

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2018-00933 (Patent 9,084,601 B2)
Case IPR2018-00934 (Patent 8,998,058 B2)
Case IPR2018-00935 (Patent 8,991,677 B2)¹

Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

ORDER
Trial Hearing
35 U.S.C. § 42.70

¹ This Order applies to all of the listed cases. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this caption in any subsequent papers.

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Petitioner and Patent Owner request an oral argument in each of IPR2018-00933, IPR2018-00934, and IPR2018-00935 pursuant to 37 C.F.R. § 42.70. Papers 25², 26. Petitioner requests 90 minutes of total argument time “to present arguments collectively for this proceeding and the concurrent proceedings.” Paper 25, 1. Patent Owner requests that all three proceedings be consolidated into a single hearing and that it be given 45 minutes total argument time for the consolidated hearing. Paper 26, 2.

Having considered the parties’ submissions, the parties’ requests for oral argument are GRANTED. A consolidated oral argument for all three captioned proceedings will commence at 9:30 am Eastern Time on September 5, 2019, on the 9th floor of Madison Building East, 600 Dulany Street, Alexandria Virginia. Seating will be available on a first-come, first-served basis. The Board will provide a court reporter, and the transcript shall constitute the official record of the hearing.

Each party will have **60 minutes** of total argument time. Petitioner will open the hearing by presenting its case regarding the challenged claims and the proposed substitute claims. Patent Owner will then respond to Petitioner’s presentation. Petitioner may reserve rebuttal time of no more than half its total argument time to reply to Patent Owner’s arguments. Patent Owner may reserve sur-rebuttal time of no more than half its total argument time to respond to Petitioner’s rebuttal.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits, if any, must be served seven business days before the hearing. The parties also shall

² IPR2018-00933 is representative and all citations are to IPR2018-00933 unless otherwise indicated.

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provide the demonstrative exhibits to the Board at least three business days prior to the hearing by emailing them to Trials@uspto.gov. The parties shall not file any demonstrative exhibits in this proceeding without prior authorization from the Board.

The Board reminds the parties that demonstrative exhibits are not evidence, but are intended to assist the parties in presenting their oral arguments to the Board. The Board also reminds the parties that demonstrative exhibits are not a mechanism for making arguments not previously addressed in the papers. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits.

The Board expects that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits. If such objections cannot be resolved, the parties may file any remaining objections with the Board at least three business days before the oral hearing. The objections should identify with particularity the portions of the demonstrative exhibits that are subject to objection and include a one-sentence statement of the basis for each objection. No argument or further explanation is permitted. The Board will consider any objections and schedule a conference call if deemed necessary. Otherwise, the Board will reserve ruling on the objections until the hearing. Any objection to demonstrative exhibits that is not timely presented will be considered waived. A hard copy of the demonstratives should be provided to the court reporter at the hearing.

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The Board expects lead counsel for each party to be present in person at the oral hearing. However, any counsel of record may present the party's argument. If either party anticipates that its lead counsel will not be attending the oral argument, the parties should initiate a joint telephone conference with the Board no later than two business days prior to the oral hearing to discuss the matter.

Questions regarding specific audio-visual equipment should be directed to the Board at 571-272-9797. Requests for audio-visual equipment are to be made no later than 5 days in advance of the hearing date. The request is to be sent directly to Trials@uspto.gov. If the request is not timely, the equipment may not be available on the day of the hearing.

In light of the foregoing, it is:

ORDERED that the oral hearing, conducted pursuant to the procedures outlined above, shall commence at 9:30 am Eastern Time on September 5, 2019.

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