

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTUITIVE SURGICAL, INC.,  
Petitioner,

v.

ETHICON LLC,  
Patent Owner

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

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Record of Oral Hearing  
Held September 5, 2019

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BEFORE: Josiah C. Cocks, Benjamin D.M. Wood, and Matthew S. Meyers,  
*Administrative Patent Judges.*

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

## APPEARANCES

### ON BEHALF OF PETITIONER:

STEVEN R. KATZ, ESQUIRE  
RYAN P. O'CONNOR, ESQUIRE  
FISH & RICHARDSON  
1000 Maine Street SW  
Washington, DC 20024  
202-783-2331

### ON BEHALF OF THE PATENT OWNER:

ANISH R. DESAI, ESQUIRE  
ROBERT S. MAGEE, ESQUIRE  
WEIL, GOTSCHAL & MANGES LLP  
2001 M Street NW  
Suite 600  
Washington, DC 20024  
202-682-7000

The above-entitled matter came on for hearing on September 5, 2019, commencing at 9:29 a.m., at the U.S. Patent and Trademark Office, USPTO Madison Building, 600 Dulany Street, Alexandria, VA 22314.

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

1 (Proceedings begin at 1:28 p.m.)

2 JUDGE COCKS: We're here today for consolidated oral  
3 argument for three proceedings, IPR2018-00935, '934, and '935  
4 involving three patents, 9,084,601, 8,998,058, and 8,991,677.

5 Would counsel for the Petitioner please introduce  
6 themselves?

7 MR. O'CONNOR: Ryan O'Connor.

8 MR. KATZ: And Steven Katz, Petitioner's.

9 JUDGE COCKS: All right. Thank you.

10 And counsel for the Patent Owner?

11 MR. DESAI: Anish Desai.

12 MR. MAGEE: And Bob Magee.

13 JUDGE COCKS: All right. Thank you.

14 Now, as we set forth in the trial hearing order,  
15 each side has 60 minutes of arguing time. The Petitioner will  
16 present their case first for both the challenge claims and the  
17 substitute claims and may reserve rebuttal time. The Patent  
18 Owner will then argue its opposition to Petitioner's case, and  
19 Patent Owner may reserve surrebuttal time. Patent Owner will  
20 then -- I mean, Petitioner will then argue its rebuttal, and  
21 we will conclude with Patent Owner arguing its surrebuttal.

22 So, Mr. O'Connor?

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Case IPR2018-00935 (Patent 8,991,677 B2)<sub>1</sub>

1           Actually, before you begin, a point of order. The --  
2   there are several proceedings involving these saved parties  
3   and this Panel that are before the Board, and there are  
4   currently oral arguments set forth, September 18th and October  
5   17th; is that correct?

6           MR. O'CONNOR: That's right. It's correct.

7           JUDGE COCKS: There was recently a request from  
8   Petitioner to go ahead and consolidate cases on October 17th,  
9   and the Panel was amenable. Did the Patent Owner have any  
10   objection?

11          MR. DESAI: Yeah. No objection.

12          JUDGE COCKS: Okay. So that leaves one last point.  
13   There's currently then one case scheduled for September 18th  
14   that IPR2018-00936, the Panel wanted to inquire if there'd be  
15   any procedural efficiency to argue that case on the 17th as  
16   well. We are mindful, that would be five cases on the 17th,  
17   which presents potentially understandable difficulty, but --

18          MR. DESAI: I just need to confirm that it works for  
19   the person who is slotted to schedule it.

20          JUDGE COCKS: Okay.

21          MR. DESAI: To argue that one. But if that's the  
22   case, we're okay with it.

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1 JUDGE COCKS: Mr. O'Connor?

2 MR. O'CONNOR: No objection.

3 JUDGE COCKS: No objection?

4 MR. O'CONNOR: From our side.

5 JUDGE COCKS: After you have conferred, if you would  
6 please go ahead and email the Board, indicating that that  
7 would be okay?

8 MR. DESAI: Absolutely.

9 JUDGE COCKS: Okay.

10 All right. Mr. O'Connor, the podium is yours. Do  
11 you wish to reserve any rebuttal time?

12 MR. O'CONNOR: Yes, Your Honor. We'd like to  
13 reserve 30 minutes for rebuttal.

14 JUDGE COCKS: 30 minutes, okay.

15 MR. O'CONNOR: And I have hard copies of the slides,  
16 if you'd like.

17 JUDGE COCKS: We will take them.

18 MR. O'CONNOR: Okay.

19 JUDGE COCKS: You may approach. Thank you. Thank  
20 you. Whenever you are ready, you may begin.

21 MR. O'CONNOR: Thank you very much.

22 As you noted, Your Honor, the challenged patents are

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