

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 IPR2018-00934  
Patent 8,998,058 B2

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

COCKS, *Administrative Patent Judge*.

JUDGMENT  
Final Written Decision  
Determining All Challenged Claims Unpatentable  
Granting Patent Owner's Motion to Amend  
*35 U.S.C. § 318(a)*

## I. INTRODUCTION

### A. Summary

Intuitive Surgical, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–18 of U.S. Patent No. 8,998,058 B2 (Ex. 1001, “the ’058 patent”). After the filing of the Petition, Ethicon LLC (“Patent Owner”) filed a statutory disclaimer of claims 11–18. Ex. 2004; *see* Paper 8, 9. We instituted trial to determine whether claims 1–10 were unpatentable under 35 U.S.C. § 103<sup>1</sup> based on Hooven<sup>2</sup> and Heinrich<sup>3</sup>. *See* Paper 9 (“Decision on Institution” or “Dec. on Inst.”).<sup>4</sup> Patent Owner filed a Patent Owner Response. Paper 15 (“PO

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<sup>1</sup> It is not entirely clear what version of § 103 Petitioner argues under. The application for the ’058 patent *proper* was filed on May 20, 2014. Ex. 1001, code (22). The *earliest effective filing date* of the ’058 patent, however, based on various chains of continuation and continuation-in-part applications, is February 14, 2008. Pet. 3; Ex. 1001, code (63). If this date is afforded priority, it would make the patent subject to pre-AIA § 103(a). *See* 35 U.S.C. § 100 (note) (2015) (applicability of AIA). While Petitioner “does not concede that the challenged claims . . . are entitled to [the 2008] priority date,” it asserts that its arguments are not affected by this difference, since both Hooven and Heinrich predate the earliest effective filing date. *See* Pet. 3–4. Petitioner claims entitlement for relief under “§ 103,” implying reliance on the post-AIA law (and in light of the refusal to concede an earlier priority date), but uses “§ 102(b)” to show that Hooven and Heinrich qualify as prior art, which corresponds better to the pre-AIA version of the law (as current § 102(b) deals only with *exceptions* to the novelty requirement). *Id.* Neither Petitioner nor Patent Owner, however, has pursued this point since. Therefore, we use the post-AIA version here.

<sup>2</sup> U.S. Patent No. 5,383,880 issued Jan. 24, 1995 (Ex. 1004, “Hooven”).

<sup>3</sup> U.S. Patent App. Pub. No. US 2005/0131390 A1 published June 16, 2005 (Ex. 1005, “Heinrich”).

<sup>4</sup> In our Decision on Institution, we treated claims 11–18 as having never

Resp.”). Patent Owner also filed a “Corrected Contingent Motion to Amend Under 37 C.F.R. § 42.121.” Paper 18 (“Motion to Amend” or “Mot. to Amend”).<sup>5</sup> Petitioner filed a Reply to Patent Owner’s Response. Paper 20 (“Pet. Reply”). Petitioner also filed an Opposition to Patent Owner’s Motion to Amend. Paper 21 (“Pet. Opp.”). Patent Owner filed a Reply in Support of its Contingent Motion to Amend. Paper 25 (“PO Reply”). Patent Owner filed a Sur-reply to Petitioner’s Reply to Patent Owner’s Response. Paper 26 (“PO Sur-reply”). Petitioner filed a Sur-reply to Patent Owner’s Reply in Support of the Contingent Motion to Amend. Paper 30 (“Pet. Sur-reply”). Oral hearing was conducted on September 5, 2019, and a transcript of the hearing is in the record. Paper 33.

We have jurisdiction under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This decision is a Final Written Decision under 35 U.S.C. § 318(a). For the reasons discussed below, we hold that Petitioner has demonstrated by a preponderance of the evidence that claims 1–10 of the ’058 patent are unpatentable under 35 U.S.C. § 103(a). We grant Patent Owner’s Contingent Motion to Amend to substitute claims 19–28 for claims 1–10 in the ’058 patent.

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been part of the ’058 patent, and concluded that Petitioner could not seek *inter partes* review of those claims. *See* Dec. on Inst. 8–9.

<sup>5</sup> A listing of proposed substitute claims 19–28 appears in Appendix A of Paper 18.

*B. Real Parties-In-Interest*

Petitioner identifies itself as the only real party-in-interest. Pet. 1.

*C. Related Matters*

The parties indicate that the '058 patent is involved in: *Ethicon LLC v. Intuitive Surgical, Inc.*, No. 1:17-cv-00871 in the United States District Court for the District of Delaware (“the Delaware litigation”).<sup>6</sup> Pet. 1–2; Paper 6, 2. Petitioner is also challenging related patents in the following proceedings before the Board: (1) IPR2018-00933 (the '601 patent); (2) IPR2018-00935 (the '677 patent); (3) IPR2018-01247, IPR2018-01248, and IPR2018-01254 (the '969 patent); (4) IPR2018-00936 (the '658 patent); (5) IPR2018-00938 (the '874 patent); (6) IPR2018-01703 (the '431 patent); and (7) IPR2019-00880 (U.S. Patent No. 7,490,749).

*D. The '058 Patent*

The '058 patent is titled “Detachable Motor Powered Surgical Instrument,” and generally relates to endoscopic surgical instruments. Ex. 1001, code (54), 1:42–53. The '058 patent summarizes its disclosure as encompassing a surgical instrument including “a housing that includes at least one engagement member for removably attaching the housing to an actuator arrangement.” *Id.* at code (57). The housing supports a motor that “may include a contact arrangement that is configured to permit power to be

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<sup>6</sup> Patent Owner contends that U.S. Patent Nos. 9,585,658 B2 (“the '658 Patent”), 8,616,431 B2 (“the '431 Patent”), 8,479,969 B2 (“the '969 Patent”), 9,113,874 B2 (“the '874 Patent”), 9,084,601 B2 (“the '601 Patent”), and 8,991,677 B2 (“the '677 Patent”) are also asserted in the Delaware litigation. Paper 6, 2.

supplied to the motor only when the housing is operably attached to the actuator arrangement.” *Id.* Figure 1 of the '058 patent is reproduced below.

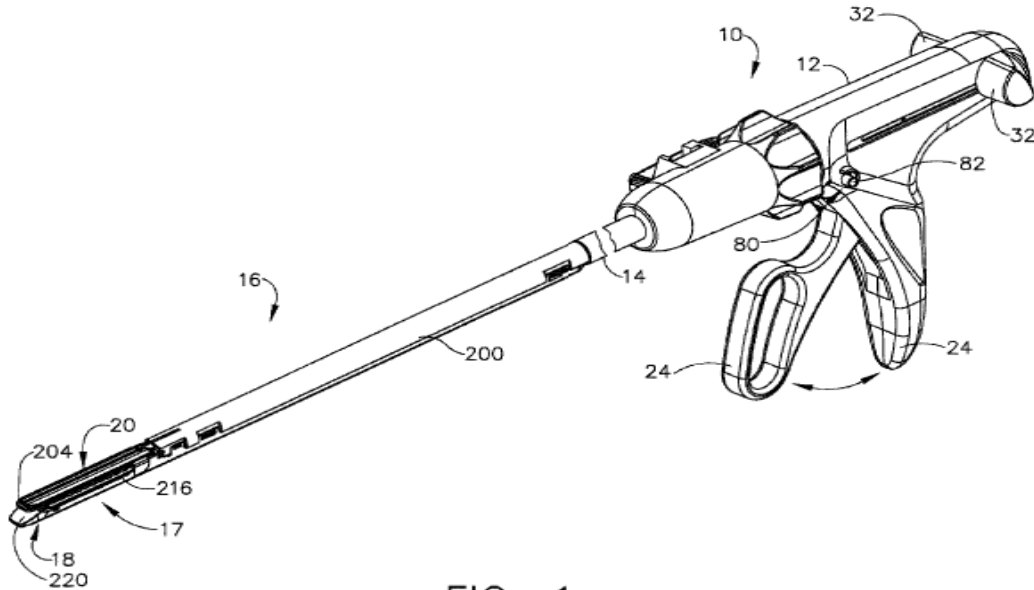


FIG. 1

Figure 1 shows “a perspective view of a disposable loading unit embodiment of the present invention coupled to a conventional surgical cutting and stapling apparatus.” *Id.* at 3:59–61. In particular, disposable loading unit 16 is coupled to surgical stapling apparatus 10. *Id.* at 10:21–25. Disposable loading unit 16 includes housing portion 200 that is configured to engage elongated body portion 14 of surgical stapling apparatus 10. *Id.* at 11:21–28. Figure 2 of the '058 patent is reproduced below.

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