

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2018-00934
Patent 8,998,058 B2

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

COCKS, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

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”). Ethicon LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”) to the Petition. We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Moreover, a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

Upon consideration of the Petition and the Preliminary Response, we conclude that the information presented shows there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim. Although the Petitioner initially sought to challenge claims 11–18 of the ’058 patent, Patent Owner has statutorily disclaimed those claims. *See* Ex. 2004. For the reasons discussed *infra*, claims 11–18 are no longer regarded as claims challenged in the Petition. Accordingly, we authorize an *inter partes* review to be instituted as to claims 1–10 of the ’058 patent on the ground raised in the Petition. Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far (prior to Patent Owner’s Response). This is not a final decision as to patentability of claims for which *inter partes* review is instituted. Any final decision will be based on the record, as fully developed during trial.

II. BACKGROUND

A. The '058 Patent

The '058 patent is titled “Detachable Motor Powered Surgical Instrument,” and generally relates to endoscopic surgical instruments. Ex. 1001, [54]; 1:49–51. 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 [57]. The housing supporting a motor that “may include a contact arrangement that is configured to permit power to be 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

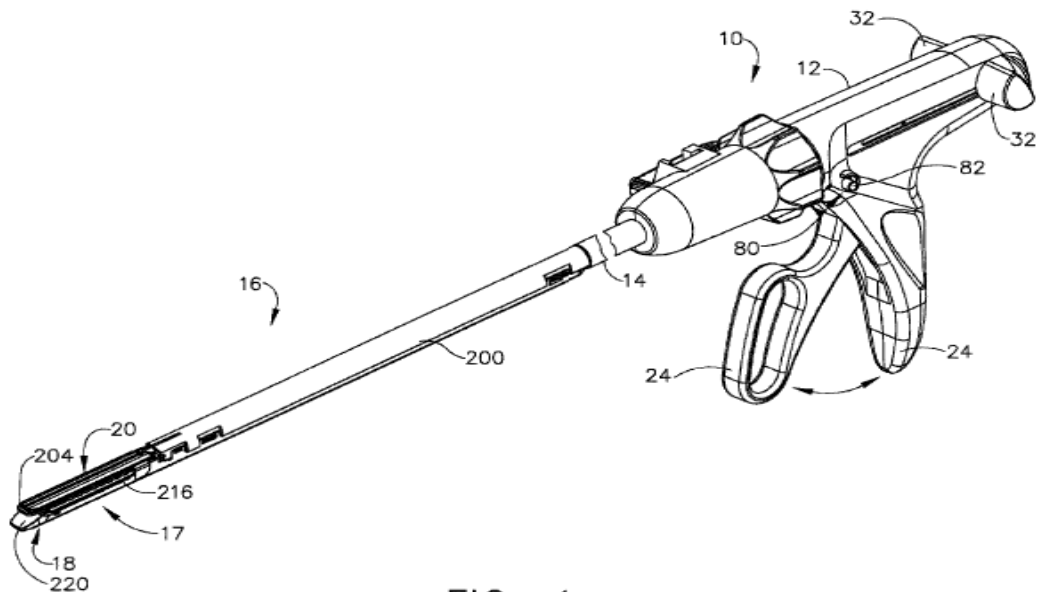


FIG. 1

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.

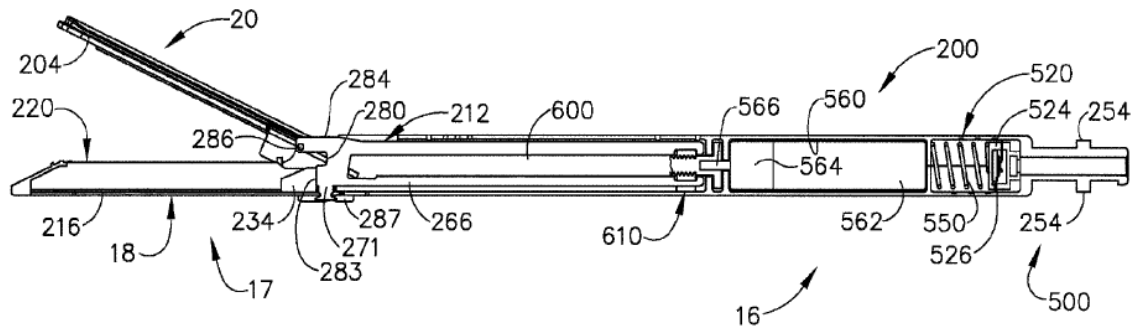


FIG. 2

Figure 2 “is a cross-sectional view of the disposable loading unit of FIG. 1 with several components shown in full view for clarity.” *Id.* at 3:62–64. The '058 patent describes the following

[T]he disposable loading unit 16 may generally comprise a tool assembly 17 for performing surgical procedures such as cutting tissue and applying staples on each side of the cut. The tool assembly 17 may include a cartridge assembly 18 that includes a staple cartridge 220 that is supported in a carrier 216. An anvil assembly 20 may be pivotally coupled to the carrier 216 in a known manner for selective pivotal travel between open and closed positions. The anvil assembly 20 includes an anvil portion 204 that has a plurality of staple deforming concavities (not shown) formed in the undersurface thereof. The staple cartridge 220 houses a plurality of pushers or drivers (not shown) that each have a staple or staples (not shown) supported thereon. An actuation sled 234 is supported within the tool assembly 17 and is configured to drive the pushers and staples in the staple cartridge 220 in a direction toward the anvil assembly 20 as the

actuation sled 234 is driven from the proximal end of the tool assembly 17 to the distal end 220.

Id. at 10:45–63.

Figure 3 of the '058 patent is reproduced below.

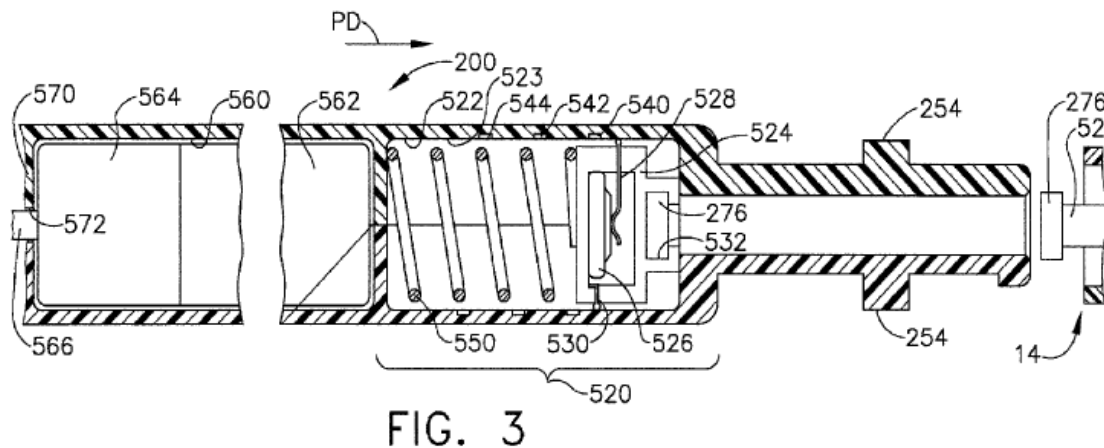


Figure 3 above illustrates a cross-sectional view of the proximal end of disposable loading unit 16 shown in Figure 1. *Id.* at 3:65–67. Housing portion 200 of the disposable loading unit defines battery cavity 522 that movably supports battery holder 524 that houses battery 526. *Id.* at 11:29–33. First battery contact 528 and second battery contact 530 are supported in electrical contact with battery 526. *Id.* at 11:33–41. The '058 further describes the following:

As can also be seen in FIG. 3, a biasing member or switch spring 550 is positioned within the battery cavity 522 to bias the battery holder 524 in the proximal direction “PD” such that when the disposable reload 16 is not attached to the elongated body 14, the battery holder 524 is biased to its proximal-most position shown in FIG. 3. When retained in that “pre-use” or “disconnected” position by spring 550, the battery contacts 528 and 530 do not contact any of the contacts 540, 542, 544 within battery cavity 522 to prevent the battery 526 from being drained during non-use.

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