

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
U.S. Patent No. 8,998,058

**PATENT OWNER'S OBJECTIONS TO DOCUMENTS SERVED WITH
PETITIONER'S REPLY AND PETITIONER'S OPPOSITION TO PATENT
OWNER'S CONTINGENT MOTION TO AMEND**

Pursuant to 37 C.F.R. § 42.64(b), Patent Owner Ethicon LLC hereby makes the following objections to the admissibility of documents submitted with Petitioner’s Reply and Petitioner’s Opposition to Patent Owner’s Contingent Motion to Amend.

Evidence	Objections
<p>IS1029</p>	<p>FRE 401/402/403: This exhibit is not relevant at least because it is not cited in Petitioner’s Opposition to Patent Owner’s Motion to Amend and any probative value is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, and wasting time.</p> <p>FRE 801/802: This exhibit is an out of court statement offered for its truth, and because it does not fall within any exception to the rule against hearsay, it is inadmissible hearsay.</p> <p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p>
<p>IS1030</p>	<p>FRE 105: To the extent that any portion of this exhibit may be deemed admissible, such admissibility should be for a limited purpose.</p> <p>FRE 401/402/403: Paragraphs 37, 51-53, 74-76, 78, 82-85, 88-106, 108-110, 112, 116-118, 125, 130-131, and 136-156 are not relevant at least because they are not cited in Petitioner’s Reply or in Petitioner’s Opposition to Patent Owner’s Contingent Motion to Amend, and any probative value of these sections is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, and wasting time.</p> <p>FRE 602: As to at least paragraphs 12-36, 38-74, 76-77, 79-83, 86, 98-99, 104-107, 109-111, 113-115, 122-123, 130-137, 140-141, 150, and 154-156, the exhibit includes</p>

Evidence	Objections
	<p>assertions for which evidence has not been introduced sufficient to show that the witness has personal knowledge of the matters asserted.</p> <p>FRE 701/702/703: Paragraphs 12-156 are improper expert testimony because the exhibit declarant is not qualified to opine on what a person of ordinary skill in the art would understand, to opine on patent claim limitations, to perform claim construction, and/or to perform legal analysis of invalidity. The opinion testimony offered in this exhibit is not based on scientific, technical, or other specialized knowledge, and is also not based on personal knowledge. The opinion testimony includes unsubstantiated leaps and advances inaccurate, unqualified generalizations. The opinion testimony fails to properly disclose the underlying facts or data on which the opinion is based. The opinion testimony includes testimony on United States patent law and/or patent examination practice. These paragraphs include opinions that are not admissible under FRE 701, 702, or 703 or <i>Daubert v. Merrell Dow Pharms, Inc.</i>, 509 U.S. 579 (1993).</p> <p>For example, paragraphs 12-25 are based on the conclusory opinion that Patent Owner’s proposed constructions of the original claims of the ’677 Patent are inconsistent with the plain language of the claims and the specification of the patent.</p> <p>As another example, paragraphs 41-50 are based on the conclusory opinion that a POSITA would have had a reasonable expectation of success in combining Viola and Heinrich in light of Young.</p> <p>FRE 705 and/or 37 C.F.R. § 42.65: This exhibit includes expert testimony that does not disclose the underlying facts or data.</p>

Evidence	Objections
	FRE 802: The entirety of the exhibit is inadmissible hearsay if offered to prove the truth of any matter allegedly asserted therein.

Dated: June 18, 2019

Respectfully submitted,

/Anish R. Desai/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on June 18, 2019, the foregoing **PATENT OWNER'S OBJECTIONS TO DOCUMENTS SERVED WITH PETITIONER'S REPLY AND PETITIONER'S OPPOSITION TO PATENT OWNER'S CONTINGENT MOTION TO AMEND** was served via electronic mail, upon the following:

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