

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2018-00935
U.S. Patent No. 8,991,677

**PATENT OWNER'S CORRECTED CONTINGENT MOTION TO AMEND
UNDER 37 C.F.R. § 42.121**

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Cases

Aqua Products, Inc. v. Joseph Matal,
872 F.3d 1290 (Fed. Cir. 2017) (*en banc*)1, 17

Corning Optical Comm’n RF, LLC v. PPC Broadband, Inc.,
IPR2014-00441, Paper 19 (P.T.A.B. Oct. 30, 2014).....3

Statutes

35 U.S.C. § 316(d)1, 2, 3

35 U.S.C. § 316(e)17

Other Authorities

37 C.F.R. § 41.1211, 2, 3, 17

LIST OF EXHIBITS

Exhibit	Description
Ex. 2001	U.S. Patent No. 5,964,394 (“Robertson”)
Ex. 2002	U.S. Patent No. 6,231,565 (“Tovey”)
Ex. 2003	Excerpts from Technology Tutorial filed in <i>Ethicon LLC, et al. v. Intuitive Surgical, Inc., et al.</i> , C.A. No. 17-871 (LPS)(CJB) (District of Delaware).
Ex. 2004	Statutory Disclaimer
Ex. 2005	Excerpts from the File History of U.S. Patent No. 8,991,677
Ex. 2006	Declaration of Dr. William Cimino
Ex. 2007	Deposition of Gregory Fischer, Ph. D., Volume 1 (February 18, 2019)
Ex. 2008	Deposition of Gregory Fischer, Ph. D., Volume 2 (February 20, 2019)
Ex. 2009	U.S. Pat. Appl. Pub. 2014/0252071 A1 (application publication of U.S. Appl. No. 14,283,729) (“the 729 Application”)
Ex. 2010	U.S. Pat. App. Pub. 2009/0206136 A1 (application publication of U.S. Appl. No. 12/031,628) (“the 628 Application”)
Ex. 2011	Reserved
Ex. 2012	Reserved
Ex. 2013	Reserved

I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner Ethicon LLC submits this contingent motion to substitute proposed claims 19-24 for original claims 1-5, and 16 (collectively, the “Amended Claims”) of U.S. Patent No. 8,991,677 (“the 677 Patent”) should any of the Amended Claims be found unpatentable.¹ Patent Owner has conferred with the Board prior to filing this motion, as required by 37 C.F.R. § 42.121, and the Board authorized the filing of this motion without a conference on February 25, 2019 via email.

In *Aqua Products, Inc. v. Joseph Matal.*, 872 F.3d 1290, 1327-28 (Fed. Cir. 2017) (*en banc*), the Federal Circuit held that the burden of persuasion to establish that proposed amendments are patentable no longer rests with the patent owner. Instead, it is the petitioner’s burden to prove unpatentability of the proposed amendments. *Id.* In a motion to amend, a patent owner need only satisfy its burden of production under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121.

¹ Patent Owner submitted a statutory disclaimer for claims 11-15 and 18 – accordingly, claims 11-15 and 18 are treated as having never been part of the 677 Patent. *See* Paper 9 at 9-10. However in order to avoid confusion, Patent Owner begins numbering its substitute proposed claims at 19.

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