

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Kyle P. Moore, et al.
U.S. Patent No.: 8,991,677 Attorney Docket No.: 11030-0049IP3
Issue Date: March 31, 2015
Appl. Serial No.: 14/283,729
Filing Date: May 21, 2014
Title: DETATCHABLE MOTOR POWERED SURGICAL
INSTRUMENT

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**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT
NO. 8,991,677 PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42**

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EXHIBITS

- IS1001 U.S. Patent No. 8,991,677 to Moore et al. (“the ’677 patent”)
- IS1002 Excerpts from the prosecution histories of U.S. Pat. Nos. 9,084,601 (Serial No. 13/832,522), 8,998,058 (Serial No. 14/282,494), 8,991,677 (Serial No. 14/283,729), 8,752,749 (Serial No. 13/118,210), 8,196,795 (Serial No. 12/856,099), and 7,793,812 (Serial No. 12/031,628)
- IS1003 Declaration of Dr. Gregory S. Fischer
- IS1004 U.S. Patent No. 5,383,880 to Hooven (“Hooven”)
- IS1005 U.S. Patent App. Pub. No. 2005/0131390 to Heinrich et al. (“Heinrich”)
- IS1006 U.S. Patent No. 5,865,361 to Milliman et al. (“Milliman”)
- IS1007 U.S. Patent No. 7,524,320 to Tierney et al. (“the ’320 patent”)
- IS1008 U.S. Patent No. 8,196,795 to Moore et al. (“the ’795 patent”)
- IS1009 U.S. Patent No. 8,752,749 to Moore et al. (“the ’749 patent”)
- IS1010 U.S. Patent No. 5,779,130 to Alesi et al. (“Alesi”)
- IS1011 [Reserved]
- IS1012 [Reserved]
- IS1013 U.S. Patent No. 6,783,524 to Anderson et al. (“the ’524 patent”)

Intuitive Surgical, Inc. (“Petitioner”) petitions for *Inter Partes* Review (“IPR”) of claims 1-18 of U.S. Patent No. 8,991,677 (“the ’677 patent”). The ’677 patent relates to a “detachable motor-powered surgical instrument” in general and to a “surgical cutting and stapling instrument” in particular. The claimed motor is operably disconnected from a power source when the housing of the stapling sub-system is not attached to the surgical instrument system, and operably connected to the power source when the housing of the stapling sub-system is attached to the surgical instrument system. IS1001, Claim 6.

Such instruments were not new at the time of the alleged priority date of the ’677 patent. As explained below, claims 1-18 are obvious over U.S. Patent No. 5,383,880 to Hooven (“Hooven”) in view of U.S. Patent App. Pub. No. 2005/0131390 to Heinrich et al. (“Heinrich”), U.S. Patent No. 5,779,130 to Alesi et al. (“Alesi”), and/or U.S. Patent No. 5,865,361 to Milliman et al. (“Milliman”). Petitioner therefore requests IPR of the challenged claims on Grounds 1-3 below.

I. MANDATORY NOTICES UNDER 37 C.F.R § 42.8

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

Intuitive Surgical, Inc. is the real party-in-interest. No other party had access to the Petition, and no other party had any control over, or contributed to any funding of, the preparation or filing of the present Petition.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

Petitioner is not aware of any disclaimers, reexamination certificates, or petitions for IPR of the '677 patent. The '677 patent is the subject of Civil Action No. 1:17-cv-00871-LPS, filed on June 30, 2017 in the United States District Court for the District of Delaware. Petitioner was served with the complaint in that action on July 12, 2017. Concurrently with this petition, Petitioner filed IPR petitions for U.S. Pat. Nos. 8,998,058 and 9,084,601, which are related to the '677 patent.

C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

Petitioner provides the following designation of counsel.

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D. Service Information

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Petitioner consents to electronic service by email at IPR11030-0049IP3@fr.com

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