

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patents of: Kyle P. Moore, et al.
U.S. Patent Nos.: 9,084,601 Attorney Docket Nos.: 11030-0049IP1
8,998,058 11030-0049IP2
8,991,677 11030-0049IP3

Title: DETATCHABLE MOTOR POWERED SURGICAL
INSTRUMENT

SUPPLEMENTAL DECLARATION OF DR. GREGORY S. FISCHER

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I, Gregory S. Fischer PhD, declare as follows:

1. I have been engaged by Fish & Richardson P.C. on behalf of Intuitive Surgical, Inc. (“Petitioner”) for the above-captioned *inter partes* review (“IPR”) proceedings. I understand that these proceedings involve United States Patent Nos. 9,084,601 (“the ’601 patent”), 8,998,058 (“the ’058 patent”), and 8,991,677 (“the ’677 patent”) (collectively, “the challenged patents”), each of which is entitled “Detachable motor powered surgical instrument,” by Kyle P. Moore, et al., and which share a common specification and figures. These patents were filed March 15, 2013, May 20, 2014, and May 21, 2014, respectively, and they issued on July 21, 2015, April 7, 2015, and March 31, 2015, respectively. I understand that the challenged patents are currently assigned to Ethicon Endo-Surgery, Inc. (“Ethicon”).

2. I understand the challenged patents claim priority to U.S. Application No. 12/031,628 (“the ’628 application”). For purposes of this IPR, I assume the earliest possible priority date of the challenged patents is the February 14, 2008 filing date of the ’628 application.

3. I have reviewed and am familiar with the specifications of the challenged patents. I understand that the challenged patents have been provided as Exhibit 1001 in each of their respective Petitions for IPR. I will cite to the specification using the following format: IS1001 (’601 patent), 1:1-10. This

example citation points to the '601 patent specification at column 1, lines 1-10.

The same disclosures, however, are also found in the '058 and '677 patent because they share a common specification and figures, which I will cite as IS1001 ('058 patent) and IS1001 ('677 patent), respectively.

4. I have reviewed and am familiar with the file history of the challenged patents. I understand that excerpts from the file histories of the challenged patents have been combined into a single document that has been provided as Exhibit 1002 (File History) in each of the Petitions for IPR of the challenged patents.

5. As noted in my initial declaration, I have reviewed and am familiar with the following prior art used in the Petitions for IPR of the challenged patents:

- a. U.S. Patent App. Pub. No. 2005/0131390 to Heinrich et al. ("Heinrich"). I understand that Heinrich has been provided as Exhibit IS1005 in each of the Petitions for IPR of the challenged patents.
- b. U.S. Patent No. 5,383,880 to Hooven ("Hooven"). I understand that Hooven has been provided as Exhibit IS1004 in the Petitions for IPR of the '058 and '677 patents.
- c. U.S. Patent No. 5,865,361 to Milliman et al. ("Milliman"). I understand that Milliman has been provided as Exhibit IS1006 in each of the Petitions for IPR of the challenged patents.
- d. U.S. Patent No. 5,779,130 to Alesi et al. ("Alesi"). I understand that Alesi has been provided as Exhibit IS1010 in each of the Petitions for IPR of the challenged patents.
- e. U.S. Pat. No. 6,783,524 to Anderson et al. ("Anderson"). I understand that Anderson has been provided as Exhibit IS1013 in each of the Petitions for IPR of the '058 and '677 patents.

- f. Tonet O. et al., Comparison of Control Modes of a Hand-Held Robot for Laparoscopic Surgery. In: Larsen R., Nielsen M., Sporning J. (eds) Medical Image Computing and Computer-Assisted Intervention – MICCAI 2006. MICCAI 2006. Lecture Notes in Computer Science, vol. 4190, pp. 429-36 (Springer, Berlin, Heidelberg 2006) (ISBN 978-3-540-44707-8) (“Tonet”). I understand that Tonet has been provided as Exhibit IS1014 in the Petition for IPR of the ’601 patent.

6. I have also reviewed an am familiar with the following prior art used in Intuitive’s oppositions to Ethicon’s motions to amend the challenged claims.

- a. U.S. Patent No. 5,954,259 to Viola et al. (“Viola”). I understand that Viola has been provided as Exhibit IS1031 in each of the Petitions for IPR of the challenged patents.
- b. U.S. Pat. No. 5,653,374 to Young et al. (“Young”). I understand that Young has been provided as Exhibit IS1032 in each of the Petitions for IPR of the ’058 and ’677 patents.

7. The challenged patents describe a “detachable motor-powered surgical instrument” in general, and a “surgical cutting and stapling instrument” in particular. *E.g.*, ’601 patent, Abstract. I am familiar with the technology described in the challenged patents as of the earliest possible priority date of the challenged patents (*i.e.*, February 14, 2008).

8. I understand that Ethicon has asked the PTO to consider the substitute claims for the original claims of the ’601, ’058, and ’677 patents identified in the table below:

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