

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.
Petitioner

v.

Ethicon LLC
Patent Owner

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

**PETITIONER'S REPLY TO
PATENT OWNER'S RESPONSE**

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B. Ethicon’s Term 1: “stapling sub-system comprising: ... an electric motor ... wherein said electric motor is operably disconnected from a power source when said housing is not attached to the surgical instrument system, and wherein said electric motor is operably connected to the power source when said housing is attached to the surgical instrument system” (Claims 6, 17)	12
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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”)
- IS1014-IS1028 Reserved
- IS1029 Webster’s Ninth New Collegiate Dictionary (1991)

- IS1030 Supplemental Declaration of Gregory S. Fischer (“Fischer
Supp. Decl.”)
- IS1031 U.S. Pat. No. 5,954,259 to Viola et al. (“Viola”)
- IS1032 U.S. Pat. No. 5,653,374 to Young et al. (“Young”)
- IS1033 Transcript of deposition of Dr. William Cimino, May 29, 2019

I. Introduction

Ethicon effectively concedes that Hooven/Heinrich renders obvious the challenged claims as issued. It tries to save the claims by improperly injecting limitations through claim construction. However, “it is important not to import ... limitations that are not part of the claim.” *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). “Claim terms should be given their plain and ordinary meaning to one of skill in the art at the relevant time and cannot be rewritten by the courts to save their validity.” *Hill-Rom Services, Inc. v. Stryker Corp.*, 755 F.3d 1367, 1374 (Fed. Cir. 2014).

II. Claim Construction

Intuitive proposed two terms for construction—“means for removably attaching said housing to the surgical instrument,” present in claims 1 and 16, and “drive means for converting the rotational motion produced by said electric motor to translational motion to eject said staples from said staple cartridge body,” present in claims 11 and 18. Petition, 16-22. Intuitive also proposed that all remaining terms be given their plain and ordinary meaning. *Id.*, 16. Ethicon did not address the terms that Intuitive proposed for construction, so they are not addressed further.

Ethicon, however, proposed constructions for two additional terms. The first term (“Term 1”) appears in claims 1 and 16:

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