

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2018-00933 – U.S. Patent No. 9,084,601

IPR2018-00934 – U.S. Patent No. 8,998,058

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

SUPPLEMENTAL DECLARATION OF DR. WILLIAM CIMINO

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I, Dr. William Cimino, hereby declare as follows:

1. I have personal knowledge of the facts stated in this supplemental declaration and, if called upon to do so, could and would attest to these facts under oath.

2. I make this supplemental declaration at the request of Ethicon LLC (“Patent Owner”), in connection with the petitions for *inter partes* review submitted by Intuitive Surgical, Inc. (“Petitioner”) for U.S. Patent Nos. 9,084,601 (“the 601 Patent), 8,998,058 (“the 058 Patent”) and 8,991,677 (“the 677 Patent”), which I will refer to collectively as the “Power Patents.” All statements made herein of my own knowledge are true, and all statements made herein based on information and belief are believed to be true. Although I am being compensated for my time in preparing this supplemental declaration, the opinions articulated herein are my own, and I have no stake in the outcome of this proceeding or any related litigation or administrative proceedings.

I. INTRODUCTION

3. In the preparation of this supplemental declaration, I have reviewed the relevant portions of the following documents:

Ex. 1001 (058 Patent) ¹	U.S. Patent No. 8,998,058 to Moore, et al. (“the 058 Patent”)
Ex. 1001 (677 Patent)	U.S. Patent No. 8,991,677 to Moore, et al. (“the 677 Patent”)
Ex. 1001 (601 Patent)	U.S. Patent No. 9,084,601 to Moore, et al. (“the 601 Patent”)
Ex. 1003	Declaration of Dr. Gregory S. Fischer
Ex. 1005	U.S. Patent App. Pub. No. 2005/0131390 to Heinrich et al. (“Heinrich”)
Ex. 1013	U.S. Patent No. 6,783,524 to Anderson et al. (“the 524 Patent”)
Ex. 1014	Oliver Tonet et al., “Comparison of Control Modes of a Hand-Held Robot for Laparoscopic Surgery”, Lecture Notes in Computer Science, vol. 4190, pp. 429-36 (“Tonet”)
Ex. 1027	Ethicon’s Opening Claim Construction Brief, <i>Ethicon LLC v. Intuitive Surgical, Inc.</i> , C.A. No. 17-871, D.I. 119 (D. Del.)
Ex. 1029	Webster’s Ninth new Collegiate Dictionary (excerpts)
Ex. 1030	Supplemental Declaration of Dr. Gregory S. Fischer
Ex. 1031	U.S. Patent No. 5,954,259 to Viola et al. (“Viola”)
Ex. 1032	U.S. Patent No. 5,653,374 to Young et al. (“Young”)
Ex. 2006	Declaration of Dr. William Cimino

¹ I understand that the 601, 058, and 677 Patents share a common specification and figures and have been provided as Exhibit 1001 in IPR2018-00933, -934 and -935. I will therefore identify which patent’s specification I am referring to whenever I cite to Exhibit 1001 in my declaration.

Ex. 2015	Excerpts of American Heritage College Dictionary 3d (1993)
Ex. 2016	Deposition Transcript of Dr. Gregory Fischer (July 11, 2019)
Ex. 2017	Excerpts of Dictionary of Mechanical Engineering (1985)

4. I have also reviewed Patent Owner's motions to amend and Petitioner's oppositions thereto in each (1985 of the IPR proceedings.

5. The opinions I have formed as explained herein are informed by and based on my consideration of the documents listed above and those documents cited herein, as well as my own knowledge and experience based upon my work in the relevant field of technology, as discussed below.

6. I have been informed that in connection with the petition for *inter partes* review of the Power Patents, Patent Owner has submitted a motion to amend the claims of the 601 Patent and contingent motions to amend the claims of the 058 and 677 Patents. I have been asked to provide my opinions on the arguments made in opposition to the motions to amend by Petitioner and Petitioner's expert, Dr. Gregory S. Fischer.

7. Summaries of my qualifications, my understanding of the law, the level of ordinary skill in the art at the time of the claimed invention, and the background of the technologies disclosed in the Power Patents are contained in Exhibit 2006, which is my initial declaration submitted in connection with IPR2018-00934 (the 058 Patent) and IPR2018-00935 (the 677 Patent). While I did

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