

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

Patent 8,991,677

PETITIONER'S REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70(a) and the Scheduling Order (Paper 10),

Petitioner submits this Request for Oral Argument on all of the instituted grounds of unpatentability of U.S. Patent No. 8,991,677. A request for Oral Argument in related IPR proceedings (IPR2018-00933 and IPR2018-00934) are being filed on this same day. Petitioner requests 90 minutes for each side (180 minutes total) to present arguments collectively for this proceeding and the concurrent proceedings.

With regard to this particular proceeding, Petitioner requests (without waiving consideration of any issue not listed below) to address the following issues:

1. Whether substitute claims 19-24 impermissibly introduce new matter;
2. Whether substitute claims 19-22 and 24 are obvious over Viola in view of Heinrich;
3. Whether substitute claim 23 is obvious over Viola in view of Heinrich and, if necessary, further in view of Young;
4. Whether claims 1-10 and 16-17 are obvious over Hooven in view of Heinrich;
5. Whether claims 1-5 and 16 are obvious over Hooven in view of Heinrich, and further in view of Milliman;
6. Whether claims 1-5 and 16 are obvious over Hooven in view of Heinrich, and further in view of Alesi;

7. Rebuttal to Patent Owner's presentation on all matters; and
8. Any additional issues on which the Board seeks clarification.

The Board has already scheduled Oral Hearing for September 5, 2019. *See* PTAB's Scheduling Order of December 7, 2018 (Paper 10).

Petitioner also respectfully requests the ability to use audio visual equipment to display demonstrative exhibits, including the use of a projector and screen that connects to a laptop computer. Petitioner's counsel will use a laptop computer with a VGA-type connector. In addition, Petitioner requests that an ELMO-type projector be made available for use.

Respectfully submitted,

Dated: August 1, 2019

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on August 1, 2019, a complete and entire copy of this Petitioner's Request for Oral Argument was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows

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