

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

PATENT OWNER'S REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70 and the Board’s Scheduling Order, Patent Owner Ethicon LLC respectfully submits this Request for Oral Argument. The Board has currently scheduled the oral hearing in IPR2018-00935 for September 5, 2019. Patent Owner specifies the following issues to be argued:

- Whether claims 1-18 of U.S. Patent No. 8,991,677 (the “677 Patent”) are unpatentable under 35 U.S.C. § 103 as obvious over U.S. Patent No. 5,383,880 (“Hooven”) in view of U.S. Patent Application Publication No. 2005/0131390 A1 (“Heinrich”).
- Whether claims 1-5 and 16 are unpatentable under 35 U.S.C. § 103 as obvious over Hooven in view of Heinrich and further in view of U.S. Patent No. 5,865,361 (“Milliman”).
- Whether claims 1-5 and 16 are unpatentable under 35 U.S.C. § 103 as obvious over Hooven in view of Heinrich and further in view of U.S. Patent No. 5,779,130 (“Alesi”).
- Whether the substitute claims in Patent Owner’s Contingent Motion to Amend (“MTA”) introduce new matter.
- Whether substitute claims 19-22 and 24 in Patent Owner’s MTA are unpatentable under 35 U.S.C. § 103 as obvious over U.S. Patent No. 5,954,259 (“Viola”) in view of Heinrich.
- Whether substitute claims 23 and 32 in Patent Owner’s MTA are

Henrich and further in view of *Comparison of Control Modes of a Hand-Held Robot for Laparoscopic Surgery* (“Tonet”).

- Any other issue the Board deems necessary for issuing a final written decision.

The Board has also currently scheduled oral hearings on September 5, 2019, for two related proceedings: IPR2018-00933 and IPR2018-00934. Patent Owner requests that all three proceedings (IPR2018-00933, -00934, and -00935) be consolidated into a single hearing.

Patent Owner requests forty-five minutes of time to address the issues identified above and the related issues identified in Patent Owner’s Request for Oral Argument in IPR2018-00933 and IPR2018-00934. To the extent the Board schedules the hearing to last more than ninety minutes, however, Patent Owner requests that it be given half the length of the hearing to address these issues.

Patent Owner requests that five spaces be reserved at the oral hearing to accommodate its counsel and corporate representatives.

Date: August 6, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 6, 2019, the foregoing
PATENT OWNER'S REQUEST FOR ORAL ARGUMENT was served via
electronic mail, upon the following:

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