UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC., Petitioner,

v.

ETHICON LLC, Patent Owner.

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

PATENT OWNER ETHICON LLC'S PRELIMINARY RESPONSE



TABLE OF CONTENTS

		I I	age		
I.	INTRODUCTION1				
II.	BAC	BACKGROUND			
	A.	Overview Of The 677 Patent	5		
	B.	Prosecution History	10		
	C.	Statutory Disclaimer Of Claims 11-15, 18	11		
III.	CLAIM CONSTRUCTION				
	A.	"Means for removably attaching said housing to the surgical instrument" (claims 1, 16)	12		
	B.	"Drive means for converting the rotational motion produced by said electric motor to translational motion to eject said staples from said staple cartridge body" (claims 11, 18)	13		
IV.	THE	THE PRIOR-ART13			
	A.	Hooven	13		
	B.	Heinrich	15		
	C.	Milliman	22		
	D.	Alesi	25		
V.	REASONS WHY THE PETITION SHOULD BE DENIED27				
	A.	Hooven In View Of Heinrich Does Not Disclose The Claimed Configuration Of Motor And Power Source	28		
		Hooven in view of Heinrich does not disclose a motor configured to receive power from a power source.	29		



		2.	Hooven in view of Heinrich does not disclose a motor that is "operably connected" and "operably disconnected"	31
	B.		oner Does Not Establish A Motivation To Combine Or onable Expectation Of Success	33
		1.	Ground 1: Petitioner provides no explanation for how to combine the incompatible systems of Hooven and Heinrich.	34
		2.	Ground 1: Petitioner relies on impermissible hindsight to combine Hooven and Heinrich	38
		3.	Ground 2: Petitioner provides no motivation to combine Hooven and Milliman.	41
		4.	Ground 3: Petitioner provides no motivation to combine Hooven and Alesi.	41
		5.	Petitioner offers no showing of a reasonable expectation of success.	42
VI	CON		ION	12



TABLE OF AUTHORITIES

	Page(s)
Cases	
Arctic Cat Inc. v. Bombardier Recreational Prod. Inc., 876 F.3d 1350 (Fed. Cir. 2017)	4, 33, 43
Compass Bank v. Intellectual Ventures II, IPR2014-00786, Paper 46	38, 41
Corning Inc. v. DSM IP Assets, IPR2013-00050, Paper 77	38, 41
Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966)	4
Honeywell Int'l Inc. v. Mexichem Amanco Holding S.A. De C.V., 865 F.3d 1348 (Fed. Cir. 2017)	34, 43
Institut Pasteur v. Focarino, 738 F.3d 1337 (Fed. Cir. 2013)	34, 43
Kinetic Concepts, Inc. v. Smith & Nephew, Inc. 688 F.3d 1342 (Fed. Cir. 2012)	28, 33, 41
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)	3, 38, 39
<i>In re Laskowski</i> , 871 F.2d 115 (Fed. Cir. 1989)	4, 39
Merck & Co. v. Teva Pharms. USA, Inc., 395 F.3d 1364 (Fed. Cir. 2005)	32
Microsoft Corp. v. Multi-Tech Sys., Inc., 357 F.3d 1340 (Fed. Cir. 2004)	12
Tech. Patents LLC v. T-Mobile (UK) Ltd., 700 F 3d 482 (Fed. Cir. 2012) cert. denied. 134 S Ct. 67 (2013)	12.



Total Containment, Inc. v. Intelpro Corp., 217 F.3d 852 (Fed. Cir. 1999)	4, 39, 40
In re Translogic Tech. Inc., 504 F.3d 1249 (Fed. Cir. 2007)	12
Vectra Fitness, Inc. v. TNWK Corp., 162 F.3d 1379 (Fed. Cir. 1998)	11
Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc., 200 F.3d 795 (Fed. Cir. 1999)	12, 13
Statutes	
35 U.S.C. § 253(a)	11
Other Authorities	
37 C.F.R. § 1.321(a)	11
37 C.F.R. § 42.24(a)	46
37 C.F.R. § 42.24(d)	46
37 C.F.R. § 42.100(b)	12
37 C.F.R. § 42.107(e)	11
77 Fed. Reg. 48 756, 48 766 (Aug. 14, 2012)	12



DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

