

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner

Case IPR2018-00933 (Patent 9,084,601 B2)
Case IPR2018-00934 (Patent 8,998,058 B2)
Case IPR2018-00935 (Patent 8,991,677 B2)₁

Record of Oral Hearing
Held September 5, 2019

BEFORE: Josiah C. Cocks, Benjamin D.M. Wood, and Matthew S. Meyers,
Administrative Patent Judges.

Case IPR2018-00933 (Patent 9,084,601 B2)
Case IPR2018-00934 (Patent 8,998,058 B2)
Case IPR2018-00935 (Patent 8,991,677 B2)₁

APPEARANCES

ON BEHALF OF PETITIONER:

STEVEN R. KATZ, ESQUIRE
RYAN P. O'CONNOR, ESQUIRE
FISH & RICHARDSON
1000 Maine Street SW
Washington, DC 20024
202-783-2331

ON BEHALF OF THE PATENT OWNER:

ANISH R. DESAI, ESQUIRE
ROBERT S. MAGEE, ESQUIRE
WEIL, GOTSCHAL & MANGES LLP
2001 M Street NW
Suite 600
Washington, DC 20024
202-682-7000

The above-entitled matter came on for hearing on September 5, 2019, commencing at 9:29 a.m., at the U.S. Patent and Trademark Office, USPTO Madison Building, 600 Dulany Street, Alexandria, VA 22314.

Case IPR2018-00933 (Patent 9,084,601 B2)
Case IPR2018-00934 (Patent 8,998,058 B2)
Case IPR2018-00935 (Patent 8,991,677 B2)₁

1 (Proceedings begin at 1:28 p.m.)

2 JUDGE COCKS: We're here today for consolidated oral
3 argument for three proceedings, IPR2018-00935, '934, and '935
4 involving three patents, 9,084,601, 8,998,058, and 8,991,677.

5 Would counsel for the Petitioner please introduce
6 themselves?

7 MR. O'CONNOR: Ryan O'Connor.

8 MR. KATZ: And Steven Katz, Petitioner's.

9 JUDGE COCKS: All right. Thank you.

10 And counsel for the Patent Owner?

11 MR. DESAI: Anish Desai.

12 MR. MAGEE: And Bob Magee.

13 JUDGE COCKS: All right. Thank you.

14 Now, as we set forth in the trial hearing order,
15 each side has 60 minutes of arguing time. The Petitioner will
16 present their case first for both the challenge claims and the
17 substitute claims and may reserve rebuttal time. The Patent
18 Owner will then argue its opposition to Petitioner's case, and
19 Patent Owner may reserve surrebuttal time. Patent Owner will
20 then -- I mean, Petitioner will then argue its rebuttal, and
21 we will conclude with Patent Owner arguing its surrebuttal.

22 So, Mr. O'Connor?

Case IPR2018-00933 (Patent 9,084,601 B2)
Case IPR2018-00934 (Patent 8,998,058 B2)
Case IPR2018-00935 (Patent 8,991,677 B2)₁

1 Actually, before you begin, a point of order. The --
2 there are several proceedings involving these saved parties
3 and this Panel that are before the Board, and there are
4 currently oral arguments set forth, September 18th and October
5 17th; is that correct?

6 MR. O'CONNOR: That's right. It's correct.

7 JUDGE COCKS: There was recently a request from
8 Petitioner to go ahead and consolidate cases on October 17th,
9 and the Panel was amenable. Did the Patent Owner have any
10 objection?

11 MR. DESAI: Yeah. No objection.

12 JUDGE COCKS: Okay. So that leaves one last point.
13 There's currently then one case scheduled for September 18th
14 that IPR2018-00936, the Panel wanted to inquire if there'd be
15 any procedural efficiency to argue that case on the 17th as
16 well. We are mindful, that would be five cases on the 17th,
17 which presents potentially understandable difficulty, but --

18 MR. DESAI: I just need to confirm that it works for
19 the person who is slotted to schedule it.

20 JUDGE COCKS: Okay.

21 MR. DESAI: To argue that one. But if that's the
22 case, we're okay with it.

Case IPR2018-00933 (Patent 9,084,601 B2)
Case IPR2018-00934 (Patent 8,998,058 B2)
Case IPR2018-00935 (Patent 8,991,677 B2)₁

1 JUDGE COCKS: Mr. O'Connor?

2 MR. O'CONNOR: No objection.

3 JUDGE COCKS: No objection?

4 MR. O'CONNOR: From our side.

5 JUDGE COCKS: After you have conferred, if you would
6 please go ahead and email the Board, indicating that that
7 would be okay?

8 MR. DESAI: Absolutely.

9 JUDGE COCKS: Okay.

10 All right. Mr. O'Connor, the podium is yours. Do
11 you wish to reserve any rebuttal time?

12 MR. O'CONNOR: Yes, Your Honor. We'd like to
13 reserve 30 minutes for rebuttal.

14 JUDGE COCKS: 30 minutes, okay.

15 MR. O'CONNOR: And I have hard copies of the slides,
16 if you'd like.

17 JUDGE COCKS: We will take them.

18 MR. O'CONNOR: Okay.

19 JUDGE COCKS: You may approach. Thank you. Thank
20 you. Whenever you are ready, you may begin.

21 MR. O'CONNOR: Thank you very much.

22 As you noted, Your Honor, the challenged patents are

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.