

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTUITIVE SURGICAL, INC.,  
Petitioner,

v.

ETHICON LLC,  
Patent Owner.

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IPR2018-01247  
Patent 8,479,969 B2

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Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

JUDGMENT  
Final Written Decision  
Determining Some Challenged Claims Unpatentable  
*35 U.S.C. § 318(a)*

## I. INTRODUCTION

Intuitive Surgical, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 19–26 of U.S. Patent No. 8,479,969 B2 (Ex. 1001, “the ’969 patent”). Ethicon LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. After the filing of the Petition, Patent Owner filed a statutory disclaimer of claim 23. Ex. 2002; *see* Prelim. Resp. 3–4. In our Decision on Institution (Paper 7, “Dec. on Inst.”), we determined that the information presented in the Petition and Preliminary Response established a reasonable likelihood that Petitioner would prevail in its challenge of claims 19–22 and 24–26<sup>1</sup> of the ’969 patent as unpatentable under 35 U.S.C. § 103 and, accordingly, we instituted *inter partes* review as to those claims. *See* 35 U.S.C. § 314(a) (2012).

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 14, “PO Resp.”), Petitioner filed a Reply to Patent Owner Response (Paper 18, “Pet. Reply”), and Patent Owner filed a Sur-reply to Petitioner’s Reply (Paper 25, “PO Sur-reply”). A combined hearing for this case and related cases IPR2018-01248 and IPR2018-01254 was held on October 17, 2019, and a transcript of the hearing is included in the record. Paper 37.

We have jurisdiction under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. To prevail, Petitioner must prove

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<sup>1</sup> In our Decision on Institution, we treated claim 23 as having never been part of the ’969 patent and did not institute *inter partes* review of this claim. *See* Dec. on Inst. 2, n. 1.

unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d) (2017).

This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 19–22 and 24–26 of the ’969 patent. For the reasons discussed below, we hold that Petitioner has demonstrated by a preponderance of the evidence that claims 19 and 20 of the ’969 patent are unpatentable under § 103(a). We also hold that Petitioner has not demonstrated by a preponderance of the evidence that claims 21, 22, and 24–26 of the ’969 patent are unpatentable under § 103(a).

## II. BACKGROUND

### A. *The ’969 Patent*

The ’969 patent issued July 9, 2013 from an application filed February 9, 2012, and claims priority, as a continuation, to an application filed May 27, 2011, which claims priority, as a continuation-in-part, to an application filed January 10, 2007. Ex. 1001, codes (45), (22), (63).<sup>2</sup> The ’969 patent is titled “Drive Interface for Operably Coupling a Manipulatable Surgical Tool to a Robot,” and generally relates to endoscopic surgical instruments. *Id.* at code (54), 1:54–57. The ’969 patent summarizes its disclosure as encompassing a surgical instrument “for use with a robotic system that has a control unit and a shaft portion,” which together with an electrically conductive elongated member, “transmit[s] control motions from the robotic system to an end effector.” *Id.* at code (57). Figure 26 of the ’969 patent is reproduced below:

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<sup>2</sup> The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 100 *et seq.* effective on March 16, 2013. Because the ’969 patent issued from an application filed before March 16, 2013, we apply the pre-

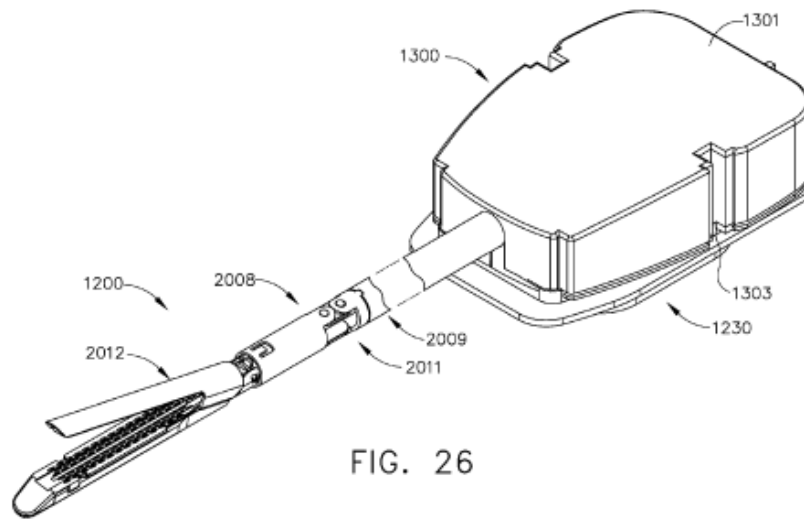


FIG. 26

Figure 26 depicts “a perspective view of a surgical tool embodiment of the present invention.” *Id.* at 5:19–20. Figure 26 illustrates surgical tool 1200 with end effector 2012, elongated shaft assembly 2008, and articulation joint 2011. *Id.* at 24:66–25:5. The ’969 patent describes that surgical tool 1200 is coupled to a robotic manipulator (not shown) by tool mounting portion 1300. *Id.* at 25:5–7.

Figure 31 of the ’969 patent is reproduced below:

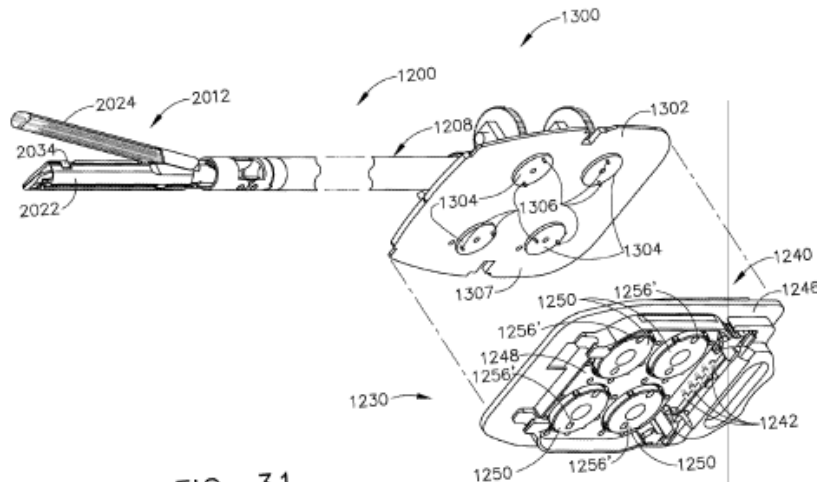


FIG. 31

AIA versions of the statutory bases for unpatentability.

Figure 31 depicts “a partial bottom perspective view of the surgical tool embodiment of FIG. 26.” *Id.* at 5:27–28. Figure 31 illustrates that “tool mounting portion 1300 includes a tool mounting plate 1302 that operably supports a plurality of (four are shown in FIG. 31) rotatable body portions, driven discs or elements 1304, that each include a pair of pins 1306 that extend from a surface of the driven element 1304.” *Id.* at 25:11–16. Figure 31 further depicts that “[i]nterface 1230 includes an adaptor portion 1240 that is configured to mountingly engage the mounting plate 1302.” *Id.* at 25:19–22. The ‘969 patent describes that “adapter portion 1240 generally includes a tool side 1244 and a holder side 1246.” *Id.* at 25:30–31.

Figure 27 of the ‘969 patent is reproduced below:

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