

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

INTUITIVE SURGICAL, INC.,  
Petitioner,

v.

ETHICON LLC,  
Patent Owner.

---

Case IPR2018-01247  
Patent 8,479,969 B2

---

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

MEYERS, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
35 U.S.C. § 314

## 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. We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Moreover, a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

Upon consideration of the Petition and the Preliminary Response, we conclude that the information presented shows there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim. Accordingly, we authorize an *inter partes* review to be instituted as to claims 19–22 and 24–26 of the ’969 patent on the grounds raised in the Petition.<sup>1</sup> Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far (prior to Patent Owner’s Response). This is not a final decision as to patentability of claims for which *inter partes* review is instituted. Any final decision will be based on the record, as fully developed during trial.

---

<sup>1</sup> Although the Petitioner initially sought to challenge claim 23 of the ’969 patent, Patent Owner has statutorily disclaimed that claim. *See* Ex. 2002. For the reasons discussed *infra*, claim 23 is no longer regarded as a claim challenged in the Petition.

## 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, and claims priority, as a continuation-in-part, to an application filed January 10, 2007. Ex. 1001, [45], [22], [63]. The '969 patent is titled “Drive Interface for Operably Coupling a Manipulatable Surgical Tool to a Robot,” and generally relates to endoscopic surgical instruments. Ex. 1001, [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.” Ex. 1001, [57]. Figure 26 of the '969 patent is reproduced below:

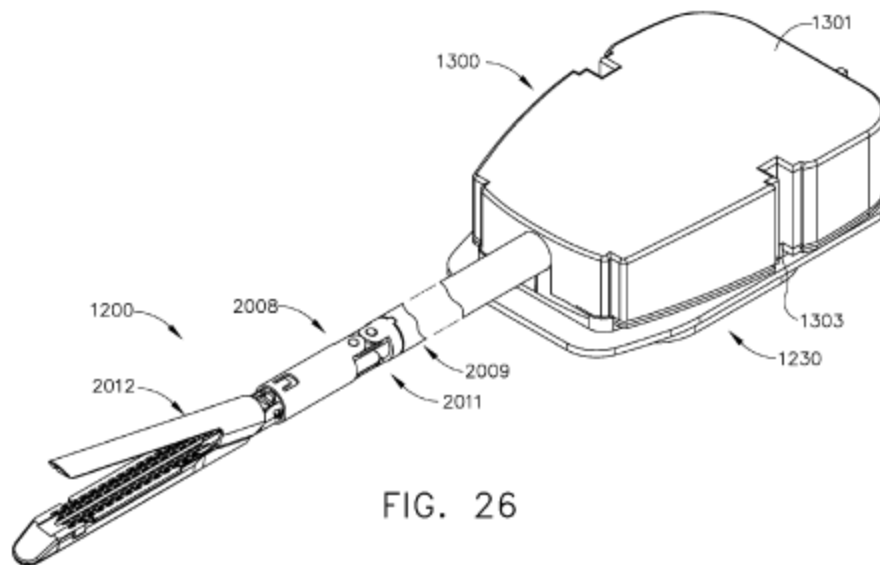


Figure 26 depicts “a perspective view of a surgical tool embodiment of the present invention.” Ex. 1001, 5:19–20. Figure 26 illustrates surgical tool 1200 with an end effector 2012, elongated shaft assembly 2008, and articulation joint 2011. Ex. 1001, 24:66–25:5. The '969 patent describes

that surgical tool 1200 is coupled to a robotic manipulator (not shown) by a tool mounting portion 1300. Ex. 1001, 25:5–7.

Figure 31 of the '969 patent is reproduced below:

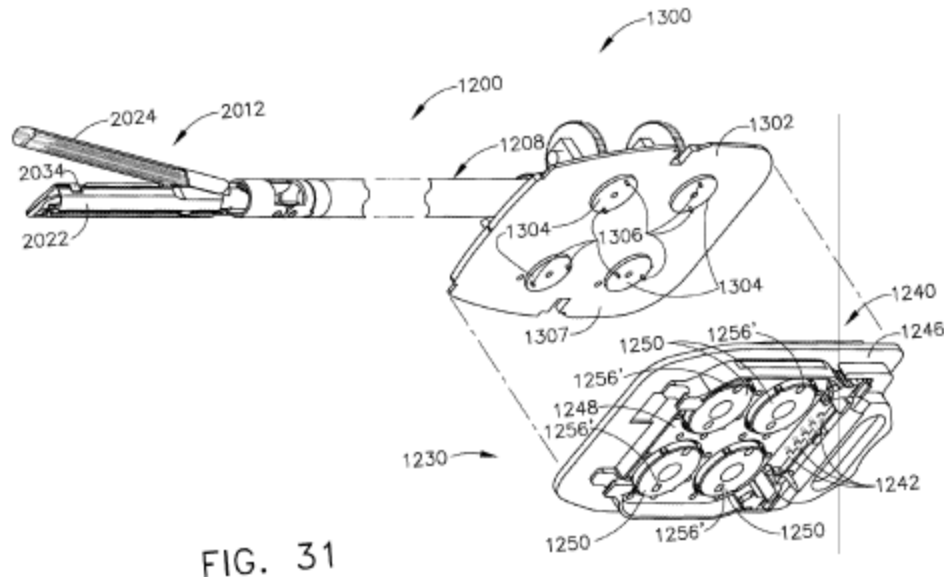


FIG. 31

Figure 31 depicts “a partial bottom perspective view of the surgical tool embodiment of FIG. 26.” Ex. 1001, 5:27–28. Figure 31 illustrates “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.” Ex. 1001, 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**.” Ex. 25:19–22. The '969 patent describes that “adaptor portion **1240** generally includes a tool side **1244** and a holder side **1246**.” Ex. 1001, 25:30–31.

Figure 27 of the '969 patent is reproduced below:

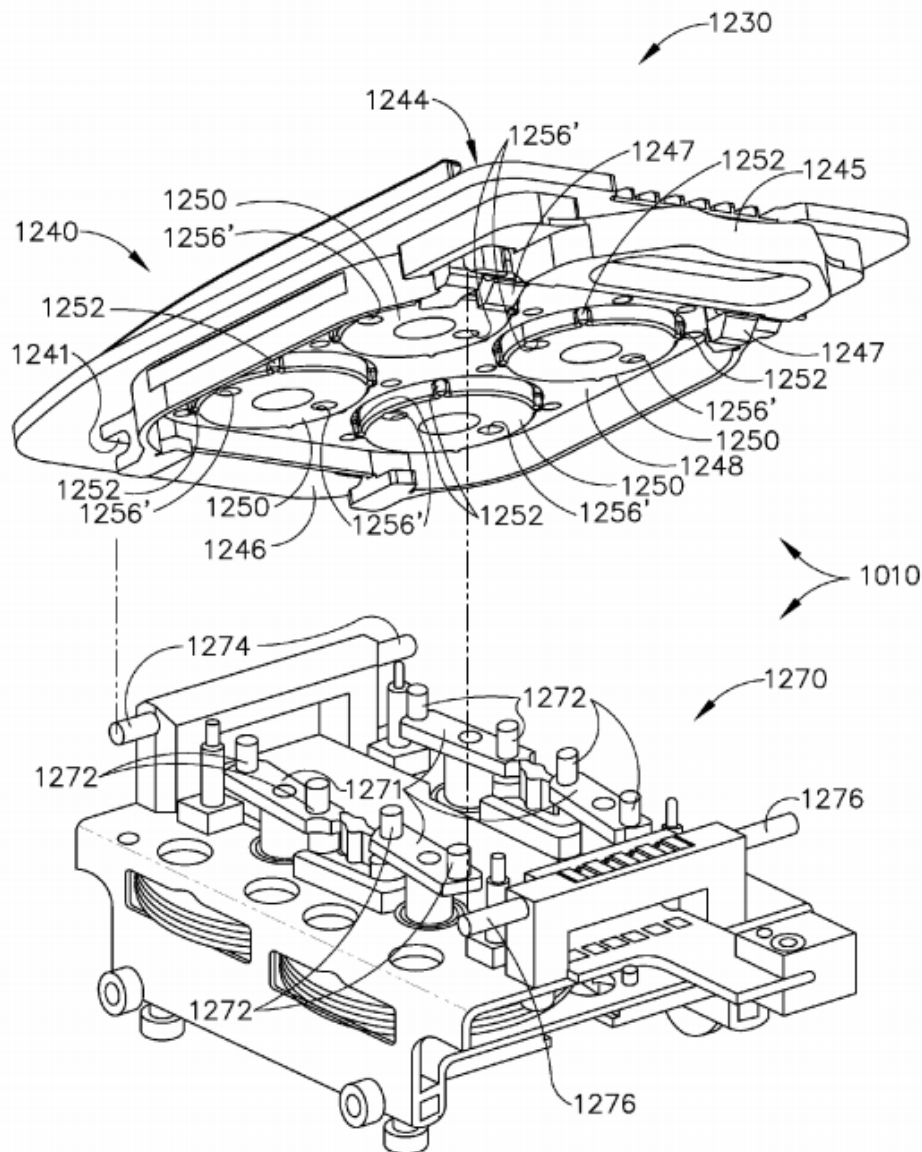


FIG. 27

Figure 27 depicts “an exploded assembly view of an adapter and tool holder arrangement for attaching various surgical tool embodiments to a robotic system.” Ex. 1001, 5:21–23. More particularly, Figure 27 illustrates that tool drive assembly 1010 “is operatively coupled to a master controller 1001.” Ex. 1001, 24:62–66.

# 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.