

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2018-01247
U.S. Patent No. 8,479,969

PATENT OWNER'S LIST OF IMPROPER REPLY ARGUMENTS

1. **Page 5, line 5 (the beginning of Section II.B) through page 8, line 2**

(“Petitioner has met its burden.”):

Petitioner makes new arguments concerning its *prima facie* burden to show how the limitation “tool mounting portion operably coupled to the distal end of the proximal spine portion” is disclosed by the prior art, whereas Petitioner’s only argument for this limitation in the Petition was: “Anderson’s tool mounting portion would be operably coupled to the distal end of the proximal spine portion of Timm’s shaft assembly via the structure of the distal spine portion itself.” *See* Petition at 52; Ex. 1004, ¶ 104 (same argument, except substituting “proximal spine portion itself” for “distal spine portion itself”).

2. **Page 8, line 14 (“Moreover, the cable ...”) through page 9, line 6**

(“This action requires the claimed operable coupling.”):

See item 1, above.

3. **Page 9, line 18 (“Accordingly, the Anderson/Timm combination ...”) through page 10, line 3 (“...and is used to lock the joint.”):**

See item 1, above.

Dated: August 14, 2019

Respectfully submitted,

/Anish R. Desai/

Anish R. Desai

Reg. No. 73,760

WEIL, GOTSHAL & MANGES LLP

767 Fifth Avenue

New York, NY 10153

T: 212-310-8730

E: anish.desai@weil.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on August 14, 2019, a copy of **PATENT OWNER'S LIST OF IMPROPER REPLY ARGUMENTS** and any accompanying exhibits was served by filing this document through the PTAB's E2E Filing System as well as delivering a copy via electronic mail upon the following:

Steven R. Katz
John C. Phillips
Ryan P. O'Connor
FISH & RICHARDSON
3200 RBC Plaza, 60 South Sixth Street
Minneapolis, MN 55402
katz@fr.com
phillips@fr.com
oconnor@fr.com

IPR11030-0049IP5@fr.com
PTABInbound@fr.com

/Timothy J. Andersen/
Timothy J. Andersen
Case Manager
Weil, Gotshal & Manges LLP
2001 M Street, N.W., Suite 600
Washington, DC 20036
T: 202-682-7075
E: timothy.andersen@weil.com