

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ETHICON LLC,)	
ETHICON ENDO-SURGERY, INC. and)	
ETHICON US LLC,)	
)	
Plaintiffs,)	
)	C.A. No. 17-871 (LPS) (CJB)
v.)	
)	
INTUITIVE SURGICAL, INC.,)	
INTUITIVE SURGICAL OPERATIONS,)	
INC. and INTUITIVE SURGICAL)	
HOLDINGS, LLC,)	
)	
Defendants.)	

**PLAINTIFFS’ NOTICE OF WAIVER OF APPEAL REGARDING THE COURT’S
ORDER INVALIDATING THE JANUARY 2018 CERTIFICATE OF
CORRECTION RELATING TO U.S. PATENT NO. 8,479,969**

During the claim construction phase of this case, Intuitive Surgical, Inc., Intuitive Surgical Operations, Inc., and Intuitive Surgical Holdings LLC (collectively “Intuitive”) argued that the Certificate of Correction issued in January 2018 relating to claim 24 of U.S. Patent No. 8,479,969 (“the ’969 Patent”) was invalid. D.I. 254 at 6. The Court’s claim construction order on December 28, 2018, adopted the original (uncorrected) claim language for claim 24, and ordered that the parties submit a joint status report on January 7, 2019 advising the Court how to proceed with respect to the Certificate of Correction. D.I. 255 at 1, 3. On February 11, 2019, after having considered the parties’ claim construction briefing and the joint status report, the Court adopted Intuitive’s position and issued an order invalidating the Certificate of Correction issued in January 2018 relating to claim 24 of the ’969 Patent. D.I. 292.

Separately, on June 14, 2018, Intuitive filed three petitions for *inter partes* review of the ’969 Patent. In each of the IPR petitions, Intuitive confirmed its position that the January 2018

Certificate of Correction was “ineffective” and presented invalidity arguments as to the obviousness of the original (uncorrected) claim language. *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01247, Paper No. 1 at 51 n.3; *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01248, Paper No. 1 at 62 n.4; *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01254, Paper No. 1 at 89 n.5. Ethicon filed its patent owner responses in the IPR petitions on April 19, 2019 and May 2, 2019. In the Patent Owner Responses, Ethicon informed the PTAB of this Court’s invalidation of the Certificate of Correction and addressed the issue of validity based on the original (uncorrected) claim language. On July 15, 2019, Intuitive filed its reply in two of the IPR petitions and requested that the PTAB **apply** the Certificate of Correction to the IPR proceeding. Intuitive argues that the District Court’s order invalidating the January 2018 Certificate of Correction is “not relevant to these [IPR] proceedings” and that the order “will be subject to appeal if and when the District Court renders judgment, and Patent Owner has specifically reserved the right to appeal the interlocutory order.” *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01247, Paper No. 18 at 4; *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01254, Paper No. 17 at 4. Thus, Intuitive is requesting that the PTAB apply the Certificate of Correction to the IPR proceedings and address **only** the issue of validity of the corrected claims on the basis that this Court’s February 11, 2019 order is not final.

Plaintiffs hereby waive the right to appeal the Court’s February 11, 2019 order invalidating the Certificate of Correction issued in January 2018 relating to claim 24 of the ’969 Patent.

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July 30, 2019

CERTIFICATE OF SERVICE

I hereby certify that on July 30, 2019, I caused the foregoing to be electronically filed with the Clerk of the Court using CM/ECF, which will send notification of such filing to all registered participants.

I further certify that I caused copies of the foregoing document to be served on July 30, 2019, upon the following in the manner indicated:

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