

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 REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70, Patent Owner Ethicon LLC respectfully submits this Request for Oral Argument. The Board has scheduled a single, consolidated oral hearing on October 17, 2019 for IPR2018-01247 and two related proceedings concerning U.S. Patent No. 8,479,969. *See* IPR2018-01247, Paper No. 29; IPR2018-01248, Paper No. 19; IPR2018-01254, Paper No. 32. Patent Owner specifies the following issues to be argued concerning IPR2018-01247:

- The alleged obviousness under 35 U.S.C. § 103 of claim 24 over Anderson (U.S. Patent No. 6,783,524) in view of Timm (U.S. Patent No. 7,510,107).
- The inapplicability of the January 2018 Certificate of Correction to this proceeding.
- The new, impermissible arguments in Petitioner's Reply that should be disregarded, as identified in Patent Owner's Sur-Reply and Patent Owner's List of Improper Reply Arguments (Paper No. 24).
- The alleged obviousness under 35 U.S.C. § 103 of claims 25-26 over Anderson in view of Timm and Wallace (U.S. Patent No. 6,699,235).
- The alleged obviousness under 35 U.S.C. § 103 of claims 19-20 over Anderson in view of Knodel (U.S. Patent No. 5,465,895).
- The alleged obviousness under 35 U.S.C. § 103 of claims 21-22 over

Anderson in view of Viola (U.S. Patent No. 5,954,259).

- Any other issue the Board deems necessary for issuing a Final Written Decision.

Patent Owner requests sixty minutes of time to address the issues identified above for IPR2018-01247 and the issues identified in Patent Owner's Requests for Oral Argument in IPR2018-01248 and IPR2018-01254. To the extent the Board schedules the hearing to last more than two hours, however, Patent Owner requests that it be given half the length of the hearing to address these issues.

Patent Owner requests that ten spaces be reserved at the oral hearing to accommodate its counsel and corporate representatives.

Date: September 12, 2019

Respectfully submitted,

/Anish R. Desai/

Anish R. Desai (Reg. No. 73,760)
Elizabeth S. Weiswasser (Reg. No. 55,721)
Weil, Gotshal & Manges LLP
767 Fifth Avenue
New York, NY 10153
Anish.Desai@weil.com
Elizabeth.Weiswasser@weil.com

Adrian Percer (Reg. No. 46,986)
Weil, Gotshal & Manges LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
Adrian.Percer@weil.com

Christopher T. Marando (Reg. No. 67,898)
Christopher M. Pepe (Reg. No. 73,851)
Weil, Gotshal & Manges LLP
2001 M Street, N.W., Suite 600
Washington, DC 20036
Christopher.Marando@weil.com
Christopher.Pepe@weil.com

Counsel for Patent Owner Ethicon LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 12, 2019, the foregoing
PATENT OWNER'S REQUEST FOR ORAL ARGUMENT was served 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
occonnor@fr.com

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

/Lauren McDuffie/ _____
Lauren McDuffie
Paralegal
Weil, Gotshal & Manges LLP
2001 M Street, N.W., Ste. 600
Washington, DC 20036
T: 202-682-7000
Lauren.McDuffie@weil.com