

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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Case IPR2018-01247  
Patent 8,479,969

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**PETITIONER'S UNOPPOSED MOTION FOR *PRO HAC VICE***

**ADMISSION OF ROGER A. DENNING**

**UNDER 37 C.F.R. § 42.10(c)**

**PETITIONER'S UPDATED EXHIBIT LIST**

- IS1001 U.S. Pat. No. 8,479,969 to Shelton, IV (“the ’969 Patent”)
- IS1002 Prosecution History of the ’969 Patent (Serial No. 13/369,609)
- IS1003 Reserved
- IS1004 Declaration of Dr. Bryan Knodel (Anderson as Primary Reference)
- IS1005 Reserved
- IS1006 Reserved
- IS1007 U.S. Patent No. 6,817,974 to Cooper et al. (“Cooper”)
- IS1008 U.S. Patent No. 6,699,235 to Wallace et al. (“Wallace”)
- IS1009 U.S. Patent No. 6,331,181 to Tierney et al. (“Tierney”)
- IS1010 U.S. Patent No. 6,783,524 to Anderson et al. (“Anderson”)
- IS1011 U.S. Patent No. 7,510,107 to Timm et al. (“Timm”)
- IS1012 U.S. Patent No. 5,465,895 to Knodel et al. (“Knodel”)
- IS1013 U.S. Patent No. 5,954,259 to Viola et al. (“Viola”)
- IS1014 U.S. Patent App. No. 2008/0167672 to Giordano et al.  
 (“Giordano”)
- IS1015 Reserved
- IS1016 Reserved

- IS1017 Supplemental Declaration of Dr. Bryan Knodel  
("Knodel Supp. Decl.")
- IS1018 Reserved
- IS1019 June 17, 2019 Deposition of Shorya Awtar for IPR2018-01247  
("Awtar Dep. I")
- IS1020 U.S. Pat. No. 9,820,768 to Gee et al. ("Gee")
- IS1021 Reserved
- IS1022 Reserved
- IS1023 June 6, 2019 Deposition of Frank Fronczak for IPR2018-00936  
("Fronczak Dep.")
- IS1024 Reserved
- IS1025 Reserved
- IS1026 District Court Complaint in *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, 1:17-cv-00871-LPS filed June 30, 2017
- IS1027 U.S. Pat. No. 7,524,320 to Tierney et al. ("Tierney 320")
- IS1028 Declaration of Roger A. Denning

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Pursuant to 37 C.F.R. § 42.10(c), Petitioner, Intuitive Surgical, Inc.

(“Petitioner”) respectfully requests that the Board recognize Roger A. Denning as counsel *pro hac vice* in this proceeding. Petitioner seeks the counsel of Mr. Denning due to his experience in representing Intuitive Surgical, Inc. in other patent-related matters and particularly due to his familiarity with the substantive and technical issues involved in this proceeding. This motion is authorized by the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response that was mailed on July 17, 2018.

Patent Owner does not oppose this motion.

### **Statement of Facts**

Mr. Denning is a patent litigation attorney with more than 20 years of experience representing clients in patent cases involving medical devices, software, micro-electronics, and life sciences. Mr. Denning litigates patent cases before various federal courts. Through his years of practice, Mr. Denning has gained substantial experience in jury trials, discovery, Markman hearings, and appeals. His declaration provides Appendix A, as evidence, with additional details of Mr. Denning’s biography.

Mr. Denning also has particular experience and familiarity with the substantive and technical issues involved in this *inter partes* review proceeding. Mr. Denning is counsel for Petitioner in International Trade Commission

Investigation No. 337-TA-1167, which includes U.S. Patent No. 8,479,969, the patent at issue in this *inter partes* review proceeding.

**Declaration of Individual Seeking to Appear**

This Motion for *Pro Hac Vice* Admission is accompanied by a Declaration of Roger A. Denning.

Accordingly, Intuitive Surgical, Inc. submits that there is good cause under 37 C.F.R. § 42.10(c) for the Board to recognize Roger A. Denning as counsel *pro hac vice* during this proceeding.

Dated: September 12, 2019

Respectfully submitted,

/Steven R. Katz/

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