

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 IPR2018-01248  
Patent 8,479,969 B2

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

COCKS, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

### *1. Introduction*

On January 17, 2020 a conference call was held between counsel for the respective parties and Judges Cocks, Meyers, and Wood. Intuitive Surgical, Inc. (“Petitioner”) was represented by Steven Katz. Ethicon LLC (“Patent Owner”) was represented by Anish Desi. Patent Owner requested the call seeking authorization to file a motion to terminate the proceeding.<sup>1</sup>

### *2. Discussion*

Trial was instituted in IPR2018-01248 on February 7, 2019 and concerns claims 24–26 of U.S. Patent No. 8,479,969 B2 (“the ’969 patent”). We have not yet entered a final written decision in IPR2018-01248. There is a related proceeding, IPR2018-01247, that also concerns claims 24–26 of the ’969 patent. A final written decision in IPR2018-01247 addressing claims 24–26 was entered on January 13, 2020. There is another related proceeding, IPR2018-01254, that concerns claim 24 of the ’969 patent. A final written decision in IPR2018-01254 addressing claim 24 was entered on January 13, 2020. Patent Owner contends that pursuant to 35 U.S.C. § 315(e)(1)<sup>2</sup>, Petitioner is prohibited from maintaining the IPR2018-01248 proceeding as to claims 24–26. Because those claims are the only claims involved in IPR2018-01248, Patent Owner believes termination of the IPR2018-01248 proceeding is appropriate.

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<sup>1</sup> Patent Owner had arranged for a court reporter on the call. When the transcript of the call becomes available the transcript should be filed as an exhibit in the proceeding.

<sup>2</sup> 35 U.S.C. § 315(e)(1) reads as follows:

**(e) Estoppel.**–

**(1) Proceedings before the office.**–The petitioner in an inter

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Petitioner does not agree with Patent Owner and is of the view that 35 U.S.C. § 315(e)(1) does not apply in this case because IPR2018-01247, IPR2018-001254, and IPR2018-01248 were filed on the same day (June 14, 2018). Petitioner directs our attention to prior Board proceedings *SK Hynix v. Netlist*, IPR2018-00364, (PTAB Aug. 5, 2019) and *Kingston v. SPEX*, IPR2018-01002 (PTAB Nov. 6, 2018) that Petitioner believes supports its view.

During the call, Patent Owner requested authorization to file a motion to terminate of no more than ten pages due no later than January 21, 2020. Petitioner expressed that if such a motion is permitted it requests authorization to file an opposition of no more than ten pages due no later than January 27, 2020. The panel believes that briefing from the parties pertaining to the above noted issue is warranted. Accordingly, the parties are authorized to file their requested briefings.

### 3. Order

It is

ORDERED that Patent Owner is authorized to file a motion to terminate of no more than ten pages due no later than January 21, 2020; and

FURTHER ORDERED that Petitioner is authorized to file an opposition of no more than ten pages due no later than January 27, 2020.

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partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

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