UNITED ST	ATES PATENT AND TRADEMARK OFFICE
BEFORE T	THE PATENT TRIAL AND APPEAL BOARD
	INTUITIVE SURGICAL, INC., Petitioner,
	V.
	ETHICON LLC, Patent Owner
	IPR2018-01248 U.S. Patent No. 8,479,969

PATENT OWNER ETHICON LLC'S MOTION TO TERMINATE



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## **TABLE OF AUTHORITIES**

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Cases
Clearlamp, LLC v. LKQ Corp., 2016 U.S. Dist. LEXIS 186028 (N.D. Ill. Mar. 18, 2016)
F'real Foods, LLC v. Hamilton Beach Brands, Inc., 2019 U.S. Dist. LEXIS 62547 (D. Del. Apr. 10, 2019)
IBM Corp. v. Intellectual Ventures II LLC, Case No. IPR2014-01465, Paper 32 (P.T.A.B. Nov. 6, 2015)10
Intuitive Surgical, Inc. v. Ethicon LLC, Case No. IPR2018-01247, Paper 40 (P.T.A.B. Jan. 13, 2020)
Intuitive Surgical, Inc. v. Ethicon LLC, Case No. IPR2018-01254, Paper 43 (P.T.A.B. Jan. 13, 2020)
Kingston v. SPEX, IPR2018-01002, Paper No. 12 (Nov. 6, 2018)
Novartis Pharm. Corp. v. Par Pharm., Inc., 2019 U.S. Dist. LEXIS 62489 (D. Del. Apr. 11, 2019)
Progressive Cas. Ins. Co. v. Liberty Mut. Ins. Co., 625 Fed. Appx. 552 (Fed. Cir. Aug. 24, 2015)
SAS Institute Inc. v. Iancu, 584 U.S, Case No. 19-969, slip op. (2018)
SiOnyx, LLC v. Hamamatsu Photonics K.K., 330 F. Supp. 3d 574 (D. Mass. 2018)
Sirona Dental Sys. v. Institut Strautmann AG, 892 F.3d 1349 (Fed. Cir. 2018)
SK Hynix Inc. v. Netlist Inc., Case No. IPR2018-00364, Paper 32 (P.T.A.B. August 5, 2019)



#### **Statutes**

35 U.S.C. § 315(e)(1)	
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37 C.F.R. § 42.122(a)	6

### **EXHIBIT LIST**

Exhibit #	Description
Ex. 2001	Excerpts of a technology tutorial filed in <i>Ethicon v. Intuitive Surgical</i> , C.A. No. 1-17:cv-871 (LPS) (CJB) (D. Del. June 28, 2018)
Ex. 2002	Patent Statutory Disclaimer for U.S. Patent No. 8,479,969 filed on October 15, 2018
Ex. 2003	[Reserved]
Ex. 2004	[Reserved]
Ex. 2005	[Reserved]
Ex. 2006	[Reserved]
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Ex. 2018	[Reserved]
Ex. 2019	[Reserved]
Ex. 2020	[Reserved]
Ex. 2021	Declaration of Dr. Shorya Awtar
Ex. 2022	Deposition Transcript of Dr. Bryan Knodel, IPR2018-01248, April 4, 2019



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