

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.

Petitioner,

v.

ETHICON, LLC,

Patent Owner.

CASE IPR2018-01248

U.S. Patent No. 8,479,969

Hearing - Conference Call

January 17, 2020

10:30 a.m.

---- Reporter: Desirea S. Jura ----

1 APPEARANCES:

2 For the Petitioner:

3 Fish & Richardson, PC

4 By Steven R. Katz, Esquire

5 By Roger Denning, Esquire

6 One Marina Park Drive

7 Boston, Massachusetts 02210-1878

8 (617) 521-7803

9 Katz@fr.com

10

11 For the Patent Owner:

12 Weil, Gotshal & Manges, LLP

13 By Anish R. Desai, Esquire

14 767 Fifth Avenue

15 New York, New York 10153-0119

16 (212) 310-8730

17 Anish.desai@weil.com

18

19 ALSO PRESENT: Dean Garner, Johnson & Johnson

20

21

22

1 P R O C E E D I N G S

2 JUDGE COX: Good morning. This is Judge  
3 Cox. I have with me on the call Judges Myers and  
4 Wood. Do we have counsel for the petitioner on the  
5 call?

6 MR. KATZ: Yes, Your Honor. This is  
7 Steven Katz and Roger Denning are on for petitioner.

8 JUDGE COX: Thank you, Mr. Katz.  
9 And do we have counsel for the patent  
10 owner?

11 MR. DESAI: Yes, Your Honor. This is  
12 Anish Desai for patent owner. Also on the call with  
13 me is Dean Garner from Johnson & Johnson.

14 JUDGE COX: Okay. Thank you, Mr. Desai.  
15 And it sounds like we have a court reporter; is that  
16 correct?

17 THE COURT REPORTER: Yes, sir.

18 MR. DESAI: That's correct, Your Honor.  
19 We arranged for a court reporter.

20 JUDGE COX: Thank you. If you could  
21 please file a transcript as an exhibit when it  
22 becomes available.

1 MR. DESAI: Absolutely.

2 JUDGE COX: Okay. Mr. Desai, you had, I  
3 think, requested this call in respect to a motion to  
4 terminate. So why don't you just give us a little  
5 background.

6 MR. DESAI: Sure. I will try to quickly  
7 frame the issue.

8 The 1240 IPR is one of three IPRs filed by  
9 petitioner challenging claim 24 of the '969 patent.  
10 It also challenges claims 25 and 26. The other two  
11 IPRs, the 1247 and the 1254, which Your Honors well  
12 know had filed a petition for issue on Monday,  
13 January 13th. As to claim 24, in addition, the 1247  
14 IPR final decision also addressed claims 25 and 26.

15 Patent owner's view is as a result of the  
16 final decision is the plain language of 35 USC  
17 315(e)(1), meaning that the 1248 IPR cannot proceed  
18 as far as the language is basically the petitioner  
19 and any third-party review of a claim in a patent may  
20 not request or maintain a proceeding before the  
21 office with respect to that claim on any ground that  
22 the petitioner raised or reasonably could have raised

1 during that interparty review.

2           There's basically two issues in our  
3 brief -- the motion to terminate. The first is  
4 whether the estoppel applies, whether the grounds  
5 raised in the 1243 IPR could have been raised for the  
6 1247 or the 1254 IPR. Numerous courts and the Board  
7 held that the reason they could have raised  
8 language -- in anticipation or obvious grounds based  
9 on patents or printed publication that the petitioner  
10 actually knew about or that a skilled researcher  
11 could have diligently located.

12           Here petitioner actually knew about Prisco  
13 and Cooper, which on the record that are in the 1248  
14 IPR. They're petitioner's own patent publications  
15 and they were asserting --

16           (Reporter interruption.)

17           MR. DESAI: I was talking about the motion  
18 of petitioner's where I think at least several months  
19 before the time that the IPRs were filed, the  
20 references were asserted and detailed charges -- our  
21 view is the estoppel applied -- first is that they  
22 could not have been raised because the statute

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.