

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

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO TERMINATE**

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I. RELIEF REQUESTED

Petitioner respectfully requests that Patent Owner's Motion be denied and that the Board issue its Final Written Decision ("FWD") in this proceeding.

II. INTRODUCTION

There is no basis to dismiss the proceeding because all three petitions challenging the '969 Patent were filed on the same day, and would have been filed as a single petition, but for the word count limit imposed by 37 C.F.R. § 42.24.

Significantly, Patent Owner fails to identify any authority where estoppel applied to multiple petitions filed **on the same day**. Indeed, no legitimate purpose would be served by such a rule. The purpose of statutory estoppel is to discourage a petitioner from filing a later petition **after** it files a first, in order to get two bites at the apple. This purpose would not be served by granting Patent Owner's Motion.

The legislative history makes this crystal clear. The estoppel of 35 U.S.C. § 315(e)(1) was intended to apply to "a **subsequent** PTO proceeding" to bar a party "from **later** using *inter partes* review or *ex parte* reexamination against the same patent, since the only issues that can be raised in an *inter partes* review or *ex parte* reexamination are those that could have been raised in the **earlier** post-grant or *inter partes* review." 157 Cong. Rec. S1376 (March 8, 2011) (statement of Sen. Kyle) (emphasis and italics added). Clearly, Congress did not intend to have this estoppel apply where multiple IPR petitions are filed simultaneously.

Here, the Board instituted review of the three simultaneously-filed petitions, and therefore all three should proceed to FWD pursuant to §318(a). Certainly, actions by Patent Owner or the Board should not impact the application of §318(a).

Specifically, a petitioner has control over the timing of its petitions, and the estoppel provision imposes consequences for petitioners who choose to file later, follow-on petitions. However, under Patent Owner's theories, even where a petitioner files simultaneous petitions, a Patent Owner could create an estoppel by choosing the timing of its Patent Owner Preliminary Responses—because it is that occurrence that triggers the institution deadline, which in turn triggers the final written decision deadlines. 35 U.S.C. § 314(b), 316(a)(11). It would be both peculiar and unjust to interpret the estoppel statute in a manner that would penalize Petitioner for actions taken by both the Patent Office (in timing the release of the FWDs), and Patent Owner (in timing the Preliminary Responses)—over which Petitioner has no control.¹

Moreover, the work of the parties here is done. In advance of the issuance

¹ Here, the consequences would be particularly unjust because Patent Owner first responded to the petitions with grounds based on Section 103, and only later filed a preliminary response to the Prisco petition which has a ground based on anticipation under Section 102.

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