

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2018-01248
Patent 8,479,969 B2

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

MEYERS, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Granting In Part Patent Owner's Motion to Terminate
Determining No Challenged Claims Unpatentable

35 U.S.C. § 318(a)

I. INTRODUCTION

Intuitive Surgical, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 23–26 of U.S. Patent No. 8,479,969 B2 (Ex. 1001, “the ’969 patent”). After the filing of the Petition, Ethicon LLC (“Patent Owner”) filed a statutory disclaimer of claim 23 (Ex. 2002) and a Preliminary Response (Paper 6) to the Petition. In our Decision on Institution (Paper 7, “Dec. on Inst.”), we determined that the information presented in the Petition and Preliminary Response established a reasonable likelihood that Petitioner would prevail in its challenge of claims 24–26 of the ’969 patent as unpatentable under 35 U.S.C. § 103 and, accordingly, we instituted *inter partes* review as to those claims. *See* 35 U.S.C. § 314(a) (2012).¹

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 13, “PO Resp.”), Petitioner filed a Reply to Patent Owner Response (Paper 16, “Pet. Reply”), and Patent Owner filed a Sur-reply to Petitioner’s Reply (Paper 17, “PO Sur-reply”). A combined hearing for the instant IPR2018-01248 (the “’248 IPR”) and related IPR2018-01247 (the “’247 IPR”) and IPR2018-01254 (the “’254 IPR”) was held on October 17, 2019, and a transcript of the hearing is included in the record. Paper 27.

On January 13, 2020, we issued a Final Written Decision in the ’247 IPR, concluding that Petitioner had shown by a preponderance of the evidence that claims 19 and 20 of the ’969 patent are unpatentable, but that Petitioner had not shown by a preponderance of the evidence that claims 21,

¹ In our Decision on Institution, we treated claim 23 as having never been part of the ’969 patent and did not institute *inter partes* review of this claim. *See* Dec. on Inst. 9–10.

IPR2018-01248
Patent 8,479,969 B2

22, and 24–26 of the '969 patent are unpatentable. *See* '247 IPR, Paper 40. At the same time, we issued a Final Written Decision in the '254 IPR, concluding that Petitioner had shown by a preponderance of the evidence that claims 1–10 of the '969 patent are unpatentable, but that Petitioner had not shown by a preponderance of the evidence that claims 11 and 24 of the '969 patent are unpatentable. *See* '254 IPR, Paper 43. Thus, all of the claims challenged in the instant '248 IPR have been subject to review and addressed in a final written decision under 35 U.S.C. § 318(a).

On January 21, 2020, Patent Owner filed an authorized motion to terminate the instant '248 IPR in consideration of estoppel under 35 U.S.C. § 315(e)(1) and our authority under 37 C.F.R. § 42.73(d)(1). Paper 31 (“Motion” or “Mot.”) On January 27, 2020, Petitioner filed an authorized opposition to Patent Owner’s Motion. Paper 33 (“Opp.”). For the reasons discussed below in Section III.A., we determine that § 315(e)(1) is applicable with respect to Petitioner’s participation in the challenge to claims 24–26 of the '969 patent, and as such, we grant Patent Owner’s Motion to the extent we terminate Petitioner from the '248 IPR, but we deny Patent Owner’s Motion to terminate the '248 IPR.

We have jurisdiction under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d) (2017).

This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 24–26 of the '969 patent. For the reasons discussed below, we conclude that Petitioner must be terminated from this

proceeding. We also hold that neither Petitioner, nor the record as a whole, has demonstrated by a preponderance of the evidence that claims 24–26 of the '969 patent are unpatentable under §§ 102(e) or 103(a).

II. BACKGROUND

A. The '969 Patent

The '969 patent issued July 9, 2013 from an application filed February 9, 2012, and claims priority, as a continuation, to an application filed May 27, 2011, which claims priority, as a continuation-in-part, to an application filed January 10, 2007. Ex. 1001, codes (45), (22), (63).² The '969 patent is titled “Drive Interface for Operably Coupling a Manipulatable Surgical Tool to a Robot,” and generally relates to endoscopic surgical instruments. *Id.* at code (54), 1:54–57. The '969 patent summarizes its disclosure as encompassing a surgical instrument “for use with a robotic system that has a control unit and a shaft portion,” which together with an electrically conductive elongated member, “transmit[s] control motions from the robotic system to an end effector.” *Id.* at code (57). Figure 26 of the '969 patent is reproduced below:

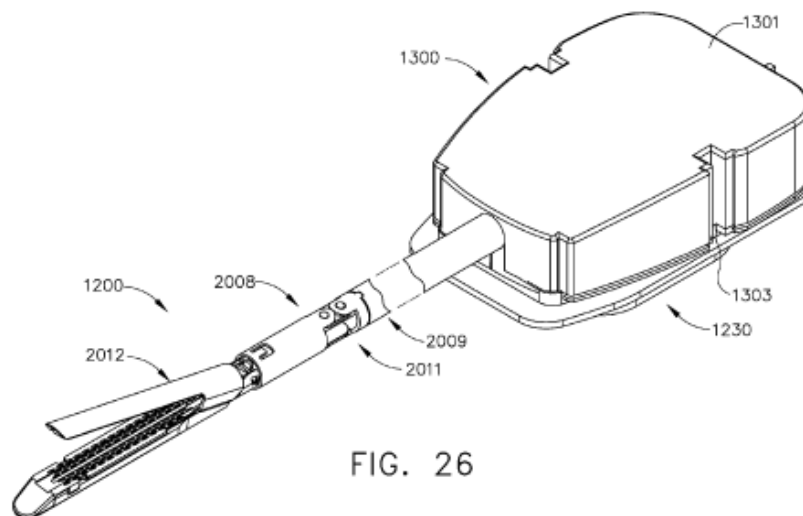


FIG. 26

Figure 26 depicts “a perspective view of a surgical tool embodiment of the present invention.” *Id.* at 5:19–20. Figure 26 illustrates surgical tool 1200 with end effector 2012, elongated shaft assembly 2008, and articulation joint 2011. *Id.* at 24:66–25:5. The ’969 patent describes that surgical tool 1200 is coupled to a robotic manipulator (not shown) by tool mounting portion 1300. *Id.* at 25:5–7.

Figure 31 of the ’969 patent is reproduced below:

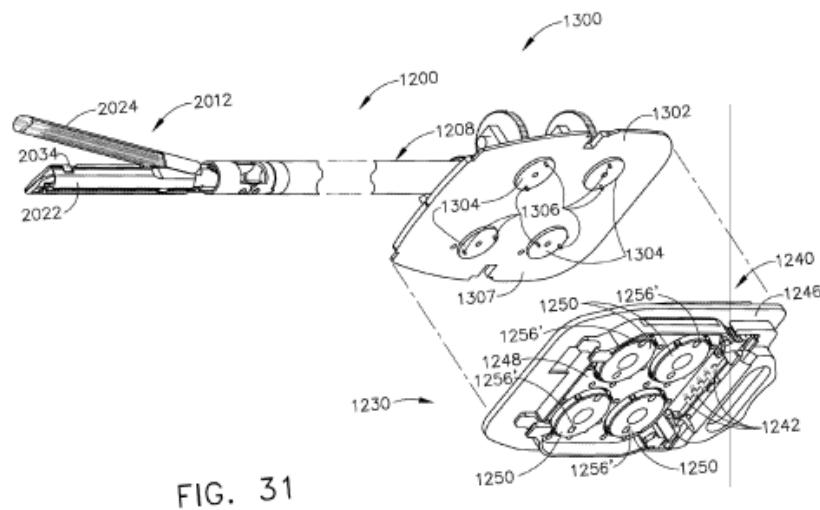


Figure 31 depicts “a partial bottom perspective view of the surgical tool embodiment of FIG. 26.” *Id.* at 5:27–28. Figure 31 illustrates that “tool mounting portion 1300 includes a tool mounting plate 1302 that operably supports a plurality of (four are shown in FIG. 31) rotatable body portions, driven discs or elements 1304, that each include a pair of pins 1306 that extend from a surface of the driven element 1304.” *Id.* at 25:11–16. Figure 31 further depicts that “[i]nterface 1230 includes an adaptor portion

² The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 100 *et seq.* effective on March 16, 2013. Because the ’969 patent issued from an application filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

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