

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
Patent 8,479,969 B2

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

MEYERS, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

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”). Ethicon LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Moreover, a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

Upon consideration of the Petition and the Preliminary Response, we conclude that the information presented shows there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim. Accordingly, we authorize an *inter partes* review to be instituted as to claims 24–26 of the ’969 patent on the grounds raised in the Petition.¹ Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far (prior to Patent Owner’s Response). This is not a final decision as to patentability of claims for which *inter partes* review is instituted. Any final decision will be based on the record, as fully developed during trial.

¹ Although the Petitioner initially sought to challenge claim 23 of the ’969 patent, Patent Owner has statutorily disclaimed that claim. *See* Ex. 2002. For the reasons discussed *infra*, claim 23 is no longer regarded as a claim challenged in the Petition.

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, and claims priority, as a continuation-in-part, to an application filed January 10, 2007. Ex. 1001, [45], [22], [63]. The '969 patent is titled “Drive Interface for Operably Coupling a Manipulatable Surgical Tool to a Robot,” and generally relates to endoscopic surgical instruments. Ex. 1001, [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.” Ex. 1001, [57]. Figure 26 of the '969 patent is reproduced below:

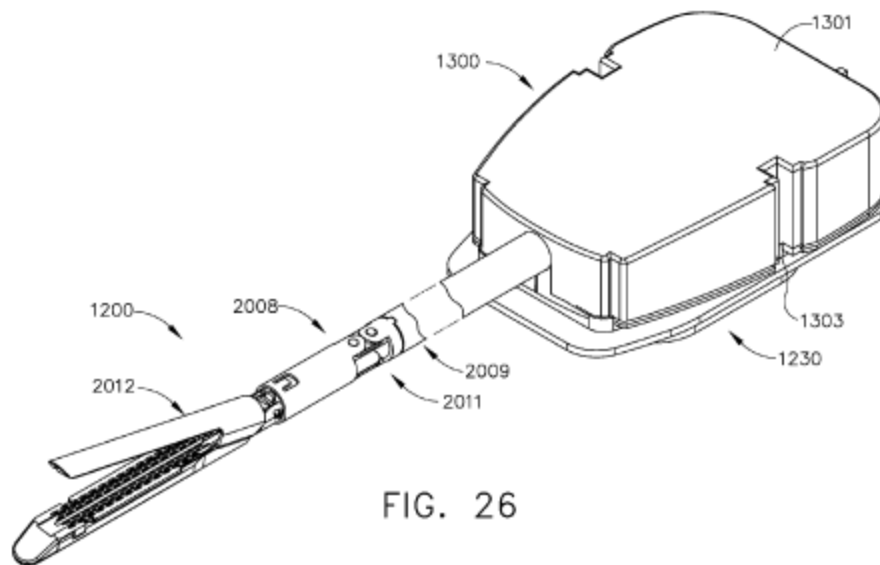


Figure 26 depicts “a perspective view of a surgical tool embodiment of the present invention.” Ex. 1001, 5:19–20. Figure 26 illustrates surgical tool 1200 with an end effector 2012, elongated shaft assembly 2008, and articulation joint 2011. Ex. 1001, 24:66–25:5. The '969 patent describes

that surgical tool 1200 is coupled to a robotic manipulator (not shown) by a tool mounting portion 1300. Ex. 1001, 25:5–7.

Figure 31 of the '969 patent is reproduced below:

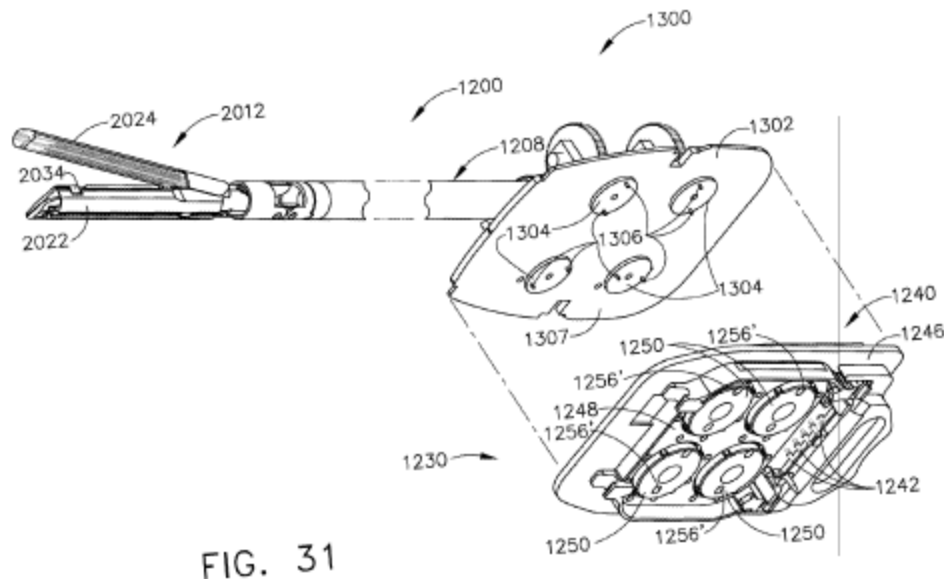


Figure 31 depicts “a partial bottom perspective view of the surgical tool embodiment of FIG. 26.” Ex. 1001, 5:27–28. Figure 31 illustrates “tool mounting portion **1300** includes a tool mounting plate **1302** that operably supports a plurality of (four are shown in FIG. 31) rotatable body portions, driven discs or elements **1304**, that each include a pair of pins **1306** that extend from a surface of the driven element 1304.” Ex. 1001, 25:11–16. Figure 31 further depicts that “[i]nterface **1230** includes an adaptor portion **1240** that is configured to mountingly engage the mounting plate **1302**.” Ex. 25:19–22. The '969 patent describes that “adaptor portion **1240** generally includes a tool side **1244** and a holder side **1246**.” Ex. 1001, 25:30–31.

Figure 27 of the '969 patent is reproduced below:

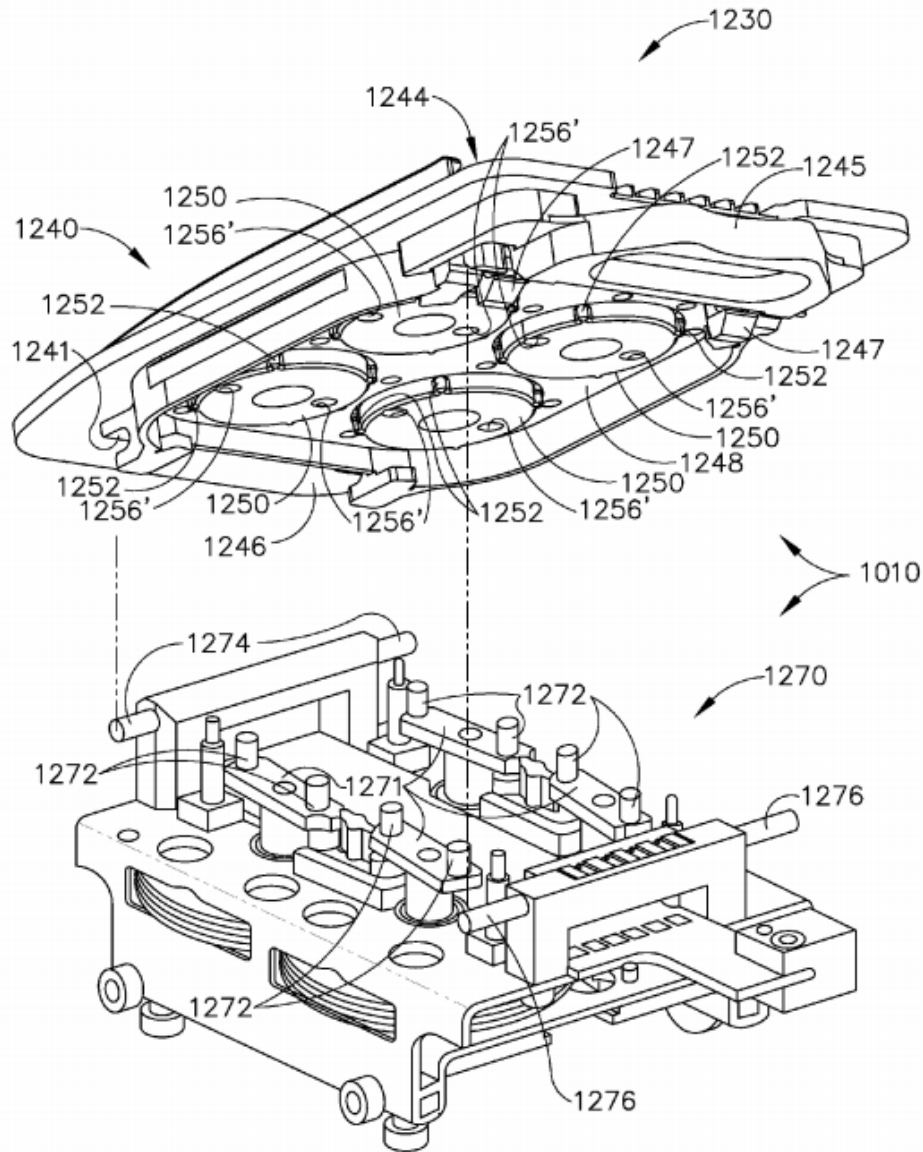


FIG. 27

Figure 27 depicts “an exploded assembly view of an adapter and tool holder arrangement for attaching various surgical tool embodiments to a robotic system.” Ex. 1001, 5:21–23. The '969 patent discloses that tool drive assembly 1010 “is operatively coupled to a master controller 1001.” Ex. 1001, 24:62–66.

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