

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

PATENT OWNER'S MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8

Patent Owner Ethicon LLC hereby submits its mandatory notices pursuant to 37 C.F.R. § 42.8(a)(2).

A. Real Party-In-Interest (37 C.F.R. § 42.8(b)(1))

Ethicon LLC (the assignee of U.S. Pat. No. 8,479,969 (“the 969 Patent”)) is an indirect subsidiary of Johnson & Johnson. Ethicon LLC has exclusively licensed Ethicon Endo-Surgery, Inc. to sell products in the United States that would infringe the 969 Patent absent a license. Ethicon Endo-Surgery, Inc. has exclusively sublicensed that right to Ethicon US, LLC. Ethicon US, LLC and Ethicon Endo-Surgery, Inc. are indirect subsidiaries of Johnson & Johnson.

B. Related Matters (37 C.F.R. § 42.8(b)(2))

Patent Owner identifies the following judicial and/or administrative matters that may be deemed related under 37 C.F.R. § 42.8(b)(2):

The 969 Patent is presently asserted in *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, C.A. No. 1:17-cv-00871-LPS (D. Del.) (“the Delaware litigation”). U.S. Pat. Nos. 9,585,658 (“the 658 Patent”), 8,616,431 (“the 431 Patent”), 9,113,874 (“the 874 Patent”), 9,084,601 (“the 601 Patent”), 8,991,677 (“the 677 Patent”), and 8,998,058 (“the 058 Patent”) are also asserted in the Delaware litigation.

The following petitions for *inter partes* review have been filed against the 969 Patent:

- IPR2018-01247
- IPR2018-01254

The 969 Patent is a continuation of U.S. Patent Application No. 13/118,259, now U.S. Patent No. 8,684,253, which is a continuation-in-part of U.S. Patent Application No. 11/651,807, now U.S. Patent No. 8,459,520.

No U.S. patents or applications claim priority to U.S. Patent Application No. 13/369,609, which issued as the 969 Patent.

The following additional U.S. patents and patent applications claim priority to one or more of the same application(s) to which the 969 Patent claims priority:

- U.S. Patent Application No. 13/026,493, now U.S. Pat. No. 8,517,243
- U.S. Patent Application No. 13/037,498 (abandoned)
- U.S. Patent Application No. 13/631,346, now U.S. Pat. No. 8,746,530
- U.S. Patent Application No. 14/176,671
- PCT/US12/39156
- U.S. Patent Application No. 14/303,049
- U.S. Patent Application No. 14/559,172
- U.S. Patent Application No. 14/559,188
- U.S. Patent Application No. 14/559,224
- U.S. Patent Application No. 14/559,251

- U.S. Patent Application No. 14/847,864
- U.S. Patent Application No. 14/848,557
- U.S. Patent Application No. 14/848,572
- U.S. Patent Application No. 15/140,671
- U.S. Patent Application No. 15/650,185
- U.S. Patent Application No. 15/652,621
- U.S. Patent Application No. 15/652,677
- U.S. Patent Application No. 15/652,916
- U.S. Patent Application No. 15/652,978
- U.S. Patent Application No. 15/653,073
- U.S. Patent Application No. 15/807,836
- U.S. Patent Application No. 15/808,327
- U.S. Patent Application No. 15/808,383

C. Lead and Back-Up Counsel and Service Information (37 C.F.R. § 42.8(b)(3)-(4))

Patent Owner identifies the following lead and back-up counsel and service information:

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