

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 REPLY TO
PATENT OWNER'S
RESPONSE**

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EXHIBITS

- IS1001 U.S. Pat. No. 8,479,969 to Shelton, IV (“the ’969 Patent”)
- IS1002 Prosecution History of the ’969 Patent (Serial No. 13/369,609)
- IS1003 Declaration of Dr. Bryan Knodel (Prisco as Primary Reference)
 (“Knodel Decl.”)
- IS1004 Reserved
- IS1005 Reserved
- IS1006 U.S. Pat. No. 8,545,515 to Prisco et al. (“Prisco”)
- IS1007 U.S. Pat. No. 6,817,974 to Cooper et al. (“Cooper”)
- IS1008 U.S. Pat. No. 6,699,235 to Wallace et al. (“Wallace”)
- IS1009 U.S. Pat. No. 6,331,181 to Tierney et al. (“Tierney”)
- IS1010 Reserved
- IS1011 Reserved
- IS1012 Reserved
- IS1013 Reserved
- IS1014 U.S. Pat. App. No. 2008/0167672 to Giordano et al. (“Giordano”)

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I. Introduction

Patent Owner does not dispute that Prisco’s “push-pull” embodiment combined with Cooper’s wrist discloses each limitation of the challenged claims. Accordingly, Petitioner has established anticipation (or at least obviousness). To avoid the inevitable finding of anticipation or obviousness, Patent Owner makes three arguments—all of which are meritless. Patent Owner first argues that Prisco does not incorporate Cooper’s wrist (even though it plainly does). Patent Owner next argues that Prisco teaches away from using Prisco’s “push-pull” embodiment in combination with Cooper’s wrist (when it plainly does not). And finally, Patent Owner argues that Cooper’s wrist is incorporated only for use with Prisco’s “pull-pull” instrument (when there is no such restriction in Prisco or Cooper), which Patent Owner asserts fails to disclose the gear limitations (even though it discloses a shaft roll gear). In sum, the challenged claims are either anticipated or rendered obvious by Prisco and its incorporated references.

II. Ground 1: Prisco discloses claim 24

A. Prisco discloses a push-pull surgical instrument with a wrist

1. *Prisco incorporates Cooper’s wrist as an optional embodiment*

Patent Owner first argues that Prisco cites Cooper for the purpose of specifically omitting Cooper’s wrist from Prisco. POR, 26-27. This novel theory is plainly wrong because Prisco specifically incorporates Cooper by reference (a

fact Patent Owner does not dispute); thus Prisco includes all of Cooper’s teachings. Incorporation is the opposite of omission.

A wrist to provide one or more end effector DOFs [degrees of freedom] (e.g., pitch, yaw; see e.g., U.S. Pat. No. 6,817,974 [Cooper] (filed Jun. 28, 2002) (disclosing “Surgical Tool Having Positively Positionable Tendon-Actuated Multi-Disk Wrist Joint”), which is incorporated herein by reference) **is optional** and is not shown.

Prisco, 10:43-48 (emphasis added throughout); *see also* Petition, 21 (same).

Far from saying Cooper’s wrist should not be used, Prisco actually states the opposite—that Cooper’s wrist is “optional”—meaning that it can be used, should a POSITA desire the benefits of the wrist. *Id.*; *see Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319, 1323 (Fed. Cir. 2005) (confirming that a reference disclosing optional inclusion of a particular component teaches compositions that both do and do not contain that component).

Prisco also discloses that instrument 110 includes a wrist. Prisco, 8:38-44, 16:38-44; Petition, 15-16, 52. Specifically, Prisco discloses that “actuation forces ... move various parts of instrument 110 in order to position, orient, and operate instrument end effector 234. Such actuation forces may typically ... **operate a wrist 236 that provides yaw and pitch DOF’s.**” Prisco, 8:34-44, Fig. 2B (emphasis added throughout unless otherwise noted); Petition, 15-16.

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