

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

PETITIONER'S UNOPPOSED MOTION FOR *PRO HAC VICE*

ADMISSION OF ROGER A. DENNING

UNDER 37 C.F.R. § 42.10(c)

PETITIONER’S UPDATED EXHIBIT LIST

- 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”)
- IS1015 Declaration of Roger A. Denning

Pursuant to 37 C.F.R. § 42.10(c), Petitioner, Intuitive Surgical, Inc.

(“Petitioner”) respectfully requests that the Board recognize Roger A. Denning as counsel *pro hac vice* in this proceeding. Petitioner seeks the counsel of Mr. Denning due to his experience in representing Intuitive Surgical, Inc. in other patent-related matters and particularly due to his familiarity with the substantive and technical issues involved in this proceeding. This motion is authorized by the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response that was mailed on August 9, 2018.

Patent Owner does not oppose this motion.

Statement of Facts

Mr. Denning is a patent litigation attorney with more than 20 years of experience representing clients in patent cases involving medical devices, software, micro-electronics, and life sciences. Mr. Denning litigates patent cases before various federal courts. Through his years of practice, Mr. Denning has gained substantial experience in jury trials, discovery, Markman hearings, and appeals. His declaration provides Appendix A, as evidence, with additional details of Mr. Denning’s biography.

Mr. Denning also has particular experience and familiarity with the substantive and technical issues involved in this *inter partes* review proceeding. Mr. Denning is counsel for Petitioner in International Trade Commission

Investigation No. 337-TA-1167, which includes U.S. Patent No. 8,479,969, the patent at issue in this *inter partes* review proceeding.

Declaration of Individual Seeking to Appear

This Motion for *Pro Hac Vice* Admission is accompanied by a Declaration of Roger A. Denning.

Accordingly, Intuitive Surgical, Inc. submits that there is good cause under 37 C.F.R. § 42.10(c) for the Board to recognize Roger A. Denning as counsel *pro hac vice* during this proceeding.

Dated: September 12, 2019

Respectfully submitted,

/Steven R. Katz/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on September 12, 2019, a complete and entire copy of this Petitioner's Motion for Pro Hac Vice and Exhibit 1015 were provided via email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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