IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

ETHICON LLC, *et al.*,	)	
	)	
Plaintiffs,	)	
	)	
v.	)	C.A. No. 17-871-LPS
	)	
INTUITIVE SURGICAL, INC., *et al.*,	)	
	)	
Defendants.	)	

DEFENDANTS' INVALIDITY CONTENTIONS

John W. Shaw (No. 3362)
Karen E. Keller (No. 4489)
David M. Fry (No. 5486)
SHAW KELLER LLP
I.M. Pei Building
1105 North Market Street, 12th Floor
Wilmington, DE 19801
(302) 298-0700
jshaw@shawkeller.com
kkeller@shawkeller.com
dfry@shawkeller.com
Attorneys for Defendants

OF COUNSEL:
Robert A. Van Nest
Brian Ferrall
R. Adam Lauridsen
William S. Hicks
Eduardo E. Santacana
KEKER VAN NEST & PETERS LLP
633 Battery Street
San Francisco, CA 94111
(415) 391-5400

Dated: March 20, 2018

I. PREFATORY STATEMENT

Pursuant to Court's Scheduling Order, Defendants Intuitive Surgical, Inc., Intuitive Surgical Operations, Inc., and Intuitive Surgical Holdings, LLC (collectively "Intuitive Surgical") hereby provide the following invalidity contentions based upon the information readily available to Intuitive Surgical as of this date. By these disclosures, Intuitive Surgical does not represent that it is identifying every item of prior art or other invalidity evidence possibly relevant to this lawsuit. Rather, these disclosures represent a good faith effort by Intuitive Surgical to identify information currently available to it as of this date. The Court has not yet construed the asserted claims, and Plaintiffs Ethicon LLC, Ethicon Endo-Surgery, Inc., and Ethicon US LLC (collectively "Ethicon") have not yet provided final infringement contentions as to the patents-in-suit.[1]

Intuitive Surgical reserves the right to amend, change, modify, supplement, or otherwise alter these contentions in a manner consistent with the Federal Rules of Civil Procedure, the Local Rules of Civil Practice and Procedure of the United States District Court for the District of Delaware, and the Court's orders in this matter.

Intuitive Surgical's contentions address and respond to only the claims from the Asserted Patents that Ethicon asserts in this case ("the Asserted Claims") and should not be deemed to suggest that any non-asserted claims of the patents-in-suit are valid, enforceable, or infringed.

As of March 20, 2018, the Asserted Claims are the following:

- Claims 1-14 of the '658 patent;

---

[1] "Patents-in-suit" refers collectively to United States Patent Nos. 9,585,658 ("the '658 Patent"), 8,479,969 ("the '969 Patent"), 9,113,874 ("the '874 Patent"), 8,998,058 ("the '058 Patent"), 8,991,677 ("the '677 Patent"), 9,084,601 ("the '601 Patent") and 8,616,431 ("the '431 Patent").

- Claims 23 and 24 of the ’969 patent;
- Claims 9 and 20 of the ’874 patent;
- Claims 6-18 of the ’058 patent
- Claims 6-15, 17 and 18 of the ’677 patent;
- Claims 1, 2, 8-10 of the ’601 patent;
- Claims 1, 2, 6, 13 of the ’431patent.

Intuitive Surgical’s investigation and analysis of the patents-in-suit, the accused technology, and the prior art remain ongoing. Ethicon’s February 18, 2018 infringement contentions are incomplete, inadequate, and unclear, because *inter alia* they fail to identify specifically where each limitation of each Asserted Claim is found within each accused instrumentality despite having Intuitive Surgical’s core technical production regarding the accused technology.

Intuitive Surgical also has not yet obtained requisite discovery from Ethicon or third parties, *e.g.*, named inventors, the prosecuting attorneys of the patents-in-suit, or sources and authors of prior art. Intuitive Surgical reserves all rights to supplement or otherwise modify these contentions based on developments in this case including continuing discovery, claim construction, evaluation of the scope and content of the prior art, changes in Ethicon’s Asserted Claims or Infringement Contentions, or for any other reason permitted by applicable law and the Court’s orders.

In addition, until such time as the Court provides its claim-construction rulings, Intuitive Surgical cannot be certain that its contentions incorporate the Court’s claim interpretation. In the interim, Intuitive Surgical’s contentions are based on the claim constructions apparently underlying the infringement contentions set forth in Ethicon’s infringement contentions, to the extent that such constructions are discernable. These contentions are not intended to, and do not,

reflect Intuitive Surgical's positions as to the proper construction of the Asserted Claims. To the extent that the contentions herein reflect an interpretation consistent with any construction adopted by Ethicon, no inference is intended nor should any be drawn that Intuitive Surgical agrees with Ethicon's claim constructions, and Intuitive Surgical expressly reserves its right to contest such constructions.

Further, no inference should be drawn that any Asserted Claim satisfies 35 U.S.C. § 112, and Intuitive Surgical reserves the right to contend that they do not (as detailed below). In particular, Intuitive Surgical reserves the right to contend that any of the Asserted Claims are indefinite, including under 35 U.S.C. § 112 to the extent claim limitations are construed as subject to means-plus-function interpretation under 35 U.S.C. § 112, paragraph 6 and the specification fails adequately to disclose corresponding structure for performing any such function recited in the claim.

In addition, all of the patents-in-suit claim priority to one or more earlier filed patent applications. In every case, Ethicon has claimed a conception and reduction to practice date based upon an earlier-filed patent application. To the extent that Ethicon seeks to rely upon any of these earlier filed patent applications, it carries the burden of establishing support in the earlier filed applications, and Intuitive Surgical reserves the right to contest any priority claim based upon the earlier filed applications. Further, to the extent that Ethicon does not rely on any of these earlier filed patent applications, then Intuitive Surgical reserves the right to amend its invalidity contentions to reflect the later priority date.

All of the contentions set forth below are made subject to the above qualifications.

I. IDENTIFICATION OF PRIOR ART

Intuitive Surgical lists below each item of prior art that anticipates and/or renders obvious one or more of the Asserted Claims. The list also includes items being relied upon to show

knowledge or use by others under § 102(a), public use or on-sale bar under § 102(b), derivation or prior inventorship under §§ 102(f)/(g), and the identity of persons or entities involved in and the circumstances surrounding the making of the claimed invention before Ethicon, including relevant dates to the extent presently known.

Issued Patents and Patent Applications
U.S. Patent No. 5,562,241 ("Knodel '241")
U.S. Patent No. 6,981,628 ("Wales")
U.S. Patent App. Pub. No. 2005/0006431 ("Shelton 2005")
U.S. Patent No. 5,662,667 ("Knodel '667")
U.S. Patent App. Pub. No. 2005/0178813 ("Swayze")
U.S. Patent No. 8,545,515 ("Prisco")
U.S. Patent No. 6,817,974 ("Cooper")
U.S. Patent App. Pub. No. 2009/0101692 ("Whitman 2009")
U.S. Patent App. Pub. No. 2011/0118709 ("Burbank")
U.S. Patent 6,783,524 ("Anderson")
U.S. Patent No. 5,383,880 ("Hooven")
U.S. Patent App. Pub. No. 2007/0023477 ("Whitman 2007")
U.S. Patent App. Pub. No. 2007/0175964 ("Shelton 2007")
U.S. Patent App. Pub. No. 2002/0165541 ("Whitman 2002")
U.S. Patent App. Pub. No. 2004/0094597 ("Whitman 2004")
U.S. Patent No. 8,241,322 ("Whitman '322)
U.S. Patent App. Pub. No. 2008/0167671 ("Giordano")
U.S. Patent App. Pub. No. 2003/0083673 ("Tierney 2003")
U.S. Patent No. 5,129,570 ("Schulze")
U.S. Patent No. 7,524,320 ("Tierney '320")
U.S. Patent No. 7,510,107 ("Timm")
U.S. Patent No. 5,779,130 ("Alesi")
U.S. Patent No. 5,865,361 ("Milliman")
U.S. Patent No. 7,097,089 ("Marczyk")
U.S. Patent No. 7,845.537 ("Shelton")

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.