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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

Hearing - Conference Call

January 17, 2020

10:30 a.m.

---- Reporter: Desirea S. Jura ----

1 APPEARANCES:

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19 ALSO PRESENT: Dean Garner, Johnson & Johnson

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21

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1 P R O C E E D I N G S

2 JUDGE COX: Good morning. This is Judge
3 Cox. I have with me on the call Judges Myers and
4 Wood. Do we have counsel for the petitioner on the
5 call?

6 MR. KATZ: Yes, Your Honor. This is
7 Steven Katz and Roger Denning are on for petitioner.

8 JUDGE COX: Thank you, Mr. Katz.
9 And do we have counsel for the patent
10 owner?

11 MR. DESAI: Yes, Your Honor. This is
12 Anish Desai for patent owner. Also on the call with
13 me is Dean Garner from Johnson & Johnson.

14 JUDGE COX: Okay. Thank you, Mr. Desai.
15 And it sounds like we have a court reporter; is that
16 correct?

17 THE COURT REPORTER: Yes, sir.

18 MR. DESAI: That's correct, Your Honor.
19 We arranged for a court reporter.

20 JUDGE COX: Thank you. If you could
21 please file a transcript as an exhibit when it
22 becomes available.

1 MR. DESAI: Absolutely.

2 JUDGE COX: Okay. Mr. Desai, you had, I
3 think, requested this call in respect to a motion to
4 terminate. So why don't you just give us a little
5 background.

6 MR. DESAI: Sure. I will try to quickly
7 frame the issue.

8 The 1240 IPR is one of three IPRs filed by
9 petitioner challenging claim 24 of the '969 patent.
10 It also challenges claims 25 and 26. The other two
11 IPRs, the 1247 and the 1254, which Your Honors well
12 know had filed a petition for issue on Monday,
13 January 13th. As to claim 24, in addition, the 1247
14 IPR final decision also addressed claims 25 and 26.

15 Patent owner's view is as a result of the
16 final decision is the plain language of 35 USC
17 315(e)(1), meaning that the 1248 IPR cannot proceed
18 as far as the language is basically the petitioner
19 and any third-party review of a claim in a patent may
20 not request or maintain a proceeding before the
21 office with respect to that claim on any ground that
22 the petitioner raised or reasonably could have raised

1 during that interparty review.

2 There's basically two issues in our
3 brief -- the motion to terminate. The first is
4 whether the estoppel applies, whether the grounds
5 raised in the 1243 IPR could have been raised for the
6 1247 or the 1254 IPR. Numerous courts and the Board
7 held that the reason they could have raised
8 language -- in anticipation or obvious grounds based
9 on patents or printed publication that the petitioner
10 actually knew about or that a skilled researcher
11 could have diligently located.

12 Here petitioner actually knew about Prisco
13 and Cooper, which on the record that are in the 1248
14 IPR. They're petitioner's own patent publications
15 and they were asserting --

16 (Reporter interruption.)

17 MR. DESAI: I was talking about the motion
18 of petitioner's where I think at least several months
19 before the time that the IPRs were filed, the
20 references were asserted and detailed charges -- our
21 view is the estoppel applied -- first is that they
22 could not have been raised because the statute

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