United States Court of Appeals for the Federal Circuit

INTUITIVE SURGICAL, INC.,
Appellant

v.

ETHICON LLC,
Appellee

ANDREW HIRSHFELD, PERFORMING THE FUNCTIONS AND DUTIES OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Intervenor

2020-1481

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2018-01248.

Decided: February 11, 2022

STEVEN KATZ, Fish & Richardson P.C., Boston, MA, argued for appellant. Also represented by RYAN PATRICK O'CONNOR, JOHN C. PHILLIPS, San Diego, CA.

ANISH R. DESAI, Weil, Gotshal & Manges LLP, New York, NY, argued for appellee. Also represented by ELIZABETH WEISWASSER; PRIYATA PATEL, CHRISTOPHER PEPE, Washington, DC.

SARAH E. CRAVEN, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED, MOLLY R. SILFEN.

Before O'MALLEY, CLEVENGER, and STOLL, *Circuit Judges*.

O'MALLEY, *Circuit Judge*.

Intuitive Surgical, Inc. ("Intuitive") appeals from a final written decision of the Patent Trial and Appeal Board ("Board") upholding the patentability of claims 24–26 of U.S. Patent No. 8,479,969. *See Intuitive Surgical, Inc. v. Ethicon LLC*, No. IPR2018-01248, 2020 WL 594140 (P.T.A.B. Feb. 6, 2020).

The threshold question is whether Intuitive is authorized by statute to pursue this appeal. That question turns on whether the Board erred in finding Intuitive estopped from maintaining this inter partes review ("IPR") proceeding and terminating Intuitive as a party under 35 U.S.C. § 315(e)(1). *Id.* at *4. We hold that the Board did not err and, thus, dismiss Intuitive's appeal. Accordingly, we do not reach the merits of the Board's final written decision upholding the patentability of claims 24–26 of the '969 patent.

I. BACKGROUND

The '969 patent is entitled "Drive Interface for Operably Coupling a Manipulatable Surgical Tool to a Robot." It relates to a robotically controlled endoscopic surgical instrument, which is a commonly used tool in minimally invasive surgery procedures.

On June 14, 2018, Intuitive filed three petitions—IPR2018-01247 ("the Timm/Anderson IPR"), IPR2018-01248 ("the Prisco/Cooper IPR"), and IPR2018-01254 ("the Giordano/Wallace IPR")—to challenge the patentability of certain claims of the '969 patent. All three IPRs challenged the patentability of claim 24 but relied on different prior art references in doing so. The Board instituted the Timm/Anderson and Giordano/Wallace IPRs in January 2019, then instituted the Prisco/Cooper IPR the following month.

In the Timm/Anderson IPR, Intuitive argued that claim 24 would have been obvious over U.S. Patent No. 6,783,524 ("Anderson") in view of U.S. Patent No. 7,510,107 ("Timm").[1] Intuitive also argued that claims 25 and 26 would have been obvious over Anderson and Timm, in further view of U.S. Patent No. 6,699,235 ("Wallace").[2] In the Giordano/Wallace IPR, Intuitive argued that claim 24 would have been obvious over U.S. Patent Application Publication No. 2008/0167672 ("Giordano") in view of Wallace.[3] On January 13, 2020, the Board issued final

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[1] Anderson, entitled "Robotic Surgical tool with Ultrasound Cauterizing and Cutting Instrument," describes a robotic surgical tool with an end effector that includes an ultrasound probe tip for cutting and cauterizing tissue. Timm, entitled "Cable Driven Surgical Stapling and Cutting Instrument with Apparatus for Preventing Inadvertent Cable Disengagement," describes a handheld surgical stapler with active and passive articulation joints.

[2] Wallace, entitled "Platform Link Wrist Mechanism," claims a robotically controlled surgical stapler and discloses the same robotic elements and similar non-robotic elements as the '969 patent.

[3] Giordano, entitled "Surgical Instrument with Wireless Communication Between Control Unit and Remote Sensor," discloses an articulation pivot and an

written decisions in both the Timm/Anderson and Giordano/Wallace IPRs, upholding the patentability of claim 24 in the face of the prior art cited there.[4] The Timm/Anderson IPR also upheld the patentability of claims 25 and 26.

In the Prisco/Cooper IPR, Intuitive argued that claims 24–26 are anticipated by U.S. Patent No. 8,545,515 ("Prisco").[5] The Prisco/Cooper IPR remained ongoing as of the January 13, 2020, final written decisions in the Timm/Anderson and Giordano/Wallace IPRs. On January 21, 2020, Ethicon filed a motion to terminate Intuitive as a party to the Prisco/Cooper IPR, arguing that Intuitive was estopped from proceeding with that IPR under 35 U.S.C. § 315(e)(1) by virtue of the January 13, 2020, decisions in the companion IPRs. On February 6, 2020, the Board issued a final written decision concurrently terminating Intuitive as a petitioner to the Prisco/Cooper IPR pursuant to § 315(e)(1) and upholding the patentability of claims 24–26 on the merits. Specifically, the Board concluded that § 315(e)(1) estopped Intuitive from maintaining the Prisco/Cooper IPR after final written decisions on the patentability of claims 24–26 were issued in the other proceedings. Among other things, the Board concluded that § 315(e)(1) did not preclude estoppel from applying where simultaneous petitions were filed by the same petitioner on the same claim.

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articulation control, which allow the surgical tool to bend relative to the shaft.

[4] In a companion opinion issued contemporaneously with this opinion on this same date, we affirm the Board's decisions in both of those IPRs.

[5] Prisco, entitled "Curved Cannula Surgical System," claims flexible endoscopic surgery instruments that extend into the surgical site through a curved cannula.

Intuitive timely appeals to this court.

II. DISCUSSION

Only a party to an IPR may appeal a Board's final written decision. *See* 35 U.S.C. § 141(c) ("A party to an inter partes review . . . who is dissatisfied with the final written decision . . . may appeal."). Section 319 of Title 35 repeats that limitation. And 28 U.S.C. § 1295(a)(4)(A) makes clear that we may review a Board's decision only "at the instance of a party." Despite this limitation, Intuitive argues it may pursue an appeal from the Board's patentability determination in this IPR. It bases this assertion on its claim that the Board misinterpreted 35 U.S.C. § 315(e)(1) when it concluded Intuitive was estopped from maintaining the Prisco/Cooper IPR. It argues that § 315(e)(1) estoppel should not apply to simultaneously filed petitions. Intuitive argues, moreover, that it may appeal the merits of the Board's final written decision on the patentability of claims 24–26 because, even if the Board's estoppel decision is not erroneous, Intuitive was once "a party to an inter partes review" and is dissatisfied with the Board's final decision within the meaning of § 319. As explained in sections B and C below, we find Intuitive's arguments unpersuasive.

A.

Neither the parties nor the U.S. Patent and Trademark Office ("PTO") dispute our jurisdiction to review the Board's estoppel decision. Section 1295(a)(4)(A) of Title 28 provides us with jurisdiction over "an appeal from a decision of . . . the Patent Trial and Appeal Board . . . with respect to a[n] . . . inter partes review under title 35." We have held that the plain language of § 1295(a)(4)(A) permits appeal where the adverse judgment is a "decision of the Board . . . 'with respect to' an inter partes review proceeding . . . [and] also final, as the judgment terminate[s] the IPR proceeding" with respect to a party. *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1348 (Fed. Cir. 2018). A decision is considered final "when it terminates

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