

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2018-01254
Patent 8,479,969 B2

Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Intuitive Surgical, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–11 and 24 of U.S. Patent No. 8,479,969 B2 (Ex. 1001, “the ’969 patent”). Ethicon LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Moreover, a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

Upon consideration of the Petition and the Preliminary Response, we conclude that the information presented shows there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim. As explained in our discussion below, we do not find a sufficient basis to use our discretion to deny institution under 35 U.S.C. § 325(d), and as such, we authorize an *inter partes* review to be instituted as to claims 1–11 and 24 of the ’969 patent on the ground raised in the Petition. Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far (prior to Patent Owner’s Response). This is not a final decision as to patentability of claims for which *inter partes* review is instituted. Any final decision will be based on the record, as fully developed during trial.

II. BACKGROUND

A. The '969 Patent

The '969 patent issued July 9, 2013 from an application filed February 9, 2012, and claims priority, as a continuation, to an application filed May 27, 2011, which claims priority, as a continuation-in-part, to an application filed January 10, 2007. Ex. 1001, [45], [22], [63]. The '969 patent is titled “Drive Interface for Operably Coupling a Manipulatable Surgical Tool to a Robot,” and generally relates to endoscopic surgical instruments. Ex. 1001, [54]; 1:54–57. The '969 patent summarizes its disclosure as encompassing a surgical instrument “for use with a robotic system that has a control unit and a shaft portion,” which together with an electrically conductive elongated member, “transmit[s] control motions from the robotic system to an end effector.” Ex. 1001, [57]. Figure 26 of the '969 patent is reproduced below:

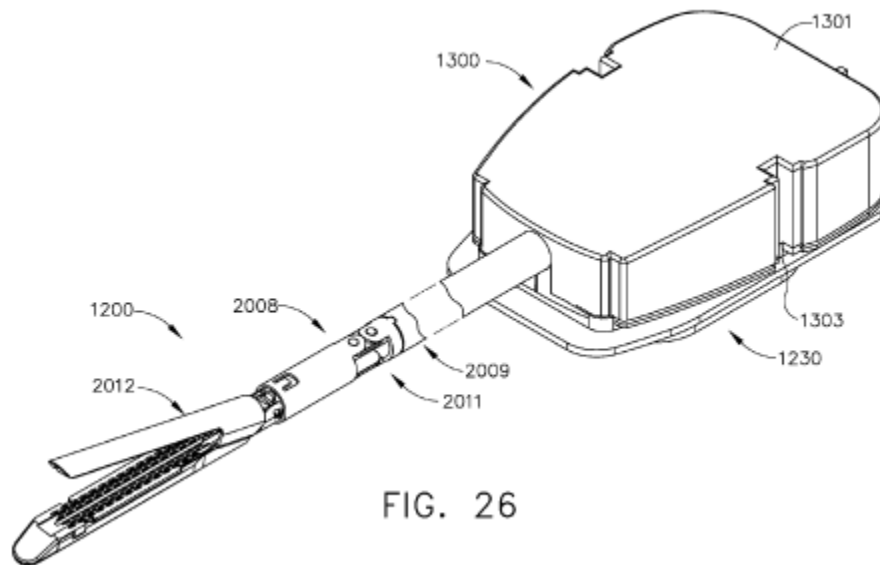


Figure 26 depicts “a perspective view of a surgical tool embodiment of the present invention.” Ex. 1001, 5:19–20. Figure 26 illustrates surgical tool 1200 with an end effector 2012, elongated shaft assembly 2008, and articulation joint 2011. Ex. 1001, 24:66–25:5. The '969 patent describes

that surgical tool 1200 is coupled to a robotic manipulator (not shown) by a tool mounting portion 1300. Ex. 1001, 25:5–7.

Figure 31 of the '969 patent is reproduced below:

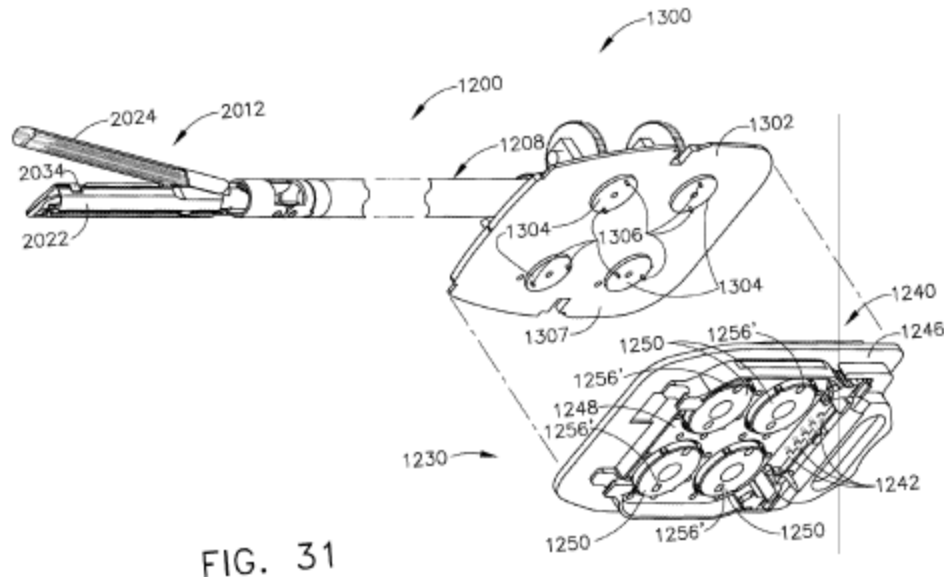


Figure 31 depicts “a partial bottom perspective view of the surgical tool embodiment of FIG. 26.” Ex. 1001, 5:27–28. Figure 31 illustrates “tool mounting portion **1300** includes a tool mounting plate **1302** that operably supports a plurality of (four are shown in FIG. 31) rotatable body portions, driven discs or elements **1304**, that each include a pair of pins **1306** that extend from a surface of the driven element 1304.” Ex. 1001, 25:11–16. Figure 31 further depicts that “[i]nterface **1230** includes an adaptor portion **1240** that is configured to mountingly engage the mounting plate **1302**.” Ex. 25:19–22. The ‘969 patent describes that “adaptor portion **1240** generally includes a tool side **1244** and a holder side **1246**.” Ex. 1001, 25:30–31.

Figure 27 of the '969 patent is reproduced below:

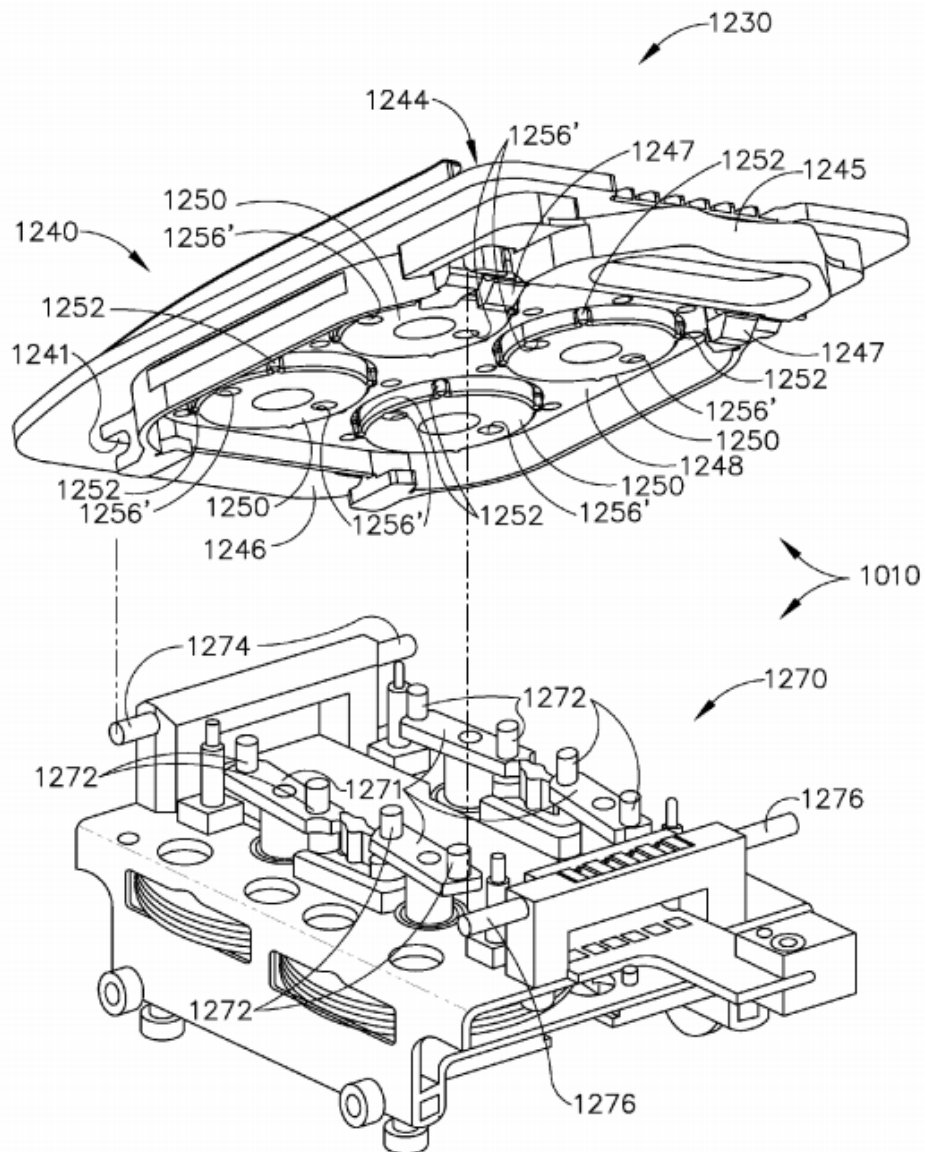


FIG. 27

Figure 27 depicts “an exploded assembly view of an adapter and tool holder arrangement for attaching various surgical tool embodiments to a robotic system.” Ex. 1001, 5:21–23. More particularly, Figure 27 illustrates that tool drive assembly 1010 “is operatively coupled to a master controller 1001.” Ex. 1001, 24:62–66.

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