

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner

IPR2018-01254
U.S. Patent No. 8,479,969

PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

	Page
I. INTRODUCTION.....	1
II. THE 969 PATENT	4
III. CLAIM CONSTRUCTION	10
IV. THE PRIOR ART.....	11
A. Giordano.....	11
B. Shelton.....	13
C. Wallace.....	15
D. Tierney	16
V. THE CHALLENGED CLAIMS ARE PATENTABLE	17
A. Claim 24: Combining Shelton’s Endocutter With Giordano’s Articulation Mechanism Fails To Disclose Or Render Obvious Limitation 24.3 (“wherein said surgical tool further comprises: a tool mounting portion operably coupled to a distal end of said proximal spine portion, said tool mounting portion being configured to operably interface with the tool drive assembly when coupled thereto”).....	17
B. Claims 11 and 24: A POSITA Would Not Have Been Motivated to Make Petitioner’s Alternative Combination of Shelton’s Stapler with Wallace’s Platform Wrist	21
1. Combining Shelton’s Endocutter With Wallace’s Wrist Mechanism And Tool Drive Would Have Resulted In An Inoperable Device Because Shelton’s Firing Mechanism Is Incompatible With Wallace’s Wrist	23
2. Combining Shelton’s Endocutter With Wallace’s Wrist Mechanism And Tool Drive Requires More Control Inputs Than Are Available in Wallace/Tierney	25

C.	Claims 11 and 24: A POSITA Would Have Been Deterred From Making Any Of Petitioner’s Proposed Combinations	27
D.	Claims 11 and 24: A POSITA Would Not Have Had A Reasonable Expectation of Success.....	31
1.	Petitioner Fails To Show A Reasonable Expectation Of Success	32
2.	A POSITA Would Have Recognized That Combining Giordano Or Shelton’s Handheld Endocutter With Wallace Or Tierney’s Tool Base Would Have Required A Significant Redesign to Provide Sufficient Forces for the Endocutter.....	34
3.	Publications from Patent Owner and Petitioner Confirm that a POSITA Would Have Lacked a Reasonable Expectation Of Success.....	37
E.	Claims 1-10: A POSITA Would Have Been Deterred From Combining The References As Petitioner Proposes	41
F.	Claims 1-10: A POSITA Would Not Have Had A Reasonable Expectation Of Success In Combining The References As Petitioner Proposes	41
VI.	CONCLUSION	42

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Samsung Elecs. Co.</i> , 839 F.3d 1034 (Fed. Cir. 2016) (<i>en banc</i>)	27
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	22
<i>Compass Bank v. Intellectual Ventures II</i> , IPR2014-00786, Paper 46 (P.T.A.B Sept. 23, 2015)	33
<i>Corning Inc. v. DSM IP Assets</i> , IPR2013-00050, Paper 77 (P.T.A.B. May 1, 2014).....	33
<i>Kinetic Concepts, Inc. v. Smith & Nephew, Inc.</i> , 688 F.3d 1342 (Fed. Cir. 2012)	32
<i>Polaris Indus., Inc. v. Arctic Cat, Inc.</i> , 882 F.3d 1056 (Fed. Cir. 2018)	27
Other Authorities	
37 C.F.R. § 42.23(b)	19
37 C.F.R. § 42.65(a)	33
37 C.F.R. § 42.100(b)	10

EXHIBIT LIST

Exhibit #	Description
2001	Excerpts of a technology tutorial filed in <i>Ethicon v. Intuitive Surgical</i> , C.A. No. 1-17:cv-871 (LPS) (CJB) (D. Del. June 28, 2018)
2002	U.S. Patent No. 7,691,098
2003	U.S. Patent No. 7,524,320
2004	U.S. Patent No. 6,783,524
2005	Declaration of Dr. Shorya Awtar
2006	[Reserved]
2007	[Reserved]
2008	[Reserved]
2009	Mucksavage et al., Differences in Grip Forces Among Various Robotic Instruments and da Vinci Surgical Platforms, <i>Journal Of Endourology</i> , Vol. 25, No. 3 (March 2011)
2010	[Reserved]
2011	Deposition Transcript of Bryan Knodel, IPR2018-01254, April 4, 2019
2012	U.S. Patent No. 8,640,788
2013	Order Invalidating the January 2018 Certificate of Correction Relating to U.S. Patent No. 8,479,969, <i>Ethicon v. Intuitive Surgical, Inc.</i> , C.A. No. 17-871 (D. Del. Feb. 11, 2019)
2014	WIPO Publication No. 2015/153642 A1
2015	U.S. Patent No. 8,186,555
2016	U.S. Patent No. 5,307,976
2017	Hermann Mayer et al., Haptic Feedback in a Telepresence System for Endoscopic Heart Surgery, <i>Presence</i> , Vol. 16, No. 5, pp. 459-470 (October 2007).
2018	Allison M. Okamura, Haptic feedback in robot-assisted minimally invasive surgery, <i>Current Opinion in Urology</i> , 19:102-107 (2009).
2019	U.S. Patent Application Publication No. 2012/0209314
2020	[Reserved]

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.