

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
U.S. Patent No. 8,479,969

**PATENT OWNER'S UPDATED MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8**

Patent Owner Ethicon LLC hereby submits the following updated mandatory notices pursuant to 37 C.F.R. § 42.8(a)(2).

A. Real Party-In-Interest (37 C.F.R. § 42.8(b)(1)) - Unchanged

Ethicon LLC (the assignee of U.S. Pat. No. 8,479,969 (“the 969 Patent”)) is an indirect subsidiary of Johnson & Johnson. Ethicon LLC has exclusively licensed Ethicon Endo-Surgery, Inc. to sell products in the United States that would infringe the 969 Patent absent a license. Ethicon Endo-Surgery, Inc. has exclusively sublicensed that right to Ethicon US, LLC. Ethicon US, LLC and Ethicon Endo-Surgery, Inc. are indirect subsidiaries of Johnson & Johnson.

B. Related Matters (37 C.F.R. § 42.8(b)(2)) - Updated

Patent Owner identifies the following judicial and/or administrative matters that may be deemed related under 37 C.F.R. § 42.8(b)(2):

The 969 Patent is presently asserted in *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, C.A. No. 1:17-cv-00871-LPS (D. Del.) (“the first Delaware litigation”). U.S. Pat. Nos. 9,585,658 (“the 658 Patent”), 8,616,431 (“the 431 Patent”), 9,113,874 (“the 874 Patent”), 9,084,601 (“the 601 Patent”), 8,991,677 (“the 677 Patent”), and 8,998,058 (“the 058 Patent”) are also asserted in the first Delaware litigation.

Patent Owner has also filed a motion for leave to file an amended complaint in *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, C.A. No. 1:18-cv-01325-LPS

(D. Del.) (“the second Delaware litigation”) to assert the 969 Patent and U.S. Pat. No. 9,844,379 (“the 379 Patent”) and withdraw infringement allegations relating to U.S. Pat. No. 9,326,770 (“the 770 Patent”). On July 17, 2019, Patent Owner’s motion was denied without prejudice in light of the parties’ joint stipulation to stay the second Delaware litigation. U.S. Pat. Nos. 9,844,369 (“the 369 Patent”), 8,602,288 (“the 288 Patent”), 8,602,287 (“the 287 Patent”), and 7,490,749 (“the 749 Patent”) are also asserted in the second Delaware litigation.

The 969 Patent is also presently asserted in *Certain Reload Cartridges for Laparoscopic Surgical Staplers*, Inv. No. 337-TA-1167 (USITC), along with the 874, 369, 379, and 749 Patents.

The following petitions for *inter partes* review have been filed against the 969 Patent:

- IPR2018-01247
- IPR2018-01248

The 969 Patent is a continuation of U.S. Patent Application No. 13/118,259, now U.S. Patent No. 8,684,253, which is a continuation-in-part of U.S. Patent Application No. 11/651,807, now U.S. Patent No. 8,459,520.

No U.S. patents or applications claim priority to U.S. Patent Application No. 13/369,609, which issued as the 969 Patent.

The following additional U.S. patents and patent applications claim priority to one or more of the same application(s) to which the 969 Patent claims priority:

- U.S. Patent Application No. 13/026,493, now U.S. Pat. No. 8,517,243
- U.S. Patent Application No. 13/037,498 (abandoned)
- U.S. Patent Application No. 13/631,346, now U.S. Pat. No. 8,746,530
- U.S. Patent Application No. 14/176,671
- PCT/US12/39156
- U.S. Patent Application No. 14/303,049
- U.S. Patent Application No. 14/559,172
- U.S. Patent Application No. 14/559,188
- U.S. Patent Application No. 14/559,224
- U.S. Patent Application No. 14/559,251
- U.S. Patent Application No. 14/847,864
- U.S. Patent Application No. 14/848,557
- U.S. Patent Application No. 14/848,572
- U.S. Patent Application No. 15/140,671
- U.S. Patent Application No. 15/650,185
- U.S. Patent Application No. 15/652,621
- U.S. Patent Application No. 15/652,677
- U.S. Patent Application No. 15/652,916

- U.S. Patent Application No. 15/652,978
- U.S. Patent Application No. 15/653,073
- U.S. Patent Application No. 15/807,836
- U.S. Patent Application No. 15/808,327
- U.S. Patent Application No. 15/808,383

C. Lead and Back-Up Counsel and Service Information (37 C.F.R. § 42.8(b)(3)-(4)) - Unchanged

Patent Owner identifies the following lead and back-up counsel and service information:

<p><u>Lead Counsel</u> Anish R. Desai Weil, Gotshal & Manges LLP 767 Fifth Avenue New York, NY 10153 T: 212-310-8730 F: 212-310-8007 anish.desai@weil.com USPTO Reg. No. 73,760 Customer No. 506,499</p>	<p><u>Back-Up Counsel</u> Elizabeth Stotland Weiswasser Weil, Gotshal & Manges LLP 767 Fifth Avenue New York, NY 10153 T: 212-310-8022 F: 212-310-8007 elizabeth.weiswasser@weil.com USPTO Reg. No. 55,721</p> <p>Adrian Percer Weil, Gotshal & Manges LLP 201 Redwood Shores Parkway Redwood Shores, CA 94065 T: 650-802-3141 F: 650-802-3100 adrian.percer@weil.com USPTO Reg. No. 46,986</p>
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