

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*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

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On July 24, 2019, Patent Owner sent an email to the Board indicating that Patent Owner and Petitioner “write jointly concerning an agreement the parties have reached, subject to the Board’s approval.” Ex. 3001.

According to Patent Owner, “Petitioner has asserted in its Reply that the sale of its robotic staplers demonstrates that tactile feedback is not a critical design feature (see Reply at 8–9).” *Id.* More particularly, Patent Owner states:

Petitioner asserted the same argument, and the Board authorized Patent Owner to submit under seal with its Sur-Reply deposition testimony from the co-pending litigation of one of Petitioner’s employees, which Patent Owner contends is inconsistent with this argument. *See* IPR2018-0036 [sic, 936], Paper No. 23 at 3–4 (July 19, 2019). The Board further authorized Petitioner to file a Sur-Sur-Reply up to 6 pages in length one week after Patent Owner files its Sur-Reply, which will be limited to responding to content appearing in Patent Owner’s Sur-Reply that is directed to the new evidence. *Id.*

Id. Patent Owner represents that “Counsel for Patent Owner and Petitioner have conferred by email and request authorization to apply the same procedure in IPR2018-01254.” *Id.*

Accordingly, consistent with our procedure in IPR2018-01254, we authorize Patent Owner to submit under seal with its Sur-Reply deposition testimony from the co-pending litigation of one of Petitioner’s employees, which Patent Owner contends is inconsistent with this argument (Ex. 3001), and we also authorize Petitioner to file a Sur-Sur-Reply up to 6 pages in length one week after Patent Owner files its Sur-Reply, which will be limited to responding to content appearing in Patent Owner’s Sur-Reply that is directed to the new evidence. *Id.*

It is so ORDERED.

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