

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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INTUITIVE SURGICAL, INC.,  
Petitioner,

v.

ETHICON LLC,  
Patent Owner.

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

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**PATENT OWNER'S REQUEST FOR ORAL ARGUMENT**

Pursuant to 37 C.F.R. § 42.70 and the Board's Scheduling Order, Patent Owner Ethicon LLC respectfully submits this Request for Oral Argument. The Board has currently scheduled the oral hearing in IPR2018-01254 for September 18, 2019. Patent Owner specifies the following issues to be argued:

- The alleged obviousness under 35 U.S.C. § 103 of claim 24 over the following references: Giordano (U.S. Patent App. No. 2008/0167672) in view of Wallace (U.S. Patent No. 6,699,235); Giordano in view of Wallace and Tierney (U.S. Patent No. 6,331,181); and Shelton (U.S. Patent No. 6,978,921) in view of Giordano and further in view of Wallace and Tierney.
- The inapplicability of the January 2018 Certificate of Correction to this proceeding.
- The new, impermissible arguments in Petitioner's Reply, as identified in Patent Owner's Sur-Reply and Patent Owner's List of Improper Reply Arguments (Paper No. 24).
- The alleged obviousness of the following claims under 35 U.S.C. § 103 over the following references: Giordano in view of Wallace (claims 1-11); Giordano in view of Wallace and Tierney (claims 1-11); Shelton in view of Wallace and Tierney (claims 1-6 and 9-10); Shelton in view of Giordano and in further view of Wallace and Tierney (claims 7, 8, and 11); and Shelton in view of Wallace and Tierney and in further view of Hueil (U.S. Patent App. No.

2007/0158385) (claims 5 and 6).

- Any other issue the Board deems necessary for issuing a Final Written Decision.

The Board has also currently scheduled an oral hearing on September 18, 2019 for a related proceeding concerning U.S. Patent No. 8,479,969 (IPR2018-01247). Patent Owner requests that IPR2018-01247 and IPR2018-01254 be consolidated into a single hearing.

Patent Owner requests forty-five minutes of time to address the issues identified above and the related issues identified in Patent Owner's Request for Oral Argument in IPR2018-01247. To the extent the Board schedules the hearing to last more than ninety minutes, however, Patent Owner requests that it be given half the length of the hearing to address these issues.

Patent Owner requests that ten spaces be reserved at the oral hearing to accommodate its counsel and corporate representatives.

Date: August 20, 2019

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on August 20, 2019, the foregoing **PATENT OWNER'S REQUEST FOR ORAL ARGUMENT** was served via electronic mail, upon the following:

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