

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

**PETITIONER'S REQUEST FOR ORAL ARGUMENT AND
REQUEST TO RESCHEDULE
TO ALIGN WITH IPR2018-01248**

Pursuant to 37 C.F.R. § 42.70(a) and the Revised Scheduling Order (Paper 11), Petitioner submits this Request for Oral Argument on all of the instituted grounds of unpatentability of U.S. Patent No. 8,479,969. Requests for Oral Argument in related IPR proceedings (IPR2018-01247 and IPR2018-01248), each of which concerns the '969 Patent, are being filed on this same day.

At present, Oral Hearings for IPR2018-01247 and IPR2018-01254 are scheduled for September 18, 2019 (See PTAB's Revised Scheduling Orders of February 12, 2019 (Paper 11 in each proceeding)) and the Oral Hearing for IPR2018-01248 is scheduled for October 17, 2019 (See PTAB's Scheduling Order of February 7, 2019 (Paper 9 in that proceeding)).

Given the overlapping subject matter and the common patent, Petitioner requests that all three proceedings concerning the '969 Patent be consolidated and held on October 17, 2019.

Petitioner requests 75 minutes for each side to present arguments collectively for this proceeding and the two related proceedings

With regard to this particular proceeding, Petitioner requests (without waiving consideration of any issue not listed below) to address the following issues:

1. Whether claims 1-11, 24 are obvious over Giordano in view of Wallace;

2. Whether claims 1-11, 24 are obvious over Giordano in view of Wallace and Tierney;
3. Whether claims 1-6, 9-10 are obvious over Shelton in view of Wallace and Tierney;
4. Whether claims 7, 8, 11, 24 are obvious over Shelton in view of Giordano and further in view of Wallace and Tierney;
5. Whether claims 5 and 6 are obvious over Shelton in view of Wallace and Tierney, and further in view of Hueil;
6. Rebuttal to Patent Owner's presentation on all matters; and
7. Any additional issues on which the Board seeks clarification.

The Board has already scheduled Oral Hearing for September 18, 2019. *See* PTAB's Revised Scheduling Order of February 12, 2019 (Paper 11).

Petitioner also respectfully requests the ability to use audio visual equipment to display demonstrative exhibits, including the use of a projector and screen that connects to a laptop computer. Petitioner's counsel will use a laptop computer with a VGA-type connector. In addition, Petitioner requests that an ELMO-type projector be made available for use.

Proceeding No. IPR2018-01254
Attorney Docket No. 11030-0049IPA

Respectfully submitted,

Dated: August 23, 2019

/Steven R. Katz/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on August 23, 2019, a complete and entire copy of this Petitioner's Request for Oral Argument and Request to Reschedule to Align with IPR2018-01248 was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows

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