

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

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**PETITIONER'S SUR-SUR-REPLY TO  
PATENT OWNER'S  
SUR-REPLY**

## TABLE OF CONTENTS

I.	Introduction.....	1
II.	The Testimony of Petitioner’s Engineer is Completely Consistent with Petitioner’s Argument in this Proceeding.....	2

## I. Introduction

The Board authorized this Sur-Sur Reply in Paper 23. This Sur-Sur Reply responds to a new issue raised by Patent Owner:

Patent Owner argues that “tactile feedback” is so “critical” to a linear stapler that a POSITA would not combine a linear stapler with a robot that lacks “tactile feedback.” Petitioner responded in its Reply Brief that Patent Owner must be wrong because Patent owner sued Petitioner in District Court over Petitioner’s robotic linear stapler which lacks the sort of “tactile feedback” Patent Owner alleges is a necessity. If “tactile feedback” of the sort Patent Owner alleges was a necessity, then logically, the accused products would have it when in fact they do not. Patent Owner has no answer.

Instead, Patent Owner asked the Board for leave to file an excerpt from the deposition of an engineer employed by Petitioner that Patent Owner asserted was “inconsistent” with Petitioner’s argument. However, far from being “inconsistent,” the deposition supports Petitioner. The testimony confirms that the robotic linear staplers of Petitioner use “SmartClamp” technology (a type of “visual feedback”) **instead of** “tactile feedback” to feel clamp strength.

## **II. The Testimony of Petitioner’s Engineer is Completely Consistent with Petitioner’s Argument in this Proceeding**

Petitioner asserts that a POSITA would be motivated to combine the surgical robot of Wallace and Tierney with the linear stapler/cutter of Giordano/Shelton because, among other reasons, a POSITA would be motivated to adapt surgical staplers for robotic use. Petition, 26.

Patent Owner argues that a POSITA would only combine a linear stapler/cutter like Giordano/Shelton with a surgical robot that provides “tactile feedback.” Patent Owner is clearly wrong because there are actual robotic linear cutter/staplers designed for use with robots that lack the sort of “tactile feedback” Patent Owner asserts is necessary.<sup>1</sup>

After Petitioner pointed out this fundamental and dispositive flaw in Patent Owner’s “tactile feedback” theory, Patent Owner informed the Board that it had “inconsistent” testimony from one of Petitioner’s engineers. 2019-07-12 Email

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<sup>1</sup> Wallace/Tierney does, in fact, disclose “tactile feedback” through an incorporated disclosure, and if the Board agrees, this issue is moot. Cooper is incorporated into Wallace, and Cooper teaches “tactile feedback.” *E.g.*, IS1018 (Cooper), 3:44-47, 5:9-13. The ’666 Application is incorporated into Tierney, and that application likewise teaches “tactile feedback.” IS1025 (’666 Application), 5:32-35.

from Christopher Pepe to the Board; *see also* Paper 23 (providing authorization for the deposition excerpt stating “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”).

Patent Owner has now filed the confidential excerpt, but Patent Owner no longer asserts it is “inconsistent.” Instead, Patent Owner states that Petitioner’s “robotic systems **did not provide tactile feedback**” and confirms that visual feedback is an adequate **substitute**. Sur-Reply, 19-20 (acknowledging that Petitioner’s product offers “SmartClamp” (a type of visual feedback) instead of “tactile feedback” to feel the clamping force).<sup>2</sup>

Accordingly, the excerpt confirms what Petitioner argued—there are actual robotic linear stapler/cutters on the market that do not have the type of tactile feedback that allows a surgeon to feel the clamping force, and therefore Patent Owner’s argument that a POSITA would not combine a linear stapler/cutter with a such a robot is baseless and wrong. Not only would a hypothetical POSITA make

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<sup>2</sup> Patent Owner provides a URL, but the following is more informative:

[https://us.davincisurgerycommunity.com/detail/videos/p6\\_stapler/video/5270751686001/stapler-smart-clamp?autoStart=true#](https://us.davincisurgerycommunity.com/detail/videos/p6_stapler/video/5270751686001/stapler-smart-clamp?autoStart=true#)

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