

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

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

PATENT OWNER'S REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70, Patent Owner Ethicon LLC respectfully submits this Request for Oral Argument. The Board has scheduled a single, consolidated oral hearing on October 17, 2019 for IPR2018-01254 and two related proceedings concerning U.S. Patent No. 8,479,969. *See* IPR2018-01247, Paper No. 29; IPR2018-01248, Paper No. 19; IPR2018-01254, Paper No. 32. Patent Owner specifies the following issues to be argued concerning IPR2018-01254:

- 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.

Patent Owner requests sixty minutes of time to address the issues identified above for IPR2018-01254 and the issues identified in Patent Owner's Requests for Oral Argument in IPR2018-01247 and IPR2018-01248. To the extent the Board schedules the hearing to last more than two hours, 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: September 12, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 12, 2019, the foregoing
PATENT OWNER'S REQUEST FOR ORAL ARGUMENT was served via
electronic mail, upon the following:

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