

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 UNOPPOSED MOTION FOR *PRO HAC VICE***

**ADMISSION OF ROGER A. DENNING**

**UNDER 37 C.F.R. § 42.10(c)**

**PETITIONER'S UPDATED EXHIBIT LIST**

- IS1001 U.S. Pat. No. 8,479,969 to Shelton, IV (“the ’969 Patent”)
- IS1002 Prosecution History of the ’969 Patent (Serial No. 13/369,609)
- IS1003 Reserved
- IS1004 Reserved
- IS1005 Declaration of Dr. Bryan Knodel (Giordano as Primary Reference)  
 (“Knodel Decl.”)
- IS1006 Reserved
- IS1007 Reserved
- IS1008 U.S. Pat. No. 6,699,235 to Wallace et al. (“Wallace”)
- IS1009 U.S. Pat. No. 6,331,181 to Tierney et al. (“Tierney”)
- IS1010 Reserved
- IS1011 Reserved
- IS1012 Reserved
- IS1013 Reserved
- IS1014 U.S. Pat. App. No. 2008/0167672 to Giordano et al. (“Giordano”)
- IS1015 U.S. Pat. No. 6,978,921 to Shelton et al. (“Shelton”)
- IS1016 U.S. Pat. App. No. 2007/0158385 to Hueil et al. (“Hueil”)
- IS1017 Supplemental Declaration of Dr. Bryan Knodel  
 (“Knodel Supp. Decl.”)

- IS1018 U.S. Pat. No. 6,132,368 to Cooper (“Cooper”)
- IS1019 June 17, 2019 Deposition of Shorya Awtar for IPR2018-01247  
 (“Awtar Dep. I”)
- IS1020 Reserved
- IS1021 Reserved
- IS1022 June 18, 2019 Deposition of Shorya Awtar for IPR2018-01254  
 (“Awtar Dep. II”)
- IS1023 June 6, 2019 Deposition of Frank Fronczak for IPR2018-00936  
 (“Fronczak Dep.”)
- IS1024 April 3, 2019 Deposition of Bryan Knodel for IPR2018-01247  
 (“Knodel Dep.”)
- IS1025 PCT App. Pub. No. WO 98/25666 (“the ’666 application”)
- IS1026 District Court Complaint in *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, 1:17-cv-00871-LPS filed June 30, 2017
- IS1027 U.S. Pat. No. 7,524,320 to Tierney et al. (“Tierney 320”)
- IS1028 Declaration of Roger A. Denning

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Pursuant to 37 C.F.R. § 42.10(c), Petitioner, Intuitive Surgical, Inc.

(“Petitioner”) respectfully requests that the Board recognize Roger A. Denning as counsel *pro hac vice* in this proceeding. Petitioner seeks the counsel of Mr. Denning due to his experience in representing Intuitive Surgical, Inc. in other patent-related matters and particularly due to his familiarity with the substantive and technical issues involved in this proceeding. This motion is authorized by the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response that was mailed on July 17, 2018.

Patent Owner does not oppose this motion.

### **Statement of Facts**

Mr. Denning is a patent litigation attorney with more than 20 years of experience representing clients in patent cases involving medical devices, software, micro-electronics, and life sciences. Mr. Denning litigates patent cases before various federal courts. Through his years of practice, Mr. Denning has gained substantial experience in jury trials, discovery, Markman hearings, and appeals. His declaration provides Appendix A, as evidence, with additional details of Mr. Denning’s biography.

Mr. Denning also has particular experience and familiarity with the substantive and technical issues involved in this *inter partes* review proceeding. Mr. Denning is counsel for Petitioner in International Trade Commission

Investigation No. 337-TA-1167, which includes U.S. Patent No. 8,479,969, the patent at issue in this *inter partes* review proceeding.

**Declaration of Individual Seeking to Appear**

This Motion for *Pro Hac Vice* Admission is accompanied by a Declaration of Roger A. Denning.

Accordingly, Intuitive Surgical, Inc. submits that there is good cause under 37 C.F.R. § 42.10(c) for the Board to recognize Roger A. Denning as counsel *pro hac vice* during this proceeding.

Dated: September 12, 2019

Respectfully submitted,

/Steven R. Katz/

Steven Katz, Reg. No. 43,706

John C. Phillips, Reg. No. 35,322

Ryan O'Connor, Reg. No. 60,254

Fish & Richardson P.C.

3200 RBC Plaza, 60 South Sixth Street

Minneapolis, MN 55402

T: 858-678-5070

F: 877-769-7945

Attorneys for Petitioner

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