

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2018-01247 (Patent 8,479,969 B2)
Case IPR2018-01248 (Patent 8,479,969 B2)
Case IPR2018-01254 (Patent 8,479,969 B2)

Record of Oral Hearing
Held: October 17, 2019

Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD, and
MATTHEW S. MEYERS, *Administrative Patent Judges.*

Case IPR2018-01247 (Patent 8,479,969 B2)

Case IPR2018-01248 (Patent 8,479,969 B2)

Case IPR2018-01254 (Patent 8,479,969 B2)

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on Thursday, October 17, 2019, commencing at 9:04 a.m., on the 9th Floor of USPTO Madison Building East, 600 Dulany Street, Alexandria, Virginia.

Case IPR2018-01247 (Patent 8,479,969 B2)

Case IPR2018-01248 (Patent 8,479,969 B2)

Case IPR2018-01254 (Patent 8,479,969 B2)

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P R O C E E D I N G S

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(Proceedings begin at 9:04 a.m.)

JUDGE WOOD: Good morning.

MR. DESAI: Good morning, Your Honor.

MR. DENNING: Good morning.

JUDGE WOOD: This is the oral argument for IPR2018-01247, IPR2018-01248, IPR2018-01254 and IPR2018-01703.

Will counsel for Petitioner please introduce themselves?

MR. DENNING: Good morning, Your Honors. My name is Roger Denning from Fish & Richardson on behalf of Petitioner, Intuitive Surgical. I have with me today my two partners, Steve Katz and Ryan O'Connor, who will also be arguing. And then I have Eming May (ph), the inhouse IP attorney from Intuitive Surgical.

JUDGE WOOD: All right. Thank you, Mr. Denning.

MR. DENNING: Thank you.

JUDGE WOOD: Will counsel for Patent Owner please introduce themselves?

MR. DESAI: Good morning, Your Honor. Anish Desai, from Weil Gotshal on behalf of Patent Owner. With me is Chris Pepe, who will be arguing as well, and Chris Marando.

JUDGE WOOD: All right. Thank you, Mr. Desai.

According to the hearing order, we will proceed

Case IPR2018-01247 (Patent 8,479,969 B2)

Case IPR2018-01248 (Patent 8,479,969 B2)

Case IPR2018-01254 (Patent 8,479,969 B2)

1 first with IPR2018-01247, -01248, and -01254, which all involve the
2 same patent.

3 Both sides will have 60 minutes. Petitioner
4 proceeds first to discuss its case and may reserve rebuttal
5 time to reply to Patent Owner's arguments. Patent Owner then
6 proceeds with its case and may reserve rebuttal time to
7 sur-reply to Petitioner's reply.

8 Following completion of the oral argument as to
9 those cases, we will proceed with IPR2018-01703, following a
10 short break, if the parties request it.

11 Before we begin, I believe Patent Owner has marked
12 some demonstratives as confidential. I'd like to remind the
13 parties that this is a public hearing. To the extent that
14 confidential information is discussed, we will need counsel to
15 be aware that it's public, and that any information that will
16 be made public. And to the extent that counsel wishes to keep
17 that information confidential, we will need to close the
18 hearing for that information. So in other words, counsel
19 needs to let the Panel know in advance of discussion of any
20 confidential information.

21 MR. DESAI: Your Honor, I believe we've discussed
22 this before the hearing, and there's not going to be any
23 issue. We're okay. Both sides are okay with proceeding on
24 the public record.

25 JUDGE WOOD: Okay. Thank you very much.

Case IPR2018-01247 (Patent 8,479,969 B2)

Case IPR2018-01248 (Patent 8,479,969 B2)

Case IPR2018-01254 (Patent 8,479,969 B2)

1 With that said, Mr. Denning, you may proceed when
2 you're ready.

3 MR. DENNING: Thank you, Your Honors.

4 I'd like to -- I think we're going to go about 40
5 minutes and reserve 20 minutes for our rebuttal, if that's
6 okay with Your Honors. We are connecting to our presentation
7 right now.

8 So, Your Honors, I plan to address the first issue,
9 maybe the threshold issue in the case, is as to whether the
10 Certificate of Correction language, or the original language,
11 or both should be subject to the Board's determination in this
12 IPR. And then I'm going to turn it over to my colleagues, Mr.
13 Katz and Mr. O'Connor, to argue the merits of each of those
14 three IPRs, I think starting with Prisco, and then going to
15 Giordano, and then going to Timm Anderson.

16 JUDGE WOOD: Mr. Denning, before you proceed
17 further, pardon the interruption, but I would like to remind
18 counsel that we have a judge -- Judge Meyers is remotely
19 connected to the hearing. So for the benefit of Judge Meyers
20 and the record, please identify all slides by slide number as
21 you proceed.

22 JUDGE MEYERS: Thank you.

23 JUDGE WOOD: And you may proceed.

24 MR. DENNING: Thank you. We'll do so.

25 Good morning, Judge Meyers.

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