

**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

---

**DECLARATION OF DR. SHORYA AWTAR**

## TABLE OF CONTENTS

	Page
I. INTRODUCTION.....	1
II. PRIORITY DATE AND LEVEL OF ORDINARY SKILL IN THE ART .....	2
III. QUALIFICATIONS .....	3
IV. RELEVANT LEGAL STANDARDS.....	4
V. OVERVIEW OF THE TECHNOLOGY DISCLOSED IN THE 969 PATENT .....	6
VI. PROSECUTION HISTORY OF THE 969 PATENT.....	16
VII. CLAIM CONSTRUCTION .....	16
VIII. OVERVIEW OF THE PRIOR ART CITED BY PETITIONER .....	17
A. Giordano.....	17
B. Shelton.....	22
C. Wallace.....	25
D. Tierney.....	29
E. Hueil .....	30
IX. PETITIONER HAS NOT DEMONSTRATED THAT ANY COMBINATION OF GIORDANO, SHELTON, WALLACE, TIERNEY, AND HUEIL RENDERS OBVIOUS THE CLAIMS OF THE 969 PATENT .....	32
A. Claim 24: Combining Shelton’s endocutter with Tierney’s robotic system, Wallace’s tool mount, and Giordano’s articulation mechanism does not result in an instrument that includes “a tool mounting portion operably coupled to a distal end of said proximal spine portion.” .....	34

B.	Claims 11 and 24: A person of ordinary skill in the art would have been deterred from attempting any of the combinations proposed for claims 11 and 24. ....	38
C.	Claims 11 and 24: A person of ordinary skill in the art would not have been motivated to combine Shelton’s endocutter with Tierney’s robotic system, Wallace’s tool base, and Wallace’s articulation mechanism .....	43
D.	Claims 11 and 24: A person of ordinary skill in the art would not have had a reasonable expectation of success in combining the prior art as proposed. ....	49
E.	Claims 1-10: A person of ordinary skill in the art would have been deterred from attempting any of the combinations proposed for claims 1-10.....	58
F.	Claims 1-10: A person of ordinary skill in the art would not have had a reasonable expectation of success in combining the prior art as proposed. ....	58
X.	JURAT .....	60

## I. INTRODUCTION

1. My name is Dr. Shorya Awtar. I have been retained by counsel for Patent Owner Ethicon LLC (“Ethicon”) in the above captioned *inter partes* review to consult with counsel, review documents, form opinions, prepare expert declarations, and be available to testify as to my opinions.

2. I understand that Petitioner Intuitive Surgical Inc. (“Intuitive”) has asserted that claims 1-11 and 24 of U.S. Patent No. 8,479,969 (the “969 Patent”) are invalid as obvious. I have been asked to give expert opinions and testimony related to the issue of the validity of claims 1-11 and 24 of the 969 Patent, including the background of the technology at issue, and the scope and content of the prior art.

3. My opinions are based on reviewing the Petition, Dr. Knodel’s declaration (Ex. 1005), the Patent Owner Response, the transcripts of Dr. Knodel’s depositions (Ex. 2011, as well as his deposition testimony in IPR2018-01247 and IPR2018-01248), and the relevant portions of all exhibits cited in any of the foregoing documents and this declaration.

4. The opinions I have formed as explained herein are informed by and based on my consideration of the documents listed above, as well as my own knowledge and experience based upon my work in the relevant field of technology, as discussed below. All statements made herein of my own knowledge are true,

and all statements made herein based on information and belief are believed to be true. Although I am being compensated for my time in preparing this declaration, the opinions articulated herein are my own, and I have no stake in the outcome of this proceeding or any related litigation or administrative proceedings. My study is ongoing, and I may supplement or amend these opinions based on the production of additional evidence, as a result of further analysis, or in rebuttal to positions subsequently taken by Intuitive and/or Dr. Knodel.

## **II. PRIORITY DATE AND LEVEL OF ORDINARY SKILL IN THE ART**

5. I have been asked to assume that the priority date of the claims of the 969 Patent is May 27, 2011. I understand that Intuitive's expert, Dr. Knodel, has also utilized a priority date of May 27, 2011 in his analysis. *See* Ex. 1005 at ¶¶ 30-32. I reserve the right to address the priority date of the claims of the 969 Patent should Intuitive subsequently contest this issue.

6. I understand that Dr. Knodel has opined that a person of ordinary skill in the art for the 969 Patent would include someone who had the equivalent of a Bachelor's degree or higher in mechanical engineering with at least 3 years working experience in the design of comparable surgical devices. Ex. 1005 at ¶ 26. While I generally agree with the level of education and type of work experience proposed by Dr. Knodel, I note that a person of ordinary skill in the art would additionally have had an understanding as to how the instrument design can

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.