

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 LIST OF IMPROPER REPLY ARGUMENTS

1. **Page 5, line 18 through Page 6, line 3; Page 6, lines 8-12; Page 11, lines 13-16:** Petitioner makes new arguments that the articulation control would be moved to Wallace's tool mounting portion, while the Petition relied on the Giordano articulation mechanism that is located on the instrument's shaft. *See* Petition at 81-83, 85-87.

2. **Page 10, lines 1-6:** Petitioner makes new arguments that a POSITA would have started with Shelton's stapler adapted to include Giordano's articulation mechanism and would have been satisfied with its single axis articulation, but the Petition argued that a POSITA would have found Wallace's teaching of multi-axis 360 degree movement to improve upon Giordano's disclosure of single axis articulation. Petition at 85.

3. **Page 11, lines 1-7:** Petitioner makes new arguments that multi-axis articulation is optional in Wallace, but the Petition relied upon Wallace's teaching of the benefits of multi-axis 360 degree movement as the sole motivation for using Wallace's articulation mechanism. Petition at 85.

4. **Page 13, lines 1-4:** Petitioner makes new arguments that a POSITA would have been motivated to use Wallace's articulation mechanism with only one axis of articulation, but the Petition relied upon Wallace's teaching of the benefits of multi-axis 360 degree movement as the sole motivation for using Wallace's articulation mechanism. Petition at 85.

Dated: August 14, 2019

Respectfully submitted,

/Anish R. Desai/

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CERTIFICATE OF SERVICE

I hereby certify that on August 14, 2019, a copy of **PATENT OWNER'S LIST OF IMPROPER REPLY ARGUMENTS** and any accompanying exhibits was served by filing this document through the PTAB's E2E Filing System as well as delivering a copy via electronic mail upon the following:

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