

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Frederick E. Shelton, IV, et al.
U.S. Patent No.: 9,113,874
Issue Date: August 25, 2015 Attorney Docket No.: 11030-0049IP6
Appl. Serial No.: 14/312,808
Filing Date: June 24, 2014
Title: SURGICAL INSTRUMENT SYSTEM

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**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT
NO. 9,113,874 PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42**

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EXHIBITS

- IS1001 U.S. Patent No. 9,113,874 to Shelton IV, et al. (“the ’874 patent”)
- IS1002 Excerpts from the Prosecution History of the ’874 patent (“the Prosecution History”)
- IS1003 Declaration of Dr. Bryan Knodel
- IS1004 U.S. Patent No. 5,383,880 to Hooven (“Hooven”)
- IS1005 U.S. Patent No. 5,662,667 to Knodel et al. (“Knodel”)
- IS1006 U.S. Patent No. 5,796,188 to Bays (“Bays”)
- IS1007 U.S. Patent No. 5,702,408 to Wales et al. (“Wales”)
- IS1008 U.S. Patent No. 7,845,537 (“the ’537 patent”)
- IS1009 U.S. Patent No. 8,161,977 (“the ’977 patent”)
- IS1010 U.S. Patent No. 8,820,603 (“the ’603 patent”)
- IS1011 U.S. Pat. App. Pub. No. 2002/0165541 (“Whitman”)
- IS1012 Excerpts from the Prosecution History of the ’537 patent (“the ’537 Prosecution History”)
- IS1013 Excerpts from the Prosecution History of the ’977 patent (“the ’977 Prosecution History”)
- IS1014 Excerpts from the Prosecution History of the ’603 patent (“the ’603 Prosecution History”)

Intuitive Surgical, Inc., (“Petitioner”) petitions for *Inter Partes* Review (“IPR”) of claims 1-21 (“the Challenged Claims”) of U.S. Patent No. 9,113,874 (“the ’874 patent”).

The ’874 patent relates to “a surgical instrument system ... including a surgical instrument [such as a surgical stapler] and a remote user-controlled actuation console for controlling the surgical instrument.” IS1001, Abstract. According to the Examiner’s Reasons for Allowance, claim 1 of the ’874 patent was allowed because it allegedly recited subject matter already found allowable in a parent application. IS1002 at 373 (Dec. 24, 2014, Notice of Allowability) (“[Claim 1] contain[s] allowable subject matter found in the parent application 13037515, now US Patent No 8,820,603.”); IS1002 at 38 (Apr. 7, 2015, Notice of Allowability) (same). That statement, however, was incorrect as the parent claim to which the Examiner was referring in fact had been rejected on prior art grounds. IS1014 at 392-93 (Jan. 31, 2013, Non-Final Rejection) (rejecting claim 1 as being anticipated by Whitman). The parent claim was then thrice amended to avoid such prior art. IS1014 at 314 (Apr. 9, 2013, Response to Office Action) (“Applicants have now amended the claim to recite the limitation that the end effector includes a knife and a channel in the frame to receive the knife. Whitman does not disclose such a feature.”); IS1014 at 250-51 (Aug. 20, 2013, Response to Office Action) (amending claim 1 to require a “rigid” shaft because “Whitman discloses only a

flexible shaft”); IS1014 at 223 (Nov. 25, 2013, Response to Office Action) (amending claim 1 to require that the motor be “located substantially” in the shaft). As such, the allowance of the ’874 patent was the result of a factual mistake. Accordingly, as the USPTO correctly recognized in the parent application, the claimed systems were not new at the time of the alleged priority date of the ’874 patent. As explained below, Hooven, either alone or in combination with Knodel and/or Bays, disclose all the elements of claims 1-21 of the ’874 patent. Petitioner therefore requests IPR of the challenged claims on Grounds 1-4 below.

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(1)

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

Intuitive Surgical, Inc. is the real party-in-interest. No other party had access to the Petition, and no other party had any control over, or contributed to any funding of, the preparation or filing of the present Petition.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

Petitioner is not aware of any disclaimers, reexamination certificates, or petitions for *inter partes* review of the ’874 patent. The ’874 patent is the subject of Civil Action No. 1:17-cv-00871-LPS, filed on June 30, 2017, in the United States District Court for the District of Delaware.

C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

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