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Paper 10
Entered: June 11, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON ENDO-SURGERY, INC.,
Patent Owner.

Case IPR2018-00938
Patent 9,113,874 B2

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

MEYERS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. BACKGROUND

Intuitive Surgical, Inc., ("Petitioner") filed a Petition for *inter partes* review of claims 1–21 of U.S. Patent No. 9,113,874 B2 (Ex. 1001, "the '874 patent").[1] Paper 2 ("Pet."). Ethicon Endo-Surgery, Inc., ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). On December 4, 2018, we entered a Decision Denying Institution of *Inter Partes* Review. Paper 8, ("Decision" or "Dec.").

On December 20, 2018, Petitioner filed a Request for Rehearing of our Decision denying institution of *inter partes* review of claims 1–15 and 18–20 of the '874 patent.[2] Paper 9 ("Req. Reh'g.").

With respect to Grounds 1–4, Petitioner contends that we erred by misapprehending the disclosure of Hooven because we "overlooked th[e] part of Hooven which discloses that the closing motion may be applied independently of the firing motion," and thus, erroneously concluded that "the two motions cannot be the 'same' motion." Req. Reh'g. 1; *see also id.* at 2–7. Accordingly, Petitioner requests the Board reconsider its findings

[1] As discussed in the Decision, claims 16, 17, and 21 are disclaimed via statutory disclaimer, filed September 5, 2018, under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). *See* Dec. 2, FN 1 (citing Ex. 2002). Accordingly, only claims 1–15 and 18–20 were addressed in the Decision. *See* 37 C.F.R. § 42.107(e).

[2] Petitioner's Request "specifically addresses the error for Ground 1 in Section I (relevant to all claims) and the errors for Ground 4 in Section V (claims 1–8, and 19)." Req. Reh'g. 10.

regarding Hooven with respect to Ground 1[3], as well as Grounds 2–4,[4] and institute trial on all grounds of the Petition. *See id.* at 10.

With respect to Ground 4, Petitioner contends that "the Board misapprehended or overlooked the import of Dr. Knodel's discussion in support" of its assertion that "it would have been obvious to replace Hooven's flexible shaft with a stiff shaft and articulation joint," as taught by Wales. *Id.* at 11–13. Accordingly, Petitioner requests the Board reconsider its decision, with respect to Ground 4, and institute trial on all grounds of the Petition. *Id.* at 10.

For the reasons discussed below, Petitioner has not demonstrated that we abused our discretion in denying institution.

II. ANALYSIS

A. Standard of Review

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing

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[3] In the Petition, Petitioner asserts the claims 1–7, 9–14, 19, and 20 are anticipated by Hooven. Pet. 13–50 (citing Exs. 1001, 1003, 1004).

[4] In the Petition, Petitioner further asserts that claims 2–4, 9–15, and 18 are obvious over Hooven and Knodel (Ground 2 – Pet. 51–67 (citing Exs. 1001, 1003, 1004, 1005)); claim 8 is obvious over Hooven and Bays (Ground 3 – Pet. 67–70 (citing Exs. 1003, 1006)); and claims 1–8 and 19 are obvious over Hooven, Knodel and/or Bays, and Wales (Ground 4 – Pet. 70–73 (citing Exs. 1003, 1007)).

relevant factors. *See Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). A request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed." 37 C.F.R. § 42.71(d). "The burden of showing a decision should be modified lies with the party challenging the decision." *Id.*

B. Analysis

Alleged Misapprehension/Overlooking of Evidence Regarding Hooven

Petitioner argues that "[t]he Board overlooked [a] part of Hooven which discloses that the closing motion may be applied independently of the firing motion, and thus the two motions cannot be the 'same' motion, as the Board found." Req. Reh'g. 1. More particularly, Petitioner asserts that the Board overlooked column 5, lines 50–65 of Hooven which discloses:

> Tissue to be treated or manipulated is placed between the anvil portion and the staple portion of the head of the instrument when in the open position. Power is applied to the flexible shaft to rotate the shaft and the threaded rod and close the anvil portion. As can be appreciated, the amount of torque required to pivot the anvil portion about the pivot pin can be sensed and the thickness of tissue between the anvil and the staple portion determined. **It is a simple matter for a controller to manipulate this information and inform the surgeon as to whether or not he has the appropriate amount of tissue between the anvil portion and the staple portion of the head of the instrument upon closure or whether he has too much or too little tissue and should re-manipulate the instrument.**

Req. Reh'g. 4 (citing Ex. 1004, 5:50–65). Based on this emphasized portion, Petitioner contends that "Hooven clearly teaches the ability to close and open the anvil without firing the device." Req. Reh'g. 3.

As an initial matter, we are not persuaded by Petitioner's contention that we misapprehended or overlooked the emphasized potion of Hooven (Ex. 1004, 5:59–65), because Petitioner did not rely on the emphasized portion of Hooven to address the "closing motion" and "firing motion" in the Petition.[5] Instead, to address the "closing motion" recited by independent claim 20 in the Petition, Petitioner relied on column 5, lines 40–55 and column 6, lines 40–44 of Hooven. Pet. 18.[6] To address the "firing motion," Petitioner relied on column 6, lines 30–34, while explicitly stating that it is "[t]he rotations of the threaded rod 71 are the firing motions." Pet. 20.[7] And, consistent with this understanding, our Decision summarized Petitioner's mapping of the disputed terms as follows:

> With respect to the "closing motion," Petitioner asserts that "[t]he proximal and distal motions of closure pin 78 are opening and closing motions, respectively, to move the jaws between open and closed positions." Pet. 18–19 (citing Ex. 1003 ¶ 42). And, with respect to the "firing motion," Petitioner asserts that that "[t]he smaller diameter portion 73 of Hooven's 'threaded rod 71' is a motor powered firing element that is configured to apply firing motions to the knife via the drive nut." Pet. 20 (citing Ex. 1003 ¶¶ 45–47; Ex. 1004, Fig. 7; Ex. 1001; Fig. 3, element 36).

Dec. 16. Based on this mapping, the Decision noted that:

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[5] We acknowledge Petitioner's points to column 5, lines 40–55 to address the "closing motion" of independent claim 20. Pet. 18. However, Petitioner did not rely on the remaining, and newly cited lines 56–65 of column 5 to address independent claims 9 and 20.

[6] With respect to independent claim 9, Petitioner relies on the same portions of Hooven. *See* Pet. 25–26.

[7] With respect to independent claim 9, Petitioner relies on the same portions of Hooven. *See* Pet. 26.

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