

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

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314(a)

I. INTRODUCTION

A. OVERVIEW

Intuitive Surgical, Inc., (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–21 of U.S. Patent No. 9,113,874 B2 (Ex. 1001, “the ’874 patent”).¹ Pet. 1. Ethicon Endo-Surgery, Inc., (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Section 314(a) of Title 35 of the United States Code provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Upon consideration of the Petition, Preliminary Response, and the associated evidence, for the reasons explained below, we conclude that the information presented in the Petition does not establish a reasonable likelihood that Petitioner would prevail with respect to any of the challenged claims.

Accordingly, we decline to institute an *inter partes* review.

B. RELATED PROCEEDINGS

The parties indicate that the ’874 patent is involved in: *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, No. 1:17-cv-00871 in the United States

¹ As discussed below in Section II.A, Patent Owner identifies that 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* Ex. 2002. In light of this disclaimer, only claims 1–15 and 18–20 remain under review. The remainder of this decision modifies the grounds of unpatentability presented by Petitioner to reflect only those claims under review. *See* 37 C.F.R. § 42.107(e).

District Court for the District of Delaware (“the Delaware litigation”).² Pet. 2; Paper 6, 2.

Petitioner is also challenging related patents in the following proceedings before the Board: (1) Case No. IPR2018-00933 (the ’601 patent); (2) Case No. IPR2018-00934 (the ’058 patent); (3) Case No. IPR2018-00935 (the ’677 patent); (4) Case Nos. IPR2018-01248 and IPR2018-01254 (the ’969 patent); (5) Case Nos. IPR2018-01247 and IPR2018-00936 (the ’658 patent); and (6) Case No. IPR2018-01703 (the ’431 patent).

C. THE ’874 PATENT

The ’874 patent relates generally to endoscopic surgical instruments that are suitable for precise placement of a distal end effector at a desired surgical site. Ex. 1001, 2:49–60. More particularly, the ’874 patent describes a surgical cutting and fastening instrument that in some embodiments includes an end effector comprising an anvil with staple forming features (*see, e.g.*, Ex. 1001, 3:47–60) and in other embodiments includes an end effector comprising a first jaw, second jaw, and a firing element. *See, e.g.*, Ex. 1001, 3:61 – 4:8. Reproduced below is Figure 1 of the ’874 patent.

² Patent Owner asserts that U.S. Pat. Nos. 9,585,658 (“the ’658 patent”), 8,616,431 (“the ’431 patent”), 8,479,969 (“the ’969 patent”), 8,998,058 (“the ’058 patent”), 9,084,601 (“the ’601 patent”), and 8,991,677 (“the ’677 patent”) are also asserted in the Delaware litigation. Paper 6, 2.

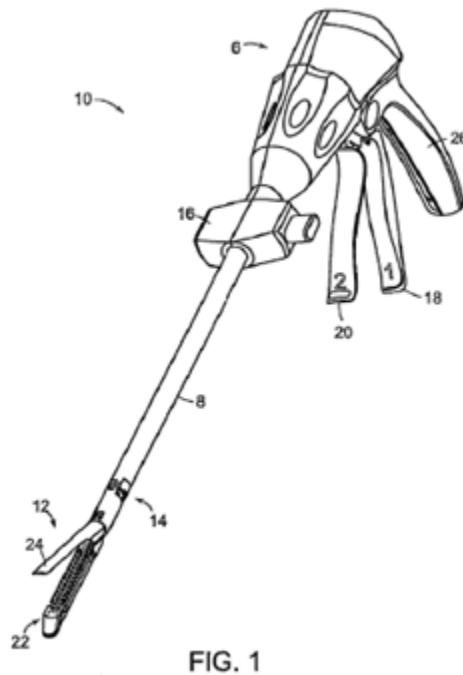


FIG. 1 illustrates a perspective view of a surgical cutting and fastening instrument.

Figure 1 depicts surgical cutting and fastening instrument 10 comprising handle 6, shaft 8, and articulating end effector 12 pivotally connected to shaft 8 at articulation pivot 14. Ex. 1001, 6:29–32. The '874 patent describes that “[i]n other embodiments, different types of clamping members besides the anvil 24 could be used, such as, for example, an opposing jaw, etc.” Ex. 1001, 7:7–9. The '874 patent discloses that “handle 6 of the instrument 10 may include a closure trigger 18 and a firing trigger 20 for actuating the end effector 12.” Ex. 1001, 6:44–46. More particularly, the '874 patent discloses:

[t]he handle 6 includes a pistol grip 26 toward which a closure trigger 18 is pivotally drawn by the clinician to cause clamping or closing of the anvil 24 towards the staple channel 22 of the end effector 12 to thereby clamp tissue positioned between the anvil 24 and channel 22. The firing trigger 20 is farther outboard

of the closure trigger **18**. Once the closure trigger **18** is locked in the closure position as further described below, the firing trigger **20** may rotate slightly toward the pistol grip **26** so that it can be reached by the operator using one hand. Then the operator may pivotally draw the firing trigger **20** toward the pistol grip **26** to cause the stapling and severing of clamped tissue in the end effector **12**.

Ex. 1001, 6:62–7:7.

D. ILLUSTRATIVE CLAIM

Petitioner challenges claims 1–15 and 18–20 of the '874 patent. Each of claims 1, 9, 19, and 20 is independent. Independent claims 1 and 9 are illustrative of the challenged claims, and are reproduced below:

1. A surgical cutting and fastening instrument comprising:

an end effector comprising an anvil with staple forming features thereon, a housing frame generally opposed to the anvil to hold a cartridge, a replaceable cartridge holding staples that can be urged out of the cartridge with a distal actuation of a deploying wedge, and at least one sensor;

an elongated shaft, said shaft having a motor therein that is operably coupled to an actuation mechanism, said shaft having at least one articulation joint for positioning the cartridge at an angle not parallel to a longitudinal axis of said shaft;

an electrically coupled remote user-controllable actuation console; and

a linear drive motion converter to convert rotary motion from said motor to linear motion.

9. A surgical instrument comprising:

a surgical end effector comprising:

a first jaw;

a second jaw, wherein said first and second jaws are supported relative to each other such that one of said first and second jaws is movable between open and closed positions

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