

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Intuitive Surgical, Inc.

Petitioner,

v.

Ethicon Endo-Surgery, Inc.

Patent Owner

IPR Case No. IPR2018-00938

U.S. Patent No. 9,113,874

**PETITIONER'S REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71(d)**

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I. **The Board Misapprehended Hooven Because It Overlooked a Key Passage Confirming Hooven Independently Applies Different Closing and Firing Motions**

The Board denied institution based on a misapprehension of Hooven. The Board overlooked that 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.

The overlooked passage is found at column 5, lines 50-65, and was quoted in part in the Petition at page 59 and the accompanying Knodel declaration at paragraph 142. That passage confirms what Petitioner describes throughout its petition—that the closing motion (provided by closure nut 77 and its closure pin 78) is different from the firing motion (provided by the small diameter portion 73 of threaded rod 71 when engaged with the firing nut). These two motions are not—as the Board found—merely the motion of the threaded rod.

Petitioner respectfully requests that the Board rehear its decision denying institution on all grounds.

Claim 9, which is representative, requires a “reciprocable closure element” which applies “opening and closing motions” to one of the end effector jaws and a “firing element” which applies “firing motions” to a driver element.

Patent Owner argued that the ’874 Patent requires that the claimed instrument had to be capable of closing and opening **before** firing:

The 874 Patent notes as much in the Background section, explaining that “[o]ne specific advantage of being able to close upon tissue before firing is that the clinician is able to verify via an endoscope that the desired location for the cut has been achieved[.]” Ex. 1001 at 3:22-25.

POPR at 3. In other words, Patent Owner asserted that the device of the ’874 Patent could close **without** firing so that the surgeon could close the jaws, but then open them and reposition the instrument if necessary.

The misapprehension concerning Hooven occurred because Patent Owner argued that Hooven failed to disclose this ability to close without firing, implying that Hooven closes and then fires as part of the same “motion”:

[T]he device described and claimed in the 874 Patent provides two motions for performing the opening/closing and firing functions. . . . Conversely, with Hooven the risk of error is always present, since both functions are controlled through application of the same motion (the rotation of the threaded rod).

Id. at 2-3.

The Board agreed with Patent Owner and held that Hooven could not anticipate (or render obvious) the challenged claims of the ’874 Patent because Hooven allegedly disclosed only a single motion for closing and firing:

Patent Owner asserts that “Hooven’s surgical instrument only applies a single motion – the rotation of a threaded rod.” Prelim. Resp. 23. We agree with Patent Owner.

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