

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Christopher J. Schall, et al.
U.S. Patent No.: 7,490,749 Attorney Docket No.: 11030-0052IP1
Issue Date: February 17, 2009
Appl. Serial No.: 11/729,355
Filing Date: March 28, 2007
Title: SURGICAL STAPLING AND CUTTING INSTRUMENT WITH
MANUALLY RETRACTABLE FIRING MEMBER

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**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT
NO. 7,490,749 PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42**

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EXHIBITS

- IS1001 U.S. Patent No. 7,490,749 to Schall, et al. (“’749 Patent”)
- IS1002 Excerpts from the Prosecution History of the ’749 Patent (“the Prosecution History”)¹
- IS1003 Declaration of Dr. Knodel, including Curriculum Vitae
- IS1004 US Patent Publication No. 2006/0175375 (“Shelton II”)
- IS1005 US Patent Publication No. 2005/0178813 (“Swayze”)
- IS1006 US Patent No. 8,322,455 (“Shelton I”)
- IS1007 Complaint for Patent Infringement, *Ethicon LLC, et al. v. Intuitive Surgical, Inc., et al.*, Case No. 1:18-cv-01325 (D. Del. Aug. 27, 2018)
- IS1008 How Design Teams Use DFM/A to Lower Costs and Speed Products to Market (1996) (retrieved from http://www.ame.org/sites/default/files/target_articles/96q1a2.pdf)
- IS1009 Electronic Comparison of Written Description of Swayze (US 2005/0178813; Original) to Shelton II (US 2006/0175375; Underline/Strikethrough)
- IS1010 U.S. Patent No. 5,941,442
- IS1011 U.S. Patent No. 5,865,361
- IS1012 Excerpts from McGraw-Hill Dictionary of Scientific and Technical Terms (6th Edition, 2003)

¹ Copies of foreign patent references removed.

Intuitive Surgical, Inc. (“Petitioner”) petitions for *Inter Partes* Review (“IPR”) of claims 1 and 3 (“the Challenged Claims”) of U.S. Patent No. 7,490,749 (“the ’749 Patent”).

I. MANDATORY NOTICES—37 C.F.R. § 42.8

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

Intuitive Surgical, Inc. is the real party-in-interest.

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

Petitioner is not aware of any disclaimers, reexamination certificates, or petitions for IPR of the ’749 Patent. The ’749 Patent is the subject of Civil Action No. 1:18-cv-01325, filed on August 27, 2018 in the District Court for the District of Delaware. And the following IPRs involve patents that belong to Patent Owner and have been asserted against Petitioner in the District of Delaware: *Intuitive Surgical, Inc. v. Ethicon LLC*, Case Nos. IPR2018-00933, -934, -935, -936, -938, -1247, -1703, -1248, and -1254.

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

Petitioner provides the following designation of counsel.

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D. Service Information

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Petitioner consents to electronic service by email at IPR11030-0052IP1@fr.com
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II. PAYMENT OF FEES—37 C.F.R. § 42.103

Petitioner authorizes the Office to charge Deposit Account No. 06-1050 for
the petition fee set in 37 C.F.R. § 42.15(a) and for any other required fees.

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