

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2019-00880
U.S. Patent No. 7,490,749

PATENT OWNER'S MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner Ethicon LLC submits the following mandatory notices.

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

Ethicon LLC (the assignee of U.S. Pat. No. 7,490,749 (“the 749 Patent”)) is an indirect subsidiary of Johnson & Johnson. Ethicon LLC has exclusively licensed Ethicon Endo-Surgery, Inc. to sell products in the United States that would infringe the 749 Patent absent a license. Ethicon Endo-Surgery, Inc. has exclusively sublicensed that right to Ethicon US, LLC. Ethicon US, LLC and Ethicon Endo-Surgery, Inc. are indirect subsidiaries of Johnson & Johnson.

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

Patent Owner identifies the following judicial and/or administrative matters that may be deemed related under 37 C.F.R. § 42.8(b)(2):

The 749 Patent is presently asserted in *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, C.A. No. 1:18-cv-01325-LPS (D. Del.) (“the Delaware litigation”). U.S. Pat. Nos. 9,884,369 (“the 369 Patent”), 8,602,288 (“the 288 Patent”), 8,602,287 (“the 287 Patent”), and 9,326,770 (“the 770 Patent”) are also asserted in the Delaware litigation. On March 12, 2019, Patent Owner filed a motion for leave to file an amended complaint in the Delaware litigation to withdraw infringement allegations relating to the 770 Patent and assert two additional patents, U.S. Patent No. 9,844,379 (“the 379 Patent”) and U.S. Patent

No. 8,479,969 (“the 969 Patent”). As of April 17, 2019, Patent Owner’s motion is still pending. The 969 Patent is also presently asserted in *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, C.A. No. 1:17-cv-00871-LPS (D. Del.).

No patents or applications claim priority to U.S. Patent Application No. 11/729,355, which issued as the 749 Patent.

The 749 Patent states that it is related to U.S. Patent Application No. 11/729,013, filed Mar. 28, 2007 (the “013 Application”), now U.S. Patent No. 8,056,787. No patents or applications claim priority to the 013 Application.

The 749 Patent is subject to a terminal disclaimer tied to U.S. Patent Application No. 11/497937, filed Aug. 2, 2006 (the “937 Application”), now U.S. Patent No. 7,441,684. U.S. Patent No. 7,431,189 claims priority to the 937 Application.

C. Lead and Back-Up Counsel and Service Information (37 C.F.R. § 42.8(b)(3)-(4))

Patent Owner identifies the following lead and back-up counsel and service information:

<u>Lead Counsel</u>	<u>Back-Up Counsel</u>
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Please address all correspondence to lead and backup counsel. Patent Owner consents to service by electronic mail at the following address:

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Date: April 16, 2019

Respectfully submitted,

/Anish R. Desai/

Anish R. Desai

Reg. No. 73,760

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on April 16, 2019, the foregoing
**PATENT OWNER'S MANDATORY NOTICES PURSUANT TO 37 C.F.R. §
42.8** was served via electronic mail, upon the following:

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