

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTUITIVE SURGICAL, INC.,  
Petitioner,

v.

ETHICON LLC,  
Patent Owner.

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Case IPR2019-00880  
Patent 7,490,749

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**SUPPLEMENTAL DECLARATION OF DR. BRYAN KNODEL**

I, Bryan Knodel, declare as follows:

## I. INTRODUCTION

1. I have been engaged as an expert by Fish & Richardson P.C. on behalf of Intuitive Surgical, Inc. (“Intuitive”) for the above-captioned *inter partes* review. I understand that this proceeding involves United States Patent No. 7,490,749 entitled “Surgical Stapling and Cutting Instrument With Manually Retractable Firing Member” attributed to inventors Christopher J. Schall and Chad P. Boudreaux, filed March 28, 2007 and issued February 17, 2009 (the ’749 Patent). I understand that the ’749 Patent is currently assigned to Ethicon LLC (“Ethicon”).

2. I understand that this declaration will be submitted in support of Intuitive’s Reply to Ethicon’s Response to the Petition for *inter partes* review of the ’749 Patent. This declaration supplements, and is intended to be read in conjunction with, my declaration in support of Intuitive’s Petition (IS1003, “my Prior Declaration”). In my Prior Declaration, I address many topics, including (but not limited to) my background and qualifications, the level of skill in art, an overview of the ’749 Patent, claim construction, certain legal standards explained to me by Intuitive’s counsel, and a detailed analysis of the prior art against claims 1 and 3 of the ’749 Patent. The opinions and explanations expressed in my Prior Declaration apply equally here.

## II. MATERIALS CONSIDERED

3. I have reviewed and am familiar with the '749 Patent (IS1001) and its file history (IS1002). I am also familiar with the following prior art used in the Petition: Shelton II (IS1004), Swayze (IS1005), and Shelton I (IS1006). In addition to these items, I have reviewed the Declaration of Dr. Shorya Awtar (EX2019, public version) and the transcript of Dr. Awtar's deposition (IS1015). I will discuss these and several other documents in detail below.

## III. TECHNICAL DISCUSSION

4. The analysis and opinions expressed in my Prior Declaration fully explain why each and every feature of the '749 Patent's claims 1 and 3 is provided in the prior art. I offered additional explanation in my subsequent deposition (EX2018). Dr. Awtar has considered my opinions and offered his own, some of which are inconsistent with my view. I will address some of those points below. The fact that I have not addressed all of Dr. Awtar's opinions should not be interpreted as agreement with them.

### **A. A Person of Ordinary Skill in the Art Would Have Immediately Envisioned Removal of Shelton II's Retraction Spring**

5. I concluded in my Prior Declaration that Shelton II's instruction at Paragraph [0154] to eliminate the tension/compression spring 1184 (a retraction spring) would have been enough to place such a configuration in the mind of an ordinarily skilled person. IS1003, ¶62. I understand that Dr. Awtar has reached a

different conclusion. In Dr. Awatar’s opinion, “a person of ordinary skill would have interpreted Paragraph [0154] to refer to the description in Paragraph [0144] of Shelton II,” which pertains to operation of the device when the retraction spring becomes disconnected. EX2019, ¶92. I preemptively addressed Dr. Awatar’s position in my Prior Declaration. There, I explained that interpreting Paragraph [0154] in a manner that adds nothing of substance to Paragraph [0144] would have been redundant, and therefore incorrect. IS1003, ¶60. The following discussion further expounds on this in view of Shelton II’s surrounding disclosure.

6. At Paragraph [0148], Shelton II suggests that the paragraphs to follow, including Paragraph [0154], describe “[*a*]dditional advantages and modifications [that] may readily appear to those skilled in the art.” As Dr. Awatar pointed out, Paragraph [0144] already alludes to the advantage of a manual backup mechanism—i.e., “the user can actuate the manual retraction mechanism if the spring were to disconnect from the firing drive.” EX2019, ¶92. It would therefore not make sense to interpret Paragraph [0154] as describing the same thing, especially when Paragraph [0148] prepares the reader for *additional* subject matter.

7. Each paragraph following Paragraph [0148] describes something *additional*—an embodiment modified from those illustrated in Shelton II’s figures and described in the preceding sections of the specification. Paragraph [0149] describes an alternative configuration where a single actuation mechanism is used

for both closing and firing operations. The illustrated embodiments have separate triggers for closing and firing. IS1004 [Shelton II], Figure 1 (elements 34/36), Figure 35 (elements 1034/1036). Paragraph [0150] describes an embodiment where “a motorized or otherwise powered handle” replaces the “manually actuated handle” of the illustrated embodiments. Paragraph [0151] indicates that the linked-rack firing drive can be replaced by “a straight rack” firing drive. Paragraph [0152] makes clear that automatic retraction, as described with reference to the illustrated embodiments, “may be desirable” but is not mandatory—i.e., “a manual retraction may be incorporated *without this feature*.” Paragraph [0153] notes that a “single stroke firing mechanism” can be substituted in place of the “multi-stroke firing mechanism” of the illustrated embodiments.

8. With all of these neighboring paragraphs plainly describing subject matter beyond the illustrated embodiments, a person of ordinary skill would not have expected anything different of Paragraph [0154]. From this perspective, when Paragraph [0154] says “a manual retraction mechanism consistent with aspects of the invention may be utilized *without the assistance of a retraction spring*,” the logical way to interpret this is that the same devices shown and discussed throughout the specification can be provided “without” the retraction spring. Again, it would not make sense to read this statement as referencing a scenario where the retraction spring becomes disconnected, as this was already described at Paragraph [0144] and

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