

PUBLIC VERSION

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
Patent 7,490,749

PETITIONER'S MOTION TO EXCLUDE EVIDENCE

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I. INTRODUCTION

Intuitive moves to exclude, in whole or in part, Exhibits 2003-2007, 2009 and 2013-2015. Ethicon submitted these exhibits with the Patent Owner Response (Paper 15) as part of an attempt to antedate its own prior patent filings. Intuitive raised several timely objections (Paper 18), yet Ethicon took no curative action. Ethicon instead chose to proceed with unsupplemented, inadmissible evidence. Ethicon should be held to its choice, and the Board should exclude the objected-to portions of Exhibits 2003-2007, 2009 and 2013-2015.

II. ARGUMENT

A. Exhibits 2003 and 2009 Contain Inadmissible Hearsay

i. *Ethicon Relies on Out of Court Statements for Their Truth*

The table below catalogs the specific statements in Exhibit 2003 and Appendices 1-2 of Exhibit 2009 (the Hearsay Exhibits) that constitute hearsay. *See* FRE 801. These out-of-court statements lack relevance outside of their truthfulness and, thus, have no “non-hearsay” purpose.

[REDACTED]	[REDACTED]	[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]

[REDACTED]	[REDACTED]	[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]

ii. *Ethicon Failed to Provide a Foundation for the “Business Record” Exception*

Ethicon has not established the Hearsay Exhibits as admissible business records for multiple reasons. First, Ethicon failed to provide pertinent testimony from an independent “custodian or qualified witness.” FRE 806(6)(D). The ’749 Patent’s inventors, who themselves rely on the Hearsay Exhibits, do not fit the bill. *See Chen v. Bouchard*, 347 F.3d 1299, 1308 (Fed. Cir. 2003) (affirming the Board’s

exclusion of lab notebooks as hearsay lacking a business-record exception in view of “circular testimony” from an inventor that the notebooks were intended to corroborate). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]; *see also United States v. Wables*, 731 F.2d 440, 449 (7th Cir. 1984) (“It is clear that, in admitting documents under the business records exception to the hearsay rule, the testimony of the custodian or otherwise qualified witness who can explain the record-keeping of his organization is ordinarily essential.”).

Second, it is not clear from the testimony of [REDACTED] that the Hearsay Exhibits were “kept in the course of a regularly conducted activity of [Ethicon’s] business.” FRE 806(6)(B). [REDACTED]

[REDACTED]

[REDACTED] *See* Ex. 2008, ¶2; Ex. 2009, ¶3; *see Chen*, 347 F.3d at 1308 (noting “the lack of evidence of [the proponents’] policies regarding maintenance of laboratory notebooks” in rationale affirming the Board’s hearsay exclusion).

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