

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 REPLY TO PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION EXCLUDE EVIDENCE**

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I. INTRODUCTION

Ethicon's Exhibits 2003-2007, 2009 and 2013-2015 should be excluded for all the reasons set forth in Intuitive's Motion to Exclude (Paper 35). The ineffective arguments in Ethicon's Opposition (Paper 39) cannot remedy the evidentiary deficiencies Ethicon chose to leave uncured by supplemental evidence.

II. ARGUMENT

A. Hearsay (FRE 801/803): Ethicon Confuses the Issues and Misapplies the Law

i. The Dates on Exhibits 2003 and 2009 Have No Relevance Beyond Their Truth

Ethicon claims that the dates in Exhibits 2003 and 2009 serve a non-hearsay purpose. Opp., p. 3. They do not. Unlike the *Seabery* decision cited by Ethicon, the present issue is not whether a prior art reference was made publically available. See Opp., 3 (citing *Seabery N. Am. Inc. v. Lincoln Glob., Inc.*, IPR2016-00840, Paper 60 at 5-6 (PTAB Oct. 2, 2017)). It is the alleged date of a reduction to practice that matters in this case. In *Seabery*, the Panel found dates appearing in an exhibit to be non-hearsay because they provided "circumstantial evidence of publication and [were] *not* assertions that publication occurred *on a date certain.*" *Seabery* at 6 (emphasis added). In contrast, Ethicon asserts here that the dates in Exhibits 2003 and 2009 establish "[redacted] designed and built the prototype." Opp., p.3 (emphasis added). By its own admission, Ethicon relies on the dates in question for their truth. The dates are, therefore, hearsay.

ii. *Authorship Alone Does Not Make [REDACTED] “Qualified Witnesses” Under the Business Records Exception*

Ethicon argues: “As the creators of Ex. 2003 and Appendices 1 and 2 of Ex. 2009, [REDACTED] are clearly qualified [witnesses].” Opp., p.5. But no authority supports the proposition that a document creator is necessarily a “qualified witness” under FRE 803(6)(D). The relevant question is whether the witness “can explain the record-keeping of his organization.” *United States v. Wables*, 731 F.2d 440, 449 (7th Cir. 1984). The Federal Circuit’s *Conoco Inc. v. Dep’t of Energy* decision cited by Ethicon is not inconsistent with this approach. Opp., p.5 (citing 99 F.3d 387, 391 (Fed. Cir. 1996)). The *Conoco* decision relies on 7th Circuit precedent that holds a “qualified witness” must “be someone with knowledge of *the procedure* governing the creation *and maintenance* of the type of records sought to be admitted.” *United States v. Franco*, 874 F.2d 1136, 1139 (7th Cir. 1989). Ethicon’s problem is that [REDACTED] do not even attempt to explain anything like a “procedure” for “maintenance” of [REDACTED]. [REDACTED]

They instead mimic the language of FRE 803(6)(C) in footnotes that vaguely reference Ethicon’s “regular practices.” Notably absent is any discussion of what those alleged practices entail.

Even if [REDACTED] were “qualified witnesses” (they are not), their conclusory testimony does not establish that the files in question were

“kept in the course of a regularly conducted activity of [Ethicon].” FRE 803(6)(B).

For example, [REDACTED] do not explain how or where the files were maintained over the last decade, per Ethicon’s alleged “regular practice.” Such an explanation is not “irrelevant,” as Ethicon argues. Opp., p.6. It is a codified condition of the business record exception.

B. Authentication (FRE 901): Ethicon’s Attorney Argument Cannot Remedy Evidentiary Deficiencies

i. *The Federal Circuit Has Upheld Exclusion of Evidence Where the Only Basis for Authentication Was Inventor Testimony*

According to Ethicon, “Petitioner has failed to cite a single district court or Federal Circuit case to support [the] assertion” that an inventor’s testimony may be insufficient to authenticate a document relied on to corroborate the same inventor’s testimony. Opp., p.8. Not so. Intuitive’s Motion cited *REG Synthetic Fuels, LLC v. Neste Oil Oyj*, a decision where the Federal Circuit affirmed the Board’s exclusion of documents for lack of authentication. See 841 F.3d 954, 965 (Fed. Cir. 2016).

The Board’s reasoning was as follows:

“While normally, the testimony of Mr. Abhari—as a witness having personal knowledge of the documents—could be sufficient to ‘support a finding that the item is what the proponent claims it is,’ *the context in which these exhibits are offered requires more*. Specifically, because REG relies on these exhibits to corroborate the testimony of Mr. Abhari, in an attempt to prove invention prior to the Dindi prior art reference, *independent evidence of authenticity is required: . . .*”

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