

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 UPDATED 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 updated mandatory notices.

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

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)) - Updated

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 second Delaware litigation”). U.S. Pat. Nos. 9,844,369 (“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 second Delaware litigation. On March 12, 2019, Patent Owner filed a motion for leave to file an amended complaint in the second 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”). On July 17, 2019, Patent Owner’s motion was denied without prejudice in light of the parties’ joint stipulation to stay the second Delaware litigation. 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.) (“the first Delaware litigation”).

The 749 Patent is also presently asserted in *Certain Reload Cartridges for Laparoscopic Surgical Staplers*, Inv. No. 337-TA-1167 (USITC), along with U.S. Pat. No. 9,113,874 (“the 874 Patent”) and the 369, 379, and 969 Patents.

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)) - Unchanged

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: July 22, 2019

Respectfully submitted,

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