

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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IPR2019-00880  
Patent 7,490,749 B2

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Record of Oral Hearing  
Held: June 9, 2020

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Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

IPR2019-00880  
Patent 7,490,749 B2

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The above-entitled matter came on for hearing on Thursday, July 9, 2020, commencing at 9:00 a.m. EDT, by video.

PROCEEDINGS

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JUDGE MEYERS: -- for IPR 2019-00880. This is Judge Meyers and here with me are Judges Cocks and Woods. Oh, excuse me, Wood.

Will counsel for Petitioner please introduce themselves?

MR. KATZ: Thank you, Your Honor. This is Steven Katz with Fish & Richardson. With me is Kenneth Darby and Josh Griswold on the audio line and also I believe that Scott Mosko from Intuitive will be joining the audio, but I don't believe he has and today's argument will be handled by Kenneth Darby.

JUDGE MEYERS: All right. Thank you, Mr. Katz.

All right. Will counsel for Patent Owner please introduce themselves?

MR. PEPE: Good morning, Your Honor. This is Christopher Pepe. I'll be arguing for Patent Owner. With me on the line and video is Anish Desai who is lead counsel and I believe Mike Timmons from -- on behalf of Patent Owner is also on the audio line.

MR. TIMMONS: Yes, I am. Thank you, Your Honors.

JUDGE MEYERS: All right. Thank you, Mr. Pepe.

According to the hearing order, I believe both sides will have 45 minutes; is that correct?

MR. PEPE: Yes, Your Honor. That sounds correct.

JUDGE MEYERS: Okay. Petitioner proceeds first to discuss its case and they will reserve rebuttal time to reply to Patent Owner's arguments. Patent Owner will then proceed with its case and may reserve rebuttal time to surreply to Petitioner's reply.

1 Before we begin, I would like to ask the parties to identify their slides  
2 by number for the court reporter and for the benefit of the judges that are all  
3 remote at this time. With that, we'd like to begin.

4 Petitioner, I don't really have a clock so I'm going to -- or actually a  
5 phone with me right now to set a timer. So I will ask Judge Cocks or Judge  
6 Wood if you could set a timer. How much time would you like to reserve  
7 for rebuttal?

8 MR. DARBY: I'll be reserving 10 minutes for rebuttal and 35  
9 minutes for opening.

10 JUDGE MEYERS: Okay. So 35 minutes for opening, all right. And  
11 10 for rebuttal. All right.

12 All right. Judge Cocks or Judge Wood, would you mind setting a  
13 timer?

14 JUDGE COCKS: Judge Meyers, this is Judge Cocks. I'll go ahead  
15 and set the timer.

16 JUDGE MEYERS: Thanks. I appreciate that.

17 All right. With that, you can begin.

18 MR. DARBY: Okay. Thank you, Your Honors. This is again  
19 Kenneth Darby speaking for Petitioner. We'll start today on Slide 2. It's a  
20 -- there's a quick preview of things we'll be discussing today so we'll start  
21 with an overview of the '749 Patent, very brief overview, and then we'll talk  
22 about the instituted grounds, in a few words our claim construction and then  
23 we'll dive into the arguments and we're going to talk about all three  
24 arguments at play with Grounds 1 and Grounds 2.

25 Ground 1 is the Shelton II ground, Ground 2 is the Swayze ground.  
26 We're going to talk about in Ground 1 a unique anticipation argument to

1 Shelton II and then we'll talk about another flavor of anticipation that  
2 applies to both Shelton II and Swayze. We're going to go a little bit out of  
3 order here and then we'll follow-up with obviousness that again both applies  
4 to both Shelton II and Swayze.

5 So with that, I'll move to Slide 4 so we can answer the question what  
6 is the '749 Patent all about. Well, the abstract here tells us that the '749  
7 Patent is about a surgical stapling and severing instrument particularly suited  
8 for endoscopic procedures. So it's an endo stapler. And the '749 Patent's  
9 endo stapler has a retraction system and the abstract tells us that it's  
10 manually actuatable and it does not require the use of additional springs or  
11 other mechanisms to generate retraction forces. So it's a fully manual  
12 retraction system. That's what the '749 Patent is about.

13 So if we turn to the claims, I'm on Slide 5 now, we see how this fully  
14 manual retraction mechanism (indiscernible) claim. The claim says,  
15 "Retraction assembly supported by said handle assembly and interfacing  
16 with said firing drive such that manual actuation of said retraction assembly  
17 causes said firing drive to generate a sole retraction motion." And that's the  
18 key phrase, "sole retraction motion." That's how inventors decided to claim  
19 a fully retraction -- or excuse me, a fully manual retraction assembly so  
20 we're going to focus on that.

21 I think you see in the briefs that all three of the references in the  
22 petition; that's Shelton II, that's Swayze and that's Shelton I, all three of  
23 those references provide this feature. Now, all of the other features of Claim  
24 1 and Claim 3, the challenged claims and I'm going to focus again on those  
25 first two references. I'm going to focus on Shelton II and Shelton I -- or  
26 excuse me, Shelton II and Swayze.

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