

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2019-00880
Patent 7,490,749 B2

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

MEYERS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
Dismissing Petitioner's Motion to Exclude
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background and Summary*

Intuitive Surgical, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1 and 3 of U.S. Patent No. 7,490,749 B2 (Ex. 1001, “the ’749 patent”). Ethicon LLC (“Patent Owner”) did not file a Preliminary Response. We instituted an *inter partes* review on all claims and all grounds asserted in the Petition. *See* Paper 7 (“Dec. on Inst.”).

After institution of trial, Patent Owner filed a Patent Owner Response. Paper 15 (“PO Resp.”).¹ Petitioner filed a Reply. Paper 27 (“Pet. Reply”).² Patent Owner filed a Sur-Reply. Paper 32 (“Sur-Reply”).³ Petitioner filed a Motion to Exclude (Paper 36⁴), to which Patent Owner filed an Opposition (Paper 39⁵), and to which Petitioner filed a Reply (Paper 42⁶).

¹ A confidential, unredacted version of the Patent Owner Response was filed as Paper 16.

² A confidential, unredacted version of the Petitioner’s Reply was filed as Paper 26.

³ A confidential, unredacted version of the Patent Owner’s Sur-Reply was filed as Paper 31.

⁴ A confidential, unredacted version of the Petitioner’s Motion to Exclude was filed as Paper 35.

⁵ A confidential, unredacted version of the Patent Owner’s Opposition was filed as Paper 38.

⁶ A confidential, unredacted version of the Petitioner’s Reply was filed as Paper 41.

Both parties also seek to have portions of the record maintained under seal. Papers 17, 25, 34, 37, 40. Those Motions to Seal will be decided in due course via a separate Order or Orders.

A hearing was held on July 9, 2020, and a transcript of the hearing is included in the record. *See* Paper 44 (“Tr.”).

We have authority under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1 and 3 of the ’749 patent are unpatentable.

B. Real Parties in Interest

Petitioner identifies itself as the only real party in interest. Pet. 1. Patent Owner identifies itself as a real party in interest. Paper 5, 2. Patent Owner indicates that it is “an indirect subsidiary of Johnson & Johnson.” *Id.*

C. Related Matters

The parties state that the ’749 patent is the subject of Civil Action No. 1:18-cv-01325 filed August 27, 2018 in the U.S. District Court for the District of Delaware. Pet. 1; Paper 5, 2. Petitioner also states that it has filed other petitions for *inter partes* review of patents owned by Patent Owner and asserted against Petitioner in the District of Delaware. *Id.*

D. The '749 Patent

The '749 patent issued February 17, 2009 from an application filed March 28, 2007, and is titled "SURGICAL STAPLING AND CUTTING INSTRUMENT WITH MANUALLY RETRACTABLE FIRING MEMBER." Ex. 1001, codes (45), (22), (54). The '749 patent describes a surgical stapler that applies lines of staples to tissue and cuts the tissue between the staple lines, and that has manual retraction capabilities. *Id.* at 1:17–24. Figure 1, reproduced below, depicts a surgical stapler according to the '749 patent:

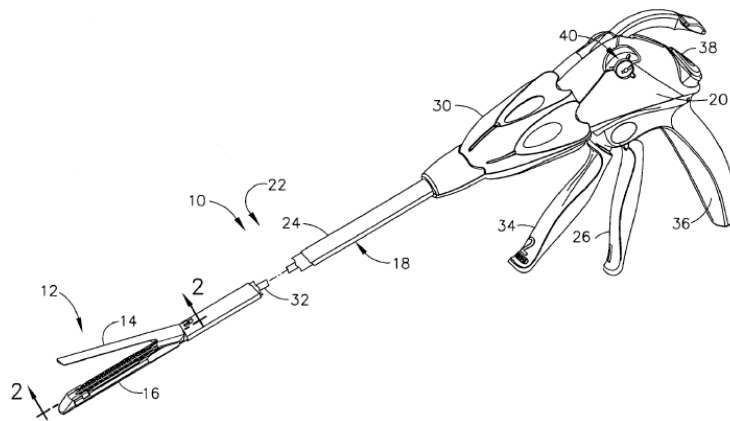


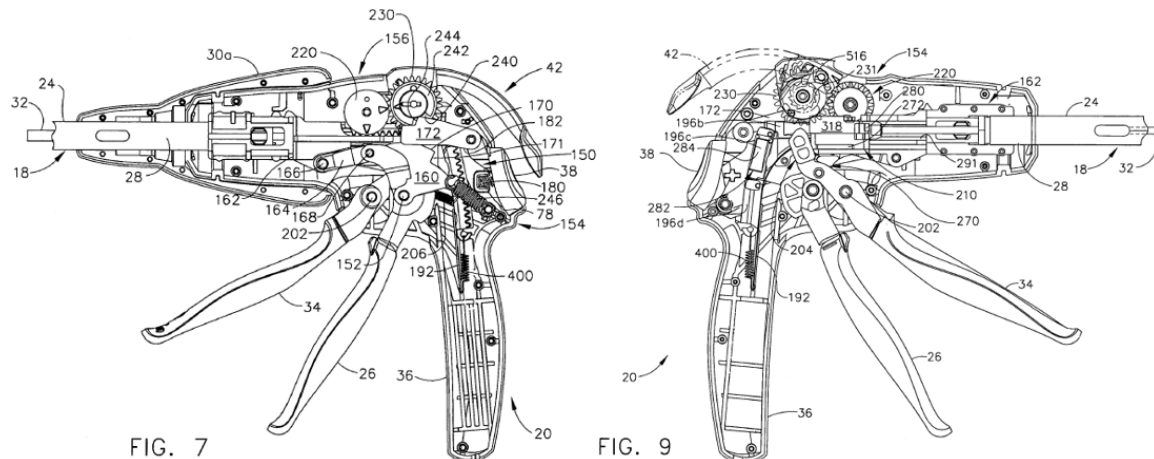
FIG. 1

Figure 1, reproduced above, depicts surgical stapling and severing instrument 10 comprising end effector 12 coupled to elongate shaft assembly 18, which in turn is coupled to handle 20. *Id.* at 5:36–43. End effector 12 comprises anvil 14 pivotally attached to elongate channel 16 to form opposing jaws for clamping tissue. *Id.* at 5:39–41. Closure tube 24 of shaft assembly 18 is coupled between closure trigger 26 and anvil 14. *Id.* at 5:60–

61. Firing rod 32⁷ is positioned for longitudinal movement and coupled between anvil 14 and multiple-stroke firing trigger 34. *Id.* at 6:6–9.

In an endoscopic operation, a surgeon first inserts end effector 12 and shaft assembly 18 in the surgical site and positions the end effector around the tissue to be stapled and severed. The surgeon then depresses closure trigger 26 fully toward pistol grip 36 to move closure tube 24 distally to push anvil 14 pivotally toward elongate channel 16, thereby clamping the tissue between the anvil and elongate channel. *Id.* at 6:19–22, 7:20–23.

The surgeon then fires the instrument. *Id.* at 6:26–30. Figures 7 and 9, reproduced below, depict portions of the instrument's firing mechanism:



Figures 7 and 9, reproduced above, provide left and right views, respectively, of portions of linked transmission firing drive 150. Upper portion 204 of firing trigger 34 engages each of links 196a-d of linked rack 200 (shown more clearly in Figures 8 and 10) during each firing stroke depression, incrementally advancing linked rack 200 distally. *Id.* at 10:19–43. Because firing rod 32 is attached to linked rack 200, it also advances

⁷ The '749 patent also refers to this structure as “firing bar 32.” *See, e.g.*, Ex. 1001, 12:11, 56–57.

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