

Trials@uspto.gov  
571-272-7822

Paper 43  
Date: November 25, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

INTUITIVE SURGICAL, INC.,  
Petitioner,

v.

ETHICON LLC,  
Patent Owner.

---

IPR2019-00991  
Patent 8,602,287 B2

---

Before JOSIAH C. COCKS, ZHENYU YANG, and  
JOHN E. SCHNEIDER, *Administrative Patent Judges.*

YANG, *Administrative Patent Judge.*

JUDGMENT

Final Written Decision  
Determining All Challenged Claims Unpatentable  
*35 U.S.C. § 318(a)*

Granting-in-Part, Dismissing-in-Part, and Denying-in-Part  
Patent Owner's Motion to Exclude (Paper 37)  
*37 C.F.R. § 42.64(c)*

Granting-in-Part, Denying-in-Part without Prejudice  
Patent Owner's Motion to Seal (Paper 15)  
*37 C.F.R. § 42.55*

Granting-in-Part, Denying-in-Part without Prejudice to Patent Owner  
Petitioner's Motion to Seal (Paper 24)  
*37 C.F.R. § 42.55*

Granting Patent Owner's Motion to Seal (Paper 34)  
*37 C.F.R. § 42.55*

## I. INTRODUCTION

### A. *Background and Summary*

Intuitive Surgical, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) seeking an *inter partes* review of claims 13–15, 17, and 18 of U.S. Patent No. 8,602,287 B2 (Ex. 1001, “the ’287 patent”). We instituted trial to review the challenged claims. Paper 6 (“Dec.”). Thereafter, Ethicon LLC (“Patent Owner”) filed a Response to the Petition (Paper 16, “PO Resp.”), Petitioner filed a Reply (Paper 25), and Patent Owner filed a Sur-Reply (Paper 34). The parties also filed Patent Owner’s Identification of Allegedly New Arguments in Petitioner’s Reply and Petitioner’s Response Thereto (Paper 32), and briefed the issue whether we should exclude certain arguments in Petitioner’s Reply and evidence in support thereof (Papers 37, 39, 40). An oral hearing for this proceeding was held on September 10, 2020, and a transcript of that hearing is of record. *See* Paper 42 (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6 and issues this final written decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons provided below, and based on the evidence and arguments presented in this proceeding, we conclude Petitioner has established by a preponderance of the evidence that claims 13–15, 17, and 18 of the ’287 patent are unpatentable.

### B. *Related Matters*

According to the parties, Patent Owner asserted the ’287 patent against Petitioner in *Ethicon LLC v. Intuitive Surgical, Inc.*, Case 1:18-cv-1325 (D. Del.). Pet. 2; Paper 5, 2.

### C. *The ’287 Patent*

The ’287 patent is directed to a motor-driven surgical cutting and fastening instrument that comprises an end effector, an electric motor, and a

motor control circuit. Ex. 1001, Abstract. Figure 1, reproduced below, depicts a surgical instrument according to the '287 patent:

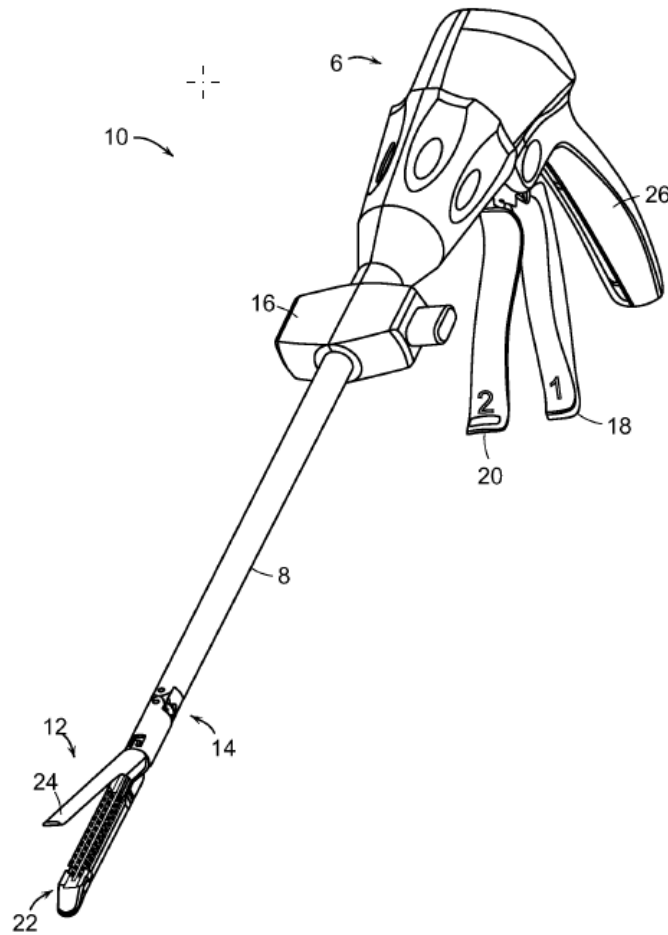


FIG. 1

Figure 1 of the '287 patent depicts a motor-driven surgical cutting and fastening instrument 10. Ex. 1001, 3:6–7. Surgical instrument 10 comprises handle 6, shaft 8, and articulating end effector 12 pivotally connected to shaft 8. *Id.* at 3:16–18.

Figure 3 of the '287 patent is reproduced below:

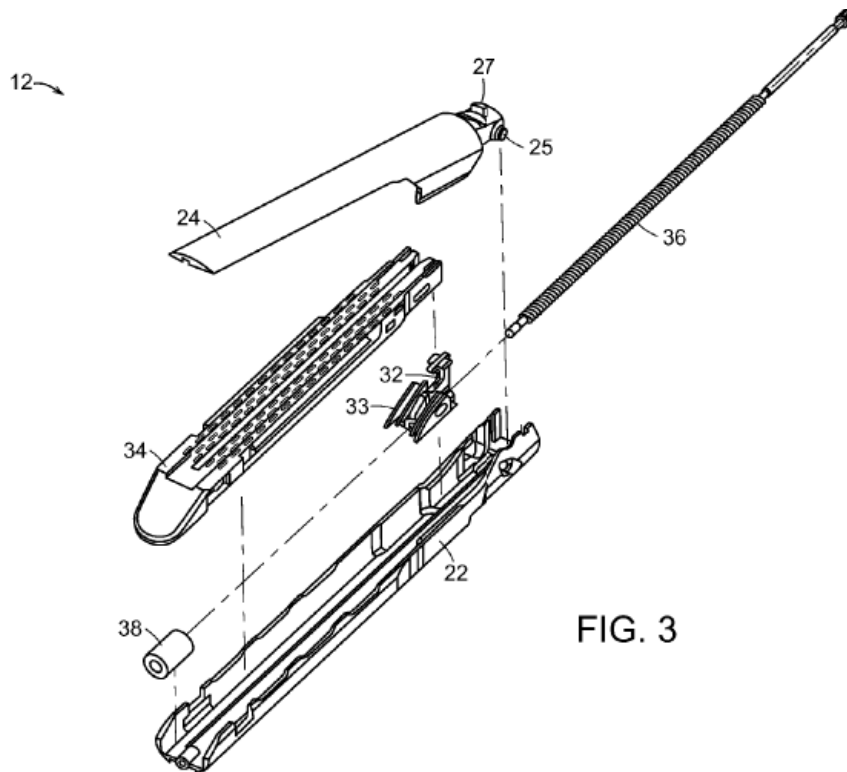


FIG. 3

Figure 3 is an exploded view of end effector 12. *Id.* at 4:22. End effector 12 includes channel 22, anvil 24, cutting instrument 32, sled 33, staple cartridge 34 that is removably seated in channel 22, and helical screw shaft 36. *Id.* at 4:24–27. Cutting instrument 32 may be, for example, a knife. *Id.* at 4:28.

According to the '287 patent, in operational use, closure trigger 18 may be actuated first. *Id.* at 4:8–9.

When the closure trigger 18 is actuated, that is, drawn in by a user of the instrument 10 toward the pistol grip portion 26, the anvil 24 may pivot about the pivot point 25 into the clamped or closed position. If clamping of the end effector 12 is satisfactory, the operator may actuate the firing trigger 20, which causes the knife 32 and sled 33 to travel longitudinally along the channel 22, thereby cutting tissue clamped within the end effector 12. The movement of the sled 33 along the channel 22 causes the staples of the staple cartridge 34 to be driven through the severed tissue and against the closed anvil 24, which turns the staples to fasten the severed tissue.

*Id.* at 4:34–45.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.