

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

ETHICON LLC, CILAG GMBH INTERNATIONAL,
Appellants

v.

INTUITIVE SURGICAL, INC.,
Appellee

2021-1601

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2019-
00991.

Decided: May 19, 2022

ADAM BANKS, Weil, Gotshal & Manges LLP, New York,
NY, argued for appellants. Also represented by ANISH R.
DESAI, ELIZABETH WEISWASSER; STEPHANIE NICOLE
ADAMAKOS, PRIYATA PATEL, CHRISTOPHER PEPE, AUDRA
SAWYER, Washington, DC.

STEVEN KATZ, Fish & Richardson, P.C., Boston, MA, ar-
gued for appellee. Also represented by RYAN PATRICK
O'CONNOR, JOHN C. PHILLIPS, San Diego, CA.

Before NEWMAN, CLEVINGER, and STOLL, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* STOLL.

Circuit Judge NEWMAN dissents without opinion.

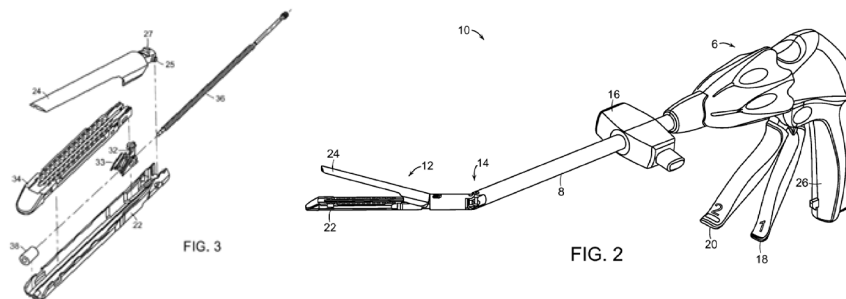
STOLL, *Circuit Judge*.

This is a patent validity case. Ethicon LLC and Cilag GmbH International (collectively, “Ethicon”) appeal from the Patent Trial and Appeal Board’s final written decision holding claims 13–15 and 17–18 of U.S. Patent No. 8,602,287 unpatentable as obvious. Ethicon challenges the Board’s fact findings regarding analogous art and motivation to combine prior art references. Because substantial evidence supports the Board’s findings, we affirm.

BACKGROUND

I

Ethicon is the assignee of the ’287 patent which is directed to a motor-driven surgical cutting instrument. Specifically, the ’287 patent is directed to a motor-driven “endocutter,” which is a tool that simultaneously cuts and staples tissue along the edges of the cut.



’287 patent, Figs. 2–3; *see also id.* at col. 1 l. 56–col. 2 l. 9.

Claim 13 of the ’287 patent is representative of the claims on appeal:

13. A surgical instrument, comprising:

an end effector comprising a firing element, wherein the firing element is configured to move along a firing path, and wherein the firing path comprises:

an initial position; and

an end-of-stroke position;

an electric motor, wherein the electric motor drives the firing element in a first direction along the firing path when the electric motor is rotated in a first rotational direction; and

a control circuit for controlling the electric motor, wherein the control circuit is configured to switch between a plurality of operational modes during rotation of the electric motor in the first rotational direction, and wherein the plurality of operational modes comprises:

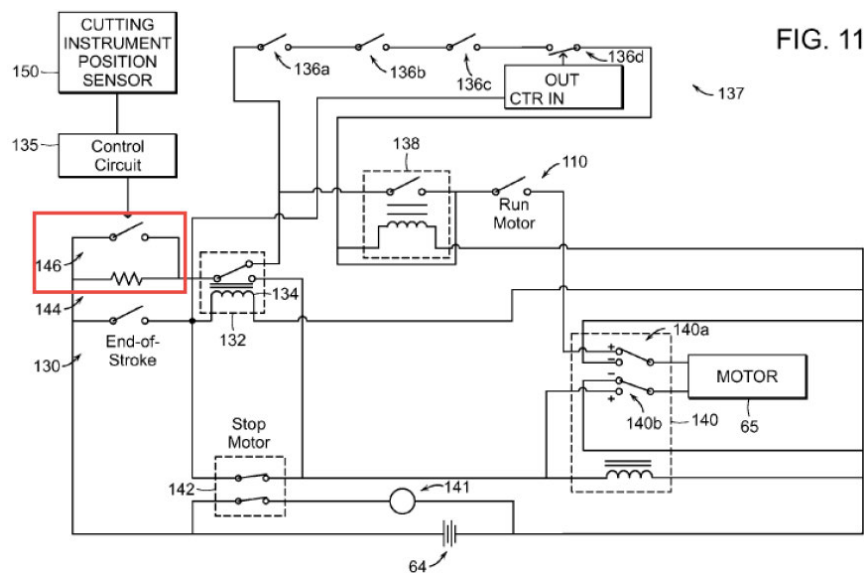
a first operational mode, wherein the control circuit operates in the first operational mode when the firing element is positioned within a first range of positions along the firing path, wherein the first range of positions is positioned between the initial position and a second range of positions, and wherein a first amount of current is supplied to the electric motor during the first operational mode; and

a second operational mode, wherein the control circuit operates in the second operational mode when the firing element is positioned within the second range of positions along the firing path, wherein the

second range of positions is positioned between the first range of positions and the end-of-stroke position, wherein a second amount of current is supplied to the electric motor during the second operational mode, and wherein the second amount of current is greater than the first amount of current.

Id. at col. 18 l. 58–col. 19 l. 24.

The purportedly inventive feature of claim 13 is that the motor for driving the endocutter uses two “operational modes,” which apply two different amounts of current to the motor based on the positioning of the firing element in the firing path. In describing how this two-mode operation works, Ethicon repeatedly cites a specific portion of column 12. There, the '287 patent describes a “soft’ start quality by limiting the motor’s ability to exert full load immediately.” *Id.* at col. 12 ll. 33–41. This is accomplished by initially having “resistive element 144” in series with the motor on startup “from time T0 to time T1.” *Id.* at col. 12 ll. 5–11.



Appellants' Br. 14 (annotating '287 patent, Fig. 11). At time T1, the "switch 146" is closed, "thereby shorting the resistive element 144 and supplying increased power to the motor 65." '287 patent col. 12 ll. 11–14. The patent explains that this "limit[s] the sudden jerking start." *Id.* at col. 12 ll. 35–37. "In addition, by starting the soft start mode, the likelihood of the motor overpowering the cartridge lockout mechanism is reduced." *Id.* at col. 12 ll. 37–39. The section finishes by referencing an additional feature of "reducing the power prior to the knife reaching its end-of-stroke (or distal) position [in order to] ease[] reversal of the motor direction." *Id.* at col. 12 ll. 39–41.

II

Intuitive Surgical, Inc. challenged certain claims of the '287 patent based on four obviousness combinations. J.A. 112–113. The obviousness combination accepted by the Board and at issue on appeal is U.S. Patent Application Publication No. 2007/0175956 A1 (Swayze) in view of U.S. Patent No. 4,346,335 (McInnis). We describe each reference below.

Swayze discloses a similar endocutter to the one described in the '287 patent, lacking only the soft start circuit (boxed in red below):

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