

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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IPR2019-01066  
Patent 9,844,369 B2

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Before ZHENYU YANG, FRANCES L. IPPOLITO and  
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

### A. *Background and Summary*

Intuitive Surgical, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 15, 22, and 23 of U.S. Patent No. 9,844,369 B2 (“the ’369 patent”). Paper 2 (“Pet.”). Ethicon LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute *inter partes* review under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Having considered the arguments and the evidence presented, for the reasons described below, we determine that Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail with respect to at least one of the claims challenged by the Petition. Accordingly, we decline to institute an *inter partes* review of all claims and all grounds asserted in the Petition.

### B. *Real Parties in Interest*

Petitioner has identified the real party-in-interest as itself, Intuitive Surgical, Inc. Pet. 1.

### C. *Related Matters*

Petitioner represents that the ’369 patent has been asserted in the following district court case: *Ethicon LLC v. Intuitive Surgical, Inc.*, CA No. 1:18-cv-01325-LPS, D. Del., filed August 27, 2018. *Id.*

### D. *The ’369 Patent*

The ’369 patent, titled “Surgical End Effectors with Firing Element Monitoring Arrangements,” issued on December 19, 2017, from U.S. Patent

Application No. 14/319,004 filed on June 30, 2014. Ex. 1001, (54), (45), (21), (22). The '369 patent claims priority to Provisional Patent Application 61/980,293, which was filed on April 16, 2014. *Id.* at (60).

The '369 patent relates to surgical stapling instruments that produce one or more rows of staples. *Id.* at col. 1, ll. 16–18. More specifically, as shown in Figure 6 below, the '369 patent is directed to an endocutter that is a type of laparoscopic surgical cutter that both staples and cuts tissue. *See id.* at col. 17, l. 51 – col. 18, l. 31.

Figure 6 illustrates the endocutter of the invention in operation and is reproduced below:

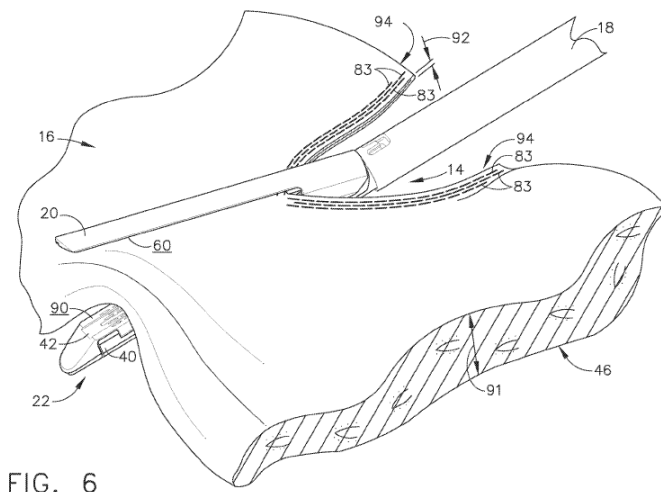


Figure 6 of the '369 patent illustrating an endocutter stapling and transecting tissue. Ex. 1001, Figure 6; col. 2, ll. 6–7.

The endocutter comprises an element referred to as an E-beam, which initiates the cutting and stapling of the tissue. *See id.* at col. 17, ll. 11–50. As described in the '369 patent, the E-beam comprises one or more lower feet, which pass through a lower internal channel of the endocutter. *Id.* at col. 17, ll. 5–10.

Figure 76 illustrates a portion of an endocutter of the invention and is reproduced below.

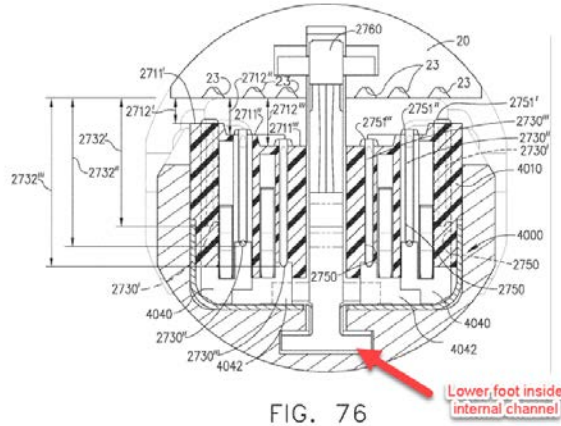


Figure 76 of the '369 Patent showing a cross section of an endocutter of the invention and annotated by the Board. Ex. 1001, Fig. 76 (annotated by panel).

The '369 patent teaches that the lower internal channel is enclosed except for proximal and distal openings, 6040 and 6042, as shown in Figure 32 below. Ex. 1001, col. 73, ll. 1-34.

Figure 32 illustrates the bottom panel of an endocutter of the invention and is reproduced below:

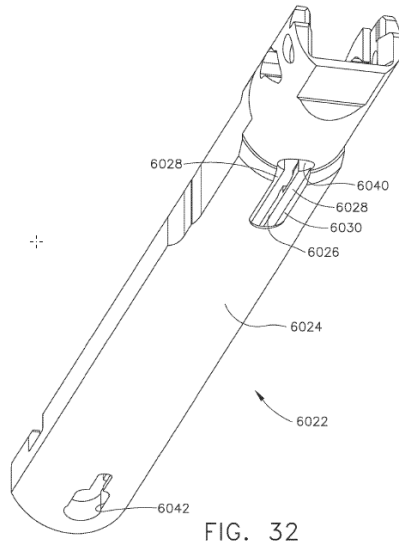


Figure 32 of the '369 patent showing a bottom perspective view of an endocutter with an enclosed internal channel. Ex. 1001, Fig. 32.

Enclosing the lower internal channel of the passageway increases the resistance of the endocutter to twisting and spreading when the endocutter staples thick tissue. Ex. 1001, col. 72, ll. 31–34. The presence of the proximal and distal openings offers the user a view of the E-beam of the firing element when it is in the starting and ending position. *Id.* at col. 73, ll. 1–34. The proximal opening also acts as a lockout for the E-beam or firing element when a staple cartridge is not in place. *Id.* at col. 76, ll. 39–62, Fig. 41.

Figure 42 illustrates a portion of an endocutter of the invention and is reproduced below:

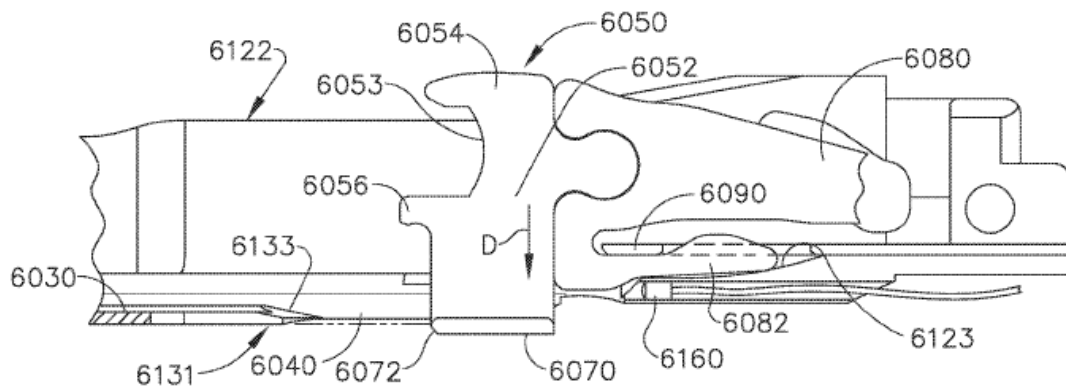


FIG. 41

Figure 41 of the '369 patent showing a partial side view of the endocutter with the foot of the E-beam, 6070, in the lockout position. Ex. 1001, Fig. 41; col. 3, ll. 48–49.

*E. Illustrative Claim*

Claim 22 is representative of the challenged claims and reads as follows:

22. A surgical end effector, comprising:
- an elongate channel including a bottom including a proximal end and a distal end, the elongate channel being configured to operably support a staple cartridge therein;
  - a firing element configured to translate between a first position adjacent the proximal end of the bottom of the elongate channel and an ending position adjacent the distal end of the bottom of the elongate channel, the firing element including a vertical portion and at least one laterally extending lower foot;
  - an internal passage extending within the elongate channel and configured to receive the at least one laterally extending lower foot when the firing element moves between the first position and ending position;
  - a proximal channel opening through the proximal end of the bottom of the elongate channel to facilitate viewing of the firing element therethrough when the firing element is in the

first position, the proximal channel opening sized to receive therein the at least one laterally extending lower foot on the firing element; and

means for guiding the at least one lower foot on the firing element out of the proximal channel opening into the internal passage upon initial application of a firing motion to the firing element.

Ex. 1001, col. 94, ll. 1–25.

*F. Prior Art and Asserted Grounds*

Petitioner asserts that claims 1, 15, 22, and 23 would have been unpatentable on the following grounds:

<b>Claims Challenged</b>	<b>35 U.S.C. §</b>	<b>References</b>
1 and 15	103(a)	Shelton <sup>1</sup> in view of Green <sup>2</sup> and Zemlok <sup>3</sup>
22 and 23	103(a)	Shelton in view of Green
22 and 23	103(a)	Shelton in view of Green and Zemlok

Petitioner also relies on the Declaration of Dr. Knodel.<sup>4</sup> Patent Owner relies on the Declaration of Dr. Fronczak.<sup>5</sup>

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<sup>1</sup> Shelton, IV et al., US 7,380,696 B2, issued June 3, 2008 (“Shelton”). Ex. 1004.

<sup>2</sup> Green, US 4,429,695, issued Feb. 7, 1984 (“Green”). Ex. 1005.

<sup>3</sup> Zemlok et al., US 2011/0036891 A1, published Feb. 17, 2011 (“Zemlok”). Ex. 1006.

<sup>4</sup> Declaration of Dr. Bryan Knodel in Support of Petition for *Inter Partes* review of U.S. Patent No. 9,844,369. Ex. 1003.

<sup>5</sup> Declaration of Dr. Frank Fronczak. Ex. 2002.

## II. ANALYSIS

### A. *Statutory Disclaimer of Claims 1 and 15*

As noted above, along with claims 22 and 23, Petitioner seeks *inter partes* review of claims 1 and 15 of the '369 patent. After the filing of the Petition, Patent Owner filed a statutory disclaimer of claims 1 and 15. Ex. 2001; *see* Prelim. Resp. 8.

Patent Owner contends that “[b]ased on this disclaimer, the [']369 patent is to be treated as though claims 1 and 15 never existed.” Prelim. Resp. 8 (citing *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Circ. 1998) (“This court has interpreted the term ‘considered as part of the original patent’ in section 253 to mean that the patent is treated as though the disclaimed claims never existed.”)). We also observe that our rules state that “[n]o *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. §42.107(e) (2018).

In considering the Federal Circuit precedent and our rules, we conclude that we cannot institute a trial on claims that have been disclaimed, and, thus, no longer exist. That conclusion is consistent with other panel decisions in *inter partes* review proceedings that addressed a near identical circumstance as we do here. *See, e.g., Vestas-American Wind Tech., Inc. and Vestas Wind Sys. A/S v. Gen. Elec. Co.*, IPR2018-01015, Paper 9 at 12–14 (PTAB Nov. 14, 2018) (“the '1015 IPR”). We share the same view as the panel in the '1015 IPR that such a conclusion is consistent with the statutory scope of *inter partes* review as laid out in 35 U.S.C. §§ 311(b) and 318(a), and is not at odds with the Supreme Court’s recent decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018). *See id.* Accordingly, we treat claims 1 and 15 as having never been part of the '369 patent, and Petitioner cannot seek *inter partes* review of those claims.



*B. Level of Ordinary Skill in the Art*

The level of ordinary skill in the art is a factual determination that provides a primary guarantee of objectivity in an obviousness analysis. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991)).

Petitioner contends that a person of ordinary skill in the art at the time the invention was made “would have had the equivalent of a bachelor’s degree or higher in mechanical engineering, or a related field directed towards medical mechanical systems, and at least 3 years working experience in research and development for surgical instruments.” Pet. 15–18 (citing Ex. 1003 ¶ 56). We determine that Petitioner’s description of the level of ordinary skill in the art is supported by the current record. *See* Ex. 1003 ¶¶ 24–26. For purposes of this decision, therefore, we adopt Petitioner’s description of the level of ordinary skill in the art.

We also note that the applied prior art reflects the appropriate level of skill at the time of the claimed invention. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

*C. Claim Construction*

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b).<sup>6</sup> Under this standard, we construe the claim

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<sup>6</sup> The Office has changed the claim construction standard in AIA proceedings to replace the broadest reasonable interpretation standard with the same claim construction standard used in a civil action in federal district courts. Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018). The change applies to petitions filed on or after

“in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.* Furthermore, at this stage in the proceeding, we need only construe the claims to the extent necessary to determine whether to institute *inter partes* review. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy. . . .’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Construing a means-plus-function claim limitation is a two-step process. First, the claim must be analyzed to determine whether the claim language actually invokes the provisions of 35 U.S.C. § 112, sixth paragraph. *See Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1364 (Fed. Cir. 2000) (“If a claim element contains the word ‘means’ and recites a function, th[e] court presumes that element is a means-plus-function element under § 112, ¶ 6. . . . That presumption falls, however, if the claim itself recites sufficient structure to perform the claimed function.”). The second step is to “determine what structures have been disclosed in the specification that correspond to the means for performing that function.” *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1361 (Fed. Cir. 2000).

### 1. *Firing Element*

Petitioner contends that the term “firing element” should be construed as a means-plus-function element as the term “element” is a nonce term and

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November 13, 2018. *Id.* Because the present Petition was filed on March 9, 2019, we construe the claims in accordance with the federal district court standard, now codified at 37 C.F.R. § 42.100(b).

the term “firing” is purely functional. Pet. 11. Petitioner contends that the corresponding structure in the Specification is the E-beam and that the term “firing element” should be limited to the disclosed E-beam. *Id.* at 12–13.

Patent Owner contends that the term “firing element” should not be construed as a mean-plus-function limitation in that the claim recited sufficient structure. Prelim Resp. 19–20. Patent Owner also argues that even if Petitioner’s proposed construction is adopted for purposes of this decision, the construction would not affect the final result. *Id.* at 20.

We have considered the arguments advanced by the parties and agree with Patent Owner that construing the term “firing element” does not impact our decision as to whether to grant or deny the petition. We therefore decline to construe the term.

## 2. *Means for Guiding*

Petitioner contends that the limitation “means for guiding” should be construed as a mean-plus-function limitation. Pet. 13. Petitioner, relying on the Specification and the prosecution history of the ’369 patent, contends that the term “means for guiding” should be construed as referring to chamfers on the foot of the E-beam, or on the channel, or both, in combination with the firing bar. *Id.* at 15.

Patent Owner contends that while the term “means for guiding” is properly construed as a mean-plus-function limitation, Petitioner’s proposed construction improperly includes the presence of the firing bar as the Specification only discloses chamfers as the guiding means. Prelim. Resp. 21. Patent Owner also contends that, for purposes of deciding whether to grant the petition, the Board need not resolve the conflict between the proposed constructions as the Petition fails regardless of which construction is adopted. *Id.*

We have considered the positions of the parties and for purposes of this decision, we adopt Patent Owner's proposed construction. We agree with Patent Owner that the Specification only refers to the use of chamfers to guide the lower foot of the firing element. *See* Ex. 1001, col. 77, ll. 24–39. With respect to the prosecution history, while the Examiner initially concluded that the firing bar was part of the means for guiding, Patent Owner did not agree with this definition and traversed the rejection based on that erroneous definition. *See* Ex. 1002, 789–99.

We also conclude that no other terms need be construed for purposes of this decision.

*D. Ground 1 – Are Claims 22 and 23 Obvious Over Shelton Combined with Green*

Petitioner contends that the subject matter of claims 22 and 23 would have been obvious to one of ordinary skill in the art at the time the invention was made over the teachings of Shelton combined with Green.

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham*, 383 U.S. at 17–18. If the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains, the claim is unpatentable under 35 U.S.C. § 103(a). *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

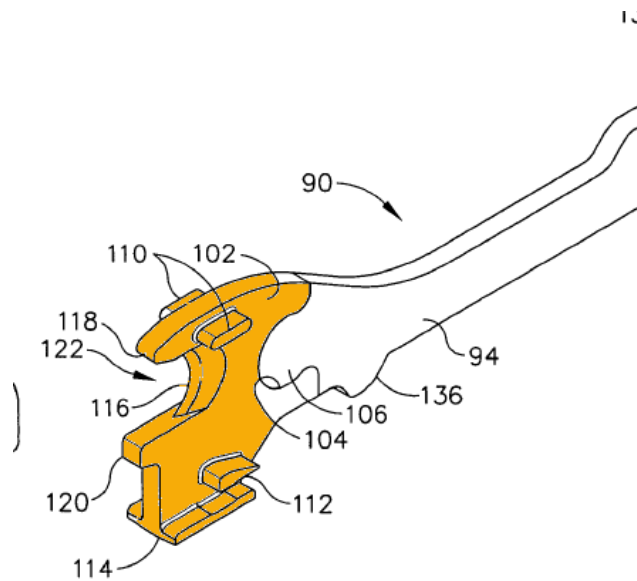
“Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim

under examination.” *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). “Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*

1. *Shelton*

Shelton discloses a surgical instrument that severs and staples tissue and can be used for laparoscopic and endoscopic procedures. Ex. 1004, Abstr. Shelton teaches an E-Beam firing element with a bottom pin or foot (Item 114 in Figure 4 below). *Id.* at col. 6, ll. 36–57.

Figure 4 of Shelton illustrates a firing bar of the disclosed stapler and is reproduced below.



Portion of Figure 4 of Shelton with the firing element highlighted by the Board. Ex. 1004, Fig. 4.

The instrument of Shelton has a lower passageway that accommodates the movement of the lower foot 114 from the proximal end of the instrument to the distal portion. *See* Ex. 1004, col. 6, ll. 59–64. As shown in Figure 8 of Shelton, the lower passageway, 134, is not enclosed.

Figure 8 of Shelton illustrates an endocutter and is reproduced below:

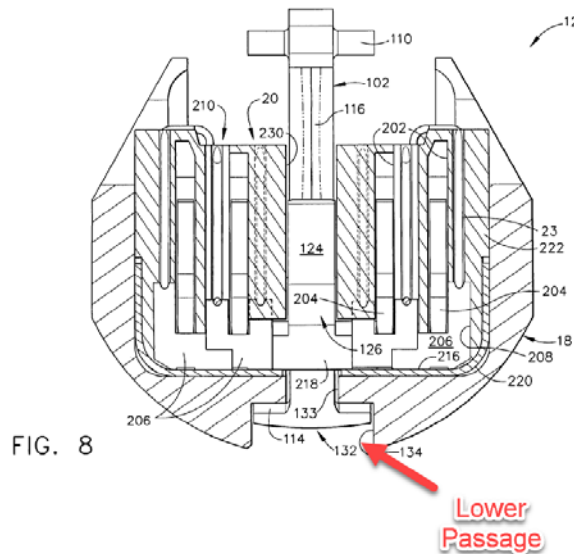


Figure 8 of Shelton showing a cross section of a stapler assembly with annotations by the Board. Ex. 1004, Fig. 8.

## 2. *Green*

Green discloses a surgical stapler having an I-beam firing element. See Ex. 1005, Figure 3; Ex. 1003 ¶¶ 61–63. The I-beam of Green has a lower foot or shoe that rides in an internal passageway. *Id.* at col. 4, ll. 20–60. As shown in figure 6 of Green reproduced below, the lower passageway, 48, is enclosed.

Figure 6 of Green illustrates a portion of an endocutter and is reproduced below:

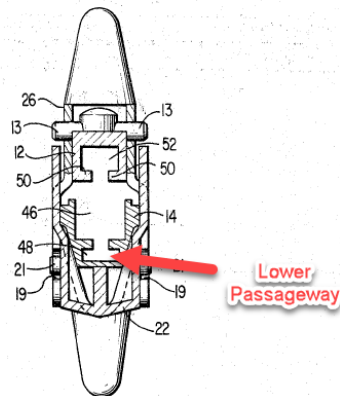


FIG. 6

Figure 6 of Green showing a cross section of the stapler with annotation by the Board. Ex. 1005, Fig. 6.

Green teaches that enclosing the passageway helps to “resist forces tending to both laterally distort the jaws and to open the jaws vertically.” Ex. 1005, col. 6, ll. 35–36.

### 3. Analysis of Claim 22

Petitioner contends Shelton combined with Green teaches all of the elements of claim 22 and that one skilled in the art would have been motivated to combine the teachings of the references with a reasonable expectation of success. See Pet. 24–43.

From the briefing on the parties, the only limitations at issue are the limitation regarding the proximal channel opening and the limitation regarding the means for guiding. See Pet. 35–43; Prelim. Resp. 32–54. As discussed more fully below, we find that Petitioner has not demonstrated

that Shelton and Green, either alone or in combination, discloses a means for guiding. We therefore decline to address the remaining claim limitations.

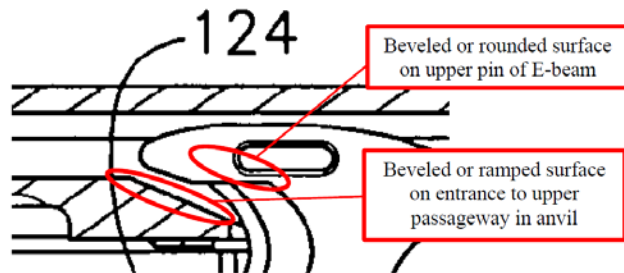
*a) Means for guiding the at least one lower foot on the firing element out of the proximal channel opening into the internal passage upon initial application of a firing motion to the firing element*

Petitioner contends that this limitation is taught by Shelton in that the drawings of Shelton depict a chamfer on the leading edge of the lower foot of the firing element. Pet. 41–42. Alternatively, Petitioner argues that it would have been obvious to one of ordinary skill in the art to add a chamfer to either the lower foot of the firing element of Shelton or the entrance of the internal passage or both to provide smoother operation of the instrument. *Id.* at 42. Petitioner contends that one skilled in the art would have known that the use of chamfers or ramped edges aid in guiding a component into another component. *Id.* at 42–43; Ex. 1003 ¶ 113.

Petitioner contends that the teachings of Shelton support this contention. Pet. 43. Petitioner contends that Figure 11 of Shelton, reproduced below, shows the use of beveled or ramped edges on both the upper pin of the E-Beam and the entrance to the upper passage of the anvil. Pet. 43. Petitioner contends that the teaching of a ramped surface in the upper passage of Shelton shows that one skilled in the art would have known that a similar structure could be used for the lower passage. *See id.* at 42–43.



Figure 11 of Shelton illustrates a portion of an endocutter and is reproduced below:



Shelton, FIG. 11.

Portion of Figure 11 of Shelton as annotated by Petitioner to show the upper passageway of Shelton. Pet. 43.

Patent Owner contends that Shelton does not teach or disclose a chamfer on the face of the lower foot. Prelim. Resp. 41. Patent Owner contends that it is clear from the drawings in Shelton that the lower foot of Shelton has a flat front face, not a chamfer. *Id.* at 42.

Patent Owner also contends that even if Shelton disclosed a chamfer, Shelton does not teach the use of the chamfer to guide the lower foot into the lower passage as required by the challenged claims. *Id.* at 44.

Patent Owner contends that the combined teachings of Shelton and Green do not teach or suggest the means for guiding limitation. *Id.* at 45. Patent Owner contends that Petitioner has not established that the lower foot of the firing element would actually engage the edge of the lower passage necessitating a means for guiding. *Id.* at 46. Patent Owner argues that Shelton teaches that the lower foot would be held by the firing bar and the middle pin such that the foot would not come into contact with the edge of the lower passage. *Id.* at 47. Patent Owner contends that since the lower

foot would be held away from the edge of the lower passage, one skilled in the art would have had no motivation to provide a guiding means. *Id.* at 48–49.

With respect to the chamfer at the opening of the upper passage of Shelton, Patent Owner contends that chamfer in the upper passage is present to address an alignment problem that occurs when the anvil containing the upper passage is closed. *Id.* at 51–53. Patent Owner contends that the alignment problem does not occur with respect to the lower passage thus the chamfers in the upper passage does not perform the same function as a chamfer in the lower passage. *Id.*

We have considered the arguments presented by the parties and conclude that Petitioner has not demonstrated that the limitation calling for a guiding means would have been obvious to one of ordinary skill in the art. As shown in Figure 4 of Shelton reproduced below, the lower foot, 114, of Shelton has a flat face, not a sloped face as suggested by Petitioner. *See* Prelim. Resp. 43.

Figure 4 of Shelton illustrates a portion of an endocutter and is reproduced below:

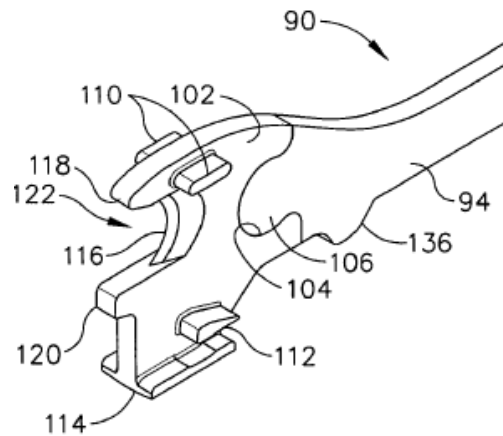


FIG. 4

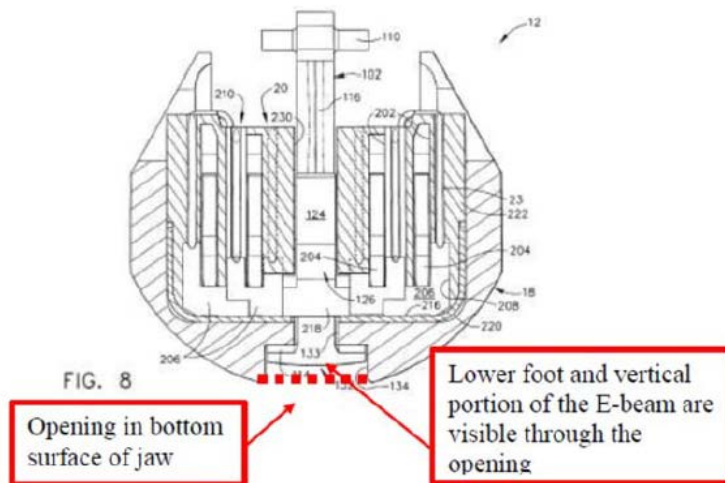
Portion of Figure 4 of Shelton showing the face of the lower foot. Ex. 1004, Fig. 4.

We also agree with Patent Owner that Petitioner has not adequately explained why one skilled in the art would have been motivated to include a guiding means in the device of Shelton or Shelton combined with Green. Petitioner, through its expert, contends that if a cover were present, the lower foot might contact the upper edge of the channel cover affecting the operation of the instrument. Pet. 42; Ex. 1003 ¶ 113. Petitioner contends that this possible interference would motivate one skilled in the art to introduce a chamfer to guide the lower foot over the edge of the cover. *Id.* We are not persuaded by Petitioner's argument.

The lockout mechanism of Shelton is designed to prevent the endocutter from operating when no staple cartridge is present. *See* Ex. 1004, col. 8, ll. 21–27. Thus, based on the teachings of Shelton, only when a staple cartridge is absent does the lower foot of the firing element descend

into the proximal channel opening. As Petitioner's expert has testified that Shelton teaches that, when a staple cartridge is in place, the sled and middle pins cause the lower foot to ride near the top of the lower passage. Prelim. Resp. 46-47; Ex. 1003 ¶ 113.<sup>7</sup> As shown in Figure 3 of Shelton below, this would position the lower foot well above the lower surface of the instrument obviating the need for a guiding element.

Figure 3 of Shelton illustrates a portion of an endocutter and is reproduced below:



Ex. 1003 at ¶ 101

Figure 3 of Shelton as annotated by Dr. Fronczak to show the position of the lower foot. Ex. 2002 ¶ 32.

We conclude that Petitioner has not demonstrated that the combination of Shelton and Green would lead one skilled in the art to add a guiding means to the resulting instrument as required by claim 22.

<sup>7</sup> Patent Owner's expert, Dr. Fronczak agrees with Dr. Knodel's interpretation of Shelton. Ex. 2002 ¶ 32.

Based on the foregoing we conclude that Petitioner has not demonstrated a reasonable likelihood of prevailing over claim 22 based on the combination of Shelton and Green.

4. *Analysis of Claim 23*

Claim 23 depends from claims 22 and adds the limitation that the guiding means comprise at least one ramped surface in the at least one lower foot and a portion of the elongate channel defining the proximal channel opening. Ex. 1001, col. 94, ll. 26–30.

Petitioner contends that this limitation is met by the teachings of Shelton and Green. Petitioner contends that one skilled in the art would have added chamfer to both the lower foot and the edge of the proximal channel opening to ensure smooth operation of the instrument. Pet. 44.

Patent Owner does not present separate arguments as to why Petitioner's contention with respect to claim 23 are incorrect, but appears to rely on the same arguments made for claim 22. *See* Prelim. Resp. 32–53.

For the reasons stated above, we conclude that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing the claim 23 is unpatentable. Petitioner has not shown why one skilled in the art would have added a guiding means to assist guiding the lower foot into the lower passage.

*F. Ground 2 – Are Claims 22 and 23 Obvious Over Shelton Combined with Green and Zemlok*

In ground 2, Petitioner challenges claims 22 and 23 as obvious over the combination of Shelton, Green and Zemlok.

1. *Zemlok*

Zemlok is directed to a surgical stapler having a visual indicator to provide the user information as to the location of a moveable part such as the

firing element. Ex. 1006 ¶¶ 10–14. As shown in Figure 6 below, in one embodiment, the visual indicators comprise, in part, a series of openings in the bottom of the device. *Id.* ¶¶ 27, 31.

Figure 6 of Zemlok illustrates a portion of an endocutter and is reproduced below:

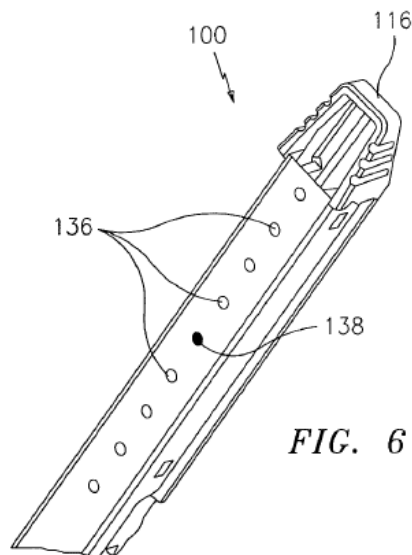


Figure 6 of Zemlok showing a series of openings for viewing the visual indicator. Ex. 1006, Fig. 6.

## 2. Analysis of Claims 22 and 23

Petitioner reiterates its arguments above for all the claims except for the limitation relating to the presence of a proximal channel opening. Pet. 47, 52–53.

We have considered the arguments of the parties and the evidence of record and conclude the Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing claims 22 and 23 are unpatentable over the combination of Shelton, Green and Zemlok. As discussed above, the combination of Shelton and Green would not lead one skilled in the art to incorporate chamfers onto the lower foot of the firing element or the edge of the lower passage or both. Petitioner has not pointed to any teaching in Zemlok that would cure these deficiencies in the other references. See Pet. 53.

### III. CONCLUSION

For the reasons discussed above, we do not institute *inter partes* review of claims 22 and 23 of the '369 patent.

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, the Petition is denied as to the challenged claims of the '369 patent; and

FURTHER ORDERED that no *inter partes* review is instituted.



IPR2019-01066  
Patent 9,844,369 B2

PETITIONER:

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