

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2020-00051
Patent 9,844,379 B2

Before JOSIAH C. COCKS, FRANCES L. IPPOLITO, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Intuitive Surgical, Inc. (“Petitioner”), filed a Petition (Paper 3, “Pet.”) to institute an *inter partes* review of claims 1–3 of U.S. Patent No. 9,844,379 B2 (“Ex. 1001, “the ’379 patent”). *See* 35 U.S.C. § 311. Ethicon LLC, (“Patent Owner”) did not file a preliminary response. We have authority 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 . . . and any response . . . 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.” Moreover, a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

Upon consideration of the Petition, we conclude that the information presented shows that there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim. Accordingly, we institute an *inter partes* review of claims 1–3 of the ’379 patent.¹

¹ As authorized by the panel (Paper 9), Patent Owner filed a “Motion Requesting Leave to Petition the Director for a Certificate of Correction.” Paper 10. We granted the Motion (Paper 13) and Patent Owner subsequently filed a “Request for Certificate of Correction” (Ex. 2002) addressed to the Commissioner for Patents. Petitioner also has challenged claims 1–3 of the ’379 patent in a concurrent proceeding, IPR2020-00050. In instituting *inter partes* review in that proceeding, we determined that the Director’s decision whether to permit a certificate of correction may have an

B. Related Matters

The parties identify *Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, C.A. No. 1:18-cv-01325-LPS (D. Del.) as a proceeding in which Patent Owner moved to amend its complaint to assert the '379 patent against Petitioner. Paper 6, 2; *see* Pet. 2. Patent Owner explains that “[o]n July 17, 2019, Patent Owner’s motion was denied without prejudice in light of the parties’ joint stipulation to stay that litigation.” Paper 6, 2. The parties also refer to a United States International Trade Commission proceeding alleging infringement of the '379 patent by Petitioner. Pet. 2; Paper 6, 2 (identifying *Certain Reload Cartridges for Laparoscopic Surgical Staplers*, Inv. No. 337-TA-1167). Petitioner further identifies several other *inter partes* review (“IPR”) proceedings involving other U.S. patents that Patent Owner has asserted against Petitioner in district court. Pet. 2–3. Patent Owner additionally references numerous other U.S. patents and patent applications that it contends “claim priority to U.S. Patent Application No. 15/064,075, which issued as the '379 patent.” Paper 6, 3–7.

Lastly, as noted above, the '379 patent is also the subject of IPR2020-00050 that was filed concurrently with this IPR.

C. Real Parties in Interest

Petitioner identifies itself as the only real party-in-interest. Pet. 1–2.

impact on the status of a certain reference as prior art. Here, however, we do not discern that the Director’s decision will have any similar impact.

D. The '379 Patent

The '379 patent is titled “Surgical Stapling Instrument Having Clearanced Opening,” and relates to “surgical instruments that are suitable for endoscopically inserting an end effector that is actuated by a longitudinally driven firing member.” Ex. 1001, code [54]; 1:51–54. The Abstract of the '379 patent sets forth the following:

A stapling assembly comprising a first jaw and a second jaw, wherein the first jaw is rotatable relative to the second jaw. The stapling assembly comprises a detachable cartridge portion comprising a plurality of staples and an anvil configured to deform the staples. The stapling assembly comprises a staple firing member comprising a first cam configured to engage the first jaw and a second cam configured to engage the second jaw when the staple firing member is advanced from an initial position, and wherein the first jaw comprises a clearanced opening configured to receive the first cam when the staple firing member is in the initial position such that the first cam is not engaged with the first jaw when the staple firing member is in the initial position.

Id. at code [57].

Figure 1 of the '379 patent is reproduced below.

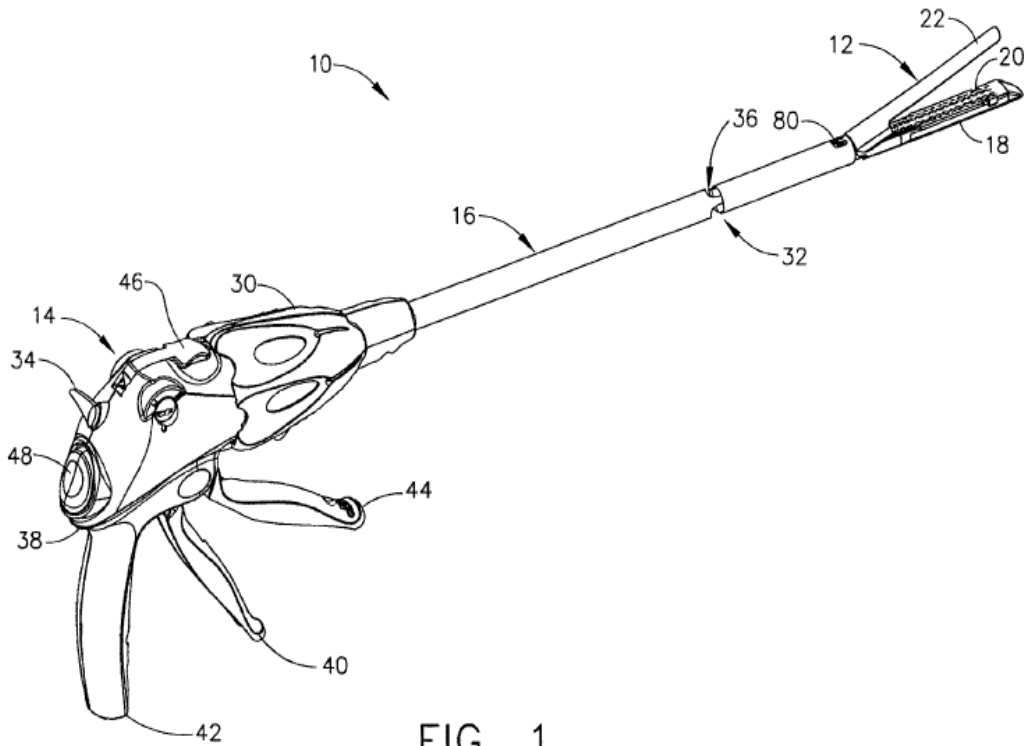


Figure 1 above shows “a perspective view of an endoscopic surgical stapling instrument for surgical stapling and severing in an open, unarticulated state.” *Id.* at 3:44–46. Surgical stapling instrument 10 includes handle 14 and staple applying assembly 12 spaced from the handle by elongate shaft 16. *Id.* at 4:58–61.

Figure 2 of the '379 patent is reproduced below.

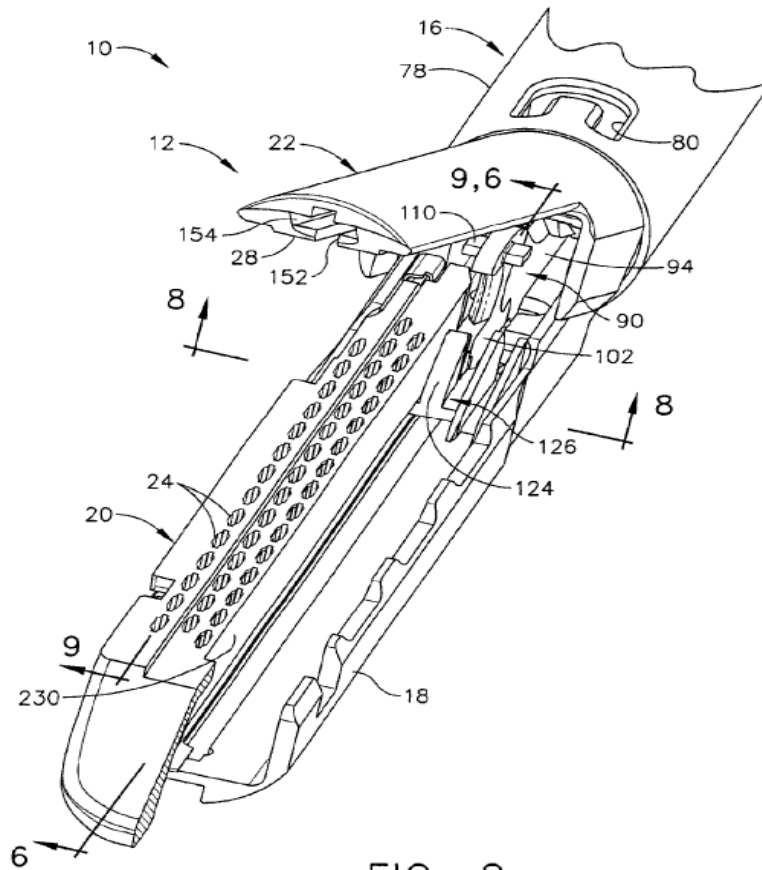


FIG. 2

Figure 2 above “is a left front perspective view of an open staple applying assembly of the surgical stapling instrument of FIG. 1 with a right half portion of a replaceable staple cartridge included in a staple channel.” *Id.* at 3:47–50. Staple receiving assembly 12 includes staple channel 18 for receiving staple cartridge 20. *Id.* at 4:61–63. “Pivotally attached to the staple channel 18 is an anvil 22 that clamps tissue to the staple cartridge 20 and serves to deform staples 23 [not shown in Figure 2] driven up from staple holes 24 in the staple cartridge 20 against staple forming recesses [not shown in Figure 2] in an anvil undersurface 28 into a closed shape.” *Id.* at 4:63–5:1. “An E-beam 102 is the distal portion of the two-piece knife and firing bar 90, which facilitates separate closure and firing as well as spacing

of the anvil 22 from the elongate staple channel 18 during firing.” *Id.* at 6:28–31.

Figure 6 of the '379 patent is reproduced below.

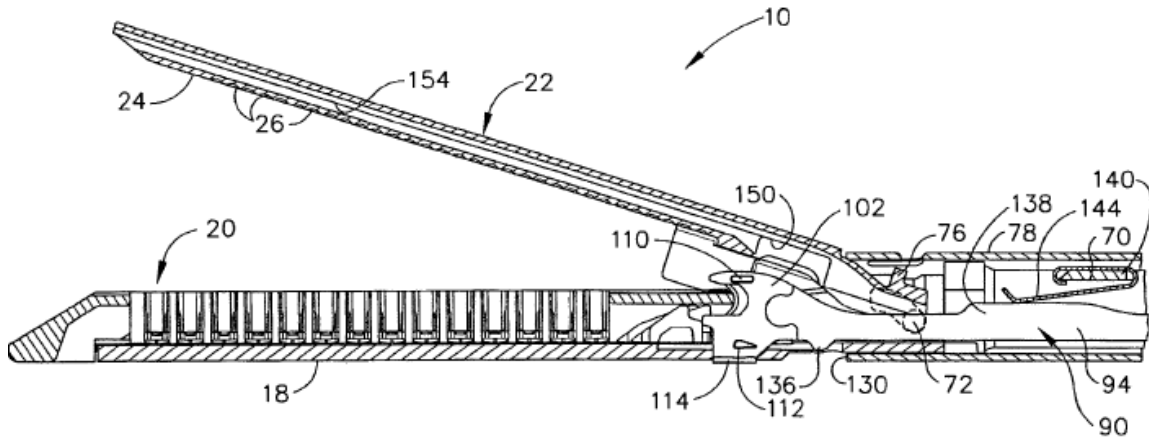


FIG. 6

Figure 6 above “is a left side view taken in longitudinal cross section along a centerline 6-6 of the staple applying assembly of FIG. 2.” *Id.* at 3:60–63. In Figure 6, surgical stapling instrument is shown in an open state with E-Beam 102 fully retracted. *Id.* at 6:61–62. “E-beam 102 is retracted with the top pins 110 thereof residing with an anvil pocket 150 near the pivoting proximal end of the anvil 22.” *Id.* at 7:29–31.

Figure 8 of the '379 patent is reproduced below.

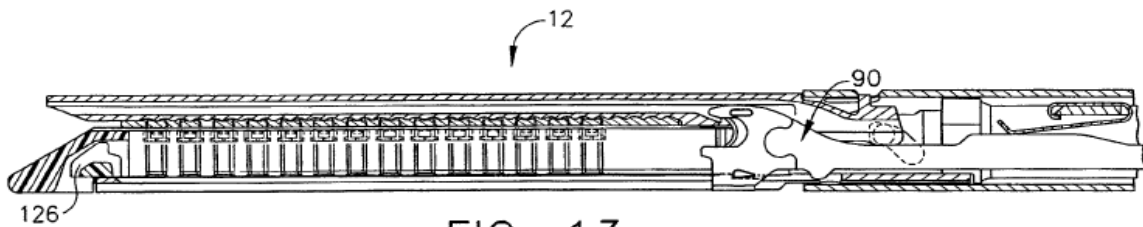


FIG. 13

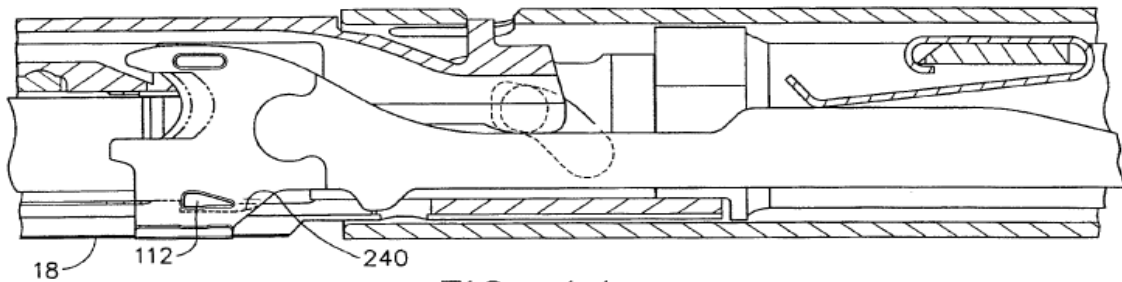


FIG. 14

Figure 13 above is a left view cross-sectional view in elevation of a closed staple applying assembly “after firing of the staple cartridge and retraction of the two-piece knife.” *Id.* at 4:22–23. Figure 14 above is “a left side cross-sectional detail view in elevation of the staple applying assembly of FIG. 13 with the two-piece knife allowed to drop into a lockout position.” *Id.* at 4:25–27. After firing, firing bar 90 is retracted leaving wedge sled 126 in a distal position. *Id.* at 8:18–19. Furthermore,

In FIG. 14, the middle pin 112 is allowed to translate down into a lockout recess 240 formed in the staple channel 18 . . . Thus, the operator would receive a tactile indication as the middle pin 112 encounters the distal edge of the lockout recess 240 when the wedge sled 126 (not shown in FIG. 14) is not proximally positioned (i.e., missing staple cartridge 20 or spend staple cartridge 20).

Id. at 8:20–26.

E. Illustrative Claim

Each of claims 1–3 is independent. Claim 1 is illustrative and is reproduced below.

1. A stapling assembly, comprising:
 - a frame;
 - a distal end;
 - a first jaw comprising a channel;
 - a channel retainer, wherein said channel is slidably attachable to said channel retainer;
 - a second jaw extending from said frame; a plurality of staples;
 - a staple firing member comprising a first cam configured to engage said first jaw and a second cam configured to engage said second jaw when said staple firing member is advanced from an unadvanced position toward said distal end, wherein one of said first jaw and said second jaw comprises a clearanced opening configured to permit said firing member to be unengaged with one of said first jaw and said second jaw when said firing member is in said unadvanced position; and
 - a lockout configured to block the advancement of said staple firing member when said channel is not attached to said channel retainer.

Ex. 1001, 8:60–9:11.

F. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–3 of the '379 patent are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–3	102	Shelton '818 ^{2, 3}

² Shelton '818, US 7,000,818 B2 issued Feb. 21, 2006 (Ex. 1014).

³ Petitioner contends that Shelton '818 incorporates by reference the entirety of another document that Petitioner identifies as “U.S. Patent Application Publication No. 2004/0232195 (‘Shelton '195,’ [Ex. 1013]).” Pet. 19 (citing

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–3	103	Green, ⁴ Solyntjes ⁵

II. ANALYSIS

A. Claim Construction

The claim construction standard to be employed in an *inter partes* review has changed. *See* 37 C.F.R. § 42.100(b) (2019). The new standard applies to proceedings in which the petition was filed on or after November 13, 2018. *Id.* Because the Petition in this case was filed after November 13, 2018, we apply the claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). *See* 83 Fed. Reg. 51,343.

Ex. 1014, 1:8–26, 9:35–38). Shelton ’818 does not, itself, reference the particular application publication number that Petitioner terms “Shelton ’195,” and instead identifies four applications by their titles and inventors that are incorporated by reference. Ex. 1014, 1:13–26. Petitioner relies on the Declaration testimony of Dr. Bryan Knodel (Ex. 1003) in asserting that Shelton ’195 constitutes subject matter of one of those four applications that has been incorporated by reference in Shelton ’818. Pet. 19 (citing Ex. 1003 ¶ 57, n.2). On the record before us, we discern no reason to doubt Petitioner’s and Dr. Knodel’s contention that one of the patent applications identified expressly in Shelton ’818 is Shelton ’195 and is incorporated by reference in its entirety as a part of Shelton ’818’s disclosure. Petitioner relies on content of Shelton ’195 as a part of its proposed ground of anticipation based on Shelton ’818.

⁴ Green, US 4,429,695 issued Feb. 7, 1984 (Ex. 1015).

⁵ Solyntjes, US 5,413,267 issued May 9, 1995 (Ex. 1011).

Petitioner contends that all claim terms should be given their plain and ordinary meaning. At this time, we agree. We also find that it is unnecessary to provide an explicit construction of any additional claim term in order to resolve the issues in dispute at this stage of the proceeding. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (explaining that claim terms need to be construed “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))).

B. Ground of Anticipation Based on Shelton '818

1. Overview of Shelton '818

Shelton '818 is titled “Surgical Stapling Instrument Having Separate Distinct Closing and Firing Systems,” and relates to “surgical stapler instruments that are capable of applying lines of staples to tissue while cutting the tissue between those staple lines[.]” Ex. 1014, code [54]; *id.* at 1:28–30.

Figures 1 and 2 of Shelton '818 are reproduced below.

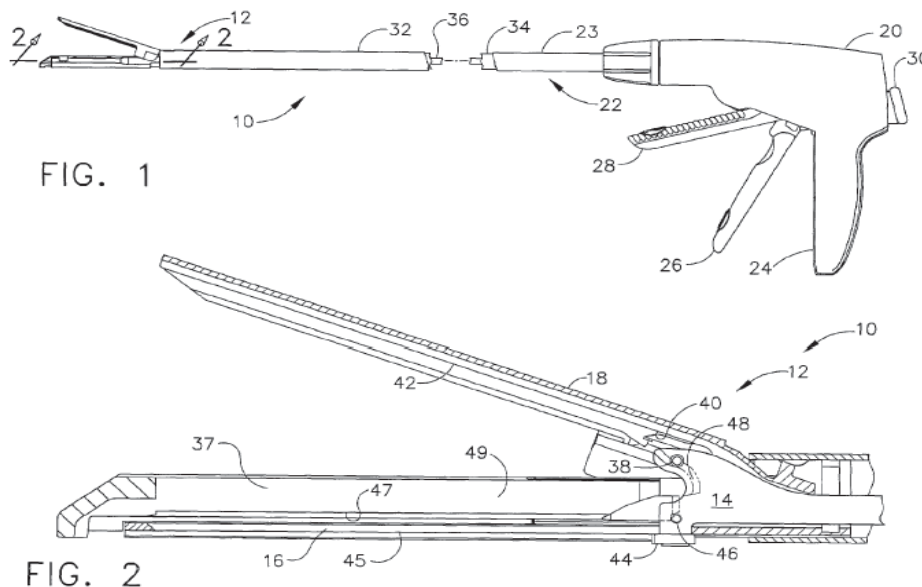


Figure 1 above “depicts a partially cut-away side elevation view of a surgical stapling and severing instrument in an open position.” *Id.* at 2:62–64. Figure 2 above “depicts a cross-sectional side elevation detail view along the line 2—2 of FIG. 1 of an end effector of the surgical stapling and severing instrument.” *Id.* at 2:65–67. Stapling and severing instrument 10 includes end effector 12 and handle portion 20. *Id.* at 4:22–36. End effector 12 includes “E-beam firing mechanism (‘firing bar’) 14 that advantageously controls the spacing of the end effector 12. In particular, an elongate channel 16 and a pivotally translatable anvil 18 are maintained at a spacing that assures effective stapling and severing.” *Id.* at 4:26–28. “[E]longate channel 16 receives a staple cartridge 37.” *Id.* at 5:2–3. “[F]iring bar 14 advantageously includes a middle pin 46 that passes through a firing drive slot 47 formed in a lower surface of the cartridge 37 and an upward surface of the elongate channel 16, thereby driving the staples. . . .” *Id.* at 5:24–27.

Figure 12 of Shelton’ 818 is reproduced below.

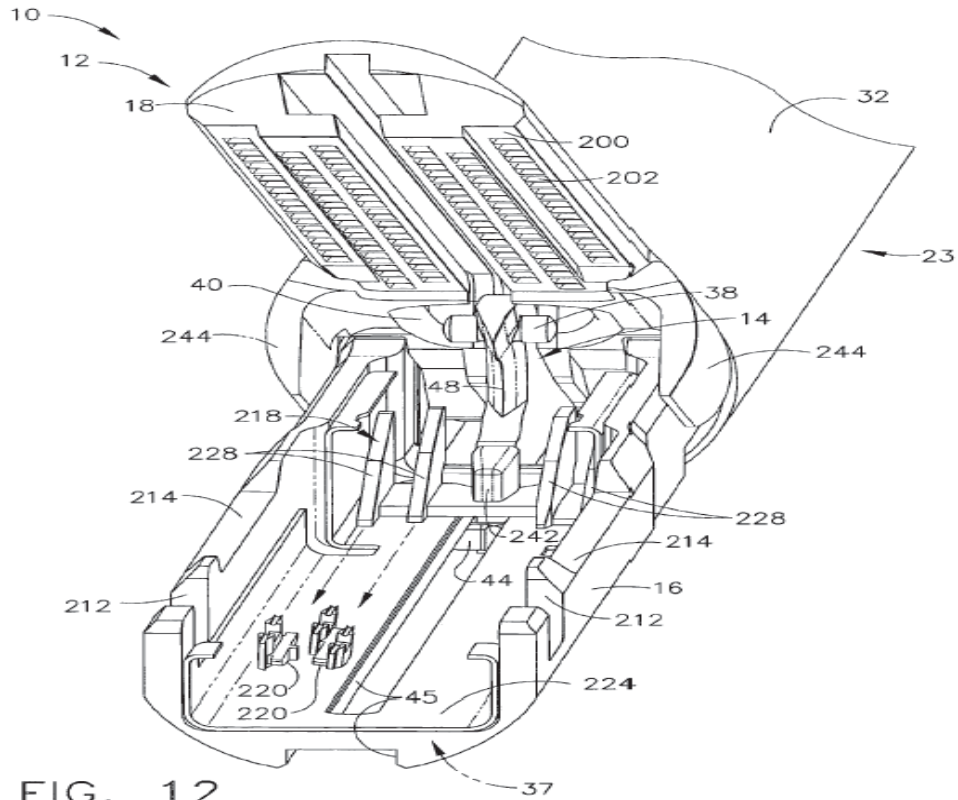


FIG. 12

Figure 12 above “depicts an isometric view of the end effector at the distal end of the surgical stapling and severing instrument” of Figure 1. *Id.* at 3:34–35. Staple cartridge 37 includes wedge sled 218 that moves distally to force staples 222 (not shown in Figure 12) resting on drivers 220 upwardly into contact with anvil forming pockets 202 on anvil 18 to form closed staples. *Id.* at 9:54–10:1.

Figure 16 of Shelton '818 is reproduced below.

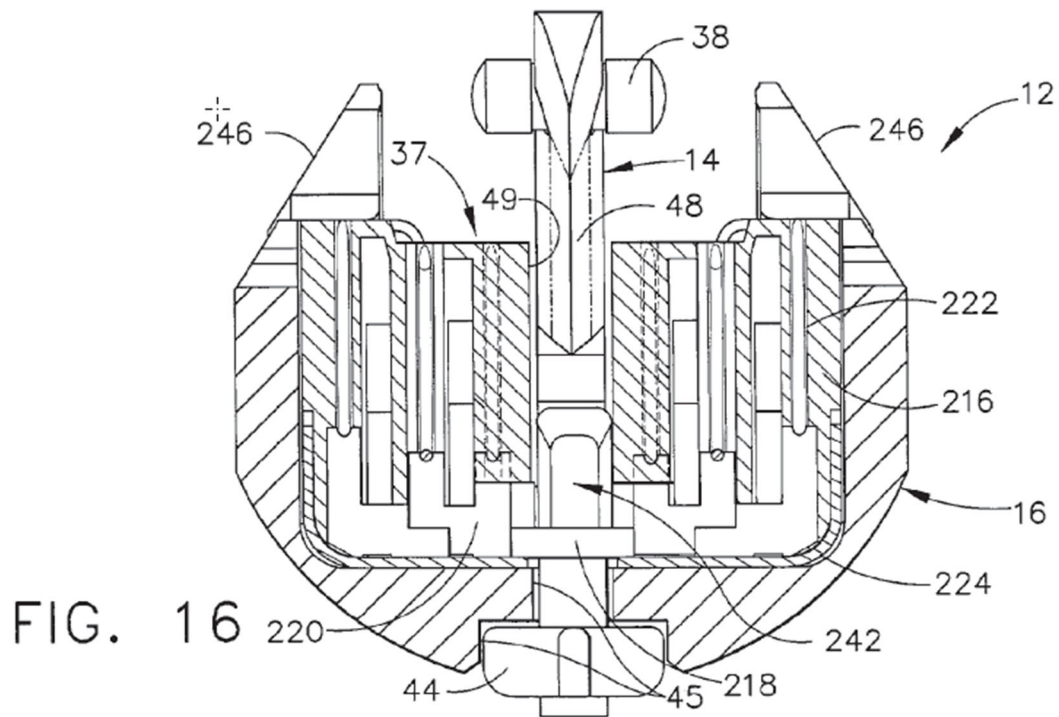


FIG. 16 above shows “the cross-sectional relationship between the firing bar, elongate channel, wedge sled, staple driver, staples and staple cartridge.” *Id.* at 3:57–59.

Figure 30 of Shelton '195 is reproduced below.

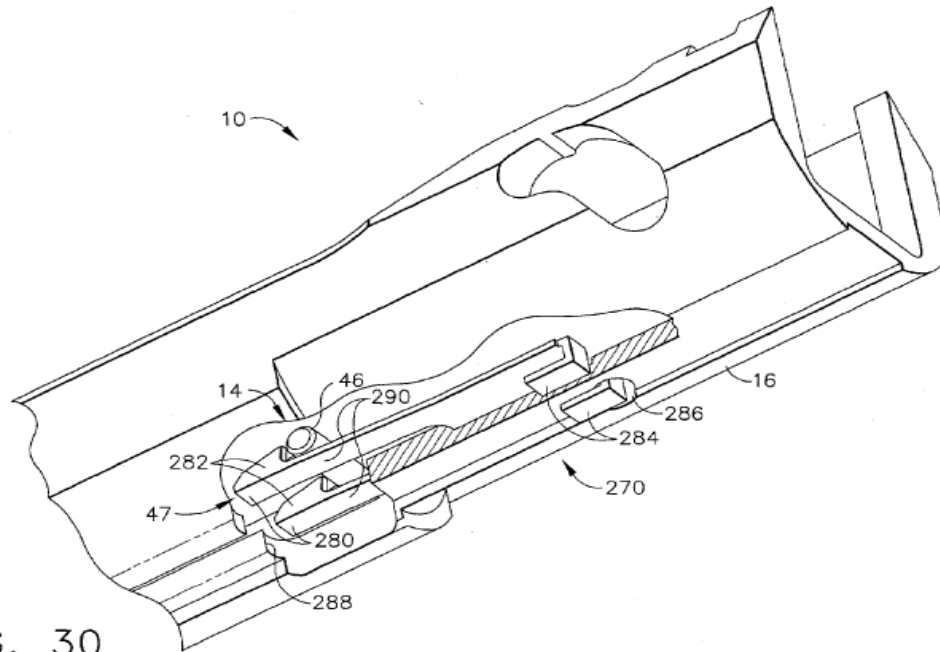
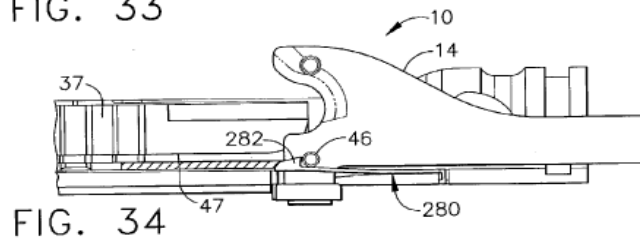
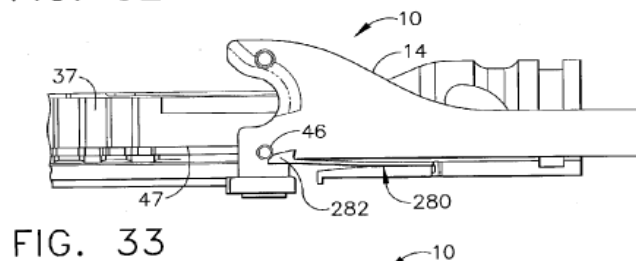
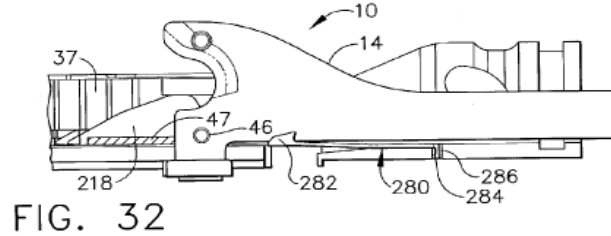
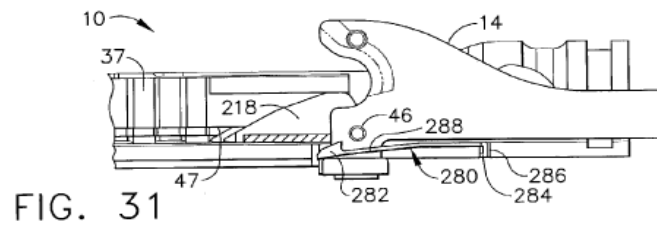


Figure 30 above shows a boom perspective view of an elongate channel of surgical stapling and severing instrument 10. Ex. 1013 ¶ 43. “[S]ingle lockout mechanism 270, depicted as a pair of lockout hooks 280 having ramped ends 282 distally placed with regard to attachment devices 284 inserted through apertures 286 in the elongate channel 16.” *Id.* at ¶ 102.

Figures 31–34 of Shelton ’195 are reproduced below.



Figures 31–34 above “depict a cross-sectional side detail view of the single lockout mechanism of FIG. 30, sequentially shown in a cartridge [37] loaded and unfired state in FIG. 31, a cartridge being fired state in FIG. 32, a spent cartridge with firing bar [14] being retracted state in FIG. 33, and a spent cartridge with firing bar retracted state in FIG. 34.” *Id.* at ¶ 44; *see id.* at ¶¶ 103–104.

2. Discussion

Anticipation under 35 U.S.C. § 102 is established when a single prior art reference discloses all elements of a claim and which are arranged as recited in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d

1376, 1383 (Fed. Cir. 2001). Petitioner further provides a detailed assessment of where every feature of claims 1–3 of the ’379 patent are found in Shelton ’818 either expressly or via incorporation by reference of disclosure in Shelton ’195 and arranged as required by those claims. Pet. 29–59. Petitioner draws additional support for that assessment through recourse to the Declaration testimony of Dr. Knodel (Ex. 1003). On this record, we conclude that Petitioner has accounted adequately for all the features of claims 1–3 of the ’379 patent based on Shelton ’818’s disclosure. Accordingly, we determine that Petitioner has shown a reasonable likelihood of success in showing the unpatentability of those claims. We, therefore, conclude that it is appropriate to institute trial based on the Shelton ’818 ground of unpatentability.

C. Ground of Unpatentability Based on Green and Solyntjes

Petitioner alternatively contends that claims 1–3 of the ’379 patent are unpatentable over Green and Solyntjes. We also institute trial based on the Green and Solyntjes ground.⁶

⁶ We institute trial on all grounds and all claims. *See AC Techs v. Amazon.com, Inc.*, 912 F.3d 1358, 1364 (Fed. Cir. 2019) (“[I]f the Board institutes an IPR, it must similarly address all grounds of unpatentability raised by the petitioner.”); *see also Guidance on the impact of SAS on AIA trial proceedings* (April 26, 2018) <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (“As required by the [*SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018)] decision, the PTAB will institute as to all claims or none. At this time, if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.”).

III. CONCLUSION

In accordance with the Federal Circuit precedent and Office guidance, we institute an *inter partes* review of all challenged claims of the '379 patent on all grounds alleged by Petitioner. Nevertheless, this Decision does not reflect a final determination on the patentability of any claim. We further note that the burden remains on Petitioner to prove unpatentability of each challenged claim. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

IV. ORDER

It is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–3 of the '379 patent is instituted with respect to all grounds of unpatentability presented in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of a trial, which commences on the entry date of this Decision.

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