

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2020-00050
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).

Patent Owner filed a “Motion Requesting Leave to Petition the Director for a Certificate of Correction.” Paper 10.¹ We granted the Motion. Paper 13.² In doing so, we instructed the parties to proceed on the premise that Patent Owner’s petition in pursuit of a certificate of correction will be successful. *See* Paper 13, 6. We are cognizant, however, that there is uncertainty in that respect. We also discern that, on this record, there is also potential uncertainty as to the full extent of the effect the requested certificate of correction would have on this IPR proceeding. Although mindful of such uncertainties, we conclude that the record presently before

¹ The Motion previously was authorized by the panel. Paper 9.

² Patent Owner subsequently filed a “Request for Certificate of Correction,” which is currently pending. *See* Ex. 2002.

us shows Petitioner has met the threshold of demonstrating a reasonable likelihood that it would prevail in its assertion of the unpatentability of at least one challenged claim. Accordingly, we institute an *inter partes* review of claims 1–3 of the '379 patent.

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 reference numerous other U.S. patents and patent applications that it contends “claim priority to one of more of the same applications(s) to which the '379 patent claims priority.” Paper 6, 3–7.

Lastly, we observe that the '379 patent is also the subject of IPR2020-00051 that was filed concurrently with this IPR.

C. Real Parties in Interest

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

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.

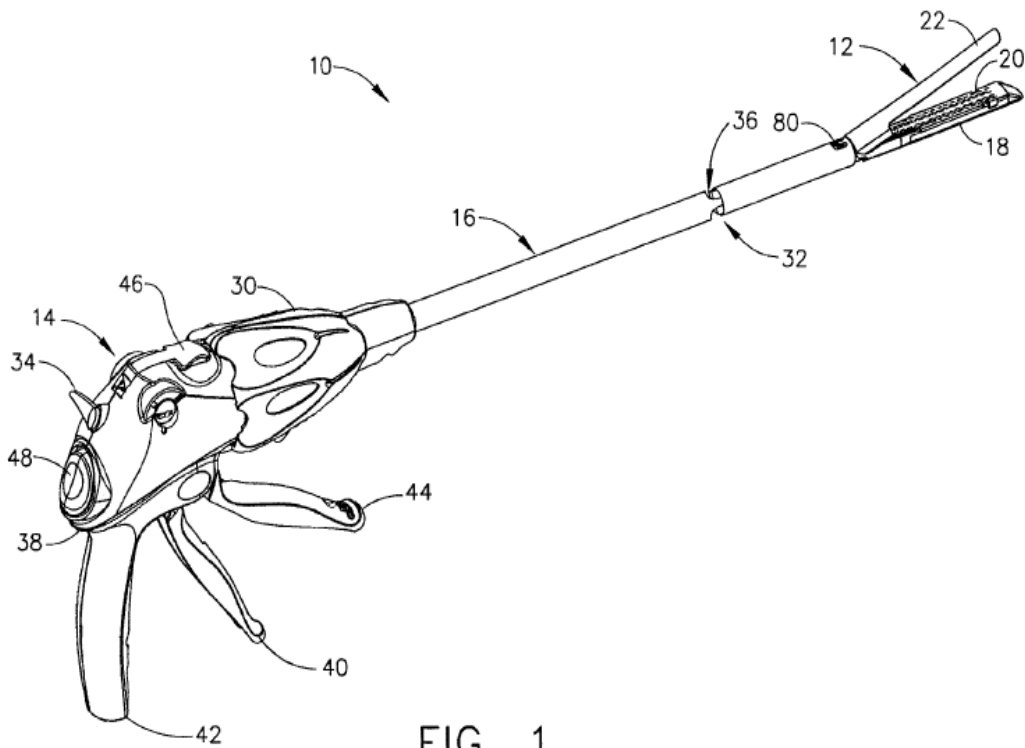


Figure 1 above shows “a perspective view of an endoscopic surgical stapling instrument for surgical stapling and severing in an open, unarticulated state.” *Id.* at 3:44–46. Surgical stapling instrument 10 includes handle 14 and staple applying assembly 12 spaced from the handle by elongate shaft 16.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

Figure 2 of the '379 patent is reproduced below.

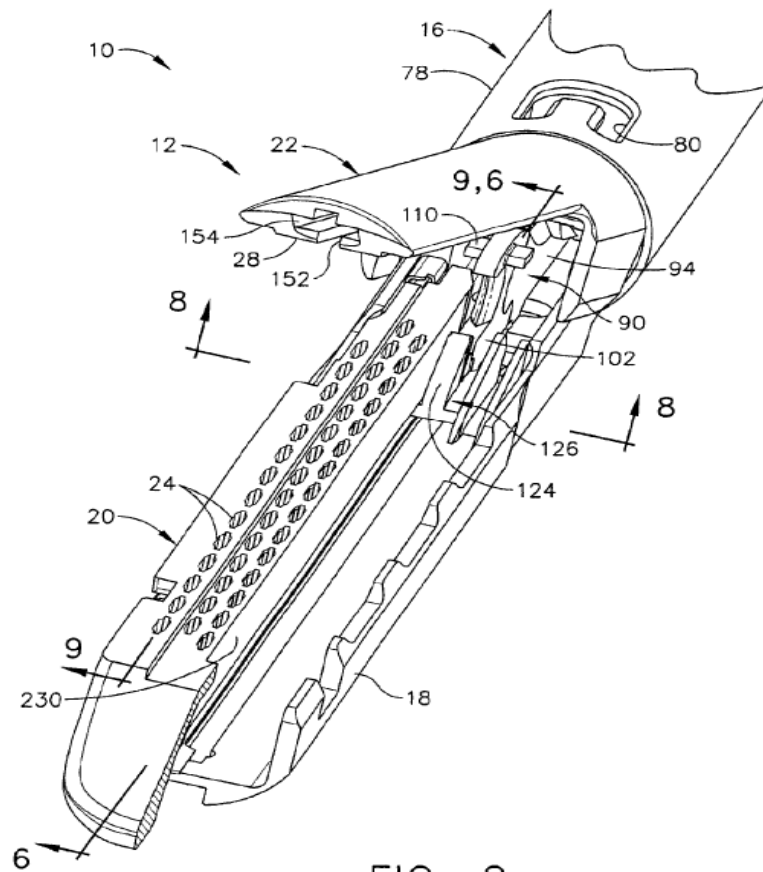


FIG. 2

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.

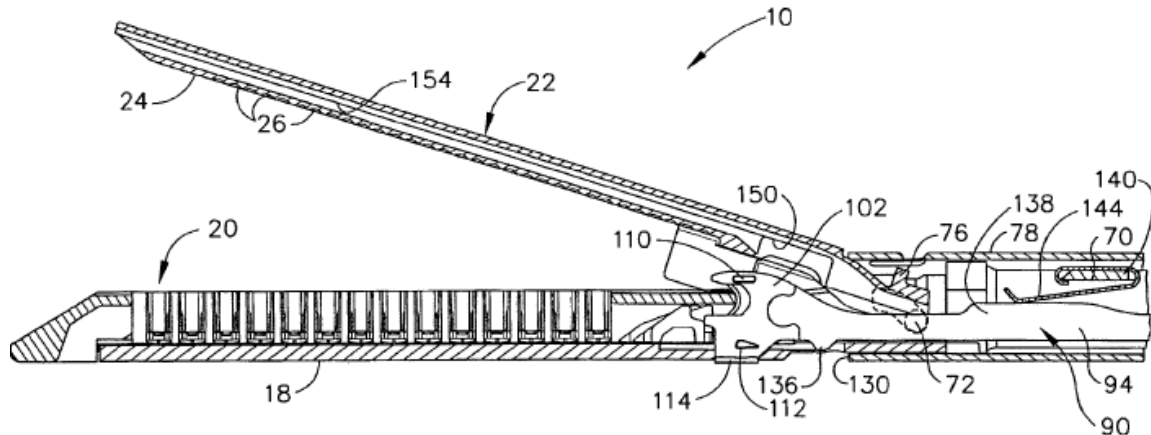


FIG. 6

Figure 6 above “is a left side view [] taken in longitudinal cross section along a centerline line 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.

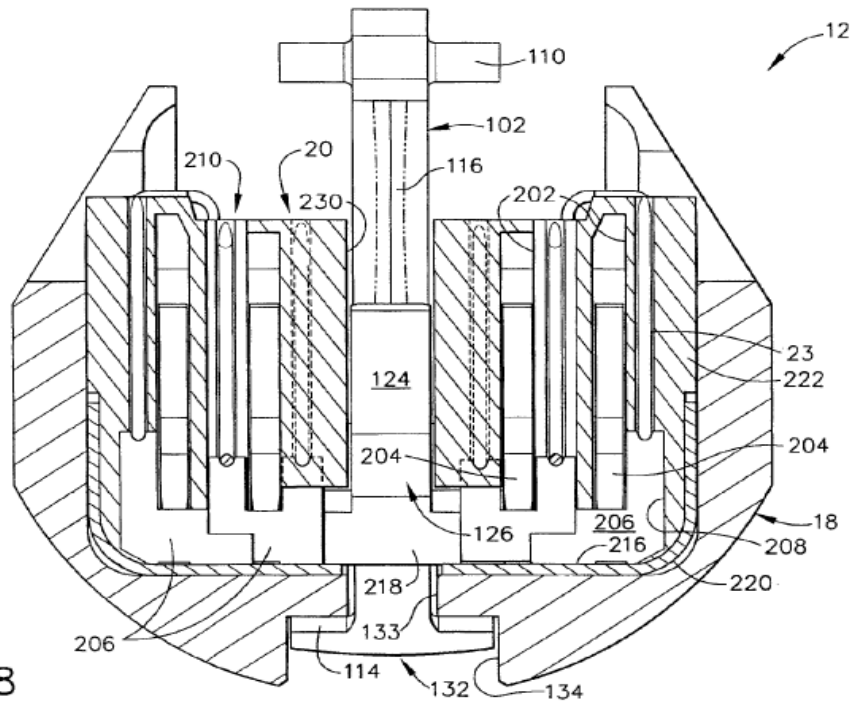


FIG. 8

Figure 8 above “is a front view in elevation taken in cross section along line 8-8 of the staple applying assembly of FIG. 2 depicting internal staple drivers of the staple cartridge and portions of the two-piece knife and firing bar.” *Id.* at 4:1–4. “Longitudinally aligned and parallel plurality of downwardly open wedge slots 202 (FIG. 8) receive respective wedges 204 integral to the wedge sled 126.” *Id.* at 7:44–47.

Figures 13 and 14 of the '379 patent are reproduced below.

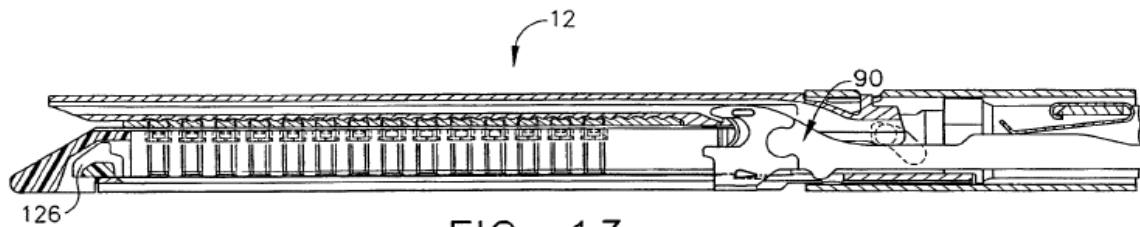


FIG. 13

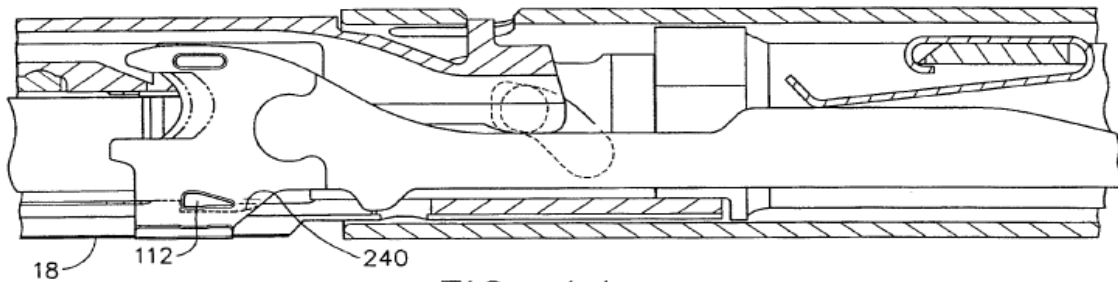


FIG. 14

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 Ground of Unpatentability

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

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–3	102	Shelton '562 ³

³ Shelton '562, US 2005/0263562 A1 published Dec. 1, 2005 (Ex. 1004).

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.

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 ’562

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). Here, Petitioner contends that “the written description of Shelton ’562 is word for word identical to the written description of the ’379 patent (with the exception of non-substantive

descriptions such as referencing co-pending applications by their application numbers rather than their patent number, and difference titled, abstract, and priority claims).” Pet. 26. Petitioner also contends that “Patent Owner cannot dispute that Shelton ’562 anticipates the challenged claims.” *Id.* Petitioner further provides a detailed assessment of where every feature of claims 1–3 of the ’379 patent are found in Shelton ’562 and arranged as required by those claims. Pet. 26–53. Petitioner draws additional support for that assessment through recourse to the Declaration testimony of Dr. Bryan Knodel (Ex. 1003). On this record, we discern no reason to conclude that Petitioner has not accounted for all the features of claims 1–3 of the ’379 patent based on Shelton ’562’s disclosure. Accordingly, if Shelton ’562 is prior art to claims 1–3 of the ’379 patent, Petitioner has shown a reasonable likelihood of success in its contention that at least one challenged claim is unpatentable.

Once again, however, we express that the decision of the Director whether to permit a certificate of correction in connection with the ’379 patent may very well have an impact on the prior art status of Shelton ’562 as applied to claims of the ’379 patent. In any Patent Owner response that follows our Decision here, Patent Owner should provide its views on the impact in this proceeding of any resulting certificate of correction. Likewise, in any reply to that response, Petitioner should also provide its views on the matter.

C. Conclusion

We have considered carefully the record presently before us and conclude that institution of *inter partes* review is warranted. Accordingly,

we do so. 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).

III. 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; 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.

IPR2020-00050
Patent 9,844,379 B2

PETITIONER:

John Phillips
Steven Katz
Ryan O'Connor
Jennifer Huang
FISH & RICHARDSON P.C.
phillips@fr.com
katz@fr.com
oconnor@fr.com
jjh@fr.com

PATENT OWNER:

Anish Desai
Elizabeth Weiswasser
Adrian Percer
Christopher Marando
Christopher Pepe
Audra Sawyer
Robert Magee
Ian Moore
Brian Ferguson
WEIL, GOTSHAL, & MANGES LLP
anish.desai@weil.com
elizabeth.weiswasser@weil.com
adrian.percer@weil.com
christopher.marando@weil.com
christopher.pepe@weil.com
audra.sawyer@weil.com
robert.magee@weil.com
ian.moore@weil.com
brian.ferguson@weil.com