UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2018-01247
Patent 8,479,969

DECLARATION OF ROGER A. DENNING IN SUPPORT OF PETITIONER'S UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION

I, Roger A. Denning, hereby declare the following:

1. I am a Principal with the law firm of Fish & Richardson P.C.

2. I have been a member in good standing of the Bar of the State of California since 2003 and a member in good standing of the Bar of the State of Arizona since 1997. My California State Bar number is 228998 and my Arizona State Bar number is 18315. I am also admitted to practice before the United States District Court for the Southern District of California since 2003 and the United States District Court for the District of Arizona since 1997.

3. I am an experienced litigation attorney with more than 20 years of experience representing clients in patent cases involving medical devices, software, micro-electronics, and life sciences. I regularly litigate patent cases in federal district courts. Through my experience in patent litigation matters, I have represented clients in many phases of litigation including discovery, *Markman* hearings, trials, and appeals. My biography is attached hereto as Appendix A.

4. I have appeared pro hac vice before the Board in the following proceedings; IPR2013-00511, IPR2013-00512, IPR2013-00514, IPR2013-00515, IPR2013-00516, IPR2016-01724, IPR2016-01735, IPR2017-00059, IPR2017-00061, IPR2017-00062, IPR2017-00272, IPR2017-00501, IPR2017-00504, IPR2017-00632, and IPR2017-01789. I am concurrently applying to appear *pro hac*

vice in the following proceedings: IPR2018-01247, IPR2018-01248, and IPR2018-01254.

5. I have not been suspended or disbarred from practice before any court or administrative body.

6. No court or administrative body has denied my admission to practice before then.

7. No sanction or contempt citation has been imposed against me by any court or administrative body.

8. I have read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of the Code of Federal Regulations.

9. I will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

10. I hereby declare that all statements made herein of my own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 35 U.S.C. § 1001.

Respectfully submitted,

Date: Sept. 11, 2019

/Roger A. Denning/

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APPENDIX A

FISH.
FISH & RICHARDSON

Roger A. Denning

Principal

San Diego, CA 858-678-4784 denning@fr.com

Background

Roger Denning is a trial lawyer specializing in complex litigation, including patent infringement and other technology-related cases. As lead counsel, Roger has helped some of the world's best-known companies win their most important cases. Roger has tried patent cases to verdict throughout the country, particularly in the patent-heavy dockets in California, Texas, Delaware, as well as the International Trade Commission. Roger also has tried to verdict a number of complex commercial cases, including in the areas of products liability, unfair competition and the False Claims Act. Roger also has advised clients in inter partes review proceedings in the Patent and Trademark Office.

An engineer by training, Roger has experience teaching juries and judges about a wide variety of technologies, including medical devices, pharmaceuticals, computer software, semiconductors, network interfaces, satellite communications, and golf ball design.

Roger joined Fish & Richardson in 2003, after beginning his career with Brown & Bain in Phoenix. He has been the Managing Principal of Fish & Richardson's Southern California office since 2009. Previously, Roger served as the Fish & Richardson's nationwide hiring principal from 2008 to 2014, and he served on the firm's seven-member Management Committee from 2013 to 2017.

Roger was born and raised in rural Kansas, where he met his wife, Michele. They have been married for over 20 years and have three children.

Services

- Litigation
- Commercial Litigation
- False Claims Act and Qui Tam
- Hatch-Waxman
- ITC Litigation
- Patent Litigation

Industries

- Electrical and Computer Technology
- Hardware
- Internet
- Life Sciences
- Manufacturing
- Medical Devices
- Semiconductors

- Software
- Telecommunications

Education

University of Chicago Law School 1997
J.D.
University of Chicago Legal Forum

Kansas State University 1993
Electrical Engineering, B.S.
Tau Beta Sigma
cum laude, Phi Kappa Phi

Admissions

- Arizona 1997
- California 2003
- U.S. Court of Appeals for the Federal Circuit

Memberships & Affiliations

Roger lectures frequently on topics relating to trial practice and patent law. He is a Master in the Clifford Wallace Inn of Court and a member of the San Diego Intellectual Property Association.

Other Distinctions

Accolades

Named "Lawyer of the Year- Litigation, Intellectual Property in San Diego" by Best Lawyers in America (2020)

Selected as a "Top Attorney of San Diego" by San Diego Daily Transcript (numerous years)

Selected as one of "San Diego's Best Attorneys" by SD Metro (2016)

Named to the Daily Transcript's list of "100 Influential Leaders in San Diego" (2016).

Named one of San Diego's "Top Influentials" by San Diego Daily Transcript (2013)

Fellow, Litigation Counsel of America (Invited in 2016)

Selected by peers for inclusion in The Best Lawyers in America© (numerous years)

Recognized as a Super Lawyer (numerous years)

Recipient of the Wiley W. Manuel Award for Pro Bono Legal Services from the State Bar of California in 2010

Recent Speaking Engagements

Roger lectures frequently on trial practice in patent and other complex cases. Roger's recent appearances include:

"All Things PTAB," Federal Circuit Bar Association Bench & Bar Conference (Coronado, California, June 23, 2018)

"The Emerging Role of Science and Technology in Mass Tort Litigation," Association of Corporate Counsel Annual Meeting (San Diego, California, December 14, 2017)

"The ITC as a Strategic Tool," Association of Corporate Counsel Annual Meeting (San Diego, California, December 15, 2016)

"Non-IP Life Sciences Litigation," Life Sciences IP Summit, Panel Discussion (San Francisco, California, November 4, 2016)

"What's on the Patent Landscape for 2015 and Beyond: What You Need to Know Now," 3rd Annual Patent Disputes for Corporate Counsel Forum (Southern California, May 20, 2015)

"Winning Trial Techniques for the Complex Patent Litigator," Patent Disputes Forum 2014 (San Diego, California, September 30, 2014)"

"Managing Discovery (Including Electronic Discovery) in Complex Litigation," Federal Circuit Bar Association, 2014 Advanced Complex Litigation Series (San Diego, California, January 29, 2014)

"Strategic Patent Litigation Issues," USC IP Institute, (Beverly Hills, California, March 14, 2013)

"Trying Hatch-Waxman Bench Trials and The Difference in Strategy for Bench vs. Jury Trials," Harris Martin Intellectual Property Law Conference (Dallas, Texas, June 14, 2012)

"Patent Damages Law: Life after Lucent, ResQNet, and Uniloc," Federal Bar Association (San Diego, California, April 11, 2012)

"Qui Tam and Fraud Claims – Current Strategies and Developments," Life Sciences Intellectual Property Summit (San Diego, California, May 19, 2011)

Experience

Medical Devices

In the Matter of Certain Sleep-Disordered Breathing Treatment Mask Systems and Components Thereof — Int'l Trade Comm'n Investigation No. 337-TA-1022 (I.T.C.). Lead counsel for complainant ResMed in investigation against New Zealand manufacturer Fisher & Paykel Healthcare involving two ResMed patents on CPAP masks to treat sleep apnea. Trial scheduled for May 2017.

Fisher & Paykel Healthcare Ltd. v. ResMed Corp. — No. 16-CV-2068 (S.D. Cal.). Lead counsel for defendant and counter-claimant ResMed in patent case against Fisher & Paykel Heathcare involving 16 total patents relating to CPAP masks and flow generators to treat sleep apnea.

In the Matter of Certain Sleep-Disordered Breathing Treatment Systems and Components Thereof — Int'l Trade Comm'n Investigation No. 337-TA-997 (I.T.C. and companion case in S.D. Cal.). Lead counsel for complainant ResMed in investigation against Chinese manufacturer BMC and U.S. distributor 3B Medical involving four ResMed patents on CPAP flow generators to treat sleep apnea. Case settled on eve of trial in January 2017.

In the Matter of Certain Sleep-Disordered Breathing Treatment Systems and Components Thereof — Int'l Trade Comm'n Investigation No. 337-TA-890 (I.T.C. and companion case in S.D. Cal.). Lead counsel for complainant ResMed in investigation against Chinese manufacturer BMC and U.S. distributor 3B Medical relating to six ResMed patents on CPAP masks and flow generators to treat sleep apnea. Six-day trial held in April 2014. Final determination finding violation and issuing exclusion order against all accused BMC masks in December 2014; remanded to ITC in April 2016 for reconsideration of domestic industry in light of Lelo Inc. v. International Trade Commission; on remand, in November 2016, ALJ Pender found domestic investments to be qualitatively but not quantitatively significant under Lelo.

In the Matter of Certain Sleep-Disordered Breathing Treatment Systems and Components T hereof — Int'l Trade Comm'n Investigation No. 337-TA-879 (I.T.C. and companion case in C.D. Cal.). Counsel for ResMed in ITC investigation against Taiwanese manufacturer APEX involving seven ResMed patents on CPAP masks and flow generators for treating sleep apnea. ITC investigation resulted in consent order barring APEX from importing, selling or importing for sale any infringing products; hearing on Apex's request for advisory opinion regarding certain design-around products held in March 2014.

Bard Peripheral Vascular, Inc. v. W.L. Gore & Associates, Inc. — Civ. No. 03-0597 (D. Ariz.). Represented Gore on remand from Federal Circuit relating to issues of willfulness and related impact on original trial.

Products Liability

In re Fresenius GranuFlo/NaturaLyte Dialysate Products Liability Litigation — (MDL No. 2428 and various state court actions). Trial counsel for Fresenius in products liability mass tort litigation relating to the use of acid concentrate products during dialysis, which the plaintiffs alleged resulted in sudden cardiac arrest.

Dial v. Fresenius Medical Care Holdings, Inc. – C.A. No. 14-11101-DPW (D. Mass.). Trial counsel for defendant Fresenius in four-week trial in which plaintiff alleged use of NaturaLyte liquid acid concentrate in hemodialysis treatment caused patient's death; obtained defense verdict of no causation in March 2017.

Ogburn-Sisneros v. Fresenius Medical Care Holdings, Inc. – No. MICV2013-05050 (Mass. Sup. Ct.). Trial counsel for defendant Fresenius in three-week trial in which plaintiff alleged use of GranuFlo granulated acid concentrate in hemodialysis treatment caused patient's death; obtained defense verdict of no causation in December 2015.

Pharmaceuticals (Hatch-Waxman)

Allergan, Inc. v. Sandoz, Inc. — No. 2:12-cv-207-JRG (E.D. Tex.). Trial counsel for Allergan in bench trial in October 2016 in Hatch-Waxman case in which defendant sought to manufacture and sell a generic version of Allergan's COMBIGAN® (brimonidine tartrate, timolol maleate) glaucoma treatment, protected by three patents. Court (J. Gilstrap) found for Allergan, keeping in place the previous permanent injunction.

Allergan, Inc. v. Sandoz, Inc. et al. — No. 6:11-cv-441 (E.D. Tex.). Trial counsel for Allergan in five-day bench trial in July 2013 in Hatch-Waxman case in which four defendants sought to manufacture and sell a generic version of Allergan's LUMIGAN® .01% (bimatoprost) glaucoma treatment, protected by five patents. Court (J. Schneider) found all asserted claims valid and infringed and granted Allergan a permanent injunction keeping the generics off the market. Published at 2013 WL 139350 (E.D. Tex. Jan. 10, 2013) and 2013 WL 1314188 (E.D. Tex. March 28, 2013)

Allergan, Inc. v. Apotex Inc. et al. — No. 1:10-cv-681 (M.D.N.C.). Trial counsel for Duke and Allergan in eight-day bench trial in November 2012 in Hatch-Waxman case in which three defendants sought to manufacture and sell a generic version of Allergan's LATISSE® (bimatoprost) treatment for hypotrichosis, protected by two patents.

Allergan, Inc. v. Sandoz, Inc. et al. — No. 2:09-cv-097 (E.D. Tex.). Trial counsel for Allergan in bench trial in August 2011 in Hatch-Waxman case in which four defendants sought to manufacture and sell a generic version of Allergan's COMBIGAN® (brimonidine tartrate, timolol maleate) glaucoma treatment, protected by four patents. Court (J. Ward) found for Allergan, granted Allergan a permanent injunction. Federal Circuit affirmed with regard to at least one patent, keeping the generics off the market. Published at 726 F.3d 1286, 2013 WL 1810852 (Fed. Cir. May 1, 2013); 818 F. Supp. 2d 974 (E.D. Tex. 2011); 2011 WL 3794364 (E.D. Tex. Aug. 25 2011); 2011 WL 2563238 (E.D. Tex. June 28, 2011); and 2011 WL 1599049 (E.D. Tex. April 27, 2011).

Allergan, Inc. v. Barr Labs., Inc. et al. — No. 09-333-SLR (D. Del.). Represented Allergan in bench trial in February 2011 in Hatch-Waxman case in which three defendants sought to manufacture and sell a generic version of Allergan's LUMIGAN® 0.03% (bimatoprost) glaucoma treatment, protected by two patents. Court (J. Robinson) found all asserted claims valid and infringed and granted permanent injunction keeping the generics off the market. Affirmed by Federal Circuit. Published at 501 Fed. Appx. 965, 2013 WL 314446 (Fed. Cir. 2013); and 808 F. Supp. 2d 715 (D. Del. 2011)

False Claims Act

United States ex rel. Gonzalez v. Fresenius Medical Care — No. 07-CV-247 (W.D. Tex.). Defended Fresenius Medical Care in qui tam action involving seven counts under the False Claims Act. Tried to jury verdict in month-long trial in El Paso, Texas in February 2010. Jury found for Fresenius on all claims; affirmed by Fifth Circuit Court of Appeals. Published at 748 F. Supp. 2d 95 (W.D. Tex. 2010); 761 F. Supp. 2d 442 (W.D. Tex. 2010); and 689 F.3d 470 (5th Cir. 2012)

Software and Encryption

RPost Holdings, Inc. v. Zix Corp. — No. 2:11-cv-00064 (E.D. Tex.). Represented Zix in patent litigation relating to RPost's assertions that Zix's ZixMail e-mail encryption system infringed RPost patent relating to e-mail receipt confirmation. Case settled favorably after claim construction.

Zix Corp. v. Echoworx Corp. — No. 3:12-cv-1102 (N.D. Tex.). Represented Zix in patent litigation asserting that Echoworx's product infringe two Zix patents relating to e-mail security and encryption. Case settled favorably.

Uniloc USA, Inc. v. Microsoft Corp. — No. 03–440S. (D.R.I.). Trial counsel for Microsoft in jury trial in March 2012 on damages issues relating to patent on software registration technology; case settled in second week of trial. This case, along with the Lucent case below, is regularly cited among the most important damages cases in patent law in recent years. Published at 632 F.3d 1292 (Fed. Cir. 2011); 640 F. Supp. 2d 150 (D.R.I. 2009); 290 Fed. Appx. 337 (Fed. Cir. 2008); and 447 F. Supp. 2d 177 (D.R.I. 2006).

Lucent Technologies, Inc. v. Gateway, Inc. et al. — No. 07-CV-2000 H (S.D. Cal.). Trial counsel for Microsoft in jury trial in July 2011 on remand from the Federal Circuit relating to damages on user-interface technology patent; original jury had awarded over $356 million; second jury awarded $70 million; Court (J. Huff) granted post-trial JMOL reducing damages to $26 million. Case settled shortly thereafter. This case, along with the Uniloc case above, is regularly cited among the most important damages cases in patent law in recent years. Published at 2011 WL 5513225 (S.D. Cal. 2011); 580 F.3d 1301 (Fed. Cir. 2009); and 580 F. Supp. 2d 1016 (S.D. Cal. 2008).

Microsoft Corp. v. Lucent Technologies, Inc. — No. 06-CV-0684 H (S.D. Cal.). Lead counsel for Microsoft in 7-week jury trial in April-June 2008 in patent case relating to video compression technology. Plaintiff sought more than $400 million in damages. Jury found that none of Microsoft's products infringe and awarded no damages. Named, with the case below, one of the "Top 10 Litigation Wins of 2008" by IP Law and Business. Published at 2008 WL 2872738 (S.D. Cal. 2008).

Microsoft Corp. v. Lucent Technologies, Inc. — No. 07-CV-2000 H (S.D. Cal.). Trial counsel for Microsoft in 6-week jury trial in February-April 2008 in patent case relating to four patents on video compression, video displays, stylus-based input devices and user interfaces. Plaintiff sought more than $2 billion in damages. Jury found Lucent's video compression patent invalid; found that Microsoft's products do not infringe the video compression or video display patents, and awarded reduced damages on the other two patents, which were further reduced after appeal. Named, with the case above, one of the "Top 10 Litigation Wins of 2008" by IP Law and Business. Published at 580 F.3d 1301 (Fed. Cir. 2009); and 580 F. Supp. 2d 1016 (S.D. Cal. 2008).

Lanham Act and Unfair Competition

Avid Identification Sys., Inc. v. Philips Semiconductors Inc. — No. 2:04-cv-183 (E.D. Tex.). Trial counsel for Avid in two-week jury trial asserting patent infringement (3 patents) and Lanham Act claims relating to RFID transponders and readers. Tried to jury verdict in May 2006. Obtained mid-trial settlement from two defendants and jury verdict against remaining defendants, including Lanham Act damages of $6 million. Published at 2006 WL 278265 (E.D. Tex. May 18, 2006); 2006 WL 278265 (E.D. Tex. February 3, 2006); 2007 WL 2901415 (E.D. Tex. Sept. 28, 2007); 603 F.3d 967, 973 (Fed. Cir. 2010)

Stonebreaker v. Medical Management Int'l, Inc. — No. GIC 830293 (Cal. Sup. Ct.). Trial counsel for Stonebreaker and Avid Identification Systems in jury trial asserting unfair competition under California Code Section 17200 and the Lanham Act relating to RFID technology. Tried to jury in July 2005. Obtained mid-trial settlement that included recovery of damages and a stipulated permanent injunction against the defendant.

Semiconductors and Communications

Applied Signal Technologies, Inc. v. ViaSat, et al. — No. 09-cv-02180 (N.D. Cal.) – Represented ViaSat in patent litigation relating to five patents on satellite communications and cancellation technology. Case settled favorably.

Coppola v. Powerware Corp. — CV 03-03667 (C.D. Cal.). Defended Powerware in patent infringement case relating to uninterruptible power supplies for computers and computer networks. Case settled prior to Markman hearing.

Maxim Integrated Products adv. Microelectronics Modules Corp. — No. 01 C 0272 (E.D. Wi.). Defended Maxim in patent infringement case relating to circuit design for switching voltage regulators. Case settled after favorable Markman ruling.

Lemelson Medical, Educational & Research Foundation v. Intel Corp. — No. 98-1413 (D. Ariz.). Defended Intel in patent infringement case relating to semiconductor manufacturing and machine vision and bar-coding technology. Case settled after favorable Markman ruling. Published at 2002 WL 31323299, 64 U.S.P.Q.2d 1172 (D. Ariz. July 30, 2002); 2002 WL 453212, 61 U.S.P.Q.2d 1905 (D. Ariz. Feb. 26, 2002); 1999 WL 813940, 52 U.S.P.Q.2d 1122 (D. Ariz. Aug. 18, 1999).

Maxim Integrated Products adv. Sipex Corp. — 99 CF 10096 RCL (D. Mass.). Represented Maxim as plaintiff in infringement case asserting patent relating to automatic shutdown circuitry for RS-232 interface devices. Case settled after favorable Markman ruling. Published at 2002 WL 1046699 (D. Mass. May 24, 2002).

Cypress Semiconductor Corp. adv. EMI Group North America, Inc. — No. Civ.A. 98-350 (D. Del.). Defended Cypress in infringement case relating to two patents on semiconductor manufacturing technology. Tried to jury verdict in 1999. Jury verdict of non-infringement of all claims and invalidity based on non-enablement, lack of utility, anticipation and obviousness; judgment affirmed by Federal Circuit. Published at 268 F.2d 1342 (Fed. Cir. 2001); 104 F. Supp. 2d 370 (D. Del. 2000); 68 F. Supp. 2d 421 (D. Del. 1999).

Consumer Goods

Callaway Golf Co. v. Acushnet Co. — No. 06-91 (D. Del.). Trial counsel for Callaway Golf in case asserting that Acushnet's popular Titleist Pro V1 and Pro V1x golf balls infringe four Callaway Golf patents on golf ball construction. Tried to jury verdict in December 2007, then again in March 2010, with intervening appeal to the Federal Circuit. Case ultimately settled. Published at 523 F. Supp. 2d 388 (D. Del. 2007); 576 F.3d 1331 (Fed. Cir. 2009).