

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

PETITIONER'S OBJECTIONS TO EVIDENCE

Pursuant to 37 C.F.R. § 42.64(b)(1), Petitioner, Intuitive Surgical, Inc. (“Petitioner”), hereby submits its notice of objections to certain evidence that Patent Owner, Ethicon LLC (“Patent Owner”), submitted with its Patent Owner Response dated April 19, 2019, in connection with IPR2018-01247. These objections are being submitted within ten business days of service of the Response.

Petitioner objects to Exhibit No. 2006 (Declaration of Dr. Shorya Awtar) and Exhibit 2007 (Declaration of Dr. Elliott Fegelman). The bases for objecting to these Exhibits include the following Federal Rules of Evidence:

FRE 801-805: Hearsay. Petitioner objects to the Exhibits as inadmissible hearsay to the extent Patent Owner intends to offer these Exhibits for the truth of the matters asserted.

FRE 401, 402, & 403: Relevant Evidence and Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons. These Exhibits contain irrelevant information, and to the extent these Exhibits are deemed to be relevant, Petitioner objects to these Exhibits because they contain conclusory and unsupported opinions and the probative value of the statements are outweighed by the danger of unfair prejudice or confusion of the issues.

FRE 702 & 703: Testimony by Expert Witnesses and Bases of an Expert’s Opinion Testimony. Petitioner objects to the Exhibits because the

opinions are not based on sufficient facts or data and the experts have not reliably applied accepted principals and methods to the facts at issue.

Petitioner objects to Exhibit No. 2007 (Excerpts from Technology Tutorial filed in Ethicon LLC, et al. v. Intuitive Surgical, Inc., et al., C.A. No. 17-871 (LPS)(CJB) (District of Delaware)). The bases for objecting to this Exhibit include the following Federal Rules of Evidence:

FRE 801, 802 & 803: Hearsay. Petitioner objects to Exhibit 2007 as inadmissible hearsay to the extent Patent Owner intends to offer this Exhibit for the truth of the matters asserted, including the attorneys' arguments regarding alleged facts to which they have no first-hand knowledge.

FRE 401 & 402: General Admissibility of Relevant Evidence. Petitioner objects to Exhibit 2007 as irrelevant to the extent it concerns a proceeding involving patents not at issue here. Furthermore, Exhibit 2007 has not been shown to be a recognized authority for any of the subject matter contained therein.

FRE 106 & 403: Remainder of or Related Writings or Recorded Statements and Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons. To the extent Exhibit 2007 is deemed to be relevant, Petitioner objects to Exhibit 2007 because it: (1) concerns a

litigation involving unrelated patents; (2) appears to contains excerpts of documents that are not part of this record; and (3) is itself a partial document. Thus, the probative value of Exhibit 2007 (if any), would be substantially outweighed by the dangers of unfair prejudice, wasting time, and confusing the issues.

Petitioner objects to Exhibit No. 2009 (Mucksavage et al., “*Differences in Grip Forces Among Various Robotic Instruments and da Vinci Surgical Platforms*”)

FRE 801-805: Hearsay. Petitioner objects to Exhibit 2009 as inadmissible hearsay to the extent Patent Owner intends to offer this Exhibit for the truth of the matters asserted. There is no declarant with personal knowledge of the experiments described in the Exhibit.

FRE 401, 402, & 403: Relevant Evidence and Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons. Exhibit 2006 is a published patent application by Petitioner having no apparent relevance to the issues presented in this proceeding, and its content does not appear probative to the issues presented in Patent Owner’s Response.

Petitioner objects to Exhibit Nos. 2014 and 2019 (International WIPO Publication Nos. WO 2015/153642 and US Patent Application Publication No. 2012/0209314). The bases for objecting to these Exhibits include the following Federal Rules of Evidence:

FRE 801-805: Hearsay. Petitioner objects to these Exhibits as inadmissible hearsay to the extent Patent Owner intends to offer these Exhibits for the truth of the matters asserted.

FRE 401, 402, & 403: Relevant Evidence and Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons. These Exhibits are patents and published applications by Petitioner having little to no relevance to any issue presented by the petition or otherwise present in this proceeding. To the extent that these Exhibits are relevant at all, any probative value of the articles is outweighed by the danger of unfair prejudice or confusion of the issues.

Dated: April 25, 2019

Respectfully submitted,

/Steven R. Katz/

Steven R. Katz, Reg. No. 43,706
Fish & Richardson P.C.
One Marina Park Drive
Boston, MA 02210
Tel: 617-521-7803
Email: katz@fr.com
Attorney for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on April 25, 2019, a complete and entire copy of this Petitioner's Objections to Evidence was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

Anish R. Desai
Elizabeth Stotland Weiswasser
Adrian Percer
Christopher T. Marando
Christopher M. Pepe
Weil, Gotshal & Manges LLP
767 Fifth Avenue
New York, NY 10153

Email: Ethicon.IPR.Service@weil.com

/Jessica K. Detko/
Jessica K. Detko
Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402
(612) 337-2516