

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ETHICON LLC, <i>et al.</i> ,)	
)	
Plaintiffs,)	
)	
v.)	C.A. No. 17-871-LPS-CJB
)	
INTUITIVE SURGICAL, INC., <i>et al.</i> ,)	
)	
Defendants.)	

DEFENDANTS' OPENING CLAIM CONSTRUCTION BRIEF

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I. INTRODUCTION¹

Intuitive asks the Court to construe the claim terms in dispute according to governing law and both the intrinsic and extrinsic evidence.

II. ARGUMENT

A. Legal standard for claim construction

Patent claims define the scope of a patentee's monopoly right, and the interpretation of those claims presents a question of law. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977-78 (Fed. Cir. 1995). A patent may disclose a wide range of technology, but “the claims of a patent define the invention[.]” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc). The specification also “is always highly relevant to the claim construction analysis,” if not “dispositive” as “the single best guide to the meaning of a disputed term.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). “The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.” *Phillips*, 415 F.3d at 1316.

The prosecution history may also provide useful insight. *See Markman*, 52 F.3d at 980. It can demonstrate, for instance, “how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips*, 415 F.3d at 1317. A court also may rely on extrinsic evidence, which “consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.” *Markman*, 52 F.3d at 980. Extrinsic evidence is given less weight than intrinsic evidence, but it can be a useful tool for understanding the relevant art and underlying technology. *See Phillips*, 415 F.3d at 1317-18.

¹ Throughout this brief, emphases in quotations were added unless otherwise stated; and quotation marks, alterations, and citations were omitted from quotations.

B. '969 Patent terms

1. “tool mounting portion operably coupled to a distal end of said proximal spine portion” ('969 claim 24)

Intuitive Surgical	Ethicon
tool mounting portion operably coupled to a distal end of said proximal spine portion	tool mounting portion operably coupled to a proximal end of said proximal spine portion

Ethicon seeks to construe this phrase in accordance with a January 2018 Certificate of Correction that substitutes “proximal” for “distal” as follows: “a tool mounting portion operably coupled to a ~~distal~~ proximal end of said proximal spine portion.” That Certificate is invalid as a matter of law, however, because “(1) the corrected claim [is] broader than the original claim[]; and (2) the presence of the clerical or typographical error, or how to correct that error, is not clearly evident to one of skill in the art.” *Central Admixture Pharm. Svcs., Inc. v. Adv. Cardiac Solutions, P.C.*, 482 F.3d 1347, 1353–54 (Fed. Cir. 2007). For purposes of this analysis, a “corrected” claim is broader than the original claim if it “covers territory the old [claim] did not.” *Id.* at 1353 (certificate of correction substituting one unit of measurement for another was invalid because “the claims as corrected cover less-concentrated solutions which would not be covered under the original claims”). “Indeed, a certificate of correction is invalid if the corrected claim contains within its scope any conceivable apparatus or process which would not have infringed the original patent.” *Cubist Pharm., Inc. v. Hospira, Inc.*, 75 F. Supp. 3d 641, 655 (D. Del. 2014), *aff’d*, 805 F.3d 1112 (Fed. Cir. 2015); *see also S.O.I.Tec Silicon On Insulator Techs., S.A. v. MEMC Elec. Materials, Inc.*, 745 F. Supp. 2d 489, 506–07 (D. Del. 2010) (certificate of correction substituting “ions” for “hydrogen ions” was invalid).

It is not necessary that the Court engage in an exercise of estimating whether that corrected claim scope is somehow quantitatively or qualitatively greater than the original claim scope. Ethicon alleges that Intuitive infringes the corrected language of claim 24, but it has never alleged—even to

support its complaint filed six months *before* issuance of the Certificate—that Intuitive infringes the original language of claim 24. This amounts to an admission by Ethicon that the corrected claim “covers territory the old [claim] did not.” Moreover, the corrected claim recites a first structure that is “operably coupled” to a “*proximal* end” of a second structure, whereas the original claim language recites a first structure that is “operably coupled” to a “*distal* end” of a second structure. If words in a claim mean anything, these two versions of the claim must encompass different “territory.”

Where, as here, the effect would be to broaden the claim, a clerical or typographical mistake may be corrected with a certificate of correction only if the mistake is “immediately apparent and leave[s] no doubt as to what the mistake is.” *Superior Fireplace Co. v. Majestic Prods. Co.*, 270 F.3d 1358, 1370 (Fed. Cir. 2001). Mistakes in this category include obvious misspellings and “clerical errors in which [for instance] the patentee attempts to change every instance of a particular claim term in prosecution but misses one, leaving a claim that, on its face, is nonsensical in light of the specification.” *Central Admixture Pharm. Svcs.*, 482 F.3d at 1354. Here, in contrast, the as-printed original claim language is typographically and grammatically correct, and the uncorrected language appears in the version of the claim that was submitted to the PTO during prosecution. Ethicon asserts that the original claim contains a clerical error, but it has never explained how that could be so.

Moreover, the presence of an error in the original claim language would not have been clearly evident to a person of ordinary skill in the art. *See* Declaration of Bryan Knodel (“Knodel Decl.”) ¶¶13-19. First, the as-printed original language of claim 24 is consistent with other claims in the ’969 Patent. *See* Knodel Decl. ¶¶15, 18-19; claim 12 (reciting a proximal spine portion with “a distal end portion operably supported on said tool mounting portion”); dependent claim 26 (reciting “articulation system” comprising two articulation bars each having a proximal end operably interfacing with an “articulation transmission” and a “distal end coupled to a proximal portion of

said elongated shaft assembly”). Moreover, there is nothing nonsensical about “operably coupling” one element (a “tool mounting portion”) to “a distal end of said proximal spine portion.” Claim 24 requires, for instance, that the “proximal spine portion [be] pivotally coupled to said distal spine portion at an articulation joint.” Because “operable coupling” does not require a direct physical connection, it is entirely logical that the tool mounting portion would be “operably coupled” to the distal end of the proximal spine portion to facilitate the motions of the articulation joint. *See id.* ¶¶15-18. Indeed, the specification describes an embodiment in which a “tool mounting plate” (the recited “tool amounting portion”) interacts with the articulation joint via articulation bars that extend from the distal end of the proximal spine portion. *See id.* ¶17; ’969 at 30:30-67; Figs. 32, 39-40.²

Nor is the purported error in the original claim language of 24 the sort of correction that is appropriate for the Court to make. Judicial correction is appropriate only if “(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.” *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1357 (Fed. Cir. 2003). For the reasons set forth above, Ethicon cannot meet this standard.

2. “[proximal/distal] spine portion” (’969 claim 24)

Intuitive Surgical	Ethicon
discrete [proximal/distal] interior supporting member within the elongated shaft assembly	structural member within [proximal/distal] portion of elongated shaft assembly

The parties agree that the “[proximal/distal] spine portion” is a member within the [proximal/distal] portion of the elongated shaft assembly. But whereas Ethicon’s proposed

² Even if one of ordinary skill had known that there was a mistake in the as-printed claim, the manner of correcting it would not have been clearly evident. Knodel Decl. ¶20. Consistent with one of the disclosed embodiments, for instance, it is equally plausible that the Applicant had intended the claim to recite a “tool mounting portion operably coupled to a ~~distal~~ proximal end of said ~~proximal~~ distal spine portion.” *Id.*; *see also* ’969 at 30:26-31:43; Figs. 32, 37-40.

construction broadly encompasses any “structural member,” Intuitive’s construction is true to the specification in explaining what that structure is.

First, Intuitive’s proposal makes clear that the proximal and distal spine portions are *interior* components. This is consistent with the specification, which consistently refers to the “spine” as an inner structure enclosed within outer portions of the elongated shaft assembly. *See, e.g.*, ’969 at 13:12-13 (“Disposed inside the closure tubes 40, 42 may be a proximate spine tube 46.”); 33:26-30 (“proximal spine shaft 2353 ... is non-movably supported within the hollow outer tube 2340”). The figures likewise confirm that the spine is an interior structure. *See, e.g., id.*, Figs. 4, 5, 32, 41. For instance, Figure 41, which provides support for claim 24’s articulation joint, shows that proximal spine portion 2052 is enclosed within proximal closure tube 2040. Similarly, Figure 32 (an exploded view of the articulation joint) depicts proximal spine portion 2052 and distal spine portion 2050 within a closure tube assembly 2009 that includes proximal closure tube 2040 and distal closure tube 2042. *Id.* at 27:28-32; *see also id.* at 27:36-38 (noting that “closure tube assembly 2009 is configured to axially slide on the spine assembly 2049”).

Second, Intuitive’s construction draws directly from the specification in clarifying that the spine portion is a *supporting* structure. It supports the exterior portion of the shaft assembly, such as closure tubes, and may also support other interior components, such as articulation bars. *See, e.g.*, ’969 at 27:28-32 (shaft assembly may include closure tubes “operably supported on a spine assembly”); 29:45-47 (proximal spine portion 2052 “provide[s] support to the knife bar 2200 as it is axially pushed therethrough”); 30:31-34 (articulation bars “are slidably supported within corresponding passages 2053 provided through the proximal spine portion 2052”).³

³ Intuitive’s construction is also consistent with extrinsic evidence defining “spine” as a supporting structure. *See* Declaration of Divya Musinipally (“Musinipally Decl.”), Ex. A (defining “spine” as “something constituting a main strength, central axis, or chief support”).

Finally, Intuitive’s construction properly clarifies that each of the distal and proximal spine portions is a *discrete* member. As described in the specification, and shown in the figures, each such spine portion is physically distinct from one another, and from other components in the elongated shaft assembly. *See, e.g.*, ’969 at 13:5-25; 27:19-38; 29:38-53; 30:26-64; 31:19-23; Figs. 4-5, 32, 37-41; claims 24, 26-28.

C. ’874 Patent terms

1. “remote[ly] user-controlled console” (’874 claims 9 and 20)

Intuitive Surgical	Ethicon
plain and ordinary meaning, or in the alternative: user-controlled unit separate from the surgical instrument that communicates with the surgical instrument	remote input device operated by a user to actuate a surgical instrument supported on a manipulator such as a robotic arm

The ’874 patent describes multiple embodiments employing a remote[ly] user-controlled console, and only in the penultimate column does the specification state that “the above described invention *also has applicability* to robotic surgical systems,” such as systems “*well known in the art and ... available from Intuitive Surgical, Inc.*” *Id.* at 30:49-50; *see also id.* at 30:51-53 (incorporating by reference Intuitive patents). Not one of the ’874 patent’s 56 figures shows a robotic console, nor does the specification disclose any robotic technology invented by Ethicon. But having incorporated Intuitive’s patents into the specification by way of a March 2011 continuation-in-part application filed years after the earlier applications, Ethicon now would have the Court believe that its purported invention not only “*has applicability* to robotic surgical systems,” but that it is actually limited to such systems. The Court should reject Ethicon’s construction, because it contradicts the plain teachings of the intrinsic record and violates black-letter claim construction law.

First, Ethicon’s construction improperly purports to limit the claimed “remote[ly] user-controlled console” to a single embodiment without pointing to any language in the claim that suggests it covers only one embodiment. Nothing in the intrinsic record suggests that the generic

recitation of a “remote[ly] user-controlled console” was intended to limit the claims as Ethicon proposes. Indeed, the specification never mentions the words “remote input device” or “manipulator.” The specification also specifically disclaims any intent to limit the claims to a disclosed embodiment. *See* ’874 at 31:26-30.

Claim differentiation principles further confirm that Ethicon’s proposed construction is improper. Four independent claims specifically require a “remote user-controllable (or “user-controlled”) **actuation** console” (*see* claims 1, 16, 19, 21), whereas claims 9 and 20 (at issue here) do not. “There is a heavy presumption that claim terms mean what they say, and a difference in meaning and scope is likewise presumed when different words or phrases are used in separate claims.” *Cooper Notification, Inc. v. Twitter, Inc.*, 867 F. Supp. 2d 485, 492 (D. Del. 2012), *aff’d*, 545 F. App’x 959 (Fed. Cir. 2013). Here, the patentees’ decision to require an “**actuation** console” in four independent claims (as compared with simply a “console” recited in claims 9 and 20) demonstrates their intention to exclude the “actuation” limitation from claims 9 and 20. *See, e.g., Alcon Research, Ltd. v. Watson Labs., Inc.*, No. CV 16-129-LPS-SRF, 2017 WL 618441, at *4 (D. Del. Feb. 15, 2017), report and recommendation adopted, No. CV 16-129-LPS-SRF, 2017 WL 5188056 (D. Del. Nov. 9, 2017). Ethicon’s construction, which requires a remote input device use to “**actuate** a surgical instrument,” is directly contrary to that demonstrated intention.

Ethicon’s construction should be rejected for the additional reason that it excludes an embodiment with no claim language suggesting that was the patentee’s intent. In particular, the specification discloses a surgical instrument that communicates data collected from sensors in the instrument to a “remote computer device”—*i.e.*, a “remote[ly] user-controlled console.” *See* ’874 at 29:26-29; Figs. 55-56. “The remote computer device 2420 may be any device with a processor and a memory, and capable of communicating with ... [the instrument] and downloading the sensor

data...” *Id.* at 29:43-46; *see also id.* at 29:46-49 (“the remote computer device 2420 may be a desktop computer, a laptop computer, a server, a workstation, ... etc.”). The sensor data may include information regarding instrument conditions, such as the position of the knife or cutting surface. *Id.* at 25:66-67; *see also* 25:1-2 (describing closure trigger sensor that “senses a condition of the closure trigger”); 25:23-24 (“anvil closure sensor 2004 may sense whether the anvil 24 is closed”). Once the sensor data is transmitted from the instrument to the remote computer device, the data may be analyzed and manipulated. *Id.* at 30:6-10; Fig. 56.

The “remote computer device” in this embodiment falls squarely within the plain meaning of “remote[ly] user controlled console” because it is a unit separate from the surgical instrument (a **remote** console) that is user-controlled to view, analyze, and manipulate data received from the instrument. Yet, Ethicon’s construction improperly excludes it without any indication in the claim that this was the drafter’s intent. Accordingly, the Court should reject Ethicon’s flawed construction and give this term its plain and ordinary meaning. Should the Court determine that further construction is appropriate, an interpretation consistent with its ordinary meaning is: “a user-controlled unit separate from the surgical instrument that communicates with the surgical instrument.”

2. “reciprocatable closure element configured to apply said opening and closing motions to said one of said first and second jaws” (’874 claim 9)

Intuitive Surgical	Ethicon
Term subject to 112(6). Function: to apply opening and closing motions to one of said first and second jaws. Structure: distal closure tube 42 and proximate closure tube 40 (Fig. 4); <i>or, in the alternative:</i> outer tube configured to apply said opening and closing motions to said one of said first and second jaws	Term not subject to 112(6). Plain and ordinary meaning.

The central dispute here is whether this limitation must be construed as a means-plus-function limitation subject to 35 U.S.C. § 112, ¶6.⁴ Intuitive submits that it must be so construed, because it is claimed by its function without the recitation of sufficient structure to perform that function. Declaration of Jeffrey Vaitekunas (“Vaitekunas Decl.”) ¶¶17-20.

Although the absence of the word “means” in a claim limitation triggers a rebuttable presumption that § 112, ¶6 does not apply, the presumption is overcome where, as here, “the claim term fails to recite sufficiently definite structure or else recites function without reciting sufficient structure for performing that function.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (en banc). The “essential inquiry” is “whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” *Id.* at 1348. “Generic terms such as ‘mechanism,’ ‘*element*,’ ‘device,’ and other nonce words that reflect nothing more than verbal constructs may be used in a claim in a manner that is tantamount to using the word ‘means’ because they typically do not connote sufficiently definite structure.” *Id.* at 1350.

⁴ That provision provides that “[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

Here, “element” is a well-known nonce word, *see id.*, and the surrounding claim language merely defines a function. The functional modifier “reciprocatable,” for instance, fails to impart any meaningful structure; at most, that word suggests a back-and-forth movement typical of virtually any mechanism that would open and close the jaws of an end effector. *See* Vaitekunas Decl. ¶19; *see also* Musinipally Decl., Ex. A (defining “reciprocating” as “characterized by alternation in motion: moving to and fro”).⁵ Similarly, the requirement that the “closure element” apply opening and closing motions to “one of said first and second jaws” carries no generally understood structural meaning in the art. *Id.* To the contrary, virtually every jaw opening and closing mechanism includes some “element” that applies motion to at least one of the jaws. *Id.* Thus, while surrounding claim language may sometimes save a “black box” nonce word from application of § 112, ¶6, no such language is present here.⁶

Because § 112, ¶6 applies, the Court must define the claimed function and its corresponding structure(s). *Williamson*, 792 F.3d at 1351. The claimed function of the “reciprocatable closure element” is to apply opening and closing motions to one of said first and second jaws. *See* Vaitekunas Decl. ¶20. The structure disclosed in the specification for performing that function is distal closure tube 42 and proximate closure tube 40. *Id.* ¶21; *see also, e.g.*, ’874 at 8:20-27, 11:65-12:14; Figs. 4, 5. The proximate closure tube 40 and distal closure tube 42 are pivotably linked by a pivot link 44. *Id.* at 8:22-24. “The distal closure tube 42 includes an opening 45 into which the tab 27 on the anvil 24 is inserted in order to open and close the anvil.” *Id.* at 8:24-26. In operation, when the

⁵ The term “reciprocatable closure element” does not appear in the specification except in a summary section, added by amendment after the notice of allowance, that does not provide any structure for that term. *See* ’874 at 4:2-8; JA607-611 (6/17/2015 Amendment to Specification); *see also* Vaitekunas Decl. ¶18.

⁶ *See, e.g., Nichia Corp. v. TCL Multimedia Tech. Holdings, Ltd.*, No. CV 16-681-RGA, 2017 WL 5719267, at *7–9 (D. Del. Nov. 28, 2017) (“dispersive member” and “reflective member” invoked § 112, ¶6 because the claims merely defined the functions of each “member”).

proximate closure tube 40 moves distally, the distal closure tube 42 also moves distally, causing the anvil 24 to rotate into a closed position. *Id.* at 11:65-12:4. When, from the closed position, the proximate closure tube 40 is caused to move proximally, the distal closure tube 42 also moves proximally, causing the anvil 24 to pivot into the open position. *Id.* at 12:4-10.

Should the Court determine that § 112, ¶6 does not apply, it should construe this term, consistent with the disclosures in the specification, as an outer tube configured to apply said opening and closing motions to said one of said first and second jaws.

3. “driver element supported for axial travel through the [surgical] end effector in response to [a] firing motion[s applied thereto]” (’874 claims 9 and 20)

Intuitive Surgical	Ethicon
Term subject to 112(6). Function: providing axial travel through the surgical end effector in response to firing motions. Structure: knife 32 with threaded opening for receiving helical drive screw 36 (Fig. 3)	Term not subject to 112(6). Plain and ordinary meaning.

This term also is subject to § 112, ¶6 because it is built around the nonce word “element” and claims a function without disclosing sufficient structure for performing that function. Vaitekunas Decl. ¶¶22-26. The prefix “driver” does not impart sufficient structure; one of ordinary skill would understand that word as referring to any structural component that imparts motion to some other component. *Id.* ¶26. Nor does the specification provide any structural definition for the claimed “driver element.” *Id.* ¶25. That term appears only in a summary section that merely repeats the functional language of the claims. *See* ’874 at 4:42-44. Moreover, the specification refers to different structural components as performing a driving function. *See* ’874 at 8:55-57 (“knife **driving** member 32 ... travel[s] longitudinally along the channel 22” to cut tissue); 8:58-64 (as sled 33 “traverses the channel 22, [it] may push up or **drive** the staples in the staple cartridge”). Because the words in this limitation lack “sufficiently definite meaning as the name for structure,” § 112, ¶6 applies.

As proposed by Intuitive, the function recited in this limitation is to provide axial travel through the surgical end effector in response to firing motions. Vaitekunas Decl. ¶27. The corresponding structure is knife 32 with a threaded opening for receiving helical drive screw 36. *Id.* ¶¶27-28; '874 Fig. 3; *see also* '874 at 8:45-49 (“The helical screw shaft 36 may interface a threaded opening (not shown) of the knife 32 such that rotation of the shaft 36 causes the knife 32 to translate ... through the staple channel 22.”); *id.* at 8:49-57 (rotation of helical screw shaft 36 “causes the knife driving member 32 to travel longitudinally along the channel 22 to cut any [clamped] tissue ...”; *id.* at 10:45-48 (rotation of helical gear drum 80 drives the main drive shaft assembly which “causes deployment of the knife 32 in the end effector”); claim 13 (“driver element comprises a tissue cutting surface”); claim 14 (“rotary drive shaft [is] in threaded engagement with said driver element”).

D. '658 Patent terms

- **“opening member configured to move longitudinally to apply an opening force to said anvil at a location other than said cam surface to move said anvil into said open position” ('658 claim 1)**
- **“opening system configured to move longitudinally to apply an opening force to said second jaw at a location other than said cam surface to move said second jaw into said open position” ('658 claim 6)**
- **“opening member configured to move longitudinally to apply a pulling force to said anvil at a location other than said cam surface to move said anvil into said fully-open position” ('658 claim 11)**
- **“pulling member configured to move longitudinally to apply a pulling force to said anvil at a location other than said cam surface to move said anvil” ('658 claim 14)**

Intuitive Surgical	Ethicon
<p>Term subject to 112(6). Function: to move said anvil [second jaw] into open [fully-open] position by moving longitudinally to apply an opening [pulling] force to said anvil [second jaw] at a location other than said cam surface. Structure: closure tube with an opening for engaging a tab on the anvil; <i>or, in the alternative:</i></p> <p>outer tube configured to move the anvil [second jaw] into open [fully-open] position by moving longitudinally to apply an opening [pulling] force to the anvil [second jaw] at a location other than said cam surface</p>	<p>Term not subject to 112(6). Plain and ordinary meaning.</p>

These claim limitations are also subject to § 112, ¶6. Vaitekunas Decl. ¶¶30-40. “Member” and “system” are well-known nonce words that operate as a substitute for “means.” *Verint Sys. Inc. v. Red Box Records Ltd.*, 166 F. Supp. 3d 364, 381 (S.D.N.Y. 2016) (“system” is a “nonce word that does not describe a structure that could perform the listed functions”); *Toshiba Tec Corp. v. Katun Corp.*, No. SACV1501979SJOJCX, 2016 WL 8861713, at *15 (C.D. Cal. Dec. 1, 2016) (“member” is a nonce word that does not connote sufficiently definite structure). The functional prefixes “opening” and “pulling” have no structural significance. Vaitekunas Decl. ¶¶31-32, 36, 38, 39. And the remaining claim language merely recites the function performed by the claimed “member” and “system.”

The requirement that the “member” and “system” be “configured to move longitudinally” does not provide sufficiently definite structure to avoid application of § 112, ¶6. Vaitekunas Decl. ¶33. A person of ordinary skill would understand that a wide variety of structures could move longitudinally to accomplish the claimed function. *Id.* Likewise, the requirement that the “member” and “system” apply an opening (or pulling) force to the anvil (or second jaw) “at a location other than said cam surface” imparts insufficient structural meaning. *Id.* ¶33. At most, “it only describes

the term’s function and interaction with other parts in the system.” *Media Rights Techs., Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1373 (Fed. Cir. 2015). That is not enough. *Id.* at 1373-74.; *see also Robert Bosch, LLC v. Snap-On Inc.*, 769 F.3d 1094, 1099-1100 (Fed. Cir. 2014) (specification’s description of how claimed “program recognition device” connects and functions with other components failed to provide sufficient structure). Accordingly, § 112, ¶6 applies.

As proposed by Intuitive, the function claimed in these terms is to move said anvil [second jaw] into open [fully-open] position by moving longitudinally to apply an opening [pulling] force to said anvil [second jaw] at a location other than said cam surface. Vaitekunas Decl. ¶¶34, 37-38, 40. The corresponding structure is a closure tube with an opening for engaging a tab on the anvil. *Id.* ¶¶34-35, 37, 38, 40;’658 at 30:57-61 (“distal closure tube 2042 includes an opening 2045 into which the tab 2027 on the anvil 2024 is inserted in order to facilitate opening of the anvil 2024 as the distal closure tube 2042 is moved axially in the proximal direction ‘PD’”); *see also, e.g., id.* at 32:43-46; 41:11-13; 42:67-43:5; 44:54-57; Figs. 2, 24, 44-49, 55-58, 60-62, 65-67, 75-78. Should the Court determine that § 112, ¶6 does not apply, it should construe this term, in light of the specification, as an outer tube configured to move the anvil [second jaw] into open [fully-open] position by moving longitudinally to apply an opening [pulling] force to the anvil [second jaw] at a location other than said cam surface.

E. ’431 Patent terms

1. “transmission arrangement communicating with the control unit of the robotic system” (’431 claim 1)

Intuitive Surgical	Ethicon
the transmission arrangement exchanging electronic control signals with the control unit of the robotic system	Plain and ordinary meaning, or “the control unit provides a control signal that results in movement of the transmission arrangement”

The transmission arrangement of claim 1 of the ’431 patent is a shifting mechanism that “move[s] between first and second positions” in response to electronic signals from the robotic

control unit. Depending on the position of the transmission, it transmits a “rotary output motion” of the tool drive assembly to create a first control motion or a second control motion of a surgical end effector. ’431, claim 1. By its ordinary meaning and as illustrated in the specification, the “communicating” limitation of claim 1 refers to the exchange of control signals with the control unit of the robotic system. Intuitive’s construction accurately reflects that limitation.

The relevant ordinary meaning of “communicate” is to “share or exchange information” or “to have an interchange.” *See* Musinipally Decl., Ex. A (“communicate” means “to send information or messages sometimes back and forth...interchange thoughts”); Ex. B (“to have an interchange, as of ideas”); Ex. D (“share or exchange information”); Ex. E (“exchange of information”). The claim language makes clear that it is the transmission arrangement itself that communicates with the control unit. Indeed, the “communicating” limitation of claim 1 stems from embodiments wherein the control unit of the robotic system supplies a “control signal” to the transmission arrangement’s shifter motor or shifter solenoid, both of which require electronic signals to operate. *See, e.g.*, ’431 at 63:37–41 (“when the robotic system 1000 supplies an appropriate control signal, switch 3914 will permit battery 3912 to supply power to the double pole switch 3918. The robotic system 1000 will also supply an appropriate signal to the double pole switch 3918 to supply power to a shifter motor 3922.”); 64:41–44 (“the controller 1001 of the robotic system 1000 will provide a control signal to the shifter motor 3922 (or shifter solenoid) to move the shifter yoke 3940 in the first direction”); 83:49–55 & 84:34–37 (“The shifter solenoid assembly 6350 is coupled to corresponding pins 6352 by conductors 6352. *See* FIG. 136. ... Such arrangement serves to electrically couple the shifter solenoid assembly 6350 to the robotic controller 1001 [T]he robotic controller 1001 activates the shifter solenoid assembly 6350 to bring the shifter gear 6342 into meshing engagement with the first horizontal drive gear 6362.”).

Further, the “communicating” limitation plainly narrows the scope of the claim to only those embodiments of the patent in which the robotic system’s control unit exchanges electronic control signals with the transmission arrangement. These embodiments each include either a shifter motor or shifter solenoid in communication with the control unit. In the “cable drive transmission” embodiment of Figs. 104–106, shifter yoke 3940 is operably coupled to shifter motor 3922, which shifts the shifter yoke into a first or second position when control signals are sent to it by the control unit of the robotic system. *Id.* at 63:42–59; *see also id.* at 64:29–65:36. The patent teaches that a shifter solenoid, which is a type of electrical magnet, can be substituted for the shifter motor of Figures 104–106. *Id.* at 63:59–61. Every occurrence of the word “communicate,” or variant thereof, refers to communication by electronic signals. *See, e.g.,* ’431 at 75:53–56; 77:65–78:3; 83:51–53.

Likewise, the articulation embodiment, best seen in Figure 149, uses a shifter solenoid 6350 that receives electronic signals from the control unit of the robotic system to shift the shifter driven gear assembly 6340 along the splined portion of a shifter shaft 6330. *Id.* at 83:46–67. The shifter solenoid 6350 moves shifter gear 6342, which is mounted on shifter shaft 6330, in meshing engagement with either a horizontal or vertical drive gear in order to articulate the end effector either to the left and right or up and down. *Id.* at 84:34–37 (“the robotic controller 1001 activates the shifter solenoid assembly 6350 to bring the shifter gear 6342 into meshing engagement with the first horizontal drive gear 6362.”), 84:62–65 (“the robotic controller 1001 activates the shifter solenoid assembly 6350 to bring the shifter gear 6342 into meshing engagement with the first vertical drive gear 6372.”).

Ethicon’s construction would read the “communicating” limitation out of the claim. While Ethicon acknowledges that “the control unit provides a control signal,” because that signal need only “*result[]* in movement of the transmission arrangement,” it does not actually require

“communication.” Nor does Ethicon’s construction specify that the communication disclosed by claim 1 is electronic. Unless the claim is construed to require that the control signal be exchanged with the transmission arrangement, and that it be electronic, the construction would rewrite the claim language. For this reason, Ethicon’s construction must be rejected.

Finally, for the reasons discussed below in connection with the power patents, Ethicon’s request for a “plain and ordinary meaning” construction of this term is disfavored in the law because there is a significant dispute between the parties concerning the scope of the term. *See O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008).

2. “transmission arrangement” (‘431 claims 1, 6, 13)

Intuitive Surgical	Ethicon
an assembly of shafts and/or gears, and other components that transmit mechanical power from a source [of rotary output motion] to a driven component	Plain and ordinary meaning, or “an arrangement of one or more shafts and/or gears that transmits mechanical power.”

Ethicon’s construction seeks to limit the scope of the transmission arrangement to shafts and/or gears, but, as discussed above, claim 1 is directed to a shifting mechanism that includes not only shafts and/or gears, but other components that perform the task of shifting the transmission arrangement into first and second positions. Indeed, claim 1 teaches that the transmission arrangement is “communicating with the control unit of the robotic system and being responsive to actuation motions therefrom to move between first and second positions.” *Id.*, claim 1. Shafts and/or gears alone could not perform that task, so the transmission arrangement must include other components to accomplish it.

Indeed, as discussed in detail above, the embodiments to which claim 1 is directed all define the transmission arrangement to include either a shifter motor or a shifter solenoid (an electrical magnet), neither of which are shafts or gears. The “cable drive transmission” embodiment of Figs.

104–106 shifts a shifter yoke 3940 by receiving electrical control signals from the control unit of the robotic system to shifter motor 3922. *Id.* at 63:42–59; *see also id.* at 64:17–65:36. The articulation embodiment depicted in Figure 149 uses shifter solenoid 6350, which receives electrical signals from the control unit, to shift the shifter driven gear assembly 6340 to bring the shifter gear 6330 into meshing engagement with different drive gears. *Id.* at 83:46–67, 84:34–65. No transmission arrangement of the patent that communicates with the control unit of the robotic system is comprised solely of shafts and/or gears. Yet Ethicon’s construction would allow it to expand the scope of claim 1 to assert it against products that contain solely shafts and gears. The Court should reject Ethicon’s attempt to broaden the scope of claim 1 and instead the Court should construe “transmission arrangement” to mean “an assembly of shafts and/or gears, and other components that transmit mechanical power from a source [of rotary output motion] to a driven component.”⁷

3. [first and second] control assembly operably interfacing with said elongated shaft assembly to apply said [first/second] control motion thereto” (’431 claim 6)

Intuitive Surgical	Ethicon
Term subject to 112(6). Function: operably interface with the elongated shaft assembly to apply [first/second] control motions to the elongated shaft assembly. Structure: Articulation system 6140, including articulation control arrangement (aka ball joint assembly) 6160, articulation drive assembly 6170, horizontal gear arrangement 6180 and vertical gear arrangement 6190, of Fig. 149	Term not subject to 112(6). Plain and ordinary meaning.

The first and second control assemblies of claim 6 are subject to § 112, ¶6. *See* Vaitekunas Decl. ¶¶42-45. The term “assembly” is a nonce word that that operates as a substitute for “means,”

⁷ Ethicon’s construction also omits from its definition of “transmission arrangement” that the transmission receives rotary mechanical power from the outputs of the tool drive assembly, which claim 1 expressly defines as being part of the transmission arrangement: “said transmission arrangement is configured to operably interface with a rotatable driven element of the tool drive assembly *to receive a rotary output motion therefrom.*” ’431, claim 1.

id. ¶¶43-44; *Vistan Corp. v. Fadei USA, Inc.*, No. C 10-4862 JCS, 2012 WL 1496099, at *15 (N.D. Cal. Apr. 27, 2012) (applying 112, ¶6 to claim term “active assembly”), and the prefix “control” imparts no additional structure. Vaitekunas Decl. ¶44; *see also Ranpak Corp. v. Storopack, Inc.*, 168 F.3d 1316 (Fed. Cir. 1998) (applying § 112, ¶6 to “control means”). Moreover, the requirement that the control assembles “operably interfac[e] with said elongated shaft assembly,” at most, suggests some form of interaction with another claimed “assembly”—not any meaningful structure. Vaitekunas Decl. ¶44; *see also Media Rights Techs.*, 800 F.3d at 1373-74; *Robert Bosch*, 769 F.3d at 1099-1100. And the remaining claim language— “to apply said [first/second] control motion thereto”—is purely functional, without any structural significance. Vaitekunas Decl. ¶44.

The claimed function of the “control assembly” is to apply control motions to the elongated shaft. Vaitekunas Decl. ¶45. The corresponding structure comprises articulation system 6140, including articulation control arrangement (aka ball joint assembly) 6160, articulation drive assembly 6170, horizontal gear arrangement 6180 and vertical gear arrangement 6190, of Figure 149. *Id.* ¶46; *see also* ’431 at 81:48–82:55. The first and second control motions are applied after the transmission arrangement selects a first or second position, and the articulation system 6140 manipulates, through a series of components, articulation cables that apply control motions through the elongated shaft. *See* Vaitekunas Decl. ¶46; ’431 at 81:48–83:45.

F. Power Patent terms

The final three patents at issue in this case are largely duplicative and raise the same issues of claim construction. U.S. Patent No. 8,998,058 and U.S. Patent No. 8,991,677 have identical claims and specifications. They also have substantively identical specifications to the U.S. Patent No. 9,084,601. All three patents have identical figures.

1. “housing”(’058 claims 6, 11; ’677 claims 6, 11; ’601 claim 1)

Intuitive Surgical	Ethicon
A structure that both covers and supports	Plain and ordinary meaning

In all three power patents, the term “housing” is generally used to describe a structure that covers and supports other structures. For example, the claim language in the ’058 and ’677 patents states that the stapling system is comprised of “a housing, wherein said staple cartridge carrier extends from said housing, and wherein said housing comprises a housing connector removably attachable to the surgical instrument system.” ’058, claims 6, 11; ’677, claims 6, 11. In the ’601 patent the term “housing” is described as a structure coupled to or supporting other structures: “a housing including at least one engagement member for removably coupling the housing to an actuator arrangement;” “first and second jaws operably coupled to the housing;” “a motor *supported* by said housing;” “a contact arrangement *supported* by said housing and configured to permit power to be supplied to the motor only when the housing is operably attached to the actuator arrangement.” ’601, claim 1.

Intuitive’s proposed construction is supported by the language in the specification. The housing is distinguished from the components that it covers, such as a motor or gear box. *See* ’058 at 11:59-61 (“[T]he housing 200 may further have a motor cavity 560 therein that houses a motor 562 and a gear box 564.”). The housing is also described as supporting other structures. *See* ’601 at 3:65-4:5 (“The surgical instrument further includes a disposable loading unit that has a housing that is coupled to the elongated shaft. A staple cartridge is *supported* by the housing assembly ... A motor is *supported* within the housing”). Intuitive’s construction is also supported by extrinsic evidence which defines “housing” as a structure which encloses, covers, protects, *and supports*. *See* Musinipally Decl., Exs. B and C.

Ethicon tries to avoid specific construction of this term, arguing that “housing” has a plain and ordinary meaning while declining to suggest what exactly that might be. Ethicon cannot sidestep construction in this fashion. The Federal Circuit has explained that a “determination that a claim term ‘needs no construction’ or has the ‘plain and ordinary meaning’ may be inadequate when a term has more than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.” *O2 Micro Int’l Ltd.*, 521 F.3d at 1361; *see also Eon Corp. IP Holdings v. Silver Spring Networks*, 815 F. 3d 1314, 1318 (Fed. Cir. 2016). In those circumstances, the “‘ordinary’ meaning of a term does not resolve the parties’ dispute, and claim construction requires the court to determine what claim scope is appropriate in the context of the patents-in-suit.” *O2 Micro Int’l Ltd.*, 521 F.3d at 1361.

Here, the parties dispute the scope of “housing” because Ethicon seeks to construe the term too broadly—to encompass *all* covering structures. Such a construction could include coverings that do not support anything, such as the insulation covering an electrical wire of the instrument. Ethicon’s proposed scope for the term’s plain and ordinary meaning is inconsistent with the intrinsic and extrinsic evidence that describes the housing as covering *and* supporting.

2. “housing connector” (’058 claim 6; ’677 claims 6, 17)

Intuitive Surgical	Ethicon
A portion of the housing that mounts it to another structure	Plain and ordinary meaning

The claim language requires that the housing connector (1) be part of the housing and (2) be removably attachable to a “surgical instrument system” (such as the “robotic system” or “robotic surgical system” discussed previously). *See* ’058, claim 6, ’677, claim 6 (“a housing, wherein said staple cartridge carrier extends from said housing, and wherein said housing comprises a housing connector removably attachable to the surgical instrument system” and “an electric motor operably

interfacing with said rotary shaft ... such that said electrical motor can only selectively receive power from said power source when said housing connector is attached to the surgical instrument.”).

Though the term “housing connector” does not appear in the specification, “this does not prevent the Court from using the specification to construe [the term] because the claims must be read in view of the specification[.]” *X One, Inc. v. Uber Techs., Inc.*, 2017 WL 3581184 at *5 (N.D. Cal. August 18, 2017). In the specification, the surgical instrument is described as being releasably coupled or attached to a tool “mounting” portion. ’058 at 17:2-4 (“The surgical tool 1200 is operably coupled to the manipulator by a tool mounting portion, generally designated as 1300.”); *id.* at 17:36-38 (“Other mechanisms/arrangements may be employed for releasably coupling the tool mounting portion 1300 to the adaptor 1240.”). The tool mounting portion is a portion of the housing. *Id.* at 17:32-35 (“Axial movement of the floating plate 1248 helps decouple the rotatable bodies 1250 from the tool mounting portion 1300 when the levers 1303 along the sides of the tool mounting portion housing 1301 are actuated (See FIG 17).”). Thus, Intuitive’s proposed construction that the housing connector is “a portion of the housing that mounts it to another structure” is consistent with the specification’s use of the analogous term “tool mounting portion.”

Ethicon proposes that the term be given its plain and ordinary meaning without specifying the structure to which the term refers. Here, the fact that the term “housing connector” is not defined in the specification and could refer to several structures in the patents-in-suit creates a dispute as to the meaning of the term. There are countless parts that “connect” to the housing. And Ethicon assumes that the “housing” is a clearly identifiable structure, despite the dispute above between the parties regarding its meaning. Adopting an unspecified plain and ordinary meaning of the term risks confusing a jury about whether or not there is infringement. When there is a dispute as to the meaning of a term, claim construction requires the court to determine what claim scope is

appropriate in the context of the patents-in-suit. *See O2 Micro*, 521 F.3d at 1361. Therefore, Ethicon’s proposed construction that “housing connector” be given its plain and ordinary meaning is insufficient.

3. “engagement member” (’601 claim 1)

Intuitive Surgical	Ethicon
A protrusion that prevents longitudinal movement	Plain and ordinary meaning

The term “engagement member” is used in the ’601 patent claims to describe a portion of the housing “for removably coupling the housing to an actuator arrangement.” ’601, claim 1. The only instance in the patent specification where the term “engagement member” is used is to describe the process of attaching, using protrusions (“nubs”), the disposable loading unit to the surgical tool. ’601 at 47:53-58 (“During rotation of loading unit 3612, nubs 3676 engage cam surface 37332 (FIG. 72) of block plate 3730 to initially move plate 3730 in the direction indicated by arrow ‘C’ in FIG. 72 to lock engagement member 3734 in recess 3721 of control rod 3720 to *prevent longitudinal movement* of control rod during attachment of disposable loading unit 3612.”)). Thus, Intuitive’s proposed construction that the engagement member serves to “prevent longitudinal movement” is supported by the specification. *See ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1375 (Fed. Cir. 2009) (“it is entirely proper to consider the functions of an invention in seeking to determine the meaning of particular claim language”)

Ethicon’s proposal that the term be given its plain and ordinary meaning is insufficient because the specification uses the term “engagement member” to describe a more specific structure than simply something that engages. Thus, Ethicon’s undefined plain and ordinary meaning for the term does not sufficiently narrow its meaning. A more specific construction grounded in the specification is required. *See Lexington Luminance LLC v. Amazon.com Inc.*,

601 F. App'x 963, 970 (Fed. Cir. 2015) (reversing construction based on dictionary definitions that was inconsistent with intrinsic record).

4. “actuator arrangement”('601 claim 1)

Intuitive Surgical	Ethicon
Indefinite	Plain and ordinary meaning or “a mechanical structure that enables movement of another mechanical structure”

The term “actuator arrangement” appears in claim 1 of the '601 Patent as follows: “A surgical cutting and stapling instrument comprising a housing including at least one engagement member for removably coupling the housing to an *actuator arrangement*; a contact arrangement supported by said housing and configured to permit power to be supplied to the motor only when the housing is operably attached to the actuator arrangement.” The term is not used in the specification.

Ethicon proposes that this term be given its plain and ordinary meaning or alternatively be construed as “a mechanical structure that enables movement of another mechanical structure.” But Ethicon’s construction does not address the actual dispute – namely, whether one skilled in the art would have been able to distinguish *which* structure in the '601 patent constitutes the “actuator arrangement.” “The claims, when read in light of the specification and the prosecution history, must provide objective boundaries for those of skill in the art.” *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014). “Otherwise, competitors cannot avoid infringement, defeating the public notice function of patent claims.” *Halliburton Energy Servs., Inc. v. M-ILLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008). Here, a person skilled in the art would not have been able to determine what portion of the invention disclosed in the '601 Patent is the “actuator arrangement.” See Vaitekunas Decl. ¶¶49-51.

Section 112(b) requires that a patent claim “particularly point[] out and distinctly claim[] the subject matter which the inventor regards as the invention.” 35 U.S.C. § 112(b). If it does not, the

claim is indefinite and therefore invalid. In particular, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus Inc. v. BioSig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014). Here, there are a variety of structures which connect to the housing and “actuate” another structure. *See, e.g.*, ’601 at 17:31-41. Indeed, unless a structure is entirely superfluous to the instrument’s mechanical operation, it may be described as “enabl[ing] movement of another mechanical structure.” Ethicon’s proposed construction does nothing to resolve the term’s ambiguity. The term and Ethicon’s proposed construction are so vague as to provide no meaningful guidance regarding the distinct structure described and, thus, the invention’s scope.

III. CONCLUSION

For the foregoing reasons, the Court should adopt Intuitive’s proposed constructions.

Respectfully submitted,

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