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Paper 23
Date: August 7, 2019

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 B2)
Case IPR2018-01254 (Patent 8,479,969 B2)[1]

Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD, and MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge.*

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

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[1] Because this Order addresses issues that are the same in both proceedings, we issue one Order to be entered in each proceeding. The parties are not authorized to use this caption unless later permitted.

On July 24, 2019, Patent Owner sent an email to the Board requesting authorization to file a motion to strike invalidity arguments in Petitioner's Replies in IPR2018-01247 and IPR2018-01254. Patent Owner indicates that Petitioner opposes Patent Owner's request. According to Patent Owner, Petitioner's Replies include arguments that were not disclosed in the Petitions.

Our Rules explain that "[a] reply may only respond to arguments raised in the corresponding . . . patent owner response." 37 C.F.R. § 42.23(b). Indeed, "[a] reply that raises a new issue or belatedly presents evidence will not be considered and may be returned." *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). For example, our Trial Practice Guide explains that "[e]xamples of indications that a new issue has been raised in a reply include new evidence necessary to make out a prima facie case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing." *Id*.

We decline, at this time, to grant Patent Owner's request to file motions to strike in these proceedings. Instead, on these facts, we determine that the following procedure serves the just, speedy, and inexpensive resolution of this issue. Patent Owner may file, in each proceeding, a paper titled "Patent Owner's List of Improper Reply Arguments," which shall include a numbered list of citations to those passages of the reply that Patent Owner believes exceed the scope of a proper reply.[2] This list must include page and line numbers, and may include

[2] For purposes of this Order, an improper argument is an argument made by Petitioner in its Reply where (1) it is beyond the scope of a reply under 37 C.F.R. § 42.23(b) or (2) if we were to rely on it in finding the challenged claims unpatentable, Patent Owner would not have had sufficient notice and opportunity to respond (*see, e.g.*, *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015)).

a brief (e.g., one sentence) explanation. The propriety or impropriety of the identified portions of the replies will be addressed, to the extent necessary, in a later Order or in our Final Written Decision. To the extent the panel determines that any item identified by Patent Owner warrants additional briefing, an additional Order will be issued, providing such instruction to the parties.

Furthermore, although at this time we do not deem it necessary to resolve this issue via formal briefing, should either party request a hearing, the parties may address this issue during oral argument if this issue is not resolved prior to oral argument.

Accordingly, it is:

ORDERED that Patent Owner is authorized to file, in each captioned proceeding, a List of Improper Reply Arguments, as outlined above;

FURTHER ORDERED that Patent Owner's List is to be filed no later than August 14, 2019; and

FURTHER ORDERED that the paper is to be no more than one page, excluding the cover page, signature block, and certificate of service.

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