

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  
U.S. Patent No. 8,479,969

---

**PETITIONER'S REQUEST FOR ORAL ARGUMENT AND  
REQUEST TO RESCHEDULE  
TO ALIGN WITH IPR2018-01248**

Pursuant to 37 C.F.R. § 42.70(a) and the Revised Scheduling Order (Paper 11), Petitioner submits this Request for Oral Argument on all of the instituted grounds of unpatentability of U.S. Patent No. 8,479,969. Requests for Oral Argument in related IPR proceedings (IPR2018-01248 and IPR2018-01254), each of which concerns the '969 Patent, are being filed on this same day.

At present, Oral Hearings for IPR2018-01247 and IPR2018-01254 are scheduled for September 18, 2019 (*See* PTAB's Revised Scheduling Orders of February 12, 2019 (Paper 11 in each proceeding)) and the Oral Hearing for IPR2018-01248 is scheduled for October 17, 2019 (*See* PTAB's Scheduling Order of February 7, 2019 (Paper 9 in that proceeding)).

Given the overlapping subject matter and the common patent, Petitioner requests that all three proceedings concerning the '969 Patent be consolidated and held on October 17, 2019.

Petitioner requests 75 minutes for each side to present arguments collectively for this proceeding and the two related proceedings.

With regard to this particular proceeding, Petitioner requests (without waiving consideration of any issue not listed below) to address the following issues:

1. Whether claim 24 is obvious over Anderson and Timm;

2. Whether claims 25 and 26 are obvious over Anderson, Timm, and Wallace;
3. Whether claims 19-20 are obvious over Anderson and Knodel;
4. Whether claims 21-22 are obvious over Anderson and Viola;
5. Rebuttal to Patent Owner's presentation on all matters; and
6. Any additional issues on which the Board seeks clarification.

Petitioner also respectfully requests the ability to use audio visual equipment to display demonstrative exhibits, including the use of a projector and screen that connects to a laptop computer. Petitioner's counsel will use a laptop computer with a VGA-type connector. In addition, Petitioner requests that an ELMO-type projector be made available for use.

Respectfully submitted,

Dated: August 23, 2019

/Steven R. Katz/  
Steven Katz, Reg. No. 43,706  
John C. Phillips, Reg. No. 35,322  
Ryan O'Connor, Reg. No. 60,254  
Fish & Richardson P.C.  
3200 RBC Plaza, 60 South Sixth Street  
Minneapolis, MN 55402  
T: 858-678-5070  
F: 877-769-7945

Attorneys for Petitioner

**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on August 23, 2019, a complete and entire copy of this Petitioner's Request for Oral Argument and Request to Reschedule to Align with IPR2018-01248 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](mailto:Ethicon.IPR.Service@weil.com)

/Diana Bradley/  
Diana Bradley  
Fish & Richardson P.C.  
3200 RBC Plaza  
60 South Sixth Street  
Minneapolis, MN 55402  
(858) 678-5667