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Paper 29
Date: September 4, 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 IPR2018-01248 (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 each of the proceedings, we issue one Order to be entered in each proceeding. The parties are not authorized to use this caption unless later permitted.

In an e-mail received Monday, August 26, 2019, Petitioner reasserted its request to consolidate hearings for IPR2018-01247, -01248, and -01254 on October 17, 2019. *Cf.* Paper 27 (IPR2018-01247); Paper 29 (IPR2018-01254). All three proceedings involve U.S. Patent No. 8,479,969 ("the '969 Patent"). In the email, Petitioner states that "[g]iven the overlapping issues, Petitioner submits consolidation of all three hearings into a single hearing would make the most sense and be both efficient and practical."

Patent Owner has not contacted the Board regarding Petitioner's e-mail. However, Petitioner's e-mail indicates that Patent Owner does not join Petitioner's request. At this time and based on Petitioner's e-mail, it appears that Patent Owner believes that the scheduling was "deliberate on the Board's part to hold the -01248 hearing separately." There was, however, no deliberate intent by the Board to bifurcate hearings for the proceedings involving the '969 Patent. Instead, the hearings were scheduled based solely on the different institution dates as a function of their respective filing dates.

After considering the parties' positions, we agree with Petitioner that given the overlapping subject matter it would "be both efficient and practical" to consolidate hearings for IPR2018-01247, -01248, and -01254 into a single hearing on October 17, 2019. This consolidation appears to be consistent with Patent Owner's Request for Oral Argument. *See* Paper 26 (IPR2018-01247); *see also* Paper 28 (IPR2018-01254). In its Request for Oral Argument, "Patent Owner requests that IPR2018-01247 and IPR2018-01254 be consolidated into a single hearing" and Patent Owner indicates that it would need "forty-five minutes of time to address the issues identified" in both IPR2018-01247 and IPR2018-01254. *See, e.g.*, Paper 26 (IPR2018-01247). Thus, we see no harm in consolidating all three

proceedings. However, if Patent Owner has good cause for opposing consolidation of the three identified proceedings, Patent Owner should contact the Board.

Accordingly, it is:

ORDERED that oral argument in each of IPR2018-01247, IPR2018-01248, and IPR2018-01254 be consolidated into a single hearing on October 17, 2019;

FURTHER ORDERED that Patent Owner is authorized to file, in each captioned proceeding, good cause for opposing consolidation of the three identified proceedings involving the '969 Patent;

FURTHER ORDERED that Patent Owner's response is to be filed no later than September 6, 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.

IPR2018-01247 (Patent 8,479,969 B2)
IPR2018-01248 (Patent 8,479,969 B2)
IPR2018-01254 (Patent 8,479,969 B2)

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