UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2018-01247
U.S. Patent No. 8,479,969

PATENT OWNER'S NOTICE OF SUPPLEMENTAL AUTHORITY

Patent Owner submits the following notice of supplemental authority in response to the Board's request at the oral hearing for authority that the Delaware District Court's order (Ex. 2013) constitutes a final judgment for collateral estoppel purposes. *See* Paper No. 37 at 33:1-18.

A. Supplemental Authority Regarding Finality

> We conclude that under Fourth Circuit law, collateral estoppel attaches in light of the JPMC court's partial summary judgment order [finding claims invalid under § 101]. … [F]inality neither demands final judgment, nor requires a party's appeal. … Because this particular issue has reached such a stage that the district court would see no really good reason for permitting it to be litigated again, the JPMC court's order meets the finality requirement under Fourth Circuit precedent.

Intellectual Ventures I LLC v. Capital One Fin. Corp., 850 F.3d 1332, 1337-38 (Fed. Cir. 2017) (quotations and citations omitted).

> [B]ecause the application of general collateral estoppel principles, such as finality of judgment, is not a matter within the exclusive jurisdiction of this court, we must apply the law of the circuit in which the district court here sits, *i.e.*, the Fourth Circuit.

Pharmacia & Upjohn Co. v. Mylan Pharm., Inc., 170 F.3d 1373, 1381 n.4 (Fed. Cir. 1999) (citing *Hartley v. Mentor Corp.*, 869 F.2d 1469, 1471 n.1 (Fed. Cir. 1989)).

B. Supplemental Authority Regarding Application of Issue Preclusion to the USPTO

> [T]he clear and convincing standard applicable under our precedent to other validity challenges should also apply to the present challenge to the validity of the certificate of correction.

Superior Fireplace Co. v. Majestic Prod. Co., 270 F.3d 1358, 1367 (Fed. Cir. 2001).

> The Examiner invokes issue preclusion to prevent re-litigating issues of written description already litigated in the district court cases. … [T]he party seeking to prove invalidity *succeeded* in meeting the higher standard of proof in district court, which typically means the same evidence should also meet the lower standard in the PTO. … Because we hold that issue preclusion prevents Appellant from re-litigating issues of written description, we need not reach the merits of the Examiner's written description rejection. To do otherwise would moot the benefits of judicial economy that issue preclusion is intended to promote.

Ex Parte Ditzik, No. 14/169,232, 2018 WL 3409672, at *3-4, *9 (P.T.A.B. July 10, 2018) (designated informative) (emphasis in original) (citing *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1298-99 (2015)[1]).

[1] *B & B Hardware*, 135 S. Ct. at 1303 ("The Court … regularly turns to the Restatement (Second) of Judgments for a statement of the ordinary elements of issue preclusion."); *Restatement (Second) of Judgments* § 13 (1982) ("[F]or purposes of issue preclusion (as distinguished from merger and bar), 'final judgment' includes any prior adjudication of an issue in another action that is determined to be sufficiently firm to be accorded conclusive effect.").

Dated: November 21, 2019

Respectfully submitted,

/Anish R. Desai/

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CERTIFICATE OF SERVICE

I hereby certify that on November 21, 2019, a copy of **PATENT OWNER'S NOTICE OF SUPPLEMENTAL AUTHORITY** was served by filing this document through the PTAB's E2E Filing System as well as delivering a copy via electronic mail upon the following:

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