

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

PETITIONER'S NOTICE OF SUPPLEMENTAL AUTHORITY

Petitioner submits the following notice of supplemental authority in response to the Board's request for authority that the Delaware District Court's order (Ex. 2013) constitutes a final judgment for collateral estoppel purposes.

A. Collateral estoppel

[J]udicial statements regarding the scope of patent claims are entitled to collateral estoppel effect in a subsequent infringement suit only to the extent that determination of scope was essential to a final judgment on the question of validity or infringement

A.B. Dick Co. v. Burroughs Corp., 713 F. 2d 700, 704 (Fed. Cir. 1983) *cert. denied*, 464 U.S. 1042 (1984).

The Court agrees . . . that the CashEdge Court's claim construction order is not a "final judgment" for collateral estoppel purposes.

Yodlee, Inc. v. Plaid Techs., Inc., No. 14-1445-LPS, 2016 WL 204372, at *3 (D. Del. Jan. 15, 2016).

Dated: November 26, 2019

Respectfully submitted,

/Steven R. Katz/

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Fish & Richardson P.C.

Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on November 26, 2019, a complete and entire copy of this Petitioner's Notice of Supplemental Authority was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

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