

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON ENDO-SURGERY, INC.,
Patent Owner.

Case IPR2018-00938
Patent 9,113,874 B2

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

MEYERS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. BACKGROUND

Intuitive Surgical, Inc., (“Petitioner”) filed a Petition for *inter partes* review of claims 1–21 of U.S. Patent No. 9,113,874 B2 (Ex. 1001, “the ’874 patent”).¹ Paper 2 (“Pet.”). Ethicon Endo-Surgery, Inc., (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). On December 4, 2018, we entered a Decision Denying Institution of *Inter Partes* Review. Paper 8, (“Decision” or “Dec.”).

On December 20, 2018, Petitioner filed a Request for Rehearing of our Decision denying institution of *inter partes* review of claims 1–15 and 18–20 of the ’874 patent.² Paper 9 (“Req. Reh’g.”).

With respect to Grounds 1–4, Petitioner contends that we erred by misapprehending the disclosure of Hooven because we “overlooked th[e] part of Hooven which discloses that the closing motion may be applied independently of the firing motion,” and thus, erroneously concluded that “the two motions cannot be the ‘same’ motion.” Req. Reh’g. 1; *see also id.* at 2–7. Accordingly, Petitioner requests the Board reconsider its findings

¹ As discussed in the Decision, claims 16, 17, and 21 are disclaimed via statutory disclaimer, filed September 5, 2018, under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). *See* Dec. 2, FN 1 (citing Ex. 2002). Accordingly, only claims 1–15 and 18–20 were addressed in the Decision. *See* 37 C.F.R. § 42.107(e).

² Petitioner’s Request “specifically addresses the error for Ground 1 in Section I (relevant to all claims) and the errors for Ground 4 in Section V (claims 1–8, and 19).” Req. Reh’g. 10.

regarding Hooven with respect to Ground 1³, as well as Grounds 2–4,⁴ and institute trial on all grounds of the Petition. *See id.* at 10.

With respect to Ground 4, Petitioner contends that “the Board misapprehended or overlooked the import of Dr. Knodel’s discussion in support” of its assertion that “it would have been obvious to replace Hooven’s flexible shaft with a stiff shaft and articulation joint,” as taught by Wales. *Id.* at 11–13. Accordingly, Petitioner requests the Board reconsider its decision, with respect to Ground 4, and institute trial on all grounds of the Petition. *Id.* at 10.

For the reasons discussed below, Petitioner has not demonstrated that we abused our discretion in denying institution.

II. ANALYSIS

A. *Standard of Review*

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing

³ In the Petition, Petitioner asserts the claims 1–7, 9–14, 19, and 20 are anticipated by Hooven. Pet. 13–50 (citing Exs. 1001, 1003, 1004).

⁴ In the Petition, Petitioner further asserts that claims 2–4, 9–15, and 18 are obvious over Hooven and Knodel (Ground 2 – Pet. 51–67 (citing Exs. 1001, 1003, 1004, 1005)); claim 8 is obvious over Hooven and Bays (Ground 3 – Pet. 67–70 (citing Exs. 1003, 1006)); and claims 1–8 and 19 are obvious over Hooven, Knodel and/or Bays, and Wales (Ground 4 – Pet. 70–73 (citing Exs. 1003, 1007)).

relevant factors. *See Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d). “The burden of showing a decision should be modified lies with the party challenging the decision.” *Id.*

B. Analysis

Alleged Misapprehension/Overlooking of Evidence Regarding Hooven

Petitioner argues that “[t]he Board overlooked [a] part of Hooven which discloses that the closing motion may be applied independently of the firing motion, and thus the two motions cannot be the ‘same’ motion, as the Board found.” Req. Reh’g. 1. More particularly, Petitioner asserts that the Board overlooked column 5, lines 50–65 of Hooven which discloses:

Tissue to be treated or manipulated is placed between the anvil portion and the staple portion of the head of the instrument when in the open position. Power is applied to the flexible shaft to rotate the shaft and the threaded rod and close the anvil portion. As can be appreciated, the amount of torque required to pivot the anvil portion about the pivot pin can be sensed and the thickness of tissue between the anvil and the staple portion determined. **It is a simple matter for a controller to manipulate this information and inform the surgeon as to whether or not he has the appropriate amount of tissue between the anvil portion and the staple portion of the head of the instrument upon closure or whether he has too much or too little tissue and should re-manipulate the instrument.**

Req. Reh’g. 4 (citing Ex. 1004, 5:50–65). Based on this emphasized portion, Petitioner contends that “Hooven clearly teaches the ability to close and open the anvil without firing the device.” Req. Reh’g. 3.

As an initial matter, we are not persuaded by Petitioner’s contention that we misapprehended or overlooked the emphasized portion of Hooven (Ex. 1004, 5:59–65), because Petitioner did not rely on the emphasized portion of Hooven to address the “closing motion” and “firing motion” in the Petition.⁵ Instead, to address the “closing motion” recited by independent claim 20 in the Petition, Petitioner relied on column 5, lines 40–55 and column 6, lines 40–44 of Hooven. Pet. 18.⁶ To address the “firing motion,” Petitioner relied on column 6, lines 30–34, while explicitly stating that it is “[t]he rotations of the threaded rod 71 are the firing motions.” Pet. 20.⁷ And, consistent with this understanding, our Decision summarized Petitioner’s mapping of the disputed terms as follows:

With respect to the “closing motion,” Petitioner asserts that “[t]he proximal and distal motions of closure pin 78 are opening and closing motions, respectively, to move the jaws between open and closed positions.” Pet. 18–19 (citing Ex. 1003 ¶ 42). And, with respect to the “firing motion,” Petitioner asserts that “[t]he smaller diameter portion 73 of Hooven’s ‘threaded rod 71’ is a motor powered firing element that is configured to apply firing motions to the knife via the drive nut.” Pet. 20 (citing Ex. 1003 ¶¶ 45–47; Ex. 1004, Fig. 7; Ex. 1001; Fig. 3, element 36).

Dec. 16. Based on this mapping, the Decision noted that:

⁵ We acknowledge Petitioner’s points to column 5, lines 40–55 to address the “closing motion” of independent claim 20. Pet. 18. However, Petitioner did not rely on the remaining, and newly cited lines 56–65 of column 5 to address independent claims 9 and 20.

⁶ With respect to independent claim 9, Petitioner relies on the same portions of Hooven. See Pet. 25–26.

⁷ With respect to independent claim 9, Petitioner relies on the same portions of Hooven. See Pet. 26.

Hooven discloses “[w]hen the flexible shaft is rotated, the threaded rod is also rotated and on rotating the closure nut will move down the threaded rod and move the closure pin in the closure slot to close the anvil portion against the staple portion of the head of the instrument.”

Id. at 17 (quoting Ex. 1004, 5:46–50 (alteration in original)), and determined that “both of the ‘motions,’ relied upon to address the ‘closing motion’ and ‘firing motion’ in the Petition depend on the same motion, i.e., the rotation of the threaded rod.” Dec. 16–17 (citing Prelim. Resp. 25–26).

Nonetheless, we have reconsidered our determination in light of the disclosure at column 5, lines 50–65 of Hooven, but are not persuaded that the newly relied upon portion of Hooven alters our determination. Although we agree with Petitioner that the emphasized portion of Hooven (Ex. 1004, 5:59–65) establishes that a surgeon may “re-manipulate the instrument” (open/close the jaws) based upon whether or not the appropriate amount of tissue is present between the anvil portion (i.e., first jaw) and the staple portion (i.e., second jaw), this disclosure does change the fact that it is the motion of the threaded rod that is responsible for both the “closing motion” and “firing motion” required by independent claim 20, and similarly required by independent claim 9. *See* Dec. 16–19.

As we stated in the Decision, with respect to the “closing motion,”

Hooven discloses “[w]hen the flexible shaft is rotated, the threaded rod is also rotated and on rotating the closure nut will move down the threaded rod and move the closure pin in the closure slot to close the anvil portion against the staple portion of the head of the instrument.”

Id. at 16 (quoting Ex. 1004 5:46–50).⁸ Thus, Hooven discloses that rotation of the threaded rod causes the closure pin to close the anvil portion (i.e., first jaw). And, with respect to the “firing motion,” we stated:

[w]hen the anvil portion **75** is closed as shown in FIG. 7, the closure nut **77** moves a stop member **85** forward so that the firing nut **86** on which the knife **82** and wedges **83** are disposed is moved forward and engages the threads of the smaller diameter portion **73** of the threaded rod to move forward along the rod and drive the staples **81** and cut tissue.

Id. (quoting Ex. 1004, 6:28–34 (alteration in original)). Here, Hooven similarly discloses that it is the smaller diameter portion of the threaded rod that drives the staple portion (i.e., second jaw). *See* Ex. 1004, 6:28–34; *Accord* Pet. 20 (stating “[t]he rotations of the threaded rod 71 are the firing motions.”); Pet. 25–26.

Petitioner contends that the “closing motion” and “firing motion” in Hooven cannot be the same motion because “Hooven clearly teaches the ability to close and open the anvil without firing the device.” Req. Reh’g. 3 (citing Ex. 1004, 5:50–65). The fact that Hooven’s anvil is able to close and open, however, is unpersuasive to show error in our determination. In this regard, Hooven discloses that “[p]ower is applied to the flexible shaft to rotate the shaft and the threaded rod and close the anvil portion.” Ex. 1004, 5:53–55. Hooven discloses that rotation of the threaded rod is controlled by “a suitable on-off switch **48** and a switch **49** to control the power supply

⁸ The fact that independent claim 9 additionally recites a “reciprocable closure element configured to apply said opening and closing motions to said one of said first and second jaws” (Ex. 1001, 32:53–55) does not alter our determination. In this regard, we note that the “reciprocable closure element” is simply configured to *apply* the “opening and closing motions.”

being provided by the motor.” Ex. 1004, 4:60–63. A PHOSITA would appreciate that simply reversing the rotation of the shaft would cause the anvil to open and allow the surgeon to “re-manipulate the instrument.” Thus, we maintain that “both of the ‘motions,’ relied upon to address the ‘closing motion’ and ‘firing motion’ in the Petition depend on the same motion, i.e., the rotation of the threaded rod.” Dec. 16–17 (citing Prelim. Resp. 25–26).⁹

Petitioner attributes the purported “misapprehension concerning Hooven occurred because Patent Owner argued that Hooven failed to disclose this ability to close without firing, implying that Hooven closes and then fires as part of the same ‘motion’.” Req. Reh’g. 2. We are not persuaded by Petitioner’s argument. While certainly informed by Patent Owner’s arguments, the Decision did not misapprehend the contents of Hooven based on Patent Owner’s argument. Instead, the Decision only relies on Hooven and the ’874 patent for the relevant findings. See Dec. 10–19.

⁹ Petitioner directs our attention to U.S. Application Serial No. 16/023,523 related to the ’874 patent, and asserts “that after the Petition was filed, the Examiner read Hooven as Petitioner does here—that Hooven discloses ‘separate and distinct’ closing and firing motions.” Req. Reh’g. 7, fn. 1. After reviewing the prosecution for the related application, we note that Petitioner’s assertion no longer holds true. Petitioner is correct that the Examiner did initially find Hooven to disclose “‘separate and distinct’ closing and firing motions” (see Non-Final Action, mailed Aug. 24, 2018), however, in response to Applicant’s argument that Hooven “fails to provide a mechanism for performing a closure motion separately and [sic] from a firing motion (see Applicant’s Arguments at 9, filed Nov. 26, 2018), the Examiner no longer relied on Hooven to address “‘separate and distinct’ closing and firing motions.” See Final Action at 2–11, mailed Mar. 28, 2019.

Alleged Misconstruction of the Terms “Closing Motion” and “Firing Motion”

Petitioner argues that “[t]he Board [c]onstrued the ‘[c]losing [m]otion’ and ‘[f]iring [m]otion’ [t]erms [t]oo [n]arrowly.” Req. Reh’g. 8 (emphases omitted). In its Request, Petitioner asserts that “[t]he threaded rod may be a ‘firing element’ and may also provide rotary motion to the ‘closure element.’” *Id.* at 9. However, Petitioner points to no evidence relied on in its Petition in that regard, and also does not indicate where in its Petition it initially made this claim construction argument. Per 37 C.F.R. § 42.71(d), Petitioner must point out where the matter previously was addressed in its Petition. We could not have misapprehended argument or evidence that was not presented. A request for rehearing is not an opportunity to supplement a petition.

Alleged Misapprehension/Overlooking of Evidence Regarding Dr. Knodel’s Declaration

Petitioner contends that “the Board misapprehended or overlooked the import of Dr. Knodel’s discussion in support” of its assertion that “it would have been obvious to replace Hooven’s flexible shaft with a stiff shaft and articulation joint,” as taught by Wales. Req. Reh’g. 11.

We are unpersuaded that we misapprehended or overlooked Petitioner’s position or cited evidence. Petitioner cites pages 70–73 of the Petition, and paragraphs 166–170 of Dr. Knodel’s Declaration, in its Request. Req. Reh’g. 11–13. At the outset, we note that our Decision expressly addressed Petitioner’s arguments and evidence along with “Dr. Knodel’s discussion in support.” *See* Dec. 31–39. Furthermore, as Patent Owner points out in its Preliminary Response, Dr. Knodel’s Declaration simply parrots Petitioner’s arguments and provides little if any analysis of

the evidence that he and Petitioner cite in support. *See* Prelim. Resp. 35–37; *Compare* Ex. 1003 ¶¶ 166–170, with Petition at 70–73.

Nonetheless, we have reconsidered our determination in light of Petitioner’s Request for Rehearing, but are not persuaded that that we misapprehended or overlooked Petitioner’s position or cited evidence. Instead, we maintain that the Petition and Dr. Knodel’s Declaration lack

a discussion as to whether the proposed combination modifies Hooven’s flexible-elongated shaft 41 to utilize Wales’ rigid-elongated second/third links, in conjunction with its fourth link in the form of the end effector (*see* Ex. 1007, 5:11–18, 29–33), or if the proposed combination simply modifies Hooven’s flexible-elongated shaft 41 by adding an “articulation joint.” *Cf.* Pet. 71 (citing Figs. 1, 4). And, while the Petition and Dr. Knodel assert that the proposed combination is simply the use of “a known technique to improve similar devices” and “would have yielded predictable results without significantly altering or hindering the functions performed by Hooven’s device” (Pet. 72–73 (citing Ex. 1003 ¶¶ 168–170)), neither Petitioner nor Dr. Knodel provides any persuasive analysis, fact-based or otherwise to establish how the proposed combination discloses or suggests the “articulation joint” recited in independent claims 1 and 19.

Dec. 38–39.

Disagreement with the Board’s analysis and conclusions is not a sufficient basis on which to request rehearing. It is not an abuse of discretion to have made an analysis or conclusion with which a party disagrees. Accordingly, the Decision did not misapprehend or overlook any arguments or evidence presented by Petitioner. We did not abuse our discretion in determining that the Petitioner did not adequately establish a reasonable likelihood of prevailing on the proposed combination of Hooven, Wales, Knodel, and/or Bays.

III. CONCLUSION

We are not persuaded by Petitioner of an abuse of discretion.
Petitioner's request for rehearing is denied.

IV. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that Petitioner's Request for Rehearing is *denied*.

IPR2018-00938
Patent 9,113,874 B2

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