

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Intuitive Surgical, Inc.,
Petitioner,

v.

Ethicon LLC,
Patent Owner.

Case IPR2018-00934
Patent 8,998,058

PETITIONER'S NOTICE OF APPEAL

Pursuant to 35 U.S.C. §§ 142 and 37 C.F.R. § 90.2(a), Petitioner Intuitive Surgical, Inc. hereby appeals to the United States Court of Appeals for the Federal Circuit from the Patent Trial and Appeal Board's ("Board") Final Written Decision entered on December 4, 2019 (Paper 34), and from all other underlying orders, decisions, rulings and opinions that are adverse to Petitioner, including, without limitation, those within the Decision on Institution of *Inter Partes* Review entered on December 7, 2018 (Paper 9).

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Petitioner indicates that the issues on appeal include, but are not limited to, the following:

- (1) whether the Board erred in finding that Patent Owner's Contingent Motion to Amend satisfied the requirements of 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121;
- (2) whether Board erred in finding that Petitioner failed to meet its burden to establish that substitute claims 19-22 and 24-27 were unpatentable under 35 U.S.C. § 103 over Viola (Ex. 1031) in view of Heinrich (Ex. 1005);
- (3) whether the Board erred in finding that Petitioner failed to meet its burden to establish that substitute claims 23 and 28 were unpatentable under 35 U.S.C. § 103 over Viola (Ex. 1031) in view of Heinrich (Ex. 1005), and further in view of Young (Ex. 1032);
- (4) the Board's claim constructions or failure to construe any terms; and

(5) any findings or determinations supporting or related to the
aforementioned issues as well as other issues decided adversely to
Petitioner in any orders, decisions, rulings, or opinions.

Simultaneous with this submission, a copy of the Notice of Appeal is being
filed electronically with the Patent Trial and Appeal Board. In addition, a copy of
this Notice of Appeal, along with the required docketing fees, are being
electronically filed with the Clerk's Office for the United States Court of Appeals
for the Federal Circuit.

Respectfully submitted,

Date: February 3, 2020

/John C. Phillips/
John C. Phillips
Reg. No. 35,322
Attorney for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4), the undersigned certifies that on February 3, 2020, a complete and entire copy of this Petitioner's Notice of Appeal was provided via email to the Patent Owner by serving the correspondence email addresses of record as follows:

Anish R. Desai
Elizabeth Stotland Weiswasser
Robert S. Magee
Adrian Percer
Christopher T. Marando
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Weil, Gotshal & Manges LLP
767 Fifth Avenue
New York, NY 10153

Email: Ethicon.IPR.Service@weil.com

I hereby certify that, in addition to being filed electronically through the Board's E2E System, the original version of the foregoing Notice of Appeal, was filed by hand on February 3, 2020, with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
Madison Building East, 1 OB20
600 Dulany Street
Alexandria, VA 22314-5793

I hereby certify that on February 3, 2020, a true and correct copy of the foregoing Notice of Appeal, along with a copy of the Final Written Decision, was filed electronically with the Clerk's Office of the United States Court of Appeals for the Federal Circuit, at the following address:

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