

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.

Petitioner

v.

ETHICON LLC

Patent Owner

Case IPR2018-01248

Patent 8,479,969

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 February 6, 2020 (Paper 34), and from all other underlying orders, decisions, rulings and opinions that are adverse to Petitioner.

This appeal is related to two other appeals being filed at the same time from the following related proceedings concerning the same patent: IPR2018-01247 and IPR2018-01254.

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 that estoppel applies under 35 U.S.C. § 315(e)(1), and whether the Board erred by concluding that "we [the Board] must terminate Petitioner from the proceeding."
- (2) Whether the Board erred in finding that Petitioner failed to meet its burden to establish that claims 24-26 were unpatentable under 35 U.S.C. § 102 or 35 U.S.C. § 103 over Prisco;
- (3) Whether the Board erred in finding that Petitioner failed to meet its burden to establish that claims 24-26 were unpatentable under 35 U.S.C. § 103 over Prisco and Cooper;

- (4) Whether the Board erred in finding that Petitioner failed to meet its burden to establish that claims 24-26 were unpatentable under 35 U.S.C. § 103 over Prisco, Cooper and Tierney;
- (5) Whether the Board erred in finding that Petitioner failed to meet its burden to establish that claims 25-26 were unpatentable under 35 U.S.C. § 103 over Prisco, Cooper, Wallace and Tierney;
- (6) The Board's claim constructions or failure to construe any terms; and
- (7) 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 14, 2020

/Steven R. Katz/

Steven R. Katz, Reg. No. 43,706
Attorney for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4), the undersigned certifies that on February 14, 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
Adrian Percer
Christopher T. Marando
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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 14, 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 14, 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:

United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W., Suite 401
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/Steven R. Katz/

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