

PUBLIC VERSION

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2018-00936
U.S. Patent No. 9,585,658

**PATENT OWNER ETHICON LLC'S
NOTICE OF APPEAL UNDER 37 C.F.R. § 90.2(a)**

PUBLIC VERSION

Pursuant to 35 U.S.C. §§ 141-144, 319 and 37 C.F.R § 90.2(a), notice is hereby given that Patent Owner Ethicon LLC (“Ethicon”) appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision (Paper No. 55) (the “Final Written Decision”), in IPR2018-00936, entered on January 13, 2020, by the United States Patent and Trademark Office, Patent Trial and Appeal Board (the “Board”), and from all orders, decisions, rulings, and opinions antecedent to the Final Written Decision. A copy of the Final Written Decision is attached hereto as Exhibit A.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Ethicon further indicates that the issues on appeal may include, but are not limited to, the Board’s determination that claims 1-14 of U.S. Patent No. 9,585,658 have been shown to be unpatentable under 35 U.S.C. § 102 in view of the grounds of unpatentability identified in the Board’s Final Written Decision, the Board’s decision to deny Ethicon’s motion to amend claims 1-14, challenges to any findings supporting those determinations, the Board’s failure to properly consider evidence of record, the Board’s legal errors in undertaking the anticipation analysis or the analysis related to the motion to amend, the Board’s failure to consider Ethicon’s arguments in support of patentability, the Board’s findings that conflict with the evidence of record and are not supported by substantial evidence, and other issues decided adversely to

PUBLIC VERSION

Ethicon.

Simultaneous with this submission, a copy of this Notice of Appeal is being filed through the Patent Trial and Appeal Board End to End (“PTAB E2E”) System. In addition, a copy of the Notice of Appeal, along with the required docketing fee, is being filed with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit.

PUBLIC VERSION

Date: March 16, 2020

Respectfully submitted,

/Anish R. Desai/

Anish R. Desai (Reg. No. 73,760)

Weil, Gotshal & Manges LLP

767 Fifth Avenue

New York, NY 10153

212-310-8730

anish.desai@weil.com

Counsel for Patent Owner Ethicon LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, in addition to being filed electronically through the PTAB E2E System, the original version of **PATENT OWNER ETHICON LLC'S NOTICE OF APPEAL UNDER 37 C.F.R. § 90.2(a)** has been sent via Federal Express on March 16, 2020, to 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
United States Patent and Trademark Office
Madison Building East, Room 10B20
600 Dulany Street
Alexandria, VA 22314-5793

The undersigned also certifies that a true and correct copy of **PATENT OWNER'S NOTICE OF APPEAL UNDER 37 C.F.R. § 90.2(a)** and required filing fee were filed electronically via CM/ECF on March 16, 2020, with the Clerk of Court for the United States Court of Appeals for the Federal Circuit.

The undersigned also certifies that a true and correct copy of **PATENT OWNER ETHICON LLC'S NOTICE OF APPEAL UNDER 37 C.F.R. § 90.2(a)** was served on March 16, 2020, via electronic mail, upon the following:

Steven R. Katz
John C. Phillips
Ryan P. O'Connor
Grant Rice
FISH & RICHARDSON
3200 RBC Plaza,
60 South Sixth Street
Minneapolis, MN 55402
katz@fr.com
phillips@fr.com
oconnor@fr.com
rice@fr.com

IPR11030-0049IP4@fr.com
PTABInbound@fr.com

/Kathy Shalabi/

Kathy Shalabi
IP Paralegal
Weil, Gotshal & Manges LLP
2001 M Street, N.W., Suite 600
Washington, DC 20036
202-682-7085
kathy.shalabi@weil.com

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON, LLC,
Patent Owner.

IPR2018-00936
Patent 9,585,658 B2

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

COCKS, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining All Challenged Claims Unpatentable

Denying Patent Owner's Motion to Amend

Dismissing Petitioner's Motion to Exclude

35 U.S.C. § 318(a)

I. INTRODUCTION

A. Summary

Intuitive Surgical, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–14 (the “challenged claims”) of U.S. Patent No. 9,585,658 B2 (Ex. 1001, “the ’658 patent”). Ethicon LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition. We instituted trial to determine whether the challenged claims were unpatentable as follows:

Claims Challenged	35 U.S.C. §	References
1–14	102	Wales ¹
3, 8	103	Wales, Knodel ²
1–14	103	Wales, Tierney ³
3, 8	103	Wales, Tierney, Knodel

See Paper 9 (“Decision on Institution” or “Dec. on Inst.”).⁴

Patent Owner filed a Patent Owner Response. Paper 16 (“PO Resp.”). Patent Owner also filed a “Contingent Motion to Amend Under 37 C.F.R. § 42.121.” Paper 15 (“Mot. to Amend”). Petitioner filed a Reply to Patent Owner’s Response. Paper 19 (“Pet. Reply”). Petitioner also filed a

¹ U.S. Patent No. 6,981,628 B2 issued January 3, 2006 to Wales (Ex. 1004, “Wales”).

² U.S. Patent No. 5,465,895 issued November 14, 1995 to Knodel et al. (Ex. 1005, “Knodel”).

³ U.S. Patent Application Publication No. US 2003/0083673 A1 published May 1, 2003 to Tierney et al. (Ex. 1006, “Tierney”).

⁴ A listing of proposed substitute claims 15–28 appears in Appendix A of Paper 15.

“Corrected Opposition to Patent Owner’s Contingent Motion to Amend.” Paper 21 (“Pet. Opp.”). Patent Owner filed a Sur-Reply to Petitioner’s Reply to Patent Owner’s Response. Papers 29, 30 (“PO Sur-Reply”).⁵ Patent Owner also filed a “Reply in Support of its Contingent Motion to Amend.” Papers 31, 32 (“PO Reply Mot. to Amend”).⁶ Petitioner filed a Sur-Sur-Reply to Patent Owner’s Sur-Reply. Paper 37 (“Pet. Sur-Sur-Reply”). Petitioner further filed a Sur-Reply to Patent Owner’s Reply to Patent Owner’s Motion to Amend. Papers 38, 39 (“Pet. Sur-Reply Mot. to Amend”).⁷ Petitioner additionally filed a Motion Exclude. Paper 40. Patent Owner filed an Opposition to Petitioner’s Motion to Exclude. Papers 42, 43.⁸ Petitioner filed a Reply in support of its Motion to Exclude. Paper 48.⁹

Oral argument was held on September 18, 2019, and a transcript of the hearing is included in the record. Paper 54 (“Tr.”).

⁵ Paper 29 is a public, redacted version of Patent Owner’s Sur-Reply and Paper 30 is a confidential version.

⁶ Paper 31 is a public, redacted version of Patent Owner’s Reply in Support of its Motion to Amend. Paper 32 is a confidential version.

⁷ Paper 38 is a confidential version of Petitioner’s Sur-Reply to Patent Owner’s Reply to Patent Owner’s Motion to amend and Paper 39 is a public, redacted version.

⁸ Paper 42 is a public, redacted version of Patent Owner’s Opposition to Petitioner’s Motion to Exclude and Paper 43 is a confidential version.

⁹ Both parties also seek to have portions of the record maintained under seal. Patent Owner filed three Motions to Seal seeking to have sealed portions of various exhibits, its Sur-Reply to Petitioner’s Reply to Patent Owner’s Response, and Patent Owner’s Opposition to Petitioner’s Motion to Exclude. Papers 28, 41, 53. Petitioner filed two Motions to Seal seeking to have sealed its Reply Brief in support of its Motion to Exclude, Exhibit 1021, and its Motion for Observations (Paper 51). Papers 49, 50. Those Motions to Seal will be decided in due course via a separate Order or Orders.

We have jurisdiction under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This decision is a Final Written Decision under 35 U.S.C. § 318(a). For the reasons discussed below, we hold that Petitioner has demonstrated by a preponderance of the evidence that claims 1–14 of the '658 patent are unpatentable. We also deny Patent Owner's Contingent Motion to Amend seeking to substitute claims 15–28 for claims 1–14 in the '658 patent. We further dismiss Petitioner's Motion to Exclude.

A. The '658 Patent

The '658 patent is titled “Stapling Systems,” and relates “to surgical staplers having an end effector closing system and a firing system deploying staples.” Ex. 1001, code (54); 1:50–53. The '658 patent describes that its stapling system comprises:

a housing comprising a rotary drive member, an elongate shaft extending from the housing, wherein the elongate shaft defines a longitudinal axis, and an end effector comprising a jaw configured to support a staple cartridge and an anvil rotatable relative to the jaw between an open position and a fully-closed position, wherein the anvil comprises a cam surface.

Id. at code (57).

Figure 1 of the '658 patent is reproduced below:

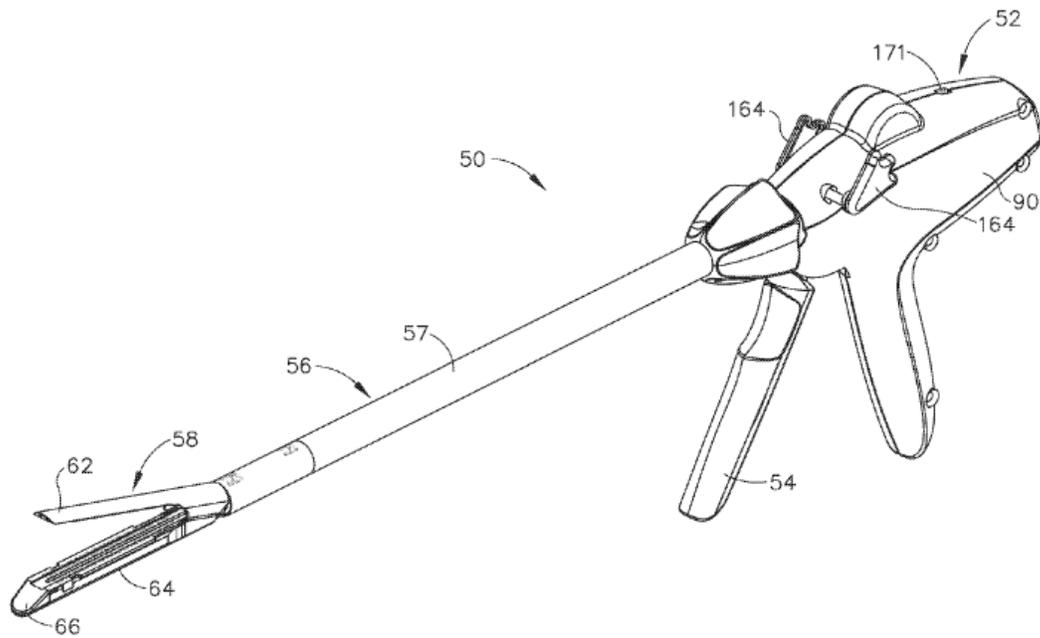


FIG. 1

Figure 1 shows “a perspective view of a surgical instrument in accordance with an embodiment of the present invention.” *Id.* at 3:36–37. As shown in Figure 1, surgical instrument 50 includes handle portion 52, trigger 54, elongate shaft assembly 56, and end-effector 58. *Id.* at 11:52–54. End effector 68 includes anvil 62 and staple cartridge channel 64. *Id.* at 11:54–55. Figure 38 is reproduced below.

Figure 43 “is a partial bottom perspective figure of the surgical tool embodiment of FIG. 38.” *Id.* at 5:24–25. Tool mounting portion 1300 includes tool drive assembly 1010 (not numbered in Figure 43) with rotatable bodies 1250 and driven elements 1304. *Id.* at 28:26–51. Figure 44 is reproduced below.

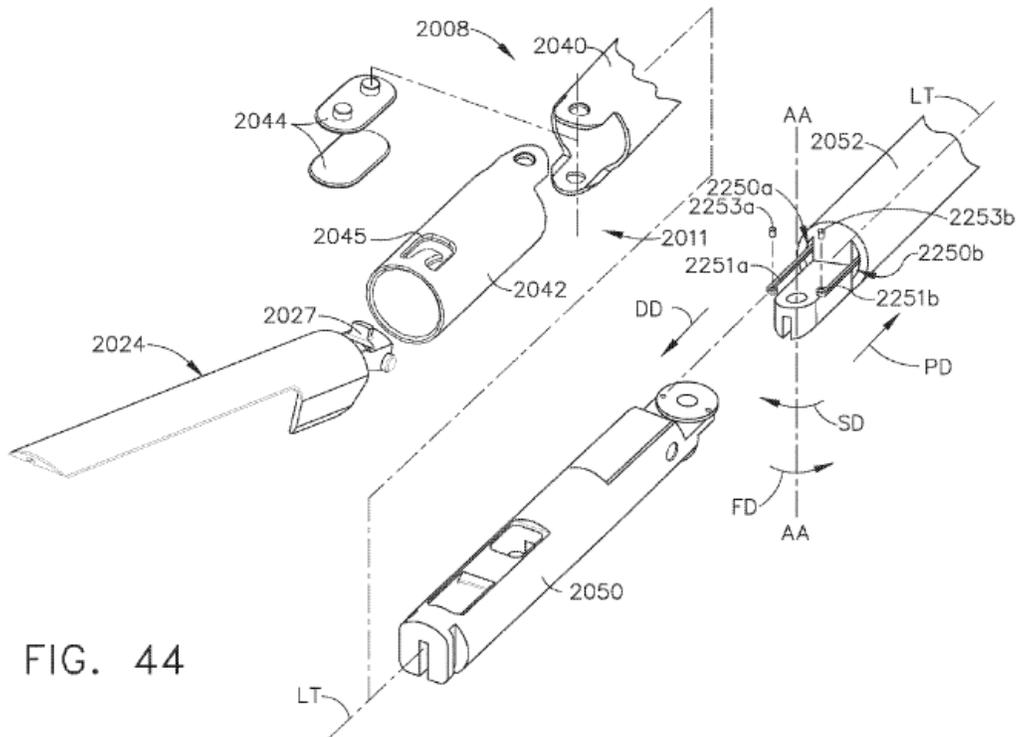


Figure 44 “is a partial exploded view of a portion of an articulatable surgical end effector embodiment of the present invention.” *Id.* at 5:26–28. As shown in Figure 44, anvil 2024 includes tab 2027 that engages closure tube 2042 via opening 2045. *Id.* at 30:46–67.

B. Illustrative Claims

Challenged claims 1, 6, 11, and 14 are independent. Claims 2–5 ultimately depend from claim 1, claims 7–10 ultimately depend from claim

6, and claims 12 and 13 depend from claim 11. Claim 1 illustrative and is reproduced below:

1. A stapling system, comprising:
 - a housing comprising a rotary drive member;
 - an elongate shaft extending from said housing, wherein said elongate shaft defines a longitudinal axis;
 - an end effector, comprising:
 - a jaw configured to support a staple cartridge; and
 - an anvil rotatable relative to said jaw between an open position and a fully-closed position, wherein said anvil comprises a cam surface;
 - a closure cam operably coupled with said rotary drive member, wherein said closure cam is configured to move longitudinally to engage said cam surface and transmit a closing motion to said anvil to move said anvil into said fully-closed position; and
 - an opening member configured to move longitudinally to apply an opening force to said anvil at a location other than said cam surface to move said anvil into said open position.

Ex. 1001, 92:54–93:4.

C. Real Parties in Interest

Petitioner identifies itself as the only real party-in-interest. Pet. 2.

D. Related Proceedings

The parties indicate that the '658 patent is involved in: *Ethicon LLC v. Intuitive Surgical, Inc.*, No. 1:17-cv-00871-LPS in the United States District Court for the District of Delaware (“the Delaware litigation”).¹⁰ Pet. 2; Paper 4, 2.

¹⁰ Patent Owner contends that U.S. Patent Nos. 8,616,431 B2 (“the '431 patent”), 8,479,969 B2 (“the '969 patent”), 9,113,874 B2 (“the '874 patent”), 9,084,601 B2 (“the '601 patent”), 8,998,058 B2 (“the '058

IPR2018-00936
Patent 9,585,658 B2

Petitioner is also challenging related patents in the following proceedings before the Board: (1) IPR2018-00933 (the '601 patent); (2) IPR2018-00934 (the '058 patent); (3) IPR2018-01247, IPR2018-01248, and IPR2018-01254 (the '969 patent); (4) IPR2018-00935 (the '677 patent); (5) IPR2018-00938 (the '874 patent); (6) IPR2018-01703 (the '431 patent); and (7) IPR2019-00880 (U.S. Patent No. 7,490,749).

II. ANALYSIS

A. *Claim Construction*

The claim construction standard to be employed in an *inter partes* review has changed. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Nov. 13, 2018) (to be codified at 37 C.F.R. pt. 42). That new standard, however, applies only to proceedings in which the petition is filed on or after November 13, 2018. This Petition was filed on May 23, 2018. Under the standard in effect at that time, “[a] claim in an unexpired patent . . . shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016) (upholding the use of the broadest reasonable interpretation standard). Accordingly, we determine whether to institute trial in this proceeding using the broadest reasonable construction standard. In determining the broadest reasonable construction, we presume that claim terms carry their ordinary and customary meaning. *See In re Translogic*

patent”), and 8,991,677 (“the '677 patent”) are also asserted in the Delaware litigation. Paper 4, 2.

Tech., Inc., 504 F.3d 1249, 1257 (Fed. Cir. 2007). A patentee may define a claim term in a manner that differs from its ordinary meaning; however, any special definitions must be set forth in the specification with reasonable clarity, deliberateness, and precision. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner offers a construction of the following terms: “rotary drive member” (claims 1, 4, and 5); “rotary member” (claims 6, 9, and 10); and “rotatable drive member” (claims 11–14). Pet. 14. Petitioner contends those three terms have the same meaning of “a gear, trigger, or other component that rotates to cause movement of another component.” *Id.* Patent Owner agrees that the three terms “should all be accorded the same construction.” PO Resp. 16 n.3. Patent Owner contends that the noted terms should be construed as a “component that rotates to drive another component in response to actuation of the stapling system.” *Id.* at 16.¹¹ On the record now before us in this trial, we do not discern any substantive or meaningful difference in the construction of the “rotary drive member” limitations proposed by the parties. We concur with both parties’ assessment that a “rotary drive member” is a component that rotates to drive another component. We also conclude, as we did in the Decision on Institution, that “rotary drive member” does not exclude a component regarded as a gear or a trigger. *See* Dec. on Inst. 9.

We find that it is unnecessary to provide an explicit construction or discussion of any additional claim term in order to resolve the issues in

¹¹ For convenience, we follow the approach of the parties and refer to all three terms collectively as requiring a “rotary drive member.” *See, e.g.*, PO Resp. 16 n.3.

dispute. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (explaining that claim terms need to be construed “only to the extent necessary to resolve the controversy” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

B. Principles of Law

Anticipation under 35 U.S.C. § 102 is established when every element in a claim, arranged as is recited in the claim, is found in a single prior art reference. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which such subject matter pertains.” 35 U.S.C. § 103(a). The question of obviousness under 35 U.S.C. § 103 is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).¹² “While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007).

¹² Neither party has submitted or relied on any objective evidence of non-obviousness.

C. Level of Ordinary Skill in the Art

Petitioner's Declarant, Dr. Knodel, testifies the following in connection with the level of ordinary skill in the art:

A person of ordinary skill in the art at the time of the alleged invention ("POSITA") would have had the equivalent of a Bachelor's degree or higher in mechanical engineering, with at least 3 years working experience in the design of surgical devices. More education may compensate for less work experience, and more work experience may compensate for less education.

Ex. 1003 ¶ 27.

Patent Owner does not challenge the above-noted testimony or offer any assessment of its own as to the level of ordinary skill in the art. We adopt Dr. Knodel's assessment of the level of ordinary skill in the art. We further find that the cited prior art references reflect the appropriate level of skill at the time of the claimed invention and that the level of appropriate skill reflected in these references is consistent with the definition of a person of ordinary skill in the art proposed by Petitioner. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

D. Anticipation Based on Wales

1. Overview of Wales

Wales is titled "Surgical Instrument with a Lateral-Moving Articulation Control." Ex. 1004, code (54). Wales's Figure 1 is reproduced below.

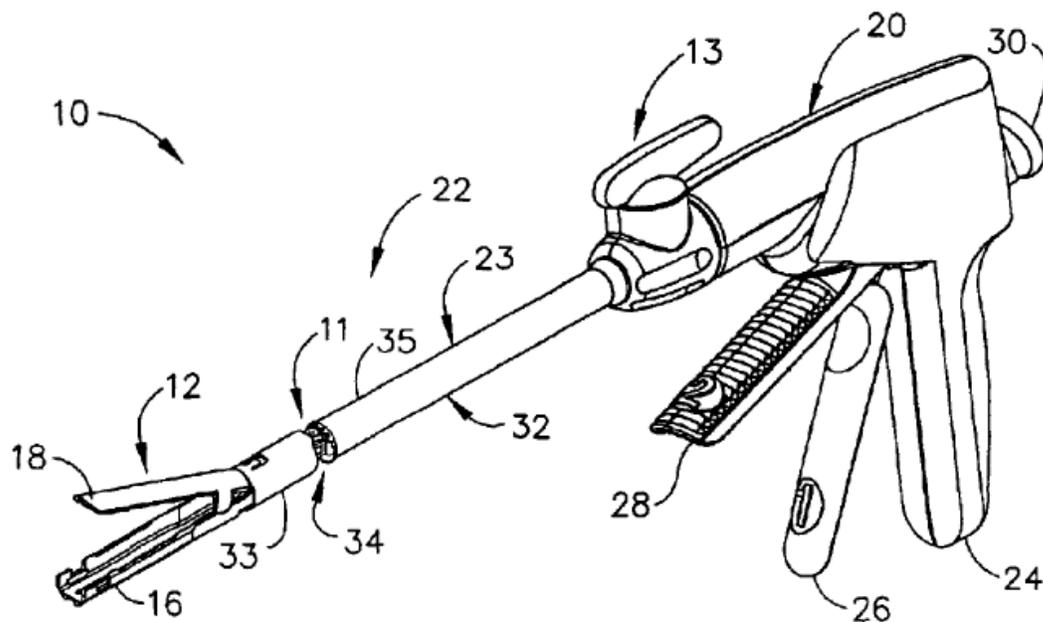


FIG. 1

Figure 1 above shows “a perspective view of an articulating surgical instrument in a nonarticulated position.” *Id.* at 3:43–44. Surgical stapling and severing instrument 10 includes handle portion 20, closure trigger 26, shaft 23, articulating mechanism 11, and end effector 12. *Id.* at 4:57–61. End effector 12 includes anvil 18 and elongate channel 16. *Id.* at 4:61–64. Wales Figure 7 is reproduced below.

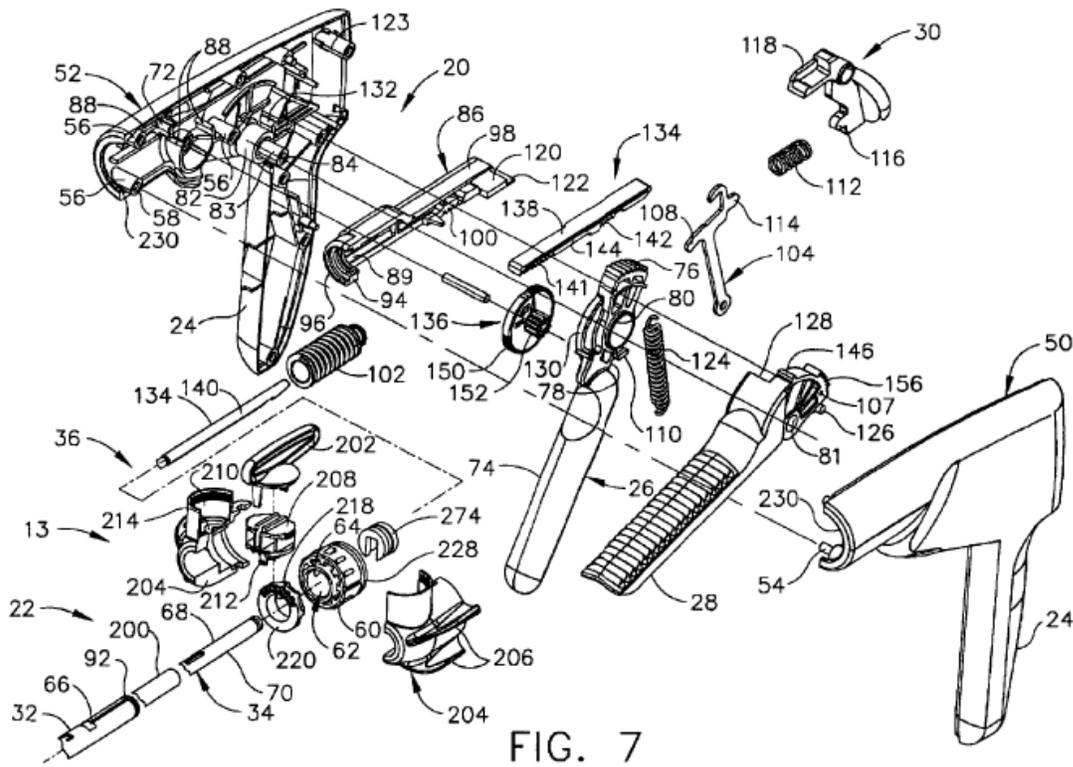


Figure 7 “depicts a perspective, exploded view of the handle portion of the proximal end of the surgical instrument of FIG. 1.” *Id.* at 3:61–63. Closure trigger 26 includes handle section 74 and gear segment section 76. *Id.* at 6:32–33. Wales also discloses that “a closure yoke 86 is housed within the handle portion 20 for reciprocating movement therein and serves to transfer motion from the closure trigger to the closure sleeve 32.” *Id.* at 6:45–47. Wales’s Figure 11 is reproduced below.

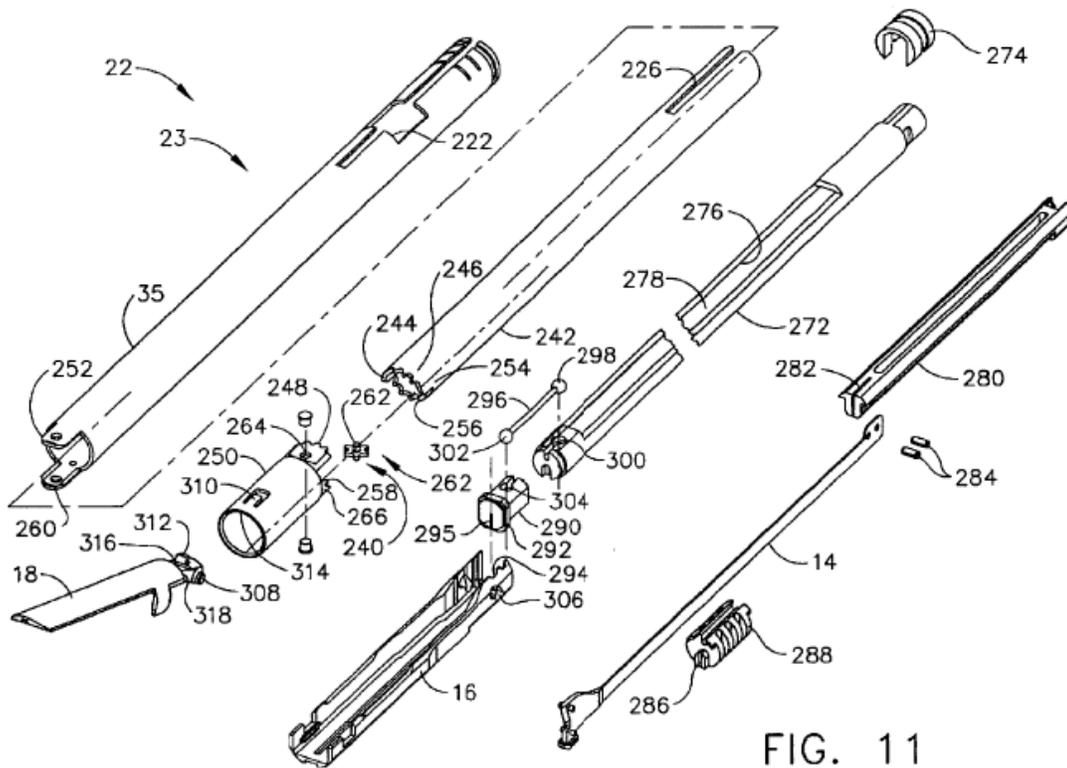


Figure 11 “depicts a perspective, exploded view of an implement portion for the surgical instrument of FIG. 1. . .” *Id.* at 4:10–11. Wales describes the following:

The elongate channel 16 also has an anvil cam slot 306 that pivotally receives an anvil pivot 308 of the anvil 18. The closure ring 250 that encompasses the articulating frame member 290 includes a distally presented tab 310 that engages an anvil feature 312 proximate but distal to the anvil pivot 308 on the anvil 18 to thereby effect opening. When the closure ring 250 is moved forward, its distally presented closing face 314 contacts a ramped cylindrical closing face 316, which is distal to tab 312 of the anvil 18. This camming action closes the anvil downward until the closing face 314 of the closure ring 250 contacts a flat cylindrical face 318 of the anvil 18.

Id. at 10:19–30.

2. *Petitioner's Contentions*

Petitioner contends that claims 1–14 of the '658 patent are anticipated by Wales. Petitioner provides detailed assessment of the content of Wales and how it discloses all the features of claims 1–14. *See* Pet. 15–44. Petitioner also supports that assessment with citation to the Declaration testimony of Dr. Knodel (Ex. 1004). For instance with respect to claim 1, Petitioner explains how Wales discloses a stapling system with all the features required, including each of: (1) “a housing comprising a rotary drive member” (Pet. 18–20); (2) “an elongate shaft” (*id.* at 20–22); (3) an end effector with “a jaw configured to support a staple cartridge” (*id.* at 22–23); (4) an “anvil” that rotates relative to the jaw between open and closed positions, and which also includes a “cam surface” (*id.* at 23–25); (5) a “closure cam” as recited (*id.* at 25–27); and, lastly, (6) an “opening member” configured and arranged as required (*id.* at 27–28). Petitioner similarly shows where it believes all the features of claims 2–14 reside in Wales. *Id.* at 29–44.

3. *Patent Owner's Contentions*

Patent Owner challenges Petitioner's position that Wales anticipates claims 1–14. The central basis of that challenge rests on the requirement of all of those claims pertaining to a “rotary drive member.” Patent Owner contends that Petitioner has relied on Wales's “gear segment 76 of the closure trigger” to account for the rotary driver member. PO Resp. 27. According to Patent Owner, however, such segment would be regarded by a skilled artisan as a component of a linear drive system and not a rotary driver member. *See id.* at 27–32. Patent Owner also contends that Wales

(citing Ex. 1004, 6:34–44. Petitioner further explains that “[t]he trigger causes rotary drive member (‘gear segment section 76’) to rotate about the pivot point, which causes ‘yoke 86 and, hence, the closure sleeve 32 [to] move distally.’ . . . The closure sleeve 32, in turn, causes ‘closure ring 250’ to move distally.” Pet. 19–20 (citing Ex. 1004, Figs. 1, 6, 7; 6:32–37, 45–64; 8:15–9:42).

Patent Owner does not dispute that the pivotal motion of gear segment 76 is understood reasonably as constituting rotary motion. Indeed, at oral argument, Patent Owner expressed agreement that gear segment 76 undergoes some rotation. Tr. 37:14–15 (“MR. PEPE: The motion of gear 76 does rotate a small amount when the user actuates it.”) Patent Owner is seemingly of the view that Wales is directed to a “linear drive” system and not a “rotary drive” system, and that, as such, gear segment 76 is not a rotary drive member because “it does not cause another component to rotate to drive an end effector motion.” PO Resp. 29. Yet, even assuming that Wales is viewed properly as a “linear drive,” Patent Owner does not explain why a component, even if part of a “linear drive,” must “cause another component to rotate” to be recognized as a rotary drive member. Patent Owner’s construction of “rotary drive member,” which we adopt, requires only that the rotary drive member must *itself* rotate to drive another component. There is no requirement that the component that is driven must also rotate. See PO Resp. 16.

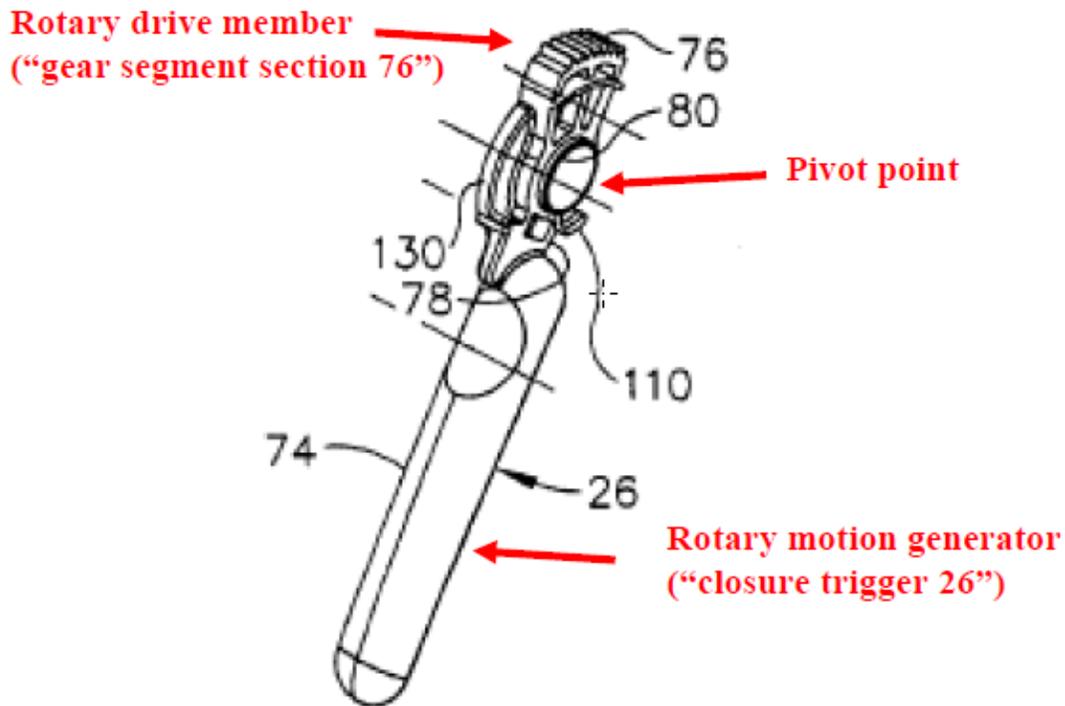
Patent Owner also points in various instances to the testimony of its Declarant, Dr. Frank Fronczak, in advocating its position on “rotary drive member.” See, e.g., PO Resp. 29–32 (citing Fronczak Decl. (Exhibit 2005) ¶¶ 56–58). Dr. Fronczak, however, does not testify that a linear drive

system is precluded from containing a component that itself rotates. When queried at oral argument, Patent Owner further did not represent that a linear drive system cannot include rotary components.¹³ Petitioner is also of that view. Pet. Reply 7 (“[n]othing in the ’658 Patent specification excludes drive systems having both rotary and linear drive members from the scope of the claims.”)

We conclude that gear segment 76, in pivoting/rotating to effect movement of yoke 86 to cause distal motion of closure sleeve 32, is viewed reasonably as a component that rotates to drive another component in response to actuation of the stapling system. That is so even if the movement of yoke 86 or the motion of closure sleeve that results from the pivoting/rotation is linear motion. Accordingly, gear segment 76 is understood readily and reasonably as a “rotary drive member.”

With respect to claims 4, 9, and 12 and the requirement of a “rotary motion generator,” we conclude that Petitioner has accounted adequately for that feature. The following is an excerpt of Wales’s Figure 7 as annotated by Petitioner.

¹³ “JUDGE COCKS: Counsel, is the premise here that this linear system cannot include any rotary component? MR. PEPE: Your Honor, the premise is that the claimed stapling system includes any component that rotates in response to actuation of a stapling system.” Tr. 34:18–22.



Pet. 31.

The annotated excerpt of Figure 7 above identifies, via added text, a “Rotary drive member,” a “Pivot point,” and a “Rotary motion generator” that is “closure trigger 26.” Petitioner contends that “‘closure trigger 26’ with a ‘handle section 74,’ . . . generates a rotary motion that rotates the rotary driver member (‘gear segment section 76’).” Pet. 30–31 (citing Ex. 1004, 6:33–44; 6:53–64). Patent Owner’s arguments to the contrary are premised on two theories: (1) that there is no rotary motion generator as a part of Wales’s disclosure because yoke 86 and closure sleeve 32 ultimately move linearly; and (2) that closure trigger 26 and gear segment 76 are “opposite ends of the same component” and, therefore, closure trigger 26 is not causing rotary motion of gear segment 76. PO Resp. 32–37; PO Sur-Reply 7–12.

As discussed above, we conclude that Wales's system reasonably includes components undergoing rotary motion even if the system is viewed generally as a "linear" system with other components exhibiting linear motion. Furthermore, although handle 74 of closure trigger 26 may be attached to gear segment 76 such that both components pivot about a pivot point upon actuation of handle 74, we do not conclude that such an arrangement prohibits consideration of the actuation of handle 74 as imparting rotational motion to gear segment 76. To that end, we agree with Petitioner that "[i]n Wales, it is clear that 'handle section 74' of 'trigger 26' generates the rotary motion to rotate 'gear segment 76' by pivoting about the pivot point." Pet. Reply 9 (citing Pet. 30; Ex. 1004, 6:33–44, 6:53–64). Accordingly, we conclude that Petitioner accounts adequately for the "rotary motion generator" feature of claims 4, 9, and 12.

We have considered carefully the positions of the parties as to the issue of whether Wales anticipates claims 1–14 of the '658 patent and the evidence cited in support of those respective positions. We conclude that Petitioner has shown, in its Petition, where all the limitations of claims 1–14, as they are arranged in those claims, are found in Wales. *See* Pet. 15–44. Accordingly, we conclude that Petitioner has shown, by a preponderance of the evidence, that claims 1–14 are anticipated by Wales.

E. Obviousness Based on Wales and Knodel

Petitioner also contends that claims 3 and 8 are unpatentable over Wales and Knodel. Claim 3 depends from claim 2 and claim 8 depends from claim 7. Claims 3 and 8 recite that the staple cartridge is "removably replaceable" within the jaw. Petitioner offers this ground as an alternative if Wales is not viewed as disclosing a removably replaceable cartridge. Patent

Owner does not offer any separate arguments regarding claims 3 and 8 vis-à-vis anticipation of those claims by Wales. We conclude that Petitioner's reliance on Knodel's teachings does not undermine the disclosure of Wales in that respect. Accordingly, on the present record, we are persuaded that Petitioner has set forth, by a preponderance of the evidence, that Wales discloses the added features of claims 3 and 8. *See* Pet 29–30, 34.

*F. Obviousness Based on Wales and Tierney, and
Wales, Tierney, and Knodel*

Petitioner also alternatively proposes that claims 1–14 are unpatentable over Wales and Tierney, and that claims 3 and 8 are unpatentable based on Wales, Tierney, and Knodel. Petitioner offers the grounds involving Tierney as alternative grounds in the event that Wales is considered to lack disclosure of a rotary drive member. Patent Owner challenges Petitioner's proposed prior art combinations on the theory that Petitioner has not articulated appropriate motivation to combine the teachings of Wales and Tierney. *See* PO Resp. 38–63. As discussed above, however, we are persuaded that Wales's gear segment section 76 is viewed reasonably as forming the required rotary drive member. Accordingly, we conclude that it is unnecessary to further evaluate the proposed grounds that involve combination of the teachings of Wales and Tierney.¹⁴

¹⁴ We observe also that Patent Owner is of the view that “Dr. Knodel's Testimony Concerning Motivation to Combine and Reasonable Expectation of Success Should be Given No Weight.” PO Resp. 63–66. Given that we conclude that Petitioner has met its burden to show that claims 1–14 are anticipated by Wales, we conclude that it is unnecessary to evaluate the weight that should be afforded Dr. Knodel's testimony when it comes to the reasoning he offers for combining the teachings of Wales and Tierney.

G. Patent Owner's Contingent Motion to Amend

Patent Owner filed a contingent motion to substitute proposed claims 15–28 (“the substitute claims”) should any of claims 1–14 be found unpatentable. As discussed above, we conclude that Petitioner has shown that claims 1–14 are unpatentable as anticipated by Wales. The contingency, thus, has materialized. We, therefore, proceed to evaluate Patent Owner’s Motion to Amend.

As noted by Patent Owner, “[i]n *Aqua Products, Inc. v. Joseph Matal*, 872 F.3d 1290, 1327–28 (Fed. Cir. 2017) (*en banc*), the Federal Circuit held that the burden of persuasion to establish that proposed amendments are patentable no longer rests with the patent owner.” *Id.* Here, that burden rests with Petitioner. *See Bosch Auto. Serv. Sols., LLC v. Matal*, 878 F.3d 1027, 1040 (Fed. Cir. 2017) (citing *Aqua Products*, 872 F.3d at 1311 (O’Malley, J., plurality)). Patent Owner need only satisfy the requirements of 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. *See Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, -01130, Paper 15 (PTAB Feb. 25, 2019) (designated precedential). Pursuant to that statute and that rule, a patent owner meets its required showing if: (1) it presents a reasonable number of substitute claims; (2) the substitute claims are responsive to a ground of unpatentability; (3) the substitute claims do not enlarge the scope of the claims or the patent; and (4) the substitute claims do not introduce new subject matter.

1. Reasonable Number of Substitute Claims

Pursuant to 37 C.F.R. § 42.121(a)(3), there is a “presumption that only one substitute claim would be needed to replace each challenged claim.” Here, Patent Owner proposes fourteen substitute claims, 15–28, to replace

fourteen challenged claims, 1–14. Petitioner does not contend that Patent Owner’s proposal in that regard is unreasonable. We conclude that this one-for-one substitution presents a reasonable number of substitute claims.

2. Respond to Ground of Unpatentability

Patent Owner contends that its substitute claims respond to the proposed grounds of unpatentability involving Wales, Knodel, and Tierney by adding claim features that Patent Owner contends are absent from the disclosures of those references. Mot. to Amend 20–25. Petitioner does not dispute that substitute claims 15–28 are responsive to the noted grounds of unpatentability. We conclude that the substitute claims satisfy the requirement that the claims “respond to a ground of unpatentability involved in the trial.” *See* 37 C.F.R. § 42.121(2)(i).

3. Scope of Substitute Claims

Pursuant to 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii), an amendment may not “enlarge the scope of the claims of the patent . . .” Patent Owner contends that the substitute claims it proposes “narrow—and do not broaden—the original claims.” Mot. to Amend 2 (emphasis omitted). More specifically, Patent Owner contends the following:

Substitute independent claims 15, 20, 25, and 28 include all of the original features of original independent claims 1, 6, 11, and 14, respectively, while narrowing the “rotary drive member” / “rotary member” / “rotatable drive member” limitations in those claims to a “rotary drive shaft” or “rotatable drive shaft.” Due to the amendments to proposed independent claims 15, 20, 25, and 28, proposed dependent claims 16-19, 21-24, and 26-27 are narrower than the original dependent claims.

Id. at 2.

Petitioner does not challenge the above-noted contentions. In reviewing the substitute claims, we discern that independent claims 15, 20, 25, and 28 are proposed as substitutes for original independent claims 1, 6, 11, and 14, respectively. With respect to claim 15, Patent Owner proposes amending the claim to omit the term “member” from “rotary drive member” and add, in its place, the term “shaft.” Patent Owner proposes similar amendments in connection with claims 20, 25, and 28.

The proposed substitute claims 16–19 are reproduced below:¹⁵

16. (proposed substitute for claim 2) The stapling system of claim 15[[1]], further comprising ~~said~~ replaceable staple cartridge.

17. (proposed substitute for claim 3) The stapling system of claim 16[[2]], ~~wherein said staple cartridge is removably replaceable within said jaw~~ further comprising a knife configured to move distally through said end effector to cut tissue.

18. (proposed substitute for claim 4) The stapling system of claim 15[[1]], ~~further comprising a rotary motion generator~~ wherein said housing further comprises a gear train configured to rotate said rotary drive membersshaft.

19. (proposed substitute for claim 5) The stapling system of claim 15[[1]], wherein said housing further comprises a ~~second rotary drive member configured to transmit a second operative motion to said end effector~~ drive said opening member, and wherein said opening member and said closure cam are driven independently.

Mot. to Amend 28–29.

Patent Owner proposes similar modifications as those reproduced above in connection with one or more of substitute claims 21–28. We

¹⁵ Deletions are shown in ~~strike through~~ and additions shown with underlining.

conclude that the amendments do not enlarge the scope of claims 1–14 of the '658 patent.

4. *New Matter*

Pursuant to 35 U.S.C. § 316(d)(3) “[a]n amendment . . . may not . . . introduce new matter.” 35 U.S.C. § 316(d)(3); *see also* 37 C.F.R. § 42.121(2)(ii) (“[a] motion to amend may be denied where: . . . [t]he amendment seeks to . . . introduce new subject matter.”) Patent Owner contends that substitute claims 15–28 do not introduce new matter. Mot. to Amend 3. Patent Owner presents a detailed table laying out where all of the features of claims 15–28 are found “from the original disclosure of the [’658 patent]—U.S. Pat. App. Pub. 2016/0220246 A1 (Ex. 2010)—and from the application to which the [’658 patent] claims priority—U.S. Appl. No. 11/810,015 (Publication No. US 2008/0300613) (Ex. 2011).” *Id.* at 3–20.

Petitioner contends that the substitute claims introduce new matter. Pet. Opp. 1–5. According to Petitioner, “each of the substitute claims recites a ‘drive shaft’ that is coupled to a closure (or clamping) cam configured to transmit a closing motion (or clamping force) to the anvil to move the anvil into the fully closed (or fully clamped) position.” Pet. Opp. 2. Petitioner notes Patent Owner pointed to support for the above-noted limitation at Exhibit 2010 ¶ 205 and Exhibit 2016 ¶¶ 39–40, 63 (citing Mot. to Amend 8).¹⁶ Petitioner contends that the referenced portions of the noted exhibits

¹⁶ Exhibit 2010 is U.S. Patent Application Publication No. 2016/0220246 and Exhibit 2016 is U.S. Patent Application Publication No. 2007/0295780 (“the ’780 publication”). Those exhibits are asserted by Patent Owner as providing written description support for the proposed substitute claims. Mot. to Amend 4, n.3.

refer to “cutting member 96” and “knife bar 30,” “each of which discloses an E-beam firing drive member.” Pet. Opp. 2. Petitioner further contends that Patent Owner’s “alleged support for the claimed closure (or clamping cam) is an E-beam.” *Id.* Petitioner additionally contends the following:

The ’658 Patent, however, does not describe an E-beam that performs the claimed function of transmitting a closing motion (or clamping force) to the anvil to move the anvil into the fully closed (or fully clamped) position. Instead, the ’658 Patent describes anvils that are moved to the “fully closed” (or fully clamped) position by a closure tube or pre-clamping collar **before** the E-beam (whether “cutting member 96” or “knife bar 30”) is ever moved.

Id.

Petitioner concludes that Patent Owner has not identified adequate written description support for the substitute claims. *Id.* at 5 (citing Knodel Supp. Decl. (Ex. 1009) ¶¶ 15–21).

Patent Owner disagrees with Petitioner and contends that “[t]he 658 Patent describes multiple ways in which the E-beam (*i.e.*, knife bar 30) acts as a closure cam that moves longitudinally to apply a closing motion to the anvil.” PO Reply Mot. to Amend 2 (citing Supp. Fronczak Decl. (Ex. 2019)) ¶¶ 10–14). In support of its position, Patent Owner also contends the following:

First, the 780 Publication describes that the upper pin 32 of knife bar 30 applies a “downward force” through anvil slot 44 (*i.e.*, the cam surface) to overcome upward deflection of the anvil. *See* Ex. 2016 at [0039]; Ex. 2019, ¶ 10. As Dr. Fronczak explains, the distal end of the anvil may deflect upward during firing after it is initially fully closed, such that the upper pins apply a downward force to re-close (*i.e.*, fully close) the anvil. Ex. 2019, ¶ 10.

Second, the 780 Publication describes that during firing, lower pin 34 of the knife bar “upwardly engages a channel slot

23 ... thereby **cooperating with the upper pin 32 to draw the anvil 40 and the elongate channel 20 slightly closer together** in the event of excess tissue clamped....” Ex. 2016 at [0040] (emphasis added). The lower pins thus apply a reaction force to the lower jaw 20, while the upper pins apply a force to the anvil to move it to the fully closed position. Ex. 2019, ¶ 11. Petitioner’s Opposition and its expert Dr. Knodel failed to fully address this clear disclosure in the specification. Opposition at 4-5; Ex. 1009, ¶ 20 (describing only the force applied by lower pins); *see also* Ex. 2019, ¶¶ 12-13.

Id. at 2–3.

We have considered the positions of Petitioner and Patent Owner, as well as the conflicting testimony of their respective declarants. In our view, Patent Owner’s declarant, Dr. Fronczak offers testimony that is more closely aligned with the disclosure of the ’780 publication. For example, the discussion in the ’780 publication pertaining to the application of a “downward force” applied to anvil 40 by upper pin 32 of knife bar 30 adequately supports Dr. Fronczak’s view that “the upper pins apply a force to the anvil to move it to the fully closed position.” *See* Ex. 2019 ¶ 11. We, therefore, credit Dr. Fronczak’s testimony in that respect and conclude that Patent Owner has identified adequate written description support for the pertinent amendments that are captured in the substitute claims proposed by Patent Owner.

Accordingly, we are persuaded by Patent Owner that its Motion to Amend does not introduce new matter.

*H. Petitioner’s Proposed Grounds of Unpatentability
for Substitute Claims 15–28*

Petitioner proposes multiple grounds that Petitioner contends demonstrate the unpatentability of substitute claims 15–28. Those grounds are summarized as follows:

Claims Challenged	35 U.S.C. §	References
15–28	102(e)	Shelton I ¹⁷
15–28	102(e)	Shelton II ¹⁸
15–28	103	Wales
15–28	103	Wales, Chang ¹⁹
15–28	103	Wales, Viola ²⁰

1. Anticipation Grounds

Petitioner contends that Shelton I and Shelton II anticipate the substitute claims because they “each disclose every limitation of every substitute claim. . . .” Pet. Opp. 6. Petitioner lays out in detail where it believes all the features of substitute claims 15–28 reside in each of Shelton I and Shelton II. *Id.* at 6–21. Patent Owner’s primary basis for challenging

¹⁷ U.S. Patent Application Publication No. US 2007/0175957 A1 published August 2, 2007 to Shelton, IV et al. (Ex. 1017, “Shelton I”).

¹⁸ U.S. Patent Application Publication No. US 2007/0175961 A1 published August 2, 2007 to Shelton, IV et al. (Ex. 1018, “Shelton II”).

¹⁹ U.S. Patent No. 5,295,614 issued March 22, 1994 to Chang (Ex. 1016, “Chang”).

²⁰ U.S. Patent No. 5,954,259 issued September 21, 1999 to Viola et al. (Ex. 1020, “Viola”).

Petitioner’s ground lies in the contention that Shelton I and II are not prior art to the ’658 patent. According to Patent Owner, “[b]ecause Shelton I and II published after the priority document of the 658 Patent (June 4, 2007), they can only qualify as prior art under 35 U.S.C. § 102(e),” but the relevant content of those documents on which Petitioner relies is purportedly not “by another” so as to qualify as prior art under § 102(e). *Id.* at 3–4 (citing *Emerachem Holdings, LLC v. Volkswagen Group of America, Inc.*, 859 F.3d 1341, 1345 (Fed. Circ. 2017)). Patent Owner additionally contends that “[e]ven if Shelton II is prior art, Petitioner has failed to demonstrate that it anticipates the substitute claims, each of which require an opening/pulling member or system configured to **move longitudinally** to apply an opening (or pulling) force to move the anvil into the [fully-]open position.” *Id.* at 6.²¹ We consider first the question of whether Shelton I or Shelton II is prior art to the ’658 patent, and in doing so, we initially focus on Shelton I.

a) Prior Art Status of Shelton I

Under 35 U.S.C. § 102(e), claims of a patent are anticipated if “the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.” “The statute’s reference to ‘by another’ means that an application issued to the same inventive entity cannot qualify as § 102(e) prior art.” *Emerachem Holdings, LLC*, 859 F.3d at 1345 (Fed. Circ. 2017). Here, the inquiry is whether the portions of Shelton I on which Petitioner relies in urging the anticipation of the substitute claims were invented by Shelton

²¹ Patent Owner does not make the same contention with respect to Shelton I. In that regard, Patent Owner does not challenge Petitioner’s contentions that Shelton I discloses all the features required by substitute claims 15–28.

alone or jointly along with the other named inventors of Shelton I, namely John Ouwerkerk and Jerome Morgan.

The Federal Circuit recently has provided direct and concrete guidance pertaining to the appropriate legal inquiry or inquiries in determining whether joint inventorship exists. To that end, the Federal Circuit indicated the following:

To be a joint inventor, one must:

- (1) contribute in some significant manner to the conception or reduction to practice of the invention,
- (2) make a contribution to the claimed invention that is not insignificant in quality, where that contribution is measured against the dimension of the full invention, and
- (3) do more than merely explain to the real inventors well-known concepts and/or the current state of the art.

Duncan Parking Techs, Inc. v. IPS Grp. Inc., 914 F.3d 1347, 1357–58 (Fed. Cir. 2019) (quoting *In re VerHoef*, 888 F.3d 1362, 1366 (Fed. Cir. 2018)). Furthermore, “[t]he law of inventorship does not hinge co-inventorship status on whether a person contributed to the conception of all of the limitations in any one claim of the patent. Rather, the law requires only that a co-inventor make a contribution to the conception of the subject matter.” *Id.* at 1358 (quoting *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1361–62 (Fed. Cir. 2004)). As is further particularly applicable here:

[T]o decide whether a reference patent is ‘by another’ for the purposes of 35 U.S.C. § 102(e), the Board must (1) determine what portions of the reference patent were relied on as prior art to anticipate the claim limitations at issue, (2) evaluate the degree to which those portions were conceived ‘by another,’ and (3) decide whether that other person’s contribution is significant enough, where measured against the full anticipating disclosure,

to render him a joint inventor of the applied portions of the reference patent.

Id.

As an additional matter, we note that throughout the course of an *inter partes* review, a petitioner always has the ultimate burden of showing the unpatentability of a subject patent. *See* 35 U.S.C. § 316(e) (“In an inter partes review instituted under this chapter, the petitioner shall have the burden of providing a proposition of unpatentability by a preponderance of the record.”); *see also Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1334 (Fed. Cir. 2016) (“[T]he burden of proof is on the petitioner to prove unpatentable those issued claims that were actually challenged in the petition for review and for which the Board instituted review.”) But, “there are two distinct burdens of proof: a burden of persuasion and a burden of production.” *Dynamic Drinkware*, 800 F.3d at 1378). The situation arising here is analogous to circumstances in which it is a patent owner that has the burden of production. *See, e.g., In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016). (“[A] patentee bears the burden of establishing that its claimed invention is entitled to an earlier priority date than an asserted prior art reference.”). Patent Owner is seeking to eliminate a document from being considered prior art under § 102(e) under the theory that the document is not “by another,” and is obligated to produce sufficient supporting evidence to justify its theory.

(1) The Declaration of Mr. Frank Shelton

Here, Patent Owner provides Declaration testimony from Mr. Frederick Shelton who is the sole listed inventor of the ’658 patent and also one of the listed inventors of Shelton I. *See* Ex. 2021. Mr. Shelton testifies

that his testimony is offered “to explain my contributions to certain patent application publications that Petitioner contends constitute prior art to the 658 Patent.” *Id.* ¶ 1. Mr. Shelton testifies that from 2005 to 2008, [REDACTED]

[REDACTED] *Id.* ¶ 5. Shelton also offers testimony that he “was solely responsible for conceiving of the instrument design architecture disclosed” in Shelton I. *Id.* ¶ 9. We share Petitioner’s view that the actual meaning of that testimony is not entirely clear. *See* Pet. 9. There are two other named inventors of Shelton I, Mr. John Ouwerkerk and Mr. Jerome Morgan, which ostensibly suggests that Mr. Shelton did not invent everything associated with Shelton I. Furthermore, although Mr. Shelton refers generally throughout his Declaration to conception of “instrument architecture” (*see, e.g.*, Ex. 2021 ¶¶ 10, 12) and “design architecture” (*id.* ¶ 11) pertaining to aspects of endocutters disclosed Shelton I, neither Mr. Shelton nor Patent Owner makes any specific attempt to tie that general “architecture” to specific features of the substitute claims. Nor are those general references to “architecture” tied in any specific way to the actual content of Shelton I. The lack of specificity in that respect does not favor Patent Owner’s position that Mr. Shelton is the sole inventor of all of the pertinent content of Shelton I on which Petitioner bases its anticipation challenge of the substitute claims, given that three named inventors were identified by the patent.

Furthermore, Mr. Shelton also testifies that [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

[REDACTED] *Id.* ¶ 15. Yet, Mr. Shelton’s testimony does not explain why

[REDACTED]

[REDACTED] the use of various switches to send signals to the motor to rotate in a certain direction depending on the position of the I-beam” was of such minimal value so as to be free of any inventive contribution to the invention of Shelton I. *Id.* Indeed, as noted above, [REDACTED]

[REDACTED]

[REDACTED] In our view, that dedicated purpose, and the contributions of Morgan and Ouwerkerk in that regard, appear germane, if not central, to content of Shelton I on which Petitioner relies in proposing that the substitute claims are anticipated by Shelton I.

Moreover, and of particular significance, Mr. Shelton testifies that [REDACTED]

[REDACTED]

[REDACTED] “are described, for example, in paragraphs [0059]-[0065]” of Shelton I. *Id.* ¶ 15. Petitioner relies directly and expressly on content appearing, for instance, at paragraphs 57–66 (Pet. Opp. 17, 20) of Shelton I in proposing anticipation of the substitute claims, which is the very content of Shelton I identified specifically by Mr. Shelton himself as exemplary content contributed by Morgan and Ouwerkerk. It is also clear that the noted paragraphs of Shelton I refer in detail to content of Shelton I

illustrated in its Figures 7–10. *See* Ex. 1017 ¶¶ 57–69. The content of Shelton’s Figures 7–10 was relied upon considerably by Petitioner in support of its theory of anticipation of the substitute claims. *See, e.g.*, Pet. Opp. 7, 9, 18, 20. In our view, such circumstances reasonably suggests that the contributions of Morgan and Ouwerkerk were sufficiently significant when “measured against the full anticipating disclosure” of Shelton I so as to establish them as joint inventors. *See Duncan Parking Techs, Inc.*, 914 F.3d at 1358.

Having considered Mr. Shelton’s Declaration testimony, we conclude that it falls short of providing credible and persuasive evidence that Mr. Shelton is the sole inventor of the pertinent content of Shelton I on which Petitioner bases its anticipation challenge of the substitute claims.

(2) Corroboration

In any event, even assuming the testimony of Mr. Shelton should be regarded as providing credible evidence that he is the sole inventor of the pertinent content of Shelton I, such testimony must generally be corroborated to be free of skepticism. *See Emerachem Holdings, LLC* 859 F.3d at 1345 (“We have treated uncorroborated testimony from an alleged inventor asserting priority with skepticism.”). Indeed, that is particularly so in situations such as those arising here in which Mr. Shelton is recalling events from nearly fourteen years ago.²² *See id.* (“These concerns particularly arise when uncorroborated testimony comes from an interested person recalling long-past events.”) The Federal Circuit has also noted the

²² The patent application that became Shelton I was filed on January 31, 2006.

following:

Because it is a mental act, an inventor’s oral testimony regarding conception must be corroborated by “evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention.”

Spansion, Inc. v. Int’l Trade Comm’n, 629 F.3d 1331, 1356 (Fed. Cir. 2010) (quoting *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985)).

Here, Patent Owner relies on the following that it contends corroborates Mr. Shelton’s testimony: (1) the Declaration testimony of Jerome Morgan (*see* PO Reply Mot. to Amend 4–5 (citing Ex. 2022 ¶¶ 6–11)), and (2) “documentation that Mr. Shelton created prior to filing of Shelton I” (*id.* at 5 (citing Mr. Shelton’s Declaration (Ex. 2021) ¶ 13, Appendix 1)).

Mr. Morgan testifies that [REDACTED]

[REDACTED] Ex. 2022 ¶ 8. His testimony also implies that [REDACTED]

[REDACTED] (*id.*), and that he worked with Mr. Shelton

[REDACTED] (*id.* ¶ 10). Although Mr.

Morgan characterizes his inventive contribution as “limited to how the motor was incorporated into and functioned in the system,” Mr. Morgan does not provide adequate explanation that such “limit[.]” is outside of the content of Shelton I on which Petitioner relies for anticipation of the substitute claims. Mr. Morgan also does not provide adequate testimony identifying the full nature of the specific content of Shelton’s I disclosure that constitutes the limit of his contribution.

We also observe that the other named inventor of Shelton I, Mr. Ouwerkerk, provides no Declaration testimony of his own from which to discern the nature of his contribution. Mr. Morgan generally testifies that Mr. Ouwerkerk [REDACTED]

[REDACTED] *Id.* ¶ 11. Yet, it cannot be determined from that testimony just what Mr. Ouwerkerk did or did not contribute [REDACTED]

Mr. Shelton additionally makes reference to a portion of Exhibit 2021 appearing in “¶ 13, Appendix 1.” PO Reply Mot. to Amend 4. Mr. Shelton characterizes Appendix I as [REDACTED]

[REDACTED] Ex. 2021 ¶ 13. Appendix I provides general summary descriptions of [REDACTED] *See id.* at 21, 23. Those brief and general descriptions, however, do not provide an adequate or meaningful basis for concluding that Mr. Shelton [REDACTED]

[REDACTED] *See Spansion, Inc.*, 629 F.3d at 1356 (citations omitted).

We have considered carefully the record before us. For the reasons discussed above, we cannot conclude that the record conveys that substantive and significant content of Shelton I on which Petitioner relies is not viewed reasonably as being “by another” as pertaining to Mr. Shelton. Accordingly, we determine that Shelton I is prior art to the ’658 patent.

b) Unpatentability Based on Shelton I

For the reasons discussed above, we find that Shelton I is prior art to the '658 patent. Petitioner has identified credibly and in detail, without dispute from Patent Owner, where all the features of substitute claims 15–28 are found in Shelton I. *See* Pet. Opp. 5–21. Petitioner also supports its position as to Shelton I with citation to the Supplemental Declaration testimony of Mr. Knodel (Ex. 1009). We do not discern any reason why that testimony should not be regarded as reliable and credible. We conclude that the circumstances here are dispositive of Patent Owner's Motion to Amend. In that respect, we determine that Petitioner, and also the record as a whole, establishes by a preponderance of the evidence that Shelton I anticipates all the substitute claims. Thus, it is appropriate to deny the Motion to Amend. Accordingly, we do so.

2. Additional Grounds

Because we conclude that Petitioner has shown that proposed claims 15–28 are not patentable based on Shelton I, we need not reach the merits of the other additional grounds of unpatentability that Petitioner has proposed for those substitute claims.

I. Petitioner's Motion to Exclude

Petitioner has filed a Motion to Exclude. Paper 40. Petitioner seeks “to exclude Appendices 1–3 to Exhibit 2021 and Appendix 1 to Exhibit 2023 (‘the objected-to appendices’) as improper hearsay under Federal Rules of Evidence 801-803 and as unauthenticated under Federal Rule of Evidence 901.” Paper 40. The “objected-to appendices” underlying that Motion either did not factor into our Decision or were not considered in a manner

detrimental to Petitioner. Accordingly, Petitioner’s Motion to Exclude is moot, and we dismiss it as such.

III. CONCLUSION

For the reasons discussed above, we hold that Petitioner has demonstrated by a preponderance of the evidence that claims 1–14 of the ’658 patent are unpatentable. We also deny Patent Owner’s Contingent Motion to Amend seeking to substitute claims 15–28 for claims 1–14 in the ’658 patent.

In summary,

Claims	35 U.S.C. §	Reference	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–14	102	Wales	1–14	
Overall Outcome			1–14	

Motion to Amend Outcome	Claim(s)
Original Claims Cancelled by Amendment	
Substitute Claims Proposed in the Amendment	15–28
Substitute Claims: Motion to Amend Granted	
Substitute Claims: Motion to Amend Denied	15–28
Substitute Claims: Not Reached	

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner has shown by a preponderance of the evidence that claims 1–14 of the ’658 patent are unpatentable;

IPR2018-00936
Patent 9,585,658 B2

FURTHER ORDERED that Patent Owner's Contingent Motion to Amend (Paper 15) seeking substitution of claims 15–28 for claims 1–14 in the '658 patent is *denied*;

FURTHER ORDERED that Petitioner's Motion to Exclude (Paper 40) is *dismissed as moot*; and

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2018-00936
Patent 9,585,658 B2

PETITIONER:

Steven R. Katz
John C. Phillips
Ryan P. O'Connor
Grant Rice
Fish & Richardson P.C.
katz@fr.com
phillips@fr.com
oconnor@fr.com
rice@fr.com

PATENT OWNER:

Anish R. Desai
Elizabeth Stotland Weiswasser
Adrian Percer
Christopher T. Marando
Christopher M. Pepe
Weil, Gotshal & Manges LLP
anish.desai@weil.com
elizabeth.weiswasser@weil.com
adrian.percer@weil.com
christopher.marando@weil.com
christopher.pepe@weil.com