IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ETHICON LLC, ETHICON ENDO-SURGERY, INC., and ETHICON US LLC,	)	
Plaintiffs,	)	
v.	)	Civil Action No. 17-871-LPS-CJB
INTUITIVE SURGICAL, INC., INTUITIVE SURGICAL OPERATIONS, INC, and INTUITIVE SURGICAL HOLDINGS, LLC,	)	
Defendants.	)	

MEMORANDUM ORDER

At Wilmington this **12th day of February, 2018**.

WHEREAS, the Court has considered both Plaintiffs Ethicon LLC, Ethicon Endo-Surgery, Inc., and Ethicon US LLC's (collectively, "Ethicon") and Defendants Intuitive Surgical, Inc., Intuitive Surgical Operations, Inc., and Intuitive Surgical Holdings, LLC's (collectively, "Intuitive") letter submissions, (D.I. 72, 74), relating to Ethicon's pending discovery dispute motion in which it requests discovery regarding Intuitive's da Vinci 60mm Xi stapler ("60mm Xi stapler") (the "Motion"), (D.I. 70), as well as the parties' arguments made during the discovery dispute teleconference on January 30, 2018, (D.I. 78 (hereinafter, "Tr.")).

NOW, THEREFORE, IT IS HEREBY ORDERED as follows:

1. Ethicon requests that the Court order Intuitive to produce technical documents regarding the 60mm Xi stapler design, Intuitive's 510(k) Application to the United States Food and Drug Administration ("FDA") for clearance to market the 60mm Xi stapler, and samples of the 60mm Xi stapler. (D.I. 72 at 1-2; *id.*, ex. 3 at 3, 8) Intuitive's 60mm Xi stapler has not yet been released, and Ethicon has not accused the device of infringement in this patent infringement

action—an action in which Ethicon currently asserts seven patents against Intuitive's 30mm and 45mm stapler products. (D.I. 49 at ¶¶ 1, 25-37; D.I. 72 at 1)

2. Ethicon commenced this action on June 30, 2017, (D.I. 1), and one month later, Ethicon filed a motion seeking limited expedited discovery regarding the 60mm Xi stapler ("motion for expedited discovery"), (D.I. 13). Ethicon asserted that it intended to file a preliminary injunction motion against Intuitive's 60mm endocutter products, but that it first required limited discovery to confirm whether or not those products infringed its patents. (*Id.* at 1) On August 16, 2017, the Court denied Ethicon's motion for expedited discovery. (D.I. 22 at 6) The Court found that the factors pertinent to such expedited requests for discovery did not weigh in favor of Ethicon where, *inter alia*, Intuitive had no finalized 60mm product, had not submitted a 510(k) Application with respect to any such product, and there appeared to be some prejudice to Intuitive in that the discovery could be misused. (*Id.* at 3-6)

3. In the instant Motion, Ethicon asserts that the circumstances have now changed, because in December 2017, Intuitive filed a 510(k) Application seeking FDA marketing approval of the 60mm Xi stapler. (D.I. 72 at 1; *id.*, ex. 1 at ex. 99.1 at 1) Intuitive continues to decline to produce discovery regarding the product, and thus Ethicon contends that the discovery dispute is now "ripe" and "urgent" since the product could be cleared by the FDA and marketed "imminently." (*Id.* at 1) Ethicon further fleshed out its asserted need for the discovery now (i.e., prior to the product's release) during the discovery dispute teleconference. Ethicon explained that access to this discovery now would: (1) promote efficiency by allowing it to amend its complaint to assert claims against the 60mm Xi stapler before claim construction begins and while Ethicon is in the process of preparing infringement contentions; and (2) enable it to file a

motion for preliminary injunction in advance of a market launch, and prior to suffering the irreparable harm it believes would occur in the event of a launch. (Tr. at 14-15) Ethicon cannot independently discover the information that it seeks regarding the 60mm Xi stapler, since the product is not commercially available and Intuitive's information regarding its design process is "proprietary and competitively sensitive[.]" (*See* D.I. 74 at 1)

4. In assessing whether a plaintiff should be permitted to obtain discovery regarding unaccused products, the Court has identified three non-exclusive factors that are important to the decision-making process: (1) the specificity with which the plaintiff has articulated how the unaccused products are relevant to its existing claims of infringement (and how the unaccused products are thus reasonably similar to the accused products at issue); (2) whether the requested information is publicly available; and (3) the burden on the defendant to produce the requested discovery. *Invensas Corp. v. Renesas Elecs. Corp.*, 287 F.R.D. 273, 282 (D. Del. 2012).

5. The procedural circumstances involved are a bit unique, and both sides also ably argued their position. But for the reasons discussed below, the Court finds that the first factor (the extent to which the record indicates that the discovery is relevant to existing infringement claims) weighs against grant of Ethicon's Motion. And because discovery is limited to that which is "relevant to any party's claim[,]" Fed. R. Civ. P. 26(b)(1), this factor is dispositive here.

6. Ethicon argues that it has a good faith basis for asserting that the 60mm Xi stapler infringes four of the patents-in-suit, for three reasons. First, Ethicon contends that "[a] change in stapler length does not require a change to the mechanical structures accused of infringing" those four patents. (D.I. 72 at 2) In support of this position, Ethicon points to the four accused structures in the 30mm and 45mm stapler products: (1) the transmission arrangement contained

in the housing (i.e., back end) used to shift between different rotary output motions; (2) the gear assemblies in the housing used to provide actuation motions; (3) the mechanisms for closing the stapler and firing the cutting sled; and (4) the opening mechanism and closure cam. (*Id.*) According to Ethicon, these structures are "essentially identical" in Intuitive's 30mm and 45mm products, despite the difference in stapler length in the two products. (*Id.*) Thus, Ethicon argues that it is "reasonable to assume" that the 60mm Xi stapler will contain essentially identical structures as well. (*Id.*) Second, Ethicon asserted that Intuitive has never denied that the 60mm Xi stapler has the same mechanical structures as does the 45mm and 30mm staplers. (*Id.*) Third, Ethicon notes that Intuitive has not produced any documents in response to Ethicon's requests for production seeking documents relating to Intuitive's "design-around" efforts, and that this suggests that Intuitive has made no efforts to change those structures in the 60mm Xi stapler. (*Id.*)

7. With respect to Ethicon's first and second reasons, Intuitive responds that Ethicon's assumption that the 60mm Xi stapler must have the same architecture as the accused products is "baseless" and "incorrect." (D.I. 74 at 1) On that score, Intuitive also submits a declaration from Robert DiSantis, its General Manager and Senior Vice President of Instruments and Accessories, in which Mr. DiSantis avers that [redacted] (D.I. 75 at ¶ 5) In Ethicon's view, this declaration was lacking, [redacted]

[redacted] *id.* at 7 (Ethicon's counsel explaining that "the onus does shift to Intuitive to take on the showing we have made specifically and either say, no, our device does not have any of those four specific features, or if it does, then we are entitled to that discovery under the framework [set out in *Invensas*, described above]"))

8. During the teleconference, however, when pressed on this issue—i.e., whether the 60mm Xi stapler has the same accused structures as the 30mm and 45mm stapler products—[redacted] The Court takes that representation seriously. In light of it, and in light of the substance of Mr. DiSantis' declaration, the Court must conclude that [redacted]

9. As for Ethicon's remaining assertion—that it has a good faith basis to believe that the 60mm Xi stapler infringes because Intuitive produced no documents relating to design-around efforts—Intuitive explained that:

> The fact that [redacted]

(*Id.* at 26) That explanation makes sense to the Court, and would make clear why Intuitive's failure to produce "design-around documents" is not necessarily an admission that the 60 mm Xi stapler has the same accused structures as do the other two accused products.

10. In light of the above, then, the Court cannot conclude that Ethicon's requested discovery regarding the unaccused 60mm Xi stapler is relevant to its existing claims of infringement. *See, e.g.*, *Tessera, Inc. v. Broadcom Corp.*, Civil Action No. 16-380-LPS-CJB, (D.I. 144 at 2-3) (D. Del. June 23, 2017) (requiring defendant to "confirm to Plaintiffs whether or not these [unaccused] products share the same circuit design as do the two specifically-accused products" and requiring defendant to respond to related discovery requests regarding the unaccused products, but only if they answered the question in the affirmative); *Hologram USA, Inc. v. Pulse Evolution Corp.*, Case No. 2:14-cv-0772-GMN-NJK, 2015 WL 13238450, at *4 (D. Nev. Dec. 18, 2015) ("[A]t its broadest, the case law provides only that a party may request discovery of devices reasonably similar to accused devices—not of all devices in a party's inventory to determine whether any are reasonably similar."). While Ethicon's letter brief articulated with specificity the accused mechanical structures that it believed were essentially identical across the 30mm, 45mm, and 60mm stapler products, [redacted] At present, then, we are left with "mere suspicion or speculation" that Intuitive's unaccused 60mm Xi stapler will infringe the asserted patents; this is not enough to render the requested discovery relevant to Ethicon's infringement claims. *Micro Motion, Inc. v. Kane Steel Co., Inc.*, 894 F.2d 1318, 1326, 1327 (Fed. Cir. 1990) ("The discovery rules are designed to assist a party to prove a claim it reasonably believes to be viable *without discovery*, not to find out if it has any basis for a

claim.") (emphasis in original).[1]

11. Ethicon's Motion is therefore DENIED.

12. Because this Memorandum Order may contain confidential information, it has been released under seal, pending review by the parties to allow them to submit a single, jointly proposed, redacted version (if necessary) of the Memorandum Order. Any such redacted version shall be submitted no later than **February 15, 2018** for review by the Court, along with a motion for redaction that includes a clear, factually-detailed explanation as to why disclosure of any proposed redacted material would "work a clearly defined and serious injury to the party seeking closure." *Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 786 (3d Cir. 1994) (internal quotation marks and citation omitted). The Court will subsequently issue a publicly-available version of its Memorandum Order.

Christopher J. Burke
UNITED STATES MAGISTRATE JUDGE

---

[1] Of course, this is not to say that Ethicon will never be able to obtain discovery about the 60 mm Xi stapler product. If Intuitive's 60mm Xi stapler is commercially released, it will be publicly available, and Ethicon presumably would be able to gain access to it at that time. (D.I. 74 at 3 n.1) If it does so, it might thereafter determine that it has a plausible claim for infringement against the product. Or it may be possible that through some other means, Ethicon will be later able to show that discovery as to that product is relevant to the infringement allegations against the two currently-accused 30 mm and 45 mm stapler products. But for now, in light of Ethicon's failure to demonstrate relevance of the requested discovery, the Court must deny the Motion.