

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

OCULAR THERAPEUTIX, INC.,  
Petitioner,

v.

MATI THERAPEUTICS, INC.,  
Patent Owner.

---

IPR2019-00448  
Patent 9,849,082 B2

---

Before ERICA A. FRANKLIN, GRACE KARAFFA OBERMANN, and  
RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining All Challenged Claims Unpatentable

Denying Patent Owner's Motion to Strike

Dismissing-In-Part and Denying-In-Part Patent Owner's Motion to Exclude

Denying Petitioner's Motion to Exclude

*35 U.S.C. § 318(a); 37 C.F.R. § 42.64*

## I. INTRODUCTION

Mati Therapeutics, Inc. (“Patent Owner”) is the owner of U.S. Patent No. 9,849,082 B2 (Ex. 1001, “the ’082 patent”). Paper 5, 2. Ocular Therapeutix, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–23 of the ’082 patent. Paper 3 (“Pet.”). We instituted trial on June 26, 2019. Paper 8 (“Institution Decision”).

Patent Owner filed a Response to the Petition. Paper 21 (“PO Resp.”). Petitioner subsequently filed a Reply, to which Patent Owner responded with a Sur-reply. Papers 30 (“Pet. Reply”), 37 (“PO Sur-reply”).

A final hearing was held where the parties presented oral argument in support of their positions. Paper 54 (“Hr’g Tr.”).

We have jurisdiction under 35 U.S.C. § 6. After considering the parties’ arguments and supporting evidence, we conclude that Petitioner has proven by a preponderance of the evidence that claims 1–23 of the ’082 patent are unpatentable. 35 U.S.C. § 316(e).

Patent Owner filed a Motion to Strike Petitioner’s Reply and Relied Upon Evidence. Paper 36 (“PO Mot. Strike”). Petitioner opposed this motion. Paper 39 (“Pet. Opp. PO Mot. Strike”). Petitioner and Patent Owner also each separately filed Motions to Exclude certain evidence. Paper 43 (“PO Mot. Exclude”); Paper 44 (“Pet. Mot. Exclude”). The parties filed respective oppositions and replies thereto. Paper 45 (“PO Opp. Pet. Mot. Exclude”); Paper 47 (“Pet. Opp. PO Mot. Exclude”); Paper 50 (“PO Reply Mot. Exclude”); Paper 51 (“Pet. Reply Mot. Exclude”). We address each of these motions in this Decision.

## II. BACKGROUND

### A. *REAL PARTIES-IN-INTEREST*

Petitioner identifies the real party-in-interest as “Ocular Therapeutix, Inc.” Pet. 3. Patent Owner identifies the real party-in-interest as “Mati Therapeutics, Inc.” Paper 5, 2.

### B. *RELATED MATTERS*

Petitioner has disclosed:

Ocular is not aware of any pending litigation related to the ‘082 Patent nor of any requested reissue, reexamination, or review of the ‘082 Patent. Ocular is, however, aware of a co-pending IPR petition regarding U.S. Pat. No. 9,463,114 [IPR2019-00442], also filed by Ocular against the same Patentee, Mati. The ‘114 Patent is not related to the ‘082 Patent but is directed to similar technology.

Ocular is aware of one pending continuation application, U.S. App. No. 15/852,619, that includes the ‘082 Patent among its priority claims. A non-final office action issued on August 28, 2018, rejecting the pending claims based on grounds similar to the one that the examiner raised against the ‘082 Patent.<sup>[1]</sup>

Pet. 4. Patent Owner identifies the same *inter partes* review and ‘619 application as Petitioner. Paper 5, 2. Patent Owner also identifies U.S. Patent Application No. 16/168,554 as related to the ‘082 patent.<sup>2</sup> *Id.*

### C. *THE ‘082 PATENT*

The ‘082 patent issued December 26, 2017, from U.S. Patent Application 15,405,991, which was filed January 13, 2017. Ex. 1001, codes (45), (21), (22). The ‘082 patent indicates priority through a series of

---

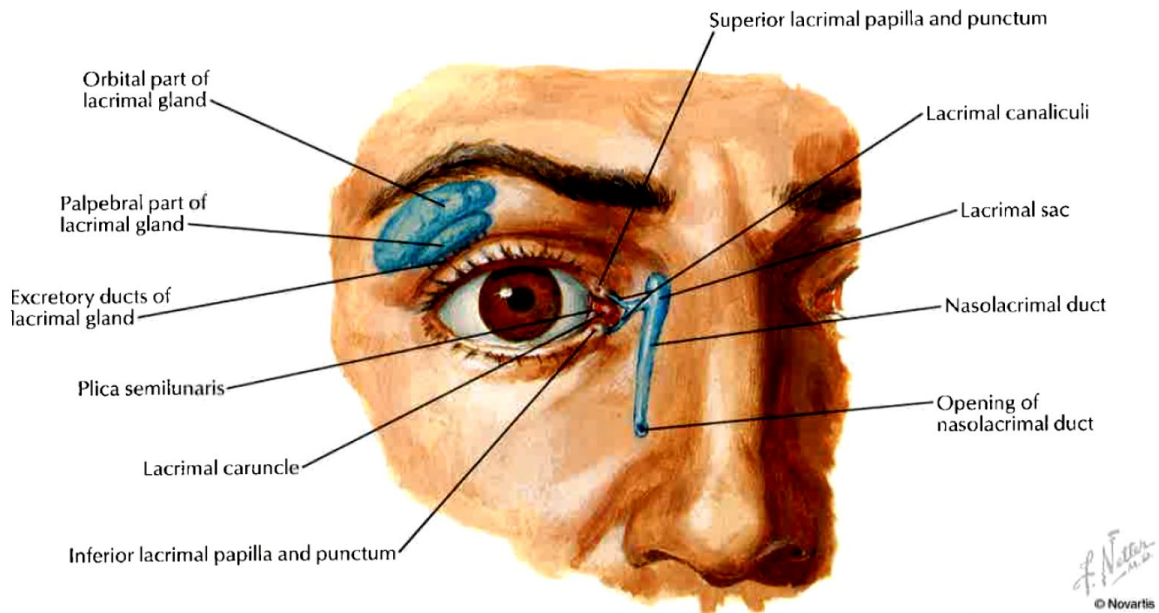
<sup>1</sup> US application 15/825,619 issued as patent US 10,383,817 B2 on Aug. 20, 2019.

<sup>2</sup> US application 16/168,554 issued as patent US 10,300,014 B2 on May 28, 2019.

continuation applications to a pair of provisional applications: Provisional 60/787,775 filed March 31, 2006, and Provisional 60/871,864 filed December 26, 2006. *Id.* codes (63), (60). The parties do not dispute the '082 patent's priority date and each treats March 31, 2006, as the earliest effective priority date. *See* Pet. 5 (“the earliest claimed priority date is March 31, 2006”); PO Resp. 51 (“as of March 31, 2006, a POSA with both Pritchard and Gillespie in hand would not have been able to make and use a claimed drug delivery system without undue experimentation”).

The '082 patent indicates its invention relates to “[a]n implant for insertion through a punctum and into a canalicular lumen of a patient.” Ex. 1001, Abstract. In the parties' submissions here, such devices are interchangeably called punctal or lacrimal plugs, inserts, and implants. *See, e.g.*, Pet. 1, 2, 6–7, 15, 17–18, 20–26, 36–51, 54–57, 62–64; PO Resp. 1–14. Punctal plugs can be intracanalicular, where they are inserted fully into the lacrimal canaliculus below the punctal opening, or they can be inserted into the lacrimal canaliculus but still exposed above the punctal opening. PO Resp. 5–6.

The relevant physiology is illustrated in a figure provided in Patent Owner's Response, reproduced below:



PO Resp. 5 (citing Ex. 2014 ¶¶ 26–27). Patent Owner's figure above shows (and labels) the relevant physiology of the human eye, including two openings, called puncta, in the corner of the eye and respectively behind the upper and lower eyelids, each of which connects to a respective duct called lacrimal canaliculi, which converge and connect with a lacrimal sac, which becomes a nasolacrimal duct as it travels down along the nose. *See id.* at 4–5. The puncta and lacrimal canaliculi carry tears away from the eye to the nasolacrimal duct of the nose anatomy. *Id.*

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.