

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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OCULAR THERAPEUTIX, INC.,  
Petitioner,

v.

MATI THERAPEUTICS, INC.,  
Patent Owner.

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Case IPR2019-00448  
Patent 9,849,082 B2

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Before ERICA A. FRANKLIN, JOHN J. LEE, and RYAN H. FLAX,  
*Administrative Patent Judges.*

FLAX, *Administrative Patent Judge.*

DECISION  
Institution of *Inter Partes* Review  
35 U.S.C. § 314

Mati Therapeutics, Inc. (“Patent Owner”) is the owner of U.S. Patent No. 9,849,082 B2 to Eugene de Juan, Jr. et al. (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.”). Patent Owner, in turn, filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute an *inter partes* review. We may institute an *inter partes* review if the information presented in the petition filed under 35 U.S.C. § 311, and any response filed under Section 313, shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314. After reviewing the parties’ submissions, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing at least one claim of the ’082 patent is unpatentable. Therefore, we institute *inter partes* review of all aforementioned claims on all grounds raised in the petition, pursuant to 35 U.S.C. § 314. *See SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *see also* Guidance on the Impact of SAS on AIA Trial Proceedings (April 26, 2018) (available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>).

I. BACKGROUND

A. *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.

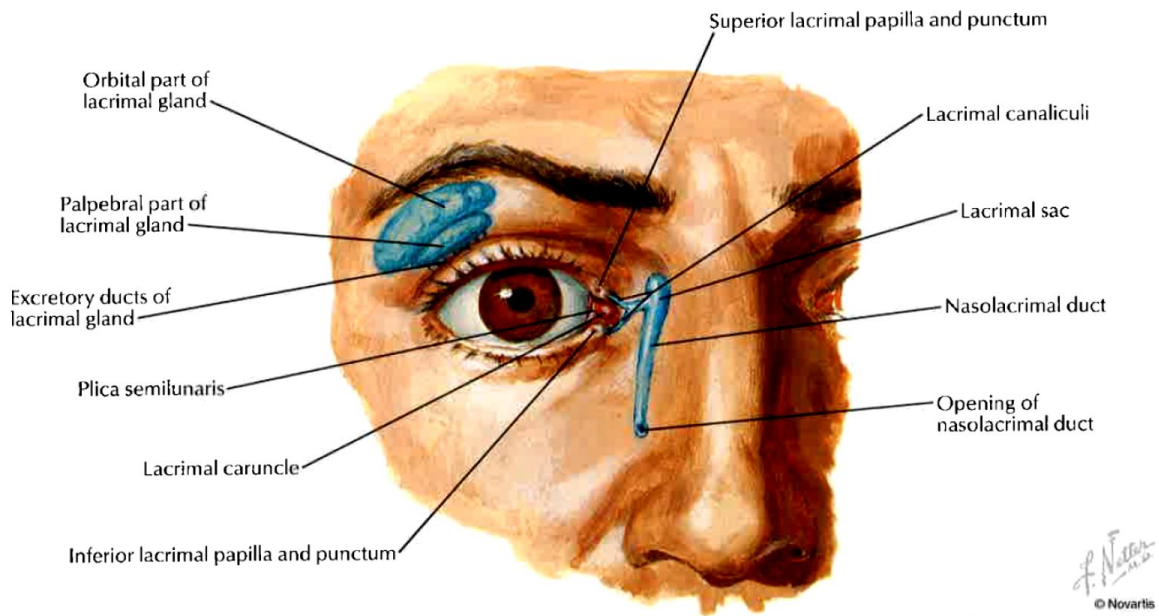
Ocular is aware of one pending continuation application, U.S. App. No. 15/852,619, that includes the '082 Patent among its priority claims. A non-final office action issued on August 28, 2018, rejecting the pending claims based on grounds similar to the one that the examiner raised against the '082 Patent.

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. *Id.*

B. *THE CLAIMED INVENTION*

The invention of the '082 patent 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, canalicular, nasolacrimal, ocular, and ophthalmic – plugs, inserts, and implants. *See, e.g.*, Pet. 1, 2, 6–7, 15, 17–18, 20–26, 36–51, 54–57, 62–64; Prelim. Resp. 2–14.

The relevant physiology is illustrated in a figure provided in the Preliminary Response, reproduced below:



Prelim. Resp. 3. Patent Owner's figure above shows (and labels) the physiology of the human eye, including a nasolacrimal duct connected to two openings, called puncta and respectively behind the upper and lower eyelids, via a lacrimal canaliculi duct that branches from the nasolacrimal duct toward the puncta. *See* Prelim. Resp. 3.

This physiology is also illustrated and described in the '082 patent at Figure 1-1, as shown below:

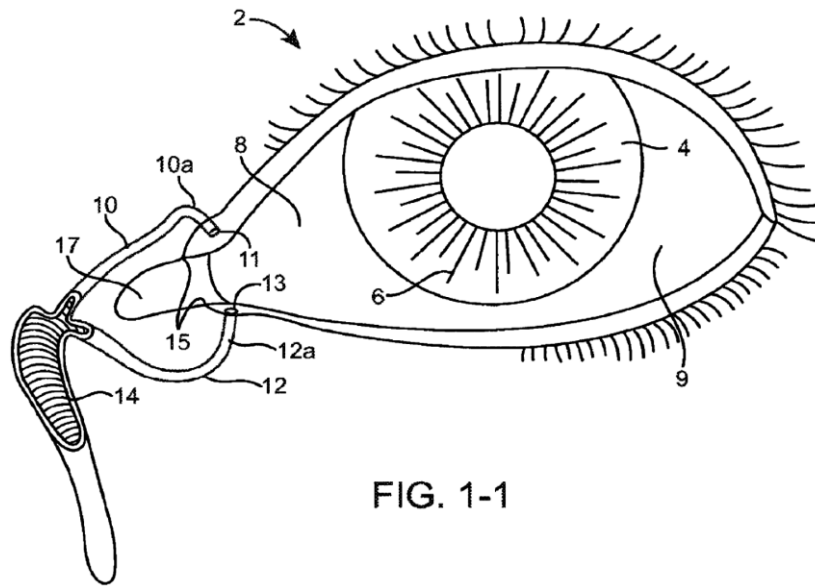


FIG. 1-1

“FIG[.]. 1-1 [above] . . . show[s] anatomical tissue structures of an eye 2 suitable for treatment with implants,” where the upper and lower canaliculus are labeled 10 and 12, respectively, and each has a punctal opening labeled 11 and 13, respectively. Ex. 1001, 7:31–65.

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