

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLAYBACK PHARMA LLC,

Petitioner,

v.

EYE THERAPIES, LLC,

Patent Owner.

Case IPR2022-00142
U.S. Patent No. 8,293,742

**PATENT OWNER'S OPENING BRIEF ADDRESSING THE BOARD'S
QUESTIONS**

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 B. Petitioner has not met its burden with respect to the “consisting essentially of” transitional phrase13

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I. Introduction

Patent Owner respectfully submits the following responses to the Board's questions relating to the preamble and the transitional phrase of the '742 patent. *See* Paper 69. The preamble "a method for reducing eye redness" is limiting, and it should be construed to require redness reduction because if it is not so construed, the steps recited in the body of the claim do not make sense. But regardless of which party's construction the Board ultimately adopts, Petitioner cannot prove inherent anticipation. Under either construction, Example 1 of the '553 patent does not anticipate because the patient population would not necessarily have redness (claims 1-2), and "about 0.025%" does not encompass 0.03% (claim 2). Additionally, Example 1 fails under Patent Owner's construction because it does not disclose, expressly or inherently, that administration of 0.03% brimonidine alone reduced any hypothetical eye redness. And Example 1 further fails under Petitioner's flawed construction because Petitioner cannot rely on inherency to prove a subjective intent to reduce redness, particularly where Example 1 explicitly states that brimonidine was administered with the intent to block the perception of pain, not reduce redness.

Petitioner's anticipation theory fails for another reason—it cannot show that Example 1 satisfies the transitional phrase "consisting essentially of," which replaced "comprising" during prosecution to overcome a prior art reference in which brimonidine was ocularly dosed with another drug. Both experts in this proceeding

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