

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SLAYBACK PHARMA LLC,  
Petitioner,

v.

EYE THERAPIES, LLC,  
Patent Owner.

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IPR2022-00142 (Patent 8,293,742 B2)  
IPR2022-00146 (Patent 9,259,425 B2)<sup>1</sup>

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Before JOHN G. NEW, TINA E. HULSE, and ROBERT A. POLLOCK,  
*Administrative Patent Judges.*

HULSE, *Administrative Patent Judge.*

ORDER  
*Conduct of the Proceeding*  
37 C.F.R. § 42.5

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<sup>1</sup> This order addresses issues that are common to both cases. We therefore exercise our discretion and issue a single order that has been entered in each case. The parties may use this style caption when filing a single paper in multiple proceedings, provided that such caption includes a footnote attesting that “the identical paper is filed in each proceeding identified in the caption.”

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A conference call was held on March 22, 2022, among counsel for Petitioner, counsel for Patent Owner, and Judges New, Hulse, and Pollock.

On March 15, 2022, Petitioner sent an email correspondence to the Board requesting authorization to file a Reply in both proceedings to address the *Fintiv* and 35 U.S.C. § 325(d) arguments made in Patent Owner's Preliminary Response. *See Ex. 3001*. Patent Owner responded to Petitioner's email, stating Patent Owner believed a Reply was not necessary, but that it would not oppose Petitioner's request provided, among other things, the Reply was limited to addressing the *Fintiv* factors alone and that it be given an opportunity to file a Sur-reply. *See id.*

During the call, Petitioner asserted that good cause exists for a Reply to respond to the *Fintiv* issues, because the Reply would address its *Sotera*-type stipulation filed after the Preliminary Response. Petitioner further asserted that it could not have foreseen Patent Owner's complex arguments with respect to § 325(d), and would like an opportunity to respond.

Patent Owner states that it would agree to a Sur-reply with respect to the *Fintiv* issues, provided Petitioner did not use the Reply to address the substantive arguments on the merits (and that Patent Owner would be authorized to file a Sur-reply of the same length). Patent Owner did not agree, however, to a Sur-reply on the § 325(d) issues, because those issues were foreseeable and the Board is equipped to evaluate those issues without further briefing.

Having considered the parties' respective arguments, we find good cause exists for Petitioner to file a Reply and Patent Owner to file a Sur-reply on both the *Fintiv* and § 325(d) issues. The *Sotera*-type stipulation was filed in the district court case after the Preliminary Response was filed and is pertinent to Patent Owner's *Fintiv* argument. And the panel may find the parties' discussion of the

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§ 325(d) issues helpful, particularly in light of the dispositive nature of the issue presented.

As such, we find good cause exists to grant Petitioner's request for authorization to file a brief Reply to Patent Owner's Preliminary Response. Petitioner's Reply shall be no longer than seven pages and may address both the *Fintiv* and § 325(d) arguments made in the Preliminary Response. Patent Owner is also authorized to file a Sur-reply to the Reply of the same length. No further testimony or evidence shall be permitted in either paper (with the exception of the *Sotera* stipulation).

Accordingly, it is

ORDERED that Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response in each proceeding is *granted*;

FURTHER ORDERED that Petitioner may file a Reply no longer than seven pages by no later than Tuesday, March 29, 2022; and

FURTHER ORDERED that Patent Owner may file a Sur-reply no longer than seven pages by no later than one calendar week after Petitioner files its Reply.

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