

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLAYBACK PHARMA LLC

Petitioner

v.

EYE THERAPIES LLC

Patent Owner

Case No. IPR2022-00142

U.S. Patent No. 8,293,742

**PETITIONER'S REPLY
TO *FINTIV* AND §325(d) ARGUMENTS
IN PATENT OWNER'S PRELIMINARY RESPONSE**

(Filed Pursuant to Paper 9)

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF AUTHORITIES	ii
ABBREVIATIONS and CITATION FORMAT.....	ii
I. <i>Fintiv</i> factors do not support denying institution under §314(a).....	1
II. Institution Should Not Be Denied Under §325(d).....	2
A. Ground 1 relies on a reference not before the Examiner	2
B. ‘553 patent is not cumulative of four references “collectively”	3
C. Grounds 1-2 avoid the <i>precise limitation added by applicant</i> to overcome rejection and obtain allowance	3
D. The primary reference of Ground 3 was not before the Examiner	4
E. Norden 2002 discloses safe and effective use of brimonidine to reduce eye redness and was also not before the Examiner	5
F. Norden 2002 is not substantively the same as ‘442 patent and Lee	6
G. Ground 3 is very different from the Examiner’s art and argument.....	6
III. Conclusion	7

TABLE OF AUTHORITIES

	<u>Page</u>
Cases	
<i>Facebook, Inc. v. USC IP Partnership, L.P.</i> , IPR 2021-00033	2
<i>Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC</i> , IPR 2019-01393	1
<i>Semiconductor Energy Laboratory Co. Ltd., v. Samsung Electronics Co., Ltd.</i> , 204 F.3d 1368, 1374 (Fed. Cir. 2000)	3

ABBREVIATIONS and CITATION FORMAT

EX __, _	Exhibit ____, page _
Pet, _	Petition (Paper 2), page _
PR, _	Preliminary Response (Paper 7), page _
related litigation	<i>Bausch & Lomb, Inc. et al. v. Slayback Pharma LLC et al.</i> , Civil Action No. 21-16766 (D.N.J.)
Schedule	Scheduling Order (EX2003) in related litigation

..

I. *Fintiv* factors do not support denying institution under §314(a)

Fintiv Factor 1: Patent Owner says a stay of the related litigation “is unlikely.” Paper 7, PR, 2. No motion to stay was filed and District Court did not address whether stay would be granted if IPR is instituted. Factor 1 is at most neutral. *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR 2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (Informative).

Fintiv Factor 2: Trial in the related litigation is four months or more *after* the May 22, 2023 anticipated deadline for Final Written Decision. EX2003 (Schedule). Factor 2 does not favor denial.

Fintiv Factor 3: Investment in the related litigation is small. District Court has made no decision on the ‘742 patent. The *Markman* hearing is *no earlier* than November 8, 2022, *followed* by close of fact discovery, *followed* by expert discovery. EX2003 (Schedule). Factor 3 does not favor denial.

Fintiv Factor 4: Patent Owner asserts “substantial overlap” between Petition and the related litigation (PR, 8-10), and that “defendants [] have not agreed to forego any invalidity challenges in the related litigation based on the grounds and art raised in the petition” (*Id.* 9). Petitioner filed a *Sotera* Stipulation (EX1043, 4) that removes the asserted overlap if IPR is instituted. Also, Petition addresses *all claims* of the ‘742 patent (claims 1-6). Factor 4 does not favor denial.

Fintiv Factor 5: Petitioner is a defendant in the related litigation. But trial in the related litigation is *at least four months after* final written decision (EX2003, Schedule), and Factor 5 “depends on which tribunal [i]s likely to address the challenged patent first.” *Facebook, Inc. v. USC IP Partnership, L.P.*, IPR 2021-00033, Paper 13 at 15 (PTAB Apr. 30, 2021). Factor 5 does not favor denial.

Fintiv Factor 6: The merits are strong. Grounds 1-2 (Paper 2, Pet, 32-44) show claims 1-2 anticipated by art not presented to Examiner, *i.e.* ‘553 patent (EX1004) and Walters 1991 (EX1005). Ground 3 (Pet, 44-64) shows claims 1-6 obvious over a primary reference, ‘553 patent, and a secondary reference, Norden 2002 (EX1006), both not presented to Examiner. Petition is supported by un rebutted expert testimony, EX1002 and EX1003. Patent Owner submitted no expert testimony and relies on attorney argument. Factor 6 does not favor denial.

Alone or together, the *Fintiv* factors do not support denying institution.

II. Institution Should Not Be Denied Under §325(d)

Institution should not be denied under §325(d) because the prior art and arguments relied on by Petitioner are substantively different from the prior art and arguments considered or relied on by the Examiner.

A. Ground 1 relies on a reference not before the Examiner

Ground 1 (Pet, 32-37) shows ‘553 patent (EX1004) anticipates claims 1-2. ‘553 patent and its PCT counterpart were not presented to the Examiner.

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.