

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX CORP.

Petitioner

v.

ALCON RESEARCH, LTD.

Patent Owner

U.S. Patent No. 8,268,299 to Kabra et al.

Issue Date: September 18, 2012

Title: Self Preserved Aqueous Pharmaceutical Compositions

Inter Partes Review No. Unassigned

**Petition for *Inter Partes* Review of U.S. Patent No. 8,268,299 Under 35 U.S.C.
§§ 311-319 and 37 C.F.R. §§ 42.1-.80, 42.100-.123**

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TABLE OF CONTENTS

I. INTRODUCTION 1

II. OVERVIEW 1

III. GROUNDS FOR STANDING (37 C.F.R. § 42.104(a)); PROCEDURAL STATEMENTS 2

IV. MANDATORY NOTICES (37 C.F.R. § 42.8(a)(1))..... 3

V. STATEMENT OF THE PRECISE RELIEF REQUESTED AND THE REASONS THEREFOR (37 C.F.R. § 42.22(a))..... 3

VI. CLAIM CONSTRUCTION 4

VII. PERSON OF SKILL IN THE ART & STATE OF THE ART..... 6

VIII. Identification of Challenge (37 C.F.R. § 42.104(b)) 7

 1. Ground 1: Claims 1, 2, 4, 8, 16, 17 and 20 Would Have Been Obvious Over Xia and Chowhan 8

 2. Ground 2: Claims 1-4, 8, 9, and 13- 20 Would Have Been Obvious Over Xia, Chowhan and Gadd 22

 3. Ground 3: Claims 5-7 and 28 Would Have Been Obvious Over Xia, the Travatan Label and Chowhan..... 34

 4. Ground 4: Claims 10-12 and 22-28 Would Have Been Obvious Over Xia, the TL, Chowhan and Gadd 42

 5. Ground 5: Claims 13 and 14 Would Have Been Obvious Over Xia, Kiyobayashi, Chowhan and Gadd 53

 6. Ground 6: Claims 24 and 27 Would Have Been Obvious Over Xia, Kiyobayashi, the TL, Chowhan and Gadd; and 56

 Ground 7: Claim 28 Would Have Been Obvious Over Xia, Kiyobayashi, the TL and Chowhan 56

IX. Secondary Considerations 59

X. Conclusion 60

CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a)) 61

I. INTRODUCTION

APOTEX CORP. ("**Petitioner**") petitions for *Inter Partes* Review (IPR), seeking cancellation of claims 1-28 ("**challenged claims**") of U.S. Patent No. 8,268,299 to Kabra et al. ("**the '299 patent**") (APO 1001), which is owned by ALCON RESEARCH, LTD.

II. OVERVIEW

As shown herein, the challenged claims of the '299 patent should never have been issued because they are unpatentable over the art cited herein. Because Petitioner is at a minimum reasonably likely to prevail in showing unpatentability, the Petition should be granted and trial instituted on all of the challenged claims.

The ophthalmic compositions recited in the claims of the '299 patent are simply an obvious repackaging of well-known components from prior art ophthalmic compositions in an attempt to evergreen a patent family. And the uses and properties of the components claimed in the '299 patent were recognized as of the earliest possible priority date of the patent. Alcon obtained the '299 patent by drafting claims that purport to be complicated – reciting specific ranges of concentrations and alleged properties of the claimed composition. But the claims of the '299 patent recite subject matter that was both simple and obvious as of the filing date of the '299 patent. All of the ranges of concentrations and properties recited in the claims were known in the prior art.

The '299 patent purports to be founded on the alleged discovery that ions interfere with the antimicrobial activity of zinc. But this phenomenon was known for at least 30 years before the earliest possible priority date of the patent. The claims also recite that the claimed ophthalmic compositions satisfy standardized pharmacopeia tests. But these tests were satisfied by compositions having the claimed components well before the filing date of the '299 patent.

Thus, the claims of the '299 patent recite ophthalmic compositions containing known components having entirely expected properties. Petitioner is reasonably likely to prevail in showing obviousness over the prior art. *Inter partes* review of the '299 patent should be instituted.

III. GROUNDS FOR STANDING (37 C.F.R. § 42.104(a)); PROCEDURAL STATEMENTS

Petitioner certifies that (1) the '299 patent is available for IPR and (2) Petitioner is not barred or estopped from requesting IPR of any claim of the '299 patent. This Petition is filed in accordance with 37 CFR § 42.106(a). Concurrently filed herewith is a Power of Attorney and an Exhibit List per § 42.10(b) and § 42.63(e), respectively. The required fee is paid via online credit card payment. The Office is authorized to charge fee deficiencies and credit overpayments to Deposit Acct. No. 19-0036 (Customer ID No. 45324).

IV. MANDATORY NOTICES (37 C.F.R. § 42.8(a)(1))

Real Party-In-Interest (37 C.F.R. § 42.8(b)(1)) is: APOTEX CORP.

Notice of Related Matters (37 C.F.R. § 42.8(b)(2)): Administrative matters: In Petitions filed concurrently herewith, Petitioner seeks IPR of (i) U.S. Pat. No. 8,323,630, which is a continuation of the '299 patent and (ii) U.S. Pat. No. 8,388,941 over references cited herein.

Designation of Lead and Back-Up Counsel (37 C.F.R. § 42.8(b)(3)):

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Notice of Service Information (37 C.F.R. § 42.8(b)(4)): Please direct all correspondence regarding this Petition to lead counsel at the above address. Petitioner consents to service by email at: eellison-PTAB@skgf.com and tpowers-PTAB@skgf.com.

V. STATEMENT OF THE PRECISE RELIEF REQUESTED AND THE REASONS THEREFOR (37 C.F.R. § 42.22(a))

Petitioner requests IPR and cancellation of claims 1-28. Petitioner's full

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