

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW WORLD MEDICAL, INC.,
Petitioner,

v.

MICROSURGICAL TECHNOLOGY, INC.,
Patent Owner.

Case IPR2020-01573

U.S. Patent No. 9,107,729

Mailed: December 17, 2020

**PATENT OWNER'S REDACTED
PRELIMINARY RESPONSE**

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Exhibit List

Exhibit	Description
2001	Declaration of Teresa M. Summers, Esq.
2002	Erin G. Sieck <i>et al.</i> , <i>Outcomes of Kahook Dual blade Goniotomy with and without Phacoemulsification Cataract Extraction</i> , 1 Ophthalmology Glaucoma, 75-81 (2018)
2003	Todd Neff, <i>UCHealth Eye Center lands global innovation awards</i> , UCHealth Today, January 6, 2016
2004	Complaint for Patent Infringement (ECF No. 1) in <i>MicroSurgical Technology, Inc., et al. v. New World Medical, Inc.</i> , Case No. 1:20-cv-00754-UNA (D. Del.), filed June 4, 2020
2005	Presentation by New World Medical titled "KDB Competitive: Trabectome/Goniotome {MST}", available at < https://www.learn.newworldmedical.com/wp-content/uploads/2020/04/ MSTTrabectome-Goniotome-min.pdf > and last accessed October 30, 2020
2006	Kahook, Malik Y., U.S. Patent No. 10,327,947, "Modified dual-blade cutting system" issued June 25, 2019
2007	October 21, 2015 press release titled "New World Medical to Launch the Kahook Dual Blade at AAO Meeting."
2008	<i>University of Colorado a global leader in patents fog inventions, innovations</i> , CU Connections, June 1, 2020.
2009	Draft Proposed Patent Owner's Additional Discovery Requests
2010	Email conversation between Lawrence Sung, counsel for Patent Owner, and Kyle Deighan, counsel for Petitioner, containing messages from October 6-7, 2020
2011	Declaration of Maeve Hickey
2012	Patent Owner's Complaint filed November 4, 2020, in the U.S. District Court for the Western District of Washington (No. 2:20-cv-01621) alleging infringement by Petitioner of U.S. Patent No. 10,786,391
2013	Email from Lawrence Sung to PTAB (November 5, 2020)
2014	KDB Glide comparison to the TrabEx

2015	Kahook, Malik Y., U.S. Patent No. 10,786,391, “Intraocular device for dual incisions” issued September 29, 2020
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I. INTRODUCTION

A petition for *inter partes* review (“IPR”) “may be considered only if . . . the petition identifies all real parties in interest.” 35 U.S.C. § 312(a)(2). “That statutory requirement, thus, defines a ‘threshold issue’ for substantive review of the merits of the challenges presented in the Petition.” *Galderma S.A. v. Allergan Industrie, SAS*, No. IPR2014-01422, 2015 WL 1022410, at *3 (P.T.A.B. Mar. 5, 2015). As explained in detail herein, The Regents of the University of Colorado (the “University”) is intimately intertwined with Petitioner New World Medical, Inc.’s (“Petitioner” or “NWM”) business related to the technology at issue in this case. The University also has a strong financial motivation to invalidate the patent at issue in this IPR and is a beneficiary of this IPR. For these reasons and more, the University should have been named as a real party in interest (“RPI”) in this proceeding.

Petitioner, however, not only failed to include the University in its list of RPIs when it filed the Petition, it also has staunchly refused to amend its identification of RPIs after Patent Owner notified Petitioner of this failure. Exclusion of the University from Petitioner’s list of RPIs conceals the University’s meaningful interest in this proceeding and is a calculated, collective attempt to avoid critical implications of estoppel. By failing to name the University as an RPI, Petitioner is paving the way for the University to observe the outcome of this IPR and have a second bite at the apple, should this IPR not succeed in invalidating all of the

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