

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW WORLD MEDICAL, INC.,
Petitioner,

v.

MICROSURGICAL TECHNOLOGY, INC.,
Patent Owner.

IPR2020-01573
Patent 9,107,729 B2

Before JAMES A. TARTAL, ROBERT A. POLLOCK, and
RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

MicroSurgical Technology, Inc. (“Patent Owner”) is the owner of U.S. Patent 9,107,729 B2 (“the ’729 patent,” Ex. 1001). Paper 29, 1 (“Response” or “Resp.”). New World Medical, Inc. (“Petitioner”) filed a Petition for an *inter partes* review of claims 1–10 (all claims) of the ’729 patent. Paper 1 (“Pet.”). Trial was instituted on March 16, 2022. Paper 22 (“Institution Decision” or “DI”). Patent Owner filed a Response to the Petition. Paper 29. Petitioner filed a Reply to Patent Owner’s Response (Paper 35, “Reply”) and Patent Owner filed a respective Sur-Reply (Paper 20, “Sur-Reply”). The parties also each filed respective motions to exclude the other’s evidence, which were each denied. Papers 51, 52, and 63. A final hearing was held on January 10, 2022, where each party presented oral argument. Paper 62 (“Hr’g Tr.”).

We have authority under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Petitioner bears the burden of proving the unpatentability of challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d) (2019). After considering the parties’ arguments and the evidence, we conclude that Petitioner proves by a preponderance of the evidence that claims 1–10 of the ’729 patent are unpatentable. 35 U.S.C. § 316(e).

I. INTRODUCTION

A. REAL PARTIES-IN-INTEREST

Petitioner identifies itself, “New World Medical, Inc.,” as a real party-in-interest. Pet. ix. Patent Owner also identifies itself, “MicroSurgical Technology, Inc.,” as a real party-in-interest. Paper 4; Paper 33.

B. RELATED MATTERS

Petitioner states:

Microsurgical Tech., Inc. (“MST” or “Patent Owner”) and The Regents of the University of California (collectively “Plaintiffs”) filed a complaint asserting infringement of U.S. Patent 9,107,729 (“the ‘729 patent”) (Ex.1001) against NWM in the U.S. District Court for the District of Delaware (No. 20-cv-00754) on June 4, 2020. *See* Ex.1017. Plaintiffs also asserted U.S. Patent 9,358,155 (“the ‘155 patent”), U.S. Patent 9,820,885 (“the ‘885 patent”), U.S. Patent 9,999,544 (“the ‘544 patent”), and U.S. Patent 10,123,905 (“the ‘905 patent), against NWM in that case. NWM was served with the complaint on August 5, 2020.

Pet. ix. Patent Owner identifies the same case in the District of Delaware as a related matter. Paper 4; Paper 33.

Although neither party identifies them as directly related matters, we note the following other *inter partes* reviews, filed by Petitioner, challenging Patent Owner’s patents at issue in the aforementioned district court case:

IPR2020-01711 regarding U.S. Patent 9,358,155 B2; IPR2021-00017 regarding U.S. Patent 9,820,885 B2; IPR2021-00065 regarding U.S. Patent 10,123,905 B2; and IPR2021-00066 regarding U.S. Patent 9,999,544 B2.

The final hearing consolidated oral arguments for this and each of these other *inter partes* review proceedings. Hr’g Tr. 1, 3:3–12.

C. THE '729 PATENT

The '729 patent issued on August 18, 2015, from U.S. Application 14/481,754, which was filed on September 9, 2014, and ultimately claims priority to U.S. Provisional Application 60/477,258, filed on June 10, 2003.¹ Ex. 1001, codes (45), (21), (22), (60), (62). The '729 patent's Abstract states:

Methods and devices for cutting strips of tissue from masses of tissue inside or outside of the bodies of human or animal subjects. The device generally comprises a) an elongate cutting tube that has a distal end and a lumen that opens through an opening in the distal end and b) first and second cutting edges formed on generally opposite edges of the distal end of the cutting tube and separated by a distance D. The device is advanced through tissue to cut a strip of tissue of approximate width W. Width W is approxima[t]ely equal to distance D.

Id. at Abstract.

Regarding the indicated feature of the invention of cutting strips of tissue, in its Background of the Invention section, the Specification explains that “[t]here are numerous medical and surgical procedures in which it is desirable to cut and remove a strip of tissue of controlled width from the body of a human or veterinary patient” and that

[o]ne surgical procedure wherein a strip of tissue of a known width is removed from an anatomical location within the body of a patient is an ophthalmological procedure used to treat glaucoma. This ophthalmological procedure is sometimes refer[r]ed to as a goniecto[m]y. In a goniecto[m]y procedure, a device that is operative to cut or ablate a strip of tissue of approximately 2-10 mm in length and about 50-200 μm in width is inserted into the anterior chamber of the eye and used

¹ Petitioner acknowledges this priority claim to June 10, 2003, and does not challenge it as the effective date of the '729 patent. Pet. 21, 24.

to remove a full thickness strip of tissue from the trabecular meshwork.

Id. at 1:18–45. The Specification further states that “there remains a need in the art for the development of simple, inexpensive and accurate instruments useable to perform the goniotomy procedure.” *Id.* at 1:66–2:2.

As meeting this asserted need, the '729 patent's Specification describes “a needle cutter device 10,” which is illustrated in its Figures 1–4. Figure 2 is an exemplary illustration and it is reproduced below:

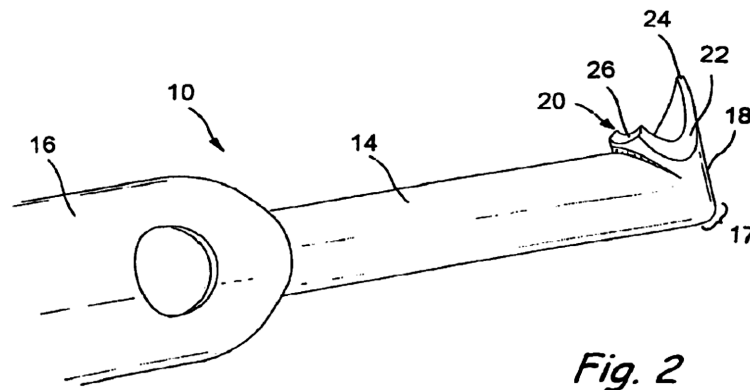


Figure 2 shows needle cutter device 10 having cutting tube 14 at an end of outer tube 16. *Id.* at 3:3–43. Cutting tube 14 terminates in an end having two cutting edges 20, 22, which are sharp to cut tissue and are positioned on opposite sides of cutting tube 14, blunt protruding tip 24, and blunt edge 26. *Id.* Cutting tube 14 has bend 17 of approximately 90 degrees at a location proximal to these features.² *Id.* The Specification describes that such a device is used “[t]o perform a goniotomy procedure.” *Id.* at 5:19–6:27. The result of using such a device to perform a goniotomy is the cutting by

² The bend angle was expressly identified by the inventors during the prosecution of the '729 patent as the angle of degrees from straight. Ex. 1002, 331 (Amendment dated May 14, 2015, remarks).

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.