

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

Filed: June 8, 2021

**DECLARATION OF GARRY P. CONDON, M.D.
IN SUPPORT OF PATENT OWNER'S RESPONSE**

TABLE OF CONTENTS

I.	Introduction	1
II.	Qualifications.....	1
III.	Materials Considered.....	1
IV.	Legal Standards	2
A.	Written Description	2
B.	Definiteness	3
C.	Enablement	3
D.	Priority	4
E.	Anticipation and Obviousness.....	4
F.	Claim Construction.....	5
G.	Person of Ordinary Skill of the Art	6
V.	Summary of my opinions	7
VI.	Details of my opinions.....	8
A.	Prior Art.....	8
i.	Quintana	9
ii.	Johnstone	24
iii.	Lee	26
iv.	Jacobi and Jacobi 2000.....	30
B.	The Netland Declaration.....	38
C.	Application of the Prior Art to the '729 Patent Claims.....	46
i.	Petition Ground 1 (Claims 1-4 and 7-9 are not anticipated by Quintana) ..	46

ii. Petition Ground 2 (Claims 4-6 and 10 are not obvious over Quintana in view of the knowledge in the art)58

iii. Petition Ground 3 (Claims 1-4 and 7-9 are not obvious over Quintana in view of Lee)64

iv. Petition Ground 4 (Claims 4-6 and 10 are not obvious over Quintana in view of Lee and the knowledge in the art)81

v. Petition Ground 5 (Claims 1-4 and 7-8 are not anticipated by Jacobi).....87

vi. Petition Ground 6 (Claims 5-6 and 9-10 are not obvious over Jacobi in view of the knowledge in the art)96

D. Conclusion102

EXHIBIT LIST

Exhibit	Description
2020	Sworn Affidavit of Manuel Quintana, M.D.
2023	DORLAND'S MEDICAL DICTIONARY SHORTER EDITION abridged from 25th ed. (1980) excerpt at 605 (definition of "section")
2024	BLACKS MEDICAL DICTIONARY 47th ed. (1992) excerpt at 519 (definition of "section")

I, Garry P. Condon, M.D., hereby declare as follows:

I. INTRODUCTION

1. I have been retained by Wiley Rein LLP as an expert witness on behalf of MicroSurgical Technology, Inc. (“MST”) in support of Patent Owner’s Response in this Inter Partes Review (“IPR”) of U.S. Patent No. 9,107,729 (Ex. 1001) (“the ’729 Patent”). I am being compensated for my time in connection with this IPR at a consulting rate of \$575 (USD) per hour. My compensation is in no way dependent on the outcome of this matter.

II. QUALIFICATIONS

2. Attached to this Declaration as Appendix A is my curriculum vitae, which provides a more detailed description of my education, training, and experience in the relevant technology.

III. MATERIALS CONSIDERED

3. I provide opinions in this declaration based on my education, training, background, and experience, as well as the documents I have reviewed to date, including the ’729 Patent and the Petition (including the following documents: Declaration of Dr. Peter Netland (Ex. 1003) (“the Netland Declaration”); Manuel Quintana, *Gonioscopic Trabeculotomy. First Results*, in 43 SECOND EUROPEAN GLAUCOMA SYMPOSIUM, DOCUMENTA OPHTHALMOLOGICA PROCEEDINGS SERIES 265 (E.L. Greve, W. Leydhecker, & C. Raitta ed., 1985) (Ex. 1004) (“Quintana”);

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.