

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*.

DECISION

Denying Patent Owner's Request for Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

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”). The parties presented their positions and arguments on patentability and the evidence of record in a Petition (Paper 1), Patent Owner’s Response (Paper 29), Petitioner’s Reply (Paper 35), and Patent Owner’s Sur-Reply (Paper 44). After considering the parties’ positions and arguments, and the evidence of record, we concluded that Petitioner proved by a preponderance of the evidence that claims 1–10 of the ’729 patent are unpatentable because they would have been obvious under 35 U.S.C. § 103 over Quintana and Lee.^{1, 2} Paper 64 (“Final Decision” or “FD”).

Patent Owner timely filed a request for rehearing of our Final Decision. Paper 65 (“Request” or “Req.”). Patent Owner argues we erred in concluding the claims are unpatentable because: (1) Quintana fails to teach “first and second cutting edges concurrently cutting, from the trabecular meshwork, a strip of tissue,” as recited by claim 1; (2) it was impermissible hindsight to rely on Exhibits 1031–1033 (“the Netland videos”); (3) there would not have been motivation for the ordinarily skilled artisan to combine

¹ Manuel Quintana, *Gonioscopic Trabeculotomy. First Results in DOCUMENTA OPHTHALMOLOGICA PROCEEDINGS SERIES 43, SECOND EUROPEAN GLAUCOMA SYMPOSIUM 265–71* (E.L. Greve et al. eds. 1985). Ex. 1004 (“Quintana”).

² U.S. Patent 4,900,300 (issued Feb. 13, 1990). Ex. 1006 (“Lee”).

Quintana and Lee; (4) Quintana and Lee fail to teach “a dual blade device” (that concurrently cut trabecular meshwork) as recited by claim 1; (5) we substituted expert witness assertions for claim elements missing from Quintana and Lee; and (6) we substituted our own analysis regarding Lee teaching an angled tip of its device where that fact was not raised by Petitioner. *See generally* Req. Our discussion below addresses these issues with the understanding that Patent Owner presents specific arguments on these points throughout its Request.

II. STANDARD OF REVIEW

The standard applicable to a request for rehearing of a Board decision is provided in Rule 42.71(d), which states in pertinent part:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

37 C.F.R. § 42.71(d) (2021). A request for rehearing is not an opportunity to present new arguments or evidence or merely to disagree with the panel’s assessment of the arguments or weighing of the evidence.

III. DISCUSSION

For the reasons that follow, we find Patent Owner has not shown we misapprehended or overlooked any matter in the Final Decision. We address Patent Owner’s arguments below.

A. QUINTANA TEACHES “FIRST AND SECOND CUTTING EDGES CONCURRENTLY CUTTING, FROM THE TRABECULAR MESHWORK, A STRIP OF TISSUE”

Patent Owner argues that that Quintana does not teach the successful removal of a strip of trabecular meshwork. Req. 3–4.³ Patent Owner further argues there is no evidence in the record to support that Quintana teaches “creating a strip of TM using a slightly, bent hypodermic needle tip, much less by the concurrent cutting of the beveled sides of the needle tip.” *Id.* at 5.

We address in the Final Decision the question of whether Quintana teaches “first and second cutting edges concurrently cutting, from the trabecular meshwork, a strip of tissue,” as recited by claim 1, which is an issue previously raised by Patent Owner. FD 45–47; *see also id.* at 33–43 (addressing whether and determining that Quintana and Lee teach “obtaining a dual blade device,” as also recited by claim 1, upon which this limitation is

³ Patent Owner’s argument focuses on whether Quintana teaches the claimed subject matter and ignores (1) that Petitioner’s ground for unpatentability is based on obviousness and a combination of Quintana and Lee, (2) that it is over this ground that we found the claims unpatentable as obvious, and (3) that we found Lee, like Quintana, teaches a trabecular meshwork stripping device having two cutting edges, as claimed. *See* FD 15–18, 32–43; *see also* DI 10–12, 21–23 (discussing such teachings of Quintana and Lee). “Non-obviousness cannot be established by attacking references individually where [unpatentability] is based upon the teachings of a combination of references. . . . [The references] must be read, not in isolation, but for what [they] fairly teach[] in combination with the prior art as a whole.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Nevertheless, we address here Patent Owner’s arguments as presented. Patent Owner also argues that we were incorrect in finding the ordinarily skilled artisan would have been motivated to combine Quintana and Lee; we address this argument below.

based). As addressed in the Final Decision, Petitioner asserts Quintana teaches a dual blade device having first and second cutting edges as a bent-tip needle having a beveled tip with two sharp sides and further teaches a process where that device is advanced through Schlemm's canal resulting in a strip of trabecular meshwork tissue having a width matching the distance between the cutting edges. *Id.* at 45. The Final Decision also addresses Petitioner's assertion that such a procedure was well known by 2003 and that Lee also teaches such a procedure, which cuts and extracts segments of trabecular meshwork. *Id.*

In the Final Decision we address Patent Owner's argument that Quintana did not teach these limitations, as Patent Owner repeats in its Request. *Id.* at 45–46. The same points that Patent Owner makes in its Request now were addressed in the Final Decision. For example, we address Quintana's use of the term “stripped” in several portions of the Final Decision. *Id.* at 37, 45–46. The Final Decision identifies that Quintana's procedure teaches “the TM is stripped slowly, gently, and easily from the canal's lumen . . . as the needle progresses.” *Id.* at 37 (citing Ex. 1004, 4); *see also id.* at 45–46. We found that Quintana's disclosure that “TM is stripped . . . from the canal's lumen” evidences the tissue's removal.⁴ *See id.* at 37 (citing Ex. 1004, 4, caption to Figure 2; crediting Ex. 1030 ¶¶ 7–10). We further explain Quintana's reference to “acheiv[ing] a section of the trabecular meshwork,” and to conducting studies “of the sectioned trabecular

⁴ Further, we found that Lee's disclosure supported our determination and that Dr. Netland's experiments confirmed that Quintana's disclosed procedure functions to cut a strip of trabecular meshwork from the eye. FD 46.

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