

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

New World Medical, Inc.,
Petitioner

v.

MicroSurgical Tech., Inc.,
Patent Owner

Case No. IPR2020-01573

U.S. Patent Nos. 9,107,729

PETITIONER'S REQUEST FOR ORAL ARGUMENT

In accordance with 37 C.F.R. § 42.70 and the Scheduling Order (Paper No. 23), Petitioner New World Medical, Inc. (“Petitioner” or “New World”) respectfully requests oral argument in this proceeding. According to the Board’s Order Revising Schedule Common to Related Proceedings in IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, and 2021-00066 (Paper No. 27), oral argument in this and the related IPR proceedings is scheduled for January 10, 2022. New World respectfully requests 60 minutes at the oral argument to address the related IPR proceedings (IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, and 2021-00066) or, to the extent it is greater, the amount of time granted to Patent Owner.

Specifically, but not by way of waiver of any unenumerated issues, New World requests oral argument to address the following issues related to this IPR proceeding:

1. The grounds on which the IPRs were instituted, including the issues and evidence raised in the parties’ briefing and supporting declarations and exhibits, including but not limited to:
 - a. The proper construction of the claim terms of U.S. Patent No. 9,107,729 (“the ‘729 patent”);
 - b. Whether claims 1-4 and 7-9 of the ‘729 patent are anticipated under pre-AIA 35 U.S.C. § 102 by Manuel Quintana,

Gonioscopic Trabeculotomy. First Results, in 43 SECOND

EUROPEAN GLAUCOMA SYMPOSIUM, DOCUMENTA

OPHTHALMOLOGICA PROCEEDINGS SERIES (E.L. Greve, W.

Leydhecker, & C. Raitta ed., 1985) (“Quintana”) (Ex. 1004);

- c. Whether claims 4-6 and 10 of the ‘729 patent are rendered obvious under pre-AIA 35 U.S.C. § 103 by Quintana in view of the knowledge of a person of ordinary skill in the art;
- d. Whether claims 1-4 and 7-9 of the ‘729 patent are rendered obvious under pre-AIA 35 U.S.C. § 103 by Quintana in view of U.S. Patent No. 4,900,300 to Lee (“Lee”) (Exhibit 1006);
- e. Whether claims 4-6 and 10 of the ‘729 patent are rendered obvious under pre-AIA 35 U.S.C. § 103 by Quintana in view of Lee, and further in view of the knowledge of a person of ordinary skill in the art;
- f. Whether claims 1-4 and 7-8 of the ‘729 patent are anticipated under pre-AIA 35 U.S.C. § 102 by Philipp C. Jacobi *et al.*, “Technique of gonioscurettage: a potential treatment for advance chronic open angle glaucoma,” 81 BRITISH J. OPHTHALMOLOGY 302-307 (1997) (“Jacobi”) (Ex. 1007);

- g. Whether claims 5-6 and 9-10 of the '729 patent are rendered obvious under 35 U.S.C. § 103 by Jacobi in further view of the knowledge of a person of ordinary skill in the art;
2. Petitioner's Motion to Strike the Affidavit of Manuel Quintana (Exhibit 2020) (Paper 34) and the parties' evidence and briefing related to Petitioner's Motion to Strike;
 3. Any issues raised by Patent Owner in its Request for Oral Argument;
 4. Rebuttal to Patent Owner's presentation on all matters;
 5. Any procedural and evidentiary issues raised by the parties; and
 6. Any issues raised by the parties in any other filings contemporaneous or subsequent to this Request, including any Motions to Exclude in this proceeding.

New World requests the ability to use audio visual equipment to display demonstrative exhibits at the hearing, including the use of a projector for a PowerPoint presentation.

Dated: November 2, 2021

Respectfully submitted,

/s/ Todd R. Tucker

Todd R. Tucker (Reg. No. 40,850)

ttucker@calfee.com

Kyle Deighan (Reg. No. 75,525)

kdeighan@calfee.com

CALFEE, HALTER & GRISWOLD LLP

The Calfee Building
1405 East Sixth Street
Cleveland, Ohio 44114
P: 216-622-8200
F: 216-241-0816

*Attorneys for Petitioner New World.
Medical, Inc.*

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.