

Case IPR2022-00142
U.S. Patent No. 8,293,742

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLAYBACK PHARMA LLC,
Petitioner,

v.

EYE THERAPIES, LLC,
Patent Owner.

Case No.: IPR2022-00142

U.S. Patent No.: 8,293,742

PETITIONER'S OPENING SUPPLEMENTAL BRIEF

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Pursuant to the Board's Order dated March 6, 2023, Petitioner submits this supplemental brief to address the Board's questions regarding the preamble and transitional phrases of the challenged claims. The preamble limits the challenged claims to methods of treating eye redness. By doing so, the preamble identifies the patients to whom brimonidine should be administered: patients suffering from eye redness. The identification of a particular patient population, however, does not change the inherent anticipation analysis. Gil inherently anticipates claims 1 and 2 because Gil discloses all steps of the claimed method in patients that necessarily suffer from eye redness. The natural result of administering 0.03% brimonidine to the patients in Gil is the reduction of eye redness. In such circumstances, courts have found newly discovered benefits of old methods are not patentable.

The "consisting essentially of" transitional phrase excludes from the claims only those methods that include unclaimed elements or steps that materially affect the basic and novel properties of the claimed method. Here, the specification makes clear that the basic and novel property of the claimed method is brimonidine's ability to reduce eye redness. Therefore, only elements that materially affect the redness reducing effects of brimonidine are excluded from the coverage of the claimed methods. In Gil and Norden, the only difference between the treatment and control groups is the administration of brimonidine. The record shows that, despite any other active ingredients administered to those patients, the patients had eye redness and no

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