

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

Patent No. 8,293,742

Henderson Legal Services, Inc.

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| <p style="text-align: right;">2</p> <p>1 UNITED STATES PATENT AND TRADEMARK OFFICE 2 ----- 3 BEFORE THE PATENT TRIAL AND APPEAL BOARD 4 ----- 5 6 SLAYBACK PHARMA LLC 7 Petitioner 8 v. 9 EYE THERAPIES, LLC 10 Patent Owner 11 ----- 12 Case No. IPR2022-00146 13 Patent No. 9,259,425 14 ----- 15 16 VIDEOTAPED DEPOSITION OF 17 NEAL A. SHER, M.D., FACS 18 Wednesday, August 10, 2022 19 Chicago, Illinois 20 8:52 a.m. CST 21 22 23 Reported by: 24 Janice M. Kocek, CSR, CLR 25 Job No. 52405</p> | <p style="text-align: right;">4</p> <p>1 A P P E A R A N C E S: 2 ** ALL PARTIES APPEARING REMOTELY ** 3 4 ON BEHALF OF THE PETITIONER: 5 GOODWIN PROCTER LLP 6 The New York Times Building 7 620 Eighth Avenue 8 New York, New York 10018 9 212.813.8800 10 BY: LINNEA P. CIPRIANO, ESQ. 11 lcipriano@goodwinlaw.com 12 13 ON BEHALF OF THE PETITIONER: 14 WENDELS MARX 15 One Giralda Farms 16 Madison, New Jersey 07940 17 973.966.3200 18 BY: LOUIS H. WEINSTEIN, ESQ. 19 lweinstein@windelsmarx.com 20 21 22 23 24 25</p> |
| <p style="text-align: right;">3</p> <p>1 The videotaped deposition of 2 NEAL A. SHER, M.D., FACS, called by the Patent 3 Owner for examination, reported stenographically 4 by Janice M. Kocek, License No. 084-002871, 5 Certified Shorthand Reporter and Certified 6 LiveNote Reporter, and Notary Public for the 7 State of Illinois, held at 70 West Madison, 8 Chicago, Illinois, commencing at the hour of 8:52 9 a.m. CST, on the 10th of August, 2022. 10 11 * * * 12 13 14 15 16 17 18 19 20 21 22 23 24 25</p> | <p style="text-align: right;">5</p> <p>1 A P P E A R A N C E S: 2 3 ON BEHALF OF THE PATENT OWNER: 4 FINNEGAN, HENDERSON, FARABOW, 5 GARRETT & DUNNER, LLP 6 901 New York Avenue, NW 7 Washington, DC 20001-4413 8 202.408.4000 9 BY: BRYAN C. DINER, ESQ. 10 bryan.diner@finnegan.com 11 CAITLIN E. O'CONNELL, ESQ. 12 caitlin.o'connell@finnegan.com 13 CHRISTINA JI-HYE YANG, ESQ. (remotely) 14 christina.yang@finnegan.com 15 16 ALSO PRESENT: 17 BEN STANSON, videographer 18 19 20 21 22 23 24 25</p> |

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| 6 | <p>1 INDEX</p> <p>2</p> <p>3 TESTIMONY OF NEAL A. SHER, M.D., FACS PAGE</p> <p>4 Examination by Mr. Diner 8, 136</p> <p>5 Examination by Ms. Cipriano 133</p> <p>6</p> <p>7 DEPOSITION EXHIBITS</p> <p>8 NUMBER DESCRIPTION PAGE</p> <p>9 Exhibit 1 Declaration of 14</p> <p>10 Neal A. Sher, M.D., FACS</p> <p>11 Patent No. 8,293,742</p> <p>12 Exhibit 2 Declaration of 20</p> <p>13 Neal A. Sher, M.D., FACS</p> <p>14 Patent No. 9,259,425</p> <p>15 Exhibit 3 United States Patent 54</p> <p>16 8,293,742 B2</p> <p>17 Exhibit 4 United States Patent 54</p> <p>18 9,259,425 B2</p> <p>19 Exhibit 5 United States Patent 114</p> <p>20 6,294,553 B1</p> <p>21 Exhibit 6 ARVO Investigative 124</p> <p>22 Ophthalmology & Visual Science</p> <p>23 Annual Meeting Abstract</p> <p>24 Issue, April 28 - May3, 1991,</p> <p>25 Sarasota, Florida</p> | 8 | <p>1 THE VIDEOGRAPHER: This is Ben</p> <p>2 Stanson with Henderson Legal Services. I'm</p> <p>3 the operator of this camera. We are on the</p> <p>4 record on August 10th, 2022, and the time</p> <p>5 is 8:52 a.m. as indicated on the video</p> <p>6 screen. We are at HeplerBroom located at</p> <p>7 70 West Madison Street in Chicago,</p> <p>8 Illinois.</p> <p>9 This is the videotaped</p> <p>10 deposition of Dr. Neal Sher that's being</p> <p>11 taken pursuant to Federal Rules of Civil</p> <p>12 Procedure on behalf of the patent holder.</p> <p>13 This case is captioned Slayback Pharma LLC</p> <p>14 versus Eye Therapies, LLC, Case Nos.</p> <p>15 IPR2022-00142 and IPR2022-00146.</p> <p>16 Will the attorneys please</p> <p>17 identify themselves for the record.</p> <p>18 MR. DINER: Bryan Diner. I'm joined</p> <p>19 by colleague, Caitlin O'Connell, with the</p> <p>20 Finnegan law firm. We represent the patent</p> <p>21 holder.</p> <p>22 MS. CIPRIANO: Linnea Cipriano of</p> <p>23 Goodwin representing the petitioner and the</p> <p>24 witness.</p> <p>25 MR. WEINSTEIN: Louis Weinstein of</p> |
| 7 | <p>1 DEPOSITION EXHIBITS</p> <p>2 NUMBER DESCRIPTION PAGE</p> <p>3 Exhibit 7 United States Patent 127</p> <p>4 6,242,442 B1</p> <p>5 Exhibit 8 Highlights of Prescribing 131</p> <p>6 Information - Simbrinza</p> <p>7</p> <p>8</p> <p>9</p> <p>10</p> <p>11</p> <p>12</p> <p>13</p> <p>14</p> <p>15</p> <p>16</p> <p>17</p> <p>18</p> <p>19</p> <p>20</p> <p>21</p> <p>22</p> <p>23</p> <p>24</p> <p>25</p> | 9 | <p>1 Windels Marx representing the petitioner.</p> <p>2 THE VIDEOGRAPHER: Thank you.</p> <p>3 Our court reporter today is</p> <p>4 Janice Kocek also with Henderson Legal</p> <p>5 Services.</p> <p>6 Will you please swear in the</p> <p>7 witness and then counsel, you may proceed.</p> <p>8 (Witness sworn.)</p> <p>9 NEAL A. SHER, M.D., FACS,</p> <p>10 called as a witness herein, having been first</p> <p>11 duly sworn, was examined and testified as</p> <p>12 follows:</p> <p>13 EXAMINATION</p> <p>14 BY MR. DINER:</p> <p>15 Q. Good morning, Dr. Sher.</p> <p>16 A. Good morning.</p> <p>17 Q. How are you?</p> <p>18 A. Good, Mr. Diner.</p> <p>19 Q. Would you please state your name and</p> <p>20 address for the record?</p> <p>21 A. Neal Andrew Sher, 132 East Delaware</p> <p>22 Place, Chicago, 60611.</p> <p>23 Q. Have you been deposed before, Doctor?</p> <p>24 A. I have.</p> <p>25 Q. And how many times?</p> |

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| 10 | <p>1 A. Probably in the range of about 20</p> <p>2 times.</p> <p>3 Q. And were those depositions in which</p> <p>4 you were deposed, were you deposed as an expert</p> <p>5 witness?</p> <p>6 A. One may have been a witness of fact</p> <p>7 in a patient-related injury, workmen's comp.</p> <p>8 But most of them -- all of them were expert.</p> <p>9 Q. Were any of them lawsuits dealing</p> <p>10 with the patent matters?</p> <p>11 A. Some.</p> <p>12 Q. Do you recall how many?</p> <p>13 A. I believe -- I can get you that</p> <p>14 number but I do not. Probably in the range of</p> <p>15 eight to ten but I haven't counted.</p> <p>16 Q. Was the most recent patent case in</p> <p>17 which you were an expert the Alcon v. Watson</p> <p>18 case?</p> <p>19 A. Yes.</p> <p>20 Q. And do you recall how many years ago</p> <p>21 that was?</p> <p>22 A. It was pre COVID but not -- maybe</p> <p>23 2019.</p> <p>24 Q. And that was within the last four</p> <p>25 years?</p> | 12 | <p>1 the patents"?</p> <p>2 A. I was asked questions regarding the</p> <p>3 clinical use of these drugs, among other things.</p> <p>4 Q. In that case, did you testify that</p> <p>5 the patents of -- in suit were invalid?</p> <p>6 A. I don't recall the details. I would</p> <p>7 have to review it. It had to do with the</p> <p>8 concentrations of the drug and whether -- and it</p> <p>9 had to do with validity of the patents. But I</p> <p>10 would need to review it. I haven't looked at</p> <p>11 that time in some years.</p> <p>12 Q. In the Alcon v. Watson case, did you</p> <p>13 testify on issues relating to claim</p> <p>14 construction?</p> <p>15 Do you know what I mean by claim</p> <p>16 construction?</p> <p>17 A. Yes.</p> <p>18 Q. Can you answer my question?</p> <p>19 A. The answer's no.</p> <p>20 Q. Okay. Great.</p> <p>21 Since you've been deposed before many</p> <p>22 times, you probably know the drill. But I'll</p> <p>23 just go through it quickly so that we're all on</p> <p>24 the same page if that's fine with you.</p> <p>25 As we have started, I'll ask the</p> |
| 11 | <p>1 A. Yes.</p> <p>2 Q. Were there any other patent cases</p> <p>3 that you were an expert in within the last four</p> <p>4 years?</p> <p>5 A. No.</p> <p>6 Q. Generally in the patent cases in</p> <p>7 which you were an expert, what was the subject</p> <p>8 matter of your testimony?</p> <p>9 MS. CIPRIANO: Objection to form.</p> <p>10 THE WITNESS: I could speak to the</p> <p>11 Lupin case. It had to do with the generic</p> <p>12 drug regarding forms of olopatadine, an</p> <p>13 antihistamine drug.</p> <p>14 BY MR. DINER:</p> <p>15 Q. And when you said the Lupin case, do</p> <p>16 you mean the Alcon v. Watson v. Lupin case?</p> <p>17 A. Correct.</p> <p>18 Q. And were you testifying on behalf of</p> <p>19 Watson in Lupin?</p> <p>20 A. Yes.</p> <p>21 Q. And was your testimony directed to</p> <p>22 the validity of the patents in that lawsuit?</p> <p>23 A. Testimony related to the practice of</p> <p>24 the patents.</p> <p>25 Q. What do you mean by "the practice of</p> | 13 | <p>1 questions. You'll answer them.</p> <p>2 If you need a break, please let me</p> <p>3 know. If there's a question pending, I just ask</p> <p>4 that you answer the question and then we can</p> <p>5 take a break; is that okay?</p> <p>6 A. Yes.</p> <p>7 Q. If for any reason you don't</p> <p>8 understand my question, you can ask and I'll be</p> <p>9 happy to clarify something that you don't</p> <p>10 understand or reask the question as you like; is</p> <p>11 that okay?</p> <p>12 A. Okay.</p> <p>13 Q. But if you answer my question, I will</p> <p>14 assume you understood what I was asking; is that</p> <p>15 fair?</p> <p>16 A. If I understand the question, yes.</p> <p>17 Q. Is there any reason why you cannot</p> <p>18 testify truthfully and accurately today?</p> <p>19 A. No.</p> <p>20 Q. And as the -- was read into the</p> <p>21 record earlier, the deposition today pertains to</p> <p>22 the two IPRs. I'll just read the numbers.</p> <p>23 IPR2022-00142 and IPR2022-00146.</p> <p>24 And do you understand that your</p> <p>25 testimony today at this deposition pertains to</p> |

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| <p style="text-align: right;">14</p> <p>1 the opinions that you offered in those two</p> <p>2 proceedings?</p> <p>3 A. Yes.</p> <p>4 Q. Okay.</p> <p>5 MR. DINER: So we'll be marking the</p> <p>6 first exhibit. This will be Sher Exhibit</p> <p>7 No. 1.</p> <p>8 MS. CIPRIANO: Thank you.</p> <p>9 MR. DINER: You're welcome.</p> <p>10 (Sher Deposition Exhibit 1 was</p> <p>11 marked for identification.)</p> <p>12 BY MR. DINER:</p> <p>13 Q. Dr. Sher, the court reporter has just</p> <p>14 handed you what has been marked as Sher</p> <p>15 Exhibit 1.</p> <p>16 Do you recognize this document as the</p> <p>17 declaration that you offered in IPR2022-00142?</p> <p>18 A. Yes.</p> <p>19 Q. And this pertains to -- you can read</p> <p>20 from the front of it -- to U.S. Patent</p> <p>21 8,293,742.</p> <p>22 Do you see that?</p> <p>23 A. Yes.</p> <p>24 Q. Can I refer to this as the '742</p> <p>25 declaration? Will that be a good easy shorthand</p> | <p style="text-align: right;">16</p> <p>1 declaration?</p> <p>2 A. There -- there were several -- a</p> <p>3 number of areas that I would go over and put in</p> <p>4 the sections, particularly on my background and</p> <p>5 such. But there were numerous areas that I</p> <p>6 prepared.</p> <p>7 Q. Do you remember those areas generally</p> <p>8 other than your background?</p> <p>9 A. Had to do with descriptions of some</p> <p>10 of the procedures and descriptions of some of</p> <p>11 the references in exhibits.</p> <p>12 Q. Okay. Do you recall how many hours,</p> <p>13 generally speaking, you spent preparing the '742</p> <p>14 declaration?</p> <p>15 A. I prepared both the '742 and the '425</p> <p>16 will be referred to. And I would say that I</p> <p>17 have to look at my spreadsheets and the bills</p> <p>18 but probably 30 to 40 hours for both.</p> <p>19 Q. So that's 30 to 40 hours total to</p> <p>20 prepare both the '742 and the '425 declarations?</p> <p>21 A. That sounds about right.</p> <p>22 Q. Okay. Does that include the time you</p> <p>23 spent reviewing the materials that you cite</p> <p>24 throughout your '742 and '425 declarations?</p> <p>25 A. I don't understand the question.</p> |
| <p style="text-align: right;">15</p> <p>1 for you as well?</p> <p>2 A. Yes, please.</p> <p>3 Q. And Sher Exhibit 1 is the declaration</p> <p>4 that you submitted in connection with your</p> <p>5 opinions in the inter partes review related to</p> <p>6 the '742 patent, right?</p> <p>7 A. Yes, sir.</p> <p>8 Q. Just turn to page 66 of Sher</p> <p>9 Exhibit 1.</p> <p>10 Is that your signature on page 66</p> <p>11 dated November 4th, 2021?</p> <p>12 A. Yes.</p> <p>13 Q. And who prepared your '742</p> <p>14 declaration?</p> <p>15 A. I worked with Mr. Weinstein and it</p> <p>16 was an iterative process and it was prepared</p> <p>17 together.</p> <p>18 Q. Okay. Did you type this declaration?</p> <p>19 A. Not the final one, no.</p> <p>20 Q. Okay. Did you contribute some text</p> <p>21 that you composed yourself to this declaration?</p> <p>22 A. Yes.</p> <p>23 Q. Do you recall what sections of the</p> <p>24 declaration that you composed yourself that</p> <p>25 would have -- you would have contributed to this</p> | <p style="text-align: right;">17</p> <p>1 Q. The 30 to 40 hours total, does that</p> <p>2 also include the time you would have spent</p> <p>3 reviewing the materials that you cited in your</p> <p>4 declarations?</p> <p>5 A. Yes.</p> <p>6 Q. Okay. Are there any corrections you</p> <p>7 would like to make to your declaration today?</p> <p>8 A. Yes.</p> <p>9 Q. Which is?</p> <p>10 A. I noted recently in going over this,</p> <p>11 we referenced an article by -- actually one of</p> <p>12 my friends wrote it -- by Pasquali. It came</p> <p>13 from Kansas City and the office was Dr. Durrie.</p> <p>14 Pasquali had to do with the use of</p> <p>15 brimonidine for LASIK. And I believe it's not</p> <p>16 clear. And it may have -- it said radial</p> <p>17 keratotomy but it had to do with LASIK, that</p> <p>18 particular study.</p> <p>19 Q. Anything else?</p> <p>20 A. No.</p> <p>21 Q. Okay. Could you turn to the next</p> <p>22 page, 67?</p> <p>23 A. I'm sorry. What -- what page?</p> <p>24 Q. Page 67. At the top you'll see</p> <p>25 Exhibit A.</p> |

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