

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 REPLY

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	CLAIM CONSTRUCTION	1
	A. Ocular Condition	1
	B. “About 0.025%”	2
III.	THE ’553 PATENT ANTICIPATES CLAIMS 1 AND 2	7
IV.	THE CHALLENGED CLAIMS ARE OBVIOUS	9
	A. The Prior Art Taught Toward Brimonidine, Not Away.....	10
	B. A POSA Would Not Have Understood Brimonidine’s Ability to Reduce Redness to Be Concentration Dependent.....	15
	C. POSA Would Have Been Motivated to Use pH Within the Claimed Range.....	17
	1. There Was No Recognized “Progression” Toward Higher pH	18
	2. Eye Redness Relievers Work on the Surface of the Eye	19
	3. There Is a Range of pH That Is Tolerable to Patients.....	20
	D. A POSA Would Have Been Able to Make the Claimed Formulations With Routine Skill.....	21
	E. Claims 4-6 Are Also Obvious	22
	F. Secondary Considerations Are Insufficient to Overcome an Obviousness Finding	22

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>ABT Sys., LLC v. Emerson Elec. Co.</i> , 797 F.3d 1350 (Fed. Cir. 2015)	24
<i>Amgen Inc. v. Hoeschst Marion Roussel, Inc.</i> , 314 F.3d 1313 (Fed. Cir. 2003)	9, 11
<i>Bristol-Myers Squibb Co. v. Teva Pharms. USA, Inc.</i> , 752 F.3d 967 (Fed. Cir. 2014)	24
<i>C.R. Bard, Inc. v. Medline Indus., Inc.</i> , No. 2020-1900, 2021 WL 3574043 (Fed. Cir. Aug. 13, 2021).....	12, 13
<i>Ethicon Endo-Surgery, Inc. v. Covidien LP</i> , 812 F.3d 1023 (Fed. Cir. 2016)	25, 26
<i>Fox Factory, Inc. v. SRAM, LLC</i> , 944 F.3d 1366 (Fed. Cir. 2019)	23
<i>In re Fulton</i> , 391 F.3d 1195 (Fed. Cir. 2004)	17
<i>Hill-Rom Serv., Inc. v. Stryker Corp.</i> , 755 F.3d 1367 (Fed. Cir. 2014)	2
<i>Micron Tech., Inc. v. Lone Star Silicon Innovations LLC</i> , IPR2017-01562, 2018 WL 6602102 (P.T.A.B. Dec. 13, 2018).....	3
<i>Microsoft Corp. v. Mira Advanced Tech., Inc.</i> , IPR2017-01411, 2018 WL 6204170 (P.T.A.B. Nov. 27, 2018).....	3
<i>Ormco Corp. v. Align Tech., Inc.</i> , 463 F.3d 1299 (Fed. Cir. 2006)	23
<i>Ortho-McNeil Pharm., Inc. v. Caraco Pharm. Lab'ys</i> , 476 F.3d 1321 (Fed. Cir. 2007)	4
<i>Par Pharm., Inc. v. Hospira, Inc.</i> , 835 F. App'x 578 (Fed. Cir. 2020)	4

Case IPR2022-00142

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

In re Peterson,

315 F.3d 1325 (Fed. Cir. 2003)17, 24

Pfizer, Inc. v. Apotex, Inc.,

480 F.3d 1348 (Fed. Cir. 2007)22

Schering Corp v. Geneva Pharms.,

339 F.3d 1373 (Fed. Cir. 2003)8, 9

Vitronics Corp. v. Conceptronic, Inc.,

90 F.3d 1576 (Fed. Cir. 1996)6

EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 8,293,742 (filed July 27, 2009) (issued Oct. 23, 2012) ('742 Patent)
1002	Expert Declaration of Neal A. Sher, M.D. (Sher)
1003	Expert Declaration of Paul A. Laskar, Ph.D. (Laskar)
1004	U.S. Patent No. 6,294,553 (filed Feb. 14, 2001) (issued Sep. 25, 2001) ('553 patent)
1005	Walters, Thomas R., et al. "A Pilot Study of Life Efficacy and Safety of AGN 190342-Lf 0.02% And 0.08% In Patients with Elevated Intraocular Pressure." <i>Association for Research in Vision and Ophthalmology</i> , vol. 32, no. 4, 15 Mar. 1991, p. 988 (Walters 1991)
1006	Norden, Richard A. "Effect of Prophylactic Brimonidine on Bleeding Complications and Flap Adherence after Laser in Situ Keratomileusis." <i>Journal of Refractive Surgery</i> , vol. 18, no. 4, 2002, pp. 468–471 (Norden 2002)
1007	U.S. Patent 6,242,442 (filed Dec. 7, 1999) (issued June 5, 2001) ('442 patent)
1008	"ALPHAGAN® (brimonidine tartrate ophthalmic solution) 0.2%." Physicians' Desk Reference, 52th ed., Medical Economics Company, Inc., 1998, p. 487 (Alphagan® Label 1998)
1009	53 Fed. Reg. 7076-7093 (Mar. 4, 1988) (Federal Register 1988)
1010	U.S. Application 12/460,941 filed July 27, 2009, downloaded from PAIR ('941 Application)
1011	U.S. Provisional Application 61/207,481 filed February 12, 2009, downloaded from PAIR ('481 Provisional)

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.