

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHNSON & JOHNSON SURGICAL VISION, INC.,
Petitioner,

v.

ALCON INC.,
Patent Owner.

IPR2021-01069
Patent 9,456,925 B2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,
and JAMIE T. WISZ, *Administrative Patent Judges*.

WISZ, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 325(d)

I. INTRODUCTION

Johnson & Johnson Surgical Vision, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1, 2, 4, 5, 11, 12, 17, 23, 24, 26, and 27 of U.S. Patent No. 9,456,925 B2 (Ex. 1001, “the ’925 patent”). Alcon Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). With Board pre-authorization (Ex. 1022), Petitioner filed a Reply (Paper 14, “Reply”), and Patent Owner filed a Sur-reply (Paper 15, “PO Sur-reply”) limited to addressing whether the Board should exercise its discretion and deny review under 35 U.S.C. § 325(d).

Under 35 U.S.C. § 314(a), the Board “may not authorize an *inter partes* review to be instituted unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” The Board has discretion to deny a request for institution when the information presented shows a petitioner raises “the same or substantially the same prior art or arguments previously presented to the Office,” for example, during patent examination. 35 U.S.C. § 325(d).

For the reasons stated below, upon considering the arguments and evidence, we exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

II. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies Johnson & Johnson Surgical Vision, Inc., and its subsidiaries AMO Development, LLC, AMO Manufacturing USA, LLC, and AMO Sales and Service, Inc. as the real parties-in-interest. Pet. 64.

Patent Owner identifies Alcon Vision, LLC, and Alcon Research, LLC, as the real parties-in-interest. Paper 4, 1.

B. Related Proceedings

Both parties identify as a related matter co-pending district court litigation in *AMO Development, LLC v. Alcon LenSx Inc.*, No. 1:20-cv-00842-CFC (D. Del.). Pet. 64; Paper 4, 1.

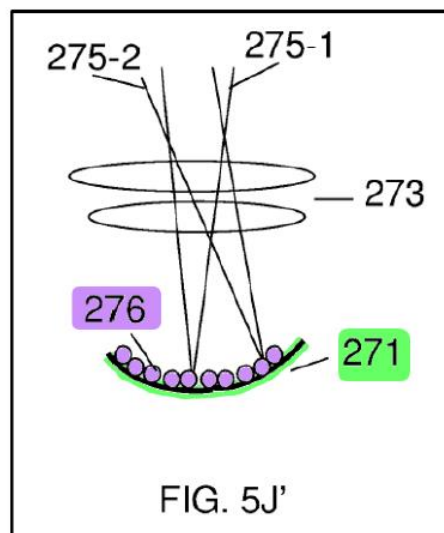
C. The '925 Patent (Ex. 1001)

The '925 patent is titled, “Photodisruptive Laser Treatment of the Crystalline Lens,” and relates to methods of treating a hard lens region of an eye with a laser, for example, for cataract surgery. Ex. 1001, codes (54), (57), 5:60–6:38. Cataracts are an eye condition that occurs when the lens transparency decreases and stiffness of the lens increases. *Id.* at 5:60–6:8. The reduced transparency region of the lens can be removed and replaced with an artificial intraocular lens. *Id.* at 6:9–20. Surgical procedures to remove the crystalline lens utilize various techniques (such as manual instruments, ultrasound, heated fluids and lasers), to break up the lens into small fragments that can be removed from the eye through incisions. *Id.* at 1:23–27. According to the '925 patent, “[p]hotodisruptive laser technology can deliver laser pulses into the lens to optically fragment the lens without insertion of a probe and thus is potentially a less intrusive procedure, offering higher precision and control.” *Id.* at 1:33–36.

A laser-induced lens fragmentation process involves using the laser to ionize a targeted portion of the hard lens region, resulting in the formation of cavitation bubbles. Ex. 1001, 7:4–11. These bubbles aid in the disruption, fragmentation, or emulsification of the targeted hard lens region, which can then be removed via aspiration through a smaller incision, or possibly

without inserting a surgical device into the lens itself. *Id.* at 7:16–21, 7:49–59.

The '925 patent describes using a laser to make certain types of “non-transverse” incisions in the lens. Ex. 1001, 4:6–7, 12:37–13:4. These non-transverse incisions follow the Z axis, which passes through the middle of the eye. *Id.* at 11:41–61, 12:38–41. The '925 patent describes one embodiment in which the incisions are formed “on a layer-by-layer basis, wherein one or more layers are at least partially formed along a curved focal plane of a laser delivery system.” *Id.* at 3:46–49. This is shown in Figure 5J' (annotated by Petitioner) below:



Pet. 6, Ex. 1001, Fig. 5J'. Annotated Figure 5J' from the '925 patent shows the focal plane 271 (highlighted in green) is curved and the incision 276 formed by the cavitation bubbles (highlighted in purple) follows the curvature of the focal plane 271. Pet. 6; Ex. 1001, 19:44–55.

According to the '925 patent, forming the curved incisions along a curved focal plane reduces or eliminates the need to move the Z scanner at the rate of the X-Y scanner. Ex. 1001, 19:53–55. This technique allows the

scanners to operate “at the fast X-Y transverse scanning speed instead of the slower z-scanning speed.” *Id.* at 19:55–57.

D. Challenged Claims

Petitioner challenges claims 1, 2, 4, 5, 11, 12, 17, 23, 24, 26, and 27 of the '925 patent. Claim 1, which is the only independent claim of the '925 patent, is illustrative of the challenged claims, and is reproduced below:

1. A method of treating a crystalline lens of an eye with a laser, the method comprising:

selecting a surgical region of the lens; and

forming an incision in the surgical region on a layer-by-layer basis by scanning a laser beam with an XY scanner of a laser delivery optics along a curved focal plane of the laser delivery optics to form a line of bubbles in each layer without adjusting a Z scanner of the laser delivery optics at a scanning rate of the XY scanner, wherein:

an orientation of a portion of the incisions is one of an orientation intersecting fibers of the lens and an orientation non-transverse to an axis of the eye; and

the incision has a spatial extent in a Z direction in the range of 0.5-10 mm, and in an X-Y plane in the range of 2-10 mm.

Ex. 1001, 40:46–61. Challenged claims 2, 4, 5, 11, 12, 17, 23, 24, 26, and 27 depend from claim 1, either directly or indirectly.

E. The Asserted Grounds of Unpatentability

Petitioner contends claims 1, 2, 4, 5, 11, 12, 17, 23, 24, 26, and 27 of the '925 patent (“the challenged claims”) are unpatentable in view of the following grounds.

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1, 2, 4, 5, 11, 12, 17, 23, 24, 26	103	Frey ¹ , Knowledge in the Art
2	17, 27	103	Frey, Blumenkranz ² , Knowledge in the Art
3	1, 2, 4, 5, 11, 12, 17, 23, 24, 26, 27	103	Blumenkranz, Frey, Knowledge in the Art

Pet. 2. Petitioner submits the Declaration of Georg Schuele, Ph.D. (Ex. 1004) in support of institution of *inter partes* review. Patent Owner submits the Declaration of Edward A. DeHoog, Ph.D. (Ex. 2001) in support of its Preliminary Response.

III. DENIAL UNDER 35 U.S.C. § 325(d)

Patent Owner asserts that we should deny the Petition under 35 U.S.C. § 325(d) because the Petition presents the same art and arguments that the Office previously analyzed and fails to show that the Office erred during prosecution. Prelim. Resp. 20.

We have discretion to deny review when “the same or substantially the same prior art or arguments previously were presented to the Office.”

¹ Frey et al., WO 2007/084602, published July 26, 2007 (Ex. 1006, “Frey”).

² Blumenkranz et al., US 2006/0195076 A1, published Aug. 31, 2006 (Ex. 1008, “Blumenkranz”).

35 U.S.C. § 325(d) (“Section 325(d)”). In that respect, Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office.³ *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

In evaluating the exercise of discretion to deny institution under Section 325(d), the Board uses the following two-part framework: (1) determining whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, determining whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, Paper 6 at 8.

In applying the two-part framework, we consider several non-exclusive factors, including:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art;

³ The Board institutes trial on behalf of the Director. 37 C.F.R. § 42.4(a).

- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (“*Becton, Dickinson*”).

Factors (a), (b), and (d) of the *Becton, Dickinson* factors relate to whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Only if the same or substantially the same art or arguments were previously presented to the Office do we then consider whether petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

A. The ’925 Patent Prosecution History

The original application for the ’925 patent was filed with thirty-nine claims. Ex. 1002, 65–72.⁴ While original claim 1 did not include the limitation that the laser be scanned “along a curved focal plane,” as recited in issued claim 1, dependent claim 27 recited that the incision layers were at

⁴ The cited page numbers in Exhibit 1002 refer to the page numbers added by Petitioner in the bottom-right corner of the page.

least partially formed “along a curved focal plane.” *Id.* at 70. An Information Disclosure Statement (“IDS”) submitted on April 7, 2010 cited Blumenkranz and was marked as considered by the Examiner. *Id.* at 135, 446.

In a Non-Final Office action on March 21, 2014, the Examiner rejected claim 1 as anticipated by Gray⁵ and claim 27 as obvious over Gray in view of Bille.⁶ Ex. 1002, 1066–1085. With respect to claim 27, the Examiner stated that, although Gray “discloses a system and method for delivering a laser beam to a lens of an eye,” it “does not expressly disclose the method . . . wherein one or more layers are at least partially formed along a curved focal plane of a laser delivery system.” *Id.* at 1075–1076. The Examiner relied on the knowledge of “one skilled in the art” in combination with Bille to teach that feature. *Id.*

The applicant subsequently amended claim 1 by adding, “forming an incision in the surgical region on a layer-by-layer basis by scanning a laser beam with an XY scanner of a laser delivery optics along *a curved focal plane* of the laser delivery optics to form a line of bubbles in each layer without adjusting a Z scanner of the laser delivery optics at a scanning rate of the XY scanner,” and argued for the patentability of amended claim 1 over Gray. Ex. 1002, 1093, 1102–1103 (emphasis added). The applicant

⁵ Frey et al., US 2007/0185475 A1, published Aug. 9, 2007 (Ex. 1020, “Gray”). Although the Examiner referred to this application as “Frey” during prosecution of the ’925 patent, Petitioner and Patent Owner refer to it as “Gray” to avoid confusion with the Frey reference cited *supra*. Pet. 8 n.3; Prelim. Resp. 6 n.1. To be consistent with how the parties describe this reference, we will also refer to it as “Gray.”

⁶ Bille et al., U.S. Patent No. 5,439,462, issued Aug. 8, 1995 (“Bille”).

argued that “the Office Action did not point to any portion of [Gray] where [Gray] would have described the newly added limitation ‘scanning a laser beam with an XY scanner of a laser delivery optics along a curved focal plane.’” *Id.* at 1102. The applicant also stated that it had “reviewed [Gray] at the non-referenced locations as well, but found no express mention of such a limitation either.” *Id.* at 1103. The applicant further argued that:

[S]canning the laser beam along a curved focal plane is not equivalent either to scanning along a flat, or transverse, focal plane in the context of the claimed method, since the claimed method is directed towards “forming an incision” with an orientation that is “one of an orientation intersecting fibers of the lens and an orientation non-transverse to an axis of the eye”. When scanning a laser beam with an XY scanner along a curved focal plane, then each line of bubbles can intersect fibers or can form an incision with an orientation non-transverse to an axis of the eye, making the method more effective than methods that XY scan in a flat plane.

Id.

In a September 25, 2014 Final Rejection, the Examiner maintained all the same rejections against the claims and provided additional analysis of Gray. Ex. 1002, 1111–1129. The Examiner asserted that Gray discloses the curved focal plane limitation added to claim 1 because Gray discloses that in “all of the laser shot patterns,” “the laser shot patterns generally follow the shape of the lens.” *Id.* at 1111–1113, 1129 (citing Ex. 1020, Fig. 19, ¶¶ 92, 107) (emphasis omitted). With respect to claim 27, the Examiner argued that Gray in view of Bille rendered obvious the curved focal plane limitation because “one skilled in the art would recognize that using [] the method of [Gray] [to form] the incision on a layer-by-layer basis and layers are at least partially formed along a curved focal plane, as taught by Bille, would allow

the operator to input the curvature of the posterior capsule and the anterior capsule.” *Id.* at 1120.

In a December 23, 2014 response, the applicant did not substantively amend the claims but, instead, argued that Gray does not describe scanning “along a curved focal plane” “either explicitly or inherently.” Ex. 1002, 1157–1158 (emphasis omitted). The applicant stated that it had “searched the entire [Gray] document and did not readily find a corresponding description either.” *Id.* at 1158. The applicant also argued that “[Gray] does not even inherently describe ‘scanning . . . along a curved focal plane’” because “following the shape of the lens at the periphery requires varying the Z depth of the cut quite fast.” *Id.*

In a March 23, 2015 Non-Final Rejection, the Examiner again maintained the same rejections and provided additional analysis of Gray’s disclosure in asserting that Gray discloses laser delivery optics along a curved focal plane. Ex. 1002, 1249–1256, 1267–1270 (citing Ex. 1020, Figs. 19, 28, 29, ¶¶ 107, 115, 121). Specifically, the Examiner pointed to Gray’s Figure 28B and argued “position 2801 is an incision in the surgical region on a layer-by-layer basis by scanning a laser beam with an XY scanner of a laser delivery optics along a curved focal plane without adjusting a Z scanner of the lase [sic] delivery optics.” Ex. 1002, 1251–1252, 1269–1270 (citing Ex. 1020, Fig. 28B (reproduced below)).

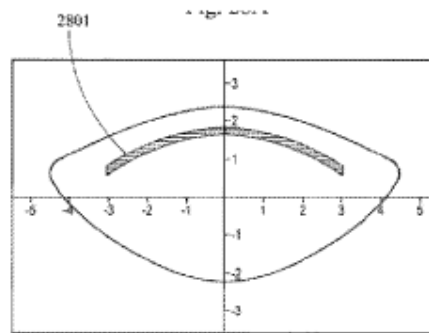


Fig. 28B

Id. at 1252. Figure 28B shows the cutting pattern 2801 in the anterior portion of the lens. Ex. 1020, ¶ 121.

In a June 23, 2015 response, the applicant again argued that Gray does not disclose scanning along a curved focal plane either “explicitly” or “inherently.” Ex. 1002, 1297–1300. Specifically, the applicant argued that Gray’s “layer-by-layer embodiments clearly show flat shot-layers, not curved ones” that “follow[] the shape of the lens” because each layer starts and ends “at different XY coordinates.” *Id.* at 1298. The applicant also argued that the feature is not inherent to Gray because:

To recognize that (1) a focal plane of the laser system can be curved, and (2) to exploit this curvature to increase the speed, and (3) to increase the safety of the surgical procedure were all inventive insights by Applicant, and are thus not inherent without express disclosure. [Gray] did not recognize any of these points (1)–(3), that his focal planes can be curved, that creating the flat cuts can pose safety challenges, and that Applicant’s claimed combination can turn a potential problem into an advantage both for safety and for speed.

Id. at 1299.

In an October 19, 2015 Non-Final Rejection, the Examiner again rejected claim 1, this time as being obvious over Gray in view of Bille. Ex. 1002, 1336. In this rejection, the Examiner stated that, “[Gray] does not

clearly disclose forming an incision in the surgical region on a layer-by-layer basis by scanning a laser beam with an XY scanner of a laser delivery optics along a curved focal plane of the laser delivery optics to form a line of bubbles in each layer.” *Id.* at 1339, 1358. However, the Examiner argued that one skilled in the art would have known how to scan along a curved focal plane in light of Bille, since “one skilled in the art would recognize that modifying the method of [Gray] with using the wavefront detector and ellipsometer, as taught by Bille, would improve the method by forming an incision in the surgical region by scanning a laser beam along a curved focal plane.” *Id.* at 1340, 1359.

In a final response on January 19, 2016, the applicant again argued that Gray does not “explicitly” or “inherently” disclose the curved focal plane limitation. Ex. 1002, 1395–1399. For example, the applicant contended:

Applicant agrees that [Gray] showed and described curved incisions. However, [Gray] never taught forming these curved incisions (a) along a curved focal plane of the laser delivery optics, and (b) without adjusting his Z scanner. These ideas require the recognition that forming curved incisions has a slowness problem, and that this problem can be solved by designing the optics with a curved focal plane that tracks the curvature of the ophthalmic targets. Such systems can create curved incisions much faster than systems without such a suitably curved focal plane.

The Office Action was unable to point to an explicit description of a laser optical system with a curved focal plane by [Gray]. Moreover, [Gray] does not describe curved focal planes inherently either, because curved incisions can be created by more than one technique: by Applicant’s inventive curved focal plane optics, or by designing a controller that adjusts the XY and the Z scanners simultaneously to form the

curved incision. Therefore, the description of a system that creates a curved incision is not a description of a system with a curved focal plane. Thus, the curved focal plane system is not inherent either in [Gray].

Id. at 1395.

The Examiner then issued a Notice of Allowance in which the Examiner stated that the closest prior art (including Gray) failed to “teach, suggest or render obvious: ‘forming an incision in the surgical region on a layer-by-layer basis by scanning a laser beam with an XY scanner of a laser delivery optics along a curved focal plane of the laser delivery optics to form a line of bubbles in each layer without adjusting a Z scanner of the laser delivery optics at a scanning rate of the XY scanner.’” Ex. 1002, 1409–1410.

B. Same or Substantially the Same Art or Arguments Previously Presented to the Office

We first consider whether Petitioner asserts the same or substantially the same art or arguments that previously were presented to the Office.

Advanced Bionics, Paper 6 at 8.

Petitioner’s grounds rely on two references – Frey and Blumenkranz – to show obviousness of the challenged claims. Pet. 2. Patent Owner argues that Gray, which is the published U.S. Patent Application version of Frey, is substantively identical to Frey and was cited by the Examiner in four Office Actions during prosecution of the ’925 patent. Prelim. Resp. 6, 22. Patent Owner also points out that Blumenkranz was cited in an IDS during prosecution. *Id.* at 21. Petitioner acknowledges that Gray was discussed by the Examiner and that it has substantially the same disclosure as Frey. Pet. 8 n.3, 61. Petitioner also acknowledges that Blumenkranz was cited in

an IDS but asserts that “nothing in the record indicates that the Examiner substantively considered it.” *Id.* at 63.

Under *Advanced Bionics*, “[p]reviously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, Paper 6 at 7–8. Because Gray, which is substantially identical to Frey, and Blumenkranz were before the Office during prosecution of the ’925 patent, we find that the same or substantially the same art was previously presented and we move on to the second part of the *Advanced Bionics* framework.

C. Whether the Office Erred in a Manner Material to Patentability

Because we find that the same or substantially the same art previously was presented to the Office, we turn to whether Petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 8, 10; see *Becton, Dickinson*, Paper 8 at 24. We conclude that Petitioner has failed to do so.

Petitioner asserts that the Examiner “overlooked and failed to consider Gray’s disclosure of ‘conventional focusing optics,’ which provides a curved focal plane.” Pet. 61. Specifically, Petitioner contends that the Examiner erred by overlooking the disclosure in paragraph 65 of Frey (paragraph 64 of Gray), which allegedly teaches curved focal plane optics. Reply 2. Paragraph 65 of Frey states that “[t]he focusing optics may be conventional focusing optics, and/or flat field optics and/or telecentric optics.” Ex. 1006 ¶ 65; Ex. 1020 ¶ 64. Petitioner contends that one of skill in the art would have known that the “conventional focusing optics” discussed in paragraph 65 of Frey have a curved focal plane. Pet. 18–21 (citing Ex. 1004

¶¶ 55–57, 81). According to Petitioner, the “prosecution history nowhere suggests that the Examiner implicitly evaluated whether Frey [0065]’s ‘conventional focusing optics’ disclose curved focal plane optics” and that the Examiner never “relied on disclosures of Frey’s optics” in rejecting the claims but, rather, relied on paragraphs describing Frey’s laser patterns for cutting the lens. Reply 2–3.

Patent Owner argues that Petitioner fails to meet its burden of showing material error by the Office because “the Office considered and reconsidered Gray’s disclosure in response to Applicant’s repeated arguments that Gray did not ‘explicitly’ or ‘inherently’ disclose the curved focal plane limitation” and because paragraph 65 of Frey does not describe a “curved focal plane.” Prelim. Resp. 22. According to Patent Owner, “[a]fter four rounds of active debate over what Gray disclosed, spanning over 80 pages of analysis, the Examiner allowed the claims,” which was not an error. *Id.* at 14; PO Sur-reply 2.

On this record, we agree with Patent Owner that the Office previously conducted an extensive analysis of whether Gray discloses a “curved focal plane” and Petitioner has not demonstrated that the Examiner materially erred. As described *supra*, the issue of whether Gray “explicitly” or “inherently” discloses a “curved focal plane” was specifically discussed by the Examiner and the applicant during prosecution, spanning 82 pages of the file history. See Prelim. Resp. 23. Petitioner directs us to no persuasive evidence that the Examiner, who was “engaged with the prior art and the ‘curved focal plane’ limitation,” erred by “fail[ing] to consider Gray’s disclosure of ‘conventional focusing optics.’” PO Sur-reply 3; Pet. 61. Patent Owner, by contrast, directs us to persuasive evidence from the

prosecution history supporting the position that the Examiner considered whether Gray discloses this limitation.

For example, in the first rejection (of claim 27) based on Gray, the Examiner stated that Gray lacked the “curved focal plane” limitation and relied on the secondary reference, Bille, for that teaching. Ex. 1002, 1075–1076. The applicant responded by amending claim 1 to include the “curved focal plane” element and argued that it had reviewed Gray “at the non-referenced locations as well, but found no express mention of such a limitation either.” *Id.* at 1103. After claim 1 was amended to include the “curved focal plane” limitation, the Examiner then rejected claim 1 as anticipated by Gray and cited to Gray’s disclosure that the “laser shot patterns generally follow the shape of the lens.” *Id.* at 1129. In response, the applicant disagreed with the Examiner’s analysis and stated that it had “searched the entire [Gray] document” and could not find any “express” or “inherent” disclosure of this limitation. *Id.* at 1158. The Examiner responded by citing to new portions of Gray to support a maintained anticipation rejection. *Id.* at 1249–1252. When the applicant again argued that Gray does not “explicitly” or “inherently” teach the “curved focal plane” limitation, the Examiner acknowledged this element was missing from Gray but argued that it would have been obvious in view of Bille. *Id.* at 1339–1340. In sum, the prosecution history demonstrates that the Examiner reevaluated the Gray disclosure after each of the applicant’s arguments and presented different analysis and citations in each of the four rejections involving Gray. *Id.* at 1064, 1109, 1247, 1334. Ultimately, the Examiner determined that Gray does not disclose the “curved focal plane” limitation and allowed the claims. *Id.* at 1409–1410.

The detailed and extensive analysis in the prosecution history of whether Gray discloses a “curved focal plane” undermines Petitioner’s argument that the Examiner overlooked and failed to consider Gray’s disclosure of “conventional focusing optics.” We are not persuaded by Petitioner’s argument that the Examiner never “relied on disclosures of Frey’s optics” in rejecting the claims but, rather, relied on Frey’s laser patterns for cutting the lens. Reply 2–3. The claim limitation at issue during prosecution recited “forming an incision in the surgical region on a layer-by-layer basis by scanning a laser beam with an XY scanner *of a laser delivery optics* along a curved focal plane *of the laser delivery optics*.” Ex. 1002, 1093 (emphasis added). Petitioner’s contention that the Examiner did not consider the delivery optics disclosed in Gray when specifically analyzing this claim limitation is not persuasive.

Similarly, we are also not persuaded by Petitioner’s argument that the Examiner’s failure to specifically cite paragraph 64 of Gray suggests that the Examiner never “evaluated whether Frey [0065]’s ‘conventional focusing optics’ disclose curved focal plane optics.” Reply 2–3. For the reasons discussed above, we agree with Patent Owner that “[t]he thorough prosecution history demonstrates an Examiner engaged with the prior art and the ‘curved focal plane’ limitation,” and that Petitioner has not sufficiently demonstrated how the Examiner erred in its evaluation of Gray. PO Sur-reply 3. *Advanced Bionics*, Paper 6 at 9 (“[I]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.”). Thus, we find that Petitioner has not persuasively shown that the Office erred in a manner material to the patentability of the challenged claims.

D. Conclusion as to Section 325(d)

For the reasons set forth above, we do not institute review of claims 1, 2, 4, 5, 11, 12, 17, 23, 24, 26, and 27 because, under 35 U.S.C. § 325(d), the same or substantially the same art previously was presented to the Office, and Petitioner has not shown that the Office erred in a manner material to patentability.

IV. CONCLUSION

For the foregoing reasons, we exercise discretion not to institute *inter partes* review under 35 U.S.C. § 325(d).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

IPR2021-01069
Patent 9,456,925 B2

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