

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IVANTIS, INC., ALCON RESEARCH, LLC,
ALCON VISION, LLC, and ALCON INC.,
Petitioner,
v.

SIGHT SCIENCES, INC.,
Patent Owner.

IPR2022-01529
Patent 9,370,443 B2

Before ULRIKE W. JENKS, SUSAN L. C. MITCHELL, and
ZHENYU YANG, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background*

Ivantis, Inc., Alcon Research, LLC, Alcon Vision, LLC, and Alcon Inc. (collectively, “Petitioner”) filed a Petition for an *inter partes* review of claims 1, 8, 11, 12, 21, 23, 24, 27, 42, 43, 46, 52, 54–59, 70, and 71 (“the challenged claims”) of U.S. Patent No. 9,370,443 B2 (Ex. 1003, “the ’443 patent”). Paper 2 (“Pet.”). Sight Sciences, Inc. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”).

With our authorization, the parties filed additional pre-institution briefing to address whether we should exercise our discretion under 35 U.S.C. §§ 314(a) or 325(d). *See* Paper 12. Petitioner filed “Petitioner’s Reply to Patent Owner’s Preliminary Response” addressing these issues. Paper 13 (“Reply”). Patent Owner filed “Patent Owner Sur-Reply” in response. Paper 14 (“Sur-Reply”).

B. *Summary of the Institution Decision*

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2020). For the reasons provided below, under 35 U.S.C. § 325(d), we deny institution of an *inter partes* review.

C. *Real Parties in Interest*

Petitioner identifies Ivantis, Inc., Alcon Research, LLC, Alcon Vision, LLC, and Alcon Inc. as the real parties-in-interest. Pet. 2. Patent Owner identifies itself, Sight Sciences, Inc., as real party-in-interest. Paper 4, 1.

D. *Related Matters*

The '443 patent is at issue in *Sight Sciences, Inc. v. Ivantis, Inc.*, C.A. No. 21-1317-GBW-SRF (D. Del.). Pet. 2; Paper 4, 1. Petitioner states that it is “concurrently filing IPR petitions for three other patents in the same family as the '443 patent, all of which are asserted in the Delaware Litigation: U.S. Patent Nos. 8,287,482 (“’482”); 9,486,361 (“’361”); and 10,314,742 (“’742”).” Pet. 2. These filed petitions are IPR2022-01533, IPR2022-01540, and IPR2022-01530, respectively. Paper 12, 1.

E. *Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of the challenged claims of the '443 patent on following grounds:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1, 8, 11, 12, 21, 23, 24, 27, 42, 43, 46, 52, 54–57	103(a)	Gharib ² , Bergheim ³
58, 59, 70, 71	103(a)	Gharib, Bergheim, Burns ⁴
1, 8, 11, 12, 27, 42, 43, 46, 52, 54–57	103(a)	Lynch ⁵ , Bergheim
21, 23, 24	103(a)	Lynch, Bergheim, Gharib
58, 59, 70, 71	103(a)	Lynch, Bergheim, Burns

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '443 patent issued from an application that claims priority to an application filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

² U.S. Patent Application Publication No. 2002/0165478 A1, published November 7, 2002 (Ex. 1005, “Gharib ’478”).

³ U.S. Patent Application Publication No. 2003/0060752 A1, published March 27, 2003 (Ex. 1006).

⁴ U.S. Patent Application Publication No. 2004/0147870 A1, published July 29, 2004 (Ex. 1007).

⁵ U.S. Patent Application Publication No. 2005/0038334 A1, published Feb. 17, 2005 (Ex. 1008).

Pet. 4. In support of its patentability challenge, Petitioner relies on, *inter alia*, the Declaration of Dr. Michael Reynard. Ex. 1001.

F. *The '443 patent (Ex. 1003)*

The '443 patent is titled “Intraocular Implants and Methods and Kits Therefor.” Ex. 1003, code (54). The '443 patent relates to devices implanted into the eye “for reducing intraocular pressure” by using “the natural drainage process of the eye.” *Id.* at code (57).

Figure 2 of the '443 patent is reproduced below.

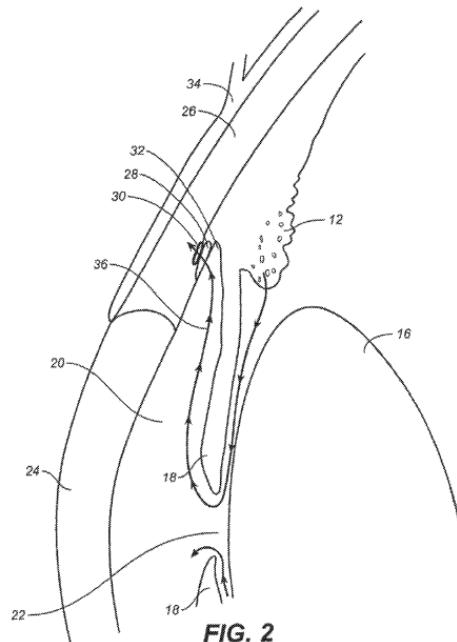


Figure 2, above, is a partial cross-sectional side view of a normal fluid drainage path from the eye. *Id.* at 5:13–14. Figure 2 depicts the general flow of aqueous humor from ciliary body 12, between lens 16 and iris 18, through pupil 22 into the anterior chamber 20, across the trabecular meshwork 28, across Schlemm's canal 30, and into aqueous veins or collector channels (not shown). *Id.* at 6:39–48. Schlemm's canal 30 extends 360° circumferentially around trabecular meshwork 28. *Id.* at 6:34–35; Fig. 3.

Glaucoma is characterized by an increase in intraocular pressure, which may lead to blindness if left untreated. *Id.* at 1:23–28. To treat glaucoma, pre-glaucoma, and ocular hypertension, the '443 patent explains that the standard surgical treatment of “trabeculectomy, or filtration surgery . . . creat[es] a new drainage site for aqueous humor.” *Id.* at 2:4–7. Trabeculectomy, however, introduces the risk of, *inter alia*, “blockage of the surgically-created opening through scarring or other mechanisms, hypotony or abnormally low intraocular pressure” *Id.* at 2:16–18.

As an alternative to trabeculectomy, “[s]tents can be inserted between the anterior chamber of the eye and Schlemm’s canal, bypassing the trabecular meshwork.” *Id.* at 2:24–26. Another alternative to trabeculectomy inserts “tubular elongated cylindrical hollow stents longitudinally into Schlemm’s canal,” which measures approximately 190–370 μM in cross-sectional diameter. *Id.* at 2:30–36. A negative aspect of bypass stents is that they “can lose functionality over time as a result of occlusion or scarring.” *Id.* at 2:33–34. Further, because “Schlemm’s canal is small,” stents are said to be “difficult or expensive to design and manufacture.” *Id.* at 2:35–37. According to the '443 patent, the walls of tubular stents “can have significant surface area contact with the trabecular meshwork and/or the collector channels, which can result in blockage of the meshwork or collector channels, substantially interfering with transmural flow across Schlemm’s canal and into the eye’s collector channel.” *Id.* at 2:45–49.

The '443 patent purports to resolve these problems with “devices for reducing pressure within the eye” comprising “a support implantable circumferentially within Schlemm’s canal that is configured to maintain the patency of at least a portion of the canal.” *Id.* at 2:58–61. The '443 patent explains that “[b]y ‘maintain the patency’ of at least a portion of the canal, it

is meant that the support operates to keep the canal at least partially unobstructed to transmurial flow, such that fluid can 1) exit through the trabecular meshwork; 2) traverse the canal; and 3) drain via the collector channels.” *Id.* at 7:28–33.

Figure 10B of the ’443 patent is reproduced below.

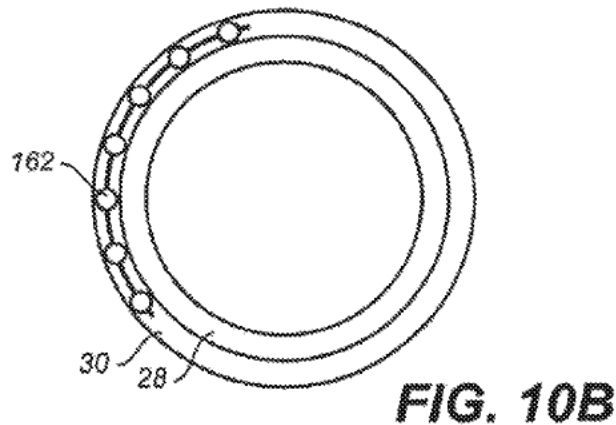


Figure 10B, above, is a configuration of support 162 implanted into and extending less than half way around Schlemm’s canal 30. *Id.* at 5:51–52; 11:53–54. Figure 10B also shows trabecular meshwork 28 adjacent to canal 30. *Id.* at 5:51–52; 12:35.

The ’443 patent describes supports having a bowed or arcuate shape smaller or larger than the radius of curvature of Schlemm’s canal. *Id.* at 11:64–12:9. Figure 11D of the ’443 patent is reproduced below.

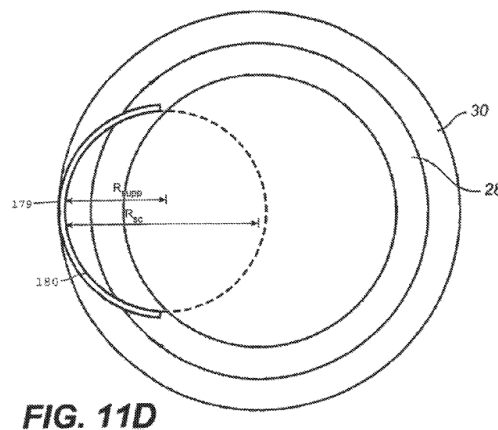


Figure 11D, above, illustrates a configuration of support 179 having a smaller radius of curvature than Schlemm's canal 30. *Id.* at 5:53–54. The '443 patent discloses that support 179 comprises arcuate member 180 having a radius of curvature R_{supp} that is less than the radius of curvature R_{sc} of canal 30. *Id.* at 12:3–6. The stiffness of arcuate member 180 is said to urge canal 30 open. *Id.* at 12:6. Figure 11D illustrates that support 179 extends out of Schlemm's canal 30 into adjacent trabecular meshwork 28. *Id.* at 12:35.

1. Illustrative Claim

Claim 1, which describes a device for reducing intraocular pressure in an eye, and claim 58, which describes a kit for doing so, are the independent claims challenged by Petitioner in this proceeding. Independent claim 1, reproduced below, is illustrative of the subject matter:

1. A device for reducing intraocular pressure in an eye having a Schlemm's canal and a trabecular meshwork, comprising:

a support implantable circumferentially within Schlemm's canal and configured to maintain the patency of at least a portion thereof, wherein the support comprises an arcuate member, wherein at least a portion of the arcuate member has a radius of curvature smaller than the radius of curvature of Schlemm's canal so that at least a portion of the arcuate member is configured to extend out of Schlemm's canal and into the trabecular meshwork and wherein the support does not substantially interfere with transmural flow across Schlemm's canal, and wherein when the support is disposed within a cylindrical section of the lumen of the canal having an internal wall surface area C , the support contacts less than 30% of C .

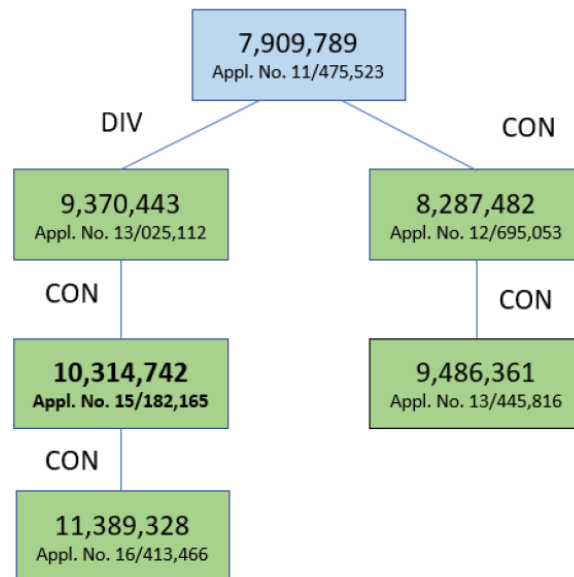
Ex. 1003, 18:12–26.

II. ANALYSIS

A. *Discretion Under 35 U.S.C. 325 (d)*

We first consider Patent Owner’s request that we deny institution⁶ under 35 U.S.C. § 325(d). Prelim. Resp. 14–47. Patent Owner contends that Petitioner’s alleged prior art was presented previously to Examiner during prosecution of the ’443 patent and related applications. *Id.*

In the Patent Owner Preliminary Response in IPR2022-01530, Patent Owner provides a patent family tree, reproduced below, which shows the relationship of the patents in the challenged patent family at issue in this request for *inter partes* review, and in IPR2022-01533, IPR2022-01540, and IPR2022-01530.



⁶ Patent Owner presents an alternative basis for denying institution under 35 U.S.C. § 314(a) based on *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) and Memo re Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (“Vidal Memo”), at 4 (June 21, 2022). Prelim Resp. 60–66. Because we deny institution based on 35 U.S.C. § 325(d), we need not separately reach a conclusion based on *Fintiv* in this decision.

The patent family tree shows that the '443 patent issued from an application that is a divisional of the application that issued as the U.S. Patent No. 7,909,789 (the "'789 patent"). Prelim. Resp. 8. Patent Owner asserts that the same "Primary Examiner Leslie Deak examined all patents in this family. (See '443; '742; '328)." *Id.*

Patent Owner argues that discretionary denial is appropriate because "[a]ll Grounds in the Petition are based on primary references Gharib '478 (Ex. 1005) or Lynch '334 (Ex. 1008), which are identical or substantially the same as, and cumulative of, references that were considered during prosecution of the '443 patent and related applications." Prelim. Resp. 16. Additionally, Patent Owner contends that Petitioner makes "no attempt to establish that the Examiner 'erred in evaluating the art or arguments' previously presented to the Office" *Id.*

Institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("the PTO is permitted, but never compelled, to institute an IPR proceeding"). Section 325(d) provides that the Director may elect not to institute⁷ a proceeding if the challenge to the patent is based on matters previously presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, Case IPR2019-01469, Paper 6 (February 13, 2020) (precedential) ("*Advanced Bionics*"). "Previously 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." *Id.* at 7–8.

⁷ The Board institutes trial on behalf of the Director. 37 C.F.R. § 42.4(a).

Advanced Bionics sets out a two-part framework for evaluating “whether the petition presents to the Office the same or substantially the same art previously presented to the Office.” *Advanced Bionics* at 7.

Advanced Bionics two-part framework reads as follows:

- (1) 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, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics at 8.

In Part 1 of the *Advanced Bionics* two-part framework we evaluate *Becton, Dickinson* factors (a), (c) and (d) as set forth below. *Advanced Bionics* at 10 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton Dickson*”)). If it is determined that the same or substantially the same art or arguments previously were presented to the Office, we then turn to Part Two of *Advanced Bionics* framework. In Part 2 we evaluate *Becton, Dickinson* factors (c), (e) and (f) as set forth below.

Becton, Dickinson identifies the following non-exclusive factors:

- (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;
- (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 prior art or arguments.

We analyze these factors below as they apply to the record in this proceeding, and find that, on balance, the factors weigh in favor of exercising our discretion under 35 U.S.C. § 325(d).

1. Part 1 – Whether the same or substantially the same art or arguments previously were presented to the Office

Petitioner contends that “[t]he grounds presented in the petition include obviousness challenges applying Lynch and Gharib as base references. Neither Lynch nor Gharib was applied against the Challenged Claims or discussed by the Examiner during prosecution of the ’443 patent or its parent applications,” and none is cumulative of such cited references. Pet. 16; *see* Reply 1–2. Petitioner contends that the Petition includes challenges applying Gharib and Lynch that were not applied against the challenged claims or discussed by Examiner during prosecution of the ’443 patent or its parent applications, therefore, weighing against exercising our discretion under §325(d). Pet. 16 (citing *Fasteners for Retail, Inc. v. RTC Indus., Inc.*, IPR2019-00994, Paper 9 at 7–11 (PTAB Nov. 5, 2019)); *see* Reply 2. Petitioner additionally presents challenges based on the combination of Gharib and/or Lynch combined with Bergheim and/or Burns. Pet. 21–83.

According to Petitioner, during prosecution of the ’443 patent, Examiner rejected the claims over Neuhaus. Petitioner states,

Patent [O]wner argued Neuhaus's support resides entirely within Schlemm's canal and therefore does not meet the limitation that "at least a portion of the arcuate member is configured to extend out of Schlemm's canal and into the trabecular meshwork." This distinction is not applicable to either Gharib or Lynch, both of which meet the arcuate member limitation.

Pet. 16–17.

a) Gharib

Petitioner further explains in its Reply that Gharib '478 is not cumulative of Neuhaus because "Gharib '478 discloses a device comprising a bifurcatable outlet section that partly resides inside Schlemm's canal and extends out into the trabecular meshwork through a continuous connection to the inlet section," and Gharib's "continuous structure does not detach and instead forms an arcuate shape that traverses the trabecular meshwork and resides in Schlemm's canal when implanted." Reply 4–5.

Patent Owner disagrees. First, Patent Owner argues that Examiner made of record in the prosecution of '443 patent a search conducted on May 13, 2010 for the parent '789 patent citing Gharib '478 "demonstrating that the Examiner also considered the reference for examining the claims of the '443 patent." Prelim. Resp. 18–19 (citing Ex. 1004, 1075 (Ref#S3)). Patent Owner also argues that Gharib '478 asserted against the claims here is identical to issued patent Gharib '841 (Ex. 2005; *see also* Ex. 2006 (Redline comparison of text)) that was before Examiner during prosecution of the continuation applications that issued as the '742 and '328 patents that both have a similar claim scope compared to the claims of the '443 patent. Prelim. Resp. 19.

Patent Owner further argues that Petitioner is presenting art and arguments that are the same or substantially the same art as considered by Examiner during prosecution of the application leading to the '443 patent. *Id.* at 23–25. For instance, Patent Owner details how “Petitioner’s arguments mimic the Examiner’s argument for Neuhaus’s wire stent that if a part extends into the trabecular meshwork, it has a smaller radius of curvature than the canal.” *Id.* at 23–24. Patent Owner further asserts that Petitioner’s argument that Gharib is not cumulative of Neuhaus is an improper new unpatentability theory raised in its Reply and contradicts Gharib’s express teaching concerning two bifurcatable elements positioned and stabilized *inside* Schlemm’s canal. Sur-Reply 4.

b) Bergheim and Burns

Petitioner asserts that neither Bergheim nor Burns were considered, applied, or discussed by Examiner. Pet. 16 (stating “none of the references applied by the examiner in either the '443 patent or its parent applications is cumulative of the references cited here”); Reply 1–2.

Patent Owner asserts that Bergheim is cited by Petitioners to assert there is motivation to reduce surface area contact because of Bergheim’s disclosure of “troughs” and “channels” to “improve aqueous humor flow into and out of the natural outflow pathways.” Prelim. Resp. 26. Patent Owner asserts Bergheim is cumulative of U.S. Patent Publication No. 2004/0260228 (“Lynch '228”) that was considered and discussed by Examiner as disclosing “fenestrations that allow fluid flow without being obstructed by the walls of Schlemm’s canal. As such, the stent does not contact 100% of the surface area of Schlemm’s canal in the location in which the stent is placed.” *Id.* at 26 (citing Ex. 1004, 765; Ex. 1010 ¶ 34).

As for Burns, Patent Owner asserts that “Petitioner’s reliance on Burns entirely overlaps with Stegmann’s kit teachings, which were already identified by the Examiner in her rejections and overcome during prosecution.” *Id.* at 27 (citing Ex. 1011; Ex. 1004, 112).

c) Lynch

Petitioner contends that Lynch was not applied against the challenge claims or discussed by Examiner during prosecution of the ’443 patent or its parent applications, therefore, weighing against exercising our discretion under §325(d). Pet. 16 (citing *Fasteners for Retail, Inc. v. RTC Indus., Inc.*, IPR2019-00994, Paper 9 at 7–11 (PTAB Nov. 5, 2019)). Petitioner also asserts that it “relies on teachings in Lynch ’334 (*e.g.*, Figs. 8B–C and 10) missing from Lynch ’197.” Reply 2 n.1.

Patent Owner disagrees. Patent Owner argues that Lynch (Ex. 1008) is highly similar and cumulative to Lynch ’197 which was considered during the prosecution of the ’443 patent. Prelim. Resp. 32 (Ex. 1004, 730–32 (Cite No. 52); *see id.* at 34–43 (comparing Lynch with Lynch ’197). Lynch ’197 was also considered during prosecution of the parent ’789 patent and continuation applications that issued as the ’742 and ’328 patents examined by the same Examiner. *Id.* (citing Ex. 2010, 14 (Cite No. 308); Ex. 2014, 1 (Cite No. 3); Ex. 2015, 4 (Cite No. 101)). In addition, Lynch ’197 was also listed on International and European Search Reports submitted during prosecution of the ’443 patent. *Id.* (citing Ex. 1004, 689–90, 695–700 (cited reference D2), 950–52; Ex. 2004).

d) Analysis – Part I

The Board has stated in *Advanced Bionics* with respect to § 325(d) that “[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. Patent Owner has shown that Gharib was made of record by Examiner because it was cited in the prosecution of the ’443 patent in a search report of a search conducted by Examiner. *See* Ex. 1004, 1075. In the search notes listing the application number for the ’443 patent, the history of the searches conducted by Examiner is set forth in detail beginning with an original search on May 13, 2010, and ending with a search on February 22, 2016 that “updated prior searches” and indicated Examiner “considered new drawing.” *Id.* at 1072. Therefore, Gharib was previously before the Office in the prosecution of the ’443 patent.

Patent Owner not only relies on this express listing by Examiner of Gharib (Ex. 1005) in the prosecution history of the ’443 patent, which we find is sufficient to show that the reference was previously presented to the Office, but also on the cumulative nature of Gharib (Ex. 1005) as the published application that issued as U.S. Patent No. 6,666,841 (“Gharib ’841”) (Ex. 2005) that was considered by Examiner during prosecution of two continuation applications that issued as the ’742 and ’328 patents. Prelim. Resp. 19; *compare* Ex. 2005, *with* Ex. 1005; *see also* Ex. 2006 (Redline comparison of text)). Patent Owner asserts “[t]he similar scope of the claims of the ’742 and ’328 patents compared to the ’443 patent . . . makes the Examiner’s consideration of Gharib ’841 relevant to the cumulativeness analysis of the ’443 patent and weighs in favor of denial under § 325(d).” Prelim. Resp. 19–20 (showing Claim Chart comparing claims of the ’742 and ’443 patents). Patent Owner points out that Examiner issued obviousness-type double-patenting rejections against the ’328 and

'742 patent claims over the '443 patent. *Id.* at 20–21 (citing Ex. 2007, 6–7; Ex. 2008, 5).

Patent Owner asserts that Gharib '841 was considered by Examiner because it was listed in an IDS and acknowledged by Examiner during prosecution of the '742 and '328 patents. Prelim. Resp. 21 (citing Ex. 2009, 4 (Cite No. 118); Ex. 2010, 9 (Cite No. 188)). Patent Owner argues that “the Board has held that an IDS citation alone is deemed previously presented to, and considered by, the Office.” *Id.* (citing *Advanced Bionics*, Paper 6 at 7–8; *Microsoft Corp. v. Koninklijke Philips N.V.*, IPR2018-00279, Paper 11 at 12, 14-15 (PTAB June 8, 2018); *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7 at 10–11 (PTAB Nov. 8, 2022); *Fellowes, Inc. v. Treefrog Devs., Inc.*, IPR2020-01509, Paper 11 at 7–8, 17 (PTAB Feb. 22, 2021); *Ocado Grp. PLC v. Autostore Tech. AS*, IPR2021-00412, Paper 9 at 34–35 (PTAB July 21, 2021)); *see* Sur-Reply 2 (citing additional Board decisions to support the position that there is no requirement for Examiner to have applied a reference in a rejection for the reference to be considered previously presented to the Office).

We recognize that Examiner did not expressly rely on Gharib '841 during prosecution of the '742 or '328 patents. Nonetheless, Patent Owner presents persuasive arguments and supporting evidence that Examiner was presented with and aware of the disclosures in Gharib '841. Thus, Patent Owner argues persuasively that Examiner considered Gharib '841 with a very similar disclosure to Gharib on which Petitioner relies in Grounds 1 and 2 of the Petition. *See, e.g.*, Ex. 2006 ((Redline comparison of text); *compare* Ex. 1005, *with* Ex. 2005. We also agree that although the '742 and '328 are patents that issued from continuation applications from the application of the '443 patent, the prosecution histories of those patents, the claims of which

were determined by Examiner to not be patentably distinct from the claims of the '443 patent, is instructive concerning art presented to the Office and considered for purposes of a § 325(d) analysis. *Live Nation Entertainment, Inc. v. Complete Entertainment Resources B.V.*, PGR2017-00038, Paper 11 at 12 (PTAB Jan. 16, 2018) (finding arguments presented to the Office in the prosecution of a continuation application with claims “of very similar scope” to the challenged claims were sufficient for finding substantially the same arguments were previously presented to the Office).⁸

We agree with Patent Owner’s conclusion that

Since the Examiner considered Gharib '841 (which contains the same disclosure as Gharib '478) during examination of the related '742 and '328 patents, the Patent Office has allowed three patents to issue to Sight Sciences over a Gharib reference that has an identical disclosure to Gharib '478. (*See generally* Ex.2006 (Redline comparing the text of Gharib references).) Gharib '478 does not offer any disclosures that the Patent Office has not already considered three times in this patent family.

Prelim. Resp. 22.

We find that Patent Owner has shown sufficiently that Gharib was presented to the Office during the prosecution of the '742 and '328 patents because Gharib '841 was presented in Information Disclosure Statements and was considered by Examiner in reviewing claims that are substantially similar to the challenged claims here as evidenced by the obviousness-type

⁸ Patent Owner argues, and we agree, that there is no requirement that Examiner needs to rely on a reference in a rejection during prosecution in order for the reference to be “considered” during prosecution. *See* Prelim Resp. 20; *see, e.g., Advanced Bionics*, Paper 6 at 7-8 (stating that previously presented art includes art cited in an IDS).

double patenting rejections of the claims of the '443 patent issued in each of the prosecution histories for the '742 and '328 patents.⁹

We also find that Patent Owner has shown sufficiently that the substantive disclosure of Lynch was presented to the Office during the prosecution of the '443 patent.

Patent Owner contends that Lynch '197 considered during prosecution of the '443 patent is substantially similar to Lynch cited in the Petition. Prelim. Resp. 32. Patent Owner provides a table comparing the relevant portions of Lynch relied on by Petitioner in the Petition with Lynch '197. *See id.* at 34–43 (*compare* Lynch (Ex. 1008) *with* Lynch '197 (Ex. 2013)).

Although Examiner did not expressly rely on Lynch (Ex. 1008) during prosecution of the '443 patent, the Patent Owner presents persuasive arguments and supporting evidence that the disclosure of Lynch was presented to the Office when Lynch '197 was presented to the Office in an IDS. We also find that Patent Owner persuasively presents evidence that the disclosures of Bergheim and Burns is cumulative of references considered by the Office. *See supra* Section II.A.1.b).

Having determined that Examiner during prosecution leading to the '443 patent (and related patents in the case of Gharib) considered Gharib, Lynch, and art to which Bergheim and Burns are cumulative, we now turn to the question whether Petitioner has established that the Office materially erred.

⁹ Because we find that Gharib itself was presented to the Office during the prosecution of the '443 patent in addition to the very similar disclosure of Gharib during the prosecution of the '742 and the '328 patents, we need not reach Patent Owner's arguments concerning the similarity of the Petitioner's obviousness arguments based on Gharib and the arguments discussed during prosecution of the '443 patent. *See* Prelim. Resp. 23–25.

Part 2 – Whether Petitioner has shown that the Office materially erred

In the Petition, Petitioner has not articulated sufficiently how Examiner erred during the prosecution leading to the '443 patent. Pet. 16–

17. The Petitioner states:

During prosecution, the '443 patent was rejected over Neuhan. Patent owner argued Neuhan's support resides entirely within Schlemm's canal and therefore does not meet the limitation that "at least a portion of the arcuate member is configured to extend out of Schlemm's canal and into the trabecular meshwork." This distinction is not applicable to either Gharib or Lynch, both of which meet the arcuate member limitation.

Id.

Petitioner does not provide a fulsome explanation as to why this distinction is not applicable to either Gharib or Lynch and did not point to any testimony of its declarant providing such an explanation. *See id.* In its Reply, Petitioner does point to figures in Lynch that are different than those in Lynch '197 before the Office, but does not explain how these figures distinguish what was before the Office during prosecution of the '443 patent. Reply 2, n.1. Petitioner concludes that none of the references it uses in its challenges were discussed or applied during the prosecution of the '443 patent, which we have indicated does not ameliorate Petitioner's responsibility to show material error here. *See id.*

Petitioner does provide an explanation as to why Gharib is different than Neuhan, which was cited against the claims by Examiner, in its Reply without any support from its declarant. Petitioner states:

The same cannot be said of Gharib '478. Even accepting Patent Owner's argument that Neuhan's "wire loop" is an entirely separate structure, removeable from the tubular support, and intended to help guide the support into place, Gharib '478 discloses a device comprising a bifurcatable outlet section that

partly resides inside Schlemm's canal and extends out into the trabecular meshwork through a continuous connection to the inlet section. Ex. 1005 at ¶ 55, Fig. 5A, 7B, 8. Patent Owner incorrectly asserts that Gharib '478's support lacks an arcuate shape. POPR at 50-54. A POSITA would have understood Gharib '478's support is a continuous structure that unfolds like a zipper when deployed in the eye and comprises an "arcuate member." Ex. 1005, Fig. 7A. Indeed, Gharib '478's outlet section is connected to the inlet section by "at least one lumen 36 for transporting aqueous from the anterior chamber 20 of an eye to the Schlemm's canal 22." *Id.* ¶ 55. In contrast to Patent Owner's characterization of Neuhann, Gharib '478's continuous structure does not detach and instead forms an arcuate shape that traverses the trabecular meshwork and resides in Schlemm's canal when implanted.

Reply 4–5. Without support from Petitioner's declarant as to how a POSA would read Gharib, this amounts to mere attorney argument, belatedly presented in Petitioner's Reply to which we will give little weight.

Therefore, we agree with Patent Owner that Petitioner did not meet its burden of showing material error. *See* Prelim Resp. 16–17; Pet. 16–17.

B. *Summary*

Considering the above *Becton Dickson* factors as they are incorporated into the two-part *Advanced Bionic* framework, we find that the factors weigh in favor of exercising our discretion and denying institution under § 325(d). The asserted art is either the same as, or cumulative to, the prior art that Examiner has already considered during prosecution of the '443 patent and its related applications, and Petitioner has not shown material error by the Office. Thus, we deny institution under § 325(d).

III. CONCLUSION

Taking account of the information presented in the Petition, Preliminary Response, Reply, Sur-Reply, and the evidence of record, we exercise our discretion under § 325(d) and deny institution.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for an *inter partes* review, pursuant to 35 U.S.C. § 314(a), of claims 1, 8, 11, 12, 21, 23, 24, 27, 42, 43, 46, 52, 54–59, 70, and 71 of the '443 patent is *denied*, and no trial is instituted.

IPR2022-01529
Patent 9,370,443 B2

FOR PETITIONER:

Gregg LoCascio
Kat Li
W. Todd Baker
Justin Bova
KIRKLAND & ELLIS LLP
gregg.locascio@kirkland.com
kat.li@kirkland.com
todd.baker@kirkland.com
justin.bova@kirkland.com

FOR PATENT OWNER:

Michelle S. Rhyu
Orion Armon
Mika Mayer
COOLEY LLP
rhyums@cooley.com
oarmon@cooley.com
mmayer@cooley.com