

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSURGICAL TECHNOLOGY, INC.,
Petitioner,

v.

THE REGENTS OF THE UNIVERSITY OF COLORADO,
Patent Owner.

PGR2021-00026
Patent 10,786,391 B2

Before LYNNE H. BROWNE, TIMOTHY J. GOODSON, and
JAMIE T. WISZ, *Administrative Patent Judges*.

WISZ, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

MicroSurgical Technology, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting a post-grant review of claims 1–20 of U.S. Patent No. 10,786,391 B2 (Ex. 1001, “the ’391 patent”). The Regents of the University of Colorado (“Patent Owner”) filed a Preliminary Response (Paper 11, “Prelim. Resp.”).

We may not authorize a post-grant review to be instituted “unless . . . the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a). After considering the Petition and Patent Owner’s Preliminary Response, we determine that Petitioner has not satisfied the burden under 35 U.S.C. § 324(a) to show that it is more likely than not that at least one of the challenged claims is unpatentable.

A. Real Parties-in-Interest

Petitioner identifies MicroSurgical Technology, Inc. as the real party-in-interest. Pet. 4. Patent Owner identifies The Regents of the University of Colorado and New World Medical, Inc. as the real parties-in-interest. Paper 4, 1.

B. Related Proceedings

The parties indicate that the ’391 patent is the subject of litigation in *New World Medical, Inc. et al. v. MicroSurgical Technology, Inc.*, No. 2:20-cv-01621-RAJ-BAT (W.D. Wash.). Pet. 5; Paper 4, 1.

C. The Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–20 of the ’391 patent are unpatentable in view of the following grounds. Pet. 38–39.

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–20	112(a)	Written Description
1–20	112(b)	Indefiniteness
1–20	102	Baerveldt ¹
1–20	103	Baerveldt

Petitioner relies on the Declaration of Gary P. Condon, M.D. (Ex. 1012), in support of its contentions.

D. The '391 Patent

The '391 patent is directed to microsurgical devices and methods for using these devices to treat medical conditions such as glaucoma, using minimally invasive surgical techniques. Ex. 1001, 1:66–2:11. One risk factor for glaucoma is elevated intraocular pressure (“IOP”), which can be caused by fluid buildup in the anterior segment of the eye. *Id.* at 10:1–9, 10:63–11:3.

The '391 patent discloses dual-blade devices that are used to cut the trabecular meshwork (“TM”) of a patient’s eye in order to increase outflow of fluid from the anterior chamber (“AC”). Ex. 1001, 1:66–2:11. According to the '391 patent, the design of the device allows the device to completely remove strips of TM tissue without leaving leaflets behind with minimal to no traumatic impact on the surrounding tissue. *Id.* at 12:4–39.

A dual-blade device according to the '391 patent is depicted below in Figures 8 and 10 from the patent. The device includes a handle (1), interface

¹ Baerveldt et al., WO 2018/151808 A1, published Aug. 23, 2018 (Ex. 1009; “Baerveldt”).

of tool shaft and handle (2), a tool shaft (3), interface of tool shaft and beveled platform (4), and beveled platform (5). Ex. 1001, 12:40–45.

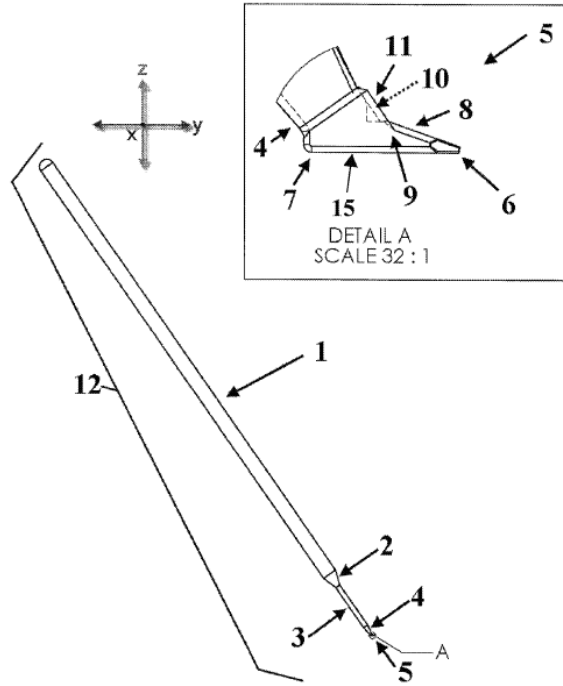


FIG. 8

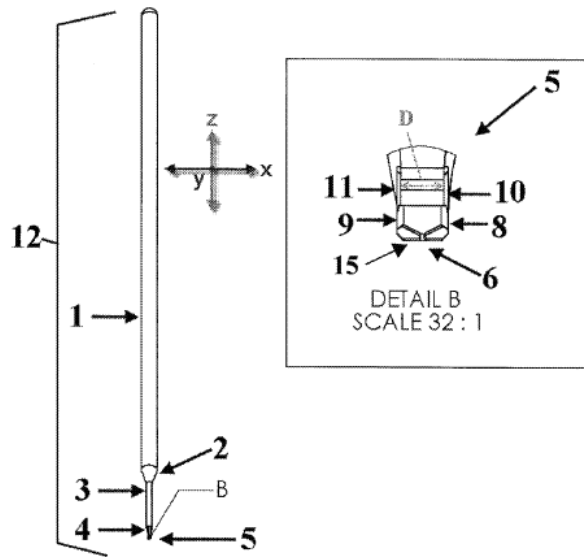


FIG. 10

Id. at Figs. 8, 10. The enlarged, detailed views of these figures provide a closer look at the beveled platform (5). Beveled platform (5) includes a first end/beveled platform tip/insertion blade tip (6), a second end/back of the beveled platform (7), a first side (8), and a second side (9). *Id.* at 12:40–56. The beveled platform (5) also includes a first lateral element (e.g., blade) (10) and a second lateral element (e.g., blade) (11) along the sides of the beveled platform (5). *Id.*

According to the '391 patent, the device is introduced through a corneal incision and advanced through the AC as shown below. Ex. 1001, 15:53–16:34.

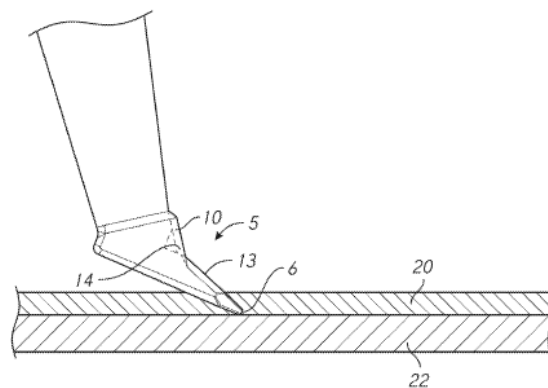


FIG. 19A

Id. at Fig. 19A. Once the TM is reached, the tip (6) of the device is used to enter into Schlemm's canal ("SC") (22). *Id.* at 15:62–64. The ramp (13) of the device elevates and lifts the TM away from the outer wall of SC (22) to present the TM tissue to the dual blades as the device is advanced. *Id.* at 15:65–16:12. The first and second lateral blades (10, 11) cut the TM (20) to form a strip. *Id.* at 16:12–18. The strip of TM tissue, which will have a width W that essentially corresponds to the distance D across the gap (14), can be received within the gap (14) between first and second lateral blades (10, 11). *Id.* at 16:19–23.

E. Illustrative Claim

Petitioner challenges claims 1–20 of the '391 patent. Claims 1 and 13 are the independent claims and are reproduced below:

1. A method for incising a trabecular meshwork to form an opening in trabecular meshwork tissue of an eye having a Schlemm's Canal, an anterior chamber and a trabecular meshwork, the method comprising:
 - providing a device comprising:
 - a shaft;
 - a distal member positioned at a distal end of the shaft, the distal member having a forward end and a rearward end;
 - a tip disposed at the forward end of the distal member;
 - a right edge and a left edge extending towards the rearward end from the tip, wherein the right edge and the left edge increase in height as they extend rearward; and
 - a gap rearward of the tip and between the right edge and the left edge, the gap defining an unoccupied space that is not part of a lumen, wherein at least portions of the right and left edges are configured to cut trabecular meshwork tissue as the trabecular meshwork tissue advances in a rearward direction over the right and left edges; inserting a distal portion of the device into the anterior chamber, the distal portion including the distal member;
 - advancing the distal member, the tip first, through the trabecular meshwork and into the Schlemm's Canal; and
 - advancing the distal member, the tip first, through the Schlemm's Canal such that trabecular meshwork tissue contacts and is severed by the right and left edges of the distal member.

13. A method for incising a trabecular meshwork to form an opening in trabecular meshwork tissue of an eye having a Schlemm's Canal, an anterior chamber and a trabecular meshwork, the method comprising:

inserting a distal portion of a device into the anterior chamber, the device comprising:

a shaft;

a distal member positioned at a distal end of the shaft, the distal member having a forward end and a rearward end;

a tip disposed at the forward end of the distal member;

a right edge and a left edge extending towards the rearward end from the tip,

wherein the right edge and the left edge increase in height as they extend rearward, and

wherein a width between the right and left edges increases as they extend rearward; and

a gap rearward of the tip and between the right edge and the left edge, the gap defining an unoccupied space that is not part of a lumen, wherein the distal portion includes the distal member;

advancing the distal member, tip first, through the trabecular meshwork and into the Schlemm's Canal; and

advancing the distal member, tip first, through the Schlemm's Canal such that trabecular meshwork tissue contacts, is stretched between, and is severed by the right and left edges of the distal member.

Ex. 1001, 25:25–54, 26:31–58. Challenged claims 2–12 depend, directly or indirectly, from claim 1 and challenged claims 14–20 depend directly from claim 13.

II. BACKGROUND

A. Person of Ordinary Skill in the Art

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the

technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986).

Petitioner and Patent Owner describe the person of ordinary skill in the art as having:

(1) a medical degree and at least two years' experience with treating glaucoma and performing glaucoma surgery; or (2) an undergraduate or graduate degree in biomedical or mechanical engineering and at least five years of work experience in the area of ophthalmology, including familiarity with ophthalmic anatomy and glaucoma surgery.

Pet. 39 (citing Ex. 1012 ¶ 11); Prelim. Resp. 30.

We adopt this definition and find that it is consistent with the level of ordinary skill in the art at the time of the invention as reflected in the prior art in this proceeding. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

B. Claim Construction

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.200(b) (2019). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.* A patentee may define a claim term in a manner that differs from its ordinary and customary meaning; however, any special definitions must be set forth in the

specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

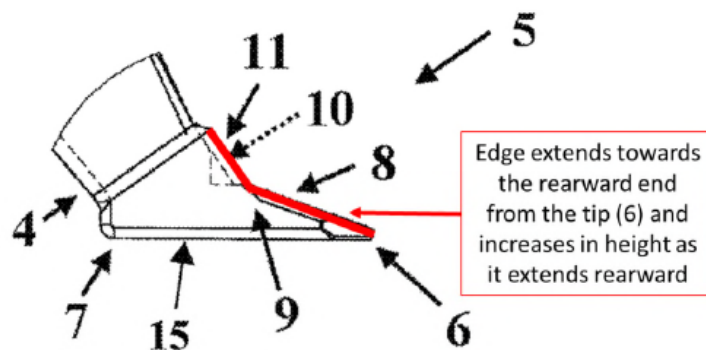
Petitioner proposes constructions for the terms “tip,” “edge,” and “lumen.” Pet. 40–41. Patent Owner generally disagrees with Petitioner’s proposed constructions and provides constructions for the terms “tip” and “edge.” Prelim. Resp. 31–38. We address construction of the term “edge” below.

1. “*edge*”

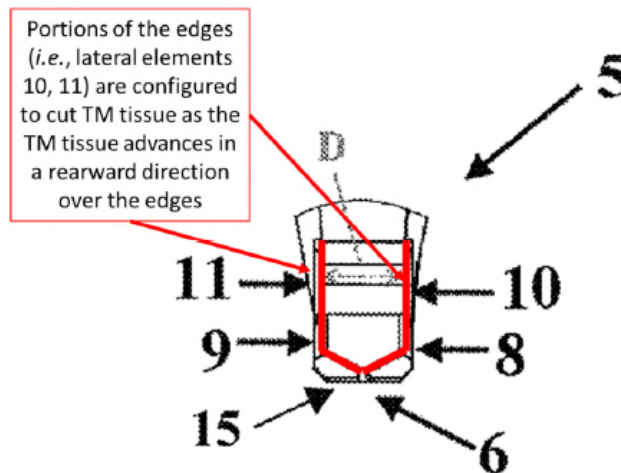
Petitioner asserts that the term “edge” should be construed as “‘a cutting structure’ configured to sever the trabecular meshwork tissue.” Pet. 40 (citing Ex. 1001, 3:63–66 (“at least portions of the right and left edges are configured to cut trabecular meshwork tissue as the trabecular meshwork tissue advances in a rearward direction over the right and left edges”)). Petitioner contends that this definition is consistent with the ordinary meaning of the word “edge” as evidenced by Merriam-Webster’s Online Dictionary which defines “edge” as “the cutting side of a blade.” *Id.* at 40–41 (citing Merriam-Webster’s Online Dictionary (accessible at www.merriam-webster.com/dictionary/edge)).

Patent Owner contends that Petitioner’s proposed construction is overly narrow and inconsistent with the ’391 patent. Prelim. Resp. 34. Patent Owner asserts that the term “edge” should be construed according to its plain and ordinary meaning, which is “the line where an area begins or ends, *i.e.*, the border.” *Id.* According to Patent Owner, in the context of the ’391 patent, “edge” is “the line/border between the sides and top of the distal member.” *Id.*

Patent Owner asserts that the '391 patent supports this construction of “edge” because, according to the claims, the “edges” must extend toward the rearward end of the distal member “from the tip.” Prelim. Resp. 34 (citing Ex.1001, cl.1, 13). Further, the claims indicate that the “edges” “increase in height as they extend rearward” and that “at least portions of the right and left edges are configured to cut trabecular meshwork tissue as the trabecular meshwork tissue advances in a rearward direction over the right and left edges.” *Id.* According to Patent Owner, “[a]s shown in the annotated figures below, the lines/borders between the sides (8, 9) and top of the distal member (a) start at the tip and extends toward the back of the distal member, (b) increase in height from the tip to the back of the distal member, and (c) include portions that cut TM tissue.”



Ex.1001 ('391 patent), Fig.8 (enlarged, annotated)



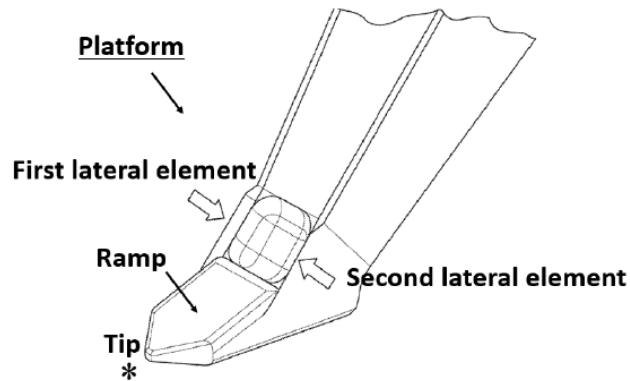
Ex.1001 ('391 patent), Fig.10 (enlarged, annotated)

Id. at 34–35 (citing Ex. 1001, Figs. 8, 10). Patent Owner’s annotated Figures 8 and 10 include lines added to demarcate the edges and labels to identify the properties of the edges.

Patent Owner further contends that Petitioner’s proposed construction refers to the “edge” of a blade while the claim refers to the “edge” of the distal member. Prelim. Resp. 38 (citing Pet. 40–41 (“cutting side *of a blade*”). According to Patent Owner, Petitioner fails to mention the other definition provided by the same dictionary, which is “the line where an object or area begins or ends : BORDER.” *Id.* (citing Merriam-Webster’s Online Dictionary (accessible at www.merriam-webster.com/dictionary/edge)).

We find that Patent Owner’s proposed construction is more consistent with the Specification and claims of the ’391 patent. The ’391 patent and its claims require that the “right edge” and “left edge” “extend[] towards the rearward end from the tip.” Ex. 1001, 3:58–60, 25:35–36, 26:43–44. Petitioner’s proposed construction, which would limit the “right edge” and “left edge” to “a cutting structure,” would be inconsistent with the ’391

patent's description and claims because the cutting portion of the distal member (*i.e.*, the first and second lateral elements) do not extend “from the tip” but, rather, extend from the ramp as shown below:



Annotated FIG. 4 of the '391 patent

Pet. 13 (citing Ex. 1001, Fig. 4).² Annotated Figure 4 includes labels added to identify the tip, ramp, and first and second lateral elements. Dependent claim 11 also specifies that at least a portion of the “edges” may be located at the tip, which is inconsistent with Petitioner’s proposed construction limiting “edge” to the lateral cutting elements. *See* Ex. 1001, 26:24–27 (“The method of claim 1, wherein, at a first location on the tip, the right edge and left edge are positioned at a first height and oriented at a first orientation that is substantially vertical.”).

The Specification and claims of the '391 patent further state that “at least portions of the right and left edges are configured to cut trabecular meshwork tissue,” which encompasses the possibility that the lateral

² The parties have proposed competing constructions for the term “tip” (*i.e.*, “the point at the distal end of the device” for Petitioner versus “the area at the forward end of the distal member” for Patent Owner); however, the cutting portions of the distal member do not extend from the “tip” under either proposed construction. *See* Pet. 40; Prelim. Resp. 31–33.

elements/blades are a portion of the edges, rather than necessarily constituting the entire edge. Ex. 1001, 3:63–64, 25:41–43. Thus, Patent Owner’s proposed construction of the “edge” being the line/border between the sides and top of the distal member is more consistent with the terms “right edge” and “left edge” as they are used in the ’391 patent. Although Patent Owner’s construction requires edges that encompass two different portions of the distal member (*i.e.*, the lateral elements/cutting blades and the ramp), as Petitioner acknowledged, “the ’391 Patent figures all consistently show the tip, ramp and lateral elements sequentially adjoined along the lateral direction.” Pet. 17 (citing Ex. 1001, Figs. 4, 8–19).

Therefore, the “right edge” and “left edge” of the distal member denote the line/border between the sides and top of the distal member. The “right edge” and “left edge” extend from the tip of the distal member, increase in height as they extend rearward, and include portions that are configured to cut trabecular meshwork tissue.

Upon review of the parties’ arguments and the evidence of record, we determine that no other terms of the ’391 patent require express construction for purposes of this Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”)).

III. ELIGIBILITY FOR POST-GRANT REVIEW

As a threshold matter, we must determine whether the ’391 patent is eligible for post-grant review. Petitioner has the burden of establishing eligibility for post-grant review. *See Commonwealth Scientific & Indus.*

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Res. Org. v. BASF Plant Science GmbH, PGR2020-00033, Paper 11, 7 (PTAB Sept. 10, 2020); *Mylan Pharms. Inc. v. Yeda Res. & Dev. Co.*, PGR2016-00010, Paper 9, 10 (PTAB Aug. 15, 2016); *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 17, 9–12 (PTAB Jan. 29, 2016).

The post-grant review provisions set forth in section 6(d) of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (September 16, 2011) (“AIA”), apply only to patents subject to the first-inventor-to-file provisions of the AIA. *See* AIA § 6(f)(2)(A) (stating that the provisions of section 6(d) “shall apply only to patents described in section 3(n)(1)”). Patents subject to the first-inventor-to-file provisions are those that issue from applications that contain or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after [March 16, 2013]; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

AIA § 3(n)(1).

Determining whether a patent is subject to the first-inventor-to-file provisions of the AIA, and therefore eligible for post-grant review, is straightforward when the patentee filed the application from which the patent issued before March 16, 2013, or when the patentee filed the application on or after March 16, 2013, without any priority claim. The determination is more complex, however, for a patent that issues from a “transition application,” that is, an application filed on or after March 16, 2013, that claims the benefit of an earlier filing date. *See* MPEP § 2159.04 (9th ed. Rev. 10.2019, June 2020). Entitlement to the benefit of an earlier

date under 35 U.S.C. §§ 119, 120, 121, or 365 is premised on disclosure of the claimed invention “in the manner provided by § 112(a) (other than the requirement to disclose the best mode)” in the earlier application. *See* 35 U.S.C. §§ 119(e), 120. Thus, for a patent issuing from a transition application, eligibility for post-grant review depends on whether the patent contains or contained at any time a claim that lacks written description and enabling support in a priority application filed before March 16, 2013.

The application that matured into the '391 patent is a transition application, as it was filed after March 16, 2013, but claims priority to applications filed before March 16, 2013. Specifically, the '391 patent issued September 29, 2020, from U.S. Application No. 16/678,785 (“the '785 application”), filed November 8, 2019. Ex. 1001, codes (45), (21), (22). The '785 application was filed as a continuation of U.S. Application No. 15/701,306 (“the '306 application”), filed on September 11, 2017. *Id.* at code (60). This parent '306 application is a continuation of U.S. Application No. 15/484,041 filed April 10, 2017, now U.S. Patent No. 9,757,279, which is a division of U.S. Application No. 15/207,329 (“the '329 application”), filed on July 11, 2016, now U.S. Patent No. 9,872,799 (“the '799 patent”), which is a continuation-in-part of U.S. Application No. 14/375,350, filed as PCT Application No. PCT/US2013/037374 on April 19, 2013, now U.S. Patent No. 10,327,947, which claims priority to provisional Application No. 61/637,611 (“the '611 provisional application”), filed April 24, 2012. *Id.* at code (60). The '611 provisional application is a pre-AIA application because it was filed before March 16, 2013.

Petitioner asserts that the '391 patent is eligible for post-grant review because none of the claims may be accorded priority to an earlier

application. Pet. 1. According to Petitioner, several of the claim limitations lack written description support in the priority applications; therefore, the effective filing date of each of the '391 patent claims is November 8, 2019, the filing date of the '785 application. *Id.* at 41–46.

Patent Owner asserts that the '391 patent is entitled to the April 24, 2012 priority date based on the filing of the '611 provisional application and is, therefore, a pre-AIA patent that is ineligible for post-grant review. Prelim. Resp. 39–59.

A. Statutory Disclaimer

Before analyzing the priority date issue, we must determine what effect, if any, Patent Owner's statutory disclaimer has on the post-grant review eligibility analysis. After the Petition was filed in this proceeding, Patent Owner filed a statutory disclaimer, disclaiming claims 3, 10, 15, and 18 of the '391 patent, effective March 22, 2021. Prelim. Resp. 18 n.2, 53–54; Ex. 2001, 1. Patent Owner contends that the disclaimed claims should not be relied on for determining post-grant review eligibility under AIA § 3(n)(1). Prelim. Resp. 53–54 (citing 37 C.F.R. § 42.207(e) (“No post-grant review will be instituted based on disclaimed claims.”); *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996) (“A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent.”); *Axon Enterprise, Inc. v. Digital Ally, Inc.*, PGR2018-00052, Paper 8 (PTAB Oct. 1, 2018) (“we must treat [the disclaimed claims] as if they never existed in determining whether to institute a post-grant review”); *Facebook, Inc. v. Skky, LLC*, CBM2016-00091, Paper 12, 11 (PTAB Sept. 28, 2017) (precedential) (“patent review eligibility is determined based on

the claims of the challenged patent as they exist at the time of the decision whether to institute, and statutorily disclaimed claims must be treated as if they never existed.”)).

We are not persuaded by Patent Owner’s arguments and instead follow the reasoning in *RetailMeNot, Inc. v. Honey Science Corp.*, PGR2019-00060, Paper 17 (PTAB Mar. 10, 2020). As stated in *RetailMeNot*, “[t]he provision of the AIA that defines which applications and patents are subject to its provisions looks beyond simply the claims in the patent and considers claims contained at any time in the application for patent.” *RetailMeNot*, Paper 17 at 10 (citing AIA § 3(n)(1)). Although *Guinn* and *Facebook*, cited by Patent Owner, state that disclaimed claims are treated as if they never existed in the patents, these statements are inapposite to post-grant review eligibility because such eligibility turns on whether the application for patent (not simply the issued patent) ever contained, at any time, a qualifying claim. *See* AIA § 3(n)(1); *RetailMeNot* at 10 (“The specific question presented by the parties in this case is whether the judicially created construct that disclaimed claims are treated as though those claims never existed in the patent extends to those same claims as contained in the application for purposes of AIA § 3(n)(1). We do not find, and Patent Owner has not provided, any persuasive authority that supports Patent Owner’s position that statutory disclaimer of patented claims should be treated as though the claims never were contained in the application for purposes of AIA § 3(n)(1).”). Further, with regard to *Axon*, “the *Axon* panel did not need to reach the issue of whether it could rely on the statutorily disclaimed claims for eligibility under AIA § 3(n)(1), because remaining

claim 15 had an effective filing that rendered the challenged patent eligible for post-grant review.” *RetailMeNot* at 11.

The instant proceeding is also distinguishable from *Facebook* because that case considered the different statutory language particular to the covered business method patent review statute. *RetailMeNot* at 11–12 (citing *Facebook* at 6; AIA § 18(a)). We also agree, as determined in *RetailMeNot*, that Rule 42.207(e) does not negate eligibility. *Id.* at 15. The comments to Rule 42.207(e) note that “no post-grant review will be instituted to review disclaimed claims.” Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680, 48,692 (Aug. 14, 2012). Thus, the comments indicate that the “based on” language in Rule 42.207(e) refers to the substantive basis for institution and not for the determination of eligibility for post-grant review. *RetailMeNot* at 15. As discussed *supra*, the language of the statute (“contains or contained at any time”) indicates that post-grant review eligibility may result from claims no longer in a patent or application. AIA § 3(n)(1).

In sum, we agree with the determination in *RetailMeNot* that a patent may be eligible for post-grant review by virtue of claims that were, at some point in time, part of the application for patent, even if those claims are later subject to a statutory disclaimer. In this case, it is undisputed that claims 3, 10, 15, and 18 were previously part of the ’391 patent. Therefore, we include these claims in our analysis of whether the ’391 patent is eligible for post-grant review.³

³ While we include an analysis of the priority date of claims 3, 10, 15, and 18 to determine whether the ’391 patent is eligible for a post-grant review, we do not provide any analysis as to the validity of these claims based on

B. Principles of Law

For a claim in a later-filed application to be entitled to the filing date of an earlier application, the earlier application must provide written description support for the claimed subject matter. *Anascope, Ltd. v. Nintendo of Am. Inc.*, 601 F.3d 1333, 1337 (Fed. Cir. 2010). The written description requirement “guards against the inventor’s overreaching by insisting that he [or she] recount his [or her] invention in such detail that his [or her] future claims can be determined to be encompassed within his [or her] original creation.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991). To satisfy the written description requirement, “the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed.” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998). A prior application need not contain precisely the same words as are found in the asserted claims. *See Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995). An adequate description does not require any particular form of disclosure or that the specification recite the claimed invention *in haec verba*, but must do more than render the claimed invention obvious. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc).

Petitioner’s challenges because these claims have been statutorily disclaimed.

C. Asserted Lack of Written Description for “transversely concave bottom surface” and a “bottom surface of the distal member has a maximum width that is less than a maximum width of the distal member”

Claims 3 and 15 of the '391 patent recite a “transversely concave bottom surface of the distal member [that] is configured to abut and be atraumatic to a back wall of the Schlemm’s Canal” and claims 10 and 18 recite that the “bottom surface of the distal member has a maximum width that is less than a maximum width of the distal member.” Ex. 1001, 25:61–63, 26:21–23, 26:65–67, 27:9–11. Petitioner contends that the '611 provisional application fails to provide written description support for these elements. Pet. 46–47. Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 53–59.

1. Petitioner’s Position

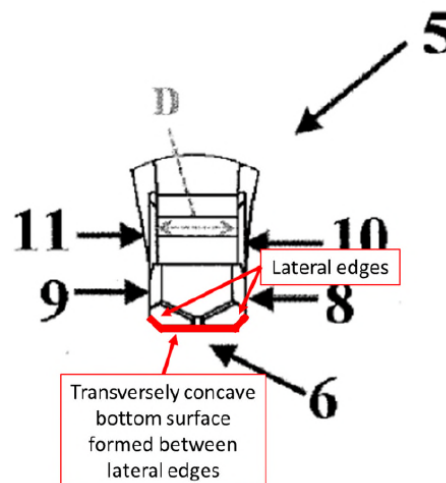
Petitioner contends that Patent Owner introduced new matter when it filed the '329 continuation-in-part application on July 11, 2016. Pet. 22. Petitioner asserts that the '329 application added the disclosure that “[t]he **bottom surface** 15 can be planar, convex, concave, or combinations thereof.” Pet. 22–23 (citing Ex. 1004, 12:47–48). According to Petitioner, none of the earlier priority applications mentioned or described the shape of the bottom surface or the maximum width of the distal member. *Id.* at 47. Therefore, Petitioner contends that claims 3, 10, 15, and 18 are not entitled to a priority date any earlier than the July 11, 2016 effective filing date of the '329 continuation-in-part application. *Id.*

2. Patent Owner's Position

Patent Owner asserts that the '611 provisional application provides support for these claim terms. Prelim. Resp. 53–59. Patent Owner cites to the '391 patents which states:

[i]n some embodiments, the device 12 includes *a bottom surface 15* that is configured to abut the outer wall of the Schlemm's canal 22 during a procedure. The bottom surface 15 can be planar, convex, concave, or combinations thereof. For example, the bottom surface 15 can include a concave portion between at least two lateral edges. *For example, lateral edges can be provided below the first side 8 and the second side 9 of the ramp 13, with a concave portion formed between the lateral edges.* The lateral edges can make contact with the outer wall of the Schlemm's canal 22 during a procedure.

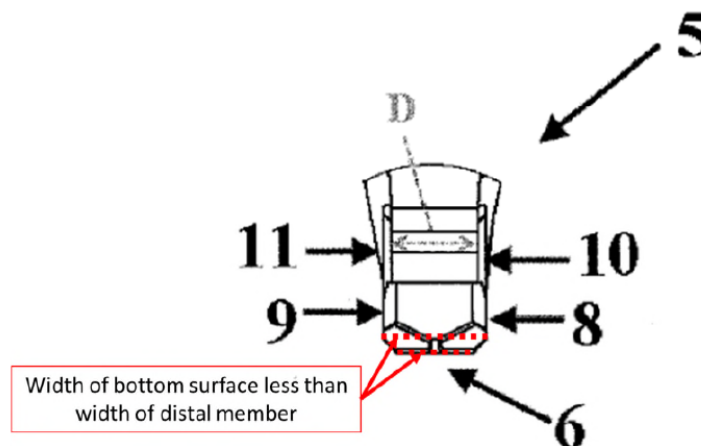
Prelim. Resp. 55 (citing Ex. 1001, 13:23–33). According to Patent Owner, the bottom surface (15) is identified in Figure 3 of the '611 provisional application. *Id.* Patent Owner contends that the concave portion can be formed between the beveled lateral edges below the sides of the device as shown in the annotated Figure 3 below:



Ex.1007 ('611 provisional), Fig. 3 (enlarged, annotated)

Id. at 57 (citing Ex. 1007, Fig. 3). Patent Owner’s annotated Figure 3 includes labels to show the lateral edges and the transversely concave bottom surface between the lateral edges.

Patent Owner also contends that the ’611 provisional application discloses that the bottom surface of the distal member has a maximum width that is less than the maximum width of the distal member. Prelim. Resp. 57. According to Patent Owner, in the device depicted in the ’611 provisional application, the lateral edges that form the border between the sides and the bottom surface are beveled such that the bottom surface has a width that is less than the width between the sides as shown in the annotated figure below:



Ex.1007 (’611 provisional), Fig. 3 (enlarged, annotated)

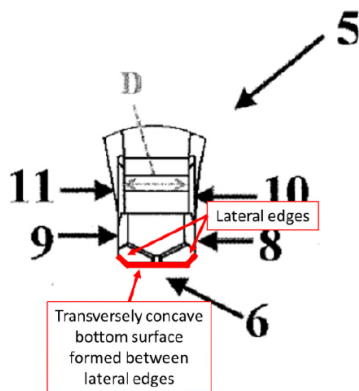
Id. at 58 (citing Ex. 1007, Fig. 3). Patent Owner’s annotated Figure 3 includes labels to show that the width of the bottom surface is less than the width of the distal member.

Patent Owner concludes that the figures in the ’611 provisional application “depict devices with a ‘transversely concave bottom surface’ and a ‘bottom surface of the distal member [that] has a maximum width that is less than a maximum width of the distal member’” and, thus, the ’611

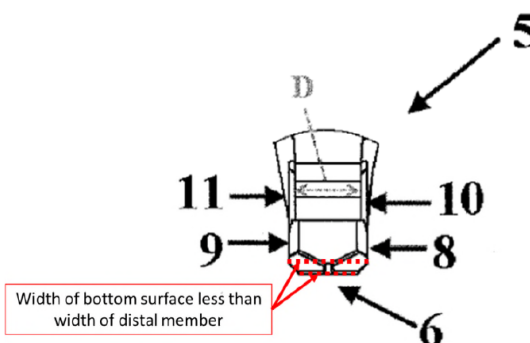
provisional application provides support for claims 3, 10, 15, and 18.
Pet. 59.

3. Analysis

We are not persuaded by Patent Owner's arguments that the '611 provisional application provides support for both a "transversely concave bottom surface" and a "bottom surface of the distal member [that] has a maximum width that is less than a maximum width of the distal member." In arguing that the bottom surface (15) of the device is transversely concave, Patent Owner points to the bottom of the device as well as portions of the beveled lateral edges to provide evidence of concavity. *See* Prelim. Resp. 55–57 (citing Ex. 1007, Fig. 3). However, in asserting that the '611 provisional application provides support for a "bottom surface of the distal member [that] has a maximum width that is less than a maximum width of the distal member," Patent Owner compares the width of the bottom of the device (without including the beveled lateral edges) to the width of the distal member at the top of the beveled lateral edges (see comparison in the annotated figures below).



Ex.1007 ('611 provisional), Fig. 3 (enlarged, annotated)



Ex.1007 ('611 provisional), Fig. 3 (enlarged, annotated)

Prelim. Resp. 57, 58 (citing Ex, 1007, Fig. 3). Patent Owner's two annotated versions of Figure 3 includes labels to show the lateral edges, the

transversely concave bottom surface between the lateral edges, and the width of the bottom surface being less than the width of the distal member.

We find that Patent Owner takes inconsistent positions with regard to what constitutes the “bottom surface” in Figure 3 of the ’611 provisional application. If the “bottom surface” includes portions of the lateral edges, then a “transversely concave bottom surface” is depicted in Figure 3; however, the maximum width of the bottom surface (i.e., where the bottom surface meets the lateral edges), would be the same as the maximum width of the distal member. Conversely, if the “bottom surface” does not include the lateral edges, then the maximum width of the bottom surface is less than the maximum width of the distal member but the bottom surface would not have concavity.

Because of this inconsistency, we find that both of these limitations cannot be supported in the ’611 provisional application and at least one of claims 3, 10, 15, or 18 cannot claim priority to the provisional. Accordingly, we find that the ’391 patent at one time contained a claim that has an effective filing date after March 16, 2013 and the ’391 patent is eligible for post-grant review.

IV. PRIORITY DATE OF NON-DISCLAIMED CLAIMS

Although we find that the ’391 patent is eligible for post-grant review, we still must determine the priority date of the other challenged (non-disclaimed) claims because Petitioner asserts that the claims are invalid as being anticipated by and/or obvious over Baerveldt, which has an international filing date of February 16, 2018 and claims priority to provisional applications filed as early as February 16, 2017. Ex. 1009, codes (22), (30). Patent Owner contends that the ’391 patent claims are entitled to

the April 24, 2012 filing date of the '611 provisional application and, thus, Baerveldt is not prior art to the '391 patent. *See* Prelim. Resp. 167. We analyze the priority issue below.

Petitioner asserts that the '391 patent priority applications do not provide written description support for the claims of the '391 patent. Pet. 43–46. According to Petitioner, Patent Owner filed the '391 patent application on November 8, 2019, with the insertion of two new paragraphs that were not included in any of the priority applications. Pet. 8–9, 44 (citing Ex. 1001, 3:54–4:25). Petitioner contends that the challenged claims “are a verbatim recitation” of the two new paragraphs and the addition of these paragraphs “appears to be a calculated attempt to provide *ipsis verbis* written description support for these claims.” *Id.* at 8. Petitioner further asserts that the disclosure from the newly added paragraphs and the challenged claims “are completely divorced from the rest of the specification” and Petitioner’s declarant, Dr. Condon, testifies that “a person having skill in the art (‘POSA’) would find that the New Matter and the Challenged Claims conflict irreconcilably with the rest of the '391 Patent and the purported priority applications.” *Id.* at 8–9. According to Petitioner, the new material added to the '391 patent is essentially copied from Petitioner’s earlier Baerveldt application. *Id.* at 9–11.

Patent Owner asserts that the '611 provisional application provides written description support for all elements of the challenged claims and that that the two new paragraphs were added to the “Summary” section during

prosecution of the '391 patent to summarize claims that are fully supported all the way back to the '611 provisional.⁴ Prelim. Resp. 3, 39.

A. Asserted Lack of Written Description for “a distal member positioned at a distal end of the shaft, the distal member having a forward end and a rearward end”

Claims 1 and 13 of the '391 patent recite “a distal member positioned at a distal end of the shaft, the distal member having a forward end and a rearward end.” Ex. 1001, 25:31–33, 26:39–41. Petitioner contends that the priority applications of the '391 patent fail to provide written description support for this “distal member.” Pet. 43–44. Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 39–47.

1. Petitioner’s Position

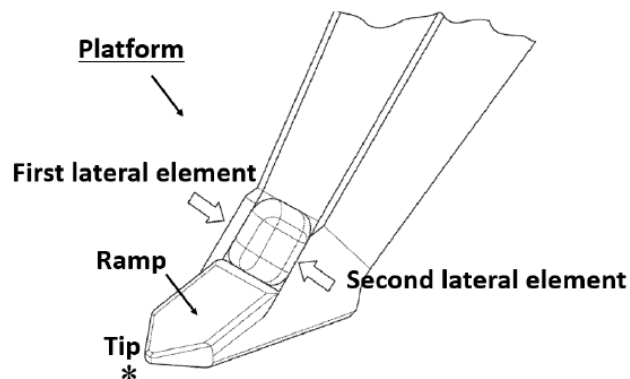
Petitioner asserts that, other than the material in the two new paragraphs and the challenged claims, there is no mention or description of a “distal member” anywhere else in the '391 patent disclosure or any of the priority applications. Pet. 12, 44. According to Petitioner, the '391 patent instead teaches a

platform comprising a tip at a distal side of the platform and a planar *ramp* extending from the distal side to a proximal side of the platform, opposite the distal side of the platform, wherein the ramp increases from a distal thickness at the distal side to a proximal thickness, greater than the distal thickness, at the proximal side; and first and second *lateral elements* for creating first and second incisions through the trabecular meshwork, the first and second lateral elements (i) being separated by a gap

⁴ In addition to asserting that the '611 provisional application provides support for the limitations challenged by Petitioner, Patent Owner also submits a claim chart providing exemplary excerpts from the '611 provisional, the '799 patent, and the '391 patent to establish support for all elements of several exemplary challenged claims. See Prelim. Resp., Appx. A.

having a width and (ii) extending from the proximal side of the platform.

Pet. 12 (citing Ex. 1001, 4:31–41). Petitioner also provides an annotated version of Figure 4 of the '391 patent (reproduced below).



Annotated FIG. 4 of the '391 patent

Id. at 13 (citing Ex. 1001, Fig. 4). Petitioner’s annotated Figure 4 includes labels added to identify the various components of the “platform” that are listed in the quoted portion of the '391 patent.

According to Petitioner and Dr. Condon, the “wholly different terms used” in the new paragraphs and challenged claims “versus the rest of the '391 Patent and the purported priority applications to describe the distal end of the disclosed embodiment would certainly confuse a POSA regarding what constitutes a *distal member*” as required by the claims. Pet. 13 (citing Ex. 1012 ¶ 41). Petitioner also contends that a POSA would find that the “distal member” recited in the new paragraphs and claims “conflicts irreconcilably with the rest of the '391 Patent and the purported priority applications.” Pet. 13, 44. For example, according to Petitioner, the “distal member” as described in the new paragraphs and claims “cannot be reconciled with any of the configurations of a tip, ramp, gap, and first and

second lateral elements that the rest of the '391 Patent discloses.” Pet. 13.

Petitioner contends:

If the right and left edges of the distal member must extend towards the rearward end from the tip, as the Challenged Claims require, then they must also incorporate the *ramp*. But as shown in annotated FIG. 4 above, there is no gap between the right and left edges of the ramp extending from the tip, which the Challenged Claims also require. And conversely, if the right and left edges of the *distal member* are meant to refer interchangeably to the first and second *lateral elements*, then FIG. 4 clearly shows that they do not extend towards the rearward end from the tip, as the Challenged Claims also require.

Id. at 12–13.

Therefore, according to Petitioner:

a POSA would necessarily conclude that (1) Patent Owner was not in possession of any invention having a *distal member* based on the '391 Patent, (2) the Challenged Claims are not entitled to the benefit of an earlier filing date from any of the purported priority applications.

Pet. 15 (citing Ex. 1012 ¶ 44).

2. Patent Owner's Position

Patent Owner contends that the '611 provisional application discloses a device with a “beveled platform 5,” which is the claimed “distal member.” Prelim. Resp. 20, 44 (citing Ex. 1007, 38⁵). According to Patent Owner, “[t]he distal member/beveled platform includes a forward end with a tip (*i.e.*, ‘first end/beveled platform tip/insertion blade tip 6’) and a rearward end (*i.e.*, ‘second end/back of the beveled platform 7’).” *Id.*

⁵ The cited page numbers in Ex. 1007 refer to the page numbers added by Petitioner in the bottom-right corner of the page.

Patent Owner also asserts that the term “distal member” does not conflict with the invention disclosed in the ’391 patent and priority applications because, “using the proper construction of the term ‘edge’ (line/border between the sides and top of the device) . . . the device disclosed in the ’611 provisional includes edges that start at the tip and extend rearward, and also have a gap between them.” Prelim. Resp. 48 (citing *Vas-Cath*, 935 F.2d at 1564). Patent Owner further contends that the ’391 patent identified a gap (14) in, for example, Fig. 19A (shown below):

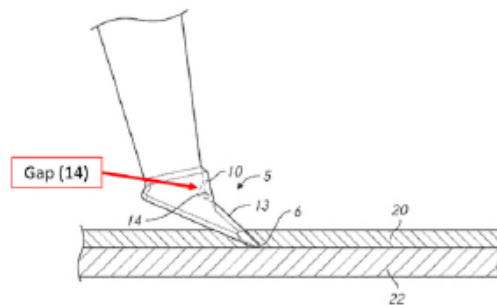
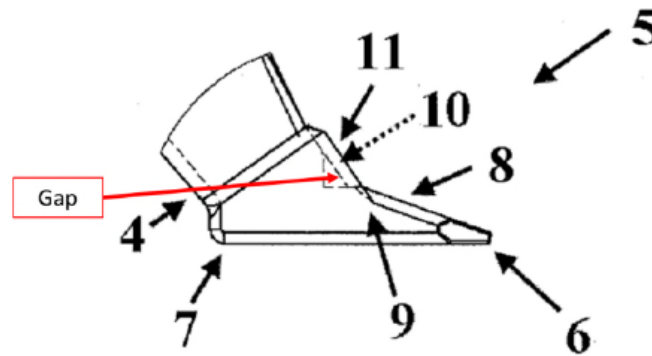


FIG. 19A

**Ex.1001 (’391 patent), Fig. 19A
(annotated)**

Id. at 46, 63 (citing Ex. 1001, Fig. 19A). According to Patent Owner, while not labeled as such, Figure 1 of the ’611 provisional application “clearly depicts the exact same structure” as shown in the annotated figure from the ’611 provisional below:

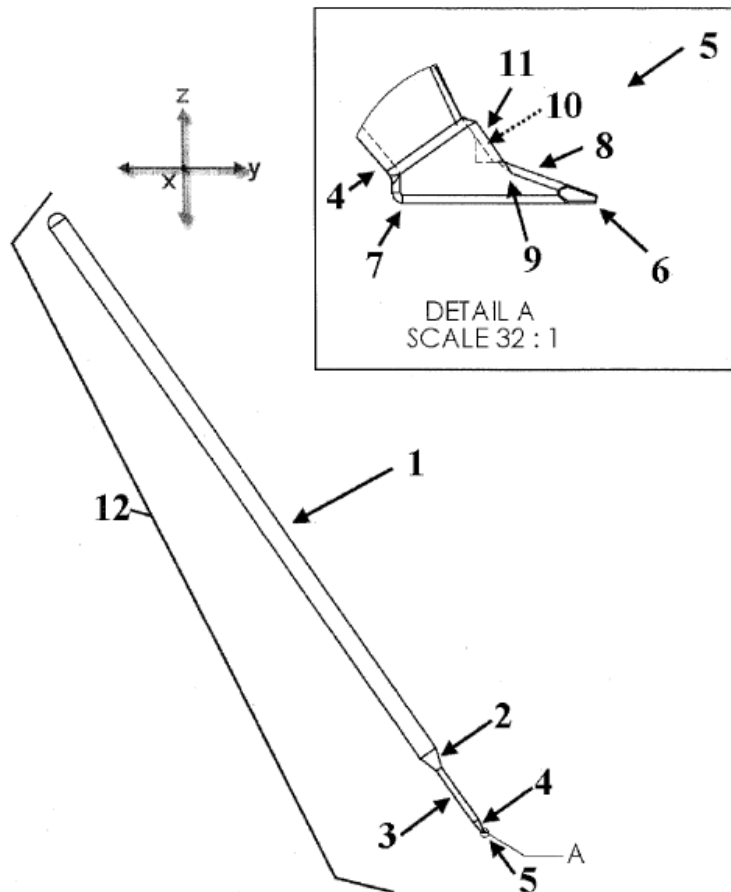


Ex.1007 ('611 provisional), Fig. 1 (enlarged, annotated)

Id. at 46 (citing Ex. 1007, Fig. 1). Patent Owner’s annotated Figure 1 includes a label showing the gap. Thus, Patent Owner contends that the ’611 provisional application provides written description support for the “distal member” limitation of the ’391 patent claims. *Id.* at 48.

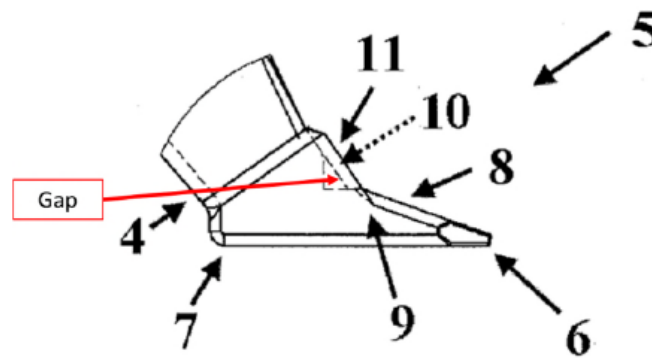
3. Analysis

Based on the evidence and arguments of record, we find that the provisional application provides sufficient written description support for the claimed “distal member.” The ’611 provisional application discloses that “[i]n one embodiment, the invention relates to a device comprising: a handle 1, interface of tool shaft and handle 2, a tool shaft 3, interface of tool shaft and beveled platform 4, *beveled platform 5, a first end/ beveled platform tip/ insertion blade tip 6, a second end/ back of the beveled platform 7, a first side 8, a second side 9, a first blade 10, and a second blade 11.*” Ex. 1007, 38 (emphasis added). The ’611 provisional application depicts these elements in Figure 1 below:



Ex. 1007, Fig 1. As shown in Figure 1, the beveled platform (5) is at the distal end of the shaft (3) and it has a forward end (6) and a rearward end (7) as required by the claimed “distal member.” Ex. 1001, 3:56–57, 25:31–33, 26:39–41.

We also agree with Patent Owner that the term “distal member” does not conflict with the ’391 patent or the ’611 provisional application. As discussed further *infra*, under the adopted construction of the term “edge,” as the lines/borders between the sides (8, 9) and top of the distal member, Petitioner’s annotated version of Figure 1 of the ’611 provisional application (reproduced below) depicts a gap between the portion of the right and left edges that comprise the lateral blades/cutting elements (10, 11):



Ex.1007 ('611 provisional), Fig. 1 (enlarged, annotated)

See Prelim. Resp. 46 (citing Ex. 1007, Fig. 1). Patent Owner's annotated Figure 1 includes a label showing the gap.

Although the term “distal member” is not used in the '611 provisional application, an adequate description does not require any particular form of disclosure or that the specification recite the claimed invention *in haec verba*. *Ariad*, 598 F.3d at 1351. Figure 1 illustrates platform (5) as being located at the distal end of device (12) and having a forward end (6) and a rearward end (7). Ex. 1007, Fig. 1. Thus, we find that “distal member” is sufficiently supported in the '611 provisional application disclosure and figures. See *Vas-Cath*, 935 F.2d at 1564 (“drawings alone may be sufficient to provide the ‘written description of the invention’ required by § 112, first paragraph”); see also *Lockwood v. Am. Airlines, Inc.*, 107 F.3d, 1572 (Fed. Cir. 1999) (explaining that the necessary support may be provided through the “words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention”).

B. Asserted Lack of Written Description for “a right edge and a left edge extending towards the rearward end from the tip,” “wherein a width between the right and left edges increases as they extend rearward,” and “a width between the right and left edges increases from a first width at a forwardmost portion of the distal member to a second width, greater than the first width, at a rearward portion of the distal member.”

Claims 1 and 13 recite “a right edge and a left edge extending towards the rearward end from the tip,” and “wherein a width between the right and left edges increases as they extend rearward,” while claim 8 recites “a width between the right and left edges increases from a first width at a forwardmost portion of the distal member to a second width, greater than the first width, at a rearward portion of the distal member.” Ex. 1001, 25:35–45, 26:14–18. Petitioner contends that the priority applications of the ’391 patent fail to provide written description support for these terms. Pet. 43–46. Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 48–53.

1. Petitioner’s Position

Petitioner contends that, other than the material in the two new paragraphs and the challenged claims, there is no mention or description of a “right edge” or a “left edge” anywhere else in the ’391 patent disclosure or any of the priority applications. Pet. 16, 44. According to Petitioner, the ’391 patent instead

consistently use three interchangeable terms to refer to the same structural component of the disclosed device: *e.g.*, in the ’391 Patent, first or second **lateral element** is used at least 30 times; first or second **lateral blade** is used at least 15 times; and first or second **cutting edges** are used at least 6 times.

Id. at 16. Petitioner asserts that none of these terms provides adequate written description support for a “right edge” or a “left edge” as required by the claims. *Id.*

According to Petitioner, “the ’391 Patent consistently teaches the first and second *lateral elements* ‘extending from the proximal side of the platform,’ as opposed to from the tip at a ‘distal side of the platform.’” Pet. 16 (citing Ex. 1001, 4:31–32; 4:38–41; 5:65–67; 6:1–2; 6:33–34). Petitioner further contends that “[t]he ’391 Patent also makes clear that the *ramp* must be located between the *tip* and first and second *lateral elements*.” *Id.* For example, “the specification discloses that ‘the *ramp* 13 increases from a distal 10 width at the distal side (*e.g.*, at the *tip* 6) to a proximal width, greater than the distal width, at the proximal side (*e.g.*, adjacent to the *lateral blades* 10, 11).” *Id.* at 16–17 (citing Ex. 1001, 13:10–13). Petitioner further contends that “[t]he specification also notes that ‘between the cutting *tip* and the first and second *lateral blades* 10, 11, the *ramp* 13 is shaped to avoid cutting tissue.” *Id.* at 17 (citing Ex. 1001, 16:46–48). According to Petitioner, because “the ’391 Patent figures all consistently show the tip, ramp and lateral elements sequentially adjoined along the lateral direction . . . [the] disclosure of ‘a right edge and a left edge extending towards the rearward end from the tip’ makes no sense in the context of the rest of the ’391 Patent or any of the purported priority applications.” *Id.* (citing Ex. 1001, Figs. 4, 8–19).

Petitioner also contends that, other than the material in the two new paragraphs and the challenged claims, there is no mention or description of a “width between the right and left edges” anywhere else in the ’391 patent disclosure or any of the priority applications. Pet. 19, 44. According to Petitioner, “[i]f the right and left edges recited in the Challenged Claims are interchangeable with the first and second lateral elements (or blades or cutting edges) taught in the ’391 Patent, then the specification excludes the

claimed (non-parallel) embodiment” because the “’391 Patent states consistently that the lateral elements must be parallel to each other.” *Id.* at 19 (citing Ex. 1001, 13:8–9 (“the first and second lateral blades are parallel to each other.”); 14:53–54 (“said first blade 10 and said second blade 11 are parallel (shown in FIG. 15)”). Petitioner further contends that “conversely, if the right and left edges must be different than the first and second lateral elements, then the required ‘gap rearward of the tip and between the right edge and the left edge’ is missing” because the only “gap” described in the ’391 patent other than in the two new paragraphs is located between the first and second lateral elements. *Id.* 19–20 (citing Ex. 1001, Fig. 4).

Petitioner also asserts that, for the same reasons as discussed above regarding the terms “right edge” and “left edge,” the term “a width between the right and left edges increases from a first width at a forwardmost portion of the distal member to a second width, greater than the first width, at a rearward portion of the distal member” is also not supported by any of the priority applications. Pet. 45–46.

Petitioner and Dr. Condon assert that the “wholly different terms” used in the two new paragraphs and the claims versus the rest of the ’391 patent and the priority applications “to describe the distal end of the disclosed embodiment would certainly confuse a POSA regarding what constitutes” a “right edge” and a “left edge,” and a “width between the right and left edges.” Pet. 17, 20 (emphasis omitted) (citing Ex. 1012 ¶¶ 48, 53). Petitioner further asserts that a POSA would find these terms to “conflict[] irreconcilably” with the rest of the ’391 patent and the priority applications. *Id.* at 17, 20, 44. According to Petitioner:

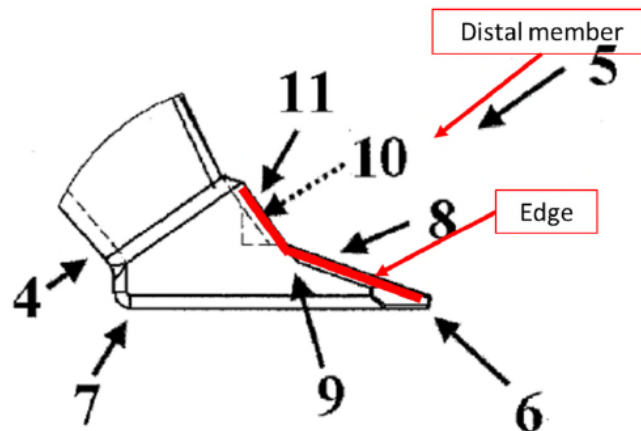
a POSA would necessarily conclude that (1) Patent Owner was not in possession of any invention having . . . “a right edge and

a left edge extending towards the rearward end from the tip;” and/or “wherein a width between the right and left edges increases as they extend rearward,” based on the ’391 Patent, and (2) the Challenged Claims are not entitled to the benefit of an earlier filing date from any of the purported priority applications.

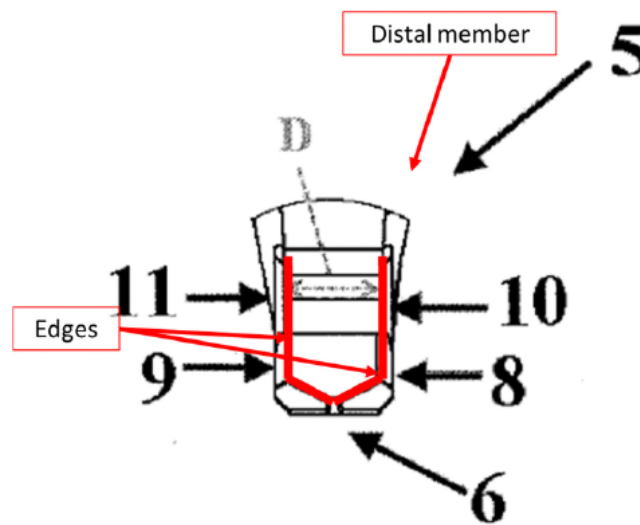
Id. at 44–45.

2. Patent Owner’s Position

Patent Owner contends that the ’611 provisional application discloses a dual blade device with “*a right edge and a left edge*’ (*i.e.*, the line/border between the sides and top of the beveled platform),” which extend towards the rearward end from the tip (6) as shown in the annotated figures below. Prelim. Resp. 20, 45 (citing Ex. 1007, 38, Figs. 1, 3).



Ex.1007 ('611 provisional), Fig. 1 (enlarged, annotated)

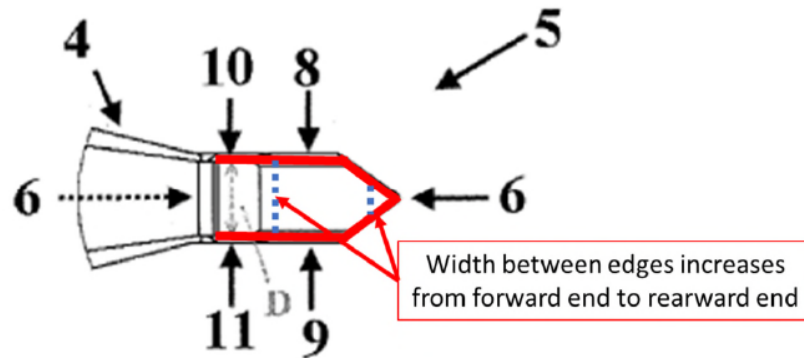


Ex.1007 ('611 provisional), Fig. 3 (enlarged, annotated)

Id. at 21, 45–46, 49 (citing Ex. 1007, Figs. 1, 3). Patent Owner’s annotated Figures 1 and 3 include labels showing the edges of the distal member.

Patent Owner also asserts that the term “edge” does not “conflict irreconcilably” with the invention disclosed in the ’391 patent and priority applications because, “under the proper construction of the term ‘edge,’ the device disclosed in the ’611 provisional includes edges that form the border between the sides and top of the device.” Prelim. Resp. 50. As explained *supra*, according to Patent Owner, the device disclosed in the ’611 provisional application also includes a gap between the edges as required by the claims. *Id.* at 46, 48.

Patent Owner further contends that the ’611 provisional application also discloses that the width between the right and left edges increases from the forward end to the rearward end of the device as shown in the annotated figure below:



Ex.1007 ('611 provisional), Fig. 6 (enlarged, annotated)

Prelim. Resp. 22, 52 (citing Ex. 1007, Fig. 6). Patent Owner's annotated Figure 6 includes lines demarcating the edges and an added label showing how the width between the edges increases from the forward end to the rearward end.

Thus, Patent Owner asserts that the width limitation does not "conflict irreconcilably" with the invention disclosed in the '391 patent and priority applications because, under the proper construction for the term "edge," the edges clearly increase in width as they extend rearward from the tip. Prelim. Resp. 53 (citing Ex. 1007, Fig. 6). According to Patent Owner, Petitioner's arguments regarding the "width" limitation in claim 8 fail for the same reasons. *Id.* at 53. Thus, Patent Owner contends that the '611 provisional application provides written description support for the edge and width limitations of the '391 patent claims. *Id.* at 50, 53.

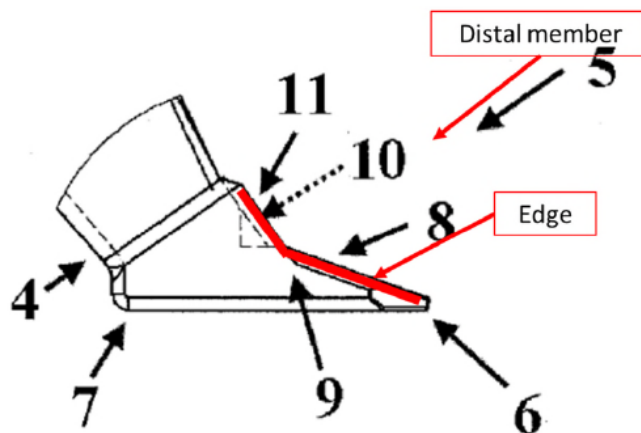
3. Analysis

Based on the evidence and arguments of record, we find that the provisional application provides sufficient written description support for "a right edge and a left edge extending towards the rearward end from the tip," "wherein a width between the right and left edges increases as they extend rearward," and "a width between the right and left edges increases from a

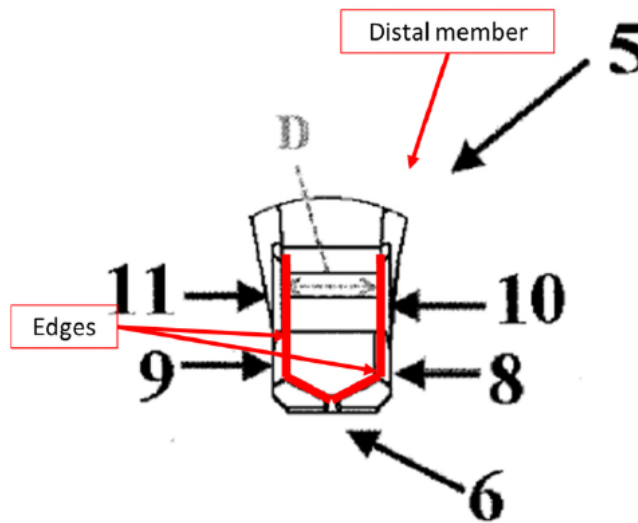
first width at a forwardmost portion of the distal member to a second width, greater than the first width, at a rearward portion of the distal member.”

Petitioner’s arguments primarily depend on their overly narrow proposed construction of “edge” as limited to the cutting structure. However, under the adopted construction of “edge” as the line/border between the sides and top of the distal member, the disputed claim terms are supported by the ’611 provisional application.

The ’611 provisional application discloses a first side (8) and a second side (9) of the beveled platform (5)/distal member wherein the first lateral blade (10) and the second lateral blade (11) are “along the sides of said beveled platform.” Ex. 1007, 38. As shown in the annotated figures below, the ’611 provisional application depicts right and left edges, which are the lines/borders between the sides (8, 9) and top of the distal member, wherein these edges extend towards the rearward end from the tip (6).

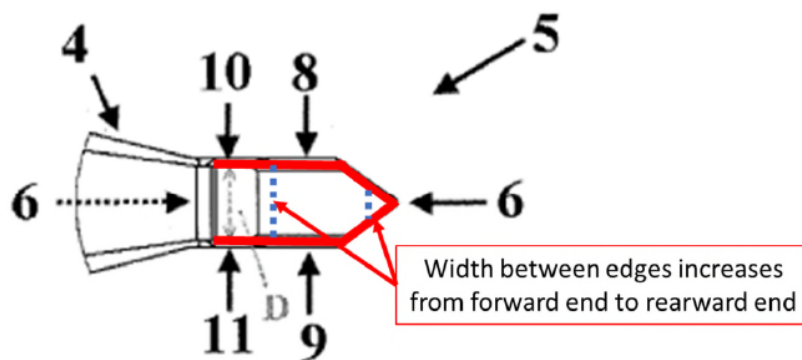


Ex.1007 ('611 provisional), Fig. 1 (enlarged, annotated)



Ex.1007 ('611 provisional), Fig. 3 (enlarged, annotated)

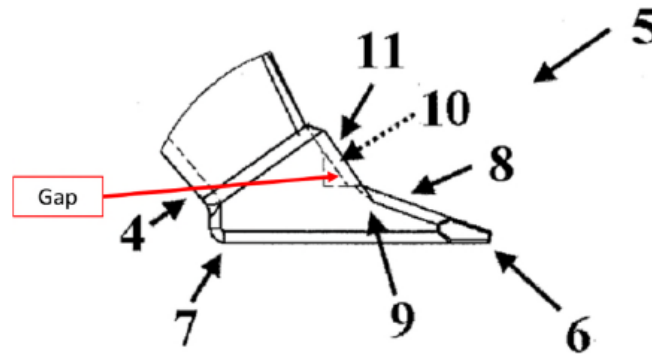
See Prelim. Resp. 21, 45–46 (citing Ex. 1007, Figs. 1, 3). Patent Owner’s annotated Figures 1 and 3 include added lines and labels indicating the edges of the distal member. The right and left edges increase in height as they extend rearward as shown in Figure 1 above, and also have a width between them that increases as they extend rearward as shown in the annotated version of Figure 6, reproduced below.



Ex.1007 ('611 provisional), Fig. 6 (enlarged, annotated)

See Prelim. Resp. 22, 52 (citing Ex. 1007, Fig. 6). Patent Owner’s annotated Figure 6 above includes added lines demarcating the edges and a label

indicating that the width between the edges increases from the forward end to the rearward end. The '611 provisional application also depicts the blades being separated by a distance (D), thus depicting a gap between a portion of the right and left edges. See Ex. 1007, 44, Figs. 3, 6. This gap is also shown in annotated Figure 1 below:



Ex.1007 ('611 provisional), Fig. 1 (enlarged, annotated)

Id. at 46 (citing Ex. 1007, Fig. 1).

Petitioner acknowledges that there is a gap between the first and second lateral elements (*i.e.*, cutting blades 10, 11) but contends that the gap is missing if the right and left edges encompass something more or different than the lateral elements. See Pet. 19–20 (citing Ex. 1001, Fig. 4).

However, the '391 patent Specification and claims do not require that the gap exist along the entirety of the right and left edges but only that a gap be present “between the right edge and the left edge.” Ex. 1001, 3:61–62, 25:39–40. As illustrated above, and as acknowledged by Petitioner, such a gap is present.

Thus, we find that the terms, “a right edge and a left edge extending towards the rearward end from the tip,” “wherein a width between the right and left edges increases as they extend rearward,” and “a width between the right and left edges increases from a first width at a forwardmost portion of

the distal member to a second width, greater than the first width, at a rearward portion of the distal member” are sufficiently supported by the ’611 provisional application text and figures.

In sum, with regard to the non-disclaimed claims, based on the information disclosed in the ’611 provisional application and the current record, we are persuaded that the disclosure of the ’611 provisional application “reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date.” *Eiselstein*, 52 F.3d at 1039 (citing *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985)). Accordingly, the record before us supports Patent Owner’s contention that the non-disclaimed ’391 patent claims receive priority to the April 24, 2012 filing date of the ’611 provisional application.

V. ASSERTED LACK OF WRITTEN DESCRIPTION

Petitioner asserts that the claims of the ’391 patent lack written description support based on the same arguments made to argue lack of priority to the ’611 provisional application. *See* Pet. 48–52. Patent Owner disputes this assertion. *See* Prelim. Resp. 60–65.

We are not persuaded by Petitioner’s written description arguments. While Petitioner contends that new disclosure was added to the ’391 patent application, Petitioner does not contend that any disclosure from the ’611 provisional application is absent in the ’391 patent. *See* Pet. 42–43. Accordingly, because we find that the ’391 patent claims are supported by the ’611 provisional application, we also find that the ’391 patent provides written description support for the claims for the same reasons as discussed *supra*. In fact, the ’391 patent includes the newly added paragraphs which

Petitioner acknowledges provide *ipsis verbis* support for the claims. *See* Pet. 8, 19, 34, 47. Thus, we find that Petitioner has not shown that it is more likely than not that the claims of the '391 patent are invalid for lack of written description.

VI. ASSERTED INDEFINITENESS

Petitioner asserts that the claims of the '391 patent are indefinite because the claim terms “a distal member positioned at a distal end of the shaft, the distal member having a forward end and a rearward end,” “a right edge and a left edge extending towards the rearward end from the tip,” and “wherein a width between the right and left edges increases as they extend rearward,” are not supported by the '391 patent or the priority applications. Pet. 53–54. Petitioner argues that these terms do not appear in the priority applications and “conflict irreconcilably” with the rest of the '391 patent and the priority applications. *Id.* at 54.

According to Petitioner, “[t]he internal inconsistency in the '391 Patent created by the New Matter is fatal to the Challenged Claims, the ‘objective boundaries’ of which, therefore, are unclear and cannot be understood by a POSA with any reasonable certainty.” Pet. 54 (citing *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014)). Petitioner contends that the '391 patent does not teach any device having the above-referenced claim elements “or any methods using such a device for incising a trabecular meshwork (TM) to form an opening in the TM tissue of an eye.” *Id.* Patent Owner disputes this assertion. *See* Prelim. Resp. 66–67.

We agree with Patent Owner that Petitioner’s indefiniteness arguments rely on the same rationale as the arguments put forth for lack of priority and written description and are premised on their overly narrow

proposed construction of the term “edge.” *See* Prelim. Resp. 66–67.

Further, the ’391 patent discusses the use of the disclosed dual blade device for incising the TM to form an opening in the TM tissue of the eye. *See* Ex. 1001, 15:53–16:34.

Therefore, for the reasons discussed *supra* with regard to priority, we are not persuaded by Petitioner’s arguments that the claims of the ’391 patent are indefinite. As discussed, under the adopted construction of “edge,” we do not find that the disputed terms “conflict irreconcilably” with the ’391 patent and priority applications. Rather, we find that the claims, viewed in light of the ’391 specification, inform those skilled in the art about the scope of the invention with reasonable certainty. *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014). Thus, we find that Petitioner has not shown that it is more likely than not that the claims of the ’391 patent are invalid for indefiniteness.

VII. ASSERTED ANTICIPATION AND OBVIOUSNESS

Petitioner asserts that the claims are anticipated by and/or obvious over Baerveldt, which is prior art under 35 U.S.C. § 102(a)(2) because the ’391 patent is not entitled to an effective filing date earlier than November 8, 2019. Pet. 56–72. As discussed *supra*, we find that the non-disclaimed claims of the ’391 patent are entitled to the April 24, 2012 priority date of the ’611 provisional application. Therefore, Baerveldt, which has an earliest possible priority date of February 10, 2017, is not prior art to the non-disclaimed ’391 patent claims. For this reason, we find that Petitioner has not shown that it is more likely than not that the claims of the ’391 patent are invalid for anticipation and/or obviousness over Baerveldt.

VIII. CONCLUSION

After considering the evidence and arguments presently before us, we determine that Petitioner has not satisfied the burden under 35 U.S.C. § 324(a) to show that it is more likely than not that at least one of the challenged claims is unpatentable. Accordingly, we do not institute a post-grant review.

IX. ORDER

In consideration of the foregoing, it is:

ORDERED that, pursuant to 35 U.S.C. § 324(d), the Petition is *denied*.

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Patent 10,786,391 B2

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