

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IVANTIS, INC.,
Petitioner,

v.

GLAUKOS CORP.,
Patent Owner.

Case IPR2018-01147
Patent 6,626,858 B2

Before ULRIKE W. JENKS, BART A. GERSTENBLITH, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314(a)

Denying Motion to Correct the Petition

37 C.F.R. § 42.104(c)

I. INTRODUCTION

A. *Background*

Ivantis, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 24–27, 30, 33–36, 40, 47, 48, and 50 (“the challenged claims”) of U.S. Patent No. 6,626,858 B2 (Ex. 1001, “the ’858 patent”). Paper 1 (“Pet.”). Glaukos Corp. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 8 (“Prelim. Resp.”). With our authorization (Paper 9), Petitioner filed a Motion to Correct the Petition pursuant to 37 C.F.R. § 42.104(c) (Paper 10 (“Motion” or “Mot.”)); Patent Owner filed an Opposition (Paper 12 (“Opp.”)), and Petitioner filed a Reply (Paper 13 (“Reply”)).¹ We address Petitioner’s Motion below.

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314. *See also* 37 C.F.R § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). For the reasons set forth below, we determine that Petitioner has not demonstrated that there is a reasonable likelihood that at least one of the challenged claims is unpatentable. Accordingly, we do not institute *inter partes* review of the challenged claims.

B. *Related Matters*

The parties state that the ’858 patent has been asserted in the following matter (Pet. 1; Paper 7, 2): *Glaukos Corp. v. Ivantis Inc.*, No. 8:18-cv-00620 (C.D. Cal.). Additionally, Petitioner filed a petition requesting *inter partes* review of related U.S. Patent No. 9,827,143

¹ We authorized briefing on Petitioner’s request for authorization to file a motion to correct the Petition during a conference call on September 18, 2018 (Paper 9); a transcript of the call is Exhibit 2010 in this proceeding.

(IPR2018-01180) that claims benefit to the same provisional application as the '858 patent.

C. The '858 Patent

The '858 patent, titled “Shunt Device and Method for Treating Glaucoma,” issued on September 30, 2003, and claims priority from an application filed on September 12, 2002, a continuation application filed on April 6, 2000, and a provisional application filed April 26, 1999. Ex. 1001, [54], [45], [22], [63], [60].

The '858 patent describes:

Shunt devices and a method for continuously decompressing elevated intraocular pressure in eyes affected by glaucoma by diverting excess aqueous humor from the anterior chamber of the eye into Schlemm's canal where post-operative patency can be maintained with an indwelling shunt device which surgically connects the canal with the anterior chamber. The shunt devices provide uni- or bi-directional flow of aqueous humor into Schlemm's canal.

Ex. 1001, Abst.

D. Illustrative Claim

Of the challenged claims, claim 24 is the only independent claim and is illustrative of the claimed subject matter. Claim 24 is reproduced below:

24. An aqueous humor shunt device to divert aqueous humor in an eye from the anterior chamber into Schlemm's canal, the shunt device comprising a distal portion having at least one terminal aspect sized and shaped to be received within a portion of Schlemm's canal and a proximal portion having at least one terminal aspect sized and shaped to be received within the anterior chamber of the eye, wherein device permits fluid communication from the proximal portion in the anterior chamber to the distal portion in Schlemm's canal, wherein the shunt device is non-linear prior to insertion.

Ex. 1001, 13:25–35.

E. Evidence Relied Upon

Petitioner relies on the following evidence in support of the Petition (Pet. 3, 10–22):

Reference	Patent / Publication	Date	Ex. No.
Spiegel ²	<i>Chirurgische Glaukomtherapie</i> , in NUTZEN UND RISIKEN AUGENÄRZTLICHER THERAPIE 139, (eds. Anselm Kampik and Franz Grehn, 1998)	1998	1002
Grieshaber B2 ³	Australian Patent App. Publication No. AU 199876197 B2, issued as Australian Patent No. 746903	May 2, 2002	1004
Richter	U.S. Patent No. 5,868,697	Feb. 9, 1999	1005

Petitioner supports its contentions with the declaration of Andrew G. Iwach M.D. (Ex. 1006 (“Iwach Declaration”)).

F. Asserted Grounds of Unpatentability in the '858 Petition

Petitioner challenges the '858 patent based on the following grounds of unpatentability (Pet. 3):

References	Basis	Claim(s) Challenged
Spiegel, Grieshaber B2	§ 103 ⁴	24–27, 30, 34, 40, 47, and 48
Spiegel, Grieshaber B2, Richter	§ 103	33, 35, 36, and 50

² In the Petition, all references to this book chapter are to the certified English-language translation (“Spiegel”). Ex. 1003.

³ Grieshaber A1 refers to the published Australian patent application, AU 199876197 A1, published February 25, 1999.

⁴ Because the claims at issue have a filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), we apply the pre-AIA version of 35 U.S.C. § 103 in this Decision.

II. ANALYSIS

A. *Petitioner's Motion to Correct the Petition*

We first consider Petitioner's Motion to Correct the Petition because resolution of this Motion is dispositive as to our consideration of Petitioner's contentions regarding the unpatentability of the challenged claims based on the asserted references. In its Motion, Petitioner requests relief to correct purported clerical errors based on its filing of Grieshaber B2 (Exhibit 1004), and certain citations in the Petition and Iwach Declaration (collectively referred to as the "error"). Mot. 1–3. Essentially, replacing filed Exhibit 1004 with Grieshaber A1, and changing identified citations in the Petition and Iwach declaration from Grieshaber B2 to Grieshaber A1. *Id.* at 3 ("the proposed corrections"). Petitioner supports its Motion with affidavits from its counsel, Deborah E. Fishman (Mot. Ex. D, or "Ex. D"), and legal assistant, Douglas V. Smith (Mot. Ex. E or "Ex. E"), detailing the nature of the error and the manner in which the error occurred. *Id.* at 3.

Petitioner characterizes this error as "inadvertent and unintentional" (Mot. 4), stating that it "did not intend to rely on Grieshaber B2, as "Grieshaber B2 is not prior art to the '858 patent" (*id.* at 4–5). To demonstrate its intent, Petitioner directs us to passages in the Petition referring to Grieshaber "as a patent *application*, not a patent." *Id.* at 5 (citing Pet. 3, 14). In Petitioner's view, Patent Owner was not prejudiced by this error and would not be prejudiced by the proposed corrections because Patent Owner was aware of Grieshaber A1 and Petitioner's intent to rely on it based on statements made in the Petition itself (*id.* at 5–6); and the differences between Grieshaber A1 and Grieshaber B2 are minor (*id.* at 6–8). Petitioner recognizes that the proposed corrections would render moot

Patent Owner's contention that Grieshaber B2 is not prior art, but asserts that Patent Owner's substantive arguments addressing the disclosure of Grieshaber would not be impacted by the proposed corrections (*id.* at 8). Noting that it could still file a corrected petition within the time period set forth in 35 U.S.C. § 315(b), Petitioner argues that "doing so would elevate form over substance," resulting in unnecessary delay in the proceeding, impose additional expenses on both parties, and present a needless burden on us. *Id.* at 9. Petitioner concludes that the proposed corrections would not impact our determination on whether to institute this *inter partes* review.⁵ *Id.*

Patent Owner opposes this Motion, arguing that "citing, quoting, and filing Grieshaber B2" by Petitioner was not a clerical mistake, and that the proposed corrections, if allowed, "would prejudice Patent Owner and impact the Board's decision on institution." Opp. 1. Specifically, Patent Owner argues that (1) Petitioner fails to prove that the error was "clerical" (*id.* at 1–6); (2) Patent Owner would be prejudiced if the proposed corrections were allowed (*id.* at 6–10); and (3) the Board's decision on institution would be impacted (*id.* at 10). Patent Owner contends that granting the Motion would necessitate another preliminary response, would delay the proceeding, and "impose costs *only* on Patent Owner." *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

⁵ It was noted during the conference call with the parties that Petitioner could refile the petition with the proposed corrections and be accorded a new filing date. Ex. 2010, 29:6–22. We indicated that we would consider a compressed briefing schedule based on the date of refiling. *Id.*

permitted, but never compelled, to institute an IPR proceeding”). An *inter partes* review proceeding begins with the filing of a petition. 37 C.F.R. § 42.104; 35 U.S.C. § 312(a). The petition itself serves the purpose of providing adequate notice to the patent owner of the basis for relief, by laying out the petitioner’s grounds and supporting evidence. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48763 (Aug. 14, 2012). Our rules require that the petitioner support its challenges by a preponderance of the evidence in order to prevail in an *inter partes* review. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). The rules, however, provide some flexibility in allowing for correction of certain types of mistakes, i.e., clerical or typographical, in papers filed by the parties. 37 C.F.R. § 42.104(c) (“A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.”); *see* 37 C.F.R. § 42.5(a) (“The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.”).

In evaluating whether to exercise our discretion and allow the proposed corrections, the Board has considered various non-exclusive factors, such as but not limited to: (1) the nature of the error, and whether the party requesting relief provides adequate explanation for how the error occurred, including how the error was discovered; (2) the length of time elapsed between learning of the error and bringing the error to the Board’s attention; (3) prejudice to the other party, if any, by allowing the proposed corrections; and (4) whether the proposed corrections have any impact on the proceeding. Against this backdrop, we consider each of these factors as

they apply to the circumstances here, but stress that not all the factors need to weigh against exercising our discretion to deny Petitioner's motion.

1. The nature of the error, and whether the party requesting relief provides adequate explanation for how the error occurred, including how the error was discovered.

Simply put, the error involves filing the wrong reference as prior art and referring to this incorrect reference in the Petition and Iwach Declaration. Petitioner avers that this error was inadvertent and occurred “[d]uring preparation of the Petition for filing, [because] the incorrect version of the reference (i.e., Grieshaber B2) was inadvertently stored on the network share drive used by an associate and a paralegal, and was mistakenly referenced during cite checking and proofing of the Petition.” Mot. 5 (citing Ex. E ¶¶ 4–6). Petitioner notes that it first became aware of the error after reviewing Patent Owner's argument in its Patent Owner Preliminary Response, challenging Grieshaber B2's status as prior art to the '858 patent. *Id.* at 9. Indeed, Petitioner's counsel, Deborah Fishman, testifies that she “did not notice these errors in the Petitions or that the Grieshaber B2 patent had been filed as an exhibit instead of the Grieshaber A1 application until I received Patent Owner's Preliminary Responses on Friday and Saturday, September 7 and 8, 2018.”⁶ Ex. D ¶ 12.

Patent Owner counters that the identified error is not “clerical” in nature but rather an “error of law” because Petitioner seeks to replace a non-prior-art patent publication, Grieshaber B2, with the prior art published *application* corresponding to that patent, Grieshaber A1, having an earlier

⁶ Ms. Fishman's testimony refers to the Petition in this case and the petition in related case IPR2018-01180.

priority date. Opp. 2 (citing *Wavetamer Gyros, LLC v. Seakeeper, Inc.*, Case IPR2017-01931, Paper 8 (PTAB Dec. 11, 2017)). Patent Owner has the better argument, i.e., the error involves a matter of law and is not clerical. There is no dispute between the parties that the version of the Grieshaber reference filed with the Petition as Exhibit 1004, i.e., Grieshaber B2, is not prior art to the '858 patent. Mot. 5; Opp. 1; *see* Ex. 2010, 9 (“What was attached to the Petition and what was served on Patent Owner’s counsel was the B2 issued patent. And . . . Patent Owner correctly points out in their preliminary response that the B2 itself . . . is too late to be prior art . . .”); *see also id.* at 16 (“the reference that [Petitioner] cited happens not to be prior art”). Thus, we find that the nature of the error is such that the proposed corrections would involve a significant modification to the record, including the filing of new evidence, i.e., Grieshaber A1, and correction to corresponding citations in the Petition as well as the Iwach Declaration.

As to discovery of the error, Petitioner essentially credits Patent Owner. Specifically, Petitioner’s counsel testifies that she became aware of the error in the Petition and accompanying evidence after receiving and reviewing Patent Owner’s Preliminary Response. Ex. D ¶ 12; *see* Ex. 2010, 8 (“[W]e did not notice that the wrong documents had been filed until it was pointed out to us by the Patent Owner in their preliminary Patent Owner response.”); *see id.* at 9 (“What was attached to the Petition and what was served on Patent Owner’s counsel was the B2 issued patent.”).

Given that the proposed corrections permeated preparation of the Petition and would involve significant modification to the present record, this factor weighs strongly in Patent Owner’s favor.

2. *The length of time elapsed between learning of the error and bringing the error to our attention*

After Petitioner learned of the error on September 7–8, 2018, it notified Patent Owner on September 10th (Ex. D ¶ 12), and on September 11th “sent an e-mail to the Board requesting a telephone conference to request leave to file a motion to correct the Petitions” (*id.* ¶ 13). Based on Petitioner’s responsiveness after learning of the error, this factor weighs in Petitioner’s favor.

3. *Prejudice to the other party, if any, by allowing the proposed corrections.*

Petitioner takes the position that the proposed corrections are merely clerical or typographical in nature and not prejudicial to Patent Owner. Mot. 5–6; Reply 3. According to Petitioner, any differences between Grieshaber A1 and Grieshaber B2 are minor and limited to sections not relied on by Petitioner in formulating their ground(s) of unpatentability. Mot. 6–8; Reply 2–3. By way of example, Petitioner directs us to text in the Petition referring to Grieshaber “as a patent *application*, not a patent.” Mot. 5. Petitioner also points us to the statement in the Petition “that “[t]he Grieshaber Australian patent application was published on February 25, 1999, two months before the priority date of the ’858 patent and, as such, constitutes prior art under 35 U.S.C. § 102(a).”” *Id.* (citing Pet. 14). Petitioner asserts that there is no prejudice to Patent Owner because statements made in the Preliminary Response demonstrate that “Patent Owner was clearly aware of the Grieshaber application (i.e., Grieshaber A1) published on February 25, 1999, and was clearly aware of Petitioner’s intent to rely on that published application.” *Id.* at 6 (citation omitted). Petitioner recognizes that the proposed corrections would render Patent Owner’s

argument directed to Grieshaber B2 moot, but contends that the proposed corrections would not impact Patent Owner's arguments directed to the disclosure of the reference. *Id.* at 8.

Patent Owner disagrees, arguing that it would be prejudiced by the proposed corrections. Opp. 6–10. Specifically, Patent Owner argues that “nothing in Petitioner's filings indicated any intent to rely on Grieshaber A1,” instead, the Petition, Iwach Declaration, and Exhibit 1004 each identify Grieshaber B2. *Id.* at 7. Patent Owner contends that it should not have to rely on analysis and arguments not in the record, and that additional arguments would have been made in its Preliminary Response if Grieshaber A1 was of record. *Id.* at 7–9. Patent Owner also contends that the 35 U.S.C. § 325(d) arguments made in its Preliminary Response would have been modified if Grieshaber A1 had been the basis for the Petition because Grieshaber A1 “includes specific language found verbatim in the counterparts previously considered by the Office but not present in Grieshaber B2.” *Id.* at 9.

Patent Owner, in formulating its Preliminary Response, should be able to rely on the Petition and accompanying exhibits as being correct. *See* 37 C.F.R. § 42.104(b). At the same time, we remain cognizant of Petitioner's burden to prove unpatentability by a preponderance of the evidence, and this burden does not shift to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378–80 (Fed. Cir. 2015). Thus, Petitioner's argument that Patent Owner could base its Preliminary Response on arguments and evidence Petitioner *intended* to include in the record versus argument and evidence *actually* in the record is unavailing because this expectation places an undue obligation on Patent Owner. Instead, the

burden of establishing that a particular reference constitutes prior art to the '858 patent falls squarely on Petitioner. 35 U.S.C. § 316(e); *see Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1576 (Fed. Cir. 1996) (holding that the challenger “bore the burden of persuasion . . . on all issues relating to the status of [the asserted reference] as prior art”).

Here, it is uncontroverted that Grieshaber A1 is not in the present record. *See* Ex. 2010, 9 (“What was attached to the Petition and what was served on Patent Owner’s counsel was the B2 issued patent.”). Furthermore, as pointed out by Patent Owner, Petitioner relies on the Iwach Declaration, which likewise mentions the later Grieshaber B2 reference. Opp. 3 (citations omitted). In other words, Patent Owner formulated its Preliminary Response based on the arguments and evidence in the existing record, and the existing record does not provide Patent Owner adequate notice that Petitioner intended to rely on Grieshaber A1 instead of Grieshaber B2 in challenging the patentability of the '858 patent. Additionally, we note that the Preliminary Response dedicates a significant portion of the allotted word count disputing that Grieshaber B2 is prior art to the '858 patent. Prelim. Resp. 8, 9–10, 18–21, and 47.

Patent Owner argues persuasively that the proposed corrections would be prejudicial. Namely, because considering and addressing arguments and evidence not presently in the record, even if similar to arguments and evidence presently of record, would inappropriately place an undue burden on Patent Owner. Thus, this factor weighs strongly in Patent Owner’s favor.

4. *Whether the proposed corrections have any impact on the proceeding.*

Petitioner notes that it could refile the Petition with the correct version of the Grieshaber reference, but argues that “doing so would elevate form

over substance, unnecessarily delay *inter partes* review proceedings, impose additional expenses on both parties, and needlessly burden the Board.”

Mot. 9. Petitioner maintains that the proposed corrections would not impact our decision on whether to institute review based on the immediate notification by Petitioner regarding the error. *Id.* Patent Owner disagrees, arguing that because Petitioner admits Grieshaber B2 is not prior art, “there is no basis for instituting a review on the Petition as filed.” Opp. 10.

Patent Owner has the better argument. There is no dispute that the proposed replacement of a non-prior art reference, Grieshaber B2, with a prior art reference having an earlier priority date, Grieshaber A1, impacts whether we institute trial. Moreover, if the proposed corrections were made of record, Patent Owner would require additional time to consider the proposed corrections relative to Petitioner’s originally filed arguments and evidence, and respond to any new arguments and evidence. Thus, this factor weighs in Patent Owner’s favor.

5. *Conclusion*

Upon weighing the above-discussed factors in light of the arguments and evidence of record, we determine that denial of Petitioner’s Motion to Correct the Petition is appropriate based on the circumstances of this case. Not only was the incorrect reference filed as an exhibit, but this error permeates the Petition, and Iwach Declaration. Also, it is not lost on us that we are addressing a motion requesting correction of the identical error in related proceeding IPR2018-01180. IPR2018-01180, Paper 10. As such, we determine that the nature of the error and magnitude of Petitioner’s proposed corrections go beyond what is contemplated by our Rules as a clerical or typographical error, especially in view of the accompanying prejudice to

Patent Owner. For these reasons, Petitioner's Motion to Correct the Petition is denied.

B. Obviousness Based on Grieshaber B2

We next consider the Petition itself. Petitioner challenges the patentability of claims 24–27, 30, 34, 40, 47, and 48 of the '858 patent under 35 U.S.C. § 103 as obvious based on Spiegel and Grieshaber B2; and claims 33, 35, 36, and 50 of the '858 patent under 35 U.S.C. § 103 as obvious based on Spiegel, Grieshaber B2, and Richter. Pet. 3.

To support its contentions, Petitioner identifies the disclosures in the cited references alleged to describe the subject matter in each of the challenged claims. *Id.* at 23–54. Specifically, Petitioner relies on Grieshaber B2's disclosure regarding the use of “a preformed curvature as an alternative to a flexible stent or shunt for insertion into Schlemm's canal” (Pet. 30 (citing Ex. 1004, 9)) to satisfy the limitation in independent claim 24 that “the shunt device is non-linear prior to insertion” (Ex. 1001, 13:34–35).

As discussed above with regard to Petitioner's Motion, there is no dispute between the parties that Grieshaber B2 is *not* prior art to the '858 patent. And, all of Petitioner's challenges are based, in part, upon Grieshaber B2. In light of our denial of Petitioner's Motion, and the parties' agreement that Grieshaber B2 is not prior art to the '858 patent, we are not persuaded that Petitioner has established a reasonable likelihood that claims 24–27, 30, 34, 40, 47, and 48 are obvious based on Spiegel and

Grieshaber B2, and claims 33, 35, 36, and 50 are obvious based on Spiegel, Grieshaber B2, and Richter.⁷

III. CONCLUSION

For the foregoing reasons, we are not persuaded that Petitioner has demonstrated that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one challenged claim of the '858 patent.

IV. ORDER

It is:

ORDERED that Petitioner's Motion to Correct the Petition Pursuant to 37 C.F.R. § 42.104(c) (Paper 10) is *denied*; and

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

⁷ Petitioner acknowledges that there is the potential to re-file the Petition because the one-year time bar under 35 U.S.C. § 315(b) has not expired. *See* Ex. 2017, 28. We point the parties to *General Plastic Industries Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) (precedential), which sets forth a non-exhaustive list of factors the Board takes into consideration when evaluating follow-on petitions.

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