EYE THERAPIES, LLC v. SLAYBACK PHARMA, LLC, Appeal No. 2023-2173 (Fed. Cir. June 30, 2025). Before Taranto, Stoll, and Scarsi. Appealed from PTAB.

Background:

Eye Therapies owns and licenses a patent with claims directed to methods for reducing eye redness *consisting essentially of* administering brimonidine or a composition *consisting essentially of* brimonidine. During prosecution, the Examiner rejected prior versions of the claims, which used "*comprising*" as the transition phrase, as being anticipated by a reference disclosing combined administration of brimonidine and brinzolamide to treat ocular diseases. The Examiner allowed the amended claims reciting "consisting essentially of," citing the applicant's argument that the amended claims *do not require the use of any other active ingredients* in addition to brimonidine. On petition by Slayback Pharma, the Board instituted an IPR. Rejecting Eye Therapies' argument that "consisting essentially of" should be interpreted in view of the prosecution history, the Board concluded that, because brimonidine alone can reduce eye redness, the claimed methods can include additional active agents that may also reduce eye-redness, *e.g.*, brinzolamide, without materially affecting the basic and novel characteristics of the invention. Applying this construction, the Board concluded that the challenged claims were unpatentable. Eye Therapies appealed the Board's decision to the Federal Circuit.

Issues/Holdings:

Did the Board err in their construction of the transition phrase "consisting essentially of" as allowing the coadministration of active ingredients other than brimonidine? Yes, reversed. Did the Board err in its consideration of facts in its obviousness analysis? Yes, vacated in view of an erroneous claim construction and remanded.

Discussion:

First, the Federal Circuit construed the transition phrase "consisting essentially of," agreeing with Eye Therapies that the prosecution history supports an atypical meaning of the phrase, rather than the standard meaning, which might permit additional unlisted active ingredients, given that they do not materially affect the basic and novel characteristics of the invention. Because the applicant secured allowance of the amended claims by arguing that the claimed methods were novel because they "do not require the use of any other active ingredients," and that the cited reference "*teaches away* from methods consisting essentially of administering brimonidine (*i.e.,* methods which do not include administering other active agents)," it is clear that the standard meaning of "consisting essentially of" is incompatible with the more restrictive meaning the applicant ascribed to the phrase. The Federal Circuit reversed the Board's claim construction and found that the transition phrase "consisting essentially of" should be read in this context to exclude use of active ingredients other than brimonidine.

Second, the Federal Circuit considered the Board's obviousness analysis. While the Federal Circuit did not prejudge whether the correct claim construction permits the same conclusion, they concluded that the Board's erroneous claim construction "infected its consideration of facts in its obviousness analysis." The appropriate construction of "consisting essential of" undermines the Board's conclusion that the prior art references, all of which involved compositions including active agents other than brimonidine, teach toward the use of brimonidine alone. Accordingly, the Federal Circuit vacated the Board's decision and remanded the matter.