

Fed. Circ. In June: Transitional Phrases In Patent Claims

By **Sean Murray and Jeremiah Helm** (July 31, 2025, 1:45 PM EDT)

*This article is part of a [monthly column](#) that highlights an important intellectual property appeal from the previous month. In this installment, we examine the Federal Circuit's ruling in *Eye Therapies v. Slayback Pharma*.*

The [U.S. Court of Appeals for the Federal Circuit](#)'s June 30 [decision](#) in *Eye Therapies LLC v. Slayback Pharma LLC* is an interesting opinion on a rarely addressed topic: transitional phrases in patent claims.

Patent claims typically have three portions: a preamble, a transitional phrase and the body of the claim. In a claim to "a chair comprising: a seat, a back, and three legs," the transitional phrase is the single word "comprising." It connects the preamble — "a chair" — with the body of the claim.

Preamble language is regularly disputed in patent litigation when one side can find a plausible argument that the preamble limits the scope of the claim. The body of the claim is almost always a bloody battlefield on which the parties wage full-scale war. The humble transitional phrase, however, is rarely the subject of a substantive dispute.

That was not the case in *Eye Therapies v. Slayback Pharma*. The case began when Slayback Pharma petitioned for inter partes review of Eye Therapies' U.S. Patent No. [8,293,742](#). The '742 patent teaches a method to reduce eye redness using a low-concentration dose of brimonidine.

Eye redness is often caused by dilation of the small blood vessels in the eye. Brimonidine was known to cause vasoconstriction, a narrowing of blood vessels.

The claims of the '742 patent recited specific low concentrations of brimonidine. But the claims contained the relatively uncommon transitional phrase "consisting essentially of." For example, Claim 1 recited: "A method for reducing eye redness consisting essentially of administering brimonidine to a patient" in specific concentrations.

The most common transitional phrase is the word "comprising." Use of "comprising" indicates that the claim covers anything with the expressly listed elements of the claim, even if it also has additional, unlisted elements.

In the chair example, our hypothetical claim would cover any chair with a seat, a back and three legs. Adding armrests, wheels or a fourth leg would not take the chair outside the scope of the claim.

By contrast, the transitional phrase "consisting of" does not permit the addition of any element beyond those expressly listed in the claim. If we substituted "consisting of" for "comprising" in our hypothetical claim, a chair with armrests would not infringe the claim.



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The transitional phrase "consisting essentially of" occupies a middle ground. Claims with this transitional phrase allow the presence of additional, unclaimed elements provided those elements "do not materially affect the basic and novel properties of the invention."

The claims of the '742 patent should therefore have covered methods of treating eye redness that administered other medicaments in addition to brimonidine, so long as the administration of the other medicaments did not "materially affect the basic and novel properties of the invention."

During inter partes review, Slayback Pharma argued that the claims of the '742 patent were obvious over three prior art references. All three references taught administering compositions that contained active ingredients in addition to brimonidine.

The [Patent Trial and Appeal Board](#) concluded that the claims of the '742 patent were obvious over the prior art. In so doing, the board found that the prior art's administration of additional active ingredients did not materially affect the basic and novel characteristics of the invention of the '742 patent.

Eye Therapies argued to the board that the prosecution history of the '742 patent required that the claims be limited to administering brimonidine as the sole active ingredient. Eye Therapies pointed to a statement by the patentee that the claimed methods "do not require the use of any other active ingredients in addition to brimonidine."

The board rejected this argument because prohibiting the use of additional ingredients "would construe the semi-open-ended transition phrase 'consisting essentially of' to have the same scope as the closed transition phrase 'consisting of.'"

On appeal, the Federal Circuit reversed the board's interpretation of the claims. The court held that the patentee's statements during prosecution had redefined the phrase "consisting essentially of." The Federal Circuit first relied, somewhat half-heartedly, on the patentee's statement that the claimed methods "do not require the use of any other active ingredients."

As Eye Therapies pointed out, though, this statement only means that the administration of brimonidine alone is sufficient to infringe the claim — no other active ingredient is required. The statement does not preclude the use of additional ingredients.

But the Federal Circuit did not rely solely on the patentee's statement about what the claimed methods "require." The patentee also distinguished the prior art from its own "methods consisting essentially of administering brimonidine (i.e., methods which do not include administering other active ingredients)."

The use of "i.e." showed that the patentee intended to define the phrase "methods consisting essentially of administering brimonidine" to mean "methods which do not include administering other active ingredients." The patentee therefore adopted a special definition of "consisting essentially of."

Because the board's determination of obviousness was based on prior art references that administered

other active ingredients in addition to brimonidine, the Federal Circuit vacated the obviousness determination and remanded so that the board could consider whether it would have been obvious to modify the prior art to employ a method that administered no active ingredient other than brimonidine.

Although it was vacated, the board's decision was interesting because it addressed an ambiguity in the law. In finding obviousness under the traditional interpretation of "consisting essentially of," the board found that the prior art's use of additional ingredients did not "materially affect the basic and novel characteristics of the invention."

Like brimonidine, some of the additional ingredients in the prior art had the effect of reducing eye redness. That is, they arguably bolstered and augmented the basic and novel characteristic of the invention: reduction of eye redness.

The board's determination appears to implicitly hold that augmenting the novel benefit of the invention does not materially affect the novel characteristics of the invention.

The Federal Circuit's opinion in *Eye Therapies* provides some useful lessons for attorneys prosecuting patents. First and foremost, attorneys should be very careful when using "i.e." or when otherwise restating claim language. Doing so may be considered a redefinition of the claim language in subsequent litigation.

More importantly, the patentee in *Eye Therapies* had no need to distinguish the prior art so broadly. The prior art cited by the patent office achieved vasoconstriction by administering two active ingredients: brimonidine and brinzolamide. The patentee could have claimed treating eye redness by administering brimonidine without administering brinzolamide. The resulting claims would have covered compositions with any active ingredient other than brinzolamide.

Better still, the patentee could have claimed administering brimonidine in a concentration sufficient to reduce eye redness. It could then have argued that the prior art did not disclose a composition in which the brimonidine alone reduced eye redness. The resulting claims would then have covered compositions with multiple active ingredients that acted independently of one another.

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