

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JEISYS MEDICAL INC.,
Petitioner,

v.

SERENDIA, LLC,
Patent Owner.

IPR2024-00384
Patent 9,320,536 B2

Before SHERIDAN K. SNEDDEN, CARL M. DeFRANCO, and
TINA E. HULSE, *Administrative Patent Judges*.

DeFRANCO, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Serendia, LLC (“Serendia”) is the owner of U.S. Patent No. 9,320,536 B2 (Ex. 1001, “the ’536 patent”). Jeisys Medical Inc. (“Jeisys”) and Ilooda Co., Ltd., (“Ilooda”) filed a petition for *inter partes* review of claims 1–9 and 11–19 of the ’536 patent. *See* Paper 4 (“Pet.”). Ilooda subsequently settled its dispute with Serendia, and we dismissed Ilooda as a petitioner. *See* Paper 15.

In due course, Serendia filed a preliminary response, including both public and confidential versions.¹ *See* Papers 12, 14, respectively (“Prelim. Resp.”). With the preliminary response, Serendia submitted a statutory disclaimer of claims 9 and 19 of the ’536 patent. *See* Ex. 2138 (dated Apr. 19, 2024). As such, they are no longer at issue in this proceeding. *See* 37 C.F.R. § 42.107(e).

Per our authorization, Jeisys filed a reply (Paper 15, “Pet. Reply”), and Serendia followed with a sur-reply (Paper 16, “PO Sur-Reply”). Exercising our jurisdiction under 35 U.S.C. § 314(a), we institute *inter partes* review of claims 1–8 and 11–18, which are the challenged claims remaining after Serendia’s statutory disclaimer.

I. BACKGROUND

A. Related Matters

This is Jeisys’s first (and only) petition challenging the ’536 patent. However, another entity, Cartessa Aesthetics, LLC (“Cartessa”), filed an earlier petition in December 2021, which we denied. *See Cartessa Aesthetics, LLC v. Serendia, LLC*, IPR2022-00378, Paper 9 (PTAB June 30, 2022).

¹ Unless otherwise noted, this decision refers to the public version.

The '536 patent is also the subject of a proceeding before the International Trade Commission, filed March 1, 2023, and captioned *Certain Dermatological Treatment Devices and Components Thereof*, No. 337-TA-1356 (“the ITC proceeding”). The respondents in the ITC proceeding include Cartessa, Jeisys, Ilooda, and numerous others. *See* Paper 7; *see also* Prelim. Resp. 5–6.

The '536 patent is also the subject of several federal district court actions, some of which are stayed pending the outcome of the ITC proceeding and some of which have been dismissed—

- *Serendia, LLC v. Cutera, Inc.*, No. 1:23-cv-00222 (D. Del.)
- *Serendia, LLC v. Cynosure, LLC*, No. 1:23-cv-00223 (D. Del.)
- *Serendia, LLC v. EndyMed Medical, Inc.*, No. 1:23-cv-00224 (D. Del.)
- *Serendia, LLC v. Lutronic Aesthetics, Inc.*, No. 1:23-cv-00225 (D. Del.) (dismissed Jan. 22, 2024)
- *Serendia, LLC v. Rohrer Aesthetics, Inc.*, No. 1:23-cv-00226 (D. Del.) (dismissed Oct. 20, 2023)
- SynKloud Technologies, LLC, et al. v. Aesthetics Biomedical, Inc., 2:22-cv-15 (D. Ariz.) (dismissed on Nov. 21, 2023)
- SynKloud Technologies, LLC, et al. v. Sung Hwan E&B Co., LTD., 6:21-cv-811 (W.D. Tex.) (dismissed Nov. 26, 2023)
- *SynKloud Technologies, LLC v. Cartessa Aesthetics, LLC*, No. 2:21-cv-4423 (E.D.N.Y.) (dismissed Nov. 21, 2023)

See Paper 7.

B. The '536 Patent

The '536 patent relates to a system and method “used in treating dermatological tissue.” Ex. 1001, 1:25–27. Figures 2A and 2B of the '536 patent, reproduced below, depict dermatological treatment apparatus 310.

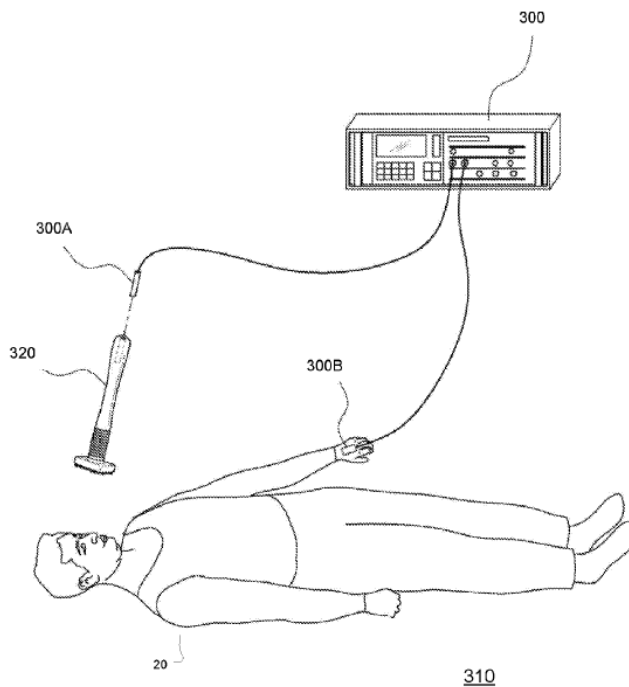


FIGURE 2A

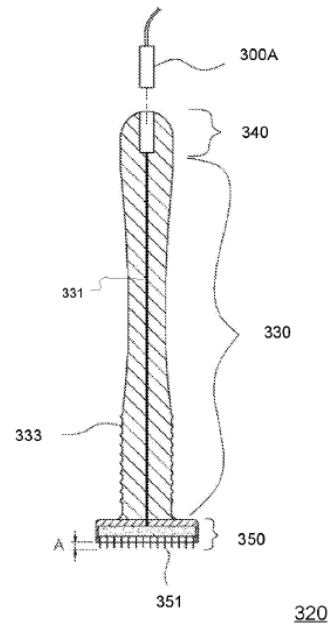


FIGURE 2B

As shown in Figures 2A and 2B, dermatological treatment apparatus 310 includes acupuncture device 320 and signal generator 300 electrically coupled to the device via one or more wires 300A. *Id.* at 3:27–33. Notably, acupuncture device 320 is provided with a plurality of acupuncture needles or pins 351. *Id.* at 3:34–42.

In operation, electrical signal generation system 300 produces electrical signals “to vibrate one or more pins 351 electrically coupled to the system 300 . . . [to] increase the micro-wound or cut formed in dermis by the pin 351.” *Id.* at 3:43–48. Pins 351 may be fixed in place, as depicted in Figure 2B above, or movable between a retracted and deployed position, i.e., extendable, as depicted in Figures 9C and 9D below. *See id.* at 2:20–25, 3:34–41, 10:9–11:6.

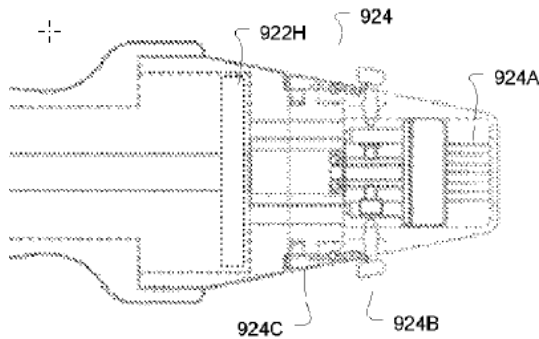


FIGURE 9C

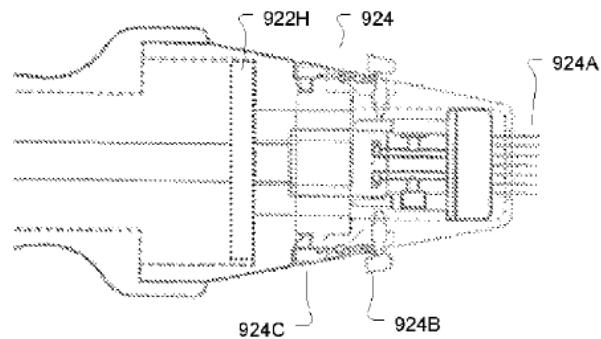


FIGURE 9D

As shown, Figure 9C depicts the dermatological treatment apparatus with the needles retracted and Figure 9D depicts the apparatus with the needles deployed.

C. Challenged Claims

Of the challenged claims, claims 1 and 11 are independent. Claim 1 is directed to a method of treating dermatological tissue, while claim 11 is directed to an apparatus for performing the method. Claim 11 is illustrative and reproduced below:

11. An apparatus for treating dermatological tissue, comprising:

a user holdable device including a proximal end and a releasably couplable deployable needle assembly, the deployable needle assembly mechanically separatably from the proximal end and including a plurality of extendable needles, a plurality of the extendable needles extendable from a deployable needle assembly end surface, one of the proximal end and the deployable needle assembly including at least one electrical conductor and the other including at least one restorably deflectable electrical contact couplable to the one of the proximal end and the deployable needle assembly at least one electrical conductor;

a motor coupled to a plurality of extendable needles that *causes the plurality of extendable needles to extend a desired distance from the needle assembly end surface* when the motor is energized with a particular signal; and

a signal generator electrically coupled to the plurality of extended needles to energize the plurality of extended needles.

Ex. 1001, 16:11–32 (emphasis added).

D. Asserted Challenges of Unpatentability

Claims Challenged ²	35 U.S.C. §	Basis
1–3, 6, 8, 11–13, 16, 18	102	Mehta ³
1–8, 11–18	103	Mehta and POSA ⁴
4, 5, 14, 15	103	Mehta, Na, ⁵ and POSA
7, 17	103	Mehta and Livneh ⁶
1–3, 6, 8, 11–13, 16, 18	103	Mehta and Lee ⁷
1–8, 11–18	103	Mehta, Lee, and POSA
4, 5, 14, 15	103	Mehta, Lee, Na, and POSA
7, 17	103	Mehta, Lee, and Livneh

In further support of these challenges, Jeisys relies on the declaration of Dany Bérubé, Ph.D. *See* Ex. 1003. Serendia submits rebuttal declarations from Peter Crosby (Ex. 2134) and Vincent Thomas (Ex. 2135).

II. DISCRETIONARY DENIAL UNDER *GENERAL PLASTIC*

In its preliminary response, Serendia argues that we should discretionarily deny the petition under the Board’s precedential decisions in

² As mentioned earlier, claims 9 and 19 are no longer at issue in this proceeding due to Serendia’s statutory disclaimer.

³ US 8,608,737 B2, issued Dec. 17, 2013 (Ex. 1004, “Mehta”).

⁴ We understand Jeisys’s use of the term “POSA” here to mean the general knowledge of a person of ordinary skill in the art.

⁵ WO 2010/0168848 A1, published Feb. 11, 2010 (Ex. 1005, “Na”).

⁶ WO 2008/005477 A2, published Jan. 10, 2008 (Ex. 1012, “Livneh”).

⁷ Korean Registered Utility Model No. KR20-0441552, published Aug. 25, 2008 (Ex. 1010 (original), Ex. 1011 (certified translation), “Lee”).

*General Plastic*⁸ and *Valve*⁹ because Jeisys has a “significant relationship” with Cartessa, the earlier petitioner of the ’536 patent and a co-respondent with Jeisys in the related ITC proceeding. *See* Prelim. Resp. 8–13; PO Sur-Reply 1–3. In support, Serendia highlights Cartessa’s and Jeisys’s collaboration in preparing and filing a joint proposed schedule, joint expert report, and joint invalidity defenses in the ITC proceeding, as well Jeisys’s reliance on the same invalidity expert as the one proffered in the ITC proceeding. *See* Prelim. Resp. 10–11 (citing Exs. 2004, 2016–19, 2125). Serendia also contends that “additional relevant and extenuating facts and circumstances” evidence a significant relationship because:

- (1) Cartessa and Jeisys are “part of the same RF micro-needling manufacturing and distribution community”;
- (2) Jeisys had notice of “potential infringement of the ’536 patent” before Cartessa filed the earlier petition; and
- (3) Jeisys engaged in “tactical delay” by having knowledge of the prior art asserted in the current petition more than seven months prior to its filing.

See id. at 11–12 (citing, respectively, Exs. 2020, 2021; Exs. 2022, 2023, 2052; Ex. 2053).

Jeisys disputes the existence of any significant relationship with Cartessa, arguing it “[n]either . . . had control over the Cartessa Aesthetics IPRs, participated or provided input into the Cartessa Aesthetics IPRs, or had knowledge of them prior to their being filed,” but filed the present petition on its own behalf and not on behalf of anyone else. Pet. 77 (citing

⁸ *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential) (“*General Plastic*” or “*GP*”).

⁹ *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential) (“*Valve*”).

Valve). In support, Jeisys cites the Director’s recent decisions in *Ford*¹⁰ and *Videndum*.¹¹ See Pet. Reply 1–4.

At the outset, we note that the Director’s decisions in *Ford* and *Videndum* clarified the Board’s application of the *General Plastic/Valve* framework. For instance, in *Ford*, the Director explained that “[u]nder existing Office policy and precedent, the Board does not recognize a ‘significant relationship’ between parties [i.e., serial petitioners] having different accused products that merely engage in *court-ordered* pretrial coordination.” *Ford*, at 9 (emphasis added). And, in *Videndum*, the Director further explained that where “the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* factor one necessarily outweighs the other *General Plastic* factors.” *Videndum*, at 6–7. Thus, per *Ford* and *Videndum*, we will not discretionarily deny a later petition in view of an earlier petition where the earlier and later petitioners are neither the same party nor have a significant relationship.

After reviewing the record, we find that no significant relationship exists with Cartessa to justify application of the *General Plastic/Valve* framework. Contrary to Serendia’s assertions about the joint submissions by Jeisys and Cartessa in the parallel ITC proceeding (*see* Prelim. Resp. 10–11), the relevant facts and circumstances here are akin to those in *Ford*. More specifically, like the “court-ordered” coordination of the petitioners in *Ford*, the collaboration of Jeisys and Cartessa as co-respondents in the ITC proceeding was *mandated* by the rules of the ITC proceeding, and, thus,

¹⁰ *Ford Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 28 (Vidal Mar. 22, 2024) (“*Ford*”).

¹¹ *Videndum Prod. Sols., Inc v. Rotolight Ltd.*, IPR2023-01218, Paper 12 (Vidal Apr. 19, 2024) (“*Videndum*”).

does not alone create the type of “significant relationship” contemplated by *Valve*. See Pet. Reply 2–3 (citing *Ford*, at 3; Exs. 1028, 1029); see also *Prime Time Toys LLC v. Spin Master, Inc.*, IPR 2023-01339, Paper 12, at 19–20 (Vidal July 9, 2024) (“*Prime Time Toys*”) (“The parties’ collaboration as co-respondents in the ITC investigation does not by itself support a finding of a “significant relationship.”). As such, Jeisys’s knowledge of the prior art asserted in the ITC proceeding and its collaboration with Cartessa on a joint invalidity defense does not create a significant relationship where such knowledge and collaboration arises from the rules of the ITC proceeding itself.

Indeed, after seeing Jeisys’s reply brief, Serendia no longer relies solely on the joint collaboration in the ITC proceeding to demonstrate a significant relationship, and, instead, argues that “[a]dditional extenuating circumstances exist here.” PO Sur-Reply 1–3. But, to the extent Serendia premises the existence of extenuating circumstances on the argument that Cartessa and Jeisys “are part of the same RF microneedling manufacturing and distribution community” (Prelim. Resp. 11), we are not persuaded. At the outset, Serendia does not dispute Jeisys’s assertion that Cartessa and Jeisys are direct competitors selling different products. See PO Sur-Reply 1–2 (acknowledging Jeisys’s assertion without disputing it). Moreover, as was the case with the serial petitioners in *Ford*, there is no evidence here that Cartessa and Jeisys “had any interactions or agreements regarding the implementation of the accused [technology] into their respective accused products” that might rise to the level of “relevant or extenuating facts or circumstances” indicative of a significant relationship. *Ford*, at 10–11; cf. *Valve*, at 10 (“Valve represented that ‘HTC’s [accused] VIVE devices incorporate certain Valve technologies under a technology license from

Valve,’ and that ‘Valve employees did provide HTC with technical assistance during the development of the accused VIVE devices.’”). Thus, in the absence of any proof of a license or other technology sharing agreement between Cartessa and Jeisys, we reject the notion that mere overlap of the technologies used in their respective products somehow creates a significant relationship.

We also reject Serendia’s reliance on *Mitek Sys., Inc. v. United Servs. Auto. Assoc.*, IPR2020-00882, Paper 29 at 17 (PTAB Nov. 6, 2020) (“*Mitek*”), to argue a significant relationship exists because Jeisys was “aware” of the asserted prior art and was “working hand-in-hand” with Cartessa in the ITC proceeding to develop invalidity contentions “seven months” before filing the current petition. *See* Prelim. Resp. 11–12. In *Mitek*, the finding of a significant relationship centered not merely on the fact of the petitioner’s awareness of an earlier petitioner’s invalidity contentions, but more critically on the existence of a “customer-supplier relationship” between the first and second petitioners that was “longstanding and deep,” as evidenced by a confidential exhibit in that case. *See Mitek*, at 17–21 (redacting actual extent of first and second petitioners’ relationship while identifying “ongoing effort” between them “to coordinate [first petitioner’s] defense” against infringement). Thus, we do not consider Jeisys’s simple knowledge of Cartessa’s invalidity contentions in the ITC proceeding as outweighing the lack of any evidence here of an actual joint defense (or similar) agreement between Jeisys and Cartessa.

We have reviewed Serendia’s other arguments but find them unpersuasive. In sum, because Jeisys and Cartessa “are neither the same party, nor possess a significant relationship under *Valve*,” the first factor of *General Plastic* necessarily outweighs the other *General Plastic* factors such

that exercising our discretion to deny the petition is not justified. *Videndum*, at 6–7.

III. ANALYSIS OF ASSERTED CHALLENGES

A. Level of Ordinary Skill in the Art

Jeisys proposes, and Serendia agrees, that one of ordinary skill in the relevant art would have had

(1) 7–10 years of experience with developing and/or using treatment systems for delivery of electromagnetic radiation energy to skin or other tissues, and (2) a related graduate engineering degree or M.D. . . . [and] may have worked as part of a multidisciplinary team and drawn upon not only his or her own skills, but also would have taken advantage of certain specialized skills of others on the team when solving a technical problem.

Pet. 14–15 (citing Ex. 1003 ¶ 50); *see also* Prelim. Resp. 32 (accepting Jeisys’s definition of the level of skill in the art). For purposes of this proceeding, we adopt the parties’ assessment of the level of ordinary skill in the art.

B. Claim Construction

The parties dispute the construction of “desired distance” as recited in claims 1 and 11. *See* Prelim. Resp. 32–38; Pet. Reply 7–8. On the one hand, Jeisys argues that the term “simply distinguishes between needles that extend or are extendable a *desired distance* as opposed to an *undesired distance*.” Pet. 17–18. According to Jeisys, the “desired distance” limitation “can be met by programming the system to extend the needles to a desired distance (as opposed to being an un-programmed, undesired distance), or by using . . . non-adjustable needles of ‘a particular needle length.’” Pet. Reply 7–8. In support, Jeisys notes the parties’ agreed-upon construction in the parallel ITC proceeding that “needles ‘extending’ a desired distance from

the surface covers non-extendable needles having a fixed length.” Pet. 18 (citing Ex. 1007, at 16).

Serendia argues that “[t]he particular distance is ‘desired’ because it is the distance a user decided to ‘select’ to achieve a particular penetration depth,” and, thus, “desired distance” means “how far the needles extend from the device’s end surface, *based on a user’s selection*, to penetrate the dermatological issue.” Prelim. Resp. 33 (emphasis added); *see also id.* at 37 (“the ‘desired distance’ is based on a user’s selection.”). According to Serendia, the specification of the ’536 patent supports such a construction by describing a particular embodiment in which “needle deployment motor controller (NDMC) module 911B” controls deployment of needles 924A “based on one or more user selected operational parameters” such as “the depth” of the needles. *Id.* at 34–35 (citing Ex. 1001, 10:9–13, 13:51–57). Serendia also argues that Jeisys’s contention regarding the parties’ agreed-upon construction in the ITC proceeding “is inapplicable since needles ‘extending’ is not in the claims of the ’536 patent,” and, thus, “by their plain language exclude ‘fixed, non-extendable needles.’” *Id.* at 37.

We need not formally construe the “desired distance” limitation in order to resolve whether institution is appropriate. That is because, on the current record, the asserted prior art satisfies the “desired distance” limitation regardless of which parties’ proposed construction we adopt. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Nonetheless, the parties are free to further explore the appropriate construction of “desired distance” at trial, in particular, whether the plain

language of the claims limits their scope to “extendable” needles, and whether construing the “desired distance” limitation as being based on a user’s selection improperly reads a preferred embodiment into the claims.

C. Anticipation by Mehta

Jeisys challenges claims 1–3, 6, 8, 11–13, 16, and 18 as being anticipated by Mehta. *See* Pet. 19–46. We begin with Jeisys’s showing for independent claim 11, which includes a detailed mapping of how Mehta satisfies each of the claim elements along with supporting testimony from Jeisys’s declarant. *See id.* at 19–36 (citing Ex. 1003 ¶¶ 78–108).

Serendia responds that Jeisys fails to show Mehta discloses the claimed “desired distance” limitation, which Serendia construes to mean “how far the needles extend from the device’s end surface, *based on a user’s selection*, to penetrate dermatological issue.” Prelim. Resp. 44 (emphasis added). According to Serendia,

In Mehta, the user does not select how far the needles extend to penetrate dermatological tissue. . . . Mehta instead discloses selecting cartridges having different probe *lengths* or *angles*, not selecting *how far* the probes in a given cartridge extend when used in Mehta’s [sic] system. . . . Mehta’s system is designed for full insertion of the needles by their entire lengths—i.e., they extend a *fixed distance*. . . . Thus, in Mehta, the distance that the needles extend when using a particular cartridge is not selected by the user but rather is determined by the needles’ “fixed length.”

Id. at 44–45.

We disagree with Serendia’s analysis of Mehta. As Jeisys correctly explains, Mehta discloses the “desired distance” limitation even assuming Serendia’s construction of that limitation, i.e., that the needles are extendable to a depth *selected by the user*. *See* Pet. 33. Indeed, although Mehta may not use the term “desired distance” expressly, it comes about as

close as one would expect from an anticipatory disclosure. For example, as Jeisys notes, Mehta discloses an embodiment that includes “depth markings” on the needles (i.e., probes) that allow the user to determine a desired depth of the needles—

The electrodes of the probe array can also include any number of visually distinguishing features (e.g., *depth markings*, colors, shades, etc.) that enable a physician to observe proper placement. . . . This ensures that the probe is not driven too far into tissue. Alternatively, *the probe can be marked with one or more features that allow the physician to determine the depth of insertion of the probe.*

Id. (citing Ex. 1004, 13:37–45 (emphases added)).

Notably, as Jeisys also explains, Mehta discloses another embodiment, depicted in Figures 10A–F, having a graphical user interface 320 (“GUI”) that displays the actual and target depths of needles so as to avoid placement of the needles in an undesired region. *See id.* at 32–34 (citing Ex. 1004, 10:38–39, 12:5–8, 32:63–33:43; Ex. 1003 ¶¶ 101–104). The GUI, as described, “can provide information for a physician (or other medical staff) to monitor various treatment parameters as well as other information regarding the placement of the array 108 or probes 104 when inserted in the tissue” and “maintain visual contact with the treatment device and tissue being treated.” Ex. 1004, 11:1–13. To do so, the GUI incorporates a “tissue characteristic indicator (whether visual, virtual, audible, or other feedback)” that allows the user to monitor the needle’s actual location in the tissue and advance the needle a desired distance for providing treatment—

FIG. 10B illustrates a tissue characteristic indicator showing a virtual depiction 350 of the depth or location of the probe array. . . . [T]he virtual depth/location depiction 350 can illustrate an actual placement of the probe array 340. . . . [T]he

system can be configured to show (or the system can have an option to show) additional probe array information. For example, *the virtual depth/location depiction 350 can also show a desired probe location (e.g., array 342 can represent the desired depth of placement for providing a treatment).* . . . As shown by FIG. 10B, providing the virtual depth/location depiction 350 allows the physician to not only identify whether the array is located within the desired tissue layer but also allows the physician to observe the angle of the electrode array in tissue. . . . *Therefore, the physician would be informed that further advancement of the probes is necessary to place the probes within the second layer 326 (which corresponds to the dermal layer).*

Id. at 32:46–33:29 (emphases added); *see also id.* at 33:57–66 (further describing “virtual depth/location depiction 350”).

Similarly, Mehta discloses that the needle may employ a sensor to assist the user in positioning the needle to the desired depth—

Referring to Fig. 8A, showing a partial section of a probe 108 placed in tissue 20. . . . The probe 8 contains a sensor 110 near a distal end or on an active area 122 of the probe 108. . . .

Measurement of a tissue parameter by *the sensor 110 provides information that can confirm whether the probe 108 is located in the desired target region.* For example, . . . if the measured impedance is not within a range normally associated with tissue, *the system can prevent treatment and alert the user for the need to reposition the probe 108.* Accordingly, the probe 108 can ultimately be repositioned as shown in FIG. 8B (or the active area 122 of the probe 108 can be repositioned).

Id. at 24:27–45, Figs. 8A–C (emphases added).¹²

Those disclosures by Mehta, either alone or together, would have been understood by one skilled in the art as providing the user with the means to

¹² Mehta also teaches that the user can select a “desired location” by choosing the needle’s insertion “angle A.” Ex. 1004, 12:31–46, Figs. 2B, 7A, 7B.

select and control the desired depth of the needles into the tissue. *See* Ex. 1003 ¶¶ 101–105. To the extent Serendia believes otherwise, it fails to read Mehta as a whole. Instead, Serendia focuses on Mehta’s so-called “cartridge” embodiment having needles of a “fixed length” (*see* Prelim. Resp. 44–46, 50) to the exclusion of Mehta’s clear and unambiguous teachings of other means for selecting and controlling how far the needles are inserted into the tissue. As discussed above, those means range from the simple—such as depth markings on the needles to assist the user in determining how far to insert them into the tissue—to the more sophisticated—such as a GUI to display and control the needle’s insertion into the tissue. In either case, the user selectively actuates a motor to cause insertion of the needles to the desired depth. *See, e.g.*, Ex. 1004, 10:33–39, 12:5–14, 13:54–14:4, 15:36–42, Figs. 3A, 3B; Ex. 1003 ¶¶ 101–104. Thus, based on the current record, we find that Mehta discloses the “desired distance” limitation of claim 11, even under Serendia’s narrower interpretation of that limitation, and otherwise meets the “motor” limitation for causing the needles to extend the desired distance.

Serendia does not dispute Jeisys’s showing of how Mehta discloses the other limitations of claim 11. *See* Prelim. Resp. 44–49, PO Sur-Reply 8–9. Having reviewed the record, we find that Jeisys sufficiently shows that Mehta discloses each of those other claim limitations. *See* Pet. 19–30, 35–36. Thus, at this stage, Jeisys demonstrates a reasonable likelihood that at least independent claim 11 is anticipated by Mehta.

Serendia offers no response to Jeisys’s challenge of claims 2, 3, 6, 8, 11–13, 16, and 18, except presumably to rely on its arguments against Jeisys’s challenge of claim 11. *See* Prelim. Resp. 44–49. Because Jeisys’s anticipation challenge satisfies the threshold for institution with respect to at

least claim 11, we do not address the other claims of this challenge in the absence of any express rebuttal or concession from Serendia. Further analysis is best left for trial after full development of the record.

D. Obviousness Challenges

Jeisys also challenges the claims of the '536 patent as obvious over various combinations of references, all of which rely on Mehta as the base reference and Na, Lee, and/or Livneh as teaching references. *See* Pet. 46–74. Serendia disputes Jeisys's rationale for why one skilled in the art would have been led to modify Mehta's device to include the teachings of Na, Livneh, and/or Lee. *See* Prelim. Resp. 49–58. In doing so, Serendia also presents evidence of secondary considerations, such as commercial success and industry praise of its "Sylfirm X" product, in an effort to prove non-obviousness of the claimed invention. *Id.* at 58–63.

At this preliminary stage, we are not so sure Serendia demonstrates a nexus between the claimed invention and the success it attributes to the Sylfirm X product. Notably, Serendia acknowledges that the success of the Sylfirm X product is due only "in part" to the technology claimed in the '536 patent. Prelim. Resp. 62. Indeed, in another proceeding, Serendia contends that commercial success of the Sylfirm X product is due to the so-called "Na effect," which is not claimed in the '536 patent but instead goes to the heart of another one of Serendia's patents. *See* Pet. Reply 8 (citing IPR2024-00386, Paper 13, at 61–63). "A patent claim is not coextensive with a product that includes a 'critical' unclaimed feature that is claimed by a different patent and that materially impacts the product's functionality." *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1375 (Fed. Cir. 2019).

Here, Serendia fails to explain the criticality of the unclaimed "Na effect" to the functionality of the Sylfirm X product. *See* PO Sur-Reply 9–

10. Nor does Serendia explain sufficiently how its evidence of commercial success is the “direct result of the unique characteristics of the claimed invention,” as opposed to those of the claimed invention at the heart of Serendia’s other patent. *See Fox Factory*, 944 F.3d at 1373–74. Thus, without more from Serendia, we think analysis of this issue is best left for trial after full development of the record. And, because Jeisys’s anticipation challenge satisfies the threshold for institution, we do not see the need to further address Jeisys’s obviousness challenges in the absence of affording Serendia an opportunity to address the shortcomings with its evidence of secondary considerations.

IV. CONCLUSION

For the above reasons, we determine that Jeisys demonstrates a reasonable likelihood of proving that at least independent claim 11 is unpatentable as anticipated by Mehta. And because “[e]qual treatment of claims and grounds for institution purposes has pervasive support in *SAS*,” we institute on all the claims as challenged in the petition. *See* 37 C.F.R. § 42.108(a), (c); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (citing *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018)).

V. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review of claims 1–8 and 11–18 of the ’536 patent is *instituted*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of trial, which will commence on the entry date of this Decision.

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