

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JEISYS MEDICAL INC.,
Petitioner,

v.

SERENDIA, LLC,
Patent Owner.

Case No. IPR2024-00386
U.S. Patent No. 9,480,836

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 9,480,836 (the “’836 patent”)
1002	File History for U.S. Patent No. 9,480,836
1003	Declaration of Dany Bérubé, Ph.D.
1004	<i>Curriculum Vitae</i> of Dany Bérubé, Ph.D.
1005	U.S. Patent Application Publication No. 2007/0208340 (“Ganz”)
1006	International Publication Number WO 2008/005477 (“Livneh”)
1007	International Publication Number WO 2007/064718 (“Hantash”)
1008	Korean Patent No. 20-0441552 (“Lee”) (translation)
1009	Korean Patent No. 20-0441552 (“Lee”) (original Korean)
1010	Macrene Alexiades-Armenakas et al., <i>Prospective Multicenter Clinical Trial of a Minimally Invasive Temperature-Controlled Bipolar Fractional Radiofrequency System for Rhytids and Laxity Treatment</i> , Dermatol. Surg. 1 (2012)
1011	Barry D. Sudbeck et al., <i>Collagen-stimulated Induction of Keratinocyte Collagenase Is Mediated via Tyrosine Kinase and Protein Kinase C Activities</i> , 269, 47 J. Biol. Chem. 30022 (1994)
1012	Sayaka Kanai et al., <i>Peptide Precursors that Acquire Denatured Collagen- hybridizing Ability by O-to-N acyl Migration at Physiological pH</i> , 18 Org. Biomol. Chem. 2823 (2020)
1013	Kristin M. Kirsch et al., <i>Ultrastructure of Collagen Thermally Denatured by Microsecond Domain Pulsed Carbon Dioxide Laser</i> , 134 Arch. Dermatol 1255 (Oct. 1998)
1014	U.S. Publication No. 2005/0222565 (“Manstein”)

Exhibit	Description
1015	Melissa A. Bogle, <i>Radiofrequency Energy and Hybrid Devices</i> , in NON-SURGICAL SKIN TIGHTENING AND LIFTING 21 (Murad Alam & Jeffrey S. Dover eds., 2009) (“Bogle”)
1016	THE IEEE STANDARD DICTIONARY OF ELECTRICAL AND ELECTRONICS TERMS (6th ed. 1997)
1017	THE ILLUSTRATED DICTIONARY OF ELECTRONICS (8th ed. 2001)
1018	BASIC ELECTRONICS THEORY (1981)
1019	R. James Koch & Brian P. Kim, <i>Radiofrequency Tissue Tightening</i> , in Non-Invasive Cosmetic Procedures 63 (2011)
1020	Heather Woolery-Lloyd & Jenna N. Kammer, <i>Skin Tightening</i> , in BASICS IN DERMATOLOGICAL LASER APPLICATIONS 147 (Inja Bogdan Allemann & David J. Goldberg eds., 2011)
1021	Antois S. Manolis et al., <i>Radiofrequency Catheter Ablation for Cardiac Tachyarrhythmias</i> , 121 Ann Intern Med. 452 (1994)
1022	David E. Haines, <i>Biophysics of Radiofrequency Lesion Formation</i> , in CATHETER ABLATION OF CARDIAC ARRHYTHMIAS 2 (Shoei K. Stephen Huang & Mark A. Wood eds., 2010)
1023	Seong Kuk Yoon, <i>Radiofrequency Ablation of Renal Cell Carcinoma: A Systematic Review</i> , in ADVANCED LAPAROSCOPY 127 (Ali Shamsa ed., 2011)
1024	Diane Irvine Duncan & Michael Kreindel, <i>Basic Radiofrequency: Physics and Safety and Application to Aesthetic Medicine</i> , in RADIOFREQUENCY IN COSMETIC DERMATOLOGY 1 (Moshe Lapidoth & Shlomit Halachmi eds., 2015)
1025	Korean Published Patent App. No. 10-2011-0074842 (translation)
1026	Korean Published Patent App. No. 10-2011-0074842 (original Korean)
1027	U.S. Patent Application Publication No. 2006/0047281 (“Kreindel”)

Petitioner's Reply to Patent Owner's Preliminary Response
U.S. Patent No. 9,480,836 | IPR2024-00386

Exhibit	Description
1028	Order No. 35: Construing Certain Terms of the Asserted Claims, Inv. No. 337-TA-1356.
1029	U.S. Patent Application Publication No. 2010/0262135
1030	International Standard, IEC 60601-2-2, Medical electrical equipment – Part 2-2: Particular requirements for the basic safety and essential performance of high frequency surgical equipment and high frequency surgical accessories
1031	George Hruza et al., <i>Skin Rejuvenation and Wrinkle Reduction Using a Fractional Radiofrequency System</i> , Vol. 8 Issue 3 Journal of Drugs in Dermatology 259 (2009)
1032	Docket Report - Serendia, LLC v. Cutera, Inc, 1:23-cv-00222-RGA (D. Del.)
1033	Docket Report - Serendia, LLC v. Cynosure, LLC, 1:23-cv-00223-RGA (D. Del.)
1034	Birefringence Definition, https://www.merriam-webster.com/dictionary/birefringence
1035	Declaration of R. James Koch, M.D.
1036	Curriculum Vitae of R. James Koch, M.D.
1037	Substitute Declaration of Jean Woloszko, Ph.D.
1038	Serendia-Ilooda Settlement Agreement
1039	Excerpt from November 7, 2023 Evidentiary Hearing Transcript from related ITC proceeding
1040	Order No. 3 (Proposed Scheduling Order) from related ITC proceeding
1041	Order No. 2 (Ground Rules) from related ITC proceeding
1042	Goldberg, David, et al., “Prospective Multicenter Clinical Trial of a Minimally Invasive Temperature-Controlled Bipolar Fractional

Petitioner's Reply to Patent Owner's Preliminary Response
U.S. Patent No. 9,480,836 | IPR2024-00386

Exhibit	Description
	Radiofrequency System for Rhytid and Laxity Treatment,” <i>Dermatol. Surg.</i> 2012; 1-11, DOI: 10.1111/dsu.120165 (2012)

CONTENTS

I.	THE <i>GENERAL PLASTIC</i> FACTORS SUPPORT INSTITUTION.....	1
A.	Factor 1	1
B.	Factors 2 through 5	4
C.	Factors 6 and 7	6
D.	Patent Owner’s Factor 8	6
II.	PATENT OWNER’S SECONDARY CONSIDERATIONS DO NOT OVERCOME THE COMPELLING CASE OF OBVIOUSNESS	7

TABLE OF AUTHORITIES

Cases

<i>Fujitsu Ltd. v. Netgear Inc.</i> , 620 F.3d 1321 (Fed. Cir. 2010)	9
<i>Ohio Willow Wood Co. v. Alps S., LLC</i> , 735 F.3d 1333 (Fed. Cir. 2013)	7
<i>Ormco Corp. v. Align Technology, Inc.</i> , 463 F.3d 1299 (Fed. Cir. 2006)	8
<i>Rambus Inc. v. Rea</i> , 731 F.3d 1248 (Fed. Cir. 2013)	9
<i>Tandon Corp. v. U.S.I.T.C.</i> , 831 F.2d 1017 (Fed. Cir. 1987)	6

Board Decisions

<i>Coalition for Affordable Drugs V LLC v. Hoffman-LaRoche Inc.</i> , IPR2015-01792, Paper 14 (PTAB Mar. 11, 2016)	10
<i>Code200, UAB v. Bright Data Ltd.</i> , IPR2022-00861, 2022 WL 3646167 (PTAB Aug. 23, 2022)	6
<i>Ford Motor Co. v. Neo Wireless LLC</i> , IPR2023-00763, Paper 28 (PTAB Mar. 22, 2024) (Vidal, K.)	1, 2
<i>Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)	1, 4
<i>Illumina, Inc., v. Ravgen, Inc.</i> , IPR2021-01271, Paper 12 (PTAB Jan. 26, 2022)	2
<i>Medtronic, Inc. v. Nuvasive, Inc.</i> , IPR2014-00074, Paper 15 (PTAB April 8, 2014)	10
<i>Merial Ltd. v. Virbac</i> , IPR2014-01279, Paper 13 (PTAB Jan. 22, 2015)	10
<i>Micron Tech., Inc. v. Netlist, Inc.</i> , IPR2022-00418, Paper 14 (PTAB Sept. 1, 2022)	5
<i>Micron Technology, Inc. v. Sonrai Memory Limited</i> , IPR2023-00909, Paper 7 (PTAB Nov. 28, 2023)	6

Petitioner’s Reply to Patent Owner’s Preliminary Response
U.S. Patent No. 9,480,836 | IPR2024-00386

<i>Mitek Sys., Inc. v. United Servs. Auto. Assoc.,</i> IPR2020-00882, Paper 29 (PTAB Nov. 6, 2020)	3
<i>Nearmap US, Inc. v. Eagle view Techs., Inc.,</i> IPR2022-01090, Paper 9 (PTAB Jan 12, 2023)	5
<i>Omron Oilfield & Marine, Inc. v. MD/TOTCO,</i> IPR2013-00265, Paper 11 (PTAB Oct. 31, 2013).....	10
<i>Qualcomm Inc. v. Monterey Rsch., LLC,</i> IPR2020-01492, Paper 9 (PTAB Mar. 8, 2021).....	1
<i>Samsung Elecs. Am., Inc. v. Uniloc Luxembourg S.A.,</i> IPR2017-01797, Paper 8 (PTAB Feb. 6, 2018)	6
<i>Samsung Elecs. Co. Ltd. v. BitMicro, LLC,</i> IPR2018-01720, Paper 14 (PTAB Mar. 29, 2019).....	4
<i>Samsung Elecs. Co. v. Iron Oak Techs., LLC,</i> IPR2018-01554, Paper 9 (PTAB Feb. 13, 2019)	6
<i>Samsung Elecs. Co., Ltd. v. MemoryWeb, LLC,</i> IPR2022-00222, Paper 12 (PTAB June 13, 2022)	5
<i>Semiconductor Component Industries v. Power Integrations, Inc.,</i> IPR2016-01588, Paper 15 (PTAB Feb. 17, 2017)	10
<i>Shanghai Lunion Info. Techs., Ltd., v. Telefonaktiebolaget LM Ericsson,</i> IPR2018-00995, Paper 12 (PTAB Nov. 13, 2018)	4
<i>Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.,</i> IPR2018-00761, Paper 15 (PTAB Sept. 5, 2018)	5
<i>Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.,</i> IPR2018-00897, Paper 9 (PTAB Oct. 1, 2018).....	7
<i>Toshiba Am. Info. Sys., Inc. v. Wallelex Microelectronics Ltd.,</i> IPR2018-01538, Paper 11 (PTAB Mar. 5, 2019).....	4
<i>Twitter, Inc., v. Palo Alto Rsch. Ctr.,</i> IPR2021-01458, Paper 11 (PTAB Apr. 6, 2022)	2
<i>Unified Patents, LLC, v. Torchlight Tech LLC,</i> IPR2022-01500, Paper 15 (PTAB May 4, 2023)	3
<i>Valve Corp. v. Elec. Scripting Prods., Inc.,</i> IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential).....	1, 2, 3, 4

Petitioner’s Reply to Patent Owner’s Preliminary Response
U.S. Patent No. 9,480,836 | IPR2024-00386

Videndum Prod. Sols., Inc. v. Rotolight Ltd.,
IPR2023-01218, Paper 12 (PTAB Apr. 19, 2024) (Vidal, K.).....4

I. THE *GENERAL PLASTIC* FACTORS SUPPORT INSTITUTION

A. Factor 1

Petitioner and prior petitioner Cartessa are competitors who sell different products. If different petitioners challenge the same patent, the Board will apply the *General Plastic* analysis to the second petition if the petitioners have “a significant relationship...with respect to [the challenged patent].” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, at 2, 9 (PTAB Apr. 2, 2019) (precedential) (citing *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)). Patent Owner relies on Petitioner and Cartessa having been two of 14 co-respondents in a parallel ITC investigation involving the '836 patent. But this ignores Patent Owner first filed a district court complaint against Cartessa in August 2021, which prompted Cartessa's petition, and then waited until March 2023 to file the ITC complaint against Petitioner. There is no “significant relationship” between them. *See, e.g., Ford Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 28, at 3 (PTAB Mar. 22, 2024) (Vidal, K.) (“Under existing Office policy and precedent, the Board does not recognize a ‘significant relationship’ between parties having different accused products that merely engage in court-ordered pretrial coordination.”); *see also, e.g., Qualcomm Inc. v. Monterey Rsch., LLC*, IPR2020-01492, Paper 9, at 16 (PTAB Mar. 8, 2021) (participation in joint-defense group); *Twitter, Inc., v. Palo Alto*

Rsch. Ctr., IPR2021-01458, Paper 11, at 31-33 (PTAB Apr. 6, 2022) (different petitioners who coordinated invalidity positions in district court litigation).

Patent Owner contends that a “significant relationship” is evidenced by joint submission in the ITC of a proposed procedural schedule and an invalidity expert report.¹ *See* POPR at 9. The ITC required joint submissions,² which does not create a “significant relationship.” *See Ford*, IPR2023-00763, Paper 28 at 3. Because Jeisys and Cartessa had no “interactions or agreements regarding implementation of the accused [technology]...into their respective accused products,” the “other relevant or extenuating facts or circumstances” identified in *Ford* are also absent here. *Id.* at 10-11.

The Board has declined to extend *Valve* to relationships between different petitioners accused of infringement based on different products. *See, e.g., Illumina, Inc., v. Ravgen, Inc.*, IPR2021-01271, Paper 12, at 16-17 (PTAB Jan. 26, 2022) (noting “the ‘significant relationship’ in *Valve* turned in large part on the fact that co-defendants and serial petitioners in that case...were each accused of

¹ Patent Owner wrongly argues that Jeisys and Cartessa “presented a joint validity defense at the evidentiary hearing.” POPR at 9. Cartessa had settled by November 7, 2023, and did not thereafter participate in Respondents’ invalidity presentation at the ITC evidentiary hearing or the post-hearing briefing. *See* Ex. 1039 at 820:13-20; Ex. 2012.

² *See, e.g.,* Ex. 1040 (joint submission of a procedural schedule); Ex. 1041 at G.R. 2 (coordinated and consolidated motion practice), G.R. 3.1 (coordinated discovery).

infringement based on the same device.”); *Unified Patents, LLC, v. Torchlight Tech LLC*, IPR2022-01500, Paper 15, at 18 (PTAB May 4, 2023) (“Patent Owner does not contend that Mercedes-Benz and Volkswagen are accused of infringement based on the same products. Thus, *Valve* does not apply.”). Patent Owner’s reliance on *Mitek Systems* is therefore misplaced. There, the Board found that different petitioners had a “significant relationship” because the accused activities were based on the *same product*. See *Mitek Sys., Inc. v. United Servs. Auto. Assoc.*, IPR2020-00882, Paper 29, at 19-20 (PTAB Nov. 6, 2020) (finding a “significant and meaningful relationship” between different petitioners due to (i) a “customer-supplier relationship” between petitioners and (ii) the second petitioner’s “admission that it was ‘closely monitoring’ the [prior] district court case” between patent owner and first petitioner “because of the potential impact on own products.”). Here, by contrast, Petitioner is a competitor of Cartessa, and Patent Owner’s prior suit against Cartessa involved products different from those made by Petitioner.

The relationship between Petitioner and Cartessa is also not “significant” because there was no coordination in any proceeding capable of patent invalidation. “[T]he ITC does not have the authority to invalidate a patent, and thus ITC decisions do not preempt issues addressed in an inter partes review

proceeding.” *Samsung Elecs. Co. Ltd. v. BitMicro, LLC*, IPR2018-01720, Paper 14, at 27 (PTAB Mar. 29, 2019).

B. Factors 2 through 5

The remaining *General Plastic* factors are “necessarily outweigh[ed]” when the second petitioner has no “significant relationship” with the prior petitioner.

Videndum Prod. Sols., Inc. v. Rotolight Ltd., IPR2023-01218, Paper 12, at 6 (PTAB Apr. 19, 2024) (Vidal, K.) (“[W]here, as here, 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.”) (emphasis added); *see also Toshiba Am. Info. Sys., Inc. v. Wallex Microelectronics Ltd.*, IPR2018-01538, Paper 11, at 21 (PTAB Mar. 5, 2019). *Videndum* is controlling here.

Patent Owner's pre-*Videndum* authority would invite the Board to “improperly expand[] the discretionary principles set forth in *General Plastic* and *Valve*.” *Videndum*, IPR2023-01218, Paper 12, at 6. For example, *Shanghai Lunion* and *Shenzhen Silver Star* (decided prior to the Board's precedential opinion in *Valve*) denied institution despite finding that factor 1 favored institution. *Shanghai Lunion Info. Techs., Ltd., v. Telefonaktiebolaget LM Ericsson*, IPR2018-00995, Paper 12 at 17, 23-24 (PTAB Nov. 13, 2018); *Shenzhen Silver Star Intelligent*

Tech. Co., Ltd. v. iRobot Corp., IPR2018-00761, Paper 15, at 9-10, 14-15 (PTAB Sept. 5, 2018).

Factors 2 through 5 do not support denial of institution in any event. While the petition presents invalidity grounds that differ from those set forth in the *Cartessa* IPR, “[t]hat Petitioner apparently may have reviewed and considered strategies undertaken by prior petitioners on similar issues does not, in and of itself, constitute unfairness to Patent Owner or create a relationship with any of the prior petitioners.” *Micron Tech., Inc. v. Netlist, Inc.*, IPR2022-00418, Paper 14, at 11 (PTAB Sept. 1, 2022) (instituting trial where “Petitioner did not file the Petition until over three years after the prior IPRs concluded, and only after being sued for infringement of the ’833 patent by Patent Owner”). Petitioner “is not related to [the prior petitioner]” and the Petition “relies upon a different combination of prior art references than the prior petitions,” and thus factors related to roadmapping or timing of the Petition carry little, if any weight. *Samsung Elecs. Co., Ltd. v. MemoryWeb, LLC*, IPR2022-00222, Paper 12, at 11 (PTAB June 13, 2022); *see also Videndum*, IPR2023-01218, Paper 12, at 6.

Patent Owner's own litigation strategy resulted in the number and timing of petitions filed against the patent at issue. The Board should institute trial in these circumstances. *See, e.g., Nearmap US, Inc. v. Eagle view Techs., Inc.*, IPR2022-01090, Paper 9, at 9 (PTAB Jan 12, 2023) (“[I]t is reasonable that Petitioner filed

its own Petition after the three previous petitions filed by unrelated parties given that ‘the present litigation dispute between Petitioner and Patent Owner did not begin until ... well after the last of the three prior IPR petitions was filed’’); *Samsung Elecs. Co. v. Iron Oak Techs., LLC*, IPR2018-01554, Paper 9, at 30 (PTAB Feb. 13, 2019); *Samsung Elecs. Am., Inc. v. Uniloc Luxembourg S.A.*, IPR2017-01797, Paper 8, at 33–34 (PTAB Feb. 6, 2018).

C. Factors 6 and 7

Factors 6 and 7 favor institution. This Petition presents compelling evidence of unpatentability and furthers “the Board’s mission to improve patent quality.” *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, 2022 WL 3646167, at *3 (PTAB Aug. 23, 2022). The Petition is the only IPR challenging the ’836 patent now before the Board. It provides an efficient means for resolving patentability. *See Micron Technology, Inc. v. Sonrai Memory Limited*, IPR2023-00909, Paper 7, at 9 (PTAB Nov. 28, 2023). The Board should review the validity of the ’836 patent independently of the ITC because the ITC lacks authority to invalidate a patent, and its invalidity rulings are not binding on the PTAB. *See Tandon Corp. v. U.S.I.T.C.*, 831 F.2d 1017, 1019 (Fed. Cir. 1987).

D. Patent Owner’s Factor 8

Petitioner and Cartessa were not similarly-situated defendants facing the same-in-time hazard and did not arise from “the same litigation threat at the same

time.” Patent Owner’s reliance on *Shenzhen II* (POPR at 28–29) is therefore misplaced. Cartessa’s petition followed Patent Owner’s district court litigation against it, while the instant Petition follows Patent Owner’s ITC complaint against Petitioner almost two years later.

II. PATENT OWNER’S SECONDARY CONSIDERATIONS DO NOT OVERCOME THE COMPELLING CASE OF OBVIOUSNESS

Evidence of secondary considerations does not overcome a compelling case of obviousness. For example, “where a claimed invention represents no more than the predictable use of prior art elements according to established functions,” as is the case here, “evidence of secondary indicia are frequently deemed inadequate to establish non-obviousness.” *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1344 (Fed. Cir. 2013).

Patent Owner also did not demonstrate a nexus between its claims and its evidence of commercial success and industry praise. Patent Owner submits that “products utilizing the inventions have achieved commercial success, *at least partially*, from incorporating the ’836 Patent’s technology.” POPR at 61-62 (emphasis added). Patent Owner elsewhere argues that the same commercial success is due to “‘the desired distance’ as claimed” by U.S. Patent No. 9,775,774. *See Ilooda v. Serendia*, IPR2024-00383, Paper 13, at 62. Because the “desired distance” is not claimed by the ’836 patent, Patent Owner’s evidence of

commercial success of the SylfirmX does not support patentability of the '836 patent. *See Ormco Corp. v. Align Technology, Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006) (“if the commercial success is due to an unclaimed feature of the device, the commercial success is irrelevant”).

Notably, while Patent Owner submits that Sylfirm X's marketing materials...link “significant benefits” to “maximizing the thermal effect on the target with little to no epidermal damage” (POPR at 63), it fails to demonstrate that absence of “epidermal damage” is a consequence of implementing the technology claimed in the '836 patent. In fact, Patent Owner has submitted that the absence of epidermal damage is the consequence of a feature not claimed by the '836 patent. *See* IPR2024-00383, Paper 13, at 61-62 (noting that “needle extension depth control,” which is “one of the main features of the '774 Patent,” enables treatment “without any thermal damage to the skin surface.”).

The so-called “Na Effect” also cannot provide a nexus, as Patent Owner argues. *See* POPR at 61-64. As explained in the Petition, the “Na Effect” was known in the prior art. Paper 1, Petition (“Pet.”) at 10-11, 25-30; *see also, e.g.*, Ex. 1003 at ¶¶54-65, ¶¶103-112; Ex. 1035 at ¶¶28-34. Specifically, Ganz (Ex. 1005) discloses the creation of “zone[s] of coagulative tissue” around electrodes inserted into skin tissue that are separated (i.e., without coagulative tissue “between the electrodes”). Pet. at 10-11, 25-30; *see also, e.g.*, Ex. 1003 ¶¶54-65, ¶¶103-112; Ex.

1035 ¶¶ 28-34; Ex. 1005 at [0010], [0028], [0030], [0048], [0051], [0053]. By attributing its evidence to a feature known in the prior art, Patent Owner tacitly acknowledges the requisite nexus is absent. *See Rambus Inc. v. Rea*, 731 F.3d 1248, 1257 (Fed. Cir. 2013).

Moreover, Patent Owner has failed to demonstrate that the Sylfirm X practices the claims, which require “[a] skin treatment apparatus...configured to cause coagulation around each electrode rather than coagulating between the electrodes.” Ex. 1001, cl. 1. However, none of the materials identified by Patent Owner (*see* POPR at 62) demonstrate that the Sylfirm X accomplishes this result, or that a clinician would ever configure it to do so. Indeed, a publication authored by Patent Owner's expert Dr. Goldberg, a practicing dermatologist, concludes that “partially denatured collagen is more effective at inducing neocollagenesis” than is “fully denatured collagen” (i.e., coagulation). Ex. 1042 at 8-9. Even if the Sylfirm X is capable of accomplishing the claimed coagulation result, that does not demonstrate that the Sylfirm X is ever “configured” to do so. *See, e.g., Fujitsu Ltd. v. Netgear Inc.*, 620 F.3d 1321, 1329 (Fed. Cir. 2010) (showing infringement requires more than “to simply show that a product is capable of infringement; the patent owner must show evidence of specific instances of direct infringement”).

Where the evidence does not plainly establish which features of the challenged claims are responsible for the objective indicia of non-obviousness,

institution should be granted. *See, e.g., Medtronic, Inc. v. Nuvasive, Inc.*, IPR2014-00074, Paper 15, at 21 (PTAB April 8, 2014). Patent Owner's reliance on *Semiconductor Component Industries, Coalition for Affordable Drugs, Merial*, and *Omron*, is also misplaced. The evidence relied on there had previously been used to determine patentability. *See Semiconductor Component Industries v. Power Integrations, Inc.*, IPR2016-01588, Paper 15, at 28-29 (PTAB Feb. 17, 2017); *Coalition for Affordable Drugs V LLC v. Hoffman-LaRoche Inc.*, IPR2015-01792, Paper 14, at 17-18 (PTAB Mar. 11, 2016); *Merial Ltd. v. Virbac*, IPR2014-01279, Paper 13, at 26-27 (PTAB Jan. 22, 2015); *Omron Oilfield & Marine, Inc. v. MD/TOTCO*, IPR2013-00265, Paper 11, at 12-13 (PTAB Oct. 31, 2013). At minimum, Patent Owner's evidence should be considered by a tribunal with the specialized expertise and authority to issue binding rulings on patentability after the record has been fully developed.

Respectfully submitted,

Date: May 9, 2024

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Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of this Petitioner's Reply to Patent Owner's Preliminary Response was served via electronic email on Patent Owner's counsel of record listed below, pursuant to its January 26, 2024 Mandatory Notices, on Thursday, May 9, 2024:

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