

Filed on behalf of: Serendia, LLC

Entered: June 14, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JEISYS MEDICAL INC.,
Petitioner,

v.

SERENDIA, LLC,
Patent Owner.

Case IPR2024-00463
Patent 10,869,812

**PATENT OWNER'S SUR-REPLY
IN SUPPORT OF
PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF CONTENTS

I.	The Board Should Deny Institution Under 35 U.S.C. § 325(d).....	1
II.	The <i>General Plastic</i> Factors Support Discretionary Denial.....	2
A.	Factor 1	2
B.	Factors 2 through 5.....	4
C.	Factors 6 and 7	5
D.	Factor 8.....	5
III.	Dr. Woloszko’s Testimony Supports Patent Owner’s Proposed Construction of “Desired Distance”	6
IV.	Objective Indicia Support Non-Obviousness	9

TABLE OF AUTHORITIES**Page(s)****CASES**

<i>Cont'l Can Co. USA, Inc. v. Monsanto Co.</i> , 948 F.2d 1264 (Fed. Cir. 1991)	10
<i>Ericsson Inc. v. Uniloc 2017, LLC</i> , IPR2019-01550, 2020 WL 1285387 (P.T.A.B. Mar. 17, 2020).....	3
<i>Ford Motor Co. v. Neo Wireless LLC</i> , IPR2023-00763, Paper 28 (P.T.A.B. Mar. 22, 2024).....	2, 3
<i>Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017).....	5
<i>Illumina, Inc. v. Ravgen, Inc.</i> , IPR2021-01271, Paper 12 (P.T.A.B. Jan. 26, 2022)	3
<i>Mitek Sys., Inc. v. United Servs. Auto. Ass'n</i> , IPR2020-00882, Paper 29 (P.T.A.B. Nov. 6, 2020).....	3
<i>PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC</i> , 815 F.3d 734 (Fed. Cir. 2016)	10
<i>Rambus Inc. v. Rea</i> , 731 F.3d 1248 (Fed. Cir. 2013)	10
<i>Shanghai Lunion Info. Techs., Ltd v. Telefonaktiebolaget LM Ericsson</i> , IPR2018-00995, Paper 12 (P.T.A.B. Nov. 13, 2018).....	5
<i>Shenzhen Silver Star Intelligent Tech. Co. v. iRobot Corp.</i> , IPR2018-00897, 2018 WL 4773439 (P.T.A.B. Oct. 1, 2018).....	5
<i>Unified Pats., LLC v. Torchlight Techs. LLC</i> , IPR2022-01500, Paper 15 (P.T.A.B. May 4, 2023)	4
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i> , IPR2019-00062, Paper 11 (P.T.A.B. Apr. 2, 2019)	3

STATUTES

35 U.S.C. § 325(d)	1
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Exhibit List

Exhibit	Description
2001	[Proposed] Stipulated Protective Order
2002	Markup Comparison Showing Differences Between the [Proposed] Stipulated Protective Order and the Default Protective Order
2003	Complainant's July 24, 2023 Supplemental Validity Contentions, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. July 24, 2023) (PROTECTIVE ORDER MATERIAL AND REDACTED VERSIONS)
2004	Expert Report of Jean Woloszko, M.D., Ph.D., dated August 14, 2023 (PROTECTIVE ORDER MATERIAL AND REDACTED VERSIONS)
2005–2006	RESERVED
2007	Deposition transcript of Jean Woloszko, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C.), taken September 14, 2023 (excerpt)
2008	Deposition transcript of Jean Woloszko, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C.), taken September 15, 2023 (excerpt)
2009–2014	RESERVED
2015	Complainant's Rebuttal Post-Hearing Brief, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. Jan. 5, 2024) (PROTECTIVE ORDER MATERIAL)

Exhibit	Description
2016	Complainant's Public Interest Statement & Complaint of Serendia, LLC, Under Section 337 of the Tariff Action of 1930, as Amended, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. Mar. 1, 2023)
2017	Parties' Proposed Procedural Schedule and Notice of USPTO/PTO Proceedings and State and Federal Litigation Pursuant to Order No. 3, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. Apr. 24, 2023)
2018	Order No. 6: Adopted Procedural Schedule, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. Apr. 27, 2023)
2019	Respondents' Joint Reply Post-Hearing Brief, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. Jan. 5, 2024) (excerpts)
2020	RESERVED
2021	Jeisys Medical Inc.'s and Cynosure, LLC's Response to the Complaint and Notice of Investigation, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. May 1, 2023)
2022	RESERVED
2023	Letter from Keith K. Im, SynKloud Technologies, LLC, to Todd Tillemans, Cynosure, LLC, dated Nov. 29, 2021
2024	Order No. 33: Granting Parties' Joint Motion to Amend the Amended Procedural Schedule [Motion Docket No. 1356-027], <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. Oct. 19, 2023)
2025–2036	RESERVED

Exhibit	Description
2037	Brochure: Sylfirm X Dual Wave RF Microneedling System (2022)
2038–2040	RESERVED
2041	Direct Rebuttal Demonstratives of Vincent A. Thomas (CDX-0045C), <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. Dec. 12, 2023) (PROTECTIVE ORDER MATERIAL)
2042–2051	RESERVED
2052	Email exchanges between SynKloud and Jeisys, transmitted December 6, 2021 through January 20, 2022, and Certified English Translations thereof (PROTECTIVE ORDER MATERIAL)
2053	Respondents' Notice of Prior Art, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. May 24, 2023) ("1356 Investigation NOPA")
2054	Complainant's Initial Validity Contentions, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. June 16, 2023) (PROTECTIVE ORDER MATERIAL)
2055–2061	RESERVED
2062	Presentation: Sylfirm X Clinical Training (2021) (PROTECTIVE ORDER MATERIAL)
2063–2065	RESERVED
2066	Martin Braun, <i>Sylfirm X Revolutionises [sic] the Clinical Applications of RF Microneedling</i> , 12 PRIME INT'L J. AESTHETIC ANTI-AGEING [sic] MED. 50 (2022)
2067	World-Class Product of Korea 2020, Certificate to ViOL Co., Ltd., dated December 9, 2020 ("Sylfirm X Award")

Exhibit	Description
2068–2069	RESERVED
2070	Curriculum Vitae of Vincent A. Thomas
2071	Profit & Loss, January–December 2021 (Accrual Basis) (July 6, 2023, 2:31 PM) (PROTECTIVE ORDER MATERIAL)
2072–2082	RESERVED
2083	ViOL, Sylfirm X User Manual (VO-UM-SFX-03), revised April 20, 2022
2084	Sylfirm X, Device Description (PROTECTIVE ORDER MATERIAL)
2085	RESERVED
2086	Sylfirm X Product Photographs
2087–2096	RESERVED
2097	Sylfirm X Introduction Video 1
2098	Transcript of Exhibit 2097 - Sylfirm X Introduction Video 1
2099–2102	RESERVED
2103	Deposition transcript of Peter Crosby, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C.), taken September 4, 2023 (excerpt)
2104	Deposition transcript of Peter Crosby, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C.), taken September 5, 2023 (excerpt)
2105–2107	RESERVED
2108	U.S. Patent Application Publication No. 2002/0120260 A1 (“Morris”)

Exhibit	Description
2109	RESERVED
2110	Certified English translation of Korean Registered Patent Publication No. KR 10-0852500, dated August 18, 2008 (“Lee ’500”)
2111	Respondents’ Amended Notice of Prior Art, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C. June 2, 2023)
2112	Rebuttal Expert Report of Peter Crosby, dated August 28, 2023 (PROTECTIVE ORDER MATERIAL)
2113	RESERVED
2114	File History for U.S. Patent No. 9,320,536
2115	U.S. Patent No. 6,890,319 B1 (“Crocker”)
2116–2118	RESERVED
2119	U.S. Patent. No. 6,277,116 B1 (“Utely”)
2120	U.S. Patent Application Publication No. 2002/0120261 A1 (“Morris ’261”)
2121	RESERVED
2122	Cartessa Aesthetics, Innovations in RF Microneedling: A Closer Look at VirtueRF, Observations Aesthetics, Issue No. 1 (June 2021)
2123–2124	RESERVED
2125	Hearing transcripts, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C.), held November 7, 2023 and December 11, 2023 (Jean Woloszko testimony excerpts) (“Woloszko Hr’g Tr.”)

Exhibit	Description
2126	Hearing transcript, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C.), held December 12, 2023 (Peter Crosby testimony excerpts) (“Crosby Hr’g Tr.”)
2127	Sylfirm X RF Inspection Report of Peter Crosby
2128	Deposition transcript of Jongju Na, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C.), taken July 25, 2023 (excerpts)
2129	RESERVED
2130	Sylfirm X Product Photographs
2131	RESERVED
2132	U.S. Patent Application Publication No. 2006/0036210 A1 (“Zhang”)
2133–2135	RESERVED
2136	Curriculum Vitae of Peter A. Crosby
2137–2138	RESERVED
2139	Appendix 7 – Summary Invalidity Claim Chart, U.S. Patent No. 10,869,812, <i>In re Certain Dermatological Treatment Devices & Components Thereof</i> , No. 337-TA-1356 (U.S.I.T.C.)
2140	Declaration of Peter Crosby, dated May 16, 2024 (“Crosby Decl.”) (PROTECTIVE ORDER MATERIAL AND REDACTED VERSIONS)
2141	Declaration of Vincent A. Thomas, dated May 20, 2024 (“Thomas Decl.”) (PROTECTIVE ORDER MATERIAL AND REDACTED VERSIONS)
2142	U.S. Patent Application Publication No. 2004/0058882 A1 (“Eriksson”)

Exhibit	Description
2143	U.S. Patent Application Publication No. 2008/0091182 A1 ("Mehta 182")
2144	Disclaimer in a Patent Under 37 C.F.R. § 1.321(a) of U.S. Patent 10,869,812 ('812 Patent), including electronic payment receipt ("Disclaimer")

I. The Board Should Deny Institution Under 35 U.S.C. § 325(d)

Petitioner misconstrues the teachings Mehta '705 and Mehta 182 to argue part one of *Advanced Bionics* is not met,¹ and then argues part two is also not met because the Examiner did not discuss those references. Both arguments fail.

As to part one, Petitioner does not dispute that Mehta '705 includes the same relevant teachings as Mehta, but instead argues that Mehta includes additional figures and descriptions. That is a red herring. First, as to Figures 9A-9G of Mehta, Petitioner does not even rely on them in its Petition to argue that the “desired distance” limitation is met. Pet. 27-30. Nor could Petitioner, as those figures and their corresponding disclosures are about tests related to power, memory, current, and voltage. Ex. 1006, 28:51-31:34. As to Figures 10A-F, the same teachings about physicians adjusting treatment disclosed in Mehta are also in Mehta '705. Ex. 2140 ¶ 78; Ex. 1011, 14:15-22, 18:35-46, 29:44-58. As to Livneh, contrary to Petitioner's arguments, Mehta 182 has similar disclosures to the coil in Livneh that Petitioner relies on for claims 9 and 18. Ex. 2143, [0092].

As to part two, Petitioner does not dispute that the relevant references were

¹ Petitioner admits that Na '848 was identified as the parent of the '812 Patent and fails to address that the teaching of Lee was considered by the Office. Paper 17 (“Reply”), 1-2.

before the Examiner and does not argue, much less establish, that the Office erred in its analysis of patentability of the challenged claims. Therefore, for the same reasons stated in the Patent Owner's Preliminary Response, § 325(d) favors denial of institution. Paper 16 ("POPR"), Section III.

II. The *General Plastic* Factors Support Discretionary Denial

A. Factor 1

Petitioner relies on *Ford Motor Co. v. Neo Wireless LLC*, to argue that "the Board does not recognize a 'significant relationship' between parties having different accused products that merely engage in court-ordered pretrial coordination." Reply at 3 (quoting *Ford*, IPR2023-00763, Paper 28 at 3 (P.T.A.B. Mar. 22, 2024)). But as the Director explained, pretrial coordination paired with "*other relevant or extenuating facts or circumstances*" may evidence a "significant relationship." *Ford*, IPR2023-00763, Paper 28 at 10-11 (emphasis added).

Other relevant and extenuating circumstances exist here, including that: (i) both petitions are directed to the same claims; (ii) Petitioner had notice of its potential infringement of the '812 Patent, and knew of litigation against other RF microneedling manufacturers/distributors, before the prior petition's filing; (iii) the current and prior Petitioners worked closely—beyond court-ordered pretrial coordination—to assert the same claim construction and invalidity positions, and to rely on the same expert (that Petitioner now relies on here) to present the same

invalidity positions at the evidentiary hearing; and (iv) Petitioner tactically delayed in filing this second Petition for ***more than seven months*** after indisputably being aware of the prior art asserted in this Petition, until after completing its coordinated efforts in litigation. POPR, Sections II.A, B, and D.1.

Petitioner does not dispute these facts. Instead, it proposes that no “significant relationship” can be found where different products are accused of infringement, disregarding the “other relevant or extenuating facts or circumstances” that evidence a “significant relationship.” *Ford*, IPR2023-00763, Paper 28 at 10-11. Petitioner further ignores the other factors enumerated in the precedential opinion in *Valve I* and its progeny. *See, e.g., Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 2, 9 (P.T.A.B. Apr. 2, 2019) (precedential) (“*Valve I*”); *Mitek Sys., Inc. v. United Servs. Auto. Ass’n*, IPR2020-00882, Paper 29 at 17 (P.T.A.B. Nov. 6, 2020); *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, 2020 WL 1285387, at *4-5 (P.T.A.B. Mar. 17, 2020).

Petitioner’s case law is inapposite. In *Illumina, Inc. v. Ravgen, Inc.*, to find no “significant relationship” existed, the Board considered that “unlike *Valve*, [petitioners] [we]re not co-defendants in the same case[,]” and “*Valve* had clearly used the Board’s denial of HTC’s earlier petition as a roadmap for *Valve*’s follow-on petition.” IPR2021-01271, Paper 12 at 16-17, 20 (P.T.A.B. Jan. 26, 2022). Here, the current and Petitioners ***were*** co-defendants, and Petitioner Jeisys ***did*** use the prior

IPR2024-00463 (USP 10,869,812) PO's Sur-Reply ISO Preliminary Response petitions (and Patent Owner's disclosures in the parallel litigation), as a roadmap for this second Petition. See POPR, Sections II.A, B, D.1, D.3. *Unified Patents, LLC v. Torchlight Technologies LLC*, is also inapt because there the patent owner's **only** basis for asserting a "significant relationship" was that petitioners were "co-defendants in litigation." IPR2022-01500, Paper 15 at 17-18 (P.T.A.B. May 4, 2023). Here, there are additional relevant and extenuating facts and circumstances evidencing a "significant relationship." *Supra* pp. 2-3.

B. Factors 2 through 5

Petitioner does not address, let alone dispute, most of the facts and case law Patent Owner raised for Factors 2 through 5, each of which **strongly** favors denying institution. For example, Petitioner does not dispute that (1) it knew or should have known of the asserted prior art at the time of the filing of the first petition (POPR, Section II.D.2 (Factor 2)), (2) it reviewed the prior Patent Owner's Preliminary Response and the Board's prior decision on institution, as well as Patent Owner's validity case in the ITC investigation, **and** adjusted its arguments in this second Petition in view of these prior disclosures (*id.* Section II.D.3 (Factor 3)), or (3) it was aware of the currently asserted prior art references at least seven months before filing this second Petition (*id.* Sections II.D.4 and 5 (Factors 4-5)).

Instead, Petitioner asserts it: (i) presents different invalidity grounds than those presented in the prior petition; and (ii) "Patent Owner's litigation strategy

resulted in the number and timing of petitions filed against the [patent at issue].”

Reply 6. But Petitioner proposing different invalidity grounds evidences improper road-mapping (*see* POPR, Section II.D.3), and Petitioner does not—and cannot—use Patent Owner’s litigation strategy to excuse waiting *at least seven months* after learning of the currently asserted prior art to file this second Petition.

C. Factors 6 and 7

Petitioner does not dispute that “multiple, staggered petition filings ... are an inefficient use of the *inter partes* review process and the Board’s resources.” *Shanghai Lunion Info. Techs., Ltd v. Telefonaktiebolaget LM Ericsson*, IPR2018-00995, Paper 12 at 20 (P.T.A.B. Nov. 13, 2018) (citation omitted). And that the ITC cannot invalidate a patent is irrelevant to whether the Board’s resources would be wasted by considering multiple tactically staggered petitions against the same claims. *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (P.T.A.B. Sept. 6, 2017) (footnote omitted).

D. Factor 8

Petitioner asserts that it and Cartessa “were not similarly-situated defendants facing the same-in-time hazard.” Reply 7. This is incorrect because they were “co-respondents in the ITC litigation and filed their invalidity contentions at the same time.” *Shenzhen Silver Star Intelligent Tech. Co. v. iRobot Corp.*, IPR2018-00897, 2018 WL 4773439, at *5 (P.T.A.B. Oct. 1, 2018).

III. Dr. Woloszko's Testimony Supports Patent Owner's Proposed Construction of "Desired Distance"

Petitioner's discussion of Dr. Woloszko's testimony is incorrect and fails to address *any* of the intrinsic evidence supporting Patent Owner's proposed construction for the "desired distance" terms. As discussed in Patent Owner's Preliminary Response (POPR, Section IV.B.1.) and further below, Dr. Woloszko's testimony supports Patent Owner's proposed construction, but more importantly, so does the intrinsic evidence, which Petitioner ignores again in its reply.

The Board need not reach extrinsic evidence to construe the "desired distance" terms. All but claims 9 and 18 recite a motor or mechanism to cause the plurality of needles to extend a "desired distance" from an end surface. Ex. 1001 ('812 Patent), cls. 2-5, 8, 13-16. Thus, the claims instruct that the "desired distance" is how far the needles extend from an end surface into dermatological tissue. The specification confirms this, explaining that the motor enables precise needle control, and does so by controlling needle deployment based on "user selected operational parameters[,]” including the "depth" of needle deployment. *Id.*, 10:32-37; *see also id.*, 10:61-65, 11:58-60, 13:63-66, 14:12-34. For example, the '812 Patent explains that, in various operational modes, "***a user may select*** the electrical signal intensity, start delay, and duty cycle (activity 934B) and ***needle deployment depth*** and number of shots per activation (activity 934C)." *Id.*, 13:63-66 (emphasis added), 14:21-24 (similar). Based on those selections, the motors "enable precise needle extension (effective

depth) control.” *Id.*, 14:24-26; *see also id.*, 14:14-20, 14:28-34. The prosecution history reinforces Patent Owner’s construction. The Examiner’s reliance on Crocker in the prosecution of a parent of the ’812 Patent shows he understood that the “desired distance” is based on a user’s selection to provide control over the penetration depth (directly or automatically through a feedback mechanism). POPR, Section IV.B.1.

Petitioner offers no response to Patent Owner’s explanation that the intrinsic evidence supports its plain and ordinary meaning construction for the “desired distance” terms. Nor does Petitioner identify any intrinsic evidence supporting its proposal that “desired distance” means “a *desired distance* as opposed to an *undesired distance*”—there is none. Pet. 11-12 (original emphasis). The Board need not go further to determine the proper construction, but the extrinsic evidence supports Patent Owner’s construction too.

Under cross-examination by the attorney representing the Office of Unfair Import Investigations at the ITC, addressing the same ’812 Patent and Mehta reference at issue here, Dr. Woloszko admitted that a motor that can advance and retract needles does not necessarily mean that the “desired distance” claim limitation is met unless the user can program that distance:

Q. Would a motor extending a plurality of needles to a predetermined distance constitute extending extendable needles a desired distance as claimed in the Family Two patents?

A. *As long as you can program this distance*, yes.

* * *

Q. In your view the fact that a motor can advance and retract needles necessarily means that the motor controls the desired distance of needle extension from an end surface as recited in the Family Two patent claims?

A. **No. It does not.** Motor, the type of motor, some motor - -

Ex. 2125, 1151:8-12, 1151:23-1152: 3 (emphasis added). These admissions reinforce Patent Owner's proposed construction. And Petitioner's attempts to explain away Dr. Woloszko's testimony by pointing to the testimony he was spoon-fed on direct examination, as he regurgitated Petitioner's slides, fails.

Petitioner argues the *first* way the claims can be met is by "selecting a cartridge with needles of a particular length[.]" Reply 8. Petitioner fails to mention that Dr. Woloszko also conceded this "doesn't change the distance from the end surface." Ex. 2125, 1152:7-19. Indeed, Petitioner's proposal that inserting any cartridge meets the "desired distance" limitations renders them meaningless because those limitations would have the same meaning if the words "desired distance" were removed. As to the *second* way—"using a motor to extend the needles to a programmed distance[.]" (Reply 8)—that distance has to be programmed (Ex. 2125, 1151:8-12), and the intrinsic evidence explains that is programmed based on user selection. Ex. 1001, 13:63-66, 14:21-24. The *third* way Petitioner argues the claims can be met is by "adjusting the needle depth by manually checking the needle

location[]” (Reply 8), but the claims exclude this. The claims recite that the motor causes the needles to extend a desired distance—not manually checking their location after they have been extended. Thus, post-extension manual adjustment cannot satisfy the claims.

Finally, nothing in the intrinsic record supports Petitioner's arguments that the “desired distance” limitations can be met by “(1) user selection of a cartridge having needle lengths corresponding to a desired distance and (2) user adjustment of the needle extension distance after an initial extension.” Reply 8. Petitioner does not argue otherwise. Instead, the intrinsic evidence—and Dr. Woloszko's admissions—support that the “desired distance” is how far the needles extend from an end surface, based on a user's selection, to penetrate dermatological issue.

IV. Objective Indicia Support Non-Obviousness

Even if the Board were to reach the merits, objective indicia of non-obviousness strongly support denial of institution on the merits. Petitioner does not dispute that (1) it was required to address objective indicia, or (2) it and its expert failed to do so. Instead, Petitioner belatedly relies on attorney argument that Patent Owner did not demonstrate a nexus between the claims and its evidence of commercial success and industry praise because: (i) Patent Owner asserts that commercial success is, at least partially, attributable to other features, and (ii) “user-selectable needle extension distance” was purportedly “known.” Reply 9-10.

Petitioner's attorney argument has no merit.

First, it is black letter law that “[i]t is not necessary ... that the patented invention be solely responsible for the commercial success, in order for this factor to be given weight.” *Cont'l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1273 (Fed. Cir. 1991) (citations omitted). When the evidence shows that a product practices the claimed invention, a presumption exists “that any commercial success of these products is due to the patented invention[.]” and “***[t]his is true even when the product has additional, unclaimed features.***” *PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 734, 747 (Fed. Cir. 2016) (emphasis added) (citations omitted). Put simply, that the Sylfirm X has other features contributing to its commercial success does not impact the nexus analysis.

Second, Petitioner does not even argue the claimed “desired distance,” as properly construed, was known. It was not. *See, e.g.*, POPR, Sections IV.D and G. Further, “[w]hile objective evidence of nonobviousness lacks a nexus if it ***exclusively*** relates to a feature that was ‘known in the prior art,’ ... the obviousness inquiry centers on whether ‘the claimed invention as a whole’ would have been obvious[.]” *Rambus Inc. v. Rea*, 731 F.3d 1248, 1257-58 (Fed. Cir. 2013) (emphasis added) (citations omitted). Despite knowing about Patent Owner's objective indicia evidence for months, Petitioner offers no evidence to support any argument that the objective indicia here relate exclusively to a known feature.

Respectfully submitted,

Dated: June 14, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 14th day of June, 2024, a true and correct copy of the foregoing **Patent Owner's Sur-Reply in Support of Patent Owner's Preliminary Response** was served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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