

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENDYMED MEDICAL LTD. and ENDYMED MEDICAL, INC.,
Petitioner,

v.

SERENDIA, LLC,
Patent Owner.

IPR2024-00842
Patent 9,480,836 B2

Before CARL M. DeFRANCO, MICHAEL L. WOODS, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

DECISION

Instituting *Inter Partes* Review and Granting Motion for Joinder
35 U.S.C. §§ 314, 315(c); 37 C.F.R. §§ 42.108, 42.122(b)

I. INTRODUCTION

EndyMed Medical Ltd. and EndyMed Medical, Inc. (collectively, “EndyMed” or “Petitioner”) filed a petition for *inter partes* review of claims 1–29 of U.S. Patent 9,480,836 B2 (“the ’836 patent”). *See* Paper 1 (“Pet.”). Serendia, LLC (“Serendia” or “Patent Owner”) filed a preliminary response that included public and confidential versions.¹ *See* Papers 14, 15, respectively (“Prelim. Resp.”).

Concurrently with the petition, EndyMed filed a motion for joinder, seeking joinder with previously-instituted *inter partes* review of the ’836 patent, namely, *Jeisys Medical Inc. v. Serendia, LLC*, IPR2024-00386 (“the ’386 IPR”). *See* Paper 2 (“Pet. Mot.”). Serendia filed an opposition to joinder. *See* Paper 10 (“PO Opp.”). EndyMed followed with a reply in support of joinder. *See* Paper 11 (“Pet. Reply”).

Exercising our jurisdiction under 35 U.S.C. § 314(a), we institute *inter partes* review of claims 1–29 of the ’836 patent. We also grant EndyMed’s motion for joinder and join EndyMed to the ’386 IPR.

II. BACKGROUND

A. Related Matters

This is EndyMed’s first and only petition challenging the ’836 patent. As noted above, however, another entity, *Jeisys Medical Inc.* (“Jeisys”), filed an earlier petition on which we granted institution of *inter partes* review. *See* ’386 IPR, Paper 18 (Institution Decision, entered July 22,

¹ Unless otherwise noted, this decision refers to the public, redacted versions of any papers, including the preliminary Response, Paper 14.

2024). The '836 patent was also the subject of IPR2022-00594 on which we denied institution. *Id.* at 4 (citations omitted); *see also* Prelim. Resp. 3.

The '836 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 Investigation”). *See* Prelim. Resp. 3–4 (referencing the same). The respondents in the ITC proceeding include Jeisys, EndyMed, and numerous others. *See id.*

The '836 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. They are:

- *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 v. Aesthetics Biomedical, Inc.*, 2:22-cv-15 (D. Ariz.) (dismissed on Nov. 21, 2023)
- *SynKloud Technologies, LLC 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 9, 1–2; *see also* Prelim. Resp. 2–3; *see also* '386 IPR, Paper 18 at 3–4.

B. The '836 Patent

The '836 patent is titled “Skin Treatment Apparatus and Method” (Ex. 1001, code (54)) and describes “skin treatment using electrical energy, especially with the primary purpose for skin treatment for aesthetics” (*id.* at code (57)).²

The '836 patent further describes a “method and apparatus that provides electric stimulation directly to a body region including the dermis via needles.” Ex. 1001, 2:37–41. The '836 patent explains that the “method revitalizes and regenerates the body region including collagen by wounding the dermis.” *Id.* The '836 patent states that “[e]xisting technology may create scars created in overheated or burned epidermis” and that an embodiment of the invention is “to prevent overheating or burning of epidermis.” *Id.* at 4:18–22. We reproduce Figure 5 of the '836 patent, below:

² Throughout this Decision, our quotations from the '836 patent and other U.S. patent documents omit bold emphasis from the reference numerals.

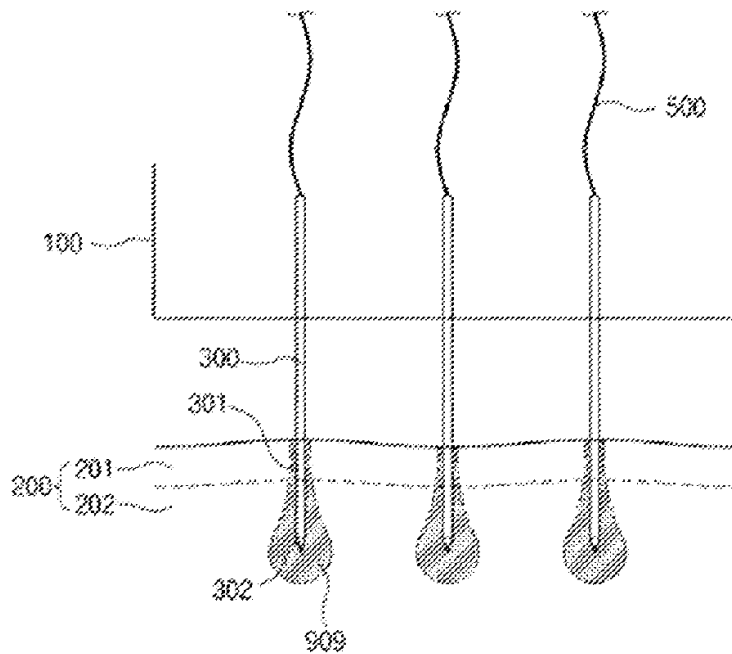


FIGURE 5

Figure 5 depicts “a simplified diagram of treatment architecture using non insulated needles according to an embodiment of” the ’836 patent. Ex. 1001, 4:41–43. In particular, Figure 5 depicts needles 300 with needle tips 302 for generating energy field 909. *See id.* at 7:27–32 (referencing Fig. 6); *see also id.* at 9:25–26.

The ’836 patent further discloses,

In an embodiment, the temperature is raised about the tip of each needle, not between needles. The method of the present invention may control electrical factors or distance between needles to control the energy field applied between needles. A method of the present invention may enable users to control the number of treatments in target areas by controlling the dissipated energy in needles.

Id. 3:30–36.

C. Challenged Claims

EndyMed challenges every claim, or claims 1–29, of the '836 patent. Pet. 1; Ex. 1001, 10:47–12:36. Of these claims, claims 1 and 14 are independent. *See* Ex. 1001, 10:47–12:36. We reproduce claim 1, below:

1. A skin treatment apparatus, comprising:
 - a plurality of electrodes, the electrodes being bipolar and configured to be insertable into skin to be treated; and
 - a radio frequency (RF) generation module, the RF generation module electrically coupled to the plurality of electrodes and configured to provide an Alternating Current (AC) RF signal to the plurality of electrodes configured to cause coagulation around each electrode rather than coagulating between the electrodes.

Id. at 10:47–55.

D. Asserted Challenges of Unpatentability

EndyMed asserts that the Challenged Claims are unpatentable based on the following grounds (Pet. 6):

Ground	Claims Challenged	35 U.S.C. § ³	Reference(s)/Basis
1	1, 2, 11–15, 23, 24, 26	103	Ganz ⁴
2	1, 2, 11–15, 23, 24, 26	103	Ganz, Livneh ⁵
3	2–10, 15–22, 25	103	Ganz, Hantash ⁶
4	2–10, 15–22, 25	103	Ganz, Livneh, Hantash
5	27–29	103	Ganz, Lee ⁷
6	27–29	103	Ganz, Livneh, Lee

EndyMed also relies on the declaration of Jean Woloszko, Ph.D. (Ex. 1037). *See* Pet. 1 (“This Petition adds and relies on Ex-1037, Substitute Declaration of Jean Woloszko, Ph.D. (added in IPR2024-00386 after its petition)). EndyMed submits that “Dr. Woloszko replaced expert Dr. Bérubé in IPR2024-00386 and agrees with and adopts paragraphs 17–268 of Dr. Bérubé’s Declaration.” *Id.* (citing Ex. 1037 ¶¶ 1, 22).

In support of its Preliminary Response, Serendia relies on the declarations of Daniel W. van der Weide (Ex. 2143) and David J. Goldberg (Ex. 2142). *See, e.g.*, Prelim. Resp. 4 (referencing Dr. Goldberg’s testimony in Exhibit 2142); *see also id.* at 30 (referencing Dr. van der Weide’s testimony in Exhibit 2143); *see also id.* at xiii (Patent Owner’s Exhibit List).

III. ANALYSIS

A. Threshold for Institution

In the '386 IPR, we instituted an *inter partes* review of claims 1–29 of the '836 patent based on the same claims and grounds of unpatentability as EndyMed asserts here. *Compare* '386 IPR, Paper 18 at 7, 39, *with* Pet. 6. In asserting these grounds, EndyMed represents that the petition here “is materially identical to the petition in instituted IPR2024-00386.” Pet. 1. EndyMed also represents that it relies on the same expert declaration as does Jeisys in the '386 IPR, specifically, that of Dr. Woloszko, who replaced Dr. Bérubé. *See id.*; *see also supra* § II.D.

Serendia argues that we should deny institution for the following three reasons:

- (1) EndyMed’s primary reference, Ganz, is directed to an entirely different treatment approach than the '836 patent;
- (2) Ganz fails to disclose or teach “electrodes being bipolar” that are “configured to cause coagulation around each electrode rather than between them”; and
- (3) That objective evidence of non-obviousness, including commercial success, industry praise, and long-felt need demonstrate non-obviousness.

See Prelim. Resp. 1–2.

As explained below, however, we addressed similar arguments in our decision to institute review of the '836 patent in the '386 IPR.

Regarding Serendia’s arguments (1) and (2), that Ganz does not teach coagulation and is instead directed to a “completely different approach” than

the '836 patent, Serendia presented similar arguments in its preliminary response in the '386 IPR. *Compare* Prelim. Resp. 21–29, *with* '836 IPR, Paper 11 at 32–39. In support of these arguments, Serendia contends that the '836 patent claims are “configured to cause coagulation,” whereas Ganz *burns tissue* around electrodes. *See* Prelim. Resp. 22–23. As explained in our decision to institute the '836 IPR, however, we disagreed with Serendia’s argument. *See, e.g.,* '836 IPR, Paper 18 at 27–29. Based on the current briefing and evidence, we explained that Ganz discloses the delivery of radio frequency to electrodes inserted into skin for creating “[z]ones of coagulation . . . in areas of tissue surrounding each perforation.” *Id.* at 28 (citation omitted). We further found that Ganz discloses that the “electrode pattern can . . . be selected to create a zone of coagulative tissue surrounding each perforation” and that these “zones can extend from the perforation site into the tissue for a length ranging from about 5 microns to about 100 microns.” *Id.* (citations omitted). We determined that based on the current briefing and evidence, the petitioner in the '386 IPR has shown a reasonable likelihood that Ganz’s radio frequency generation module is “configured to cause coagulation around each electrode rather than coagulating between the electrodes.” *Id.* at 29.

Regarding Serendia’s argument (2) that Ganz fails to disclose *bipolar* electrodes that are configured to cause coagulation around each electrode (*see* Prelim. Resp. 28–37), we addressed a similar argument in our decision to institute the '386 IPR (*see, e.g.,* '386 IPR, Paper 18 at 20–21, 27–29). In particular, in our decision to institute the '386 IPR, we determined that based on the current briefing and evidence, including Ganz’s disclosure of “bipolar electrodes,” the petitioner has shown a reasonable likelihood that Ganz

discloses that its “electrodes [are] bipolar.” ’386 IPR, Paper 18 at 21 (citation omitted). Indeed, Ganz discloses that “[i]n some cases, the electrodes are monopolar electrodes whereas in other cases the electrodes are bipolar electrodes.” Ex. 1005 ¶ 11.

Regarding argument (3), objective evidence of non-obviousness, Serendia submits that there “is a strong nexus between the commercial success of [its] Sylfirm X and the claimed invention.” Prelim. Resp. 66. Serendia contends EndyMed’s obviousness grounds fail because EndyMed did not address known objective evidence of nonobviousness, including evidence of commercial success, industry praise, and long-felt need. *See* Prelim. Resp. 60–71.

Although Serendia presented similar arguments in the ’386 IPR (*see* ’386 IPR, Paper 11 at 59–65), Serendia argues that the Preliminary Response “provide[s] additional citations and explanation of evidence to address the Board’s concern” (*see* Prelim. Resp. 71). In the decision to institute the ’386 IPR, we determined that Serendia “does not explain sufficiently how its evidence of objective indicia is a direct result of the features of the Challenged Claims.” ’386 IPR, Paper 18 at 38. In the Preliminary Response, Serendia contends that “there is substantial evidence directly linking the claimed invention and the evidence of secondary considerations.” Prelim. Resp. 72. In support of this argument, Serendia relies on the *Sylfirm X Brochure*. *See id.* at 73 (citing Ex. 2037, 12).

At this preliminary stage of briefing and evidence, we disagree with Serendia.

The question of nexus is highly fact specific, and it is patent owner’s burden to establish a sufficient nexus. *Fox Factory, Inc. v. SRAM, LLC*, 944

F.3d 1366, 1373 (Fed. Cir. 2019). Presuming nexus is appropriate “when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘embodies the claimed features, and is coextensive with them.’” *Id.* (citations omitted).

The patent owner is afforded an opportunity to prove nexus by showing that the evidence of secondary considerations is the “direct result of the unique characteristics of the claimed invention.” *Fox Factory*, 944 F.3d at 1373–1374 (internal citation omitted). “Although we do not require the patentee to prove perfect correspondence to meet the coextensiveness requirement, what we do require is that the patentee demonstrate that the product is essentially the claimed invention.” *Id.* at 1374 (citation omitted).

Here, Serendia references the *same evidence* as providing evidence of nonobviousness for *four different patents*. For example:

1. In the instant *inter partes* review, Serendia references the Sylfirm X Brochure and submits that “[a]dvertisements for the Sylfirm X tout the benefit of the ’836 Patent Technology.” Prelim. Resp. 68.
2. In IPR2024-00843, challenging U.S. Patent Number 9,775,774, Serendia references the same Sylfirm X Brochure and submits that “[a]dvertisements for the Sylfirm X tout the benefit of the [’774] Patent technology.” IPR2024-00843, Paper 11 at 55.
3. In IPR2024-00844, challenging U.S. Patent Number 9,320,536, Serendia references the same Sylfirm X Brochure and submits that “[a]dvertisements for the Sylfirm X tout the benefit of the ’536 Patent technology.” IPR2024-00844, Paper 11 at 64.
4. In IPR2024-00845, challenging U.S. Patent Number 10,869,812, Serendia references the same Sylfirm X Brochure and submits that “[a]dvertisements for the Sylfirm

X tout the benefit of the '812 Patent technology.” IPR2024-00845, Paper 13 at 66–67.

As noted above, Serendia asserts that the Sylfirm X Brochure evidences nonobviousness for four different patents. In this situation, a presumption of nexus is appropriate only if patent owner demonstrates that the claims of all four patents “generally cover the same invention.” *See Fox Factory*, 944 F.3d at 1377 (“Where a product embodies claims from two patents, a presumption of nexus can be appropriate only if the claims of both patents generally cover the same invention.”). “The same evidence of secondary considerations cannot be presumed to be attributable to two different combinations of features.” *Id.* at 1378 (citation omitted). “In such situations, the patentee retains the burden of proving the degree to which evidence of secondary considerations tied to a product is attributable to a particular claimed invention.” *Id.* (citation omitted).

Here, Serendia does not demonstrate that the four different patents cover the same invention. *See* Prelim. Resp. 59–74. Indeed, Serendia does not address U.S. Patents 9,775,774, 9,320,536, and 10,869,812 at all. *See id.* That Serendia separately sought patent protection for each of these four patents suggests that these patents do not generally cover the same invention. *Cf Fox Factory*, 944 F.3d at 1378 (“The same evidence of secondary considerations cannot be presumed to be attributable to two different combinations of features.”). We made a similar determination in the '386 IPR. *See, e.g., '386 IPR*, Paper 18 at 38 (“Patent Owner fails to set forth which patents ‘generally cover’ the Sylfirm X device.” (citations omitted)).

We further note that, in most cases, an analysis of objective evidence of nonobviousness is best made on a complete trial record, and not upon the incomplete record presented at the institution stage.

For the foregoing reasons, the underlying premise of Serendia's arguments here and in the '386 IPR remains substantially the same. Thus, for the same reasons discussed in our decision instituting the '386 IPR, we find that EndyMed demonstrates a *reasonable likelihood* of prevailing with respect to at least one of challenged claims 1–29 of the '836 patent. *See* '386 IPR, Paper 18. That is not to say, however, that Serendia may not ultimately persuade us at trial of the deficiency of EndyMed's showing based on a preponderance of the evidence.

B. Joinder

In seeking joinder, EndyMed represents that the instant petition “is identical in all materials respects” to the petition in the '386 IPR, “differing only in party-specific facts and formalities in Sections I–II and IX.” Mot. 1. EndyMed explains that it is filing the petition and seeking joinder with the '386 IPR “to allow a petitioner to remain in order to complete trial in the event Jeisys [the petitioner in the '386 IPR] reaches a settlement with Serendia . . . or otherwise terminates from the proceeding prior to trial.” *Id.* at 2. As such, EndyMed agrees it “will act as an ‘understudy’ and will not assume an active role unless Jeisys ceases to participate in the 386 Proceeding.” *Id.*; *see also id.* at 8–10 (representing the same).

At the outset, we note that EndyMed's concern with a potential settlement in the '386 IPR has come to fruition. Jeisys and Serendia have reached a settlement resolving their dispute over the '836 patent and have jointly requested termination of the '386 IPR. *See* '386 IPR, Paper 34

(“Joint Motion to Terminate *Inter Partes* Review”). Thus, it appears EndyMed would necessarily assume an active role in the ’386 IPR if joinder is granted.

We have discretion to join a later petitioner of a patent with an ongoing *inter partes* review of that same patent.

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c). Indeed, there is a policy preference for joining a later petitioner if their petition does not present new issues that might complicate or delay an existing proceeding. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed as of right – if an inter partes review is instituted on the basis of a petition, for example, a party that files an *identical* petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.” (emphasis added)).

Serendia argues that joinder should be denied due to EndyMed’s “unreasonable and unjustifiable delay” in filing the petition and seeking joinder with the ’386 IPR, despite being aware of the ’836 patent and Jeisys’s petition for “more than 7 months” before filing. PO Opp. 1–2.

We disagree with Serendia.

EndyMed need not justify its delay where, as here, EndyMed satisfies the joinder requirement of filing the petition within one month of our institution of trial in the ’386 IPR. *See* 37 C.F.R. § 42.122(b); *see also* 37

C.F.R. §§ 1.7(a), 42.1(a). Indeed, by rule, EndyMed could not have filed the instant petition prior to institution of the IPR it was seeking to join. *See* 37 C.F.R. § 42.122(b) (“Any request for joinder must be filed . . . no later than one month *after* the institution date of any *inter partes* review for which joinder is requested.”) (emphasis added). And, although there is a one-year statutory bar from the date of service of a complaint alleging infringement for requesting *inter partes* review, that bar does not apply to a request for joinder. *See* 35 U.S.C. § 315(b). Thus, despite being filed more than one year from the service date of Serendia’s complaint alleging infringement of the ’836 patent, EndyMed’s petition and motion are nonetheless timely.

Serendia also argues that joinder should be denied due to duplicative efforts with the parallel Delaware litigation, which involves the same parties and patent as here. *See* PO Opp. 3–4. That argument fails for the simple reason that EndyMed submits a *Sotera* stipulation, agreeing not to pursue in the Delaware litigation the same grounds that are asserted in the petition here or any grounds that reasonably could have been raised here. *See* Pet. Reply 1–2. A *Sotera* stipulation mitigates concerns of duplicative efforts, and we decline to discretionarily decline institution where a petitioner makes such a stipulation. *See* Katherine K. Vidal, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) (“Director Memo”), at 3, 7–8. Thus, we will not discretionarily deny the petition or motion for joinder on the basis of the parallel Delaware litigation.⁸

⁸ To the extent Serendia also relies on duplicative efforts with the pending ITC investigation, the Director has expressly stated that the Board “will not”

Also, to the extent Serendia contends EndyMed should not be permitted to join and continue an *inter partes* review that would otherwise be terminated due to Serendia's settlement with Jeisys, we disagree for several reasons. First, this is EndyMed's first and only petition challenging the '836 patent. As such, there is no risk of "repeated attacks" by the "same petitioner," as was the case in *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 5–13 (October 28, 2020) (precedential), where joinder was denied because the same petitioner had filed multiple petitions against the same patent. In contrast, permitting joinder here will ensure that the '386 IPR is not prematurely terminated based on an opportunistic settlement by Serendia with fewer than all the parties against which Serendia has asserted the '836 patent.

Moreover, as explained above, EndyMed's petition includes no new grounds of unpatentability and is materially identical to Jeisys's petition in the '386 IPR. And, in seeking joinder, EndyMed agrees to abide by the scheduling order presently set in the 383 IPR.⁹ *See* Mot. 8 ("EndyMed explicitly consents to the trial schedule as adopted in the 386 Proceeding."). EndyMed also agrees to rely primarily on Jeisys's filings and arguments, unless Jeisys ceases to participate in the '386 IPR, which is likely to occur given the pending motion to terminate Jeisys as a petitioner in the '386 IPR. *See* Mot. 9 ("Unless and until Jeisys ceases to participate, EndyMed will not assume an active role in the 386 Proceeding"); *see also* IPR2024-00386,

discretionarily deny a petition based on a parallel ITC proceeding. *See* Director Memo at 7.

⁹ Should we deem it appropriate, we may adjust the deadlines in the 383 IPR upon the grant of joinder. *See* 35 U.S.C. § 316(a)(11); *see also* 37 C.F.R. § 42.100(c).

Paper 34 (Joint Motion to Terminate IPR2024-00386). Accordingly, we are not concerned with cooperation and duplication among petitioners, as EndyMed would be the lone petitioner upon the termination of Jeisys.

In sum, we are not persuaded that joinder in this case will undermine our ability to secure a just, speedy, and inexpensive resolution of this proceeding. Rather, we are persuaded that joinder is appropriate here. As such, we grant EndyMed's motion to join the '842 IPR with the '386 IPR.

IV. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review of claims 1–29 of the '836 patent is hereby *instituted*;

FURTHER ORDERED that EndyMed's motion for joinder is hereby *granted*;

FURTHER ORDERED that the IPR2024-00842 is joined to IPR2024-00386;

FURTHER ORDERED that IPR2024-00842 is hereby *terminated*;

FURTHER ORDERED that, unless notified otherwise, the scheduling order currently in effect in IPR2024-00386 shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceedings are to be made only in IPR2024-00386;

FURTHER ORDERED that EndyMed Medical Ltd. and EndyMed Medical, Inc. shall be added as petitioners to the case caption in IPR2024-00386 for all further submissions; and

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FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2024-00386.

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