

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENDYMED MEDICAL LTD. AND ENDYMED MEDICAL, INC.,
Petitioners,

v.

SERENDIA, LLC,
Patent Owner.

U.S. Patent No. 9,775,774

Inter Partes Review No. IPR2024-00843

PETITIONERS' MOTION FOR JOINDER

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners EndyMed Medical Ltd. and EndyMed Medical, Inc. (collectively “EndyMed”) request joinder as a party to previously instituted *inter partes* review (“IPR”) of U.S. Patent No. 9,775,774 (“the ’774 Patent”), *Jeisys Medical Inc. v. Serendia, LLC*, Case No. IPR2024-00383 (“the 383 Proceeding”). EndyMed today filed a Petition in its IPR2024-00843 requesting institution of an IPR of the same ’774 Patent as in the 383 Proceeding. This Motion for Joinder is timely filed because it was filed no later than one month after the institution in the 383 Proceeding. 37 C.F.R. § 42.122(b). This concurrently-filed Petition is timely filed because the time period set forth in 37 C.F.R. § 42.101(b) shall not apply when the petition is accompanied by a request for joinder. 37 C.F.R. § 42.122(b). EndyMed has consulted with counsel for Jeisys Medical Inc. (“Jeisys”), the current petitioner in the 383 Proceeding, and Jeisys does not oppose this Motion for Joinder. EndyMed has also retained Jean Woloszko, petitioners’ expert in the 383 Proceeding.

EndyMed’s Petition is identical in all material respects to the petition filed in the 383 Proceeding (containing identical invalidity analysis in Sections I, V-IX, and differing only in party-specific facts and formalities in Sections II-IV and X). EndyMed’s Petition adds and relies on EX1025, Substitute Declaration of Jean Woloszko, Ph.D., which was added in IPR2024-00383 after its petition to switch

experts, and which adopts the opinions of the original expert Dr. Bérubé's Declaration. EX1025, ¶¶1,22. EndyMed's Petition and the petition in the 383 Proceeding challenge the same claims, on the same grounds, with the same arguments, and rely on the same prior art and evidence, including identical declarations from the same experts. EndyMed agrees to proceed solely on the grounds, claim constructions, evidence, and arguments advanced, or that will be advanced, in the 383 Proceeding. EndyMed respectfully submits its Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits EndyMed's joinder in the 383 Proceeding.

EndyMed is filing its Petition and this Motion for Joinder to allow a petitioner to remain in order to complete trial in the event Jeisys reaches a settlement with Serendia, LLC ("Patent Owner") or otherwise terminates from the proceeding prior to trial. Upon joining the 383 Proceeding, EndyMed will act as an "understudy" and will not assume an active role unless Jeisys ceases to participate in the 383 Proceeding. That is, for so long as Jeisys remains in the proceeding, Jeisys will maintain the lead role, and EndyMed will not introduce any briefing, arguments or evidence or seek additional depositions or deposition time. Accordingly, the proposed joinder will neither unduly complicate the 383 Proceeding nor delay its schedule in any way.

Joinder of EndyMed in this matter provides a public benefit by allowing the

383 proceeding to continue in the event that Jeisys' participation terminates, thereby furthering "the Board's mission to improve patent quality" where the Board already established a "reasonable likelihood" that all claims (not statutorily disclaimed) in the '774 Patent are unpatentable in IPR2024-00383. *Code 200, UAB et al v. Bright Data Ltd.*, IPR2022-00861, -00862, 2022 WL 3646167, at *3 (P.T.A.B. August 23, 2022) (precedential); Institution Decision in the 383 Proceeding, at 2, 18-19. In addition, joinder will help efficiently resolve disputes among the parties, and narrow the issues in EndyMed's co-pending district court action because if EndyMed joins the 383 Proceeding, a final written decision would estop EndyMed from raising certain invalidity challenges in its parallel litigation pursuant to 35 U.S.C. §315(e). These considerable efficiencies simplify and expedite the potential issues in the co-pending district court action against EndyMed.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase filings, any additional costs on Patent Owner will be *de minimis*. On the other hand, denial of joinder would prejudice EndyMed. EndyMed's interests may not be adequately protected in the 383 Proceeding, particularly if Jeisys settles with Patent Owner.

Accordingly, EndyMed respectfully requests the Board join EndyMed as a

party to the 383 Proceeding.

II. BACKGROUND AND RELATED PROCEEDINGS

The '774 Patent is involved in at least each of the following related matters:

- *Certain Dermatological Treatment Devices and Components Thereof*, 337-TA-1356 (“ITC Investigation”)
- *Serendia, LLC v. Cutera, Inc.*, 1:23-cv-00222 (D. Del.)
- *Serendia, LLC v. Cynosure, LLC*, 1:23-cv-00223 (D. Del.)
- *Serendia, LLC v. EndyMed Medical, Inc.*, 1:23-cv-00224 (D. Del.)
- *Serendia, LLC v. Lutronic Aesthetics, Inc.*, 1:23-cv-00225 (D. Del.)
- *Serendia, LLC v. Rohrer Aesthetics, Inc.*, 1:23-cv-00226 (D. Del.)
- *Jeisys Medical Inc. v. Serendia, LLC*, IPR2024-00383

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an existing IPR proceeding. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Xilinx, Inc. v. FG SRC LLC*, IPR2021-00633, Paper 15, at 13-14 (P.T.A.B. Aug. 2, 2021); *AT&T Services, Inc. v. Convergent Media Solutions, LLC*, IPR2017-01237, Paper 10, at 23 (P.T.A.B. May 10, 2017); *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17, at 4-6 (P.T.A.B. Jul. 29, 2013); *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper

15, at 3-4 (P.T.A.B. Sep. 24, 2013); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4 (P.T.A.B. Feb. 25, 2013). “The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations.” *Dell*, IPR2013-00385, Paper 17, at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should:

(1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.

Xilinx, Inc., IPR2021-00633, Paper 15, at 14.

B. Joinder with the 383 Proceeding Is Appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces *identical* arguments and the *same* grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper No. 12, at 9 (P.T.A.B. Aug. 24, 2016) (emphasis added) (internal quotations and citations omitted); *see also Xilinx, Inc.*, IPR2021-00633, Paper 15, at 16.

Here, joinder with the 383 Proceeding is appropriate because EndyMed’s Petition introduces *identical* unpatentability arguments and the *same* grounds

raised in the petition of the 383 Proceeding. In other words, both petitions contain the same grounds based on the same prior art combinations and supporting evidence against the same claims. Indeed, there are no material changes to the facts, citations, evidence, or arguments used in demonstrating satisfaction of the implicated claims by the applied prior art. Because these proceedings introduce identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of this proceeding and the 383 Proceeding.

Moreover, the Board has indicated that the factors outlined by *General Plastics* are not particularly relevant here “where a different petitioner files a ‘me-too’ or ‘copycat’ petition in conjunction with a timely motion to join.” *See, e.g., Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11, at 9-11 (P.T.A.B. Oct. 30, 2018); *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25, at 7-8 (P.T.A.B. Feb. 21, 2018). And the present facts stand in stark contrast to the *Apple Inc. v. Uniloc 2017 LLC* case where the Board denied institution and joinder based on *General Plastic*. *See* IPR2020-00854, Paper 9 (P.T.A.B. “Precedential” Oct. 28, 2020). In that case, the second-in-time petitioner seeking joinder had previously petitioned for, and been denied, *inter partes* review of the same patent. *Id.* at 2. Not so here. This is EndyMed’s first challenge against the ’774 Patent at

the PTAB, and there is no risk of prejudice or abuse. Rather, through grant of this joinder, the Board is simply offered the opportunity to ensure that the 383 Proceeding is not prematurely terminated based on opportunistic settlement by Patent Owner with fewer than all parties against which it has asserted the subject patent.

C. Joinder Will Not Add Any New Grounds of Unpatentability or Impact the Trial Schedule

The Petition is based on the same grounds and combinations of prior art in the 383 Proceeding. For simplicity and efficiency, EndyMed has copied the substance of the petition in the 383 Proceeding and its accompanying expert declarations. EndyMed does not seek to introduce grounds or claims not currently in the 383 Proceeding and seeks only to join the proceeding as instituted. No discovery will be required of Patent Owner beyond that which it may need in the 383 Proceeding—nor should the Board permit any. The present Petition introduces no new substantive issues relative to the 383 Proceeding and does not seek to broaden the scope of the 383 Proceeding.

Joinder will not impact the 383 Proceeding trial schedule because the present Petition presents no new issues or grounds of unpatentability. *See Sony Corp. v. Memory Integrigy, LLC*, IPR2015-01353, Paper No. 11 at 6 (P.T.A.B. Oct. 15, 2015) (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already

required in [the original IPR]”); *see also Xilinx*, IPR2021-00633, Paper 15, at 16. Further, EndyMed explicitly consents to the trial schedule as adopted in the 383 Proceeding. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

Patent Owner’s Response will also not be negatively impacted because the substantive issues presented in the present Petition are identical to the issues presented in the 383 Proceeding. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the petition in the 383 Proceeding. Also, because the present Petition relies on the same expert declarations, no extra depositions are needed for the proposed joined proceeding.

Accordingly, joinder with the 383 Proceeding does not unduly burden or negatively impact the trial schedule.

D. Procedures to Simplify Briefing and Discovery

EndyMed explicitly agrees to take an “understudy” role, which will simplify briefing and discovery. Specifically, EndyMed agrees, upon joining the 383 Proceeding, that the following conditions, as previously approved by the Board in similar circumstances, shall apply, so long as Jeisys remains an active party:

- a) EndyMed will join all of Jeisys’s filings and oral arguments in the 383 Proceeding, unless a filing or oral argument concerns issues

solely involving EndyMed;

- b) EndyMed shall not be permitted to raise any new grounds not instituted by the Board in the 383 Proceeding, or introduce any argument or discovery not introduced by Jeisys;
- c) EndyMed shall be bound by any agreement between Patent Owner and Jeisys concerning discovery and/or depositions; and
- d) EndyMed at deposition shall not request any time for direct, cross examination or redirect, beyond that permitted under 37 C.F.R. § 42.53 or any other agreement between Patent Owner and Jeisys.

See Mylan Pharmaceuticals Inc. v. Novartis AG, IPR2015-00268, Paper No. 17, at 5 (P.T.A.B. Apr. 10, 2015); see also *Xilinx*, IPR2021-00633, Paper 15, at 16 (the Board granting joinder on the basis that “Petitioner ‘explicitly agrees’ that it will take an ‘understudy’ role in the Intel IPR and only assume an active role should Intel cease to participate”). Unless and until Jeisys ceases to participate, EndyMed will not assume an active role in the 383 Proceeding.

Thus, by EndyMed accepting an “understudy” role, the parties can comply with the trial schedule assigned to the 383 Proceeding without needing any duplicative efforts by the Board or Patent Owner. These steps minimize the possibility of any complication or delay from joinder. *See Sony*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because “joinder would

increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” where petitioners agreed to an “understudy” role). EndyMed is further willing to agree to any other reasonable conditions the Board deems necessary to permit joinder.

IV. CONCLUSION

Joinder will not affect the substance, procedure, or scheduling of the 383 Proceeding. EndyMed files this motion under the statutory joinder provisions as contemplated by the AIA. Joinder will simplify the issues and promote efficiency, justice, and speed.

For the foregoing reasons, Petitioners EndyMed respectfully requests joinder as a party to the IPR, *Jeisys Medical Inc. v. Serendia, LLC*, Case No. IPR2024-00383.

Respectfully submitted,

Dated: August 1, 2024

By: / Guy Yonay /
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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), I hereby certify that a complete copy of the attached Petitioners' Motion for Joinder is being served via Priority Mail Express on August 1, 2024, the same day as the filing of the above-identified document in the United States Patent and Trademark Office with the Patent Trial and Appeal Board, on the Patent Owner at the following correspondence address of record as listed in the USPTO Patent Center:

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