Filed on behalf of: Serendia, LLC

Entered: September 27, 2024

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.

Case IPR2024-00845
Patent 10,869,812

PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION FOR JOINDER

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Exhibit List

Exhibit	Description
2001	Summons in a Civil Action, *Serendia, LLC v. EndyMed Med., Inc.*, No. 1:23-cv-00224 (D. Del. Mar. 16, 2023), ECF No. 6

Patent Owner Serendia, LLC ("Serendia") opposes Petitioners' EndyMed Medical Ltd. and EndyMed Medical, Inc. (collectively, "Petitioners") Motion to Join *Jeisys Medical Inc. v. Serendia, LLC*, IPR2024-00463 ("the 463 Proceeding"), which the Board recently instituted on U.S. Patent 10,869,812 ("the '812 Patent").

"Joinder may be authorized when warranted, but the decision to grant joinder is discretionary." *Sony Corp. of Am. V. Network-1 Sec. Sols., Inc.*, IPR2013-00386, Paper 16 at 3 (P.T.A.B. July 29, 2013) (citations omitted). As moving parties, Petitioners have the burden to establish that they are entitled to such discretionary relief. 37 C.F.R. §§ 42.20(c), 42.122(b). Petitioners have not met that burden.

First, Petitioners fail to explain their unreasonable and unjustifiable delay in filing their IPR petition and seeking joinder. Petitioners have been aware of the '812 Patent since at least March 1, 2023, when Serendia filed a complaint in the International Trade Commission, seeking institution of an investigation pursuant to Section 337 of the Tariff Act of 1930, in which Serendia asserted that Petitioners and others infringe several of its patents, including the '812 Patent. Compl., *Certain Dermatological Treatment Devices & Components Thereof*, No. 337-TA-1356 (Mar. 1, 2023) ("the 337-TA-1356 Investigation"). Nowhere in its Motion for Joinder do Petitioners explain why they waited not only more than a year after being aware of the '812 Patent, but also more than 7 months since their co-

Respondents in the 337-TA-1356 Investigation filed their own IPR petition on the same patent. Importantly, should Petitioners' Motion for Joinder be denied, their IPR Petition would be timed-barred under Section 315(b) based on Serendia's district court action asserting the same '812 Patent against Petitioners, the complaint for which was served on March 14, 2023. *See* Ex. 2001, Summons, *Serendia, LLC v. EndyMed Med., Inc.*, No. 1:23-cv-00224 (D. Del. Mar. 16, 2023) ("Delaware Litigation").

Second, the Board should exercise its discretion to deny joinder and institution under *Apple Inc. v. Fintiv, Inc*., IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) ("*Fintiv*"). Granting joinder under 35 U.S.C. § 315(c) requires two decisions, both of which are subject to the Director's discretion: "whether the joinder applicant's petition for IPR 'warrants' institution under § 314[]" and "whether to 'join as a party' the joinder applicant." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). Thus, the Board must consider whether to exercise discretion to deny Petitioners' petition before granting institution, and under *Fintiv*, the Board considers the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;

3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, IPR2020-00019, Paper 11 at 5-6.

As to factor 1, because the Delaware Litigation is stayed pending a decision from the 337-TA-1356 Investigation, there is no evidence one way or another whether the court would grant a stay if joinder were granted and no trial date has been set. Therefore, factor 1 is neutral. As to factor 2, after a decision from the 337-TA-1356 Investigation, the Delaware Litigation will resume, and a scheduling order will issue. Petitioners fail to contemplate this eventuality and provide no analysis aside from contending, without evidence, that a final written decision will issue "long before any … litigation would go to trial[.]" Pet. 86. This is insufficient to carry Petitioners' burden, and thus at worst, factor 2 is neutral. Nonetheless, because the Delaware Litigation involves the same parties and the same '812 Patent subject to Petitioners' IPR Petition and Motion for Joinder, much of the investment and efforts that will be spent to litigate the issues in the Delaware Litigation have already been undertaken in the 337-TA-1356 Investigation. Thus,

factors 3, 4, and 5 all favor of denial of institution/joinder. And, here, where Petitioners have ***not*** stipulated that they will not pursue "the same grounds as in the petition or any grounds that could have reasonably been raised in the petition[]" in the Delaware Litigation should their joinder motion be granted, factor 4 weighs even more heavily in favor of denial of institution and joinder. *See* Katherine K. Vidal, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation at 7 (June 21, 2022)[1] ("*Fintiv* Mem."). Petitioners merely contend that "if EndyMed joins the 463 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)[]" (Mot. 3), but this will not "simplify and expedite the potential issues in the co-pending district court action" as Petitioners contend (*id.*), and will do nothing to "mitigate[] concerns of potentially … duplicative efforts." *Fintiv* Mem. at 7.

With *Fintiv* factors 1-5 favoring discretionary denial or being neutral, the Board then must assess the challenges presented by the petition under a compelling merits standard, rather than under the lower reasonable likelihood of prevailing standard. *Commscope Techs. LLC v. Dali Wireless, Inc*., IPR2022-01242, Paper

[1] https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

23 at 6 (P.T.A.B. Feb. 27, 2023) (precedential). As Director Vidal explained, "it is only a finding under this higher standard that would compel the Board to review claims for the public benefit when other considerations favor discretionary denial." *Id*. at 4. And "the Board *shall* provide its reasoning in determining whether the merits are compelling." *Id*. (original emphasis) (citation omitted).

Nothing in Petitioners' joinder motion addresses, much less supports, that their Petition presents compelling evidence of unpatentability. Instead, Petitioners merely contend the petition "presents exceptionally compelling evidence of unpatentability" based on the Board's finding in the 463 Proceeding that Jeisys had shown a reasonable likelihood of prevailing. Pet. 84-85. But the "compelling merits" standard is **higher** than the "reasonable likelihood of prevailing" standard the Board used to analyze the IPR petition in the 463 Proceeding. Satisfaction of the latter is insufficient to meet the higher threshold. And importantly, Serendia has not yet had its opportunity to file its Patent Owner Preliminary Response ("POPR") to Petitioners' petition, in which Serendia intends to address the Board's preliminary findings in its Institution Decision in the 463 Proceeding to further show there is no compelling evidence of unpatentability.

For all these reasons, Serendia submits joinder is not proper and Petitioners have failed to meet their burden to show otherwise.

Respectfully submitted,

Dated: September 27, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 27th day of September, 2024, a true and correct copy of the foregoing **Patent Owner's Opposition to Petitioners' Motion for Joinder and Exhibit 2001** were served by electronic mail on Petitioners' lead and backup counsel at the following email addresses:

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