

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.

IPR2024-00843 (Patent 9,775,774 B2)
IPR2024-00844 (Patent 9,320,536 B2)
IPR2024-00845 (Patent 10,869,812 B2)¹

Before SHERIDAN K. SNEDDEN, CARL M. DEFRANCO, and
TINA E. HULSE, *Administrative Patent Judges*.

DEFRANCO, *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)

¹ This decision addresses issues that are the same in each of the above-listed proceedings. We issue one decision to be entered in each proceeding. The parties are not authorized to use this heading style in any subsequent papers.

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I. INTRODUCTION

This is a consolidated decision for IPR2024-00843 (“the 843 IPR”), IPR2024-00844 (“the 844 IPR”), and IPR2024-00845 (“the 845 IPR”). EndyMed Medical Ltd. and EndyMed Medical, Inc. (“EndyMed”) filed separate petitions for *inter partes* review of claims 1–20 of U.S. Patent 9,775,774 B2 (“the ’774 patent”) in the 843 IPR, claims 1–9 and 11–19 of U.S. Patent 9,320,536 B2 (“the ’536 patent”) in the 844 IPR, and claims 1–20 of U.S. Patent 10,869,812 B2 (“the ’812 patent”) in the 845 IPR. *See* Paper 1 (“Pet.”).² In due course, Serendia, LLC (“Serendia”), as owner of the three challenged patents, filed a preliminary response to each petition that included public and confidential versions.³ *See* Papers 11, 12, respectively (“Prelim. Resp.”). Serendia also filed statutory disclaimers of claims 1–12 and 15–20 of the ’774 patent, claims 9 and 19 of the ’536 patent, and claims 1, 7, 10–12, 17, 19, and 20 of the ’812 patent.

Concurrently with the petitions, EndyMed filed a motion for joinder, seeking joinder with previously-instituted *inter partes* reviews of the ’774, ’536, and ’812 patents, namely, *Jeisys Medical Inc. v. Serendia, LLC*, IPR2024-00383 (“the 383 IPR”), IPR2024-00384 (“the 384 IPR”), and IPR2024-00463 (“the 463 IPR”). *See* Paper 2 (“Pet. Mot.”). Serendia filed an opposition to joinder. *See* Paper 8 (“PO Opp.”). EndyMed followed with a reply in support of joinder. *See* Paper 9 (“Pet. Reply”).

² We refer only to papers and exhibits in the 843 IPR, but note that similar papers and exhibits were also filed in the 844 and 845 IPRs.

³ Unless otherwise noted, this decision refers to the public version.

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Exercising our jurisdiction under 35 U.S.C. § 314(a), we institute *inter partes* review of claims 13 and 14 of the '774 patent, which are the only challenged claims remaining for review as a result of Serendia's statutory disclaimer. We also grant EndyMed's motion for joinder, join EndyMed to the 383 IPR, and terminate the 843 IPR.

As for the other two related proceedings, the 844 and 845 IPRs, we see no material difference in the arguments and evidence submitted by EndyMed and Serendia with respect to at least the anticipation ground asserted across all three proceedings. Nor do we detect any material difference in the parties' arguments with respect to EndyMed's joinder motion. Thus, while we limit our analysis below to the 843 IPR, it applies equally to the 844 and 845 IPRs. That said, we also institute *inter partes* review of claims 1–8 and 11–18 of the '536 patent and claims 2–6, 8, 9, 13–16, and 18 of the '812 patent, which are the claims remaining for review after Serendia's statutory disclaimer of the other challenged claims in each of those proceedings. We also grant EndyMed's motion for joinder, join EndyMed to the 384 and 463 IPRs, and terminate the 844 and 845 IPRs.

II. BACKGROUND

A. Related Matters

This is EndyMed's first (and only) petition challenging the '774 patent. However, as noted above, another entity, Jeisys Medical Inc. ("Jeisys"), filed an earlier petition on which we granted institution of *inter partes* review. See 383 IPR, Paper 17 (Institution Decision, entered July 22, 2024). The '774 patent was also the subject of another petition on which we denied institution, namely, *Cartessa Aesthetics, LLC v. Serendia, LLC*,

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IPR2022-00376, Paper 9 (Decision Denying Institution, entered June 27, 2022).

The '774 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* Paper 7; *see also* Prelim. Resp. 3–4. The respondents in the ITC proceeding include Cartessa, Jeisys, EndyMed, and numerous other entities.

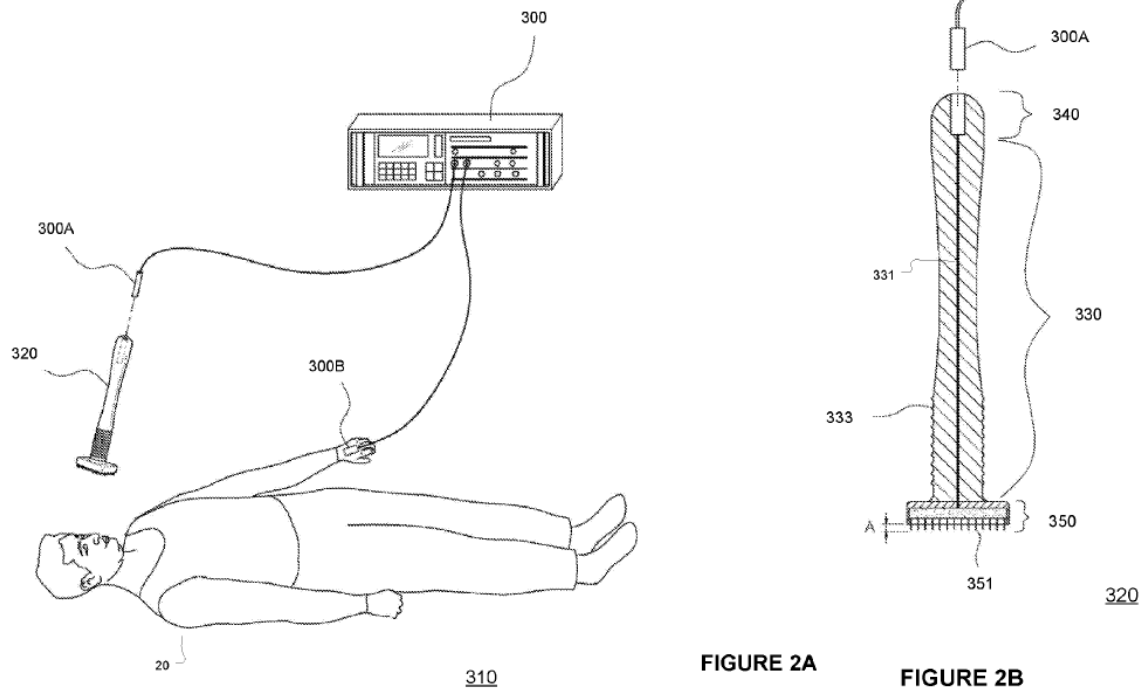
The '774 patent is also the subject of several federal district court actions, some of which are stayed pending the outcome of the ITC proceeding and some of which have been dismissed—

- *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 7.

B. The '774 Patent

The '774 patent is directed to a system and method “used in treating dermatological tissue.” Ex. 1001, 1:30–32. Figures 2A and 2B of the '774 patent, reproduced below, depict dermatological treatment apparatus 310.



As shown in Figures 2A and 2B, dermatological treatment apparatus 310 includes acupuncture device 320 and signal generator 300 electrically coupled to the device via one or more wires 300A. *Id.* at 3:38–45. Notably, acupuncture device 320 is provided with a plurality of acupuncture needles or pins 351. *Id.* at 3:45–54.

In operation, electrical signal generation system 300 produces electrical signals “to vibrate one or more pins 351 electrically coupled to the system 300 . . . [to] increase the micro-wound or cut formed in dermis by the pin 351.” *Id.* at 3:55–60, 4:1–15. Pins 351 may be fixed in place, as

depicted in Figure 2B above, or moveable between a retracted position and a deployed position, as depicted below in Figures 9C and 9D, respectively.

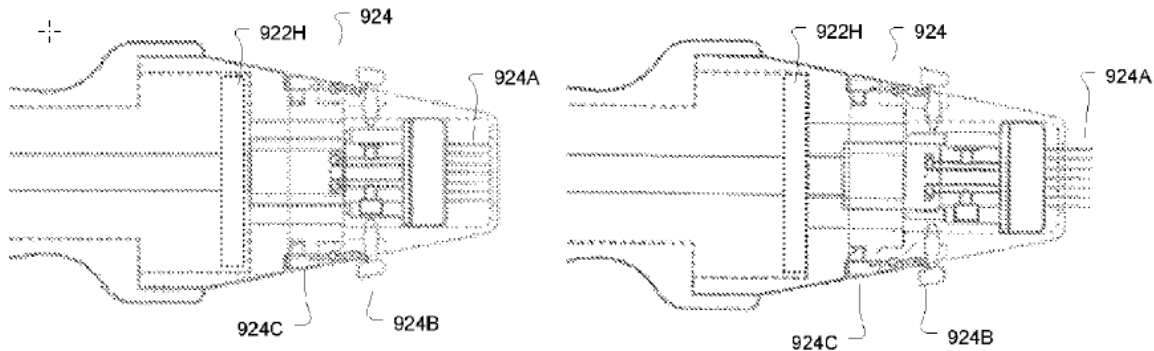


FIGURE 9C

FIGURE 9D

Figure 9C depicts dermatological treatment apparatus 924 with needles 924A retracted, and Figure 9D depicts the apparatus with needles 924A deployed, i.e., extended. *See id.* at 2:28–33, 3:45–52, 10:31–11:31.

C. Challenged Claims

As mentioned above, only dependent claims 13 and 14 of the '774 patent remain subject to review. They are reproduced below along with their base claims 11 and 12:

11. An apparatus for treating dermatological tissue, comprising:

a device including a plurality of needles one of extending or extendable a desired distance from a surface, the desired distance selected to enable the plurality of needles to penetrate dermatological tissue; and

a signal generator electrically coupled to the plurality of extended needles to produce pulsed radio frequency signals across the plurality of needles to affect dermatological tissue near the plurality of needles.

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12. The apparatus for treating dermatological tissue of claim 11, wherein the device includes an end surface configured to be placed on or near dermatological tissue to be treated, the end surface including *a plurality of needles extendable a desired distance from the end surface*.

13. The apparatus for treating dermatological tissue of claim 12, further including a mechanism for causing *the plurality of the extendable needles to extend a desired distance from the end surface*.

14. The apparatus for treating dermatological tissue of claim 12, further including a motor coupled to the plurality of extendable needles that may be directed to cause *the plurality of the extendable needles to extend a desired distance from the end surface*.

Ex. 1001, 16:34–57 (emphases added).

D. Asserted Challenges of Unpatentability

Claims Challenged	35 U.S.C. §	Basis
13, 14	102	Mehta ⁴
13, 14	103	Mehta and Lee ⁵

In further support of these challenges, EndyMed relies on the declaration of Jean Woloszko, Ph.D. (Ex. 1025). Serendia submits rebuttal declarations from Peter Crosby (Ex. 2147) and Vincent A. Thomas (Ex. 2124).

⁴ US 8,608,737 B2, issued Dec. 17, 2013 (Ex. 1004, “Mehta”).

⁵ Korean Registered Utility Model No. KR20-0441552, published Aug. 25, 2008 (Ex. 1010 (original), Ex. 1011 (certified translation), “Lee”).

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III. ANALYSIS

A. Threshold for Institution

In the 383 IPR, we instituted an *inter partes* review of claims 13 and 14 of the '774 patent based on the same claims and grounds of unpatentability as EndyMed asserts here, namely, anticipation by Mehta and obviousness over Mehta and Lee. *Compare* 383 IPR, Paper 17, at 6, with Pet. 4, 43, 64–70. In asserting these grounds, EndyMed represents that the petition here “is identical in all material respects to the petition filed in instituted IPR2024-00383.” Pet. 1. EndyMed also represents that it relies on the same expert declaration as does Jeisys in the 383 IPR. *See id.* (representing that Exhibit 1025 is the same as Exhibit 1025 added in the 383 IPR).

Serendia does not dispute that EndyMed’s petition here is substantially the same as Jeisys’s petition in the 383 IPR. Instead, Serendia contends that the preliminary response here “raise[s] new issues and evidence not yet considered . . . in the Jeisys cases.” Ex. 3001 (email from counsel for Serendia to the Board, dated Dec. 16, 2024). Although we acknowledge that Serendia’s preliminary response raises *some* additional evidence that was not submitted with the preliminary response in the 383 IPR, we disagree that the preliminary response raises any “new issues.” That is because, from our comparison, the preliminary response here presents substantially the same arguments as those presented in Serendia’s preliminary response in the 383 IPR.

For instance, Serendia proposes the same claim constructions here as it does in the 383 IPR. *Compare* Prelim. Resp. 16–26 (arguing constructions

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for “desired distance,” “pulsed radio frequency signals,” and “mechanism”), *with* 383 IPR, Paper 11, 33–39 (same). Serendia also makes essentially the same arguments with respect to the Mehta-based anticipation ground as it does in the 383 IPR. *Compare* Prelim. Resp. 32 (“[T]he claims require using a mechanism/motor to extend the needles to a programmed distance. . . . Mehta never discloses any kind of programming to determine how far the needles extend from the device’s end surface.”), *with* 383 IPR, Paper 11, 49 (“There is no disclosure in Mehta of programming the distance that the needles extend.”). And, just as it does for the obviousness ground in the 383 IPR, Serendia argues here a lack of a reason to combine Mehta and Lee. *Compare* Prelim. Resp. 40 (“Even assuming Mehta and Lee relate to ‘similar technologies,’ that merely supports that they *could* be combined; it is not a *reason* to do so.”), *with* 383 IPR, Paper 11, 53 (“But even assuming Mehta and Lee relate to ‘similar technologies,’ that merely supports that they *could* be combined; it is not a *reason* to do so.”). Finally, here and in the 383 IPR, Serendia posits the same objective indicia of nonobviousness—“commercial success” and “industry praise”—and argues that the petitioner ignores it. *Compare* Prelim. Resp. 49 (“Despite being aware of the substantial evidence of secondary considerations, EndyMed and its expert disregard it.”), *with* 383 IPR, 60 (“Specifically, despite being aware of the substantial evidence of secondary considerations, Petitioners and their expert completely ignore it.”).

As for the new evidence, we acknowledge that Serendia’s preliminary response here cites exhibits that were not submitted with the preliminary response in the 383 IPR, namely, Exhibits 2038, 2039, 2079, 2147, and

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2149–2154. But, of those exhibits, only two are relevant to the anticipation ground on which we instituted trial in the 383 IPR—the declaration of Serendia’s expert, Dr. Crosby (Ex. 2147) and the deposition transcript of EndyMed’s expert, Dr. Woloszko (Ex. 2154). We have considered Serendia’s citations to the deposition transcript of Dr. Woloszko, but, at this stage, do not find them persuasive when read in the context of the surrounding testimony. *See* Prelim. Resp. 34, 36, 38 (citing Ex. 2154). As for the citations to Dr. Crosby’s declaration (Ex. 2147), only paragraphs 102 and 103 are newly submitted. The other citations to Dr. Crosby’s declaration, i.e., paragraphs 101 and 105–107, correspond to paragraphs of Dr. Crosby’s declaration that we already considered in the 383 IPR. *Compare* Ex. 2147 ¶¶ 101, 105–107, *with* 383 IPR, Ex. 2123 ¶¶ 81, 82–84, respectively. And, in reviewing new paragraphs 102 and 103 of Dr. Crosby’s declaration, we do not consider them particularly helpful at this stage.

More importantly, as shown in the above comparison, the underlying premise of Serendia’s arguments here and in the 383 IPR remains substantially the same. Thus, for the same reasons discussed in our decision instituting the 383 IPR, we find that EndyMed demonstrates a *reasonable likelihood* of prevailing with respect to at least one of challenged claims 13 and 14 of the ’774 patent. *See* 383 IPR, Paper 17, 11–18. 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.

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B. Joinder

In seeking joinder, EndyMed represents that the instant petition “is identical in all materials respects” to the petition in the 383 IPR, “differing only in party specific facts and formalities in Sections II–IV and X.” Mot. 1. EndyMed explains that it is filing the petition and seeking joinder with the 383 IPR “to allow a petitioner to remain in order to complete trial in the event Jeisys [the petitioner in the 383 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 383 Proceeding.” *Id.*; *see also id.* at 8–9 (same).

At the outset, we note that EndyMed’s concern with a potential settlement in the 383 IPR has come to fruition. Jeisys and Serendia have reached a settlement resolving their dispute over the ’774 patent and have jointly requested termination of the 383 IPR. *See* 383 IPR, Paper 31 (“Joint Motion to Terminate *Inter Partes* Review”). Thus, it appears EndyMed would necessarily assume an active role in the 383 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.

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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)).

Here, there is no dispute that EndyMed’s petition is materially identical to the petition in the 383 IPR. Instead, Serendia argues that joinder should be denied due to EndyMed’s “unreasonable and unjustifiable delay” in filing the petition and seeking joinder with the 383 IPR, despite being aware of the ’774 patent and Jeisys’s petition for “more than 7 months” before filing. PO Opp. 1–2. We disagree. 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 383 IPR. *See* 37 C.F.R. § 42.122(b); *see also* 37 C.F.R. §§ 1.7(a), 42.1(a). Indeed, per our rules, 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

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of Serendia’s complaint alleging infringement of the ’774 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. And because a *Sotera* stipulation mitigates concerns of duplicative efforts, we decline to discretionarily deny 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 joinder on the basis of the parallel Delaware litigation.⁶

Also, to the extent Serendia contends EndyMed should not be permitted to join and continue an IPR 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 ’774 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

⁶ To the extent Serendia also relies on duplicative efforts with the pending ITC investigation, the Director has expressly stated that the Board “will not” discretionarily deny a petition based on a parallel ITC proceeding. *See* Director Memo, at 7.

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same petitioner had filed multiple petitions against the same patent. In contrast, permitting joinder here will ensure that the 383 IPR is not prematurely terminated based on an opportunistic settlement by Serendia with fewer than all the parties against which Serendia has asserted the '774 patent.

Moreover, as explained above, EndyMed's petition includes no new grounds of unpatentability and is materially identical to Jeisys's petition in the 383 IPR. And, in seeking joinder, EndyMed agrees to abide by the scheduling order presently set in the 383 IPR.⁷ *See* Mot. 7–8. EndyMed also agrees to rely primarily on Jeisys's filings and arguments, unless Jeisys ceases to participate in the 383 IPR, which is likely to occur given the pending motion to terminate Jeisys as a petitioner in the 383 IPR. Then, at least, there would no longer be concerns of 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 843 IPR to the 383 IPR. And, for the same reasons, we grant EndyMed's motion to join the 844 and 845 IPRs to the 384 and 463 IPRs, respectively.

⁷ 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).

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IV. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review of claims 13 and 14 of the '774 patent, claims 1–8 and 11–18 of the '536 patent, and claims 2–6, 8, 9, 13–16, and 18 of the '812 patent is hereby *instituted*;

FURTHER ORDERED that EndyMed's motion for joinder in each of the IPR2024-00843, -00844, and -00845 IPRs is hereby *granted*;

FURTHER ORDERED that the IPR2024-00843 is joined to IPR2024-00383, that IPR2024-00844 IPR is joined to IPR2024-00384, and that IPR2024-00845 is joined to IPR2024-00463;

FURTHER ORDERED that IPR2024-00843, -00844, and -00845 are hereby *terminated*;

FURTHER ORDERED that, unless notified otherwise, the scheduling order currently in effect in IPR2024-00383, -00384, and -00463 shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceedings are to be made only in IPR2024-00383, -00384, and -00463;

FURTHER ORDERED that EndyMed Medical Ltd. and EndyMed Medical, Inc. shall be added as petitioners to the case caption in IPR2024-00383, -00384, and -00463 for all further submissions, an example of which is attached to this Decision;⁸ and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2024-00383, -00384, and -00463.

⁸ The caption shall be modified in the event the Board terminates Jeisys Medical Inc. as a petitioner in IPR2024-00383, -00384, and -00463.

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[Sample Case Caption]

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⁹ The Board, in IPR2024-00843, joined EndyMed Medical Ltd. and EndyMed Medical Inc. as petitioners to this proceeding.