UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EUNSUNG GLOBAL CORP.,
Petitioner,

v.

HYDRAFACIAL LLC,
Patent Owner.

Case No. IPR2024-01491

Patent No. 11,865,287

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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I. THE EXAMINER CONSIDERED AND REJECTED THE SAME OR SUBSTANTIALLY THE SAME ART

The Petition acknowledged that 325(d) is in play, but decided to forego the required *Advanced Bionics* analysis. Pet., 95; POPR, 61. Now, with a second bite, Eunsung still does not—and cannot—counter HydraFacial's evidence that the Board should deny institution under 325(d). POPR, 61-70.

Eunsung argues that Palmer differs materially from Greenberg because Palmer teaches "liquid solutions." Reply to POPR ("RTP"), 1. But this overlooks that Palmer's liquid solutions are "pulsed jet" dental irrigants for oral tissue, not skin treatments. POPR, 22-23. Disclosing dental irrigants does not make Palmer more relevant than Greenberg, which specifically addresses skin treatment, nor does it establish greater compatibility with Karasiuk, which relates to skin treatment. Palmer's focus on periodontal irrigation makes its motivations distinct and its disclosure no better than Greenberg's microdermabrasion system. *Id*., 38-42.

Eunsung argues that Trueba was considered and is not cumulative. RTP, 1-2. But Eunsung does not refute that Trueba fails to address the limitations missing from Karasiuk and Palmer (Ground 1B) or Greenberg (Ground 2B). POPR, 65.

Eunsung asserts that Greenberg discloses particles, while Coleman uses a "'dry' abrasive." RTP, 2-3. This is wrong and only highlights Eunsung's misunderstanding of the art. Greenberg discloses an apparatus "using ***abrasive***

particles" and emphasizes that they must be "sufficiently ***dry***." EX1006, ¶¶ 2, 69-71. Coleman's particles are not materially different from Greenberg's.

Thus, the Petition relied on the same or substantially the same art previously presented to the Office. This satisfies the first step of *Advanced Bionics*, and the Board need not address Eunsung's arguments regarding whether the same or substantially the same arguments were presented.

II. THE EXAMINER DID NOT ERR IN ANALYZING THE ART

Eunsung argues that the Examiner overlooked the teachings of Palmer and Greenberg on the sequential delivery of multiple pre-mixed treatment fluids. RTP, 3. Even if this were true, Eunsung does not explain how these teachings would have affected the Examiner's patentability assessment.

As the RTP notes, the Examiner stated that "[i]t would not be obvious to modify Coleman to function as claimed because Coleman discloses that the treatment materials are delivered together/mixed." *Id*. (citing EX1002, 202). Coleman's system could not have delivered the materials sequentially because, as the Examiner explained, "water is necessary to deliver[] the abrasive material." EX1002, 202. Without the water, the particles could not be delivered to abrade skin; without the particles, the plain water solution would not abrade skin. *Id*. The system achieves its delivery through opening valves that "form a composite stream of water/abrasive/medicine to the probe." EX2011, [0060]; *see also id*., claims 5

("applying a benign abrasive to said stream of water"), 11 ("means for applying a benign abrasive to water from said nozzle").

Eunsung provides no rationale for why Palmer (disclosing dental irrigants for oral tissue) and Greenberg (disclosing a dry-particle microdermabrasion system) would have motivated a POSITA to change Coleman's approach by stopping mixing of its treatment materials and instead delivering them sequentially. In fact, Coleman teaches away from sequential delivery. As the Examiner noted, sequential delivery "would not provide the intended effect." EX1002, 202. Delivering sterile water alone would not abrade the skin, just as water is essential for delivering the abrasive. *Id*.

Eunsung further asserts that the Examiner overlooked similar teachings in Trueba. RTP, 3. However, this assertion tries to rewrite the Petition, which did not rely on Trueba to address the limitations missing from Karasiuk and Palmer (Ground 1B) or Greenberg (Ground 2B). POPR, 65.

Eunsung also argues that the Examiner erred in overlooking the '287 patent's broad definition of "fluid" and "treatment material" when analyzing Coleman. RTP, 3. This argument is wrong. The Examiner correctly interpreted these terms as referring to a liquid rather than exclusively dry particles. The Petition, not the Examiner, erred in applying an overly broad interpretation.

The Board should exercise its discretion to deny institution.

III. SECONDARY CONSIDERATIONS SUPPORT PATENTABILITY

Eunsung challenges two points regarding HydraFacial's nexus: (1) that HydraFacial Systems embody and are coextensive with the claimed inventions, and (2) that the objective indicia result directly from the HydraFacial Systems' unique and claimed ability to selectively apply multiple treatment fluids drawn from separate containers. RTP, 4. Eunsung is mistaken in both challenges.

Eunsung first argues that HydraFacial's assertion that its Systems practice the claims contradicts its argument that Palmer does not disclose a handpiece "connected to the console." *Id*. Not so. A simple inspection of images of the Systems confirms that the handpiece connects to the console. EX2001, ¶¶ 111-112. In contrast, Palmer's handpiece connects only to the modular portable control unit enclosure, not the mobile cart that Eunsung asserts is the console. POPR, 25-31.

Eunsung attacks the nexus between the commercial success of the commercial embodiments and the claimed novel feature. RTP, 5-7. But the POPR's argument compares the success of two products sold by the same company, for the same purpose, where only one embodies the claimed novel feature. POPR, 52-55. Eunsung tries to impose an unattainable burden in showing secondary considerations. However, when a product is coextensive with the claimed features, as here, a nexus between the objective indicia and a novel feature of the claimed invention is presumptively attributed to the patented invention. *Muniauction, Inc. v.*

Thomson Corp., 532 F.3d 1318, 1328 (Fed. Cir. 2008) (citation omitted). Specifically, Eunsung argues that several unclaimed product features may contribute to the product's success. RTP, 5-7. This argument is factually flawed.

First, certain of Eunsung's allegedly unclaimed features are indeed claimed in the '287 patent. For example, the claims recite a vacuum source (EX1001, claims 1, 11, 22, 26, 37), which performs the identified "vacuum therapy" (RTP, 5). Various dependent claims recite a touchscreen (EX1001, claims 6, 19, 32, 43), which is essentially the "intuitive touchscreen with built-in treatment protocols" (RTP, 5).

Second, Eunsung identifies features that were available on both the HydraFacial Nectre and HydraFacial Systems, and therefore cannot be responsible for the relative commercial success of the HydraFacial Systems over the Nectre. For example, Eunsung references various handpiece features, including a "patented disposable HydroPeel™ tip," "patented diamond abrasion tip," "unique spiral design," "spiral shaped tip design," "skin interface with inflow and outflow apertures," "skin interface with abrading structure," "skin interface with a plurality of ridge elements," and "outer periphery configured to contact a skin surface." *Id*., 5-6. These features were incorporated into the Nectre's handpiece. *See, e.g.*, EX2035, 11; EX2037, 8. Similarly, Eunsung references the use of "active serums" and a "patented Vortex-Fusion® serum delivery system." RTP, 5. However, the Nectre and HydraFacial Systems used the same serums and combination of a spiral

tip and vacuum therapy. *See, e.g.*, EX2035, 11-12, 17-18; EX2037, 6. Also, like those HydraFacial Systems, the Nectre had a "small footprint" and was "easy to use" and "profitable" for clinicians. *See, e.g., id*.

Third, Eunsung identifies the feature of "simultaneous exfoliation, extraction, cleaning and hydration." RTP, 5 (citing EX2039, 1) (emphasis omitted). This feature simply describes the operations during a single treatment with the HydraFacial System. But the ability to use multiple serums in a single treatment is the thrust of the '287 patent's claimed invention. POPR, 5. Indeed, the Nectre also provided exfoliation, extraction, cleaning, and hydration, but the user could not perform these functions in a single treatment without the operator changing out fluid containers to perform the different functions. EX2035, 6 (Nectre Owner's Manual: "The process removes dead skin cells and impurities while simultaneously infusing new skin with cleansing, hydrating and moisturizing serums & antioxidants.").

Fourth, Eunsung identifies the "Blue & Red / Infrared LED light" feature and acknowledges the POPR discussed it. RTP, 5. Rather than directly refuting HydraFacial's explanation that this feature was ancillary, achievable with less expensive devices, and that the HydraFacial Systems were not marketed as light therapy systems (POPR, 52), Eunsung tries to downplay the significance of HydraFacial's declarant testimony (RTP, 5).

Eunsung also alleges that the invention of the ’287 patent (e.g., selecting treatment fluids from multiple containers) is absent from HydraFacial’s marketing materials. *Id*., 6. However, the exhibit page cited by Eunsung in the sentence preceding its allegation contradicts this assertion. *Id*., 5-6. The exhibit touts that because a HydraFacial System is “[e]quipped with […] four serum ports[] and serum port toggles, operation is simple and easy.” EX2047, 1. Other materials also highlight the feature. EX2042, 1 (“[T]he HydraFacial™ is the only machine of its kind that uses the 4-in-1 technology.”); EX2022, 1 (“device that carries out a patented three-part regimen”); EX2046, 1; EX2041, 4.

Finally, Eunsung offers only a conclusory analysis in its attempt refute the POPR’s evidence of copying and industry praise. RTP, 6-7. Eunsung acknowledges that HydraFacial’s patents covering handpiece features were asserted against a party. *Id*. However, Eunsung fails to address that the party sold a knock-off system practicing the ’287 patent’s claimed inventions or that the specific industry praise indeed related to the claimed inventions as the POPR explained. *Id*. Such a conclusory analysis is not enough to rebut the strong evidence of non-obviousness.

Thus, secondary considerations support patentability and underscore the need to guard against Eunsung’s hindsight bias reflected in the Petition. Given the Petition’s weak obviousness case, the Board should deny institution further based on these considerations.

Respectfully Submitted,

Dated: February 21, 2025

/ Benjamin B. Anger /
Benjamin B. Anger (Reg. No. 62,207)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), I certify that on February 21, 2025, a copy of this **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served via the email correspondence address of record for Petitioner's counsel of record:

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