

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EUNSUNG GLOBAL CORP.,
Petitioner,

v.

HYDRAFACIAL LLC,
Patent Owner.

Case IPR2024-01491
Patent 11,865,287

**PETITIONER’S REPLY TO PATENT OWNER’S SUPPLEMENTAL BRIEF ON
IMPACT OF RECISSION OF JUNE 2022 MEMORANDUM ON
DISCRETIONARY DENIAL**

EXHIBITS

- EUNSUNG-1001 U.S. Pat. No. 11,865,287 to Ignon (“the ’287 patent”)
- EUNSUNG-1002 Excerpts from the Prosecution History of the ’287 patent (“the Prosecution History”)
- EUNSUNG-1003 Declaration of Mr. Eric Simon
- EUNSUNG-1004 U.S. Patent Publication No. 2003/0212415 (“Karasiuk”)
- EUNSUNG-1005 U.S. Patent No. 5,199,604 (“Palmer”)
- EUNSUNG-1006 U.S. Patent Publication No. 2003/0093089 (“Greenberg”)
- EUNSUNG-1007 U.S. Patent No. 6,390,815 (“Pond”)
- EUNSUNG-1008 U.S. Patent No. 6,684,880 (“Trueba”)
- EUNSUNG-1009 U.S. Patent No. 4,512,764 (“Wunsch 1982”)
- EUNSUNG-1010 U.S. Patent Publication No. 2003/0018252 (“Duchon”)
- EUNSUNG-1011 U.S. Patent No. 4,215,476 (“Armstrong”)
- EUNSUNG-1012 Friedman, et al., Chemical peels, dermabrasion, and laser therapy, *Disease-a-Month* 55.4 (2009): 223-235 (“Friedman”)
- EUNSUNG-1013 Burgess, Cheryl M., *Cosmetic dermatology*, Heidelberg, Germany: Springer, 2005 (“Burgess”)
- EUNSUNG-1014 Pickering, J. A., Touch-sensitive screens: the technologies and their application, *International Journal of Man-Machine Studies* 25.3 (1986): 249-269 (“Pickering”)
- EUNSUNG-1015 Friedman, Mark J. et al., The AMSA injection: A new concept for local anesthesia of maxillary teeth using a computer-controlled injection system. *Quintessence Int* 29 (1998): 297-3

(“Friedman 1998”)

- EUNSUNG-1016 Lee, Woan-Ruoh, et al., Lasers and microdermabrasion enhance and control topical delivery of vitamin C, Journal of investigative dermatology 121.5 (2003): 1118-1125 (“Lee”)
- EUNSUNG-1017 U.S. Patent No. 9,550,052 (“the ’052 patent”)
- EUNSUNG-1018 U.S. Patent No. 11,446,477 (“the ’477 patent”)
- EUNSUNG-1019 U.S. Patent No. 6,428,518 (“Brengele”)
- EUNSUNG-1020 U.S. Patent No. 4,559,036 (“Wunsch”)
- EUNSUNG-1021 U.S. Patent No. 6,099,511 (“Devos”)
- EUNSUNG-1022 U.S. Patent No. 5,163,902 (“Lynn”)
- EUNSUNG-1023 U.S. Patent No. 5,190,525 (“Oswald”)
- EUNSUNG-1024 U.S. Patent No. 6,673,082 (“Mallett”)
- EUNSUNG-1025 Rajan, Poonam, et al., Skin barrier changes induced by aluminum oxide and sodium chloride microdermabrasion, Dermatologic surgery 28.5 (2002): 390-393 (“Rajan”)
- EUNSUNG-1026 Karimipour, Darius J., et al., Molecular analysis of aggressive microdermabrasion in photoaged skin, Archives of dermatology 145.10 (2009): 1114-1122 (“Karimipour”)
- EUNSUNG-1027 U.S. Patent No. 6,241,739 (“Waldron”)
- EUNSUNG-1028-1099 [RESERVED]
- EUNSUNG-1100 Email from the Board dated February 7, 2025, authorizing Petitioner to file a response to Patent Owner’s Preliminary Response

- EUNSUNG-1101 ORDER STAYING CASE, Case No. 2:24-cv-00587-TC
(October 3, 2024)
- EUNSUNG-1102 ORDER GRANTING UNOPPOSED MOTION TO STAY
PROCEEDINGS PENDING ITC RESOLUTION, Case No.:
2:24-cv-06250 (October 23, 2024)
- EUNSUNG-1103 ORDER GRANTING JOINT MOTION TO INVOKE THE
STATUTORY STAY OF PLAINTIFF’S CLAIMS, Civil
Action No. 2:24-cv-02480-JPM-tmp (September 11, 2024)
- EUNSUNG-1104 NOTICE OF JOINT MOTION TO STAY THIS ACTION,
Civil Action No. 2:24-cv-4253 (July 19, 2024)
- EUNSUNG-1105 ORDER Granting Motion to Stay, Civil Action No. 2:24-cv-
4253 (August 22, 2024)
- EUNSUNG-1106 GRANTING RESPONDENT EUNSUNG GLOBAL CORP.’S
MOTION TO STAY THE INVESTIGATION, Inv. No. 337-
TA-1408 (October 15, 2024)
- EUNSUNG-1107 Court Opinion Granting Plaintiff’s Motion for Partial Summary
Judgment, *Wirtgen America, Inc., v. United States, et al.*, CIT,
Slip. Op. 20-70, Court No. 20-00027, May 18, 2020
- EUNSUNG-1108 Ken Parker and Daniel Lammie, “Moving Forward in the Face
of an ITC Exclusion Order,” June 2023
- EUNSUNG-1109 INITIAL DETERMINATION GRANTING RESPONDENT
EUNSUNG GLOBAL CORP.’S UNOPPOSED MOTION TO
TERMINATE THE INVESTIGATION BASED ON
CONSENT ORDER, Inv. No. 337-TA-1408 (December 19,
2024)
- EUNSUNG-1110 Transcript, CASE MANAGEMENT CONFERENCE, Inv. No.
337-TA-1408 (December 17, 2024)

EUNSUNG-1111 Transcript, CASE MANAGEMENT CONFERENCE, Inv. No.
337-TA-1408 (September 18, 2024)

Fintiv favors institution. Petitioner, Eunsung Global Corp., is not a party to the ITC proceeding referenced by Patent Owner (“PO”). Although PO recognizes that *Fintiv* applies to “the ***defendant*** in the parallel proceeding,” PO offers no justification for why its ITC litigation with ***Cartessa*** warrants discretionary denial of ***Eunsung’s*** petition. The ***only*** parallel proceeding between Eunsung and PO is a stayed district court case that will not resolve before the present IPR.

Further, PO presumes that rescission of the 2022 Guidance Memo endorses consideration of ITC investigations for *Fintiv* analysis. Not so. The 2022 Memo addressed several issues and its rescission now leaves each open; indeed, the rescission did not state that *Fintiv* applies to administrative ITC proceedings like it does for district court litigation. And good reasons remain for why it should not.

ITC investigations do not ***parallel*** IPRs because invalidity rulings at the ITC carry ***no*** preclusive effect on other forums. *Texas Instr. Inc. v. Cypress Semi. Corp.*, 90 F.3d 1558, 1569 (Fed. Cir. 1996). The Board has explained that the “ITC does not have the authority to invalidate a patent in a way that is applicable to other forums, and thus ITC decisions do not preempt issues addressed in an *inter partes* review.” *Nichia Corp.*, IPR2019-01259, Paper 21, 27 (Jan. 2020). Absent PTAB action, the same invalidity issues will need to be litigated again even if the ITC finds claims invalid. *Id.*, 27-28. Indeed, PO can assert the ’287 patent in other lawsuits in different courts and against other defendants, regardless of the ITC’s

determination. For these reasons, ITC investigations do “not render [an IPR] proceeding duplicative or ... a waste of the Board’s resources.” *Samsung Elecs. Co.*, IPR2018-01410, Paper 14, 18 (Jan. 2019). Thus, *Fintiv* is inapplicable to PO’s sole basis for *Fintiv* denial—its ITC investigation against Cartessa.

a. Eunsung’s district court case is stayed

PO’s district court case against Eunsung is stayed. EX1101. Three other district court cases involving the ’287 patent are also stayed. EX1102 to 1105. And the ITC proceeding was stayed as to Eunsung prior to Eunsung’s termination. EX1106. Because the ITC cannot resolve validity of the ’287 patent in the same manner as the Board, the amount of stayed litigation that can be resolved through this IPR strongly favors institution. Indeed, the Board has found that Factor 1 “weighs strongly against exercising our discretion to deny institution” when, as here, the Petitioner is not a party to the parallel proceeding. *Bose Corp.*, IPR2021-00680, Paper 15, 13-14 (Oct. 2021); *Owens Corning Roofing & Asphalt, LLC v. Kirsch Research & Dev., LLC*, IPR2020-01389, Paper 11 at 11 (Feb. 2021)(“the litigation that involves the Petitioner is stayed, weighing strongly against exercising discretion to deny compared to the other litigations that are not stayed”).

b. Eunsung’s district court case is stayed with no trial date set

Because the ITC cannot invalidate claims, future litigation remains even if the ITC finds the ’287 patent invalid. Indeed, the ’287 patent remains asserted

against Eunsung in a stayed district court proceeding without a set trial date.

Consistent with the goals of the AIA, that litigation necessarily follows the FWD and can be efficiently resolved in this IPR. In these circumstances, the Board has found that Factor 2 “weighs strongly in favor of institution.” *Owens Corning Roofing*, IPR2020-01389, Paper 11, 11; *Bose Corp.*, IPR2021-00680, Paper 15, 14-15; *TCL Industries*, IPR2021-00990, Paper 9, 28-29 (PTAB Nov. 22, 2021).

Even considering the ITC, the time between conclusion of an IPR and a full trade investigation favors the IPR. In contrast to trials, ITC investigations do not conclude with the hearing. An ID will not issue until over three months later (here August 2025). Another four months pass before a FD (here December 2025). Then another 60 days pass for presidential review (here February 2026). Extensions of these due dates are possible and, if an exclusion order is issued, litigation before Customs would be an option. EX1107; EX1108. Given the broader timeline, the Board’s statutory deadline (here April 2026) compares favorably.

c. Investment in the parallel proceeding by the court and the parties

No investment has occurred in Eunsung’s district court case. EX1101. And, because the ITC investigation was stayed as to Eunsung, limited investment related to Eunsung occurred before the ITC. EX1106; EX1110, 17 (“we have not been paying close attention to them, given our status as the stayed Respondent”); EX1111, 7 (“We think we can fight this dispute in a different forum”).

Further, the ITC's ID is not due (August 17, 2025) until over four months after the Board's institution due date (April 15, 2025) with the target date (December 17, 2025) four months later. The Board has refused to exercise discretion in similar circumstances. *3Shape*, IPR2020-00223, Paper 12, 34 n.15 (May 2020); *Wirtgen*, IPR2018-01201, Paper 13, 11-12 (Jan. 2019); *Feit Elec. Co.*, IPR2018-00921, Paper 9, 8-9, 34-35 (Oct. 2018). Further, Petitioner diligently filed its petition less than 3 months after the ITC investigation was instituted.

d. Petitioner's Sotera stipulation prevents overlap

If the Board institutes review, Eunsung agrees to a *Sotera* stipulation in its litigation with PO, which strongly favors institution. Also, to demonstrate overlap, PO submitted excerpts from a supplement validity response filed in October 2024, which does not confirm the grounds that will actually be presented at the ITC hearing. Further, the petition challenges 41 claims, less than half of them being asserted at the ITC with further reduction likely. Because the petition covers at least 21 claims that will not be addressed by the ITC, institution is warranted.

e. The parties are different

Eunsung was terminated from the ITC proceeding. EX1109. PO suggests that Eunsung and Cartessa have a close relationship, but did not submit any evidence to substantiate it. To be clear, Cartessa had no involvement in this IPR. Since being terminated from the ITC investigation, Eunsung has not been involved

in Cartessa's litigation with PO. Eunsung and Contessa are represented by different counsel and neither party controls or funds the other. Eunsung cannot direct or control Cartessa's invalidity case at the ITC, nor can Cartessa direct or control Eunsung's arguments here. For these reasons, the parties do not have a significant relationship for purposes of discretionary denial and Cartessa's presentation of invalidity before the ITC does not represent Eunsung's interest.

f. Other circumstances strongly favor institution

Merits favor institution. PO argues that only one feature is missing from the Karasiuk-Palmer combination and that argument requires a narrow interpretation of "connected to the console" that is misaligned with disclosure in the '287 patent and PO's own product. EX1001, Abstract ("manifold system is coupled to the console"), 6:21-24 ("coupled to the manifold"), 18:6-18; EX2033, 7-8, 10 (waste line connects to waste container sitting on console). For Greenberg, PO's only argument disregards the '287 patent's clear definition of the term fluid to include "a plurality of fine solids." Pet., 69 (citing EX1001, 5:47-52).

Finally, efficient use of Board resources favors institution. Eunsung has filed IPRs (IPR2025-00452, -00453, -00455) of three other patents asserted against it in district court. These IPRs use the same prior art advanced here. It would be most efficient for the Board to consider these IPRs together, which could efficiently resolve several stayed litigations consistent with the goals of the AIA.

Respectfully submitted,

Dated: March 19, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on March 19, 2025, a complete and entire copy of this Petitioner's Reply to Patent Owner's Supplemental Brief on Impact of Recission of June 2022 Memorandum on Discretionary Denial and accompanying exhibits were provided by email, to the Patent Owner, by serving the correspondence addresses of record as follows:

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