

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 MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 AND 42.122(b)**

I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Eunsung Global Corp. (“Eunsung”) respectfully moves to join its *inter partes* review petition involving U.S. Patent No. 11,865,287 (“the ’287 patent”) with the *inter partes* review that Sinclair Pharma Limited et al. (collectively “Sinclair”) have requested for the same patent in *Sinclair Pharma Ltd. et al. v. HydraFacial LLC*, IPR2025-00145 (the “Sinclair IPR”). Because the Board instituted trial in the Sinclair IPR on June 2, 2025, this motion for joinder is timely filed under 37 C.F.R. § 42.122(b).

Joinder is appropriate here: both Eunsung and Sinclair’s petitions present substantively the same patentability challenges, and joinder will not affect the Sinclair IPR trial schedule or require additional board resources to adjudicate. Nor does that result change because the Board previously denied Eunsung’s petition on discretionary grounds. Instead, joinder would reduce the workload on the Board (and the Director) by rendering moot Eunsung’s pending Director Review request. Accordingly, Eunsung’s petition should be joined with the ongoing and already-instituted Sinclair IPR.

II. BACKGROUND

In mid-2024, Patent Owner (“HydraFacial”) filed actions against Eunsung in the District of Utah and the International Trade Commission—both of which accuse Eunsung of infringing the ’287 patent. *See HydraFacial LLC v. Luvo*

Medical Technologies Inc. et al., 2-24-cv-00587 (D. Utah); *Certain Hydrodermabrasion Systems and Components Thereof*, Inv. No. 337-TA-1408 (ITC).

On September 30, 2024, Eunsung timely filed this IPR challenging the '287 patent. Less than two months later, Sinclair filed a copycat petition, challenging the same claims, based on the same grounds, and relying on the same art. *Sinclair Pharma Ltd. v. HydraFacial LLC*, IPR2025-00145, Paper 2. Indeed, Sinclair sought to join this proceeding, noting that “the issues presented in the [Sinclair] Petition are identical to the issues presented in the Eunsung Petition.” *Sinclair*, Paper 3 at 6-7.

On April 11, 2025, despite finding that the Eunsung petition’s “obviousness challenges meet the standard for institution,” the Board discretionarily denied institution of the Eunsung IPR based solely on *Fintiv*. Paper 17 at 8-17. One month later, Eunsung timely filed for Director Review of the Board’s institution decision, which is currently pending before the Director. Paper 18. On June 2, 2025, the Board instituted Sinclair’s copycat IPR. *Sinclair*, Paper 12. Sinclair’s motion for joinder was dismissed as moot in light of the Eunsung IPR’s discretionary denial. *Id.* at 32.

III. ARGUMENT

A. Legal Standard

Pursuant to 35 U.S.C. § 315(c), the Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant joinder, the Board considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 4 (PTAB July 29, 2013).

B. Petitioner's Motion for Joinder is Timely

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *see also* PTAB, Boardside Chat: AIA Motions Practice 20 (2021) (“Request for authorization to file motion [for joinder] is not required[.]”), https://www.uspto.gov/sites/default/files/documents/ptab_boardside_chat_aia_motions_practice_20210318.pdf. The Board instituted the Sinclair IPR on June 2, 2025. *Sinclair Pharma Ltd. v. HydraFacial LLC*, IPR2025-00145, Paper 12 (PTAB June 2, 2025). Thus, Petitioner's current motion is timely.

C. Each of the Factors Weighs in Favor of the Board Granting the Motion for Joinder

The Eunsung IPR’s petition is substantively identical to the Sinclair IPR’s petition; it presents no new grounds of unpatentability. Additionally, as all substantive issues are identical, joinder should have no impact on the pending schedule of the Sinclair IPR.

1. Joinder with the Sinclair IPR is Appropriate Because It Will Promote an Efficient Determination of the Validity of the ’287 Patent Without Prejudice to Any Party

The Board “routinely grants motions for joinder where” as here, “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 12 at 9 (PTAB Aug. 24, 2016). Here, there are no substantive differences between Eunsung’s petition for *inter partes* review and the Sinclair IPR petition. *See Sinclair*, Paper 3 at 6-7; Paper 11 at 2. Eunsung also relies upon the same supporting evidence, including the declaration of Mr. Simon, which Sinclair’s expert has “reviewed and adopted” without adding “any new or additional opinions.” *Sinclair*, Paper 3 at 5-6.

Because these proceedings introduce identical unpatentability arguments and the same grounds, a consolidated proceeding including the Eunsung and Sinclair IPRs will be more efficient and less wasteful. *See, e.g., Oracle Am. Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (explaining that

“joining [petitioner’s] identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both [the patent owner] and the Board.”). Joinder with the Sinclair IPR would also lessen the burden on the Board and Director by rendering moot Eunsung’s pending Director Review request.

Furthermore, joining Eunsung as a party to the Sinclair IPR would promote the public interest relating to the unpatentability of the ’287 Patent and not cause any undue prejudice to the Sinclair IPR petitioners or the Patent Owner. HydraFacial has asserted the ’287 Patent at the ITC and before six district courts. These lawsuits have named companies making up essentially the entire industry of hydrodermabrasion. With such a vast assertion in multiple district court and ITC proceedings against various defendants, the validity of the ’287 Patent is a common issue that is most efficiently addressed in a common forum, such as the PTAB. Further, because all of the district court cases are either in their early stages or currently stayed, proceeding with validity review at the PTAB would enhance overall judicial efficiency. Indeed, if the ’287 Patent is invalidated early through the present IPR, it would save substantial resources that would otherwise be spent over the next several years in litigation before district courts in Utah, California, Tennessee, New York, Nevada, and Delaware. Therefore, joining Eunsung as a party to the Sinclair IPR would promote the public interest in having the validity of the ’287 Patent reassessed with

Eunsung's participation.

Further, as discussed above, Sinclair sought to join the Eunsung IPR. *Sinclair*, Paper 3. And Patent Owner must respond to the grounds identified in both *inter partes* review petitions regardless of joinder. Patent Owner's waiver of a separate preliminary response in the Sinclair IPR cements this point. *Sinclair*, Paper 11 at 2 ("Because the present Petition raises no new challenges, grounds, or material differences from the Petition in IPR2024-01491, Patent Owner does not believe additional briefing is necessary at this time.").

2. Petitioner Does Not Propose New Grounds of Unpatentability

As discussed above, the Eunsung IPR does not assert any grounds of patentability not already instituted in the Sinclair IPR. The Eunsung IPR challenges the same claims of the '287 patent based on the same arguments, evidence, and grounds of unpatentability as the Eunsung IPR. *See Sinclair*, Paper 2; *Sinclair*, Paper 3 at 6-7. The substantive portions of the Eunsung and Sinclair petitions are identical. To be sure, the petition in the Sinclair IPR relies on the declaration from Mr. Simon in Eunsung's IPR, which was "reviewed and adopted" by Sinclair's expert without adding "any new or additional opinions." *Sinclair*, Paper 3 at 5-6.

As a result, consolidation of this proceeding with Sinclair's via joinder

therefore will not raise any new issues of unpatentability. *See Par Pharm., Inc. v. Novartis AG*, IPR2016-01023, Paper 20 at 14 (Oct. 27, 2016) (granting motion for joinder where petitioners “do not assert any new ground of unpatentability that is not already being considered in [an instituted IPR proceeding], rely on the same arguments and evidence, and do not require any modification to the existing schedule”).

3. Joinder Will Have No Impact on the Sinclair IPR Trial Schedule

Eunsung’s participation will not result in changes to the schedule because Eunsung’s petition does not seek to broaden the scope of the Sinclair IPR petition or introduce new substantive issues. There are no new issues for the Board to address. Furthermore, the Patent Owner’s Response, if any, will not be affected because the Patent Owner will not be required to provide analysis or arguments beyond what it will already provide in responding to the Sinclair IPR petition. Accordingly, joinder of Eunsung would not affect the schedule in the Sinclair IPR.

4. Briefing and Discovery Will Be Simplified Because Eunsung Has Agreed to Consolidated Filings and an Understudy Role if the Sinclair Petitioner Remains

Eunsung’s participation will simplify briefing and discovery—as Sinclair’s petition raises issues and arguments derived from Eunsung’s IPR and relies on Eunsung’s expert. Eunsung’s participation will also ensure that a petitioner remains to complete the trial in case Sinclair reaches a settlement with

HydraFacial.

To further prevent joinder from imposing a burden on the Sinclair IPR petitioners, Patent Owner, or the Board, Eunsung agrees to take an “understudy” role. Specifically, Eunsung agrees that, if joined, the following conditions shall apply so long as Sinclair remains an active party:

- (a) all filings by Eunsung in the Sinclair IPR shall be consolidated with the filings of Sinclair, unless a filing concerns termination, settlement, or issues solely involving Eunsung;
- (b) Eunsung shall not be permitted to raise any new grounds not instituted by the Board in the Sinclair IPR, or introduce any argument or discovery not introduced by Sinclair;
- (c) Eunsung shall be bound by any agreement between Patent Owner and Sinclair concerning discovery and/or depositions; and
- (d) Eunsung at deposition shall not request any direct, cross examination or redirect time beyond that permitted for Sinclair alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Sinclair. *See Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5-6 (Apr. 10, 2015) (finding the same proposed limitations “are consistent with the ‘understudy’ role that Petitioner agrees to assume, as well as Petitioner’s assertion that its presence

would not require introducing any additional arguments, briefing or discovery.”).

Unless and until Sinclair ceases to participate, Eunsung will not assume an active role in the Sinclair IPR. By Eunsung accepting an “understudy” role, Patent Owner and Sinclair can comply with the existing trial schedule without needing any duplicative efforts by the Board or the Patent Owner. These steps will minimize the possibility of any complication or delay from joinder. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015- 01353, Paper No. 11 at 6-7 (Oct. 5, 2015) (instituting IPR and granting 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). Eunsung is further willing to agree to any other reasonable conditions the Board deems necessary.

IV. CONCLUSION

For the foregoing reasons, Eunsung respectfully requests joinder with
Sinclair Pharma Ltd. et al. v. HydraFacial LLC, IPR2025-00145.

Respectfully submitted,

Dated: June 16, 2025

/Jeremy J. Monaldo/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on June 16, 2025, a complete and entire copy of this Petitioner's Motion for Joinder was provided by email, to the Patent Owner by serving the correspondence addresses of record as follows::

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