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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SINCLAIR PHARMA LIMITED, SINCLAIR PHARMA US, INC., VIORA,
INC., EMA AESTHETICS LTD., AND AESTHETIC MANAGEMENT
PARTNERS, LLC AND AESTHETIC MANAGEMENT PARTNERS, INC.,
Petitioners,

v.

HYDRAFACIAL LLC,
Patent Owner.

Case No. IPR2025-00145

Patent No. 11,865,287

**PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. PETITIONERS PRIOR ART AND ARGUMENTS DERIVE FROM THE ITC PROCEEDING, MAKING THE ITC’S INITIAL DETERMINATION RELEVANT INFORMATION.....	1
A. Petitioners’ prior art and arguments substantially overlap with those in the ITC proceeding involving the patent at issue.	1
B. The ITC issued its Initial Determination and Patent Owner promptly notified Petitioners.....	3
III. THE BOARD SHOULD GRANT PATENT OWNER LEAVE TO SUBMIT THE ITC INITIAL DETERMINATION SO THAT THE BOARD HAS ACCESS TO ITS RELEVANT INFORMATION.	3
A. The ITC Initial Determination could not have been obtained earlier.....	4
B. Considering the ITC Initial Determination is in the interests of justice.....	5
1. The ITC Initial Determination provides relevant information that the Board should consider.....	5
2. Fairness supports making the Initial Determination part of the record, as Petitioners will have an opportunity to address it.	11
IV. CONCLUSION.....	12

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	11
<i>Eunsung Global Corp. v. HydraFacial LLC</i> , IPR2024-01491	1, 3, 6
<i>Redline Detection, LLC v. Star Envirotech, Inc.</i> , 811 F.3d 435 (Fed. Cir. 2015)	4
<i>Toshiba Corp., et al. v. Macronix Int’l Co.</i> , IPR2017-01864	12

Other Authorities

37 C.F.R. § 42.1	4
37 C.F.R. § 42.23(b)	11
37 C.F.R. § 42.25(b)	5, 6
37 C.F.R. § 42.100(b)	4, 5
37 C.F.R. §42.123(b)	1, 3, 5

I. INTRODUCTION

Patent Owner (“PO”) seeks to add to the record the ITC’s public Initial Determination (Ex. 2161, “ID”) in Investigation No. 337-TA-1408 (“the 1408 ITC proceeding”). In that ID, the ITC found that the claims of the ’287 patent are patentable over the same prior art and arguments raised in these proceedings.

Under 37 C.F.R. §42.123(b), any party may submit supplemental information if doing so would be in the interests of justice. The ID is highly relevant and will aid the Board in developing a complete record for its conclusions.

Indeed, in a September 16, 2025 Memorandum titled *PTAB Consideration of Prior Findings of Fact and Conclusions of Law*, the Director stated that the “Board shall consider relevant materials submitted by the parties from [] other proceedings,” expressly including prior findings or conclusions issued by the ITC.

Accordingly, PO respectfully requests that the Board grant this Motion and accept the ID into the record.

II. PETITIONERS PRIOR ART AND ARGUMENTS DERIVE FROM THE ITC PROCEEDING, MAKING THE ITC’S INITIAL DETERMINATION RELEVANT INFORMATION.

A. Petitioners’ prior art and arguments substantially overlap with those in the ITC proceeding involving the patent at issue.

In the 1408 ITC proceeding, PO asserted the ’287 patent against multiple parties, including Eunsung Global Corp. (“Eunsung”). *Eunsung Global Corp. v. HydraFacial LLC*, IPR2024-01491, Paper 17 at 14-16. Eunsung later filed an IPR

petition (“Eunsung Petition”) presenting the same prior art and arguments advanced in the ITC case, specifically relying on (1) the Karasiuk-Palmer combination and (2) Greenberg. *Id.* at 7, 17.

On November 25, 2024, Petitioners in the present IPR filed a copycat petition, together with a contingent motion to join the Eunsung IPR. IPR2025-00145, Paper 2 (“AMP Petition”), Paper 3 (“Joinder Motion”). Petitioners expressly acknowledged that the AMP Petition is substantively identical to the Eunsung Petition, explaining:

[T]he AMP Petition copies verbatim the challenges set forth in the Eunsung Petition and relies on an expert declaration that adopts the relevant portions of the expert declaration submitted in the Eunsung IPR. The only differences between the AMP Petition and the Eunsung Petition relate to formalities of a different party filing the petition; there are no other changes to the facts, citations, evidence, or arguments introduced in the Eunsung Petition.

Joinder Motion at 5; *see also id.* at 6 (explaining that the AMP Petition “does not assert any new grounds of patentability” and “challenges the same claims of the ’287 patent based on the same arguments, substantially the same evidence, and the same grounds of unpatentability as the Eunsung IPR.”).

Although the Eunsung and AMP Petitions are substantively identical, the Board denied Eunsung’s Petition, explaining that “[g]iven the advanced stage of litigation in the ITC and the substantial overlap of issues,” “instituting an inter partes

review would be an inefficient use of the Board’s and parties’ resources.” IPR2024-01491, Paper 17 at 17.

B. The ITC issued its Initial Determination and Patent Owner promptly notified Petitioners.

Shortly after PO filed its Response in the present IPR, PO was notified that the ITC had issued its confidential ID regarding the ’287 patent in the 1408 ITC proceeding. *See* ID, Cover Page. The ID addressed, *inter alia*, the ITC’s views on claim construction, the patentability of claims over the same prior art and arguments raised in the present IPR, and the same secondary considerations of non-obviousness currently before the Board. *See generally id.* The ID followed a one-week ITC hearing that included testimony from multiple witnesses and a comprehensive review of the record, supported by extensive briefing from all parties.

The public version of the ID was issued by the ITC on September 16, 2025.

III. THE BOARD SHOULD GRANT PATENT OWNER LEAVE TO SUBMIT THE ITC INITIAL DETERMINATION SO THAT THE BOARD HAS ACCESS TO ITS RELEVANT INFORMATION.

Under 37 C.F.R. § 42.123(b), a party seeking to submit supplemental information more than one month after institution must show both (1) “why the supplemental information reasonably could not have been obtained earlier,” and (2) “that consideration of the supplemental information would be in the interests-of-justice.” “[T]imeliness and relevancy provide additional requirements that must be construed within the overarching context of the PTAB’s regulations governing IPR

and general trial proceedings.” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 446 (Fed. Cir. 2015). The Board has broad discretion in managing these motions, which is exercised in light of Part 42’s mandate to “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1.

When claim construction is at issue, the Board applies the *Phillips* standard and “will [] consider[]” any prior claim-construction determination from a district court or the ITC that is “timely made of record.” 37 C.F.R. § 42.100(b). Further, the PTAB has indicated that “prior findings or conclusion” of the ITC should be submitted to the Board as soon as they become available, explaining that the Board must meaningfully account for these prior findings. *See* Memorandum on PTAB Consideration of Prior Fact Findings and Legal Conclusions (“PTAB Memo”)¹; Trial Practice Guide (November 2019)² at 47-48.

A. The ITC Initial Determination could not have been obtained earlier.

The supplemental information at issue is the ID, which issued in confidential form on August 26, 2025—one day after PO filed its Response. ID, Cover Page.

¹ Available at:

https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf

² Available at: <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>

Because the ID did not exist at the time of the Response, it could not have been submitted with the Response. *See* 37 C.F.R. § 42.123(b).

Upon issuance of the confidential determination, PO acted promptly to file this Motion pursuant to 37 C.F.R. § 42.25(b), which directs that “[a] party should seek relief promptly after the need for relief is identified.” Indeed, PO started this process even before the ITC released a public version of the ID, which the ITC entered on September 16, 2025.

B. Considering the ITC Initial Determination is in the interests of justice.

Granting PO leave to submit the public ID and to make it of record is warranted for many reasons. These include ensuring a complete and accurate record, fairness and lack of prejudice, efficient and timely case management, and promoting consistency across tribunals.

1. The ITC Initial Determination provides relevant information that the Board should consider.

The Patent Office’s 2018 rulemaking adopting the *Phillips* standard makes clear that the PTAB will consider ITC constructions made of record “to promote consistency,” while assigning them “appropriate weight.” Changes to Claim

Construction Standard Before PTAB³. The rulemaking further emphasized that “the scope of an issued patent should not depend on the happenstance of which court or governmental agency interprets it.” *Id.*

That policy has now been reinforced by the Director’s recent memorandum, which directs the Board to consider prior findings of fact and conclusions of law from tribunals such as the ITC. PTAB Memo. This directive squarely advances the consistency that the 2018 rulemaking sought to promote, while ensuring that any divergences across tribunals are expressly addressed and explained. *See id.* Incorporating the ID into the record is essential for the Board to properly account for the ITC’s prior adjudication in its decision-making. *Id.*

Petitioners themselves conceded in their Director Review briefing that it is “logical” to treat the merits of the Eunsung and AMP Petitions consistently “[i]n view of the identity between petitions on the merits.” IPR2025-00145, Paper 16 at 4. The Board likewise recognized in the Eunsung IPR the “substantial overlap of issues” with the 1408 ITC proceeding when discretionarily denying institution. IPR2024-01491, Paper 17 at 17. Extending that same principle of consistency here,

³ Available at: <https://www.federalregister.gov/documents/2018/10/11/2018-22006/changes-to-the-claim-construction-standard-for-interpreting-claims-in-trial-proceedings-before-the>

the Board should recognize that the overlap between the AMP Petition and the ITC proceeding compels incorporation of the ID into the record.

The importance of considering the complete public ID becomes especially clear when the parties' arguments are contrasted with the ID itself. A few examples make the point clear:

Claim Construction: "treatment fluid"

Petitioners argue that "a POSITA would have understood and found obvious that Greenberg's 'particles' constitute 'fluid' within the meaning of the '287 patent" because "the air flow carrying particles is considered to be 'fluid' as used in the '287 patent." IPR2025-00145, Paper 2 ("Pet.") at 68. In response, PO argues that "[a] POSITA would have understood that a collection of dry particles, standing alone, is not a 'treatment fluid' under the plain and ordinary meaning of that term, as informed by the specification and prosecution history." IPR2025-00145, Papers 23-24 ("POR") at 9. Confronted with the same argument, the ID explains that the '287 patent "does not even remotely suggest that 'dry particles' are liquids or fluids." ID at 109.

Ground 1A: Karasiuk-Palmer Combination

Petitioners argue that "a POSITA would have found obvious that Karasiuk's device 10 (handpiece) is connected to 'mobile cart 170' (console), as illustrated in Palmer." Pet. at 20-21 (emphasis removed). In response, PO argues that "Petitioners

have not shown that either Karasiuk's or Palmer's handpiece is ever connected to a console." POR at 24. On this issue, the ID concludes "that the 'handpiece connected to the console' claim elements of the Asserted Claims [would not] have been obvious" in view of Karasiuk and Palmer. ID at 158-161.

Petitioners further argue that "[s]everal reasons would have prompted a POSITA to modify Karasiuk's system based on Palmer's teachings." Pet. at 8. In response, PO argues that "hindsight bias invades Walbrink's analysis when attempting to combine disparate technologies, such as Palmer's dental irrigation system with the single-reservoir skin treatment system disclosed in Karasiuk." POR, 7. On this issue, the ID concludes that Karasiuk, in combination with Palmer, does not render the claims of the '287 patent obvious. It finds that Palmer's "dental irrigation devices" are not analogous art to the "skin treatment devices" disclosed by the '287 patent, and Palmer's "system and method of selecting among different fluids" is not reasonably pertinent to the problems addressed by the inventions of the '287 patent. ID at 150-152. The ID further explains that a person of ordinary skill in the art would not have considered the lack of multiple containers in Karasiuk to be problematic and therefore would not have sought to combine Palmer's multi-container disclosure with Karasiuk's disclosure. *Id.* at 157-158.

Ground 1B: Karasiuk-Palmer-Trueba Combination

Petitioners argue that “Karasiuk-Palmer’s system would have been modified based on Trueba’s teachings of computer control and display.” Pet. at 51. In response, PO argues that “[i]ncorporating the control and display from Trueba’s mucosal inhaler—an entirely different device that relies on inkjet technology—only makes the already flawed combination more problematic.” POR at 54. On this issue, the ID concludes that “Trueba is not analogous prior art to the ’287 patent.” ID at 140-143, 161.

Ground 2A: Greenberg

Petitioners argue that “Greenberg discloses or renders it obvious that the system is configured to deliver the first treatment fluid (e.g., ‘highly abrasive particles’) in the first container (e.g., container 90) and the additional treatment fluid (e.g., ‘organic ones’) in the at least one additional container (e.g., container 94) to the handpiece sequentially (‘subsequently’).” Pet. at 73. In response, PO argues that “Petitioners’ [Greenberg] argument rests entirely on an overbroad interpretation of the claim term ‘treatment fluid’ to include a collection of dry particles.” POR, 59. On this issue, the ID concludes that Greenberg does not disclose the “treatment materials” or “fluid” claimed by the ’287 patent because Greenberg discloses only the use of “dry particles” in its treatment system. ID at 107-109. The ID further determines that “Greenberg expressly teaches *away* from using liquids.” *Id.* at 136.

Secondary Considerations

Petitioners present no secondary considerations analysis in their Petition. *See* Pet. PO argues in its Response that “Petitioners attempt to reconstruct the invention with hindsight,” “[b]ut objective, real-world evidence tells a different story—one of genuine innovation, not obviousness.” POR at 71. On this issue, the ID concludes that secondary considerations of nonobviousness—including commercial success—support the validity of the claims of the ’287 patent. ID at 174-184. In particular, it finds that HydraFacial’s growth significantly outpaced the global cosmetics market, and that the commercial “HydraFacial Systems are coextensive with the Asserted Claims” the ’287 patent’s invention. *Id.* at 183-184. The ID further finds that “comparative sales data, consumer preference, and technical advantages of the HydraFacial Systems confirm the nexus between the Asserted Claims and HydraFacial’s commercial success. The consistent and substantial growth in revenue, coupled with a preference for the HydraFacial Systems over simpler alternatives, like the Nectre, provides additional support for a finding of non-obviousness of the ’287 patent.” *Id.*

These examples confirm that the ITC’s reasoning provides essential context and analysis that cannot be captured through selective excerpts, underscoring why the Board should receive the complete public ID.

This conclusion is further supported by the Trial Practice Guide, which explains the factors the Board may consider in deciding what weight to give prior constructions, including the similarity of the records. Trial Practice Guide at 47. Submitting the full public version—rather than only claim constructions—is the most practical approach, enabling the Board to evaluate and assign the weight it deems appropriate. Attempting to submit only selected portions would be both impractical and unfair: it raises difficult questions about who decides what to include or redact, risks depriving the Board of relevant context, and offers no clear benefit for the Board. The only party who might gain from such selective submission is Petitioners, by attempting to withhold information and contrary findings that undermine its arguments.

2. Fairness supports making the Initial Determination part of the record, as Petitioners will have an opportunity to address it.

Allowing this filing is fair and non-prejudicial. The Trial Practice Guide underscores that parties must have a “full and fair opportunity” to present arguments and evidence before any final decision. *Id.* at 49. Petitioners will be able to address the ID in their Reply, and PO may respond in a Sur-Reply, consistent with 37 C.F.R. § 42.23(b). Federal Circuit precedent confirms that due process is satisfied when the opposing party has a meaningful opportunity to respond—precisely the situation here. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015).

The Board's handling in *Toshiba Corp., et al. v. Macronix Int'l Co.*, IPR2017-01864, confirms the point. There, the Board granted a motion to submit an ID as supplemental information and permitted related briefing from both sides. IPR2017-01864, Paper 20. When the non-moving party later claimed prejudice and sought to strike a supporting declaration, the Board denied that request, noting it could weigh the evidence at the close of trial. IPR2017-01864, Paper 29 at 3-4. The takeaway is straightforward: when an ITC ID is relevant, the appropriate remedy is briefing—not exclusion—so both sides can be fully heard and the record is complete.

Petitioners themselves have already acknowledged they do not object to including the ITC's claim-construction determinations as part of the record. This concession undermines any claim of unfairness, as it demonstrates Petitioners recognize the relevance and cannot credibly assert prejudice from its inclusion.

IV. CONCLUSION

For the foregoing reasons, PO respectfully requests that the Board grant this Motion to submit the complete public version of the ITC's ID.

Respectfully Submitted,

Dated: September 19, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), I certify that on September 19, 2025, a copy of this **PATENT OWNER’S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION AND EXHIBIT 2161** were served via the email correspondence address of record for Petitioner’s counsel of record:

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Respectfully Submitted,

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