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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EUNSUNG GLOBAL CORP.,

Petitioner,

v.

HYDRAFACIAL LLC,

Patent Owner.

Case No. IPR2025-00445

U.S. Patent No. 9,550,052

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

TABLE OF CONTENTS

Page No.

I. INTRODUCTION	1
II. BASES FOR DISCRETIONARY DENIAL	4
A. The Director Should Deny the Petition Because Eunsung Is Wasting Resources by Refusing to Produce Evidence that its Petition Was Untimely Filed Under § 315(b)	4
B. The Director Should Deny the Petition Under 325(d)	7
1. <i>Advanced Bionics</i> 1A – the same or substantially the same art	11
2. <i>Advanced Bionics</i> 1B – the same or substantially the same arguments.....	14
3. <i>Advanced Bionics</i> 2 – Eunsung cannot show the Office erred in a manner material to the patentability of the challenged claims.....	15
C. The Director Should Deny the Petition Due to the Weak Merits Underlying Eunsung’s Unpatentability Challenge.....	18
D. The Director Should Deny the Petition Due to Its Reliance on Evidence Modified by Eunsung without Explanation or Acknowledgement.....	24
III. CONCLUSION	28

TABLE OF AUTHORITIES

Page No(s).

Cases

<i>Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH,</i> IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).....	10, 15, 16, 17
<i>Becton, Dickinson and Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)	<i>passim</i>
<i>Belden Inc. v. Berk-Tek LLC,</i> 805 F.3d 1064 (Fed. Cir. 2015)	22
<i>DeSilva v. DiLeonardi,</i> 181 F.3d 865 (7th Cir. 1999)	27
<i>Keysight Techs., Inc. v. Centripetal Networks, Inc.,</i> IPR2022-01421, Paper 14 (P.T.A.B. Aug., 24, 2023).....	8
<i>Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.</i> (Case IPR2017-00651, Paper 152 (January 24, 2019)).....	5, 6
<i>Worlds Inc. v. Bungie, Inc.,</i> 903 F.3d 1237 (Fed. Cir. 2018)	6

Statutes

35 U.S.C. § 315(b)	1, 4
35 U.S.C. § 325(d)	<i>passim</i>

Other Authorities

37 C.F.R. §§ 11.18(c), 42.65(a)	3
37 C.F.R. § 42.6(e).....	30
37 C.F.R. § 42.24	29

TABLE OF AUTHORITIES
(cont'd)

	Page No(s).
37 C.F.R. § 42.24(a).....	29
37 C.F.R. § 42.51(b)(1)(iii).....	5
37 C.F.R. § 11.18(c).....	27
37 C.F.R. § 42.65(a).....	27
Memorandum on Interim Processes for PTAB Workload Management	1

I. INTRODUCTION

Pursuant to the Acting Director’s Memorandum *Interim Processes for PTAB Workload Management* (“Memorandum”) issued on March 26, 2025, Patent Owner HydraFacial LLC (“HydraFacial” or “Patent Owner”) sets forth the bases on which the Director should exercise discretion to deny institution of this IPR. This filing is timely, submitted within one month of the Notice Extending Deadline for Discretion Briefing, dated April 11, 2025. Paper 7. At least four independent bases support denying institution, and collectively they weigh strongly in favor of exercising discretion to deny institution.

First, Eunsung holds—but has steadfastly refused to produce—evidence establishing that the Petition is time-barred under 35 U.S.C. § 315(b). Eunsung filed its Petition years after HydraFacial served a complaint on Cartessa Aesthetics, LLC (“Cartessa”), alleging infringement of U.S. Patent No. 9,550,052 (“’052 patent”) based on Cartessa’s sales of Eunsung’s Skinwave product, which Cartessa exclusively distributes. Because Cartessa was in privity with Eunsung when the complaint was served and is a real party in interest (RPI) in this IPR, the Petition constitutes an impermissible second bite at the apple before the PTAB for Eunsung and Cartessa. Indeed, the validity of the ’052 patent was previously upheld on summary judgment when Cartessa challenged its validity in the district court.

Discretionary denial is warranted to conserve the resources of the Board, ITC, and parties and to avoid unnecessary discovery and briefing. Rather than producing known, relevant information requested by HydraFacial, Eunsung is forcing the parties to engage in further discovery and briefing both at the ITC and in this IPR, thereby delaying the introduction of evidence that will ultimately show the Petition is time-barred. If Eunsung contends the Petition is not time-barred, it should provide admissions and evidence to the Director now so that the Director, Board, ITC, and parties do not expend additional resources. Eunsung's failure to do so in its opposition briefing will continue to waste resources through discovery and motion practice and should accordingly be treated as a factor favoring discretionary denial.

Second, denial is warranted under 35 U.S.C. § 325(d) because the Petition merely rehashes the same or substantially similar prior art or arguments that were previously considered by the U.S. Patent Office. The Examiner already substantively considered Karasiuk, Eunsung's primary reference for all grounds, during prosecution of the '052 Patent. The Examiner expressly acknowledged that Karasiuk's parent, which includes nearly the same disclosure as Karasiuk, is "considered pertinent to applicant's disclosure," but declined to rely on it to reject any claims. Ex. 1002, 163.

Eunsung also relies on other prior art that was either already reviewed by the Examiner or is not materially different from what was previously considered. Rather

than providing a substantive explanation of how the Examiner allegedly erred, the Petition mischaracterizes the Examiner's analysis. The Director should reject the Petition because Eunsung cannot identify an error in the Examiner's analysis and because Eunsung mischaracterized the record.

Third, the merits of the Petition are weak and strongly support discretionary denial. Although HydraFacial will fully address the merits in its Patent Owner's Preliminary Response (POPR) and demonstrate that Eunsung has not met its burden for institution, the Director should discretionarily deny the Petition now because it fails to identify any combination of prior art that discloses or suggests the "manifold" recited in all claims. The Petition's reliance on Palmer falls short of meeting this limitation, and its fallback theories are based on hindsight and speculation, mischaracterize the prior art, and ignore critical differences in structure and functionality. These deficiencies undermine any reasonable likelihood that the Petition would prevail on its unpatentability grounds, thus warranting discretionary denial.

Fourth, the Petition improperly relies on altered figures from the Karasiuk reference, which Eunsung modified without explanation or acknowledgement. The improper alterations identified by HydraFacial raise serious concerns about the reliability of Eunsung's submissions and cast doubt on the integrity of the Petition and its accompanying expert declaration, which, as a result, should be entitled to

little or no weight. *See* 37 C.F.R. §§ 11.18(c), 42.65(a). Neither the Board nor HydraFacial should be expected to act as archeologists tasked with uncovering and investigating additional issues. The Director should exercise discretion to deny institution to prevent unnecessary and unfair expenditure of resources by the Board and HydraFacial on such further investigation and analysis.

For all of these reasons, and as detailed further below, the Director should exercise her discretion to deny institution.

II. BASES FOR DISCRETIONARY DENIAL

A. The Director Should Deny the Petition Because Eunsung Is Wasting Resources by Refusing to Produce Evidence that its Petition Was Untimely Filed Under § 315(b)

The Memorandum provides that “the parties are permitted to address all relevant considerations” when seeking a discretionary denial, including “any other considerations bearing on the Direction’s discretion.” While the one-year bar under 35 U.S.C. § 315(b) has traditionally been treated as a non-discretionary statutory requirement, the Director should, in this case, also consider it as a basis for discretionary denial. Doing so would avoid unnecessary expenditure of Board, ITC, and party resources where the Petition was not timely filed.

Under 35 U.S.C. § 315(b), “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the ... real party in interest[] or privy of the petitioner is served with a

complaint alleging infringement of the patent.” Here, Eunsung qualifies as both a real party in interest and privy of Cartessa Aesthetics, LLC (“Cartessa”), which HydraFacial sued in December 2020 by filing a complaint alleging infringement of the ’052 patent (“2020 suit”). Cartessa is Eunsung’s exclusive distributor for the accused products at issue in the 2020 suit, and the companies have maintained a close relationship before, during, and after the 2020 suit. The court ultimately upheld the validity of the ’052 patent in the 2020 suit, rejecting Cartessa’s invalidity challenge and granting summary judgment of no invalidity. *See Edge Systems LLC v. Cartessa Aesthetics, LLC*, 2:20-cv-06082-GRB-ST, Dkt. 97 (E.D.N.Y)

HydraFacial is actively seeking discovery of a distribution agreement between Eunsung and Cartessa, as well as any evidence that Eunsung reimbursed Cartessa for litigation expenses incurred in the 2020 suit. Although HydraFacial requested that Eunsung produce this information as part of its discovery obligations—including under 37 C.F.R. § 42.51(b)(1)(iii)—Eunsung has steadfastly refused to do so, necessitating burdensome additional discovery both at the ITC and in this proceeding.

HydraFacial contends that Eunsung, like the petitioner in the precedential PTAB decision *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.* (Case IPR2017-00651, Paper 152 (January 24, 2019)), will be time-barred once the Board is made aware of all relevant evidence. In *Ventex*, the Board terminated the IPR

because the petitioner failed to name a time-barred RPI and privy. In its RPI analysis, the Board found that the parties “had a specially structured, preexisting, and well established business relationship with one another, including indemnification and exclusivity arrangements,” where the earlier litigant received not merely a generalized benefit from the IPR, but a “direct benefit of a finding of unpatentability of claims.” *Ventex*, Paper 152, at 10. To support a finding of privity, the Board cited the parties’ “preexisting substantive legal relationship in the form of two contracts, a Supplier Agreement with an obligation to indemnify and defend, and an Exclusive Manufacturing Agreement,” with the agreements “directly relat[ing] to the product accused of infringing the patent at issue.” *Id.*, at 12.

To the extent Eunsung disagrees that the Petition is time-barred, Eunsung should provide supporting admissions and evidence to the Director now so that the Director, Board, ITC, and parties do not waste additional resources. Eunsung’s failure to do so in any opposition filed in response to this brief would needlessly force further discovery and motion practice and thus should be interpreted as a factor favoring discretionary denial. *See also Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242-44 (Fed. Cir. 2018) (holding a petitioner bears the ultimate burden of proving it is not time-barred once a patent owner puts the issue in dispute with sufficient evidence).

B. The Director Should Deny the Petition Under 325(d)

35 U.S.C. § 325(d) authorizes the Director to reject the Petition when “the same or substantially the same prior art or arguments previously were presented to the Office.” Here, every ground in the Petition relies on Karasiuk (Publ. No. 2003/0212415) (Ex. 1004) as the primary reference. Pet., 1. The Examiner, however, already substantively considered Karasiuk during prosecution of the ’052 Patent. In an Office Action dated August 5, 2025, the Examiner expressly acknowledged that Karasiuk’s parent—which has nearly the same disclosure as Karasiuk—is “considered pertinent to applicant’s disclosure,” but ultimately declined to rely on it in rejecting the claims:

Application/Control Number: 14/698,673
Art Unit: 3734

Page 10

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Muldner (US 6,277,128 B1) (Figures 7 and 10), Rosso (US 6,432,114 B1) (Figures 1-3), Karasiuk (US 6,695,853 B2) (Figure 5), Chang (US 7,232,444 B2) (Figures 1-5), Goble et al. (US 2006/0116674 A1) (Figures 1-3).

Ex. 1002, 163 (annotation added).¹

¹ U.S. Patent No. 6,695,853 to Karasiuk is the parent to the Karasiuk reference relied on in the Petition as Ex. 1004. *See* Ex. 1004 at 1. The child application (Ex.

These facts sharply contrast with Eunsung’s assertion that Karasiuk was merely “buried in an IDS” and “not addressed substantively” (Pet., 4, 91), and instead implicate 35 U.S.C. § 325(d), requiring an *Advanced Bionics* analysis to determine whether to deny the Petition.

Eunsung attempts to rewrite Section 325(d) to avoid an *Advanced Bionics* analysis. Specifically, Eunsung argues:

Because the ’052 patent’s prosecution did not involve negotiation regarding the prior art combinations applied, Grounds 1A-1E cannot be said to be the same as, or substantially similar to, art or arguments that the Office previously considered.

Pet., 91. Eunsung’s arguments lack legal and factual support. Prior art need only have been “previously presented to the Office” to invoke Section 325(d). The prosecution history need not include detailed evidence the prior art was “considered” or involved in any “negotiation.” *Keysight Techs., Inc. v. Centripetal Networks, Inc.*, IPR2022-01421, Paper 14 at 5 (P.T.A.B. Aug., 24, 2023) (Director Review) (“[T]he first part of the *Advanced Bionics* framework does not require that an Examiner

1004) was filed as a continuation-in-part and includes additional disclosure, but the Fig. 6 embodiment relied on by Eunsung in this IPR is the substantively the same between these references. The Examiner’s reference to “Figure 5” in the Office Action is likely a typographical error and should have been “Figure 6.”

provide a ‘discussion, analysis, or other findings on the applicability’ of the relevant material contained in an IDS.”)

Eunsung’s argument is also factually flawed. The Examiner expressly acknowledged in an Office Action that he considered Karasiuk’s parent “pertinent to applicant’s disclosure,” but he declined to rely on it for rejecting the claims. Ex. 1002, 163. Furthermore, the Examiner certified that he considered the Karasiuk publication that Petitioner relies on in the Petition as Ex. 1004 (Publ. No. 2003/0212415), as well as its patent grant (U.S. Pat. No. 7,658,742), its continuation child application publication and patent grant (Publ. No. 2007/0088371 and U.S. Pat. No. 7,951,156), and its continuation grandchild application publication (Publ. No. 2012/0136374). Ex. 1002, 172-173, 175-176. Moreover, Karasiuk itself was specifically identified in four separate search queries conducted by the Examiner, including Search 44, where Karasiuk (“20030212415,” referring to Publ. No. 2003/0212415) was queried among just a few other references:

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S44	8	("20010023351" "20030093089" "20030212415" "6250996" "D450842").PN. OR ("D503979").URPN.	US-PGPUB; USPAT; USOCR	OR	ON	2015/07/23 10:14

Id., 57; *id.*, 50, 53, 60.

In *Advanced Bionics*, the Board explained its two-part framework for deciding whether to deny institution under Section 325(d):

Thus, under § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review. If reasonable minds can disagree regarding the purported treatment of art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH, IPR2019-01469, Paper 6 at 8-9 (PTAB Feb. 13, 2020) (precedential). The Board further explained that *Becton, Dickinson* factors (a), (b), and (d) provide insight into whether the same or substantially the same art or arguments was previously presented to the Office, and *Becton, Dickinson* factors (c), (e), and (f) provide insight into whether the petitioner has shown the Office materially erred. *Id.* at 10-11; *see Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17 (PTAB Dec. 15, 2017) (precedential). Here, applying the *Becton, Dickinson*

factors under the *Advanced Bionics* framework supports denial of the Petition under Section 325(d).

1. *Advanced Bionics* 1A – the same or substantially the same art

Becton, Dickinson factor (a)—“the similarities and material differences between the asserted art and the prior art involved during examination”—and *Becton, Dickinson* factor (b)—“the cumulative nature of the asserted art and the prior art involved during examination”—bear on whether the same or substantially the same art was previously presented to the Office. *Id.* Here, the Examiner already considered the *exact* primary reference, Karasiuk, and one of the *exact* secondary references, Mercier, Eunsung relies on. Ex. 1002, 163, 173, 170; *id.*, 50, 53, 57, 60. The Examiner even noted his review of Karasiuk’s parent patent (*id.*, 163 (Karasiuk’s parent patent is “prior art made of record and not relied upon [that] is considered pertinent to applicant’s disclosure.”))), which includes nearly all of the same Karasiuk disclosures that the Petition points to.

Eunsung argues the Examiner did not consider secondary references Palmer, Trueba, and Wunsch. Pet., 91. However, there are no material differences between the relied-on teachings of Palmer, Trueba, and Wunsch and the prior art the Examiner already considered. And to the extent Eunsung relies on any teachings of Palmer, Trueba, or Wunsch that go beyond Karasiuk, such teachings are not as relevant as the prior art the Examiner already considered.

Eunsung cannot plausibly allege that Palmer discloses multiple skin-treatment containers as claimed because Palmer discloses dental-irrigant containers. *See e.g.*, Ex. 1005, claim 1 (“[p]eriodontal irrigating system”). Eunsung relies on Palmer more generally, as allegedly disclosing multiple treatment containers and container-selection structure. But that alleged disclosure is no more relevant than the disclosure of Coleman (U.S. Pat. Appl. Publ. No. 2001/0049511), which the Examiner applied during prosecution (Ex. 1002, 102-111, 155-159, 162). In fact, the Examiner expressly found that:

Coleman discloses (Figures 4-6) a system for performing a skin treatment procedure, the system comprising: a console (Figure 6) including a manifold (see Figure 6 below), the manifold being in fluid communication with a first fluid container (60C) and at least a second fluid container (60B), the first fluid container and the at least second fluid container capable of containing a treatment material for a skin treatment procedure ... wherein the manifold is capable of controlling a flow of treatment material from the first fluid container and at least the second fluid container through the supply conduit ... wherein the system is capable of permitting a user to select a treatment material from the first fluid container or the at least second fluid container to be delivered through the supply conduit to the handpiece assembly.

Ex. 1002, 102-103.

Moreover, Coleman’s system is more closely related to Karasiuk’s system than Palmer’s. Coleman is at least in the field of dermatological treatment (Ex. 1018,

Abstract) rather than the field of dental irrigation. Coleman's system, like Karasiuk's, incorporates a vacuum source. Ex. 1018, [0020], [0050]. This vacuum pressure in Coleman draws waste from the skin to a container. *Id.* In contrast, Palmer's system merely uses a pump to push dental-irrigant from its containers. Ex. 1005, 5:10-22. But Coleman's system also includes a pump for dispensing treatment liquid from containers. Ex. 1018, [0059].

Thus, if it would have been obvious to combine Karasiuk with the disclosure of multiple treatment containers and container-selection structure to yield the claimed invention, the Examiner would have rejected the claims in view of Karasiuk and Coleman. The Examiner's finding that the claims are patentable over Karasiuk and Coleman shows that the claims are likewise patentable over Karasiuk and Palmer.

Eunsung also cannot rely on Trueba and Wunsch to overcome Section 325(d). These references add nothing of consequence to the grounds. Specifically, Eunsung relies on Trueba as allegedly disclosing a computer control and display (Pet., 50-53, 85-87), and Wunsch as allegedly disclosing a manifold selector and sequencer-timer (Pet., 71). However, the Examiner previously asserted that Coleman, Greenberg (Publ. No. 2003/0093089), and/or Duchon (Publ. No. 2003/0018252) disclosed the features, and ultimately allowed the claims. Ex. 1002, 38-40, 102-109, 155-161. Eunsung does not rely on Trueba and Wunsch as allegedly disclosing anything the

Examiner had not already found to be taught by the prior art applied during examination. Therefore, neither Trueba nor Wunsch calls into question the Examiner's patentability findings.

Eunsung's reliance on the same or substantially the same art that was previously presented to the Office, as demonstrated above, is sufficient to satisfy the first step of the *Advanced Bionics* framework.

2. *Advanced Bionics* 1B – the same or substantially the same arguments

Becton, Dickinson factor (d)—“the extent of the overlap between the arguments made during examination and the manner in which [Eunsung] relies on the prior art of Patent Owner distinguishes the prior art”—bears on whether the same or substantially the same arguments were previously presented to the Office. IPR2017-01586, Paper 8 at 17. It is not necessary to determine whether the same or substantially the same arguments were previously presented to the Office because Eunsung's reliance on the same or substantially the same art previously presented to the Office is enough to satisfy the first step of *Advanced Bionics*. Nevertheless, Eunsung's reliance on its asserted prior art overlaps significantly with arguments implicitly made in the Examiner's finding that the claims are patentable over the prior art of record.

For example, Eunsung argues it would have been obvious to modify Karasiuk's single-container device to include Palmer's container-selection structure and containers to yield the claimed invention. Pet., 7-13. However, the Examiner's findings that the prior art of record, including Karasiuk, does not make obvious the claimed multi-container devices (*see* Ex. 1002, 38-40), necessarily implies the Examiner considered and rejected the argument that it would have been obvious to modify a single-container device to include multiple selectable containers to yield the claimed invention.

Accordingly, in view of the significant overlap between Eunsung's reliance on its asserted prior art and arguments the Examiner implicitly considered and rejected, Eunsung relies on the same or substantially the same arguments previously presented to the Office, satisfying the first step of *Advanced Bionics*.

3. *Advanced Bionics 2* – Eunsung cannot show the Office erred in a manner material to the patentability of the challenged claims

Because Eunsung's Petition satisfies the first step of *Advanced Bionics*, Eunsung is required to proceed to the second step and show that the Office erred in a manner material to the patentability of challenged claims. Eunsung cannot show that the Office made any such material error.

Becton, Dickinson factors (c), (e), and (f) related to whether Eunsung has demonstrated a material error by the Office. *Advanced Bionics*, IPR2019-01469,

Paper 6 at 10. With respect to factor (c)—“the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection”—Eunsung argues Karasiuk was cited in an IDS but “not addressed substantively during examination.” Pet., 91. This is incorrect as explained because the Examiner expressly commented on reviewing Karasiuk’s parent patent. Ex. 1002, 163 (Karasiuk’s parent patent is “prior art made of record and not relied upon [that] is considered pertinent to applicant’s disclosure.”). Regardless, even when “the record of the Office’s previous consideration of the art is not well developed or silent, then a petitioner” must still “show the Office erred by overlooking something persuasive under factors (e) and (f).” *Advanced Bionics*, IPR2019-01469, Paper 6 at 10. Eunsung failed to show any such error in the Petition and will be unable to do so in its opposition.

With respect to *Becton, Dickinson factor (e)*—“whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art” (IPR2017-01586, Paper 8 at 18)—Eunsung merely asserts that “[t]o the extent Karasiuk and Mercier were previously considered, the Examiner erred in overlooking the teachings cited in the Petition.” Pet., 91.

That conclusory assertion is pure speculation, supported by no evidence. Nothing in the prosecution history even suggests the Examiner overlooked, ignored, or misapplied the teachings of Karasiuk, Mercier, or the other prior art of record.

Moreover, even if a reasonable mind could interpret the prosecution history as suggesting the Examiner may have overlooked any prior-art teachings, a reasonable mind could also interpret the prosecution history as showing that the Examiner considered Karasiuk and Mercier, along with the other prior art of record, and determined that the claims would not have been obvious over any combination of that art. In that case, where “reasonable minds can disagree regarding the purported treatment of art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 9.

With respect to *Becton, Dickinson factor (f)*—“the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments” (IPR2017-01586, Paper 8 at 18)—Eunsung merely argues the “Examiner also did not have the benefit of considering” Karasiuk and Mercier “in combination with Palmer, Trueba, or Wunsch.” Pet., 91-92. However, as explained above, the Palmer teaching Eunsung relies on—multiple containers for dental irrigation—is at best cumulative, and indeed, less relevant, than Coleman’s teaching of multiple containers for dermatological treatment. And the Trueba and Wunsch teachings Eunsung relies on—a computer control and display (Pet., 50-53, 85-87) and a manifold selector and sequencer-timer (Pet., 71)—are not only (1) unrelated to the reasons the claims were allowed during examination, but also (2) cumulative

of the Coleman, Greenberg, and Duchon references the Examiner applied against the claims.

Accordingly, Eunsung has not shown—and cannot show—the Examiner materially erred in allowing the claims over Karasiuk and the other prior art of record. Therefore, the Board should defer to the Examiner’s patentability finding by denying the Petition. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9.

C. The Director Should Deny the Petition Due to the Weak Merits Underlying Eunsung’s Unpatentability Challenge

The Director should decline to institute IPR based on the weakness of Eunsung’s unpatentability challenge. Every ground in the Petition relies on a combination of Karasiuk and Palmer (Pet., 1), but this combination fails to disclose a limitation required by all claims—namely, a “manifold.” The Petition’s attempt to satisfy this limitation is technically unsupported and analytically flawed. It contradicts the Petition’s own definition of “manifold,” finds no support in Palmer, and ultimately relies on impermissible hindsight.

Each independent claim of the ’052 patent recites a manifold. For example, independent claim 1 requires “a console including a manifold, the manifold being in fluid communication with a first fluid container and at least a second fluid container.” Similarly, independent claim 11 recites “a manifold in fluid communication with at least two fluid containers.”

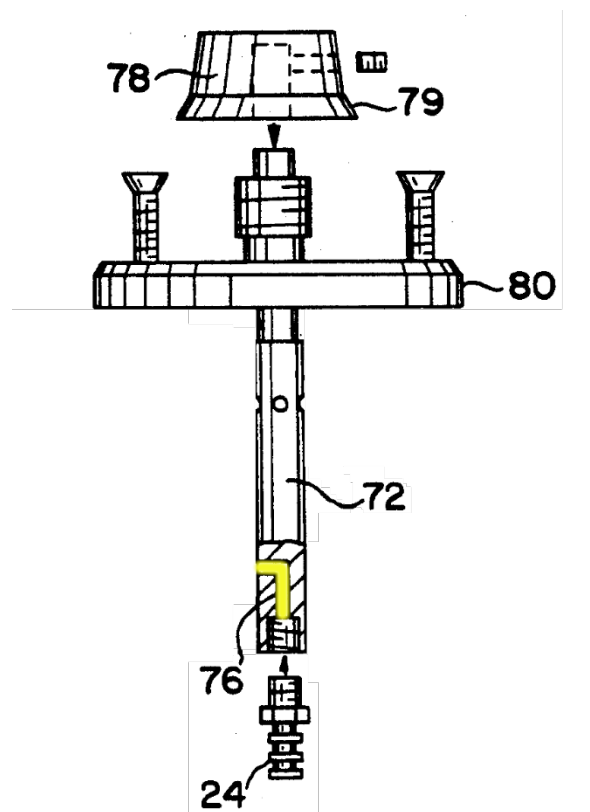
To attempt to meet this limitation, the Petition and its accompanying expert declaration point to Palmer's selector valve means 20 and argue it constitutes a "manifold." Pet., 15-19; Ex. 1003, ¶¶104-109. But this argument fails under the Petition's own adopted definition of manifold, which defines "manifold" as "a chamber or pipe with many openings." Pet., 15 (citing Ex. 1029, 5); *see also* Ex. 1003, ¶104 n.1 (Ex. 1029, 5). Palmer's selector valve means 20 is neither a chamber nor a pipe with *many* openings. Instead, Palmer describes the device as "means for coupling a selected *one* of the inputs 22 to *the* output 24." Ex. 1005, 5:1-9 (emphasis added).

Palmer elaborates on the configuration and operation of its one-to-one connection. The selector valve means 20 includes a main body 70 and a rotatable central cylinder core or stem 72 mounted within the main body 70. *Id.*, 8:6-8. The rotatable core 72 has a "liquid outlet passage 76," which consists of a single inlet and a single outlet: "A liquid outlet passage 76 is formed in the rotatable core 72 having *one end opening* into the selector valve output port 24 *and another end opening* onto the cylindrical core surface in the plane of the inner ends of passages 74." *Id.*, 8:13-18 (emphasis added).

When a user rotates the knob 78 on the front of the selector valve means 20, the rotatable core 72 is "rotated until the end of the outlet passage 76 communicates with the particular inlet passage 74 corresponding to the inlet coupled to the desired

irrigating solution.” *Id.*, 8:45-48. “For example, when the knob is rotated so that the pointer 78 indicates the indicia designated ‘6’, the outlet passage 76 communicates with the inlet passage 74 which opens into the inlet port 22₆ which is coupled to the solution 34₆ contained in the reservoir 12₆.” *Id.*, 8:48-53.

The outlet passage 76’s single-input-to-single-output connection within the rotatable core 72 is shown in yellow in the excerpt from Figure 5A below:



Id., Fig. 5A excerpt (annotated). As illustrated in full Figure 5A, the selector valve means 20 connects the inlet port 22₆ to the outlet passage 76 (the connected path shown in green), while the inlet port 22₁ is disconnected and physically blocked from the outlet passage 76 (the disconnected path shown in red):



This design is fundamentally distinct from a manifold, which, according to Eunsung’s cited definition, requires “a chamber or pipe with many openings.” As such, Palmer’s selector valve means 20 does not meet the manifold limitation in independent claims 1 and 11, and the Petition fails to establish otherwise.

Recognizing this deficiency, the Petition proposes two modifications to the Karasiuk-Palmer combination, but both are flawed and rely on hindsight rather than objective reasoning based on the prior art.

First, as a modification in Ground 1A, the Petition argues that “a POSITA would have found it obvious to use a manifold to implement Palmer’s functionality of switching treatment fluids.” Pet., 19. It asserts that manifolds were “well-known,” “within a POSITA’s general knowledge,” one of “a finite number of identified, predictable solutions,” and “an obvious design choice.” *Id.*, 20-22. But these conclusory assertions do not establish that a POSITA **would have been motivated** to make such a substitution—only that a POSITA **could have**. See *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.”).

Critically, the Petition and expert declaration identify no shortcoming in Palmer’s selector valve means 20 that would justify replacing it. Pet., 19-22; Ex. 1003, ¶¶110-113. At most, the Petition contends a POSITA would have selected a manifold because “it eliminates the need of manual connecting/disconnecting and allows for a simpler handpiece design with one input.” Pet., 21. However, Palmer’s selector valve means 20 already eliminates manual connections, and the Petition and

expert declaration fail to explain how a manifold could possibly simplify Karasiuk's handpiece design.

The Petition also argues that incorporating a manifold in the Karasiuk-Palmer combination "would have merely involved a simple substitution of one well-known element for another to obtain predictable results." Pet., 21-22. But this is inconsistent with the Petition's own cited definition of a "manifold." And a device that selectively connects one input to one output like Palmer's selector valve means 20 is not equivalent to "a chamber or pipe with many openings." Replacing one with the other would require significant unaddressed structural and functional changes to accommodate the manifold's many openings. This is not a simple substitution.

Second, the Petition presents Ground 1D, which combines Wunsch with Karasiuk and Palmer, asserting that a POSITA would have replaced Palmer's liquid solution coupling and selector means 16 with Wunsch's manifold selector and sequencer-timer. *Id.*, 1, 71. But this proposed modification is illogical and clearly hindsight driven. The Petition touts the benefits of Wunsch's sequencer-timer—namely, its ability to automatically control and dispense fluid—but fails to recognize that its proposed combination lacks any mechanism for measuring the quantity of solution dispensed. *Id.*, 73, 75. Without this, the alleged automatic control has no feedback loop and cannot function as intended.

Wunsch makes clear that “[t]he quantity of solution dispensed is metered by a volumetric infusion pump.” Ex. 1020, Abstract; *see also id.*, 7:57-65 (“[F]luid volume through the dispensing tube 18 is controlled by the volumetric infusion pump 20.”). Yet the Petition never incorporates Wunsch’s infusion pump, and thus provides no means of regulating Wunsch’s manifold selector through the sequencer-timer. Pet., 74-75.

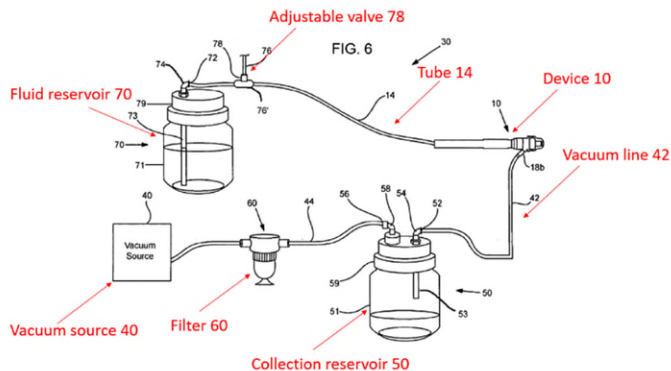
In sum, the Petition’s unpatentability challenge rests on deficient combinations, improper hindsight, and inconsistent reasoning. It fails to identify a manifold as required by each claim, and its fallback arguments either mischaracterize the prior art or ignore key structural and functional differences. Because the Petition does not present a reasonable likelihood of prevailing on unpatentability, the Director should reject institution of IPR.

D. The Director Should Deny the Petition Due to Its Reliance on Evidence Modified by Eunsung without Explanation or Acknowledgement

The Petition relies on Karasiuk as its primary reference for all grounds. Pet., 1. And within Karasiuk, the Petition relies heavily on Figure 6, which appears in whole or in part across nine pages of the Petition and nine pages of the accompanying expert declaration. *See* Pet., 5, 8, 16, 25, 27, 30, 32-33, 35; Ex. 1003, ¶¶52, 76, 104, 121, 123, 129, 133, 135, 138. In each instance, the entire figure or portions of it include unexplained and unacknowledged modifications—specifically, black lines

and figure labels—that are presented as if they originate from Karasiuk, when they do not.

The left-hand figure below shows what the Petition and expert declaration present as Karasiuk’s Figure 6, including Eunsung’s acknowledged annotations in red. In contrast, the right-hand figure below shows Figure 6 from Ex. 1004 (Karasiuk, Publ. No. 2003/0212415), where the green circles indicate the unacknowledged modifications by Eunsung and its expert.



Eunsung’s Modified Fig. 6
(Pet., 5; Ex. 1003, ¶52)

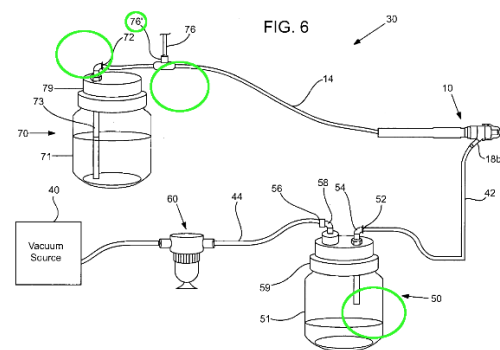
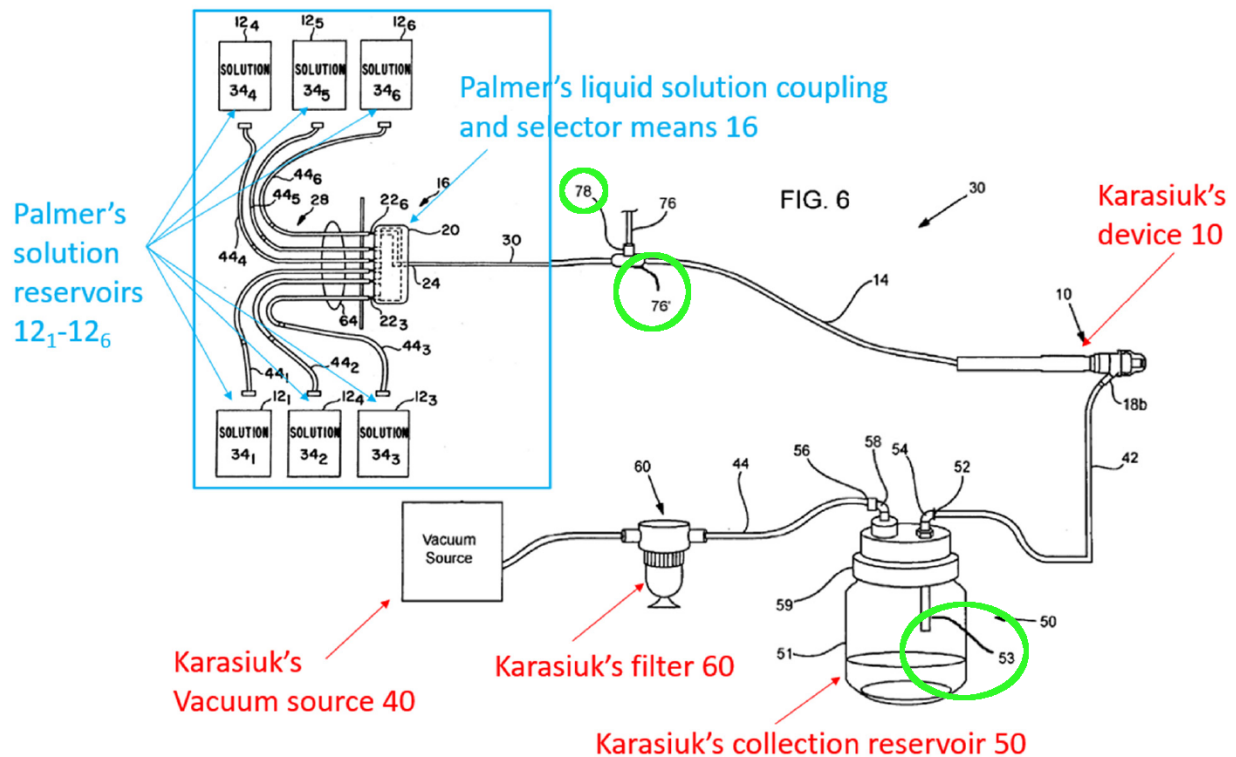


Fig. 6 from Ex. 1004
(green circles indicate
Eunsung’s modifications)

As shown, Eunsung and its expert altered Figure 6 at least by adding lines and labels for item 53 near the collection reservoir 50, adding lines and labels for item 74 near fluid reservoir 70, relabeling item 76’ as item 78, and adding a line and label for item 76’ to replace the relabeled item 78. In turn, the Petition relied on analysis in the expert declaration that cites to and emphasizes mentions of at least one of these

structures—item 53. Pet., 31 (citing Ex. 1003, ¶131 (referencing “extension tube 53”)), 36-37 (citing Ex. 1003, ¶140 (referencing “extension tube 53”)).

These unexplained and unacknowledged modifications carry over to the Petition’s mash-up combination of Karasiuk and Palmer, which similarly includes the added line and label for item 53, the relabeled item 78, and the added line and label for item 76’ replacing the relabeled item 78—as identified by green circles added by HydraFacial to the following figure from the Petition and expert declaration:



Pet., 8; Ex. 1003, ¶76 (green annotation by HydraFacial).

Eunsung and its expert presented these black line modifications and annotations as if they were part of Karasiuk’s original disclosure. This misleads the Director, Board, and HydraFacial as to what Karasiuk actually discloses, and raises concerns about what other unexplained and unacknowledged modifications may have been included in the Petition but remain unidentified. Such uncertainty undermines the credibility of Eunsung’s reliance on the evidence. *See* 37 C.F.R. § 11.18(c) (“By presenting to the Office ... any paper, the party ... is certifying that ... [t]he allegations and other factual contentions have evidentiary support.”). Further, the testimony of Eunsung’s expert should be given little to no weight as unreliable and failing to disclose the underlying facts on which the opinion is based. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

The Director, Board, and HydraFacial should not be expected to undertake the burden of reviewing the Petition for improperly modified evidence. “A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.” *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999). Rather than requiring the Board or HydraFacial to identify further such issues during the merits review process or an IPR proceeding, the Director should exercise discretion and deny institution.

III. CONCLUSION

For the foregoing reasons, HydraFacial respectfully requests that the Director discretionarily deny institution of the Petition.

Respectfully submitted,

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Dated: May 12, 2025

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CERTIFICATE OF TYPE-VOLUME LIMITATIONS
UNDER 37 C.F.R. § 42.24

The undersigned certifies that the foregoing **BRIEF IN SUPPORT OF PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL** contains 5,625 words, exclusive of the parts exempted as provided in 37 C.F.R. § 42.24(a), and therefore complies with the type-volume limitations of 37 C.F.R. § 42.24(a).

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **BRIEF IN SUPPORT OF PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL** is being served on May 12, 2025, via email pursuant to 37 C.F.R. § 42.6(e), to counsel for Patent Owner as addressed below:

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