

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

EUNSUNG GLOBAL CORP.,
Petitioner,

v.

HYDRAFACIAL LLC,
Patent Owner.

IPR2025-00445 (Patent 9,550,052 B2)
IPR2025-00452 (Patent 12,053,607 B2)
IPR2025-00453 (Patent 11,446,477 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Referring the Petitions to the Board

IPR2025-00445 (Patent 9,550,052 B2)
IPR2025-00452 (Patent 12,053,607 B2)
IPR2025-00453 (Patent 11,446,477 B2)

HydraFacial LLC (“Patent Owner”) filed a request for discretionary denial (Paper 8, “DD Req.”) in the above-captioned cases, and Eunsung Global Corp. (“Petitioner”) filed an opposition (Paper 12, “DD Opp.”).¹

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

The challenged patents in IPR2025-00452 and IPR2025-00453 have not been in force for a significant period of time (issued in 2024 and 2022, respectively). Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to those challenged patents, and the Petitions are referred to the Board.

The patent challenged in IPR2025-00445, on the other hand, issued in 2017, and this would ordinarily favor denying institution. However, in reviewing Patent Owner’s arguments under 35 U.S.C. § 325(d) and Petitioner’s response, Petitioner provides persuasive reasoning, supported by evidence, that discretionary denial under § 325(d) is not appropriate due to a material error in examination.

In determining whether to discretionarily deny a petition under § 325(d), Office policy requires a determination of “(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 first part of the framework is

¹ Unless indicated otherwise, citations are to papers in IPR2025-00445. The parties filed similar papers in IPR2025-00452 and IPR2025-00453.

IPR2025-00445 (Patent 9,550,052 B2)
IPR2025-00452 (Patent 12,053,607 B2)
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satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

Petitioner’s arguments that the Office materially erred are persuasive. In particular, during prosecution of the patent challenged in IPR2025-00445, the patent examiner identified a feature that was missing from the prior art. DD Opp. 15–21. Although the patent examiner determined that Karasiuk² was pertinent but did not disclose the allowable features, Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings in Karasiuk that appear to disclose the allowable features of the claims. *Id.* Discretionary denial is not appropriate for this reason.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are referred to the Board to handle the cases in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s request for discretionary denial is *denied*;

FURTHER ORDERED that the Petitions are referred to the Board;
and

² US Pub. 2003/0212415, pub. Nov. 13, 2003 (Ex. 1004).

IPR2025-00445 (Patent 9,550,052 B2)
IPR2025-00452 (Patent 12,053,607 B2)
IPR2025-00453 (Patent 11,446,477 B2)

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

IPR2025-00445 (Patent 9,550,052 B2)
IPR2025-00452 (Patent 12,053,607 B2)
IPR2025-00453 (Patent 11,446,477 B2)

FOR PETITIONER:

Jeremy J. Monaldo
Sangki Park
Jay Zhu
FISH & RICHARDSON P.C.
jjm@fr.com
spark@fr.com
jzhu@fr.com

For PATENT OWNER:

Ali S. Razai
Benjamin J. Everton
Benjamin B., Anger
Alexander B. Stein
Jacob L. Peterson
MORGAN, LEWIS & BOCKIUS LLP
ali.razai@morganlewis.com
ben.everton@morganlewis.com
ben.anger@morganlewis.com
alexander.stein@morganlewis.com
jacob.peterson@morganlewis.com