

HYDRAFACIAL LLC,

Plaintiff,

v.

AESTHETIC MANAGEMENT
PARTNERS, LLC and AESTHETIC
MANAGEMENT PARTNERS INC.,

Defendants.

patent, the ‘641 Patent, and the ‘642 Patent. Plaintiff notified Defendants that it would also file a complaint with the International Trade Commission (“ITC”) asserting some of the same patents. Defendants have not yet answered or otherwise responded to the Complaint in this case.

On August 6, 2024, Plaintiff filed a Complaint against Defendants with the ITC under Section 337 of the Tariff Act of 1930 alleging that Defendants’ AQUAFIRME™ product infringes the ‘052 Patent and the ‘287 Patent (collectively, “the ITC Patents”). Plaintiff supplemented its ITC complaint on August 16, 2024.

On September 5, 2024, the ITC issued a Notice of Investigation (“Notice”) regarding institution of an investigation involving the ITC Patents. See Ex. A. The Notice lists each Defendant in this case as a named Respondent.

II. LAW AND ARGUMENT

Under 28 U.S.C. § 1659, a district court “shall stay” parallel litigation “until the determination of the Commission becomes final” if certain conditions are met. 28 U.S.C. § 1659(a). First, the civil action must “involv[e] parties that are also parties to a proceeding before the [ITC].” *Id.* Second, the claims for which the stay is requested must “involve[] the same issues” as those before the ITC. *Id.* Third, the stay must be requested by a respondent before the ITC within thirty days of being named as a respondent before the ITC. *Id.*

Each of these requirements is met here. First, the Parties to this action are also parties to the ITC action. Second, the claims for which the stay is requested involve the same issues as those before the ITC. The first and third claims involve the same patents as those before the ITC, with the same asserted patent claims that relate to skin treatment systems. Plaintiff’s second, fourth and fifth claims for relief are based on patents that are in the same family as the ITC Patents and involve overlapping subject matter. Plaintiff’s second claim for relief under the ‘477 Patent is based on

claims to skin treatment systems that have some overlapping features with the claims of the ITC patents. Plaintiff's fourth and fifth claims for relief under the '641 Patent and the '642 Patent relate to removable tips that are used with skin treatment systems, like those claimed in the ITC patents. Third, the stay is being requested within thirty days after Defendants were named as respondents in the ITC action on September 5.

In addition, to the extent the Court determines that the issues raised by the second, fourth, and fifth claims do not sufficiently overlap with the issues in the ITC action, such that a stay is not mandatory under 28 U.S.C. § 1659, the Court should exercise its discretion to grant a stay. *See* H.R. Rep. No. 103-826(I), at 141 (stating that after granting mandatory stay under Section 1659(a), "[t]he district court may use its discretionary authority to stay any other claims in the action before it"). As other courts have recognized, "Congress explicitly intended that district courts should consider using their discretionary power to stay patent infringement litigation that is related to, but not duplicative of, an action before the ITC." *Aliphcom v. Fitbit, Inc.*, 154 F. Supp. 3d 933, 937 (N.D. Cal. 2015) (quoting *Zenith Elecs. LLC v. Sony Corp.*, 2011 WL 2982377, at *2 (N.D. Cal. July 22, 2011)). Where the non-overlapping patents-in-suit are part of the same patent family as those in the ITC action, courts regularly find that a stay of all proceedings is appropriate. *See, e.g., Flexsys Ams., LP v. Kumho Tire, U.S.A., Inc.*, 2005 WL 1126750, at *3 (N.D. Ohio Apr. 29, 2005) (staying case as to all patents, including those not asserted in the ITC action, given likely overlap in claim construction, invalidity, and relevant prior art between the ITC case and the civil action).

Here, all Parties join in the request for a stay of all causes of action and agree that a stay until a final determination of the ITC investigation will simplify the disputes and proceedings before this Court. Of the five patents asserted in this case, two are asserted in the ITC and the other three are in the same patent family. Thus, there are likely to be overlapping and related claim

construction, infringement, and invalidity assertions in this case and the ITC action. Further, this case is in its infancy, and staying it pending resolution in the ITC action will avoid piecemeal, duplicative litigation and promote judicial economy.

III. CONCLUSION

For the foregoing reasons, the Parties jointly request that the Court stay these proceedings in their entirety until the ITC's determination becomes final.

Respectfully submitted,

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