

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AESTHETIC MANAGEMENT PARTNERS, LLC AND AESTHETIC
MANAGEMENT PARTNERS, INC.,
Petitioner,

v.

HYDRAFACIAL LLC,
Patent Owner.

Case No. IPR2025-01217
Patent No. 11,446,477

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

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LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Pat. No. 11,446,477 to Ignon (“the ’477 patent”)
1002	Excerpts from the Prosecution History of the ’477 patent (“the Prosecution History”)
1003	Declaration of Mr. Eric Simon
1004	U.S. Patent Publication No. 2003/0212415 (“Karasiuk”)
1005	U.S. Patent No. 5,199,604 (“Palmer”)
1006	U.S. Patent Publication No. 2003/0093089 (“Greenberg”)
1007	U.S. Patent No. 6,390,815 (“Pond”)
1008	U.S. Patent No. 6,684,880 (“Trueba”)
1009	U.S. Patent No. 4,512,764 (“Wunsch 1982”)
1010	U.S. Patent Publication No. 2003/0018252 (“Duchon”)
1011	U.S. Patent No. 4,215,476 (“Armstrong”)
1012	Friedman, et al., Chemical peels, dermabrasion, and laser therapy, Disease-a-Month 55.4 (2009): 223-235 (“Friedman”)
1013	Burgess, Cheryl M., Cosmetic dermatology, Heidelberg, Germany: Springer, 2005 (“Burgess”)
1014	Pickering, J. A., Touch-sensitive screens: the technologies and their application, International Journal of Man-Machine Studies 25.3 (1986): 249-269 (“Pickering”)
1015	Friedman, Mark J. et al., The AMSA injection: A new concept for local anesthesia of maxillary teeth using a computer-controlled injection system. Quintessence Int 29 (1998): 297-303 (“Friedman 1998”)
1016	Lee, Woan-Ruoh, et al., Lasers and microdermabrasion enhance and control topical delivery of vitamin C, Journal of investigative dermatology 121.5 (2003): 1118-1125 (“Lee”)
1017	U.S. Patent No. 6,162,232 (“Shadduck”)
1018	U.S. Patent Publication No. 2001/0049511 (“Coleman”)
1019	U.S. Patent No. 6,428,518 (“Brengele”)
1020	U.S. Patent No. 4,559,036 (“Wunsch”)
1021	U.S. Patent No. 4,559,036 (“Wunsch”)
1022	U.S. Patent No. 5,163,902 (“Lynn”)
1023	U.S. Patent No. 5,190,525 (“Oswald”)
1024	U.S. Patent No. 6,673,082 (“Mallett”)

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1025	Rajan, Poonam, et al., Skin barrier changes induced by aluminum oxide and sodium chloride microdermabrasion, <i>Dermatologic surgery</i> 28.5 (2002): 390-393 (“Rajan”)
1026	Karimipour, Darius J., et al., Molecular analysis of aggressive microdermabrasion in photoaged skin, <i>Archives of dermatology</i> 145.10 (2009): 1114-1122 (“Karimipour”)
1027	U.S. Patent No. 6,241,739 (“Waldron”)
1028	Lacey, Gerard, and Kenneth M. Dawson-Howe. "The application of robotics to a mobility aid for the elderly blind." <i>Robotics and Autonomous Systems</i> 23.4 (1998): 245-252.
1029	Nayler, Gordon. <i>Dictionary of mechanical engineering</i> . SAE International, 1996 (“Nayler”)
1030	Card, Stuart K., Jock D. Mackinlay, and George G. Robertson. "A morphological analysis of the design space of input devices." <i>ACM Transactions on Information Systems (TOIS)</i> 9.2 (1991): 99-122.
1031	U.S. Patent No. 3,930,598 (“Slagle”)
1032	Excerpts from the Prosecution History of the ’052 patent (“the ’052 Prosecution History”)
1033	U.S. Pat. No. 9,550,052 to Ignon (“the ’052 patent”)
1034	Declaration of Harold Walbrink
1035	D.I. 80, Scheduling Order, <i>HydraFacial LLC v. Aesthetic Management Partners, LLC</i> , No. 2:24-cv-02480 (W.D. Tenn. Jul. 29, 2025)
1036	RESERVED
1037	RESERVED
1038	D.I. 19, Joint Motion to Invoke the Statutory Stay, <i>HydraFacial LLC v. Aesthetic Management Partners, LLC</i> , No. 2:24-cv-02480 (W.D. Tenn. Aug. 12, 2024)
1039	Table of currently pending cases where Patent Owner HydraFacial asserts the ’052 patent against other parties
1040	Timelines Illustrating the Relevant Events In Eunsung IPRs and AMP IPRs

The '477 patent was just referred to a merits panel on July 10, 2025 because the Director found that it “ha[s] not been in force for a significant period of time (issued in ... 2022). Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial.” *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00453, Paper 14, 2 (Dir. July 10, 2025) (*Eunsung*).

The Director also found that even an IPR on related U.S. Patent No. 9,550,052 should be referred to a merits panel, despite having issued in 2017, because “Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings in Karasiuk that appear to disclose the allowable features of the claims ... ***Discretionary denial is not appropriate for this reason.***”¹ *Id.*, 3. That finding applies equally to the '477 patent, which is closely related to and shares a common specification with the '052 patent, and has claims that PO has repeatedly emphasized are substantially similar to those of the '052 patent. Paper 7 (“Req.”), 2. The examiner of the '477 patent never applied Karasiuk.

Prior to the Director’s referral, the Petitioner herein (“AMP”) filed an identical petition despite having the right to file a completely different and independent challenge. Days after the July referral—with this duplicate understudy petition already pending—Patent Owner (“PO” or “HydraFacial”) settled the prior IPR to avoid a merits review.

¹ In this brief, emphasis is added unless otherwise indicated.

Given the limited duration of this patent’s existence coupled with patent examiner’s material error in allowing substantially similar claims—already identified to the public by the Director—the Board is uniquely positioned to address the unpatentability of the ’477 patent claims in a single matter, thus avoiding duplicative litigation and potentially inconsistent results as PO continues to prosecute suits on the ’477 patent against numerous defendants in district courts around the country (*i.e.*, Florida, Delaware, California, Tennessee, and Nevada). EX1039; *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23, 2 (Dir. July 2, 2025) (rejecting discretionary denial because an IPR is more efficient than multiple district court cases separately addressing validity).

Unable to dispute that the error identified by the Director still stands, PO reaches on ancillary issues like settlement discussions, the failure of which resulted in the filing of this petition. Req., 4. But the petition was timely, and petitioners should not be penalized for engaging patent owners in good-faith negotiations, which would chill this desirable conduct. In any event, PO has no settled expectations in a patent the Director has *already* identified as reflecting material error relative to the exact same IPR grounds.

PO also argues that a 2023 district court decision and a 2025 preliminary ITC decision, both involving a different party, undermine the Director’s prior referral. Req., 5-13. The 2023 decision involved a different defendant and different prior art; it addressed *none* of this petition’s prior art. The ITC decision also involved different parties and a different record. Neither provides any reason to disturb the Director’s decision that discretionary denial is unwarranted.

I. AMP TIMELY AND APPROPRIATELY FILED ITS PETITION BEFORE THE DIRECTOR’S DECISION

A. Petitioner Filed Its Understudy Petition Early

Like the Director, AMP also found the prior petition persuasive, and in the name of efficiency filed a duplicate petition and a Contingent Motion for Joinder.² Petitioner’s filing deadline would have been September 29, 2025 (30 days after institution of Eunsung’s IPR), 35 U.S.C. §§ 315(b)-(c); 37 CFR § 42.122(b)—but Petitioner elected to file on July 7, 2025, several months early, as shown in the following timeline. *See also* EX1040, 2.



² Because the Eunsung proceeding settled, the joinder contingency is now moot.

The present petition can now be considered on its own.

In short, Petitioner acted diligently, without even awaiting feedback from the Director on an identical petition. Petitioner took this same approach in other IPRs against HydraFacial patents, including IPR2025-00145 and IPR2025-01169. Petitioner consistently elected not to wait until institution or for Director feedback, instead filing understudy petitions months earlier than necessary. EX1040. Petitioner's consistently proactive, early filings are the opposite of the "delay and gamesmanship" argued by PO. Req., 4-5.

B. Petitioner's Understudy Petition Appropriately Followed the Grounds of the Prior Petition

PO criticizes Petitioner for filing a "near-verbatim copy" of Eunsung's earlier IPR petition. Req., 4, 7. But Petitioner merely followed the Office's requirements when, as here, a petition is accompanied by a joinder petition under Section 315(c). Paper 3, 1. Section 315(c) "does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1335 (Fed. Cir. 2020). Indeed, the "[f]actors that the Board may consider in deciding a motion for joinder include ... whether a new ground of unpatentability is raised in the second petition, how the cost and schedule of the first proceeding will be impacted if joinder is granted, and whether granting joinder will add to the complexity" of the proceeding. Consolidated Trial Practice Guide (2019) ("CTPG"), 76.

Essentially, PO is arguing that Petitioner should have presented grounds completely different from those in Eunsung’s petition, thus creating vastly more work for the Board. PO’s argument contradicts Office policy and would frustrate the Board’s efficiency.

C. Petitioner Should Not Be Penalized for Good-Faith Settlement Negotiations Relative to a Patent Demonstrating Material Error

PO further argues that engaging in settlement discussions instead of immediately filing an IPR “strongly favors discretionary denial.” Req., 4-5. To the contrary, the Office’s guidelines and decisions have delineated strong policy reasons to encourage settlement efforts between parties, as early resolution (*e.g.*, pre-institution, as Petitioner sought) conserves resources of the Board, the parties, and the courts. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” CTPG, 86. These policies are even more pronounced when an agency proceeding could be avoided altogether.

After being sued, Petitioner acted reasonably and prudently in seeking a negotiated resolution before filing a petition on a patent that is subject to the same material error identified by the Director in Eunsung’s IPR on the closely-related ’052 patent. If negotiations had succeeded, no IPR would have been needed. Petitioner’s good-faith settlement negotiations align with the Office’s policy and should not be weighed in favor of discretionary denial.

**D. The Director Has Confirmed that the Three-Year-Old
'477 Patent Does Not Give Rise to Settled Expectations**

The Director has already found that there are no “settled expectations that favor discretionary denial” because the ’477 patent “ha[s] not been in force for a significant period of time (issued in ... 2022).” *Eunsung*, Paper 14, 2. Indeed, the Board and the Director have consistently found no “settled expectations that favor discretionary denial” for patents of this vintage; to the contrary, “early challenges favor robust, predictable patent rights and weigh against discretionary denial.” *Microsoft Corp. v. Edge Networking Sys., LLC*, IPR2025-00619, Paper 12, 2 (Dir. July 31, 2025) (“issued in ... 2020”); *Intas Pharms. Ltd. v. Atossa Therapeutics, Inc.*, IPR2025-00799, Paper 12, 2 (Dir. Aug. 29, 2025) (“issued in 2022”).

PO’s reliance on *GenghisComm* (Req., 3) is misplaced. In that case, discretionary denial was driven by the fact that the IPR final written decision was expected six months after the district court trial. *Samsung Elecs. Co., v. GenghisComm Holdings, LLC*, IPR2025-00780, Paper 11, 2 (Dir. Aug. 14, 2025). Here, the federal district court in the Western District of Tennessee (“WDTN”) has not even set a trial date yet. These considerations relate to the *Fintiv* analysis. *Infra* § IV.B. PO offers no reason for the Director to reach a different conclusion regarding the issue of “settled expectations.”

**E. Settled Expectations Do Not Exist When
Material Error Has Already Been Identified**

While Petitioner's early challenge already confirms the same outcome as the Director reached in *Eunsung*, PO's settled expectation arguments also ignore that there cannot possibly be such expectations where the Director has already identified material error in the examination of the 052 patent, which PO acknowledges is "from the same family as the '477 Patent with substantially similar claims." Req., 2. Indeed, the only reasonable expectation here is that the '477 patent remains suspect on the Karasiuk-based grounds until the agency can review the identified material error. PO's attempt to pull the rug out from under the agency's review only amplifies the need to move forward. In this IPR, PO faces only the same review that the Director already concluded was appropriate, as this petition was already pending and is identical to the first *Eunsung* petition.

The understudy petition here is substantively identical to the previous petition as is required for joinder practice. CTPG, 76. *Compare* Paper 2, 1, with *Eunsung*, Paper 2, 1. Petitioner used the same arguments, supported by an expert declaration that "adopted the positions and opinions set forth in EUNGUNG-1003, the declaration of Eric Simon." Paper 2, 1 n.1. As *Eunsung* previously explained, the prior art combinations were not previously considered (*Adv. Bionics* Part 1), *see Eunsung*, Paper 12, 3-10, and the Office materially erred in overlooking Karasiuk's teachings and not applying the combinations (*Adv. Bionics* Part 2).

Id., 10-20. Evaluating the evidence, the Director concluded, as to the '052 patent (and the same conclusion applies, by extension, to the '477 patent): “Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings in Karasiuk that appear to disclose the allowable features of the claims.” *Eunsung*, Paper 14, 2-3. The error recognized in that referral is identically present here.

In evaluating discretionary denial, settled expectations cannot outweigh material error. *Id.*, 2-3 (“Discretionary denial is not appropriate” in view of error); *Anthony, Inc. v. ControlTec LLC*, IPR2025-00559, Paper 12, 2 (Dir. July 16, 2025) (rejecting discretionary denial for patents 17+ years old because material examiner error was shown). Rather, “it is an appropriate use of Office resources” to review the examiner’s material error. *Anthony*, Paper 12, 2.

II. PRIOR PROCEEDINGS CONFIRM THE PETITION’S MERIT

A. The Pending '287 Patent IPR Makes Institution Here Particularly Efficient, Weighing Against Discretionary Denial

PO admits the '477 patent is “part of a close patent family that includes the '052 and '287 Patents—each of which recite substantially similar claim limitations.” Req., 5. When it moved to stay its district court litigation against AMP, PO admitted—indeed, insisted—that “the '477 Patent is based on claims to skin treatment systems that have some overlapping features with the claims of the ['052 and '287] patents,” which are likely to present “overlapping and related claim construction, infringement, and invalidity assertions.” EX1038, 2-4.

Given the admitted similarities, the Board’s decision to institute IPR with respect to the ’287 patent strongly supports institution of IPR for the ’477 patent, and provides yet another reason why the concept of “settled expectations” makes no sense here. IPR2025-00145, Paper 12 (Institution Decision), 17-18, 21-22 (PTAB June 2, 2025) (“[W]e conclude there is a reasonable likelihood that Petitioner will succeed in demonstrating that claims 1-3, 8-12, 14-16, 22, 23, 26, 28, 29, 34-37, 39, 40, and 45 of the ’287 patent are rendered obvious by the combined disclosures of Karasiuk and Palmer,” and that “claims 1-10, 12, 17-20, 22-26, 28-36, and 40-44 are rendered obvious by ... Karasiuk, Palmer, and Trueba.”). Referring the ’477 patent to the merits panel would be an efficient use of resources given the Board’s ongoing review of the closely-related ’287 patent. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 2 (Dir. Jul. 16, 2025) (in view of prior IPR, “it is an efficient use of Board resources to address the related patent”); Memorandum Regarding Interim Processes for PTAB Workload Management,³ 2-3 (past PTAB consideration of validity is one factor in aiming to “improve PTAB efficiency”).

³ <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

**B. The *Cartessa* Summary Judgment Decision Is Irrelevant;
It Involved None of Petitioner’s Prior Art References**

PO relies on a 2023 decision in the *Cartessa* litigation, in which the Eastern District of New York granted summary judgment of no invalidity over U.S. Patent No. 6,162,232 (“Shadduck”). EX2067, 2. The *Cartessa* decision is irrelevant. The present petition does not rely on Shadduck at all, and not a single one of the prior art references used in the present petition were at issue in *Cartessa*. Further, while Shadduck lacked a manifold (Req., 6-7; EX2067, 5-6), the Palmer reference relied upon herein for the manifold limitation plainly discloses a manifold as Eunsung explained in its opposition to PO’s discretionary denial motion (IPR2025-00445, Paper 12, 23-27), and as the Director implicitly agreed when declining to discretionarily deny Eunsung’s petition. *Id.*, Paper 14. A prior decision that addresses none of the references at issue here cannot plausibly create “settled expectations” on the part of PO.

**C. The ITC Decision Was Based on a Different Record
and an Argument PO Has Never Made to the Board**

**1. The So-Called “Non-Analogous Art”
Doctrine Underlying the ITC Decision Is
So Weak PO Has Never Argued It to the Office**

The ITC decision addressed by PO is an initial determination by an Administrative Law Judge, subject to review by the ITC either at the request of a party or on the Commission’s own motion. 19 C.F.R. §§ 210.42-210.44.

As PO concedes, the initial determination was based on a conclusion that Palmer and Trueba are not so-called “analogous art.” Req., 9. Further, the ALJ’s “motivation-to-combine” analysis for Karasiuk and Palmer was also premised on the idea that Palmer is not “analogous art.” EX2161, 157 (“Cartessa’s obviousness argument fails at the outset because Palmer is not analogous art.”).

The “non-analogous art” argument is *so weak that PO has never raised it to the Office*. The ALJ based the “non-analogous art” finding on the erroneous conclusion that Palmer is limited to dental applications (EX2161, 150) when it broadly discusses “delivering a selected one of multiple liquid solutions to a treatment site” *not* limited to teeth. EX1005, Title (“to a treatment site”), Abstract (same), 1:10-15 (“to treatment sites, *such as* in connection with periodontic procedures”), 2:48-51 (“to a treatment site”), 2:52-56 (same), 2:57-62 (same), 2:63-66 (same), 3:3-8 (same), 3:9-14 (same), 3:15-26 (same), 4:50-68 (same).

To qualify as analogous art, a reference need only be “from the same field of endeavor” *or* “reasonably pertinent” to the invention. *In re Bigio*, 381 F.3d 1320, 1325-26 (Fed. Cir. 2004) (toothbrush is “analogous art” with respect to hair brush). The ALJ’s manifestly erroneous conclusion that Palmer’s multiple-container arrangement is not reasonably pertinent to use at skin “treatment sites” in no way suggests that the present petition lacks merit. Indeed, PO never raised this argument when defending Eunsung’s IPR on the ’052 patent. IPR2025-00445,

Paper 8 (Discretionary Denial Brief: no mention of “non-analogous art”); Paper 10 (Patent Owner Preliminary Response: no mention of “non-analogous art”). PO likewise failed to raise it—and thus waived it—in defending AMP’s IPR on the ’287 patent. IPR2025-00145, Paper 23 (Patent Owner Response: no mention of “non-analogous art”). If anything, the fact that the lynchpin of the ALJ’s initial determination is absent from all Patent Office proceedings on this patent family reinforces the suspect nature of these patents’ claims.

Additionally, Mercier (used in IPR Grounds 1C and 1F) and Wunsch (used in IPR Grounds 1D-1F) were not before the ITC, and thus the combinations in IPR grounds 1C-1F were not at issue in the ITC. EX2163, 13; EX2161.

2. Alleged Commercial Success From a Different Proceeding, on a Different Patent, Against a Different Party, Provides No Reason to Discretionarily Deny the Present Petition

Before the ITC, in a case not involving Petitioner, PO argued that it enjoyed commercial success with a nexus to the ’287 patent claims based on the use of “multiple treatment containers.” That is exactly what the prior art Palmer reference shows. EX1005, Fig. 1 (showing six solution containers), Abstract (“a plurality of solution reservoirs, each including a quantity of respective liquid solution, a handpiece, a selector valve for fluidly coupling the handpiece to a selected one of the liquid solutions...”). As a matter of law, nexus cannot arise from prior art.

Tokai Corp. v. Easton Enter., 632 F.3d 1358, 1369-70 (Fed. Cir. 2011).

Further, secondary considerations cannot overcome a strong case of obviousness. *Genentech, Inc. v. Sandoz Inc.*, 55 F.4th 1368, 1378 (Fed. Cir. 2022). Here, the Board already concluded, when instituting IPR on the '287 patent, that “a person of ordinary skill in the art would have had a reasonable expectation of success” in combining Karasiuk’s skin treatment system with Palmer’s six solution reservoirs. IPR2025-00145, Paper 12, 18.

PO’s argument that secondary considerations trump this simple combination is based on a different proceeding not involving Petitioner, addressing a different patent (the '287 patent rather than the '477 patent), based on a higher standard of proof for patent invalidity (clear and convincing evidence rather than the preponderance standard that applies here). Given that Petitioner had no opportunity to address the issue, PO’s alleged secondary considerations do not provide a reasonable basis for discretionary denial. *Microsoft Corp. v. Interdigital Patent Holdings, Inc.*, IPR2024-00305, Paper 12, 23 (PTAB May 10, 2024) (instituting IPR: “because Petitioner has yet to have an opportunity to consider or challenge Patent Owner’s secondary considerations evidence, we decline to consider it for purposes of deciding whether to institute trial.”).

3. The ITC ALJ's Analysis of Greenberg Does Not Undermine the Director's Referral

PO argues a previous ITC finding related to the Greenberg reference as relevant to discretionary considerations here—it is not. Req., 9-10. The Greenberg reference is applied in only 2 of the 6 IPR grounds presented in the petition. Even accepting PO's representations with respect to the ALJ's analysis as true, and they are not, the Director has already found the other 4 grounds of the petition based on Karasiuk (and not including Greenberg at all) as demonstrating material error. *Eunsung*, Paper 12, 3. And PO has emphasized both to the agency and to the courts that the '477 claims are substantially similar to the '052 claims. Of course, PO is free to present the ITC ALJ's findings at trial to rebut the Greenberg grounds, but at this stage, this Greenberg argument has no bearing on the previous identification of material error relative to the Karasiuk grounds.

III. HYDRAFACIAL'S REMAINING ARGUMENTS ARE MERITLESS

A. HydraFacial's Alleged Investment Is Conclusory and Irrelevant

PO argues that that an “extraordinary amount of investment” can correlate to “settled expectations.” *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9, 2 (Dir. July 24, 2025). Of course, in that same case the Director found that the patent owner failed to demonstrate such extraordinary investment, and in fact the Director referred one of the challenged patents to a merits panel. *Id.*, 2-4.

The same is true here. PO's argument is based on domestic industry from an ITC proceeding, which presents a low bar. *Wuhan Healthgen Biotech. Corp. v. Int'l Trade Comm'm*, 127 F.4th 1334, 1338-39 (Fed. Cr. 2025) ("inexpensive" product development may still establish a domestic industry). There is no evidence of "extraordinary" investment by PO.

B. PO Misrepresents Mr. Walbrink's Testimony

Mr. Walbrink testified clearly that Palmer's "selector means" has multiple inlets connecting it to multiple liquid solution reservoirs. EX2164, 74-75. PO offers no explanation why Palmer's selector means is not a manifold. Req., 13-14. As best understood, PO imagines a use that somehow transforms Palmer's manifold structure to a non-manifold structure. This transformative use theory is baseless. Indeed, this argument has already been rejected. In the prior IPR, PO also argued that Palmer lacked a manifold (IPR2025-00453, Paper 11, 14-19), Eunsung explained the flaws in PO's argument (*Id.*, Paper 12, 22-29), and the Director implicitly agreed with Eunsung when declining to discretionarily deny Eunsung's petition. *Id.*, Paper 14. Mr. Walbrink's cited testimony is fully consistent with the grounds presented in the petition and the Director's prior decision.

IV. THE FINTIV FACTORS DISFAVOR DISCRETIONARY DENIAL

Discretionary denial under *Apple v. Fintiv*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) ("*Fintiv*") is unwarranted.

A. Factor 1: The Board Will Not Speculate on a Stay

Contrary to PO's insinuation, AMP *will* file a stay motion in the near future, even prior to institution of this IPR, given that the '287 patent is already subject to IPR and PO admits the '287 and '477 patents overlap heavily. *Supra* § II.A. PO's contention that Judge Lipman is unlikely to grant a stay misrepresents her comments at the hearing in question. After explaining that the AMP matter is her first patent infringement case (EX2158, 4) she expressed openness to considering a stay and provided guidance on what she would like to see in AMP's stay motion. EX2158, 178 ("I'm not interested in trying to make either side spend money that they shouldn't have to spend ... what I would want to know in a stay – in a motion for a stay is what does the process look like that I'm staying the case for? What's the length of time ... So if I could hear a little bit of things related to that if you end up moving. That would be helpful.").

Further, the Board has consistently refused to speculate on future-filed stays, and treats Factor 1 as neutral when no stay has been formally requested. *See, e.g., Home Depot U.S.A., Inc. v. Sec. Tech., LLC*, IPR2024-01420, Paper 12, 43-44 (Mar. 24, 2025) (treating Factor 1 as neutral: "If Petitioner were to file a motion to stay ... we decline to speculate how the district court would rule on such a motion."); *Ericsson Inc. v. XR Commc'ns LLC*, IPR2024-00868, Paper 8, 28 (Dec. 13, 2024) (same). Therefore, Factor 1 is neutral.

B. Factor 2: There Is No Trial Date

As PO acknowledged, there is no trial date set in the district court case. Req., 15. The lack of a trial date disfavors discretionary denial. *OnePlus Techs. (Shenzhen) Co., v. Pantecch Corp.*, IPR2025-00762, Paper 9, 2 (Dir. Sept. 12, 2025).

Further, per the district court’s scheduling order, trial will occur about 331 days after a *Markman* ruling (EX1035), some time after the February 27, 2026 claim construction hearing. EX2158, 174. In short, a district court trial is likely to occur no earlier than Spring 2027—well after a final written decision in this IPR.

PO’s reliance on the *Cartessa* cases is misplaced because Petitioner is not a party to those cases. *Dolby Labs. v. Intertrust Techs.*, IPR2020-00665, Paper 11, 15-17 (Feb. 16, 2021) (Fintiv Factor 2 weighed against denial, despite pre-FWD trial in Texas, because petitioner “Dolby is not a party to the Texas Actions”).

Factor 2 weighs against discretionary denial.

C. Factor 3: The District Court Case Is at an Early Stage

This factor disfavors discretionary denial because “a significant portion of work remains to be done in the district court proceeding.” *Protect Animals With Satellites LLC v. OnPoint Sys., LLC*, IPR2021-01483, Paper 11, 15 (Mar. 4, 2022). While the parties have engaged in limited fact discovery and exchanged initial contentions, the vast bulk of the work lies ahead. AMP has not yet deposed any of the ’477 patent inventors, nor has AMP deposed a single HydraFacial employee.

Markman briefing has not begun, the *Markman* hearing is not scheduled until February 27, 2026, fact discovery will not close until 90 days after a *Markman* ruling, expert discovery will not even open until 120 days after a *Markman* ruling, and dispositive motions are even farther away. EX1035. In similar circumstances the Board has consistently found that *Fintiv* Factor 3 disfavors discretionary denial. *Protect Animals With Satellites*, Paper 11, 15 (Factor 3 disfavored discretionary denial where “the completion of fact and expert discovery and dispositive motions” still lay in the future).

D. Factor 4: No Overlap Between IPR and Litigation

Factor 4 concerns “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, Paper 11, 6. Under Factor 3, PO focuses on the district court case between PO and Petitioner in the WDTN. In that litigation, there will be ***no overlap at all*** because, by the time of the district court trial, Petitioner will be subject to estoppel based on the final written decision in this matter under Section 315(e)(2). Accordingly, Factor 4 strongly disfavors discretionary denial.

Presumably for this reason, PO shifts gears under Factor 4, ignores the WDTN case, and instead argues overlap between this IPR and the Cartessa ITC case. Req., 18. But there is also zero overlap between this IPR and the ITC case, in which PO asserted only the '287 patent and not the '477 patent, with respect to which the Director already found the patent examiner committed material error.

Further, as discussed *supra* § II.C.1, the ITC’s analysis of the prior art focused on the so-called “non-analogous art” doctrine, which PO has never even tried to argue to the Office—once again confirming no overlap.

Factor 4 thus strongly disfavors discretionary denial.

E. Factor 5: Neutral Because the Parties Are the Same

Where the IPR and litigation involve the same parties, factor 5 is neutral. *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9, 20-21 (Oct. 21, 2020) (granting institution).

Presumably for this reason, PO again ignores the WDTN case when discussing Factor 5, and instead argues overlap between this IPR and the ITC case between PO and Cartessa, in which PO asserted only the ’287 patent.

Trying to suggest that AMP and Cartessa are “coordinating their litigation efforts” like the parties in *Fitbit Inc. v. Philips N. Am. LLC*, IPR2020-00828, Paper 13, 15-16 (PTAB Nov. 3, 2020), PO argues that AMP “now seeks to relitigate” Cartessa’s arguments “by using Cartessa’s Karasiuk- ... based invalidity contentions.” Req., 18-19. To the contrary, as PO admits elsewhere, AMP followed the Office’s requirements and duplicated *Eunsung’s* IPR petition, filing the petition herein as an understudy with a contingent joinder motion. Req., 4 (AMPs “petition is a near-verbatim copy of an IPR filed by Eunsung.”). With respect to Cartessa, PO acknowledges that “AMP was not a party in *Cartessa ITC*.” Req., 19.

Further, given that the Director has already identified a material error, it would disserve the public interest to discretionarily deny this petition simply because an unrelated party used similar prior art in an unrelated proceeding before a different tribunal, and PO rushed to terminate the prior IPR before the Office could complete its review of the error.

F. Factor 6: The Merits Are Particularly Strong

Factor 6 weighs strongly against discretionary denial (indeed, arguably outweighs all other factors) because the Director has already identified a material error in another IPR (*Eunsung*, IPR2025-00445) against the closely-related '052 patent with substantially similar claims. IPR2025-00445, Paper 14, 2-3.

Further, as discussed *supra* § II.A, the Board has instituted IPR on the '287 patent, which PO acknowledges overlaps heavily with the '477 patent.

Under Factor 6, “if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution ... [which] may serve the interest of overall system efficiency and integrity.” *Fintiv*, Paper 11, 14-15. Therefore, Factor 6 weighs strongly against discretionary denial.

V. CONCLUSION

Discretionary denial is unwarranted. A merits review should be undertaken.

Date: October 17, 2025

Respectfully submitted,
/Scott A. McKeown/

Scott A. McKeown, Reg. No. 42,866
WOLF, GREENFIELD & SACKS, P.C

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on October 17, 2025, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

Ali S. Razai	ali.razai@morganlewis.com
Benjamin J. Everton	ben.everton@morganlewis.com
Benjamin B. Anger	ben.anger@morganlewis.com
Jacob L. Peterson	jacob.peterson@morganlewis.com

MLB-HydraFacial-IPR-477-2@morganlewis.com

Date: October 17, 2025

/MacAulay Rush/
MacAulay Rush
Paralegal
WOLF, GREENFIELD & SACKS, P.C.