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Paper 20
Date: August 20, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JEISYS MEDICAL INC.,
Petitioner,

v.

SERENDIA, LLC,
Patent Owner.

IPR2024-00463
Patent 10,869,812 B2

Before SHERIDAN K. SNEDDEN, CARL M. DEFRANCO, and TINA E. HULSE, *Administrative Patent Judges*.

DEFRANCO, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Serendia, LLC ("Serendia") is the owner of U.S. Patent No. 10,869,812 B2 (Ex. 1001, "the '812 patent"). Jeisys Medical Inc. ("Jeisys") and Ilooda Co., Ltd., ("Ilooda") filed a petition for *inter partes* review of claims 1–20 of the '812 patent. *See* Paper 1 ("Pet."). Ilooda subsequently settled its dispute with Serendia, and we dismissed Ilooda as a petitioner. *See* Paper 13.

In due course, Serendia filed a preliminary response, including both public and confidential versions.[1] *See* Papers 14, 16, respectively ("Prelim. Resp."). Per our authorization, Jeisys filed a reply (Paper 17, "Pet. Reply"), and Serendia followed with a sur-reply (Paper 18, "PO Sur-Reply").

Notably, with its preliminary response, Serendia filed a statutory disclaimer of claims 1, 7, 10–12, 17, 19, and 20 of the '812 patent.[2] *See* Ex. 2144 (dated May 13, 2024). As such, those claims are no longer part of this proceeding (*see* 37 C.F.R. § 42.107(e)), leaving only dependent claims 2–6, 8, 9, 13–16, and 18 at issue. Exercising our jurisdiction under 35 U.S.C. § 314(a), we institute *inter partes* review of those remaining claims.

I. BACKGROUND

A. Related Matters

This is Jeisys's first (and only) petition challenging the '812 patent. However, another entity, Cartessa Aesthetics, LLC ("Cartessa"), filed an earlier petition in December 2021, which we denied. *See Cartessa Aesthetics, LLC v. Serendia, LLC*, IPR2022-00377, Paper 9 (PTAB June 28, 2022).

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[1] Unless otherwise noted, this decision refers to the public version.
[2] In its preliminary response, Serendia also identifies claim 6 as being disclaimed. Prelim. Resp. 34 n.3; *see also id.* at 46 n.4. But, as filed, the statutory disclaimer does not indicate that to be the case. *See* Ex. 2144, at 3.

The '812 patent is currently the subject of a proceeding before the International Trade Commission, filed March 1, 2023, and captioned *Certain Dermatological Treatment Devices and Components Thereof*, No. 337-TA-1356 ("the ITC proceeding"). The respondents in the ITC proceeding include Cartessa, Jeisys, Ilooda, and numerous others. *See* Paper 5; *see also* Prelim. Resp. 4–5.

The '812 patent is also the subject of several federal district court actions, some of which are stayed pending the outcome of the ITC proceeding and some of which have been dismissed—

- *Serendia, LLC v. Cutera, Inc.*, No. 1:23-cv-00222 (D. Del.)
- *Serendia, LLC v. Cynosure, LLC*, No. 1:23-cv-00223 (D. Del.)
- *Serendia, LLC v. EndyMed Medical, Inc.*, No. 1:23-cv-00224 (D. Del.)
- *Serendia, LLC v. Lutronic Aesthetics, Inc.*, No. 1:23-cv-00225 (D. Del.) (dismissed Jan. 22, 2024)
- *Serendia, LLC v. Rohrer Aesthetics, Inc.*, No. 1:23-cv-00226 (D. Del.) (dismissed Oct. 20, 2023)
- *SynKloud Technologies, LLC v. Aesthetics Biomedical, Inc.*, 2:22-cv-15 (D. Ariz.) (dismissed Nov. 21, 2023)
- *SynKloud Technologies, LLC v. Sung Hwan E&B Co., Ltd.*, 6:21-cv-811 (W.D. Tex.) (dismissed Nov. 26, 2023)
- *SynKloud Technologies, LLC v. Cartessa Aesthetics, LLC*, No. 2:21-cv-4423 (E.D.N.Y.) (dismissed Nov. 21, 2023)

See Paper 7.

B. The '812 Patent

The '812 patent relates to a system and method "used in treating dermatological tissue." Ex. 1001, 1:33–35. Figures 2A and 2B of the '812 patent, reproduced below, depict dermatological treatment apparatus 310.

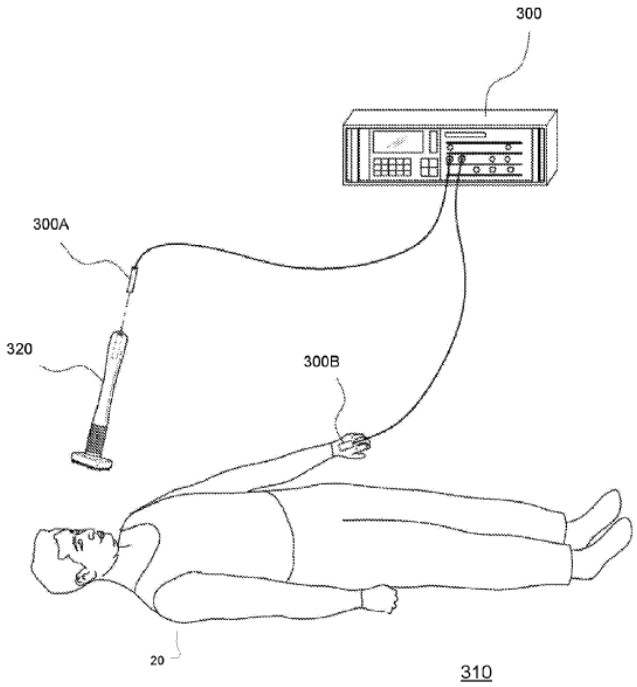

FIGURE 2A

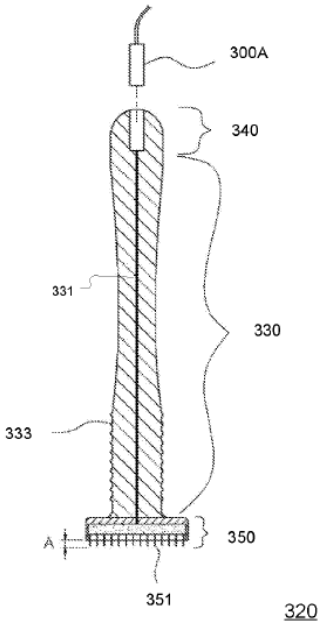

FIGURE 2B

As shown in Figures 2A and 2B, dermatological treatment apparatus 310 includes acupuncture device 320 and signal generator 300 electrically coupled to the device via one or more wires 300A. *Id.* at 3:40–47. Acupuncture device 320 is provided with a plurality of acupuncture needles or pins 351. *Id.* at 3:47–56.

In operation, electrical signal generation system 300 produces electrical signals "to vibrate one or more pins 351 electrically coupled to the system 300 . . . [to] increase the micro-wound or cut formed in dermis by the pin 351." *Id.* at 3:57–62. Pins 351 may be fixed in place, as depicted in Figure 2B above, or movable between a retracted and deployed position, i.e., extendable, as depicted in Figures 9C and 9D below. *See id.* at 2:31–36, 3:47–54, 10:32–11:32.

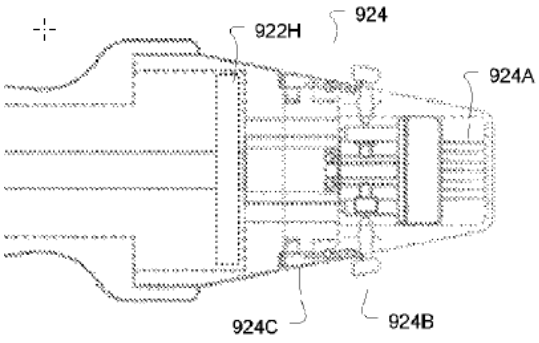

FIGURE 9C

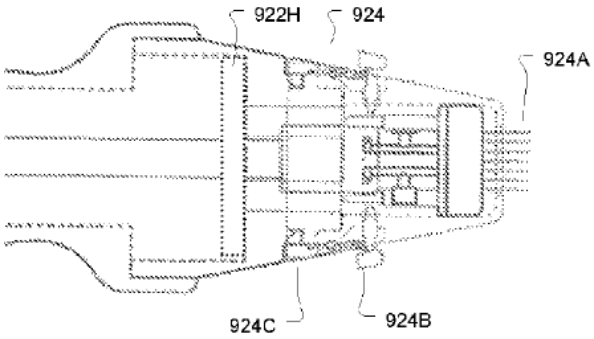

FIGURE 9D

As shown, Figure 9C depicts the dermatological treatment apparatus with the needles retracted, and Figure 9D depicts the apparatus with the needles deployed.

C. Challenged Claims

Of the challenged claims remaining in the '812 patent, claims 2–6, 8, and 9 are method claims, whereas claims 13–16 and 18 are apparatus claims that are counterparts of the method claims. Apparatus claim 13 (and its base claim 12) are illustrative of the claimed subject matter and are reproduced below.

> 12. An apparatus for treating dermatological tissue, comprising:
>
> a user holdable device including a proximal end and a releasably couplable deployable needle module, the releasably couplable deployable needle module mechanically separatably from the user holdable device proximal end and including a needle assembly including a plurality of needles,
>
> the needle assembly movable within the releasably couplable deployable needle module to extend the plurality of needles from the releasably couplable deployable needle assembly end surface while at least one electrical contact of the needle assembly remains electrically coupled to at least one electrical contact of the user holdable device proximal end.

> 13. The apparatus of claim 12, further including a motor coupled to the needle assembly to *extend the plurality of needles a desired distance* from the releasably couplable deployable needle assembly end surface when the motor is energized with a particular signal.

Ex. 1001, 16:45–64 (emphasis added).

D. Asserted Challenges

Claims Challenged[3]	**35 U.S.C. §**	**Basis**
2, 3, 6, 8, 13–16	102	Mehta[4]
2–6, 8, 13–16	103	Mehta and POSA[5]
4, 5	103	Mehta, Na,[6] and POSA
2, 3, 6, 8, 13–16	103	Mehta, Lee,[7] and POSA
4, 5	103	Mehta, Lee, Na, and POSA
9, 18	103	Mehta, Livneh,[8] and POSA

In further support of these challenges, Jeisys relies on the declaration of Dany Bérubé, Ph.D. *See* Ex. 1003. Serendia submits rebuttal declarations from Peter Crosby (Ex. 2140) and Vincent Thomas (Ex. 2141).

II. DISCRETIONARY DENIAL UNDER *GENERAL PLASTIC*

In its preliminary response, Serendia argues that we should discretionarily deny the petition under the Board's precedential decisions in

[3] As mentioned earlier, claims 1, 7, 10–12, 17, 19, and 20 are no longer at issue in this proceeding due to Serendia's statutory disclaimer.
[4] US 8,608,737 B2, issued Dec. 17, 2013 (Ex. 1006, "Mehta").
[5] We understand Jeisys's use of the term "POSA" here to mean the general knowledge of a person of ordinary skill in the art.
[6] WO 2010/016848 A1, published Feb. 11, 2010 (Ex. 1007, "Na").
[7] Korean Registered Utility Model No. KR20-0441552, published Aug. 25, 2008 (Ex. 1008 (original), Ex. 1009 (certified translation), "Lee").
[8] WO 2010/0168848 A1, published Feb. 11, 2010 (Ex. 1010, "Livneh").

General Plastic[9] and *Valve*[10] because Jeisys has a "significant relationship" with Cartessa, the earlier petitioner of the '812 patent and a co-respondent with Jeisys in the related ITC proceeding. *See* Prelim. Resp. 6–10; PO Sur-Reply 2–5. In support, Serendia highlights Cartessa's and Jeisys's collaboration in preparing and filing a joint proposed schedule, joint expert report, and joint invalidity defenses in the ITC proceeding, as well Jeisys's reliance on the same invalidity expert as the one proffered in the ITC proceeding. *See* Prelim. Resp. 8–10 (citing Exs. 2004, 2016–18, 2125). Serendia also contends that "[a]dditional relevant and extenuating facts and circumstances" evidence a significant relationship because:

> (1) Cartessa and Jeisys "are part of the same RF micro-needling manufacturing and distribution community";
>
> (2) Jeisys "was on notice of its infringement of the '812 patent" before Cartessa filed the earlier petition; and
>
> (3) Jeisys engaged in "tactical delay" by "being aware of the asserted prior art in the current petition "more than seven months" prior to filing the petition.

See id. at 9–10 (citing, respectively, Ex. 2021; Exs. 2023, 2052; Ex. 2053).

Jeisys disputes the existence of any significant relationship with Cartessa, arguing it "[n]either . . . had control over the Cartessa Aesthetics IPRs, participated or provided input into the Cartessa Aesthetics IPRs, or had knowledge of them prior to their being filed," but filed the present petition on its own behalf and not on behalf of anyone else. Pet. 85 (citing

[9] *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential) ("*General Plastic*" or "*GP*").
[10] *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential) ("*Valve*").

Valve). In further support, Jeisys points us to the Director's recent decisions in *Ford*[11] and *Videndum*.[12] *See* Pet. Reply 3–5.

At the outset, we note that the Director's decisions in *Ford* and *Videndum* clarified the Board's application of the *General Plastic/Valve* framework. For instance, in *Ford*, the Director explained that "[u]nder existing Office policy and precedent, the Board does not recognize a 'significant relationship' between parties [i.e., serial petitioners] having different accused products that merely engage in *court-ordered* pretrial coordination." *Ford*, at 9 (emphasis added). And, in *Videndum*, the Director further explained that where "the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* factor one necessarily outweighs the other *General Plastic* factors." *Videndum,* at 6–7. Thus, per *Ford* and *Videndum*, we will not discretionarily deny a later petition in view of an earlier petition where the earlier and later petitioners are neither the same party nor have a significant relationship.

After reviewing the record, we find that no significant relationship exists with Cartessa to justify application of the *General Plastic/Valve* framework. Contrary to Serendia's assertions about the joint submissions of Jeisys and Cartessa in the parallel ITC proceeding (*see* Prelim. Resp. 8–10), the relevant facts and circumstances here are akin to those in *Ford*. More specifically, like the "court-ordered" coordination of the petitioners in *Ford*, the collaboration of Jeisys and Cartessa as co-respondents in the ITC proceeding was *mandated* by the rules of the ITC proceeding, and, thus,

[11] *Ford Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 28 (Vidal Mar. 22, 2024) ("*Ford*").
[12] *Videndum Prod. Sols., Inc v. Rotolight Ltd.*, IPR2023-01218, Paper 12 (Vidal Apr. 19, 2024) ("*Videndum*").

does not alone create the type of "significant relationship" contemplated by *Valve*. *See* Pet. Reply 3–4 (citing *Ford*, at 3; Exs. 1024, 1025); *see also Prime Time Toys LLC v. Spin Master, Inc.*, IPR 2023-01339, Paper 12, at 19–20 (Vidal July 9, 2024) ("*Prime Time Toys*") ("The parties' collaboration as co-respondents in the ITC investigation does not by itself support a finding of a 'significant relationship.'"). As such, Jeisys's knowledge of the prior art asserted in the ITC proceeding and its collaboration with Cartessa on a joint invalidity defense does not create a significant relationship where such knowledge and collaboration arises from the rules of the ITC proceeding itself.

Indeed, after seeing Jeisys's reply brief, Serendia no longer relies solely on the joint collaboration in the ITC proceeding to demonstrate a significant relationship, and, instead, argues that "[o]ther relevant and extenuating circumstances exist here." PO Sur-Reply 2–4. But, to the extent Serendia premises the existence of extenuating circumstances on the argument that Cartessa and Jeisys "are part of the same RF microneedling manufacturing and distribution community" (Prelim. Resp. 19), we are not persuaded. At the outset, we note that Serendia does not dispute Jeisys's assertion that Cartessa and Jeisys are direct competitors selling "different products." *See* PO Sur-Reply 3 (acknowledging Jeisys's assertion without disputing it). Moreover, as was the case with the serial petitioners in *Ford*, there is no evidence here that Cartessa and Jeisys "had any interactions or agreements regarding the implementation of the accused [technology] into their respective accused products" that might rise to the level of "relevant or extenuating facts or circumstances" indicative of a significant relationship. *Ford*, at 10–11; *cf. Valve*, at 10 ("Valve represented that 'HTC's [accused] VIVE devices incorporate certain Valve technologies under a technology

license from Valve,' and that 'Valve employees did provide HTC with technical assistance during the development of the accused VIVE devices.'"). Thus, in the absence of any proof of a license or other technology sharing agreement between Cartessa and Jeisys, we reject the notion that mere overlap of the technologies used in their respective products somehow creates a significant relationship.

We also reject Serendia's reliance on *Mitek Sys., Inc. v. United Servs. Auto. Assoc.*, IPR2020-00882, Paper 29 at 17 (PTAB Nov. 6, 2020) ("*Mitek*"), to argue a significant relationship exists because Jeisys was "aware" of the asserted prior art and was "working hand-in-hand" with Cartessa in the ITC proceeding to develop invalidity contentions "seven months" before filing the current petition. *See* Prelim. Resp. 8–9. In *Mitek*, the finding of a significant relationship centered not merely on the fact of the petitioner's awareness of an earlier petitioner's invalidity contentions, but more critically on the existence of a "customer-supplier relationship" between the first and second petitioners that was "longstanding and deep," as evidenced by a confidential exhibit in that case. *See Mitek*, at 17–21 (redacting actual extent of first and second petitioners' relationship while identifying "ongoing effort" between them "to coordinate [first petitioner's] defense" against infringement). Thus, we do not consider Jeisys's simple knowledge of Cartessa's invalidity contentions in the ITC proceeding as outweighing the lack of any evidence here of an actual joint defense (or similar) agreement between Jeisys and Cartessa.

We have reviewed Serendia's other arguments but find them unpersuasive. In sum, because Jeisys and Cartessa "are neither the same party, nor possess a significant relationship under *Valve*," the first factor of *General Plastic* necessarily outweighs the other *General Plastic* factors such

that exercising our discretion to deny institution is not justified. *Videndum*, at 6–7.

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(d)

Serendia also urges us to deny institution under 35 U.S.C. § 325(d) because "the Petition presents substantially the same art the Office previously analyzed and fails to show the Office materially erred during prosecution" of the '812 patent. Prelim. Resp. 24. According to Serendia, Mehta, which is at the heart of each of Jeisys's asserted challenges, is "nearly identical" to another reference cited on the face of the '812 patent that was purportedly considered during prosecution, namely, "Mehta '705."[13] *Id*. at 25 n.2 (citing Ex. 1011); *see also* PO Sur-Reply 1–2.

Jeisys responds that the Mehta reference serving as the primary basis of its challenges is "materially different" from the Mehta '705 reference cited on the face of the '812 patent in at least one critical respect—Mehta includes disclosure relevant to the disputed "desired distance" limitation that is absent from Mehta '705. Pet. Reply 1–2 (citing Ex. 1006, 32:67–33:3, 33:24–27, 33:30–34, Figs. 10A–10F). As such, Jeisys argues, exercising our discretion under § 325(d) is not justified because Serendia fails to satisfy the first part of the two-part *Advanced Bionics*[14] framework. *See id.* at 2.

We agree with Jeisys. Mehta is *not* substantially the same as Mehta '705. What Mehta '705 omits, but Mehta includes, is an embodiment comprising "graphical user interface 320" and "tissue characteristic indicator 350" that allows a user to monitor the needle's "location" in the tissue so as to decide when the needle is placed at a "desired depth." Ex. 1006, 32:46–

[13] US 8,540,705 B2, issued Sep. 24, 2013 (Ex. 1011).
[14] *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential).

33:29, Figs 10A–10F. Nowhere do we discern a similar embodiment in Mehta '705. At best, Mehta '705 discloses a "display screen" for displaying a "variety of information to the physician . . . such as treatment delivery settings, electrode impedance, electrode temperature, tissue temperature, treatment duration, power delivered, energy delivered, etc." Ex. 1011 (Mehta '705), 29:44–58, Figs. 10A, 10B. But, notably lacking from Mehta '705 is any disclosure of determining the "depth" and "location" of the needle's placement in the tissue, let alone means for doing so, which Mehta discusses at length and upon which Jeisys relies to meet the "desired distance" limitation. *See* Ex. 1006, 32:46–33:61; Pet. 27–28.

Because Mehta includes disclosure relevant to the disputed "desired distance" limitation that is absent from Mehta '705, Serendia fails to satisfy the first part of the *Advanced Bionics* framework. *See Wolfspeed, Inc. v. The Tr. of Purdue Univ.*, IPR2022-00761, Paper 13, at 7–8 (PTAB Mar. 30, 2023) (Vidal, K.) (reference not "substantially the same prior art" when it includes disclosure relevant to unpatentability grounds not present in references previously before the Office). And to the extent Serendia makes a similar argument with respect to the asserted secondary references of Na, Lee, and Livneh, it is of no consequence given Serendia's failed showing with respect to the *primary* reference of Mehta.[15] Thus, we decline to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

[15] We also reject Serendia's assertion that Jeisys's expert in the ITC proceeding admitted that "the Mehta reference" was considered by the Office. *See* Prelim. Resp. 25 (citing Ex. 2125, at 62:4–9). It is unclear from the transcript whether the expert was referring to the Mehta patent identified on the face of the '812 patent or the Mehta patent forming the basis of Jeisys's challenges.

IV. ASSERTED CHALLENGES

A. Level of Ordinary Skill in the Art

Jeisys proposes, and Serendia agrees, that we should adopt the level of ordinary skill in the art as defined in the parallel ITC proceeding, that is,

> (1) 7–10 years of experience with developing and/or *using treatment systems for delivery of electromagnetic radiation energy to skin or other tissues*, and (2) a related graduate engineering degree or M.D. . . . [and] may have worked as part of a multidisciplinary team and drawn upon not only his or her own skills, but also would have taken advantage of certain specialized skills of others on the team when solving a technical problem.

Pet. 11 (citing Ex. 1005, at 14); Prelim. Resp. 33 (accepting Jeisys's definition of the level of skill in the art). For purposes of this proceeding, we see no reason to depart from that definition, as it appears consistent with the level reflected in the asserted prior art.

B. Claim Construction

The parties dispute the construction of "desired distance" as recited in claims 2, 8, and 13. *See* Pet. 11; Prelim. Resp. 34; Pet. Reply 8. On the one hand, Jeisys argues that the term "simply distinguishes between needles that extend or are extendable a *desired distance* as opposed to an *undesired distance*." Pet. 11–12. According to Jeisys, the "desired distance" limitation "can be met by programming the system to extend the needles to a desired distance *or* by using . . . non-adjustable needles of 'a particular needle length.'" Pet. Reply 8. In support, Jeisys notes the parties' agreed-upon construction in the parallel ITC proceeding that "needles 'extending' a desired distance from the surface covers non-extendable needles having a fixed length." Pet. 12 (citing Ex. 1005, at 16).

Serendia responds that "[t]he particular distance is 'desired' because it is the distance a user decided to select to achieve a particular penetration depth," and, thus, "desired distance" means "how far the needles extend from the device's needle module or needle assembly end surface, *based on a user's selection*, to penetrate dermatological issue." Prelim. Resp. 34–35 (emphasis added); *see also id.* at 37 ("the 'desired distance' is based on a user's selection."). According to Serendia, the specification of the '812 patent supports such a construction by describing a particular embodiment in which "needle deployment motor controller (NDMC) module 911B" controls deployment of needles 924A "based on one or more user selected operational parameters" such as "the depth" for the needles' deployment. *Id.* at 36 (citing Ex. 1001, 10:32–37, 14:14–20; 14:61–65). Serendia also argues that Jeisys's contention regarding the parties' agreed-upon construction in the ITC proceeding "is inapplicable since needles 'extending' is not in the '812 Patent claims," and, thus, "by their plain language exclude 'fixed, non-extendable needles.'" *Id.* at 37 (citing Ex. 1001, claims 2, 8, 13).

We need not formally construe the "desired distance" limitation in order to resolve whether institution is appropriate. That is because, on the current record, the asserted prior art satisfies the "desired distance" limitation regardless of which parties' proposed construction we adopt. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) ("The Board is required to construe 'only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.'") (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Nonetheless, the parties are free to further explore the appropriate construction of "desired distance" at trial, in particular, whether the plain language of the claims limits their scope to extendable needles (as opposed

to fixed needles), and whether construing the "desired distance" limitation as being based on a user's selection improperly reads a preferred embodiment into the claims.

C. Anticipation by Mehta

Jeisys challenges claims 2, 3, 6, 8, and 13–16 as being anticipated by Mehta. *See* Pet. 13, 25–34, 37–39. In doing so, Jeisys provides a detailed mapping of how Mehta satisfies each of the claim elements with supporting testimony from its expert.[16] *See id.* at 13–39 (citing Ex. 1003 ¶¶ 70–138).

We begin with claims 2, 8, and 13, each of which recites the disputed "desired distance" limitation. As discussed above, Serendia construes this claim limitation to mean "how far the needles extend from the device's needle module or needle assembly end surface, *based on a user's selection*, to penetrate dermatological issue." Prelim. Resp. 34–35 (emphasis added). With that construction in mind, Serendia argues that Mehta fails to disclose this limitation because—

> In Mehta, the user does not select how far the needles extend to penetrate dermatological tissue. . . . Mehta instead discloses selecting cartridges having different probe *lengths* or *angles*, not selecting *how far* the probes in a given cartridge extend when used in Metha's [sic] system. . . . Mehta's system is designed for full insertion of the needles by their entire lengths—i.e., they extend a *fixed distance*. . . . Thus, in Mehta, the distance that the needles extend when using a particular cartridge is not selected by the user but rather is determined by the needles' "fixed length."

Id. at 46–47.

[16] We also consider Jeisys's showing for base claims 1 and 12, from which the challenged claims depend. *See* Pet. 14–25 (claim 12), 34–36 (claim 1).

We disagree with Serendia's analysis of Mehta. As Jeisys correctly explains, Mehta discloses the "desired distance" limitation even assuming Serendia's construction of that limitation, i.e., that the needles are extendable to a depth *selected by the user*. *See* Pet. 33. Indeed, although Mehta may not use the term "desired distance" expressly, it comes about as close as one would expect from an anticipatory disclosure. As Jeisys explains, Mehta discloses an embodiment having a graphical user interface 320 ("GUI"), as depicted in Figures 10A–F, for displaying the actual and target depths of needles to avoid placing them in an undesired region. *See id.* at 27–29 (citing Ex. 1006, 10:33–39, 12:5–8, 32:63–33:43; Ex. 1003 ¶¶ 95–98). The GUI, as described, "can provide information for a physician (or other medical staff) to monitor various treatment parameters as well as other information regarding the placement of the array 108 or probes 104 when inserted in the tissue" and "maintain visual contact with the treatment device and tissue being treated." Ex. 1006, 11:1–13. To do so, the GUI incorporates a "tissue characteristic indicator (whether visual, virtual, audible, or other feedback)" that allows the user to monitor the needle's actual location in the tissue and advance the needle to a "desired depth" for providing treatment—

> FIG. 10B illustrates a *tissue characteristic indicator* showing a virtual depiction 350 of the depth or location of the probe array. . . . *[T]he virtual depth/location depiction 350 can illustrate an actual placement of the probe array 340*. . . . [T]he system can be configured to show (or the system can have an option to show) additional probe array information. For example, *the virtual depth/location depiction 350 can also show a desired probe location (e.g., array 342 can represent the desired depth of placement for providing a treatment)*. . . . As shown by FIG. 10B, providing the virtual depth/location depiction 350 allows the physician to not only identify whether

> the array is located within the desired tissue layer but also allows the physician to observe the angle of the electrode array in tissue. . . . *Therefore, the physician would be informed that further advancement of the probes is necessary to place the probes within the second layer 326 (which corresponds to the dermal layer)*.

Id. at 32:46–33:29 (emphases added); *see also id.* at 33:57–66 (further describing "virtual depth/location depiction 350"). Along with the GUI, control system/energy supply unit 90 is provided for allowing the user to selectively control and adjust insertion of the needles based on feedback from the GUI. *See id.* at 10:33–39, 10:53–11:13, 12:5–14, 13:54–14:4, 25:24–29.

Similarly, Mehta discloses that the needle may employ a sensor to assist the user in positioning the needle to the desired depth—

> Referring to Fig. 8A, showing a partial section of a probe 108 placed in tissue 20. . . . The probe 8 contains a sensor 110 near a distal end or on an active area 122 of the probe 108. . . .
>
> Measurement of a tissue parameter by *the sensor 110 provides information that can confirm whether the probe 108 is located in the desired target region*. For example, . . . if the measured impedance is not within a range normally associated with tissue, *the system can prevent treatment and alert the user for the need to reposition the probe 108*. Accordingly, the probe 108 can ultimately be repositioned as shown in FIG. 8B (or the active area 122 of the probe 108 can be repositioned).

Id. at 24:27–45, Figs. 8A–C (emphases added); *see also id.* at 25:16–29 (disclosing sensors for controlling and adjusting needle placement).[17]

Those disclosures by Mehta, either alone or together, would have been understood by one skilled in the art as providing the user with the means to

[17] Mehta also teaches that the user can select a "desired location" by choosing the needle's insertion "angle A." Ex. 1004, 12:31–46, Figs. 2B, 7A, 7B.

select and control the desired depth of the needles into the tissue. *See* Ex. 1003 ¶¶ 95–98. To the extent Serendia believes otherwise, it fails to read Mehta as a whole. Instead, Serendia focuses on Mehta's so-called "cartridge" embodiment having needles of a "fixed length" (*see* Prelim. Resp. 46–48) to the exclusion of Mehta's clear and unambiguous teachings of specific means for selecting and controlling how far the needles are inserted into the tissue, including, for example, "control system/energy supply unit 90," "graphical user interface 320," and "tissue characteristic indicator 350." *See, e.g.*, Ex. 1004, 10:33–39, 10:53–11:13, 12:5–14, 13:54–14:4, 32:16–34:45, Figs. 2A–2D, 3A, 3B, 10A–10F. Thus, based on the current record, we find that Mehta satisfies the "desired distance" limitation of claims 2, 8, and 13, even under Serendia's proposed construction of that limitation.

Serendia does not dispute Jeisys's showing of how Mehta discloses the other limitations of claims 2, 8, and 13, including the limitations of their respective base claims 1 and 12. *See* Prelim. Resp. 45–50, PO Sur-Reply 8–9. In reviewing the record, we find that Jeisys sufficiently shows that Mehta discloses each of those additional limitations. *See* Pet. 14–30, 34–37. Thus, at this stage, Jeisys demonstrates a reasonable likelihood that at least claims 2, 8, and 13 are anticipated by Mehta.

Serendia offers no response to Jeisys's challenge of claims 3, 6, 15, and 16, except presumably to rely on its arguments against Jeisys's challenge of claims 2, 8, and 13. *See* Prelim. Resp. 45–50. Because Jeisys's anticipation challenge satisfies the threshold for institution with respect to claims 2, 8, and 13, we need not address the other claims of this challenge in the absence of any express rebuttal or concession from Serendia. Further analysis is best left for trial after full development of the record.

D. Obviousness Challenges

Jeisys also challenges the claims of the '812 patent as obvious over various combinations of references, all of which rely on Mehta as the base reference and Na, Lee, and/or Livneh as teaching references. *See* Pet. 9, 39–84. Serendia disputes Jeisys's rationale for why one skilled in the art would have been led to modify Mehta's device to include the teachings of Na, Livneh, and/or Lee. *See* Prelim. Resp. 50–61. In doing so, Serendia also presents evidence of secondary considerations, such as commercial success and industry praise of its "Sylfirm X" product, in an effort to prove non-obviousness of the claimed invention. *Id.* at 62–66.

At this preliminary stage, we are not persuaded that Serendia demonstrates a nexus between the claimed invention and the success it attributes to the Sylfirm X product. Notably, Serendia acknowledges that the success of the Sylfirm X product is due only "in part" to the technology claimed in the '812 patent. Prelim. Resp. 65. Indeed, in another proceeding, Serendia contends that commercial success of the Sylfirm X product is due to the so-called "Na effect," which is not claimed in the '812 patent and instead goes to the heart of another one of Serendia's patents. *See* Pet. Reply 9 (citing IPR2024-00386, Paper 13, at 61–63).

"A patent claim is not coextensive with a product that includes a 'critical' unclaimed feature that is claimed by a different patent and that materially impacts the product's functionality." *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1375 (Fed. Cir. 2019). Here, Serendia fails to explain the criticality of the unclaimed "Na effect" to the functionality of the Sylfirm X product. *See* PO Sur-Reply 9–10. Nor does Serendia explain sufficiently how its evidence of commercial success is the "direct result of the unique characteristics of the claimed invention," as opposed to those of the claimed

invention at the heart of Serendia's other patent. *See Fox Factory*, 944 F.3d at 1373–74. Thus, without more from Serendia, we think analysis of this issue is best left for trial after full development of the record. And, because Jeisys's anticipation challenge satisfies the threshold for institution, we do not see the need to further address Jeisys's obviousness challenges in the absence of affording Serendia an opportunity to address the shortcomings in its evidence of secondary considerations.

V. CONCLUSION

For the above reasons, we determine that Jeisys demonstrates a reasonable likelihood of proving that at least claims 2, 8, and 13 are unpatentable as anticipated by Mehta. And because "[e]qual treatment of claims and grounds for institution purposes has pervasive support in *SAS*," we institute on all the claims as challenged in the petition. *See* 37 C.F.R. § 42.108(a), (c); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (citing *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018)).

VI. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review of claims 2–6, 8, 9, 13–16, and 18 of the '812 patent is *instituted*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of trial, which will commence on the entry date of this Decision.

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