

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LUMENIS LTD. and POLLOGEN LTD.  
Petitioners

v.

THE GENERAL HOSPITAL CORPORATION  
Patent Owner

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Case IPR2019-01181  
Patent 9,510,899

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**JOINT MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW**

***Mail Stop “PATENT BOARD”***  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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**PETITIONERS' UPDATED EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
<b>1001</b>	U.S. Patent No. 9,510,899 B2 to Manstein (“’899 patent”)
<b>1002</b>	Prosecution History of U.S. Patent No. 9,510,899 (“’899 PH”)
<b>1003</b>	Prosecution History of U.S. Patent No. 9,095,357 (“’357 PH”)
<b>1004</b>	Prosecution History of U.S. Patent No. 7,824,394 (“’394 PH”)
<b>1005</b>	U.S. Provisional Application No. 60/558,476 (“’476 Provisional”)
<b>1006</b>	Expert Declaration of Dr. Robert E. Grove (“Grove Decl.”)
<b>1007</b>	Dr. Robert E. Grove Curriculum Vitae (“Grove CV”)
<b>1008</b>	U.S. Patent No. 6,277,116 B1 to Utely <i>et al.</i> (“Utely”)
<b>1009</b>	WO Publication No. 02/053050 A1 to Altshuler <i>et al.</i> (“Altshuler”)
<b>1010</b>	U.S. Patent Application Publication No. 2004/0162551 to Brown <i>et al.</i> (“Brown”)
<b>1011</b>	U.S. Patent Application Publication No. 2002/0087155 A1 to Underwood <i>et al.</i> (“Underwood”)
<b>1012</b>	WO Publication No. 2005/007003 A1 to Debendictis <i>et al.</i> (“Debendictis”)
<b>1013</b>	U.S. Patent No. 6,126,657 to Edwards <i>et al.</i> (“Edwards”)
<b>1014</b>	Orentreich, David, <i>et al.</i> , “Subcutaneous Incisionless (Subcision) Surgery for the Correction of Depressed Scars and Wrinkles,” <i>Elsevier Science Inc.</i> (1995) (“Orentreich”)
<b>1015</b>	Pozner, Jason N., <i>et al.</i> , “Nonablative Laser Resurfacing: State of the Art 2002,” <i>Aesthetic Surgery Journal</i> , Vol. 22, No. 5, <i>Scientific Forum</i> (2002) (“Pozner”)

Exhibit No.	Description
<b>1016</b>	Goats, Geoffrey C., “Continuous short-wave (radio-frequency) diathermy,” British Journal of Sports Medicine, Vol. 23, No. 2 (1989) (“Goats”)
<b>1017</b>	Capon, Alexandre <i>et al.</i> , “Can Thermal Lasers Promote Skin Wound Healing?” American Journal of Clinical Dermatology Vol. 4, No. 1 (2003) (“Capon”)
<b>1018</b>	Fitzpatrick, Richard, <i>et al.</i> , “Multicenter Study of Noninvasive Radiofrequency for Periorbital Tissue Tightening,” Lasers in Surgery and Medicine, Vol. 33, No. 4 (2003) (“Fitzpatrick”)
<b>1019</b>	Hsu, Te-Shao, <i>et al.</i> , “The Use of Nonablative Radiofrequency Technology to Tighten the Lower Face and Neck,” Seminars in Cutaneous Medicine and Surgery, Vol. 22, No. 2 (2003) (“Hsu”)
<b>1020</b>	Narins, David, <i>et al.</i> , “Non-Surgical Radiofrequency Facelift,” Journal of Drugs in Dermatology, Vol. 2, Issue 5 (2003) (“Narins”)
<b>1021</b>	U.S. Patent Application Publication No. 2003/0120269 A1 to Bessette <i>et al.</i> (“Bessette”)
<b>1022</b>	U.S. Patent Application Publication No. 2002/0120260 A1 to Morris <i>et al.</i> (“Morris”)
<b>1023</b>	Arnoczky, Steven P., <i>et al.</i> , “Thermal Modification of Connective Tissues: Basic Science Considerations and Clinical Implications,” Journal of the American Academy of Orthopaedic Surgeons, Vol. 8, Issue 5 (2000) (“Thermal Modification”)
<b>1024</b>	U.S. Patent Application Publication No. 2002/0111615 A1 to Cosman <i>et al.</i> (“Cosman”)
<b>1025</b>	Complainants’ Petition for Review of Order No. 21, ITC Litigation 337-TA-1112, filed April 3, 2019 (“Petition for Review”)
<b>1026</b>	U.S. Provisional Application No. 60/486,304 (“304 Provisional”)

<b>Exhibit No.</b>	<b>Description</b>
<b>1027</b>	Isaac Chang, “Finite Element Analysis of Hepatic Radiofrequency Ablation Probes using Temperature-Dependent Electrical Conductivity,” BioMedical Engineering OnLine, (2003) (“Chang”)
<b>1028</b>	Settlement Agreement (CONFIDENTIAL)

## **I. STATEMENT OF RELIEF REQUESTED**

Petitioners Lumenis, Ltd. and Pollogen, Ltd. and Patent Owner The General Hospital Corporation have entered into a confidential Settlement Agreement (Exhibit 1028) that resolves all underlying disputes between Petitioners and Patent Owner with respect to U.S. Patent No. 9,510,899 (“the ’899 patent”). The parties are concurrently filing a separate Joint Request that the Settlement Agreement being filed herewith be treated as business confidential information and be kept separate from the files of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Accordingly, pursuant to 37 C.F.R. § 42.71(a), the parties jointly move the Board to dismiss this *inter partes* petition in its entirety. The Board authorized the parties to file this joint motion to dismiss in an email on July 26, 2019.

## **II. STATEMENT OF FACTS**

On July 12, 2019, Petitioners and Patent Owner entered into a confidential Settlement Agreement. *See* EX1028 (Confidential). Under the terms of the Settlement Agreement, Petitioners and Patent Owner agreed to jointly seek termination of all pending PTAB proceedings where Petitioners and Patent Owner are the adverse parties. A complete listing of all PTAB proceedings for which Petitioners and Patent Owner are seeking termination, along with the status of each PTAB proceeding as of the date of this Motion, is provided below.

<b>PTAB Proceeding</b>	<b>Status</b>
<i>Lumenis, Ltd. et al. v. The General Hospital Corp.</i> , IPR2019-01180 (P.T.A.B. June 6, 2019)	Pending Institution
<i>Lumenis, Ltd. et al. v. The General Hospital Corp.</i> , IPR2019-01181(P.T.A.B. June 6, 2019)	Pending Institution

The '899 patent is also the subject of the following related litigation. No other litigation or proceeding between the parties involving the '899 patent is contemplated.

<b>Litigation</b>	<b>Status</b>
<i>Certain Radio Frequency Micro-Needle Dermatological Treatment Devices and Components Thereof</i> , Inv. No. 337-TA-1112 (Apr. 9, 2018)	Pre-Hearing (for the '899 patent)
<i>Syneron Medical Ltd. et al. v. EndyMed Medical Ltd. et. al.</i> , 1-18-cv-10678 (D. Mass., Apr. 9, 2018)	Stayed, June 13, 2018
<i>Syneron Medical Ltd. et al. v. Illooda Co., Ltd. et al.</i> , 1-18-cv-10679 (D. Mass., Apr. 9, 2018)	Dismissed, Mar. 28, 2019
<i>Syneron Medical Ltd. et al. v. Invasix Inc. et. al.</i> , 1-18-cv-10680 (D. Mass., Apr. 9, 2018)	Dismissed, Feb. 21, 2019
<i>Syneron Medical Ltd. et al. v. Jeisys Medical Inc. et. al.</i> , 1-18-cv-10681 (D. Mass., Apr, 9, 2018)	Dismissed, Mar. 19, 2019
<i>Syneron Medical Ltd. et al. v. Lumenis et. al.</i> , 1-18-cv-10682 (D. Mass., Apr. 9, 2018)	Stayed-Pending Dismissal, June 8, 2019
<i>Syneron Medical Ltd. et al. v. Lutronic, Corp. et. al.</i> , 1-18-cv-10683 (D. Mass., Apr. 9, 2018)	Dismissed, Feb. 5, 2019

Litigation	Status
<i>Syneron Medical Ltd. et al. v. Sung Hwan E&amp;B Co., Ltd. d/b/a Shenb Co. Ltd. et. al.</i> , 1-18-cv-10684 (D. Mass., Apr. 9, 2018)	Dismissed, Mar. 7, 2019

### III. ARGUMENT

The Board has the authority to “dismiss any petition or motion.” 37 C.F.R. § 42.71(a); *see also* 37 C.F.R. § 42.74 (discussing settlement of proceedings).

Termination of a proceeding pursuant to a settlement is authorized and encouraged by statute, regulations, and Board policy, even when those proceedings are closer to a decision on the merits than the present, pre-institution case. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72, 42.74; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012). Dismissal of the present petition for *inter partes* review in its entirety is in the interest of justice.

#### A. The Board Should Dismiss the Petition and Terminate this *Inter Partes* Review.

Public policy favors dismissing the present IPR petition and terminating the proceeding. The federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Bergh v. Dept. of Trans.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Board’s Trial Practice Guide stresses that “[t]here are strong public

policy reasons to favor settlement between the parties to a proceeding.” 77 Fed.

Reg. at 46,768.

Additionally, dismissal of the petition, in view of the Settlement Agreement, is appropriate. The USPTO can conserve significant administrative and judicial resources by dismissing the petition now, removing the need for the Board to review additional briefing by the parties, issue an institution decision, hold oral argument, and render a final written decision. The Board has terminated entire IPR proceedings based on joint motions to terminate, even after the merits had been fully briefed and the matter was ready for oral argument. *See Toyota Motor Corp. v. Blitzsafe Tex. LLC*, IPR2016-00421, Paper 28 at 2-3 (P.T.A.B. Feb. 21, 2017) (granting motion to terminate even after all substantive papers were filed, “particularly in light of the fact that a final written decision is not due until more than four months from now”); *Plaid Techs., Inc. v. Yodlee, Inc.*, IPR2016-00273, Paper 29 at 2 (P.T.A.B. Feb. 8, 2017) (granting motion to terminate because “[t]he parties’ joint motions to terminate were filed prior to the oral hearings in these cases”); *Apex Med. Corp. v. Resmed Ltd.*, IPR2013-00512, Paper 39, at 2-3 (P.T.A.B. Sept. 12, 2014) (granting joint motion to terminate after the parties had fully briefed the matter because “the record is not yet closed, and the Board has not yet decided the merits of this proceeding.”); *Lam Research Corp. v. Flamm*, IPR2015-01764, Paper 27 at 5 (P.T.A.B. Dec. 15, 2016) (granting motion to

terminate after all briefing and oral argument when statutory deadline for rendering final written decision is within two months of motion). The Board has also dismissed petitions to terminate proceedings before institution. *See, e.g., Taiwan Semiconductor Manufacturing Co. Ltd. v. Cohen*, IPR2018-00469, Paper 18 at 2-3 (P.T.A.B. Jul. 20, 2018); *Samsung Electronics Co. Ltd. v. Nvidia Corp.*, IPR2015-01270, Paper 11 at 2-4 (P.T.A.B. Dec. 9, 2015).

Because this proceeding is still at an early stage (i.e., before institution), the expected normal course is to dismiss the petition and terminate the proceeding upon settlement. 77 Fed. Reg. at 48,768 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”).

#### **B. Written Settlement Agreement**

The parties represent that their entire agreement in connection with the termination of this proceeding has been made in writing and is embodied in Exhibit 1028 submitted herewith. There are no other agreements or understandings, oral or written, between the parties beyond those of Exhibit 1028 made in connection with, or in contemplation of, the dismissal of Petitioners’ request for *inter partes* review. To avoid any doubt, the parties hereby certify that they have complied with the requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

Pursuant to 37 C.F.R. § 42.74(c), the parties are filing herewith as Exhibit 1028 a true copy of the complete Settlement Agreement. The Settlement Agreement has been filed for access by the “Parties and Board Only” due to the highly sensitive business confidential information they contain. The parties desire that the Settlement Agreement be maintained as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and a separate joint request for such is being filed concurrently.

#### IV. CONCLUSION

Petitioners and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Dismiss Petition for *Inter Partes* Review and terminate this proceeding in its entirety.

Date: July 26, 2019

Respectfully submitted,

/Robert Greene Sterne/

Robert G. Sterne (Reg. No. 28,912)  
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
Attorney for Petitioners  
Lumenis Ltd. and Pollogen Ltd.

Date: July 26, 2019

Respectfully submitted,

/Joel A. Austin/

Joel A. Austin (Reg. No. 59,712)  
QUARLES & BRADY LLP  
Attorney for Patent Owner  
The General Hospital Corporation

**CERTIFICATION OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that on July 26, 2019, true and correct copies of the foregoing **JOINT MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW** and Exhibit 1028 were served electronically via e-mail in their entirety on the following parties:

Joel A. Austin (Lead Counsel)  
Jack M. Cook (Back-up Counsel)  
Stephen J. Gardner (Back-up Counsel)  
Michael T. Piery (Back-up Counsel)  
QUARLES & BRADY LLP  
[joel.austin@quarles.com](mailto:joel.austin@quarles.com)  
[jack.cook@quarles.com](mailto:jack.cook@quarles.com)  
[stephen.gardner@quarles.com](mailto:stephen.gardner@quarles.com)  
[michael.piery@quarles.com](mailto:michael.piery@quarles.com)  
[DocketAZ@quarles.com](mailto:DocketAZ@quarles.com)

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Robert Greene Sterne/

Robert G. Sterne (Reg. No. 28,912)  
Attorney for Petitioners  
Lumenis Ltd. and Pollogen Ltd.

Date: July 26, 2019  
1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600