

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFEWAVE, INC.,
Petitioner,

v.

EDWARD BLENDERMANN,
Patent Owner.

Case IPR2016-00131
Patent 8,617,590 B2

Before DONNA M. PRAISS, SHERIDAN K. SNEDDEN, and
JON B. TORNQUIST, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

LifeWave, Inc. (“Petitioner”) filed a Petition (Paper 2; “Pet.”) to institute an *inter partes* review of claims 1, 2, 9, 12, 14, 16, and 18 of U.S. Patent No. 8,617,590 B2 (Ex. 1001; “the ’590 patent”). Patent Owner Edward Blendermann (“Patent Owner”) filed a Patent Owner Preliminary Response. Paper 9 (“Prelim. Resp.”). We apply the threshold for review under 35 U.S.C. § 314.

For the reasons provided below, we determine Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’590 patent. *See* 35 U.S.C. § 314(a). We, therefore, deny the Petition for an *inter partes* review.

A. *Related Proceedings*

The parties identify the following co-pending case involving the ’590 Patent: *Edward L. Blendermann v. LifeWave, Inc.*, Case No. 2:15-cv-14265 (S.D. Fla. 2015). Pet. 4; Paper 5.

B. *The ’590 Patent (Ex. 1001)*

The ’590 patent discloses methods for increasing muscle strength by wearing a nutrient holding device (e.g., a necklace or locket) during the performance of physical activity. Ex. 1001, Abstract, 1:9–13. The nutrient may include substance such as vitamins, minerals, amino acids, phytomorphagens, herbs, enzymes, and hormones. *Id.* at 2:63–3:1.

C. Challenged Claims

Challenged claims 1, 2, 9, 12, 14, 16, and 18 of the '590 patent are reproduced below:

1. A method of improving muscle strength and endurance during physical activity (exercise) by wearing a nutrient holding device, said device incorporating a waterproof enclosure containing at least one nutrient, whereby said waterproof enclosure does not contain a magnet, polarizer, sulfur powders or crystals.

2. A method of improving muscle strength and endurance during physical activity by wearing a nutrient holding device containing at least one nutrient whereby the nutrient material is only separated from the body by the covering of said holding device; the thickness of said holding device may be up to 3 mm.

9. A method according to claim 1 where said nutrient is in the form of a solid, powder, gel or liquid.

12. A method according to claim 1 where said nutrients are selected from vitamins, minerals, blue-green algae, essential fatty acid, phytomorphagens, glandulars, amino acids, herbs and hormones.

14. A method according to claim 1 where stimulation occurs at mechanoreceptor sites which are located throughout the surface of the body, thus allowing for multiple placement points for this device.

16. A method according to claim 1 where said waterproof housing acts to preserve the integrity of the enclosed nutrients and also acts as a barrier separating this nutrient material and the skin thereby avoiding any dermatological consequences or any pharmaceutical event.

18. A method of improving muscle strength according to claim 1 by wearing a nutrient holding device in the form of a non transdermal patch that adheres to the body.

Ex. 1001, 10:56–12:26.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1, 2, 9, 12, 14, 16, and 18 of the '590 patent on the following grounds. Pet. 6.

References	Basis	Claim[s] challenged
Amulets ¹	§ 102(b)	1, 2, 9, 12, 14, and 16
The '744 document ²	§ 102(b)	2
Amulets and the '744 document	§ 103(a)	2 and 18

Petitioner relies also on the Declaration of C. Norman Shealy in support of the proposed grounds of unpatentability. Ex. 1015 (“Shealy Decl.”).

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, the Board interprets a claim term in an unexpired patent according to its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1275–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). Under that standard, and absent any special definitions, we assign claim terms their ordinary and customary meaning, as would be

¹ How To Make Amulets, Charms And Talismans: What They Mean and How to Use Them (Lippman, ISBN 0806515724). Ex. 1005 (“Amulets”).

² Chinese Patent Application Publication CN1133744A. Ex. 1003, the English translation of which is Ex. 1004 (“the '744 document”).

understood by one of ordinary skill in the art at the time of the invention, in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Only terms that are in controversy need to be construed, however, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

We interpret the following terms of the challenged claims as part of our analysis. The Petition does not require explicit construction of any other claim term at this time. *See, e.g., Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs.*, 200 F.3d at 803).

1. “*method of improving muscle strength and endurance during physical activity*”

The preambles of independent claims 1 and 2 recite a “method of improving muscle strength and endurance during physical activity by wearing a nutrient holding device.” We recognize that, in general, “[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering–Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). “But, . . . preamble language will limit the claim if it recites not merely a context in which the invention may be used, but the essence of the invention without which performance of the recited steps is nothing but an academic exercise.” *Id.* (citing *Griffin v. Bertina*, 285 F.3d 1029, 1033 (Fed. Cir. 2002)).

In *Boehringer*, for example, the Federal Circuit found the “growing and isolating . . . virus” language of a preamble was limiting because “‘growing’ and ‘isolating’ are not merely circumstances in which the method may be useful, but instead are the *raison d’être* of the claimed method itself.” *Boehringer*, 320 F.3d at 1344–45. Without the preamble, the court found that “the claimed method [was] reduce[d] to nothing more than a process for producing cytopathic effects in sheets of cultured MA–104 cells—a process whose absence of fathomable utility rather suggests the academic exercise.” *Id.* at 1345. The court thus recognized that one of ordinary skill in the art would not understand the utility of the process without the “growing” and “isolating” language of the preamble.

We conclude that, as in *Boehringer*, one of ordinary skill in the art would not understand the utility of the process of the challenged claims, viewed in light of the Specification, without the preamble language of the claims. The body of each of independent claims 1 and 2 is absent any clear language indicating that the utility of the invention is improving muscle strength and endurance during physical activity. As such, we find the preamble of the claim recites the essence of the invention and states an essential limitation to the claims.

Moreover, we note that during the prosecution of the ’590 patent, the utility of the claimed invention for improving muscle strength was relied upon by applicant to assert patentability of the claims (Ex. 1006,³ 192) and also relied upon by the examiner in determining that the claimed method

³ Prosecution History of the ’590 patent.

was free of the prior art (*id.* at 37). *See In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1347 (Fed. Cir. 2002) (“Clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention.”).

2. “*the thickness of said holding device may be up to 3 mm*”

Petitioner argues that the phrase “thickness of said holding device may be up to 3 mm” recited in claim 2 is reasonably construed to encompass a thickness of the holding device over 3 mm. Pet. 19–20. We disagree. Rather, we agree with Patent Owner that “[t]he inclusion of ‘up to’ signifies that the word ‘may’ is being used in the *restrictive*, not *permissive*, manner.” Prelim. Resp. 18. Petitioner’s proposed construction would read the element out of the claim, which is improper. *See Texas Instruments, Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (Claim language cannot be mere surplusage. An express limitation cannot be read out of the claim).

B. Law of Anticipation

To prevail in its challenges to the patentability of the claims, a petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 314(a); 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A claim is unpatentable under 35 U.S.C. § 102 if a prior art reference discloses every limitation of the claimed invention, either explicitly or inherently. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047 (Fed. Cir. 1995); *see MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999) (holding that “[t]o anticipate, a single reference

must teach every limitation of the claimed invention,” and any limitation not taught explicitly must be taught inherently and would be so understood by a person experienced in the field); *In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991) (the dispositive question is “whether one skilled in the art would reasonably understand or infer” that a reference teaches or discloses all of the elements of the claimed invention).

The principle of inherency, in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. We note, however, that “anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation, [or the reference] cannot inherently anticipate the claims.” *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 (Fed. Cir. 2002) (internal citation omitted); see *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 (Fed. Cir. 2001) (“[C]onsistent with the law of inherent anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art”) (citations omitted); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (that a feature in the prior art reference “could” operate as claimed does not establish inherency).

C. Petitioner's Asserted Anticipation and Obviousness Grounds

1. Ground 1: Anticipation of Claims 1, 2, 9, 12, 14, and 16 by Amulets

Petitioner contends that claims 1, 2, 9, 12, 14, and 16 are anticipated by Amulets (Ex. 1005). Pet. 20–30. In support of its assertion that Amulets anticipates the challenged claims, Petitioner further provides a detailed discussion on how each limitation of the challenged claims is disclosed in Amulets. Pet. 24–30. For at least the reasons discussed below, we are not persuaded that Petitioner has presented sufficient evidence to establish that Amulets discloses all limitations of claims 1, 2, 9, 12, 14, and 16.

a. Petitioner's contention that Amulets discloses a “method of improving muscle strength and endurance during physical activity” is not supported by sufficient evidence

Petitioner contends that “Amulets discloses that amulets are protectors from disease, **increase strength** and virility, and protect from specific dangers.” Pet. 20 (citing Ex. 1005, 9). Petitioner directs our attention to the Mercurial (or Mercurian) amulet disclosed in Amulets, which is “to be worn on the upper throat to provide protection from ailments to the throat region like respiratory infections involving sore throat, and other ailments.” *Id.* (citing Ex. 1005, 125–26).

Petitioner contends that the disclosure of the Mercurial amulet inherently meets the limitation for a “method of improving muscle strength and endurance during physical activity” in independent claims 1 and 2. Petitioner reasons that “protection from ailments to the throat region like respiratory infections involving sore throat . . . improves muscle strength and

endurance during physical activity.” *Id.* at 25 (citing Shealy Decl. ¶¶ 27–31).

Patent Owner notes that Amulets discloses wearing the Mercurian amulet as a means to protect the user from sore throats and canker sores, but argues that Amulets does not disclose wearing the Mercurial Amulet during exercise. Prelim. Resp. 25. Patent Owner further argues that sore throats may result from causes unrelated to a respiratory infection, and as such, “[p]rotection from sore throats could be wholly unrelated to respiratory infections.” *Id.* at 28 (citing Ex. 2004⁴). In this regard, Patent Owner notes that Petitioner’s expert merely testifies that sore throats “are a sign of respiratory infection,” not that all sore throats are caused by respiratory infection. *Id.* (citing Shealy Decl. ¶ 32). Patent Owner thus contends that Petitioner’s inherency theory fails “because Petitioner has not presented evidence to demonstrate that reducing sore throats will ‘necessarily’ result in the reduction of respiratory infections.” *Id.* at 27.

We find Patent Owner to have the better position. In particular, we are not persuaded that the practice of the methods disclosed in Amulets necessarily results in a method of improving muscle strength and endurance during physical activity. Nothing in Amulets suggests wearing the Mercurian amulet during physical exercise or for the purpose of improving strength. Nor does Petitioner present evidence that a wearer of the Mercurian amulet necessarily would perform some form of exercise while

⁴ Mayo Clinic, Sore Throat Causes, available at <http://www.mayoclinic.org/diseases-conditions/sore-throat/basics/causes/con-20027360> (last visited Feb. 1, 2016)

wearing the amulet.

It is well established that “[n]ew uses of old products or processes are indeed patentable subject matter.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1378–79 (Fed. Cir. 2005) (finding a patent claiming a new use of a composition for the treatment of sunburn patentable over prior art disclosing the composition but not suggesting the application of the compound to the skin—“there is an important distinction between topical application to skin for the purpose of avoiding sunburn, and the much narrower topical application to skin sunburn.”); *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (holding that principles of inherency do not prohibit a process patent for a new use of an old structure). The facts of this case, as presented by Petitioner, fall squarely within this principle.

Furthermore, Petitioner fails to provide sufficient evidence to establish that the maintenance of good health necessarily leads to improved muscle strength, as compared to, for example, maintaining the status quo. On this record, we are unable to distinguish between, for example, improvement of muscle strength and the lack of diminishment of muscle strength due to illness.

In view of the above, we find that Petitioner has failed to establish that Amulets inherently discloses a “method of improving muscle strength and endurance during physical activity” as required by the challenged claims.

b. Petitioner’s contention that Amulets discloses a “device incorporating a waterproof enclosure” is not supported by sufficient evidence

With regard to the recitation of “said device incorporating a waterproof enclosure” in claim 1, Petitioner contends that “the Mercurian

amulet is formed in part by two layers of [polyester] resin which combine to form a waterproof enclosure.” Pet. 25; *see also id.* at 23 (“the layers of resin form a layer of material that lies on the surface of the seeds, herbs, and tortoise shell, and surrounds the seeds, herbs, and tortoise shell, thereby forming a covering or housing that is waterproof.”); Ex. 1005, 4. Petitioner reasons that polyesters are plastics and that “[p]lastic is known to be waterproof.” Pet. 24.

Patent Owner argues that “Petitioner offers no support for this statement beyond a conclusory statement that polyester resin is plastic and that plastic is waterproof.” Prelim. Resp. 29 (citing Pet. 24).

We find Patent Owner to have the better position. Petitioner fails to provide sufficient evidence to establish that the container disclosed in Amulets would have been recognized as waterproof to a person of ordinary skill in the art. Moreover, Patent Owner presents evidence to show that resins, including polyester, will both absorb water and allow water to “pass through them in vapor form” due to osmotic effects. Ex. 2005, 2.

c. Amulets fails to disclose the requirement of a “thickness of said holding device may be up to 3 mm”

Petitioner argues that Amulets discloses the element of claim 2 requiring that “the thickness of said holding device may be up to 3 mm” based on its proposed claim construction that the phrase “may be up to 3 mm” encompasses a thickness of the holding device over 3 mm. Pet. 28. As set forth above, we decline to adopt this claim construction. Petitioner has failed otherwise to establish that the device disclosed in Amulets has a thickness of up to 3 mm.

2. *Ground 2: Anticipation of Claim 2 by the '744 Document*

Petitioner contends that claim 2 is anticipated by the '744 document (Ex. 1004). Pet. 30–37. Petitioner directs our attention to the following teachings of the '744 document. *Id.*

The present invention relates to a self-sticking magnetic plastic patch, characterized in that a magnetic plastic piece 2 is attached on a medical adhesive substrate 1, with a water-proof surficial film 3 covered on the magnetic plastic piece, and Chinese or Western medicine 5 is arranged between the magnetic plastic piece 2 and the water-proof surficial film 3. The self-sticking magnetic plastic patch of the present invention has the functions of *relieving pain, reducing inflammation, reducing blood pressure and antidiarrheal and so on*. The clinical experiment results are good, the efficiency is higher than 85 percent, and the self-sticking magnetic plastic patch of the present invention is safe and reliable without side effects, easy to use, soft and comfortable, and can be affixed to any part of the body and acupuncture points.

Ex. 1004, 1:6–9 (emphasis added). The '744 document further discloses that “the self-sticking magnetic plastic patch can eliminate pain, numbness and slowness.” *Id.* at 3:4–7.

Petitioner argues that using the patch disclosed in the '744 document for “relieving pain, reducing inflammation, reducing blood pressure” and for eliminating “pain, numbness, and slowness” inherently meets the element for “[a] method of improving muscle strength and endurance during physical activity” as recited in claim 2. Petitioner reasons as follows:

One or more of these effects would produce an improvement in muscle strength and endurance during physical activity. For

example, ***at least*** pain relief would increase muscle strength and endurance.

Pet. 35 (citing Shealy Decl. ¶¶ 50–52).

We are not persuaded. Nothing in the '744 document suggests wearing the self-sticking magnetic plastic patch during physical exercise or for the purpose of improving strength. Petitioner fails to provide sufficient evidence to establish that, for example, eliminating “pain, numbness, and slowness” necessarily leads to improved muscle strength, as compared to, for example, maintaining the status quo. On this record, we are unable to distinguish between, for example, improvement of muscle strength and the lack of diminishment of muscle strength due to “pain, numbness, and slowness.”

3. Ground 3: Obviousness of Claims 2 and 18 Over the Combination of Amulets and the '744 Document

Petitioner contends that claims 2 and 18 are unpatentable under 35 U.S.C. § 103 over the combination of Amulets and the '744 document. Pet. 24–25, 53–60. As discussed above, Petitioner contends that Amulets inherently discloses “[a] method of improving muscle strength and endurance during physical activity” as required by claims 2 and 18. Pet. 43–44 (arguing that “Amulets discloses the Mercurian amulet provides protection from ailments to the throat region like respiratory infections involving sore throat, and other ailments . . . , [which] improves muscle strength and endurance during physical activity.”). For the reasons discussed above, Petitioner has failed to establish that Amulets inherently discloses a method of improving muscle strength and endurance during physical activity as required by claims 2 and 18.

Accordingly, we find that Petitioner has failed to establish a reasonable likelihood that it would prevail in showing the unpatentability claims 2 and 18 based on the combination of Amulets and the '744 document.

III. CONCLUSION

Petitioner has failed to establish a reasonable likelihood that it would prevail in showing that any of claims 1, 2, 9, 12, 14, 16, and 18 of the '590 patent are unpatentable in view of the asserted references.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* as to all challenged claims of the '590 patent.

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