

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EIS GMBH,
Petitioner,

v.

NOVOLUTO GMBH,
Patent Owner.

IPR2019-01444
Patent 9,763,851 B2

Before SUSAN L.C. MITCHELL, SCOTT C. MOORE, and
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

EIS GMBH (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–6 of U.S. Patent No. 9,763,851 B2 (Ex. 1001, “the ’763 patent”). Paper 1. (“Pet.”). NOVOLUTOGMBH filed a Preliminary Response to the Petition. Paper 11 (“Prelim. Resp.”).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon considering the Petition and the Preliminary Response, we determine that Petitioner has not shown a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim. Accordingly, we deny the Petition and decline to institute an *inter partes* review.

A. *Real Parties in Interest*

Petitioner identifies the following entities as real parties-in-interest: EIS GmbH; EIS Inc., Triple A Import GmbH; Triple A Marketing GmbH, Triple A Sales GmbH, and Triple A Internetshops GmbH (formerly known as “Internetsupport Bielefeld”).

B. *Related Proceeding*

Petitioner has not identified any related proceedings involving the ’851 patent. Pet. 8. Petitioner notes that a related patent US 9,937,097, also assigned to Patent Owner was the subject of a Petition for *inter partes* review, IPR2019-01302. *Id.* at 9. The Board denied that Petition on January 13, 2020. IPR2019-01302, paper 17.

C. The '851 Patent

The '851 patent, titled Stimulation Device, issued on September 19, 2017, from Application 15/023,471 filed on March 21, 2016. EX. 1001 (10)(21)(22)(45) and (86). It claims priority to German Patent Application No. 102013110501, filed September 23, 2013. Ex. 1001, col. 1, ll. 6–10.

The '851 patent relates to a sexual stimulation device for erogenous zones, in particular the clitoris. Ex. 1001, col. 1, ll. 12–13. The stimulation is produced by the application of positive and negative pressures with negative pressure defined as “a media pressure below the reference pressure” and a positive pressure being defined as “a media pressure above the reference pressure.” *Id.* at col. 4, ll. 3–8. The reference pressure is defined as “the existing ambient pressure in relation to the stimulation device at the beginning of use (i.e. prior to placing the stimulation device on the area of skin to be stimulated). In the preferred use of the stimulation device with air, the reference pressure is the currently existing air pressure or normal pressure.” *Id.* at ll. 20–25. The positive and negative pressures are created by changing the volume of a chamber in the device. *Id.* at col. 9, ll. 2758.

D. Illustrative Claims

Claims 1 is representative of the challenged claims and read as follows:

1. A stimulation device for a clitoris, comprising:
 - a pressure field generator comprising:
 - a first chamber having a single opening;
 - a second chamber having first and second openings, the second opening of the second chamber for placing over the clitoris; and
 - a connection element having a first opening and a separate second opening thereby forming a straight channel connecting the single opening of the first chamber with the first opening of the second chamber;
 - a drive unit that changes a volume of the first chamber in such a manner that a stimulating pressure field is generated in the second chamber via the connection element; and
 - a control device that actuates the drive unit; and a housing enclosing the pressure field generator, the drive unit, and the control device; wherein:
 - the pressure field generated in the second chamber consists of a pattern of negative and positive pressures modulated with respect to a reference pressure,
 - the first chamber is connected with the second chamber solely by the connection element,
 - the stimulation device has no valves,
 - the stimulation device is a portable hand-held device with a battery,
 - the connection element is rigid and the first and second openings of the connection element are aligned to one another so that a media flow during a compression of the first chamber is directed to the clitoris through the straight channel with a nozzle effect, and
 - the second opening of the connection element is configured to face the clitoris through the second chamber.

E. Evidence

Petitioner relies on the following references:

Guan, CN2153351Y, issued December 11, 1993 (Ex. 1007) (“Guan”).

Hovland et al., US 6,964,643 B2, issued November 15, 2005 (Ex. 1005) (“Hovland”).

Gloth, US 5,813,973, issued September 29, 1998 (Ex. 1007) (“Gloth”).

Makower et al., US 8,579,837 B1, issued November 12, 2013 (Ex. 1006) (“Makower”).

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–6 would have been unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 4–6	103	Guan, Hovland
3	103	Guan, Hovland, Gloth
5, 6	103	Guan, Hovland, Makower

Petitioner also relies on the declaration of Michael R. Prisco, P.E., Ph.D. Ex. 1002. Patent Owner relies on the declarations of Morton Olgaard Jensen, Ph. D., Dr. Med. (Ex. 2001) and Debra Herbenick, Ph.D. (Ex. 2004).

II. ANALYSIS

A. Legal Standard for Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary

considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). If the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains, the claim is unpatentable under 35 U.S.C. § 103(a). *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

A proper 35 U.S.C. § 103 analysis requires “a searching comparison of the claimed invention—including all its limitations—with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

“Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination.” *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). “Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*

B. Level of Ordinary Skill in the Art

The level of ordinary skill in the art is a factual determination that provides a primary guarantee of objectivity in an obviousness analysis. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991)).

Petitioner contends that a person of ordinary skill in the art would have had “a bachelor’s degree in mechanical engineering, biomechanical engineering, or the equivalent, and three or more years of experience in fluid mechanics and pump-based medical devices.” Pet. 4; Ex. 1002 ¶¶ 18–22. Petitioner also contends that “practical experience could qualify one not

having the aforementioned education as a [person of ordinary skill in the art], while a higher level of education could offset lesser experience.” Pet. 4; Ex. 1002 ¶¶ 18–22.

Patent Owner contends that a person of ordinary skill in the art would have had “a bachelor’s degree or equivalent practical experience in mechanical engineering, biomechanical engineering, biomedical engineering, sexual health or human sexuality, or the equivalent, and three or more years of experience in research, development, or design of devices that interact with the human female body (and specifically the vulva).” Prelim. Resp. 1–2. Patent Owner also contends “[e]xperience in fluid mechanics and pump-based medical devices, though helpful, is not necessary. More practical experience could offset less education and *vice versa*.” *Id.* at 2.

We have considered the contentions of the parties, and for purposes of this decision, we apply Petitioner’s definition of a person of ordinary skill in the art. Although the invention generally relates to a device for stimulating female erogenous zones, as seen from the discussion below, the design and operation of the device largely relate to issues of mechanical engineering and fluid flow. Thus, we conclude that experience in developing devices that interact with the female body is not needed to define a person of ordinary skill in the art.

C. Claim Construction

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2018) (as amended); *see* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings

Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,340, 51,358 (Oct. 11, 2018) (amending 37 C.F.R. § 42.100(b); effective November 13, 2018) (now codified at 37 C.F.R. § 42.100(b) (2019)). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.* Furthermore, at this stage in the proceeding, we need only construe the claims to the extent necessary to determine whether to institute *inter partes* review. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe 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))).

Both the Petitioner and Patent Owner contend that no claim construction is needed at this stage of the proceeding. Pet. 4; Prelim. Resp. 7. As both parties appear to agree as to the meaning of “reference pressure” that is at the heart of the controversy here, we need not expressly construe the claim term here. *See* Ex. 1002, ¶ 28; Ex. 2001 ¶ 34.

D. Obviousness based on Guan and Hovland

Petitioner contends that the subject matter of claims 1–6 would have been obvious to one of ordinary skill in the art at the time the invention was made over Guan combined with Hovland. Patent Owner counters that none of these references teaches “a pattern of negative and positive pressures modulated with respect to a reference pressure” as required by the challenged claim and one of skill in the art would have had no reason to combine the teachings of these references. Prelim. Response 25–38.

1. *Guan*

Guan discloses a health massager which generates pulsating air pressure to stimulate meridian points for therapeutic purposes. Ex. 1007, 3. Guan teaches the contraction of an air bag to produce the pulsating air pressure. *Id.*

2. *Hovland*

Hovland discloses an electrically-operated stimulation device which can be used to stimulate various body parts including the clitoris. Ex. 1005, Abstr.

3. *Analysis*

Petitioner contends that Guan teaches all of the elements of the independent claims with the exception of the elements calling for stimulation of the clitoris; that the device is battery operated; and that the device is configured to face the clitoris. Pet. 23–52. Petitioner contends that Hovland teaches these elements. *Id.*

With respect to the element calling for modulation of positive and negative pressure with respect to a reference pressure, Petitioner contends that this element is taught by Guan. Pet. 38–43. Petitioner contends that Guan uses the changing volume of the airbag to create both a positive and negative pressure relative to a reference pressure. *Id.* Petitioner contends that the reference pressure is the ambient pressure in the device before any motion is imparted on the bag. *Id.* Petitioner supports this contention with the testimony of Dr. Prisco who opines that when the air bag is not expanded or contracted, the air in the bag is at ambient pressure and that is the reference pressure. Ex. 1002 ¶ 91.

Patent Owner contends that Guan cannot be properly asserted against the challenged claims as Guan is directed to non-analogous art.¹ Prelim. Resp. 25–26. Patent Owner contends that Guan does not teach or suggest modulation of positive and negative pressure with respect to a reference pressure. Prelim. Resp. 26–27. Patent Owner notes that Guan only refers to pulsating air and does not state whether the pulses are created by positive or negative pressure. *Id.* Patent Owner also argues the Petitioner’s declarant improperly attributes features to Guan that are not present in the disclosure of Guan. *Id.*

We have considered the arguments advanced by the parties and the evidence of record and conclude that Petitioner has not demonstrated a reasonable likelihood of establishing that the asserted claims are unpatentable over Guan combined with Hovland.

Figure 1 of Guan illustrates a gas-powered massager and is reproduced below:

¹ We need not address whether Guan is analogous art as we find, based on the merits of the combination of Guan and Hovland that Petitioner has failed to show a reasonable likelihood of success on the merits.

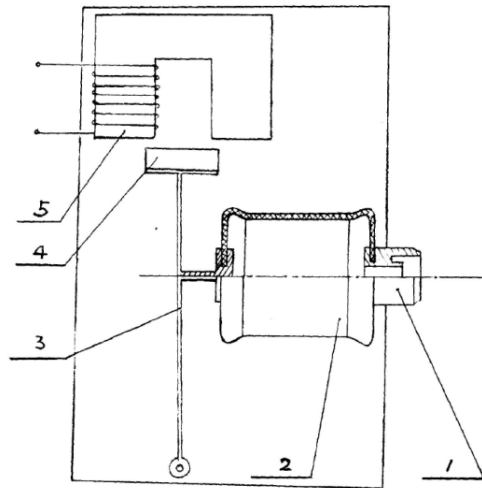


Figure 1, the sole figure in Guan, shows the air bag 2 of the device in a fully expanded position. Ex. 1007, 4. Guan does not teach any other position for the air bag, but instead only indicates that the bag is acted upon by the lever 3 to create a reciprocating motion. Ex. 1007, 3. Guan is silent as to the pressures that are created by expansion and contraction of the airbag. *See Id.*

Although we agree with Dr. Prisco that the pressure in the air bag before the arm acts upon it can be considered the reference pressure as defined by the '851 patent, we do not find support in Guan for Dr. Prisco's opinion that the bag would produce both negative and positive pressures relative to this reference (starting) pressure. See Ex. 1002 ¶ 28 (stating "the reference pressure is the *existing ambient pressure* prior to placing the stimulation device on the region of skin to be stimulated"); see Ex. 2001 ¶ 34 (agreeing that "the reference pressure is usually the existing ambient pressure in relation to the stimulation device at the beginning of use (*i.e.*, prior to placing the device on the area of skin to be stimulated"). Nothing in Guan teaches the bag in a starting position other than that it is fully expanded, which would be the starting pressure according to the definition

applied by Dr. Prisco. Ex. 1007, 3. Using the fully expanded bag as the starting position, we agree with Dr. Prisco that contraction of the bag would have decreased the volume of the bag, creating a positive pressure relative to the starting pressure of the expanded bag. Ex. 1002 ¶ 91. Dr. Prisco also opines that when the bag expands, it creates a negative pressure with respect to the reference pressure. *Id.* Dr. Prisco bases this opinion on his assertion that the reference pressure of the fully expanded bag “is the prevailing atmospheric pressure, i.e., a reference pressure.” *Id.* However, returning the bag to its fully expanded position would result in the internal pressure returning from a positive pressure value back to the reference pressure. *See* Ex. 2001 ¶ 106 (Arrangement in Guan would create a vacuum and return to normal pressure or positive pressure and return to normal pressure).

As Patent Owner points out, Dr. Prisco’s opinion that the expansion of Guan’s bag would result in a negative pressure is based on unsupported assumptions as to how the device of Guan works. For example, Dr. Prisco opines that the rubber mouth described in Guan forms a largely air-tight seal. *See* Ex. 1002 ¶ 92. Dr. Prisco based this opinion on Guan’s teaching that the rubber mouth comes into contact with the body. *Id.* As Patent Owner’s declarant, Dr. Jansen, points out, merely bringing the mouth into contact with a body does not teach or imply that an air-tight seal is formed. Ex. 2001 ¶ 109. Other than the reference to the mouth contacting a body, nothing in Guan teaches or suggests an air-tight seal. *See* Ex. 1004, 3.

Similarly, Dr. Prisco opines in detail as to how the device in Guan operates based on a supposition that appears to be guided by the disclosure in the ’851 patent. Ex. 1002 ¶¶ 89–92; *see* Ex. 2001 ¶¶ 97–108. Guan, however, only describes the different elements present in the disclosed device and provides no explicit discussion as to how those elements operate.

Ex. 1004, 3. Dr. Prisco offers no persuasive evidence to support his opinions that the elements operate in the manner he describes. *See* Ex. 1002 ¶¶ 89–92.

Based on the foregoing, we afford Dr. Prisco’s opinions little weight. *Perreira v. Secretary of the Dept. of HHS*, 33 F.3d 1375, 1377 (Fed. Cir. 1994). (“An expert opinion is no better than the soundness of the reasons supporting it.”).

Petitioner does not point to any teaching in Hovland regarding the modulation of positive and negative pressure relative to a reference pressure. *See* Pet. 38–43. Thus, the references, even combined as proposed by Petitioner, neither teach nor suggest all of the limitations of the challenged claims. For this reason we find that Petitioner has not demonstrated a reasonable likelihood of establishing that the challenged claims are unpatentable.

E. Ground 2 – Obviousness based on Guan, Hovland and Gloth

Petitioner contends that the subject matter of claim 3 would have been obvious over the teachings of Guan combined with Hovland and Gloth. Pet. 64–69. Claim 3, which depends from claim 1, includes the limitation calling for a pattern of negative and positive pressures relative to a reference pressure. 35 U.S.C. §112, fourth paragraph (“A claim in dependent form call be construed to incorporate by reference all of the limitations of the claim to which it refers.”) As discussed above, Petitioner has not shown that Guan or Hovland teaches this limitation. Petitioner also has not pointed to anything in Gloth that teaches a pattern of negative and positive pressure relative to a reference pressure. *See* Pet. 64–69.

Based on the foregoing, we conclude that Petitioner has not demonstrated a reasonable likelihood that claim 3 is unpatentable over Guan combined with Hovland and Gloth.

F. Ground 3 - Obviousness Based on Guan combined with Hovland and Makower

Petitioner contends that the subject matter of claims 5 and 6 would have been obvious over the teachings of Guan combined with Hovland and Makower. Pet. 69–76. Claims 5 and 6, which depend from claim 1, include the limitation calling for a pattern of negative and positive pressures relative to a reference pressure. As discussed above, Petitioner has not shown that Guan or Hovland teaches this limitation. Petitioner also has not pointed to anything in Makower which teaches a pattern of negative and positive pressure relative to a reference pressure. See Pet. 69–76.

Based on the foregoing, we conclude that Petitioner has not demonstrated a reasonable likelihood that claim 3 is unpatentable over Guan combined with Hovland and Makower.

G. Secondary Considerations of Non-obviousness

Patent Owner contends that the present record contains evidence of secondary considerations of non-obviousness sufficient to establish that the claimed invention is non-obvious. Prelim. Resp. 38–55.

As shown by our analysis above, Petitioner has not demonstrated that the references asserted teach all of the elements of the challenged claims. Therefore, we need not address the evidence of secondary considerations.

H. Discretion Under 35 U.S.C. § 325(d)

Patent Owner contends that we should exercise our discretion under 35 U.S.C. § 325(d) and deny the petition, as the art represented by Petitioner

is either the same as or cumulative of the art considered by the Examiner during prosecution of the '097 patent. Prelim. Resp. 12–18. Patent Owner also contends that the arguments presented by Petitioner are substantially the same as those presented by the Examiner during prosecution. *Id.* at 18–25.

As discussed above, the references advanced in this petition, either alone or in combination, fail to disclose or teach all of the elements of the challenged claims, and Petitioner therefore fails to demonstrate a reasonable likelihood that the challenged claims are unpatentable. Therefore, we need not reach the issue of whether we should exercise our discretion under § 325(d).

III. CONCLUSION

We conclude that Petitioner has not demonstrated a reasonable likelihood of showing that the challenged claims are unpatentable.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the petition for *inter partes* review is denied.

IPR2019-01444
Patent 9,763,851 B2

FOR PETITIONER:

Dinesh N. Melwani
Biju I. Chandran
BOOKOFF MCANDREWS, PLLC
dmelwani@bomcip.com
bchandran@bookoffmcandrews.com

FOR PATENT OWNER:

Tammy J. Dunn
OSHA LIANG LLP
Dunn@oshaliang.com