

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*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)
Denying Motion to Exclude
37 C.F.R. § 42.64

I. INTRODUCTION

A. Background and Summary

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 ’851 patent”). Paper 1 (“Pet.”). NOVOLUTO GmbH (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 11. On January 13, 2020 we issued our Decision Denying Institution. Paper 12 (“Dec.”).

Petitioner filed a Request for Rehearing of our Decision Denying Institution under 37 C.F.R. § 42.71(c) and (d). Paper 14 (“Req. Reh’g”).¹ Upon reconsideration of the arguments and evidence of record at the time, we granted the Request for Rehearing and instituted *inter partes* review on all grounds presented in the Petition. Paper 18 (“Reh’g Dec.” or “Rehearing Decision”).

Patent Owner then filed a Response on November 3, 2020. Paper 28 (“Resp.”). Petitioner filed a Reply on January 26, 2021. Paper 35 (“Reply”). Patent Owner filed a Sur-Reply on March 9, 2021. Paper 37 (“Sur-Reply”). On March 30, 2021, the parties jointly informed the Board that no oral hearing was needed in this case. Paper 38.

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the

¹ Petitioner also sought review of the Decision by the Precedential Opinion Panel. Ex. 3001. That request was denied on April 6, 2020. Paper 16. Following denial by the Precedential Opinion Panel, Petitioner brought an action in the United States District Court for the Eastern District of Virginia seeking review of denial by the Precedential Opinion Panel under the Administrative Procedure Act. Paper 22. The district court action was dismissed following our grant of Petitioner’s Request for Rehearing. Paper 34, 2.

claims on which we instituted trial. Based on the complete record before us, we determine that Petitioner has not shown, by a preponderance of the evidence, that claims 1–6 are unpatentable. In addition, for the reasons explained below, we deny Petitioner’s Motion to Exclude evidence.

B. 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”). Paper 34.

Patent Owner identifies itself as the real party-in-interest and that WOW Tech International GmbH is the corporate parent of Novoluto GmbH. Paper 39.

C. Related Matters

Petitioner has stated that the ’851 patent is the subject of litigation in two district court actions: *EIS Inc. v. WOW Tech International GmbH et al.*, No. 1:19-cv-01227-LPS, (D. Del.) and *Novoluto, GmbH v. Uccellini LLC d/b/a Lora DiCarlo*, No. DOR-6-20-cv-02284-MTK (D. Ore.). Paper 34, 3.

Petitioner also states that two related patents, US 9,937,097 B2 and US 9,849,061 B2 are the subject of IPR2019-01302 and IPR2020-00007 respectively. *Id.* We issued a Final Written Decision in IPR2019-01302 on June 14, 2021. IPR 2020-00007 remains pending.

D. 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, codes (10), (21), (22), (45), and (86). It claims priority to German Patent Application No. 102013110501, filed September 23, 2013. *Id.*, 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 expressly defined in the Specification of the '851 patent 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 col. 4, 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. 27–58.

E. Illustrative Claims

Claims 1 is representative of the challenged claims and reads 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.

Ex. 1001, col. 14, ll. 16–50 (emphasis added).

F. Evidence

Petitioner relies on the following references:

Guan, CN2153351Y, issued December 11, 1993 (Ex. 1004) (“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”).

Petitioner also relies on the declarations of Michael R. Prisco, P.E., Ph.D., Exs. 1002 and 1018, and the declaration of Richard Meyst.

Ex. 1020. Patent Owner relies on the declarations of Morton Olgaard Jensen, Ph.D., Dr. Med. (Exs. 2001 and 2036) and Debra Herbenick, Ph.D. (Exs. 2004 and 2038).

G. Prior Art and Asserted Grounds

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

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

II. ANALYSIS

A. Legal Standards

1. Burden

In an *inter partes* review, the burden of proof is on the Petitioner to show that the challenged claims are unpatentable, and that burden never shifts to the patentee. 35 U.S.C. § 316(e) (2018); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016).

2. 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 The provisions of the Leahy-Smith America Invents Act (“AIA”) regarding obviousness apply to patents containing at least one claim having an effective filing date on or after March 16, 2013. Pub L. 112–29, 125 Stat. 284 (2011). On its face, the ’851 patent has an effective filing date of July 22, 2014. Therefore, the post-AIA version of 35 U.S.C. § 103 applies to this Decision.

(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. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

A proper § 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.*

“[O]bjective evidence of nonobviousness includes copying, long felt but unsolved need, failure of others, commercial success, unexpected results created by the claimed invention, unexpected properties of the claimed invention, licenses showing industry respect for the invention, and skepticism of skilled artisans before the invention.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citations omitted). “For objective [evidence of secondary considerations] to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the *claimed invention*.” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010)

(alterations in original) (quoting *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995)).

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)).

In our Decision on Institution, we adopted Petitioner’s proposed definition of one skilled in the art as an individual with “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,” and Petitioner’s proposal 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.” Dec. 6–7 (alteration in original).

Focusing on use of the claimed stimulation device specifically for erogenous zones, Patent Owner renews its argument that in addition to the education level recited above, a person of ordinary skill in the art would have “three or more years of experience in research, development, or design of devices that interact with the human female body (and specifically the vulva).” Resp. 2. Patent Owner supports this contention by citing to the Technical Field discussion in the Specification where it states that the field relates to “a stimulation device for erogenous zones, in particular for the clitoris.” *Id.* (citing Ex. 1001, col. 1, ll. 12–13). Patent Owner also contends that the claims support this definition as the claims recite a stimulation device and system that directs “media flow . . . to the clitoris” with an

opening “configured to face the clitoris.” *Id.* (quoting Ex. 1001, claims 1–6) (alteration in original).

We have considered Patent Owner’s argument and are not persuaded that our original definition of a person of ordinary skill in the art was in error. We do not agree that one of ordinary skill in the art requires such specific expertise for the subject matter set forth in the field of invention or the claims of the ’851 patent. A “hypothetical ‘person having ordinary skill in the art’ to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art.” *Ex parte Hiyamizu*, 10 USPQ 2d 1393, 1394 (BPAI 1988). Although the device disclosed in the ’851 patent is a sexual stimulation device, the scientific and engineering principles applicable to the claimed device and method involve mechanical engineering and fluid flow and are not necessarily specific to the application of such a device.

As we previously noted in our Decision on Institution:

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 relates 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.

Dec. 7.

Based on the forgoing, we continue to apply the same definition of a person of ordinary skill in the art we used in our Decision on Institution. However, the findings and conclusions set forth below would have been the same had we instead adopted Patent Owner’s proposed definition.

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) (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 we need only construe the claims to the extent necessary to determine the patentability of the challenged claims. *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))).

In our Decision on Institution, we declined to construe any term because the parties contended that no construction was needed at that stage. Dec. 8. Petitioner now proposes an express construction for the term “reference pressure,” arguing that Patent Owner has improperly defined reference pressure to be only the existing ambient pressure in the device prior to use. Reply 8. Petitioner contends that this construction is improper as it is limited to a specific embodiment of the ’851 patent and ignores the broader teachings of the ’851 patent. *Id.* at 8–9.

Petitioner now contends that the proper construction of the term reference pressure should be “a ‘given’ pressure around which higher and lower pressures are generated for stimulating the body, which may be determined prior to or after application of the device to the body.” Reply, 9 (emphasis omitted). Petitioner explains:

The specification describes atmospheric pressure as exemplary, not required. *See* Ex. 1001, 4:20–25, 12:51–53; Ex. 1018 ¶¶11–18; Ex. 1020 ¶¶36–42. Indeed, the ’851 teaches that “negative-pressure...is preferably less than the usual systolic blood pressure in the blood vessels of body part 11.” Ex. 1001, 9:38–46 (emphasis added), 1:62–65. Accordingly, setting a “negative” pressure that is above systolic pressure—which is indisputably higher than ambient pressure—would require a reference pressure that is also above systolic pressure, and accordingly, above ambient pressure. Ex. 1018 ¶¶14–15; Ex. 1020 ¶¶43–46; Ex. 1049; Ex. 1017 ¶88.

Reply 8–9.

Petitioner supports this proposed construction with the testimony of Messrs. Prisco and Meyst as well as citations to portions of the ’851 patent. *Id.* (citing Ex. 1018 ¶¶ 17–18; Ex. 1020 ¶ 46; Ex. 1001, col. 4, ll. 20–25).

Patent Owner responds that both Patent Owner and Petitioner initially applied the same definition of “reference pressure” as the ambient pressure in the device prior to use. Sur-Reply 2. Patent Owner contends that Petitioner’s newly proposed construction here is improper and is not supported by the ’851 patent. *Id.* at 2–5.

We have considered the arguments advanced by the parties and the evidence of record, and conclude that the original construction used by the parties was proper. Contrary to Petitioner’s contention, the construction set forth in our Institution Decision is not limited to a single example, but is consistent with the overall teachings of the Specification of the ’851 patent. *See, e.g.*, Ex. 1001, col. 4, ll. 20–25, col. 12, ll. 51–53, Fig. 14. Also, the construction originally used by the parties is not limited to atmospheric pressure, but refers generally to the prevailing pressure in the device before it is applied to the body, *i.e.*, the ambient pressure, as described in the

Specification of the '851 patent. *See* Pet. 5–6 (stating “the reference pressure is the existing ambient pressure prior to placing the stimulation device on the region of skin to be stimulated”); Ex. 1002 ¶ 28 (same); Prelim. Resp. 5 (stating “[t]he 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 to be stimulated [Ex. 1001], 4:20–25)”). This “ambient pressure” as described in the Specification of the '851 patent that both parties referenced refers to the pressure within the device regardless of the environment in which it is used. For instance, the Specification of the '851 patent lists additional environments for use of the claimed device to include “a liquid medium, such as water or commercially available lubricant.” *Id.* at col. 4, ll. 9–19.

Even if agree with Petitioner that the proposed new construction is in response to arguments raised by Dr. Jensen, Petitioner’s reliance on the teachings with regard to systolic pressure does not support its position that the “reference pressure” may not be the prevailing pressure or ambient pressure in the device before it is applied to the body. The entire paragraph regarding systolic pressure, which relates to Figure 5 of the '851 patent, reads:

Assuming that in the first state the pressure in the chambers 3 and 4 corresponds to the currently prevailing external reference pressure (air pressure for example), the overall pressure that is present in the second state will be lower than the external reference pressure. This negative pressure is set such that it is preferably lower than the usual systolic blood pressure in the blood vessels of the body part 11. The blood circulation in this area thus increases, and the clitoris 12 is better supplied with blood in the second state.

Ex. 1001, col. 9, ll. 38–46. It is clear that, when read in context, the reference pressure referred to in this paragraph is the prevailing pressure in the device.

Based on the foregoing, we construe the term “reference pressure” as “a prevailing pressure within the device prior to placing the stimulation device on the area of the skin to be stimulated.”

D. Obviousness Based on Guan Combined with Hovland

Petitioner contends that the subject matter of claims 1, 2, and 4–6 would have been obvious to one of ordinary skill in the art at the time the invention was made over Guan combined with Hovland. Pet. 23.

1. Guan

Guan discloses a health massager which generates pulsating air pressure to stimulate meridian points for therapeutic purposes. Ex. 1004, 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, Abst.

3. Non-Analogous Art

Before we begin our analysis of the claims we first address Patent Owner’s contention that Guan cannot be properly combined with Hovland as Guan is non-analogous art. Resp. 40–42.

“Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to

the particular problem with which the inventor is involved.” *In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992).

Patent Owner argues that the field of endeavor for the present invention is sex toys whereas Guan is directed to medical treatment using a variation of acupuncture. Resp. 40. Patent Owner supports this argument by pointing to the teachings in the Specification that the claimed device is designed to be used to stimulate erogenous zones. *Id.* at 43–45. Patent Owner contends that Guan is directed to acupressure/acupuncture and is not relevant to sexual stimulation. *Id.*

Petitioner contends that acupressure can be used in the genital region. Reply 10. Petitioner also contends that Patent Owner’s contention that the device described in the ’851 patent is limited to stimulating erogenous zones is contradicted by the teachings of the ’851 patent and by Patent Owner’s experts. *Id.* at 11.

Patent Owner responds by contending that the presence of acupressure points in the genital region does not render Guan relevant prior art. Sur-Reply 16–17. In support of this contention Patent Owner points to the testimony of Dr. Herbenick that acupressure meridian theory is not concerned with sexual arousal and orgasms and that one skilled in the art would not look to meridian theory to aid in developing a sex toy. *Id.* (citing Ex. 2038 ¶ 91; Ex. 1016, 191–194 (first Herbenick deposition); Ex. 1023, 97 (second Herbenick deposition)).

Patent Owner also argues that Petitioner’s reliance on the location of meridians in the perineum or genitals is misplaced. Sur-Reply, 17. Patent Owner contends that treatment for sexual dysfunction is different than sexual stimulation and that they entail different approaches. *Id.* Patent

Owner also contends that the regions where the meridians are located, e.g., the perineum, are significantly different than the vulva or the clitoris. *Id.*

Finally, Patent Owner contends that while the Specification of the '851 patent may include a reference to stimulating other body parts, the challenged claims are specifically limited to stimulating the clitoris. *Id.* at 18. Patent Owner contends that Guan is directed to treatment of various ailments and is not relevant to sexual stimulation of erogenous zones. *Id.*

In our Rehearing Decision, we addressed Patent Owner's contention that Guan is non-analogous art and held that although Guan is not directed to a sex toy, it is reasonably pertinent to the problem faced by the inventor. Reh'g Dec. 6. Having considered the arguments of the parties and the evidence of record, we affirm our original conclusion that Guan is analogous art.

Guan is directed to a device that uses pulses of air to massage or stimulate a body part. *See* Ex. 1004, 1; Ex. 1002 ¶ 70. Although we agree with Patent Owner that the claims are directed to a device for stimulation of the clitoris, the '851 patent teaches its general applicability to stimulating a body part. Ex. 1001, col. 8, ll. 60–65. Patent Owner's description of the field of endeavor as sex toys is too narrow in light of the breadth of the teachings of the '851 patent of stimulating a body part. We find that both Guan and the '851 patent relate to the same field of endeavor of stimulating a body part. *See* Ex. 1020 ¶¶ 68–71.

Moreover, the Specification of the '851 patent teaches that the disclosed device stimulates the body part in an indirect way. Ex. 1001, col. 2, ll. 60–62; col. 4, ll. 26–29. Guan also massages a body part indirectly. *See* Ex. 1004, 3. Thus, both the present invention and Guan address similar problems, and Guan is considered analogous art.

4. *Analysis of Claim 1*

Petitioner contends that the combination of Guan and Hovland teaches each of the limitations recited in claim 1. Pet. 23–52. Because we find that Petitioner has not shown by a preponderance of the evidence that the challenged claims are unpatentable as obvious over the combination of Guan Hovland, we will concentrate our analysis on only the limitation that Petitioner has failed to show is taught by the combination, which is the requirement for “the pressure field generated in the second chamber consists of a pattern of negative and positive pressure modulated with respect to a reference pressure.”

Petitioner contends that Guan teaches this limitation. Pet. 38–43. Petitioner contends that prior to starting any motion of the air bag, the pressure in the device is the reference pressure. *Id.* (citing Ex. 1002 ¶¶ 90–91). Petitioner contends that as the lever in Guan compresses the air bag, it creates a positive pressure with respect to the reference pressure. *Id.* Petitioner contends that as the lever expands the airbag, it creates a negative pressure with respect to the reference pressure. *Id.* Petitioner contends that this results in modulated positive and negative pressures with respect to a reference pressure. *Id.*

In support of this contention, Petitioner initially relies on the testimony of Dr. Prisco where he compares the operation of Guan with an embodiment disclosed in the ’851 patent. Pet., 38–43. In his testimony, Dr. Prisco testifies that the ’851 patent discloses an embodiment that operates in the same manner as a piston pump. Ex. 1002 ¶ 90. Dr. Prisco then testifies that the device in Guan operates in the same manner as the piston pump disclosed in the ’851 patent, and therefore it modulates between positive and negative pressure as required by the claims. *Id.* ¶¶ 91–92.

Patent Owner responds that Guan does not disclose modulated positive and negative pressures, but is limited to pulsing positive pressure. Resp. 30–31. Patent Owner contends that Petitioner’s contentions with respect to Guan teaching modulated positive and negative pressures are not supported by the limited disclosure in Guan. *Id.* at 31–33.

Patent Owner supports these arguments with the testimony of Dr. Jensen who testified:

It is worth noting that Guan fails to provide a complete or clear description of the device’s elements or the interactions and functioning of its elements. Guan fails to provide specific details of, for example, the coupling of lever (3) to other components, the orientations of the electromagnet and magnet (*e.g.*, orientations of the charges and poles), which are required to determine the movement of the lever (3) and the magnet (4), and details regarding how air enters and exits the air bag or even deformation of the airbag.

Ex. 2036 ¶ 94. Dr. Jensen goes on to note that Dr. Prisco’s analysis of Guan is not supported by the teachings of Guan, but is instead based on assumptions using information gleaned solely from the ’851 patent in an inappropriate hindsight analysis. *Id.* ¶ 93 (“Dr. Prisco’s arguments that Guan teaches or suggests this limitation of claim 1 of the ’851 Patent appear to be guided solely by having read the ’851 Patent first and then improperly applying hindsight to reconstruct Guan.”).

Patent Owner also contends that the reciprocating motion of Guan only creates a variation in positive pressure and does not result in a negative pressure. Resp. 34–35. Patent Owner contends that one skilled in the art would have understood the device described in Guan to pulse air in only one direction and not between positive and negative pressures. *Id.*

Patent Owner contends that Petitioner's analysis of Guan improperly uses the '851 patent as a road map. Resp. 37–41.

Petitioner contends that one skilled in the art would have understood that the air bag in Guan is in an intermediate position and that the action of the lever causes the air bag to expand and contract, thereby creating positive and negative pressures. Reply 2–3. Petitioner also contends that the plain meaning of the term pulsation supports the conclusion that the device in Guan produces positive and negative pressures. *Id.* at 4–5. Petitioner also contends that Guan's teaching of both acupuncture and cupping indicates that the device in Guan can create both positive and negative pressures. *Id.* at 6.

For the first time, Petitioner advances the argument in its Reply that if Guan alone does not teach modulation between positive and negative pressure, this element is taught by Hovland.³ Reply 12. Petitioner points to the following paragraph in Hovland as supporting its contention that Hovland teaches modulation between positive and negative pressure:

According to other embodiments, pump/motor assembly 300 provides pneumatic and/or hydraulic actuation to create e.g., vibration, percussion, subatmospheric pressure and/or superatmospheric pressure, or modulation of these effects.

Ex. 1005, col. 13, ll. 20–24. Petitioner contends that one skilled in the art would have interpreted this passage as referring to modulation between the effects recited. Reply 13–14.

Patent Owner responds that the teachings of Guan do not support Petitioner's analysis and that Guan is limited to producing only positive

³ Petitioner contends that Patent Owner “opened the door” to this argument by asserting that Hovland does not teach modulation of pressures in its Response. Reply 12.

pressures. Sur-Reply 6–11. With respect to Hovland, Patent Owner contends that Petitioner is improperly offering a new grounds of unpatentability in Petitioner’s Reply. *Id.* at 1, 11–12. Patent Owner also contends that Hovland does not teach modulation between positive and negative pressures. *Id.* at 11–16.

We have considered the arguments presented by the parties and the evidence of record and conclude that Petitioner has not demonstrated that Guan teaches or suggests the claim element “the pressure field generated in the second chamber consists of a pattern of negative and positive pressure modulated with respect to a reference pressure.”

Petitioner’s arguments with respect to Guan creating a positive and negative pressure with respect to a reference pressure are based on the bag in Guan starting in an intermediate position. Reply 5 (citing Ex. 1018 ¶¶ 30–34 and Ex. 1020 ¶¶ 50–61); *see* Ex. 1020 ¶ 54–57. Guan, however, is silent with respect to the starting position of the airbag. *See* Ex. 1011. Moreover, Dr. Prisco testified:

A person of skill in the art would also have understood that the depicted position in *Guan*’s would not necessarily be the starting position when the device is placed on the body and powered on. Ex. 1004. *Guan* does not provide a mechanism or teaching for returning the air bag to the depicted position prior or after use.

Ex. 1018 ¶ 32; *see also* Ex. 1020 ¶ 54 (absent a reverse polarity, there is no magnetic force to return the magnet to the starting position).

Given Guan’s silence as to the starting position of the air bag, Petitioner and its experts appear to rely on an assumption that Guan inherently teaches that the air bag always starts in a position that is neither fully expanded nor fully compressed. Although inherency may supply a missing element in an obviousness analysis, the petitioner must show that it

is a natural result flowing from the operation of the device. *PAR Pharm., Inc. v. TWI Pharm., Inc.*, 773 F.3d 1186, 1195 (Fed. Cir. 2014). In the instant case, Petitioner has not established that the intermediate position would naturally result from the operation of the device.

While Dr. Prisco and Mr. Meyst based their opinions on the air bag of Guan being in an intermediate position, as Dr. Prisco testified, there is no mechanism to return the bag to that position for each use. Ex. 1018 ¶ 32. Thus the intermediate position of the air bag is not a natural result that necessarily flows from the use of the bag as described in Guan.

Petitioner contends that the device of Guan can also be used for cupping, which in turn is a teaching that the device can be used to generate positive and negative pressures. Reply 6. We are not persuaded by this argument. The discussion of cupping in Guan appears as part of a discussion of prior art solutions. Ex. 1004, 3. We do not discern, nor does Petitioner point to, any specific teaching in Guan that the device of Guan can be used for cupping.⁴ Moreover, even if Guan's device could be used for cupping, Petitioner has not pointed to any reasoning or teaching that would have led one skilled in the art to combine cupping with acupuncture as used in Guan's device. *See* Reply 6.

Petitioner contends that Patent Owner has failed to identify any structure in Guan that would prevent the device from operating in the manner described by Petitioner's experts. Reply 3. Petitioner, however, inappropriately places the burden of persuasion on Patent Owner. It is Petitioner's burden to establish that the subject matter of the claims would

⁴ Cupping is a traditional Chinese medical therapy that involves the application of negative pressure for therapeutic purposes. Ex. 1033, 8 (Liu alternative medicine article).

have been obvious, not Patent Owner’s burden to establish the negative, that such subject matter would not have been obvious. *See Magnum*, 829 F.3d at 1375.

Turning to Petitioner’s argument with respect to Hovland, we agree with Patent Owner that this represents a new argument that is not properly raised on Reply. Sur-Reply 1. As we noted in our Decision on Institution, in the Petition, “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.” Dec. 13. The argument that Hovland supplies the necessary teaching of modulation of positive and negative pressures is a new theory advanced in Petitioner’s reply.

Petitioner contends that Patent Owner “opened the door” for it to assert Hovland teaches modulation of pressures by contending that Hovland does not teach modulation between positive and negative pressures. Reply 12. We are not persuaded. While Patent Owner made the argument, we do not find that it was sufficient to permit Petitioner to introduce a new theory of unpatentability in its Reply. As the Supreme Court has found, it is the Petition that defines the scope of *inter partes* review. *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018); *see Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (rejecting petitioner’s attempt to cure a petition’s deficiencies in reply, noting the “obligation for petitioners to make their case in their petition”); PTAB Consolidated Trial Practice Guide 74 (November 2019)⁵ (“[A] reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.”).

⁵ The Consolidated Trial Practice Guide can be found at <https://www.uspto.gov/TrialPracticeGuideConsolidated>

The case cited by Petitioner in support of its argument does not require a different result. In *Belden*, the issue before the court was whether the Board properly denied patent owner's motion to exclude the reply declaration of petitioner's expert. *Belden Inc. v. Ber-Tek LLC*, 805 F.3d 1064, 1078 (Fed. Cir. 2015). The Board declined to exclude the declaration, concluding that the declaration responded to patent owner's expert declaration and patent owner's response to the petition. *Id.* Our reviewing court determined that the Board's decision was not in error. *Id.* The court found that the reply declaration of petitioner's expert responded only to arguments made in patent owner's response and by patent owner's expert. *Id.*

Unlike the situation in *Belden*, Petitioner here does not merely seek to introduce evidence to rebut positions taken by Patent Owner, but instead seeks to introduce an entirely new theory on unpatentability. This is not permitted.

Moreover, even if we were to permit Petitioner to introduce a new argument based on Hovland, we do not find that argument persuasive.

Petitioner contends that, to the extent the element of modulated positive and negative pressure is not taught by Guan, that element is taught by Hovland. *See Reply*. 12–15.

Hovland teaches that in one embodiment, the device disclosed therein has a “pump/motor assembly [which] provides pneumatic and/or hydraulic actuation to create e.g. vibration, percussion, subatmospheric pressure and/or superatmospheric pressure, or modulation of these effects.” Ex. 1005, col. 13, ll. 21–24. Petitioner construes this passage as teaching that the device in

Hovland can modulate both positive and negative pressures as required by claim 1. *Id.* Petitioner contends that the use of the term “and/or” would lead one skilled in the art to understand that the device of Hovland can modulate between subatmospheric and superatmospheric pressures. *Id.*

Patent Owner contends that although Hovland may teach a device that can produce positive (superatmospheric) or negative (subatmospheric) pressures, it does not teach modulating between those pressures. Sur-Reply 12. Patent Owner contends that the recited paragraph only indicates that the individual effects can be modulated, but not that the device can modulate between the effects. *Id.* at 13.

We have considered the arguments advanced by the parties and the evidence of record and conclude that Patent Owner has the more persuasive argument. While we agree with Petitioner that Hovland teaches a device capable of producing positive and negative pressures individually, we do not find that Hovland discloses modulating between those effects. We agree with Patent Owner that, when read in context, the cited passage refers to modulation of the individual effects recited in the sentence, but not modulation between the effects. Sur-Reply 13. This interpretation is consistent with the overall teachings of Hovland, which describe modulation of the vacuum or negative pressure effect. For example, Hovland teaches the use of a vacuum modulator to vary the suction pressure applied by the device. Ex. 1005, col. 12, ll. 42–59. Hovland also teaches that the vacuum modulator can be used to pulsate the vacuum level of the device. *Id.* at col. 14, ll. 21–22. Hovland goes on to teach:

When applied to the clitoris, the vacuum applied by device 200 will cause the clitoris to become engorged, i.e. filled with blood. Vacuum level and modulation can be adjusted by either the patient or her partner, as needed, to maintain engorgement.

Thus, embodiments of the invention provide the ability both to rapidly *modulate vacuum pressure* with modulator 290, in a manner akin to the modulation of alternating current, for example, and simultaneously to more evenly hold underlying vacuum pressure at a substantially constant level or gradually change it, e.g. with wheel 280, in a manner akin to direct current. This dual functionality provides substantial advantages over the prior art.

Id. at col. 14, ll. 27–39 (emphasis added). Thus when read in the context of the entire disclosure of Hovland, we find that the reference in Hovland to modulation refers to modulation of one specific effect, not modulation between two or more effects.

Petitioner contends that the use of the term “and/or” as it appears in Hovland, calls for the device to create both effects. Reply 14–15; Ex. 1018 ¶¶ 53–55.

While we agree with Petitioner that the term “and/or” calls for a device that can create both positive and negative pressures, as discussed above, we do not read Hovland as teaching modulating between effects, as required for claim 1. This is confirmed by the plain language of Hovland, which refers to “modulation of these effects” rather than “modulation between effects.” Ex. 1005, col. 13, ll. 20–24. Moreover, when the cited paragraph is read in the context of the other disclosures in Hovland discussed above, we find that the overall teachings of Hovland are focused on modulation of the individual effects, not modulating between the effects. Ex. 1005, col. 12, ll. 21–24; Ex. 2026 ¶¶ 161–163. While Hovland teaches a device that can produce positive and negative pressures we discern nothing in Hovland that teaches modulating between these effects.

5. *Objective Indicia*

Before reaching an ultimate conclusion on obviousness, we must consider so-called objective indicia of non-obviousness when they are in evidence. *Graham*, 383 U.S. at 18. Objective indicia of non-obviousness, or “secondary considerations,” guard against hindsight reasoning in an obviousness analysis, and are often “the most probative and cogent evidence in the record.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1328 (Fed. Cir. 2016) (citations omitted). As such, objective indicia of non-obviousness must be considered in every case in which they are presented. *Id.* (citing *Transocean Offshore Deepwater Drilling Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012)). The objective indicia evidence we must consider, if presented, includes “copying, long felt but unsolved need, failure of others, commercial success, unexpected results created by the claimed invention, unexpected properties of the claimed invention, licenses showing industry respect for the invention, and skepticism of skilled artisans before the invention.” *Rouffet*, 149 F.3d at 1355. We must also determine if Patent Owner has shown a nexus between the evidence and the merits of the claimed invention. *Wyers*, 616 F.3d at 1246.

a) *Nexus*

There must be a “nexus” between the merits of the claimed invention and the evidence of secondary considerations for such evidence to be accorded substantial weight. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). Nexus is presumed if a marketed product embodies the claimed features and is coextensive with them. *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 723 F.3d 1363, 1372 (Fed. Cir. 2013). A patent owner is entitled to a presumption of a nexus if it shows that “the asserted objective evidence is

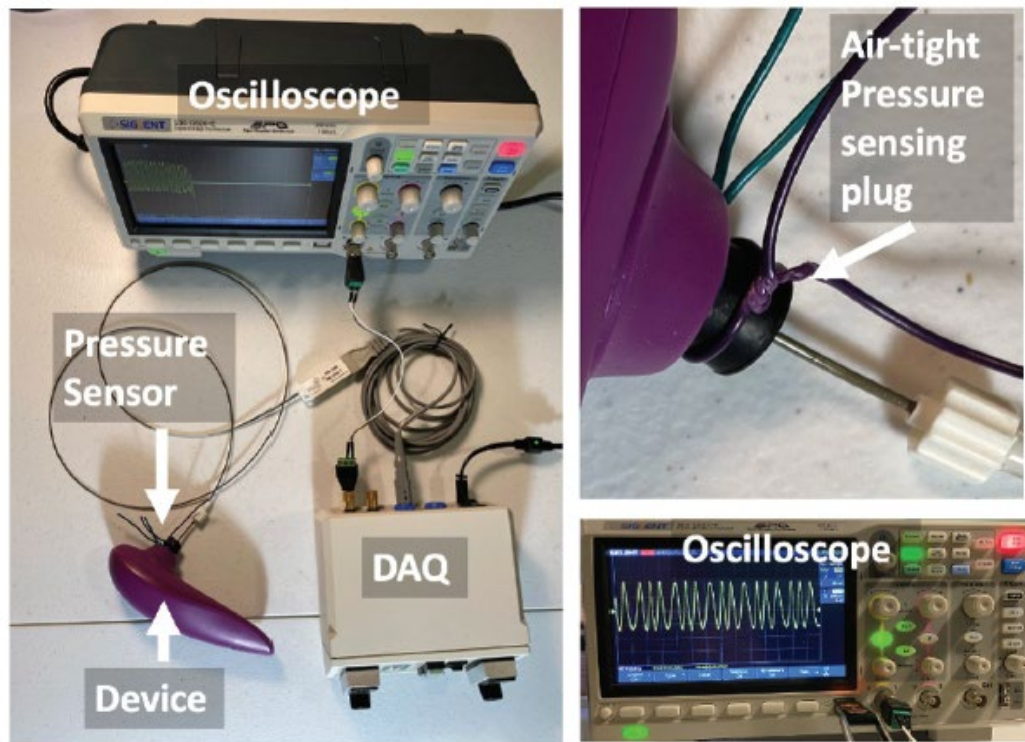
tied to a specific product and that product ‘is the invention disclosed and claimed in the patent.’” *WBIP*, 829 F. 3d at 1335.

Patent Owner contends that five of its commercial products, the Womanizer® Classic, Premium, Starlet, Liberty, and Pro, “are covered by the challenged claims.” Resp. 8. In support of this contention Patent Owner relies on the testimony of its experts Drs. Jensen and Herbenick. *Id.* at 8–14 (citing Exs. 2036 and 2038).⁶

Both Dr. Herbenick and Dr. Jensen reviewed the Womanizer® Classic and concluded that the device was coextensive with at least claim 1 of the ’851 patent. Ex. 2036 ¶ 46; Ex. 2038 ¶ 36. Dr. Herbenick prepared a detailed claim chart tracking each element of the independent claims to specific components of the Womanizer® Classic, concluding that the device contains each of the structural elements recited in the independent claims. Ex. 2038 ¶¶ 37–52; Ex. 2041. Dr. Jensen reviewed the device and Dr. Herbenick’s claim charts and also concluded that all of the structural elements are present in the device. Ex. 2036 ¶ 46–51.

Dr. Jensen also conducted an experiment to determine whether the Womanizer® Classic produced modulated positive and negative pressures with respect to a reference pressure. Ex. 2036 ¶¶ 48–49. The following images from Dr. Jensen’s declaration shows the equipment used to test the pressure of the Womanizer® Classic, as well as the pressure graph generated as a result of the tests:

⁶ As Dr. Herbenick has testified, the Womanizer® Classic, Premium, Starlet, Liberty, and Pro differ only in style features with the structure and mechanics of the devices being the same. Ex. 2038 ¶ 35. For this reason, Dr. Herbenick and Jensen focused their analyses only on the Womanizer® Classic. Ex. 2036 ¶ 45; Ex. 2038 ¶ 35.



Figures from Ex. 2036 ¶ 48 showing equipment set up used by Dr. Jensen.

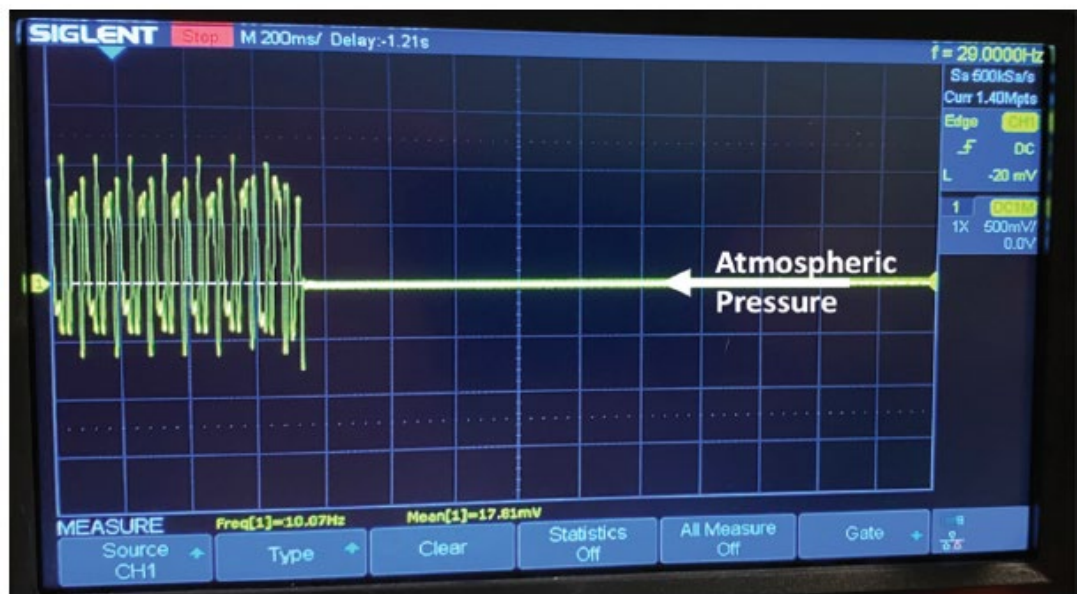


Figure from Ex. 2036 ¶ 48 showing pressure recorded in the Womanizer® Classic evaluated by Dr. Jensen.

As shown in the top images above, Dr. Jensen's testing set-up included an oscilloscope, data acquisition equipment ("DAQ"), and a pressure sensor with an air-tight pressure sensing plug connected to the device. *Id.* In the pressure graph shown above, the y-axis indicates pressure (as a voltage measurement) relative to ambient or atmospheric pressure (zero line) and the x-axis indicates time (milliseconds). *Id.* Based on the results of that experiment and the product literature relating to the Womanizer® Classic, Dr. Jensen concludes that the commercial devices meet the limitations calling for modulated positive and negative pressures with respect to a reference pressure. *Id.* ¶¶ 48–49.

Petitioner contends that Patent Owner is attempting to mislead the board by alleging that there are no relevant technical differences between the various commercial products where, in fact, there are. Reply 21. Petitioner also contends that Patent Owner has failed to establish a nexus between the commercial products and the challenged claims. Reply 22. Petitioner contends that Patent Owner's arguments are largely based on the testimony of Dr. Herbenick, who Petitioner contends is not qualified to render such testimony. *Id.* at 23.

Petitioner contends that Patent Owner is not entitled to a presumption that the commercial devices embody the claimed invention as they include features not recited in the claims. Reply 21–23. Petitioner also argues that Dr. Jensen's testing of the alleged commercial embodiment is unsound and does not establish a nexus between the device and the claims. *Id.* at 23–24.

We have considered the arguments presented by the parties and the evidence of record and find that Patent Owner has established a nexus between the claims of the '851 patent and its commercial products. The testimony of both Dr. Herbenick and Dr. Jensen demonstrate that all of the

elements of the claims are present in the Womanizer® Classic, Premium, Starlet, Liberty, and Pro products and that the products are essentially the claimed inventions. Ex. 2036 ¶¶ 45–51; Ex. 2038 ¶¶ 35–52.

Petitioner contends that the presence of additional, unclaimed features precludes a presumption of a nexus between the commercial embodiments and the claims of the '851 patent. Reply 23. In support of this contention Petitioner cites to *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366 (Fed. Cir. 2019). Petitioner's reliance on *Fox Factory* is misplaced. As the court in *Fox Factory* stated:

To be sure, we have never held that the existence of one or more unclaimed features, standing alone, means nexus may not be presumed. Indeed, there is rarely a perfect correspondence between the claimed invention and the product. As we explained, the purpose of the coextensiveness requirement is to ensure that nexus is only presumed when the product tied to the evidence of secondary considerations “is the invention disclosed and claimed.” Thus, if the unclaimed features amount to nothing more than additional insignificant features, presuming nexus may nevertheless be appropriate.

Id. at 1375. The court went on to state: “Although we do not require the patentee to prove perfect correspondence to meet the coextensiveness requirement, what we do require is that the patentee demonstrate that the product is essentially the claimed invention.” *Id.*

In *Fox Factory*, the alleged commercial embodiment included unclaimed features that the patentee described as critical to the products' performance. *Id.* at 1374–1375. It was the presence of these critical, unclaimed features that lead the court to hold: “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.” *Id.*

The case before us is factually distinct from *Fox Factory*. While Petitioner has identified several features of the Womanizer® products that are not recited in the claims, we do not discern any evidence to suggest that these unclaimed features are critical to the products and impact the products' functionality. *See* Reply 23. While Dr. Herbenick testified that additional features were present in the Womanizer® devices, Petitioner has not pointed to any testimony by Dr. Herbenick or other evidence to support the contention that these additional features significantly affect the functionality of the devices. *See id.* at 22; Ex. 1023, 116–121.

Petitioner also contends that Patent Owner's evidence that the commercial products are coextensive with the claims of the patent is unreliable. Reply 23. Petitioner contends that Dr. Herbenick testimony regarding the Womanizer® Classic that Dr. Herbenick did not actually observe the connection element. *Id.* With respect to Dr. Jensen's testimony, Petitioner contends that Dr. Jensen's testing technique is unsound and should not be relied upon. *Id.* at 23–24. We find both of these arguments unpersuasive.

We are not convinced that Dr. Herbenick has not established that there is a connection element as required by the challenged claims in the commercial device. In her Declaration, Dr. Herbenick specifically identified item 13 in the photos below as the connection element. Ex. 2038 ¶ 51.

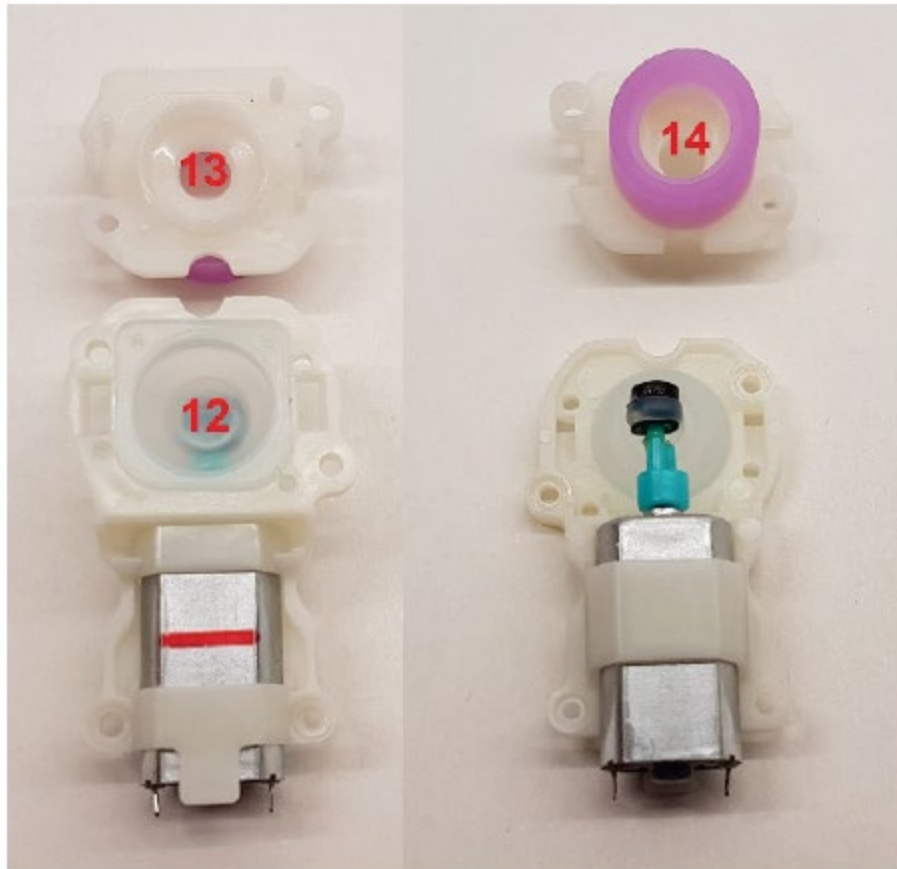


Figure from Ex. 2038 ¶ 51 showing the inner and outer chambers of the Womanizer® Classic device.

Dr. Herbenick unequivocally testified that element 13 in the photograph is the connection element. Ex. 1016, 82. In addition, Dr. Jensen also testified that a connection element is present in the commercial embodiment.

Ex. 2036 ¶¶ 46–47, 51.

We are similarly unpersuaded by Petitioner’s critique of Dr. Jensen’s testing methodology. In particular, Petitioner and Dr. Prisco and Mr. Meyst point to Dr. Jensen’s deposition testimony indicating that he used a rubber plug or bottle stopper with the pressure sensor for his testing. Ex. 1018 ¶¶ 82–94; Ex. 1020 ¶¶ 72–76. Petitioner contends that this technique is

unreliable because the rubber stopper used by Dr. Jensen “could be filling most of the chamber.” Reply 23–24. In support of this contention Petitioner cites to Dr. Prisco’s and Mr. Meyst’s testimony concerning the use of the stopper by Dr. Jensen. *Id.* Dr. Prisco, however, never testified that the stopper might fill the chamber, but rather that the use of the stopper could affect the pressures generated. Ex. 1018 ¶ 84. Dr. Prisco offers no explanation why this might be so or that it actually occurred when Dr. Jensen conducted his experiments. For this reason, we give little weight to Dr. Prisco’s critique of Dr. Jensen’s methodology. *Ebit Sys. Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1358 (Fed. Cir. 2018) (“The PTAB [i]s entitled to weigh the credibility of the witnesses”) (alteration in original); *see* 37 C.F.R. § 42.65 (Expert testimony that does not disclose underlying facts or data is entitled to little weight.).

Mr. Meyst also testified that he had issues with how Dr. Jensen conducted his experiments. Ex. 1020 ¶¶ 72–76. As part of his critique, Mr. Meyst identified several potential issues with respect to Dr. Jensen’s test method. *Id.* While Mr. Meyst opines that he would have conducted the experiments differently, Mr. Meyst does not explain how the alleged irregularities affected the results achieved by Dr. Jensen that the Womanizer® devices modulate positive and negative pressure with respect to a reference pressure. *Id.*

Dr. Prisco also testified that the data produced by Dr. Jensen shows that the pressure in the device modulated at a pressure greater than atmospheric pressure. Ex. 1018 ¶¶ 84–90. Petitioner contends that this further supports the conclusion that Dr. Jensen’s test results are unreliable. *See* Reply 24. Again, we are not persuaded by this argument. Even if we were to accept Petitioner’s argument that the reference pressure in

Dr. Jensen's test was something other than atmospheric pressure, our construction of reference pressure does not limit the term to atmospheric pressure, but only the pressure in the device before it is applied to the body. Petitioner does not dispute that the data produced by Dr. Jensen shows modulation of positive and negative pressure with respect to a reference pressure regardless of whether it is atmospheric pressure. *See id.*; Ex. 1018 ¶¶ 82–83.

Based on the foregoing we conclude that Patent Owner has established a nexus between the Womanizer® devices and the challenged claims of the '851 patent.

b) Commercial Success

The commercial response to an invention is significant to determinations of obviousness and is entitled to fair weight. *Demaco Corp. v. F. von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1391 (Fed. Cir. 1988).

Patent Owner contends that the Womanizer® products are “stand-out successes.” Resp. 71. In support of this contention, Patent Owner points to various consumer testimonials as well as Dr. Herbenick's testimony regarding the sales of Womanizer® products. *Id.* Patent Owner also points to its sales data for the Womanizer® products. *Id.*

Petitioner contends that Dr. Herbenick's testimony should be given little weight as Patent Owner did not produce evidence relating to market share, sales expectations or other evidence showing the comparative success of the Womanizer® devices with other products. Reply 25.

We have considered the arguments presented by the parties and the testimony of Dr. Herbenick and evidence of record and find that Patent Owner has not shown that the Womanizer® products are commercially successful on the record before us.

Commercial success in the context of secondary considerations is typically established by evidence of sales of the product embodying the claimed invention and relevant market share.⁷ *In re Applied Materials, Inc.*, 692 F.3d 1289, 1299 (Fed Cir. 2012). In the present case Patent Owner has not offered any testimony regarding the market share for the relevant products. *See* Ex. 2038 ¶¶ 53–54.

Absent market share information, we cannot determine if the relevant products enjoyed commercial success sufficient to support a finding of non-obviousness. *Applied Materials*, 692 F.3d at 1299.

c) Long-Felt Need

“Evidence of a long felt but unsolved need that is met by the claimed invention is further evidence of non-obviousness.” *Millennium Pharms., Inc. v. Sandoz Inc.*, 862 F.3d 1356, 1369 (Fed. Cir. 2017). Evidence of a long felt but unresolved need tends to show non-obviousness because it is reasonable to infer that the need would have not persisted had the solution been obvious. *WBIP*, 829 F.3d at 1332.

Patent Owner contends that there was a long-felt but unmet need for a sexual stimulation device that provided sexual pleasure while minimizing potential side effects. Resp. 71 (citing Ex. 2038 ¶¶ 55–57). Patent Owner contends that the use of prior art stimulation devices could cause numbness or damage to genitalia creating a need for a device which avoided these effects. Resp. 72. Citing the testimony of Dr. Herbenick, Patent Owner contends that the Womanizer® products satisfied this need. *Id.* at 71–72 (citing Ex. 2038 ¶¶ 55–57).

⁷ The analysis also requires a showing of a nexus between the claimed features and the sales of the relevant product. *Applied Materials*, 692 F.3d at 1299.

In its Reply, Petitioner contends that indirect stimulation devices such as the claimed device were known in the art before the invention of the claimed device and that such devices would have avoided the side effects recited by Dr. Herbenick. Reply 26. Petitioner also contends that Patent Owner has not presented any empirical data to show that the commercial embodiments filled the long-felt need. *Id.*

In its Sur-Reply, Patent Owner contends that the testimony of Dr. Herbenick is sufficient to support a finding that the Womanizer® products satisfied a long-felt need. Sur-Reply 24.

We have considered the arguments presented by the parties and the evidence of record and conclude that Patent Owner has shown that there was a long-felt need that was satisfied by the Womanizer® products. Dr. Herbenick testified that she led a study of women who used vibrators and found that 28.5% of those women experienced one or more side effects including genital numbness, pain, irritation, inflammation/swelling, tears or cuts. Ex. 2038 ¶ 56 (citing Ex. 2011, 1861–63, Table 5). Dr. Herbenick testified that these injuries resulted in the need for a sexual stimulation device that “met the need for sexual stimulation devices that facilitate orgasm but without physically coming into contact with the clitoris.” *See id.* ¶ 57. Dr. Herbenick testified that the Womanizer® products satisfied this need

by providing alternating positive and negative pressures to the clitoris so as to provide indirect stimulation to the clitoris sufficient to facilitate female orgasm. This is important as my research, published in a 2009 issue of the Journal of Sexual Medicine, had found that physical contact has caused numbness or even tears or cuts in a subset of female vibrator users.

Id. Dr. Herbenick also testified that the prior art devices failed to meet this need. *Id.* ¶ 58.

Petitioner contends that indirect stimulation devices were known in the art. Reply 26. We find this argument unpersuasive. Petitioner cites to the testimony of Dr. Herbenick to support this contention. *Id.* However, a careful reading of the cited pages reveals that Dr. Herbenick testified that, in the study she conducted, women were merely asked what type of vibrator they used, but not whether the vibrator was used directly or indirectly. Ex. 1023, 61–62. We also note that Dr. Herbenick testified that at the time she conducted her study, most of the vibrators available in the market would have been direct vibration without a lot of indirect stimulation devices. Ex. 1023, 62–63. While she testified that there were some devices in the market that provided indirect stimulation, they were suction-only devices that were less popular. *Id.* Dr. Herbenick testified that these suction-only devices are not the same as the Womanizer® devices, which apply alternating positive and negative pressures. *Id.*

Petitioner also contends that Patent Owner has failed to present any empirical data to support that the Womanizer® products fulfill the long-felt need. Reply 26. Again we are unpersuaded by Petitioner’s argument. Petitioner has not stated what specific “empirical data” is needed to show that the Womanizer® products fulfill the need, nor has Petitioner cited any case law holding that such data is required. *Id.* Moreover, Petitioner has not presented any evidence to rebut Dr. Herbenick’s conclusion that the Womanizer® devices fulfill the long-felt need.

In reaching our decision that the Womanizer® products fulfilled a long-felt need in the market for female sexual stimulation devices that have fewer detrimental side effects, we credit Dr. Herbenick’s extensive

experience in studying sexual health and behavior, including vulvar and vaginal health, as well as the use of sexual enhancement products such as vibrators including her detailed studies reported in Exhibit 2010. Ex. 2038 ¶¶ 7, 12, 13, 16, 55–59. Petitioner did not offer any expert with a similar expertise to rebut Dr. Herbenick’s testimony.

d) Failure of Others

Evidence that others tried but failed to develop a claimed invention may carry significant weight in an obviousness inquiry. *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1081 (Fed. Cir. 2012). This objective indicia factor is closely tied to the long-felt need factor discussed above. *Id.* at 1082 (“Longfelt need is closely related to failure of others.”).

Patent Owner contends that prior to the development of the Womanizer® products, “experts in sexual health and behavior were well aware of the potential adverse side effects of using vibrators for sexual stimulation, yet no one had successfully designed a product that facilitated orgasm while physically contacting the clitoris without also having these potential side effects, despite numerous attempts.” Resp. 72. In support of this contention, Patent Owner cites Dr. Herbenick’s testimony that while experts in the field were aware of the issues of clitoral discomfort and numbness that arose from direct clitoral contact, none of the prior art devices accomplished the goal of providing a stimulation device without discomfort or numbness. *Id.*; Ex. 2038 ¶¶ 58–61.

Petitioner does not address Patent Owner’s argument or evidence. *See* Reply 22–27.

We find that Patent Owner has persuasively shown that others in the field failed to develop a sexual stimulation device that avoided the issues of clitoral discomfort or numbness.

Dr. Herbenick testified based on her own experience in teaching the use of various stimulation devices and her work in developing such devices that no one had developed a product that achieved sexual stimulation in the same manner as the Womanizer® devices. Ex. 2038 ¶¶ 60–62.

Dr. Herbenick testified that each prior device of which she was aware was limited to “either direct contact (such as a vibrator or flicking) or was limited to providing suction.” *Id.* ¶ 62. Neither of these approaches solved the issue of clitoral discomfort or numbness. *See id.*

e) Skepticism

Evidence of industry skepticism about whether or how a problem could be solved, or the workability of the claimed solution, weighs in favor of nonobviousness of the claimed invention. *United States v. Adams*, 383 U.S. 39, 52 (1966); *WBIP*, 829 F.3d at 1335.

Patent Owner contends that “industry experts and participants were skeptical about the commercial embodiments and, specifically, about how modulating between positive and negative air pressure might facilitate orgasm.” Resp. 73 (citing Ex. 2038 ¶¶ 63–67).

Petitioner contends that skepticism must be evaluated from the viewpoint of industry experts and that, with the exception of Dr. Herbenick, the evidence submitted by Patent Owner is limited to consumer reviews. Reply 27 (citing *WBIP*, 829 F.3d at 1335; *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1365 (Fed. Cir. 2007)).

We have considered the arguments presented by the parties and the evidence of record and find that Patent Owner has shown industry

skepticism relating to the Womanizer® products. Although we agree with Patent Owner that most of the reviews cited by Dr. Herbenick are consumer reviews and not experts in the field, the compilation of reviews cited by Dr. Herbenick includes reviews from experts who expressed skepticism about the products. For example, there is a review by Dr. Emily Morse, “a sexologist with a doctorate in human sexuality,” who expressed skepticism about the product in her review. Ex. 2018, 78. Another expert is Vanessa Marin, a licensed psychotherapist specializing in sex therapy, who reviewed the product and expressed skepticism about it. Ex. 2016, 124–128. These reviews in addition to the testimony of Dr. Herbenick show industry skepticism about the Womanizer® products. Ex. 2038 ¶¶ 63–67.

f) Praise by Others

Evidence of industry praise of the claimed invention weighs in favor of nonobviousness. *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1053 (Fed. Cir. 2016). Evidence of industry praise may include evidence of industry awards given to commercial embodiments of the claimed invention. *See Henny Penny Corp. v. Frymaster, LLC*, 938 F.3d 1324, 1333–1334 (Fed. Cir. 2019) (finding evidence of industry praise, including industry awards for the patented product).

Patent Owner contends that, notwithstanding the industry skepticism discussed above, the industry has also praised the Womanizer® products extensively. Resp. 73. Patent Owner contends that reviews of the Womanizer® products have described them as “innovative, unique, and [in] other similar terms.” *Id.* at 73–74 (citing Ex. 2038 ¶ 68). Patent Owner also contends that the Womanizer® has been honored with many awards. *Id.* at 75.

Petitioner has not presented any arguments in response to Patent Owner's showing. *See* Reply 21–27.

We find that Patent Owner has presented sufficient evidence showing praise in the industry favoring a finding of non-obviousness. As Dr. Herbenick testified,

[t]he Womanizer has been honored with many awards, several of them recognizing the entire brand or product line. As examples, the Womanizer W-100 was named the Most Innovative Female Product at the ADULTEX Awards on May 3, 2015. On May 30, 2015, the Womanizer was named Best New Female Product by the ETO Awards. In January 2016, the Womanizer W-100 was named Outstanding Product for Women at the Adult Video News (AVN) O Awards hosted at the AVN Novelty Expo in Las Vegas, Nevada. The Womanizer was also named Product of the Year in each of 2015 and 2016, as well as Product Line of the Year in 2017 by the EROTIX Awards.

Ex. 2038 ¶ 74 (footnotes omitted, citing Ex. 2044, 1, 6, 13, 17, 13, and 30). In addition, the Womanizer® products have received praise by both sex toy retailers and consumers. Ex. 2038 ¶¶ 68–75.

g) Copying

“Copying may indeed be another form of flattering praise for inventive features.” *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1311 (Fed. Cir. 2010).

Patent Owner contends that Petitioner and others have copied the Womanizer® products and that this copying supports a finding on non-obviousness. Resp. 75–80. In support of this contention Patent Owner points to Petitioner's statement that it would stop selling devices that violated Patent Owner's German equivalent of the '851 patent as well as a decision of a German court that a later version of Petitioner's product infringed that patent. *Id.* at 75–77. Patent Owner also points to a statement submitted by

Petitioner in an unfair competition lawsuit where a store owner stated that Petitioner had “ripped off the technology of Womanizer.” *Id.* at 77. Patent Owner also cites to various product reviews comparing Petitioner’s products to Patent Owner’s. *Id.* at 77–79. Patent Owner also cites to reviews of other products which compare the products to the Womanizer. *Id.* at 79–80.

Petitioner contends that Patent Owner’s evidence of copying is insufficient as it comprises conclusory statements based on undisclosed testing and data. Reply 25. With respect to the decision of the German court, Petitioner contends that this is not evidence of copying as there is no evidence that Petitioner or anyone else “changed any designs to copy the ’851 after learning of the patent.” *Id.* at 25–26.

Patent Owner responds by again pointing to Petitioner’s statement regarding infringing the German equivalent of the ’851 patent. Sur-Reply 23–24. Patent Owner contends that Petitioner has offered only attorney argument that does not rebut the evidence of copying. *Id.*

Copying in the context of objective indicia of non-obviousness can be demonstrated either through internal documents, direct evidence such as disassembling a patented prototype, photographing its features, and using the photograph as a blueprint to build a virtually identical replica, or access to, and substantial similarity to, the patented product (as opposed to the patent). *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004). Marketing materials may also be used to show copying. *See Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1368 (Fed. Cir. 2012).

We have considered the arguments presented by the parties and the evidence of record and find that Patent Owner has presented sufficient evidence of copying to support a finding of non-obviousness. Patent Owner

first marketed its Womanizer product in 2014. Ex. 2038 ¶ 77. Petitioner produced its first Satisfyer product just over a year later. *Id.* Petitioner acknowledged that this device violated Patent Owner’s “technical property rights” and withdrew the product from the market. *Id.* ¶ 78; Ex. 2045 (Novoluto press release).

Petitioner then launched a second version of the product which Petitioner described as offering “pressure wave stimulation and contactless clitoral stimulation.” Ex. 2038 ¶ 79; Ex. 2019. Petitioner also describes its Satisfyer products as providing “a touch-free climax” and offering a “rapid change between suction and pressure.” Ex. 2038 ¶ 83; Ex. 2021. Patent Owner has also introduced evidence that shows that Petitioner’s products are substantially similar to the Womanizer products. Ex. 2038 ¶¶ 82–83, 86–87; *see, e.g.*, Ex. 2016, 102–105; Ex. 2020. This demonstrates that Petitioner had access to the Womanizer products and produced products substantially similar to the patented product.

Patent Owner has also introduced persuasive evidence that other manufacturers have copied the Womanizer products. Ex. 2038 ¶¶ 84–85, 88; *see, e.g.*, Exs. 2046–2049. One example of a device sold by other manufacturers that copies the claimed invention is the Blowfish clitoral stimulator which was described as mimicking the technology of the Womanizer. Ex. 2049; Ex. 2038 ¶ 84.

Given this evidence of the similarity of the competitive products to the Womanizer® products and Petitioner’s failure to offer any persuasive evidence in rebuttal, we find that Patent Owner has presented persuasive evidence of copying to support a conclusion of non-obviousness.

h) Conclusion

Based on the foregoing we conclude that Patent Owner has presented sufficient evidence relating to objective indicia to support a finding of non-obviousness. Although Patent Owner failed to present persuasive evidence relating to commercial success, Patent Owner has presented persuasive evidence relating to long-felt need, failure of others, praise by others, and copying. Patent Owner has also shown a nexus between its commercial products and the claimed invention. In sum, several types of objective indicia evidence in the record weigh in favor of a determination that the challenged claims are non-obviousness.

6. The Remaining Claims

All of the remaining claims challenged in Ground 1 include a limitation calling for modulation of positive and negative pressures with respect to a reference pressure. Based on our analysis above, we find that Petitioner has not presented sufficient persuasive evidence that the subject matter of the remaining claims would have been obvious over Guan combined with Hovland and that Patent Owner has presented persuasive evidence regarding objective indicia of non-obviousness.

7. Conclusion

From the foregoing analysis, and weighing all of the evidence and arguments presented by both sides, we conclude that Petitioner has not demonstrated by a preponderance of the evidence that the subject matter of 1, 2, and 4–6 would have been obvious to one of ordinary skill in the art over Guan combined with Hovland.

E. Grounds 2 and 3

The remaining grounds rely on the combination of Guan and Hovland as advanced in Ground 1. *See* Pet. 64–72. Petitioner does not point to nor do

we discern any teaching in Gloth or Makower that remedies the deficiencies of Guan and Hovland discussed above. *See id.* Thus, for the reasons stated above for Ground 1, we find that Petitioner has not demonstrated that claims 3, 5, and 6 are unpatentable as obvious.

III. PETITIONER’S MOTION TO EXCLUDE

Petitioner has moved to exclude Patent Owner’s two expert declarations (Exhibits 2036 and 2038), as well as Exhibit 2048. Paper 40 (“MTE”). For the reasons set forth below, Petitioner’s Motion is denied.

A. Exhibit 2038 — Declaration of Dr. Herbenick

Petitioner contends that we should either exclude the testimony of Dr. Herbenick or afford it little weight for several reasons. First, Petitioner contends that Patent Owner failed to comply with 37 C.F.R. § 42.65(b) in that Patent Owner failed to provide an affidavit explaining how certain tests that Dr. Herbenick relied upon were performed. MTE 2–5. Second, Petitioner contends that Patent Owner failed to produce all documents relied upon by Dr. Herbenick in rendering her opinions. *Id.* at 6–9. Third, Petitioner contends that the testimony of Dr. Herbenick should be excluded because of allegedly improper objections made by counsel for Patent Owner during Dr. Herbenick’s deposition. *Id.* at 9–13. Fourth, Petitioner contends that Dr. Herbenick is not qualified to testify as a technical expert. *Id.* at 15. Finally, Petitioner contends that we should strike Dr. Herbenick’s testimony as she did not disclose her work as a witness in other proceedings. Paper 43, 5 (“MTE Reply”).

We address each of these arguments in turn.

1. Failure to Comply with 37 C.F.R. § 42.65(b)

Petitioner contends that we should exclude or give little weight to all of Dr. Herbenick’s testimony because her declaration does not provide any

information relating to the experiments that produced the graph discussed in paragraph 47 of her declaration. MTE 2–3. While Petitioner may be correct with respect to Dr. Herbenick’s failure to adequately describe what tests led to the graph on paragraph 47 of her declaration, we find this objection moot as we did not rely on that part of her testimony.

Petitioner also argues that we should exclude or give little weight to Dr. Herbenick’s testimony about the different components in the Womanizer® products as Patent Owner did not provide an affidavit concerning the deconstruction and observation of the devices. MTE 4–5. We do not find that this is a sufficient reason to exclude or discount Dr. Herbenick’s testimony. Rule 42.65(b) refers to “technical” tests. We find that dismantling a device and identifying the components of the device does not constitute a “technical” test within the scope of the Rule. We therefore decline to exclude or give little weight to that portion of her testimony.

2. Withheld Documents and Information

Petitioner contends that we should exclude or give little weight to the testimony of Dr. Herbenick because Patent Owner failed to provide all the relevant facts and data that support Dr. Herbenick’s opinions. Specifically, Petitioner contends that Patent Owner failed to produce drafts of Dr. Jensen’s declaration that Dr. Herbenick reviewed in connection with her declaration and documents relating to the differences between the various Womanizer products. MTE 5–8. Petitioner also points to Dr. Herbenick’s failure to disclose the fact that she has testified for Patent Owner in other

matters as evidence that Patent Owner has withheld other information and documents. MTE 8–9. We address each of these issues in turn.⁸

a) Draft Declarations

We find that Petitioner’s objection to Dr. Herbenick’s declaration on the basis that Patent Owner did not produce the draft of Dr. Jensen’s declaration that Dr. Herbenick reviewed in connection with her declaration to be without merit. We agree with Patent Owner that the declarations of the other experts do not constitute facts or data as that term is used in 37 C.F.R. § 42.65(b) that would be required to be produced. Paper 41, 6–7 (“MTE Resp.”)

Petitioner contends that Patent Owner failed to produce documents relating to the differences between the various Womanizer products and that those difference show that there are technical differences between the products. MTE 7–8. Petitioner contends that this contradicts the testimony of Patent Owner’s experts that the mechanics of the two products are the same. *Id.*

We find that Petitioner’s objection on this ground is without merit. To begin, Patent Owner’s experts acknowledged that the various Womanizer products were different but that the difference did not affect their analyses. Ex. 2036 ¶ 41; Ex. 2038 ¶ 35. Moreover, the “technical difference” identified by Petitioner relates to lights on the device, a feature that does not appear to be related to the issue of whether the devices embody the claimed inventions. MTE 7.

⁸ We note that at no time during this proceeding did Petitioner seek assistance from the panel to obtain the documents it now says warrant excluding Dr. Herbenick’s testimony.

b) Dr. Herbenick's Alleged Bias

Petitioner contends that Dr. Herbenick failed to disclose that she had testified for Patent Owner in other proceedings, which demonstrates Dr. Herbenick's bias and Patent Owner's withholding of relevant information. MTE 7–8; MTE Reply 5. We are not persuaded that this warrants excluding Dr. Herbenick's testimony. Although the testimony regarding Dr. Herbenick's work for Patent Owner may be relevant, it goes to the issue of credibility, not admissibility. *See, e.g., NuVasive, Inc. v. Iancu*, 752 F. App'x 985, 996 (Fed. Cir. 2018) (“While the Board can and should weigh the credibility of any expert testimony, it should not outright disregard expert testimony from a witness simply because that individual is compensated for his time and expense in testifying.”).

3. Patent Owner's Alleged Misconduct

Petitioner contends that the testimony of Dr. Herbenick should be excluded because of alleged misconduct by Patent Owner's counsel during the depositions Dr. Herbenick and Dr. Jensen. MTE 9–13. Petitioner contends that counsel for Patent Owner repeatedly made speaking objections which coached the witness and affected Petitioner's ability to obtain discovery. *Id.*

Patent Owner contends that the objections were proper and necessitated by misrepresentations made by Petitioner's counsel. MTE Resp. 10–12. Patent Owner also argues that even if the objections were improper, exclusion of the expert's declarations is not the proper remedy. *Id.* at 12.

We begin by noting that several of the alleged speaking objections identified by Petitioner were from depositions in other proceedings and are not relevant to the issue of excluding testimony in this proceeding. Exhibits

1022 and 1023 are transcripts from IPR2019-01444 and Exhibits 1053 and 1054 are from IPR2020-00007.

With respect to this proceeding, Petitioner has identified only one possible instance of a speaking objection. We do not find this to be such egregious conduct as to warrant excluding Dr. Herbenick's testimony. Moreover, the testimony affected by the alleged improper objections has no bearing on our decision. The question related to the teachings of the Taylor references which are not at issue in this proceeding. Ex. 1016, 183.

Given the single alleged speaking objection and the fact that the affected testimony is not relevant to our decision, we decline to exclude Dr. Herbenick's testimony.

4. Dr. Herbenick's Expertise

Petitioner contends that Dr. Herbenick lacks the relevant technical expertise to testify about the validity of the '851 patent or whether Patent Owner's commercial products embody the claims of the '851 patent. MTE 15. We do not find that Petitioner has stated sufficient grounds to exclude Dr. Herbenick's testimony.

While Dr. Herbenick does not have a technical degree or an extensive technical background, she has extensive experience evaluating and designing sex toys. *See, e.g.*, Ex. 2038 ¶¶ 55–59 (evaluation of the long-felt need in the industry). It is in this context that Dr. Herbenick's testimony has been offered and relied upon by us in reaching our decision. *See SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010) (noting that there is no requirement of a perfect match between the expert's experience and the relevant field).

On the issue of validity, most of Dr. Herbenick's testimony has been with respect to objective indicia, an issue about which we find

Dr. Herbenick well qualified to opine. The only “technical” testimony offered by Dr. Herbenick that we rely upon is her identification of the various components found in the Womanizer® devices. Ex. 2038 ¶¶ 35–52. With the exception of her opinion regarding modulation of positive and negative pressures, we find that her experience in evaluating and designing sex toys gives her a sufficient background to provide opinion testimony regarding various components of the devices. *See* Ex. 2038 ¶¶ 4–17.

With respect to Dr. Herbenick’s testimony regarding modulation of positive and negative pressures, we have not relied on Dr. Herbenick’s testimony in reaching our decision.

Dr. Herbenick did not offer any technical analysis of the prior art, therefore her alleged lack of understanding regarding how the prior art operated is irrelevant to the question of whether her testimony should be excluded.

5. Conclusion

From the foregoing analysis we see no reason to exclude Dr. Herbenick’s testimony or to give it little weight. For this reason, that portion of Petitioner’s Motion to Exclude is denied.

B. Exhibit 2036 — Declaration of Dr. Jensen

Petitioner contends that the testimony of Dr. Jensen should be excluded or given little weight. MTE 1. As with Dr. Herbenick’s testimony, Petitioner cites several reasons to exclude Dr. Jensen’s testimony. First, Petitioner contends that Patent Owner violated 37 C.F.R. § 42.65(b) by not providing a proper affidavit describing Dr. Jensen’s experiment. *Id.* at 2–4. Second, Petitioner contends that Patent Owner did not produce all documents Dr. Jensen relied upon in reaching his opinions. *Id.* at 6–9. Finally, Petitioner contends that improper conduct by Patent Owner’s

counsel during the deposition of Dr. Jensen warrants exclusion of Dr. Jensen's testimony. *Id.* at 9–13.

1. Failure to Comply with 37 C.F.R. § 42.65(b)

While Petitioner contends that Dr. Jensen's declaration does not comply with 37 C.F.R. § 42.65(b), Petitioner does not state how the declaration fails to comply with the Rule. *See* MTE 2–4. Petitioner's arguments focus on alleged deficiencies in Dr. Jensen's methodology, which would go to the weight to be afforded such testimony, and do not address any failure to comply with our Rules.⁹ *Id.*

Moreover, failure to comply with 37 C.F.R. § 42.65(b) also goes to the weight given the evidence. *Emerson Elec. Co. v. IPCO, LLC*, IPR2017-00213, Paper 42 at 25–26 (PTAB May 11, 2018) (affording expert testimony no weight for failure to comply with 37 C.F.R. § 42.65(b)); *Altair Pharm., Inc. v. Paragon Biotech, Inc.*, PGR2015-00011, Paper 48 at 16–17 (PTAB Nov. 14, 2016) (“Without the necessary information prescribed in §42.65(b), we cannot determine whether the evidence . . . is credible.”). Therefore we decline to exclude Dr. Jensen's for failure to comply with 37 C.F.R. § 42.65(b).

⁹ Petitioner contends that Dr. Jensen's procedure does not comply with the FDA's guidance for good laboratory practices found at 21 C.F.R. § 58. That section of the regulations relates to product safety testing and is irrelevant to any issue before us. *See* 21 C.F.R. § 58.1(a). Moreover, Petitioner's argument regarding compliance with the FDA rules and well as Petitioner's argument that Dr. Jensen's test is impossible to replicate is unsupported by any evidence. “Attorneys' argument is no substitute for evidence.” *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989).

2. Withheld Documents and Information

Petitioner's arguments with respect to this issue are the same as for Dr. Herbenick's declaration discussed above. MTE 6–9. For the same reasons given above, we decline to exclude Dr. Jensen's declaration.

3. Patent Owner's Alleged Misconduct

Petitioner's arguments with respect to this issue are the same as for Dr. Herbenick's declaration discussed above. MTE 8–12.

We note that, with respect to Dr. Jensen's deposition in this proceeding, Petitioner identified only two allegedly improper objections. MTE 11–12. A review of the testimony reveals that the questions relate to the definition of the term “sexual pleasure” as it is used in the '851 patent. Ex. 1015, 56–58. The term “sexual pleasure” is not in dispute in this proceeding. We do not believe that two alleged speaking objections about a term that is not in dispute warrants excluding Dr. Jensen's declaration.

4. Conclusion

Based on the foregoing we deny Petitioner's Motion to Exclude as it relates to Exhibit 2036.

C. Exhibit 2048

Petitioner contends that Exhibit 2048 should be excluded on the grounds of hearsay and lack of authenticity. MTE 13.

In reaching our decision we did not rely on Exhibit 2048. We therefore dismiss as moot Petitioner's motion with respect to Exhibit 2048.

D. Conclusion

For the reasons stated above, we deny Petitioner's Motion to Exclude in its entirety.

IV. CONCLUSION

Weighing the evidence of the disclosures of the references, the competing testimony, the reasoning to combine the references, and the evidence showing secondary indicia of non-obviousness, we determine that Petitioner has failed to show, by a preponderance of the evidence, that any of claims 1–6 of the '851 patent is unpatentable.

We also deny Petitioner's Motion to Exclude.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–6 of the '851 patent are not determined to be unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude is denied; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1–2, 4–6	103	Guan, Hovland		1, 2, 4–6
3	103	Guan, Hovland, Gloth		3
5, 6	103	Guan, Hovland, Makower		5, 6
Overall Outcome				1–6

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