

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EIS GMBH,
Petitioner,

v.

NOVOLUTO GMBH,
Patent Owner.

Case IPR2020-00007
Patent 9,849,061 B2

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

MITCHELL, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Request for Rehearing of Decision Denying Institution
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314; 37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner EIS GMBH (“Petitioner”) filed a Request for Rehearing of the Decision Denying Institution of *Inter Partes* Review (Paper 8, “Dec.”) of claims 1–3, 5, 7, 8, 11, 14, 15, 17–21, and 23–26 (the “challenged claims”) of U.S. Patent No. 9,849,061 B2 (Exhibit 1001, “the ’061 Patent”). Paper 9, “Req. Reh’g.” For the reasons that follow, the Request for Rehearing is *granted*, and we institute *inter partes* review.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. *Id.*

When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

III. ANALYSIS

Petitioner asserts that we failed to view the evidence in the light most favorable to the Petitioner, and made findings that are not supported by the evidence. Req. Reh’g 1. For instance, Petitioner asserts that we failed to accord sufficient credence to the testimony offered by Petitioner’s declarant,

Michael R. Prisco, P.E., Ph.D., who “testified that a person of skill in the art (POSITA) would understand that *Taylor*’s¹ Fig. 3 depicts a bellows 160 that is neither fully compressed nor expanded, with a single opening connected to suction cup member 156 sealingly engaged with the body to form a closed system.” Req. Reh’g 2 (citing Ex. 1002 (Dr. Prisco’s Declaration) ¶¶ 64, 75(vii), 104). Concomitantly, Petitioner asserts, we accorded too much credence to the testimony of Patent Owner’s declarant, Morten Olgaard Jensen, Ph.D., Dr.Med., with respect to the meaning of “and/or” and “modulation” as used in Hovland’s² disclosure. *Id.* at 3 (citing Dec. 25–29; Prelim. Resp. 63–66).

Petitioner also asserts that the following conclusions were not sufficiently supported by record evidence:

1. Our finding based on a dictionary definition of “bellows” to mean unidirectional flow from two openings versus bidirectional flow from a single opening, Petitioner asserts, “adds an additional component (an opening or valve) to *Taylor*’s bellows 160 that is neither disclosed nor taught in the reference in order to find that the *Taylor* system is not closed.” Req. Reh’g 7–8; and
2. Our finding that Hovland teaches the modulation of specific effects such as sub-atmospheric and super-atmospheric pressures, but does not teach modulation between these disparate effects, Petitioner asserts, belies the plain meaning of “and/or” in the phrase

¹ Taylor, U.S. Patent No. 5,725,473, issued Mar. 10, 1998 (Ex. 1004, “Taylor”).

² Hovland et al., U.S. Patent No. 6,964,643 B2, issued Nov. 15, 2005 (Ex. 1006, “Hovland”).

“subatmospheric pressure *and/or* superatmospheric pressure, or modulation of these effects,” *Id.* at 14–15.

Upon further reflection and review of the record, we are persuaded by Petitioner’s contentions that we misapprehended or overlooked its arguments as to the appropriate weight that we should accord Dr. Prisco’s testimony versus the testimony of Dr. Jensen and what findings we can draw on this preliminary record from the teachings of the asserted references in light of what one of skill in the art would glean from these references. Because we agree with Petitioner that we misapprehended or overlooked certain of its arguments material to the institution decision, we grant the rehearing request as explained in greater detail below. Before revisiting that issue, however, we first address the threshold issue raised by Patent Owner that we should exercise our discretion and deny institution of the Petition under 35 U.S.C. § 325(d).

A. 35 U.S.C. § 325(d)

Section 325(d) provides that the Board, exercising discretion on the Director’s behalf, may elect not to institute a proceeding if the challenge to the claims of the patent is based on “the same or substantially the same prior art or arguments” previously presented to the Office. 35 U.S.C. § 325(d); 37 C.F.R. § 42.4(a); *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6, 7 (PTAB Feb. 13, 2020) (precedential). We apply the factors set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017), to make this highly fact intensive determination. *Advanced Bionics*, Paper 6, 7.

The non-exclusive *Becton, Dickinson* factors that provide the most guidance for us to determine whether “the same or substantially the same

prior art or arguments” were before the Examiner during prosecution of the ’061 Patent are the following: (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; and (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art. *Advanced Bionics*, Paper 6, 9 n.10, 10. If, after review of these factors, we determine that the same or substantially the same art or arguments previously were presented to the Office, we look to *Becton, Dickinson* factors (c), (e), and (f) to determine whether the Petitioner has demonstrated a material error by the Office. *Id.* at 10.³ These additional factors are as follows: (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments. *Id.* at 9, n.10.

Patent Owner acknowledges that neither Taylor nor Zipper,⁴ two of the three prior art references asserted against the challenged claims, were

³ “[U]nder § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics*, Paper 6, 8.

⁴ Zipper, US 2013/0261385 A1, published Oct. 3, 2013 (Ex. 1007, “Zipper”).

before the Examiner during prosecution of the '061 Patent, but asserts that “[a]ll grounds recycle prior art and/or arguments already considered by the Office.” *See* Prelim. Resp. 18. Patent Owner asserts that Taylor is similar to Fang⁵ that was considered by the Office during the prosecution of the '061 Patent, and Zipper is similar to Mertens⁶ and Wei⁷ that were both considered by the Office during prosecution of the '061 Patent. *Id.* at 18–29. Patent Owner also asserts that Hovland, the third piece of art asserted against the claims of the '061 Patent, was considered during prosecution of the '061 Patent. *Id.* at 24–25.

In all four grounds in the Petition, Petitioner relies on Taylor for teaching the modulation of positive and negative pressures with respect to a reference pressure with Hovland serving as a second reference to teach such modulation should we conclude that Taylor falls short. *See* Pet. 34–37 (Ground I); Pet. 66–71 (Ground II) (stating “if it is argued that compression and expansion of *Taylor*’s bellows 160 somehow does not result in a pattern of negative and positive pressures, modulated with respect to a reference pressure, as required by claims 1 and 21, it would have been obvious to a POSITA to modify *Taylor*’s stimulation device with the teachings of *Hovland* to apply modulated super-atmospheric pressure along with *Taylor*’s ‘cyclical vacuum’ (i.e., sub-atmospheric pressure) to achieve the benefits described by *Hovland*”); Pet. 84 (Ground III); Pet 85–86 (Ground IV). Petitioner adds Zipper in Grounds 3 and 4 challenging claim 20 alone to teach the remote control device limitation. Pet. 80–86.

⁵ Fang, U.S. Patent No. 5,377,701, issued Jan. 3, 1995 (“Fang”).

⁶ Mertens, US 2013/0116503, published May 9, 2013 (“Mertens”).

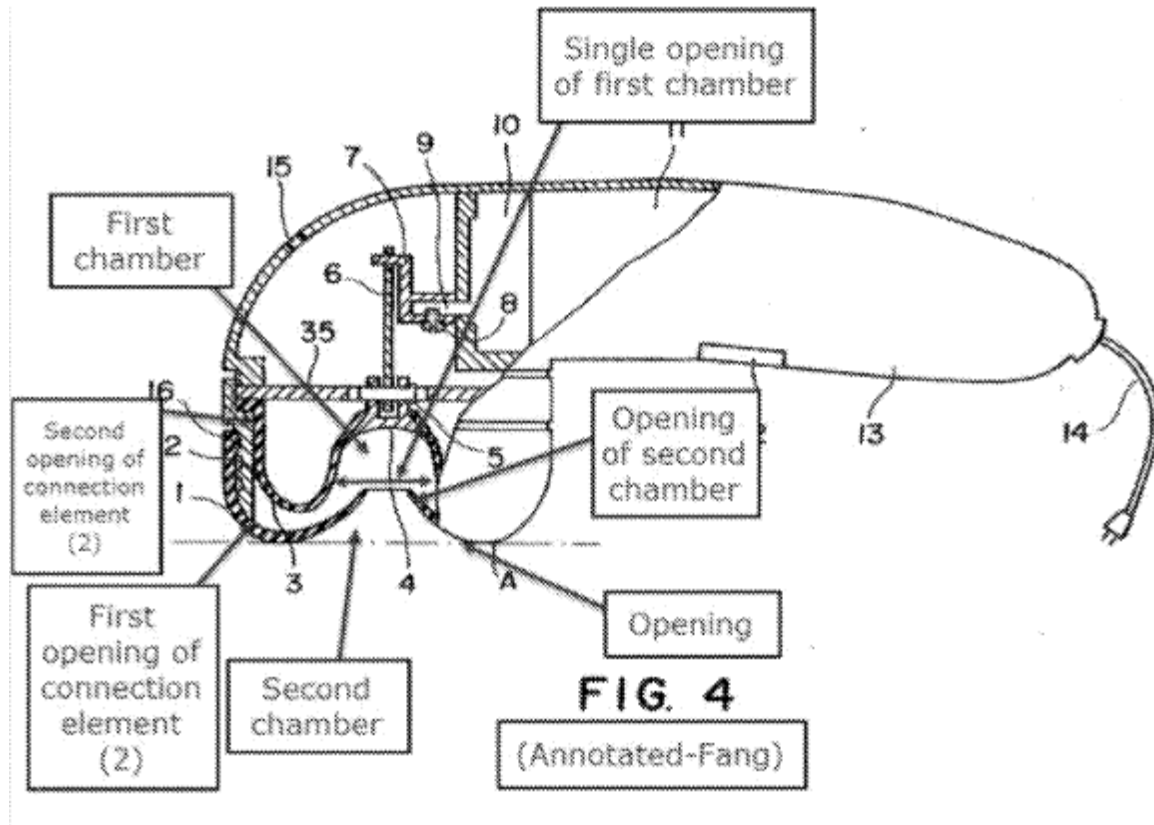
⁷ Wei, CN10260034, published July 25, 2012 (Ex. 1003, 137–144, “Wei”).

The core of the dispute between the parties focuses on whether Taylor alone or any of the combinations asserted by Petitioner teaches “wherein the stimulating pressure field generated in the at least one second chamber comprises a *pattern of negative and positive pressures, modulated [] with respect to a reference pressure,*” that is required by each challenged claim. Ex. 1001, 16:37–40 (Claim 1) (emphasis added), 18:14–17 (Claim 20), 18:30–34 (Claim 21) (“modulating, by a drive unit of the stimulation device interacting with the pressure field generating arrangement, the pressure field in a *pattern of negative and positive pressures with respect to a reference pressure*”) (emphasis added); see Prelim. Resp. 53–70. Thus, in determining whether “the same or substantially the same prior art or arguments” were previously presented to the Office, we will focus our analysis on whether Taylor or Petitioner’s arguments based on Taylor are substantially the same as Fang or the Examiner’s arguments based on Fang during prosecution of the ’061 Patent.

Patent Owner asserts that “Petitioner merely repeats the Examiner’s arguments about Fang, substituting Taylor for Fang,” in the Petition. Prelim. Resp. 21. Specifically, Patent Owner asserts that “Petitioner argues that Taylor fulfills the ’061 Patent’s requirements in claim 1 for ‘a pattern of negative and positive pressures, modulated with respect to a reference pressure’ (Pet. 21–23), even though, as was the case with Fang, Taylor only discloses suction, not positive pressure or modulation between positive and negative pressures.” Prelim. Resp. 21.

1. *Prosecution History of the '061 Patent*

The Examiner rejected claims 1, 3–5, 7–8, 11, 16, and 18 as obvious over Fang. The Examiner referred to the following annotated Figure 4 of Fang to illustrate how Fang taught the subject matter of the rejected claims.



Ex. 1003, 197. The Examiner asserted that annotated Figure 4 above shows the pressure field generator comprising a first chamber, a second chamber with an opening for placing over a body part, and a connection element connecting the first and second chambers. *Id.* at 197–198.

The Examiner also asserted that annotated Figure 4 shows:

a drive unit (6, 10, and 11, fig. 2, Col 4, lines 23-27) that changes the volume of the first chamber in such a manner that a stimulating pressure field is generated in the second chamber via the connecting element (Col 4, lines 23-56, Fang discloses that the negative pressure is formed when the diaphragm (3) is deformed, the deformation of the diaphragm caused by the

drive unit causes the volume of the first chamber to change, and since the connecting element (2) connects the first chamber and the second chamber, the change in volume from the first chamber to the second chamber is via the connecting element); and a control device that actuates the drive unit (12, figs. 1-4, Col , lines 12-17); wherein: the pressure field generated in the second chamber (see the annotated-Fang fig. 4 above) consists of a pattern of negative and positive pressures modulated with respect to a normal pressure (see figs. 1-4 and Col 4, lines 23-56, **the stimulating device is capable of producing suction (negative pressure) when the diaphragm is being deformed away from the second chamber, therefore, when the diaphragm (3) is deformed toward the second chamber, the diaphragm would produce a positive pressure compared to the normal pressure, wherein normal pressure is the ambient pressure when the diaphragm is not being deformed in either directions**), the first chamber is connected solely with the second chamber by the connection element (see fig. 2 and the annotated-Fang fig. 4 above, the first chamber is fluidly connected exclusively with the second chamber by the connection element (2)).

Id. at 198 (emphasis added).

2. Patent Owner's Arguments

Patent Owner asserts that the Examiner's view of Fang's ability to modulate positive and negative pressures with respect to a reference pressure in the bolded and italicized portion of the quote from the prosecution history set forth above "are the same arguments Petitioner now asserts with respect to Taylor." Prelim. Resp. 19. Patent Owner responded to the Examiner's assertions concerning Fang that "Fang's apparatus 'purely acts with negative pressure (i.e., as a vacuum) on the skin.' [Patent Owner] further explained that Fang's apparatus cannot produce a positive pressure, because air is released by disconnecting drawing member 4 (acting as a valve) before any positive pressure can be generated." *Id.* at 20 (citing Ex. 1003, 183). After

this response, Patent Owner asserts that the Examiner allowed the claims of the '061 Patent. *Id.* at 21. Patent Owner concludes that “Petitioner merely repeats the Examiner’s arguments about Fang, substituting Taylor for Fang.” *Id.* 21.

3. *Analysis*

To determine whether Taylor and Fang are substantially the same art or whether substantially the same arguments concerning the teachings of these two pieces of art are being made by the Examiner during prosecution of the '061 Patent and the Petitioner here, a further review of Fang and Taylor is instructive. Taylor and Fang appear to work differently.

Fang (Ex. 3001)

For instance, with reference to annotated Figure 4 set forth above, Fang describes the mechanism of the “sucking massage device” for removing facial wrinkles as follows.

When the drawing member 4 is drawn upwardly, the diaphragm 3 is deformed. Because the center hole portion of the diaphragm 3 is still joined tightly with the drawing member 4, the chamber formed by the diaphragm 3, the sucking lip 1 and skin A is expanded and a negative pressure is formed therein to suck the skin A.

When the drawing member 4 moves downwardly, the head of the drawing member 4 disconnects with the center hole portion of the diaphragm 3 and air enter the chamber, whereby the skin is released because of the vanish of the negative pressure.

Ex. 3002, 4:28–38.

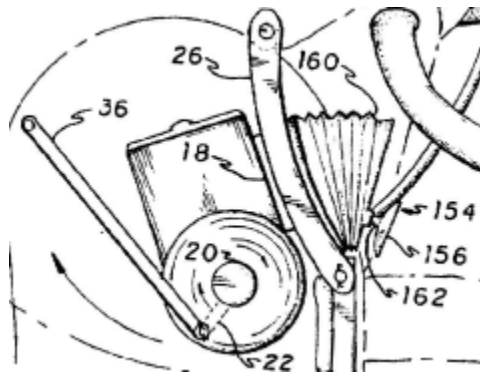
In other words, Fang appears to apply suction to the skin, but then releases the skin “because of the vanish of the negative pressure.” *Id.* at 4:38. Taylor, on the other hand, appears to apply a cyclical vacuum to the

skin via a suction cup that is sealingly connected. *See* Ex. 1004, 5:32–38. A more fulsome description of Taylor is set forth below.

Taylor (Ex. 1004)

Taylor discloses a sexual aid that includes a means for introducing a vacuum to stimulate the clitoris. Ex. 1004, code (57). In this embodiment, the device comprises a suction cup which engages the upper portion of the vulva. *Id.* at 5:28–30. The suction cup is in fluid communication with a bellows that cyclically introduces a vacuum within the suction cup. *Id.* at ll. 32–38. The cyclical vacuum stimulates the clitoris. *Id.* at ll. 40–41.

Taylor describes this embodiment as shown in an excerpt of Figure 3 depicted below more specifically as follows.



The portion of Figure 3 shown above describes a second embodiment of first stimulator 154 that introduces a vacuum to stimulate the clitoris.

Ex. 1004, 5:27–32.

The first stimulator 154 includes a suction cup member 156 that conformingly and sealingly receives the upper portion of the vulva. The suction cup member 156 of the first stimulator 154 is more specifically directed at receiving the clitoris. The suction cup member 156 is in fluid communication with a bellows 160 or squeeze ball (not shown) via flexible conduit 162. As the arm 26 oscillates relative to the housing, the arm 26 compresses and expands the bellows 160 relative to the housing 12. The arm 26 and bellows 160 cyclically introduce a vacuum in the volume

defined by the suction cup member 156 and the portion of the vulva received therein. The cyclical vacuum phenomenon stimulates the clitoris.

Ex. 1004, 5:29–41.

Application of *Becton, Dickinson* Factors (a), (b), and (d)

We conclude from a review of Fang and Taylor that they are not substantially the same art nor is Petitioner making substantially the same argument as was presented the Office during prosecution of the '061 Patent based on Fang. We find that the way in which Fang and Taylor work appear to be materially different. Fang appears to apply only suction to the skin whereas Taylor, with the sealingly connected suction cup, appears to apply a cyclical vacuum that Dr. Prisco testifies meets the claim limitations requiring generation of a pattern of negative and positive pressures, modulated with respect to a reference pressure. Ex. 1002 ¶¶ 62–64, 75. Thus Taylor appears to teach the claim element Patent Owner argued during prosecution was missing from Fang.

Also, in applying factors (b) and (d) of *Becton, Dickinson*, because of such differences noted above, we find that Taylor is not cumulative of Fang, which was considered and applied by the Office during prosecution of the '061 Patent.

4. *Conclusion*

Thus, we find that Taylor and Fang are not substantially the same art, nor were substantially the same arguments based on these references presented in the Petition and during prosecution of the '061 Patent, respectively. As discussed above, because Petitioner primarily relies on Taylor in all four grounds for teaching the modulation of positive and negative pressures with respect to a reference pressure as required by all of

the challenged claims, we also find that, overall, the same or substantially the same art was not previously presented to the Office nor were the same or substantially the same arguments previously presented to the Office.

Therefore, we do not need to reach the application of the remaining *Becton, Dickenson* factors relating to whether the Petitioner has demonstrated a material error by the Office. Thus, we decline to exercise our discretion under § 325(d) to deny institution of an *inter partes* review here.

B. Ground 1

Turning to an analysis of whether we made findings that are not appropriately supported by record evidence or whether we failed to view an issue of fact in the light most favorable to the Petitioner, we begin with a review of our decision denying institution.

In our decision on institution, we found that

Taylor only expressly teaches introduction of a cyclical vacuum using its device and does not anywhere describe its device as producing a positive pressure relative to a reference or atmospheric pressure. Petitioner relies on a single sentence in Taylor that provides that suction cup member 156 “conformingly and **sealingly** receives the upper portion of the vulva” to infer that a closed system is formed. It is only based on this alleged closed system in Taylor that Petitioner asserts that positive pressures with respect to atmospheric pressure is created.

We find that the device as described in Taylor does not support Petitioner’s conclusion that the system created by Taylor’s device becomes a closed system capable of producing positive and negative pressures relative to a reference pressure or atmospheric pressure. We agree with Patent Owner that to come to such a conclusion requires us to determine that Taylor inherently discloses such a closed system because there is no such express disclosure. The description of Taylor’s device, however, does not provide the requisite detail for us to

determine that it will necessarily produce negative and positive pressures relative to atmospheric pressure.

First, we agree with Patent Owner that Petitioner's analysis of Taylor requires that the bellows is a sealed container with only one opening to be able to create positive and negative pressures relative to atmospheric pressure as evidenced by Petitioner's reliance on the statement that the suction cup member "sealingly" receives the upper portion of the vulva. As Patent Owner points out, bellows is "an instrument or machine that by alternate expansion and contraction draws in air through a valve or orifice and expels it through a tube." Thus, a bellows is defined as providing a unidirectional medium flow versus a bidirectional flow that would be required for a bellows to produce both positive and negative pressures with respect to atmospheric pressure. Taylor's description of the use of bellows for creating only a cyclical vacuum appears to be consistent with a bellows with unidirectional flow.

Also, to achieve both negative and positive pressures with respect to the atmospheric reference pressure, Petitioner asserts that Taylor's bellows would need to begin in a state of being neither compressed nor expanded. There is nothing in Taylor, however, that describes or confirms that Taylor's bellows are neither compressed nor expanded when suction cup member 156 conformingly and sealingly receives the upper portion of the vulva.

Petitioner makes no attempt in its analysis of Taylor to address how an apparatus described as a bellows would provide bidirectional flow of air to create positive and negative pressures in suction cup member 156, or why from the teachings of Taylor, it is assumed that suction cup member 156 is first sealed against the body part when the bellows are neither compressed nor expanded. Petitioner seems to derive these assumptions as to how Taylor's apparatus works on the single sentence—"The first stimulator 154 includes a suction cup member 156 that conformingly and sealingly receives the upper portion of the vulva."—which does not provide sufficient support for Petitioner's assumptions. Therefore, we find that Taylor's disclosure does not support Petitioner's assumptions as

to how Taylor's device works to arrive at a device that anticipates the challenged claims

Dec. 21–24 (citations omitted).

Petitioner takes issue with these findings at the institution stage of the proceeding. Petitioner asserts that our Decision incorrectly added an opening or valve to Taylor's bellows 160 based on Patent Owner's proffered dictionary definition of "bellows" when such an opening or valve is not taught by Taylor. Req. Reh'g. 8. Petitioner points out that Taylor teaches that bellows 160 is interchangeable with squeeze ball 74 that has a single opening. *Id.* (citing Ex. 1004, Fig. 4, 5:33–35, 5:50–6:3). Petitioner concludes that "A POSITA would infer that a closed system is essential in *Taylor* because there is no valve or other opening disclosed in bellows 160, and because the other disclosed system for delivering pressure, the squeeze ball, has a single opening forming a closed system with bidirectional flow. Regardless, this is a material dispute of fact that Petitioner should have an opportunity to address at trial." Req. Reh'g 9 (citing Ex. 1002 ¶¶ 60–65, 75(ii), 77(ii)).

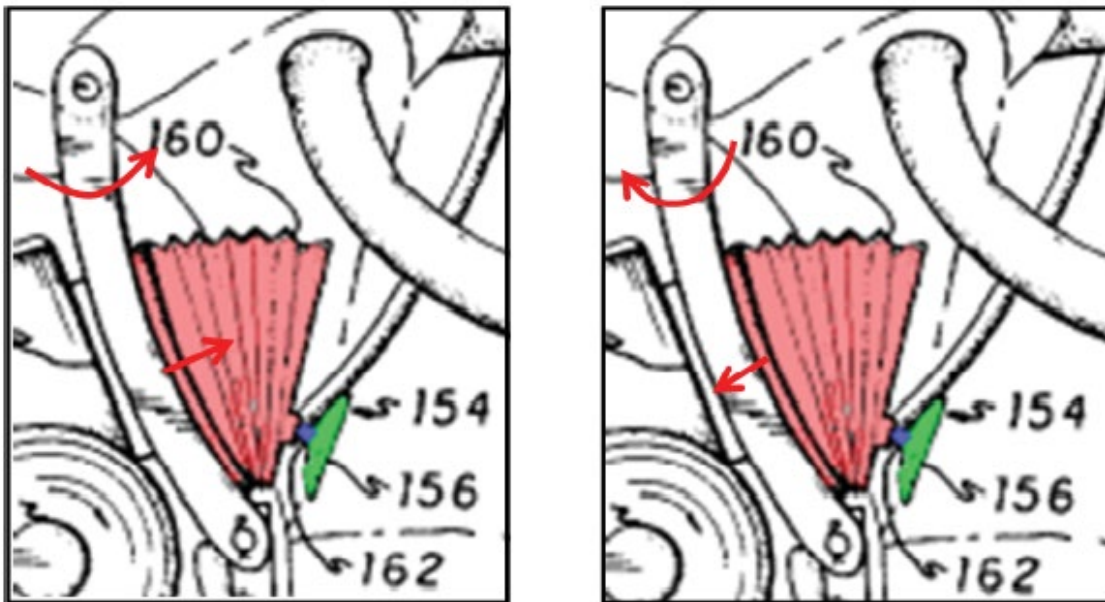
By the same token, Petitioner asserts that we also erred in finding at the institution stage that Taylor does not teach that its bellows are neither compressed nor expanded when suction cup member 156 conformingly and sealingly receives the upper portion of the vulva. *Id.* at 9–10. Petitioner states that:

Fig. 3 discloses bellows 160 in a state that is not fully expanded or compressed as it is engaged to the vulva. . . . And, as explained in the Petition, *Taylor* discloses that arm 26 'compresses and [then] expands the bellows 160' after suction cup member 156 'sealingly' engages the vulva. Thus, *Taylor* teaches expanding bellows 160 to a larger size, as well as compressing to a smaller size, after the suction cup is applied to

the vulva. . . . Thus, the Decision ignores the testimony of Dr. Prisco and, at a minimum, fails to view, in a light most favorable to the petitioner, genuine issues of material fact at the institution stage.

Req. Reh'g. 9–10.

First, in further reviewing Taylor's Figure 3 along with the description of Figure 3 and Dr. Prisco's and Dr. Jensen's testimony concerning Taylor, Petitioner's Request persuades us that a genuine question of material fact remains concerning whether Taylor is a sealed container with only one opening that is able to create positive and negative pressures. *See* Ex. 1004, 5:29–41; Ex. 1002 ¶¶ 39–64; Ex. 2001 ¶¶ 85–105. Dr. Prisco provides the following annotated Figure 3 from Taylor to explain how Taylor's device works.



Dr. Prisco states that suction cup member 156 shown in green in each of the annotated Figure 3s above conformingly and sealingly receive the upper portion of the vulva. Ex. 1002 ¶ 62. Dr. Prisco also testifies that suction cup member 156 is in fluid communication with bellows 160

colored red in the Figures above (or with a squeeze ball that is not shown) by way of flexible conduit 162 colored blue in the Figures above. *Id.*

Dr. Prisco testifies the arm next to the bellows in the Figures above oscillates to compress and expand the bellows. *Id.* Dr. Prisco describes this action and how it teaches the claim limitations relating to modulation of positive and negative pressures relative to a reference pressure more fully below.

With reference to the figures immediately above, as the arm 26 swings to the right side (see figure on the left above), the wall of the bellows 160 attached to the arm 26 also moves to the right to “compress[]” and decrease the volume of the bellows 160. Similarly, when the arm 26 swings to the left side (see figure on the right above), the wall of the bellows 160 attached to the arm 26 (See figure above) also moves to the left to “expand[]” the bellows 160 and increase its volume. (*Id.*)

Taylor’s bellows 160 is able to generate varying pressures for application to the clitoris because when suction cup member 156 sealingly receives the body part, a closed system is formed. (*See id.* at 5:29-31.) Thus, when the bellows 160 is not “compress[e]d” or “expand[ed],” the air within the bellows 160 and the suction cup member 156 is at a reference pressure, which, in this case would be the prevailing atmospheric pressure. (*See id.* at 5:35-49.) And, as a result of Boyle’s law, when the suction cup member 156 is “sealingly” engaged with the upper portion of the vulva, and “the arm 26 compresses . . . the bellows 160 relative to the housing 12,” the pressure of the air in bellows 160 increases to a value above the reference pressure. (*See id.* at 5:29-31, 35-40.) This is because, when the volume of bellows 160 is reduced with the suction cup member 156 sealingly engaged with the vulva, the air trapped in the bellows 160, flexible conduit 162, and the suction cup member 156 compresses and increases in pressure. (*See id.* at 5:35-49.) Similarly, when the suction cup member 156 is “sealingly” engaged with the upper portion of the vulva, and “the arm 26 . . . expands the bellows 160 relative to the housing 12,” the

pressure of the air in the bellows 160 decreases to a value below the reference pressure. (*See id.*) When the air in the bellows 160 is above the reference pressure, high pressure air from the bellows 160 through the flexible conduit 162 and blows against the vulva through the suction cup member 165. (*See id.*) And, when the pressure inside the bellows 160 is below the reference pressure, air flows from the suction cup member 165 into the bellows 160 and applies a suction force on the vulva. (*See id.*)

Ex. 1002 ¶¶ 63–64.

We find that Dr. Prisco’s testimony is a reasonable interpretation of how Taylor works if the bellows are bidirectional, and the bellows are expanded and contracted when the suction cup is sealingly engaged. Figure 3 of Taylor shown above appears to support Dr. Prisco’s testimony that the bellows may be expanded or contracted from the initial position shown in Figure 3 and does not appear to show any valve or second opening in the bellows to provide unidirectional flow as Dr. Jensen, Patent Owner’s declarant, asserts. Also, as Petitioner asserts, Taylor indicates that a squeeze ball may be substituted for the bellows expressly indicating a device with a bidirectional flow. Although Patent Owner raises valid arguments concerning a common definition of bellows indicating unidirectional flow and provides testimony from Dr. Jensen reasonably supporting such a position, these dueling positions create a genuine issue of material fact that we weigh in favor of Petitioner on institution. *See* 37 C.F.R. 42.108(c).

With regard to Hovland, we found that “[a]lthough Hovland discloses the use of positive or negative pressures to stimulate the clitoris, Hovland only teaches that super-atmospheric pressure is an *alternative* to, not in conjunction with, a vacuum or suction.” Dec. 27. We found that Hovland’s disclosure supported this view. *See id.* at 27–29. Petitioner asserts that we did not give “and/or” its plain meaning to include modulation between two

effects, such as application of subatmospheric and superatmospheric pressure. Req. Reh’g 14. Petitioner points us to two discussions in Hovland teaching using effects in combination. *Id.* at 14–15 (citing Ex. 1002 ¶¶ 66, 92–96; Ex. 1006, 4:37–42; 17:19–23, 14:66–16:63); *see* Pet. 13–15.

Petitioner concludes that “[w]hen ‘and/or’ is correctly afforded its plain and ordinary meaning, *Hovland*’s embodiment that is ‘configured to provide . . . vibration, precussion, subatmospheric pressure *and/or* superatmospheric pressure, *or modulation of these effects*”

teaches modulation of subatmospheric pressure, modulation of superatmospheric pressure, and modulation of both subatmospheric and superatmospheric pressures together.” Req. Reh’g 15; *see* Ex. 1002 ¶¶ 65–69. In further review of Hovland, we agree with Petitioner that at least an issue of fact remains with respect to the meaning of “and/or” in the context of Hovland.

Petitioner has persuaded us that we overlooked or misapprehended aspects of Taylor and Hovland that create at least a genuine issue of material fact that at the institution stage of the proceeding must be viewed in favor of Petitioner. When viewing these questions of fact in favor of Petitioner, we determine that Petitioner has shown a reasonable likelihood of succeeding on the merits with respect to at least claim 1. *See* Pet. 20–38 (claim 1 – anticipation by Taylor).⁸ We have also reviewed Petitioner’s contentions

⁸ Because we have decided to institute based on an anticipation ground, we need not address Patent Owner’s arguments and evidence concerning secondary indicia at this stage of the proceeding. *See* Prelim. Resp. 35–53. The question of whether the secondary consideration evidence supports a conclusion that the subject matter of the claims is not obvious, however, is fact intensive and is best decided on a full record. *Cf. Monark Knitting Mach, Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 886 (Fed. Cir. 1998)

with respect to the remaining challenged claims and challenges, and determine that the Petition provides the requisite showing, at this stage of the proceeding, that either Taylor anticipates the claims or the various combinations of Taylor, Hovland, and Zipper disclose the subject matter of these claims. *See* Pet. 39–86. Patent Owner's remaining arguments for these grounds concerning the application of impermissible hindsight and attacking the rationale to combine the various references do not persuade us otherwise on this record.

Petitioner also takes issue with our construction of the term “reference pressure,” and asserts that it is not limited to atmospheric pressure. Req. Reh’g. 4–7. Petitioner states that “[i]t is correct that when the bellows 160 is neither compressed nor expanded, the air within the bellows 160 and the suction cup 156 is at a reference pressure, which, in that particular case/state of *Taylor*, would correlate to the prevailing atmospheric pressure. Those statements and positions are not tantamount to limiting the meaning or scope of the term ‘reference pressure’ in the claims to solely the prevailing atmospheric pressure.” Req. Reh’g 5–6. Petitioner advocates that we adopt the following plain meaning of reference pressure: a “given pressure” around which higher and lower pressures are created. *Id.* at 6.

We find that at this stage of the proceeding we do not need to define the term “reference pressure” to determine whether to institute *inter partes* review. As we have found that at least a fact question exists concerning whether Taylor teaches positive and negative pressures with respect to a reference pressure, an issue of fact that we resolve in favor of Petitioner at

(determining that issues of fact concerning secondary considerations precluded grant of summary judgment).

institution, we do not need to further define “reference pressure.” We vacate the portion of our previous decision regarding claim construction of this term and look forward to the parties’ further briefing concerning this issue.

IV. CONCLUSION

We find that on rehearing, Petitioner has made a sufficient showing that the evidence and arguments presented in the Petition are sufficient to warrant institution. We, therefore, grant the Request for Rehearing and amend our decision to institute by granting the petition and instituting *inter partes* review of claims 1–3, 5, 7, 8, 11, 14, 15, 17–21, and 23–26 of the ’061 patent on all grounds asserted in the petition.

V. ORDER

In consideration of the foregoing, it is hereby:

Ordered that Petitioner’s Request for Rehearing is GRANTED;

ORDERED that pursuant to 35 U.S.C. § 314(a), an inter partes review is instituted on all challenges raised in the Petition; and

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

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