

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITO RED LIGHT, INC.,
Petitioner,

v.

JOOVV, INC.,
Patent Owner.

Case IPR2024-00621
Patent 11,253,719

PATENT OWNER'S PRELIMINARY RESPONSE

Filed on behalf of Joovv, Inc.

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EXHIBIT LIST

Exhibit No.	Description
EX2001	January 20, 2020 and April 6, 2021 Cease and Desist Letters from Joovv, Inc. to Mito Red Light, Inc.
EX2002	U.S. Patent No. 11,033,752
EX2003	U.S. Patent No. 10,478,635 (Reexamined)
EX2004	U.S. Patent No. 10,639,495 (Reexamined)
EX2005	U.S. Patent No. 10,828,505 (Reexamined)
EX2006	U.S. Patent No. 11,542,172
EX2007	Complaint for Patent Infringement, <i>Joovv, Inc. v. Mito Red Light, Inc.</i> , Case No. 23-cv-01084-MTL, Dkt. 1 (D. AZ. June 13, 2023)
EX2008	Claim Construction Order, <i>Joovv, Inc. v. Mito Red Light, Inc.</i> , Case No. 23-cv-01084, Dkt. 68 (D. AZ. April 1, 2024)
EX2009	U.S. Patent Publication No. 2011/0054573 (Mitchell)
EX2010	U.S. Patent Publication No. 2018/0008839 (Hamid)
EX2011	Scheduling Order, <i>Joovv, Inc. v. Mito Red Light, Inc.</i> , Case 2:23-cv-01084-MTL, Dkt. 34, (D. AZ. Sept. 26, 2023)
EX2012	Defendant's Initial Disclosure of Invalidity Contentions Pursuant To N.D. Ill. Patent L.R. 2.3(a)-(b), <i>Joovv, Inc. v. Mito Red Light, Inc.</i> , Case No. 23-cv-01084
EX2013	Patent Owner's Infringement Contentions with Regard to U.S. Patent No. 11,253,719
EX2014	Declaration of Dr. Jianzhong Jiao, Ph.D.
EX2015	Curriculum vitae of Dr. Jianzhong Jiao, Ph.D.
EX2016	Order Setting Date for Final Infringement Contentions, <i>Joovv, Inc. v. Mito Red Light, Inc.</i> , Case No. 23-cv-01084, Dkt. 68 (D. AZ. May 28, 2024)

Patent Owner Joovv, Inc. (“Patent Owner”) hereby submits its Preliminary Response to Mito Red Light, Inc.’s (“Petitioner”) petition for *inter partes* review of U.S. Patent No. 11,253,719 (“the ’719 Patent”).

I. INTRODUCTION

Patent Owner is a pioneer and leading seller in the field of photobiomodulation therapy systems. Patent Owner is the owner of the following U.S. Patents, among several others:

Patent No.	Filing Date	Priority Relationship to the ’719 Patent
11,033,752 (“the ’752 Patent)	October 22, 2018	Parent
10,478,635 (“the ’635 Patent)	December 20, 2018	Parent
10,639,495 (“the ’495 Patent)	September 26, 2019	Parent
10,828,505 (“the ’505 Patent)	June 7, 2017	None
D963,873 (“the ’873 Patent)	April 15, 2021	Continuation
11,524,172 (“the ’172 Patent)	February 4, 2022	Continuation

Each of the abovementioned patents focuses on Patent Owner’s red-light panels and directly related technology.

Patent Owner asserted claims of patent infringement against Petitioner in the United States District Court, District of Arizona, on June 13, 2023 (“the Arizona Litigation”). The Arizona Litigation alleges Petitioner’s infringement of the ’719 Patent, the ’752 Patent, the Reexamined ’635 Patent, the Reexamined ’495 Patent, the ’505 Patent, the ’172 Patent, and the ’873 Design Patent. Ten months after Patent Owner commenced the Arizona Litigation, Petitioner filed this Petition against just a single one of the seven (7) patents involved in that case. The Board should deny institution for several reasons.

First, Petitioner asserted all the references submitted here in the co-pending Arizona Litigation, and the trier of fact in the said litigation is thus poised to consider the validity of the ’719 Patent.² Thus, proceeding here is a poor use of the Board’s already scarce resources.

Second, Patent Owner already presented Dijkstra and Norwood—the same references relied on in the Petition—to the Patent Office during prosecution and the examiner did not err in allowing the claims over those two references because each are missing at least one limitation of the claims.

² U.S. Patent No. 6,314,699 (“Tucker”) and U.S. Patent Publication No. 2004/0127961 (“Whitehurst”), Exhibits 1015 and 1016, respectively, to the Petition, were not cited by Petitioner in the Arizona Litigation. However, other than being listed in the List of Exhibits, those references are not mentioned in the instant Petition.

Third, the remaining six of Patent Owner’s seven patents identified above, covering the same technology and the same products sold by Petitioner, are not involved in this Petition and will remain valid and asserted in the Arizona Litigation, regardless of the outcome of this proceeding. Thus, the validity or invalidity of the ’719 Patent is not dispositive of any issue, claim, defense, or damages in the Arizona Litigation.

Fourth, this *Inter Partes* Review, if instituted, is not expected to be completed until several months *after* the trial date in the Arizona Litigation. As a result, Petitioner will not benefit from the instant proceeding, even if they receive a favorable ruling.

Finally, the main reference asserted by Petitioner, Dijkstra, not only lacks key structural elements of the challenged claims—to wit: a first plurality of lights and a second plurality of lights configured to emit—it actually *teaches against* including such a structure. Petitioner has failed to meet its burden because Petitioner’s Petition and the accompanying Declaration of its expert, Dr. Bretschneider, contain no arguments as to where Dijkstra shows this element and/or how the secondary reference, Norwood, could be (or should be) combined to form this element. Indeed, the Petition merely cites to three paragraphs of Dijkstra, but the cited paragraphs do not even mention these structures. For this additional independent reason, Petitioner

has failed to meet its burden to present a *prima facie* case of unpatentability on any ground.

For any of these reasons, the Board should deny institution.

II. BACKGROUND

A. Co-Pending Litigation on the '719 Patent

On January 20, 2020, Patent Owner notified Petitioner in writing that Petitioner was infringing Patent Owner's '635 Patent, which had just issued two months prior. EX2001 at p. 1-3. On April 5, 2021, Patent Owner notified Petitioner in writing that Petitioner was also infringing Patent Owner's '495 Patent, '505 Patent, and the published application for what became the '752 Patent. *Id.* at 8-10. On June 13, 2023, Patent Owner commenced the Arizona Litigation asserting infringement of Patent Owner's '752 Patent (EX2002), Reexamined '635 Patent (EX2003), Reexamined '495 Patent (EX2004), '505 Patent (EX2005), '172 Patent (EX2006), '873 Patent, and '719 Patent (EX1001) that is the subject of this Petition. EX2007 (*Joovv, Inc. v. Mito Red Light, Inc.*, No. 2:23-cv-1084-MTL, Dkt. 1 (D. Ariz. June 13, 2023)). The Arizona Litigation is at an advanced, *post-Markman*, stage, the District Court having already issued its claim-construction ruling months ago, on April 1, 2024. EX2008.

The Arizona Court has not issued a stay of litigation and Petitioner has confirmed it will not seek a stay of those proceedings. Pet. at p. 51 (“Petitioner does not intend to seek a stay as the litigation involves 6 patents”).

B. The Invention of the ’719 Patent

Photobiomodulation therapy (or light therapy) is a therapeutic technique that uses low-level emission of selective wavelengths of light to improve health and to treat a variety of health conditions, including skin issues, such as wrinkles, scars, persistent wounds, and many other conditions. EX1001, at 1: 42-46. The ’719 Patent describes and shows a photobiomodulation therapy system that provides a highly effective way to treat many common ailments of the human body. *Id.*, Abstract. The invention provides two or more light therapy devices that are communicatively coupled together in various ways. *Id.* Each of the light devices include a housing, a communication module, and a plurality of lights arranged and configured to emit at least one of red light and near infrared light. *Id.* The ’719 Patent describes a first light therapy device 12a with a first housing 14a and a second light therapy device 12b with a second housing 14b. *Id.*, 5:12-31. The first light therapy device 12a has a “first plurality of lights” 16a and the second light therapy device 12b has a “second plurality of lights” 16b. *Id.*

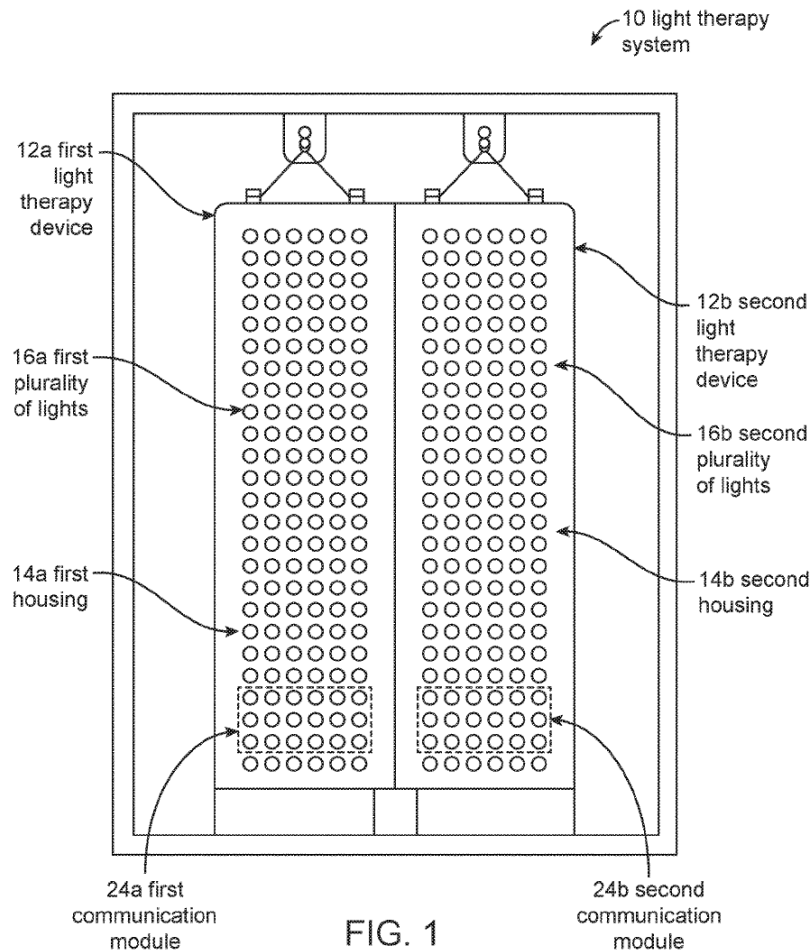


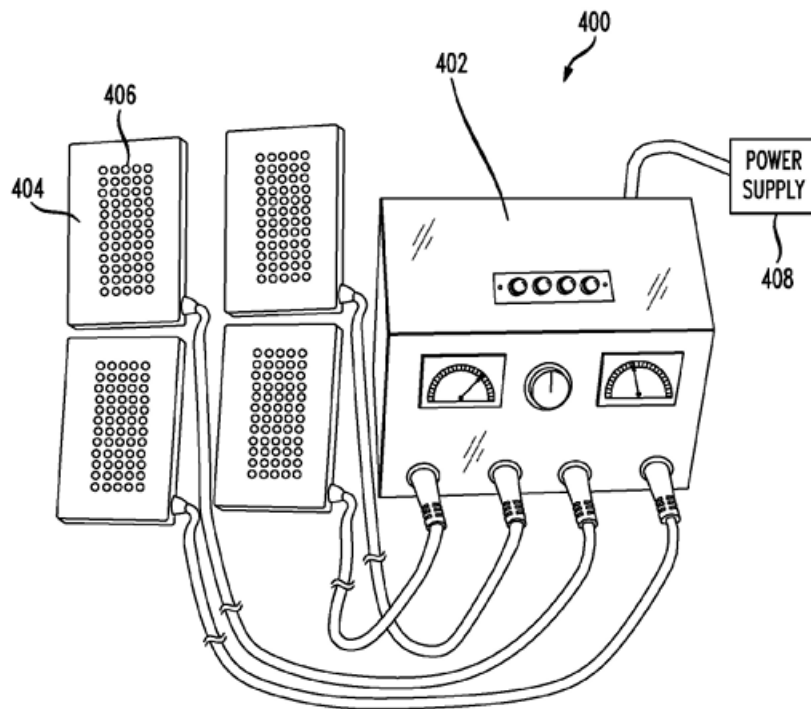
FIG. 1 illustrates each of the two “plurality of lights” as 6 columns and 25 rows of circles arranged in a rectangular grid, 16a and 16b. *See* EX1001, FIG. 1. The specification explains that the purpose of the plurality of lights is to “treat an entire body at once.” *See id.* at 5:1-3 (“Many top professionals have adopted light therapy, but oftentimes the light therapy devices and systems used are not big enough to treat an entire body at once”); *see also id.* at 6:15-18 (“a user is standing in the middle of the light therapy system 10 to treat the entire body with light therapy simultaneously”). Thus, through the use of the invention of the ’719 Patent, “the area

of treatment can be expanded to reduce the time and number of treatments to achieve the desired results.” *Id.* at 6:6-8.

Normal parlance in English refers to “a light” or “lights” as structure(s), e.g., something that is energized by flipping a switch (scenario 1) and also refers to “a light” or “light” as an electromagnetic wave, e.g., the visible energy that lights up a room (scenario 2). That said, Claim 1 recites a “plurality of lights configured to emit.” EX1001, 11:55-61. This “configured to emit” (light waves) limitation excludes scenario 2 (light waves) as the language makes clear that what is being referenced in Claim 1 of the ’719 Patent is a plurality of electrically powered structures that each cause/produce light to be emitted.

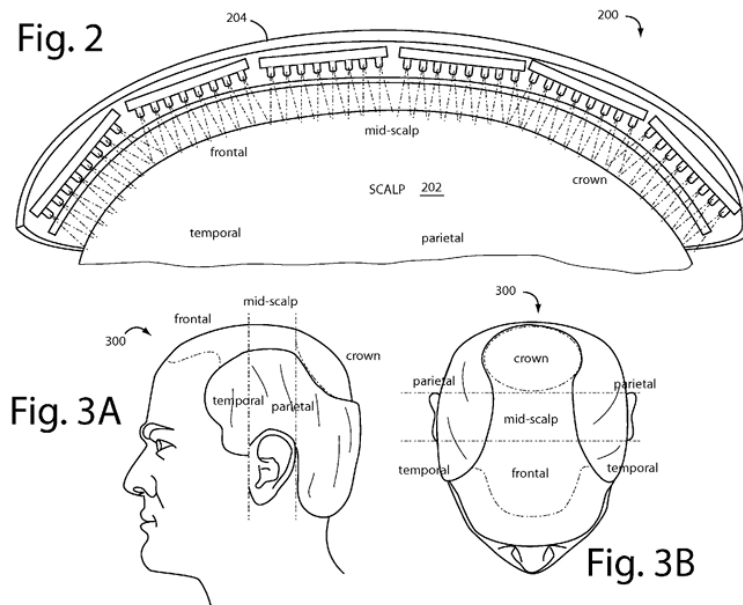
Indeed, the foregoing interpretation is consistent with the prosecution history of the ’719 Patent, where the Examiner cited two references against Claim 1 in its explanation of the claim scope. Specifically, the Examiner cited U.S. Patent Pub. No. 2011/0054573 to Mitchell (“Mitchell”) (EX2009) and U.S. Patent Pub. No. 2018/0008839 to Hamid (“Hamid”) (EX2010), asserting that each, similar to the scope of Claim 1 for this element, has a “plurality of lights configured to emit.” EX1003 at 192-95. First, the Examiner pointed to the panel of lights 404 in Mitchell’s FIG. 4 (reproduced below) as disclosing the “plurality of lights configured to emit” like that asserted in Claim 1 of the ’719 Patent. *Id.*

FIG. 4



As can be gleaned, Mitchell's panels of lights 404 (EX2009 at FIG. 4) are undeniably similar in structure to the panels of lights 16a and 16b, labeled "plurality of lights," in FIG. 1 of the '719 Patent, reproduced above. EX2014 at ¶ 36. Each is an array of individual light emitters that broadcast separate light beams into the environment. *Id.*

The Examiner then cited paragraph [0046] of Hamid, which describes its FIG. 2 (reproduced below) showing "dozens of discrete VCSEL laser devices [that] can more or less uniformly flood the entire scalp 202 with near infrared monochromatic light." EX1003 at 195; EX2010 at FIG. 2.



Like Mitchell, Hamid teaches an array of individual light emitters that simultaneously broadcast separate light beams into a user's scalp when the device is being used to treat a scalp condition. EX2010 at ¶ [0026-27] (“These laser arrays A-F 130-135 are generally about an inch or two square and arranged in tiles for 100% laser light coverage of the user's entire scalp . . . in current embodiments we've found it best to treat all areas of the scalp together at the same time and not divide treatments into zones.”). Thus, based on the specification and the Examiner's observations noted in the prosecution history of the '719 Patent, one of skill in the art, after reading said material, would understand that each one of the “plurality of lights configured to emit at least one of red light and near infrared light” consists of multiple and spatially separated lights that broadcast many (e.g., 6 x 25, or 150) separate light beams (not a single beam) onto a user's body. EX2014 at ¶ 39.

C. U.S. Patent Publication No. 2019/0030359 to Dijkstra (“Dijkstra”)

Like the invention of the ’719 Patent, Dijkstra is also “a light therapy device for providing therapeutic treatment to a user's body.” EX1004, Abstract. Specifically, Dijkstra discloses one or more small devices that project various types of light onto a treatment area of a subject. *Id.* The device has optical sensors that allow it to follow the subject and continuously target the treatment area with the light treatment, even as the subject moves. *Id.* (“the device is having a rotatable assembly that automatically follows the movement of the desired area of the body needs to be treated.”).

Importantly, however, Dijkstra differs from the invention claimed in the ’719 Patent in *at least* one very important aspect: Dijkstra’s light beam emission is very purposely and specifically a single steerable light—not a plurality of lights. EX2014 at ¶ 45. This fact is explained extensively in the specification and shown in all of Dijkstra’s figures. Unlike the invention of the ’719 Patent, which is designed to broadcast extensive and non-aimed light on the entire body of a subject at the same time, Dijkstra’s devices are designed to be extremely precise and able to target only small areas on the body, e.g., “into the nasal cavity,” at any given time. EX1004 at ¶ [0036]. Dijkstra’s devices are precise enough to, “with the help of a motor[,] keep[] the light projection intact on the treatment portion of the user body regardless of the movement of the user body or the treatment portion,” to “keep the projected light

away from the user’s eyes,” and, when two devices are operating, each one “prevents an overlap of the light.” EX1004 at ¶ [0017], [0064], [0067]. Dijkstra instructs that “the light therapy device adjusts focus of the light projection in case the light rays scattering out of the treatment portion (towards sensitive areas e.g. eyes) and making user uncomfortable.” *Id.* at ¶ [0108]. This precision is shown, for example, in Dijkstra’s FIG. 4a (reproduced below), where a specific area—and only that area—on a user’s forehead, is being treated.

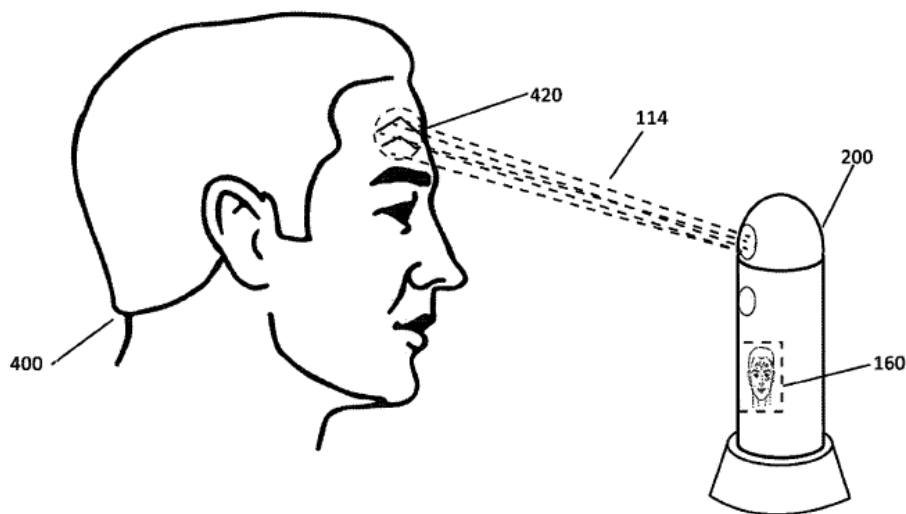


FIG. 4A

In one instance, Dijkstra’s specification uses the word “array” in connection with lights. However, read in its proper context and not in isolation, Dijkstra is referring to multiple devices with a single aim of a single light beam from each device, as shown in its FIG. 9. EX2014 at ¶ 46. Conversely, Dijkstra does not disclose an array of light beams being emitted from a single device. *Id.* Dijkstra is,

instead, very clearly designed to rotate and steer its single output of light. Indeed, if Dijkstra were to rotate while broadcasting an array of light beams from a single device, it would be difficult or perhaps impossible to “keep the projected light away from the user’s eyes” and also keep “the light rays scattering out of the treatment portion,” as is required by Dijkstra. *Id.*

Moreover, in section VI(A)(i), *infra*, Patent Owner cites clear support within Dijkstra that proves (1) Dijkstra does not show “a first housing with a first plurality of lights configured to emit”; and (2) Dijkstra specifically teaches away from such an arrangement. Petitioner’s entire argument that Dijkstra shows a “plurality of lights” is a blind citation to three paragraphs in Dijkstra, without explanation or argument, and a citation to a single paragraph of their expert’s report, again, without explanation or argument.

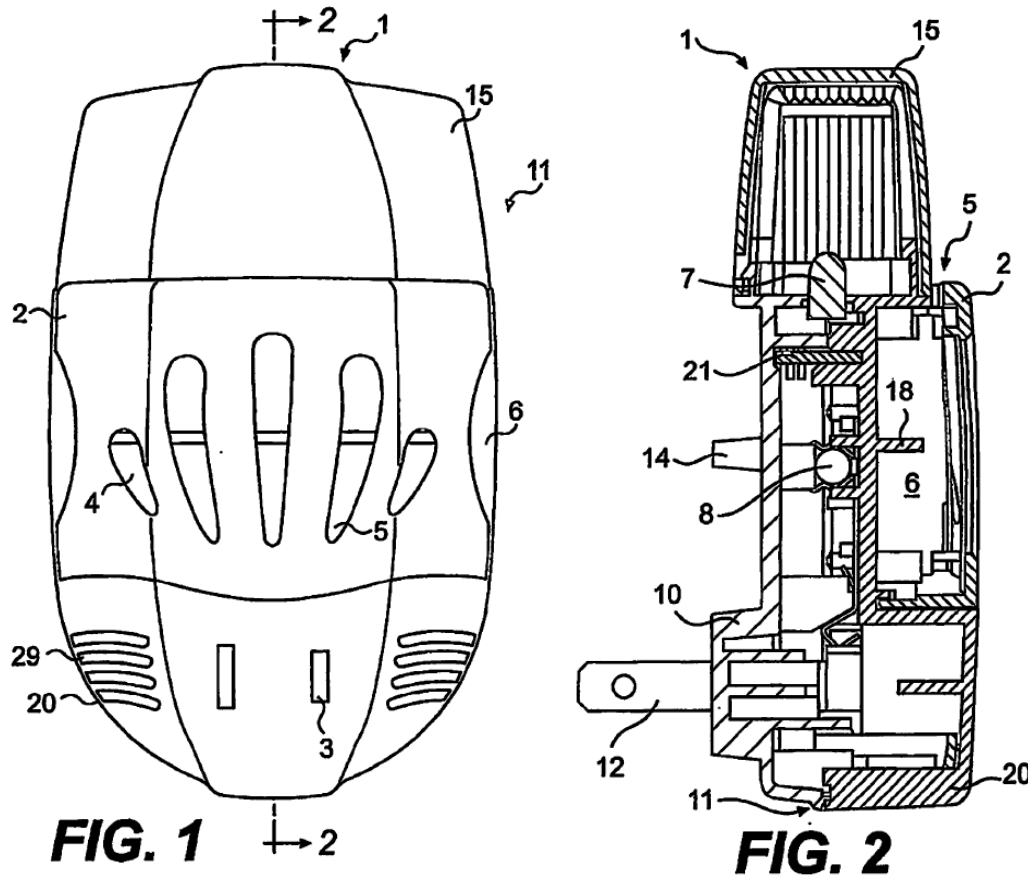
In section VI(A)(ii), *infra*, Patent Owner will address Petitioner’s citations and show why they are woefully insufficient to meet Petitioner’s burden to show unpatentability.

D. U.S. Patent Publication No. 2006/0237439 to Norwood (“Norwood”)

Norwood discloses a fragrance “plug-in diffuser having one or more LEDs used as nightlights and/or ornamental displays.” EX. 1005 at ¶ [0001]. The structure consists of a housing 11, a compartment or slot 6 for receiving an active material, a heating element 8, and a lighting element 7. *Id.* at ¶ [0050]. A set of “diffusion outlets

5 . . . provide for a chimney effect so that air movement occurs across the front of an active material cartridge contained in a compartment or slot 6 formed in the housing

11. *Id.* at ¶ [0059]. Figures 1 and 2 of Norwood are reproduced below.



“The lighting element 7 . . . may be a single LED or a plurality of LEDs, such as one or more LED arrays. If multiple LEDs are used, they may be arranged in, for example, a line, a circle, a square, a flower shape, a rainbow shape, or any other desired shape or arrangement [and can be] LEDs of the same or different colors depending on the particular aesthetic design of the diffuser.” *Id.* at ¶ [0053].

III. CLAIM CONSTRUCTION IS NOT NECESSARY TO DENY INSTITUTION HERE

Petitioner posits that the claim terms of the '719 Patent should be given their plain meaning. Pet. at 4. Patent Owner does not disagree. The parties previously agreed to the definition of certain terms in the Arizona Litigation and others were defined by the Court. EX2008. Patent Owner believes that none of those terms will be the focus of this proceeding and, as such, the Board need not go beyond, or even address, the District Court's constructions to deny institution and find that Petitioner has not met its burden to show a reasonable likelihood of prevailing. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) ("The Board is required to construe 'only those 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)). Patent Owner reserves the right to assert additional claim construction positions should the Board institute IPR.

IV. LEVEL OF ORDINARY SKILL

Petitioner suggests that a person of ordinary skill in the art ("POSITA") is an individual with a bachelor's degree in an engineering field (*e.g.*, mechanical, chemical, electrical, or materials science) and at least two years of design experience with LED panel lighting or display products. Pet. at p. 5. Patent Owner and its expert agree. EX2014 at ¶¶ 40-42.

V. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION DUE TO THE ADVANCED STAGE OF THE DISTRICT COURT PROCEEDINGS AND PATENT OWNER'S PRIOR SUBMISSION OF THE SAME REFERENCES TO THE PATENT OFFICE

As a threshold matter, the Board should exercise its discretion to deny institution of *inter partes* review under 35 U.S.C. § 314(a) because the parallel Arizona Litigation against Petitioner is at an advanced stage. The Arizona Litigation involves the same patent and asserted references and the trial is anticipated to conclude in the summer of 2025. If trial were ordered on this Petition, the statutory deadline for a Final Written Decision would likely be September 28, 2025, meaning that decision would be expected nearly two months *after* the jury trial concluded in the Arizona Litigation. Thus, any ruling here cannot be used in the Arizona Litigation, and conducting a validity trial here, after conclusion of the Arizona Litigation addressing the questions of patent validity, is an inefficient use of resources and does not support institution under *Fintiv*.

The Board may additionally decline institution under 35 U.S.C. § 325(d) because every ground of this challenge relies on the same Dijkstra and Norwood references Petitioner submitted during prosecution. Petitioner improperly presents the same references, which are missing key limitations, with no explanation of any alleged prior examiner error. There is no basis to consider them again here.

A. The Board Should Deny Institution Under Section 314(a) Because All of the *Fintiv* Factors Support Denial

The Board identified a non-exhaustive list of six factors in *Fintiv* that guide its decision in exercising discretion to deny institution in view of parallel litigation. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495, at *2 (P.T.A.B. Mar. 20, 2020) (precedential). As explained below, due to the advanced stage of the parallel Arizona Litigation asserting the same alleged prior art proffered in the Petition, all of the *Fintiv* factors support denying institution in this instance. Simply put, institution of IPR would be an inefficient use of already scarce Board resources, and would only result in a duplicative additional proceeding. The Board is well within its discretion to deny institution.

1. Factor 1: Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.

In Factor 1, the Board examines whether the district court action is stayed, or whether a stay may be granted. *Fintiv*, 2020 WL 2126495, at *3. This factor is easily analyzed. The Arizona Litigation has not been stayed, and Petitioner affirmed in the Petition that “Petitioner does not intend to seek a stay as the [Arizona] litigation involves 6 patents.” Pet. at p. 51.

Accordingly, if PTAB trial is instituted, “inefficiency and duplication of efforts” will result. *Fintiv*, 2020 WL 2126495, at *3. As explained for Factor 4, the Arizona Litigation covers the same challenged claims and alleged prior art at issue

in this Petition – *see infra* § IV(A)(4) – which would, unavoidably, result in the same validity issues being decided repeatedly should IPR be instituted here. This factor thus weighs decidedly *against* institution.

2. Factor 2: The proximity of the court’s trial date to the Board’s projected statutory deadline for a Final Written Decision.

For Factor 2, “[i]f the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under NHK.” *Fintiv*, 2020 WL 2126495, at *4. A trial date has not yet been set in the Arizona Litigation. However, the deadline for filing dispositive motions is May 1, 2025, and the Parties are required to notify the District Court that they are ready for the Final Pretrial Conference by May 8, 2025. EX2011 at 6. Trial will be set shortly after that date. The Scheduling Order warns the parties that “The Deadlines are Real.” *Id.* at 10. Thus, there is no reason to predict a trial date later than the summer of 2025 in the Arizona Litigation. Indeed, the Board “generally take[s] courts’ trial schedules at face value absent some strong evidence to the contrary.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2486683, at *5 (P.T.A.B. May 13, 2020). The Board considers the trial date in parallel litigation in evaluating this *Fintiv* factor 2. *See, e.g., Fitbit, Inc. v. Philips North Am. LLC*, IPR2020- 00828, 2020 WL 6470312, at *4-5 (P.T.A.B. Nov. 3, 2020) (trial date in a

parallel Garmin case before final written decision deadline was “relevant” and “weighs in favor of invoking our discretion to deny institution” of Fitbit’s petition).

Against the foregoing procedural backdrop of the Arizona Litigation, if trial were ordered on the instant Petition, the statutory deadline for a Final Written Decision would be approximately September 28, 2025, i.e., nearly two months after the trial concludes in the Arizona Litigation. This timing is similar to that in the Board’s *NHK* decision, where the district court trial was scheduled to begin several months before the Board would have concluded the IPR. *NHK Spring Co. v. Intriplex Techs., Inc.*, IPR2018-00752, 2018 WL 4373643, at *7 (P.T.A.B. Sept. 12, 2018) (precedential). The earlier Arizona trial date thus strongly favors discretionary denial under Factor 2. *See Fintiv*, 2020 WL 2126495, at *4.

3. Factor 3: Investment in the parallel proceeding by the court and the parties.

Factor 3 evaluates “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision” and whether “the district court has issued substantive orders.” *Fintiv*, 2020 WL 2126495, at *4. The more substantive work that has been performed in the district court litigation, the more likely the Board should exercise its discretion to deny review. Here, for the reasons that follow, such discretion should be exercised.

Due to Petitioner’s delay, Patent Owner has undertaken a substantial investment of resources in the Arizona Litigation. The parties have already served infringement contentions, non-infringement contentions, invalidity contentions, discovery responses, completed the claim construction process, and Respondent has spent several days inside Petitioner’s facility manually inspecting the accused infringing devices. See EX2011 at 1-3; EX2012; EX2013; Ex 1014. Moreover, the parties are required to serve their “final” infringement contentions, non-infringement contentions, and invalidity contentions in approximately one month, on August 2, 2024. *See* EX2016.

The district court has also invested substantial resources in the Arizona Litigation and has even already conducted a *Markman* hearing and issued its claim-construction order on April 1, 2024. EX2008. “[D]istrict court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Fintiv*, 2020 WL 2126495, at *4.

As explained above in section V(A)(2), the Board Decision here would likely be *after* the trial in the Arizona Litigation. Accordingly, conducting a separate trial before the Board several months *after* the enormous expenditures of time and resources for a district court trial is hardly the “efficient alternative to district court litigation” envisioned by the AIA. *Gen. Plastic Indus. Co. v. Canon Kabushiki*

Kaisha, IPR2016-01357, 2017 WL 3917706, at *7 (P.T.A.B. Sept. 6, 2017). This factor thus heavily favors denying institution.

4. Factor 4: Overlap between issues raised in the petition and in the parallel proceeding.

Factor 4 evaluates the overlap between the Petition and the parallel district court action. When “the Board [is] presented with substantially identical prior art arguments that were at issue in the district court... concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong.” *Fintiv*, 2020 WL 2126495, at *5. That is exactly the case here. In the Arizona Litigation, Patent Owner asserted its ’752 Patent (EX2002), Reexamined ’635 Patent (EX2003), Reexamined ’495 Patent (EX2004), ’505 Patent (EX2005), ’172 Patent (EX2006), ’873 Patent, and the ’719 Patent (EX1001) that is the subject of this Petition. All of these patents pertain to the exact same technology, “photobiomodulation therapy and systems,” which is the title of the ’719 Patent, ’752 Patent, ’635 Patent, ’495 Patent, and ’172 Patent. Unsurprisingly, Petitioner has argued in the Arizona Litigation that the claims are invalid based on the same Dijkstra and Norwood references presented in the Petition here. EX2012, citing Dijkstra 79 times and Norwood 50 times.

In other words, the Petition almost entirely overlaps with the claims asserted in the Arizona Litigation and asserts the same references to argue invalidity. The substantial overlap in the invalidity challenges, therefore, strongly supports denying

institution. *Fintiv*, 2020 WL 2126495, at *5 (“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.”).

5. Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party.

Petitioner Mito Red Light is the defendant in the parallel Arizona Litigation. This factor also weighs in favor of denying institution here.

6. Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits.

Under this factor, the Board considers other pertinent circumstances, including the merits of the Petition. *Fintiv*, 2020 WL 2126495, at *6. “[I]f the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Id.*

Here, the merits of Petitioner’s challenge are, at best, shaky and unsupported. The Petition principally relies on references recycled from the file history, the principal one of which is missing key aspects of the claims. As explained below, the main reference, Dijkstra, not only lacks a light source having a “plurality of lights,” but, worse, it actually teaches away from such a light source, which is required by all of the claims of the ’719 Patent. In addition, the Petition also fails to identify where in Dijkstra the “plurality of lights” is even alleged to be found. And, make no mistake, Norwood does not and cannot make up for the intentional deficiencies in

Dijkstra. Further, the Petition cites an exhibit list containing three additional references – Tucker, Whitehurst, and Mitchell – but the Petition does not mention these references at all.

In addition, Patent Owner has asserted six other patents in the Arizona Litigation that cover the same or highly-related technology. This proceeding will thus have questionable (and, at best, marginal) positive impact to Petitioner, should the Board rule in its favor.

Because Petitioner’s challenge lacks merit, this factor also heavily favors discretionary denial. *Fitbit*, 2020 WL 6470312, at *9 (“[T]he merits of the proceeding weigh in favor of denying institution ...”).

7. None Of The *Fintiv* Factors Support Institution

“[I]n evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, 2020 WL 2126495, at *3. None of the *Fintiv* factors support instituting review. Considered holistically, therefore, *Fintiv* supports the Board exercising its discretion to deny review under Section 314(a) here, thereby conserving the Board’s and parties’ resources and preventing multiple proceedings evaluating the same invalidity challenges that are set to be decided at the district court level well before the Board could conclude this IPR.

B. The Board Should Deny Institution Under Section 325(d) Because Petitioner Presented the Same References Used in Both Grounds During Prosecution

The Board should further decline institution under 35 U.S.C. § 325(d) because both Grounds rely on two references that Petitioner previously presented during the original prosecution of the '719 Patent: Dijkstra and Norwood.

Section 325(d) provides that the Director may elect not to institute a proceeding if “the same or substantially the same prior art or arguments previously were presented to the Office.” The Board applies a two-part framework: “(1) whether the same or substantially the same art previously was presented to the Office”; and, if so, (2) “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, 2020 WL 740292, at *3 (P.T.A.B. Feb. 13, 2020) (precedential).

“Previously presented art includes...art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Id.* at *3; *see also Biocon Pharma Ltd. v. Novartis Pharms. Corp.*, IPR2020-01263, 2021 WL 608300, at *3-4 (P.T.A.B. Feb. 16, 2021) (denying institution based on art previously presented in an IDS).

1. Dijkstra and Norwood Were Previously Presented to the Patent Office

Patent Owner submitted the Dijkstra and Norwood references Petitioner relies on for Grounds 1 & 2 via an IDS during the original prosecution. *See* EX1003 at 84-86 (showing “7932482 [to] Norwood” and “20190030359 [to] Dijkstra” were considered). The Examiner, Tammie K. Marlen, signed the IDS, indicating she considered both references. *Id.* Indeed, both references are listed on the face of the ’719 Patent under “References Cited.” EX1001 at 2-3 (listing “7,932,482 [to] Norwood” and “2019/0030359 [to] Dijkstra”). Simply put, Dijkstra and Norwood were considered by the examiner during the original prosecution. *See, e.g., Biocon*, 2021 WL 608300, at *4 (exercising discretion to deny institution: “the Examiner considered [the reference] because it is listed on the IDS and the Examiner signed the IDS”).

Because the same references were previously presented to the Patent Office, the first part of the *Advanced Bionics* framework is satisfied. *See, e.g., Advanced Bionics*, 2020 WL 740292, at *8 (P.T.A.B. Feb. 13, 2020); *Biocon*, 2021 WL 608300, at *4 n.4.

2. Petitioner Has Not and Cannot Establish the Patent Office Materially Erred in Allowing the Claims Because Dijkstra and Norwood Lack Key Limitations

Petitioner has not met its burden to show the Patent Office erred in allowing the claims. For the second part of the framework, Petitioner must “demonstrate[] that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, 2020 WL 740292, at *3.

Petitioner knows it relied on references recycled from the original ’719 prosecution, but pointedly omitted this fact when it referenced only the ’635, ’495, and ’172 patents. Pet. at 3 (“In particular, the *Dijkstra* and *Norwood* references, raised in Grounds 1 and 2, were applied in the *ex parte* reexaminations of the ’635 and ’495 patents and during the original prosecution of the ’172 patent.”).

By refusing to even acknowledge the presence of these two references in the IDS signed by the Examiner, Petitioner conspicuously sidesteps having to explain to this Board how the Patent Office supposedly erred in allowing the claims over the *Dijkstra* and *Norwood* references. Indeed, Petitioner cannot establish error because, among other deficiencies, *Dijkstra* lacks and teaches away from using a light source with a “plurality of lights,” as required by all claims. *See infra* § VI(A), (B).

Petitioner is similarly left unable to establish error via the *Norwood* reference. *Norwood* is a fragrance diffuser (i.e., non-analogous art), and, although *Norwood* does disclose multiple lights in its plug-in diffusers, a “plurality of lights” would

destroy the functionality of Dijkstra. Aware of this fact, Petitioner was unable to provide in the Petition a single statement as to why the lone medical treatment light of Dijkstra should be replaced with multiple low-quality ambient lights of Norwood. The Examiner did not err in any way, and certainly did not materially err, in allowing the claims over Dijkstra and Norwood.

If the first part of the *Advanced Bionics* “framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute inter partes review.” 2020 WL 740292, at *3. The Board should do exactly that here. Petitioner provides no evidence, or even argument, warranting reconsideration of Dijkstra or Norwood. *See* Pet. at 9-12. In other words, because the Patent Office considered the identical references during prosecution, and because Petitioner entirely fails to demonstrate any material error warranting reconsideration, the Board should exercise its discretion to deny institution under Section 325(d).

**VI. PETITIONER FAILS TO MEET ITS BURDEN ON ALL GROUNDS
BECAUSE THE ALLEGED PRIOR ART FAILS TO TEACH OR
SUGGEST THE LIMITATIONS OF ALL CHALLENGED CLAIMS**

Even if considered on the merits, the Board should also not institute trial because Petitioner fails to show a reasonable likelihood of prevailing. Indeed, the Petition fails to address all aspects of the claims. For purposes of this preliminary response, Patent Owner addresses only one of these claim limitations — “plurality

of lights configured to emit.” The first Ground relies solely on Dijkstra for the limitation a first and second “plurality of lights configured to emit.” The second Ground leans on Norwood, but for the lead/follow claim limitations, not the “plurality of lights” limitation. As described more thoroughly below, although Norwood discloses multiple lights in its plug-in diffusers, a “plurality of lights” would destroy the functionality of Dijkstra and require a substantial engineering change to its structure; likewise, Petitioner does not make a single statement as to why the single medical treatment light of Dijkstra should be duplicated or replaced with the low-quality ambient lights of Norwood.

A. The Petition Fails to Show a Likelihood of Prevailing on the Dijkstra Ground

All of the challenged claims require a first and a second “plurality of lights configured to emit” “for providing a light therapy treatment.” EX1001 at 11:52-63. Ground 1 of the Petition relies exclusively on Dijkstra to teach this limitation. But Dijkstra’s device does not use and cannot use a “plurality of lights configured to emit.” In addition, Petitioner has failed to make a prima facie case showing that Dijkstra discloses such a feature.

i. Dijkstra Does Not Teach, Show or Suggest a Housing with a Plurality of Lights Configured to Emit

As an initial matter, Petitioner conflates what the word “light” refers to in Dijkstra’s Detailed Description. As explained in the report of Patent Owner’s Expert,

Dr. Jiao, a POSITA, understands that the word “light” is commonly used to describe two types of objects. EX 2014 at ¶¶ 34, 48. Type 1 is a natural agent (electromagnetic radiation) that stimulates sight and makes things visible, e.g., visible light or emitted light. *Id.* Type 2 is a hardware device that emits light, e.g., a headlight or a flashlight. Dijkstra has used light in the specification for both objects and it is important to distinguish between the two during this analysis. *Id.*

Dijkstra’s detailed description starts at paragraph [0059] and refers to FIGs. 1 & 2, which show the relevant components of its light therapy device 200. Dijkstra explains that each device 200 has a first housing 210 rotatably mounted on a second housing 220. EX1004 at ¶ [0059].

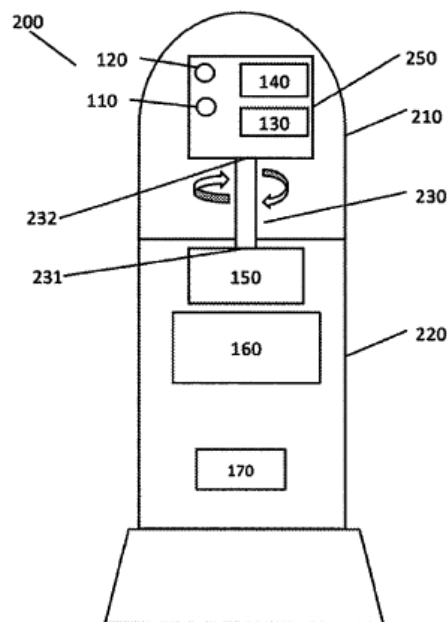


FIG. 2

The rotatable head 250 includes a **single** light projection unit 110 and a camera unit 120, which are both controlled by a controlling unit 130. *Id.* The single light projection unit 110 is comprised of a light head 111, a light direction controller 112, and a light source 113. *Id.* at ¶ [0061]. **Dijkstra only describes and shows each device as having a single light projection unit 110, i.e., a single light emitter.**

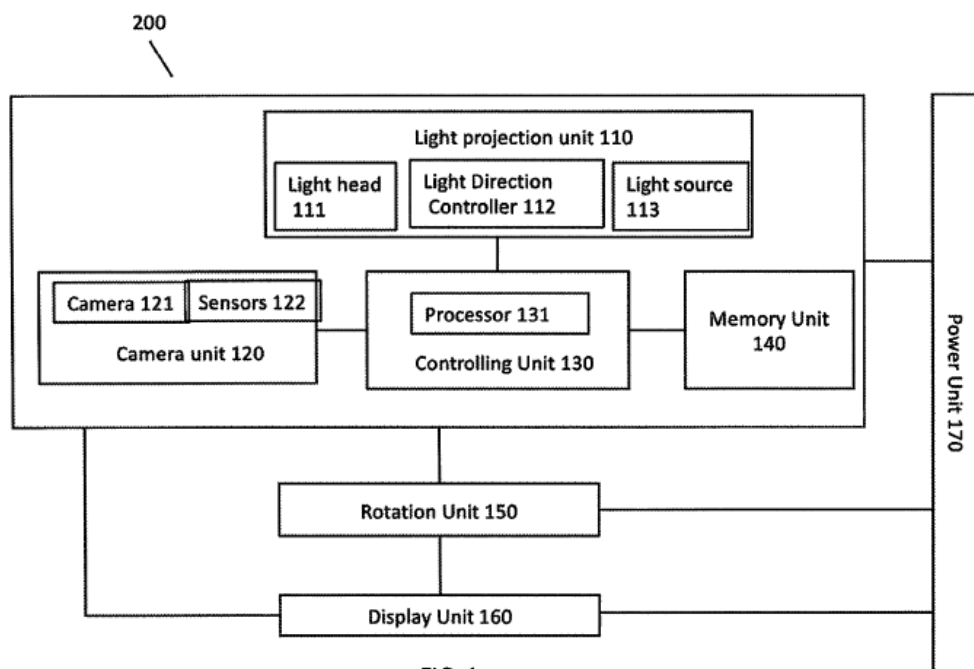


FIG. 1

Paragraph [0061] of Dijkstra explains that “the light source 113 projects **a** light [singular] on the light direction controller 112 which is able to control and divert **the light** [singular] as per the controlling unit 130 input.” *Id.* (emphasis added). The specification goes on to explain that “the light direction controller 112 uses saccade mirror, direction tuning film, laser sintering, or mirror type

galvanometer, etc. techniques for controlling a direction of **a light** [in the singular] **emitted** from the light source 113.” *Id.* (emphasis added).

Paragraph [0061] consistently refers to “**a light**” **in the singular** being emitted and explains why there is and can only be a single light emitted from the device — i.e., because it is very specifically aimed at the treatment site (a portion of a user’s body) by the light direction controller 112. In paragraph [0063], Dijkstra describes that “**the** light source 113 may be **a** LED light, infrared light, **a** UV light, **a** laser light, photo reactive chemical producing light, phosphorus or any other suitable light source.” EX 1004 at ¶ [0063]. (Emphasis added). In all examples of the light source, a singular light (a light beam) is emitted from the direction controller 112 within the light project unit 110.

Dijkstra describes the importance of the single light beam precision control. Paragraph [0064] provides significant details on how Dijkstra tracks the treatment site of the user. It explains that “[t]he light direction controller 112 follows a treatment portion of a user body to an extent by changing a direction of the light projection . . . once the treatment portion starts moving . . . keeps the light projection [i.e., emission] intact on the treatment portion of the user body regardless of the movement of the user body or the treatment portion.” EX1004 at ¶ [0064].

The precision required by and provided by Dijkstra to track the subject and move the single light output/emission is further clarified in paragraph [0067], where

Dijkstra states “[t]he light projection unit 110 project[s] a light . . . the light head 111 keeps the projected light away from the user’s eyes, as the . . . light projection could be hazardous to the human eyes.” *Id.* at ¶ [0067] (emphasis added). Further precision is described in paragraph [0108], where Dijkstra instructs that “the light therapy device adjusts focus of the [singular] light projection in case the light rays scattering out of the treatment portion (towards sensitive areas e.g. eyes) and making user uncomfortable.” *Id.* at ¶ [0108] (emphasis added). Intense precision is taught throughout the specification. *See e.g., id.* at ¶ [0136] (“The devices emit infrared light...into the nasal cavity”); [0037] (“applied to the genitalia area of male/female humans and animals to treat erectile dysfunction”); ¶ [0110] (“light to treat a port-wine stain . . . a capillary malformation in the skin”); FIG. 3 (“projecting a light on ... one external body condition”); ¶ [0016] (“light projection unit to project a light on the external body condition”); ¶ [0024] (“focus of a light on the ... portion of the user body”); ¶ [0061] (“controlling a direction of a light emitted from the light source 113”). Put simply, Dijkstra consistently refers to what is emitted from the device as “a light,” in the singular, and there is simply no way Dijkstra could provide the required “focus” and light direction it describes as being necessary if it emitted a plurality of lights, as Petitioner loosely suggests, albeit without any explanation, in the Petition. EX2014 at ¶ 53.

Dijkstra provides ample additional support for its light direction precision requirement and abilities. For example, paragraph [0087] of Dijkstra teaches:

the mirror galvanometer (not shown) acts as the light direction controller 112. A light from the light source 113 is made to fall on at least one mirror of the galvanometer and the controlling unit provides input to the galvanometer, based on the controlling unit 130 input the coil of the galvanometer rotates and projects the light [in the singular] in the desired direction through the light head 111 . . . The light [in the singular] from the light source is made to fall on the mirror. The reflected light will fall on a light head attached to the mirror galvanometer. When the coil deflects the mirror deflects with it. The light [in the singular] which is deflected also moves on a treatment portion of the user body.

(Emphasis added). Paragraph [0089] teaches:

The light therapy device 200 does not select the area near the user's eyes for the treatment as it can be hazardous to the eyes, the light therapy device 200 uses low wavelength light projection for treating the area near the user's eye. Further, the controlling unit 130 does not allow the light [in the singular] projection [i.e., emission] to go beyond the treatment portion or a predefined distance.

(Emphasis added). Paragraphs [0087] & [0089] again refer to what is projected/emitted as “a light” or “the light,” in the singular, and they explain the precise control of that single beam of light, which is required to protect the safety of the user, and which is made possible by the control unit 130.

Moreover, the fact that Dijkstra’s devices only emit a single light beam is further made clear in a number of other portions of Dijkstra. For example:

1. Paragraph [0077]: “the controlling unit 130 allows the light projection unit 110 to project a light [in the singular] on the at least one external

body condition and/or the at least one internal body condition according to the treatment profile.” (Emphasis added).

2. Paragraph [0078]: “the controlling unit 130 allows **the** light projection unit 110 to project **a light [in the singular]** on the at least one external body condition and/or the at least one internal body condition based on the treatment profile at step 380.” (Emphasis added).
3. Paragraph [0079]: “projecting **a light [in the singular]** 114 on the treatment portion 420.” (Emphasis added).
4. Paragraph [0080]: “the user 400 manually selects the treatment portion 420 via the display unit 160 and projects **a light [in the singular]** 114 on the treatment portion 420.” (Emphasis added).

Consistent with all of the foregoing examples, the figures of Dijkstra also only shows Dijkstra’s devices to have a single light emission, via a single projection unit 110. EX2014 at ¶ 56. Specifically, FIG. 2 (reproduced above on page 32) shows the light projection unit 110 as consisting of a single opening, not a plurality of openings. *Id.* Similarly, FIG. 4A (reproduced below) shows a single light beam being projected onto a small section of a subject’s forehead. *Id.*

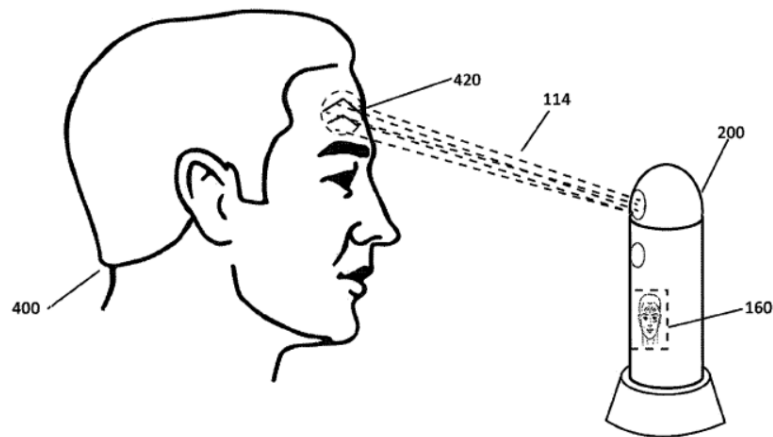


FIG. 4A

Additionally, FIG. 7 (reproduced below) shows a single light beam being projected onto various sections of the subject, using the light direction controller 112 within the light projection unit 110. *Id.* at ¶ 57.

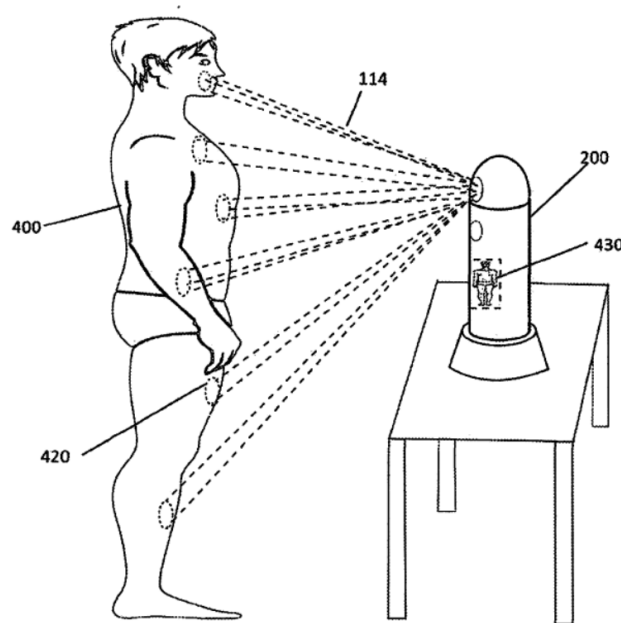


FIG. 7

It is clear to a POSITA that the dashed lines in FIG. 7 illustrate one singular light beam varying its projecting location or position on the subject, one at a time

based on the control needs and it does not mean to project multiple beams from one device simultaneously. EX2014 at ¶ 58. Similarly, FIG. 8 (reproduced below) shows two devices being used on a subject simultaneously. The small circles on the subject's body are potential treatment areas, each targeted one at a time and coming from a single projecting beam emitted from the single light projection unit 110. *Id.* Dijkstra's devices are not able to treat more than one location on a user's body at a time, due to the single focused light beam being emitted. EX1004, ¶ [0064] ("The light direction controller 112 follows a treatment portion of a user body to an extent by changing a direction of the light projection"); ¶ [0098] ("each light therapy device is projecting light towards a separate treatment portion on the user body").

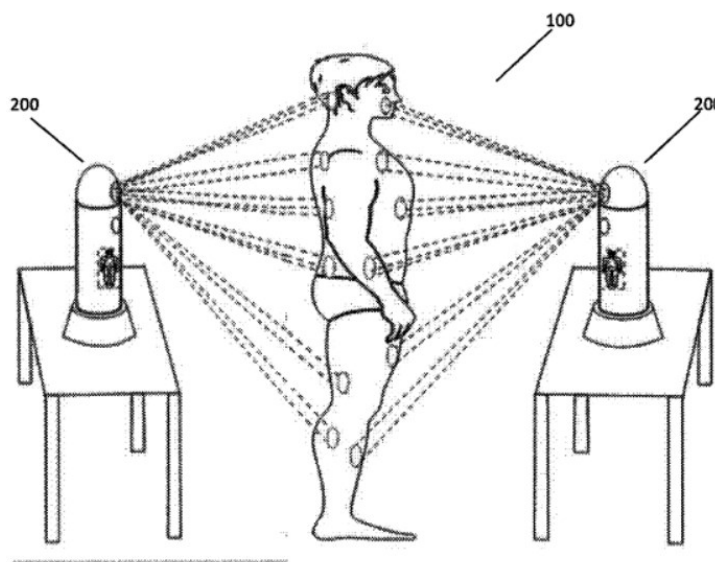
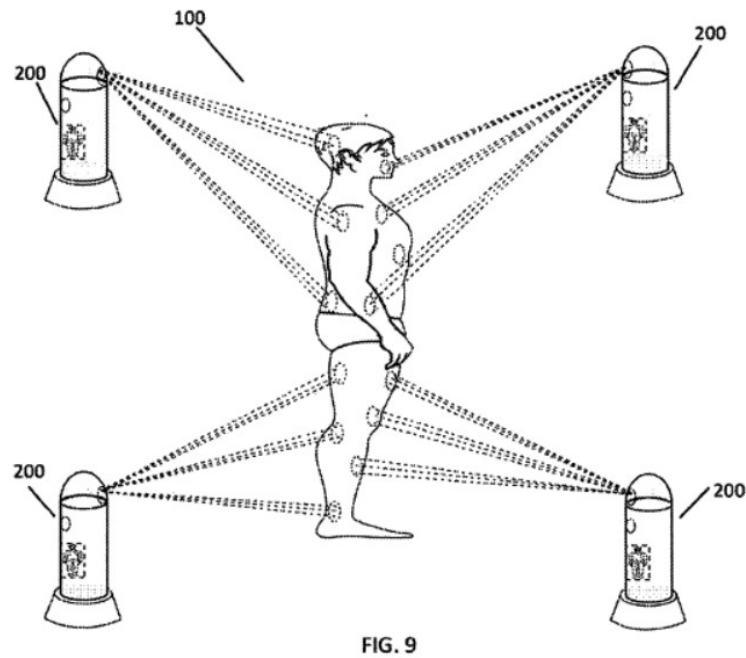


FIG. 8

Finally, FIG. 9 (reproduced below) shows four devices being used to treat a subject. The figure also shows the singular light emitted from each device is only treating a

very specific area of the subject's skin, and each device does not project multiple beams simultaneously. EX2014 at ¶ 59.



If there were any doubt as to the precision required by Dijkstra, its text makes clear that “the two or more light therapy devices automatically allocate their separate treatment portions so that they do not overlap each other's treatment portion while the light [in the singular] is being projected on the allocated treatment portion by the two or more light therapy devices.” EX1004 at ¶ [0098]; EX2014 at ¶ 60. If Dijkstra broadcast using a plurality of lights, it would be exceedingly difficult, if not impossible, to prevent the light from “overlapping” other treatment areas. EX2014 at ¶ 60.

Based on the foregoing, it is clear that Dijkstra stands in stark contrast to the invention of the '719 Patent that, unlike Dijkstra, uses large panels of lights and discloses “a user is standing in the middle of the light therapy system 10 to treat the entire body with light therapy simultaneously.” EX1001 at 6:15-18; EX2014 at ¶ 61. Conversely, Dijkstra is flush with disclosures explaining the precision provided by its devices, the reason that precision is required, and, when describing light emitted from each device, always refers to it in the singular. In fact, the word “lights” (plural) does not appear a single time in Dijkstra, while it appears 263 times in the specification and claims of the '719 Patent. Bottom line, Dijkstra does not teach, show or suggest a housing with a plurality of lights configured to emit, and this Petition should therefore be denied. EX2014 at ¶ 62.

ii. Petitioner’s Argument that Dijkstra Discloses a First Housing and a First Plurality of Lights Configured to Emit Also Fails.

Petitioner further alleges in the Petition that “Dijkstra shows . . . a first housing (210) and a first plurality of lights arranged and configured to emit red light or near-infrared light.” Pet. at p. 9. The Petition, however, fails to provide a specific identification of what structure in Dijkstra is supposed to be the “plurality of lights configured to emit.” Petitioner simply cites three paragraphs in Dijkstra ([0019], [0129], and [0133]) and to one paragraph (144) in the report of its expert, Dr. Bretschneider, but does so *without explanation or argument of any kind*. *Id.* at 10.

For example, the paragraph Petitioner cites to in Dr. Bretschneider's report does not point to or explain which structures in Dijkstra supposedly show "a first housing (210) and a first plurality of lights configured to emit." EX1002, ¶144. Rather, paragraph 144 of Dr. Bretschneider's report simply cites to other sections of the report. Specifically, in paragraph 144, Dr. Bretschneider says "*See infra* ¶¶80-131." A search for the word "plural" in Dr. Bretschneider's report reveals that the first paragraph he mentions "plural" in connection with Dijkstra is paragraph 89, wherein his report says "a first plurality of lights (array per [0034])." EX1002, ¶ 89.

Notably, however, the paragraph of Dijkstra Dr. Bretschneider is referring to, [0034], in its entirety, reads "[0034] According to yet another aspect of the present disclosure, the light therapy device uses infrared light which tends to be used to treat wrinkles and other problems caused by poor skin support, such as translucent skin or coarse skin." Remarkably, there is not one mention of the word "array" or "plurality" in paragraph [0034] of Dijkstra. Yet, paragraph 89 of Dr. Bretschneider's report does not provide any further support for his conclusion and, in fact, does not even attempt to identify where in Dijkstra "a second plurality of lights configured to emit" can arguably be found. Instead, paragraph 108 of Dr. Bretschneider's report appears to be a copy of paragraph 89, again only citing to paragraph [0034] of Dijkstra. EX1002, ¶ 108. There is no other citation to Dijkstra within his report for "a plurality of lights configured to emit."

Having found no support whatsoever in Dr. Bretschneider’s report, Patent Owner is only left to return to the three paragraphs cited in the Petition; however, such return results in the same fatal end for Petitioner. For instance, paragraph [0019] of Dijkstra refers to “**the** light projection unit...and **a** light source” in the singular, which does not support Petitioner’s position. Likewise, paragraph [0129] of Dijkstra is quickly dispatched because it says absolutely nothing about the number of lights in the Dijkstra device. And, finally, paragraph [0133] states that “LED treatments **s** [plural] work by using an **array** of bright light-emitting diodes that send low-level light energy into the deeper layers of the skin.” (Emphasis added). This final citation, on first blush, appears to have a potential to contradict Patent Owner’s argument that Dijkstra does not disclose a housing with a “plurality” of lights; but, read closer, it is unambiguously clear that the sentence is referring to “treatments,” not an actual physical structure, and “treatments” is written in the plural form. EX2014 at ¶ 65. This makes sense, as Dijkstra describes “a user **using** a **plurality** of light therapy **devices** according to an exemplary embodiment” as shown in FIG. 9. EX1004 at ¶ [0047] (emphasis added); *see also* ¶ [0098] (“light therapy devices 200); EX2014 at ¶ 65. The parties are seemingly in agreement on this fact, as Petitioner included FIG. 9 in this section of the Petition. *See* Pet. at 10 and Petitioner’s inclusion of FIG. 9.

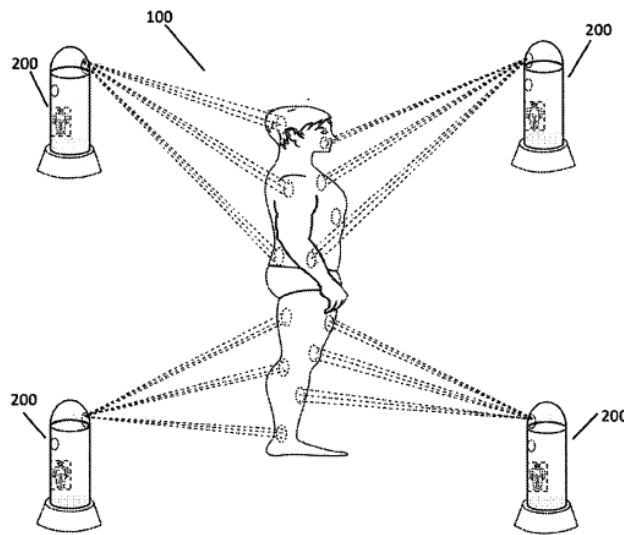


FIG. 9

With reference to FIG. 9 (reproduced above), Dijkstra teaches “wherein a user is using a **plurality** of light therapy **devices** 200 for full body treatment at a time. In this, the user is surrounded by the **plurality** of light therapy **devices** and each light therapy device is projecting light towards a separate treatment portion on the user body.” *Id.* at ¶ [0098]. Naturally, a plurality of devices, each with one LED, would, together, comprise a plurality of LEDs. EX2014 at ¶ 66. Dijkstra continues “[f]urther, the two or more light therapy devices automatically allocate their separate treatment portions so that they do not overlap each other's treatment portion while the light is being projected on the allocated treatment portion by the two or more light therapy devices.” *Id.* at ¶ [0017]. If each therapy device 200 was broadcasting an “array” of light beams, it would be exceedingly difficult, if not impossible, to prevent the beams from overlapping on a human or animal subject. EX2014 at ¶ 66.

Thus, Dijkstra’s paragraph [0133], which describes “treatments,” does not disclose “a first housing and a first plurality of lights configured to emit,” as recited in independent claim 1 of the ’719 Patent. *Id.*

Accordingly, Petitioner has not only failed to discuss where and how Dijkstra discloses a “plurality of lights configured to emit,” but worse, Petitioner has not mentioned it at all. Such omission is critical, as, in “an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (emphasis added); *see also In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016) (“In an inter partes review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316 (e), and that burden never shifts to the patentee.”) (quoting *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015)). Petitioner has simply failed to meet its burden to present a prima facie case of unpatentability on this ground.

As an aside in the interest of thoroughness and completeness, and although it was not raised by Petitioner, Patent Owner briefly addresses Dijkstra’s paragraph [0051]. This paragraph is a template statement indicating the use of terms in the patent stated in the singular can be interpreted as plural. EX1004 at ¶ [0051]. This paragraph is not specific to the actual invention in Dijkstra and does not adequately

enable a Dijkstra device that could have two light sources. EX2014 at ¶ 68. As stated above, Dijkstra’s specification only and purposely discloses a single embodiment – a device that emits a single light beam for the purposes of light beam control in direction, location, etc. Nowhere in Dijkstra’s specification is there any disclosure of a direction controller 112 that can divert the single light beam from the light source 113 into multiple directions to form plural light beams or for a single device to have two light sources 113 and two light projection units 110. Such configuration simply does not exist, would defeat the claimed goals of Dijkstra, and certainly is not enabled by a single catch-all template paragraph. *Application of Armbruster*, 512 F.2d 676, 677 (C.C.P.A. 1975) (“a specification which ‘describes’ does not necessarily also ‘enable’ one skilled in the art to make or use the claimed invention”). Dijkstra’s disclosure is fundamentally and essentially different from the ’719 Patent claims of “plurality of lights configured to emit”, in which the extended and non-aimed lights are projected to “full body” (EX1001, FIG. 3).

Finally, Patent Owner recognizes that a single letter in paragraph [0019] of Dijkstra is the only letter/word in Dijkstra’s entire specification that could, potentially, be interpreted in a way that contravenes Patent Owner’s position that Dijkstra only shows a single light source. Specifically, paragraph [0019] states “the light projection unit includes a light direction controller, a light head and a light source, wherein the light source is a laser light, LEDs, photoreactive chemical

producing light, phosphorus or any other suitable light source generating the light ranging from 100-1600 nm wavelength.”

Although this argument has not been made by Petitioner or its expert, a POSITA would have understood that the “s” after LED could not reasonably be interpreted as indicating multiple LEDs are present in Dijkstra’s light source. EX2014 at ¶ 69. Such a conclusion would be improper and inaccurate as it would be entirely at odds with every other aspect of Dijkstra. As explained above, every portion of Dijkstra actually discussing Dijkstra’s light source very clearly refers to it as a singular light.

As just one example, paragraph [0063] contains virtually identical language to that of paragraph [0019], but refers to “LED” in the singular. EX1004 at ¶ [0063] (“the light source 113 may be **a LED** light, infrared light, a UV light, a laser light, photo reactive chemical producing light, phosphorus or any other suitable light source generating the light in a range of 100-1600 nm wavelength for treating a person.”) (emphasis added). The same is true with paragraph [0103], which reads “the light source 113 projecting the light on the light direction controller 112 is selected from a group of LED light, a laser light, an Infrared light, UV Light, an electromagnetic light or any other suitable light.”

Patent Owner has provided herein many other citations to Dijkstra referring to the light source as a single lamp and the figures show the same. It simply does not

make sense that Dijkstra would consistently refer to “a LED” and “a light” throughout the specification, e.g., paragraphs [0028], [0033], [0063], [0133], and Claim 14, and describe and enable precise light beam control, and then suddenly include multiple LEDs as an option, particularly, without any discussion thereof. Such is not the actual enabling disclosure of Dijkstra.

This leaves only two possibilities. First, the “s” may simply be a typographical error, or, second, Dijkstra is referring to the fact that one of several different “LEDs” needs to be selected in order to produce the desired wavelength within the specified wavelength range (100-1600 nm) mentioned in that same sentence. EX2014 at ¶ 69. This second explanation makes sense, as Dijkstra does discuss the fact that diodes only produce light in certain ranges. Dijkstra at ¶ [005] (“light spectrums emitted by LEDs (blue or red) are known to be therapeutic for skin treatment against maladies”) (emphasis added).

It is difficult to know which is the correct interpretation, but, either way, Petitioner has not only not discussed this portion of Dijkstra, but, more telling, Petitioner has not mentioned it at all. Once again, “[i]n an inter partes review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316 (e), and that burden never shifts to the patentee.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d at 1375. Petitioner has

failed to meet its burden to present a prima facie case of unpatentability on this ground.

B. The Petition Fails to Show a Likelihood of Prevailing on the Dijkstra + Norwood Ground

Considering Dijkstra with Norwood does not change the above result. Norwood teaches wall plug-in scented diffusers that include decorative low-power LEDs (less than 0.1 watts) that serve the sole purpose of providing a nightlight and/or ornamental displays. Specifically, with regard to its purpose, Norwood teaches “the LED lighting element 7 of our invention provides sufficient light, i.e., is of a sufficient luminous intensity, to satisfactorily perform as a nightlight.” EX1005 at ¶ [0053]. Norwood further teaches that its nightlight is of unusually low power. *Id.* at ¶ [0056] (“the LED lighting element 7 of our invention uses substantially less power than conventional nightlight devices . . . only a small fraction (less than 0.1 watt) is used to power the LED lighting element 7.”). Norwood further teaches that if multiple LEDs are used, it is only for aesthetic purposes. EX1005 at ¶ [0053] (“If multiple LEDs are used, they may be arranged in, for example, a line, a circle, a square, a flower shape, a rainbow shape, or any other desired shape or arrangement [and can be] LEDs of the same or different colors depending on the particular aesthetic design of the diffuser”).

Norwood is entirely non-analogous art to the devices of Dijkstra that provide therapeutic skin treatment via a specialized high-power intense singular light source. EX2014 at ¶ 74. Petitioner yet somehow claims Norwood is analogous, suggesting that Norwood “addressed the ‘problem is that conventional diffusers typically do not have suitable controllability for varying the emission of light and/or fragrance.’” Pet. at p. 36. While controllability may be one aspect of the claimed photobiomodulation therapy systems and methods of the ’719 Patent, it is entirely unrelated to the type of light source being used. EX2014 at ¶ 74.

More importantly, the ’719 Patent teaches the plurality of lights arranged and configured to emit lights that are projecting onto full body of a user who’s taking the light therapy. *Id.* at ¶ 75. In particular, one of ordinary skill in the art of photobiomodulation therapy systems and methods for medical treatment would find two aspects of non-analogous art disclosed by Norwood. *Id.*

The first aspect is Norwood’s LED light emission level. Norwood discloses a purely aesthetic ornamental display device with a very low light emission level using low-power (less than 0.1 watts) LEDs. EX1005 at ¶ [0056] (“only a small fraction (less than 0.1 watt) is used to power the LED lighting element 7”). The LED light emission then is diffused with diffusers to be shaped in an esthetic fashion such as flowers and rainbows to serve the function solely as a nightlight and/or ornamental display. *Id.* at ¶ [0053].

In contrast, Dijkstra requires a “high-powered” light source. EX1004 at ¶ [0107] (“the device provides intense pulsed light IPL) treatment. In this, a high-powered, computer-controlled, visible, broad-spectrum pulse of light, generally in the visible spectral range of 400 to 1200 nm and a frequency range of 1 to 1,000,000 (Hz) with or without variable hertz is delivered.”). *See also*, EX1004 [0019 and 0063, 0067] (wavelengths 100-1600 nm); [0037] (800-1072 nm) [0127] (1600 nm); [0129] (632-904 nm); and [0130] (1072 nm). A POSITA would have understood that low emission level ornamental display device is a contradiction to the function and purpose of high emission level lighting therapeutic device, which light emission level must be established for various skin treatment purposes. EX2014 at ¶¶ 78-80. If one assumes that the power level used in the Norwood’s device might be increased to that required by Dijkstra, it will lead to damage of Norwood’s device. *Id.*

The second consideration is the light projection in Norwood, which is for an aesthetic, ornamental purpose and is in stark contrast to Dijkstra, which teaches light projection onto a specifically aimed at area or portion of user’s body. EX2014 at ¶¶ 76-80. Norwood’s disclosure shall not and cannot define where the emitted lights are to be projected, because there is no reason or intention to control the light projecting direction, beam spread, or light intensity level as disclosed in Dijkstra. *Id.* Norwood and Dijkstra teach non-analogous or contradictory light projections. *Id.*

A POSITA would have understood that there would not be any motivation to combine Dijkstra with Norwood. *Id.* at ¶ 78. Regardless of the light color or controllability disclosed by each, the light emission level and light projection in Norwood and Dijkstra have the opposite purposes. *Id.* Thus, the combination of Dijkstra and Norwood does not and cannot render claim 1 of the '719 Patent obvious.

Petitioner has failed to provide argument for motivation to combine Dijkstra and the Norwood nightlight, or Dijkstra and POSITA's knowledge to form the invention claimed in Claims 2, 3, 9, 10, 11, 16, 17, and 19 of the '719 Patent, in particular, "a plurality of lights configured to emit." The fundamental differences in light emission level and light projection between the light therapy device described by Dijkstra and the aesthetic ornamental device described by Norwood are widely contradictory, and the two devices are non-analogous art. EX2014 at ¶ 80. The combination would be strongly against POSITA's common sense, technical knowledge, and objective view. *Id.* As such, the combination of Dijkstra and Norwood or Dijkstra and POSITA knowledge does not and cannot render the '719 Patent's Claims 2, 3, 9, 10, 11, 16, 17, and 19 obvious. *Id.* at ¶ 81.

VI. CONCLUSION

Based on the foregoing, Patent Owner respectfully requests that the Board deny institution.

Mito Red Light, Inc. v. Joovv, Inc.
Patent No. 11,253,719—IPR2024-00621

CONCEPT LAW GROUP, P.A.

Dated: June 28, 2024

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that pursuant to 37 C.F.R. § 42.24(d), a true copy of the foregoing PATENT OWNER’S PRELIMINARY RESPONSE contains 10,131 words and therefore complies with the type-volume limitations of 37 C.F.R. § 42.24.

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing PATENT OWNER’S PRELIMINARY RESPONSE AND EXHIBITS is being served electronically on June 28, 2024 to the following lead counsel for Petitioner to the following email addresses:

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