

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

|                           |   |                                    |
|---------------------------|---|------------------------------------|
| VIVEVE, INC.,             | § |                                    |
|                           | § |                                    |
| <i>Plaintiff,</i>         | § | CIVIL ACTION NO. 2:16-CV-01189-JRG |
|                           | § |                                    |
| v.                        | § |                                    |
|                           | § |                                    |
| THERMIGEN LLC,            | § |                                    |
| THERMIAESTHETICS LLC, RED | § |                                    |
| ALINSOD, MD,              | § |                                    |
|                           | § |                                    |
| <i>Defendants.</i>        | § |                                    |

**ORDER**

Before the Court is Defendants’ Motion for Partial Summary Judgment (Dkt. No. 88) that claims 1, 2, 5–8, 17–33, 35–38, and 40–41 of U.S. Patent No. 8,961,511 (“the ’511 Patent” or “the patent-in-suit”) are invalid pursuant to 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,463,331 (“the ’331 Patent” or “the Edwards Patent”). On May 22, 2018, the Court held an initial Pre-trial Conference at which the parties presented oral argument on said Motion. (Dkt. No. 88.) After considering the briefing, the argument of the parties, and the supplements filed by both Plaintiff and Defendants (Dkt. Nos. 119-1 and 126-1), the Court finds that Defendants’ Motion should be **DENIED** for the reasons set forth herein.

**I. BACKGROUND**

On October 21, 2016, Plaintiff Viveve, Inc. (“Plaintiff” or “Viveve”) filed its original complaint for infringement of its U.S. Patent No. 8,961,511 (the “’511 patent”) against Defendants. (See Dkt. No. 1.) The ’511 patent is titled “Vaginal Remodeling Device and Methods,” and claims a method for remodeling female genital tissue by applying heat to certain target tissue. (*Id.* at 4.)

On May 22, 2018, the Court held an initial Pre-trial Conference in which the Court heard argument on the remaining pending motions, including the instant Motion wherein the Defendants argue that the '331 Patent<sup>1</sup> discloses, expressly or inherently, all of the limitations of Claims 1, 2, 5-8, 17-33, 35-38, and 40-41 of the '511 Patent and, thus, a partial summary judgment of invalidity as to these claims is warranted. (See Dkt. No. 88.)

## **II. APPLICABLE LAW**

Summary judgment should be granted “if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). Any evidence must be viewed in the light most favorable to the nonmovant. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986) (citing *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 158–59 (1970)). Summary judgment is proper when there is no genuine issue of material fact. *Celotex v. Catrett*, 477 U.S. 317, 322 (1986). “By its very terms, this standard provides that the mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact.” *Anderson*, 477 U.S. at 247–48. The substantive law identifies the material facts, and disputes over facts that are irrelevant or unnecessary will not defeat a motion for summary judgment. *Id.* at 248. A dispute about a material fact is “genuine” when the evidence is “such that a reasonable jury could return a verdict for the nonmoving party.” *Id.*

The moving party must identify the basis for granting summary judgment and identify the evidence demonstrating the absence of a genuine issue of material fact. *Celotex*, 477 U.S. at 323. If the moving party does not have the ultimate burden of persuasion at trial, the party “must either produce evidence negating an essential element of the nonmoving party’s claim or defense or show

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<sup>1</sup> According to the Defendants, the '331 Patent was not considered by the USPTO or cited during prosecution of the application that resulted in the '511 Patent. (Dkt. No. 88 at 8.)

that the nonmoving party does not have enough evidence of an essential element to carry its ultimate burden of persuasion at trial.” *Nissan Fire & Marine Ins. Co., Ltd. v. Fritz Cos., Inc.*, 210 F.3d 1099, 1102 (9th Cir. 2000).

### **III. DISCUSSION**

Defendants move for summary judgment that claims 1, 2, 5-8, 17-33, 35-38, and 40-41 of the ’511 Patent are invalid as anticipated by the ’331 Patent.<sup>2</sup> (Dkt. No. 88.) “‘Anticipation’ in patent terms means that the claimed invention is not new; that is, the invention as claimed was already known.” *Ericsson Inc. v. Intellectual Ventures I LLC*, No. 2016-1671, slip op. at 2 (Fed. Cir. May 29, 2018). “To anticipate a claim, a single prior art reference must expressly or inherently disclose each claim limitation.” *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008). A claim limitation is inherently disclosed if it is “necessarily present . . . in the single anticipating reference.” *Schering Corp. v. Geneva Pharms.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003). “If [a] claimed invention was ‘described in a printed publication’ either before the date of invention, 35 U.S.C. § 102(a), or more than one year before the U.S. Patent application was filed, 35 U.S.C. § 102(b), then that prior art anticipates the patent.” *See Metaswitch Networks Ltd. v. Genband US LLC*, No. 2:14-cv-744-JRG, 2016 WL 943601, at \*1 (E.D. Tex. Mar. 17, 2016).

#### **A. Independent Claim 1:**

According to Defendants, “the Edwards ’331 Patent discloses, expressly or inherently, each and every limitation of [C]laim 1 under U.S.C. § 102(b).” (*See id.* at 9–13.) Claim 1 of the ’511 Patent recites:

1. A method for remodeling a therapeutic zone within a target tissue, the target tissue comprising tissue underlying an epithelium of female genital tissue

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<sup>2</sup> The Defendants submit that the ’331 Patent issued on October 8, 2002, which is more than one year prior to the February 7, 2006 priority date of the ’511 Patent and, therefore, is prior art. (Dkt. No. 88 at 8.) Viveve does not dispute this.

comprising at least one of vulva, introitus and vagina tissue, the method comprising:

heating the target tissue, and

remodeling the therapeutic zone of target tissue, wherein the heating includes heating a portion of the vagina extending from the introitus inwardly to a location from 1 cm to 3.5 cm in from the introitus.

In response, Viveve submits that the '331 Patent fails to anticipate the “heating the target tissue” limitation of the claim. (Dkt. No. 95 at 7.) Viveve, relying on the expert report of Dr. Bass<sup>3</sup> and other evidence, including deposition testimony, first argues that the '331 Patent only discloses ablative treatments, which destroy or remove the tissue and thus, does not meet the Court’s construction of “heating the target tissue.” (*Id.* at 11; Dkt. No. 95-4 at 5–6.) Second, “Defendants rely on inherency—without supporting evidence—to allege the '331 patent ‘heat[s] tissue underlying the epithelium,’ and that the temperature of tissue underlying the epithelium is higher than the epithelium.” (Dkt. No. 95 at 11, 13–14) “At a minimum, the inherency of these points raise genuine issues of material fact such that summary judgment is not appropriate.” (*Id.* at 11.)

Viveve next argues that, again relying on the expert report of Dr. Bass, the '331 Patent also does not disclose “heating a portion of the vagina extending from the introitus inwardly to a location from 1 cm to 3.5 cm in from the introitus.” (Dkt. No. 95 at 14–16.) According to Viveve, the Defendants made an inherency argument that the '331 Patent’s delivery of energy to the anterior and posterior regions of the vagina wall “*necessarily includes* heating a location in the lower half of the vaginal wall from 1 cm to 3.5 cm in from the introitus.” (*Id.* at 15.) Defendants, however, offer no evidence to support this argument (*Id.*)

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<sup>3</sup> In their Reply (Dkt. No. 98), Defendants argue that Dr. Bass’s opinion in support of Viveve’s Opposition are not reliable “since it ignores the critical teachings of Edwards and thus presents no genuine dispute of fact.” (*Id.* at 4.) In its Sur-Reply (Dkt. No. 103), Viveve argues in response that, tellingly, Defendants did not challenge any of Dr. Bass’s opinions on these *Daubert* grounds and that Dr. Bass simply disagrees with “their understanding of those teachings and their conclusion.” (*Id.* at 7.) The Court finds that, for purposes of this Motion, the Court should not discount his opinion. Had the Court struck such opinions of Dr. Bass per a prior and properly presented *Daubert* motion, the Court would view this differently. However, such is not the case.

The Court finds summary judgment to be inappropriate as to Claim 1. “As a general rule, summary judgment is inappropriate where an expert’s testimony supports the non-moving party’s case.” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 683 (Fed. Cir. 2015) (quoting *Provenz v. Miller*, 102 F.3d 1478, 1490 (9th Cir.1996)). Here, Viveve’s arguments, supported by evidence and expert testimony, create material fact questions as to whether the ’331 Patent discloses every limitation of Claim 1 of the ’511 Patent. Accordingly, Defendants’ Motion is **DENIED** as to Claim 1.

**B. Independent Claim 35:**

Defendants submit that the ’331 Patent discloses expressly or inherently each and every limitation of Claim 35 and anticipates Claim 35 under 35 U.S.C. § 102(b). (See Dkt. No. 88 at 13.) Claim 35 recites:

35. A method for remodeling a therapeutic zone within a target tissue, the target tissue comprising tissue underlying an epithelium of female genital tissue comprising at least one of vulva, introitus and vagina tissue, the method comprising:  
heating the target tissue, and  
remodeling the therapeutic zone of target tissue, wherein the heating includes heating a portion of the vagina circumferentially around its wall from 1 o’clock to 11 o’clock, wherein the aspect closest to the urethra is at 12 o’clock.

In response, Viveve asserts that, as Dr. Bass explains, the plain meaning of claim 35 requires treating a 300 degree arc in a wall of the vagina, not merely discrete portions within that arc. (Dkt. No. 95 at 17.) “At best the ’331 Patent discloses treating 11 o’clock and 1 o’clock and/or 5 o’clock to 7 o’clock,” which, according to Viveve, is not what Claim 35 requires. (*Id.*) Thus, the Court should deny summary judgment as to Claim 35.

Again, the Court finds that summary judgment is inappropriate in this case. As with Claim 1, Viveve’s arguments, supported by evidence and expert testimony, create genuine issues of

material fact that defeat Defendants' motion as to Claim 35. Accordingly, Defendants' Motion is **DENIED** as to Claim 35.

### **C. Dependent Claims:**

Claims 2, 5-8, and 17-33 depend from Claim 1, and Claims 36-38, 40-41 depend from Claim 35. Defendants submit that "[n]one of these claims add any limitation of patentable weight that would preserve their validity." In response, Viveve asserts that, because these claims depend on Claims 1 and 35, they are not anticipated by the '331 Patent. The Court agrees with Viveve that because summary judgment is inappropriate as to the independent claims, summary judgment is likewise inappropriate as to those claims which depend from the independent claims, for at least the same reasons as discussed above. *See Lambda Optical Sols. LLC v. Alcatel-Lucent USA, Inc.*, CV 10-487-RGA-CJB, 2017 WL 4002148, at \*13 (D. Del. Mar. 31, 2017) ("Because the Court has found that summary judgment cannot be granted in Alcatel's favor with respect to independent claims 1 and 25, there is no need to address Alcatel's other anticipation-related arguments regarding the dependent claims, which depend from claim 1."); *see also Medtronic Vascular Inc. v. Abbott Cardiovascular Sys., Inc.*, 614 F. Supp. 2d 1006, 1017 (N.D. Cal. 2009) ("[S]ince the dependent claims of the '255 patent—claims 13, and 15–16—all depend upon independent claim 11, there is a dispute of material fact as to these claims, as well.")

### **IV. CONCLUSION**

Accordingly, the Court hereby **DENIES** Defendants' Motion for Partial Summary Judgment. (Dkt. No. 88.)

**So ORDERED and SIGNED this 29th day of May, 2018.**

  
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RODNEY GILSTRAP  
UNITED STATES DISTRICT JUDGE