

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THERABODY, INC.

Petitioner,

v.

HYPERICE IP SUBCO, LLC,

Patent Owner.

Case No. PGR2024-00053

U.S. Patent No. 11,857,482

PATENT OWNER'S PRELIMINARY RESPONSE

Mail Stop: PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	STATEMENT OF THE PRECISE RELIEF REQUESTED	2
III.	TECHNICAL BACKGROUND AND THE ‘482 PATENT	2
A.	The ‘482 Patent	2
B.	Prior Art.....	4
1.	Mabuchi	5
2.	Pivaroff.....	7
3.	Harris.....	8
C.	Claims of the ‘482 Patent	9
D.	Relevant Portions of the Prosecution History of the ‘482 Patent.....	10
1.	Overview	10
2.	Summary of Office Actions	12
IV.	LEVEL OF ORDINARY SKILL	16
V.	CLAIM CONSTRUCTION	17
VI.	GROUND IN THE PETITION.....	17
VII.	ARGUMENTS	18
A.	The Board Should Deny Institution Under § 325(d) and 324(a).....	18
1.	The Board Should Deny Institution Under § 325(d)	19

a)	Part 1 of § 325(d) Test: Same or Substantially the Same Prior Art and Arguments Already Considered	21
(1)	Indefiniteness and Lack of Written Description– Grounds 1 and 2.....	21
(2)	Pivaroff and Harris in Grounds 4, 5, 6, and 7	23
(3)	Mabuchi in Grounds 3, 4, 5, 6, and 7	24
b)	Part 2 of § 325(d) Test: The PTO Did Not Err in a Manner Material to Patentability	32
c)	Conclusion as to § 325(d).....	33
2.	The Board Should Deny Institution Under § 324(a)	34
B.	The Board Should Deny Institution on the Merits.....	36
1.	<u>Ground 1</u> : Petitioner Fails to Establish that Claims 34-38, 40, 41, 43-46 and 58-60 are Unpatentable Under 35 U.S.C. § 112(a) as Lacking Written Description Support	37
a)	Ground 1A: The Specification Reasonably Conveys a “First Massaging Head” Having a “Pocket to Receive the Quick Release Connector.”	38
b)	Ground 1B: The Specification Reasonably Conveys a “Substantially Cylindrical Pocket to Receive the Quick Release Connector”	42
c)	Ground 1C: The Specification Reasonably Conveys a “Quick Release Connector”	44
2.	<u>Ground 2</u> : – Petitioner Fails to Establish that Claims 34-38, 40, 41, 43-46 and 58-60 are Unpatentable Under 35 U.S.C. § 112(a) Because the	

	Claimed “Substantially Cylindrical Pocket to Receive the Quick Release Connector” Is Indefinite	47
3.	<u>Ground 3</u> : Petitioner Fails to Establish that Mabuchi Renders Claims 34, 35 and 58-60 Obvious	50
a)	Claim 34, Recitation 34[e]: “a quick release connector at the distal end of the piston, wherein the quick release connector is configured to secure a first massaging head while the piston reciprocates a predetermined stroke length at the first speed, wherein the first massaging head has a substantially cylindrical pocket to receive the quick release connector.”	50
b)	Dependent Claims 35 and 58-60	56
4.	<u>Ground 4</u> : Petitioner Fails to Establish that Mabuchi in view of Harris Renders Claims 36-38, 40-41 and 43-46 Obvious.....	57
5.	<u>Ground 5</u> : Petitioner Fails to Establish that Mabuchi in view of Harris, and Further in View of Pivaroff Render Claims 37 and 38 Obvious	59
6.	<u>Ground 6</u> : Petitioner Fails to Establish that Pivaroff in view of Mabuchi Renders Claims 34, 35 and 58-60 Obvious	60
7.	<u>Ground 7</u> : Petitioner Fails to Establish that Pivaroff in view of Mabuchi, further in view of Harris Renders Claims 36-38, 40-41 and 43-46 Obvious.....	62
C.	The Board Should Deny Institution Pursuant to Fintiv.....	62
VIII.	CONCLUSION.....	65

TABLE OF AUTHORITIES

CASES

<i>ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012)	57
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (Feb. 13, 2020)	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated precedential May 5, 2020)	62, 63, 65
<i>Ariad Pharms., Inc. v. Eli Lilly & Co.</i> , 598 F.3d 1336 (Fed. Cir. 2010) (<i>en banc</i>)	37, 42, 46
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (Dec. 15, 2017)	<i>passim</i>
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	57, 58, 59, 60
<i>Biofrontera Inc., et al. v. DUSA Pharmaceuticals, Inc.</i> , No. IPR2018-01585, Paper 10 (PTAB Feb. 26, 2019)	36
<i>Biosig Instruments, Inc. v. Nautilus, Inc.</i> , 783 F.3d 1374 (Fed. Cir. 2015)	48
<i>Boston Sci. Corp. v. Johnson & Johnson</i> , 647 F.3d 1353 (Fed. Cir. 2011)	37, 47
<i>Capon v. Eshhar</i> , 418 F.3d 1349 (Fed. Cir. 2005)	37, 47
<i>Chevron Oronite Co. v. Infineum USA L.P.</i> , IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018)	36
<i>Deeper, UAB v. Vexilar, Inc.</i> , IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019)	36

<i>Depuy v. Medtronic Sofamor Danek</i> , 567 F.3d 1314 (Fed Cir. 2009)	62
<i>Falko-Gunter Falkner v. Inglis</i> , 448 F.3d 1357 (Fed. Cir. 2006)	37
<i>Forte Biosciences, Inc. v. Univ. of Mass.</i> , 2024 WL 3104512 (PTAB June 24, 2024)	46
<i>In re Gianelli</i> , 739 F.3d 1375 (Fed. Cir. 2014)	58, 61
<i>Grace Instrument Indus., LLC v. Chandler Instruments Co.</i> , 57 F.4th 1001 (Fed. Cir. 2023)	49
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	34
<i>Indivior Inc. et al. v. Dr. Reddy's Labs, S.A.</i> , 930 F.3d 1325, 1349 (Fed. Cir. 2019)	40, 44
<i>Infobionic, Inc. v. Braemer Mfg'ing, LLC</i> , IPR2015-01704, Paper 11 (PTAB Feb. 16, 2016)	18, 33
<i>InTouch Techs., Inc. v. VGO Commc'ns, Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014)	<i>passim</i>
<i>Ironburg Inventions Ltd. v. Valve Corp.</i> , 64 F.4th 1274 (Fed. Cir. 2023)	48, 49
<i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 572 U.S. 898, 134 S.Ct. 2120, 189 L.Ed.2d 37 (2014)	47, 48
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)	33
<i>Oil States Energy Servs. LLC v. Green's Energy Grp.</i> , LLC, 138 S. Ct. 1365 (2018)	18
<i>Puma North America, Inc. v. Nike, Inc.</i> , IPR2019-01042, Paper 10 (October 31, 2019)	24

<i>In re Ratti</i> , 270 F.2d 810 (CCPA 1959)	56
<i>Retailmenot, Inc. v. Honey Science Corp.</i> , PGR2019-00060, Paper 17 (PTAB Mar. 10, 2020)	34, 35
<i>SAS Inst. Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	34
<i>Universal Imaging Indus., LLC v. Lexmark Int’l, Inc.</i> , No. IPR2019-01387, Paper 7 (PTAB Feb. 27, 2020)	25
<i>Vas-Cath Inc. v. Mahurkar</i> , 935 F.2d 1555 (Fed. Cir. 1991)	37

OTHER AUTHORITIES

35 U.S.C. § 112	<i>passim</i>
35 U.S.C. § 103	4, 11, 23, 36
35 U.S.C. § 324	<i>passim</i>
35 U.S.C. § 325	<i>passim</i>
35 U.S.C. § 326	35
37 C.F.R. § 42.1	35
37 C.F.R. § 42.6	68
37 C.F.R. § 42.24	67
MPEP	22, 25

TABLE OF EXHIBITS

#	DESCRIPTION	SHORT
Ex. 1001	U.S. Patent No. 11,857,482	‘482 Patent
Ex. 1002	Declaration of John D. Pratt, Ph.D, in Support of Petition for Post Grant Review of U.S. Patent No. 11,857,482	
Ex. 1003	Curriculum Vitae of Dr. John D. Pratt	
Ex.1004	Prosecution History of the ‘482 Patent (Application No. 17/681,367)	
Ex. 1005	U.S. Patent No. 4,513,737	Mabuchi
Ex. 1006	U.S. Patent No. 6,432,072	Harris
Ex. 1007	U.S. Patent No. 6,682,496	Pivaroff
Ex. 1008	U.S. Patent Publication No. 2003/0195443	Miller
Ex. 1009	U.S. Patent Publication No. 2007/0150004	Colloca
Ex. 1010	Taiwanese Patent Number 9,720,7752U	Wang
Ex. 1011	Certified English Translation of Taiwanese Patent Number 9,720,7752U	
Ex. 1012	U.S. Patent No. 2,550,775	Clark

I. INTRODUCTION

Patent Owner Hyperice IP Subco, LLC (“Patent Owner”) submits this Preliminary Response to the Petition for Post-Grant Review No. PGR2024-00053 (“Petition”) filed on October 30, 2024, by Theragun, Inc. (“Petitioner”) challenging Claims 34-38, 40, 41, 43-46 and 58-60 of U.S. Patent No. 11,857,482 (Ex. 1001, “the ‘482 Patent”).

The Board should deny institution under 35 U.S.C. §§ 325(d) and 324 because, as detailed herein, the Petition recycles arguments previously considered and overcome during prosecution before the Patent and Trademark Office (“PTO”), and the Petition fails to show the PTO made any error material to patentability. To the extent the Petition has any reasonable chance of succeeding on any Grounds, fairness and efficiency dictate that this Petition should be denied because it fails to show the Grounds present strong arguments that reasonably could result in invalidation of any challenged claims.

The Board also should deny institution on the merits because the Petition evidences a fundamental misunderstanding of why the ‘482 Patent was allowed and, as a result, fails to both challenge the actual bases for allowance and address the novel and non-obvious claim elements that distinguish the ‘482 Patent over the prior art.

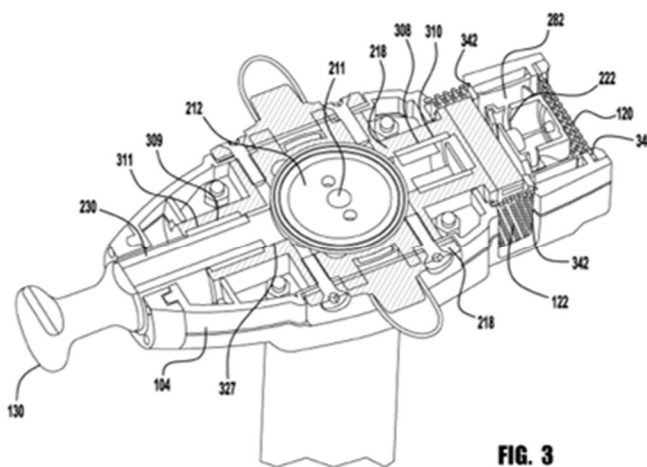
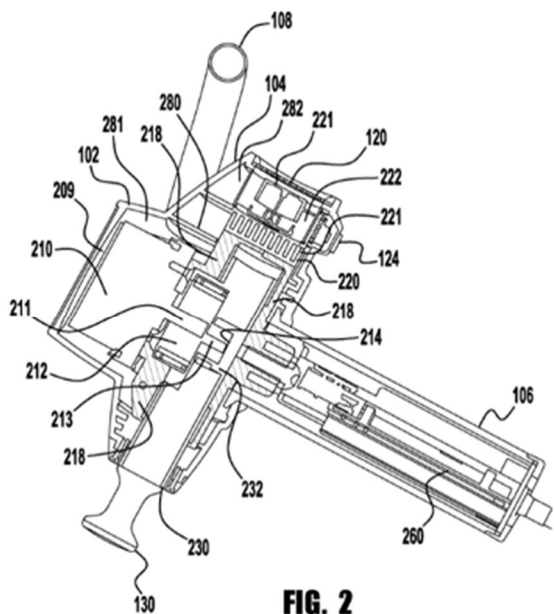
II. STATEMENT OF THE PRECISE RELIEF REQUESTED

Patent Owner requests that the Board deny institution of the Petition with respect to all challenged claims.

III. TECHNICAL BACKGROUND AND THE ‘482 PATENT

A. The ‘482 Patent

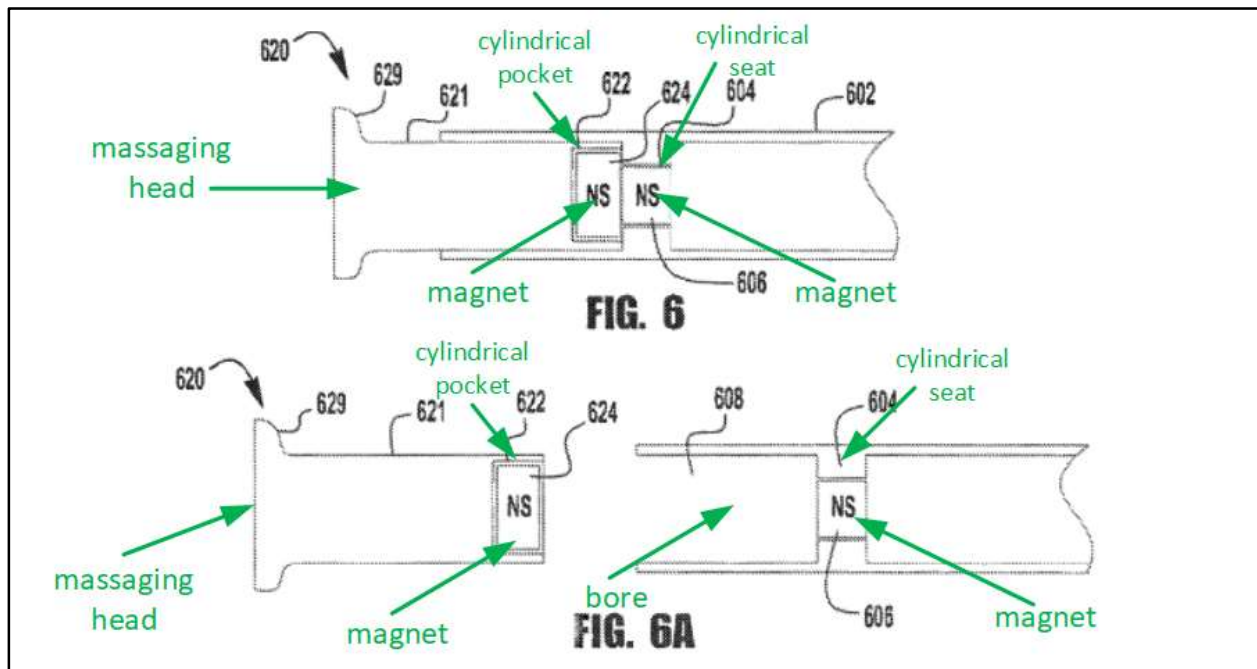
The ‘482 Patent is generally directed to a deep muscle-stimulating, percussive massage device. *See* Ex. 1001 at Abstract, 1:22-25, Figs. 1-3, and claims 1-61.



The ‘482 Patent discloses and claims improvements to deep muscle-stimulating, percussive massage devices. *Id.* at 1:21-30. One of those improvements is a “massage head 130 [that] includes a quick-release connection.” *Id.* at 3:41-44, Figs. 1-3, 6-6A; *see also id.* at 2:4-8 (“In yet another exemplary embodiment, a

messaging device includes a handle, a piston, a quick-connection mechanism and one or more massaging heads releasably connectable to the piston by the quick-connection mechanism.”). One such embodiment of a quick-release connection – discussed in more detail below – is the “quick-connect system 600 for connecting a massaging head to a piston.” *Id.* at 3:41-44, 6:47-49, Figs 6-6A; *see also id.* at 2:37-39 (“FIGS. 6, 6A and 6B illustrate an exemplary quick-disconnect mechanism for connecting one or more massaging heads to a massaging device”). The ‘482 Patent discloses and claims that, when providing a deep tissue massage using a percussive massage device, it may be desirable to switch massaging heads to work on different muscles or different portions of muscles during the massage. The disclosed and exemplary quick-connect system allows a user to quickly switch massaging heads without turning off the massaging device. *See id.* at 3:41-44, 6:47-56, Figs. 1-3, 6-6A.

As illustrated in Figs. 6 and 6A, one embodiment of the quick-connect system 600 includes a piston 602 that has a hollow-end bore 608 for receiving the shaft 621 of a massaging head 620. A cylindrical seat 604 is located within the bore 608 of piston 602. The cylindrical seat 604 retains a magnet 606, which assists in holding the massaging head in place. *See id.* at 6:57 – 7:3.



The massaging head 620 includes a shaft 621 having a cylindrical pocket 622 at the distal end. *See id.* at 6:63-64. The cylindrical pocket 622 includes a magnet 624. *See id.* at 6:64-65. As disclosed in the ‘482 Patent, when the shaft 621 of massaging head 620 slides (or is slid) into opening in bore 608, the magnets 606 and 624 are attracted to one another and magnetically hold massaging head 620 firmly in place. *See id.* at 6:67 – 7:3. Among other things, the inventive configuration of the ‘482 Patent allows “a user to quickly remove and replace the massaging head” during normal use of the percussive massage device. *See id.* at 7:8-9.

B. Prior Art

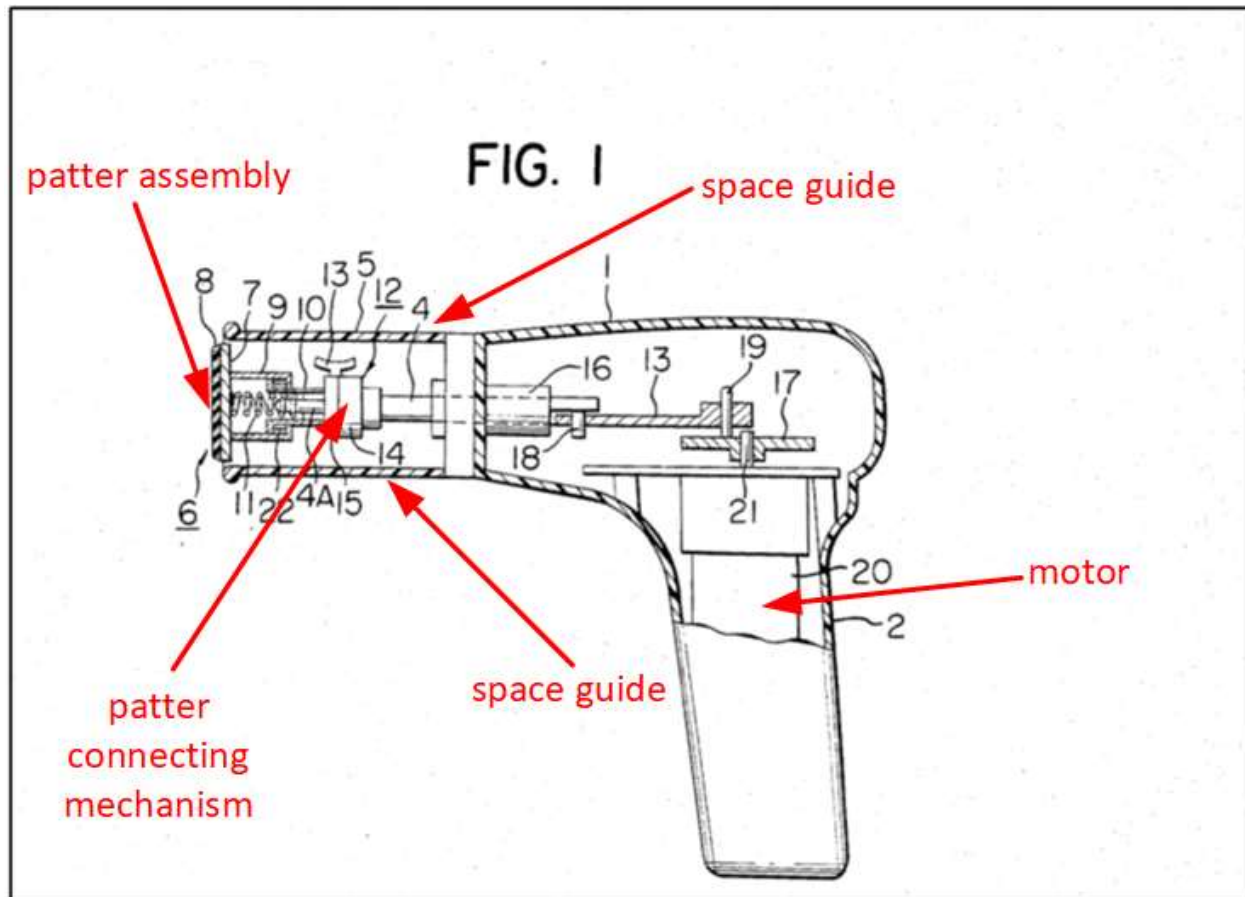
The prior art corresponds to a number of distinct categories of therapeutic devices. As discussed in detail below, for challenges related to 35 U.S.C. § 103, the Petition attempts to combine the teachings of disparate types of such devices.

Specifically, the Petition relies upon a first category of prior art devices associated with beauty treatment, such as disclosed in Mabuchi (Ex. 1005), that are configured to provide a gentle patting force on the surface of the user's face. The Petition also relies upon a second category of prior art devices associated with muscle stimulation, such as disclosed in Pivaroff (Ex. 1007) and Harris (Ex. 1006), that are configured to provide kinetic percussion and concussion vibration. The prior art references individually, or in combination, fail to teach or suggest at least "a quick release connector . . . wherein the quick release connector is configured to secure a first massaging head while the piston reciprocates a predetermined stroke length at the first speed."

1. Mabuchi

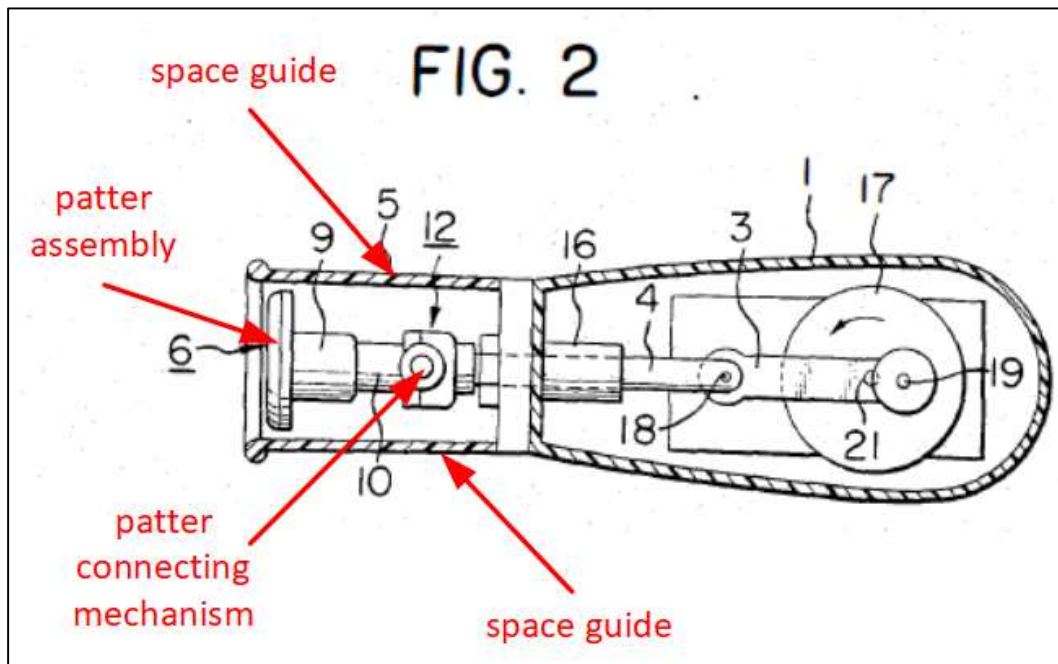
The teachings of U.S. Patent No. 4,513,737 (Ex. 1005 - Mabuchi), relied on in Grounds 3-7 of the Petition, are specifically directed toward a "beauty treatment device" including "a padder, or padder assembly removably fitted to the actuator, a space guide fitted to the device body to control the reciprocating motion of the padder assembly, and a resilient member fitted to either or both of the padder assembly and the actuator." Ex. 1005 at Abstract. Mabuchi distinguishes its disclosed device for "beauty treatment to repeatedly tap or pat the skin surface" from a vibrating device that "only presses and/or kneads the skin." *See* Ex. 1005 at 1:13-29. Notably, Mabuchi does not disclose a device for deep muscle-stimulating percussive massage.

Figure 1 of the '737 Patent illustrates the fully assembled version of the beauty device disclosed in Mabuchi.



Mabuchi specifically discloses various connection mechanisms for allowing interchangeability of the patter assembly 6. *See* Ex. 1005 at 5:65-67. Mabuchi teaches that interchangeability of the patter assembly requires some form of physical access to the connection mechanism, regardless of the embodiment of the connection mechanism. *See id.* However, Mabuchi teaches that the space guide 5 fully encompasses the patter assembly 6 in all embodiments and is required for operation

of the disclosed beauty treatment device. Accordingly, the space guide 5 must be fully removed in order for a user to access the connection mechanism. *See* Ex. 1005 at Figure 2 and 2:53-67.



The connection mechanisms 12 of Mabuchi cannot operate outside of being fully encompassed within the space guide 5 and are not accessible, and therefore would not be suitable, for securing the patter assembly during operation of the beauty treatment device.

2. Pivaroff

The Petition relies on U.S. Patent No. 6,682,496 (Pivaroff – Ex. 1007) in Grounds 5, 6, and 7. Pivaroff discloses a therapeutic massaging device for muscle stimulation. *See* Ex. 1007 at 1:18-27. The teachings of Pivaroff were extensively

considered, and eventually overcome, during prosecution of the application leading to the '482 Patent. *See, e.g.*, Ex. 1004 at 2587-2595. As the Examiner concluded during prosecution, Pivaroff fails to teach or suggest a quick release connector as recited in the challenged claims. *Id.* at 2593-2594. Petitioner does not dispute this conclusion.

Pivaroff discloses a treatment device with a hollow head 44 into which grains of various precious gems, metals, or minerals must be inserted as part of the therapeutic process. *See* Ex. 1007 at 2:55 – 3:30. According to the teachings of Pivaroff, the hollow head and grain design is critical to the function of the disclosed device for deep muscle stimulation. *See* Ex. 1007 at 3:20-29. As discussed in detailed below, the hollow head design disclosed in Pivaroff not only lacks a quick-release connector, but also requires significant redesign in order to receive any type of connection mechanism as proposed in the Petition.

3. Harris

The teachings of U.S. Pat. No. 6,432,072 (Harris – Ex. 1006) were considered and overcome during prosecution. Petitioner relies on Harris for Grounds 5, 6 and 7 of the Petition, primarily with respect to the challenged dependent claims. Harris discloses a hand-held massager having a flat, vibrating massage head and a pair of massage nodes. *See* Ex. 1005 at 1:34-41, Abstract. As detailed below, the Harris

reference fails to cure the deficiencies in the teachings of Mabuchi or Pivaroff, alone or in combination.

C. Claims of the '482 Patent

Petitioner has requested post-grant review of Claims 34-38, 40, 41, 43-46 and 58-60 of the '482 Patent, which are reproduced below for reference with the same numbering and internal modifications used in the Petition.

'482 Patent Claims	
34.[pre]	A percussive massager comprising:
[34.a]	a housing;
[34.b]	a piston in the housing having a proximal end and a distal end;
[34.c]	a motor at least partially within the housing and operatively connected to the proximal end of the piston, wherein the motor is configured to cause the piston to reciprocate at a first speed;
[34.d]	a drive mechanism between the motor and the piston that controls a predetermined stroke length of the piston; and
[34.e]	a quick release connector at the distal end of the piston, wherein the quick release connector is configured to secure a first massaging head while the piston reciprocates a predetermined stroke length at the first speed, wherein the first massaging head has a substantially cylindrical pocket to receive the quick release connector.
35.	The percussive massager of claim 34, further comprising: a second massaging head configured to releasably couple to the distal end of the piston via the quick release connector.
36.	The percussive massager of claim 34, wherein the motor is configured to cause the piston to reciprocate the predetermined stroke length at a second speed.
37.	The percussive massager of claim 36, wherein the first speed and the second speed are each less than or equal to 3600 strokes per minute.
38.	The percussive massager of claim 36, wherein the first speed and the second speed are each greater than or equal to 600 strokes per minute.
40.	The percussive massager of claim 36, further comprising: a control panel positioned on an exterior of the housing.

‘482 Patent Claims	
41.	The percussive massager of claim 40, wherein the control panel is configured to display one or more visual indicators.
43.	The percussive massager of claim 40, wherein the control panel has one or more inputs.
44.	The percussive massager of claim 43, wherein the one or more inputs comprise at least one of: a button, a switch, and a dial
45.:	The percussive massager of claim 43, wherein the first speed and the second speed are each selectable via the one or more inputs.
46.	The percussive massager of claim 43, wherein a first selection of the one or more inputs is configured to cause the percussive massager to power on and wherein a second selection of the one or more inputs is configured to cause the percussive massager to power off.
58.	The percussive massager of claim 34, wherein the motor has an output shaft configured to rotate about a rotation axis, and wherein the drive mechanism comprises: a flywheel operatively connected to the output shaft of the motor to rotate about a flywheel axis, the output shaft extending into the flywheel along the flywheel axis; and a crank pin extending from the flywheel, the crank pin being operatively connected to the piston.
59.	The percussive massager of claim 58, wherein an offset between the flywheel axis and an axis of the crank pin controls the predetermined stroke length of the piston.
60.	The percussive massager of claim 59, wherein the motor is directly connected to the flywheel, and wherein the crank pin is directly connected to the flywheel.

D. Relevant Portions of the Prosecution History of the ‘482 Patent

1. Overview

The Petition contends that the Patent Office Examiner failed in two material respects when handling the application leading to the ‘482 Patent. First, the Petition argues that “[t]he record contains no discussion of whether these claims satisfied the requirements of written description or definiteness under § 112.” Petition at 74.

Second, the Petition argues that, for purposes of the analysis under 35 U.S.C. § 103, the Examiner did not consider the Mabuchi reference with respect to the challenged claims. *See* Petition at 74, 76. The Petition is wrong in both respects.

With regard to the challenges under 35 U.S.C. § 112, the Petition attempts to draw a negative inference on the basis that the prosecution history does not establish that the Examiner explicitly considered Section 112 with respect to the challenged claims. The Petition provides no evidence to support this assertion and, as detailed below, no such evidence exists. In fact, drawing all reasonable inferences in light of the prosecution history, the Examiner almost certainly considered Section 112 with respect to all claims, including the challenged claims. Regardless, the challenged claims and specification satisfy the requirements of Section 112, as detailed below.

With regard to the challenges under Section 103, the challenged claims were allowed, contrary to the Petition's arguments, with full consideration by the Examiner that a teaching of a magnetic component that "might" allow for a massage head to connect to a piston while the piston reciprocates is not sufficient to render the claims obvious.

A review of the relevant prosecution history confirms that the challenged claims were allowed based on the novel and non-obvious features of the '482 Patent that distinguish it from all the prior art of record. The Petition essentially reconsiders the same prior art and arguments previously considered and overcome during

prosecution without any additional, substantive reasoning. Moreover, in its attempt to address the admitted efficiencies in the cited and applied art, the Petition misconstrues the teachings of the prior art and attempts to combine the teachings in an impermissible manner. The Petition fails to show that at least one challenged claim is more likely than not to be unpatentable.

2. Summary of Office Actions

The application maturing into the '482 Patent was filed on February 22, 2022 as a continuation application to U.S. Patent No. 11,285,075, which was a continuation application of U.S. Patent No. 9,889,066.¹ *See* Ex. 1001, Cover. The application was filed with 30 original claims and accompanied by a request for prioritized examination (Track One).² *See* Ex. 1004 at 0008, 0025-0028. The challenged claims³ were properly entered by way of amendment on August 10, 2023 in a response to a July 6, 2023 Office Action and subsequent interview. *See* Ex. 1004 at 2524-2531. The Examiner issued a Notice of Allowance on September 13, 2023. *See* Ex. 1004 at 2587-2595.

¹ The '482 Patent also claims priority to U.S. Provisional Application No. 61/841,693.

² The request for Prioritized Examination was granted on 4/13/2022. *See* Ex. 1004 at 0054.

³ Challenged independent Claim 34 corresponds to independent Claim 38 referenced by the Patent Office during prosecution.

Of particular note, on June 9, 2022, prior to any examination on the merits, Respondent filed an Information Disclosure Statement (“IDS”) complying with Respondent’s duty of disclosure and citing all the prior art references that were cited and applied in all four Office Actions (including Meyers, Instructables, Miller, **Harris, Pivaroff**, Tsai, Ehrenreich, Colloca, Rhoades, Noble, and Elman). *See* Ex. 1004 at 1167-1184. The IDS also cited all the prior art references relied upon in the Petition (*i.e.*, Mabuchi, Harris and Pivaroff). The submitted IDS was acknowledged as considered on 1/26/2023. *See* Ex. 1004 at 2207-2224.

The prosecution of the ‘482 Patent included four Office Actions (02/07/2023 (Non-Final) - *see* Ex. 1004 at 2227-2247; 03/07/23 (Final) - *see* Ex. 1004 at 2323-2341; 05/15/2023 (Non-Final) - *see* Ex. 1004 at 2397-2413; and 07/06/2023 (Final)- *see* Ex. 1004 at 2455-2473), four Examiner interviews (03/21/2023; 06/07/2023; 07/25/23; and 08/10/2023) - *see* Ex. 1004 at 2362-2363; 2452-2453; 2502-2503; 2562-2563), and the Notice of Allowability (09/13/2023 - *see* Ex. 1004 at 2587-2595).

For each Office Action and the Post-Allowance amendment, the assigned Primary Examiner, Examiner Stanis, conducted detailed keyword searches against the references cited in the IDS (including Mabuchi, Pivaroff and Harris) using the Patent Office’s electronic searching tool. *See* Ex. 1004 at 2248-2265; 2343-2344; 2414-2417; 2477-2488; and 2582-2585. For example, in support of the first Office

Action (02/07/2023), Examiner Stanis generated 18 pages of search queries run against all the cited references, including specifically the teachings of Mabuchi. *See* Ex. 1004 at 2248-2265. Additionally, as the claims of the ‘482 Patent were amended and arguments presented, Examiner Stanis conducted supplemental keyword searching against the same set of cited references (including Pivaroff, Harris, and Mabuchi) and specifically chose to rely on the teachings of other prior art references, namely, Colloca, Rhoades, Noble and Elman over the other art of record (including Mabuchi). *See* Ex. 1004 at 2323-2341; 2392-2453; and 2455-2473.

The claimed subject matter at issue in the Petition relates specifically to the recited “quick release connector” of the percussive massager. Throughout the prosecution history, the Examiner relied on the teachings of various prior art references for the “quick release connector.”

For example, in the March 7, 2023, Final Office Action, the Examiner addressed the added recitation of a “quick release connector” by stating that “it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to design the modified device of Meyer to have multiple interchangeable impact heads that can be coupled to the reciprocating piston via a quick release connector as taught by Miller.” *See* Ex. 1004 at 2329-2330.

Similarly, in the March 15, 2023 Office Action, in response to Respondent's arguments distinguishing the teachings of Miller, the Examiner considered the additional teachings of Colloca with regard to the "quick release connector":

Therefore, it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to design the modified device of Meyer to have multiple interchangeable impact heads that can be coupled to the reciprocating piston via a quick release connector as taught by Colloca to allow a user to select different types of massage heads as dictated by the user's therapy needs.

See Ex. 1004 at 2405-2406.

Most importantly, in the July 6, 2023, Office Action, the Examiner cited the previously relied-upon teachings of Pivaroff (as a primary reference) but then added the teachings of Rhoades to address not only the teachings of a "quick release connector" in general, but also the use of magnetic attractive forces for such connection mechanisms. *See* Ex. 1004 at 2458-2459.

In successfully distinguishing the claims of the '482 Patent over all the cited and applied references, including the last proposed combination of the Pivaroff and Rhoades, Applicant submitted arguments related to the individual deficiencies in the teachings of each respective reference and their purported combinations. *See* Ex. 1004 at 2532-2539. This included arguments highlighting the significant challenges associated with the proposed combination of references corresponding to a deep

tissue massager (Pivaroff) and a cosmetic massager (Rhoades). *See* Ex. 1004 at 2536.

The resulting Notice of Allowability issued by Examiner Stanis encompasses the key point that is not addressed by the Petition:

Pivaroff does not disclose a quick-connect system configured to allow a massaging head to be secured or connected to the percussive massager while the piston reciprocates as required by ... Claim 38.

While Rhoades discloses a quick-connect system that uses magnetic coupling that *might* allow for a massage head to attach to a piston while the piston reciprocates, Rhoades does not disclose the **claimed structure** of the quick release connection system – namely ... a substantially cylindrical pocket at the first massaging head to receive a quick release connector (claim 38).

See Ex. 1004 at 2593-2594 (emphasis added).

IV. LEVEL OF ORDINARY SKILL

The relevant field of art is devices for applying percussive massage to a selected portion of the body. A person of ordinary skill in the art (“POSITA”) at the time of the invention would have a working knowledge of product development, and would likely have a degree in engineering and/or industrial design, and/or at least three to five years of experience in conceiving, designing, engineering, and/or modifying such products and devices.

V. CLAIM CONSTRUCTION

At this stage of the proceedings, no claim construction is necessary, and the claim terms can be given their plain and ordinary meaning.

VI. GROUNDS IN THE PETITION

The Petition presents the following seven Grounds – two Grounds based on 35 U.S.C. ¶ 112 and five Grounds that primarily rely on prior art and arguments previously considered and overcome during prosecution.

#	References /Statutory Basis (<u>underlined</u> if already considered and overcome during prosecution)	Claims
1.	Lack of Written Description under 35 U.S.C. ¶ 112	34-38, 40, 41, 43-46, and 58-60
2.	Indefinite under 35 U.S.C. ¶ 112	34-38, 40, 41, 43-46, and 58-60
3.	Mabuchi (Ex. 1005)	34, 35, and 58-60
4.	Mabuchi (Ex. 1005) combined with <u>Harris (Ex. 1006)</u>	36-38, 40, 41, and 43-46
5.	Mabuchi combined with <u>Harris (Ex. 1006)</u> further combined with <u>Pivaroff (Ex. 1007)</u>	37-38
6	<u>Pivaroff (Ex. 1007)</u> combined with Mabuchi (Ex. 1005)	34, 35, and 58-60
7	<u>Pivaroff (Ex. 1007)</u> combined with Mabuchi (Ex. 1005) further combined with <u>Harris (Ex. 1006)</u>	36-38, 40, 41, and 43-46

Pivaroff (Ex. 1007) and Harris (Ex. 1006) were specifically cited and overcome during prosecution. *See* ‘482 Patent, References Cited. Additionally, Mabuchi (Ex. 1005) was cited in an IDS prior to any official action by the PTO and

was identified in search queries in each of the official actions, including four Office Actions and the Notice of Allowability. *See* Ex. 1004 at 2227-2247; 2323-2341; 2392-2453; 2455-2473; 2587-2595. The Petition also cites an expert declaration from John D. Pratt, Ph.D. (“Pratt”) that parrots the Petition’s arguments with little elaboration.⁴

VII. ARGUMENTS

The Petition fails to establish that any claim of the ‘482 Patent is more likely than not to be unpatentable; thus, institution should be denied with respect to all challenged claims.

A. The Board Should Deny Institution Under § 325(d) and 324(a)

Institution is discretionary. *Oil States Energy Servs. LLC v. Green’s Energy Grp.*, LLC, 138 S. Ct. 1365, 1371 (2018). The Board should exercise its discretion and deny institution pursuant to 35 U.S.C. §§ 325(d) and 324(a) and the relevant caselaw because the same or substantially the same prior art and arguments previously were presented to, and fully considered by, the Examiner. Petitioner has not demonstrated that the Examiner erred in a manner material to the patentability of challenged claims, and fairness and efficiency dictate that this Petition—which

⁴ The Board has previously noted that expert declarations that merely parrot the petition’s arguments are entitled to little or no weight. *See, e.g., Infobionic, Inc. v. Braemer Mfg’ing, LLC*, IPR2015-01704, Paper 11 at 6, 12 (PTAB Feb. 16, 2016).

recycles the same art and arguments previously considered and overcome—should be denied as a whole.

1. The Board Should Deny Institution Under § 325(d)

The Board may deny institution where “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

Under § 325(d), the Board uses a 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 first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

If a condition in the first part of the 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. If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. *At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.*

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8-9 (Feb. 13, 2020) (precedential decision) (emphasis added).

The panel in *Advanced Bionics* further clarified how the factors listed below “provide useful insight into how to apply the [two-part] framework under 35 U.S.C. § 325(d)”:

[Factors to consider under part 1:]

- (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;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;

[Factors to consider under part 2:]

- (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.

Advanced Bionics, Paper 6 at 9-10 & n.10 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to § III.C.5., first paragraph)).

a) Part 1 of § 325(d) Test: Same or Substantially the Same Prior Art and Arguments Already Considered

Factors (a), (b), and (d) of the Becton, *Dickinson* test, which are considered under the first part of the *Advanced Bionics* Section 325(d) test, all weigh in favor of finding that the same, substantially the same, cumulative, or overlapping prior art and arguments were previously presented to the Examiner and overcome during the prosecution of the '482 Patent. As such, deference should be given to the full examination process conducted by the Examiner by denying institution.

(1) Indefiniteness and Lack of Written Description— Grounds 1 and 2

The Petition contends that the first prong of the *Advanced Bionics* Section 325(d) test is not met, because “[t]he record contains no discussion of whether [the challenged] claims satisfied the requirements of written description or definiteness under § 112.” Petition at 74. The Petition further contends that “it was a material error for the examiner not to have considered the written description and indefiniteness issues for the challenged Claim 34 and its dependents.” *Id.* at 75. However, the Petition provides no evidence establishing that the Examiner did not consider the written description and indefiniteness requirements for the challenged claims.

The Petition incorrectly asserts that the “Patent Owner added the challenged claims late in the prosecution,” and that “[t]he Examiner issued a Notice of

Allowance immediately following their addition...” *See* Petition at 75-76. In fact, the Patent Owner added the challenged claims on August 10, 2023 (*see* Ex. 1004 at 2528-2539) and then the Examiner and the prosecuting attorney participated in an interview during which, *inter alia*, “Examiner Stanis agreed that the proposed amendments... overcome the prior art of record” because, among other reasons, “[t]he cited prior art does not disclose... a cylindrical pocket in the first massaging head configured to receive a quick release connector.” *See* Ex. 1004 at 2563. The Examiner did not issue a Notice of Allowance until September 13, 2023 – more than one month later. *See* Ex. 1004 at 2586.

Furthermore, the Petition provides no evidence that Examiner Stanis failed to understand or comply with the requirements of the Manual of Patent Examining Procedure (“MPEP”). Section 2166⁵ of the MPEP dictates Patent Office procedures regarding 35 U.S.C. § 112(a), and Section 2173⁶ dictates Patent Office procedures for compliance with 35 U.S.C. § 112(b). Examiner Stanis, an experienced Primary Patent Examiner⁷, undoubtably understood and fully considered the statutory

⁵ <https://www.uspto.gov/web/offices/pac/mpep/s2166.html#fp7.31.05>

⁶ <https://www.uspto.gov/web/offices/pac/mpep/s2173.html>

⁷ Examiner Stanis was a Primary Examiner in Art Unit 3785 with more than 10 years of service at the time of the examination. According to Patent Bots, Examiner Stanis is considered a “harder” examiner, with a grant rate of 64% over 272 cases. *See* <https://www.patentbots.com/stats/examiner/3785-STANIS-TIMOTHY-A>

requirements of 35 U.S.C. § 112 during the prosecution of the ‘482 Patent. Indeed, the prosecution history confirms that the Examiner considered various subsections of Section 112. For example, in the first Office Action, Examiner Stanis interpreted certain claim terms under 35 U.S.C. § 112(f), and the Examiner rejected originally-filed Claims 27-30 under 35 U.S.C. § 112(b) as indefinite. *See* Ex. 1004 at 2231-34.

At the very least, “reasonable minds can disagree regarding the purported treatment of the art or arguments” by the Examiner; therefore “it cannot be said that the Office erred in a manner material to patentability.” *See Advanced Bionics*, Paper 6 at 8-9. Accordingly, with regard to Grounds 1-2, the Board should exercise its discretion under Section 325(d) and deny institution.

(2) Pivaroff and Harris in Grounds 4, 5, 6, and 7

With respect to *Becton, Dickinson* factor (a), the Petition simply asserts that “the prior art references asserted in Grounds 3 through 7 were of record during the prosecution.” *See* Petition at 74. However, the Petition fails to fully acknowledge the extent to which the Examiner considered two of the primary references relied upon in the Petition, Pivaroff and Harris. The Examiner made Section 103 rejections in all four office actions based on Pivaroff and Harris. *See* Ex. 1004 at 2227-2247; 2323-2341; 2392-2453; 2455-2473. Moreover, Pivaroff was cited and applied as a primary reference in the last Office Action (July 6, 2023 - *see* Ex. 1004 at 2455-2473) and was the subject of a telephone interview with Respondent’s representative

on July 25, 2023. *See* Ex. 1004 at 2502-2503. Additionally, the Notice of Allowance (September 13, 2023) specifically references the teachings of Pivaroff and Rhoades as the closest prior art of record. *See* Ex. 1004 at 2593-2594. In addition, the teachings of Harris were consistently cited by the Examiner in all four Office Actions with regard to the dependent claims. *See* Ex. 1004 at 2227-2247; 2323-2341; 2392-2453; 2455-2473.

With respect to factors (b) and (d), the Petition not only relied upon the teachings of Pivaroff and Harris in Grounds 4-7, but repeated the very same analysis and arguments made by the Examiner. The Petition does not provide any new analysis of the teachings of Pivaroff or Harris or present any new arguments regarding applicability to the challenged claims of the '482 Patent. Such a high degree of overlap of arguments presented in the Petition and the arguments repeatedly made during examination weighs in favor of exercising discretion to deny institution. *See Puma North America, Inc. v. Nike, Inc.*, IPR2019-01042, Paper 10 at 14 (October 31, 2019).

(3) Mabuchi in Grounds 3, 4, 5, 6, and 7

With respect to factor (a), the Petition admits that Mabuchi was of record during the prosecution but argues that “neither the Examiner nor Applicants ever discussed the Mabuchi reference.” *See* Petition at 74. The Petition does not provide any independent analysis as to factor (a) and, notably, does not provide any evidence

that Examiner Stanis was unaware of, or failed to consider, the teachings of Mabuchi.

Under the Board's precedent, "[p]reviously presented art includes art made of record [on an IDS] in the prosecution history of the challenged patent." *Advanced Bionics*, Paper 6 at 7-8. This includes references actually cited and applied in Office Actions (*e.g.*, Pivaroff and Harris) or cited on an IDS during prosecution of the parent application (*e.g.*, Mabuchi). *See Becton, Dickinson*, Paper 8 at 22-23; Ex. 1009 at 157-60, 323-24. Indeed, other Board decisions have found that consideration of a reference listed on an IDS weighs in favor of denying institution under § 325(d) as well as the *Becton, Dickinson* factors (a), (b), and (d). *See, e.g., Universal Imaging Indus., LLC v. Lexmark Int'l, Inc.*, No. IPR2019-01387, Paper 7 at 15-17 (PTAB Feb. 27, 2020) (Adkins reference cited, but not separately discussed, was deemed considered for § 325(d) purposes); MPEP § 609.05(b) (9th ed., Rev. Jan. 2018) ("Examiners must consider all citations submitted in conformance with the rules, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a[n IDS] (or the examiner may use the alternative electronic signature method noted above) provides a clear record of which citations have been considered by the Office.").

The prosecution history of the '482 Patent further indicates that for each of the four Office Actions and the Notice of Allowability, Examiner Stanis conducted

detailed keyword searching against the references cited in the IDS (including Mabuchi) using the Patent Office's electronic searching tool for each Office Action. *See* Ex. 1004 at 2248-2265; 2343-2344; 2414-2417; 2477-2488; 2582-2585. For example, in support of the first Office Action, Examiner Stanis generated 18 pages of search queries run against all the cited references, including specifically the teachings of Mabuchi. *See* Ex. 1004 at 2248-2265. Additionally, as the claims of the '482 Patent were amended and arguments presented, Examiner Stanis conducted supplemental keyword searching against the same set of cited references (including Mabuchi) and specifically chose to rely on the teachings of Colloca, Rhoades, Noble and Elman over the other art of record (including Mabuchi). *See* Ex. 1004 at 2323-2341; 2392-2453; 2455-2473.

With respect to factors (b) and (d), the teachings of Mabuchi and the arguments provided in the Petition are cumulative and were already considered by the Examiner. The Petition attempts to characterize the teachings of Mabuchi as introducing a key element that was never considered by the Examiner, stating that "neither the Examiner nor Applicants ever discussed the Mabuchi reference, relied upon herein as disclosing the 'quick release connector' limitation that was used to distinguish the other prior art references during prosecution." *See* Petition at 74. The Petition then incorrectly summarizes that "Mabuchi discloses the key 'quick release connector' that was argued to be missing from the other cited prior art...." *Id.* at 74-

75. Not only does the Petition incorrectly characterize the claims of the ‘482 Patent and the teachings of Mabuchi, but the statement is factually inaccurate in light of the prosecution history.

Throughout the prosecution of the application leading to the ‘482 Patent, the Examiner relied on the teachings of numerous prior art references for the “quick release connector.” In a first example, in the March 7, 2023, Final Office Action, the Examiner addressed the added recitation of a “quick release connector” by stating:

The modified apparatus of Meyer does not have the connection mechanism as a “quick release connector.”

However, Miller teaches a percussive therapeutic device (Fig. 1) comprising a plurality of massage heads (Fig. 1, impact heads 70) that are releasably coupled to the distal end of a piston via a quick release connector ([0026] discloses a quick release connector using a collar pin 66 and pin notches 68 as shown in Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to design the modified device of Meyer to have multiple interchangeable impact heads that can be coupled to the reciprocating piston via a quick release connector as taught by Miller to allow a user to select different types of massage heads as dictated by the user’s therapy needs.

See Ex. 1004 at 2329-2330.

Similarly, in the March 15, 2023, Office Action, in response to Respondent's arguments distinguishing the teachings of Miller, the Examiner considered the additional teachings of Colloca with regard to the "quick release connector" to cure the potential deficiencies identified with regard to the teachings of Miller:

The modified apparatus of Meyer does not have the connection mechanism as a "quick release connector," wherein the quick release connector is configured to connect a first massaging head while the piston moves between the minimum reciprocation stroke length and the maximum reciprocation stroke length at the first speed.

However, Colloca teaches a reciprocating massage device comprising a reciprocating piston (Fig. 9, plunger rod 151) and interchangeable impact heads (Fig. 2, impact head 70 may be removed and replaced with a different impact head. Figs. 14A-14D depict different varieties of impact heads). The connection between the impact head and the massage device is a "quick connection" ([0056] discloses that the impact coupler 78 of the impact head 70 forms a "press fit" with the thrust nose piece 130 of the housing 12). This quick, press fit connection would allow the user to quickly swap out impact heads, even during reciprocation of the piston.

Therefore, it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to design the modified device of Meyer to have multiple interchangeable impact heads that can be coupled to the reciprocating piston via a quick release connector as taught by Colloca to allow a user to select different types

of massage heads as dictated by the user's therapy needs. The modified device would allow the user to connect or remove a massaging head during movement of the piston. While the references do not explicitly teach a method step of connecting a massaging head during movement of the piston, claim 1 is a device claim in which the quick release connector "is configured" to connect a first massaging head while the piston moves. The quick release connector of Colloca operates in a similar manner as the applicant's quick release connector (see Applicant's Figs. 6-6B), and would similarly be "configured" to allow connection of a massaging head during movement of the piston.

See Ex. 1004 at 2405-2406.

While Miller may arguably have taught a connection mechanism that was too cumbersome to connect a massage head to a piston during movement of the piston, Colloca teaches a much simpler connection mechanism that is "configured to" connect a massaging head to a reciprocating piston during movement of the piston. The connection mechanism of Colloca is very similar to the connection mechanism of the applicant depicted in applicant's Figs. 6A-6B.

See Ex. 1004 at 2412.

Most importantly, in the July 6, 2023 Office Action, the Examiner updated the analysis to cite the previously relied upon teachings of Pivaroff (as a primary reference) but then specifically added the teachings of Rhoades to address not only a "quick release connector" in general, but also the use of magnetic attractive forces for such connection mechanisms:

Pivaroff does not explicitly disclose that the quick release connector is configured to connect a first massaging head “while the piston moves the predetermined stroke length at the first speed.” While it may be possible that the head 44 may be unscrewed from the rod 38 during reciprocation of the piston, the reference is not clear if this is the case. However, Rhoades discloses a massaging device (Fig. 4A, device 100) comprising a housing (Fig. 4A, handle portion 130 and head portions 120, 140 form a housing) having a quick release connector for attaching removable massage heads (Figs. 4A-4B, attachment heads 200 may be connected to the head portions 120/140 of the housing via a quick release connector). Rhoades discloses that these quick release connectors can be threaded mating or **magnetic attractive force** ([0061]).

Therefore, it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to replace the threaded connection between the massaging head and the piston of Pivaroff with a magnetic attractive force connection as taught by Rhoades because such a modification is the simple substitution for one known massage head connection mechanism for another known massage head connection mechanism to obtain the predictable result of securely fastening a removably massage head to the housing of a massage device. See MPEP 2143(I)(B). Use of a magnetic connection instead of a threaded connection provides the additional benefit of allowing for quicker removal and installation of the massage heads. While the resultant device does not explicitly state that the massage head can be connected to the piston during movement of the piston, the

magnetic quick release connector is the same type of connection mechanism as found on the applicant's device (see Applicant's Figs. 6-6B, which depicts a magnetic quick release connector). Thus, the modified device of Pivaroff would have the quick release connector as "configured" to connect a first massaging head while the piston moves in the same manner as the Applicant.

See Ex. 1004 at 2458-2459 (emphasis in original).

Applicant's arguments filed on 6/7/2023 on Pages 2-6 with respect to claims 1 and 27 and regarding Meyer, Instructables, and Colloca not disclosing the claimed "quick release connector" have been considered, but are moot in view of the new grounds of rejection presented in this office action. It is importantly noted that while the applied references do not explicitly teach a method step of connecting a first massaging head to a piston while the piston is moving, claims 1 and 27 recited devices that are "configured to" perform such a function. The applicant appears to be relying on the magnetic structure of the quick release connector (see applicant's Figs. 6-6B), wherein the current rejection applies a similar magnetic structure that would allow for the function of connecting a massage head while the piston is moving.

See Ex. 1004 at 2471-2472.

In successfully distinguishing the allowed claims of the '482 Patent over the cited and applied references, including the last proposed combination of the Pivaroff and Rhoades, Applicant submitted arguments related to the deficiencies in the teachings of each respective reference, whether alone or combined with each other.

See Ex. 1004 at 2532-2539. This included arguments highlighting the significant challenges associated with the proposed combination of references corresponding to a deep tissue massager (Pivaroff) and a cosmetic massager (Rhoades). *See* Ex. 1004 at 2536. The teachings of Mabuchi suffer from the same deficiencies.

Thus, Advanced Bionics, factors (a), (b), and (d) favor denial of the institution of the Petition.

b) Part 2 of § 325(d) Test: The PTO Did Not Err in a Manner Material to Patentability

The Petitioner has not even attempted to show that the Examiner materially erred in evaluating the prior art and arguments during prosecution. Factors (c), (e), and (f) of *Becton, Dickinson*, which are considered under the second part of the Section 325(d) test, all weigh in favor of finding the Examiner did not make any error material to the patentability of the challenged claims.

With respect to factors (c) and (e), the Petition presented no argument at all because the Petition concludes, without any evidence, the Examiner did “not consider the Mabuchi reference against the newly added claims.” As discussed above, Mabuchi was known to the Examiner, and substantially the same prior art and arguments were considered and overcome during prosecution. Thus, the Petition has not made, and cannot make, the “showing that the Examiner misapprehended or overlooked *specific teachings* in the relevant prior art such that the error by the

[Examiner] was material to the patentability of the challenged claims” required to show the Examiner erred.” *Advanced Bionics*, Paper 6 at 21; *see also NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) at 16 (“point[ing] out sufficiently how the Examiner erred in evaluating the asserted prior art” is required).

With respect to factor (f), the Petition does not specifically identify any required “additional evidence and facts presented in the petition that warrant reconsideration of the prior art.” *See NHK*, Paper 8 at 16-17. Rather, the Petition relies on the same, or substantially the same, arguments that the Applicant overcame in prosecution. To the extent the Petition is relying on an expert declaration from Dr. Pratt under factor (f) because the Pratt declaration was not before the PTO, the expert’s arguments are entitled to little weight because they merely repeat (often verbatim) the arguments from the Petition without any evidentiary support. *See NHK*, Paper 8 at 16-17; *Infobionic, Inc. v. Braemer Mfg’ing, LLC*, IPR2015-01704, Paper 11 (PTAB Feb. 16, 2016) at 6, 12.

c) Conclusion as to § 325(d)

Because the same or substantially the same prior art or arguments previously were presented to the Examiner during prosecution of the ‘482 Patent, “the Board’s decisions generally have required a showing that the [Examiner] erred in evaluating the art or arguments” and, if such an error is not shown, “the Director may exercise

his discretion not to institute.” *Advanced Bionics*, Paper 6 at 8 (citing *Becton, Dickinson*, Paper 8 at 24). As discussed above, all of the *Becton, Dickinson* factors favor denying institution. Thus, the Board should deny institution here in keeping with its “commitment to defer to previous [Examiner] evaluations of the evidence of record unless material error is shown.” *Advanced Bionics*, Paper 6 at 9.

2. The Board Should Deny Institution Under § 324(a)

The Board should exercise its discretion to deny institution under Section 324(a), because fairness and efficiency dictate that this Petition, which recycles the same art and arguments previously considered and overcome, should be denied as a whole.

“[E]ven when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims, institution of review remains discretionary.” *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) [and 324(a)] invests the Director with discretion on the question *whether* to institute review....”) (emphasis in original). “[T]he PTO is permitted, but never compelled, to institute an IPR [or PGR] proceeding.” *Retailmenot, Inc. v. Honey Science Corp.*, PGR2019-00060, Paper 17 at 34 (PTAB Mar. 10, 2020) (quoting *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016)). In exercising that discretion, the Board is guided by the statutory requirement, in promulgating regulations for PGR, to consider the effect of any regulations on “the efficient administration of the Office

[and] the ability of the Office to timely complete proceedings,” 35 U.S.C. § 326(b), as well as the requirement to construe our rules to “secure the just, speedy, and inexpensive resolution of every proceeding,” 37 C.F.R. § 42.1(b). PTO guidance, issued June 5, 2018, also explains that the Board “will evaluate the challenges and determine whether § 325(d) is sufficiently implicated that its statutory purpose would be undermined by instituting on all challenges” and, if so, “evaluate whether the entire petition should be denied.” SAS Q&A’s, Part D, Effect of SAS on Future Challenges that Could Be Denied for Statutory Reasons (June 5, 2018), available at https://www.uspto.gov/sites/default/files/documents/sas_qas_20180605.pdf (answer to Question D1). *See also Retailmenot*, Paper 17 at 34-35.

As detailed above, pursuant to § 325(d), the Petition should not be instituted because all Grounds present the same or substantially the same prior art and arguments previously considered and overcome during prosecution, and no error by the PTO material to patentability has been shown.

Even if Petitioner had been able to establish that a few claims are more likely than not unpatentable—which the Petitioner has not done—the Board should exercise its discretion to deny institution under § 324(a). Instituting a trial with respect to all challenged claims would not be an efficient use of the Board’s time and resources given the duplicity and significant substantive weaknesses in the Grounds presented in the Petition. *See, e.g., Deeper, UAB v. Vexilar, Inc.*, IPR2018-

01310, Paper 7 at 41-43 (PTAB Jan. 24, 2019) (informative) (denying institution where a reasonable likelihood of prevailing was shown at most for 1 of 4 grounds and 2 of 23 claims); *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (PTAB Nov. 7, 2018) (informative) (denying institution where a reasonable likelihood of prevailing was shown at most for 2 of 20 claims); *Biofrontera Inc., et al. v. DUSA Pharmaceuticals, Inc.*, No. IPR2018-01585, Paper 10 at 14-15 (PTAB Feb. 26, 2019) (denying institution where a reasonable likelihood of prevailing was shown at most for 1 of 8 grounds and 3 of 19 claims).

B. The Board Should Deny Institution on the Merits

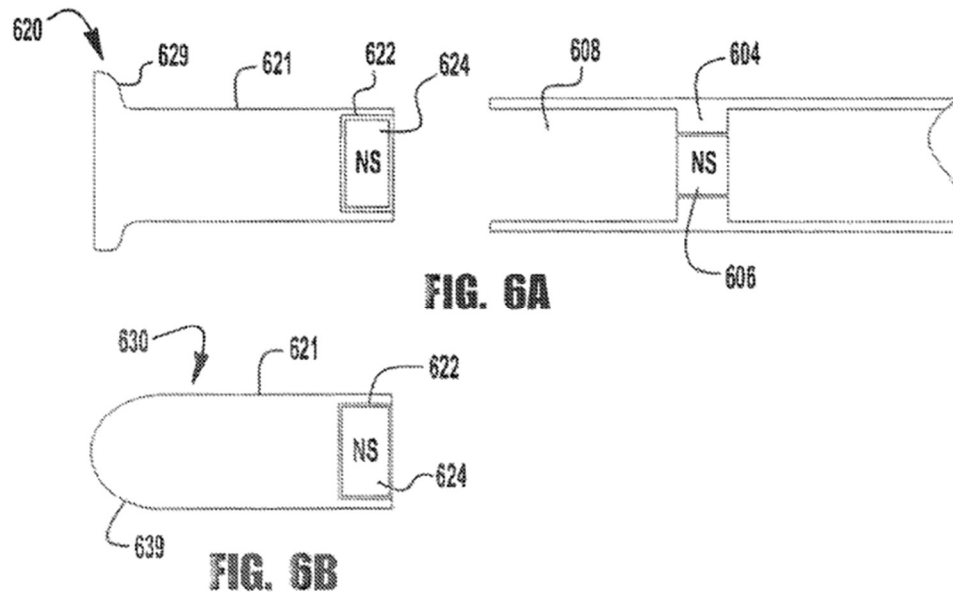
The Board should deny institution on the merits because the Petition fails to meet its burden to show at least one challenged claim is more likely than not to be non-compliant with the statutory requirements of 35 U.S.C. § 112 or obvious under 35 U.S.C. § 103. *See* 35 U.S.C. § 324(a). Each of the individual Grounds suffers from flawed technical analyses of the prior art and flawed applications of the statutory bases for invalidity. In addition, the Grounds generally amount to nothing more than an attempt to reconsider arguments previously overcome during prosecution of the '482 Patent.

1. Ground 1: Petitioner Fails to Establish that Claims 34-38, 40, 41, 43-46 and 58-60 are Unpatentable Under 35 U.S.C. § 112(a) as Lacking Written Description Support

To satisfy the written description requirement under 35 U.S.C. § 112(a), the specification must “reasonably convey[] to those skilled in the art that the inventor had possession” of the claimed invention as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). An adequate description does not require any particular form of disclosure or that the specification recite the claimed invention *in haec verba*. *Id.* at 1352. In fact, “drawings may suffice to satisfy the ‘written description’ requirement of § 112.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). In evaluating the adequacy of the written description, a court may also consider “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.” *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005) (cited with approval in *Ariad*, 598 F.3d at 1352); *see also Boston Sci. Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1366 (Fed. Cir. 2011) (holding that because assessment for written description is made from perspective of person of ordinary skill in the art, in some instances, a patentee can rely on information that is “well-known in the art” to satisfy written description). “A patent need not teach, and preferably omits, what is well known in the art.” *Falko-Gunter Falkner v. Inglis*, 448 F.3d 1357, 1365 (Fed. Cir. 2006).

a) Ground 1A: The Specification Reasonably Conveys a “First Massaging Head” Having a “Pocket to Receive the Quick Release Connector.”

The written description and accompanying figures reasonably convey, to a skilled artisan, a “first massaging head” having a “pocket to receive the quick release connector.” Figures 6A and 6B illustrate two embodiments of massaging heads 620 and 630. Each of these massaging heads has a “cylindrical pocket 622 at the distal end,” and the pocket receives the quick release connector, magnets 608 and 624 (‘482 Patent at 6:64-65, Figs. 6A and 6B):

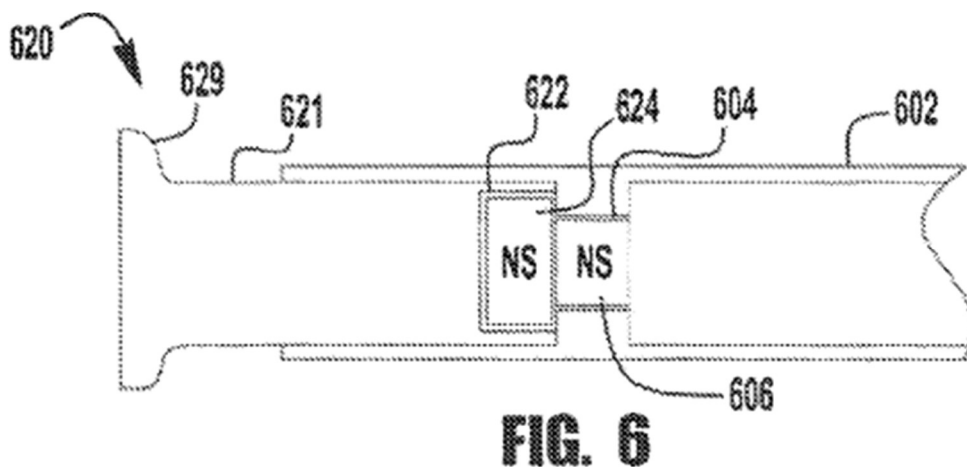


The written description provides the following additional details regarding this embodiment of a quick-connect system:

Quick-connect system 600 includes a piston 602 that has a hollow-end bore 608 for receiving the shaft 621 of a massaging head 620. Located

within the bore 608 of piston 602 is a cylindrical seat 604. Cylindrical seat 604 retains a magnet 606. Magnet 606 is illustrated with its north pole located flush with the seat and facing toward the opening in bore 608. Massaging head 620 includes a shaft 621 having a cylindrical pocket 622 at the distal end. Located within the cylindrical pocket 622 is a magnet 624. Magnet 624 is positioned so that its south pole is located at the distal end of shaft 621. Accordingly, when the shaft 621 of massaging head 620 is slid into opening in bore 608, the magnets 606 and 624 are attracted to one another and magnetically hold massaging head 620 firmly in place.

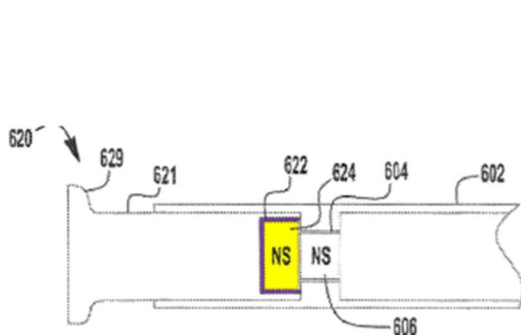
Ex. 1001 at 6:57 – 7:3. Figure 6 shows the quick-connect system in operation, with cylindrical pocket 622 receiving the quick release connector (magnets 606 and 624):



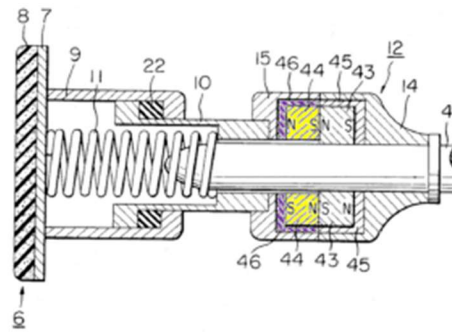
According to the Petitioner, for the same reason, the Mabuchi prior art reference discloses a cylindrical pocket to receive the quick release connector:

Furthermore, to the extent Patent Owner contends that the '482 Patent's disclosure of cylindrical pocket 622 holding magnet 624 at the distal

end of shaft 621 is a “substantially cylindrical pocket to receive the quick release connector,” Mabuchi discloses the same arrangement. As shown in the annotated figures from the ’482 Patent and Mabuchi below, Mabuchi similarly discloses a pocket (yoke core 46) holding magnet 44 in flange 15 of the pater assembly 6. Ex-1002 ¶118.



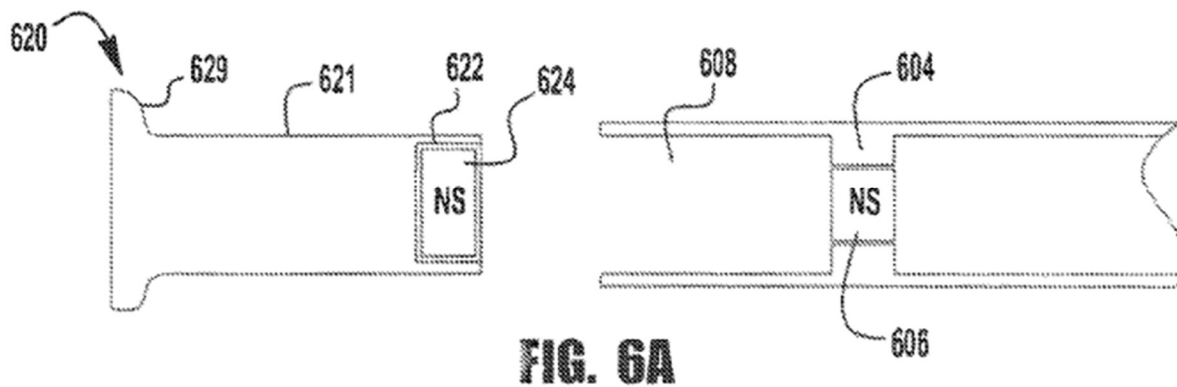
Ex-1001, Fig. 6 (annotated)



Ex-1005, Fig. 18 (annotated)

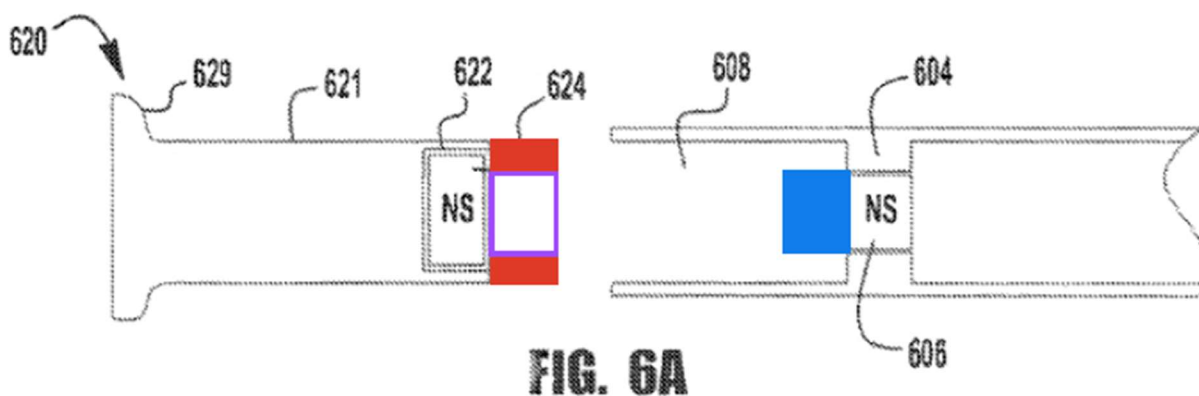
Petition at 41-42.

If the Board determines that Figure 6 of the ’482 Patent does not literally show a pocket to receive the quick release connector, the specification nevertheless reasonably conveys the claimed feature to a skilled artisan. *See Indivior Inc. et al. v. Dr. Reddy’s Labs, S.A.*, 930 F.3d 1325, 1349 (Fed. Cir. 2019) (“The specification need not recite the claimed invention *in haec verba*” so long as specification reasonably conveys claimed feature to a skilled artisan). The specification shows a “female” bore 608 (which is the same as pocket) in the piston, and that bore 608 receives the “male” massaging head 620.



A skilled artisan could easily swap these, so that a “male” portion of the piston could be inserted into a “female” bore/pocket in the massaging head.

Alternatively, a skilled artisan could accomplish something similar by revising the structure shown in Figure 6A. The skilled artisan could simply extend magnet 606 (extension shown in blue), extend the length of massaging head 620 (extension shown in red), and create a pocket (shown in purple) into which magnet 606 could be inserted:

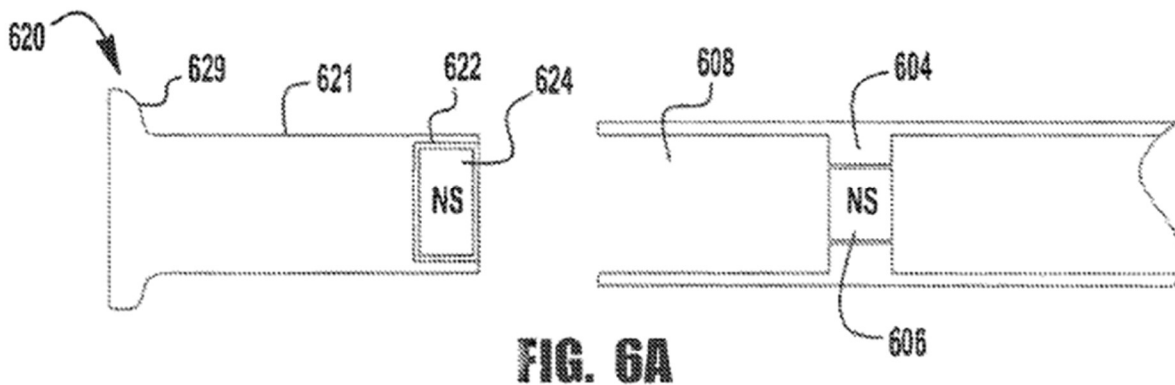


Thus, the specification reasonably conveys to those skilled in the art that the inventor had possession of this element of the claimed invention – a massaging head

having a pocket to receive the quick release connector – as of the filing date. *See Ariad Pharms.*, 598 F.3d at 1351.

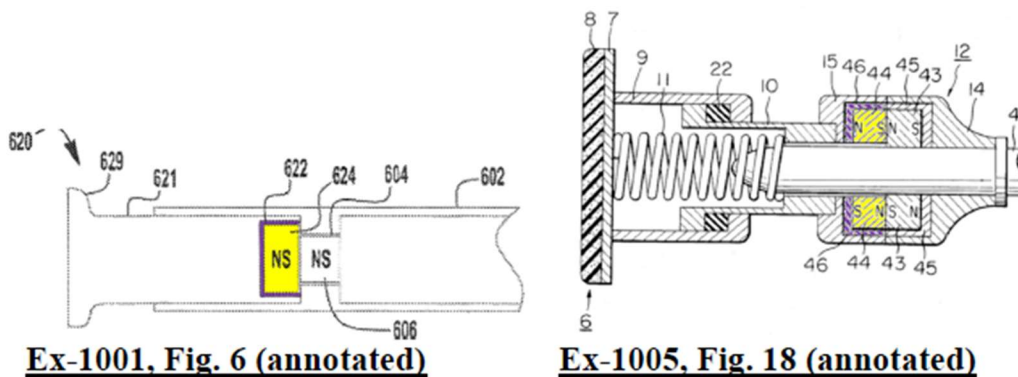
b) Ground 1B: The Specification Reasonably Conveys a “Substantially Cylindrical Pocket to Receive the Quick Release Connector”

The written description and accompanying figures reasonably convey, to a skilled artisan, a “substantially cylindrical pocket to receive the quick release connector.” As detailed above, the specification reasonably conveys a massaging head having a pocket to receive the quick release connector to a skilled artisan. In addition, the specification reasonably conveys to a skilled artisan that this pocket is substantially cylindrical. The written description notes that “Massaging head **620** includes a shaft **621** having a cylindrical pocket **622** at the distal end” (‘482 Patent at 6:63-64), as illustrated in cross-sectional view Figure 6A:



According to the Petitioner, for the same reason, the Mabuchi prior art reference discloses a substantially cylindrical pocket to receive the quick release connector:

Furthermore, to the extent Patent Owner contends that the '482 Patent's disclosure of cylindrical pocket 622 holding magnet 624 at the distal end of shaft 621 is a "substantially cylindrical pocket to receive the quick release connector," Mabuchi discloses the same arrangement. As shown in the annotated figures from the '482 Patent and Mabuchi below, Mabuchi similarly discloses a pocket (yoke core 46) holding magnet 44 in flange 15 of the pater assembly 6. Ex-1002 ¶118.



Petition at 41-42.

In addition, Petitioner admits that "a POSITA would recognize that the opening at the end face of the flange 15 [shown above in Figure 18] is a substantially cylindrical pocket configured to receive the substantially cylindrical actuator head." Petition at 41. The "substantially cylindrical" opening at the end face of flange 15 in Mabuchi is no different than the "substantially cylindrical" pocket disclosed in Figure 6 of the '482 Patent.

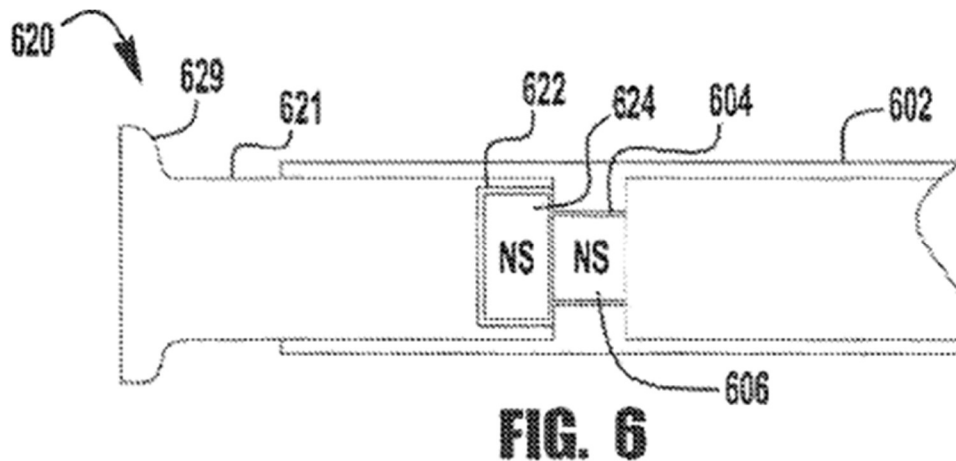
Claim 34 specifies that the massaging head is attachable while the piston reciprocates. A POSITA would understand that the pocket of the massaging head needs to be substantially cylindrical so that the massaging head could be attached

while the device is reciprocating, but it need not be perfectly cylindrical to achieve this. *See Indivior Inc., 930 F.3d at 1349* (“[t]he specification need not recite the claimed invention *in haec verba*” so long as the specification reasonably conveys the claimed feature to a skilled artisan).

Thus, the specification reasonably conveys to those skilled in the art that the inventor had possession of this element of the claimed invention – a substantially cylindrical pocket to receive the quick release connector – as of the filing date.

c) Ground 1C: The Specification Reasonably Conveys a “Quick Release Connector”

The written description and accompanying figures reasonably convey, to a skilled artisan, a “quick release connector” that “is configured to secure a first massaging head while the piston reciprocates a predetermined stroke length at the first speed.” In fact, the specification explicitly describes and illustrates one embodiment of the quick release connector, in which magnets assist in securing the connection:



FIGS. 6 and 6A illustrate an exemplary embodiment of a quick-connect system 600 for connecting a massaging head 620 to a piston 602. When providing a deep tissue massage using a massaging device, such as, for example, massaging device 100, it may be desirable to switch massaging heads to work on different muscles or different portions of muscles during the massage. The exemplary quick-connect system 600 allows a user to quickly switch massaging heads 620. Moreover, the exemplary quick-connect system 600 may be used without turning off the massaging device 100.

Quick-connect system 600 includes a piston 602 that has a hollow-end bore 608 for receiving the shaft 621 of a massaging head 620. Located within the bore 608 of piston 602 is a cylindrical seat 604. Cylindrical seat 604 retains a magnet 606. Magnet 606 is illustrated with its north pole located flush with the seat and facing toward the opening in bore 608. Massaging head 620 includes a shaft 621 having a cylindrical pocket 622 at the distal end. Located within the cylindrical pocket 622 is a magnet 624. Magnet 624 is positioned so that its south pole is

located at the distal end of shaft 621. Accordingly, when the shaft 621 of massaging head 620 is slid into opening in bore 608, the magnets 606 and 624 are attracted to one another and magnetically hold massaging head 620 firmly in place.

See Ex. 1001 at 6:57 – 7:3, Fig. 6.

Petitioner contends that this disclosure “fails to provide sufficient written description to support the challenged claims’ broad functional language claiming any ‘quick release connector’ that ‘is configured to secure a first massaging head while the piston reciprocates a predetermined stroke length at the first speed.’” Petition at 25. But this is an issue pertaining to claim construction regarding the scope of the “quick release connector” limitation, not a Section 112 issue.

Petitioner cites *Forte Biosciences, Inc. v. Univ. of Mass.*, 2024 WL 3104512 (PTAB June 24, 2024) and states that “the Panel found unpatentable challenged claims that were ‘directed broadly’ to a method of treatment with ‘a functional description’ of a compound, where the specification “only provide[d] a single working example a compound that meets these functional requirements.”” Petition at 24-24. *Forte* is inapposite, as the term “quick-release connector” is not a functional description, but rather a known term of art. *Forte* and *Ariad* both relate to pharmaceutical compounds that accomplish a certain function, whereas a simple quick-release connector would be known to a POSITA to include a number of

different mechanical configurations. *See Boston Scientific Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1366 (Fed. Cir. 2011) (Because specification is viewed from perspective of one of skill, a patentee may rely on information that is “well-known in the art” for purposes of meeting written description requirement); *see also Capon*, 418 F.3d at 1359 (“It is not necessary that every permutation within a generally operable invention be effective in order for an inventor to obtain a generic claim, provided that the effect is sufficiently demonstrated to characterize a generic invention.”).

Thus, the specification reasonably conveys to those skilled in the art that the inventor had possession of this element of the claimed invention – a quick release connector – as of the filing date. The claims are not unpatentable under Section 112(a).

2. Ground 2: – Petitioner Fails to Establish that Claims 34-38, 40, 41, 43-46 and 58-60 are Unpatentable Under 35 U.S.C. § 112(a) Because the Claimed “Substantially Cylindrical Pocket to Receive the Quick Release Connector” Is Indefinite

A patent is indefinite only “if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901, 134 S.Ct. 2120, 189 L.Ed.2d 37 (2014); *see also* 35 U.S.C. § 112(b) (the specification must “conclude with one or more

claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”). The indefiniteness standard “mandates clarity, while recognizing that absolute precision is unattainable.” *Nautilus*, 572 U.S. at 901. Words of degree like “substantially” are not “inherently indefinite,” but “the court must determine whether the patent provides some standard for measuring that degree.” *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374, 1378 (Fed. Cir. 2015) (internal quotation marks omitted).

In *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1288 (Fed. Cir. 2023), the Federal Circuit held that the “substantially...” language italicized below did not render the limitation indefinite:

a first back control and a second back control, each back control being located on the back of the controller and each back control including an elongate member that *extends substantially the full distance between the top edge and the bottom edge* and is inherently resilient and flexible

The accused product – a handheld controller for a game console, is shown below:



The Federal Circuit agreed with the district court’s holding that the claim term was not indefinite, based on the purpose of the claimed structure: “[w]ith respect to the rear controls, the word ‘substantially’ is reasonably precise, given that the purpose of the elongate shape is to allow ‘a user to engage the paddles with any of the middle, ring, or little finger.’” *Ironburg Inventions*, 64 F.4th at 1288.

Similarly, in *Grace Instrument Indus., LLC v. Chandler Instruments Co.*, 57 F.4th 1001, 1009 (Fed. Cir. 2023), the Federal Circuit concluded that the term “enlarged chamber” was not indefinite: “in the context of this patent, ‘enlarged chamber’ does not require that chamber to be larger than some baseline object; rather it must be large enough to accomplish a particular function.” As stated by the *Ironburg* court:

The indefiniteness challenge in *Grace* was unsuccessful because a person of ordinary skill in the art would know when a chamber is large enough to accomplish the function identified in the patent. Likewise, here, a person of ordinary skill in the art would know that an elongate member extends substantially the full distance between the top and bottom edge of a controller when the elongate member is long enough for different-sized hands to engage with the member using a middle, ring, or little finger.

Ironburg Inventions, 64 F.4th at 1288. Likewise, with respect to the ‘482 Patent, a person of ordinary skill in the art would know when the pocket in a massaging head

is substantially cylindrical enough – *i.e.*, sufficiently cylindrical – to accomplish the function identified in the patent: receiving the quick release connector while the piston reciprocates.⁸ In other words, the pocket of the massaging head needs to be sufficiently cylindrical to enable the massaging head to be attached while the massage device’s piston is reciprocating. If the massaging head can be attached while the massage device’s piston is reciprocating, the pocket is substantially cylindrical. Thus, the term “substantially cylindrical pocket to receive the quick release connector” is not indefinite.

3. Ground 3: Petitioner Fails to Establish that Mabuchi Renders Claims 34, 35 and 58-60 Obvious

At least the following recitations of independent Claim 34 and Dependent Claims 35 and 58-60 of the ‘482 Patent are either missing from, or not obvious in light of, the asserted single prior art reference, Mabuchi (Ex. 1005), in Ground 3. Thus, the Petition fails to meet its burden under Ground 3.

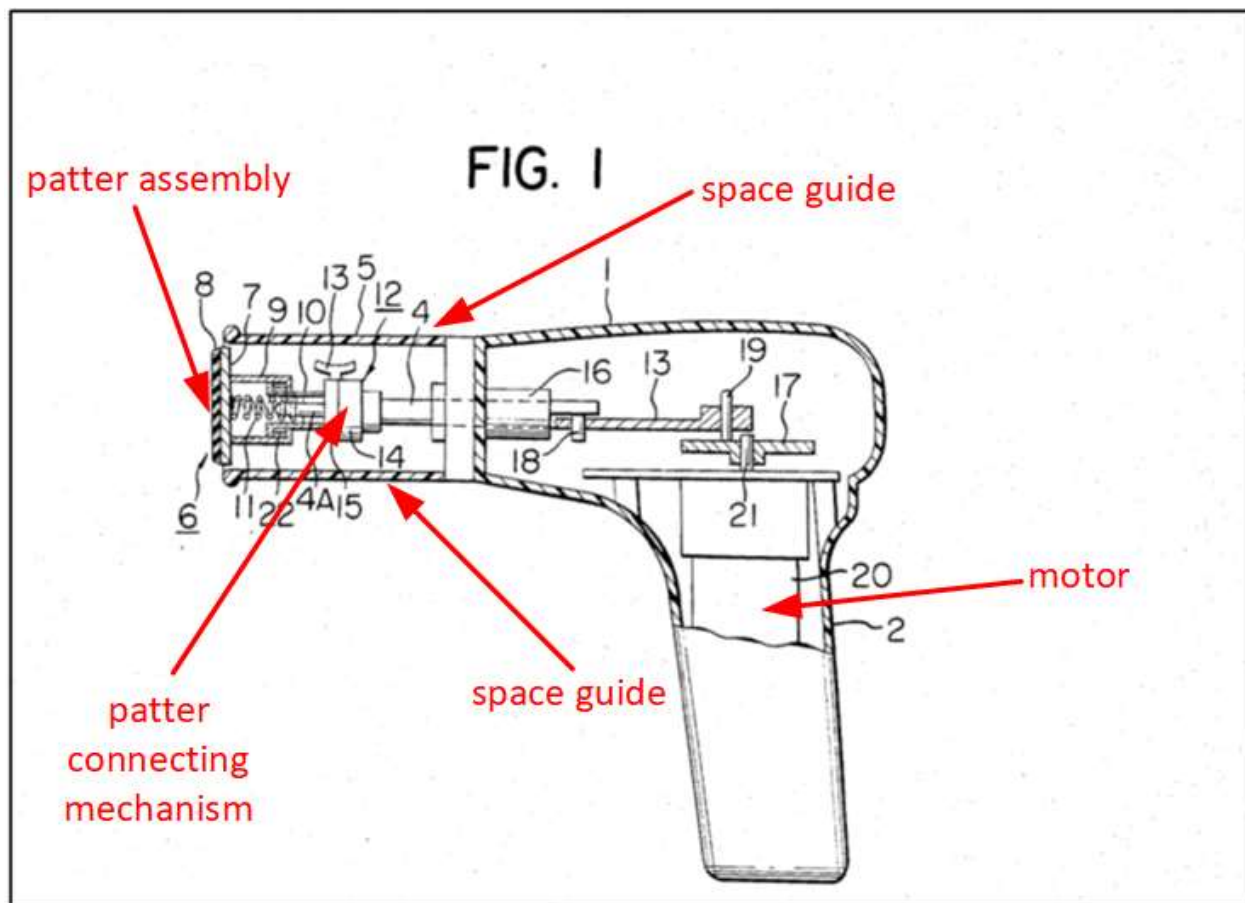
- a) Claim 34, Recitation 34[e]: “a quick release connector at the distal end of the piston, wherein the quick release connector is configured to secure a first massaging head while the piston reciprocates a predetermined stroke length at the first speed, wherein the first massaging head has a substantially**

⁸ Similarly, in the parallel district court proceeding, Therabody asserts the following proposed claim construction for “a substantially cylindrical pocket to receive the quick release connector”: “the pocket is sufficiently cylindrical such that it can receive the quick release connector without the need for rotational alignment.”

cylindrical pocket to receive the quick release connector.”

Mabuchi does not disclose, teach, or suggest at least the recitation of Claim 34[e] of “a quick release connector . . . wherein the quick release connector is configured to secure a first massaging head while the piston reciprocates a predetermined stroke length at the first speed. . . .” The Petition incorrectly relies on portions of the teachings of Mabuchi in a manner that would require a substantial reconstruction and redesign, which would alter the fundamental principles of operation of the disclosed beauty treatment device.

The teachings of Mabuchi are specifically directed toward a “beauty treatment device” including “a padder, or padder assembly removably fitted to the actuator, a space guide fitted to the device body to control the reciprocating motion of the padder assembly, and a resilient member fitted to either or both of the padder assembly and the actuator.” Ex. 1005 at Abstract. Figure 1 of the ‘737 Patent illustrates the fully assembled version of the disclosed beauty device.



Of particular relevance, Mabuchi discloses the essential, required function of the “space guide 5.” *See* Ex. 1005 at 1:6-11; 4:6-16. More specifically, Mabuchi teaches that the space guide 5 fully encompasses the pater assembly 6 in all embodiments and is required for operation of the disclosed beauty treatment device.⁹ The edge of the space guide 5 contacts a user’s face to maintain contact, via a constant exerted force, with the skin so that the pater assembly 6 can continue to pat

⁹ Mabuchi specifically refers to the space guide 5 as “the invention,” which reinforces that the space guide is essential to the operation of all embodiments disclosed in Mabuchi.

the user's skin at a constant rate and to engage the resilient member 11. The constant contact of the space guide 5 is fundamental to the operation of the disclosed "beauty treatment device."

In the invention, the space guide 5 plays a role of maintaining the distance between the device body 1 and the skin surface constant. In the absence of the space guide 5, the patting intensity of the padder assembly 6 would become unstable due to the variability of the distance with service conditions. In other words, it would become difficult for the padder assembly 6 to pat the skin surface at a constant rate. In some cases, the absence of the space guide 5 would cause both the plate member 7 and the cushion member 8 to be kept in contact with the skin surface at all times to exert a pushing force onto the skin surface, rather than patting the skin.

Ex. 1005 at 5:38-51; *See also id.* at 4:12-18.

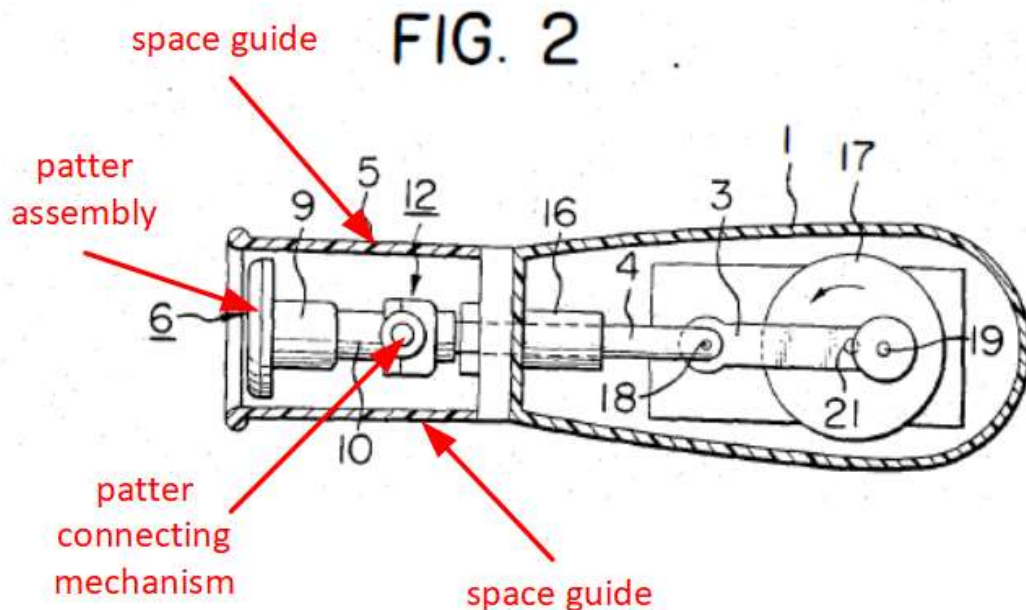
The teachings of Mabuchi disclose that it may be possible to substitute or change the shape of the padder assembly 6 such that the padder be characterized as "interchangeable." *See* Ex. 1005 at 5:52-64. Mabuchi further teaches that such interchangeability is achieved by way of releasable connection mechanism(s) between the padder assembly 6 and the actuator 4. In addition, Mabuchi teaches that

“the patter assembly 6 must be securely connected to the actuator 4 to prevent unwanted disengagement.” Ex. 1005 at 5:60-64.

Mabuchi discloses variations of connection mechanisms with regard to Figures 8-20. Ex. 1005 at 5:65-67. All of the illustrations in Figures 8-20 are simplified drawing figures in which critical components of the beauty treatment device are not illustrated including the space guide 5. As indicated in the Brief Description of the Drawings (with regard to the second image of all the disclosed embodiments), the views in Figures 8-20 are simplified for the purpose of “explaining the method of fitting and removing the patter connecting mechanism.” See Ex. 1005 at 1:65-67; 2:1-26.

The Petition relies on a disclosure of one specific embodiment of a connection mechanism 12, illustrated in Figures 18-19, in which magnetic forces may be utilized to releasably secure the patter assembly 6 to the actuator mechanism 4. The Petition cites solely to the simplified disclosure in Figure 19 and in a conclusory manner indicates “Mabuchi teaches that this design prevents the patter assembly 6 from unintentionally separating from the actuator 4 during use, yet allows a user to quickly remove and replace patter assembly 6.” Petition at 38. Notably, the Petition does not identify any specific teaching in Mabuchi that states that the “design” enables “a user to quickly remove and replace patter assembly.” No such teaching exists.

In accordance with the teachings of Mabuchi, the space guide 5 fully encompasses the connection mechanism 12 (regardless of form or variation) and therefore must be fully removed in order for a user to access the connection mechanism. *See* Ex. 1005 at Figure 2 and 2:53-67.



Petitioner has not met the burden of explaining how Mabuchi teaches or suggests “a quick release connector . . . wherein the quick release connector is configured to secure a first massaging head while the piston reciprocates a predetermined stroke length at the first speed. . . .” The Petition has, at best, selectively and inappropriately taken the teachings of Mabuchi out of context of the full teachings of the reference. Specifically, the Petition has ignored that all the embodiments of the connection mechanisms 12 cannot operate outside of being fully encompassed within the space guide 5 and would not be suitable for securing the

patter assembly during operation of the beauty treatment device. Such a line of argument, as suggested in the Petition, would require a substantial reconstruction and redesign of the beauty treatment device disclosed in Mabuchi and cannot support a prima facie case of obviousness. *See In re Ratti*, 270 F.2d 810, 813 (CCPA 1959) (“This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principles under which the [primary reference] construction was designed to operate.”).

The Petition with regard to Ground 3 has failed to meet the required burden. The prosecution history of the ‘728 Patent is clear that a line of reasoning in which a connection mechanism requires some form of physical manipulation (*e.g.*, thread and screw connection mechanisms, removing a housing, etc.) does not meet the burden of establishing a prima facie case of obviousness.

b) Dependent Claims 35 and 58-60

With regard to dependent Claims 35 and 58-60, the Petition does not attempt to acknowledge or correct the deficiencies associated with the teachings of Mabuchi with regard to the analysis of independent Claim 34. Accordingly, for the same reasons discussed above in connection with independent Claim 34, the Petition fails to meet its burden under Ground 3.

4. Ground 4: Petitioner Fails to Establish that Mabuchi in view of Harris Renders Claims 36-38, 40-41 and 43-46 Obvious

With regard to dependent Claims 36-38, 40-41 and 43-46, the Petition attempts to combine the teachings of Harris (considered and distinguished fully during prosecution) with the teachings of Mabuchi. Accordingly, the deficiencies and failure to establish a prima facie case of obviousness with regard to Ground 3 carry over with regard to Petitioner's arguments in Ground 4. Moreover, the Petition does not attempt to acknowledge or correct the deficiencies associated with the teachings of Mabuchi based on the teachings of Harris.

A POSITA would not find the necessary motivation to combine the teachings of Harris and Mabuchi. *See InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1351-52 (Fed. Cir. 2014); *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012). “[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (emphasis in original) (citation omitted). Harris is directed to a therapeutic massaging device for addressing deep muscle stimulation. *See Ex. 1006 at 1:5-12*. Mabuchi is directed to a beauty apparatus in which the skin is gently stimulated, namely, to repeatedly pat “the skin by causing a patter or patter assembly to hit the skin at a given rate to impact the

skin surface.” Ex. 1005 at 1:10-20. Additionally, Mabuchi expressly identifies that there are different categories of massaging devices based on intended outcomes, *e.g.*, a pattering of the skin surface vs. kneading of the user. *See* Ex. 1005 at 1:20-30. The forces exerted by each device would inherently be different.

The Petition appears to support combining the teachings of Harris with Mabuchi based on the common disclosure of a “percussive treatment device.” *See* Petition at 47. But the Petition does not attempt to address the multitude of significant modifications that would be required for such references to be properly combined in order to be integrated in the manner suggested by the Petition. Merely arguing, as is done in the Petition, that a POSITA *could* adapt a piece of prior art (even if incorrect) to perform a recited function is inadequate to show that a POSITA *would* actually do so. *See InTouch*, 751 F.3d at 1351-52; *see also In re Gianelli*, 739 F.3d 1375, 1379 (Fed. Cir. 2014) (“Physical capability alone does not render obvious that which contraindicated.”). Moreover, just because cited art “could” be combined, does not mean a POSITA ***would have been motivated*** to combine cited art features. As such, the Petition further fails to meet the burden with regard to Ground 4. *See Belden*, 805 F.3d at 1073.

5. Ground 5: Petitioner Fails to Establish that Mabuchi in view of Harris, and Further in View of Pivaroff Render Claims 37 and 38 Obvious

With regard to dependent Claims 37-38, the Petition attempts combine the teachings of Harris and Pivaroff (considered and distinguished fully during prosecution) with the teachings of Mabuchi in Ground 3. Accordingly, the deficiencies with regard to Ground 3 carry over with regard to Petitioner's arguments in Ground 5. The Petition does not attempt to remedy the deficiencies of Mabuchi based on the teachings of Harris or Pivaroff.

The Petition does not even attempt to argue that Mabuchi or Harris disclose a percussive device that operates at two speeds, each of which are less than or equal to 3600 strokes per minute. Nothing in Mabuchi or Harris would render these claims obvious.

Additionally, as discussed with regard to Ground 4, the teachings of Harris and Mabuchi are not appropriately combinable. Moreover, just because cited art "could" be combined, does not mean a POSITA *would have been* motivated to combine cited art features. *See InTouch*, 751 F.3d at 1351-52; *Belden*, 805 F.3d at 1073.

6. Ground 6: Petitioner Fails to Establish that Pivaroff in view of Mabuchi Renders Claims 34, 35 and 58-60 Obvious

With regard to independent Claim 34, the Petition attempts to combine the teachings of Pivaroff (considered and distinguished fully during prosecution) with a repeat of the analysis of the teachings of Mabuchi in Ground 3. The Petition does not attempt to correct the deficiencies associated with the teachings of Mabuchi based on Pivaroff. Rather, it appears that Ground 6 is simply a repeat of the arguments overcome in prosecution (Pivaroff in view of Rhoades as identified above) by the substitution of a reference (Mabuchi) with the same fundamental limitations and even further technical deficiencies.

Moreover, the teachings of Pivaroff and Mabuchi are not appropriately combinable. Just as with Grounds 4 and 5, a POSITA would not find the necessary motivation to combine the teachings of Pivaroff and Mabuchi. In addition, as with the prior grounds, the Petition does not address the multitude of significant modifications that would be required for such two references to be properly combined in order to be integrated in the manner suggested by the Petition. Moreover, just because cited art “could” be combined, does not mean a POSITA **would have been** motivated to combine cited art features. *See InTouch*, 751 F.3d at 1351-52; *Belden*, 805 F.3d at 1073.

As previously described, a POSITA with an appropriate understanding of the teachings of Mabuchi would understand that the removable and interchangeable aspect of a padder assembly 6 requires complete removal of the space guide 5 and its reattachment prior to operation of the disclosed beauty treatment device. The Petition does not cite (and Mabuchi does not teach) anything in regard to an ability to manipulate any embodiment of the connection mechanism 12 (including the embodiment in Figures 18-19) while the beauty treatment device is in operation.

The treatment device in Pivaroff includes a hollow head 44 and a hollow body 46, and the hollow body includes grains of precious gems or metals that are part of the therapeutic process. *See* Ex. 1007 at 2:55-67. The Petition fails to address in any manner how the connection mechanism 12 in Mabuchi would be incorporated into the hollow body massaging heads taught in Pivaroff without substantial degradation of either the therapeutic muscle treatment function disclosed in Pivaroff or the intentional soft padder beauty treatment disclosed in Mabuchi. Rather, the Petition incorrectly suggests that “a POSITA would have understood that their teachings [Mabuchi and Pivaroff] could be combined with little to no change in their respective function.” Petition at 58.

Merely arguing, as is done in the Petition, that a POSITA *could* adapt a piece of prior art (even if incorrect) to perform a recited function is inadequate to show that a POSITA *would* actually do so. *See In re Gianelli*, 739 F.3d at 1379. Moreover,

to modify both the Mabuchi and Pivaroff teachings to reduce or eliminate the individual benefit provided by either reference (respectively, a beauty treatment device (Mabuchi) and a deep muscle stimulator device (Pivaroff) teaches away from any such combination. *See Depuy v. Medtronic Sofamor Danek*, 567 F.3d 1314 (Fed Cir. 2009).

7. Ground 7: Petitioner Fails to Establish that Pivaroff in view of Mabuchi, further in view of Harris Renders Claims 36-38, 40-41 and 43-46 Obvious

With regard to dependent Claims 36-38, 40-41 and 43-46, the Petition attempts to combine the teachings of Harris (considered and distinguished fully during prosecution) with Pivaroff in combination with Mabuchi as discussed in Ground 6. Accordingly, the deficiencies and failure to establish a prima facie case of obviousness with regard to Ground 6 carries over with regard to Petitioner's arguments in Ground 7. Again, just because cited art "could" be combined, does not mean a POSITA *would have been* motivated to combine cited art features. *See InTouch*, 751 F.3d at 1351-52.

C. The Board Should Deny Institution Pursuant to Fintiv

Under the precedential guidance set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated precedential May 5, 2020), the Board considers the following factors in determining whether to institute an AIA post-grant proceeding where there is parallel district litigation:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding; and
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and other circumstances that impact the Board's exercise of discretion, including the merits.

The Board should exercise its discretion and deny institution of this Post Grant Review based on the *Fintiv* factors.

First, Therabody did not seek a stay in the underlying district court action. The Court has not granted a stay, and no evidence exists that a stay may be granted if this PGR is instituted.

Second, the trial date in the district court action will likely occur very close in time to the Board's projected statutory deadline for a final written decision. Although the district court has not yet set a trial date, the claim construction hearing will occur on April 16, 2025. This Board will likely issue its determination regarding whether to institute the PGR in April 2025, and the projected statutory deadline for a final written decision would be April 2026. Patent Owner expects that Judge

Holcomb will set a trial date following the issuance of the claim construction ruling, and that the trial date will be early-to-mid 2026.

Third, the parties have already made a substantial investment in the district court litigation. Patent Owner initiated the district court litigation in February 2024. Since that time, the parties have engaged in extensive pleading practice, prepared and served infringement contentions and invalidity contentions, and served and responded to written discovery. In addition, the parties have complied with several claim construction deadlines, and opening and responsive claim construction briefs are due within the next three weeks.

Fourth, there is a substantial overlap between issues raised in the Petition and in the parallel district court proceeding. In its invalidity contentions, Therabody contends that the asserted claims of the '482 Patent are invalid for the same reasons asserted in its PGR Petition. In addition, in the joint claim construction statement in the parallel district court proceeding, Therabody contends that the “substantially cylindrical pocket to receive the quick release connector” limitation is indefinite and/or invalid for lack of written description support, just as Therabody does in its Petition.

Finally, the petitioner and the defendant in the parallel proceeding are the same party.

Accordingly, Patent Owner respectfully requests that the Board exercise its discretion and deny institution of this PGR based on *Fintiv*.

VIII. CONCLUSION

For the foregoing reasons, the Patent Owner respectfully requests that the Board deny institution.

Respectfully submitted,

Dated: January 30, 2025

/ Mauricio A. Uribe /
Mauricio A. Uribe (Reg No. 46206)
mauricio.uribe@knobbe.com
Knobbe, Martens, Olson & Bear LLP
925 Fourth Avenue Suite 2500
Seattle, WA 98104
Tel: 206-405-2000
Fax: 206-405-2001

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §§ 42.24(d), the undersigned certifies that this Patent Owner's Preliminary Response complies with the 18,700-word type-volume limitation because it contains 13,594 words after excluding the parts exempted according to the word count feature of Microsoft Word.

Dated: January 30, 2025

/ Mauricio A. Uribe /

Mauricio A. Uribe (Reg No. 46206)

mauricio.uribe@knobbe.com

Knobbe, Martens, Olson & Bear LLP

925 Fourth Avenue Suite 2500

Seattle, WA 98104

Tel: 206-405-2000

Fax: 206-405-2001

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that, a copy of the foregoing document **PATENT OWNER'S PRELIMINARY RESPONSE** with any attachments was served by electronic mail upon the following:

Marc J. Pensabene
O'Melveny & Myers LLP
1301 Avenue of the Americas, 17th Floor
New York, NY 10019
Email: mpensabene@omm.com

Brett J. Williamson
Cameron W. Westin
O'Melveny & Myers LLP
610 Newport Center Drive, 17th Floor
Newport Beach, CA 92660
Telephone: (949) 823-6900
Fax: (949) 823-6994
Email: bwilliamson@omm.com
Email: cwestin@omm.com

Dated: January 30, 2025

/Mauricio A. Uribe /
Mauricio A. Uribe (Reg No. 46206)
mauricio.uribe@knobbe.com
Knobbe, Martens, Olson & Bear LLP
925 Fourth Avenue Suite 2500
Seattle, WA 98104
Tel: 206-405-2000
Fax: 206-405-2001