UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

HYPER ICE, INC., a California corporation and HYPERICE IP SUBCO, LLC, a Delaware limited liability company, Plaintiffs, v. THERABODY, INC., Defendant.	Case No. 8:24-cv-00390-JWH-(DFMx)

DEFENDANT THERABODY, INC.'S DISCLOSURE OF INVALIDITY CONTENTIONS

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I. Introduction

Defendant Therabody, Inc. ("Therabody" or "Defendant") makes the following Patent Local Rule 3-3 Disclosure of Invalidity Contentions to Plaintiffs Hyper Ice, Inc. and Hyperice IP Subco, LLC (collectively "Hyperice" or "Plaintiff") for Case No. 8:24-cv-00390-JWH.

Plaintiff has asserted U.S. Patent Nos. 11,857,482 ("the '482 Patent") and 11,938,082 ("the '082 Patent") (collectively, "the Asserted Patents" or "the Patents-in-Suit") against Defendant. First Amended Complaint (C.D. Cal. 8:24-cv-00390, Dkt. 37). In Plaintiff's Patent Local Rule 3-1 and 3-2 Disclosure of Asserted Claims and Infringement Contentions served on July 5, 2024 and Supplemental Disclosure of Asserted Claims and Infringement Contentions served on September 6, 2024 (collectively, "Infringement Contentions"), Plaintiff has asserted the following claims against Defendants:

- Claims 34-38, 40, 41, 43-46, and 58-60 of the '482 Patent
- Claims 1-4, 7, 9-11, and 13 of the '082 Patent

Defendant's Invalidity Contentions address only those claims asserted in Plaintiff's Infringement Contentions. Defendant submits these Invalidity Contentions without waiving any argument about the sufficiency or substance of Plaintiff's Infringement Contentions.

Based on its investigation to date, Defendant hereby: (a) identifies each item of prior art that anticipates each asserted claim or renders it obvious; (b) specifies whether each such item of prior art anticipates each asserted claim and/or renders it obvious and, if a combination of items of prior art makes a claim obvious, identify each such combination and the motivation to combine such items; (c) submits a chart identifying where specifically in each item of prior art each element of each asserted claim is found, including for each element that is governed by 35 U.S.C. § 112(f), the identity of the structure(s), act(s), or material(s) in each item of prior art that

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performs the claimed function; and (d) identifies any grounds of invalidity of the asserted claims based on indefiniteness, lack of enablement, or lack of written description under 35 U.S.C. § 112(a).

In addition, pursuant to Patent Local Rule 3-4, and based on its investigation to date, Defendant has produced or is producing documents concurrently with these Invalidity Contentions.

II. Reservations

Defendant reserves the right to amend these Invalidity Contentions. The information and documents that Defendant produces are based on information available to date and are subject to further revision.

The information and documents that Defendant produces are based on Defendant's present understanding of Plaintiff's infringement theories as advanced by Plaintiff in its Infringement Contentions. If Plaintiff attempts or is permitted to amend its contentions, or provides additional information regarding its infringement theories, doing so may lead to further grounds for invalidity, and thus Defendant specifically reserves the right to amend or supplement its Invalidity Contentions.

Further, because discovery (including third party discovery) is at an early stage, Defendant reserves the right to amend or supplement these Invalidity Contentions. For example, Defendant herein identifies prior art products manufactured by third parties who are believed to have knowledge, documentation, and/or corroborating evidence relating to invalidity and/or prior art. It is, therefore, likely that Defendant will discover additional prior art or additional information relating to known prior art, and Defendant reserves the right to supplement these contentions after becoming aware of additional prior art or information. Defendant further reserves the right to introduce and use such supplemental materials at trial.

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Defendant's claim charts in Exhibits A-B cite particular teachings and disclosures of the prior art as applied to limitations of the asserted claims. However, persons having ordinary skill in the art may view an item of prior art generally in the context of other publications, literature, products, and understanding. Accordingly, the cited portions are only exemplary, and Defendant reserves the right to rely on uncited portions of the prior art references and on other publications and expert testimony as aids in understanding and interpreting the cited portions, as providing context thereto, and as additional evidence that a claim limitation is known or disclosed. Defendant reserves the right to establish what was known to a person having ordinary skill in the art through other publications, products, and/or testimony. Defendant also reserves the right to rely on uncited portions of the prior art references, other publications, and testimony to establish that a person of skill in the art would have been motivated to combine certain of the cited references so as to render the claims obvious. Citations to figures are inclusive of all discussion of those figures.

Defendant further intends to rely on inventor admissions concerning the scope of the asserted claims or of the prior art relevant to the asserted claims found in, *inter alia*, the patent prosecution history and/or reexamination history for the Asserted Patents and related patents and/or patent applications; any deposition testimony of a named inventor of the Asserted Patents; and the papers filed and any evidence submitted by Plaintiff in conjunction with this litigation. Defendant reserves the right to contend that the asserted claims are invalid for failure to name the correct inventor(s), and/or to contend that Plaintiff lacks standing to bring this litigation with respect to such patents.

Furthermore, nothing stated herein shall be treated as an admission or suggestion that Defendant agrees with Plaintiff regarding the scope of any asserted claim or the claim

constructions in its Infringement Contentions. To the extent that Defendant's Invalidity Contentions reflect claim constructions consistent with or suggested by Plaintiff's Infringement Contentions, no inference is intended nor should any be drawn that Defendant agrees with Plaintiff's claim constructions. By applying any of Plaintiff's apparent claim constructions and interpretations, Defendant does not concede in any way that those constructions and interpretations are correct, but rather asserts the fundamental principle that whatever infringes a claim if later in time anticipates if earlier in time. Defendant expressly reserves the right to propose alternative constructions to those that have been or may be advocated by Plaintiff.

Nor shall anything in these Invalidity Contentions be treated as an admission that Defendant's accused products meet any limitation of any asserted claim. Defendant denies that it infringes any claim of the Asserted Patents. To the extent that any prior art contains a claim element that is the same as or similar to an accused product, inclusion of that prior art in Defendant's Invalidity Contentions shall not be deemed a waiver by Defendant of any claim construction or non-infringement position. Defendant expressly reserves the right to contest any claim construction asserted by Plaintiff and expressly reserve all non-infringement arguments.

In its Infringement Contentions, Plaintiff contends that the asserted claims of the Asserted Patents are entitled to a priority date of July 1, 2013. Defendant reserves the right to challenge Plaintiff's alleged priority dates or any alleged dates of conception or reduction to practice. Defendant further reserves the right to seek discovery regarding conception and reduction to practice, as appropriate, and to demonstrate public use and/or the on-sale bar under 35 U.S.C. § 102(b), and/or applicants' failure to comply with 35 U.S.C. § 112. In addition, Defendant relies on Plaintiff's alleged priority date in forming these Invalidity Contentions, and to the extent

Plaintiff later argues, or it is determined that, any different priority date applies, Defendant reserves the right to amend these contentions accordingly.

III. U.S. Patent No. 11,857,482 ("the '482 Patent")

A. Identification of Prior Art

In addition to the prior art cited on the face of the '482 Patent and related patents, the admitted prior art in the specifications of the '482 Patent and related patents, the prior art cited in any file histories of the '482 Patent and related patents, the prior art cited in Post-Grant Review Petition PGR2024-00053, filed September 27, 2024 ("the '482 PGR Petition"), the prior art cited in any other reexaminations, *inter partes* review proceedings, reissue proceedings, or other examination or post-grant proceedings of the '482 Patent and related patents, and the prior art cited in any invalidity contentions or expert reports submitted in any action or proceedings involving the '482 Patent or related patents, Defendant identifies the following prior art that anticipates each asserted claim or renders it obvious.

1. Prior Art Patents

The following patents and patent publications are prior art to the asserted claims under at least 35 U.S.C. § 102 and/or 35 U.S.C. § 103. The identification of any patent or patent publication shall be deemed to include any counterpart patent or application filed, published, or issued anywhere in the world.

Patent or Publication Number	Country of Origin	Filing Date	Date of Issue or Publication
U.S. Patent Application Pub. No. 2013/0261516A1 ("Cilea")	United States	March 30, 2013	October 3, 2013
U.S. Patent No. 6,228,042 ("Dungan")	United States	September 24, 1998	May 8, 2001
U.S. Patent Application Pub. No. 2010/0274162	United States	April 22, 2009	October 28, 2010

Patent or Publication Number	Country of Origin	Filing Date	Date of Issue or Publication
A1 (“Evans”)			
U.S. Patent No. 8,870,796 (“Hoffman”)	United States	April 5, 2010	October 28, 2014
U.S. Patent No. 5,803,916 (“Kuznets”)	United States	March 19, 1996	September 8, 1998
U.S. Patent Application Pub. No. 2003/0009116 A1 (“Luettgen”)	United States	May 8, 2002	January 9, 2003
U.S. Patent No. 5,134,777 (“Meyer”)	United States	December 5, 1991	August 4, 1992
U.S. Patent No. 7,503,923 (“Miller ’923”)	United States	November 21, 2003	March 17, 2009
U.S. Patent Application Pub. No. 2003/0195443 (“Miller”)	United States	April 12, 2002	October 16, 2003
U.S. Patent No. 6,537,236 (“Tucek”)	United States	December 26, 2000	March 25, 2003
Taiwan Patent Application Pub. No. TWM343481U (“Wang”)	Taiwan	May 5, 2008	November 1, 2011
U.S. Patent No. 4,513,737 (“Mabuchi”)	United States	December 22, 1980	April 30, 1985
U.S. Patent Application Pub. No. 2007/0150004 (“Colloca”)	United States	December 5, 2006	June 27, 2007
U.S. Patent Application Pub. No. 2013/0138023A1 (“Lerro”)	United States	April 12, 2002	October 16, 2003
U.S. Patent No. 6,682,496 (“Pivaroff”)	United States	December 28, 1999	January 27, 2004
U.S. Patent No. 3,994,290 (“Springer”)	United States	September 29, 1975	November 30, 1976
WO Publication No. 2010086513A1 (“Gueret”)	International	January 27, 2009	August 5, 2010
JP Patent No. H0686736U (“JP ’736”)	Japan	May 26, 1993	December 20, 1994
WO Publication No. 2010086513A1 (“Legrain”)	International	October 24, 2003	May 13, 2004

Patent or Publication Number	Country of Origin	Filing Date	Date of Issue or Publication
U.S. Patent No. 3,696,693 ("Bosten")	United States	November 18, 1969	October 10, 1972
U.S. Patent No. 6,432,072 ("Harris")	United States	January 21, 2000	August 13, 2002
U.S. Patent No. 1,339,179 ("Elmen")	United States	June 14, 1918	May 4, 1920
U.S. Patent No. 4,730,605 ("Noble")	United States	July 14, 1986	March 15, 1988
U.S. Patent No. 5,215,051 ("Smith")	United States	October 19, 1992	June 1, 1993
U.S. Patent No. 5,103,809 ("DeLuca")	United States	December 5, 1990	April 14, 1992
U.S. Patent No. 3,172,675 ("Gonzalez")	United States	February 19, 1963	March 9, 1965
U.S. Patent No. 7,641,476 ("Didur")	United States	June 23, 2006	January 5, 2010
U.S. Patent No. 7,435,042 ("White")	United States	May 10, 2006	October 14, 2008
U.S. Patent No. 8,631,532 ("Utsch")	United States	July 25, 2012	January 21, 2014
U.S. Patent No. 9,132,058 ("Imboden")	United States	January 9, 2008	September 15, 2015
U.S. Patent No. 6,911,013 ("Heimberger")	United States	August 20, 2002	June 28, 2005
U.S. Patent No. 5,140,979 ("Nakagawa")	United States	December 12, 1989	August 25, 1992
U.S. Patent Publication No. 20070244416A1 ("Sobin")	United States	April 14, 2006	October 18, 2007
KR101162978B1 ("Min")	Korea	February 9, 2012	July 9, 2012
CN201067499Y ("Chan")	China	June 13, 2007	June 4, 2008
CN201750912U ("Jinming")	China	July 19, 2010	February 23, 2011
CN2390610Y ("Lin")	China	June 3, 1999	August 9, 2000
CN2698333Y ("Zhou")	China	December 3, 2003	May 11, 2005
CN201894734U ("Shuishan")	China	August 13, 2010	July 13, 2011

Patent or Publication Number	Country of Origin	Filing Date	Date of Issue or Publication
TWM445439U ("Lo")	Taiwan	July 17, 2012	January 21, 2013
WO2013107898A1 ("Dauvister")	International	January 21, 2013	July 25, 2013
WO Publication No. 2012165833A2 ("Lee")	International	May 29, 2012	December 6, 2012
WO Publication No. 2014080103A2 ("Giraud")	International	October 17, 2013	May 30, 2014
U.S. Design Patent No. 649,657 ("Petersen")	United States	March 29, 2011	November 29, 2011

2. Prior Art Non-Patent Publications

The following non-patent publications are prior art to the asserted claims under at least 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

Title	Author/Publisher	Date of Publication
Instructables.com ("Instructables")	Rachel	August 28, 2007
Irestusa.com, SL-C28 ("iRest")	iRest USA	July 29, 2011
Brookstone's Active Sport Massager ("Brookstone")	Brookstone	May 21, 2012

3. Prior Art Systems

Defendant's investigation into publicly available prior art systems that teach and/or render obvious each element of any asserted claims is ongoing. Fact discovery is at an early stage, and Defendant may require discovery from third parties regarding publicly available prior art systems. Defendant reserves the right to amend its identification of prior art systems as Defendants become aware of the existence, functionality, and/or characteristics of prior art systems as a result of its investigation and forthcoming discovery. In addition to the prior art products, components, systems, and methods that may be identified as a result of discovery, Defendant also reserves the

right to rely on the documents and publications identified in the corresponding claim charts as prior art publications.

The following systems are prior art under 35 U.S.C. § 102:

- Products, components, systems, and methods invented, designed, developed, reduced to practice, and/or in public use or on sale related to the Young Sun YS-889 Model ("Young Sun"), as exemplified in claim charts in Exhibit A-01. Based on information available to Defendant, Defendant believes that this system was in public use or on sale at least by March 16, 2009, as evidenced by Taiwan's Bureau of Standards, Metrology and Inspection Registration No. CI538065000021, and the publication of Taiwanese Patent Application TWM343481U (*see* Exhibit A-12).

B. Primary References

Defendant contends that the primary prior art references identified below and described in the charts attached as Exhibits A-01 to A-20, by themselves, anticipate the asserted claims of the '482 Patent. To the extent that a primary reference is deemed not to anticipate a claim for failing to teach one or more limitations of that claim, Defendant contends that the claim would nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention in view of the prior art reference itself, as described in the attached charts. Defendant's prior art charts (attached as Exhibits A-01 thru A-20) set forth the particular claims that are anticipated under 35 U.S.C. § 102 and/or rendered obvious under 35 U.S.C. § 103 by each item of prior art and identify where specifically in each item of prior art, each element of each asserted claim is found.

Exhibit	Primary References
A-01	Young Sun YS-889 Model ("Young Sun")

Exhibit	Primary References
A-02	U.S. Patent Application Pub. No. 2013/0261516A1 (“Cilea”)
A-03	U.S. Patent No. 6,228,042 (“Dungan”)
A-04	U.S. Patent Application Pub. No. 2010/0274162 A1 (“Evans”)
A-05	U.S. Patent No. 8,870,796 (“Hoffman”)
A-06	U.S. Patent No. 5,803,916 (“Kuznets”)
A-07	U.S. Patent Application Pub. No. 2003/0009116 A1 (“Luettgen”)
A-08	U.S. Patent No. 5,134,777 (“Meyer”)
A-09	U.S. Patent No. 7,503,923 (“Miller ’923”)
A-10	U.S. Patent Application Pub. No. 2003/0195443 (“Miller”)
A-11	U.S. Patent No. 6,537,236 (“Tucek”)
A-12	Taiwan Patent Application Pub. No. TWM343481U (“Wang”)
A-13	U.S. Patent No. 4,513,737 (“Mabuchi”)
A-14	U.S. Patent Application Pub. No. 2007/0150004 (“Colloca”)
A-15	U.S. Patent Application Pub. No. 2013/0138023A1 (“Lerro”)
A-16	U.S. Patent No. 6,682,496 (“Pivaroff”)
A-17	U.S. Patent No. 3,994,290 (“Springer”)
A-18	WO Publication No. 2010086513A1 (“Gueret”)
A-19	JP Patent No. H0686736U (“JP ’736”)
A-20	WO Publication No. 2010086513A1 (“Legrain”)

C. Secondary References

Exhibit A-A lists secondary prior art references and identifies, on a limitation-by-limitation basis, where specifically each secondary reference teaches the limitations of the asserted claims. To the extent that a primary reference is deemed, by itself, not to anticipate or

render obvious a claim for failing to teach one or more limitations, the claim would nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention by the combination of the primary reference with one or more of the other primary references listed above and/or the references listed as disclosing those alleged missing limitations in Exhibit A-A.

D. Obvious Combinations

To the extent that a primary reference is deemed, by itself, not to anticipate or render obvious a claim for failing to teach one or more limitations, the claim would nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention by the combination of the primary reference with one or more other primary references and/or the knowledge of someone skilled in the art. For example, a person of ordinary skill in the art would have been motivated to combine any reference in Exhibits A-01 to A-20 with any other reference(s) in Exhibit A-01 to A-20. Such combinations would be achieved, for example, by merely combining the disclosures described in the respective claim charts for each reference.

Defendant also contends that any of the primary references (or combination of primary references) could be combined with any of the secondary references (or combination of secondary references) in Exhibit A-A to render obvious the asserted claims. Such combinations would be achieved by merely combining the disclosures described in the respective claim charts for each reference.

The obviousness combinations are provided in the alternative to Defendant's anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not itself anticipatory.

1. Exemplary Combinations

Below are examples of prior art references that would have been combined by one of ordinary skill in the art at the time of the alleged invention. These combinations are merely examples. The asserted claims of the '482 Patent are rendered obvious by:

- Young Sun alone or in combination with one or more of Wang, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Cilea alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller '923, Miller, Colloca, Springer, Gueret, JP '736, and Legrain, and any of the references in Exhibit A-A.
- Dungan alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Lerro, Cilea, and Evans, and any of the references in Exhibit A-A.
- Evans alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Hoffman alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Kuznets alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Luettgen alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Meyer alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller '923, Miller, Colloca, Springer, Gueret, JP '736, and Legrain, and any of the references in Exhibit A-A.

- Miller ’923 alone or in combination with one or more of Miller, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Miller alone or in combination with one or more of Miller ’923, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Tucek alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller ’923, Miller, Colloca, Springer, Gueret, JP ’736, and Legrain, and any of the references in Exhibit A-A.
- Wang alone or in combination with one or more of Young Sun, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Mabuchi alone or in combination with one or more of Wang, Pivaroff, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Colloca alone or in combination with one or more of Wang, Young Sun, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Lerro alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller ’923, Miller, Colloca, Springer, Gueret, JP ’736, and Legrain, and any of the references in Exhibit A-A.
- Pivaroff alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller ’923, Miller, Colloca, Springer, Gueret, JP ’736, and Legrain, and any of the references in Exhibit A-A.

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- Springer alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Gueret alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- JP ’736 alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.
- Legrain.alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit A-A.

2. Motivations to Combine

To the extent a finder of fact finds that a primary prior art reference does not disclose one or more limitations of an asserted claim, the asserted claim is nevertheless obvious because the alleged missing limitations contain nothing beyond ordinary improvements. In other words, the asserted claim combines known elements to achieve predictable results or chooses between clear alternatives known to those of skill in the art, particularly in view of the state of the art as reflected in the relevant prior art.

Moreover, as explained above, it would have been obvious to a person of skill in the art at the time of the alleged invention of the asserted claims to combine any primary reference with any combination of other primary references or secondary references so as to practice the asserted claims. To the extent that Plaintiff argues that any concept claimed in the asserted claims is not disclosed in a primary reference, it would, at a minimum, have been obvious to adapt the primary reference to include the concept or combine it with other primary references or secondary

references that disclose the concept. Each concept described and claimed in the Asserted Patents was known to those of skill in the art as available design choices for percussive massage devices.[1]

The Supreme Court has held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 416 (2007). "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one." *Id*. at 417. As the Supreme Court made clear, "[f]or the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id*.

To determine whether there is an apparent reason to combine the known elements in the fashion claimed by the patent at issue, a court can "look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art." *Id*. at 418. For example, obviousness can be demonstrated by showing "there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *Id*. at 420. "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id*. Common sense also teaches that "familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id*.

[1] Each concept described and claimed in the '482 Patent was known to those of skill in the art as available design choices for massage devices.

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However, the Supreme Court in *KSR* held that a claimed invention can be obvious even if there is no explicit teaching, suggestion, or motivation for combining the prior art to produce that invention. In summary, *KSR* holds that patents that are based on new combinations of elements or components already known in a technical field may be found to be obvious. *See, generally*, *KSR*, 550 U.S. 398. Specifically, the Court in *KSR* rejected a rigid application of the "teaching, suggestion, or motivation [to combine]" test. *Id*. at 418. "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim." *Id*. at 419. "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id*. at 420. A key inquiry is whether the "improvement is more than the predictable use of prior art elements according to their established functions." *Id*. at 417.

The rationale to combine or modify prior art references is significantly stronger when, as here, the references seek to solve the same problem, come from the same field, and correspond well to each other. *In re Inland Steel Co*., 265 F.3d 1354, 1362 (Fed. Cir. 2001). The Federal Circuit has held that two references may be combined as invalidating art under similar circumstances, namely "[the prior art] focus[es] on the same problem that the … patent addresses: enhancing the magnetic properties of … steel. Moreover, both [prior art references] come from the same field …. Finally, the solutions to the identified problems found in the two references correspond well." *Id*. at 1364 (concerning patents and prior art relating to improving the magnetic and electrical properties of steel).

In view of the Supreme Court's *KSR* decision, the PTO issued a set of Examination Guidelines. Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103 in

view of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc*., 72 Fed. Reg. 57526 (October 10, 2007). Those Guidelines summarized the *KSR* decision and identified various rationales for finding a claim obvious, including those based on other precedents. Those rationales include:

> (A) Combining prior art elements according to known methods to yield predictable results;
>
> (B) Simple substitution of one known element for another to obtain predictable results;
>
> (C) Use of known technique to improve similar devices (methods, or products) in the same way;
>
> (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
>
> (E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
>
> (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
>
> (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Id. at 57529. The above rationales likewise apply in rendering obvious the asserted claims of the Asserted Patents.

The references disclosed herein, alone or in combination, contain an explicit and/or implicit teaching or motivation to combine them due to the following: (1) the knowledge generally available to a person of ordinary skill in the art; (2) the prior art references as understood by a person of ordinary skill in the art; (3) the nature of the problem to be solved; (4) the fact that each prior art reference addresses similar problems; and (5) the knowledge of those skilled in the art that the disclosed elements had been or could be used together.

As an example of those reasons and motivations to combine the references, the primary

references identified in Section III.B, as well as secondary references in Exhibit A-A, generally relate to massage devices, and in particular to percussive massage devices and connectors for attachments to devices. *See* Ex. A-01 to A-20 and A-A. The references disclose similar components and techniques for applying percussive massage to a user. *Id.* The attached charts in Ex. A-01 to A-20 and A-A provide additional reasons and motivations to combine the charted references.

Additionally, the primary and secondary references listed above are analogous art. They are all directed to massage devices, and in particular to percussive massage devices and connectors for attachments to devices. *See, e.g.*, Young Sun (percussive massage device); Cilea at [0002] ("The present invention relates generally to a medical percussion device. More specifically, the present invention relates to a hand held percussion device for the purpose of addressing soft tissue (muscle, fascia, tendon, and ligaments) dysfunction and pain syndromes."); Dungan at 2:11 ("The present invention provides a chiropractic adjustment tool or tapper"); Evans at Abstract ("The technology described herein provides a handheld massager."); Hoffman at 33:45-49 ("As an option, vibrator 10 will also contain programming and controls to enable the selection of variable frequency response algorithms (or variations in vibration cadence). Such as in the Sharper Image Massager Model HF 757 incorporated herein by reference."); Kuznets at 5:14-17 ("The present invention is of a hand held, electrically operated body and joints massage device having changeable massage heads which can be used to provide selected stroking, rubbing and/or kneading massaging effects."); Luettgen at [0002] ("The present invention generally relates to hand-held massagers."); Miller '923 at 1:10-11 ("Even more particularly, it relates to an improved head assembly for a percussive therapeutic device."); Miller at [0001] ("The present invention involves the field of medical devices. More particularly, it involves the field of

percussive medical devices used as chiropractic adjustment tools used to move bones and relieve muscle spasms and stress."); Tucek at 1:10-13. ("The present invention generally relates to a chiropractic adjustor apparatus for use in a chiropractic treatment to apply vibratory energy or force to the human body."); Wang at Technical Field of the Utility Model (Certified Translation) ("The present invention relates to a massage tool for human physiotherapy, and more particularly to a low-resonance reciprocating motion mechanism."); Mabuchi at 1:6-12 ("This invention relates generally to a beauty treatment device, and more specifically to a beauty treatment device having a space guide that permits an actuator to repeatedly reciprocate and controls the motion of the actuator wherein a patter repeatedly pats a skin surface being treated at a given rate."); Colloca at [0001] ("Particularly, it involves the field of electromechanical manipulation/adjusting instruments used to apply controlled dynamic forces to the human body."); Lerro at [0001] ("The present invention relates to a device for massaging or treatment of the back and neck muscles of a patient, comprising a housing having a drive motor disposed therein, which indirectly generates an adjustable lift motion with a constant amplitude in the axial direction on a massaging finger, comprising a massaging body and a fixing pin for connection of the finger with a drive of the spine massage device."); Pivaroff at 1:6-9 ("This invention relates generally to medical devices, and, more particularly, to a deep muscle stimulator device to increase muscle metabolism, increase the lactic acid cycle and to relieve pain."); Springer at 2:5-8 ("It is an additional object of the instant invention to provide a new and improved massaging device wherein the massaging device utilizes revolving and rotating spheres . . . ."); Gueret at [0073] (Machine Translation) ("The tool can also be adapted to massage the scalp and feature curved flexible fingers with enlarged heads at their ends."); JP '736 at [0007] "In order to solve the above problem, the present invention provides a tapping attachment having a massage tool at its tip for tapping the skin

surface of the face etc…."); Legrain (Machine Translation) ("The present invention relates to a massage device of the type comprising means for driving in rotation, or capable of receiving this movement, to then transmit it to means transforming it into a repeated back-and-forth movement to actuate a striking member intended for contact with the skin.").

One of skill in the art would also have been motivated to combine the different publications and patents that were authored by employees of a given company or assigned to the same assignee and/or related to the same subject matter. Additionally, one of skill in the art would have been motivated to combine different references that were authored, developed, or invented by the same individual(s) related to the same subject matter. The common inventor/author/architect of the references demonstrate that they relate to continued work in a common field of effort and continued related developments in that field. One of skill in the art would, therefore, combine the references related to each individual. For example, a POSITA would have been motivated to combine Miller and Miller '923, based solely on the fact that they have overlapping inventors/authors. Additionally, based on the teachings of the references and/or the knowledge of one of ordinary skill, one of skill in the art would have been motivated to combine different references from the same company. For example, a POSITA would have been motivated to combine at least Young Sun and Wang, which constitute a patent and corresponding product. And, one of skill in the art would have been motivated to combine prior art systems or products with any related or applicable documentation or literature for that system, including for the reason that these materials are related.

In addition, below are additional motivations to combine prior art for particular claim limitations. The following discussion of specific claim limitations are merely examples and are not limiting.

For example, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach limitations 34[a] ("a housing") and/or 34[b] ("a piston in the housing having a proximal end and a distal end"), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses limitations 34[a] and/or 34[b] in Exhibits A-01 to A-20 or Exhibit A-A. For example, several prior art references, including at least Dungan, Evans, Hoffman, Kuznets, Miller '923, Lerro, Pivaroff, Springer, Gueret, and Legrain.

A person skilled in the art would have understood that a massage device having a housing and a piston was well understood, and would have been motivated to incorporate these features into massage devices. *See, e.g.*,. Dungan at Abstract ("A chiropractic adjustment tool or tapper comprises a housing, the housing having an open end; a striker assembly disposed within the housing and secured thereto; and a plunger device or plunger disposed externally to the housing and secured thereto, the plunger being in communication with the striker assembly through the open end in the housing."); Evans at [0006] ("The hand held massager includes a housing dimensioned for handheld grip by a user . . . ."); Hoffman at 33:11-15 ("The active end of the provided linear stepper motor is operatively linked with and drives the proximal 'non-active end' of shaft 16 (not shown within housing 14), which is thereafter projected through housing 14 (now shown), to enable contact with the selected attachment interface."); Kuznets at 5:28-32 ("The body massage device presented in FIG. 1, referred to herein as device 20, includes a shaft housing 22 engaging a main rotating shaft 24, shaft housing 22 being formed suitable to grip by a user and serves as a handle of device 20."); Miller '923 at 1:48-57 ("The present invention provides a chiropractic adjustment tool or tapper, which, generally, comprises a housing, with or without a handle and a motor or power source to drive an axially reciprocating rod. The reciprocating rod

is disposed perpendicularly or near perpendicularly to the handle. One end of reciprocating rod extends from the housing which has a spring pair assembly to permit the ready adjustment of impact force and axial travel of the reciprocating rod. The opposite end of the reciprocating rod has an attached impact head"); Lerro at [0033] ("The housing 2 comprises a first housing part 20, in which is mounted the motor 3 and at least a part of the reduction gear 4. In a second housing part 21 is finally arranged the guide unit 7."); Pivaroff at 3:33-38 ("The top hollow housing 16 of the device 10 of the present invention is preferably made from the same material as the elongated handle 14, and includes a removable top plate and a truncated, pyramid-shape extending portion 52 which surrounds and provides protection around the reciprocating rod 38."); Springer at 2:59-3:7 ("Referring now to FIGS. 2 and 3, in combination with FIG. 1, it is seen that the massage unit 12 has a stem 18 projecting therefrom, which is received in a bore 19 within the coupling element 13 of the drive unit 10. The massage unit is held into the drive unit as illustrated in FIG. 4. The stem 18 has a slot 20 formed in 65 one end, and a pair of projections 21 radially extending adjacent to the slot, so that the stem will frictionally engage the bore 19, and thereby hold the massage unit 12 mounted into the drive unit 10."); Gueret at [0257] (Machine Translation) ("In the example considered, the gripping member 12 defines a housing 20 for receiving a vibrating source 21 which carries a tool 25, for example a finishing tool for perfecting makeup applied using the applicator 2."); Legrain (Machine Translation) ("The massage device of the invention comprises a housing enclosing the various parts in relative motion with respect to each other capable of transforming the continuous rotational movement received from an electric motor into a striking movement of a tool which projects outside the housing."). Thus, a person of ordinary skill in the art would have been motivated to modify any of the primary references to include this feature. A person of ordinary skill in the art would also have had a

reasonable expectation of success. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

As another example, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach limitations 34[c], [d], and/or [e] ("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;"), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses these limitations in Exhibits A-01 to A-20 or Exhibit A-A. For example, several prior art references, including at least Cilea, Dungan, Evans, Kuznets, Miller '923, Miller, Tucek, Wang, Mabuchi, and Lerro, explicitly describe or disclose "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." *See, e.g.*,. Cilea at [0020] ("The hand held percussion device 100 provides a handle 101 containing a rechargeable battery stored therein, and trigger 102 for activating the hand held percussion device 100. When activated, an internal, electric battery powered motor actuates an external mechanical plunger 103 which operates in a linear motion range. The external mechanical plunger 103 and bottom guide surface 104 is placed against a patient's muscle, fascia, tendon, or ligament and is subjected to the repetitive mechanical plunger motion resulting in a deep massage. Various external mechanical plungers 103 of differing shapes, sizes, contours, textures and hardness may be used and it is possible that the external mechanical plungers 103 will be easily or readily changed. Additionally, the speed of the hand held percussion device 100 is controlled by the trigger 102 so that if more speed is desired, a user simply depresses the trigger 102 further.");

Dungan at 2:22-26 ("The striker assembly comprises a reciprocating striking rod. A power source, such as a pneumatic motor, electric motor, solenoid arrangement, or the like, provides power through a series of gears and springs to move the striking rod in reciprocating fashion."); Evans at [0051] ("The massager 10 also includes a vibrator and rotator motor 54 configured to provide a vibration and rotation to the massager. The massager 10 is motor driven. As such, the massage head capsule 30 can both vibrate and rotate on protruding node 50. This pivoting movement of the massage head capsule 30 will produce a comfortable kneading effect to a desired area of treatment. The weight of the massage roller ball 42 provides deep penetrating."); Kuznets at 7:28-32 ("As shown in FIG. 2, shaft housing 52 may be deployed colinearly with shaft 54. Alternatively, as shown in FIG. 3a, shaft housing 52 may be deployed angularly relative to shaft 54. In the later case motor 56 indirectly rotates shaft 54 via an additional shaft 53 and angular transmission means 55."); Miller '923 at 1:58-65 ("The operation of the device is with a solenoid, or other motive force driving the reciprocating rod axially. The reciprocating rod is slidealbly [sic] mounted within the housing, transiting through the solenoid coil. The reciprocating rod is held in place by springs, affixed to the reciprocating rod to limit travel and to return the reciprocating rod to the neutral position between impacts. On activation, the reciprocating rod is accelerated axially by the solenoid or other motive force."); Miller at [0006] ("The present invention provides a chiropractic adjustment tool or tapper, which, generally, comprises a housing, with or without a handle and a motor or power source to drive an axially reciprocating rod."); Tucek at 4:15-23 ("The elongated force-transmitting shaft 44 extends through the electromagnetic drive mechanism 46, through the middle portion 52 and interior cavity 54 of the housing 42, and through the central openings 62, 64 in the opposite (front and rear) end portions 56, 58 of the housing 42. In such manner, the shaft 44 is reciprocally supported

by the opposite end portions 56, 58 of the housing 42, preferably in a substantially symmetrical relationship to the electromagnetic drive mechanism 46."); Wang at Embodiment Mode (Certified Translation) (Through the composition of the components described above, the low-resonance reciprocating motion mechanism (10) is powered by the motor power piece (41), and the output shaft (411) drives the eccentric rotating shaft (42) to perform a circling motion. The bearing (44) drives the clamping sleeve (321) to axially reciprocate along the shaft rod (31), to drive the shaft rod (31) to axially and reciprocally make a linear displacement along the shaft rod (31), so that the tail of the end of the shaft rod (31) extending out of the body (21) forms repeated expanding and retracting pressing actions suitable for specific parts of a human body."); Mabuchi at 2:45-52 ("A rotating disc 17 is fixed to the motor output shaft 21, which in turn causes the rotating disc 17 to rotate. A rod 3 is fitted at an end thereof to a crankshaft 19 provided on the rotating disc 17, the other end thereof being connected to an actuator 4 via a rod shaft 18. Consequently, as the rotating disc 17 rotates, the actuator 4 is caused to reciprocate within an actuator bearing 16 via the rod 3."); Lerro at [0032] ("The massage device 1 comprises a housing 2, in which a motor 3 is arranged, which drives through a transmission, in this case a reduction gear, a ring-shaped sliding track 6. A guide unit 7 converts the rotary movement of the ring-shaped guide track 6 into a lift motion, which acts on a massaging finger 8. The lift motion itself is changed into an alternating lift motion by the aforementioned controller 10, which will still be described below.").

A person skilled in the art would have understood the benefits of a reciprocating piston to provide percussive massage using a motor, would have recognized that configuring a massage device in this way would provide massaging benefits to a user, and would have been motivated to incorporate these features into massage devices accordingly. Thus, a person of ordinary skill

in the art would have been motivated to modify any of the primary references to include this feature. A person of ordinary skill in the art would also have had a reasonable expectation of success. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

As another example, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach limitations 34[g], [h], and/or [i] ("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"), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses these limitations in Exhibits A-01 to A-20 or Exhibit A-A. For example, several prior art references, including at least Mabuchi, Colloca, Cilea, Hoffman, Kuznets, Luettgen, Miller '923, Miller, Wang, and Tucek, explicitly describe or disclose "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." *See, e.g.*,. Mabuchi at 8:26-39and Figs. 18, 19 ("When connecting the patter assembly 6 to the actuator 4, the end face of the actuator is brought in close contact with the end face of the flange 15. This causes the magnet 43 implanted in the coupling 14 and the magnet 44 implanted in the flange 15 to attract with each other, bringing the actuator 4 and the patter assembly 6 in position. This connecting mechanism 12 utilizing the different polarities of the magnets 43 and 44 ensures

positive connection of the actuator 4 and the patter assembly 6, both of which are subjected to vibrations caused by high-speed reciprocating motion. In addition, positive connection can be ensured without positioning the actuator 4 and the patter assembly 6."); Colloca at [0056] ("The preferred embodiments shown in FIGS. 14 and 14A-D show various preferred embodiments of the impact head 70 including a cushion(s) 73, an impact body 75 and an impact coupler 78. In these preferred embodiments, the cushions are of some soft material such as rubber, the impact body is made of metal such as aluminum, and the impact coupler is typically a soft material such as an o-ring to form a press fit with the thrust nose piece 130."); Cilea at [0006], Fig. 1 ("Various plungers of differing shapes, sizes, contours, textures and hardness may be used and it is possible that the plungers will be easily or readily changed."); Evans at [0040] and Fig. 6 ("The massager 10 can further include a quick release button 18 disposed upon the massage head 48 of the massager 10 and configured to be actuated by the user to remove the massage capsule 30 from the massager 10 for interchange ability and replaceability."); Hoffman at 41:7-13 and Figs. 3, 10 ("Hollow connecting column 65 is attached to and projected from housing 64, which enables removable attachment (by friction) to shaft 16 of vibrator 10 (or to the shaft of any of the provided variations to vibrator 10 according to the invention), however any known means of attachment (fixed or removable) may be used, as long as a sound vibratory connection is established."); Kuznets at 11:16-13 ("Thus, the body and joints massage device of the present invention includes a shaft housing engaging a main rotating shaft, the shaft housing being formed suitable to grip by a user and may be engaged with different types of massage heads. Using a quick release mechanism and suitable construction of the massage heads and the shaft housing, the various heads may be easily connected to or disconnected from a single shaft housing (i.e., changeable heads)."); Luettgen at [0062] and Figs. 8A-C ("As previously explained, a tip 145 may be easily

fitted or removed to the head 135 via a connection means 140. The tip 145 serves to transfer the vibrations of the J-shaped vibrating massager 100 from the head 135 and J-hook 110 to the user, thus providing a massage."); Miller '923 at 2:52-55 ("The user can simply pull the impact head off the reciprocating rod and reinstall a different shaped impact head depending on what the treatment requires."); Miller at [0026] ("Affixed to the forward end 18 of the reciprocating rod 16 is a coupler 62. The coupler 62 is used for affixing impact heads 70 of varying shapes. In the preferred embodiment the coupler 62 is formed so as to permit the impact head 70 to be removably affixed to the reciprocating rod 16 at a set, but adjustable angle. This is accomplished through the use of a sleeve element 64 on the impact head 70. The coupler is comprised of a collar 62 affixed to the reciprocating rod 16, a collar pin 66 set on the collar 62 and pin notches 68 set in a sleeve base 67 of the sleeve element 64. The collar 62 is mounted on the reciprocating rod 16 offset from the forward end 18 so as to permit the sleeve element 64 of the impact head to receive a portion of the forward end 18 of the reciprocating rod 16 for stability. The sleeve base 67 abuts the collar 67 and the collar pin 66 is received into one of a number of defined pin notches 68 on the sleeve base 67 so as to prevent rotation of the impact head 70. A simple retaining hook or loop 72 or similar means retains the impact head 70."); Wang at Embodiment Mode (Certified Translation) and Figs. 3, 9 ("In addition, it should be noted that the end of the shaft rod (31) extending out of the body (21) can be used to be connected to various models of massage heads . . . ."); Tucek at 5:38-49 and Fig. 4 ("Also, a plurality of force transmitting elements 122 of different configurations are adapted to be fitted to a hex shaped segment 124 of the front end 44E of the shaft 44 and placed against a part of the human body to be treated. The different configurations of the elements 22 allow for the application of force in different ways to the human body. The adjustor apparatus 40 has a mode of operation similar to that of a jack

hammer or the like. In the case of the apparatus 40, vibratory impacts are transmitted at the front end 44E of the shaft 44 by the selected one of the force transmitting elements 122 when it is placed against the desired part of the human body.").

A person skilled in the art would have understood the benefits of a quick release connector for securing the massage head, would have recognized that including a quick release connector provide benefits to the massage device including the ability to change massage heads, and would have been motivated to incorporate these features into massage devices accordingly. Thus, a person of ordinary skill in the art would have been motivated to modify any of the primary references to include this feature. A person of ordinary skill in the art would also have had a reasonable expectation of success. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

IV. U.S. Patent No. 11,938,082 ("the '082 Patent")

A. Identification of Prior Art

In addition to the prior art cited on the face of the '082 Patent and related patents, the admitted prior art in the specifications of the '082 Patent and related patents, the prior art cited in any file histories of the '082 Patent and related patents, the prior art cited in Post-Grant Review Petition PGR2024-00053, filed September 27, 2024 ("the '482 PGR Petition"), the prior art cited in any reexaminations, post-grant review or *inter partes* review proceedings, reissue proceedings, or other examination or post-grant proceedings of the '082 Patent and related patents, and the prior art cited in any invalidity contentions or expert reports submitted in any action or proceedings involving the '082 Patent or related patents, Defendant identifies the following prior art that anticipates each asserted claim or renders it obvious.

1. Prior Art Patents

The following patents and patent publications are prior art to the asserted claims under at least 35 U.S.C. § 102 and/or 35 U.S.C. § 103. The identification of any patent or patent publication shall be deemed to include any counterpart patent or application filed, published, or issued anywhere in the world.

Patent or Publication Number	Country of Origin	Filing Date	Date of Issue or Publication
U.S. Patent Application Pub. No. 2013/0261516A1 ("Cilea")	United States	March 30, 2013	October 3, 2013
U.S. Patent No. 6,228,042 ("Dungan")	United States	September 24, 1998	May 8, 2001
U.S. Patent Application Pub. No. 2010/0274162 A1 ("Evans")	United States	April 22, 2009	October 28, 2010
U.S. Patent No. 8,870,796 ("Hoffman")	United States	April 5, 2010	October 28, 2014
U.S. Patent No. 5,803,916 ("Kuznets")	United States	March 19, 1996	September 8, 1998
U.S. Patent Application Pub. No. 2003/0009116 A1 ("Luettgen")	United States	May 8, 2002	January 9, 2003
U.S. Patent No. 5,134,777 ("Meyer")	United States	December 5, 1991	August 4, 1992
U.S. Patent No. 7,503,923 ("Miller '923")	United States	November 21, 2003	March 17, 2009
U.S. Patent Application Pub. No. 2003/0195443 ("Miller")	United States	April 12, 2002	October 16, 2003
U.S. Patent No. 6,537,236 ("Tucek")	United States	December 26, 2000	March 25, 2003
Taiwan Patent Application Pub. No. TWM343481U ("Wang")	Taiwan	May 5, 2008	November 1, 2011
U.S. Patent No. 4,513,737 ("Mabuchi")	United States	December 22, 1980	April 30, 1985
U.S. Patent Application	United States	December 5, 2006	June 27, 2007

Patent or Publication Number	Country of Origin	Filing Date	Date of Issue or Publication
Pub. No. 2007/0150004 ("Colloca")			
U.S. Patent Application Pub. No. 2013/0138023A1 ("Lerro")	United States	April 12, 2002	October 16, 2003
U.S. Patent No. 6,682,496 ("Pivaroff")	United States	December 28, 1999	January 27, 2004
U.S. Patent No. 3,994,290 ("Springer")	United States	September 29, 1975	November 30, 1976
WO Publication No. 2010086513A1 ("Gueret")	International	January 27, 2009	August 5, 2010
JP Patent No. H0686736U ("JP '736")	Japan	May 26, 1993	December 20, 1994
WO Publication No. 2010086513A1 ("Legrain")	International	October 24, 2003	May 13, 2004
U.S. Patent No. 3,696,693 ("Bosten")	United States	November 18, 1969	October 10, 1972
U.S. Patent No. 6,432,072 ("Harris")	United States	January 21, 2000	August 13, 2002
U.S. Patent No. 1,339,179 ("Elmen")	United States	June 14, 1918	May 4, 1920
U.S. Patent No. 4,730,605 ("Noble")	United States	July 14, 1986	March 15, 1988
U.S. Patent No. 5,215,051 ("Smith")	United States	October 19, 1992	June 1, 1993
U.S. Patent No. 5,103,809 ("DeLuca")	United States	December 5, 1990	April 14, 1992
U.S. Patent No. 3,172,675 ("Gonzalez")	United States	February 19, 1963	March 9, 1965
U.S. Patent No. 7,641,476 ("Didur")	United States	June 23, 2006	January 5, 2010
U.S. Patent No. 7,435,042 ("White")	United States	May 10, 2006	October 14, 2008
U.S. Patent No. 8,631,532 ("Utsch")	United States	July 25, 2012	January 21, 2014
U.S. Patent No. 9,132,058 ("Imboden")	United States	January 9, 2008	September 15, 2015

Patent or Publication Number	Country of Origin	Filing Date	Date of Issue or Publication
U.S. Patent No. 6,911,013 ("Heimberger")	United States	August 20, 2002	June 28, 2005
U.S. Patent No. 5,140,979 ("Nakagawa")	United States	December 12, 1989	August 25, 1992
U.S. Patent Publication No. 20070244416A1 ("Sobin")	United States	April 14, 2006	October 18, 2007
KR101162978B1 ("Min")	Korea	February 9, 2012	July 9, 2012
CN201067499Y ("Chan")	China	June 13, 2007	June 4, 2008
CN201750912U ("Jinming")	China	July 19, 2010	February 23, 2011
CN2390610Y ("Lin")	China	June 3, 1999	August 9, 2000
CN2698333Y ("Zhou")	China	December 3, 2003	May 11, 2005
CN201894734U ("Shuishan")	China	August 13, 2010	July 13, 2011
TWM445439U ("Lo")	Taiwan	July 17, 2012	January 21, 2013
WO2013107898A1 ("Dauvister")	International	January 21, 2013	July 25, 2013
WO Publication No. 2012165833A2 ("Lee")	International	May 29, 2012	December 6, 2012
WO Publication No. 2014080103A2 ("Giraud")	International	October 17, 2013	May 30, 2014
U.S. Design Patent No. 649,657 ("Petersen")	United States	March 29, 2011	November 29, 2011

2. Prior Art Non-Patent Publications

The following non-patent publications are prior art to the asserted claims under at least 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

Title	Author/Publisher	Date of Publication
Instructables.com ("Instructables")	Rachel	August 28, 2007
Irestusa.com, SL-C28 ("iRest")	iRest USA	July 29, 2011
Brookstone's Active Sport Massager ("Brookstone")	Brookstone	May 21, 2012

3. Prior Art Systems

Defendant's investigation into publicly available prior art systems that teach and/or render obvious each element of any asserted claims is ongoing. Fact discovery is at an early stage, and Defendant may require discovery from third parties regarding publicly available prior art systems. Defendant reserves the right to amend its identification of prior art systems as Defendants become aware of the existence, functionality, and/or characteristics of prior art systems as a result of its investigation and forthcoming discovery. In addition to the prior art products, components, systems, and methods that may be identified as a result of discovery, Defendant also reserves the right to rely on the documents and publications identified in the corresponding claim charts as prior art publications.

The following systems are prior art under 35 U.S.C. § 102:

- Products, components, systems, and methods invented, designed, developed, reduced to practice, and/or in public use or on sale related to the Young Sun YS-889 Model ("Young Sun"), as exemplified in claim charts in Exhibit B-01. Based on information available to Defendant, Defendant believes that this system was in public use or on sale at least by March 16, 2009, as evidenced by Taiwan's Bureau of Standards, Metrology and Inspection Registration No. CI538065000021, and the publication of Taiwanese Patent Application TWM343481U (*see* Exhibit B-12).

B. Primary References

Defendant contends that the primary prior art references identified below and described in the charts attached as Exhibits A-01 to A-20, by themselves, anticipate the asserted claims of the '082 Patent. To the extent that a primary reference is deemed not to anticipate a claim for failing to teach one or more limitations of that claim, Defendant contends that the claim would

nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention in view of the prior art reference itself, as described in the attached charts. Defendant's prior art charts (attached as Exhibits A-01 thru A-20) set forth the particular claims that are anticipated under 35 U.S.C. § 102 and/or rendered obvious under 35 U.S.C. § 103 by each item of prior art and identify where specifically in each item of prior art, each element of each asserted claim is found.

Exhibit	Primary References
B-01	Young Sun YS-889 Model ("Young Sun")
B-02	U.S. Patent Application Pub. No. 2013/0261516A1 ("Cilea")
B-03	U.S. Patent No. 6,228,042 ("Dungan")
B-04	U.S. Patent Application Pub. No. 2010/0274162 A1 ("Evans")
B-05	U.S. Patent No. 8,870,796 ("Hoffman")
B-06	U.S. Patent No. 5,803,916 ("Kuznets")
B-07	U.S. Patent Application Pub. No. 2003/0009116 A1 ("Luettgen")
B-08	U.S. Patent No. 5,134,777 ("Meyer")
B-09	U.S. Patent No. 7,503,923 ("Miller '923")
B-10	U.S. Patent Application Pub. No. 2003/0195443 ("Miller")
B-11	U.S. Patent No. 6,537,236 ("Tucek")
B-12	Taiwan Patent Application Pub. No. TWM343481U ("Wang")
B-13	U.S. Patent No. 4,513,737 ("Mabuchi")
B-14	U.S. Patent Application Pub. No. 2007/0150004 ("Colloca")
B-15	U.S. Patent Application Pub. No. 2013/0138023A1 ("Lerro")
B-16	U.S. Patent No. 6,682,496 ("Pivaroff")
B-17	U.S. Patent No. 3,994,290 ("Springer")

Exhibit	Primary References
B-18	WO Publication No. 2010086513A1 ("Gueret")
B-19	JP Patent No. H0686736U ("JP '736")
B-20	WO Publication No. 2010086513A1 ("Legrain")

C. Secondary References

Exhibit B-A lists secondary prior art references and identifies, on a limitation-by-limitation basis, where specifically each secondary reference teaches the limitations of the asserted claims. To the extent that a primary reference is deemed, by itself, not to anticipate or render obvious a claim for failing to teach one or more limitations, the claim would nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention by the combination of the primary reference with one or more of the other primary references listed above and/or the references listed as disclosing those alleged missing limitations in Exhibit B-A.

D. Obvious Combinations

To the extent that a primary reference is deemed, by itself, not to anticipate or render obvious a claim for failing to teach one or more limitations, the claim would nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention by the combination of the primary reference with one or more other primary references and/or the knowledge of someone skilled in the art. For example, a person of ordinary skill in the art would have been motivated to combine any reference in Exhibits B-01 to B-20 with any other reference(s) in Exhibit B-01 to B-20. Such combinations would be achieved, for example, by merely combining the disclosures described in the respective claim charts for each reference.

Defendant also contends that any of the primary references (or combination of primary references) could be combined with any of the secondary references (or combination of

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secondary references) in Exhibit B-A to render obvious the asserted claims. Such combinations would be achieved by merely combining the disclosures described in the respective claim charts for each reference.

The obviousness combinations are provided in the alternative to Defendant's anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not itself anticipatory.

1. Exemplary Combinations

Below are examples of prior art references that would have been combined by one of ordinary skill in the art at the time of the alleged invention. These combinations are merely examples. The asserted claims of the '082 Patent are rendered obvious by:

- Young Sun alone or in combination with one or more of Wang, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Cilea alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller '923, Miller, Colloca, Springer, Gueret, JP '736, and Legrain, and any of the references in Exhibit B-A.
- Dungan alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Lerro, Cilea, and Evans, and any of the references in Exhibit B-A.
- Evans alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Hoffman alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.

- Kuznets alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Luettgen alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Meyer alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller '923, Miller, Colloca, Springer, Gueret, JP '736, and Legrain, and any of the references in Exhibit B-A.
- Miller '923 alone or in combination with one or more of Miller, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Miller alone or in combination with one or more of Miller '923, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Tucek alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller '923, Miller, Colloca, Springer, Gueret, JP '736, and Legrain, and any of the references in Exhibit B-A.
- Wang alone or in combination with one or more of Young Sun, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Mabuchi alone or in combination with one or more of Wang, Pivaroff, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.

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- Colloca alone or in combination with one or more of Wang, Young Sun, Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Lerro alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller '923, Miller, Colloca, Springer, Gueret, JP '736, and Legrain, and any of the references in Exhibit B-A.
- Pivaroff alone or in combination with one or more of Young Sun, Wang, Mabuchi, Pivaroff, Hoffman, Kuznets, Luettgen, Miller '923, Miller, Colloca, Springer, Gueret, JP '736, and Legrain, and any of the references in Exhibit B-A.
- Springer alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Gueret alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- JP '736 alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.
- Legrain.alone or in combination with one or more of Pivaroff, Mabuchi, Dungan, Meyer, Tucek, and Lerro, and any of the references in Exhibit B-A.

2. Motivations to Combine

To the extent a finder of fact finds that a primary prior art reference does not disclose one or more limitations of an asserted claim, the asserted claim is nevertheless obvious because the allege missing limitations contain nothing beyond ordinary improvements. In other words, the asserted claim combines known elements to achieve predictable results or chooses between clear

alternatives known to those of skill in the art, particularly in view of the state of the art as reflected in the relevant prior art.

Moreover, as explained above, it would have been obvious to a person of skill in the art at the time of the alleged invention of the asserted claims to combine any primary reference with any combination of other primary references or secondary references so as to practice the asserted claims. To the extent that Plaintiff argues that any concept claimed in the asserted claims is not disclosed in a primary reference, it would, at a minimum, have been obvious to adapt the primary reference to include the concept or combine it with other primary references or secondary references that disclose the concept. Each concept described and claimed in the Asserted Patents was known to those of skill in the art as available design choices for percussive massage devices.[2]

The Supreme Court has held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 416 (2007). "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one." *Id*. at 417. As the Supreme Court made clear, "[f]or the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id*.

To determine whether there is an apparent reason to combine the known elements in the fashion claimed by the patent at issue, a court can "look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace;

[2] Each concept described and claimed in the '082 Patent was known to those of skill in the art as available design choices for massage devices.

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and the background knowledge possessed by a person having ordinary skill in the art." *Id*. at 418. For example, obviousness can be demonstrated by showing "there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *Id*. at 420. "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id*. Common sense also teaches that "familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id*.

However, the Supreme Court in *KSR* held that a claimed invention can be obvious even if there is no explicit teaching, suggestion, or motivation for combining the prior art to produce that invention. In summary, *KSR* holds that patents that are based on new combinations of elements or components already known in a technical field may be found to be obvious. *See, generally*, *KSR*, 550 U.S. 398. Specifically, the Court in *KSR* rejected a rigid application of the "teaching, suggestion, or motivation [to combine]" test. *Id*. at 418. "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim." *Id*. at 419. "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id*. at 420. A key inquiry is whether the "improvement is more than the predictable use of prior art elements according to their established functions." *Id*. at 417.

The rationale to combine or modify prior art references is significantly stronger when, as here, the references seek to solve the same problem, come from the same field, and correspond well to each other. *In re Inland Steel Co*., 265 F.3d 1354, 1362 (Fed. Cir. 2001). The Federal

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Circuit has held that two references may be combined as invalidating art under similar circumstances, namely "[the prior art] focus[es] on the same problem that the … patent addresses: enhancing the magnetic properties of … steel. Moreover, both [prior art references] come from the same field …. Finally, the solutions to the identified problems found in the two references correspond well." *Id*. at 1364 (concerning patents and prior art relating to improving the magnetic and electrical properties of steel).

In view of the Supreme Court's *KSR* decision, the PTO issued a set of Examination Guidelines. Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc*., 72 Fed. Reg. 57526 (October 10, 2007). Those Guidelines summarized the *KSR* decision and identified various rationales for finding a claim obvious, including those based on other precedents. Those rationales include:

> (A) Combining prior art elements according to known methods to yield predictable results;
>
> (B) Simple substitution of one known element for another to obtain predictable results;
>
> (C) Use of known technique to improve similar devices (methods, or products) in the same way;
>
> (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
>
> (E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
>
> (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
>
> (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Id. at 57529. The above rationales likewise apply in rendering obvious the asserted claims of the Asserted Patents.

The references disclosed herein, alone or in combination, contain an explicit and/or implicit teaching or motivation to combine them due to the following: (1) the knowledge generally available to a person of ordinary skill in the art; (2) the prior art references as understood by a person of ordinary skill in the art; (3) the nature of the problem to be solved; (4) the fact that each prior art reference addresses similar problems; and (5) the knowledge of those skilled in the art that the disclosed elements had been or could be used together.

As an example of those reasons and motivations to combine the references, the primary references identified in Section IV.B, as well as secondary references in Exhibit B-A, generally relate to massage devices, and in particular to percussive massage devices and connectors for attachments to devices. *See* Ex. B-01 to B-20 and B-A. The references disclose similar components and techniques for applying percussive massage to a user. *Id.* The attached charts in Ex. B-01 to B-20 and B-A provide additional reasons and motivations to combine the charted references.

Additionally, the primary and secondary references listed above are analogous art. They are all directed to massage devices, and in particular to percussive massage devices and connectors for attachments to devices. *See, e.g.*, Young Sun (percussive massage device); Cilea at [0002] ("The present invention relates generally to a medical percussion device. More specifically, the present invention relates to a hand held percussion device for the purpose of addressing soft tissue (muscle, fascia, tendon, and ligaments) dysfunction and pain syndromes."); Dungan at 2:11 ("The present invention provides a chiropractic adjustment tool or tapper"); Evans at Abstract ("The technology described herein provides a handheld massager."); Hoffman

at 33:45-49 (“As an option, vibrator 10 will also contain programming and controls to enable the selection of variable frequency response algorithms (or variations in vibration cadence). Such as in the Sharper Image Massager Model HF 757 incorporated herein by reference.”); Kuznets at 5:14-17 (“The present invention is of a hand held, electrically operated body and joints massage device having changeable massage heads which can be used to provide selected stroking, rubbing and/or kneading massaging effects.”); Luettgen at [0002] (“The present invention generally relates to hand-held massagers.”); Miller ’923 at 1:10-11 (“Even more particularly, it relates to an improved head assembly for a percussive therapeutic device.”); Miller at [0001] (“The present invention involves the field of medical devices. More particularly, it involves the field of percussive medical devices used as chiropractic adjustment tools used to move bones and relieve muscle spasms and stress.”); Tucek at 1:10-13. (“The present invention generally relates to a chiropractic adjustor apparatus for use in a chiropractic treatment to apply vibratory energy or force to the human body.”); Wang at Technical Field of the Utility Model (Certified Translation) (“The present invention relates to a massage tool for human physiotherapy, and more particularly to a low-resonance reciprocating motion mechanism.”); Mabuchi at 1:6-12 (“This invention relates generally to a beauty treatment device, and more specifically to a beauty treatment device having a space guide that permits an actuator to repeatedly reciprocate and controls the motion of the actuator wherein a patter repeatedly pats a skin surface being treated at a given rate.”); Colloca at [0001] (“Particularly, it involves the field of electromechanical manipulation/adjusting instruments used to apply controlled dynamic forces to the human body.”); Lerro at [0001] (“The present invention relates to a device for massaging or treatment of the back and neck muscles of a patient, comprising a housing having a drive motor disposed therein, which indirectly generates an adjustable lift motion with a constant amplitude in the axial direction on a massaging finger,

comprising a massaging body and a fixing pin for connection of the finger with a drive of the spine massage device."); Pivaroff at 1:6-9 ("This invention relates generally to medical devices, and, more particularly, to a deep muscle stimulator device to increase muscle metabolism, increase the lactic acid cycle and to relieve pain."); Springer at 2:5-8 ("It is an additional object of the instant invention to provide a new and improved massaging device wherein the massaging device utilizes revolving and rotating spheres . . . ."); Gueret at [0073] (Machine Translation) ("The tool can also be adapted to massage the scalp and feature curved flexible fingers with enlarged heads at their ends."); JP '736 at [0007] "In order to solve the above problem, the present invention provides a tapping attachment having a massage tool at its tip for tapping the skin surface of the face etc…."); Legrain (Machine Translation) ("The present invention relates to a massage device of the type comprising means for driving in rotation, or capable of receiving this movement, to then transmit it to means transforming it into a repeated back-and-forth movement to actuate a striking member intended for contact with the skin.").

One of skill in the art would also have been motivated to combine the different publications and patents that were authored by employees of a given company or assigned to the same assignee and/or related to the same subject matter. Additionally, one of skill in the art would have been motivated to combine different references that were authored, developed, or invented by the same individual(s) related to the same subject matter. The common inventor/author/architect of the references demonstrate that they relate to continued work in a common field of effort and continued related developments in that field. One of skill in the art would, therefore, combine the references related to each individual. For example, a POSITA would have been motivated to combine Miller and Miller '923, based solely on the fact that they have overlapping inventors/authors. Additionally, based on the teachings of the references

and/or the knowledge of one of ordinary skill, one of skill in the art would have been motivated to combine different references from the same company. For example, a POSITA would have been motivated to combine at least Young Sun and Wang, which constitute a patent and corresponding product. And, one of skill in the art would have been motivated to combine prior art systems or products with any related or applicable documentation or literature for that system, including for the reason that these materials are related.

In addition, below are additional motivations to combine prior art for particular claim limitations. The following discussion of specific claim limitations are merely examples and are not limiting.

For example, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach limitations 1[a] ("a housing"), 1[b], and/or 1[c] ("a piston in the housing having a proximal end and a distal end, the distal end of the piston having a bore"), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses limitations 1[a], 1[b] and/or 1[c] in Exhibits B-01 to B-20 or Exhibit B-A. For example, several prior art references, including at least Dungan, Evans, Hoffman, Kuznets, Miller '923, Lerro, Pivaroff, Springer, Gueret, and Legrain..

A person skilled in the art would have understood that a massage device having a housing and a piston was well understood, and would have been motivated to incorporate these features into massage devices. *See, e.g.*,. Dungan at Abstract and 5:15 ("A chiropractic adjustment tool or tapper comprises a housing, the housing having an open end; a striker assembly disposed within the housing and secured thereto; and a plunger device or plunger disposed externally to the housing and secured thereto, the plunger being in communication with the striker assembly

through the open end in the housing."; "The plunger 14 comprises a hollow cylindrical body 28."); Evans at [0006] ("The hand held massager includes a housing dimensioned for handheld grip by a user . . . ."); Hoffman at 33:11-15 ("The active end of the provided linear stepper motor is operatively linked with and drives the proximal 'non-active end' of shaft 16 (not shown within housing 14), which is thereafter projected through housing 14 (now shown), to enable contact with the selected attachment interface."); Kuznets at 5:28-32 ("The body massage device presented in FIG. 1, referred to herein as device 20, includes a shaft housing 22 engaging a main rotating shaft 24, shaft housing 22 being formed suitable to grip by a user and serves as a handle of device 20."); Miller '923 at 1:48-57 ("The present invention provides a chiropractic adjustment tool or tapper, which, generally, comprises a housing, with or without a handle and a motor or power source to drive an axially reciprocating rod. The reciprocating rod is disposed perpendicularly or near perpendicularly to the handle. One end of reciprocating rod extends from the housing which has a spring pair assembly to permit the ready adjustment of impact force and axial travel of the reciprocating rod. The opposite end of the reciprocating rod has an attached impact head"); Lerro at [0033], Fig. 1 ("The housing 2 comprises a first housing part 20, in which is mounted the motor 3 and at least a part of the reduction gear 4. In a second housing part 21 is finally arranged the guide unit 7."); Pivaroff at 3:33-38 ("The top hollow housing 16 of the device 10 of the present invention is preferably made from the same material as the elongated handle 14, and includes a removable top plate and a truncated, pyramid-shape extending portion 52 which surrounds and provides protection around the reciprocating rod 38."); Springer at 2:59-3:7 ("Referring now to FIGS. 2 and 3, in combination with FIG. 1, it is seen that the massage unit 12 has a stem 18 projecting therefrom, which is received in a bore 19 within the coupling element 13 of the drive unit 10. The massage unit is held into the drive unit as illustrated in FIG. 4. The

stem 18 has a slot 20 formed in 65 one end, and a pair of projections 21 radially extending adjacent to the slot, so that the stem will frictionally engage the bore 19, and thereby hold the massage unit 12 mounted into the drive unit 10."); Gueret at [0257] (Machine Translation) ("In the example considered, the gripping member 12 defines a housing 20 for receiving a vibrating source 21 which carries a tool 25, for example a finishing tool for perfecting makeup applied using the applicator 2."); Legrain (Machine Translation) ("A second part 7 is arranged inside the housing 1, coaxial with the longitudinal axis of the housing 1. The second part 7 has a tubular shape and comprises, in its upper part, a radial collar 8 on which several axial cam ramps 9 are made. The cylindrical external surface located below the collar 8 is provided with external grooves 10. The cylindrical internal surface of the upper part of the second part 7 has internal grooves 11."). Thus, a person of ordinary skill in the art would have been motivated to modify any of the primary references to include this feature. A person of ordinary skill in the art would also have had a reasonable expectation of success. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

As another example, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach limitations 1[d] and/or 1[e] ("a motor operatively connected to the proximal end of the piston, wherein the motor is configured to cause the piston to reciprocate at a first speed;"), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses these limitations in Exhibits B-01 to B-20 or Exhibit B-A. For example, several prior art references, including at least Cilea, Dungan, Evans, Kuznets, Miller '923, Miller, Tucek, Wang, Mabuchi,

and Lerro, explicitly describe or disclose "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." *See, e.g.*, Cilea at [0020] ("The hand held percussion device 100 provides a handle 101 containing a rechargeable battery stored therein, and trigger 102 for activating the hand held percussion device 100. When activated, an internal, electric battery powered motor actuates an external mechanical plunger 103 which operates in a linear motion range. The external mechanical plunger 103 and bottom guide surface 104 is placed against a patient's muscle, fascia, tendon, or ligament and is subjected to the repetitive mechanical plunger motion resulting in a deep massage. Various external mechanical plungers 103 of differing shapes, sizes, contours, textures and hardness may be used and it is possible that the external mechanical plungers 103 will be easily or readily changed. Additionally, the speed of the hand held percussion device 100 is controlled by the trigger 102 so that if more speed is desired, a user simply depresses the trigger 102 further."); Dungan at 2:22-26 ("The striker assembly comprises a reciprocating striking rod. A power source, such as a pneumatic motor, electric motor, solenoid arrangement, or the like, provides power through a series of gears and springs to move the striking rod in reciprocating fashion."); Evans at [0051] ("The massager 10 also includes a vibrator and rotator motor 54 configured to provide a vibration and rotation to the massager. The massager 10 is motor driven. As such, the massage head capsule 30 can both vibrate and rotate on protruding node 50. This pivoting movement of the massage head capsule 30 will produce a comfortable kneading effect to a desired area of treatment. The weight of the massage roller ball 42 provides deep penetrating."); Kuznets at 7:28-32 ("As shown in FIG. 2, shaft housing 52 may be deployed colinearly with shaft 54. Alternatively, as shown in FIG. 3a, shaft housing 52 may be deployed angularly relative to shaft 54. In the later case motor 56

indirectly rotates shaft 54 via an additional shaft 53 and angular transmission means 55."); Miller '923 at 1:58-65 ("The operation of the device is with a solenoid, or other motive force driving the reciprocating rod axially. The reciprocating rod is slidealbly [sic] mounted within the housing, transiting through the solenoid coil. The reciprocating rod is held in place by springs, affixed to the reciprocating rod to limit travel and to return the reciprocating rod to the neutral position between impacts. On activation, the reciprocating rod is accelerated axially by the solenoid or other motive force."); Miller at [0006] ("The present invention provides a chiropractic adjustment tool or tapper, which, generally, comprises a housing, with or without a handle and a motor or power source to drive an axially reciprocating rod."); Tucek at 4:15-23 ("The elongated force-transmitting shaft 44 extends through the electromagnetic drive mechanism 46, through the middle portion 52 and interior cavity 54 of the housing 42, and through the central openings 62, 64 in the opposite (front and rear) end portions 56, 58 of the housing 42. In such manner, the shaft 44 is reciprocally supported by the opposite end portions 56, 58 of the housing 42, preferably in a substantially symmetrical relationship to the electromagnetic drive mechanism 46."); Wang at Embodiment Mode (Certified Translation) (Through the composition of the components described above, the low-resonance reciprocating motion mechanism (10) is powered by the motor power piece (41), and the output shaft (411) drives the eccentric rotating shaft (42) to perform a circling motion. The bearing (44) drives the clamping sleeve (321) to axially reciprocate along the shaft rod (31), to drive the shaft rod (31) to axially and reciprocally make a linear displacement along the shaft rod (31), so that the tail of the end of the shaft rod (31) extending out of the body (21) forms repeated expanding and retracting pressing actions suitable for specific parts of a human body."); Mabuchi at 2:45-52 ("A rotating disc 17 is fixed to the motor output shaft 21, which in turn causes the rotating disc 17 to rotate. A rod 3 is fitted

at an end thereof to a crankshaft 19 provided on the rotating disc 17, the other end thereof being connected to an actuator 4 via a rod shaft 18. Consequently, as the rotating disc 17 rotates, the actuator 4 is caused to reciprocate within an actuator bearing 16 via the rod 3."); Lerro at [0032] ("The massage device 1 comprises a housing 2, in which a motor 3 is arranged, which drives through a transmission, in this case a reduction gear, a ring-shaped sliding track 6. A guide unit 7 converts the rotary movement of the ring-shaped guide track 6 into a lift motion, which acts on a massaging finger 8. The lift motion itself is changed into an alternating lift motion by the aforementioned controller 10, which will still be described below.").

A person skilled in the art would have understood the benefits of a reciprocating piston to provide percussive massage using a motor, would have recognized that configuring a massage device in this way would provide massaging benefits to a user, and would have been motivated to incorporate these features into massage devices accordingly. Thus, a person of ordinary skill in the art would have been motivated to modify any of the primary references to include this feature. A person of ordinary skill in the art would also have had a reasonable expectation of success. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

As another example, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach limitations 1[g], and/or 1[h] ("a quick-connect system comprising the distal end of the piston and a first massaging head, wherein the quick-connect system is configured to have a proximal end of the first massaging head inserted into or removed from the bore while the piston reciprocates the predetermined stroke length at the first speed"), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine

the primary reference with any of the prior art that discloses these limitations in Exhibits B-01 to B-20 or Exhibit B-A. For example, several prior art references, including at least Springer, Legrain, Gueret, JP '736, Colloca, Cilea, Hoffman, Kuznets, Miller, and Bosten., explicitly describe or disclose "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." *See, e.g.*,. Springer at 2:59-3:7 and Figs. 1-3 ("Referring now to FIGS. 2 and 3, in combination with FIG. 1, it is seen that the massage unit 12 has a stem 18 projecting therefrom, which is received in a bore 19 within the coupling element 13 of the drive unit 10. The massage unit is held into the drive unit as illustrated in FIG. 4. The stem 18 has a slot 20 formed in 65 one end, and a pair of projections 21 radially extending adjacent to the slot, so that the stem will frictionally engage the bore 19, and thereby hold the massage unit 12 mounted into the drive unit 10. A pair of radial projections 22 register with recesses 23 (FIG. 1) in the coupling element 13, so that the coupling element 13 will positively drive massage unit 12. When it is desired to remove the massage unit 12 from the drive unit 10, the massage unit is simply pulled with sufficient force to overcome friction between the projections 21 and the interior surface of the bore 19."); Gueret at [0142] and Fig. 12 (Machine Translation) ("The vibrating unit 72 may comprise an end piece 77 into which a rod 78 provided at the end with a specific application element can be inserted, as illustrated in FIG. 12."); Legrain (Machine Translation) and Figs. 7-8 ("A mushroom-shaped striking tool 4 comprises a large-surface active part 14 (at least 40 mm in diameter) extended downwards by a rod 15. The external surface of the rod 15 is grooved and engages with the internal grooves 11 of the second part 7. The striking tool 4 comes into contact with the front part of the second part

7. Thus produced, the striking tool 4 is removably mounted and can be replaced with another having an active surface 14 of different geometry and/or flexibility."); JP '736 at 0024] ("Thereafter, when connecting or disconnecting the striking attachment 20 to the drive shaft 18, the above-mentioned operation can be repeated to easily replace multiple striking attachments 20."); Colloca at [0056] and Fig. 2 ("The preferred embodiments shown in FIGS. 14 and 14A-D show various preferred embodiments of the impact head 70 including a cushion(s) 73, an impact body 75 and an impact coupler 78. In these preferred embodiments, the cushions are of some soft material such as rubber, the impact body is made of metal such as aluminum, and the impact coupler is typically a soft material such as an o-ring to form a press fit with the thrust nose piece 130."); Cilea at [0006], Fig. 1 ("Various plungers of differing shapes, sizes, contours, textures and hardness may be used and it is possible that the plungers will be easily or readily changed."); Evans at [0040] ("The massager 10 can further include a quick release button 18 disposed upon the massage head 48 of the massager 10 and configured to be actuated by the user to remove the massage capsule 30 from the massager 10 for interchange ability and replaceability."); Hoffman at 41:7-13 ("Hollow connecting column 65 is attached to and projected from housing 64, which enables removable attachment (by friction) to shaft 16 of vibrator 10 (or to the shaft of any of the provided variations to vibrator 10 according to the invention), however any known means of attachment (fixed or removable) may be used, as long as a sound vibratory connection is established."); Kuznets at 11:16-13 ("Thus, the body and joints massage device of the present invention includes a shaft housing engaging a main rotating shaft, the shaft housing being formed suitable to grip by a user and may be engaged with different types of massage heads. Using a quick release mechanism and suitable construction of the massage heads and the shaft housing, the various heads may be easily connected to or disconnected from a single shaft housing (i.e.,

changeable heads)."); Miller '923 at 2:52-55 ("The user can simply pull the impact head off the reciprocating rod and reinstall a different shaped impact head depending on what the treatment requires."); Bosten at 5:3-10 ("Referring still to FIGs. 2 and 3, the bit 144 just described may be retained in guide 148 in any desired fashion. One exemplary scheme of retaining the bit, shown in FIG. 2, involves the use of a magnet 158 slidably received in guide 148. Bit retainer 158 and bit 144 are biased to the left as shown in FIGs. 2 and 3 by a compression spring 166 fixed to magnet 158 and to a pin or rod 168 fitted in the rear end of guide 148.").

A person skilled in the art would have understood the benefits of a quick release connector for securing the massage head, would have recognized that including a quick release connector provide benefits to the massage device including the ability to change massage heads, and would have been motivated to incorporate these features into massage devices accordingly. Thus, a person of ordinary skill in the art would have been motivated to modify any of the primary references to include this feature. A person of ordinary skill in the art would also have had a reasonable expectation of success. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

V. Invalidity Contentions Under 35 U.S.C. § 112

Defendant include below the grounds on which Defendant contends the asserted claims are invalid for failure to meet the requirements of the first two paragraphs of 35 U.S.C. § 112(a) and (b).

Plaintiff has not yet provided a claim construction for many of the terms and phrases that Defendant anticipates will be in dispute. Defendant, therefore, cannot provide a complete list of its § 112 defenses because Defendant does not know whether Plaintiff will proffer a construction

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for certain terms and phrases that is broader than, or inconsistent with, the construction that would be supportable by the disclosure set forth in the specification.

To the extent the following contentions reflect constructions of claim limitations consistent with or implicit in Plaintiff's Infringement Contentions, no inference is intended nor should any be drawn that Defendant agrees with Plaintiff's claim constructions, and Defendant expressly reserves the right to contest such claim constructions. Defendant offers these contentions in response to Plaintiff's Infringement Contentions and without prejudice to any position it may ultimately take as to any claim construction issues.

Accordingly, Defendant reserves the right to amend or supplement these § 112 Invalidity Contentions as discovery progresses.

A. Indefiniteness Under 35 U.S.C. § 112(b)

35 U.S.C. § 112(a) requires that a patent claim "particularly point[] out and distinctly claim[] the subject matter which the inventor … regards as his invention." 35 U.S.C. § 112(b). Claim terms that fail to inform those skilled in the art "with reasonable certainty … about the scope of the invention" fail the definiteness requirement of 35 U.S.C. § 112. *Nautilus, Inc. v. Biosig Instruments, Inc*., 572 U.S. 898, 901 (2014).

Each of the asserted claims are invalid as indefinite under 35 U.S.C. § 112 because they fail to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. In particular, the following limitations, read in light of the intrinsic evidence, fail to inform those skilled in the art with reasonable certainty about the scope of the claimed inventions:

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- Claim 34: “a drive mechanism between the motor and the piston that controls a predetermined stroke length of the piston”
- Claim 34: “a quick release connector at the distal end of the piston”
- Claim 34: “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”
- Claim 34: “wherein the first massaging head has a substantially cylindrical pocket to receive the quick release connector.”
- Claim 35: “a second massaging head configured to releasably couple to the distal end of the piston via the quick release connector.”
- Claim 41: “wherein the control panel is configured to display one or more visual indicators.”
- Claim 45: “wherein the first speed and the second speed are each selectable via the one or more inputs.”
- Claim 59: “wherein an offset between the flywheel axis and an axis of the crank pin controls the predetermined stroke length of the piston.”

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- Claim 1: “a drive mechanism that controls a predetermined stroke length of the piston”
- Claim 1: “a quick-connect system comprising the distal end of the piston and a first massaging head”
- Claim 1: “wherein the quick-connect system is configured to have a proximal end of the first massaging head inserted into or removed from the bore while the piston reciprocates the predetermined stroke length at the first speed.”

- Claim 4: "wherein the control panel is configured to display one or more visual indicators."
- Claim 9: "wherein the motor and the handle are on a same side of a plane perpendicular to the flywheel axis that extends through the flywheel."
- Claim 10: "wherein an offset between the flywheel axis and an axis of the crank pin controls the predetermined stroke length of the piston."
- Claim 13: "wherein the bore comprises a substantially cylindrical bore."

B. Lack of Enablement/Lack of Written Description Under 35 U.S.C. § 112(a)

The asserted claims of the Patents-In-Suit are further invalid under 35 U.S.C. § 112(a) because the specifications do not contain an adequate written description of the subject matter of these claims and would not enable one of skill in the relevant art to make and use the alleged invention.

For a claim to be valid, the specification must contain "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." 35 U.S.C. § 112(a). To fulfill the written description requirement, it "must clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed." *Ariad Pharm., Inc. v. Eli Lilly & Co*., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (citation and internal quotation marks omitted). "[T]he applicant must 'convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,' and demonstrate that by disclosure in the specification of the patent." *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc*., 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)).

The specification must also describe "the manner and process of making and using [the invention], in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains … to make and use the" invention. *Ariad*, 598 F.3d at 1343; *see also* 35 U.S.C. § 112(a). "The enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation." *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003) (citation omitted). "[T]he scope of the claims must be less than or equal to the scope of the enablement." *Nat'l Recovery Tech., Inc. v. Magnetic Separation Sys., Inc*., 166 F.3d 1190, 1196 (Fed. Cir. 1999).

Each of the asserted claims below are invalid because the specifications fail to provide written description and/or an enabling disclosure of at least the following limitations:

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- Claim 34: "a drive mechanism between the motor and the piston that controls a predetermined stroke length of the piston"
- Claim 34: "a quick release connector at the distal end of the piston"
- Claim 34: "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"
- Claim 34: "wherein the first massaging head has a substantially cylindrical pocket to receive the quick release connector."
- Claim 59: "wherein an offset between the flywheel axis and an axis of the crank pin controls the predetermined stroke length of the piston."

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- Claim 1: "a drive mechanism that controls a predetermined stroke length of the piston"

- Claim 1: "a quick-connect system comprising the distal end of the piston and a first massaging head"
- Claim 1: "wherein the quick-connect system is configured to have a proximal end of the first massaging head inserted into or removed from the bore while the piston reciprocates the predetermined stroke length at the first speed."
- Claim 9: "wherein the motor and the handle are on a same side of a plane perpendicular to the flywheel axis that extends through the flywheel."
- Claim 10: "wherein an offset between the flywheel axis and an axis of the crank pin controls the predetermined stroke length of the piston."
- Claim 13: "wherein the bore comprises a substantially cylindrical bore."

VI. Document Production

Pursuant to Patent Rule 3-4, Defendants are concurrently producing the prior art identified in these Invalidity Contentions, but Defendants are not required to produce the prior art in the file history of the Asserted Patents.

In addition, based on its investigations to date, and to the extent not already produced, Defendants will produce documentation sufficient to show the operation of any aspects or elements of the Accused Instrumentalities identified by Plaintiff in its P. R. 3-1(c) chart.

Defendants reserve the right to supplement these productions with additional documentation, in accordance with the Federal Rules of Civil Procedure, the Local Rules, the Court's orders and other applicable rules and statutes.

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CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure, I hereby certify that, on October 21, 2024, all counsel of record who have appeared in this case are being served with a copy of the foregoing via the electronic mail.

/s/ Kristin Godfrey
Kristin Godfrey
Case Manager
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