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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
16/869,402	05/07/2020	Jason Wersland	76840-5077	4812

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EXAMINER
STUART, COLIN W

ART UNIT	PAPER NUMBER
3785	

NOTIFICATION DATE	DELIVERY MODE
07/28/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@jmbm.com

Therabody EX2016
Hyper Ice v. Therabody
PGR2026-00051

Office Action Summary	Application No. 16/869,402	Applicant(s) Wersland et al.	
	Examiner COLIN W STUART	Art Unit 3785	AIA (FITF) Status Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☑ Responsive to communication(s) filed on 6/17/20.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL.** 2b) ☑ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☑ Claim(s) 1-9 and 17-27 is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6) ☐ Claim(s) _____ is/are allowed.

7) ☑ Claim(s) 1-9 and 17-27 is/are rejected.

8) ☐ Claim(s) _____ is/are objected to.

9) ☐ Claim(s) _____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to **PPHfeedback@uspto.gov.**

Application Papers

10)☑ The specification is objected to by the Examiner.

11)☑ The drawing(s) filed on 5/7/20 is/are: a)☐ accepted or b)☑ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☑ Notice of References Cited (PTO-892)

2) ☑ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date attached.

3) ☑ Interview Summary (PTO-413) Paper No(s)/Mail Date 7/9/20.

4) ☐ Other: _____.

Notice of Pre-AIA or AIA Status

1. The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Note: the crossed-through reference in the IDS filed 6/24/20 is not being considered at this time as the publication number, date, and name of the cited document does not match.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "116" and "117" have both been used to designate the pinion shaft, references characters “101” and “402” have both been used to designate the housing, and reference characters “230” and “310” have both been used to designate the pushrod and the reciprocator (note in Fig. 8 these reference characters are pointing to the same part).

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 47, 700.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 228.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "230" has been used to designate all of the first rod portion, the reciprocator, and the pushrod and reference character "231" has been used to designate both the protrusion and the first rod portion.

7. The drawings are objected to because para. 00125 discloses a compliant dampening block with reference 402; however, 402 in para. 33 does not appear to show a dampening block nor does there appear to be such a dampening block shown in the drawings.

8. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

9. The disclosure is objected to because of the following informalities:

- Para. 00123 recites the phrase "opening 222b that_receives" to which the underscore mark is objected to;

- Para. 00119 recites the phrase "and comfort of using the_device" to which the underscore mark is objected to;
- Para. 00120 recites the phrase "second handle portion 145 f(the second handle portion length)." to which the 'f(the' term appears to be a typographical error;
- Para. 00125 recites the phrase "In some_embodiments" to which the underscore mark is objected to;
- Para. 00129 recites the phrase "and the adapter member_226" to which the underscore mark is objected to;
- Para. 00159 recites that "1.8 volts is divided into 60 0.3-volt increments" and this is objected to as this appears it should be 0.03-volt increments;
- Para. 00166 is objected to as it recites "3-volt increments" and as discussed above this does not appear to be the value of the increments;
- Para. 00183 recites the phrase "using the lookup table. **[END OF 5063]**" which is objected to for what appears to be extraneous/typographical language;
- Para. 00200 refers to a "Fig. 39", "Fig. 40", and "Fig. 41" when disclosing various grips of the device; however, it appears from the disclosure that these figures should be –Fig. 38--, --Fig. 39--, and –Fig. 40--, respectively;
- Para. 00205 recites the phrase "As shown in Fig. 41, a "base" grip may be utilized" which is objected to as Fig. 41 does not appear to show a base grip; and
- Para. 00238 refers to a "Fig. 46" (two instances) in reference to a touch screen on a mobile device and this is objected to as Fig. 46 does not show a touch screen on a mobile device and furthermore, there is no "Fig. 46" but rather Figs. 46A-D.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 2-3, 17, and 21-23 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

Regarding claim 2, the language "The percussive therapy device of claim wherein" (line 1) renders the claim indefinite as it is not known what claim this claim 2 depends on and thus the metes and bounds of the claim cannot be ascertained. For purposes of expedited examination this claim will be examined as if dependent on claim 1.

Regarding claim 21, this dependent device claims that it "further comprising haptic feedback"; however, this appears to be a method step has 'haptic feedback' is not a structural element per se but rather the creation of the experience of touch for a user via various means (force, vibration, etc.). Thus the claim is unclear as this appears to be a method step and it is not known how such haptic feedback step is provided. Examiner suggests amending to read –wherein the percussive therapy device is configured to provide haptic feedback—for example.

Claims 3, 17, 22, and 23 are rejected based on dependency on a rejected claim.

Claim Rejections - 35 USC § 103

12. In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory

basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

13. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims the examiner presumes that the subject matter of the various claims was commonly owned as of the effective filing date of the claimed invention(s) absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and effective filing dates of each claim that was not commonly owned as of the effective filing date of the later invention in order for the examiner to consider the applicability of 35 U.S.C. 102(b)(2)(C) for any potential 35 U.S.C. 102(a)(2) prior art against the later invention.

15. Claim 1 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rix (7,927,259) in view of Haas (2005/0126018).

Regarding claim 1, Rix shows a percussive therapy device (see Fig. 1-5, abstract for example) which includes a housing 14, a motor positioned in the housing (see Fig. 1 and col. 2 ln. 23-27, col. 4 ln. 54-58, motor 72), a switch for activating the motor (see Fig. 1 and col. 3 ln. 65-67, switch 22), and a push rod assembly operatively connected to the motor and configured to reciprocate in response to activation of the motor (see Fig. 1, push rod assembly 18, see col. 2 ln. 23-27 and col. 4 ln. 54-58 for example). Rix teaches that the device is an electrical saw converted to be a massager (see col. 1 ln. 30-36 and col. 3 ln. 63) and as such one would expect that the device would have an electrical source; however, Rix is silent as to explicitly including this feature. Haas teaches a similar device (note that the

device of Rix is a reciprocating saw converted to be a massager as discussed above) which includes an electrical source (see Haas para. 0021). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the Rix device to explicitly include an electrical source, as taught by Haas, in order to provide the required elements to power the device, i.e. electrical source.

16. Claim 4 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rix and Haas as applied to claim 1 above, and further in view of Marton et al. (10,314,762).

Regarding claim 4, the modified Rix device is silent as to including a wireless connection device; however, Marton teaches a similar device which includes a wireless connection device (see Marton Fig. 35 and col. 37 ln. 38 through col. 39 ln. 19 which discloses connection of the device with a remote electronic device via wireless connection). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix device to include a wireless connection device, as taught by Marton, in order to provide the ability to connect with a remote device for monitoring (Marton col. 37 ln. 38 through col. 39 ln. 19).

17. Claims 5 and 21 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rix and Haas as applied to claim 1 above, and further in view of Paul et al. (2018/0288160).

Regarding claim 5, the modified Rix device teaches a battery as the electrical source (see Haas para. 0021), but is silent as to the device including a wireless charging receiver in electrical communication with the battery; however, Paul teaches a massage device which includes rechargeable battery in communication with a wireless charging receiver (see Paul para. 0039). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix device to include a wireless charging receiver in electrical communication with

the battery, as taught by Paul, in order to provide the ability reuse the device after the battery has been drained without having to use another separate battery.

Regarding claim 21, the modified Rix device is silent as to further including haptic feedback; however, Paul teaches a similar massage device which includes providing haptic feedback to the user (see Paul para. 0040). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix device to include providing haptic feedback to the user, as taught by Paul, in order to alert the user about information related to the operation of the device (see Paul para. 0040).

18. Claim 6 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rix and Haas as applied to claim 1 above, and further in view of Roberts (2015/0119771).

Regarding claim 6, the modified Rix device is silent as to the device further including a touch screen; however, Roberts teaches a similar device which includes a touch screen to provide a user interface (see Roberts Fig. 1-2 and para. 0159). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix device to include a touch screen, as taught by Roberts, in order to provide a well-known data input tool/user interface to control the device (see Roberts para. 0150).

19. Claims 7-8 and 19-20 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rix and Haas as applied to claim 1 above, and further in view of Stanbridge (2012/0253245) and Kehoe et al. (2013/0014968).

Regarding claim 7, the modified Rix device is silent as to the motor explicitly being a brushless motor and a motor mount is positioned in the housing such that the motor is secured to the motor

mount and the mount is secured to the housing; however, Stanbridge teaches a similar massage device which includes a brushless motor (see Stanbridge para. 0109), and Kehoe teaches a similar device (note that Rix is a reciprocating saw converted to a massage device as discussed above) which includes a motor mount for mounting a motor to and mounting to the housing (see Kehoe Fig. 4-8, motor 32, motor mount 64, Fig. 12, motor 232, motor mount 256, Fig. 1 showing the motor and mount secured within the housing). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix device's motor to be a brushless motor, as taught by Stanbridge, and to include a motor mount for mounting the motor inside the housing, as taught by Kehoe, in order to provide a motor efficient motor (brushless being more efficient than a brushed motor) and to provide the required structural components to secure the motor inside the device (mount).

Regarding claim 8, the modified Rix device's motor mount includes first and second side walls that define a motor mount interior therebetween and the motor being secured to the first side wall and the second side wall is secured to the housing (see Kehoe Fig. 5-6, Fig. 6 showing the upper side of the motor mount 64 which is the second side wall, the underside which the motor is mounted to as shown in Fig. 5 being the first side wall, interior shown at 92, see also Fig. 12 showing similar sidewalls, Fig. 1 and 2 showing securing within the housing).

Regarding claim 19, the modified Rix device's first side wall includes at least a first flange extending outwardly therefrom and positioned adjacent a first protrusion on the motor (see Kehoe Fig. 4-6, flanges 84 extending outwardly from underside/first side wall and adjacent to protrusions 60 on the motor).

Regarding claim 20, the modified Rix device's first side wall includes second a third flanges extending outwardly therefrom and positioned adjacent second and third protrusions on the motor (see Kehoe Fig. 4-6 which shows first and second flanges 84 extending outwardly from underside/first side

wall and adjacent to first and second protrusions 60 on the motor, para. 0031 disclosing that there can be more than two flanges 84 and more than two protrusions 60 and thus discloses first, second and third flanges and protrusions).

20. Claims 7-9 and 18 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rix and Haas as applied to claim 1 above, and further in view of Stanbridge and Naughton et al. (2010/0162579).

Regarding claim 7, the modified Rix device is silent as to the motor explicitly being a brushless motor and a motor mount is positioned in the housing such that the motor is secured to the motor mount and the mount is secured to the housing; however, Stanbridge teaches a similar massage device which includes a brushless motor (see Stanbridge para. 0109), and Naughton teaches a similar device (note that Rix is a reciprocating saw converted to a massage device as discussed above) which includes a motor mount for mounting a motor to and mounting to the housing (see Naughton Fig. 8, motor mount element 68 which is shown in first and second side walls as shown in this figure, motor 65, all secured to the housing 42/44 as can be seen). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix device's motor to be a brushless motor, as taught by Stanbridge, and to include a motor mount for mounting the motor inside the housing, as taught by Naughton, in order to provide a motor efficient motor (brushless being more efficient than a brushed motor) and to provide the required structural components to secure the motor inside the device (mount).

Regarding claim 8, the modified Rix device's motor mount includes first and second side walls that define a motor mount interior therebetween and the motor being secured to the first side wall and the second side wall is secured to the housing (see Naughton Fig. 8, first and second side walls being each half element 68 with interior as shown).

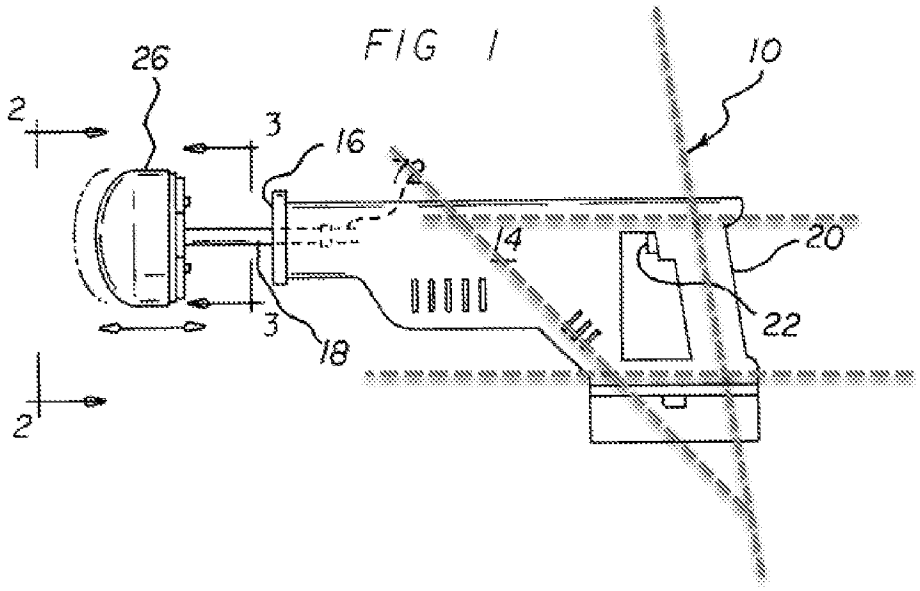
Regarding claim 9, the modified Rix device's motor includes a shaft (Naughton Fig. 8 with shaft of motor 65 as shown and including element 210) that extends through a protrusion opening defined in the first side wall of the motor mount and into the interior and at least a portion of the push rod assembly being positioned in the motor mount interior (see Naughton Fig. 8 which shows shaft 210 extending through a protrusion opening at element 310 with portion 230 of push rod assembly 235 also positioned in the motor mount interior, see also Fig. 7).

Regarding claim 18, the modified Rix device's push rod assembly extends through a push rod opening defined in the motor mount and out of the motor mount interior (see Naughton Fig. 8, push rod opening adjacent element 230 in this figure, see also Fig. 7).

21. Claim 24 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rix in view of Haas, Pepe (2017/0304145), and Calvert (7,041,072).

Regarding claim 24, the use of the Rix device includes a method of using a percussive massage device (see Fig. 1-5 and abstract for example), which includes obtaining the percussive massage device (see Fig. 1), the device including a housing 14 that includes first, second and third handle portions, with first, second and third axes, that cooperate to define a handle opening (see annotated Fig. 1 below which has labeled 4 different axes, each one of these defined by handle portions as shown, thus a possibility of first through fourth handle portions, the portions are handle portions as they are capable of being grasped by a user), a motor positioned in the housing (see Fig. 1 and col. 2 ln. 23-27, col. 4 ln. 54-58, motor 72), a switch for activating the motor (see Fig. 1 and col. 3 ln. 65-67, switch 22), and a push rod assembly operatively connected to the motor and configured to reciprocate in response to activation of the motor (see Fig. 1, push rod assembly 18, see col. 2 ln. 23-27 and col. 4 ln. 54-58 for example), activating the motor using the switch and grasping the first handle portion and massaging a first body portion (see annotated Fig. 1 below, a first handle portion such as the portion at 20, switch 22

is actuated to activate the motor per col. 3 ln. 65-67, and the ordinary use of the device would provide massage to at least a first body portion). Rix teaches that the device is an electrical saw converted to be a massager (see col. 1 ln. 30-36 and col. 3 ln. 63) and as such one would expect that the device would have an electrical source; however, Rix is silent as to explicitly including this feature. Haas teaches a similar device (note that the device of Rix is a reciprocating saw converted to be a massager as discussed above) which includes an electrical source (see Haas para. 0021). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the Rix method's device to explicitly include an electrical source, as taught by Haas, in order to provide the required elements to power the device, i.e. electrical source. The now modified Rix is silent as to explicitly grasping the second and third handle portions and massaging the first body part; however, Pepe teaches a similar percussive massage device which includes plural handle portions which are intended to be grasped (see Pepe Fig. 1 and para. 0024, handle portions 12 and 14 intended to be grasped by the user) and Calvert teaches a similar massage device which includes a handle which is intended to be grasped in various positions depending on the particular treatment being given (see Calvert col. 4 ln. 25-47). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix method to include grasping the second and third handle portions and massaging the body part, as taught by Pepe and Calvert, in order to provide the ability to provide the required gripping positions depending on the particular treatment being given (see Calvert col. 4 ln. 25-28).



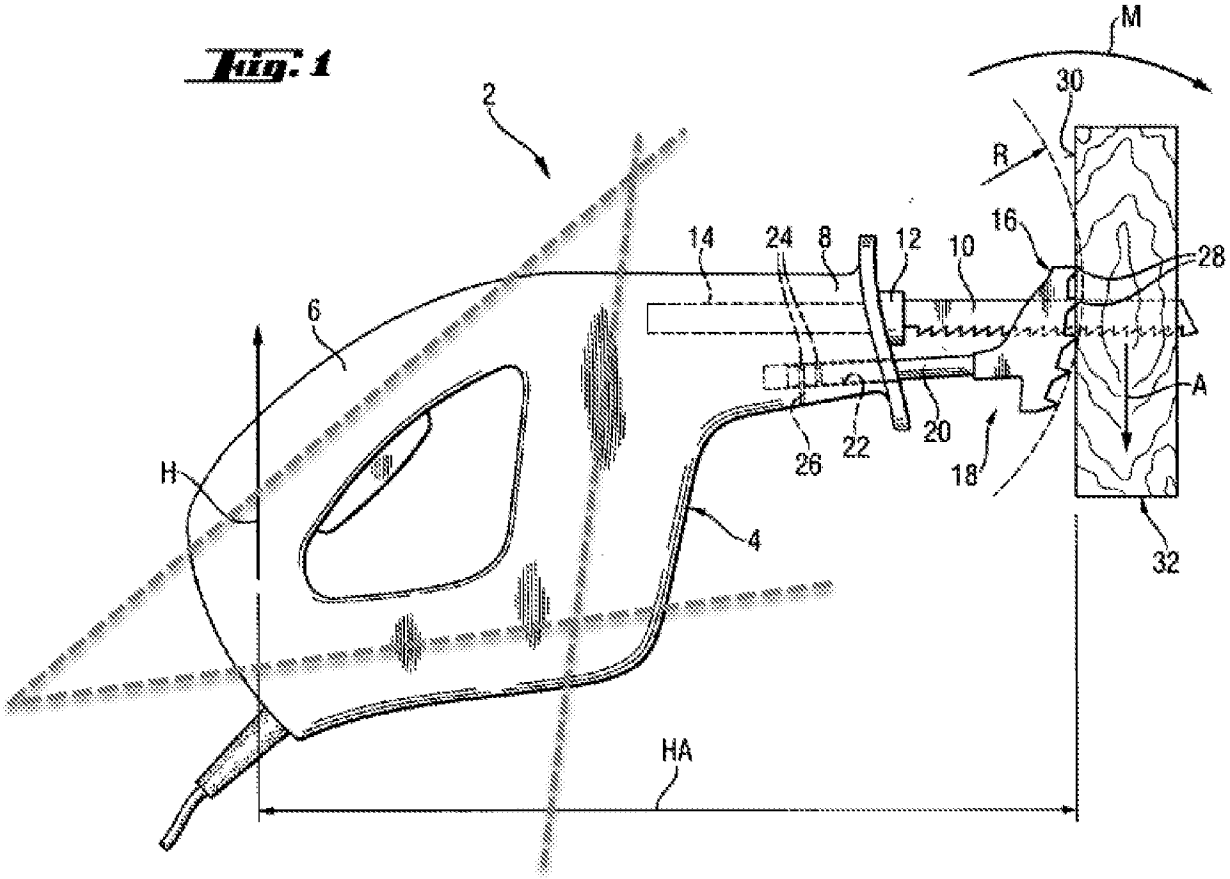
22. Claims 24-27 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rix in view of Haas, Neumeier (2005/0252011), and Calvert.

Regarding claim 24, the use of the Rix device includes a method of using a percussive massage device (see Fig. 1-5 and abstract for example), which includes obtaining the percussive massage device (see Fig. 1), the device including a housing 14 that includes first, second and third handle portions, with first, second and third axes, that cooperate to define a handle opening (see annotated Fig. 1 above which has labeled 4 different axes, each one of these defined by handle portions as shown, thus a possibility of first through fourth handle portions, the portions are handle portions as they are capable of being grasped by a user), a motor positioned in the housing (see Fig. 1 and col. 2 ln. 23-27, col. 4 ln. 54-58, motor 72), a switch for activating the motor (see Fig. 1 and col. 3 ln. 65-67, switch 22), and a push rod assembly operatively connected to the motor and configured to reciprocate in response to

activation of the motor (see Fig. 1, push rod assembly 18, see col. 2 ln. 23-27 and col. 4 ln. 54-58 for example), activating the motor using the switch and grasping the first handle portion and massaging a first body portion (see annotated Fig. 1 above, a first handle portion such as the portion at 20, switch 22 is actuated to activate the motor per col. 3 ln. 65-67, and the ordinary use of the device would provide massage to at least a first body portion). Rix teaches that the device is an electrical saw converted to be a massager (see col. 1 ln. 30-36 and col. 3 ln. 63) and as such one would expect that the device would have an electrical source; however, Rix is silent as to explicitly including this feature. Haas teaches a similar device (note that the device of Rix is a reciprocating saw converted to be a massager as discussed above) which includes an electrical source (see Haas para. 0021). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the Rix method's device to explicitly include an electrical source, as taught by Haas, in order to provide the required elements to power the device, i.e. electrical source. The now modified Rix is silent as to explicitly grasping the second and third handle portions and massaging the first body part; however, Neumeier teaches a similar device (note that the device of Rix is a reciprocating saw converted to be a massager as discussed above) which includes plural gripping surfaces (see Neumeier Fig. 1 and para. 0018, main handle grip 6 and additional grip at 8) and Calvert teaches a similar massage device which includes a handle which is intended to be grasped in various positions depending on the particular treatment being given (see Calvert col. 4 ln. 25-47). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix method to include grasping the second and third handle portions and massaging the body part, as taught by Neumeier and Calvert, in order to provide the ability to provide the required gripping positions depending on the particular treatment being given (see Calvert col. 4 ln. 25-28).

Regarding claim 25, the modified Rix method is silent as to the first, second, and third handle portions providing interior edges and defining lengths as claimed; however, Neumeier teaches a similar

device (note that the device of Rix is a reciprocating saw converted to be a massager as discussed above) which includes handle portions which have an interior edge with length which would allow for a user to grasp such that at least a portion of three fingers extend through the handle opening and contact the interior edge as claimed (see annotated Fig. 1 of Neumeier below which shows the axes defined by three different handle portions all of which define the handle opening via interior edges with lengths which would allow for the user to have at least a portion of three fingers extending therethrough and contacting the interior edge). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified Rix method's device's handle to be shaped, as taught by Neumeier, in order to provide a desired, ergonomic shape to the handle.



Regarding claim 26, the modified Rix method's housing includes a head portion with the motor positioned therein (see annotated Fig. 1 of Neumeier above and Fig. 1 of Rix, actuated output 18 of Rix is reciprocated via motor 72 which is located in a similar location as a head portion 8 of Neumeier).

Regarding claim 27, the modified Rix method includes at least two of the first, second, and third handle portions being generally straight (see annotated Fig. 1 of Neumeier above).

Double Patenting

23. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the claims that are directed to the same invention so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

24. Claim 1 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 16/890544 (reference application). This is a provisional statutory double patenting rejection since the claims directed to the same invention have not in fact been patented.

25. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(l)(1) - 706.02(l)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission.

For more information about eTerminal Disclaimers, refer to

www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

26. Claims 1, 24, and 25 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 6, 1, and 2 of U.S. Patent No. 10,702,448.

Although the claims at issue are not identical, they are not patentably distinct from each other because the patented claims include each structural and functional feature and claimed method steps but include additional limitations such that the patented claims are narrower versions of the instant claims and as such any infringement on the patented claims would result in infringement on the instant claims. Instant claim 1 corresponds to patent claim 6. Instant claim 24 corresponds to patent claim 1. Instant claim 25 corresponds to patent claim 2.

27. Claims 2-3, 22-23, and 26-27 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 6-7 and 2 of U.S. Patent No. 10,702,448 in view of Rix.

Regarding instant claim 2 and 26, patent claim 6, and 2, includes each first, second, and third handle portions as claimed, but is silent as to explicitly including a head portion with the motor therein; however, Rix teaches a similar device with handle portions and a head portion with the motor therein (see Rix Fig. 1, head portion being the part of the housing which houses motor 72). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the patent claim 6 device, claim 2 method to explicitly include a head portion to house the motor, as taught by Rix, in order to provide room for the required elements for operating the device.

Instant claim 3 corresponds to modified patent claim 6. Instant claims 22 and 23 correspond to modified patent claim 7. Instant claim 27 corresponds to modified patent claim 2.

28. Claim 17 is rejected on the ground of nonstatutory double patenting as being unpatentable over claim 8 of U.S. Patent No. 10,702,448 in view of Rix and Paul.

Regarding instant claim 17, the modified patent claim 8 includes a battery in the second handle portion, but is silent as to including a wireless charging receiver in electrical communication with the battery and positioned within the third handle portion; however, Paul teaches a similar device which includes wireless charging receiver for charging a battery (see Paul para. 0039). it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified patent claim 8 to include a wireless charging receiver in electrical communication with the battery, as taught by Paul, in order to provide the ability reuse the device after the battery has been drained without having to use another separate battery and it would have been obvious to provide this to the third handle portion as a matter of design choice.

29. Claim 4 rejected on the ground of nonstatutory double patenting as being unpatentable over claim 6 of U.S. Patent No. 10,702,448 in view of Marton.

Regarding instant claim 4, the patent claim 6 is silent as to including a wireless connection device; however, Marton teaches a similar device which includes a wireless connection device (see Marton Fig. 35 and col. 37 ln. 38 through col. 39 ln. 19 which discloses connection of the device with a remote electronic device via wireless connection). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the patent claim 6 to include a wireless connection device, as taught by Marton, in order to provide the ability to connect with a remote device for monitoring (Marton col. 37 ln. 38 through col. 39 ln. 19).

30. Claims 5 and 21 are rejected on the ground of nonstatutory double patenting as being unpatentable over claim 6 and 8 of U.S. Patent No. 10,702,448 in view of Paul.

Regarding instant claim 5, the patent claim 8 device is silent as to including a wireless charging receiver in electrical communication with the battery and positioned within the third handle portion; however, Paul teaches a similar device which includes wireless charging receiver for charging a battery (see Paul para. 0039). it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the modified patent claim 8 to include a wireless charging receiver in electrical communication with the battery, as taught by Paul, in order to provide the ability reuse the device after the battery has been drained without having to use another separate battery

Regarding instant claim 21, the patent claim 6 device is silent as to further including haptic feedback; however, Paul teaches a similar massage device which includes providing haptic feedback to the user (see Paul para. 0040). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the patent claim 6 to include providing haptic feedback to the user, as taught by Paul, in order to alert the user about information related to the operation of the device (see Paul para. 0040).

31. Claim 6 is rejected on the ground of nonstatutory double patenting as being unpatentable over claim 6 of U.S. Patent No. 10,702,448 in view of Roberts.

Regarding instant claim 6, the patent claim 6 is silent as to the device further including a touch screen; however, Roberts teaches a similar device which includes a touch screen to provide a user interface (see Roberts Fig. 1-2 and para. 0159). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the patent claim 6 to include a touch screen, as taught by Roberts, in order to provide a well-known data input tool/user interface to control the device (see Roberts para. 0150).

32. Claims 7-9 and 18 are rejected on the ground of nonstatutory double patenting as being unpatentable over claim 6 of U.S. Patent No. 10,702,448 in view of Stanbridge and Naughton.

Regarding instant claim 7, the patent claim 6 is silent as to the motor explicitly being a brushless motor and a motor mount is positioned in the housing such that the motor is secured to the motor mount and the mount is secured to the housing; however, Stanbridge teaches a similar massage device which includes a brushless motor (see Stanbridge para. 0109), and Naughton teaches a similar device which includes a motor mount for mounting a motor to and mounting to the housing (see Naughton Fig. 8, motor mount element 68 which is shown in first and second side walls as shown in this figure, motor 65, all secured to the housing 42/44 as can be seen). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the patent claim 6 motor to be a brushless motor, as taught by Stanbridge, and to include a motor mount for mounting the motor inside the housing, as taught by Naughton, in order to provide a motor efficient motor (brushless being more efficient than a brushed motor) and to provide the required structural components to secure the motor inside the device (mount).

Regarding instant claim 8, the modified patent claim 6's motor mount includes first and second side walls that define a motor mount interior therebetween and the motor being secured to the first side wall and the second side wall is secured to the housing (see Naughton Fig. 8, first and second side walls being each half element 68 with interior as shown).

Regarding instant claim 9, the modified patent claim 6's motor includes a shaft (Naughton Fig. 8 with shaft of motor 65 as shown and including element 210) that extends through a protrusion opening defined in the first side wall of the motor mount and into the interior and at least a portion of the push rod assembly being positioned in the motor mount interior (see Naughton Fig. 8 which shows shaft 210 extending through a protrusion opening at element 310 with portion 230 of push rod assembly 235 also positioned in the motor mount interior, see also Fig. 7).

Regarding instant claim 18, the modified patent claim 6's push rod assembly extends through a push rod opening defined in the motor mount and out of the motor mount interior (see Naughton Fig. 8, push rod opening adjacent element 230 in this figure, see also Fig. 7).

33. Claims 7 and 19-20 are rejected on the ground of nonstatutory double patenting as being unpatentable over claim 6 of U.S. Patent No. 10,702,448 in view of Stanbridge and Kehoe.

Regarding instant claim 7, the patent claim 6 is silent as to the motor explicitly being a brushless motor and a motor mount is positioned in the housing such that the motor is secured to the motor mount and the mount is secured to the housing; however, Stanbridge teaches a similar massage device which includes a brushless motor (see Stanbridge para. 0109), and Kehoe teaches a similar device (note that Rix is a reciprocating saw converted to a massage device as discussed above) which includes a motor mount for mounting a motor to and mounting to the housing (see Kehoe Fig. 4-8, motor 32, motor mount 64, Fig. 12, motor 232, motor mount 256, Fig. 1 showing the motor and mount secured within the housing). Thus it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the patent claim 6 motor to be a brushless motor, as taught by Stanbridge, and to include a motor mount for mounting the motor inside the housing, as taught by Kehoe, in order to provide a motor efficient motor (brushless being more efficient than a brushed motor) and to provide the required structural components to secure the motor inside the device (mount).

Regarding instant claim 19, the modified patent claim 6 first side wall includes at least a first flange extending outwardly therefrom and positioned adjacent a first protrusion on the motor (see Kehoe Fig. 4-6, flanges 84 extending outwardly from underside/first side wall and adjacent to protrusions 60 on the motor).

Regarding claim 20, the modified patent claim 6 first side wall includes second a third flanges extending outwardly therefrom and positioned adjacent second and third protrusions on the motor (see Kehoe Fig. 4-6 which shows first and second flanges 84 extending outwardly from underside/first side wall and adjacent to first and second protrusions 60 on the motor, para. 0031 disclosing that there can be more than two flanges 84 and more than two protrusions 60 and thus discloses first, second and third flanges and protrusions).

34. Claims 1 and 24 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1 and 15 of U.S. Patent No. 10,357,425.

Although the claims at issue are not identical, they are not patentably distinct from each other because patent claims 1 and 15 include each structural and functional feature and claimed method steps but include additional limitations such that the patented claims are narrower versions of the instant claims and as such any infringement on the patented claims would result in infringement on the instant claims. Instant claim 1 corresponds to patent claim 1. Instant claim 24 corresponds to patent claim 15.

35. Claim 1 is provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claim 1 of copending Application No. 16/869389 in view of Rix.

This is a provisional nonstatutory double patenting rejection.

Regarding instant claim 1, the copending claim 1 includes each structural and functional limitation as claimed, but is silent as to including a push rod assembly as claimed; however, Rix teaches a similar device which includes a push rod assembly as claimed (see Rix Fig. 1, push rod assembly 18, see col. 2 ln. 23-27 and col. 4 ln. 54-58 for example) and it would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to modify the copending claim 1

device to include a push rod assembly, as taught by Rix, in order to provide the required elements (i.e. push rod assembly with attached treatment structure) to provide the user with the massage.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Griner (2017/0156974), Wersland (2017/0027798), Zhang (2019/0175434), and Danby et al. (2015/0005682).

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to COLIN W STUART whose telephone number is (571)270-7490. The examiner can normally be reached on M-F: 9-5.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see https://ppair-my.uspto.gov/pair/PrivatePair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/COLIN W STUART/
Primary Examiner, Art Unit 3785