

IN THE PATENT AND TRADEMARK OFFICE

In re patent application of: WERSLAND, Jason, et. al. Serial No. 17/018,099 Filed: September 11, 2020 Title: PERCUSSIVE THERAPY DEVICE	Confirmation No. 2849 Group Art Unit: 3785 Examiner: Stuart, Colin W. Customer No. 24,574 Docket No. 76840-5090
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AMENDMENT

Please amend the above-identified application, without prejudice, as follows:

Amendments to the Claims begin on page 2 of this paper.

Remarks begin on page 7 of this paper.

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

What is claimed is:

1. (currently amended) A percussive therapy device comprising:

a housing,

an electrical source,

a motor positioned in the housing,

a switch for activating the motor,

a push rod assembly operatively connected to the motor and configured to reciprocate in response to activation of the motor,

an attachment connected to a distal end of the push rod assembly, wherein the attachment is configured to be percussively applied to at least a first muscle, wherein percussive application of the attachment to the first muscle naturally causes the temperature of the first muscle to rise from a starting temperature,

a temperature sensor, and

a routine controller that is configured to initiate a protocol configured to provide user instructions to apply the attachment to the first muscle until the temperature sensor senses that the first muscle has reached a predetermined temperature as a result of percussive application of the attachment, wherein the predetermined temperature is above the starting temperature, and wherein once the predetermined temperature has been reached, user instructions are provided to apply the attachment to a second muscle.

2. (original) The percussive therapy device of claim 1 wherein the motor is a brushless motor with a rotatable motor shaft, wherein the percussive therapy device further comprises a motor mount positioned in the housing, wherein the motor mount includes a mounting wall having a shaft opening defined therein, wherein the motor is mounted to the mounting wall and the motor shaft extends through the shaft opening, wherein first and second mounting flanges extend from and extend perpendicular to the mounting wall, and wherein the first and second mounting flanges are secured to opposite sides of the housing.

3. (previously presented) A percussive therapy device comprising:

a housing,

an electrical source,

a motor positioned in the housing, wherein the motor is a brushless motor with a rotatable motor shaft,

a motor mount positioned in the housing, wherein the motor mount includes a mounting wall having a shaft opening defined therein, wherein the motor is mounted to the mounting wall and the motor shaft extends through the shaft opening, wherein first and second mounting flanges extend from and extend perpendicular to the mounting wall, and wherein the first and second mounting flanges are secured to opposite sides of the housing, wherein a first boss member extends outwardly from the first mounting flange and a second boss member extends outwardly from the second mounting flange, wherein the housing includes a first housing portion and a second housing portion, wherein a first mounting member that defines a first opening is defined in the first housing portion, wherein a second mounting member that defines a second opening is defined in the second housing portion, wherein the first boss member extends through the first opening, wherein the second boss member extends through the second opening, wherein a first threaded fastener secures the first boss member to the first housing portion, and wherein a second threaded fastener secures the second boss member to the second housing portion

a switch for activating the motor, and

a push rod assembly operatively connected to the motor and configured to reciprocate in response to activation of the motor.

4. (previously presented) The percussive massage device of claim 3 wherein a first cylindrical dampening member that includes a first annular groove defined in an outer surface thereof is received on the first boss member, wherein a ring portion of the first mounting member is received in the first annular groove, wherein a second cylindrical dampening member that includes a second annular groove defined in an outer surface thereof is received on the second boss member, and wherein a ring portion of the second mounting member is received in the second annular groove.

5. (currently amended) The percussive therapy device of claim 1 further comprising a screen positioned on the housing, wherein the temperature sensor comprises ~~and~~ an infrared thermometer module positioned in the housing, wherein a temperature opening through which an infrared beam is configured to be emitted is defined in the housing, and wherein a temperature reading of a body part that is generated by the infrared thermometer module is configured to be displayed on the screen.

6-7. canceled

8. (previously presented) The percussive therapy device of claim 1 further comprising a heart rate monitor.

9. (previously presented) The percussive therapy device of claim 8 wherein the heart rate monitor is positioned on a first handle portion.

10. (previously presented) The percussive therapy device of claim 9 wherein the heart rate monitor is positioned on a top surface of the first handle portion and is configured to shine light onto a user's palm to monitor heart rate.

11. (previously presented) The percussive therapy device of claim 9 wherein the heart rate monitor includes first and second pulse contacts positioned on the first handle portion.

12. (previously presented) The percussive therapy device of claim 11 wherein the first pulse contact is positioned on a top surface of the first handle portion and the second pulse contact is positioned on a bottom of the first handle portion.

13. (previously presented) The percussive therapy device of claim 1 further comprising a male or female attachment member on a distal end of the push rod assembly, wherein the male or female attachment member includes a heating element therein.

14. (previously presented) The percussive therapy device of claim 1 further comprising a male or female attachment member on a distal end of the push rod assembly, wherein the male or female attachment member includes a first set of electrical contacts.

15. canceled.

16. (currently amended) The percussive therapy device of claim ~~[[15]]~~ 14 wherein the attachment member is a male attachment member that includes first and second balls biased outwardly therefrom, wherein the first and second balls are the first set of electrical contacts.

17. (previously presented) The percussive therapy device of claim 1 further including a software application executable on a mobile device that is configured to control the operation of the percussive therapy device, wherein the software application includes routines that are accessed based on scanning a scannable member with the mobile device.

18-19. canceled

20. (new) The percussive therapy device of claim 1 wherein the attachment does not include a heating element therein

REMARKS

In this amendment, claims 1, 5 and 16 have been amended, claim 20 has been added and no claims have been canceled. Accordingly, claims 1-5, 8-14, 16, 17 and 20 remain pending in the present application.

ALLOWABLE SUBJECT MATTER

Applicant thanks the Examiner for allowing claims 3-4.

INTERVIEW

Applicant thanks the Examiner for extending the courtesy of an interview on September 14, 2021. During the interview proposed amendments to the claims were discussed. The Examiner indicated that the amendment regarding warming up "naturally," which differentiated from the heated attachment of Pepe, was heading in the right direction.

REJECTIONS UNDER 35 U.S.C. § 112

Claim 5 was rejected for not complying with the written description requirement as the Examiner considered the infrared thermometer to be "an additional temperature sensor device" due to the inclusion of "a temperature sensor" in claim 1. Applicant disagrees. However, to move prosecution forward, claim 5 has been amended to address the issue.

Claim 16 was rejected for being indefinite. Claim 16 has been amended to overcome the rejection.

REJECTIONS UNDER 35 U.S.C. §§ 103

The Examiner has rejected claims 1-2 as being anticipated by Pepe (US 2017/0304145) in view of Marton (US 10,314,762), Goldstein (2018/0008512) and DeBenedictis (US 2015/0216719), claim 5 as being obviousness over Pepe, Marton, Goldstein, DeBenedictis in view of Pepe '306 (US 2020/0261306) and Bohm (US 2012/0078071), claim 8 as being

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obviousness over Pepe, Marton, Goldstein, DeBenedictis and Avni (2009/0112134), claims 9 and 11-12 as being obviousness over Pepe, Marton, Goldstein, DeBenedictis, Avni and further in view of Gomez (US 2020/0179210), claim 10 as being obviousness over Pepe, Marton, Goldstein, DeBenedictis, Avni and Gomez in view of Bardha (US 2007/0129220), claim 13 as being obviousness over Pepe, Marton, Goldstein, DeBenedictis and further in view of Pepe '594 (2020/0268594), claims 14 as being obviousness over Pepe, Marton, Goldstein, DeBenedictis, Pepe '594 and further in view of Giraud (US 2015/0305969), claim 16 as being obviousness over Pepe, Marton, Goldstein, DeBenedictis Pepe '594 and Giraud and further in view of Estes (US 2009/0326540), and claim 17 as being obviousness over Pepe, Marton, Goldstein, DeBenedictis, Dematio (2014/0207032) and Konik (US 2016/0346163).

Claim 1 has been amended to recite "wherein percussive application of the attachment to the first muscle naturally causes the temperature of the first muscle to rise from a starting temperature." A person of ordinary skill in the art would understand that the use of the term "warm up" within the sentence "This can be used to be sure that a body part has been warmed up properly prior to exercise," is related to warming up the body part or muscle using the body's natural ability to "warm" a muscle. Furthermore, a person of ordinary skill in the art would understand that the application of the attachment of a percussive massage device naturally causes the temperature of the muscle to rise as a result of natural processes in the human body. See, e.g., <https://www.verywellfit.com/how-to-warm-up-before-exercise-3119266>, which states "Here are the specifics of what happens to your body during a warm-up:

- **Blood temperature rises:** The temperature of blood increases as it travels through the muscles. As blood temperature goes up, the binding of oxygen to hemoglobin weakens so oxygen is more readily available to working muscles, which may improve endurance.
- **Muscle temperature increases:** Warm muscles both contract more forcefully and relax more quickly, reducing the risk of overstretching a muscle and causing injury. Your overall body temperature also increases, which improves muscle elasticity; this can enhance speed and strength."

Paragraph [00276] provides for support for the treatment protocols being used for natural "warm up" without the use of a heated attachment. Paragraph [00276] states "In a preferred

embodiment, the temperature reading capability is integrated with and a part of the treatment routines or protocols described herein. For example, instead of a routine or a step within a routine running or extending for a predetermined period of time, the routine or step (i.e., the amount of time a particular muscle or body part is treated or targeted) can extend until the muscle or body part (referred to generally herein as a body part) reaches a predetermined temperature. Accordingly, reaching a predetermined temperature can be substituted for predetermined period of time for any of the routines discussed herein. For example, step 1526 in FIG. 46C can be substituted with the method 1500 applies the device 400 is activated until a specified temperature is reached. This can be used to be sure that a body part has been warmed up properly prior to exercise. Therefore, in use, the temperature will rise from a starting temperature to a predetermined finishing temperature and the routine can then go to the next step or end. There also may be a number of "temperature steps" that are each part of the a routine. For example, in the first step, the muscle may go from the starting temperature and move to a second temperature. The next step may treatment and temperature reading from the second temperature to a higher third temperature. The temperature range between the starting and the finish temperature within the routine may also be different for each user. Furthermore, haptic feedback or other notification or instructions can be provided to let the user know when the finish temperature or predetermined temperature has been reached and they can move to the next step in the routine."

Accordingly, it is respectfully submitted that adding the term "naturally" to claim 1 defines over the teachings of Pepe, which includes a heating gel or heating element therein and provides "artificial heating" to the body part, as taught in paragraph [0029] of Pepe. In the interview discussed above, the Examiner indicated that he agreed that the term naturally defines over the heated attachment of Pepe. However, the Examiner mentioned that Pepe also disclosed a non-heated or "room temperature" attachment. The rejection of claim 1 prior to the addition of the term "naturally," was a combination of Pepe (for including many of the components of the percussive therapy device, as well as a heated attachment that will cause the muscle to heat up in use), in view of Marton (for an alleged routine controller), Goldstein (for providing instructions)

and DeBenedictis (for a controller for providing temperature readings to reach a target temperature on the user's body).

In determining obviousness, §103 expressly requires considering the claimed invention “as a whole.” Focusing the §103 inquiry on a particular aspect of the invention that differs from the prior art improperly disregards the “as a whole” statutory mandate. MPEP §2141.02. See *Jones v. Hardy*, 727 F.2d 1524, 1530 (Fed. Cir. 1984); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (The “as a whole” instruction in title 35 prevents evaluation of the invention part by part.... This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.”); *Princeton Biochemicals, Inc. v. Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005); *Allergan, Inc. v. Apotex, Inc.*, 754 F.3d 952 (Fed. Cir. 2014).

In the present situation, prior to the addition of the term "naturally," the Examiner included the DeBenedictis reference for "providing temperature readings," based on combining DeBenedictis with Pepe, and Pepe's teaching of a heated attachment. In short, the Examiner's position is that Pepe heats up the muscle with the heated attachment and DeBenedictis reads it. However, after addition of the term "naturally," the Examiner must once again look at the claimed invention "as a whole" and must not use hindsight reasoning ("using the invention as a roadmap to find its prior art components") to arrive at an obviousness rejection. Here, claim 1 requires "the temperature of the first muscle to [naturally] rise from a starting temperature" as a result of "percussive application of the attachment to the first muscle." Claim 1 also requires "a temperature sensor" that "senses [when] the first muscle has reached a predetermined temperature as a result of percussive application of the attachment." It is respectfully submitted that once the heated attachment of Pepe is removed from consideration based on the inclusion of "natural" warming up of the muscle, the prima facie case of obviousness breaks down if the claimed invention is considered "as a whole." A person of ordinary skill in the art would not look to the DeBenedictis reference and its alleged teaching of a controller for providing temperature readings to reach a target temperature on the user's body (based on "artificial heating"). In short, although the "room temperature" attachment may cause the muscle to warm up during use, there

is no recognition or teaching regarding this in Pepe, so why would a skilled artisan be led to DeBenedictis and its teaching of a temperature sensor. None of the other cited references make up for the deficiencies of Pepe and DeBenedictis.

Accordingly, withdrawal of the 103 rejection is respectfully requested.

Claim 20 has been added and recites "wherein the attachment does not include a heating element therein," to further distinguish over the Pepe reference.

Lastly, with respect to all rejections not specifically discussed or addressed herein, Applicant hereby disagrees with all of the Examiner's reasoning and discussion and concedes nothing.

REQUEST FOR TELEPHONE CONFERENCE

If after considering this Amendment, the Examiner believes that the claims are not allowable, Applicant requests that the Examiner please contact their authorized representative identified below by phone prior to issuing any further Office action for the purpose of hopefully resolving any such issue.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

It is believed that no additional fee is due for submitting this response. However, in the event a fee is required, the Commissioner is authorized to charge any amounts due or credit any overpayments in connection with this matter to Deposit Account No. 10-0440.

Respectfully submitted,

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Dated: September 15, 2021

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