

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYPER ICE INC.,
Petitioner

v.

THERABODY, INC.,
Patent Owner

Case PGR2026-00051
U.S. Patent No. 12,396,919

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.207(a)**

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TABLE OF CONTENTS

II.	THE '919 PATENT	3
A.	Overview	3
B.	The '919 Patent Priority Date.....	10
1.	Continuity of disclosure	11
a.	The '081 Patent is not <i>necessary</i> for maintaining continuity of disclosure because intermediate family member '064 Patent is entitled to the direct benefit of the '424 Application.	12
b.	The '081 Patent's incorporation-by-reference of the '424 Application is sufficient to maintain continuity of disclosure.	15
2.	Sufficiency of the '424 Application's disclosure	17
C.	Level of Skill in the Art.....	22
D.	Claim Construction.....	23
III.	OVERVIEW OF THE CITED PRIOR ART	24
A.	Hu '965	24
B.	Hu '951	27
C.	Pepe	31
D.	Huang	33
E.	Marton	34
F.	Hypervolt.....	37
IV.	LEGAL STANDARDS	38
V.	ARGUMENTS AGAINST INSTITUTION.....	39
A.	The Petition does not establish that Hypervolt is even prior art, or that Hypervolt and Hu '951 render obvious claims 1, 3, 4, and 7–11 (Ground 6, Claims 1, 3, 4, and 7–11).	39
1.	Petitioner fails to establish that the Hypervolt product is prior art or even place it in evidence.....	39
2.	Petitioner's proposed modification of Hypervolt in view of Hu '951 is not based in the teachings of the references.	43

B.	Hu '965 is not prior art, and the proposed modifications are not supported by Petitioner's evidence (Ground 2, claims 1–6, 9–11, and 14–20).....	48
1.	Hu '965 is not prior art.....	48
2.	Petitioner's proposed modification of Hu '965 in view of Hu '951 is not supported by the evidence Petitioner relies on for this Ground.	49
C.	Petitioner's proposed combination of Pepe, Hu '951, and Huang omits key elements from each independent claim (Ground 4, claims 1–6, 9–11, and 14–20).....	52
1.	“the handle portion... intersects... the motor axis” in claims 2 and 18 is missing from the combination.....	52
2.	“the reciprocation axis extends... on a dividing plane” in claim 1 and “the reciprocation axis extends on a dividing plane” in claims 2 and 18 are missing from the combination.	55
3.	“a motor positioned in the housing” in claim 1 is missing from the combination.....	57
D.	Petitioner's extensive inconsistencies among the Grounds are fatal to certain dependent claim challenges (Grounds 3 and 5, claims 7, 8, 12, and 13).....	59
E.	The claims satisfy the written description requirement (Ground 1, Claims 1–20).	62
1.	The disclosure supports “a proximal end of the push rod assembly is connected to the eccentric shaft at a location offset from the dividing plane in a first direction.”	63
2.	The disclosure supports “the handle portion axis extends at an oblique angle to the reciprocation axis and intersects ... the motor axis.”	68
3.	The disclosure supports “the common plane bisects the housing.”	72
4.	The disclosure supports “a battery housed in the handle portion.”	73
5.	The disclosure supports a “handle.”	74
6.	The disclosure supports “a housing comprises a first portion ... [and] a second portion.”	75

VI. THE PETITION’S DEFICIENCIES WARRANT DENIAL UNDER <i>CHEVRON</i> AND <i>DEEPER</i>	78
VII. CONCLUSION.....	79

PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	Amended Complaint for Patent Infringement, <i>Therabody, Inc. v. Hyper Ice, Inc.</i> , Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), February 25, 2026
2002	Demand Letter from Therabody, Inc. to Hyper Ice, Inc., December 10, 2025
2003	Second Amended Complaint for Patent Infringement, <i>Hyper Ice, Inc. v. Therabody, Inc.</i> , Case No. 8:25-cv-01939-JVS-KES (C.D. Cal.), September 29, 2025
2004	U.S. District Court Judicial Caseload Profile, December 31, 2025
2005	Scheduling Order, <i>Therabody, Inc. v. Hyper Ice, Inc.</i> , Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), May 8, 2026
2006	Defendant Hyper Ice, Inc.'s Invalidity Contentions, <i>Therabody, Inc. v. Hyper Ice, Inc.</i> , Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), July 6, 2026
2007	First Amended Complaint for Patent Infringement, <i>Hyper Ice, Inc. v. Therabody, Inc.</i> , Case No. 8:24-cv-00390-JWH-DFM (C.D. Cal.), September 12, 2024
2008	First Amended Complaint, <i>Therabody, Inc. v. Hyper Ice, Inc.</i> , Case No. 8:24-cv-00378-MEMF-DFM (C.D. Cal.), May 30, 2024
2009	U.S. Patent Application Publication No. 2019/0254922 A1 to Marton et al. ("Marton '922"), published August 22, 2019
2010	Pending claims filed January 21, 2026, in U.S. Patent Application No. 19/295,322
2011	Therabody, Inc.'s Patent L.R. 3.1 Disclosure of Asserted Claims and Infringement Contentions, <i>Therabody, Inc. v. Hyper Ice, Inc.</i> , Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), May 22, 2026

Exhibit No.	Description
2012	Second Amended Complaint for Patent Infringement, <i>Hyper Ice, Inc. v. Therabody, Inc.</i> , Case No. 8:24-cv-02034-JWH-DFM (C.D. Cal.), March 12, 2025
2013	Final Office Action in U.S. Patent Application No. 17/244,239, mailed January 28, 2022
2014	Non-Final Office Action in U.S. Patent Application No. 17/018,099, mailed November 16, 2021
2015	Final Office Action in U.S. Patent Application No. 17/018,099, mailed July 19, 2021
2016	Non-Final Office Action in U.S. Patent Application No. 16/869,402, mailed July 28, 2020
2017	Non-Final Office Action in U.S. Patent Application No. 17/018,099, mailed March 10, 2021
2018	Prosecution History of U.S. Patent No. 10,857,064
2019	Plaintiff's Patent L.R. 4-2 Preliminary Claim Constructions and Extrinsic Evidence, <i>Therabody, Inc. v. Hyper Ice, Inc.</i> , Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), August 31, 2026

TABLE OF AUTHORITIES

Cases

<i>Allergan USA, Inc. v. MSN Lab 'ys Priv. Ltd.,</i> 111 F.4th 1358 (Fed. Cir. 2024)	65, 68
<i>Ariad Pharms., Inc. v. Eli Lilly & Co.,</i> 598 F.3d 1336 (Fed. Cir. 2010).....	63
<i>Chevron Oronite Co. LLC v. Infineum USA L.P.,</i> IPR2018-00923, Paper 9 (P.T.A.B. Nov. 7, 2018)	78
<i>Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.,</i> 635 F.3d 1373 (Fed. Cir. 2011).....	65, 68
<i>Deeper, UAB v. Vexilar, Inc.,</i> IPR2018-01310, Paper 7 (P.T.A.B. Jan. 24, 2019).....	78
<i>Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.,</i> 800 F.3d 1375 (Fed. Cir. 2015).....	48, 49
<i>Ex Parte Maziere,</i> 27 U.S.P.Q.2d 1705 (B.P.A.I. Jan. 26, 1993)	16
<i>Gemtron Corp. v. Saint-Gobain Corp.,</i> 572 F.3d 1371 (Fed. Cir. 2009).....	40
<i>Gentry Gallery, Inc. v. Berkline Corp.,</i> 134 F.3d 1473 (Fed. Cir. 1998).....	65, 66, 68
<i>Hulu, LLC v. Sound View Innovations, LLC,</i> IPR2018-01039, Paper 29 (P.T.A.B. Dec. 20, 2019)	41
<i>ICU Med., Inc. v. Alaris Med. Sys., Inc.,</i> 558 F.3d 1368 (Fed. Cir. 2009).....	65, 67, 68
<i>In re Magnum Oil Tools Int'l, Ltd.,</i> 829 F.3d 1364 (Fed. Cir. 2016).....	38, 39
<i>Maquet Cardiovascular LLC v. Abiomed, Inc.,</i> 627 F. Supp. 3d 72 (D. Mass. 2022)	15, 16, 69
<i>MaxLite, Inc. v. Jiaxing Super Lighting Elec. Appliance Co., Ltd.,</i> IPR2020-00208, Paper 10 (P.T.A.B. June 24, 2020).....	10
<i>Parus Holdings, Inc. v. Google LLC,</i> 70 F.4th 1365 (Fed. Cir. 2023)	41

<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005).....	23
<i>Purdue Pharma L.P. v. Faulding Inc.</i> , 230 F.3d 1320 (Fed. Cir. 2000).....	10
<i>Realtime Data, LLC v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. 2019).....	23
<i>ScriptPro LLC v. Innovation Assocs., Inc.</i> , 833 F.3d 1336 (Fed. Cir. 2016).....	66, 67
<i>Vas-Cath Inc. v. Mahurkar</i> , 935 F.2d 1555 (Fed. Cir. 1991).....	64
<i>Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.</i> , 200 F.3d 795 (Fed. Cir. 1999).....	24
<i>ZTE (USA), Inc. v. CyWee Group Ltd.</i> , IPR2019-00143, Paper 87 (P.T.A.B. Feb. 17, 2021).....	11, 17, 69

Statutes

35 U.S.C. § 102(a)(2).....	28, 32, 33, 48
35 U.S.C. § 112(a)	14, 17, 62
35 U.S.C. § 119(e)(1).....	14, 15
35 U.S.C. § 322(a)(3).....	38, 43
35 U.S.C. § 324(a)	39
35 U.S.C. § 326(b)	79
35 U.S.C. § 326(e)	39, 49
35 U.S.C. 282(b)	23

Regulations

37 C.F.R. § 1.57(d)	passim
37 C.F.R. § 1.78(a)(1)	14
37 C.F.R. § 1.78(a)(2)	14
37 C.F.R. § 1.78(a)(3)	14
37 C.F.R. § 42.200(b)	23
37 C.F.R. § 42.204(b)(4).....	38, 43

37 C.F.R. § 42.204(b)(5).....	40, 41
37 C.F.R. § 42.22(a)(2).....	41, 42
37 C.F.R. § 42.6(a)(3)	41, 42

Other Authorities

Interim Process Memo for PTAB Workload Management, March 26, 2025	79
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I. INTRODUCTION

Patent Owner respectfully submits that the Director should deny the Petition because Petitioner has not met its burden to show that any challenged claim of U.S. Patent No. 12,396,919 (“the ’919 Patent”) is more likely than not unpatentable.

Five of Petitioner’s eleven grounds and sub-grounds advance invalidity theories under 35 U.S.C. § 103. But the Office already considered *all* prior art now asserted in the Petition throughout the extensive prosecution of the ’919 patent. Petitioner’s effort to repackage that prior art has produced a scattershot of asserted grounds, each of which suffers from independent legal and factual defects.

First, Petitioner’s Ground 6, based on its own product, is a gratuitous hindsight redesign to meet the claims. That redesign is wholly unsupported by the asserted prior art. Instead, Petitioner relies almost exclusively on expert testimony. Neither the Petition nor Petitioner’s expert cite to any reference as teaching the redesign. The purported secondary reference, Hu ’951, is only cited once in connection with reasonable expectation of success; never as actually teaching any redesign or claim element.

Second, Petitioner’s Ground 2 fails at the threshold because it depends on Hu ’965, which is not prior art to any claim challenged in Ground 2. Every one of those claims is entitled to the filing date of a provisional application that predates Hu ’965. Petitioner’s attempt to break that priority chain relies on a manufactured

distinction between *disclosing* subject matter and showing *possession* of it, as well as a novel interpretation of 37 C.F.R. § 1.57(d) that finds no support in the caselaw and in any event would not affect the priority chain.

Third, Petitioner’s Ground 4 assumes a person of ordinary skill in the art (“POSITA”) would have modified Pepe by incorporating Huang’s drive mechanism with Pepe’s motor and linear output. But Pepe does not show its motor or any other internal mechanics. And neither reference explains how Huang’s drive mechanism for a *rocking* output could be adapted to produce Pepe’s *linear* output. This Ground further requires a POSITA to rearrange features within the proposed combination in highly specific ways that have no support in the cited references or the knowledge of a POSITA.

Fourth, Petitioner’s Grounds 3 and 5, both directed to a subset of dependent claims, purportedly build on the combinations asserted in Grounds 2 and 4. But Petitioner’s Grounds 3 and 5 use the underlying references in a manner that is irreconcilable with the interpretations it advances in Grounds 2 and 4. This is not merely a mistake in the Petition—those irreconcilable positions are used to justify the additional modifications. Petitioner needs the references to mean one thing to reach the independent claims and something different to reach the dependent ones, and it cannot have both. Moreover, because these dependent claim challenges depend on the same combinations, they fail with Grounds 2 and 4 in any event.

Finally, Petitioner consolidates *six* separate written description challenges into one Ground, covering an assortment of terms spanning multiple claims of the '919 patent. Each rests on the manufactured distinction noted above that requires an unduly narrow view of what a specification must contain to convey possession. Petitioner attempts to distinguish between *disclosing* subject matter and showing *possession* of it but provides no authority for a distinction that would invalidate any challenged claim—because there is none. Possession is shown by the disclosure; the two are not independent hurdles.

The Petition's *eleven* separate grounds and sub-grounds do not compensate for the defects in each. Individually, they are weak; collectively, they are inconsistent. The Petition fails to show that any challenged claim is more likely than not unpatentable.

II. THE '919 PATENT

A. Overview

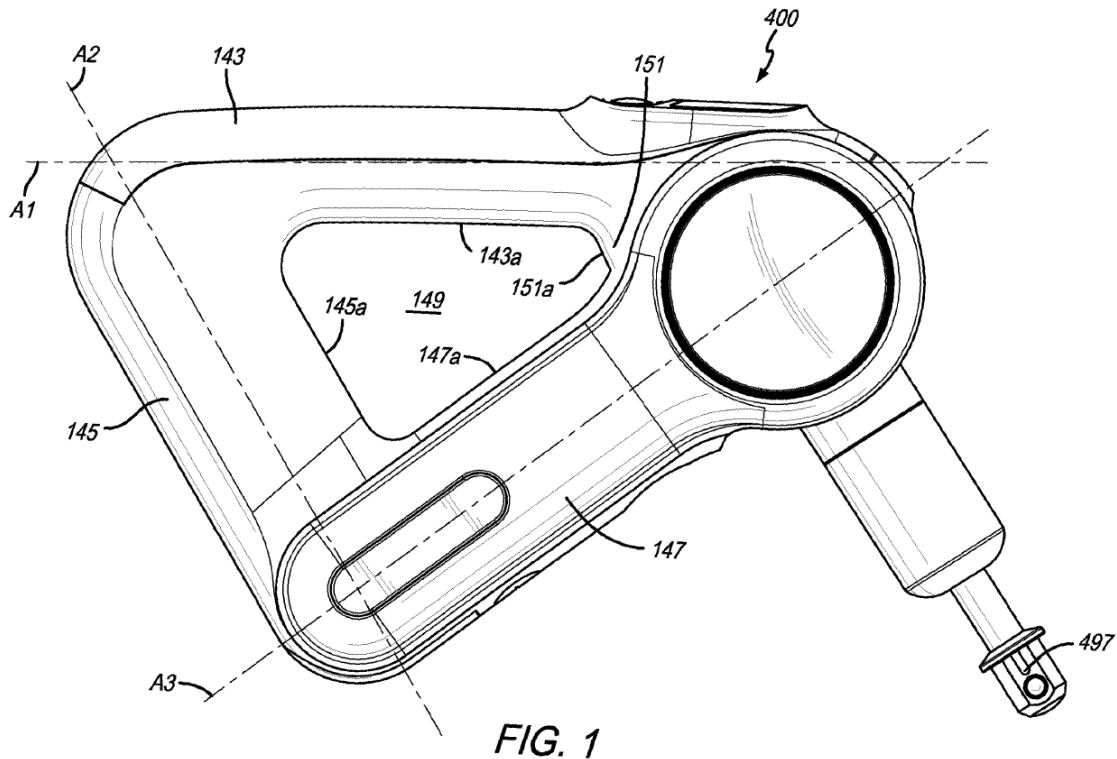
The '919 Patent represents one aspect of Patent Owner's nearly two decades of pioneering innovation in percussive massage therapy. The absence of effective tools in this field led Patent Owner's founder, Dr. Jason Wersland—then recovering from a motorcycle accident—to create a percussive therapy device in 2008. EX2008, 3. Dr. Wersland continued to refine the concept and launched the first Theragun as a commercial product in 2016. EX2008, 4.

Thus began a period of sustained innovation by Patent Owner. The Theragun has advanced through multiple generations, each introducing new inventive developments. The pace and breadth of that innovation is evident from the number of concepts disclosed in Patent Owner's applications.

Most pertinent to the Grounds in the Petition, on May 7, 2019, Patent Owner filed U.S. Provisional Application No. 62/844,424 ("the '424 Application") disclosing multiple embodiments reflecting different variations on the Theragun concept. EX1017, 62–98. Two of the categories of devices in the '424 application are described as "the G3" (or Generation 3) and "the G4" (or Generation 4). For example, "FIGS. 14–15 show an embodiment of a reciprocal treatment device 208 (referred to as the G3)," with variations on the G3 shown in FIGS. 16–27, while "FIGS. 28–38 show another embodiment of a percussive massage device 400 (sometimes referred to as the G4)." EX1017, 52–54. The '424 Application illustrates the G3 and G4 devices among a much larger set of drawings depicting other embodiments not assigned a generation number. EX1017, 62–98.

U.S. Application No. 18/809,073 ("the '073 Application"), which issued as the '919 Patent, claimed priority to the '424 Application through a series of subsequent non-provisional patents and applications, and many of the '424 Application's embodiments also appear in the '919 Patent. In the '919 Patent, "FIG. 1 shows an embodiment of a percussive massage device 400 that includes a

rechargeable battery... 114 (FIG. 19).” EX1001, 6:15–17. “[T]he percussive
massage device 400 includes three handle portions.” EX1001, 6:17–22. “[T]he first
handle portion 143 defines a first handle portion axis A1, the second handle
portion 145 defines a second handle portion axis A2 and the third handle portion
147 defines a third handle portion axis A3.” EX1001, 6:35–39.



EX1001, FIG. 1.

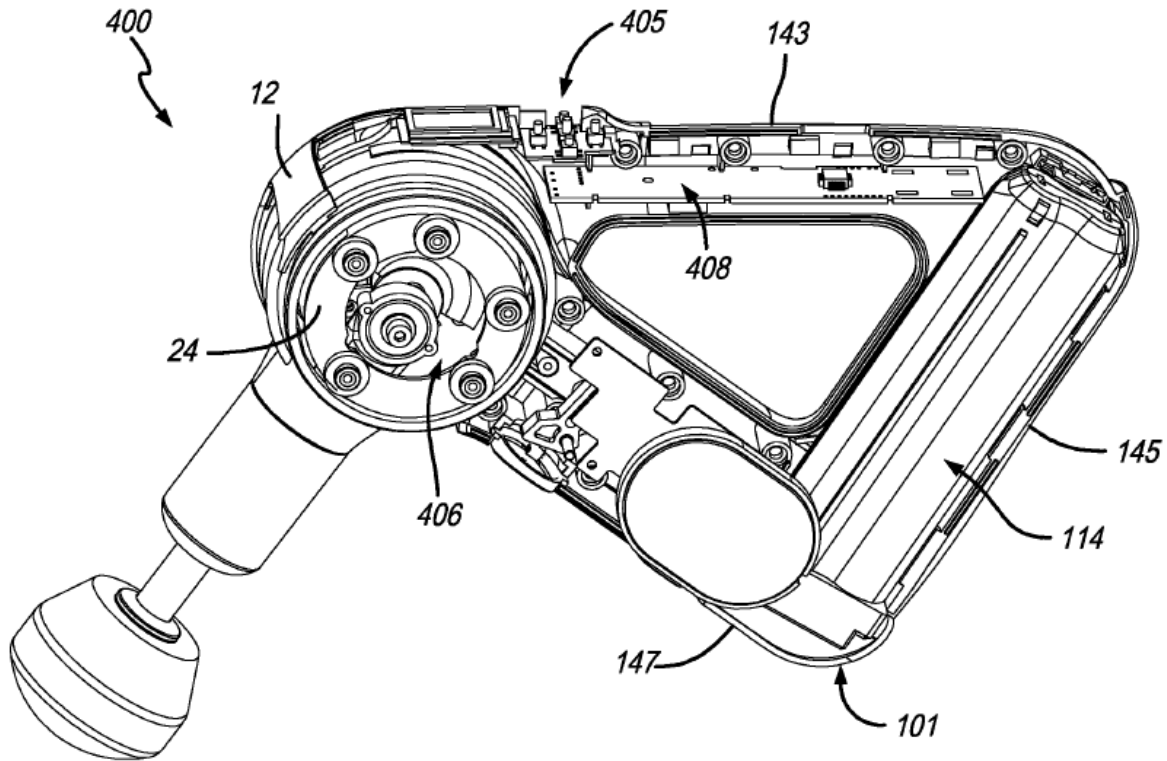


FIG. 19

EX1001, FIG. 19.

“The percussive massager device 400 can include a rotatable arm that is part of rotation housing 44. The motor 406 is located in the rotation housing 44, which is housed with the head portion 12 of the housing 101.” EX1001, 14:50–54.

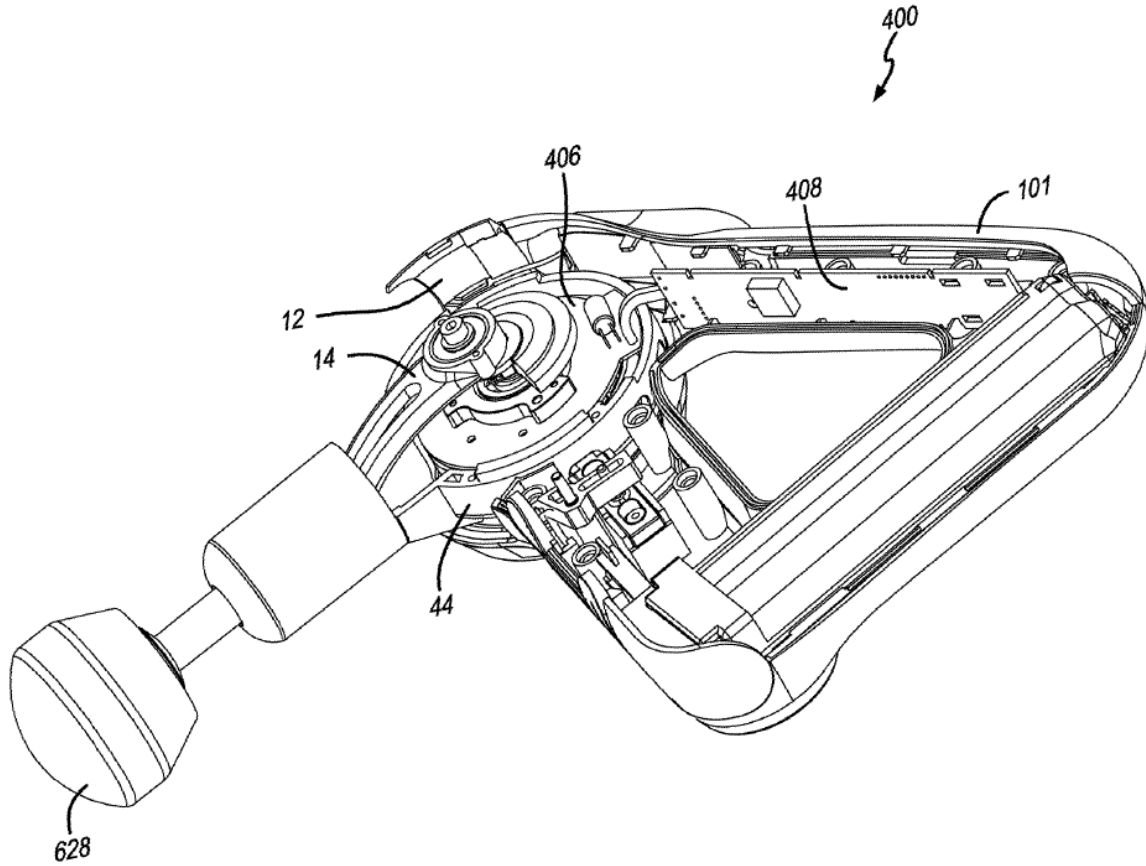


FIG. 21

EX1001, FIG. 21.

“[T]he device 400 includes a housing 101, an electrical source 114, a motor 406 positioned in the housing 101,” and “a switch... for activating the motor 406.”

EX1001, 16:66–17:4. The relevant embodiment includes a “touch screen 409, rocker button 447,” and “button 403,” one of which may be the aforementioned “switch.” *Id.*

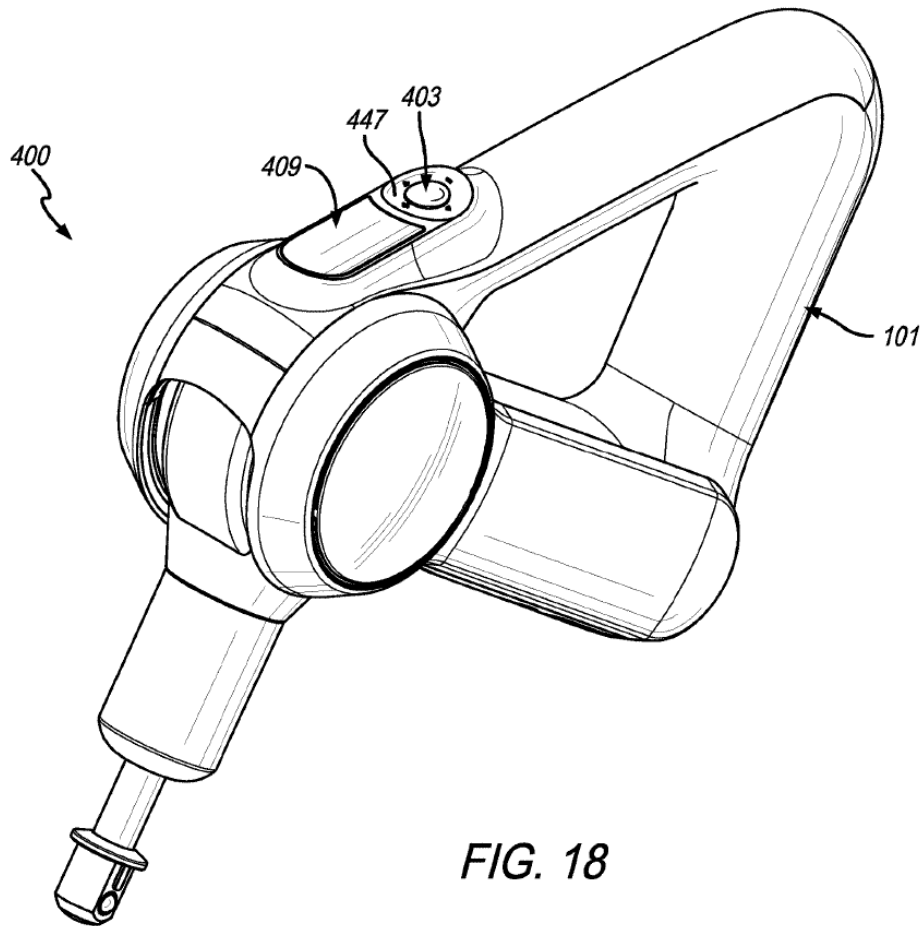
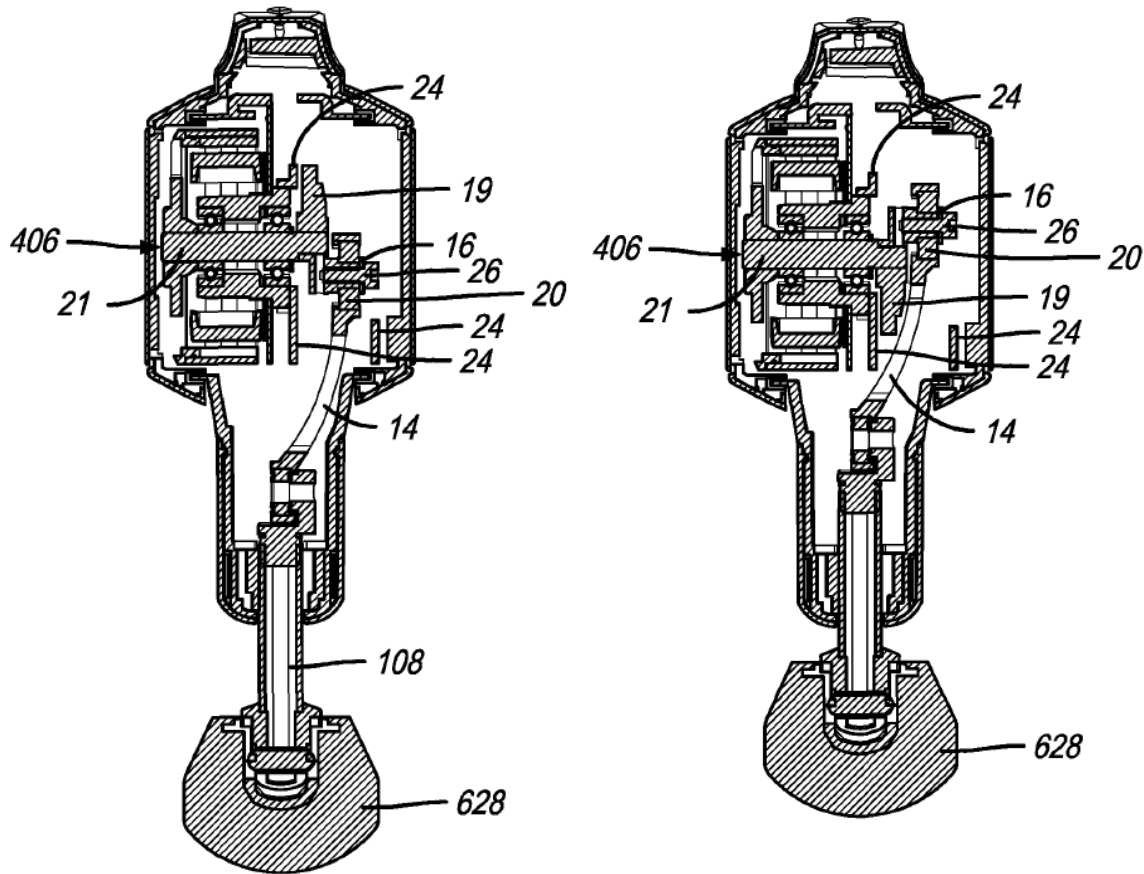


FIG. 18

EX1001, FIG. 18.

“[T]he device includes a push rod or shaft 14 that is connected directly to a shaft 16 that is rotated by the motor 406 and the motor shaft 21 extending therefrom. The shaft 16 can be part of a counterweight assembly 17 that includes a counterweight 19.” EX1001, 14:56–60. “[T]he push rod 14 is L-shaped or includes an arc shape Preferably, the point where the push rod 14 is connected to the shaft 16 is offset from the reciprocating path that the distal end 18 of the push rod 14 (and the massage attachment 628) travel. This capability is provided by the arc or L-shape.” EX1001, 14:60–66.



EX1001, FIGS. 22A and 22B.

The L-shape or arc shape of the push rod is “so the motor can be located at or near the middle of the device, otherwise a large protrusion would be necessary” EX1001, 14:66–15:6. “The arc also allows the push rod 14 to have a close clearance with the motor ... and allows the outer housing to be smaller than similar prior art devices” EX1001, 15:6–10.

“[O]ne or more bearings 20 are included at the proximal end of the push rod 14 where it connects to the motor The bearing 20 is received on the shaft 16.” EX1001, 15:12–18.

“[T]he term push rod assembly used herein includes any of the components discussed herein or combinations thereof, e.g., push rod 14, output shaft 108 ... that extend from the rotating motor shaft 21 ... that provide reciprocating motion and include the attachment on the distal end thereof. The push rod assembly also includes the male connector ... that allows connection of an attachment to be used for massage or therapy.” EX1001, 15:50–61.

Various combinations of these features appear in the claims.

B. The '919 Patent Priority Date

Petitioner has the burden to establish that a patent lacks priority to an earlier application from which priority was claimed, and must identify any and all elements of the claims that the petitioner believes lack written description support in any and all earlier applications. *See MaxLite, Inc. v Jiaying Super Lighting Elec. Appliance Co., Ltd.*, IPR2020-00208, Paper 10 (P.T.A.B. June 24, 2020). Adequate written description does not require *in haec verba* support for the claimed subject matter at issue. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000).

Petitioner argues that the claims of the '919 Patent are not entitled to the benefit of the filing date of the '424 Application for two reasons: an alleged break in continuity of disclosure through the chain of priority from the '424 Application to the '919 Patent, and an alleged lack of sufficient disclosure in the '424

Application itself. Petition, 28. Petitioner is wrong on both points. And Petitioner has not identified any other basis for disputing that any challenged claim of the '919 Patent has priority to the '424 Application.

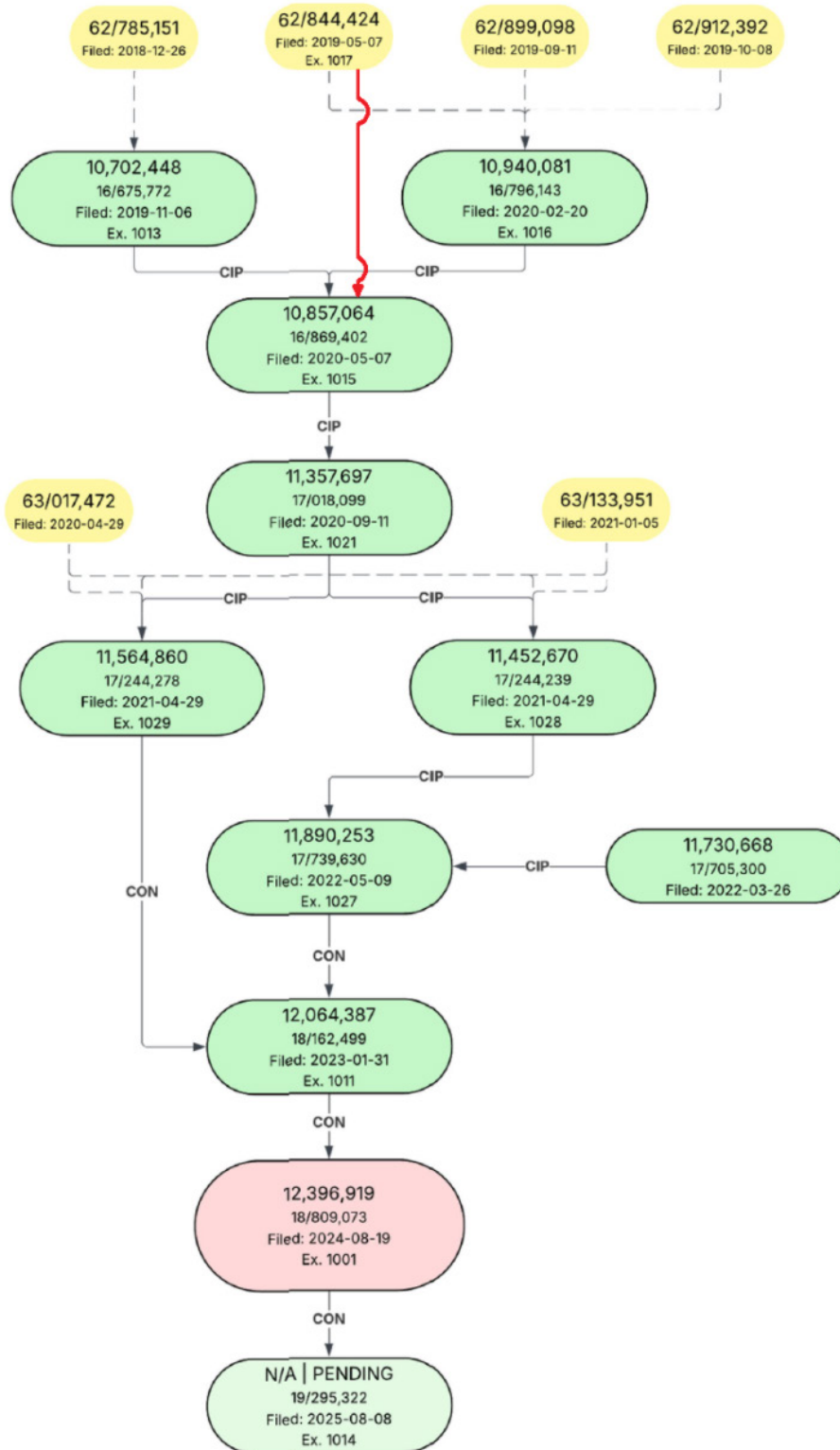
1. Continuity of disclosure

Petitioner contends that the immediate child of the '424 Application—U.S. Patent 10,940,081 (“the '081 Patent”)—breaks continuity because the '081 Patent did not expressly re-disclose Figures 28, 31, 32, and 35–38 of the '424 Application. Petition, 28–30. Petitioner concedes the '081 Patent incorporates the '424 Application by reference, but dismisses that incorporation as insufficient under 37 C.F.R. § 1.57(d) and *ZTE (USA), Inc. v. CyWee Group Ltd.*, IPR2019-00143, Paper 87 at 115–16 (P.T.A.B. Feb. 17, 2021).

Petitioner’s argument fails for at least two reasons. *First*, the '919 Patent claims priority to another intermediate family member, U.S. Patent No. 10,857,064 (“the '064 Patent”), which itself claims priority to (and was co-pending with) the '424 Application. Thus, no re-disclosure of subject matter in the '081 Patent was needed to maintain continuity of disclosure. *Second*, even if the disclosure in the '081 patent was relevant, its incorporation by reference of the '424 Application maintains continuity of disclosure.

- a. **The '081 Patent is not *necessary* for maintaining continuity of disclosure because intermediate family member '064 Patent is entitled to the direct benefit of the '424 Application.**

The relevant subject matter has continuity of disclosure through the chain of priority from the '424 Application to the '919 Patent because intermediate family member '064 Patent is entitled to the direct benefit of the '424 Application under both the statutory and regulatory requirements. Petitioner's family tree for the '919 Patent from the Petition is reproduced below, annotated in **red** to show the direct benefit overlooked by Petitioner.



Petition, 24 (annotated).

Section 119(e)(1) of 35 U.S.C. gives an application “the same effect ... as though filed on the date of the provisional application” where the later application (1) discloses the invention “in the manner provided by section 112(a),” (2) shares at least one inventor with the provisional, (3) is filed “not later than 12 months after” the provisional, and (4) contains a specific reference to it. 35 U.S.C. § 119(e)(1).

The applicable regulatory requirements are similar: the later-filed application must be “filed not later than twelve months after the date on which the provisional application was filed” and “must contain ... a reference to each such prior-filed provisional application ... included in an application data sheet,” and the “prior-filed application must name the inventor or a joint inventor named in the later-filed application.” 37 C.F.R. §§ 1.78(a)(1)–(3).

U.S. Patent Application No. 16/869,402 (“the ’402 Application”), which issued as the ’064 Patent, satisfies each statutory and regulatory condition. It was filed on May 7, 2020, exactly 12 months after the ’424 Application. EX2018, 1081. It named three of the same inventors as the ’424 Application: Jason Wersland, Benjamin Nazarian, and Jaime Sanchez Solana. EX2018, 1089–90; EX1017, 16. And it included specific reference to the ’424 Application in both the Application Data Sheet and the first paragraph of the specification. EX2018, 1092, 1149.

Accordingly, the '402 Application (and thus the '064 Patent) “**shall** have the same effect” as to inventions it commonly discloses with the '424 Application as though filed on the date of the provisional. 35 U.S.C. § 119(e)(1) (emphasis added). In other words, the '402 Application (as well as the resulting '064 Patent) has the *direct* benefit of the '424 Application.

The '081 Patent is therefore not *necessary* for continuity of disclosure. Petitioner cannot show a break in continuity from contents of a patent that is not necessary for priority purposes.

b. The '081 Patent's incorporation-by-reference of the '424 Application is sufficient to maintain continuity of disclosure.

Petitioner argues 37 C.F.R. § 1.57(d) precludes the '081 Patent from incorporating any “essential material” to the '919 Patent. Petition, 30, fn. 10. That is not how § 1.57(d) operates. Section 1.57(d) only prevents the '081 Patent from incorporating subject matter that is essential material *to the '081 Patent itself*. Here, the relevant subject matter is not essential material to the '081 Patent.

Persuasive caselaw contradicts Petitioner's interpretation of § 1.57(d). In *Maquet Cardiovascular LLC v. Abiomed, Inc.*, 627 F. Supp. 3d 72, 81–82 (D. Mass. 2022), the court rejected the very reading Petitioner advances. Specifically, the court determined the relevant inquiry under § 1.57(d) is whether the disclosure was “essential material” for the *intervening patents* in the middle of the chain of

disclosure. *Id.* at 81 (emphasis added). Stated another way, “[m]aterial that was nonessential and incorporated by reference in a preceding patent ***can later be called upon to serve as essential material for claims made in a later patent*** without compromising the continuity of disclosure,” even when the incorporated document is neither a patent nor a published application. *Id.* at 82 (emphasis added). Thus, an applicant is ““quite correct in not further burdening the record of that file by including the text which was incorporated by reference,’ even though that material would prove essential in the descendant patent.” *Id.* (quoting *Ex Parte Maziere*, 27 U.S.P.Q.2d 1705, 1993 WL 322908 at *3 (B.P.A.I. Jan. 26, 1993)).

Maquet’s interpretation is consistent with the language of Rule 1.57(d), which defines “essential material” with respect to what is necessary to provide written description of “the claimed invention” or “claimed means or step,” – referring to the claimed invention of the relevant patent, not a later claimed invention.

Thus, the relevant inquiry of what is “essential material” is answered based on the claims of the patent that includes the incorporation statement – *not* based on the claims of a descendent patent. And here, the subject matter in question is *not* essential to the ’081 Patent, which itself expressly discloses all material that is essential to its own claims. Any remaining material from the ’424 Application is therefore inessential to the ’081 Patent, and therefore eligible for incorporation by

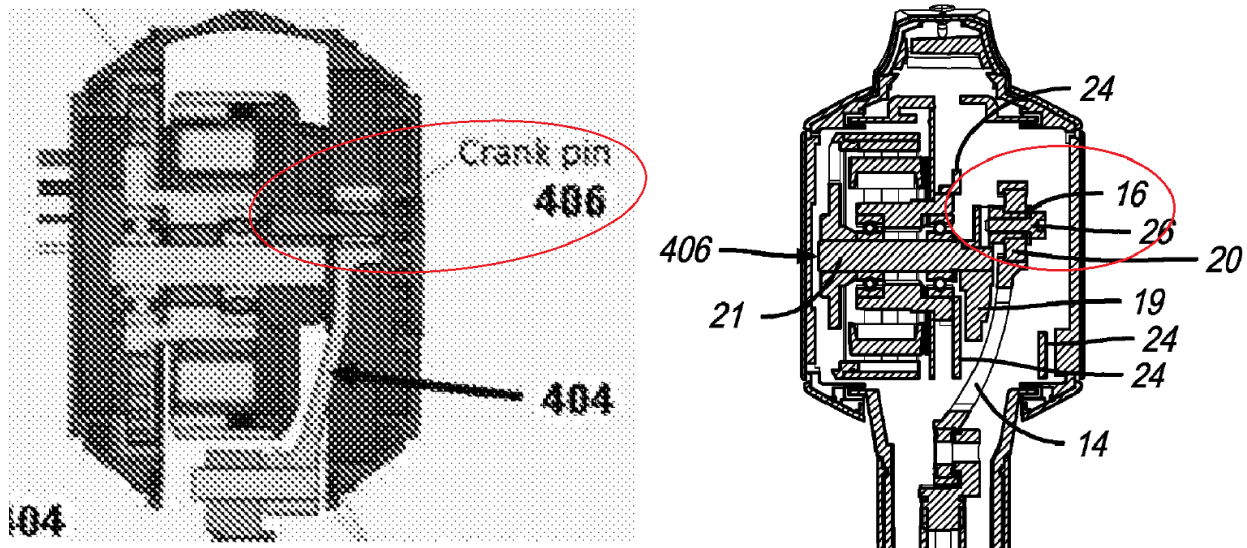
the '081 Patent.

In this regard, the Board decision in *ZTE (USA), Inc. v. CyWee Group Ltd.*, IPR2019-00143, Paper 87 (P.T.A.B. Feb. 17, 2021) differs from the facts presented here, and is entirely consistent with *Maquet* and the language of Rule 1.57(d). In *ZTE*, unlike here, the Patent Owner attempted to rely on incorporation by reference to incorporate subject matter that would have been essential to a claim in the *same patent* that included the statement. *ZTE*, Paper 87 at 115–16. Second, unlike the claims here, the proposed substitute claims in *ZTE* lacked § 112(a) written description in any patent or published application. *Id.* Thus, *ZTE* does not support Petitioner's position.

2. Sufficiency of the '424 Application's disclosure

Petitioner argues the '424 Application lacks sufficient disclosure to support “a push rod assembly operatively connected to the motor” together with “the push rod assembly is connected to the eccentric shaft” as recited in claim 1, as well as “the push rod is operatively connected to the motor by the eccentric shaft” as recited in claims 2 and 18. Petition, 30–31. Petitioner's argument rests on the notion that “[t]he '424 Provisional discloses a different ‘eccentric shaft’ mechanism than that disclosed and claimed in the '919 Patent.” Petition, 30. This is an artificial distinction Petitioner created without basis in either disclosure.

First, the '424 Application discloses and describes “pin 406” that is essentially identical in all relevant details to the '919 Patent’s *shaft 16*, which provides the basis for the claimed “eccentric shaft” (see annotated Figures below). And tellingly, Petitioner never alleges that the '919 Patent itself fails to provide adequate written description of these parts of claims 1, 2, and 18. *See* EX1001, 14:56–15:20, FIG. 22B, and EX1017, 55, 88, 91, 96.



EX1017, 91 (cropped, annotated). EX1001, FIG. 22B (cropped, annotated).

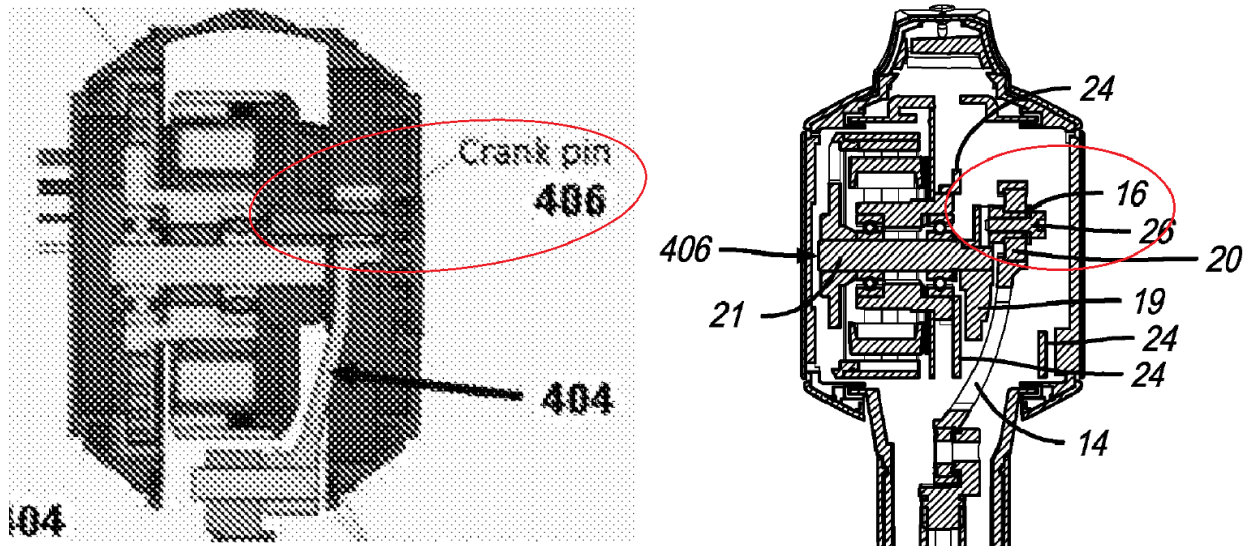
Second, Petitioner does not dispute that the pin 406 in the '424 Application is an “eccentric shaft.” With it being uncontested that the pin 406 embodies an eccentric shaft, the '424 Application provides clear support for the claim language at issue where it discloses “the push rod 404 that is connected directly to the motor 402 by a pin 406” and “the proximal end of the push rod where it connects to the motor.” EX1017, 55.

Third, Petitioner’s argument that the ’424 Application’s description of the pin 406 still does not support the breadth of the claims (Petition, 34–35) rests on insignificant differences between the disclosures of the ’424 Application and the ’919 Patent. Petitioner first characterizes the ’919 Patent claims as “broadly recit[ing] a standalone eccentric shaft” that indirectly connects the push rod to the motor via the standalone eccentric shaft, then characterizes the ’424 Application as “exclusively disclos[ing] a *direct* connection between the push rod and the motor” by a pin. Petition, 30, 34 (emphasis added). From this, Petitioner alleges that the ’919 patent claims “are broad enough to cover indirect connection between the push rod and the motor via a separate eccentric shaft and unlimited other intervening elements, but the ’424 Provisional exclusively discloses a direct connection between the push rod and the motor via a pin that is part of the motor.” Petition, 34.

Petitioner’s convoluted distinction is both artificial and wrong. Petitioner provides no explanation why the claimed “eccentric shaft” is “standalone” while the ’424 Application’s “pin” is “exclusively” a “part of the motor.” The ’424 Application does not use the word “directly” every time it describes the connection between the push rod and the motor, making Petitioner’s argument that the ’424 Application “exclusively discloses a direct connection between the push rod and the motor” inaccurate. Petition, 34; EX1017, 55 (“two bearings 410 ... are

included at the proximal end of the push rod where it connects to the motor”). And again, the ’424 Application’s disclosure regarding its pin 406 is the same in all relevant details to the ’919 Patent’s disclosure regarding the shaft 16, and Petitioner tellingly does not contest the sufficiency of the ’919 Patent’s disclosure for these parts of the claims.

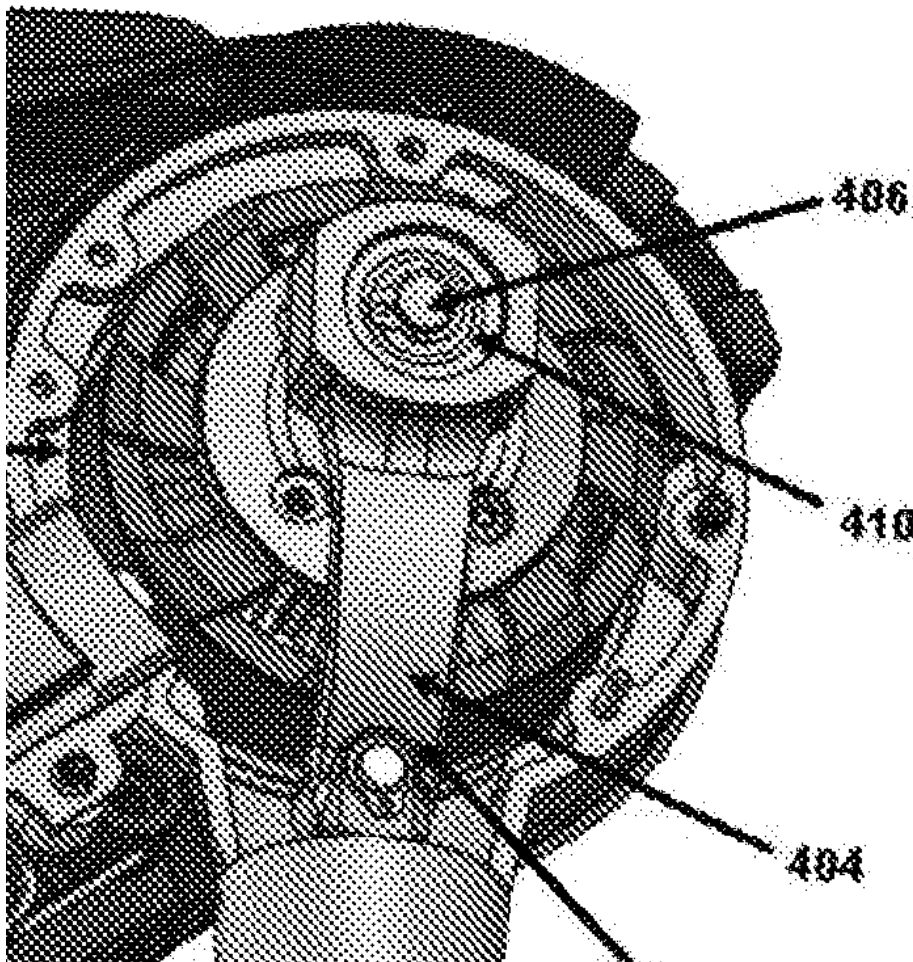
The drawings show that the pin 406 in the ’424 application is no more a part of the motor than the ’919 Patent’s shaft 16 is:



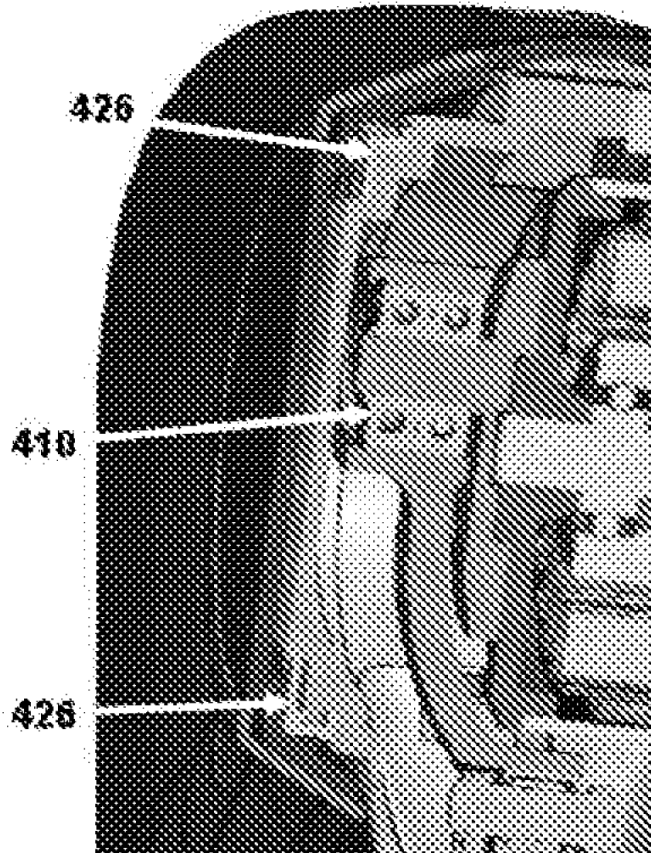
EX1017, 91 (cropped, annotated). EX1001, FIG. 22B (cropped, annotated).

Nothing in the ’424 application limits the pin to being “exclusively” a “part of the motor.” The ’424 Application discloses “a push rod or shaft 404 that is connected directly to the motor 402 by a pin 406.” EX1017, 55. Petitioner rests its entire argument on the word “directly” necessarily excluding any intervening elements between the push rod and the motor. But that narrow interpretation is

inconsistent with the '424 Application's own disclosure, which discloses two bearings 410 that are preferably included *between* the push rod 404 and the pin 406, and thus are intervening elements between the push rod and the motor. *Id.* The drawings show that the bearings 410 extend between the proximal end of the push rod 404 and the pin 406 so that the push rod 404 does not contact the pin 406.



EX1017, 88 (cropped).



EX1017, 96 (cropped).

In summary, the '424 Application provides clear support for the claim '919 Patent claim language, and contrary to what Petitioner argues, discloses intervening elements between the motor and the push rod. Accordingly, Petitioner's sufficiency challenge fails.

C. Level of Skill in the Art

At this stage of the proceeding, solely for purposes of this Preliminary Response, Patent Owner does not dispute Petitioner's level of skill for a POSITA. Petition, 17. Patent Owner reserves the right to contest Petitioner's level of skill for a POSITA, should trial be instituted.

D. Claim Construction

In a post-grant review, claims are “construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.200(b). All claim terms must be given their ordinary and customary meaning as understood by a POSITA at the time of the invention, in light of the specification and prosecution history of the patent. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Petitioner asserts that “transverse” should be interpreted to mean “‘acting, lying, or being across’ or simply ‘non-parallel.’” Petition, 20. Petitioner further asserts that “offset” is used consistent with its ordinary and customary meaning as “a distance or positional displacement between the centerlines or centerpoints of two components.” Petition, 20–21. Other than these two terms, Petitioner submits no further claim terms need to be expressly construed. Petition, 18.

In the related district court proceeding, Patent Owner has provided a preliminary construction of “transverse to” to mean “non-parallel.” EX2019, 2.

None of the arguments below turn on the construction of any specific claim term. Thus, no express construction is required for the Director to deny institution. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms ... that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v.*

Am. Sci. & Eng'g, Inc., 200 F.3d 795, 803 (Fed. Cir. 1999)). Although Patent Owner believes that the Director need not construe any term at this stage, Patent Owner's arguments here are consistent with its preliminary district court construction. Patent Owner reserves the right to contest Petitioner's implicit or explicit constructions should trial be instituted.

III. OVERVIEW OF THE CITED PRIOR ART

The Petition recycles prior art that was already considered during the lengthy prosecution of the challenged claims. Most of these references represent imitation percussive devices made to capitalize on the popularity of the original Theragun. The one exception, Huang, is an entirely different type of device. The Office correctly allowed the challenged claims over this prior art, and Petitioner fails to meet its burden to show now that any is more likely than not unpatentable

A. Hu '965

Chinese Patent Application Publication No. CN 109907965 A to Hu ("Hu '965") relates to a "deep myofascial impact massager." EX1023, Abstract. Hu '965 was published June 21, 2019. EX1022, (43). Petitioner has not identified any U.S. patent, U.S. patent application, or international patent application designating the United States claiming the benefit of Hu '965, meaning no document Hu '965's disclosure has been identified that could qualify as prior art under 35 U.S.C. 102(a)(2). Hu '965's filing date is therefore irrelevant. The earliest date that Hu

'965 could qualify as prior art is accordingly June 21, 2019.

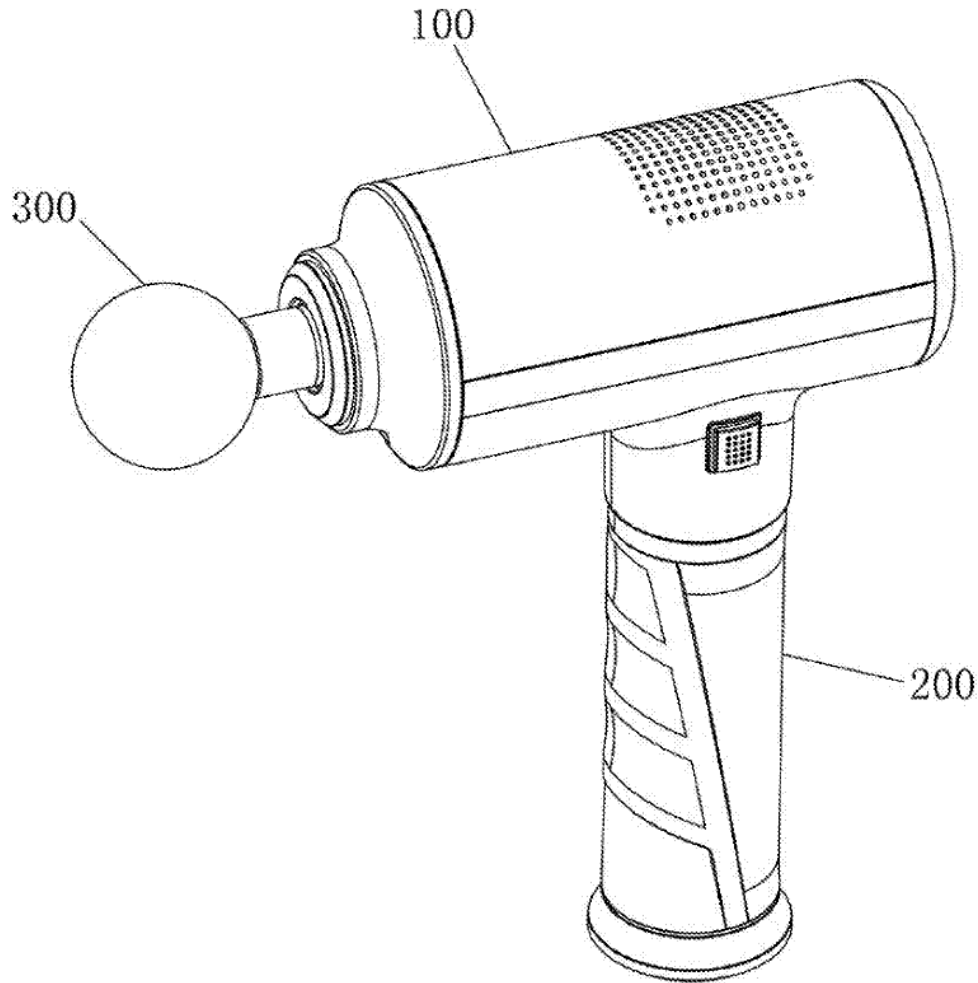


图 1

EX1022, FIG. 1.

Hu '965 is concerned with improving on the power supply systems of earlier devices. EX1023, ¶¶[0002]–[0006]. The earlier power supplies “primarily take[] either one of ... two forms: First, those without energy storage functions,” which “brings great inconvenience to the user,” and “[s]econd, those with a battery energy storage function,” which “becomes unusable and must be discarded” if

“either the main body or the battery structure is damaged.” EX1023, ¶[0004].

“[F]urther deficiencies” Hu ’965 identifies in the prior art include the absence of “a prominent power indicator” and the fact that “[t]he power switches are all disposed on the main body. During use, once the power switch on the main body is turned off, the battery structure portion is prone to leakage and power loss.” EX1023, ¶¶[0005]–[0006].

Hu ’965 solves the latter problem by providing its main power switch 241 on its battery structure 200 instead of its main body 100. EX1023, ¶[0041]. “Since both the main power switch 241 and the battery charging port 242 are disposed on the base 240 of the battery structure 200, turning off the main power switch 241 ensures that both the main body 100 and the battery structure 200 are in a power-off state. No residual power or leakage will occur in the battery structure 200, effectively avoiding the leakage issues found in prior art products after shutdown and further ensuring the safety of product use.” EX1023, ¶[0041].

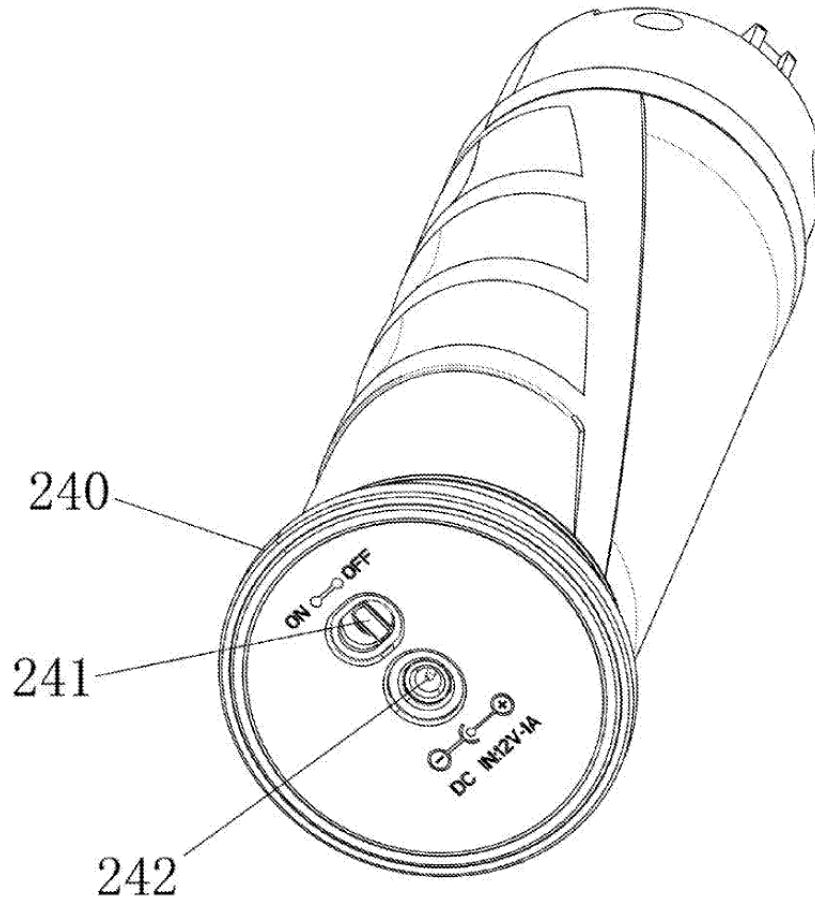


图 8

EX1022, FIG. 8.

B. Hu '951

U.S. Patent Application Publication No. 2021/0022951 A1 to Hu (“Hu '951”) is an application naming a different inventor “Hu” than Hu '965. Hu '951 is directed to “[a] hand-held muscle massager.” EX1036, Abstract. Hu '951 is a national stage entry of International Patent Application No. PCT/CN2019/086962, which claims the benefit of Chinese Patent Application No. 201910056372.9, which was filed on January 18, 2019. EX1036, (86), (30); EX1037, (30). Hu '951

therefore has a disclosure date under 35 U.S.C. § 102(a)(2) of January 18, 2019.

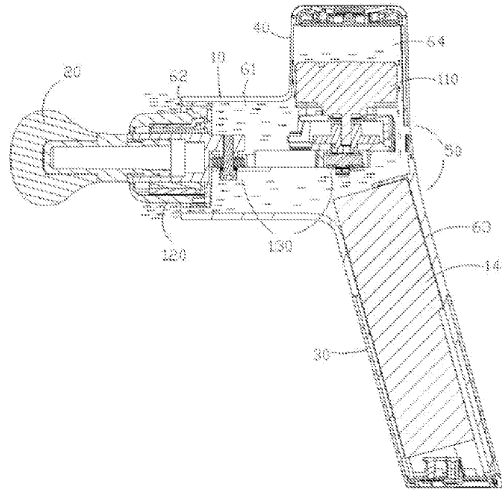


Fig. 5

EX1036, FIG. 5.

Hu '951 is concerned with overcoming problems with prior art devices such as inadequate head dissipation and the difficulty of holding them in a way that enables application of sufficient pressure. EX1036, ¶¶[0004]–[0008]. The placement of a heat dissipation hole at the front end of the device to prevent sweat from entering and contaminating the internal components is the “main object of the invention.” EX1036, ¶[0007]. To this end, Hu '951 explains that the motion opening 62 can either act as “both the air inlet and the air outlet of the ventilation and heat dissipation passage” as shown in the embodiment of Figure 5, or the motion opening 62 can be “an air inlet of the ventilation and heat dissipation passage, and the passage includes an air outlet 65” as shown in the embodiment of Figure 6.

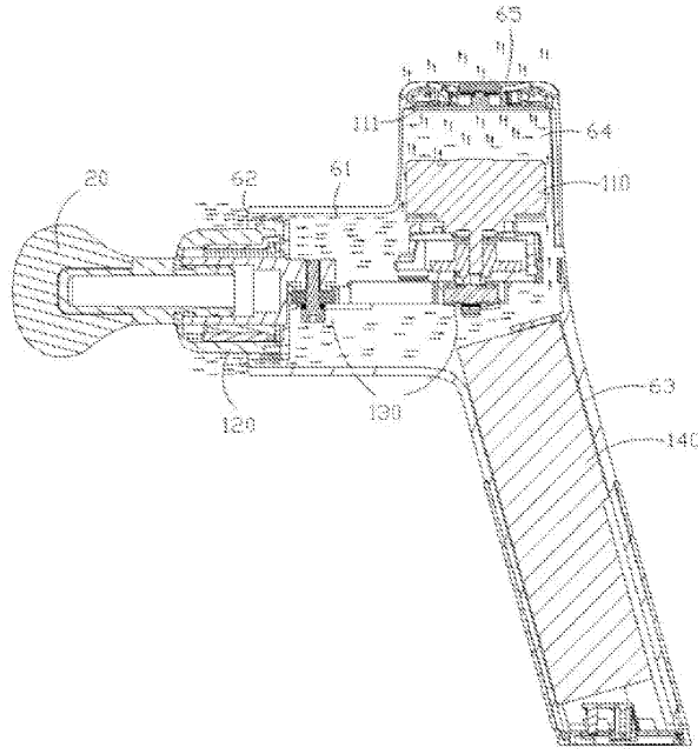
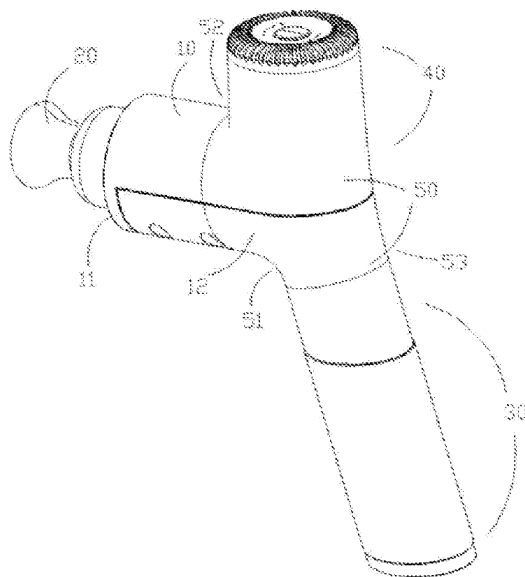


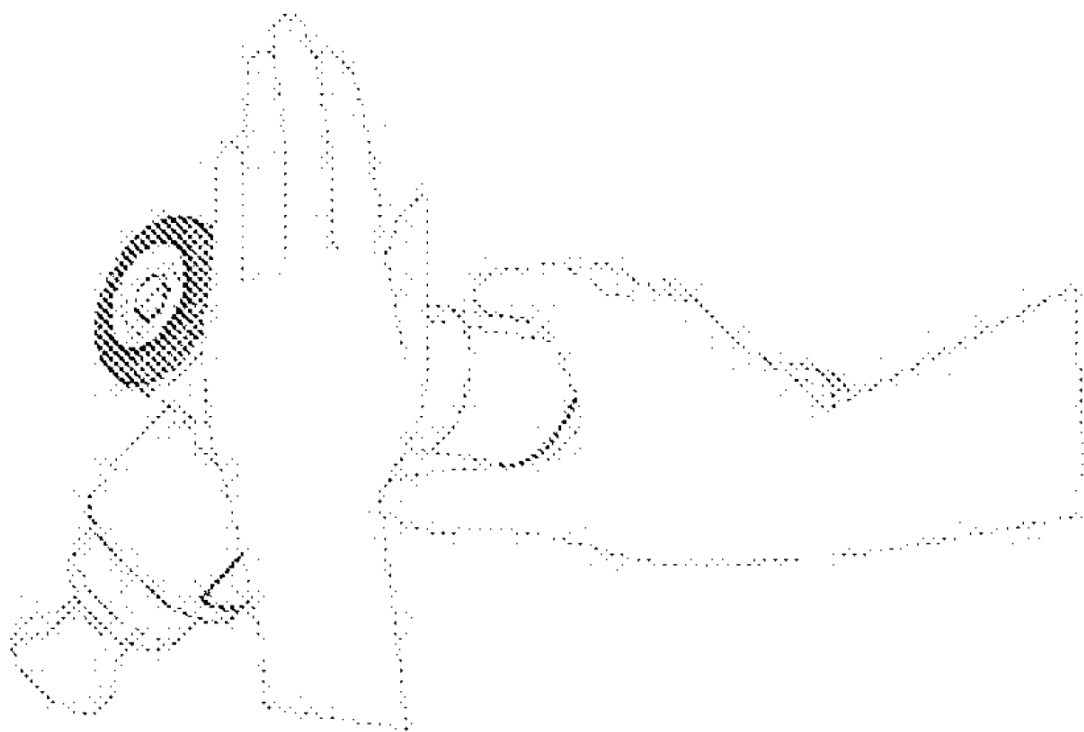
Fig. 6

EX1036, FIG. 6.

To solve the problem of enabling the user to apply sufficient force, Hu '951 creates “[a] smooth pressing grip surface 50 is formed at the intersection of the massage body 10, the main handle 30 and the auxiliary handle 40.” EX1036, ¶[0032]. Hu '951 achieves this achieved by “avoid[ing] the design of rear convex platform of the rear end of the traditional massager” and instead providing the “smooth pressing grip surface 50, which can enable the user's palm press comfortably on the rear of the massager, thus can improve the use experience and is convenient for the user to apply force.” EX1036, ¶[0033].



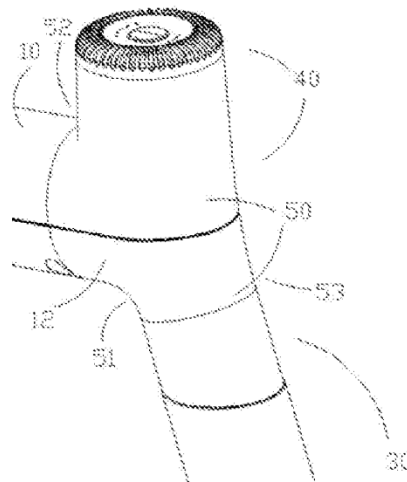
EX1036, FIG. 3.



EX1036, FIG. 4 (cropped).

To create the smooth pressing surface 50, Hu '951 changes three angles

from the prior art. EX1036, ¶[0035]. These are a “main angle 51 ... formed between the massage body 10 and the main handle 30,” an “auxiliary angle 52... formed between the massage body 10 and the auxiliary handle 40,” and a “handle angle 53 is formed between the main handle 30 and the auxiliary handle 40.” EX1036, ¶[0034]. This is the purpose for which Hu '951 discloses that the “main angle 51 is greater than 90° and less than or equal to 135°.” EX1036, ¶[0036].



EX1036, FIG. 3 (cropped).

C. Pepe

U.S. Patent Application No. 2017/0304145 A1 (“Pepe”) discloses “an electronic handheld device for performing a massage on a user.” EX1025, Abstract. Pepe was filed on April 21, 2017. EX1025, (22). Pepe claims priority to an earlier-filed provisional application. EX1025, (60). However, Petitioner has not alleged commonality between Pepe’s disclosure and that of its provisional application, so the cited portions of Pepe should be treated as having a disclosure

date under 35 U.S.C. § 102(a)(2) of April 21, 2017.

Pepe discloses a device 10 with two handles 12, 14 constructed for “better ergonomics.” EX1025, ¶[0024]. “The secondary handle 14 is slightly angularly offset from being parallel to the primary handle 12 such that, the bottom extremity of the secondary handle 14 leans towards that of the primary handle 12.” EX1025, ¶[0024].

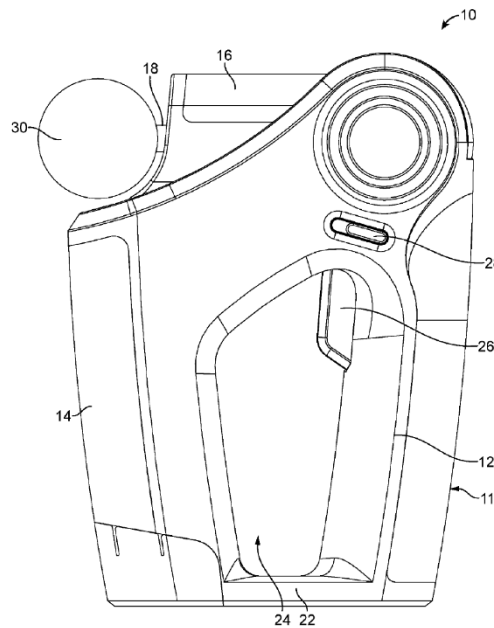


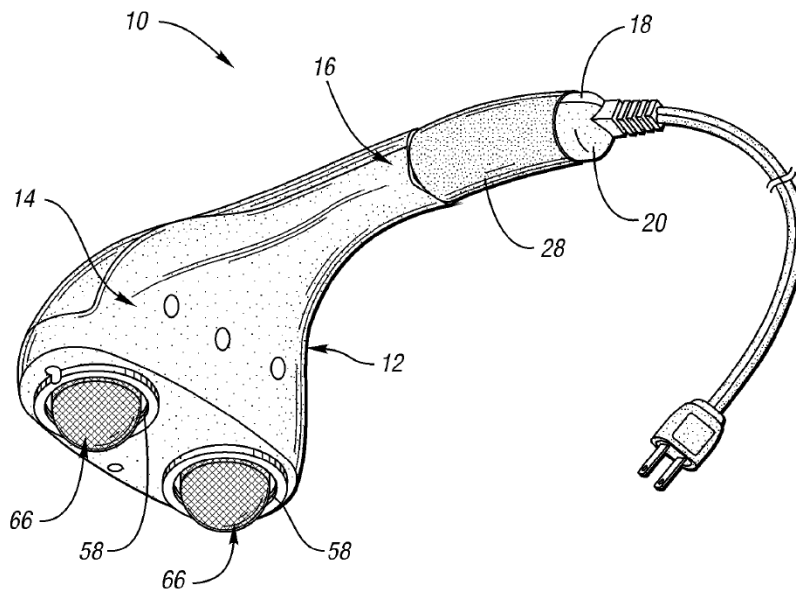
FIG. 4

EX1025, FIG. 4.

“The primary and secondary handles 12 and 14 are meant to be gripped by dominant and non-dominant hands respectively.” EX1025, ¶[0024]. “[T]he device 10 comprises a trigger 26 secured to the primary handle 12 closer to the top extremity thereof,” and “actuating the trigger 26 results in the activation of the motor.” EX1025, [0027].

D. Huang

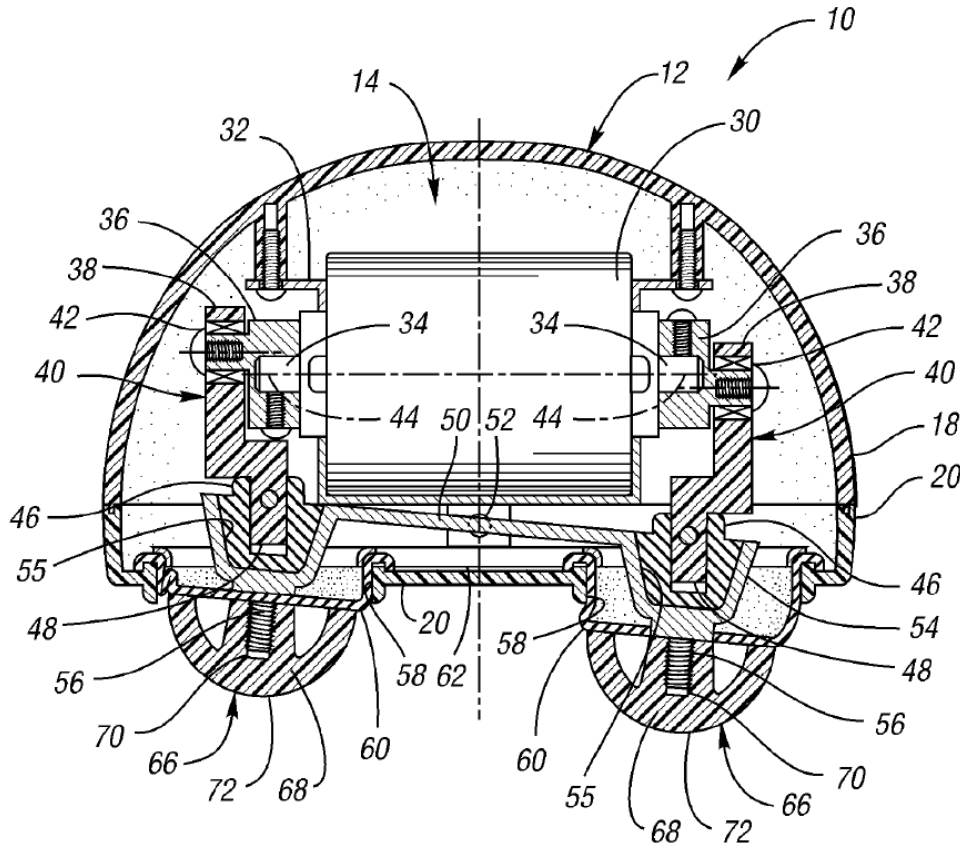
U.S. Patent Application Publication No. 2001/0027280 A1 (“Huang”) differs significantly from the other references in that it is not directed to a percussive massage device with a linear output. EX1035, Abstract. Instead, its output takes the form of a “rocker arm” that “form[s] a massage surface, wherein the massage nodes are moved asynchronously.” EX1035, Abstract. Huang was filed on December 30, 1999. EX1035, (22). Huang therefore has a disclosure date under 35 U.S.C. § 102(a)(2) of December 30, 1999.



EX1035, FIG. 1.

Huang’s purpose is to overcome the disadvantage of prior rocking massage devices driven by a single motorized arm, which is that both sides of the device would cease to move if the arm broke. EX1035, ¶¶[0005]–[0006]. For that purpose, Huang includes two opposed connecting rods 40 that drive either side of

the rocker arm 50. EX1035, [0022]. The rocker arm 50 rocks on a central pivot axis 52. *Id.*



EX1035, FIG. 5.

The rods 40 are connected to the rocker arm 50 by resilient rubber studs 46 that, in combination with the constraint of the rocker arm 50 to the pivot axis 52, enable the motor's rotational output through the rods 40 to be converted to rocking motion of the arm 50. EX1035, ¶¶[0021], [0022], [0025].

E. Marton

U.S. Patent No. 10,314,762 B1 ("Marton") is directed to a "portable electromechanical percussive massager ... 100." EX1043, 7:14–16.

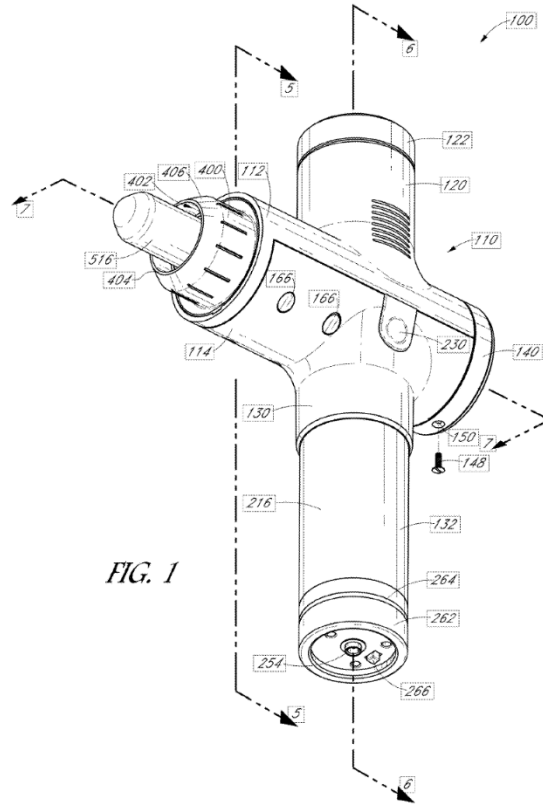
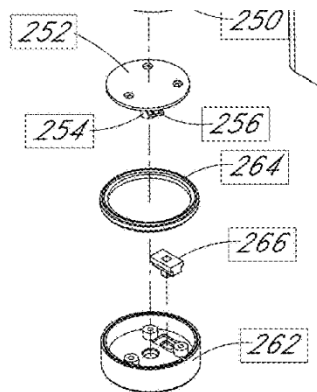


FIG. 1

EX1043, FIG. 1.

Marton includes an internal on/off switch 256 operable from the underside of the device by a switch actuator extender 266. EX1043, 9:37–57.

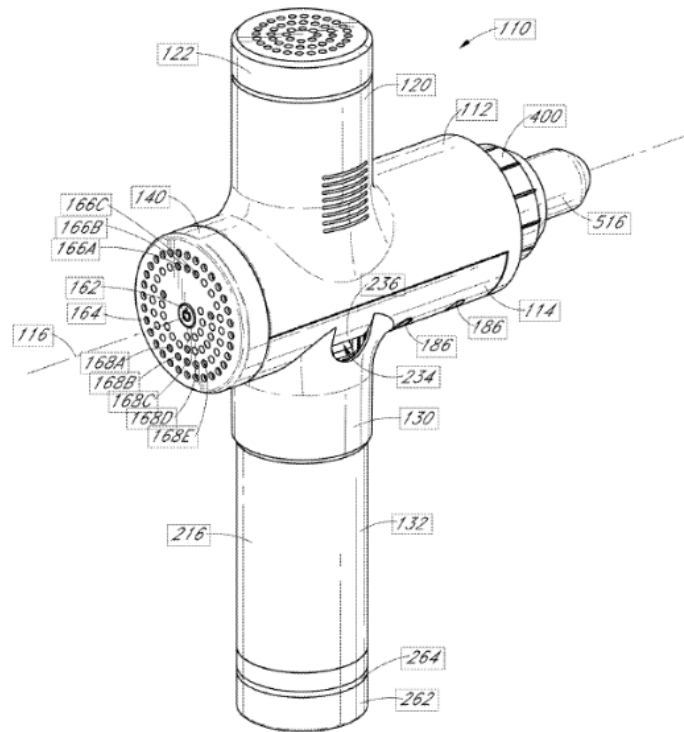


EX1043, FIG. 9 (cropped).

The device also includes a “central pushbutton switch 162” that is

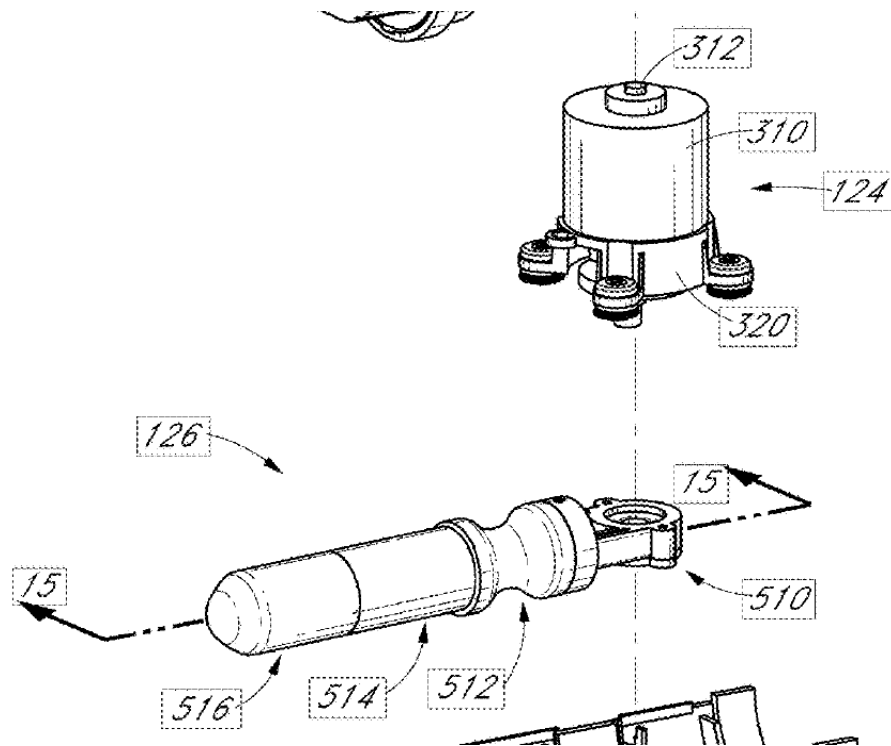
surrounded by bores through which LEDs 166A–166C and 168A–168E are visible.

EX1043, 7:62–8:15. The LEDs can indicate, for example, an operational state or battery charge state for the device. EX1043, 8:9–21. The pushbutton switch 162 communicates with a motor controller to cycle through motor speeds. EX1043, 23:4–37.



EX1043, FIG. 2.

Marton's device has a substantially different drive mechanism from, for example, Hu '965 and Hu '951. Rather than using a sequence of pivoting, inflexible links, Marton uses “a flexible interconnection linkage 512” to transfer the rotational output from the motor to the linear motion of the applicator head 516. EX1043, 10:63–11:3.



EX1043, FIG. 3 (cropped).

F. Hypervolt

Hypervolt is Petitioner's own product that followed Therabody's original Theragun into the market. Petitioner alleges "Hyperice introduced its Hypervolt product (the 'Hypervolt') on February 26, 2018, and Hyperice began the Hypervolt shortly thereafter." Petition, 47. It is not clear whether Petitioner alleges Hypervolt became prior art on February 26, 2018, the date when Petitioner alleges "Hyperice introduced its Hypervolt product," or "shortly thereafter," which is when Petitioner alleges "Hyperice began the Hypervolt." Petition, 47.

Regardless, as explained below, Petitioner fails to provide competent evidence of what Hypervolt disclosed at the time of invention of the '919 patent.



It may look like a hairdryer, but this device packs a soothing punch.
TREVOR RAAB

EX1033, 4.

IV. LEGAL STANDARDS

The Petition must identify, with particularity, the grounds and evidence that support finding the claims unpatentable. 35 U.S.C. § 322(a)(3). “Where the grounds for unpatentability are based on prior art, the petition must specify where each element of the claim is found in the prior art. For all other grounds of unpatentability, the petition must identify the specific part of the claim that fails to comply with the statutory grounds raised and state how the identified subject matter fails to comply with the statute.” 37 C.F.R. § 42.204(b)(4).

The determination regarding institution must be based on what the Petition actually presents, not what it could have reasonably presented had it been drafted differently. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (holding that the Board is not “free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during” a

post grant proceeding). Post-grant review may not be instituted unless the petition demonstrates “that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a).

V. ARGUMENTS AGAINST INSTITUTION

A. The Petition does not establish that Hypervolt is even prior art, or that Hypervolt and Hu ’951 render obvious claims 1, 3, 4, and 7–11 (Ground 6, Claims 1, 3, 4, and 7–11).

1. Petitioner fails to establish that the Hypervolt product is prior art or even place it in evidence.

To rely on a product as prior art, Petitioner bears the burden of proving—through evidence—that the device was in public use or on sale before the effective filing date. *See In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d at 1375; 35 U.S.C. § 326(e). Petitioner fails to carry that burden.

Ground 6 relies on an alleged prior art product—Petitioner’s own Hypervolt device. Yet Petitioner does not submit any competent evidence of the Hypervolt product into the record. Petitioner relies solely on images pasted into the Petition, rather than a product brochure, properly authenticated photographs, or other documentary evidence. Additionally, Petitioner does not establish the depicted device predates the effective filing date of the ’919 patent. Petitioner also fails to support its challenges with anything more than conclusory assertions, rather than evidence.

The deficiencies are especially striking because the Hypervolt is Petitioner’s

own product: Petitioner has every means to prove when it was made and sold, how its serial numbers are formatted, and how it operates, yet proves none of it.

First, Petitioner supports its challenges based on Hypervolt only with photographs (unaccompanied by any exhibit citation) pasted directly into the Petition, and two cursory cites to an unauthenticated internet archive web page (EX1032). *See* Petition, 119–131. That does not satisfy the Petition’s threshold obligations. Section 42.204(b)(5) requires a petition to identify “[t]he exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.204(b)(5). Images embedded in the Petition are not evidence; they are attorney argument. *See Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) (“unsworn attorney argument ... is not evidence”). Petitioner cannot establish a claim limitation is met—much less that a device embodying it existed before the effective filing date—based on unlabeled images.

Second, setting aside the evidentiary defect, Petitioner fails to prove the threshold fact on which the entire ground depends: that the depicted product was in public use or on sale before the effective filing date. At the institution stage, the petition must identify, with particularity, evidence sufficient to establish the prior art was available before the critical date of the challenged patent and, therefore,

that it is more likely than not that it qualifies as prior art. *C.f. Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (P.T.A.B. Dec. 20, 2019) (precedential). Petitioner falls far short of meeting its burden. Instead, Petitioner provides a conclusory assertion that its Hypervolt product was introduced on February 26, 2018. *See* Petition, 47. Although Petitioner cites several exhibits that purportedly show the Hypervolt was on sale in 2018, it never explains their relevance or identifies what information in those exhibits allegedly establishes prior-art status. *See* Petition, 47–48. A petition must identify the relevance of the evidence on which it relies and the specific portions supporting the challenge; Petitioner cannot satisfy that obligation through unexplained citations to exhibits. 37 C.F.R. § 42.204(b)(5); *see also* 37 C.F.R. § 42.22(a)(2) (a petition must include a detailed explanation of the significance of the evidence including material facts). Thus, Petitioner leaves it to the Board to sift through the evidence, rather than establishing the prior art date with evidence and analysis in the Petition itself, as required. *See* 37 C.F.R. § 42.6(a)(3) (arguments must not be incorporated by reference); *Parus Holdings, Inc. v Google LLC*, 70 F.4th 1365, 1371–1372 (Fed. Cir. 2023) (a party’s burden cannot be met without citing the evidence with specificity and explaining the significance of the materials; judges are not required to hunt for “truffles” or “play arch[a]eologist with the record.”) (internal citations omitted).

More fundamentally, Petitioner fails to even establish that the depicted product is in fact the version of Hypervolt alleged to be on sale in 2018. Petitioner asserts that the product depicted in the photos has a serial number “3018” that reflects the product’s manufacture or sale date. Petition, 48. But the only showing provided in the Petition to establish that “3018” is in fact a serial number and that it follows any date-encoding format is a parenthetical to a citation to a general website accessed in 2026. Petition, 48, n.11. The Petition itself contains no explanation that Hypervolt follows that format, or even that the convention was in place as of the critical date. Rather, Petitioner once again provides a string citation to four different exhibits, with no explanation of the significance of the evidence, or even pin cites, to support its allegation that the analyzed Hypervolt product is prior art. Petition, 48.

The Board should not consider the evidence buried in Petitioner’s string citation because Petitioner fails to explain the significance of the evidence in the Petition, as required, and violates the Board’s rules against incorporation by reference. *See* 37 C.F.R. §§ 42.6(a)(3) and 42.22(a)(2). Thus, Petitioner’s failure leaves the date of the product depicted in the photographs wholly unproven.

Third, Petitioner does not identify the evidence relied upon in its challenges with particularity, as required. Where, as here, “the grounds for unpatentability are based on prior art, the petition must specify where each element of the claim is

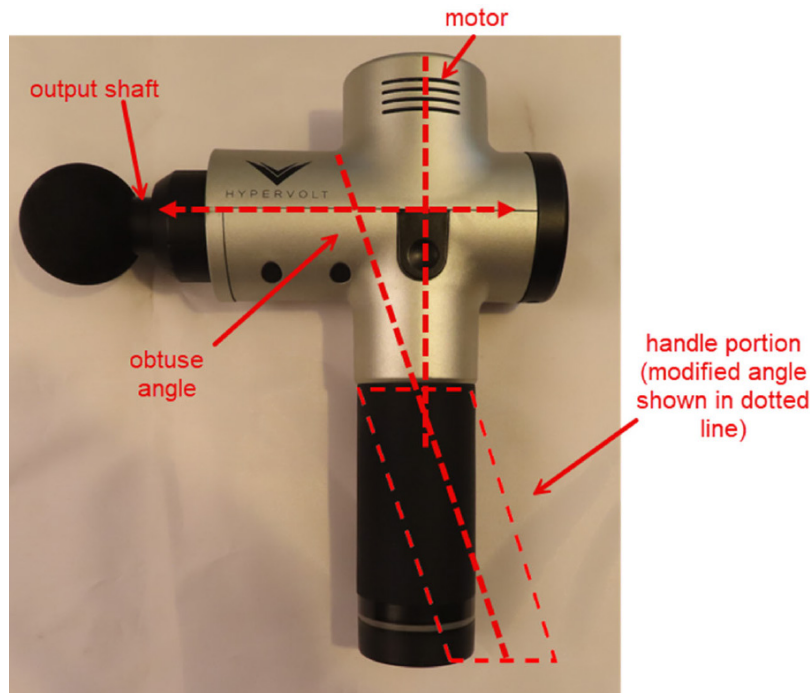
found in the prior art.” 37 C.F.R. § 42.204(b)(4); *see also* 35 U.S.C. § 322(a)(3) (petition must identify “with particularity ... the evidence that supports the grounds for the challenge to each claim”). Instead of that showing, the Petition offers a series of conclusory assertions that Hypervolt teaches the claimed “eccentric shaft,” “push rod assembly,” and “output shaft,” citing only to expert testimony, and no explanation of how the alleged Hypervolt product supports each assertion. *See* Petition, 120–121. These are only examples; the same conclusory approach pervades the ground. Such cursory and conclusory analysis falls well short of Petitioner’s obligation to perform a reasoned analysis based on the prior art asserted in its challenges.

For these reasons alone, Petitioner fails to establish, by a preponderance of the evidence, that Hypervolt in view of Hu ’951 renders obvious the claims challenged under ground 6 of the Petition.

2. Petitioner’s proposed modification of Hypervolt in view of Hu ’951 is not based in the teachings of the references.

In Ground 6, Petitioner appears to concede Hypervolt fails to disclose “an interior angle defined between the handle portion and the output shaft is obtuse,” as recited in claim 1. Petition, 118, 122. Petitioner proposes modifying Hypervolt by changing the angle of its handle based on the “main angle 51” disclosed in Hu ’951. Petition, 118, 122. Petitioner relies on this modification to reach the only independent claim addressed in Ground 6. Petition, 122.

First, the Petition supplies no reason why the modification would be carried out to angle *only* the bottom half of Hypervolt’s handle, as opposed to the entire handle as Hu ’951 teaches. EX1036, ¶[0034], FIG. 3.



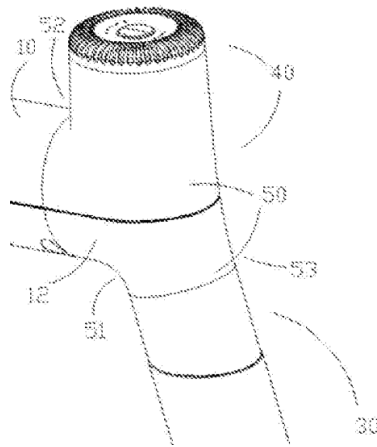
Petition, 122 (showing an image of Hypervolt annotated by Petitioner to show the proposed modification).

Second, Petitioner’s modification would not have been obvious because it applies Hu ’951’s main angle in a way that fails to achieve Hu ’951’s stated purpose for that angle.

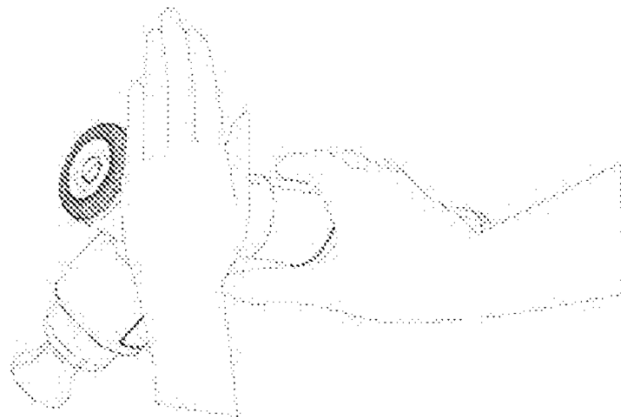
A POSITA would not understand Hu ’951 to teach making this modification to the Hypervolt, because Hu ’951’s purpose for the relied-upon “main angle 51” is something that can’t be done on the Hypervolt.

Hu ’951 teaches that the purpose of the main angle 51 is to act in

cooperation with the auxiliary angle 52 and handle angle 53 so that the device “can avoid the design of rear convex platform of the rear end of the traditional massager.” EX1036, ¶¶[0033]–[0035]. Rather than the “rear convex platform” of other devices, Hu ’951’s angles cooperate to provide the device with a “smooth pressing grip surface 50, which can enable the user's palm press comfortably on the rear of the massager, thus can improve the use experience and is convenient for the user to apply force, and enhance the massage effect.” EX1036, ¶[0033].



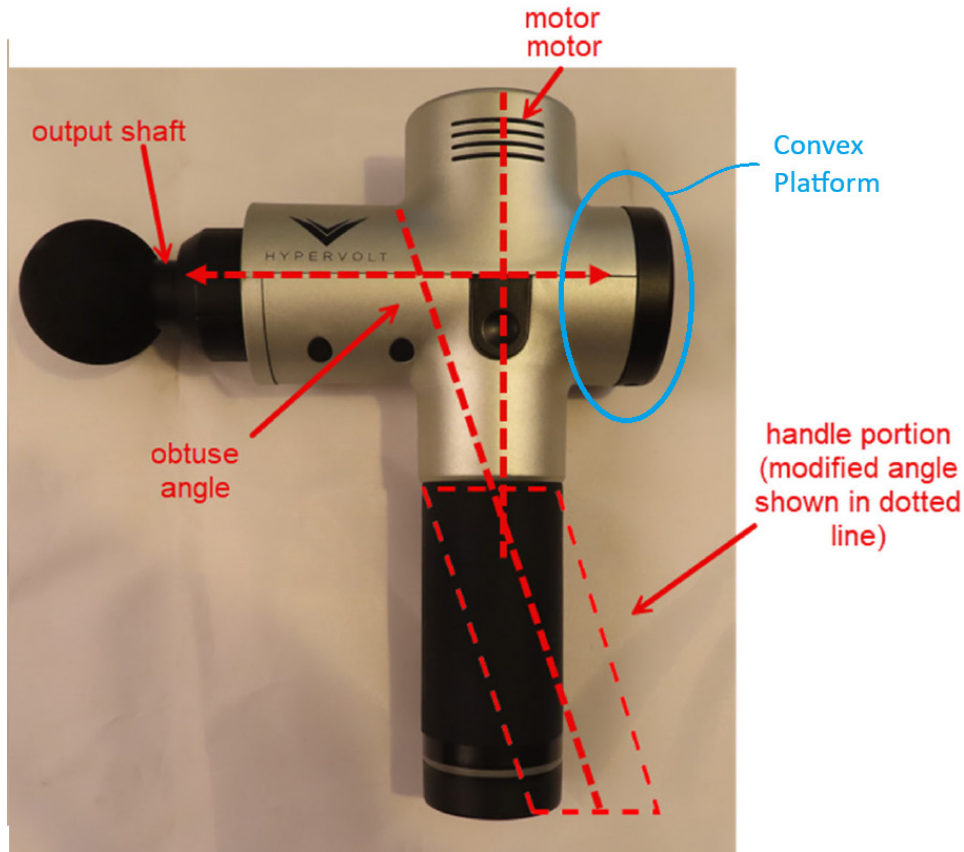
EX1036, FIG. 3 (cropped).



EX1036, FIG. 4 (cropped).

Hu '951 does not suggest that the main angle 51 has any other utility or benefit. From the perspective of Hu '951's disclosure, *no reason* exists for the main angle 51 other than to eliminate the "rear convex platform" of other devices and replace it with the smooth pressing grip surface 50. Petitioner's discussion of other exhibits showing so-called "pistol grip" handles suggests Petitioner believes the background literature teaches other reasons for angling a handle this way, but those exhibits cannot outweigh Hu '951's own teachings because Petitioner did not make them part of the ground.

The proposed modification of Hypervolt would not achieve the purpose taught by Hu '951. It would fail to achieve the purpose of the main angle 51 because the result has a rear convex platform instead of a smooth pressing surface:



Petition, 122 (annotation in blue added by Patent Owner).

Despite Petitioner citing other exhibits with what it calls “pistol grip” style handles in Section XIII.A.1 to support Ground 2 (Petition, 54–57) and referring to that discussion again in Ground 6 (Petition, 118), Petitioner does not rely on those exhibits as part of the asserted ground. Nor does Petitioner purport to rely on “common knowledge in the art.” These background exhibits, therefore, cannot fill gaps in the asserted ground or substitute for disclosure in the references relied upon in Petitioner’s challenges. Thus, evaluation of Ground 6 must focus on what Hu '951 says about its own handle angle.

The Petition therefore fails to establish that the proposed modification is

more likely than not to have been obvious.

B. Hu '965 is not prior art, and the proposed modifications are not supported by Petitioner's evidence (Ground 2, claims 1–6, 9–11, and 14–20).

1. Hu '965 is not prior art.

Hu '965 does not qualify as prior art. Hu '965 was not published until June 21, 2019, *after* the May 7, 2019 filing date of the '424 Application. Hu '965 does not have a corresponding PCT or US application that could qualify as prior art under § 102(a)(2). Thus, June 21, 2019, is the earliest date it could qualify as prior art.

As discussed in Section II.B, all of the claims challenged in Ground 2 are entitled to the May 7, 2019 priority date of the '424 Application. EX1017, 9. Petitioner's arguments to the contrary ignore the other intervening family patents providing priority, eschew the governing precedent on incorporation by reference, and apply an unduly narrow interpretation of the '424 Patent's disclosed embodiments that is contradicted by the specification and figures. *See* Section II.B

Patent Owner's rebuttal of Petitioner's attempts to rebut priority satisfies its burden on this issue. "[T]here are two distinct burdens of proof: a burden of persuasion and a burden of production." *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The burden of persuasion as to the unpatentability of claims in a post-grant review is on Petitioner. 35 U.S.C. §

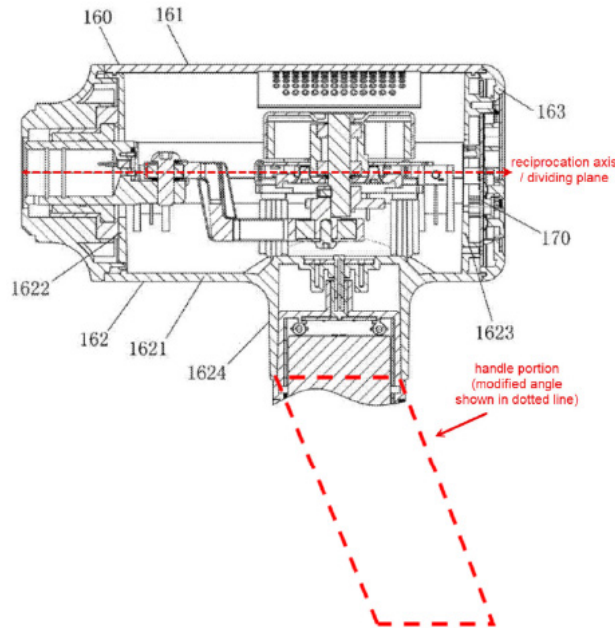
326(e). The distinct burden of production “is a shifting burden, ‘the allocation of which depends on where in the process of trial the issue arises.’” *Dynamic Drinkware*, 800 F.3d at 1379. A petitioner may satisfy its initial burden of production by arguing that claims are invalid over prior art, thereby shifting the burden of production to the patent owner. *Id.* at 1379–80. The patent owner may then fulfill the burden of production and shift it back to the petitioner by arguing or producing evidence that the petitioner’s references fail to qualify as prior art based on the effective priority date of the challenged claims. *Id.* at 1380.

Here, Patent Owner has rebutted all of Petitioner’s arguments that the claims of the ’919 Patent are not entitled to the benefit of the filing date of the ’424 Application. *See* Section II.B. Petitioner has not identified any other basis for disputing that every claim challenged in Ground 2 has priority to the ’424 Application. Accordingly, Petitioner fails to meet its burden to show that Hu ’965 qualifies as prior art to any of these claims.

2. Petitioner’s proposed modification of Hu ’965 in view of Hu ’951 is not supported by the evidence Petitioner relies on for this Ground.

Even if Hu ’965 could be considered prior art, it fails to render any of the challenged claims obvious. In Ground 2, Petitioner appears to concede that Hu ’965 fails to disclose “an interior angle defined between the handle portion and the output shaft is obtuse,” as recited in claim 1, or that “the handle portion axis

extends at an oblique angle to the reciprocation axis and intersects the reciprocation axis and the motor axis,” as recited in claims 2 and 18. Petition, 65–66, 73–74. Petitioner proposes modifying Hu ’965 by changing the angle of its handle based on the “main angle 51” disclosed in Hu ’951. Petition, 65–66.



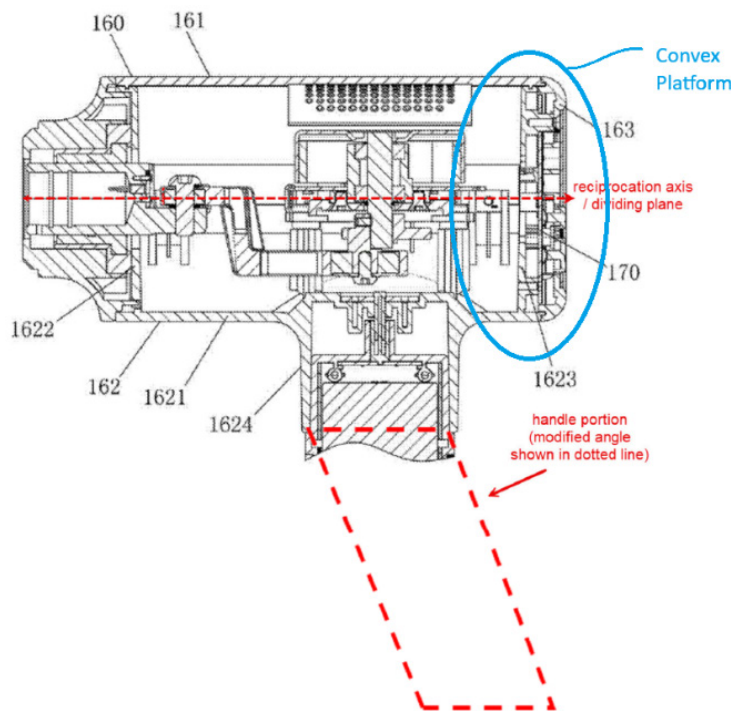
Petition, 66 (showing Hu ’965’s FIG. 6 as annotated by Petitioner to show the proposed modification).

First, the Petition supplies no reason why the modification would be carried out to angle *only* the bottom half of Hu ’965’s handle, as opposed to the entire handle as Hu ’951 teaches. EX1036, ¶[0034], FIG. 3.

Second, as discussed above in section V.A.2, Hu ’951 teaches that the purpose of the main angle 51 is to act in cooperation with the auxiliary angle 52 and handle angle 53 so that the device “can avoid the design of rear convex

platform of the rear end of the traditional massager” (EX1036, ¶¶[0033]–[0035]), and it would not have been obvious to use Hu ’951’s main angle 51 to modify Hu ’965 in a way that would fail to achieve that purpose.

The proposed modification of Hu ’965 would not achieve the purpose taught by Hu ’951. It fails to achieve the purpose of the main angle 51 because the result has a rear convex platform instead of a smooth pressing surface:



Petition, 66 (annotation in blue added by Patent Owner).

Despite Petitioner citing other exhibits with what it calls “pistol grip” style handles (Petition, 54–57), Petitioner does not rely on those exhibits as part of the asserted ground. Nor does Petitioner purport to rely on “common knowledge in the art.” These background exhibits, therefore, cannot fill gaps in the asserted ground

or substitute for disclosure in the references relied upon in Petitioner's challenges.

Thus, evaluation of Ground 2 must focus on what Hu '951 says about its own handle angle.

As discussed above, Petitioner's proposed modification would fail to achieve Hu '951's only stated purpose. As a result, Petitioner has not shown that the proposed modification is more likely than not to have been obvious.

C. Petitioner's proposed combination of Pepe, Hu '951, and Huang omits key elements from each independent claim (Ground 4, claims 1–6, 9–11, and 14–20).

1. “the handle portion... intersects... the motor axis” in claims 2 and 18 is missing from the combination.

Claims 2 and 18 both require “a motor configured to output torque about a motor axis” and “the handle portion axis ... intersects... the motor axis.” None of Ground 4's references disclose this feature individually. Petitioner takes the motor axis and handle portion axis from Pepe and Hu '951, respectively, but finds no support in any of the references for combining them in the particular manner Ground 4 proposes with respect to claims 2 and 8.

Petitioner alleges “Pepe in view of Hu '951 and Huang teaches or suggests 2/18[a] *a motor [20] configured to output torque about a motor axis* [green dot extending into the page of FIG. 3].” Petition, 99. Petitioner also annotates the alleged motor axis as a horizontal dashed line on Pepe's Figure 6. Petition, 100.

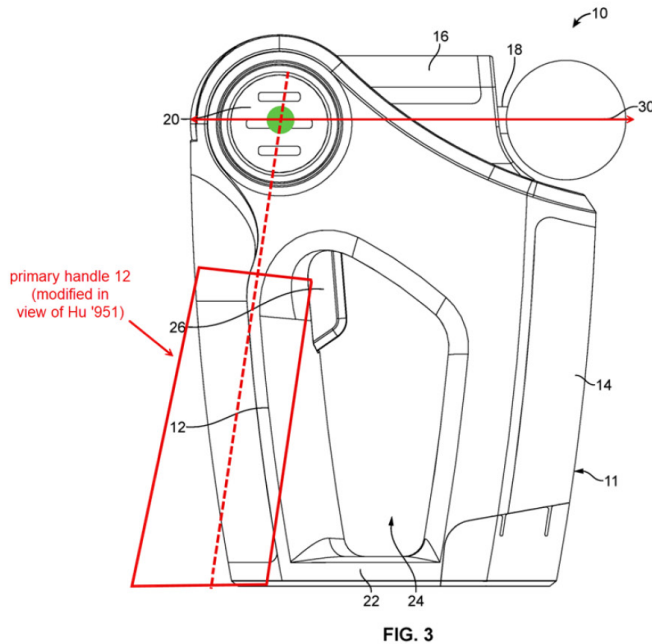


FIG. 3

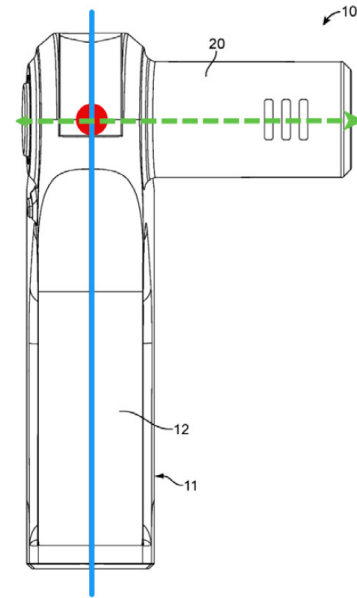


FIG. 6

Petition, 100 (showing Pepe's FIGS. 3 and 9 as annotated by Petitioner).

The Petition does not cite support in any of the references for why the motor axis would be placed as shown in Petitioner's annotated figures. Petitioner relies on Pepe itself for the presence of a motor, but acknowledges that Pepe's motor is "not shown" and that "Pepe is silent as the particular drive mechanism for converting the motor's rotational output to reciprocal." Petition, 89.

In other words, Petitioner's annotated drawings compare an axis of Pepe's motor *unit* 20, not an axis about which the motor (located somewhere in that motor unit 20) is configured to output torque. The location of a motor axis, as recited in these claims, is simply unknowable from Pepe's disclosure.

Furthermore, even assuming Pepe's motor axis would be positioned through a centerline of the motor unit 20, as shown in Petitioner's annotated drawings, the

references still would not support Petitioner's argument that it would have been obvious to modify the handle portion axis to intersect the motor axis.

Petitioner provides no support for why it would have been obvious to modify the handle portion axis in Pepe's Figure 3 to have the specific combination of placement and angle necessary for the handle portion axis to intersect the motor axis as shown in Petitioner's annotations to Pepe's figures. Petitioner relies on Hu '951 for these modifications. Petition, 88–89, 102. But Petitioner does not say why, exactly, the modification would have been made *to this specific angle*.

The Petition itself characterizes Hu '951 as teaching that the handle 12 may “form an angle ‘that is greater than 90° and less than or equal to 135°’ with respect to the shaft 18.” Petition, 88–89 (quoting EX1036, ¶[0036]). Thus, even assuming the basic premise of Petitioner's modification of Pepe in view of Hu '951 allows for a broad range of handle angles, *most of which would fail to result in the handle portion axis intersecting the motor axis* at any given position for the handle portion.

Indeed, looking at the Petition's annotations of the modified Pepe handle (Petition, 95), it is readily apparent that a slightly different angle of the handle in either direction, while still within the range of “greater than 90° and less than or equal to 135°,” would result in the handle portion axis failing to intersect the motor axis.

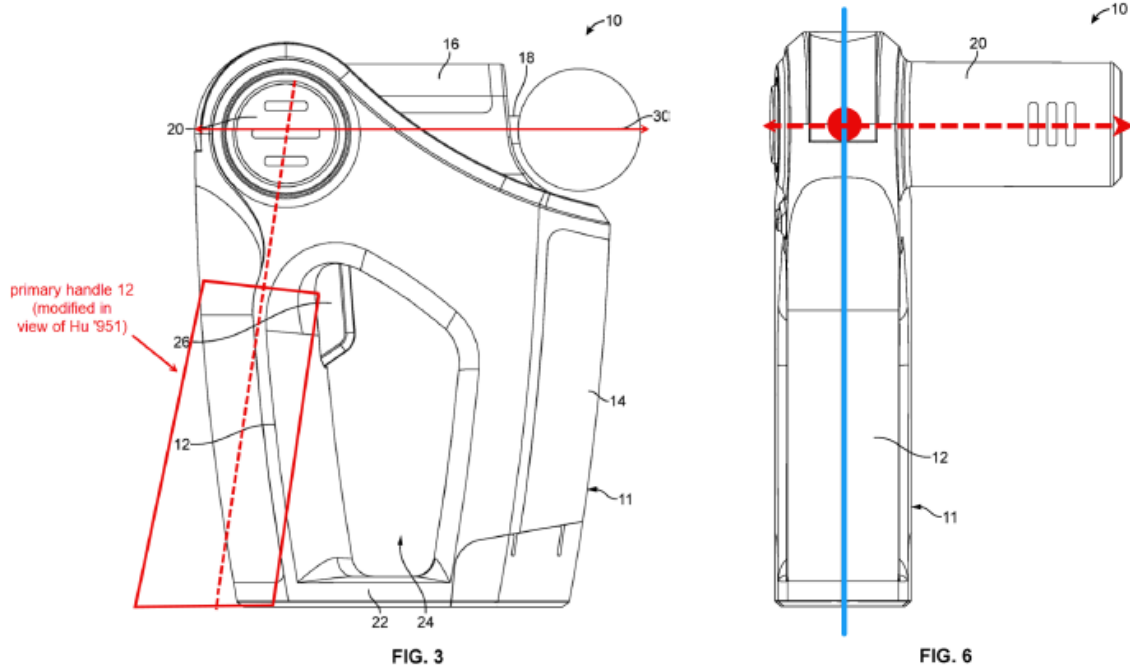
So too would modifying the handle to extend at a slightly different angle without adjusting its placement to compensate. And Petitioner *does* modify the angle of Pepe's handle portion in view of Hu '951 without explaining why it would be modified to the precise location necessary for the handle portion axis to intersect the motor axis. Petition, 88–89.

Accordingly, Petitioner has provided no evidence that it would have been obvious to modify Pepe to have a handle portion axis that intersects the motor axis as required by claims 2 and 18.

2. “the reciprocation axis extends... on a dividing plane” in claim 1 and “the reciprocation axis extends on a dividing plane” in claims 2 and 18 are missing from the combination.

Claim 1 recites “a proximal end of the push rod assembly is connected to the eccentric shaft at a location offset from the dividing plane in a first direction, the motor extends transverse to the handle portion and away from the dividing plane in a second direction opposite the first direction.” Claims 2 and 18 similarly recite “the motor is located on a first side of the dividing plane” and “the proximal end of the push rod is coupled to the eccentric shaft on a second side of the dividing plane.” The Petition fails to establish the cited references disclose, alone or in combination, placing the push rod assembly and motor so that the dividing plane would align with Pepe's alleged reciprocation axis. Petitioner simply assumes the drive mechanism imported from Huang would be integrated with Pepe's non-

illustrated motor at a location that would fulfill these elements of claims 1, 2, and 18.



Ex-1025, FIGS. 3 and 6

Petition, 95 (showing FIGS. 3 and 6 of Pepe as annotated by Petitioner).

Although Ground 4 invokes Hu '951, Ground 4 does not rely on Hu '951 for features related to the placement of the reciprocation axis or dividing plane.

Ground 4 relies on Huang to supply what petitioner refers to as the “drive mechanism.” Petition, 89. In terms of claim elements, this means petitioner relies on Huang for the push rod assembly and the arrangement thereof relative to the motor. Petition, 92–94.

Neither Pepe nor Huang discloses how to connect Huang’s rod 40 should be linked to Pepe’s shaft 18. Petitioner acknowledges “Pepe is silent as [to] the

particular drive mechanism for converting the motor's rotational output to reciprocal ('to-and-fro') motion in the shaft, simply explaining that it can be 'by means of gears, or the like.'" Petition, 89. Pepe also fails to illustrate any relevant interior mechanics. *Id.* Petitioner *does not* rely on Hu '951 for any aspect of the so-called drive mechanism, and instead alleges it would have been obvious to incorporate Huang's "output shaft 34 of the motor 30 to reciprocal motion in a connecting rod 40 via a crank arm 36." *Id.* (citing EX1035, ¶¶[0020]–[0021]). Neither Pepe nor Huang discloses how the output end of Huang's connecting rod 40 could be constrained to move axially without that rocking assembly, nor do they disclose alternative structures by which Huang's connecting rod 40 could be used to drive the longitudinal motion of Pepe's shaft 18.

Thus, the references provide no reason to arrange Huang's alleged push rod assembly with Pepe's non-illustrated motor in the specific location that would result in the dividing plane aligning with Pepe's reciprocation axis.

3. "a motor positioned in the housing" in claim 1 is missing from the combination.

Pepe does not disclose "a motor positioned in the housing," as recited in claim 1. To the contrary, the Petition's own discussion of Pepe discusses two distinct elements of Pepe: its motor unit 20 and its housing 11. Petition, 90–92, 110–11. Petitioner argues "the motor unit 20 [blue] extends through the housing 11; thus, a POSITA would understand that the motor in the motor unit 20 is

positioned in the housing 11. Ex-1002, ¶¶189–90.” Petition, 91.

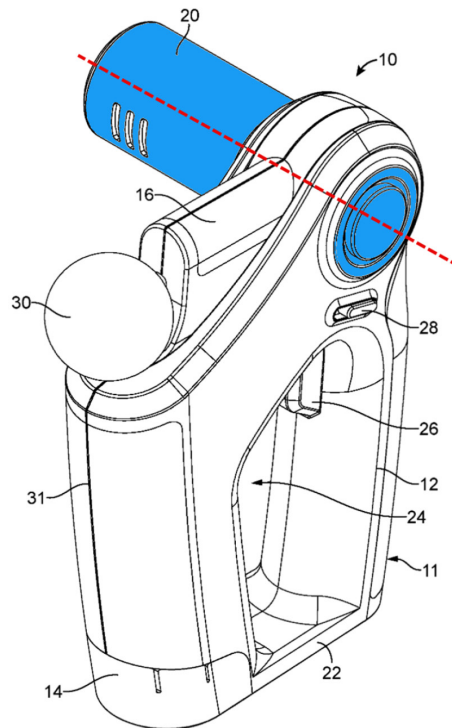


FIG. 1

Ex-1025, FIG. 1

Petition, 91 (showing Pepe’s FIG. 1 as annotated by Petitioner).

Pepe’s motor unit 20 is not itself a “motor.” Rather, “[t]he motor unit 20 *houses* a motor (not shown).” EX1025, ¶[0026]. Nothing in Pepe suggests the motor extends the *entire length* of the motor unit 20, nor does Pepe ever show *where* in the motor unit 20 the motor itself is located. Pepe’s disclosure that the motor unit 20 extends through the housing 11 therefore does not establish that the motor itself extends into the housing 11. And even if some portion of the motor *did* extend into the housing, it would still fail to meet the claim element of “a motor positioned in the housing.” That is, “a motor positioned in the housing” requires

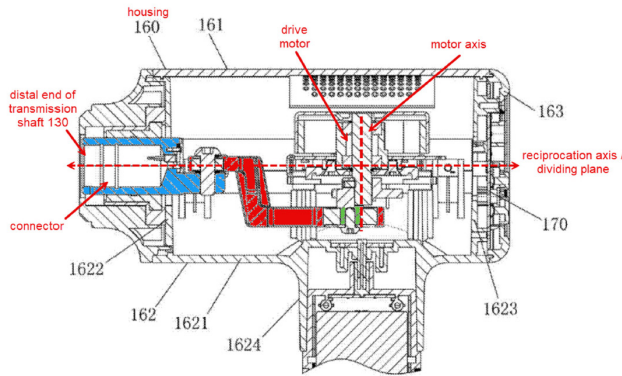
more than just some incidental portion of a motor being within the housing. Pepe therefore fails to disclose a motor positioned in the housing as claimed.

D. Petitioner’s extensive inconsistencies among the Grounds are fatal to certain dependent claim challenges (Grounds 3 and 5, claims 7, 8, 12, and 13)

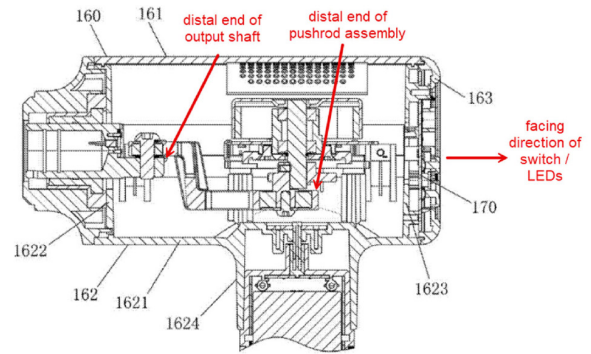
Grounds 3 and 5 suffer from a fundamental problem: they both interpret the prior art differently than Grounds 2 and 4. Grounds 3 and 5 purportedly build on the combinations asserted in Grounds 2 and 4, respectively, to challenge dependent claims. But, in these grounds, Petitioner improperly reverses the directions considered “proximal” and “distal” from Grounds 2 and 4. Having adopted on interpretation in Grounds 2 and 4, Petitioner cannot reverse course and switch its unpatentability theory for the dependent claims.

For example, the interpretation of Hu ’965 relied on for Ground 3 is inconsistent with the interpretation of Hu ’965 used in Ground 2 with respect to the “the distal end of the output shaft.”

In Ground 2, Petitioner alleges Hu ’965 discloses “*an output shaft* [130]... *having a distal end* [exposed end] *that comprises a connector* [annular grooves] *for an attachment* [300].” Petition, 71.



Ex-1023, FIG. 6



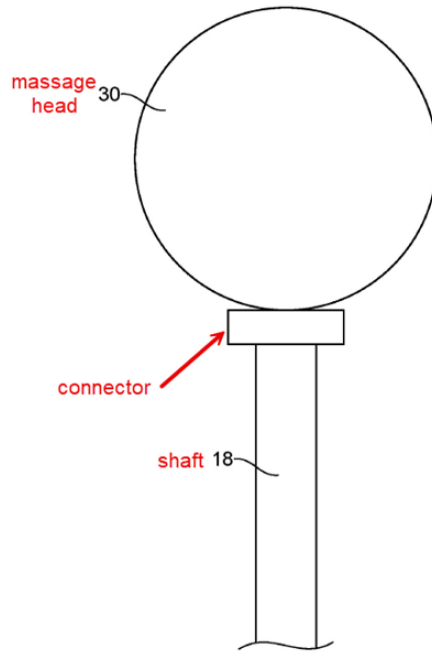
Ex-1023, FIG. 6

Petition, 72 (Ground 2; annotated).

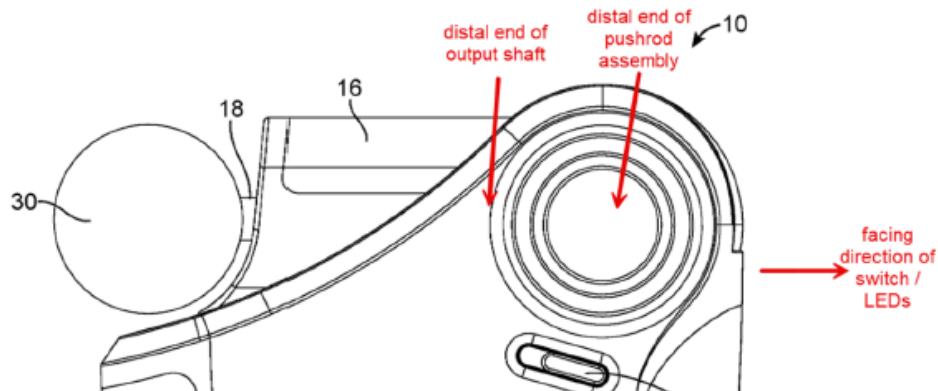
Petition, 87 (Ground 3; annotated).

As shown above, from the perspective of Figure 6, Ground 2 identifies the *left* end of Hu '965's transmission shaft 130 as the distal end, while Ground 4 identifies the *right* end of the transmission shaft 130 as the distal end.

The interpretation of Pepe relied on for Ground 5 is similarly inconsistent with the interpretation Petitioner advances for the independent claims challenged in Ground 4. In Ground 4, Petitioner alleges Pepe discloses “*an output shaft [18]... having a distal end [exposed end of 18] that comprises a connector for an attachment [30].*” Petition, 99. But, in Ground 5, Petitioner identifies a different location in Pepe as the alleged distal end of the output shaft. Petition, 117.

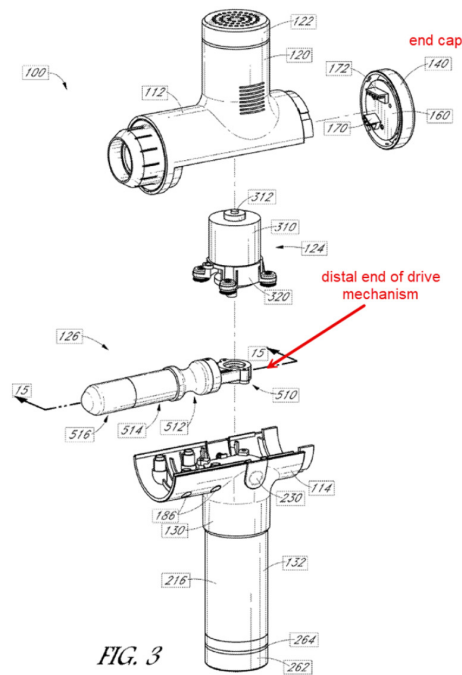


Petition, 100 (showing Pepe's FIG. 9A as annotated by Petitioner).



Petition, 117 (showing a portion of Pepe's FIG. 4 as annotated by Petitioner).

These inconsistencies are fatal to Grounds 3 and 5 as a whole because both of these grounds rely on the locations of the alleged distal end of the output shaft – as well as other inconsistently interpreted features – to justify the proposed further modification of Pepe in view of Marton and explain where the features imported from Marton would be placed in the combination. Petition, 84–85, 116–17.



Petition, 116 (showing Marton's FIG. 3 as annotated by Petitioner in Ground 5).

Accordingly, Petitioner fails to meet its burden that the claims challenged in Grounds 3 and 5 are more likely than not to be unpatentable. Having adopted one interpretation in Grounds 2 and 4, Petitioner cannot reverse course in Grounds 3 and 5 and relocate those same features elsewhere in the prior art.

E. The claims satisfy the written description requirement (Ground 1, Claims 1–20).

Petitioner asserts claims 1–20 are “[u]npatentable under 35 U.S.C. § 112(a) for lack of written description.” Petition, 6. Plaintiff’s “Ground 1” actually contains six different written description arguments: two that collectively challenge aspects of the three independent claims; and four more challenging narrow aspects

of dependent claims. Those challenges all fail, for the reasons described below.

The written “description requirement does not demand any particular form of disclosure,” nor “that the specification recite the claimed invention *in haec verba*.”

Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc). That principle alone disposes most of Petitioner’s arguments.

1. The disclosure supports “a proximal end of the push rod assembly is connected to the eccentric shaft at a location offset from the dividing plane in a first direction.”

Petitioner alleges the specification fails to disclose “a proximal end of the push rod assembly is connected to the eccentric shaft at a location offset from the dividing plane in a first direction” as recited in claim 1. Yet, Petitioner’s own annotations to the ’919 patent’s Figure 22B concede that it shows each of these features. Petition, 37–38.

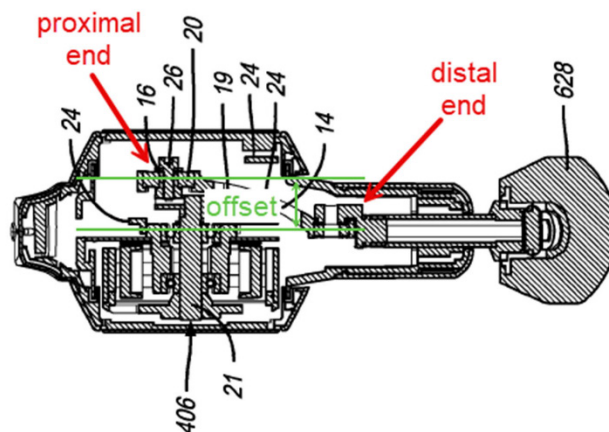


FIG. 22B

Petition, 38.

The challenged claim features—the push rod assembly (including push rod 14 and an un-numbered output shaft that extends to the attachment 628), a

proximal end connected to the eccentric shaft (shaft 16), and that connection being offset from the dividing plane—all appear in the figure above. This alone supports the challenged element because “drawings alone may provide a ‘written description’ of an invention as required by § 112.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991).

Petitioner argues that this claim limitation is unsupported because the location of the proximal end is not limited to “the distal end of the push rod 14,” but instead to “a location offset from the dividing plane.” Petition, 38. Yet both are unquestionably disclosed in the ’919 Patent. The challenged claims’ “dividing plane” is defined relative to the “reciprocation axis” and “motor axis,” i.e., “the reciprocation axis extends transverse to the handle portion on a dividing plane normal to the motor axis.” So defining the location as offset relative to the “dividing plane” means that it is both offset from the reciprocation axis and “normal to the motor axis.” The specification describes this relationship: “the point where the push rod 14 is connected to the shaft 16 is *offset* from the *reciprocating path* that the distal end 18 of the push rod 14 ... travel[s].” EX1001, 14:62–65. *Id.* Petitioner’s own annotations to Figure 22B show that the direction of the offset in the embodiment of Figure 22B is indeed away from a plane normal to the motor axis.

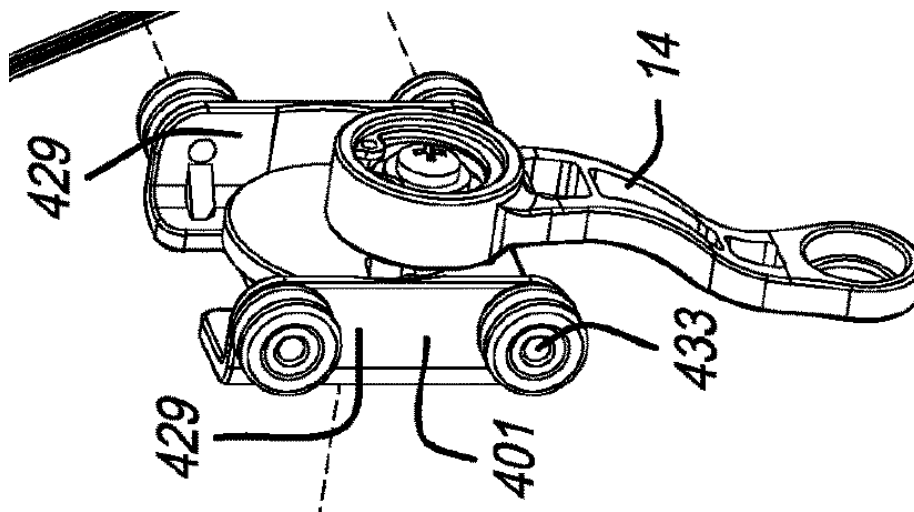
Petitioner’s arguments rely on *Gentry Gallery, Inc. v. Berkline Corp.*, 134

F.3d 1473 (Fed. Cir. 1998) and *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368 (Fed. Cir. 2009). Petition, 38. Those cases are readily distinguishable. *Gentry Gallery* concerned a patent where “the original disclosure clearly identifies the console as the only possible location for the controls,” and “locating the controls anywhere but on the console is outside the stated purpose of the invention.” Petition, 38; *Gentry Gallery*, 134 F.3d at 1479. This led the court to consider locating recliner controls on the console an “essential element” of the invention. *Gentry Gallery*, 134 F.3d at 1479. And “in *ICU Medical*, the specification at issue was clear that having a spike within the medical valve was necessary to the use of the claimed invention.” *Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.*, 635 F.3d 1373, 1382 (Fed. Cir. 2011) (distinguishing *ICU Medical* on the basis that the patent at issue contained “no such narrow disclosure” because it disclosed an alternative to the allegedly necessary feature). “[T]he entirety of the specification in *ICU Medical* described *only* medical valves having spikes.” *Allergan USA, Inc. v. MSN Lab’ys Priv. Ltd.*, 111 F.4th 1358, 1375 (Fed. Cir. 2024) (emphasis in original). Because the figures and description failed to “demonstrate that the inventor possessed a medical valve that operated without a spike,” the court concluded “a person of skill in the art would not understand the inventor of the ... patents to have invented a spikeless medical valve” and held the relevant claims invalid. *ICU Med.*, 558 F.3d at 1377–78.

By contrast, the '919 Patent *does* disclose the claimed arrangement of “a proximal end of the push rod assembly is connected to the eccentric shaft at a location offset from the dividing plane in a first direction,” as shown in Figure 22 and the accompanying description. EX1001, 14:62–65 (“Preferably, the point where the push rod 14 is connected to the shaft 16 is offset from the reciprocating path that the distal end 18 of the push rod 14 (and the massage attachment 628) travel.”). And the '919 Patent *does not* identify “an L-shaped or arc shaped push rod” (Petition, 37) as the “only possible” way to implement a push rod assembly connected “at a location offset from the dividing plane” of the motor axis. Rather, the '919 Patent provides arcuate or L-shapes for the push rod as *examples* of how to achieve the claimed offset without excluding alternatives. EX1001, 14:62–66. This is demonstrated where the specification explains how to achieve the claimed offset in a way that is not specific to the arc or L-shape. EX1001, 14:66–15:6 (“the push rod 14 is designed such that it can transmit the force at least partially *diagonally or in an arc* along its shape instead of vertically so the motor can be located at or near the middle of the device” (emphasis added)).

In these respects, the '919 Patent's disclosure regarding the offset point of connection is like the disclosure of “sorting and storing” in a patent at issue in *ScriptPro LLC v. Innovation Assocs., Inc.*, 833 F.3d 1336, 1341–42 (Fed. Cir. 2016), where the Federal Circuit distinguished both *Gentry Gallery* and *ICU*

Medical. In *ScriptPro*, the Court determined a patent's disclosure was not limited to a specific method of sorting and storing information, explaining that "a specification's focus on one particular embodiment or purpose cannot limit the described invention where that specification expressly contemplates other embodiments or purposes. This is especially true in cases such as this, where the originally filed claims are not limited to the embodiment or purpose that is the focus of the specification." *ScriptPro, LLC*, 833 F.3d at 1341. The '919 Patent contemplates embodiments without the arc or L-shaped push rod as well as purposes that have nothing to do with the offset point of connection. For example, Figure 32 of the '919 Patent shows a push rod 14 that would be better described as S-shaped than as arcuate or L-shaped.



EX1001, FIG. 32 (cropped).

The disclosure of an alternative to the arc or L-shape for the push rod is enough on its own to establish that the disclosure is not limited to those shapes.

Crown Packaging Tech., 635 F.3d at 1382 (distinguishing *ICU Medical* on the basis that the patent at issue contained “no such narrow disclosure” because it disclosed an alternative to the allegedly necessary feature); *Allergan USA*, 111 F.4th at 1375 (distinguishing *ICU Medical* on the basis that the patent at issue disclosed embodiments without the allegedly necessary feature).

And regarding the purposes of the inventions disclosed in the ’919 Patent, the Background describes “a need for a percussive therapy device to be automated to provide effective massage or recovery.” EX1001, 1:59–61. The Summary goes on to mention a variety of inventive concepts that do not relate to the offset point of connection, much less to a specific arcuate or L-shape for the push rod. EX1001, 1:66–3:8. It therefore cannot be said that the purpose of the inventions of the ’919 patent is limited to an arcuate or L-shaped push rod.

Finally, the originally filed claims of the ’919 Patent were not limited to an arcuate or L-shape for the push rod. EX1006, 995–96.

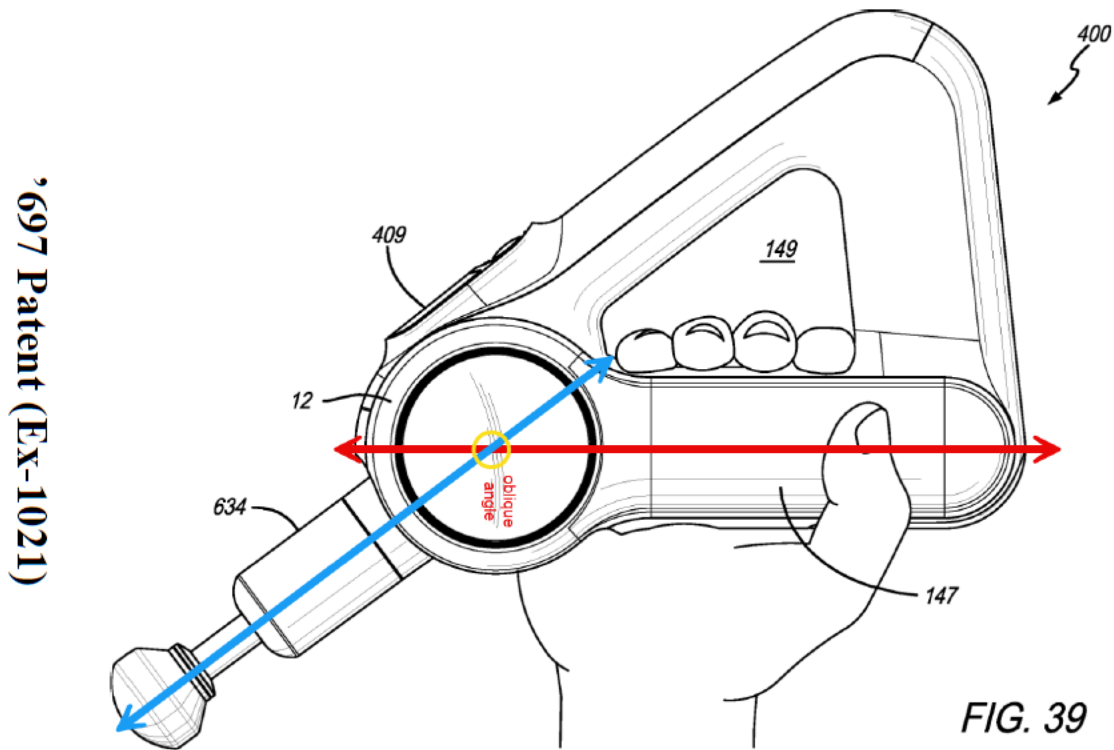
The ’919 Patent therefore displays every factor by which the *ScriptPro* court distinguished *Gentry Gallery* and *ICU Medical*. Thus, this element is fully supported in the specification.

2. The disclosure supports “the handle portion axis extends at an oblique angle to the reciprocation axis and intersects ... the motor axis.”

The ’919 Patent discloses this limitation. First, Petitioner’s own arguments

provide an example of how the '919 Patent supports this limitation. Petitioner acknowledges this feature is disclosed in U.S. Patent No. 11,357,697 (“the '697 Patent,” EX1021) and that the '697 Patent is incorporated by reference into the '919 Patent. Petition, 41; EX1001, 1:7–46. 37 C.F.R. § 1.57(d) states that “[e]ssential material’ may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference.” 37 C.F.R. § 1.57(d). The '697 Patent *is* a U.S. patent (not an unpublished application as in *Maquet*, nor a provisional application as in *ZTE*), so it is a source from which, even if needed, “[e]ssential material’ may be incorporated by reference.” Petitioner’s only response to this incorporation by reference—that § 1.57(d) purportedly “does not allow for multi-generational incorporation”—finds no support in the Rule or in precedent. Petition, 41.

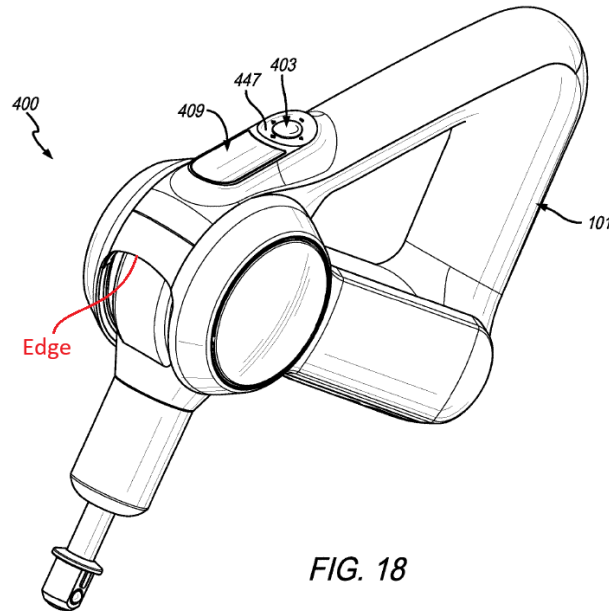
The reference statement was included in the '919 Patent specification upon filing. EX1001, ¶[0001]; EX1003, 904. 37 C.F.R. § 1.57(d) permits this incorporation, even if it relates to essential material, because the '697 Patent is a U.S. patent. 37 C.F.R. § 1.57(d). Petitioner cites no authority to support its argument that this incorporation was ineffective.



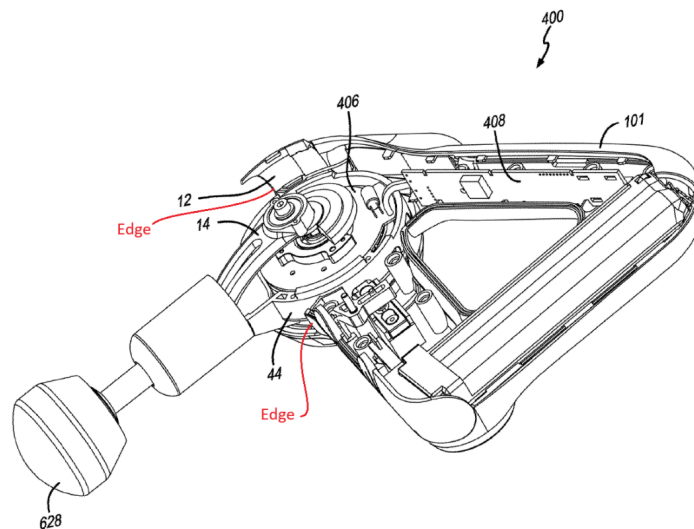
Petition, 41 (showing FIG. 39 of the '697 Patent as annotated by Petitioner).

Second, even without incorporating the '697 Patent, the specification of the '919 Patent discloses the same capability as Figure 39 of the '697 Patent, and thus independently supports this limitation. The '919 Patent discloses the percussive massage device 400 “can include a rotatable arm that is part of rotation housing 44.” EX1001, 14:50–52. The range of rotation available to the rotation housing 44 is shown in Figures 18 and 21 by the edges of the opening in the enclosing head portion 12. EX1001, Figures 18 and 21. These drawings make it clear that the rotation housing 44 can rotate to the position described in claims 2 and 18, i.e., placing the reciprocation axis at an obtuse angle to the axis of the lower handle

portion that also intersects the motor axis. This is the same feature shown in Figure 39 of the '697 Patent, which Petitioner concedes supports the limitation. *See* EX1021, 22:50–23:5, FIGS. 33 and 41.



EX1001, FIG. 18 (annotated).



Petitioner ignores Figures 18 and 21 of the '919 Patent and how they

compare with the relevant features of the incorporated '697 Patent, instead looking only to the '919 Patent's Figure 1, when the reciprocation axis is specifically set at a right angle to one of the handle portions. Petition, 40. Petitioner's limited analysis of only one figure in the '919 patent cannot establish that the '919 Patent's written description is deficient.

Thus, this element is fully supported in the specification.

3. The disclosure supports “the common plane bisects the housing.”

Petitioner alleges the “common plane” within claim 9's limitation of “the common plane bisects the housing” is “yet another undisclosed ‘plane.’” Petition, 42. But Petitioner concedes the specification describes a “motor shaft axis A4 (or a **plane** defined by the motor shaft axis) **bisects the housing 101.**” *Id.*; EX1001, 23:31–32. That this disclosure appears in the embodiments of Figures 29–33 rather than that of Figures 18–23A does not prevent it from supporting the claims for three reasons.

First, contrary to Petitioner's assertions, the embodiment of Figures 29–33 was not “later-added”; it was present in the '073 Application as originally filed and remains present in the '919 Patent. Petition, 42; EX1003, 943–44, 997–1001; EX1001, 23:31–32.

Second, this conceptual disclosure with respect to the housing 101 of the embodiment of Figures 29–33 is also relevant to the housing 101 of the

embodiment of Figures 19–23A. The housings of both embodiments (both labeled with numeral 101) are materially alike such that this description regarding the embodiment of Figures 29–33 proves the inventors had possession of the concept that a centrally-located axis would define a plane that bisects either housing 101.

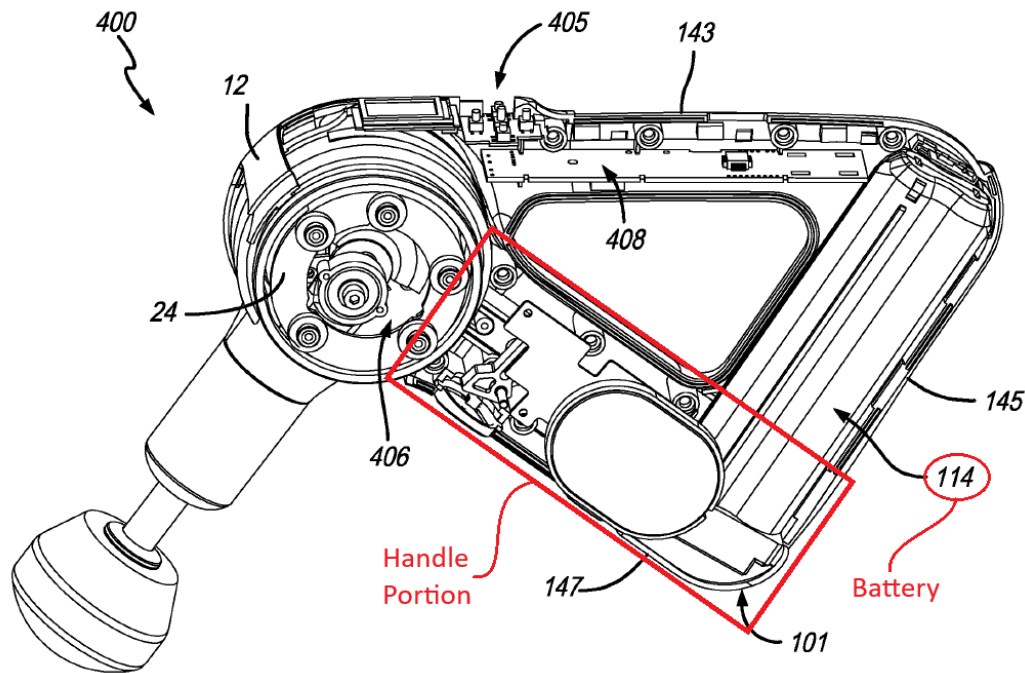
Third, nearly the same limitation can be found in claim 21 of U.S. Patent No. 10,857,064, which the '919 Patent incorporates by reference. EX1015, claim 21 (“The method of claim 16 wherein a transverse plane that bifurcates the housing extends through the handle opening”).

4. The disclosure supports “a battery housed in the handle portion.”

Petitioner argues the '919 Patent fails to support “a battery housed in the handle portion” as recited in claim 10. Petition, 43. Petitioner argues this feature as recited in claim 10 is incompatible with claim 1’s recitation of “an interior angle defined between the handle portion and the output shaft is obtuse” because “the specification only describes the battery 114 as being in the second handle portion 145, which is parallel to the output shaft.” Petition, 43.

The claim feature of “a battery housed in the handle portion” is supported at least in Figure 19, which shows the battery 114 housed in the handle portion 147. EX1001, FIG. 19. The '919 Patent provides written description for an internal angle between the handle portion 147 and the output shaft being obtuse as discussed above in Section V.E.2, meaning claim 10 is also supported without any

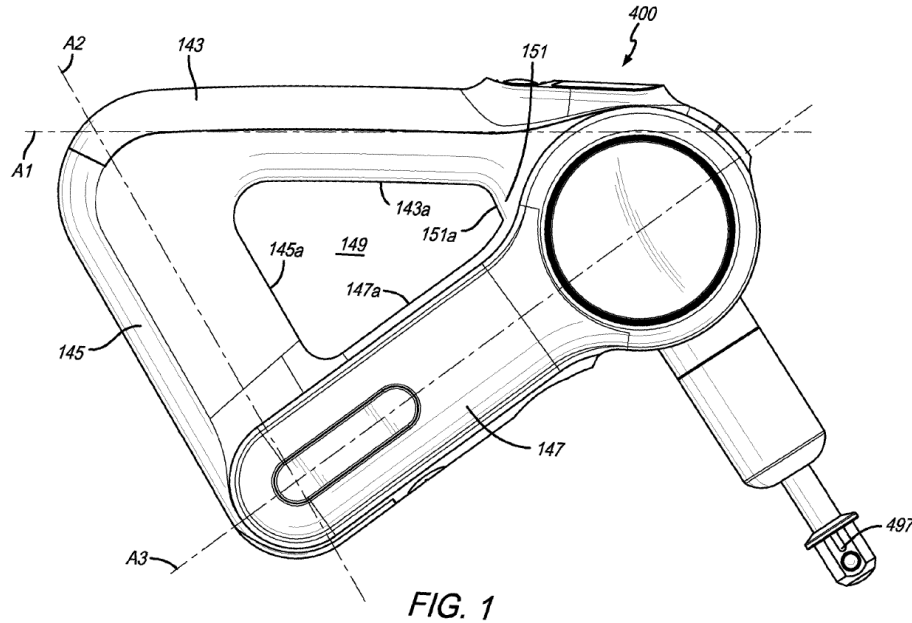
conflict with the features of claim 1.



EX1001, FIG. 19 (annotated).

5. The disclosure supports a “handle.”

Petitioner argues the specification’s disclosure of three “handle portions” fails to demonstrate possession of a handle that includes a handle portion as recited in claim 16 but provides no explanation as to why it would not be immediately apparent that a “handle portion” is inevitably part of a “handle.” The ’919 Patent describes how “the percussive massager device 400 includes three handle portions (referred to herein as first handle portion 143, second handle portion 145 and third handle portion 147) that cooperate to define a central or handle opening 149.” EX1001, 6:15–22.



EX1001, FIG. 1.

The existence of a “handle opening 149” necessitates the existence of a “handle” to contain it, and the fact that “the three handle portions ... cooperate to define” the “handle opening 149” means the handle portions are included in the handle.

6. The disclosure supports “a housing comprises a first portion ... [and] a second portion.”

Petitioner argues the '919 Patent does not “reasonably convey a housing comprising ‘a first portion’ and ‘a second portion’” as recited in claims 11 and 17. Petition, 44. But the '919 specification discloses housing 101 including many more than just two portions. The housing 101 is part of the embodiment of Figures 18–23A. EX1001, 14:37–42, 14:49–55. And, as shown at least in Figure 18, the housing clearly has at least two portions. EX1001, FIG. 18.

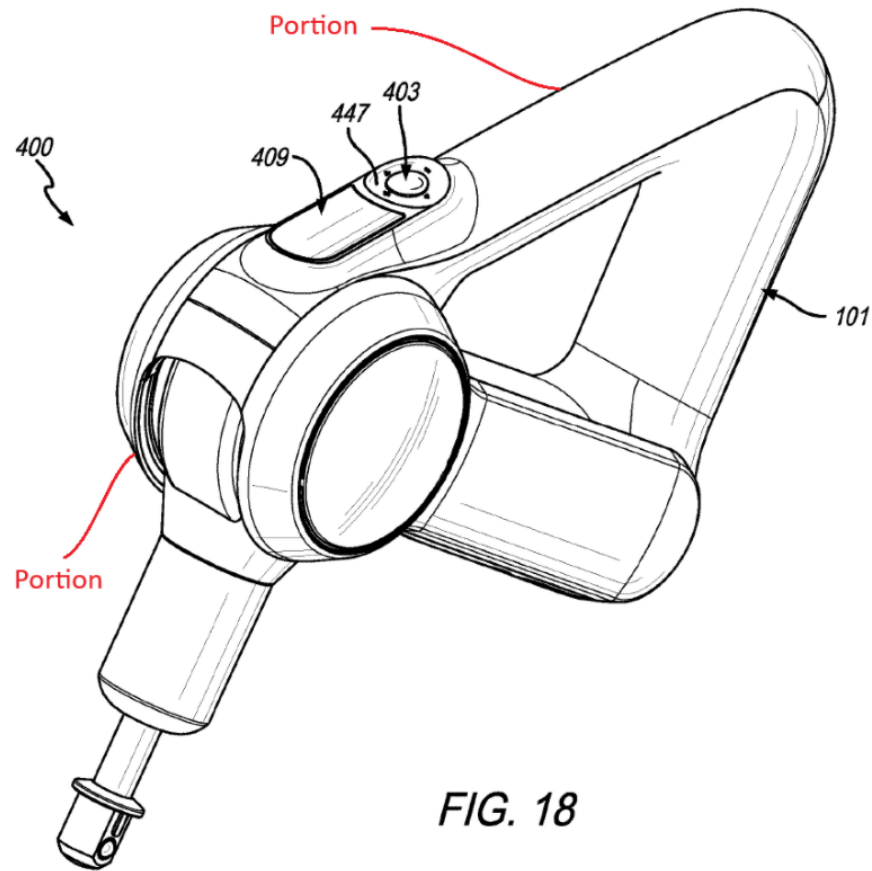
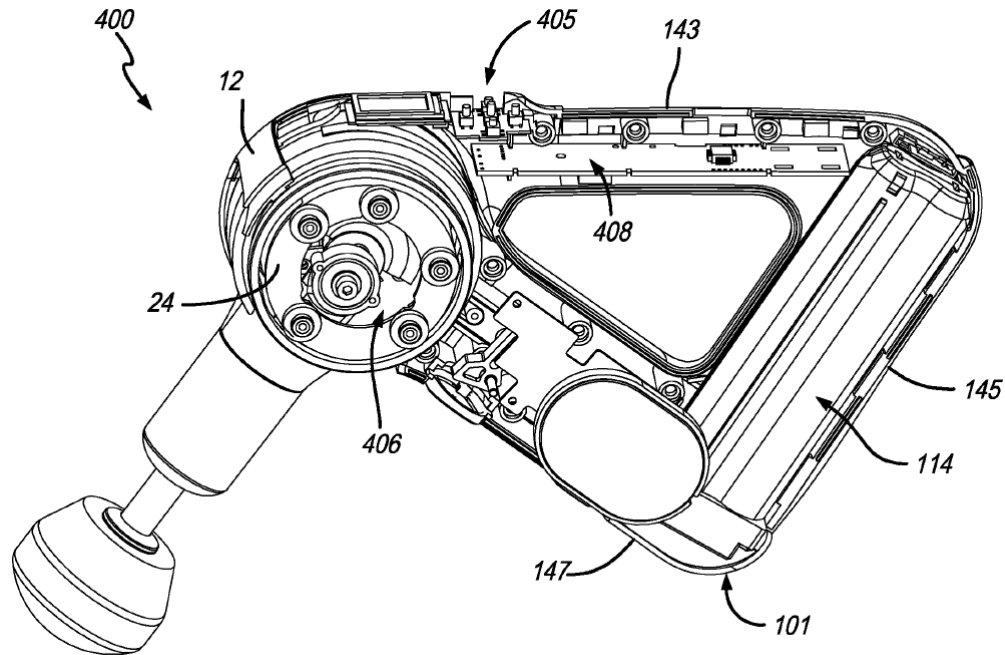


FIG. 18

EX1001, FIG. 18 (annotated).

Further, the specification describes the housing of the embodiment of Figures 18–23A as being dividable into “portions” in its description that “[t]he motor 406 is located in the rotation housing 44, which is housed with **the head portion 12 of the housing 101.**” EX1001, 14:52–54 (emphasis added). As another example, at least Figure 19 shows that the first, second, and third handle “portions” 143, 145, 147 are all parts of the housing 101. EX1001, FIG. 19. Contrary to the Petition’s argument, all of these portions of the disclosure were present in the ’073 Application as originally filed. EX1003, 913–14, 928–29, 968, 982–83.



EX1001, FIG. 19.

The written description of the '919 Patent also includes language that was added during prosecution and mirrors the exact language challenged in Ground 1F. EX1001, 15:61–65; EX1003, 289 (showing the corresponding mid-prosecution amendment to the specification). The specification of the '919 Patent expressly discloses “[t]he housing comprises a first portion that extends away from the handle portion and encloses a portion of the push rod assembly, and the housing comprises a second portion that extends away from the handle portion and the first portion.” EX1001, 15:61–65. The Examiner’s decision to allow this amended language to persist into the written description of the '919 Patent shows he considered it and determined it added no new matter.

**VI. THE PETITION’S DEFICIENCIES WARRANT DENIAL UNDER
CHEVRON AND *DEEPER*.**

The merits consideration phase of a PGR includes determining whether the petition presents a sufficient number of grounds/challenges that meet the reasonable likelihood standard. When “a petition meets the standards for institution in relation to fewer than all the challenges presented, or where deficiencies in the petition ... affect only a portion of the challenges presented, the [Board] will evaluate all the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied.” Trial Practice Guide, § II.D.3 (citing 35 U.S.C. §§ 316(b), 326(b)); *accord Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (P.T.A.B. Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (P.T.A.B. Jan. 24, 2019) (informative).

As discussed throughout this Preliminary Response, the Petition’s eleven separate grounds and sub-grounds each suffer from numerous fatal deficiencies. Given these defects, institution of trial should be denied even if some of the claims or Grounds meet the standard for institution—which they do not.

Instituting review would not be an efficient use of the Board’s time and resources where resolving this proceeding would require costly and time-consuming adjudication of challenges that are flawed from the outset. *See Interim*

Process Memo for PTAB Workload Management,¹ 3; 35 U.S.C. § 326(b).

VII. CONCLUSION

The Petition fails to show that any of the challenged claims is more likely than not unpatentable and, therefore, the Board should deny institution.

Respectfully submitted,

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¹ Available at

<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 18,700 words, comprising 12,880 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word in 14-point Times New Roman font.

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER PRELIMINARY
RESPONSE UNDER 37 C.F.R. § 42.207(a)** and associated Exhibits 2018–2019
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