

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

THERABODY, INC.,

Petitioner

v.

DATAFEEL INC.,

Patent Owner.

---

Case No.: PGR2025-00026  
U.S. Patent No. 12,036,174

---

**PATENT OWNER'S PRELIMINARY RESPONSE  
PURSUANT TO 37 C.F.R. §42.207**

## TABLE OF CONTENTS

EXHIBIT LIST .....	ii
I. INTRODUCTION .....	1
II. THE '174 PATENT .....	3
1. Overview .....	3
2. Relevant Prosecution History .....	4
III. RELEVANT PRIOR ART.....	5
IV. LEVEL OF ORDINARY SKILL IN THE ART .....	5
V. CLAIM CONSTRUCTION.....	6
VI. DEFECTS IN GROUNDS OF UNPATENTABILITY.....	6
A. Defects in Ground 5 – Written Description (§ 112) .....	7
B. Defects in Ground 6 – Enablement (§ 112).....	11
C. Defects in the Petition’s § 103 Grounds .....	18
1. Ground 2: Petitioner Fails to Establish that Claim 4 is Unpatentable as Obvious Over Lee in view of Barasch and Choi.....	18
2. Ground 4: Petitioner Fails to Establish that Claim 4 is Unpatentable as Obvious Over Giraud in View of Choi.....	20
VII. CONCLUSION.....	23
CERTIFICATE OF COMPLIANCE .....	24

## EXHIBIT LIST

Exhibit No.	Description
2001	Minutes of Scheduling Conference entered December 20, 2024, in case 8:24-cv-02034-JWH-DFM
2002	Defendant Therabody, Inc's Disclosure of Invalidity Contentions, served March 7, 2025.
2003	Lex Machina Motion Metrics Report, District Judge John William Holcomb (generated May 27, 2025)
2004	Lex Machina C.D. Cal. Patent Cases Report (generated May 27, 2025)
2005	Lex Machina C.D. Cal. District Judge John William Holcomb Patent Cases Report (generated May 27, 2025)
2006	Statutory disclaimer of claims 1-3 and 5-19 of USPN 12,036,174 filed in Application No. 18/526,980

## TABLE OF AUTHORITIES

	<b>Page(s)</b>
<b>Cases</b>	
<i>Ariad Pharms., Inc. v. Eli Lilly &amp; Co.</i> , 598 F.3d 1336 (Fed. Cir. 2010) (en banc).....	7, 8
<i>Baxalta Inc. v. Genentech, Inc.</i> , 81 F.4th 1362 (Fed. Cir. 2023).....	12
<i>Boston Sci. Corp. v. Johnson &amp; Johnson</i> , 647 F.3d 1353 (Fed. Cir. 2011).....	8
<i>Capon v. Eshhar</i> , 418 F.3d 1349 (Fed. Cir. 2005).....	7
<i>Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.</i> , 289 F.3d 801 (Fed. Cir. 2002).....	8
<i>Falko-Gunter Falkner v. Inglis</i> , 448 F.3d 1357 (Fed. Cir. 2006).....	8
<i>In re Forman</i> , 230 USPQ 546 (BPAI 1986).....	12
<i>Genentech, Inc. v. Novo Nordisk, A/S</i> , 108 F.3d 1361 (Fed. Cir. 1997).....	11
<i>Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.</i> , 868 F.3d 1013 (Fed. Cir. 2017).....	6
<i>Phison Electronics Corp. v. Vervain, LLC</i> , PGR2024-00047, Paper 9 (March 17, 2025) .....	11, 12
<i>Pitney Bowes, Inc. v. Hewlett–Packard Co.</i> , 182 F.3d 1298 (Fed. Cir. 1999).....	8
<i>Raytheon Technologies Corp. v. General Electric Company</i> , 993 F.3d 1374 (Fed. Cir. 2021).....	1

<i>Vas-Cath Inc. v. Mahurkar</i> , 935 F.2d 1555 (Fed. Cir. 1991).....	7
<i>Vivid Techs., Inc. v. Am. Sci. &amp; Eng’g, Inc.</i> , 200 F.3d 795 (Fed. Cir. 1999).....	6
<i>In re Wands</i> , 858 F.2d 731 (Fed. Cir. 1988).....	11, 12
<i>In re Wright</i> , 999 F.2d 1557 (Fed. Cir. 1993).....	11
<b>Statutes</b>	
35 U.S.C. § 102 .....	7
35 U.S.C. § 103 .....	2, 7, 17
35 U.S.C. § 112 .....	2, 6, 7, 11, 12
35 U.S.C. § 112(a).....	7
35 U.S.C. § 324 .....	2
35 U.S.C. § 324(a).....	7
<b>Other Authorities</b>	
37 C.F.R. §42.6(a)(2)(ii) .....	24
37 C.F.R. §42.6(a)(2)(iii) .....	24
37 C.F.R. §42.24(a)(1) .....	24
37 C.F.R. §42.24(d).....	24
37 C.F.R. § 42.207 (e).....	1
89 Fed. Reg. 1,563, 1,565–66 (Jan. 10, 2024) .....	12
U.S. Patent No. 12,036,174.....	1, 2, 3, 4

## I. INTRODUCTION

Patent Owner DataFeel Inc. (“Patent Owner”) submits its Preliminary Response to the Petition for Post-Grant Review No. PGR2025-00026 (“Petition” or “Pet.”) filed on January 17, 2025, by Therabody, Inc. (“Petitioner”) challenging claims 1-19 of U.S. Patent No. 12,036,174 (the “Challenged Claims”). Ex. 1001 (the “’174 Patent”).

Patent Owner has disclaimed claims 1-3 and 5-19, leaving only claim 4 at issue in this proceeding.<sup>1</sup> Accordingly, Patent Owner’s Preliminary Response

---

<sup>1</sup> Patent Owner has contemporaneously filed a statutory disclaimer with the USPTO for claims 1-3 and 5-19 of the ’174 Patent. *See* Exhibit 2006. Pursuant to 37 C.F.R. § 42.207 (e), “[n]o post-grant review will be instituted based on disclaimed claims.” Accordingly, Patent Owner respectfully submits that the Board should not institute any post-grant review based on the disclaimed claims of the ’174 Patent, and Patent Owner will not otherwise address the disclaimed claims in this Preliminary Response. Patent Owner is not making any admission as to the validity of the disclaimed claims. Thus, no adverse inference shall result from the disclaimer, and the disclaimer shall have no effect on the non-disclaimed claims of the ’174 Patent. *See Raytheon Technologies Corp. v. General Electric Company*, 993 F.3d 1374, 1379, n.4 (Fed. Cir. 2021) (internal citations and quotations omitted) (“Disclaimed claims are treated as if they never existed, ... and disclaimer does not legally constitute an admission that the subject of the disclaimer appears in the prior art.”).

addresses only Grounds 2, 4, 5, and 6 – the only Grounds addressing claim 4 – and only as they relate to claim 4.

As detailed in its separately-filed Request for Discretionary Denial, Patent Owner respectfully submits that the Board should exercise its discretion and deny institution under 35 U.S.C. § 324 for each of the reasons set forth in the Request for Discretionary Denial, including the advanced stage of the underlying district court litigation.<sup>2</sup> To the extent the Board reaches the merits of Petitioner’s asserted Grounds, the Board should deny institution because the Petition presents superficial and unsupported § 112 arguments contrary to legal precedent, and because the prior art utilized in the Petition’s § 103 arguments fails to disclose or suggest several essential elements of claim 4.

---

<sup>2</sup> As referred to herein, the “underlying district court litigation” or “underlying litigation” refers to Case No. 8:24-cv-02034-JWH-DFM, titled *Hyper Ice, Inc. v. Therabody, Inc.*, which along with Case No. 8:24-cv-02092-JWH-DFM was consolidated into Case No. 8:24-cv-01472-JWH-DFM, all pending in the Central District of California. *See* Ex. 2001 at p. 2. Hyperice is the sole licensee that has been granted the express, irrevocable right to, inter alia, sublicense, enforce, and defend the ’174 Patent. In the underlying district court litigation, Hyperice contends that certain Therabody products infringe the ’174 Patent. Therabody contends that it does not infringe any asserted claim, and that all asserted claims are invalid.

## II. THE '174 PATENT

### 1. Overview

The '174 Patent is generally directed to treatment devices with energy generators and energy generator elements that communicate and transmit different energy types toward an area of skin of a user. *See* Ex. 1001 at Abstract. These energy types include, for example, heat energy, impact energy, electrical energy, and pressure energy. *See id.* at 17:66 – 19:36. Figure 3A shows an exemplary energy generator, and Figure 4A shows that energy generator applying a percussive impact energy directed toward the skin:

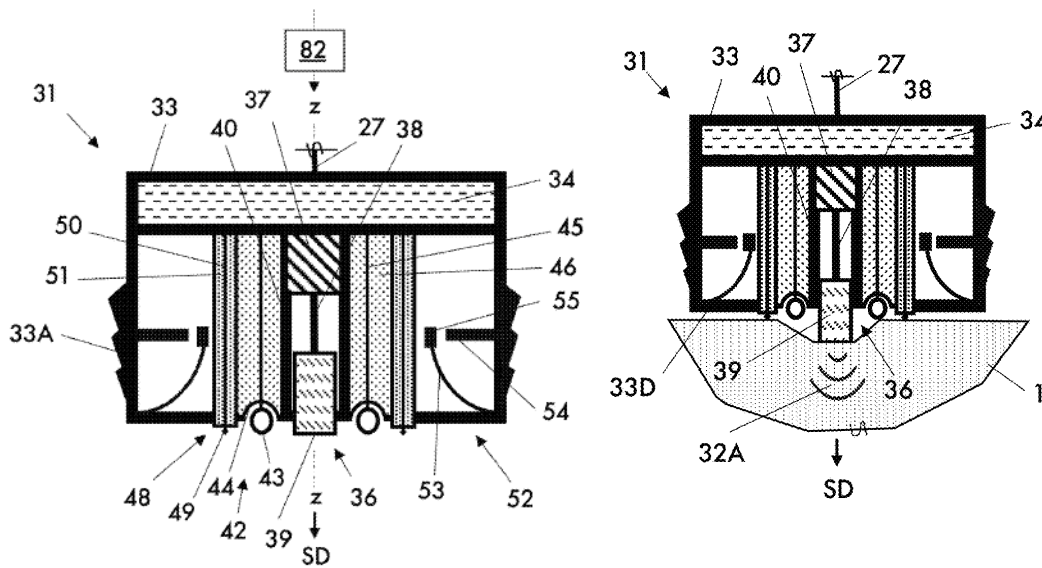


FIG. 3A

FIG. 4A

Independent claim 1, and its dependent claim 4, claim as follows:

1. A treatment device, comprising:
  - a body provided with a processing unit and a power source; and
  - a plurality of energy generator elements being independently operable to convert electricity from the power source into a plurality of

different energy types transmittable towards an area of skin of a user, the plurality of energy generator elements being arranged coaxially about an axis,

wherein the body includes a grip arranged to be grasped by a hand of the user applying a gripping force to maintain the plurality of energy generator elements on or adjacent the area of skin,

wherein the plurality of energy generator elements includes a first energy generator element and a second energy generator element, and wherein the first energy generator element is an impact generator element having a tissue contact surface that is linearly actuatable along the axis to contact and cause corresponding physical movement of the area of skin.

\* \* \*

4. The treatment device of claim 1, wherein the second energy generator element includes a reflecting groove circumferentially arranged about the axis, the reflecting groove defining a concave shape arranged to reflect energy generated from the second energy generator element towards the area of skin.

Ex. 1001 at 40:48-67, 41:9-15.

## **2. Relevant Prosecution History**

Applicant filed the application leading to the '174 Patent on December 1, 2023 as U.S. Patent App. No. 18/526,980, claiming priority to several related applications and to provisional application Nos. 62/676,949 and 62/575,951, filed on May 26, 2018 and October 23, 2017, respectively. Following the Applicant's Preliminary Amendment on February 5, 2024, the Examiner allowed all claims without any

rejections. *See* Ex. 1004 at 865-83. After allowance, Applicant amended several claims, and the Examiner again allowed the claims without any rejections. *See id.* at 1475-85.

### **III. RELEVANT PRIOR ART**

Petitioner's cited prior art references encompass disparate types of mechanical devices, which Petitioner attempts to combine to arrive at the claimed embodiments but that are the result of improper hindsight reconstruction. Specifically, with respect to Ground 2, Petitioner relies upon Lee (Exs. 1005 & 1006), which is directed to a first category of mechanical devices associated with percussive massage; Barasch (Ex. 1007), which is directed to a second category of mechanical devices in which the device communicates user feedback messages; and Choi (Exs. 1008 & 1009), which is directed to a third category of mechanical devices associated with vibration massage. With respect to Ground 4, Petitioner relies upon Giraud (Ex. 1011), which is directed to a fourth category of mechanical devices associated with beauty treatment for facial skin.

As explained below, the prior art references, individually or in combination, fail to teach or suggest the limitations of claim 4.

### **IV. LEVEL OF ORDINARY SKILL IN THE ART**

The relevant field of art is devices for applying percussive massage to a selected portion of the body. A person of ordinary skill in the art ("POSITA") as of the effective filing date of the Challenged Claims would have a working knowledge of product development and would likely have a degree in engineering and/or

industrial design and/or at least three to five years of experience in conceiving, designing, engineering, and/or modifying such products and devices.

## V. CLAIM CONSTRUCTION

Claim construction proceedings are underway the underlying litigation. However, at this stage of the proceeding and in view of the deficiencies in Petitioner's grounds of unpatentability regarding claim 4, Patent Owner submits that no claim construction is necessary. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (applying *Vivid Techs.* in the context of an *inter partes* review).

## VI. DEFECTS IN GROUNDS OF UNPATENTABILITY

The Board should deny institution on the merits because Petitioner fails to meet its burden to show that the sole remaining claim, claim 4, is more likely than not<sup>3</sup> to be non-compliant with the statutory requirements of 35 U.S.C. § 112 or

---

<sup>3</sup> “Comparing the two [AIA trial institution] standards, the ‘reasonable likelihood’ standard is lower than the ‘more likely than not’ standard. The reasonable likelihood standard allows for the exercise of discretion but encompasses a 50/50 chance whereas **the ‘more likely than not’ standard requires greater than a 50% chance of prevailing.**” <https://www.uspto.gov/patents/laws/america-invents-act-aia/message-chief-judge-james-donald-smith-board#heading-1> (accessed March 25, 2025) (emphasis added).

obvious under 35 U.S.C. § 103.<sup>4</sup> See 35 U.S.C. § 324(a). The individual Grounds suffer from flawed applications of the statutory bases for invalidity, flawed technical analyses of the prior art, and failure to set forth any reason why a POSITA would have modified the various references to arrive at the claimed embodiments and explain why a POSITA would have a reasonable expectation of success with the various modifications.

**A. Defects in Ground 5 – Written Description (§ 112)**

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

---

<sup>4</sup> Petitioner does not raise any anticipation grounds under 35 U.S.C. § 102 and, thus, concedes that the claimed inventions are novel.

perspective of person of ordinary skill in the art, in some instances, a patentee can rely on information that is “well-known in the art” to satisfy written description). “A patent need not teach, and preferably omits, what is well known in the art.” *Falko-Gunter Falkner v. Inglis*, 448 F.3d 1357, 1365 (Fed. Cir. 2006).

Petitioner’s lone written description argument is that “the specification fails to demonstrate possession of the claimed invention of a treatment device with energy generator elements that only provide treatment functionality and no communication functionality.” Pet. at 85. First, the preamble is limiting only “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett–Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). Here, the preamble should not be treated as limiting because: (1) the preamble only provides a use, for the structure recited in the claims’ bodies, (2) the preamble does not impose any structural requirements beyond those explicitly provided in the claims’ bodies, (3) no arguments made during prosecution to overcome prior art relied on the “treatment device” language in the preamble, and (4) the preamble term “treatment device” does not supply antecedent basis for any term in any claim. Second, even if the term “treatment device” in the preamble of the claims is limiting – which it is not – Petitioner fails to explain the basis for its unfounded contention that the written description must disclose energy generator elements that only provide treatment functionality and no communication functionality. Moreover, Petitioner ignores the fact that the term “communication” is used broadly throughout the written description to include the communication of

treatments via a variety of energies including, for example, heat energy, impact energy, electrical energy, and pressure energy:

- “The body may comprise a plurality of **communication** bays, and each energy generator may be located in and configured to output the energy signal out of one of the **communication** bays. The body may comprise an insulating material configured to promote flows of the one or more energies out of each **communication** bay....” Ex. 1001 at 2:5-10.
- “An interior surface of each **communication** bay or hole may be configured to direct the one or more energies in the signal direction. The interior surface of each **communication** bay or hole may be configured to focus at least one energy of the one or more energies....” *Id.* at 2:16-20.
- “causing, with the processing unit, the plurality of energy generators in each band to **communicate** with nerves associated with the skin by outputting one or more energies of the plurality of energies in response to the input data.” *Id.* at 9:34-38.
- “Additional aspects of exemplary energy transceiver 10 are now described with reference to FIGS. 2A-C. As shown, transceiver 10 may comprise: a body 20; a tissue interface 30; a processing unit 60; and an attachment element 70. With these elements, and the variations described herein, energy transceiver 10 may be configured to **communicate** energy signal 90 to nerves associated with skin 2 by outputting the one or more energies 32 towards skin 2 with tissue interface 30.” *Id.* at 15:46-54.

- “As shown in FIG. 4A, for example, impact generator element 36 may be configured to **communicate** an **impact energy** 32A to the brain through nerves associated with skin 2. For example, impact generator element 36 may be a mechanical actuator that converts electricity from power source 66 into a mechanical movement recognizable by touch receptors of skin 2....” *Id.* at 18:1-7.
- Heat generator element 42 may be configured to **communicate** a **heat energy** 32B to the brain through nerves associated with skin 2. As shown in FIG. 4B, generator element 42 may include an electrical resistor that converts electricity from power source 66 into an amount of heat recognizable by temperature receptors of skin 2, such the Ruffini corpuscle. For example, heat generator element 42 may include an electrical resistor 43, a heat reflecting groove 44, a conductor 45, and an insulating material 46. *Id.* at 18:33-41.
- Shock generator element 48 may be configured to **communicate** an **electrical energy** 32C to the brain through nerves associated with skin 2. As shown in FIG. 4C, shock generator element 48 may be an electroshock generator that converts electricity from power source 66 into an electrical shock recognizable by electricity-sensitive receptors, such as the muscles and pain receptors located in the dermis layer of skin 2. For example, energy generator element 48 may include at least two electric contacts 49, a conductor 50, and an insulating material 51. *Id.* at 18:62 – 19:4.

- Pressure generator element 52 may be configured to **communicate** a **pressure energy** 32D to the brain through nerves associated with skin 2. As shown in FIG. 4D, pressure generator element 52 may be an electroacoustic transducer that converts electricity from power source 66 into a sound wave recognizable by pressure receptors of skin 2, such as the Pacinian corpuscle. For example, pressure generator element 52 may include a cone 53, a voice coil 54, and a magnet 55. *Id.* at 19:25-33.

The above excerpts illustrate that treatment may be provided when the generator elements communicate energies such as heat energy, impact energy, electrical energy, and pressure energy, through nerves associated with the skin.

**B. Defects in Ground 6 – Enablement (§ 112)**

As the PTAB recently explained in *Phison Electronics Corp. v. Vervain, LLC*:

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without “undue experimentation.” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993)). Determining the need for “undue experimentation” is not “a single, simple factual determination, but rather is a conclusion reached by weighing many” factors. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Those factors (the *Wands* factors) include:

- (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state

of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

*Id.* (citing *In re Forman*, 230 USPQ 546, 547 (BPAI 1986)).

The Federal Circuit did not “interpret *Amgen* to have disturbed [its] prior enablement case law, including *Wands* and its factors.” *Baxalta Inc. v. Genentech, Inc.*, 81 F.4th 1362, 1367 (Fed. Cir. 2023). The Office “continue[s] to use the *Wands* factors to ascertain whether the experimentation required to enable the full scope of the claimed invention is reasonable” because “Federal Circuit precedent applying the *Wands* factors prior to *Amgen* is still informative.” 89 Fed. Reg. 1,563, 1,565–66 (Jan. 10, 2024).

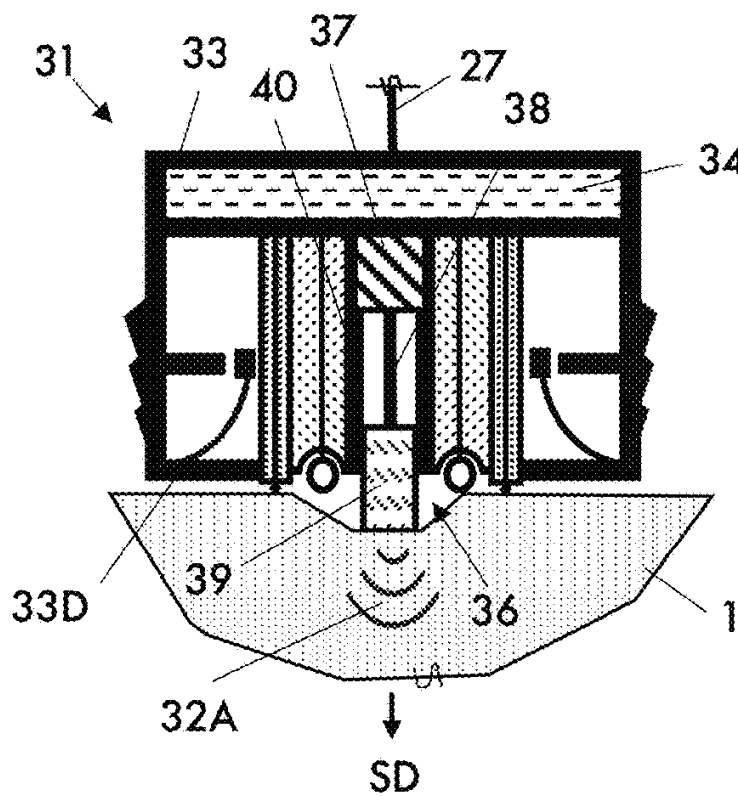
*Phison Electronics Corp. v. Vervain, LLC*, PGR2024-00047, Paper 9, \*35-36 (March 17, 2025).

Petitioner fails to even address *Wands* factors 1, 4, 5, 6, 7, or 8. For this reason alone, Petitioner’s enablement argument is deficient. *See Phison Electronics Corp.*, PGR2024-00047, Paper 9, \*39-40 (finding that the petitioner failed to support its § 112 enablement argument because it confused written description and enablement requirements and failed to consider the *Wands* factors).

Petitioner provides only a brief, conclusory analysis regarding *Wands* factors 2 and 3. Petitioner incorrectly contends that “the specification does not provide sufficient guidance and direction on how to utilize energy generator elements as part of a treatment device,” and Petitioner contends that the specification does not disclose any examples of outputting energies. Pet. at 91. These assertions could not

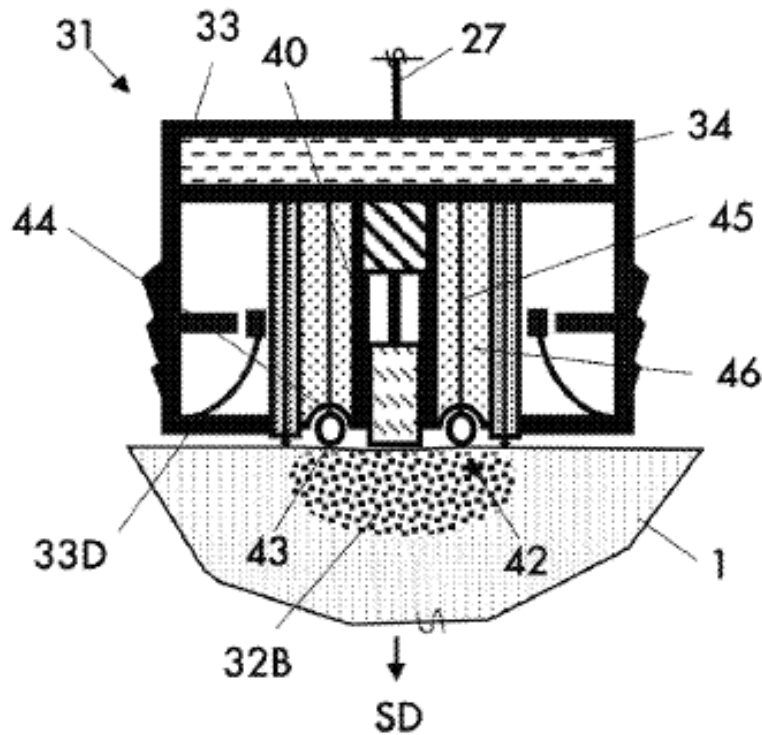


- “As shown in FIG. 4A, for example, **impact generator element 36** may be configured to communicate an **impact energy 32A** to the brain through nerves associated with skin 2. For example, impact generator element 36 may be a mechanical actuator that converts electricity from power source 66 into a mechanical movement recognizable by touch receptors of skin 2....” *Id.* at 18:1-7.



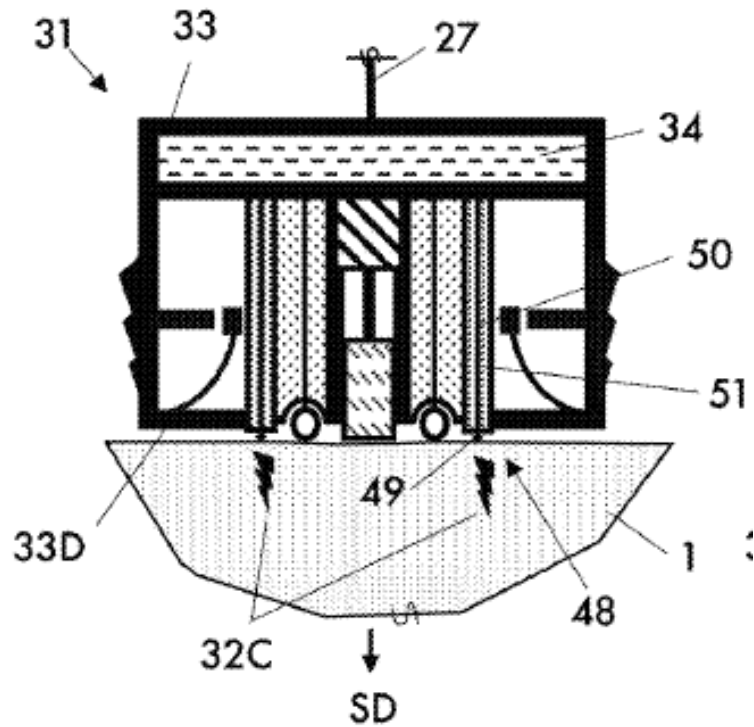
**FIG. 4A**

- “**Heat generator element 42** may be configured to communicate a **heat energy 32B** to the brain through nerves associated with skin 2. As shown in FIG. 4B, generator element 42 may include an electrical resistor that converts electricity from power source 66 into an amount of heat recognizable by temperature receptors of skin 2, such the Ruffini corpuscle. For example, heat generator element 42 may include an electrical resistor 43, a heat reflecting groove 44, a conductor 45, and an insulating material 46.” *Id.* at 18:33-41.



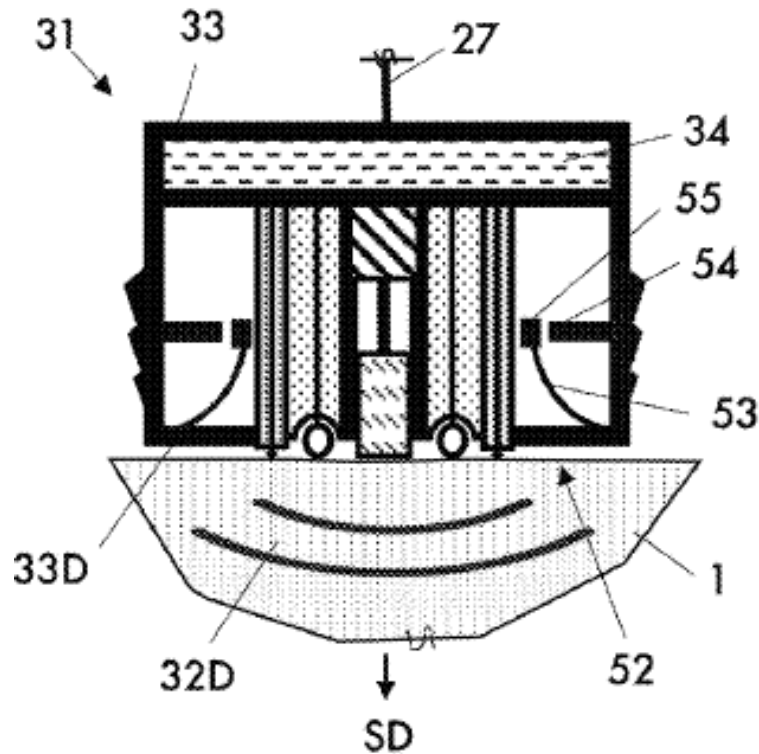
**FIG. 4B**

- “**Shock generator element 48** may be configured to communicate an **electrical energy 32C** to the brain through nerves associated with skin 2. As shown in FIG. 4C, shock generator element 48 may be an electroshock generator that converts electricity from power source 66 into an electrical shock recognizable by electricity-sensitive receptors, such as the muscles and pain receptors located in the dermis layer of skin 2. For example, **energy generator element 48** may include at least two electric contacts 49, a conductor 50, and an insulating material 51.” *Id.* at 18:62 – 19:4.



**FIG. 4C**

- “**Pressure generator element 52** may be configured to communicate a **pressure energy 32D** to the brain through nerves associated with skin 2. As shown in FIG. 4D, pressure generator element 52 may be an electroacoustic transducer that converts electricity from power source 66 into a sound wave recognizable by pressure receptors of skin 2, such as the Pacinian corpuscle. For example, pressure generator element 52 may include a cone 53, a voice coil 54, and a magnet 55.” *Id.* at 19:25-33.



**FIG. 4D**

C. Defects in the Petition's § 103 Grounds

1. Ground 2: Petitioner Fails to Establish that Claim 4 is Unpatentable as Obvious Over Lee in view of Barasch and Choi.

Petitioner fails to meet its burden to establish that claim 4 is obvious over Lee in view of Barasch and Choi. Claim 4 recites as follows:

4. The treatment device of claim 1, wherein the second energy generator element includes a reflecting groove circumferentially arranged about the axis, the reflecting groove defining a concave shape arranged to reflect energy generated from the second energy generator element towards the area of skin.

Ex. 1001 at 41:9-15 (emphasis added). The written description states that, “[a]s shown in FIG. 3B... [g]roove 44 may include a concave shape extending proximally into housing 33 to contain resistor 43, and the shape may include a distal surface configured to reflect heat energy 32B toward skin 2.” *Id.* at 18:48-55.

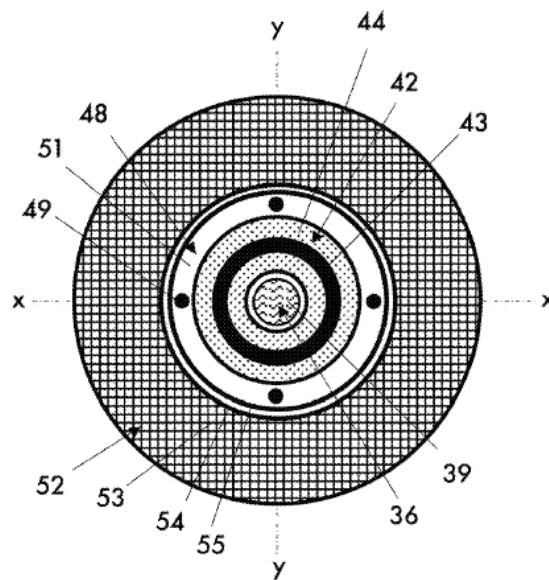
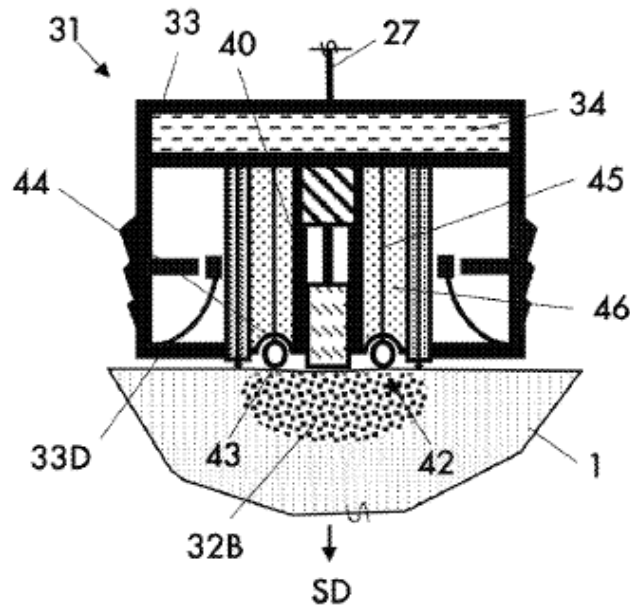


FIG. 3B

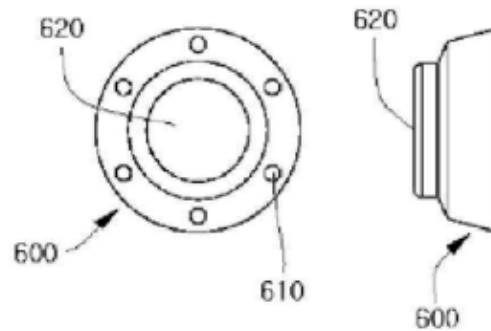
In addition, the written description states that “[a]s shown in FIG. 4B... heat generator element 42 may include an electrical resistor 43, a heat reflecting groove 44, a conductor 45, and an insulating material 46.” *Id.* at 18:35-41.



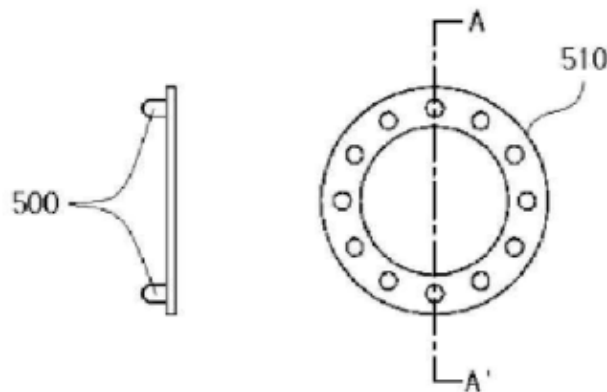
**FIG. 4B**

Neither Lee nor Barasch nor Choi disclose a “reflecting groove defining a concave shape arranged to reflect energy generated from the second energy generator element towards the area of skin.” Petitioner does not even argue that either Lee or Barasch disclose this element, and Petitioner misrepresents Choi’s disclosure. Choi discloses convex infrared LED lamps 500 that can be arranged on the circular panel 510 so that they can be fitted and coupled to the infrared lamp fixing part 610 on convex infrared housing 600. *See Ex. 1009 at ¶¶ 46-50 and FIGs. 5 and 6:*

**FIG. 5**



**FIG. 6**



Choi does not disclose a reflecting groove defining a concave shape to reflect energy towards the skin. Accordingly, Petitioner has failed to meet its burden to establish that claim 4 is obvious over Lee in view of Barasch and Choi.

**2. Ground 4: Petitioner Fails to Establish that Claim 4 is Unpatentable as Obvious Over Giraud in View of Choi.**

The Petition fails to meet its burden to establish that claim 4 is obvious over Giraud in view of Choi. Claim 4 recites as follows:



FIG. 5

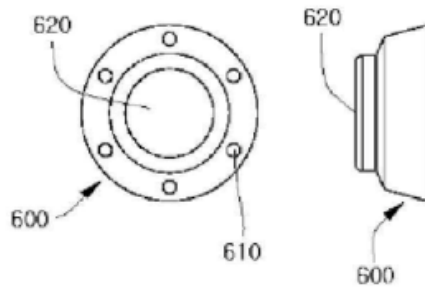
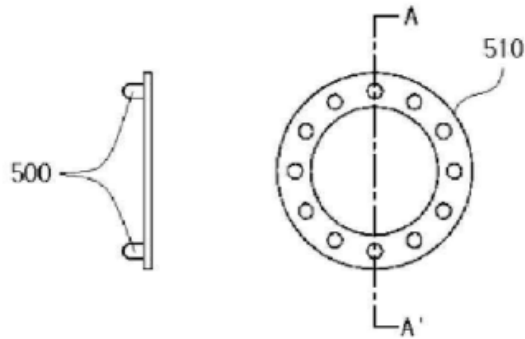


FIG. 6



But neither reference discloses a reflecting groove defining a concave shape to reflect energy towards the skin, and Petitioner does not even argue to the contrary. Accordingly, Petitioner has failed to meet its burden to establish that claim 4 is obvious over Giraud in view of Choi.

## VII. CONCLUSION

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

Dated: May 27, 2025

Respectfully submitted,

/James P. Murphy/

James P. Murphy (Reg. No. 55,474)

POLSINELLI PC

1000 Louisiana, Suite 6400

Houston, Texas 77002

## CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that this paper contains 3,862 words, excluding the portions exempted under 37 C.F.R. §42.24(a)(1), according to the word count feature of the word-processing system used to prepare this paper.

The undersigned further certifies that this paper complies with the typeface requirements of 37 C.F.R. §42.6(a)(2)(ii) and formatting requirements of 37 C.F.R. §42.6(a)(2)(iii). This paper has been prepared in 14-point, Times New Roman proportional font with normal spacing.

Dated: May 27, 2025

Respectfully,

/James P. Murphy/

James P. Murphy (Reg. No. 55,474)

POLSINELLI PC

1000 Louisiana, Suite 6400

Houston, Texas 77002

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Preliminary Response is being served on May 27, 2025, via email directed to the following email addresses of record:

Marc J. Pensabene  
[mpensabene@omm.com](mailto:mpensabene@omm.com)

Brett J. Williamson  
[bwilliamson@omm.com](mailto:bwilliamson@omm.com)

Bradley Berg  
[bmberg@omm.com](mailto:bmberg@omm.com)

Kristin Godfrey  
[kgodfrey@omm.com](mailto:kgodfrey@omm.com)

Respectfully,  
/Ericka McNeil/  
Ericka McNeil  
POLSINELLI PC  
1000 Louisiana Street, Suite 6400  
Houston, Texas 77002  
Tel: (713) 374-1600  
Fax: (713) 374-1601