

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
Patent No. 12,036,174

**PETITIONERS' OPPOSITION TO
PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

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Ex-1012	Chunpeng Jiang et al., <i>A Wearable Braille Recognition System Based on High Density Tactile Sensors</i> , 2020 IEEE 33rd Int’l Conf. on Micro Electro Mech. Sys. (MEMS) 28-31 (2020)
Ex-1013	<i>The Cadence Tablet</i> , Tactile Engineering, https://www.tactile-engineering.com/cadence (last visited Jan. 16, 2025)
Ex-1014	Devin Thorpe, <i>These 6 Women Undergrads at MIT Invented a Game-Changer for the Blind</i> , Forbes, https://www.forbes.com/sites/devinthorpe/2016/12/20/these-6-women-undergrads-at-mit-invented-a-game-changer-for-the-blind/ (Dec. 20, 2016)
Ex-1015	<i>O-Rejuv Facial Device</i> , O Cosmedics, https://www.ocosmedics.com/o-rejuv-facial-device.html (last visited Jan. 16, 2025)
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Ex-1019	<i>Finding a Percussion Massager for Effective Muscle Recovery</i> , Pulse Therapy Hub, https://pulsetherapyhub.com/the-difference-between-a-percussion-massager-and-a-vibration-massager (lasted visited Jan. 16, 2025)
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Ex-1023	<i>Vibrational Massagers vs. Percussive Massagers</i> , Fit Body Factory, https://thefitbodyfactory.com/blogs/news/vibrational-massagers-vs-percussive-massagers (lasted visited Jan. 16, 2025)
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Ex-1025	<i>How to Implement In-Sensor Vibration Monitoring with ISM330IS</i> , ST Community, https://community.st.com/t5/mems-and-sensors/how-to-implement-in-sensor-vibration-monitoring-with-ism330is/ta-p/572988 (lasted visited Jan. 16, 2025)
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Ex-1035	Plaintiff's First Amended Disclosure of Asserted Claims and Infringement Contentions (P.R. 3-1 & 3-2), <i>Hyper Ice, Inc. v. Therabody, Inc.</i> , No. 8:24-cv-02034-JWH-DFM (C.D. Cal. Feb. 27, 2025)
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Ex-1037	Docket Sheet, <i>Pavemetrics Systems, Inc. v. Tetra Tech</i> , No. 2:21-cv-01289-MCS-MAA (C.D. Cal.)
Ex-1038	Coke Morgan Stewart, Leadership 2025: Welcoming Remarks and Opening Keynote (Apr. 1, 2025)
Ex-1039	Defendant Therabody, Inc.'s Disclosure of Invalidity Contentions, <i>Hyper Ice, Inc. v. Therabody, Inc.</i> , No. 8:24-cv-2034-JWH-DFM (C.D. Cal. Mar. 7, 2025)

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Ex-1041	Minute Order, <i>DMF, Inc. v. AMP Plus, Inc.</i> , No. 2:18-cv-07090-CAS-GJSx (C.D. Cal. July 12, 2019), ECF No. 251
Ex-1042	Claim Construction Order, <i>Gene Pool Techs., Inc. v. Coastal Harvest, LLC</i> , No. 5:21-cv-01328-JWH-SHK (C.D. Cal. Oct. 23, 2022), ECF No. 87
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I. INTRODUCTION

Therabody respectfully submits this response in opposition to Patent Owner DataFeel Inc.'s Request for Discretionary Denial ("PO Request") under *Fintiv v. Apple*, requesting that the Director decline to institute post-grant review of U.S. Patent No. 12,036,174 ("the '174 Patent"). Patent Owner disclaimed 18 of 19 challenged claims in response to the Petition. The only remaining claim of the '174 Patent is unpatentable, as amply demonstrated in the Petition. There is no trial date. This PGR should be tried on the merits. Each pertinent *Fintiv* consideration favors referral to the merits panel; none justifies the discretionary denial that Patent Owner seeks.

II. THE *FINTIV* FACTORS FAVOR INSTITUTION

This PGR challenged 19 claims of the '174 patent (claims 1-19). Rather than respond substantively to Therabody's arguments, Patent Owner disclaimed all of the challenged claims *except one*—Claim 4—meaning that there is now a single claim at issue in both this PGR and the District Court Proceedings. EX-1033 (dismissal); Prelim. Resp. 1; Ex-2006. Contrary to Patent Owner's assertion that "[p]ermitting institution here would not promote efficiency or finality [and] would reward strategic forum manipulation," PO Request, 3, instituting the present petition would promote exactly the type of efficiency intended by AIA post-grant proceedings. Indeed, as reflected by the cancellation of nearly 95% of the claims at

issue, the PGR process has already resulted in significant efficiencies and is likely to result in even greater efficiencies if allowed to play out substantively—either by finding the remaining claim unpatentable or by estopping Petitioner from arguing invalidity under 35 U.S.C. §325(e)(2). As discussed below, proper consideration of the *Fintiv* factors weighs heavily in favor of instituting this PGR.

A. Factor 1: Likelihood of a Stay

Therabody intends to promptly seek a stay in the underlying litigation should the Board institute review. Therabody has not yet done so based on the standard practice in the Central District of California, where motions to stay are typically filed—and most often granted—after the PTAB’s institution decision, not before. *See, e.g.*, Minute Order, 1, *DMF, Inc. v. AMP Plus, Inc.*, No. 2:18-cv-07090-CAS-GJSx (C.D. Cal. Jul. 12, 2019), ECF No. 251 (Ex-1041) (denying a pre-institution motion to stay noting “The Court will not entertain any motions to stay the case until the PTAB has granted defendants’ IPR petition”); Minute Order, 2, *Fontem Ventures, B.V. v. NJOY, Inc.*, No. 2:14-cv-01645 (C.D. Cal. Sept. 24, 2014), ECF No. 32 (Ex-1040) (“While it has discretion to do so, absent the stipulation of the parties, the Court will not stay this action based on the mere filing of petitions for inter partes review. Instead, Defendants may renew the Motion when and if the United States Patent and Trademark Office grants the requested inter partes reviews.”). Therabody has already followed that practice in separate litigation

involving the same plaintiff¹ asserting a different family of patents in the same district court. There, Therabody moved for a stay of the case shortly after the first of its two PGR petitions was instituted. Ex-1034. That motion remains pending.

Thus, the mere fact that Therabody has not yet moved the District Court for a stay provides no basis to infer any “dual-track” strategy, as Patent Owner contends. If the PGR is instituted, Therabody will move for a stay and, as Patent Owner admits, such a request is likely to be granted. *See* PO Request 4 (“Judge Holcomb frequently grants stay motions pending PTAB proceedings.”).

Remarkably, it is Patent Owner that seeks a dual track strategy, indicating that “a stay ... should be denied.” PO Request 5. But even if Patent Owner opposes a stay in the district court, the statistics that Patent Owner itself submitted confirm that Judge Holcomb grants stays in 73% of stay motions pending PTAB proceedings. *See* PO Request 4; Ex-2003, p. 1. Nothing in the present record suggests this case will be treated any differently.

In considering requests for discretionary denial, the Director has often found similar situations as evidence of a high likelihood of a stay and denied the requests, in part, for that reason. *See, e.g., Twitch Interactive, Inc. v. Razdog Holdings LLC,*

¹ The Plaintiff in that separate litigation is Hyper Ice, Inc., which is an exclusive licensee of the '174 Patent and co-plaintiff in Patent Owner's lawsuit asserting the '174 Patent against Petitioner.

IPR2025-00307, -00308 *et al.*, Paper 18, 2 (P.T.A.B. May 16, 2025) (finding a high likelihood of a stay where judges granted stayed for instituted PTAB proceedings 76% of the time); *Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9, 2 (P.T.A.B. June 12, 2025).

Patent Owner's reliance in its Factor 1 analysis on Therabody's decision (as of this date) not to have filed a PGR or IPR against the newly-asserted '161 Patent is equally misplaced. Patent Owner and its co-plaintiff HyperIce did not amend their complaint to add the '161 Patent until March 12, 2025—more than eight months after filing a complaint for infringement of the '174 Patent and months after Petitioner filed this PGR. Thus, the so-called “staggered litigation strategy” (PO Request 2) is Patent Owner's doing, not Petitioners. The timing of Patent Owner's amendment, not any tactical delay by Therabody, explains why a petition has not yet been filed. Moreover, while the '161 Patent is part of the same family as the '174 Patent, its claims target a distinct aspect of the technology and Patent Owner asserts them against completely different Therabody products. *Compare* Ex-1035, 45, 56 (accusing Theraface Pro for claim 4 of the '174 Patent) *with* Ex-1035, 100-130 (accusing Therabody SmartGoggles of infringing asserted claims of the '161 Patent).

Given the likelihood of a stay, as admitted by Patent Owner, Factor 1 weighs heavily against discretionary denial.

B. Factor 2: The Trial Date Is Uncertain

Patent Owner concedes that Judge Holcomb has not yet set a trial date. As Patent Owner explains, per the Judge's usual practice a scheduling order setting a trial date does not issue until after the court enters its claim construction ruling, and those orders routinely appear a month or more after the *Markman* order and several months after the hearing itself. *See* PO Request 5 (citing Ex-2001, p. 2). Currently, that *Markman* hearing is scheduled for July 30, 2025.² Patent Owner's suggestion that the litigation is "moving faster than normal" is incorrect and rests on an apples-to-oranges comparison between the scheduled *Markman* date here and the actual *Markman* dates in other matters, PO Request 5-6. Moreover, it ignores that the Court often reschedules *Markman*. Indeed, in the parties' parallel '482-patent case, the *Markman* hearing originally set for January 7, 2025 did not occur until April 23, 2025 and the ruling has not issued. ECF Nos. 26, 33, 47, and 67. In this case the hearing has already moved once (albeit by a single day). ECF No. 61.

The fact that there is no trial date set at the time of a request for discretionary denial is often cited alone as a contributing factor in denying such request. *See, e.g., Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-

² Since Patent Owners Request, the Court has moved the *Markman* hearing from July 29 to July 30. Scheduling Notice, *Shenzhen Kelaisiman Trading Co. v. Hyper Ice, Inc.*, No. 8:24-cv-01472-JWH-DFM (C.D. Cal. June 20, 2025), ECF No. 61 (Ex-1046).

00307, -00308 *et al.*, Paper 18, 2 (P.T.A.B. May 16, 2025); *Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9 at 2 (P.T.A.B. June 12, 2025); *Merck Sharp & Dohme v. Halozyme, Inc.*, PGR2025-00006, -00009, Paper 29, 2 (P.T.A.B. June 12, 2025). But here, the evidence shows that even if a trial date is eventually set, it will be much later than Patent Owner estimates.

Patent Owner's reliance on another case before Judge Holcomb—*Gene Pool Technologies, Inc. v. Coastal Harvest, LLC*, No. 5:21-cv-01328 (C.D. Cal)—is misplaced. Patent Owner noted that court issued a claim construction ruling on October 23, 2022 (Ex-1042) and then issued a scheduling order one month later on November 23, 2022 (Ex-1043). *See* PO Request, 5. But Patent Owner fails to mention that the *Markman* hearing itself was held on May 19, 2022 (five months before the claim construction ruling issued), more than **17 months** before the October 23, 2023 trial date that was later set. *See* Ex-1043; Ex-1036 (docket report for *Gene Pool Tech.*). *See also*, *Pensmore Reinforcement Techs., LLC v. Cornerstone Manufacturing and Distribution Inc.*, No. 5:21-cv-01556 (C.D. Cal). (setting trial 14 after *Markman* (Exs-1044, 1045)).

Thus, Patent Owner’s estimate of a “mid-2026” trial date based on *Gene Pool Tech.* is simply incorrect. *See* PO Request 5.³ In fact, *Gene Pool Tech.* points to a much later trial date—over 17 months after the July 30, 2025 *Markman* hearing, thus likely in December 2026 or early 2027. Similarly, *Pensmore Reinforcement* suggests, at the earliest, a late-2026 trial date. And those estimates assume that the current schedule holds and the district court case is not stayed.

By contrast, if the Board institutes review in August 2025, a final written decision will issue no later than August 2026—at least 4-5 months before any likely trial. Taking an evidence-based view of Judge Holcomb’s docket, Factor 2 weighs against discretionary denial.

C. Factor 3: There Is Significant Work Remaining

While the parties have exchanged initial contentions and produced some documents, no depositions have been taken, expert discovery has not begun, and the court has not construed the claims. The bulk of fact discovery, expert discovery, dispositive motions, Daubert briefing, and pre-trial preparations all

³ Patent Owner’s discussion of *Pavemetrics Systems, Inc. v. Tetra Tech, Inc.*, Case No. 2:21-cv-01289-MCS-MAA (C.D. Cal) is also misplaced. *See* PO Request, 5. That case was not before Judge Holcomb. While it briefly was transferred to Judge Holcomb five days after the Complaint was filed (Ex-1037 (docket report)), Judge Holcomb recused himself one day later and the case was transferred to Judge Scarsi. Thus, the timing pointed to by Patent Owner is reflective of Judge Scarsi’s typical practice, not Judge Holcomb’s typical practice.

remain ahead. The district court thus stands far from any merits resolution, and the lion's share of work—both for the parties and the judiciary—remains to be done.

If Patent Owner seeks to avoid unnecessary work for itself and the district court in view of a parallel PGR, this is entirely within its control. Patent owners can and routinely do agree to stay the parallel district-court litigation post-institution proceedings by the Board and these joint or unopposed requests are invariably granted, including in the Central District of California.⁴ If a litigation

⁴ See, e.g., Order to Stay Litigation, *Biomedical Device Consultants Laboratories of Colorado, LLC v. Vivitro Labs, Inc.*, No. 2:23-cv-04291-HDV-E (C.D. Cal. April 11, 2024), ECF No. 101; Order Granting Joint Stipulation to Stay Case, *Genexa Inc. v. Kinderfarms LLC*, No. 2:23-cv-08378-MCS-SK (C.D. Cal. April 16, 2024), ECF No. 52; Order Granting Joint Stipulation to Stay Case, *Inneos, LLC v. Opticis Co. Ltd.*, No. 8:23-cv-00185-MCS-ADR (C.D. Cal. Feb. 9, 2024), ECF No. 100; Order Staying Case, *E-Vision Optics, LLC v. Luxottica Group S.p.A.*, No. 8:23-cv-02013 AB (SHKx) (C.D. Cal. Jan. 17, 2025), ECF No. 121; Order Granting Unopposed Motion to Stay, *Jonathan E. Jaffe v. Adobe, Inc.*, No. 2:23-cv-06224-JWH-MAA (C.D. Cal. Apr. 9, 2025), ECF No. 58; Order Granting Stipulation and Order for Stay, *Molecular Loop Biosciences, Inc. v. Illumina, Inc.*, No. 1:24-cv-00680-RGA-SRF (D. Del. Feb. 6, 2025), ECF 39; Order Granting Stipulation to Stay Case, *Orca Security Ltd. v. Wiz, Inc.*, No. 1:23-cv-00758-JLH-SRF (D. Del. Jan. 16, 2025), ECF No. 233; Order Granting Motion to Stay, *EyesMatch Ltd. v. Samsung Elecs. Am. Inc.*, No. 2:23-cv-00363-JRG-RSP (E.D. Tex. Dec. 19, 2024), ECF No. 60; Order Granting Motion to Stay, *Flip Phone Games Inc. v. PLR Worldwide Sales Ltd.*, No. 2:23-cv-00139-JRG (E.D. Tex. Dec. 10, 2024), ECF No. 138; Order Granting Joint Motion to Stay, *Athalonz LLC v. Under Armour, Inc.*, No. 2:23-cv-00193-JRG (E.D. Tex. Sept. 13, 2024), ECF No. 77; Order Granting Joint Motion to Stay, *Fendgo LLC v. Samsung Elecs. Co., Ltd.*, No. 2:23-cv-00221-JRG (E.D. Tex. June 14, 2024), ECF No. 55; Order Granting Stipulation Regarding Stay, *Datanet LLC v. Dropbox Inc.*, No. 3:24-cv-01972-AMO (N.D. Cal. May 15, 2024), ECF No. 149.

stay is still opposed by Patent Owner after institution, any inefficiencies should be weighed against Patent Owner for refusing to agree to stay the case, not Petitioners. Therefore, Factor 3 weighs against discretionary denial.

D. Factor 4: Overlap of Issues

Because a final written decision will almost certainly issue well before any trial, there is no need to file a *Sotera*-style stipulation in this proceeding. Rather, the broad PGR estoppel under 35 U.S.C. § 325(e)(2) will attach before trial and, at a minimum, Judge Holcomb will have ample opportunity to consider and benefit from the Board’s analysis on the few overlapping issues. As a result, any overlap is minimal and does not create inefficiency or risk of conflicting outcomes.

Even setting aside the likely attachment of estoppel, the actual overlap of issues between this PGR and the district court litigation is limited and does not warrant discretionary denial. While some invalidity arguments may proceed in parallel in both forums, as discussed with respect to Factor 1 above, it is likely that the District Court case will be stayed, at least as to the ’174 Patent, upon institution of the PGR. In that event, contrary to Patent Owner’s arguments, there would be no overlap between the proceedings. Although the ’174 Patent and ’161 Patent share a specification, their claims are directed to entirely different inventions. For example, the claims of the ’161 Patent never mention a “treatment device” nor do they require a “reflective groove” as required by the only claim of the ’174 Patent

that remains at issue here. Instead, the '161 Patent's claims are directed to a "wearable device" that is used to communicate information to the user through the skin. Despite Patent Owner's arguments here, Patent Owner is well aware of the differences between the patents. It has not accused any products of infringing both patents. *Compare* Ex-1035, 45, 56 (accusing Theraface Pro for claim 4 of the '174 Patent) *with* Ex-1035, 100-130 (accusing Therabody SmartGoggles of infringing asserted claims of the '161 Patent). And Therabody's invalidity contentions for the '161 Patent rely on entirely different prior art references than those asserted against the '174 Patent, and thus have no overlap with the references at issue in this PGR. Ex-1039, 10 ('174 Patent Charted References) 69 ('161 Patent Charted References).

Therefore, Factor 4 weighs against discretionary denial.

E. Factor 5: Identity of the Parties

The Petitioner and the district-court defendant are the same. The Patent Owner and its exclusive licensee are the plaintiffs in the district court. When the parties are the same, Factor 5 generally follows Factor 2, such that "this factor favors denial if trial precedes the Board's Final Written Decision and favors institution if the opposite is true." *Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021) (internal quotation marks omitted). *Tesla, Inc. v. Autonomous Devices LLC*, IPR202301054, Paper 20 at 14–

15 (PTAB Dec. 13, 2023) (“When the Board’s deadline for a Final Written Decision precedes the district court trial date and the parties are the same in both proceedings, Fintiv factor 5 typically weights against exercising discretion to deny institution”). As explained above, here the Final Written Decision will issue before any trial and thus Factor 5 weighs against discretionary denial.

F. Factor 6: The Petition’s Merits Are Strong And The Patent Was Only Recently Issued

Although Patent Owner elected to address only discretionary factors, the sixth *Fintiv* factor asks whether “other circumstances,” including the strength of the petition, counsel for or against institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 14-15 (March 20, 2020) (designated precedential May 5, 2020). Here, Petitioner brought its PGR challenge early in the life of the ’174 Patent, which favors denying Patent Owner’s request. Moreover, Patent Owner has already disclaimed every claim except one in response to the strength of the Petition’s grounds, and the Petition marshals multiple, well-supported grounds that challenged claim 4 is at least reasonably likely to be found unpatentable. The merits weigh heavily in favor of institution. Patent Owner’s contrary assertions rest on a mischaracterization of Petitioner’s position and a conspicuous lack of evidence.

1. The Petition Challenges The Patent Early In Its Life

The '174 Patent issued on July 16, 2024. Ex-1001, Cover. Petitioner brought this PGR on January 17, 2025—a mere six months later. The Director has frequently cited early challenges as a factor for denying requests for discretionary denial. *See, e.g., Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9, 2 (June 12, 2025) (Acting Director Stewart: “Early challenges to patents favor robust, predictable patent rights and weigh against discretionary denial.”); *Merck Sharp & Dohme v. Halozyme, Inc.*, PGR2025-00006, -00009, Paper 29, 2 (June 12, 2025) (same); Ex-1038, 7-8 (Acting Director Stewart noting that “PGRs ... can [] help improve the durability of patent rights”). In connection with the weight of the evidence described below, this early challenge weighs against discretionary denial.

2. The Disclaiming Of All But One Claim Demonstrates The Petition’s Strength

Patent Owner’s statutory disclaimer of claims 1-3 and 5-19—filed only after reviewing Petitioner’s detailed obviousness, enablement, and written-description challenges—speaks volumes as to the strength of Petitioner’s case. By disclaiming 18 of the 19 originally challenged claims, Patent Owner tacitly concedes that the prior-art combinations and § 112 grounds set forth in the Petition are, at a minimum, compelling. That concession is another circumstance under *Fintiv*. Factor 6 that weighs heavily against discretionary denial.

3. The Choi-Based Grounds Are Strong

Petitioner’s Ground 2 (Lee + Barasch + Choi) and Ground 4 (Giraud + Choi) each explain—step-by-step and with unrebutted expert testimony—why Choi discloses, and a POSITA would understand, the “reflecting groove circumferentially arranged about the axis ... defining a concave shape arranged to reflect energy ... toward the area of skin” required by claim 4. Ex-1002, ¶¶ 196-198, 228-231; Pet., 58-63, 66-78. Patent Owner’s Preliminary Response never seriously engages with those showings.

Patent Owner mischaracterizes Choi by focusing on the LED lamps, not the housing holding those lamps relied on by Petitioner. Patent Owner repeatedly argues that Choi teaches only “convex infrared LED lamps” and therefore cannot satisfy the “concave reflecting groove” limitation. Prelim. Resp. 19-22. That is a strawman: Petitioner never relies on the shape of the LED lamps, nor does the shape of the LED lamps have anything to do with whether there is a reflecting groove, as required by claim 4. Instead, the petition identifies the infra-red lamp housing 600—the annular structure that surrounds the slide shaft—as the claimed reflecting groove. Pet., 60-62; Ex-1009, ¶¶ 45-50, Fig. 5. That housing is expressly described as “tubular” and “configured in a circular shape corresponding to the inner surface shape of the main body,” ¶¶ 48-49, and it is the housing (not the

LEDs) that “guide[s] the infrared light ... to irradiate the skin,” *Id.*, ¶¶ 46, 48-49.

Patent Owner never addresses that disclosure.

Patent Owner baldly asserts—with a citation and no quotation—that Choi’s housing is “convex.” Prelim. Resp., 20-21 (citing Ex-1009, ¶¶46-50). Choi does not say that. Below is the entire text of Choi cited by Patent Owner for this contention:

The infrared lamp housing 600 holds the infrared LED lamp 500 and *is a means for directing infrared light generated by the infrared LED lamp 500 to irradiate the skin of a user.*

The infrared lamp housing 600 *is configured in a circular shape* corresponding to the inner surface shape of the main body 100, and is coupled from within the opening of the main body 100 so that the front end fits into the opening and is exposed to the outside.

The infrared lamp housing 600 is tubular in shape, comprising at least one or more infrared lamp fixing parts 610 spaced at regular intervals along a circular outer periphery to which the infrared LED lamp 500 is fitted and coupled, and a shaft pass-through hole 620 in the center for passing the slide shaft 321.

The infrared LED lamp 500 is a means for generating infrared light to provide an infrared heating function.

FIG. 6 is a drawing of an example infrared LED lamp 500, illustrating an infrared lamp fixture *formed in an infrared lamp housing 600*. The infrared LED lamp 500 may be configured in the form of infrared LED

lamps arranged on the circular panel 510 so that they can be fitted and coupled to the infrared lamp fixing part 610.

Ex-1009, ¶¶46-50 (emphasis added).

Choi's textual description corroborates the Petitioner's position, not Patent Owner's. Figures 5 and 6, and the description above, depict a hollow, cylindrical structure surrounding the central shaft; its interior surface is recessed relative to the outer periphery, *i.e.*, **concave**. Ex-1009, Figs. 5-6 (annotated in Pet., 62). The text also describes the housing as "tubular" and explains that the LED lamp fixtures are "formed *in*" the housing. Ex-1009, ¶¶46-50 (emphasis added). Further, its purpose is "directing" the light towards the skin of the user. Dr. Jensen explained that these disclosures would lead a POSITA to understand the housing is concave because its purpose is to reflect and channel infrared energy toward the skin, a function conventionally achieved with a concave surface. Ex-1002, ¶ 197.

Choi provides ***no support*** for concluding that the housing is convex. And Patent Owner offers no expert declaration, technical literature, or even attorney argument addressing that point. The Board therefore should credit Dr. Jensen's analysis.

4. The Written Description Ground Is Strong

Patent Owner's attempt to recast the written description record cannot overcome the fundamental defect identified in the Petition: The '174 Patent's

specification nowhere describes, even generically, a *treatment device* that employs the claimed “plurality of energy generator elements” to deliver therapeutic energy to the user’s skin. Because the sole remaining claim hinges on that very concept, the merits of this ground also favor institution.

Ariad and its progeny require more than generic boilerplate; the specification must “reasonably convey” possession of the *claimed* invention. *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). Indeed, a written description that merely provides “formal textual support” for the claim limitations, but fails to describe the claimed “actual functioning” of those limitations, does not satisfy § 112. *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013).

The ’174 Patent’s specification is explicit that the invention “generally relate[s] to *communication devices*, methods, and systems.” ’174 Pat., 1:28-30 (emphasis added). Every detailed embodiment—including Figs. 1A/1B, 2A-2C, 4A-4D, and 8A—describes devices whose entire purpose is to *communicate* non-visual signals through the skin that are then interpreted by the user’s nervous system. None of those embodiments is presented, even in passing, as delivering medical or cosmetic *treatment*. There is no discussion or disclosure of any therapeutic dosages, durations, or clinical endpoints. No disclosure of pathologies or cosmetic conditions that would purportedly be treated. And no guidance as to

how a device for “treatment” might differ from one the devices disclosed for “communication.”

Likewise, claim 4’s “reflecting groove” is never linked to treatment, and only described as part of “heat generator element 42” that is “configured to communicate a heat energy 32B to the brain through nerves associated with skin 2.” Prelim. Resp. 8-10; Ex-1001, 18:33-41. That is communication, not treatment. Nothing in that passage—or anywhere else in the specification—teaches or suggests the groove is provided to administer therapy, much less treatment.

Patent Owner’s attorney argument cannot bridge this gap between the disclosed “communication” devices and the claimed “treatment” device. Surprisingly, Patent Owner attempts to do so by quoting numerous passages that are all about “communication.” *See* Prelim. Resp., 9-10. The scattered excerpts merely confirm that the inventors possessed, at most, communication strategies involving impact, heat, electrical, and pressure signals. They do not evidence possession of using those same energies therapeutically.

Patent Owner’s argument that the preamble is non-limiting, and thus does not require any written description support, also fails. *See* Prelim. Resp. 8. That argument concedes Petitioner’s point: if “treatment device” has no limiting effect, then nothing in the body of claim 4 is tethered to the specification’s communication-centric disclosure. Conversely, if “treatment device” is limiting,

then the absence of any treatment-based embodiment or other written description dooms claim 4. Either way, the written description defect stands. Moreover, Patent Owner's argument rests on the mistaken assumption that the preamble must be limiting in order for the Petitioner's written description argument to succeed. In reality, Petitioner's argument does not depend on whether the preamble is limiting. Rather, the focus is on the patent's failure to provide written description report for the "actual functioning" of the energy generator limitations that is claimed. *Novozymes*, 723 F.3d at 1349. A POSITA would have understood—even in the context of a non-limiting preamble—that the '174 Patent claims subject matter directed to treatment functionality. Thus, the lack of written description support for using energy generators for treatment remains fatal.

Petitioner's early filing of this PGR petition, Patent Owner's disclaimer of 18 of 19 challenged claims in response to the Petition, and the compelling strength of the challenges to the sole remaining claim are all additional circumstances that strongly favor denying Patent Owner's request for discretionary denial.

III. CONCLUSION

When weighed collectively, the *Fintiv* factors point decisively toward institution. Therabody intends to move promptly for a stay if review is instituted; no trial date has been set and a realistic schedule places any trial well after the Board's final decision; the parties have not yet invested heavily in merits

discovery; Therabody's early filing of this Petition and the early stages of the district court litigation eliminates risk of overlap; and the Petition presents strong unpatentability grounds. Denying institution would neither promote efficiency nor conserve judicial resources; it would instead risk inconsistent outcomes and deprive the parties, the public, and the Office of a timely, expert determination of the '174 patent's validity.⁵

Dated: June 27, 2025

Respectfully submitted,

/s/ Marc J. Pensabene

⁵ Petitioners reserve the right to challenge the March 26, 2025 Interim Process for PTAB Workload Management at least because it is legally invalid as (1) exceeding the Director's authority, (2) arbitrary and capricious, (3) adopted without notice-and-comment rulemaking, and (4) should not apply retroactively to petitions filed before it was issued. *See* Petition for Writ of Mandamus, *In re Motorola Solutions, Inc.*, No. 25-134 (Fed. Cir. June 23, 2025).

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** contains 4,415 words excluding; a table of contents, a table of authorities, Mandatory Notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing. Petitioners have relied on the word count feature of the word processing system used to create this paper in making this certification.

CERTIFICATE OF SERVICE

I hereby certify that on June 27, 2025, I caused a true and correct copy of the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** to be served electronically on counsel for Patent Owner at the following addresses:

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