

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EIS GMBH,  
Petitioner,

v.

NOVOLUTO GMBH,  
Patent Owner.

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Case IPR2020-00007  
Patent 9,849,061 B2

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Before SUSAN L. C. MITCHELL, SCOTT C. MOORE, and  
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining Challenged Claims Not Unpatentable

*35 U.S.C. § 318(a)*

Granting Patent Owner's Motion to Seal and for Entry of a Protective Order

*37 C.F.R. §§ 42.14, 42.54*

Granting Patent Owner's Unopposed Motion to  
Submit Supplemental Information

*37 C.F.R. § 42.123(b)*

Denying Petitioner's Motion to Exclude

*37 C.F.R. § 42.64*

## I. INTRODUCTION

### A. Background and Summary

On October 2, 2019, EIS GmbH (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–3, 5, 7, 8, 11, 14, 15, 17–19, and 20–26 (the “challenged claims”) of U.S. Patent No. 9,849,061 B2 (Ex. 1001, “the ’061 patent”). See 35 U.S.C. §§ 311–319. On January 8, 2020, Novoluto GmbH (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”). On April 6, 2020, we denied institution of an *inter partes* review. See Paper 8, 2, 30 (“Dec.”).

Petitioner filed a Request for Rehearing of the Decision Denying Institution of *Inter Partes* Review of the challenged claims of the ’061 patent. Paper 9, “Req. Reh’g.”<sup>1</sup> Upon reconsideration of the arguments and evidence of record at the time, we found that at least a fact question exists concerning whether Taylor or Hovland teaches or suggests positive and negative pressures with respect to a reference pressure, an issue of fact that we resolved in favor of Petitioner at institution, and instituted *inter partes* review on all grounds presented in the Petition. Paper 15, 16–20 (“Reh’g Dec.” or “Rehearing Decision”); see 37 C.F.R. § 42.108(c) (2020).<sup>2</sup> We also

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<sup>1</sup> Petitioner also sought review of the Decision by the Precedential Opinion Panel. Ex. 3001. That request was denied on June 16, 2020. Paper 11. Following denial by the Precedential Opinion Panel, on June 25, 2020, Petitioner brought an action in the United States District Court for the Eastern District of Virginia seeking review of denial by the Precedential Opinion Panel under the Administrative Procedure Act. Paper 12, 1–2. The district court action was dismissed following our granting Petitioner’s Request for Rehearing. Paper 19, 4–5; Paper 21, 2.

<sup>2</sup> This Rule has since been amended to delete the requirement that an issue of fact created by testimonial evidence at the institution stage be viewed in

IPR2020-00007  
Patent 9,849,061 B2

vacated the portion of our previous Decision on Institution regarding construction of “reference pressure” and invited further briefing by the parties. *Id.* at 20–21.

Patent Owner filed a Response on December 18, 2020. Papers 23, 24 (“Resp.”). Petitioner filed a Reply on March 12, 2021. Paper 25 (“Reply”). Patent Owner filed its Sur-Reply on April 23, 2021. Paper 35 (“Sur-Reply”). On May 14, 2021, the parties jointly informed the Board that no oral hearing was necessary in this case. Paper 37.

This is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims on which we instituted trial. Based on the complete record before us, we determine that Petitioner has not shown, by a preponderance of the evidence, that claims 1–3, 5, 7, 8, 11, 14, 15, 17–19, and 20–26 are unpatentable. In addition, for the reasons set forth below, we grant Patent Owner’s Combined Motion to Seal and Motion for a Protective Order, and we deny Petitioner’s Motion to Exclude Evidence. *See* Papers 25, 38.

#### *B. Real Parties in Interest*

Petitioner identifies EIS GmbH, EIS Inc., Triple A Import GmbH, Triple A Marketing GmbH, Triple A Sales GmbH, Triple A Finance GmbH & Co. KG, and Triple A Internetsshops GmbH (formerly known as “Internetsupport Bielefeld”), as the real parties in interest. Pet. 1; Paper 7, 1; Paper 12, 1; Paper 21, 1; Paper 31, 1. Patent Owner identifies itself as the owner of the ’061 patent and WOW Tech International GmbH, Patent

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the light most favorable to the petitioner. *See* 85 Fed. Reg. 79,120, 79,122, 79,129 (Dec. 9, 2020).

IPR2020-00007  
Patent 9,849,061 B2

Owner's corporate parent, which later changed to IntiHealth Ger GmbH, as the real parties in interest. Paper 4, 2; Paper 13, 2; Paper 14, 2; Paper 19, 2; Paper 27, 2; Paper 33, 2 (identifying IntiHealth Ger GmbH as the corporate parent); Paper 36, 2 (same).

### *C. Related Proceedings*

The parties identify two ongoing court proceedings involving the '061 patent: *EIS, Inc. v. IntiHealth Ger GmbH*, No. 19-1227 (LPS) (D. Del.) and *Novoluto, GmbH v. Uccellini LLC d/b/a Lora DiCarlo*, C.A. No. DOR-6-20-cv-02284-MTK (D. Ore.). Pet. 1; Paper 4, 3; Paper 36, 2–3. The parties also identify U.S. Patent No. 9,937,097 (“the '097 patent”) that issued from a continuation application of the '061 patent, which has been challenged in IPR2019-01302. Pet. 1; Paper 4, 3. An *inter partes* review in IPR2019-01302 has been conducted, and all claims were found not unpatentable. *See EIS GmbH v. Novoluto GmbH*, IPR2019-01302, Paper 50, 73 (PTAB June 14, 2021).

The parties also identify U.S. Patent No. 9,763,851 B2 (“the '851 patent”) that they assert discloses related subject matter that has been challenged by Petitioner in IPR2019-01444. *See* Pet. 2; Paper 4, 3. An *inter partes* review in IPR2019-01444 has been conducted, and all claims were found not unpatentable. *See EIS GmbH v. Novoluto, GmbH*, IPR2019-01444, Paper 45, 52 (PTAB Aug. 5, 2021).

Patent Owner also identifies several patent applications pending before the Office that are related to either the '097 or '851 patents. Paper 4, 2–4.

*D. The '061 Patent*

The '061 patent, titled “Stimulation Device Having an Appendage,” generally relates to a device having a pressure field generating arrangement with a first chamber connected to a second chamber with an opening for placing on a body part, and a drive unit that varies the volume of the first chamber such that a pressure field that serves for stimulation is generated in the second chamber. Ex. 1001, Abst. The pressure field generating arrangement is more specifically described as follows.

This embodiment according to the invention, of chambers in fluidic communication via at least one connection element, allows simple generation of a pressure field in the second chamber by changing the volume in the first chamber, this pressure field being temporarily directed at the area of skin to be stimulated.

A pressure field, in the context of the invention, is a field of medium pressures that is variable over time and has temporary positive pressures and temporary negative pressures, a negative pressure being a pressure of medium that is below the reference pressure and a positive pressure being a pressure of medium that is above the reference pressure. As a result, the medium flows back and forth in the pressure field according to the invention. Thus, preferably a (largely) intermittent exchange of said medium can occur.

*Id.* at 3:11–25.

The described reference pressure “is usually the atmospheric pressure acting on the stimulation device that prevails when application begins (i.e. prior to placing the stimulation device on the area of skin to be stimulated).” *Id.* at 3:38–41. In the preferred embodiment that uses air as the medium, the reference pressure “is the currently prevailing air pressure or normal pressure.” *Id.* at 3:41–43.

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