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'S BRIEF ON DISCRETIONARY DENIAL

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Amended Complaint for Patent Infringement, *Therabody, Inc. v. Hyper Ice, Inc.*, 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, *Hyper Ice, Inc. v. Therabody, Inc.*, 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, *Therabody, Inc. v. Hyper Ice, Inc.*, Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), May 8, 2026
2006	Defendant Hyper Ice, Inc.'s Invalidity Contentions, *Therabody, Inc. v. Hyper Ice, Inc.*, Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), July 6, 2026
2007	First Amended Complaint for Patent Infringement, *Hyper Ice, Inc. v. Therabody, Inc.*, Case No. 8:24-cv-00390-JWH-DFM (C.D. Cal.), September 12, 2024
2008	First Amended Complaint, *Therabody, Inc. v. Hyper Ice, Inc.*, 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, *Therabody, Inc. v. Hyper Ice, Inc.*, Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), May 22, 2026

Exhibit No.	Description
2012	Second Amended Complaint for Patent Infringement, *Hyper Ice, Inc. v. Therabody, Inc.*, 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

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Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,
IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) 7, 8, 9, 12

Advanced Micro Devices, Inc. v. XtreamEdge, Inc.,
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IPR2026-00190, Paper 13 (P.T.A.B. May 15, 2026) 10

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I. INTRODUCTION

The Director should deny institution of post-grant review of U.S. Patent No. 12,396,919 ("the '919 patent") because institution would not serve the interests of the Office or the patent system.

First, the Petition should be denied under § 325(d). The Office already considered *all* prior art presented in Petitioner Hyper Ice Inc.'s ("Hyperice" or "Petitioner") challenges during the extensive prosecution of the '919 patent. Patent Owner overcame rejections based on some of this same prior art, and there was no material error in the Office's determination that the claims are patentable.

Second, the *Fintiv* factors favor denial. Petitioner and Patent Owner are already engaged in three separate ongoing patent infringement actions in the Central District of California. All three cases are overseen by the same judge and involve the same competing percussive massage device technology. Meanwhile, Petitioner waited until the last possible day to file this parallel PGR challenge to the '919 patent. By the time of the institution decision, the parties and the district court will have made substantial investment in adjudicating '919 patent, including conducting a Markman hearing. Petitioner's belated stipulation should not be considered and does little to mitigate concerns of inefficiency.

Third, Petitioner explicitly preserves the ability to advance inconsistent claim construction positions in the PGR that conflict with its positions in the

district court. This tactic diminishes the integrity of the patent system and promotes gamesmanship.

II. BACKGROUND

A. Patent Owner's Development of the Patented Technology

The '919 patented technology stems from Patent Owner Therabody Inc.'s ("Therabody" or "Patent Owner") pioneering work in percussive therapy devices. Therabody's founder, Dr. Jason Wersland, developed the technology after a traumatic motorcycle accident in 2007 left him searching for a solution to alleviate debilitating soft-tissue pain. Finding no adequate option on the market, Dr. Wersland—a trained chiropractor—began experimenting with vibration-based treatment and developed an early experimental device using a jigsaw as a base motor. EX2001, ¶¶8–9.

After numerous prototypes and years of experimentation, Dr. Wersland discovered that particular depths and speeds of percussion were effective at easing muscle pain. In 2016, Therabody commercialized its innovation with the launch of the Theragun G1. Therabody's percussive therapy devices soon gained widespread adoption and were being used by more than 250 sports teams, as well as physical therapists, trainers, and consumers worldwide. EX2001, ¶9. Today, Therabody is a leading wellness technology company, with nearly 600 utility and design patents in the United States and worldwide. EX2001, ¶10. The '919 patent reflects

Therabody's continuing innovation in percussive therapy systems.

B. Petitioner and Patent Owner's Multiple Ongoing District Court Litigations in the Central District of California

Petitioner Hyperice competes directly with Patent Owner in the percussive therapy market. Petitioner released the first generation of its "Hypervolt" line of percussive massage devices in 2018, two years after Patent Owner released its first generation of the Theragun.

Since January 2024, Petitioner and Patent Owner have been engaged in multiple active litigations before Judge John W. Holcomb in the Central District of California. The actions involve their competing percussive massage device products. In 2024 and 2025, Petitioner filed a patent infringement suit asserting two patents against Patent Owner's Theragun line, and a separate set of patent infringement suits filed jointly with DataFeel, Inc. (the owner of patents licensed exclusively by Petitioner). *See* EX2001; EX2003, ¶10; EX2007; EX2012. Also in 2024, Patent Owner filed a Lanham Act suit based on Petitioner's false statements claiming it was first to market in the percussive massage device category. *See* EX2008. Those cases remain ongoing.

On December 10, 2025, Patent Owner notified Petitioner that its Hypervolt Go 2 product infringes the '919 patent and provided a detailed claim chart comparing claim 1 of the '919 patent to the infringing product. EX2002. Despite receiving notice, Petitioner continued selling its infringing product without a

license. On January 2, 2026, Patent Owner filed suit in the Central District of California to protect and enforce its rights to the ’919 patented technology. That parallel case is also before Judge Holcomb.

Rather than ceasing sales of its infringing Hypervolt Go 2 product or attempting to design around Patent Owner’s patented technology, Petitioner doubled down on its infringing activity. On or about March 10, 2026, Petitioner developed and released its new Hypervolt 3 line of products (Hypervolt 3, Hypervolt Go 3, and Hypervolt 3 Pro), with full knowledge and awareness that these products likewise infringe the ’919 patent. EX2011, 5. Thus, far from modifying its products to avoid the patented technology, Petitioner continued and expanded its infringing product portfolio despite the active district court litigation.

Given Petitioner and Patent Owner’s long and ongoing history of disputes in the same District Court, this is precisely the type of direct competitor dispute that should proceed in district court and not before the PTAB. As the Director has recognized, “courts are, and always have been, the primary forum for adjudicating private disputes,” while AIA review serves broader interests of the Office, the patent system, and the public. *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 6–7 (P.T.A.B. May 14, 2026) (precedential) (Squires, Director). Here, the district court will resolve infringement, damages, injunctive relief, and any invalidity issues that Petitioner pursues. Meanwhile, Petitioner waited until the

last possible day to file a PGR petition in this forum. The parties' dispute is already before the forum best positioned to resolve it, and there is no broader public-interest concern presented here that warrants institution of a parallel PGR.

III. OVERVIEW OF THE '919 PATENT AND ITS COMPREHENSIVE EXAMINATION

The '919 patent is entitled "Percussive Therapy Device with Electrically Connected Attachment." It was filed as U.S. Patent Application No. 18/809,073 on August 19, 2024, and claims priority, through a series of applications, to a provisional application filed December 26, 2018. EX1001, (60), (63). It discloses an improved percussive therapy device.

The Office conducted a thorough examination of the '919 patent and considered *all* the references used in Petitioner's PGR challenges. Hu '965 (EX1022); Hu '951 (EX1036); Marton (EX1043); Pepe (EX1025); and Huang (EX1035) were all cited on an IDS and considered explicitly by the Examiner on November 7, 2024. EX1003, 619, 626, 628, 630. And for the Hypervolt product prior art that Petitioner relies on in Ground 6, Petitioner acknowledges that the Examiner also considered "a detailed YouTube video showing Hypervolt's inner workings." Pet., 1; EX1003, 645 (IDS citing the identical YouTube link as the link associated with EX1005 (Pet., vi)); *see also* EX1005 (the YouTube video).

The Examiner did not just consider these references, but applied two of them in prior art rejections, which Patent Owner ultimately overcame. The Examiner's

first office action (issued on November 7, 2024) rejected claims as anticipated by Hu ’951, which Petitioner now relies upon in *all* of its Petition’s prior-art based challenges. EX1003, 590–595; Pet., 6. In the same office action, the Examiner rejected claims as obvious over, in part, U.S. Patent Application Publication No. 2019/0254922 A1 to Marton (“Marton ’922”). EX1003, 598–599, 627. Marton ’922 contains the same subject matter Petitioner relies on the Marton reference for in the Petition’s obviousness challenges. Both references share the same inventors, both are assigned to Petitioner, and both share nearly identical disclosure. *Compare* EX1043, FIGS. 1–24 and 7:7–25:16 *with* EX2009, FIGS. 1–24 and ¶¶[0037]–[0115].

Patent Owner overcame these rejections through a significant use of the Office’s and the Patent Owner’s resources. Patent Owner conducted an Examiner interview and submitted an amendment and remarks on February 4, 2025. EX1003, 560–574. Those amendments and remarks overcame the rejection based on Hu ’951, but the Examiner then issued a final office action on February 14, 2025 that maintained the rejection based on Marton ’922. EX1003, 307–326. After further amendments/remarks by Patent Owner (EX1003, 287–300), a second Examiner interview (EX1003, 302–303), and submission of a terminal disclaimer (EX1003, 280–282), the Examiner determined the claims were allowable over all of the considered prior art, including Marton ’922. EX1003, 33–37.

There was no material error in the Examiner's correct conclusion that the claims of the '919 patent are patentable over *all* the references used in Petitioner's PGR challenges.

IV. THE PETITION WARRANTS DISCRETIONARY DENIAL FOR MULTIPLE REASONS.

The Director should exercise discretion to deny institution under 35 U.S.C. § 325(d). The Petition also warrants denial under 35 U.S.C. § 324(a) for multiple independent reasons.

A. Institution should be denied under 35 U.S.C. § 325(d) because all of the same art was previously considered by the Office.

This PGR should be denied because the Office has already thoroughly considered all prior art used in Petitioner's challenges during prosecution of the '919 patent. *See* Section III. Under the two-part framework used by the Board to decide whether to deny institution under 35 U.S.C. § 325(d), both parts are met. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7–8 (P.T.A.B. Feb. 13, 2020) (precedential) ("*Advanced Bionics*"). It is not an efficient use of the Board's resources to reconsider patentability based on the same art previously before the Office. Thus, this PGR warrants denial under 325(d).

Under part one of the *Advanced Bionics* framework, the Petition presents the "same or substantially the same art previously … presented to the Office."

Advanced Bionics at 8. Petitioner alleges: (1) claims 1–20 are unpatentable under § 112(a) for lack of written description; (2) claims 1–6, 9–11, and 14–20 are obvious over Hu ’965 and Hu ’951; (3) claims 7, 8, 12, and 13 are obvious over Hu ’965, Hu ’951, and Marton; (4) claims 1–6, 9–11, and 14–20 are obvious over Pepe, Hu ’951, and Huang; (5) claims 7, 8, 12, and 13 are obvious over Pepe, Hu ’951, Huang, and Marton; and (6) claims 1, 3, 4, and 7–11 are obvious over the Hypervolt product and Hu ’951. Pet., 6.

Every one of the references used in Petition’s challenges was considered previously by the Office during prosecution of the ’919 patent. *See* Section III, *infra*. Moreover, much of Petitioner’s relied-upon prior art was applied and distinguished during prosecution:

Hu ’951 was applied by the Examiner in a rejection and overcome, and all six references were cited in an IDS. *See* Section III.

Marton ’922 was cited in an IDS by Patent Owner, applied in a rejection by the Examiner, and overcome. *See id.* Notably, Marton ’922 contains the *same disclosure* as the cited portions of Marton relied upon by Petitioner in its challenges. *Compare* EX1043, 7:42–8:24, 9:33–10:37, 10:63–11:3, 23:4–38, 23:53–24:4, 24:19–23, FIGS. 2–4B *with* EX2009, ¶¶42–43, 49–53, 56, 111, 113–114, FIGS. 2–4B.

Pepe has already been considered and applied repeatedly by the same Examiner that granted the '919 patent during the prosecution of multiple parent applications. EX2016, pp. 11, 25; EX2017, pp. 6, 8, 10, 12–16, 18; EX2015, pp. 4, 8–13, 16; EX2014, pp. 2, 7–12, 17; EX2013, pp. 7, 9–13, 15, 18.

The Examiner also carefully considered the § 112(a) written description requirement, as required, and as evidenced by the issuance of a written description rejection that Patent Owner overcame. EX1003, 586–590.

Therefore, part one of *Advanced Bionics* is clearly met.

Under part two of the framework, Petitioner has not, and cannot, demonstrate "that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics* at 8. Tellingly, Petitioner fails to even acknowledge in its Petition that all the relied-upon references were previously presented to the Office, much less identify any concrete error that provides reason for the Office to revisit its patentability determination. To be sure, Petitioner cannot credibly argue error when the Examiner applied, and thus clearly considered, much of the same, or surrounding, disclosure from Hu '951 and Marton used in the PGR challenges. *See, e.g.*, EX1003, 590–595 (citing Hu '951, FIGS. 1–9, ¶10, 28, 30, 42–43), 599 (citing Marton '922, ¶¶43, 114, FIGS. 3, 4A); Pet., 65–66, 82 (citing, *e.g.*, EX1036 (Hu '951), ¶¶28–29, 34, 38, 45, FIGS 3, 5, 6),

84–85, 115–116 (citing, *e.g.*, EX1043 (Marton), 9:57–10:37, 23:53–24:4, 24:19–23, FIG. 3) (disclosure identical to Marton '922 as described above).

Nor can Petitioner credibly argue that the references in an IDS were not considered. The prosecution record demonstrates that the Examiner carefully reviewed the cited art and then identified and applied some of those references (Hu '951 and Marton '922) in a rejection. Notably, those references are the same, or substantially the same, as references on which Petitioner now relies upon in its challenges. That the Examiner selected the very references underlying Petitioner's challenges confirms that the Examiner understood and considered the substance of the disclosed prior art.

Moreover, the '919 patent is part of a large family of related U.S. and international patents, making the disclosure of prior art both expected and appropriate. Patent Owner's IDS was therefore "not tantamount to a voluminous IDS that may have impaired the examiner's ability to consider the listed references," but instead reflected "applicant's good faith effort to meet its duty of disclosure." *Microsoft Corp. v. Sandpiper CDN, LLC*, IPR2026-00190, Paper 13 at 3–4 (P.T.A.B. May 15, 2026) (Squires, Director). Unlike the circumstances at issue in *Ecto World LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 (P.T.A.B. May 19, 2025) (precedential), Patent Owner did not inundate the Examiner with references in a manner that impaired meaningful review. On the

contrary, the Examiner identified and applied the same prior art that forms the basis of Petitioner's challenges, confirming that the art was considered during prosecution.

To the extent Petitioner attempts to argue material error based on a different Examiner's pending rejections in a continuation application currently in prosecution (*see* Pet., 13–16), such arguments cannot support a finding of material error. Prosecution of the '322 continuation application is ongoing, Patent Owner disputes the rejections, and the Office has not made a final determination of patentability. Moreover, the claims of the '322 continuation application differ from the claims of the '919 patent (EX2010), such that the Petition does not even assert the prior art reference applied in the current rejection of the '322 application.

More fundamentally, the Examiner of the pending continuation is applying materially different standard of claim construction. Claims are given "their broadest reasonable interpretation consistent with the specification" during prosecution, *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), while in a PGR, claims "shall be 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).

Petitioner's challenges reflect, at most, disagreement with the Examiner's reasonable, and correct, decision to allow the '919 patent claims. That is not reason

to revisit the Office's determination. *See Advanced Bionics* at 9 ("If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability."). The Director should reject Petitioner's improper attempt to challenge the '919 patent over the same art previously considered by the Office and deny institution under § 325(d).

B. The *Fintiv* factors weigh in favor of denial.

The *Fintiv* factors favor discretionary denial of institution. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) ("*Fintiv*") (identifying six non-exclusive factors relevant to whether institution would be an efficient use of Board resources where there is parallel litigation).

1. Factor 1 favors denial because there is no stay.

Factor 1 favors denial because there is no stay of the parallel district court litigation, Petitioner has not sought to obtain a stay, and there is no evidence that a stay would be granted.

2. Factor 2 favors denial, or is at worst neutral, because the district court trial date will likely occur at the same time as the projected Final Written Decision.

Factor 2 favors denial. Patent Owner filed the parallel district court action on January 2, 2026, but Petitioner waited until the last possible day (nine months to the day after the '919 patent granted) to file a PGR Petition. As a result, the

projected statutory deadline for a Final Written Decision (FWD) in this PGR is not until November 29, 2027.

Although no trial date has yet been set in district court, the median time to trial for the Central District of California is 25.5 months (EX2004, 68), which would place trial approximately in mid-February 2028 (when measured from the service date of the district court complaint, January 12, 2026), which is less than three months after the FWD deadline.

However, the record indicates that the parallel district court proceeding is moving more rapidly than the district's median time to trial. The district court judge has already scheduled the claim construction hearing for November 18, 2026—before the projected institution decision date—and has stated he will issue a trial schedule after claim construction is complete. EX2005, 2. Thus, it is likely that trial will occur sooner than the median time, placing it at the same time, or even earlier than the FWD.

Factor 2, therefore, favors denial, or is at worst neutral.

3. Factor 3 favors denial because there has been significant investment in the district court.

Factor 3 favors denial. The relevant consideration is the "amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*" *Fintiv* at 9 (emphasis added). Here, the deadline for issuing a Decision on Institution (DI) in this PGR is November 30, 2026. By

this date, significant work will have been done by both the parties and the district court in the parallel litigation, including the exchange of infringement and invalidity contentions (May 22, 2026 and July 6, 2026, respectively), exchange of claim construction positions (August 31, 2026), and completion of claim construction briefing (November 6, 2026). Importantly, the Markman hearing will also occur prior to the projected institution date (on November 18, 2026). The parties will also have engaged in significant document production. Thus, at the time of institution, the parties and court will have invested substantial effort in the district court proceeding.

That effort is on top of the district court's and parties' investment in three other cases, including two patent actions and a False Advertising action, also involving Petitioner's and Patent Owner's percussive massage devices and patents. *See* EX2001; EX2003, ¶10; EX2007; EX2008; EX2012; Section II.B, *infra*. The district court will continue to invest resources in multiple aspects of Patent Owner and Petitioner's disputes through the time for institution of the present Petition.

Accordingly, Factor 3 strongly favors denial.

4. Factor 4 favors denial because the PGR issues overlap with district court and Patent Owner's late stipulation, which does little to reduce duplicative effort, should not be considered.

Factor 4 considers the overlap between the issues raised in the PGR petition and in the parallel proceeding to evaluate "concerns of inefficiency and the

possibility of conflicting decisions." *Fintiv* at 12. This factor also strongly favors denial.

In the parallel district court proceeding, Petitioner submitted invalidity contentions that completely overlap with its PGR challenges. *Compare* EX2006, 17–38, 40–41 (asserting that the claims are obvious over references including Hu '965, Hu '951, Marton, Pepe, Huang, and Hypervolt; asserting that claim terms are unpatentable under § 112(a) for lack of written description support) *with* Pet., 6, 35–44 (asserting that the challenged claims are unpatentable as obvious based on the same references and that the same terms lack written description support). In district court, Petitioner further challenges the claim on numerous additional obviousness grounds. EX2006, 17–38.

Petitioner's last-minute stipulation—filed just a few weeks before Patent Owner's discretionary denial brief— should be disregarded. The Director has made clear that stipulations must be filed "as soon as practicable, so that the patent owner may address the impact of the stipulation in its discretionary denial brief." *See Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2026-00018, Paper 20 at 3 (P.T.A.B. April 28, 2026) (Squires, Director) (citing Interim Process § I.D) Patent Owner offers no explanation for its delay or reason why the stipulation was not filed with the Petition or shortly thereafter. This is precisely the type of

gamesmanship the timing requirement is intended to prevent—the stipulation should not be considered.

Even if considered, Petitioner's stipulation does little to mitigate concerns of inefficiency or duplication of effort such that this proceeding would be a "true alternative" to the parallel district court proceeding. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (P.T.A.B. Mar. 28, 2025) (on Director Review vacating panel's institution decision and denying under *Fintiv*). Petitioner's stipulation is expressly conditional, applying only if the PTAB or the Director does not subsequently "vacate, reverse, or withdraw institution or otherwise deinstitute the proceeding." Paper 7 at 1. It, therefore, effectively allows Petitioner to preserve duplicate invalidity contentions through the conclusion of this PGR. As the Director has recognized, such tactics are problematic because it permits a petitioner "to maintain duplicative grounds in district court until the eve of trial … [and] could force patent owner[] to expend significant resources substantively responding to such grounds in the district court." *See Advanced Micro Devices, Inc. v. XtreamEdge, Inc.*, IPR2025-00223, Paper 29 at 4–5 (P.T.A.B. May 12, 2026) (Squires, Director).

Accordingly, this PGR will not be a "true alternative" to the parallel proceeding. Patent Owner will necessarily have to prepare for the possibility that the duplicative grounds may become active if this PGR is instituted and then

terminated (e.g., because Petitioner decides to advance an inconsistent claim construction or take other action to warrant termination). Petitioner's stipulation that it will not "pursue" the duplicate challenges as long as the PGR is instituted, and remains instituted, does little to mitigate the resources that Patent Owner will need to expend to prepare for the possibility that Petitioner could resurrect its challenges. Moreover, the inefficiencies in instituting a PGR here are heightened by the duplicative effort the parties and district court will necessarily incur in the other actions involving the competing percussive massage device products. *See* Section II.B.

Accordingly, Factor 4 strongly favors denial.

5. Factor 5 favors denial because the parties in the PGR are identical to the parties in the district court.

Factor 5 favors denial because the parties are the same in both proceedings. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (P.T.A.B. May 13, 2020) ("Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.").

6. Factor 6 favors denial because the merits are weak.

Factor 6 also favors denial because the merits are weak. As will be explained in the Patent Owner's Preliminary Response ("POPR"), for multiple reasons, the Petition fails to establish that the challenged claims are unpatentable over the asserted Grounds. For instance, Petitioner's Ground 6 challenge improperly relies

exclusively on declarant testimony by Mr. Morrill, and Mr. Morrill, in turn, cites to nothing in the record to support his testimony. *See* Pet., 118–131; EX1002, ¶¶239–263. Patent Owner asks the Director to consider the briefing presented in its POPR. *See* Interim Process, § II.C.i (patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits).

In sum, the *Fintiv* factors weigh heavily in favor of denial and strongly demonstrate that institution of this PGR would be duplicative and be contrary to the intent of AIA proceedings to provide "a more efficient system for challenging patents" and "reduc[e] unwarranted litigation costs." H.R. Rep. No. 112-98 at 39–40 (2011).

C. Petitioner reserves the right to advance inconsistent claim constructions in the PGR and district court in clear contravention of Office policy.

The Petition should be denied because Petitioner explicitly reserves the right to present different claim construction positions before the PTAB and in district court. In its PGR Petition, Petitioner chose not to present any grounds asserting the claims are indefinite under § 112. Yet in district court, Petitioner specifically "reserves the right to amend or supplement" its contentions to assert claim terms are indefinite under § 112. EX2006, 41–42. Thus, Petitioner effectively asserts the right to take inconsistent claim construction positions across forums, notwithstanding the Office's clear guidance that such conduct is highly disfavored

and undermines the integrity of the patent system.

Allowing petitioners to propose different constructions at the Board and the district court is contrary to the goal of "providing greater predictability and certainty in the patent system." *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 4 (P.T.A.B. Nov. 3, 2025) (Squires, Director) (precedential) (internal citations omitted). Rules 104(b)(3) and 104(b)(4) require a petitioner to explain "how the challenged claim is to be construed" and "how the construed claim is unpatentable." 37 C.F.R. §§ 42.204(b)(3)–(4). "The Board's claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums." *Revvo*, IPR2025-00632, Paper 20 at 4.

Petitioner's conduct "demonstrates that this dispute is less about a litigation alternative, as Congress intended, and more about inconsistent positions to gain an upper hand in the overall litigation." *See Terumo BCT Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 20 at 4 (P.T.A.B. May 12, 2026) (Squires, Director) (informative) (citing H.R. Rep. No. 112-98 at 48 (2011)). This is, therefore, another independent reason that favors discretionary denial.

V. CONCLUSION

For the foregoing reasons, the Director should exercise discretion to deny institution of this PGR.

Respectfully submitted,

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

I certify that the above-captioned **PATENT OWNER'S BRIEF ON DISCRETIONARY DENIAL** and associated Exhibits 2001–2017 were served in their entireties on July 29, 2026, upon the following parties via electronic mail:

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