

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYPER ICE INC.,
Petitioner,
v.
THERABODY, INC.,
Patent Owner.

Case No. PGR2026-00051

U.S. Patent No. 12,396,919

PETITIONER'S BRIEF OPPOSING DISCRETIONARY DENIAL

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PETITIONER'S EXHIBIT LIST

Exhibit No.	Description	Previously Served
1001	U.S. Patent No. 12,396,919 B2 with April 21, 2026 Certificate of Correction (the "'919 Patent")	X
1002	Declaration of Nathan Morrill In Support of Petition for Post-Grant Review of U.S. Patent No. 12,396,919	X
1003	Prosecution History of the '919 Patent	X
1004	YouTube.com page, Introducing the Hypervolt by HYPERICE, posted February 26, 2018	X
1005	YouTube.com video, Introducing the Hypervolt by Hyperice (video associated with Ex. 1004) (also available at https://www.youtube.com/watch?v=eI3QbjhGNK0)	X
1006	Press release, Hyperice Introduces Hypervolt, a State-of-the Art Vibration, Massage Device for Muscle Relief, February 26, 2018	X
1007	YouTube.com page, Hypervolt v Theragun Review, posted March 14, 2018	X
1008	YouTube.com video, Hypervolt review (video associated with Ex. 1007) (also available at https://www.youtube.com/watch?v=kFfOI4IM0Tc)	X
1009	U.S. Patent No. 4,730,605 to Noble et al.	X
1010	U.S. Patent Application Publication 2001/0027280 A1 to Huang	X
1011	U.S. Patent No. 12,064,387 B2 to Wersland et al.	X
1012	Excerpts from the Prosecution History of U.S. Patent 12,064,387	X
1013	U.S. Patent No. 10,702,448 to Wersland et al.	X

Exhibit No.	Description	Previously Served
1014	Prosecution History of U.S. Patent Application No. 19/295,322	X
1015	U.S. Patent No. 10,857,064 B2 to Wersland et al.	X
1016	U.S. Patent No. 10,940,081 B2 to Nazarian et al.	X
1017	Prosecution History of U.S. Provisional Application No. 62/844,424	X
1018	Merriam Webster Dictionary – Definition of TRANSVERSE	X
1019	Merriam Webster Dictionary – Definition of OBTUSE	X
1020	Collins English Dictionary – Definition of OFFSET	X
1021	U.S. Patent No. 11,357,697 to Wersland et al.	X
1022	Chinese Patent Application Publication No. CN 109907965 A to Hu	X
1023	English Translation of Chinese Patent Application Publication No. CN 109907965 A	X
1024	Certificate of Accuracy of Translation of Chinese Patent Application Publication No. CN 109907965 A	X
1025	U.S. Patent Application Publication No. 2017/0304145 A1 to Pepe	X
1026	U.S. Patent No. 11,478,400 B1 to Marton et al.	X
1027	U.S. Patent No. 11,890,253 to Wersland et al.	X
1028	U.S. Patent No. 11,452,670 to Wersland et al.	X
1029	U.S. Patent No. 11,564,860 to Wersland et al.	X
1030	U.S. Patent No. 10,959,908 B2 to Lee et al.	X
1031	Unused	
1032	Internet Archive - Hypervolt product page dated March 1, 2018	X

Exhibit No.	Description	Previously Served
1033	Internet Archive - Runnersworld.com article, The Hyperice Hypervolt Makes Foam Rollers Obsolete dated August 14, 2018	X
1034	Internet Archive - New York Times article, October 5, 2018	X
1035	U.S. Patent Application Publication No. 2001/0027280 A1 to Huang	X
1036	U.S. Patent Application Publication No. 2021/0022951 A1 to Hu	X
1037	International Patent Application Publication No. WO 2020/147223 to Hu	X
1038	English Translation of International Patent Application Publication No. WO 2020/147223 to Hu	X
1039	Certification of Accuracy of Translation of International Patent Application Publication No. WO 2020/147223 to Hu	X
1040	Chinese Patent Application Publication No. CN 109771238 A to Hu	X
1041	English Translation of Chinese Application Publication No. CN 109771238 A to Hu	X
1042	Certification of Accuracy of Translation of Chinese Patent Application Publication No. CN 109771238 A to Hu	X
1043	U.S. Patent No. 10,314,762 B1 to Marton et al.	X
1044	U.S. Patent No. 753,414 to Luger	X
1045	Museum of Technology, The History of Gadgets and Gizmos, August 22, 2016	X
1046	U.S. Patent No. 1,245,860 to Black & Decker	X
1047	U.S. Patent No. 5,618,315 to Elliott	X

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1048	Young et al, (2013) The natural angle between the hand and handle and the effect of handle orientation on wrist radial/ulnar deviation during maximal push exertions, <i>Ergonomics</i> , DOI:10.1080/00140139.2013.765602	X
1049	Patent Owner's Infringement Allegations for the '919 Patent with respect to Hypervolt Go 2, filed 2/25/2026 in <i>Therabody, Inc. v. Hyper Ice, Inc.</i> , C.D. Cal. Case No. 8:26-cv-00003-JWH-KES	X
1050	Declaration of Maggie Sakioka in Support of Petition for Post-Grant Review of U.S. Patent No. 12,396,919	X
1051	Hypervolt Inventory as of August 31, 2018	X
1052	Invoice dated August 10, 2018 from Dongguan YIXUNNUO Technology Co., Ltd.	X
1053	NRI Receipt No. 211045 dated August 17, 2018	X
1054	EMC Test Report for Hypervolt dated March 1, 2018	X
1055	U.S. App. No. 19/295,322 – Transaction History	
1056	U.S. App. No. 17/244,239 – Response to Office Action dated 1/28/2022	
1057	U.S. App. No. 17/018,099 – Response to Office Action dated 11/16/2021	
1058	U.S. App. No. 17/018,099 – Response to Office Action dated 7/19/2021	
1059	U.S. App. No. 16/869,402 – Response to Office Action dated 7/28/2020	
1060	U.S. App. No. 17/018,099 – Response to Office Action dated 3/10/2021	
1061	Email to Therabody's Litigation Counsel sent 8/11/2026	

Exhibit No.	Description	Previously Served
1062	<i>Entropic Commc'ns, LLC v. DISH Network Corp.</i> , No. 2:23-CV-01043-JWH-KES, Dkt. 571 (C.D. Cal. Feb. 13, 2025)	
1063	Judge Holcomb Stay Pending PTAB Statistics	
1064	<i>C.R. Laurence Co., Inc. v. Frameless Hardware Co.</i> , No. 2:21-cv-01334-JWH-RAO, Dkt. 122 (C.D. Cal. Dec. 9, 2022)	
1065	<i>Longitude Licensing Ltd. v. Amazon.com, Inc.</i> , No. 8:23-cv-00039-JWH-DFM, Dkt. 61 (C.D. Cal. Oct. 18, 2023)	
1066	<i>Hyper Ice, Inc. v. Therabody, Inc.</i> , No. 8:24-cv-00390-JWH-DFM, Dkt. 52 (C.D. Cal. July 7, 2025)	
1067	Email Attaching Therabody's Discovery Requests to Hyper Ice dated 8/14/2026	
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1071	<i>Therabody, Inc. v. Hyper Inc., Inc.</i> , No. 8:26-cv-00003-JWH-KES – Defendant's Proposed Terms for Construction	
1072	<i>Therabody, Inc. v. Hyper Inc., Inc.</i> , No. 8:26-cv-00003-JWH-KES – Plaintiff's Proposed Terms for Construction	
1073	<i>Therabody, Inc. v. Hyper Inc., Inc.</i> , No. 8:26-cv-00003-JWH-KES – Hyperice's Preliminary Claim Constructions	
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<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (Feb. 13, 2020)	3, 9
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (Mar. 20, 2020)	2, 13, 15, 16, 17, 19
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (May 19, 2025)	2, 3, 9
<i>Entropic Commc'ns, LLC v. DISH Network Corp.</i> , No. 2:23-CV-01043-JWH-KES, 2025 WL 519639 (C.D. Cal. Feb. 13, 2025)	13
<i>FreightCar America, Inc. v. National Steel Car Ltd.</i> , IPR2025-01046, Paper 20 (Oct. 10, 2025)	15
<i>Lockwood v. Am. Airlines, Inc.</i> , 107 F.3d 1565 (Fed. Cir. 1997)	5
<i>Magnolia Medical Techs., Inc. v. Kurin, Inc.</i> , IPR2026-00097, Paper 17 (May 14, 2026)	1, 3
<i>Samsung Elecs. Co., Ltd. v. Netlist, Inc.</i> , IPR2026-00018, Paper 20 (April 28, 2026)	17
<i>Tesla, Inc. v. Autonomous Devices</i> , IPR2023-01172, Paper 21 (Jan. 8, 2024)	16
<i>Tesla, Inc. v. Bulletproof Property Management, LLC</i> , IPR2026-00204, Paper 14 (June 15, 2026)	18

Statutes

35 U.S.C. § 112	5, 12
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35 U.S.C. § 1205

35 U.S.C. § 325(e)18

Other Authorities

37 CFR § 42.64(b)19

I. INTRODUCTION

Hyperice’s Petition should not be discretionarily denied under either 35 U.S.C. §324(a) or §325(d). Regarding §324(a), the *Fintiv* factors nearly universally favor institution, with no scheduled trial date, no substantial investment by the parties prior to institution, a substantial likelihood that the litigation will be stayed upon institution, and Hyperice’s *Sotera* stipulation eliminating duplicate efforts.

Regarding §325(d), the central purpose of AIA review is to determine whether a patent “may have been improvidently granted and whether and to what extent that right should continue to be recognized at all.” *Magnolia Medical Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17, *7.8 (May 14, 2026) (precedential). That is what occurred here—the ’919 Patent issued as a result of multiple Office errors.

First, the Examiner incorrectly accorded the claims the benefit of a provisional application filing date based on Patent Owner’s (“PO”) incomplete—and ultimately incorrect—argument. Second, the Examiner incorrectly interpreted claim 1 as requiring a rotatable output shaft when it does not. These errors, individually and collectively, caused the Examiner to overlook the highly relevant prior art that forms the basis of the Petition. PO’s characterization of this proceeding as simply a “competitor dispute” ignores Petitioner’s showing the ’919 Patent was improvidently granted—precisely the circumstance AIA review is meant to address. (Paper 7 (“PO’s Brief”), p.4).

PO's arguments unduly focus on two secondary references cited in the Petition while downplaying the significance of the overlooked and unapplied prior art publications, the never considered system art, and the numerous §112(a) deficiencies at the heart of the Petition. The previously applied references, Hu '951 and Marton, are applied as *secondary* references according to their straightforward teachings that PO never challenged during prosecution. The overlooked and unapplied references, Hu '965 and Huang, on the other hand, disclose the very same offset drive mechanism described in the '919 Patent such that they "include[] specific teachings that impact patentability of the challenged claims." *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, *5 (May 19, 2025) (precedential as to §A) ("*Ecto World*") (cleaned up). Moreover, the Hypervolt product's relevance as unconsidered system art is confirmed by new, post-issuance evidence, including PO's infringement contentions.

The Petition should not be discretionarily denied.

II. THE PETITION SHOULD BE REFERRED FOR MERITS CONSIDERATION

A. The *Fintiv* Factors Weigh Strongly Against Discretionary Denial

Fintiv factors 1-4 and 6 each favor institution. Factor 5—the identity of the parties—is not sufficient to overcome the numerous other factors favoring institution.

1. Fintiv Factor 1: A Stay is Likely if the PGR is Instituted

If this PGR is instituted, the parallel litigation will almost certainly be stayed. Petitioner intends to promptly move to stay the parallel litigation upon institution of this PGR, and Judge Holcomb favors staying litigation in light of instituted PTAB proceedings. (EX-1061); *see Entropic Commc'ns, LLC v. DISH Network Corp.*, No. 2:23-CV-01043-JWH-KES, 2025 WL 519639, at *3 (C.D. Cal. Feb. 13, 2025)¹ (“There is a near uniform line of authority [reflecting the principle that] after the PTAB has instituted review proceedings, the parallel district court litigation ordinarily should be stayed.”) (alterations in original) (internal quotations omitted). Consistent with this principle, Judge Holcomb has granted 14 of 16 motions to stay pending PTAB proceedings. (EX-1063)². Thus, it is very likely that Judge Holcomb will stay the parallel litigation upon institution of this PGR, which will address all claims at issue.

¹ A copy of this decision is attached as EX-1062.

² Of the three denied motions, *C.R. Laurence Co., Inc. v. Frameless Hardware Co., LLC* was incorrectly coded as “deny” as to the stay (EX-1064), *Longitude Licensing Ltd. v. Amazon.com, Inc.* (EX-1065) was denied because the PTAB had not yet instituted review, and *Entropic Commc'ns, LLC v. Dish Network Corp.* was denied because the PTAB was only considering two of 10 asserted patents (EX-1062).

In an earlier litigation between Hyperice and Therabody before Judge Holcomb, Hyperice joined Therabody's motion to stay upon institution of Therabody's PGRs against Hyperice's patents with a substantially similar posture as the parallel litigation, in which the *Markman* hearing was held just prior to institution. (EX-1066). Judge Holcomb stayed that litigation. Petitioner has reached out to Therabody's litigation counsel regarding joining a motion to stay in the parallel litigation but has received no response. (EX-1061, 1067). Regardless, Judge Holcomb is likely to stay the litigation upon institution.

Accordingly, factor 1 weighs against discretionary denial.

2. Fintiv Factor 2: The Final Written Decision Would Issue Before Any Trial

PO agrees, at pages 12-13 of its brief, that: (1) no trial date has yet been set in district court; (2) the projected statutory deadline for a Final Written Decision (FWD) in this PGR is no later than November 29, 2027; and (3) even under PO's median time to trial statistics, the trial would occur about three months *after* the FWD deadline. These facts weigh against discretionary denial. *See FreightCar America, Inc. v. National Steel Car Ltd.*, IPR2025-01046, Paper 20, *2 (Oct. 10, 2025) (declining to deny institution because the final written decision due date was 1 month before the scheduled trial date).

When the "median time to trial" is limited to recent patent cases in C.D. Cal.—rather than all civil cases as PO cited—trial would be estimated to occur late

November 2028, a full year after the FWD would issue. (EX-1068). And when Judge Holcombs' own time-to-trial statistics are considered, trial would be expected to occur around April 11, 2028, or five months *after* the FWD would issue. (EX-1069). Under any available statistic, the FWD is expected to issue well before trial.

PO's assertion that "it is likely that trial will occur sooner than the median time, placing it at the same time, or even earlier than the FWD" is pure conjecture. (PO's Brief, p.13). No deadline for fact or expert discovery has been set, nor has a trial date. (*Id.*, pp.12-13). Factor 2 weighs against denial.

3. Fintiv Factor 3: There has Been No Significant Investment in the Litigation

The parallel litigation is in its early stages and will remain so even until the Decision on Institution, by which time the parties will have exchanged infringement and invalidity contentions and will have argued claim construction. Litigation-specific activities have not yet occurred. Discovery deadlines have not been set, Petitioner has not served any discovery requests, and no depositions have been noticed or conducted. To date, only PO has issued written discovery requests, and only after Petitioner indicated its intent to move to stay the litigation if this PGR trial is instituted. (EXS-1061, 1067).

In past cases, the Board has found litigation even much further along—with completed fact discovery, depositions, and expert reports—insufficient to warrant denial. *See Abbot Vascular, Inc. v. FlexStent, LLC*, IPR2019-00882, Paper 11,

*28-29 (Oct. 7, 2019); *Tesla, Inc. v. Autonomous Devices*, IPR2023-01172, Paper 21, *8-9 (Jan. 8, 2024).

Lacking substantial investment by the parties, Factor 3 weighs against denial.³

4. **Fintiv Factor 4: Petitioner’s Sotera Stipulation Cures Any Possible Redundancy**

Petitioner has stipulated that “if the PTAB institutes trial in PGR2026-00051 and does not subsequently vacate, reverse, or withdraw institution or otherwise deinstitution the proceeding, [Petitioner] will not pursue in the co-pending litigation the specific grounds asserted in PGR2026-00051 or any other ground that could reasonably be raised in PGR2026-00051.” (Paper 6). PO’s arguments against Petitioner’s straightforward stipulation are without merit.

First, PO argues that Petitioner’s stipulation should be disregarded as untimely. (PO’s Brief, p.15). In *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2026-00018, Paper 20, *3 (April 28, 2026), the petitioner did not file its stipulation until two weeks after the conclusion of discretionary denial briefing. Here, Petitioner filed its stipulation *three weeks before* PO’s deadline to file its discretionary denial brief, giving PO ample time to consider Petitioner’s stipulation. (See PO’s Brief, pp.15-17

³ The parties’ effort and investment in unrelated litigations are irrelevant to factor 3, which considers the “amount and type of work already completed *in the parallel litigation*.” (See PO’s Brief, pp.13-14 (emphasis added)).

(addressing Petitioner’s stipulation)). Moreover, Petitioner filed its Stipulation *one day* after it served its invalidity contentions in the parallel litigation. (EX-2006). PO cannot credibly allege prejudice.

Second, PO criticizes Petitioner’s stipulation as being “expressly conditional” because it is applicable if a decision to institute this proceeding is not vacated, reversed, or withdrawn. (PO’s Brief, p.16). This language is consistent with the estoppel provision, which attaches “in a post-grant review ... that results in a final written decision.” 35 U.S.C. § 325(e). This language is also consistent with recent stipulations in proceedings that were referred for merits consideration. (EX-1070 (collecting stipulations)); *see Tesla, Inc. v. Bulletproof Property Management, LLC*, IPR2026-00204, Paper 14, *2-3 (June 15, 2026) (informative) (citing “Petitioner’s broad stipulation” as supporting the decision to deny the request for discretionary denial).

Petitioner’s aforementioned intent to move to stay the litigation upon institution, which is likely to be granted, addresses the remainder of PO’s arguments.

Thus, Factor 4 weighs against denial.

5. Fintiv Factor 5: The Parties are the Same

Because “no single factor is dispositive,” and because Factors 1, 2, 3, 4, and 6 *each* weigh against denial, this factor alone does not warrant denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, *6 (Mar. 20, 2020) (precedential).

6. **Fintiv Factor 6: Additional Considerations**

a) **The Merits are Exceptionally Strong**

As to the merits, PO only alleges an evidentiary deficiency in Ground 6, which should be raised after institution. (PO’s Brief, pp.17-18); 37 CFR § 42.64(b). Ground 6 relies on the Hypervolt product, one of which Petitioner’s expert, Mr. Morrill, disassembled and photographed in detail. (Pet., pp.47-48, 119-31). Mr. Morrill’s testimony is thus supported by concrete physical evidence in the record—not bare assertion. PO will have an opportunity to cross-examine Mr. Morrill during trial.

b) **Fairness Favors Institution**

Therabody previously challenged two Hyperice patents via PGR proceedings PGR2024-00053 and PGR2025-00013, which concluded with Final Written Decisions in April and May 2026, respectively. Now, Therabody is asserting one of its newly-issued patents against Hyperice. Just as Therabody availed itself to the PGR process to challenge Hyperice’s patents, Hyperice should be permitted to avail itself to the same process to challenge Therabody’s patent.

B. **Numerous Examination Errors Confirm that the ’919 Patent was Allowed in Error**

“[U]nder § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is

satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, *8 (Feb. 13, 2020) (precedential). The analysis at step two of the *Advanced Bionics* framework considers “how the Examiner erred in overlooking the prior art” “with reference to *Becton Dickinson* factors (c), (e), and (f).” *Ecto World*, *5. Nevertheless, “[a] substantial showing of apparent examiner error can overcome other factors that suggest discretionary denial.” *Magnolia Medical Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17, *7-8 (May 14, 2026) (precedential).

1. The Examiner Incorrectly Accorded the Challenged Claims the May 7, 2019, Provisional Filing Date

The '919 Patent is a continuation of U.S. App. No. 18/162,499 (the “'499 Application”), which issued as U.S. Patent No. 12,064,387 (the “'387 Patent”). (EX.1001, code [63]). During prosecution of the '499 Application, to disqualify a cited prior art reference, PO argued that “[t]he present application claims the benefit of U.S. Provisional Patent Application No. 62/844,424 (‘the '424 application’), filed May 7, 2019” and “[t]he subject matter of at least claims 2, 7-14, and 18-21 is entitled to the priority date of the '424 application because support for that subject matter can be found at least in FIGS. 28, 31, 32, and 35-38, and paragraphs [0118]-[0122] of the '424 application.” (EX-1012, pp.162-63). For reasons explained below, the Examiner mistakenly accepted PO’s assertion, stating in the

Notice of Allowance that “Applicant’s argument that ... independent claims 2 and 13 are supported in provisional 62/844424 filed 5/7/19 is persuasive.” (*Id.*, p.176).

That same Examiner, Examiner Stuart, examined the '919 Patent and apparently examined the Challenged Claims believing they were entitled to the same (incorrect) May 7, 2019, provisional filing date. For example, during prosecution, PO’s representative conducted an Examiner interview to “discuss[] the provisional application 62/844424 as having support for claim 19.” (EX-1003, pp.572, 575). After the Examiner “indicated that it does not appear the provisional application supports the limitation of claim 19,” and PO subsequently amended claim 19 to remove the unsupported limitation, indicating that the PO and Examiner intended for the Challenged Claims accorded the May 7, 2019, priority date. (*Id.*, pp.572, 566). Moreover, the Examiner repeatedly rejected the claims on the ground of nonstatutory double patenting in view of the '387 Patent, eventually causing PO to file a Terminal Disclaimer so that the '919 Patent could be allowed. (*Id.*, pp.34, 38, 280-81, 321-24, 600-02). Confirming this understanding, the Examiner cited only prior art references that predated the May 7, 2019, provisional filing date during prosecution of the '919 Patent. (*Id.*, pp.310-319, 590-99). Thus, the prosecution history reveals that the Examiner and PO treated the Challenged Claims as having the May 7, 2019, effective filing date, which was in error.

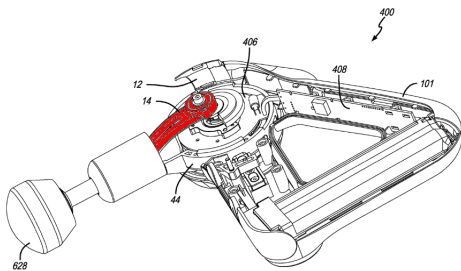
“In order to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997). Thus, for the Challenged Claims to be entitled to the May 7, 2019, filing date of the ’424 provisional application, PO was required to *but failed to* show continuous disclosure through each of the intervening applications leading to the ’424 provisional application, not merely that the ’424 provisional application contained the necessary disclosure⁴. (See Pet., p.24 (graphical representation of the ’919 Patent’s priority chain)).

As explained in the Petition, the earliest intervening non-provisional application, U.S. Application No. 16/796,143 (now U.S. Patent No. 10,940,081) lacks the very disclosure from the ’424 provisional application that PO originally cited during prosecution of the ’387 Patent as providing written description support for the later-filed claims. (Pet., pp.25-29). By accepting PO’s incomplete argument at face value and by failing to review and confirm that each intervening application contained the necessary disclosure (which would have revealed the break in

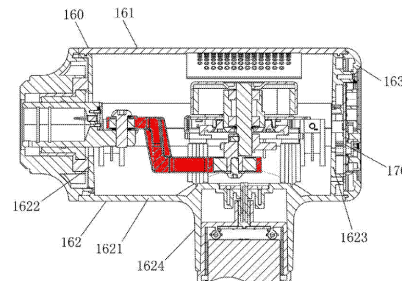
⁴ To be clear, Petitioner also disputes that the ’424 provisional application itself supports the Challenged Claims. (Pet., pp.30-35).

continuity at the '081 Patent), the Office materially erred in examining the '919 Patent by using the incorrect May 7, 2019, effective filing date. (*Id.*, pp.28-29).

Due to this error, the Examiner failed to consider Hu '965, which published on June 21, 2019, approximately two months after the May 7, 2019, provisional filing date, as prior art against the Challenged Claims. (*Id.*, p.45). As explained in the Petition, Hu '965 is extremely relevant to the Challenged Claims because it discloses the same offset drive mechanism / push rod assembly as required by all of the Challenged Claims and even describes it as providing the same purported benefit as the '919 Patent—a more compact device. (*Id.*, pp.45, 61-63, 73).



'919 Patent, FIG. 21



Hu '965, FIG. 6

Compounding matters, Hu '965 was also buried in a voluminous IDS filing along with Huang, which was similarly overlooked during prosecution but is cited in the Petition as teaching the drive mechanism limitations. In particular, Hu' 965 and Huang were listed as two references among 700+ references in a single IDS. (EX-1003, pp.1023-59). The IDS was so excessive that the Examiner requested PO's assistance in "highlight[ing] those documents which have been specifically brought to applicant's attention and/or are known to be of most significance." (*Id.*, p.585).

PO never provided the requested assistance. (*Id.*, pp.567-70).

Taken together, the Office materially erred in overlooking the highly relevant Hu '965 reference, which was at least in part the result of the Office examining the Challenged Claims based on the incorrect May 7, 2019, provisional filing date. In addition, Hu '965 is unlike the other references cited during prosecution because it not only discloses the described and claimed offset drive mechanism but asserts the same purported benefit in such a drive system as the '919 Patent—a more compact device—confirming its material relevance to the '919 Patent.

2. The Examiner Misinterpreted the Claims

In the final Office action prior to allowance, the Examiner stated that the “obtuse” and “oblique” angle limitations of various claims “[are] being interpreted in view of the disclosure, in particular, the rotation housing 44 (Fig. 21-23) *which would allow **the angular position** between handle portion/axis and output shaft/reciprocation axis **to be adjusted*** and to assume an obtuse/oblique angle.” (EX-1003, p.308 (*emphasis* added)). In rejecting claim 1 in the same Office action, the Examiner cited U.S. Patent No. 10,959,908 to Lee as teaching the drive mechanism limitations and referred to “Fig. 8 [of Lee] [as] showing the adjustable massager thus allowing for multiple angular locations for the reciprocation axes A3-A3'””. (*Id.*, pp.310-11, 315).

The Examiner appears to have incorrectly interpreted the “obtuse” angle limitation of claim 1 as requiring a rotatable output shaft allowing its angular position with respect to the handle portion to be adjusted despite no such limitation being present in the claim. Despite the Examiner’s express statement confirming this interpretation, PO never corrected the record and allowed the ’919 Patent to issue despite the Examiner’s misinterpretation. (*Id.*, pp.295-300). Indeed, by limiting examination of at least claim 1 to only references with an angular adjustability, *i.e.*, Lee, the Examiner overlooked numerous relevant references that lack the adjustable angle but otherwise disclose many relevant claim limitations, such as Pepe, and would have caused the Examiner to overlook relevant references that disclose the claimed drive mechanism but lack angular adjustability, such as Huang.

3. The Examiner Overlooked Huang’s Teachings

Like Hu ’965, Huang was buried within the same 700 reference IDS. (EX-1003, p.619). The Examiner never cited Huang to reject any claim of the ’919 Patent despite Huang’s highly material teachings as to the offset drive mechanism, including the same “L-shaped” push rod disclosed in the ’919 Patent. (Pet., 49, 92-94, 96-97, 101-10).

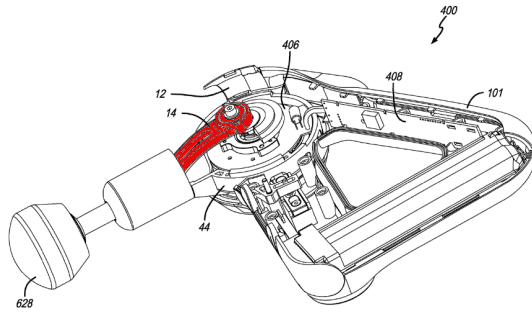


FIG. 21

'919 Patent, FIG. 21

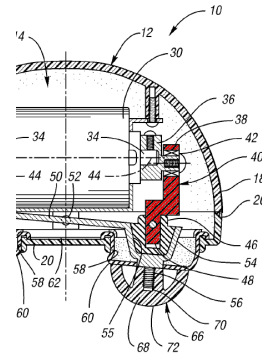


Fig. 5

Huang, FIG. 5 (partial)

Huang's relevance is confirmed by the ongoing examination of U.S. Application No. 19/295,322 (the "'322 Application"), which is a child application of the '919 Patent. (EX-1014, p.596). The '322 Application is being examined by a different Examiner than examined the '919 Patent and its progeny. In the most recent communication in the '322 Application, the Examiner and PO's representative "discussed the 103 rejections with respect to the Danby, *Huang*, and Noble prior art" with the Examiner "disagree[ing]" with PO's arguments. (*Id.*, pp.2-4 (emphasis added)). The '322 Application currently stands finally rejected, with the six-month deadline to respond being September 9, 2026. (EX-1055).

Huang's material relevance coupled with PO's decision to ignore the Examiner's request for assistance in locating "those documents ... known to be of most significance" in the 700+ reference IDS favor institution. (*Id.*, p.585); *see Ecto World*, *5-7 (holding that even when art is submitted in an IDS, "a petitioner may argue that it satisfies the second part of *Advanced Bionics* because the asserted prior art was not a basis for rejection during examination, is not substantially the same as

prior art the Examiner applied, and includes specific teachings that ‘impact patentability of the challenged claims’” and noting that “the Board should consider a petitioner’s argument based on the volume of the references submitted to the Office during examination and any applicant information or assistance regarding the relevance of references” which “may demonstrate that discretionary denial under § 325(d) is not warranted.”).

4. **The Petition Properly Relies on Limited, Unchallenged Disclosures from Hu ’951, Marton, and Pepe**

a) **Hu ’951**

During prosecution of the ’919 Patent, Hu ’951 was cited as *anticipating* claims 2 and 14 but was never cited to reject claim 1. (EX-1003, pp.590-95). In the Petition, Hu ’951 is used as *a secondary reference* teaching only those limitations related to the “oblique” or “obtuse” angled handle. (Pet., pp.52, 65, 74). During prosecution, the Examiner stated that “Hu [’951] shows ... wherein the handle portion axis extends at an oblique angle to the reciprocation axis ... (see annotated Fig. 5 below showing handle portion axis ... which forms an oblique angle with the reciprocation axis as can be seen).” (EX-1003, pp.590-92). PO never contested or challenged the Examiner’s characterization of Hu ’951. (*Id.*, p.569). Rather, PO amended claim 2 “to recite ‘the proximal end of the push rod is farther from the reciprocation axis than the distal end is’” and argued that “Hu [’951] does not disclose *this feature*.” (*Id.* (*emphasis added*)). The Petition does not rely on Hu ’951

as teaching the “the proximal end of the push rod is farther from the reciprocation axis than the distal end is” limitation recited in claims 2, 5, 6, and 18, but instead cites previously overlooked and unapplied Hu ’965 (Pet., pp.75, 79-80) and Huang (*Id.*, pp.104-05, 109-10) as teaching these limitations.

b) Marton ’922

In the final Office action before allowance, the Examiner cited Marton ’922 as “teach[ing] a similar percussive massage device which includes a backward facing electronic display and switch” to reject claim 8 and “a backward facing electronic display” to reject claim 12. (EX-1003, p.319). PO never challenged the Examiner’s characterization of Marton ’922. (*Id.*, p.298). Because PO never contested the Examiner’s characterization of Marton ’922 as teaching these features, the Petition appropriately and accurately cites Marton as *a secondary reference* teaching these same features of certain dependent claims.

c) Pepe was not Cited During Prosecution

The Examiner never cited Pepe to reject any claim of the ’919 Patent, and PO fails to explain the relevance of the “multiple parent applications” to the Challenged Claims. (PO’s Brief, p.9). Notably, PO only provided the rejections citing Pepe with its brief. (EXs-2013-16). Nevertheless, as with Hu ’951 and Marton ’922, PO never disputed Pepe’s teachings relevant to the Petition. (*See* EXS-1056-60 (PO’s responses to the rejections filed as EXS-2013-17, respectively). Thus, not only did

the Examiner overlook Pepe's relevance to the Challenged Claims, likely as a result of the uncorrected misinterpretation of claim 1, the Petition nevertheless properly cites Pepe as teaching features never challenged by PO.

d) Additional Evidence is Advanced in the Petition

The prior art Hypervolt product and the accused Hypervolt Go 2 utilize a substantially similar drive mechanism. (Pet., pp.123-24). PO's infringement allegations (EX-1049), which confirm PO's interpretation of claim 1 against the Hypervolt Go 2, were unavailable to the Examiner during prosecution of the '919 Patent. These infringement allegations support that the prior art Hypervolt anticipates the drive mechanism as claimed in at least claim 1 of the '919 Patent. (*Id.*).

Because substantial Office errors pervaded the prosecution of the '919 Patent and caused the Examiner to overlook multiple highly relevant references, including Pepe, Huang, and Hu '965, and because the Examiner could not have considered the Hypervolt product during prosecution, the Petition should not be discretionarily denied under §325(d).

Moreover, the Petition challenges all 20 claims as lacking written-description support under § 112(a). (Pet., pp. 37-44). A close review of the claims reveals that PO's continuation-upon-continuation approach—with a focus on competitors' products rather than the supporting disclosure—has resulted in claims untethered to anything the inventor ever possessed. Although the Examiner caught some such

issues during prosecution, the Examiner missed many more. (EX-1003, pp.586-90). These oversights constitute additional material error favoring institution.

III. PETITIONER’S CLAIM CONSTRUCTIONS ARE CONSISTENT

PO’s final argument suggests that Petitioner intends to advance conflicting claim constructions. (PO’s Brief, pp.18-19). Not so. Petitioner served its Preliminary Claim Constructions in the parallel litigation today, and Petitioner’s proposed claim constructions are *identical* to those advanced in the Petition. (EX-1073).

PO contends that, in its Invalidity Contentions in the parallel litigation, Petitioner “specifically ‘reserves the right to amend or supplement’ its contentions to assert claim terms are indefinite under § 112.” (PO’s Brief pp.18). Petitioner *actually* stated that it “reserves the right to amend or supplement these contentions *to account for the claim constructions provided by the Court or in view of Plaintiff’s proposed claim constructions.*” (EX-2006, pp.42-43 (emphasis added)). In other words, Petitioner may argue that future constructions, either submitted by PO or adopted by the Court, are indefinite. This is common sense, not gamesmanship.⁵

⁵ Parties routinely reserve the right to amend or supplement contentions or proposed constructions; in fact, in PO’s Preliminary Claim Constructions, PO states that it “reserves the right to supplement, amend, or otherwise modify these preliminary constructions ... as further clarification and/or additional information becomes

Regardless, Petitioner does not intend to advance any inconsistent claim constructions between the proceedings.

IV. CONCLUSION

Petitioner respectfully requests that Patent Owner's request for discretionary denial be denied and that the Petition be referred for consideration on the merits.

Dated: August 31, 2026

Respectfully submitted,

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available” and “further reserves the right to modify its claim construction positions based on the Court’s constructions or rulings on any related patents....” (EX-1074).

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above document was served on August 31, 2026, by filing this document through the Patent Trial and Appeal Board P-TACTS System and by e-mail service to the following email addresses.

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