

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 AUTHORIZED REPLY TO
PETITIONER'S BRIEF OPPOSING
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
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P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S UPDATED EXHIBIT LIST

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

Exhibit No.	Description
2012	Second Amended Complaint for Patent Infringement, <i>Hyper Ice, Inc. v. Therabody, Inc.</i> , 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
2018	Prosecution History of U.S. Patent No. 10,857,064
2019	Plaintiff's Patent L.R. 4-2 Preliminary Claim Constructions and Extrinsic Evidence, <i>Therabody, Inc. v. Hyper Ice, Inc.</i> , Case No. 8:26-cv-00003-JWH-KES (C.D. Cal.), August 31, 2026
2020	Information Disclosure Statement filed in U.S. Patent Application No. 18/162,499 on February 15, 2024

Petitioner's allegations of material error in its Opposition (Paper 8; "Opp.") rest on mischaracterizations of the record. As detailed in Patent Owner's Discretionary Denial Brief, the Director should deny institution because the Office already considered all prior art relied-upon in the Petition, applied some of that art in rejections, and expressly evaluated written description support under § 112(a).

First, Petitioner contends the Examiner improperly treated the challenged claims as being entitled to the filing date of the '424 Application and therefore failed to recognize Hu '965 as prior art. Opp., 9-13. As explained, Petitioner's priority challenge arguments all fail. Paper 9 ("POPR"), 9-11. Moreover, the Examiner initially determined that at least one of the claims ***was not*** entitled to the '424 priority date (EX1003, 572). With that determination made, nothing would have prevented the Examiner from considering and applying Hu '965 as prior art.

Second, Petitioner argues that Hu '965 and Huang were "buried" in an IDS containing hundreds of references. Opp., 11-12, 14. But Hu '965 was first submitted in an IDS in the parent application that contained only eleven references. EX2020. That IDS was considered by the same Examiner who later examined the '919 patent. The larger IDS during prosecution of the '919 patent was necessary to cite references from related applications, and the record demonstrates the Examiner considered, and applied, references from that IDS. Paper 7 ("D.D. Br."), 10. As to Huang, as explained in the Discretionary Denial Brief, another Examiner's reliance

on Huang in a separate continuation application does not show material error here because the claims differ, Patent Owner disputes the rejection, and the Office has not finally determined patentability. *See* D.D. Br., 11; Opp., 15. Indeed, Huang's use in a rejection in the continuation (Opp., 15) confirms Huang was not "buried."

Third, Petitioner mischaracterizes prosecution by alleging that the Examiner interpreted claim 1 to require a rotatable output shaft and therefore overlooked Pepe. Opp., 13-14, 17-18. The Examiner imposed no such requirement. Rather, prosecution reflects the Examiner's initial view that the art satisfied the claimed angles because rotating the housing *would allow* the angular position to be obtuse/oblique. EX1003, 308, 310-11, 315. That the claims could read on a rotatable output shaft does not mean they require one, and the Examiner never said they did.

Fourth, Petitioner's argument that the Examiner did not consider Hypervolt, Opp., 18, fails. The Examiner considered a video disclosing the same Hypervolt information on which Petitioner relies. D.D. Br., 5.

Finally, Petitioner's reliance on Hu '951 and Marton '922 for substantially the same teachings the Examiner previously relied upon in rejecting the claims merely reaffirms that the Petition repackages art already considered by the Office.

Accordingly, the Petition should be denied under 325(d), as well as for the other independent reasons set forth in the Discretionary Denial Brief.

Respectfully submitted,

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Date: September 11, 2026

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

I certify that the above-captioned **PATENT OWNER'S AUTHORIZED
REPLY TO PETITIONER'S BRIEF OPPOSING DISCRETIONARY
DENIAL** and associated Exhibit 2020 were served in their entirety on September
11, 2026, upon the following parties via electronic mail:

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