

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 REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

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P.O. Box 1450
Alexandria, VA 22313-1450

I. '919 PATENT PRIORITY DATE (POPR SECTIONS II.B AND V.B.1)

Hu '965 is prior art to the Challenged Claims *unless* PO “present[s] argument and evidence to show that each of the limitations of the challenged claims ... could rely on an earlier priority date” than Hu '965. *MaxLite, Inc. v. Jiaxing Super Lighting Elec. Appliance Co., Ltd.*, IPR2020-00208 (“*MaxLite*”), Paper 14, *8 (June 1, 2021); (Pet., pp.27-28 (describing PO's burden to establish priority)). PO instead relies on an earlier *MaxLite* decision—Paper 10—to argue that Petitioner must identify “any and all” unsupported limitations (POPR, p.10), but that decision was reversed on rehearing and the IPR instituted once the burden was correctly placed on the patent owner “to show that each of the limitations of the challenged claims ... could rely on an earlier priority date that the [prior art] reference.” *MaxLite*, Paper 14, *8.

Petitioner satisfied any *initial* burden by identifying, with expert testimony, the “eccentric shaft” limitations as being unsupported by the '424 Provisional. (Pet., pp.30-35). PO disputes this with only attorney argument and without addressing the counterweight assembly 17 added after the '424 Provisional. (POPR, pp.17-22). Further, the Examiner never expressly determined priority for any of, let alone all of, the Challenged Claims despite appearing to examine them with that understanding, which was in error. Because PO failed to satisfy its burden to show support for each limitation of the Challenged Claims in the '424 Provisional, the Challenged Claims cannot claim priority to the '424 Provisional at this stage.

II. THE HYPERVOLT IS PRIOR ART (POPR SECTION V.A.1)

The Petition establishes, with substantial and unchallenged evidence, that the particular Hypervolt analyzed by Petitioner's expert, Mr. Morrill, is prior art. The Petition cites the declaration of long-time Hyperice employee Maggie Sakioka, authenticating Hyperice's business records (Exs-1050-53), that together establish that a Hypervolt with serial number 3018 "was manufactured in the 30th week of 2018, *i.e.*, between July 23-29, 2018," and received in the U.S. by mid-August 2018 (Ex. 1050, ¶¶8-9), confirming its status as §102(a)(1) prior art. (Pet., p.48); *see Ens Labs Ltd. v. Unstoppable Domains Inc.*, IPR2024-00872, Paper 8, *18-19 (Nov. 22, 2024) (prior art status appropriately supported by declarations "[r]ather than argument"). A 2018 YouTube video and print articles provide additional background evidence of public availability. (Pet., p.48 (*citing* Exs-1007-08 and 1033-34)).

The Petition explains that "Mr. Morrill disassembled and analyzed a Hypervolt having serial number 3018" and presents arguments accompanied by reproductions of Mr. Morrill's pictures of the "3018" Hypervolt that he analyzed with specific citations to his declaration. (*Id.*, pp.48, 118-31 (*citing* Ex-1002, ¶¶113-14, 239-62)). The Petition, for all Grounds, cites Mr. Morrill's declaration *before* reproduced images, identifying the evidentiary basis for each reproduced image.

Tellingly, PO declines to address any of Petitioner's evidence, and never asserts that the Hypervolt is not prior art – because PO knows that it is prior art.

Dated: September 11, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above document was served on September 11, 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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