

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 SUR-REPLY TO
PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

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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
2021	Institution Decision, <i>Lupin Ltd. v. Pozen Inc.</i> , IPR2015-01775, Paper 15 (P.T.A.B. Mar. 1, 2016)

Petitioner’s Reply rests on a non-precedential rehearing decision, *MaxLite*, Paper 14, to wrongly assert that Patent Owner must prove support for “each of the limitations.” Reply, 1. But Hyperice reads *MaxLite* too broadly. Petitioner bears the burden of persuasion that Hu ’965 is prior art, and that burden “never shifts.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Only the burden of production shifts, and rebutting what the Petition raised satisfies that burden. *Id.* at 1379–80; POPR, 48–49; *see also* EX2021, 10-11 (*Lupin* Board decision explaining patent owner need only respond commensurate to petitioner’s contentions). *MaxLite* applied *Dynamic Drinkware* and *Lupin*, and neither case shifts the ultimate burden of persuasion to Patent Owner.

Even under Petitioner’s framework, the priority challenge fails. The Preliminary Response showed—from text and figures, not “attorney argument”—that the ’424 Application discloses the “eccentric shaft” claim limitations, including with an intervening element, i.e., intervening bearings 410. POPR, 20–21. The “counterweight assembly” (Reply, 1) is not a claim limitation but Petitioner’s example of another intervening element. Indeed, every limitation of independent claims 1, 2, and 18 is supported (Petition’s labels, Paper 2, x–xiv):

Claim 1 / Claims 2, 18	EX1017 (¶ or FIG., with EX1017 page)
1[pre], 1[a] / 2/18[pre]	¶[00117] (54)

Claim 1 / Claims 2, 18	EX1017 (¶ or FIG., with EX1017 page)
1[b] / 2/18[c]	¶[00118] (55); FIGS. 31, 33 (91, 93)
1[c] / 2/18[b]	FIG. 33 (93)
1[d] / 2/18[a]	¶[00118] (55); FIG. 31 (91)
1[e] / 2/18[h]	¶[00118] (55) (“pin 406”); FIG. 31 (91)
1[f-1]–[f-4] / 2/18[d]–[e], [i]	¶[00118] (55); FIGS. 31, 35 (91, 95)
1[f-5] / 2/18[g]	FIGS. 31, 35 (91, 95)
1[f-6] / 2/18[f]	¶[00120] (55–56); FIG. 35 (95)
1[g]	¶[00118] (55); FIGS. 31, 33 (91, 93)
2/18[j]	¶[00118] (55); FIGS. 28, 31, 35 (88, 91, 95)

Thus, Petitioner has not shown Hu ’965 to be prior art to any claim.

On the Hypervolt, the Petition offered only a conclusion, the string cite “Ex-1002, ¶114; Exs-1050-1053,” and a website footnote for a date code. Paper 2, 48 and n.11; POPR, 40–42. Petitioner’s *Reply* cannot supply what the *Petition* was required to contain. 37 C.F.R. §§ 42.204(b)(5), 42.22(a)(2), 42.6(a)(3). *Ens Labs* is not to the contrary; the defect is the *Petition*’s silence, not the declarations. Citing Mr. Morrill’s declaration (without explanation) does not cure the unlabeled photographs: the Hypervolt itself is not of record, and an expert’s account of a device he later examined does not show what was public in 2018.

Respectfully submitted,

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Date: September 16, 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
SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE** and Exhibit 2021 were served in their entireties on
September 16, 2026, upon the following parties via electronic mail:

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Date: September 16, 2026

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