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 SUR-REPLY TO PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO DISCRETIONARY DENIAL

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

The Examiner erred by failing to consider or properly apply relevant prior art, including Hu '965, Huang, and Pepe, and Hypervolt was never considered. PO's Reply (Paper 10) does not rebut these errors. Trial should be instituted.

Hu '965 was Overlooked as Prior Art. The Examiner overlooked that Hu '965 discloses the same eccentric drive mechanism providing the same alleged benefit as the '919 Patent. The Examiner's only express priority analysis indicated a lack of provisional support for claim 19, and PO declined to show provisional support for any Challenged Claim in its POPR. Thus, *at least* at the institution stage, Hu '965 is prior art. *See Intelligent Wellhead Sys., Inc. v. Downing Wellhead Equip., LLC*, PGR2025-00002, Paper 15, *20-21 (May 22, 2025) ("[PO] appears to assume, incorrectly, that Petitioner has the burden of showing that the '952 Patent is *not* entitled to any earlier effective filing date….").

Lengthy IDS. PO declined the Examiner's request to identify the most relevant of the 700+ references in the IDS. PO cannot excuse its omission by suggesting the Examiner should have recalled Hu '965 from the parent prosecution.

Reliance on Huang in the Child Application Confirms Error. In examining the child '322 Application, the Examiner described Huang as teaching an eccentric drive mechanism with the motor and bearing on opposite sides of the reciprocating path that could be substituted for another reciprocating movement mechanism; these teachings are material to at least Challenged Claims 2, 4, and 18.

(Ex-1014, pp.291-92); *see Western Digital Techs., Inc. v. Godo Kaisha IP Bridge 1*, IPR2025-00701, Paper 9, *2 (Aug. 14, 2025) (finding material error where allowable subject matter from challenged patent was rejected in child application).

The Examiner Erred by Focusing on Lee. The Examiner cited only Lee to reject claim 1, incorrectly focusing on Lee being an "adjustable massager" having an "adjustable output shaft." (Ex-1003, pp.310, 315, 317). The Examiner erred by not applying a non-adjustable reference to reject claim 1, including Pepe, and further erred by failing to appreciate that angled handles are a known, obvious ergonomic improvement to handheld devices. (Pet., pp.54-58); *see Harbor Freight Tools USA Inc. v. Champion Power Equip., Inc.*, IPR2025-00805, Paper 20, *3 (Sept. 19, 2025) (finding material error where "the Office cited Tsuda against a parent application … [but] failed to cite Tsuda for a similar limitation in the challenged patent").

Hypervolt. PO's argument rests on a YouTube video that lacks the detail of the Petition's expert disassembly and analysis of a physical Hypervolt. (Pet., pp.118-31). Further, PO does not dispute the Hypervolt's teachings. (POPR, pp.43-48).

Uncontested Teachings. PO does not dispute that the cited teachings of Hu '951 and Marton were *never disputed* during prosecution. Moreover, Hu '951 and Marton are only cited as secondary references for their straightforward teachings. *See Grimco, Inc. v. Principal Lighting Group, LLC*, IPR2021-00968, Paper 13, *20 (Nov. 22, 2021) (previously-cited art merely used "in a minor capacity").

Dated: September 16, 2026

Respectfully submitted,

/Kyle W. Kellar/

Kyle W. Kellar (Reg. No. 71,165)
Kyle.Kellar@wbd-us.com
WOMBLE BOND DICKINSON (US) LLP
655 N. Central Ave., Suite 2300
Glendale, CA 91203-1445

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above document was served on September 16, 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.

Richard D. Coller III
Melissa A. Haapala
Joseph K. Venier
STERNE, KESSLER, GOLDSTEIN & FOX PLLC

rcoller-PTAB@sternekessler.com
mhaapala-PTAB@sternekessler.com
jvenier-PTAB@sternekessler.com
PTAB@sternekessler.com

Attorneys for Patent Owner

Dated: September 16, 2026

/Kyle W. Kellar/
Kyle W. Kellar