

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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THERABODY, INC.,

Petitioner

v.

DATAFEEL INC.,

Patent Owner.

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Case No.: PGR2025-00026

U.S. Patent No. 12,036,174

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**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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## EXHIBIT LIST

Exhibit No.	Description
2001	Minutes of Scheduling Conference entered December 20, 2024, in case 8:24-cv-02034-JWH-DFM
2002	Defendant Therabody, Inc's Disclosure of Invalidity Contentions, served March 7, 2025.
2003	Lex Machina Motion Metrics Report, District Judge John William Holcomb (generated May 27, 2025)
2004	Lex Machina C.D. Cal. Patent Cases Report (generated May 27, 2025)
2005	Lex Machina C.D. Cal. District Judge John William Holcomb Patent Cases Report (generated May 27, 2025)

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## I. INTRODUCTION

Patent Owner DataFeel Inc. (“Patent Owner”) submits its Preliminary Response to the Petition for Post-Grant Review No. PGR2025-00026 (“Petition” or “Pet.”) filed on January 17, 2025, by Therabody, Inc. (“Petitioner”) challenging claims 1-19 of U.S. Patent No. 12,036,174 (the “Challenged Claims”). Ex. 1001 (the “’174 Patent”).<sup>1</sup>

Patent Owner respectfully submits that the Board should exercise its discretion and deny institution under 35 U.S.C. § 324 in light of the advanced stage of the underlying district court litigation.<sup>2</sup>

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<sup>1</sup> The Board extended the due date for filing Patent Owner’s brief for discretionary denial to one month from the date of the April 24, 2025, Notice Extending Deadline for Discretionary Briefing. The one-month deadline from April 24, 2025, falls on a Saturday and Monday May 26, 2025, is a Federal Holiday. In accordance with 37 C.F.R. § 1.7, the due date for the present brief is Tuesday May 27, 2025.

<sup>2</sup> As referred to herein, the “underlying district court litigation” or “underlying litigation” refers to Case No. 8:24-cv-02034-JWH-DFM, titled *Hyper Ice, Inc. v. Therabody, Inc.*, which along with Case No. 8:24-cv-02092-JWH-DFM was consolidated into Case No. 8:24-cv-01472-JWH-DFM, all pending in the Central District of California. *See* Ex. 2001 at p. 2. Hyperice is the sole licensee that has been granted the express, irrevocable right to, inter alia, sublicense, enforce, and defend the ’174 Patent. In the underlying district court litigation, Hyperice contends that certain Therabody products infringe the ’174 Patent. Therabody contends that it does not infringe any asserted claim, and that all asserted claims are invalid.

Conduct of the Petitioner warrants discretionary denial under the *Fintiv* framework because it reflects a deliberate strategy to divide and preserve arguments across multiple forums while avoiding commitment to any single adjudicative outcome. Of the four patents asserted in the underlying litigation, U.S. Patent Nos. 11,938,082 (“the ’082 patent”), 11,857,482 (“the ’482 patent”), 12,036,174 (“the ’174 patent”), and 12,097,161 (“the ’161 patent”), Petitioner has filed PGRs against each of the ’082, ’482, and ’174 patents, but conspicuously withheld a challenge against the ’161 patent, despite asserting invalidity defenses against each in court. This pattern evidences a tactical withholding of arguments and an effort to reserve certain defenses exclusively for the district court, undermining the efficiency goals of the AIA.

Moreover, Petitioner has refused to provide any *Sotera*-style stipulation in any of the three PGRs, making clear its intent to reassert in district court any arguments it withholds or loses here. The lack of stipulation across the various co-pending proceedings substantially weighs in favor of denial when petitioners seek dual-track litigation while avoiding estoppel consequences.

While a trial date has not yet been set, the Central District of California has an established track record of resolving cases efficiently. Indeed, the absence of a firm date does not give Petitioner license to create a staggered litigation strategy that burdens the Patent Owner and the PTAB alike. The Director has clarified that the

Board must consider “realistic trial timing” alongside other systemic factors, including *Petitioner’s litigation behavior and willingness to streamline proceedings through stipulations*.

Permitting institution here would not promote efficiency or finality would reward strategic forum manipulation. This PGR is part of a fragmented challenge pattern designed to maximize optionality and minimize estoppel, contrary to the purpose of post-grant review as an alternative, not a supplement, to district court litigation.

## **II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION**

Under the precedential guidance set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (designated precedential May 5, 2020)<sup>3</sup>, the Board considers the following factors in determining whether to institute an AIA post-grant proceeding where there is parallel district litigation:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

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<sup>3</sup> On February 28, 2025, the USPTO rescinded its June 21, 2022, memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”. *See* <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding; and
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and other circumstances that impact the Board's exercise of discretion, including the merits.

The Board should exercise its discretion and deny institution of this Post Grant Review based on a holistic consideration of the *Fintiv* factors.<sup>4</sup>

First, Petitioner has not sought a stay in the underlying litigation and the Court has not granted a stay. This omission by the Petitioner is telling, particularly given that Judge Holcomb frequently grants stay motions pending PTAB proceedings. In data available from Lex Machina, 73% of stay motions pending PTAB proceedings have been granted by Judge Holcomb. *See* Exhibit 2003, pg. 1.

Regardless of the motivations for not seeking a stay motion, which Patent Owner does not speculate, it is clear that having district court litigation and PTAB proceedings on the same issues does little to simplify the issues between the parties. Moreover, as the Petitioner elected to not file a PTAB challenge against the '161

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<sup>4</sup> Petitioner declined to address the *Fintiv* factors in its Petition. *See* Pet. at 92.

patent, Patent Owner maintains that a stay of the present district court proceedings, if sought, should be denied.

Accordingly, the first factor favors denial.

Second, the trial date in the district court action in the Central District of California will likely occur before the Board's projected statutory deadline for a final written decision. The claim construction hearing is scheduled for July 29, 2025. *See* Ex. 2001 at p. 2. Judge Holcomb's standing practice is to issue a trial scheduling order after the claim construction process is completed. *See* Ex. 2001 at p. 2. For example, in *Gene Pool Technologies, Inc. v. Costal Harvest, LLC*, Case No. 5:21-cv-01328-JWH-SHK, Judge Holcomb issued a claim construction order on October 23, 2022 (Dkt. 87) and then, one month later, on November 23, 2022, issued a civil trial scheduling order (Dkt. 94) scheduling trial. Patent Owner anticipates that the trial date will be set for mid-2026. A mid 2026 trial date would be consistent with Judge Holcomb's trial timelines in patent cases. In fact, using data from Lex Machina, Patent Owner identified only one patent case that has proceeded to trial in Judge Holcomb's court. *See Pavemetrics Systems, Inc. v. Tetra Tech, Inc.*, Case No. 2:21-cv-01289-MCS-MAA (receiving a jury verdict on August 24, 2022, 559 days after the February 11, 2021, complaint).

Moreover, the scheduled date of the claim construction hearing shows that the district court action is progressing faster than a typical action in the Central District

of California, supporting a likelihood that the trial date will occur even sooner than expected.<sup>5</sup>

The projected statutory deadline for a final written decision in this matter, if instituted, is August 2026. As such, the anticipated trial date will predate any final written decision in this matter, favoring denial based on the second factor.

Third, the parties have made a substantial investment in the underlying litigation. Patent Owner initiated the district court litigation in September 2024. Since that time, the parties have engaged in extensive pleading practice, prepared and served infringement contentions and invalidity contentions, reviewed and produced documents, and prepared additional documents for production. In addition, the parties have exchanged proposed terms for claim construction, and have exchanged preliminary claim constructions and extrinsic evidence. This substantial and ongoing investment by both the parties and the Court favors denial based on the third factor.

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<sup>5</sup> The scheduled date of the claim construction hearing, July 29, 2025, is 313 days after the filing of the district court action on September 19, 2024. The median number of days from filing to a claim construction hearing in C.D. Cal. is 367 days, which is an increase in trial progression speed by up to 15%. *See* Ex. 2004, pg. 3. What is more, the median number of days from filing to a claim construction hearing in the Central District of California *specific to Judge Holcomb* is 476 dates, which is an increase in trial speed by up to 41%. *See* Ex. 2005, pg. 2.

Fourth, there is a substantial overlap between the issues raised in the Petition and in the underlying district court proceedings. In its invalidity contentions, Therabody contends that the asserted claims of the '174 Patent are invalid based on many of the same prior art references asserted in the Petition. *See* Ex. 2002 at pp. 5-65, (citing, *inter alia*, Lee, Barasch, Choi, Rhoades, and Giraud as references in various alleged obviousness combinations). In addition, Therabody contends in its invalidity contentions that claims 1-19 are invalid for lack of written description support and lack of enablement, just as Therabody does in its Petition. *Id.* at 119-123.

Additionally, Petitioner has failed to file a *Sotera* stipulation despite contending it may do so in the original PGR petition. Petitioner likewise did not file a *Sotera* stipulation after contending it may do so in the original petition in the other two related PGR proceedings.<sup>6</sup> This is despite guidance issued by the Board nearly a month ago that a *Sotera* stipulation should be filed “as soon as practicable.” *See* United States Patent and Trademark Office, *FAQs for Interim Processes for PTAB Workload Management*, USPTO (Apr. 25, 2025, last updated May 7, 2025),

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<sup>6</sup> As discussed previously herein, Petitioner filed PGR2024-00053, regarding U.S. Patent No. 11,857,482, on September 27, 2024, and PGR2025-00013, regarding U.S. Patent No. 11,938,082, on December 23, 2024.

available at <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>.

Even if Petitioner files a *Sotera* stipulation in at least one of these three PGR proceedings, Petitioner has not filed a PGR petition for a fourth related patent, U.S. Patent No. 12,097,161, a continuation application of the '174 patent presently at issue. Thus, at least one of the four related patents are likely to proceed to trial in the district court, with claim features that overlap with the claims of the '174 patent (e.g., “a plurality of energy generator elements being independently operable to convert electricity from the power source into a plurality of different energy types transmittable towards an area of skin of a user” from the '174 patent and “a plurality of energy generators being independently operable to convert electricity from the power source into a plurality of different energy types transmittable towards the skin of the user,” from the '161 patent).

Since these patents share materially similar claim scope, and are asserted in the same litigation, the risk of redundancy is acute. The Petitioner's strategy, challenging the '174 Patent while reserving the '161 Patent for district court, would force two tribunals to analyze overlapping technology, art, and arguments in parallel, wasting resources and undermining judicial economy.

Allowing the dual-track approach to address overlapping subject matter frustrates the goals of efficiency and finality. Here, the clear redundancy between the '174 and '161 patents supports discretionary denial based on the fifth factor.

Accordingly, because the *Fintiv* factors favor denial, Patent Owner respectfully requests that the Board exercise its discretion and deny institution of this Post Grant Review based on *Fintiv*.

### **III. CONCLUSION**

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution under 35 U.S.C. § 324 in light of the advanced stage of the underlying district court litigation.

Dated: May 27, 2025

Respectfully submitted,

/James P. Murphy/

James P. Murphy (Reg. No. 55,474)

POLSINELLI PC

1000 Louisiana, Suite 6400

Houston, Texas 77002

Fax: (713) 374-1601

## **CERTIFICATE OF SERVICE**

I hereby certify that the foregoing Patent Owner's Request for Discretionary Denial pursuant to 37 C.F.R. §42.207 and supporting materials (Exhibits 2001-2005) have been served in their entirety today, May 27, 2025, by electronic mail to:

Marc J. Pensabene  
[mpensabene@omm.com](mailto:mpensabene@omm.com)

Brett J. Williamson  
[bwilliamson@omm.com](mailto:bwilliamson@omm.com)

Bradley Berg  
[bmberg@omm.com](mailto:bmberg@omm.com)

Kristin Godfrey  
[kgodfrey@omm.com](mailto:kgodfrey@omm.com)

Dated: May 27, 2025

Respectfully,  
/Ericka McNeil/  
Ericka McNeil  
POLSINELLI PC  
1000 Louisiana Street, Suite 6400  
Houston, Texas 77002  
Tel: (713) 374-1600  
Fax: (713) 374-1601

## CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that this paper contains 1,894 words, excluding the portions exempted under 37 C.F.R. §42.24(a)(1), according to the word count feature of the word-processing system used to prepare this paper.

The undersigned further certifies that this paper complies with the typeface requirements of 37 C.F.R. §42.6(a)(2)(ii) and formatting requirements of 37 C.F.R. §42.6(a)(2)(iii). This paper has been prepared in 14-point, Times New Roman proportional font with normal spacing.

Dated: May 27, 2025

/Ericka McNeil/

Ericka McNeil