

1 BRETT J. WILLIAMSON (S.B. #145235)
 2 bwilliamson@omm.com
 3 CAMERON W. WESTIN (S.B. #290999)
 4 cwestin@omm.com
 5 BRADLEY M. BERG (S.B. #300856)
 6 bmberg@omm.com
 7 JASTON BURRI (S.B. #353642)
 8 jburri@omm.com
 9 MARC J. PENSABENE (admitted *pro hac vice*)
 10 mpensabene@omm.com
 11 LAURA B. GORE (admitted *pro hac vice*)
 12 lgore@omm.com
 13 GYUHYUN (JOANNE) BAE (admitted *pro hac vice*)
 14 jbae@omm.com
 15 O'MELVENY & MYERS LLP
 16 610 Newport Center Drive, Floor 17
 17 Newport Beach, CA 92660
 18 Tel.: (949) 823-6900 | Fax: (949) 823-6994

19 *Counsel for Defendant Therabody, Inc.*

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**UNITED STATES DISTRICT COURT
 CENTRAL DISTRICT OF CALIFORNIA
 SOUTHERN DIVISION**

20 HYPER ICE, INC., a California
 21 corporation and HYPERICE IP
 22 SUBCO, LLC, a Delaware limited
 23 liability company,

24 Plaintiffs,

25 v.

26 THERABODY, INC.,

27 Defendant.

Case No. 8:24-cv-00390-JWH-(DFMx)

**DEFENDANT THERABODY,
 INC.'S NOTICE OF MOTION AND
 MOTION TO STAY PENDING
 INSTITUTED POST-GRANT
 REVIEW**

Judge: Hon. John W. Holcomb
 Place: Courtroom 9D, 9th Floor
 Date: June 20, 2025
 Time: 9:00 AM PT

1 **TO PLAINTIFF AND THE CLERK OF THE COURT:**

2 **PLEASE TAKE NOTICE** that on June 20, 2025, in Courtroom 9D of the
3 above-entitled Court located at the Ronald Reagan Federal Building Federal Building
4 and United States Courthouse, 411 W. 4th Street, Santa Ana, California 92701-4516,
5 Therabody, Inc. will and hereby does move this Court for an Order staying this case
6 pending the completion of instituted post-grant review proceedings in PGR2024-
7 00053.

8 The Motion is based on this Notice, the attached Memorandum of Points and
9 Authorities, the Declaration of Cameron Westin in support thereof, the files and
10 records herein, and such further evidence as may be received by the Court.

11
12 Dated: May 12, 2025

Respectfully submitted,
O'MELVENY & MYERS, LLP

13
14 /s/ Brett J. Williamson

BRETT J. WILLIAMSON (S.B. #145235)

bwilliamson@omm.com

15 CAMERON W. WESTIN (S.B. #290999)

cwestin@omm.com

16 BRADLEY M. BERG (S.B. #300856)

bmberg@omm.com

17 JASTON BURRI (S.B. #353642)

jburri@omm.com

18 MARC J. PENSABENE (admitted *pro hac vice*)

mpensabene@omm.com

19 LAURA B. GORE (admitted *pro hac vice*)

lgore@omm.com

20 GYUHYUN (JOANNE) BAE (admitted *pro hac*
21 *vice*)

jbae@omm.com

22 O'MELVENY & MYERS LLP

23 610 Newport Center Drive, Floor 17

24 Newport Beach, CA 92660

25 Tel.: (949) 823-6900 | Fax: (949) 823-6994

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27
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1 **I. INTRODUCTION**

2 Therabody respectfully requests that this case be stayed pending the Patent
3 Trial and Appeal Board’s (“PTAB”) resolution of instituted Post-Grant Review
4 (“PGR”) of U.S. Patent No. 11,857,482 (“the ’482 Patent”). In the instituted
5 PGR2024-00053 (“the ’482 PGR Proceeding”), the PTAB will rule on the validity
6 of all claims that Hyperice asserts against eight of nine accused Therabody products.
7 The totality of the circumstances, and all three factors traditionally considered in this
8 District, favor a stay of this action until the ’482 PGR Proceeding is complete.

9 First, the case remains in its early stages. While the Court and the parties just
10 conducted a *Markman* hearing, discovery is not complete, the parties have not
11 conducted any party or third party depositions, no expert reports have been served,
12 no dispositive motions have been filed, and no trial date has been set.

13 Second, a stay will simplify the issues. On its own, the instituted ’482 PGR
14 Proceeding will either eliminate the questions of liability and damages for the vast
15 majority of accused products from the case, or eliminate the questions of validity for
16 one of two asserted patents. Moreover, the PTAB will decide whether to institute a
17 PGR petition challenging all asserted claims of the other patent, U.S. Patent No.
18 11,938,082 (“the ’082 Patent”), by no later than July 13, 2025. Hyperice did not
19 participate in the PTAB’s new discretionary denial process, increasing the likelihood
20 of institution. And the similarity between these patents, their claims, and the asserted
21 grounds makes institution of that petition highly likely, in which case *every* claim
22 Hyperice asserts against Therabody in this case will be under PTAB review.

23 Third, a stay would not unduly prejudice Hyperice. While Therabody and
24 Hyperice are competitors, Hyperice has shown no particular urgency in reaching a
25 resolution in this matter and never sought a temporary restraining order or a
26 preliminary injunction. A stay of Hyperice’s action against Therabody will allow
27 Hyperice and the Court to focus its efforts litigating the other related cases, which do
28 not involve the claims under review in the ’482 PGR Proceeding.

1 During the meet and confer process, Hyperice’s counsel took the position that
2 a stay was “premature” until the PTAB instituted PGR proceedings for the ’082
3 Patent. But that patent is asserted against only one Therabody product. Pressing
4 forward at this juncture with discovery, developing liability, validity, and damages
5 cases, and filing dispositive motions on all products and asserted claims in the interim
6 would be a waste of Court and party resources, regardless of whether the PTAB
7 institutes PGR proceedings for the ’082 Patent. For the reasons discussed herein,
8 Therabody respectfully requests that the Court stay Hyperice’s action against
9 Therabody pending the PTAB’s completion of the ’482 PGR Proceeding.

10 **II. FACTUAL BACKGROUND**

11 **A. Procedural History of Hyperice’s Assertions Against Therabody**

12 U.S. Patent Number 11,857,482 (“the ’482 Patent”) issued on January 2, 2024.
13 One day later, Plaintiffs Hyper Ice, Inc. and Hyperice IP Subco LLC (collectively,
14 “Hyperice”) commenced its litigation campaign by filing a complaint against
15 Defendant Therabody, Inc. (“Therabody”) in the United States District Court for the
16 District of Delaware. *See Hyper Ice, Inc. et al. v. Therabody, Inc.*, Case No. 1:24-
17 cv-00004 (the “Delaware Litigation”). The original complaint in the Delaware
18 Litigation alleged that six Therabody products infringed claim 34 of the ’482 Patent.
19 Delaware Litigation, Dkt. No. 1 at ¶¶ 12, 15. Hyperice filed an amended complaint
20 on February 16, 2024, alleging that two more Therabody products infringed claim 34
21 of the ’482 Patent. Delaware Litigation, Dkt. No. 17 ¶¶ 12, 16.

22 On February 23, 2024, Hyperice dismissed the Delaware Litigation and filed
23 a new complaint in this Court. *See* Complaint for Patent Infringement at ¶ 16, *Hyper*
24 *Ice, Inc. et al. v. Therabody, Inc.*, No. 8:24-cv-00390 (the “Consolidated Case”), ECF
25 No. 1. That complaint accused the same Therabody products from the Delaware
26 Litigation of infringing claim 34 of the ’482 Patent. *Id.* at ¶¶ 14, 19.

27 U.S. Patent No. 11,938,082 (“the ’082 Patent”) issued on March 26, 2024.
28 Nearly six months later, on September 12, 2024, Hyperice filed a First Amended

1 Complaint (the “FAC”) accusing only one product, the Theragun PRO Plus, of
2 infringing the ’082 Patent. *Hyper Ice, Inc. v. Joicom Corp.*, No. 8:24-00098, ECF
3 No. 37 at ¶¶ 11, 18, 28.

4 At the June 21, 2024, Scheduling Conference, this Court consolidated
5 Hyperice’s case against Therabody with Hyperice’s cases against other competitors,
6 including MerchSource and Bob & Brad, under the lead case *Hyper Ice Inc. et al. v.*
7 *Joicom Corp.*, Case No. 8:24-cv-00098, ECF No. 26.¹ Hyperice asserted different
8 claims from the ’482 Patent against these other defendants, for reasons discussed
9 below. *See, e.g.*, Complaint for Patent Infringement at ¶ 22, *Hyper Ice, Inc. et al. v.*
10 *Merchsource, LLC*, Case No. 8:24-cv-00410 (C.D. Cal. Feb. 27, 2024), ECF No. 1
11 (alleging that MerchSource infringes “at least Claim 1 of the ’482 Patent”);
12 Complaint for Patent Infringement at ¶ 15, *Hyper Ice, Inc. et al. v. Bob and Brad,*
13 *LLC*, Case No. 2:24-cv-03212 (C.D. Cal. Jan. 3, 2024), ECF No. 1 (alleging that Bob
14 & Brad infringes “at least Claim 1 of the ’482 Patent”).

15 Due at least in part to Hyperice’s filing strategy for its cases against
16 Therabody, this case remains in its early stages. The bulk of discovery efforts remain.
17 Therabody and Hyperice have both served and responded to written discovery in this
18 action and produced documents, but neither party has noticed or conducted any fact
19 depositions. Declaration of Cameron Westin in Support of Therabody’s Motion to
20 Stay (“Westin Decl.,” filed concurrently herewith) ¶ 3.² Expert reports have not been
21 served, expert discovery has not started, and the Court has yet to enter a scheduling
22 order with cutoffs for any type of discovery. No dispositive motions have been filed.
23 And while the Court held a *Markman* hearing two days after the PTAB instituted the
24

25 ¹ That consolidation was “for pretrial purposes through the date of the *Markman*
26 hearing,” *id.*, which occurred on April 23, 2025.

27 ² During claim construction discovery, Hyperice conducted a short deposition of
28 Therabody’s claim construction expert, Dr. Pratt, concerning an expert declaration
he submitted in support of certain claim construction positions. Westin Decl. ¶4.



1 '482 PGR Proceeding, the Court has not yet issued a final claim construction order,
 2 and no trial date has been set.

3 **B. The Asserted Claims and Accused Products**

4 On July 5, 2024, Hyperice served infringement contentions accusing eight
 5 Therabody products of infringing independent claim 34 and dependent claims 35-38,
 6 40, 41, 43-46, and 58-60 of the '482 Patent. Ex. 1.³ On September 6, 2024, Hyperice
 7 served contentions accusing the Theragun PRO Plus of infringing independent claim
 8 1 and dependent claims 2-4, 7, 9-11, and 13 of the '082 Patent. Ex. 2.

<u>Patent</u>	<u>Claims Asserted Against Therabody</u>	<u>Accused Therabody Products</u>
11,857,482	34-38, 40, 41, 43-46, 58-60	Theragun Pro, Elite, Mini, Prime, Relief, and Sense. TheraFace Pro and Pro LED.
11,938,082	1-4, 7, 9-11, 13	Theragun PRO Plus.

13 The reason that the vast majority of Therabody’s accused products are only
 14 accused of infringing one independent claim of the '482 Patent—claim 34—has to
 15 do with how the products connect the massage attachments. The eight Therabody
 16 products accused of infringing the '482 Patent include a piston that inserts into an
 17 opening in the massage attachment, as shown in the images below.

Connector for Theragun Pro, Elite, Mini, Prime, Relief, and Sense	Connector for TheraFace Pro and Pro LED
	

28 ³ All citations to “Ex. ___” refer to Exhibits to the Westin Decl.

1 Independent claim 34 of the '482 Patent is the only independent claim in either
2 the '482 or '082 Patent that allows for such a configuration, i.e., a “first massaging
3 head [that] has a substantially cylindrical pocket to receive the quick release
4 connector.” '482 Patent, 11:64–12:14. The other claims of the '482 Patent, which
5 Hyperice has not asserted against Therabody, all require an arrangement with a bore
6 in the piston, not a pocket in the attachment. *See* '482 Patent, claims 1, 32.

7 Therabody’s PRO Plus, on the other hand, includes a threaded extension on
8 the massage head attachment that is screwed into a slot in the PRO Plus’s piston, as
9 shown below. Hyperice accuses the PRO Plus of infringing independent claim 1 of
10 the '082 Patent, which recites “the distal end of the piston having a bore,” and “a
11 quick-connect system” where “the proximal end of the first massaging head [is]
12 inserted into or removed from the bore.” '082 Patent, 9:64–10:11.



23 **C. Therabody’s PGR Petitions**

24 Therabody filed PGR petitions challenging all claims asserted against
25 Therabody from both patents, asserting similar grounds in each. That is because the
26 '482 and '082 Patents are related, share an identical specification and figures, and
27 claim largely overlapping subject matter. As discussed below, the similarity of the
28 claims and grounds, and the PTAB’s Institution Decision siding with Therabody on

1 all prior art invalidity grounds for the '482 PGR Petition, shows that it is highly likely
2 the '082 PGR Petition will be instituted as well.

3 **1. The Instituted '482 PGR Proceedings**

4 On September 27, 2024, Therabody filed a petition in Case No. PGR2024-
5 00053, requesting PGR of claims 34-38, 40, 41, 43-46, and 58-60 of the '482 Patent,
6 i.e., all of the claims Hyperice asserts against eight of nine products in this litigation.
7 Ex. 3 (“the '482 PGR Petition”). The petition, supported by expert testimony from
8 Dr. John Pratt, argued that the claims were invalid for lack of written description
9 support, indefiniteness, and obviousness based on prior art references. *Id.* at 4-5.

10 The prior art grounds argued that claim 34 was invalid as obvious over U.S.
11 Patent No. 4,513,737 (“Mabuchi”), and over U.S. Patent No. 6,682,496 (“Pivaroff”)
12 in view of Mabuchi.⁴ *Id.* at 33-42. Mabuchi disclosed not only a remarkably similar
13 percussive device to the one disclosed in the '482 Patent, but also a nearly identical
14 connector using magnets to allow the attachment to be quickly secured and released.
15 *See, e.g., id.* at 37-39 (discussing how Mabuchi teaches the claimed “quick release
16 connector” of claim 34), 76 (comparing Mabuchi’s figures to those of the '482
17 Patent). A claim chart that Dr. Pratt submitted with the PGR petition, comparing the
18 Mabuchi prior art to the asserted claims, is attached hereto as Exhibit 4.

19 Therabody’s '482 PGR Petition also asserted that Pivaroff in view of Mabuchi
20 rendered the asserted claims invalid as obvious. Ex. 3 at 58-63. The petition noted
21 that while Pivaroff had been discussed during the original prosecution of the '482
22 Patent, the only element of claim 34 (and most of the dependent claims) found to be
23 lacking in Pivaroff was the claimed “quick release connector.” *See id.* at 33. That
24 was because the only “connecting means” Pivaroff disclosed for the connector was a
25 screw thread connection. *See id.* at 32. Because Mabuchi separately taught a
26 connector that relied on magnets to connect the attachments, Therabody’s petition

27 _____
28 ⁴ A third prior art reference, U.S. Patent No. 6,432,072 (“Harris”), was only relied on
to challenge certain dependent claims as obvious. *Id.*

1 asserted that Pivaroff in view of Mabuchi’s teachings also rendered claim 34 and its
2 dependent claims obvious. *Id.* at 62-63. Dr. Pratt’s claim chart comparing the
3 Pivaroff/Mabuchi combination to the asserted claims is attached hereto as Exhibit 5.

4 Hyperice filed a Patent Owner Preliminary Response (“POPR”) on January 30,
5 2025. Ex. 6. In its POPR, Hyperice argued that both Mabuchi and the
6 Pivaroff/Mabuchi combination could not teach a “quick release connector . . .
7 configured to secure a first massaging head while the piston reciprocates a
8 predetermined stroke length at the first speed.” *Id.* at 55. Hyperice’s contention was
9 that a “space guide” disclosed in another figure in Mabuchi would prevent securing
10 a massaging head while the piston reciprocates. *Id.* at 53-55. Hyperice also
11 contended that it would not have been possible to combine Mabuchi’s teachings with
12 Pivaroff’s device. *Id.* at 60-62. Notably, besides arguing that the “space guide”
13 prevented Mabuchi from teaching the claimed “quick release connector,” Hyperice
14 did not dispute that any other claim elements (from claim 34 or the dependent claims)
15 were present in the prior art. Hyperice also argued that the Board should exercise
16 discretionary denial because the prior art references were submitted to the Patent
17 Office during the original prosecution of the ’482 Patent, and because “the trial date
18 in [this] district court action will likely occur very close in time to the Board’s
19 projected statutory deadline for a final written decision.” *Id.* at 18-36, 62-65.

20 The PTAB agreed with Therabody, instituting PGR proceedings for the ’482
21 Patent after determining that it was “more likely than not” that Therabody “would
22 prevail in establishing unpatentability of at least one of claims 34-38, 40, 41, 43-46,
23 and 58-60 of the ’482 Patent.” ECF No. 68-01 at 2. In particular, the Board found
24 that “***the obviousness ground over the Mabuchi reference is very strong.***” *Id.* at 13-
25 14 (emphasis added). It expressly rejected Hyperice’s “space guide” argument. *Id.*
26 at 35-36. And for every single prior art argument, the Board agreed with Therabody’s
27 position, and rejected Hyperice’s. *Id.* at 35 (“On the current record, we find Patent
28 Owner’s arguments unpersuasive.”); 39 (same); 41 (same); 43 (same).

1 The PTAB also rejected Hyperice’s arguments for discretionary denial of the
2 ’482 PGR petition. Dismissing Hyperice’s arguments that the PTAB should not
3 reconsider prior art that was of record during the original prosecution of the ’482
4 Patent, the Board agreed with Therabody “that the Examiner did not identify the
5 pertinence of Mabuchi’s disclosure and did not issue a rejection based on such
6 disclosure or combined teachings, and that *this constitutes Examiner error.*” *Id.* at
7 10 (emphasis added). And in rejecting Hyperice’s argument to defer to the
8 proceedings in this Court, the Board found that “[t]here is no indication that the trial
9 will be completed prior to a PTAB Final Written Decision.” *Id.* at 12.

10 **2. The ’082 PGR Petition**

11 On December 23, 2024, Therabody filed a petition in Case No. PGR2025-
12 00013, requesting post grant review of claims 1-18 of the ’082 Patent. Ex. 7 (“the
13 ’082 PGR Petition”). The petition, again supported by expert testimony from Dr.
14 Pratt, argued that the claims were invalid for lack of written description support, that
15 certain dependent claims were invalid for indefiniteness, and that Claims 1-4, 7, 9-
16 11, and 13 (i.e., all of the claims asserted against Therabody) were obvious based on
17 prior art references. *Id.* at 4.

18 The prior art grounds asserted in Therabody’s ’082 PGR Petition echo those
19 already instituted in the ’482 PGR Petition, while accounting for the ’082 Patent’s
20 claims’ requirement that “a quick-connect system” has a “proximal end of the first
21 massaging head inserted into or removed from the bore” in the piston. Accordingly,
22 the first asserted ground relies on a combination of Mabuchi with U.S. Published
23 Patent App. No. 2007/0150004 (“Colloca”), which teaches a percussive massage
24 device with a “proximal end of the first massaging head inserted into or removed
25 from” a bore in the piston. *Id.* at 34-44. Dr. Pratt’s claim chart comparing the
26 Mabuchi/Colloca combination to the asserted claims is attached hereto as Exhibit 8.

27 Similarly, the second asserted ground relies on a combination of Pivaroff,
28 which already discloses a bore in the piston, with a simple bar magnet connector

1 disclosed in U.S. Patent No. 3,007,504 (“Clark”) that allows a “magnetic tool adapted
2 to receive, interchangeably, a plurality of tool endings . . . while the same are
3 magnetically held in contact with the tool.” *Id.* at 55-65. In other words, replacing
4 the threaded connector in Pivaroff with Clark’s magnetic connector provides the
5 same solution disclosed and claimed by the ’082 Patent. *Id.* at 63-64. Dr. Pratt’s
6 claim chart comparing the Pivaroff/Clark combination to the asserted claims is
7 attached hereto as Exhibit 9.

8 Hyperice filed a POPR to Therabody’s ’082 PGR Petition on April 11, 2025,
9 ten days *before* the PTAB issued its Institution Decision in the ’482 PGR Proceeding.
10 Ex. 10. Given that timing and the overlap in claimed subject matter and asserted
11 grounds, it is not surprising that Hyperice’s POPR in the ’082 PGR petition relies on
12 arguments that the PTAB subsequently rejected when instituting the ’482 PGR
13 Proceeding. For example, Hyperice again argued that the “space guide” in another
14 embodiment of Mabuchi would prevent securing a massaging head while the piston
15 reciprocates. *Id.* at 52-53. Hyperice argued that Mabuchi is not a “percussive
16 massager” at all, *id.* at 44-45, contrary to the ’482 PGR Proceeding’s Institution
17 Decision that found Mabuchi to be a “very strong” prior art reference for percussive
18 massage device claims, ECF No. 68-01 at 13-14.⁵

19 Importantly, Hyperice elected to not participate in the PTAB’s newly
20 established discretionary denial process for the ’082 PGR Petition, in which Hyperice
21 would have had the opportunity to file a separate brief addressing why the petition
22 should not be instituted because the prior art was considered during the original
23 prosecution, or because the PTAB should defer to the proceedings in this Court. *See*
24 Ex. 11. That led the PTAB to refer the substantive challenge to a merits panel to *only*
25 consider the “non-discretionary” merits of the ’082 PGR Petition. *Id.*

26 Those merits are overwhelmingly strong. The overlap in claim scope and prior

27 _____
28 ⁵ Hyperice also voluntarily disclaimed one of the ’082 Patent’s claims rather than
having it subjected to PTAB review. Ex. 10 at 33-34.

1 art grounds, Hyperice’s repetition of already-rejected substantive arguments against
2 institution, and Hyperice’s choice to forego discretionary denial arguments
3 demonstrate a high likelihood that the ’082 PGR Petition will be instituted as well.

4 **III. LEGAL STANDARD**

5 In addition to having the inherent power to manage their dockets and stay
6 proceedings, Courts in this District often grant stays in light of the “liberal policy in
7 favor of granting motions to stay proceedings pending the outcome of [post grant
8 proceedings], especially in cases that are still in the initial stages of litigation and
9 where there has been little or no discovery.” *Limestone v. Micron Tech.*, No. SACV
10 15-0278-DOC (RNBx), 2016 WL 3598109, at *2 (C.D. Cal. Jan. 12, 2016) (quoting
11 *Aten Int’l Co., Ltd. v. Emine Tech. Co., Ltd.*, No. SACV 09-0843 AG (MLGx), 2010
12 WL 1462110, at *6 (C.D. Cal. Apr. 12, 2010)).

13 To determine whether to stay a case pending post grant proceedings, courts in
14 this District consider three factors: “(1) whether discovery is complete and whether
15 a trial date has been set; (2) whether a stay will simplify the issues in question and
16 trial of the case; and (3) whether a stay would unduly prejudice or present a clear
17 tactical disadvantage to the nonmoving party.” *Universal Elecs., Inc. v. Universal*
18 *Remote Control, Inc.*, 943 F. Supp. 2d 1028, 1030–31 (C.D. Cal. 2013) (quoting *Aten*
19 *Int’l*, 2010 WL 1462110, at *6). Ultimately, “the totality of the circumstances
20 governs.” *Limestone*, 2016 WL 3598109, at *2 (internal citations omitted).

21 **IV. THIS ACTION SHOULD BE STAYED PENDING RESOLUTION OF**
22 **THE INSTITUTED PGR PROCEEDINGS**

23 **A. Factor 1: The Early Stage of the Case Strongly Favor a Stay.**

24 The stage of litigation is measured at the time of filing of a motion to stay.
25 *VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1316 (Fed. Cir. 2014). In
26 determining whether the first factor favors a stay, Courts in this District consider “the
27 progress of discovery, the status of claim construction, and whether a trial date has
28 been set.” *Polaris PowerLED Techs., LLC v. LG Elecs., Inc.*, No. SACV 20-00125-

1 JVS (DFMx), 2020 WL 6064964, at *2 (C.D. Cal. Aug. 26, 2020). When “‘there is
2 more work ahead of the parties and the Court than behind,’ this factors weighs in
3 favor of granting a stay.” *Id.* at *2 (quoting *Tierravision, Inc. v. Google, Inc.*, No.
4 11-CV-2170 DMS (BGS), 2012 WL 559993, at *2 (S.D. Cal. Feb. 21, 2012)).⁶

5 Here, discovery is in its early stages, and far more work lies ahead than behind.
6 While Therabody and Hyperice have exchanged some documents and written
7 discovery, the parties have not undertaken fact depositions or expert reports, other
8 than in connection with claim construction. This case is in a similar posture to
9 Entropic Communications’ action against Comcast before this Court in *Entropic*
10 *Commc’ns, LLC v. Cox Commc’ns, Inc.*, No. 2:23-cv-1049, ECF No. 366 (C.D. Cal.
11 Feb. 12, 2025) (hereinafter “*Entropic v. Cox*,” attached as Ex. 12). There, the parties
12 had exchanged documents, but had not taken any depositions nor started expert
13 discovery. *Id.* at 5. Discovery was not complete, and no trial date had been set. *Id.*
14 The Court had already conducted a claim construction hearing, but had not yet issued
15 its claim construction order. *Id.* The Court noted that “courts in this district often
16 find cases in the early stages despite significant claim construction progress.” *Id.* at
17 6 (citing *RJ Tech. LLC v. Apple Inc.*, No. 8:22-cv-01874-JVS (JDEx), 2023 WL
18 8188475, at *2 (C.D. Cal. Oct. 4, 2023)). Because “the Court and parties ha[d]
19 significant substantive work ahead, including completing discovery, potentially
20 adjudicating summary judgment motions, and conducting trial,” this factor weighed
21 in favor of a stay. *Id.* See also *Entropic Commc’ns, LLC v. DISH Network Corp.*,
22 No. 2:23-cv-01043-JWH-KES, 2025 WL 519639, at *3 (C.D. Cal. Feb. 13, 2025)
23 (discovery was in its early stages where “the parties have not taken any depositions
24 nor undertaken expert discovery for issues other than claim construction”).

25
26 ⁶ See also *Purecircle USA Inc. v. SweeGen, Inc.*, No. SACV 18-1679 JVS (JDEx),
27 2019 WL 3220021, at *2 (C.D. Cal. June 3, 2019) (same); *Semiconductor Energy*
28 *Lab. Co. Ltd. v. Chimei Innolux Corp.*, No. SACV 12-21-JST (JPRx), 2012 WL
7170593, at *2 (C.D. Cal. Dec. 19, 2012) (same).

1 Because this case is in its early stages, this factor strongly supports a stay.

2 **B. Factor 2: A Stay Will Simplify the Issues in This Case.**

3 “There is a near uniform line of authority reflecting the principle that after the
4 PTAB has instituted review proceedings, the parallel district court litigation
5 ordinarily should be stayed.” *Versata Software, Inc. v. Configit A/S*, No. LA CV 20-
6 09019 JAK (MRWx), 2022 WL 3598158, at *3 (C.D. Cal. Apr. 27, 2022) (internal
7 citations omitted). As another Court in this District summarized, PTAB review of
8 all asserted claims from a patent will significantly narrow the issues in the case:

9 If the PTAB cancels all of the asserted claims, this action will be
10 rendered moot. If the PTAB cancels or narrows a portion of the asserted
11 claims, the scope of this litigation may be significantly reduced. Even
12 if no patent claim is eliminated, the intrinsic record developed during
13 the IPR may inform on issues like claim construction. In addition,
14 Fujitsu would be estopped under 35 U.S.C. § 315(e)(2) from raising in
this litigation, arguments which were raised, or reasonably could have
been raised, in the IPR.

15 *Core Optical Techs., LLC v. Fujitsu Network Commc’ns, Inc.*, No. SACV 16-00437-
16 AG-JPRx, 2016 WL 7507760, at *2 (C.D. Cal. Sept. 12, 2016) (Guilford, J.).

17 The simplification in the *Entropic v. Cox* case, where this Court found that this
18 factor favored a stay, is also illustrative. In the *Entropic* case, the PTAB instituted
19 review of seven out of ten asserted patents, but denied institution as to another, while
20 two other patents had not been challenged at the PTAB. Ex. 12 at 3-4. The Court
21 nonetheless found that this factor weighed in favor of a stay because the “scope of
22 that review far outweighs the claims that the PTAB will not address,” and if “the
23 PTAB invalidates any challenged patent claim, some simplification is guaranteed.”
24 *Id.* at 7-8. The Court also stayed proceedings against Comcast’s co-defendant, which
25 had not filed its own IPR petitions, on the condition that the co-defendant agree to be
26 bound by the estoppel provisions of the IPR proceedings. *Id.*

27 The simplification factor weighs strongly in favor of a stay here. With the
28 ’482 PGR Proceeding now instituted, the most likely outcome is the cancellation of

1 all asserted claims against eight of the nine accused products in this case. The most
2 recent statistics from the U.S. Patent and Trademark Office indicate that the petitioner
3 succeeded in invalidating *all* challenged claims in 63% (116 out of 185) of cases
4 reaching a Final Written Decision, and invalidating at least some of the challenged
5 claims in 82% (152 out of 185) of such cases. Ex. 13 (PTAB Trial Statistics, FY 25
6 Q2 Outcome Roundup) at 11. If any claims survive, Therabody will be estopped
7 from raising invalidity grounds in this action that were raised or reasonably could
8 have been raised in the PGR proceedings. See 35 U.S.C. § 325(e)(2). Thus,
9 regardless of the outcome of the PGR, the issues in this case will be simplified by
10 allowing the '482 PGR Proceeding to unfold.

11 While the '082 Patent is not yet under PTAB review, the overlap in claim scope
12 and prior art grounds demonstrate there is a high likelihood that the '082 PGR
13 Petition will be instituted by July 2025. Moreover, Hyperice decided to forego
14 discretionary denial briefing at the PTAB, meaning that even if this case moves
15 forward and a trial date is set, the PTAB will not consider whether its proceeding
16 would duplicate efforts in this Court. Ex. 11.

17 Finally, because the '482 PGR Proceeding involves claims *only* asserted
18 against Therabody, there is no need to stay Hyperice's cases against its other
19 competitors, including Bob & Brad and MerchSource. The '482 Patent claims
20 asserted against those defendants are not under review. If the '082 PGR Petition is
21 instituted, the Court and the other related parties can at that time consider whether a
22 stay of those cases is merited, despite the '482 Patent claims against those defendants
23 not being under any PTAB review.

24 Because completion of the instituted '482 PGR Proceedings is assured to
25 greatly simplify the issues in the case, this factor thus strongly favors a stay.

26 **C. Factor 3: A Stay Will Not Unduly Prejudice Hyperice**

27 When considering this factor, courts consider: "(1) the timing of the petition
28 for review; (2) the timing of the request for the stay; (3) the status of the review

1 proceedings; and (4) the relationship of the parties.” *TeleSign Corp. v. Twilio, Inc.*,
2 No. CV 15-3240 PSG, 2016 WL 6821111, at *4 (C.D. Cal. Mar. 9, 2016) (internal
3 quotations omitted). While “any delay may be prejudicial to a party filing a claim
4 for patent infringement,” courts in this District require plaintiffs to show a “unique
5 prejudice beyond what any plaintiff necessarily experiences when its suit is stayed
6 pending IPR.” *Wonderland Nursery Goods Co. v. Baby Trend, Inc.*, No. EDCV 14-
7 01153-VAP (SPx), 2015 WL 1809309, at *4 (C.D. Cal. Apr. 20, 2015); *see also*
8 *PersonalWeb Techs., LLC v. Apple Inc.*, 69 F. Supp. 3d 1022, 1029 (N.D. Cal. 2014)
9 (“Courts have repeatedly found no undue prejudice unless the patentee makes a
10 specific showing of prejudice beyond the delay necessarily inherent in any stay.”).

11 Here, Hyperice cannot claim any prejudice from the timing of Therabody’s
12 PGR petitions or its request for a stay. Therabody diligently filed its ’482 and ’082
13 PGR Petitions well within the statutory limits, and within three and four months,
14 respectively, of Hyperice serving infringement contentions that identified what
15 claims would be at issue in the litigation. *See Core Optical*, 2016 WL 7507760, at
16 *3 (finding no “dilatory motive” where defendant filed its IPR petition within three
17 months of receiving plaintiff’s infringement contentions). Therabody also diligently
18 requested a stay, first notifying the Court of the PTAB’s Institution Decision one day
19 after it issued, Dkt. 68, and then informing the Court of its intention to move for a
20 stay at the *Markman* hearing the next day. After following this District’s Local Rule
21 7-3 meet and confer process, Therabody now files this motion to stay within three
22 weeks of the PTAB’s Institution Decision.

23 Hyperice also cannot claim any prejudice due to the current status of the
24 petitions or this action. The ’482 PGR Proceeding is already instituted, and thus
25 litigating its claims under that patent in two parallel venues would be wasteful to
26 Hyperice, just as it would be to this Court and to Therabody. While the PTAB has
27 not yet instituted the ’082 PGR Petition, it was Hyperice that *voluntarily waived* its
28 right to argue to the PTAB that adjudication of the validity of the ’082 Patent should

1 proceed in this Court instead. *See* Ex. 11.

2 Finally, while Therabody and Hyperice are competitors, that alone does not
3 establish undue prejudice from a stay. Rather, this consideration “focuses on the
4 patentee’s need for an expeditious resolution of its claim.” *VirtualAgility*, 759 F.3d
5 at 1318. In its case against Therabody, Hyperice’s actions demonstrate that it has no
6 interest in expeditiously resolving its patent case against Therabody. After initially
7 filing the action based on the ’482 Patent in the District of Delaware, Hyperice
8 voluntarily dismissed it six weeks later, then refiled it in this Court. After the ’082
9 Patent issued in March 2024, Hyperice waited nearly six months before moving to
10 amend its complaint to add the ’082 Patent in this case.

11 And in the sixteen months that Hyperice has been pursuing its patent
12 infringement claims against Therabody, it never sought a temporary restraining order
13 or preliminary injunction. Courts in this District regularly find that plaintiffs failing
14 to do so are adequately compensated by monetary relief and not unduly prejudiced
15 by a stay. *See Nichia Corp. v. Vizio, Inc.*, No. SACV 16-00545 SJO (MRWx), 2017
16 WL 3485767, at *6 (C.D. Cal. Feb. 2, 2017) (“The fact that Nichia has not sought a
17 preliminary injunction suggests that it considers monetary damages to be adequate.”);
18 *Autoalert, Inc. v. Dominion Dealer Sols., LLC*, No. SACV 12-1661-JST (JPRx), 2013
19 WL 8014977, at *3 (C.D. Cal. May 22, 2013) (“Plaintiff’s failure to file for a
20 preliminary injunction in the seven months since it filed its Complaint further
21 suggests that monetary damages will adequately compensate Plaintiff.”).

22 Because Hyperice will not be unduly prejudiced, this factor also strongly
23 favors staying the case.

24 **V. CONCLUSION**

25 Therabody respectfully requests that the Court grant its motion to stay pending
26 resolution of the instituted ’482 PGR Proceeding.

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Dated: May 12, 2025

Respectfully submitted,
O'MELVENY & MYERS, LLP

/s/ Brett J. Williamson
BRETT J. WILLIAMSON (S.B. #145235)
bwilliamson@omm.com
CAMERON W. WESTIN (S.B. #290999)
cwestin@omm.com
BRADLEY M. BERG (S.B. #300856)
bmberg@omm.com
JASTON BURRI (S.B. #353642)
jburri@omm.com
MARC J. PENSABENE (admitted *pro hac vice*)
mpensabene@omm.com
LAURA B. GORE (admitted *pro hac vice*)
lgore@omm.com
GYUHYUN (JOANNE) BAE (admitted *pro hac vice*)
jbae@omm.com
O'MELVENY & MYERS LLP
610 Newport Center Drive, Floor 17
Newport Beach, CA 92660
Tel.: (949) 823-6900 | Fax: (949) 823-6994

CERTIFICATION OF CONFERENCE

This motion is made following the conference of counsel pursuant to L.R. 7-3 which took place on May 2, 2025.

By: /s/ Cameron W. Westin
Cameron W. Westin