

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ICON HEALTH & FITNESS, INC.,  
Petitioner,

v.

NAUTILUS, INC.,  
Patent Owner.

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Case IPR2017-00495  
Patent 8,323,155 B2

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Before BARRY L. GROSSMAN, BART A. GERSTENBLITH, and  
ROBERT L. KINDER, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION  
Denying Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71*

## I. INTRODUCTION

ICON Health & Fitness, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 10, “Req. Reh’g”) of our Decision Denying Institution of *Inter Partes* Review (Paper 9, “Decision” or “Dec.”), dated July 6, 2017. The Petition raised four grounds challenging claims 1–16 of U.S. Patent No. 8,323,155 B2 (“the ’155 patent”). We determined that Petitioner had not established a reasonable likelihood that it would prevail in showing the unpatentability of the claims based on any of the challenges. Dec. 2, 29.

In particular, we determined that Petitioner had not shown a reasonable likelihood that it would prevail in showing that one of ordinary skill in the art would have combined the teachings of Maresh-I and Maresh-II, or the teachings of Stearns and Maresh-II, in the manner proposed *and* modified those teachings to meet the cam limitations of the claims. Dec. 15–19 (discussing Petitioner’s challenge based on Maresh-I and Maresh-II), 25–28 (discussing Petitioner’s challenge based on Stearns and Maresh-II).

Petitioner contends that we misapprehended or overlooked at least two reasons why one of ordinary skill in the art would have modified the teachings of Maresh-I and Stearns “to include curved force receiving members.” Req. Reh’g 6. First, that “a ‘cam effect’ . . . may be obtained by making the proposed modifications” and, second, “the *explicit teaching* in Maresh-II to modify flat force receiving members *itself* provides a reason for making a similar modification to flat force receiving members disclosed in other references.” *Id.*

For the reasons stated below, Petitioner’s rehearing request is *denied*.

## II. STANDARD OF REVIEW

Pursuant to 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, opposition, or reply. *See* 37 C.F.R. § 42.71(d).

## III. DISCUSSION

### *Obtaining a “Cam Effect”*

Petitioner contends that obtaining a cam effect was set forth in the Petition as a reason for making the proposed modifications. Req. Reh’g 7.

The Decision focused on elements 1d and 9c (*see, e.g.*, Dec. 12 n.1), which recite “right and left downward-facing cams adjacent the respective first ends of the right and left elongate stride members, the right and left downward-facing cams riding on the right and left supports, respectively” and “right and left cams adjacent respective first ends of the right and left elongate stride members, the right and left cams being variably movable across the respective right and left supports relative to the right and left crank arms rotating about the crank axis,” respectively. Ex. 1007, 1, 3. The Decision addressed Petitioner’s arguments as to why one of ordinary skill in the art allegedly would have modified Maresh-I’s slot 745 in light of Maresh-II, finding none of them sufficient. Dec. 15–19.

We recognize that the Petition included the following sentence in its discussion of grounds 1 and 3: “Additionally, a [person of ordinary skill in the art] would have recognized that by doing so, a ‘cam effect’ might be obtained.” Pet. 19 (discussing the combination of Maresh-I and Maresh-II) (citing Ex. 1004, 9:52–57, 9:60–65; Ex. 1006 ¶¶ 17, 42–50), 31 (discussing the combination of Stearns and Maresh-II) (citing Ex. 1004, 9:52–57, 9:60–65; Ex. 1006 ¶¶ 17, 75–83). To the extent that Petitioner intended achieving a cam effect to be a reason for making the proposed modifications and combination, we agree with Petitioner that we did not address expressly this argument. We did not do so because there is nothing reflected in that one sentence to convey that a cam effect is itself something desired or something of benefit that would have prompted one of ordinary skill in the art to make the modifications and combination proposed. Petitioner’s statement stands alone and unsupported. In other words, the statement suggests that, after modifications are made, a cam effect might result, but the statement never suggests why obtaining such an effect is desirable or would warrant the modifications in the first instance. The same sentence is provided in Mr. Ganaja’s declaration. *See* Ex. 1006 ¶¶ 49, 82. As with the Petition, Mr. Ganaja does not explain why achieving a cam effect would have been a reason that would have prompted one of ordinary skill in the art to undertake the modifications and combination proposed. *Id.*; *see Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017) (“In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious without identifying any

reason why a person of skill in the art would have made the combination.”  
(citation omitted)).

*Explicit Teaching in Maresh-II*

Petitioner contends that we misapprehended or overlooked that Maresh-II contains an explicit teaching that its flat force receiving members may be replaced with a force receiving member that is curved. Req. Reh’g 8. Petitioner asserts that this teaching “provides a reason for making the same modification to the flat force receiving members of the elliptical machines of Maresh-I and Stearns.” *Id.* at 9; *see id.* at 8–9 (“This **explicit teaching** not only provides a reason to modify the device disclosed by the reference, but also provides a reason to modify other devices that have the same component.”).

We did not misapprehend or overlook Maresh-II’s teaching. In fact, to the contrary, we stated the following:

We acknowledge that Maresh-II teaches the option of using alternative support member 3310, which has a curved surface, as a substitute to its overlying rack and/or force receiving member, which has a flat surface (i.e., the surface without teeth), and that the result is likely a modified shape of elliptical path. Nonetheless, Petitioner has not explained why one of ordinary skill in the art, viewing Maresh-II’s teaching, would modify one particular surface of Maresh-I’s slot 745 to modify the elliptical path. Specifically, Petitioner has not provided a reason with rational underpinning for making the modification.

Dec. 16.

Similarly, we did not misapprehend or overlook Maresh-II’s teaching in the context of Petitioner’s proposed combination with Stearns. Rather, we stated the following:

We acknowledge that Maresh-II teaches the option of using alternative support member 3310, which has a curved surface, as

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