

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NAUTILUS, INC.,
Petitioner,

v.

ICON HEALTH & FITNESS INC.,
Patent Owner.

Case IPR2017-01363
Patent 9,403,047 B2

Before GEORGE R. HOSKINS, TIMOTHY J. GOODSON, and
JAMES A. WORTH, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Petitioner filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–19 of U.S. Patent No. 9,403,047 B2 (Ex. 1001, “the ’047 patent”). Patent Owner filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”).

We instituted an *inter partes* review on all of the challenged claims and asserted grounds. See Paper 7 (“Dec. on Inst.”). After institution, Patent Owner submitted a Patent Owner Response (Paper 17, “PO Resp.”) and Petitioner submitted a Petitioner Reply (Paper 21, “Reply”). A transcript of the oral hearing is included in the record. Paper 32 (“Tr.”). There are no motions pending in this proceeding.

The table below summarizes the instituted grounds as listed in the Order section of our Decision on Institution:

Reference(s)	Basis	Claim(s)
Sleamaker ¹	§ 103	1, 11–13
Sleamaker and Hanoun ²	§ 103	2–5
Sleamaker and Six-Pak ³	§ 103	6–10
Sleamaker, Six-Pak, and Hanoun	§ 103	14–19

¹ U.S. Patent No. 5,354,251, issued Oct. 11, 1994, Ex. 1002.

² U.S. Patent Pub. No. US 2007/0232452 A1, published Oct. 4, 2007, Ex. 1003.

³ *SPT-6 Six-Pack Trainer Owner’s Manual*, Ex. 1004. The parties both refer to this reference as Six-Pak. See, e.g., Pet. 12; PO Resp. 1. That spelling is at odds with the reference itself, but to avoid confusion, we follow the parties’ convention.

Reference(s)	Basis	Claim(s)
Sleamaker and Kleinman ⁴	§ 103	13
Sleamaker, Six-Pak, Hanoun, and Kleinman	§ 103	19
Six-Pak and Ehrenfried ⁵	§ 103	1, 6–13
Six-Pak, Ehrenfried, and Hanoun	§ 103	2–5, 14–19
Six-Pak, Ehrenfried, and Kleinman	§ 103	13
Six-Pak, Ehrenfried, Hanoun, and Kleinman	§ 103	19

Dec. on Inst. 24–25.

This listing of the grounds differs in certain respects from the summary of grounds chart shown in the Petition. *See* Pet. 15–16. The reason for these differences is that, as we explained in our Decision on Institution, the summary chart in the Petition does not accurately reflect the actual arguments presented in the Petition. *See* Dec. on Inst. 18. For example, Petitioner’s summary chart indicates that the first ground challenges claims 1–5 and 11–13 based on the combination of Sleamaker and Hanoun. *See* Pet. 15. Yet Petitioner’s arguments against claim 1 and its dependent claims 11–13 cite only Sleamaker and do not cite Hanoun. *See id.* at 23–26, 31–33. Thus, the grounds listed in the Order section of the Decision on Institution reflected the challenges presented in the Petition’s actual arguments, not the summary charts or headings. *See* Dec. on Inst. 18. We noted in the Decision on Institution that we were not recasting or reformulating the Petitioner’s challenges, but simply conforming the

⁴ Int’l Pub. No. WO 2008/152627 A2, published Dec. 18, 2008, Ex. 1006.

⁵ U.S. Patent No. 5,738,611, issued Apr. 14, 1998, Ex. 1005.

grounds to the arguments actually presented in the Petition. *Id.* at 18–19. Following institution, neither party has expressed any disagreement with the statement of the grounds set forth in the Decision on Institution.

There is only one disputed issue in this proceeding: whether Petitioner has established that Six-Pak qualifies as a prior art printed publication. *See* PO Resp. 1–13; Reply 1–12; Tr. 23:3–5 (Patent Owner agreeing that the sole contested issue is the public availability of Six-Pak). That issue is discussed in Section III.C. below. The remaining aspects of Petitioner’s challenges—i.e., all grounds that do not rely on Six-Pak—are uncontested. *See* PO Resp. 1 (beginning brief by arguing that Petitioner failed to meet its burden regarding Six-Pak’s public availability and therefore “any grounds relying on that reference should be resolved in Patent Owner’s favor”); *id.* at 13 (concluding brief by requesting that “the Board find patentable the claims involved in any grounds using the Six-Pak reference”).⁶

We have authority under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision is

⁶ The scheduling order in this proceeding reminded Patent Owner that “any arguments for patentability not raised in the [Patent Owner Response] will be deemed waived.” Paper 8, 5; *see also In re NuVasive, Inc.*, 842 F.3d 1376, 1380–81 (Fed. Cir. 2016) (holding that a patentee waived an argument by presenting it only in the preliminary proceeding and not during the trial, despite the Board cautioning the patentee that arguments not briefed in the response would be deemed waived).

issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–5 and 11–13 of the '047 patent are unpatentable, but has not shown that claims 6–10 and 14–19 are unpatentable. *See* 35 U.S.C. § 316(e).

B. Related Matters

Petitioner states that the parties are engaged in litigation and in proceedings at the Board that are unrelated to the '047 patent. Pet. 2. Patent Owner does not identify any related district court or Board proceedings. Paper 3, 2.

C. The '047 Patent

The '047 patent issued on August 2, 2016, from an application filed on December 24, 2014. Ex. 1001, (45), (22). The patent claims priority to a provisional application filed on December 26, 2013. *Id.* at (60), 1:6–10.

The '047 patent describes a cable exercise machine that includes a sensor tracking the position of a flywheel incorporated into a magnetic resistance mechanism. *Id.* at 5:4–7. An energy tracker receives position information from the sensor and resistance level, and based on those inputs, can determine the amount of calories burned during a pull or over the course of a workout. *Id.* at 5:22–28. The flywheel is arranged to resist movement of four different resistance cables, and to rotate only in a single direction and only when a pull force is exerted by the user, such that the position of the flywheel represents work done as part of the workout. *Id.* at 5:29–32, 54–60.

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