

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ICON HEALTH & FITNESS, INC.,
Petitioner,

v.

NAUTILUS, INC.,
Patent Owner.

Case IPR2017-00493
Patent 7,341,542 B2

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 1–100 of U.S. Patent No. 7,341,542 B2 (“the ’542 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, 21–22.

In particular, we first construed “right means,” “left means,” “second end portion support,” “first support,” “second support,” “first member,” and “second member” as invoking § 112, ¶ 6, because none of the terms has a sufficiently definite meaning as a name for structure. Dec. 7–15. Second, with respect to independent claims 1, 46, 75, and 86, we found that Petitioner did not identify corresponding structure, material, or acts in the specification for performing each of the recited functions. *See id.* at 17–18 (discussing Maresh-I), 19–21 (discussing Stearns). With respect to independent claims 91, 94, 97, and 100, we found that even if we accepted Petitioner’s identification of the alleged corresponding structure, material, or acts, Petitioner’s analysis failed to show that the prior art structures were the same or equivalent. *Id.* at 18 (discussing Maresh-I), 20–21 (discussing Stearns). Rather, Petitioner’s analysis focused entirely on the functional language of these claim elements without identifying and addressing the corresponding structure. *Id.* at 18 (discussing Maresh-I), 20–21 (discussing Stearns).¹

¹ Petitioner incorrectly states that “the Decision found that the equivalent structure was not shown in the prior art.” Req. Reh’g 2 (citing Dec. 18).

Petitioner contends that we misapprehended or overlooked four issues: (1) even assuming that the claim term “second end portion support” is a means-plus-function limitation, dependent claims 22 and 23 recite explicit structure for the “second end portion support,” removing claims 22 and 23 from the purview of § 112, ¶ 6 (Req. Reh’g 3–7); (2) the *evidence* presented by Petitioner that “second end portion support,” “first support,” “second support,” “first member,” and “second member” are not, in fact, means-plus-function limitations, and, thus, are not subject to the claim construction requirements of § 112, ¶ 6 (*id.* at 7–11); (3) even assuming that “second end portion support” is a means-plus-function limitation, Petitioner complied with the means-plus-function rule for this claim term (*id.* at 11–13); and (4) analysis in the Petition and supporting evidence showing how the prior art includes the same or an equivalent structure that performs the same functions as the “right means,” “left means,” and “first means” (*id.* at 13–15).

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

We did not undertake an analysis to determine whether the equivalent structure was shown in the prior art because Petitioner failed to do so in the first instance: “By not identifying a corresponding structure, material, or acts in the ’542 patent specification, Petitioner does not show where that structure, material, or acts or its equivalent is disclosed by Maresh-I.” Dec. 18 (citing 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art . . . relied upon.”)).

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

Claims 22 and 23

Petitioner contends that we misapprehended or overlooked the explicit structure recited in claims 22 and 23 for the claim term “second end portion support.” Req. Reh’g 3. Petitioner asserts that even though claims 22 and 23 depend from claim 1, they recite specific structure, and, thus, do not invoke § 112, ¶ 6. *Id.* at 6.

We need not determine whether the structures recited in claims 22 and 23 remove those claims from the requirements of § 112, ¶ 6 because Petitioner did not address this matter previously in a motion, opposition, or reply. *See* 37 C.F.R. § 42.71(d). Nor, for that matter, does Petitioner contend to the contrary. *See generally* Req. Reh’g 3–7.²

Petitioner’s Alleged Evidence that “second end portion support,” “first support,” “second support,” “first member,” and “second member” Are Not Means-Plus-Function Limitations

Petitioner contends that we misapprehended or overlooked evidence presented by Petitioner that “second end portion support,” “first support,”

² This issue is not addressed in the Petition and Petitioner did not seek leave to file a reply to Patent Owner’s preliminary response on any issue raised therein. *See* 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response . . .”).

“second support,” “first member,” and “second member” are not, in fact, means-plus-function limitations. Req. Reh’g 7–11. Petitioner asserts that it presented “actual evidence” that these terms have “sufficiently definite meanings as the names for structures” because Mr. Ganaja, Petitioner’s declarant, “identified and explained examples of these structures in the *Maresh-I* and *Stearns* references.” *Id.* at 9–10 (citing Ex. 1006 ¶¶ 86, 89, 151, 153).³

We disagree. First, Petitioner again fails to identify where it addressed this issue in a motion, opposition, or reply. *See* 37 C.F.R. § 42.71(d).

Second, Mr. Ganaja did not provide testimony regarding the meaning of any of these terms. The declaration paragraphs cited by Petitioner refer to Mr. Ganaja’s opinions as to whether the references—*Maresh-I* and *Stearns*—disclose structures that he contends teach or disclose the claim limitations. *See* Ex. 1006 ¶ 86 (discussing *Maresh-I*), ¶ 89 (same), ¶ 151 (discussing *Stearns*), ¶ 153 (same). Identifying a structure in a prior art reference that allegedly teaches a claim limitation does not speak to whether that claim limitation has a sufficiently definite meaning as the name for structure. Mr. Ganaja’s analysis would be undertaken whether or not the

³ Petitioner also contends that Patent Owner failed to present any evidence to rebut the presumption that these terms do not invoke § 112, ¶ 6 because the terms do not recite the word “means.” Req. Reh’g 8. Petitioner overlooks that our Decision did not rely solely on Patent Owner’s argument. Rather, we relied on the plain and ordinary meaning of “support” and “member” (Dec. 12–15) and specifically found that in light of the intrinsic evidence (claim language and specification) and extrinsic evidence (dictionary meanings) the terms failed to convey sufficiently definite meaning as the names for structures (*id.*).

limitation invoked § 112, ¶ 6—to determine if the limitation was disclosed. In other words, Mr. Ganaja’s identification of *Maresh-I*’s “forward rocker link 730” as teaching the claimed “second end portion support” (Ex. 1006 ¶ 89), for example, does not speak to whether or not “second end portion support” has a sufficiently definite meaning as the name for structure such that it does not invoke § 112, ¶ 6.

Accordingly, we did not misapprehend or overlook evidence presented by Petitioner that these terms are not means-plus-function limitations.

Petitioner’s Alleged Compliance with the Requirements for Means-Plus-Function Claim Terms

Petitioner contends that even if “second end portion support” is a means-plus-function limitation, we misapprehended or overlooked Petitioner’s compliance with the “claim construction requirements.”⁴ Req. Reh’g 11–13. First, Petitioner points to paragraph 13 of Mr. Ganaja’s declaration arguing that Petitioner identified the specific portions of the specification that describe the structure corresponding to the claimed function. *Id.* at 12. Second, Petitioner contends that it “specified where a structure equivalent to ‘tracks’ and ‘swing arms’ is found in *Maresh-I* . . . and *Stearns*.” *Id.* at 12–13 (citing Pet. 14–15, 40; Ex. 1006 ¶¶ 89, 153).

⁴ Although Petitioner refers to the two steps as “claim construction requirements” (Req. Reh’g 11), the two-step analysis is for determining whether a means-plus-function limitation was present in the prior art. In order to perform this analysis, claim construction—including identification of the claimed function and corresponding structure found in the specification—must be completed.

We disagree. Petitioner did not do either. First, Petitioner did not identify any portion of the specification describing corresponding structure *in the Petition*. Second, there is no mention of tracks or swing arms in the discussion of Maresh-I and Stearns at pages 14, 15, and 40 of the Petition, let alone any argument that the structures identified in either reference are *equivalent*. See Pet. 14, 15, 40.

Accordingly, we did not misapprehend or overlook whether Petitioner complied with these requirements for means-plus-function claim terms; Petitioner did not.

Petitioner's Alleged Analysis and Evidence Regarding the Same or Equivalent Structures

Petitioner asserts that we misapprehended or overlooked discussion in the Petition and Mr. Ganaja's declaration showing how the prior art includes the same structure that performs the same function as the "right means," "left means," and "first means" of claims 91, 94, 97, and 100. Req. Reh'g 13. Petitioner contends that it identified crank arms 28 and 30 as well as reciprocator 126 with a pulley mounted on the rear stanchion as structures corresponding to these means-plus-function limitations. *Id.* at 14. Additionally, Petitioner argues that the Petition presented evidence to show that the crank arms of the '542 patent were the same as, or equivalent to, structures identified in each of Maresh-I (radially displaced pins of cranks 760) and Stearns (left and right rotatable connections between rollers 2023 and cranks 2020). *Id.* at 14–15.

We disagree. As we explained in our Decision, Petitioner's analysis focuses on the functional language of these claim limitations and fails to explain how the structures of Maresh-I and Stearns are the same as, or

equivalent to, those identified in the '542 patent. Dec. 18, 20–21. For example, Petitioner's discussion of Maresh-I equates the claimed "right means" and "left means"⁵ with Maresh-I's "radially displaced pins of cranks 760," but fails to make any argument explaining how these are the same or equivalent structures. *See* Pet. 13–14.

Accordingly, we did not misapprehend or overlook discussion in the Petition regarding these structures.

IV. ORDER

For the reasons explained, it is hereby ORDERED that Petitioner's request for rehearing is *denied*.

⁵ Petitioner states that it grouped the recited "right lifting-lowering member" and "left lifting-lowering member" of claim 1 with the "right means" and "left means" recited in claim 91 for convenience. Req. Reh'g 14.

IPR2017-00493
Patent 7,341,542 B2

For PETITIONER:

John Gadd
Mark Ford
Adam Smoot
MASCHOFF BRENNAN
jgadd@mabr.com
mford@mabr.com
asmoot@mabr.com

For PATENT OWNER:

Andrew Mason
John Vandenberg
Garth Winn
KLARQUIST SPARKMAN, LLP
andrew.mason@klarquist.com
john.vandenberg@klarquist.com
garth.winn@klarquist.com