



FOLEY & LARDNER LLP

ATTORNEYS AT LAW

777 EAST WISCONSIN AVENUE
MILWAUKEE, WI 53202-5306
414.271.2400 TEL
414.297.4900 FAX
WWW.FOLEY.COM

WRITER'S DIRECT LINE
414.297.5723
rmckenna@foley.com

CLIENT/MATTER NUMBER
098208-0250

June 24, 2021

VIA ELECTRONIC MAIL

Chris Jaczko
Procopio
12544 High Bluff Drive
Suite 400
San Diego, CA 92130

Re: Infringement of Woodway USA Patents
Our Ref. No. 097208-0250

Dear Mr Jaczko:

I am contacting you to follow-up on your earlier correspondence with Mr. Doug Bayerlein, President of our client, Woodway USA, Inc. regarding LifeCORE's infringement of both US Pat. Nos. 9039580 ("the '580 Patent") and 10561884 ("the '884 Patent"). We have reviewed your response to Mr. Bayerlein's demand letter, and as explained below, your arguments trying to dodge LifeCore's infringement are unpersuasive.

A. The '580 Patent

First, with respect to claim 1 of the '580 Patent, you claim the AirRunner doesn't infringe "because the shafts of the AirRunner treadmill are fixedly coupled to the frame rather than 'rotatably' coupled to the frame." The original demand letter sent by Mr. Bayerlein included a claim chart specifically identifying the structural features of the AirRunner corresponding to the relevant claim elements. This claim chart and annotated photographs specifically identified the shaft (5) as the structural feature corresponding to the "shaft rotatably coupled" element of claim 1. However, you denied infringement of claim 1 on the grounds that an entirely different element of AirRunner doesn't rotate. The fact that LifeCORE has included an additional structural element in the AirRunner which doesn't rotate, does not change the fact that the AirRunner *does* include a shaft, specifically shaft (5) (seen below) which rotates and otherwise meets all the requirements of claim 1.

Second, as you evaluate the claim language and the relative location of various elements in the AirRunner, you must keep in mind the meaning of the term "coupled." This term is expressly defined in the specification of both the '580 and '884 Patents as:

AUSTIN
BOSTON
CHICAGO
DALLAS
DENVER

DETROIT
HOUSTON
JACKSONVILLE
LOS ANGELES
MADISON

MEXICO CITY
MIAMI
MILWAUKEE
NEW YORK
ORLANDO

SACRAMENTO
SAN DIEGO
SAN FRANCISCO
SILICON VALLEY
TALLAHASSEE

TAMPA
WASHINGTON, D.C.
BRUSSELS
TOKYO

EX2013

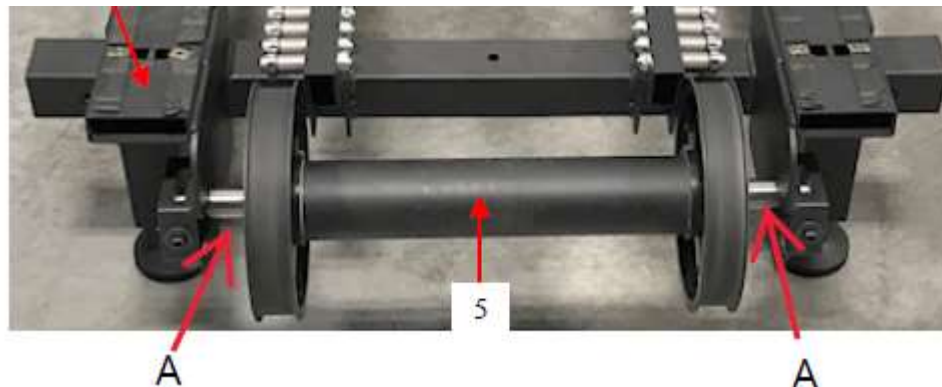
June 24, 2021

Page 2

... the joining of two members directly or indirectly to one another. Such joining may be stationary or moveable in nature. Such joining may be achieved with the two members or the two members and any intermediate members being integrally formed as a single unitary body with one another or with the two members or the members and any additional intermediate members being attached to one another. Such joining may be permanent in nature or may be removable or releasable in nature. (*E.g.*, Col. 32, lines 10 – 19 of the ‘580 Patent.)

This interpretation of “coupled” was unequivocally adopted by the Court in *Chapco, Inc. et al. v. Woodway USA, Inc.*, 3:15-CV-1665-JCH Doc. No. 76, at *17–18 (D. Conn. Dec. 8, 2016) (the “Claim Construction Ruling”), a case where Woodway successfully enforced its patent rights in the ‘580 Patent.

With the proper construction of “coupled” in mind, your statement that your client has fixedly mounted a solid stub shaft (A) as seen below to the frame is interesting but irrelevant because the AirRunner also includes “shaft (5) rotatably coupled to the frame” as specifically identified in the original claim chart. Contrary to the position asserted in your letter, the AirRunner literally meets the claim language of including a shaft (5) rotatably coupled to the frame and the inclusion of the stub shaft (A) doesn’t change this fact.



Third, you attempt to distinguish the AirRunner from claim 1 of the ‘580 Patent is based upon the false assertion that “Woodway distinguished its invention from the prior art by specifying that the safety device ... is rotatably coupled to the rear shaft” during prosecution of US Pat. No. 8,986,169 (“the ‘169 Patent”), which you argue constitutes a disclaimer that limits claims in the ‘580 Patent “to installing a safety device on the rear shaft only.” To support this baseless assertion, you cite comments made during the *Chapco* Claim Construction Ruling. Any reliance on the Claim Construction Ruling is misplaced.

June 24, 2021

Page 3

The relative location of the safety device between the front and rear shaft was neither at issue in the *Chapco* case nor before the court for claim construction. The “Background” section on page 2 of the Claim Construction Ruling identifies the nine different words or phrases briefed and before the court – none of which related to the relative location of the safety device. Indeed, at page 15 of the Claim Construction Ruling, the court readily admits that any alleged disclaimer was “not at issue” in the claim construction ruling. Thus, any comments on this topic are clearly dicta and provide no binding statement of claim construction on the ‘169 Patent or the balance of the patent family as you wrongly assert.

Not only is the Claim Construction Ruling dicta irrelevant, your “disclaimer” argument highlights your failure to perform a detailed review of the prosecution history of the patent family. It is clear from the prosecution history that Woodway has not disclaimed coupling the safety device on the front shaft. During the prosecution of the ‘169 Patent, Woodway prosecuted multiple independent claims of differing claim scope – for example, allowed claim 1 expressly included language specifying that the safety device was “coupled to at least one of the front shaft and the rear shaft” whereas claim 11 specified the “safety device cooperating with the rear shaft” with no mention of the front shaft. This is important because the alleged disclaimer on which you purport to rely was based upon the language of the Oblamski Declaration, which expressly states, “the engineering team decided to place a safety device ... on one of the front and/or rear shafts of the treadmill” which is consistent with the express language of allowed claim 1.

The Oblamski Declaration identifies the benefits of mounting the safety device to the rear shaft in response to a *specific rejection* of pending claims 11 and 15 (now granted claims 11 and 14) found on pages 7 and 11 of the Office Action. These particular claims included the safety device coupled solely to the rear shaft. In responding to this *specific* rejection of pending rear-shaft only claims 11 and 15, the Declaration expressly calls out the benefits of mounting the safety device to the rear shaft. However, the language in the Declaration relating to the benefits of mounting the safety device to the rear shaft was *never* applied in response to a rejection of claim 1 which specifically includes the language “coupled to at least one of the front shaft and the rear shaft.” Instead, a detailed review of the Declaration shows that Oblamski’s specific discussion of the rejection of claim 1 was limited to challenging the combination of prior art references and *only* this issue.

Controlling legal authorities undermine your attempt to extend prosecution arguments relating to claims 11 and 15 of the ‘169 Patent to claim 1 of the ‘580 Patent (or similar language in Woodway’s other patents) when the operative claim language is not only different, but is actually diametrically opposed to the arguments presented during prosecution. Any alleged disavowal does not extend to other claims with a different limitation. *See, e.g., Medtronic, Inc. v. Advanced Cardiovascular Sys.*, 248 F.3d 1303, 1315 (Fed. Cir. 2001) (citing *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999)). The express language of pending claims 11 and 15 of the ‘169 Patent links the safety device to only the rear shaft, while the plain language of claim 1 states that the

June 24, 2021

Page 4

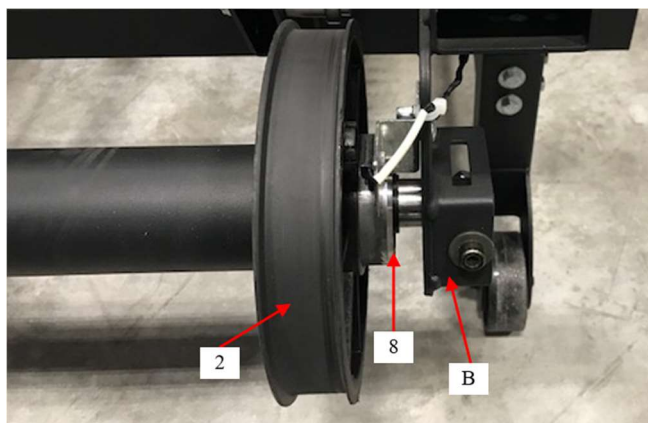
safety device is “coupled to at least one of the front shaft and the rear shaft.” Coupling the safety device solely to the front shaft is a “different limitation.” In view of the plain language of the claims along with a detailed review of the prosecution history of the ‘169 Patent, it is clear that Woodway never disclaimed coupling the safety device to the front shaft. To argue to the contrary is wrong on the law, the facts, the prosecution history, and the plain language of the claims of the ‘169 Patent, the ‘580 Patent, the ‘884 Patent and, as described below, the ‘745 Patent.

Fourth, your arguments with respect to the remaining claims of the ‘580 Patent are equally unavailing. With respect to claim 11, you once again rely upon the position that the stub shafts (A) seen above don’t rotate but are silent with respect to the rotation of the shaft (5). As illustrated above, shaft (5) *does* rotate.

With respect to claim 25, your infringement denial is not credible in view of the physical structure and operation of the AirRunner in our possession. This unit’s running belt *cannot* “move in either forward or reverse directions.” Clearly, the AirRunner safety device is designed to prevent such unsafe operation. If LifeCORE has recently changed the structure and operation of the AirRunner, we would be happy to reevaluate our claim. Please advise.

B. The ‘884 Patent

First, as shown below, “[t]he AirRunner treadmill does [] have a housing on the safety device and thus the safety device is [] ‘at least partially supported by a housing of the safety device.’” A portion of the safety device is partially supported by the housing (B) because the portion of the safety device is coupled to the stub shaft (A), which is further coupled to housing. In this arrangement, the housing interferes with the safety device to “substantially prevent[] rotation of the portion of the safety device” as recited in claim 1. Thus, contrary to your assertion, the AirRunner does in fact include a housing, which isn’t even required by all the claims of the ‘884 Patent. *See Grober v. Mako Products, Inc.*, 686 F.3d 1335, 1344 (Fed. Cir. 2012) (“a patent is infringed if a single claim is infringed”).



June 24, 2021

Page 5

Your attempt to distinguish the AirRunner from the method claims(s) of the ‘884 Patent is similarly weak. There is no credible evidence that the running belt of the AirRunner can rotate in the reverse direction if the safety device is operational.

Your further efforts to distinguish the AirRunner from claim 37 equally fail. The safety device of the AirRunner does indeed include two rotatable elements. Based on our investigation, the particular one-way bearing used in the AirRunner includes a first rotatable element and a second rotatable element, respectively shown as [9] and [10] in the previously-enclosed claim chart. Both the inner race and outer race of this commercially-available one-way bearing are capable of rotating. As you note, “the safety device of the AirRunner is fixed to the shaft that is fixedly coupled to the frame” in an installed state. Nonetheless, the portion of the safety device that is coupled to the frame, namely the first rotatable element [9], is *rotatable* but only becomes “fixed” after it is coupled to the stationary frame. To be sure, if the safety device of the AirRunner instead coupled to the frame via the second rotatable element [10], such that the second element [10] was similarly “fixed,” the first rotatable element [9] would freely rotate. Accordingly, the safety device of the AirRunner does in fact include two rotatable elements, and the AirRunner thus literally infringes claim 37.

D. Validity and Enforceability Assertions

Your validity and enforceability challenges are unpersuasive. With respect to the allegations of obviousness, the art that you rely upon was before the examiner during prosecution, and Woodway has a long history of securing patent coverage over the prior art references you have cited. The single reference that was not before the examiner was the Woodway LOKO owner’s manual. However, this reference is cumulative as the use of a linear bearing rail structure seen in the Woodway LOKO owner’s manual was specifically before the examiner. *See, e.g.*, US Patent Nos. 4334676 and 4614337.

As is readily apparent from the prosecution of the entire patent family, the ‘580, ‘884, and ‘745 Patents have undergone diligent and thorough examination. We wish you the best of luck in arguing against the validity of Woodway’s patents based on art already substantively reviewed and relied upon during multiple substantive prosecutions by different examiners.

E. The ‘745 Patent

Finally, we also take this opportunity to formally notify LifeCORE of the issuance of yet another Woodway patent, specifically US Pat. No. 10799745 (“the ‘745 Patent”). As detailed in the attached claim chart, the promotion and sale of the Assault AirRunner similarly infringes at least claim 1 of the ‘745 Patent.

June 24, 2021

Page 6

F. Conclusion

In view of the foregoing, we reiterate our demand that LifeCORE cease infringement of Woodway's patents. While we remind you of our offer to explore resolution of this matter outside of the courtroom, as demonstrated in the *Chapco* case, Woodway is not afraid to resort to the courts to protect and enforce its valuable patent rights.

If there is to be any amicable resolution of this matter, we must receive your substantive response no later than **July 16, 2021**.

Sincerely,

Richard J. McKenna

Encl.: Copy of '745 Patent and Claim Chart

cc: Woodway USA, Inc. (w/encl)