

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFECORE FITNESS, LLC
d/b/a ASSAULT FITNESS,
Petitioner,

v.

WOODWAY USA, INC.,
Patent Owner.

IPR2024-00083
Patent 11,465,005 B2

Before MEREDITH C. PETRAVICK, NEIL T. POWELL, and
AMEE A. SHAH, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

LifeCore Fitness, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–4, 6–13, 15, and 16 of U.S. Patent No. 11,465,005 B2 (Ex. 1001, “the ’005 patent”). Paper 2 (“Pet.”). Woodway USA, Inc. (“Patent Owner”) file a Preliminary Response. Paper 6 (“Prelim. Resp.”).

With our authorization, Petitioner filed a Preliminary Reply (Paper 8, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 9, “Prelim. Sur-reply”). Additionally, we held a conference call with both parties on May 7, 2024, to further discuss this issue of whether the Petition was filed by a person in accordance with 35 U.S.C. § 311. A corrected transcript of the conference call appears in the record. Paper 12 (“Tr.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

After considering the Petition, the Preliminary Response, Preliminary Reply, Preliminary Sur-reply, and the evidence of record, we determine the information presented shows a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one of challenged claims 1–4, 6–13, 15, and 16 of the ’005 patent.

We institute an *inter partes* review of all challenged claims of the ’005 patent on the grounds asserted in the Petition.

B. Real Parties in Interest

The Petition identifies LifeCore Fitness, Inc. as the real party in interest. Pet. ix. On March 11, 2024, Petitioner filed Updated Mandatory Notices stating:

On April 19, 2023, LifeCORE Fitness, Inc. converted from a California corporation to a Delaware limited liability company, LifeCORE Fitness, LLC.

On February 7, 2024, Sprinter Merger Sub, LLC, a Delaware limited liability company and wholly-owned subsidiary of FitLab Inc., merged with and into LifeCORE, and as a result, FitLab Inc. became the majority equity holder of LifeCORE. LifeCORE Fitness, LLC is now a subsidiary of FitLab Inc. and continues to do business as Assault Fitness.

Paper 7, 1. In the Updated Mandatory Notices, Petitioner identifies LifeCore Fitness, LLC d/b/a Assault Fitness and FitLab Inc. as the real parties in interest. *Id.*

Patent Owner identifies Woodway USA, Inc. as the real party in interest. Paper 3, 1.

C. Related Matters

The parties identify the following related court proceeding:
Woodway USA, Inc. v. LifeCore Fitness, Inc. d/b/a Assault Fitness, Case No. 3:22-cv-00492 (S.D. Cal.) (“the District Court Litigation”). Pet. ix; Paper 3, 1.

Petitioner also indicates that “the related ’580 Patent was at issue in” the following proceedings:

Woodway USA, Inc. v. Samsara Fitness, LLC et al., Case No. 2:15-cv-00956 (E.D. Wis.), and

Chapco, Inc. et al v. Woodway USA, Inc., Case No. 3:15-cv-01665
(D. Conn (“the Chapco Litigation”).

Pet. ix; Paper 4, 2.

This proceeding is related to the following *inter partes* reviews:
IPR2023-00836 (U.S. Patent No. 9,039,580 B1), IPR2023-00843 (U.S.
Patent No. 10,561,884 B2), and IPR2023-00849 (U.S. Patent No.
10,799,745 B2) (collectively, “the Related IPRs”). We instituted *inter partes* review in each of these proceedings.

D. The '005 patent

The '005 patent is titled “Manually Powered Treadmill” and issued on Oct. 11, 2022. Ex. 1001, code (45), (54). The '005 patent depicts manual treadmill 10 in Figure 1, which is reproduced below.

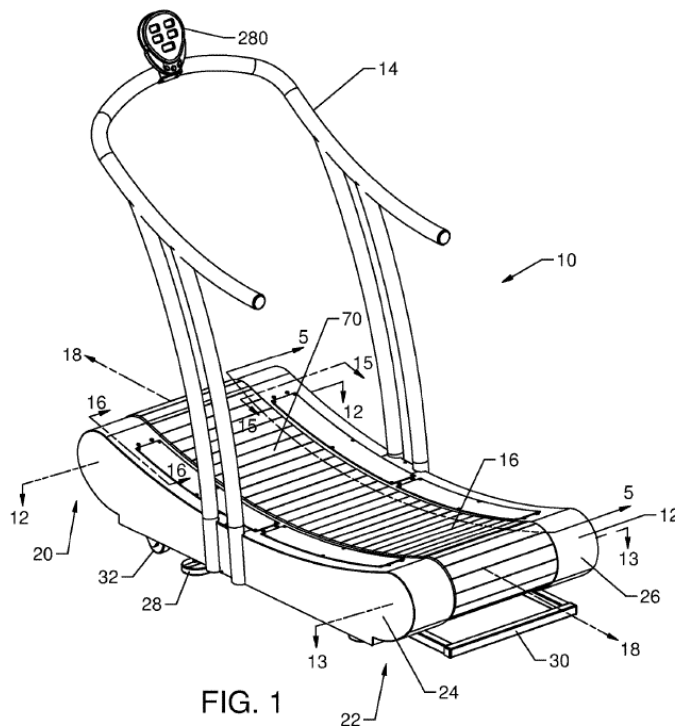


Figure 1 shows manual treadmill 10, having a handrail 14 mounted on a base 12, which supports running belt 16. *Id.* at 4:50–54. Running belt 16 has a

non-planar running surface 70. *Id.* at 6:14–17. As a user runs on the treadmill, running belt 16 moves (rotates) in a generally clockwise direction as seen in Figure 1. *Id.* at 6:53–58.

Figure 2 of the '005 patent is reproduced below.

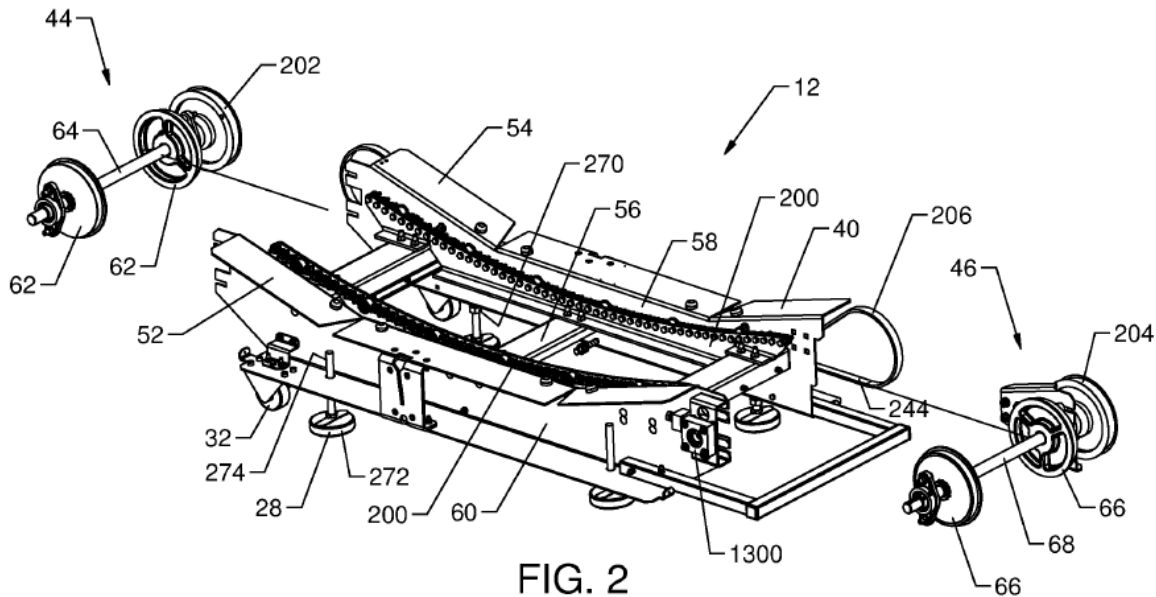


Figure 2 depicts an embodiment of base 12, having a frame 40, front shaft assembly 44, and rear shaft assembly 46. *Id.* at 5:13–16. Rear shaft assembly 46 has running belt pulleys 66 interconnected with shaft 68. *Id.* at 5:34–39. Base 12 includes “a pair of opposed bearing rails 200 to support the running belt 16 along with a front synchronizing belt pulley 202, a rear synchronizing belt pulley 204, and a synchronizing belt 206 all of which are interconnected to the running belt 16.” *Id.* at 11:11–16.

Figure 9 of the '005 patent is reproduced below.

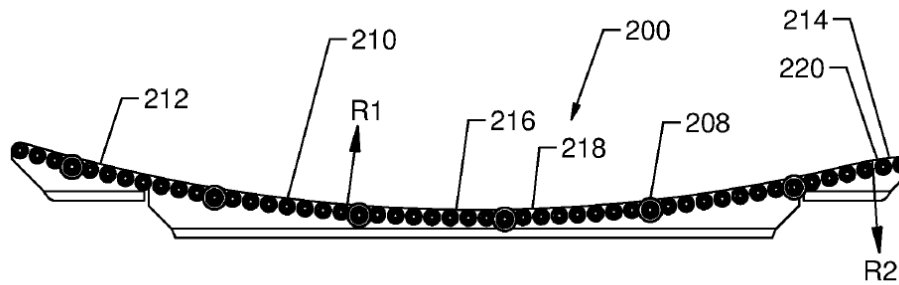


FIG. 9

Figure 9 depicts bearing rail 200. *Id.* at 3:26–27. Bearing rail 200 includes a plurality of bearings 208 and has top profile 210, which is shaped as a complex curve in this embodiment. *Id.* at 11:20–23. However, the shape of the top profile can have variations and may not have an entirely smooth contour. *Id.* at 12:12–25, Figs. 7a–7j.

Forward rotation of running belt 16 is undesirable because it could cause a user to lose their footing, resulting in injury. *Id.* at 27:2–10. Manual treadmill 10, thus, may include safety devices to prevent forward rotation. *Id.* at 27:11–19.

One safety device is depicted in Figure 36 of the '005 patent, reproduced below.

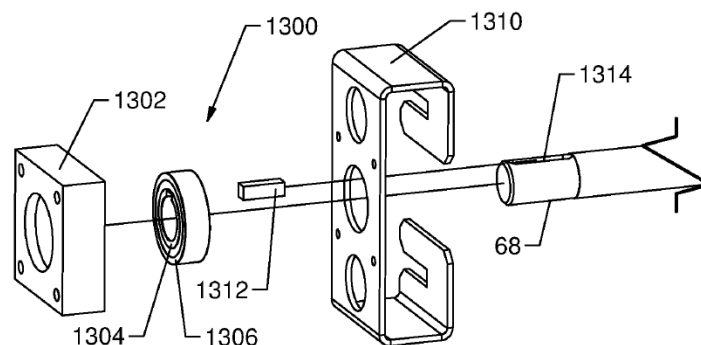


FIG. 36

Figure 36 depicts one embodiment of a one-way bearing assembly. *Id.* at 4:37–39. One-way bearing assembly 1300 restricts motion by permitting

rotation of front and rear shaft assemblies 44, 46 in only one direction. *Id.* at 27:15–19. One-way bearing assembly 1300 has inner ring 1304 and an outer ring 1306. *Id.* at 27:22–26. Disposed between inner ring 1304 and outer ring 1306 are sprags (not shown) that are asymmetric and, thus, allow for motion in one direction and prevent rotation in the opposite direction. *Id.* at 27:26–29. Housing 1302 is fixed to a bracket 1310 that is connected to, and preferably directly mounted to, the frame 40 to fix the location of the housing 1302 and prevent movement of the housing 1302 in response to the rotation of the rear shaft 68. *Id.* at 27:29–33. Key 1312 is fixed to inner ring 1304 and cooperates with keyway 1314 in rear shaft 68, and, thus, inner ring 1341 rotates with rear shaft 68. *Id.* at 27:43–46.

If a force is applied by the user to the running belt 16 that urges the rear shaft 68 to rotate counterclockwise, the one-way bearing assembly 1300 provides a counter force, preventing the counterclockwise rotation of the rear shaft 68 and the forward rotation of the running belt 16. Specifically, as the rear shaft 68 begins to move counterclockwise, the interaction of the key 1312 and the keyway 1314 begins to drive the inner ring 1304 of the one-way bearing assembly 1300 rearward. The Sprags become wedged between the inner ring 1304 and the outer ring 1306, preventing the counterclockwise rotation of the inner ring and key 1312 disposed therein. The key 1312, by virtue of its inability to rotate, provides a counterforce to the keyway 1314 as the keyway continues to attempt to rotate counterclockwise. By preventing the keyway 1314 from moving counterclockwise, the one-way bearing assembly 1300 thus prevents the rear shaft 68, the rear running belt pulleys 66, and running belt 16 from rotating counterclockwise as seen in FIGS. 1 and 5.

Id. at 27:53–28:4.

The '005 patent discloses another embodiment of a safety device having a one-way bearing assembly. *Id.* at 28:5–12, Fig. 38. Additionally,

the '005 patent discloses other safety systems to prevent undesirable forward rotation of running belt 16, such as a cam locking system, taper locks, a user operated pin system, or a band brake system with a lever. *Id.* at 29:30–35.

E. Illustrative Claim

Petitioner challenges claims 1–4, 6–13, 15 and 16 of the '005 patent. Claims 1, 9, and 15 are independent. Claims 2–4 and 6–8 depend directly or indirectly from claim 1, claims 10–13 depend directly or indirectly from claim 9, and claim 16 depends from claim 15. Claim 1 is illustrative and reproduced below, with limitation labels added in brackets.

1. [1(a)] A manually powered treadmill, comprising:
 - [1(b)] a frame;
 - [1(c)] at least one front running belt pulley coupled to the frame;
 - [1(d)] at least one rear running belt pulley coupled to the frame and spaced a distance from the at least one front running belt pulley;
 - [1(e)] a running belt at least partially supported by at least one of the at least one front running belt pulley and the at least one rear running belt pulley, wherein the running belt includes a running surface, at least a portion of which is curved;
 - [1(f)] a safety device coupled to the frame and the running belt, the safety device having a first element and a second element, the first element substantially surrounding the second element or the second element substantially surrounding the first element;
 - [1(g)] wherein one of the first and second elements of the safety device and the running belt freely rotate in a first direction of rotation relative to the frame, however, in a second direction of rotation, opposite the first direction of rotation, the one of the first and second elements is substantially prevented from

rotation relative to the frame to substantially prevent or resist rotation of the running belt relative to the frame.

Ex. 1001, 32:60–33:16.

F. Evidence and Asserted Grounds

Petitioner asserts that claims 1–4, 6–13, 15, and 16 would have been unpatentable on the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1–4, 6, 7, 9–13, 15, 16	103	Socwell, ¹ Magid, ² Sclater ³
2	1–4, 6–13, 15, 16	103	Tollkien, ⁴ Sclater

Petitioner relies upon the Declaration of Robert Giachetti, Ph.D. (Ex. 1003) to support its analysis.

II. ANALYSIS

A. 35 U.S.C. § 312

Patent Owner contends that the Petition should not be considered because the Petition fails to comply with 35 U.S.C. § 312(a)(2) because “the Petition does not identify the Delaware [Corporation] as an RPI.” Prelim. Resp. 7; *see also* Prelim. Sur-reply 1–2.

Petitioner responds that the Board may accept updated mandatory notices as long as the Petition would not have been time-barred under 35 U.S.C. § 315(b) if it had included the unidentified real party in interest.

¹ U.S. Patent No. 5,897,461, issued Apr. 27, 1999 (Ex. 1011).

² U.S. Patent No. 5,538,489, issued July 23, 1996 (Ex. 1012).

³ Neil Sclater & Nicholas P. Chironis, *Mechanisms & Mechanical Devices Sourcebook*, Third Ed. (McGraw-Hill 2001) (Ex. 1017).

⁴ DE 19922822 B4, issued July 15, 2004 (Ex. 1031).

Prelim. Reply 2 (citing *Proppant Express Investments, LLC v. Oren Tech., LLC*, IPR2017-01917, Paper 86, 7 (PTAB Feb. 13, 2019) (precedential) (“*Proppant Express*”)). Petitioner updated its mandatory notices to identify the Delaware Corporation and FitLab Inc. as real parties in interest. Paper 7, 1.

1. Background

On October 24, 2022, LifeCore Fitness, Inc. d/b/a Assault Fitness (“the California Corporation”) was served with an amended district court complaint that added the ’005 patent to the patents-in-suit in the District Court Litigation. Ex. 1006.

On April 19, 2023, the California Corporation converted to LifeCore Fitness, LLC d/b/a Assault Fitness (“the Delaware Corporation”). Paper 7, 1.

On October 24, 2023, the California Corporation filed the Petition. In the Petition, Petitioner identifies only the California Corporation as a real party in interest. Pet. ix.

On March 11, 2024, Petitioner filed Updated Mandatory Notices identifying the Delaware Corporation and FitLab Inc. as real parties in interest. Paper 7, 1.

2. Discussion

35 U.S.C. § 312(a)(2) states: “A petition filed under section 311 may be considered only if . . . the petition identified all real parties in interest.” Under our precedent, the Board may, under 35 U.S.C. § 312(a), accept updated mandatory notices as long as the petition would not have been time-barred under 35 U.S.C. § 315(b) if it had included the real party in interest. *Proppant Express Investments*, Paper 86, 7. *see also Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1374 n.9 (Fed. Cir. 2018) (en banc) (“For

example, if a petition fails to identify all real parties in interest under § 312(a)(2), the Director can, and does, allow the petitioner to add a real party in interest.”). To determine whether to accept Petitioner’s updated mandatory notices, we look to “whether there have been (1) attempts to circumvent the § 315 bar or estoppel rules, (2) bad faith by the petitioner, (3) prejudice to the patent owner caused by the delay, or (4) gamesmanship by the petitioner.” *Proppant Express*, Paper 86, 6.

a) § 315(b) Bar

Although Patent Owner argues that any new or updated petition filed now in the Delaware Corporation’s name would be time-barred (Prelim. Resp. 9), Patent Owner does not allege that the Petition would have been barred under 35 U.S.C. § 315(b) if Petitioner had identified the Delaware Corporation or FitLab Inc. as real parties in interest *at the time the Petition was filed*. In other words, Patent Owner does not allege that any of the now named real parties in interest were served with a complaint more than one year before the filing date of the Petition (i.e., before October 24, 2022). *See generally* Prelim. Resp. 2–9.

b) Attempts to Circumvent § 315(b) Bar or Estoppel Rules

There is no specific allegation that any of Petitioner and the now named real parties in interest were attempting to evade the estoppel rules in 35 U.S.C. § 315(e) or 37 C.F.R. § 42.73(d).

c) Prejudice to Patent Owner Caused by the Delay

In its Preliminary Response and Preliminary Sur-reply, Patent Owner makes no allegation that it suffered prejudice by Petitioner’s delay in identifying the Delaware Corporation and FitLab, Inc. as real parties in interest. *See generally* Prelim. Resp. 2–9; Prelim. Sur-reply 1–2.

During our conference call, Patent Owner contended that it was prejudiced by Petitioner's delay because 1) institution of *inter partes* review in this proceeding will allegedly further delay the District Court Litigation, which is currently stayed to some extent due to institution of the Related IPRs and 2) additional legal fees were expended addressing this issue. Tr. 20:19–22:4.

Although Petitioner's delay in filing updated mandatory notices may have caused Patent Owner some prejudice, the prejudice is not sufficient to warrant not considering the Petition. We have no sufficient evidence to support Patent Owner's allegation that Petitioner's delay in updating its mandatory notices would cause the district court to further delay the District Court Litigation. As to the additional legal fees, “[w]e do not believe that the cost of having to litigate a good faith dispute between the parties is the type of prejudice sufficient to warrant termination.” *Proppant Express*, Paper 86, 10 (citing *Dassault Systemes, SA v. Childress*, 663 F.3d 832, 842 (6th Cir. 2011)).

d) Bad Faith

In its Preliminary Response and Preliminary Sur-reply, Patent Owner makes no sufficient allegation of bad faith by Petitioner. *See generally* Prelim. Resp. 2–9; Prelim. Sur-reply 1–2.

During the conference call, Patent Owner indicated that Petitioner acted in bad faith by taking six months from the conversion to update its mandatory notices. *See* Tr. 18:7–12. According to Patent Owner, Petitioner should have acted with appropriate due diligence to file the Petition with the proper name in the first place. *Id.* at 21:19–22:4.

In response, Petitioner argued that it had nothing to gain by withholding its name change. *Id.* at 24:2–3. Petitioner explained that the

misidentification “was just an error” and that Petitioner’s counsel for this *inter partes* review was not aware of the conversion when the Petition was filed. *Id.* at 24:3–5. Petitioner noted that it updated its mandatory notice once it learned of the error. *Id.* at 24:6–7.

We agree with Petitioner. There is insufficient evidence of bad faith on the part of Petitioner.

e) Gamesmanship

In its Preliminary Sur-reply, Patent Owner argues that Petitioner’s mandatory notices remain deficient because Petitioner allegedly fails to disclose all of its current or former members and is allegedly blocking discovery on this issue in the District Court Litigation. Prelim. Sur-reply 1–2. Patent Owner contends: “Petitioner’s gamesmanship makes it impossible for Patent Owner to determine if a time-bar issue has arisen as it cannot possibly assess if unidentified RPIs or privies are now or may later be time-barred, undermining the purposes of RPI identification.” *Id.* at 2; *see also* Tr. 23:1–12.

Patent Owner’s allegation of gamesmanship is based on the alleged existence of further unnamed real parties in interest, but Patent Owner has not provided sufficient evidence to show that further unnamed real parties in interest exist. There is insufficient evidence of gamesmanship on the part of Petitioner.

3. Conclusion

We are not persuaded by Patent Owner that the Petition should not be considered because, when it was filed, the Petition failed to identify the Delaware Corporation and FitLab Inc. as real parties in interest.

B. 35 U.S.C. § 311(a)

Patent Owner contends that the Petition should not be considered because when the California Corporation converted to the Delaware Corporation on April 19, 2023, the California Corporation ceased to exist and, thus, the California Corporation could not have filed the Petition under 35 U.S.C. § 311 on October 24, 2023. Prelim. Resp. 6–7; Prelim. Sur-reply 1.

Petitioner responds that when the California Corporation converted to the Delaware Corporation, under Delaware law, the Delaware Corporation continues the existence of the California Corporation, which was not dissolved by the conversion. Prelim. Reply 1 (citing 6 Del. C. § 18–214(g)). Petitioner further argues that, under Delaware Law, “all of the rights, privileges and powers of the other entity that has converted, . . . as well as all other things and causes of action belonging to such other entity, shall remain vested in the domestic limited liability company.” Prelim. Reply 1–2 (quoting 6 Del. C. § 18–214(f) (emphasis removed)). Petitioner, thus, asserts: “LifeCORE Fitness, Inc. continues to exist in the form of LifeCORE Fitness, LLC and its IPR rights remain vested in LifeCORE Fitness, LLC.” Prelim. Reply 2. Petitioner, thus, argues that the California Corporation continues to exist in the form of the Delaware Corporation.

Patent Owner replies that Petitioner misses the point — “the problem is that *the Petition was not filed in the Delaware LLC’s name* but instead in the name of the (nonexistent) California corporation.” Prelim. Sur-reply 1.

Patent Owner cites a number of cases in support of its argument that an allegedly nonexistent corporation cannot file a Petition under 35 U.S.C. § 311. Prelim. Resp. 6. We have reviewed each of those cases but do not find the cited cases persuasive because the facts are not sufficiently similar

to the facts here. In *Charles Brooks Co. v. Georgia-Pacific, LLC*, 552 F.3d 718, 722 (8th Cir. 2009), the court addressed a specific Arkansas statute that concerned whether an Arkansas corporation can file suit after its charter has been revoked, and not reinstated, for failing to pay a tax. In *PrimeSource Bldg. Prods. v. United States*, 494 F. Supp. 3d 1307, 1321–1323 (Ct. Int'l Trade 2021), a concurring opinion determined that a coalition of domestic nail manufacturers could not intervene in an action because the coalition did not meet the common law definition of an unincorporated association and, thus, does not have a legal existence. In *ChinaCast Educ. Corp. v. Guo*, Case No. CV 15-05475-AB (Ex), 2016 WL 10653269, *8 (C.D. Cal. Jan. 8, 2016), the court issued an order to show cause why the court should not dismiss an action brought by a dissolved Delaware corporation, after expiration of an applicable three-year wind-up period, because the corporation no longer existed as a legal entity under Delaware law. These cases involve a legal entity that dissolved, ceased to exist entirely, or never existed in the first instance. These cases do not sufficiently address the circumstances here — where a first legal entity converted to second legal entity under Delaware law and the Petition erroneously identified the first legal entity as the Petitioner. *See* Prelim. Reply 1–2.

We agree with Patent Owner that the Petition should have, but was not, filed in the Delaware Corporation's name. *See* Prelim. Sur-reply 1. We do not agree with Patent Owner, however, that this leads to the conclusion that we should not consider the Petition. *See* Prelim. Resp. 4–7.

During our conference call, we inquired of both Petitioner and Patent Owner whether § 311(a) is jurisdictional (i.e., whether the Board may not allow the substitution of the new name of the Delaware Corporation for its old name, i.e., the California Corporation's name). Petitioner responded in

the negative, arguing that § 311 is procedural. Tr. 7:18–6:3. Patent Owner responded affirmatively, arguing that the language of § 311 is jurisdictional. *See id.* at 7:13–10:15.

Section 311(a) sets forth a requirement for a petition — a person who is not the owner of the patent may file the petition — that must be satisfied for the Board to give consideration to the petition. 35 U.S.C. § 311(a). In *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38, 4–5 (PTAB Mar. 4, 2016) (precedential) (“*Lumentum Holdings*”), the Board explained that the determination of whether a statutory limitation is jurisdictional “turns on ‘whether Congress has clearly stated that the rule is jurisdictional’” and, “absent such a clear statement, . . . courts should treat the restriction as nonjurisdictional in character.” *Lumentum Holdings*, 4 (quoting *Elektta, Inc. v. Varian Medical Systems, Inc.*, IPR2015-01401, Paper 9, 6–7 (PTAB Dec. 31, 2015)). Patent Owner fails to identify any evidence—and we are not aware of any evidence—that Congress has clearly stated that this requirement is jurisdictional.

Section 311(a)’s requirement is similar to other statutory requirements for a petition; for example, § 312(a)(2) sets out a requirement that a petition must identify all real parties in interest. In *Lumentum Holdings*, the Board determined that the similar statutory requirement in § 312(a)(2) is not jurisdictional. *Lumentum Holdings*, 4.

Give the lack of evidence of a clear statement by Congress and how the similar statutory limitation for a petition has been treated, we determine that § 311(a) is not jurisdictional. The Board is not deprived of jurisdiction over this *inter partes* review by Petitioner’s lapse in compliance with the requirement of § 311(a), nor is the Board precluded from allowing Petitioner’s lapse to be corrected.

Petitioner proposes that we modify the caption of the case to:
LifeCore Fitness, LLC d/b/a Assault Fitness v. Woodway USA, Inc.
Paper 7, 1.

As applied to the facts of this case, where there is no allegation that Petitioner is the “owner of the patent” being challenged, as concerns § 311(a), and there is no sufficient evidence of bad faith, given the Delaware Corporation is a continuation of the California Corporation, we determine that the matter of the Petition misidentifying the Petitioner is akin to the matter of a petition misidentifying a real party in interest. We, therefore, apply a similar analysis to this issue that we applied to the issue under § 312(a)(2) and reach the same conclusion. *See supra*, 10–13. We emphasize that there is no allegation that the Petition would have been barred under 35 U.S.C. § 315(b) had it been filed in the name of the Delaware Corporation. We are not persuaded by Patent Owner that the Petition should not be considered because the Petition was filed in the name of the California Corporation.

Under the circumstances here, we agree with Petitioner that modifying the caption is appropriate. *See, e.g., Lumentum Holdings*, Paper 27 (granting a motion to re-caption the proceeding to reflect updated mandatory notices).

C. 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise discretion under 35 U.S.C. § 314(a) to deny the Petition in light of the District Court Litigation. Prelim. Resp. 23–34 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”)).

Section 314(a) grants the Director discretion to deny institution of an *inter partes* review. 35 U.S.C. § 314; *Cuozzo Speed Techs., LLC v. Lee*, 579

U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst., Inc. v Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question *whether* to institute review.”) (emphasis in original); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). The Board may, in the interest of fairness and efficient use of Board resources, deny institution under § 314(a) where there is a parallel district-court proceeding involving the same or substantially the same parties and invalidity challenges. *Fintiv*, Paper 11, 5–6, 12–13 (setting out six nonexclusive factors that the Board may consider in determining whether to deny institution because of a parallel district-court proceeding).

The Director of the United States Patent and Trademark Office issued an *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (“Director’s Memo”)⁵ to clarify “the [Board’s] current application of *Fintiv* to discretionary institutions where there is parallel litigation” and to “confirm[] that the precedential import of *Fintiv* is limited to facts of that case.” Director’s Memo 2. The Director’s Memorandum explains that, “[c]onsistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” *Id.* at 3 (footnote omitted) (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-

⁵ Available at:

https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)). The Director Memo explains that such a *Sotera* stipulation “mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB . . . and allows the PTAB to review grounds that the parallel district court litigation will not resolve.” *Id.* at 7–8 (citation omitted).

Here, Petitioner indicates that “LifeCORE submitted its *Sotera* stipulation to [Patent Owner] by email on March 1, 2024, not long after PO filed its Preliminary Response.” Prelim. Reply 3. Petitioner’s email to Patent Owner is provided as Exhibit 1035, and it states:

In accordance with *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (Precedential), LifeCore agrees that if IPR2024-00083 is instituted, LifeCore will not pursue in the related District Court Litigation (*Woodway USA, Ind., v. LifeCORE Fitness, Inc. d/b/a Assault Fitness*, Case No. 3:22-cv-00492 (S.D. Cal.)) any ground raised or that could have been reasonably raised in IPR2024-00083.

Ex. 1035.

Patent Owner asserts that “Petitioner’s untimely purported *Sotera* stipulation comes too late” because “Petitioner made a strategic decision to forgo a fulsome *Sotera* stipulation with its Petition, and it should have to live with that decision.” Prelim. Sur-reply 3.

Patent Owner does not cite to any binding precedent that establishes a time limit by which a *Sotera* stipulation must be submitted before we enter our decision on institution, and we are not aware of any such precedent. *See NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13, 4 (PTAB Sept. 7, 2022) (precedential) (Director decision holding that “the only appropriate time for a petitioner to offer a stipulation related to the *Fintiv* factor 4

analysis is prior to the Board’s decision of whether to institute review”). Nor does Patent Owner assert that it has been prejudiced by the timing of the stipulation. We, thus, are not persuaded that we should disregard Petitioner’s *Sotera* stipulation because of its timing.

Under the guidance in the Director’s Memorandum, Petitioner’s stipulation is dispositive and we thus decline to discretionarily deny institution under 35 U.S.C. § 314 in view of the related District Court Litigation.

D. 35 U.S.C. § 325(d)

Patent Owner argues that the Petition should be denied under 35 U.S.C. § 325(d). Prelim. Resp. 9–23. In determining whether to deny institution under § 325(d), we use

the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, 8 (PTAB Feb. 13, 2020) (precedential).

The *Becton, Dickinson* factors provide useful insight into how to apply the framework under 35 U.S.C. § 325(d). *Id.* at 9 (referencing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton*”)).

Under the first part of the *Advanced Bionics* framework, we consider “whether the same or substantially the same art previously was presented to

the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Id.* at 8. We evaluate *Becton, Dickinson* factors (a), (b), and (d) to determine whether Petitioner has demonstrated material error. *Id.* at 10. Those factors are:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination; and
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art.

Becton, Paper 8, 17–18. Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (“IDS”), in the prosecution history of the challenged patent. *Id.* at 7–8.

Patent Owner argues that the same and or substantially the same art were previously presented to the Office because Socwell, Magid, Tollkien, and the Declaration of Dr. Giachetti from the Chapco Litigation are listed on the face of the ’005 patent. Prelim. Resp. 11–12; *see also* Ex. 1001, code (56) (listing references cited). Patent Owner argues Petitioner relies upon “nearly identical arguments” regarding the teachings of Socwell, Magid, and Tollkien because the Chapco Litigation Declaration was presented to the Office during the prosecution. Prelim. Resp. 11–13.

Petitioner does not dispute that Socwell, Magid, Tollkien, and the Chapco Litigation Declaration were previously presented to the Office, but argues that Sclater was not and that “the combinations of references applied in the petition, were not applied, nor cumulative with, the references applied during Examination.” Pet. 102–103.

Patent Owner does not dispute that Sclater was not previously presented to the Office (Prelim. Resp. 11) and does not assert that the Chapco Litigation Declaration addresses Sclater (*see id.* at 11–14).

Patent Owner, however, argues that Sclater is cumulative to U.S. Patent No. 7,115,073 (“Nizamuddin”), which was indicated as considered on an IDS. Prelim. Resp. 14–15. Patent Owner argues that Sclater is cumulative of Nizamuddin because both disclose a sprag clutch and, like Nizamuddin, Sclater fails to disclose an adequate motivation to combine a sprag clutch with the treadmills of Socwell, Magid, and Tolkien. *Id.* at 16–20. Patent Owner, thus, contends that Sclater does not add anything meaningful to the combination. *Id.*

Both of Petitioner’s asserted grounds rely upon Sclater to teach the claimed safety device, for example, as recited by limitations 1(f) and 1(g). Sclater was not previously presented to the Office. And, we are not persuaded by Patent Owner that Sclater is cumulative to other prior art considered during examination, including Nizamuddin. As the Petition points out, Sclater teaches, for example, that a friction-type clutch is quieter than a ratchet-type clutch and that roller clutches are better suited for high-speed freewheeling than pawl-and-ratchet clutches. Pet. 28–29 (citing Ex. 1017, 316).

Accordingly, we determine that the same or substantially the same art was not previously presented to the Office and that the same or substantially the same arguments were not previously presented to the Office, because both of Petitioner’s asserted grounds include Sclater, which was not previously presented to the Office and is not cumulative of other prior art previously presented.

Because we determine that part one of the framework is not satisfied, we need not turn to part two to determine whether Petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims.

We decline to exercise discretion under § 325(d) to deny the Petition.

E. Legal Standards

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d, 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). “[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 550 U.S. at 416 (citing *U.S. v. Adams*, 383 U.S. 39, 50–51 (1966)). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in

the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Here, the record contains no evidence of objective indicia of non-obviousness.

F. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art (“POSA”) would have had a bachelor’s degree in mechanical engineering and at least one year of machine design experience related to power transmission equipment and a demonstrated understanding of the biomechanics of exercise, including knowledge in the field of anthropometry (i.e., the study of human proportions).

Pet. 4 (citing Ex. 1003 ¶¶ 48, 44–49 (supporting testimony of Dr. Giachetti)) (emphasis omitted). Petitioner additionally states that “[t]his description is approximate and additional development experience could make up for less education and vice versa.” *Id.*

At this stage of the proceeding, Patent Owner does not dispute Petitioner’s proposed level of ordinary skill in the art and does not propose an alternative level. *See generally* Prelim. Resp. 2.

On this record, we adopt Petitioner’s assessment of the level of ordinary skill in the art as it is consistent with the ’005 patent and the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

G. Claim Construction

We construe each claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in

the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019). Under this standard, claim terms are generally given their plain and ordinary meaning as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). Only those terms in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019).

Petitioner proposes constructions of the claim terms “substantially prevent” and “safety device” because the construction of these terms is at issue in the District Court Litigation. Pet. 13–15, 46–47.

Patent Owner notes that the district court “has issued its claim construction order” (Prelim. Resp. 2 (citing Ex. 1033)), but Patent Owner does not otherwise address claim construction.

We note that the district court construed “substantially prevent” as “restricts rotation to allow for only one rotational direction of movement.” Ex. 1033, 16 (internal quotation marks omitted). The district court also construed “safety device” as “a device that includes the elements recited and restricts rotation to allow for only one rotational direction of movement or resists rotation in one direction of rotation.” *Id.* at 23 (internal quotation marks omitted).

Our analysis below is consistent with the district court’s construction of these claim terms. *See* Ex. 1003, 10–17, 22–25. We do not need to construe these claim terms any further in order to reach our decision about institution. *See Realtime Data*, 912 F.3d at 1375 (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent

necessary to resolve the controversy.” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

H. Ground 1: Unpatentability over Socwell, Magid, and Sclater

Petitioner asserts that claims 1–4, 6, 7, 9–13, 15, and 16 are unpatentable over Socwell, Magid, and Sclater. Pet. 20–65. At this stage of the proceeding, Patent Owner does not directly address the patentability merits of the Petition, arguing instead that “[t]he Petition should be denied as procedurally improper.” Prelim. Resp. 1.

1. Summary of Socwell

Socwell is a U.S. patent titled “Exercise Treadmill” and issued on April 27, 1999. Ex. 1011, codes (45), (54). Socwell discloses “a novel curved deck treadmill which provides a structurally supported arcuate shaped, movable surface on which a user may exercise.” *Id.* at 3:26–29. In one embodiment, the curved deck treadmill does not have a motor. *Id.* at 11:54–60.

Socwell’s Figure 1 is reproduced below.

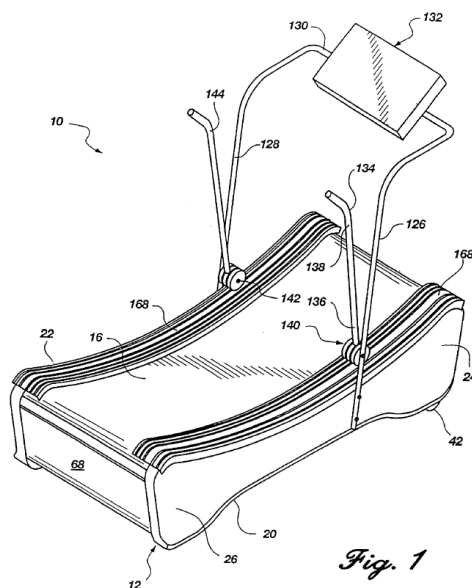


Figure 1 “is a perspective view of one presently preferred embodiment of a curved deck treadmill.” *Id.* at 4:35–36. Curved deck treadmill 10 comprises a support frame 12 having first side 20 and second side 22, with deck 56 between. *Id.* at 5:23–26.

Socwell’s Figure 2 is reproduced below.

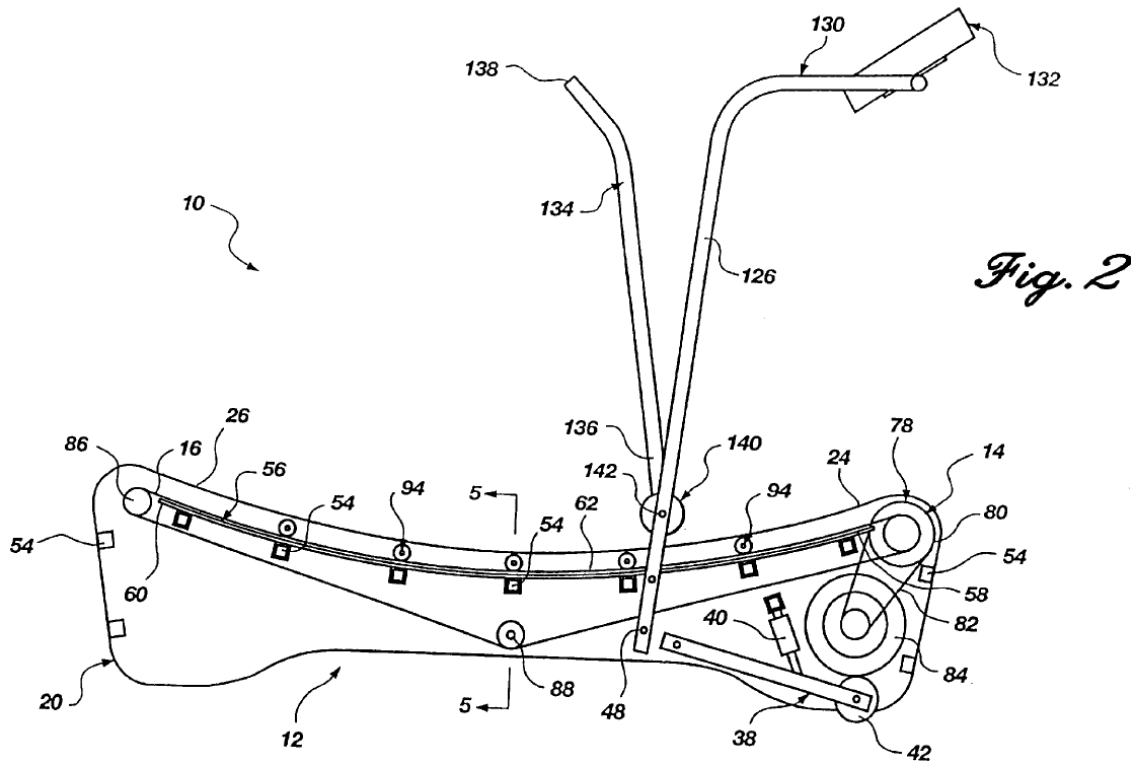


Figure 2 “is a side elevational view of the embodiment of [Figure 1] exposing one presently preferred arrangement of the internal components of the present invention.” *Id.* at 4:38–40. In one embodiment, deck 56 has first end 58, second end 60, and intermediate portion 62 between. *Id.* at 5:26–28. Roller assembly 14 is provided between first roller 78 and second roller 86. *Id.* at 5:33–38. Belt 16 is rotatably mounted on roller assembly 14 in relation to deck 56 and provides “a structurally supported arcuate shaped, movable surface on which a user may exercise.” *Id.* at 5:42–45.

Socwell's Figure 5 is reproduced below.

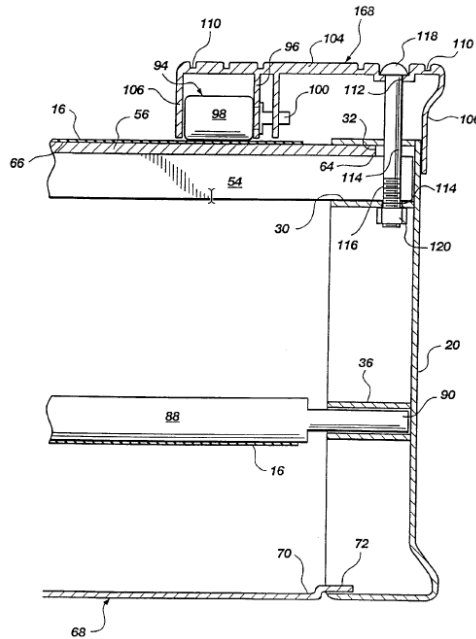


Fig. 5

Figure 5 depicts belt securing assembly 94. Belt securing assembly 94 retains endless belt 15 in a curvilinear configuration, substantially flush with deck 56. *Id.* at 10:5–9. Belt securing assembly 94 includes mounting bracket 96, which holds roller 98 so that roller 98 engages belt 16. *Id.* at 10:17–21.

2. Summary of Magid

Magid is a U.S. patent titled “Walker Apparatus with Left and Right Foot Belts” and issued on July 23, 1996. Ex. 1012, codes (45), (54).

Magid's Figure 2 is reproduced below.

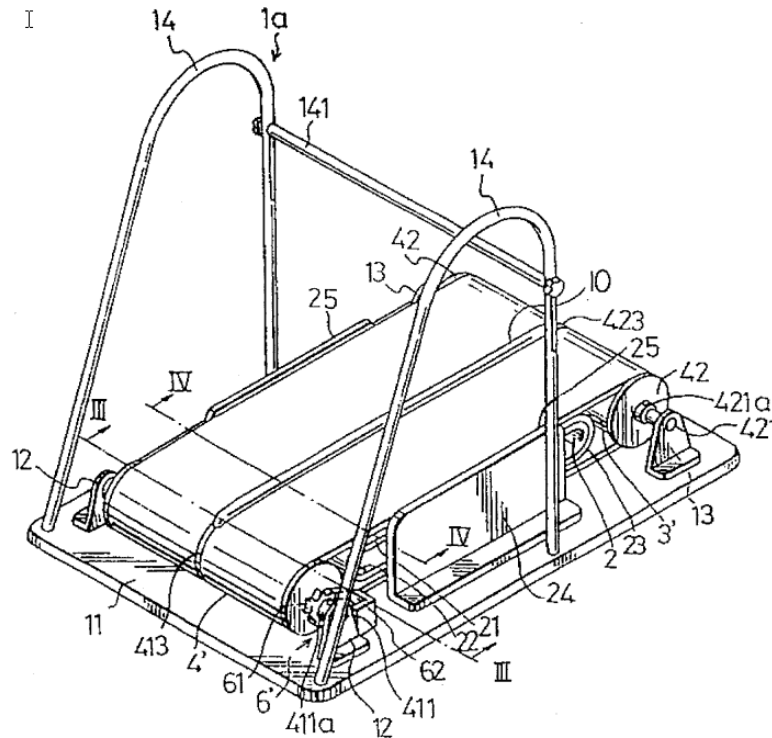


FIG. 2

Figure 2 depicts Magid’s preferred embodiment of a walker apparatus — an exercise walker. *Id.* at 3:41–44. The exercise walker comprises base 11, having two-foot belts 4, 4’, a pair of front rollers 41, and a pair of rear rollers 42. Figure 2 shows unidirectional control means 6, 6’, which permits only unidirectional movement of foot belts 4, 4’. *Id.* at 4:47–49. Magid states:

A unidirectional control means 6, 6' is installed to permit only unidirectional movement of the left and right foot belts 4, 4'. In this embodiment, the control means 6, 6' includes a pair of ratchet gears 61 attached to outer ends of the front rollers 41

and mounted rotatably on the first shaft 411, and a pair of pawls 62 secured to the base 11 and engaging one of the ratchet gears 61 to permit only unidirectional rotation of the front rollers 41, thereby preventing bidirectional movement of the foot belts 4, 4'. A releasable means (not shown) may be provided to release selectively the pawls 62 from the ratchet gears 61 in a known manner to permit reciprocating movement of the foot belts 4, 4' when desired. Of course, the ratchet gears may be attached to the rear rollers 42 to achieve the same result.

Id. at 4:46–60.

3. *Overview of Sclater*

Sclater is titled “Mechanisms and Mechanical Devices Sourcebook, Third Edition.” Ex. 1017, cover. Chapter 9 of Sclater is titled “Coupling, Clutching, and Braking Devices” and describes basic mechanical clutches, including a cam and roller clutch. *Id.* at 302–303. A cam and roller clutch is “an over-running clutch [that] is better suited for higher-speed free-wheeling than a pawl-and-ratchet clutch.” *Id.* at 303. For a cam and roller clutch,

[t]he inner driving member has cam surfaces on its outer rim that hold light springs that force the rollers to wedge between the cam surfaces and the inner cylindrical face of the driven member. While driving, friction rather than springs force the rollers to wedge tightly between the members to provide positive clockwise drive. The springs ensure fast clutching action. If the driven member should begin to run ahead of the driver, friction will force the rollers out of their tightly wedged positions and the clutch will slip.

Id.

Sclater also discusses spring-loaded pins and sprags in a one-way clutch and describes them as having “[s]prags combined with cylindrical rollers in a bearing assembly [that] can provide a simple, low-cost method for meeting the torque and bearing requirements of most machine

applications” and can serve as a roller bearing, and with the clutch’s torque rating dependent on the number of sprags. Ex. 1017,312.

Sclater further provides “details of overriding clutches” and explains a friction clutch is quieter than a ratchet and pawl. Ex. 1017,316. In discussing ways to apply overrunning clutches, Sclater explains that “[t]hese clutches allow freewheeling, indexing and backstopping,” and “they will solve many design problems.” *Id.* at 318.

Figure 1 from Sclater’s page 318 is reproduced below.

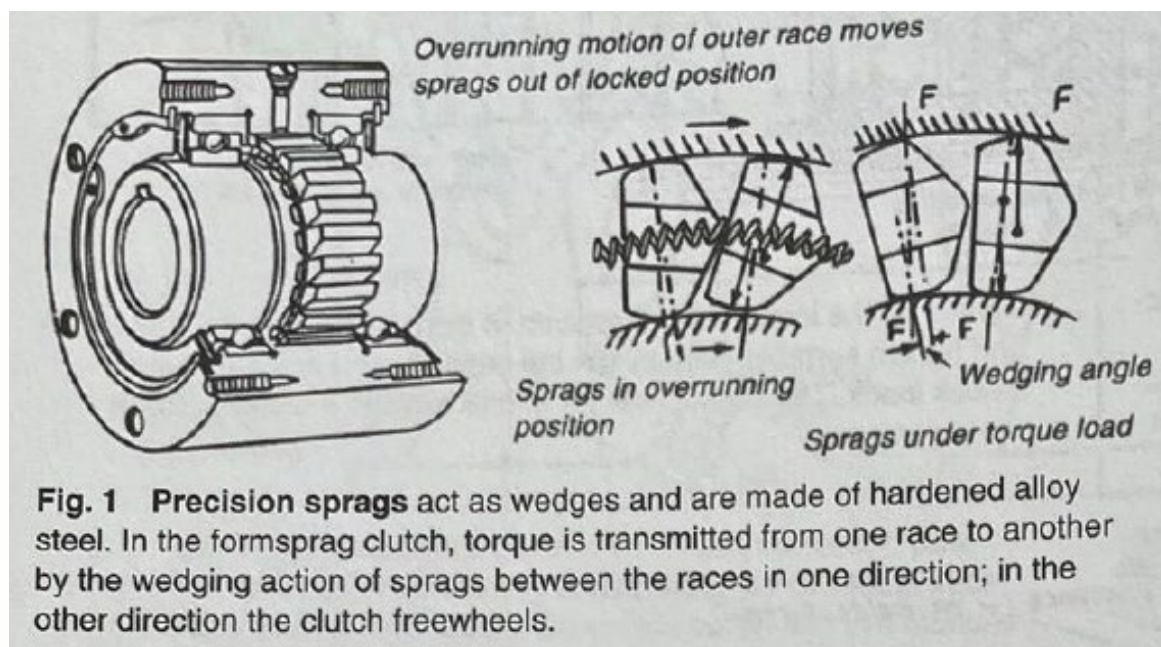


Figure 1 illustrates “precision sprags” which are an example of an overrunning clutch. *Id.* at 318. This clutch transmits torque from one race to another by the wedging actions of sprags between the races in one direction and, in the other direction, the races freewheel. *Id.*

Sclater states that application for sprag-type clutches “include overrunning, backstopping, and indexing” and the selection of an overrunning sprag clutch “requires a review of the torque to be transmitted, overrunning speed, type of lubrication, mounting characteristics,

environment conditions, and shock conditions that might be encountered.”
Ex. 1017, 320.

Figure 2 from Sclater’s page 320 is reproduced below.

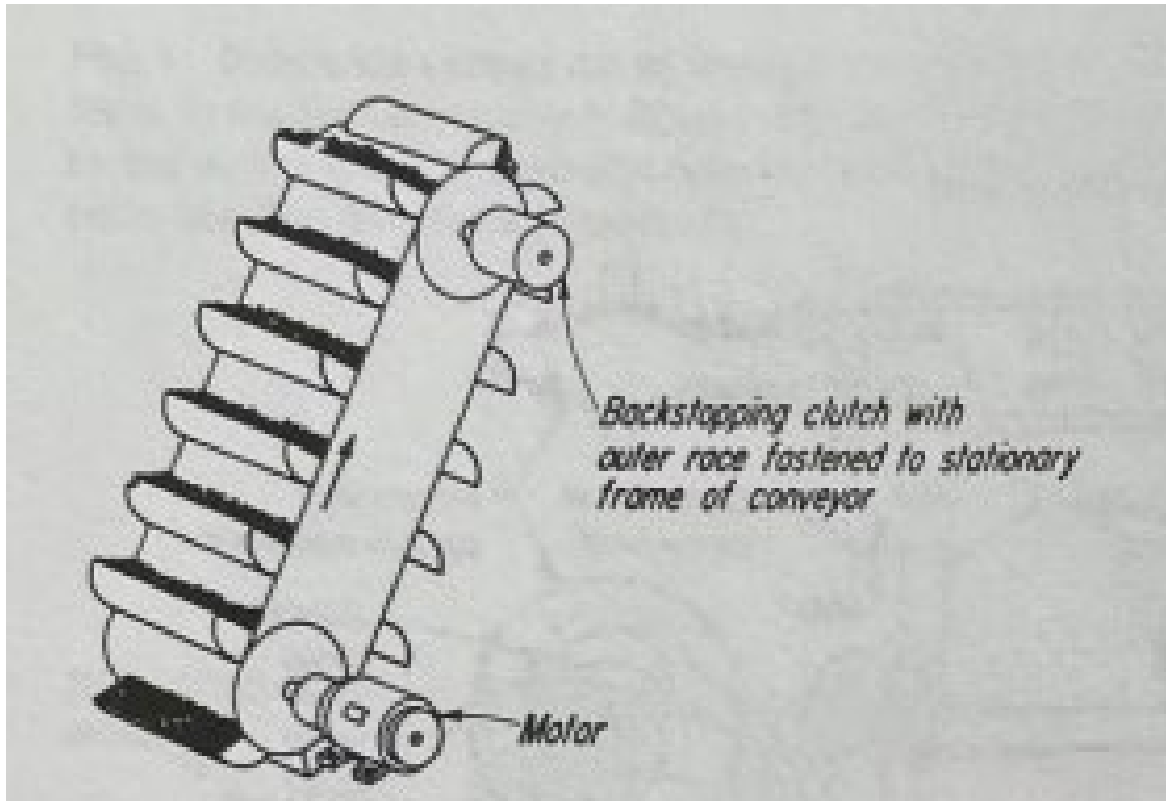


Figure 2 depicts an example application of backstopping. *Id.* at 320. A vertical conveyor carrying buckets and having a motor and a backstopping clutch with an outer race fastened to the stationary frame of the conveyor.

4. *Analysis of Independent claim 1*

Petitioner contends that claim 1 is unpatentable over Socwell, Magid, and Sclater. Pet. 33–55.

*a) Limitation 1(a): A manually powered treadmill, comprising:*⁶

Petitioner contends that Socwell discloses a manually powered treadmill. Pet. 33–34 (citing Ex. 1011, Abstr., 3:26–29; Ex. 1003 ¶¶ 152–154, 202, 224).

Based on the current record, we determine that Petitioner’s analysis and evidence sufficiently disclose limitation 1(a), the preamble.

b) Limitation 1(b): a frame;

Limitation 1(c): at least one front running belt pulley coupled to the frame;

Limitation 1(d): at least one rear running belt pulley coupled to the frame and spaced a distance from the at least one front running belt pulley; and

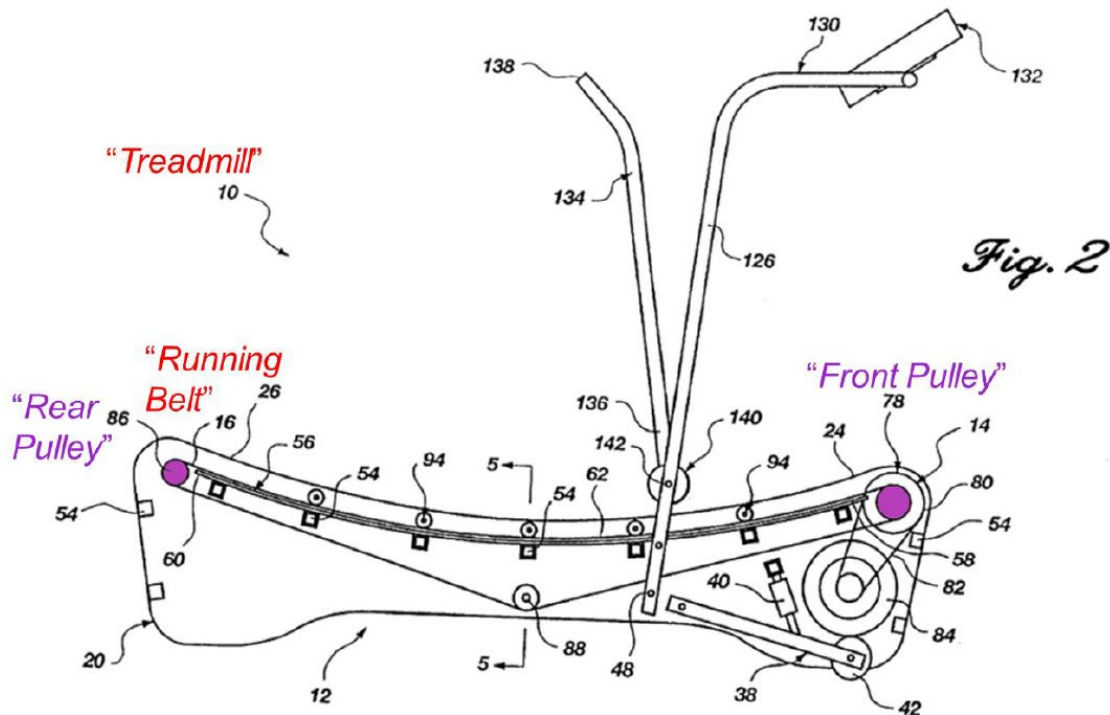
Limitation 1(e): a running belt at least partially supported by at least one of the at least one front running belt pulley and the at least one rear running belt pulley, wherein the running belt includes a running surface, at least a portion of which is curved;

Petitioner contends, and Patent Owner does not dispute, that Socwell discloses the treadmill having a frame (i.e., frame 12); front running belt pulley (i.e., first roller 78), a rear running belt pulley (i.e., second roller 86), and a running belt (i.e., belt 16) with a curved running surface, arranged as recited in limitations 1(b)–1(e). Pet. 35–39 (citing Ex. 1011, 4:13–18,

⁶ On this record, we do not need to determine whether the preamble is limiting as it is undisputed that Socwell discloses a manually powered treadmill.

5:23–26, 5:33–45, 6:23–25, 6:27–45, 9:57–65, 10:17–26, Fig. 1, Fig. 2, Fig. 4, Fig. 5; Ex.1003 ¶¶ 155–163, 203–206, 225–227).

Reproduced below is Socwell’s Figure 2, with Petitioner’s annotations.



Ex.1011, Fig.2 (Annotated)

Annotated Figure 2 depicts a side elevational view of the treadmill, with Petitioner’s annotations pointing to front pulley 78, rear pulley 86, and running belt 16. Ex. 1011, 4:35–40; Pet. 29. Annotated Figure 2 shows the curved running surface of running belt. 16.

Based on the current record, we determine that Petitioner’s analysis and evidence sufficiently disclose limitations 1(b)–(e).

- c) *Limitation 1(f): a safety device coupled to the frame and the running belt, the safety device having a first element and a second element, the first element substantially surrounding the second element or the second element substantially surrounding the first element; and*

Limitation 1(g): wherein one of the first and second elements of the safety device and the running belt freely rotate in a first direction of rotation relative to the frame, however, in a second direction of rotation, opposite the first direction of rotation, the one of the first and second elements is substantially prevented from rotation relative to the frame to substantially prevent or resist rotation of the running belt relative to the frame.

Petitioner contends, and Patent Owner does not directly dispute⁷, that the combination of Socwell, Magid, and Sclater teaches limitations 1(f) and 1(g). In particular, Petitioner relies upon Magid and Sclater as teaching the claimed safety device. *See* Pet. 20–33, 39–46.

Petitioner asserts that Magid teaches a treadmill having a safety device (i.e., unidirectional control means 6, 6') mounted front or rear shaft assembly to prevent bidirectional movement of the belt and teaches the safety device including a ratchet gear 61 coupled to one of the shafts and a

⁷ The Preliminary Response does not address directly Petitioner's patentability analysis for Grounds 1 and 2. *See generally* Prelim. Resp. However, within in its § 325(d) analysis, Patent Owner argues that the addition of Sclater is cumulative to the previously presented art because Sclater, like the previously present art, fails to supply an adequate motivation to use Sclater's sprag type clutch. *Id.* at 16–20. In as much as Patent Owner's § 325(d) arguments regarding lack of adequate motivation may be considered as addressing the merits of Grounds 1 and 2, we note that we found substantially similar arguments unpersuasive in our Institution Decisions in the Related IPRs. *See, e.g.*, IPR2023-00836, Paper 6, 40–42; IPR2023-00843, Paper 6, 36–40.

pawl coupled to a base. Pet. 40–42 (citing Ex. 1012, 4:46–59; Ex. 1003 ¶¶ 164–169, 207–209, 229).

Petitioner argues: “It would have been obvious to a POSA to combine Socwell’s treadmill with Magid’s control means to permit only unidirectional movement of the running belt to reduce the risk of a user stepping onto the running belt of the treadmill and losing their balance when the belt moves in the forward direction.” Pet. 24 (citing Ex. 1003 ¶ 137); *see also* Pet. 20–26 (explaining that it was known that injury could occur if a treadmill belt moved in an unexpected direction (citing Ex. 1011, 1:32–67, 2:45–48; Ex. 1013, 1:30–37; Ex. 1019, 3–4; Ex. 1020, 8; Ex. 1003 ¶¶ 71–73, 131–137)).

Petitioner asserts that Sclater teaches a sprag-type one-way bearing assembly that has an outer race (i.e., first element) that substantially surrounds an inner race (i.e., second element), with a plurality of sprags and rolling elements between the inner race and outer race. Pet. 42–43 (citing Ex. 1017, 312). The sprags act as wedges so that torque is transmitted from one race to another in one direction but not the other direction. Ex. 1017, 312, 318; Ex. 1003 ¶¶ 171–175.

Petitioner argues: “A POSA would have been motivated to substitute Sclater’s one-way sprag-type bearing assembly for Magid’s ratchet-and-pawl one-way clutch mechanism to obtain predictable results, e.g., reduced noise and improved durability, while maintaining the backstopping functionality and resultant safety benefits of Magid.” Pet. 26 (citing Ex. 1003 ¶ 141); *see also* Pet. 27–33 (explaining that ratchet-and-pawl mechanism was known to be noisy and less durable (citing Ex. 1003 ¶¶ 142–151; Ex. 1017, 303, 316, 320; Ex. 1018, 38–43, 52–53)).

Based on the current record, we determine that Petitioner’s analysis and evidence sufficiently disclose limitations 1(f)–(g).

d) Conclusion as to claim 1

After considering Petitioner’s evidence and analysis based on the record before us at this stage of the proceeding, we determine that Petitioner has shown a reasonable likelihood that claim 1 is unpatentable over Socwell, Magid, and Sclater.

5. Ground 1’s Remaining Claims and Ground 2

“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. § 42.108(a). We must “either (1) institute as to all claims challenged in the petition and on all grounds in the petition, or (2) institute on no claims and deny institution.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019),⁸ 5–6, 64; *see also* 37 C.F.R. § 42.108(a), *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1359–60 (Fed. Cir. 2018) (stating a decision to institute is “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”).

Thus, because we have decided to grant institution on Ground 1 with respect to claim 1, we must do the same for claims 2–4, 6, 7, 9–13, and 15, and 16 for Ground 1. We note that for the remaining claims of Ground 1, Petitioner has mapped the limitations of the challenged claims to the teachings of the prior art combinations and articulated reasons why one of

⁸ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated>

ordinary skill in the art would have combined the references, supporting its contentions with citations to Dr. Giachetti's Declaration.

Patent Owner at this stage does not raise any arguments specifically directed to these claims of Ground 1.

Further, because we have decided to institute *inter partes* review based on Ground 1, we must do the same for Ground 2 as well, as institution must include all challenged claims under all asserted grounds. *See* 37 C.F.R. § 42.108(a). We again note that, for Ground 2, Petitioner has mapped the limitations of the challenged claims to the teachings of the prior art combinations and articulated reasons why one of ordinary skill in the art would have combined the references, supporting its contentions with citations to Dr. Giachetti's Declaration.

Patent Owner at this stage does not raise any arguments specifically directed to Ground 2.

III. CONCLUSION

After considering the evidence and arguments presented in the Petition, Preliminary Response, Preliminary Reply, and Preliminary Sur-reply, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail in establishing that at least claim 1 is unpatentable. Accordingly, we institute an *inter partes* review on all grounds of unpatentability in the Petition. At this stage of the proceeding, we have not made a final determination with respect to the patentability of any of the challenged claims.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claims 1–4, 6–13, 15, and 16 of the '005 patent on the unpatentability grounds asserted in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this decision; and

FURTHER ORDERED that documents filed in the proceeding after entry of this order shall use the following caption:

LIFECORE FITNESS, LLC
d/b/a ASSAULT FITNESS,
Petitioner,

v.

WOODWAY USA, INC.,
Patent Owner.

IPR2024-00083
Patent 11,465,005 B2

IPR2024-00083
Patent 11,465,005 B2

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