

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
U.S. Patent No. 11,465,005

PATENT OWNER'S SURREPLY

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EXHIBIT LIST

Exhibit No.	Exhibit
2001	<i>Reserved</i>
2002	Minute Entry for Claim Construction Hearing, <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc.</i> , Case No. 3:22-cv-00492-JO-BLM, Dkt. 57 (S.D. Cal.)
2003	<i>Reserved</i>
2004	U.S. Patent No. 5,709,632 to Socwell
2005	Redline Comparison of Specifications for U.S. Patent Nos. 5,709,632 and 5,897,461
2006	U.S. Patent No. 8,986,169 to Bayerlein, <i>et al.</i>
2007	U.S. Patent No. 9,039,580 to Bayerlein, <i>et al.</i>
2008	Opening Expert Report of Dr. Robert Giachetti, <i>Chapco Inc. v. Woodway USA, Inc.</i> , C.A. No. 3:15-cv-01665 (JCH), Dkt. 216-1 (D. Conn.)
2009	Declaration of Robert Giachetti, <i>Chapco Inc. v. Woodway USA, Inc.</i> , C.A. No. 3:15-cv-01665, Dkt. 88-2 (JCH) (D. Conn.)
2010	<i>Reserved</i>
2011	U.S. Patent No. 7,115,073 to Nizamuddin
2012	<i>Reserved</i>
2013	<i>Reserved</i>
2014	<i>Reserved</i>

Exhibit No.	Exhibit
2015	Defendant's Second Amended Invalidity Contentions and Associated Claim Charts, <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc.</i> , Case No. 3:22-cv-00492-JO-BLM (S.D. Cal.)
2016	Declaration of Kadie M. Jelenchick
2017	Declaration of Sarah E. Rieger
2018	Declaration of Dr. Kim Blair
2019	<i>Curriculum vitae</i> of Dr. Kim Blair
2020	Declaration of Eric A. Weber
2021	Additional Excerpts from Neil Sclater and Nicholas P. Chironis, <i>Mechanisms & Mechanical Devices Sourcebook</i> , Third Ed., (McGraw-Hill 2001) ("Sclater")
2022	January 10, 2024 Deposition Transcript of Robert Giachetti (IPR2023-00836, U.S. Patent No. 9,039,580)
2023	January 10, 2024 Deposition Transcript of Robert Giachetti (IPR2023-00849, U.S. Patent No. 10,799,745)
2024	January 9, 2024 Deposition Transcript of Robert Giachetti (IPR2023-00843, U.S. Patent No. 10,561,884)
2025	<i>Reserved</i>
2026	<i>Reserved</i>
2027	<i>Reserved</i>
2028	Woodway Non-Motorized Treadmills User Manual
2029	Altra Industrial Motion Product Brochure
2030	<i>Reserved</i>

Exhibit No.	Exhibit
2031	Press Release, Woodway USA, Inc., Woodway Debuts Speedboard at IHRSA Show (March 20, 2009) (on file with author)
2032	Woodway's Confidential Sales and Cost Data for CURVE Line of Treadmills From Woodway's Fiscal Years 2010 through 2024.
2033	Woodway's Confidential Sales and Placement Data for the CURVE Legacy Treadmill From Woodway's Fiscal Year 2009
2034	Woodway's Confidential Sales and Placement Data for the CURVE Legacy Treadmill from Woodway's Fiscal Year 2010
2035	Video: Woodway CURVE® Treadmill With Safety Device
2036	Video: Woodway CURVE® Treadmill Without Safety Device
2037	<i>Patents</i> , WOODWAY.COM, http://www.woodway.com/support/patents (last visited Jan. 29, 2024)
2038	Confidential List Price and Cost Information for the CURVE Line of Treadmills From Woodway's Fiscal Year 2008 through Dec. 31, 2023
2039	<i>Shop</i> , WOODWAY.COM, http://www.woodway.com/shop (last visited Jan. 23, 2024)
2040	<i>Treadmills</i> , ASSAULTFITNESS.COM, http://assaultfitness.com/collections/treadmills (last visited January 23, 2024)
2041	Search Results for Assault Air Runner for Sale Online, http://google.com (search "Assault Air Runner treadmill"; then follow "shopping" icon)

Exhibit No.	Exhibit
2042	<i>Chapco, Inc. and Samsara Fitness, LLC v. Woodway USA, Inc.</i> , Case No. 3:13-cv-1665 (JCH), Dkt. 144 (D. Conn. Sept. 26, 2017)
2043	Letter from Richard J. McKenna, Foley & Lardner LLP, to Christopher Kelly, Gym Store, Inc. (Oct. 21, 2014) (on file with author)
2044	March 2, 2017 Expert Report of Kim B. Blair, Ph.D., <i>Chapco, Inc. and Samsara Fitness, LLC v. Woodway USA, Inc.</i> , Case No. 3:15-cv-1665 (JCH) (D. Conn.)
2045	Lisa Malosky, HEALTH & FITNESS SPORTS MAGAZINE, February 2010
2046	ATHLETIC BUSINESS, March 2010
2047	Press Release, Woodway USA, Inc., Woodway CURVE Featured on NBC's The Biggest Loser (Dec. 29, 2010) (on file with author)
2048	Kelsey Cannon, <i>The Hardest 20-Minute Workout of Your Life</i> , MEN'S HEALTH, Mar. 4, 2014, https://www.menshealth.com/fitness/a19536030/instafit-harder-sprint-workout/ (last visited Jan. 30, 2024)
2049	<i>Watch: Move, Shape and Shred Your Body For Summer</i> , MEN'S HEALTH, May 3, 2017, https://www.menshealth.com/uk/building-muscle/a757686/watch-move-shape-shred/ (last visited Jan. 30, 2024)
2050	Kaleigh Ray, <i>The Woodway Curve</i> , TREADMILLREVIEWS.COM, Aug. 9, 2012, https://www.treadmillreviews.com/articles/the-woodway-curve/ (last visited Jan. 30, 2024)
2051	11Alive, <i>Megaformer workout combines curved Woodway treadmill for new workout</i> , YOUTUBE (Mar. 5, 2019), https://www.youtube.com/watch?v=QqlJIwsBRlc .

Exhibit No.	Exhibit
2052	Roy M. Wallack, <i>Treadmills, Ellipticals Tap Into Natural Power</i> , L.A. TIMES (Nov. 16, 2009), https://www.latimes.com/health/la-he-gear16-2009nov16-story.html (last visited Jan. 30, 2024)
2053	David Quick, <i>New Treadmill Creates Buzz</i> , POST & COURIER (July 21, 2009), http://www.postandcourier.com/news/2009/jul/21/new_treadmill_creates_buzz89834/ (last visited July 23, 2009)
2054	GOVERNMENT RECREATION & FITNESS, May 2020
2055	Rachel Bachman, <i>Treadmills Unplugged: A Gym Workout Powered by Your Feet</i> , WALL STREET JOURNAL (July 6, 2015), http://www.wsj.com/articles/treadmills-unplugged-a-gym-workout-powered-by-your-feet-1436202306 .
2056	Rachel Zabonick-Chonko, <i>Treadmills Are Making a Comeback</i> , CLUB SOLUTIONS, Dec. 11, 2014, https://clubsolutionsmagazine.com/2014/12/treadmills-making-comeback/ (last visited Jan. 29, 2024)
2057	Press Release, FIBO, FIBO Jubilee With Many Innovations: Nominees Announces For FIBO INNOVATION AWARDS (Apr. 14, 2010) (on file with Woodway)
2058	<i>Treadmills</i> , TRUEFORMRUNNER.COM, https://trueformrunner.com/collections/treadmills-1/products/trueform-trainer (last visited Jan. 30, 2024)
2059	<i>Treadmills</i> , TECHNOGYM.COM, https://www.technogym.com/en-US/product/skillmill_DJK0.html (last visited Jan. 30, 2024)
2060	<i>Speedboard</i> , SPEEDFIT.COM, https://www.speedfit.com/SpeedboardPro.html (last visited Jan. 27, 2024)

Exhibit No.	Exhibit
2061	<i>Products, IN10CT Curved Manual Treadmill</i> , AXTIONFITNESS.COM, https://axtionfitness.com/products/in10ct-curved-manual-treadmill (last visited Jan. 29, 2024)
2062	<i>New Items</i> , XEBEXFITNESS.COM, https://xebexfitness.com (follow “new items”; then follow “Xebex AirPlus Runner Smart Connect”) (last visited Jan. 29, 2024)
2063	<i>Shop, Sprintbok Treadmill</i> , WATERROWER.COM, http://www.waterrower.com/us/collection/nohrd-sprintbok (last visited Jan. 29, 2024)
2064	<i>Shop By Brand, Cascade Ultra Runner Plus Treadmill</i> , FITDIRECT.COM, https://fitdir.com/cascade-ultra-runner-plus-treadmill/ (last visited Jan. 29, 2024)
2065	<i>Cardio</i> , TRUGRIT-FITNESS.COM, https://trugrit-fitness.com/collections/cardio/products/grit-runner-curved-manual-treadmill (last visited Jan. 29, 2024)
2066	Woodway Infringement Contentions (’580 Patent), <i>Samsara TrueForm Runner, Chapco, Inc. and Samsara Fitness, LLC v. Woodway USA, Inc.</i> , Case No. 3:15-cv-1665 (JCH) (D. Conn.)
2067	Woodway’s Infringement Contentions (’580 Patent), <i>Assault Air Runner, Woodway USA, Inc. v. LifeCORE Fitness, Inc. d/b/a Assault</i> , Case No. 3:22-cv-00492-JP (BLM) (S.D. Cal.)
2068	Woodway Infringement Contentions (’884 Patent), <i>Assault Air Runner, Woodway USA, Inc. v. LifeCORE Fitness, Inc. d/b/a Assault</i> , Case No. 3:22-cv-00492-JP (BLM) (S.D. Cal.)
2069	Woodway Infringement Contentions (’745 Patent), <i>Assault Air Runner, Woodway USA, Inc. v. LifeCORE Fitness, Inc. d/b/a Assault</i> , Case No. 3:22-cv-00492-JP (BLM) (S.D. Cal.)

Exhibit No.	Exhibit
2070	Woodway Infringement Contentions ('005 Patent), Assault Air Runner, <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc. d/b/a Assault</i> , Case No. 3:22-cv-00492-JP (BLM) (S.D. Cal.)
2071	Owner's Manual, Assault Air Runner Manual Treadmill
2072	Marketing Material, Assault Air Runner
2073	Proposed Protective Order
2074	Proposed Protective Order Redline
2075	LifeCore Fitness, LLC Certificate of Conversion and Certificate of Formation
2076	Order Setting Deadlines, <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc.</i> , Case No. 3:22-cv-00492-JO-BLM, Dkt. 63 (S.D. Cal.)
2077	Order Granting in Part and Denying in Part Defendant's Motion to Stay, <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc.</i> , Case No. 3:22-cv-00492-JO-BLM, Dkt. 73 (S.D. Cal.)
2078	Woodway USA, Inc.'s First Amended and Supplemental Disclosure of Asserted Claims and Infringement Contentions (Redacted), <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc.</i> , Case No. 3:22-cv-00492-JO-BLM (S.D. Cal.)
2079	Transcript of Hearing on Motion to Stay, <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc.</i> , Case No. 3:22-cv-00492-JO-BLM (S.D. Cal.)
2080	Woodway USA, Inc.'s Opposition to LifeCORE Fitness, Inc.'s Motion to Stay Litigation Pending <i>Inter Partes</i> Review, <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc.</i> , Case No. 3:22-cv-00492-JO-BLM, Dkt. 66 (S.D. Cal.)

Exhibit No.	Exhibit
2081	Defendant's Memorandum and Points of Authority in Support of Motion to Stay Litigation Pending <i>Inter Partes</i> Review, <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc.</i> , Case No. 3:22-cv-00492-JO-BLM, Dkt. 60-1 (S.D. Cal.)
2082	July 30, 2024 Deposition Transcript of Robert Giachetti (IPR2024-00083, U.S. Patent No. 11,465,005)
2083	Woodway CURVE Treadmill Claim Chart ('005 Patent)
2084	LifeCORE Fitness, Inc. d/b/a Assault Fitness confidential sales information relating to the Assault AirRunner models, produced in <i>Woodway USA, Inc. v. LifeCORE Fitness, Inc. d/b/a Assault Fitness</i> , Case No. 3:22-cv-00492-JO-BLM (S.D. Cal.) as LCF035149 and marked as Deposition Exhibit 109

I. LEVEL OF ORDINARY SKILL IN THE ART

While critical of PO's proposed level of ordinary skill in the art, Petitioner fails to offer any support for its proposal. Rather, it relies solely on the *ipse dixit* of Giachetti, who without explanation concludes that an "understanding of exercise biomechanics...is important to understand the design of curved treadmills." EX1036, ¶19. As Blair explained, Giachetti never articulated what he considered in reaching his opinion or even explained what the relevant field of "art" is. EX2018, ¶65. Giachetti's reply declaration is similarly deficient, parroting the same conclusory statements from his first declaration without disclosing any supporting facts or data. EX1036, ¶19. Giachetti's opinions warrant no weight. 37 C.F.R. §42.65(a); *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (PTAB Aug. 24, 2022) (precedential). Indeed, in other IPRs on related patents, the Board "agree[d] with Patent Owner that...knowledge of exercise biomechanics is not" required for a POSA. *E.g.*, IPR2023-00849, Paper 42, 18 (PTAB October 24, 2024) ("849 FWD").

Separately, Petitioner's proposed definition that requires an engineering degree must fail as it excludes certain inventors of the '005 Patent, which should be the "starting point [for how a POSA understands the claims]...based on the well-settled understanding that inventors are typically persons skilled in the field of the invention." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*).

Any POSA definition “should include the inventor.” *Reckitt Benckiser LLC v. Gemak Trust*, IPR2020-00186, Paper 8, 6 (PTAB May 15, 2020). Contrary to Petitioner’s statement, (Reply, 1), Blair did “know for a fact that [some named inventors] don’t” have an engineering degree, and this testimony remains unrebutted. EX1038, 9:24-10:6.

II. CLAIM CONSTRUCTION

A. “*substantially prevent[]*” and “*safety device*”

The Reply does not argue that the district court constructions for the terms “substantially prevent[]” and “safety device” are incorrect. Reply, 2. Accordingly, these constructions should be adopted for the reasons stated in the district court’s claim construction order. POR, 5-6; EX1033, 10-17, 22-25.

B. “*plurality of bearings*”

Petitioner’s Reply incorporates new evidence which is reason enough to reject it. Specifically, the Reply cites Giachetti’s second declaration and a newly-added dictionary definition in Exhibit 1051. But even if the Petition had timely cited such evidence for the meaning of “bearing,” the relevant definition undermines Petitioner’s position. The definition of “bearing” as “any part of a machine in or on which another part revolves, slides, etc.” ***supports*** the premise that a POSA would understand that a bearing is defined by its function with respect to “another part” that for example, “revolves, slides, etc.” “***in or on***” the bearing. EX1051, 163

(emphasis added); Reply, 3; EX1036, ¶11. That is, this definition confirms to a POSA that “bearings” are characterized specifically by their relationship to other moving parts, which slide on the bearings. Moreover, the same dictionary evidence submitted in Reply contains the definition for “bear,” the root word to “bearing,” as “to be capable of sustaining weight,” further supporting PO’s position that “bearings” are intended to bear/support the treadmill’s belt. EX1051, 162. Blair’s Declaration also supports such an understanding of “bearing” in this context. *See, e.g.*, EX2018, ¶¶72-73, 80-82.

While the Board construed a similar “bearing” term in a related proceeding to not require “any particular structure, positioning under the running belt, nor bearing any weight,” that construction was made without the evidence presented here. *See* 849 FWD, 22. Petitioner introduces a dictionary definition that squarely contradicts both Petitioner’s arguments and the Board’s prior claim construction as it demonstrates that “bearing” is specifically defined by its relation to other parts. This evidence – submitted by Petitioner itself – demonstrates that PO has not read a preferred embodiment into the claims, but rather that a POSA would have understood that the “plurality of bearings” must be below the belt so the belt may slide “in or on” the bearings.

As explained by the POR and Blair, this definition is supported by the ’005 Patent specification since it uses the term “bearing” to describe structures that

support a belt sliding on top of it, but uses terms like “rollers” and “wheels” to describe structures that sit above and hold the running belt in a curved shape. POR, 7-11; EX2018, ¶¶70-80. Accordingly, based on both Petitioner's extrinsic evidence and the '005 Patent specification itself, PO's arguments are consistent with a POSA's understanding of “bearings,” *i.e.*, as being positioned below the belt such that the belt *slides on* the bearings.

III. PETITIONER'S REPLY IMPROPERLY INTRODUCES NEW ARGUMENTS NOT MADE IN THE PETITION

The Reply improperly introduces new arguments outside of those presented in the Petition, which should not be accorded any weight. *See* 37 C.F.R. §42.23(b); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’...Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the...unpatentability of an original...claim, *and new evidence that could have been presented in a prior filing.*”) (emphasis added). Here, Petitioner and its expert cite to new evidence to support new arguments that could have been made in the Petition. For example, Petitioner's Reply and Giachetti's Second Declaration (EX1036) add Exhibits 1051–

52, which were introduced for the first time in Reply. *See* Reply, 3 (citing a new dictionary reference, EX1051, to support new claim construction arguments), 26-30 (citing a new patent reference, EX1052, to support new secondary considerations arguments).

Further, the Reply raises new arguments omitted from the Petition and relies on a second Giachetti Declaration that contains opinions that could have been included with the Petition. *See, e.g.*, EX1036, ¶¶29-32, 47-48, 50-68, 78-79, 83-84, 97-98, 109-112; Reply, 6-8, 11-18. For example, and particularly egregiously, these new arguments purport to explain what a POSA would have understood based on the alleged state of the art. *E.g.*, Reply, 13-14. In support of this new argument, the Reply includes an annotated figure from Abelbeck, however, this reference was neither mentioned nor cited in the Petition. Such new arguments should be disregarded under 37 C.F.R. §42.23(b).

IV. THE CHALLENGED CLAIMS ARE NOT UNPATENTABLE

A. Socwell does not disclose “a plurality of bearings” (Claims 6, 13, 16)

Socwell, at most, discloses a single bearing (deck 56), as the belt of Socwell would not slide “in or on” any other structure. *See supra* §II.B. Consistent with the POR, Socwell’s rollers 98 do not disclose a “plurality of bearings” because no part of the Socwell treadmill “revolves, slides, etc.” in or on the rollers 98. EX1051, 163;

POR, 7-11. Instead, the belt slides *under* the rollers 98, not *in* or *on* them as required by Petitioner's newly proffered dictionary definition. Rollers 98 are definitionally not bearings. Neither the Reply nor the Board's prior decision in a related proceeding alter this conclusion.

Petitioner's newly submitted dictionary evidence for "bearing" (*see supra* §II.B) also fully accords with the '005 Patent specification. As the POR explains, Socwell's belt does not slide on and is not supported by rollers 98, and thus, a POSA would not understand Socwell's rollers 98 to constitute bearings. POR, 7-11; EX2018, ¶¶70-80. Rather, Socwell's rollers 98 more closely track the separate "roller or wheel assemblies 716" described in the '005 Patent specification. *See* POR, 7-8; EX2018, ¶77. At most, Socwell discloses a single bearing in deck 56, but otherwise fails to disclose a "plurality of bearings" as required in Claims 6, 13, and 16.

B. Petitioner fails to establish that Tollkien discloses "a running belt...wherein the running belt includes a running surface..." (Ground 2, All Claims)

Petitioner's attempts to backfill its arguments in the Petition with new arguments in Reply is improper. All Claims specifically require a "running belt" that "includes a running surface...." The Petition then points to Tollkien's continuous belt 12 as the claimed "running belt." Pet., 79 ("Tollkien discloses a continuous belt 12 (*running belt*)"). The Petition did *not* identify the combined

assembly of continuous belt 12 and cross members 10 as the claimed “running belt.” Now, realizing its mistake, Petitioner attempts to rectify its position in Reply, raising a new argument that continuous belt 12 and cross members 10 should be considered a single assembly. Reply, 7.

In the Petition, Petitioner relied on two separate components to satisfy the Claims’ requirement for a running belt that “includes” a running surface. Specifically, **only** continuous belt 12 was identified as the “running belt” while cross members 10 were identified as the “running surface.” Pet., 79-80. Importantly, Tollkien explains that cross members 10 are not a component of belt 12 but rather are “attached with rivets 6 to [the] continuous belt 12.” EX1031, ¶[0018]. Thus, because belt 12 is not the surface “on which a runner’s feet would typically make contact when the user is running on the treadmill during normal use,” Petitioner failed to meet its burden of showing that Tollkien’s belt 12 “includes [the] running surface.” Petitioner cannot backfill its deficient Petition by adopting a new argument and interpretation of Tollkien in Reply, namely that belt 12 is an “assembly that includes a belt and cross members.” Reply, 7. This is not how either the Petition or Tollkien itself present belt 12, and new arguments developed in Reply are improper and should be disregarded. 37 C.F.R. §42.23(b).

In a footnote, Petitioner implies that PO’s arguments are inconsistent with how its own treadmills operate with slats forming the running belt. Reply, 6, n. 3.

This is inaccurate and again reflects an attempt by Petitioner to change the arguments presented in its Petition—*i.e.*, the arguments to which Petitioner is bound and PO is responding. Moreover, while the '005 Patent and coextensive PO products do disclose slats 228 attached at either end to two underlying endless belts 226, the latter being likened to Tollkien's continuous belt 12 by Petitioner, the '005 Patent does not describe the underlying belts as the full running belt. EX1001, 14:65-15:4; *see also id.*, 13:56-58 ("endless belts 226 are configured to provide support for the running belt 16 in order to support the weight of a user"). Endless belts 226 are separate support belts, and if the slats were removed, there would be no surface between them, unlike belt 12 in Tollkien. The Petition, on the other hand, describes Tollkien's belt 12 as comprising the entire running belt. Pet., 79.

Petitioner's criticisms of PO's arguments are misplaced in view of these clear differences between the '005 Patent and the arguments made in the Petition. Petitioner's new argument—that cross members 10 and belt 12 of Tollkien would have collectively been considered the running belt with the surface of the cross members making the running surface—must be rejected. 37 C.F.R. §42.23(b); *Intelligent Bio-Systems, Inc.*, 821 F.3d at 1369-70.

C. Tollkien does not disclose “a front [or rear] shaft coupled to frame...” (Claims 2-3)

Petitioner attempts to remedy the Petition's conclusory arguments regarding the shaft limitations with improper new arguments in Reply. The Petition's statement about Tollkien's purported teaching of a front and rear shaft is limited to pages 90-91, which include just two sentences and two annotated figures, and fails to specify where the shaft limitations are supposedly disclosed. POR, 15-16. Now recognizing the clear deficiencies in the Petition, Petitioner's Reply points to a *different* section of the Petition (*i.e.*, Pet., 78). Reply, 9. However, as Petitioner ultimately admitted in the Reply, even Giachetti could not point to the word “shaft” in Tollkien. Reply, 10; EX2082, 67:25-68:12. When pressed, Giachetti testified that roller 2 in Tollkien “would technically qualify as a shaft” (EX2082, 54:21) but such an opinion was not presented in his Declarations or the Petition, and would not map onto the claim language requiring that the “front [or rear] shaft” be “adapted to support the at least one front [or rear] running belt pulley.” EX1001, Claim 2. And neither the Petition nor Giachetti's Declarations articulate *any* reason why or how a POSA would have identified the unnamed/unmarked circles in Tollkien's rollers 2 as a shaft based solely on the figures. Accordingly, Petitioner has failed to demonstrate how Tollkien discloses a front/rear shaft.

Just as problematic, Petitioner provides a new annotated figure that was absent from the Petition and Giachetti's Opening Declaration (Pet., 11-12). This new argument and evidence must be rejected. 37 C.F.R. §42.23(b); *Intelligent Bio-Systems, Inc.*, 821 F.3d at 1369-70.

Petitioner states that it was simply "common sense" that Tollkien discloses a front/rear shaft but fails to provide any support in the Petition for why "common sense" would lead a POSA to interpret Tollkien's figures as now alleged. The case Petitioner cites even specifically "emphasized the importance of a *factual foundation* to support a party's claim about what one of ordinary skill in the relevant art would have known." *Randall Mfg. v. Rea*, 733 F.3d 1355, 1362 (Fed. Cir. 2013) (emphasis added). As the Federal Circuit has explained, "common sense cannot be used as a 'wholesale substitute for reasoned analysis and evidentiary support....'" *B/E Aero., Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1380 (Fed. Cir. 2020) (quoting *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016)). If Petitioner intended to rely on a POSA's "common sense" as a gap-filler where a reference was otherwise silent on that element, the Petition needed to provide factual evidence to support what a POSA would have purportedly known. It did not. Indeed, while Giachetti's Opening Declaration discussed the general state of the art, it failed to discuss what a POSA would have known about shafts with any specificity, and there is no discussion of how a POSA would have understood drawings in the art to

disclose a shaft when the reference otherwise never uses that term. *See* EX1003, ¶¶50-91. This and the comparable lack of discussion in the Petition is a fundamental deficiency that cannot be overcome.

D. Petitioner fails to establish that Tollkien discloses “a plurality of bearings coupled to the frame” (Claims 6, 13, 16)

Just as with the front/rear shaft limitations, Petitioner similarly attempts to backfill with new argument to bolster the Petition's failure of proof regarding the “plurality of bearings coupled to the frame” element. Again, Petitioner argues that “common sense” fills the gaps in its Petition. Reply, 12-13. But to support this assertion, the Reply only cites to and provides an annotated figure from the Abelbeck reference, *which was never included in the original Petition*. Reply, 13-14. Nowhere in the Petition is there any reference to or mention of Abelbeck or its exhibit number (EX1015), and the Petition fails to identify what a POSA would have understood about Tollkien based on Abelbeck. *See generally* Petition. Petitioner's improper new arguments in Reply must be rejected.

More specifically, the Reply contains many assertions that are never mentioned—let alone supported with evidence—in the Petition. For example, the Reply states that “a POSA would have understood the weight of the user would close the gap between the belt and the runners to place them in contact when in use.” Reply, 15. The only citation supporting this statement is to Giachetti's Reply

Declaration, an unsurprising fact given that there is nothing in the Petition or Giachetti's Opening Declaration that even hints at this concept. It is a completely new, and thus improper, argument in Reply.

Similarly, the Reply states that a "POSA would have understood that the runners [in Tolkien] are mounted to the frame" without citing to the Petition or Giachetti's Opening Declaration, again demonstrating an improper new argument. Reply, 16-17. Yet, substantively, Giachetti's testimony that there are "a ton of different ways" the runners could be attached and that "it's not depicted" in Tolkien confirms Blair's understanding.¹ EX2082, 73:23-74:13; EX2018, ¶114. Petitioner's belated attempt to mischaracterize Giachetti's testimony is not only improper but also cannot change the fact that neither the Petition, Giachetti, nor Tolkien support Petitioner's Reply arguments, nor does it explain why a POSA would have understood the runners to be attached to the frame. Again, the mere invocation of "common sense" cannot replace analysis and evidentiary support. *B/E Aero.*, 962 F.3d at 1380.

When Petitioner's new arguments based on previously uncited prior art are disregarded (as they must be), Petitioner is left without any evidence that Tolkien's

¹ Petitioner also mischaracterizes Blair's testimony, (Reply, 15) as he never "admitted" fixed bumpers would create excessive friction. EX1050, 81:21-83:11.

runners are bearings or are attached to the frame. Accordingly, Petitioner fails to establish that Tollkien discloses “a plurality of bearings coupled to the frame.”

E. Petitioner Fails to Demonstrate Motivation to Combine

1. A POSA Would Not Have Been Motivated to Combine Magid with Socwell (Ground 1)

Petitioner's arguments regarding the alleged motivation to combine these references remain deficient. Whether Socwell and Magid fall within the broad field of “exercise equipment” is insufficient. Reply, 18-20. Simply being in the same field of endeavor cannot establish motivation to combine. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9, 10 (PTAB Oct. 16, 2018) (informative).

Perhaps recognizing this fatal flaw, Petitioner attempts to backfill by relying on third-party treadmill safety standards. These arguments also fail. No ground includes these so-called standards as a primary or secondary reference, and the Petition never asserts that any ground would be supplemented by a POSA's general knowledge of the art. *See generally* Petition. Even if it had, as Blair explained, none of the “standards” Petitioner identifies call for a one-way bearing or other mechanical means for restricting the movement of the belt in one direction. EX2018, ¶141. Petitioner cannot rely on third-party standards that fail to address the relevant elements to provide the missing motivation to combine.

Further, Petitioner continues to downplay the significance of prior art discouraging its proposed combinations. The POR describes in detail the teachings in Magid that would have discouraged a POSA from attempting to combine it with Socwell. POR, 26-30. Petitioner's attempted rebuttal does not contest that such teachings exist, but instead asks the Board to disregard them as "not relevant to the proposed combinations." Reply, 20. This is improper. The Board cannot disregard a teaching discouraging the asserted combination simply because the petitioner does not specifically rely on it. *See, e.g., Arctic Cat Inc. v. Bombardier Rec. Prods.*, 876 F.3d 1350, 1360 (Fed. Cir. 2017) ("[T]he prior art could contain one reference suggesting a combination and others critiquing or otherwise discouraging the same. Even a single reference can include both types of statements, and...it is error to fail to consider the entirety of the art."). The Board must consider Magid for all it teaches, including teachings that discourage a curved, single-belt design.

The sole case Petitioner cites does not stand for any contrary proposition—or even for the proposition Petitioner states. *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994) states that "a reference that teaches away is a significant factor to be considered in determining unobviousness" only to conclude that the reference at issue did not arise to a teaching away because it "teaches that [the relevant element] is usable and has been used for [the applicant's] purpose." 27 F.3d at 553. Unlike *Gurley*, nothing in Magid supports using its bearing assembly or safety device with a curved running

surface. *See generally* EX1012. Rather, as explained, many teachings would actively discourage a POSA from attempting to combine the features of Magid with a curved or multi-planar treadmill. POR, 35-39. Petitioner cannot overcome these teachings by simply asking the Board to disregard them.

2. Petitioner's Obviousness Arguments Regarding Sclater Rely on Improper Hindsight (Ground 1)

Petitioner's arguments regarding the alleged motivation to substitute Sclater for Magid similarly fail. Despite Petitioner's contrary assertions, its stated motivations plainly rely on hindsight bias and must be rejected.

While spending much of its Reply discussing how a POSA would understand the Emerson catalog and purportedly rely on its disclosures to substitute a sprag-type clutch for Magid's ratchet-type clutch, (Reply, 21-22), the Petition relied on Sclater as a secondary reference, not Emerson. *See generally* Petition. But Sclater is just as problematic. Sclater describes several devices a POSA would recognize as more similar to—and more easily substituted for—Magid's toothed ratchet-type one-way bearing. POR, 30-42. Petitioner never explains why a POSA would consider a completely different sprag-type clutch when Sclater itself discloses more structurally similar and more easily substituted devices like toothless ratchets that would also solve the purported "problems" identified. The only explanation is that Petitioner relied on hindsight to select Sclater's—and now Emerson's—sprag-type clutch

specifically to cobble together a device that it contends meets the elements of the Challenged Claims. This is improper.

As the Supreme Court has held, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements *in the way the claimed new invention does*. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-19 (2007) (emphasis added). Petitioner does not even attempt to meet this standard, never explaining why a POSA would have selected the specific sprag-type clutch it elects over the dozens of others Sclater discloses. *See* POR, 32-40. Selecting a clutch is much more complicated than Petitioner suggests, with Sclater itself identifying an entire list of factors that must be considered before selecting a clutch for a particular application, none of which Petitioner or Giachetti even attempt to address. EX1017, 320. Petitioner and Giachetti admittedly engaged with none of these (*see* POR, 38-39),² rendering their motivation to combine arguments necessarily lacking. *See Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, 925 F.3d 1373, 1381-82 (Fed.

² Petitioner states to the contrary in Reply but cites nothing in support of its contention. Reply, 21.

Cir. 2019) (finding no motivation to combine where “[e]vidence shows that selecting a dielectric and a method of forming that dielectric is more complicated than Petitioners suggest” and Petitioners failed to address various factors that must first be considered).

Petitioner's Reply misstate the issue, namely that a POSA would not have been motivated to select the specific sprag identified in the Petition because Sclater identifies many alternative, similar devices that could achieve the same result. Reply, 24. The Petition simply fails to identify why a POSA would have selected the specific sprag they chose from Sclater to use in the combination.

3. A POSA Would Not Have Been Motivated to Combine Sclater with Tollkien (Ground 2)

Petitioner does not address the issues with the purported motivation to combine Sclater with Tollkien identified in the POR, instead relying on the same arguments for combining Sclater with Socwell. Reply, 24.

The Reply now admits that Socwell teaches that a “curved running surface may solve the issue of a user falling off the back of a treadmill” conceding the lack of motivation to combine a safety device with a curved treadmill design. Reply, 24. Despite this concession, the Reply insists that the motivation to combine should be based on solving the “problem of instability when mounting or dismounting a treadmill.” Reply, 24; *see also id.*, 22 (“[I]t has long been recognized users may be

injured by falling off of a treadmill while mounting or dismounting it.”). Petitioner, however, fails to identify any evidence to support this principle for curved manual treadmills. In particular, the Reply’s assertion that Chickering and Socwell identify this problem is plainly false (*see generally* EX1011 & EX1013; *see also* POR, 43-44), and neither Petitioner nor Giachetti identify any prior art teaching or other evidence whatsoever to indicate that mounting or dismounting a treadmill creates a safety hazard. Reply, 22-23. Based on its failure to preliminarily establish any instability problem when mounting or dismounting a treadmill, let alone that a POSA would have been motivated to combine Sclater and Tolkien in order to solve such a problem, Petitioner’s arguments should be rejected.

V. SECONDARY CONSIDERATIONS DICTATE A FINDING OF NONOBVIOUSNESS

A. Nexus

PO clearly demonstrated nexus between certain of the Challenged Claims and Woodway’s products. Petitioner’s arguments to the contrary—which rely on caselaw that contradicts Petitioner’s position—must fail.

There is a rebuttable presumption of nexus if a product “is the invention disclosed and claimed.” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019). This presumption was established through Blair’s testimony and detailed claim charts demonstrating that each element of most Challenged Claims is present

in PO's products. EX2018, ¶¶177 (citing EX2083); *see also* EX1050, 22:4-13. Petitioner fails to rebut or even challenge this evidence. Instead, Petitioner misapprehends prior Board decisions to assert that the presumption of nexus should not apply in the first place. Petitioner's citation to *Lectrosonics, Inc., v. Zaxcom, Inc.*, IPR2018-01129, Paper 33, 33 (PTAB Jan. 24, 2020) (precedential) is particularly misleading.

Unlike here, the patent owner in *Lectrosonics* did “**not** provide an analysis demonstrating that its products are coextensive...with the challenged claims;” *i.e.*, it failed to establish a presumption of nexus at all. *Id.*, 33. Although the Board discussed ways a patent owner may still rely on secondary considerations, these apply only where “a presumption of nexus is **inappropriate**.” *Id.* (citing *Fox Factory*, 944 F.3d at 1375) (emphasis added). Such alternatives are inapplicable when PO has offered unrebutted analysis demonstrating coextensiveness.

Petitioner's arguments that there is no presumption of nexus because PO's various models of CURVE treadmills have unclaimed distinguishing features (Reply, 25-26) must be rejected. There is no “bright-line rule that the presumption of nexus does not apply if any unclaimed feature materially affects the functioning of a product that is alleged to be coextensive,” and the Board's previous efforts to announce such a rule were found erroneous. *Teva Pharms. Int'l GmbH v. Eli Lilly & Co.*, 8 F.4th 1349, 1361 (Fed. Cir. 2021). Indeed, “[s]uch a rule would be

unsound” as “the presumption of nexus would rarely, if ever, attach because virtually every innovative product inevitably has some unclaimed feature that materially affects its functionality.” *Id.* Rather, “[t]he presumption analysis requires the fact finder to consider the unclaimed features of the stated products ***to determine their level of significance and their impact on the correspondence between the claim and the products.***” *Id.* (emphasis added). Notably, the requisite level of significance for the presumption not to apply is quite high. In *Fox Factory*, the Federal Circuit concluded that a “patent claim is not coextensive with a product that includes a ‘critical’ unclaimed feature that is claimed by a different patent and that materially impacts the product's functionality....” *Id.* (internal citations omitted). By extension, where the significance of the unclaimed feature is not “critical” to the functionality of the device at issue, the presence of that feature is insufficient to render a presumption of nexus inappropriate.

Petitioner's arguments regarding the alleged lack of coextensiveness fail to demonstrate that the unclaimed features of the CURVE treadmills materially impact the products' functionality or are critical to their commercial success, as required under *Fox Factory*. First, while the CURVE treadmills include features such as “toothed belts,” “displays,” and “adjustable resistance,” these features are peripheral to the claimed invention and do not account for the commercial success of the CURVE treadmills. Petitioner's reliance on distinguishing features across CURVE

product lines, such as handrail configurations or onboard generators, conflates product differentiation with material impact. These variations serve niche customer preferences but do not detract from the core invention's contribution to the products' success. For example, the incorporation by reference of U.S. Patent No. 5,470,293 in the '005 Patent does not establish that toothed belts are critical; instead, this merely acknowledges prior art for treadmill components, unrelated to the specific features claimed in the '005 Patent. PO is entitled to a presumption of nexus because the claims are coextensive with the CURVE treadmills. *See* POR, 49-58; EX2018, ¶¶176-177; EX2083; EX1050, 22:4-13.

B. Commercial Success

Petitioner's arguments regarding the alleged lack of nexus between the uncontested and undeniable commercial success of PO's products and the claimed inventions are misplaced. PO never argued the commercial success of its products resulted from the inclusion of a safety device; indeed, the commercial success section of the POR never even mentions the safety device. POR, 58-62.

Petitioner's citations to *Dow Chemical Co. v. Halliburton*, 324 U.S. 320, 330 (1945) and *Ex Parte Jellá*, 90 USPQ2d 1009 (BPAI 2008) are misplaced. Reply, 28. The patented process in *Dow* merely applied a well-known chemical process in a new field, while the patent in *Jellá* related to a market demand-driven garage door design—but Petitioner has not identified *any* examples of curved manual treadmills

with a safety device. The CURVE treadmills were the first of their kind. EX2020, ¶9.

The POR focuses on the products as a whole, which PO has established are coextensive with the claimed inventions. POR, 49-58; *supra* §V.A. “When a patentee can demonstrate commercial success, usually shown by significant sales in a relevant market, and that the successful product is the invention disclosed and claimed in the patent, it is presumed that the commercial success is due to the patented invention.” *Chemours Co. FC, LLC v. Daikin Indus.*, 4 F.4th 1370, 1378 (Fed. Cir. 2021) (citations omitted). Petitioner fails to rebut this presumption.

Petitioner is wrong that there can be no commercial success without market share evidence. The Federal Circuit has reversed Board decisions that erroneously conclude that “gross sales figures, absent market share data, ‘are inadequate to establish commercial success.’” *Chemours*, 4 F.4th at 1378. The Board should not make the same error here, particularly when Petitioner lacks evidence to support its identification of the relevant market. Moreover, PO provided evidence that it was the sole market player until 2014 when third-party infringements began. EX2020, ¶22.

Likewise, Petitioner’s assertion that commercial success cannot be established because of unclaimed features is misplaced. “[T]he commercial success of the embodiment with additional unclaimed features is to be considered when evaluating

the obviousness of the claim, provided that embodiment's success has a sufficient nexus to the claimed and novel features of the invention.” *ArcelorMittal France v. AK Steel Corp.*, 700 F.3d 1314, 1325 (Fed. Cir. 2012). Courts “never held that the existence of one or more unclaimed features, standing alone, means nexus may not be presumed.” *Teva*, 8 F.4th at 1361 (quoting *Fox Factory*, 944 F.3d at 1374).

Here, despite bearing the burden to rebut the presumption of nexus and commercial success with actual evidence, Petitioner offers nothing but a list of purported unclaimed features and bare speculation that they contributed to the CURVE treadmills' commercial success (“sales *could be* ...”). Reply, 25-32. This is not enough. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016) (“[A] patent challenger cannot successfully rebut the presumption with argument alone—it must present evidence.”); *Polaris Indus. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018) (same). Indeed, the unclaimed features Petitioner identifies are not found in all CURVE treadmills, with very few CURVE treadmills being equipped with the sophisticated software Petitioner references, for example. EX1037, 27:8-30:8. Even with the resultant price-range for the CURVE treadmills (*id.*), the entire CURVE line has experienced commercial success, regardless of whether additional features are present, further demonstrating that commercial success is not tied to unclaimed features.

C. Industry Praise

Petitioner's arguments regarding industry praise also depend on the false premise that PO relied on a "safety device" for secondary considerations. PO established nexus for and relied on the claimed combination as a whole, not any individual feature. Thus, the mere fact that the evidence of industry praise does not reference a safety device is irrelevant.

D. Copying

Petitioner's Reply also misrepresents PO's copying evidence. PO has not relied only on the superficial appearance to show copying; certain competitor products, such as Samsara's treadmill, have been adjudged to infringe previously issued PO's patents, which include features Petitioner now claims are obvious. POR, 64-65. Combined evidence of access and substantial similarity (both in appearance and claimed features) establishes copying.

Likewise, Petitioner's blatant copying of the user manual for a specific Woodway product is relevant to whether the product in the copycat manual was itself copied. Petitioner does not deny that portions of EX2071 were copied from Woodway or attempt to rebut such evidence. Reply, 34. The copying from PO's own manual provides strong, un rebutted evidence of copying by Petitioner.

E. Failure of Others and Passage of Time

The mere fact that PO's only competitors in the curved, manual treadmill market were later copycats is clear evidence that others had failed to develop the product themselves. The Federal Circuit has recognized that, when competitors "tried and failed to develop the claimed invention and copied it instead," it evidences failure of others. *Dow Chem. Co. v. Am. Cyanamid Co.*, 816 F.2d 617, 622 (Fed. Cir. 1987). As PO explained, this is precisely what happened here. *See* POR, 67 ("until others in the industry started to copy Patent Owner's CURVE products, Patent Owner was the only provider of curved, manual treadmills in the market"). Petitioner's bald assertions that there was no failure of others ignores this evidence and must fail.

With respect to passage of time, Petitioner relies only on the supposed lack of long-felt need or failure of others to support disregarding the significant gaps between the prior art and date of invention. Reply, 35. Because PO demonstrated failure of others, Petitioner's arguments must fail.

Dated: December 17, 2024

By: /R.J. McKenna/
Richard J. McKenna
Registration No. 35,610
Counsel for Patent Owner

CERTIFICATE OF COMPLAINT

This Preliminary Patent Owner Response complies with the type-volume limitations required by 37 C.F.R. §42.24. The word count in this paper totals 5,586 words. Patent Owner has relied upon the word count feature of Microsoft Word.

Dated: December 17, 2024

/R.J. McKenna/
Richard J. McKenna
Registration No. 35,610
Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S SURREPLY** was served on December 17, 2024, by email to Petitioner's counsel of record:

aturner@brookskushman.com

jhalan@brookskushman.com

rcantor@brookskushman.com

kkonz@brookskushman.com

LCF113IPR@brookskushman.com

Dated: December 17, 2024

/R.J. McKenna/
Richard J. McKenna
Registration No. 35,610
Counsel for Patent Owner