

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STRAVA, INC.; MAPMYFITNESS, INC.; &
FITNESSKEEPER, INC.
Third Party Requesters

v.

ICON HEALTH & FITNESS, INC.
Patent Owner

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1¹
Technology Center 3900

Before: STEVEN D. A. McCARTHY, DANIEL S. SONG, and
BRETT C. MARTIN, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Issued September 7, 2010 to Scott R. Watterson et al. (hereinafter referred to as the '800 patent).

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

STATEMENT OF THE CASE

The Patent Owner appeals under 35 U.S.C. § 134(b) and 315(a) from the Examiner's rejection of claims 7, 11, 12, 39–43, 45, 46, 50–54, 56–71, 73, 74, and 77–100. The Requesters appeal the Examiner's non-adoption of proposed rejections of claims 39–65, 80–87, and 98–100. Claims 1–37 were original to the '800 patent and claims 38–100 were added during the reexamination prosecution. Claims 1–6, 8–10, 13–38, 44, 47–49, 55, 72, 75, and 76 were cancelled during the reexamination prosecution. We have jurisdiction under 35 U.S.C. § 6(b).

We are informed that the '800 patent is the subject of five litigations pending in the US District Court for the District of Utah:

Icon Health & Fitness et al. v. Garmin Ltd. et al., Civil Docket No. 1:11-cv-00166-DB, filed November 11, 2011;

Icon Health & Fitness et al. v. Polar Electro Oy, Civil Docket No. 1:11-cv-00167-PMW, filed November 11, 2011;

Icon Health & Fitness et al. v. FitnessKeeper, Inc., Civil Docket No. 1:11-cv-00173-CW, filed December 9, 2011;

Icon Health & Fitness et al. v. MapMyFitness, Inc., Civil Docket No. 1:11-cv-00174-DB, filed December 9, 2011; and

Icon Health & Fitness et al. v. Strava, Inc., Civil Docket No. 1:11-cv-00175-CW, filed December 9, 2011.

We AFFIRM the Examiner's decision. Because this affirmance sustains rejections of all pending claims we decline to reach the Requesters' cross-appeal.

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

THE INVENTION

The Patent Owner's invention "relates to exercise equipment and, more specifically, to systems and methods for providing improved exercise devices in combination with other users and/or a live or stored trainer via a communications network. Spec. col. 1, ll. 48–51. Claims 1² and 7, reproduced below, are illustrative of the claimed subject matter:

1. An exercise system, comprising:
 - a portable physical activity sensing system comprising:
 - a sensor configured to be associated with a user and configured to sense a physical activity parameter of the user during the performance of physical activity by the user; and
 - a memory in communication with the sensor, wherein the sensor communicates data representative of the sensed physical activity parameter to the memory, and wherein the memory stores the data representative of the sensed physical activity parameter; and
 - a separate communication system comprising:
 - a communication device for receiving physical activity related information from the portable physical activity sensing system;
 - a memory configured to store physical activity related information regarding the user of the portable physical activity sensing system; and
 - a processor configured to analyze and update information received from the portable physical activity sensing system, wherein the communication device sends information either to the portable physical activity sensing system, to the user of the portable physical activity sensing system, or to both the user and the portable physical activity sensing system, and wherein the portable physical activity sensing system records information about the user's physical activity and sends the information to the separate communication system, the

² Claim 1 was cancelled, but claim 7, which is on appeal, depends from claim 1.

Appeal 2015-004767

Reexamination Control No. 95/002,359

Patent US 7,789,800 B1

separate communication system updates the user's stored information with the information received from the portable physical activity sensing system, and wherein the user may access the updated information stored by the separate communication system.

7. The exercise system of claim 1, wherein the memory of the portable physical activity sensing system comprises a removable memory.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Schminke	US 4,860,763	Aug. 29, 1989
Matthews	US 4,867,442	Sep. 19, 1989
Dempsey	US 5,417,222	May 23, 1995
Browne	US 5,598,849	Feb. 4, 1997
Tsuda	US 5,906,581	May 25, 1999
Root	US 6,013,007	Jan. 11, 2000
Poulton	US 6,066,075	May 23, 2000
Pyles	US 6,175,608 B1	Jan. 16, 2001
Hickman	US 6,193,631 B1	Feb. 27, 2001
Larson	US 6,196,631 B1	Mar. 6, 2001
Jacobsen	US 6,198,394 B1	Mar. 6, 2001
Mault	US 6,513,532 B2	Feb. 4, 2003
Shum	US 6,585,622 B1	July 1, 2003
Stubbs	US 6,736,759 B1	May 18, 2004
Narayanaswami	US 7,477,890 B1	Jan. 13, 2009
Teller	US 7,689,437 B1	Mar. 30, 2010
Schweikhardt	WO 87/05727 A1	Sep. 24, 1987
Kuusela	WO 97/49077 A1	Dec. 24, 1997
Henderson	WO 98/00204 A1	Jan. 8, 1998
Margulis	WO 99/30613 A1	June 24, 1999
Damen	WO 99/44016 A1	Sep. 2, 1999

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

THE REJECTIONS ON APPEAL

The Examiner made the following rejections:

1. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root and Tsuda. RAN 5.
2. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Matthews and Tsuda. RAN 6.
3. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Browne and Tsuda. RAN 6.
4. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickman and Matthews. RAN 7.
5. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schweikhardt and Tsuda. RAN 8.
6. Claims 11 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews and Schminke. RAN 9.
7. Claims 11 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Browne and Schminke. RAN 10.
8. Claims 11 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hickman and Matthews. RAN 10.
9. Claims 11 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schweikhardt and Schminke. RAN 11.
10. Claims 39, 64, 79, 80, 84, 85, 87–89, 91, 93, and 95–100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root and Jacobsen. RAN 12.

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

11. Claims 40–42, 50–52, 54, 56, 63, and 81–83 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Jacobsen, and Henderson. RAN 16.
12. Claim 57–62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Jacobsen, Henderson, and Teller. RAN 18.
13. Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Jacobsen, Henderson, and Poulton. RAN 18.
14. Claims 45, 46, and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Jacobsen, Henderson, and Narayanaswami. RAN 19.
15. Claims 65, 86, 90, 92, and 94 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Jacobsen, and Teller. RAN 19.
16. Claims 39, 64, 79, 80, 84, 85, 88, 89, 91, 93, 95, and 97 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root and Stubbs. RAN 20.
17. Claims 40, 51, 52, 54, 56, 63, 81–83, and 87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Stubbs, and Henderson. RAN 20.
18. Claims 41–44 and 48–50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Stubbs, Henderson, and Jacobsen. RAN 20.
19. Claims 45 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Stubbs, Henderson, Jacobsen, and Narayanaswami. RAN 21.

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

20. Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Stubbs, Henderson, Jacobsen, and Dempsey. RAN 21.

21. Claim 53 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Stubbs, Henderson, and Narayanaswami. RAN 21.

22. Claim 57–62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Stubbs, Henderson, and Teller. RAN 22.

23. Claims 65, 86, 90, 92, and 94 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Stubbs, and Teller. RAN 22.

24. Claim 96 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Stubbs, and Jacobsen. RAN 23.

25. Claims 66 and 67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root and Teller. RAN 23.

26. Claims 68 and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Teller, and Henderson. RAN 24.

27. Claims 70, 72, and 76 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Teller, Henderson, and Jacobsen. RAN 25.

28. Claim 71 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Teller, Henderson, Jacobsen, and Poulton. RAN 25.

29. Claims 73 and 74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Teller, Henderson, Jacobsen, and Narayanaswami. RAN 26.

30. Claim 75 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Teller, Henderson, Jacobsen, and Dempsey. RAN 26.

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

31. Claims 77 and 78 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Teller, and Pyles. RAN 27.
32. Claim 98–100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root and Shum. RAN 27.
33. Claims 38, 39, 79, 88, 91, 93, 95, and 97 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root and Margulis. RAN 27.
34. Claims 40 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, and Henderson. RAN 28.
35. Claims 41, 42, 45, 49, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Henderson, and Narayanaswami. RAN 28.
36. Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Henderson, Narayanaswami, and Poulton. RAN 29.
37. Claims 44 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Henderson, Narayanaswami, and Mault. RAN 29.
38. Claim 46 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Henderson, Narayanaswami, and Jacobsen. RAN 29.
39. Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Henderson, Narayanaswami, and Dempsey. RAN 30.
40. Claims 52, 55, 56, and 63 stand rejected under 35 U.S.C.

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

§ 103(a) as being unpatentable over Root, Margulis, Henderson, and Damen.
RAN 30.

41. Claims 53 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Henderson, Damen, and Narayanaswami. RAN 30.

42. Claim 57–62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Henderson, Damen, and Teller. RAN 31.

43. Claim 64 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, and Narayanaswami. RAN 31.

44. Claim 65 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Damen, and Teller. RAN 33.

45. Claims 80 and 84 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, and Damen. RAN 34.

46. Claim 85–87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, Damen, and Teller. RAN 34.

47. Claims 89, 90, 92, and 94 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, and Teller. RAN 34.

48. Claim 96 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root, Margulis, and Mault. RAN 35.

ANALYSIS

Rejections of Claim 7

The Patent Owner argues these rejections as a group. App. Br. PO 6. In particular, the Patent Owner argues that each of the rejections involving Tsuda is improper because Tsuda is not portable as required by claim 7. *Id.* This is allegedly so because Tsuda teaches a stationary exercise bike and

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

that the cuff used to measure vital signs of the user is connected to the stationary bike. *Id.* The Examiner and Requesters maintain that combinations involving Tsuda are proper both because Tsuda is portable and because the portable aspect is taught by the other references, and thus Tsuda need not teach this. Resp. Br. R 3–5. We agree with the Requesters and the Examiner on both points.

The Patent Owner suggests that Tsuda is not portable because it is not "designed to be *easily* carried or moved by a user." App. Br. PO 7. We see no basis for the interjection of a degree of ease of portability by the Patent Owner because there is no specific definition in the Specification limiting the meaning of portable to being *easily* moved about and that a broad, but reasonable definition of portable is simply that it is capable of being carried or moved about as pointed out by the Requesters. Resp. Br. R 4. Under that definition, we agree that a stationary exercise bicycle, while maybe less portable than a memory card, is nonetheless portable to the extent required by the claims.

Further, even if we did agree with the Patent Owner on this point, it is irrelevant because the claims do not require portability of the exercise system itself, in this case the bicycle, but of the physical activity sensing system. The Examiner relies upon Tsuda to teach a removable memory card. RAN 36. The Examiner does not rely upon Tsuda to teach portability of the physical activity sensing system. The devices of each of Root, Matthews, and Browne, are, as admitted by the Patent Owner, portable devices. App. Br. PO 6. We agree with the Requesters and the Examiner,

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

that the combinations as suggested by the Examiner could be easily adapted to include removable memory as taught in Tsuda.

Also, the fact that the read/write device is not portable in Tsuda is not dispositive because Tsuda need not teach such portability. The Patent Owner has not persuasively argued that Tsuda's read/write capability would not have been adaptable to the portable devices of Root, Matthews, and Brown, but merely asserts that because the entire system of Tsuda is not portable, that the read/write device also would not be portable. We see no basis for finding that the read/write device of Tsuda would be incompatible with the portable devices of any of Root, Matthews, and Brown. Accordingly, we sustain the Examiner's rejections of claim 7 involving Tsuda and any of Root, Matthews, and Brown.

Regarding the Examiner's rejection of claim 7 over Schweikhardt and Tsuda, we agree with the Requesters that the mistaken mention of Root rather than Tsuda on page 38 of the RAN does not change the original rejection. The Patent Owner has not persuasively argued why the combination of Schweikhardt and Tsuda is deficient as otherwise explained by the Examiner and further detailed by the Requesters in the original Request and subsequent comments during the reexamination prosecution. *See* Resp. Br. R 5. We further agree with the Requesters that the "if the PDU records data from the sensors and transfers the recorded data to the plug, the sensors and plugs must be 'in communication', even if only indirectly." *Id.* Accordingly, we are not persuaded of error in the Examiner's rejection of claim 7 over Schwekhardt and Tsuda.

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

As to the rejection over Hickman and Matthews, the Patent Owner again argues the references individually without addressing the overall combination. Specifically, in this case, the Patent Owner argues that Hickman teaches away from Matthews because Matthews disparages devices that are not portable. App. Br. PO 9. Even granting that there is a form of disparagement, such would not be teaching away because the device of the combination would still be portable. Accordingly, we are not persuaded of error in the combination of Hickman and Matthews.

The Patent Owner also argues that Hickman fails to teach writable memory because it discloses only a CD-ROM, which is a Read-Only-Memory. App. Br. PO 11. Requesters, however, have submitted evidence, in the form of a Declaration of Frank Koperda stating that, although ROM stands for Read-Only-Memory, at the time of Hickman, writeable optical discs and optical drives capable of both reading and writing to optical discs were well known so that "it would have been obvious to one of ordinary skill in the art to incorporate a read/write feature into the CD-ROM drive of Hickman in order to write data to the CD and extend the memory capabilities of Hickman." Resp. Br. R 8, quoting Koperda Decl. ¶ 15. The Patent Owner asserts that this declaration is insufficient because it is not record evidence under *K/S HIMPP v. Hear-Wear Technologies, LLC*, 751 F.3d 1362 (Fed. Cir. 2014). App. Br. PO 11. The Patent Owner asserts that only documentary evidence is record evidence and that only a piece of prior art showing that optical discs were known to be writeable would suffice. *Id.* We disagree.

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

The rejection of claim 7 is based on the teachings of two patents, namely, Hickman and Matthews. Mr. Koperda's declaration merely explains how one of ordinary skill in the art would have understood the teachings of Hickman and what would have been obvious to a person of ordinary skill in the art at the time of invention. A declaration is record evidence, just as a piece of prior art would be, and the Patent Owner has not challenged the correctness of the evidence submitted, merely the form. The facts here differ from those in *K/S HIMPP*. In *K/S HIMPP*, our reviewing court sustained the Board's decision not to credit assertions regarding the knowledge of one of ordinary skill in the art without evidence to support the assertions. Here, Mr. Koperda's declaration supports the Examiner's finding that writable optical discs were known at the time of invention, and the conclusion that providing a writing feature would have been obvious to one of ordinary skill in the art. Accordingly, we are not persuaded that Hickman teaches only read-only-memory and sustain the Examiner's rejection of claim 7 over Hickman and Matthews.

Rejections of Claims 11 and 12

The Patent Owner alleges that the combinations involving Schminke are improper because Schminke teaches away from such combinations. App. Br. PO 12. The Examiner, however, merely utilizes the teaching in Schminke that one could have either "the separate communication system remote from the portable physical activity sensing system as shown in figure 1 or have it integrated with the exercise device as taught in figure 2." RAN 42. Thus, the Examiner uses Schminke to teach that an alternative to the type of remote system taught in all of the references, including Schminke,

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

would be to use an integrated system as also taught in Schminke. This is not teaching away, but utilizing an advantage taught by Schminke and applying it to the other prior art teachings. As such, we are not persuaded of error and affirm the Examiner's rejection.

The Patent Owner merely repeats the arguments discussed *supra* that Hickman and Matthews are not properly combinable. We reject those arguments for the same reasons as discussed above. As such we sustain the Examiner's rejections of claims 11 and 12.

Rejections over Narayanaswami and Teller

The Patent Owner's only arguments regarding these rejections are that the references are not prior art based on the submission of the Declaration under 37 C.F.R. § 1.131 that allegedly swears behind the references. (*See* Ex. 1 to the App. Br. PO). We agree with the Requesters that the Declaration is insufficient because the Patent Owner "makes no attempt...to point to specific evidence supporting each of the claim limitations." Resp. Br. R 12. The mere allegation that "[t]he '410 Application³ fully discloses and supports the Invention" is insufficient. Dec. ¶ 3. Furthermore, the Patent Owner appears to admit that the documentary evidence is insufficient to prove that all aspects of the invention were conceived prior to the references at issue and thus points to paragraph 13 of the declaration for anything missing. App. Br. PO 14. Paragraph 13 is merely an uncorroborated statement by the inventors that:

Although the screenshots of the earliest models of embodiments of the Invention shown in Exhibits B and C do not illustrate

³ The '410 Application refers to US Patent Application 09/776,410 to which the '800 patent claims priority.

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

each of the features of the Invention, we had jointly formed in our minds a definite and permanent idea of all of the features of the Invention prior to the last modification of the first model shown in Exhibit B on June 14, 2000.

Such uncorroborated testimony is insufficient to prove an earlier date of invention. Thus we deem Narayanaswami and Teller prior art and sustain the Examiner's rejections over these references.

The "Over the Internet" and "E-mail" Limitations

Regarding the rejections that the Patent Owner argues as insufficient for failing to teach the "over the Internet" limitation (App. Br. PO 14–18), we agree with the Examiner and the Requesters that it would have been obvious to send such data or information over the Internet. *See* Resp. Br. R 12–13. As the Requesters point out (Resp. Br. R 13), Root even specifically discloses that such information could be sent over a conventional telephone line using dial-up modems and that such information eventually ends up on the associated website. *See, e.g.*, RAN 52, citing Root 2:36–39; *see also* Root 6:29–41. For the reasons stated by the Requesters, we agree with the Examiner that it would have been obvious to send such information over the Internet as claimed. *See also* RAN 51–52, 69; Requesters' Comments to the Action Closing Prosecution 7–8.

Regarding the e-mail limitation, which requires users being able to correspond via e-mail using the claimed website, we see no basis for the Patent Owner's assertion that Root's disclosure requires the use of an entirely separate website. App. Br. PO 18. In the portion cited by the Requesters (Root, col. 9, ll. 55–60), Root describes various things that happen via the website. As the Patent Owner admits, this portion of Root teaches "users posting and exchanging favorite local courses via the Internet website"

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

(App. Br. PO 18). In fact, everything in the cited portion of Root appears to occur via the website. We see no persuasive basis to conclude that because Root does not explicitly state that the e-mail is sent via the website that it is not (or that it would not have been obvious to do so). Contextually, the passage at issue is describing features of the website and, absent disclosure to the contrary, it stands to reason that the e-mail, as with the other data discussed, is also sent via the website.

Additionally, the Patent Owner argues that Root's e-mail is not "real-time" as claimed because it is "asynchronous non-real-time communication, as opposed to synchronous 'real-time' communication." Reply Br. PO 11 (emphasis removed). Claim 97 recites nothing regarding synchronous or asynchronous communication and requires only that the communication be "real-time." Given Mr. Koperda's un rebutted declaration testimony (¶¶ 37–49) that the communication disclosed in Root can be considered real-time consistent with the '800 patent Specification we agree with the Requesters that what is disclosed in Root is sufficiently real-time to meet the limitation of claim 97. Accordingly, we are not persuaded by the Patent Owner's arguments and sustain the Examiner's rejections of claims 39–43, 45, 46, 50–54, 56–65, 79–97, 99, and 100.

Remaining Arguments

The Patent Owner makes a series of additional arguments stating why certain claims are improperly rejected by the Examiner. *See* App. Br. PO 21–32. While we deal with certain specific arguments *infra*, most of these arguments are merely cumulative or restatements of arguments already dealt with above and are also unpersuasive. To any extent we do not specifically

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

address any of these remaining arguments, we agree with the Requesters' rebuttal of such (Resp. Br. R 15–23) as well as the Examiner's response to the same (RAN 53–68).

Third Computing Device

The Patent Owner alleges that the rejections of claims 40–43, 45, 46, 50–54, 56–63, 68–71, 73, 74, and 81–83 are improper for failure to disclose the recited third computing device element. As the Examiner states:

It is noted that Henderson teaches 10:17–21 "[i]ncline sensor 144 ... is driven by CPU 126 ... ". As noted above, Henderson teaches the heart rate monitor 124 communicates via an RF transceiver with route computer 108. Using RF transceivers to wirelessly communicate between computing devices is old and well known as exemplified by Henderson. If the incline sensor 144 requires a CPU to record the changes in inclination and transmit the information to the route computer 108 then the third computing device would likewise include a processor, memory and a RF wireless interface. Such would have been an obvious provision in the Root exercise system to record cycle parameters.

We further agree with the Requesters that this claim element is not skipped over as asserted by the Patent Owner, but is clearly detailed in the original Request. *See* Resp. Br. R 15 (citing to TPR Comments to ACP 11–13 and the Koperda Declaration). Accordingly, we are not persuaded of error regarding this aspect of the Examiner's rejections.

Virtual Reality Display

The Patent Owner argues that Poulton does not teach a portable virtual reality display (App. Br. PO 22) and therefore the rejection is deficient, but as the Requesters point out, the '800 patent does not describe a virtual reality display that is part of the portable device (Resp. Br. R 16).

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

The Patent Owner selectively cites the Specification to assert that the display 622 must be portable, but when looking at the disclosure as a whole, as pointed out by the Requesters, the '800 patent discloses that "display 622 can be remote from control device 604" and that this remote "display 622 can be a virtual reality (VR) display, cathode ray tube (CRT), and the like." Spec. col. 51, ll. 57–60. As such, the disclosure does not support an integral VR display, but discusses remote VR displays only. Also, given that the '800 patent equates VR displays to CRT displays, the disclosure in Poulton of a mosaic of CRT displays is equivalent to that disclosed in the '800 patent with respect to any alleged portability as asserted by the Patent Owner. Further, "a virtual reality display" does not necessarily require a single discrete monitor as argued by the Patent Owner (App. Br. PO 23), but may encompass a mosaic of monitors that acts as a single virtual reality display. Accordingly, we do not find this argument persuasive and sustain the Examiner's rejection of claims 43 and 71.

Button

Regarding claims 45, 46, 53, and 73, the Patent Owner alleges that a "button" as claimed "had a very specific meaning to one having ordinary skill at the time of the invention, and generally refers to a 'touch sensitive control' that has only two states." App. Br. PO 24. The Patent Owner goes on to assert that Narayanaswami discloses only a squiggle input function that is more complicated than a simple button. *Id.* This selective citation, however, ignores additional disclosure that specifically states that "the touch sensitive panel is provided with a four (4) position touch screen" and that "forward and back navigation for Wrist Watch displays is enabled by

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

physically touching certain areas of the touch sensitive panel." Spec., col. 5, ll. 31–35. Clearly the input disclosed in this passage is of the type that has only two states, pressed or unpressed, as argued. Accordingly, we do not find this argument persuasive and sustain the Examiner's rejection.

Voice Activated Controller

The Patent Owner argues that the rejection of claims 46 and 74 is improper because the Examiner erroneously relies upon the microphone 640 of Jacobsen. App. Br. PO 24. Without rebutting the substance of the declaration, the Patent Owner again repeats the argument that Mr. Koperda's declaration evidence supporting the obviousness of this element is insufficient as not being "record evidence." We do not find this argument persuasive for the reasons stated above. Furthermore, as the Requesters state, "without specifically addressing the portions of Jacobsen cited by Requesters, [Patent Owner] makes a blanket statement that Jacobsen does not teach the 'two-way audio radio' limitation." Resp. Br. R 18. Accordingly, we find the Examiner's rejection sufficiently supported by the record and are not persuaded by the Patent Owner's arguments.

As to claims 57–62 and 65, the Patent Owner merely restates previous arguments regarding the contacts of the cradle as discussed above.

Analyze

The Patent Owner argues that the Examiner erred in relying upon Root because the Examiner allegedly relied on the personal computer aspect of Root and not the portable device as required by the claims. App. Br. PO 28. As the Requesters points out, however, "Root's *portable device* 'can also be used as a health monitoring and **analysis tool**' (Root 3:11–12 . . .) and is

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

capable of 'showing **progress and trends**', i.e. analysis, (Root 10:18–19).' Resp. Br. R 20. Again, the Patent Owner's selective citation of the references fails to address portions specifically noted by both the Examiner and the Requesters that teach the claimed analysis. Accordingly, we sustain the Examiner's rejection of claims 66–71, 73–75, 77, and 78.

Coupling to Clothing

The Patent Owner argues that the rejection of claims 77 and 78 is deficient because Pyles teaches a strap to mount the device to the waist rather than being configured to couple to clothing. App. Br. PO 28–29. As pointed out by the Requesters, however, Pyle specifically references Sutton, US Patent No. 5,117,444, issued May 26, 1992, which teaches a pedometer on a belt, which is clothing. Resp. Br. R 21; *see also* Sutton 5:20–25.

Requesters also point out that Root specifically "discloses 'unit 101 can be hooked to an athlete's **belt or waistband 203 with a clip** 119 (FIG. 1B) as shown in Fig. 2.'" (Root at 5:1–3 (emphasis added).") Resp. Br. R 21.

Accordingly, the Examiner's rejection is properly supported and we sustain it.

Regarding claim 86, the Patent Owner merely restates arguments already addressed previously.

Login Information

The Patent Owner argues that the rejection of claim 91 is improper because Root does not teach obtaining login information from the user. App. Br. PO 30. The Patent Owner also takes issue with Requesters' use of an example of a member number as being evidence of this teaching. *Id.* As the Requesters argue, however, the example is not even necessary because in

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

order to log on to a web site, such a website must, by definition, obtain login information from the user. Resp. Br. R 22. We agree. The mere act of logging on must comprise obtaining login information from the user or else there would be no logging on, there would simply be use of the website. We find this argument unpersuasive and sustain the Examiner's rejection.

Direct Interaction

Regarding claim 92, the Patent Owner argues that the rejection fails to support the element requiring direct interaction via a website because "it is conceivable that the[] personal fitness recommendations could be automatically generated for the user without any involvement of a 'personal trainer.'" App. Br. PO 31. While it may be true that it could be done without direct involvement, Root clearly discloses that users may interact directly with each other via e-mail as discussed *supra*. Furthermore, Teller specifically discloses that "a member may also grant access to his or her data to a third party such as a health care provider or a personal trainer." Teller 12:1–3. As the Requesters point out, this is an obviousness rejection and the combination of the teachings sufficiently suggests that, using the direct communication taught in Root, one of ordinary skill in the art would have understood that a personal trainer given access to user data as taught in Teller, could also provide the fitness recommendations. We see no deficiency in this obviousness rejection and therefore are unpersuaded by the Patent Owner's arguments.

Accelerometer

The arguments with regard to the rejection of claims 98–100 focus on one supporting rationale for the rejection (mere substitution) while ignoring

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

other rationales set forth by the Examiner and/or the Requesters. As the Requester points out in its Comments after the ACP, the Patent Owner "omits that Requester[s] also asserted that incorporating Shum's accelerometer into the system of Root would have been no more than **'combining prior art elements** according to known methods to yield predictable results. (MPEP 2143.)' (CC-Rsh at 98–1.)" Comments after ACP, 32. We agree that, regardless of the mere substitution rationale, the rejection may properly be supported by the other rationales, which the Patent Owner does not challenge. Accordingly, we sustain the Examiner's rejection.

DECISION

For the above reasons, we AFFIRM the Examiner's decision to reject claims 7, 11, 12, 39–43, 45, 46, 50–54, 56–71, 73, 74, and 77–100.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED

Appeal 2015-004767
Reexamination Control No. 95/002,359
Patent US 7,789,800 B1

PATENT OWNER:

MASCHOFF BRENNAN
1389 CENTER DRIVE, SUITE 300
PARK CITY, UT 84098

THIRD PARTY REQUESTER:

STERN, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

CU