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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHNSON HEALTH TECH CO. LTD. and
JOHNSON HEALTH TECH NORTH AMERICA, INC.,
Petitioners,

v.

ICON HEALTH & FITNESS, INC.,
Patent Owner.

Case IPR2014-00184
Patent 8,298,123 B2

Before JOSIAH C. COCKS, BRIAN J. McNAMARA, and CARL M. DEFRANCO JR., *Administrative Patent Judges.*

DEFRANCO, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Johnson Health Tech Co. Ltd. and Johnson Health Tech North America, Inc. (collectively "Johnson") filed a Petition ("Pet.") for *inter partes* review of claims 1–10 of U.S. Patent No. 8,298,123 B2 ("the '123 patent"). On January 30, 2014, we instituted an *inter partes* review of the '123 patent ("Dec. to Inst.") on grounds of unpatentability under 35 U.S.C. § 103.

After a period of discovery, Icon Health & Fitness, Inc. ("Icon"), the owner of the '123 patent, filed a Patent Owner Response ("PO Resp.").[1] Johnson, in turn, filed a Reply ("Reply") to Icon's Response. An oral hearing was held on February 10, 2015, and a transcript (Paper 32, "Tr.") has been entered into the record. We have jurisdiction under 35 U.S.C. § 6(c). For the reasons that follow, we conclude that Johnson has proven by a preponderance of the evidence that claims 1–10 of the '123 patent are unpatentable.

II. BACKGROUND

A. The '123 Patent[2]

The '123 patent relates to an exercise and health system comprised of two parts: (1) a "local system" having "one or more health or fitness devices," such as a stationary bicycle or weight machine, each equipped with a computer that serves to "provide feedback and encouragement to the user" of the device; and (2) a "remote computer system," in communication with the local system, "which can be used to monitor the progress and to *vary the*

[1] Icon did not file a motion to amend the claims.

[2] The '123 patent is the subject of a concurrent district court action, *ICON Health & Fitness, Inc. v. Johnson Health Tech N. Am., Inc.*, No. 1:13-cv-112 (D. Utah, filed Aug. 7, 2013). Pet. 1.

exercise program or script" of the user. Ex. 1001, 2:34–54, 4:18–22, Fig. 1 (emphasis added). The remote system communicates interactively with the local system via a "modem" and "telephone line," or alternatively, "via a wide-area network (WAN) such as the Internet." *Id*. at 5:59–66, 6:23–30.

Notably, the remote system can be operated by a "human personal trainer" to upload information from the local system "to be analyzed . . . at the remote computer." *Id*. at 2:56–66. The personal trainer can then provide the user of the fitness device with "additional instruction, encouragement, and cautions" and download "*new exercise scripts or programs* to the local system computer to implement these changes." *Id*. at 2:56–3:3 (emphasis added); *see also id*. at 10:48–50 ("information can be downloaded to the local system . . . to, for example, change exercise scripts"). Operated in this manner, the local system can serve as a "virtual personal trainer" for the user. *Id*. at 2:54–55.

B. The Challenged Claims

Johnson challenges the patentability of claims 1–10 of the '123 patent (Pet. 7–50), and we instituted *inter partes* review of all ten claims (Dec. Inst. 19). Claim 1 is the sole independent claim, and recites:

> 1. A local exercise system comprising:
>
> at least one exercise apparatus; and
>
> at least one associated local computer configured to control an operation of said exercise apparatus based upon a script stored in a read/write memory of said local computer, said script having been received over a wide area network interface from a remote server system, the script defining an exercise session that is to be performed at the local system, wherein the script specifies a number of exercise related steps to be performed by the exercise apparatus as part of the exercise session,

> wherein the local system is configured to detect a selection corresponding to said script and to the exercise session that is implemented during execution of said script,
>
> wherein the local system is configured to process the exercise session by initiating execution of the modifiable script as part of the exercise session, and
>
> wherein the local system is configured, in response to at least one of monitored user performance or user input detected at the local system, to determine to carry out a different number of exercise related steps than the number of exercise related steps specified by the script, and is configured to thereafter, upon determining that the session has not been completed, continue to process the exercise session.

Ex. 1001, 12:28–52.

C. The Instituted Grounds of Unpatentability

This *inter partes* review addresses the issue of whether claims 1–10 of the '123 patent would have been unpatentable under 35 U.S.C § 103 as obvious over Dyer,[3] or the combination of Dyer with Poulton.[4]

III. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under this standard, claim terms generally are given their ordinary and customary meaning, as understood by one of ordinary skill in the art in the context of the patent's entire written disclosure. *In re Translogic Tech., Inc*., 504 F.3d 1249, 1257 (Fed. Cir. 2007). However, a "claim term will not receive its ordinary

[3] US Patent No. 4,828,257, iss. May 9, 1989 (Ex. 1002).
[4] US Patent No. 5,702,323, iss. Dec. 30, 1997 (Ex. 1012).

meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history." *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

Here, the parties focus on the construction of three claim terms, specifically, "script," "wide area network interface," and "exercise related step." As such, we make explicit the construction of these terms. All other terms in the challenged claims need not be construed expressly.

1. "script"

Claim 1 recites that the local computer is configured to control the exercise apparatus "based upon a script" stored in the computer's memory. Throughout the specification, the term "script" is used interchangeably with the term "exercise program." *See, e.g.*, Ex. 1001, 2:53–54 ("exercise program or script"), 3:2 ("new exercise scripts or programs"), 7:56–57 ("a user 'script' of what kind of exercise program"). Stating the "exercise program" of a user proceeds according to "scripts," the specification further explains that "[a] script is simply a sequence of exercise or other health-related events that are performed in fixed or variable sequences." Ex. 1001, 8:5–8. The specification goes on to describe a script in terms of "steps or parameters [that] can be modified" (*id*. at 12–13) and "a desired exercise session which can be varied" (*id*. at 23–24). Consistent with those descriptions, we construe the term "script" to mean "an exercise program

consisting of steps and parameters that may be performed in fixed or variable sequence."[5]

2. "wide area network interface"

Claim 1 recites the script as being received at the local computer "over a wide area network interface" from the remote system. Johnson proposes an interpretation of this term that includes a telephone modem and line. Pet. 5–6. The claim term "wide area network" appears once in the specification, which reads in pertinent part:

> The computer 24 is also coupled to a modem 62 for communication over a telephone line 30. *Alternatively, the computer 24 can be coupled to the remote computer 14 by other communication linkages, such as ISDN digital transmission line, via a local area network, or via a wide area network (WAN) such as the Internet*. In other words, the telephone line 30 represents only one type of data communication channel between the local systems 12 and the remote system 14.

Ex. 1001, 5:59–66 (emphasis added).

This description gives one example of a "wide area network interface," namely, the internet, and describes the "wide area network" in terms of a computer network. Importantly, the use of the words "[a]lternatively" and "other" alters the plain meaning of the term by drawing a clear distinction between "a wide area network" and "a telephone line." As described, the local system computer can be connected to the remote system computer by "a modem [and] telephone line," or alternatively, by "*other communication linkages*," such as "a wide area network (WAN)." *Id*. That description distinguishes a wide area network link from a telephone

[5] At oral hearing, Icon agreed that a "script" is an "exercise program" made up of "sets" and associated "parameters" such as "weight" and "a number of repetition[s]." Tr. 43–44.

line link. As such, we are not persuaded that a "wide area network interface" necessarily includes a modem/telephone line, as Johnson proposes. *See* Pet. 5–6. Rather, in keeping with the broadest reasonable interpretation consistent with the specification, we construe the term "wide area network interface" to mean "a communication link with a network of computers interconnected over a wide area, such as the internet."

3. "exercise related step"

Claim 1 recites that the local system is configured "to carry out a different number of exercise related steps than the number of exercise related steps specified by the script." Icon asserts that the term should be construed as an exercise "set." PO Resp. 9. Johnson does not propose any construction for this term aside from its plain and ordinary meaning. Pet. 4.

The specification uses the term "step" in the context of describing the "order and structuring of the script," for example:

> if it is detected that the user is getting tired due to a slowing of the exercise repetition rate, the *steps* or parameters *of the exercise script* can be modified accordingly. In other words, certain *script steps* can be skipped or the *parameters concerning the steps* can be modified. For example, if a user is determined to be tiring by the local system 12, and if *the script says the next exercise event is to be ten repetitions on the weight trainer 20, that step* could be skipped. Alternatively, the *weight training step* could still be done, but the resistance parameters could be modified. For example, instead of doing ten repetitions at a hundred pounds resistance on the weight trainer 20, eight repetitions at eighty pounds of resistance might be called for.

Ex. 1001, 8:10–22 (emphases added). This portion of the specification distinguishes between "steps" and "parameters concerning the steps." As described, a "step" is a particular segment of an overall exercise program

that includes either a particular station for weight training *or* a particular group, or set, of repetitions on the weight trainer. In contrast, a "parameter" is a characteristic of the weight training step, such as the precise number of pounds or repetitions. Thus, changing the number of steps or segments of an exercise program is distinct from changing the parameters that characterize the particular step or segment. With that description in mind, we construe the term "exercise related step" to mean "a particular segment of an exercise program, where the segment may be a period of exercise on one of the exercise stations used in the exercise program, or may be a group, or set, of repetitions at one of the exercise stations."

B. The Grounds of Obviousness

In the Preliminary Proceeding,[6] we instituted trial on obviousness grounds that included claims 1–10, determining there was a reasonable likelihood that Johnson would prove the claims unpatentable over either Dyer alone or in combination with Poulton. Dec. to Inst. 19. Rather than address each of the ten claims on which we instituted trial, Icon, in its Patent Owner Response, focuses exclusively claims 1, 2, 4, and 6. *See* PO Resp. 2, 13. That is, Icon presents evidence and argument only in support of "Claim 1," "Claim 2," "Claim 4," and "Claim 6" (*see id*. at 6, 13, 17, 21), but is silent on the patentability of claims 3, 5, and 7–10. Given Icon's partial response to the Petition, we divide our analysis in two parts, discussing, first, those claims that Icon addresses in its Patent Owner Response, and, second, those claims that Icon leaves unaddressed.

[6] A "Preliminary Proceeding," as defined by our rules, "begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted." 37 C.F.R. § 42.2.

1. Claims 1, 2, 4, and 6

Johnson argues that claims 1, 2, 4, and 6 are unpatentable over Dyer alone and provides a detailed explanation of how Dyer meets each limitation of the claims. Pet. 6–9, 24, 33, 42. In case we do not find that Dyer teaches a "wide area network interface," as required by claim 1, Johnson relies on Poulton as teaching an internet link for exercise stations and combines that teaching with Dyer to argue unpatenability of the claims. Pet. 12–15, 25, 34, 43.

Like the claimed invention, Dyer discloses a "computer-controlled, user interactive" exercise system that communicates "personalized instructional and educational information to a user" and provides an "exercise regimen which is *automatically adjusted* to meet the needs of a user." Ex. 1002, 1:12–20 (emphasis added). Also, like the claimed invention, Dyer's system includes a local system made up of at least one "exercise station" equipped with a "central processor unit (CPU) . . . for use in updating and evaluating user information" (*id*. at 5:49–59, 11:39–46), and a remote "central computer" for communicating a user's "performance history, as well as their exercise program, to individual exercise stations" (*id*. at 10:32–50). Each exercise station has a "visual display" and "voice generator" for communicating "exercise instructions and performance evaluations to the user" from the remote central computer. *Id*. at 8:53–9:1, Fig. 4.

In operation, a user provides an identifier to the exercise station, which accesses and retrieves information about the user from the remote central computer. *Id*. at 3:57–65. "This user information is used in developing *any recommended changes in the user's exercise program*." *Id*.

at 3:65–67 (emphasis added). In turn, visual and audio instructions "are provided to the user during the exercise period to further assist the user . . . to achieve the desired aerobic or other condition during the exercise period." *Id*. at 4:18–26. Notably, as taught by Dyer, the system "*automatically updat[es] a user's exercise program based upon his performance history*," and "optimiz[es] the value of the exercise session," by providing "*real-time* performance evaluations and coaching instructions to a user of the exercise equipment." *Id*. at 3:11–21 (emphases added). As a result, the system serves to emulate "a live coach/participant situation." *Id*. at 4:26–30.

a. Independent Claim 1

Icon seeks to distinguish Dyer from the claimed invention, arguing that Dyer's local system cannot "determine to carry out a different number of exercise related steps than the number of exercise related steps specified by the script," as required by claim 1. PO Resp. 8. This limitation, according to Icon, requires that the exercise system be able to evaluate and change the "number of sets" that a user performs during a given exercise session. *Id*. at 9. On that basis, Icon asserts that Dyer "never indicates that a number of sets (*i.e.*, *steps*) of an exercise are adjusted" in the course of a workout, but only that "the weight or pace (*i.e.*, *a parameter*) is adjusted." *Id*. at 9. In Icon's view, the quantity of sets in Dyer always remains the same, and although Dyer may enable the parameters of a set, that "is not akin to changing steps . . . because steps and parameters are clearly distinguished from one another in the Board's claim construction." *Id*. at 12.

Although Icon is correct that we construe a "step" to be different from a "parameter," Icon's assertion that Dyer is limited to changing only parameters of an exercise, but not the number of steps (or sets), fails to read

Dyer "for all that it teaches." *In re Mouttet*, 686 F.3d 1322, 1331 (Fed. Cir. 2012). On its face, Dyer teaches that "[d]uring any given exercise period, *user performance is continuously evaluated*" by the system. Ex. 1002, 4:18–26 (emphasis added). That continuous evaluation, according to Dyer, consists of assisting the user "through each repetition of the exercise" and providing "on-line, real-time evaluation and instructions to the user regarding performance of his exercise program." *Id*. at 4:53–63. And because user performance is evaluated in "real time," Dyer explains that the system is capable of "automatically producing *changes to the user's exercise program in view of the user's performance history*." *Id*. at 4:63–5:1 (emphasis added); *see also id*. at 48:23–26 ("providing an exercise system which uses the present and past user performance history in addition to demographic data for developing *changes to the user's exercise program*") (emphasis added). Those passages support a broader view of Dyer as teaching a system that can make changes to the "exercise program" as a whole, be it the parameters of an exercise in particular or the number of sets in general.

Icon's narrow reading of Dyer as failing to teach adjustments to the "number of sets" ignores that Dyer is concerned with evaluating a user's performance in real time, and then, based on that real time evaluation, instructing the user on how to improve performance by making "changes to the user's exercise program." *Id*. at 48:25–26. Although portions of Dyer focus on changes to parameters, such as number of repetitions and levels of resistance, Dyer does not rule out changes to other aspects of the "exercise program." In the fitness world, an exercise program has long been known to be defined by both the number of repetitions *and* the number of sets. Ex.

1017 at 9–10, 34, 43. In fact, Dyer describes the exercise routine in terms of "the number of sets of a given exercise performed, and the total number of repetitions of the exercise performed." Ex. 1002, 22:19–27. Dyer even defines what is meant by a "set." *Id*. at 22:23–27. Nothing in Dyer suggests that the system's ability to change the "exercise program" would not also encompass the ability to change the number of sets.

Indeed, elsewhere, Dyer describes a "preferred embodiment" that can "determine proposed changes to the exercise program" by tracking the number of "sets" performed by a user and deriving a "rating" of the user's performance. Ex. 1002, 47:7–54. According to Dyer, the system "calculates the rating average for *all of the sets* of the exercise session," which "could include those *sets* comprising an exercise session on the current local station, and it could also include *those sets performed* on other local exercise stations during the user's current, total exercise session." *Id*. at 47:31–36 (emphasis added). After assessing the number of sets, the system "communicates to the user any recommended weight change." *Id*. at 47:40–41. Given that the user is rated on the number of "sets performed," a skilled artisan would have understood that, in order to improve the user's overall rating, the changes recommended by Dyer's system would include changes to the number of sets to be performed in the future.

In another embodiment, Dyer likewise teaches that the system "compares the *number of sets* completed with the *value of sets* to be completed in a given session" and "instruct[s] the user based on his overall performance on several stations." *Id*. at 47:55–61 (emphasis added). "If the user skips one or more exercise stations," the system "notes this and advises the user," including making "appropriate coaching instructions." *Id*. at

47:64–48:1. Dyer's disclosure that the system can advise and instruct a user based on whether the user completed a "number of sets," or skipped a "station," indicates that the system can instruct the user to change the number of sets or stations in response to the user having skipped a set or station.

Icon attempts to distinguish Dyer by arguing that "it is the user that determines whether to skip a step," not the system. PO Resp. 14–15. We do not find this argument persuasive because the claim language expressly contemplates that the user may be involved in the determination of a different number of steps. Specifically, as claimed, the determination is carried out "in response to at least one of monitored user performance *or user input.*" That means either the user or the system can initiate the determination to change the number of steps. Dyer satisfies the claim language because a skilled artisan would understand Dyer's system to be advising and instructing the user on changes to the exercise program only after the user has skipped a set or a station, i.e., in response to user input. *See* Ex. 1017 at 48 (testimony by Icon's declarant that, in Dyer, "if the user was not conforming to the computer expectations, there would be some notification that—that the session isn't going according to plan and then the user then would opt—could opt to change the number of repetitions or the number of sets or eliminate use of the machine").

Also, in arguing that Dyer is limited to changing parameters, and not sets, Icon points to an "initialization procedure" in which Dyer only describes adjustments to "repetitions and weight." PO Resp. 10–11. However, the "initialization procedure" in Dyer pertains to establishing a "beginning weight," or "starting weight," for the *first* repetition of an

exercise routine that has yet to be determined. Ex. 1002, 36:3–46. Because the sole objective of initialization is to determine the "initial weight value" of "one repetition," that section of Dyer, naturally, would not mention a number of sets. *See id*. at 36:24–64; *see also* Ex. 1017 at 31–37 (testimony by Icon's declarant that initialization is "not a workout" because "[w]hat it's looking for is the—what's called the one rep maximum.") *and* Ex. 2006 at 24–25 (testimony by Johnson's declarant that initialization is "a one shot deal"). Moreover, there is no evidence that Dyer's discussion of "initialization" negates in any way its teachings elsewhere, as discussed above, of the ability to change the exercise program *after* initialization is complete. *See In re Inland Steel Co.*, 265 F.3d 1354, 1361 (Fed. Cir. 2001) (the entire disclosure of a reference must be considered for what it fairly teaches one of ordinary skill in the art).

Given Dyer's extensive discussion of evaluating and instructing users based on their completion of "sets" or "stations" in a given exercise program, we find that a skilled artisan would have understood Dyer's teaching of "automatically producing changes to the user's exercise program in view of the user's performance history" (Ex. 1002, 4:63–5:1) to encompass not only changes to the precise parameters of a particular exercise, but also changes to the number of sets in general. Thus, we conclude that Johnson has proven by preponderant evidence that Dyer is capable of "carrying out a different number of sets than the number originally prescribed by the exercise program," as required by claim 1.

Claim 1 also requires that local system receive the exercise program, or script, "over a wide area network interface" with the remote system. Johnson argues that Dyer's disclosure of transmitting data between the local

and remote systems via "outside computers," "telephone communication systems," and a "modem" would have suggested a "wide area network interface." Pet. 6–9 (citing Ex. 1002 10:51–63). Johnson's declarant adds that "in 1995, interaction with the internet was commonly done via a telephone modem connected to a telephone line" and "even though a telephone line is not necessarily a wide area network, a modem connected to a telephone line is clearly a 'wide area network interface.'" Ex. 1016 ¶ 10(d). Also, Johnson argues that, if Dyer is found not to teach a "wide area network interface," a skilled artisan nonetheless would have found it obvious to modify Dyer's transmission link to incorporate the internet because Poulton teaches that "the worldwide web or internet" can be used for linking exercise apparatus "between users remotely spaced from one another." Pet. 12–15 (citing Ex. 1012).

In its Patent Owner Response, Icon does not dispute that, in the relevant time frame, a skilled artisan would have considered the internet to be a well-known interface for transmitting information between remote computers, nor does Icon dispute that a skilled artisan, viewing Dyer's disclosure of transmitting information via a modem/telephone link, would have considered the internet as an obvious substitution.[7] *See* PO Resp. 8–17 (focusing exclusively on the limitation that the system "carry out a different number of exercise related steps . . ."). Likewise, Icon does not dispute that Poulton teaches the internet as an obvious substitution for the modem/telephone link of Dyer. *See id*. at 17. After due consideration, we

[7] Icon argued in the Preliminary Proceeding that neither Dyer alone nor Dyer in view of Poulton teaches or suggests a "wide area network interface," as required by claim 1. Dec. to Inst. 10–12. In its Patent Owner Response, however, Icon no longer posits this argument.

find that a preponderance of the evidence shows that a skilled artisan, viewing the teachings of Dyer alone or in combination with Poulton, would have been led to utilize the internet as the communication link for Dyer's exercise system in order to obtain quicker access to larger amounts of information at remote locations. *See* Pet. 15.

After considering the totality of the evidence and argument presented by Johnson and Icon, we also find that Dyer teaches or suggests the remaining limitations of claim 1. Accordingly, we conclude that a preponderance of the evidence shows that claim 1 would have been unpatentable for obviousness over Dyer alone or in combination with Poulton.

b. Dependent Claims 2, 4, and 6

Johnson relies on Dyer as teaching the limitations of claims 2, 4, and 6. Pet. 24–26, 33–34, 42–44. Unlike other dependent claims, Icon argues in support of patentability for claims 2, 4, and 6. PO Resp. 13, 17–25. For the reasons that follow, we conclude that a preponderance of the evidence demonstrates that these claims are unpatentable.

Claim 2, which depends directly from claim 1, adds the limitation that the local system is able to carry out a different number of steps "by skipping at least one of the specified steps." Icon relies on the same arguments for patentability of claim 2 as it does for claim 1. PO Resp. 13–14. As discussed above, Dyer teaches that the system monitors whether the user "finish[es] all sets" or "skips one or more stations" (Ex. 1002, 47:55–67), and based on that performance, instructs the user on "proposed changes to the exercise program" (*id*. at 47:7–10). We find that a skilled artisan would have understood those teachings by Dyer to mean that the system can

instruct the user to either finish the set or station, or skip it entirely. As such, we determine that a preponderance of the evidence demonstrates that claim 2 would have been obvious over Dyer alone, or Dyer and Poulton in combination.

Claim 4 depends from claim 3, and recites that the local system is configured to "generate audio" about "a change in resistance" for the particular exercise "prior to" the change actually occurring. Icon argues that neither Dyer alone nor Dyer in combination with Poulton teaches or suggests "audio that is directly related to a change in resistance . . . prior to the change in resistance actually occurring." PO Resp. 18. We disagree. Dyer teaches expressly that:

> Visual and audio instructions and evaluation information are provided to the user during the exercise period to further assist the user in exerting the appropriate amount of force to achieve the desired aerobic or other condition during the exercise period. These instructions and evaluation information are preferably communicated to the user *audibly to provide verbal motivation to the user* similar to that received in a live coach/participant situation." *Id*. at 4:23–30

Ex. 1002, 4:22–26.

Importantly, Dyer goes on to explain that, in making changes to a user's exercise program, the CPU communicates a number of instructions to the user, including "any recommended weight change and preferably also [] an explanation to the user *as to why the resistance . . . should be changed*." *Id*. at 47:7–10, 40–43 (emphasis added). In another section, Dyer discloses that the system audibly instructs the user of a reduction in weight *before* the next set is begun: "With the weight reduced, the CPU passes to block 675 and *produces an audible* and optionally visual output *indicating that the*

weight has been reduced, and requesting the user to please continue with the exercise session." *Id*. at 33:37–59 (emphasis added). Contrary to Icon's assertions, these express teachings by Dyer indicate that the verbal warning of a new resistance/weight level occurs "prior to" the user undertaking the exercise. As such, we conclude that a preponderance of the evidence demonstrates a skilled artisan would have understood Dyer as teaching the limitations of claim 4.

Claim 6 depends from claim 5. Together these claims add that the "audio" or "verbal recitation" generated by the system include "a description" and "a duration of time" for the exercise event. Icon argues that these limitations are not met because Dyer "does not calculate, determine, or otherwise identify a duration of time related to a user's pace." PO Resp. 23. We disagree. Dyer expressly teaches that the system includes a "speech generator" which verbally "advise[s] the user if he is going too fast or too slow" and "will periodically give the user positive reinforcement." Ex. 1002, 16:61–17:4. We find that Dyer's teaching of verbally advising and reinforcing a user as to their pace for a given exercise would have suggested to a skilled artisan including, as part of the verbal advice, the length of time a user needs to maintain that pace. As such, we conclude that a preponderance of the evidence shows a skilled artisan would have understood Dyer as teaching the limitations of claim 6.

2. Dependent Claims 3, 5, and 7–10

Johnson relies on Dyer for teaching the limitations of claims 3, 5, and 7–10. These claims define further the terms, "audio" and "exercise event," as used in the other claims. In its Petition, Johnson presents credible and probative evidence pointing towards the unpatentability of claims 3, 5, and

7–10. Pet. 24–26, 33–34, 42–44. In its Response, however, Icon never disputes Johnson's challenge to these dependent claims. PO Resp. 6–25.

Inter partes review, by its very nature, is meant to be an interactive process between petitioner and patent owner. In that regard, our rules instruct that the patent owner response "must include a statement identifying material facts in dispute. Any material fact not specifically denied may be considered admitted." 37 C.F.R. § 42.23(a). In addition, our trial practice guide provides that "[t]he response should identify all the involved claims that are believed to be patentable and state the basis for that belief." *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

Here, Johnson presents persuasive evidence and argument showing unpatentability of claims 3, 5, and 7–10. In contrast, Icon does not articulate any reason for patentability of these claims. Absent any rebuttal from Icon, we will not scour the record in an effort to save the unaddressed claims. Upon review of Johnson's case, a preponderance of the evidence shows a skilled artisan would have understood Dyer as teaching the limitations of claims 3, 5, and 7–10. As such, those claims are unpatentable as obvious.

IV. CONCLUSION

Johnson has proven by a preponderance of the evidence that claims 1–10 of the '123 patent are unpatentable for obviousness over Dyer alone, or Dyer and Poulton, under 35 U.S.C. § 103. This is a Final Written Decision of the Board under 35 U.S.C. § 318(a).

V. ORDER

Accordingly, it is hereby:

ORDERED that claims 1–10 of the '123 patent have been proven to be unpatentable by a preponderance of the evidence; and

FURTHER ORDERED that the parties to the proceeding seeking judicial review of this Final Written Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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