

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Inter Partes* Review of:)
U.S. Patent No. 7,166,062)
Issued: Jan. 23, 2007)
Application No.: 09/641,627)
Filing Date: Aug. 18, 2000)

For: **System For Interaction With Exercise Device**

FILED VIA E2E

**Petitioner Peloton Interactive, Inc.'s Ranking and Explanation of
Parallel Petitions Challenging U.S. Patent No. 7,166,062**

Explanation and Ranking for Petitions for
Inter Partes Review of USP 7,166,062

Petitioner Peloton Interactive, Inc. (“Petitioner”) hereby respectfully submits this Paper in support of its two petitions for *inter partes* review of claims 1, 3-5, 8-11, 15-16, 21-23, 26-28, 30, 36, 38, 40, 45-46, 48-50, 52, 54, 56-57, 59, 61, 78-85, 87, 89-90, and 92-95 of U.S. Patent No. 7,166,062 (“’062 Patent”) owned by ICON Health & Fitness, Inc. (“Patent Owner”).

Petitioner has concurrently filed two petitions for *inter partes* review of the ’062 Patent: one of claims 1, 3-5, 8-11, 15-16, 21-23, 26-28, 30, 36, 38, 40, 45-46, and 48 (“Petition I”) and the other of claims 49-50, 52, 54, 56-57, 59, 61, 78-85, 87, 89-90, and 92-95 (“Petition II”). Pursuant to the Board’s Consolidated Trial Practice Guide (November 2019), Petitioner provides this separate paper to (1) identify the material differences between the petitions, (b) explain why the Board should exercise its discretion to institute both petitions, and (c) provide a ranking for the petitions. *See* Consolidated Trial Practice Guide (November 2019) at 59-61.

I. MATERIAL DIFFERENCES BETWEEN THE PETITIONS

Petitioner seeks *inter partes* review of 46 claims of the ’062 Patent—23 claims in Petition I and 23 claims in Petition II. Petitioner uses the same prior art in both petitions and has divided the challenged claims in a logical manner (including independent claims 1 and 29 and their dependents in Petition I and including independent claims 49, 78, and 85 and their dependents in Petition II):

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Petition	Claims	Ground
Petition I	1, 3-5, 8-11, 15-16, 21-23, 26-28, 30, 36, 38, 40, 45-46, and 48	§ 103 over Studor alone or in view of the knowledge of a person of ordinary skill in the art
	1, 3-5, 8-11, 15-16, 21-23, 26-28, 30, 36, 38, 40, 45-46, and 48	§ 103 over Clem in view of the knowledge of a person of ordinary skill in the art or Hickman
Petition II	49-50, 52, 54, 56-57, 59, 61, 78-85, 87, 89-90, and 92-95	§ 103 over Studor alone or in view of the knowledge of a person of ordinary skill in the art
	49-50, 52, 54, 56-57, 59, 61, 78-85, 87, 89-90, and 92-95	§ 103 over Clem in view of the knowledge of a person of ordinary skill in the art or Hickman

The material differences between the two petitions lie in (i) their mutually exclusive claim sets, and (ii) the distinct subject matter of the two claim sets. In particular, the two independent claims in Petition I parallel each other and are both directed to an exercise system comprising (a) an exercise mechanism, (b) user interface device / interface means, (c) communicating mechanism / communicating means, and (d) controller / means for controlling. In contrast, the other three independent claims vary, with independent claim 49 directed to an exercise system also comprising a means for reproducing (such as audio or video output devices), independent claim 78 directed to an exercise device comprising (a) an exercise

mechanism configured to respond to an exercise program stored on a remote system and (b) control means, and independent claim 85 directed to an exercise system comprising (a) a local system, (b) a remote system, and (c) a communication link between the remote and local systems. Further, Petitioner proposes two different grounds because the type of disclosure differs between grounds. For example, to the extent that a “trainer” encompasses a “stored trainer” as discussed in the ’062 Patent, Studor discloses a trainer in the form of a video, disk, or dynamic or interactive software program that promulgates control signals to the exercise equipment. But to the extent that a trainer is narrowly construed to be limited to a “live trainer,” Clem expressly teaches that the user can interact with a live fitness expert in real time, and thus receive visual and audio signals from a live trainer. As another example, Studor teaches a “diagnostic control” to determine whether the software needs to be updated. However, Clem by itself does not disclose such a “diagnostic control.”

Thus, this related but nuanced subject matter requires additional space to ensure that each claim variation is discussed and fully explained. In short, all 46 claims cannot be effectively challenged in a single 14,000-word petition.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO INSTITUTE BOTH PETITIONS

Petitioner respectfully requests that the Board exercise its discretion to institute both Petition I and Petition II. *First*, Petitioner only filed two distinct

petitions to adequately address all 46 challenged claims within the statutory word limits for petitions. *See Microsoft Corp. v. IPA Techs. Inc.*, No. IPR2019-00810, Paper 12 at 13-14 (Oct. 16, 2019) (finding multiple petitions reasonable when “[f]aced with word count limitations and a large number of challenged claims”). In fact, the number of challenged claims in the instant petitions is almost four times the average. *See* “PTAB Trial Statistics,” United States Patent and Trademark Office, https://uspto.gov/sites/default/files/documents/ptab_aia_fy2020_roundup.pdf (last visited Oct. 8, 2021), at 5, 16 (indicating an average of 12 challenged claims per IPR, PGR, and CBM petition).

Further, two petitions are particularly necessary here because the challenged independent claims are directed to different subject matter. In cases where petitions address more than 20 claims, particularly where claims introduce detail and complexity, requests to institute multiple petitions have often been granted. *See e.g., Dolby Laboratories, Inc. v. Intertrust Technologies Corp.*, IPR2020-01106, Paper 12 at 19-21 (PTAB Jan. 5, 2021) (granting two petitions filed against 18 claims); *Adobe Inc. v. SynKloud Technologies, LLC*, IPR2020-01392, Paper 8 at 8-10 (PTAB Mar. 11, 2021) (granting two petitions against 20 “lengthy” and “complex” asserted claims). As such, instituting both petitions is appropriate when considering the large number of claims Petitioner must address.

Second, instituting both petitions will not unduly burden the Board or Patent Owner. Although the necessary arguments and explanation for all 46 claims cannot be reasonably covered in a single petition, the Board and parties can obtain efficiencies by holding a single oral argument and consolidating depositions between the proceedings.

Notably, institution of both does not waste the resources of the Board or Patent Owner, unlike in other cases denying institution of multiple petitions, because Petitioner here does not seek to use multiple petitions as a means to needlessly multiply the number of challenges against the same claims. *See, e.g., Intel Corp. v. Tela Innovations, Inc.*, No. IPR2019-01518, Paper 17 at 5-16 (Mar. 30, 2020) (denying institution of multiple petitions that needlessly multiplied the number of challenges against same claims). Rather, two petitions are required here to adequately cover all 46 claims. Accordingly, instituting review on both petitions will allow the efficient consideration of the prior art against all of the challenged claims.

III. RANKING OF PETITIONS

Petitioner requests that the Board consider the merits and institute both petitions because the petitions challenge different claim sets. Pursuant to the Board's direction to rank the petitions, however, Petitioner asks the Board to consider the merits of each petition beginning with Petition I followed by Petition II.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of Petitioner Peloton Interactive, Inc.'s Ranking and Explanation for Parallel Petitions Challenging U.S. Patent No. 7,166,062 was served on the official correspondence address for the patent shown in PAIR via FEDERAL EXPRESS next business day delivery, on October 13, 2021:

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