

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ICON HEALTH AND FITNESS, INC.

Appeal No. 2006-0790
Reexamination Control No. 90/005,117

HEARD: April 6, 2006

Before SCHAFFER, DELMENDO, and GAUDETTE, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL UNDER
35 U.S.C. §§ 134 & 306

This is a decision on an appeal under 35 U.S.C. §§ 134 and 306 (2006) from the examiner's final rejection of claims 1 through 13 (final Office action mailed March 13, 2000), which are all of the claims pending in the above-identified

reexamination proceeding.¹ Because the examiner has made out a prima facie case of obviousness with respect to claims 1 through 12 and since the appellant (patent owner) has failed to direct us to persuasive evidence in rebuttal, we affirm as to these 5 claims. With respect to claim 13, however, we reverse because the examiner has not met the initial burden of proving a prima facie case of obviousness.

Accordingly, the examiner's decision is affirmed in part.

10

The Appealed Subject Matter

The subject matter on appeal relates to a treadmill having, inter alia, "a base reorientable from a first position in which the user performs exercises and a second position or storage position in which the base may be further reoriented for 15 transport about a support surface." ('624 patent at column 1, lines 5-9.) In one embodiment, the treadmill comprises a specified support structure, tread base, handle means, roller means, and a gas spring for stably retaining the tread base in a second (or storage) position. (Claims 1-12.) In another

¹ This proceeding is a reexamination of United States Patent 5,676,624 (hereinafter '624 patent) issued to Watterson et al. on October 14, 1997, based on application 08/594,271 filed on January 30, 1996.

embodiment, the treadmill comprises a specified support structure, tread base, handle means, roller means, and means for stably retaining the tread base in a second (or storage) position, wherein the treadmill is configured to have a center of gravity positioned relative to the roller means and handle means to facilitate rotation of the treadmill about the roller means upon application of a rotational force by a user to the handle means. (Claim 13.)

10

The References

The examiner relies on the following prior art documents as evidence of unpatentability:

15	Day	931,394	Aug. 17, 1909
	Teague, Jr. (Teague)	4,370,766	Feb. 1, 1983
20	Dalebout et al. (Dalebout)	4,913,396	Apr. 3, 1990

Damark International, Inc.: The Great Deal Company! 6 (Nov. 17, 1994) (Damark).

25

The Examiner's Rejections

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- I. claims 1 through 3 and 10 through 12 as unpatentable over the combined teachings of Damark and Teague (examiner's answer mailed on May 24, 2005 at 3; final Office action at 2);
- 5 II. claims 4 through 9 as unpatentable over the combined teachings of Damark, Teague, and Dalebout (answer at 3; final Office action at 3); and
- 10 III. claim 13 as unpatentable over the combined teachings of Damark and Day (answer at 3; final Office action at 3-4).

For the reasons discussed below, we affirm rejections I and II but not III.

15 **Findings of Fact**²

We make the following findings of fact by at least a preponderance of the evidence.

1. The appellant states that: (i) claims 1 through 3 and 10 through 12 stand or fall together with respect to rejection I; and (ii) claims 4 through 9 stand or fall
- 20

² In the "Discussion" section below, we number our findings of fact as "FF__."

together with respect to rejection II. (Substitute
appeal brief filed on December 31, 2001 at 7.)

Rejection I: Claims 1-3 & 10-12 over Damark & Teague

2. Appealed claim 1 reads:

5 1. A treadmill comprising:
 support structure having a base for stably
 positioning on a support surface to be free
 standing and having upright structure extending
 upwardly from said base;
10 a tread base having a frame that includes a
 front, a rear, a left side, a right side and an
 endless belt positioned between said left side
 and said right side, said frame being connected
 to said support structure to be moveable about an
15 axis of rotation spaced from said front toward
 said rear between a first position in which said
 endless belt is position [sic] for operation by a
 user positioned thereon and a second position in
 which said rear of said frame is positioned
20 toward said support structure;
 handle means associated with said support
 structure positioned for grasping by a user for
 moving said support structure with said tread
 base in said second position between a use
25 position in which said support structure has said
 base positioned on said support surface for
 stably positioning said support structure on a
 support surface and a moving position in which
 said support structure is rotatably displaced
30 from said use position;
 roller means adapted to said base for
 engagement with said support surface when said
 support structure is reoriented to said moving
 position for movement of said support structure
35 by user on said support surface; and
 a gas spring connected between the tread
 base and the upright structure to assist in
 stably retaining said tread base in said second
 position relative to said upright structure with

said tread base in said second position.

3. The examiner did not find that the limitation "a gas
spring connected between the tread base and the
5 upright structure to assist in stably retaining said
tread base in said second position relative to said
upright structure with said tread base in said second
position" in appealed claim 1 invoked 35 U.S.C. § 112,
¶6.

10 4. The appellant never challenged the examiner's
interpretation of the last clause of appealed claim 1
(or any other clause in the appealed claims) as
invoking the strictures of 35 U.S.C. § 112, ¶6.

15 5. At oral argument held on April 6, 2006, the
appellant's counsel was asked whether the last clause
in appealed claim 1 invoked 35 U.S.C. § 112, ¶6.

6. In response to the question, the appellant's counsel
confirmed that the last clause of appealed claim 1 did
not invoke the strictures of 35 U.S.C. § 112, ¶6.

20 7. Damark discloses a manual treadmill identified as
"Wilson Manual Treadmill" comprising: a base that
necessarily includes a frame having a front, a rear,
left side, and a right side with an endless belt

positioned between the left side and the right side;
and a handle extending from the base.

8. Damark further teaches that the treadmill may be
folded vertically.

5 9. The appellant acknowledges Damark's disclosure as
follows (request for reexamination filed on September
25, 1998 at 3):

10 The Damark reference depicts a manual folding
treadmill having a tread base rotatably attached
to an upright support structure, wherein the
point of attachment is intermediate the front and
rear of the tread base.

15 10. Damark also describes the provision of front wheels to
allow easy movement and easy storage of the treadmill.

11. The examiner determined that Damark "discloses all the
limitations of the claims, except for a gas spring
connected between the tread base and the upright
structure to assist in stably retaining said tread
20 base in said second position relative to said upright
structure with said tread base in said second
position." (Final Office action at 2.)

12. The appellant does not dispute the examiner's
determination that Damark "discloses all the
25 limitations of the claims, except for a gas spring

connected between the tread base and the upright structure to assist in stably retaining said tread base in said second position relative to said upright structure with said tread base in said second position." (Substitute appeal brief at 7-11.)

5

13. Teague describes a recess or cabinet bed of the type in which a bed is mounted at its head upon a counterbalancing mechanism provided to support the bed as it swings between its horizontal or "open position" in use and its vertical or "closed position" in storage. (Column 1, lines 5-11; Figures 1-4.)

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14. Teague teaches that the bed includes an improved counterbalancing mechanism facilitating movement between these two stable positions. (Column 1, lines 12-68.)

15

15. As part of the counterbalancing mechanism, Teague teaches (column 2, line 1 to column 3, line 68) the use of gas springs 56, which "provide the lifting force or moment to move the bed up to the position where its center of gravity passes over the pivot axis, but when the bed continues to move toward the fully closed position, the springs reverse their

20

action and act against that continued movement"

(column 2, lines 4-8; emphasis added).

16. The function of the gas springs 56 is more specifically described in Teague as follows (column 4, lines 1-22):

When the bed is moved from its open position to a balanced position wherein its center of gravity 61 is directly over its pivot axis, and upon further movement the gas springs continue to act as compression springs but their action is reversed. Hence, the springs act against the force of gravity which moves the bed to its fully closed position.

During the movement of the bed from its open position to the position wherein its center of gravity 61 is over its pivot axis 13, each lever 50 is swung to a position wherein its pivot 52 is in alignment with the lever pivot 48 and the gas spring pivot 58 so that the gas springs are nearly fully extended and they are exerting no moment of force. However, as bed 2 continues to swing clockwise around its pivot axis to its fully closed position, each of levers 50 continues to swing clockwise around its pivot axis 48 and pivot 52 moves along an arcuate path beyond its position in alignment with pivots 58 and 48. That further swinging movement of lever 50 causes the gas springs to be subjected to compression and they act against and cushion the action of gravity as the bed moves to its fully closed or rest position...[Emphasis added.]

17. The only disclosure in the '624 patent under reexamination with respect to a "gas spring"

associating the tread base with the upright structure
is found at column 15, lines 3-28.

18. The inventors disclose that gas spring 505 of the '624
patent is part of a lift assist assembly. (Column 15,
5 lines 3-28.)

19. The inventors disclose the function or purpose of the
gas spring as follows: "The force and the torque (TF)
exerted by the spring 505 is selected so that the
resulting required lifting force (LF) may be nominal
10 (e.g. 5 to 20 pounds)." (Column 15, lines 22-24.)

20. Teague teaches that the gas springs, like the gas
spring described in the '624 patent, provide a lifting
force. (Column 2, lines 3-8.)

21. Appealed claim 1 does not limit the degree or manner
15 in which the gas spring "assist[s] in stably
retaining" the tread base at the storage position.

22. The appellant has not proffered any evidence (e.g.,
declaration evidence) that would support the
allegation that Teague's gas spring does not "assist"
20 in stable retention.

23. Teague expressly teaches that the bed has two stable positions (operating and storage positions). (Column 1, lines 37-39.)

5 Rejection II: Claims 4-9 over Damark, Teague, & Dalebout

24. Claim 4 depends from claim 3, which depends from claim 2, which in turn depends from claim 1.

25. Claims 2 through 4 recite:

10 2. The treadmill of claim 1 wherein said base includes a left portion positioned proximate said left side and a right portion positioned proximate said right side, wherein said left portion and said right portion each have a forward end spaced outwardly from said upright member, and wherein said roller means includes a wheel rotatably attached to said forward end of said left portion and a wheel rotatably attached to said forward end of said right portion.

20 3. The treadmill of claim 2, wherein said upright structure includes a left upright member and a right upright member, said right upright member being spaced from and in general alignment with said left upright member.

25 4. The treadmill of claim 3, wherein said handle means includes a left handle mechanically associated with said left upright member and a right handle mechanically associated with said right upright member.

30

26. The appellant does not dispute the examiner's findings with respect to Dalebout. (Substitute appeal brief at 11.)

27. With respect to rejection II, the appellant refers to
5 the same arguments made against the basic combination of Damark and Teague.

Rejection III: Claim 13 over Damark & Day

28. Claim 13 recites:

10 13. A treadmill comprising:
 support structure having a base for stably
 positioning on a support surface to be free
 standing and having upright structure extending
 upwardly from said base;
15 a tread base having a frame that includes a
 front, a rear, a left side, a right side and an
 endless belt positioned between said left side
 and said right side, said frame being connected
 to said support structure to be movable between a
20 first position in which said endless belt is
 positioned for operation by a user positioned
 thereon and a second position in which said rear
 of said frame is positioned toward said support
 structure;
25 handle means associated with said support
 structure positioned for grasping by a user for
 moving said support structure with said tread
 base in said second position between a use
 position in which said support structure has said
30 base positioned on said support surface for
 stably positioning said support structure on a
 support surface and a moving position in which
 said support structure is rotatably displaced
 from said use position;

roller means adapted to said base for engagement with said support surface when said support structure is reoriented to said moving position for movement of said support structure by the user on said support surface;

means for stably retaining said tread base in said second position relative to said upright structure with said tread base in said second position; and

wherein said treadmill is configured to have a center of gravity positioned relative to said roller means and said handle means to facilitate rotation of said treadmill about said wheel means upon application of a rotational force by the user to said handle means.

29. Unlike claim 1, claim 13 does not include the limitations with respect to the "gas spring" component.

30. Appealed claim 13 recites that "said treadmill is configured to have a center of gravity positioned relative to said roller means and said handle means to facilitate rotation of said treadmill about said wheel means upon application of a rotational force by the user to said handle means." (Emphasis added.)

31. The examiner took the position that Damark discloses every limitation of appealed claim 13 except for the claim limitation "means for stably retaining said tread base in said second position relative to said

upright structure with said tread base in said second position." (Final Office action at 4.)

32. Day teaches an exercising device which may be folded into a storage position and retained in such position by use of set screws 16. (Page 2, lines 20-56; Figures 1-2.)

33. The examiner alleged (answer at 6):

It is inherent that Damark's treadmill (see figure) is heavier at the roller means and as broadly claimed, Damark's [sic] center of gravity is positioned relative to said roller means and said handle means to facilitate rotation of said treadmill about said wheel means upon application of a rotational force by the user to said handle means.

34. The appellant asserted (substitute appeal brief at 13):

[T]here is no teaching, suggestion, or motivation in Damark of distributing the components of the treadmill such that the treadmill has a center of gravity that assists the user in tipping or rotating the treadmill onto the wheels for transport. In fact, there is no mention or discussion whatsoever in the Damark reference regarding the placement of specific components, weight distribution or center of gravity, much less the benefit (i.e., making it easier for the user to rotate or tip the treadmill onto its wheels, which is more significant in relation to heavier, motorized treadmills) that is achieved and claimed by appellant.

35. The examiner did not identify any evidence or
persuasive technical reasoning to establish that when
rotational force is applied to the handle means of
Damark's treadmill, the center of gravity is
5 positioned such that the treadmill necessarily rotates
about the wheels.

Discussion

Grouping of Claims

10 Prior to addressing the merits, we note the appellant's
statements that: (i) claims 1 through 3 and 10 through 12 stand
or fall together with respect to rejection I; and (ii) claims 4
through 9 stand or fall together with respect to rejection II.
(FF1; Appeal brief filed on December 31, 2001 at 7.) We
15 therefore select claims 1 and 4 as representative of each of the
two groups of claims rejected in grounds I and II, respectively,
and confine our discussion to these representative claims. See
37 CFR § 41.37(c) (vii) (2005) (effective September 13, 2004).

Rejection I: Claims 1-3 & 10-12 over Damark & Teague

20 For convenience, appealed claim 1 is reproduced again as
follows (FF2):

1. A treadmill comprising:

5 support structure having a base for stably positioning on a support surface to be free standing and having upright structure extending upwardly from said base;

10 a tread base having a frame that includes a front, a rear, a left side, a right side and an endless belt positioned between said left side and said right side, said frame being connected to said support structure to be moveable about an axis of rotation spaced from said front toward said rear between a first position in which said endless belt is position [sic] for operation by a user positioned thereon and a second position in which said rear of said frame is positioned toward said support structure;

15 handle means associated with said support structure positioned for grasping by a user for moving said support structure with said tread base in said second position between a use position in which said support structure has said base positioned on said support surface for stably positioning said support structure on a support surface and a moving position in which said support structure is rotatably displaced from said use position;

20 roller means adapted to said base for engagement with said support surface when said support structure is reoriented to said moving position for movement of said support structure by user on said support surface; and

25 a gas spring connected between the tread base and the upright structure to assist in stably retaining said tread base in said second position relative to said upright structure with said tread base in said second position.

30 We start with claim construction. Specifically, we must first consider the scope and meaning of certain contested claim limitations. Gechter v. Davidson, 116 F.3d 1454, 1457, 1460
35 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); In re

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Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

Appealed claim 1 recites in part (last clause): "a gas spring connected between the tread base and the upright structure to assist in stably retaining said tread base in said second position relative to said upright structure with said tread base in said second position." (FF2.) The examiner did not hold that this clause invoked 35 U.S.C. § 112, ¶6. (FF3.) The appellant never challenged the examiner's interpretation of this clause (or any other clause in the appealed claims) in this regard. (FF4.) In fact, at oral argument held on April 6, 2006, the appellant's counsel was questioned whether the last clause in appealed claim 1 invoked 35 U.S.C. § 112, ¶6. (FF5.) In response, the appellant's counsel confirmed that it did not. (FF6.) Thus, it is appropriate, as the examiner has done so here, to give the language of this clause its broadest reasonable interpretation consistent with the accompanying specification. In re American Academy of Science Tech Center, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004) ("The 'broadest reasonable construction' rule applies to reexaminations as well as initial examinations.").

Damark discloses a manual treadmill identified as "Wilson Manual Treadmill" comprising: a base that necessarily includes a frame having a front, a rear, left side, and a right side with an endless belt positioned between the left side and the right side; and a handle extending from the base. (FF7.) Damark further teaches that the treadmill may be folded vertically. (FF8.) Indeed, we note that the appellant acknowledges Damark's disclosure as follows (FF9; request for reexamination filed on September 25, 1998 at 3):

10 The Damark reference depicts a manual folding treadmill having a tread base rotatably attached to an upright support structure, wherein the point of attachment is intermediate the front and rear of the tread base.

15 Damark also describes the provision of front wheels to allow easy movement and easy storage of the treadmill. (FF10.) That Damark discloses the above elements or limitations has not been contested.

20 After considering the scope and content of the prior art relative to the claimed invention, the examiner determined that Damark "discloses all the limitations of the claims, except for a gas spring connected between the tread base and the upright structure to assist in stably retaining said tread base in said
25 second position relative to said upright structure with said

tread base in said second position.” (FF11; final Office action at 2.) Again, the appellant does not dispute the examiner’s determination in this regard. (FF12.)

Notwithstanding this difference, the examiner concluded
5 that the subject matter of appealed claim 1 would have been obvious to a person having ordinary skill in the art within the meaning of 35 U.S.C. § 103(a). Specifically, the examiner relied on the teachings of Teague to account for the sole difference between the invention recited in appealed claim 1 and
10 Damark.

Teague describes a recess or cabinet bed of the type in which a bed is mounted at its head upon a counterbalancing mechanism provided to support the bed as it swings between its horizontal or “open position” in use and its vertical or “closed
15 position” in storage. (FF13; column 1, lines 5-11; Figures 1-4.) Teague teaches that the bed includes an improved counterbalancing mechanism facilitating movement between these two stable positions. (FF14; column 1, lines 12-68.) As part of the counterbalancing mechanism, Teague teaches (FF15; column
20 2, line 1 to column 3, line 68) the use of gas springs 56, which “provide the lifting force or moment to move the bed up to the position where its center of gravity passes over the pivot

axis..." (Column 2, lines 4-6.) Teague also describes an additional feature for the gas springs as follows: "[W]hen the bed continues to move toward the fully closed position, the springs reverse their action and act against that continued
5 movement" (column 2, lines 6-8). The function of the gas springs 56 is more specifically described in Teague as follows (FF16; column 4, lines 1-22):

10 When the bed is moved from its open position to a balanced position wherein its center of gravity 61 is directly over its pivot axis, and upon further movement the gas springs continue to act as compression springs but their action is reversed. Hence, the springs act against the force of gravity which moves the bed to its fully closed position.

15 During the movement of the bed from its open position to the position wherein its center of gravity 61 is over its pivot axis 13, each lever 50 is swung to a position wherein its pivot 52 is in alignment with the lever pivot 48 and the gas spring pivot 58 so
20 that the gas springs are nearly fully extended and they are exerting no moment of force. However, as bed 2 continues to swing clockwise around its pivot axis to its fully closed position, each of levers 50 continues to swing clockwise around its pivot axis 48
25 and pivot 52 moves along an arcuate path beyond its position in alignment with pivots 58 and 48. That further swinging movement of lever 50 causes the gas springs to be subjected to compression and they act against and cushion the action of gravity as the bed
30 moves to its fully closed or rest position...[Emphasis added.]

Based on this evidence, we conclude (as did the examiner) that one of ordinary skill in the art would have been led to

combine the teachings of Damark and Teague so as to arrive at a treadmill encompassed by appealed claim 1. Specifically, we hold that one of ordinary skill in the art would have found the requisite motivation, suggestion, or teaching in the prior art to provide Teague's counterbalancing mechanism including gas springs 56 in the treadmill described in Damark in order to obtain all of the advantages described in Teague. In light of the prior art teachings as a whole, a person having ordinary skill in the art would have had a reasonable expectation that incorporation of Teague's counterbalancing mechanism in the treadmill described in Damark, which opens in use and closes in storage in a manner similar to that described for Teague's bed, would decrease the lifting moment required to store the treadmill while ensuring that the tread base is stably retained in the storage position.

We appreciate that Teague discloses the use of the counterbalancing mechanism in a bed rather than a treadmill as in Damark. This fact alone, however, does not preclude a determination that a person having ordinary skill in the art would have combined the teachings of the two references. Two tests for determining whether a prior art reference is analogous are as follows: (1) whether the art is from the same field of

endeavor, regardless of the problem addressed; and (2) if the reference is not within the inventor's endeavor, whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. In re Bigio, 381 F.3d 1320, 5 1325, 72 USPQ2d 1209, 1211-12 (Fed. Cir. 2004); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

Here, the appellant's recited purpose for the "gas spring" element recited in appealed claim 1 is "to assist in stably retaining said tread base in said second position relative to 10 said upright structure with said tread base in said second position [i.e., closed position]." Furthermore, the only disclosure in the '624 patent under reexamination with respect to a "gas spring" associating the tread base with the upright structure is found at column 15, lines 3-28. (FF17.) There, 15 the inventors disclose that the gas spring 505 is part of a lift assist assembly. (FF18.) In particular, the inventors disclose the function or purpose of the gas spring as follows: "The force and the torque (TF) exerted by the spring 505 is selected so that the resulting required lifting force (LF) may be nominal 20 (e.g. 5 to 20 pounds)." (FF19; column 15, lines 22-24.)

Because Teague's gas springs are said to act against "continued movement" of the rotating body to its storage

position (column 2, lines 3-8), they are provided for the same or similar purpose as that recited in appealed claim 1 (i.e., "to assist in stably retaining said tread base in said second position relative to said upright structure with said tread base in said second position"). Moreover, Teague teaches that the gas springs, like the gas spring described in the '624 patent, provide a lifting force. (FF20; column 2, lines 3-8.) Thus, Teague's gas spring functions in the same or similar manner as the appellant's gas spring. It follows then that Teague's teachings with respect to the lift assembly including gas springs are "reasonably pertinent to the particular problem [providing an element that assists in stable retention of a rotatable body at a storage position and assisting in the lift of the rotating body to its storage position] with which the inventor is involved." Under these circumstances, we reject the appellant's contention (substitute appeal brief at 10; reply brief filed on July 22, 2005 at 3-4) that Teague is nonanalogous art.

The appellant also urges that because Teague teaches that the gas spring exerts a force resisting the force of gravity (which, according to Teague, retains the bed in the storage position), its teachings are diametrically opposed to the

characteristic of the gas spring recited in appealed claim 1
("to assist in stably retaining said tread base in said second
position relative to said upright structure with said tread base
in said second position"). (Reply brief at 2-3.)

5 We do not find this argument persuasive. Appealed claim 1
does not limit the degree or manner in which the gas spring
"assist[s] in stably retaining" the tread base at the storage
position. (FF21.) As already pointed out, Teague teaches that
"when the bed continues to move toward the fully closed
10 position, the [gas] springs reverse their action and act against
that continued movement." (Column 2, lines 6-8; emphasis
added.) Thus, without the gas springs, the lifting force and
the momentum of the rotating body (i.e., "continued movement")
in Teague would necessarily cause the body to extend beyond the
15 storage position. Giving the disputed claim limitation its
broadest reasonable interpretation, we determine that Teague's
gas spring would reasonably appear to "assist" in stable
retention of the rotating body. In this regard, the appellant
has not proffered any evidence (e.g., declaration evidence) that
20 would support the allegation that Teague's gas spring does not
"assist" in stable retention. (FF22.) Mere attorney arguments
or conclusory statements do not take the place of evidence.

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See, e.g., In re Geisler, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997).

It is important to emphasize that Teague expressly teaches that the bed has two stable positions (operating and storage 5 positions). (FF23; column 1, lines 37-39.) Also, Teague's gas springs provide lift assist, just like the gas springs claimed and described in the appellant's own patent under reexamination (column 15, lines 3-28). (FF18.) While Teague's "springs act against the force of gravity which moves the bed to its fully 10 closed position" (column 4, lines 5-7),³ there is no declaration evidence to establish that Teague's gas spring does not stably retain the bed in the upright or storage position.

The appellant's reliance (substitute appeal brief at 8-9) on In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 15 1999) is misplaced. In In re Dembiczak, the claims recited an orange, premanufactured decorative bag simulating the general appearance of the outer surface of a pumpkin having facial indicia thereon. In re Dembiczak, 175 F.3d at 997, 50 USPQ2d at

³ The appellant refers to Teague column 1, lines 50-51 for the proposition that "gravity tends to hold the bed in its fully closed position." (Reply brief at 3.) We note, however, that the relied upon disclosure does not relate to Teague's counterbalancing mechanism but to other prior art. (Column 1, lines 46-68.)

1615. The claims were rejected as obvious over conventional trash bags in view of two references: one describing "how to teach children to make a 'Crepe Paper Jack-O-Lantern' out of a strip of orange crepe paper, construction paper cut-outs in the shape of facial features, and 'wadded newspapers' as filling"; and another "describing a method of making a 'paper bag pumpkin' by stuffing a bag with newspapers, painting it orange, and then painting on facial features with black paint." In re Dembiczak, 175 F.3d at 997-998, 50 USPQ2d at 1615-1616. The court reversed because there was no identification of any suggestion, teaching or motivation to combine the references or "specific--or even inferential--findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis." In re Dembiczak, 175 F.3d at 1000, 50 USPQ2d at 1618.

In contrast to In re Dembiczak, Teague provides the requisite motivation, suggestion, or teaching for one of ordinary skill in the art to combine the references and thus arrive at a treadmill encompassed by appealed claim 1. As we discussed above, Teague teaches that a particular counterbalancing mechanism including gas springs decreases the

lifting moment required to move a rotatable body (bed mattress) into its storage position while ensuring that the body does not continue its movement beyond its storage position. Although Teague relates to a counterbalancing mechanism in the context of a bed, it constitutes analogous art because the counterbalancing mechanism including gas springs addresses the same or similar problem as the gas spring assembly disclosed in the '624 patent.

For these reasons, we hold that the examiner has made out a prima facie case of obviousness and since the appellant has failed to direct us to persuasive evidence in rebuttal, we uphold the examiner's rejection on this ground.

Rejection II: Claims 4-9 over Damark, Teague, & Dalebout

Claim 4 depends from claim 3, which depends from claim 2, which in turn depends from claim 1. (FF24-25.)

2. The treadmill of claim 1 wherein said base includes a left portion positioned proximate said left side and a right portion positioned proximate said right side, wherein said left portion and said right portion each have a forward end spaced outwardly from said upright member, and wherein said roller means includes a wheel rotatably attached to said forward end of said left portion and a wheel rotatably attached to said forward end of said right portion.

3. The treadmill of claim 2, wherein said upright structure includes a left upright member and a right upright member, said right upright member being

spaced from and in general alignment with said left upright member.

5 4. The treadmill of claim 3, wherein said handle means includes a left handle mechanically associated with said left upright member and a right handle mechanically associated with said right upright member.

10 The appellant does not dispute the examiner's findings with respect to Dalebout. (FF26; substitute appeal brief at 11.) Nor does the appellant assert that one of ordinary skill in the art would not have found it obvious to combine Dalebout with Damark and Teague. Rather, the appellant refers to the same
15 arguments made against the basic combination of Damark and Teague as discussed in rejection I. (FF27.)

For reasons already discussed in rejection I, we detect no error in the examiner's basic combination of Damark and Teague. Accordingly, we uphold the examiner's rejection of appealed
20 claim 4 as well.

Rejection III: Claim 13 over Damark & Day

Claim 13 recites (FF28):

25 13. A treadmill comprising:
support structure having a base for stably positioning on a support surface to be free standing and having upright structure extending upwardly from said base;
a tread base having a frame that includes a

front, a rear, a left side, a right side and an endless belt positioned between said left side and said right side, said frame being connected to said support structure to be movable between a first position in which said endless belt is positioned for operation by a user positioned thereon and a second position in which said rear of said frame is positioned toward said support structure;

handle means associated with said support structure positioned for grasping by a user for moving said support structure with said tread base in said second position between a use position in which said support structure has said base positioned on said support surface for stably positioning said support structure on a support surface and a moving position in which said support structure is rotatably displaced from said use position;

roller means adapted to said base for engagement with said support surface when said support structure is reoriented to said moving position for movement of said support structure by the user on said support surface;

means for stably retaining said tread base in said second position relative to said upright structure with said tread base in said second position; and

wherein said treadmill is configured to have a center of gravity positioned relative to said roller means and said handle means to facilitate rotation of said treadmill about said wheel means upon application of a rotational force by the user to said handle means.

Unlike claim 1, claim 13 does not include the limitations with respect to the "gas spring" component. (FF29.) Instead, claim 13 recites (FF30) that "said treadmill is configured to have a center of gravity positioned relative to said roller means and said handle means to facilitate rotation of said

treadmill about said wheel means upon application of a rotational force by the user to said handle means." (Emphasis added.)

The examiner took the position that Damark discloses every
5 limitation of appealed claim 13 except for the claim limitation
"means for stably retaining said tread base in said second
position relative to said upright structure with said tread base
in said second position." (FF31; final Office action at 4.) To
account for this difference, the examiner relied on the
10 teachings of Day.⁴

As to the limitation "said treadmill is configured to have
a center of gravity positioned relative to said roller means and
said handle means to facilitate rotation of said treadmill about
said wheel means upon application of a rotational force by the
15 user to said handle means" (last recited element), the examiner
alleged (FF33; answer at 6):

It is inherent that Damark's treadmill (see figure) is
heavier at the roller means and as broadly claimed,
Damarks's [sic] center of gravity is positioned
20 relative to said roller means and said handle means to
facilitate rotation of said treadmill about said wheel
means upon application of a rotational force by the
user to said handle means.

⁴ Day teaches an exercising device which may be folded into
a storage position and retained in such position by use of set
screws 16. (FF32; page 2, lines 20-56; Figures 1-2.)

The appellant, on the other hand, asserted (FF34;
substitute appeal brief at 13):

5 [T]here is no teaching, suggestion, or motivation in
Damark of distributing the components of the treadmill
such that the treadmill has a center of gravity that
assists the user in tipping or rotating the treadmill
onto the wheels for transport. In fact, there is no
10 mention or discussion whatsoever in the Damark
reference regarding the placement of specific
components, weight distribution or center of gravity,
much less benefit (i.e., making it easier for the user
to rotate or tip the treadmill onto its wheels, which
is more significant in relation to heavier, motorized
15 treadmills) that is achieved and claimed by appellant.

We agree with the appellant on this issue. The contested
claim limitation calls for the treadmill to be "configured to
have a center of gravity positioned relative to said roller
20 means and said handle means to facilitate rotation of said
treadmill about said wheel means upon application of a
rotational force by the user to said handle means." While the
examiner alleged that this limitation would be "inherent" in
Damark, it is well settled that inherency may not be established
25 by mere probabilities or possibilities and that it is
insufficient to merely show that a certain thing may result from
a given set of circumstances. In re Robertson, 169 F.3d 743,
745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); accord
MEHL/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365, 52

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USPQ2d 1303, 1305 (Fed. Cir. 1999).

Here, the examiner has not identified any evidence or persuasive technical reasoning to establish that when rotational force is applied to the handle means of Damark's treadmill, the center of gravity is positioned to facilitate rotation of the treadmill about the wheels. (FF35.) Mere conjecture or speculation is not enough to shift the burden of proof to the appellant.

Accordingly, we hold that the examiner has failed to carry the initial burden of proving a prima facie case of obviousness within the meaning of 35 U.S.C. § 103(a) as to appealed claim 13. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-78 (Fed. Cir. 1984).

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Order

In sum, it is ORDERED that:

the 35 U.S.C. § 103(a) rejection of claims 1 through 3 and
10 through 12 as unpatentable over the combined teachings of

5 Damark and Teague is AFFIRMED;

the 35 U.S.C. § 103(a) rejection of claims 4 through 9 as
unpatentable over the combined teachings of Damark, Teague, and
Dalebout is AFFIRMED;

the 35 U.S.C. § 103(a) rejection of claim 13 as
10 unpatentable over the combined teachings of Damark and Day is
REVERSED.

The decision of the examiner to reject claims 1 through 13
is therefore AFFIRMED IN PART.

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Time for Taking Action

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

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AFFIRMED IN PART

10

Richard E. Schafer)
Administrative Patent Judge)

15

Romulo H. Delmendo)
Administrative Patent Judge) BOARD OF PATENT
APPEALS AND
INTERFERENCES

20

Linda M. Gaudette)
Administrative Patent Judge)

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