

Appeal No. 2013-1167  
(U.S. Serial No. 10/378,261)

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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**IN RE RAYMOND GIANNELLI**

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Appeal from the United States Patent and Trademark Office,  
Patent Trial and Appeal Board

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**BRIEF FOR APPELLEE – ACTING DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

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June 7, 2013

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## **Illustrative Claim 1**

1. A row exercise machine comprising an input assembly including a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion, the input assembly defining a substantially linear path for the first handle portion from the first position to the second position.

(A104)

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## **STATEMENT OF RELATED CASES**

The Acting Director is unaware of any other appeal from the Patent Trial and Appeal Board (Board) for the United States Patent and Trademark Office (USPTO) in connection with this patent application that has previously been before this Court. The Acting Director is also unaware of any other cases pending in this or any other court that will directly affect, or be directly affected, by the Court's decision in this appeal.

## I. STATEMENT OF THE ISSUES

Appellant Raymond Giannelli claims an exercise machine comprising handles that move in a “substantially linear path” when a user pulls on them with “a rowing motion.” Giannelli’s claimed machine also includes, *inter alia*, handles, a seat, and a chest pad. The prior art patent, U.S. Patent 5,997,447, discloses an exercise machine with handles, a seat cushion, and a vertical support cushion. The Board affirmed the Examiner’s obviousness rejection, explaining that the relevant question for an apparatus claim is not whether the prior art has the same intended use, but instead whether the prior art apparatus discloses or renders obvious all of the claimed limitations. While Giannelli argued that the prior art exercise machine used a pushing motion, the Board found the prior art was capable of being used with a pulling (or rowing) motion as well. The Board also found there was no patentable difference between the application’s claimed “substantially linear path” of motion and the prior art’s “slightly curvilinear” path. The Board rejected Giannelli’s argument that the purpose of the prior art exercise machine was different than the claimed machine, explaining that a new intended use does not make an old product patentable. The sole issue on appeal is whether substantial evidence supports the Board’s findings.

## II. STATEMENT OF THE CASE

Giannelli filed patent application 10/378,261 entitled “Rowing Machine” on March 3, 2003. A10-33. The Examiner rejected all pending claims as obvious pursuant to 35 U.S.C. § 103(a) in light of one prior art reference, U.S. Patent No. 5,997,447 (’447 patent, A173-197), which also lists Giannelli as an inventor. A3. The Board affirmed, A2-7, and this appeal followed.

## III. STATEMENT OF THE FACTS

### A. Giannelli’s application

Giannelli discloses a rowing exercise machine that provides a substantially linear path of motion for the handles when pulled. A14 at ¶ 10. The machine includes a seat (20), chest pad (22) and handles (38a and 38b). A17 at ¶¶ 21-22; Figs. 2-4 (A30-32). During operation, the user selects a weight, grasps the handles, and pulls back, moving the handles from a first position to a second position. The user then allows the handles to return to the original position. A20 at ¶ 32. During use, the handles of the machine travel in a “substantially linear path,” of motion. A18 at ¶ 26. The application asserts that the substantially linear path of motion allows the user to “maintain the proper biomechanical alignment” during the exercise. *Id.* An exemplary machine is depicted in Figure 4, with the

substantially linear path of motion for the handles during use indicated by “P.”

A32 (reproduced below).

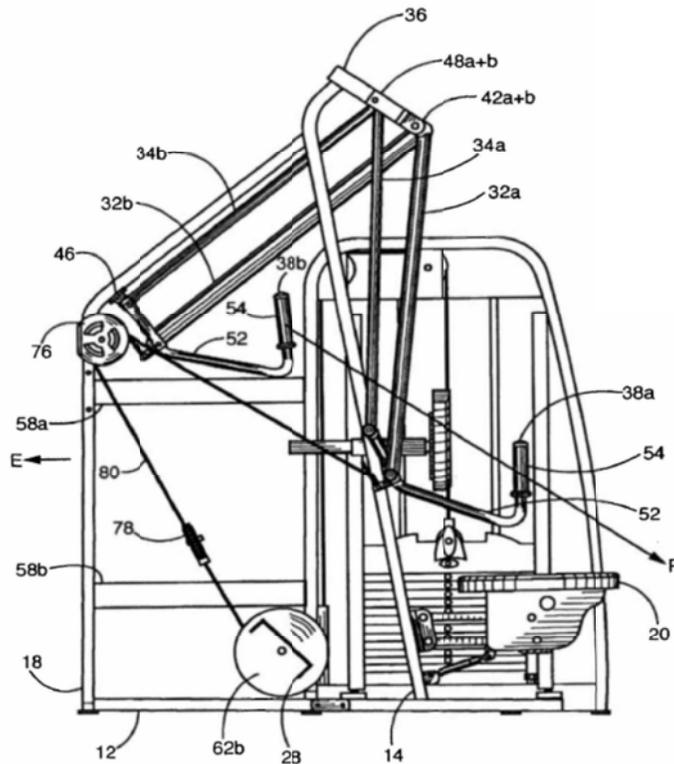


Figure 4

Claim 1 is representative of the claims in this appeal.<sup>1</sup> Claim 1 is directed to a row exercise machine comprising handles which travel in a substantially linear path when moved from a first to a second position. This claim is very general, including little more structure than an input assembly with handles. Claim 1 reads:

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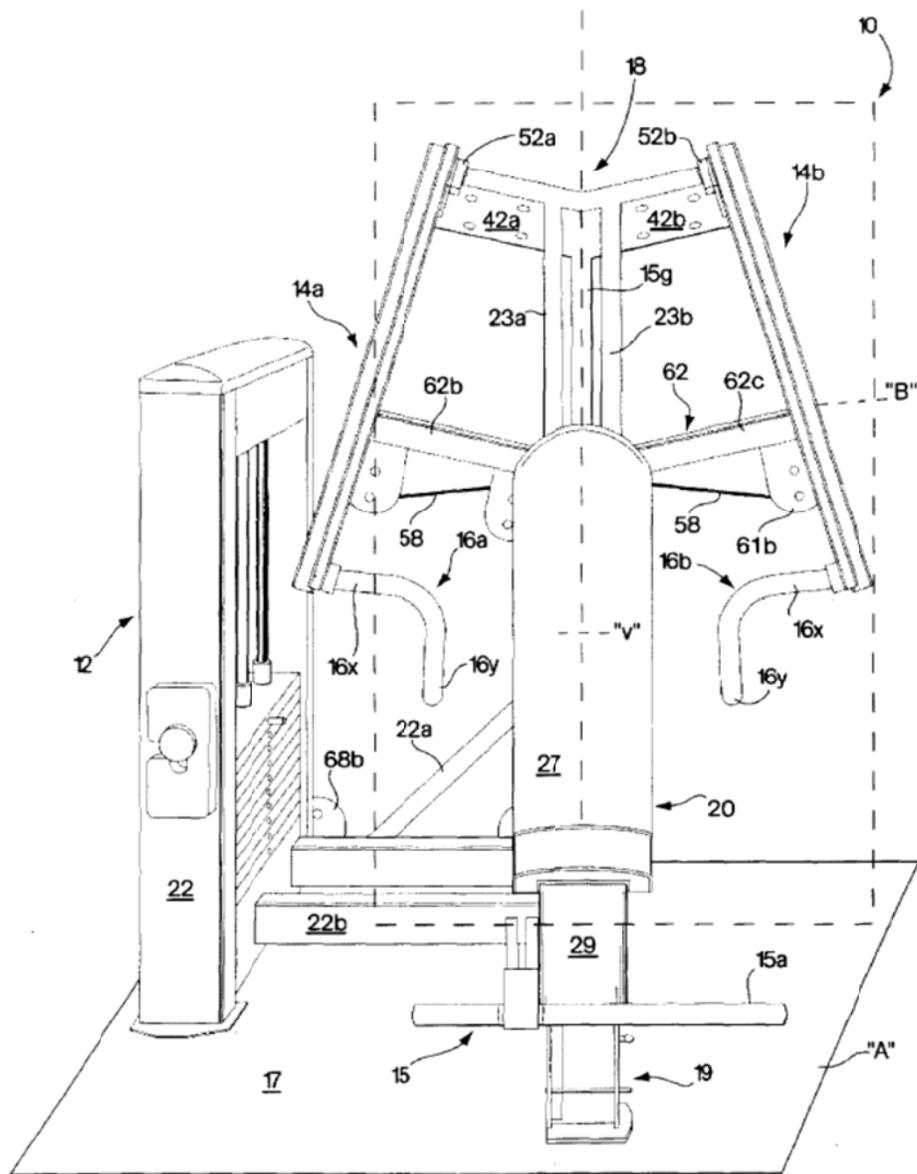
1. Before the Board, Giannelli also argued, and the Board decided, claim 23 separately. A7. Giannelli does not pursue any separate arguments about claim 23 before this court.

1. A row exercise machine comprising an input assembly including a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion, the input assembly defining a substantially linear path for the first handle portion from the first position to the second position.

A3 (emphasis added).

**B. The prior art '447 patent**

The '447 patent discloses an exercise machine with a similar arrangement of parts to the machine claimed in the Giannelli application. A173-197. The machine is suitable for “exercising regions of the upper body,” A190 col.1 ll.15-17, and includes handles (16), a seat cushion (25), and an adjustable support cushion (27). A192 col.5 ll.2-8, 47-50; see also Figures 1-2, 5, and 9-14 (A174-187). During use, the machine’s handles “travel in a slightly curvilinear . . . path,” which helps maintain “proper biomechanical alignment.” A195 col.11 ll.57-64.



'447 patent Fig. 2

### C. The Board decision

The Examiner rejected the claims at issue as obvious over the '447 patent, A81-84, Giannelli appealed, and the Board affirmed the rejection. A2-7. The Board selected claim 1 as representative of claims 1-22, 24, and 25, A3, and

addressed claim 23 separately, A7. While the specification discusses a number of different features that could be included in an exercise machine, claim 1 is broad and requires only that the exercise machine have handles that can be moved in a substantially linear path if pulled by the user. A3. While claim 23 includes more structural limitations than claim 1, A107, Giannelli only challenged the “chest pad” limitation. A7.

The Board agreed with the Examiner that claim 1 would have been obvious in view of the '447 patent.<sup>2</sup> The Board first rejected Giannelli's argument that the machine disclosed in the '447 patent “is not directed to a row exercise machine,” and explained that “the relevant issue is whether Giannelli's [prior art] apparatus is capable of being used by exerting a pulling force on the handles in a rowing motion.” A4. The Board also rejected Giannelli's argument that the absence of an explicit teaching in the '447 patent to use the disclosed machine to actually carry out a row exercise rebutted the Examiner's finding that the prior art machine was, in fact, capable of being used for a row exercise. A4-5.

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2. Although the Examiner rejected, and the Board affirmed, the claims as obvious, for at least some claims all of the limitations are disclosed by the '447 patent. In fact, the Examiner initially rejected the claims as anticipated. A62-64. This does not impact the case as “anticipation is the epitome of obviousness.” Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983); see also Johns Hopkins Univ. v. CellPro, Inc., 152 F.3d 1342, 1357 n. 21 (Fed. Cir. 1998).

The Board explained that the absence of an instruction to use the prior art machine for a row exercise “is not dispositive” since “the recitation of a new intended use for an old product does not make a claim to that old product patentable.” A5 (quoting In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). The Board also indicated that Giannelli did not provide “any persuasive argument or evidence to show” the prior art exercise machine “is incapable of being used by exerting a pulling force on the handles in a rowing motion.” A5. The Board concluded that the Examiner’s findings regarding the prior art machine’s capacity to be used for a row exercise were “reasonable” and that Giannelli “has not shown that the apparatus could not be used in such manner.” A5. The Board likewise concluded that the Examiner’s finding that the slightly curvilinear path of motion in the ’447 machine fell within the scope of the claimed “substantially linear path” was also “reasonable.” A5-6.

Regarding the “chest pad” limitation of claim 23, the Board agreed with the Examiner that there was no “structural limitation for the claimed ‘chest pad’” that was missing in the prior art support cushion. A7. The Board also explained that “the claim does not specify the location of the chest pad as opposing the row-pulling motion on the handles.” A7. Because the particular arrangement of the chest pad with respect to the rest of the machine was not claimed, and

“[u]nclaimed features of the row exercise machine cannot be relied upon for patentability,” the Board concluded that the Examiner did not err in his findings with respect to claim 23. A7. Finally, the Board rejected Giannelli’s argument that the ’447 patent is non-analogous art, observing that both the prior art and pending application are in the field of exercising the upper body. A6.

#### IV. SUMMARY OF THE ARGUMENT

Substantial evidence supports the Board's findings that the claims at issue are obvious in view of the '447 patent. Representative claim 1 is directed to an exercise machine with handles that are arranged in a way that results in a "substantially linear path of motion" when pulled by the user. Claim 23 is similar, and also includes a "chest pad." The prior art '447 patent discloses an exercise machine with a support pad and handles which travel in a "slightly curvilinear path" of motion when pushed.

The Board found that, under the broadest reasonable construction, the claimed "substantially linear" path encompasses the "slightly curvilinear" path of the prior art machine. The Board also properly found that the prior art machine could be used with a pulling motion in addition to the disclosed pushing mode of operation. Finally, the Board correctly found that the claimed "chest pad" included no structural limitations, and that the pad used in the '447 patent's exercise machine therefore met this limitation as well.

On appeal, Giannelli argues that the prior art does not disclose handles that travel in a substantially linear path if pulled because the prior art does not include an explicit instruction to use the prior art machine as part of a row exercise. It is well established, however, that a new intended use does not make an old apparatus

patentable. In this case, the breadth of the claims and the lack of structural limitations means that the prior art exercise machine either discloses or renders obvious every element of the claimed exercise machine.

Giannelli also argues that the ability to use the prior art machine in a row exercise was not inherent to the device because the '447 exercise machine was never intended to be used in that fashion. The Board, however, found that the structure disclosed in the '447 patent was inherently capable of being used in a row exercise. Whether or not the machine was ever used in a row exercise, the Board found, the structure nevertheless had the ability to be pulled, and if pulled it would exhibit the claimed property of a substantially linear path of motion. Giannelli does not rebut this finding.

Substantial evidence supports the Board's determinations. The '447 patent discloses an exercise machine with handles which travel in a substantially linear path during use. It also discloses a pad positioned within the machine structure. The claims at issue are all broad apparatus claims. The claims at issue are not, as Giannelli repeatedly argues, method claims that require the prior art teach a particular way to use the disclosed apparatus. The disclosure of the '447 patent provides substantial evidence for the rejection of the apparatus claims at issue.

## V. ARGUMENT

### A. The standard of review

This Court reviews the Board’s factual determinations for substantial evidence, and reviews legal conclusions de novo. In re Gartside, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” Consol. Edison Co. v. NLRB, 305 U.S. 197, 229 (1938). “[W]here two different, inconsistent conclusions may reasonably be drawn from the evidence in record, an agency’s decision to favor one conclusion over the other is the epitome of a decision that must be sustained upon review for substantial evidence.” In re Jolley, 308 F.3d 1317, 1329 (Fed. Cir. 2002). Whether an invention would have been obvious is a question of law based on underlying factual determinations. Gartside, 203 F.3d at 1316. What a reference discloses is a question of fact. Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc., 73 F.3d 1085, 1088 (Fed. Cir. 1995). On appeal, the appellant bears the burden to “not only show the existence of error, but also show that the error was in fact harmful because it affected the decision below.” In re Watts, 354 F.3d 1362, 1369 (Fed. Cir. 2004).

**B. Substantial evidence supports the Board’s findings that the claimed invention would have been obvious over the ’447 patent**

Claim 1 broadly claims an exercise machine comprising “a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion.” A104.<sup>3</sup> In other words, claim 1 simply requires an exercise machine with handles that can be pulled. The only further structural limitation is that the handles must move in “a substantially linear path . . . from the first position to the second position.” If an exercise machine has handles, and those handles move in a “substantially linear path” when pulled, it falls within the scope of claim 1:

1. A row exercise machine comprising an input assembly including a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion, the input assembly defining a substantially linear path for the first handle portion from the first position to the second position.

A3 (emphasis added).

Given the breadth of claim 1, the Board correctly found that the exercise machine disclosed in the ’447 patent met all of the limitations of the claim.

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3. The Board treated claim 1 as representative of claims 2-14, 16-22, 24 and 25. A3. Giannelli does not dispute that designation. Accordingly, the Acting Director likewise treats claim 1 as representative. See 37 C.F.R. § 41.37(c)(1)(iv); In re Dance, 160 F.3d 1339, 1340 n.2 (Fed. Cir. 1998).

Specifically, the Board found that the '447 patent disclosed an exercise machine with an input assembly that resulted in the handles traveling in a “slightly curvilinear” path during use. A2-5; see also A173 ('447 patent abstract) (“The tilted planes through which the four-bar linkage mechanisms travel enable the handles to travel along a slightly curvilinear downwardly diverging path . . . .”); A190 col.2 ll.41-45 (same); A191 col.3 ll.15-19 (handles travel in slightly curvilinear path during use); A195 col.11 ll.57-61 (The four bar linkage mechanisms “enable the handles 16a and 16b to travel in a slightly curvilinear . . . path, which is illustrated as ‘C’ in FIG. 11.”).

The Board also found that even though the '447 patent discloses the exercise machine being used in a “push” style exercise, the handles would travel in the same (“slightly curvilinear”) path of motion if used in a “pull” exercise. A5-6. In addition, the Board found that the handles of the '447 exercise machine were capable of being pulled; in other words, there was nothing in the structure of the machine that prevented it from being used in a row exercise. A5. Applying the broadest reasonable construction of “substantially linear,” the Board found there was no patentable difference between the “slightly curvilinear” path of the prior art handles and the claimed requirement that the handles be positioned in a way to yield a “substantially linear” path of motion. A5-6.

The Board also correctly held that the '447 patent rendered claim 23 obvious. The Board rejected Giannelli's argument that the '447 patent, which discloses a seat and support pad, does not disclose the "chest pad" limitation of claim 23. The Board explained that claim 23 "does not recite any structural limitation for the claimed 'chest pad'" that is otherwise missing from the prior art. A7. In particular, the Board explained that "the claim does not specify the location of the chest pad as opposing the row-pulling motion on the handles." A7. The Board further reasoned that "[u]nclaimed features of the row exercise machine cannot be relied upon for patentability." A7. Substantial evidence supports the Board's findings.

**C. Giannelli's arguments on appeal lack merit**

**1. The prior art need not disclose the same intended use in order to render the claimed apparatus obvious**

On appeal, Giannelli asserts that the '447 patent does not meet the "first handle portion adapted to be moved from a first position to a second position by a pulling force exerted . . . in a rowing motion" limitation of claim 1. Instead of rebutting the Board's factual findings regarding the prior art machine, Giannelli argues that the prior art could not have the claimed properties because there is no evidence that anyone ever used the machine with a pulling motion. Appellant's Br. at 15-20. This argument ignores the clear distinction between apparatus and

method claims: “It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

The claims at issue are exclusively apparatus claims directed to an exercise machine with a specific property: that the handles travel in a substantially linear path of motion when moved from a first to a second position. A104-107. There is no requirement that the apparatus must be used in a particular way, and no method claim directed towards the use of the apparatus in a row exercise. Instead, the claims simply require that the “handle portion” is “adapted to be moved . . . by a pulling force exerted by a user” with the “input assembly defining a substantially linear path” of motion for the handle. A104 (claim 1); see also A107 (claim 23: “the pair of handle portions travel to a nadir of the substantially linear path as the pair of handle portions are moved”). In other words, the handles must be able to be pulled in a substantially linear path.

The Board found that the prior art ’447 exercise machine included all of the claimed limitations. A4-6. Substantial evidence supports this finding: the ’447 patent teaches an exercise machine with four-bar linkage mechanisms and a pair of handles, A191 col.4 l.66-A192 col.5 l.10, which travel in a slightly curvilinear path between a first and second position, A191 col.3 ll.12-19, and also includes an

adjustable support cushion, A192 col.5 ll.46-50. Giannelli never rebutted this finding. A4, see also A5 (Giannelli “has not shown that the apparatus could not be used” in a row exercise.). Based on this disclosure, the Board found that the ’447 machine’s structure inherently allowed the handles to be pulled in a substantially linear path. A4-6. The Board’s finding reflects the logical conclusion that absent evidence to the contrary, handles which travel in a substantially linear path when pushed travel in that same path when pulled.

Once the Examiner (and later the Board) found that the ’447 exercise machine handles inherently had the capacity to be pulled, Giannelli had the opportunity to come forward with evidence demonstrating that the prior art handles could not, in fact, be pulled in a substantially linear path. Schreiber, 128 F.3d at 1477; see also, e.g., In re Swinehart, 439 F.2d 210, 213 (CCPA 1971) (If the Patent Office “has reason to believe” a feature is an inherent characteristic of the prior art, “it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.”).<sup>4</sup> The Board reasonably found “a user could face the handles 16a, 16b and support

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4. Although Giannelli asserts Swinehart, and other cases, are inapposite because they “involve chemical compositions,” Appellant’s Br. at 21, this distinction is unavailing. Regardless of the field, whether a limitation is disclosed in the prior art “is a factual issue on which evidence may be introduced.” Schreiber, 128 F.3d at 1477.

cushion 27 of [the '447 patent] apparatus and exert a pulling force on the handles 16a, 16b in a rowing motion,” and Giannelli never rebutted this finding. A5-6.

On appeal, Giannelli fails to identify evidence that might undermine the Board’s findings and logical conclusion, for example evidence that the prior art handles could not actually be pulled. Instead, Giannelli argues that in order to disclose the claimed apparatus, the use of the prior art machine in a pull exercise must also be “inevitable.” Appellant’s Br. at 20. This argument is meritless: Giannelli’s “contention that his structure will be used to [exercise in a row motion] does not have patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with [a row exercise].” Schreiber, 128 F.3d at 1477 (emphasis added). Giannelli cannot distinguish Schreiber on the basis that “[t]here was no dispute in [Schreiber] that the prior art reference . . . could be used for the same purpose as the claimed purpose.” Appellant’s Br. at 21. In fact, the applicant in Schreiber made, and the Court rejected, exactly this argument: that the prior art “does not disclose that such a structure can be used” for the unclaimed purpose disclosed in the specification. Schreiber, 128 F.3d at 1477. Whether or not it was inevitable to use the '447 exercise machine as part of a row exercise, it nevertheless meets the structural limitations in Giannelli’s broad claims.

The cases cited by Giannelli are not to the contrary, and merely reflect the fact specific nature of the inquiry. In Robertson, the claims required a total of three fastening elements, while the prior art only included two fastening elements. In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). As such, the two fastening elements in the prior art did not disclose the third fastening device required by the claims. Id. In Polaroid Corp. v. Eastman Kodak Co., 789 F.2d 1556, 1573 (Fed. Cir. 1986), the prior art failed to disclose the “light-shielding” function of the means-plus-function claim limitation. In re Oelrich, 666 F.2d 578, 581 (CCPA 1981), which also included a means-plus-function limitation, is similar: the Court held there was no inherency because the claimed function did not necessarily follow from the prior art disclosure. In contrast, here the Board reasonably found that the ’447 exercise machine’s handles could be pulled, and Giannelli did not proffer evidence to rebut this finding. A5. Giannelli is wrong that the prior art must also disclose the same intended use in order to render the claimed apparatus obvious. Schreiber, 128 F.3d at 1477.

Finally, Giannelli presents what he suggests is new evidence of patentability (i.e., the patents and figures in Appellant’s Brief at 12-13 and 18-19, respectively). To the extent these are actually evidence, they were never presented to the Board and cannot be presented for the first time on appeal. Watts, 354 F.3d at 1367; see

also In re Kahn, 441 F.3d 977, 990 (Fed. Cir. 2006) (judicial notice reserved for “undisputed fact[s]”). In reality, however, neither the figures nor the patents are evidence of patentability. The figures are attorney argument in picture form, suggesting possible ways the prior art machine could be used (Giannelli provides no support for his assertion that the illustrations “are as accurate a representation as any imaginable” for the “use of the ’447 chest press,” A9, A11.). They do not establish that the ’447 handles cannot be pulled, or can only be pushed. Likewise, the patentability of different claims in different patents in view of different prior art is not evidence that the broad claims at issue here are obvious. Ultimately, the new figures and arguments reinforce that Giannelli is erroneously arguing for the patentability of claims – method claims – that simply are not pending. See, e.g., Appellant’s Br. at 19 (asserting no inherency because multiple ways to use prior art machine). Substantial evidence supports the Board’s conclusion that the apparatus claims at issue on appeal are obvious in view of the ’447 patent.

**2. Giannelli waived any argument regarding claim 23 on appeal, and the Board correctly found the support pad disclosed in the ’447 patent meets the chest pad limitation in any case**

Giannelli argued claim 23 separately before the Board. On appeal, however, he does not argue claim 23 separately. Giannelli never mentions claim 23 in his brief (in his “Overview, Background and Claims of the Invention,” he quotes

claims 1, 14, 15, and 22, but not claim 23). The Acting Director addresses only the arguments Giannelli made in his brief, as Giannelli has waived the remaining arguments. See, e.g., Advanced Magnetic Closures, Inc. v. Rome Fastener Corp., 607 F.3d 817, 833 (Fed. Cir. 2010) (“This court has consistently held that a party waives an argument not raised in its opening brief.”); SmithKline Beecham Corp. v. Apotex Corp., 439 F.3d 1312, 1319 (Fed. Cir. 2006) (“Our law is well established that arguments not raised in the opening brief are waived.”).

To the extent Giannelli presents arguments regarding the chest pad limitation, see, e.g., Appellant’s Brief at 9, 11, 18-21, these arguments rely on the structural limitations of claims 14 and 22, or the “pulling force exerted by a user” limitation of claims 1 and 15. Claim 23 has neither limitation. Compare claim 23 (A107) with claims 1 (A104), 14-15 (A106), and 22 (A107). Because Giannelli did not argue claims 14, 15, and 22 separately before the Board, A3, he cannot argue them separately on appeal. See In re Suitco Surface, Inc., 603 F.3d 1255, 1261 (Fed. Cir. 2010) (“Without any reason for its decision not to separately argue [a claim] before the Board, [the applicant] has waived its separate . . . argument on appeal.”). The Board correctly found that claim 23 does not include “any structural limitation for the claimed ‘chest pad’ that [the prior art] support cushion lacks.” A7.

## VI. CONCLUSION

This Court should affirm the Board's decision because substantial evidence supports the Board's findings that the claimed apparatus is obvious in view of the exercise machine disclosed in the '447 patent.

Respectfully submitted,

June 7, 2013

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## CERTIFICATE OF SERVICE

I certify that on July 7, 2013, I electronically filed the foregoing BRIEF FOR APPELLEE – ACTING DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE using the Court’s CM/ECF filing system, which constitutes service, pursuant to Fed. R. App. P. 25(c), Fed. Cir. R. 25(a), and the Court’s Administrative Order Regarding Electronic Case Filing 6(A) (May 17, 2012).

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