

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

TONAL SYSTEMS, INC.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. _____
)	
ICON HEALTH & FITNESS, INC.,)	DEMAND FOR JURY TRIAL
)	
Defendant.)	

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Tonal Systems, Inc. (“Tonal”), for its Complaint against Defendant ICON Health & Fitness, Inc. (“ICON”), alleges as follows:

NATURE OF THE ACTION

1. This is a declaratory judgment action arising under the Declaratory Judgment Act, 28 U.S.C. § 2201 et seq. and the Patent Laws of the United States, 35 U.S.C. § 1 et seq. Tonal seeks a declaration of non-infringement of United States Patents Nos. 10,709,925 (“the ’925 Patent”) and 10,758,767 (“the ’767 Patent”) (together, the “Patents-in-Suit”).

THE PARTIES

2. Plaintiff Tonal is a corporation organized and existing under the laws of Delaware, with a principal place of business at 325 Vermont Street, San Francisco, California 94103. Tonal is the creator and manufacturer of a groundbreaking strength training machine that uses sophisticated digital technology paired with a revolutionary motor to simulate the feel of physical weights in a compact digital environment.

3. Defendant ICON is a corporation organized and existing under the laws of Delaware, with a principal place of business at 1500 South 1000 West, Logan, Utah, 84321.

4. ICON claims to be the owner by assignment of all right, title and interest in the Patents-in-Suit.

JURISDICTION AND VENUE

5. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and under the patent laws of the United States, 35 U.S.C. §§ 1 *et seq.*

6. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 1331, 1338(a), and 2201(a).

7. As described in more detail below, an immediate, real, and justiciable controversy exists between Tonal and ICON as to whether Tonal is infringing or has infringed the Patents-in-Suit.

8. ICON is subject to general personal jurisdiction in this district because it is a Delaware corporation and thus resides in the District of Delaware.

9. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b)-(c).

THE PATENTS-IN-SUIT

10. The '925 Patent, entitled "Strength Training Apparatus," issued on July 14, 2020. ICON is listed as the owner by assignment on the face of the patent. A true and correct copy of the '925 Patent is attached as Exhibit A.

11. The '767 Patent, entitled "Resistance Mechanism in a Cable Exercise Machine," issued on September 1, 2020. ICON is listed as the owner by assignment on the face of the patent. A true and correct copy of the '767 Patent is attached as Exhibit B.

**ICON'S ENFORCEMENT OF THE PATENTS-IN-SUIT
AND THREATS AGAINST TONAL**

12. ICON is a relentless and aggressive asserter of its patent portfolio, engaging in ceaseless litigation against many of Tonal's competitors. Indeed, in the last decade, ICON has

been involved in over 50 lawsuits involving patents in the same patent family as, or otherwise similar to, the Patents-in-Suit. *See, e.g., ICON Health & Fitness, Inc. v. Johnson Health Tech North America*, No. 1:10-cv-00209 (D. Utah); *ICON Health & Fitness, Inc. v. Octane Fitness LLC*, No. 8:08-cv-00437 (C.D. Cal); *ICON Health & Fitness, Inc. v. True Fitness Technology, Inc.*, No. 4:18-cv-00439 (E.D. Mo.); *ICON Health & Fitness, Inc. v. Nautilus Inc.*, No. 3:19-cv-05217 (W.D. Wash.); *ICON Health & Fitness, Inc. v. Viatek Consumer Products Group, Inc.*, No. 1:19-cv-00119 (E.D. Tenn.); *ICON Health & Fitness, Inc. v. Flywheel Sports, Inc.*, No. 2:19-cv-00022 (E.D. Tex.); *ICON Health & Fitness, Inc. v. Polar Electric Oy*, No. 1:11-cv-00167 (D. Utah); *ICON Health & Fitness, Inc. v. Strava*, No. 1:11-cv-00175 (D. Utah); *ICON Health & Fitness, Inc. v. Peloton Interactive, Inc.*, No. 1:16-cv-08303 (S.D.N.Y.); *ICON Health & Fitness, Inc. v. FitnessKeeper*, No. 1:11-cv-00173 (D. Utah); *ICON Health & Fitness, Inc. v. MapMyFitness*, No. 1:11-cv-00174 (D. Utah); *ICON Health & Fitness, Inc. v. Garmin Ltd.*, No. 1:11-cv-00166 (D. Utah); *ICON Health & Fitness, Inc. v. Wahoo Fitness LLC*, No. 8:13-cv-01065 (C.D. Cal.); *ICON Health & Fitness, Inc. v. PaceMaster, LLC*, No. 6:11-cv-00487 (E.D. Tex.); *ICON Health & Fitness, Inc. v. Saris Cycling Group, Inc.*, No. 3:13-cv-00005 (W.D. Wis.).

13. ICON has expressly accused Tonal of infringing the Patents-in-Suit. On or about August 21, 2020, attorney David R. Wright, acting on behalf of ICON, sent a letter to Tonal with the subject line “ICON Health & Fitness, Inc.’s Patents” and asserting “patent infringement” by Tonal. A true and correct copy of the August 21 letter is attached hereto as Exhibit C. ICON’s letter states that “[i]t has recently come to [ICON’s] attention that Tonal Systems, Inc. is manufacturing, using, selling, offering for sale, or importing into the United States products which practice one or more claims of the ’925 and ’767 patents.” ICON’s letter goes on to assert that “Tonal’s strength-training cable machines practice at least claim 1 of the ’925 patent,” and asserts

that the Tonal devices incorporate each of the elements of that claim. With respect to the '767 patent, ICON's letter similarly asserts that "Tonal's strength-training cable machines practice at least claim 1 of the '767 patent" and asserts that the Tonal devices incorporate each of the elements of that claim.

14. ICON's August 21, 2020 letter and its history of litigation against Tonal's competitors constitutes affirmative enforcement conduct by ICON establishing a substantial controversy of sufficient immediacy and reality regarding whether Tonal infringes any claim of the Patents-in-Suit.

COUNT I
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '925 PATENT

15. Tonal restates and incorporates by reference the allegations in the preceding paragraphs of this Complaint as if fully set forth herein.

16. As set forth above, ICON identified the '925 patent in correspondence with Tonal and asserts that Tonal's strength training device infringes one or more claims of the '925 patent.

17. Tonal, however, has not infringed and does not infringe any claim of the '925 patent, either directly or indirectly, literally or under the doctrine of equivalents.

18. Tonal does not infringe the claims of the '925 patent because Tonal's strength training device does not meet at least the limitations of "a tower" and a "magnetic mechanism" as required by claim 1 of the '925 patent. More specifically, Tonal's strength training device is wall-mounted, not a tower. Additionally, Tonal's accused device does not include the "magnetic mechanism" claimed by the '925 patent and, instead, uses a revolutionary motor, pioneered by Tonal, to simulate physical weights.

19. ICON's litigious history, the infringement allegations by ICON against Tonal, and Tonal's denial of infringement have created a substantial, immediate, and real controversy between

the parties as to the non-infringement of the '925 patent. A valid and justiciable controversy has arisen and exists between ICON and Tonal within the meaning of 28 U.S.C. § 2201.

20. A judicial determination of non-infringement is necessary and appropriate so that Tonal may ascertain its rights regarding the '925 patent.

COUNT II
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '767 PATENT

21. Tonal restates and incorporates by reference the allegations in the preceding paragraphs of this Complaint as if fully set forth herein.

22. As set forth above, ICON identified the '767 patent in correspondence with Tonal and asserts that Tonal's strength training device infringes one or more claims of the '767 patent.

23. Tonal, however, has not infringed and does not infringe any claim of the '767 patent.

24. Tonal does not infringe the claims of the '767 patent because Tonal's strength training device does not meet at least the limitations of "a tower" and an "electromagnetic unit" as required by claim 1 of the '767 patent. More specifically, Tonal's strength training device is wall-mounted, not a tower. Additionally, Tonal's accused device does not include the "electromagnetic unit" claimed by the '767 patent and, instead, uses a revolutionary motor, pioneered by Tonal, to simulate physical weights.

25. ICON's litigious history, the infringement allegations by ICON against Tonal, and Tonal's denial of infringement have created a substantial, immediate, and real controversy between the parties as to the non-infringement of the '767 patent. A valid and justiciable controversy has arisen and exists between ICON and Tonal within the meaning of 28 U.S.C. § 2201.

26. A judicial determination of non-infringement is necessary and appropriate so that Tonal may ascertain its rights regarding the '767 patent.

PRAYER FOR RELIEF

WHEREFORE, Tonal respectfully requests the following relief:

- A. Judgment that Tonal has not infringed and does not infringe any claim of the Patents-in-Suit;
- B. Judgment in favor of Tonal and against ICON on Tonal's claims; and
- C. Such further and additional relief as the Court deems just and proper.

JURY DEMAND

Tonal demands a jury trial on all issues and claims so triable.

MORRIS, NICHOLS, ARSHT & TUNNELL LLP

/s/ Jack B. Blumenfeld

OF COUNSEL:

Daralyn J. Durie
Timothy C. Saulsbury
Bethany D. Bengfort
DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111
(415) 362-6666

Jack B. Blumenfeld (#1014)
Andrew Moshos (#6685)
1201 North Market Street
P.O. Box 1347
Wilmington, DE 19899
(302) 658-9200
jblumenfeld@mnat.com
amoshos@mnat.com

Attorneys for Plaintiff Tonal Systems, Inc.

September 8, 2020