

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Tempur Sealy International, Inc.
Petitioners,

v.

Select Comfort Corporation
Patent Owner

Patent No. 5,904,172

Issued: May 18, 1999

Filed: July 28, 1997

Inventors: James Edwin Giffit and Paul James Mahoney

Title: VALVE ENCLOSURE ASSEMBLY

Inter Partes Review No. 2014-01419

REQUEST FOR RECONSIDERATION

Pursuant to 37 C.F.R. § 42.71(d), Petitioner hereby requests the Patent Trial and Appeal Board (“the Board”) reconsider its February 17, 2015, Decision (“the Decision”) denying Petitioner’s August 29, 2014, Petition (“the Petition”) for an *Inter Partes* Review (“IPR”) of U.S. Patent No. 5,904,172 (“the ‘172 patent”). For the reasons provided below, the Board’s refusal to consider the merits of the Petition was an abuse of discretion.

First, the Decision is based on an erroneous interpretation of law. The Board denied the Petition on the grounds that the Petition failed to cite to specific portions of the references themselves¹, but cited only to the Declaration of Mr. Bernard Kuchel (“the Declaration”). Decision at 6. However, the Board has already accepted petitions using the exact same format. Indeed, the PTO’s Rules and Regulations do not require that a petition cite to “specific portions of the references themselves.” Rather, the PTO’s Rules and Regulations require precisely what the Decision purports to prohibit: citation to evidence.

Second, the Decision is not based on substantial evidence. The Petition explains how the challenged claims of the ‘172 patent are obvious in view of the

¹ In fact, the Petition does cite to specific portions of the references throughout.

See e.g. Petition at 12 (“Kery discloses distributor (88)” where 88 is the number used to identify the distributor throughout the drawings and specification of Kery).

three cited prior art references in accordance with the IPR rules. The Decision itself acknowledges that “the Kutchel Declaration (Ex. 1011) provides additional information regarding each of [the stated] shortcomings” but erroneously finds that “this information is not discussed adequately in the Petition and may not be incorporated by reference.” Decision at 7. The Board’s refusal to consider evidence cited in the Declaration is an abuse of discretion.

I. Standard of Review

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). A party requesting rehearing must identify specifically all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion.

II. The Decision is an Abuse of Discretion

A. The rejection of the Petition based on its format of presenting evidence, a format described in the PTO’s Rules and Regulations

and that has been accepted by the Board in other *Inter Partes Review* (IPR) proceedings, is *per se* an abuse of discretion.

The Board's only reason for rejecting the Petition is based on the Petition's evidentiary format. Specifically, the Board rejected the Petition because the Petition did not include "any citation to specific portions of the references themselves". Decision at 6. However, the Petition does cite to specific portions of the references. For example, the Petition states that: "The distributor (88) of Kery is for use with an air inflatable mattress (air bed (10)) having at least one air bladder (the air springs (32) and elastic balls (56)) inflated by compressed air. [*Id.* at ¶ 64]. Kery discloses a pump (compressor 92)), fluidly coupled to the at least one air bladder (the air springs (32) and elastic balls (56)) via distributor (88) and corresponding air line (94), and air tubes (66) for providing compressed air to the at least one air bladder. [*Id.* at ¶ 64]" Petition at 12. As shown, the Petition cites to the Kery reference and the specific reference numbers from Kery's figures, which are citations to specific portions of the Kery reference itself.

Further, the Board's rejection overlooks and departs from the Board's established practice of accepting petitions that cite to an expert declaration, which, in turn, cites to prior art to establish factual evidence for the petition. Indeed, the Board has accepted at least four other IPR petitions using the exact same format used in this Petition. Specifically, the petitions for all of IPR Nos. 2013-00292,

2013-00293, 2013-00294, and 2013-00295, cite to an expert declaration that, in turn, cites to specific portions of the references. For instance, pages 25-27 of the petition for IPR 2013-00292 cite to an expert declaration (Ex. 1003), which, in turn, cites to specific portions of the references, to show various claims as being unpatentable. *Microsoft Corp. v. Sufrcast Inc.*, IPR2013-00292, Paper 6, 25-27, (May 22, 2013). This same format is followed in the other above-noted IPRs, all of which were accepted by the Board, and all of which had trial instituted. Indeed, in the decision instituting trial in IPR2013-00292, the Board specifically refers to pages 25-27 of the IPR 2013-00292 petition, finding those pages sufficient to institute an IPR:

Microsoft alleges that claims 1-13, 17-28, 30-33, 35-37, 39-43, and 46-50 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Duhault II. 292 Pet. 25-27; 293 Pet. 27-29; 294 Pet. 20-21. **Microsoft provides detailed explanations as to how each claim limitation is met by the cited prior art reference, and the explanations are supported by the declaration of Dr. David R. Karger.** Ex. 1003. In light of the arguments and evidence submitted by both parties, Microsoft has established a reasonable likelihood that claims 1-13, 17-28, 30-33, 35-37, 39-43, and 46-50 are unpatentable as anticipated by Duhault II.

Microsoft Corp. v. Sufrcast Inc., IPR2013-00292, Paper 19, 20 (Nov. 19, 2013)

(emphasis added). The instant Petition's format is the same as these other IPR

petitions, so there is no basis on which to distinguish the circumstances of the

present Petition from those the Board has already accepted. It is *per se* an abuse of

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