

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEMPUR SEALY INTERNATIONAL, INC.,
Petitioner,

v.

SELECT COMFORT CORP.,
Patent Owner.

Case IPR2014-01419
Patent 5,904,172

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION ON REHEARING
37 C.F.R. § 42.71(c)

I. INTRODUCTION

Petitioner, Tempur Sealy International, Inc., filed a Petition on August 29, 2014, requesting an *inter partes* review of claims 2, 3, 6, 9, 12, 13, 16, and 20–25 of U.S. Patent No. 5,904,172¹ (Ex. 1001). Paper 1 (“Pet.”). Patent Owner, Select Comfort Corp., filed a Preliminary Response on December 4, 2014. Paper 6 (“Prelim. Resp.”). The Board denied institution of an *inter partes* review. Paper 7 (“Dec.”). Petitioner filed a Request for Rehearing asking that the Board reconsider its decision not to institute. Paper 8 (“Req. Reh’g”).

We have considered the Request for Rehearing, but decline to modify the Decision.

II. STANDARD

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. *See* 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. *See Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). The party challenging the decision has the burden of showing a decision should be modified, and the request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

¹ *See also* Ex Parte Reexamination Certificate, US 5,904,172 C1, iss. Jan. 3, 2014 (Ex. 1003); Certificate of Correction, May 18, 1999 (Ex. 1005).

III. ANALYSIS

A. *Interpretation of Law*

Petitioner argues that by denying the Petition for failing to cite specific portions of the prior art references, we erroneously interpreted the law and abused our discretion. Req. Reh'g 9.

Before addressing this argument we address Petitioner's characterization that failing to cite to specific portions of the references was the Board's "only" reason for rejecting the Petition. *See* Req. Reh'g. 3. To the contrary, the lack of citations was one of several reasons that the Petition was deficient. Dec. 6–8. Therefore, even if we accepted Petitioner's argument that we erroneously interpreted the law to require that the Petition cite to the references, that would not demonstrate the Decision should be altered because it stands on other reasons. With this in mind we address Petitioner's argument.

The petition itself must: (1) "identify specific portions of the evidence that support the challenge," and (2) "specify where each element of the claim is found in the prior art patents or printed publications relied upon."² *See* Dec. 6 (citing 37 C.F.R. §§ 42.104(b)(5), 104(b)(4)).

Here the Petition is deficient in that it does not identify specific portions of the evidence (Kery and Guthrie) that support the challenge, nor does the Petition specify where each element of the claim is found in those references. Dec. 6. Contrary to Petitioner's assertion (Req. Reh'g 2–9), this deficiency is not cured by the Petition's citation to the Kuchel Declaration

² Notably, the Request for Rehearing is unpersuasive, in part, because it addresses 37 C.F.R. § 42.104(b)(4), but does not address 37 C.F.R. § 42.104(b)(5), which was also cited in the Petition. *See* Dec. 6.

(Ex. 1011) that in turn cites to the references. As stated above, the requirement applies to the Petition itself.

Nor are we persuaded by Petitioner's contention that the Board has an 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. Req. Reh'g at 3–4 (citing as examples, IPR2013-00292/293/294/295). The *inter partes* reviews identified by Petitioner are a group of cases filed together, and for that reason are better described as a single example than an “established practice.” More importantly, these cases are distinguishable from the Petition at hand. The Petitions of the cited cases make reference to prior art patents, while the Petition at hand contains no citation to a prior art patent or publication. *See, e.g.*, IPR2013-00292, *Microsoft Corporation v. Surfcase, Inc.*, Paper 6, 28 (citing Ex. 1015, 4:24–26; 29:17–23), 30 (citing Ex. 1015, 33:6–9); IPR2013-00294, *Microsoft Corporation v. Surfcase, Inc.*, Paper 4, 18 (citing Ex. 1013, 3:47–50), 20 (citing Ex. 1013, 3:47–50, 4:23–26).

Consequently, Petitioner has not demonstrated that the Decision rested upon an erroneous interpretation of law.

B. Substantial Evidence

Petitioner argues that the Decision is an abuse of discretion in that it is not based on substantial evidence because the Petition establishes a

substantial likelihood³ that the challenged claims are obvious in view of the cited art. Req. Reh’g 9–13.

A petition must provide a detailed explanation of the significance of evidence, and explain how the construed claim is unpatentable.⁴ Dec. 7–8 (citing 37 C.F.R. §§ 42.22(a)(2), 104(b)(4)).

Petitioner contends that the Petition explains how the construed claims are unpatentable, and establishes the differences between Kery and the subject matter of claim 16 by listing the elements disclosed by Kery and where an element was not disclosed by Kery, by relying upon Kery and Guthrie. Req. Reh’g 9–10 (citing Pet. 12, 14). We disagree.

The Petition states that “[t]he automated system of Kery+Guthrie would have a microprocessor and electronic pressure sensors.” Pet. 14 (citing Ex. 1011 ¶ 69); Dec. 7. Such disclosure does not sufficiently explain that Kery does not disclose a processor, nor that Guthrie does. Consequently, the Petition does not provide a detailed explanation of the evidence, nor explain sufficiently how the construed claim is unpatentable. This deficiency is further illustrated by considering the portion of the Declaration cited in the Petition.

The cited portion of the Declaration states that Kery does not disclose a processor, and cites to: another portion of the Declaration (Sections IX(B)–

³ We note that the standard in a decision to institute an *inter partes* review is not “substantial likelihood.” The Board must determine whether the information presented in a petition demonstrates a reasonable likelihood that petitioner will prevail in establishing that at least one of the challenged claims is unpatentable. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(c).

⁴ The duty to explain the differences between the prior art and the claimed subject matter is part of the duty to explain how the challenged claims are unpatentable under 37 C.F.R. § 42.104(b)(4).

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