UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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AMERICAN NATIONAL MANUFACTURING INC,
Petitioner,

v.

SLEEP NUMBER CORPORATION
f/k/a SELECT COMFORT CORPORATION,
Patent Owner.
_____

IPR2019-00497 (Patent 8,769,747 B2)
IPR2019-00500 (Patent 9,737,154 B2)
IPR2019-00514 (Patent 5,904,172)[1]
_____

Before SCOTT A. DANIELS, FRANCES L. IPPOLITO, and
ALYSSA A. FINAMORE, *Administrative Patent Judges.*

DANIELS, *Administrative Patent Judge.*

ORDER
Denying Patent Owner's Second Motion for Additional Discovery
37 C.F.R. §§ 42.24, 42.51(b)(2)

Following a conference call with the parties on October 16, 2019, and
by an Order of October 17, 2019, we authorized Patent Owner to file a
Motion for Additional Discovery ("Motion," or "Mot.") and Petitioner to file

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[1] We issue one Order and enter it in each proceeding.

an Opposition ("Opposition," or "Opp.") to the Motion in each of the above-captioned proceedings. Paper 41. Where necessary, and for purposes of brevity we refer in this Order only to documents filed in IPR2019-00497.

Patent Owner seeks additional discovery pertaining to its assertion of nexus and copying. Mot. 1–3. With its Motion (Paper 47), and proposed Discovery Requests (Exhibit 2074, "Requests") Patent Owner requests specifically that the Board require Petitioner to produce or grant access to (1) five versions of its source code that were produced in the District Court, and (2) three exhibits to Patent Owner's infringement contentions against Petitioner. Mot. 1; Ex. 2074. Patent Owner filed an Opposition (Paper 49) to the Motion and Requests. Opp. 1.

After considering the arguments, evidence, and facts of the case before us, we determine that it is not in the interests of justice to grant Patent Owner's Motion. For the reasons stated below, Patent Owner's motion is *denied*.

A. *Background*

Patent Owner's Motion is a second request for additional discovery, as it follows a previous motion for additional discovery and opposition (Papers 18, 23), which we granted in-part in an Order (Paper 34, "First Add'l Disc. Order"). Patent Owner now requests to use certain information in these IPR proceedings already obtained in the underlying District Court proceeding, specifically, five versions of Petitioner's source code ("accused source code"), apparently utilized in allegedly infringing products. Mot. 1–2. Patent Owner contends that the accused source code is relevant to secondary considerations, particularly, nexus and copying. *Id.* at 2–3. Patent Owner acknowledges that despite obtaining a modification of the

District Court's Protective Order, ("Protective Order"), the accused source code remains subject to redaction and confidentiality in the underlying district court litigation and therefore the accused source code itself, cannot currently be used in these IPR proceedings. *Id.* at 1; Ex. 3004.

Patent Owner obtained the modified Protective Order allowing Patent Owner to use certain confidential documents and information from the District Court proceeding in these IPR proceedings, except for third-party source code. *See* Ex. 3004, 9 ("[A]ny documents used in IPR must have private source code information from third parties redacted."). Petitioner asserts that all the accused source code is third-party source code. Opp. 1–2. Thus, according to Patent Owner, such assertions unreasonably block Patent Owner from using any of the accused source code from the District Court in these proceedings. Mot. 1–2.

Petitioner opposes the Motion and Requests for a variety of reasons, including that the Requests are irrelevant with respect to secondary considerations because Patent Owner may, but has strategically chosen not to, rely on its own information to show commercial success. Opp. 1. Also, Petitioner contends that Patent Owner is simply relying on its unproven allegations of infringement to assert copying, and that disclosing and using the accused source code in these proceedings would violate the rights of third-party source code owners and the District Court's Protective Order. *Id.*

B. *Patent Owner's Requests*

Because it cannot use the accused source code from the District Court proceeding in these IPR proceedings, Patent Owner proposes one Interrogatory and one corresponding Request for Production, which we reproduce below.

> **Interrogatory No. 1:** Please affirmatively provide notice that Sleep Number may Access and Use the Accused Source Code in this IPR Proceeding.
>
> **Request No. 1:** Please produce, or in the alternative provide Access and Use of, the following: (1) the Accused Source Code contained within bates numbered pages ANMISC_0001-0031, ANMISC_0038-0111, and ANMISC_0121-0437 and (2) Sleep Number's Infringement Contentions Against ANM.

Ex. 2074.

C. Analysis

We address the Interrogatory and corresponding Request for Production along with the parties' arguments below.

1. Patent Owner's Arguments

Patent Owner addresses the *Garmin* factors[2] with respect to its Requests. Mot. 3–5. Patent Owner argues that something useful will be uncovered because the accused source code is known to exist and has been inspected by Patent Owner already in the District Court case. *Id.* at 4. And, according to Patent Owner, in these proceedings "the Source Code will be instructive to the Board in analyzing secondary considerations." *Id.* at 3. Patent Owner has also apparently incorporated certain of the accused source code with its infringement contentions at the District Court, and wishes to use the infringement contentions, including the accused source code, and

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[2] *Garmin Int'l Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential). The *Garmin* factors are: (1) more than a possibility and mere allegation that something useful will be discovered; (2) requests that do not seek other party's litigation positions and the underlying basis for those positions; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests that are not overly burdensome to answer. *Id.*

related exhibits to show nexus and copying as they relate to secondary considerations in these IPR proceedings. *Id.* at 4. Patent Owner argues that using the infringement contentions and exhibits for purposes of secondary considerations in these IPRs, is not seeking Petitioner's litigation positions. *Id.* Patent Owner also argues that it cannot generate equivalent discovery because of the Protective Order, and that the accused source code is not publically available. *Id.* at 5. Also, Patent Owner contends that requesting authorization to seek a subpoena from the Board is not reasonable where the information is known to exist, has been disclosed already in the District Court, and is in possession of both parties. *Id.* Patent Owner argues that the Requests are easily understandable and not overly burdensome as they are already in the possession of both parties. *Id.*

2. *Petitioner's Arguments*

Petitioner argues that it does not own the accused source code and that Patent Owner's Requests violate the rights of third-party owners of the accused source code and disregards the District Court's Protective Order. Opp. 1–2. Petitioner argues that despite knowing that the accused source code was owned by third parties it was Patent Owner "who offered to redact third-party source code to mollify concerns about third-party rights in connection with its efforts to modify the District Court's protective order." *Id.* at 2. Petitioner argues that producing the accused source code in these IPR proceedings, effectively making an end run around the District Court's Protective Order, "does not just fail to serve the 'interests of justice,' it actively undermines this standard as set forth in 37 CFR § 42.51(b)(2)(i)." *Id.* Petitioner asserts that the appropriate course of action was for Patent Owner to seek the Board's authorization to request a subpoena for the

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