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.

_____

Case No. IPR2019-00500

Patent No. 9,737,154

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PETITIONER'S OPPOSITION TO PATENT OWNER'S ORIGINAL MOTION TO AMEND (PAPER 42)

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Petitioner American National Manufacturing, Inc. ("ANM" or "Petitioner") files this Opposition in response to Patent Owner Sleep Number Corp.'s (f/k/a Select Comfort Corp.) ("PO" or "Sleep Number") Original Motion to Amend (Paper 42) (the "MTA").[1] The appendix to the MTA provides a redline of proposed "Substitute Claims" (or the "Proposed Amendment(s)").

I. INTRODUCTION

PO files a barebones MTA. It lacks any analysis or discussion of prior art or how any Proposed Amendment addresses grounds of unpatentability. It lacks any supporting expert declaration. These deficiencies alone are ground for denial.

Nonetheless, Petitioner herein analyzes the Proposed Amendments. That analysis shows that the Proposed Amendments add nothing more than non-distinguishing, generic limitations within the ambit of prior art and do nothing to add to patentability.

Accordingly, the Board should deny the MTA.

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[1] On January 5, 2020, PO submitted an email to the Board that requested leave to file a corrected MTA in order to correct a material misrepresentation in the MTA. *See* MTA at 8 (falsely claiming that the application leading to the '747 Patent contains a claim of priority to the '172 Patent). Petitioner does not oppose this procedural request (although it disagrees with substance of PO's position regarding usage for support of the '172 Patent as discussed in § II.B.2 *infra*). It does not appear that the Board has ruled on PO's request, and to date, PO has not filed a corrected MTA.

II. ARGUMENT[2]

A. The Proposed Amendments Fail To Meet The Statutory And Regulatory Requirements

Before the patentability of the Proposed Amendments may be addressed, the claims must be shown to meet the statutory requirements of 35 U.S.C. § 316(d) and the procedural requirements of 37 C.F.R. § 42.121. That is, Patent Owner must demonstrate: (1) the amendment proposes a reasonable number of substitute claims; (2) the amendment does not seek to enlarge the scope of the claims of the patent or introduce new subject matter; (3) the amendment responds to a ground of unpatentability involved in the trial; and (4) the original disclosure sets forth written description support for each proposed claim. *See* 35 U.S.C. § 316(d)(1)(B),(3); 37 C.F.R. §42.121; *Lectrosonics, Inc., v. Zaxcom*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential). Additionally, there is a duty of candor:

> which includes a patent owner's duty to disclose to the Board information of which the patent owner is aware that is material to the patentability of substitute claims, if such information is not already of record in the case. When considering the duty of candor in connection with a proposed amendment, a patent owner should consider each added limitation. Information about an added limitation may be material even if it does not include the rest of the claim limitations.

Lectrosonics, Paper 15 at 9–10.

PO has failed to demonstrate that its proposed substitute claims meet these threshold requirements, so the MTA should be denied.

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[2] Pin citation to an exhibit in the record of this IPR proceeding refer to the exhibit page numbers added in bottom-most footer of the exhibit if multiple page numbering is present.

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