

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

**PETITIONER'S REPLY TO PATENT OWNER'S REQUEST TO RESCIND
THE FILING DATE OF THE PETITION AND DENY INSTUTION OF
THE PETTION FOR FAILURE TO TIMELY SERVE THE PETITION
UPON PATENT OWNER**

Table of Contents

I.	INTRODUCTION	1
II.	STATEMENT OF MATERIAL FACTS	2
III.	APPLICABLE LEGAL STANDARD	3
IV.	ARGUMENT	4
	A. Petitioner Timely Served Patent Owner by Serving Both Sleep Number Corporation’s Designated Litigation Counsel and the Correspondent Address of Record.....	4
	B. Petitioner Properly Identified Sleep Number Corporation as the Owner of the Patent.....	6
	C. Sleep Number is On Notice Its Patent is Subject to an IPR and Cannot Show Any Prejudice.	8
	D. Alternatively, If There Is Any Perceived Defect, the Board Could Cure on Its Own Initiative or Grant Petitioner Authorization to File a Motion to Seek Cure.....	9
V.	CONCLUSION.....	10

I. INTRODUCTION

Patent Owner Sleep Number Corp.’s (“PO”) requested relief to rescind the filing date of the Petition and deny institution of the Petition for *Inter Partes Review* (“IPR”) of Patent 9,737,154 (“’154 Patent”) should be denied.

It is indisputable that PO’s PTO counsel of record and its litigation counsel of record both were in fact served and received copies of the Petition. PO itself also received the Petition as evidence by its counsel (having been retained by PO for this IPR matter) reaching out to Petitioner’s counsel days later to address this very issue. Such satisfies the statutory and regulatory requirements.

The Petition correctly identifies the PO throughout; however, the cover page inadvertently identifies “Select Comfort Corp.” Select Comfort is PO’s former name—not a separate or distinct entity. PO operated under that name for years and years and that name is also listed on the cover page of the ’154 Patent. Patent Owner only recently executed a name change (not an assignment). PO present no controlling authority that this presents a defect as to service.

There simply is no prejudice to PO from either of these form-over-substance issues. If there is any perceived defect, it can easily be waived or cured, either by the Board or granting authorization for Petitioner to file an appropriate motion.

Accordingly, following statutory law and PTAB precedent the Board should deny PO's request and find the Petition timely filed, properly served, and the current filing date should be maintained.

II. STATEMENT OF MATERIAL FACTS

1. PO first filed a civil action against Petitioner alleging infringement of the '154 Patent on December 29, 2017, and served it January 2, 2019. Ex. 1018 ("Elliott Decl."), ¶ 6, Ex. 1023.

2. The third page of the Petition refers to the '154 Patent as "Mahoney," stating "Mahoney is assigned to Sleep Number Corporation" (Petition, Paper 2 at 3 ("Pet.")), and the Petition identifies PO as litigating the '154 Patent against Petitioner (Pet. at 1 (identifying the co-pending California District Court ("C.D. Cal.") litigation)), jointly stayed by court order in view of this IPR. *See* Elliott Decl., ¶ 2, Ex. 1019.

3. Petitioner served the Petition by FedEx Saturday delivery upon Ms. Patton on December 21, 2018, and it was received December 26, 2018. Pet. at 66; and Elliott Decl., ¶ 3, Ex. 1020. Ms. Elizabeth Patton of Fox Rothschild LLP, Minneapolis, MN is litigation counsel for PO in the C.D. Cal. litigation. Ex. 1017.

4. Petitioner served the Petition by FedEx Saturday delivery upon PO's listed correspondent of record, Fish and Richardson P. C., Minneapolis, MN, on

December 21, 2018, and it was received December 26, 2019. Pet. at 66; and Elliott Decl., ¶ 4, Ex. 1021.

5. On January 10, 2019, Mr. Lukas Toft of Fox Rothschild LLP, Minneapolis, MN, acknowledged receipt of the Petition, and corresponded with Petitioner's counsel on behalf of PO regarding service of the petition. Elliott Decl., ¶ 5, Ex. 1022; and Ex. 2007 ¶ 2.

6. On January 11, 2019 Mr. Toft requested a telephone conference with the Board seeking guidance regarding a service issue. *See* Paper 5 at 2.

7. This Reply to Patent Owner's Preliminary Response ("PR") is authorized by the Board. *See* Paper 5 at 4-5.

III. APPLICABLE LEGAL STANDARD

The statutory requirements for consideration of an IPR include that "the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner." 35 U.S.C. § 312(a)(5) (emphasis added). Serving the Petition upon a designated representative of the patent owner is sufficient. *See Micron Tech., Inc. v. e.Digital Corp.*, IPR2015-00519, Paper 14 at 4 (PTAB Mar. 24, 2015 (finding service of a petition on active litigation counsel independently effects service of the petition under § 312(a)(5)). The regulations promulgated pursuant to the statute state that "[t]he petitioner may additionally serve the petition and

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.