

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.

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Cases<sup>1</sup>

IPR2019-00497 (Patent 8,769,747)

IPR2019-00500 (Patent 9,737,154)

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Before KEN B. BARRETT, SCOTT A. DANIELS, and  
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceedings  
37 C.F.R. § 42.5

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<sup>1</sup> This Order addresses issues that are the same in both cases. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Petitioner's counsel requested, by an email dated May 7, 2019, authorization to file a second or expanded Reply to Patent Owner's Preliminary Response.<sup>2</sup> We deny this request for the following reasons.

First, the email is improper because it contains detailed arguments responding to the Patent Owner's Preliminary Response. Substantive arguments are not permitted in email correspondence with the Board. Second, Petitioner is not entitled as a matter of right, to enter a Reply to a Patent Owner Preliminary Response. 35 U.S.C. § 313; 42 C.F.R. § 42.108(c). Even considering just these two points, Petitioner's email is troubling as it is nothing less than a Motion for a reply to Patent Owner's Preliminary Response or, considering the amount of substantive arguments contained in the email, effectively a Reply Brief. *See* 37 C.F.R. § 42.20(a). Such a practice is concerning because, not only does the Board have to respond to the correspondence, but it distracts the Board from the mission to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. §42.1 (b). Additionally, it is prejudicial to the other party, who has no formal recourse to oppose, except to compound the situation by sending its own email. Further, Petitioner's correspondence circumvents our rules prohibiting the filing of a motion without prior authorization. *See* 37 C.F.R. § 42.20(b).

Moreover, "good cause" does not exist simply because Petitioner surmises that it needs "to correct the record as to a number of misleading

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<sup>2</sup> We previously authorized Petitioner to file a ten page Reply "addressing only the issue of service and issues relating to service of process raised in the Patent Owner Preliminary Response." *See, e.g.*, IPR2019-00497, Paper 6, 4–5.

statements of fact and arguments made by Patent Owner,” as Petitioner’s email states. 42 C.F.R. § 42.108(c). Whether or not the presentation of evidence and arguments in a brief is “misleading” is highly subjective and, in this case, we determine that the allegations of misleading assertions does not rise to the level of good cause justifying the need for a reply. It is the very nature of the Board and *inter partes* review proceedings to consider the arguments of both parties, weigh the evidence, determine the most compelling arguments, and make determinations to which the applicable law is applied. 35 U.S.C. § 314.

The arguments in Petitioner’s email state simply a disagreement with Patent Owner’s positions taken in its Preliminary Response, which at best, we find unpersuasive as to a showing of good cause.

Contrary to Petitioner’s assertion, due process in this case does not favor a second reply brief. As permitted by statute and our rules, both parties have been permitted an equal opportunity to submit their pre-institution briefs. 42 C.F.R. §§ 42.102, 107. To the extent that the Board does not institute a trial, if Petitioner is dissatisfied with the Board’s decision it may request rehearing and at that time has an opportunity to identify a matter believed to have been misapprehended or overlooked. 37 CFR 42.71(d)(1).

Finally, we instruct the parties that in any request for a conference call with the Board to resolve a dispute, the requesting party shall: (a) certify that it has conferred with the other party in an effort to resolve the dispute; (b) identify (without substantive argument) with specificity the issues for which agreement has not been reached; (c) identify (without substantive argument) the precise relief to be sought; and (d) propose two or more specific dates and times at which both parties are available for the conference call.

IPR2019-00497 (Patent 8,769,747)

IPR2019-00500 (Patent 9,737,154)

It is

ORDERED that Petitioner's request for leave to file a reply is *denied*;

IPR2019-00497 (Patent 8,769,747)

IPR2019-00500 (Patent 9,737,154)

PETITIONER:

Kyle L. Elliott

Kevin S. Tuttle

Jaspal S. Hare

SPENCER FANE LLP

kelliott@spencerfane.com

ktuttle@spencerfane.com

jhare@spencerfane.com

PATENT OWNER:

Steven A. Moore

Kecia J. Reynolds

PILLSBURY WINTHROP SHAW PITTMAN LLP

steve.moore@pillsburylaw.com

kecia.reynolds@pillsburylaw.com

Luke Toft

FOX ROTHSCHILD LLP

ltoft@foxrothschild.com