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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Case No. IPR2019-00500
Patent No. 9,737,154 B2

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PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

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Introduction

Patent Owner ("PO") requests the Board require Petitioner ("ANM") produce (1) five versions of ANM's source code printed on bates numbered pages ("Source Code") in the district court case ("District Court Case"), and (2) the three exhibits to PO's Infringement Contentions against ANM ("Contentions") (*See* Ex. 2074.)

Factual and Procedural Background

During the District Court Case, ANM made various accused Source Code available for inspection at its counsel's offices under strict procedures set forth in the District Court Protective Order ("DCPO"). Following inspection, PO drafted and served Infringement Contentions that refer to nine versions of Source Code line numbers, variables, and functions, including the five versions requested herein.

On September 26, 2019, after PO sought use from the District Court, per the Board's guidance, of District Court documents in this IPR (including Source Code), the District Court modified the DCPO, but based on ANM's opposition arguments, held that PO must redact, *i.e.* not use, third-party source code in documents used in this IPR. (*See* Ex. 2071 ¶ 9; Ex. 2043.)[1] While thereafter meeting and conferring on October 10, 2019 to formulate a stipulated protective order for this IPR (*see* Ex.

[1] PO made the initial offer to redact third-party code believing that only Medisphere code, one of nine versions of Source Code, would require redaction.

2024), ANM took the position, only 13 days prior to Due Date 1 for PO's Patent Owner Response ("POR") and in a surprise to PO, that ***all*** Source Code constitutes third-party source code that must be redacted and cannot be provided to the Board. (*See* Ex. 2071 ¶ 11.) ANM later offered access to the Platinum code owned by Elsyn, but subsequently rescinded its offer and claimed it had no authority to consent to the use of any Source Code. (*Id.* ¶ 11; Ex. 2073.) Accordingly, PO did not learn until October 10, 2019 it could not use ***any*** Source Code in this IPR. PO immediately notified ANM it wanted to request a conference with the Board. (Ex. 2071 ¶ 12.) The parties requested one on October 14 and it was held October 16, 2019. As a result of the call, PO narrowed its discovery requests to five versions of Source Code.

Argument

I. The Source Code is Probative to Questions of Patentability.

PO requests use of the Source Code because it is narrowly related to copying and nexus. "Evidence of copying tends to show nonobviousness." *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1336 (Fed. Cir. 2019).[2] "[E]vidence of efforts to replicate a specific product" is probative of copying. *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010). Further, as articulated in the POR, nexus is

[2] *See also Silicon Labs., Inc. v. Cresta Tech. Corp.*, No. IPR2015-00626, 2016 WL 8969909, at *13 (P.T.A.B. Aug. 11, 2016) (competitor copying may be relevant).

required to show secondary considerations. (*See* Paper 45 at 67); *see also Brown & Williamson Tobacco Corp. v. Phillip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000) ("[I]f the marketed product embodies the claimed features, and is coextensive with them, then a nexus is presumed and the burden shifts to the party asserting obviousness to present evidence to rebut the presumed nexus.").

II. PO's Request is Timely.

As detailed above, per the Board's guidance, PO first sought use of the Source Code through modifying the DCPO. It was not until September 26, 2019 that the District Court issued its order prohibiting use of third-party source code, and it was not until October 10, 2019 that PO learned ANM was taking the position that ***all*** Source Code is third-party owned. PO requested to file this motion immediately.

III. Discovery is Appropriate as to the Source Code in This Case.

The Panel may order additional discovery if it "is in the interests of justice," which involves considering the five *Garmin* factors discussed in detail below. *Kingston Tech. Co., Inc. v. CATR Co., Ltd.*, IPR2015-00149, Paper 24 at 2 (PTAB June 10, 2015) (citing 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2)); *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB March 5, 2013). Here, PO's request is in the interests of justice because the Source Code will be instructive to the Board in analyzing secondary considerations. This is especially true as ANM should not be allowed to use this IPR proceeding as both a

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