

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 B2

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION FOR ADDITIONAL DISCOVERY**

TABLE OF CONTENTS

Introduction 1

Factual Background 1

I. ANM’s Discovery Requests Do Not Satisfy the *Garmin* Factors. 1

 A. The Requests Do Not Have Any Possibility of Usefulness..... 2

 B. ANM Can Generate Equivalent Discovery. 4

 C. The Requests Are Burdensome, Seek PO’s Litigation Positions,
 and Are Not Tailored or Understandable..... 5

II. ANM’s Discovery Requests Are Untimely. 5

Introduction

Patent Owner (“PO”) opposes Petitioner’s (“ANM”) belated Motion for Additional Discovery (“Motion”) because ANM’s discovery requests seek expansive, overbroad, and burdensome marketing and advertising financial information not relevant to any arguments pending before the Board.

Factual Background

Following PO’s motion for additional discovery, the Board previously ordered ANM to produce a certain subset of data related to ANM’s financials. (Paper 34.) PO’s economics expert analyzed and opined on that ANM data, which PO cited in the secondary considerations argument of its Patent Owner Response (“POR”). (See Paper 46 (“POR”) at 66–68; Ex. 2030.) Other PO experts analyzed PO’s products for purposes of a copying opinion, but not for any opinion as to PO’s financials or to the success of PO’s products as ANM contends. (See POR at 61–65; Exs. 2027, 2029.) No PO expert opined on PO’s financials or product success, nor did PO rely on such evidence in its POR. (See POR & accompanying Exs.)

I. ANM’s Discovery Requests Do Not Satisfy the *Garmin* Factors.

The Board may order additional discovery if it “is in the interests of justice,” which involves considering the five *Garmin* factors discussed below. See 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 (P.T.A.B. Mar. 5, 2013). ANM’s requests fail to

satisfy these factors because they are overbroad, burdensome, not sufficiently limited in scope, seeking data available elsewhere, and irrelevant.

A. The Requests Do Not Have Any Possibility of Usefulness.

There is no evidence tending to show beyond speculation that something useful will be uncovered by ANM's requests. *See Garmin*, IPR2012-00001, Paper 26 at 6–8.¹ In satisfying its initial burden on secondary considerations, PO relied upon evidence of (1) ANM's commercial success, (2) industry praise, and (3) copying and industry adoption. (POR at 59–68.) The requested data relating to PO's financials could only be relevant (if at all) to rebut an argument relying on PO's marketing and sales, which was not made. Therefore, the requested data cannot rebut PO's arguments and is not relevant.

Attempting to circumvent this, ANM essentially lumps all secondary consideration factors together, arguing that the success of PO and its products (or lack thereof) could refute PO's arguments related to ANM's success or to copying of PO's products. This is nonsensical. PO's marketing efforts are irrelevant to ANM's sales or commercial success. *See Pfizer Inc. v. Ivax Pharm., Inc.*, No. CIV.A.07CV00174(DMC), 2009 WL 2905454, at *6 (D.N.J. Sept. 9, 2009)

¹ For two of its requests, ANM admits they only “may show” certain information, which is insufficient under this factor. (Ex. 2076 at Reason for Interrog. 8, 9.)

(marketing of one product cannot impact commercial success analysis of different product).² Moreover, even ANM’s cited cases demonstrate that evidence rebutting each factor must actually relate to that factor. *See Seadrill Ams., Inc. v. Transocean Offshore Deepwater Drilling, Inc.*, IPR2015-01929, Paper 103 at 46–64 (P.T.A.B. May 18, 2017) (analysis involves “placing the evidence offered” into different “buckets – commercial success, praise, copying, etc.” but recognizing that certain evidence may relate to more than one bucket, *e.g.* to either “praise” or “copying”); *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329–37 (Fed. Cir. 2016) (evaluating evidence related to each factor separately).

Simply put, ANM seeks evidence it cannot use to rebut PO’s secondary considerations arguments, which relate to ANM’s commercial success, not PO’s. ANM’s requests should thus be denied. *See Prong, Inc. v. Yeoshua Sorias*, IPR2015-01317, Paper 22 at 4–6 (P.T.A.B. Mar. 10, 2016) (denying motion for additional discovery because party had “not provided a threshold amount of reasoning or

² Additionally, ANM’s reliance on PO’s recent marketing efforts rather than those at the time the patented technology was introduced (*i.e.* 1998 and 2008) supports a finding that requests for 25 years of marketing data is pure speculation. (*Compare* Motion at 2–4 (relying on a 2019 10-K, website, and marketing deal) *with* Ex. 2077 (containing public links to PO’s 10-Ks dating back to the late 1990s).)

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.