

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)

IPR2019-00514 (Patent 5,904,172)

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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 all three 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.

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IPR2019-00514 (Patent 5,904,172)

Patent Owner requested, by several emails dated January 11, 2019, January 16, 2019, and March 13, 2019, a telephone conference with the Board seeking guidance as to Patent Owner's assertion that each of the Petitions in the above-captioned cases are defective because service of the Petitions was improper.<sup>2</sup> Patent Owner's counsel contended in its third email of March 13, 2019 that because it disputed service of process, no mandatory notices were due and that the filing dates of the Petitions should be rescinded. Following the third email, the Board requested that Patent Owner provide relevant statutory and regulatory provisions and case law supporting its argument with respect to service of process and the purported defects in the Petitions. Patent Owner's counsel subsequently provided via email on March 19, 2019, citations to certain rules and PTAB cases upon which it relies for its position.

A conference call including Judges Daniels, Barrett, and Ippolito, as well as, among others, Patent Owner's counsel, Mr. Steve Moore, and Petitioner's counsel, Mr. Kyle Elliot, was conducted on March 20, 2019. During the call Mr. Moore explained that he did not file mandatory notices within the time proscribed by 37 C.F.R. § 42.8(a)(3) out of concern that filing such notices was an acknowledgement or acquiescence to service of process, and that Patent Owner did not concede that service of the Petitions was proper in these proceedings. The Board explained that mandatory notices, are in fact *mandatory*, so that the Board has knowledge of who represents Patent Owner in these proceedings and can appropriately and

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<sup>2</sup> Patent Owner's first two emails were sent to the Board prior to the cases being assigned to a panel.

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timely communicate with the correct legal representative of the Patent Owner. We noted that we will not consider the filing of the mandatory notices as waiver of any argument that Patent Owner might make in this proceeding regarding the assertion of improper service of process. Patent Owner's counsel was instructed to file the appropriate Mandatory notices by close of business March 21, 2019.

Patent Owner's counsel, Mr. Moore, asserted during the call that in captioning the Petitions with Patent Owner's previous name, "Select Comfort Corporation," Petitioner failed to properly serve the correct entity. Also, Mr. Moore argued that Petitioner failed to provide service at the proper correspondence address of record as required under 37 C.F.R. § 42.105(a). In view of these deficiencies, Mr. Moore contends that the Board should dismiss the current Petitions and that Petitioner cannot, now, refile, and properly serve Patent Owner within the 1-year time bar following service of process in the underlying district court litigation under 35 U.S.C. § 315(b).<sup>3</sup>

Petitioner's counsel, Mr. Elliot, argued that the correct entity was properly served, namely that "Select Comfort Corporation" was the same corporate entity as "Sleep Number Corporation" is now, and considering that this was simply a name change effected in 2017, not a corporate restructuring, reorganization, or substantive change in corporate entity. Mr. Elliot argued that the proper recourse was to allow Petitioner to file a motion

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<sup>3</sup>The parties explained that litigation in the United States District Court Central District of California, Case No.: 5:18-cv-00357-AB-SP, is currently stayed, pending the outcome of the Board's relevant decisions and determinations in these IPR's with regards to filing dates and institution of *inter partes* review.

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to correct this clerical defect under 37 C.F.R. § 42.104(c), so that the case headings reflect the current name of Patent Owner–Sleep Number Corporation. Mr. Elliot argued further that the appropriate representatives at the correct correspondence addresses, were in fact served, namely counsel as listed in the Office’s Patent Assignments database as the proper correspondence address of record, as well as counsel of record handling the underlying litigation in the district court litigation of the patents at issue in these proceedings.

After brief discussions relating to service of process under 37 C.F.R. §§ 42.105–106 and a recap of certain PTAB decisions relating to service, we instructed Patent Owner to submit its arguments relating to insufficiency of service of process in its Patent Owner Preliminary Response. We also granted Petitioner a 10-page Reply to Patent Owner’s Preliminary Response in each of these proceedings, due two weeks following the filing of the Preliminary Responses for each respective case, and addressing only the issue of service and any issues relating to service of process raised in the Patent Owner Preliminary Response. No sur-reply by Patent Owner is authorized.

It is

ORDERED that Patent Owner shall file its Mandatory Notices under 37 C.F.R. § 42.8(a)(3).

FURTHER ORDERED that Patent Owner will submit its arguments relating to insufficiency of service of process in its respective Patent Owner Preliminary Responses.

FURTHER ORDERED that Petitioner is authorized a 10 page Reply, due two weeks following the respective filing date of each Preliminary

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Response, and addressing only the issue of service and issues relating to service of process raised in the Patent Owner Preliminary Response.

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