

Allee, J. Lori

From: L Toft <ltoft@foxrothschild.com>
Sent: Friday, January 11, 2019 4:54 PM
To: trials@uspto.gov
Cc: Tuttle, Kevin; Elliott, Kyle L.; Hare, Jaspal; e patton; A Hansen; Steve Moore; Nicole Cunningham; k ecia
Subject: Re: IPR2019-00497; IPR2019-00500; IPR2019-00514

Dear Board,

Patent Owner Sleep Number Corporation respectfully request the Board's guidance. On December 21, 2018, Petitioner filed petitions in IPR2019-00497, challenging the validity of U.S. Patent No. 8,769,747 ("the '747 Patent"), and IPR2019-00500, challenging the validity of U.S. Patent No. 9,737,154 ("the '154 Patent"). On December 29, 2019, Petitioner filed IPR2019-00514, challenging the validity of U.S. Patent No. 5,904,172 ("the '172 Patent").

Sleep Number disputes whether the patent owner was properly named and served. The parties met and conferred on Friday, January 11, 2019 regarding this dispute. Sleep Number respectfully requests a telephone call with the Board regarding this issue and the parties are jointly available at the following times:

Monday, January 13: 11am to 7pm EST

Tuesday, January 14: 11am to 12pm EST and 2pm to 5pm EST

To provide further information in advance of the requested telephone conference, brief summaries of the parties' respective positions are set forth below.

Sleep Number's Position

It is Sleep Number's position that the each of the petitions are defective, that service is improper, and that no filing date should be afforded because each of the petitions name Select Comfort Corporation as the patent owner, whereas Sleep Number Corporation owns each of the patents at issue. Accordingly, Sleep Number does not intend to file Mandatory Notices pursuant to 37 C.F.R. § 42.8 until the Board is able to provide guidance on how to proceed. Sleep Number's counsel can provide additional detail regarding its position upon request or during the requested telephone call with the Board. Sleep Number disagrees with Petitioner's position, which is pasted below at their request.

Petitioner's position in the communication to the Board at the request of Fox Rothschild LLP, counsel for patent owner in IPR2019-00497, IPR2019-00500, and IPR2019-00514:

Petitioner American National Manufacturing, Inc. joins in this request to state:

1. Petitioner requests this email should copy Petitioner;
2. Petitioner has served the above IPR petitions on the patent owner and designated representative of patent owner pursuant to 35 USC 312(a)(5) and 37 CFR 42.105(a);
3. Petitioner opposes patent owner's request to address this issue until they have: (a) complied with 37 CFR 42.8(a)(2) in each of the above IPR proceedings; and (b) addressed the issue pursuant to 37 CFR 42.107 in each proceeding; and
4. Kyle Elliott and Kevin Tuttle, counsel for Petitioner, are available for a call with the Board: Monday, Jan. 14 after 11:00 am (EST); or Tuesday, Jan. 15 after 11:00 am (EST).

We look forward to the Board's response.

Sincerely,
Luke Toft

Luke Toft

Associate

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