

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. IPR2019-00514

Patent No. 5,904,172

**PETITIONER'S REPLY TO PATENT OWNER'S REQUEST TO RESCIND
THE FILING DATE OF THE PETITION AND DENY INSTUTION OF
THE PETTION FOR FAILURE TO TIMELY SERVE THE PETITION
UPON PATENT OWNER**

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I. INTRODUCTION

Patent Owner Sleep Number Corp.’s (“PO”) requested relief to rescind the filing date of the Petition and deny institution of the Petition for *Inter Partes Review* (“IPR”) of Patent 5,904,172 (“’172 Patent”) should be denied.

It is indisputable that PO’s PTO counsel of record and its litigation counsel of record both were in fact served and received copies of the Petition. PO itself also received the Petition as evidence by its counsel (having been retained by PO for this IPR matter) reaching out to Petitioner’s counsel days later to address this very issue. The evidence and PO’s actions show the statutory and regulatory requirements have been met.

The Petition correctly identifies the PO throughout; however, the cover page inadvertently identifies “Select Comfort Corp.” Select Comfort is PO’s former name—not a separate or distinct entity. PO operated under that name for years and years and that name is also listed on the cover page of the ’172 Patent. Patent Owner only recently executed a name change (not an assignment). PO present no controlling authority that this presents a defect as to service.

PO is on notice of this challenge to the ’172 Patent, and there simply is no prejudice to PO from either of these form-over- substance issues. If there is any perceived defect, it can easily be waived or cured, either by the Board or granting authorization for Petitioner to file an appropriate motion.

Accordingly, following statutory law and PTAB precedent the Board should deny PO's request and find the Petition timely filed, properly served, and the current filing date should be maintained.

II. STATEMENT OF MATERIAL FACTS

1. PO first filed a civil action against Petitioner alleging infringement of the '172 Patent on December 29, 2017, and served it January 2, 2019. Ex. 1029 ("Elliott Decl."), ¶ 6, Ex. 1034.

2. The fourth page of the Petition refers to the '172 Patent as "Gifft," stating "Gifft is assigned to Sleep Number Corporation" (Petition, Paper 2 at 4 ("Pet.")), and the Petition identifies PO as litigating the '172 Patent against Petitioner (Pet. at 1 (identifying the co-pending California District Court ("C.D. Cal.") litigation)), jointly agreed to an stayed by court order in view of this IPR. *See* Elliott Decl., ¶ 2, Ex. 1030.

3. Petitioner served the Petition by FedEx FedEx Priority Overnight® upon Ms. Patton on December 29, 2018, and it was received January 2, 2019. Pet. at 70; and Elliott Decl., ¶ 3, Ex. 1031. Ms. Elizabeth Patton of Fox Rothschild LLP, Minneapolis, MN is litigation counsel for PO in the C.D. Cal. litigation. Exs. 1023 and 1038 at 2.

4. Petitioner served the Petition by FedEx Priority Overnight® upon PO's listed correspondent of record, Fish and Richardson P. C., Minneapolis, MN, on

December 29, 2018, and it was received January 2, 2019. Pet. at 70; and Elliott Decl., ¶ 4, Exs. 1032 and 1039 at 2.

5. On January 10, 2019, Mr. Lukas Toft of Fox Rothschild LLP, Minneapolis, MN, acknowledged receipt of the Petition, and corresponded with Petitioner's counsel on behalf of PO regarding service of the petition. Elliott Decl., ¶ 5, Ex. 1033; and Ex. 2007 ¶ 2.

6. On January 11, 2019 Mr. Toft requested a telephone conference with the Board seeking guidance regarding a service issue. *See* Paper 6 at 2.

7. This Reply to Patent Owner's Preliminary Response ("PR") is authorized by the Board. *See* Paper 6 at 4-5.

III. APPLICABLE LEGAL STANDARD

The statutory requirements for consideration of an IPR include that "the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner." 35 U.S.C. § 312(a)(5) (emphasis added). Serving the Petition upon a designated representative of the patent owner is sufficient. *See Micron Tech., Inc. v. e.Digital Corp.*, IPR2015-00519, Paper 14 at 4 (PTAB Mar. 24, 2015) (finding service of a petition on active litigation counsel independently effects service of the petition under § 312(a)(5)). The regulations promulgated pursuant to the statute state that "[t]he petitioner may additionally serve the

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