

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEMPUR SEALY INTERNATIONAL, INC.,
Petitioner,

v.

SELECT COMFORT CORP.,
Patent Owner.

Case IPR2014-01419
Patent 5,904,172 C1

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Tempur Sealy International, Inc., seeks review of claims 2, 3, 6, 9, 12, 13, 16, and 20–25 of U.S. Patent No. 5,904,172¹ (issued May 18, 1999) (Ex. 1001, “the ’172 patent”). See Paper 1 (“Pet.”). Patent Owner, Select Comfort Corp., contends that Petitioner’s request should be denied. See Paper 6 (“Prelim. Resp.”). After considering the Petition and Preliminary Response, we determine that Petitioner has not established a reasonable likelihood of prevailing with respect to any of the challenged claims of the ’172 patent. See 35 U.S.C. § 314(a). Accordingly, we deny the Petition, and decline to institute *inter partes* review.

A. *Related Proceedings*

Petitioner states that Patent Owner has asserted infringement of the ’172 patent against the Petitioner in the co-pending district court case: *Select Comfort Corporation v. Tempur Sealy International, Inc.* d/b/a/ Tempur-Pedic (Civil Action No. 0: 14-cv-00245-JNE-JSM) (D. Minn.).² Pet. 2.

¹ See Ex Parte Reexamination Certificate, US 5,904,172 C1, issued Jan. 3, 2014 (Ex. 1003); Certificate of Correction, May 18, 1999 (Ex. 1005).

² Served on Petitioner on Feb. 7, 2014.

B. Asserted Grounds and Prior Art

Petitioner asserts the following grounds of unpatentability:

Claims challenged	Statutory Basis	References
6, 16, 20, 21	§ 103(a)	Kery ³ and Guthrie ⁴
2, 3, 12, 13, and 22–25	§ 103(a)	Kery, Moulton ⁵ , and Guthrie
9	§ 102(b)	Kery
9	§ 103(a)	Kery and Guthrie

C. The '172 Patent

The '172 patent relates to an electric pump for use with an inflatable mattress. Ex. 1001, 1:4–5. Valve enclosure assembly 100 includes processor board 20, and is preferably incorporated into an air mattress system having at least one bladder (e.g., left or right bladder 122, 124) fluidly coupled to pump 112. *Id.* at 2:56–57; 3:60–64; 4:3–10; Figs. 2, 3.

³ Ex. 1006, US Patent No. 3,784,994 (Jan. 15, 1974).

⁴ Ex. 1008, US Patent No. 5,235,713 (Aug. 17, 1993).

⁵ Ex. 1007, US Patent No. 4,527,298 (July 9, 1985).

Figure 3 of the '172 patent is reproduced below:

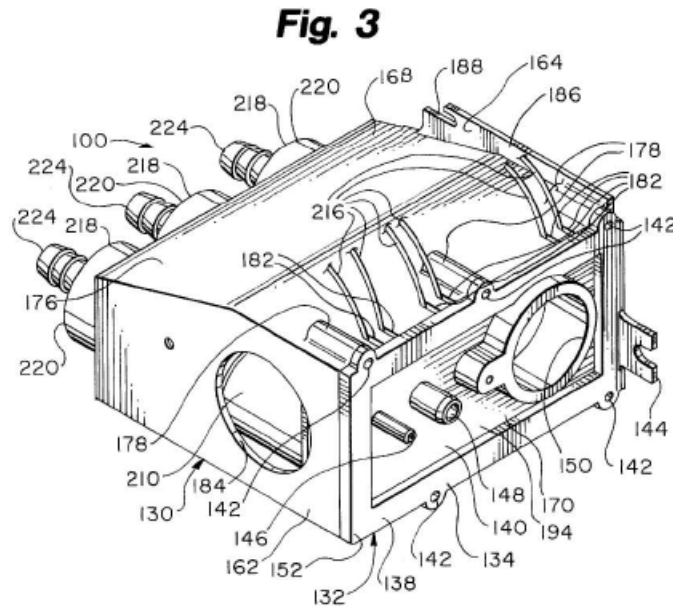


Figure 3 is a perspective view of the claimed valve assembly. Ex. 1001, 3:31–32.

Assembly 100 includes: an enclosure, at least one valve, and a pressure monitoring means. The enclosure (air chamber 133) is defined by enclosure 130 and rear cover 132. *Id.* at 4:17–20; Figs. 3, 10, 11. At least one valve (218) is disposed within assembly 100. *Id.* at 5:59–60; Figs. 3, 4. Valve member 226 of valve 218 is biased to the closed position. *Id.* at 2:37–39; 6:1–8; Fig. 7. When valve member 226 is unseated (open) air passes from the interior of valve assembly 100 through axial air passageway 222 to the respective bladder. *Id.* at 7:26–28; Fig. 7 (closed); Fig. 8 (open).

Pressure monitoring is accomplished by two different configurations. In a first embodiment, pressure monitoring port 146 is fluidly coupled to the interior of assembly 100 and includes an outwardly directed portion designed to receive a small tube for conveying pressure to a pressure sensor. *Id.* at 4:30–36; Fig. 3. In an alternative embodiment, pressure monitoring is

accomplished via a pressure monitor tab 240⁶ on valve body 220 of two of valves 218. *Id.* at 6:22–24; Fig. 9.

Of the challenged claims, claims 2, 6, 9, 12, 16, and 20 are independent. Claim 16 is illustrative and is reproduced below:

16. An improved valve enclosure assembly for use with an air inflatable mattress having at least one air bladder inflated by compressed air, a pump fluidly coupled to the at least one air bladder for providing compressed air thereto, and a processor for providing commands to the improved valve enclosure assembly during an inflate/deflate cycle, the improved valve enclosure assembly being fluidly coupled intermediate the pump and the at least one air bladder for controlling the inflation of the at least one air bladder, comprising:

an enclosure defining a substantially fluidly sealed air chamber and having at least one air inlet to the air chamber being fluidly coupled to the pump, the enclosure being formed of an enclosure portion and a rear cover portion, a flexible seal being compressively interposed between the enclosure portion and a rear cover portion to effect a substantially fluid tight seal therebetween;

at least one valve operably coupled to the enclosure being in selective fluid communication with the air chamber and being in fluid communication with the at least one air bladder for selectively fluidly coupling the air chamber to at least one air bladder; and

⁶ The '172 patent also refers to the expanded diameter portion of valve body 220 as element 240. Ex. 1001, 6:17–21, 36–37; Figs. 4, 6, 7, 9.

pressure monitor means being operably coupled to the processor and being in fluid communication with the at least one valve for monitoring the pressure in the at least one bladder.

Claims 3⁷ and 22–25 depend from independent claim 2. Claim 13 depends from independent claim 12.⁸ Claim 21 depends from independent claim 20.

II. ANALYSIS

Each ground asserted in the Petition is deficient for at least the reasons given below.

To begin, none of the four grounds of unpatentability asserted by Petitioner includes any citation to specific portions of the references themselves.⁹ Rather, the Petition cites only to the Declaration of Mr. Bernard Kuchel (Ex. 1011). *See e.g.*, Pet. 12 (citing Ex. 1001 ¶¶ 50–62,¹⁰ 64, and 71). Citation in the Declaration does not correct this deficiency because the requirement applies to the petition itself. *See* 35 U.S.C. §§ 312(a)(3), (4); 37 C.F.R. §§ 42.104(b)(4), (5); 37 C.F.R. § 42.22(a)(2) (requiring a petition to include a detailed explanation of the significance of the evidence); *see generally* *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003, slip op. at 10, 14 (P.T.A.B. Oct. 25, 2012)

⁷ *See* Ex. 1005 (correcting the '172 patent so that claim 3 depends from claim 2).

⁸ *See* Ex. 1005 (correcting the '172 patent so that claim 13 depends from claim 12).

⁹ Kery, Ex. 1006; Guthrie, Ex. 1008; and Moulton, Ex. 1007.

¹⁰ The Petition cites to sections IX(A)–(C), which corresponds to ¶¶ 50–62.

(Paper 8) (the Board “will address only the basis, rationale, and reasoning put forth by the Petitioner in the petition”).

Further, the obviousness analysis of each of the grounds of unpatentability put forth in the Petition is substantively deficient in several respects. Petitioner’s alleged ground of unpatentability asserting that claim 16 is obvious over Kery and Guthrie is illustrative. See Pet. 12–15. First, the Petition does not state explicitly the differences between Kery and the subject matter of claim 16. See Pet. 12–15; *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (citing with approval the four part obviousness test of *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966), that includes determining the differences between the claims at issue and the prior art). Second, the Petition does not explain cogently how the construed claims are unpatentable. 37 C.F.R. § 42.104(b)(4). For instance, the Petition states that the system of Kery and Guthrie would include a microprocessor without identifying which reference is relied upon as disclosing a processor as claimed. Pet. 14 (citing Ex. 1011 ¶ 69). Third, the Petition does not adequately articulate a reason for combining Kery and Guthrie. Specifically, the Petition states, without a cogent supporting explanation, that a person of ordinary skill in the art would have found it “obvious to automate Kery in view of Guthrie.” Pet. 12.

We recognize that the Kuchel Declaration (Ex. 1011) provides additional information regarding each of these shortcomings; however, this information is not discussed adequately in the Petition and may not be incorporated by reference. See 37 C.F.R. § 42.6(a)(3) (prohibiting incorporation by reference); see generally *Cisco Systems, Inc., v. C-Cation Techs., LLC*, Case IPR2014-00454, slip op. at 9–10 (PTAB Aug. 29, 2014)

(Paper 12) (expanded panel decision explaining that arguments not made in the Petition will not be considered); *Fidelity National Information Services, Inc., v. Datatransury Corp.*, Case IPR2014-00489, slip op. at 9 (PTAB Aug. 13, 2014) (Paper 9) (“Under our rules, the petition must contain a ‘full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence’ 37 C.F.R.

§ 42.22(a)(2). We, therefore, decline to consider information presented in a supporting declaration, but not discussed sufficiently in a petition”).

IV. CONCLUSION

Based on the arguments and evidence presented in the Petition, we conclude that Petitioner has not demonstrated a reasonable likelihood it will prevail in showing claims 2, 3, 6, 9, 12, 13, 16, and 20–25 of the ’172 Patent are unpatentable.

V. ORDER

Accordingly, it is

ORDERED that the petition is *denied*; and

FURTHER ORDERED that *no inter partes* review is instituted.

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