

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Casper Sleep Inc.,
Petitioner,

v.

Werner Media Partners, LLC,
Patent Owner.

U.S. Patent 10,842,301
IPR 2024-00474

**PETITIONER'S OPPOSITION TO PATENT OWNER'S SUBSTITUTED
MOTION TO EXCLUDE UNDER 37 C.F.R. § 42.64(c)**

Pursuant to the Board's Scheduling Order for this IPR, as amended (Papers 8 and 45), Petitioner respectfully files this Opposition to Patent Owner's Substituted Motion to Exclude Under 37 C.F.R. § 42.64(c) (Paper 46).

I. PATENT OWNER'S REQUEST TO EXCLUDE EXHIBIT 1031 SHOULD BE DENIED

Patent Owner's request under FRE 106 and FRE 702/703 in Section III.A to exclude Exhibit 1031 should be denied. Exhibit 1031 is U.S. Patent No. 9,538,855, which names Patent Owner's technical expert, Andrew Gross, as its first inventor.

As a named inventor, Mr. Gross has personal knowledge about Exhibit 1031. Mr. Gross also holds himself to be a person of ordinary skill in the art ("POSITA"), (Exhibit 1074, 10:12-22; 68:10-12), and allegedly analyzed U.S. Patent 10,842,301 ("the '301 Patent," Exhibit 1001) and cited prior art from a POSITA's point of view, (Exhibit 2001, ¶ 24). Mr. Gross's deposition testimony concerning Exhibit 1031 was directed to a POSITA's knowledge about improved convection in foam due to airholes, and is referenced as such in the Second Declaration of Petitioner's technical expert, David M. Brienza Ph.D. (*See* Exhibit 1075, ¶ 35).

Further, Petitioner's use of Exhibit 1031 during Mr. Gross's deposition was squarely within the scope of Mr. Gross's direct testimony. For example, Exhibit 1031 was referenced in Mr. Gross's opening declaration to support his

qualification as an expert in the field. (Exhibit 2001, ¶ 12). Moreover, Exhibit 1031 is not being introduced as an additional prior art to add any additional grounds of unpatentability but is being introduced to ascertain Mr. Gross's knowledge, which is a requirement under FRE 702(a).

Patent Owner had a full and fair opportunity to re-cross Mr. Gross concerning any portion of Exhibit 1031 at his deposition, and also had a full and fair opportunity to depose Dr. Brienza but chose not to do so.

II. PATENT OWNER'S REQUEST TO EXCLUDE EXHIBIT 1037 SHOULD BE DENIED

Patent Owner's request under FRE 106 and FRE 602 in Section III.B to exclude Exhibit 1037 should be denied. Exhibit 1037 is a hand drawing created by Mr. Gross as requested by Petitioner during Mr. Gross's deposition. (Exhibit 1074, 211:12-218:21).

Contrary to Patent Owner's allegation, Mr. Gross's direct testimony reviewed the disclosure of the '301 Patent and the resulting impact of the patented process. (*See, e.g.*, Exhibit 2001, ¶¶ 29, 37, 41, 59, 71, 79, 109, 130, 145). As such, Exhibit 1037 is not outside of Mr. Gross's direct testimony. In fact, Mr. Gross's direct testimony was submitted in response to Petitioner's expert's, Dr. Brienza's, direct testimony, which discussed the '301 Patent. (*See, e.g.*, Exhibit 1006, ¶¶ 27-40). Patent Owner had a full and fair opportunity to re-cross Mr.

Gross concerning Exhibit 1037 at his deposition and also had an opportunity to depose Dr. Brienza but chose not to do so.

Concerning Patent Owner's objection under FRE 602, the rule explicitly does not apply to expert testimony. *Id.* ("This rule does not apply to a witness's expert testimony under Rule 703.").

III. PATENT OWNER'S REQUEST TO EXCLUDE EXHIBITS 1047 AND 1050 SHOULD BE DENIED

Patent Owner's request to exclude Exhibits 1047 and 1050 in Sections III.C and III.D under FRE 106, 602, 702/703, 901, and 1002/1003 should be denied.

Exhibit 1047 is an article written by David Perry, entitled "Purchases at the Top," and appeared in *BedTimes Magazine* on July 27, 2022, disclosing that brick-and-mortar retailers accounted for a slight majority (52%) of bedding accessories purchases (which includes pillows), while online sales accounted for 46% of purchases. Exhibit 1050 is a report from *Fortune* regarding U.S. Pillow Market Size, 2023-2030, disclosing that the U.S. pillow market size in 2022 was \$3.07 billion and that the foam pillow market was 19.37% of that market, or about \$600 million. Exhibits 1047 and 1050 were presented to Patent Owner's expert Jeff Quinn to impeach his market share analysis, which omitted all brick-and-mortar sales and all online non-Amazon sales and included total annual sales of only \$3M. (Exhibit 1078, 107:20-111:4, 123:12-127:4). Petitioner's marketing expert Mr.

Shiroff also relied on Exhibits 1047 and 1050 when impeaching Mr. Quinn. (Exhibit 1076, ¶¶ 66-70).

Petitioner's objection under FRE 106 should be denied because Exhibits 1047 and 1050 are complete documents.

Petitioner's objection under FRE 602 should be denied because Exhibits 1047 and 1050 are part of an expert's testimony under FRE 703.

Petitioner's objection under FRE 702/703 should be denied. As an expert, it was reasonable for Mr. Shiroff to investigate and opine about the deficiencies in Mr. Quinn's market share analysis.

Petitioner's objection under FRE 901 should be denied. Exhibits 1047 and 1050 are what the Petitioner claims they are, viz. an article from *BedTimes Magazine* and a *Fortune* report. Evidence may be authenticated by its "appearance, contents, substance, internal patterns, or other distinctive characteristics ... taken together with all the circumstances." FRE 901(b)(4).

Petitioner's objection under FRE 1002/1003 should be denied. Exhibit 1047 is timestamped October 31, 2024, because that is the date when the July 27, 2022, article was obtained from the Internet. Exhibit 1050 is a report about pillow sales from the Internet. Both Exhibits 1047 and 1050 are duplicates admissible to the same extent as the original articles on the Internet.

IV. PATENT OWNER’S REQUEST TO EXCLUDE EXHIBITS 1057, 1058, 1059, 1083, AND 1084 SHOULD BE DENIED

Patent Owner’s request to exclude Exhibits 1057, 1058, 1059, 1083, and 1084 in Sections III.E and III.I under FRE 106, 602, 702/703, 901, and 1002/1003 should be denied. Exhibits 1057, 1058, 1059, 1083, and 1084 show sales and videos of Fohm and Brooklyn Bedding pillows occurring before sales of Patent Owner’s GhostPillow. Exhibits 1057, 1058, and 1059 were presented to Patent Owner’s expert Jeff Quinn to impeach his finding that the GhostPillow was the first foam pillow having phase change material (“PCM”) and holes ever sold. (Exhibit 1078, 260:16-278:5). Petitioner’s marketing expert Mr. Shiroff also relied on Exhibits 1057, 1058, 1059, 1083, and 1084 when impeaching Mr. Quinn. (Exhibit 1076, ¶¶ 81-89).

Petitioner’s objection under FRE 106 should be denied because Exhibits 1057, 1058, 1059, 1083, and 1084 are complete documents.

Petitioner’s objection under FRE 602 should be denied because Exhibits 1057, 1058, 1059, 1083, and 1084 are part of an expert’s testimony under FRE 703.

Petitioner’s objection under FRE 702/703 should be denied. As an expert, it was reasonable for Mr. Shiroff to investigate and opine about the failure of Mr. Quinn to consider all prior sales of foam pillows having PCM and holes before stating that the GhostPillow was the first such pillow ever to be sold.

Petitioner's objection under FRE 901 should be denied. Exhibits 1057, 1058, 1059, 1083, and 1084 are what the Petitioner claims they are, *viz.* Amazon, YouTube and Kickstarter webpages about the Fohm and Brooklyn Bedding pillows.

Petitioner's objection under FRE 1002/1003 should be denied because these duplicate documents are admissible to the same extent as the original documents.

V. PATENT OWNER'S REQUEST TO EXCLUDE ¶ 55 AND ¶¶ 103-109 OF EXHIBIT 1075 SHOULD BE DENIED

Patent Owner's request under FRE 801/802/805 and 37 C.F.R. § 42.65(a) in Section III.F to exclude ¶ 55 and ¶¶ 103-109 of Exhibit 1075 should be denied. Exhibit 1075 is the Second Declaration of David M. Brienza, Ph.D. Paragraph 55 discusses ER-20 foam by INOAC Corporation, which is disclosed in Ohta (Exhibit 1009), one of the prior art references cited in the Petition. Paragraphs 103-109 show various combinations of Crawford (Exhibit 1011) in view of Lievestro (Exhibit 1013), two other references cited in the Petition.

First, Patent Owner's request to exclude should be rejected at least because it is not based on the originally asserted objection and because the asserted objection did not identify the grounds with specific particularity to allow for proper correction. Specifically, the originally asserted objection involving FRE 801/802/805 and 37 CFR §42.65(a) was stated as "FRE 106; FRE 602; FRE 702/703; FRE 801/802/805; FRE 901; 37 C.F.R. § 42.65(a) (lack of foundation of

Dr. Brienza’s review of the Element testing results).” (Paper 29, at 5). Thus, Patent Owner’s compound objection not only failed to identify the specific paragraphs of Dr. Brienza’s second declaration (Exhibit 1075) but was directed at a completely different part of Dr. Brienza’s testimony. Thus, Patent Owner request should be rejected for the lack of an effective objection. *See* 37 C.F.R. § 42.64(c).

Patent Owner’s request to exclude ¶ 55 of Exhibit 1075 under FRE 801/802/805 should also be rejected on the merits. Paragraph 55 details Dr. Brienza’s investigation into the ER-20 product described in Ohta and his opinions drawn therefrom. Neither Dr. Brienza’s recitation of his investigation nor his opinion are hearsay.

Patent Owner’s request to exclude ¶¶ 103-109 of Exhibit 1075 under 37 C.F.R. § 42.65(a) should also be rejected on the merits. These paragraphs include Dr. Brienza’s factually supported, well-reasoned opinions as to why a POSITA would modify Crawford’s system to add Lievestro’s hole-cutting/cracking process either before or after PCM application, or by modifying one of Crawford’s compression rollers to use Lievestro’s die-roll body. For example, Dr. Brienza explains that making “the holes [as taught by Lievestro] would enhance [Crawford’s] temperature regulation, yielding predictable result of having a bedding product that absorbs heat and provides and enhanced cooling effect to the user.” (Exhibit 1006, ¶ 94). Patent Owner’s expert, Mr. Gross, admitted that the

three embodiments were disclosed in Dr. Brienza's first declaration. (Exhibit 2001, ¶¶ 134-135; Exhibit 1074, 87:16-88:15). Dr. Brienza's opinions are further supported by his detailed factual analysis of the Lievestro and Crawford references. (Exhibit 1075, ¶¶ 30-47, 62-69, 101-102). Moreover, Dr. Brienza's opinions are in direct response to Mr. Gross's speculative testimony concerning hypothetical issues with PCM due to Lievestro's pressure gradient, possible heating, and airhole clogging (*see*, Exhibit 2001, ¶¶ 43, 44, 135) and, as such, are within the scope of a proper reply.

Finally, policy considerations for excluding expert testimony are less compelling in bench proceedings such as *inter partes* reviews than in jury trials. *See, e.g., B/E Aerospace Inc. v. MAG Aerospace Industries, LLC*, IPR2014-01513, Paper 104, 9 (PTAB March 18, 2016).

VI. PATENT OWNER'S REQUEST TO EXCLUDE EXHIBIT 1076 SHOULD BE DENIED

Patent Owner's request to exclude Exhibit 1076 in Section III.G under FRE 602, 702/703, 801/802/805, 37 C.F.R. § 42.65(a) should be denied. Exhibit 1076 is the Declaration of David Shiroff, Petitioner's marketing expert.

Patent Owner's objection under FRE 602 should be denied because Exhibit 1076 is an expert's testimony under FRE 703. FRE 602 explicitly does not apply to such situations.

Patent Owner's objection under FRE 702/703 should be denied. Mr. Shiroff has over 25 years of experience in high level positions within the bedding industry, including 18 years as President and CEO of Metro Mattress. At Metro Mattress, he designed private label sleep related products such as mattresses and pillows. He worked with dozens of foam suppliers, mattress and pillow manufacturers and other raw material suppliers over nearly two decades to create highly innovative and marketable products under Metro Mattress's house brands. In the process of designing, sourcing and selling hundreds of thousands of these products—most of which were made of foam and other cushioning materials and many of which contained temperature regulating properties—he became expert in the design of highly innovative and marketable sleep products. (Exhibit 1076, ¶¶ 13-22).

Mr. Shiroff's well-reasoned opinion detailed significant flaws in Mr. Quinn's declaration concerning secondary considerations, including improper market share and survey analysis, lack of nexus between the Patent Owner's product and the merits of the challenged claims, and improper interpretation of testing results. Given Mr. Shiroff's vast experience and detailed, well-reasoned critique of Mr. Quinn's opinions, Patent Owner pointing to a few items that Mr. Shiroff never personally witnessed (such as holes being punched in foam and the like) does not negate his status as an expert witness for this IPR.

Patent Owner's objection under 37 C.F.R. § 42.65(b) should be denied. This regulation requires experts who rely on test data to submit, *inter alia*, all data related to such tests. But as a rebuttal expert to Patent Owner's expert, Mr. Shiroff did not need to conduct or oversee any tests himself. Mr. Shiroff instead impeached Mr. Quinn's conclusions about the tests Mr. Quinn oversaw. Thus, this regulation does not apply to Mr. Shiroff.

Patent Owner's objection under FRE 801/802/806 should be denied. Mr. Shiroff adopted Dr. Brienza's findings but those very findings were submitted to Patent Owner along with Mr. Shiroff's findings when Petitioner filed its Reply to Patent Owner's Response. (Exhibit 1075). Dr. Brienza's findings were not hearsay. Further, Patent Owner had a full and fair opportunity to depose Dr. Brienza concerning his discussions with Mr. Shiroff but chose not to do so.

VII. PATENT OWNER'S REQUEST TO EXCLUDE EXHIBITS 1079, 1080, AND 1081 SHOULD BE DENIED

Patent Owner's request to exclude Exhibits 1079, 1080, and 1081 in Section III.H under FRE 106, 602, 702/703, 901, and 1002/1003 should be denied.

Exhibits 1079, 1080, and 1081 are videos and pictures of a Boers Technik drilling machine for pillows. Petitioner's marketing expert Mr. Shiroff relied on Exhibits 1079, 1080, and 1081 when impeaching Mr. Quinn's testimony that the GhostPillow could not have been created using a drilling machine. (Exhibit 1076, ¶¶ 48-50).

Petitioner's objection under FRE 106 should be denied because Exhibits 1079, 1080, and 1081 are complete documents.

Petitioner's objection under FRE 602 should be denied because Exhibits 1057, 1058, and 1059 are part of an expert's testimony under FRE 703.

Petitioner's objection under FRE 702/703 should be denied. As an expert, it was reasonable for Mr. Shiroff to investigate and opine about the failure of Mr. Quinn to consider machines that are capable of drilling holes into foam pillows.

Petitioner's objection under FRE 901 should be denied. Exhibits 1079, 1080, and 1081 are what the Petitioner claims they are, *viz.* videos and pictures of a Boers Technik drilling machine for pillows.

Petitioner's objection under FRE 1002/1003 should be denied because these duplicate documents are admissible to the same extent as the original documents.

VIII. PATENT OWNER'S REQUEST TO EXCLUDE EXHIBIT 1086 SHOULD BE DENIED

Patent Owner's request to exclude Exhibit 1086 in Section III.J under FRE 106, 602, 702/703, 801, and 901 should be denied. Exhibit 1086 is Dr. Brienza's email exchange discussing the properties of ER-20 foam, which is cited in Ohta. Exhibit 1086 constitutes Dr. Brienza's first-hand investigation into this subject matter and was provided to address Mr. Gross's statements regarding Ohta. Patent Owner had a full and fair opportunity to depose Dr. Brienza concerning Exhibit 1086 but chose not to do so.

Petitioner's objection under FRE 106 should be denied because Exhibit 1086 is a complete document.

Petitioner's objection under FRE 602 should be denied because Exhibit 1086 is part of an expert's testimony under FRE 703.

Petitioner's objection under FRE 702/703 should be denied. As an expert, it was reasonable for Dr. Brienza to investigate and opine about the properties of ER-20 foam, which is cited in Ohta. Patent Owner had a full and fair opportunity to depose Dr. Brienza but chose not to do so.

Petitioner's objection under 801 should be denied. Exhibit 1086 constitutes Dr. Brienza's investigation into the properties of ER-20 foam, which is cited in Ohta. Even if Exhibit 1086 were hearsay (which it is not), Dr. Brienza's testimony about this exhibit would still be admissible under FRE 703.

Petitioner's objection under FRE 901 should be denied. Exhibit 1086 is what the Petitioner claims it is, *viz.* an email string concerning Dr. Brienza's investigation into the ER-20 cited in Ohta.

IX. PATENT OWNER'S REQUEST TO EXCLUDE PORTIONS OF MR. GROSS'S DEPOSITION TESTIMONY (EXHIBIT 1074) SHOULD BE DENIED

As set forth in detail below, Patent Owner's objections under FRE 611 in Section III.K to certain portions of Mr. Gross' deposition testimony, (Exhibit

1074), should be denied because the cross-examination was within the scope of Mr. Gross's direct testimony as set forth in his first declaration, (Exhibit 2001).

Item	Page:Lines	Petitioner's Response
1	26:2-7	Mr. Gross opined concerning the scope of claims 1 and 2 of the '301 patent. (<i>See, e.g.</i> , Exhibit 2001, ¶¶ 15, 36, 41, 159).
2	31:3-9	Mr. Gross testified that he reviewed Exhibit 1005 ('251 Reexam). (Exhibit 2001, ¶ 25). USPTO confirmed that the file history indicates why the claims were allowed. (Exhibit 1005, pp. 133-134).
3	32:22-33:2	Mr. Gross testified that reviewed the '251 Reexam (Exhibit 1005), which explained the merit of claim 1. <i>See</i> Item 2.
4	33:4-28:19	<i>See</i> Item 2.
5	41:16-42:13, 43:7-11	Mr. Gross testified, when preparing his [first] declaration, he reviewed the claim constructions section of the Board's Order Granting Institution of this IPR. (Exhibit 1074, 40:10-17).
6	47:20-48:1	<i>See</i> Item 5.

7	50:7-13, 50:24-51:23	Mr. Gross opined that foam in the '301 Patent had to be non-reticulated. (Exhibit 2001, ¶ 68).
8	77:24-78:15	<i>See</i> Section II regarding Exhibit 1037.
9	101:9- 102:13	Mr. Gross opined that Lievestro's system "may" produce high operating temperatures. (Exhibit 2001, ¶¶ 44, 124-125, 141-142). As admitted, that opinion was a mere hypothesis, i.e., speculation, (Exhibit 1074, 98:10-19). Because Mr. Gross opened the door to issues about the operation and resulting temperatures of Lievestro's system, Petitioner was entitled to question him about Lievestro's system-cooling options. (<i>See. e.g., id.</i> , 102:14-103:10)
10	195:1- 196:15	Mr. Gross testified that Patent Owner's GhostPillow is manufactured using the process claimed in the '301 Patent. (Exhibit 2001, ¶ 15). Petitioner was entitled to question him about the GhostPillow manufacturing process.
11	198:6-13	Item 11 explores Mr. Gross's own statement in paragraph 44 of his declaration. (<i>See</i> Exhibit 1075, 97:23-98:6).
12	210:9- 218:21	Mr. Gross testified that he reviewed the '301 Patent. (Exhibit 2001, ¶ 25). Item 12 includes testimony about the process and product disclosed in the '301 Patent.

X. CONCLUSION

For the reasons set forth above, the Board should deny Patent Owner's Motion to Exclude in all respects.

Respectfully submitted,

Dated: January 13, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e), service was made on Patent Owner as detailed below.

Date of Service January 13, 2025

Manner of Service Email to patent@assoulineberlowe.com,
contact@pearsonip.com, wais@cotmanlaw.com,
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Document Served - This Opposition to the Patent Owner's Substituted Motion to Exclude Under 37 C.F.R. § 42.64(c)

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