

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

REPLY TO OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE

Pursuant to 37 C.F.R. § 42.64(c) and the Board’s Scheduling Order for this IPR (Paper 8), Casper Sleep Inc. (“Petitioner”) respectfully files this Reply to the Opposition (Paper 50) of Werner Media Partners, LLC (“Patent Owner”) to Petitioner’s Motion to Exclude Exhibits 2013, 2015, 2016, and 2017 (collectively, the “Challenged Exhibits”) under FRE 702.¹

I. AS THE BOARD RECOGNIZED, PETITIONER PROPERLY BRIEFED ITS SECONDARY CONSIDERATION ARGUMENTS

As the Board recognized in its Strike Order (Strike Order, at 4), Patent Owner’s argument that Petitioner’s secondary consideration arguments in this IPR were procedurally improper, (Paper 50, at 7), is without merit. Petitioner stated in its Petition that “Petitioner is aware of no evidence supporting a claim for secondary considerations.” (Paper 2, at 76). In its Response, Patent Owner countered with six alleged categories of secondary consideration categories.

¹ Petitioner’s opening brief also requested the Board to exclude Exhibits 2033, 2041, 2043, 2044, and 2045 under FRE 702. On January 13, 2025, the Board granted Petitioner’s Motion to Strike in part and expunged Exhibits 2030–2045 from the record. (“Strike Order,” Paper 48). As a result, Petitioner hereby withdraws as moot its Motion to Exclude with respect to Exhibits 2033, 2041, 2043, 2044, and 2045.

(Paper 12, at 45–59). In its Reply, Petitioner demonstrated that: (1) there was no nexus between the six secondary consideration categories and the merit of the claimed process; and (2) each of the six secondary consideration categories was fatally flawed. (Paper 24, at 19–32). Finally, Patent Owner’s Sur-Reply (Paper 31) responded by citing to the cross-examination of Petitioner’s expert Mr. Shiroff (which was procedurally proper) and to 16 new Exhibits 2030–2045 (which, as the Board found in its Strike Order, was not).

Except for the now-stricken Exhibits 2030–2045 in Patent Owner’s Sur-Reply, the secondary considerations briefing by both parties in this IPR was well within the Board’s rules. Nonetheless, Patent Owner argues that “Petitioner summarily dismissed the topic of secondary considerations in the Petition. After reviewing Patent Owner’s numerous grounds of secondary consideration in the Response, Petitioner desperately attacks Patent Owner’s expert witness Mr. Quinn as well as the Element test results.” (Paper 50, at 7).

In its Strike Order, the Board directly addressed and rejected this argument:

Regarding these arguments, although Petitioner has the ultimate burden of proof in this proceeding, the (initial) burden of asserting and producing evidence of objective indicia of non-obviousness falls on Patent Owner, not Petitioner, thus, it was not Petitioner’s responsibility to guess Patent Owner’s future arguments and preemptively address such matters in the Petition.

(Strike Order, at 4). This finding by the Board that Petitioner acted properly when briefing secondary considerations likewise applies to refute Patent Owner's argument in its opposition to Petitioner's Motion to Exclude that Petitioner somehow acted improperly.

II. ALL CHALLENGED EXHIBITS ARE INADMISSIBLE UNDER FRE 702

A. Mr. Quinn's Lack of a Bachelor-of-Science Degree Renders All of His Testimony Inadmissible

The Board accepted and used Petitioner's proposed definition of a POSITA when instituting this IPR, which required "at least a bachelor's degree in engineering ..., or an equivalent level of education...." (Paper 7, at 9-10). Based on Dr. Brienza's findings, Petitioner argued in its Reply that a bachelor-of-science degree is the minimum required level of education for such a POSITA. (Paper 24, at 2-3). As the holder of a bachelor-of-arts degree, Mr. Quinn simply does not meet this threshold and does not qualify as a POSITA.

Patent Owner emphasizes in its opposition the alleged benefits of Mr. Quinn's market share and market survey analyses that Mr. Quinn himself designed and implemented. Patent Owner misses the point. Given the scientific concepts involved in this case, such as properties of foam and phase change materials, heat transfer, and air flow characteristics, a bachelor-of-science degree is a necessary requirement for a POSITA. But since Mr. Quinn lacks this educational threshold,

he is not qualified as a POSITA and any results and conclusions based on the design and implementation of his analyses are inadmissible

B. Mr. Quinn Improperly Applied the Results of the Element Tests

In its opposition, Patent Owner argues that Mr. Quinn’s analysis of the Element Tests would have been made by anyone who has sufficient knowledge and experience in the bedding industry. Patent Owner misses the point. Petitioner does not question that Element performed the six tests properly and reported out correct data from those tests. Petitioner instead challenges Mr. Quinn’s application of the Element tests to the issue of this case. Specifically, *none* of the Element Tests involved Patent Owner’s GhostPillow product at all—either as a finished product or before application of the phase change material and holes.

Patent Owner ignores that each Element Tests states: “[t]est results contained in this report pertain only to the samples submitted for testing and not necessarily to all similar products.” (Exhibit 2017, at 4, 9, 15, 20, 22, 24). Notwithstanding these explicit warnings, Mr. Quinn improperly applied the Element Test results to establish an alleged nexus between Patent Owner’s GhostPillow product and the ’301 Patent. But since Element never tested Patent Owner’s GhostPillow product, Mr. Quinn’s reliance on the Element Tests results is—by the terms of those very tests—scientifically improper. The results of the Element Tests are therefore inadmissible.

C. Mr. Quinn’s Self-Defined “Market” is Improper

Patent Owner’s defense of Mr. Quinn’s use of his self-created “Molded Gel Memory Foam PCM pillow with punched holes” market in his secondary consideration analysis fails. First, Patent Owner never explains why this so-called “market” produced one set of competitors for a market share analysis and (except for Casper) an entirely different set of competitors for the market survey analysis. Second, Patent Owner does not address Mr. Quinn’s admission that he had never seen such a “market” before creating it for this litigation. (Exhibit 1078, 105:23-107:2). These failures render Mr. Quinn’s so-called “market” a nullity. All conclusions based on that “market” are inadmissible.

III. CONCLUSION

For the reasons stated above and in Petitioner’s opening brief, the Board should exclude all of the Challenged Exhibits under FRE 702.

Respectfully submitted,

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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 17, 2025

Manner of Service Email to patent@assoulineberlowe.com,
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Document Served - This Reply to Opposition to Petitioner's Motion to Exclude

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