

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBAL SHADE CORPORATION
Petitioner,

v.

WITH-U E-COMMERCE (SHANGHAI) CO., LTD.
Patent Owner.

IPR2023-00580
Patent 10,669,738 B2

Before PATRICK R. SCANLON, BARRY L. GROSSMAN, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On August 11, 2023, we instituted trial as to claims 1, 2, 4, 13, and 14 of U.S. Patent No. 10,669,738 B2. Paper 9. After institution, Patent Owner filed a Contingent Motion to Amend. Paper 16 (“Motion” or “Mot.”). Should we find in a final written decision that the challenged claims are unpatentable, Patent Owner proposes substitute claims 15–19, each of which corresponds to a respective one of challenged claims 1, 2, 4, 13, and 14. Mot. 1. Petitioner filed its Opposition to the Motion. Paper 19 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend]”); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements

and burdens for a motion to amend); *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
Yes, Patent Owner proposes no more than 1 substitute claim for each challenged claim.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes. Patent Owner responds to the grounds of unpatentability. Mot. 13–25. Petitioner does not argue otherwise.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No. Petitioner does not argue otherwise. Each of the proposed substitute claims include narrowing limitations.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No as to claims 15 and 17–19.

On this record, we find Patent Owner has set forth written description support for the proposed substitute claim 15 at pages 3–8 of the Motion. Proposed substitute claims 17–19 are amended only to change their dependency. Petitioner does not identify any particular limitations of substitute claims 15 and 17–19 for which support is lacking.

Yes as to claim 16.

Proposed substitute claim 16 depends from proposed substitute claim 15 and is amended to recite, *inter alia*, “in said unfolded state, said first connecting rod extends upward from said center bottom cap to said first oblique top pipe to form a Y-shaped member.” Mot. 28.

Patent Owner identifies support for proposed substitute claim 16 in a chart provided on pages 9–11 of the Motion. In the chart, Patent Owner identifies written description support for the above limitation from “the Originally Filed Specification (Ex. 2013)” in the second column of the chart (which also cites original Figures provided by Patent Owner as Ex. 2014) as well as from “the Priority Documents (Parent, PCT

Translation, JP Translation)” in the third column. Mot. 9, 11. In particular, Patent Owner identifies pages 7–8, paragraph 2, and Figures 16–19, and 21 of the originally filed specification as support for the above limitation. *Id.* at 11.

Petitioner disputes whether the above limitation has written description support in the originally filed specification. *See* Opp. 1–5. Petitioner does not appear to dispute that the originally filed specification provides support for the limitation that “said first connecting rod” and “said first oblique top pipe” “form a Y-shaped member.” *Id.* at 2. However, Petitioner argues that the newly-added limitation of “said first connecting rod ***extends upward*** from said center bottom cap” lacks written description support in the originally filed specification. *Id.* First, Petitioner points out that paragraph 2 on page 7 of the original specification does not mention that the connecting rod 83 “extends upward.” *Id.* Next, Petitioner reproduces originally filed Figures 16 and 17 (Ex. 2014) and argues that “neither Figure clearly shows the relevant connecting rod ***extending upwards.***” *Id.* at 3. Petitioner also addresses Figures 18, 19, and 21. According to Petitioner, Figure 18 “does not depict the first connecting rod or the center bottom cap at all,” “Figure 19 depicts the canopy in a partially folded state, which provides no information about the unfolded state recited in the claim,” and “Figure 21 depicts an entirely different embodiment that does not include structures that form a Y-shaped member, making it irrelevant.” *Id.* at 4.

At this preliminary stage, we are inclined to agree with Petitioner that the portions of the originally filed Specification and Figures relied on by Patent Owner do not support the claimed limitation of “said first connecting rod extends upward from said center bottom cap.” Page 7, paragraph 2 of the originally filed Specification (which carries over to page 8), on which Patent Owner relies, pertinently describes that “the first oblique top pipe 81 and the first connecting rod 83, as well as the second oblique top pipe 82 and the second connecting pipe 84, forms a Y-shaped member, i.e., the inner retractable unit 8 consists of a plurality of Y-shaped members.” There is no mention in paragraph 2 of the first connecting rod extending in any particular direction. As for Figures 16 and 17, these are isometric drawings, and, as Petitioner points out, both are drawn “from an indeterminate perspective angle” (Opp. 3), making it difficult to discern whether first connecting rods 83 “extend slightly upward, horizontally, or slightly downward” (*id.*). We also agree with Petitioner that Figures 18,

19, and 21 do not provide support for the argued limitation for substantially the reasons provided by Petitioner.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record,¹ it appears that Petitioner (or the record) has shown a reasonable likelihood that proposed substitute claims 15–19 are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

Yes as to claims 15 and 17–19.

On this record, it appears that Petitioner has shown a reasonable likelihood that the combination of Rousselle (Ex. 1003), Tsai (Ex. 1005), Ohnishi (Ex. 1006), and Khatchadourian (Ex. 1103) teaches or suggests the added limitations of claim 15. Claims 17–19 were amended only to change their dependency.

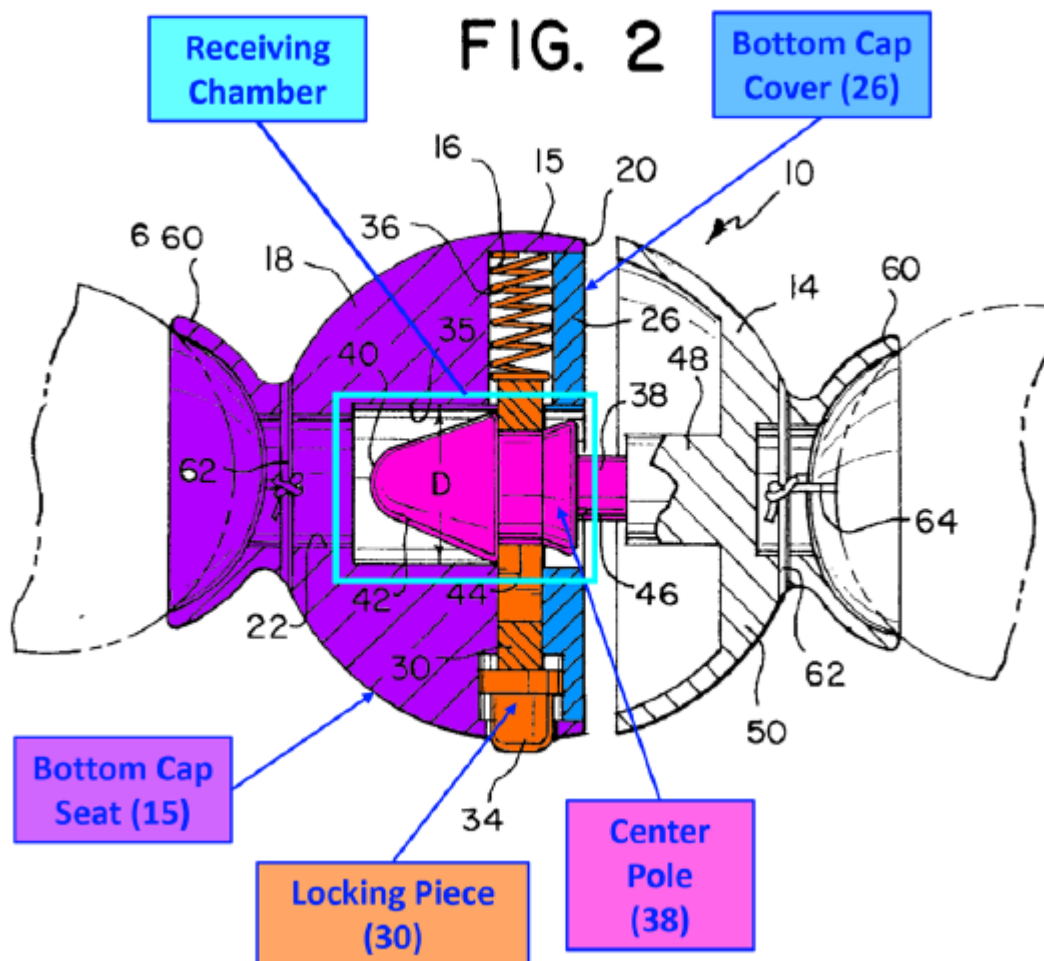
On pages 6–7 of the Opposition, Petitioner explains how Rousselle and Ohnishi disclose “a locking piece received in said center bottom cap.”

On pages 7–9 of the Opposition, Petitioner argues that the combination of Rousselle and Ohnishi teaches the claim 15 limitations of “center bottom cap comprises a bottom cap seat and a bottom cap cover that are connected to one another,” “a receiving chamber is provided in said center bottom cap at a junction between said bottom cap seat and said bottom cap cover,” and the “locking piece is located within said receiving chamber and between said bottom cap cover and said bottom cap seat.” According to Petitioner, “[i]t would have been a trivial design change for a POSITA to simply move the boundary between the two pieces such that they meet at the locking piece, forming a bottom cap seat and bottom cap cover.” Opp. 8. At this stage, we

¹ We express no view on the patentability of original claims 1, 2, 4, 13, and 14 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in the Patent Owner’s Motion to Amend.

are not convinced that it would have been “a trivial design change” to move the boundary of the two pieces of the Rousselle/Ohnishi device in the manner proposed.

However, Petitioner also provides a new reference, Khatchadourian, and argues that “Rousselle and Ohnishi, in view of Khatchadourian, disclose, or at least suggest,” these limitations. Opp. 13. On pages 9–13, Petitioner explains in detail how Khatchadourian discloses a locking piece disposed in a receiving chamber provided in a center bottom cap at a junction between a bottom cap seat and a bottom cap cover. On page 11, Petitioner provides an annotated version of Figure 2 of Khatchadourian, which is reproduced below, showing how Khatchadourian purportedly discloses the claimed arrangement of the locking piece, receiving chamber, bottom cap seat, and bottom cap cover.



Petitioner contends that “[b]ased on Khatchadourian’s disclosure and the benefits a POSITA would have understood from such an arrangement, a POSITA would have been motivated to include a bottom cap seat and bottom cap cover in Rousselle’s center bottom cap when modifying it to include Ohnishi’s locking piece.” Opp. 11–12. And, according to Petitioner, “[f]or ease of manufacturing and maintenance, a POSITA would have recognized that it would be advantageous to have easy access to insert and remove the locking piece from the lock” and “[t]he arrangement shown in Khatchadourian, where the locking piece sits in a bottom cap seat and is covered by a removable bottom cap cover, provides such easy access to the locking piece.” *Id.* at 12 (quoting Ex. 1102, ¶ 52 (Second Declaration of Jeffrey Stein Ph.D.)).

On pages 13–16 of the Opposition, Petitioner explains how Rousselle discloses the claim 15 limitation of “said collapsible canopy frame is moved to said unfolded state by pushing said center bottom cap upwards to drive said plurality of inner retractable units outwardly, which causes said plurality of outer retractable units and said at least three supporting legs to extend outwards, until said center bottom cap is connected with said center top cap.” As Petitioner points out (Opp. 14), Patent Owner does not dispute that Rousselle discloses this limitation. Instead, Patent Owner contends that Petitioner’s two proposed modifications of Rousselle in view of Tsai are inoperative. Mot. 17–19. In our Institution Decision, we found that the Petition presents a reasonable likelihood of prevailing on Petitioner’s proposed alternative modification, whereby “one of ordinary skill in the art would have modified Tsai’s canopy by including Rousselle’s hinges 450 and center tubes 500 to connect Tsai’s inner retractable units with the top and bottom of Rousselle’s central lock.” Paper 9, 32–33. Accordingly, we focus on Petitioner’s alternative modification in this Preliminary Guidance.

According to Patent Owner, “Tsai teaches against any center activation like that of the proposed claim. Tsai disparages center activation because it requires another user in the center of the tent to push the central components up.” Mot. 18 (citing Ex. 1005, 2:19–22). The cited portion of Tsai involves a discussion of a prior art shelter frame shown in Figures 16 and 17 of Tsai, and discloses that “[t]his frame is also somewhat difficult to unfold in that an extra person is sometimes needed to push the center strut upwardly to its completely extended position.” Ex. 1005, 2:19–22. At this preliminary stage, we are not persuaded that the disclosure in Tsai relating to a different shelter disparages the proposed combination with Rousselle. First, the prior

art shelter frame shown in Figures 16 and 17 of Tsai is significantly different from that of Rousselle, and from Tsai's inventive frame as shown in its Figures 1, 10, 20, and 21. Furthermore, Rousselle discloses an erection device that facilitates assembly of shelters/tents and "can enable a single individual, even a small individual, to easily assemble a relatively large structure." Ex. 1003, 59–62. Based on this disclosure in Rousselle that a single individual can assemble the structure alone, we are not persuaded that the proposed modification would require an "extra person" as described in Tsai's discussion of the unrelated prior art. In particular, Patent Owner does not explain why using Rousselle's central lock in connection with Tsai's inventive frame as shown in its Figures 1, 10, 20, and 21 would suffer from the same difficulties identified by Tsai in connection with the prior art shelter frame shown in its Figures 16 and 17.

No as to claim 16.

On pages 17–22 of the Opposition, Petitioner explains how the prior art of record, including Tsai, Choi (Ex. 1104), and Lin (Ex. 1105), disclose collapsible canopy frames having "outer retractable units comprising three hinged X-shaped rod members." At this preliminary stage, we tend to agree with Petitioner that this limitation is disclosed in at least one of the cited references, and that it would have been obvious to modify the two-X-shaped embodiment of Tsai to include three X-shaped members.

On pages 22–23 of the Opposition, Petitioner addresses the "sliding sleeve" limitation of claim 16, and argues that "when Rousselle is combined with Tsai (for example, by combining Rousselle's center lock with Tsai's canopy), the resulting combination includes a sliding sleeve on each leg that is moved along the length direction of the leg when the center bottom cap is pushed upward to unfold the canopy." Opp. 22 (citing Ex. 1102 ¶ 77). At this preliminary stage, we tend to agree with Petitioner's position regarding this limitation.

On pages 23–25 of the Opposition, Petitioner addresses the claim 16 limitation of "in said unfolded state, said first connecting rod extends upward from said center bottom cap to said first oblique top pipe to form a Y-shaped member." According to Petitioner, "[t]o the extent the '738 patent provides written description support for this limitation, Rousselle provides the same level of disclosure and thus discloses this limitation." Opp. 23. In support, Petitioner reproduces Figure 1(A) of Rousselle. *Id.* We are not

persuaded that Figure 1(A) of Rousselle discloses the connecting rods 500 “extending upwardly” as recited in claim 16.

Petitioner further contends that “to the extent Rousselle does not explicitly disclose the limitation, it suggests it.” Opp. 24. According to Petitioner, “[a] POSITA would have understood that simply by varying the length of Rousselle’s center pole (*see* Pet., §V.A.3.g), the distance between Rousselle’s upper and lower clevises (e.g., center top and bottom caps) when locked could likewise be varied” (Opp. 25 (citing Ex. 1102 ¶ 81), and “[t]his would allow for different angles, including upwardly extending angles, of the connecting rods in the locked and unfolded position” (*id.*). At this preliminary stage, we are not persuaded that Rousselle suggests the claimed arrangement. Petitioner’s argument that different angles for connecting rods 500 could be achieved, including upwardly extending angles, “simply by varying the length of Rousselle’s center pole” does not explain why, in the absence of hindsight, a person of ordinary skill in the art would have been motivated to vary the length of Rousselle’s center pole to achieve different angles.

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