

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Hangzhou Taihe Trading Co., Ltd. & Ningbo Likeju Trading Co., Ltd.
Petitioner

v.

EP Family Corp.
Patent Owner

Design Patent No. D934,012
Case No. 2023-0658

PETITION FOR *INTER PARTES* REVIEW

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LIST OF EXHIBITS

<u>Exhibit</u>	<u>Description</u>
Ex. 1001	U.S. Design Patent No. D934,012 to Chang (“the ’012 patent”)
Ex. 1002	Declaration of Expert Witness Paul Hatch (“Hatch”)
Ex. 1003	Resume and Prior Testimony of Paul Hatch
Ex. 1004	U.S Patent No. 476,400 to Morgan et al. (“ <i>Morgan</i> ”)
Ex. 1005	Spanish Industrial Design No. I146513 to Muebles Bordonabe, S.A. (“ <i>Bordonabe Furniture</i> ”)
Ex. 1006	U.S. Design Patent No. D424,325 to Iannacone (“ <i>Iannaccone</i> ”)
Ex. 1007	Ikea, <i>Table Galant</i> - \$149.00 / pieces (“ <i>Galant</i> ”)
Ex. 1008	Affidavit of Nathaniel E. Frank-White
Ex. 1009	Complaint, Dkt. 1 in <i>EP Family Corp. v. Changzhou Win Up Time Tech. Co</i> , Case No. 2:22-cv-08192 (C.D. Cal.)
Ex. 1010	Amazon product page for accused product, ASIN# B09JSBL7LH

Hangzhou Taihe Trading Co., Ltd. & Ningbo Likeju Trading Co., Ltd.

request IPR and cancellation of the design claimed in the '012 patent (Ex. 1001).

I. PRELIMINARY STATEMENT

The challenged design purports to claim an ornamental design for a tabletop that consists of nothing more than two planks abutted against each other. No lines, structures, or other features on the surface, sides, or interior of the tabletop are claimed. Even the ends of the tabletop are specifically disclaimed. What remains is a design patent that broadly lays claim to nothing more than two boards or planks (i.e., two rectangular prisms).

Forming a tabletop out of two side-by-side planks was not new at the time of the '012 patent. Indeed, tabletops made from two planks have been used for 100s, if not thousands of years. Folding tables, like *Morgan*, have used two foldable planks to form a tabletop for at least 130 years. And drop-leaf tables like *Iannaccone* have also used two planks to form a tabletop, with one of the planks able to fold or drop down. Moreover, as demonstrated by *Bordonabe Furniture*, dividing a table into two planks was obvious and used in other table designs that are decades old. Finally, although the overall size of a tabletop is a purely functional consideration that is not patentable, even if that were not the case, the overall tabletop proportions claimed by the '012 patent were disclosed and used by *Galant* decades earlier.

This petition presents two alternative constructions for the relative widths of the tabletop planks. Because Patent Owner has asserted the '012 patent against tabletops with equal-width planks, Petitioner anticipates Patent Owner will maintain a consistent construction in this proceeding. Alternatively, Petitioner proposes a construction that requires unequal-width planks, as is depicted in the '012 patent drawings. Regardless of the construction, however, the purported “design” is obvious over the prior art, which long utilized both equal and unequal-width planks to form tabletops.

Properly viewed in the context of the prior art, the '012 patent is nothing more than a broad confiscation of the rights to a two-plank tabletop. Patent owner cannot simply take a rectangular tabletop—like the *Galant* tabletop which, aside from being one piece, is *literally* identical to the claimed tabletop—divide it into two pieces and lay claim to the resulting “design.”

II. THE '012 PATENT

The '012 patent claims the “ornamental design for a tabletop, as shown and described.” The tabletop includes a “top portion,” shown in Figs 1-7 and a “bottom portion,” shown in Figs. 8-15. The combined “table top,” including both the top and bottom portions, is shown in Figs. 15-23. Fig. 23 of the '012 patent shows the entire tabletop:

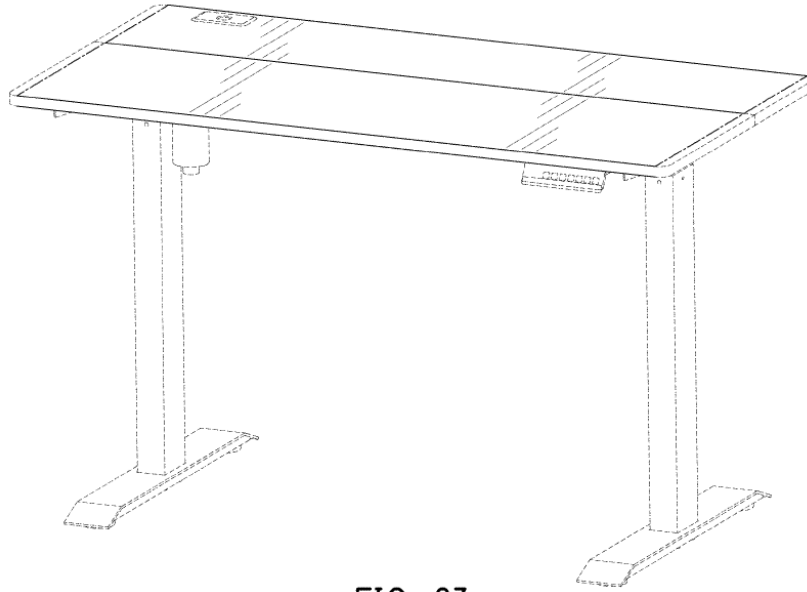


FIG. 23

The '012 patent states that the “broken line portions of the table top in Figs. 1-23 represent portions of the article that form no part of the claim.” As shown in Figs. 1 (bottom portion) and 9 (top portion), the ends of the tabletop pieces and features on the surface, interior, and sides of the tabletop are shown in broken lines:

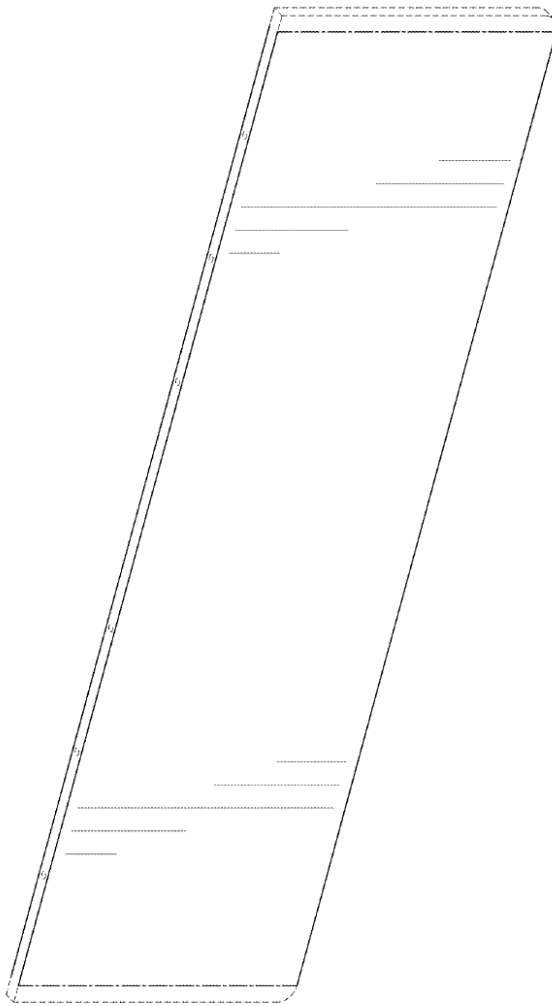


FIG. 1

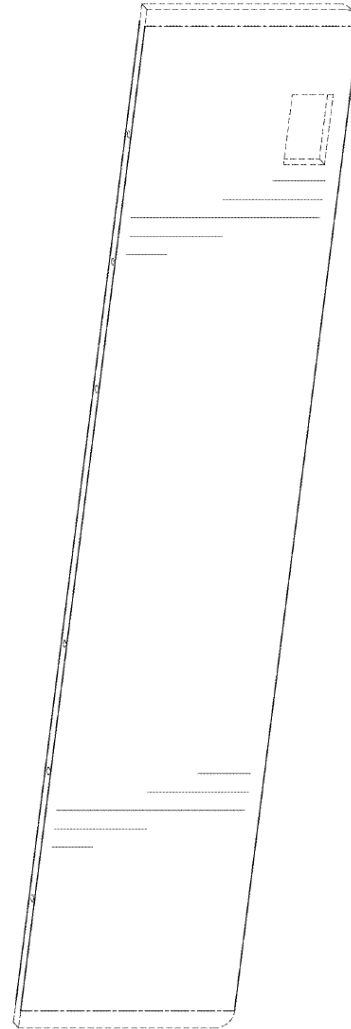


FIG. 9

III. STATEMENT OF RELIEF REQUESTED

Claim 1 of the '012 patent is unpatentable and should be cancelled in view of the following prior art and grounds.

Prior Art References	
Ref. 1:	<i>Morgan</i> , U.S. Design No. D476,400 (Ex. 1004); issued June 7, 1892, is prior art under 35 U.S.C. § 102(a)(1).

Ref. 2	<i>Bordonabe Furniture</i> , Spanish Industrial Design No. I146513 (Ex. 1005 at 20-21 (16 FEBERO 2000, BOLETIN OFICIAL DE LA PROPIEDAD INDUSTRIAL at 718-719)); published February 16, 2000, is prior art under 35 U.S.C. § 102(a)(1).
Ref. 3	<i>Iannaccone</i> , U.S. Design Patent No. D424,325 (Ex. 1006); issued May 9, 2000, is prior art under 35 U.S.C. § 102(a)(1).
Ref. 4	<i>Galant</i> (Ex. 1007); published and publicly accessible before April 18, 2005, is prior art under 35 U.S.C. § 102(a)(1).

As explained further in Section V.C below on claim construction, this petition proposes alternative constructions for the width of the two boards/planks that make up the claimed tabletop: the first based on the Patent Owner's anticipated construction in which the claimed design encompasses boards with equal widths and the second in which the boards cannot have equal widths. Regardless of the construction adopted, the claim of the '012 patent is unpatentable based on the grounds identified in the table below, which also identifies the proposed construction used for each ground.

Ground	Grounds of Unpatentability	Claim Construction
1	<i>Morgan</i> anticipates the claim of the '012 patent under 35 U.S.C. § 102.	Patent Owner's Equal-Width
2	<i>Morgan</i> renders the claim of the '012 patent obvious under 35 U.S.C. § 103	Patent Owner's Equal-Width
3	<i>Galant</i> and <i>Morgan</i> render obvious the claim of the '012 patent under 35 U.S.C. § 103.	Patent Owner's Equal-Width

4	<i>Bordonabe Furniture</i> anticipates the claim of the '012 patent under 35 U.S.C. § 102.	Both Constructions
5	<i>Bordonabe Furniture</i> renders the claim of the '012 patent obvious under 35 U.S.C. § 103	Both Constructions
6	<i>Galant</i> and <i>Bordonabe Furniture</i> render obvious the claim of the '012 patent under 35 U.S.C. § 103.	Both Constructions
7	<i>Iannaccone</i> anticipates the claim of the '012 patent under 35 U.S.C. § 102.	Both Constructions
8	<i>Iannaccone</i> renders the claim of the '012 patent obvious under 35 U.S.C. § 103	Both Constructions
9	<i>Galant</i> and <i>Iannaccone</i> render obvious the claim of the '012 patent under 35 U.S.C. § 103.	Both Constructions

IV. DISCRETIONARY DENIAL IS NOT WARRANTED

Discretionary denial under 35 U.S.C. § 314(a) is not warranted in this case because the *Fintiv* factors do not favor denial. *See Apple v. Fintiv*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). The *Fintiv* factors include: (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits.

The first factor is neutral because neither party has requested a stay¹ in the parallel district court litigation. *See, e.g., Samsung Elecs. Co. Ltd. v. Staton Techiya LLC*, IPR 2022-01078, Paper 10 at 13 (PTAB Dec. 29, 2022) (finding the first factor neutral where no stay had been granted).

The second factor weighs against discretionary denial. Although the initial scheduling order (Dkt. 26) has trial scheduled for November 28, 2023, the Patent Office’s Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation at 8-9 (June 21, 2022) (“Interim Procedure”) states that this factor should be analyzed in light of the median time to trial for civil actions. According to the most recent statistics (June 30, 2022), the median time from filing to trial for civil cases in the Central District of California is 23.5 months, up nearly 3 months from the previous year. U.S. District Courts – Federal Court Management Statistics – Profiles – June 3, 2022, *available at*: <https://www.uscourts.gov/file/45245/download>.

This 23.5-month period establishes an expected trial date in June 2024 for the parallel district court litigation, which was filed in June 2022. This is close to the projected statutory deadline for a final written decision. Accordingly, this factor weighs against discretionary denial, or is at worst neutral. *See, e.g., Apple v.*

¹ Petitioner intends to seek a stay once *inter partes* review is instituted.

Jawbone Innovations, LLC, IPR2022-01084, Paper 9 at 17 (PTAB Dec. 16, 2022)

(finding factor 2 to “weigh[] against discretionary denial” where the trial date was “around the same time or after” the projected final written decision.

The third factor strongly weighs against denial. As of the filing of this petition, practically nothing has happened in the district court litigation. An answer was only just filed in December 2022. No discovery has taken place. Nor have any motions been filed. Nor has any claim construction taken place. Thus, petitioner submits this factor weighs against discretionary denial.

As to the fourth factor, Petitioner stipulates that, unless the Board denies or later vacates institution, it will not pursue invalidity in the district court based on the specific grounds asserted in the petition. This stipulation prevents overlap because it requires the grounds asserted in the parallel proceedings to be mutually exclusive. See Interim Procedure at 7-8. As the Board in *Apple* found, such a stipulation mitigates to some degree the concerns of duplicative efforts and weighs marginally against discretionary denial. *Apple v. Jawbone Innovations, LLC*, IPR2022-01084, Paper 9 at 19-20 (discussing *identical* stipulation).

Factor 5 is neutral or at worst slightly favors denial. It’s not disputed that the parties here are the same. The Board has found this factor neutral in similar circumstances. See, e.g., *Protect Animals with Satellites, LLC v. OnPoint Sys.*,

LLC, IPR2021-01483, Paper 11 at 17 (PTAB Mar. 4, 2022) (finding the 5th factor neutral despite identical parties based on the trial date).

Factor 6 overwhelmingly weighs against denying institution. As demonstrated throughout this petition, the merits are compellingly strong. Petitioner has demonstrated a more than reasonable likelihood of success. Indeed, the design patent at issue in this case is exceedingly simple in nature, consisting of nothing more than two side-by-side planks. Given the rudimentary nature of the challenged design and the resulting limited issues for review, it should not be difficult to observe that the merits of the petition are strong. Accordingly, the Board should not deny institution here because “there is compelling evidence of unpatentability.” Interim Procedure at 5; *see also* Interim Procedure at 3-4 (noting the desire to “give third parties a quick, inexpensive, and reliable alternative to district court litigation to resolve questions of patent validity) (citations omitted).

In view of the foregoing factors, Petitioner submits that discretionary denial is not warranted in this case.

V. CLAIM CONSTRUCTION

A. The Solid Lines Define the Scope

The scope of the '012 patent is defined by the solid lines in figures 1-23—as opposed to the broken or dashed lines. *See, e.g., Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir. 2001); 37 C.F.R. § 1.152.

Although the Federal Circuit has recognized the “difficulties entailed in trying to describe a design in words” and has stated that the “preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design,” it has also recognized that it may be “helpful to point out . . . various features of the claimed design as they relate to the accused design and the prior art.” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679-80 (Fed. Cir. 2008). Accordingly, Petitioner construes the claims based on the solid lines of the ’012 patent along with verbal descriptions of certain features relevant to the prior art.

The specification of the ’012 patent claims the “ornamental design for a table top, as shown and described.” ’012 patent, claim 1. The description of the figures notes that “[t]he broken line portions of the tabletop in FIGS. 1-23 represent portions of the article that forms no part of the claim.” ’012 patent, description. The ’012 patent specifically explains that the broken lines include the “broken lines of the tenons in Fig. 8” and “the broken lines of the bases in Fig. 23.” *Id.* The description also disclaims “[t]he dot-dash broken lines,” which represent “boundary lines and form no part of the claimed design.”

Fig. 23 of the ’012 patent is reproduced below.

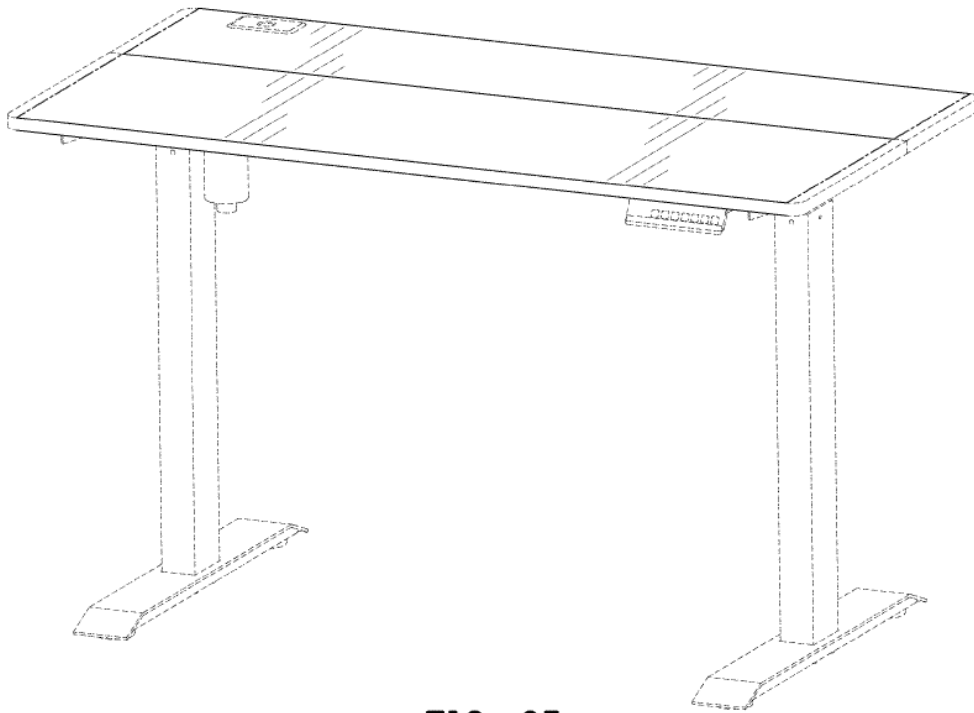


FIG. 23

As shown in Fig. 23, the claimed design does not include the edges of the tabletop (shown on the left and right of Fig. 23 above). Nor does the claimed design include any legs used to support the tabletop. Also, the design does not include anything attached to or contained within the surface or interior of the tabletop.

B. The '012 Patent Claim Consists of Two Boards/Planks

The '012 patent divides the tabletop into a “top portion” and a “bottom portion,” with figures 1-8 showing various views of the “top portion” and figures 9-15 showing views of the “bottom portion.” '012 patent, description. The remaining figures, 15-23, show “the table top,” with both the top and bottom

portions. *Id.* As shown in Figs. 1 (top portion) and 9 (bottom portion) below, the top and bottom portions each consists of a rectangular prism.

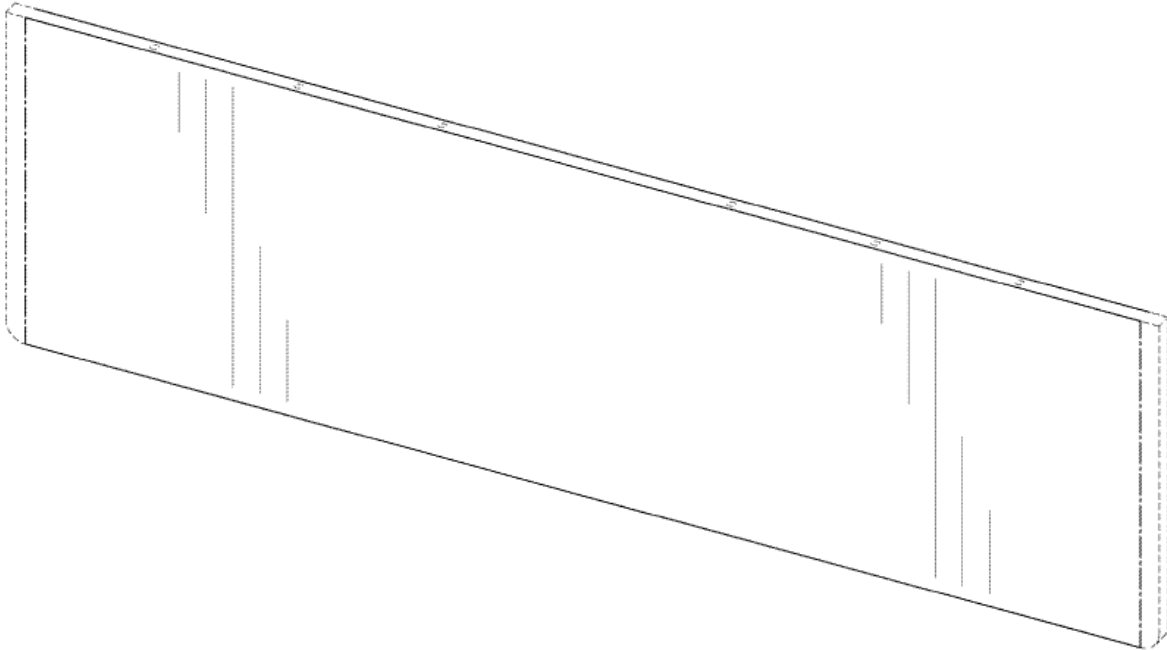


FIG. 1

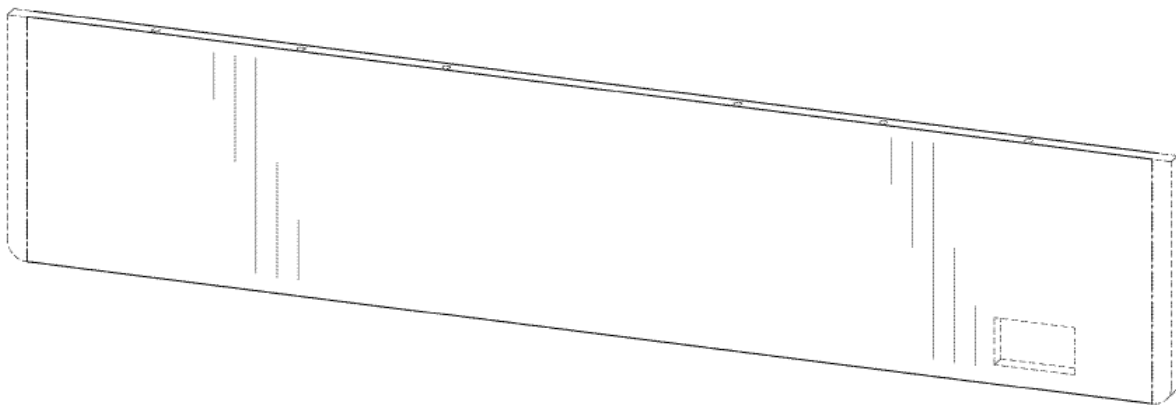


FIG. 9

Accordingly, Petitioner construes the claimed design to cover *two rectangular prisms abutted against each other to form a tabletop*. For ease of

reference, Petitioner refers to these rectangular prisms simply, and interchangeably as “boards” or “planks.”

C. Alternative Constructions for the Width of the Boards/Planks

The '012 patent shows that the two planks have different widths, with the “top portion” shown in Figs. 1-8 being wider than the “bottom portion” shown in Figs. 9-15. The resulting tabletop, as shown in Fig. 18 below with the “top portion” on the bottom, includes a seam where the two planks meet. In Fig. 18, the tabletop seam is not shown to be in the middle of the tabletop. In other words, Fig. 18 shows the planks have different, unequal widths.

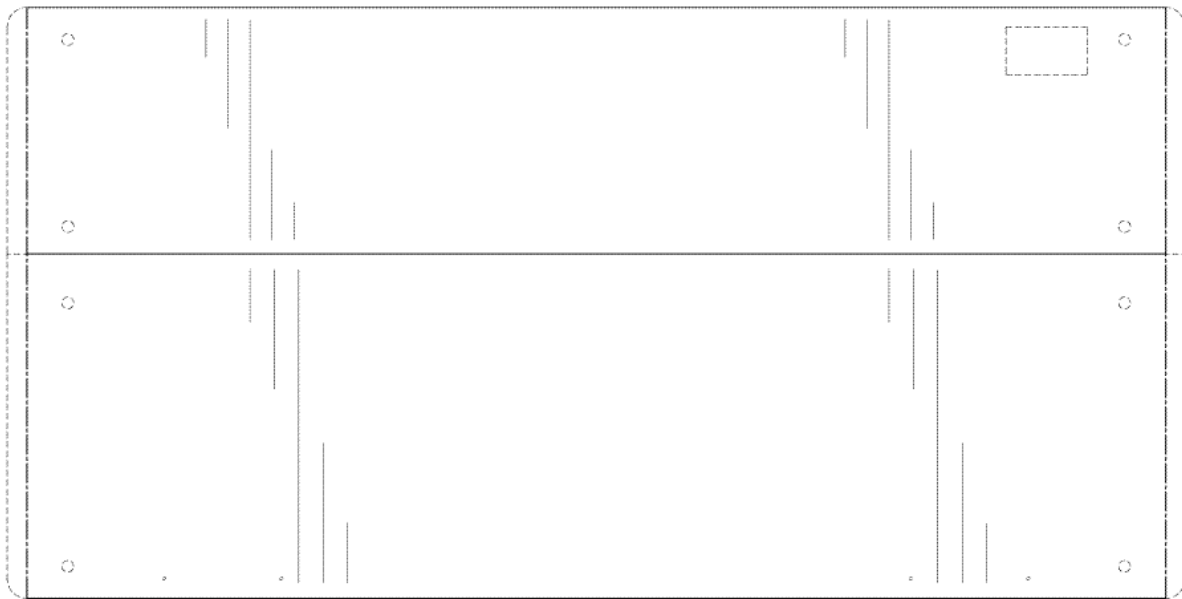


FIG. 18

In the district court litigation, however, the Patent Owner has asserted the '012 patent against tables that include a seam directly in the middle of the table.

See Ex. 1009 at 10 (accusing ASIN# B09JSBL7LH); Ex. 1010 (product page for ASIN B09JSBL7LH). Patent Owner's assertion of the '012 patent against tables with boards having the same, equal width (i.e., the seam is in the middle of the table) evidences Patent Owner's expected construction in this proceeding.

Petitioner expects Patent Owner to take a consistent position here, and based on such a construction, the prior art invalidates the challenged claim of the '012 patent. Patent Owner's statements before a federal court on the scope of the '012 patent may be cited here and considered by the Board pursuant to 35 U.S.C.

§§ 301(a)(2) and (d). Such statements may be considered to determine the proper meaning of patent claims. *See, e.g., 10X Genomics, Inc. v. Bio-Rad Labs. Inc.*, IPR 2020-00086, Paper 8 at 18-22 (PTAB Apr. 27, 2020).

Accordingly, Petitioner proposes alternative claim constructions for the relative width of the boards/planks. First, Petitioner proposes to construe the '012 patent to encompass tabletops wherein the boards/planks can have equal widths (i.e., they meet in the middle of the table), based on Patent Owner's expected construction.² Grounds 1-6 address this construction. Second, Petitioner proposes

² Petitioner utilizes Patent Owner's anticipated construction only for purposes of this proceeding and reserves the right to advocate different constructions. *See General Electric Co. v. Vestas Wind Sys. A/S.*, IPR2018-00928, Paper 9 at 14-16

to construe the '012 patent to cover *only* tabletops where the boards/planks have *unequal* widths (i.e., the seam in the table is off-center), based on the solid lines of the figures in the '012 patent. That is, Petitioner proposes to construe the '012 patent to *exclude* tabletops with planks having *equal* widths. Grounds 4-9 address this construction. Notably, grounds 4-6 specifically address both constructions because the prior art reference includes both equal and unequal-width planks.

While Grounds 4-9 specifically address a construction that excludes equal-width planks, these grounds also show the unpatentability of the claimed design under Patent Owner's anticipated construction because Patent Owner's expected construction merely encompasses equal-width planks—it does not necessarily require equal-width planks.

Where Petitioner expects Patent Owner to advance a certain construction that differs from Petitioner's construction, presentation of alternative constructions has been approved by the Board. *See, e.g., Philip Morris Prods., S.A. v. RAI Strategic Holdings, Inc.*, IPR 2020-00921, Paper 13 at 44 (PTAB Aug. 5, 2021) (recognizing that petitioners are often required to anticipate arguments that may be

(PTAB Nov. 5, 2018) (“[T]he rule does not prohibit a petitioner from submitting more than one construction, including one that it believes is incorrect, such as a patent owner's expected construction”).

advanced by the patent owner in a preliminary response resulting in their arguing in the alternative); *10X Genomics*, IPR 2020-00086, Paper 8 at 22 (“The regulatory history accompanying 37 C.F.R. § 42.104(b)(3) expressly contemplates that a petitioner may rely on alternative claim constructions.”).

VI. APPLICABLE LEGAL STANDARDS

A. Anticipation

The ordinary observer test is the “the sole test for anticipation.” *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009). This test asks whether an ordinary observer, familiar with the prior art, would be deceived into believing that the prior art reference and the claimed design are the same. *Egyptian Goddess*, 543 F.3d at 675, 681. The “ordinary observer” is one of ordinary acuteness who is a principal purchaser of the underlying articles with the claimed design. *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1337 (Fed. Cir. 2015) (citations omitted).

B. Obviousness Under 35 U.S.C. § 103

“For design patents, the ultimate inquiry for obviousness is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Spigen Korea Co. v. Ultraproof, Inc.*, 955 F.3d 1379, 1383 (Fed. Cir. 2020). “Obviousness is a question of law based on underlying factual questions [including] ‘(1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed

invention and the prior art; and (4) objective evidence of non-obviousness.’” *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014). (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

To determine whether a design patent is obvious, the Federal Circuit applies a two-part test. First, before prior art can be combined, there must exist a “‘primary reference,’ i.e., a single reference that creates ‘basically the same visual impression’ as the claimed design.” *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, at 1275 (Fed. Cir. 2021) (citing *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). To be “basically the same,” the designs cannot have substantial differences in their overall visual appearances or require major modifications. *Id.* (citing *Spigen Korea Co. v. Ultraproof, Inc.*, 955 F.3d 1379, 1383 (Fed. Cir. 2020)).

Second, after identifying the primary reference, secondary references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d, 1326, 1331 (Fed. Cir. 2014). The secondary references must be “so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Id.* (internal quotations and brackets omitted).

VII. DESIGNER OF ORDINARY SKILL

Petitioner submits that a designer of ordinary skill at the time would have been someone with a bachelors in furniture design or an equivalent field or two years of practical experience designing furniture. Ex 1002, Hatch Declaration (“Hatch”) at ¶¶ 33-36. A higher level of skill is likely not warranted given the rudimentary nature of using two boards to make a tabletop. *Id.*

VIII. OVERVIEW OF THE PRIOR ART

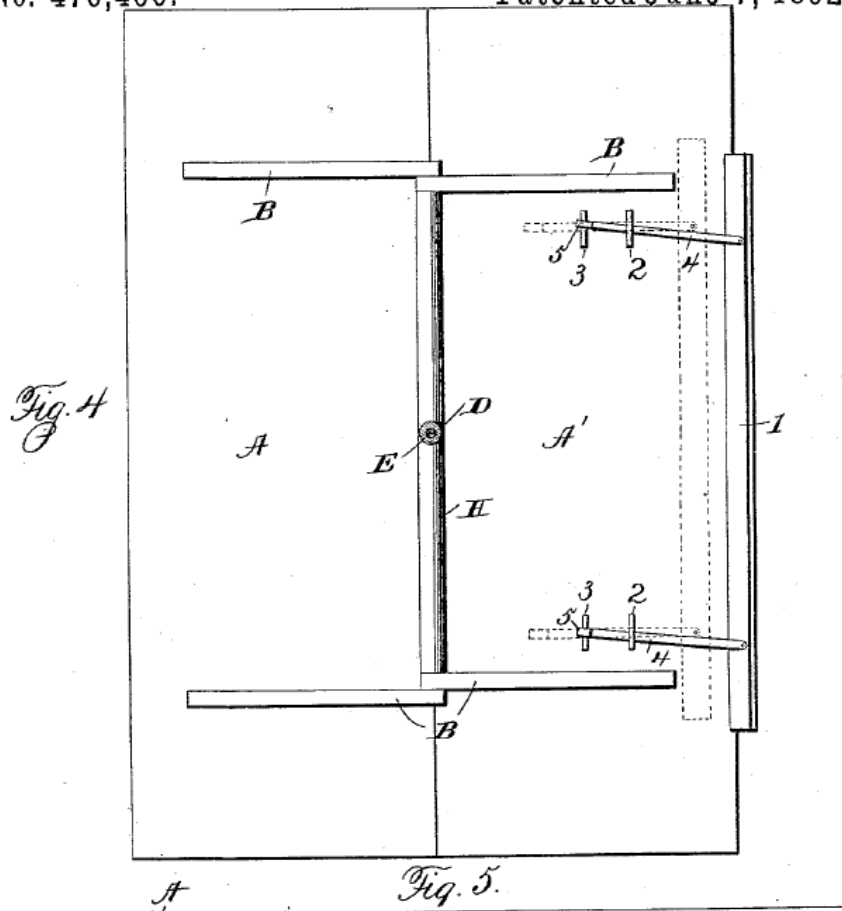
A. Morgan, U.S. Design No. 476,400 (Ex. 1004)

Morgan is a U.S. utility patent that issued on June 7, 1892, more than 130 years ago. It is prior art under at least 35 U.S.C. § 102(a)(1).

Morgan discloses a “folding table” that “can be folded so as to occupy but little space and which may be adjusted for various purposes.” *Morgan* at 1:13-17. Fig. 5 of *Morgan*, reproduced below, shows the folding table has a tabletop formed from two side-by-side boards:

No. 476,400.

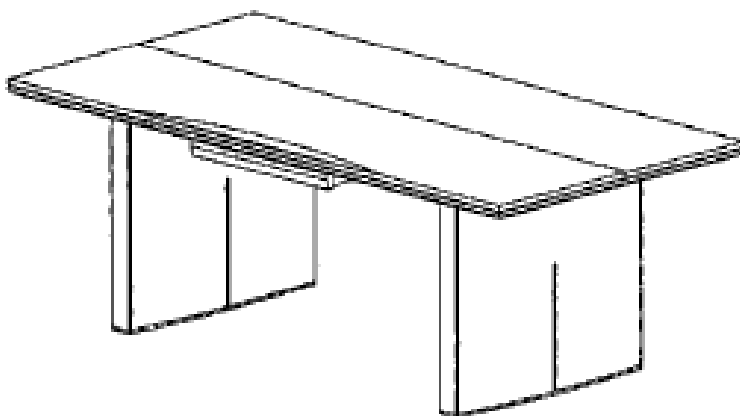
Patented June 7, 1892.



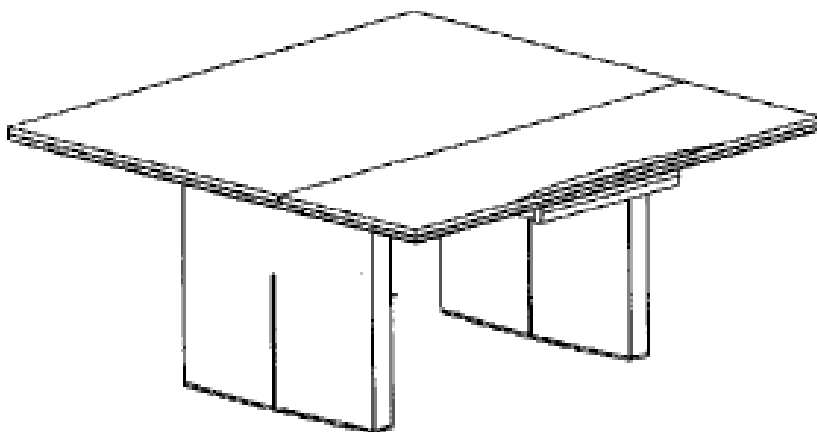
B. *Bordonabe Furniture*, Spanish Industrial Design No. I146513 (Ex. 1006 at 20-21 (16 FEBERO 2000, BOLETIN OFICIAL DE LA PROPIEDAD INDUSTRIAL at 718-719))

Bordonabe Furniture is a Spanish industrial design registration that was published on February 16, 2000, over two decades ago. *Bordonabe Furniture* is prior art under at least 35 U.S.C. § 102(a)(1).

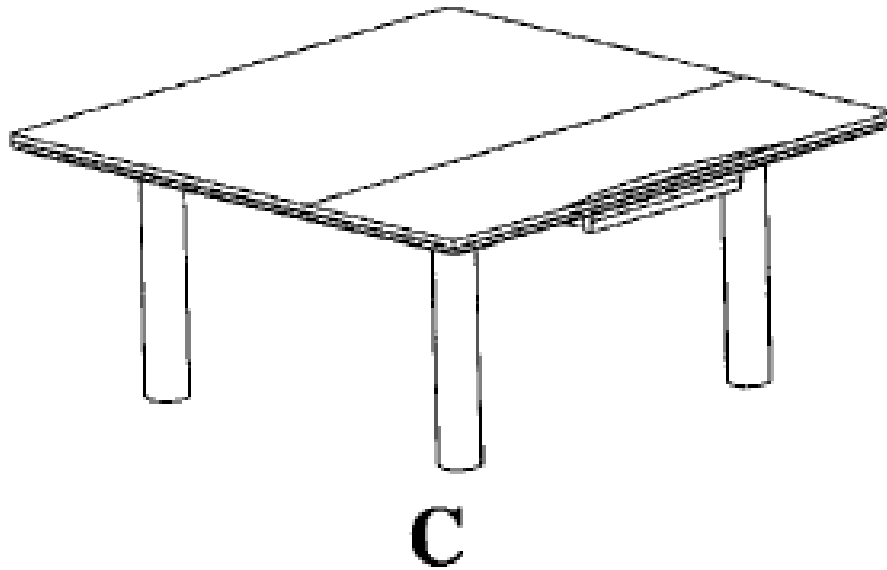
Bordonabe Furniture discloses 6 table designs, labelled A-F, three of which (A-C) include rectangular tabletops formed from two side-by-side boards, as shown in the reproduced figures below.



A



B



C. *Iannaccone*, U.S. Design Patent No. 424,325 (Ex. 1007)

Iannaccone is a U.S. design patent that issued on May 9, 2000, over 2 decades ago. *Iannaccone* is prior art under at least 35 U.S.C. § 102(a)(1).

Iannaccone discloses a “folding table” design. As shown in Fig. 1 of *Iannaccone*, the disclosed folding table includes a tabletop formed from two unequal-width planks arranged together side-by-side:

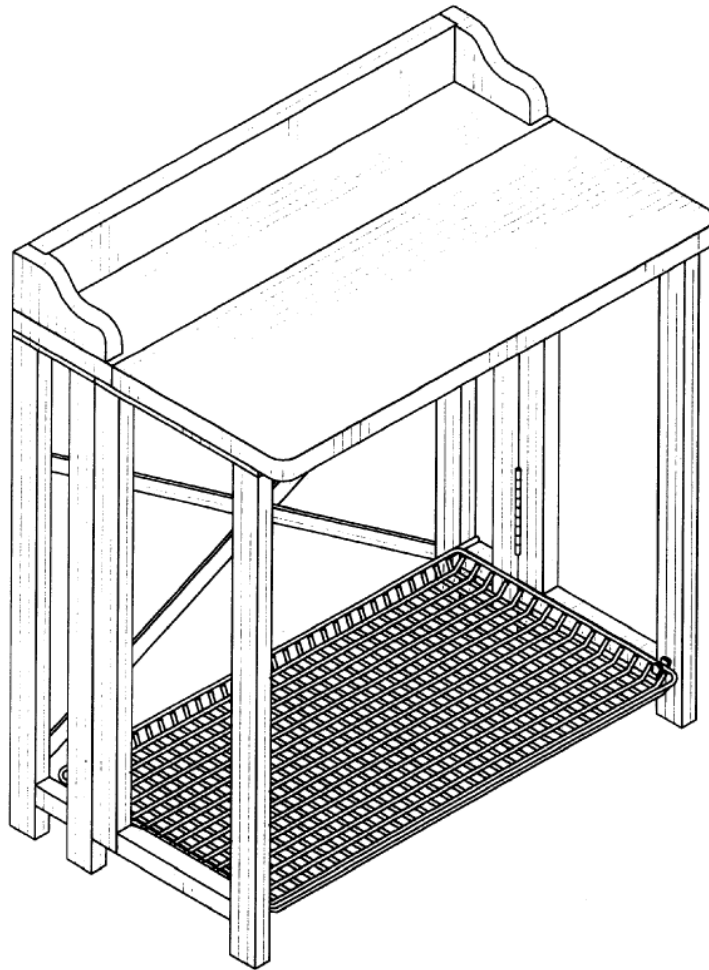


FIG. 1

D. Galant

Galant is an archived copy of Ikea’s website captured by the Wayback Machine on April 18, 2005. Ex. 1008 at ¶¶5-6. *Galant* is prior art under at least 35 U.S.C. § 102(a)(1).

Galant, which was captured by the Wayback Machine, is “inherently reliable.” *Analog Devices, Inc. v. Xilinx, Inc.*, IPR2020-01606, Paper 63 at 7(PTAB Apr. 20, 2022). As the Federal Circuit has recognized, district courts

have taken “judicial notice” of the contents of webpages available through the Wayback Machine. *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374-75 (Fed. Cir. 2021). Moreover, Petitioner has submitted a declaration (Ex. 1008) further evidencing the authenticity and public accessibility date of *Galant*. Accordingly, *Galant* is prior art under at least 35 U.S.C. § 102(a)(1).

Galant discloses the Galant tabletop, which was 120cm long and 60cm wide. The Galant tabletop disclosed in *Galant* is reproduced below:

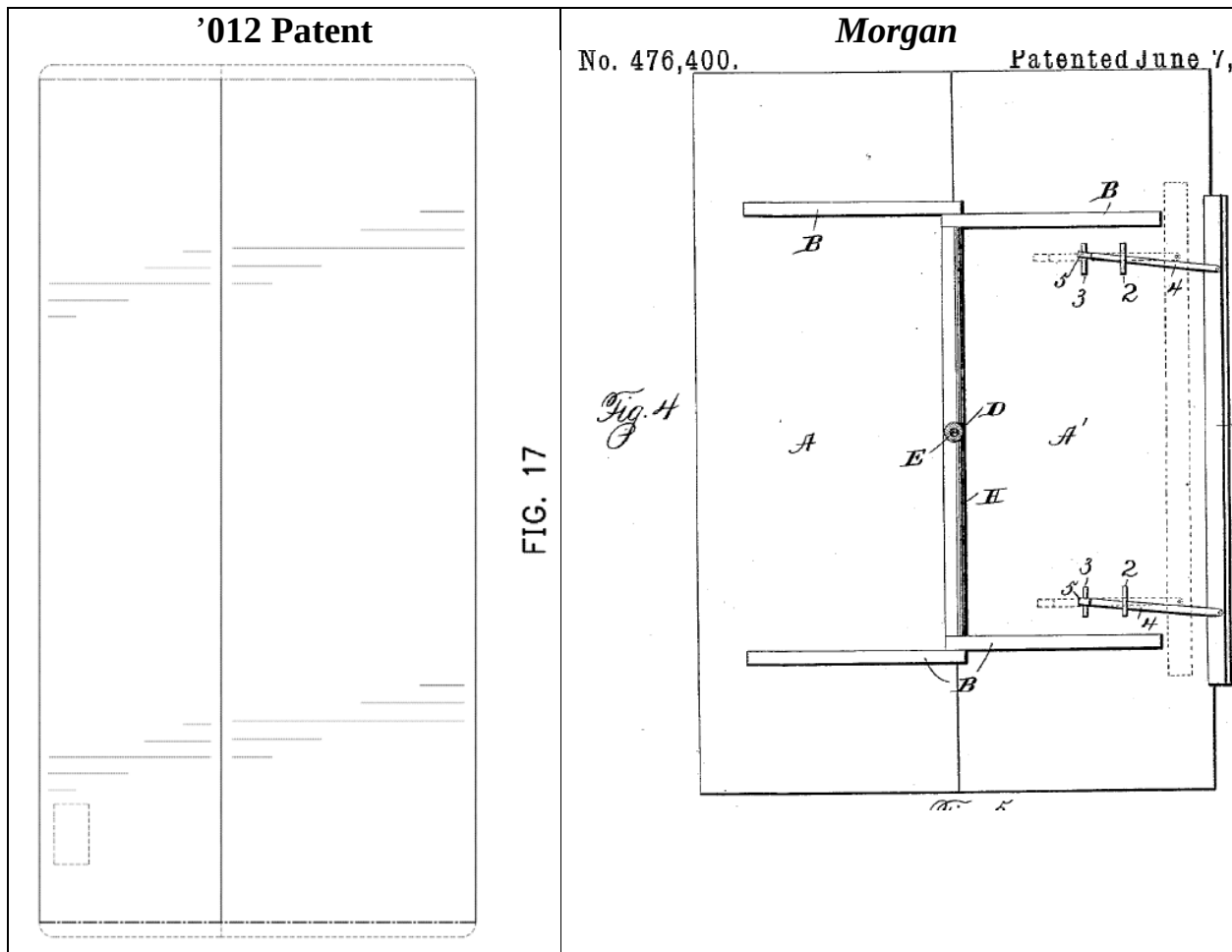


IX. CLAIM 1 OF THE '012 PATENT IS UNPATENTABLE OVER THE PRIOR ART

A. Ground 1: The Claim Is Anticipated Under § 102 by *Morgan*

Over 100 years ago, *Morgan* disclosed the same overall visual impression as the claimed design under Patent Owner's anticipated claim construction where the claimed design encompasses tabletops with equal-width boards/planks. Hatch at ¶¶ 53-58. As a result, the claim is anticipated by *Morgan*.

Under Patent Owner's construction, the tabletop disclosed in *Morgan* is identical in visual appearance to the '012 patent, as shown below in the side-by-side comparison:



As shown above, *Morgan's* tabletop includes the same tabletop claimed in the '012 patent: that is, a tabletop that consists of two rectangular prisms (boards or planks). That is, setting the legs of *Morgan* aside because legs are not claimed in the '012 patent, *Morgan's* tabletop is the same as that of the '012 patent. Moreover, *Morgan's* tabletop falls within the scope of the '012 patent under Patent Owner's anticipated construction because it includes equal-width planks.

In view of the above, an ordinary observer familiar with the relevant prior art, including the prior art references cited in this petition, would be deceived into

believing that *Morgan*, taken as a whole, is the design claimed in the '012 patent.

Hatch at ¶ 54. To the extent there are any minor variations, they do not preclude a finding of anticipation because the overall impression created—that of two planks abutted against each other to form a tabletop—remains equivalent between *Morgan* and the '012 patent. Hatch at ¶¶ 57-58. For example, while the *Morgan* tabletop has an overall length and width that may differ from the claimed design, a person of ordinary skill would likely not regard this as a difference in “design” because the overall impression created by the tabletop would remain the same: two planks abutted against each other. *Id.*

Like *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1243 (Fed. Cir. 2009), where the court agreed that slight variations in the “number and position of the circular holes” in shoes (e.g., Croc shoes) did not preclude a finding of anticipation because the overall visual impression remained the same, here any slight variations Patent Owner may allege would not change the overall visual impression created by *Morgan*: that of simply using two side-by-side planks to form a tabletop. Hatch at ¶¶ 57-58.

In *International Seaway*, the Federal Circuit considered the design of shoes (e.g., Croc shoes) with holes as part of the design. While that case specifically addressed the differing number and position of holes in two shoe design and found the difference would not have precluded a finding of anticipation, the result would

have been the same had the case addressed differences in shoe size instead. That is, a longer or shorter shoe design (appropriate for people with bigger/longer or smaller/shorter feet) would also not have precluded anticipation so long as the overall visual impression remained the same between shoe designs. The same is true here: a longer or shorter tabletop (as in the case of *Morgan*) does not preclude a finding of anticipation because the overall visual impression (simply two planks) remains the same.

B. Ground 2: The Claim Is Obvious Under § 103 Over *Morgan*

Under Patent Owner’s anticipated construction (which encompasses equal-width boards), and in view of the common knowledge of a designer having ordinary skill in the art, the claim is obvious under 35 U.S.C. § 103 over *Morgan*. Hatch at ¶¶ 59-63.

Morgan is a suitable primary reference because its “design characteristics [] are basically same as the claimed design.” *Durling*, 101 F.3d at 103. *Morgan*’s tabletop has the same design claimed in the ’012 patent: one consisting of two planks abutted against each other. Indeed, *Morgan* is so similar to the claimed design that no secondary reference is necessary.

To the extent there are any differences (under Patent Owner’s construction) between *Morgan* and the claimed design, *Morgan* itself readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d

1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). For instance, to the extent Patent Owner argues that the proportions of the entire tabletop (i.e., the overall length/width) differ between *Morgan* and the claimed design, those proportions would have been obvious because they are purely functional, rather than ornamental in nature. See *Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be “obvious, from a functional standpoint.”). Indeed, the length and width of the workspace created by a rectangular tabletop is dictated by the size and proportions of the desired workspace, which is entirely functional in nature. See *Door-Master*, 256 F.3d at 1312 (“only the non-functional aspects of an ornamental design as shown in a patent are proper bases for design patent protection”) (internal quotations and citations omitted).

Even if that were not the case, however, a designer of ordinary skill would have found changing the overall length/width of the table to be trivially obvious. Hatch at ¶¶ 62-63. A designer with ordinary skill in the art would have had the common knowledge and skill to understand that any given table could be easily modified to be longer or shorter depending on the application and would have been motivated to vary the overall size of the tabletop to suit the particular application.

For example, a square coffee table is easily changed to be 2x3 (instead of 1x1) while retaining the same design characteristics as the original coffee table.

In view of the above, the claim is obvious under 35 U.S.C. § 103 based on *Morgan*.

C. Ground 3: The Claim is Obvious Under § 103 Over *Galant* and *Morgan*

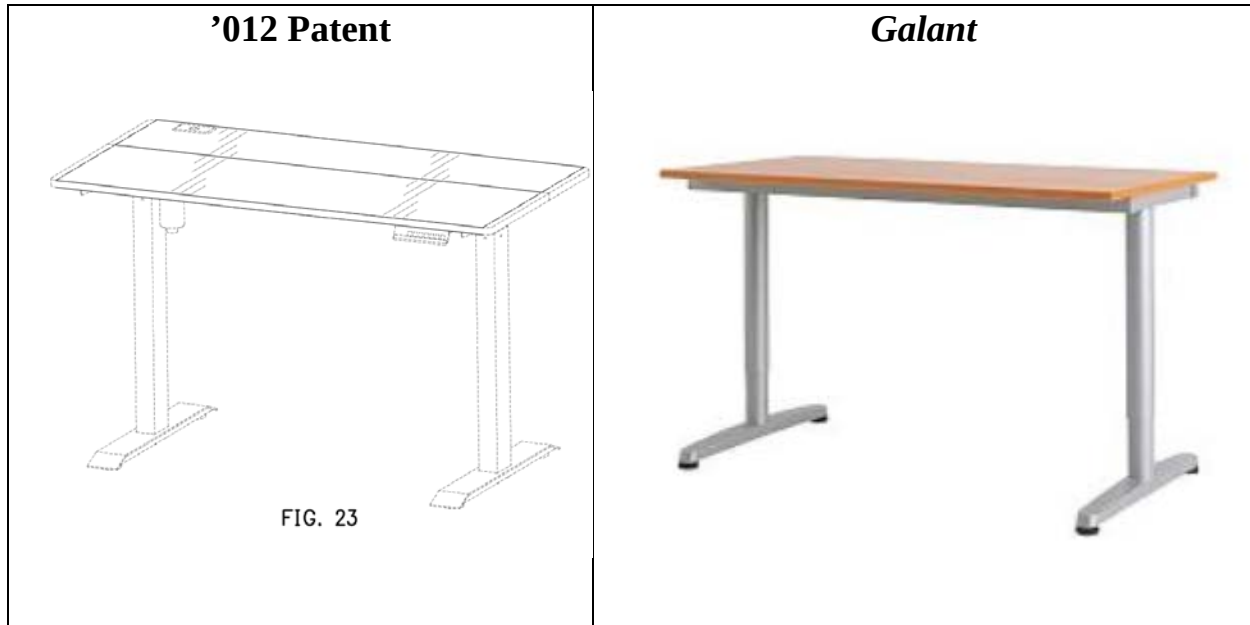
Under Patent Owner's anticipated construction, the claimed design is obvious over *Galant* and *Morgan*. Hatch at ¶¶ 64-72.

As explained in the previous section, *Morgan* is a suitable primary reference because it has the same design characteristics: that of a tabletop formed of two side-by-side boards.

To the extent Patent Owner argues that the overall proportions (length/width) of the tabletop differ between *Morgan* and the claimed design, Petitioner submits (*see* previous section) that the claimed design is obvious without reference to a secondary reference. Petitioner also maintains that a mere variation of the tabletop size is not patentable because it is entirely functional in nature. *Monoflo*, 5 F.3d 1505; *Door-Master*, 256 F.3d at 1312.

Nonetheless, to the extent a secondary reference is needed, *Galant* renders obvious a tabletop with proportions identical to the claimed design. As shown below, *Galant* discloses a rectangular tabletop. *Galant* explains that the tabletop

has a length of 120cm and a width of 60cm. In other words, *Galant* discloses a tabletop twice as long as it is wide.



Galant's tabletop has same length/width proportion disclosed in the claimed design. See '012 patent, Fig. 17 (showing a tabletop that is approximately twice as long as it is wide). In fact, as shown in the comparison above, *Galant*'s tabletop is *literally identical* to the claimed tabletop aside from the seam that divides the two planks in the claimed design. Hatch at ¶ 68. Thus, to the extent patent owner argues that *Morgan* does not render the claimed design obvious (see previous section) because *Morgan* has a tabletop with a different length/width, it would have been obvious to implement a tabletop that is twice as long as it is wide in view of *Galant*.

A designer of ordinary skill would have found it obvious to vary the length and width of the table in *Morgan* in view of *Galant* at least because it was a tabletop size offered by *Ikea*, a popular, well-known furniture provider. Hatch at ¶ 69. At a minimum, such a tabletop proportion would have been obvious to try. *Id.* Designing the tabletop to have a length/width proportion that matched another tabletop was a simple design choice that involved no more than a mere substitution of one known element for another (i.e., substituting one tabletop size for another). Implementing *Morgan*'s folding table with the dimensions of *Galant* would have beneficially and obviously created a table the size of *Galant* that could fold, increasing versatility and allowing the table to be stored when not in use. This would have been a desirable option so that the resulting table could be used as a desk, as was the case with *Galant*. *Id.*

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) ("obvious changes in arrangement and proportioning are no more patentable in one case than in the other"). Indeed, there is nothing unpredictable or nonobvious about designing a table to be longer to allow for more workspace on the tabletop. Hatch at ¶ 70. While the support mechanism under *Morgan*'s tabletop would have needed to be appropriately modified to support the new size of the tabletop, this would have been well within

the skill of an ordinary designer to do, at least because *Morgan* involved folding table technology that is over 130-years old.

The *Galant* tabletop is “so related to the primary reference” as to suggest the application of its dimensions to *Morgan* because both references are tabletops. Both references relate to tables and their tabletops. A designer of ordinary skill would have immediately recognized that features from one tabletop, whether ornamental or functional, could easily be applied to the other.

The resulting tabletop would continue to have the two planks disclosed in *Morgan* appropriately lengthened to form a tabletop twice as long as it is wide. Under Patent Owner’s anticipated construction, which encompasses equal-width boards, the resulting tabletop would be identical to the claimed tabletop.

To the extent Patent owner alleges there are any other differences when compared to the claimed design, *Morgan* and *Galant* readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”).

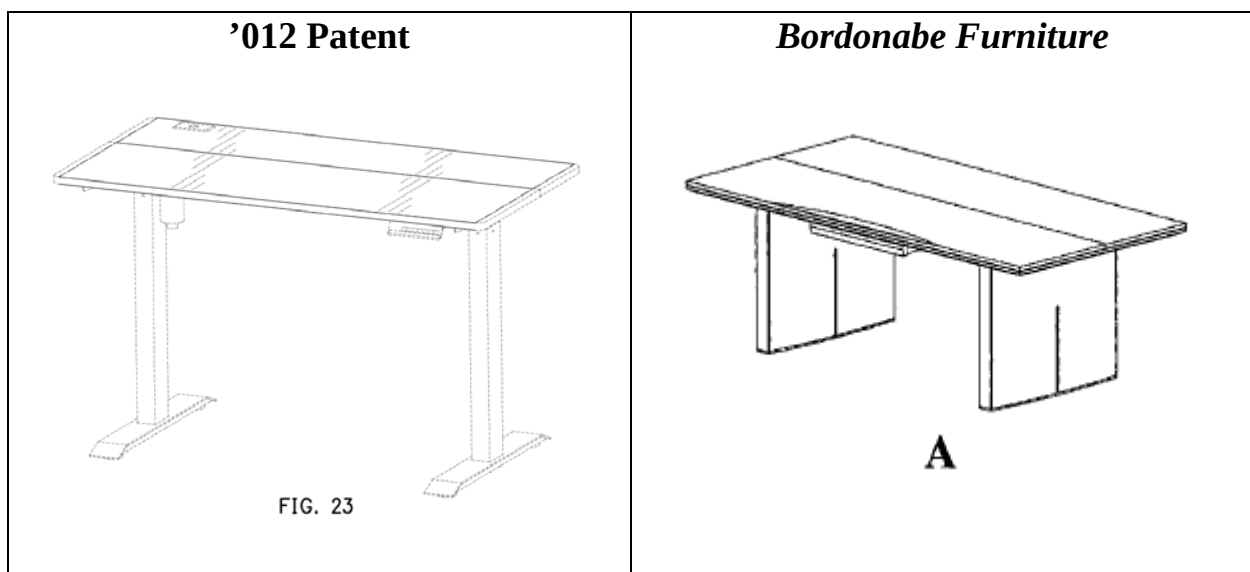
D. Ground 4: The Claim Is Anticipated Under § 102 by *Bordonabe Furniture*

Bordonabe Furniture discloses the same overall visual impression as the claimed design, whether under Patent Owner’s anticipated construction or a

construction the excludes equal-width planks. Hatch at ¶¶ 73-81. Thus,

Bordonabe Furniture anticipates the claimed design.

As shown in the below side-by-side comparison, design A of *Bordonabe Furniture* depicts a tabletop that is identical in visual appearance to the '012 patent under Patent Owner's anticipated construction: (Ex. 1006 at 20 (16 FEBERO 2000, BOLETIN OFICIAL DE LA PROPIEDAD INDUSTRIAL at 718)).



Design A of *Bordonabe Furniture* includes a tabletop with the same design claimed in the '012 patent: one consisting of two boards/planks. Design A of *Bordonabe Furniture* is encompassed within the scope of Patent Owner's anticipated construction because the construction encompasses tabletops consisting of boards having equal widths. Hatch at ¶ 74.

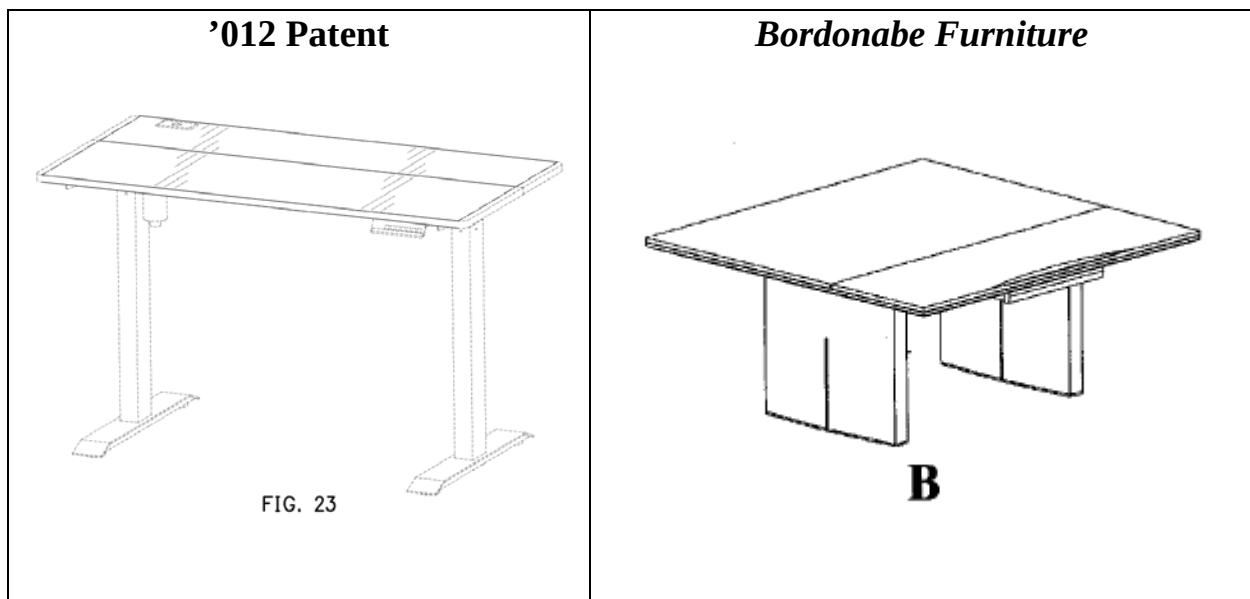
While design A of *Bordonabe Furniture* includes legs and other features on the side of the tabletop that differ from the broken line environment shown in the

'012 patent, these features are not relevant to determining whether the claimed design is anticipated because those features are not claimed. Indeed, the '012 patent specifically disclaims the legs and other features attached to the tabletop, showing them in broken lines.

An ordinary observer, familiar with the relevant prior art, including those cited in this petition), would be deceived into believing design A of *Bordonabe Furniture* is the same design claimed in the '012 patent—one that consists of two boards—which under Patent Owner's anticipated construction encompasses boards having equal widths. Hatch at ¶ 76. To the extent there are any minor variations, those would not preclude a finding of anticipation because the overall visual impression remains the same—that of two side-by-side boards used to form a tabletop. *See, e.g., Int'l Seaway Trading*, 589 F.3d at 1243. In other words, there are no substantial differences between *Bordonabe Furniture* and the claimed design. Hatch at ¶ 76 (exhaustively addressing differences).

Additionally, under Petitioner's alternative proposed construction that excludes boards of equal width, *Bordonabe Furniture* also discloses the same overall visual impression as, and therefore anticipates, the '012 patent. As shown in the table below, *Bordonabe Furniture* Design B includes a tabletop with the same design claimed in the '012 patent: one consisting of two boards/planks. Moreover, design B has two boards/planks that fall within both (1) the scope of

Patent Owner's anticipated construction (which encompasses boards with equal widths but does not necessarily require equal-width boards) and (2) Petitioner's alternative construction which excludes equal-width boards. This is the case because the boards in *Bordonabe Furniture* Design B are depicted with unequal width boards. (Ex. 1006 at 20 (16 FEBERO 2000, BOLETIN OFICIAL DE LA PROPIEDAD INDUSTRIAL at 718)).



Under both constructions, an ordinary observer, familiar with the relevant prior art, including those cited in this petition, would be deceived into believing the tabletop depicted in Design B of *Bordonabe Furniture* is the same design as claimed in the '012 patent—because it consists of two unequal width boards. Hatch at ¶ 79. In other words, an ordinary observer would have immediately seen that the design of the tabletop in Design B simply divided the overall tabletop into two unequal-width pieces, which is the same as the design in the '012 patent.

As in *International Seaway*, where the court agreed that minor variations in both the number and *position* of holes did not preclude a finding of infringement (589 F.3d at 1243), here, any minor variations Patent Owner may point out in the position of the line between planks or the overall size of the table do not preclude anticipation because they would not change the overall visual impression created by *Bordonabe Furniture*: that of simply using two side-by-side planks to form a tabletop. See Hatch at ¶¶ 80-81. Indeed, a shoe, shirt, or pant design does not change merely because it is modified to fit a person with bigger feet or longer legs. Here, minor changes to the proportioning of *Bordonabe Furniture*'s tabletop to suit a room or application would not alter its basic design: side-by-side planks to form a tabletop.

E. Ground 5: The Claim Is Obvious Under § 103 Over *Bordonabe Furniture*

Under either Patent Owner's anticipated construction (which encompasses equal-width boards) or Petitioner's alternative construction, the claim is obvious under 35 U.S.C. § 103 over *Bordonabe Furniture*. Hatch at ¶¶ 82-94.

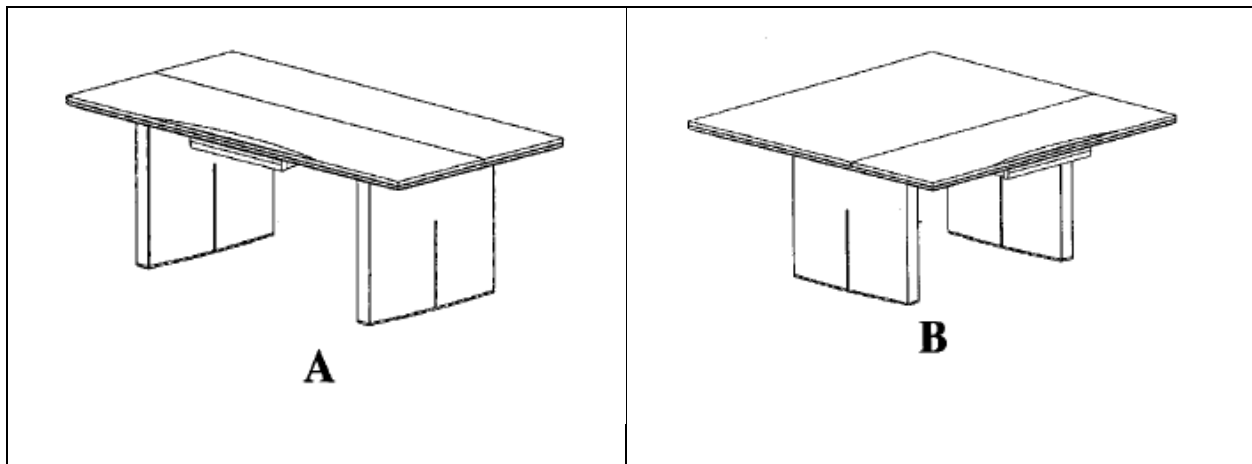
Bordonabe Furniture is a suitable primary reference because its "design characteristics [] are basically same as the claimed design." *Durling*, 101 F.3d at 103. *Bordonabe Furniture*'s tabletop has the same design claimed in the '012 patent: one consisting of two planks abutted against each other. As explained in the preceding section, *Bordonabe Furniture* discloses basically the same design as

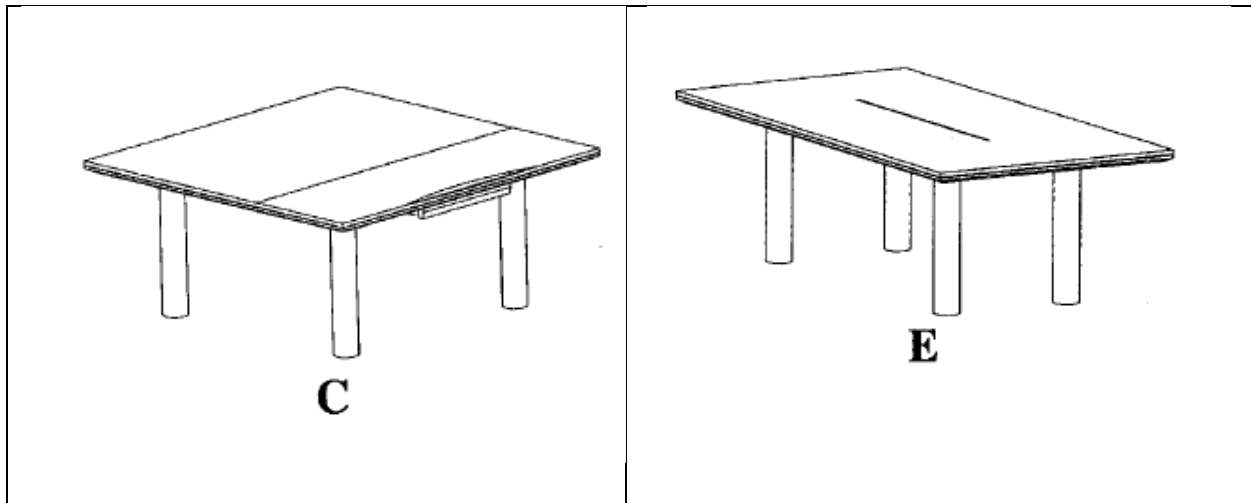
the '012 patent under either alternative construction because it discloses equal and unequal-width planks as options for the two tabletop planks. Indeed, *Bordonabe Furniture* is so similar to the claimed design that no secondary reference is necessary.

To the extent there are any differences (under Patent Owner's construction) between *Bordonabe Furniture* and the claimed design, *Bordonabe Furniture* itself readily suggests those differences to a designer of ordinary skill in the art. See, e.g., *In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) ("obvious changes in arrangement and proportioning are no more patentable in one case than in the other"); see also Hatch at ¶¶ 85-87 (exhaustively analyzing differences). For instance, to the extent Patent Owner argues that the proportions of the entire tabletop (i.e., the overall length/width) differ between *Bordonabe Furniture* and the claimed design, those proportions would have been obvious because they are purely functional, rather than ornamental in nature. See *Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be "obvious, from a functional standpoint."). Indeed, the length and width of the workspace created by a rectangular tabletop is entirely dictated by the size and proportions of the desired workspace, which is entirely functional in nature. See *Door-Master*, 256 F.3d at 1312 ("only the non-functional aspects of an ornamental design as shown in a patent are proper bases

for design patent protection”) (internal quotations and citations omitted); Hatch at ¶ 85.

Moreover, *Bordonabe Furniture* itself expressly teaches variations in the size and proportions of tabletops, showing a variety of rectangular shapes and relative proportions between the planks, including both equal and unequal-width planks (Ex. 1006 at 20-21 (16 FEBERO 2000, BOLETIN OFICIAL DE LA PROPIEDAD INDUSTRIAL at 718-19)). In fact, Design A of *Bordonabe Furniture* includes a tabletop with proportions that are difficult to distinguish from the claimed design. Hatch at ¶ 76 (noting the proportion difference is “hard to discern”).





With these variations in mind, an ordinary designer would have found any alleged proportional differences between *Bordonabe Furniture* and the claimed design to be obvious. Hatch at ¶ 86. A designer with ordinary skill in the art would have had the common knowledge and skill to understand that any given table design could be easily modified to be longer or shorter depending on the application and would have been motivated to make such modifications. A square coffee table is easily designed to be 2x3 (instead of 1x1) while retaining the same design characteristics as the original coffee table. Likewise, a longer tabletop (e.g., used as a dining or writing table) is easily shortened, while retaining the same overall design, to serve applications typically involving shorter tables, like coffee tables and nightstands. Here, changing the overall length and width of a tabletop, while retaining the same design characteristics, would have been trivially obvious to an ordinary designer.

Bordonabe Furniture itself not only suggests that (1) the overall shape of the table could be easily varied, but also suggests that (2) the placement of the dividing line (where the two boards meet) could vary from table to table. As shown above, *Bordonabe Furniture* disclosed that the position of the seam can vary, disclosing equal width and unequal-width seams in Designs A-C. Moreover, under the second construction, varying the width of the planks would have been obvious to an ordinary designer based on the common knowledge of the designer. A designer of ordinary skill would have found it obvious to vary the relative widths of the boards to arrive at widths similar to the claimed design based on considerations such as (1) maximizing resources, (2) the ability to source equal-width planks, and (3) wood grain patterns (e.g., finding matching grains or avoiding knots). Hatch at ¶¶ 90-93. At a minimum, changing the relative widths of the boards would have been obvious to try in view of the varied designs in *Bordonabe Furniture*. *Id.*

To the extent there are any other differences between *Bordonabe Furniture* and the claimed design, they are exceedingly minor. Indeed, the only other possible difference discernable from close inspection is that *Bordonabe Furniture*'s tabletop may include ornamental edge profiling (e.g., a chamfer or other ornamental edge) that appears absent from the claimed design. See Hatch at ¶¶ 85-94. But that is an additional ornamental feature present in *Bordonabe Furniture* rather than the claimed design. It would have been obvious to omit such

edge profiling, to the extent it's even there, and simply use the default edge for a table. See Hatch at ¶¶87 (explaining that square edges are the default, initial edges that results from preparing wood). Any other difference is *de minimus* and not sufficient to justify a finding that the claimed design is patentable under § 103. *Id.* at ¶ 94.

In view of the above, the claim is obvious under 35 U.S.C. § 103 based on *Bordonabe Furniture*.

F. Ground 6: The Claim is Obvious Under § 103 Over *Galant* and *Bordonabe Furniture*

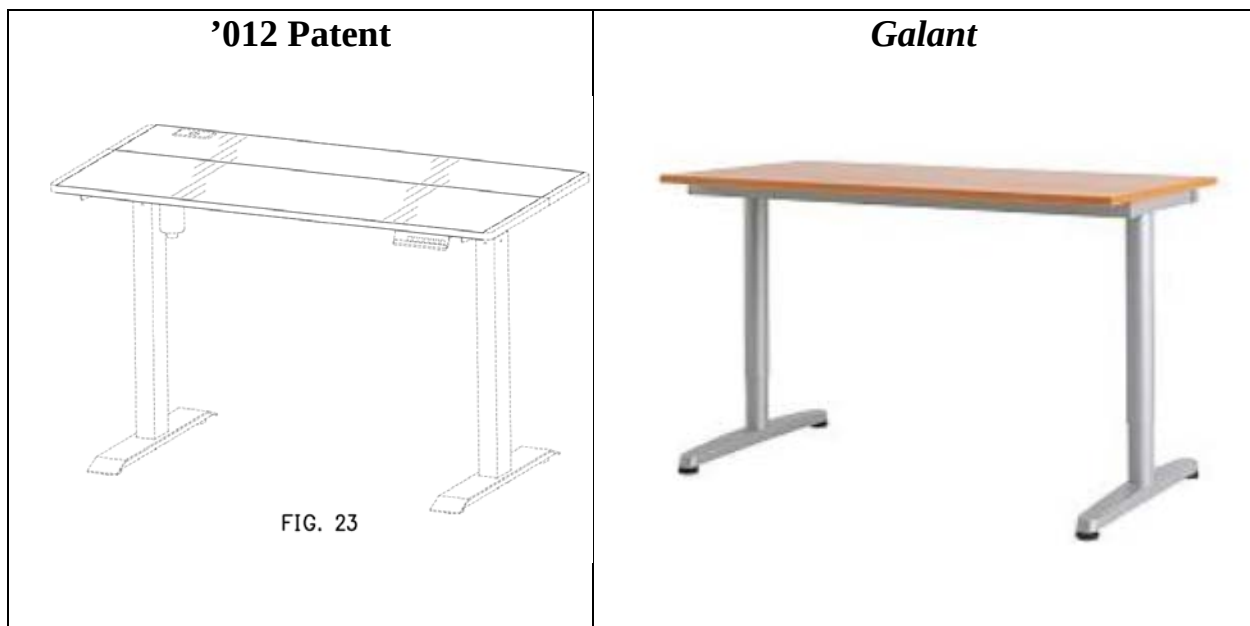
Under both Patent Owner's anticipated construction and Petitioner's proposed construction, the claimed design is obvious over *Galant* and *Bordonabe Furniture*. Hatch at ¶¶ 95-104.

As explained in the previous section, *Bordonabe Furniture* is a suitable primary reference under either proposed construction because it has the same design characteristics: that of a tabletop formed of two side-by-side boards. Design A of *Bordonabe Furniture* shows two side-by-side boards of equal widths and Design B of *Bordonabe Furniture* shows unequal-width planks.

To the extent Patent Owner argues that the overall proportions (length/width) of the tabletop differ between *Bordonabe Furniture* and the claimed design, Petitioner submits (*see* previous section) that the claimed design is obvious without reference to a secondary reference. Petitioner also maintains that a mere

variation of the tabletop size is not patentable because it is entirely functional in nature. *Monoflo*, 5 F.3d 1505; *Door-Master*, 256 F.3d at 1312.

Regardless, *Galant* renders obvious a tabletop with proportions identical to the claimed design. As shown below, *Galant* discloses a rectangular tabletop. *Galant* explains that the tabletop has a length of 120cm and a width of 60cm. In other words, *Galant* discloses a tabletop twice as long as it is wide.



Galant's tabletop has same length/width proportion disclosed in the claimed design. See '012 patent, Fig. 17 (showing a tabletop that is approximately twice as long as it is wide). In fact, as shown in the comparison above, *Galant*'s tabletop is *literally identical* to the claimed tabletop aside from the seam that divides the planks in the claimed design. Hatch at ¶ 99. Thus, to the extent patent owner argues that *Bordonabe Furniture* does not render the claimed design obvious (see

previous section) because *Bordonabe Furniture* has a tabletop with a different length/width, it would have been obvious to implement a tabletop that is twice as long as it is wide in view of *Galant*.

A designer of ordinary skill would have found it obvious to vary the length and width of the table designs in *Bordonabe Furniture* (including Design A and Design B) in view of *Galant* at least because it was a tabletop size offered by *Ikea*, a popular, well-known furniture provider. Hatch at ¶ 100. At a minimum, such a tabletop proportion would have been obvious to try. *Id.* A designer of ordinary skill would have recognized that the *Galant* dimensions are an example of desirable and appropriate dimensions for a desk, whether to be used as a writing desk or computer desk. Implementing *Bordonabe Furniture*'s tables with the dimensions of *Galant* would have beneficially and obviously created a table with a popular functional size, while maintaining the design characteristics of *Bordonabe Furniture*. Designing the tabletop to have a length/width proportion that matched another tabletop was a simple design choice that involved no more than a substitution of one known element for another (i.e., substituting one tabletop size for another). Indeed, even *Bordonabe Furniture* itself shows rectangular tabletops of various proportions, further evidencing the obvious nature of varying tabletop dimensions.

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). Indeed, there is nothing unpredictable or nonobvious about designing a table to be longer to allow for more workspace on the tabletop. Hatch at ¶ 101.

The *Galant* tabletop is “so related to the primary reference” as to suggest the application of its dimensions to *Bordonabe Furniture*. Both references relate to tabletops and features from one, whether ornamental or not, would have been readily applicable to the other by a designer of ordinary skill.

The resulting tabletop would continue to have the two planks disclosed in *Bordonabe Furniture*, with equal-width planks of Design A or unequal-width planks of Design B. The planks would have been appropriately dimensioned to form an overall tabletop twice as long as it is wide. Under Patent Owner’s anticipated construction, which encompasses equal-width boards, the tabletop resulting from Design A would be completely identical to the claimed tabletop. Hatch at ¶ 103. And under Petitioner’s construction, which excludes equal-width planks (and also under Patent Owner’s construction which does not necessarily exclude unequal-width boards), the tabletop resulting from Design B would also be identical to the claimed tabletop design.

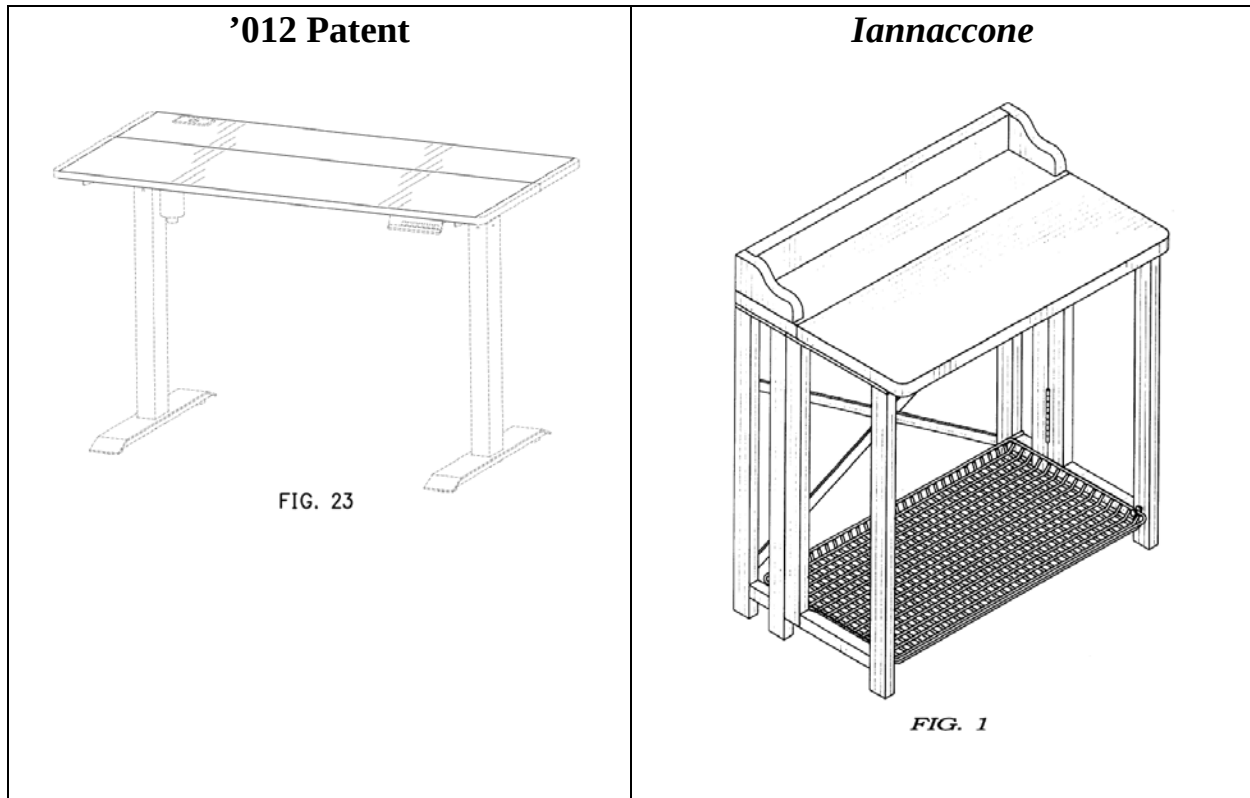
To the extent Patent owner alleges there are any other differences when compared to the claimed design, *Bordonabe Furniture* and *Galant* readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). For example, any differences in the proportioning of the unequal-width planks is readily suggested by *Bordonabe Furniture*, which discloses various positions for the dividing line between the planks. Hatch at ¶ 104 (exhaustively addressing differences). As discussed in the preceding section, a designer of ordinary skill would have known that the planks could be dimensioned in any way to achieve the same overall tabletop workspace and would have found it obvious to vary the widths of the planks to arrive at proportions similar to the claimed design based on considerations such as (1) maximizing resources, (2) the ability to source equal-width planks, and (3) wood grain patterns (e.g., finding matching grains or avoiding knots). Hatch at ¶¶ 104, 90-93. Any other differences, to the extent there are any, are *de minimus* and not sufficient to justify a finding that the claimed design is patentable under § 103. *See* Hatch at ¶ 104.

G. Ground 7: The Claim Is Anticipated Under § 102 by *Iannaccone*

Iannaccone discloses the same overall visual impression as the claimed design, whether under Patent Owner’s anticipated construction or a construction

that excludes equal-width planks. Hatch at ¶¶ 105-12. *Iannaccone* thus anticipates the '012 patent.

The below table shows a side-by-side comparison of the claimed design with the tabletop disclosed in *Iannaccone*:



As is evident from the above comparison, *Iannaccone*'s tabletop has the same design claimed in the '012 patent—one consisting of two boards/planks abutted against each other. Hatch at ¶¶ 106-07. Moreover, the planks have widths that are not equal and therefore meet in a line that is not in the middle of the tabletop, as shown in Fig. 1 of *Iannaccone* above.

While *Iannaccone* includes an additional back piece that sits on top of the table (shown in the top left of Fig. 1 sitting on top of the table), this feature is not relevant to the determination of whether *Iannaccone* discloses the same *tabletop* design as that claimed in the '012 patent. Indeed, the '012 patent specifically disclaims features other than the tabletop, including the legs and other items attached to the tabletop itself.

An ordinary observer would be deceived into believing *Iannaccone* and the '012 patent have the same design for the tabletop. Hatch at ¶ 109. The tabletops are practically identical, both consisting of unequal-width planks with similar proportions abutted against each other to form a tabletop that creates the same visual impression. *Id.* Even the overall size of the tabletops and widths of the planks are generally similar and difficult to distinguish from each other without resort to a measuring device. *Id.* at ¶ 110. To the extent there are any minor variations, those would not preclude a finding of anticipation because the overall impression created by simply using two side-by-side planks to make a tabletop remains the same between *Iannaccone* and the claimed design. *See, e.g., Int'l Seaway Trading*, 589 F.3d at 1243.

H. Ground 8: The Claim Is Obvious Under § 103 Over *Iannaccone*

Under both alternative constructions, and in view of the common knowledge of a designer having ordinary skill in the art, the claim is obvious under 35 U.S.C. § 103 over *Iannaccone*. Hatch at ¶¶ 113-27.

Iannaccone is a suitable primary reference because its “design characteristics [] are basically same as the claimed design.” *Durling*, 101 F.3d at 103. *Iannaccone*’s tabletop has the same design claimed in the ’012 patent: one consisting of two planks abutted against each other. Indeed, *Iannaccone* is so similar to the claimed design that no secondary reference is necessary.

Iannaccone’s planks fall within Patent Owner’s construction because they are not equal in width and Patent Owner’s anticipated construction does not necessarily exclude unequal width boards. And *Iannaccone*’s planks fall within Petitioner’s construction because that construction requires unequal-width planks.

To the extent there are any differences between *Iannaccone* and the claimed design, *Iannaccone* itself readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). For instance, to the extent Patent Owner argues that the proportions of the entire tabletop (i.e., the overall length/width) differ between *Iannaccone* and the claimed design, that difference is exceedingly minor because *Iannaccone*’s

overall tabletop size is similar to that of the '012 patent. Any difference in proportion is difficult to see without a measuring device. Hatch at ¶ 116.

Moreover, those proportions would have been obvious because they are purely functional, rather than ornamental in nature. See *Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be “obvious, from a functional standpoint.”). Indeed, the length and width of the workspace created by a rectangular tabletop is entirely dictated by the size and proportions of the desired workspace, which is entirely functional in nature. See *Door-Master*, 256 F.3d at 1312 (“only the non-functional aspects of an ornamental design as shown in a patent are proper bases for design patent protection”) (internal quotations and citations omitted).

Regardless, a designer with ordinary skill in the art would have had the common knowledge and skill to understand that any given table design could be easily modified to be longer or shorter depending on the application and would have been motivated to make such modifications. A square coffee table is easily designed to be 2x3 (instead of 1x1) while retaining the same design characteristics as the original coffee table. Likewise, a longer tabletop (e.g., used as a dining or writing table) is easily shortened, while retaining the same overall design, to serve applications typically involving shorter tables, like coffee tables and nightstands. Changing the overall length and width of a tabletop, while retaining the same

design characteristics, would have been trivially obvious to an ordinary designer.

Hatch at ¶ 118.

To the extent Patent Owner argues that the relative widths of the unequal-width planks differ between *Iannaccone* and the claimed design, that argument has no merit. Both tabletops have a narrower and wider plank and the proportioning between them is similar in nature. Any difference in widths is insubstantial. Hatch at ¶ 119.

Nonetheless, even if there were a substantial difference in widths between *Iannaccone* and the claimed design, proportioning the planks in *Iannaccone* differently would have been trivially obvious. *Iannaccone* itself suggests varying the proportions of the planks. As shown in Fig. 7 of *Iannaccone*, the wider plank is able to fold down to allow the table to occupy less space when not in use. A designer of ordinary skill would have immediately understood (indeed, anyone can understand this) that the relative width of the wider plank determines how much of the table is folded down and how much remains in the unfolded position.

Increasing the width of the wider plank relative to the narrow plank allows the table to occupy less space when folded, while decreasing the width of the wider plank relative to the narrow plank causes the table to occupy more space when folded down. Accordingly, an ordinary designer would have understood that the folded-down portion could be *trivially* designed to be wider or narrower depending

on the desired balance between (1) space saving and (2) usability of the table in its folded state. Hatch at ¶¶ 121-25 (explaining that varying the folded down portion has been done for centuries).

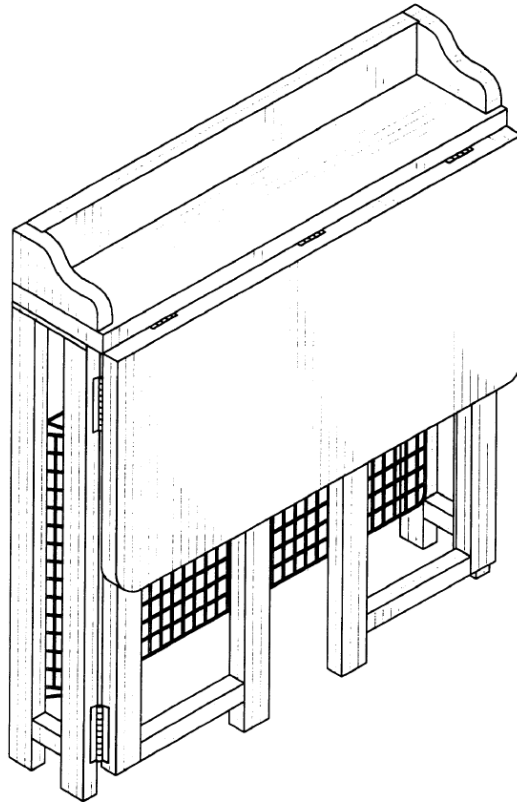


FIG. 7

For example, with a wider fold-down section, the table would achieve a very thin profile when not in use with the drawback that the table would be largely unusable when folded down, owing to the small remaining surface area. With a narrower fold-down section, the table would predictably retain more utility when folded down (because less of the table width is folded down and more remains in

the un-folded section), with the drawback that the table would occupy more space even when in the folded position. Varying the folded and unfolded area in such a table design borders on the trivial and has been done in drop leaf tables for 100s of years. Hatch at ¶ 124-25. Accordingly, any such difference Patent Owner may raise in support of its claimed design would have been obvious to an ordinary designer.

In view of the above, the claim is obvious under 35 U.S.C. § 103 based on *Iannaccone*.

I. Ground 9: The Claim is Obvious Under § 103 Over *Galant* and *Iannaccone*

Under both Patent Owner's anticipated construction and Petitioner's proposed construction, the claimed design is obvious over *Galant* and *Iannaccone*. Hatch at ¶¶ 128-39.

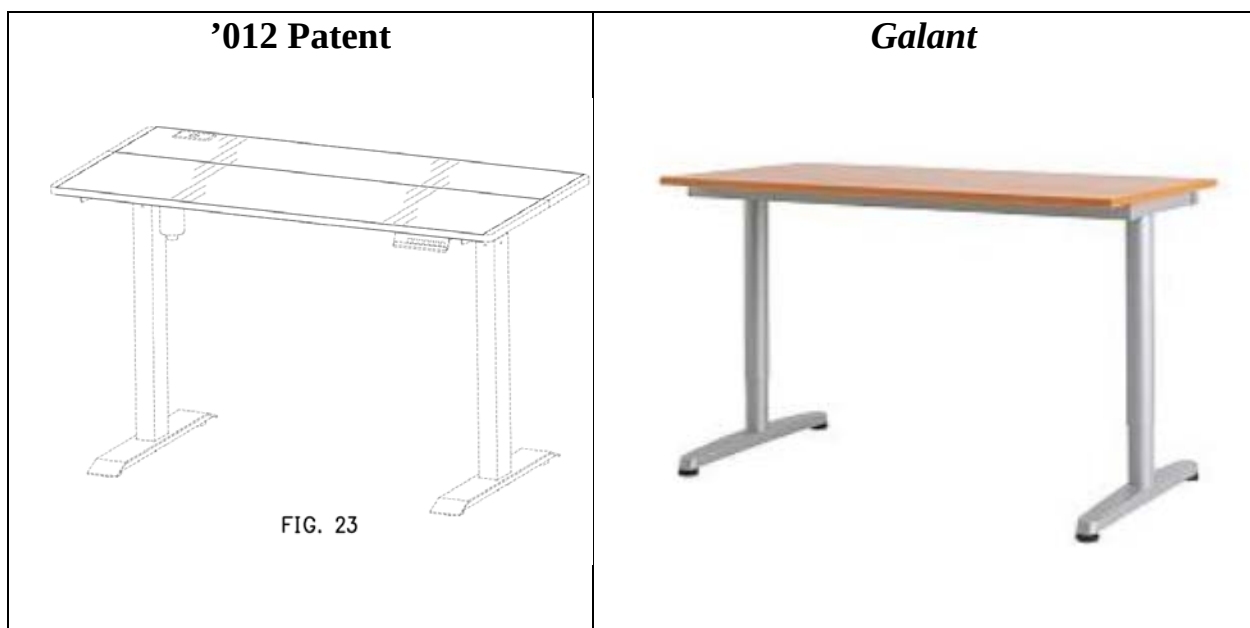
As explained in the previous section, *Iannaccone* is a suitable primary reference under either proposed construction because it has the same design characteristics: that of a tabletop formed of two unequal-width side-by-side boards.

To the extent Patent Owner argues that the overall proportions (length/width) of the tabletop differ between *Iannaccone* and the claimed design, Petitioner submits (*see* previous section) that the claimed design is obvious without reference to a secondary reference. Petitioner also maintains that a mere variation

of the tabletop size is not patentable because it is entirely functional in nature.

Monoflo, 5 F.3d 1505; *Door-Master*, 256 F.3d at 1312.

Regardless, *Galant* renders obvious a tabletop with proportions identical to the claimed design. As shown below, *Galant* discloses a rectangular tabletop. *Galant* explains that the tabletop has a length of 120cm and a width of 60cm. In other words, *Galant* discloses a tabletop twice as long as it is wide.



Galant's tabletop has same length/width proportion disclosed in the claimed design. See '012 patent, Fig. 17 (showing a tabletop that is approximately twice as long as it is wide). In fact, *Galant* is *literally identical* to the claimed design in all respects except for the seam in the table that separates the two planks. Hatch at ¶ 133. Thus, to the extent patent owner argues that *Iannaccone* does not render the claimed design obvious (see previous section) because *Iannaccone* has a tabletop

with a different length/width, it would have been obvious to implement a tabletop that is twice as long as it is wide in view of *Galant*.

A designer of ordinary skill would have found it obvious to vary the length and width of the table designs in *Iannaccone* in view of *Galant* at least because it was a tabletop size offered by *Ikea*, a popular, well-known furniture provider. Hatch at ¶ 134. At a minimum, such a tabletop proportion would have been obvious to try. *Id.* Designing the tabletop to have a length/width proportion that matched another tabletop was a simple design choice that involved no more than a substitution of one known element for another (i.e., substituting one tabletop size for another). Implementing *Iannaccone* with a tabletop having the dimensions of *Galant* would have beneficially permitted the table to be used as a desk, as was the case in *Galant*, while beneficially maintaining the versatility of a folding table. This would have brought the benefits of *Iannaccone* (space saving and the ability to fold) to tables having the dimensions of *Galant*.

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). Indeed, there is nothing unpredictable or nonobvious about designing a table to be longer or shorter to allow for more or less workspace on the tabletop. Hatch at ¶ 135.

The *Galant* tabletop is “so related to the primary reference” as to suggest the application of its dimensions to *Iannaccone*. Both references relate to tabletops and features from one, whether ornamental or not, would have been readily applicable to the other by a designer of ordinary skill.

The resulting tabletop would continue to have the two unequal-width planks disclosed in *Iannaccone*, which falls under both Patent Owner’s and Petitioner’s construction. The planks would have been appropriately dimensioned to form an overall tabletop twice as long as it is wide according to *Galant*’s overall tabletop dimensions. The resulting tabletop would be identical to the claimed design because it would include two unequal-width planks forming a tabletop with the same overall proportions as the claimed designs.

To the extent Patent owner alleges there are any other differences when compared to the claimed design, *Iannaccone* and *Galant* readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”).

For example, the relative proportion between the planks in *Iannaccone* is already similar to that of the claimed design. Therefore, there is no substantial difference in that regard between *Iannaccone* and the claimed design. Hatch at ¶¶ 138, 120-26. Nonetheless, to the extent there is a substantial difference, any

difference in the proportioning of the unequal-width planks is readily suggested by *Iannaccone*, which shows the wider portion of the tabletop folded down in Fig. 7. A designer of ordinary skill would have readily understood that the width of the wider plank determines how much of the table is folded down and how much remains in the unfolded position. Accordingly, an ordinary designer would have understood that the folded-down portion could be *trivially* designed to be wider or narrower depending on the desired balance between (1) space saving and (2) usability of the table in its folded state. Hatch at ¶¶ 138, 120-26.

For example, with a wider fold-down section, the table would achieve a very thin profile when not in use with the drawback that the table would be largely unusable when folded down, owing to the small remaining surface area. With a narrower fold-down section, the table would predictably retain more utility when folded down (because less of the table width is folded down and more remains in the un-folded section), with the drawback that the table would occupy more space even when in the folded position. Varying the folded and unfolded area in such a table design borders on the trivial and has been done in the context of drop-leaf tables for 100s of years. Hatch at ¶ 123-25. Accordingly, any such difference Patent Owner may raise in support of its claimed design would have been obvious to an ordinary designer.

X. MANDATORY NOTICES

A. Real Party-in-Interest Under 37 C.F.R. § 42.8(b)(1)

The Petitioners and real parties-in-interest are Hangzhou Taihe Trading Co., Ltd. & Ningbo Likeju Trading Co., Ltd.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

EP has asserted the '012 patent in a case captioned *EP Family Corp. v. Changzhou Win Up Time Tech. Co.*, Case No. 2:22-cv-08192 (C.D. Cal.), which was filed on June 21, 2022. Ex. 1009.

C. Lead and Back-up Counsel Under 37 C.F.R. § 42.8(b)(3)

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P Andrew Riley (Reg. No. 66,290) ariley@meimark.com MEI & MARK LLP 818 18th Street NW, Suite 410 Washington, DC 20006 Tel: 888-860-5678 Fax: 888-706-1173	Lei Mei (Reg. No. 56,913) mei@meimark.com MEI & MARK LLP 818 18th Street NW, Suite 410 Washington, DC 20006 Tel: 888-860-5678 Fax: 888-706-1173 Guang-Yu Zhu (Reg. No. 66,250) gzhu@meimark.com MEI & MARK LLP 818 18th Street NW, Suite 410 Washington, DC 20006 Tel: 888-860-5678 Fax: 888-706-1173

D. Service Information Under 37 C.F.R. § 42.8(b)(4)

Please address all correspondence to lead and back-up counsel at the addresses shown above. Petitioner consents to electronic service by email.

XI. GROUNDS FOR STANDING

Petitioner certifies the '012 patent is available for IPR and that Petitioner is not barred or estopped from requesting IPR of the '012 patent challenging the claims on the grounds in this petition.

XII. CONCLUSION

Petitioner requests IPR and cancellation of claim 1 of the '012 patent because it is unpatentable based on the foregoing grounds.

Date: March 6, 2023

Respectfully submitted,

By: /P. Andrew Riley/
P Andrew Riley
Lead Counsel

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(a)(1)(i), the undersigned hereby certifies that the foregoing PETITION FOR *INTER PARTES* REVIEW OF U.S. DESIGN PATENT NO. D934,012 contains 10,139 words, excluding parts of the Petition exempted under § 42.24(a), as measured by the word-processing system used to prepare this paper.

Date: March 6, 2023

Respectfully submitted,

By: /P. Andrew Riley/
P Andrew Riley
Lead Counsel

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that on March 6, 2023, a copy of the foregoing PETITION FOR *INTER PARTES* REVIEW OF U.S. DESIGN PATENT NO. D934,012 and the associated PETITIONER’S POWER OF ATTORNEY were served by FedEx on the correspondence address of record indicated in the Patent Office’s Patent Center system for U.S. Design Patent No. D934,012:

Wang IP Law Group, P.C.
18645 E. Gale Avenue
Suite 205
Industry, CA
UNITED STATES

Date: March 6, 2023

Respectfully submitted,

By: /P. Andrew Riley/
P Andrew Riley
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