

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HANGZHOU TAIHE TRADING CO., LTD. and
NINGBO LIKEJU TRADING CO., LTD.,

Petitioner,

v.

EP FAMILY CORP.,

Patent Owner.

Case IPR2023-00658
Patent D934,012

**PATENT OWNER'S
PRELIMINARY RESPONSE**

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EXHIBIT LIST

Exhibit No.	Description
2001	Translation of Bordonabe Furniture
2002	Office Action, App. No. 29/693,716 Prosecution History, June 25, 2021
2003	Notice of Cited References, App. No. 29/693,716 Prosecution History, Apr. 21, 2021 and Oct. 1, 2021
2004	U.S. Patent No. 2,755,153 to J. Pucci et al. (the “153 Patent”)
2005	U.S. 2,715,558 to Bell (the “558 Patent”)

I. INTRODUCTION

Petitioners HANGZHOU TAIHE TRADING CO., LTD. and NINGBO LIKEJU TRADING CO., LTD (herein “Hangzhou”) have requested Inter Partes Review and cancellation of the design claimed in US Design Patent D934,012 to Chang (the “’012 Patent”). Patent Owner EP FAMILY CORP. (herein “EP Family”) submits this Preliminary Response to Hangzhou’s Petition outlining EP Family’s arguments against and rejecting Hangzhou’s grounds for cancellation.

Hangzhou’s Petition challenging the ‘012 Patent fails to meet the reasonable likelihood of success standard on any of the asserted grounds. This failure compels denial of Hangzhou’s petition. *See Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 41– 43 (PTAB Jan. 24, 2019) (denying petition where the majority of challenged claims and grounds failed to meet the reasonable likelihood of success standard).

Specifically, none of the references cited by Hangzhou meet the legal requirements to anticipate or make obvious the ‘012 Patent under the applicable legal standard, when applied correctly. Patent owner will show that U.S. Patent No. 476,400 to Morgan et al. (“Morgan”) fails, under the Ordinary Observer Test, to anticipate the ‘012 Patent. Further, Morgan does not provide the visual impression necessary to act as a primary reference in an obviousness analysis for a design patent. Lastly, the Examiner in the ‘012 Patent prosecution cited multiple folding table references, similar to Morgan, failing to cite any of those references as anticipating or making obvious the design in the ‘012 Patent, allowing issuance of the subject patent.

A review of the language of the Bordonabe Furniture (herein “Bordonabe”) reference, see Bordonabe Translation, Ex. 2001, when translated from Spanish to English, clearly shows that Bordonabe discloses a much more complex design, with beveled edges that an ordinary observer,

familiar with the prior art, would not believe was the same as the ‘012 Patent. Further, because of the clear additional design complexities disclosed in the translation, Bordonabe does not create “basically the same visual impression” as the ‘012 Patent and thus cannot operate as a primary reference.

U.S. Patent No. D424,325 to Iannaccone (“Iannaccone”), for the same reasons as Morgan, fails the ordinary observer test for anticipation and to act as a primary reference for an obviousness analysis.

Petitioner has failed to provide a single reference that, under the ordinary observer test, anticipates the ‘012 Patent. Further, none of the cited references meets the legal standard of a primary reference for an obviousness analysis. Without a primary reference, Galant fails to act as an appropriate secondary reference. As none of the cited references have a reasonable likelihood of success to meet the legal requirements for anticipation or obviousness, Hangzhou’s petition should be dismissed and institution of IPR denied.

II. BACKGROUND

EP Family sells its SHW Memory Preset Electric Height Adjustable Standing Desk (“Plaintiff’s Standing Desk”), which incorporates the design protected in the ‘012 Patent, throughout the United States through various online retail websites including Amazon. The popularity of Plaintiff’s Standing Desk has led to Plaintiff receiving an abundance of positive reviews for the product, and the design of Plaintiff’s Standing Desk has become known throughout the United States. Because Plaintiff’s Standing Desk has become so popular and recognized by consumers, the design of Plaintiff’s product has been subject to widespread infringement by various parties, including Petitioners.

To combat this blatant infringement, Patent Owner EP Family filed suit under 35 U.S.C. §271 alleging infringement of the ‘012 Patent by various defendants, including Petitioners, in the Central District of California on June 21, 2022. This matter, captioned *EP Family Corp. v. Changzhou Win Up Time Technology Co., Ltd, et al.*, No. 2:22-cv-04242-GW-MAR (C.D. Cal.) has been disclosed as related pursuant to 37 C.F.R. §42.8(b)(2).

EP Family contends that Petitioner brings this IPR in an attempt to avoid their copying and infringement of the designs protected by the validly issued ‘012 Patent. As previously stated, Petitioner has failed to present arguments or present references that provide a reasonable likelihood of success to meet the legal requirements for cancelation in this IPR. For this reason, Patent Owner requests that institution be denied.

III. ‘012 PATENT

Design patent D934,012 titled “Table Top” was filed on June 4, 2019 as Application Number 29/693,716 with Jeff Y. Chang listed as the sole inventor. The design disclosed in the ‘012 Patent relates to the separable table top utilized in EP Family’s standing desk designs. The brief file wrapper for the ‘012 Patent includes an Office Action issued April 4, 2021 issuing a Requirement for Restriction/Election and a Notice of References Cited. The Patent Owner responded to the Requirement for Restriction on June 11, 2021 with an election, amendments to the specification/figures (to remove the embodiments not elected) and arguments to traverse the restriction requirement. On June 25, 2021, the examiner issued an Ex Parte Quayle Action stating that the Requirement for Restriction had been successfully traversed by the Patent Owner’s arguments and that the application was in condition for allowance should the previous amendments to the specification and figures be reversed. See *Office Action, App. No. 29/693,716 Prosecution History, June 25, 2021*, Page 3., Ex. 2002 (herein “Office Action – Traversal”). The

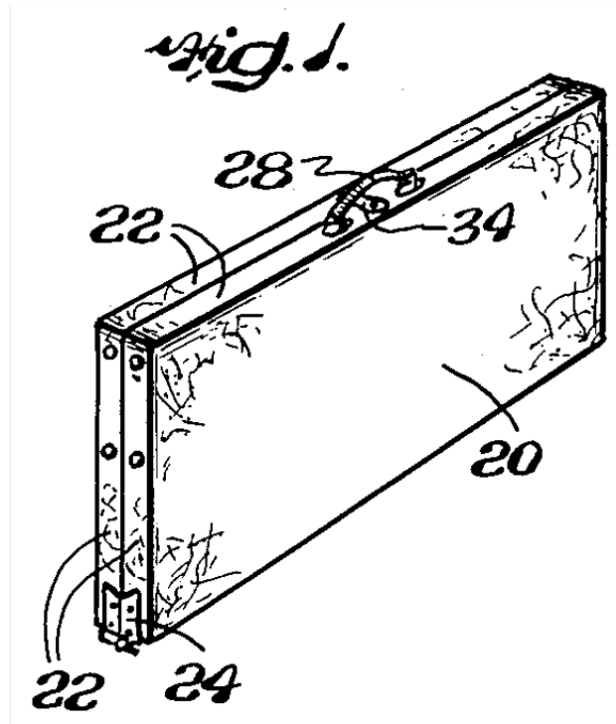
required amendments were made and a notice of allowance issued on September 9, 2021. The examiner made a minor amendment to page three of the Notice of References cited on October 1, 2021, updating the name on the final reference cited. The issue fee was paid and the '012 Patent issued on October 6, 2021.

The '012 Patent issued with 23 figures showing views of the patented design from different perspectives. Each of the 23 figures is necessary to show and describe the ornamental design as claimed. Patent Owner will not reproduce each figure in this section but will include the relevant figures to each argument and reference cited by Petitioner.

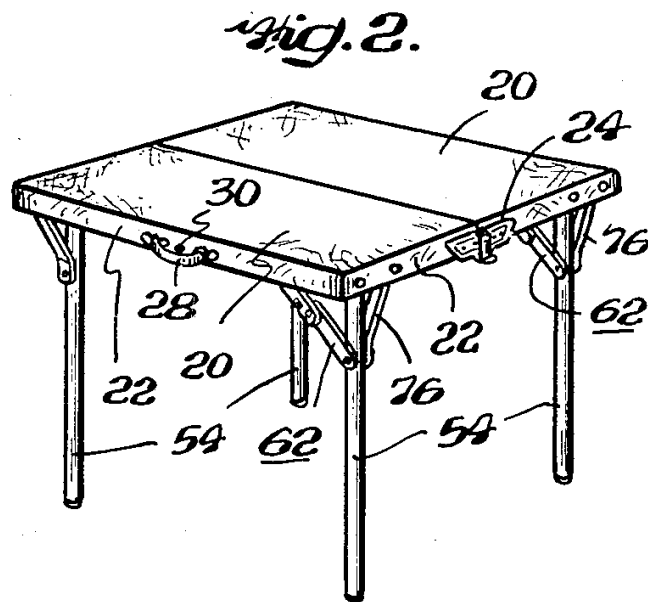
The '012 Patent issued with no substantive rejections under either 35 U.S.C. §102 for anticipation or 35 U.S.C. §103 for obviousness. However, the Notice of References Cited provides insight into the type of references considered by the examiner and rejected as not qualifying as a §102 or §103 reference for the design contained in the '012 Patent. See *Notice of Cited References, App. No. 29/693,716 Prosecution History, Apr. 21, 2021 and Oct. 1, 2021*, Ex. 2003 (herein "Cited References").

A. Cited References

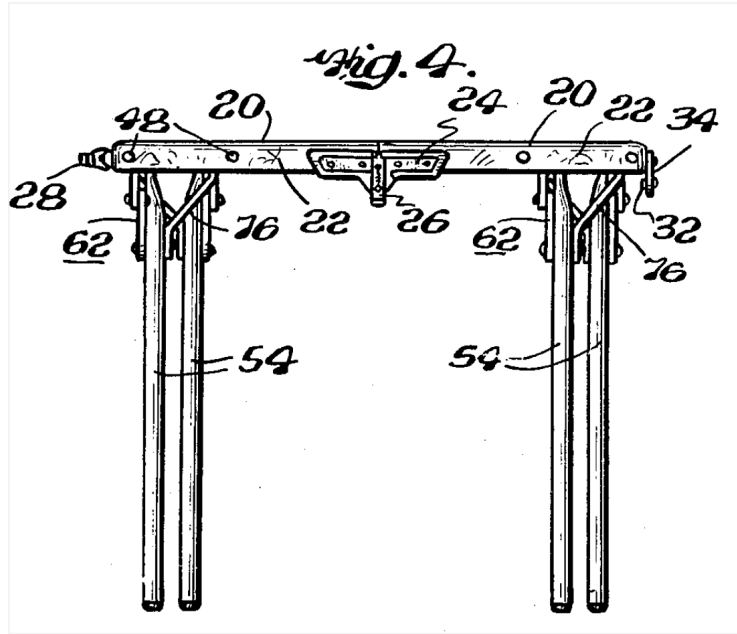
U.S. Patent No. 2,755,153 to J. Pucci et al., Ex. 2004 (the "'153 Patent"), titled "Folding Sectional Top Table" is included on the Notice of Cited References. The '153 Patent discloses a "sectional top folding bridge table" including "a pair of identical top sections 20." See *'153 Patent*, Col. 1, Lines 71-72, Col. 2, line 1, Ex. 2004. "The top sections 20 are connected by a pair of identical hinges 24 so that the top sections can be positioned either in open edge-to-edge coplanar relationship as show in Figs. 2 and 4 or in closed parallel side-by-side relationship as shown in Fig. 1." See *'153 Patent*, Col. 2, lines 3 -7, Figs. 1, 2 and 4. Figs 1, 2 and 4 of the '153 Patent are reproduced below:



'153 Patent, Fig. 1.

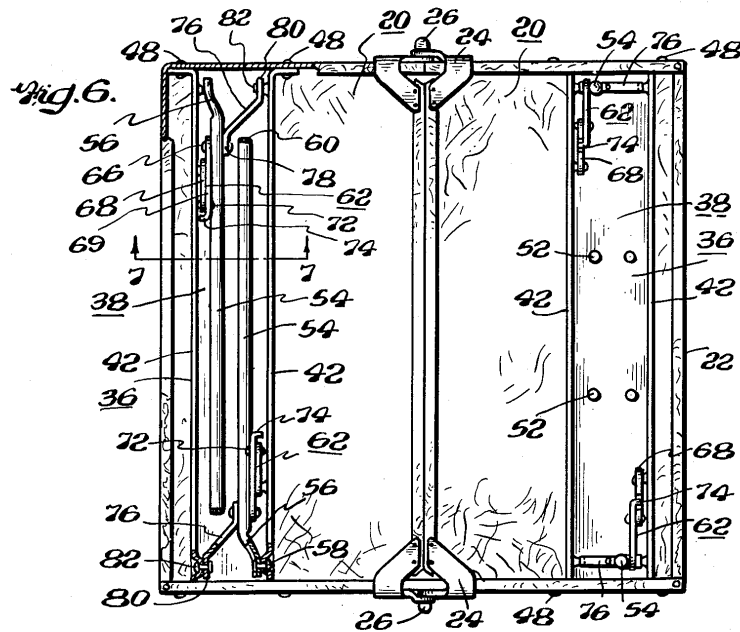


'153 Patent, Fig. 2.



'153 Patent, Fig. 4.

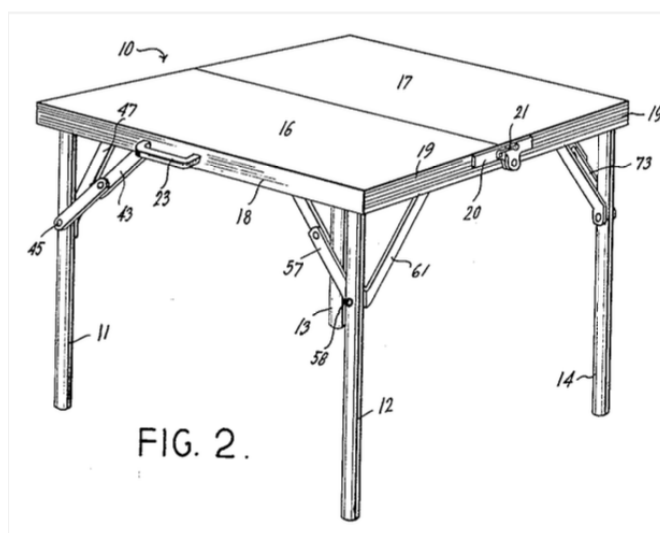
Fig. 6 of the '153 Patent bears a strong resemblance to the figures reproduced from the U.S. Patent No. 476,400 to Morgan et al. ("Morgan") reference cited by Petitioners.



'153 Patent, Fig. 6

U.S. 2,715,558 to Bell, Ex. 2005 (the “’558 Patent”), titled “Folding Sectional Top Table” is also included in the Notice of Cited References. The ‘558 Patent is directed to “foldable or collapsible tables” including those with “at least one pair of legs pivotally connected to a table top and swingable between an operative, depending position and a collapsed position disposed in side by side relation underlying the table top.” See ‘558 Patent, Col. 1, lines 15 – 22, Ex. 2005.

The relevant figures are:



‘558 Patent, Fig. 2.

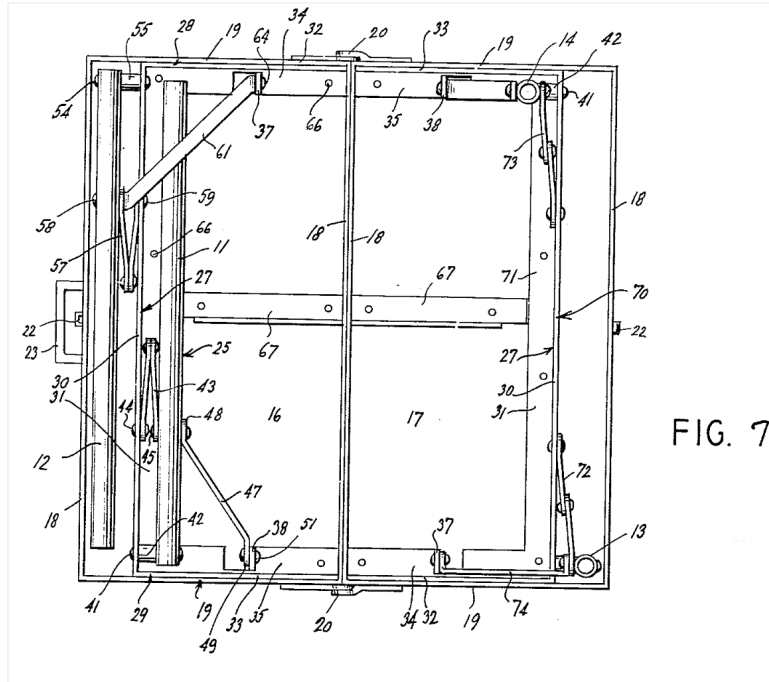


FIG. 7.

'558 Patent, Fig. 7.

Both the '153 Patent and '558 Patent disclose folding tables with rectangular tabletop sections with a break in the approximate center of the table. From the inclusion of these references in the Cited References document provided during examination, it is clear that the examiner considered folding table references, similar to that disclosed in Morgan, and dismissed them as anticipating or making obvious the design contained in the '012 Patent.

IV. CLAIM CONSTRUCTION

Patent Owner has reviewed Petitioner's proposed claim construction and the precedent cited in that section of their petition. Patent Owner agrees that the controlling Federal Circuit precedent related to construction of design patent claims is *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008). However, Patent Owner does not agree that a verbal description of the claimed design is required to construe the claim of the patent. In this case, the 23 figures included in the '012 Patent are sufficient to show the claimed invention. Patent Owner does,

however, agree that a written description of some aspects of the prior art may be necessary to adequately point out the obvious and clear differences between the '012 Patent and the references cited by Petitioner.

Petitioner proposes two alternative claim constructions in their petition, including one construction based on Patent Owner's anticipated construction. Further, Petitioner reserves the right to advocate different constructions at a later point, should this proceeding continue. It is Patent Owner's position that discussion and/or dispute of the proffered constructions at this phase of the proceeding is irrelevant, as Petitioner's petition fails to meet the reasonable likelihood of success standard on any of the asserted grounds, under any claim construction.

Petitioner fails to provide a single reference that would be considered anticipating (under §102) under the ordinary observer test nor any combination of references that would prove obviousness (under §103), under any proffered construction of the '012 Patent claim. For this reason, Patent Owner does not dispute Petitioner's provided claim construction at this stage in the proceeding. However, Patent Owner reserves the right to dispute Petitioner's claim construction as well as to provide and argue an alternate construction in the event institution is granted.

V. LEGAL STANDARDS

A. Anticipation – 35 U.S.C. §102

It is well settled law that the ordinary observer test is the sole test for anticipation of a design patent. *Intern. Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1241 (Fed. Cir. 2009). Under the ordinary observer test, the question is whether an ordinary observer would be deceived into believing that the prior art design is the same as the patented design. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 681 (Fed. Cir. 2008). The central factual question of

this analysis is whether a consumer making a purchase would believe that the prior art design and the patent design are the same. *Id.* The ordinary observer is “not an expert in the claimed designs, but one of ‘ordinary acuteness’ who is a ‘principal purchaser’ of the underlying articles with the claimed designs.” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1337 (Fed. Cir. 2015). Based on the above Federal Circuit precedent, the ordinary observer would be a principal purchaser of tables with an ordinary acuteness. The central question for anticipation is whether such an ordinary observer would be deceived into thinking that any of the prior art references cited are the same as the patented design.

B. Obviousness – 35 U.S.C. §103

The question for design patents 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). The question of fact is whether a prior art reference qualifies as a “primary reference.” *Id.* “A ‘primary reference’ is a ‘single reference that creates ‘basically the same’ visual impression as the claimed design. To be ‘basically the same,’ the designs at issue cannot have ‘substantial differences in the[ir] overall visual appearance[s]’. Additionally, if ‘major modifications’ would be required to make a design look like the claimed design, then the two designs are not ‘basically the same.’” *Id.* (citations omitted)

If a primary reference exists, it is a question of fact whether an ordinary designer would have modified the primary reference with secondary references to create a design that has the same overall visual appearance as the claimed design. *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021) A secondary reference may be used to modify a primary reference to create a design that has the same overall visual appearance as the claimed design. A secondary reference must be so related to the appearance of certain ornamental features in one

reference to suggest the application of those features to the other reference. *MRC Innovations, Inc. v. Hunter MFG., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014).

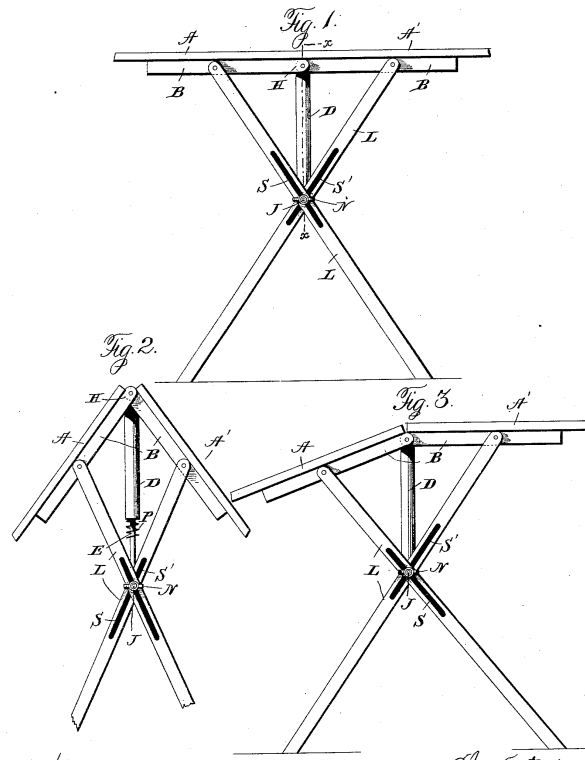
C. Designer of Ordinary Skill

Patent Owner disputes Petitioners characterization of the patented design as rudimentary. In fact, the patent design is the result of substantial and sophisticated design expertise. The commercial success and resultant copying of the product sold under the patent are evidence of the quality of the design. Patent Owner submits that a designer of ordinary skill would have a minimum of 10 years of practical experience designing furniture.

VI. NONE OF THE CITED REFERENCES ANTICIPATE THE ‘012 PATENT OR ARE AN APPROPRIATE PRIMARY REFERENCE FOR THE ‘012 PATENT.

A. Morgan Does not Anticipate the ‘012 Patent.

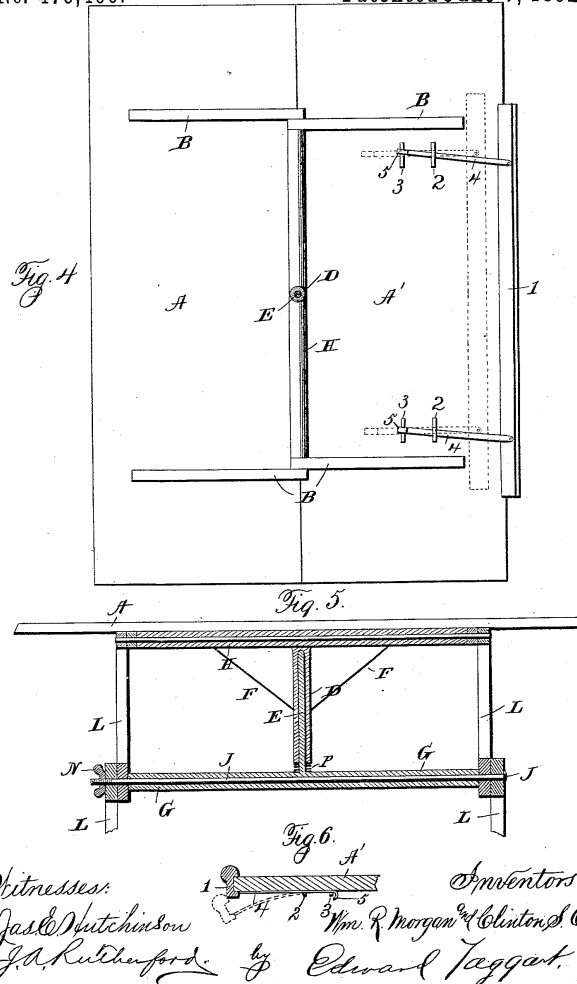
Petitioner argues that U.S. Patent No. 476,400 to Morgan et al. (“*Morgan*”) anticipates the ‘012 Patent under 35 U.S.C. §102. Morgan is titled “Folding Table,” dates from 1892 and includes six figures reproduced here:



Morgan, Figs 1 – 3.

No. 476,400.

Patented June 7, 1892.



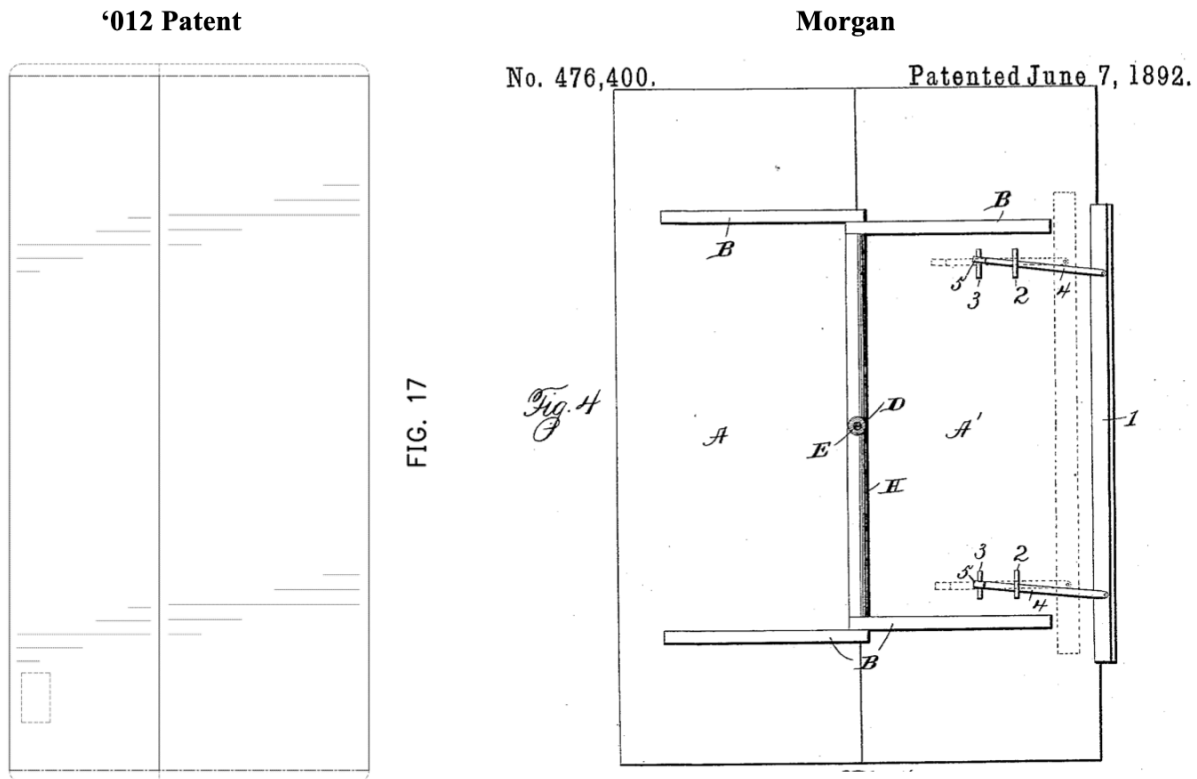
Morgan, Figs. 4 – 6.

Morgan clearly discloses a folding table with two leaves attached to two crossed legs which pivot about a rod attached between the two legs at their crossing point. See *Morgan*, Col. 1, lines 35 – 50. The leaves may be adjusted to form a desk, a drawing table, folded to reduce the amount of space required or adjusted for various other purposes. *Morgan*, Col. 1, lines 9 – 19.

In an attempt to prove that an ordinary observer would be deceived into believing that the Morgan is the same as the '012 Patent, Petitioner compares but one out of 23 figures of the '012 Patent to a single figure of Morgan. The claimed design in the '012 Patent is comprised of the material in all 23 figures and selecting just one figure in an attempt to show Morgan is the same

is not a complete analysis. Further, Morgan contains six figures, each clearly depicting key features of the reference. Patent Owner argues that complete analysis of any similarity between the '012 Patent and Morgan requires a comparison of at least all of the figures of the '012 Patent.

Regardless, a comparison of Figure 17 of the '012 Patent and Figure 4 of Morgan as provided by Petitioner, reveal substantial differences that argue against an ordinary observer being deceived into believing that Morgan is the same as the '012 Patent.



Patent Owner disagrees that the legs shown in Fig. 4 of Morgan should be ignored in the ordinary observer test. Petitioner has provided no legal support for this proposition. While Fig. 17 of the '012 Patent does not show any legs of the claimed table design (other figures do show legs), Fig. 4 of Morgan clearly shows legs and other mechanical features that would not be ignored by the ordinary observer. It would be impossible to expect the ordinary observer, who is merely a regular purchaser of ordinary acuteness to disregard the legs and other mechanical

features of Morgan to conclude that Morgan is the same design as the '012 Patent. Further, conceding that Fig. 4 of Morgan may be the most similar to the '012 Patent, these clear differences result in a clear failure to meet the ordinary observer test.

Morgan clearly discloses a folding table with a variety of potential positions for the leaves. The '012 Patent discloses a separable table top for a standing desk, not a folding table. The '012 Patent does not show any suggested mechanization of the two portions of the table top disclosed in Morgan. This difference alone is enough to prevent an ordinary observer from believing Morgan is the same as the '012 Patent. A comparison of other figures of the '012 Patent and Morgan reach the same conclusion.

Comparing other figures of the '012 Patent and Morgan that show the complete design of also clearly fail the ordinary observer test. Figure 23 of the '012 Patent shows the complete claimed table top design. Figs 1, 2 and 3 of Morgan give a clear view of the features and operation of the disclosed device.

'012 Patent

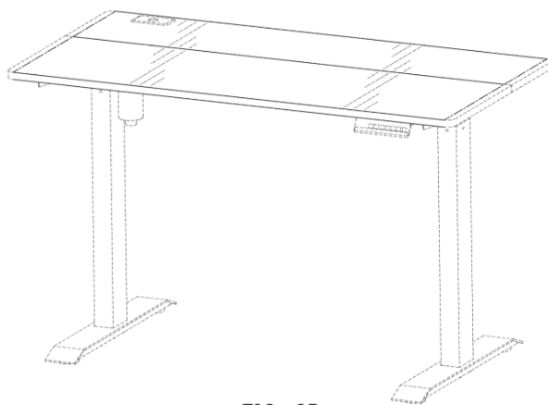
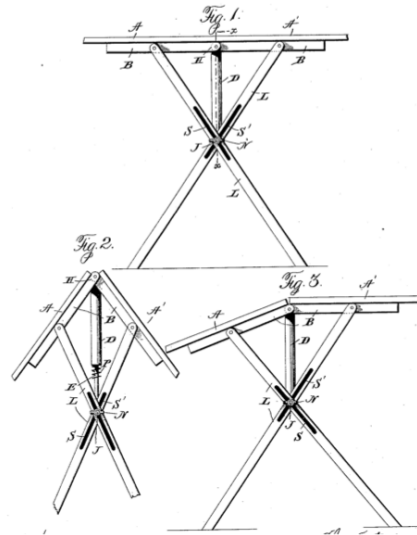


FIG. 23

Morgan



A review of Fig. 23 of the '012 Patent versus Figs 1, 2 and 3 of Morgan reveal the substantial differences between the design claimed in the '012 Patent and the folding table disclosed in Morgan. Morgan shows two legs on each side, crossed in the center. Morgan also discloses a folding mechanism that allows the table to be utilized at a variety of angles. These clear differences between the '012 Patent and Morgan would prevent the ordinary observer from believing these are the same design.

B. Morgan is Not a Primary Reference.

As outlined above, a primary reference is a single reference that creates basically the same visual impression as the claimed design. To be basically the same, the designs at issue cannot have substantial differences in their overall visual appearance. *Spigen Korea Co. v. Ultraproof, Inc.*, 955 F. 3d 1379, 1383 (Fed. Cir. 2020). The differences between the claimed design in the '012 Patent and the device disclosed in Morgan are substantial and prevent Morgan from acting as a Primary Reference.

C. Folding Tables were Reviewed During Examination.

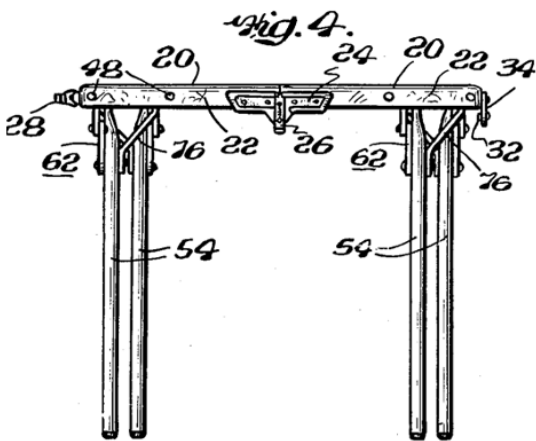
A review of the prosecution history of the '012 Patent shows that the examiner reviewed and dismissed various folding table references as not anticipating or making obvious the design in the '012 Patent. These references are included in the Cited References and outlined in detail above.

Each of these references bear a striking visual similarity to Morgan, very similar titles, and make it clear that the examiner did not believe that folding tables of this type were similar enough to the design in the '012 Patent to trigger a rejection under §102 (anticipation) or §103 (obviousness). A comparison of each of the folding table references included in Cited References highlights the similarity between the considered and merely Cited References and Morgan.

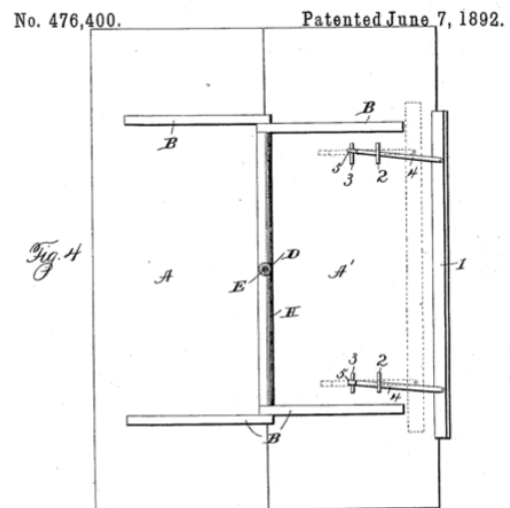
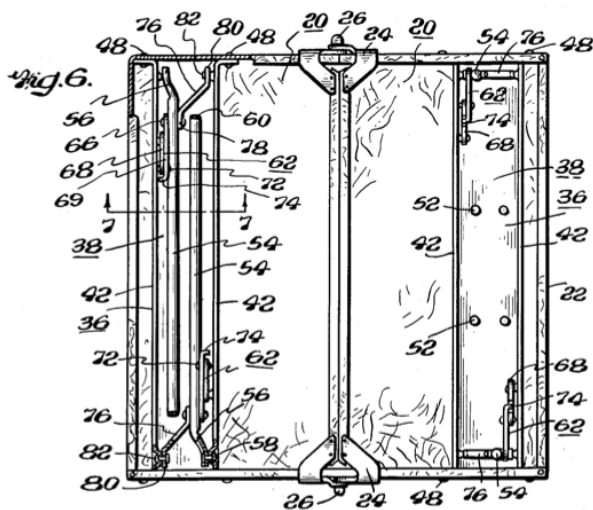
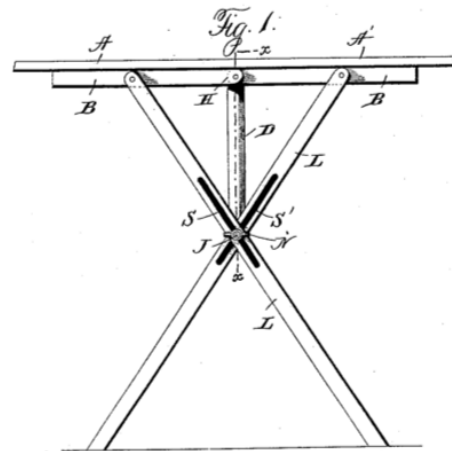
1. The '153 Patent – “Folding Sectional Table” – Compared to Morgan.

A comparison of key figures of the cited '153 Patent to Morgan shows the striking visual and design similarity between the references. Fig. 4 of the '153 Patent compared to Fig. 1 of Morgan shows this similarity. Fig. 6 of the '153 Patent compared to Fig. 4 of Morgan also shows this similarity:

'153 Patent



Morgan



There is clear and unmistakable visual similarity between the '153 Patent and Morgan.

Both the '153 Patent and Morgan are folding tables with a break in the center of the table top.

This break in the table top enables the two table top sections to be folded parallel to each other. Each table top is supported by legs and the underside of the table top includes hardware and mechanics that enable the folding and storage of the table legs.

In addition to the visual similarity, the titles of the ‘153 Patent and Morgan are very similar and have essentially the same meaning. The title of the ‘153 Patent is “Folding Sectional Table” while the title of Morgan is “Folding Table.” Aside from the addition of the word “Sectional” in the ‘153 Patent, these titles are identical and both refer to folding tables. The ‘012 Patent does not disclose, discuss or suggest a folding table.

The examiner considered the ‘153 Patent during examination of the ‘012 Patent and did not issue a rejection based on the ‘153 Patent. These facts, when combined, strongly support the proposition that any folding table, including the folding table disclosed in Morgan, does not anticipate or make obvious the ‘012 Patent.

2. The ‘558 Patent – “Folding Sectional Top Table” – Compared to Morgan

As with the ‘153 Patent, a comparison of the design of the ‘558 Patent to Morgan shows a striking similarity. Comparing Figs. 5 and 7 of the ‘558 Patent to Figs. 1 and 4 of Morgan, respectively, highlights the obvious visual and design similarities.

'558 Patent

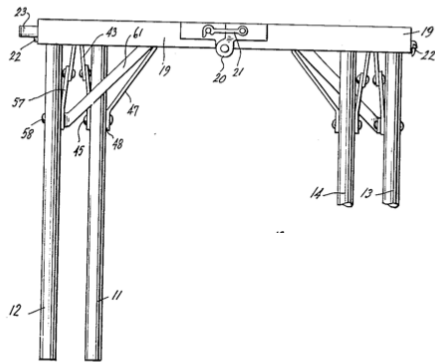
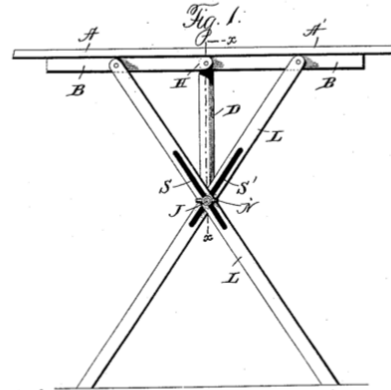


FIG. 5.

Morgan



No. 476,400.

Patented June 7, 1892.

Fig. 4

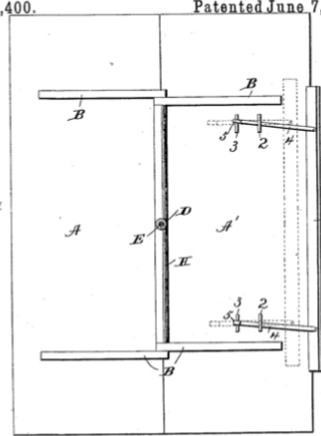


FIG. 7.

Again, the above figures clearly highlight the unmistakable visual similarity between the '558 Patent and Morgan. Both the '558 Patent and Morgan are folding tables with a break between two sections of the table top. This break in the table top enables the two table top sections to be folded parallel to each other. Each table top is supported by legs and the underside of the table top includes hardware and mechanics that enable the folding and storage of the table legs.

The title of the '558 Patent bears a striking similarity to the title of Morgan. The '558 Patent is titled "Folding Sectional Top Table" and Morgan is titled "Folding Table." They share

the common elements of folding table and have essentially identical meaning. The ‘012 Patent does not disclose, discuss or suggest a folding table.

The examiner considered the ‘558 Patent during examination of the ‘012 Patent and did not issue a rejection based on the ‘558 Patent. These facts, when combined, strongly support the proposition that any folding table, including the folding table disclosed in Morgan, does not anticipate or make obvious the ‘012 Patent.

D. Bordonabe Furniture does not Anticipate the ‘012 Patent.

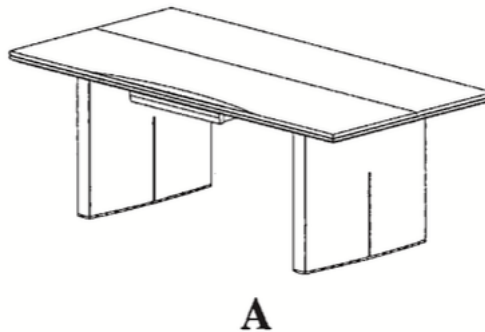
Petitioner argues that various designs contained in the Bordonabe Furniture reference, *16 FEBERO 2000, BOLETIN OFICIAL DE LA PROPIEDAD INDUSTRIAL* at 718 – 719, *Petitioner Ex. 1006*, 20 – 21 (“Bordonabe”) anticipate the ‘012 Patent. A careful review of each of these designs, in relation to the translated description for each, clearly show that an ordinary observer would not be deceived into believing each design is the same as the ‘012 and thus each design fails to anticipate the ‘012 Patent.

Bordonabe is a 459 page Spanish language reference containing a variety of designs for many types of products. Petitioner cites four table designs contained in Bordonabe as anticipating the ‘012 Patent: A, B, C, and E. See *16 FEBERO 2000, BOLETIN OFICIAL DE LA PROPIEDAD INDUSTRIAL* at 718 – 719, *Petitioner Ex. 1006*, 20 – 21. Each of the cited designs includes a single drawing and a block of descriptive text. In the original reference, the descriptive text is in Spanish. In their arguments, Petitioner fails to consider this descriptive text or provide a translation. Consideration of only the single drawing associated with the Bordonabe designs, without the associated descriptions, provides, at best, a misleading picture of what is disclosed by this reference.

Review of the Bordonabe designs in conjunction with descriptive text translated into English reveals significant and substantial differences between each cited design and the '012 Patent resulting in a very different visual impression. See *Bordonabe* Translation, Ex. 2001. The substantially different visual impressions would lead to an ordinary observer believing each of the Bordonabe designs to be different from the '012 Patent.

1. Bordonabe Design A Compared to the '012 Patent

The below drawing is included with Bordonabe Design A:



Bordonabe at 718.

The translated description outlines the following design features in relation to Design A:

- 1) Thick rectangular legs with a vertical groove on the lower half of the leg;
- 2) Legs inset from the edge of the table top;
- 3) A table top formed of a lower and upper piece;
- 4) The lower and upper piece forming a beveled recess, extending along the major axis between them;
- 5) An arched edge on the front edge of the workspace;
- 6) A drawer positioned at the front center of the workspace, with the drawer front angled downward and inward.

Bordonabe Translation, Pg. 1, Ex. 2001.

A comparison of the above design features of Bordonabe Design A and the '012 Patent show many significant differences resulting in a very different visual impression.

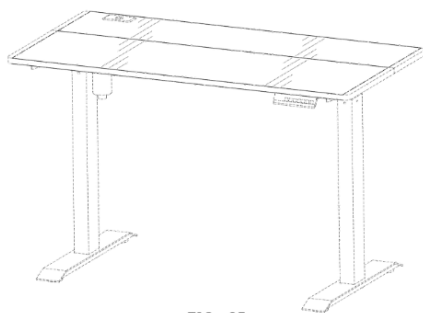
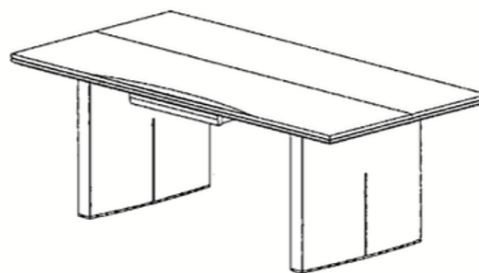
'012 Patent

FIG. 23

Bordonabe Design A**A**

Particularly in relation to the table top, Bordonabe A has: 1) a beveled front edge, 2) a recessed and beveled cut line between the lower and upper pieces and 3) an arched edge around the front. The table top disclosed in '012 Patent does not show any of these design features. Bordonabe Design A also includes a drawer under the workspace with an angled drawer front and thick, rectangular legs that include a vertical groove on their lower half. Again, the '012 Patent does not disclose any of these additional design features shown in Bordonabe Design A.

Bordonabe Design A discloses a single drawing shown from just one angle. While views from other angles are not available in the reference, one could imagine that a view from other angles such as a view of the top of the table top might further highlight the design differences between Bordonabe Design A and the '012 Patent. Viewed from the top, the design differences in Bordonabe Design A and the '012 Patent would likely be much more apparent to the ordinary observer. Specifically, one might expect the beveled front edge, the recessed and beveled cut line between the lower and upper pieces and the arched edge around the front to be even more visible and pronounced. If this top view was compared to the top view of design disclosed the '012 Patent, an ordinary observer would not believe that Bordonabe Design A is the same design as shown in the '012 Patent.

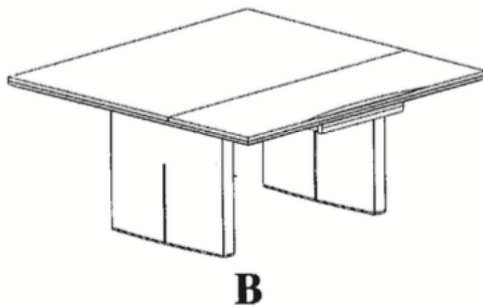
Similarly, a side view of Bordonabe Design A would show the arched and beveled edges more clearly. A comparison of this side view of Bordonabe Design A, if available, with the side views provided in the '012 Patent would further highlight the clear design differences in prevent an ordinary observer from believing these are the same design.

The single drawing and description for Bordonabe A Design does not disclose or suggest that the referenced table top is separable. In contrast, the table top disclosed in the '012 Patent is separable. When EP Family clarified this separability to the Examiner during prosecution, the Examiner withdrew a previously issued restriction requirement. See *Office Action – Traversal*, Page 3, Ex. 2003.

The clear and numerous design differences between Bordonabe Design A and the '012 Patent would make it impossible for an ordinary observer to be deceived into thinking Bordonabe Design A is the same as the design shown in the '012 Patent.

2. Bordonabe Design B Compared to the '012 Patent.

The below drawing is included with Bordonabe Design B:



Bordonabe at 718.

The translated description outlines the following design features in relation to Design B:

- 1) Thick rectangular legs with a vertical groove on the lower half of the leg;

- 2) Legs inset from the edge of the table top;
- 3) A table top formed of a lower and upper piece;
- 4) The lower and upper piece forming a beveled recess, extending along the major axis between them;
- 5) An arched edge on the front edge of the workspace;
- 6) A drawer positioned at the front center of the workspace, with the drawer front angle downward and inward.

Bordonabe Translation, Pg. 1, Ex. 2001.

A comparison of the above design features of Bordonabe Design B and the '012 Patent show many significant differences resulting in a very different visual impression.

'012 Patent

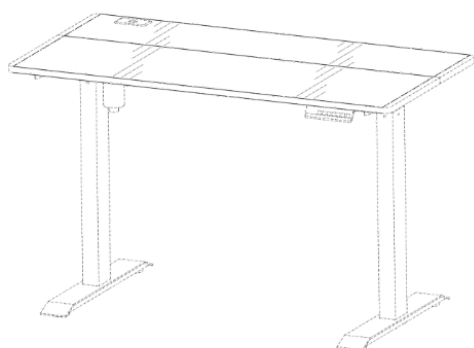
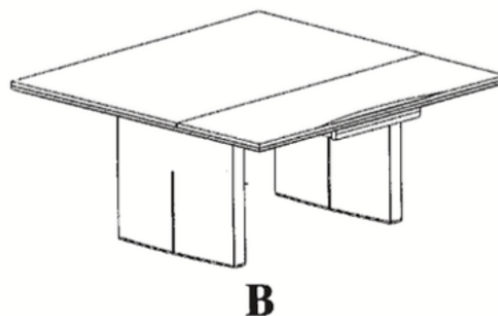


FIG. 23

Bordonabe Design B



B

Bordonabe Design B is very similar to Bordonabe Design A in design, aside from a difference in the width of the upper and lower pieces of the table top. Bordonabe Design B has the following differences in table top design: 1) a beveled front edge, 2) a recessed and beveled cut line between the lower and upper pieces and 3) an arched edge around the front. The table top disclosed in '012 Patent does not show any of these design features. As with Bordonabe Design A, Bordonabe Design B also includes a drawer under the workspace with an angled drawer front

and thick, rectangular legs that include a vertical groove on their lower half. Again, the ‘012 Patent does not disclose any of these additional design features shown in Bordonabe Design B.

Bordonabe Design B also discloses a single drawing shown from just one angle. While views from other angles are not available in the reference, one could imagine that a view from other angles such as a view of the top of the table top might further highlight the design differences between Bordonabe Design B and the ‘012 Patent. Viewed from the top, the design differences in Bordonabe Design B and the ‘012 Patent would likely be much more apparent to the ordinary observer. Specifically, one might expect the beveled front edge, the recessed and beveled cut line between the lower and upper pieces and the arched edge around the front to be even more visible and pronounced. If this top view was compared to the top view of design disclosed the ‘012 Patent, an ordinary observer would not believe that Bordonabe Design B is the same design as shown in the ‘012 Patent.

Similarly, a side view of Bordonabe Design B would show the arched and beveled edges more clearly. A comparison of this side view of Bordonabe Design B, if available, with the side views provided in the ‘012 Patent would further highlight the clear design differences in prevent an ordinary observer from believing these are the same design.

The single drawing and description for Bordonabe Design B does not disclose or suggest that the referenced table top is separable. In contrast, the table top disclosed in the ‘012 Patent is separable. When EP Family clarified this separability to the Examiner during prosecution, the Examiner withdrew a previously issued restriction requirement. See *Office Action – Traversal*, Page 3, Ex. 2003.

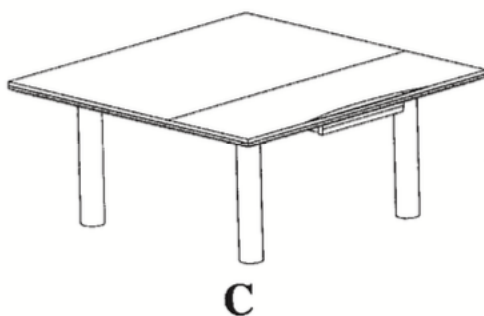
The application of the ordinary observer legal standard to the factual differences between Bordonabe Design B and the ‘012 Patent results in the same outcome as with Bordonabe Design

A. Due to the numerous and significant differences in design, an ordinary observer would not be deceived into thinking Bordonabe Design B is the same as the design shown in the '012 Patent.

Thus, Bordonabe Design B does not anticipate the '012 Patent.

3. Bordonabe Design C Compared to the '012 Patent.

The below drawing is included with Bordonabe Design C:



Bordonabe at 719.

The translated description outlines the following design features in relation to Design C:

- 1) Four cylindrical legs;
- 2) The legs inset from the edge of the table top;
- 3) A table top formed of a lower and upper piece;
- 4) The lower and upper piece forming a beveled recess, extending along the major axis between them;
- 5) An arched edge on the front edge of the workspace;
- 6) A drawer positioned at the front center of the workspace, with the drawer front angle downward and inward.

Bordonabe Translation, Pg. 2, Ex. 2001.

A comparison of the above design features of Bordonabe Design C and the '012 Patent show many significant differences resulting in a very different visual impression.

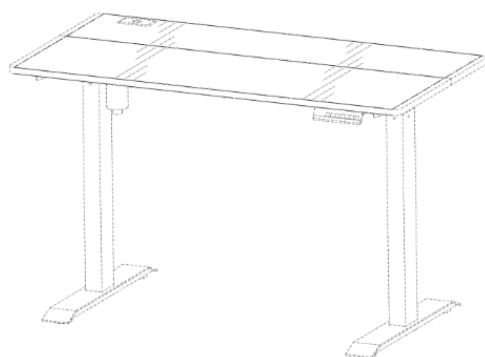
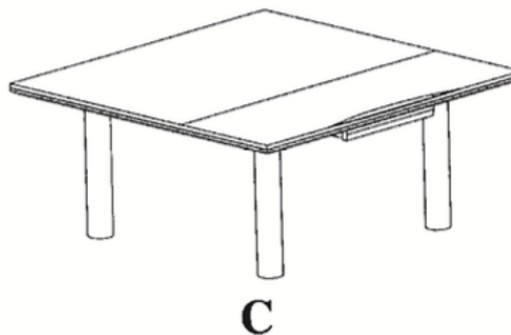
'012 Patent

FIG. 23

Bordonabe Design C**C**

Bordonabe Design C is very similar to Bordonabe Design A and Bordonabe Design B in the design of its table top. The type and shape of the legs of Bordonabe Design C are the main differentiator from Designs A and B. Accordingly, Bordonabe Design C has the following differences in table top design from the '012 Patent: 1) a beveled front edge, 2) a recessed and beveled cut line between the lower and upper pieces and 3) an arched edge around the front. The table top disclosed in '012 Patent does not show any of these design features. As with Bordonabe Designs A and B, Bordonabe Design C also includes a drawer under the workspace with an angled drawer front. Bordonabe Design C includes four cylindrical legs, each inset from the edge of the workspace. Again, '012 Patent does not disclose a drawer. Further, the '012 Patent does not disclose four cylindrical legs inset from the edge of the workspace.

Bordonabe Design C also discloses a single drawing shown from just one angle. While views from other angles are not available in the reference, one could imagine that a view from other angles such as a view of the top of the table top might further highlight the design differences between Bordonabe Design C and the '012 Patent. Viewed from the top, the design differences in Bordonabe Design C and the '012 Patent would likely be much more apparent to

the ordinary observer. Specifically, one might expect the beveled front edge, the recessed and beveled cut line between the lower and upper pieces and the arched edge around the front to be even more visible and pronounced. If this top view was compared to the top view of design disclosed the '012 Patent, an ordinary observer would not believe that Bordonabe Design C is the same design as shown in the '012 Patent.

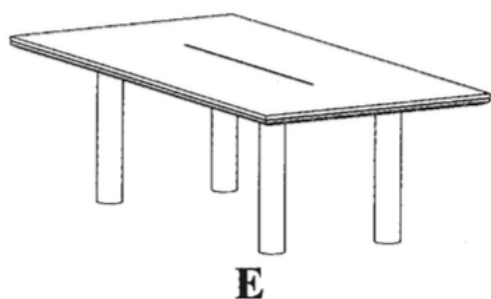
Similarly, a side view of Bordonabe Design C would show the arched and beveled edges more clearly. A comparison of this side view of Bordonabe Design C, if available, with the side views provided in the '012 Patent would further highlight the clear design differences in prevent an ordinary observer from believing these are the same design.

The single drawing and description for Bordonabe Design C does not disclose or suggest that the referenced table top is separable. In contrast, the table top disclosed in the '012 Patent is separable. When EP Family clarified this separability to the Examiner during prosecution, the Examiner withdrew a previously issued restriction requirement. See *Office Action – Traversal*, Page 3, Ex. 2003.

The application of the ordinary observer legal standard to the factual differences between Bordonabe Design C and the '012 Patent results in the same outcome as with Bordonabe Designs A and B. Due to the numerous and significant differences in design, an ordinary observer would not be deceived into thinking Bordonabe Design C is the same as the design shown in the '012 Patent. Thus, Bordonabe Design C does not anticipate the '012 Patent.

4. Bordonabe Design E Compared to the '012 Patent.

The below single drawing is included with Bordonabe Design E:



Bordonabe at 719.

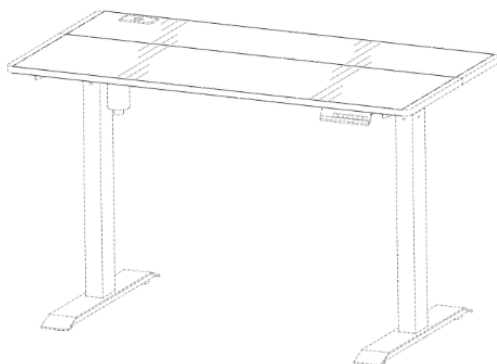
The translated description outlines the following design features in relation to Design E:

- 1) Four cylindrical legs;
- 2) The legs inset from the edge of the table top;
- 3) A table top formed of two superimposed tops;
- 4) The lower being a single piece with a beveled edge;
- 5) The upper having a cut line that does not reach the edge.

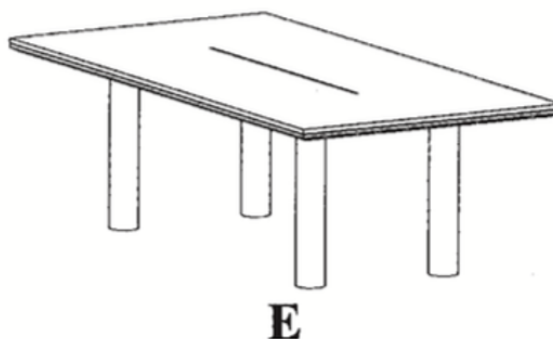
Bordonabe Translation, Pg. 3, Ex. 2001.

A comparison of the above design features of Bordonabe Design E and the '012 Patent show many significant differences resulting in a very different visual impression.

'012 Patent



Bordonabe Design E



Bordonabe Design E has the following differences in table top design from the '012 Patent: 1) a table top comprised of two super imposed pieces, 2) the top piece having a cut line that does not reach the edge and 3) the lower piece with a beveled edge. The table top disclosed in '012 Patent does not show any of these design features. Bordonabe Design E includes four cylindrical legs, each inset from the edge of the workspace. The '012 Patent does not disclose four cylindrical legs inset from the edge of the workspace.

Bordonabe Design E also discloses just a single drawing shown from just one angle. While views from other angles are not available in the reference, one could imagine that a view from other angles such as a view of the top of the table top might further highlight the design differences between Bordonabe Design E and the '012 Patent. Viewed from the top, the design differences in Bordonabe Design E and the '012 Patent would likely be much more apparent to the ordinary observer. Specifically, one might expect the table top comprised of two super imposed pieces, the top piece having a cut line that does not reach the edge and the lower piece with a beveled edge to be even more visible and pronounced. If this top view was compared to the top view of design disclosed the '012 Patent, an ordinary observer would not believe that Bordonabe Design E is the same design as shown in the '012 Patent.

Similarly, a side view of Bordonabe Design E would show the two super imposed pieces and beveled edges more clearly. A comparison of this side view of Bordonabe Design E, if available, with the side views provided in the '012 Patent would further highlight the clear design differences in prevent an ordinary observer from believing these are the same design.

The single drawing and description for Bordonabe Design E does not disclose or suggest that the referenced table top is separable. In contrast, the table top disclosed in the '012 Patent is separable. When EP Family clarified this separability to the Examiner during prosecution, the

Examiner withdrew a previously issued restriction requirement. See *Office Action – Traversal*, Page 3, Ex. 2003.

The application of the ordinary observer legal standard to the factual differences between Bordonabe Design E and the ‘012 Patent results in the same outcome as with Bordonabe Designs A, B and C. Due to the numerous and significant differences in design, an ordinary observer would not be deceived into thinking Bordonabe Design E is the same as the design shown in the ‘012 Patent. Thus, Bordonabe Design E does not anticipate the ‘012 Patent.

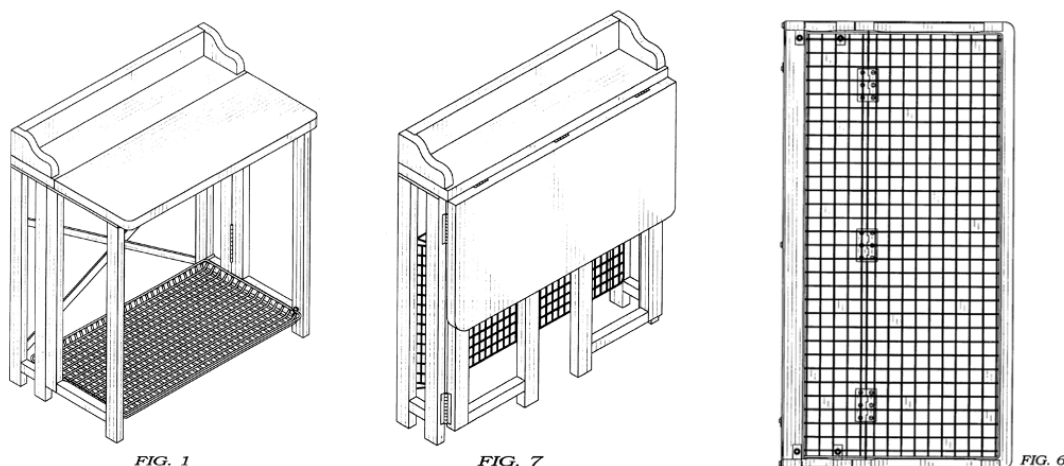
E. Bordonabe Furniture is not a Primary Reference.

A primary reference must create basically the same visual impression as the claimed design, i.e. the designs at issue cannot have substantial differences in their overall visual appearance. If major modifications are required to make a design look like the claimed design, then the two designs are not basically the same. *Spigen Korea Co. v. Ultraproof, Inc.*, 955 F. 3d 1379, 1383 (Fed. Cir. 2020). For the reasons outlined in detail above, there are substantial differences in the overall visual appearance of Bordonabe Designs A, B, C and E and the ‘012 Patent. These designs are not basically the same, as they would require major modifications to make them the same. For the same reasons that each of the Bordonabe designs do not anticipate the ‘012 Patent, the Bordonabe designs cannot be primary references and thus are inappropriate to be utilized in an obviousness analysis for a design patent.

F. Iannaccone Does not Anticipate the ‘012 Patent.

Petitioner argues that U.S. Patent No. D424,325 to Iannaccone (“Iannaccone”) anticipates the ‘012 Patent under 35 U.S.C. §102. Iannaccone is titled “Folding Table” and includes 12 figures. As with Morgan, Petitioner has chosen to present only one figure in their arguments. Other figures shown in Iannaccone disclose very relevant details of the patented design and show

differences that disqualify the reference from use in an anticipation or obviousness analysis. The Iannacone figures reproduced here show: 1) a perspective view of the table in an unfolded state, Iannacone, Fig. 1, 2) a perspective view of the table in a folded state, *Id.* Fig. 7, and 3) a bottom view with the table in an unfolded state, *Id.* Fig. 6.



Iannacone is yet another folding table with obvious design differences from the ‘012 Patent. The ‘012 Patent does not disclose, discuss or suggest a folding table. In addition, a visual inspection of the above figures shows the following clear differences:

- 1) Three short raised sections at the rear of the non-folding panel;
- 2) Two of the raised sections having a curved design along the top;
- 3) A folding section of the table top that folds parallel with the legs;
- 4) Three legs on each side, for a total of six legs;
- 5) Two cross members along the rear side of the table;
- 6) A grid material that is shown at the bottom of the table when unfolded and displayed vertically when folded.

Based on the above enumerated substantial design differences, an ordinary observer would not be deceived into believing that Iannacone is the same design as the ‘012 Patent.

Further, the Examiner reviewed and dismissed two folding table references, very similar to Iannacone in design, function and title, during prosecution of the ‘012 Patent. The cited ‘153 Patent is “Folding Sectional Table” and the cited ‘558 Patent is titled “Folding Sectional Top

Table.” These are nearly identical titles to Iannaccone (“Folding Table”) and have the same essential meaning. Iannaccone is a folding table with the similar design and function to the cited ‘153 and ‘558 Patents.

G. Iannaccone is not a Primary Reference.

Based on the numerous and substantial design differences, listed above, between Iannaccone and the ‘012 Patent it is clear that they do not create the same visual impression.

H. Galant is not a Secondary Reference.

As outlined above, Petitioner has failed to provide a single appropriate primary reference for the ‘012 Patent. Because none of the references cited by Petitioner meet the legal standard for a primary reference, Galant cannot be appropriately combined with any of those references to prove an obviousness argument.

While any argument that Galant is a secondary would be moot in the absence of a primary reference, Patent Owner reserves the right to argue that Galant is not a secondary reference later in this proceeding, if appropriate. Further, Patent Owner points out that Petitioner has compared the entirety of Galant to the ‘012 Patent in their analysis of Galant as a secondary reference. This is the only time Petitioner has taken this position and is contrary to their analysis of Morgan, Bordonabe and Iannaccone.

VII. PETITIONER DOES NOT HAVE A REASONABLE LIKELIHOOD OF SUCCESS ON ANY OF THE ASSERTED GROUNDS.

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

As outlined above, clear differences between the ‘012 Patent and Morgan would prevent the ordinary observer from believing these are the same design. Morgan fails the ordinary observer test and thus does not anticipate the ‘012 Patent.

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

Morgan does not create the same visual impression as the '012 Patent and thus is not an appropriate primary reference for an obviousness analysis. The claim of the '012 Patent is not obvious over Morgan.

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

Morgan is not a primary reference, thus combination with Galant does not result in a finding of obviousness. Patent Owner reserves any arguments that Galant is not an appropriate secondary reference for a later stage of this proceeding.

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

Bordonabe Designs A, B, C, and E each fail the ordinary observer test as outlined above. Thus, none of the Bordonabe designs anticipate the '012 Patent under 35 U.S.C. §102.

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

None of the cited designs in Bordonabe (Designs A, B, C and E) create the same visual impression as the '012 Patent and thus are not appropriate primary references. The '012 is not obvious over Bordonabe.

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

Bordonabe is not a primary reference, thus combination with Galant does not result in a finding of obviousness. Patent Owner reserves any arguments that Galant is not an appropriate secondary reference for a later stage of this proceeding.

G. Ground 7: The Claim is Anticipated by Iannaccone.

Due to significant and substantial design differences between Iannaccone and the ‘012 Patent, Iannaccone fails the ordinary observer test. Iannaccone does not anticipate the ‘012 Patent.

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

Iannaccone does not create the same visual impression as the ‘012 Patent and thus is not an appropriate primary reference for an obviousness analysis. The claim of the ‘012 Patent is not obvious over Iannaccone.

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

Iannaccone is not a primary reference, thus combination with Galant does not result in a finding of obviousness. Patent Owner reserves any arguments that Galant is not an appropriate secondary reference for a later stage of this proceeding.

VIII. CONCLUSION

Hangzhou’s Petition challenging the ‘012 patent fails to meet the reasonable likelihood of success standard on any of the asserted grounds. This failure compels denial of Hangzhou’s petition.

Date: June 5, 2023

Respectfully submitted,

By: /Robert McConnell/
Robert McConnell
Lead Counsel

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(b)(1), the undersigned hereby certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE contains 7,387 words, excluding parts of the Petition exempted under § 42.24(a)(1), as measured by the word-processing system used to prepare this paper.

Date: June 5, 2023

Respectfully submitted,

By: /Robert McConnell/
Robert McConnell
Lead Counsel

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that on June 5, 2023, a copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE were served by email on Lead Counsel for Petitioner at the email address listed below:

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Date: June 5, 2023

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