

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.

IPR2023-00658
Patent D934,012 S

Before JOSIAH C. COCKS, SCOTT A. DANIELS, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Hangzhou Taihe Trading Co., LTD. & Ningbo Likeju Trading Co., LTD. (“Hangzhou” or “Petitioner”) filed a Petition requesting *inter partes* review of the sole claim of U.S. Patent No. D934,012 S (Ex. 1001, “the ’012 patent”). Paper 3 (“Pet.”). EP Family Corp., (“EP” or “Patent Owner”) filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the arguments and evidence presented by Petitioner and Patent Owner, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of the challenged claim. *See* 35 U.S.C. § 314(a). Accordingly, we institute an *inter partes* review of the challenged claim.

A. *Real Parties in Interest*

Petitioner states that it is the real party in interest. Pet. 57. Patent Owner states that it is the real party in interest. Paper 4.

B. *Related Matters*

The parties indicate that the ’012 patent has been asserted against the defendant in *EP Family Corp. v. Changzhou Win Up Time Technology Co., Ltd, et al.*, Case No. 2:22-cv-04242 (C.D. Cal.) (“the infringement action”). Pet. 81; Paper 6.

C. *The ’012 Patent (Ex. 1001)*

Petitioner challenges the design claim in the ’012 patent, issued October 26, 2021, titled “Table Top,” the claim recites “[t]he ornamental design for a table top, as shown and described.” Ex. 1001, [54], [57], Figs.

1–23. Selected drawings illustrating the claim for the ornamental design for the table top are reproduced below:

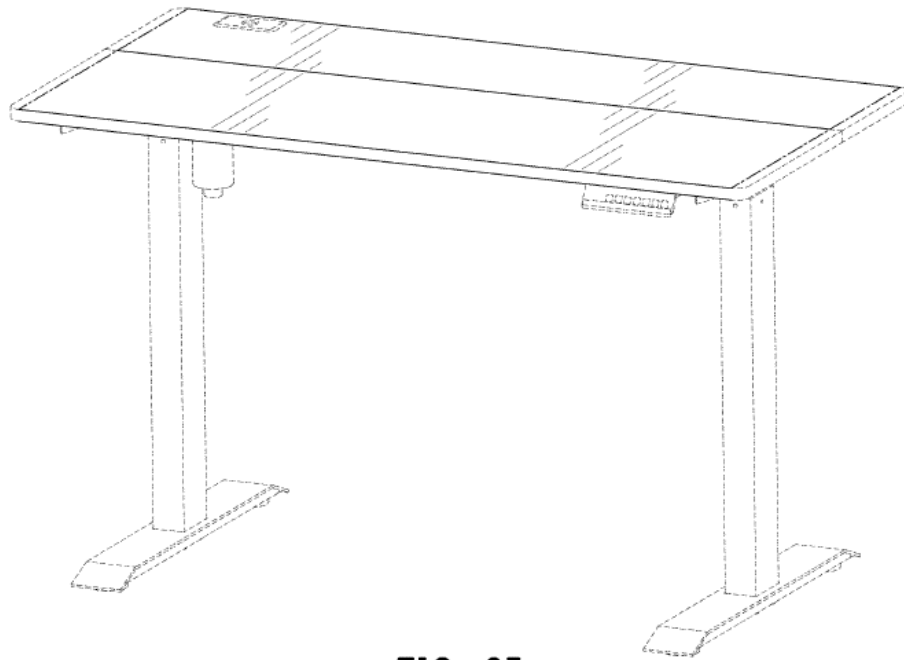


FIG. 23

Figure 23 is a perspective view of the claimed tabletop “shown in an environment of use.” *Id.* at Description.

In addition to the table legs, we point out that both ends of the claimed table top are illustrated by broken lines, as well as dot-dashed broken lines. The ’012 patent describes that “[t]he broken line portions of the table top in FIGS. 1-23 represent portions of the article that form no part of the claim.” *Id.* The ’012 patent further describes that “[t]he dot-dash broken lines in FIGS. 1-3, 8-11[,], 16-18[,], and 23 represent boundary lines and form no part of the claimed design.” *Id.*; see 37 C.F.R. § 1.152; see also MPEP § 1503.02, Subsection III (“Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be

described as forming no part of the claimed design or of a specified embodiment thereof.”).

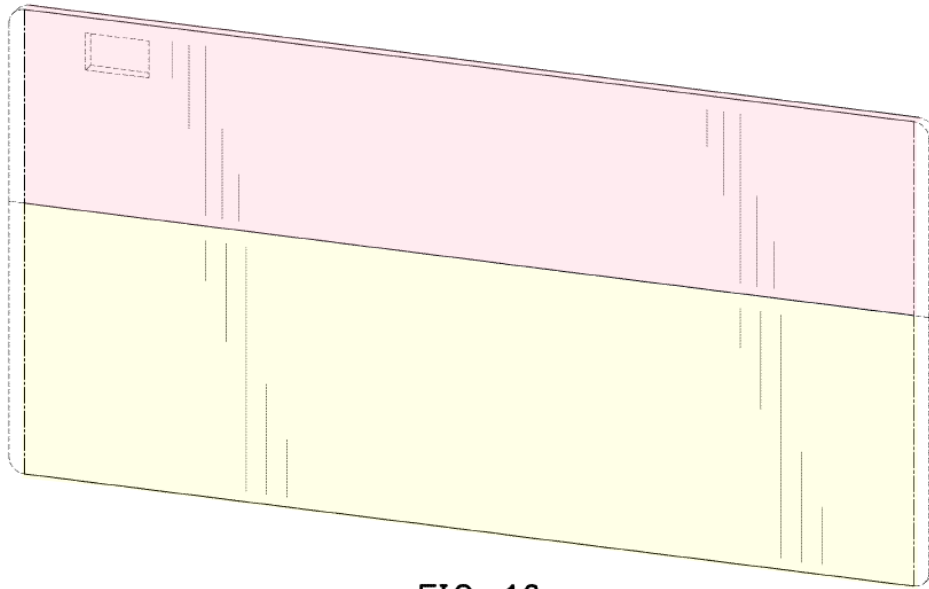


FIG. 16

Figure 16, above, is an annotated perspective view of the claimed table top including a wider portion (yellow) and a narrower portion (pink).¹ *Id.*

¹ The '012 patent refers to the wider portion as the “top portion” and the narrower portion as the “bottom portion” of the claimed table top. Ex. 1001, Description. We will more accurately describe these as the “wider portion” and the “narrower portion” of the table top respectively.



FIG. 17

Figure 17, above, is a front view of the table top illustrating the relative proportions of the wider and narrower portions of the table top as they are joined together. *Id.*

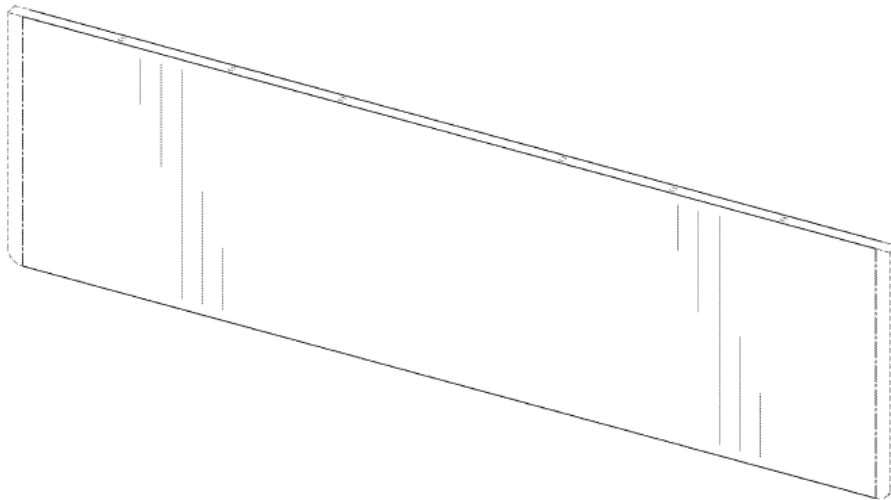


FIG. 1

Figure 1, above, is a perspective view of just the wider portion of the table top. *Id.*

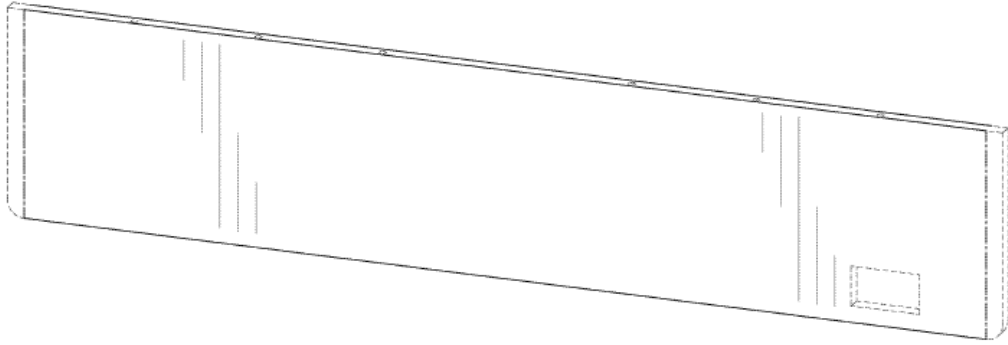


FIG. 9

Figure 9, above, is a perspective view of just the narrower portion of the table top. *Id.*



FIG. 20

Figure 20, above, is an elevation view of an end of the claimed table top where the wider and narrower portions are joined as in Figures 16, 17, and 23.

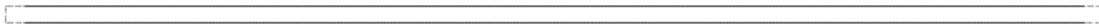


FIG. 21

Figure 21, above, is an elevation view of a side of the claimed table top.

D. Prior Art and Asserted Grounds

Petitioner asserts that the claim would have been unpatentable on the following grounds:²

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1	102 ³	Morgan ⁴
2	1	103	Morgan
3	1	103	Galant, ⁵ Morgan
4	1	102	Bordonabe ⁶
5	1	103	Bordonabe
6	1	103	Galant, Bordonabe
7	1	102	Iannaccone ⁷
8	1	103	Iannaccone
9	1	103	Galant, Iannaccone

II. ANALYSIS

Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375,

² Petitioner supports its challenge with a Declaration by Mr. Paul Hatch. (Ex. 1002). *See infra*.

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Given that the application from which the ’012 patent issued was filed after this date, the current versions of §§ 102 and 103 apply.

⁴ Ex. 1004, U.S. Patent No. 476,400 (iss. June 7, 1892).

⁵ Ex. 1007, IKEA webpage, advertisement, Workspace furniture & accessories | Desks | GALANT table, <https://web.archive.org/web/20050418202119/http://www.ikea.com> (April 18, 2005).

⁶ Ex. 1005, *Boletín Oficial De La Propiedad Industrial*, Spanish Industrial Design No. I14653 to Bordonabe (Pub. Feb. 16, 2000).

⁷ Ex. 1006, U.S. Patent No. D424,325 (iss. May 9, 2000).

1378 (Fed. Cir. 2015). To prevail, Petitioner must establish the facts supporting its challenge by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A. Anticipation

Notably for design patents, the “ordinary observer” test for anticipation is the same test used for infringement. *See Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009) (applying *Egyptian Goddess* holding to the test for anticipation). The ordinary observer test for design patent infringement was first enunciated by the Supreme Court in *Gorham Co. v. White*, 81 U.S. 511 (1871), as follows:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Id. at 528. It is important to keep in mind for designs that the “ordinary observer” is not the same as a person of ordinary skill in the art. The ordinary observer is quite often a consumer, or purchaser, considering a product in the ordinary course of business. *See Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998) (“[T]he focus is on the actual product that is presented for purchase, and the ordinary purchaser of that product.”) In *Egyptian Goddess*, the Federal Circuit explained that the ordinary observer is also a person familiar with the prior art designs. *Egyptian Goddess v. Swiza, Inc.*, 543 F.3d 665, 675–78 (Fed. Cir. 2008).

For purposes of determining anticipation, it is necessary to compare all the ornamental features of the claimed design to the prior art under the

ordinary observer standard. *Int’l Seaway*, 589 F.3d at 1243 (“[T]he ordinary observer test requires consideration of the design as a whole.”) (citation omitted). For purposes of comparison, the question is whether the claimed design and the prior art are substantially the same: “The mandated overall comparison is a comparison taking into account significant differences between the two designs . . . minor differences cannot prevent a finding of anticipation.” *Id.*; see also *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010).

B. Obviousness

In a challenge to a design patent based on obviousness under 35 U.S.C. § 103, the ultimate inquiry is “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). This obviousness inquiry consists of two steps. *Apple*, 678 F.3d at 1329. In the first step, a primary reference (sometimes referred to as a “*Rosen* reference”) must be found, “the design characteristics of which are basically the same as the claimed design.” *Id.* (quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)). This first step is itself a two-part inquiry under which “a court must both ‘(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘basically the same’ visual impression.’” *High Point Design v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311–12 (Fed. Cir. 2013) (quoting *Durling*, 101 F.3d at 103).

In the second step, the primary reference may be modified by secondary references “to create a design that has the same overall visual

appearance as the claimed design.” *Id.* at 1311. However, the “secondary references may only be used to modify the primary reference if they are ‘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.’” *Durling*, 101 F.3d at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

When evaluating prior art references for purposes of determining patentability of ornamental designs, the focus must be on actual appearances and specific design characteristics rather than design concepts. *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993); *see also Apple, Inc.*, 678 F.3d at 1332 (“Rather than looking to the ‘general concept’ of a tablet, the district court should have focused on the distinctive ‘visual appearances’ of the reference and the claimed design.”).

C. The Designer of Ordinary Skill

Petitioner asserts 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.” Pet. 18 (citing Ex. 1002 ¶¶ 33–36). Petitioner adds that “[a] higher level of skill is likely not warranted given the rudimentary nature of using two boards to make a tabletop.” *Id.*

Patent Owner disputes Petitioner’s asserted level of skill and disputes that the table top design is “rudimentary,” arguing that “a designer of ordinary skill would have a minimum of 10 years of practical experience designing furniture.” Prelim. Resp. 15. Patent Owner argues that the claimed table top “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.” *Id.*

Patent Owner does not, on this record, point to specific evidence of copying or quality. *Id.* And, Patent Owner’s contention that the claimed design resulted from “substantial and sophisticated design expertise,” is similarly unsupported by corroborating evidence at this point. We have before us at this point in the proceeding mainly the testimony of Petitioner’s declarant, Mr. Hatch, who testifies that without a bachelor’s degree in furniture design, “a little more than two years of practical design experience . . . is appropriate given the relatively simple nature of the design at issue, which involves little more than two boards forming a tabletop.” Ex. 1002 ¶¶ 34–35.

Based on the present record, we adopt the Petitioner’s articulation of a designer of ordinary skill, which is supported by the testimony of Mr. Hatch. As of yet, Patent Owner has not provided any evidence to rebut Petitioner’s or Mr. Hatch’s assertions. We also note that, under the present record, our analysis of this case would be the same under either party’s definition. The parties are free to address this issue at trial if they so wish.

D. Claim Construction

As the parties appear to agree, it is well-settled that a design is represented better by an illustration than a description. Pet. 9–10; Prelim. Resp. 12–13; *see also Egyptian Goddess*, 543 F.3d at 679 (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although preferably a design patent claim is not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Egyptian Goddess*, 543 F.3d at 679–80; *cf. High Point*

Design LLC v. Buyers Direct, Inc., 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”) (citation omitted).

Petitioner argues that “[t]he scope of the ’012 patent is defined by the solid lines in figures 1-23—as opposed to the broken or dashed lines.”

Pet. 9. Petitioner also argues that “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.” *Id.* at 10. Petitioner’s verbal construction considers that

[a]s 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.

Id. at 11.

Petitioner “construes the claimed design to cover *two rectangular prisms abutted against each other to form a tabletop*” and that it uses the terms “boards” or “planks” interchangeably with “rectangular prisms.”

Pet 12–13. Petitioner then proposes two alternative claim constructions regarding the relative widths of two rectangular boards/planks, the first one of which is based on “Patent Owner’s expected construction” and encompasses, but does not require, table tops where each of the two boards/planks has the same width as the other. Pet. 13–15. Petitioner explains that this first construction is “Patent Owner’s expected construction” based on Patent Owner’s assertions in the copending district court litigation. Pet. 14. Petitioner’s alternative, second construction

requires the two rectangular board/planks to have unequal widths. Petitioner explains that with this construction, the '012 patent would “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.” Pet. 14–15.

Patent Owner argues that no “verbal description of the claimed design is required to construe the claim of the patent.” Prelim. Resp. 12. Patent Owner asserts that the Figures of the '012 patent “are sufficient to show the claimed invention.” *Id.* Patent Owner mainly argues “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.” *Id.* at 13. Patent Owner does not provide an explicit construction, but “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.” *Id.*

At this stage of the proceeding, we agree with Patent Owner that a verbal construction is not necessary to describe the overall ornamental nature of the '012 design as Figures 1–23 clearly show the claimed table top and that the best description of the ornamental features of the '012 design comes from the drawings themselves. For example, Figures 1–23 clearly depict a table top having two rectangular portions/planks having different widths.

Also, Petitioner’s proposed verbal description correctly reiterates the laws and rules relating to patent drafting and the use of broken lines.

37 C.F.R. § 1.152; *see also* MPEP § 1503.02, Subsection III (“Unclaimed

subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used.

Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”).

We determine on the record at this point in the proceeding that the solid lines illustrating the design in Figures 1–23 of the ’012 patent, along with the written description, including that “[t]he broken line portions of the table top in FIGS. 1-23 represent portions of the article that form no part of the claim,” provide an accurate representation and understanding of the claimed table top and that a verbal construction is not necessary. *See Egyptian Goddess*, 543 F.3d at 679 (The Federal Circuit explaining that “it should be clear that the court is not obligated to issue a detailed verbal description of the design if it does not regard verbal elaboration as necessary or helpful.”).

Although we do not undertake a detailed verbal construction, we acknowledge in our following anticipation and obviousness analysis relevant design characteristics of the ’012 design, including key similarities and distinctions relative to the prior art, including further discussion of the relative width of the two portions/planks depicted in Figures 1–23. *See MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1332 (Fed. Cir. 2014) (Affirming that a verbal claim construction was unnecessary, the Federal Circuit explained that “the district court did not err by failing to provide an express verbal description of the claimed design; rather, it described the claimed design in the context of comparing it to the prior art”).

E. Ground 8 – Alleged Obviousness over Iannaccone (Ex. 1006)

On this record, Petitioner has established a reasonable likelihood of prevailing on its assertion that the claim would have been obvious over Iannaccone for the reasons explained below.

1. Iannaccone (Ex. 1006)

Titled “Folding Table,” Iannaccone illustrates “[t]he ornamental design for a folding table, as shown and described.” Ex. 1006, code (54) (57). Iannaccone includes ten figures of the claimed folding table, of which we reproduce Figures 1, 2, 5, and 7 below.

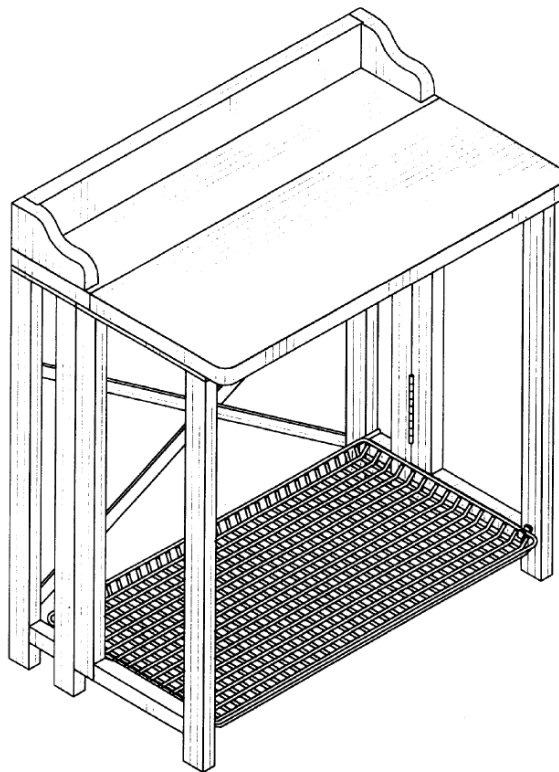


FIG. 1

Iannaccone states that Figure 1 “is a perspective view of the folding table of my design.” *Id.* at Description.

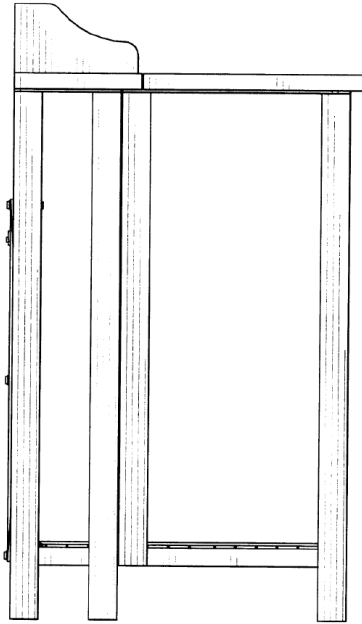
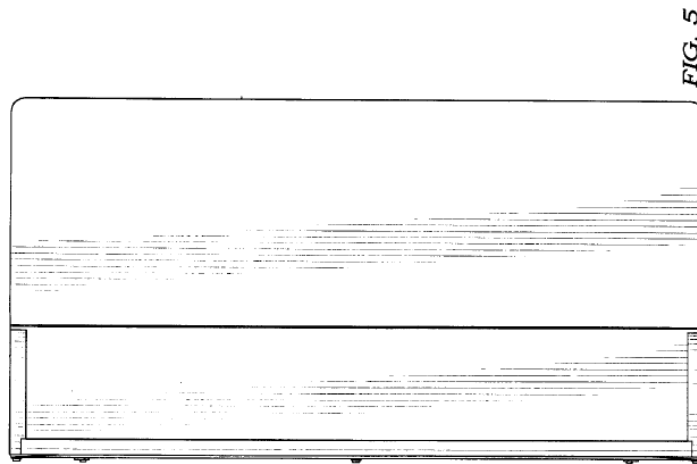


FIG. 2

Iannaccone's Figure 2 "is a right and left side elevation view" of the claimed folding table. *Id.*



Iannaccone describes that Figure 5 "is a top plan view" of the claimed folding table. *Id.*

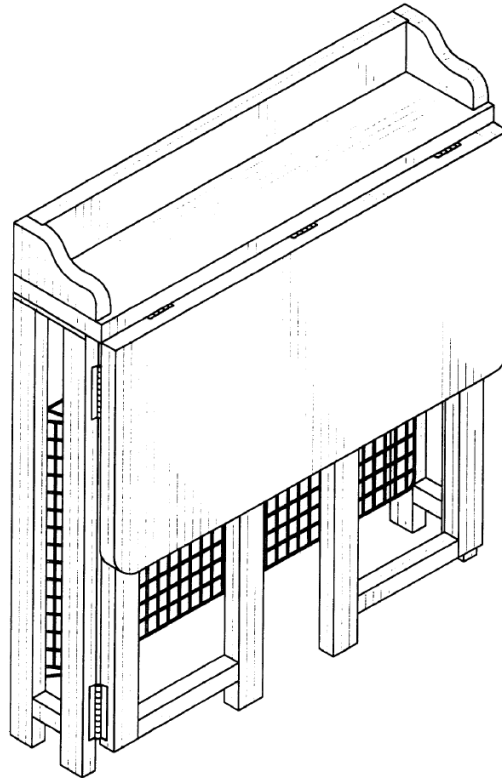
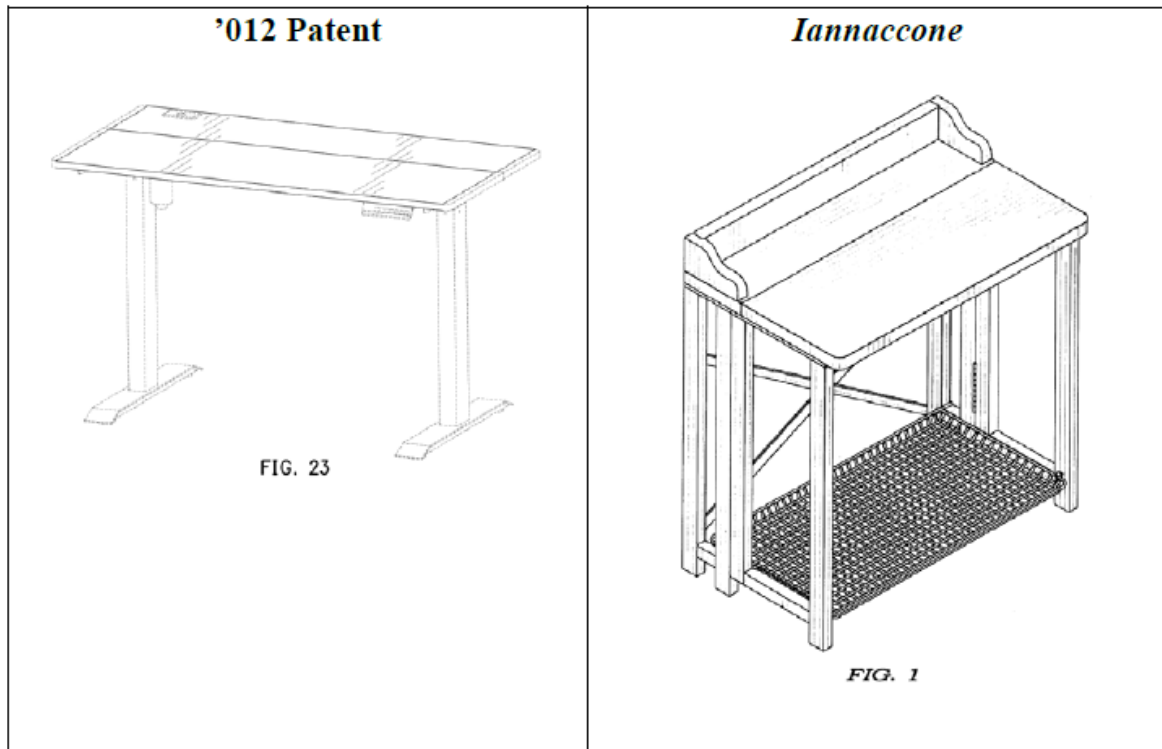


FIG. 7

Iannaccone's Figure 7 "is a perspective view of the folding table of my design, shown in a folded State." *Id.*

2. *Petitioner's Arguments*

Petitioner provides the following comparison, reproduced below, showing Figure 23 of the claimed design side-by-side with Iannaccone's Figure 1.



Petitioner relies on the comparison of Figure 23 of the '012 patent and Figure 1 from Iannaccone above as a basis for its assertion that Iannaccone is a suitable primary reference. Petitioner argues that “*Iannaccone*’s tabletop has the same design claimed in the '012 patent: one consisting of two planks abutted against each other.” Pet. 48. Petitioner argues further that:

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.

Id. Besides being a primary reference for purposes of obviousness, Petitioner contends that “*Iannaccone* is so similar to the claimed design that no secondary reference is necessary.” *Id.*

In support of Petitioner’s arguments, Mr. Hatch testifies that “[t]he tabletops are basically the same, both having unequal-width boards abutted against each other to form the tabletop.” Ex. 1002 ¶ 109. Mr. Hatch explains that

[a]lthough *Iannaccone* is slightly broader in its proportional width, its overall proportions are still in the form of a long rectangle with a clear long and short side. The boards also meet along the long dimension of *Iannaccone*, as is the case in the claimed design. In my opinion, there are at most insignificant differences between *Iannaccone* and the claimed tabletop design. The overall visual impression, that of a rectangular tabletop that is simply made by adjoining two unequal-width rectangular boards, is exactly the same between *Iannaccone* and the ’012 patent.

Id. ¶ 112. Based on a visual comparison, Mr. Hatch testifies further that “I believe *Iannaccone* anticipates the claimed design because an ordinary observer would regard the designs as being the same, regardless of the [claim] construction used. Accordingly, *Iannaccone* would also create the same basic visual impression as the claimed design: i.e., a tabletop formed from two unequal-width boards.” *Id.* ¶ 114.

Mr. Hatch confirms that there is a potential visible difference in the overall proportions between the claimed table top and *Iannaccone*. *Id.* ¶ 116. Addressing this difference, Mr. Hatch testifies that a “possible difference between *Iannaccone* and the claimed design is the proportioning of the unequal-width boards. I don’t see this as a major difference between *Iannaccone* and the claimed design. Both tabletops have a narrower and wider board and the overall proportioning between them is similar.” *Id.* ¶ 119. Mr. Hatch explains further that

the wider board in both cases appears to be less than twice the width of the narrower board. The overall visual impression created by both, without specifically taking out a measuring device and looking for minute differences, is the same—two unequal-width boards with different, but still generally similar widths. It is thus my opinion that there is no substantial difference in proportioning of the board widths between *Iannaccone* and the claimed design.

Id. Mr. Hatch continues, explaining that “even if there was a substantial difference, proportioning the boards in *Iannaccone* differently would have been trivially obvious.” *Id.* ¶ 120. Mr. Hatch testifies that

[a] designer of ordinary skill would have immediately understood (indeed, anyone can understand this) that the width of the wider board determines how much of the table is folded down and how much remains in the unfolded position. Increasing the width of the wider board relative to the narrow board allows the table to occupy less space, while decreasing the width of the wider board relative to the narrow board causes the table to occupy more space when folded down. Changing these proportions and making corresponding changes to the folding structure beneath the table, would have been extremely easy and obvious to an ordinary designer, if not trivial in nature.

Id.

Mr. Hatch also addresses the fact that *Iannaccone* illustrates a “back piece” positioned on top of the narrower width portion of *Iannaccone*’s folding table.⁸ *Id.* ¶ 108. Mr. Hatch explains that “I do not consider this piece when comparing *Iannaccone*’s tabletop to the tabletop in the ’012 patent. This is because the ’012 patent shows only the tabletop in solid lines

⁸ Patent Owner refers to this “back piece” feature as “three short raised sections,” or the “raised sections.” For consistency, we use Patent Owner’s nomenclature in this Decision.

and specifically avoids claiming anything attached to the top, interior, and bottom of the tabletop.” *Id.*

3. *Patent Owner’s Arguments*

Petitioner argues that Iannaccone neither anticipates nor rises to the level of a primary reference for purposes of obviousness. Prelim. Resp. 35. Patent Owner argues specifically that Iannaccone’s figures “show differences that disqualify the reference from use in an anticipation or obviousness analysis.” *Id.* at 35–36. Patent Owner argues that the table top of the ’012 patent is not a folding table as in Iannaccone, and further proposes the following 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.

Id. at 36. Patent Owner argues that “[t]he ‘012 Patent does not disclose, discuss or suggest a folding table . . . the Examiner reviewed and dismissed two folding table references, very similar to Iannaccone in design, function and title, during prosecution of the ‘012 Patent.” *Id.*

Considering the enumerated differences, above, Patent Owner contends that “[b]ased 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.” *Id.* at 37.

4. *Analysis*

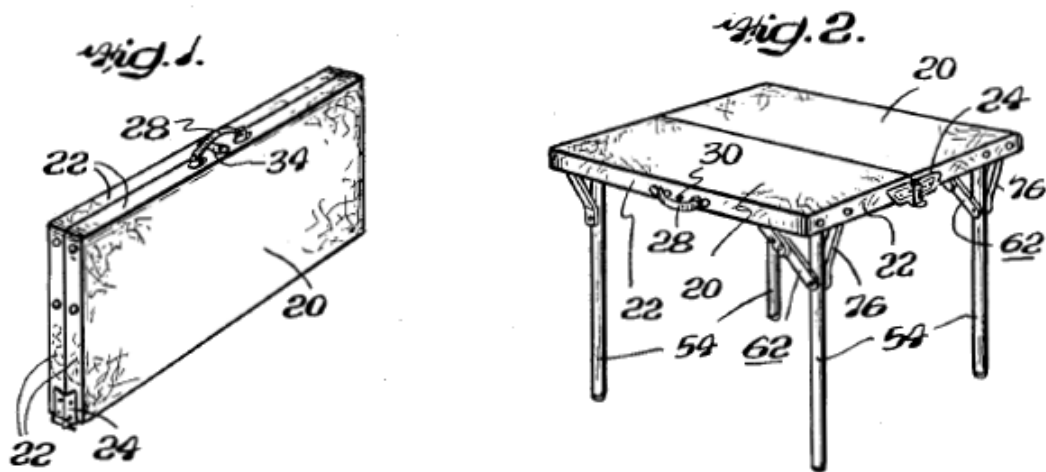
For the reasons below, we find that Petitioner has shown a reasonable likelihood that the claimed table top of the '012 patent would have been obvious in view of Iannaccone.

a) *Whether Folding Tables are Appropriate Prior Art*

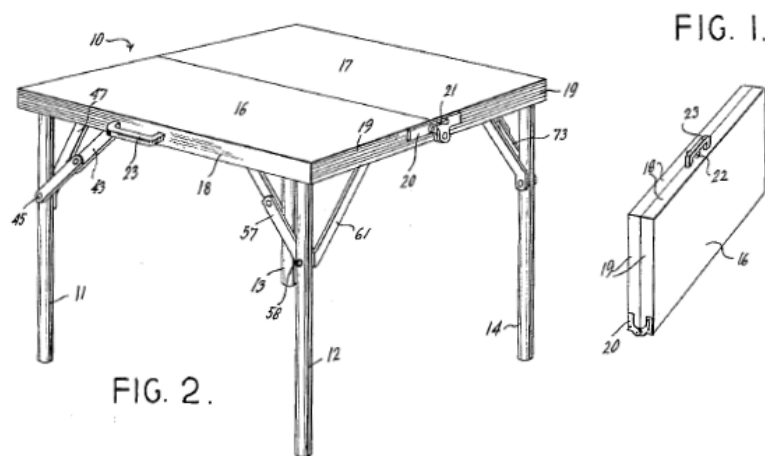
As an initial matter, we address Patent Owner's argument with respect to Iannaccone, (made similarly for another of Petitioner's applied prior art references to Morgan, which we discuss below), that the claimed table top is not a folding table and that "the Examiner reviewed and dismissed two folding table references, very similar to Iannaccone in design, function and title, during prosecution of the '012 Patent." Prelim. Resp. 36; *see also, e.g., id.* at 20–24 (discussing the Examiner's review of folding table references during prosecution of the '012 patent).

On the record before us, Patent Owner has shown only that the cited references to U.S. Patent No. 2,755,153 ("the '153 patent"), and U.S. Patent No. 2,715,558 ("the '558 patent"), directed to folding tables, were cited on an IDS during prosecution. Patent Owner argues that these references listed on the IDS "strongly support the proposition that any folding table, including the folding table disclosed in Morgan [and Iannaccone], does not anticipate or make obvious the '012 Patent." *Id.* at 24. Patent Owner's assertion, however, is only a guess. Considering the Office Action from June 25, 25, 2021, the Examiner never stated or expressly acquiesced that folding tables were not appropriate prior art, nor explained in any manner *why* these references were not applied in a rejection. Ex. 2002. It is just as possible that the '153 patent and the '558 patent were not applied by the Examiner because they disclose two equal width table top portions, whereas

the '012 patent claims a table top composed of two portions having different widths. Relevant figures from the '153 and '558 patent are reproduced below.



Figures 1 and 2 from the '153 patent illustrate a folding table top composed of equal width halves.



Figures 1 and 2 from the '558 patent illustrate a folding table top composed of equal width halves.

In addition, on this record, Patent Owner has not explained how the functional aspect of a folding table is relevant to an ornamental design for a table top or why the folding characteristics of a table should be considered in a design patent analysis by the Examiner or the Board. To the extent Patent

Owner argues that a folding table is substantially different from the claimed design or that a folding table cannot create basically the same visual impression as the claimed design, such an argument is undeveloped and not persuasive at this stage of the proceeding. *See, e.g.*, Prelim. Resp. 20–22 (stating the Examiner’s failure to issue a rejection based on folding table prior art “strongly supports the proposition that any folding table . . . does not anticipate or make obvious the ’012 patent), 36–37 (asserting an ordinary observer would not be deceived into believing that Iannaccone is the same design as the ’012 design because, *inter alia*, Iannaccone has a folding section that folds parallel with the legs); *id.* at 37 (asserting Iannaccone is not a primary reference because the “numerous and substantial design differences . . . do not create the same visual impression”). Notably, the ’012 patent is directed to “an ornamental design for a table top” including two differing width portions; such a table top could, conceivably, be directed to a folding table top or to a table top that otherwise has its component portions joined and abutted with one another. We appreciate that the drawings in the ’012 patent, for example Figures 1, 6, 8, and 9 show a series of holes and tenons ostensibly for joining the wider and narrower portions of the tabletop. These holes and tenons are, however, drawn in broken lines and “form no part of the claim” or “the claimed design.” Ex. 1001, Description. Thus, based on the present record, the ’012 patent claims a table top composed of two different width portions without claiming *how* the portions are joined or abutted.

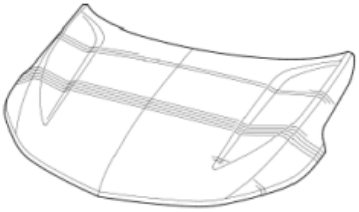
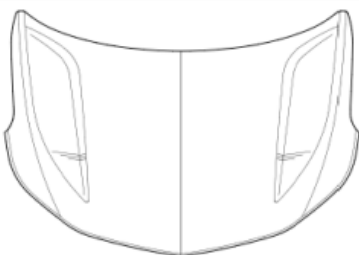
For the foregoing reasons, based on the record before us, including our review of the prosecution history of the ’012 patent, we are not persuaded that a prior art folding table is incapable of being either or both an

anticipatory and obviousness reference with respect to the '012 patent. However, the parties are invited to address this issue at trial if they so choose.

b) Patent Owner's Asserted Six "Clear Differences"

We now turn to Patent Owner's asserted six "clear differences" between the claimed table top and Iannaccone. These asserted differences raise an interesting issue with respect to design patentability analysis. The issue is whether, by *not claiming* features of a table, such as table legs, the claim for "a table top" can avoid potential anticipation and obviousness references by asserting that the prior art references have these features and are therefore different. This issue may be easier to explain with an example. Patent Owner's asserted clear difference 4) is that Iannaccone illustrates "[t]hree legs on each side, for a total of six legs." We agree that Iannaccone illustrates six legs. Ex. 1006, Fig. 1. But the '012 patent does not claim a table, or table legs, just "a table top." Ex. 1001, code (54). The only table legs in the '012 patent are drawn in broken lines and unclaimed. If differences from the prior art could be asserted by reducing a claim to an essentially disembodied minimal feature of the article of manufacture, here a *table top* to prevent the use of a prior art *table* as a potential prior art reference, then seemingly, the only references that could ever be a valid anticipatory or obviousness challenge would be a prior art reference *only* disclosing a table top. In other words, and particularly considering the dearth of ornamentation and features in the claimed design, Patent Owner's "clear differences" arguments appear to avoid patentability challenges by reducing the scope of a design patent potentially to a point where few prior art references could ever be found and applied.

One case-in-point is *LKQ v. GM Global Technology Operations LLC*, IPR2020-00821, Paper 34 (PTAB Oct. 8, 2021) (Final Written Decision). In *LKQ*, the Board considered a “vehicle hood” that GM had claimed alone, that is—without any additional vehicle components, parts or surrounding environmental structure, such as the vehicle itself. *LKQ*, 3. The prior art included a variety of printed publications, mainly advertisements, promotional brochures and websites, all depicting complete vehicles, having hoods, which Petitioner argued were primary references to the claimed hood design. *Id.* at 24–31. The Board considered the prior art, in comparison to the claimed design, for example, in the table reproduced below.

'759 PATENT	CRUZE WEBSITE (PRIMARY)
 Ex. 1001, FIG. 1	 Ex. 1006, at 4 (cropped)
 Ex. 1001, FIG. 2	 Ex. 1006, at 7 (cropped)

Id. at 46. It is clear in the asserted prior art references, even in these cropped figures from the applied references, that the prior art hood is part of a complete vehicle. Besides the hood, in the asserted primary references there are clearly shown, *inter alia*, headlights, front grill and bumper, wheels and windshields, all distinctly and visibly connected to the hood, or part of, the

vehicle itself. Yet the Board correctly did not consider, (nor was any substantive argument made by GM that it should) these additional parts and components of the complete vehicle in the obviousness analysis. In significant part, this is because the claimed “vehicle hood” does not claim additional features of the vehicle, only a hood. *Id.* at 3; *see also Early Warning Services LLC, v Fintech Innovation Assoc. LLC*, PGR 2022-00046, Paper 16 at 13–19 (PTAB Jan. 16, 2023) (Decision on Institution) (instituting trial despite differences between the prior art references and claimed GUI design where “Petitioner has properly relied on the disclaimer in the ’453 patent that ‘[t]he broken line showing of a portion of a display screen and a computer device in FIGS. 1 through 4 forms no part of the claimed design”).

Patent Owner’s arguments here appear contrary to the well-known all-elements rule. It is well understood that under the all-elements rule, each element in a patent claim is deemed material to defining the scope of the patented invention. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1016 (Fed. Cir. 2006). Patent Owner’s arguments appear to be including unclaimed elements, for example table legs, to define the scope of the claim when applied to the prior art. *See* Prelim. Resp. 36 (Patent Owner arguing that a difference from the claimed design is that Iannaccone includes “[t]hree legs on each side, for a total of six legs.”).

Patent Owner make these same “clear differences” arguments for both anticipation and obviousness. Prelim. Resp. 36–37. Our discussion above, together with the century-old axiom of patent law, “that which infringes if later, anticipates if earlier,” leaves us skeptical at this point that Patent Owner’s arguments regarding differences in the prior art, for example table

legs, that are unclaimed in the '012 patent, carry much weight in design patentability analysis. *See Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889) (The Supreme Court explaining “[t]hat which infringes, if later, would anticipate, if earlier.”). To be clear, in an infringement analysis an important question would be, does the table top of an accused infringing table include all the elements of the “table top” claimed in the '012 patent. It is essentially immaterial to the analysis whether the accused infringing table has three, four, six or any other number of legs, because the scope of the *claimed* table top does not require legs of any number or type.

Conversely, in a patentability analysis, under either anticipation or the determination of a primary reference for purposes of obviousness, we are not persuaded that all the elements and features of the prior art reference designs, such as in this case, table legs, should be assessed against a claimed design that does not claim any table legs.

Besides the table legs in asserted difference 4), our analysis holds true at least for Patent Owner’s asserted differences 5) and 6) relating to Iannaccone’s two cross members along the rear side of the table and grid material forming a shelf beneath the table top. These features are shown in Iannaccone’s Figure 1 reproduced below.

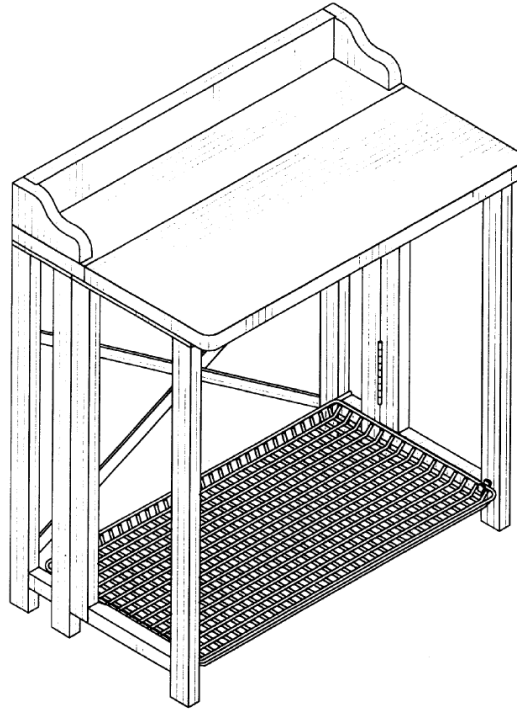


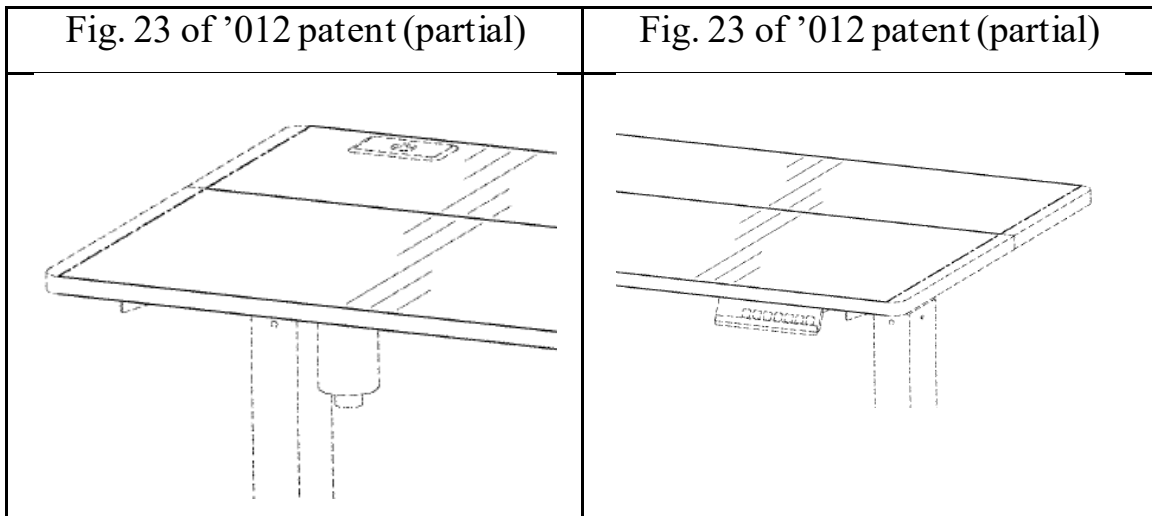
FIG. 1

Iannaccone's Figure 1 illustrates six table legs supporting a grid material forming a shelf below the table top and cross-bracing extending between the two back legs of the claimed table. *Id.* Description.

For difference 3) we have discussed the issue as to the relevance of folding tables, above, and like differences 4)–6) we do not currently find Patent Owner's arguments as to these differences effective to distinguish the claimed table top from Iannaccone.

We also consider Patent Owner's differences 1) and 2) and address specifically the "[t]hree short raised sections at the rear of the non-folding panel." Prelim. Resp. 36. Despite the fact that like table legs, the "raised sections" depicted on Iannaccone's table are attached to the table top, we consider the possibility that this feature presents a somewhat different appearance when compared to the claimed design. So, in part, we rely on our analysis above as to differences 4)–6) also for the "raised sections"

because, the '012 patent illustrates, but does not claim, any elements on or in the table top besides simply the table top itself. For example, as shown below, the partial views from Figure 23 depict various elements connected to the table top drawn in dashed lines.



Besides the cylindrical object below the table top portion shown on the left, the Figure 23 illustrates in dashed lines what appears as a rectangular object supported on (or in) the top surface of the table top. On the right, there is illustrated in dashed lines a different rectangular object (a panel) attached to the bottom surface of the table top.

In Iannaccone, like the table legs, cross members, and grid material, the “raised sections” are components of Iannaccone’s complete table that may be attached to, but are *in addition* to the table top. As shown above, considering the claimed “table top” any additional features are shown in dashed lines. For instance, there is apparently a hole or passage through the table top illustrated by dashed lines as shown in Figures 9–11 and 16–18, and thus not claimed.

Aside from the basic principles of patent law and design patentability analysis discussed above, we recognize in the test for design patent obviousness articulated in *Durling* and *Rosen* that a primary reference must be found, “the design characteristics of which are basically the same as the claimed design.” *Durling*, 101 F.3d at 103 (quoting *Rosen*, 673 F.2d at 391). And, that we must both “(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘basically the same’ visual impression.” *High Point Design*, 730 F.3d 1301, 1311–12 (Fed. Cir. 2013) (quoting *Durling*, 101 F.3d at 103). As to part (1), in our claim construction we have determined that the correct visual impression created by the patent design as a whole is “that the solid lines illustrating the design in Figures 1–23 of the ’012 patent provide an accurate representation and understanding of the claimed table top and that a verbal construction is not necessary.” Section II.D.; *see also In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996) (The obviousness “inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features.”). That said, we recognize that some description of the claimed design may be helpful.

Considering, by way of example, Figures 17, 20, and 23 reproduced below, we provide the following description of the claimed table top.

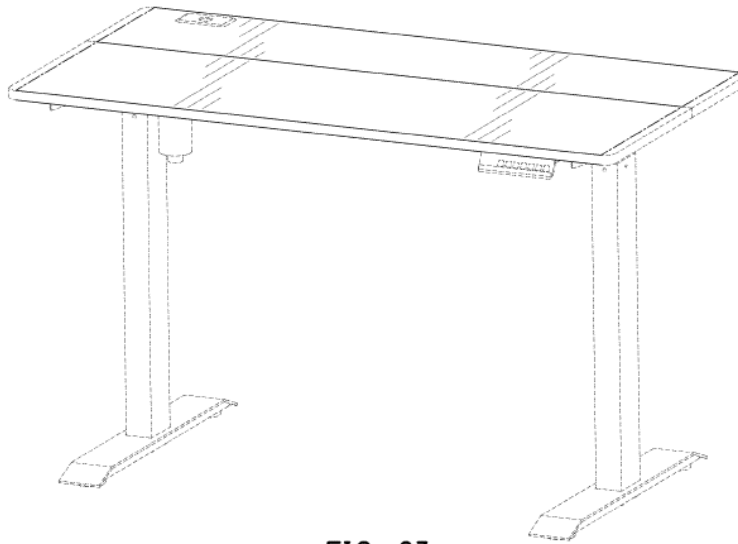


FIG. 23

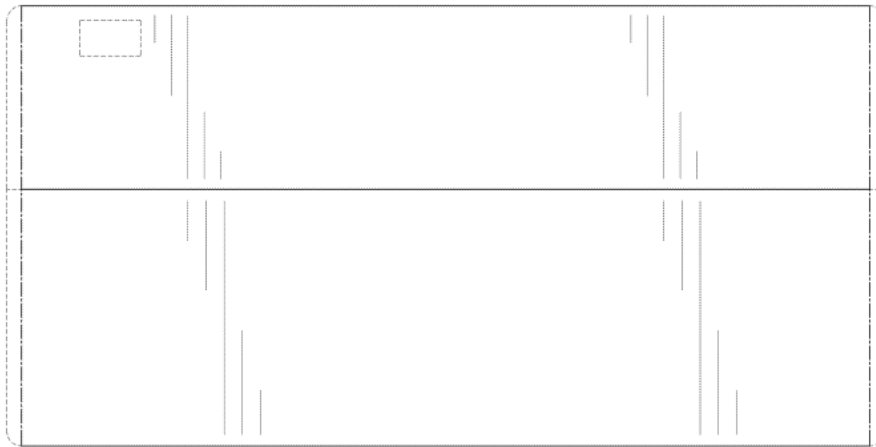


FIG. 17

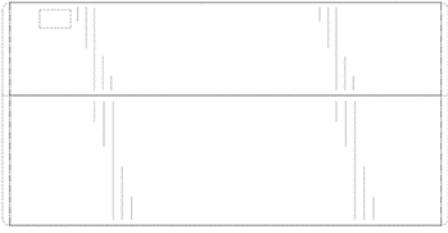


FIG. 20

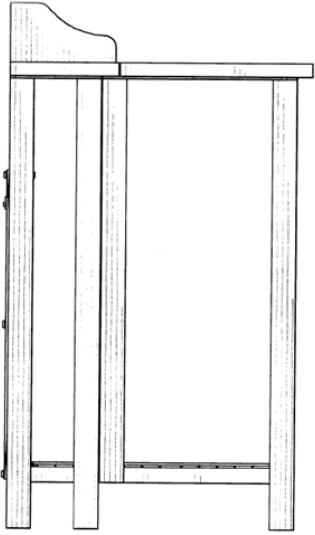
Figures 17, 20, and 23 of the claimed table top illustrate the claimed design in a perspective, front, and elevation end view along with certain features of a table and table top drawn in dashed lines.

The claimed table top consists of two rectangular portions of matching thickness and equal length. The two rectangular portions, one of which is wider than the other, are abutted, i.e., joined, together along a matching long edge forming a visible seam extending the length of the table top. Due to the dashed-dot-dashed boundary lines forming the unclaimed ends of the wider and narrower portions, the length of the table top extends between the dashed-dot-dashed boundary lines. *See In re Owens*, 710 F.3d 1362, 1367 (Fed. Cir. 2013) (The Court explaining that “when an unclaimed boundary line is introduced . . . it is ‘understood that the claimed design extends to the [unclaimed] boundary but does not include the [unclaimed] boundary.’” *Id.* (quoting MPEP § 1503.02)). The visible seam is formed off-center in the table top due to the relative width proportions of the narrower and wider portions of the table top. Without actually measuring the claimed design, it is reasonably observable that the narrower portion is slightly more than $\frac{1}{2}$ the width of the wider portion. The figures, particularly Figure 23, illustrate additional features of a table and table top, including for example table legs and a hole or passage in the table top, drawn in broken lines which are not part of the claimed design.

We next must determine if Iannaccone is a single reference that creates basically the same visual impression as the claimed table top. We find that it does. Considering the table top shown in Iannaccone’s Figure 5, in comparison to Figure 17 of the ’012 patent below, Iannaccone clearly illustrates a table top that has an off-center seam extending the length of the rectangular table top.

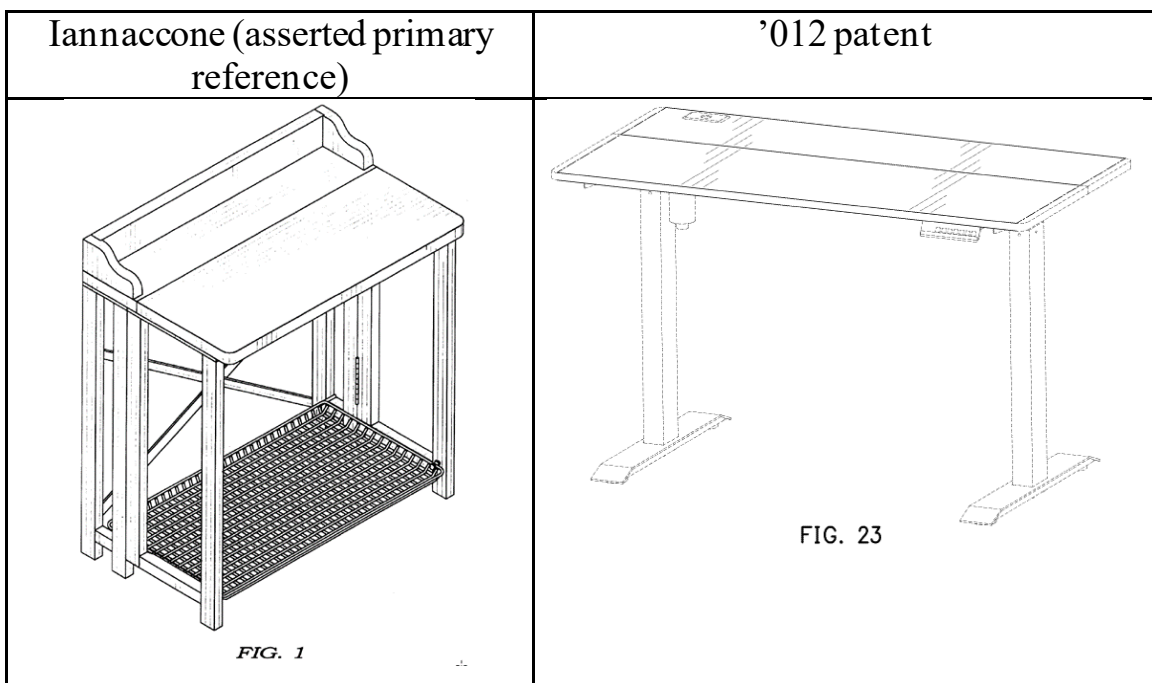
Iannaccone (asserted primary reference)	'012 patent
 FIG. 5	 FIG. 17

Further considering Iannaccone's Figure 2 and Figure 20 the '012 patent in comparison as reproduced in the table below, Iannaccone shows a relative proportionality of the narrower portion of the table top that appears also slightly more than $\frac{1}{2}$ the width of the wider portion.

Iannaccone (asserted primary reference)	'012 patent
 FIG. 2	 FIG. 20

Iannaccone's Figure 2 is shown above in comparison to Figure 20 of the '012 patent illustrating the matching thickness of the narrower and wider portions of the table tops in each design. The end views of the designs again show the similar relative proportionality of the narrower and wider portions between each design.

For a perspective comparison, we reproduce below Iannaccone's Figure 1 in comparison to Figure 23 of the claimed table top.



Iannaccone's Figure 1 perspective view is shown on the left in comparison to the perspective view of Figure 23 in the '012 patent on the right. Although a little less apparent in the perspective view of Figure 23 of the claimed design, mainly because of the nature of the elevation, it is observable that there is a similar proportional width offset between the wider and narrower portions of each design.

We agree with Petitioner’s declarant, Mr. Hatch, that there is an observable proportional difference in length and width between the table tops, the perspective view showing in particular that the table top in the ’012 patent appears slightly longer compared to its overall width, relative to Iannaccone’s table top. Ex. 1002 ¶¶ 116, 131. On this record, we are persuaded by Mr. Hatch’s testimony that “a designer of ordinary skill would have found it trivially obvious to vary the length and width of a given tabletop design to suit different applications.” *Id.* Also, Petitioner provides persuasive, presently unrebutted, evidence that the overall proportions between the two are small differences, including Mr. Hatch’s testimony that “this is a minor difference and difficult to notice because both tabletops are already rectangular in shape with a clear long edge. Without specifically looking for this difference, it would be easy to miss.” *Id.* ¶ 116.

Mr. Hatch also addressed the “raised sections” asserted by Petitioner stating that

[w]hile *Iannaccone* includes an additional back piece that rests on the top surface of the table—specifically on the narrower board shown in Fig. 1—I do not consider this piece when comparing *Iannaccone*’s tabletop to the tabletop in the ’012 patent. This is because the ’012 patent shows only the tabletop in solid lines and specifically avoids claiming anything attached to the top, interior, and bottom of the tabletop.

Id. ¶ 108. We agree with Mr. Hatch here as well, and also note that even considering the “raised sections” as part and parcel of Iannaccone’s table top, the raised sections do not detract in a significant way from the visual impression created by Iannaccone’s table top. In sum, the ’012 patent does not claim a table, but a design that is clearly embodied in only part of table, namely a table top.

We appreciate that the raised sections slightly obscure one's view of the top surface edge of the narrower portion of Iannaccone's table top. Petitioner, however, presents sufficient argument that these features are not relevant to the determination of whether Iannaccone discloses the same tabletop design as that claimed in the '012 patent. *See* Pet. 47. To the extent they must be considered, on the record before us, Petitioner has provided sufficient evidence that the "raised sections" shown in Iannaccone to be a minor difference which has little effect on the overall appearance of Iannaccone's table top. *See, e.g.,* Ex. 1002 ¶ 106 ("The tabletop in *Iannaccone* has exactly the same design as the claimed design because it is nothing more than two unequal-width boards placed side-by-side to form the tabletop surface."); *see Sealy Tech., LLC v. SSB Mfg. Co.*, 825 F. App'x 801, 806 (Fed. Cir. 2020) (The Federal Circuit explaining that "the presence of the duvet fasteners on the handles is no more than a slight difference in design . . . and does not detract either from the Board's finding that Somma Nouveau discloses the requisite handles, or from its overall finding that Somma Nouveau creates basically the same visual impression as the claimed design."). In *Sealy*, despite the duvet cover blocking the view of a significant portion of the prior art mattress, including the side and rear edges, the Court affirmed the Board's determination that the prior art mattress of "Somma Nouveau discloses 'basically the same' design as the claimed design." *Id.*

Given the plethora of views in Iannaccone clearly illustrating the front, back, side, top and bottom as well as perspective views of Iannaccone's table top, Petitioner has sufficiently shown that, even with the raised sections as well as the table legs and other elements, a designer of

ordinary skill in the art would readily appreciate that Iannaccone's table top depicts a readily observable similar proportionality between the wider and narrower portions of the table top that is basically the same as the claimed table top. *See id.* ¶ 114 (Dr. Hatch testifying that “*Iannaccone* would also create the same basic visual impression as the claimed design: i.e., a tabletop formed from two unequal-width boards.”).

With respect to the raised sections, we acknowledge that the raised sections supported on the table top could be viewed as part of the table top itself, and might, by some ordinarily skilled designers, be accorded some weight when comparing the designs. However, even if we accord some weight to the raised sections, it appears, based on the present record, that Iannaccone's table top would not need major, nor perhaps even minor, modification to look like the claimed design. *See In re Harvey*, 12 F.3d at 1063 (The Federal Circuit determining that “the Harvey prior art vase is not ‘basically the same’ as the claimed designs. Because major modifications would be required to make Harvey's prior art vase look like the claimed designs, it cannot qualify as a basic design.”).

The Board looks forward to the parties' briefs, arguments, case law citations and analysis with respect to the issue of prior art as compared to the claimed design.

On this record, the weight we accord the raised sections is determined mostly by the design patent claim itself. As explained by the Federal Circuit, “[i]n considering patentability of a proposed design the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings.” *In re Rosen*, 673 F.2d at 391. In this proceeding the entirety of the design is simply a table top, not an entire table. Indeed, the '012 patent

claims a table top shown in Figures 1–23 and does not claim any additional features or elements besides two different width planks. And, to the extent the raised sections of Iannaccone are entitled to some weight in the comparison, on this record it appears that the raised sections do not significantly visually detract from the overall appearance of Iannaccone’s table top which appears basically the same as the claimed table top.

On this record, we determine that Petitioner has established a reasonable likelihood that Iannaccone is a proper primary reference as it is “a single reference that creates ‘basically the same’ visual impression” as the patented design. *Durling*, 101 F.3d at 103. Therefore, on the present record, we determine that Petitioner has established a reasonable likelihood that the claim of the ’012 patent would have been obvious to a designer of ordinary skill in the art over Iannaccone.

F. Ground 7 – Alleged Anticipation over Iannaccone (Ex. 1006)

It is well-settled that a patentee, as Patent Owner has done in the ’012 patent, can obtain a design patent on a part of another article of manufacture. *See Auto. Body Parts Ass’n v. Ford Glob. Techs., LLC*, 930 F.3d 1314, 1316–17 (Fed. Cir. 2019) (Ford claiming “Exterior of Vehicle Hood,” in U.S. Patent No. D489,299 and “[t]he ornamental design for a vehicle head lamp,” in U.S. Patent No. D501,685, automotive parts which are used in certain models of Ford’s F-150 trucks.). Analogous to the automotive body parts designs, here, Patent Owner obtained a design patent on a specific part of a table, namely the table top. Ex. 1001, code (54). However, as discussed with respect to Ground 8, above, it is also well-established that “that which infringes if later, anticipates if earlier.” *Peters*, 129 U.S. at 537. And, if Patent Owner can assert infringement against tables and desks which

allegedly embody the design of the claimed table top, then Patent Owner's table top design must be similarly subject to patentability challenges based on table tops embodied in prior art table and desk designs. *See* Ex. 1009 ¶ 15 (In its Complaint in the underlying district court litigation, Patent Owner argues that "Defendants typically sell various infringing and/or counterfeit goods, including *infringing height adjustable standing desks* that infringe upon Plaintiff's '012 Patent.") (emphasis added). In this proceeding, from a patentability standpoint, what sauce is good for the goose is also good for the gander. *The English Rogue, Continued in the Life of Meriton Lagroon and other Extravagants*, Part III, Pg. 4, Richard Head, (1665), The Internet Archive, Open Library, <https://archive.org/details/englishroguedesc03headuoft/page/n13/mode/2up?ref=ol&view=theater> (last visited August 23, 2023).

We are persuaded on this record that Petitioner has shown a reasonable likelihood that Iannaccone anticipates the claimed table top in the '012 patent. Petitioner's declarant, Mr. Hatch, testifies that in comparison "[t]he tabletop in *Iannaccone* has exactly the same design as the claimed design because it is nothing more than two unequal-width boards placed side-by-side to form the tabletop surface." Ex. 1002 ¶¶ 106–108. With respect to the raised sections, Mr. Hatch testifies that "I do not consider this piece when comparing *Iannaccone*'s tabletop to the tabletop in the '012 patent. This is because the '012 patent shows only the tabletop in solid lines and specifically avoids claiming anything attached to the top, interior, and bottom of the tabletop." *Id.* ¶ 108. Mr. Hatch explains that "[f]rom a simple, ordinary visual inspection, with the level of acuity the ordinary

observer would apply, the overall proportions of *Iannaccone*'s tabletop appear to be the same as the claimed design.” *Id.* ¶ 110. Mr. Hatch acknowledges there are some proportional differences in the table tops but that “the difference in proportion is minor and requires effort to notice, with both tables being generally rectangular in overall shape. Although *Iannaccone* is slightly broader in its proportional width, its overall proportions are still in the form of a long rectangle with a clear long and short side.” *Id.* ¶ 112.

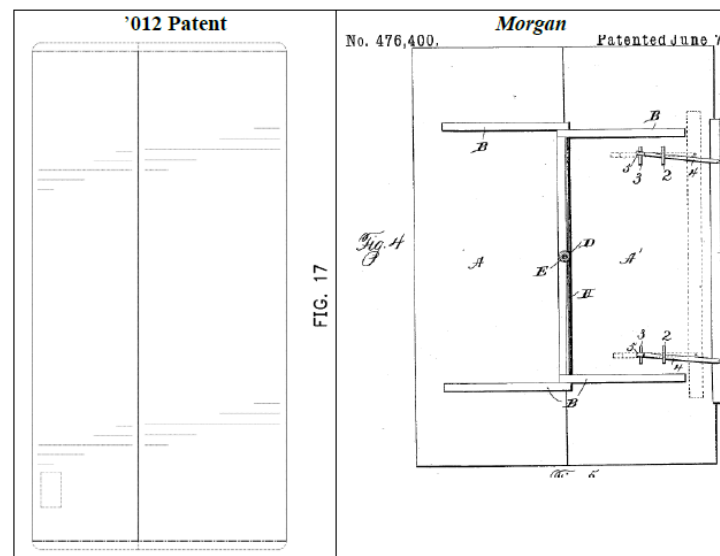
Mr. Hatch's testimony is unrebutted on this record. Based on this testimony and our comparison of the designs we are persuaded at this point in the proceeding that an ordinary observer with knowledge of the prior art would find the proportional differences in the overall visual appearance of the claimed design relatively minor in nature in a comparison with *Iannaccone*.

Having compared all the ornamental features of the claimed table top design to *Iannaccone*, along with Mr. Hatch's testimony, we find merit in Petitioner's comparisons and evidence that an ordinary observer, having considered the claimed design in the '012 patent as a whole, would find the claimed table top and *Iannaccone*'s table top substantially the same. Pet. 45–47 (citing Ex. 1002 ¶¶ 105–112). Any minor differences do not prevent a finding of anticipation based on the record before us. *See Int'l Seaway*, 589 F.3d at 1243 (“minor differences cannot prevent a finding of anticipation.”).

Accordingly, on the present record, we determine that Petitioner has established a reasonable likelihood that that an ordinary observer would find the claim of the '012 patent anticipated by *Iannaccone*.

G. Grounds 1–2 – Alleged Anticipation and Obviousness over Morgan

Petitioner relies on Morgan as the anticipatory reference for Ground 1 and as the primary reference for the obviousness challenge in Ground 2. Pet. 24–29. Petitioner asserts that “*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.” *Id.* at 24 (citing Ex. 1002 ¶¶ 53–58). As discussed above, we regard the claim of the ’012 patent as requiring a table top with two portions of unequal widths. Petitioner does not make any argument that the ’012 patent is unpatentable under an alternative claim construction that does not require equal-width boards/planks. Petitioner’s comparison of Figure 17 of the ’012 patent and Figure 4 of Morgan is reproduced below.



Petitioner compares Figure 17 of the ’012 patent above, left, with Figure 4 of Morgan above, right. The visibly clear difference between Morgan and the claimed table top is that Morgan discloses a table top with a seam down the center of the table top, that is not offset, i.e., not off-center, so as to define

two unequal width table portions as in the '012 patent. Patent Owner mainly argues that Morgan discloses a folding table and thus does not anticipate or render obvious the '012 patent. Prelim. Resp. 23–24.

At this point in the proceeding, based on our claim construction that the solid lines illustrating the design in Figures 1–23 of the '012 patent provide an accurate representation and understanding of the claimed table top, and our explanation that “[t]he visible seam is formed off-center in the table top due to the relative width proportions of the narrower and wider portions of the table top,” it does not appear that Morgan discloses this feature of the claimed design.

We will fully consider the merits of the parties’ arguments and evidence on this challenge after the parties have had a full and fair opportunity to raise arguments and present evidence for this challenge.

H. Ground 3 – Alleged Obviousness over Morgan and Galant

Petitioner asserts that under an alternative claim construction in which the claimed design encompasses tabletops with equal-width boards/planks, the claimed design would have been obvious over Morgan, as the primary reference, in combination with Galant, which depicts a table top having the same overall proportions as the claimed design. Pet. 29–32; *see also id.* at 30 (stating “*Galant*’s tabletop is *literally identical* to the claimed tabletop aside from the seam that divides the two planks in the design). In particular, Petitioner argues that “*Morgan* is a suitable primary reference because it has the same design characteristics: that of a tabletop formed of two side-by-side boards.” *Id.* at 29. As discussed above, Morgan discloses a seam that is not off-center so as to create two unequal width portions of the table top. Petitioner does not rely on Galant to remedy this deficiency.

We will fully consider the merits of the parties' arguments and evidence on this challenge after the parties have had a full opportunity to raise arguments and present evidence for this challenge.

I. Grounds 4 and 5 – Alleged Anticipation and Obviousness over Bordonabe

Petitioner argues that “*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.” *Id.* at 32–33 (citing Ex. 1002 ¶¶ 73–81). In that regard, Petitioner points to two Figures or Designs (A and B) in *Bordonabe* appearing on page 20. Design A appears to show a table with a top having portions that are of equal width, and Design B appears to show a table with a top having portions that are unequal in width. *See* Ex. 1005, 20. For the reasons discussed above as to claim construction, we consider *Bordonabe*’s Figure B with unequal top portions as being more pertinent in connection with the design of the ’012 patent.

As Patent Owner argues with respect to anticipation, *Bordonabe* provides mainly perspective views of the prior art table, making it difficult, but perhaps not impossible, to assess the specific proportions of *Bordonabe*’s unequal width table top portions. Prelim. Resp. 24–34. In particular with respect to *Bordonabe*’s Figure B, Patent Owner argues, similar to *Iannaccone* above, that there are six differences from the claimed design, including, e.g., “[t]hick rectangular legs with a vertical groove on the lower half of the leg.” *Id.* at 25. As for obviousness, Patent Owner argues that “[f]or the same reasons that each of the *Bordonabe* designs do not anticipate

the ‘012 Patent, the Bordonabe designs cannot be primary references.” *Id.* at 35.

The Bordonabe reference appears to be limited to one view of each embodiment of the prior art table. *See, e.g.*, Ex. 1005, 20. In that respect, Patent Owner’s view that a “single drawing shown from just one angle” as to Bordonabe Design B, may inhibit an adequate comparison of that design as compared with the design of the ’012 patent. However, it may be that the claimed design and Bordonabe Design B create substantially the same impression because, as Mr. Hatch testifies, “[i]t would have been immediately apparent to an ordinary observer (purchaser) that design B of *Bordonabe Furniture* has a tabletop design that involved dividing the overall tabletop into two unequal portions, which is the same as the ’012 patent.” Ex. 1002 ¶ 79. Based on this visual similarity, Mr. Hatch testifies that “the ordinary observer would be deceived into believing the two tabletops have the same design.” *Id.* ¶ 76. Mr. Hatch also testifies that for purposes of a primary reference for obviousness, based on the similarities “*Bordonabe Furniture* would also create the same basic visual impression as the claimed design: i.e., a tabletop formed from two equal width boards.” *Id.* ¶ 83.

Whether Bordonabe anticipates or is a proper primary reference are questions that we leave for further development during trial. We will fully consider the merits of the parties’ arguments and evidence on this challenge after the parties have had a full and fair opportunity to raise arguments and present evidence for this challenge.

J. Ground 6 – Alleged Obviousness over Galant and Bordonabe

Bordonabe is also relied upon as a primary reference in combination with Galant in this challenge. Pet. 41. Petitioner argues that “*Bordonabe*

Furniture is a suitable primary reference because it has the same design characteristics: that of a tabletop formed of two side-by-side boards.” *Id.* at 29. As discussed above, we agree with Patent Owner that Bordonabe provides mainly perspective views of the prior art table, and has a visually different long edge appearance compared to the claimed table top.

Whether Bordonabe is a suitable primary reference we leave for development during trial. We will fully consider the merits of the parties’ arguments and evidence on this challenge after the parties have had a full opportunity to raise arguments and present evidence for this challenge.

K. Ground 9 – Alleged Obviousness over Galant and Iannaccone

Petitioner contends that “[t]o the extent Patent Owner argues that the overall proportions (length/width) of the tabletop differ between Iannaccone and the claimed design, . . . *Galant* discloses a tabletop twice as long as it is wide.” *Id.* at 52–53. Patent Owner makes the same arguments that Iannaccone is not a primary reference in combination with *Galant* for the same reasons it is not, by itself, an anticipatory and obviousness reference as discussed above. Prelim. Resp. 35–37. Patent Owner reserves the right to assert *Galant* is not a proper secondary reference later in the proceeding. *Id.* at 37.

We find merit in Petitioner’s argument that *Galant*, also disclosing a table top, reveals a table top of the same relative length, width, and thickness proportions as the claimed design. For example, consistent with our visual review, Mr. Hatch testifies that “*Galant*’s tabletop has the same proportions as the claimed design . . . as shown in the comparison between the claimed design and *Galant*, the tabletops are literally identical except for the seam that divides the two boards in the claimed design.” Ex. 1002 ¶ 133.

We will fully consider the merits of the parties' arguments and evidence on this challenge after the parties have had a full and fair opportunity to raise arguments and present evidence for this challenge.

III. CONCLUSION

We determine that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to the one claim of the '012 patent. 37 C.F.R. § 42.108(c); *SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *see also* *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (stating that a decision to institute is “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”). We therefore institute trial on all challenges included in the Petition.

Our factual findings and determinations at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review of the '012 patent is hereby instituted as to the claim on all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial on the grounds of unpatentability authorized above; the trial commences on the entry date of this decision.

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