

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
MOTION TO AMEND**

TABLE OF CONTENTS

<i>I. INTRODUCTION.....</i>	<i>3</i>
<i>II. THE ‘012 PATENT.....</i>	<i>3</i>
<i>III. PROCEDURAL BACKGROUND.....</i>	<i>4</i>
<i>IV. PROPOSED AMENDMENTS.....</i>	<i>6</i>
<i>V. GROUNDS OF UNPATENTABILITY.....</i>	<i>13</i>
A. Grounds 1, 2 and 3 – 35 USC §102/103 – Morgan and Galant.....	13
1. Motion to Amend.....	13
2. Response to Institution	16
B. Ground 4, 5 and 6 – 35 USC §102/103 – Bordonabe and Galant	16
1. Motion to Amend.....	16
2. Response to Institution	19
C. Grounds 7, 8 and 9 – 35 USC §102/§103 – Iannoccone and Galant	19
1. Motion to Amend.....	19
2. Response to Institution	23
<i>VI. CONCLUSION</i>	<i>24</i>

I. INTRODUCTION

Patent owner EP FAMILY CORP. (herein “EP Family”) files this Motion to Amend (“MTA”) the claim of US Design Patent D934,012 to Chang (the “’012 Patent”) in response to institution of proceedings in the above captioned Inter Parties Review. EP Family further elects to participate in the pilot program for motion to amend practice (“Pilot Program”) in this matter before the Patent Trial and Appeal Board (“Board”). As required, Patent Owner conferred with the Board about the proposed MTA on a conference call held Monday, October 16, 2023. *See Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019*, Pg. 66.

With this MTA, Patent Owner will provide the required claim listing, clearly outlining the changes to be made and support from the disclosure for the proposed changes. As required by 37 C.F.R. §42.121(a)(2)(i), Patent Owner will demonstrate how the proposed amendments respond to and address each ground of unpatentability outlined in the Institution. Patent Owner argues that the proposed claim amendments traverse each of the nine grounds of invalidity presented in Petitioner’s petition for Inter Partes Review. Further, the amendments are permissible as they do not expand the scope of the claim, are supported by the current disclosure, and contain no new matter.

II. THE ‘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 ‘012 Patent issued on October 6, 2021 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. As with all design patents, the ‘012 Patent includes a single claim,

specifically “The ornamental design for a table top, as shown and described.” The 23 figures of the ‘012 Patent show the claimed invention. Further, the ‘012 Patent includes the following disclaimer:

The broken line portions of the table top in FIGS. 1 – 23 represent portions of the article that form no part of the claim. The broken lines of the tenons in FIG. 8 illustrate environment that form no part of the claimed design. The broken lines of the bases in FIG. 23 illustrate environment that form no part of the claimed design. The 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.

‘012 Patent, Pg 1, Col 2.

Since the top and bottom edges of the top and bottom portions are connected by dot-dash dashed lines, the distances between the top and bottom edges of the top and bottom portions, i.e., the widths of the top and bottom portions are not limited to unequal embodiments as shown in the drawings. Thus, we respectfully submit that the top and bottom portions are not construed as the “wider portion” and the “narrower portion” of the table top respectively on page 4 of the Decision Granting Institution. See *Decision Granting Institution*, IPR2023-00658, Paper 8, Page 4.

The single claim, 23 figures of the ‘012 Patent and the included disclaimer set the scope of the claimed invention in the ‘012 Patent. This MTA will amend the drawings of the ‘012 Patent to amend the scope of the claimed invention such that the grounds of invalidity argued by Petitioner are traversed.

III. PROCEDURAL BACKGROUND

Petitioners Hangzhou Taihe Trading Co., Ltd. and Ningbo Likeju Trading Co., Ltd. filed their IPR on March 6, 2023 claiming that the ‘012 Patent is invalid under 35 U.S.C. §102 as anticipated by each of U.S. Patent No. 476,400 to Morgan et al. (“Morgan”), the Bordonabe Furniture reference, *16 FEBERO 2000, BOLETIN OFICIAL DE LA PROPIEDAD INDUSTRIAL*

at 718 – 719, *Petitioner Ex. 1006*, 20 – 21 (“Bordonabe”), and U.S. Patent No. D424,325 to Iannaccone (“Iannaccone”). Petitioner also argues that the ‘012 Patent is invalid under 35 U.S.C. §103 as obvious under various combinations of Morgan, Bordonabe, and Iannaccone with Galant, Ex. 1007, IKEA webpage, advertisement, Workspace furniture & accessories | Desks | GALANT table, [https://web.archive.org/web/20050418202119/ http://www.ikea.com](https://web.archive.org/web/20050418202119/http://www.ikea.com) (April 18, 2005) (“Galant”).

Patent Owner’s Preliminary Response, filed on June 5, 2023, disputes the Petitioners likelihood of success on each of the nine argued grounds of invalidity. Patent Owner argues, and continues to maintain, that the claim of the ‘012 Patent is not anticipated under §102 over Morgan nor obvious under §103 over Morgan or Morgan and Galant. Further, the claim of the ‘012 Patent is not anticipated under §102 over Bordonabe nor obvious under §103 over Bordonabe or Bordonabe and Galant. Finally, Patent Owner argued and continues to maintain that the claim of the ‘012 Patent is not anticipated under §102 over Iannaccone or obvious under §103 over Iannaccone or Iannaccone and Galant.

On September 1, 2023 the Board granted institution of Inter Parties Review on the following grounds of unpatentability:

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

7	1	102	Iannaccone
8	1	103	Iannaccone
9	1	103	Galant, Iannaccone

In this MTA, Patent Owner will respond to the Board's analysis of each ground of unpatentability and show how the proposed amendments traverse the specific ground.

IV. PROPOSED AMENDMENTS

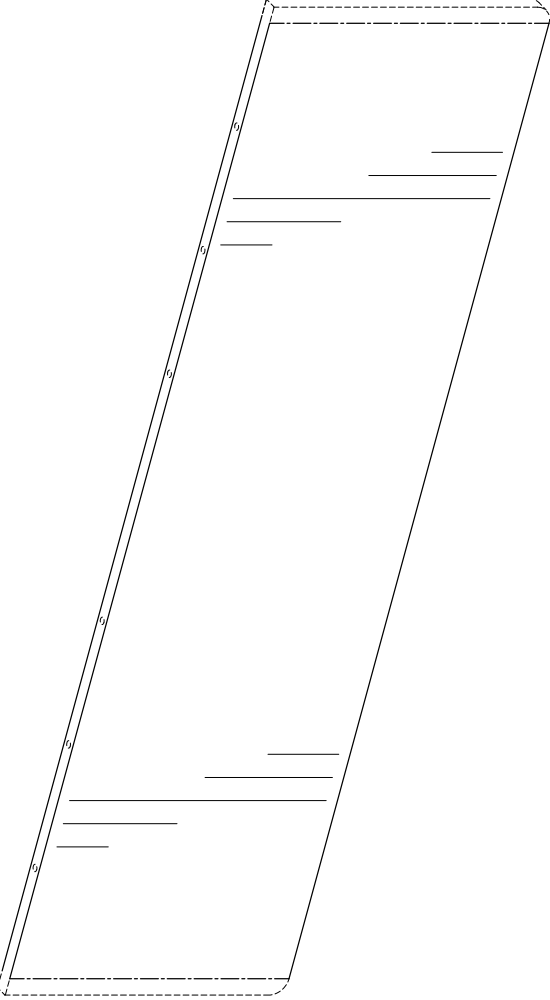
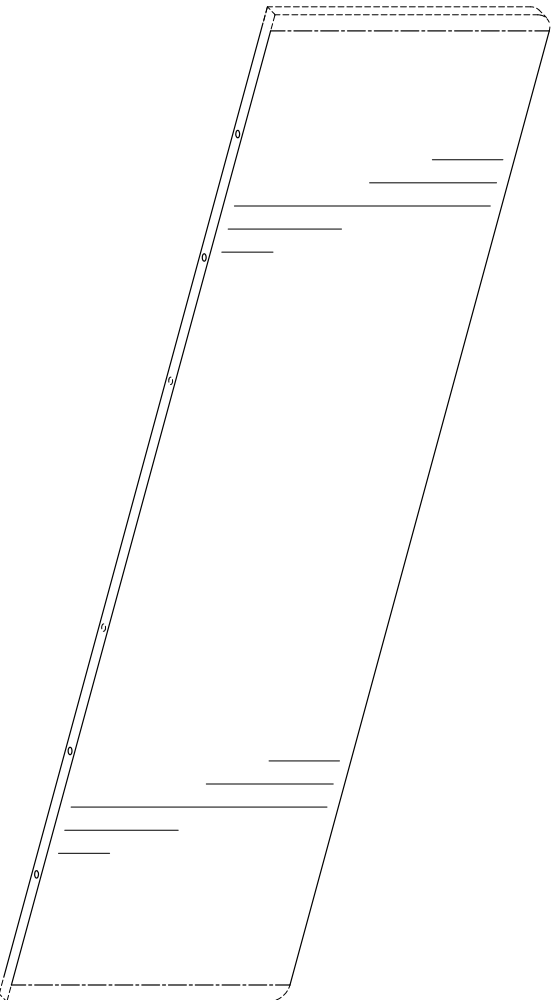
EP Family moves to amend the claim of the '012 Patent as presented below. The original figure is presented next to each proposed amended figure. Figures that are unchanged by the proposed amendment are presented as such.

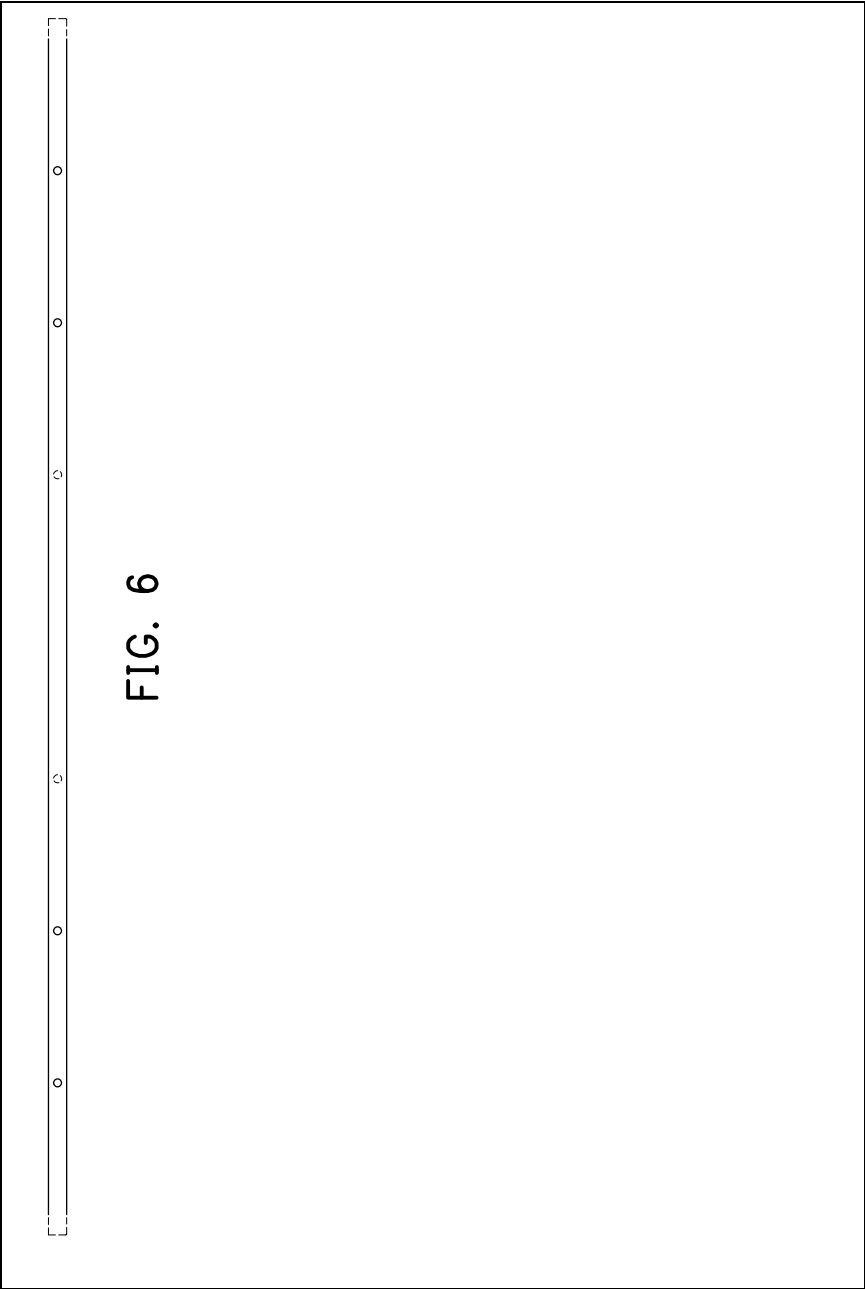
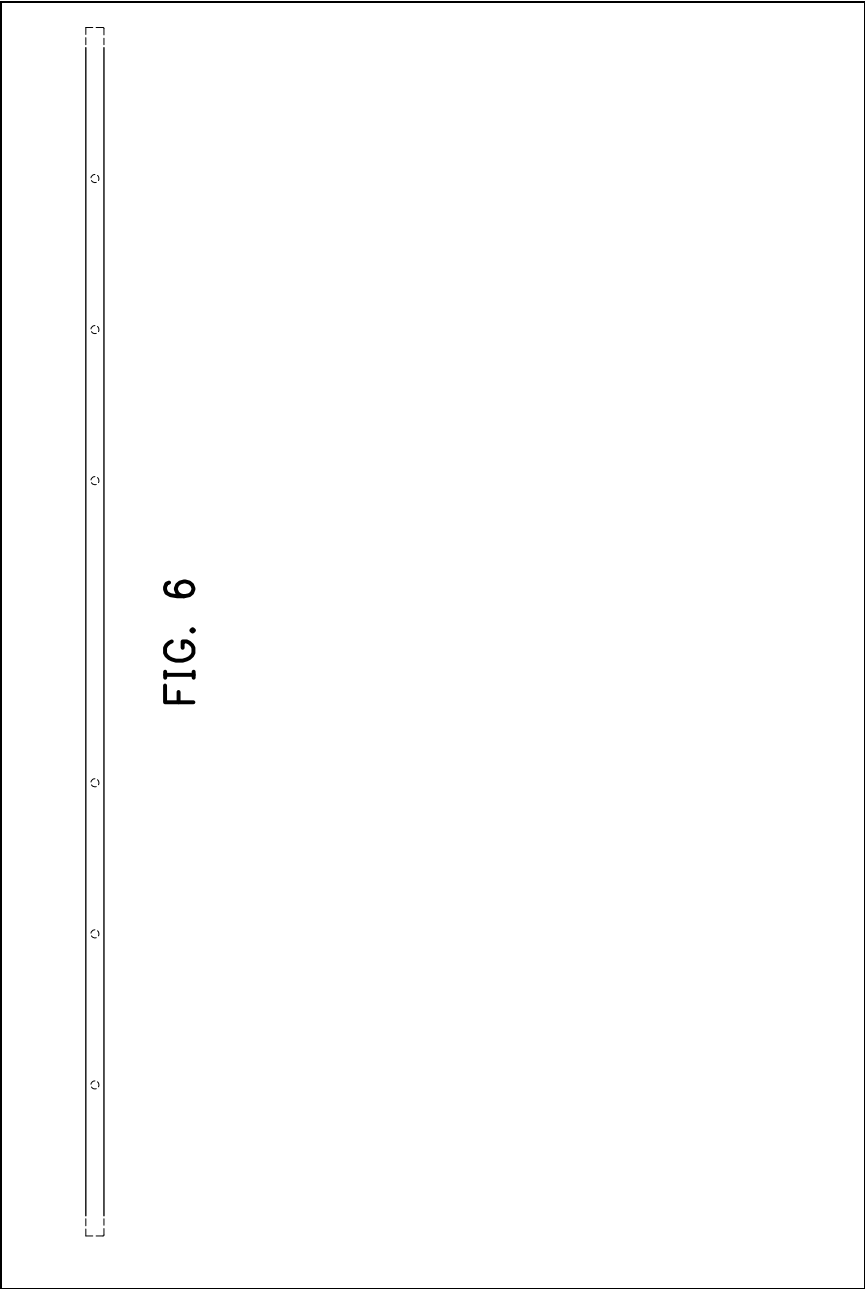
The changes to each figure are:

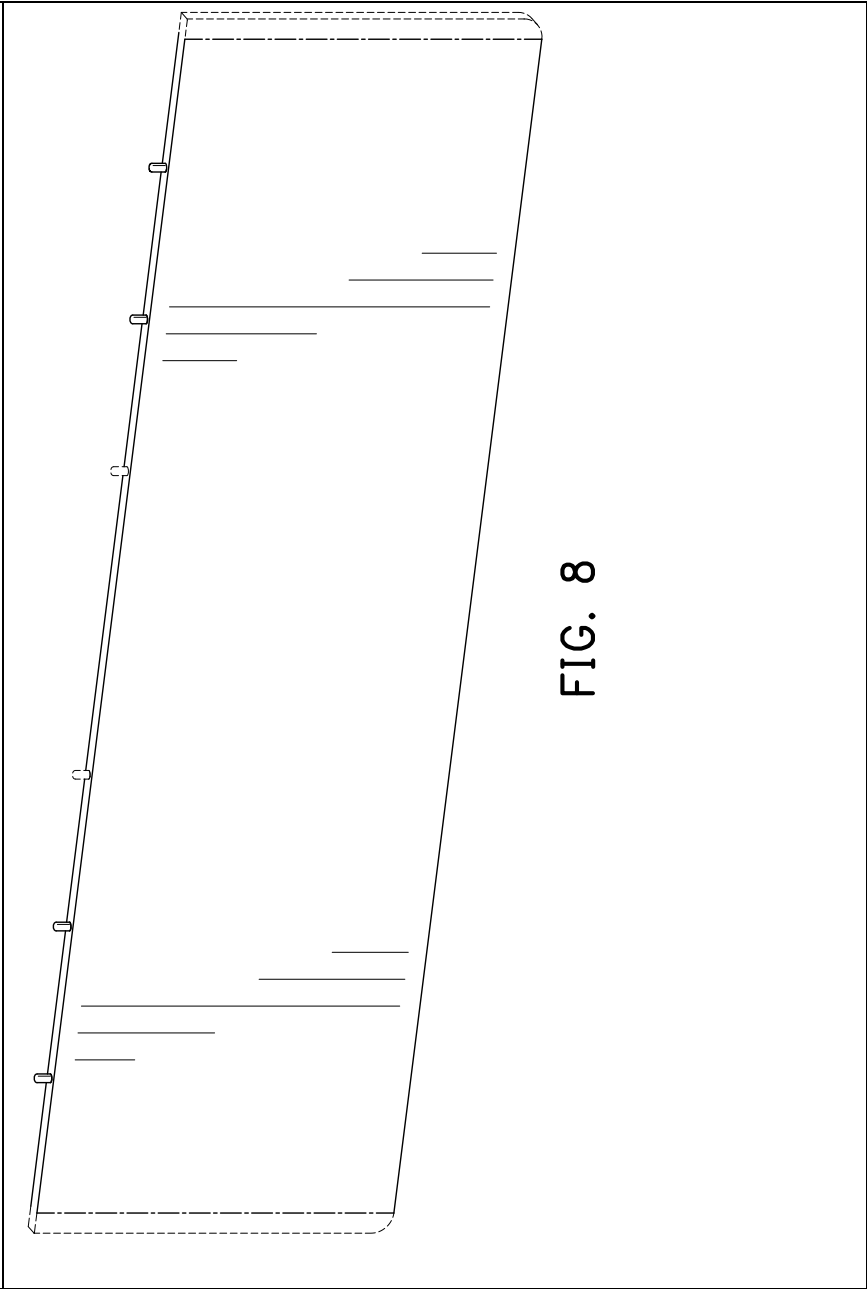
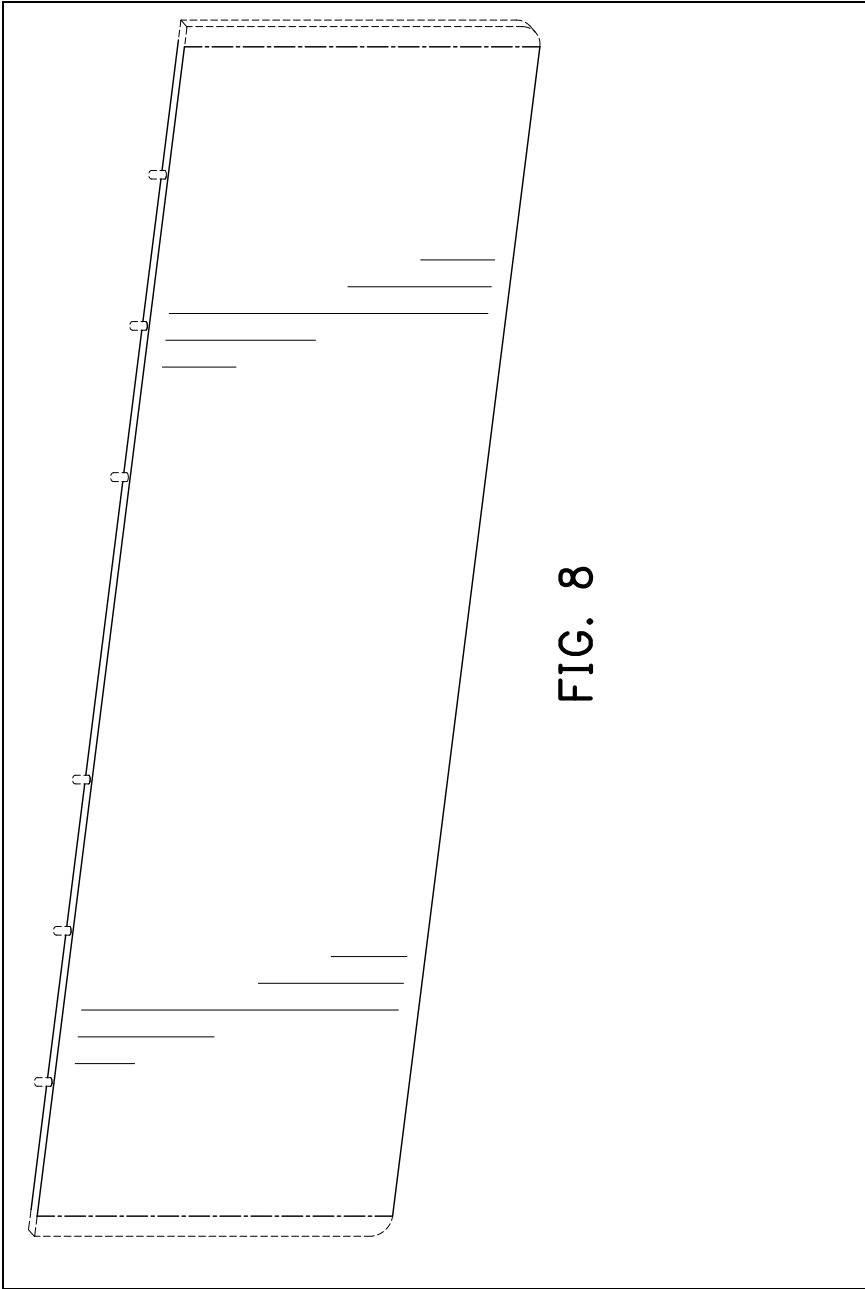
- Figure 1: Removal of disclaimer of a total of four holes by amending the outline of the four holes from broken lines to solid lines. Two of the holes are located closest to the right side edge of the table top and two of the holes are located closest to the left side outer edge of the table top.
- Figure 6: Removal of disclaimer of a total of four holes by amending the outline of the four holes from broken lines to solid lines. Two of the holes are located closest to the right side edge of the table top and two of the holes are located closest to the left side outer edge of the tabletop.
- Figure 8: Removal of disclaimer of a total of four tenons by amending the outline of the four tenons from broken lines to solid lines. Two of the tenons are located closest to the right side outer edge of the table top and two of the tenons are located closest to the left side outer edge of the table top.

- Figure 9: Removal of disclaimer of a total of four holes by amending the outline of the four holes from broken lines to solid lines. Two of the holes are located closest to the right side outer edge of the table top and two of the holes are located closest to the left side outer edge of the table top.
- Figure 14: Removal of disclaimer of a total of four holes by amending the outline of the four holes from broken lines to solid lines. Two of the holes are located closest to the right side outer edge of the tabletop and two of the holes are located closest to the left side outer edge of the table top.

Patent owner proposes no amendments to Figs 2 – 5, 7, 10 – 13, 15 – 23.

Original Figure	Proposed Amended Figure
 FIG. 1	 FIG. 1





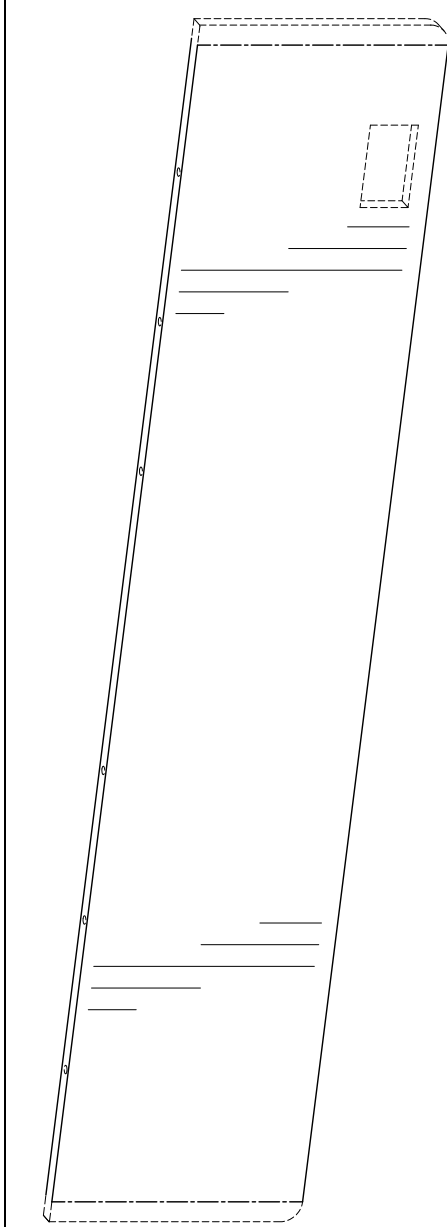


FIG. 9

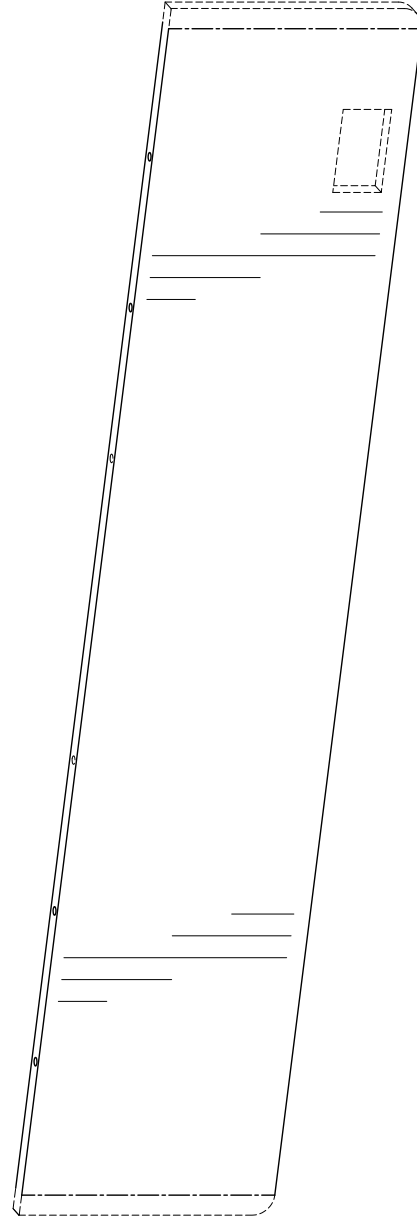


FIG. 9

FIG. 14



FIG. 14



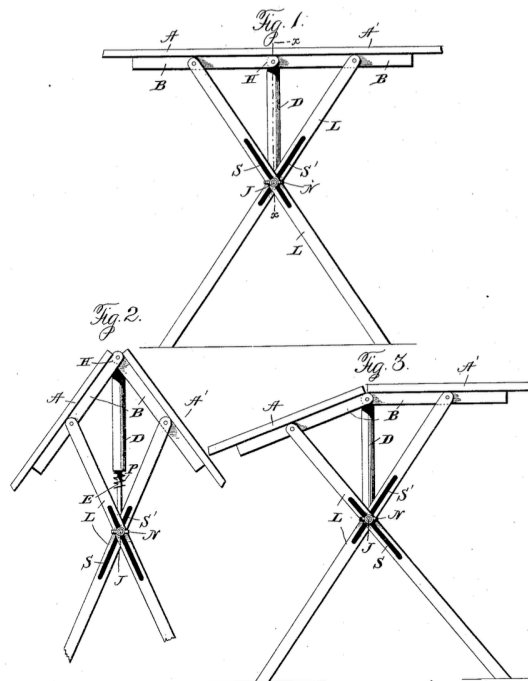
V. GROUNDS OF UNPATENTABILITY

These amendments address each ground of unpatentability argued in the Petition and Institution decision by adding claim elements that are not found in any of the cited prior art references. The specific elements added to the claim of the '012 Patent are a total of four tenons and four holes. These amendments are clearly shown by the removal of previously disclaimed matter in Figures 1, 6, 8, 9 and 14. These features are clearly show in the drawings as originally filed and issued in the '012 Patent and thus the amendments include no new matter. Further, the amendments do not enlarge the scope of the claim of the '012 Patent. In fact, the amendments narrow the scope of the claim by adding the previously disclaimed holes and tenons.

A. Grounds 1, 2 and 3 – 35 USC §102/103 – Morgan and Galant

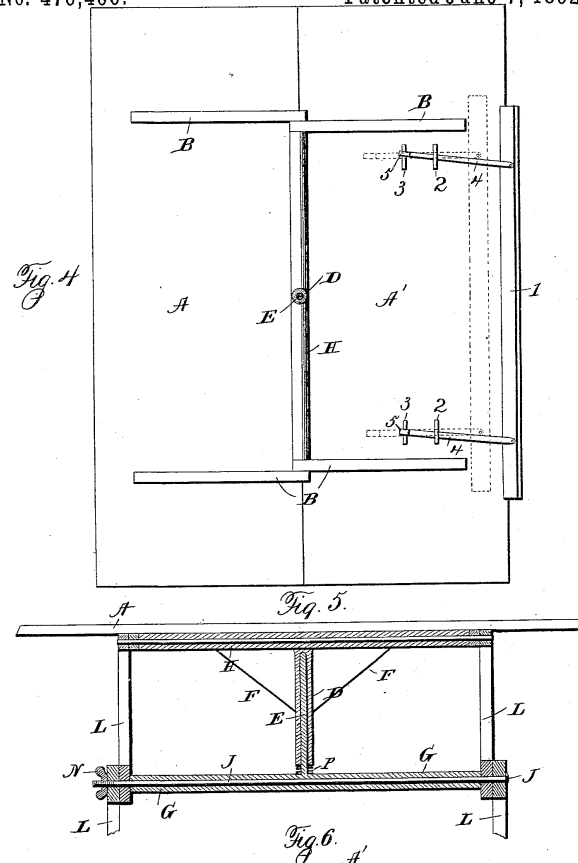
1. Motion to Amend

The figures and specification of Morgan do not disclose or suggest tenons or holes. The published figures of Morgan are:



No. 476,400.

Patented June 7, 1892.



Witnesses:
 Jas. C. Hutchinson
 J. A. Kitchin pro. by
 Inventors:
 Wm. R. Morgan & Clinton S. Osborn
 Edward Taggart, atty.

These figures do not show or suggest any holes or tenons located between the two halves of the table top. The specification of Morgan is also silent on any disclosure or suggestion of holes or tenons between the two halves of the table top.

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).

Patent Owner argues that Morgan does not operate as a §102 reference for the amended ‘012 Patent under the Ordinary Observer test. As Patent Owner argued in their Preliminary Response, an ordinary observer would not be deceived into believing that Morgan is the same design as the current claim of the ‘012 Patent. The amended claim with the addition of tenons and holes further differentiates the design of the ‘012 Patent from that of Morgan. Thus, the proposed claim amendments address ground of unpatentability 1.

The analysis of Morgan as a §103 reference closely mirrors the analysis above regarding Morgan’s applicability as a §102 reference. As stated above, the figures and specification of Morgan do not disclose or suggest tenons or holes nor does specification of Morgan disclosure or suggest holes or tenons between the two halves of the table top.

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.*

For the same reasons that Morgan does not operate as a §102 reference, Morgan is also not a primary reference as required in the design patent §103 analysis. Morgan does not create “basically the same” visual impression as the current claims of ‘012 Patent for the same reasons outlined in Patent Owner’s Preliminary Response. The proposed claim amendment, with the addition of tenons and holes, further differentiates the design of the ‘012 Patent from that of Morgan. Thus, the proposed claim amendments address ground of unpatentability 2.

Morgan does not operate as a primary reference in the design patent §103 analysis and Galant does nothing to remedy that deficiency. Galant discloses a single piece table top design, without two portions and does nothing to remedy any deficiencies in Morgan. Further, Galant does not disclose tenons or holes as required by the amended ‘012 Patent claim. Thus, the proposed claim amendments address ground of unpatentability 3.

2. Response to Institution

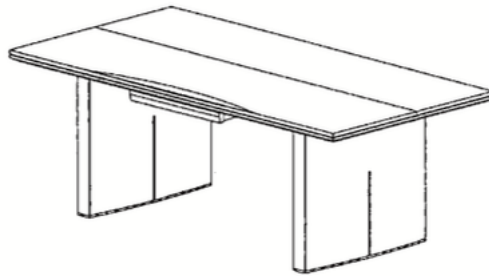
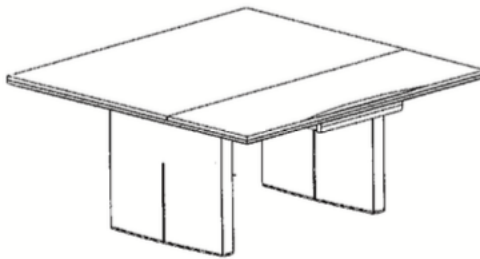
Patent Owner continues and maintains the arguments contained in their Preliminary Response regarding Morgan as an anticipating or making obvious the design of the ‘012 Patent. The claim amendments proposed only further differentiate Morgan from the design of the ‘012 Patent resulting in a failure of Morgan in the Ordinary Observer test or operate as a primary reference when compared to the amended claim of the ‘012 Patent. Galant, which does not disclose holes or tenons, does not provide any additional necessary elements for the §103 analysis.

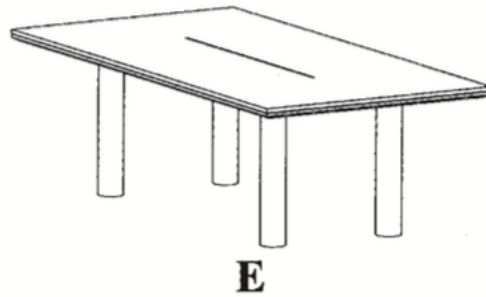
B. Ground 4, 5 and 6 – 35 USC §102/103 – Bordonabe and Galant

1. Motion to Amend

Petitioner cites four table designs contained in Bordonabe (a 459 page reference, in Spanish) 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 Spanish. The cited figures of Bordonabe are:

**A****B****C**



The single figure and the brief written description provided for each design variation of Bordonabe provides little useful information about the construction of each of the tables. Specifically, it is unclear from the drawings or text if the table top is composed of two pieces (in A, B or C) or is a single piece with a beveled design feature. *Bordonabe* Translation, Pg. 1 - 3, Ex. 2001. The details of the construction of the table top are too sparse to determine how the table top is assembled. None of the figures or provided description provide any disclosure or suggestion of holes or tenons as required by the proposed amended claim of the '012 Patent. Without the necessary detail and disclosure of tenons and holes, it is unlikely that an ordinary observer would be deceived into thinking any of the cited Bordonabe designs is the same as the amended claim of the '012 Patent. Bordonabe fails the ordinary observer test and cannot act as a §102 reference for the '012 Patent.

Just as the addition of the holes and tenons in the amended claim of the '012 Patent prevent an ordinary observer from being deceived into thinking the design of the '012 Patent is the same as Bordonabe, these features make it impossible for Bordonabe to act as a primary reference. Bordonabe does not provide basically the same visual impression as the claimed design due to the substantial differences in their overall visual appearances, those substantial differences being increased by the addition of holes and tenons to the claim. For this reason, the amended claim addresses ground 5 of the IPR.

The addition of Galant to the obviousness analysis does nothing to remedy the failure of Bordonabe to act as a primary reference. Galant discloses a single piece table top, with no holes or tenons. The Galant design provides no additional missing claim elements that would advance an obviousness analysis including Bordonabe related to the amended claim of the '012 Patent. For this reason, the amended claim addresses ground 6 of the IPR.

2. Response to Institution

Patent Owner continues and maintains the arguments contained in their Preliminary Response regarding Bordonabe as anticipating or making obvious the design of the '012 Patent. Further, Patent Owner notes the Board's analysis suggesting that design B is the most pertinent reference. See *Decision Granting Institution*, IPR2023-00658, Paper 8, Page 46. Even if some of the Bordonabe designs may be more pertinent than others, none of the Bordonabe designs suggest or disclose the holes or tenons contained in the proposed claim amendments for the '012 Patent. Without these key details, each design disclosed in Bordonabe will fail the ordinary observer test and thus does not anticipate the amended claim of the '012 under 35 U.S.C. §102. The absence of any suggestion or disclosure of holes or tenons in Bordonabe as required by the proposed claim amendments for the '012 Patent further prevent the Bordonabe reference from acting as a primary reference in an obviousness analysis. Galant, which shows a single piece table top with no holes or tenons, provides no additional claim elements that would provide support to show the amended claim of the '012 Patent is obvious over the combination of Galant and Bordonabe.

C. Grounds 7, 8 and 9 – 35 USC §102/§103 – Iannoccone and Galant

1. Motion to Amend

Design patent Iannoccone illustrates an ornamental design for a folding table with a table top formed of two boards. These two boards may be folded down or propped up in a horizontal manner to form a contiguous table top. The figures of Iannoccone most relevant to this motion to amend are Figs. 1, 7, 8, 9 and 11. Each of these figures are shown below.

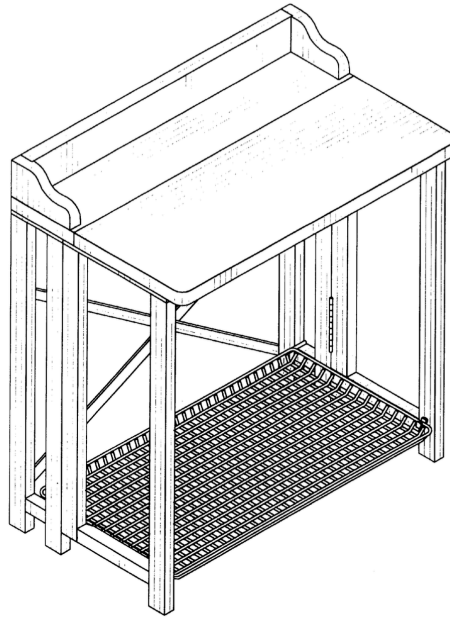


FIG. 1

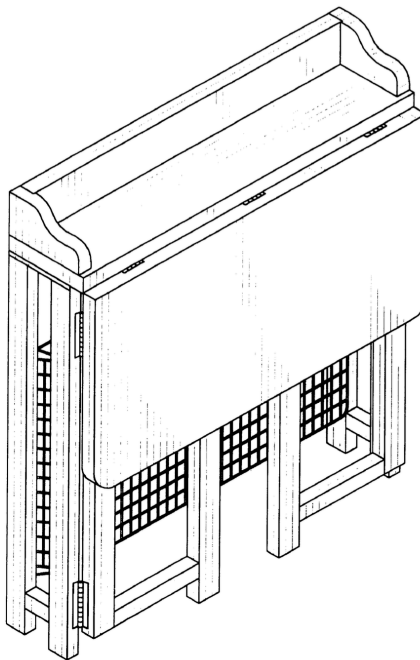


FIG. 7

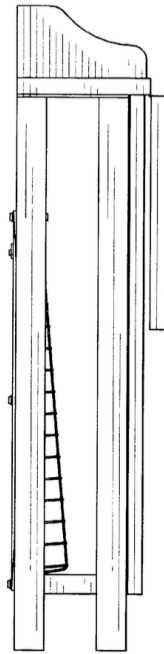


FIG. 8

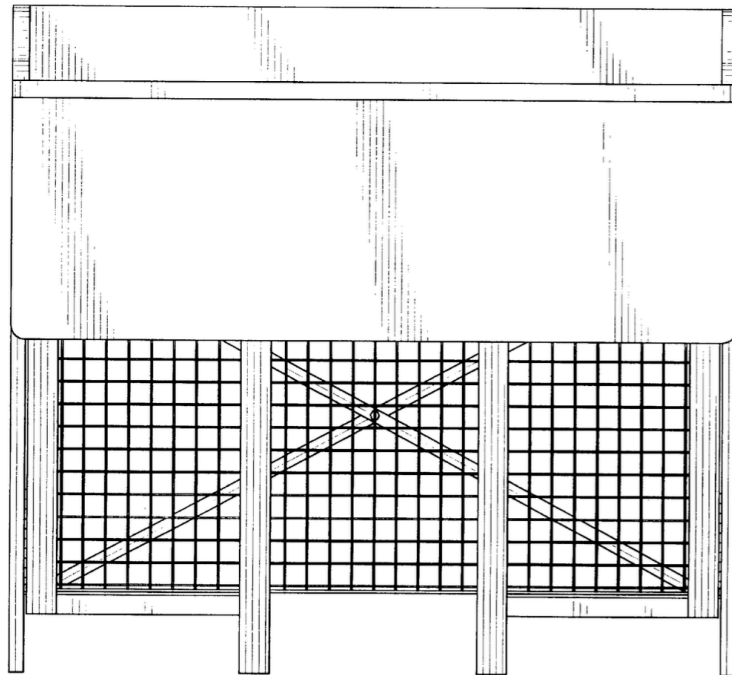


FIG. 9

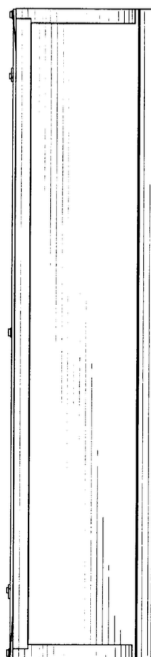


FIG. 11

The specification of Iannoccone includes the following descriptions of each figure:

FIG. 1 is a perspective view of the folding table of my design.

FIG. 7 is a perspective view of the folding table of my design, shown in a folded state.

FIG.8 is a right and left side elevation view of FIG.7.

FIG. 9 is a front elevation view of FIG. 7.

FIG.11 is a top plan view of FIG. 7.

See Iannaccone, Pg. 1. The figures and specification of Iannoccone do not disclose or suggest any holes or tenons between the two halves of the folding table top. The addition of the holes and tenons in the proposed amended claim of the '012 Patent further differentiate Iannoccone from the '012 Patent.

The Patent Owner further argues that the clear design differences between the amended claim of the '012 Patent and Iannaccone prevent Iannoccone from operating as a §102 reference under the Ordinary Observer test. Patent Owner argues that Petitioner will not be able to show that an ordinary observer would be deceived into believing the amended claim of the '012 Patent

is the same design as Iannaccone. Iannaccone fails the Ordinary Observer test applied to the ‘012 Patent.

Further, the design differences introduced with the addition of the holes and tenons of the amended claim prevent Iannaccone from operating as a primary reference in a properly applied §103 analysis. The holes and tenons create “substantial differences” between the visual appearance of the amended claim of the ‘012 Patent and Iannaccone such that they do not provide “basically the same visual impression” as each other. Without providing basically the same visual impression, Iannaccone cannot act as a primary reference under controlling precedent. *Spigen Korea Co. v. Ultraproof, Inc.*, 955 F. 3d 1379, 1383 (Fed. Cir. 2020).

Lastly, as discussed above, Galant discloses a single tabletop design, without two portions and does not disclose tenons or holes as required by the amended ‘012 Patent claim. Galant does nothing to remedy the lack of holes and tenons in Iannaccone and does nothing to further an obviousness analysis under applicable design patent case law.

The amended claim of the ‘012 Patent prevent Iannaccone from operating as a §102 under the Ordinary Observer test or as primary reference required in a §103 analysis. For these reasons, the proposed claim amendments address grounds 7 and 8 of the IPR. The addition of the Galant reference to a §103 analysis does not provide any of the missing elements from the amended claim of the ‘012 Patent. Thus, the proposed claim amendments address ground 9 of the IPR.

2. Response to Institution

Patent Owner continues and maintains the arguments contained in their Preliminary Response regarding the Ordinary Observer test and Iannaccone operating as a §102 anticipatory reference for the ‘012 Patent. Further, Patent Owner continues and maintains the arguments

contained in their Preliminary Response regarding Iannaccone being a primary reference in a §103 analysis or the combination of Iannaccone and Galant making obvious the design of the ‘012 Patent. The addition of the holes and tenons in the amended claim of the ‘012 Patent further differentiates the design of the ‘012 Patent from that of Iannaccone and Galant. The absence of any suggestion or disclosure of holes or tenons in Iannaccone, as required by the proposed claim amendments for the ‘012 Patent, prevent the Iannaccone reference from anticipating the amended claim of the ‘012 Patent under §102. Any comparison of the design of the amended claim of the ‘012 Patent and Iannaccone fails the Ordinary Observer test. Further, these differences prevent Iannaccone from acting as a primary reference in an obviousness analysis. Galant, which shows a single table top with no holes or tenons, provides no additional claim elements that would provide support to show the amended claim of the ‘012 Patent is obvious over the combination of Galant and Iannaccone.

VI. CONCLUSION

Patent Owner moves to amend the claims of the ‘012 Patent as outlined above and hereby requests the Board enter the proposed amendments. The proposed amendments are supported by the existing disclosure of the ‘012 Patent, introduce no new matter, and do not expand the scope of the claim. Further, the proposed amendments are responsive to and address each ground of unpatentability instituted in the IPR.

Date: November 21, 2023

Respectfully submitted,

By: /Robert McConnell/
Robert McConnell
Lead Counsel

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(a)(vi), the undersigned hereby certifies that the foregoing PATENT OWNER'S MOTION TO AMEND contains 24 pages, excluding parts of the Petition exempted under § 42.24(a)(1), as measured by the word-processing system used to prepare this paper.

Date: November 21, 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 November 21, 2023, a copy of the foregoing PATENT OWNER'S MOTION TO AMEND were served by email on Lead Counsel for Petitioner at the email address listed below:

P Andrew Riley (Reg. No. 66,290)
ariley@meimark.com
MEI & MARK LLP
818 18th Street NW, Suite 410 Washington, DC 20006
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Fax: 888-706-1173

Date: November 21, 2023

Respectfully submitted,

By: /Robert McConnell/
Robert McConnell
Lead Counsel