

UNITED STATES PATENT AND TRADEMARK OFFICE

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

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

v.

EP Family Corp.  
Patent Owner

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

---

**PETITIONERS' MOTION TO STRIKE**

**LIST OF EXHIBITS**

| <b><u>Exhibit</u></b> | <b><u>Description</u></b>                                                                                          |
|-----------------------|--------------------------------------------------------------------------------------------------------------------|
| Ex. 1001              | U.S. Design Patent No. D934,012 to Chang (“the ’012 patent”)                                                       |
| Ex. 1002              | Declaration of Expert Witness Paul Hatch (“Hatch”)                                                                 |
| Ex. 1003              | Resume and Prior Testimony of Paul Hatch                                                                           |
| Ex. 1004              | U.S Patent No. 476,400 to Morgan et al. (“ <i>Morgan</i> ”)                                                        |
| Ex. 1005              | Spanish Industrial Design No. I146513 to Muebles Bordonabe, S.A. (“ <i>Bordonabe Furniture</i> ”)                  |
| Ex. 1006              | U.S. Design Patent No. D424,325 to Iannacone (“ <i>Iannaccone</i> ”)                                               |
| Ex. 1007              | Ikea, <i>Table Galant</i> - \$149.00 / pieces (“ <i>Galant</i> ”)                                                  |
| Ex. 1008              | Affidavit of Nathaniel E. Frank-White                                                                              |
| Ex. 1009              | Complaint, Dkt. 1 in <i>EP Family Corp. v. Changzhou Win Up Time Tech. Co</i> , Case No. 2:22-cv-08192 (C.D. Cal.) |
| Ex. 1010              | Amazon product page for accused product, ASIN# B09JSBL7LH                                                          |
| Ex. 1011              | Supplemental Declaration of Paul Hatch (“Hatch Suppl.”)                                                            |
| Ex. 1012              | U.S. Patent No. 543,609 to Carter (“ <i>Carter</i> ”)                                                              |
| Ex. 1013              | EVANS BROS. LONDON, JOINTS IN WOODWORK (3d ed. 1920)                                                               |
| Ex. 1014              | United States Patent No. 666,435 to Oliver (“ <i>Oliver</i> ”)                                                     |
| Ex. 1015              | United States Patent No. 1,766,694 to Siskin (“ <i>Siskin</i> ”)                                                   |
| Ex. 1016              | Highlighted Version of Patent Owner’s MTA Reply                                                                    |

Petitioners respectfully request the Board strike the portions of Patent Owner's Reply in Support of Its Motion to Amend ("MTA Reply") and associated declaration evidence (Ex. 2006) identified below in Section I.A. The arguments and evidence do not relate to the amendments in Patent Owner's Motion to Amend ("MTA") and should have been submitted in Patent Owner's response to the petition, which was not filed in this proceeding.

**I. Patent Owner's Arguments Regarding Patentability of the Original Claim Should Be Stricken from the Record**

Patent Owner's MTA Reply raises arguments and introduces evidence regarding the patentability of the claim that do not relate to the amendments contained in Patent Owner's MTA. Instead, the arguments and evidence relate to whether Petitioner's primary references qualify as ones having the same overall visual appearance as the original, unamended claimed design—without regard to amendments contained in Patent Owner's MTA.

Most, if not all, of these improper arguments were raised over *nine months ago* in Patent Owner's Preliminary Response. Patent Owner, however, did not file a response to the petition. Nor did Patent Owner raise any of these arguments in its Motion to Amend. Instead, Patent Owner tactically waited until its MTA Reply to resurrect and further develop these arguments—none of which relate to the claim amendments. Patent Owner has waived these arguments by failing to respond to

the petition. Moreover, Petitioners are substantially prejudiced by Patent Owner's tactics because Petitioners have an abbreviated response period for its sur-reply when compared to the nearly three-month period for Petitioners' reply to Patent Owner's response to the petition. *See* Scheduling Order, Paper 9 at 11 (*compare* Due Dates 1 and 2). Petitioners are also prohibited from submitting additional evidence in connection with its sur-reply, and even if they could, would likely have had difficulty mustering such evidence in such an abbreviated time period.

Accordingly, the Board should strike Patent Owner's late submitted arguments regarding patentability that do not relate in any way to the amendments submitted in Patent Owner's Motion to Amend. Consolidated Trial Practice Guide at 94 ("any arguments for patentability not raised in the response may be deemed waived.")

**A. Specific Portions of Patent Owner's MTA Reply and Evidence Should Be Stricken**

Petitioners submit that the Board should strike the following portions of Patent Owner's MTA Reply and Mr. William's declaration (Ex. 2006). For ease of reference, the argument below places the portions of the MTA Reply in proximity to their associated discussion in Mr. William's declaration. Petitioners have also included Exhibit 1016, which is a copy of Patent Owner's MTA Reply with the

below-identified portions highlighted. The highlighted portions of Exhibit 1016 should be stricken as well if the Board grants this motion.

| ID | Document  | Page # | Specific Identification                                                                                                                      |
|----|-----------|--------|----------------------------------------------------------------------------------------------------------------------------------------------|
| 1  | MTA Reply | 9-10   | Last full paragraph and final paragraph running onto page 10: “ <i>Morgan</i> discloses . . . always attached to each other”                 |
| 2  | Ex. 2006  | 24-26  | ¶¶61-63                                                                                                                                      |
| 3  | MTA Reply | 10     | Parts of first full paragraph:<br>“In contrast . . . after assembly.”<br><br>“After assembly, the table top . . . after assembly states”     |
| 4  | MTA Reply | 12     | Last full paragraph: “Petitioner cites four table designs . . . not reach the edge.”                                                         |
| 5  | Ex. 2006  | 26-30  | ¶¶64-73                                                                                                                                      |
| 6  | MTA Reply | 13     | Last full paragraph: “Design patent <i>Iannoccone</i> . . . vertically when folded”                                                          |
| 7  | MTA Reply | 14     | First two paragraphs: “Focusing solely on . . . 76-77.”                                                                                      |
| 8  | MTA Reply | 14-15  | Part of last paragraph: “Further, <i>Iannaccone</i> . . . different visual impression than that of the ‘012 Patent. <i>Id.</i> at ¶¶ 80-83.” |
| 9  | Ex. 2006  | 30-35  | ¶¶74-83                                                                                                                                      |

**B. Patent Owner's Arguments Were Previously Raised and Waived**

Patent Owner was warned on numerous occasions that arguments raised in its preliminary response that are not re-raised in a response to the petition are waived. The scheduling order states that “Patent Owner is cautioned that any arguments not raised in the response may be deemed waived,” in connection with Due Date 1, the date for Patent Owner’s response to the petition. Scheduling Order, Paper 9 at 9. Similarly, the Consolidated Trial Practice Guide states that “any arguments for patentability not raised in the response may be deemed waived.” Consolidated Trial Practice Guide at 94. It further states that “a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.” *Id.* at 74. “The Board is not required to attempt to sort proper from improper portions of the reply or sur-reply.” *Id.*

The caselaw is also clear that new or abandoned arguments raised again for the first time on reply to a motion to amend are waived. For instance, the Board in *3M Company* granted a motion to strike where the Patent Owner raised a new argument in its MTA reply and MTA sur-reply. *3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, Paper 45 at 2-7 (P.T.A.B. Apr. 26, 2019).

Despite these warnings, Patent Owner decided not to submit a Patent Owner response. In doing so, Patent Owner waived “any arguments for patentability not raised in [its] response.” Consolidated Trial Practice Guide at 74.

Most, if not all of Patent Owner's arguments were known to Patent Owner over **nine months ago**, when Patent Owner filed its preliminary response. For example, the arguments and associated evidence in items #1-2 in the above table (Section I.A) contend that Morgan is not a suitable primary reference because it is a folding table with two states. But Patent Owner presented nearly identical arguments about Morgan being a folding table with legs and other mechanical features in its preliminary response. *See* Preliminary Response, Paper 7 at 18-20 ("Morgan clearly discloses a folding table with a variety of potential positions for the leaves").

Similarly, the arguments and associated evidence in items #4-5 in the above table discuss five alleged differences between *Bordonabe Furniture* and the '012 patent. Those exact same five alleged differences were raised over nine months ago in the preliminary response. *See id.* at 28-29 (listing first 3 differences word-for-word and noting the last two differences in the second to last sentence); *see also id.* at 27-35 (similar discussion for other *Bordonabe Furniture* designs).

Likewise, the arguments and associated evidence in items #6, 7, and 9 were raised in the preliminary response. *Id.* at 35-37. In fact, the six alleged differences Patent Owner enumerates on page 13 of its MTA Reply were listed, literally word-for-word and likely copy/pasted, on page 36 of its preliminary response.

What’s worse, the Board specifically discussed the above issues in the Institution Decision and noted the “interesting issue with respect to design patent analysis” of “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 the prior art references have these features and are therefore different.” Institution Decision, Paper 8 at 25 (emphasis in original). The Board invited further briefing regarding the topic, stating that it “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.” *Id.* at 40. In spite of this invitation to further develop the arguments in the preliminary response, Patent Owner chose to abandon them by not filing a response to the petition. Instead, Patent Owner tactically waited until its MTA Reply—over nine months later—to reassert these previously abandoned arguments and attempt to submit additional declaration evidence in support.

In view of the above, Patent Owner has abandoned/waived its arguments that it previously raised in connection with the preliminary response, including those contained in items #1-2, 4-7, and 9 in the above table. The Board should therefore strike these portions.

**C. New Arguments Unrelated to the Claim Amendments Should Have Been Raised Earlier**

Items #3 and 8 in the above table (Section I.A) include both (1) arguments that Patent Owner previously presented in its preliminary response and (2) a single new argument: that the prior art does not disclose assembled and unassembled states. This single new argument, however, does not relate to the amendments in the motion to amend; i.e., the addition of holes and tenons to the claimed design. This new argument relates solely to the patentability of the original claim, without any amendment, like the ones Patent Owner previously presented and waived.

Even a cursory review of the portions identified in items #3 and 8 reveals that they do not relate in any way to the added holes or tenons. Rather, they focus on the existence of multiple views in the original, unamended claim, allegedly showing the two tabletop pieces as separate pieces. Thus, Patent Owner's argument regarding assembled and unassembled states does not relate in any way to its claim amendment: the addition of holes and tenons.

The Board should strike these arguments as well because they should have been presented in Patent Owner's response to the petition. The arguments differ from the ones discussed in the previous section in only one way: they were omitted from the preliminary response. But Patent Owner nonetheless should have

presented them in its response to the petition nearly five months ago. *See* Scheduling Order, Paper 9 at 11 (Due Date 1 set as November 24, 2023).

**D. Patent Owner's Arguments and Evidence Substantially Prejudice Petitioners**

Petitioners suffer substantial prejudice from Patent Owner's late submission of arguments/evidence regarding patentability that relate in no way to the MTA amendments. Had Patent Owner presented these arguments and evidence in its response to the petition, Petitioners would have had nearly 3 months to muster evidence, depose Patent Owner's declarant, and draft a response. Instead, Patent Owner waited until the eve of trial, with oral argument scheduled less than a month from the date of this motion. Scheduling Order, Paper 9 at 11 (May 16, 2024).

As a result, Petitioners had only half the time available to it to muster a response. *Id.* at 11 (*compare* Due Date 3 with Due Date 2). Moreover, while Petitioners would have been able to submit additional declaration evidence had Patent Owner filed a response to the petition (Consolidated Trial Practice Guide at 73), Petitioners are prohibited from submitting additional evidence with their sur-reply. *See* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9497, 9500 (Mar. 15,

2019)(“Generally speaking, new evidence (including declarations) may be submitted with every paper in the MTA process, except a sur-reply.”).

Thus, Petitioners are prejudiced by Patent Owner’s tactical decision to wait until its MTA reply to raise the above-noted arguments and evidence, making this motion Petitioners’ only viable remedy.

## **II. Conclusion**

For the above reasons, Petitioners respectfully request that the Board strike the arguments contained in Patent Owner’s Reply in Support of its Motion to Amend and associated evidence, as identified above in Section I.A.

Date: April 17, 2024

Respectfully submitted,

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

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on April  
, 2024, a copy of the foregoing **PETITIONERS' MOTION TO STRIKE**  
and associated Exhibit 1016 were served by electronic mail on Patent Owner at the  
following addresses:

Robert McConnell  
robert@mcconnellfirm.com

Tommy SF Wang  
twang@thewangiplaw.com

Date: April 17, 2024

Respectfully submitted,

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