

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 OPPOSITION TO
PETITIONER'S MOTION TO STRIKE**

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EXHIBIT LIST

Exhibit No.	Description
2001	Translation of Bordonabe Furniture
2002	Office Action, App. No. 29/693,716 Prosecution History, June 25, 2021
2003	Notice of Cited References, App. No. 29/693,716 Prosecution History, Apr. 21, 2021 and Oct. 1, 2021
2004	U.S. Patent No. 2,755,153 to J. Pucci et al. (the “153 Patent”)
2005	U.S. 2,715,558 to Bell (the “558 Patent”)
2006	Declaration of Expert Witness Robert Williams
2007	Curriculum Vitae of Expert Witness Robert Williams
2008	Albert Jackson, David Day, and Simon Jennings, <i>The Complete Manual of Woodworking</i> (1989)
2009	<i>Fine Woodworking on Joinery</i> (1985)
2010	James Krenov, <i>The Impractical Cabinetmaker</i> 19 (1993)
2011	Chris Marshall, <i>Accounting for Cross-grain Wood Movement on Breadboard Ends?</i> , Woodworkers Journal, (Feb 15, 2015) https://www.woodworkersjournal.com/accounting-cross-grain-wood-movement-breadboard-ends/
2012	Gary Rogowski, <i>The Complete Illustrated Guide to Joinery</i> (2002)
2013	Rockler, <i>Beadlock® Tenon Stock</i> (Last accessed March 26, 2024) https://www.rockler.com/beadlockreg-tenon-stock
2014	<i>Lamello Catalogue 2015/2016</i> (2015)

I. INTRODUCTION

Patent Owner respectfully requests that the Board deny Petitioner's Motion to Strike portions of Patent Owner's Reply to Petitioner's Opposition to Motion to Amend ("MTA Reply"). The arguments and evidence referenced in Petitioner's Motion are responsive to arguments made by Petitioner in its Opposition to the Motion to Amend ("MTA Opposition") and thus are timely submitted in the MTA Reply. There is no prejudice to Petitioner as they been given ample notice of the referenced arguments and evidence with an opportunity to respond in their sur-reply brief. Rather than simply respond or seek a more appropriately tailored solution, Petitioner seeks the exceptional and inappropriate remedy of striking portions of Patent Owner's MTA Reply. For these reasons, Petitioner's Motion to Strike should be denied.

II. THE REFERENCED ARGUMENTS AND EVIDENCE ARE RESPONSIVE TO PETITIONER'S MTA OPPOSITION.

Petitioner identifies nine identified sections of the MTA Reply to be stricken in their Motion. See *Motion to Strike*, Pg.3. For sake of brevity, Patent Owner will utilize the same ID numbers outlined in Petitioner's Motion. The referenced arguments and evidence will be referred to collectively as the "Referenced Arguments."

A reply may respond to arguments raised in the preceding brief. See 37 C.F.R. §42.23(b), *Consolidated Trial Practice Guide, November 2019*, Pg. 74 ("TPG"). Patent Owner will show that each of the Referenced Arguments is responsive to an argument and/or evidence presented in Petitioner's MTA Opposition. As such, they are appropriate in the MTA Reply and should not be stricken.

Petitioner argues six grounds of unpatentability in their MTA Opposition, each based on a claim of obviousness under 35 U.S.C. §103. Each of these grounds involve a primary reference and a secondary reference, as does any design patent obviousness analysis. The Referenced

Arguments each directly relate to one of Petitioner’s grounds of unpatentability, the arguments and evidence presented therein, and specifically whether the cited reference properly operates as a Primary Reference. The chart below shows how each of the Referenced Arguments relate to the arguments made in the Petitioner’s MTA Opposition.

ID	Responding to Petitioner Argument	Citation(s) to Petitioner’s MTA Opposition and Supplemental Declaration of Paul Hatch
1	Ground 1: §103 <i>Morgan and Carter</i> Ground 2: §103 <i>Morgan, Galant, and Carter</i>	<i>MTA Opposition</i> , Pages 13 – 18, <i>Supplemental Declaration of Paul Hatch</i> , ¶¶61 – 67 (“Supp. Hatch Decl.”)
2	Ground 1: §103 <i>Morgan and Carter</i> Ground 2: §103 <i>Morgan, Galant, and Carter</i>	<i>MTA Opposition</i> , Pages 13 – 18, <i>Supp. Hatch Decl.</i> , ¶¶61 – 67.
3	Ground 1: §103 <i>Morgan and Carter</i> Ground 2: §103 <i>Morgan, Galant, and Carter</i>	<i>MTA Opposition</i> , Pages 13 – 18, <i>Supp. Hatch Decl.</i> , ¶¶61 – 67.
4	Ground 3: §103 <i>Bordonabe Furniture and Carter</i> Ground 4: §103 <i>Bordonabe Furniture, Galant, and Carter</i>	<i>MTA Opposition</i> , Pages 18 – 21, <i>Supp. Hatch Decl.</i> ¶¶68 – 80.
5	Ground 3: §103 <i>Bordonabe Furniture and Carter</i> Ground 4: §103 <i>Bordonabe Furniture, Galant, and Carter</i>	<i>MTA Opposition</i> , Pages 18 – 21, <i>Supp. Hatch Decl.</i> ¶¶68 – 80.
6	Ground 5: §103 <i>Iannaccone and Carter</i> Ground 6: §103 <i>Iannaccone, Galant, and Carter</i>	<i>MTA Opposition</i> , Pages 21 – 25, <i>Supp. Hatch Decl.</i> ¶¶81 – 90.
7	Ground 5: §103 <i>Iannaccone and Carter</i> Ground 6: §103 <i>Iannaccone, Galant, and Carter</i>	<i>MTA Opposition</i> , Pages 21 – 25, <i>Supp. Hatch Decl.</i> ¶¶81 – 90.

8	Ground 5: §103 <i>Iannaccone</i> and <i>Carter</i> Ground 6: §103 <i>Iannaccone</i> , <i>Galant</i> , and <i>Carter</i>	<i>MTA Opposition</i> , Pages 21 – 25, <i>Supp. Hatch Decl.</i> ¶¶81 – 90.
9	Ground 5: §103 <i>Iannaccone</i> and <i>Carter</i> Ground 6: §103 <i>Iannaccone</i> , <i>Galant</i> , and <i>Carter</i>	<i>MTA Opposition</i> , Pages 21 – 25, <i>Supp. Hatch Decl.</i> ¶¶81 – 90.

As outlined above, each Referenced Argument is responsive to an argument made in Petitioner’s MTA Opposition. Further, most of these arguments have been made previously in Patent Owner’s Preliminary response and Motion to Amend. Petitioner has ample notice of these arguments, opportunities to address them in their MTA Opposition and future ability to respond in their upcoming sur-reply. There is no prejudice to Petitioner to have these arguments raised at this stage in the proceeding. Rather than focus their efforts on briefing arguments related to their grounds of unpatentability, they choose to make an inappropriate motion to strike relevant arguments against their alleged grounds and complain about lack of time to develop those arguments.

III. THE REFERENCED ARGUMENTS WERE NOT WAIVED

Patent Owner has not waived any arguments about the suitability of *Morgan*, *Bordonabe Furniture* or *Iannaccone* as primary references. Each of these arguments are referenced and discussed in Patent Owner’s Motion to Amend (“MTA”). See *Motion to Amend*, Pages 13 – 24. These arguments have been made and renewed by Patent Owner at every stage of this process. The Petitioner has been on notice of Patent Owner’s arguments and simply cannot claim to be prejudiced by renewal of the same arguments used throughout this proceeding. Further, in its MTA Opposition, again cites *Morgan*, *Bordonabe Furniture*, and *Iannaccone* as primary

references to *Carter*, their claimed secondary reference. Patent Owner has a clear right to dispute and provide evidence for any arguments raised by Petitioner in their MTA Opposition, which has been done in the MTA Reply. Claiming surprise and lack of time to respond to arguments that have been part of the record for nearly the entire pendency of this proceeding should not be rewarded with the exceptional remedy of striking content from Patent Owner's briefs and exhibits. Petitioner has an opportunity to respond to the arguments in their sur-reply brief.

The case cited by Petitioner to justify its motion to strike, *3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, Paper 45 at 2-7 (P.T.A.B. Apr. 26, 2019) is distinguishable on the facts of the case. There, the Patent Owner raised an entirely new argument in their MTA Reply brief. In our case, these arguments are not new and have been raised at each stage of the process. Patent Owner has been continuously crystalizing the issues related to patentability for decision by the Board. *Morgan*, *Bordonabe Furniture*, and *Iannaccone* do not operate as primary references for the numerous reasons outlined repeatedly in its briefs, especially in relation to the proposed amended claim. As a claimed secondary reference, *Carter* does nothing to remedy the deficiencies.

Lastly, to the extent there is a new argument is included related to *Morgan*, *Bordonabe Furniture*, and *Iannaccone* status as primary references, which Patent Owner does not concede, the appropriate remedy would be expanded briefing page limits briefing or a request to submit a second supplemental expert declaration with the Petitioner's sur-reply. Striking a portion of a brief is an exceptional remedy that the Board expects to grant rarely.

IV. STRIKING A PORTION OF A BRIEF IS AN EXCEPTIONAL REMEDY

“Striking the entirety of or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely.” See *TPG*, Pg. 80. “A motion to strike may be appropriate when a party believes the Board should disregard arguments or late-filed evidence in its entirety, whereas further briefing may be more appropriate when the party wishes to address the proper weight the Board should give to the arguments or evidence. In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply.” *Id.*

Petitioner has prior authorized sur-reply brief in which it may present arguments responsive to the MTA Reply. If the existing page limits or other restrictions do not allow for full development of those arguments, the correct remedy would be to request authorization for additional briefing or a waiver. If presented with a reasonable request, Patent Owner may be willing to stipulate to such a request.

Lastly a survey of Motion to Strike Board decisions show that they are generally granted related to a sur-reply brief when the other party has no opportunity to respond. See *Apple Inc. v. Parus Holdings, Inc.*, IPR 2020-00686, Paper 31 at 6 (P.T.A.B. June 10, 2021), *Shenzen Chic Electrics Co. LTD. v. Pilot, Inc.*, IPR-2021-01232, Paper 20 (P.T.A.B. Sept. 22, 2022), *Chanel, Inc. v. Molo Design, LTD.*, IPR2022-00543, Paper 34 at 5 (P.T.A.B. May 10, 2023).

V. CONCLUSION

For the foregoing reasons, Petitioner’s Motion to Strike should be denied.

Date: April 24, 2024

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 OPPOSITION TO PETITIONER'S MOTION TO STRIKE contains 5 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: April 24, 2024

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 April 24, 2024, a copy of the foregoing PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE were served by email on Lead Counsel for Petitioner at the email address listed below:

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