

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' NOTICE OF SUPPLEMENTAL AUTHORITY

Petitioners respectfully submit this notice of supplemental authority regarding *LKQ Corp. v. GM Global Tech Operations LLC*, 2021-2348 (Fed. Cir. May 21, 2024). *LKQ Corp.* issued on May 21, 2024, after the hearing in this case.

In *LKQ Corp.*, the Federal Circuit relaxed the requirements for design patent obviousness, “conclud[ing] that the *Rosen-Durling* test requirements—that (1) the primary reference be ‘basically the same’ as the challenged design claim; and (2) any secondary references be ‘so related’ to the primary reference that features in one would suggest application of those features to the other—are improperly rigid.” *Id.* at 15. The Federal Circuit clarified that obviousness of a patented design is determined based on application of the *Graham* factors that have been developed as analytical tools for reviewing the validity of a utility patent under § 103. *Id.* at 19.

Regarding the first *Rosen-Durling* requirement that the primary reference be “basically the same” as the claimed design, the Federal Circuit clarified that the requirement that “a single primary reference discloses nearly every aspect of the claimed design—does not fit all obviousness scenarios for designs and cannot be reconciled with Supreme Court precedent.” *Id.* at 17. “Rather, an analogous art requirement applies to each reference.” *Id.* at 19.

Regarding the second *Rosen-Durling* requirement, the Federal Circuit explained that the “so related” requirement was inconsistent with the Supreme

Court's decision in *Smith v. Whitman Saddle*, 148 U.S. 674 (1893), which "relied on the knowledge and practice of a saddler or ordinary workman of the trade instead of a 'so related' requirement to combine prior art references." *Id.* at 18-19.

LKQ Corp. is relevant to the arguments raised by Patent Owner regarding whether each reference "operate[s] as a primary reference." See MTA Reply at 8, 9-10 (*Morgan*), 12 (*Bordonabe Furniture*), 13-14 (*Iannaccone*). Specifically, Patent Owner has argued that various (unclaimed) differences between the primary references and the claimed design disqualify the references as primary references. *Id.* After *LKQ Corp.*, there is no longer a threshold requirement that the primary references qualify as such based on a "basically the same" requirement and instead the references need only be analogous art. *LKQ Corp.* at 19. All of the primary references here qualify as analogous art because they are references showing tabletops.

Regarding the secondary references (*Carter* and *Galant*), Patent Owner has not argued that they do not qualify as secondary references. In any event, they also qualify as analogous art because they are references regarding tabletops.

Date: July 12, 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 July 12, 2024, a copy of the foregoing **PETITIONERS' NOTICE OF SUPPLEMENTAL AUTHORITY** was served by electronic mail on Patent Owner at the following addresses:

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Date: July 12, 2024

Respectfully submitted,

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