

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 RESPONSE TO PETITIONER'S
NOTICE OF SUPPLEMENTAL AUTHORITY**

Patent Owner respectfully submits this response to Petitioner’s Notice of Supplemental Authority (“Notice”) regarding *LKQ Corp. v. GM Global Tech Operations LLC*, 2021-2348 (Fed. Cir. May 21, 2024). In its Notice, Petitioner outlines the relevance of *LKQ Corp.* to the obviousness claims in the present action. Patent Owner does not dispute this. There is no doubt of the impact that the overruling and replacement of the *Rosen-Durling* test will have on design patent obviousness analysis at all levels of review, including during this IPR proceeding.

Replacement of the test with the *Graham* obviousness factors utilized for utility patents provides familiarity with the factors and their application, but the wholesale replacement of one legal test with another introduces significant uncertainty into the system, especially in pending litigation before the Patent Trial and Appeal Board. The Federal Circuit discussed that impact and uncertainty in their opinion, *id.* at 28 – 29, and we await the Board’s further proceedings in the *LKQ Corp.* matter for guidance on how to proceed under this new legal framework.

Although Patent Owner does not dispute the relevance of *LKQ Corp.* to the present case, Patent Owner does dispute Petitioner’s characterization of the case and application to the facts in the current record. The facts of record were developed with the *Rosen-Durling* test as the controlling test for design patent obviousness, and an opportunity to argue the application of the *Graham* obviousness standard, new to design patents, to the necessarily augmented record, is needed to fully adjudicate Petitioner’s obviousness allegations.

Accordingly, Patent Owner respectfully requests that the Board order any additional arguments and briefing necessary to apply the new obviousness standard to the present case.

Date: July 19, 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 July 19, 2024, a copy of the foregoing PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE OF SUPPLEMENTAL AUTHORITY were served by email on Lead Counsel for Petitioner at the email address listed below:

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Date: July 19, 2024

Respectfully submitted,

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