

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.

IPR2023-00658
Patent No. D934,012 S

Before JOSIAH C. COCKS, SCOTT A. DANIELS, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Granting In-Part and Denying In-Part Patent Owner's
Noncontingent Motion to Amend
35 U.S.C. § 318(a)

I. INTRODUCTION

Hangzhou Taihe Trading Co., LTD. & Ningbo Likeju Trading Co., LTD. (“Hangzhou” or “Petitioner”) filed a Petition requesting *inter partes* review of the sole claim of U.S. Patent No. D934,012 S (Ex. 1001, “the ’012 patent”). Paper 3 (“Pet.”). EP Family Corp., (“EP” or “Patent Owner”) filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”).

Following our Institution Decision (Paper 8, “Inst. Dec.”), Patent Owner did not file a Patent Owner Response, and instead filed a noncontingent Patent Owner’s Motion to Amend (Paper 11, “Mot. to Amend” or “Mot.”).¹ Petitioner filed Petitioner’s Opposition to Patent Owner’s Motion to Amend (Paper 13, “Opp.”). Patent Owner subsequently filed Patent Owner’s Reply to Petitioner’s Opposition to Motion to Amend (Paper 14., “Reply Opp.”), and Petitioner filed Petitioner’s Sur-Reply to Patent Owner’s Reply to Opposition to Motion to Amend (Paper 20).

An oral hearing was held on May 16, 2024. A transcript of the hearing has been entered as Paper 23. (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). In summary, we *grant in-part* Patent Owner’s Noncontingent Motion to Amend canceling the original claim of the ’012 patent. As a result, we do not reach the unpatentability grounds asserted in the Petition against the original claim. We also *deny in-part* Patent Owner’s Noncontingent Motion to Amend as to

¹ Following a telephone conference with the parties’ counsel, we entered an Order on December 14, 2023 clarifying that Patent Owner’s Motion to Amend sought to replace the original claim in the ’012 patent with the proposed substitute claims and was *noncontingent*. By its nature, a noncontingent motion to amend is a request to cancel the original claim in reliance on the proposed substitute claim. Paper 12; 37 CFR § 42.121(a)(3).

adding the proposed substitute claim to the '012 patent because the proposed substitute claim is indefinite under 35 U.S.C. § 112. Because the proposed substitute claim is indefinite, we do not reach Petitioner's obviousness grounds asserted in the Opposition against the proposed substitute claim under 35 U.S.C. § 103.

A. Real Parties in Interest

Petitioner states that it is the real party in interest. Pet. 57. Patent Owner states that it is the real party in interest. Paper 4.

B. Related Matters

The parties indicate that the '012 patent has been asserted against the defendant in *EP Family Corp. v. Changzhou Win Up Time Technology Co., Ltd, et al.*, Case No. 2:22-cv-04242 (C.D. Cal.) (“the infringement action”). Pet. 81; Paper 6.

II. PROPOSED SUBSTITUTE CLAIM

The Motion to Amend proposes to “amend the drawings of the '012 Patent to amend the scope of the claimed invention” in the '012 patent. Mot. 4, 6–12. Specifically, Patent Owner proposes to amend Figures 1, 6, 8, 9, and 14 by adding tenons and holes—which were originally drawn in broken lines and not part of the claimed design. *Id.* at 6–12 (amending Figures 1, 6, 9, and 14 to include holes and amending Figure 8 to include tenons); *see* Ex. 1001, code (57) (“The broken line portions of the table top in FIGS. 1-23 represent portions of the article that form no part of the claim.”). For the reasons below, we determine the proposed substitute claim is indefinite under 35 U.S.C. § 112 and *deny* the Motion to Amend. As a result, we do not reach the obviousness grounds asserted in the Opposition against the proposed substitute claim under 35 U.S.C. § 103.

A. The '012 Patent (Ex. 1001) and Proposed Substitute Claim

Petitioner challenges the proposed substitute claim in the '012 patent, issued October 26, 2021. Titled “Table Top,” the claim recites “[t]he ornamental design for a table top, as shown and described.” Ex. 1001, code (54), (57), Figs. 1–23.² Selected drawings, beginning with Figure 23, illustrating the proposed substitute claim for the ornamental design for the table top are reproduced below:

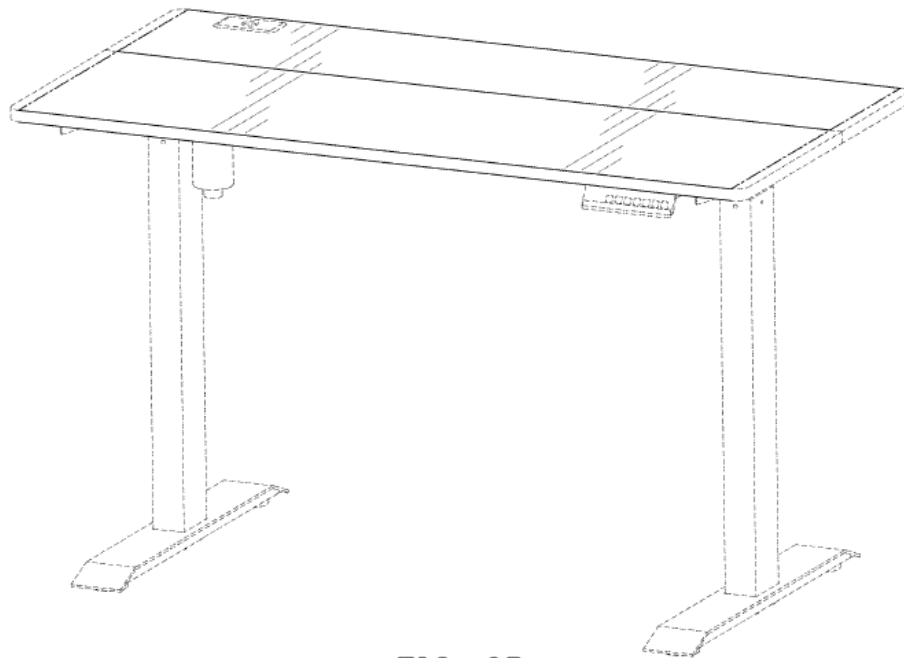


FIG. 23

Figure 23 is a perspective view of the claimed tabletop “shown in an environment of use.” *Id.* code (57). As shown in the drawings, the table top illustrates a wider portion and a narrower portion.

In addition to the table legs, we point out that both ends of the claimed table top are illustrated by broken lines, as well as dot-dashed broken lines.

² We use the term “claim” and “proposed substitute claim” interchangeably because in a noncontingent motion to amend the original claim is necessarily canceled.

The '012 patent describes that “[t]he broken line portions of the table top in FIGS. 1-23 represent portions of the article that form no part of the claim.”

Id. The '012 patent further describes that “[t]he 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.” *Id.*; *see* 37 C.F.R. § 1.152; *see also* Manual of Patent Examining Procedure (MPEP) § 1503.02, Subsection III (“Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”).

Figure 16 is reproduced below as annotated by the Board. Ex. 1001, Fig. 16.

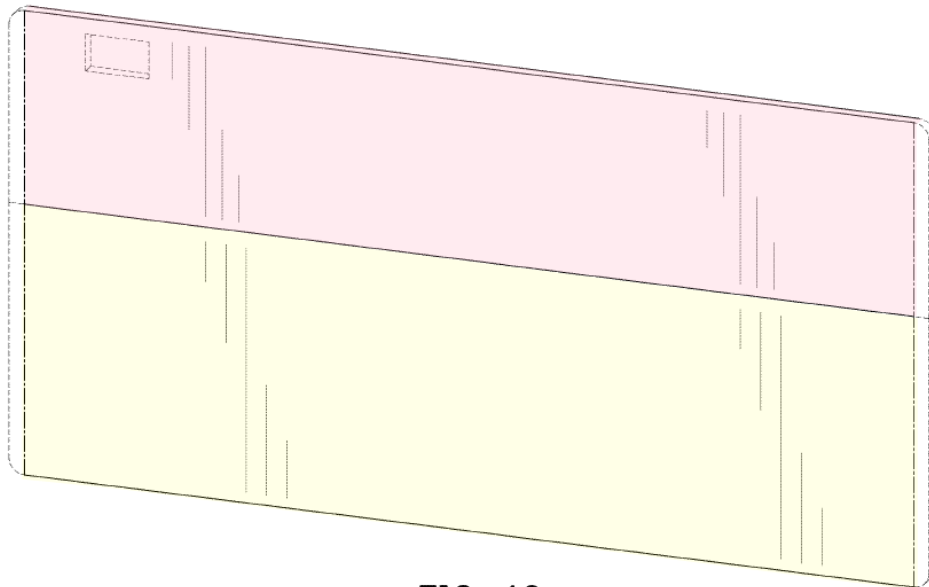


FIG. 16

Figure 16, above, is an annotated perspective view of the claimed table top including wider portion (yellow) and narrower portion (pink).³ *Id.*



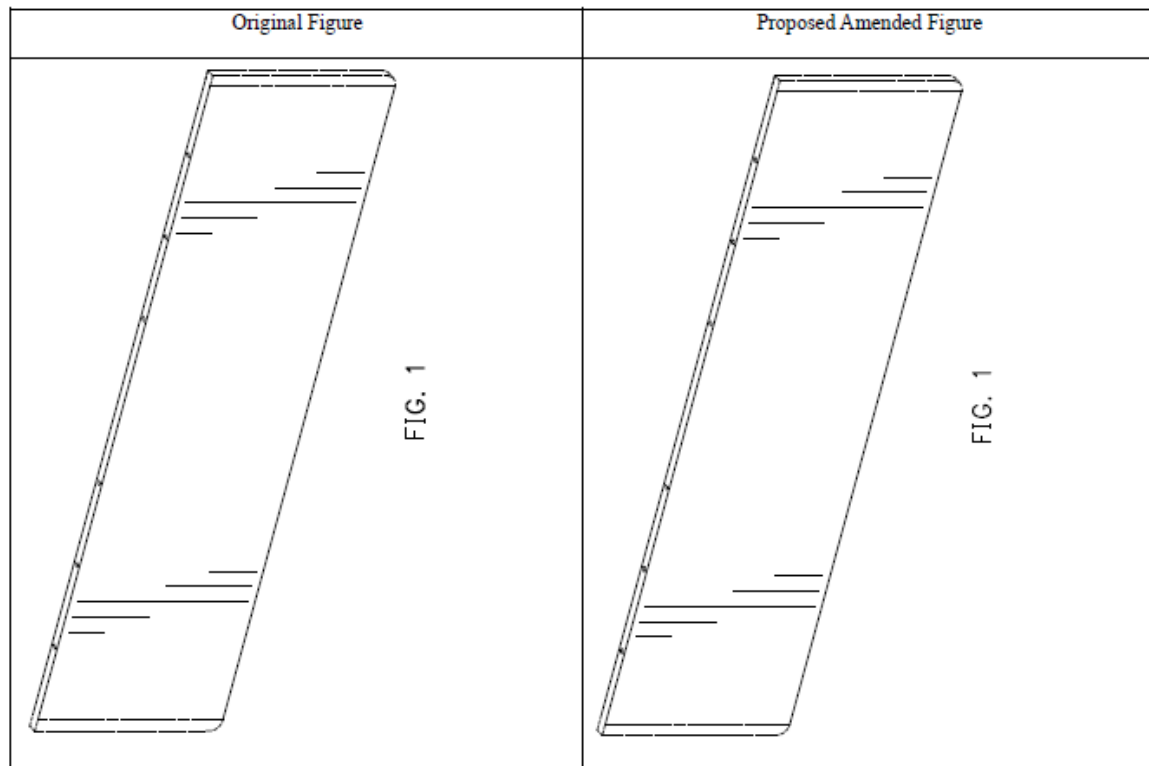
FIG. 17

Figure 17, above, is a front view of the table top illustrating the relative proportions of the wider and narrower portions of the table top as they are joined together. *See id.*

Different from Figures 16–23 illustrating the complete table top, Figures 1–8 depict separate views of the wider portion of the table top while Figures 9–15 depict various views of the narrower portion of the table top. *Id.* In its noncontingent Motion to Amend, Patent Owner amended Figures 1, 6, 8, 9, and 14 to change the dashed lines depicting certain of the holes (Figures 1, 6, 9, 14) and tenons (Figure 8) to solid lines. Mot. to Amend 6–12. Because certain figures are critical to our analysis in this case, we reproduce below Patent Owner’s comparison of amended and original

³ The ’012 patent confusingly refers to the wider portion as the “top portion” and the narrower portion as the “bottom portion” of the claimed table top. Ex. 1001, Description. We will more accurately describe these as the “wider portion” and the “narrower portion” of the table top respectively.

Figures 1 and 8 showing the wider portion of the table top, along with exploded partial views of amended Figures 1, 6, 8, 9, and 14.



PO Resp. 8. Patent Owner explains that proposed amended Figure 1 includes “[r]emoval 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.” *Id.* at 6.

Where in the comparison figures it is difficult to see the actual amendments, we reproduce enlarged, rotated, and annotated, partial views of amended Figures 1 and 6 below.

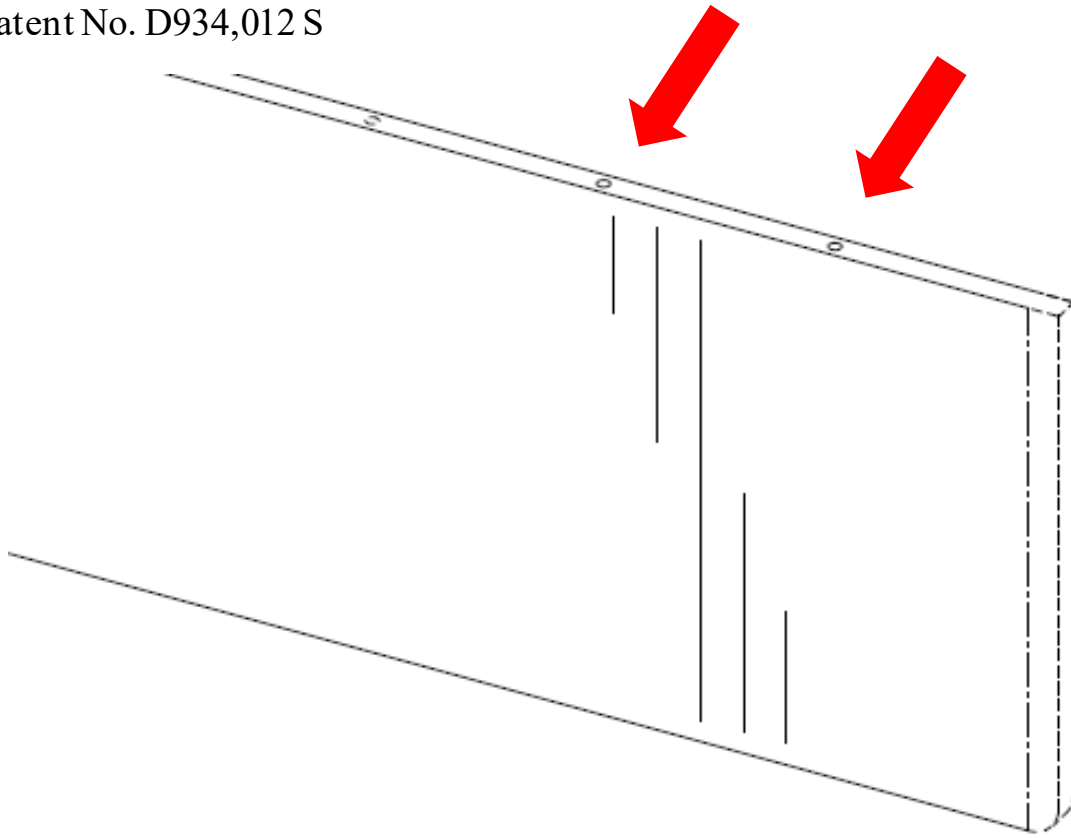
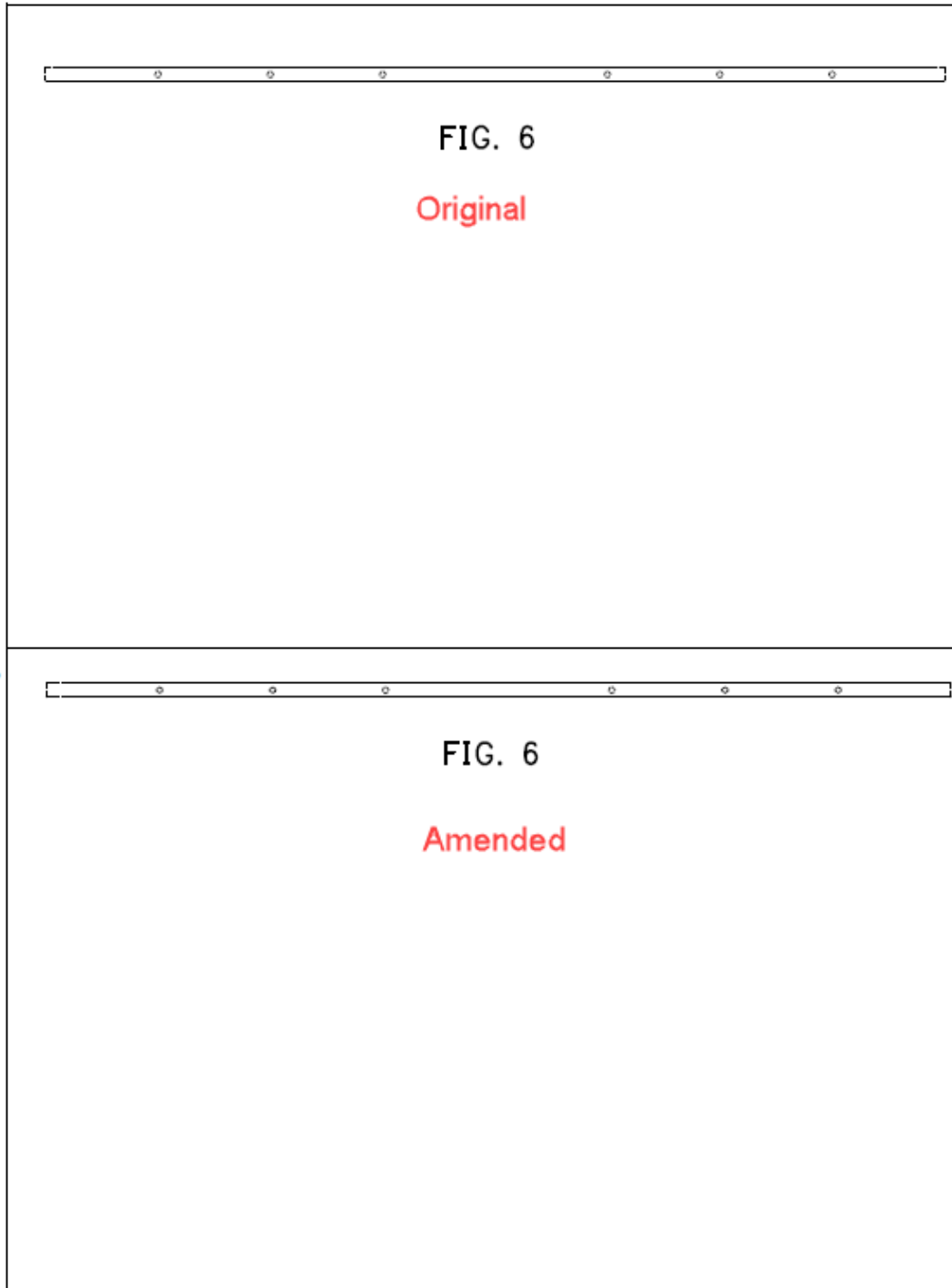


FIG. 1

Annotated amended Figure 1 illustrates, now in solid lines, two of three holes, as pointed to by red arrows, located closest to the right end of the table top. Not shown in this enlarged annotated figure 1, two of the three holes located closest to the left end of the table top are also illustrated by solid lines.

Patent Owner's comparison of amended Figure 6 and original Figure 6 with annotations by the Board is reproduced below.



Patent Owner explains that amended Figure 6 includes

[r]emoval 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.

Id. at 6. Because it is difficult to see in the comparison view, an enlarged and annotated partial view of amended Figure 6 is reproduced below.

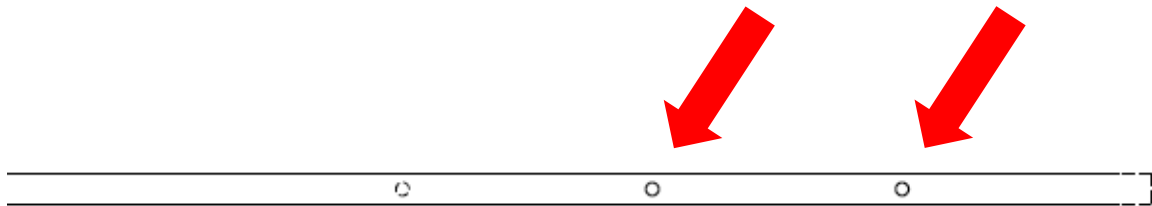
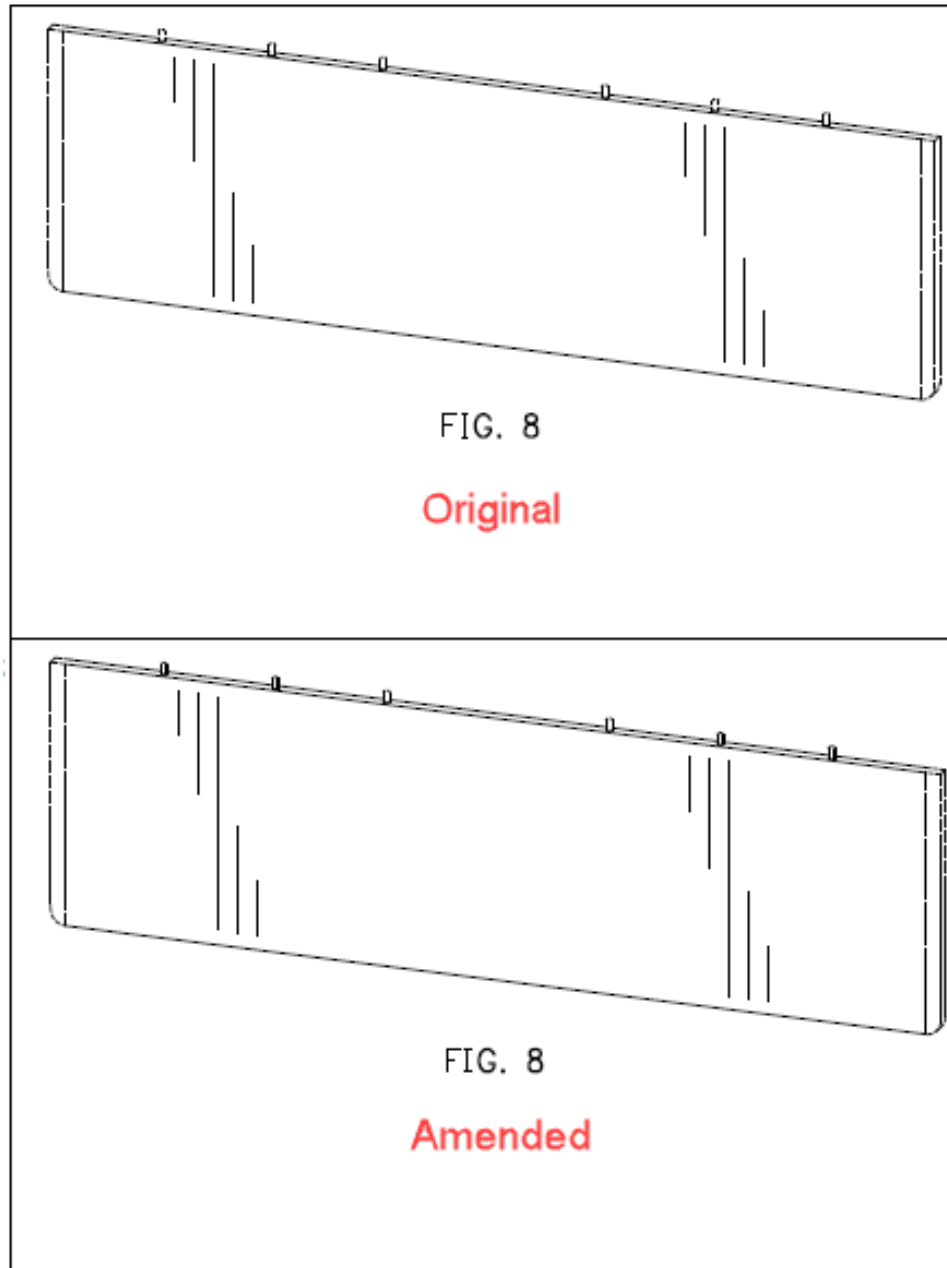


FIG. 6

The enlarged partial view of annotated amended Figure 6 more clearly illustrates that Patent Owner proposes to use solid lines instead of the original dashed lines for two of the three holes as indicated by red arrows located closest to the right end of the table top. Although not shown in the enlarged partial view above, Patent Owner also proposes to illustrate the two holes located closest to the opposing left end of the table top using solid lines rather than the dashed lines of the original figure.

Patent Owner also amended Figure 8 to change the dashed lines representing some of the tenons to solid lines. Patent Owner's comparison of amended and original Figure 8 as annotated by the Board is reproduced below.



Patent Owner states that amended Figure 8 includes

[r]emoval 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.

Id. at 6.

Because in the comparison figures it is difficult to see the actual amendments, we reproduce an annotated, enlarged partial view of amended Figure 8 below.

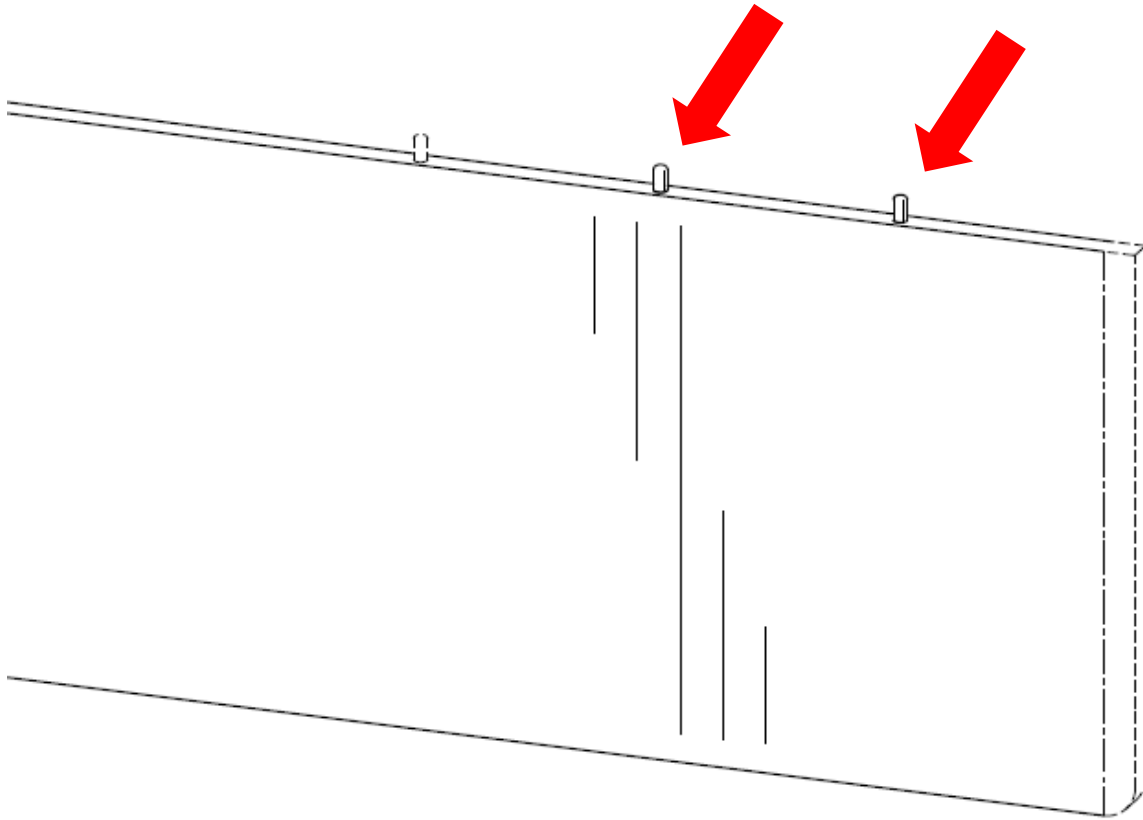


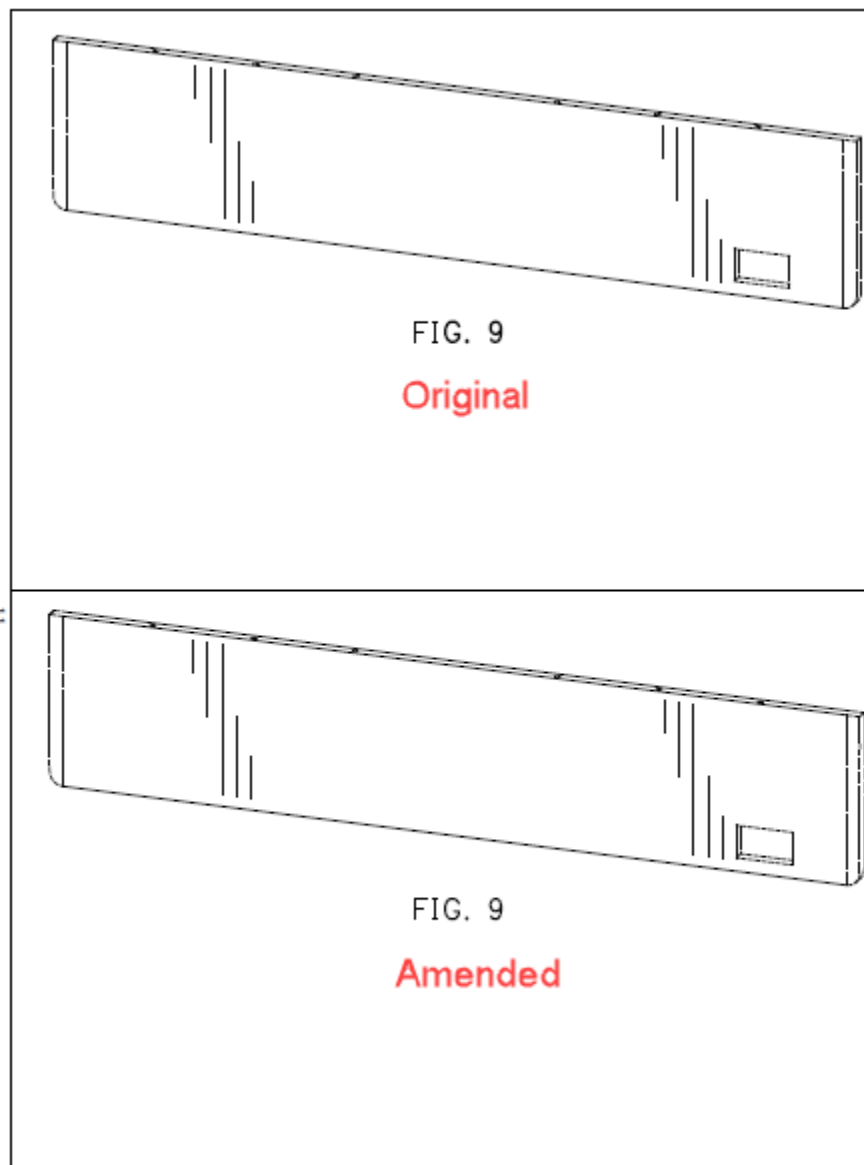
FIG. 8

Annotated amended Figure 8 is an enlarged view of a portion of amended Figure 8, corresponding to the right end wider portion of the claimed table top of amended Figure 1. As indicated by the red arrows, a pair of the three tenons on the right end of the table top are altered to appear in solid lines. The opposing left side of the table top, which is not shown but is symmetric to the partial view above, includes another three tenons with a pair altered to appear in solid lines.

Because it bears on our analysis and ultimate decision of unpatentability, we again point out that the '012 patent describes Figures 1–

8 as corresponding to the same wider portion of the table top. Ex. 1001, code (57). Consequently, Figures 9–15 illustrate the narrower portion of the table top which we discuss below. *Id.*

Patent Owner explains that amended Figures 9 and 14 depict four of the six holes in solid lines, rather than dashed lines of the original figures, as shown by Petitioner’s respective comparison figures below and as annotated by the Board.



Patent Owner describes for amended 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.

Id. at 7.

Because in the comparison figures it is difficult to see the actual amendments, we reproduce an annotated enlarged partial view of amended Figure 9 below.

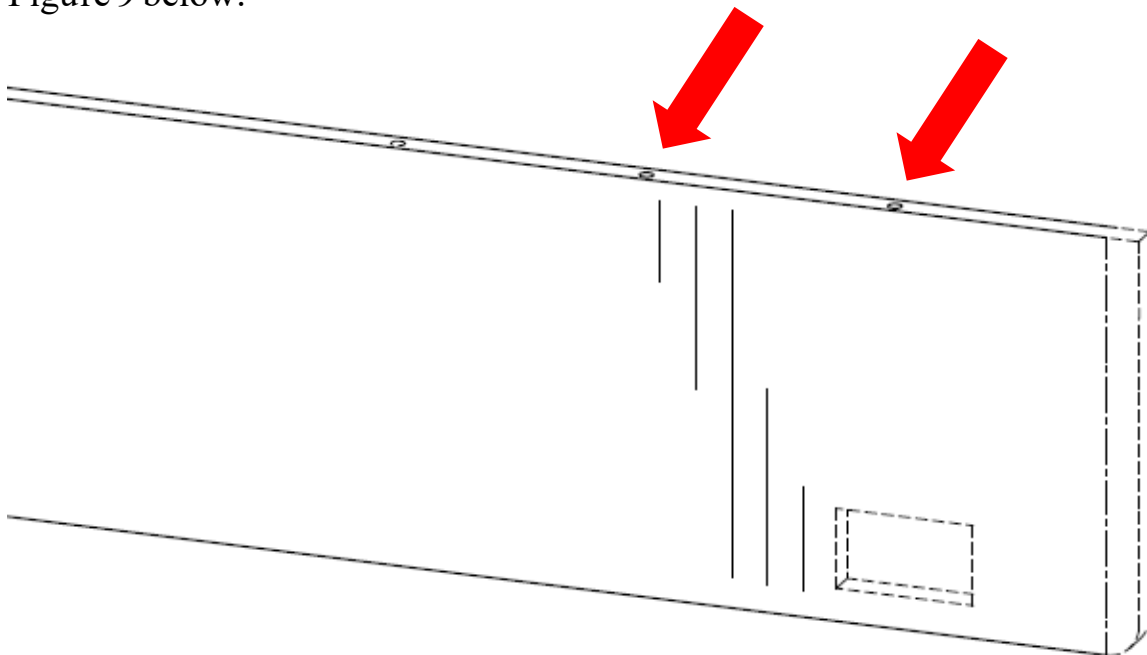
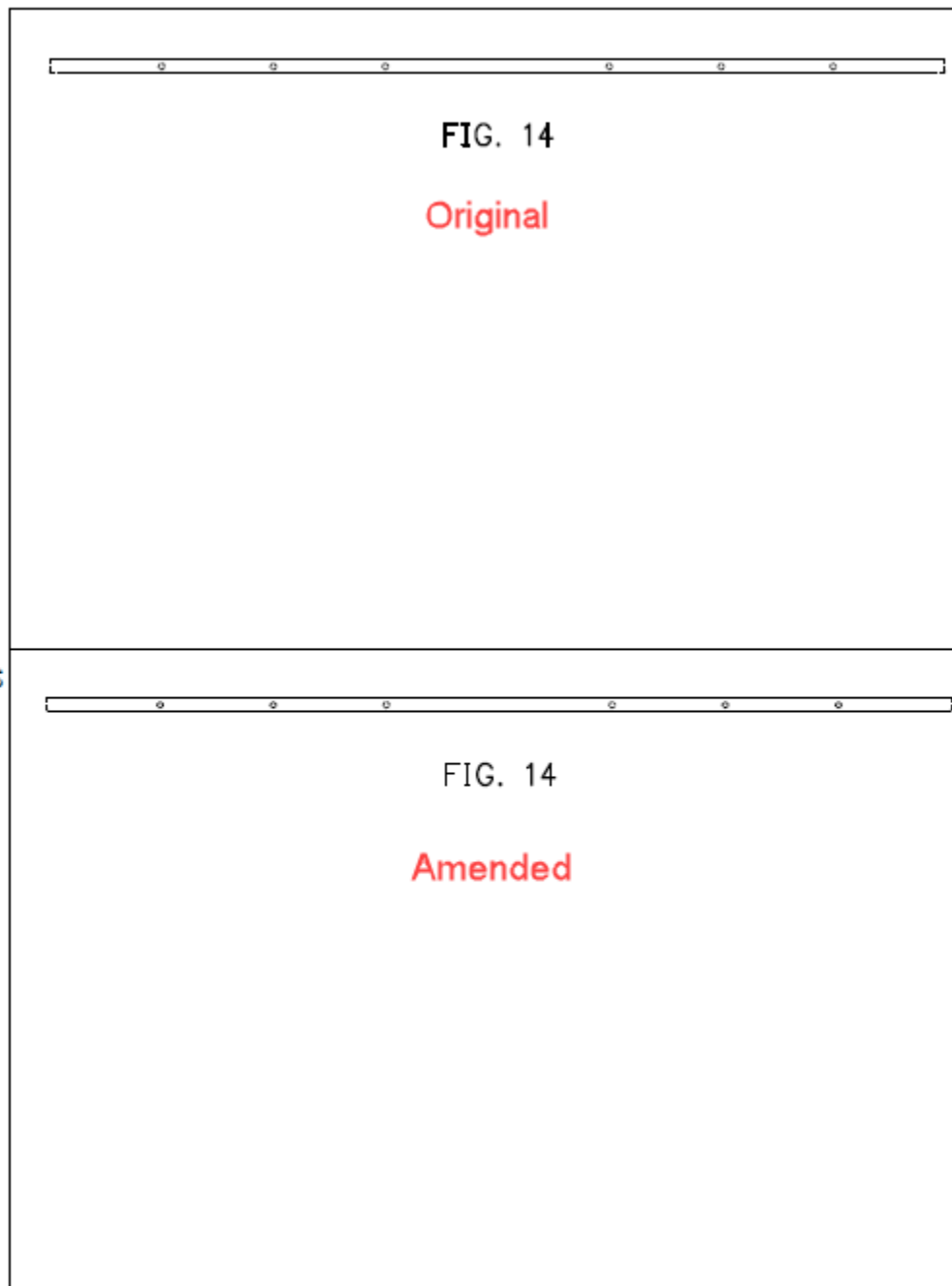


FIG. 9

Annotated amended Figure 9 is an enlarged perspective view corresponding to the narrower portion of the claimed table top illustrating a pair of the three holes, as indicated by red arrows, located closest to the right end of the table top in solid lines. The left end of the table top includes a symmetrical amendment to two of the three holes present in that portion of the table top.

Patent Owner's comparison of amended and original Figure 14 as annotated by the Board is reproduced below.



Patent Owner explains that amended Figure 14 includes

[r]emoval 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.

Id. at 6.

Because it is difficult to see in the comparison view, an annotated enlarged partial view of amended Figure 14 is reproduced below.

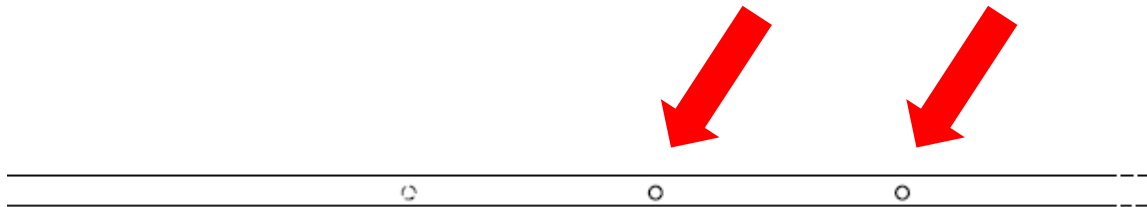


FIG. 14

Annotated amended Figure 14 is an enlarged elevation view corresponding to the narrower portion of the claimed table top illustrating a pair of the three holes, indicated by red arrows, in solid lines. The opposing left side of this portion of the table top, not shown above, includes a symmetrical amendment of a pair of three holes.

B. Prior Art and Asserted Grounds

Besides asserting that the proposed substitute claim is indefinite, Petitioner asserts that the claim would have been unpatentable on the following grounds:⁴

⁴ Petitioner supports its challenge with a Declaration by Mr. Paul Hatch. (Ex. 1002), Patent Owner relies on a Declaration by Mr. Robert Williams (Ex. 2006). *See infra*.

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1	103 ⁵	Carter, ⁶ Morgan ⁷
2	1	103	Carter, Galant, ⁸ Morgan
3	1	103	Galant, Bordonabe ⁹
4	1	102	Carter, Galant, Bordonabe
5	1	103	Carter, Iannaccone ¹⁰
6	1	103	Carter, Galant, Iannaccone

However, because the proposed substitute claim is indefinite for the reasons discussed below, we do not reach Petitioner’s obviousness challenges.

C. Designer of Ordinary Skill in the Art

Petitioner asserts that “a designer of ordinary skill at the time would have been someone with a bachelors in furniture design or an equivalent field or two years of practical experience designing furniture.” Pet. 18 (citing Ex. 1002 ¶¶ 33–36). Petitioner adds that “[a] higher level of skill is likely not warranted given the rudimentary nature of using two boards to make a tabletop.” *Id.*

⁵ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Given that the application from which the ’012 patent issued was filed after this date, the current versions of §§ 102 and 103 apply.

⁶ Ex. 1012, U.S. Patent No 543,609 (iss. July 30, 1895).

⁷ Ex. 1004, U.S. Patent No. 476,400 (iss. June 7, 1892).

⁸ Ex. 1007, IKEA webpage, advertisement, Workspace furniture & accessories | Desks | GALANT table, <https://web.archive.org/web/20050418202119/http://www.ikea.com> (April 18, 2005).

⁹ Ex. 1005, *Boletín Oficial De La Propiedad Industrial*, Spanish Industrial Design No. I14653 to Bordonabe (Pub. Feb. 16, 2000).

¹⁰ Ex. 1006, U.S. Patent No. D424,325 (iss. May 9, 2000).

In its Patent Owner’s Preliminary Response, Patent Owner disputed Petitioner’s asserted level of skill and assertion that the table top design is “rudimentary,” arguing that “a designer of ordinary skill would have a minimum of 10 years of practical experience designing furniture.” Prelim. Resp. 15. We noted in our Institution Decision Patent Owner’s argument that the claimed table top “design is the result of substantial and sophisticated design expertise. The commercial success and resultant copying of the product sold under the patent are evidence of the quality of the design.” Inst. Dec. 10–11 (quoting Prelim. Resp. 15). Patent Owner has not, on the complete record now before us, pointed to persuasive evidence of copying or quality. We also note that on the complete record Patent Owner’s contention that the claimed design resulted from “substantial and sophisticated design expertise,” is unsupported by corroborating evidence. *See* Prelim. Resp. 15. Since entry of our Institution Decision, we have received no further evidence or argument as to the level of skill of an ordinary designer from either party.

We have, on the complete record now before us, mainly the testimony of Petitioner’s declarant, Mr. Hatch, who testifies that

the designer of ordinary skill in the art would be a person who has a bachelor’s degree in furniture design or an equivalent field or alternatively two years of practical experience designing furniture . . . [which] is appropriate given the relatively simple nature of the design at issue, which involves little more than two boards forming a tabletop.

Ex. 1002 ¶¶ 34–35.

Based on the complete record, we adopt Petitioner’s articulation of a designer of ordinary skill as it is supported by the testimony of Mr. Hatch. *Id.* ¶¶ 33–38. We also note that, based on the complete trial record, our

analysis would be the same whether or not a table top design is in fact considered rudimentary.

III. ANALYSIS

A. *Threshold Criteria of 35 U.S.C. § 316 and 37 C.F.R. § 42.121*

“Before considering the patentability of any substitute claims . . . the Board first must determine whether the motion to amend meets the statutory and regulatory requirements set forth in [35 U.S.C.] §316(d) and 37 C.F.R. § 42.121.” *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (PTAB Feb. 25, 2019) (precedential, “*Lectrosonics*”).

“[T]he patent owner must satisfy the Board that the statutory criteria in [35 U.S.C.] §316(d)(3) are met and that any reasonable procedural obligations imposed by the Director are satisfied.” *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1305–06 (Fed. Cir. 2017) (lead plurality opinion by J. O’Malley); *see also id.* at 1341 (“There is no disagreement that the patent owner bears a burden of production in accordance [with] 35 U.S.C. § 316(d).”) (majority opinion by J. Reyna).

We address these threshold criteria below.

1. *Must Propose a Reasonable Number of Substitute Claims*

“The presumption is that only one substitute claim would be needed to replace each challenged claim.” 37 C.F.R. § 42.121(a)(3). The ’012 patent had a single claim directed to “[t]he ornamental design for a table top, as shown and described.” Ex. 1001, code (57). The ’012 patent included 23 figures illustrating that claim. *Id.* Patent Owner has proposed to amend certain figures of the ’012 patent in its noncontingent Motion to Amend. Thus, as a part of its noncontingent Motion to Amend, Patent Owner has proposed only one substitute claim that is illustrated, in-part, based on the amended figures.

2. *Must Respond to Ground of Unpatentability*

Patent Owner's amendments to the claim must respond to a ground of unpatentability raised in the trial. 37 C.F.R. § 42.121(a)(2)(i). In this case, Patent Owner argues that neither Morgan or Galant "disclose or suggest tenons or holes" as shown in the proposed substitute claim. Mot. to Amend 15. By adding tenons and holes in the proposed substitute claim Patent Owner has responded to a ground of unpatentability in this proceeding.

3. *Must Not Enlarge Scope of Claims*

A substitute claim cannot enlarge the scope of the claim. 35 U.S.C. § 316(d)(3); *see* 37 C.F.R. § 42.121(a)(2)(i)-(ii). By converting dashed lines in the original figures into solid lines to add tenons and holes to the proposed substitute claim, and thus adding limitations, Patent Owner has not enlarged the scope of the proposed substitute claim.

4. *Must Not Introduce New Matter*

A motion to amend "may not . . . introduce new matter." 35 U.S.C. § 316(d)(3); *see* 37 C.F.R. § 42.121(a)(2)(ii). The motion to amend must have support in the originally filed disclosure. 37 C.F.R. § 42.121(b)(1); *see* PTAB Consolidated Trial Practice Guide (Nov. 2019),¹¹ 69, 71. Converting dashed lines in the original figures to solid lines in order to add tenons and holes to the proposed substitute claim does not introduce new matter into the proposed substitute claim. *See* MPEP § 1504.04 ("an amendment that changes the scope of a design by either converting originally-disclosed solid line structure to broken lines or converting originally-disclosed broken line structure to solid lines would not introduce new matter because such

¹¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

amendment would not introduce subject matter that was not originally disclosed.”).

5. *Conclusion Regarding Threshold Criteria*

Patent Owner has met its burden to establish that the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 have been satisfied.

B. *Indefiniteness of Proposed Substitute Claim*

As discussed above, the proposed substitute claim amends certain figures to add tenons and holes that, in the original claim, were drawn in broken lines and therefore not part of the claimed design. *See* MPEP § 1503.02 III. (“A broken line showing is for illustrative purposes only and forms no part of the claimed design or a specified embodiment thereof.”).

Petitioner argues that the proposed substitute claim is indefinite because “the substitute claim results in multiple inconsistent drawings, from which an ordinary observer would not be able to ascertain the scope of the claim.” *Opp.* 4 (citing Ex. 1011 ¶¶ 36–41). Petitioner asserts that the drawings are inconsistent because they depict the same wider portion of the table top as having both tenons (amended Figure 8) and holes (amended Figures 1 and 6). *Id.* at 4–6. According to Petitioner, there is no way of knowing if the wider portion of the table top of the claimed design includes tenons or holes. *See id.*

Petitioner argues specifically that the Motion to Amend “proposes to amend Fig. 8 to add tenons. Yet Figs. 2 and 3, both of which show the same ‘top portion’ [i.e., wider portion] of the tabletop as Fig. 8, do not show the added tenons.” *Id.* Petitioner provides the following comparison table of Figures 8, 2, and 3 of the proposed substitute claim.

MTA Fig. 8	Fig. 2	Fig 3.
 FIG. 8	 FIG. 2	 FIG. 3

Petitioner’s comparison table illustrates Figure 8, a perspective view of the wider portion of the claimed table top having four tenons (two tenons are shown still in broken lines as well), whereas Figures 2 and 3 are front and rear plane views of the same wider portion and lack any tenons. *Id.* at 5

Petitioner argues also that “[t]he same problem affects Figs. 4 and 5, which are left and right-side views in which the added tenons should be visible.” *Id.* We reproduce Figures 4 and 5 of the proposed substitute claim below.



FIG. 5



FIG. 4

Figures 4 and 5 of the proposed substitute claim illustrate left and right side views of the wider portion of the claimed table top and do not show any tenons. Ex. 1001, code (57). Petitioner argues that the inconsistent drawings, some showing tenons, some not, in the proposed substitute claim makes the claim indefinite “[b]ecause a person of ordinary skill in the art would have no way of knowing from the visual disclosure whether the claimed design requires tenons.” Opp. 6.

Patent Owner asserts that “[o]ne of ordinary skill in the art would understand how the tenons and holes should be positioned on each of the table top portions.” Reply Opp. 7. Patent Owner argues specifically that

[t]he previously disclaimed and now claimed holes of the first table top portion are shown in Figs. 1 and 6. The previously disclaimed and now claimed tenons of the first table top portion are shown in Fig. 8. The now claimed tenons of Fig. 8 are clearly included in the first table top portion.

Id. Patent Owner concludes, arguing that “[b]ased on these observations related to the amended drawings and claim of the ‘012 Patent, the location of

the tenons in the top portion of the table top is clear to one of ordinary skill in the art.” *Id.* (citing Ex. 2006 ¶¶ 50–56).

Upon review of the evidence of record, we agree with Petitioner. The Federal Circuit recently explained that “a design patent is indefinite under § 112 if one skilled in the art, viewing the design as would an ordinary observer, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure.” *In re Maatita*, 900 F.3d 1369, 1377 (Fed. Cir. 2018). In *Maatita*, the Federal Circuit reversed the Board’s finding of indefiniteness of a design for a shoe bottom, i.e., a shoe sole, finding

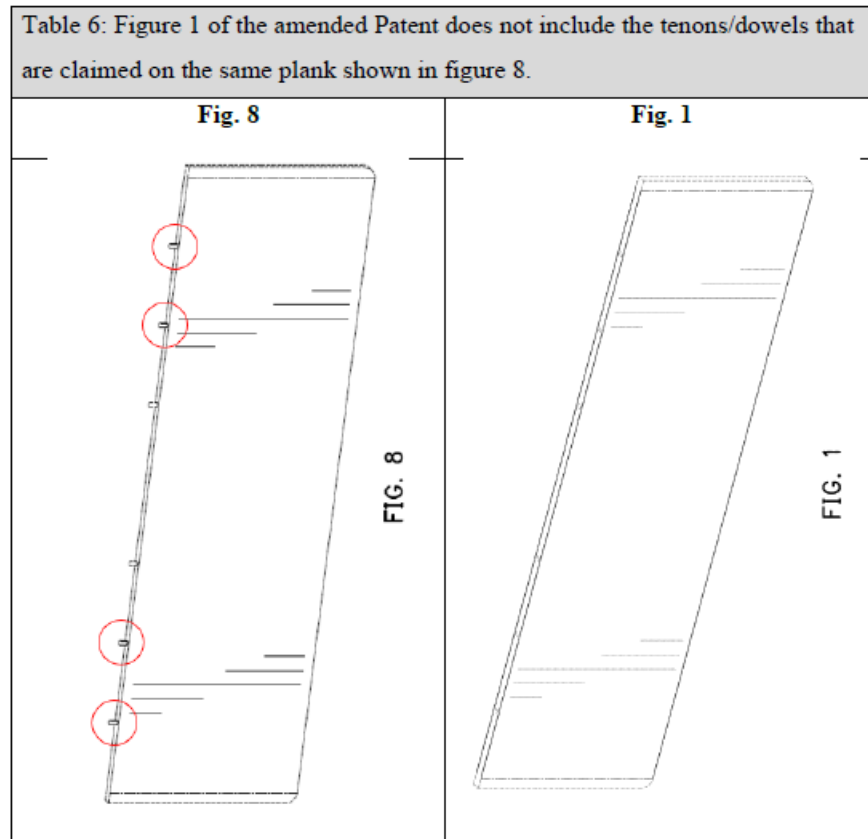
that *Maatita*’s two-dimensional drawing clearly demonstrates the perspective from which the shoe bottom should be viewed. A potential infringer is not left in doubt as to how to determine infringement. In this case, *Maatita*’s decision not to disclose all possible depth choices would not preclude an ordinary observer from understanding the claimed design, since the design is capable of being understood from the two-dimensional, plan- or planar-view perspective [] shown in the drawing.

Id. at F.3d 1378–79. Different from *Maatita*, the issue in this proceeding is not whether an ordinary observer would sufficiently understand a three-dimensional ornamental design from a two-dimensional figure, but whether inconsistencies between figures of the proposed substitute claim render the scope of the claimed table top uncertain. *See Maatita*, 900 F.3d at 1376 (The Federal Circuit specifically distinguishing *Maatita*’s single two-dimensional drawing from indefiniteness issues raised by inconsistent drawings: “[h]ere, we are not dealing with inconsistencies in the drawings, or inconsistencies between the drawings and the verbal description, but

rather with a single representation of a design that is alleged to be of uncertain scope”).

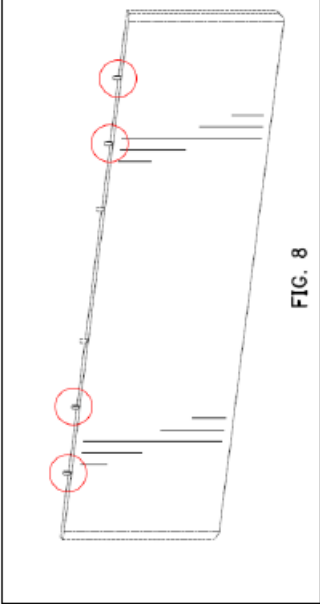
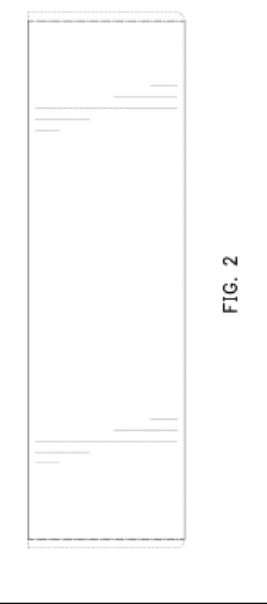
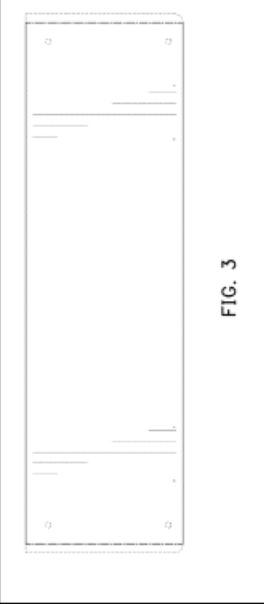
Patent Owner does not expressly dispute that there are inconsistencies between the figures illustrating the wider portion of the table top in Figures 1–8, but argues that “there are no inconsistencies *in the location* of any now claimed holes or tenons.” Reply Opp. 7 (emphasis added). With respect to the inconsistencies between the figures, Patent Owner’s declarant, Mr. Williams, concedes that “Figs. 1, 2 and 3 do not show tenons, but due to their clear inclusion in Fig. 8, which relates to the same top portion of the table top as Figs. 1, 2 and 3, it is clear that tenons are included in the top portion of the table top.” Ex. 2006 ¶ 54. Mr. Williams testifies further that “[i]t is my experience that tenons are generally included in the larger portion of two table top portions.” *Id.* ¶ 55.

Petitioner’s declarant, Mr. Hatch, testifies that Figures 1 and 8 illustrate the same wider, i.e., top, portion of the table top in the proposed substitute claim. Ex. 1011 ¶ 37. Mr. Hatch points out that “Figure 8 (amended) includes the added tenons/dowels while Figure 1 does not.” *Id.* Table 6 from Mr. Hatch’s supplemental declaration comparing Figures 1 and annotated Figure 8 of the proposed amended claim is reproduced below. *Id.*



Mr. Hatch’s Table 6 illustrates amended Figure 8 with tenons, on the left, as compared to amended Figure 1 on the right, with holes. *Compare* Mot. to Amend 6 (For Figure 1, “amending the outline of the four holes from broken lines to solid lines), *with id.* (For Figure 8, “amending the outline of the four tenons from broken lines to solid lines”).

In addition, Mr. Hatch, in Table 7 reproduced below, points out that Figures 2 and 3 illustrating front and rear plane views of the wider portion of the table top also fail to show tenons. Ex. 1011 ¶ 39.

Table 7: Figures 2, 3, 4 and 5 of the amended Patent also do not include the tenons/dowels that are claimed on the same plank shown in figure 8.		
Amended Fig. 8	Fig. 2	Fig 3.
		

Considering the side-by-side comparison of Figures 2 and 3 with Figure 8 in Table 7, Mr. Hatch testifies that “[b]ecause tenons/dowels are projections, one would expect them to stick out from the sides of these views. But Figures 2 and 3 remain unamended and do not show the tenons/dowels.” *Id.* ¶ 38. Mr. Hatch testifies further that “Figures 4 and 5 have the same problem because the profile of the projections/tenons should also be visible in those figures.” *Id.* ¶ 39. According to Mr. Hatch,

there is no way to determine whether the substitute claim actually includes/requires the added tenons or not. Only one figure includes them (Figure 8), and all of the remaining figures (1-5) that illustrate this portion of the table top, omit the tenons even though one would expect the tenons to be visible in those images.

Id. ¶ 40. Considering the standard for indefiniteness in design patents, Mr. Hatch concludes that “an ordinary observer would not be able to determine

whether the tenons are actually required by the substitute claim and therefore would not be able to understand the scope of the substitute claim.” *Id.* ¶ 41.

In contrast, Patent Owner’s declarant, Mr. Williams, testifies based on his “experience[,] that tenons are generally included in the larger portion of two table top portions.” Ex. 2006 ¶ 55. However, Mr. Williams’ experience does not explain *why* an ordinary observer would understand such functional and ornamental characteristics of tenon and hole arrangements. *Id.* Nor does this testimony proclaim that tenons *must* be in the larger of two table top portions. Indeed, even considering an ordinary observer imbued with Mr. Williams’ level of expertise and experience, and understanding for instance that *it may be more likely* that the wider portion includes tenons, this does not resolve the glaring inconsistency that Figure 1 illustrates holes and Figure 8 illustrates tenons. In other words, Mr. Williams’ “experience” does not resolve the visible tension that, on one hand, Figure 1 illustrates holes as part of the claimed ornamental design in the wider portion of the table top, and on the other hand, Figure 8 illustrates tenons as part of *the same* wider portion of the table top. The problem here may be more eloquently explained as “Two roads diverged in a yellow wood[,] And sorry I could not travel both.” Robert Frost, The Road Not Taken, The Poetry of Robert Frost—The Collected Poems, 105, Henry Holt and Co. (1969).

Considering the entire record before us in this case we credit Mr. Hatch’s testimony. The issue is not, as Patent Owner has framed it, whether “[o]ne of ordinary skill in the art would understand *how the tenons and holes should be positioned* on each of the table top portions.” Reply Opp. 7. The question is whether a person of ordinary skill in the art viewing the design for a table top in the proposed substitute claim as would an ordinary observer, understand whether or not the wider portion of the table top as

shown in amended Figure 8 includes tenons, or, as shown in amended Figures 1 and 6, holes.

As Mr. Hatch persuasively explains, in the proposed substitute claim a majority of the drawings for the wider portion, i.e., Figures 1–6, omit the tenons added in Figure 8. Ex. 1011 ¶ 37 (Mr. Hatch testifying that “Figure 8 is the only amended figure that adds tenons/dowels.”) Indeed, Figures 1 and 6 not only fail to illustrate tenons, but actually are amended to include holes rather than tenons, as described in the Motion to Amend. *See, e.g.*, Motion to Amend 6 (Patent Owner describing, “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.”).

On the complete record in this proceeding, we determine that a designer of skill in the art considering the claim from either their own, or the perspective of an ordinary observer, would be uncertain whether the wider portion of the claimed table top depicted in Figures 1–8 includes tenons, or holes. It is reasonable that anyone observing two distinct ornamental designs for the same wider portion of the table top would be unclear as to the claimed ornamental design where holes are shown in one figure but tenons are shown in another figure illustrating the same wider portion of the table top. Observing as a whole, the figures illustrating the table top in the proposed substitute claim, the question remains, does the wider portion of the table top include tenons, or holes? *See Maatita*, 900 F.3d at 1376 (“Ultimately, a patent is indefinite for § 112 purposes whenever its claim, read in light of the visual disclosure (whether it be a single drawing or multiple drawings), ‘fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.’”) (quoting *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014)).

Based on the complete record before us, we determine that the proposed substitute claim fails to “inform those skilled in the art about the scope of the invention with reasonable certainty.” *See Nautilus*, 572 U.S. at 910. Thus, Petitioner has shown, by a preponderance of the evidence, that the proposed substitute claim is indefinite and we accordingly deny Patent Owner’s Noncontingent Motion to Amend.

C. Obviousness of Proposed Substitute Claim

We have already determined that the proposed substitute claim is unpatentable based on indefiniteness. Therefore, we need not reach Petitioner’s obviousness-based challenges to the proposed substitute claims.

III. CONCLUSION¹²

In conclusion, we grant Patent Owner’s noncontingent request to cancel the original claim of the ’012 patent, and we deny Patent Owner’s request to add the proposed substitute claim to the ’012 patent. Thus, the result of this decision is summarized by the following two tables:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claim(s) Shown Unpatentable	Claims Not Shown Unpatentable
1	103(a)	Carter, Morgan		

¹² Should Patent Owner wish to pursue amendment of the challenged claim in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claim(s) Shown Unpatentable	Claims Not Shown Unpatentable
1	103(a)	Carter, Galant, Morgan		
1	103(a)	Carter, Bordonabe		
1	103(a)	Carter, Galant, Bordonabe		
1	103(a)	Carter, Iannaccone		
1	103(a)	Carter, Galant, Iannaccone		

Motion to Amend Outcome	Claim(s)
Original Claims Cancelled by Amendment	1
Substitute Claims Proposed in the Amendment	1
Substitute Claims: Motion to Amend Granted	
Substitute Claims: Motion to Amend Denied	1
Substitute Claims: Not Reached	

III. ORDER

For the reasons given, it is

ORDERED that, Patent Owner's Motion to Amend is *granted-in-part* as to the noncontingent request to cancel the original claim of the '012 patent;

FURTHER ORDERED that Patent Owner's Motion to Amend is *denied-in-part* as to the request to add the proposed substitute claim to the '012 patent; and

FURTHER ORDERED that, because this is a Final Written Decision, any party to the proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2023-00658
Patent No. D934,012 S

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