

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MUNCHKIN, INC. AND TOYS “R” US, INC.
Petitioners

v.

LUV N’ CARE, LTD.
Patent Owner

CASE IPR2013-00072
Patent D617,465

Before SALLY C. MEDLEY, JENNIFER S. BISK, and MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

**LUV N’ CARE, LTD.’S RESPONSE TO THE BOARD’S DECISION
TO INSTITUTE INTER PARTES REVIEW**

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Receipt is acknowledged of the Decision of April 25, 2013 in the present inter partes review of U.S. Patent No. D617,465 (“the ‘465 patent” or “the patent-at-issue”), which ‘465 patent was filed as U.S. Serial No. 29/292,909 (“the ‘909 application” or “the patent application”).

In response to the Decision, each of the issues raised therein is addressed below. Reconsideration and further examination of the application are respectfully requested. The Commissioner is hereby authorized to debit any and all amounts deemed required from Deposit Account No. 50-5393.

Discussion of Amended Claim / Amended Drawings

I. Issue of Continuity

In the Office Action, a priority issue was raised as to the continuity of the ‘465 patent with respect to its parent. Further thereto, a motion to amend has been filed, including amended drawings. It is submitted that the amended drawings fully address all of the continuity objections.

As acknowledged in the Office Action, the ‘465 patent is a continuation of Serial No. 10/536,106 (“the ‘106 application” or “the parent application”). The disclosure of the ‘106 application was fully incorporated by reference in the present

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'465 patent, as part of the specification originally filed in the '909 application. *See*, '909 Original Specification filed October 31, 2007 at p.1.

Accordingly, the patentee has amended the drawings herein, so as to conform the drawings in the '465 patent to those of its parent application.

As shown in the attached amended drawings, the patentee has taken the figures from the issued '465 patent and digitally conformed them to various figures in the parent '106 application. As such, the present amendments are believed to address all of the objections raised by the Patent Office on page 7 of the Decision. In particular:

- i. The overall perimeter shape of the spout has been amended to match the 'race-track' shape in Figure 8E of the '106 application, including structure and relative sizes.¹
- ii. In addition, the slits in the spout tip and vent have been added to the figures. Those slits have been included in dotted outline, as they are unclaimed subject matter.

¹ The additional edges around the perimeter of Figure 8E are not shown in the attached replacement figures, since they are not visible due to the attachment of the lid to the screw ring.

In addition, the claim has been narrowed very slightly. Specifically: (1) the minor notches on the spout portion have been added to the claim (by using solid, instead of broken lines); and (2) a raised rim around the air vent has been added. Both of these features are shown in the figures of the '106 application. An embodiment with notches, for example, is shown in Figure 10(b) of the '106 application, and an embodiment with the raised rim is shown in Figure 11(d).

An illustration of the amended drawings in comparison to various figures, in whole or cropped, from the '106 application (labeled "Original Fig.") is set forth in the Patent Owner's Motion to Amend concurrently filed on today's date. As shown by the examples therein, the currently amended figures are consistent with the figures of the '106 application.²

As a result, in view of the above, it is submitted that continuity is present between the '106 application and the present patent, such that the patentee is entitled

² The patentee notes that these amendments are not intended as an admission that the '465 patent was not previously entitled to priority. As further discussed below, the patentee believes that priority was present in view of the drawings and the statements in the written description in the parent. The present drawings have been amended without prejudice, however, to conform them to particular figures as discussed above, so as to expedite favorable action and an allowance.

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to the priority benefit of the '106 application's filing date. Recognition of that continuity and priority are respectfully requested.

II. Rejections Over Prior Art

Based on the loss of continuity, the Office Action had rejected the '465 patent as follows:

- (1) as being obvious under 35 U.S.C. §102(b) over Hakim U.S. Pub. 2007/0221604 ("Hakim '604");
- (2) as being obvious under 35 U.S.C. §102(b) over Hakim U.S. Pat. No. 6,994,225 ("Hakim '225");

In view of the amendments herein to address the continuity issues, it is submitted that the present application is entitled to the August 5, 2003 filing date of the '106 parent application. As a result, withdrawal of the rejections is respectfully requested.

In particular, the present application claims the priority of Hakim '604 (Hakim '604 being the same as the '106 parent). As a result, the 2007 publication of Hakim '604 and the Hakim '225 patent are not prior art.

Accordingly, with the elimination of all of the primary references, it is respectfully submitted that the present patent is fully valid and patentable.

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