

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Munchkin, Inc.

Petitioner

v.

Luv N' Care, Ltd.

Patent Owner

Case IPR2013-00072

Patent D617,465

Opposition to Patent Owner's July 25, 2013 Motion to Amend

Through this paper, the petitioner respectfully opposes Patent Owner's July 25, 2013 Motion to Amend (Paper 13). If any fee is necessary for this paper to be fully considered, the petitioner respectfully requests that all such fees be charged to Deposit Account No 12-0600 with reference to attorney docket number 533625. Patent Owner is being served a copy of this paper, as shown by the attached Certificate of Service.

I. Introduction

Patent Owner's description of the proposed amendments is neither comprehensive¹ nor accurate,² and the arguments in Paper 13 directed to priority date are fundamentally flawed. As set forth below, the pending Motion to Amend (Paper 13) should be denied at least because: (a) it does not only respond to a ground of unpatentability involved in the trial; (b) it seeks to enlarge the scope of the claim in the '465 Patent; (c) it does not clearly set forth support in the original

¹ For example, it fails to point out that the claim language would be amended from "as shown and described" to "as shown".

² For example, the patent owner's characterization of the proposed drawing amendments as narrowing the claim scope is wrong. And the patent owner's statement that "no claimed features have been removed" is similarly wrong; for example, the claimed smooth surface around the vent hole has been removed in favor of a raised ridge.

disclosure for the amended claim; and (d) it does not clearly set forth support in the earlier-filed disclosure for the amended claim. This violates 37 C.F.R. §§ 42.121(a)(2)(i), 42.121(a)(2)(ii), 42.121(b)(1), and 42.121(b)(2), respectively.

But if the amendments proposed in Paper 13 are allowed, they nevertheless do not overcome the invalidity problems addressed in the Request for *Inter Partes* Review (Paper 3) and the Decision to Institute (Paper 8). And still further, the proposed amendments raise new invalidity issues at least under 35 U.S.C. §§ 112 and 316(d)(3). These issues are discussed in detail in the petitioner's Reply to Patent Owner's July 25, 2013 Response.

II. The proposed amendment is impermissibly outside the scope of IPR

The '465 Patent as issued claims "the ornamental design for a drinking cup, as shown and described." *See* Exh. 1002 at Claim. Although not addressed by Patent Owner, the proposed amendment changes that language to simply "the ornamental design for a drinking cup as shown"—without the "and described". *See* Exh. 2002 at Claim. This amendment does not respond to a ground of unpatentability involved in the trial, and thus should be denied for violating 37 C.F.R. § 42.121(a)(2)(i). Further, by not even pointing out this proposed amendment to the claim text, Patent Owner has violated the requirement to "show the changes clearly". *See* 37 C.F.R. § 42.121(b). It is unknown how many other edits were not shown clearly in the proposed amendments, and the burden to

identify these amendments is squarely on the patent owner. *See id.*

III. The proposed amendment impermissibly enlarges the claim scope

The best guidance provided by the USPTO is that a claim is broadened (has an enlarged scope) if “any conceivable product or process” falls within the scope of the amended claim (here, defined by the drawings) that would not have infringed the original patent. *See* MPEP 1412.03. This is consistent with case law on broadening. *See, e.g., Thermalloy*, 121 F.3d at 692 (“A new claim enlarges if it includes within its scope any subject matter that would not have infringed the original patent.”); *Brady Const. Innovations, Inc. v. Perfect Wall, Inc.*, 290 Fed.Appx. 358, 363 (Fed. Cir. 2008); *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 (Fed. Cir. 1987). Indeed, case law is well settled that “a claim is broadened if it is broader in *any* respect than the original claim, even though it may be narrowed in other respects.” *In re Rogoff*, 261 F.2d 601, 603 (C.C.P.A. 1958) (emphasis added).

So the test for broadening is not merely an accounting of claim elements, with additional elements (or even the same number of elements) in an amended claim necessitating a finding of no broadening. Instead, if even one conceivable product falls outside the original claim but inside the scope of the amended claim, there is broadening. In cases where the configuration has been changed (i.e., where amendments are not merely changing broken lines to solid lines), such edits

would affect at least the outermost claim scope as illustrated below in FIGURE 1. There, the original scope is represented by solid lines, and the amended scope is represented by dashed lines. Common scope is where the two overlap, and broadened scope is the non-overlapping dashed area.

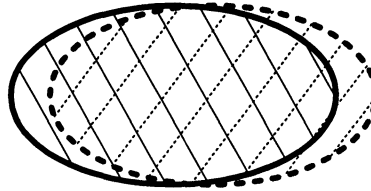


FIGURE 1

The Federal Circuit recently found that having less features in a design patent context does not mean that the claim is more broad. In *Apple, Inc. v. Samsung Elecs. Co.*, the prior art computer tablet included more features than in the design patent at issue, such as a sharply contrasting frame, a perforated corner, and sides that include projections and indentations. 678 F.3d 1314, 1330-31 (Fed. Cir. 2012). If the more minimalist design claimed in the patent were more broad than the prior art, it could not be valid. See *Philip v. Mayer, Rothkopf Indus.*, 635 F.2d 1056, 1060 (2nd Cir. 1980) (“We have long held that a patent is invalid, no matter how...original the invention it protects, if the applicant for the patent claims the invention so broadly that it encompasses already established prior art.”); see also, *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1367 (Fed. Cir. 2002) (where a claim “reads on prior art, the patent is invalid”); and see, *Knapp v. Morss*, 150 U.S. 221, 228 (1893) (“the rule is well established[:]

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