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

Reply to Patent Owner's July 25, 2013 Response

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Through this paper, the petitioner respectfully replies to Patent Owner's July 25, 2013 Response. 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

The USPTO has determined that the '465 Patent as issued is not entitled to a priority date before 10/31/2007. *See* Paper 8 at pp. 6-7. And, contrary to Patent Owner's assertion, the USPTO has *not* acknowledged that the '465 Patent is actually a continuation of Application 10/536,106 (published as US 2007/0221604; "Hakim '604"). As discussed in detail below, the '465 Patent is in fact not a continuation. Thus, even in view of Patent Owner's proposed amendments,[1] the '465 Patent cannot be awarded a priority date earlier than 10/31/2007, and the only

[1] Although the patent owner opines that the drawings are amended "without prejudice" (Paper 14 at p. 4) and that the amendments "are not intended as an admission" (Paper 14 at p. 4), estoppel indeed attaches when amendments are made (as is the case here) for the purpose of trying to overcome a rejection. *See Felix v. Am. Honda Motor Co.,* 562 F.3d 1167, 1182-83 (Fed. Cir. 2009). Also, intervening rights attach with such amendments. *See Yoon Ja Kim v. Earthgrains Co.*, 451 Fed.Appx. 922, 923-24, 926 (Fed. Cir. 2011).

claim of the '465 Patent should be invalidated as obvious over (or, in view of the proposed amendments, anticipated by) Hakim '604 and US 6,994,225 ("Hakim '225"), respectively.

Substantively, there are at least four problems that are fatal to Patent Owner's response. First, the amended drawings impermissibly broaden the claim of the issued '465 Patent—in violation of 35 U.S.C. § 316(d)(3). Second, the amended drawings cause the '465 Patent to be invalid under 35 U.S.C. § 112. Third, the patent owner has waived any priority claim. And fourth, the amendments fail to establish priority under 35 U.S.C. § 120.

Finally, if the proposed amendments are not permitted, the only claim of the '465 Patent should still be invalidated as obvious over Hakim '604 and Hakim '225, respectively. The USPTO properly determined the priority date of the '465 Patent as being 10/31/2007, and Patent Owner has not provided any persuasive reasoning as to why the USPTO's determination should be considered erroneous. Each issue is discussed in detail below, and the petitioner respectfully requests that the USPTO invalidate the only claim of the '465 Patent.

II. The amendment is an impermissible broadening

A. Broadening in any respect is not permitted

Amendments in *inter partes* review ("IPR") proceedings "may not enlarge the scope of the claims of the patent[.]" 35 U.S.C. § 316(d)(3). This corresponds

to 35 U.S.C. § 314(a) (pre-AIA), which causes broadened claims to be invalid. *See Thermalloy, Inc. v. Aavid Eng'g, Inc.*, 121 F.3d 691, 692, 694 (Fed. Cir. 1997).

The best guidance provided by the USPTO is that a claim is broadened 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 <u>not</u> 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.

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