

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

LUV N’ CARE, LTD.  
Patent Owner

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CASE IPR2013-00072  
Patent D617,465

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

**LUV N’ CARE, LTD.’S REPLY  
IN SUPPORT OF MOTION TO AMEND**

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## **I. The Proposed Amendment is Not Outside the Scope of IPR**

The allegations that Patentee’s amendment is outside the scope of IPR (Opposition-17 at 1-3), and that Patentee failed to point out an amendment to the claim language (*Id.* at fn. 1), are all without merit.<sup>1</sup> Specifically, Petitioners allege that Exhibit 2002 is an improper amendment to delete “and described” from the claim. However, as per Patentee’s Motion, Exhibit 2002 is not an amendment. It is the initial specification from the ‘465 patent file wrapper. *See*, Motion-13 at 6, citing Exhibit 2 (Exhibit 2002). The claim language was never amended herein.

## **II. Petitioners’ Response Improperly Raises New and Impermissible Grounds**

### *A. The Response Raises New Grounds*

For the first time, Petitioners make allegations regarding a recessed bottom, and a “cup without protrusions (or “ridges”)”. Both of those features were in the issued drawings of the ‘465 Patent; yet, neither was objected to in the Petition. As a result, those grounds were waived. Petitioners should not be allowed to belatedly raise new grounds not in their original Petition. To do so – now after Patentees’ filing of its Response and Motion – would be unfair to the Patentee.

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<sup>1</sup> The issued patent includes a description of its broken lines, so the “as shown and described” language is proper. *See*, MPEP §§1503.01 II(c) and 1503.02 III. The recent amendment still includes broken lines and never deleted that language.

*B. The Response Also Raises Impermissible Grounds*

“A Petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent ***only on a ground that could be raised under section 102 or 103 ...***” 35 U.S.C. 311(b) (emphasis added). Accordingly, all of Petitioners’ allegations regarding invalidity under 112 are improper and should be rejected.<sup>2</sup>

**III. The Amended Claims are Entitled to Priority**

The present ‘465 Patent claims direct priority to the ‘106 Application, and the amended drawings correspond to the figures of the ‘106 application, as shown in the Patentee’s Motion and Exhibit 2003.<sup>3</sup> As such, priority is proper.

Petitioners’ argument that it is somehow forbidden to include any broken lines in the present ‘465 Patent is totally misplaced. It is directly inconsistent with *Zahn*.<sup>4</sup> A similar argument was also rejected by the Federal Circuit in *Daniels*.<sup>5</sup> This case,

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<sup>2</sup> Furthermore, as shown in Exhibit 2003, the views being patented are all consistent with each other. Petitioners’ figure comparison is inaccurate.

<sup>3</sup> “The parties agree that the parent application discloses no boundary that corresponds (either explicitly or implicitly) to this newly-added broken line.” *Id.* By adding a new line, *Owens* created a new shape not shown in the parent, which the Federal Circuit ruled to be impermissible new matter.

<sup>4</sup> *See, In re Zahn*, 617 F.2d 261, 267 (CCPA 1980). *Zahn* held that a design for an article of manufacture may be embodied in less than all of the article. It rejected a contrary, limited construction of 35 U.S.C. §171.

<sup>5</sup> In *Daniels*, a continuation was filed to delete a leaf design which was part of the parent. *In re Daniels*, 144 F.3d 1452, 1453 (Fed. Cir. 1998). The Court upheld

however, is even stronger than *Daniels*, since no lines have been deleted. The lines here are shown in the parent, with some being made broken here to be unclaimed.

In addition, Petitioners' reliance on *Owens* is misleading. In *Owens*, the patentee added a broken line in a continuation *where no line at all existed in the parent*. *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013). The present case is completely different. Here, *existing* solid lines were made broken.

Moreover, this is a design patent application. As such, features such as the slit valves have been put in broken lines. Otherwise, the Petitioner would object on the grounds that the features are "functional" since the slits act as valves.

In short, Petitioners' position is inconsistent with established law and practice in which a Patentee may claim less than all of an article of manufacture.<sup>6</sup> Contrary to the rule that Petitioners espouse, a Patentee is not hamstrung by having to claim every disclosed feature of an article.

#### **IV. The Claim Has Been Slightly Narrowed Not Broadened**

Petitioners' claims of alleged broadening are likewise misplaced. It is undisputed that Petitioner has amended to claim elements which were not in the

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priority as the remaining design was nonetheless in the parent.

<sup>6</sup> Furthermore, the '106 Application repeatedly emphasizes that there are numerous variations for the features therein, different embodiments, and so forth.

issued claim, and it is traditionally accepted that adding elements narrows a claim.<sup>7</sup>

Furthermore, Petitioners’ argument basically rests on an allegation that *any* change to a design patent results in a “broader” design that does not infringe the original. That position is contrary to Supreme Court and Federal Circuit precedent.

After *Egyptian Goddess*, infringement is not based on “points of novelty” – isolated elements as Petitioners are arguing. Rather, infringement of a design patent must be based on the design as a whole. *Hall v. Bed Bath & Beyond, Inc.*, 705 F.3d 1357 (Fed. Cir. 2013). More particularly, the criterion for design patent infringement is that two designs are deemed substantially the same, if, in the eye of the ordinary observer, giving such attention as a purchaser usually gives, the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528, 20 L. Ed. 731 (1871).

To an ordinary observer, the designs here are substantially the same – the minute changes made by amendment do not change the overall appearance. The overall designs in the drawings are so close that the product of either would infringe the other. As the Supreme Court explained, the standard is the ordinary observer, not the expert. To say that the ordinary observer will discern between the precise elliptical nature of a racetrack as opposed to an oval, or discern the exact thickness

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<sup>7</sup> Although the narrowing here is minor, it is, nonetheless, still a narrowing.

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