

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARGET CORPORATION
Petitioner

v.

DESTINATION MATERNITY CORPORATION
Patent Owner

Case No. IPR2013-00531
Patent RE43,563

Dated: May 5, 2014

**PATENT OWNER'S MOTION IN THE ALTERNATIVE TO AMEND
CLAIM 1 OF U.S. PATENT NO. RE43,563**

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LIST OF EXHIBITS

- Exhibit 1001: Hendrickson et al. U.S. Patent No. RE43,563 (“the ’563 Patent”)
- Exhibit 1002: *J.C. Penney ontrend Maternity Catalog*, dated Fall/Winter 2005, cover and pages 15 and 19 (“JCP”)
- Exhibit 1004: U.S. Patent No. 6,276,175 to Browder (“Browder”)
- Exhibit 1029: PTAB Decision for IPR2013-00531 dated February 14, 2014
- Exhibit 1031: PTAB Decision for IPR2013-00532 dated February 19, 2014
- Exhibit 1034: Japanese Utility Model Patent No. 3,086,624 to Asada
- Exhibit 1035: Petitioner’s Certified Translation of Asada
- Exhibit 2019: Deposition transcript of Amy Brady (October 10, 2013)
- Exhibit 2020: Exhibit 114 from deposition transcript of Amy Brady
- Exhibit 2021: July 17, 2007 Patent Owner press release - introduction to Secret Fit Belly styles
- Exhibit 2022: Declaration of Phil Green
- Exhibit 2026: Declaration of David Brookstein, Sc.D. in Support of Patent Owner’s Motion in the Alternative to Amend Claim 1 of U.S. Patent No. RE43,563
- Exhibit 3002: October 10, 2013 Deposition of Mindy Simon

I. INTRODUCTION

Patent Owner Destination Maternity Corporation (“Patent Owner”) moves in the alternative to amend claim 1 of U.S. Reissue Patent RE43,563 (“RE’563”) under 35 U.S.C. § 316(a)(9) and 37 C.F.R. § 42.121. Patent Owner provides a “claim-by-claim approach to specifying the contingency of substitution” as required by *Idle Free Systems, Inc. v. Bergstrom Inc.*, IPR2012-00027, Paper 26 (June 11, 2013) at 10. If the Board determines that claim 1 is unpatentable over the prior art at issue in this trial, Patent Owner moves to amend claim 1. *Idle Free* at 4-5.

II. CLAIM LISTING

1. (Currently amended) A garment portion having an attached belly panel portion comprising:

an expansible belly panel adapted to [[substantially]] cover a wearer's entire belly region, said belly region comprising an area beginning just beneath the wearer's breast area and extending over the wearer's abdomen to a lower abdomen region beneath the wearer's belly, said belly panel comprising:

an upper edge portion defining a first encircling circumference about [[a]] the wearer's torso that is at or above the wearer's upper abdomen region during all stages of pregnancy, and

a lower edge portion spaced from the upper edge portion and defining a second encircling circumference about the wearer's lower abdomen region;

and

a garment lower portion, in communication with the lower edge portion, having a torso encircling circumference that recedes downward to make way for expansion of the belly panel.

III. GOOD CAUSE EXISTS FOR THE AMENDMENTS.

Patent Owner proposes two substantive amendments¹ to Claim 1 in the alternative, in the event that the Board finds claim 1 of RE'563 anticipated by JCP-A (Ex. 1002), Asada (Exs. 1034, 1035), and/or Browder (Ex. 1004).

The first substantive amendment further avoids anticipation by JCP-A and Asada by claiming an expansible belly panel that covers a wearer's torso from an area from just beneath the breast area to the lower abdomen:

an expansible belly panel adapted to [[substantially]] cover a wearer's entire belly region, said belly region comprising an area beginning just beneath the wearer's breast area

This addresses the Board's comment that claim 1 requires the belly *region*, but not necessarily the belly *panel*, to begin "just beneath the wearer's breast area." See PTAB Feb. 14, 2014 Dec. Paper 10 at 7. By eliminating the modifier "substantially," the expansible belly panel more clearly recites coverage of the entire belly region.

The second substantive amendment further avoids anticipation by JCP-A, Asada, and Browder by specifically claiming that the upper edge of the garment's

¹ Patent Owner also replaces "a" with "the" before "wearer's torso that is at or above the wearer's upper abdomen region" to clarify the claim.

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