

Filed on behalf of Clearlamp, LLC

By: Matthew L. Cutler (mcutler@hdp.com)
Bryan K. Wheelock (bwheelock@hdp.com)
Harness, Dickey & Pierce, PLC
7700 Bonhomme, Suite 400
St. Louis, MO 63105
Tel: (314) 726-7500
Fax: (314) 726-7501

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LKQ CORPORATION
Petitioner

v.

Patent of CLEARLAMP, LLC
Patent Owner

Case IPR2013-00020
Patent 7,297,364

PATENT OWNER CLEARLAMP, LLC'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION AND SUMMARY OF ARGUMENT.....	1
II. FACTUAL BACKGROUND.....	7
A. Overview of the Invention of the ‘364 Patent.....	7
B. The ‘364 Patent’s Novel Methods for Refurbishing Vehicle Lamps ...	8
C. The ‘364 Patent’s Prosecution History	10
III. LKQ’s Proposed Ground Do Not Show a Reasonable Likelihood That LKQ Will Prevail As To Any Claim	11
A. Certain of LKQ’s Proposed Grounds Must Fail Because They Rely on Arguments that the Office has Previously Rejected	12
B. The Office’s Prior Ruling that Kuta Teaches Away from the Claims Was Correct, and the Board Should Therefore Reject LKQ’s Grounds 1–5	13
C. The Cole Reference Also Teaches Away From Removing A Lamp From a Vehicle, so LKQ Likewise Cannot Prevail on Grounds 6–10	19
D. LKQ’s Ground 11 Fails Because Autopia Does Not Disclose Applying a Clear Coat to the Vehicle Light.....	21
E. LKQ’s Attempted Reliance on the “Admitted [Magni] Prior Art” in Grounds 1–11 is Improper and Does not Support a Finding of Obviousness.....	22
1. Grounds 1–11 must fail to the extent they rely on the ‘364 patent’s description, which is not prior art	22
2. The Magni Prosecution History Cited by LKQ Fails to Teach Applying the Compound as a Clear Coat to a Vehicle Lens	24
F. Grounds 2, 3, 5, 7, 8, 10, and 11 also fail because the Internet forum documents relied on in those Grounds are not competent evidence of the prior art	25
1. LKQ’s Internet-based evidence is not admissible evidence because it is not authenticated.....	25

2. LKQ has not shown Autopia, Eastwood, or SHO to be prior art because the alleged dates of those posts are supported only by inadmissible hearsay26

IV. CONCLUSION.....28

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Duhn Oil Tool, Inc. v. Cooper Cameron Corp.</i> , 818 F. Supp. 2d 1193 (E.D. Cal. 2011)	14
<i>Hilgraeve, Inc. v. Symantec Corp.</i> , 271 F. Supp. 2d 964 (E.D. Mich. 2003)	27
<i>In re Fulton</i> , 391 F.3d 1195 (Fed. Cir. 2004)	17
<i>In re Gurley</i> , 27 F.3d 551 (Fed. Cir. 1994)	14
<i>In re Hedges</i> , 783 F.2d 1038 (Fed. Cir. 1986)	15
<i>Janssen Pharmaceutic N.V. v. Mylan Pharmaceuticals, Inc.</i> , 456 F. Supp. 2d 644 (D.N.J. 2006).....	15
<i>Lorraine v. Markel Am. Ins. Co.</i> , 241 F.R.D. 534 (D. Md. 2007)	26
<i>Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.</i> , 73 F.3d 1085 (Fed. Cir. 1995)	15
<i>Ricoh Co., Ltd. v. Quanta Computer, Inc.</i> , 550 F.3d 1325 (Fed. Cir. 2008)	16
<i>St. Luke’s Cataract and Laser Inst. v. Sanderson</i> , 2006 WL 1320242 (M.D. Fla. May. 12, 2006)	26
<i>Symbol Techs., Inc. v. Opticon, Inc.</i> , 1990 WL 58887 (S.D.N.Y. May 3, 1990), 17 U.S.P.Q.2d 1737 (S.D.N.Y. 1990), <i>aff’d</i> , 935 F.2d 1569 (Fed. Cir. 1991)	23
<i>Tec Air, Inc. v. Denso Mfg. Mich., Inc.</i> , 192 F.3d 1353 (Fed. Cir. 1999)	14

U.S. v. Adams,
383 U.S. 39 (1966).....14

United States v. Cestnik,
36 F.3d 904 (10th Cir. 1994)27

Volterra Semiconductor Corp. v. Primarion, Inc.,
796 F. Supp. 2d 1025 (N.D. Cal. 2011).....17, 19, 20

STATUTES

35 U.S.C. § 102.....passim

35 U.S.C. § 103.....4, 6

35 U.S.C. § 112.....11

35 U.S.C. § 314.....1, 6, 11

35 U.S.C. § 316.....28

35 U.S.C. § 325.....2, 3, 12, 13

OTHER AUTHORITIES

37 C.F.R. § 42.6125

37 C.F.R. § 42.6225

37 C.F.R. § 42.10425

37 C.F.R. § 42.1071

77 Fed. Reg. 48756, 48758 (Aug. 14, 2012)25

77 Fed. Reg. 48764 (Aug. 14, 2012).....4

2 Donald S. Chisum, *Chisum on Patents*, § 5.03[3][a][i][G] (Matthew
Bender).....20

FRE 90125, 26

FRE 90226

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.