

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LKQ CORPORATION  
Petitioner

v.

CLEARLAMP, LLC  
Patent OWNER

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Case IPR2013-00020  
Patent 7,297,364

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Before SALLY C. MEDLEY, KEVIN F. TURNER, and  
JOSIAH C. COCKS, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On May 1, 2013, the following individuals participated in the initial

conference call:<sup>1</sup>

- (1) Mr. Alan Barry and Mr. Jason Engel, counsel for LKQ;
- (2) Mr. Bryan Wheelock, counsel for Clearlamp; and
- (3) Sally Medley, Kevin Turner, and Josiah Cocks, Administrative Patent Judges.

In preparation for the initial call, both parties filed a motions list. Papers 24 and 25. The following proposed motions and other matters were discussed during the call.

*Motion to File Supplemental Evidence*

LKQ seeks authorization to file a motion to submit supplemental evidence in the event Clearlamp challenges evidence submitted thus far by LKQ. Paper 24 at 1. Counsel for Clearlamp confirmed that Clearlamp did not serve any objection to evidence LKQ submitted during the preliminary proceeding, and thus there is no occasion for LKQ to file any supplemental evidence. *See*, 37 CFR 42.64(b)(1) and (2). Accordingly, the Board did not authorize a motion for LKQ to file supplemental evidence.

*Motion to Reconsider Certain Findings in the Board's Decision to Institute*

LKQ seeks authorization to file a motion to reconsider certain findings in the Board's Decision to Institute (Paper 18; "Decision") (i) that certain proposed grounds of unpatentability are redundant; and (ii) that certain disclosures do not constitute admitted prior art. Paper 24 at 1.

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<sup>1</sup> The initial conference call is held to discuss the Scheduling Order and any motions that the parties anticipate filing during the trial. Office Patent Trial Practice Guide, 77 *Fed. Reg.* 48756, 48765 (Aug. 14, 2012).

As explained, a party dissatisfied with a decision may file a request for rehearing without prior authorization from the Board. However, the time for filing such a request is within 14 days of the entry of the decision to institute. *See* 37 C.F.R. § 42.71. The time has expired to file a rehearing request. As explained, a late filing of the rehearing request will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice. 37 C.F.R. § 42.5(c)(3). In light of this explanation, counsel for LKQ represented that LKQ no longer seeks authorization to file a rehearing request.

#### *Motion to Amend Claims*

Clearlamp intends to file a motion to amend claims. Paper 25 at 2. The Board explained that any motion to amend must be filed with a detailed explanation as to how the proposed substitute claims obviate the grounds of unpatentability authorized in this trial, and a clear identification of where in the written description support for the claim amendment can be found. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. 37 C.F.R. § 42.221. A motion to amend should be filed as a separate paper, and not within the same paper as a patent owner response. Lastly, the parties were directed to the Patent Trial Practice Guide that explains that petitioners may respond to new issues arising from proposed substitute claims including evidence responsive to the amendment. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48766-48767 (Aug. 14, 2012).

In addition to the motion to amend, Clearlamp intends to file a response to the petition. The Board noted that any arguments for patentability not raised and fully briefed in the response will be deemed waived.

*Protective Order*

Clearlamp requests entry of a protective order. Paper 25 at 2. Counsel for the respective parties indicated that they will discuss the matter further to determine if a protective order is desired and whether the parties can agree on the content of the protective order. The parties understand that the Board has a default protective order that may be used in this proceeding.

Upon further consideration, and to the extent the parties agree upon a protective order, the parties are authorized to file a joint proposed protective order. To the extent the joint proposed protective order deviates from the Board's default protective order, the parties must identify how the proposed order departs from the Board's default order appearing in Appendix B to the Board's Trial Practice Guide. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48769.

*Schedule*

Counsel for the respective parties indicated that they have no issues with the Scheduling Order (Paper 19) entered on March 29, 2013.

*Settlement*

The parties represented that they are in negotiations, but have no agreement regarding settlement.

*Miscellaneous*

LKQ filed a motion to designate registered patent attorney, Mr. Jason Engel, as back-up counsel in place of Ms. Boice. Paper 20. The motion is dismissed. As explained, a motion was not necessary under the circumstances presented. LKQ

should update the counsel information in the Patent Review Processing System (PRPS) by adding Mr. Engel to the system. In addition, LKQ should file a paper under 37 CFR § 42.8(a)(3) notifying the Board of the replacement of back-up counsel. Should a question arise regarding adding Mr. Engel to the PRPS system, LKQ may contact the Board at 571-272-7822 for assistance.

Lastly, the parties indicated that the related litigation is stayed pending the *inter partes* review. The parties agreed to file a notice under 37 CFR § 42.8(a)(3) indicating the same.

*Order*

It is

ORDERED that LKQ's motion to designate back-up counsel (Paper 20) is *dismissed*;

FURTHER ORDERED that the parties are authorized to file a proposed protective order in accordance with the instructions provided above;

FURTHER ORDERED that any proposed protective order is due no later than May 16, 2013; and

FURTHER ORDERED that the parties provide the 37 CFR § 42.8(a)(3) notification updates in accordance with the instructions provided per this order.

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