

Case IPR2013-00020; Petitioner's Opposition to Motion to Amend

Trials@uspto.gov
Tel: 571.272.7822

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LKQ CORPORATION
Petitioner

v.

Patent of CLEARLAMP, LLC
Patent Owner

Case No. IPR2013-00020
Patent 7,297,364

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
AMEND**

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I. STATEMENT OF RELIEF REQUESTED

Patent Owner Clearlamp LLC (“PO” or “Clearlamp”), through its Motion to Amend (“Motion”)¹ and Patent Owner Response (“Response”), alleges that the ’364 Patent is the first disclosure of a process for refurbishing lamps to original equipment condition. In this regard, PO argues that the prior art Kuta reference fails to disclose the proposed substitute claims because it targets the consumer retail market, not the OEM refurbished parts market. (Motion, 2). Kuta, however, is not limited to PO’s purported “consumer retail market”. Regardless, the prior art teaches that “‘restoring’ [car parts] is an art based partly on observing, documenting and duplicating just how the factory did it when new”. (Ex. 1026) (emphasis added). PO’s expert, Mr. Katsamberis, admits that the prior art AS 4000 clear coat was used to “create OEM headlamps”. (Ex. 1017, 23:12-17). The Nestell patent is an example of a prior art patent that corroborates Mr. Katsamberis’ admission regarding the AS 4000 clear coat, its prior art status, and its use to create OEM headlamps. (Ex. 1028, 6:34-36). PO’s proposed substitute claims do not distinguish over the prior art of record, let alone the prior art known to PO.

PO proposes three iterative substitute claims for each challenged

¹ The Motion does not contain a statement of material facts. Accordingly, no response is due pursuant to 37 C.F.R. §42.23(a), and no facts are admitted.

independent claim.² Specifically, substitute Claim 25 adds trivial features to Claim 1, substitute Claim 25' adds trivial features to Claim 25 and substitute Claim 25'' adds trivial features to Claim 25'. Similarly, substitute Claim 37 adds trivial features to Claim 13, substitute Claim 37' adds trivial features to Claim 37, and substitute Claim 37'' adds trivial features to Claim 37'. Each iteration of the substitute claims was known in the prior art, so none of the proposed substitute claims is patentably distinct from the prior art. PO also has not demonstrated a need sufficient to rebut the presumption that only one substitute claim should replace each challenged claim. Moreover, PO has failed to distinguish the alternate substitute claims from one another. PO has also contravened page limit rules by impermissibly incorporating its Response throughout its Motion. (Motion, 2, 3, 5, 6) (e.g., "This is explained in the Patent Owner Response in [specific Sections of Response]."; ". . . for the same reasons discussed in the Patent Owner Response . . ."). The incorporated arguments should not be considered. (37 C.F.R. §42.6(a)(3)).

PO has thus failed to meet its burden to show that it is entitled entry of the substitute claims proposed in the Motion.

² While the Opposition focuses on the substitute claims, independent Claims 1 and 13 are also unpatentable over the art of record and the new art as applied herein.

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