

Filed on behalf of Clearlamp, LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LKQ CORPORATION
Petitioner

v.

CLEARLAMP, LLC
Patent Owner

Case IPR2013-00020
Patent 7,297,364

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

Fully Removing the Clearcoat Patentably Distinguishes Claims 25 and 37

Petitioner argues that “fully removing the clearcoat finish” does not patentably distinguish proposed substitute claims 25 and 37. (Paper 52, Opp., II.A.1, p. 3; III.A.1. p. 11). While Kuta does not use the word “partially”, Kuta discloses only partially removing the clearcoat. Kuta explains that the sanding discs (the only tool disclosed for removing the clearcoat) is “unable” to reach the corners of the lens:

when the lens 10 appears clear. Finally, an ultra-ultra fine 1500 grit sanding pad is moved manually and continuously over the exterior surface 12 of the automotive lens 10 until limited access corners 14 of the lens 10, where the sanding disc 20 is unable to reach, become clear and, again, while flushing the exterior surface 12 with water 30 as before.

Ex. 1002, ¶ [0023]. Petitioner *argues* that it would have been obvious to fully remove the clearcoat *if* the Kuta process were modified contrary to Kuta’s express purpose of avoiding the expense of removing and reinstalling lenses:

Therefore, the present invention method removes the abraded surface on a lens while it is still mounted on the vehicle, and restores optical clarity and light output to the level of new lenses.

Ex. 1002, ¶ [0010]. Kuta is limited to *in situ* treatment of the lenses, where the clearcoat is not (and apparently does not have to be) fully removed. Petitioner has not shown it was obvious to ignore Kuta’s teachings (1) not to remove the lenses and

(2) that partial removal of the clearcoat was adequate. Fully removing the clearcoat patentably distinguishes substitute claims 26 and 37. *See*, (Paper 35, Response, II.C.1., p. 12-15; II.D.a. p 21-25).

Evening the Lamp Surface Patentably Distinguishes Claims 25 and 37

Petitioner argues that “evening the lamp for surface by smoothing out the lamp surface to minimize any troughs created through the removal of the damage” does not patentably distinguish proposed substitute claims 25 and 37 (Paper 52, Opp., II.A.2. p. 5; III.A.2. p. 11). Patent Owner submits evening the lamp surface is not disclosed in Kuta. Evening the lamp surface patentably distinguishes substitute claims 25 and 37. *See*, (Paper 35, Response, II.C.2. p. 15-17, II.D.1.b. p. 25-26).

Petitioner also argues that the evening step lacks of antecedent basis. (Paper 52, Opp., II.A., p. 3). The language “removal of the damage” is supported by the preamble, “a method for refurbishing a lamp surface of a lamp *having surface damage.*” In any event, Petitioner concedes (Paper 52, Opp., II.A. p. 3) that alternative claim 25’ has adequate antecedent basis.

Restoring to OE Condition Patentably Distinguishes Claims 25’, 25’’ and 37’

Petitioner argues that the amendment “wherein, the steps (b) through (h) are performed to restore the lamp to its original equipment condition” does not patentably distinguish substitute claims 25’ or 25’’ (Paper 52, Opp., II.B. p. 7; II.C.2. p. 9) or 37’ (Paper 52, Opp., III.B. p. 12). However, the prior art does not

disclose a process that restores the lamp to its original equipment condition, or even that such a restoration is possible. Kuta teaches only partially removing the clearcoat, and while this may be acceptable to a consumer, it does not achieve an original equipment condition. This was confirmed by the unrebutted testimony of Patent Owner's experts, A. Harvey Bell, who established that Kuta does not remove the original clear coat (EX2004 ¶¶ 54-55), and Mr. Katsamberis, has stated that, if the original clear coat finish is not fully removed from the lamp surface, it is not possible to achieve an original equipment condition. (EX2007 at ¶¶ 27-29).

Restoring to original equipment condition patentably distinguishes claims 25', 25'', and 37'. *See* (Paper 35, Response, II.A.1. p. 7-8; II.D.1.a. p. 24-25; II.D.2. p. 32).

Removing Damage Patentably Distinguishes Claims 25'' and 37''

Petitioner argues that "removing the damage from the lamp surface" does not patentably distinguish proposed substitute claims 25'' and 37'' (Paper 52, Opp., II.C. p. 9, III.C. p. 12). This language is appropriate as providing additional antecedent basis for the evening step in claims 25'' and 37'', which patentably distinguishes the claims over the prior art.

Statically Neutralizing Distinguishes Claim 37

Petitioner argues that "Statically neutralizing debris on the lamp surface to facilitate removal of all of the debris on the lamp surface after all of the steps that create debris" does not patentably distinguish proposed substitute claim 37 (Paper

52, Opp., III.A.3., p. 11). As explained in Patent Owner's Response, p. 32, in Kuta the static neutralization occurs during the sanding process *and before the buffing process*. Thus, the lamp surface is "statically neutralized to facilitate the removal of all of the debris on the lamp surface" before the process has stopped creating debris on the lamp surface. There is no disclosure, for example, that after the buffing step (which Kuta describes as occurring after the grinding step), a further static neutralization is performed on the lens surface. EX2004 at ¶ 79. Instead, Kuta fails to teach neutralizing static to facilitate the removal of all of the debris from the lamp. Statically neutralizing patentably distinguishes claim 37. *See* (Paper 35, Response, II.D.2. p. 31-33).

The Substitute Claims Are Patentably Distinct over the Prior Art

Petitioner argues that the Patent Owner has not shown that the substitute claims are patentably distinct over the prior art. (Paper 52, Opp., IV. p. 13). The Patent Owner submits that the original claims in the patent distinguish over the prior art, but in the event that giving the claims their broadest reasonable interpretation (37 C.F.R. § 42.100(b)) gives the claims broader meaning than their actual meaning, the Patent Owner has conditionally proposed amendments to the original claims to give effect to the actual meaning of the claims. For each amendment, the Patent Owner explained how the proposed amendment distinguished over the prior art, with

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