

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

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

COCKS, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Summary

LKQ Corporation (“LKQ”) filed a petition on October 17, 2012 (Paper 1, “Pet.”) requesting *inter partes* review of claims 1-24 of U.S. Patent No. 7,297,364 (“the ’364 patent”) (Ex. 1001) pursuant to 35 U.S.C. §§ 311-319. On March 29, 2013, the Board instituted a trial for each of claims 1-24 on two grounds of unpatentability.¹

After institution of trial, the Patent Owner, Clearlamp, LLC (“Clearlamp”) filed a Patent Owner Response (“PO Resp.”) to the petition. Papers 33, 35². LKQ filed a Reply to Clearlamp’s Response on September 30, 2013 (“Pet. Reply”). Paper 50. Clearlamp also filed a Motion to Amend (Paper 38), a “Motion for Entry of Protective Order and to Seal Under 37 C.F.R. 42.54” (Paper 34), and a “Motion for Entry to Seal Under 37 C.F.R. 42.54” (Paper 41). LKQ has filed a Motion to Exclude Evidence (Paper 58).

Oral hearing was conducted on January 2, 2014.³

The Board has jurisdiction under 35 U.S.C. § 6(c). Pursuant to 35 U.S.C. § 318(a), this decision is “a final written decision with respect to the patentability of any patent claim challenged by the petitioner.”

LKQ has shown by a preponderance of the evidence that claims 1-10, 13, and 14 are unpatentable. LKQ has not shown that claims 11, 12, and 15-24 are unpatentable.

¹ See Paper 18 (“Institution Decision” or “Inst. Dec.”).

² Paper 33 is a version of Clearlamp’s Response filed with portions redacted. Paper 35 is an unredacted version of the Response filed under seal.

³ A transcript of the oral hearing has been entered into the record as Paper 72 (“Hr’g Tr.”).

Clearlamp's Motion to Amend is *denied*.

LKQ's Motion to Exclude Evidence is *dismissed*.

Clearlamp's "Motion for Entry of Protective Order and to Seal Under 37 C.F.R. 42.54" (Paper 34) is *granted*.

Clearlamp's "Motion for Entry to Seal Under 37 C.F.R. 42.54" (Paper 41) is *granted*.

B. The '364 Patent

The '364 patent relates to the refurbishing of lamp surfaces of a vehicle so as to remove surface wear and scratches. Ex. 1001, col. 1, ll. 8-12. The '364 patent includes twenty-four claims. Claims 1 and 13 are independent claims and are reproduced below:

1. A method for refurbishing a lamp surface of a lamp having surface damage, the method comprising the steps of:

removing the lamp from a motor vehicle;

removing an original clear coat finish from the lamp surface of the lamp;

evening the lamp surface;

grinding swirls and scratches out of the lamp surface;

buffing the lamp surface;

cleaning the lamp surface;

spraying a replacement clear coating material over the lamp surface; and

curing the replacement clear coat material.

13. A method for refurbishing a lamp surface of a lamp having surface damage, the method comprising the steps of:

removing the lamp from a motor vehicle;

removing an original clear coat finish from the lamp surface of the lamp;

evening the lamp surface;

grinding swirls and scratches out of the lamp surface;

buffing the lamp surface;

cleaning the lamp surface;

statically neutralizing debris on the lamp surface to facilitate the removal of all of the debris on the lamp surface;

spraying a replacement clear coating material over the lamp surface; and

curing the replacement clear coat material.

Id. at col. 4, ll. 33-45; col. 5, ll. 19-32.

C. Prior Art

The following items of prior art are involved in this *inter partes* review:

US 2005/0208210 A1("Kuta") September 22, 2005 Ex. 1002

US 6,106,648 ("Butt") August 22, 2000 Ex. 1003

Forum posts from Eastwood ShopTalk website⁴ (“Eastwood”) Ex. 1004

D. The Asserted Grounds of Unpatentability

The Board instituted trial on the following grounds of unpatentability:

Claims 1-24 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kuta and Butt.

Claims 1-24 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kuta and Eastwood.

II. ANALYSIS

A. Claim Construction

The Board construes a claim of an unexpired patent in an *inter partes* review using the “broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Claim terms usually are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the underlying patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Indeed, the ordinary and customary meaning usually applies unless an inventor has acted as his or her own lexicographer and has set forth a special meaning for a claim term. *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Neither LKQ nor Clearlamp contends that the inventors of the ’364 patent have acted as their own lexicographer and given any claim term a special meaning. Accordingly, we give all terms of the claims their ordinary

⁴ <http://forum.eastwood.com/showthread.php?118-Plastic-headlight-re-sealing&s=d3d5c104c4068d77bcc48e2e5ad4922>.

and customary meaning as would be understood by a person of ordinary skill in the art. We observe there is dispute between the parties as to the ordinary meaning of certain claim terms. We make explicit the meaning of the disputed terms.

1. *“removing an original clear coat finish from the lamp surface of the lamp”*

The parties disagree as to what extent the original clear coat finish must be removed in connection with the above-noted “removing” step. According to Clearlamp, the “removing” step requires that the clear coat finish be “fully” removed and does not encompass, within its scope, any removal characterized as less than full or complete removal, i.e., only “partially” removing the clear coat finish. PO Resp. 12-13. LKQ challenges Clearlamp’s position that the ordinary meaning of the step of “removing” the clear coat finish must be construed narrowly as “fully” removing. Pet. Reply 2.

In advocating for its proposed claim construction, Clearlamp relies on portions of the specification of the ’364 patent as well as the declaration testimony of Mr. Katsamberis (Exhibit 2007). PO Resp. 13-14. The referenced portions of the ’364 patent describe an embodiment of the disclosed invention in which during the refurbishing process a clear coat finish “is fully removed from the lamp surface.” Ex. 1001, col. 3, ll. 10-15. The portions also describe the resulting optical characteristics of the refurbished lamp “are very similar to those of the original equipment lamp assembly.” *Id.* at col. 4, ll. 21-23. Mr. Katsamberis also bases his opinion, that the claims require “fully” removing the clear coat finish, on the same portions of the ’364 patent. Ex. 2007 ¶ 27.

We are not persuaded that the claim interpretation proffered by Clearlamp presents the broadest reasonable interpretation of the pertinent phrase that would be understood by a skilled artisan in light of the specification. Notably absent from the claims themselves is the use of the qualifier “fully” in connection with the noted “removing” step. Indeed, the portions of the specification on which Clearlamp relies in advocating for its desired claim construction do not define the term “removing” as meaning only “fully removing” to the exclusion of an act of removing that is something less than “fully.” To that end, the referenced portion of the ’364 patent reads:

When grinding the original clear coat finish 12 a halo effect will be created differentiated between the different thicknesses of the original clear coat finish 12 as it is being ground off of the lamp surface 10. Thus, it can be confirmed that the original coat finish 12 is fully removed from the lamp surface 10 when the halo effect approaches the edges of the lamp surface 10.

Ex. 1001, col. 3, ll. 6-11

Thus, the ’364 patent conveys reasonably that removing the clear coat finish occurs to some degree less than “fully” until a “halo effect approaches the edges of” a lamp surface, at which point the removal is at the level of “full[]” removal. That does not establish a meaning of the term “removing” as narrowly meaning only “fully removing.” Moreover, that the clear coat finish is considered “fully removed” when the halo effect only “approaches” the edges of the lamp surface itself suggests that full removal of the clear coat finish is accomplished even if some residual remains at the outermost portions of the edges.

On this record, we are not persuaded that the broadest reasonable construction of “removing the original clear coat finish from the lamp

surface of the lamp” includes only total, or complete, removal of the finish within its scope, to the exclusion of an act of removal that is something less than the entire elimination of the finish. In other words, we conclude that the step of “removing” the clear coat finish encompasses within its scope the removal of less than all portions of the clear coat finish.

2. “*evening the lamp surface*”

Clearlamp contends that “evening the lamp surface” should be construed as “smoothing out the lamp surface to minimize any troughs created through the removal of damage.” PO Resp. 16. LKQ contends that the ordinary meaning of the pertinent phrase is simply “smoothing out the lamp surface” and that the qualifying portion that the smoothing has a particular purpose, i.e., “to minimize any troughs created through the removal of damage,” is unduly narrow. Pet. Reply 2 (emphasis omitted). We agree with LKQ.

The ordinary meaning of the verb “even” is “to make even; level; smooth.”⁵ With that meaning in mind, the claim feature “evening the lamp surface” would be interpreted seemingly as leveling or smoothing the lamp surface. That meaning is consistent with the meaning that is proffered by LKQ. Clearlamp does not explain why such leveling or smoothing should be qualified to be directed to a specific result, i.e., to “minimize any troughs created through the removal of damage.”

Accordingly, consistent with the meaning offered by LKQ, we construe “evening the lamp surface” as leveling or smoothing the lamp surface.

⁵ <http://dictionary.reference.com/browse/even?s=t> (last accessed March 6, 2014).

3. “*statically neutralizing debris*”

Claim 13 requires the step of “statically neutralizing debris on the lamp surface to facilitate the removal of all the debris on the lamp surface.” According to Clearlamp, there is an “implicit[.]” requirement of claim 13 mandating that the “statically neutralizing debris” step must be performed only after other steps of the claims have been performed, namely those directed to grinding and buffing of the lamp surface. PO Resp. 17-18. In support of its position, Clearlamp urges that such construction is dictated by “logic” and is supported in the Specification of the ’364 patent. *Id.* at 18-19 (citing Ex. 1001, col. 3, l. 64-col. 4, l. 3). LKQ disagrees with Clearlamp’s construction, urging that the claims reasonably encompass the performance of the statically neutralizing step at times other than after all grinding and buffing steps. Pet. Reply 2-3.

We agree with LKQ. “Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one.” *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342 (Fed. Cir. 2001). Here, there is no explicit language in the claims themselves that imposes a temporal restriction on the statically neutralizing step requiring that it be performed at a particular time.

We also are not persuaded by Clearlamp’s argument that claim 13 imposes an implicit time for the performance of the step. There simply is not a sufficient basis for concluding that such a step is limited intrinsically to performance at any particular time. That is, the broadest reasonable interpretation of claim 13 conveys that the statically neutralizing step may be performed at any of various times and, at any of those times, the step serves to remove all of the debris that is present on the lamp surface. The portion

of the Specification referenced by Clearlamp is consistent with that understanding. That portion simply conveys that, in one described embodiment, “[b]y neutralizing the lamp surface **10** to all static energy, particulate from the grinding and buffing steps may be more easily removed.” Ex. 1001, col. 3, l. 64-col. 4, l. 1. Even if that embodiment describes performance of the statically neutralizing step after all grinding and buffing acts have occurred, that does not preclude the performance of that step at other times in other embodiments.

Accordingly, we are not persuaded that claim 13 requires a singular time for the performance of static neutralization. Instead, as discussed above, the broadest reasonable construction of the step that is consistent with the Specification of the ’364 patent includes statically neutralizing at various times during the refurbishing process.

*B. Petitioner’s Evidence of Obviousness over Kuta
and either Butt or Eastwood*

1. LKQ’s Petition

a. Kuta

Kuta is titled “Headlight lens resurfacing apparatus and method.” Ex. 1002, Title. Kuta’s abstract is reproduced below:

Refinishing an exterior automotive lens having a damaged exterior surface in situ using a continuous movement and oscillating motion, with first, a 320 grit sanding disc, next a 600 grit sanding disc and finally a 1500 grit sanding pad while slushing the surface with water to prevent melting of the surface. Buffing the surface with a polishing compound until a high gloss is achieved. Finally, coating the surface with a transparent ultraviolet hardenable coating material, and hardening it by exposure to an ultraviolet light source. The

method is accomplished using an oscillating tool having a remotely located drive.

Thus, Kuta sets forth that its lens or lamp resurfacing approach is “in situ” and involves multiple sanding steps coupled with “slushing” the surface of a lens with water. Kuta’s process also involves steps of polishing and coating the lens surface.

b. Butt

Butt discloses a method of rebuilding a damaged lens of a vehicle lamp. Ex. 1003, Abstract. Butt describes that a damaged lens may be repaired while remaining on a vehicle. *Id.* at col. 2, ll. 53-57. Butt also describes that if desired, a vehicle lamp, and its associated lens, may be removed from the vehicle as a matter of convenience. *Id.* at col. 2, ll. 57-60. Thus, Butt conveys that the removal and the non-removal of a vehicle lamp are both known options to those of ordinary skill in the art when engaging in the repair or resurfacing of a damaged lens of a vehicle lamp.

c. Eastwood

Eastwood is a document characterized as a series of Internet forum posts from a website. The content of the posts are directed toward “resealing” and “buffing” the headlight of a vehicle. *E.g.*, Ex. 1004, p. 1. In a post dated February 18, 2005, and appearing on page 6 of Eastwood, a forum poster with the moniker “Pontistevve” states the following:

I took the headlights out of my Mustang to do them, because I didn’t want to risk any damage to the car. If I were making a business out of this, I would look at doing it the autosol way with a little 4” round pad. It wouldn’t get the edges too good, and is hard to get around the alignment dowels with, but you wouldn’t have to pull the lights. I just seriously doubt they would last real long. I’ve done it before with buffers and

rubbing compounds too, just never got em perfect and the longevity wasn't there. With my plastic polish way, I would bet on the results lasting for several years. I know some guys spray clear over the lenses too.

Thus, Eastwood, like Butt, conveys that the options of either removing a vehicle's headlight or maintaining it on the vehicle when refurbishing the headlight were known to one of ordinary skill in the art.

d. Reasons to Combine the References

In its Petition, LKQ urges that Kuta discloses all the limitations of claims 1-24 of the '364 patent with the exception of the requirement of "removing the lamp from a motor vehicle." Pet. 16-32. To account for that requirement, LKQ relied on the teachings of either Butt or Eastwood. As discussed above, each of those references establishes that it was known in the art that, in refurbishing the lamp of a vehicle headlight, the lamp may be removed. In light of that knowledge, LKQ contends that claims 1-24 would have been obvious. *Id.* at 8-12.

2. Clearlamp's Arguments

In its Patent Owner Response, Clearlamp contends that claims 1-24 of the '364 patent are not unpatentable over Kuta and either Butt or Eastwood because Kuta allegedly lacks certain features of those claims. PO Resp. 20-48.

a. "removing the lamp from the motor vehicle"

Each of claims 1 and 13 requires the step of removing a lamp from a motor vehicle in the course of refurbishing that lamp. In deciding to institute trial based on the disclosure of Kuta, the Board considered arguments offered by Clearlamp in its Preliminary Patent Owner Response

that Kuta teaches away from removing a lamp from a motor vehicle, as taught in each of Butt and Eastwood. We, however, were not persuaded that the arguments were correct. Inst. Dec. 8-11. In particular, the Board determined that one with ordinary skill in the art would have recognized reasonably from the teachings of the prior art that, in undertaking a vehicle lamp repair process, there are two known options with respect to the configuration of the lamp during that process, i.e., (1) that it be removed from the vehicle, or (2) that it remain mounted on the vehicle. We also determined that the art conveys that there are recognized tradeoffs attributed to each approach. Those tradeoffs include a cost benefit associated with maintaining the lamp on the vehicle versus a matter of convenience and alleviating potential vehicle damage associated with removing the lamp.

In its Patent Owner Response, Clearlamp again advances an argument that Kuta “teaches away” from combination with either Butt or Eastwood. PO Resp. 29. In making the argument, Clearlamp relies extensively on the declaration testimony of Mr. Bell (Ex. 2004). In particular, Clearlamp argues the following:

Patent Owner respectfully submits that it is more than just a matter of whether there are two choices of (1) removing the lamp from the vehicle, or (2) not removing the lamp from the vehicle, that is at issue in this analysis. EX2004 at ¶¶ 74-84. Instead, the context of the inventions dictates that Kuta teaches away from the suggested combination. *Id.* To that end, Kuta is directed to the consumer retail parts market. *Id.* at ¶ 80. When efficiency and cost-effectiveness is paramount, as is in the case in that industry, there is no reason to remove the lamp from the car. This is so, even if the quality of the end product suffers (such as not removing all the clear coat from the edge of the lamp, not evening the lamp surface, not statically

neutralizing the lamp to facilitate the removal of all debris, etc.). *Id.* at ¶ 76.

PO Resp. 29.

Thus, Clearlamp premises its argument on a theory that because Kuta may value the efficiency and cost-effectiveness in refinishing a lamp on a vehicle because of the particular consumer market or industry it targets, that indicates a “teach[ing] away” from an approach of removing the lamp as a quality measure that is targeted in another industry.

Clearlamp’s argument is unpersuasive. That Kuta may value a cost-effective approach to lamp refurbishing does not mean that a person of ordinary skill in the art must also value such an approach, to the preclusion of one that favors quality over cost. Indeed, rather than “no reason,” a person of ordinary skill in the art has good reason to select between a limited number of known options within his technical grasp when solving a particular problem, in this case engaging in lamp refurbishment. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.”) Here, selecting between the removal and non-removal of a vehicle lamp, where each approach has known tradeoffs, is not an undertaking based on innovation, but is instead the product of a skilled artisan’s exercise of ordinary skill and common sense.

We have fully considered Clearlamp’s position that the recited step of “removing the lamp from the vehicle” renders the claims of the ’364 patent

free of the applied prior art. However, in light of the record before us, we are not persuaded that the position is correct.

b. “removing an original clear coat finish from the lamp surface of the lamp”

The above-noted feature appears in each of claims 1 and 13. According to Clearlamp, Kuta does not disclose that feature because it allegedly does not disclose “fully” removing a clear coat finish.

At the outset, as discussed above, we are not persuaded that the step of “removing” the clear coat finish requires full or total removal to the exclusion of removal that is less than full. Kuta makes clear that its sanding process operates to remove a sufficient amount of an original clear coat finish from a lens surface to the point where the lens surface “appears clear,” is “satisfactory and quite clear,” and ensures that “clarity is restored to the lens.” Ex. 1002 ¶¶ 23, 25. A replacement coating then is applied to that clear surface. *Id.* We are not persuaded that Kuta fails to disclose the “removing” of a clear coat finish that is required by claims 1 and 13.

Moreover, even assuming that the claims do require full or complete removal of a clear coat finish, and that Kuta does not disclose removal to that extent, the question before us is one of obviousness. In an obviousness analysis, it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed because inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. *KSR Int’l Co.*, 550 U.S. at 418. In this case, that some amount of clear coat finish may remain after Kuta’s sanding steps is attributed to difficulty in reaching the corners of a lens or lamp when it remains affixed to

a vehicle. *See* Ex. 1002 ¶ 25. However, the grounds of unpatentability are premised on Kuta's disclosure when taken with either Butt or Eastwood.

Butt and Eastwood describe that in refurbishing vehicle lamps, the lamps may be removed from the vehicle because it is "more convenient" (Ex. 1003, col. 1, ll. 57-60) or to alleviate the potential of damage to the vehicle during the refurbishing process (Ex. 1004, p. 6). Although in Kuta, some clear coat finish may remain in Kuta's process due to one particular circumstance (i.e., a lamp or lens remaining in situ), as noted above, it is apparent that Kuta desires to remove as much of the finish as possible to a point where the lens is "satisfactory and quite clear." Ex. 1002 ¶ 23. A person of ordinary skill in the art reasonably would have inferred that, when a lens is removed from the vehicle, the refurbishing process is not inhibited in connection with access to the corners of the lens, and additional removal of the original clear coat finish may be attained to produce a lens that is appropriately clear. Indeed, that inference is consistent with the deposition of Clearlamp's own expert witness, Mr. Katsamberis. In that regard, the deposition includes the following exchange in connection with the above-noted issue:

Q. [from counsel for LKQ] Let's assume for a second that the system of Kuta was used to refinish a lamp that had been removed from a car; okay? Can you assume that?

A. [from Mr. Katsamberis] Yes.

Q. Would the limited access corners which are labeled as Number 14 in Kuta still exist if that was the case?

A. Probably not.

Q. Why not?

A. Because the car body will not be there to limit your access to those corners.

Ex. 1017, p. 102, ll. 4-15 (emphasis removed).

We have considered the declaration testimony of Clearlamp's expert witnesses, Mr. Bell (Ex. 2004) and Mr. Katsamberis (Ex. 2007). That testimony, however, neglects to consider appropriately what a person of ordinary skill in the art would have taken from the combined teachings of Kuta and either Butt or Eastwood. None of Clearlamp, Mr. Bell, or Mr. Katsamberis, adequately explains why a skilled artisan, not faced with resurfacing a lamp that remains on a vehicle, would stop short of fully removing a clear coat finish when seeking to produce a lens or lamp that is "satisfactory and quite clear."

Accordingly, we have considered Clearlamp's arguments, but conclude that LKQ has shown by a preponderance of the evidence that the claimed step of "removing an original clear coat finish from the lamp surface of the lamp" does not distinguish the claims over the prior art.

c. "evening the lamp surface"

According to Clearlamp, the step of "evening the lamp surface" recited in claims 1 and 13 is absent from the disclosure of Kuta. In that regard, although Kuta discloses multiple sanding operations associated with its headlight resurfacing method, Clearlamp maintains that the evening of the lamp surface required by the claims is absent from the teachings of Kuta. According to Clearlamp, that is so because there is "no reason to even out the lamp" in Kuta, and, in support of that position, Clearlamp relies on the declaration testimony of Mr. Bell (Ex. 2004). PO Resp. 25-26. Mr. Bell

testifies, in part, that Kuta does not disclose the “evening” step because it allegedly does not minimize any troughs created through the removal of damage. Ex. 2004 ¶ 57.

At the outset, as discussed above, we are not persuaded that the “evening” step in question narrowly requires that “troughs” be minimized. Instead, the broadest reasonable construction of the “evening” step simply requires that the surface of a lamp be smoothed or leveled. Clearlamp’s arguments and Mr. Bell’s testimony in that regard, do not take into account the broadest reasonable interpretation of “evening the lamp surface.”

Furthermore, we observe that there is marked similarity between the disclosure in the ’364 patent as to what actions enter into “evening” and Kuta’s sanding procedures. In particular, the ’364 patent describes the use of various “grits” of sandpaper, including “320 sandpaper” which is applied to the lamp surface during the act of removing the original clear coat and also explains that “the evening of the lamp surface **10** includes the step of grinding the lamp surface **10** with a sandpaper having a grit of approximately 320.” Ex. 1001, col. 2, l. 58-col. 3, l. 24. Similarly, Kuta also discloses that its sanding process involves the use of sanding disc 20 of “approximately 320 grit” that is “moved continuously” using an “oscillating motion” over the surface of a lens. Ex. 1002 ¶ 23. Elsewhere, Kuta characterizes the configuration of sanding disc 20 as incorporating foam pad 21 that is “critical for smoothing lens **10**.” *Id.* ¶ 28.

We have considered the arguments advanced by Clearlamp in connection with the step of “evening of the lamp surface.” However, in light of the clear and unambiguous disclosure in Kuta of the above-noted sanding operation, Kuta discloses the required step of “evening” the lamp surface.

d. “*spraying a replacement clear coating material over the lamp surface*”

In accounting for the above-noted feature appearing in claims 1 and 13, LKQ points to Kuta at paragraphs 23 and 26. Pet. 21. The noted portions of Kuta describe the application of “a transparent ultraviolet hardenable coating material” applied to the lens as a “scratch resistant coating.” Clearlamp contends that one of ordinary skill in the art would not have understood that “spraying” is an available technique for the application of such a coating. PO Resp. 27. In support of that contention, Clearlamp relies on the declaration testimony of its expert witnesses, Mr. Bell and Mr. Katsamberis. *Id.* at 27-28. In particular, according to Mr. Bell:

Because Kuta discloses an *in situ* refinishing process, a person of ordinary skill in the art would have recognized that it would have been uneconomical (too expensive and time consuming) to conduct full preparations to the vehicle such that a clear coat could be sprayed (as opposed to brushing or wiping) onto the lamp surface. For example, spraying a clear coating without first covering the hood or front bumper would result in clear coating being applied to those surfaces. As such, a person of ordinary skill in the art would not have understood Kuta to teach *spraying* a replacement clear coating finish on the lamp surface.

Ex. 2004 ¶ 60.

Similarly, Mr. Katsamberis gives the following testimony:

The Kuta process is directed to a refinishing process in which the lamp remains on the vehicle while it is being refinished. Further, Kuta’s teaching that its process is “more cost effective” ([0010]) (because it does not require removal of the lamp) would have indicated to a person of ordinary skill that Kuta did not describe a process in which adjacent parts of the car (hood, bumper, side panel) were covered before the new clear coating is applied. That is because covering the car parts around the uneven surface of the lamp is time-intensive and

requires precise placement, especially if the coverings are, for example, square or rectangular sheets or tarps.

As a result, a person of ordinary skill in the art would have understood that the replacement clear coating of Kuta would not be sprayed on. Rather, it would be brushed or wiped onto the lamp.

Ex. 2007 ¶¶ 38, 39.

Neither Mr. Bell nor Mr. Katsamberis testifies that the prospect of “spraying” a clear coat onto a vehicle lamp was one not known in the art. Indeed, it is apparent from their testimony that spraying such a coating was a known approach in the art, albeit one with potential economic detriments when applied to lamps that remain on a vehicle. In other words, that spraying may be a less preferred option when applying a replacement coating onto a vehicle lamp that remains affixed to a vehicle does not indicate that spraying is an unknown or unworkable technique. Obviousness does not require that a particular approach be the most beneficial or the most advantageous.

Furthermore, the grounds of unpatentability proposed by LKQ and at issue in this trial are not premised on Kuta taken alone. Instead, the grounds are based on Kuta taken with either Butt or Eastwood. As discussed above, each of Butt and Eastwood conveys that when refurbishing the lamps of a vehicle, it was known in the art that the lamps may be either removed from or maintained on a vehicle. When so removed, the potential detriments associated with spraying the clear coat seemingly no longer would be of concern.

Moreover, it is recognized in Eastwood that spraying is a known option for applying a clear coat. In that regard, as set forth in the forum post by “Pontistevé” (reproduced *supra*), after relaying that either keeping the

lamps on a vehicle or removing the lamps are available options, Pontistevé states that “I know some guys spray clear over the lenses too.” Ex. 1004, p. 6. Thus, the application of clear coat via “spray” is a known technique, which is consistent with the testimony of Mr. Bell and Mr. Katsamberis. The record thus establishes that a person of ordinary skill in the art, in implementing teachings of removing a lamp onto Kuta’s lens refurbishing process, would have known that a replacement coating may be applied via an act of spraying.

Accordingly, for the foregoing reasons, we conclude that LKQ has shown by a preponderance of the evidence that the step of “spraying a replacement clear coating material over the lamp surface” does not patentably distinguish the claims of the ’364 patent over the prior art.

e. “statically neutralizing debris”

In its Petition, LKQ points to content of Kuta describing a process of flushing the surface of a lens during the sanding process in accounting for the “statically neutralizing debris” step of claim 13. Pet. 28 (citing Ex. 1002 ¶¶ 23, 24, and 29). As set forth in those paragraphs of Kuta, the surface of a lens is flushed with water during sanding to remove material from the lens and is continued until the flushing water “turns clear.” Ex. 1002 ¶ 23.

Clearlamp does not contend that the water flushing procedure in Kuta fails to constitute an act of statically neutralizing debris so as to remove debris from the surface of Kuta’s lens. We also observe that each of Clearlamp’s experts, Mr. Bell and Mr. Katsamberis, when queried, were of the view that the act of flushing of water over a lens surface may constitute a step of statically neutralizing debris on the surface. Ex. 1017, pp. 103-104; Ex.1018, pp. 48-49. We are satisfied that the record before us conveys that

Kuta's process of flushing water over the lens surface is an act of statically neutralizing debris on the surface. In arguing that Kuta does not meet the step of "statically neutralizing debris on the lamp surface to facilitate removal of all of the debris on the lamp surface," Clearlamp relies on its construction of the pertinent step in requiring a particular sequence of the application of the "statically neutralizing" technique as occurring only after all steps of grinding and buffing have been completed. PO Resp. 31-32.

As noted above, however, we are not persuaded that Clearlamp's construction of the pertinent "statically neutralizing debris" step is correct. The claims do not require that the step occurs at a particular time. As noted above, Kuta explains that its application of "flushing water" upon the surface of a lens is done until that water "turns clear" and the sanding process is stopped. Ex. 1002 ¶ 23. Flushing the lens surface until the water "turns clear" conveys that all of the debris on the surface, at that time, has been removed.

We are cognizant of the testimony of Mr. Bell and Mr. Katsamberis on which Clearlamp relies in connection with its position concerning the "statically neutralizing debris" step. *See* PO Resp. 32-33 (citing Ex. 2004 ¶ 79; Ex. 2007 ¶ 21). That testimony is predicated on an assumption that claim 13 of the '364 patent requires that static neutralization occur only after certain grinding and buffing steps and before the application of a clear coating so as to place the refurbished lamp into a state characterized as "original equipment condition" or "OEM." *See* Ex. 2004 ¶ 79; Ex. 2007 ¶ 21. The claims, however, do not require any particular time for statically neutralizing debris. Also, neither of the terms "original equipment

condition” or “OEM” appears in claim 13. We conclude that the claim does not require any particular resulting condition of the resurfaced lamp.

We have considered Clearlamp’s arguments, but conclude that LKQ has shown by a preponderance of the record that the step of “statically neutralizing debris on the lamp surface to facilitate removal of all of the debris on the lamp surface,” does not patentably distinguish claim 13 over the prior art.

f. “applying infrared radiation to the lamp surface”

Each of claims 11 and 15 requires that the step of curing the replacement clear coat includes a step of “applying infrared radiation to the lamp surface.” As was advanced in its Petition, LKQ relies on disclosure contained within the ’364 patent. In particular, LKQ pointed to the following description in the ’364 patent:

Once applied, the replacement clear coat material 58 is cured at 60. The curing process 58 is done by having the replacement clear coat surface 58 receive infrared radiation. The material used to create the replacement clear coat surface 58 is sold by assignee under the trademark MAGNI 700, which requires enough infrared radiation typically found in an oven at a temperature of 230° F. ± 40° F. for approximately 45 minutes to 60 minutes.

Ex. 1001, col. 4, ll. 10-17.

According to LKQ, the above-quoted statement from the ’364 patent constitutes admitted prior art and demonstrates that a person of ordinary skill in the art would have understood that “infrared radiation” may be used in curing a replacement clear coat. Pet. 24-25, 29. During the course of this *inter partes* review proceeding, including in the Patent Owner Response (PO Resp. 33-35) and at oral hearing (Hr’g Tr. 29), Clearlamp disputes LKQ’s

characterization of the pertinent content of the '364 patent as “admitted prior art.” In that regard, Clearlamp contends that the statement is not prior art to the '364 patent, and is not considered properly as evidence of the use of infrared radiation in the course of curing a clear coat.

In considering the respective positions of LKQ and Clearlamp, it is not apparent that the above-noted statement in connection with the “MAGNI 700” is an admission as to prior art. There is no indication in the above description that the curing of the clear coat using infrared radiation was known to anyone but the inventors prior to the filing of the application that issued as the '364 patent. The description is contained in the body of the patent describing the invention, and not, for example, in the background section of the patent description. Moreover, LKQ has not directed us to suitable supporting evidence demonstrating that the above description is indicative of known prior art. In that regard, we are persuaded by Clearlamp that LKQ has not established sufficiently that the statement in the '364 patent concerning “MAGNI 700” is evidence for use as a factual basis in any of LKQ’s proposed grounds of unpatentability.

In its Reply, LKQ attempts to bolster its case that the statements in the '364 patent concerning “MAGNI 700” are prior art. In particular, according to LKQ, Clearlamp’s “expert confirmed that Magni 700 was a clear coat with the same chemistry as prior art AS 4000. (Ex. 1017, 18-23-19:2).” Pet. Reply 10. Even assuming that LKQ’s assessment of the testimony of the expert is correct, LKQ does not explain sufficiently why chemical similarities between “MAGNI 700” and some other coating type, i.e., “AS 4000,” establishes the portions of the '364 patent as admitted prior art. LKQ also does not explain sufficiently how such similarity between those

products demonstrates an appropriate underlying factual basis to account for the application of the required infrared radiation as a curing technique.

We have considered the record developed over the course of the trial in this *inter partes* review proceeding. For the foregoing reasons, we are not persuaded that LKQ has established the requisite factual basis in connection with the requirements of claims 11 and 15 concerning the application of infrared radiation in a process of curing a replacement clear coat material.

3. Conclusion - Petitioner's Evidence of Obviousness

On review of the record before us, we conclude that LKQ's Petition establishes a prima facie basis that claims 1-10, 13 and 14 are unpatentable over Kuta taken with either Butt or Eastwood. However, because LKQ has not accounted appropriately for features of claims 11 and 15, we are not persuaded that LKQ has demonstrated that those claims are unpatentable on the grounds of unpatentability involved in this proceeding. Claims 12 and 16-24 ultimately depend from either claim 11 or claim 15. On this record, we also are not persuaded of the unpatentability of claims 12 and 16-24.

C. Secondary Considerations of Nonobviousness

Once a prima facie case of obviousness has been established, a patentee may come forward with evidence, i.e., secondary considerations, of nonobviousness for evaluation en route to the ultimate conclusion of obviousness. *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012). As discussed above, LKQ has established a prima facie case of obviousness in connection with claims 1-10, 13, and 14. In response, Clearlamp has come forward with

evidence that it contends shows “(1) copying of others and (2) commercial success” with respect to the ’364 patent. PO Resp. 37.

At the outset, we note that “secondary considerations of nonobviousness . . . simply cannot overcome a strong prima face case of obviousness.” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010). Indeed, “where the inventions represented no more than ‘predictable use of prior art elements according to their established functions,’ the secondary considerations are inadequate to establish nonobviousness as a matter of law.” *Id.* (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)). Here, the prima facie basis for obviousness with respect to claims 1-10, 13, and 14 is strong because, as discussed above, each of the recited features of those claims was well known in the art of vehicle lamp refurbishment, as evidenced by Kuta, Butt, and Eastwood. Claims 1-10, 13, and 14 predictably employ those steps for their known and established functions in the art. That Clearlamp may present some evidence of nonobviousness does not compel a determination that the evidence overcomes a strong case of obviousness, as is presented here. In any event, we also are not persuaded that the evidence on which Clearlamp relies is sufficient to demonstrate nonobviousness.

1. Copying By Others

Although, “copying by a competitor may be a relevant consideration in the secondary factor analysis[,]” “[n]ot every competing product that arguably falls within the scope of a patent is evidence of copying.” *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004). Copying, as objective evidence of nonobviousness, requires evidence

of effort to replicate a specific product. *Wyers*, 616 F.3d at 1246; *Iron Grip*, 392 F.3d at 1325.

Here, Clearlamp relies, in-part, on the declaration testimony of Dr. Robert Sandau (Ex. 2016) in making out its case of copying. In particular, Clearlamp points to testimony of Dr. Sandau describing various meetings that occurred between one more of the inventors⁶ of the '364 patent and representatives of LKQ, including Dr. Sandau. In his Declaration, Dr. Sandau testifies that, in those meetings, aspects of the inventors' process in refurbishing lamps were discussed. Clearlamp also emphasizes the following in connection with Dr. Sandau's testimony:

At least one of the meetings took place at Mr. Paperi's facility "[t]hey had their, their coating line and everything, they took us through that...[t]hey took us through, showed us how the system worked, you know, how the spray application went on."

PO Resp. 41.

Thus, Clearlamp contends that, in at least one meeting, aspects of the "coating line" and "spray application" were shown to representatives of LKQ in connection with the production facility of inventor Paperi. We note, however, that the following portion of Dr. Sandau's testimony is omitted from that quoted above: "There was no product and no one working in the facility when they took us through so we couldn't actually see them showing what they were doing." Ex. 2016, p. 27, ll. 19-22. Thus, Dr. Sandau also testifies that, at the noted "at least one meeting," the representatives of LKQ did not actually see the operations of the facility. We further observe that Dr. Sandau testifies that Mr. Paperi, when queried, would not disclose

⁶ The inventors of the '364 patent are Alexander Krause-Heringer and Maurice Paperi.

aspects of his process pertaining to the type of clear coating involved. Ex. 1016, p. 54, l. 19- p. 55, l. 2.

We have reviewed the record before us in connection with Clearlamp's position that LKQ copied the claimed invention of the '364 patent. In light of that review, it is not apparent from the evidence of record, including Dr. Sandau's testimony, that LKQ was afforded complete access to the entirety of the refurbishing process that was employed by Mr. Paperi. Neither is it apparent from the record that there is sufficient evidence that LKQ undertook to replicate the particular process of Mr. Paperi. Indeed, even assuming that LKQ does produce a product encompassed by the invention of the '364 patent, for instance that of claims 1 and 13, the record suitably establishes that one of ordinary skill in the art would have been cognizant *from the prior art* of all the steps associated with those claims and which operate for their intended function. In that regard, Clearlamp has not shown persuasively that LKQ's refurbishing process is due only to an act of copying of the particular process practiced by Dr. Paperi, rather than simply through practice of the teachings of the prior art.

2. *Commercial Success*

To demonstrate nonobviousness based on "commercial success," Clearlamp must show that commercial success actually occurred and that there is a nexus that exists between that success and the merits of the claimed invention. *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1350 (Fed. Cir. 2012). In order to establish a proper nexus, a patentee must offer "proof that the sales were a direct result of the unique characteristics of the claimed invention-as opposed to other economic and commercial factors unrelated to the quality

of the patented subject matter.” *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). Furthermore, absent comparative sales data such as market share information, absolute numbers are not very meaningful. *See Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1567 (Fed. Cir. 1984). In that regard, “evidence related solely to the number of units sold provides a very weak showing of commercial success.” *Huang*, 100 F.3d at 140.

Here, Clearlamp bases its commercial success position generally on “the sale of headlamps by LKQ” and urges that those sales alone “demonstrate significant commercial success of the patented invention.” PO Resp. 47 (citing Ex. 2009 ¶¶ 47-48). Yet, even assuming that headlamps produced by LKQ are those encompassed by the claimed invention of the ’364 patent, which has not been shown, the existence of sales alone sheds little light on the underlying reasoning for the sales. Indeed, absent from any of Clearlamp’s filings is any meaningful assessment of other potential factors that may have contributed to such sales that have no bearing on the merits of the invention of the ’364 patent. Also, absent from Clearlamp’s filings is any comparative sales data that would indicate what the noted sales mean in conjunction with market share. Neither can we infer from the information provided that the noted sales represent a substantial share of the market. Simply put, Clearlamp has not offered sufficient information for us to determine whether the refurbished headlamps were actually commercially successful to demonstrate nonobviousness.

3. Conclusion

In connection with claims 1-10, 13, and 14, we have considered all evidence of record and have weighed the objective evidence offered by Clearlamp that it contends demonstrates nonobviousness against the

evidence of obviousness. For the foregoing reasons, we conclude that, on balance, the strong evidence of obviousness outweighs the weak evidence of nonobviousness. Accordingly, we conclude that LKQ has shown by a preponderance of the evidence that claims 1-10, 13, and 14 would have been obvious over the prior art.

D. Clearlamp's Motion to Amend Claims

Clearlamp filed a motion to amend claims. Paper 38 (“Mot. to Amend”). Clearlamp “moves to substitute claims 25-48 for claims 1-24 at issue in this *Inter Partes Review*.” Mot. to Amend 2. We understand from the content of Clearlamp’s motion that it is a contingent motion. In that regard, the proposed substitute claims 25-48 are contingent on the Board’s determination that claims 1-24 are unpatentable based on LKQ’s Petition.

Title 37 C.F.R. § 42.121 sets forth the requirements pertaining to “Amendment of the patent.” Section 121(a)(3) is reproduced below:

(3) *A reasonable number of substitute claims.* A motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims. The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.

Thus, only a “reasonable number” of substitute claims are permitted, and there is a presumption that only one substitute claim is needed to replace a challenged claim (i.e., “one for one” claim substitution).

Here, however, Clearlamp has not proposed one for one substitution of claims, and instead has proposed multiple “alternative” replacement claims for various claims of the ’364 patent. *See* Mot. to Amend 2-15. More particularly, with respect to claim 1, Clearlamp proposes three alternative substitute claims designated 25, 25’ and 25’’ and, with respect to

claim 13, three alternative substitute claims designated 37, 37' and 37''. Clearlamp, however, makes no attempt to rebut the presumption of one for one claim substitution by demonstrating a need for multiple alternatives. At oral hearing, when queried about the "alternative" substitute claims in its Motion to Amend, counsel for Clearlamp withdrew from consideration claims 25, 25', 37 and 37'. In particular, counsel for Clearlamp represented that the "double prime" versions of the pertinent claims are the only substitute claims for original claims 1 and 13 the Board need consider.⁷

Accordingly, the Board exercises its discretion in connection with the multiple alternative, substitute claims and considers those pertinent claims characterized as "double prime" versions. Substitute claims 25'' and 37'', which are substitute claims for claims 1 and 13, respectively, are contingent on a determination that claims 1 and 13 are unpatentable. Because the Board has determined that claims 1 and 13 are unpatentable over prior art, the contingency has manifested. Therefore, consistent with the requirements of 37 C.F.R. § 41.121 and Clearlamp's above-noted withdrawal from our consideration claims 25, 25', 37 and 37' we consider substitute claims 25'' and 37'' that appear in the Motion to Amend.

⁷ MR. CUTLER: That is going to be correct. 37 double prime and 25 double prime.

MR. ENGEL: Both double prime?

MR. CUTLER: Both double prime.

JUDGE MEDLEY: Are those the only two we need to consider?

MR. CUTLER: That's right.

Hr'g Tr. 58.

1. Clearlamp's Burden of Proof

In connection with a motion to amend claims, a patent owner, as the moving party, bears the burden to show entitlement to the relief requested. 37 C.F.R. § 42.20(c). Thus, Clearlamp bears the burden of proof in demonstrating patentability of its substitute claims over the prior art. The following discussion from *Idle Free systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, slip. op. 33 (PTAB January 7, 2014, Paper 66) is instructive in that regard:

Distinguishing the proposed substitute claims only from the prior art references applied to the original patent claims, however, is insufficient to demonstrate general patentability over prior art. An *inter partes* review is neither a patent examination proceeding nor a patent reexamination proceeding. The proposed substitute claims are not entered automatically and then subjected to examination. Rather, the proposed substitute claims will be added directly to the patent, without examination, if the patent owner's motion to amend claims is granted. As the moving party, a patent owner bears the burden to show entitlement to the relief requested. 37 C.F.R. § 42.20(c).

That is, Clearlamp has the burden of showing the patentability of its proposed substitute claims 25'' and 37'' over the prior art in general, and not simply over the prior art that was applied to the original patent claims. With the above backdrop in mind, we proceed to consideration of Clearlamp's Motion to Amend pertaining to substitute claim 25'' and substitute claim 37''.

2. *Substitute Claim 25''*

Claim 25'' as is set forth in the Motion to Amend is reproduced below, and includes underlined text indicating material inserted relative to claim 1.

A method for refurbishing a lamp surface of a lamp having surface damage, the method comprising the steps of: (a) removing the lamp from a motor vehicle; (b) removing damage from the lamp surface of the lamp; (c) fully removing an original clear coat finish from the lamp surface of the lamp; (d) evening the lamp surface by smoothing out the lamp surface to minimize any troughs created through the removal of the damage; (e) grinding swirls and scratches out of the lamp surface; (f) buffing the lamp surface; (g) cleaning the lamp surface; (h) spraying a replacement clear coating material over the lamp surface; and (i) curing the replacement clear coat material; wherein, the steps (b) through (i) are performed to restore the lamp to its original equipment condition, with the lamp surface having an optical quality similar to the optical quality of an original equipment lamp surface.

Mot. to Amend 8-9.

Claim 25'' effectively adds to claim 1 four substantive features. In that regard, claim 25'' adds steps of: (1) "removing damage from the lamp surface of the lamp; (2) "fully" removing an original clear coat finish; (3) evening the lamp surface, encompassing "smoothing out the lamp surface to minimize any troughs created through the removal of the damage"; and (4) performing steps (i.e., (b) through (i) in claim 25'') "to restore the lamp to its original equipment condition, with the lamp surface having an optical quality similar to the optical quality of an original equipment lamp surface."

a. “*removing damage from the lamp surface of the lamp*”

With respect to this added feature, Clearlamp contends that it is not disclosed in any of Kuta, Butt, or Eastwood, and concludes that the feature, as such, distinguishes claim 25” over the prior art. Mot. to Amend 4. At the outset, that each of Kuta, Butt, and Eastwood may lack the “removing damage” step added by claim 25” is, in and of itself, not sufficient to demonstrate that the feature distinguishes the claim from the prior art in general.

In any event, we are not persuaded that the feature is absent from the disclosure of Kuta. As set forth in Kuta, it is directed to “[r]efinishing an exterior automotive lens having a *damaged exterior surface*.” Ex. 1002, Abstract (emphasis added). Further, Kuta makes explicit that its disclosed method “is a step-by-step process for removing this damage, to return lenses 10 to like-new condition without the relatively high cost of replacing them.” *Id.* ¶ 23. Clearlamp contends that Kuta’s disclosure “at most ‘removes a scratch resistance coating’” and does not “remove damage.” Mot. to Amend 4. In support thereof, Clearlamp points to the testimony of Mr. Bell (Ex. 2004 ¶¶ 51-53). The noted portions of Mr. Bell’s testimony, however, do not state that Kuta is understood as not removing damage. Also, neither Mr. Bell nor Clearlamp addresses the explicit disclosure in Kuta directed to the goal of removing damage from a lens or lamp.

In light of the plain disclosure in Kuta concerning the removal of damage to a lens or lamp, we agree with LKQ that Kuta contemplates “removing damage from the lamp surface of the lamp” that is required by claim 25”. *See* Paper 52 (“Opp. Mot. to Amend”), p. 6.

b. “fully” removing an original clear coat finish from the lamp surface of the lamp

As discussed above (*see* section II.B.2.b.), we are not persuaded that the act of “fully” removing an original coat finish is a recitation that is patentably distinguished over the prior art, such as the teachings of Kuta taken with either Butt or Eastwood. In that regard, a person of ordinary skill in the art would have appreciated reasonably that an original coat finish may be “fully” removed if desired. We are also cognizant of the teachings of the prior art characterized by LKQ as “Toyota Prelude Club Forum Posts” (Ex. 1024) (“Prelude”). Pet. Opp. 5. As set forth in Prelude, and as noted by LKQ, during the course of “renewing” headlights, it is recognized that “all of the clearcoat” may be removed during a sanding operation. *Id.* (citing Ex. 1024).

c. evening the lamp surface “by smoothing out the lamp surface to minimize any troughs created through the removal of the damage”

During the course of this proceeding, Clearlamp has argued that Kuta does not perform “evening” of a lamp surface by “smoothing” the surface to minimize “troughs” that may be created during the course of removing damage from the lamp. *See* PO Resp. 25-26; *see also* Mot. to Amend 2. Once again, Clearlamp’s focus on the disclosure of Kuta is insufficient to meet Clearlamp’s burden in demonstrating patentability of the prior art in general. Furthermore, with respect to Clearlamp’s assertions concerning Kuta, we do not agree.

As discussed above, Kuta describes a sanding operation in which sanding disc 20 is “moved continuously” using an “oscillating motion” over the surface of a lens so as to return the lens to “like-new condition.” Ex.

1002 ¶ 23. Kuta also characterizes the operation of sanding disc 20 as contributing to the “smoothing” of the lens. *Id.* ¶ 28. Clearlamp does not explain adequately why sanding a lens to restore it to a like-new condition and which contributes to smoothing of the lens does not amount to the evening step required by claim 25”, including the removal of imperfections, such as troughs, that may be generated during the refurbishing process.

Accordingly, we are not persuaded that the “evening” step recited in claim 25” distinguishes the claim over the prior art.

d. Performing steps “to restore the lamp to its original equipment condition, with the lamp surface having an optical quality similar to the optical quality of an original equipment lamp surface.”

Clearlamp generally contends that the step of restoring a lamp to its “original equipment condition” serves to distinguish claim 25” over the prior art. Mot. to Amend 3. In support of that contention, Clearlamp makes reference to alleged deficiencies of Kuta, Butt, and Eastwood in that regard, without further explanation that restoring a lamp to “original equipment condition” would be nonobvious in light of the prior art as a whole. For the reasons noted above, that is not sufficient for Clearlamp to meet its burden in showing patentability over the prior art.

In any event, the term “original equipment condition” is not defined in the ’364 patent. Clearlamp points to the declaration testimony of Mr. Katsamberis who testifies that portions of the ’364 patent at column 4, lines 21-23 describing that “refurbished lamp having optical characteristics which are very similar to those of the original equipment lamp assembly” constitute restoring the lamp to its original equipment condition. *See* Mot. to Amend 3; *see also* PO Resp. 13-14 (citing Ex. 2007 ¶ 27).

The record is replete with prior art describing restoration of vehicle lamps so as to improve their condition. In that regard, Kuta describes that the goal of its refurbishing process is to restore lenses “to like-new condition.” Ex. 1002 ¶ 23. LKQ also makes reference to prior art of record describing that the object of restoring vehicle parts, including lamps, is “duplicating just how the factory did it when new,” to return the part: “to its original state,” and “to a state where the transparency, optical quality, and appearance are close to if not equal to, a new article.” Opp. Mot. to Amend 8 (citing exhibits 1026 and 1022).

We have considered Clearlamp’s position that the above-noted step of claim 25” directed to restoring the lamp to its “original equipment condition” renders the claim distinct from the prior art. However, in light of the teachings in the prior art concerning the understanding in the art as to the objectives of restoring vehicle parts, including lamps, we are not persuaded that Clearlamp is correct. The record sufficiently reflects that a skilled artisan would have recognized that a vehicle lamp may be returned to a state that is “like-new,” or like its “original state,” such that it may be considered in “original equipment condition.”

3. *Substitute Claim 37”*

Substitute claim 37” is reproduced below:

A method for refurbishing a lamp surface of a lamp having surface damage, the method comprising the steps of: (a) removing the lamp from the motor vehicle; (b) removing damage from the lamp surface of the lamp; (c) fully removing an original clear coat finish from the lamp surface of the lamp; (d) evening the lamp surface by smoothing out the lamp surface to minimize any troughs created through the removal of the damage; (e) grinding swirls and scratches out of the lamp

surface; (f) buffing the lamp surface; (g) cleaning the lamp surface; (h) statically neutralizing debris on the lamp surface to facilitate the removal of all of the debris on the lamp surface after the steps (b) through (d); (i) spraying a replacement clear coating material over the lamp surface; and (j) curing the replacement clear coat material; wherein, the steps (b) through (j) are performed to restore the lamp to its original equipment condition.

Mot. to Amend 12-13.

Claim 37'' adds to claim 13 features similar to those noted above in conjunction with claim 25''. For the same reasons as those given above, we are not persuaded that those features distinguish claim 37'' over the prior art.

Claim 37'' also adds a feature that "statically neutralizing debris on the lamp surface" occurs "after" other steps in the process, including the step of evening the lamp surface. Although Clearlamp generally contends that the added feature patentably distinguishes claim 37'' (Mot. to Amend 5), Clearlamp does not provide an adequate explanation in support of that contention. As discussed above, there is no dispute that Kuta discloses a step of statically neutralizing debris on a lamp surface to remove debris from that surface. Although Kuta does not make explicit that the step may occur after acts of sanding or smoothing have occurred, i.e., evening, Clearlamp does not explain why a person of ordinary skill in the art would not have inferred reasonably that such time is an available option to engage in statically neutralizing debris on a lamp surface.

Furthermore, LKQ directs our attention to other art of record, namely U.S. Patent No. 7,163, 446 "Cole", that is characterized as demonstrating that it is "well-known in the art to statically neutralize 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." Opp. Mot. to Amend 12 (citing Ex. 1008,

col. 3, ll. 13-17, 54-61; and col. 6, ll. 49-46). The referenced portions of Cole describe acts of removing debris after sanding steps have been completed. Clearlamp provides no explanation why, in light of the teachings of Cole, a skilled artisan would have failed to recognize that statically neutralizing debris to a lamp surface to remove all the debris may occur after a step of evening the lamp surface.

4. Substitute Claims 26-36 and 38-48

With respect to substitute claims 36-36 and 38-48, Clearlamp states only the following:

Claims 26-36 are proposed substitutes of claims 2-12, but which depend from claim 25. In the event that claim 1 is found not patentable, but one of the alternate versions of claim 25 is found patentable, then claims 26-36 would maintain corresponding coverage to claims 2-12.

Claims 38-48 are proposed substitutes of claims 14-24, but which depend from claim 37. In the event that claim 13 is found not patentable, but one of the alternate versions of claim 37 is found patentable, then claims 38-48 would maintain corresponding coverage to claims 14-24.

Mot. to Amend 5, 7.

Clearlamp's general statements that substitute claims 26-36 and 38-48 "maintain corresponding coverage" of claims 2-12 and 14-24, respectively, are insufficient to meet Clearlamp's burden of showing patentability of the dependent claims.

5. *Conclusion – Motion to Amend Claims*

We have considered the Motion to Amend Claims, the Opposition, and the Reply. For the foregoing reasons, Clearlamp’s Motion to Amend Claims is *denied*.

E. LKQ’s Motion to Exclude

LKQ filed a Motion to Exclude Evidence (Paper 58) (“Mot. to Excl.”) seeking to exclude the following: (1) portions of Exhibit 2004; (2) the entirety of Exhibit 2009; (3) the entirety of Exhibits 2012-2014; (4) portions of Exhibits 2016 and 2021⁸; and (5) the entirety of Exhibit 2017. We have considered LKQ’s motion. Upon review, we observe that in connection with each of the Exhibits, or portions thereof, that LKQ seeks to exclude, the underlying issue for which the Exhibit was advanced was decided in LKQ’s favor. That is, to the extent that we considered and/or relied upon any of the pertinent Exhibits, the admissibility or inadmissibility thereof, does not impact our decision.

Accordingly, we find it unnecessary to consider objections to the admissibility of any of Exhibits 2004, 2009, 2012-2014, 2016, 2017, or 2021. We *dismiss* LKQ’s Motion to Exclude Evidence as moot.

⁸ Exhibit 2016 is a partial transcript of the deposition of Robert Sandau filed July 1, 2013. Exhibit 2021 is a full transcript of the transcript that was filed July 23, 2013. Although Exhibit 2016 in its “Introduction” section does not make reference to Exhibit 2021 (*see* Mot. to Excl. 1), it is apparent from the content of the Motion that LKQ also seeks to exclude Exhibit 2021 (*see id.* at 10 n.2.)

F. Clearlamp's Motions to Seal

Clearlamp filed a Motion for Entry of Protective Order and to Seal (Paper 34) and a Motion for Entry to Seal (Paper 41). The Motions are unopposed and are *granted*.

Title 37 C.F.R. § 42.56 is reproduced below:

§ 42.56 Expungement of confidential information

After denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.

Further guidance with respect to expungement of confidential information is set forth in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012):

6. Expungement of Confidential Information: Confidential information that is subject to a protective order ordinarily would become public 45 days after denial of a petition to institute a trial or 45 days after final judgment in a trial. There is an expectation that information will be made public where the existence of the information is referred to in a decision to grant or deny a request to institute a review or is identified in a final written decision following a trial. A party seeking to maintain the confidentiality of information, however, may file a motion to expunge the information from the record prior to the information becoming public. § 42.56. The rule balances the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history for public notice purposes. The rule encourages parties to redact sensitive information, where possible, rather than seeking to seal entire documents.

Thus, should Clearlamp seek to maintain the confidentiality of the material that is the subject of its Motions to Seal, Clearlamp should file a motion to expunge the information from the record before 45 days from the entry of judgment.

III. CONCLUSION

We have considered the record before us in this *inter partes* review proceeding. We conclude that LKQ has shown by a preponderance of the evidence that claims 1-10, 13 and 14 are unpatentable. LKQ has not shown that claims 11, 12, and 15-24 are unpatentable.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IV. ORDERS

In consideration of the foregoing, it is:

ORDERED that claims 1-10, 13, and 14 of the '364 patent have been shown to be unpatentable;

FURTHER ORDERED that claims 11, 12, and 15-24 have not been shown to be unpatentable;

FURTHER ORDERED that Clearlamp's Motion to Amend Claims is *denied*;

FURTHER ORDERED that LKQ's Motion to Exclude Evidence is *dismissed* as moot; and

FURTHER ORDERED that Clearlamp's Motion to Seal and Entry of Protective Order (Paper 34) and Motion to Seal (Paper 41) are *granted*.

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Patent 7,297,364

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