

**IN THE UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

CLEARLAMP, LLC,)	
)	
Plaintiff,)	
)	Case No. 12 C 2533
v.)	
)	Judge Joan H. Lefkow
LKQ CORPORATION,)	
)	
Defendant.)	

OPINION AND ORDER

Clearlamp, LLC (Clearlamp) filed suit against LKQ Corporation (LKQ) alleging patent infringement under 35 U.S.C. § 271. (Dkts. 1, 19, 82.) Clearlamp answered and counterclaimed seeking declaratory judgments of non-infringement and invalidity. (Dkts. 26, 81.) The parties then participated in *inter partes* review before the Patent Trial and Appeal Board (PTAB) at the U.S. Patent and Trademark Office (U.S. PTO). (See Dkt. 39.) On May 1, 2015, the parties exchanged their Local Patent Rule 3.1 final infringement, invalidity, and unenforceability contentions, which Clearlamp sought leave to amend on June 19, 2015. (Dkt. 98.) The court denied that motion. (Dkt. 114.) Thereafter the parties submitted claim construction briefs and, on December 8, 2015, this court construed the disputed terms. (Dkt. 188.) Prior to that ruling, the parties submitted cross-motions for summary judgment on invalidity, Clearlamp also moved for summary judgment on its infringement claim, and LKQ moved for partial summary judgment of non-infringement. (Dkts. 123, 127.) For the reasons stated below, LKQ’s motion for summary judgment on invalidity is granted; LKQ’s motion for summary judgment of non-infringement is denied as moot; and Clearlamp’s motions for summary judgment are denied.

BACKGROUND¹

LKQ is a Delaware corporation that refurbishes and sells vehicle headlamps. (Dkt. 133-1, Clearlamp’s Local Rule 56.1 Statement of Facts (Clearlamp’s LR 56.1) ¶¶ 2, 4–5.) Clearlamp is a Missouri LLC and owner of U.S. Patent No. 7,297,364 (the ’364 Patent).² (Dkt. 125-1, LKQ’s Local Rule 56.1 Statement of Facts (LKQ’s LR 56.1) ¶¶ 1, 5.) The ’364 Patent, which is titled “Method For Refurbishing Lamp Surfaces,” was filed on December 19, 2005, and issued on November 20, 2007. (*Id.* ¶ 5.) The parties dispute whether the ’364 Patent is valid and, if so, whether LKQ’s process infringes the ’364 Patent.

I. The ’364 Patent

The ’364 Patent provides a process for salvaging damaged motor vehicle headlamps. ’364 Patent, 1:14–18. The part is not only expensive but can be damaged from ordinary use. *Id.* Not all headlamp damage requires scrapping the part, rather some can be salvaged. *See id.* at 1:16–18. The ’364 Patent sought to improve on the method disclosed in U.S. Patent Application No. US 10/804,435 (Kuta), which claims a refurbishing method in which the headlamp remains in the motor vehicle by introducing the step of removing the headlight prior to refurbishing. *See id.* at 1:25–56; *see also id.* at 1:60–62 (noting that the ’364 Patent provides “[a] method for refurbishing a surface of a lamp having surface damage [that] includes the steps of removing the

¹ Unless otherwise noted, the facts in this section are taken from the parties’ Local Rule 56.1 statements and are construed in the light most favorable to the non-moving party in each motion for summary judgment. The court will address many but not all of the factual allegations in the parties’ submissions, as the court is “not bound to discuss in detail every single factual allegation put forth at the summary judgment stage.” *Omnicare, Inc. v. UnitedHealth Grp., Inc.*, 629 F.3d 697, 704 (7th Cir. 2011) (citation omitted). In accordance with its regular practice, the court has considered the parties’ objections to the statements of fact and includes in this background only those portions of the statements and responses that are appropriately supported and relevant to the resolution of this motion. Any facts that are not controverted as required by Local Rule 56.1 are deemed admitted.

² Clearlamp acquired the ’364 Patent by assignment. (Dkt. 161-1, Clearlamp’s Response to LKQ’s Local Rule 56.1 Statement of Facts (Clearlamp’s Resp. to LKQ’s LR 56.1) ¶ 5).

lamp from the motor vehicle”). The refurbishing process generally consists of the steps of sanding and buffing the exterior surface of the headlight prior to applying and curing a clear coat. *Id.* at 1:60–67; *see also id.* at 4:33–6:37.

II. *Inter Partes* Review

The scope of this litigation has been reduced by *inter partes* review, which found claims 1–10 and 13–14 unpatentable as obvious in light of three pieces of prior art: (1) Kuta; (2) U.S. Patent No. 6,106,648 (Butt), and a series of chats from an Internet-based automotive forum (dkt. 154, LKQ’s Local Rule 56.1 Statement of Additional Facts (LKQ’s Add. LR 56.1), Ex. H (Eastwood)). *LKQ Corp. v. Clearlamp, LLC*, No. IPR2013-00020 (P.T.A.B. Mar. 27, 2014), slip. op. at 25. Relevant here, the PTAB found that Kuta rendered obvious all of the limitations in claims 13 and 14, other than claim 13’s “removing the lamp from the motor vehicle” limitation, which was rendered obvious by either Butt or Eastwood.³ *Id.* at 5–25. Therefore, Kuta in view of Butt or Eastwood rendered all of claims 13 and 14 unpatentable. *Id.* at 25.

³ At oral argument, Clearlamp insisted that the PTAB found claim 13 unpatentable only by combining Kuta, Butt, and Eastwood. As discussed below, this is not of central importance since this court cannot merely adopt the PTAB’s findings. The PTAB decision, however, is quite clear that claim 13 is rendered unpatentable by Kuta in view of either Butt or Eastwood. *LKQ Corp.*, No. IPR2013-00020, slip op. at 12 (“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.”); *see also id.* at 25 (“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.”).

Clearlamp makes a similar argument in its reply brief: that the combination of Kuta, Butt, and Eastwood is not disclosed in LKQ’s final invalidity contentions and, therefore, LKQ has violated the local patent rules, which require, in relevant part, “(1) identification, with particularity, of each item of prior art that allegedly anticipates each asserted claim or renders it obvious . . . ; (2) a statement of whether each item of prior art allegedly anticipates each asserted claim or renders it obvious. If a combination of items of prior art allegedly makes a claim obvious, each such combination, and the reasons to combine such items must be identified; (3) a chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found,” N.D. Ill. LPR 2.3(b), 3.2. While potentially an improper new argument, it appears that Clearlamp is offering its interpretation of an argument previously raised by LKQ. This argument, however, does not hold much weight, as LKQ is only arguing, as its final invalidity contention charts disclose, that the new prior art when viewed in combination of Kuta and either Butt or Eastwood renders the asserted claims invalid.

III. Claims At Issue

The parties raise claims 15, 16, 17, and 24 of the '364 Patent in their cross-motions , which are reproduced below along with the claims upon which they depend (i.e., claims 13 and 14):

13. A method for refurbishing a lamp surface of a lamp having surface damage, the method comprising the steps of:
removing the lamp from the 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 coat material over the lamp surface; and
curing the replacement clear coat material.

14. A method as set forth in claim **13** wherein the step of cleaning the lamp surface includes the step of applying a solvent to the lamp surface to remove the debris from the lamp surface.

15. A method as set forth in claim **14** wherein the step of curing the replacement clear coat material includes the step of applying infrared radiation to the lamp surface.

16. A method as set forth in claim **15** wherein the step of applying infrared radiation includes the step of heating the lamp in an oven.

17. A method as set forth in claim **16** wherein the step of removing the original clear coat finish includes the step of grinding the original clear coat finish with course [sic] grit sandpaper.

...

24. A method as set forth in claim **16** wherein the step of curing the replacement clear coat material includes the step of applying ultraviolet radiation to the lamp surface after the step of heating the lamp in an oven.

'364 Patent at 5:19–6:37.

LEGAL STANDARD

Summary judgment obviates the need for a trial where there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A genuine issue of material fact exists if “the evidence is such that a reasonable jury could return a verdict for the nonmoving party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986). To determine whether any genuine fact issue exists, the court must pierce the pleadings and assess the proof as presented in depositions,

answers to interrogatories, admissions, and affidavits that are part of the record. Fed. R. Civ. P. 56(c). In doing so, the court must view the facts in the light most favorable to the non-moving party and draw all reasonable inferences in that party's favor. *Scott v. Harris*, 550 U.S. 372, 378 127 S. Ct. 1769, 167 L. Ed. 2d 686 (2007). When considering cross-motions for summary judgment, the court must be careful to draw reasonable inferences in the correct direction. *See, e.g., Int'l Bhd. of Elec. Workers, Local 176 v. Balmoral Racing Club, Inc.*, 293 F.3d 402, 404 (7th Cir. 2002). The court may not weigh conflicting evidence or make credibility determinations. *Omnicare*, 629 F.3d at 704.

The party seeking summary judgment bears the initial burden of proving there is no genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). In response, the non-moving party cannot rest on bare pleadings alone but must designate specific material facts showing that there is a genuine issue for trial. *Id.* at 324; *Insolia v. Philip Morris Inc.*, 216 F.3d 596, 598 (7th Cir. 2000). If a claim or defense is factually unsupported, it should be disposed of on summary judgment. *Celotex*, 477 U.S. at 323–24.

ANALYSIS

The parties have cross-moved on invalidity and infringement. LKQ suggested at oral argument that this court need not reach the parties' motions with respect to invalidity if it finds that LKQ has not infringed the asserted claims. The same is true of the opposite — if asserted claims are invalid, then this court need not reach the issue of infringement. *See Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1580 (Fed Cir. 1983) (“The claim being invalid there is nothing to be infringed.”); *see also Commil USA, LLC v. Cisco Sys., Inc.*, 575 U.S. ---, 135 S. Ct. 1920, 1929, 191 L. Ed. 2d 883 (2015) (“To say that an invalid patent cannot be infringed, or that

someone cannot be induced to infringe an invalid patent, is in one sense a simple truth, both as a matter of logic and semantics.” (citing *M. Swift & Sons, Inc. v. W.H. Coe Mfg. Co.*, 102 F.2d 391, 396 (1st Cir. 1939)). Since the court finds the asserted claims invalid, it takes the latter approach and does not reach infringement. Likewise, while the parties discuss a number of grounds for invalidity, the asserted claims are invalid if any of the grounds renders them so. When UVHC3000 is viewed in light of Kuta viewed in light of either Butt or Eastwood the asserted claims are rendered invalid. It is this invalidity argument, which both parties raised in their cross-motions for summary judgment, that is discussed below.

I. Invalidity

A patent is presumed valid, *see* 35 U.S.C. § 282, and an accused infringer must establish by clear and convincing evidence that the claims at issue are invalid. *See Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1370 (Fed. Cir. 2002). Here the parties have cross-moved on the issue of invalidity,⁴ Clearlamp argues that it is entitled to summary judgment that claims 15, 16, and 24 of the '364 Patent are not rendered invalid by UVHC3000 when viewed in light of the prior art before the PTAB and LKQ argues that it is entitled to summary judgment that claims 15, 16, 17, and 24 of the '364 Patent are rendered invalid by the same prior art combination. Each largely makes the same arguments in support of its motion as it does in opposition to the other's motion. As such, keeping in mind each party's respective burden on summary judgment, the court will assess the parties' invalidity contentions in a single analysis.

⁴ In its memorandum in opposition to Clearlamp's motion for summary judgment, LKQ argues that Clearlamp's motion with respect to invalidity "should be denied out of hand for failure to follow the Court's order." (Dkt. 153 at 24.) LKQ argues that, because the burden of showing invalidity falls on the accused infringer, this court ordered Clearlamp not to move for summary judgment on LKQ's invalidity counterclaim. (*Id.* at 23.) LKQ is incorrect and its citation to the May 15, 2014 hearing transcript itself so demonstrates. In that hearing, the court ordered Clearlamp, because of the presumption of validity, not to move for a finding of *validity*, but stated that Clearlamp could move for summary judgment of non-invalidity. (Dkt. 68 at 8:15–9:19.)

A. Section 103(a) Obviousness

Under 35 U.S.C. § 103(a),⁵ a patent is invalid “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a); *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068 (Fed. Cir. 2012). Indeed, an invention must represent enough of a qualitative advance over earlier technology to justify the granting of a patent. *See Graham v. John Deere Co.*, 383 U.S. 1, 9, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966).

“Obviousness is a question of law based on underlying factual findings: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the art; and (4) objective considerations of nonobviousness.” *In re Capsule Patent Litig.*, 676 F.3d at 1068 (citing *Graham*, 383 U.S. at 17–18). Thus, if there are no genuine issues of material fact as to these three issues, determination of invalidity is for the court to decide.

A party seeking to invalidate a patent as obvious must demonstrate, by clear and convincing evidence, “that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.” *Id.* at 1068–69 (quoting *Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009)). District courts must consider the underlying factual findings first before deciding whether to invalidate a patent

⁵ The Leahy-Smith America Invents Act (AIA) amended § 103, however, the amendments made to § 103 apply only to registrations filed eighteen months after the AIA’s September 16, 2011 effective date. Because the ’364 Patent was filed before the amendments to § 103, the pre-AIA version applies.

in order to avoid the tendency to depart into “the tempting, but forbidden zone of hindsight.” *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873 (Fed. Cir. 1985), *overruled on other grounds by Nobelpharma.*

1. Scope and Content of Prior Art

As discussed above, the obviousness challenge addressed by the court is in combining the prior art that LKQ used before the PTAB (Kuta, Butt, and Eastwood) with UHVC3000. LKQ’s arguments for invalidity are substantially identical to those that it put forth in its final invalidity contentions, which are based upon contrasting a plain reading of the prior art with the ’364 Patent. (*See* dkt. 153 at 6–8.) As Clearlamp reiterated during oral argument, its opposition to LKQ’s invalidity arguments are not substantive but, rather, procedural in nature. First, Clearlamp argues that LKQ inappropriately relies on the PTAB’s findings and therefore should not be permitted to rely on Kuta, Butt, or Eastwood. Second, Clearlamp maintains that § 315(e)(2) estops LKQ from relying upon UHVC3000. Since, as discussed below, Clearlamp’s procedural arguments are resolved in LKQ’s favor, LKQ’s substantive arguments remain un rebutted.

a. Kuta, Butt, Eastwood

i. Impact Of The PTAB’s Decision

Clearlamp argues that LKQ tries to shortcut the obviousness analysis by essentially using the PTAB decision “as akin to a piece of 35 U.S.C. § 102 prior art” and, even if that were the case, the different claim construction and burden of proof standards on *inter partes* and district court review undermine the persuasive value of the PTAB decision. (Dkt. 133 at 22–24.) In framing LKQ’s argument in this manner, Clearlamp overstates its breadth. There is no doubt that LKQ would like this court to merely adopt the PTAB’s findings. (*See, e.g.*, dkt. 125 at 19.)

Over the course of its briefing, however, LKQ appears to have abandoned any argument that this court is required to do so, instead insisting that this court can find the PTAB's decision persuasive (*see* dkt. 169 at 8 n.7) and shifting focus to the prior art itself (*see id.* at 7–8). This does not appear to be a new argument, rather it is one that is consistent with LKQ's final invalidity contentions, which collectively refer to the PTAB decision and the prior art considered by the PTAB as "PTAB Analysis/Art." (LKQ's LR 56.1, Ex. UU at 6–7.) These final invalidity contentions make clear that LKQ believes that Kuta, Butt, and Eastwood, themselves, render claims 13 and 14 invalid. (*See id.* at A-22–26 (disclosing how Kuta in view of Butt renders claims 13 and 14 obvious); *see also id.* at A-27–31 (disclosing how Kuta in view of Eastwood renders claims 13 and 14 obvious).) In fact, a modified version of LKQ's final invalidity contentions providing similar information appears in its response brief. (*See* dkt. 153 at 6–8.) Therefore, Kuta, Butt, and Eastwood are properly before this court.⁶

Additionally, the PTAB's *inter partes* review decision can be used as persuasive evidence before this court.⁷ In certain contexts, the Federal Circuit has even stated that district

⁶ As explained in more detail below, since Kuta, Butt, and Eastwood were used by LKQ during *inter partes* review to attempt to invalidate the asserted claims, § 315(e)(2) estoppel prevents their use during this civil litigation if not properly combined with other pieces of prior art that were not reasonably available during *inter partes* review. *See Star Envirotech, Inc. v. Redline Detection, LLC*, No. SACV 12-01861 JGB (DFMx), 2015 WL 4744394, at *3 (C.D. Cal. Jan. 29, 2015).

⁷ *See Ultratec, Inc. v. Sorenson Comms., Inc.*, No. 14-cv-66-jdp, 2015 WL 5330284, at *14 (W.D. Wis. Sept. 11, 2015) ("This court is not bound by the PTAB decision, but its reasoning is persuasive."); *DSS Tech. Mgmt., Inc. v. Apple, Inc.*, No. 14-cv-05330-HSG, 2015 WL 1967878, at *4 (N.D. Cal. May 1, 2015) ("And even if the PTAB does not invalidate some or all of the claims, the PTAB's claim construction and invalidity analyses 'would likely prove helpful to this Court,' whether or not the standard applied is identical to the one this Court must apply in the litigation." (quoting *Black Hills Media, LLC v. Pioneer Electronics (USA) Inc.*, No. CV 14-00471 SJO (PJWx), 2014 WL 4638170, at *6 (C.D. Cal. May 8, 2014)); *Black Hills*, 2014 WL 4638170, at *6 ("The Court may also derive benefit from the PTAB's claim construction for the patents under review. While the PTAB interprets claim terms using the 'broadest reasonable construction,' 37 C.F.R. § 42.100(b), its analysis would likely prove helpful to this Court, no matter its final determination."); *CANVS Corp. v. United States*, 118 Fed. Cl.

courts must consider the U.S. PTO's decision. *See, e.g., Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556 (Fed Cir. 1985) (“The Examiner’s decision, on an original or reissue application, is never binding on a court. It is, however, evidence the court must consider in determining whether the party asserting invalidity has met its statutory burden by clear and convincing evidence.”) Such reasoning has found its way into certain district court opinions discussing whether to issue stays pending *inter partes* review; however, courts have done so only when discussing the impact of the PTAB upholding claims—as a PTAB decision that a petitioner was not able to render a claim unpatentable by a preponderance of the evidence is a strong indication that an alleged infringer cannot demonstrate that the patent is invalid by clear and convincing evidence. *See, e.g., Evolutionary Intelligence, LLC v. Facebook, Inc.*, Nos. C 13-4202 SI, C 13-4204 SI, 2014 WL 261837, at *2 (N.D. Cal. Jan. 23, 2014) (“[S]implification of the issues could still occur in the event the PTO affirms the claims because the PTO’s upholding of the claims ‘is strong evidence that the court must consider in assessing whether the party asserting invalidity has met its burden of clear and convincing evidence.’” (quoting *Internet Patents Corp. v. eBags, Inc.*, No. C 12-03385 SBA, 2013 WL 4609533, at *3 (N.D. Cal. Aug. 28, 2013))).

The PTAB’s decision is persuasive because it affords this court an opportunity to consider the PTAB’s expert reasoning based on the evidence presented to it. *See TAS Energy, Inc. v. San Diego Gas & Elec. Co.*, No. 12cv2777-GPC(BGS), 2014 WL 794215, at *4 (S.D. Cal. Feb. 26, 2014) (noting in consideration of stay, that waiting for outcome on *inter partes* review could facilitate trial by providing the court with the expert opinion of the U.S. PTO). Even upon the same evidence, however, *inter partes* review does not replace district court

587, 593 (2014) (“[E]ven if [certain claims] were to survive PTAB review, the PTAB’s final decision sustaining these claims would contain analysis that would be helpful to the court.”).

proceedings for claims that the PTAB does not find to be unpatentable. While § 315(e)(2) estoppel does limit the evidence that may be presented to a district court, it does not preclude petitioners from raising grounds during a district court proceeding that could not have reasonably been raised during *inter partes* review.

The different standards of review, the different evidence presented, and the different arguments made, raise the possibility of inconsistent unpatentability and invalidity decisions, but this type of inconsistency is permitted by the patent laws. *Cf. In re Swanson*, 540 F.3d 1368, 1378 (Fed. Cir. 2008) (noting “that a final court decision of a claim’s validity will not preclude a finding of a substantial new question of validity based on the same art because of the different standard of proof employed by” district courts and the U.S. PTO (internal quotation marks and citations omitted)); *see also id.* at 1377 (“[A] prior holding of validity is not necessarily inconsistent with a subsequent holding of invalidity.” (quoting *Stevenson v. Sears Roebuck & Co.*, 713 F.2d 705, 710 (Fed. Cir. 1983))). Since “[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” 35 U.S.C. § 112(d); 35 U.S.C. § 112 ¶ 4 (pre-AIA), the limitations of unpatentable independent claims survive *inter partes* review if they are incorporated by reference into a patentable dependent claim. Therefore, the possibility for this same inconsistency exists when the PTAB finds certain independent claims unpatentable, but finds other dependent claims not to be unpatentable.

This allows for a situation in which a district court could find that a limitation of an unpatentable independent claim is nonobvious, thereby rendering the entirety of the dependent claim nonobvious. *See Callaway Gold Co. v. Acushnet Co.*, 576 F.3d 1331, 1344 (Fed. Cir. 2009) (“A broader independent claim cannot be nonobvious where a dependent claim stemming from that independent claim is invalid for obviousness.” (citing *Ormco Corp. v. Align Tech.*,

Inc., 498 F.3d 1307, 1319 (Fed. Cir. 2007))). It is this paradoxical situation that Clearlamp persists exists here. The facts, however, do not support Clearlamp’s contention. This is not a decision that this court reaches by merely adopting the PTAB’s decision but, as explained below, is one that this court reaches only after considering the prior art that is before it on summary judgment.⁸ While there is certainly some overlap between the PTAB’s and this court’s review, given the different standards employed in *inter partes* and district court review, some repeated effort seems inevitable.⁹ Based upon that review, an explanation of Kuta’s, Butt’s, and Eastwood’s content follows.

ii. Kuta’s, Butt’s, and Eastwood’s Content

Kuta provides a method for refinishing exterior automotive lenses with damaged exterior surfaces while the lens remains in the motor vehicle—“*in situ*.” Kuta at 2–3. Kuta’s method claims sanding the lenses with a fine sanding disc (to remove the original clear coat), an ultra-

⁸ LKQ’s generalized arguments that 37 C.F.R. § 42.73(d)(3) and the doctrine of collateral estoppel preclude Clearlamp from arguing that LKQ must meet its burden as to each limitation of the asserted claims during this district court proceeding are undeveloped and unpersuasive. The scope of 37 C.F.R. § 42.73(d)(3) is limited to proceedings before the PTAB, *see* 37 C.F.R. § 42.1(a), and the case that LKQ cites in support of its collateral estoppel argument concerned similar claims of different patents being litigated in two different *district courts*, *see Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342–43 (Fed. Cir. 2013).

⁹ In a pair of dissenting opinions, albeit in a slightly different context, Judge Newman has recently recognized that unless *inter partes* review resolves all claims there will be some duplication in district courts. *See Synopsys, Inc. v. Mentor Graphics Corp.*, Nos. 2014-1516, 2014-1530, 2016 WL 520236, at *13 (Fed. Cir. Feb. 10, 2016) (Newman, J., dissenting) (“[T]he present practice of partial decision by the PTAB leads to duplicative proceedings in the PTAB and the district courts. Since the AIA provides for a different standard of proof than in the district courts, this system of partial decision does not achieve the reliability and expedition for which the AIA was enacted, but instead can produce prolonged uncertainty and multiplied proceedings, at increased rather than reduced cost. In the case at bar, validity of all of the challenged claims was not decided by the PTAB, illustrating this concern.”); *see also VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1327 (Fed. Cir. 2014) (Newman, J., dissenting) (“With the stay now imposed by my colleagues, [the plaintiff] will undergo an *inter partes* trial in the PTAB on some, but not all, of the invalidity issues that the defendants raised in the district court. Whichever side loses in the PTO then has the right first to request reconsideration by the PTAB, and then the right of judicial review of the PTO decision. Unless all of [the plaintiff’s] patent claims are finally eliminated in the PTO and that ruling sustained on appeal, the procedure could be repeated in the district court.”).

fine sanding disc (to render the exterior surface clear), and an ultra-ultra fine sanding pad (to manual reach the limited access corners of the lens), while flushing the surface with water to prevent melting. *Id.* The exterior surface is then polished with a buffing compound until a high gloss is achieved and lastly, the exterior surface is coated with transparent ultraviolet hardenable coating and cured. *Id.*

Butt provides a “method for partially or completely rebuilding a damaged lens of a vehicle lamp,” which can include removing the lens from the vehicle for rebuilding. Butt at 1:10–11, 2:57–67. According to Butt, “it is generally more convenient to remove the lamp or lighting unit from the vehicle and to remove the damaged lens from the housing to which it is connected” before rebuilding the damaged lens. *Id.* at 2:57–67.

Eastwood is a series of messages from an Internet forum discussing the buffing and resealing of motor vehicle headlamps. *See generally* Eastwood. While various sanding and buffing methods are discussed, LKQ relies upon Eastwood for its disclosure that prior to buffing, the headlights can be removed from the car. Eastwood at 6.

b. UVHC3000

i. Section 315(e)(2) Estoppel

Clearlamp argues that § 315(e)(2) estops LKQ from raising UVHC3000 in this civil action. Section 315(e)(2) provides:

The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 *that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that post-grant review.*

(emphasis added). Section 315(e)(2) estoppel is fairly new and the Federal Circuit has yet to

define its scope. District courts addressing § 315(e)(2) have done so almost exclusively when considering to stay proceedings pending *inter partes* review and provide little insight as to its breadth.¹⁰ LKQ identifies one case that discusses how a product may be combined during civil litigation with prior art that was available during *inter partes* review, although the case does not address the parties' threshold disagreement as to how § 315(e)(2)'s use of the word "reasonably" should be interpreted. (See dkt. 153 at 10–11 (citing *Star Envirotech*, 2015 WL 4744394, at *3–4).)

Given the lack of precedent, both parties turn to legislative history. In doing so, the parties dispute whether § 315(e)(2) is more or less robust than pre-AIA estoppel. This disagreement, however, does not address the question of what "reasonably" means, which did not appear in the old statute but does in the new one. Compare 35 U.S.C. § 315(c) (pre-AIA), with 35 U.S.C. § 315(e)(2). The Senate floor debate appears most relevant and, of that discussion, Senator Kyl's floor statement is most on point:

The present bill also softens the could-have-raised estoppel that is applied by *inter partes* review against subsequent civil litigation by adding the modifier "reasonably." It is possible that courts would have read this limitation into current law's estoppel. Current law, however, is also amenable to the interpretation that litigants are estopped from raising any issue that it would have been physically possible to raise in the *inter partes* reexamination, even if only a scorched-earth search around the world would have uncovered the prior art in question. *Adding the modifier "reasonably" ensures that could-have-raised estoppel extends only to that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.*

157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (emphasis added). Both

¹⁰ Clearlamp cites a number of these cases, which do not set forth much more than the statutory language itself. (See dkt. 133 at 27–28 (citing *Universal Elecs. v. Universal Remote Control*, 943 F. Supp. 2d 1028, 1032 (C.D. Cal. 2013), *Wildcat Licensing WI, LLC v. Johnson Control, Inc.*, No. 13-CV-328-WMC, 2014 WL 232106, at *3 (W.D. Wis. Jan. 22, 2014), and *Evolutionary Intelligence, LLC v. Millennial Media, Inc.*, No. 5-13-CV-04206-EJD, 2014 WL 2735801, at*4 (N.D. Cal. June 11, 2014)).)

parties cite to Senator Kyl's statement (*see* dkt. 133 at 27; dkt. 153 at 10), and appear to tailor their arguments to this standard (*see* dkt. 153 at 25; dkt. 161 at 19; dkt. 186 at 12–14). The court also finds § 315(e)(2)'s legislative history instructive and therefore applies it here,¹¹ an *inter partes* review petitioner is estopped from relying on any ground that could have been raised based on prior art that could have been found by a skilled searcher's diligent search.

One question raised by the parties' discussion of § 315(e)(2) is the extent to which prior art that *was not* reasonably available during *inter partes* review can be used if it is cumulative of prior art that *was* reasonably available during *inter partes* review. *Star Envirotech* touches on this point, but only minimally. There the court allowed a product (which are never available during *inter partes* review) to be used during district court proceedings after determining that the product was a superior and separate reference to the product's manual (which was available during *inter partes* review). *Star Envirotech*, 2015 WL 4744394, at *4. When the product was disassembled it disclosed features claimed in the patent that were not disclosed in the manual. *Id.* Since *Star Envirotech* found that the product was not cumulative of other prior art, the court did not reach the issue of when cumulative prior art would not be allowed in district court proceedings.

Clearlamp argues that unavailable prior art that is cumulative of available prior art is estopped by § 315(e)(2) from being used during subsequent district court proceedings. LKQ responds that Clearlamp's argument takes § 315(e)(2) estoppel too far, as it frames Clearlamp's argument as "seek[ing] to extend estoppel to any ground a petitioner reasonably could have

¹¹ The PTAB too has found the legislative history compelling. *See Apotex Inc. v. Wyeth LLC*, No. IPR2015-00873, 2015 WL 5523393, at *4 (P.T.A.B. Sept. 16, 2015) ("What a petitioner 'could have raised' was broadly described in the legislative history of the America Invents Act ('AIA') to include 'prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.'" (citations omitted)).

raised and any ground based on the same underlying theory as grounds the petitioner reasonably could have raised.” (Dkt. 153 at 37.) LKQ has the better reading of § 315(e)(2), which refers to “any ground”—meaning specific pieces of prior art—that reasonably could have been raised, and not, as Clearlamp contends, any “subject matter” that reasonably could have been raised (dkt. 133 at 34).

It is true that grounds can be cumulative or redundant of one another, but that does not mean that § 315(e)(2) estops those redundant grounds from being offered in civil litigation if they were not available during *inter partes* review. The PTAB’s interpretation, albeit inferentially, of § 315(e)(1) estoppel in *Apotex* supports this conclusion. In relevant part, § 315(e)(1) estops a petitioner from asserting that a claim is unpatentable during *inter partes* review on any ground that the petitioner raised or reasonably could have raised during a prior *inter partes* review relating to that claim. This is the same standard present in § 315(e)(2). Compare 35 U.S.C. § 315(e)(1), with *id.* § 315(e)(2). In *Apotex*, the PTAB addressed whether a petitioner was estopped from raising a ground raised in a previous petition for *inter partes* review where the PTAB found the ground redundant of the ground on which trial was instituted. *Apotex*, 2015 WL 5523393, at *4–5. The PTAB reasoned that the petitioner was not estopped from raising the ground in its new petition because it was not available during the previous petition where the PTAB had declined to institute trial on the redundant ground. *Id.* This reasoning is compelling. In *Apotex*, the ground, despite being redundant of a ground asserted, was permitted to be raised in the subsequent *inter partes* review because it could not reasonably have been raised during the previous *inter partes* review. *Id.* at *5. The relevant inquiry, therefore, is not whether the ground is redundant of a ground that was asserted but, rather, whether the ground reasonably could have been raised. Merely being redundant to a ground that

could have been asserted during *inter partes* review does not estop the alleged infringer from relying upon a ground based upon prior art that was not reasonably available during *inter partes* review.

With this standard in mind, the court can apply it to UVHC3000. Clearlamp contends that § 315(e)(2) estoppel applies because LKQ was aware of UVHC3000 before the filing of its *inter partes* review petition because the product is disclosed in LKQ's '971 Patent. Clearlamp is only partially correct. Clearlamp is correct to the extent that it is arguing that LKQ is estopped from using the '971 Patent as prior art. The '971 Patent is not prior art—it was filed after the effective date of the '364 Patent—and, even if it were, it was a ground that reasonably could have been raised during *inter partes* review. Clearlamp is incorrect to the extent that it is arguing that LKQ is estopped from using the product UVHC3000 as prior art because, unlike in district court litigation, products cannot be offered as prior art during *inter partes* review. *See* 35 U.S.C. § 311. While LKQ seeks to cloak its reliance upon UVHC3000 as a product, so as to avoid § 315(e)(2) estoppel, such an argument is disingenuous as it is the UVHC3000 datasheet upon which LKQ relies to invalidate the asserted claims. (*See, e.g.*, dkt. 125 at 26.)

In support of its argument that it can use the datasheet, LKQ cites to *Star Envirotech*. (*See* dkt. 153 at 10–11.) *Star Envirotech*, however, is not directly on point. As discussed above, there the court permitted a product that was a superior and separate reference to be used during district court litigation even though the product's manual had been available during *inter partes* review. *Star Envirotech*, 2015 WL 4744394, at *3–4. Here LKQ seeks to combine the product's datasheet, and not the product itself, with the prior art used during *inter partes* review to invalidate the asserted claims. Since the datasheet is a publication, it is of the type of prior art that could have been used during *inter partes* review.

In accordance with the § 315(e)(2) standard, the datasheet can be used in civil litigation only if it could not have been found by a skilled searcher performing a diligent search. LKQ argues that the document was not and could not have been found through such a search and, in fact, the datasheet, which was publicly available on UHVC3000's manufacturer's website in 2001, only made its way into LKQ's hands via a third-party subpoena. (LKQ's LR 56.1 ¶ 35.) In arguing that it performed an adequate search, LKQ, at least initially, takes on an unnecessary burden. It is the proponent of an estoppel argument that bears the burden. *See Kennedy v. United States*, 965 F.2d 413, 417 (7th Cir. 1992) ("The burden of proof is on the party claiming estoppel." (citation omitted)). This means that Clearlamp must present evidence that a skilled searcher's diligent search would have found the UVHC3000 datasheet. One way to show what a skilled search would have found would be (1) to identify the search string and search source that would identify the allegedly unavailable prior art and (2) present evidence, likely expert testimony, why such a criterion would be part of a skilled searcher's diligent search. Clearlamp, in fact, has performed step one with respect to two other pieces of prior art that LKQ argues invalidates the asserted claims.¹² It has not, however, done so with respect to UVHC3000.¹³ As such, Clearlamp is left arguing that a skilled searcher's diligent search would have found cumulative pieces of prior art and, therefore, LKQ should be estopped from using prior art that

¹² Clearlamp argues that a reasonable search would have found Frazier because it would have included patents cross-referenced to the same class/subclass as the '364 Patent, *compare* U.S. Patent No. 6,431,735 B2 (Frazier) (within subclass 427/164), *with* Kuta (within subclass 427/164), and that Maag would have been found through specified changes to LKQ's proximity searches) (Clearlamp's Resp. to LKQ's Add. LR 56.1 ¶ 14).

¹³ Clearlamp argues that the datasheet is inadmissible hearsay. (Clearlamp's Resp. to LKQ's LR 56.1 ¶ 35.) In doing so, Clearlamp misconstrues what the datasheet is being offered for, as it is not being offered to prove the truth of the matter asserted, i.e., that UVHC3000 worked in the manner that the datasheet discloses, rather it is being offered to show the effect that it would have had on a skilled artisan, thereby rendering the '364 Patent obvious. This is a non-hearsay purpose akin to offering an out-of-court statement to show its effect on a listener.

was not reasonably available during *inter partes* review if prior art that was reasonably available allowed for the same argument for invalidity. As discussed above, merely being cumulative of other prior art does not invoke § 315(e)(2) estoppel. But even if it did, Clearlamp’s underlying factual arguments are wanting because they all go to the existence of the product and do not address the information disclosed in the datasheet.

For example, Clearlamp argues that a date-restricted Google search for “UVHC3000” returns a number of search results, including the 2004 “List of Acceptable Plastics for Optical Lenses and Reflectors Used on Motor Vehicles” that LKQ attaches to its motion. (*See* dkt. 161 at 19; *see also* Clearlamp’s Add. LR 56.1, Ex. ZZ.) This list, however, only discloses the existence of the UVHC3000 product and it does not contain the curing information that is disclosed in the datasheet. (*See* LKQ’s LR 56.1, Ex. L.) Therefore, even if § 315(e)(2) estops cumulative pieces of prior art, it would not have that effect here where the datasheet discloses non-cumulative information.

ii. UVHC3000’s Content

Since the UVHC3000 datasheet is properly before the court, it is necessary to identify its contents. The datasheet describes UVHC3000 as “a clear, solvent-based, UV radiation cured coating which provides protection to parts made out of polycarbonate against abrasion, chemical damage, degradation caused by ultraviolet radiation and weathering.” (LKQ’s LR 56.1, Ex. J at 1.) The datasheet also notes that UVHC3000 complies with “the ECE Automotive Regulations for European forward lighting applications, and is in the AMECA list of Acceptable Plastics for Optical Lenses and Reflections Used on Motor Vehicles.” *Id.* Further, and relevant to LKQ’s invalidity arguments, the datasheet states that after UVHC3000 is applied “the solvents are allowed to flash-off at room temperature for 1–2 minutes followed by 2–6 minutes at high

temperature flash off at 63–85°C using either infra-red heaters or indirect fired convection ovens.” (LKQ’s LR 56.1 ¶ 37 (quoting Ex. J at 3).) The datasheet also discloses that “UVHC3000 will cure to an abrasion resistant weatherable hardcoat upon exposure to UV light.” (LKQ’s LR 56.1, Ex. J at 3.)

2. Differences Between The Claims And The Prior Art

As noted above, Clearlamp makes no substantive non-invalidity arguments, including pointing out any differences between the asserted claims and the prior art. Some differences, however, are apparent.

Each of the asserted claims includes the limitation that the headlight be removed from the motor vehicle prior to refurbishing. Kuta does not disclose this limitation. Both Butt and Eastwood discuss the possibility of removing the headlight from the motor vehicle prior to either the repair process discussed in Butt or the general buffing and refurbishment process discussed in Eastwood, but neither discusses any of the other limitations in the asserted claims at length. Other than the application, flashing, and hardening process, UVHC3000 does not address any of the other limitations in the asserted claims.

3. The Level of Ordinary Skill In The Art

This court previously identified the level of ordinary skill in the art in its final claim construction analysis:

[A] person of ordinary skill in the art of motor vehicle lamp refurbishing would have one to two years’ experience designing automobile headlamps or manufacturing or refurbishing headlamps. A college degree would be helpful but it is not required. The person of ordinary skill would have knowledge not only about removing the lamps from the vehicle and preparing the lamps for coating and curing (as co-inventor Maurice Paperi did), but also about the coating and curing aspects of the ’364 Patent (as Krause-Heringer did).

(Dkt. 188 at 4.) As discussed below, the manner in which this court previously defined the skilled artisan makes certain of LKQ’s proposed prior art combinations inevitable.

4. Objective Considerations Of Nonobviousness

Objective considerations of nonobviousness include evidence that focuses on the impact of the claimed invention on the marketplace rather than its technical merits—such as the need for the invention or the success of the invention. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538–39 (Fed.Cir.1983). Clearlamp offers no argument as to the objective considerations of nonobviousness.

5. Application

As indicated above, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. 398, 418, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007). Rather, a party seeking to invalidate a patent as obvious must demonstrate, by clear and convincing evidence “that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.” *In re Capsule Patent Litig.*, 676 F.3d at 1068–69 (quoting *Procter & Gamble*, 566 F.3d at 994). Whether a skilled artisan would have been motivated to combine the teachings of prior art and whether a skilled artisan would have had a reasonable expectation of success from doing so are both questions of fact. *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164–66 (Fed. Cir. 2006). That does not mean, however, that these questions cannot be resolved on summary judgment when there is no genuine issue of material fact—as ultimately the question of obviousness is a legal determination. “When, as here, the content of the prior art, the scope of the patent claim, and the level of ordinary skill in

the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate.” *KSR Intern. Co.*, 550 U.S. at 427.¹⁴ The evidence points to the conclusion that a skilled artisan would have been motivated to combine UVHC3000 with Kuta and Butt or Eastwood and would have had a reasonable expectation of success from doing so.

The court’s definition of the level of ordinary skill in the art, essentially forecloses any possibility that one skilled in the art would not combine the teachings of Kuta with Butt or Eastwood because this court’s previous determination recognized that one skilled in the art would have knowledge of removing the lamps from the vehicle. (*See* dkt. 188 at 4 (noting that a skilled artisan would have knowledge of removing the lamps from the vehicle and coating and curing the lamps).) Further, Kuta notes that its method has limitations in terms of reaching the corners of the lamp, *see* Kuta at 2 ¶ 23, and a skilled artisan would have been motivated to follow the teachings of Eastwood, which, while recognizing that there are benefits to keeping the lamp in the car, provides that removing the lamp from the car addresses the limitations identified by Kuta (*see* Eastwood at 6 (“If I were making a business out of this, I would look at

¹⁴ In expressing its disagreement with the Federal Circuit and reinstating the district court’s grant of summary judgment on obviousness grounds, the Supreme Court also noted the following:

A separate ground the Court of Appeals gave for reversing the order for summary judgment was the existence of a dispute over an issue of material fact. We disagree with the Court of Appeals on this point as well. To the extent the court understood the *Graham* approach to exclude the possibility of summary judgment when an expert provides a conclusory affidavit addressing the question of obviousness, it misunderstood the role expert testimony plays in the analysis. In considering summary judgment on that question the district court can and should take into account expert testimony, which may resolve or keep open certain questions of fact. That is not the end of the issue, however. The ultimate judgment of obviousness is a legal determination. *Graham*, 383 U.S. at 17.

Id. at 426.

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.”)). Additionally, in discussing one of the risks of not removing the lamps, Eastwood identifies further risks of leaving the lamp in the car, including some that the ’364 Patent itself was addressing. (*Compare* Eastwood at 6 (“I took the headlights out of my Mustang to do them, because I didn’t want to risk any damage to the car.”), *with* ’364 Patent (“And finally, this method of [sic] undesirable because it refurbishes the headlamp surface while the headlamp is still mounted in the motor vehicle. In particular, mistakes made by the operator of the method may accidentally grind the motor vehicle should the operator miscalculate forces being applied to the headlamp surface.”).) The same is true of Kuta and Butt. While Kuta and Butt discuss different types of repairs to headlamps, given the overlap in the subject matter, a person of ordinary skill in the art would have been motivated by Butt to add the additional step of removing the lamp from the vehicle prior to engaging in a Kuta-like repair because the technique had been used on the same device in a similar way. As the Supreme Court has said in a slightly different context, “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR Intern. Co.*, 550 U.S. at 417.

LKQ also argues that a skilled artisan would have been motivated to combine the UVHC3000 datasheet’s teachings with those of Kuta and Butt or Eastwood. UVHC3000, as its datasheet makes clear, was known during the prior art timeframe and was listed in the Automotive Manufacturers Equipment Compliance Agency, Inc.’s (AMECA) list of Acceptable

Plastics for Optical Lenses and Reflectors Used on Motor Vehicles.¹⁵ (See LKQ’s LR 56.1 ¶ 36.) Since this court previously found that one skilled in the art would have knowledge of coating and curing the lamp, one skilled in the art would have had the motivation to use a clear coat according to its manufacturer’s instructions. Further, Kuta called for the use of a UV hardenable clear coat and UVHC3000 is such a clear coat that multiple sources noted was for use on automotive lenses, therefore, a skilled artisan would have been motivated to combine the teachings of the datasheet in conjunction with those of Kuta and Butt or Eastwood.

Given that the skilled artisan would have been motivated to combine the prior art, the question remains as to whether a skilled artisan would have had a reasonable expectation of success from doing so. Here that does not appear to be a close question. A skilled artisan—who would have knowledge of removing the lamp as well as coating and curing the lamp (dkt. 188 at 4)—would have viewed each piece of prior art as a rather limited cumulative improvement upon the previous prior art. While Kuta does not disclose that the lamp should be removed from the vehicle prior to refurbishing, a skilled artisan would have already had that knowledge and therefore would have understood that the process would likely be successful outside of the vehicle. Likewise, since the skilled artisan would have had knowledge of the coating and curing process, a skilled artisan too would have thought that she could achieve a reasonable likelihood of success by curing the clear coat according to the manufacturer’s instructions.

Since the skilled artisan would have been motivated to combine the prior art and had a

¹⁵ LKQ cites undisputed testimony regarding the significance of UVHC3000’s inclusion in the AMECAs list. (See LKQ’s LR 56.1 ¶ 36; *see also id.*, Ex. K at 29:22–30:12 (“A. The AMECA list is basically a governmental . . . agency that maintains a list of acceptable plastics and things for use on motor vehicles. Generally, it’s related to items that are safety-related, for things such as forward lighting, tail lamps, side marker lights, and so forth. Q. And what does it mean for UVHC3000 to be on that list? A. AMECA maintains a list of acceptable plastics designed for use on motor vehicles in the United States. They also certify coatings that are acceptable for use on those plastics. Q. So, including it on that list would mean that UVHC3000 is an acceptable coating? A. That’s correct.”).)

reasonable expectation of success from doing so, the asserted claims are obvious if each of their limitations are disclosed in the prior art. Combining the prior art does just that. First, the limitations contained in the unpatentable independent claims of which the asserted claims depend (claims 13 and 14) are revealed by Kuta, Butt, and Eastwood. As discussed above, both Butt and Eastwood render the “removing the lamp from the motor vehicle” limitation in claim 13 obvious. Kuta, in turn renders each of the remaining limitations in claims 13 and 14 obvious. This is the same determination that the PTAB made under its claim construction (broadest reasonable construction) and burden of proof (preponderance of the evidence) standards, but this court has little difficulty determining that the result is the same under this court’s more stringent claim construction (ordinary and customary meaning) and burden of proof (clear and convincing evidence) standards.¹⁶ Construing the ’364 Patent’s terms according to their ordinary and customary meaning demonstrates that the limitations in claims 13 and 14 are obvious in light of Kuta, Butt, and Eastwood.

More specifically, the bulk of claim 13’s limitations are disclosed within ¶ 23 of Kuta’s detailed description, as detailed in the below table:

Specified Claim 13 Limitations	Kuta ¶ 23	Comparison
removing an original clear coat finish from the lamp surface of the lamp evening the lamp surface grinding swirls and scratches out of the	First, a fine sanding disc 20 , of the type shown in FIG. 4 , of approximately 320 grit, is placed into contact with one of the lenses and moved continuously, over the exterior surface 12 while applying as oscillating motion to the disc 20 and while flushing the exterior surface 12 from melting due to friction heat building from the sanding. As the exterior surface 12 , primarily factory installed hard coating materials, of the lens 10 is removed it exposes a non-abraded surface below, which now becomes the	Kuta teaches removing the original (or factory installed) clear coat from the lamp surface, including evening the lamp surface (after all, Kuta teaches manually sanding the corners of the lamp surface to achieve the same effect

¹⁶ In fact the PTAB noted that the case for obviousness of claims 13 and 14 is strong. (*See* PTAB Decision at 26 (“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 the those claims was well known in the art of vehicle lamp refurbishment, as evidenced by Kuta, Butt, and Eastwood.”).)

Specified Claim 13 Limitations	Kuta ¶ 23	Comparison
<p>lamp surface</p> <p>cleaning the lamp surface</p> <p>statically neutralizing debris on the lamp surface to facilitate the removal of all of the debris on the lamp surface</p>	<p>exterior surface 12. The sanding process is stopped when the flushing water 30 turns clear. This same motion is repeated using an ultra-fine, 600 grit sanding disc 20 and, again, with the water flush, and stopping the sanding 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.</p>	<p>that the motorized sanding achieves to the rest of the lamp surface). Further Kuta teaches cleaning the lamp surface through the flushing of water, which also has the effect of statically neutralizing debris.</p>
<p>buffing the lamp surface</p>	<p>When the lens 10 is satisfactory and quite clear, it is buffed using a buffing compound until a high gloss is achieved.</p>	<p>Kuta teaches the buffing limitation, through its direction to buff the lens.</p>
<p>spraying a replacement clear coat material over the lamp surface</p> <p>curing the replacement clear coat material</p>	<p>Finally, the exterior surface 12 is coated with a transparent ultraviolet hardenable coating material, which is then hardened by exposure to an ultraviolet light source.</p>	<p>Kuta teaches the curing limitation (as set forth in claim 13 but not the additional curing limitation found in the asserted claims) by teaching to harden the clear coat by exposing it to a UV light source. While Kuta does not directly disclose spraying the replacement clear coat, both Eastwood and UVHC3000 disclose that that spraying clear coat was previously known in the prior art period.¹⁷</p>

Clearlamp’s own interpretation of how LKQ’s process infringes the ’364 Patent conforms with this analysis. (See *dk. 133* at 13–20 (construing the ’364 Patent).) See *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (“Because the claims of a

¹⁷ See Eastwood at 6 (“I know some guys spray clear over the lenses too.”). (LKQ’s LR 56.1, Ex. J at 3 (“For spray or flow coating application, it is recommended to reduce the solids content down to 25–35%.”).) Therefore, even if spraying the clear coat could not be inferred from Kuta itself, since Eastwood and the UVHC3000 datasheet disclose spraying the clear coat, the asserted claims are invalidated without needing to combine both Butt and Eastwood as suggested by Clearlamp.

patent measure the invention at issue, the claims must be interpreted and given the same meaning for purposes of both validity and infringement analyses. A patent may not, like a nose of wax, be twisted one way to avoid anticipation and another to find infringement.” (internal quotation marks and citations omitted)).

Likewise, Kuta discloses the added limitation in claim 14. (*Compare* ’364 Patent at 5:33–36 (“A method as set forth in claim **13** wherein the step of cleaning the lamp surface includes the step of applying a solvent to the lamp surface to remove the debris from the lamp surface.”), *with* Kuta at 2 ¶ 23 (noting that the step of sanding the lamp surface is accompanied by flushing with water).)

The same is true for the limitation in claim 17 that “the step of removing the original clear coat finish includes the step of grinding the original clear coat finish with [coarse] sandpaper.” (’364 Patent at 6:4–7). The court’s claim construction determined the meaning of the term is sufficiently clear without further definition. (Dkt. 188 at 8–9.) The ’364 Patent’s preferred embodiment of this step makes clear that Kuta’s detailed description of the invention discloses the same limitation. (*Compare* ’364 Patent at 2:63–65 (“In the preferred embodiment, the range of grit for the step of grinding the original clear coat finish is in the range of 320 and 240 grit.”), *with* Kuta at 2 ¶ 23 (“First, a fine sanding disc **20**, of the type shown in **FIG. 4**, of approximately 320 grit, is placed into contact with one of the lenses and moved continuously As the exterior surface **12**, primarily factory installed hard coating materials of the lens is removed it exposes a non-abraded surface below, which now becomes the exterior surface **12**.”).) *See Globetrotter Software, Inc. v. Elan Computer Grp., Inc.*, 362 F.3d 1367, 1381 (Fed. Cir. 2004) (“A claim interpretation that excludes a preferred embodiment for the scope of the claim ‘is rarely, if ever, correct.’” (quoting *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1583

(Fed. Cir. 1996)).¹⁸ That Kuta discloses the limitations of claims 13 and 14, absent removing the lamp from the vehicle, is almost inevitable from the '364 Patent itself, which provides that it is addressing problems caused by Kuta's method that result from the fact that the lamp remains in the body. (See '364 Patent at 1:25–56.)

Kuta does not, however, disclose the additional limitation in claims 15, 16, and 24, which provide:

15. A method as set forth in claim **14** wherein the step of curing the replacement clear coat material includes the step of applying infrared radiation to the lamp surface.

16. A method as set forth in claim **15** wherein the step of applying infrared radiation includes the step of heating the lamp in an oven.

24. A method as set forth in claim **16** wherein the step of curing the replacement clear coat material includes the step of applying ultraviolet radiation to the lamp surface after the step of heating the lamp in an oven.

The only process of hardening the replacement clear coat that is set forth in Kuta is through exposure to ultraviolet light. Kuta at 3 (“coating the exterior surface with a transparent ultraviolet hardenable coating material, and hardening the coating material by exposure to an ultraviolet light source”). In the court’s final claim construction it adopted the following constructions of the disputed terms in the claims 15, 16, and 24:

- “curing the replacement clear coat material” constructed as “converting the replacement clear coat from a liquid to a hard coat of original equipment-type quality;”
- “applying infrared radiation [to the lamp surface]” constructed as “applying energy from the infrared spectrum to the lamp surface;” and
- “applying ultraviolet radiation to the lamp surface” constructed as “applying energy from the ultraviolet spectrum to the lamp surface.”

(Dkt. 188 at 1.) With these constructions in mind, claims 15, 16, and 24 take the following form:

- Claim 15: A method as set forth in claim **14** wherein the step of *converting the replacement clear coat from a liquid to a hard coat of original equipment-type quality*

¹⁸ Other than this limitation, claim 17 entirely depends on claim 16. As discussed below, the limitations in claim 16 are obvious in light of the prior art.

- includes the step of *applying energy from the infrared spectrum to the lamp surface*.
- Claim 16: A method as set forth in claim **15** wherein the step of *applying energy from the infrared spectrum to the lamp surface* includes the step of heating the lamp in an oven.
 - Claim 24: A method as set forth in claim **16** wherein the step of *converting the replacement clear coat from a liquid to a hard coat of original equipment-type quality* includes the step of *applying energy from the ultraviolet spectrum to the lamp surface* after the step of heating the lamp in an oven.

In construing the terms in the asserted claims in this manner, the court accepted Clearlamp's proposed constructions, which defined the curing process to include not merely the step of hardening the clear coat but all steps that are required to convert the clear coat to a hard coat of original equipment-type quality. This means that the use of the word curing in the asserted claims can be read to include both the flashing off and hardening process, as both processes are part of the transition from a liquid to a hard coat of original equipment-type quality. While LKQ contests, in its response brief, that even under Clearlamp's proposed construction there are questions of fact as to whether its process infringes, it does recognize, in its opening brief, the interrelatedness of the invalidity and the infringement analysis:

Clearlamp asserts that curing also involves the application of infrared radiation. Clearlamp's theory suffers a fatal flaw. If processing UVHC3000 according to the manufacturer's recommendations—which is what LKQ does—satisfies the asserted claims, it also invalidates them because UVHC3000 was commercially available, and carried the same processing instructions, at least four years **before** the filing of the '364 Patent.

(Dkt. 125 at 26.) In other words, the only manner in which LKQ's process can be read to infringe on the asserted claims is if LKQ's use of a convection oven to flash off the clear coat prior to being hardened via UV light is within the definition of curing. *See Amazon.com, Inc.*, 239 F.3d at 1351. Since the UVHC3000 datasheet reveals such a limitation, it thereby invalidates the asserted claims. The datasheet provides that after the clear coat is applied, "the solvents are allowed to flash-off at room temperature for 1–2 minutes *followed by 2–6 minutes of*

high temperature flash-off at 63°–85°C using either infra-red heaters or indirect fired convection ovens. . . . The UVHC3000 will cure to an abrasion resistant weatherable hardcoat upon exposure to UV light.” (LKQ’s LR 56.1, Ex. J at 3 (emphasis added).) According to the court’s construction, the asserted claims provide for applying energy from the infrared spectrum to the lamp surface, which can be satisfied by heating the lamp in an oven, followed by exposing the clear coat to UV light. The datasheet calls for this precise process and thereby reveals the limitations of the asserted claims.

Since the asserted claims’ limitations are disclosed in the prior art and a skilled artisan would have been motivated to combine the prior art and would have had a reasonable expectation of success from doing so, the asserted claims are invalid as obvious. Accordingly, LKQ’s motion for summary judgment for invalidity of claims 15, 16, 17, and 24 is granted and Clearlamp’s motion for summary judgment for non-invalidity of claims 15, 16, and 24 is denied.

CONCLUSION AND ORDER

For the foregoing reasons, LKQ’s motion for summary judgment (dkt. 123) is granted in part and denied in part and Clearlamp’s motion for summary judgment (dkt. 127) is denied. The clerk is instructed to enter summary judgment in favor of LKQ on its claim of invalidity. All other issues are moot. This case is terminated.

Date: March 18, 2016



U.S. District Judge Joan H. Lefkow