

It's Not All that Bleak for Patent Owners at the PTAB (Patent Trial and Appeal Board)

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LKQ Corp. v. Clearlamp, LLC; MicroStrategy, Inc. v. Zillow, Inc.; Kyocera Corp. v. Softview LLC

In addition to the many IPRs and CBM reported in this issue, the Patent Trial and Appeal Board (PTAB) has now issued several decisions where the merits determination was at least partially adverse to the petitioner.

LKQ Corp. v. Clearlamp, LLC

In this *inter partes* review (IPR), the PTAB cancelled 12 out of 24 challenged claims of a Clearlamp-owned patent titled "Method for refurbishing lamp services" directed to a method for refurbishing a surface of a vehicle lamp having surface damage. The patent had been asserted by Clearlamp against LKQ in a district court action. Although the PTAB cancelled claims 1-10, 13 and 14, it concluded that LKQ had not met its burden of establishing that claims 11, 12 and 15-24 are unpatentable. *LKQ Corp. v. Clearlamp, LLC*, IPR 2013-00020, (PTAB, Mar. 27, 2014 (Cocks, APJ))

In this IPR, Clearlamp properly offered substitute claim amendments (as replacements for original claims) on a contingent basis. However, the PTAB denied all of the proposed amended claims.

Although the PTAB addressed secondary considerations of non-obviousness (copying and commercial success) offered by Clearlamp in some detail, it nevertheless concluded that the strong evidence of obviousness of the cancelled claims outweighed Clearlamp's evidence.

MicroStrategy, Inc. v. Zillow, Inc.

The PTAB issued a decision on a patent titled "Automatically determining a current value for a real estate property, such as a home, that is tailored to input from a human user, such as its owner." The patent owner Zillow sued Trulia Inc., a real estate firm that apparently uses MicroStrategy software, for infringement of the patent and MicroStrategy was the petitioner at the Board. *MicroStrategy, Inc. v. Zillow, Inc.*, PTAB, No. IPR 2013-00034, March 27, 2014 (Kim, APJ)

MicroStrategy challenged all 40 claims of the patent, but the PTAB instituted trial only on claims 2,

5-17 and 26-40. In its final decision the PTAB found that 25 of the claims on which IPR had been instituted are unpatentable for anticipation and obviousness, but that MicroStrategy did not establish that claims 12, 27, 34 and 38 are unpatentable.

Practice Note: Trulia subsequently filed a covered business method (CBM) challenge on the same patent, challenging the claims on which IPR had not been instituted, this time challenging the claims under 35 U.S.C. § 101 as not patent eligible. Section 101 is available as a challenge basis in a CBM proceeding, but not in an IPR proceeding.

Kyocera Corp. v. Softview LLC

The PTAB cancelled the 27 challenged claims of the two patents both titled “Scalable display of internet content on mobile devices.” The patents are directed to mobile devices to support resolution independent scalable display of web content to allow zooming and panning for better viewing on smaller screen sizes. Softview asserted the patents against defendants in a district court proceeding. *Kyocera Corp. v. Softview LLC*, PTAB, NO. IPR 2013-00007, March 27, 2014 (B.J. McNamara, APJ)

The board determined that all of the challenged claims were obvious over prior art cited by Kyocera.

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