

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC. ET AL.
Petitioner

v.

CUOZZO SPEED TECHNOLOGIES LLC
Patent Owner

Case IPR-2012-00001
Patent 6,778,074

Before JAMESON LEE, MICHAEL P. TIERNEY, and JOSIAH C. COCKS,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call was held on March 4, 2013, between Judges Lee, Tierney, and Cocks and respective counsel for the parties. Cuozzo initiated the conference call to confer about its intent to file a motion to amend claims under 37 C.F.R. § 42.121. Counsel for Cuozzo inquired about (1) whether Cuozzo's motion to amend should provide a general listing of all claims in its patent including claims which are not under review, (2) whether Cuozzo should file one paper inclusive of

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the patent owner's response and the motion to amend claims, (3) the form for proposing more than one substitute claim per claim under review, and (4) what actions petitioners are permitted to take in opposing a patent owner's proposed amendment.

The judges indicated (1) that a motion to amend claims should not list claims which are not involved in this review, (2) that Cuozzo should file separate papers, one which is the patent owner's response, and another which is its motion to amend claims, (3) that the motion to amend claims should make clear which is "the" substitute claim for each claim under review, and if there are proposed claims beyond those for a one-to-one substitution of original claims, then the motion has to rebut the presumption that one-for-one replacement of claims is sufficient (counsel for Cuozzo was further informed that simply saying that having additional claims increases the odds of having a surviving claim at the end of review would likely not rebut the presumption), (4) that in opposing Cuozzo's motion to amend claims, Garmin may argue unpatentability over prior art of the proposed substitute claims and submit evidence to support the argument.

It is

ORDERED that Cuozzo should note the above guidance in filing its motion to amend claims under 37 C.F.R. § 41.121(a); and

FURTHER ORDERED that Cuozzo is encouraged, for each proposed substitute claim that bears a strong resemblance to an original claim under review, to identify that original claim and make clear what are the relative changes with respect to the original claim, *e.g.*, denoting text deleted by one notation such as bracketing and text inserted by another notation such as underlining.

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For PETITIONER

Jennifer C. Bailey
Scott Brown
HOVEY WILLIAMS LLP
jcb@hoveywilliams.com
jcrawford@hoveywilliams.com

For PATENT OWNER

John R. Kasha
Kelley Kasha
Kasha Law LLC
john.kasha@kashalaw.com
Kasha Law LLC
kelley.kasha@kashalaw.com