UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC. ET AL.
Petitioner

v.

Patent of CUOZZO SPEED TECHNOLOGIES LLC
Patent Owner

Case IPR2012-00001
Patent 6,778,074

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

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I. The Proposed Substitute Claims Improperly Enlarge the Scope of the Original Claims and Introduce New Matter

Cuozzo proposes substitute claims 21–23 for original claims 10, 14, and 17.[1] The Board should reject the substitute claims because they improperly enlarge the scope of the original claims and introduce new subject matter not previously disclosed in the '074 Patent. *See* 37 C.F.R. § 42.221(a)(2)(i–ii); 35 U.S.C. §§ 132(a), 112.

A. Claims 21 and 22 Improperly Enlarge and Lack Support

The Board's construction of "integrally attached" precludes a single electronic display that operates as a speedometer and a colored display. Cuozzo attempts to circumvent the Board's construction by reciting in claim 21 that the speedometer comprises an LCD, and the colored display is *the* LCD. (Paper 32 at 4) (emphasis added.) Cuozzo subtly suggests that the subject matter of dependent claims 12 and 18 have merely been merged into prior independent claim 10. (Paper 32 at 4, 7.) But substitute claim 21, contrary to original claim 10, purports to encompass a single LCD that is itself both the speedometer and the colored display. Because such an embodiment would not have infringed the original claims as construed by the Board, Cuozzo's substitute claims improperly enlarge the scope of the original claims. *See* 37 C.F.R. § 42.221(a)(2)(i–ii); 35 U.S.C. § 132(a);

[1] It is unclear if Cuozzo has canceled original claims 10, 14, and 17 or is arguing in the alternative for the patentability of claims 21–23. (*See* Paper 31 at 2, ¶¶ 1, 3.)

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Quantum Corp. v. Rodime, PLC, 65 F.3d 1577, 1580 (Fed. Cir. 1995) (amended or new claim is enlarged if it includes any subject matter that would not have infringed original patent; claim is broader than original claims if it is broader in *any* respect, even if narrower in other respects).

Additionally, as discussed in Garmin's Reply, there is no written-description support in the '074 Patent for an electronic embodiment in which the speedometer and the colored display are merged into a single LCD display. Further, Cuozzo's own expert, Dr. Morris, contends such an embodiment is merely "*implied*" by the '074 Patent and it would be "natural" for one skilled in the art to create such a system, because there is no such actual disclosure in the patent. (Ex. 2002 at ¶¶ 28–29 (emphasis added); *see also* Ex. 1021 at 17, tr. 65:14–68:16.) This is insufficient under the law. *See Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998) ("In order for a disclosure to be inherent, . . . the missing descriptive matter must necessarily be present in the . . . specification such that one skilled in the art would recognize such a disclosure."); *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1295 (Fed. Cir. 2002). Because written-description support does not exist, the Board should reject the substitute claims.

B. Claim 23 Improperly Enlarges and Lacks Support

Substitute claim 23 also attempts to enlarge the scope of the claims and add new subject matter. The plain language of original claims 1 and 10 makes clear

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