



# THINK FORWARD

## PTAB Orders Cancellation of Claims in its First IPR Final Decision

November 18, 2013

On November 13, 2013, the Patent Trial and Appeal Board (PTAB) issued its first final written decision under the new inter partes review (IPR) proceedings in *Garmin International Inc. et. al. v. Cuozzo Speed Technologies LLC*, case number IPR2012-00001, which also happens to be the first-filed IPR. The three-judge panel sided with Petitioner Garmin, ordering cancellation of the claims under review. This decision comes less than three months after the oral hearing was conducted on August 16, 2013.

The challenged patent (U.S. Patent No. 6,778,074) relates to a speed limit indicator and method for displaying the speed of a vehicle in relation to the legal speed limit at the vehicle's current location. Cuozzo had previously filed a lawsuit in New Jersey federal court alleging that Garmin's nüvi® personal navigation device infringed Cuozzo's speedometer patent. See *Cuozzo Speed Technologies LLC v. Garmin International Inc. et. al.*, case number 2:12-cv-03623, in the U.S. District Court for the District of New Jersey.

The PTAB originally denied Garmin's IPR petition on seventeen (17) of the twenty (20) claims challenged in the petition. However, in Thursday's final written decision, the PTAB found that Garmin met its burden of proof by a preponderance of the evidence, showing that the remaining three (3) claims are unpatentable under 35 U.S.C. § 103(a).

One reason Garmin was successful in its obviousness arguments was that Cuozzo failed to meet the required evidentiary standard required by the PTAB to antedate a reference. The PTAB ruled that Cuozzo failed to provide sufficient evidence to corroborate the earliest conception and a later witnessed invention disclosure document. The PTAB also found that Cuozzo failed to provide an adequate explanation for gaps in subsequent diligence leading to the constructive reduction to practice.

The PTAB denied Cuozzo's Motion to Amend, finding that the proposed substitute claims impermissibly added new matter and enlarged the scope of the claims. With respect to the latter rationale for denying Cuozzo's Motion to Amend, the PTAB articulated its rationale that patent owners should consider in drafting potential substitute claims for an IPR. "The scope of each of claims 10, 14, and 17 has been enlarged because a structure not covered by those claims would be covered by respective substitute claims 21-23," the PTAB wrote in its decision.

With more than 500 petitions for IPR filed so far at the USPTO, IPRs have quickly become a valuable tool for defendants in patent infringement suits to pursue cost-effective defenses.

If you have any questions or wish to discuss how this decision may impact your company, please contact your attorney at [Brinks Gilson & Lione](#).