

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 IPR2012-00001 (JL)
Patent 6,778,074

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

LEE, *Administrative Patent Judge.*

ORDER
Conduct of Proceedings
37 C.F.R. § 42.5

INTRODUCTION

A joint telephone conference was held on July 16, 2013, between respective counsel for the parties and Judges Tierney, Lee, and Cocks. The matter in dispute concerns errata sheets Cuozzo has filed in connection with the cross-examination testimony of Cuozzo's inventor Mr. Giuseppe Cuozzo and expert witness Dr. James Morris. The cross examination of Mr. Giuseppe Cuozzo occurred on May 14, 2013, and of Dr. James Morris occurred on May 15, 2013. Petitioner Garmin filed on May 21, 2013, its reply to Cuozzo's Patent Owner Response, and also its opposition to Patent Owner's Motion to Amend Claims, at least one of which paper cited and referred to some cross examination testimony of the witnesses. Cuozzo then filed on June 21, 2013, its reply to Garmin's opposition to Cuozzo's Motion to Amend Claims, and also filed, without prior authorization from the Board, the errata sheets as Exhibits 1026 and 1027.

On July 10, 2013, the parties jointly requested a conference call with the Board to resolve their dispute regarding the propriety of the filing of the errata sheets without prior authorization from the Board.

DISCUSSION

The rules for an *inter partes* review do not provide for the filing of errata sheets in connection with the deposition testimony of a witness. Thus, a party intending to file an errata sheet, for whatever purpose, especially if it is to change the substantive testimony of a witness, must contact the Board and obtain prior authorization before doing so. One of the comments to the proposed rules for implementing *inter partes* review, post grant review, and covered business method

Case IPR 2012-00001
Patent 6,778,074

patent review inquired about errata sheets and what is or is not acceptable in an errata sheet, and the Office's response is that the rules do not provide for the submission of errata sheets and that a party who believes an errata sheet is necessary may request a conference call with the Board. *Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decision; Final Rule, 77 Fed. Reg. 48612, 48642 (Aug. 14, 2012)*(Response to Comments).

The Board notes that the opportunity has passed for Garmin to continue with the cross examination in light of the proposed change, and that Garmin already has filed a submission based on and citing to original and unchanged testimony.

The Board further notes that cross examination of a live witness has important value in obtaining the dynamic and contemporaneous response of the witness and does not have the characteristic of an interrogatory to be answered at home after thorough study over a long period of time. Also, particularly if the opposing party has filed a paper identifying the deficiencies in the original testimony, it would be unfair to permit a party to attempt to cure those deficiencies by changing or adding to the original testimony, thus nullifying the challenges and circumventing procedure.

Moreover, the party proffering the witness for cross examination has the opportunity to conduct redirect examination of the witness immediately following the cross examination, to cure any perceived deficiency or to make more complete an answer. In this case, it is undisputed that the errata sheets materially alter the substantive testimony of inventor Giuseppe Cuzzo and expert witness Dr. James

Morris. It is also undisputed that Garmin's filings on May 21, 2013, cited to and discussed original unchanged testimony of the witnesses. It is further undisputed that after Cuozzo's unauthorized filing of the errata sheets on June 21, 2013, Garmin did not have an opportunity to conduct further cross examination of the witnesses or to submit a revised reply to Cuozzo's Patent Owner Response or a revised opposition to Cuozzo's Motion to Amend Claims.

Cuozzo contacted the Board way too late for its request to change the cross examination testimony of its witnesses. It does not mean that had the Board been contacted shortly after the cross examination, the request to change the substantive testimony would have been granted. We take this opportunity to state that unless unopposed by the other party, a request to make a material change to the substance of cross examination testimony is unlikely to be successful no matter when the request is made. Error in transcription is a different matter.

CONCLUSION

For the foregoing reasons, it is

ORDERED that Cuozzo's filing of the errata sheets is unauthorized and Exhibits 1026 and 1027 will be expunged from the record;

FURTHER ORDERED that reliance by any party on either errata sheet or Exhibit 1026 and/or Exhibit 1027 will be as good as null and regarded as unsupported by the record; and

FURTHER ORDERED that the parties may file a joint request for filing an errata sheet, labeled as an exhibit, that corrects spelling or typographical errors,

Case IPR 2012-00001
Patent 6,778,074

which do not change the substance of the testimony, within one week of the date of this communication.

Case IPR 2012-00001
Patent 6,778,074

For PETITIONER:

Jennifer C. Bailey
HOVEY WILLIAMS LLP
jcb@hoveywilliams.com

Jason R. Mudd
ERISE IP, P.A.
Jason.Mudd@EriseIP.com

For PATENT OWNER:

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