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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OMEGA PATENTS, L.L.C.

Appeal 2022-003758
Reexamination Control 90/014,675
Patent 8,032,278 B2
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and ERIC B. CHEN,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. §§ 134 and 306 the Examiner's decision to reject claims 1–22. We have jurisdiction under 35 U.S.C. §§ 134 and 306, and we heard the appeal on October 28, 2022.

We REVERSE.

¹ Appellant identifies Omega Patents, L.L.C., as the real party in interest .
Appeal Br. 6.

STATEMENT OF THE CASE

This proceeding arose from a request for *ex parte* reexamination filed on February 10, 2021 of United States Patent 8,032,278 (“’278 patent”), issued to Kenneth E. Flick on October 4, 2011.

The ’278 patent describes a tracking unit that is compatible with multiple vehicles. To this end, the tracking unit includes a multi-vehicle compatible controller that communicates with a vehicle device using a corresponding vehicle device code from among plural codes. The unit also has a downloading interface that permits downloading enabling data related to the corresponding vehicle device code, where enabling data may be: (1) the vehicle device code; (2) an instruction to select a code from among those already stored; or (3) the data or sequence to allow the controller to generate the vehicle device code. *See* ’278 patent, Abstract, col. 23, l. 41–col. 24, l. 4.

Claim 1 is illustrative of the invention and is reproduced below:

1. A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible tracking unit comprising:
 - a vehicle position determining device;
 - a wireless communications device;
 - a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information;
 - said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle

device code from among a plurality thereof for different vehicles; and

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.

RELATED PROCEEDINGS

This appeal is said to be related to various proceedings. First, Appellant informs us of ten related reexamination proceedings involving various patents as follows:

Reexamination Control	Corresponding U.S. Patent
90/013,741	6,756,885
90/014,038	6,756,885
90/013,832	7,671,727
90/013,587	8,032,278
90/013,851	8,032,278
90/014,309	8,032,278
90/013,659	6,346,876
90/014,122	6,346,876
90/014,121	7,671,727
90/014,419	8,032,278

See Appeal Br. 8–10; Reply Br. 2–3. We rendered decisions in connection with appeals in reexamination proceedings 90/013,851, 90/014,122, and 90/014,121. *See Ex parte Omega Patents, L.L.C.*, Appeal No. 2018-008119

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(PTAB Nov. 13, 2018); *see also Ex parte Omega Patents, L.L.C.*, Appeal No. 2019-006299 (PTAB Dec. 3, 2019); *Ex parte Omega Patents, L.L.C.*, Appeal No. 2020-000387 (PTAB Jan. 28, 2020).

Appellant also informs us of related litigation involving Appellant and various parties, including the CalAmp Corporation (“CalAmp”) who, according to Appellant, is the customer of Requester, namely the Innova Electronic Corporation (“Innova”). Appeal Br. 6–8; Reply Br. 2. Appellant adds that CalAmp and Innova requested the last four reexaminations of the ’278 patent. Appeal Br. 6.

This litigation includes a case where the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”), among other things, vacated the judgment of infringement by a Florida District Court and remanded for a new trial to determine whether CalAmp directly infringed the ’278 patent’s asserted claims. *See Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1349, 1354 (Fed. Cir. 2019).

On remand, the district court conducted a second jury trial, where a jury found that CalAmp directly infringed each asserted claim of the ’278 patent. *See Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1367 (Fed. Cir. 2021). On appeal, the Federal Circuit affirmed the court’s judgment of infringement of the ’278 patent’s asserted claims. *See id.* at 1365–66, 1369–70 (concluding that the district court properly denied CalAmp’s motion judgment as a matter of law (JMOL) and a new trial in connection with infringement of the ’278 patent), 1382. The Federal Circuit, however, vacated and remanded for a new trial on damages. *See id.* at 1365–66, 1382.

Appellant also informs us of an infringement lawsuit involving Enfora, Inc. and Appellant that concluded September 3, 2019.

Lastly, Appellant informs us that the parties settled in connection with infringement litigation involving Firstech, LLC and Appellant. Appeal Br. 8.

THE REJECTION

The Examiner rejected claims 1, 4–11, and 18–22 under 35 U.S.C. §103 as unpatentable over Lowrey (US 6,611,740 B2; issued Aug. 26, 2003) and Lightner (US 6,636,790 B1; issued Oct. 21, 2003). Final Act. 27–47.²

SUBSTANTIAL NEW QUESTION OF PATENTABILITY (SNQ)

Appellant disputes the Examiner’s SNQ determination in this proceeding because (1) the present reexamination request over Lowrey is said to be “substantially identical” to the second reexamination request that relied on another prior art reference to Chou,³ and (2) Requester ostensibly relied on a defective incorporation by reference to Lightner in an attempt to provide the missing multi-compatible controller. Appeal Br. 15–17. Appellant adds that the present reexamination represents a “pattern of harassment” due to serial and duplicative reexamination requests that, according to Appellant, abuse USPTO procedures, waste USPTO resources,

² Throughout this opinion, we refer to: (1) the Final Office Action mailed Oct. 5, 2021 (“Final Act.”); (2) the Appeal Brief filed April 1, 2022 (“Appeal Br.”); (3) the Examiner’s Answer mailed April 21, 2022 (“Ans.”); and (4) the Reply Brief filed June 21, 2022 (“Reply Br.”).

³ U.S. Patent 6,330,499 B1; issued Dec. 11, 2011.

contain misleading information, and treat Appellant unfairly. *See* Appeal Br. 17–20; *see also* Reply Br. 2–3.

Appellant’s SNQ arguments, however, are untimely and are, therefore, not before us. Notably, Appellant must first request reconsideration of the SNQ before the Examiner before we can review that issue. Manual of Patent Examining Procedure (MPEP) § 2274(VI) (9th ed. rev. 10.2019 June 2020). That was not done here.

To be sure, in a response after final rejection filed December 6, 2021, Appellant included a section entitled “The Request for Reexamination Should Not Have Been Granted” on pages 14 to 16 that includes a subheading entitled “The Original Request Does Not Present An SNQ” on page 14. Although some of the arguments on pages 12 to 16 in Appellant’s response after the final rejection are similar to those raised on pages 12 to 14 of a response filed August 23, 2021 to the Examiner’s non-final office action, the arguments made *before* the Examiner’s final rejection do not squarely address the alleged impropriety of the Examiner’s SNQ determination, much less include a section entitled “The Original Request Does Not Present An SNQ” as in the response after the final rejection.

Rather, Appellant’s arguments made before the Examiner’s final rejection more generally allege that the USPTO should not have granted the reexamination request since it is ostensibly part of a long-standing pattern of “duplicative harassment” that abuses USPTO procedures, wastes USPTO resources, presents misleading information, and treats Appellant unfairly. *See* Response to Non-Final Office Action filed Aug. 23, 2021, at 12–14.

In short, the arguments made *before* the Examiner’s final rejection did not specifically request that the Examiner reconsider the SNQ determination, nor did the Appeal Brief identify the communication in which Appellant first requested reconsideration of the SNQ before the Examiner in accordance with MPEP § 2274(VI). But leaving these defects aside, Appellant’s SNQ arguments are untimely, for they were first presented *after* final rejection and, consequently, after prosecution closed. *See* MPEP § 2272 (“It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution.”).

As Section 2272 of the MPEP explains, both the Examiner and Appellant should identify and develop *all* issues *before* the final Office action, including presenting evidence. Therefore, Appellant’s arguments regarding the alleged lack of an SNQ is untimely and runs counter to MPEP procedure that, by encouraging identifying and developing *all* issues before final rejection, promotes compact prosecution. This practice is especially important where, as here, the proceeding is treated with special dispatch. *See* 35 U.S.C. § 305; *see also Ethicon, Inc. v. Quigg*, 849 F.3d 1422, 1426 (Fed. Cir. 1988) (noting that “special dispatch” envisions some type of unique, extraordinary, or accelerated movement).

The procedural mandates of MPEP § 2274(VI) underscore this point. As noted previously, MPEP § 2274(VI) requires that Appellant request reconsideration of the SNQ issue before the Examiner before we can review that issue. Although MPEP § 2274(VI) provides two non-limiting examples

of when this reconsideration can be requested, namely in a patent owner's statement or response under 37 C.F.R. §§ 1.530 and 1.111, respectively, this request must nevertheless be made not only before the Appeal Brief, but also during prosecution before the Examiner—not after prosecution closes—particularly when MPEP § 2274(VI) is interpreted in light of the limitations of after-final practice noted in MPEP § 2272. *See* MPEP § 2274(VI) (requiring that a patent owner *first* request consideration before the Examiner, and *then* seek review of the Examiner's SNQ determination before the Board); *see also id.* (requiring a patent owner identify in its Appeal Brief the communication in which the owner first requested reconsideration of the SNQ before the Examiner); MPEP § 2272 (discussing after-final practice). To the extent that Appellant contends that MPEP § 2274(VI) permits requesting reconsideration of the SNQ before the Examiner in the first instance after prosecution closes, as is the case here, such a belated request runs counter to any reasonable interpretation of (1) MPEP § 2274(VI) that requires the request to be made before appeal, and (2) MPEP § 2272 that indicates that prosecution is closed in the reexamination proceeding when the Examiner enters a final rejection.

That is not to say, however, that despite an Appellant not complying with the procedural mandates of MPEP § 2274(VI), the Board cannot review the Examiner's SNQ determination that is so facially improper that no reasonable mind could accept it such that there is no substantial evidence to support the determination. *See In re Gartside*, 203 F.3d 1305, 1312 (Fed. Cir. 2000). One such circumstance would be when it is indisputably clear from the record that a patentability question deemed as an SNQ was already

decided in the original examination, for no procedural rule can enable reexamination under those circumstances. *See In re Recreative Technologies Corp.*, 83 F.3d 1394, 1396–98 (Fed. Cir. 1996).

But that is not the case here. Although the patentability question at issue in *Recreative Technologies* involved the same prior art reference as the question decided in the original examination—not different references as is the case here—cumulative references that repeat the teachings of previously-considered prior art nonetheless preclude an SNQ, for they do not raise a patentability question different from that considered in an earlier examination. *See* MPEP §§ 2242, 2247. These situations, however, are rare as noted in the following guidance from the MPEP:

For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different. However, it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter.

MPEP § 2258.01

Therefore, because Appellant did not preserve the SNQ issue for appeal by first requesting reconsideration of the SNQ before the Examiner, that issue is not before us.

Appellant's other contentions that the present reexamination was allegedly improperly granted due to an alleged abuse of process and,

therefore, the reexamination should be terminated (*see* Appeal Br. 17–20; Reply Br. 2–3) present a petitionable—not appealable—matter that is, therefore, not before us. To the extent Appellant is asking the Board to terminate the reexamination on page 3 of the Reply Brief, we lack the power and jurisdiction to do so. Rather, such termination requests are petitionable matters for the Director—not appealable matters for the Board. *Cf. Ex parte Best Medical Int’l, Inc.*, Appeal No. 2022-002998 at 5–13 (PTAB Aug. 30, 2022) (non-precedential) (citing *In re Vivint*, 14 F.4th 1342 (Fed. Cir. 2021)); *see also Best Medical*, at 11 (noting that the Board’s independent review of the Examiner’s SNQ determination, “while pertaining to the propriety of the reexamination itself, is nonetheless limited solely to the Examiner’s SNQ determination—not other bases, factors, circumstances, or reasons why a reexamination should, or should not, have been ordered.”).

Therefore, Appellant’s other contentions that the present reexamination was allegedly improperly granted due to an alleged abuse of process and, therefore, the reexamination should be terminated (*see* Appeal Br. 17–20; Reply Br. 2–3) are a petitionable matter that is not before us.

THE OBVIOUSNESS REJECTION

The Examiner finds that Lowrey discloses every element of independent claim 1, but cites Lightner to the extent that Lowrey does not teach additional details regarding how its diagnostic data is vehicle-specific. Final Act. 27–33.

Appellant argues that Lowrey and Lightner fail to disclose every recited feature. Appeal Br. 20–32. According to Appellant, Lowrey’s

schema teachings are extremely limited and, therefore, Lowrey lacks the recited downloading interface for permitting downloading enabling data related to at least one corresponding vehicle device code for use by the recited multi-vehicle compatible controller. Appeal Br. 20–25.

Appellant also contends that Lowrey’s wireless appliance is not the recited multi-vehicle compatible controller despite the Examiner’s findings to the contrary. *See* Appeal Br. 25–27; *see also* Reply Br. 3–9. Although Appellant acknowledges that Lowrey’s wireless appliance can be transferred between vehicles, Appellant contends that the transferred wireless appliance would nevertheless be operationally incompatible with a new vehicle as was the case with the device in the Chou reference that was at issue in an earlier appeal involving the ’278 patent. Appeal Br. 27–31; *see also* Reply Br. 4–9.

Appellant also argues that the claimed invention is patentable over Lowrey and Lightner because of the submitted evidence of secondary considerations of non-obviousness, namely evidence of licensing, commercial success, copying by others, customer need, and the limited value for products without the invention. Appeal Br. 32–49; *see also* Reply Br. 9–12. Appellant emphasizes that the Examiner failed to give this evidence proper weight, for not only is there a nexus between this evidence and the claimed invention as evidenced by, among other things, a jury verdict in related litigation, the Board found this same evidence persuasive of non-obviousness in an earlier appeal involving the ’278 patent. Appeal Br. 32–49; *see also* Reply Br. 9–12.

ISSUE

Under 35 U.S.C. § 103, has the Examiner erred in rejecting claim 1 by finding that Lowrey and Lightner collectively would have taught or suggested: (1) a multi-vehicle compatible controller to be coupled to a vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and (2) a downloading interface for permitting downloading of enabling data related to at least one corresponding vehicle device code for use by said multi-vehicle compatible controller?

This issue turns on whether the Examiner gave the cited evidence of secondary considerations of non-obviousness proper weight.

ANALYSIS

As noted previously, this appeal is related to, among other things, an appeal involving the '278 patent where we held that the Examiner erred in rejecting claim 1 as (1) anticipated by Chou, and (2) obvious over Chou. *See Ex parte Omega Patents, L.L.C.*, Appeal No. 2018-008119 (PTAB Nov. 13, 2018) (“Nov. 2018 Bd. Dec’n”).

Chou, however, is no longer at issue: rather, in this appeal, the question is whether the same claim would have been obvious over Lowrey’s and Lightner’s collective teachings.

But what is common to both appeals is the evidence of secondary considerations of non-obviousness—the very evidence that we found persuasive in reversing the Examiner’s obviousness rejection in the earlier

appeal. *See* Nov. 2018 Bd. Dec’n at 14 (finding that Appellant’s evidence of secondary considerations of non-obviousness, including licensing, commercial success, copying by others, customer need, and the limited value for accused products without the invention further weighed in Appellant’s favor); *accord* Appeal Br. 34–36; Reply Br. 12 (noting this finding).

A key aspect of our finding in this regard is, as it was in a related appeal,⁴ (1) the jury’s verdict in related litigation that there was a nexus between the evidence of secondary considerations of non-obviousness and the claimed invention, and (2) the Federal Circuit’s affirming the district court’s upholding the jury’s infringement verdict. *See Omega Patents*, 13 F.4th at 1365 (affirming the judgment of infringement of the ’278 patent’s asserted claims).

Our holding in a related appeal involving similar secondary considerations evidence is instructive in this regard, albeit in connection with a different patent. *Cf.* Dec. 2019 Bd. Dec’n, at 10–18. In that appeal, we found Appellant’s evidence of secondary considerations of non-obviousness of the claimed invention, including licensing, commercial success, and copying by others, outweighed the evidence of obviousness and was dispositive of error in the Examiner’s rejections. *See id.* at 17–18.

In reaching this conclusion, we emphasized the jury’s verdict that there was a nexus for each proffered secondary consideration to the claimed invention. *See id.* at 13 (noting the jury’s finding that eight licenses were

⁴ *Cf. Ex parte Omega Patents, L.L.C.*, Appeal No. 2019-006299 (PTAB Dec. 3, 2019) (“Dec. 2019 Bd. Dec’n”) at 10–18.

key factors in the claimed invention's non-obviousness because the licenses were accepted *due to the merits of the claimed invention*), 14 (noting the jury's finding that the commercial success of products embodying the claimed invention was due to the *claimed invention's merits*—not other factors), and 16 (noting the jury's verdict that others copying the claimed invention was a key factor indicating non-obviousness of that invention).

Notably, as Appellant indicates, the jury made similar findings here. *See* Appeal Br. 38 (reproducing jury verdict form indicating the jury's finding that others accepted licenses under patents *because of the merits of the claimed invention*), 39 (reproducing jury verdict form indicating the jury's finding that accused products covered by the claim were commercially successful *due to the merits of the claimed invention* rather than due to advertising, promotion, salesmanship, or product features other than those claimed), and 42 (reproducing jury verdict form indicating the jury's finding that others copying the claimed invention indicated non-obviousness of the claimed invention).

We found this evidence, along with that pertaining to customer need and the accused products' limited value without the invention, persuasive for showing non-obviousness of claim 1 of the '278 patent—the very claim at issue here. *See* Nov. 2018 Bd. Dec'n at 14 (finding that Appellant's evidence of secondary considerations of non-obviousness, including licensing, commercial success, copying by others, customer need, and the limited value for accused products without the invention further weighed in Appellant's favor).

The Examiner’s decision, then, to give this evidence pertaining to licensing, commercial success, and copying “little weight” because the jury’s and the court’s determinations were based on evidence that is said to be not of record in the present reexamination proceeding (Ans. 16, 19, 21) is problematic. Notably, the Examiner considered our November 2018 decision involving the ’278 patent not only in the Final Rejection from which this appeal is taken, but also in granting the request for reexamination. *See* Final Act. 3–4 (discussing the November 2018 Board decision); *see also* Order Granting Request for *Ex Parte* Reexamination mailed Mar. 25, 2021, at 3–4, 15 (discussing the November 2018 Board decision).

By granting the present reexamination proceeding, the Examiner considered our November 2018 decision and, therefore, presumably considered the record evidence supporting that decision—evidence that includes the same evidence of secondary considerations of non-obviousness that we found persuasive and that is also at issue here in this proceeding. *Accord* Reply Br. 11–12 (noting this point).

This secondary considerations evidence cannot be discounted: it plays a critical role in the obviousness analysis and, indeed, weighs in Appellant’s favor in that regard. *See Leo Pharm. Products, Ltd. v. Rea*, 726 F.3d 1346, 1358 (Fed. Cir. 2013) (“Objective indicia of nonobviousness play a critical role in the obviousness analysis.”). That is, this evidence is not just a cumulative or confirmatory part of the obviousness analysis, but rather is independent evidence of non-obviousness that is the most probative evidence in that regard “in avoiding the trap of hindsight when reviewing, what otherwise seems like, a combination of known elements.” *See id.*

We reach this conclusion despite the differences between Lowrey's and Chou's explicit disclosures, namely Lowrey's ability to (1) transfer the controller easily from one vehicle to another in column 4, lines 59 to 63; (2) extract new data-collection schema from an incoming data packet; and (3) collect vehicle data according to that extracted schema in column 7, lines 33 to 36. *See* Lowrey Fig. 2 (steps 36 and 38); *see also* Ans. 12 (noting the differences between Lowrey and Chou).

Given that functionality, Lowrey's wireless appliance is "multi-vehicle compatible" at least in that sense, particularly since each vehicle can include a unique schema. *See* Lowrey col. 7, ll. 55–56. But even when combined with Lightner as the Examiner proposes, we nonetheless find Appellant's evidence of secondary considerations of non-obviousness of the claimed invention, including licensing, commercial success, copying by others, customer need, and the limited value for accused products without the invention, outweighs the evidence of obviousness on this record.

Therefore, we are persuaded that the Examiner erred in rejecting (1) independent claim 1; (2) independent claim 18 that recite commensurate limitations; and (3) dependent claims 4–11 and 19–22 for similar reasons. Because this issue is dispositive regarding our reversing the Examiner's rejection of these claims, we need not address Appellant's other associated arguments.

Appeal 2022-003758
Reexamination Control 90/014,675
Patent US 8,032,278 B2

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 4–11, 18–22	103	Lowrey, Lightner		1, 4–11, 18–22

REVERSED

CC:

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