

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB USA, INC. AND GEOTAB, INC.,
Petitioners,

v.

OMEGA PATENTS, LLC,
Patent Owner.
U.S. Patent No. 8,032,278
Filing Date: June 3, 2007
Issue Date: October 4, 2011

Case No. IPR2023-00504

**PATENT OWNER'S PRELIMINARY
RESPONSE UNDER 35 U.S.C. § 313 AND 37
C.F.R. § 42.107**

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35 U.S.C. §101	21
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35 U.S.C. §325(d)	4, 51, 57
37 C.F.R. §42.107	1
37 C.F.R. §42.108	1
37 C.F.R. §42.120	57
37 C.F.R. §42.24	59

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83 Fed. Reg. 51341 (Oct. 11, 2018)	10
MPEP §2106	21
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MPEP §2143	33, 42

EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 8,032,278 to Flick (the '278 Patent)
1002	Prosecution File History of U.S. Patent No. 8,032,278
1003	Declaration of Jeffrey Miller, Ph.D.
1004	Curriculum Vitae of Jeffrey Miller, Ph.D.
1005	Prosecution History of Ser. No. 90/013,587 (RX1)
1006	Prosecution History of Ser. No. 90/013,851 (RX2)
1007	Prosecution History of Ser. No. 90/014,309 (RX3)
1008	Prosecution History of Ser. No. 90/014,419 (RX4)
1009	Prosecution History of Ser. No. 90/014,675 (RX5)
1010	Claim Rejection, mailed May 6, 2016 in No. 90/013,587 (RX1)
1011	Decision granting ex parte reexamination request, mailed December 15, 2016 in No. 90/013,851 (RX2)
1012	Ex parte Omega Patents, LLC, No. 2018-008119 (Nov. 3, 2018)
1013	Decision granting ex parte reexamination request, mailed March 25, 2021 in No. 90/014,675 (RX5)
1014	Non-Final Rejection, mailed October 5, 2021 in No. 90/014,675 (RX5)
1015	Patent Owner's Appeal Brief, No. 90/014,675 (April 1, 2022)
1016	Transcript of oral argument in Ex parte Omega Patents, LLC, No. 2022-003758, Reexamination No. 90/014,675 (Oct. 28, 2022)
1017	<i>Ex parte Omega Patents, LLC</i> , No. 2022-003758 (Nov. 30, 2022)

1018	D.I. 50, Claim Construction Order, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 20, 2015) (“ <i>CalAmp-CC</i> ”).
1019	D.I. 34, Claim Construction Order, <i>Omega Patents, LLC v. Firstech, LLC</i> , No. 2:20-cv-01344 (W.D. Wash. Nov. 22, 2021) (“ <i>Firstech-CC</i> ”).
1020	<i>Omega Patents, LLC v. CalAmp Corp.</i> , 920 F.3d 1337 (Fed. Cir. 2019) (“ <i>CalAmp-I</i> ”)
1021	<i>Omega Patents, LLC v. CalAmp Corp.</i> , 13 F.4th 1361 (Fed. Cir. 2021) (“ <i>CalAmp-II</i> ”)
1022	D.I. 14, Omega Patents Answering Brief In Opposition to Geotab USA, Inc.’s Motion to Dismiss, <i>Omega Patents, LLC v. Geotab USA, Inc. and Geotab, Inc.</i> , No. 1:22-cv-01044-CFC (D. Del. Nov. 16, 2022)
1023	U.S. Patent No. 6,957,133 (“Hunt”)
1024	U.S. Patent No. 6,756,885 (“Flick-885”)
1025	U.S. Patent No. 6,011,460 (“Flick-460”)
1026	D.I. 040, Omega Patents Opposition to CalAmp Motion For Claim Construction, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Oct. 3, 2014)
1027	D.I. 144, Jury Verdict, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 30, 2019)
1028	D.I. 310, Jury Verdict, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 24, 2016)
1029	D.I. 143, Jury Instructions, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Nov. 24, 2016)
1030	D.I. 309, Jury Instructions, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 30, 2019)
1031	Y. Park and A. Fumiyuki, eds. <i>Enhanced Radio Access Technologies For Next Generation Mobile Communication</i> . Dordrecht: Springer, 2007.
1032	F. Delli Priscoli and M. Neri, “Integration of the ORBCOMM satellite network with the GSM Short Message Service.” <i>Space Communications</i> , Vol. 19, no. 1, pp. 47-57, 2003.
1033	D.I. 180, Transcript, Civil Jury Trial–Day 3, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 18, 2016)
1034	Pages from D.I. 181, Transcript, Civil Jury Trial–Day 4, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 19, 2016)

1035	<i>RESERVED</i>
1036	<i>RESERVED</i>
1037	<i>RESERVED</i>
1038	<i>RESERVED</i>
1039	Pages from D.I. 338, Transcript, Civil Jury Trial–Day 2, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 24, 2019)
1040	Pages from D.I. 339, Transcript, Civil Jury Trial–Day 3, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 25, 2019)
1041	<i>RESERVED</i>
1042	<i>RESERVED</i>
1043	<i>RESERVED</i>
1044	Comparison of limitations in '278 patent claims 13-22 with limitations in '278 patent claims 1-12
1045	U.S. District Court – Judicial Caseload Profile for the District of Delaware, <i>available at</i> https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0630.2022_0.pdf (last visited December 19, 2022)
1046	Title 40 Code of Federal Regulations, Part 86, Subpart S—General Compliance Provisions for Control of Air Pollution From New and In-Use Light Duty Vehicles, Light-Duty Trucks, and Complete Otto-Cycle Heavy-Duty Vehicles (July 1, 2007)
1047	SAE J1939-71 Vehicle Application Layer (rev. DEC2004)
1048	SAE J1708 Serial Data Communications Between Microcomputer Systems in Heavy-Duty Vehicle Applications (rev. AUG2004)
1049	<i>RESERVED</i>
1050	International Standard ISO 15031-4 Road Vehicles—Communication between vehicle and external equipment for emissions related diagnostics—Part 4: External test equipment (1st ed. June 15, 2005) (“ISO 15031-4:2005”)
1051	Pages from Microsoft Internet & Networking Dictionary (2003)
1052	SAE J1978 OBD-II Scan Tool – Equivalent to ISO/DIS 15031-4:

	December 14, 2001 (revised 2002-04)
1053	Pages from IEEE 100 The Authoritative Dictionary of IEEE Standard Terms (7th Ed. 2000)
1054	D.I. 265, Federal Circuit Mandate, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. July 1, 2019)
1055	D.I. 392, Order Dismissing With Prejudice, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. June 16, 2022)
1056	U.S. Patent No. 8,856,266 B2
1057	U.S. Patent Application Publication No. US 2005/0032511 A1
1058	U.S. Patent Application Publication No. US 2004/0138790 A1
1059	U.S. Patent No. 6,611,740 to Lowrey
1060	U.S. Patent No. 7,209,813
1061	<i>RESERVED</i>
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1064	U.S. Patent No. 7,617,727
1065	D.I. 145-85, PL104, 4/15/2015 Expert Report of Joseph C. McAlexander, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1066	13 Cal. Code Reg. §1968.2 Malfunction and Diagnostic System Requirements—2004 and Subsequent Model-Year Passenger Cars, Light-Duty Trucks, and Medium-Duty Vehicles and Engines (2004)
1067	February 19, 2007 Internet Archive capture of startech.com webpage on computer cables at https://web.archive.org/web/20070219050320/http://www.startech.com/Product/Category.aspx?WCID=7&WCLID=2&MLID=2&menu=1&from=more&c=US
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1069	<i>RESERVED</i>
1070	Control of Air Pollution From New Motor Vehicles and New Motor

	Vehicle Engines; Modification of Federal On-Board Diagnostic Regulations for: Light-Duty Vehicles, Light-Duty Trucks, Medium Duty Passenger Vehicles, Complete Heavy Duty Vehicles and Engines Intended for Use in Heavy Duty Vehicles Weighing 14,000 Pounds GVWR or Less; Extension of Acceptance of California OBD II Requirements, 68 Fed. Reg. 35792 (June 17, 2003)
1071	SAE J1850 Class B Data Communications Network Interface, Rev. 2001-05 (May 2001)
1072	ISO 15765-4:2005(E) Road vehicles – Diagnostics on Controller Area Networks (CAN) – Part 4: Requirements for emissions-related systems (1st ed. ISO January 15, 2005)
1073	ISO 15031-5:2006(E) Road vehicles — Communication between vehicle and external equipment for emissions-related diagnostics — Part 5: Emissions-related diagnostic services (ISO 1st ed. January 15, 2006)
1074	ISO 14230-4 Road vehicles — Diagnostic systems — Keyword Protocol 2000 —Part 4: Requirements for emission-related systems (ISO 1st ed. June 1, 2000)
1075	SAE J1979 (R) E/E Diagnostic Test Modes – Equivalent to ISO/DIS 15031-5:April 30, 2002 (April 2002)
1076	SAE J2178-1 Class B Data Communication Network Messages— Detailed Header Formats and Physical Address Assignments (reaffirmed July 2004).
1077	D.I. 10, Geotab USA, Inc.’s Opening Brief In Support Of Motion To Dismiss, <i>Omega Patents, LLC v. Geotab USA, Inc. and Geotab, Inc.</i> , No. 1:22-cv-01044 (D. Del. Nov. 2, 2022)
1078	SAE J2178-4 Class B Data Communication Network Messages— Message Definitions for Three Byte Headers (reaffirmed July 2004).
1079	Pages from Title 40 Code of Federal Regulations, Part 86, Subpart S— General Compliance Provisions for Control of Air Pollution From New and In-Use Light Duty Vehicles, Light-Duty Trucks, and Complete Otto-Cycle Heavy-Duty Vehicles (July 1, 2014)
1080	Pages from Collins English Dictionary (5th ed. 2000)
1081	Pages from Newton’s Telecom Dictionary (2005)
1082	ISO 14230-2 Road vehicles—Diagnostic systems—Keyword Protocol 2000 – Part 2: data link layer (1st ed. Mar. 15, 1999)
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1087	<i>RESERVED</i>
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1090	D.I. 145-80, PL99, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1091	D.I. 145-54, PL68, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1092	D.I. 145-53, PL67, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1093	D.I. 145-67, PL81, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1094	D.I. 145-42, PL45, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1095	D.I. 145-57, PL71, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1096	D.I. 145-68, PL82, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1097	D.I. 145-69, PL83, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1098	D.I. 145-70, PL84, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1099	D.I. 145-73, PL88, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1100	D.I. 145-74, PL90, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1101	D.I. 145-75, PL92, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1102	D.I. 145-76, PL93, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1103	D.I. 145-77, PL96, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)

1104	D.I. 145-79, PL98, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1105	D.I. 145-81, PL100, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. Feb 25, 2016)
1106	D.I. 145-83, PL102, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. Feb 25, 2016)
1107	D.I. 145-84, PL103, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. Feb 25, 2016)
1108	D.I. 145-88, PL141, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. Feb 25, 2016)
1109	D.I. 145-55, PL69, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1110	D.I. 145-71, PL85, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1111	D.I. 145-72, PL86, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1112	D.I. 145-82, PL101, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. Feb 25, 2016)
1113	D.I. 145-78, PL97, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2001	U.S. Patent No. 6,636,790 to Lightner
2002	Declaration of Mr. Joseph C. McAlexander, III
2003	Curriculum Vitae of Mr. Joseph C. McAlexander, III
2004	D.I. 297-1, Deposition of Galin Chen, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2005	D.I. 297-4, Deposition of Peter Hergesheimer, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2006	D.I. 297-5, Deposition of Stephen Hall, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2007	D.I. 39, Defendant CalAmp Corp’s Opening Claim Construction Brief, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 5, 2014)
2008	Intent to issue Reexamination Certificate, mailed on April 14, 2023 in 90/014,675 (RX5)
2009	U.S. Patent No. 5,732,074 to Spaur et al.

I. PRELIMINARY STATEMENT

Pursuant to 37 C.F.R. §42.107, Patent Owner Omega Patents, LLC (Patent Owner) submits this Preliminary Response to the above-captioned Petition for *Inter Partes* Review (Petition) of U.S. Patent No. 8,032,278 (Ex-1001, the ‘278 Patent) filed by Geotab USA, Inc. and Geotab, Inc. (Petitioners).

II. INTRODUCTION

To justify institution of *inter partes* review, the Petition must show that, as a factual and legal matter for an asserted ground, a Petitioner has a reasonable likelihood of proving at least one challenged claim unpatentable. *See, e.g.*, 37 C.F.R. §42.108(c); 35 U.S.C. §314. As detailed below, Petitioners have not met this burden as to any of the asserted grounds, and therefore no *inter partes* review should be instituted.

Petitioners argue that multiple patent licensees, multiple United States Patent and Trademark Office (USPTO) patent examiners, two different Patent Trial and Appeal Board (PTAB) panels, a jury, and a District Court are all wrong about the validity of the ‘278 Patent because of yet another cumulative reference – this time to inventors Hunt, Lowrey and Banet (U.S. Pat No. 6,957,133) (Ex-1023, *Hunt*). In the most-recent fifth ex parte reexam of the ‘278 Patent, the PTAB again found the originally filed claims patentable over a similar reference to Lowrey, Banet,

Lightner, Borrego, Myers and Williams (U.S. Pat. No. 6,611,740) (Ex-1059) either alone or in combination with a reference to Lightner, Borrego, Myers and Lowrey (U.S. Pat. No. 6,636,790) (Ex-2001). The three patents to Hunt, Lowrey and Lightner are all currently assigned to Verizon Patent and Licensing Inc., New Jersey. It's basically the same rotating group of inventors and the same technology, yet Petitioners contend this time it's somehow different.

Patent Owner notes that even if *Hunt* were somehow "new", Petitioners concede that *Hunt* still fails to anticipate or render obvious claims 2-3, 7, 9-10, 23-27, 20, and 22. The majority of these claims are directed to a wired signal downloading interface -- one of the two species of downloading interfaces recited in the challenged claims -- the other being a wireless signal downloading interface. To argue obviousness of these claims, Petitioners attempt to combine U.S. Patent No. 6,756,885 to Flick (*Flick885*), also owned by the Patent Owner, with *Hunt*. Of course, *Flick885* is described in the Background of the '278 *Patent* and was considered by the examiner in the original prosecution. Accordingly, it's not new either.

Regarding its anticipation arguments for Claims 1, 4-6, 8, 11-12, 18-19 and 21, the Petitioners wrongly rely upon boilerplate language in the specification -- unrelated to the actual invention of *Hunt* -- in an attempt to piece together the elements of the challenged claims. The relied-upon boilerplate language is at best

unrelated, and at worst contradictory to the inventors' description of their invention in the specification of *Hunt*. Accordingly, a Person of Ordinary Skill in the Art (POSA) would not read *Hunt* as argued by Petitioners. This same deficiency permeates through the obviousness challenges to these claims as Petitioners' declarant attempts to supply the missing teachings of *Hunt*.

Petitioners' attempts to use the printed matter doctrine to read recitations out of the challenged claims must fail given the claim constructions applied in the extensive prosecution before the USPTO and litigation in the courts.

Petitioner's characterization of the Patent Owner's evidence of secondary considerations of non-obviousness as "phantom" is flawed. Significant parts of this evidence of secondary considerations was elicited from an infringer's employees in litigation involving the '278 *Patent*, who described the '278 *Patent* as providing important features sought by its customers and increasing the value of their product -- technology they could not design around. D.I. 297-1, 26:11-20 (Ex-2004); D.I. 297-4, 45:3-19, 46:25-47:19 (Ex-2005); D.I. 297-5, 64:15-24, 102:16-103:13, 155:4-13 (Ex-2006). Moreover, the compelling evidence of secondary considerations was already twice considered and adopted by the PTAB in the second and fifth *ex parte* reexams. *Ex Parte Omega Patents, LLC*, Appeal 2018-008119 (Ex-1012); *Ex Parte Omega Patents, LLC*, Appeal 2022-003758 (Ex-

1017)¹.

Accordingly, Patent Owner respectfully requests that the Board deny institution under 35 U.S.C. §325(d).

III. OVERVIEW OF THE PRIOR ART

The Petitioners identified the following references – cumulative to the art already cited and considered by the Examiner – which Petitioners assert anticipates and/or renders obvious the claims of the ‘278 *Patent*.

A. U.S. Patent No. 6,957,133 to Hunt et al. (*Hunt*)

Hunt (Ex-1023) is directed to a wireless system for monitoring and analyzing a vehicle’s GPS and diagnostic data. *Hunt* 2:23-25. The system performs the monitoring and analysis functions using a wireless appliance. *Hunt* 2:25-27. The wireless appliance is based upon an integrated, silicon-based architecture. *Id.* The architecture is in the form of an application specific integrated circuit (ASIC) for communicating with multiple systems on a data communications bus. *Hunt* 2:28-31. A GPS module collects location-based data. *Hunt* 2:23-25, 5:4-5, 6:18-26. A communications circuit collects diagnostic data relating to the vehicle. *Hunt* 5:8-10. The communications circuit selects one supported communications protocol from among supported communications

¹ Patent Owners notes that the USPTO has recently issued an intent grant a reexamination certificate based upon the PTAB’s Decision on Appeal (Ex-2008).

protocols. *Hunt* 5:7-19. Supported protocols are fixed and correspond to discrete hardware integrated circuit (IC) modules. *Hunt* 5:7-16, 5:43-6:18, and 8:14-9:45.

B. U.S. Patent No. 6,756,885 To Flick (*FLICK885*)

Flick885 (Ex-1024), an earlier patent to Mr. Flick, the inventor of the ‘278 *Patent*, was cited by Patent Owner during prosecution of the ‘278 *Patent*. Ex-1002. *Flick885* is described in the Background of the Invention section of the ‘278 *Patent*. Accordingly, *Flick885* was specifically considered by the Examiner. *Id.*; *McAlexander*, ¶44 (Ex-2002).

Flick885 discloses a multi-vehicle compatible control system for a vehicle that operates on a data communications bus. *Flick885*, 5:5-15. A multi-vehicle compatible controller of the system provides a bus interface for remote operation of devices on the data communications bus. *Id.*, 5:11-34, 6:33-40. The bus interface interfaces using proper signal levels and formats on the data communications bus. *Id.*, 6:35-40; *McAlexander*, ¶45.

IV. THE ‘278 PATENT

The Background of the Invention section of the ‘278 *Patent* (Ex-1001) states that, “[m]otor vehicles, such as passenger cars, trucks, busses, fleet vehicles, etc. are widely used and knowing the locations of such vehicles is often desired. For example, should a vehicle be stolen, it would be beneficial to know the vehicle's location so that authorities could be promptly and accurately directed to retrieve

the vehicle. Indeed, the tracking system could plot the getaway path of the thief.”
‘278 Patent, 1:30-36.

The Background of the Invention also defines problems addressed by the claimed invention of the *‘278 Patent*. For example, the Background of the Invention provides that “[t]here are, of course, a number of vehicles which come from the manufacturer with some form of security system already installed. In addition, a number of vehicles are also equipped with aftermarket security systems. Many conventional vehicle tracking units may not be readily installed in vehicles, particularly those vehicles already including a vehicle security system. In addition, complexity of installation may significantly increase the system costs.” *‘278 Patent*, 1:35-42; *McAlexander*, ¶48. “Unfortunately, such advanced techniques for dealing with multiple device codes for a vehicle having a data communications bus have not yet been developed for vehicle tracking units.” *Id.* 2:38-41.

Moreover, the Background of the Invention describes the inventor’s prior developed technology relating to security and control systems that address data bus interoperability as follows:

U.S. Pat. No. 5,719,551, assigned to Omega Patents, LLC,
the assignee of the present invention, discloses a vehicle
security system for a vehicle including a data bus
connecting a plurality of vehicle devices. A signal

enabling circuit enables the alarm controller to operate using a set of desired signals selected from a plurality of possible sets for different vehicles. U.S. Pat. No. 6,011,460, assigned to Omega Patents, LLC, discloses a similar system where the set of desired signals from the plurality of different sets of signals for different vehicles is obtained, such as by connection and communication with a downloading device. Additionally, U.S. Pat. No. 6,756,885, also assigned to Omega Patents, LLC, discloses a multi-vehicle control system whereby a multi vehicle compatible controller stores a set of device codes for a given vehicle device for a plurality of different vehicles. Device codes are read from the data communications bus, and a match between a read device code and the stored device codes is determined to provide compatibility with different vehicles. *Id.* 2:19-37.

McAlexander, ¶49 ¶.

The written description and associated drawings of the ‘278 *Patent* include embodiments having a downloading interface to address the potential difficulties of interfacing to a vehicle data bus and devices connected thereto. ‘278 *Patent*,

23:41-25:4, and FIGS. 10-13. Embodiments include a remote transmitter, and a remote start controller including a receiver and at least one processor to generate a climate control command on the data communications bus of the vehicle and remote start the vehicle. *Id.* The at least one processor of the remote start controller is also configured to perform a different respective function in each different embodiment. *Id.*; *McAlexander*, ¶50.

There are two species or categories of signal downloading interfaces disclosed and claimed in the ‘278 *Patent*: (1) a wired signal downloading interface (e.g. Claim 2) that may include a connector for temporary connection to a downloading device (e.g. Claim 3); and (2) a wireless signal downloading interface (e.g. Claim 4) that may include a wireless receiver for temporary connection to a downloading device (e.g. Claim 5). ‘278 *Patent* 24:14 – 25:28; 26:16-29. *McAlexander*, ¶51.

V. LEVEL OF ORDINARY SKILL IN THE ART

Petitioners contend that a POSA “would have had a Bachelor’s degree in electrical engineering, computer engineering, computer science, automotive engineering, or a related discipline, and at least two years of experience in networking or automotive engineering.” Petition 9. Petitioners also contend that “POSAs would have understood networking electronics, been familiar with vehicle data buses, regulations and industry standards involving on-board diagnostics

(“OBD-II”), and at least one underlying network protocol used by OBD-II.”

Petition 9.

Patent Owner particularly disagrees with Petitioners’ characterization that a POSA “would have understood networking electronics, been familiar with vehicle data buses, regulations and industry standards involving on-board diagnostics (“OBD-II”), and at least one underlying network protocol used by OBD-II.” Patent Owner asserts that the level of a POSA has already been determined, and this level, which is consistent with previous characterizations of a POSA by the opposing party in litigation and also used by Patent Owner’s Expert, should be adopted by the PTAB. In particular, in litigation regarding the ‘278 *Patent*, the opposing party, *CalAmp*, defined a POSA such that:

“The relevant field of art for purposes of construing the claims of the patents-in suit is the vehicle telematics industry. A person of ordinary skill in the art in that field would have at least an undergraduate degree in electrical engineering, automotive engineering, or an equivalent engineering discipline, and several years’ experience in designing, manufacturing, installing and/or working on vehicle telematics systems. Alternatively, additional years of practical experience may replace the engineering

degree, or completion of post-graduate engineering studies may reduce the years of practical experience necessary.” D.I. 39, p. 9; ¶116 (Ex-2007).

For the purpose of this Patent Owner’s Preliminary Response, Patent Owner will apply the Petitioners’ heightened level of skill. *McAlexander*, ¶27. Should the Board institute trial, Patent Owner reserves the right to provide its own definition for a POSA and support for that definition in its §42.120 Response, including expert testimony regarding the appropriate definition along with that Response.

VI. CLAIM CONSTRUCTION

Under *Phillips*, patent claims should be interpreted in light of the intrinsic evidence, including the specification and file history, and “the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1317 (Fed. Cir. 2005); *see also* 83 Fed. Reg. 51341 (Oct. 11, 2018) (adopting *Phillips* standard for AIA proceedings before the Board).

Two district courts construed terms in challenged claims: Ex-1018, D.I. 50, *Omega Patents v. CalAmp Corp.*, No. 6:13-cv-1950 (M.D. Fla. Feb. 20, 2015) (*CalAmp-CC*), and Ex-1019, D.I. 34, *Omega Patents v. Firstech*, No. 2:20-cv-01344 (W.D. Wash. Nov. 22, 2021) (*Firstech-CC*). The Federal Circuit issued

opinions on two appeals from the CalAmp litigation: Ex-1020, 920 F.3d 1337 (Fed. Cir. 2019) (*CalAmp-I*) and Ex-1021, 13 F.4th 1361 (Fed. Cir. 2021) (*CalAmp-II*). All terms not specifically construed should be given their ordinary meaning.

VII. GROUND 1: CLAIMS 1, 4-6, 8, 11-12, 18-19, 21 ARE NOT ANTICIPATED BY *HUNT*

The Petitioners rely on *Hunt* to challenge the patentability of Claims 1, 4-6, 8, 11-12, 18-19, and 21 as being anticipated by *Hunt*. *Hunt*, described herein, discloses an ASIC based wireless appliance that includes a microprocessor for determining which discrete-component based protocol module to select for communication. *Hunt* 5:35-67; 8:46-9:43. Of note, Petitioners concede that *Hunt* fails to disclose the first category of downloading interfaces specifically recited in dependent Claims 2 and 3, that is, where the downloading interface comprises a wired signal downloading interface (Claim 2) and includes a connector for temporary connection to a downloading device (Claim 3). *Petition* 5, 67.

Regarding the second category of downloading interface – the wireless signal downloading interface (Claims 4 and 5) – Petitioners cobble together disjoint and contradictory language in an attempt to invalidate these claims. *Petition* 34-43. Indeed, Petitioners rely on superfluous and contradictory boilerplate as the sole basis for the purported disclosure. *Hunt* 10:35-12:67; *McAlexander*, ¶53.

A. Hunt Fails to Disclose All the Claim Elements

Patent Owner submits that *Hunt* fails to disclose a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. *Hunt*'s vehicle-communication circuit (box 4 in FIG. 1A; box 25 in FIG. 1B; and box 25 in FIG. 5) in combination with a microprocessor (box 8 in FIG. 1A; box 27 in FIG. 1B; and box 27 in FIG. 5) discloses the claimed multi-vehicle compatible controller. Petition 19-20. However, programming of the vehicle-communication circuit, which is either an ASIC or "transistors or conventional circuit elements," cannot be changed via a downloading interface. *Hunt* 9:43-44. Accordingly, *Hunt* fails to disclose the claimed downloading interface.

Hunt discloses a hardware based system in the form of an ASIC, which is, as recited in Claim 1 of *Hunt*, a single ASIC. *Hunt* 9:18-55; 12:1-17. The discrete individual circuit modules that correspond to each protocol are integrated directly into the ASIC and thus fixed. *Hunt* 9:18-55; *McAlexander*, ¶55. *Hunt* discloses that "these logic diagrams represent circuits that function as individual modules within the data-communications circuit and are integrated directly into the ASIC." *Id.* "These protocols can be implemented using integrated silicon-based solutions (e.g., a custom ASIC), or using transistors or conventional circuit elements." *Id.* In other words, protocols cannot be added at a later time or date beyond those

included at manufacture. *McAlexander*, ¶55.

An ASIC is an integrated circuit chip, programmed during manufacture, which has been custom built or fabricated for a specific use rather than a generic use. *McAlexander*, ¶56. Logic gates are masked and then wired at the factory to perform specific functions. *McAlexander*, ¶56. These structures and functions cannot be changed once the ASIC is manufactured. *McAlexander*, ¶56. In the case of *Hunt*, the ASIC is controlled by a microprocessor to select among the protocols for which the ASIC was created. *McAlexander*, ¶57.

The *Hunt* vehicle communication circuit is expressly directed to an ASIC, but Petitioners attempt to broaden *Hunt* to cover other non-disclosed embodiments beyond the ASIC. *McAlexander*, ¶58. A POSA would understand that *Hunt* does not teach or suggest the claimed downloading interface since an ASIC is programmed at a semiconductor fabrication level, and *Hunt* expressly touts the benefits of an ASIC. *McAlexander*, ¶59. By using an ASIC, “the entire wireless appliance **13** can be incorporated into a single ‘chip set’, described by a reference design, thereby reducing its size, manufacturing costs, and potential post-installation failures.” *Hunt* 5:39-42; *McAlexander*, ¶60.

Hunt teaches the wireless appliance is embodied in an ASIC, and the claims of *Hunt* also require a microprocessor. *Hunt* 8:46-9:27. Claim 2 of *Hunt*, for example, recites a microprocessor and a vehicle-communication circuit. *Hunt*

12:41-48; *McAlexander*, ¶61. The vehicle-communications circuitry is in electrical communication with the microprocessor and integrated into a single ASIC. *Id.* The microprocessor does not perform interfacing with the ASIC using any of the protocols hard wired in the ASIC, as those functions are embodied only in an ASIC. *Hunt* 8:46-9:27 and FIGS. 1A and 1B; *McAlexander*, ¶61. Rather, the microprocessor performs basic computer functionality, for example, and determines the communication of the host vehicle. *Id.* The microprocessor does not provide individual support for the communication protocols, which instead is done by the ASIC-based communication modules 25a-25e. *Id.*

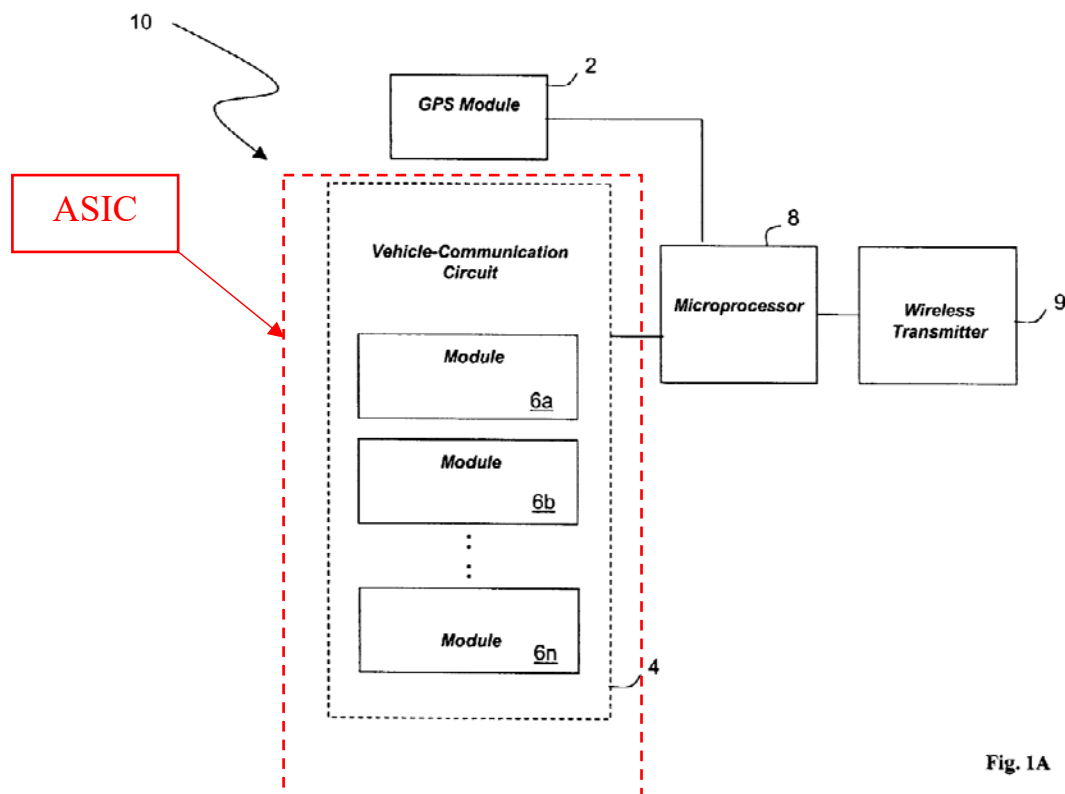


Fig. 1A

Patent Owner's Annotated FIG. 1A of *Hunt*

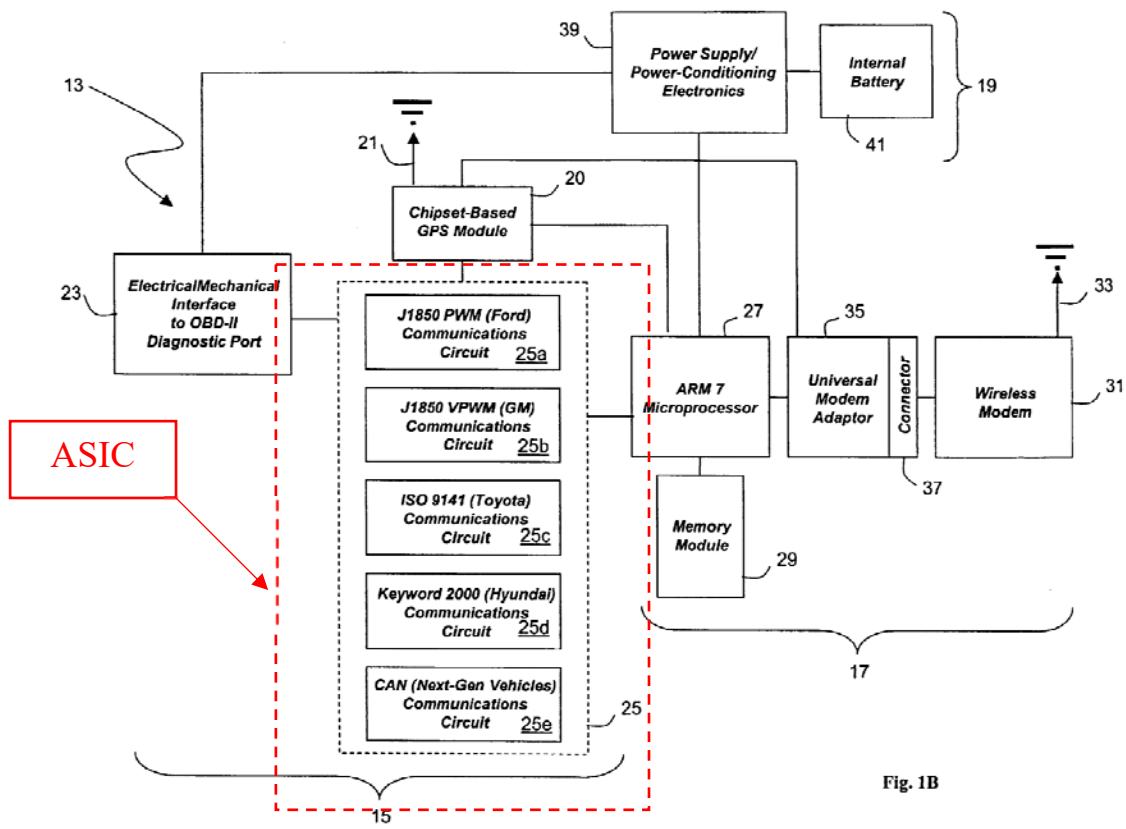


Fig. 1B

Patent Owner's Annotated FIG. 1B of *Hunt*

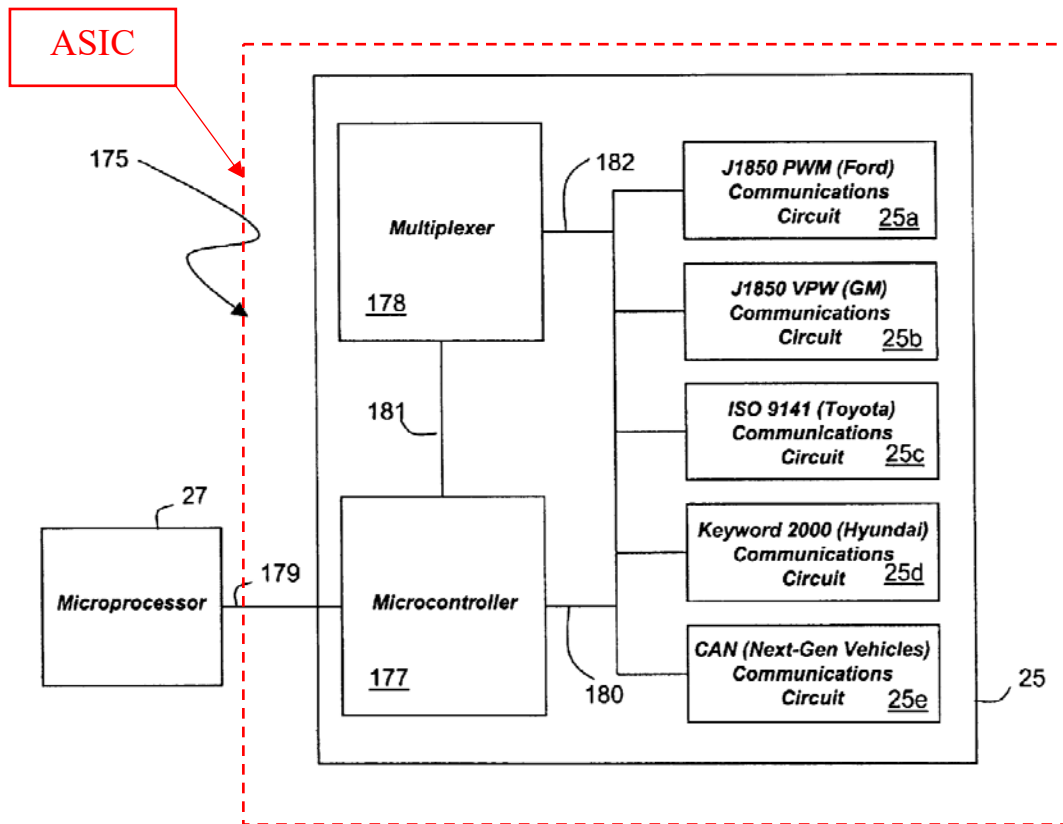


Fig. 5

Patent Owner's Annotated FIG. 5 of *Hunt*

Petitioners concede that *Hunt* fails to disclose a wired signal downloading interface. Petition 5, 67. Desperately hunting to find a wireless downloading interface, the Petitioners turn to inconsistent boilerplate language. Petition 34-36 (citing *Hunt* 10:46-54 and 11:5-18). The boilerplate language relied upon by Petitioners (*Hunt* 10:36-11:67) amounts to nothing more than unsupported speculation, inconsistent with the description of the invention of the *Hunt* reference. *McAlexander*, ¶63. The POSA would be unable to use the teachings of *Hunt* to somehow make a wired or wireless signal downloading interface – and

since the ASIC is preloaded with the predetermined protocols, there is no reason for additional downloading. *McAlexander*, ¶64. The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. See MPEP §2121.01 citing *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003).

The *Hunt* specification concludes with nine paragraphs of boilerplate language. (*Hunt* 10:36-11:67). Petitioners point to *Hunt* 10:46-54 which describes, in part, “some embodiments of the present invention may be implemented in part or in whole as a hard-wired circuit, a circuit configuration fabricated into an application specific integrated circuit, or a firmware program loaded into non-volatile storage, or as a software program loaded from or into a data storage medium as machine readable code.” (Emphasis Added). Petition 35. There is nothing in *Hunt* that would teach or suggest to a POSA how to logically reconcile the above boilerplate passage, filled with generic alternative language, from *Hunt* with the inventors’ invention (i.e. the ASIC) being taught in *Hunt*.

“Section 102(a) provides that an issued patent is invalid if "the invention [therein] was . . . described in a printed publication . . . before the invention thereof by the

applicant." Section 102 embodies the concept of novelty--if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is "anticipated" by the prior invention. As we have stated numerous times [], in order to demonstrate anticipation, the proponent must show "that the four corners of a single, prior art document describe every element of the claimed invention." *Xerox*, 458 F.3d at 1322 (quoting *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000)). This statement embodies the requirement in section 102 that the anticipating invention be "described in a printed publication," and is, of course, unimpeachable. But it does not tell the whole story. Because the hallmark of anticipation is prior invention, the prior art reference--in order to anticipate under 35 U.S.C. §102--must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)."

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359 at 21-22 (Fed. Cir. 2008). Petitioners fail to show how *Hunt* discloses all of the claim elements within the four corners of *Hunt* specifically “arranged” as in the challenged claims. *McAlexander*, ¶66.

Petitioners attempt to selectively apply pieces of these boilerplate passages to the actual device in *Hunt*, but *Hunt* is silent as to what language could be implemented, how to do so, and to which data (e.g., protocol implementation data, or programming instructions for how to perform the functions taught by *Hunt*, such as the microprocessor **27**, as discussed in further detail below).

Firmware, for example, are basic instructions for specific hardware. *McAlexander*, ¶68. Firmware is typically embodied in an integrated circuit and provides basic instructions for the hardware. *Id.* A POSA, based upon the ASIC teachings of *Hunt*, would consider the “firmware loaded into non-volatile storage medium” as providing the basic operations, for example, for the microprocessor **27**, as the programming of the ASIC is fixed or fixed by conventional circuit elements, transistors, integrated silicon based solutions. *Hunt* 8:14-65; 9:36-43; 11:11-19; FIGS. 1A and 1B; *McAlexander*, ¶68. There can be no anticipation where the POSA is left to guess how to arrange the disjointed elements in an attempt to arrive at the claimed invention. *McAlexander*, ¶69.

Hunt describes the microprocessor **27** such that it receives and processes

diagnostic data and location based data operating to format the diagnostic data using firmware. *Hunt* 6:18-65. The firmware is configured to recognize the wireless modem and format outgoing vehicle diagnostics so that the wireless appliance can operate on different wireless networks throughout the world. *Id.* The microprocessor **27** also determines the protocol and communicates the protocol to the ASIC which selects one of the five modules to communicate with the host vehicle. *Hunt* 9:18-23; FIG. 5.

Petitioners contend that the ability of the microprocessor **27** to update firmware that tests “each protocol in an effort to establish communications” is somehow a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. Petition 40. In other words, the Petitioners contend that because the firmware of the microprocessor **27** can be updated, and the microprocessor **27** selects the appropriate protocol, *Hunt* somehow discloses a downloading interface as in the challenged claims. *Id.* This rationale is erroneous. This is no downloading interface. *McAlexander*, ¶71. Keeping in mind that Petitioners have already conceded *Hunt* fails to disclose a wired interface, Patent Owner submits that there is nothing in *Hunt* that discloses any downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible

controller. *McAlexander*, ¶72. For example, the circuitry to implement the protocols cannot be changed as they are embodied in an ASIC. *Hunt* 9:18-45; *McAlexander*, ¶73. In other words, *Hunt* discloses that protocols cannot be added. *McAlexander*, ¶74.

The reference to “carrier wave modulated” does not supply the missing elements of *Hunt*. *McAlexander*, ¶75. The “carrier wave modulated” terms are simply boilerplate to reference a type of computer readable medium to satisfy statutory subject matter requirements. See, for example, 35 U.S.C. §101; MPEP §2106; and *McAlexander*, ¶75. *Hunt* does not disclose any type of downloading interface. *McAlexander*, ¶75.

The POSA cannot fabricate missing puzzle pieces from mere blanket boilerplate statements. Indeed, as noted above, the claimed and disclosed embodiments of *Hunt* identify the microprocessor 27, and separate vehicle-communications circuit, in the form of an ASIC, in communication with the microprocessor. *Hunt* 8:15-20, 8:46-9:45; 12:4-17; 12:43-48; FIG. 1A, 1B, and 5; and *McAlexander*, ¶76. The separate circuit or circuits are discrete circuit elements embodied in an ASIC that includes modules corresponding to different protocols. *McAlexander*, ¶76. There is no downloading interface for permitting downloading of enabling data relating to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. *Id.* *McAlexander*, ¶77.

Even further stretching the actual teachings of *Hunt*, Petitioners contend that *Hunt*'s universal modem adapter and wireless modem together disclose the claimed downloading interface for permitting downloading of enabling data relating to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. Petition 37; *McAlexander*, ¶78. As described above, the microprocessor 27 receives and processes diagnostic data and location based data, and operates to format the diagnostic data using firmware. *Hunt* 6:18-65; and *McAlexander*, ¶79. The firmware is configured to recognize the wireless modem and to format outgoing vehicle diagnostic so that the wireless appliance can operate on different wireless networks throughout the world. *McAlexander*, ¶80. This does not disclose the claimed downloading interface for enabling data related to the at least one corresponding vehicle device code, nor does this disclosure of *Hunt* permit the addition of a broad data interface to be based thereon. *McAlexander*, ¶81.

Petitioners leap to yet another disjointed boilerplate section of *Hunt* in an attempt to show that *Hunt*'s ASIC device can be a cellphone and thus includes the claimed downloading interface. Petition 37, citing *Hunt* 11:34-40; *McAlexander*, ¶82. The *Hunt* wireless appliance is hardwire installed in a vehicle. *Hunt* 5:5-6, 8:46-65; *McAlexander*, ¶83. It is illogical to hardwire install a cellphone in the vehicle, particularly to the OBD-11 diagnostic port as taught by *Hunt*. *Id.*

Hunt teaches that any deviation from an ASIC is undesirable. As described *Supra*, by using an ASIC, “the entire wireless appliance **13** can be incorporated into a single ‘chip set’, described by a reference design, thereby reducing its size, manufacturing costs, and potential post-installation failures.” *Hunt* 5:39-42; *McAlexander*, ¶84. Thus, there is no reason a POSA would interpret the boilerplate language to include or disclose the claimed downloading interface. Petitioner’s jump to use of boilerplate language would thus require undue experimentation on how to keep size and costs small and reduce post-installation failures, particularly in view of the express desire to achieve this using an ASIC. *McAlexander*, ¶85. The Petitioner’s desire to treat the various boilerplate sections as simply being interchangeable with the various embodiments is improper and contrary to the teachings of *Hunt*, as will be understood by a POSA. *McAlexander*, ¶86.

A reference must be considered for what it teaches to a POSA, including portions that teach away from the claimed embodiments. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). A POSA will understand that the boilerplate language does not apply to the vehicle-communication circuit including modules, as described in *Hunt*. *McAlexander*, ¶87. Thus, *Hunt* fails to disclose a downloading interface for permitting downloading of enabling data related to the at

least one corresponding vehicle device code for use by the multi-vehicle compatible controller as in the challenged claims. *Id.*

B. All Claim Terms Must Be Given Patentable Weight

Petitioners also contend that the downloaded data content does not limit the downloading interface. Petition 38. More particularly, the Petitioners contend that the claimed “enabling data” should not be given any patentable weight. *Id.*, at 38-40.

The issue of interpreting “enabling data” has already been considered in previous litigations and reexaminations, and Petitioners’ desired claim construction is inconsistent with prior claim constructions. *McAlexander*, ¶89. The PTAB, in what was the second reexamination in a string of reexaminations, highlighted:

“...[i]n related litigation, the District Court did not construe the term ‘downloading interface,’ but did construe the term ‘enabling data’ as data relating to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller- a construction that matches the terms in the claim. See *Omega Patents, LLC v. CalAmp Corp.*, No. 6:13-cv-1950-0rl -40DAB, (M.D. Fla. Feb. 20, 2015) (“Dist. Ct. Claim Construction Order”) at 20-23, 25.”

“According to the Specification, enabling data may be, for example, (1) the vehicle device code or codes; (2) an instruction to select a code or codes from among those already stored; or (3) the data or sequence to allow the controller 111 to generate the vehicle device code or codes. '278 patent, col. 24, 11. 9-13. Our emphasis on the permissive and exemplary language in this passage underscores that enabling data is not limited to these three alternatives.”

“But despite this non-limiting description, what is clear from Appellant's disclosure is that downloading enabling data via the recited interface enables the recited controller to use a particular vehicle device code from among plural such codes for different vehicles by providing either (1) the code itself to the controller, or (2) data that otherwise enables the controller to select or generate the code. See '278 patent, col. 24, 1. 5-col. 25, 1. 28; Figs. 10-13.”

Ex Parte Omega Patents, LLC, Appeal 2018-008119 at 12-13 (2018) (Ex-1012); *McAlexander*, ¶89. Thus, not only was the term “enabling data” given patentable weight, the courts and this Board have provided clear guidance on its construction. *McAlexander*, ¶90. Nonetheless, the Petitioners contend that the printed matter doctrine affords Petitioners the opportunity to disregard certain claim terms. The Petitioners turn to *In re DiStefano* in an attempt to support this contention. 808 F.3d 845, 848-851 (Fed. Cir. 2015). The claim at issue in *DiStefano* recites “selecting a first element.” *Id.* The Court in *In re DiStefano* ruled that: “Although the selected web assets can and likely do communicate some information, the content of the information is not claimed. And where the information came from, its ‘origin,’ is not part of the informational content at all.” *Id.* at 851. Nothing in the claim calls for origin identification to be inserted into the content of the web asset.” *Id.* at 851.

All claim limitations must be considered when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). With respect to the printed matter doctrine, information content can be given patentable weight if it “has a functional or structural relation to the substrate.” *In re DiStefano* at 850. In sharp contrast, the claimed downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle

compatible controller does claim the content of the information – enabling data related to the at least one corresponding vehicle device code. ‘278 *Patent* 26:13-16. The enabling data has a functional relation to the claimed multi-vehicle compatible controller in that it is “used by the multi-vehicle compatible controller” for communicating with a vehicle device using the corresponding vehicle device code. ‘278 *Patent* Claim 1; 24:13-51; *McAlexander*, ¶91.

Patent Owner notes that in the previous litigations and reexaminations, this position regarding the printed matter doctrine was never raised. The claim language of a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller clearly communicates the content of the data and its effect on the multi-vehicle compatible controller to those having ordinary skill in the art. *McAlexander*, ¶92. In other words, the multi-vehicle compatible controller is programmed to perform the recited functions, and those functions are performed based upon the enabling data. *Id.* Thus, the term “enabling data” should be given full patentable weight. And when the term “enabling data” is given full patentable weight, *Hunt* fails to disclose a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. *McAlexander*, ¶93.

C. Claim 4

As explained in Section VII(0 above, *Hunt* fails to disclose a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least these reasons set forth in Section VII(0 above, dependent Claim 4 is also patentable. *McAlexander*, ¶94.

D. Claim 5

Hunt fails to disclose a wireless signal downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller and that includes a wireless receiver for temporary connection to a downloading interface. Petitioners once again turn to the boilerplate of *Hunt* as allegedly disclosing this recitation too. Petition 42. In particular, the Petitioners, as described above in Section VII(0 above, desire to read the boilerplate language as disclosing more than it reasonably conveys to a POSA. *McAlexander*, ¶95. Petitioners then make a jump in logic that a POSA, in view of the boilerplate, would have turned to the host computer system 57 of *Hunt* as being a downloading device. Petition 42, citing to *Hunt* 7:40-49. The cited portions of *Hunt* merely describe that data packets sent to the *Hunt* appliance are sent over the Internet to a computer. *Hunt* 7:40-49; *McAlexander*, ¶96. Petitioners continue to mix and match disjointed embodiments

for which there is no logical connection. *McAlexander*, ¶97. A host computer that runs a website that communicates with the *Hunt* wireless appliance – boilerplate about computer instructions being on a computer readable medium – logic circuits the function as individual protocol modules integrated into an ASIC --- there is simply no logical connection between the components, specifically the contended wireless downloading interface and its temporary connection to a downloading device. *Hunt* 9:28-35, 11:11-19, 7:40-49; and *McAlexander*, ¶97. A POSA would understand a host computer that runs a website cannot be a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller and that includes a wireless receiver for temporary connection to a downloading interface. *McAlexander*, ¶98. The host computer has nothing to do with protocols, nor selecting the communications protocol of the host vehicle. *Id.* Accordingly, dependent Claim 5 is also patentable.

E. Claim 6

Section VII(0 above explains that *Hunt* fails to disclose a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least these reasons set forth in Section VII(0 above, dependent Claim 6 is also patentable. *McAlexander*, ¶100.

F. Claim 8

Section VII(0 above, explains that *Hunt* fails to disclose a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least these reasons set forth in Section VII(0 above, dependent Claim 8 is also patentable. *McAlexander*, ¶101.

Moreover, despite the Petitioners' contentions, the '278 *Patent* downloading interface is for permitting downloading of enabling data. *McAlexander*, ¶102. Dependent Claim 8 recites the downloading interface being also for permitting downloading of at least programming instruction. *Id.* Thus, the downloading interface of the '278 *Patent* is for permitting downloading of both enabling data and at least one programming instruction. *Id.* No matter how many passages of *Hunt* are cobbled together by Petitioners, *Hunt* fails to disclose a downloading interface is for permitting downloading of enabling data and also for permitting downloading of at least programming instruction. *Id.*

G. Claim 11

Section VII(0 above, explains that *Hunt* fails to disclose a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least these reasons set forth in Section VII(0 above,

dependent Claim 11 is also patentable. *McAlexander*, ¶104.

H. Claim 12

Section VII(0 above, explains that *Hunt* fails to disclose a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least these reasons set forth in Section VII(0 above, dependent Claim 12 is also patentable. *McAlexander*, ¶105.

I. Claims 18-19, 21

Independent Claim 18 recites subject matter from independent Claim 1 and dependent Claim 5. ‘278 *Patent* 25:64-26:15, 26:26-29, and 27:27-28-15.

Independent Claim 18 does not recite the downloading interface as a wireless downloading interface as recited in dependent Claim 5. *Id.* For the reasons set forth in Sections VII(0) and (0 above, independent Claim 18 is also patentable. *McAlexander*, ¶106. Dependent Claims 19 and 21 are also patentable for at least the same reasons. *McAlexander*, ¶107.

VIII. GROUND 2: CLAIMS 1, 4-6, 8, 11-12, 18-19, 21 ARE NOT OBVIOUS OVER HUNT

Petitioners, recognizing the shortcomings of *Hunt*, proffer alternatives that the POSA would simply fill in the missing pieces. Petition 46-48; *McAlexander*, ¶108. A POSA would not have found it obvious to “fill in” the missing pieces of *Hunt*. *Id.* Additionally, evidence of secondary considerations weighs heavily in

favor of patentability. *McAlexander*, ¶109.

A. POSA Would Not Have Found the Claims Obvious in View of Hunt

1. It Would Not Have Been Obvious for A POSA To Modify Hunt In the Way Proposed By Petitioners

In Ground 2, Petitioners concede that *Hunt* fails to disclose the downloading interface as in the challenged claims. Patent Owner agrees. *McAlexander*, ¶110. However, Petitioners contend that “[t]o the extent Hunt’s disclosure of programming the system ‘later’ than manufacture (*Hunt*, 11:5-18) is treated as not expressly disclosing programming the firmware, updating Hunt’s *firmware* through its wireless modem and/or wired connection would have been the conventional and obvious way to implement Hunt’s post-manufacture programming with a reasonable expectation of success.” Emphasis in original; Petition 48, citing *Miller* (Ex-1003), ¶355; *McAlexander*, ¶110.

As described above in Section VII(A), there is no logical connection disclosed in *Hunt* between the firmware and the modules defined in the ASIC. The firmware may simply update the basic functions of the microprocessor, which is discrete and separate from the ASIC that includes the modules. *Hunt* 8:46-9:45, FIGS. 1a, 1b, and 5; *McAlexander*, ¶111.

The modem delivers packets of data to an Internet-accessible website for display of diagnostic and location data. *Hunt* 6:35-7:61; *McAlexander*, ¶112.

Petitioners are attempting to use the boilerplate to fill in the gaps to tie together disjointed pieces of *Hunt*. *McAlexander*, ¶112; Petition 48, *Miller* ¶¶356-357. *Hunt* is silent as to updating the downloading data via a downloading interface because updating an ASIC post manufacture is not possible -- the functions of the ASIC are set during manufacture. *McAlexander*, ¶113. Petitioners' conclusory statement that it was "predictable" falls well short of any required technical rationale required to sustain an obviousness rejection – it is generic and bears no relation to any specific combination of prior art elements. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007); MPEP §2143; *ActiveVideo Networks, Inc. v. Verizon Communs., Inc.*, 694 F.3d 1312, 1329 (Fed. Cir. 2012); *McAlexander*, ¶114.

In other words, despite Petitioners' declarant's attempt to supply the missing teachings of *Hunt*, *Hunt* fails to render obvious the claims of the '278 *Patent*, and specifically, fails to teach, suggest, or describe in any way the claimed downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. *McAlexander*, ¶115.

Moreover, the only way a POSA could possibly make the leap proposed by Petitioners would involve the improper use of hindsight based upon Patent Owner's own specification. *McAlexander*, ¶116. Without that hindsight, a POSA

would conclude that the ASIC was not programmable post manufacturing and thus, a downloading interface would be impractical and inoperable and to try to do so would add unnecessary cost. *McAlexander*, ¶116. *Hunt* discloses that its modem can operate on different wireless networks. *Hunt* 6:35-50; and *McAlexander*, ¶117. *Hunt* further discloses that, “[w]ith firmware, the microprocessor 27 formats the diagnostic and location based data into separate packets and serially transfers these packets through a universal modem adaptor 35 to a wireless modem 31.” *Hunt* 6:35-38; *McAlexander*, ¶118. A POSA would thus understand that even if the firmware would be updated, it would be solely for formatting packets of diagnostic and location-based data for communication via the modem. *Id.* To make a connection that a firmware update is for updating the ASIC protocols in *Hunt* is neither supported by *Hunt*, nor would the POSA make that leap. *McAlexander*, ¶119. *Hunt* still fails to disclose a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. *Id.* “Technical advance, like much of human endeavor, often occurs through incremental steps toward greater goals. These marginal advances in retrospect may seem deceptively simple, particularly when retracing the path already blazed by the inventor.” *Mintz v. Dietz & Watson*, 679 F.3d 1372, 1378 (Fed. Cir. 2012).

To simply declare that a mash-up of *Hunt* to arrive at the claimed

embodiments would be “predicable” is nothing more than a conclusion and, without more, amounts to a declaration that the combination is “common sense” since it is possible that the POSA could arrive at the claimed embodiments. *McAlexander*, ¶120. “[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Personal Web Technologies, LLC v. Apple, Inc.* 848 F.3d 987 at 994 (Fed. Cir. 2017), citing *InTouch Techs., Inc. v. VGO Communications, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014). A clear, evidence-supported account of the contemplated workings of the combination is a prerequisite to adequately explaining and supporting a conclusion that a relevant skilled artisan would have been motivated to make the combination and reasonably expect success in doing so. *Personal Web Tech.*, 848 F.3d at 994. Petitioners fall well short of providing any evidence that a POSA would have, without hindsight, recognized the problem facing the inventor, turned to boilerplate language in *Hunt*, and apply the boilerplate language to desired selected sections of *Hunt*, all while considering the teachings of *Hunt* as a whole. *McAlexander*, ¶121

2. Petitioners’ Proposed Combinations Ignore Compelling Evidence of Secondary Considerations

Patent Owner has presented truthful and compelling evidence of secondary considerations, most of which is already considered and confirmed twice by the

PTAB. Ex-1012, Ex-1017; and *McAlexander*, ¶122. Evidence of secondary considerations must be evaluated when considering obviousness. *Graham v. John Deere Co.*, 383 U.S. 1 at 17-18, 148 USPQ 459 at 467 (1966). This evidence, which was already considered by the PTAB twice, included licensing, commercial success, copying by others, customer need, and limited value for accused products without the invention. See *Ex Parte Flick*, Appeal 2022-003758 at 14 (Ex-1017); *McAlexander*, ¶122. Secondary considerations evidence cannot be discounted: it plays a critical role in the obviousness analysis and, indeed, weighs in Patent Owner’s favor in this regard. See *Leo Pharm. Products, Ltd. v. Rea*, 726 F.3d 1346, 1358, (Fed. Cir. 2013); *Ex Parte Flick*, Appeal 2022-003758 at 15 (Ex-1017); *McAlexander*, ¶122. 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.” *Ex Parte Flick*, Appeal 2022-003758 at 15 (Ex-1017), citing *Leo Pharm. Products* at 1358; *McAlexander*, ¶123.

When the secondary considerations evidence is considered, the claims of the ‘278 Patent are not obvious in view of *Hunt*. *McAlexander*, ¶124.

B. Claim 4

Sections VII(A) and VIII(A) above, explain that *Hunt* fails to disclose or

render obvious a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least the reasons set forth in Sections VII(A) and VIII(A) , dependent Claim 4 is also patentable. *McAlexander*, ¶125.

C. Claim 5

Hunt fails to disclose or render obvious a wireless signal downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller and that includes a wireless receiver for temporary connection to a downloading interface. That is, for at least the reasons set forth in Sections VII(A) and VIII(A) above, dependent Claim 5 is also patentable. *McAlexander*, ¶126.

D. Claim 6

Sections VII(A) and VIII(A) above, explain that *Hunt* fails to disclose or render obvious a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least the reasons set forth in Sections VII(A) and VIII(A) above, dependent Claim 6 is also patentable. *McAlexander*, ¶127.

E. Claim 8

Sections VII(A) and VIII(A) above, explain that *Hunt* fails to disclose or render obvious a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least the reasons set forth in Sections VII(A) and VIII(A) above, dependent Claim 8 is also patentable.

McAlexander, ¶128.

F. Claim 11

Sections VII(A) and VIII(A) above, explain that *Hunt* fails to disclose or render obvious a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least the reasons set forth in Sections VII(A) and VIII(A) above, dependent Claim 11 is also patentable.

McAlexander, ¶129.

G. Claim 12

Sections VII(A) and VIII(A) above, explain that *Hunt* fails to disclose or render obvious a wireless downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. For at least the reasons set forth in Sections VII(A) and VIII(A) above, dependent Claim 12 is also patentable.

McAlexander, ¶130.

H. Claims 18-19, 21

Independent Claim 18 recites subject matter from independent Claim 1 and dependent Claim 5. ‘278 *Patent* 25:64-26:15, 26:26-29, and 27:27-28-15.

Independent Claim 18 does not recite the downloading interface as a wireless downloading interface as recited in dependent Claim 5. *Id.* For the reasons set forth above in Sections VII(A) and VIII(A) and (C), independent Claim 18 is also patentable. *McAlexander*, ¶131. Dependent Claims 19 and 21 are also patentable for at least the reasons set forth above in Sections VII(A) and VIII(A).

McAlexander, ¶132.

IX. GROUND 3: *FLICK885* AND *HUNT* DO NOT RENDER OBVIOUS CLAIMS 1-22

Petitioners are improperly distilling the claims of the ‘278 *Patent* to make the argument that a POSA would have known to slap a GPS unit in a single housing with the other components. *McAlexander*, ¶133. Petitioners’ contentions fail to consider the entire teachings of *Flick885* and *Hunt*, and Petitioners’ declarant fails to supply the missing pieces and/or rationale for combination.

McAlexander, ¶134. Moreover, *Flick885* and the art that it incorporates by reference, namely U.S. Patent No. 6,011,460 to Flick (*Flick460*), were already considered and are cumulative. *McAlexander*, ¶135. Petitioners’ arguments for unpatentability must also fail in light of the Patent Owner’s compelling evidence of secondary considerations of non-obviousness. *Id.*

Petitioners contend that a combination of *Flick885* and *Hunt* renders obvious the claims of the ‘278 *Patent*. More particularly, Petitioners contend that *Flick885* discloses “everything” except GPS and a single housing. Petition 49; *Miller* ¶1361; *McAlexander*, ¶136.

A. Flick885

Flick885 (Ex-1024) was cited by Patent Owner during prosecution of the ‘278 *Patent*. Ex-1002; *McAlexander*, ¶137. *Flick885* is described in the Background of the Invention section of ‘278 *Patent*. *Id.* Accordingly, *Flick885* was specifically considered by the Examiner. *Id.*

Flick885 discloses a multi-vehicle compatible control system for a vehicle that operates on a data communications bus. *Flick885*, 5:5-15; *McAlexander*, ¶138. A multi-vehicle compatible controller of the system provides a bus interface for remote operation of devices on the data communications bus. *Flick885*, 5:11-34, 6:33-40; and *McAlexander*, ¶138. The bus interface interfaces using proper signal levels and formats on the data communications bus. *Flick885*, 6:35-40; *McAlexander*, ¶138.

Flick460 is directed to a vehicle security system for a vehicle having a data communications bus. *McAlexander*, ¶139. *Flick460*, abstract. *Flick460*, like *Flick885* was also cited in the prosecution of the ‘278 *Patent* and also considered by the Examiner. Ex-1002; *McAlexander*, ¶139. *Flick460*, also similarly to

Flick885, was described in the background section of the ‘278 *Patent*, specifically: “U.S. Pat. No. 6,011,460, assigned to Omega Patents, LLC, discloses a similar system where the set of desired signals from the plurality of different sets of signals for different vehicles is obtained, such as by connection and communication with a downloading device.” ‘278 *Patent*, 2:25-29; *McAlexander*, ¶139.

B. A POSA Would Not Have Found the Claims Obvious Over The Combination of *Flick885* and *Hunt*

1. A POSA Would Not Combine *Flick885* with *Hunt*

A POSA would not combine *Flick885* with *Hunt*. *McAlexander*, ¶140.

Once again, the Petitioners attempt to fill in the missing teachings in an attempt to arrive at the challenged claims using hindsight. Petition 50-51, *Miller* ¶¶365-367; *McAlexander*, ¶141. *Flick885* addresses, among others, the problems of security system or car alarm compatibility, but does not disclose anything about vehicle position determining. *Flick885* 1:21-67; *McAlexander*, ¶141. *Hunt* is directed to the monitoring of a vehicle, particularly, for analyzing a vehicle’s GPS and diagnostic data. *Hunt* 2:23-25, 4:11-27; *McAlexander*, ¶142. *Hunt* does not address ongoing compatibility with different vehicles since *Hunt* discloses protocol modules being embodied in an ASIC. *Hunt* 9:18-45; *McAlexander*, ¶142; see, e.g., Section VII(A) above.

Petitioners contend that a POSA would add location services to *Flick885* to

“achieve any or all of the ‘advantages’ *Hunt* describes.” Petition 50-51, *Miller* ¶366. This statement amounts to nothing more than a conclusion that a POSA would turn to *Hunt* simply to make *Flick885* better. *McAlexander*, ¶143.

Petitioners’ declarant’s statement is insufficient as a motivation to make or build something better – failing to explain why a POSA would have combined the specific elements to arrive at the challenged claims. *McAlexander*, ¶144; *ActiveVideo Networks, Inc. v. Verizon Communs., Inc.*, 694 F.3d, at 1328. A combination of *Flick885* and *Hunt* can only be achieved through the use of improper hindsight. *McAlexander*, ¶145. Technical advance, like much of human endeavor, often occurs through incremental steps toward greater goals. These marginal advances in retrospect may seem deceptively simple, particularly when retracing the path already blazed by the inventor. *Mintz v. Dietz & Watson*, at 1378.

Similarly, the Petitioners’ declarant’s blanket conclusory statement that the “combination” is “no more than the ‘predictable use of the prior art elements’” as the rationale for combining *Flick885* and *Hunt* is also improper. It is conclusory and lacks a technical rationale. *ActiveVideo Networks, Inc. v. Verizon Communs., Inc.*, 694 F.3d at 1328; *KSR* 550 U.S. 398 at 418; *Personal Web Tech* at 992, 993-994; MPEP §2143, *McAlexander* ¶146.

2. Petitioners Proposed Combination of *Flick885* and *Hunt* Fails to Consider Compelling Evidence of Secondary Considerations

Patent Owner has presented compelling evidence of secondary considerations, most of which is already recognized and confirmed twice by the PTAB. *McAlexander*, ¶147. Evidence of secondary considerations must be evaluated when considering obviousness. *Graham v. John Deere Co.*, 383 U.S. 1 at 17-18, 148 USPQ 459 at 467 (1966). This evidence, which was already considered by this Board on multiple occasions, included licensing, commercial success, copying by others, customer need, and limited value for accused products without the invention. See *Ex Parte Flick*, Appeal 2022-003758 at 14 (Ex-1017); D.I. 297-1, 26:11-20 (Ex-2004); D.I. 297-4, 45:3-19, 46:25-47:19 (Ex-2005); D.I. 297-5, 64:15-24, 102:16-103:13, 155:4-13 (Ex-2006); and *McAlexander*, ¶147. Secondary considerations evidence cannot be discounted: it plays a critical role in the obviousness analysis and, indeed, weighs in Patent Owner's favor in this regard. See *Leo Pharm. Products, Ltd. v. Rea*, 726 F.3d 1346, 1358, (Fed. Cir. 2013); *Ex Parte Flick*, Appeal 2022-003758 at 15 (Ex-1017). 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." *Ex Parte Flick*, Appeal

2022-003758 at 15 (Ex-1017), citing *Leo Pharm. Products* at 1358; *McAlexander*, ¶147.

When the secondary considerations evidence is properly weighed with respect to the proposed combination of *Flick885* and *Hunt*, particularly the adding of a vehicle position determining device and a multi-vehicle compatible controller for cooperating with the vehicle position determining device to send vehicle position data, the claims of the ‘278 *Patent* are not obvious. *McAlexander*, ¶148. Petitioners are offering to simply slap a GPS from *Hunt* to the *Flick885* system and put it all in a single housing, and contend, nearly fifteen (15) years later and after careful consideration by a multitude of tribunals, that the combination would have been obvious. This is wrong, and flies in the face of common sense, and does not given proper weight to the evidence of secondary considerations. *McAlexander*, ¶149.

Courts have cautioned against falling into the forbidden use of hindsight, and rely on evidence of secondary considerations to provide guides on this forbidden use. *Mintz v. Dietz & Watson*, at 1379; *McAlexander*, ¶147.

“The need for Graham findings can be important to ward against falling into the forbidden use of hindsight. Simply because the technology can be easily understood does not mean that it will satisfy the legal standard of

obviousness. In fact, objective consideration of simple technology is often the most difficult because, once the problem and solution appear together in the patent disclosure, the advance seems self-evident. Instead, the proper analysis requires a form of amnesia that “forgets” the invention and analyzes the prior art and understanding of the problem at the date of invention.”

Mintz v. Dietz & Watson, at 1379.

Accordingly, the claims are patentable over *Flick885* and *Hunt*.

C. The Combination of *Flick885* and *Hunt* is No Better Than the Combination of *Lowrey* and *Lightner*

The PTAB has previously considered the combination of *Lowrey* and *Lightner* – the same rotating inventor group and the same technology. *McAlexander*, ¶150; *Ex Parte Flick*, Appeal 2022-003758 at 12 (Ex-1017). Both *Lowrey* and *Lightner* disclose GPS. Thus, adding GPS to the already considered *Flick885* is not only duplicative of art already considered, but no better than art already considered. *McAlexander*, ¶150.

D. Claims 2-12

Sections IX(B-C) above, explain that even the selective combination of *Flick885* and *Hunt* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections IX(B-C), dependent Claims 2-

12 are also patentable. *McAlexander*, ¶151.

E. Claim 13

Independent Claim 13 includes subject matter from independent Claim 1 and dependent Claim 3. Sections IX(B-C) above, explain that even the selective combination of *Flick885* and *Hunt* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections IX(B-C), independent Claim 13 is also patentable. *McAlexander*, ¶152.

F. Claims 14-17

Dependent Claims 14-17 recite subject matter similar to dependent Claims 6-9. *McAlexander*, ¶153. Sections IX(B-C) above, explain that even the selective combination of *Flick885* and *Hunt* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections IX(B-C), dependent Claims 14-17 are also patentable. *McAlexander*, ¶153.

G. Claim 18

Independent Claim 18 recites subject matter from independent Claim 1 and dependent Claim 5. ‘278 *Patent* 25:64-26:15, 26:26-29, and 27:27-28-15. Independent Claim 18 does not recite the downloading interface as a wireless downloading interface as recited in dependent Claim 5. *Id.* For the reasons set forth above in Sections IX(B-C), independent Claim 18 is also patentable over the combination of *Flick885* and *Hunt*. *McAlexander*, ¶154.

H. Claims 19-22

Dependent Claims 19-22 recite subject matter similar to dependent Claims 6-9. *McAlexander*, ¶155. Sections IX(B-C) above, explain that even the selective combination of *Flick885* and *Hunt* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections IX(B-C), dependent Claims 19-22 are also patentable. *McAlexander*, ¶155.

X. EVIDENCE OF SECONDARY CONSIDERATIONS SUPPORT PATENTABILITY

Petitioners advance a laundry list of reasons to discard all evidence of secondary considerations. Petition 76-81. Petitioners' contentions including the requirement that Petitioners be granted the opportunity to cross-examine witnesses, the PTAB not considering the secondary considerations in a "adversarial proceeding", the weight of the secondary consideration evidence, Omega has "blocking patents" negating commercial success, there is no nexus, and there is no evidence of copying, licenses are missing, amount nothing more than a hand-waving in an attempt to get the PTAB to look past the evidence of secondary considerations. *McAlexander*, ¶156.

This PTAB has twice considered the evidence of secondary considerations. *Ex Parte Omega Patents, LLC*, Appeal 2018-008119 (Ex-1012); *Ex Parte Omega Patents, LLC*, Appeal 2022-003758 (Ex-1017); *McAlexander*, ¶157. Petitioners want the PTAB to simply discard the evidence that the PTAB has already

considered, twice as it relates to the '278 *Patent*, and, most recently:

“A key aspect of our finding in this regard is, as it was in a related appeal, (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.4 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 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).” *Ex Parte Flick*, Appeal 2022-003758 (Ex-1017), at 13-14 (internal footnotes omitted); *McAlexander*, ¶158.

In other words, the PTAB has already, on multiple occasions, considered the same secondary evidence and determined the sufficiency of this evidence: there is a nexus, there is commercial success, there is copying, there is licensing, there is customer need, and there is limited value of accused products without the invention. *McAlexander*, ¶159. The PTAB has carefully considered and found this evidence sufficient twice, and taking into consideration a jury verdict, Federal Circuit Appeal, and testimony of the opposing party admitting to copying and limited value of product without the claimed invention. *Id.*; see also D.I. 297-1, 26:11-20 (Ex-2004); D.I. 297-4, 45:3-19, 46:25-47:19 (Ex-2005); D.I. 297-5, 64:15-24, 102:16-103:13, 155:4-13 (Ex-2006), and *McAlexander*, ¶159.

Patent Owner submits that rarely does evidence get considered this many times and by such a variety of tribunals. The evidence of secondary considerations here should be fully considered consistent with the previous determinations of this Board and other tribunals. *McAlexander*, ¶160.

XI. INSTITUTION SHOULD BE DENIED

A. The Board Should Decline to Institute under 35 U.S.C. §325(d) Because the Same or Substantially the Same Prior Art And Same Arguments Were Presented to the Office

The Board may “reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. §325(d). In *Becton Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17-18 (Dec. 15, 2017) (precedential in relevant part), the Board identified six non-exclusive factors in evaluating whether to deny institution under §325(d):

- (1) the similarities and material differences between the asserted art and the prior art involved during examination;
- (2) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (3) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;

- (4) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (5) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (6) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Advanced Bionics establishes the following “two-part framework” for deciding whether to apply Section 325(d):

- “(1) whether the same or substantially the same art previously was presented to the [Patent] Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.”

Advanced Bionics v. Med-El Elektromedizinische Gerate, IPR2019-01469, Paper 6, 7-8 (Feb. 13, 2020) (precedential).

1. *Hunt* Is Cumulative and Similar to the Prior Art Considered

Once issued as a Patent, the ‘278 *Patent* has been subject to a litany of challenges including five (5) reexaminations and multiple litigations. In the most recent reexamination of the ‘278 *Patent*, the PTAB evaluated both U.S. Patent No. 6,611,740 to *Lowrey* (Ex-1059) and U.S. Patent No. 6,636,790 to *Lightner* (Ex-2001). See *Ex Parte Omega Patents, LLC*, Appeal 2022-003758 (2022) (Ex-1017); and *McAlexander*, ¶161. *Hunt* is similar to *Lowrey* and *Lightner* and enjoys two of its three inventors in common with *Lowrey*, and a common inventor with *Lightner*. Ex-1023; Ex-1059; Ex-2001; and *McAlexander*, ¶161. All four of the *Lightner* inventors enjoy commonality with the inventor group in *Lowrey*. *Id.* *Lowrey* is directed to an internet based vehicle diagnostic system that includes a wireless appliance in electrical contact with an in-vehicle computer and that can report position data from a GPS device, while *Lightner* is directed to a wireless diagnostic system and method for monitoring vehicles that includes a wireless appliance that can be physically and electrically installed. *Id.*; *McAlexander*, ¶161. Similarly, *Hunt* is directed to small-scale integrated vehicle telematics device that collects, transmits, and analyzes diagnostic and location-based data from a motor vehicle. Ex-1023; *McAlexander*, ¶162. In other words, *Hunt*, *Lowrey*, and *Lightner* share the same inventor group, and, like most of the art cited against the ‘278 *Patent*, are directed to the same common technology.

McAlexander, ¶163. *Lowrey* and *Lightner* were both cited in *Hunt*. *Hunt*, page 2; *McAlexander*, ¶164. Patent Owner submits that we have now come full circle with prior art rejections -- *Hunt* cites U.S. Patent No. 5,732,074 to *Spaur et al.* *Id.* (Ex-2009). *Spaur et al.* was used to formulate a rejection in the first reexamination – a rejection that was later withdrawn. See Reexamination Control No. 90/013,587 (RX1; Ex-1005); *McAlexander*, ¶164. Patent Owner also now has one of its own earlier patents, *Flick885*, cited in the Petition, despite being considered over fifteen years ago by the USPTO. Petition 48-75; *McAlexander*, ¶164.

The PTAB determined that “collective teachings” of both *Lowrey* and *Lightner* fail to teach or suggest the claimed embodiments of the ‘278 *Patent*, including the claimed 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. *Ex Parte Omega Patents, LLC*, Appeal 2022-003758 at 12 (Ex-1017); *McAlexander*, ¶165. The issue of whether a prior art reference discloses the claimed 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 was also previously decided by the PTAB – again determining that the prior art, that time *Chou*, fails to teach or suggest the claimed 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. *Ex Parte Omega Patents, LLC*, Appeal 2018-008119 at 14 (2018) (Ex-1012); *McAlexander*, ¶165.

2. *Flick885* Was Already Considered

During prosecution of the ‘278 *Patent*, the Patent Owner cited *Flick885*. ‘278 *Patent*, page 2; *McAlexander*, ¶166. Not only did the Patent Owner cite *Flick885*, Patent Owner embraced *Flick885*, identifying it in the background section of the patent: “Additionally, U.S. Patent No. 6,756,885, also assigned to Omega Patents, LLC discloses a multi-vehicle control system whereby a multi-vehicle compatible controller stores a set of device codes for a given vehicle device for a plurality of different vehicles. Device codes are read from the data communications bus, and a match between a read device code and the stored device codes is determined to provide compatibility with different vehicles.” ‘278 *Patent*, 2:29-37; *McAlexander*, ¶166. Moreover, in determining that there was not a substantial new question of patentability raised, U.S. Patent Number 5,719,551 (*Flick551*) was considered. See Reexamination Control No. 90/014,419 (RX4; Ex-1008); and *McAlexander*, ¶166. *Flick551* is in the priority chain of *Flick885*. *Flick885*, page 1; *McAlexander*, ¶166.

Accordingly, Patent Owner points out the substantial similarities between the now-asserted art and the prior art considered during the many rounds of

examination. *McAlexander*, ¶167. In addition, Patent Owner submits that Petitioners failed to sufficiently point out how any Examiner erred in evaluation of any of the prior art, to which the asserted prior art is merely cumulative. *Id.*

B. The Compelling Nature of Secondary Considerations Has Repeatedly Been Confirmed

The PTAB has twice considered the sufficiency of evidence of secondary considerations. See *Ex Parte Omega Patents, LLC*, Appeal 2022-003758 (Ex-1017), *Ex Parte Omega Patents, LLC*, Appeal 2018-008119 (Ex-1012); and *McAlexander*, ¶168. In the most recent Decision on Appeal in Appeal 2022-003758 (Ex-1017), the PTAB specifically noted that consideration goes beyond the PTAB to two jury trials, and a Federal Circuit Appeal. *Ex Parte Omega Patents, LLC*, Appeal 2022-003758, 4-5; *McAlexander*, ¶168. The PTAB noted that a key aspect in multiple appeals is a jury verdict in related litigation that there was a nexus between the evidence of secondary considerations and the claimed invention, and the Federal Circuit's upholding of the jury's infringement verdict affirming the judgement of infringement of the '278 Patent's asserted claims. *Ex Parte Omega Patents, LLC*, Appeal 2022-003758 at 13-14; *McAlexander*, ¶168. The jury found evidence of acceptance of licenses because of the merits of the claimed invention, evidence of commercial success because of the merits of the claimed invention, and copying. *Id.* The PTAB has considered this evidence, including its sufficiency, at least twice, a jury has considered this evidence, and

the Federal Circuit has also considered this evidence. *Id.* Patent Owner submits that rarely does evidence get considered this many times by such a variety of tribunals, all of which have been deemed both credible and compelling.

McAlexander, ¶169.

XII. CONCLUSION

Even based on the preliminary record currently before the PTAB, the Petition is deficient in multiple respects. The prior art relied upon in the Petition fails to disclose the claimed embodiments when combined by a POSA. Moreover, a POSA would not have combined the prior art relied upon in the Petition, and would not have done so for the reasons set forth in the Petition. Still further, Patent Owner submits that the *Becton* factors weigh in favor of the PTAB exercising discretion under 35 U.S.C. §325(d) to deny the Petition. *Becton, Dickinson and Co. v. Braun Melsungen AG*, IPR2017-01586 (December 15, 2017) (precedential).

Patent Owner does not point out every deficiency of the Petition and instead reserves the right to make additional arguments and provide additional evidentiary support in its §42.120 Response should the Board institute *inter partes* review. The Petition fails to establish a reasonable likelihood that the Petitioners would prevail with respect to any of the challenged claims.

Therefore, Patent Owner respectfully submits that no *inter partes* review

should be instituted.

Dated: April 27, 2023

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. §42.24(d)

Pursuant to 37 C.F.R. §42.24(a)(1)(i), the undersigned hereby certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE contains 11,387 words, excluding the parts of this Response that are exempted under 37 C.F.R. §42.24(a), as measured by the word-processing system used to prepare this paper.

/s/ Ryan T. Santurri

Ryan T. Santurri, Lead Counsel
Reg No. 61,894

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Patent Owner's Preliminary Response, and Exhibits 2001 through 2009, are being served on April 27, 2023, by electronic mail at the following email addresses of record for the Petitioners:

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