

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 RESPONSE UNDER § 37
C.F.R. § 42.120**

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37 C.F.R. §42.120	66
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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> ")
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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 (" <i>Hunt</i> ")

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)
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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)
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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_distprofile0630.20

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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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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)
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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)
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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)
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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)

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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)
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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.
2010	Second Declaration of Mr. Joseph C. McAlexander, III

2011	Reexamination Certificate Issued May 17, 2023, in 90/014,675 (RX5).
2012	U.S. Patent No. 5,515,043 to Berard et al.
2013	U.S. Patent No. 6,628,233 to Knockeart et al.
2014	Declaration of Mr. Christian Tregillis
2015	D.I. 145-43, PL47, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2016	D.I. 145-19, PL1, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2017	D.I. 145-20, PL2, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
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2019	D.I. 145-36, PL20, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2020	D.I. 145-59, PL73, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2021	Master And Cross-License Agreement, dated May 12, 2007, between Omega R&D, Omega Patents and Directed Electronics, Inc.
2022	D.I. 145-38, PL22, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)

I. INTRODUCTION

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, a District Court, and the Federal Circuit 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*). Ex-2010, ¶32. 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). Ex-2010, ¶33. 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 different. Ex-2010, ¶34.

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. Ex-2010, ¶35. To argue obviousness of

these claims, Petitioners propose combining U.S. Patent No. 6,756,885 to Flick (*Flick885*), also owned by the Patent Owner, with *Hunt*. Ex-2010, ¶36. Of course, *Flick885* is described in the Background of the ‘278 *Patent* and was considered by the examiner in the original prosecution. Ex-2010, ¶37. *Flick885* is not new to the prosecution of the ‘278 *Patent* either. Ex-2010, ¶37.

Regarding anticipation of 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* – trying to piece together the elements of the challenged claims. Ex-2010, ¶38. The relied-upon boilerplate language is contradictory to the inventors’ description of their invention in the specification of *Hunt*. Ex-2010, ¶39. Accordingly, a Person of Ordinary Skill in the Art (POSA) would not read *Hunt* as argued by Petitioners. *Id.* This same deficiency permeates the obviousness challenges as Petitioners’ declarant attempts to supply the missing teachings of *Hunt*. Ex-2010, ¶40.

Petitioners’ attempts to use the printed matter doctrine to read recitations out of the challenged claims must also 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. Ex-2010, ¶41. The evidence of secondary considerations includes testimony from an infringer’s

employees in litigation involving the ‘278 *Patent*, describing the ‘278 *Patent* as providing important features sought by its customers and increasing the value of their product – and recognizing it included 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); Ex-2010, ¶41; Ex-2014, ¶¶31-44. Much of the 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; Ex-2010, ¶42.

Because Petitioners failed to meet its statutory burden of demonstrating unpatentability by a preponderance of the evidence pursuant to 35 U.S.C. §316(e), patentability of the challenged claims should be confirmed.

II. OVERVIEW OF THE PRIOR ART

The Petitioners identified the following references 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

¹ Patent Owners notes that the USPTO has recently issued a reexamination certificate based upon the PTAB’s Decision on Appeal (Ex-2011).

monitoring and analysis functions using a wireless appliance. *Hunt* 2:25-27; Ex-2010, ¶43. 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; Ex-2010, ¶43. A GPS module collects location-based data. *Hunt* 2:23-25, 5:4-5, 6:18-26; Ex-2010, ¶43. A communications circuit collects diagnostic data relating to the vehicle. *Hunt* 5:8-10; Ex-2010, ¶43. The communications circuit selects one supported communications protocol from among supported communications protocols. *Hunt* 5:7-19; Ex-2010, ¶43. 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; Ex-2010, ¶43.

B. U.S. Patent No. 6,756,885 To Flick

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.*; Ex-2010, ¶44.

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; Ex-2010, ¶45.

III. THE ‘278 PATENT

A. Overview of 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; Ex-2010, ¶46.

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, many vehicles are also equipped with aftermarket security systems. Ex-2010, ¶47. 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; Ex-2010, ¶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.

Ex-2010, ¶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.*; Ex-2010, ¶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, and 26:16-29; Ex-2010, ¶51.

B. The Validity of the '278 Patent Has Been Confirmed Repeatedly

Starting in 2013, Patent Owner was in protracted litigation with CalAmp Corp. asserting four patents, one of which was the *'278 Patent* (the “CalAmp Litigation”). In the first trial in the CalAmp Litigation, a jury concluded that the asserted patents, including the *'278 Patent*, were infringed and not invalid. Ex-1027. On appeal, the Federal Circuit affirmed the jury’s finding of no invalidity as to the *'278 Patent* and the other asserted patents. *Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1343 (Fed. Cir. 2019).² The parties conducted a second trial, which resulted in a finding of direct infringement of the *'278 Patent* and the award of damages for 917,000+ units based thereon³. Ex-1028. Infringement of the *'278 Patent* was affirmed by the Federal Circuit on appeal, but the damages award was reversed and remanded for a third trial. *Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1382 (Fed. Cir. 2021). The case was resolved prior to a third trial.

In 2015, CalAmp filed a petition for ex parte reexamination, application

² In the first appeal, the Federal Circuit also reversed and remanded the case for a new trial on select issues of infringement, willfulness, damages and fees. *Omega Patents*, 920 F.3d at 1354.

³ The jury also found that CalAmp did not induce infringement of a different asserted patent, and found damages for a single unit on a third patent that CalAmp was determined to infringe in the first trial. Ex-1028.

90/013,587. Ex-1005. The examiner reviewed the petition and evidence and confirmed the claims. Ex-1005, pp. 13-14. CalAmp filed another petition for ex parte reexamination in 2016, application 90/013,851. Ex-1006. In the second reexamination, the claims were rejected, the decision was appealed, the Board reversed, and the claims of the ‘278 *Patent* were confirmed. Ex-1006, p. 140-reversal, p. 20-confirmation of the claims). CalAmp filed a third reexamination in 2019, application 90/014,309. Ex-1007. After ordering reexamination, the examiner confirmed the validity of the claims of the ‘278 *Patent*. Ex-1007, pp. 23-24. A fourth petition for reexamination was filed in 2019, application 90/014,419. The examiner denied institution of reexamination (Ex-1008, p. 51), but petitioner filed a petition to review the refusal. In July 2023, the petition was granted-in-part and that reexamination is currently ongoing. A fifth petition for reexamination was submitted in 2021, application 90/014,675. Ex-1009. In the fifth reexamination, the claims were rejected, the decision was appealed, the Board reversed, and the claims of the ‘278 *Patent* were confirmed. Ex. 1009, p. 17.

IV. 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.” *Id.* In its Institution Decision, the Board applied this level of skill noting that it, “appears to be consistent with the ‘278 patent and the asserted prior art.” Decision, 23. For the purposes of this IPR proceeding, Patent Owner has applied this level of skill⁴, and notes that it is sufficient for the Board to evaluate the Petition Grounds.

V. CLAIM CONSTRUCTION

In its Institution Decision, the Board construed the claim term “enabling data”, referring to the specification of the ‘278 *Patent* as the single best guide to the meaning of a disputed claim term. Decision 25. The ‘278 *Patent* describes the term “enabling data” as data that “may be the vehicle device code or codes, an instruction to select a code or codes from among those already stored, or the data or sequence to allow the controller 111 to generate the vehicle device code or codes, for example.” Decision 25 (citing Ex-1001, 24:8-13). The Board looked to *Omega Patents I* (Ex-1012) for guidance on the construction of “enabling data” and wholly adopting this construction as: data that “enables the recited controller to use a particular vehicle device code from among plural such codes by providing either (1)

⁴ Patent Owner reserves the right to propose a different level of skill in the art and support in other proceedings, including the related district court proceedings between these parties.

the code itself to the controller, or (2) data that otherwise enables the controller to select or generate the code.” Decision 25-27 (citing *Omega Patents I*, 12-13). Patent Owner agrees with the Board.

Petitioners contended that the printed matter doctrine applies to the term “enabling data” and that the term should be imparted no patentable weight relying on *In re DiStefano* and *Praxair Distribution*. Petition, 38-40 (citing *In re DiStefano*, 808 F.3d 845, 848-851 (Fed. Cir. 2015); *Praxair Distribution v. Mallinckrodt Hosp. Prods. IP*, 890 F.3d 1024 (Fed. Cir. 2018)). The Board rejected this contention, finding the claimed “enabling data” of the ‘278 *Patent* does not constitute non-limited printed matter. Decision 25-26. The Board further determined that the “enabling data” dictates how the particular information is used – to “enable[] the recited controller to use a particular vehicle device code form among plural such codes for different vehicles.” Decision 26-27 (citing *Omega Patents I*, 12-13; see also *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994)). Patent Owner concurs with this determination, as well as the Board’s finding no further construction is necessary.

VI. 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. *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; Ex-2010, ¶52.

Regarding the second category of downloading interface – the wireless signal downloading interface (Claims 4 and 5) – Petitioners cobble together disjointed and contradictory language in an attempt to invalidate these claims. Petition 34-43. Instead, Petitioners rely on superfluous and contradictory boilerplate as the sole basis for the purported disclosure. *Hunt*, 10:35-12:67; Ex-2010, ¶53.

A. *Hunt Fails to Disclose All the Claim Elements*

For the purposes of institution of this *Inter Partes Review*, the Board adopted Petitioners’ argument that the claims of the ‘278 *Patent* are anticipated by *Hunt*. The Board’s Decision set forth a perceived dispute between the parties as turning on the meaning of “enabling data” as recited in limitation 1[e], and whether “enabling data” must be downloaded to *Hunt*’s vehicle-communications circuit, or whether downloading “enabling data” to *Hunt*’s microprocessor satisfies the language of the claim limitation 1[e]. Decision, 35. Ex-2010, ¶54. Patent Owner contends this is incorrect.

Patent Owner submits that the dispute turns on the entire claim element 1[e]:

“a downloading interface for permitting downloading of enabling data to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.” Decision, 32-33, 35; Ex. 1001, 26:12-15; Ex-2010, ¶55. Put another way, do the cited references disclose the physical structure of an interface that permits the multi-vehicle compatible controller to connect to the outside world and receive enabling data for use by the controller? Ex-2010, ¶55.

1. The Claims of the ‘278 Patent Require More Than Enabling Data

The Board, in its Decision, agrees with the Patent Owner that *Hunt’s* vehicle-communications circuit is not reprogrammable (or updatable) through download, but finds that claim 1 does not require the controller to be “reprogrammable (or updatable) through download.” Decision, 37. This, according to the Board, is based on a “broad” recitation of limitation 1[e] focused on the phrase “related to.” *Id.* The Board’s focus on the term “enabling data,” removed from the rest of the claim language is error. The dispute turns on *Hunt’s* failure to disclose all portions of 1[e]. Claim 1 requires, via a downloading interface, the downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller. Ex-1001, 26:12-15. The Board’s decision fails to give proper weight to the entire claim element, and the statement that *Hunt’s* ASIC need not be “reprogrammable” seemingly removes the claim limitation that the controller download, via a downloading interface, the enabling data for use by the controller.

Ex-2010, ¶57.

2. Hunt Fails To Disclose A Downloading Interface For Permitting Downloading of Enabling Data...For Use By the Multi-Vehicle Compatible Controller

a) Hunt Fails to Disclose A Downloading Interface

*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. Ex-2010, ¶58. As it relates to the “downloading interface for downloading”, *at the time of the invention* a POSA would understand that the claimed “downloading interface for permitting downloading” is a physical interface (e.g., either hardwired or wireless) that permits downloading from somewhere remote or outside of the hardware (i.e., the outside world). Ex-2010, ¶59. Absent a physical downloading interface, there is no way to obtain from the outside world the enabling data to be “for use” by the multi-vehicle compatible controller. Ex-2010, ¶60.*

When evaluating the scope of a claim, every limitation in the claim must be considered. A claimed invention may not be dissected into discrete elements and then evaluated in isolation. Instead, the claim as a whole must be considered. *See, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89 (1981). The '278 *Patent* describes a wireless version of the downloading interface as including a wireless receiver, interface circuitry or logic circuitry with switching components, and that it may

communicate via any one or more wireless technologies such as cellular, satellite, IR, Bluetooth, or WiFi. Ex-2010, ¶61; Ex. 1001, 24:14-26. The '278 *Patent* also describes a wired variation of the downloading interface that includes a connector for temporary connection, a mating connector, and interface circuitry, and may communicate using any one or more of RS232/429 protocol, USB, FireWire, and TCP/IP (Internet). Ex-2010, ¶62; Ex. 1001, 24:33-44. These descriptions from the '278 *Patent* conform to what a POSA would understand the “downloading interface for downloading” to be – permitting enabling data to be downloaded from external devices in the outside world. Ex-2010, ¶63. The use, for example, of WiFi, IR, cellular, satellite, RS232/429 protocol, USB, FireWire, and/or TCP/IP demonstrates that the POSA would readily recognize that running of firmware or providing data from one internal component to another is not performed by a downloading interface for downloading. Ex-2010, ¶64. The above-described protocols and external transfer techniques are not used internally between device components, such as the microprocessor and the vehicle-communications circuit in *Hunt*. Ex-2010, ¶65.

Downloading is the transmission of a file or data from one computer or storage device to another, typically over a network, such as, for example, from a larger server to a user device. Ex-2010, ¶66. Downloading is not reading from a memory or communicating data within a single device or ASIC as in *Hunt. Id.* The testing and selecting of the protocols do not satisfy the definition of downloading by a POSA.

Id. Thus, a POSA understands a “downloading interface for permitting downloading” is not satisfied by permitting communication from one internal component to another internal component, as in *Hunt*. Ex-2010, ¶67. Accordingly, the Board’s conclusion that *Hunt*’s teaching of “downloading firmware on the MVCC’s microprocessor satisfies the “enabling data” limitation of claim 1” is in error. Decision, 36; Ex-2010, ¶67.

The Board concluded that the “running of firmware” to select a protocol is somehow downloading, via a downloading interface, enabling data relating to the at least one corresponding vehicle device code. Decision, 36. The “running of firmware” is not downloading of enabling data via a downloading interface and for use with a multi-vehicle compatible controller. Ex-2010, ¶68.

The Board adopted Petitioners’ argument that *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. Decision 31; Petition 19-20.⁵ However, programming of the vehicle-communication circuit, which is either an ASIC or “transistors or conventional circuit elements,” cannot be changed via a

⁵ The Board erroneously concluded that Patent Owner conceded that *Hunt* discloses the claimed multi-vehicle compatible controller. While *Hunt* discloses selecting the appropriate fixed protocols from an ASIC, *Hunt* does not disclose the claimed multi-vehicle compatible controller because the claimed multi-vehicle compatible controller must cooperate with a downloading interface and must operate using enabling data downloaded from the downloading interface – which *Hunt* fails to disclose.

downloading interface. *Hunt* 9:43-44. No enabling data related to at least one corresponding vehicle device code can be downloaded via a downloading interface in *Hunt* for use by the contended multi-vehicle compatible controller. Ex-2010, ¶69. *Hunt* fails to disclose or suggest to the POSA that data that enables the recited controller to use a particular vehicle device code from among a plurality of 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, can be downloaded from a downloading interface in *Hunt*. Accordingly, *Hunt* fails to disclose the claimed downloading interface for permitting downloading of enabling data for use the by multi-vehicle compatible controller. Ex-2010, ¶70.

*b) The Hunt ASIC Cannot Operate on Downloaded
Enabling Data*

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. Ex-2010, ¶72. Logic gates are masked and then wired at the factory to perform specific functions. Ex-2010, ¶72. These structures and functions cannot be changed once the ASIC is manufactured. Ex-2010, ¶72.

Hunt discloses a hardware-based system in the form of a single ASIC, as recited in Claim 1 of *Hunt*. *Hunt* 9:18-55; 12:1-17. The ASIC is controlled by a microprocessor to select among the protocols for which the ASIC was created. Ex-2010, ¶73. The discrete individual circuit modules that correspond to each protocol

are integrated directly into the ASIC and thus fixed. *Hunt* 9:18-55; Ex-2010, ¶71. *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 after original manufacturing. Ex-2010, ¶72.

Not only is a downloading interface for downloading enabling data for the multi-vehicle controller absent from *Hunt*, a POSA would understand that there is no need for a downloading interface to permit downloading of enabling data for the multi-vehicle compatible controller because any data hypothetically downloaded cannot be operated on by the ASIC since the programming of the ASIC is fixed. Ex-2010, ¶74. Likewise, there is no need for vehicle device codes to be downloaded via a downloading interface since an ASIC could not do anything with these codes. Ex-2010, ¶75. With no mechanism to use subsequent downloaded data, there is no basis to suggest a POSA would understand *Hunt* to disclose a downloading interface for such data. Ex-2010, ¶76.

The vehicle codes in *Hunt* are fixed during manufacture. Ex-2010, ¶77. A POSA would recognize there is no need to download instructions to select the vehicle device codes already stored via a downloading interface since the multi-

vehicle compatible controller stored them when manufactured, and since vehicle device codes cannot be added to an ASIC, there is no reason to add instructions for device codes that do not exist at the time of manufacture. Ex-2010, ¶77. There is no need for data to allow the multi-vehicle compatible controller to generate the vehicle device codes to be downloaded via a downloading interface since, this is programmed into the ASIC at manufacture. Ex-2010, ¶78. Any hypothetical downloading of enabling data via a hypothetical downloading interface would have no effect on the operation of the device in *Hunt*. Ex-2010, ¶79.

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. Ex-2010, ¶80. 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 this as a benefit of an ASIC. Ex-2010, ¶81. 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; Ex-2010, ¶82.

Hunt teaches the wireless appliance implemented with an ASIC and 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; Ex-2010, ¶83.

The vehicle-communications circuitry is in electrical communication with the microprocessor and integrated into a single ASIC. *Id.* The microprocessor does not interface with the ASIC using 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; Ex-2010, ¶83. Rather, the microprocessor performs basic computer functionality, for example, and determines the communication of the host vehicle. Ex-2010, ¶84. The microprocessor does not provide individual support for the communication protocols, which instead is done by the ASIC-based communication modules 25a-25e. *Id.* An ASIC is faster than a microprocessor. Ex-2010, ¶83.

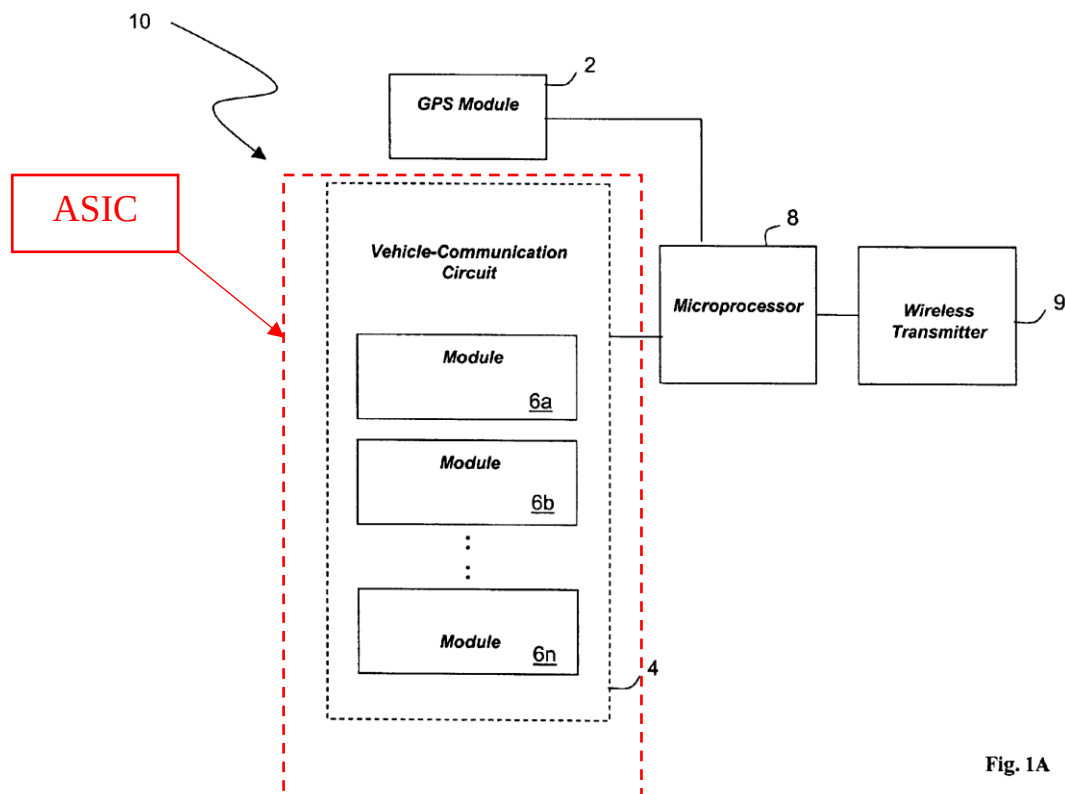


Fig. 1A

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

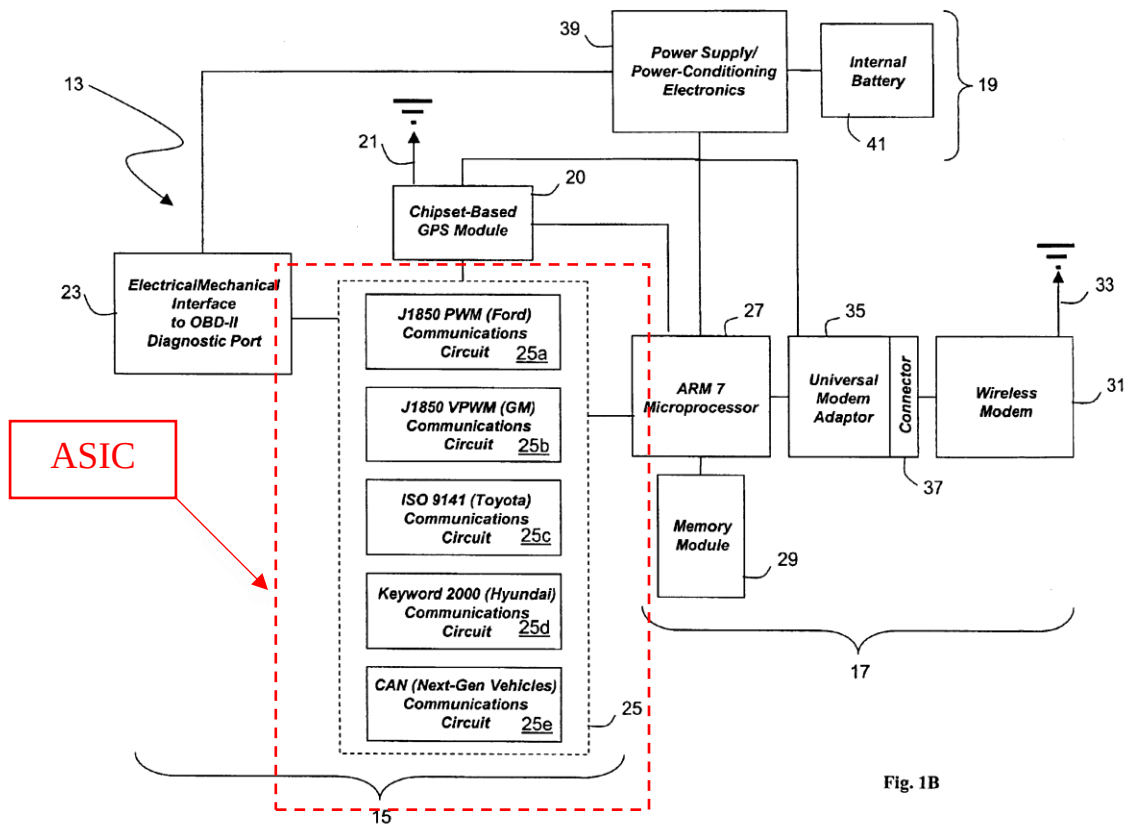


Fig. 1B

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

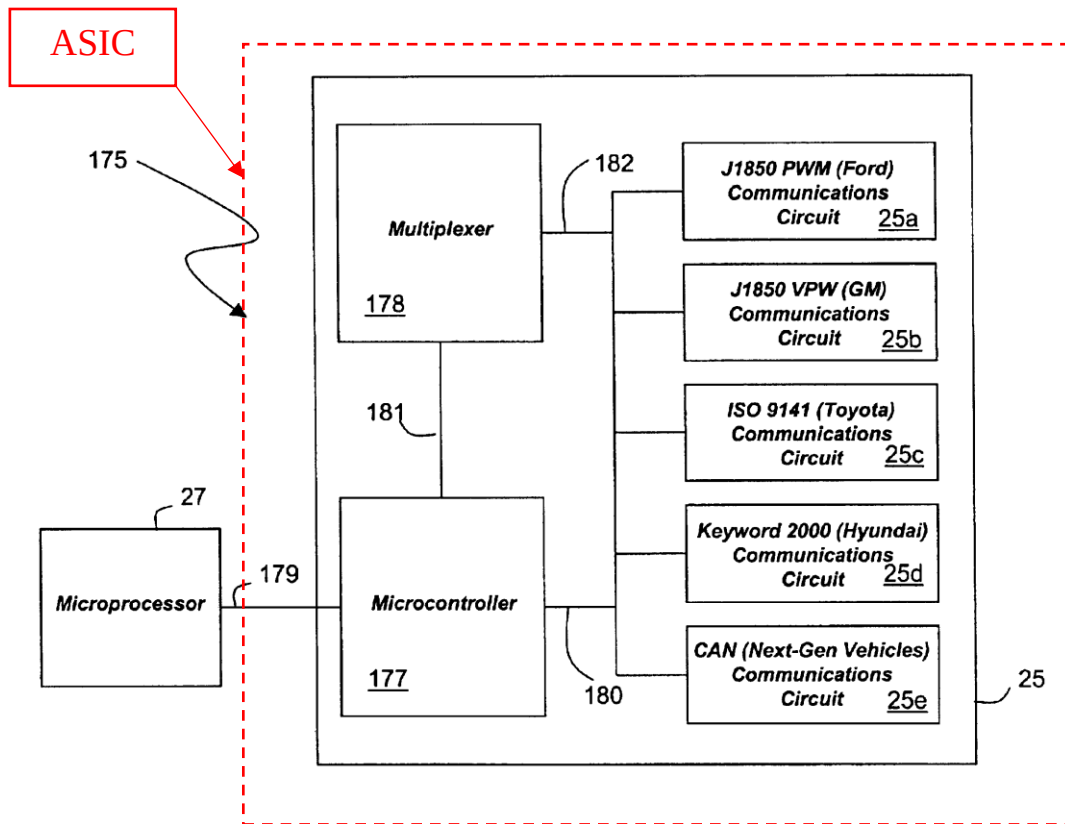


Fig. 5

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

Despite Petitioners' concession that *Hunt* fails to disclose a wired signal downloading interface, for the purposes of instituting this *Inter Partes* Review, the Board took that position that downloading firmware that is run to determine the vehicle-communications protocol of the host vehicle is enabling data. Petition 5, 67; Decision 36-37; Ex-2010, ¶85. The Board took the position that the *Hunt* microprocessor "*communicates the specific protocol* to the vehicle communications circuit." Decision, 36 (Emphasis in original). Simply running firmware that determines the proper vehicle-communications protocol and providing some sort of

instructions from one internal component to another internal component does not amount to downloading via a downloading interface of enabling data. Ex-2010, ¶86. Downloading, particularly via a downloading interface, is not an internal running of firmware or internal communications between components. Ex-2010, ¶87. As discussed, *Supra*, a POSA would understand that downloading of enabling data via a downloading interface means the enabling data comes from somewhere “external” or the outside world. Ex-2010, ¶88; See Section VI.A.2.a, *Supra*. Loading firmware onto or executing firmware on a microprocessor is not downloading via a downloading interface. Ex-2010, ¶89. Firmware is basic instructions for specific hardware. Ex-2010, ¶90. 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; Ex-2010, ¶91. This is not downloading of enabling data via a downloading interface. *Id.* Even if the firmware is somehow added at a time later than ASIC fabrication, it is not done via a downloading interface. *Id.* For example, firmware may be added by providing an integrated circuit with these basic instructions. *Id.* But why should a POSA be left to guess how to arrange these

disjointed elements? There can be no anticipation where the POSA must guess how to arrange the disjointed elements in an attempt to arrive at the claimed invention. *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008), citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983); *See also In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); Ex-2010, ¶92.

c) *Boilerplate Cannot Fill The Gaps in Hunt To Disclose A Downloading Interface*

Having conceded that *Hunt* fails to disclose a wired downloading interface, Petitioners turn to inconsistent boilerplate language in *Hunt*. 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. Ex-2010, ¶93. 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 – and thus no reason to even consider the boilerplate. Ex-2010, ¶94. 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 Pharms., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003); Emphasis Added. Boilerplate in the specification that is seemingly in every patent cannot operate to broaden the scope of what it conveys to a POSA, particularly, when the specification is read as a whole. Ex-2010, ¶95; *Akeva L.L.C. v. Adidas-Salomon AG, Adidas America, Inc.*, 208 Fed. Appx. 861, 865 (Fed. Cir. 2006); *Les Traitments Des Eaux Poseidon, Inc. v. Kwi, Inc.*, 135 F.Supp 2d 126, 135 (D. Mass 2001). That is just the case in *Hunt* as *Hunt* teaches using an ASIC, but Petitioners want *Hunt* to disclose embodiments that include updating the protocols – essentially undoing or ignoring the ASIC teachings. Ex-2010, ¶95.

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, with the inventors’ invention (i.e., the ASIC) being taught in *Hunt*. Ex-2010, ¶96. As this Court has recognized “[b]ecause

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.’” *Net MoneyIN*, 545 F.3d at 1369 , quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).”

Petitioners attempt to selectively apply snippets of boilerplate to the actual device in *Hunt*, but fail to show how *Hunt* discloses all of the claim elements within the four corners of *Hunt* specifically “arranged” as in the challenged claims. Ex-2010, ¶97. The voluminous boilerplate section of *Hunt* describes that “some of the processes may be programmed when the computer system is manufactured or via computer-readable medium at a later date.” Ex. 1023, 11:10-19; Ex-2010, ¶99. These processes, which are loosely associated with some of the present embodiments, may be executed by programmable equipment, such as computers. *Id.* *Hunt* fails to disclose which processes can be updated, offering no guidance to a POSA whether these processes include firmware or what functions are encompassed by “some”. *Id.* *Hunt* is silent as to what boilerplate language to combine, 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). Ex-2010, ¶98. In other words, the boilerplate does not equate to the specific arrangement claimed in the ‘278 *Patent*. *Id.* The POSA cannot

fabricate missing puzzle pieces from mere boilerplate. *Net MoneyIN*, 545 F.3d at 1369; Ex-2010, ¶100. 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 Ex-2010, ¶100. The separate circuit/circuits are discrete circuit elements embodied in an ASIC that includes modules corresponding to different protocols. Ex-2010, ¶100. 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. Ex-2010, ¶101.

d) *Hunt's Diagnostic And Network Compatibility Functions*

Hunt describes the microprocessor 27 receiving and processing diagnostic data and location based data operating to format the diagnostic data using firmware. *Hunt* 6:18-65; Ex-2010, ¶102. This 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.* *Hunt* fails to disclose updating this firmware and whether it is included in the “some processes” that may be “programmed at a later date.” *Hunt*, 11:11-19; Ex-2010, ¶103. And even if *Hunt* could somehow disclose updating this firmware, the wireless network communications capability is not enabling data: data that 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. *Id.* This does not disclose a downloading interface for downloading enabling data related to the at least one corresponding vehicle device code for the multi-vehicle compatible controller, nor does this disclosure of *Hunt* permit the addition of a broad data interface to be based thereon. Ex-2010, ¶104.

e) Hunt's Protocol Selecting Functions

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. The ability of the microprocessor **27** to update firmware that tests “each protocol in an effort to establish communications” does not 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. Ex-2010, ¶105. Just because the firmware of the microprocessor **27** can maybe be updated, and the microprocessor **27** selects the appropriate protocol, does not mean that *Hunt* somehow discloses a downloading interface as in the challenged claims. *Id.* There is no disclosure in *Hunt* that updating the microprocessor firmware equates to downloading enabling data for use in the controller, because a POSA understands the protocols necessary for communication

on the vehicle data bus are in the ASIC and cannot be changed. *Hunt* 9:18-45; Ex-2010, ¶106. 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. *Id.*

f) *Hunt's Modem*

Stretching the actual teachings of *Hunt* further, 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; Ex-2010, ¶107. One modem can be physically replaced with another. *Hunt* 6:56-59; Ex-2010, ¶108. 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. Ex-2010, ¶109. 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. Ex-2010, ¶110.

If, hypothetically, *Hunt's* modems disclose structure for a downloading interface, the data these modems process is not enabling data related to the at least one corresponding vehicle device code. Ex-2010, ¶111. Instead, the only disclosure

associated with modem communication is “diagnostic and location-based data” and GPS data. *Hunt*, 6:35-38, 10:6-9; Ex-2010, ¶111.

g) A Cellphone Is Not A Downloading Interface

Petitioners leap to yet another boilerplate section of *Hunt* to argue *Hunt*’s ASIC device can be a cellphone and thus includes the claimed downloading interface. Petition 37, citing *Hunt* 11:34-40; Ex-2010, ¶112. The *Hunt* wireless appliance is hardwire installed in a vehicle; it is illogical to hardwire a cellphone to the OBD-11 diagnostic port. *Hunt* 5:5-6, 8:46-65; Ex-2010, ¶113.

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; Ex-2010, ¶114. Thus, there is no reason a POSA would interpret the boilerplate language to include or disclose the claimed downloading interface. To use of boilerplate language as suggested by Petitioners would 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. Ex-2010, ¶115. The various boilerplate sections are not simply interchangeable with the various embodiments; Petitioners’ suggestions are improper and contrary to the teachings of *Hunt*, as will be understood by a POSA. Ex-2010, ¶116.

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, 1551 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). *Hunt*'s stated desire to use an ASIC to reduce size, costs and later failures contradict implementing boilerplate language with the vehicle-communication circuit described in *Hunt* (i.e., the unchangeable ASIC). Ex-2010, ¶117. *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. Claim 4

As explained in Section VI.A 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 VI.A above, dependent Claim 4 is also patentable. Ex-2010, ¶118.

C. 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. Petition, 42. As described above in Section VI.A.2.c) above, Petitioners read the boilerplate language as disclosing more than it reasonably conveys to a POSA. Ex-2010, ¶119. 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; Ex-2010, ¶120. There is no logical connection between the alleged wireless downloading interface and a temporary connection between a host computer that runs a website, boilerplate references to computer instructions on a computer readable medium, and logic circuits the function as individual protocol modules integrated into an ASIC. *Hunt* 9:28-35, 11:11-19, 7:40-49; and Ex-2010, ¶121. A POSA would understand a host computer that runs a website has nothing to do with vehicle communication protocols, nor selecting the communications protocol of the host vehicle. Ex-2010, ¶123. Therefore, such a combination 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. Ex-2010, ¶122. Accordingly, dependent Claim 5 is also patentable.

D. Claim 6

Section VI.A 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 VI.A above, dependent Claim 6 is also patentable. Ex-2010, ¶124.

E. Claim 8

Section VI.A.2 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 VI.A above, dependent Claim 8 is also patentable. Ex-2010, ¶125.

Moreover, despite the Petitioners' contentions, the '278 *Patent* downloading interface permits downloading of enabling data. Ex-2010, ¶126. Dependent Claim 8 recites the downloading interface being also for permitting downloading of at least programming instruction. Ex-2010, ¶127. Thus, the downloading interface of the '278 *Patent* permits 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 for downloading of enabling data and also for downloading of at least one programming

instruction. *Id.*

F. Claim 11

Section VI.A 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 VI.A above, dependent Claim 11 is also patentable. Ex-2010, ¶128.

G. Claim 12

Section VI.A 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 VI.A above, dependent Claim 12 is also patentable. Ex-2010, ¶129.

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 in Section VI.A above and VI.C above, independent Claim 18 is also patentable. Ex-2010, ¶130. Dependent Claims 19 and 21 are also patentable for at least the same

reasons. Ex-2010, ¶131.

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

Recognizing the shortcomings of *Hunt*, Petitioners proffer that the POSA would simply fill in the missing pieces with disjointed fragments from *Hunt*. Petition 46-48; Ex-2010, ¶132. 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. Ex-2010, ¶133.

A. 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. Ex-2010, ¶134. 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; Ex-2010, ¶134. The Board, for the purpose of instituting this *Inter Partes Review*, agreed with the Petitioners that, “it would have been routine for an ordinarily skilled artisan to

utilize a programmable computer system for *Hunt*'s vehicle-communication circuit and update it through its downloading interface (i.e., universal modem adaptor and wireless modem)."⁶ Decision 39. This rationale is flawed. Ex-2010, ¶135.

As described above in Section VI.A.2 above, there is no logical connection disclosed in *Hunt* between the firmware and the modules defined in the ASIC. At best, the firmware may simply update the basic functions of the microprocessor, which are discrete and separate from the ASIC that includes the modules. *Hunt* 8:46-9:45, FIGS. 1a, 1b, and 5; Ex-2010, ¶136. As described in Section VI.A.2 above, there is simply no reason to download and update the firmware in *Hunt* with enabling data. Since protocols are hardwired as an ASIC and unchangeable, there is simply no reason to update or change the functions that operate with these fixed protocols. Ex-2010, ¶137.

The Board attempts to connect the dots between the disjointed passages of *Hunt*, turning to purely general boilerplate in *Hunt*. Decision, 39-40. The Board relied on *Hunt*'s disclosure that "it would be 'apparent to one of ordinary skill in the art' that some of the disclosed embodiments could be implemented 'in many different embodiments of software, firmware, and hardware.'" Decision, 39 (citing

⁶ In making its decision, the Board relies on the position that Patent Owner does not contest Petitioner's contentions with respect to claim element 1[d]. Patent Owner disputes that *Hunt* discloses element 1[d] as the claimed MVCC cooperates with the claimed downloading interface and operate on enabling data. Thus, since *Hunt* does not disclose element 1[e] it cannot disclose element 1[d]. Section VI.A above.

Ex. 1023, 10:55-59); Ex-2010, ¶138. The Board further relied on *Hunt*'s disclosure that the *absence* of specific reference to actual software code or specialized hardware components is because artisans of ordinary skill would be able to “design software and control hardware to implement the embodiments of the present invention based on the description herein with only a reasonable effort and without undue experimentation.” Decision 39-40; *Hunt*, 10:64-11:4; Ex-2010, ¶138. The Board offers no specific evidence to support this conclusion, and a POSA would not make the logical leaps required to design software to “implement the embodiment of the present invention based upon the description” without undue experimentation or the improper use of hindsight. Ex-2010, ¶138. The Board gives full faith and credit to *Hunt*'s boilerplate, finding no fault with reliance on boilerplate as providing evidence that a POSA would have recognized there were many predictable and routine variations for implementing *Hunt*'s invention. See generally, Decision, 40; Ex-2010, ¶139. The Board relies on boilerplate of *Hunt* that speaks generally about the disclosed embodiments. *Id.*

The specification of *Hunt*, when read as whole, clearly demonstrates *Hunt* is far narrower than what the Petitioners and Board are extracting. General language cannot operate to contradict the specific disclosure. *Silicon Graphics, Inc. v. ATI Technologies*, 607 F.3d 784, 791 (Fed. Cir. 2010); Ex-2010, ¶140. The specification as a whole suggests to a POSA something contrary to the boilerplate – using an ASIC

with fixed programming. Ex-2010, ¶141; *See also, Akeva L.L.C.*, 208 Fed. Appx. at 865; *Les Traitments Des Eaux Poseidon*, 135 F.Supp 2d at 135. The use of general, vague, and permissive boilerplate language does not open the door for a POSA to implement any and all changes by simply characterizing them as routine and conventional. Ex-2010, ¶142.

The Board concluded that from *Hunt*'s general boilerplate, the POSA was aware of the techniques for updating programming via a downloading interface, and a POSA "wishing to utilize a programmable vehicle-communication circuit (e.g., to add new communications modules 'later' or post manufacture) would have been motivated to update that vehicle-communications circuit via Hunt's downloading interface." Decision, 40; Ex-2010, ¶143. Other than the teachings of the '278 *Patent*, what would lead a POSA to search for such a combination? *Hunt* did not recognize this problem, because otherwise *Hunt* would have used a solution other than an ASIC. Ex-2010, ¶144. Yet the Board concluded that if a POSA can implement a predictable variation and would see the benefit of doing so, §103 likely bars patentability, offering no reason to make such a combination. *Id.*

A POSA would not read the *Hunt* general boilerplate as inviting updating of programming via a downloading interface, nor does it invite adding new communications modules "later" because these are consistent with the specific teachings of *Hunt*. Ex-2010, ¶145. The Board relies on *KSR* noting that combining

two embodiments disclosed adjacent to each other in the prior art does not require a leap of inventiveness. Decision, 40 citing *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007); Ex-2010, ¶146. But there is only one embodiment in *Hunt*, and general boilerplate language does not provide another embodiment or undo the specific embodiments disclosed. Ex-2010, ¶146. Embodiments and disclosures cannot be fabricated based upon wished-for boilerplate language. Ex-2010, ¶147; VI.A.2.c) above; and *Les Traitments Des Eaux Poseidon*, 135 F. Supp. 2d at 135. It is not possible to have essential structural features, such as the *Hunt* ASIC, also be “non-restrictive” based upon boilerplate. *Id.*

The modem of *Hunt* does nothing more than deliver packets of data to an Internet-accessible website for display of diagnostic and location data. *Hunt* 6:35-7:61; Ex-2010, ¶148. The modem of *Hunt* does not to use, download, or otherwise operate on enabling data. *Id.* *Hunt* is silent as to updating the enabling data via a downloading interface because updating an ASIC post manufacture is not possible - - the functions of the ASIC are set during manufacture. Ex-2010, ¶149. The Board concludes that a skilled artisan would have used known and predictable techniques for updating or adding new communications modules later. Decision, 40; Ex-2010, ¶150. However, neither the Board, the Petitioners, nor *Hunt* describe specifically how to achieve this. *Id.* As agreed by the Board, an ASIC is hardwired and not updatable. Decision, 39; Ex-2010, ¶151. There is simply no way to update the *Hunt*

ASIC with new protocols later, and a POSA would not download enabling data because of the fixed nature of the ASIC. *Id.*

To add new protocols would require a complete disregard of the ASIC teachings in *Hunt*. Ex-2010, ¶152. *Hunt* specifically uses, and even claims, an ASIC for reducing size, manufacturing costs, and post-installation failures. Ex-2010, ¶152; *Hunt*, 5:40-41. At best, *Hunt* conveys to a POSA that the protocols of the Hunt ASIC can be implemented in silicon-based solutions, transistors, or conventional circuit elements – all of which are not updatable via a downloading interface for downloading enabling data. Ex-2010, ¶153; *Hunt*, 9:36-43. There is nothing predictable and routine about undoing an ASIC. Ex-2010, ¶154. Stated alternatively, what is predictable to a POSA is that the *Hunt* ASIC cannot have protocols or new modules added post manufacture. *Id.* As such, there is no reason set forth in *Hunt* to update the ASIC with new protocols. *Id.* Even if a POSA would recognize that it may be beneficial to add new protocols in *Hunt*, at the time of the invention the POSA would likely replace the ASIC with a different ASIC similar to *Hunt's* disclosure of replacing one modem for another. Ex-2010, ¶155. A POSA recognizes that an ASIC is faster than a microprocessor. Ex-2010, ¶83. A processor, for example, is instruction driven and slower because one must go back and forth to retrieve the instructions, interpret the instructions, and then execute the instructions. *Id.* A POSA would not go backwards and replace the ASIC with

anything other than another ASIC. *Id.*

The conclusory statement that it was “predictable” to add a downloading interface for downloading enabling data, as recited in the ‘278 *Patent*, 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*, 550 U.S. at 418; MPEP §2143; *ActiveVideo Networks, Inc. v. Verizon Communs., Inc.*, 694 F.3d 1312, 1329 (Fed. Cir. 2012); Ex-2010, ¶156. No evidence has been supplied that a POSA, based upon *Hunt*, would not only have recognized the precise combination proposed, but that it was predictable. *Id.*

In other words, *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. Ex-2010, ¶157.

The only way a POSA could possibly make the leap proposed by Petitioners is the improper use of hindsight based upon Patent Owner’s own specification. Ex-2010, ¶158. 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. Ex-2010, ¶158. *Hunt* discloses that its modem can operate on different wireless networks.

Hunt 6:35-50; and Ex-2010, ¶159. *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; Ex-2010, ¶160. A POSA would thus understand that even if the firmware were updated, it would be solely for formatting packets of diagnostic and location-based data for communication via the modem. *Id.* This is not enabling data. *Id.*

To make a connection that a firmware update could update the ASIC protocols in *Hunt* is neither supported by *Hunt*, nor would the POSA make that unpredictable leap. Ex-2010, ¶161. *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.* The evidence does not support an interpretation of *Hunt* where the firmware is updated with enabling data via a downloading interface, and any contention that it somehow would be contrary to the actual teachings of *Hunt*. Ex-2010, ¶162. “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 conclusory and, without more, amounts to suggesting the combination is “common sense” since it is possible that the POSA could arrive at the claimed embodiments. Ex-2010, ¶163. “[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 Techs., LLC v. Apple, Inc.* 848 F.3d 987, 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 and while considering *Hunt* as a whole, recognized the problem facing the inventor, turned to boilerplate language in *Hunt*, and applied the boilerplate language to desired selected sections of *Hunt*. Ex-2010, ¶164. Section 103 cannot be redefined with general boilerplate language. *Id.*

Defining the problem in terms of the solution, as the Board has in its adoption of Petitioners’ arguments, is evidence of hindsight. *Insite Vision, Inc. v. Sandoz, Inc.*, 783 F.3d 853, 859 (Fed. Cir. 2015); Ex-2010, ¶165. There is nothing in *Hunt* to motivate a POSA, at the time of invention, to recognize, fabricate, and puzzle

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

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

Evidence of secondary considerations must be evaluated when considering obviousness. *Graham v. John Deere Co.*, 383 U.S. 1 at 17-18 (1966). Patent Owner has presented compelling evidence of secondary considerations, such as licensing, commercial success, copying by others, customer need, and limited value for accused products without the invention, most of which has been considered and confirmed twice by the PTAB. Ex-1012, Ex-1017; and Ex-2010, ¶166. Secondary consideration 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. Prods., Ltd. v. Rea*, 726 F.3d 1346, 1358, (Fed. Cir. 2013); *Ex Parte Flick*, Appeal 2022-003758 at 15 (Ex-1017); Ex-2010, ¶166. This 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. Prods.* at 1358; Ex-2010, ¶167.

When the secondary considerations evidence is considered, the claims of the

'278 *Patent* are not obvious in view of *Hunt*. Ex-2010, ¶168. Petitioners advance a laundry list of reasons to discard all evidence of secondary considerations. None are availing. In these proceedings, similar art to *Hunt* was presented and considered and with respect to the same missing claim element – the downloading interface for permitting downloading of enabling data relating to at least one vehicle device code for use by the multi-vehicle compatible controller. Ex-2010, ¶168.

Petitioners want the PTAB to simply discard the evidence that the PTAB has already considered 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.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 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); Ex-2010, ¶209.

In other words, the Board has carefully considered and found this evidence sufficient *twice*, and taking into consideration jury verdicts, Federal Circuit appeals, and testimony of *an infringer* 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 Ex-2010, ¶¶208, 210. The Patent Owner sets forth below additional evidence of licensing, commercial success, copying by others, customer need, and limited value of products without the claimed invention.

a) Licensing

The ‘278 *Patent* has been licensed by numerous parties over the years. Ex-2014, ¶18. Indeed, the ‘278 *Patent* has been included in a half-dozen licenses provided by the Patent Owner, and is within the portfolios of patents that have generated in excess of \$70MM in patent royalties. Ex-2014, ¶18-20. The licensing of the ‘278 *Patent* (and several other asserted patents) was recognized by the jury in the first trial between Patent Owner and CalAmp, during which CalAmp unsuccessfully challenged the validity of the ‘278 *Patent*:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word "yes" in the blank below to any question that you answer "yes" to):

YES

Did others accept licenses under patents because of the merits of the claimed invention?

Ex-1027.

In other words, after observing all of the testimony of the witnesses, reviewing the exhibits presented during trial, and applying the Court's Jury Instructions, the Jury determined that the licenses were based on the merits of the claimed invention, including the '278 Patent. The 2016 Jury verdict was challenged on appeal by CalAmp, and the Federal Circuit affirmed the finding rejecting invalidity of the '278 Patent. *See Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1343 (Fed. Cir. 2019). The extensive licensing of the '278 Patent is evidence of non-obviousness.

b) *Commercial Success*

In addition to licensing, the first CalAmp Jury Verdict form also addresses commercial success due to the merits of the claimed invention:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word "yes" in the blank below to any question that you answer "yes" to):

yes

Were accused products covered by the claim commercially successful due to the merits of the claimed invention rather than due to advertising, promotion, salesmanship, or features of the product other than those found in the claim?

Ex-1027.

While the finding was infringement was reversed by the Federal Circuit in the first appeal, a second jury again found CalAmp's devices infringed the '278 Patent, and in a second appeal, the Federal Circuit affirmed the finding of infringement. *Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1373 (Fed. Cir. 2021). Thus, the second CalAmp Jury Verdict establishes that CalAmp's commercial products correspond to the claimed invention. In particular, as of the second CalAmp trial (in 2019), CalAmp had sold over 917,000 units that infringed the '278 Patent:

Total damages awarded: \$ 4,586,111

Number of accused products included in damages award: 917,223

5.B. Of the total number of accused products found to infringe and therefore included in the damage award (see question 5.A. above), how many accused products have been found to infringe each patent (for any patents found not infringed, please leave that line blank):

'876 patent: 0

'885 patent: 0

'727 patent: 1 unit

'278 patent: 917,222 unit

Ex-1028. The extensive sales of infringing products is evidence of commercial success directly tied to the ‘278 *Patent*. Indeed, the technology in the ‘278 *Patent* provided valuable advantages over other options.

c) *Copying by Others*

In the following excerpt from the First Jury Verdict from the CalAmp litigation as to invalidity, the Jury confirmed the evidence established copying of the patented inventions, including the ‘278 *Patent*:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word “yes” in the blank below to any question that you answer “yes” to):

YES Did others copy the claimed invention?

Ex. 1027.

The Jury’s finding of infringement of all of the asserted claims of the ‘278 *Patent* established that CalAmp’s products correspond to the claimed invention, as did the significant sales volume (referenced above) of products from CalAmp that embody the ‘278 *Patent*.

d) *Customer Need and Limited Value*

The ‘278 *Patent* was one of three patents asserted in the CalAmp litigation providing features for multi-vehicle compatibility via the data bus for a vehicle

tracking system. Ex-2010, ¶169. The ‘278 *Patent* provided for multi-vehicle databus compatibility in a vehicle tracking system. Ex-2010, ¶169. There was a demonstrable customer need for such a system, which was heavily touted by CalAmp about its infringing LMU products. Ex-2014, ¶¶28-35. Mr. Tregillis recognized that testimony from two separate CalAmp engineers—during litigation where CalAmp (like GeoTab) attacked the validity of the ‘278 *Patent*—confirmed such features drove demand for the infringing products and that the lack of such features reduced the value of the products. Ex-2014, ¶¶38-41. In particular, CalAmp’s director of system engineering and technology, who was involved in developing the infringing CalAmp units, confirmed there was a market need for the infringing products, because it provided for simple installation and enhanced capability. Ex-2014, ¶40-41, citing to Ex. 2005, 40:20-41:3, 46:25-48:19. The technology in the ‘278 *Patent* avoided the need to have multiple SKUs (stock keeping units), thus it was a sales-driven request of customers to reduce the number of units needed by installers, as noted by another engineer of CalAmp. Ex-2010, ¶170, citing Ex. 2005 40:6 – 41:3; Ex-2014, ¶41. Alternatively, without the patented ‘278 *Patent* technology, a vehicle tracking device would have limited value because of the need to stock far more vehicle specific products, increasing the expense, the number of products, and the required stocking levels of such products. Ex-2010, ¶171, citing to Ex. 2004, 46:25–48:19; Ex-2014, ¶41.

e) *Nexus for Secondary Considerations of Non-Obviousness*

In the first trial between the Patent Owner and CalAmp, the Jury held each of the asserted patents, including the '278 *Patent*, not invalid. They identified the evidence of secondary considerations as to all asserted patents, including the '278 *Patent*. All of the factors expressly identified by the jury for purposes of their validity decision related to the '278 *Patent*. In the second CalAmp trial, other than a single infringing unit of a different patent, all 917,000+ units sold by CalAmp for which damages were awarded infringed the '278 *Patent*, showing the customer need was specific to the '278 *Patent*. Ex-1028.

Further, Mr. Tregillis noted the lack of design arounds available specifically for the technology in the '278 *Patent*. In reaching his opinions, Mr. Tregillis relied testimony from a CalAmp engineer, who confirmed CalAmp was unable to find a design around. Ex. 2014, ¶¶43-44, citing to Ex-2005, 46:25-47:19. This testimony was reinforced by an e-mail sent by a CalAmp representative (Galin Chen) to CalAmp's outside patent counsel (David Bailey), admitting "[claim] 13 [of the '278 *Patent*] may relate to how we program a unit at the factory so it may be harder to avoid." Ex-2014, ¶44, citing to Ex-2015. As such, these secondary considerations were directly tied to the '278 *Patent*. Patent Owner submits that rarely does evidence get considered this many times and by such a variety of tribunals. Ex-2010, ¶211. The evidence of secondary considerations here should be fully considered consistent

with the previous determinations of this Board and other tribunals. Ex-2010, ¶211. And when the evidence of secondary considerations is properly considered, the evidence clearly supports a finding of non-obviousness. Ex-2010, ¶212.

B. Claim 4

Section VI.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 Section VI.A.2 above, dependent Claim 4 is also patentable. Ex-2010, ¶172.

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 Section VI.A.2 above, dependent Claim 5 is also patentable. Ex-2010, ¶173.

D. Claim 6

Section VI.A.2 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 Section VI.A.2 above, dependent Claim 6 is also patentable. Ex-2010, ¶174.

E. Claim 8

Section VI.A.2 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 Section VI.A.2 above, dependent Claim 8 is also patentable. Ex-2010, ¶175.

F. Claim 11

Section VI.A.2 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 Section VI.A.2 above, dependent Claim 11 is also patentable. Ex-2010, ¶176.

G. Claim 12

Section VI.A.2 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 Section VI.A.2 above, dependent Claim 12 is also patentable. Ex-2010, ¶177.

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. Ex-2010, ¶178. Dependent Claims 19 and 21 are also patentable for at least the reasons set forth above in Section VI.A.2 above. Ex-2010, ¶179.

VIII. 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. Ex-2010, ¶180. 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. Ex-2010, ¶181. 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. Ex-2010, ¶182. 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; Ex-2010, ¶183.

A. *Flick885*

Flick885 (Ex-1024) was described in the Background of the Invention section of '278 *Patent* and cited by Patent Owner during prosecution of the '278 *Patent*. Ex-1002; Ex-2010, ¶184. 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; Ex-2010, ¶185. 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 Ex-2010, ¶185. The bus interface interfaces using proper signal levels and formats on the data communications bus. *Flick885*, 6:35-40; Ex-2010, ¶185.

Flick460, like *Flick885* was also cited in the prosecution of the '278 *Patent*, described in the background section of the '278 *Patent*, and considered by the Examiner. '278 *Patent*, 2:25-29; Ex-2010, ¶186. *Flick460* is directed to a vehicle security system for a vehicle having a data communications bus. Ex-2010, ¶186. *Flick460*, abstract.

B. The Claims of the ‘278 Patent are Not Obvious Based on the Combination of Flick885 and Hunt

1. A POSA Would Not Combine Flick885 with Hunt

Once again, the Petitioners attempt to fill in the missing teachings to arrive at the challenged claims using hindsight, but a POSA would not combine *Flick885* with *Hunt*. Petition 50-51, *Miller* ¶¶365-367; Ex-2010, ¶187, 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; Ex-2010, ¶188. *Hunt* is directed to the monitoring of a vehicle, particularly, for analyzing a vehicle’s GPS and diagnostic data, but does not address ongoing compatibility with different vehicles since *Hunt* discloses protocol modules being embodied in an ASIC. *Hunt* 2:23-25, 4:11-27, 9:18-45; Ex-2010, ¶189; see, e.g., VI.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 is nothing more than a conclusion that a POSA would turn to *Hunt* simply to make *Flick885* better, but Petitioners’ declarant’s statement fails to explain why a POSA would have combined the specific elements to arrive at the challenged claims. Ex-2010, ¶190-191; *ActiveVideo Networks*, 694 F.3d, at 1328.

The Board turned to *Dystar* to support the position that making something “better” is acceptable as a motivation for combining references. Decision, 47; citing

Dystar Textilfarben GmbH v. C.H. Patrick Co., 464 F.3d 1356, 1365 (Fed. Cir. 2006). The Board oversimplifies *Dystar*, which held that implicit motivation to combine exists ... when the “improvement” is technology-independent **and** the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. *Id.*, emphasis added. According to *Dystar*, in this case where the “improvement” is technology dependent, a technical rationale is required, but simply uttering the terms “desirable” or “better” is not sufficient. Importantly, there is no evidence to support that combination of *Hunt* with *Flick885* will make a stronger, cheaper, faster, more durable, or more efficient device. A POSA would understand that at the time of the invention adding GPS would make the device slower, as more processing power would be required at a time when processing power, particularly in real-time, was severely limited. Ex-2010, ¶192. There is no evidence as to obtaining “any and all advantages” of *Hunt* as they relate to *Flick885*. A combination of *Flick885* and *Hunt* can only be achieved through the use of improper hindsight. Ex-2010, ¶193.

Indeed, if the present inventor of the ‘278 *Patent*, Mr. Flick, did not come up with adding GPS until the ‘278 *Patent* (noting that there are over 100 patents in which Mr. Flick is an inventor), then how could a POSA come up with it without the benefit of hindsight? Ex-2010, ¶194. If the claims of the ‘278 *Patent* are obvious

simply with a reference that discloses the use of GPS for tracking, then any of the Examiners during examination or numerous challenges since would have made such a rejection. Ex-2010, ¶195. GPS was disclosed in the prior art considered by the Examiner and/or the Board, but there has never been a finding that simply disclosing GPS led to obviousness. *See, e.g.*, U.S. Patent No. 7,366,892 to Spaur et al. (Ex-2009); U.S. Patent No. 5,515,043 (Ex-2012); U.S. Patent No. 6,628,233 (Ex-2013); U.S. Patent No. 6,611,740 to Lowrey (Ex-1059); and U.S. Patent No. 6,636,790 to Lightner (Ex-2001). The cited and considered documents in the ‘278 *Patent*, and its prosecution history and challenges, are replete with GPS references. Ex-2010, ¶196; Ex-1001. Yet, the Examiner issued the ‘278 *Patent*. *Id.*

Now, years later, Petitioners want the Board to determine the Examiner was wrong to issue the ‘278 *Patent*, despite the many GPS references. 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*, 679 F.3d at 1378; emphasis added).

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 because it is conclusory and lacks a technical rationale. *ActiveVideo Networks*, 694 F.3d at 1328;

KSR 550 U.S. at 418; *Personal Web Tech*, 848 F.3d at 992-994; MPEP §2143, Ex-2010, ¶197.

The Board agreed with the Petitioners that *Hunt* teaches “many advantages” and that this is a proper impetus for combining *Flick ‘885* and *Hunt*. Decision, 46, citing Ex. 1023, 4:12. However, a careful reading of *Hunt* acknowledges that the term “many advantages” refers to the ability to characterize vehicle performance in near real time by analyzing real time transmission of GPS and diagnostic data, followed by analysis and display of these data using an Internet-hosted website. Ex-2010, ¶198; *Hunt*, 4:12-18. In other words, it is not the GPS that provides the “many advantages” but rather the ability to present the acquired data via the Internet and in real-time. *Id.* There is no evidence to show that the desire to add GPS from *Hunt* to the *Flick885* existed in the art. Ex-2010, ¶199. The adoption of the problem that GPS provides “many advantages” in terms of the solution (i.e., adding GPS) weighs heavily in favor of the prohibited use of hindsight. Ex-2010, ¶198; *Insite Vision*, 783 F.3d at 859. Accordingly, a POSA would not combine *Flick885* with *Hunt* and any combination would be improper for these reasons alone. Ex-2010, ¶198.

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

Evidence of secondary considerations must be evaluated when considering obviousness. *Graham v. John Deere Co.*, 383 U.S. at 17-18 . As noted by the Federal

Circuit in *Mintz v. Dietz*, the following helpful guidance is provided with respect to the objective criteria of secondary considerations:

[t]hese objective criteria thus help turn back the clock and place the claims in the context that led to their invention. 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. For these reasons, this court requires consideration of these objective indicia because they “provide objective evidence of how the patented device is viewed in the marketplace, by those directly interested in the product.”

679 F.3d at 1378, emphasis added, internal citations omitted.

Mintz further provides:

[i]ndeed, where the invention is less technologically complex, 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.

Id. at 1379; emphasis added.

As noted above, evidence of secondary considerations of nonobviousness specific to the ‘278 *Patent* has already considered and relied on by this Board, 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); Ex-2010, ¶200. 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. Ex-2010, ¶201. Petitioners suggest slapping GPS functionality 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, does not given proper weight to the evidence of secondary considerations, and instead relies on improper hindsight analysis. Ex-2010, ¶202; *Mintz v. Dietz*, 679 F.3d at 1379). As set forth herein, supported by considerable evidence of secondary considerations, the claims are patentable over *Flick885* and *Hunt*.

C. Claims 2-12

Section VIII.B 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 Section VIII.B above, dependent Claims 2-12 are also patentable. Ex-2010, ¶203.

D. Claim 13

Independent Claim 13 includes subject matter from independent Claim 1 and dependent Claim 3. Section VIII.B above, explains 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. Ex-2010, ¶204.

E. Claims 14-17

Dependent Claims 14-17 recite subject matter similar to dependent Claims 6-9. Ex-2010, ¶205. Section VIII.B 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 Section VIII.B above, dependent Claims 14-17 are also patentable. Ex-2010, ¶205.

F. 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 Section VIII.B above, independent Claim 18 is also patentable over the combination of *Flick885* and *Hunt*. Ex-2010, ¶206.

G. Claims 19-22

Dependent Claims 19-22 recite subject matter similar to dependent Claims 6-9. Ex-2010, ¶207. Section VIII.B above, explained 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 Section VIII.B above, dependent Claims 19-22 are also patentable. Ex-2010, ¶207.

IX. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that the challenged claims would have been obvious. Petitioner failed to meet its statutory burden of demonstrating unpatentability by a preponderance of the evidence pursuant to 35 U.S.C. §316(e), and patentability of the challenged claims should accordingly be confirmed.

Dated: October 18, 2023

Respectfully submitted,

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

Pursuant to 37 C.F.R. §42.120, the undersigned hereby certifies that the foregoing Patent Owner's Response Under 37 C.F.R. §42.24 contains 13,700 words, excluding the parts of this Response that are exempted under 37 C.F.R. §42.24, 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 Response under 37 C.F.R. §42.105, and Exhibits 2010 through 2022, are being served on October 17, 2023, by electronic mail at the following email addresses of record for the Petitioners:

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Dated: October 18, 2023

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