

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB USA, INC. AND GEOTAB, INC.,

Petitioner,

v.

OMEGA PATENTS, LLC,

Patent Owner.

IPR2023-00504
Patent 8,032,278 B2

Before BARRY L. GROSSMAN, AMBER L. HAGY, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On November 6, 2023, counsel for Patent Owner contacted the Board via email requesting removal of Paper 18 and Exhibits 2023 and 2024 from the record of the above-referenced proceeding. Ex. 3001.¹ Paper 18 is titled “Patent Owner’s Notice of Filing Supplemental Evidence Pursuant to 37 C.F.R. § 42.64(b)(1).” Exhibit 2023 is titled “Declaration of Kenneth E. Flick,” and Exhibit 2024 is titled “Omega Royalty Report (April 2023).” Patent Owner’s email stated that, “[o]nce removed, the Patent Owner plans to file a notice of service of the same evidence rather than filing such evidence at this time.” *Id.*

To more clearly understand Patent Owner’s request, the Board held a conference call between the panel and counsel for the parties on November 9, 2023. No court reporter was on the call. Counsel for Patent Owner explained that it meant to respond to Petitioner’s Objections to Evidence Served with Patent Owner’s Response (Paper 17) by serving on Petitioner (rather than filing with the Board) the information contained in Exhibits 2023 and 2024 as supplemental evidence pursuant to 37 C.F.R. § 42.64(2). In response to the Board’s questions about the confidentiality of information contained in those Exhibits, counsel for Patent Owner confirmed that the information is public and no measures to restrict access to that information are necessary at this time. Finally, counsel for Petitioner stated that Petitioner does not oppose the expungement of Paper 18 and Exhibits 2023 and 2024.

¹ The email refers to Exhibit 2023 twice. We consider this to be a typographical error meant to refer to Exhibit 2023 and Exhibit 2024.

Upon consideration of the record and the parties' respective representations during the conference call, we grant Patent Owner's request to expunge Paper 18, Exhibit 2023, and Exhibit 2024 from the record of this proceeding. Patent Owner may serve the information contained in former Exhibits 2023 and 2024 on Petitioner as supplemental evidence under 37 C.F.R. § 42.64(2). To the extent the time period for service of supplemental evidence has passed,² we waive that requirement of 37 C.F.R. § 42.64(2). *See* 37 C.F.R. § 42.5(b) ("The Board may waive or suspend a requirement of parts 1, 41, and 42 . . ."). Patent Owner may provide service on Petitioner within five business days of this Order.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Paper 18, Exhibit 2023, and Exhibit 2024 are hereby expunged; and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.64(2), Patent Owner may serve the information contained in former Exhibits 2023 and 2024 on Petitioner as supplemental evidence within five (5) business days of this Order.

² The supplemental evidence rule requires service "within ten business days of service of the objection." 37 C.F.R. § 42.64(2).

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