

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.

Case No. IPR2023-00504
Patent No. 8,032,278

PETITIONERS' SECOND UPDATED MANDATORY NOTICES

Petitioners Geotab USA Inc. and Geotab Inc hereby make the following updates to their Mandatory Notices.

I. REAL PARTY-IN-INTEREST

[No Change.]

Petitioners are the real parties-in-interest.

II. RELATED MATTERS

A decision in this proceeding could affect or be affected by the following matters. The matters identified in Sections II.B-II.G each involve or involved U.S. Patent No. 8,032,278.

A. United States Patent & Trademark Office

U.S. Patent No. 8,032,278 (Ex. 1001, “the ’278 patent”) issued from U.S. Patent Application No. 11/773,272, which is a continuation-in-part of U.S. Patent Application No. 11/076,259 (U.S. Patent No. 7,720,597), which is a continuation of U.S. Patent Application No. 10/383,496 (U.S. Patent No. 7,149,623), which is a continuation of U.S. Patent Application No. 09/859,972 (U.S. Patent No. 6,606,561), which claims priority to U.S. Provisional Application Nos. 60/264,811, 60/258,005, 60/251,552, 60/252,125, 60/236,890, 60/246,463 [sic], 60/222,777, 60/205,178.¹

¹ The ’278 patent priority claim to U.S. Provisional App. No. 60/246,463 appears to be a typographical error that should refer to App. No. 60/246,436. Ex. 1014, 6n.3

U.S. Patent No. 8,032,278 was involved in the following Re-Examinations:

- (i) Re-Examination Serial No. 90/013,587, filed September 14, 2015
- (ii) Re-Examination Serial No. 90/013,851, filed October 28, 2016
- (iii) Re-Examination Serial No. 90/014,309, filed May 24, 2019
- (iv) Re-Examination Serial No. 90/014,419, filed December 16, 2019
- (v) Re-Examination Serial No. 90/014,675, filed February 16, 2021

In Re-Examination Serial No. 90/014,419 (“RX4”), the request identified substantial new questions of patentability (“SNQP”) for all claims based on (1) non-statutory obviousness-type double patenting, and (2) obviousness in view of U.S. Patent No. 5,719,551 (“Flick-551”) over any one of six references—e.g., “in combination with any one of Brinkmeyer, Monroe, Drori, the Space Daily Trimble article, the Mateja article, and the Holusha article.” EX1008, 38-39.

On January 27, 2020 the Office denied the RX4 request.

On July 27, 2023, in response to a petition, the Office granted the RX4 request for the SNQP involving statutory obviousness over Flick-551.

(“The Office notes that the serial number of this provisional application [60/246,463] contains a typographical error; the provisional application presumably intended in the priority claim was actually 60/246,436.”).

On January 2, 2024, the Office issued a Notice of Intent to Issue a Reexam Certificate. The Office confirmed patentability of all claims over the RX4 request's obviousness combinations involving Flick-551.

B. United States Patent Trial and Appeal Board

Verizon Connect, Inc. v. Omega Patents, LLC, IPR2023-01162.

C. U.S. District Court for the Delaware

Omega Patents asserted the '278 patent against Petitioners in these actions (collectively "the Litigation"):

- *Omega Patents, LLC v. Geotab USA, Inc.*, Case No. 1:22-cv-01044-WCB (D. Del.)
- *Omega Patents, LLC v. Geotab, Inc.*, Case No. 1:23-cv-00382-WCB (D. Del.)

Omega Patents originally filed No. 1:22-cv-01044-WCB against Geotab USA, Inc. and Geotab, Inc. On March 10, 2023, the district court dismissed Geotab, Inc. for improper service. On April 4, 2023, Omega Patents filed No. 1:23-cv-00382-WCB against Geotab, Inc. On August 1, 2023, the district court stayed both actions pending final written decision in IPR2023-00504, without having consolidated the cases.

D. U.S. District Court for the Northern District of Georgia

Omega Patents asserted the '278 patent in these actions:

- *Omega Patents, LLC v. Enfora, Inc.*, Case No. 1:13-cv-00646 (N.D. Ga.)
- *Omega Patents, LLC v. Enfora, Inc.*, Case No. 1:17-cv-02769 (N.D. Ga.).

E. U.S. District Court for the Middle District of Florida

Omega Patents asserted the '278 patent in these actions:

- *Omega Patents, LLC v. CalAmp Corp.*, Case No. 6:13-cv-01950 (M.D. Fla.)
- *Omega Patents, LLC v. DEI Holdings, Inc.*, Case No. 6:20-cv-00693 (M.D. Fla.)
- *Omega Patents, LLC v. Verizon Connect, Inc. f/k/a Verizon Telematics, Inc.*, Case No. 6:22-cv-02371 (M.D. Fla.).

F. U.S. District Court for the Western District of Washington

Omega Patents asserted the '278 patent in: *Omega Patents LLC v. Firstech LLC*, Case No. 2:20-cv-01344 (W.D. Wash.).

G. U.S. Court of Appeals for the Federal Circuit

These appeals involved the '278 patent:

- *Omega Patents, LLC v. CalAmp Corp.*, Case No. 18-1309
- *Omega Patents, LLC v. CalAmp Corp.*, Case No. 20-1793
- *Omega Patents, LLC v. CalAmp Corp.*, Case No. 20-1794

III. LEAD AND BACKUP COUNSEL

[No Change.]

Lead Counsel: Adam R. Wichman, Registration No. 43,988

Backup Counsel: Richard F. Giunta, Registration No. 36,149

IV. SERVICE INFORMATION

[No Change.]

Petitioners consent to electronic service of all documents to the below email addresses:

Email: AWichman-PTAB@WolfGreenfield.com
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Respectfully submitted,
Geotab USA, Inc. and Geotab, Inc.

Date: January 8, 2024

/Adam R. Wichman/

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on January 8, 2024, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Patent Owner, upon the following:

Ryan T. Santurri
Christopher F. Regan
David S. Carus

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Date: January 8, 2024

/MacAulay Rush /
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