

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 SUR-REPLY IN
RESPONSE TO PETITIONERS' REPLY IN
SUPPORT OF ITS PETITION**

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<i>WBIP, LLC v. Kohler Co.</i> , 829 F.3d 1317 (Fed. Cir. 2016)	17

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35 U.S.C. §102	9
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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> ")
1021	<i>Omega Patents, LLC v. CalAmp Corp.</i> , 13 F.4th 1361 (Fed. Cir. 2021) (" <i>CalAmp-IP</i> ")
1022	D.I. 14, Omega Patents Answering Brief In Opposition to Geotab USA, Inc.'s Motion to Dismiss, <i>Omega Patents, LLC v. Geotab USA, Inc. and Geotab, Inc.</i> , No. 1:22-cv-01044-CFC (D. Del. Nov. 16, 2022)
1023	U.S. Patent No. 6,957,133 (" <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)
1030	D.I. 309, Jury Instructions, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 30, 2019)
1031	Y. Park and A. Fumiyuki, eds. <i>Enhanced Radio Access Technologies For Next Generation Mobile Communication</i> . Dordrecht: Springer, 2007.
1032	F. Delli Priscoli and M. Neri, “Integration of the ORBCOMM satellite network with the GSM Short Message Service.” <i>Space Communications</i> , Vol. 19, no. 1, pp. 47-57, 2003.
1033	D.I. 180, Transcript, Civil Jury Trial–Day 3, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 18, 2016)
1034	Pages from D.I. 181, Transcript, Civil Jury Trial–Day 4, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 19, 2016)
1035	<i>RESERVED</i>
1036	<i>RESERVED</i>
1037	<i>RESERVED</i>
1038	<i>RESERVED</i>
1039	Pages from D.I. 338, Transcript, Civil Jury Trial–Day 2, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 24, 2019)
1040	Pages from D.I. 339, Transcript, Civil Jury Trial–Day 3, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 25, 2019)
1041	<i>RESERVED</i>
1042	<i>RESERVED</i>
1043	<i>RESERVED</i>
1044	Comparison of limitations in ’278 patent claims 13-22 with limitations in ’278 patent claims 1-12
1045	U.S. District Court – Judicial Caseload Profile for the District of Delaware, <i>available at</i> https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0630.20

	22_0.pdf (last visited December 19, 2022)
1046	Title 40 Code of Federal Regulations, Part 86, Subpart S—General Compliance Provisions for Control of Air Pollution From New and In-Use Light Duty Vehicles, Light-Duty Trucks, and Complete Otto-Cycle Heavy-Duty Vehicles (July 1, 2007)
1047	SAE J1939-71 Vehicle Application Layer (rev. DEC2004)
1048	SAE J1708 Serial Data Communications Between Microcomputer Systems in Heavy-Duty Vehicle Applications (rev. AUG2004)
1049	<i>RESERVED</i>
1050	International Standard ISO 15031-4 Road Vehicles—Communication between vehicle and external equipment for emissions related diagnostics—Part 4: External test equipment (1st ed. June 15, 2005) (“ISO 15031-4:2005”)
1051	Pages from Microsoft Internet & Networking Dictionary (2003)
1052	SAE J1978 OBD-II Scan Tool – Equivalent to ISO/DIS 15031-4: December 14, 2001 (revised 2002-04)
1053	Pages from IEEE 100 The Authoritative Dictionary of IEEE Standard Terms (7th Ed. 2000)
1054	D.I. 265, Federal Circuit Mandate, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. July 1, 2019)
1055	D.I. 392, Order Dismissing With Prejudice, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. June 16, 2022)
1056	U.S. Patent No. 8,856,266 B2
1057	U.S. Patent Application Publication No. US 2005/0032511 A1
1058	U.S. Patent Application Publication No. US 2004/0138790 A1
1059	U.S. Patent No. 6,611,740 to Lowrey
1060	U.S. Patent No. 7,209,813
1061	<i>RESERVED</i>
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1064	U.S. Patent No. 7,617,727
1065	D.I. 145-85, PL104, 4/15/2015 Expert Report of Joseph C. McAlexander, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1066	13 Cal. Code Reg. §1968.2 Malfunction and Diagnostic System Requirements—2004 and Subsequent Model-Year Passenger Cars, Light-Duty Trucks, and Medium-Duty Vehicles and Engines (2004)

1067	February 19, 2007 Internet Archive capture of startech.com webpage on computer cables at https://web.archive.org/web/20070219050320/http://www.startech.com/Product/Category.aspx?WCID=7&WCLID=2&MLID=2&menu=1&from=more&c=US
1068	D.I. 145, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1069	<i>RESERVED</i>
1070	Control of Air Pollution From New Motor Vehicles and New Motor Vehicle Engines; Modification of Federal On-Board Diagnostic Regulations for: Light-Duty Vehicles, Light-Duty Trucks, Medium Duty Passenger Vehicles, Complete Heavy Duty Vehicles and Engines Intended for Use in Heavy Duty Vehicles Weighing 14,000 Pounds GVWR or Less; Extension of Acceptance of California OBD II Requirements, 68 Fed. Reg. 35792 (June 17, 2003)
1071	SAE J1850 Class B Data Communications Network Interface, Rev. 2001-05 (May 2001)
1072	ISO 15765-4:2005(E) Road vehicles – Diagnostics on Controller Area Networks (CAN) – Part 4: Requirements for emissions-related systems (1st ed. ISO January 15, 2005)
1073	ISO 15031-5:2006(E) Road vehicles — Communication between vehicle and external equipment for emissions-related diagnostics — Part 5: Emissions-related diagnostic services (ISO 1st ed. January 15, 2006)
1074	ISO 14230-4 Road vehicles — Diagnostic systems — Keyword Protocol 2000 —Part 4: Requirements for emission-related systems (ISO 1st ed. June 1, 2000)
1075	SAE J1979 (R) E/E Diagnostic Test Modes – Equivalent to ISO/DIS 15031-5:April 30, 2002 (April 2002)
1076	SAE J2178-1 Class B Data Communication Network Messages— Detailed Header Formats and Physical Address Assignments (reaffirmed July 2004).
1077	D.I. 10, Geotab USA, Inc.’s Opening Brief In Support Of Motion To Dismiss, <i>Omega Patents, LLC v. Geotab USA, Inc. and Geotab, Inc.</i> , No. 1:22-cv-01044 (D. Del. Nov. 2, 2022)
1078	SAE J2178-4 Class B Data Communication Network Messages— Message Definitions for Three Byte Headers (reaffirmed July 2004).
1079	Pages from Title 40 Code of Federal Regulations, Part 86, Subpart S— General Compliance Provisions for Control of Air Pollution From New and In-Use Light Duty Vehicles, Light-Duty Trucks, and Complete Otto-

	Cycle Heavy-Duty Vehicles (July 1, 2014)
1080	Pages from Collins English Dictionary (5th ed. 2000)
1081	Pages from Newton’s Telecom Dictionary (2005)
1082	ISO 14230-2 Road vehicles—Diagnostic systems—Keyword Protocol 2000 – Part 2: data link layer (1st ed. Mar. 15, 1999)
1083	<i>RESERVED</i>
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1087	<i>RESERVED</i>
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1090	D.I. 145-80, PL99, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1091	D.I. 145-54, PL68, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1092	D.I. 145-53, PL67, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1093	D.I. 145-67, PL81, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1094	D.I. 145-42, PL45, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1095	D.I. 145-57, PL71, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1096	D.I. 145-68, PL82, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1097	D.I. 145-69, PL83, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1098	D.I. 145-70, PL84, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1099	D.I. 145-73, PL88, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1100	D.I. 145-74, PL90, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1101	D.I. 145-75, PL92, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1102	D.I. 145-76, PL93, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)

1103	D.I. 145-77, PL96, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1104	D.I. 145-79, PL98, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1105	D.I. 145-81, PL100, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. Feb 25, 2016)
1106	D.I. 145-83, PL102, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. Feb 25, 2016)
1107	D.I. 145-84, PL103, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. Feb 25, 2016)
1108	D.I. 145-88, PL141, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1109	D.I. 145-55, PL69, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1110	D.I. 145-71, PL85, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1111	D.I. 145-72, PL86, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1112	D.I. 145-82, PL101, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
1113	D.I. 145-78, PL97, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2001	U.S. Patent No. 6,636,790 to Lightner
2002	Declaration of Mr. Joseph C. McAlexander, III
2003	Curriculum Vitae of Mr. Joseph C. McAlexander, III
2004	D.I. 297-1, Deposition of Galin Chen, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2005	D.I. 297-4, Deposition of Peter Hergesheimer, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2006	D.I. 297-5, Deposition of Stephen Hall, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2007	D.I. 39, Defendant CalAmp Corp’s Opening Claim Construction Brief, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 5, 2014)
2008	Intent to issue Reexamination Certificate, mailed on April 14, 2023, in 90/014,675 (RX5)
2009	U.S. Patent No. 5,732,074 to Spaur et al.
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)
2018	D.I. 145-34, PL18, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
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)
2023	<i>RESERVED</i>
2024	<i>RESERVED</i>
2025	Transcript, Deposition of Jeffrey Miller, Ph.D. (February 29, 2024)
2026	Errata to Transcript, Deposition of Jeffrey Miller, Ph.D. (February 29, 2024)

Petitioners continue arguing that *Hunt* is somehow unique and unlike any other prior art ever considered despite the multiple reexaminations and litigations. Petitioners argue that *Hunt* alone either anticipates or renders obvious some of the claims the '278 *Patent*, and that *Hunt* in combination with *Flick885* renders obvious all the claims because, unlike previous challenges, *Hunt*, nor any reference like it, was considered. (Reply, 1.) Petitioners have now had an opportunity to present their own evidence and argument to rebut Omega's evidence, but Petitioners have presented no such rebuttal evidence. Rather, Petitioners have only offered unsupported and conclusory attorney arguments, attempting to discredit Omega's strong factual evidence of secondary considerations.

Also notably absent from Petitioners' Reply is an acknowledgement that the Patent Office's Central Reexamination Unit (CRU), which includes highly qualified and trained patent examiner panels, not only considered this *Inter Partes* Review (IPR), but expressly considered the *Hunt* and *Flick885* prior art references when confirming, yet again, the patentability of the claims of the '278 *Patent*. Paper 24. That same CRU panel has issued a reexamination certificate. Paper 31. That is because *Hunt* is like multiple other references considered before, while the strong secondary considerations evidence weighs heavily in favor of patentability. Here, as there, the claims of the '278 *Patent* should be confirmed patentable.

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

As an initial matter, Omega notes that Petitioners concede that *Hunt* fails to anticipate Claims 2, 3, 7, 9-10, 13-17, 20, and 22. Thus, Petitioners concede that *Hunt* fails to disclose wired downloading interfaces specifically recited in dependent Claim 2, and a connector for temporary connection to a downloading device (Claims 3, 13). Petition 6, 67; Ex-2010, ¶52. Moreover, the Patent Office has already considered *Hunt* as an anticipatory reference, and with respect to this IPR, found all claims of the '278 *Patent* patentable. Paper 24. In other words, the Patent Office has already determined that *Hunt* does NOT anticipate the claims of the '278 *Patent*. *Id.*

A. *Hunt's* Vehicle Device Codes

Hunt fails to expressly disclose the term “device codes.” Ex-2025, 81:18-25; Ex-1123, 146:11-15. Thus, despite Petitioners’ expert testimony, *Hunt's* ASIC may generate device codes. *Id.* Petitioners’ expert testified that *Hunt* does not disclose generating a device code in an ASIC, and argues that *Hunt* discloses generating device codes, just not by the ASIC. Ex-1115, 79. To make this argument, he mischaracterizes Omega’s expert, who did not just say that *Hunt* does not describe the ASIC generating device codes, but instead that *Hunt* does not even identify device codes (whether in the ASIC or elsewhere). Ex-1123, 146:11-15. In other words, *Hunt* is silent as to where device codes are generated. *Hunt* leads the POSA to conclude that vehicle device codes are fixed and generated by or in the ASIC by

way of the communications modules 25a-e. POR, 18-19 citing Ex-2010, 74-79.

If *Hunt* somehow does inform a POSA where device codes are stored or generated, a POSA should not be left guess. *Hunt* cannot be anticipatory if it does not disclose all the claim elements within its four corners. POR 26, citing *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, at 1369 (Fed. Cir. 2008). At best, if *Hunt* discloses generating device codes, it is in communications modules 25a-e. POR, 18-19 citing Ex-2010, 74-79.

B. *Hunt's* ASIC

There is no dispute that an ASIC's programming is fixed upon manufacture, and the Board agrees. Decision, 37; Ex-2025, 45:12-14. *Hunt's* custom ASIC includes a microcontroller 177 and a multiplexer 178 – components beyond physical layer circuitry. *Hunt*, FIG. 5, 8:46-65. The microcontroller 177 is NOT the microprocessor 27.¹ Petitioners' expert appears to be confused about the inclusion of a microprocessor within *Hunt's* ASIC – confusing the microcontroller 177 with the microprocessor 27. Reply, 25-26; Ex-1115, ¶¶69-73. Petitioners' expert's testimony is misleading, attempting to make the illogical connection that *Hunt's* ASIC is re-programmable post manufacture because it includes the microprocessor that *Hunt* discloses having firmware installed thereon. *Id.* This is wrong. *Hunt's*

¹ *Hunt* in Col. 3, lines 50-51, the summary, discloses that the ASIC includes a microprocessor. *Hunt* provides no reference numbers. However, a further review of *Hunt* would lead a POSA to conclude that *Hunt's* microprocessor 27 is not on the ASIC.

ASIC includes separate modules that support the communication protocols. These protocols cannot be changed without changing the ASIC. POR, 18, citing Ex-2010, ¶¶74-77. Petitioner’s expert acknowledges an ASIC is not reprogrammable. Ex-1125, 45:12-13.

Hunt describes the microprocessor determining the communications protocol of the host vehicle by testing each protocol to establish communications. The microprocessor 27 then selects the protocol that successfully communicated with the vehicle. *Hunt*, 9:4-8. One way of selecting the protocol is to determine the existence of electrical signals on certain output pins. *Hunt*, 9:8-16. The protocol selection may be communicated to the multiplexer 177 (on the ASIC) to select the appropriate communications module 25a-e. *Hunt*, 9:17-27.

Hunt expressly teaches the benefits of using an ASIC as reducing manufacturing costs and increasing reliability. *Hunt*, 4:39-41. *Hunt* expressly teaches that other fabrication techniques are undesirable, such as, for example, using discrete circuit components that are expensive, time-consuming to fabricate on a printed circuit board, and that tend to fail over time due to heat and vibration. *Hunt*, 4:41-46. Petitioners contend that the functions of the ASIC can be performed using transistors or conventional circuit elements – something other than an ASIC – which Petitioners contend is not required by the *Hunt*. Reply, 22-23; Ex-1115, 78, citing *Hunt*, 9:37-44. However, these are the same “elements” (i.e., discrete circuit

components) that *Hunt* expressly describes as undesirable. *Hunt* 4:41-46.

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

1. *Hunt* Does Not Download Enabling Data

Hunt does not download enabling data. As would be understood by a POSA at the time of the invention and in light of the specification, downloading does not mean transferring data between internal components. POR, 14-15, citing Ex-2010, 59-65. Petitioners insist that “[D]ownload means to transfer data,” citing to Ex-1051. Reply, 16. What Petitioners miss is the remainder of the definition of “download” from their Ex-1051 quote, which defines download as “to transfer a copy of a file from a remote computer to the requesting computer by means of a modem or network.” Ex-1051; emphasis added. Accordingly, any instructions from the microprocessor 27 to the ASIC cannot be downloading of enabling data via a downloading interface. POR, 15-16.

Hunt discloses both a microprocessor 27 separated from the ASIC and a microcontroller 177 on the ASIC that communicate via a data link 179. *Hunt*, 8:46-60. The microprocessor 27 selects the protocol that has successfully communicated with the vehicle and does so by communicating with the microcontroller 177 to operate the multiplexer 178. *Hunt*, 9:3-17. This is not downloading of enabling data. POR, 22-23.

The microprocessor 27 stores firmware. *Hunt*, 6:27. Firmware is basic instructions for specific hardware. POR, 23. *Hunt* discloses that with firmware, the microprocessor formats the diagnostic and location-based data into separate packets and transmits the packets through a universal modem adaptor 35. *Hunt*, 6:35-38. The firmware running on the microprocessor 27 recognizes the modem adaptor 35 so that the wireless appliance can be easily configured to operate on different wireless networks. *Hunt*, 6:59-65. This description of *Hunt*'s firmware is not enabling data and is not downloaded via a downloading interface. POR, 23.

2. There Is No Need For Downloading Of Enabling Data In Hunt

Since the protocol modules 25a-e of *Hunt* are not changeable within the ASIC, there is no need or desire to download enabling data. POR, 18. Even if *Hunt* somehow disclosed downloading of firmware to the microprocessor 27, this firmware would perform the operations of formatting data for wireless communication via the modem adaptor. POR, 18-21, 27-28. Moreover, the firmware that selects any communications would not change. POR, 28-29. The method by which each protocol is tested would not change regardless of the type or amount of protocol modules on the ASIC. *Id.*

3. Firmware Can Be Updated Without A Downloading Interface

Hunt's reference to firmware does not necessarily require updates to

firmware, and if updated, updated via a downloading interface. POR, 16, 23. Firmware can be updated by changing the microprocessor 27 or providing an additional integrated circuit. POR, 23. Petitioners concede that updating the firmware, let alone with enabling data, is not disclosed by *Hunt*, arguing “it would have been obvious to update the microprocessor’s firmware.” Reply, 19.² Nothing in *Hunt* discloses or suggests updating the firmware with enabling data from a downloading interface.

4. Boilerplate Cannot Save Hunt

Having conceded that *Hunt* fails to disclose a wired downloading interface, and struggling to locate any downloading interface in an attempt to anticipate selected claims of the ‘278 *Patent*, Petitioners rely on general purpose and inconsistent boilerplate language. POR, 24-27. When considering *Hunt* as a whole, the boilerplate cannot supply the critical deficiencies. POR, 25. Nine paragraphs of boilerplate in *Hunt* are riddled with alternative language, including this passage from *Hunt*: “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,

² In their anticipation arguments, Petitioners rely on another reference in attempt to show that updating firmware is routine. Reply 18-19. However, this is an obviousness argument relying on another reference to supply a missing element of *Hunt*. *Id.* Petitioners concede *Hunt* does not anticipate the claims, arguing that it would have been “obvious” to update the firmware. Reply, 19.

or as a software program loaded from *or* into a data storage medium as machine readable code.” (Emphasis Added). POR, 25, citing *Hunt*, 10:46-52. The above-noted passage can amount to thousands of permutations, none of which *Hunt* actually discloses, as this would seek to improperly broaden the scope of what *Hunt* conveys to a POSA. POR, 25-27. Column 11 of *Hunt* continues with these unworkable permutations, stating that “some” (unidentified) processes can be programmed during manufacture “or” later in time. *Hunt*, 11:5-32. This is not an express teaching of installing firmware including enabling data via a downloading interface as Petitioners contend. POR 25-27; Ex-1115, ¶26. How is a POSA to reconcile this passage or any of the “conditional language” of the *Hunt* boilerplate with what *Hunt* really invented? POR, 25-27. To anticipate under 35 U.S.C. §102, *Hunt*, like all references, 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. POR 25-26, citing *Net MoneyIn*, 545 F.3d at 1369. The Petitioners know that *Hunt* fails to do exactly this, and instead contend that “it would have been obvious to update the microprocessor’s firmware to support the new communications protocol hardware.” Reply, 19, citing Ex-1115, 30-31. This goes far beyond anything expressly disclosed in *Hunt*.

5. A Cellphone Cannot Be A Downloading Interface In *Hunt*

Petitioners double-down on their contention that *Hunt* discloses a cellphone

as a wireless downloading interface from among the laundry-list of devices in the boilerplate. POR, 30-31; Reply 20-21. Petitioners make the argument that since Bluetooth was known at the time of the invention, a POSA would have replaced the data link 179 between the microprocessor 27 and the ASIC 25 with Bluetooth transceivers coupled to both the microprocessor and the ASIC. Reply 20-21; Ex-2025, 71:18-72:8. Not only would this add costs and complexity to *Hunt*, which, by way of the ASIC, *Hunt* attempts to reduce, but it makes no logical sense since this would place the microprocessor and its functionality in someone's cellphone, which may or may not be in the vehicle. POA, 30-31; Reply 20 arguing that microprocessor 27 may be in a cellphone.

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

Having conceded that *Hunt* falls well short of being anticipatory for certain of the claims, Petitioners turn to a theory that *Hunt*, by itself, renders the Claims 1, 4-6, 8, 11-12, 18-19, and 21 of the '278 *Patent* obvious. POR, 35. A POSA, at the time of the invention of the '278 *Patent*, would not "fill in" the large gaps in *Hunt*, particularly with disjointed boilerplate. POR 35-44. The secondary considerations evidence, which MUST be considered in an obviousness determination, weigh heavily in favor of patentability. POR, 35, 44-53. The Patent Office agrees with Omega finding all the claims of the '278 *Patent* patentable upon considering not only *Hunt*, but the secondary considerations evidence weighing in favor of

patentability, and this IPR. Papers 24, 25 and 31.

A. POSA Would Not Modify *Hunt* In The Way Proposed By Petitioners

Petitioners contend that since updating firmware, for example, to fix bugs, was known, a POSA would have updated the firmware in *Hunt* similarly to address any bugs. Reply, 18-19. While updating firmware may generally be known, there is simply no relation between any potential firmware updating and the enabling data. POR, 36; see Section I.C above. The thousands of permutations derived from the *Hunt* general purpose boilerplate do not support a finding of obviousness. POR, 36-40. Petitioners contend that a POSA would supply an endless number of firmware patches to update the firmware with new capabilities or fix bugs. Reply, 18-19; Ex-1115, 26-29. This argument fails. Capabilities, as they relate to the contended enabling data cannot and would not be updated, as the protocols are fixed in the ASIC. POR, 35-43. Any added capabilities would likely be added to modem functionality, as disclosed by *Hunt*. POR, 39-40. It is not sufficient to contend that a software bug may exist, and, if it did, an update may be performed. POR, 35-43. Any reliance on the broad boilerplate to suggest that the boilerplate renders all permutations predictable and obvious is clearly an improper use of hindsight. POR, 41-42.

Petitioners misstate Omega's arguments with respect to changing the ASIC. Reply, 19. Should a POSA desire to change the ASIC to change the protocols, the

firmware that reads and selects the operational protocol would not change. POR, 36, 39. The way *Hunt* selects protocols would not change regardless of how many or which protocols are embodied in the ASIC. *Id.* That is, the POSA recognizes the benefits of the ASIC – that it can be swapped, and without the need for updating any firmware. POR, 36, 39-44. Indeed, Petitioners’ expert acknowledges that once an ASIC is manufactured, there is no download to fix a bug, but instead the entire ASIC must be replaced. Ex-1125, 70:10-17.

B. Strong Secondary Consideration Evidence Affirms Patentability

In its Reply, Petitioners attempt to pigeonhole the evidence of secondary considerations on one ground or another, when Omega has presented the evidence globally, applied to both Ground 2 and 3 for the same reasons. POR, p. 35, 60-62. As it did in the Patent Owner’s Response, Omega again addresses the issue of same evidence of secondary considerations globally, because it applies with the same force whether to Ground 2 or Ground 3.

In its Reply, Petitioners suggest the Board simply ignore the evidence, offering little more than unilaterally deeming its arguments as “strong” and contending secondary considerations are irrelevant. Yet the law requires consideration of secondary considerations in the obviousness analysis. *See, e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983) (“Thus evidence rising out of the so-called ‘secondary considerations’ must always when

present be considered en route to a determination of obviousness.”) Perhaps more importantly, Petitioners offer no evidence to rebut the significant evidence of secondary considerations offered by Omega. Petitioner’s expert witness (Dr. Miller) admitted that he did not consider the declaration of Christian Tregillis (Ex-2014) in forming his opinions in his reply declaration. Ex-2025, 25:10-26:18. Similarly, Dr. Miller’s declaration in support of Petitioner’s Reply expressly references only one obviousness issue with which he disagreed, but he admitted he did not consider numerous secondary considerations in forming the opinion. Ex-2025, 82:5-19, 84:23-85:16.)

1. The Evidence of Secondary Considerations Enjoys an Unrebutted Presumption of Nexus

Petitioners argue there is no nexus between the claims and secondary considerations. This argument is woefully off the mark. As set forth in the POR, a jury determined (and the Federal Circuit affirmed) that the CalAmp LMU-3000/3030/3050 products at issue in the Omega-CalAmp litigation infringed claims 1-6, 8, 11, 12-14, 16, 18, 19 and 21 of the ‘278 *patent*. Ex-1028. CalAmp touted the technology claimed in the ‘278 *patent*, including the multi-vehicle controller and the ability to perform GPS tracking functionality, which evidences the coextensive nature of the products with the claims. Ex-2014, ¶¶33-40. For example, the commercial requirements specification for the products expressly state the purpose of the product is coextensive with the claims. Ex-2014, ¶36; Ex-2018, p. 4, “OBD-

II product for a value added GPS tracking and cellular communication product”; Ex-2019, p. 5, “The LMU-3030 is a self-contained vehicle tracking and data monitoring unit. The product is capable of monitoring and communicating with the vehicle Engine Control Unit via the OBD II port to retrieve vehicle status and diagnostic data.” Mr. Tregillis also highlighted evidencing supporting a general market need for the infringing products, as supported by testimony from individuals involved in developing the infringing products, which was also supported by testimony that “sales-driven requests from customers” led to the combination of technologies in CalAmp’s infringing devices. Ex-2014, ¶¶40-41; Ex-2010, ¶170. Contrary to the unsupported attorney arguments of Petitioner, as noted in the Tregillis declaration, the need was for a combination of technologies, not discrete or unclaimed features already available separately. Ex-2014, ¶¶25, 27-29. The need for the combined technologies is also reflected in the fact that there was a recognition that there was no viable design around incorporating the tracking and data bus technologies. Ex-2014, ¶¶43-44. Ultimately, CalAmp enjoyed significant commercial success with the infringing units, selling 917,222 infringing products at the time of the verdict in the second trial, which were expressly tied to claims of the ‘278 *patent* at issue in

this proceeding³. Ex-2018, p. 6. Contrary to Petitioners’ argument, the evidence supports a finding that the infringing products are coextensive with the claims.

“We presume that such a nexus applies for objective indicia when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘embodies the claimed features, and is coextensive with them.’” *Polaris Indus. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018), quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000). With a nexus presumed, the Petitioners were required—but failed—to offer evidence to rebut the nexus. *See Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1393 (Fed. Cir. 1988).

This is not a case where the infringing product is not coextensive, such as where “the patented invention is only a component of a commercially successful machine or process.” *Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). All independent claims of the ‘278 *patent* recite “a multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle”—just like the infringing products. Ex-2014, ¶29 (with depictions of the OBD II tracking unit). Petitioners argue (without evidence)

³ Petitioners criticize the evidence of commercial success based on “blocking patents” it identifies as the *Flick885* and *Flick ‘727* patents. However, the jury did not award damages for any units of the *Flick885* patent (which was expired before the verdict), and separately awarded damages for a single unit under the ‘727 patent rather than all units at issue in the case. As such, Petitioners’ blocking patent theory is without merit.

that the infringing products “*include significant unclaimed features...*” Petitioner’s Reply, p. 6, emphasis original. Petitioners rely on the decision in *Fox Factory, Inc. v. SRAM, LLC*, arguing that the presence of unclaimed features precludes recognition of infringing products as coextensive with the claims. Petitioner’s Reply, p. 7. Yet this argument is directly contrary to the holding in *Fox Factory*, stating: “To be sure, we have never held that the existence of one or more unclaimed features, standing alone, means nexus may not be presumed.” *Fox Factory*, 944 F.3d 1366, 1374 (Fed. Cir. 2019).

In contrast to *Fox Factory*, where the Omega described certain unclaimed features as “critical,” there is no such evidence here. Rather, this case is more akin to *Polaris*, where the Federal Circuit confirmed that unrebutted evidence showing the claims are coextensive with the product establishes the presumption of a nexus. 882 F.3d at 1073. Directly relevant to Petitioner’s argument is that the Federal Circuit recognized “a patent challenger may rebut the presumption of nexus by presenting evidence to show that the commercial success was due to extraneous factors other than the patented invention such as additional unclaimed features and external factors.” *Id.* at 1072 (cleaned up). In other words, in the *Polaris* decision, the burden was on the challenger to establish commercial success related to unclaimed features. *Id.* Here, Petitioner’s expert ignored the Tregillis declaration and Petitioners offered no evidence to suggest the unclaimed features rebutted the

presumption of a nexus. Instead, Petitioners cited to a Federal Circuit opinion from the CalAmp litigation that focused instead on damages, long after defendant's validity challenge had been resolved in Omega's favor. Petitioner's Reply, p. 6. The fact that the Federal Circuit remanded the question of damages to develop the factual record further does not address whether the claims of the '278 *patent* are coextensive.

To be clear, while the infringing products included exactly what is claimed in the '278 *patent* along with other unclaimed features, Petitioners offer no evidence supporting the assertion that the infringing products included “***significant unclaimed features***.” Indeed, the express purpose of the infringing products, as recognized by the development documents themselves, was the combination of an “OBDII product for a value added GPS tracking and cellular communication product.” Ex-2018, p. 4. Petitioners cannot rely on attorney argument to establish facts contrary to the purpose of the infringing products as disclosed during development. A nexus for the commercial success, as well as the related recognition of customer need, market demand, and no viable work around, all tie directly to infringing products that are coextensive with the '278 *patent* claims at issue here.

Petitioners argue that the nexus “cannot turn on features known in the art,” citing *In re Kao*, 639 F.3d 1057, 1068-1069 (Fed. Cir. 2011). Petitioner's Reply, p. 7. However, the holding in *Kao* (quoted by Petitioner) related solely to unexpected

results, which would not be “unexpected” where already found in the prior art. *See id.* Instead, “there is no requirement that ‘objective evidence must be tied exclusively to claim elements that are not disclosed in a particular prior art reference in order for that evidence to carry substantial weight.’” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1331 (Fed. Cir. 2016). Petitioners’ arguments that the secondary considerations were known in the art should be disregarded as both unsupported by evidence and inconsistent with the law, which recognizes the claimed invention as a whole can provide proof of a nexus, as is evidenced from the secondary consideration evidence presented by Omega.

2. Other Board Decision On the ‘278 Patent

Petitioners argue Board decisions in regarding patentability of the ‘278 *patent* are “not *evidence*.” Petitioner’s Reply, p. 8. Omega has highlighted the fact that, in five separate reexaminations, the Patent Office has considered the patentability of the ‘278 *patent*. In several of those proceedings, evidence of secondary considerations was considered and relied on. While Petitioners have argued Board decisions that consider different art are irrelevant (*id.*), the most recent decision in *Ex Parte* reexamination, application 90/014,419, confirmed the patentability of the ‘278 *patent*, this time with express consideration of the ongoing IPRs and the combination of *Hunt* and the *Flick885* (Paper 24), and cited evidence of secondary

considerations in confirming the patentability of the ‘278 *patent*.⁴ Omega has defended the ‘278 *patent* time and again, but Petitioners request the Board disregard much of the same evidence recognized in numerous other proceedings that resulted in the confirmation of patentability.

3. Omega Identifies Relevant Evidence of Secondary Considerations

Petitioners attempt to parse the evidence and compartmentalize it between one ground or another, when in fact Omega presented a unified explanation of considerable evidence of secondary considerations. While Petitioners feign confusion and argue something more is required to evaluate the evidence presented, this ignores the evidence presented as a whole. Much of this evidence was identified and presented in the Omega-CalAmp litigation. As reflected in the Tregillis Declaration and the documents cited therein, CalAmp developed the products that infringed the ‘278 *patent*, for the purpose of the combination of an “OBDII product for a value added GPS tracking and cellular communication product,” just as claimed in the ‘278 *patent*. Ex-2014, ¶36; Ex-2018, p. 4. As recognized in the declarations

⁴ Petitioners filed the prosecution histories for all five reexaminations at EX1005-EX1009. However, as acknowledged by both parties in mandatory notices (Papers 24, 25 and 31), *Ex Parte* reexamination 4 (90/014,419) has continued. As noted in Papers 24, the Patent Office confirmed the patentability of the claims of the ‘278 *patent* over all art cited herein (as reflected in the IDS forms referenced therein), including ‘133 to *Hunt* and the *Flick* ‘885 patents. Paper 24. To the extent not already before this Board, Omega requests the Board take official notice of the proceedings referenced by both parties. *See, e.g., Data Engine Techs. LLC. V. Google LLC*, 906 F.3d 999, 1008 n. 2 (Fed. Cir. 2018) (prosecution histories are subject to judicial notice); FRE 201; 37 C.F.R. 42.62.

of McAlexander and Tregillis, the development was spurred by a market need for the infringing products, which provided a unified solution (avoiding multiple SKUs of units with limited market value) of multi-vehicle compatible tracking units that connected to the data bus. Ex-2014, ¶¶40-41, citing to Ex. 2005, 40:20-41:3, 46:25-48:19; Ex-2010, ¶¶170-171, citing Ex-2006 40:6 – 41:3. The evidence established no design around was identified, while CalAmp acknowledged claim 13 of the ‘278 *patent* as “harder to avoid” infringement, further supporting the recognition of this as evidence of secondary considerations. Ex-2014, ¶¶44, citing Ex-2005, 44:23-45:19, and Ex-2015. Ultimately, a jury tied the commercial success of 917,222 units of infringing products specifically to the ‘278 *patent*. Ex-1028.

Petitioners argue the features referenced in the evidence were “known” (Petitioner’s Reply, pp. 9-10), but offer no evidence to support such a contention beyond arguing that *Hunt* discloses these features. Importantly, it is evident from the Tregillis declaration (and evidence cited) that the fundamental issue was the development of a unitary device that performed the claimed functions, not simply the addition of one feature. Thus, Petitioners’ effort to highlight one feature or another is irrelevant. Moreover, as set forth in the POR (and herein above), *Hunt* does not disclose all elements, and, therefore, cannot establish such features were known. Indeed, Petitioners implicitly concede that *Hunt* does not disclose numerous claims found infringed by CalAmp’s products, including claims 2, 3, 13, 14 and 16,

because Petitioners have not asserted anticipation or obviousness by *Hunt* as to those claims. Petition, p. 5. Notably, claim 13, was the specific claim CalAmp acknowledged was harder to avoid. Ex-2015.

Petitioners argue that Omega-CalAmp verdicts (filed by Petitioners) are not relevant. Petitioners' Reply, p. 11-12. Both verdicts reflected findings that the CalAmp products discussed above infringe numerous claims of the '278 *patent*. Petitioners argue it is "incredible" that Omega relies on these verdicts, given that the second verdict was vacated and remanded for a third trial. *Id.* However, the salient points are (1) that juries awarded damages in recognition of the infringement, which was expressly tied to the '278 *patent* in the second trial, and (2) 917,222 units sold reflects the commercial success of the infringing products. Ex-1028. The Federal Circuit remanding for a new trial on the amount of damages does not establish the technology in the '278 *patent* was not valuable nor successful—only the particular dollar value for damages remained at issue for a third trial. *Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1382 (Fed. Cir. 2021).

Finally, Petitioners attack the findings of the jury on licensing and copying. Petitioners' Reply, pp. 12, 14-15. The '278 *patent* was included in various licenses encompassing multiple patents that generated more than \$70MM in royalties. Ex-2014, ¶¶18-20. Petitioners cite cases holding that where licenses encompass multiple patents, such evidence may be afforded less weight, but neither states such evidence

is to be disregarded. Moreover, as Mr. Tregillis pointed out in his deposition, when the '278 *patent* was the last patent in various licenses to expire, the same royalty rate remained (Ex-1124, 73:1-13), supporting the conclusion that value is reflected by the licenses. Similarly, while Petitioners argue the jury's findings of copying was untethered to any particular patent (Petitioners' Reply, p. 12), this ignores the evidence presented to the jury (and in these proceedings) referenced in the Tregillis declaration that CalAmp had no design alternatives and admitted it would be harder to avoid claim 13 of the '278 *patent*. Ex-2014, ¶44. The evidence of secondary considerations is well-documented and tied directly to the '278 *patent* multiple ways. As recognized by the Patent Office in a recent *ex parte* decision, this evidence overcomes an obviousness challenge relying on the art of Petitioners.

III. GROUND 3: CLAIMS 1-22 ARE NOT OBVIOUS OVER *HUNT*

Here too, the Patent Office has considered *Hunt*, *Flick885*, the volumes of evidence of secondary considerations, and this very IPR. Again, the Patent Office found all the claims of the '278 *Patent* valid citing as the reason for patentability, the secondary considerations evidence. *Id.* Nonetheless, the Petitioners contend that no secondary considerations evidence can support combining GPS with a vehicle controller because "Hunt taught doing so years before Omega filed the '278 patent." Reply, 1. The test for obviousness is not one that simply finds an element in the prior art for combination. POR, 57-62. Secondary considerations must be considered in

any obviousness determination. *Id.*

A. *Hunt* is Just Like the Already Considered Prior Art When Combined with Flick885

Hunt, much like the other prior art that has come before it challenging the ‘278 *Patent*, discloses GPS. POR, 57-59. To no one’s surprise, 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). *Id.* The cited and considered documents in the ‘278 *Patent*, and its prosecution history and challenges, are replete with GPS references. *Id.* Thus, it is also no surprise that the Patent Office recently affirmed the patentability of the claims of the ‘278 *Patent* considering *Hunt* in combination with *Flick885*. Paper 24.

B. *Hunt*’s “Advantages” Are No Different Than Any Other Previously Considered Reference

Petitioners rely on *Hunt*’s teaching of “advantages” of GPS. Reply, 2. The above noted laundry list of already considered prior art references inevitably are replete with the same “advantages”. POR, 58-60; See Section III.A above. Petitioners contend that the *Flick885* and *Hunt* combination is a predictable use of prior art elements. Reply, 2. But the above-noted GPS-disclosing references were

also considered. POR, 58-60. And still, Examiners and the Board continue to affirm that patentability of the claims of the ‘278 *Patent*, including specific consideration of *Hunt* in combination with *Flick885*. POR, 58-60, Papers 24, 25, 31.

C. The Combination of *Flick885* and *Hunt* Is Fraught With Hindsight

Petitioners distill the combination of a GPS, like in *Hunt*, with *Flick885* to nothing more than a predictable and suitable combination that provides “advantages” that can be used for improvement in the same way. Reply, 2-4. Petitioners focus on GPS alone in *Hunt* but fail to consider *Hunt* as a whole at the time of filing – when GPS was not so prolific. POR, 57-60. Petitioners fail to establish that any recognized benefit of a combined system would have been recognized by a POSA at the time of filing. This is impermissible hindsight. Omega has provided evidence that adding GPS at the time of filing of the ‘278 *Patent* was in fact beyond the skill of a POSA since a POSA would not do so in consideration of processing speeds. POR 58; Ex-2020, ¶192.

D. Strong Secondary Consideration Evidence Confirms Patentability

As set forth in detail in Section II.B above with respect to Ground 2, the evidence of secondary considerations is well-documented and tied directly to the ‘278 *Patent*. This evidence applies equally in both Grounds 2 and 3 and is incorporated herein. In light of such evidence, the only way one could deem the claims obvious is through improper hindsight reconstruction. Here, as in many

proceedings in the past, the claims of the '278 *Patent* should be confirmed patentable. The Grounds of the petition should be rejected.

Respectfully submitted, March 8, 2024

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

Pursuant to 37 C.F.R. §42.24(a)(1)(i), the undersigned hereby certifies that the foregoing PATENT OWNER'S SUR-REPLY IN RESPONSE TO PETITIONER'S REPLY IN SUPPORT OF ITS PETITION contains 5,523 words, excluding the parts of this Response that are exempted under 37 C.F.R. §42.24(a), as measured by the word-processing system used to prepare this paper.

/s/David S. Carus

DAVID S. CARUS, Back-Up Counsel
Reg. No. 59,291

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

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: March 8, 2024

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