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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' MOTION TO EXCLUDE EXHIBITS 2004-2006
AND PORTIONS OF EXHIBITS 2010 AND 2014**

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37 C.F.R. § 42.52	1, 4, 9
37 C.F.R. § 42.53	1, 4, 9
37 C.F.R. § 42.62	1, 4

37 C.F.R. § 42.64	1
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OTHER AUTHORITIES

Consolidated Trial Practice Guide (Nov. 2019)	1, 4, 9
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LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 8,032,278
1002	Prosecution 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 <i>ex parte</i> reexamination request, mailed December 15, 2016 in No. 90/013,851 (RX2)
1012	<i>Ex parte Omega Patents, LLC</i> , No. 2018-008119 (Nov. 3, 2018)
1013	Decision granting <i>ex parte</i> 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 <i>Ex parte Omega Patents, LLC</i> , No. 2022-003758, Reexamination No. 90/014,675 (Oct. 28, 2022)
1017	<i>Ex parte Omega Patents, LLC</i> , No. 2022-003758 (Nov. 30, 2022)
1018	D.I. 50, Claim Construction Order, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 20, 2015) (“ <i>CalAmp-CC</i> ”).
1019	D.I. 34, Claim Construction Order, <i>Omega Patents, LLC v. Firstech, LLC</i> , No. 2:20-cv-01344 (W.D. Wash. Nov. 22, 2021) (“ <i>Firstech-CC</i> ”).
1020	<i>Omega Patents, LLC v. CalAmp Corp.</i> , 920 F.3d 1337 (Fed. Cir. 2019) (“ <i>CalAmp-I</i> ”)
1021	<i>Omega Patents, LLC v. CalAmp Corp.</i> , 13 F.4th 1361 (Fed. Cir. 2021) (“ <i>CalAmp-II</i> ”)
1022	D.I. 14, Omega Patents Answering Brief In Opposition to Geotab USA, Inc.’s Motion to Dismiss, <i>Omega Patents, LLC v. Geotab USA, Inc. and Geotab, Inc.</i> , No. 1:22-cv-01044-CFC (D. Del. Nov. 16, 2022)
1023	U.S. Patent No. 6,957,133 (“Hunt”)
1024	U.S. Patent No. 6,756,885 (“Flick-885”)
1025	U.S. Patent No. 6,011,460 (“Flick-460”)

1026	D.I. 040, Omega Patents Opposition to CalAmp Motion For Claim Construction, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Oct. 3, 2014)
1027	D.I. 144, Jury Verdict, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 30, 2019)
1028	D.I. 310, Jury Verdict, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 24, 2016)
1029	D.I. 143, Jury Instructions, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Nov. 24, 2016)
1030	D.I. 309, Jury Instructions, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 30, 2019)
1031	Y. Park and A. Fumiyuki, eds. <i>Enhanced Radio Access Technologies For Next Generation Mobile Communication</i> . Dordrecht: Springer, 2007.
1032	F. Delli Priscoli and M. Neri, “Integration of the ORBCOMM satellite network with the GSM Short Message Service.” <i>Space Communications</i> , Vol. 19, no. 1, pp. 47-57, 2003.
1033	D.I. 180, Transcript, Civil Jury Trial–Day 3, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 18, 2016)
1034	Pages from D.I. 181, Transcript, Civil Jury Trial–Day 4, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 19, 2016)
1035	<i>RESERVED</i>
1036	<i>RESERVED</i>
1037	<i>RESERVED</i>
1038	<i>RESERVED</i>
1039	Pages from D.I. 338, Transcript, Civil Jury Trial–Day 2, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 24, 2019)
1040	Pages from D.I. 339, Transcript, Civil Jury Trial–Day 3, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 25, 2019)
1041	<i>RESERVED</i>
1042	<i>RESERVED</i>
1043	<i>RESERVED</i>
1044	Comparison of limitations in ’278 patent claims 13-22 with limitations in ’278 patent claims 1-12
1045	U.S. District Court – Judicial Caseload Profile for the District of Delaware, <i>available at</i>

	https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0630.2022_0.pdf (last visited December 19, 2022)
1046	Title 40 Code of Federal Regulations, Part 86, Subpart S—General Compliance Provisions for Control of Air Pollution From New and In-Use Light Duty Vehicles, Light-Duty Trucks, and Complete Otto-Cycle Heavy-Duty Vehicles (July 1, 2007)
1047	SAE J1939-71 Vehicle Application Layer (rev. DEC2004)
1048	SAE J1708 Serial Data Communications Between Microcomputer Systems in Heavy-Duty Vehicle Applications (rev. AUG2004)
1049	<i>RESERVED</i>
1050	International Standard ISO 15031-4 Road Vehicles—Communication between vehicle and external equipment for emissions related diagnostics—Part 4: External test equipment (1st ed. June 15, 2005) (“ISO 15031-4:2005”)
1051	Pages from Microsoft Internet & Networking Dictionary (2003)
1052	SAE J1978 OBD-II Scan Tool – Equivalent to ISO/DIS 15031-4: December 14, 2001 (revised 2002-04)
1053	Pages from IEEE 100 The Authoritative Dictionary of IEEE Standard Terms (7th Ed. 2000)
1054	D.I. 265, Federal Circuit Mandate, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. July 1, 2019)
1055	D.I. 392, Order Dismissing With Prejudice, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. June 16, 2022)
1056	U.S. Patent No. 8,856,266 B2
1057	U.S. Patent Application Publication No. US 2005/0032511 A1
1058	U.S. Patent Application Publication No. US 2004/0138790 A1
1059	U.S. Patent No. 6,611,740
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

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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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1085	<i>RESERVED</i>
1086	<i>RESERVED</i>
1087	<i>RESERVED</i>
1088	<i>RESERVED</i>
1089	<i>RESERVED</i>
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)
1114	Board E-Mail Authorizing Reply to Patent Owner’s Preliminary Response (May 15, 2023)
1115	Declaration of Jeffrey Miller, Ph.D., In Support Of Petitioners’ Reply to POR
1116	J. Bray and C.F. Sturman, Bluetooth 1.1: Connect Without Cables (2d ed. Prentice Hall PTR 2002) (“Bray”)
1117	Affidavit of Nathaniel E. Frank-White, Internet Archive Records Request Processor, with Exhibit B, “The Bluetooth Wireless Technology White Paper, Rev. 1991A-11/00” (Atmel 2000) (“Atmel”)
1118	U.S. Patent No. 8,495,615 (“Alberti”)
1119	Data Sheet SN55LBC176, SN65LBC176, SN65LBC176Q Differential Bus Transceiver (Texas Instruments)
1120	Data Sheet, LTC1487 Ultra-Low Power RS485 with Low EMI, Shutdown and High Input Impedance (Linear Technology)
1121	Data Sheet, Si9243AEY Single-Ended Bus Transceiver (Vishay Siliconix)
1122	Data Sheet, L9637 ISO 9141 Interface (STMicroelectronics)
1123	Transcript, Deposition of Joseph C. McAlexander III (January 5, 2023)

1124	Transcript, Deposition of Christian Tregillis (December 22, 2023)
1125	U.S. Patent No. 6,606,561 (“Flick-561”)
1126	Errata to Transcript, Deposition of Joseph C. McAlexander III (January 5, 2023)
1127	LinkedIn page of Gallin Chen, visited March 26, 2024
1128	LinkedIn page of Peter Hergesheimer, visited March 26, 2024
1129	LinkedIn page of Stephen Hall, visited March 26, 2024

Patent Owner (“PO”) filed the transcripts of depositions from prior litigation between PO and third-party CalAmp as EX2004-EX2006. PO repeatedly cites, paraphrases, and quotes these exhibits in the POR, the Sur-Reply, and the McAlexander (EX2010) and Tregillis (EX2014) declarations as evidence purportedly establishing secondary considerations, relying on EX2004-EX2006 for the truth of the matters asserted therein. *See* POR at 2-3, 47, 51-52, 62 and Sur-Reply at 12-13, 18-19, 21.

Petitioners move to exclude EX2004-EX2006 as hearsay under Fed. R. Evid. (“Rule”) 802. Petitioners also move to exclude those portions of PO’s expert declarations that repeat the hearsay—namely EX2010, ¶¶41, 170-171, 200, and 210, and EX2014, ¶¶38-41, and 43-44—as improper expert testimony under Rules 702-703 and as hearsay under Rule 802. Petitioners timely filed objections to this evidence in Paper 14 at 1-2 (EX2004-EX2006) and Paper 17 at 1-3 (paragraphs in EX2010, EX2014).

This motion is authorized by the Scheduling Order (Paper 12) at 10, and is supported by the Federal Rules of Evidence, 37 C.F.R. §§42.20(a), 42.52(a)(1), 42.53(a), 42.62(a), 42.64(c), 35 U.S.C. §24, the Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), and the cases and authorities cited herein.

I. Introduction

Exhibits 2004-2006 are indisputably hearsay. They are deposition testimony from a different proceeding (Rule 801(c)(1)) that PO offers for the truth of the matters asserted (Rule 801(c)(2)) to purportedly establish secondary considerations. PO relies on this evidence in its trial papers (POR and Sur-reply) and quotes it in its expert declarations (EX2010, EX2014). No exception applies.

By filing hearsay testimony from third-party deponents, taken in prior litigation with an unrelated party, PO ignored the Federal Rules of Evidence and the Board's regulations governing reliance on testimonial evidence. Petitioners had no opportunity to cross-examine the witnesses and elicit testimony contradicting PO's repeated misrepresentations that this hearsay establishes secondary considerations. The Board should exclude this hearsay and the expert testimony that parrots it.

II. Statement of Facts

On April 27, 2023, PO filed EX2004-EX2006 with its Preliminary Response. The exhibits are transcripts of deposition testimony by Galin Chen (EX2004), Peter Hergesheimer (EX2005), and Stephen Hall (EX2006) in a patent litigation, not involving Petitioners, between PO and third-party CalAmp. CalAmp is not a party to this IPR. The deponents testified in the CalAmp litigation that

they were CalAmp employees. EX2004, 8:9-15; EX2005, 6:4-8; EX2006, 6:11-15. Petitioners timely objected to EX2004-EX2006. Paper 14.

On October 18, 2023, PO filed its POR (Paper 15) and declarations from purported experts Mr. McAlexander (EX2010) and Mr. Tregillis (EX2014). The POR cited EX2004-EX2006 for the truth of the matters asserted, which PO characterized (incorrectly) as purported evidence of secondary considerations. *See* POR, 2-3 (“The evidence of secondary considerations includes testimony from an infringer’s employees in [CalAmp] litigation[.]”), citing EX2004, 26:11-20; EX2005, 45:3-19, 46:25-47:19; EX2006, 64:15-24, 102:16-103:13, 155:4-13; *see also* POR, 47, 51-52, 62. The POR also cited PO’s experts purporting to restate—and in some instances block quoting—EX2004-EX2006 for the truth of the matter asserted. *See e.g.*, EX2010, ¶¶41, 170-171, 200, 210; EX2014, ¶¶38-41, 43-44. Petitioners timely objected. Paper 17.

On March 8, 2024, PO filed its Sur-reply (Paper 32), citing EX2004-EX2006 for the truth of the matters asserted, which PO characterized (incorrectly) as purported evidence of secondary considerations. Sur-reply, 12-13, 18-19. The Sur-reply also cited the improper expert testimony in EX2010 and EX2014. Petitioners had already timely objected to this hearsay evidence which PO cited again in the Sur-reply. Papers 14 and 17.

PO did not offer, and made no attempt to compel, testimony in this proceeding from any of the deponents in EX2004-EX2006, as provided by 37 C.F.R. §§42.52(a)(1), 42.53(a), 42.53(d)(3), 35 U.S.C. §24, and CTPG, 29. PO never offered any of the deponents for cross-examination by Petitioners. PO made no attempt to show that any deponent—Chen, Hergesheimer, or Hall—was unavailable to offer testimony in this proceeding.

III. The Board Should Exclude EX2004-EX2006 As Inadmissible Hearsay.

The Federal Rules of Evidence apply in IPR. 37 C.F.R. §42.62(a). This includes the rule against hearsay. Rule 802; *The Data Company Techs. v. Bright Data*, IPR2022-00135, Paper 51, 82-83 (May 31, 2023) (excluding third-party testimony from prior litigation as hearsay).

Hearsay is a statement that: (1) “the declarant does not make while testifying at the current trial or hearing;” which (2) “a party offers... to prove the truth of the matter asserted in the statement.” Rule 801(c). This includes deposition testimony from another case. “[P]rior testimony from another case, which is not subject to cross-examination by the opposing party [in IPR], is hearsay if offered for the truth of the matter.” *Data Company*, IPR2022-00135, Paper 51 at 82. Hearsay is inadmissible unless an exception applies. Rule 802. No exception applies to PO’s use of EX2004-EX2006.

A. EX2004-EX2006 Are Hearsay.

1. EX2004-EX2006 are transcripts of deposition testimony from a different proceeding.

The deposition testimony in the transcripts filed as EX2004-EX2006 was provided in prior litigation between PO and third-party CalAmp. None of the testimony was made “while testifying at the current trial or hearing.” Rule 801(c)(1).

2. PO offers EX2004-EX2006 for the truth of the matter asserted.

PO repeatedly offers EX2004-EX2006 to prove the truth of the matter asserted in the deposition testimony. Rule 801(c)(2). That PO mischaracterizes what the testimony in these exhibits actually says does not change the fact that PO offers the testimony for the truth of the matters that PO contends were asserted. *See* POR, 2-3 (“The evidence of secondary considerations *includes testimony* from an infringer’s employees in [CalAmp] litigation[.]”) (emphasis added), citing EX2004, 26:11-20; EX2005, 45:3-19, 46:25-47:19; EX2006, 64:15-24, 102:16-103:13, 155:4-13; *see also* POR, 47 (mischaracterizing the hearsay testimony as “admitting to copying and limited value of product without the claimed invention”), citing EX2004, 26:11-20; EX2005, 45:3-19, 46:25-47:19; EX2006, 64:15-24, 102:16-103:13, 155:4-13; *id.*, 51-52 (paraphrasing hearsay testimony), citing EX2005, 40:6-41:3, 46:25-48:19.

The POR also relies on conclusory testimony from McAlexander (EX2010, ¶171) paraphrasing the deposition testimony, and from Tregillis (EX2014, ¶¶38-41, 43-44) **block quoting** EX2006 (EX2014, ¶¶38-39) and paraphrasing EX2005, all for the truth of the matter that PO contends was asserted in the deposition testimony. POR, 51-52.

The Sur-reply offers the hearsay testimony, and the expert testimony parroting it, for the truth of what it asserts. *See, e.g.*, Sur-reply, 13 (referring to “testimony from individuals involved in developing infringing products”), citing EX2014, ¶¶40 (quoting EX2005, 40:20-41:3), 41 (paraphrasing EX2005, 40:6-41:3, “46:25-28:19” [sic]), EX2010, ¶170 (paraphrasing hearsay “as noted by engineers of CalAmp”), citing EX2005, 40:6-41:3, EX2006, 40:20-41:3. *See also* Sur-reply at 18-19 (similar).

In short, PO bases its secondary considerations arguments on EX2004-EX2006 and the experts quoting and paraphrasing that deposition testimony. PO offers the deposition testimony for the truth of the matters that PO contends were asserted in EX2004-EX2006. EX2004-EX2006 are indisputably hearsay under Rule 801(c).

B. No Exception Applies.

No hearsay exception applies that would make EX2004-EX2006 admissible.

1. PO made no showing that any deponent from EX2004-EX2006 was unavailable under Rule 804(a).

Rule 804(b) specifies exceptions to the rule against hearsay if the witness is unavailable. The proponent of the hearsay bears the burden of showing that the declarant is unavailable. *Williams v. United Dairy Farmers*, 188 F.R.D. 266, 271 (S.D. Ohio 1999) (collecting cases). Rule 804(a) specifies five alternative criteria for unavailability. PO cannot meet its burden to show any of them.

a. PO cannot show unavailability under Rule 804(a)(1).

CalAmp did not assert privilege over the testimony in EX2004-EX2006 and, given that the testimony is public, any privilege is waived. Thus, PO cannot show that privilege makes any deponent unavailable. Rule 804(a)(1).

b. PO cannot show unavailability under Rule 804(a)(2).

PO cannot show that any deponent refused a court order to testify under Rule 804(a)(2) because PO never sought a subpoena from a district court that a deponent could defy. Rule 804(a)(2).

c. PO cannot show unavailability under Rule 804(a)(3).

PO cannot show that any deponent testified to not remembering the subject matter of the deposition testimony in EX2004-2006 because PO never took testimony from Chen, Hergesheimer, or Hall in this proceeding. Rule 804(a)(3).

d. PO cannot show unavailability under Rule 804(a)(4).

PO has not shown that any deponent in EX2004-EX2006 was unavailable to testify because of death or current infirmity, physical, or mental illness under Rule 804(a)(4).

e. PO cannot show unavailability under Rule 804(a)(5).

Rule 804(a)(5) provides that a declarant is unavailable when “absent from the trial or hearing *and the statement’s proponent has not been able, by process or other reasonable means, to procure*” the declarant’s attendance or testimony.

To meet its burden to show unavailability under Rule 804(a)(5), PO “must... establish that reasonable efforts were undertaken to secure the declarant’s attendance at the hearing.” *Williams*, 188 F.R.D. at 272. The hearsay’s proponent cannot meet its burden where it never tried to compel witness testimony. *United States v. Zane*, 495 F.2d 683, 699 (2d Cir. 1974) (failure to call available witness foreclosed hearsay exception under Rule 804(b)(1)); *CaptionCall, LLC v. Ultratec, Inc.*, IPR2015-00636, Paper 97, 17 (Sep. 7, 2016) (“Patent Owner does not identify any attempt to bring Mr. Puzey forward as a witness in this proceeding. Accordingly, we do not find that he is unavailable in this proceeding, and FRE 804(b)(1) does not apply[.]”).

PO’s failure to even try to secure testimony from the CalAmp deponents in this IPR precludes it from showing unavailability under Rule 804(a)(5). PO did not offer a declaration from Mr. Chen (EX2004), Hergesheimer (EX2005), or Hall

(EX2006), and made no attempt to elicit testimony in this proceeding where they would have been subject to cross-examination by Petitioners—even though the Board’s regulations provide procedures for compelling testimony under 37 C.F.R. §§42.52(a)(1), 42.53(a), 42.53(d)(3), 35 U.S.C. §24, and CTPG, 29. Each deponent maintains a LinkedIn profile representing that each deponent resides within the jurisdiction—and subject to the subpoena powers—of a United States District Court. EX1127 (Chen); EX1128 (Hergesheimer); EX1129 (Hall); 35 U.S.C. §24. In short, PO cannot show that it has been unable, “by process or other reasonable means,” to procure a deponent’s attendance at a deposition in this proceeding under Rule 804(a)(5) because PO made no effort to use process available under the statute and regulations to compel attendance at a deposition in this proceeding.

Because PO cannot show that Chen, Hergesheimer, or Hall were unavailable under Rule 804(a), no exception under Rule 804(b) applies to EX2004-EX2006.

2. PO cannot meet the requirements for the residual exception under Rule 807.

The residual exception allows hearsay even when no other exception applies but is “reserved for exceptional cases” *Conoco v. Dept. of Energy*, 99 F.3d 387, 392 (Fed. Cir. 1996) (discussing residual exceptions now codified at Rule 807); *United States v. Husky*, 90 F.4th 651, 670 (4th Cir. 2024) (“The residual exception is used very rarely, and only in exceptional circumstances.”) (cleaned up). The

evidence must be “more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts.” Rule 807(a)(2). This is not an exceptional case. PO cannot meet the requirements of Rule 807.

Instead of filing EX2004-EX2006, PO could have obtained voluntary declarations from Mr. Chen, Hergesheimer, or Hall covering the relevant subjects; PO could have sought to compel their deposition testimony in this proceeding; or PO could have submitted testimony from others. These alternatives would have submitted testimony from witnesses that were subject to cross-examination by Petitioners in this proceeding. PO never tried to do any of this.

The Board regularly finds the residual exception *inapplicable* where (like here) a proponent *did not even try* to take the witness’s deposition in the IPR proceeding. In *Asetek Danmark v. CoolIT Sys.*, IPR2020-00825, Paper 50 (Oct. 12, 2021), the Board found Rule 807 “does not apply” where a petitioner sponsored hearsay testimony but “made no effort to take [the witness’s] deposition during the course of this proceeding.” *Asetek*, 46. The Board explained that “if Petitioner really believed that [the witness’s] testimony was critical, it should have sought his testimony in this proceeding. Having failed to do so, Petitioner cannot now argue that it could not have obtained [the witness’s testimony] in this proceeding through reasonable efforts.” *Id.* PO never sought testimony from

Chen, Hergesheimer, or Hall in this IPR despite the Board providing a process for doing so. Under *Asetek*, PO's failure to seek that testimony precludes PO from arguing for admissibility under Rule 807.

In *Data Company*, the Board rejected the patent owner's attempts to justify the residual exception for trial testimony from prior litigation "because the witnesses 'were cross-examined by parties with similar motive and opportunity,' '[t]rial testimony under oath possesses guarantees of trustworthiness,' and the testimony has been corroborated." *Data Company*, IPR2022-00135, Paper 51 at 82. Observing that Rule 807 requires that hearsay statements must be "more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts," the Board found that the residual exception ***failed*** because "more probative evidence could have provided by Patent Owner... by declarations submitted ***in this proceeding that could have been subject to cross-examination.***" *Id.* at 83 (emphasis added). The same is true here, where PO could have filed declarations or sought to compel depositions in this proceeding but did not even try.

In short, EX2004-EX2006 are hearsay. No exception applies. The Board should exclude these exhibits.

IV. The Board Should Exclude Portions of EX2010 and EX2014 Parroting The Hearsay In EX2004-EX2006 As Improper Expert Testimony Under Rules 702-703 And As Hearsay Under Rule 802.

While an expert may base an opinion on facts or data that are not admissible as evidence, “Rule 703 does not authorize admitting inadmissible evidence on the pretense that it is the basis for expert opinion when, in fact, the expert adds nothing to the inadmissible evidence other than transmitting it to the jury.” *Wi-LAN Inc. v. Sharp Elecs. Corp.*, 992 F.3d 1366, 1374 (Fed. Cir. 2021) (cleaned up); *see also Data Company*, IPR2022-00135, Paper 51 at 82-83 (Rule 703 “does not make the underlying facts admissible”). The Federal Circuit recognizes that “Rule 703 ‘was not intended to abolish the hearsay rule and to allow a witness, under the guise of giving expert testimony, to in effect become the mouthpiece of the witnesses on whose statements or opinions the expert purports to base his opinion.’” *Wi-LAN Inc.*, 992 F.3d at 1376, quoting *Factory Mut. Ins. Co. v. Alon USA L.P.*, 705 F.3d 518, 524 (5th Cir. 2013). “[S]econd-hand evidence” from an expert that “‘did not analyze his source materials so much as repeat their contents’” falls “outside the permissible bounds of Rule 703.” *Wi-LAN*, 992 F.3d at 1374-1375, quoting *United States v. Mejia*, 545 F.3d 179, 197-198 (2d Cir. 2008); *see generally Wi-LAN*, 992 F.3d at 1374-1376 (collecting cases).

It could not be clearer from their testimony that McAlexander (EX2010, ¶¶41, 170-171, 200, 210) and Tregillis (EX2014, ¶¶38-41, 43-44) are nothing more

than mouthpieces for the Chen, Hergesheimer, and Hall hearsay testimony that they parrot from EX2004-EX2006—doing exactly what Rule 703 and *Wi-LAN* forbid. For example, at EX2014, ¶¶38-39, Tregillis ***block quotes*** testimony from EX2006 without analysis. *See also* EX2014, ¶¶40 (paraphrasing and quoting EX2006), 41 (paraphrasing and quoting EX2005), 43 (paraphrasing EX2005), 44 (paraphrasing and quoting EX2004); EX2010, ¶¶41 (paraphrasing EX2004-EX2006), 170 (paraphrasing EX2005, EX2006), 171 (paraphrasing EX2005), 200 (conclusory reference to EX2004-EX2006 as evidence of secondary considerations), 210 (citing “testimony of the opposing party admitting to copying” and paraphrasing EX2004-EX2006).

McAlexander and Tregillis did not testify that they personally observed any of the subject matter discussed in the hearsay testimony in EX2004-EX2006. Rule 703. Paraphrasing and quoting the hearsay testimony in EX2004-EX2006 does not apply any specialized knowledge or apply reliable principles or methods to any facts under Rule 702. The testimony from McAlexander and Tregillis just parrots the hearsay. That is not permitted. *Wi-LAN*, 992 F.3d at 1376 ; Rules 702-703, 802.

PO cannot show that McAlexander and Tregillis parroting the hearsay at EX2010, ¶¶41, 170-171, 200, 210, and EX2014, ¶¶38-41, 43-44, has probative value that “substantially outweighs their prejudicial effect.” Rule 703; *Wi-LAN*

Inc., 992 F.3d at 1376 (affirming summary judgment excluding expert testimony inadmissible evidence under Rule 703). Accordingly, the Board should exclude this testimony in EX2010 and EX2014.

V. Conclusion

The Board should exclude Exhibits 2004-2006 as hearsay under Rule 802. The Board should exclude Exhibit 2010, ¶¶41, 170-171, 200, and 210, and Exhibit 2014, ¶¶38-41, and 43-44, parroting the hearsay testimony in Exhibits 2004-2006, as improper expert testimony under Rules 702-703 and as hearsay under Rule 802.

Respectfully submitted,
Geotab USA, Inc. and Geotab, Inc.

Date: April 3, 2024

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

I certify that on April 3, 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:

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