

Paper No. _____

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 IPR2023-00504
Patent 8,032,278

**PATENT OWNER'S OPPOSITION TO PETITIONERS'
MOTION TO EXCLUDE EXHIBITS 2004-2006
AND PORTIONS OF EXHIBITS 2010 AND 2014**

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Rules

Fed.R.Evid. 703	1, 6, 7, 8, 9
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Fed.R.Evid. 803(3).....	1, 4, 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-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 (" <i>Hunt</i> ")
1024	U.S. Patent No. 6,756,885 (" <i>Flick-885</i> ")
1025	U.S. Patent No. 6,011,460 (" <i>Flick-460</i> ")

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 to Lowrey
1060	U.S. Patent No. 7,209,813
1061	<i>RESERVED</i>
1062	<i>RESERVED</i>
1063	<i>RESERVED</i>
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>
1084	<i>RESERVED</i>
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)
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)

I. Introduction

Petitioners' motion seeks to exclude evidence submitted by Omega that is highly relevant and probative of secondary considerations of non-obviousness. Omega has filed deposition transcripts (EX2004-EX2006) of three witnesses who provided relevant, sworn testimony regarding their existing mental state of mind surrounding the development of products practicing the inventions of the '278 patent. If the testimony is deemed hearsay, it clearly falls within the exceptions to the hearsay rule, namely Federal Rule of Evidence 803(3). However, multiple courts have recognized that this evidence does not amount to hearsay and can be admitted for purposes of secondary considerations.

Not only do Petitioners request the exclusion of the fact witness testimony itself, but Petitioners also seek to exclude the opinions of Omega's experts who rely upon and reference the evidence (EX2010, ¶¶41, 170-171, 200, 210; EX2014, ¶¶38-41, 43-44), notwithstanding FRE 703 clearly allowing an expert witness to rely upon evidence that would be otherwise inadmissible. As set forth below, Petitioners' motion should be denied.

II. The Sworn Testimony

Exhibits 2004-2006 are transcripts of deposition testimony by Galin Chen (EX2004), Peter Hergesheimer (EX2005), and Stephen Hall (EX2006) from litigation between Omega and CalAmp Corp, Case No. 6:13-cv-01950-PGB-DCI

(M.D. Fla. 2013)¹. Mr. Chen was a senior business director for CalAmp (EX2004, p. 8), Mr. Hergesheimer was a senior director of software and architecture for CalAmp (EX2005, p. 6), and Mr. Hall was a director of system engineering and technology for CalAmp (EX2006, p. 6). All of these deponents had personal knowledge specific to the state of the art and CalAmp’s development of products at issue in that litigation, the CalAmp LMU-3000/3030/3050 products, which were found to infringe claims 1-6, 8, 11, 12-14, 16, 18, 19 and 21 of the ‘278 patent. EX1028.

The testimony of Mr. Chen (EX2004, 26:11-20) describes how CalAmp had to purchase the technology because of the difficulty in developing the infringing products in house. Mr. Hergesheimer (EX2005, 40:6-41:3, 45:19, 46:25-48:19) explained his “belief” that the infringing units were developed in response to an unfilled need in the market. Mr. Hergesheimer also offered his impression that there were no alternative non-infringing designs available, and that he believed products without the claimed functionality were of limited value and less desirable to consumers. Mr. Hall’s testimony (EX2006, 40:6-41:3, 64-67, 102:16-103:13, 155:4-

¹ Notably, testimony from these transcripts has been relied upon by the PTAB in favorable *ex parte* reexamination proceedings, specifically the second and fifth *ex parte* reexams. *Ex Parte Omega Patents, LLC*, Appeal 2018-008119 (Ex-1012); *Ex Parte Omega Patents, LLC*, Appeal 2022-003758 (Ex-1017).

13) also offers his perception of the relevant state of the art in the market at the time CalAmp developed its infringing products.

III. The Testimony Should Not Be Excluded

“[S]imilar to a district court in a bench trial, the Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to evidence presented.” *Unified Patents, LLC v. Longhorn HD LLC*, IPR202000879, Paper 35 at 51 (Nov. 9, 2021), citing *Corning Inc. v. DSM IP Assets B.V.*, IPR201300053, Paper 66 at 19 (PTAB May 1, 2014).

Moreover, when addressing similar efforts to exclude relevant testimony, multiple federal courts have recognized that when evidence that may arguably qualify as hearsay is offered for the purpose of supporting secondary considerations, it is admissible. For example, in *Hynix Semiconductor, Inc. v. Rambus, Inc.*, No. C-00-20905 RMW, 2009 U.S. Dist. LEXIS 5765, at *50 (N.D. Cal. Jan. 16, 2009), the court determined an article referencing praise in the industry was not hearsay “because it was admitted not for its truth, but as a proper secondary consideration...” Similarly, in *HTC Corp. v. Tech. Props.*, No. 5:08-cv-00882-PSG, 2013 U.S. Dist. LEXIS 129263, at *16 (N.D. Cal. Sep. 6, 2013), the court determined that evidence of “industry acclaim is one of the secondary considerations that can be looked to in determining non-obviousness” served a non-hearsay purpose and therefore was admissible. In *Infinity Canopy, Inc. v. Imp. Fence Direct, Inc.*, No. CV 19-08427-

AB (AGR), 2022 U.S. Dist. LEXIS 98094, at *14 n.2 (C.D. Cal. Mar. 17, 2022), the court rejected a party's objections (including a hearsay objection) because the information was offered to show secondary considerations. Petitioner relies heavily on *The Data Company Techs. v. Bright Data*, IPR2022-00135, Paper 51, 82-83 (May 31, 2023), which does not appear to have referenced any of the district court rulings which are directly contrary to the Board's ruling in *Data Company*. Omega offers the evidence for purposes of establishing secondary considerations—a purpose for which multiple federal courts have recognized is acceptable.

Even if the testimony is hearsay, it is subject to an exception to the rule under FRE 803(3)—an exception also not expressly considered in *Data Company*. In particular, the witnesses provided their state of mind as to the state of the art motivations for the development of the CalAmp infringing products, including customer demand, long felt need and non-infringing alternatives. For example, Mr. Hergesheimer discussed his subjective beliefs as to customer demand and the ability to develop alternative designs to avoid infringement. (EX2005, 40:6-41:3, 45:19.) Mr. Hergesheimer also described his then state of mind as to the intent of the development, namely the value and desirability of certain features included in the infringing products. (EX2005, 46:25-48:19.) Similarly, Mr. Hall offered his current perception of the market needs vis-à-vis the infringing products. (EX2006, 40:6-41:3, 64-67, 102:16-103:13, 155:4-13.) If the witnesses' perceptions were accurate,

they provide significant evidence of industry need and value of the patented technology. Even if these witnesses' perceptions regarding CalAmp's products were somehow incorrect, they nonetheless reflect the view of these industry insiders, who recognized the value of the patented technology. Either way, the testimony is offered for the limited purpose of secondary considerations, and the Board should consider this evidence.

IV. Expert Opinions

Petitioner next argues that portions of the expert declarations referencing testimony in EX2004-EX2006 should be excluded because they "parrot" the testimony. Again, Petitioner is wrong on its position and characterization. Petitioner cites to EX2010, ¶¶41, 170-171, 200 and 2010 in the McAlexander declaration, which does not parrot testimony. Instead, Mr. McAlexander acknowledged the significant record evidence of secondary considerations that has been considered by juries and the PTAB. *See, e.g.*, EX2010, ¶¶200, 210. Mr. McAlexander opines it is rare to have so much evidence of nonobviousness relied on by the PTAB in several unsuccessful challenges to a patent's validity. *Id.* The fact that Mr. McAlexander cites the deposition testimony (along with other PTAB decisions where relevant) is not parroting the testimony, but instead referencing support for his opinion.

Mr. Tregillis does directly quote some of the testimony from EX2004-EX2006, however, the point of the quotations is context and support for his own

opinions rather than simply conveying the testimony itself. For example, Mr. Tregillis refers to commercial success and industry need for the ‘278 *Patent* technology. (EX2014, ¶21, 25.) Commercial success is supported by the benefits of the technology to users (EX2014, ¶26-27) and the sales of infringing devices (EX1028²). As Mr. Tregillis recognized, industry need for the technology was supported by marketing used by CalAmp to promote the infringing products (EX2014, ¶35), as well as by the explanation of the motivation for developing the infringing CalAmp products in the commercial requirements specification for the infringing products (EX2014, ¶36; EX2018). Mr. Tregillis also referenced the testimony of both Mr. Hergesheimer and Mr. Hall, both of whom provided testimony that supported the same concepts of commercial success and industry need/customer demand otherwise referenced by Mr. Tregillis. (EX2014, ¶¶ 38-41.) In other words, while Mr. Tregillis relies on testimony from these individuals, he is free to do so under Rule 703 in support of his opinions, which are also supported by other citations.

The question of whether the expert opinions, allegedly relying on hearsay, are admissible is a much different question than whether the underlying testimony is admissible. *See Princeton Dig. Image Corp. v. Office Depot, Inc.*, No. 13-239-LPS, 2017 U.S. Dist. LEXIS 120493, at *7 (D. Del. Aug. 1, 2017)(denying the motion to

² EX1028 is referenced in ¶45 of the Tregillis Declaration.

exclude expert opinions relying on hearsay, and recognizing the question of presenting the hearsay to the jury was a different issue); *see also Nestle Healthcare Nutrition, Inc. v. Steuben Foods, Inc.*, IPR2015-00249, Paper 76 at 13 (June 2, 2016) (“Our determination is not made by a jury, so [the caveat on disclosing inadmissible facts and data to the jury] does not apply”). Even if the Board finds the testimony in EX2004-EX2006 itself inadmissible, this does not foreclose the expert opinions, as expressly recognized by FRE 703. Indeed, FRE 703 expressly recognizes that “[i]f experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion on the subject, they need not be admissible for the opinion to be admitted.” FRE 703; *see also Curtis v. Alcoa, Inc.*, No. 3:06-CV-448, 2009 U.S. Dist. LEXIS 130437, at *16 (E.D. Tenn. Sep. 1, 2009) (“experts are specifically excepted from the rule excluding hearsay if they are relying upon statements that are reasonably relied upon by experts in their field.”) Petitioner does not argue that the testimony of CalAmp personnel and engineers is not the type of testimony a technology expert, such as Mr. McAlexander, or a financial expert, such as Mr. Tregillis, would rely. Mr. McAlexander has 50 years of experience in microcircuit and semiconductor technologies (EX2010, ¶7), and of course would ordinarily rely on testimony from engineers involved in the development of the infringing CalAmp products. Similarly, Mr. Tregillis regularly opines on the economic analysis of patents, including economic damages and valuations. EX2014, ¶¶5-6. In that

context, there can be no doubt that he can rely on information related to sales, licensing, market factors, and consumer demand, as provided by the engineers involved in the CalAmp infringing multi-vehicle tracking systems.

Petitioner relies on *Wi-LAN Inc. v. Sharp Elecs. Corp.*, 992 F.3d 1366, 1374 (Fed. Cir. 2021), which addressed whether hearsay evidence could be presented to the jury through an expert. Similarly, Rule 703 references “disclos[ing] [inadmissible facts or data] to the jury only if their probative value in helping the jury evaluate the opinion substantially outweighs their prejudicial effect. (FRE 703, underlining added.) Here, even if the Board ultimately finds the testimony presented in EX2004-EX2006 is hearsay and is inadmissible, excluding expert opinions that rely on that testimony simply because it references it or quotes it is not proper. *See, e.g., Sikorsky Int’l Operations, Inc. v. Babcock Mission Critical Servs. Ltd.*, No. 3:19-cv-00833 (OAW), 2022 U.S. Dist. LEXIS 246043, at *13 (D. Conn. Apr. 20, 2022)(denying a motion to exclude expert testimony that relied in part on hearsay); *Planned Parenthood of the Great Nw. & Hawaiian Islands v. Wasden*, No. 1:18-cv-00555-BLW, 2021 U.S. Dist. LEXIS 189804, at *5 (D. Idaho Sep. 30, 2021)(denying a motion to exclude expert testimony based on hearsay, in particular where presented in a bench trial); *Weinhoffer v. Davie Shoring, Inc.*, 479 F. Supp. 3d 330, 334 (E.D. La. 2020)(denying a motion to exclude expert testimony relying on hearsay in a bench trial, finding “as this matter is set for bench trial, there is no

jury and the Court can properly weigh the probative value and prejudicial effect of the evidence”); *Wasica Fin. GmbH v. Schrader Int'l*, 432 F. Supp. 3d 448, 460 (D. Del. 2020). Here, where the experts considered and referenced hearsay, it is offered as support for the related opinions and properly considered by experts in their field. The Board should deny the motion to exclude.

V. Conclusion

As noted above, the testimony filed at EX2004-EX2006 is offered as proof of secondary considerations, which numerous courts have admitted over hearsay objections. Moreover, the actual testimony cited was provided by engineers who expressed their state of mind as to the motivation and rationale for developing the infringing products, as permitted as an exception to hearsay under FRE 803(3).

The challenged opinions of the submitted expert declarations cite the challenged testimony as a basis for the opinions—opinions that can properly rely on testimony, even if that testimony is not otherwise admissible. There is no need to balance the prejudice of admitting the opinions (and evidence cited therein) because the section of FRE 703 cited by Petitioner relates to jury trials, rendering the provision inapplicable in these proceedings. Petitioner’s motion should be denied.

Dated: April 10, 2024

Respectfully submitted,
Omega Patents, LLC

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on April 10, 2024, true and correct copies of the foregoing PATENT OWNER'S REQUEST FOR ORAL ARGUMENT was served via electronic mail upon the following counsel for record for Petitioners:

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Dated: April 10, 2024

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