

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB USA, INC. AND GEOTAB, INC.,
Petitioner,

v.

OMEGA PATENTS, LLC,
Patent Owner.

IPR2023-00504
Patent 8,032,278 B2

Record of Oral Hearing
Held: April 24, 2024

Before BARRY L. GROSSMAN, AMBER L. HAGY, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

APPEARANCES:

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The above-entitled matter came on for hearing on Wednesday, April 24, 2024, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P R O C E E D I N G S

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JUDGE HAGY: Okay, good afternoon everyone, I'm Judge Hagy. This is our hearing for IPR2023-00504. We have Petitioners Geotab USA, Inc., and Geotab, Inc., and Patent Owner Omega Patents LLC. The challenged patent is US patent number 8,032,278. With me today on the Panel are Judges Grossman and Dougal. I will note we have had a Panel change since the Decision to Institute due to Judge Sawert's departure from the Board. I just want to make a note of that. So let's go ahead and get started with counsel introductions. Petitioner, will you please identify who is present for you today and who will be presenting arguments.

MR. WICHMAN: Thank you, Your Honor. This is Adam Wichman for Petitioners Geotab USA and Geotab. I will be arguing today, and with me is my colleague Rich Guinta. And we have representatives from Petitioner Geotab listening on the public line.

JUDGE HAGY: Okay, thank you Mr. Wichman. And for Patent Owner?

MR. SANTURRI: Good afternoon, this is Ryan Santurri, on behalf of the Patent Owner, with me I have co-counsel Chris Reagan, who as you can see on the video feed. And also in the room with me is David Carus, another counsel.

JUDGE HAGY: Okay, thank you Mr. Santurri. So again, welcome everyone. It's good to have you here virtually. So if at any time during the proceeding you encounter any kind of technical or other difficulties, please let us know immediately. For example, you can contact the team members who provided you with connection information. Usually these things go

1 very smoothly, but every now and then somebody freezes up. And so, if that
2 does happen and you're not aware of it, we will let you know and we will
3 give you a chance to repeat yourself. Again, as a reminder, we do have the
4 whole record in front of us, and we do have the slides that both parties
5 submitted last week. We also have the objections that each side has
6 submitted with regard to each other's demonstratives. And I will just say
7 that both parties' objections are duly noted. You do not have to repeat them
8 or reargue them during the hearing today, but feel free to do as you wish in
9 that regard. We also have Petitioner's motion to exclude certain Patent
10 Owner exhibits. We are not going to rule on these objections or the motion
11 to exclude at this time. Instead, we will take everything under advisement.
12 We will hear your argument on all of this, all of the documents, and we will
13 render our ruling on any objections or motion to exclude in the final written
14 decision.

15 Okay, so with that, we're about to get started. As you all know,
16 Petitioner bears the burden of persuasion here and will proceed first,
17 followed by Patent Owner. Both parties may reserve time. Petitioner may
18 reserve time for rebuttal. Patent Owner for sur-rebuttal. So let me go ahead
19 and ask Petitioner, how much time would you like to reserve for sur-
20 rebuttal?

21 MR. WICHMAN: Yeah, I'd like to reserve 15 minutes for rebuttal.

22 JUDGE HAGY: Okay, and Patent Owner, how much time would you
23 like to reserve?

24 MR. SANTURRI: Five minutes would work from our perspective.

25 JUDGE HAGY: Okay, so because we're on video, we don't have the
26 light timer system. Would either of you like for us to tell you when you

1 were nearing the end of your time? I will definitely give you a one minute
2 warning. If you would like any additional warning, just let us know. And at
3 the end of each presentation, we will tell you how much time that you have
4 remaining.

5 Okay, so just a few ground rules. Because we want to keep the
6 arguments focused on the merits, counsel are directed not to interrupt the
7 other side to make objections. You may raise and discuss objections during
8 your own time for response following your sur-rebuttal. Also, so we have a
9 clear record, please let us know what slide you're on when you're presenting
10 or what exhibit or filing you're referencing and what page. Also, please
11 mute your line when you're not speaking. And maybe if it's been a minute
12 since you've last spoken, it would be helpful if you could reidentify yourself
13 for the court reporter. And then after our time is up, we will go off the
14 record. But we want to give the court reporter a chance to make sure that
15 there are no questions about spelling or any other concerns to address. So
16 please go ahead -- please stay on the line until we tell you otherwise.

17 So that's all the initial housekeeping to take care of. So with that
18 Petitioner, are you ready to begin? Okay, we assumed -- Mr. Wichman?
19 Did we lose everybody?

20 MR. GUINTA: I'm still here.

21 JUDGE HAGY: Okay. All right. And I see Mr. Santurri.

22 MR. SANTURRI: Yes, I'm still here as well. Thank you.

23 JUDGE HAGY: Thank you. Okay, Mr. Wichman, can you hear us?

24 MR. GUINTA: Your Honor, if it's okay with you, he's one office
25 over. I'm going to run in and see what's going on. Is that okay?

1 JUDGE HAGY: All right. All the famous last words about we barely
2 have technical difficulties, right off the bat.

3 MR. GUINTA: I'll be right back, Your Honor.

4 JUDGE HAGY: Okay.

5 MR. TOROSSIAN: I see that the counsel are just reconnecting right
6 now. This is Charlie from the VPC.

7 JUDGE HAGY: Okay. Okay. So we lost him. Just for a second.
8 We're doing an hour for each side. Is that my recollection? Okay. All
9 right.

10 MR. TOROSSIAN: I see the counsel connecting twice. He might
11 need to drop off on one connection. I'm sorry.

12 JUDGE HAGY: All right.

13 MR. GUINTA: He said his computer inexplicably rebooted, and so
14 it's coming back online.

15 JUDGE HAGY: No worries. Okay, I see you've got a hand raised,
16 Mr. Wichman.

17 MR. TOROSSIAN: This is Charlie from the VPC again. I'm sorry,
18 can you disconnect from both WebEx's and try to connect one more time,
19 please? Maybe I see him muted also.

20 JUDGE HAGY: Okay, Mr. Wichman, are you back with us?

21 MR. TOROSSIAN: He's probably trying to connect the audio
22 portion.

23 JUDGE HAGY: All right. Okay. Mr. Wichman, can you hear us?

24 MR. WICHMAN: Okay. Apologies, Your Honor. I'm not sure what
25 happened.

26 JUDGE HAGY: Can you hear me?

1 MR. WICHMAN: Okay, I can hear you. Can you hear me?

2 JUDGE HAGY: We can. We can.

3 MR. WICHMAN: So exactly the worst time this happened.

4 JUDGE HAGY: Well, you know, actually, it would probably have
5 been worse if you were in the middle of your argument. Or maybe you
6 missed part of Patent Owner's argument. That would be unfortunate. You
7 just missed me babbling about housekeeping, which I'm sure you're familiar
8 with. But if there's anything that you missed that you want me to repeat
9 about housekeeping. But I think you probably know our ground rules. So
10 with that, you have reserved 15 minutes for your rebuttal. So out of the 60.
11 So if you are, you're ready, you've got everything sorted away. Are you
12 ready to go?

13 MR. WICHMAN: Excellent. If you could give me a moment to open
14 with Adobe Acrobat here.

15 JUDGE HAGY: Of course.

16 MR. WICHMAN: I have the demonstratives up.

17 JUDGE HAGY: All right.

18 MR. WICHMAN: This chose to freeze up as well. I'll have to restart
19 this.

20 JUDGE HAGY: Not a problem.

21 MR. WICHMAN: My apologies.

22 JUDGE HAGY: Okay. I used to joke sometimes I think computers
23 sense the sweat through your fingertips and they crash right when you need
24 to do something critical. This is it.

25 MR. WICHMAN: It could be what happened here. This may take a
26 minute or two. I'm not sure why this is.

1 JUDGE HAGY: Okay.

2 MR. WICHMAN: Okay, now let's try this again. Okay, I believe
3 we're ready to begin here.

4 JUDGE HAGY: All right. So with that, we will hear first from
5 counsel for Petitioner, and you may begin.

6 MR. WICHMAN: Okay, well, thank you, Your Honor. My apologies
7 for the technical difficulties, but I'll begin on slide two of the Petitioner's
8 demonstratives. The 278 patent says that on July 3rd of 2007, which is the
9 critical date in this case, nobody had thought to combine multi-vehicle
10 control systems with the GPS. Now, the Patent admits that using GPS for
11 vehicle tracking was known. And the Patent admits that multi-vehicle
12 compatible controllers were known, including Flick-885. And then the
13 Patent claims to have invented using the known GPS, with the known
14 vehicle controllers and call that a vehicle tracking unit. And my apologies.
15 I'm getting alert that my computer's going to reboot. I don't see how to stop
16 this. I think what I need to do is reboot the computer in advance of this and
17 then I can make the argument. I'm not sure.

18 JUDGE HAGY: All right, well, let's take a pause.

19 MR. WICHMAN: Okay. My apologies.

20 JUDGE HAGY: No worries. We have, I think we've got like over
21 three hours blocked out for a two hour argument. So that's one of the places
22 that we do.

23 MR. WICHMAN: When I reboot this, it's going to drop off the call.
24 I'll have to like do this thing and then restart.

25 JUDGE HAGY: Understood. Okay. Go for it.

1 COURT REPORTER: Judge, while we have a second. Could you
2 tell me the name again of the judge who retired?

3 JUDGE HAGY: Kristi Sawert. S-A-W-E-R-T. If you look back at
4 the Decision to Institute, you would see her name in the caption. I just
5 wanted to point that out in case there was any confusion.

6 COURT REPORTER: Yeah. Thank you very much. I just, I'm the
7 reporter. I just want to make sure I got it right. Thank you very much.

8 JUDGE HAGY: Okay. Got it.

9 MR. GUINTA: If it's okay with you, Your Honor. I'll just be off
10 camera sitting here. He's just going to use my machine.

11 JUDGE HAGY: Not a problem.

12 MR. WICHMAN: Okay. I apologize to everybody for that. I need to
13 pull up the demonstratives.

14 JUDGE HAGY: They're up. Okay. So you really hadn't gotten very
15 far into it. So just for your flow, you want to just go ahead and start from
16 the beginning, and I think you were only maybe a minute in.

17 MR. WICHMAN: I would love to do that. Thank you, Your Honor.

18 JUDGE HAGY: Okay.

19 MR. WICHMAN: And I had the wrong demonstratives up, so here
20 we go.

21 JUDGE HAGY: Okay.

22 MR. WICHMAN: All right. Ready to rock and roll. All right, so I'll
23 try this again and we'll start with slide two on Petitioner's demonstratives.
24 So the 278 patent says that on July 3rd of 2007, which is the critical date for
25 this case, nobody had thought to combine a multi-vehicle controller with
26 GPS. So, but the Patent admits that using GPS for multi, for vehicle

1 tracking was known. And the Patent admits that multi-vehicle compatible
2 controllers were known, including Flick-885. And then the Patent claims
3 using this known GPS with the known vehicle controllers and calls that
4 combination a vehicle tracking unit.

5 So slide three, Hunt did this in 2003 and Hunt did it using
6 conventional GPS. So the Patent Owner spends its slides 47 to 49,
7 suggesting that using GPS was known. But Hunt teaches using GPS with a
8 multi-vehicle controller. And we show that in the blue outline here on the
9 bottom right of slide three, the multi-vehicle controller itself, three
10 components in Hunt, the microprocessor, the memory and the vehicle
11 communication circuit. And their mapping is not disputed. So the next
12 slide, if we turn to slide four, the alleged invention was known and obvious
13 on July 3rd of 2007. Hunt itself anticipates claim one and the other claims
14 challenging ground one, and then Flick-885 in view of Hunt renders all the
15 claims obvious, and that's ground three.

16 The yellow highlights here on slide four are the disputes in ground
17 one and ground three, and the rest is not disputed. So, for example, there's
18 no dispute that the combination of Flick-885 with Hunt meets every
19 limitation in every claim, including claim one. And the only prior art
20 mapping that the Patent Owner disputes in the POR is limitation 1-E for
21 Hunt in ground one. But the Patent Owner doesn't dispute any other
22 mapping from Hunt to any other limitation in any claim challenge to ground
23 one. And in particular, I'll point out again, there's no dispute that Hunt
24 meets limitation 1-A with the GPS disclosure and limitation 1-C with the
25 multi-vehicle compatible controller.

1 So, slide five, this will organize our discussion. We've associated the
2 disputes with the grounds where they come up on each of the three grounds.
3 We'll focus on the disputed issues. And slide seven, we'll begin with
4 ground three because it addresses all the claims, and the issues are clear cut.
5 The only question for obviousness is whether a person of ordinary skill in
6 the art -- I'm going to call that a POSA -- would have combined Hunt's GPS
7 teaching with the Flick-885 teaching of a multi-vehicle controller in July of
8 2007. And Hunt expressly described doing that four years earlier, in 2003.
9 So this combination of GPS with a multi-vehicle controller is not some
10 hypothetical thing. It had been done. It was part of the public knowledge.
11 It was part of the POSA's knowledge. And under the *Graham* framework,
12 as we showed in the Petition, forming that combination was within the
13 POSA's ordinary skill, was within the scope and content of the prior art
14 Hunt, and is no different from what the patent is claiming. Because, as we
15 just showed you, there's no dispute that the combination of Flick-885 and
16 Hunt meets every limitation in every claim in the patent.

17 Slide eight. So Hunt explicitly tells the POSA that there were many
18 advantages to adding GPS to a multi-vehicle controller. And there's nothing
19 surprising about any of this. Conventional GPS gives the vehicle location,
20 and knowing the vehicle location lets you add all kinds of location based
21 services. So adding the GPS allows the device to monitor the vehicle
22 location and facilitate services like roadside assistance, stolen vehicle
23 recovered, providing alerts that the vehicle was moved without the owner's
24 knowledge, meaning it was stolen or towed.

25 Slide nine. In the Institution Decision, you agreed that the POSA
26 would have had reason to combine Hunt's GPS teaching with Flick-885 in

1 order to achieve these many advantages. And that's the combination at
2 issue. We show that, on the top right of slide nine, the POSA would have
3 added Hunt's conventional GPS teaching to the Flick-885 controller
4 teaching.

5 Slide ten. So the Patent Owner -- we looked at the Patent Owner's
6 arguments against the reasons to combine. First, it has --

7 JUDGE GROSSMAN: Mr. Wichman?

8 MR. WICHMAN: Yes.

9 JUDGE GROSSMAN: Judge Grossman, just before we go too far
10 from your last slide nine, your point on our Institution Decision, I want to
11 just make it clear. What I'm sure you already know is that the statements in
12 our Institution Decision are not findings of fact or conclusions of law.
13 They're preliminary, based on an incomplete record and a reasonable
14 likelihood standard. They don't rise to the preponderance of evidence
15 standard that we will apply in our final decision. And so, what -- our
16 statements in the Institution Decision clearly are not our ultimate
17 determination in this case.

18 MR. WICHMAN: Yes, sir. Thank you, Your Honor. Certainly.
19 May I proceed?

20 JUDGE GROSSMAN: Yep.

21 MR. WICHMAN: Okay. Slide ten. So the Patent Owner says that
22 the POSA would not have combined GPS with a controller because that
23 would make the device slower. And there's a number of problems with this
24 argument. First, it's unsupported attorney argument. It relies on entirely on
25 this testimony from its expert, McAlexander, at paragraph 192. But that
26 declaration paragraph just repeats the language in the POR verbatim with no

1 analysis. And under the Board's precedential decision in *Xerox v. Bytemark*,
2 this testimony from Mr. McAlexander is not entitled to any weight. Second,
3 this "makes slower" argument is inconsistent with the facts, because Hunt,
4 as we explained, Hunt already made this combination in 2003. And there's
5 nothing in Hunt and there's nothing in the 278 patent itself that even
6 identifies this makes slower issue or describes how to overcome it. And
7 third, this argument is irrelevant because the law, even if there were some
8 sort of trade off to adding GPS to a multi-vehicle controller, the trade off
9 doesn't overcome the reasons to combine, because all the law requires is that
10 the combination provide a suitable option. And Hunt demonstrates that this
11 combination was a suitable option. And then in sur-reply, the Patent Owner
12 has no response. The makes slower argument has no merit.

13 Slide eleven. The Patent Owner argues that the combination in 2007
14 can only be achieved by hindsight. The idea of hindsight is just not relevant
15 here, because the idea of hindsight is that the fact finder, you, are
16 substituting your knowledge of the invention or the facts of the state of the
17 art at the time of the invention. But in this case, we have a reference, Hunt,
18 that is the state of the art that had already combined GPS with the multi-
19 vehicle controller at the time of invention in 2007. So there's no question of
20 you substituting your knowledge of the invention for the state of the art of
21 the facts. The reference explicitly teaches making the combination, meaning
22 it cannot be hindsight to recognize that four years after Hunt had added GPS
23 to a multi-vehicle controller, that POSA would have known to do it, would
24 have known how to do it, and would have known why to do it. So the
25 hindsight argument has no merit.

1 And then I'll just mention that the Patent Owner makes this ongoing
2 compatibility argument in the POR at 57, we responded in the reply at pages
3 two to three, and recognizing Judge Grossman's observation on the
4 Institution Decision, nonetheless, at institution, at page 46, in the Institution
5 Decision, you rejected that argument, and the Patent Owner has not given
6 any reason to reach a different conclusion now because there's nothing new
7 in the POR that adds anything to the arguments pre-institution. So before I
8 move on, do you have any questions on why these Patent Owner challenges
9 to the reasons combined are without merit? Okay, slide 13.

10 JUDGE DOUGAL: So I have one question. So I know you're going
11 to get into secondary considerations later, and I don't, or I assume you will.
12 If we were to find that there were secondary considerations, why would this
13 combination be enough to overcome those, you know, any secondary
14 considerations that Patent Owner has put forward?

15 MR. WICHMAN: Thank you, your Honor. That is a fantastic
16 question. And that's exactly what I was going to turn to next. So maybe I
17 should do that and then come back and ask if that's responded to your
18 question.

19 JUDGE DOUGAL: Okay, so I'll just put it on the record for Patent
20 Owner. I kind of have the reverse question also. You know, I want to hear
21 Patent Owner when it's your turn. As to secondary considerations, why
22 Petitioner's arguments aren't going to be enough. Let's go ahead.

23 MR. WICHMAN: Okay, so slide 13. So this brings us to the
24 secondary considerations. So as Judge Dougal recognized, the Patent Owner
25 argues that the secondary considerations show nonobviousness of the claims.
26 Slide 14. So again, recognize, you already recognized at institution,

1 recognizing that it was provisional, that Hunt and Flick-885, in view of
2 Hunt, provided strong evidence of unpatentability. But as a fundamental
3 issue, the secondary considerations don't help the Patent Owner here,
4 because the only dispute, the only dispute is whether the POSA would have
5 formed the combination of the GPS teaching with a multi-vehicle controller,
6 and Hunt already did it. Hunt expressly taught it and gave the reason to do
7 it. So the purpose of secondary considerations is to counter hindsight. But
8 there is no hindsight because the combination had been achieved in the art.
9 So even if you credit everything the Patent Owner says about the secondary
10 considerations, that can't erase Hunt's teachings from the prior art and can't
11 show nonobviousness under the *Graham* prong. But I'll continue on slide
12 15.

13 The combination also fits squarely within the *KSR* rationale of a
14 predictable use of prior art elements according to their established functions.
15 It's Hunt's conventional GPS and it augments Flick-885 controllers
16 providing its established function. And when this rationale applies, the
17 Federal Circuit tells us that in *Wyers* and in the other cases that we cited in
18 the Petition at page 77, as a matter of law, the secondary considerations are
19 inadequate to establish nonobviousness. And that's exactly the case here.
20 And the Patent Owner has no answer to this. So before I move on, do you
21 have any questions on why *Wyers* means that, as a matter of law, the
22 secondary considerations are inadequate to establish obviousness over Flick-
23 885 and Hunt for any claim?

24 All right, we also have arguments about the secondary considerations
25 evidence, but we will save that for the discussion of ground two. Okay, in
26 that case, let's talk slide 16. Throughout the reply, the Patent Owner makes

1 a new argument, and the Patent Owner argues that the CRU considered Hunt
2 and Flick-885 in reexam four, which is number 90/014,419, and then
3 confirmed the claims over Hunt and Flick-885. But that is not what
4 happened in reexam four. When deciding the invalidity challenge in this
5 case, you are not bound by anything the CRU did in the reexam four, and
6 nothing in reexam four changes the patentability analysis under the
7 Petition's grounds. And this is exactly what you noted in the Institution
8 Decision in the parallel Verizon IPR that is also challenging the 278 patent,
9 and we reprinted that language here on the top right of slide 16.

10 So reexam four. In reexam four, the CRU declared the ex parte
11 reexam in part. None of the questions of patentability involved Hunt or
12 Flick-885 or their combination. The Patent Owner took the references from
13 this IPR and references from the Verizon IPR and then listed them in an IDS
14 that ran ten pages with over 80 references. Filed the IDS. The Patent Owner
15 did not explain the content or the relevance of any of the references on that
16 IDS, not Hunt, not Flick-885, and the Patent Owner did not put the Petition
17 on the IDS and the Patent Owner did not tell the CRU that the IPR had been
18 instituted.

19 Now, on their slide eight, the Patent Owner says that the examiner
20 considered this IPR. What they mean is that the examiner did a litigation
21 search in the reexam. That's it. We have no idea whether the examiner
22 looked at any of the papers in this IPR. The examiner initialed the IDS and
23 confirmed the claims, but we have no indication that the examiner
24 substantively considered Flick-885 and Hunt, and the examiner's statements
25 of reasons for allowance did not involve Flick-885 and Hunt. So we point
26 out on the slide here, slide on the bottom right, the MPEP section 2256 and

1 2656, it is clear that the CRU's consideration of initialed references and
2 reexam is limited to the degree that the Patent Owner explained the content
3 and the relevance of those references. And here the Patent Owner didn't do
4 any of that. The outcome of reexam four has no bearing on unpatentability
5 in this IPR, as shown in the Petition and as shown in ground three. Unless
6 you have any questions, I will move on to ground one.

7 Slide 18. So if we turn to ground one, Hunt anticipates claim one and
8 several of these other claims. And the dispute is, the Patent Owner's
9 dispute, is whether Hunt meets its downloading interface limitation in 1-E
10 slide 19. So this is the limitation 1-E to recite the downloading interface for
11 permitting downloading of enabling data. And in the Institution Decision at
12 pages 25 to 26, you construe the term enabling data to include data that
13 otherwise enables the controller to select or generate the code.

14 Slide 20. So the Petition shows that Hunt teaches wirelessly
15 downloading and installing firmware. And specifically we reproduce the
16 language on the top right of slide 20. The firmware causes Hunt's
17 microprocessor to identify the host vehicle's communication protocol, and
18 then using that information, the microprocessor selects the appropriate
19 module in the vehicle communication circuit that can communicate with the
20 host vehicle's network. That means that the downloaded firmware is
21 enabling data because it enables the controller to select and generate the
22 vehicle device codes by identifying the host vehicle's communication
23 protocol.

24 Slide 21. In the Institution Decision of page 37, you also found that
25 data that otherwise enables the controller to select or generate the code is
26 enabling data related to the vehicle device codes. In other words, this meets

1 the language of the claim limitation. And then at pages 28 to 38, you
2 rejected the Patent Owner's arguments that Hunt failed to meet limitation 1-
3 A and nothing in the POR gives you any reason to reach a different
4 conclusion.

5 Now, slide 22, the Patent Owner does not meaningfully dispute what
6 Hunt says or how Hunt works, which we just explained. They make a
7 hodgepodge of arguments that are not responding to how the Petition maps
8 on to limitation 1-E, most of them involving the ASIC. The arguments are
9 non responsive distractions, and we just won't get into them now, we have
10 responded in the papers. Slide 23, there's a second embodiment of Hunt. It
11 involves using a cell phone that also needs limitation 1-E because Hunt says,
12 as we show on the bottom left of Slide 23, there's a data link 179 and that
13 data link connects microprocessor 27 to a vehicle communication circuit 25
14 and Hunt says to use a cell phone to provide microprocessor 27. Hunt
15 describes wirelessly downloading software to its appliance, which now
16 includes the cell phone. So software that implements processes for Hunt's
17 appliance on the cell phone, an app, is enabling data. And in response to
18 this, the Patent Owner argues that it's illogical to hardwire a cell phone to
19 the OBD-II diagnostic port, but that misrepresents what Hunt says. Hunt
20 never says that microprocessor 27 has to be hardwired to anything or the cell
21 phone that provides it. All Hunt says is that microprocessor 27 connects the
22 vehicle communication circuit by an asynchronous serial connection,
23 datalink 179, and at the time of invention POSA's knew that Bluetooth met
24 that description. Because Bluetooth provided an asynchronous serial
25 connection, it was also wireless, an ideal way to achieve what Hunt

1 describes and was also routinely used for that purpose. So none of that is
2 disputed.

3 And finally, the Patent Owner says that the cell phone disclosure is
4 boilerplate. But as you pointed out in the Institution Decision at 40, there's
5 no fault in relying on Hunt's disclosure for what it says. So now in the sur-
6 reply at pages two to three, the Patent Owner argues a new argument that
7 Hunt does not expressly disclose the term device code. Unfortunately, in the
8 Patent Owner's slides, that's slide eleven and slide 26, that becomes
9 something different, something else, where they say Hunt does not disclose
10 the device code. All right, this is misrepresenting Dr. Miller's deposition
11 testimony. At deposition, Dr. Miller was asked, does Hunt make reference
12 to device codes? And he responded, Hunt does not use the term device code
13 in the patent. So Dr. Miller never said that Hunt fails to disclose device
14 codes. And of course, it plainly does disclose using device codes, as shown
15 in the Petition.

16 So what do we do with this new argument? Well, first, it's waived
17 because it's not made anywhere in the POR. It's made for the first time in
18 sur-reply. But second, even if you consider this new argument, it fails. And
19 it fails for the reasons shown in the Petition at pages 23 to 34. The device
20 code limitation appears in limitation 1-D. And that limitation simply says
21 that the multi-vehicle compatible controller uses or is capable of using
22 vehicle device codes. This is squarely addressed in the Petition at pages 23
23 to 24. But even if you just start at page 27, the argument header is Hunt's
24 multi-vehicle compatible controller uses a vehicle device code. And
25 continues. None of the evidence cited is disputed, none of the argument is
26 disputed in the POR, and none of the testimony from Dr. Miller supporting

1 this part of the Petition is rebutted. So this is unrebutted testimony that
2 contradicts this new argument in the sur-reply. And then again, of course, in
3 the Institution Decision at pages 31 to 32, you already, you agreed that Hunt
4 meets the limitation, the vehicle device code in limitation 1-D. So unless
5 you have further questions on ground one, I'll turn to ground two.

6 JUDGE HAGY: I kind of have a question. Do you think that the
7 parties dispute that enabling data need not be device codes? In other words,
8 that the patent does not require downloading device codes themselves? Do
9 you think that the Patent Owner disputes the way that you're reading
10 enabling data as including this other type of data that helps the system select
11 the code as opposed to the code itself?

12 MR. WICHMAN: That's a great question, Your Honor. I can't -- if
13 that's the Patent Owner's position, they're wrong. We are applying the
14 claim construction that you adopted in the Institution Decision. That claim
15 construction is consistent with the intrinsic evidence in column 24 of the 278
16 patent and was also applied by the CRU in reexam where you found it and
17 adopted it, or it may have been the Board on ex parte appeal and reexam.
18 But that claim construction does not require the enabling data to be the
19 device code itself. Have I responded to your question here?

20 JUDGE HAGY: Yeah, I think you've given me your response and
21 I'll ask Petitioner. I'm sorry, I'll ask Patent Owner that question as well,
22 because I thought I saw something in there that they were disputing the way
23 that you're reading enabling data.

24 MR. WICHMAN: Okay, thank you. So if I move to, are there any
25 other questions on ground one? Okay, let's turn to ground two. Which
26 problems. All right, slide 29. So you only reach ground two if you find that

1 there is something lacking in Hunt for anticipation in ground one. And
2 remember, the only limitation that's challenged in ground one is whether
3 Hunt meets this downloading interface limitation 1-E. If for some reason
4 you find that it does not, well, then Hunt still renders obvious claim one and
5 all these other claims challenging ground one.

6 Slide 30. Specifically, it would have been routine for Hunt to
7 download programming, that is enabling data, meeting limitation 1-E. We
8 show this in the Petition at 48 and in the reply at 29. You agreed with this
9 reasoning in the Institution Decision at pages 39 to 40. In the Petition, we
10 argue about updating the firmware and the microprocessor, which is, as we
11 pointed out, a component of the multi-vehicle controller. In the Institution
12 Decision, you referred to updating a reprogrammable vehicle
13 communication circuit. So that's clearly in Hunt right, because Hunt
14 describes an embodiment that uses an ASIC to include a vehicle
15 communication circuit. Hunt specifically says the ASIC includes a
16 microprocessor, that would be a reprogrammable vehicle communication
17 circuit.

18 Slide 31. In terms of reasons to do this, set aside that Hunt explicitly
19 says the wireless download to the controller, Patent Owner doesn't dispute
20 that there were reasons to do this for wireless download, even if only to fix
21 software bugs. So the only remaining disputes now are we're back to
22 secondary considerations. Slide 33. So the secondary considerations for
23 ground two. But in its trial papers, the Patent Owner argues that this also
24 applies. The secondary considerations that they urge against ground two
25 also apply to ground three. What we say here will apply equally to ground
26 three and ground two.

1 Slide 35 so, as we discussed with ground three, the secondary
2 considerations cannot overcome obviousness under the first three *Graham*
3 factors, the level of skill in the art, the scope and content of the prior art, and
4 differences between the claims and the prior art. And under *Wyers*, the
5 secondary considerations, as a matter of law, are inadequate to establish
6 nonobviousness. But if we nonetheless look at what the Patent Owner
7 presented for secondary considerations, that evidence and the arguments fail.
8 And they fail for several reasons, which we show here on slide 35. They fail
9 to show entitlement to a presumption of nexus for any secondary
10 consideration. They fail to show nexus for any secondary considerations,
11 and the evidence they point to does not support an inference of
12 nonobviousness. So let's begin with the presumption of nexus on slide 37.

13 The Patent Owner has the burden to show that it is entitled to a
14 presumption of nexus, and that includes a burden to show that these CalAmp
15 products that the Patent Owner points to as the basis of a secondary
16 consideration are co-extensive with the claims. That means the Patent
17 Owner has to show that each of these CalAmp products is the invention
18 disclosed and claimed, is limited to the features of the claimed invention,
19 and does not include significant unclaimed features. And the Patent Owner
20 does not meet this burden for several reasons. First, waiver. Second, the
21 facts, and third, collateral estoppel. But we can start with waiver. The
22 Patent Owner waived any presumption of nexus because it never argued or
23 showed in the POR that these CalAmp products are co-extensive with any
24 claim. And under the Board's precedential decision in *Lectrosonics*, a
25 presumption of nexus is inappropriate.

1 Slide 39. So if we look at the facts. So from CalAmp's own product
2 specifications, these CalAmp products have significant unclaimed features.
3 CalAmp calls these key features three-axis accelerometer, an onboard
4 programmable event generator or alert engine. In the second appeal to the
5 Federal Circuit from the CalAmp litigation, the Federal Circuit confirmed
6 these are unclaimed features and they're significant. They are so significant
7 that the Patent Owner vacated the damages award and remanded because
8 there had been no accounting for these unclaimed features, and squarely
9 rejected the Patent Owner's argument that product sales were driven by the
10 claimed features. So the significant unclaimed features prevent co-
11 extensiveness. Without co-extensiveness, there cannot be a presumption of
12 nexus.

13 Slide 40. In sur-reply, the Patent Owner argues that it did show co-
14 extensiveness, but it does this by citing evidence that's not cited anywhere in
15 the POR, and they rely on paragraph 36. Well, in paragraph 36, their expert
16 Tregillis admits that the CalAmp products automatically detect and
17 configure the OBD II ports, but that's not a claimed feature. So if the Patent
18 Owner's own expert is telling you that the CalAmp products include
19 significant unclaimed features, that precludes co-extensiveness.

20 JUDGE HAGY: So, I have a question. So there were two jury
21 verdicts, is that right?

22 MR. WICHMAN: That's correct.

23 JUDGE HAGY: The CalAmp case. And so, the 2016 jury verdict is
24 the one that has a lot of questions that the jurors answered with regard to
25 copying or commercial success. Correct? But then that verdict was

1 appealed to the Federal Circuit. It came back for a retrial on damages, not
2 validity. Correct? Damages and validity, correct?

3 MR. WICHMAN: Damages and infringement.

4 JUDGE HAGY: Damages and infringement. So the second verdict,
5 the jury was not asked to break anything out in terms of any type of
6 secondary considerations or anything like that because validity was not
7 before them?

8 MR. WICHMAN: That's correct.

9 JUDGE HAGY: And so in the first verdict form, where they were
10 asked to do that, it was not really broken out by patent was it?

11 MR. WICHMAN: Not at all. They were asked question five about
12 the claimed invention. The case had four patents and 30 patent claims. I'm
13 sorry, go ahead.

14 JUDGE HAGY: That's it. I just wanted to make sure that I was
15 following that. It seems like there are a lot of moving parts with some of,
16 their evidence of secondary considerations. I'm good now. Okay, that's
17 right.

18 MR. WICHMAN: Well, anyway, to come back to co-extensiveness,
19 slide 41, if we look at this exhibit, CalAmp's requirement specification that
20 their expert Tregillis was citing, it's got a whole host of significant
21 unclaimed features. We've highlighted some of them here, some we already
22 mentioned. But impact detection based on MEMS data, acceleration and
23 deceleration based on MEMS data, none of this is in the claims. There is --
24 nobody could look at this requirements document and conclude that it is
25 describing a product that is limited to the claimed invention in any claim in
26 the 278 patent. And that means that there is no co-extensiveness, and

1 without co-extensiveness, there is no presumption. I'm going to skip over
2 the collateral estoppel issue and just go. Let's talk about nexus now.

3 Slide 46. So the Patent Owner has a burden to show nexus reaching
4 secondary considerations, and it did not do that. So as the Board's
5 precedential decision of *Lectrosonics* explains, the secondary considerations
6 cannot result from something other than what is claimed and what is not in
7 the claim. But there must be a nexus to some aspect of the claim that is not
8 already in the prior art. Even if that aspect is the combination itself, it can't
9 be in the prior art. And this is because nexus is the connection between what
10 they say is evidence of non-obviousness in the claim. The whole point of
11 nexus is that the Patent Owner can't rely on things that other people do to
12 show non-obviousness. They can't take credit for other people's work as
13 somehow showing the inventions are non-obvious. That's exactly what they
14 do here, slide 49. So we looked at everything that the POR identifies as
15 some aspect of the claim or feature supporting a secondary consideration.
16 We collected them here on slide 49 and then apply it to *Lectrosonics*. None
17 of these features meet the criteria for nexus under *Lectrosonics*. They're
18 not. And we've given you cites to the trial papers. The reply, the Petition.
19 I'll add another Petition, page 79 to 80. We discussed the evidence in
20 greater detail at these pages in the Petition, slide 50.

21 So here we just show these features and secondary considerations in
22 table form. And like we just explained, the Patent Owner is relying on
23 known features, also unclaimed features, and in some cases relying on the
24 hearsay deposition testimony from exhibits 2004 to 2006, which are subject
25 to the pending motion to exclude. On the bottom, I'll just point out, this
26 should probably also say for commercial success and copying, should also

1 say unclaimed. But we're pointing this out here because the commercial
2 success and copying arguments rely on the features listed above and also
3 rely on the embodiment, the CalAmp products. And we mentioned licensing
4 because their licensing evidence points to portfolio licenses of prior art
5 licenses. So that was known in the art. So there's no nexus for that. So I'm
6 not going to go into individual slides here. I will ask if you have a specific
7 question, the one that you would like me to discuss, I can do that now.
8 Otherwise, we collect the materials on these slides and at these citations in
9 the reply. Okay, so let me, let's go to slide 58. Let's talk about the
10 evidence.

11 So we looked at the Patent Owner's evidence of secondary
12 considerations, and none of it is entitled to any weight on nonobviousness
13 under the *Graham* framework. So even ignoring the fact that there's no
14 nexus for any secondary consideration, and we'll start with the reexams,
15 because over and over, the Patent Owner says that the claims are not obvious
16 because it survived. They survived reexams. Well, the CRU decisions on
17 reexam and Board decisions on ex parte appeal and two of the reexams,
18 they're not evidence, not evidence of nonobviousness. None of those
19 reexams decided a question of patentability over Hunt over Flick-885 or
20 over their combination. And those decisions are not binding on this panel,
21 as you recognize, for the reasons you explained in the Institution Decision at
22 pages 18 to 19, the *Graham* analysis is fact specific, comparing the claims to
23 the scope and content of the asserted prior art, and the prior in this case --
24 it's just different. The prior art was not in a question presented in any of
25 those reexams. So the nonobviousness findings in reexams, they're not

1 evidence, they're not binding. And that remains true for reexams for slide
2 60.

3 So the jury findings, as Judge Hagy brought up, the jury findings in a
4 verdict forum with this special question on secondary considerations, the
5 question at the top right of slide 60, those findings are not evidence of non-
6 obviousness. They're just the opinions of a different fact finder. They're
7 not binding on Geotab because Geotab wasn't a party for that litigation, and
8 they're not binding on you because you have to make your own decision
9 what the evidence shows. And it should be clear that regardless of what the
10 jury thought about the secondary considerations evidence in that case, the
11 jury did not evaluate any of that evidence against this prior art, as *Graham*
12 requires, not Hunt, not Flick-885 and not their combination. And like Judge
13 Hagy pointed out, the jury's -- the Patent Owner is relying on the jury
14 findings in response to a question about the claimed invention in a case with
15 four patents and 30 claims, none of that's tethered to any challenged claim.
16 So the jury response on secondary consideration questions, that evidence, is
17 not binding on Geotab, not binding on you.

18 Talk about copying quickly.

19 JUDGE HAGY: Yeah. Quick question. On appeal of the first
20 verdict, did the Federal Circuit have any occasion to comment on any
21 findings regarding secondary considerations? I mean, I think I pulled that
22 decision, and what I recall is that the challenge to the lack of invalidity
23 finding had to do with the way a claim was construed. I don't recall the
24 Federal Circuit commenting on any finding regarding secondary
25 considerations. Do you recall?

1 MR. WICHMAN: That's my understanding as well, Your Honor.
2 Okay, slide 61, copying. So, copying, we find on the Petition, copying
3 evidence requires evidence of replicating a specific product, and the Patent
4 Owner doesn't show anything like that. All the Patent Owner has is an
5 infringement verdict from the CalAmp litigation. But an infringement
6 verdict is not evidence of copying, as we pointed out in our Petition. And
7 again, the Patent Owner, we show you here on the side with the red
8 highlight, Patent Owner is relying on hearsay deposition testimony as, quote,
9 admitting copying. Well, you know first that hearsay is inadmissible for
10 reasons in the motion to exclude it. But you can look at it yourself. None of
11 it supports anything that the Patent Owner is saying about it. There's no
12 evidence of copying.

13 So slide 62, let's talk about the licensing. None of the licensing
14 evidence is entitled to any weight or nonobviousness. So the Patent Owner
15 identified six exhibits by their portfolio licenses for settlements. All the
16 portfolios are licensing 45 or more patents or applications. The cases that
17 we identified in the Petition at page 82 explain why this evidence has no
18 probative value for nonobviousness. And the Patent Owner has no answer to
19 this. Slide 63. So I just want to point out, there is no document that licenses
20 the 278 patent by itself. There's no portfolio patent royalty that depends on
21 the 278 patent. There's no royalty rate that depends on the 278 patent
22 because the royalty rate is the same with or without the 278 patent.

23 In Slide 64. Well, before I move on to the other exhibits, several of
24 the exhibits that the Patent Owner identifies have their own problems. We
25 discussed this in the reply to page 13. But on slide 64. So over and over
26 now the Patent Owner is telling you that its portfolio, other patents, have

1 generated large license fees. So portfolio revenues from 2004, almost eight
2 years before the 278 patent even issued, from patents, plural. All right, those
3 revenues are not attributable to the 278 patent. They're not broken out for
4 the 278 patent, the Patent Owner is passing on license revenue associated
5 with other patents as the basis of nonobviousness arguments for the 278
6 patents, and it isn't.

7 Slide 66. I'd like to point out, to remind you that in the Petition we
8 explain that there are blocking patents, specifically Flick-885 and Flick-727.
9 And the Federal Circuit tells us that when there are blocking patents, the
10 inference of nonobviousness from any evidence of commercial success is
11 weak. And it's weak because those blocking patents are a barrier to entry.
12 So any alleged failure of others to achieve the claimed invention is more
13 indicative of deterrence from the blocking patents than inventiveness. And
14 again, the Patent Owner has no answer for those.

15 So I'd like to bring the panel back to slide four here and remind you
16 right where we started, that with ground three. The only dispute is whether
17 the POSA would have combined Hunt's GPS teaching with a multi-vehicle
18 compatible controller as Hunt had already done in 2003. There is no dispute
19 that the combination of Flick-885 and Hunt means every limitation in every
20 claim. So under the *Graham* analysis, the level of skill in the art is not
21 disputed, the scope and content of the prior art is not disputed. And there is
22 no difference. It's undisputed. There's no difference between this
23 combination and everything in the claim because every limitation is met.
24 We've shown you that there's no meaningful dispute on the reasons to
25 combine, and we've shown you that as a matter of law, under *Wyers*, the
26 secondary considerations are inadequate to show nonobviousness, and the

1 Patent Owner simply has no response. So unless you have questions, I'll
2 save the remainder of my time for rebuttal.

3 JUDGE HAGY: I have that you had just under a minute left in your
4 principal time and then 15 minutes for rebuttal. So you have just a little over
5 15 minutes.

6 MR. WICHMAN: Thank you, Your Honor.

7 JUDGE HAGY: Okay, so, Patent Owner, you said that you wanted to
8 save five minutes for your rebuttal, correct?

9 MR. SANTURRI: Yes, Your Honor.

10 JUDGE HAGY: So let me, I am kind of keeping time here. So I've
11 got you set for 55 minutes, and whenever you're ready, please begin.

12 MR. SANTURRI: All right, thank you, Your Honor.

13 On behalf of the Patent Owner, I do want to go ahead and I know they
14 took their grounds out of order. I'm going to try to cover them in order just
15 because it's easier for me to keep my train of thought that way. But I do
16 want to start with sort of prior to these proceedings there was a lot of
17 discussion from Mr. Wichman and several questions from the Panel on it.
18 So I do actually want to cover essentially all the other numerous proceedings
19 and various ways where this 278 has been tested and found valid. You
20 know, there's lots of, and lots of argument about why these are relevant. We
21 do think that they are relevant. We do think that if nothing else, there's
22 certainly persuasive value to all these findings. I mean, at the end of the
23 day, I'm not sure how a Patent Owner can ever expect to have finality when
24 one party after the next can continue to bring more and more challenges with
25 similar, if not completely cumulative art. You know, stepping back to that
26 first trial, I know from the Panel, had a couple questions on it. It was a, the

1 initial trial did address validity. There were several patents at issue and
2 there were jury findings that several of the secondary considerations applied.
3 And I'm looking at slide three of our demonstratives is where we have that
4 jury question number five. Your Honor is correct, there were several patents
5 there. But nonetheless, the jury looking at well, a lot of the evidence that
6 this Panel has found that not only were the CalAmp products commercially
7 successful as a result of the claimed inventions, but there was copying and
8 there were licenses related to these.

9 Again, I don't, that doesn't necessarily, that one piece of information
10 doesn't necessarily, you know, answer the questions before this Panel, but
11 we do think you have to consider all of these issues. As the Panel noted, the
12 -- ultimately it went on appeal. The Federal Circuit sent it back for a second
13 trial. That trial did not address validity. That was only infringement and
14 damages. And at the end of that trial we had, in my mind, a much stronger
15 connection between the jury's findings and specifically the 278 patent.
16 Because some of the questions that you had about whether there were
17 multiple patents involved initially in the first trial, that is true. In the second
18 trial, the jury, and we have the verdict form on slide four, typically allocated
19 the, you know, found the number of units that specifically infringed the 278
20 and awarded damages based upon that and also found that there was no
21 infringement of other patents. Right towards the end of Mr. Wichman's
22 argument, he made reference to blocking patents and whether there was
23 some sort of waiver of that because we didn't use the words blocking patents
24 in our, in some of our papers. But ultimately, what we have said from the
25 POR and as well as the sur-reply is that that second jury found damages
26 specific to the 278 and to no other patents. So whether you want to refer to

1 them as blocking patents or simply saying this is tied specifically to the 278
2 and no other patents, we have addressed that issue. And we do believe, and
3 I'll get into this in more detail, that this does, that this is evidence of
4 secondary considerations. Namely, it gives us a point in time, and this was a
5 jury verdict in 2020, I believe, a point in time where in this case, CalAmp
6 sold over 917,000 units that are -- will infringe on the 278. And as I'll cover
7 a little bit later, it does, they are coextensive with the 278 patent.

8 So while the jury's find, let's say the jury's finding may not be sort of,
9 in the strictest sense of the word, considered evidence, we do know that at
10 this point in time, you have over 900,000 units that infringe the 278 patent
11 that were sold. Ultimately, after the second appeal, the Federal Circuit sent
12 it back again for essentially additional evidence to address the amount of
13 damages. But there wasn't a question as to the number of infringing units
14 that were going to be subject to that award.

15 JUDGE HAGY: Right now, counsel. So again, these were, you have
16 on slide three and then on slide four, these were different juries about three
17 years apart, correct?

18 MR. SANTURRI: Yes, Your Honor.

19 JUDGE HAGY: So, yeah, so I see that the jury, the second jury
20 pretty much found that all the infringement was for the 278 patents. We
21 don't really know what the first jury would have found.

22 MR. SANTURRI: Your Honor. It is correct that we don't. They did
23 not, in the first jury verdict, they did not break out their findings as to
24 particular patents. You were right. I do think that, you know, and again, we,
25 I guess the parties disagree as to the -- how important this is. But, you
26 know, we've had five re-examinations of the 278 patent. We had re-

1 examination number one, where all claims were found patentable, re-
2 examination number two, where the claims were rejected by the examiner
3 and it would appeal to the Board and it was reversed. And the Board
4 expressly relied upon evidence of secondary considerations. And essentially
5 that evidence was out of the CalAmp trial. So this is a lot of the same, some
6 of the same evidences we put before this Panel. We have reexam three
7 where again, the claims were all confirmed, reexam four. And I'll get to into
8 this. Actually, let me jump to reexam five because that's a little more
9 straightforward. Again, that was a reexam that, where the claims were
10 rejected, the Board reversed, and again, specifically relied upon secondary,
11 the same secondary consideration evidence. Reexam four is a reexam that
12 was recently concluded. I guess the parties dispute whether, what level of
13 interest the examiner took in these proceedings. You can see from the IDS
14 that the references here were all submitted. Not only that, but the
15 declarations of Patent Owners expert and Petitioner's expert were submitted.
16 The examiner not only pulled the litigation docket, but he specifically noted
17 in the record that he reviewed as of December 2023, both co-pending IPR's.
18 Of course, that was at a time where the institution decision had already been
19 rendered, and I believe both cases, certainly in this case, so the examiner did
20 have not only the references, but also Petitioner's here, their expert's
21 declaration was specifically broken out on an IDS. And nonetheless, the
22 examiner did find that confirmed patentability again referred to the
23 secondary considerations.

24 So whether certainly these, we believe all these findings are, if
25 nothing else, persuasive evidence that examiner after examiner, Board after
26 Board decision, have all found, looking at continued stream of prior art, that

1 these claims are patentable. And we don't believe there's anything
2 presented here that rises to the level not already considered previously and
3 rejected.

4 So if I'm going to start with ground one, and of course, that's the
5 argument that Hunt itself anticipates a select number of the claims. They do
6 not. The Petitioner seemingly acknowledges that there are, that Hunt does
7 not disclose the wired download interface, but they argue that reference to a
8 cell phone towards the end of the disclosure is enough to support this
9 wireless download interface. And again, this is where we really have
10 focused on the specific technology in Hunt versus what we view as kind of
11 generic background and boilerplate towards the end of the Hunt disclosure.

12 Now, turning to slide, I mean, it's slide 14 of Patent Owner's. The
13 argument that they have made is essentially that, well, the Hunt patent refers
14 to processor having firmware and makes reference to firmware being
15 downloaded, and therefore this is a download interface and can be used for
16 enabling data. We disagree with that. We think that that fundamentally
17 changes the nature of Hunt here. In Hunt, we had an application or a patent
18 where Hunt describes the advantages of using an ASIC over other types of
19 circuitry. And I don't think there's really any dispute, certainly from our
20 perspective, and also Petitioner's expert and the Board and its preliminary
21 findings all acknowledge that an ASIC cannot be changed after it's been
22 manufactured.

23 And so the fundamental distinction here is that if envisioned or if one
24 of skill in the art wanted to be able to account for new device codes for
25 differences in subsequent vehicles, like what was described in the 278
26 patent, this ability to account for vehicle devices and device codes that had

1 yet to even be released. The only way to do so is to have a download
2 interface that allows one to alter these bus communications. But nothing in
3 Hunt allows that to happen, no matter what is downloaded into Hunt. If you
4 want to accept the notion that certain aspects of Hunt, there is disclosure in
5 Hunt of being able to download firmware. And of course there are
6 references to firmware and downloading and Hunt. But what we have here
7 is we have the ability to do so with respect to some processes and not others.
8 And that is pretty specific in Hunt and so --

9 JUDGE HAGY: Counsel, so that brings up a question that I had
10 asked Petitioner. So what is Patent Owner's position on whether this
11 firmware, that you agree at least some aspect can be updated, what is your
12 position on whether that is within the scope of enabling data, as we have
13 construed it?

14 MR. SANTURRI: Your Honor, no, we do not believe that that's
15 enabling data. And I think we essentially try to address this in, among other
16 slides, slide 18 of our demonstratives. And the idea here is that no matter
17 what is downloaded to the microprocessor that's in Hunt, nothing changes
18 the ability to communicate on the data bus. Whatever came from the
19 manufacturer, whatever was initially included in that ASIC, whether it's the
20 device codes or talking to it in order to the microprocessor initiating the
21 queries to the bus, nothing different than what happened at the time of
22 manufacture can ever occur, no matter how many times or how many ways
23 you change the firmware. So while we don't dispute the Board's definition
24 of enabling data, we don't believe that that encompasses firmware. That
25 could change some of the processes in this microprocessor, but cannot
26 change any way that the ASIC talks to the data bus. And I think that is

1 really the primary distinction between the parties on this issue. And that is
2 honestly, that's why we have been so focused on Hunt's focus on an ASIC,
3 because as we've pointed out, and we have a slide on this. In fact, it's slide
4 19. Hunt specifically discloses why an ASIC would be used to reduce
5 manufacturing costs and increase reliability, and why you wouldn't use
6 discrete circuit components such as the expense and the time to fabricate and
7 failures. These are the reasons why Hunt counted use of an ASIC for the
8 vehicle communication circuit. And if the vehicle communication circuit is
9 essentially fixed at both -- fixed when it's manufactured, no matter what
10 firmware is addressed thereafter, nothing is different. There's nothing
11 different enabled by any download. And I think one of skill in the art would
12 recognize that frankly, it makes no sense to try to change the way that that
13 microprocessor speaks to the ASIC, you know, communicates with the
14 ASIC, when the ASIC can only receive and send out information based upon
15 its original manufacturer.

16 Now there are -- we also address. So I think that that addresses one
17 aspect of Petitioner's argument in terms of this idea that it's element 179
18 essentially reflects the download interface. I think the other part of this is
19 when we're talking about the essentially trying to graft on the various
20 generic boilerplate that's found in Hunt to really fundamentally change the
21 specific descriptions that are provided in Hunt as to the structure. If you
22 take a look at our slide 22, slide 22, we've provided essentially a graphical
23 representation that we're, the Petitioner has identified the multi-vehicle
24 compatible controller as inclusive of the microprocessor. And they argue
25 that this element 179 could be performed via cell phone. That doesn't make
26 a whole lot of sense because nothing -- because the ASIC can't be changed,

1 nothing that comes in or out of that 179 to the vehicle communication circuit
2 would alter the programming in the ASIC. So the idea that you would take a
3 cell phone and try to download firmware or codes or anything else to the
4 vehicle communication circuit is pretty illogical because it simply cannot be
5 done. That's why Hunt focused on an ASIC and in fact had unique custom
6 ASIC's that were envisioned by this invention.

7 When we asked the Petitioner's expert about this, he basically said,
8 well, if you wanted to make those changes, you would just have to redo the
9 whole ASIC, which again doesn't, is completely divergent of the idea of
10 being able to download enabling data to make changes when changes occur
11 in the marketplace. Essentially the idea that when a manufacturer comes out
12 with new codes and new devices, you want to be able to, the idea of the
13 inventor was to be able to react to that and be able to make updates, to
14 address those changes in what was available commercially. And that's
15 simply not what Hunt provides or establishes to one ordinary skill in the art.
16 If we take a look at turning to slide 23, there was another, I thought one
17 other issue that we take with Petitioner's theory is this idea that element 179
18 could be via Bluetooth. But at least our interpretation of the multi-vehicle
19 compatible controller is that that structure is in the vehicle. So I'm not --
20 they seem to take the position that you could actually have the
21 microprocessor that's involved, that's part of the multi-vehicle compatible
22 controller as somewhere outside the vehicle, and that you would use a
23 Bluetooth interface that you would install with the ASIC and then separately
24 have it with your cell phone, and that would all be part of a multi-vehicle
25 compatible controller. I think that contradicts their own picture, their own
26 markups of the drawings, and it contradicts the language of the patent that

1 talks, really references this as a tracking unit for a vehicle and the bus
2 communicating throughout the vehicle. I don't know how you interpret that
3 into essentially a remote component being part of this multi-vehicle
4 compatible controller. So we think that the arguments that somehow a cell
5 phone could be, could essentially take the place for part of this multi-vehicle
6 compatible controller just seem contradictory to positions they took earlier
7 and also contradictory to what's in the disclosure itself.

8 And again, we come back to this idea that where, slide 25, that
9 Petitioner really just continues to turn to the boilerplate. And really, if you
10 sort of look at the boilerplate and Hunt as a whole, he almost said pretty
11 much anything that anything with an electronic circuit that man could come
12 up with that could also be part of my invention. Because you have so many
13 or's, and in parts, and in wholes that may be used here, there or everywhere
14 else, really just recited every possible type of circuitry. And they want to
15 sort of latch onto this and override these specifics that were described in
16 Hunt as a way to read in the download interface as part of their ground one,
17 anticipation. And I think part of that is to avoid having to deal with
18 secondary considerations that are -- that they cannot address in the context
19 of grounds two and three. Because as I'll go through in a little bit, we
20 believe that there are significant evidence of secondary considerations.

21 Now, there was one additional argument that Mr. Wichman brought
22 up, and this is the question of device codes, and whether they're, whether
23 Hunt disclosed device codes. I think the discussion and the arguments that
24 have been made is that there is no disclosure of device codes in Hunt. And
25 because of that, the only conceivable location for device codes has to be
26 within the ASIC. And again, this comes back to sort of our main, our

1 primary point, which is within ASIC, they can't be changed. And so
2 certainly to the extent that enabling data is device codes themselves, there's
3 no way that Hunt could alter those. And even to the extent that enabling
4 data is related to the use of those device codes, changing the firmware and a
5 microprocessor outside of this ASIC would not alter anything about the
6 ability to use device codes to speak on the vehicle because the device codes
7 were set from the outset and can't be changed by subsequent download.

8 Turning to their ground two, essentially, ground two acknowledges
9 that, essentially relies upon, again, relies upon the same boilerplate, the same
10 disclosures, but argues that one of skill in the art would just read this generic
11 boilerplate and go ahead and add, go ahead and add this download interface.
12 Again, I think their problem here is that there is no, there is no relationship
13 between the boilerplate and enabling data. There's no relationship between
14 the firmware references by Hunt and enabling data. And as we note on slide
15 31 of our demonstrative, there's no motivation for a person ordinary skill in
16 the art to download enabling data if the ASIC is not modifiable. There's no,
17 you know, the fact that the fact that download interface it is possible to
18 download firmware or software into circuitry, generally speaking, does not
19 provide the person of ordinary skill in the art any reason to do so here, where
20 Hunt has made clear that the vehicle communication circuit is going to be
21 fixed and can't be modified.

22 Alternatively, there are parts of Hunt that do make sense as to why
23 one would download firmware, because as we've noted in our POR is that
24 the, there is specific discussion of modems and being able to swap out
25 different modems to be able to access different networks. So certainly in
26 that context where the, where Hunt specifically says that that firmware is

1 used to enable the communication essentially between the Hunt device and
2 the outside world. In that context, it makes sense to be able to download
3 firmware as you alter the modems or other communications between device
4 and the outside world. But it certainly makes no sense to a person of
5 ordinary skill in the art to try to alter or download enabling data when you
6 can't actually change the way this device speaks on the bus or communicates
7 on the bus.

8 JUDGE HAGY: I have a question. So I'm looking at the claims of
9 Hunt and yes, a lot of the claims they recited an ASIC, but there are some
10 embodiments that are claimed that don't recite an ASIC. And so wouldn't
11 that provide some information to the ordinarily skilled artisan that not
12 necessarily limited to an ASIC that the, what they refer to as boilerplate is
13 actually supporting the disclosure for that? For example, I'm looking at
14 claim 35, in contrast, because it reflects a vehicle communication circuit and
15 electrical communication with a microprocessor. And then there are
16 modules that perform different functions. Contrasting that with -- I'm
17 having issues with, okay, there you go -- contrasting that with claim one,
18 which does recite an ASIC, for example.

19 MR. SANTURRI: Just a second here, Your Honor, I'm pulling those
20 up so I can take a quick look at them.

21 JUDGE HAGY: Yes, suddenly my Adobe is super slow.

22 MR. SANTURRI: Well, you know, I think that part of this is, you
23 know, part of the issue here is making sure that we consider the prior art as a
24 whole. And while I do recognize that Hunt is a little vague in claim 35 as to
25 what the specific substrate is that he's referred, because obviously you have
26 the microprocessor supported by a substrate and the vehicle communication

1 circuit there as well, the detailed description that Hunt provides is always in
2 the context of an ASIC or other circuitry that sticks, such as transistors. So I
3 just don't think that there's any support in Hunt to suggest that this is not
4 fixed circuitry when it comes to the vehicle communication circuit itself. If
5 you're looking at the reference as a whole.

6 Now in terms of ground two, obviously with both ground two and
7 ground three, we'll be dealing with the obviousness and we're dealing with
8 secondary considerations. And so I do want to address those more fully
9 here. Obviously, we've talked about some of the right up front. I talked
10 about some of the jury conclusions because of the fact that the Panel had
11 some questions on that. There are, you know, one of the issues that was
12 raised by Mr. Wichman was licensing. It's true the 278 has been involved in
13 a number of portfolio licenses. But as Mr. Tregellis pointed out -- and Mr.
14 Tregellis was the damages expert for Omega in the two CalAmp cases, so
15 he's pretty, he's, you know, for years been familiar with the, with Omega's
16 licensing -- as he pointed out, that even as the 278 essentially became the
17 last of the patents as part of those portfolios, the royalties remain the same.
18 So it is true that the 278 is one of the number of patents in there. But
19 nonetheless, people licensees paid all the way through the end of the 278
20 patent when that was essentially one of the only patents, if not the only
21 patent, I think Mr. Tregellis said was the final patent left in some of those
22 portfolios that generated, at last we checked, \$71 million. So this basically
23 comes down to a question of weight. And certainly the 278 is licensed, has
24 generated licensing revenue. But I do recognize that there are, we do
25 acknowledge that there are other patents in these licenses.

1 You know, I think that really a lot of the secondary considerations, we
2 can only present so much through these proceedings in terms of CalAmp and
3 the developments. But that really is the sort of the best or the most
4 accessible evidence that we have in the context of evidence of secondary
5 considerations, because we actually really had documentation from the, from
6 the inception of these infringing products all the way through. And so for
7 example, when you take a look at the slide 36 of our, of our demonstratives,
8 this is an excerpt from CalAmp's developmental documents. So these were
9 internal documents when they were initially developing this product, where
10 they recognized that there was this need for an OBD II product that was
11 updatable, you could actually make updates that's discovered in this
12 development document. So this is an OBD II product that can be updated as
13 need be, like with the 278 patent and provided the value added proposition
14 of GPS tracking in cellular. So this really was, I mean, essentially their
15 development documents for CalAmp essentially almost go down the list and
16 check off the elements for claim one of the 278 patent in the sense that you
17 have this updatable OBD product and you integrate GPS and cellular
18 communications into it.

19 Not only do we have their internal documents, but we then have for
20 example slide 37, the CalAmp, their press releases describing this new
21 product that they're launching for a segment of the market and anticipate
22 that to be available for use in commercial and consumer auto insurance
23 applications. So again, we had essentially this market participant
24 recognizing the consumer need for really the product as a whole. I know
25 that sort of throughout much of their papers and in their arguments,
26 Petitioner really wants to try to carve up the invention and talk about it in

1 discrete pieces. But you know, going back to *KSR* and various other cases
2 that talk about essentially every invention is going to have to build on known
3 pieces. And the question is, was it novel to put those things together? Were
4 there others that recognized the need to put all of these elements together?
5 So here we have an upload and updatable OBD to multi-vehicle compatible
6 controller combined with GPS and cellular. CalAmp certainly believes that
7 that was something this market participant that was not out there and was not
8 available.

9 We do also reference testimony from engineers involved in the
10 development, and we disagree with Petitioner's position that this is hearsay
11 because these are these statements, the testimony of these engineers is really
12 offered to provide their belief or their belief and their motivations behind the
13 development and their recognition of what they believed the market actually
14 desired. And so we have testimony, for example, on slide 38 about the
15 market need from their customers. And of course this is reflected in both
16 their development documents and their press releases. And as well, we had
17 Mr. Tregillis who took a look at someone who's sort of more focused on
18 damages and market needs and the advertising and sales side of the equation,
19 as opposed to technical experts. He offered a declaration in this case where
20 he really addressed, where he had sort of pulled all these pieces together and
21 recognized that of course, this reflected a market desire for this technology.
22 And at least according to the market participants that we looked at, wasn't
23 available from others. And that was from CalAmp's perspective, they
24 believed that this was something that was new to the market.

25 On slide 39, we also talked about the fact that there were no design
26 arounds and we had engineers that told us that they didn't come up with

1 alternative designs. And we think that this is offered for a non-hearsay
2 purpose. But we also had the discussion internally within CalAmp. That's
3 the email snippet at the bottom of slide 39 that I don't believe Petitioners
4 have objected to is hearsay. Where they're internal folks recognized claim
5 13 of the 278 related to how they actually downloaded the information in
6 their unit, the factory, and it was going to be harder to avoid that. Again,
7 this just reflects the idea that there were, that they did not recognize there to
8 be design alternatives for it. We have a number of, ultimately, we have all
9 this secondary consideration evidence. The number of decisions from
10 *Graham v. John Deere* to *Mintz v. Dietz* that we've cited, all recognize that
11 secondary considerations have to be considered in the context of
12 obviousness. But we have Mr. I'm sorry, Dr. Miller, the Petitioner's expert.
13 He acknowledged in deposition that he didn't offer any opinions in response
14 to Mr. Tregillis, our expert, who sort of compiled and offered his opinions
15 on secondary considerations. In fact, Petitioner's expert gave the impression
16 that he had specifically avoided this sort of thing because he, you know, if
17 you take a look at his little snippet of his testimony on slide 42, he suggested
18 he wasn't even familiar with whose opinions were presented in exhibit 2014,
19 but he specifically said he didn't consider those opinions as part of his
20 analysis.

21 And similarly, we went through and inquired whether he considered
22 any of the evidence of commercial success, the evidence of customer need
23 and the limited value of the products without the technology, and also
24 whether he considered the lack of available alternatives. And in response to
25 each of those, he said he did not consider those. So, you know, taking a look
26 at slides 42 to 44 from the Patent Owner here we have an expert for the

1 Petitioner who essentially refused to look at any evidence of secondary
2 considerations. And so I think that that is an issue here because you have,
3 for example, the argument that there were these supposed significant
4 unclaimed features that are in the CalAmp products, but there is no
5 testimony, there is no evidence from Petitioner that these supposed
6 unclaimed features are significant at all. And I think that was a question
7 from the Panel early on about how you should address these secondary
8 considerations. I think here we have essentially unrebutted evidence of
9 secondary considerations because we have testimony from our experts and
10 testimony that's provided as part of this overall context from CalAmp and
11 from those trials and from the development of those infringing products, that
12 all evidence, all are part of the evidence of secondary considerations. And
13 there is no response from any expert or through any evidence from Petitioner
14 on that front. They are more focused on just trying to argue that you should
15 ignore it as opposed to trying to address the evidence itself.

16 I do think that in the context of some of the challenges to it, for
17 example with co-extensiveness and those issues, you have to recognize here
18 that we've, I think both sides briefed this, really the question is, are the
19 claims essentially covering the patented product? I'm sorry, the infringing
20 product or are the claims essentially a component claim? And it's
21 something less than what was actually being sold. And here we know that
22 the products themselves are all that was claimed. For example, it is a one
23 solitary piece was the tracking unit that includes the multi-vehicle
24 compatible controller, the GPS, the cellular or wireless communication, the
25 downloaded interface. All of that is reflected by these CalAmp products.
26 There were some slides, let me see if I can locate a couple of those. The

1 Petitioner focused on several slides, for example, to argue that these are not
2 coextensive and that essentially we had to use the words coextensive in our
3 arguments in order to establish this. I don't think that that's the test. The
4 question is, does the evidence establish that the products were coextensive?
5 And we have provided the evidence to show that these CalAmp products go
6 down the line and tick off each of the elements that are found in the 278
7 claims.

8 There's also, they also have argued that the second CalAmp decision
9 somehow sort of answers the question on co-extensiveness. And I think
10 there are a couple problems with that. First, the first problem that is the fact
11 that in the second CalAmp case, invalidity was not an issue. This was not a
12 question for a jury or anyone else. Instead, the question was the question
13 that the -- well, the relevant question. There were other issues that arose in
14 other aspects of the second appeal, but the relevant question here that the
15 Petitioner has raised is whether the finding that, whether the finding by the
16 Federal Circuit that more evidence was needed in order to address the
17 question of apportionment and the amount of damages somehow impacts
18 whether the question of secondary considerations, and I think that these are
19 two separate, these are two separate inquiries. As, as Judge Hagy has, I
20 believe, recognized in one of her questions, the question of invalidity was
21 not an issue here and therefore the jury wasn't asked in the second case to
22 address any of these issues.

23 Now, I do also want to highlight the fact that the -- find my full quote
24 here. So on a couple, I think the same snippet occurs in several of the
25 Petitioner's slides. The one I'm looking at is 42, where they quote part of
26 the CalAmp decision underlining the notion, essentially saying that the part

1 that they quote is a reasonable jury. Omega argues a reasonable jury could
2 have concluded the infringing LMU sales were driven primarily, if not
3 exclusively, by the invention of the 278 patent and determined to apportion
4 minimal, if any, value to other characteristics. And then the quote ends with
5 a dot, dot, dot. And we disagree. I think that there's an important excerpt
6 there that is relevant because I think that this completely twists at least my
7 view of the ruling of the Federal Circuit. Because after you get to this part
8 about the other characteristics, the Federal Circuit said the rule of that
9 Omega argues what the Petitioner states and then goes on to say in that a
10 reasonable jury could have concluded that the multi-vehicle compatible
11 feature was worth anywhere from almost the entire profit of the product to
12 \$7 to \$626 to \$5 value that was awarded. We disagree. Now that we
13 disagree part that's highlighted and bolded on, for example, slide 42, I
14 believe, is the Federal Circuit disagreeing with the notion that the multi-
15 vehicle compatibility is the only function that drives the cost here. I think
16 that these slides that make this reference and excerpt that part are misleading
17 because I think that the Federal Circuit addressed whether one feature,
18 multi-vehicle compatibility, was the entirety of the value, and they seem to
19 say that it was not. Or if it was, Omega needed to better document it
20 whenever it went back for a third trial. Of course, multi-vehicle
21 compatibility was one of several of the patented features here.

22 And so, the notion that we get from, for example, slide 42 I think is
23 incorrect and inconsistent with this CalAmp ruling. There's no doubt the
24 Federal Circuit sent Omega back to better document the damages to provide
25 whatever additional evidence Omega was going to present at a third trial,
26 which did not occur. But the Federal Circuit did not suggest that anything as

1 it pertains to the nexus and the co-extensiveness of the claims versus, versus
2 secondary considerations. And I do think it's also notable that in the first
3 case, where there were four patents, the jury came back with a higher
4 number, a higher per unit damages number than when they came back on
5 just the 278 and that one unit of the 727. So even the second jury awarded a
6 lower damages number, but nonetheless still \$5 a unit tied specifically to the
7 278 patent.

8 I do want to turn to the third ground, and that is the combination of
9 Hunt with the Flick-885 patent. And I think the primary issue here is the
10 idea that, well, gee, everybody knew about GPS and multi-vehicle
11 compatible controllers were known. And so therefore, this is in hindsight,
12 this is simply the combination of this. And in fact, Petitioner offers slides
13 that suggest that Hunt envisioned this combination years earlier. That's not
14 what happened here, because from our perspective, and obviously we have a
15 dispute here, but our view of this is that Hunt doesn't have any disclosure of
16 a download interface for enabling data. And so Hunt certainly didn't
17 envision the idea of including this multi-vehicle compatible controller that
18 could be updated in the future along with GPS. So I don't think you can
19 look back to Hunt for a motivation to combine these when Hunt didn't
20 recognize the combination at the time. I think that what we have here is you
21 had in the context of the 278. So at the time of filing, the examiner had
22 before him multi-vehicle compatible controllers, multi-vehicle OBD
23 technology from the inventor himself. And that's all disclosed in the context
24 right in the background of the 278 patent. And the examiner also had
25 probably half a dozen patents that all referenced GPS and provided for GPS
26 as prior art to the 278 patent. And the examiner recognized that there was

1 no motivation to combine GPS with the multi-vehicle compatible, updatable
2 multi-vehicle compatible controller presented by Flick.

3 And I think, for example, if you've given the Board a couple of
4 figures from the various prior art that were considered from the outset, for
5 example, on Slide 48, the Spaur reference Slide 49 to Berard, both of these
6 disclosed GPS. And frankly, if you look at the Spaur patent, you can see
7 that on Slide 48, you can see that there was a multi-vehicle compatible data
8 bus, there was a controller, and there was GPS. And really this is essentially
9 the same as what Hunt offered, because you have cellular communication,
10 you have GPS, you have the controller, you have the bus, the multi-vehicle
11 bus. And the examiner recognized that wasn't good enough at the time, that
12 one of ordinary skill in the art wouldn't have combined these in the way that
13 Mr. Flick did. So certainly it's easy with now almost, what is this about 17
14 years later, we can say, of course one ordinary skill in the art would have
15 recognized to do this, but at the time when the examiners had the same basic
16 art before them, they recognized that there was no reason for one of skill in
17 the art to make this combination.

18 JUDGE HAGY: I'm sorry to interrupt. But you might want to take a
19 break and have some water. You've been talking for a long time. So on
20 slide 48, the Spaur references. Was this a reference that was actually
21 discussed by the examiner in the prosecution history and found that it was?

22 MR. SANTURRI: I don't know if I know the answer to that question
23 off the top of my head. I don't remember if this was one that was in the, that
24 was, let's see. So this was a reference that was cited by the examiner in the
25 original prosecution. I can certainly, during my, during Mr. Wichman's
26 rebuttal time, I can take a look back to see if I can see whether there was a

1 specific discussion of this in the prosecution's history. But I can tell you
2 that, you know, just based upon the patent itself, that this was cited by the
3 examiner during the original prosecution.

4 JUDGE GROSSMAN: Mr. Santurri, this is Judge Grossman. I just
5 want to go clarify my understanding of your consideration of Hunt and
6 Flick-885 and it goes back to what you put on your slide eight based on
7 some of the re-examinations. In your slide eight, you make reference to the
8 fact that the examiner considered this IPR, which I think is this IPR that
9 we're considering now the 504 case that the examiner considered a
10 combination of Hunt and Flick-885 and secondary considerations. And then
11 your next bullet on slide eight is the examiner confirmed the patentability of
12 the claims of the 278 patent. My understanding is that the references before
13 the examiner and re-examination number four on your slide eight, official
14 title is re-examination 90-014,419, and were not Hunt and not Flick-885 or
15 either alone or in some combination. And in our Decision to Institute on
16 page 15, we said that neither party has presented any evidence that Hunt was
17 before the Office during re-examination proceedings. Was our statement in
18 the DI wrong or is your statement wrong on your slide eight that Hunt was
19 before the examiner in re-examination number four?

20 MR. SANTURRI: I'm going to say no to both of those questions,
21 Judge. The statement in the Institution Decision was not wrong at the time
22 that reexam number four was instituted, the Hunt was not before, was not the
23 basis of the initiation of the ex parte reexam. However, after -- during that --
24 during the re-examination process, at re exam four, the Patent Owner
25 submitted Hunt, resubmitted Flick, which of course is part of the
26 prosecution, which is part of the background and would have been before

1 him implicitly anyway, but nonetheless resubmitted Hunt and Flick. The
2 declaration of Dr. Miller that puts, that essentially lays out these
3 combinations and also notified the examiner of the co-pending IPR's, which
4 the examiner specifically noted in that he reviewed on December 12th, 2023.
5 So after this Board's Institution Decision. So that's so, no, you weren't
6 wrong in your initial decision because it wasn't before him at the time. It is
7 our position that by virtue of providing these references to declarations and
8 notifying the examiner of these ongoing IPR's and him specifically noting
9 that he reviewed these IPR's, that those are things that he considered. So
10 that's the basis for my statement on slide eight, is that he did have these
11 references, he did have the combination as presented by Dr. Miller, as well
12 as these Board proceedings as of December 12th, 2023.

13 JUDGE GROSSMAN: Was that the Hunt alone or the combination
14 of Hunt and Flick-885? Was that the basis for the re-examination, challenge
15 and re-examination four?

16 MR. SANTURRI: No, Your Honor, it was not the original basis. But
17 once, as that proceeding was ongoing, we submitted the references and the
18 declarations and notified him of the co-pending IPR. So from our
19 perspective, he was on notice of these by virtue of us alerting him to it and
20 him actually reviewing it, as noted in his search notes.

21 JUDGE GROSSMAN: Is that sort of like having submitting an IDS
22 in the prosecution of an application that the examiner initials? I considered
23 20 page IDS with 50 references listed as being before the examiner.

24 MR. SANTURRI: I think it's a little more specific than that, because
25 in his search notes, he specifically stated that he reviewed IPR2023-504 and

1 IPR2023-1162. So that's not him simply initialing the IDS. He actually
2 noted in his search notes that those were reviewed, he undertook.

3 JUDGE GROSSMAN: Thank you.

4 MR. SANTURRI: And to go back to the earlier, the earlier question
5 from Judge Hagy, the Spaur reference was specifically considered in the
6 context of reexam. Not only was it referenced in the -- it was specifically
7 considered in re-examination number one.

8 So just to sort of wrap it up, because I think I'm about out of time, in
9 terms of ground three, you know, from our perspective, we believe that the
10 Petitioner failed to provide a technical rationale for combining GPS with
11 Flick. We don't think that Hunt was directed towards monitoring the vehicle
12 and analyzing GPS and diagnostic data. It wasn't -- and doing that through
13 use of an ASIC. It wasn't directed towards the advantages and the problems
14 that even Petitioner acknowledged in the 278, which was this idea of being
15 able to update the device and have ongoing compatibility through the life of
16 the device by adding the download interface. And so based upon this
17 information as well as our written papers, we think that the claims should be
18 confirmed as a result of this IPR.

19 JUDGE HAGY: Okay, thank you, Mr. Santurri. You finished at
20 exactly 55 minutes, so you have five minutes remaining for your sur-
21 rebuttal. Okay, so, Mr. Wichman, you had saved 15 minutes. I think I had
22 you at just a little more than that left. So whenever you're ready. And
23 you're muted, sir, following original instructions. I do appreciate that.

24 MR. WICHMAN: Okay, well, thank you, Your Honor. So I'll start.
25 Let me just start by addressing this idea of a downloading interface that Mr.
26 Santurri already just mentioned. So in the Petition at page 37, we identified

1 the downloading interface in Hunt. And it's not the cell phone and it's not
2 the data link 179. It is specifically a wireless modem and a universal modem
3 adapter. That's the first embodiment in Hunt. The second embodiment with
4 the cell phone. The cell phone provides the hardware that does the wireless
5 downloads. So there is a downloading interface. What I thought I heard Mr.
6 Santurri say was that he seems to argue that the value of adding GPS to a
7 microcontroller is whether the controller is updatable via a downloading
8 interface. But that's not responsive to the reasons to combine that are
9 articulated specifically in Hunt itself. Mr. Santurri said that they had no
10 finality because they had gone through these reexams. And yet the
11 patentability of their patent is still challenged here in this proceeding. Well,
12 they seriously sued a bunch of patent defendants. Now they sued Geotab.
13 This is Geotab's first chance to challenge the validity of the 278 patent
14 claim.

15 Let's talk about secondary considerations as relevant to grounds two
16 and three. So in the Patent Owner Slide 36, Mr. Santurri said that the
17 CalAmp development document that they were describing a product, that is
18 exactly what they claim to have invented. But look at what he's pointing to,
19 because that describes the prior art, Hunt, exactly. So what Mr. Santurri is
20 relying on very clearly is technology and features that were known in the art.
21 So there's no nexus under *Lectrosonics*. And in fact, I didn't hear a single
22 explanation of how the Patent Owner meets the test for nexus under
23 *Lectrosonics*. All they say is that there are these CalAmp products and the
24 CalAmp products infringed. But that's not enough as we showed you. Let's
25 talk about these other reexams.

1 In other reexams, the prior art with GPS was cited for uses that did not
2 involve a vehicle controller. But that's not relevant here because Hunt
3 specifically is using a GPS with a multi-vehicle compatible controller. And
4 remember that that's not disputed. That's limitation 1-E and 1-C in the
5 claims and Hunt meets it. If we could turn to ground one, there were a
6 number of statements about Hunt and its use of an ASIC. So if you could
7 turn to the Petitioner slide 67, the first point that I'll make, exactly as you
8 pointed out, Judge Hagy, exactly as you pointed out by referring to Hunt
9 claim 35, is that an ASIC is not required. And I mean this is the most
10 relevant language in the specification. On the right side of slide 67, an ASIC
11 is an alternative. And the only thing that Hunt describes that ASIC as
12 including is circuitry that provides the same functionality as off the shelf
13 transceivers, which we explained in Dr. Miller's reply declaration.

14 But if you can look at the Petitioner slide 68, Hunt is very clear that its
15 ASIC includes a microprocessor. Now if you want, no matter how you want
16 to deal with that, if you want to say, well, that's not a conventional
17 understanding of an ASIC, it doesn't really matter because that's how Hunt
18 used term in the patent right here on the bottom left of slide 68, the ASIC
19 features a microprocessor on the right on the bottom of slide 68, claim 63
20 and Hunt the ASIC comprises a microprocessor. So of course, of course
21 programming that is wirelessly downloaded to Hunt for that microprocessor,
22 whether it be in the ASIC or somewhere else, is going to change what the
23 ASIC does and how the ASIC works. I heard Mr. Santurri say that nothing
24 changes the ability of Hunt's multi-vehicle compatible controller to
25 communicate on a data bus. And he's referring to that firmware that we
26 discussed. Let me find the slide here.

1 Slide 20 on the top right. Well, what Mr. Santurri is saying is the
2 exact opposite of what Hunt is describing. Because if Hunt's
3 microprocessor does not identify the host vehicle's communication protocol,
4 and if Hunt's microprocessor does not select the circuit that's compatible
5 with that host vehicle communication protocol, then nothing can
6 communicate over the host vehicle data bus to the multi-vehicle compatible
7 controller. That's why the firmware that Hunt describes wirelessly
8 downloading to the micro -- multi-vehicle controller is enabling data under
9 the correct instruction of the term. And so, if we go back to slide 68 in the
10 Patent Owner demonstratives, this idea that the microprocessor includes --
11 the ASIC includes a microprocessor.

12 So even in the embodiment where Hunt uses an ASIC, and the
13 embodiment where Hunt's ASIC includes a microprocessor, that ASIC is
14 clearly modifiable. And so that directly contradicts what the Patent Owner
15 is telling you on their slide 31, which is that the ASIC is not modifiable.

16 And so finally, I'll just come back to slide four of the Petitioner slides,
17 if I could. So again, I'll remind the Board that there's no dispute. There's
18 no dispute. Every single limitation in every single claim is satisfied by the
19 combination of Flick-885 and Hunt. The reasons to form this combination
20 are right there in Hunt itself. The law doesn't require the reason to combine
21 to be in the reference. It could be known in the art, but here it is, it's right in
22 the reference. That's the basis of the ground. And there's no meaningful
23 dispute that there were reasons to do it. Hunt says why to do it, and the
24 POSA knew how to do it because Hunt had achieved it four years before the
25 invention date.

1 Here, the secondary considerations, I haven't heard any answer to
2 why or how the secondary considerations avoid what the Federal Circuit has
3 told us in *Wyers*, that the secondary considerations, because we meet the
4 *KSR* rationale, that applies in *Wyers*, the secondary considerations, as a
5 matter of law, are not entitled to, are inadequate to establish nonobviousness.
6 And I haven't heard a single answer from Patent Owner, not in the papers
7 and not in argument today.

8 So let me ask the Panel now, are there any issues where you have
9 questions that I could address at this point? Okay, if not, let me thank you
10 for your time, and that will conclude our argument with us. Thank you.

11 MR. SANTURRI: Judge Hagy, you're on mute. I'm sorry, I didn't
12 hear you. I didn't catch that.

13 JUDGE HAGY: You have five minutes for your sur-rebuttal.

14 MR. SANTURRI: Thank you. Ultimately, from our perspective, we
15 think Petitioner ignores all evidence of secondary considerations, ignores
16 multiple other findings confirming the patentability here with essentially
17 cumulative art to what we have here, and offers no reason why this Board
18 should reach conclusions not found by others. I do want to go back to one
19 thing that Mr. Wichman said. He talked about this 68 of Petitioner slides.
20 He talked about the idea that claim 63 incorporates the microprocessor in a
21 single ASIC. And I understood him to be saying that that meant that you
22 could in fact modify this ASIC because it has a microprocessor. I think
23 that's the opposite of what actually happens here. His expert confirmed that
24 an ASIC can't be modified.

25 So if the microprocessor is part of the ASIC, and that may be slightly
26 unusual, but if your microprocessor is part of the ASIC, it cannot be

1 modified. There is no firmware update that go to it. It is fixed as of the date
2 of manufacture, and really further supports our understanding, our
3 interpretation of Hunt, that what he designed is the idea of a device that
4 operates as an ASIC. It makes it more reliable and cheaper because it's
5 fixed initially and cannot be altered thereafter, and certainly can't be altered
6 with enabling data through a download.

7 So for all of the reasons that we provided, I thank the Panel for your
8 time and your consideration. And we believe that the evidence and the
9 arguments before you provide you with the proper rationale, or the proper
10 rationale and motivation to be able to confirm these claims, especially in
11 light of cases such as *Mintz v. Dietz*, that really require a strong
12 consideration of the secondary considerations.

13 JUDGE HAGY: Okay, do we have any, I don't think we have any
14 other questions for you guys. So with that, that will officially conclude the
15 hearing. And we thank you very much for your very helpful presentations. I
16 also personally found the slides to be thorough and helpful. So thank you
17 for that. So, we now consider the case to be submitted, and we will issue a
18 final decision in due course. So on the official part, we are adjourned. But
19 as I mentioned at the beginning, please stay on the line and I will ask the
20 court reporter if you have any questions or clarifications.

21 (Whereupon, the proceedings at 3:20 p.m. were concluded.)

IPR2023-00504
Patent 8,032,278 B2

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