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Subject: Geotab USA, Inc. and Geotab, Inc. v. Omega Patents, LLC, IPR2023-00504; Patent Owner's Request for Director's Review
Date: Friday, August 16, 2024 1:30:15 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)

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Dear Honorable Director,

As outlined in Section 3.A of the *Revised Interim Director Review Process*, Petitioner provides this priority-ranked list of two issues for which Petitioner seeks Director review (Paper 46), and a brief explanation for each:

1. Whether ensuring finality and consistency in USPTO proceedings is a matter of compelling legal policy, where the repeated filing of “new” challenges using cumulative references are essentially used to “forum shop” for a favorable panel, leading to an inconsistent decision by the USPTO in this proceeding.
2. Whether the Board made erroneous conclusions of law by providing more weight to Petitioner's attorney argument than Patent Owner's undisputed evidence of secondary considerations.

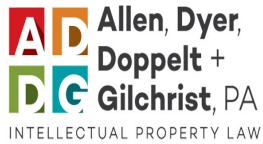
Issue 1 – The Board's final decision in this proceeding follows decisions in five *ex parte* reexaminations and protracted federal court litigation, all of which confirmed the patentability of the '278 Patent. This proceeding, like all those before it, included references disclosing the vehicle data bus and GPS, yet the Board in this proceeding reached the opposite conclusion from all prior panels (and in two instances PTAB appeal panels). Permitting this or any other petitioner to continue to rely on cumulative references is effectively forum shopping. The only difference between the initial prosecution, five *ex parte* reexaminations and this proceeding was the panel in this proceeding. Finality and consistency are a compelling legal policy, and a review of the Board's decision in this proceeding evidences an inconsistent result.

Issue 2 – While courts and the USPTO recognize the importance of evidence of secondary considerations, the Board in this proceeding made erroneous conclusions of law, essentially deferring to Petitioner's attorney argument over un rebutted evidence offered by the Patent Owner showing coextensiveness of the claims with infringing products. While the law presumes a nexus between secondary consideration evidence and products shown to be coextensive, here the Board failed to give the proper weight to un rebutted evidence of secondary considerations by the Patent Owner when the only “evidence” offered in rebuttal was attorney argument from Petitioner. In other words, the Board made erroneous conclusions of law by improperly shifting the burden to Patent Owner when Patent Owner enjoyed a presumption, and Petitioner offered no evidence to overcome this presumption.

/Ryan T. Santurri/

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