

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB USA, INC. AND GEOTAB, INC.,
Petitioners,

v.

OMEGA PATENTS, LLC,
Patent Owner.
U.S. Patent No. 8,032,278
Filing Date: June 3, 2007
Issue Date: October 4, 2011

Case No. IPR2023-00504

**PATENT OWNER'S EXPEDITED PETITION
FOR DIRECTOR REVIEW/INTERVENTION
IN THE PENDING FEDERAL CIRCUIT
APPEAL**

I. INTRODUCTION AND REVIEW OF RELIEF REQUESTED

Patent Owner respectfully files this expedited¹ petition requesting that the Director revisit the prior Director's denial of its request for Director Review in this proceeding. (Paper 45.) In particular, Patent Owner requests that Director Review be granted to conform the result here to the result in IPR2023-01162 ("*Verizon*"), a substantively identical IPR that was decided by the same Board panel and for which the Federal Circuit stayed the pending appeal while awaiting the Director's decision in the *Verizon* proceeding.²

The Final Written Decisions ("FWD") entered in the *Verizon* proceeding and in this proceeding were issued by the same three administrative patent judges ("APJs"), on the analogous substantive grounds, to reach the same result. In both FWDs, the Board relied on the inventor's own cited art disclosing a vehicle data bus in combination with a generic GPS reference ("the Flick + GPS combination"). Both FWDs deemed all challenged claims obvious notwithstanding the fact that patentability of the challenged patent, U.S. Patent No. 8,032,278 ("the '278 Patent"), has been confirmed time and time again by the USPTO (in the original

¹ Geotab has requested that the stay in the Federal Circuit appeal be lifted and the opening brief due no later than July 18, 2025.

² Because Director review in this proceeding was denied last fall, a notice of appeal was filed on October 21, 2024. (Paper 48.) Patent Owner requested that the Federal Circuit stay the appeal pending the outcome of the *Verizon* proceeding so that the appeals of both proceedings could be consolidated, which Petitioner did not oppose. Ex. A. The Federal Circuit granted the request and stayed the appeal of this matter, and is awaiting an update on the outcome of the *Verizon* proceeding prior to taking any additional action. Ex. B.

prosecution and five reexamination requests), and has also been confirmed by a jury (and subsequently affirmed on appeal). In every prior instance, the ‘278 inventor’s own art disclosing the vehicle data bus was known as cited art, as were references disclosing GPS. The current Director granted review of the FWD in the *Verizon* proceeding and terminated it. The same good cause to terminate the *Verizon* proceeding exists and applies with equal force in this proceeding. Accordingly, Patent Owner respectfully requests that the Director revisit the prior denial of Director review to reach the same result here.

Alternatively, because a notice of appeal has already been filed, Patent Owner requests that the Director intervene in the currently pending but stayed Federal Circuit appeal of this proceeding. Now that the Director has acted in and terminated the *Verizon* proceeding, Patent Owner respectfully seeks the same reasoned result in this proceeding, either now or after intervening in the appeal and requesting remand to act.

II. ARGUMENT

The nonobviousness and patentability of U.S. Patent No. 8,032,278 (“the ‘278 Patent”) over the same basic combination of art at issue here (references disclosing a vehicle data bus and disclosing GPS) was confirmed when the patent

issued, in five reexaminations,³ and in a jury trial.⁴ The prior art available for combination in each of these cases included the vehicle data bus + GPS combination.

The two IPRs that are the subject of this request assert Flick + GPS combinations. In this proceeding, Petitioner asserted the combination of the inventor's '885 Patent (disclosing the data bus), which is described in the specification of the '278 Patent, with U.S. Patent No. 6,957,133 to Hunt (Ex-1023), which was relied on for the disclosure of GPS. *Geotab*, Paper 45, p. 30-31. In IPR2023-01162, a copy-cat IPR filed about six months later, relied on the Flick '885 Patent (disclosing the data bus), combined with the Flick '561 Patent, relied on for the disclosure of GPS. *Verizon* Proceeding, Paper 34, p. 36

The same three APIs were assigned to both IPRs. Notwithstanding the seven-plus prior confirmations of patentability of the '278 Patent, in these two IPRs, they found the '278 Patent invalid in view of the Flick + GPS combination. The FWDs included no meaningful consideration of past proceedings, including the jury verdict of nonobviousness, based largely on ample evidence of secondary

³ Reexamination Nos. 90/013,587; 90/013,851; 90/014,309; 90/014,419; 90/014,675. In the most recently finalized reexamination, 90/014,419, Patent Owner disclosed the references and expert declaration submitted by Petitioners here to the examiner. The '278 Patent emerged from that challenged unscathed.

⁴ *Omega Patents, LLC v. CalAmp Corp.*, No. 6:13-cv-1950-Orl-40DCI, 2017 U.S. Dist. LEXIS 55846, at *23 (M.D. Fla. Apr. 6, 2017); *Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1343 (Fed. Cir. 2019).

considerations of nonobviousness, or any analysis of how the results of these IPR proceedings foster consistency among proceedings, which is undeniably a goal of the PTAB reflected by 35 U.S.C. § 315(d) (recognizing co-pending proceedings could be stayed, consolidated or terminated).⁵ Instead, the FWDs in both proceedings relied on Flick + GPS combination. Both tossed aside the significant evidence of secondary considerations of nonobviousness that was found persuasive in several prior proceedings, and the jury verdict of nonobviousness in favor of their consideration of an art combination available in every proceeding: “[w]hile we do not second-guess our colleagues’ decisions...we cannot say the same based on the combination of Flick ‘885 and [Flick ‘561/Hunt].” (*Verizon* Paper 34, p. 54/*Geotab* Paper 45, p. 49.)

Patent Owner requested Director Review of both FWDs. In this proceeding, the prior Director issued a one-word order: “denied.” (Paper 47, p. 2.) In contrast, in *Verizon*, the Director substantively analyzed the issues, granted review, and terminated the proceedings on June 3, 2025 (Paper 37, Paper 40). In particular, the Director found that (1) “the Board failed to explain adequately its decision to deny Patent Owner a presumption of nexus;” (2) “the Board did not sufficiently articulate how the Federal Circuit’s apportionment requirement in the damages

⁵ See also, USPTO Strategic Plan, 2018-2022, noting “The reliability of patent grants also extends to the USPTO’s decision consistency.” (P. 8)

context—which involves a different legal standard—translates to the significance of the unclaimed features for the purpose of nexus;” and (3) “the Board did not sufficiently address Patent Owner’s evidence of licensing, which both the district court jury and the Board previously weighed in Patent Owner’s favor.” (*Verizon* proceeding, Paper 37.)

Because this IPR was filed first, the prior Director’s decision was rendered earlier on September 17, 2024. Patent Owner appealed and subsequently requested that the appeal be delayed pending the outcome of the Director’s review of IPR2023-01162 because of the substantive overlap between the proceedings and the similarity of the FWDs from the same panel. (Ex. A.) Petitioner did not oppose, and the Federal Circuit issued an order on May 14, 2025, staying the appeal and requiring the parties to update it on the outcome of the *Verizon* proceeding. (Ex. B.)

Because the FWDs in this proceeding and the *Verizon* proceeding are substantively the same, which Petitioner conceded when it did not oppose Patent Owner’s request stay the appeal pending the outcome of the *Verizon* proceeding so that the appeals could be resolved together through consolidation the appeals (if necessary), the same good cause exists to grant Director Review and terminate this proceeding. This exhausted Patent Owner, which was already survived more challenges than should ever have occurred, respectfully requests that the Director

reach this same result here.

In this proceeding, the Board committed the same three errors for which the Director terminated the *Verizon* proceeding. As in the *Verizon* proceeding, the Board here failed to properly consider either the undisputed record evidence of secondary considerations or the statutory and policy goals of consistency among decisions of this agency, leading to directly contrary rulings from the USPTO. The Director specifically recognized in the *Verizon* proceeding that the “Board failed to explain adequately its decision to deny Patent Owner a presumption of nexus,” (*Verizon* proceeding, Paper 37, p. 2). This failure is equally present in this proceeding. (*See, e.g., Geotab* proceeding, Paper 45, p. 53.)

In addition to the failure to properly address the presumption of a nexus, the Board here also failed to “consider Patent Owner’s argument that the challenged patent was the last patent standing and continued to collect royalties—even when others in the portfolio licenses expired” (*Verizon* proceeding, Paper 37, p. 3)—further establishing the Board did not properly weigh unrebutted evidence of secondary considerations. This failure was also evident in the same panel’s decision in this proceeding in the context of analogous testimony⁶.

Despite the PTAB expressly relying on evidence of secondary considerations in respective PTAB appeals for two separate *ex parte* reexaminations, the panel in

⁶ *Geotab* proceeding, Ex-1124, 73:1-13.

this proceeding (and in the *Verizon* proceeding) rejected record evidence of secondary considerations more expansive than previously considered by the PTAB⁷, vaguely finding it “weak,” “irrelevant,” and “of limited value”—despite no affirmative evidence or expert testimony offered by Petitioners to rebut Patent Owner’s evidence of secondary considerations. As noted in Patent Owner’s Request to the Director, the Patent Owner has accumulated and submitted considerable evidence of secondary considerations, such as from district court litigation in which the defendant’s engineers admitted the infringing products were developed based on sales-driven requests from customers demanding the features therein and touting their value proposition and lack of design around options.⁸ This favorable jury verdict was reinforced by the commercial success evidenced by the sales of 900,000+ infringing products and licensing evidence relied on twice by the PTAB in confirming validity in *ex parte* reexaminations. Yet none of this evidence was considered by the panel in a manner consistent with the prior USPTO panels or the district court jury.

Unfortunately, the thorough Director review in the *Verizon* proceeding did

⁷ In both IPR proceedings, Patent Owner submitted unrebutted expert testimony, fact witness testimony, and an infringer’s internal documentation, all of which further strengthen the record of nonobviousness.

⁸ See, e.g., *Verizon* proceeding, Ex-2019 ¶¶25-26/36-41, Ex-2023, p. 4, Ex-2024 p. 5, Ex-2021 p. 40-41/94, Ex-2044 ¶¶24-27/31-32, Ex-2011 44:23-45:19, Ex-2012 p. 69, Ex-2032, Ex-2033; *Geotab* proceeding, Ex-2010 ¶170, Ex-2014 ¶¶18-20/33-44, Ex-2018 p. 4, Ex-2019 p. 5, Ex-2015, Ex-2005 45:15-19, Ex-2006 40:20-41:4, Ex-1027, Ex-1028, .

not occur in this proceeding, with a denial of review and no substantive analysis or rationale articulated. To address the inconsistency between the outcome of the *Verizon* and *Geotab* proceedings, as well as with all prior USPTO proceedings, Patent Owner requests further consideration by the Director consistent with the findings in the *Verizon* proceeding. To the extent the Director concludes such a reconsideration cannot currently be completed in the current posture of the case, the Patent Owner requests that the Director intervene in the appeal, as permitted under 35 U.S.C. §143, to seek a remand from the Federal Circuit for further proceedings consistent with the findings in the *Verizon* proceeding. Patent Owner also plans to separately seek remand from the Federal Circuit for the same reasons.

III. CONCLUSION

The '278 Patent has been examined and reexamined time and again in view of references directed toward the vehicle data bus and GPS. The Director recognized that the *Verizon* proceeding was improperly instituted and lacking in support for invalidity. This proceeding suffers the same flaws and should be considered in the same context to ensure consistency. The Patent Owner requests that the Director reconsider the prior decision, including (if necessary) intervening in the Federal Circuit appeal to seek a remand for reconsideration.

Dated: June 13, 2025

Respectfully submitted,

/s/Ryan T. Santurri

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing is being served on June 13, 2025,
by electronic mail at the following email addresses of record for the Petitioners:

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Dated: June 13, 2025

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EXHIBIT A

No. 2025-1108

United States Court of Appeal for the Federal Circuit

OMEGA PATENTS, LLC,

Appellant,

v.

GEOTAB USA, INC. AND GEOTAB, INC.,

Appellee

Appeal from the United States Patent and Trademark Office, Patent Trial and
Appeal Board, in No. IPR2023-00504

**UNOPPOSED MOTION OF APPELLANT TO DEACTIVATE AND STAY
THE APPEAL UNTIL FINAL DISPOSITION OF IPR2023-01162**

Dated: April 10, 2025

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LLC*

Appellant Omega Patents, LLC (“Omega”) respectfully moves to deactivate and stay the appeal in the above-captioned case until final disposition of *Verizon Connect Inc. v. Omega Patents, LLC*, IPR2023-01162. Omega’s counsel has informed counsel for Appellees Geotab USA, Inc. and Geotab Inc. (“Geotab”) of Omega’s motion to deactivate and stay the appeal. Geotab takes no position on Omega’s motion.

On June 30, 2023, Petitioner Verizon Connect Inc. (“Verizon”) filed IPR2023-01162 challenging all claims of the same patent at issue in this case, U.S. Patent No. 8,032,278 (the “’278 Patent”). Verizon alleged that the claims of the ’278 Patent were unpatentable on three grounds. *See* Paper 2. On August 21, 2024, Verizon withdrew grounds two and three from the petition. *See* Paper 24. On January 28, 2025, the PTAB issued a Final Written Decision determining all claims of the ’278 Patent unpatentable under (pre-AIA) 35 U.S.C. § 103(a) based on U.S. Patent No. 6,756,885 to Flick (“’885 Patent”) and U.S. Patent No. 6,606,561 to Flick (“’561 Patent”). *See* Paper 34. On February 26, 2025, Omega filed a Request for Director Review of the PTAB’s decision, and on March 4, 2025, Verizon filed a Response. *See* Papers 35, 36. The Director has not yet issued a decision on Omega’s request for review.

IPR2023-01162 and this case involve several overlapping issues. Both proceedings pertain to the ’278 Patent and were decided by the same panel of PTAB

judges. In both proceedings the PTAB determined all claims of the '278 Patent unpatentable under (pre-AIA) 35 U.S.C. § 103(a) based on the combination of two references, and the primary reference in both combinations was the same (the '885 Patent). Omega presented the same evidence of secondary considerations of nonobviousness in both proceedings. And in both, the PTAB held the '278 Patent unpatentable over Omega's evidence of secondary considerations.

Should the Director deny review in IPR2023-01162, Omega intends to appeal to this Court and will move to consolidate that appeal with the instant case for judicial efficiency. *See* Fed. Cir. Rule 15 Practice Notes ("Appeals ... from decisions involving the same or related patents from the same tribunal will usually be consolidated."). Should the Director grant review, for judicial efficiency the instant appeal should remain in place until a final decision is reached in IPR2023-01162 and is either appealed by a party (at which point Omega will move to consolidate that appeal with this case) or the time for appeal has lapsed.

Accordingly, Omega respectfully moves this Court to deactivate and stay the appeal in the above-captioned case pending final disposition of IPR2023-01162.

CONCLUSION

Omega's motion to deactivate and stay this appeal pending final disposition of IPR2023-01162 should be granted.

Respectfully Submitted,

Dated: April 10, 2025

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CERTIFICATE OF COMPLIANCE

I hereby certify that this motion complies with the type-volume limitation of Federal Rule of Appellate Procedure 27(d)(2)(A). The motion is printed in Times New Roman 14-point font, and it contains 444 words, excluding the items listed in Federal Circuit Rule 32(b)(2).

Dated: April 10, 2025

/s/ Denise M. De Mory

Denise M. De Mory

ATTORNEY FOR APPELLANT

EXHIBIT B

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

OMEGA PATENTS, LLC,
Appellant

v.

GEOTAB USA, INC., GEOTAB, INC.,
Appellees

2025-1108

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2023-
00504.

ON MOTION

Before DYK, *Circuit Judge*.

O R D E R

Upon consideration of Omega Patents, LLC's unopposed motion to stay this appeal pending the United States Patent and Trademark Office's resolution of a related *inter partes* review proceeding, IPR2023-01162,

IT IS ORDERED THAT:

The motion is granted, and this appeal is stayed. The parties are directed to inform the court how they believe this appeal should proceed no later than 14 days following the United States Patent and Trademark Office's final resolution of IPR2023-01162.

FOR THE COURT



Jarrett B. Perlow
Clerk of Court

May 14, 2025
Date