

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

OMEGA PATENTS, LLC,
Patent Owner.

Case No. IPR2023-00504
Patent No. 8,032,278

**PETITIONERS' RESPONSE TO PATENT OWNER'S
EXPEDITED PETITION FOR DIRECTOR REVIEW**

Patent Owner's expedited petition for review (Paper No. 49) should be denied for several reasons.

First, and most fundamentally, the petition cannot be granted because the Director lacks jurisdiction over this case. Patent Owner filed a Notice of Appeal eight months ago on October 21, 2004. IPR2023-00504, Paper No. 48. It is black-letter law that “the act of filing a notice of appeal confers jurisdiction on an appellate court and divests the trial court of jurisdiction over matters related to the appeal.” *Gilda Indus. v. United States*, 511 F.3d 1348, 1350 (Fed. Cir. 2008); *see also Griggs v. Provident Consumer Discount Co.*, 459 U.S. 56, 58 (1982) (“The filing of a notice of appeal is an event of jurisdictional significance—it confers jurisdiction on the court of appeals and divests the district court of its control over those aspects of the case involved in the appeal.”). Respectfully, as a matter of law, the Director cannot grant Patent Owner's petition because the Director lacks jurisdiction.

Second, even if the Director still had jurisdiction over this case, Patent Owner's petition should be denied because the petition is procedurally improper and untimely. The deadline for filing a petition for Director review is 30 days after a final written decision. 37 C.F.R. §§ 42.75(c)(1), 42.71(d)(2). In this case, that deadline was August 19, 2024. Patent Owner already filed a petition for Director review within that deadline on August 16, 2024. IPR2023-00504, Paper No. 46.

That original petition was **denied** nine months ago on September 17, 2024. IPR2023-00504, Paper No. 47.

The Board's rules explicitly limit a party to **one** request for Director review. 37 C.F.R. § 42.75(c) ("A party to a proceeding under this part may file **one** request for Director Review of a decision...") (emphasis added). The Board's rules do not permit Patent Owner to file a second petition eleven months after the final written decision was issued, nine months after the original petition for Director review was denied, or eight months after the case was sent to the Federal Circuit for appellate review. Patent Owner's second petition is procedurally improper and untimely.

Third, Patent Owner's extraordinary request that the Director vacate the final written decision in this case and **terminate** the proceeding (IPR2023-00504, Paper No. 49 at 2, 5) ignores the reasoning behind the Director's termination decision in the *Verizon* proceeding.¹ The Director terminated the *Verizon* proceeding because ordering the panel in **that** case to reconsider its final written decision would have been inefficient given the existence of "a separate IPR concluding that the same claims are unpatentable that is currently on appeal," *i.e.*, **this IPR**. IPR2023-01162, Paper No. 37 at 4; IPR2023-01162, Paper No. 40 at 2 (citing reasoning detailed in

¹ *Verizon Connect, Inc. v. Omega Patents, LLC*, IPR2023-01162.

the Director's show cause order). That is, the Director's decision to terminate the *Verizon* proceeding was expressly based on the facts that the Board had already found Patent Owner's claims unpatentable in **this IPR** and Patent Owner's appeal of the final written decision in this IPR was already before the Federal Circuit. The Director thus plainly envisioned that the appeal in this IPR would move forward.

Finally, the Director should also decline Patent Owner's invitation to intervene in the pending Federal Circuit appeal for the purpose of seeking remand. There are material differences between this proceeding and the *Verizon* proceeding that go well beyond the fact that the Director terminated the *Verizon* proceeding with the expectation that the appeal in this case would move forward.

For example, the prior art relied upon (and against which Patent Owner's evidence of secondary consideration was weighed) differs between the two proceedings. In this proceeding (unlike in the *Verizon* proceeding), Petitioner identified a single prior-art reference (Hunt) that explicitly taught in **one** reference the combination of features that Patent Owner touts as inventive—*i.e.*, “a vehicle data base” combined with GPS. Paper 49 at 2-3.² No such reference was used in

² The Petition in this proceeding presented a ground establishing that Hunt anticipates many challenged claims, which renders Patent Owner's secondary-

any prior challenge against the '278 Patent. Contrary to Patent Owner's suggestion, Hunt was "relied on" for far more than "the disclosure of GPS." *Id.*, 3. Hunt was also relied on to explicitly teach using GPS with what Patent Owner calls a "vehicle data bus." See IPR2023-00504, Paper No. 45 (FWD) at 26-28 (finding that Hunt and the primary reference Flick '885 both disclose multi-vehicle compatible controller ("MVCC") systems, and that Hunt expressly discloses advantages of using GPS in such systems); IPR2023-00504, Paper No. 27 (Petitioner's Reply) at 5-6 (explaining that the POR never refuted that Hunt explicitly teaches using GPS in an MVCC system with a vehicle data bus).

Patent Owner's secondary-considerations arguments also varied significantly between the two proceedings. Compare IPR2023-01162, Paper No. 16 at 29-48 with IPR2023-00504, Paper No. 15 at 44-53.

Given the differences between the two proceedings, the concerns the Director had with the final written decision in the *Verizon* proceeding are inapplicable to the final written decision in this case. For example, the Director expressed concern with the *Verizon* panel's "fail[ure]" to explain adequately its decision to deny Patent

considerations argument moot for those claims. Paper No. 1 at 10-45. The Board ultimately declined to address this ground in its final written decision.

Owner a presumption of nexus,” observing that Patent Owner had allegedly submitted “unrebutted expert testimony [which] established that any unclaimed features of CalAmp products were insignificant for the next analysis.” IPR2023-01162, Paper No. 37 at 2 (citing Patent Owner’s Director Request at 10-12). There was no such “unrebutted expert testimony” in this proceeding.

The unrebutted testimony that concerned the Director, and which Patent Owner highlighted in its *Verizon* petition for Director review at 10-12, is found in a supplemental expert declaration that was filed in the *Verizon* proceeding but that declaration—and that testimony—was never submitted in this proceeding. *See* EX2044 in IPR2023-01162. Patent Owner never submitted such testimony in this proceeding because—unlike in the *Verizon* proceeding—the Patent Owner Response in this proceeding never argued that a nexus should be presumed between the claims and any secondary consideration evidence. *Compare* IPR2023-00504, Paper No. 15 at 52-53 (only arguing in this proceeding that an actual nexus existed, not that one should be presumed) and Paper No. 44 at 22:21-25 (arguing that Patent Owner waived any argument in this proceeding that a nexus should be presumed); *with* IPR2023-01162, Paper No. 16 at 38-43 (arguing, in the *Verizon* proceeding, that a nexus should be presumed). Thus, unlike in the *Verizon* proceeding, there was no “unrebutted expert testimony” in this case allegedly establishing a presumption of nexus that the Board could have failed to address.

The Director also expressed concern with the *Verizon* panel’s treatment of Patent Owner’s evidence of licensing, pointing to a particular argument Patent Owner made regarding the challenged patent being “the last patent standing.” IPR2023-01162, Paper No. 37 at 3. Patent Owner waived that argument in this proceeding by not advancing it in its Patent Owner Response. *See, generally* IPR2023-00504, Paper No. 15 at 47-48 (discussing licensing); *see also* IPR2023-00504, Paper No. 12 at 9 (“[A]ny arguments not raised in the response may be deemed waived.”).

If there are errors in the Board’s final written decision (there are none), then Patent Owner can identify those errors for the Federal Circuit and explain why any such errors warrant vacatur. There is no compelling or broad policy justification for the Director to intervene in Patent Owner’s appeal, a fact underscored by the Director’s decision not to intervene in the appeal at any point in the eight months that the appeal has been pending.

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

Date: June 17, 2025

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

I certify that on June 17, 2025, a copy of the foregoing document, including any exhibits filed therewith, will be served via electronic mail, as previously consented to by Patent Owner, upon the following:

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Date: June 17, 2025

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