

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
KENNETH E. FLICK)
)
Request for Reexamination of)
8,032,278)
)
Control No. **90/014,675**) Attorney Docket No.:
) **(58106CIP1_REX5)**
Confirmation No. **7247**)
) Examiner: **L. WASSUM**
Filing Date: **2/16/2021**)
) Art Unit: **3992**
For: **VEHICLE TRACKING UNIT WITH**)
 DOWNLOADABLE CODES AND)
 ASSOCIATED METHODS)
)

DECLARATION BY JOSEPH C. McALEXANDER, III
UNDER 37 C.F.R. §1.132

I, the undersigned, hereby declare that:

I. Background

1. In formulating my opinions, I have relied upon my training, knowledge, and experience in the relevant art.

2. I am the Founder and President of McAlexander Sound, Inc., a professional engineering company, formerly the IP Director of CCI, a leader in the field of underwater wireless dive computers, Vice President of EPI Technologies, Inc., a systems and integrated circuit testing and reliability certification company, and a design and product manager at Texas Instruments. I have 49 years of experience in microcircuit and semiconductor technologies, including: device design, fabrication, assembly, testing, and marketing; control system

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design and analysis; and quality, reliability, and defect/failure analysis.

3. I am a technical expert in the subject matter areas relevant to this *ex parte* reexamination, including design and testing of circuits and systems related to control systems employing wireless communication protocols and operation, information storage and transfer, user interfaces, information signal processing, applications and operating systems, and electronic device hardware and firmware design and control. From 2000-2003, I represented Toyota as its 30(b)(6) witness and technical expert focused on vehicle alarm systems.

4. I am a Registered Professional Engineer (#79454) in the State of Texas and hold a Bachelor of Science degree in Electrical Engineering from North Carolina State University.

5. I am an inventor on 31 U.S. patents and a number of foreign patents, and I am familiar with the patent process. Five of the 31 patents (3 U.S. and 2 EP) are directed to MEMS technology for vehicle air bag sensor deployment. Three of the 31 patents (2 U.S. and 1 EP) are directed to mobile device tracking, such as is used to track vehicles.

6. I have been an expert witness and technical consultant for the past 32 years in IP matters related to product/process analysis and investigation.

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7. I prepared expert reports and provided trial testimony in the case of Omega Patents, LLC (the '278 Patent Owner) v. CalAmp Corp. (the Requester supplies the defendant with the infringing product) that recently concluded in the Middle District of Florida (hereinafter referred to as the "CalAmp litigation"). In that CalAmp litigation, the '278 patent was asserted and determined by the jury to be not invalid, and to be infringed by CalAmp. (First Jury Verdict, Exhibit 2). In the Court's Final Order of April 5, 2017 (Exhibit 6), the Court confirmed that the asserted claims were not invalid (including the claims of the '278 patent).

8. I have been retained by the Patent Owner to provide technical consultation in the present reexamination of the '278 patent, particularly with respect to addressing rejections based upon Lowrey et al. and Lightener et al.

II. The '278 Patent and Current Office Action

9. I have extensively reviewed the '278 patent, along with its file history, and arguments advanced by CalAmp's trial expert, Mr. Andrews, as part of my work on behalf of the Patent Owner during the course of the CalAmp litigation. I have also reviewed the related litigation trial transcript and exhibits, and have reviewed the Court's Final Order of April 5, 2017, and Final Judgment of April 24, 2017.

10. I have reviewed the current Office Action dated June 21, 2021 for the fifth reexamination of the '278 patent. In that Office Action, the claims were rejected as follows:

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Claims 1, 4-11 and 18-22 were rejected over Lowrey et al. in view of Lightener et al.

11. Representative Claim 1 of the '278 patent is directed to a multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle. The multi-vehicle compatible tracking unit comprises a vehicle position determining device, a wireless communications device, and a multi-vehicle compatible controller for cooperating with the vehicle position determining device and the wireless communications device to send vehicle position information. The multi-vehicle compatible controller is to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles. The multi-vehicle compatible tracking unit comprises a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. Independent Claim 13 (patentability already confirmed) recites that the downloading interface includes a connector for temporary connection to a downloading device. Independent Claim 18 recites that the downloading interface includes a wireless receiver for temporary connection to a downloading device.

III. The Prior Art Analysis

12. I understand that Lowrey et al. discloses an internet-based vehicle-diagnostic system with a wireless appliance in electrical contact with an in-vehicle computer that

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can report position data from a GPS device. The wireless appliance operates based upon a schema to select packets from the in-vehicle computer. These packets are transmitted to a host computer system for processing.

13. I understand that Lightener et al. discloses a wireless diagnostic system in communication with a plurality of vehicles. The wireless diagnostic system also comprises a host computer system, and data collectors in each of the vehicles. The data collector queries data from the OBD bus in the vehicle and sends the data over a wireless network. Data is retrieved from the vehicle periodically. Lightener et al. also notes: "[d]epending on the make and model of the vehicle, the data packet can contain hundreds of datum that describe, e.g.: i) basic properties of the power train (e.g., emission levels, fuel-System Status, engine temperature, Speed and odometer readings, anti-lock brake Status, RPMs, fuel and intake manifold pressure); and ii) manufacturer-specific information..." (Col. 6, lines 26-33).

14. It is my opinion that one of ordinary skill in the art would recognize that Lowrey et al. fails to disclose the multi-vehicle compatible controller and downloading interface of the claimed vehicle tracking unit, as these claim recitations are interpreted by the Examiner.

15. It is my opinion that one of ordinary skill in the art would recognize that Lowrey et al. fails to disclose

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"said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles", as recited in independent Claim 1, for example.

16. It is my opinion that one of ordinary skill in the art would recognize that Lowrey et al. discloses uploading schema to the wireless appliance to collect data packets from the vehicle.

17. It is my opinion that one of ordinary skill in the art would recognize that Lowrey et al. discloses that the wireless appliance requires the technician to review processed results and upload new schema.

18. It is my opinion that one of ordinary skill in the art would recognize that Lowrey et al. fails to disclose the multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles since it requires outside configuration to work with a vehicle.

19. It is my opinion that one of ordinary skill in the art would recognize that Lowrey et al. fails to disclose the "downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device

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code for use by said multi-vehicle compatible controller," as recited in independent Claim 1, for example.

20. It is my opinion that one of ordinary skill in the art would recognize that the claimed enabling data may comprise the vehicle device code or codes, an instruction to select a code or codes from among those already stored, or the data or sequence to allow the controller to generate the vehicle device code or codes.

21. It is my opinion that one of ordinary skill in the art would recognize that Lowrey et al. fails to disclose the claimed enabling data. Rather, the schema of Lowrey et al. fails to meet the bounds of this claimed feature.

22. It is my opinion that Lightener et al. fails to make up for the deficiencies of Lowrey et al.

IV. Evidence of Secondary Considerations

23. I submit that the person of ordinary skill in the art would not find it obvious to selectively modify Lowrey et al. Instead, it is my opinion that such a selective modification or combination would only be motivated by improper hindsight reconstruction - here about twenty years of hindsight.

24. I submit that merits of the claimed invention extend to providing multi-vehicle compatibility, as described above. Accordingly, there exists evidence of secondary considerations of non-obviousness including:

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- a. The First Jury Verdict, page 9, provides that others accepted licenses under the patents "because of the merits of the claimed invention."
- b. I also understand that Omega has received in excess of \$70 million in licensing revenue, much of it from the '278 patent and the other asserted patents in the CalAmp litigation. The Second Jury Verdict adds another \$4.5M to this amount.
- c. The '278 patent is one of three patents asserted in the related litigation providing features for multi-vehicle compatibility as is important for the overall licensing program of the Patent Owner.
- d. The First Jury Verdict, page 9, includes the Jury's determination that the accused products were "commercially successful due to the merits of the claimed invention rather than due to advertising, promotion, salesmanship, or features of the product other than those found in the claim." And the Jury determined that the asserted claims of the '278 patent were infringed by the accused CalAmp devices.
(Exhibits 2-3, First Jury Verdict, Pages 5-6, Second Jury Verdict, Pages 4-5).
- e. CalAmp's employees testified in the related litigation that the multi-vehicle compatibility provides for simplified installation in a vehicle and avoids the need for separated stock keeping units (SKUs). Hall

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deposition, 40:25 - 41:2; and Hergesheimer deposition, 43:3-16).

- f. CalAmp telemetry devices have enjoyed significant commercial success having sold over 917,223 units of the accused products.
- g. The First Jury Verdict, on page 9, includes a finding that others copied the claimed invention.
- h. The Court determined that "CalAmp was well aware of Omega's patents since at least 2010. Rather than take a license, and choosing not to design around Omega's patents, CalAmp elected to sell infringing products and continues to do so to this day. CalAmp's motivation to engage in this behavior is obvious: their customers wanted this technology, and CalAmp wanted to provide it." (Exhibit 6, Final Order, pg. 19).
- i. The Accused Products in the CalAmp litigation were developed because of "customer need." (Hall deposition, 40:20-41:12; Hergesheimer deposition, 40:23-41:3.).
- j. Further, the infringing CalAmp Products would have "limited value" if it were not for the multi-vehicle compatibility. (Hergesheimer deposition, 46:25-47:169.).

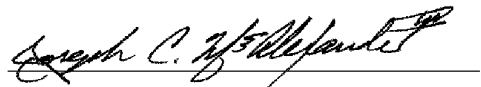
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25. I hereby declare further that all statements made herein are of my own knowledge and are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful and false statements may jeopardize the validity of the application or any patent issued thereon.



Joseph C. McAlexander, III

August 21, 2021

Date