

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	)	
	)	

RESPONSE TO THE
OFFICE ACTION MAILED JUNE 21, 2021
IN EX PARTE REEXAMINATION

EFILED

Commissioner for Patents

Dear Commissioner:

Responsive to the Official Action of June 21, 2021,
please enter the amendments and remarks set out below.

If any fee is required, authorization is given to
charge Deposit Account No. 01-0484.

In the Claims:

This listing of claims replaces all prior versions and listings of claims in the application.

1. (Pending) A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible tracking unit comprising:

a vehicle position determining device;

a wireless communications device;

a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information;

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; and

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.

2. (Pending) The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface comprises a wired signal downloading interface.

3. (Pending) The multi-vehicle compatible tracking unit according to claim 2 wherein said wired signal downloading

interface comprises a connector for temporary connection to a downloading device.

4. (Pending) The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface comprises a wireless signal downloading interface.

5. (Pending) The multi-vehicle compatible tracking unit according to claim 4 wherein said wireless signal downloading interface comprises a wireless receiver for temporary connection to a downloading device.

6. (Pending) The multi-vehicle compatible tracking unit according to claim 1 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

7. (Pending) The multi-vehicle compatible tracking unit according to claim 1 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

8. (Pending) The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

9. (Pending) The multi-vehicle compatible tracking unit according to claim 1 further comprising a remote transmitter; and wherein said multi-vehicle compatible

controller also performs at least one vehicle remote control function responsive to said remote transmitter.

10. (Pending) The multi-vehicle compatible tracking unit according to claim 9 wherein the at least one vehicle remote control function comprises at least one of a vehicle security function, a remote keyless entry function, and a remote engine starting function.

11. (Pending) The multi-vehicle compatible tracking unit according to claim 1 wherein said wireless position determining device comprises a Global Positioning System (GPS) receiver.

12. (Pending) The multi-vehicle compatible tracking unit according to claim 1 further comprising a housing containing said vehicle position determining device, said wireless communications device, said multi-vehicle compatible controller, and said downloading interface.

13. (Pending) A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible vehicle tracking unit comprising:

a vehicle position determining device;

a wireless communications device;

a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information;

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; and

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller;

said downloading interface comprising a connector for temporary connection to a downloading device.

14. (Pending) The multi-vehicle compatible tracking unit according to claim 13 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

15. (Pending) The multi-vehicle compatible tracking unit according to claim 13 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

16. (Pending) The multi-vehicle compatible tracking unit according to claim 13 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

17. (Pending) The multi-vehicle compatible tracking unit according to claim 13 further comprising a remote transmitter; and wherein said multi-vehicle compatible

controller also performs at least one vehicle remote control function responsive to said remote transmitter.

18. (Pending) A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible vehicle tracking unit comprising:

a vehicle position determining device;

a wireless communications device;

a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information;

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; and

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller;

said downloading interface comprising a wireless receiver for temporary connection to a downloading device.

19. (Pending) The multi-vehicle compatible tracking unit according to claim 18 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

20. (Pending) The multi-vehicle compatible tracking unit according to claim 18 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

21. (Pending) The multi-vehicle compatible tracking unit according to claim 18 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

22. (Pending) The multi-vehicle compatible tracking unit according to claim 18 further comprising a remote transmitter; and wherein said multi-vehicle compatible controller also performs at least one vehicle remote control function responsive to said remote transmitter.

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

REMARKS

The Patent Owner thanks the Examiner for the careful and thorough reexamination of the issued claims of the '278 patent, now on their fifth reexamination. The patentability of the issued claims has been confirmed repeatedly by the U.S. Patent and Trademark Office. The Patent Owner thanks the U.S. Patent and Trademark Office and the conferee Examiners for extending all courtesies to the Patent Owner's Representatives during the telephone interview of July 22, 2021. The Patent Owner filed an Interview Summary under separate cover on July 28, 2021. The Patent Owner also thanks the Examiner for confirming the patentability of Claims 2-3 and 12-17.

Additionally, the Patent Owner submits herewith a Rule 132 Declaration from Joseph C. McAlexander, III (Exhibit 1) (the technical consultant for the related litigation with the Requester's customer, and the technical consultant for the prior reexaminations of the '278 patent) in support of arguments for patentability.

The Patent Owner submits that all of the claims are patentable, presents arguments herein supporting such patentability, and respectfully requests that the Examiner withdraw all pending rejections and issue a Reexamination Certificate confirming all claims as patentable.

I. Background

A. The Related Litigation

The Requester, i.e. the Innova Electronic Corporation (hereinafter "Innova"), is a supplier of an infringing product to the CalAmp Corporation (hereinafter "CalAmp"). The past four

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

ex parte reexaminations of the '278 patent have been filed by the Requester and CalAmp.

Personnel of CalAmp began patent licensing discussions with Mr. Flick, President of the Patent Owner, in approximately 2005. Meetings were held in 2009 and a patent license was offered, and rejected, resulting in a lawsuit filed December 14, 2009. This suit did not involve the '278 patent under reexamination, and was resolved on June 9, 2010.

Further licensing discussions with CalAmp failed and another lawsuit was filed against CalAmp on December 20, 2013. (6:13-cv-01950-PGB-DCI, in the Middle District of Florida (Orlando)). This case involved the present '278 patent.

On February 24, 2016, the related seven-day jury trial involving the '278 patent was concluded with a First Jury Verdict (Exhibit 2), where CalAmp was found to infringe all of the asserted claims in all of asserted patents, and, in particular, the asserted Claims 1, 3-5, 12, 14 and 16 of the '278 patent. In the finding that the '278 patent was not invalid, the Jury found secondary factors indicating non-obviousness of the '278 patent.

In the related litigation between the Patent Owner and CalAmp, which ultimately resulted in a rejection of CalAmp's invalidity arguments, CalAmp on April 20, 2018 filed its first appeal brief with the Court of Appeals for the Federal Circuit. The Patent Owner filed its responsive brief on May 30, 2018, and CalAmp filed a reply brief on July 2, 2018. Of particular relevance, CalAmp's briefs in the litigation raised no issues with respect to validity of any of the asserted patents (including the '278 patent) in view of the prior art carefully

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. **90/014,675**
Filed: **2/16/2021**

selected and presented at trial.

On April 8, 2019, the Appeal was affirmed-in-part, reversed-in-part, and vacated-in-part. The decision remanded the case back to the District Court for a retrial. During the retrial, CalAmp did not challenge the validity of the infringed claims. The second trial concluded on September 30, 2019, and the Jury found CalAmp infringed the '278 patent and awarded \$4,586,111 in damages. (See Second Jury Verdict, Exhibit 3). The court jury also awarded an ongoing royalty of \$5 a unit for the '278 patent.

CalAmp on May 14, 2020 filed a second appeal brief with the Court of Appeals for the Federal Circuit. Oral arguments were held on May 6, 2021.

A litigation against Enfora, Inc. (1:17-cv-02769-TWT, pending in the Northern District of Georgia (Atlanta)) was concluded September 3, 2019, which included the '278 patent.

The Patent Owner is also asserting the '278 patent in a pending litigation against Firstech, LLC in the Western District of Washington (2:20-cv-01344).

B. Related Reexaminations

As in this fifth reexamination, the Requester and CalAmp have filed follow-on reexamination requests against three other patents of the Patent Owner. This is the list of the other reexaminations and related statuses:

U.S. Patent No. **6,756,885** (expired August 22, 2016)
Reexamination 90/013,741 resulting in Reexamination
Certificate August 1, 2017.

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

U.S. Patent No. 6,756,885 (expired August 22, 2016)
Reexamination 90/014,038 resulting in Reexamination
Certificate October 25, 2019.

U.S. Patent No. 6,346,876 (expired August 22, 2016)
Reexamination 90/013,659 resulting in Reexamination
Certificate September 1, 2017.

U.S. Patent No. 6,346,876 (expired August 22, 2016)
Reexamination 90/014,122 resulting in Reexamination
Certificate March 23, 2020.

U.S. Patent No. 7,671,727
Reexamination 90/013,832 resulting in Reexamination
Certificate August 1, 2017.

U.S. Patent No. 7,671,727
Reexamination 90/014,121 in Reexamination Certificate
May 29, 2020, canceling all claims.

U.S. Patent No. 8,032,278 (unexpired)
Reexamination 90/013,587 resulting in Reexamination
Certificate December 28, 2016.

U.S. Patent No. 8,032,278 (unexpired)
Reexamination 90/013,851 resulting in Reexamination
Certificate February 6, 2019.

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

U.S. Patent No. 8,032,278 (unexpired)
Reexamination 90/014,309 resulting in Reexamination
Certificate January 8, 2020.

U.S. Patent No. 8,032,278 (unexpired)
Reexamination 90/014,419, request for reexamination
was denied, Innova filed a petition challenging the
determination of no substantial new question of
patentability on February 25, 2020.

The Patent Owner submits that the Requester's and
CalAmp's duplicative and harassing efforts are improper. The
Requester and CalAmp, having failed in their initial round of *ex
parte* reexamination requests for the litigated patents, are now
on to round five.

The Patent Owner submits that such sequential/serial
requests for *ex parte* reexamination are a waste of USPTO
resources. The Patent Owner submits that the Requester is
abusing patent office procedures in a fashion that is
fundamentally unfair to the Patent Owner.

C. The Request for Reexamination Included Misleading Information

The request for *ex parte* reexamination of the '278
patent for the present reexamination is based upon so-called
recently identified U.S. Patent No. 6,611,740 to Lowrey et al.
This is the second request filed by attorneys for Innova. The
first request (denied) having been filed on December 16, 2019.
Innova's customer, CalAmp, directly filed three of its own
serial reexamination requests on: (1) September 14, 2015; (2)

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

October 28, 2016; and (3) May 24, 2019. The litigation sparking this series of reexamination requests was filed against CalAmp on December 20, 2013 as noted above.

On pages 1-2 of the second request (fifth in the series), Requester's attorney states: "[r]ecently, additional prior art that was not previously considered by the United States Patent and Trademark Office ("USPTO") has been identified that is believed to raise a substantial new question of patentability." (Emphasis Added).

At a minimum, this language is misleading. Indeed, seventeen Innova patents cite this same reference, and predate the present reexamination request and the first Innova reexamination request. The "recently identified" Lowrey et al. patent was cited in cases personally prosecuted by the attorney for the Requester, see, e.g., U.S. Patent Nos. 10,643,403 (filed September 30, 2015 and issued May 5, 2020); 10,640,060 (filed March 8, 2017 and issued May 5, 2020); 10,462,225 (filed August 25, 2017 and issued October 29, 2019); and 10,163,281 (filed January 12, 2017 and issued December 25, 2018).

The Patent Owner notified the Requester of this misleading information in a communication dated March 5, 2021 (Exhibit 4) encouraging Requester to update the Patent Office regarding the "recently identified" reference. Requester responded to the Patent Owner, but chose not to advise the Patent Office despite this clear showing of repeated harassment of the Patent Owner. A copy of the Requester's response is attached as Exhibit 5.

The Patent Owner submits that the serial harassment of Patent Owner is evident and respectfully requests the Patent

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

Office to confirm patentability of the rejected claims based on this reason alone.

D. The Request for Reexamination Should Not Have Been Granted

The Patent Owner submits that the present *ex parte* reexamination should not have been granted. As noted above, the present fifth reexamination request of the '278 patent is representative of serial and duplicative harassment of the Patent Owner by the Requester (Supplier of CalAmp) and CalAmp.

Indeed, the one consistent beat throughout the multiple requests of reexamination is the formula of combining a tracker prior art reference with a secondary reference in an attempt to provide the multi-vehicle compatibility. The Requester has used this same formula again in the present reexamination.

Moreover, as noted hereinabove, the Requester has utilized the Lowrey et al. prior art reference similarly to the prior four failed prior requests for *ex parte* reexamination filed against the '278 patent. The Patent Owner submits that the USPTO should not have granted the present request since it is part of long standing pattern of duplicative harassment by CalAmp and its supplier, the Requester.

II. The Pending Claims

The claimed invention, as recited in independent Claim 1, for example, 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 Claims 13 (patentability already confirmed) and 18 are directed to related multi-vehicle compatible vehicle tracking units. Independent Claim 13 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 Rejections Are In Error And The Claims Are Patentable

A. Introduction

The Requester argued substantial new questions of patentability for the claims of the '278 patent on multiple grounds. In particular, Requester argued Claims 1, 2 and 4-22 as being anticipated by Lowrey et al.

The Examiner correctly recognized that Claims 1, 2 and 4-22 are not anticipated by Lowrey et al.

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

Requester also argued that Claims 1-22 are obvious over Lowrey et al. The Examiner correctly confirmed the patentability of Claims 2-3 and 12-17 despite Requester's arguments.

Nevertheless, in the Office Action, the Examiner took the position that Claims 1, 4-11 and 18-22 are unpatentable over the combination of Lowrey et al. and Lightner et al.

B. Lowrey et al. and Lightner et al. Fail to Disclose Each and Every Feature of the Claimed Invention

Lowrey et al., like much of the prior art repeatedly considered in previous reexams, discloses an internet-based vehicle-diagnostic system including a wireless appliance in electrical contact with an in-vehicle computer and that can report position data from a GPS device. (See Figure 1, reproduced below).

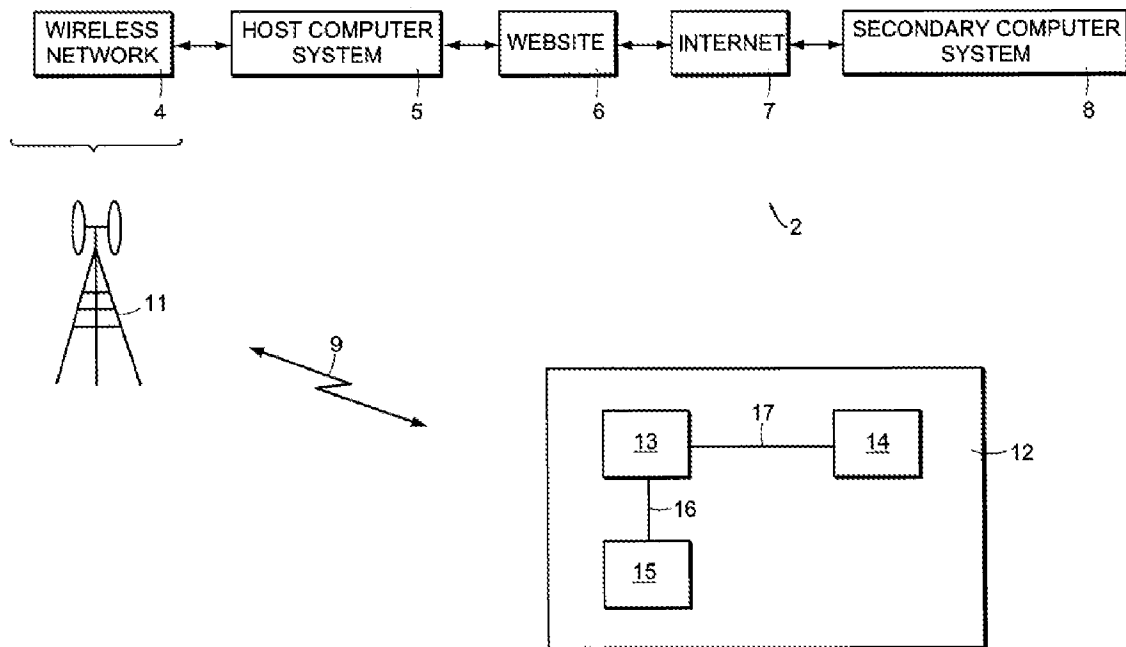


Figure 1 of Lowrey et al.

With respect to independent Claims 1 and 18, the Patent Owner respectfully submits that Lowrey et al. fails to disclose or fairly suggest the claimed features of:

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.

Rather, Lowrey et al. is very similar in disclosure to the respective primary references applied in the prior four *ex parte* reexaminations of the '278 patent. In short, the typical

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

formula includes combining a vehicle tracker prior art reference with a secondary reference in an attempt to provide the multi-vehicle compatibility.

In the first *ex parte* reexamination of the '278 patent, CalAmp failed in its attempt to invalidate the claims by applying Suman et al. and Spaur et al. (Cell Port Labs patent), and Beckert et al.

In the second *ex parte* reexamination of the '278 patent, CalAmp failed in its attempt to invalidate the claims by applying Chou et al.

In the third *ex parte* reexamination of the '278 patent, CalAmp failed in its attempt to invalidate the claims by applying a Cell Port Labs Press Release, Spelt et al., and the SAE HS-3000 Manuals, and separately over Jones et al. and the SAE HS-3000 Manuals.

In the fourth *ex parte* reexamination of the '278 patent, CalAmp's supplier, the Requester, failed in its attempt to raise a substantial new question of patentability by applying Flick '551, Brinkmeyer, Monroe, Drori, Space Daily Trimble, Mateja, and Holusha.

In the present reexamination, the Examiner correctly notes that Lowrey et al. fails to disclose or fairly suggest the multi-vehicle features of the claims. In particular, the Examiner noted: "[t]o the extent that Lowrey does not explicitly teach additional details of how the diagnostic data is vehicle-specific, Lightner discloses these additional details at col. 6, lines 26-34 [reproduced portion of Lightner omitted]." (Office Action 6-21-2021, page 14).

The cited portion of the secondary reference to

Lightner et al. recites:

[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 (e.g., status of the door locks, airbags, and entertainment center). In total, for most vehicles there are typically more than 300 datum that can be included in the data packet. (Col. 6, lines 26-35).

As noted during the telephonic interview, the Patent Owner respectfully submits that the claimed invention is patentable over the proposed combination of Lowrey et al. and Lightner et al. Firstly, the applied combination of prior art references fails to disclose or fairly suggest: "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. Rather, the primary reference to Lowrey et al. discloses a wireless appliance coupled to the OBD port of the vehicle. The wireless appliance "includes a data-collection component that, in turn, includes a microcontroller that has Software and a data-collection schema loaded in the microcontroller's memory. The Schema is essentially a map that describes the data that the wireless appliance collects from the vehicle's engine computer, and its corresponding location in the computer's memory." (Col. 6,

lines 56-62; and see Exhibit 1, paragraphs 15-18).

Using the map of the schema, the wireless appliance grabs certain packets from the vehicle network and transmits the packets to the remote host computer system. The host computer system then "analyzes the data packet using a map that corresponds to the Schema to generate a data set." (Col. 7, lines 4-6). Once transmitted, a technician reviews the transmitted packets in an attempt to diagnose the problem with the vehicle. If the technician decides more data is needed, the "technician uses the web site to Select a new Schema (Step 32) and then sends an incoming data packet that includes a new Schema over the wireless network to the wireless appliance included in the vehicle being diagnosed." (Col. 7, lines 22-25; and see Exhibit 1, paragraphs 15-18).

The primary reference to Lowrey et al. notes that: "[t]he above-described system is designed to work with multiple vehicles and multiple secondary computer systems, each connected to the web site through the Internet. ... The system 20 operates similarly as that described above". (Col. 7, lines 44-49). In other words, after the technician reviews processing and uploads a new schema, the packets are simply grabbed from the respective vehicles and sent to the host computer system for analysis.

Secondly, the applied combination of prior art references fails to disclose or fairly suggest the: "downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller", as recited in independent Claim 1, for example. As correctly recognized by the Examiner, the '278 patent notes that the "enabling data may

be 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 111 to generate the vehicle device code or codes, for example.” (Col. 24, lines 8-13; and see Exhibit 1, paragraphs 19-21).

Again, the teachings of the primary reference to Lowrey et al. are limited to the schema. The primary reference to Lowrey et al. describes the schema as “essentially a map that describes the data that the wireless appliance collects from the vehicle’s engine computer, and its corresponding location in the computer’s memory.” (Col. 6, lines 59-62). The schema indicates where and when to grab packets, which are sent to the remotely located host computer system. The Patent Owner submits that the limited teachings of the primary reference to Lowrey et al. do not meet the claimed enabling data. Rather, the schema does not provide either a device code, an instruction to select a code or codes from among those already stored, or a data or sequence to allow the controller to generate the vehicle device code or codes. In addition, Patent Owner submits that the secondary reference to Lightener et al. also fails to make up for the deficiencies of the primary reference to Lowrey et al. (See Exhibit 1, paragraphs 19-22).

B. Evidence of Secondary Considerations and Declaration Evidence

1. Introduction

To rebut the Examiner’s obviousness rejections, the Patent Owner offers the following secondary considerations supporting non-obviousness. This evidence was presented and

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

considered favorably by the Patent Trial and Appeal Board (PTAB) in the second *ex parte* reexamination of the '278 patent. The PTAB stated that "we add that Appellant's evidence of secondary considerations of non-obviousness, including licensing, commercial success, copying by others, customer need, and the limited value for accused products without the invention, only further weighs in favor of Appellant." (Decision on Appeal, Application Serial No. 90/013,851, page 14).

As noted by the Federal Circuit in *Mintz v. Dietz*, 679 F.3d 1372 (Fed. Cir. 2012), the following helpful guidance is provided with respect to the objective criteria of secondary considerations:

[t]hese objective criteria thus help turn back the clock and place the claims in the context that led to their invention. Technical advance, like much of human endeavor, often occurs through incremental steps toward greater goals. These marginal advances in retrospect may seem deceptively simple, particularly when retracing the path already blazed by the inventor. For these reasons, this court requires consideration of these objective indicia because they "provide objective evidence of how the patented device is viewed in the marketplace, by those directly interested in the product." (*Id.* at 1378; emphasis added).

Mintz further provides:

[i]ndeed, where the invention is less technologically complex, the need for Graham findings can be important to ward against falling into the forbidden use of hindsight. Simply because the technology can be easily understood does not mean that it will satisfy the legal standard of obviousness. In fact,

objective consideration of simple technology is often the most difficult because, once the problem and solution appear together in the patent disclosure, the advance seems self-evident. Instead, the proper analysis requires a form of amnesia that "forgets" the invention and analyzes the prior art and understanding of the problem at the date of invention.
(*Id.* at 1379; emphasis added).

The Patent Owner sets forth below evidence of licensing, commercial success, copying by others, customer need, and limited value of products without the claimed invention.

2. Licensing

The '278 patent in Claim 1, for example, 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.

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

The Patent Owner points to the following excerpt from the First Jury Verdict form (Exhibit 2) from the related litigation with establishing the merits of the claimed invention and the licenses:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word "yes" in the blank below to any question that you answer "yes" to):

YES Did others accept licenses under patents because of the merits of the claimed invention?

In other words, after observing all of the testimony of the witnesses, reviewing the exhibits presented during trial, and applying the Court's Jury Instructions, the Jury determined that the licenses were based on the merits of the claimed invention, including the '278 patent.

As noted in Mr. McAlexander's Declaration (Exhibit 1, paragraph 24(b)), the Patent Owner has received in excess of \$70 million in licensing revenue, from the '278 patent and the other asserted patents in the related litigation.

Mr. McAlexander also notes that the '278 patent is one of three patents asserted in the related litigation providing features for multi-vehicle compatibility; and, multi-vehicle compatibility is important for the overall licensing program of the Patent Owner. (Exhibit 1, paragraph 24(c)).

Mr. McAlexander cites to CalAmps's own employees' trial testimony for the propositions that the multi-vehicle compatibility provides for simplified installation and avoids

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

the need to have multiple SKUs (stock keeping units). (Exhibit 1, paragraph 24(e)). Further details regarding the "customer need" and "limited value" without the multi-vehicle compatibility are provided below.

3. Commercial Success

The Patent Owner respectfully points to the following excerpt from the First Jury Verdict form from the related litigation that provides evidence of commercial success due to the merits of the claimed invention:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word "yes" in the blank below to any question that you answer "yes" to):

YES

Were accused products covered by the claim 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?

Furthermore, the Jury also determined that the features of the '278 patent were included in the infringing devices of the Requester's customer (CalAmp) (in both trials). The Jury determined that asserted claims of the '278 patent were infringed. The Jury Verdict evidences that products supplied to CalAmp by the Requester correspond to the claimed invention.

This is the pertinent portion of the Second Jury Verdict form:

In re Patent Application of:
KENNETH E. FLICK
 Reexamination Control No. 90/014,675
 Filed: 2/16/2021

	LMU-3000	LMU-3030	LMU-3050	VPOD	VPOD2
Claim 8	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☐ Yes ☒ No	☐ Yes ☒ No
Claim 11	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☐ Yes ☒ No	☐ Yes ☒ No
Claim 12	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No		
Claim 13	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☐ Yes ☒ No	☐ Yes ☒ No
Claim 14	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☐ Yes ☒ No	☐ Yes ☒ No
Claim 16	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☐ Yes ☒ No	☐ Yes ☒ No
Claim 18	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☐ Yes ☒ No	☐ Yes ☒ No
Claim 19	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☐ Yes ☒ No	☐ Yes ☒ No
Claim 21	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☐ Yes ☒ No	☐ Yes ☒ No

As noted in Mr. McAlexander's Declaration, CalAmp was found to infringe with 917,223 units of the accused products. (Exhibit 1, paragraph 24(f)).

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

Mr. McAlexander also notes that the '278 patent is one of three patents asserted in the related litigation providing features for multi-vehicle compatibility; and, multi-vehicle compatibility is important for the overall licensing program of the Patent Owner. Mr. McAlexander cites to CalAmp's (customer of Requester) own employees' trial testimony for the propositions that the multi-vehicle compatibility provides for simplified installation and avoids the need to have multiple SKUs (stock keeping units). (Exhibit 1, paragraph 24(c) and 24(e)).

4. Copying by Others

Once again, the Patent Owner points to the following excerpt from the First Jury Verdict form from the related litigation that establishes copying:

- 5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word "yes" in the blank below to any question that you answer "yes" to):**

YES Did others copy the claimed invention?

The Jury's finding of infringement of the asserted claims of the '278 patent (provided above) establishes that Requester's products supplied to CalAmp correspond to the claimed invention.

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

5. Customer Need

The Patent Owner directs the Examiner's attention first to the Court's determination in the first trial of the related litigation. In its Final Order, the Court provides:

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 [Supplied by the Requester] wanted to provide it. (Exhibit 6, Final Order, page 19; Emphasis added.)

The McAlexander Declaration provides that the multi-vehicle accused products in the CalAmp litigation were developed because of "customer need" for a simple installation that did not require splicing of wires. (Exhibit 1, paragraph 24(i)). Mr. McAlexander's position is supported by the following testimony of Mr. Stephen Hall and Mr. Peter Hergesheimer, both CalAmp employees, as follows:

Testimony of CalAmp Employee Stephen Hall

Q. Can you introduce yourself for the record

A. Yes. My name is Stephen Hall. The correct spelling is S-t-e-p-h-e-n.

Q. All right, sir. And by whom are you employed?

A. I'm an employee of CalAmp Corporation.

Q. Do you have a title at CalAmp?

A. My official title is director of system

engineering and technology.

Q. What does it mean to be the director of system engineering and technology at CalAmp?

A. My role is to look at the needs of our customer and market and to match them up with various technologies that are going on in the industry component level and otherwise to make sure that we have an appropriate solution. (Stephen Hall deposition, 6:8-22).

Q. All right, sir. I'm going to hand you what was previously marked as Exhibit 1 to the deposition of Mr. Hergesheimer. Can you tell me what Exhibit 1 is?

A. I'm looking at a CalAmp datasheet for the LMU-3000 product.

Q. And were you involved in the development of the LMU-3000?

A. I was.

Q. And what was your role in developing the LMU-3000?

A. My role on the 3000 was at the CRS level. I provided the requirements document for that. The various blocks within it were predefined by our existing partnerships, and so I didn't do a lot of component selection type of work, so it was really limited just to the CRS document.

Q. Was there a particular market need that you identified leading up to the creation of the CRS for the LMU-3000?

A. The 3000 was driven by a general market need that we heard from a number of customers. The primary interest was coming from a need for a simple installation type of solution and the opportunity to enhance the capability of the product that we could offer with certain data items coming off of the vehicle bus. (Stephen Hall deposition, 6:8-22; and 40:20-41:12; Emphasis added).

Testimony of CalAmp Employee Peter Hergesheimer

Q. You have been designated as a representative on whether CalAmp has willfully or deliberately infringed in this case. Beyond knowing about the devices and how they operate, do you know anything about CalAmp's assertions that its actions are not willful or deliberate?

A. I would say from my experience in the development of these devices that there's no willful infringement.

Q. And -- and what's that based on?

A. That's based on knowing where the -- the technology that we use came from and the fact that these were sales-driven requests and somebody had a problem to solve and we went about solving the problem.

Q. What do you mean sales-driven request?

A. Well, typically our -- typically we have a customer that says hey, I would like to do this particular -- have a product that has this feature and so CalAmp goes about designing that product.

Q. So the LMU3000 development was the result of -- or was -- was undertaken because customers expressed a demand to CalAmp for these products?

A. I -- I believe that's the case. I can't say specifically for these, but that's in general how our product development works. (Peter Hergesheimer deposition, 40:6 - 41:3).

6. Limited Value for Products Without the Invention

The Examiner's attention is directed to the section above regarding Commercial Success. The Patent Owner asserts that the accused products as covered by the '278 patent would have "limited value" if it were not for multi-vehicle compatibility. CalAmp's own employee, Peter Hergesheimer, testified as follows:

Testimony of CalAmp Employee Peter Hergesheimer

Q. Can you state your name for the record.

A. Peter Hergesheimer.

Q. All right. Sir, and by whom are you employed?

A. CalAmp.

Q. Okay. And what's your position at CalAmp?

A. I'm the senior director of software and architecture in the MRM group. (Peter Hergesheimer deposition, 6:2-8).

Q. Do you know whether the LMU3000 would have any value if it didn't work on multiple vehicles?

A. It would have a limited value.

Q. You would need separate skus for each vehicle; right?

A. That would be one way of solving that problem.

Q. Is there any other way?

A. Different skus could be different software got loaded onto the same sku.

Q. Okay. So you can -- whether you have a different sku or not, you would need to -- if -- if the LMU3000 was vehicle specific, it would need software for each vehicle in which it was -- separate software for each vehicle in which it was designed to work?

A. Each vehicle type I would guess, yes.

Q. And that would be a more expensive exercise, I would think, from CalAmp's perspective?

A. Yes.

Q. And less desirable than the -- than the option

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

you have now where the LMU is able to service multiple vehicles?

A. Yes, even though it is still pretty painful.

(Peter Hergesheimer deposition, 46:25 - 47:19;
Emphasis added).

In view of the evidence of secondary considerations the Patent Owner submits that any obviousness type rejection of the pending claims is rebutted.

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

CONCLUSION

In view of the arguments presented above and the evidence submitted herewith, it is submitted that all of the claims are patentable. Accordingly, a Reexamination Certificate confirming all claims as patentable is respectfully requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge or credit any discrepancies in fee amounts to Deposit Account No. 01-0484.

Respectfully submitted,

/JACK G. ABID/

JACK GEORGE ABID
Reg. No. 58,237
Allen, Dyer, Doppelt, Milbrath
& Gilchrist, P.A.
255 S. Orange Avenue, Suite 1401
Post Office Box 3791
Orlando, Florida 32802
407-841-2330
407-841-2343 fax
Attorney for the Patent Owner

In re Patent Application of:
KENNETH E. FLICK
Reexamination Control No. 90/014,675
Filed: 2/16/2021

CERTIFICATE OF SERVICE

Certificate of Service in compliance with 37 C.F.R. §1.530(c)

Pursuant to 37 C.F.R. §§1.530(c), 1.248, I hereby certify that on August 23, 2021, a complete copy of this Request is being served via First Class U.S. Mail upon Third Party Requester at the correspondence address as shown in PAIR:

Mark B. Garred
STETINA BRUNDA GARRED & BRUCKER
75 Enterprise, Suite 250
Aliso Viejo, California 92656

Respectfully submitted,

/JACK GEORGE ABID/

Jack G. Abid