

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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	)	
_____	)	

PATENT OWNER'S APPEAL BRIEF

EFILED

Commissioner for Patents

Dear Commissioner:

Submitted herewith is Patent Owner's Appeal Brief. If any fee is required, authorization is given to charge Deposit Account No. 01-0484.

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Reexamination Control No. 90/014,675
Filed: 2/16/2021

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(1) Real Party in Interest

The real party in interest is OMEGA PATENTS, L.L.C., assignee of the present application as recorded at reel 019515, frame 0350.

(2) Related Appeals, Interferences, and Trials

At present there are no related appeals, or interferences. There are three related trials.

I. First 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 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

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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 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

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the Court of Appeals for the Federal Circuit. On September 14, 2021, the Federal Circuit confirmed infringement of the '278 patent and remanded for a further trial on damages.

II. Second Litigation

The Patent Owner filed a patent infringement lawsuit on July 21, 2017 against Enfora, Inc. in the Northern District of Georgia, Atlanta Division (Case 1:17-cv-02769-TWT). The asserted patents in this Enfora suit include the '278 patent, which is the subject of this fifth reexamination by the Requester. This litigation was concluded September 3, 2019.

III. Third Litigation

The Patent Owner was also asserting the '278 patent in a litigation against Firstech, LLC in the Western District of Washington (2:20-cv-01344). This suit has been settled prior to trial.

(3) 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

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Certificate August 1, 2017.

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.

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

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, Requester 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 earlier rounds of *ex
parte* reexamination requests for the '278 patent, 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.

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(4) Summary of the Claimed Subject Matter

Independent Claim 1 is directed to a multi-vehicle compatible tracking unit 110 for a vehicle comprising a vehicle data bus 122 extending throughout the vehicle. The multi-vehicle compatible tracking unit comprises a vehicle position determining device 112, a wireless communications device 113, and a multi-vehicle compatible controller 111 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 121 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 116 for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. (Figures 10-13, reproduced below, and Page 27, Col. 23, line 41 through Page 28, Col. 25, line 61).

Independent Claim 13 is directed to a multi-vehicle compatible tracking unit 110 for a vehicle comprising a vehicle data bus 122 extending throughout the vehicle. The multi-vehicle compatible vehicle tracking unit comprises a vehicle position determining device 112, a wireless communications device 113, and a multi-vehicle compatible controller 111 for cooperating with the vehicle position determining device and the wireless

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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 121 using at least one corresponding vehicle device code from among a plurality thereof for different vehicles. The multi-vehicle compatible vehicle tracking unit comprises a downloading interface 116 for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. The downloading interface comprises a connector 133a-133b for temporary connection to a downloading device 115''. (Figures 10 & 13, reproduced below, and Page 27, Col. 23, line 41 through Page 28, Col. 25, line 61).

Independent Claim 18 is directed to a multi-vehicle compatible tracking unit 110 for a vehicle comprising a vehicle data bus 122 extending throughout the vehicle. The multi-vehicle compatible vehicle tracking unit includes a vehicle position determining device 112, a wireless communications device 113, and a multi-vehicle compatible controller 111 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 121 using at least one corresponding vehicle device code from among a plurality thereof for different vehicles. The multi-vehicle compatible vehicle tracking unit

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includes a downloading interface 116 for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. The downloading interface comprises a wireless receiver 114 for temporary connection to a downloading device 115. (Figures 10-11, reproduced below, and Page 27, Col. 23, line 41 through Page 28, Col. 25, line 61).

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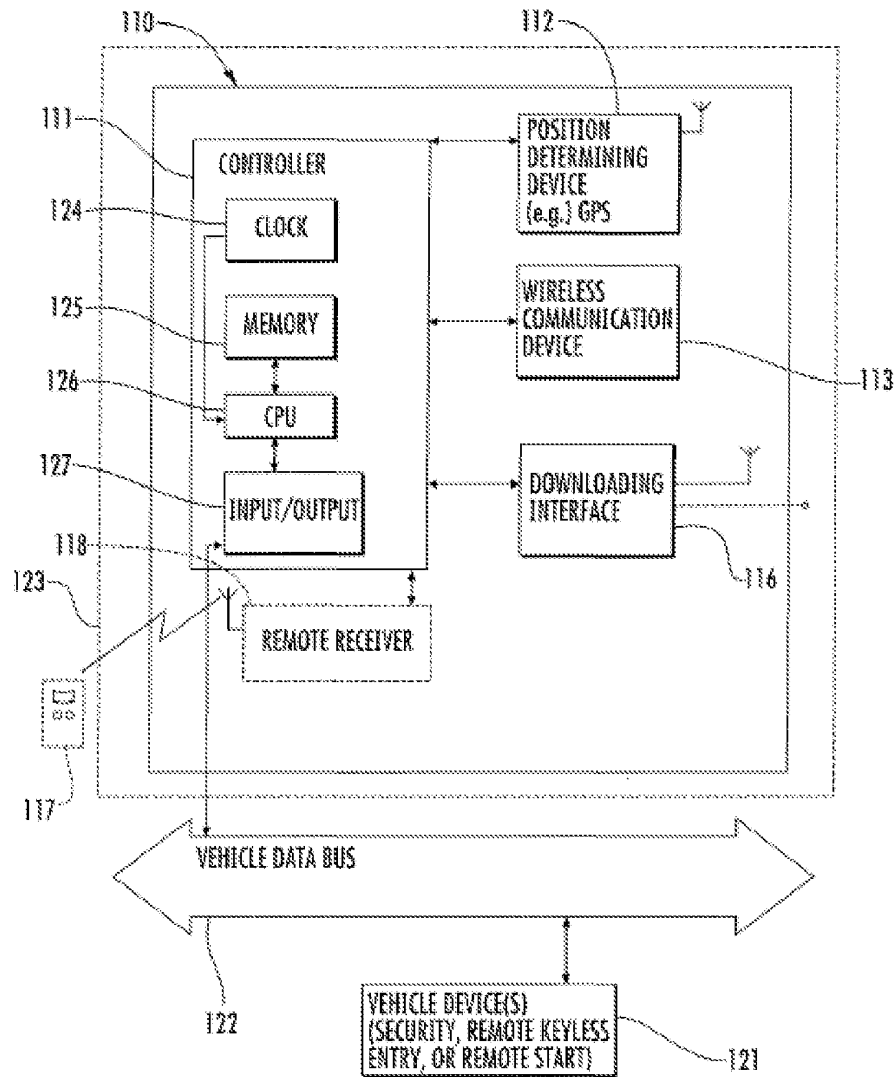


Figure 10 of the '278 Patent

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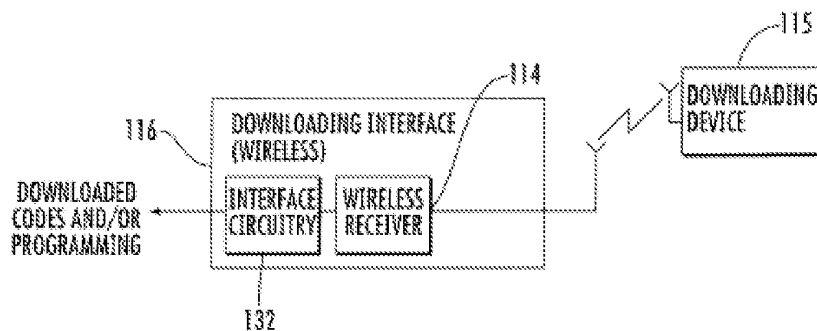


Figure 11 of the '278 Patent

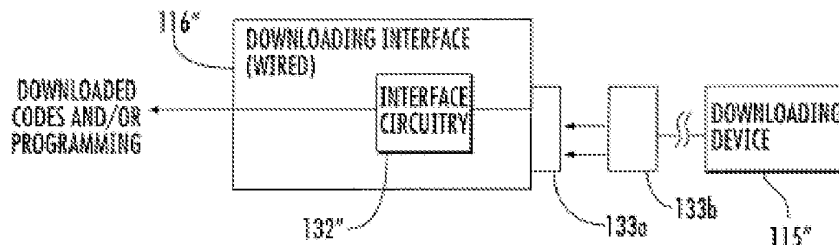


Figure 13 of the '278 Patent

(5) The Request for Reexamination Should Not Have Been Granted

I. The Original Request Does Not Present an SNQ

The Patent Owner submits that the present *ex parte* reexamination should not have been granted based upon the combination of Lowrey et al. and Lightener et al. For a proper order for *ex parte* reexamination, the Patent Office must identify a "substantial new question of patentability." 35 U.S.C. §303(a).

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MPEP §2242(I) recites:

a substantial new question of patentability as to the claim is present, unless the same question of patentability has already been: (A) decided in a final holding of invalidity by a federal court in a decision on the merits involving the claim, after all appeals; (B) decided in an earlier concluded examination or review of the patent by the Office; or (C) raised to or by the Office in a pending reexamination or supplemental examination of the patent.

The Patent Owner submits that present fifth reexamination request over Lowrey et al. is substantially identical to the second reexamination request of this same patent, which relied on the Chou et al. prior art reference. As detailed in Section 6(I)(C) herein, the disclosure of Lowery et al. is very similar to the disclosure of Chou et al. As in Chou et al., Lowrey et al. discloses a wireless appliance that can be physically and electrically installed in different vehicles, but is only operationally compatible with one vehicle. ("At best, Chou's controller is compatible with one vehicle, namely the particular vehicle whose fault codes correspond to that particular vehicle for which the controller was designed", Exhibit 8, Decision on Appeal, page 11).

More so, in the present *ex parte* reexamination, the Requester relied upon a defective incorporation by reference to Lightener et al. in an attempt to provide the missing multi-vehicle compatible controller. In the second *ex parte*

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reexamination request, Requester's customer, CalAmp, (the Requester in that reexamination) also relied upon a secondary prior art reference, SAE Manuals, to provide the missing multi-vehicle compatible controller. In short, the present reexamination is cumulative to the prior art already presented, considered, and rejected in the second reexamination.

II. The Present Reexamination Represents A Pattern Of Harassment

As noted above, the present fifth *ex parte* 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 once again in the present *ex parte* reexamination.

Moreover, as noted above, 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.

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Furthermore, the Patent Owner respectfully submits that the Requester's repeated requests for *ex parte* reexamination should have been rejected as being wasteful of USPTO resources and being fundamentally unfair to the Patent Owner. In a recent line of decisions, the Patent Trial and Appeal Board (PTAB) has delineated a rule governing follow-on requests for IPR. (See *Nvidia Corp. v. Samsung Electronics. Co.*, IPR2016-00134, 2016 Pat. App. Filings LEXIS 3606; and *General Plastic Indust. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357-61 (PTAB)). The Patent Owner submits that the PTAB should introduce the rationale from its *Nvidia* line of decisions within the framework of *ex parte* reexaminations.

III. 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) 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

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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 Office to confirm patentability of the rejected claims based on

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this reason alone.

(6) Argument

I. Lowrey et al. and Lightener et al. Fail to Disclose Each and Every Feature of the Claimed Invention

A. The Schema Teachings of Lowrey et al. Are Extremely Limited

Lowrey et al., like much of the prior art repeatedly considered in previous reexaminations, 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).

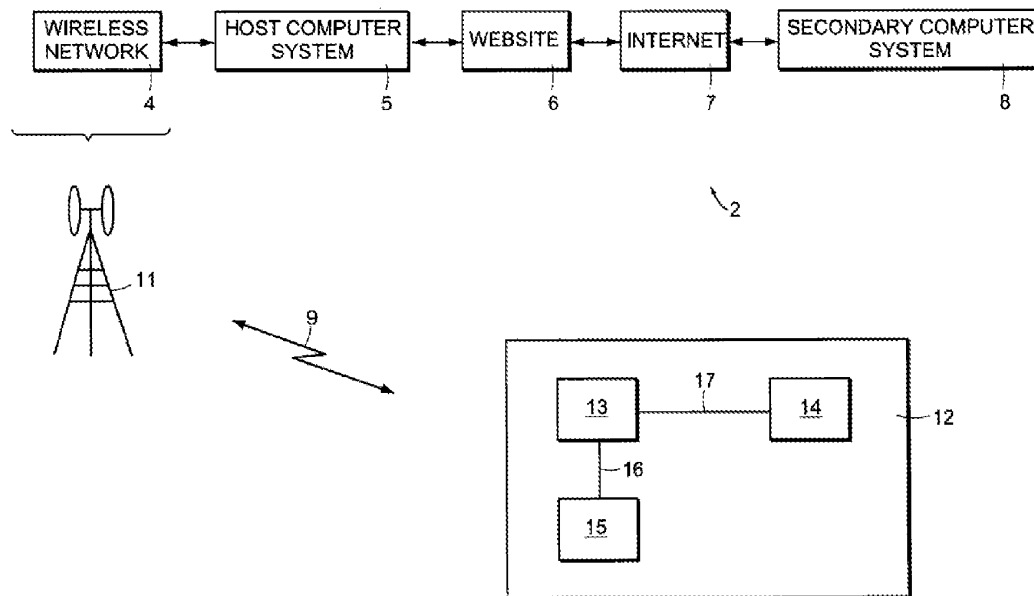


Figure 1 of Lowrey et al.

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As noted in the Second McAlexander Declaration, to be installed in a given vehicle, Lowrey et al. states: “[a] schema specific to a given type of vehicle is typically loaded onto the microcontroller before the wireless appliance is installed in the vehicle (step 22 in FIG. 2).” (Col. 6, lines 62-65: Emphasis Added; and see Exhibit 7, page 6). As described in Figure 2, the wireless appliance is installed with an “original data-collection schema”. (See Figure 2, reproduced below).

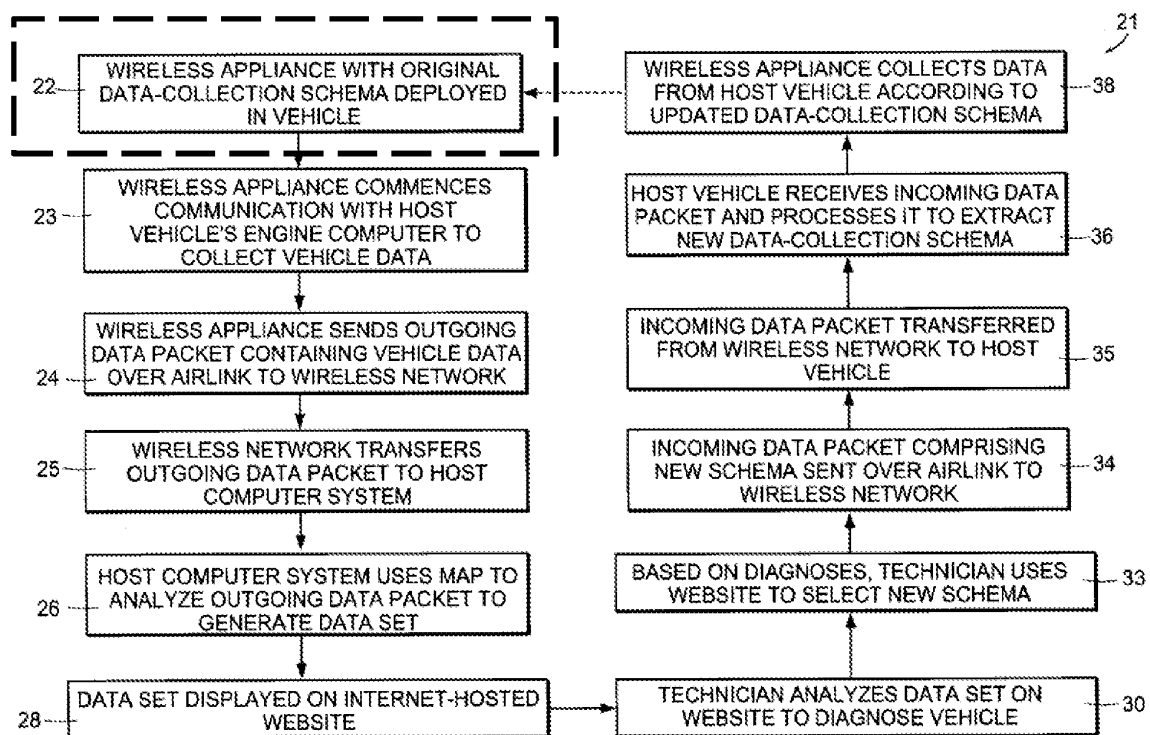


Figure 2 of Lowrey et al. (Annotated)

Once installed in the given vehicle, Lowrey et al.

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describes the schema as follows:

a schema component that identifies the diagnostic data to be collected from the vehicle's computer. The schema component features an **address** that describes a location of a diagnostic datum in the vehicle's computer memory. It can also describe a **time or frequency** that the data-collection component collects data from the vehicle's computer, or a time or frequency that the data-transmission component transmits an outgoing data packet.
(Col. 2, line 64 through Col. 3, line 5: Emphasis Added).

Lowrey et al. further recites:

a technician working at a vehicle-service center logs into the web site and analyzes the data set corresponding to a particular vehicle to diagnose a potential mechanical or electrical problem (step 30). ...

Based on the analysis, the technician may decide that additional data are required, or that data need to be collected and transmitted at a higher or lower frequency. In this case **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** (step 34). ...

The host vehicle receives the packet [in which the wireless appliance is already installed] and processes it to extract the new data-collection schema (step 36). The

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wireless appliance uses the **updated schema to extract a revised set of data from the vehicle's engine computer, or send out data at a revised frequency** (step 38).
(Col. 7, lines 14-37: Emphasis Added).

In other words, the wireless appliance is installed into the given vehicle with an original schema for that given vehicle. (See Exhibit 7, page 6). The schema itself is an "address that describes a location of a diagnostic datum in the vehicle's computer memory". (Col. 2, line 67; and see also Exhibit 7, page 6). If the technician reviewing the data transmitted from the wireless appliance to the remote host computer system needs more data, the technician commands the transmission of a new schema for the same given vehicle to collect additional data. In other words, as noted in the Second McAlexander Declaration, the new schema is for collecting more data for the same vehicle. (Exhibit 7, page 6).

Furthermore, the Patent Owner respectfully submits that Lowrey et al. fails to disclose "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", as recited in independent Claim 1, for example. In construing this claim feature, the PTAB noted: "this enabling data enables the recited controller to use a particular vehicle device code from among plural such codes for different vehicles by providing either (1) the code itself to the controller, or (2) data that otherwise enables the controller to

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select or generate the code.” (Exhibit 8, Decision on Appeal, Page 12, Emphasis Added; and see also Exhibit 7, page 6).

In the final Official Action, the Examiner noted:

the Office notes that the disclosed data packet containing a new schema is consistent with the Office’s interpretation of the claimed “enabling data” as including data that otherwise enables the controller to select or generate the code, since said new schema, which includes the data to collect and its location, enables the wireless appliance to collect that particular data, i.e., to use that particular vehicle device code from among plural such codes for different vehicles corresponding to different schemas). (Page 32).

As detailed above, the technician commands transmission of a new schema while the wireless appliance is installed in the same given vehicle. The schema only commands collection of additional data on the same vehicle. Therefore, Lowrey et al. fails to disclose the claimed enabling data feature.

In the Advisory Action, the Examiner stated: “the district court’s construction of the claimed ‘enabling data’ requires only data relating to a particular vehicle device code. Lowrey’s downloaded schema includes such data corresponding to a particular device code corresponding to the vehicle in which the device is currently connected.” (Page 7). The Patent Owner submits that this interpretation is improper. Rather, as correctly recognized by the PTAB, “this enabling data enables the

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recited controller to use a particular vehicle device code from among plural such codes for different vehicles..." (Exhibit 8, Decision on Appeal, Page 12, Emphasis Added).

In the Advisory Action, the Examiner stated: "[t]he Office also notes that there would be no reason why Lowrey's wireless appliance would download vehicle device codes that were applicable to a vehicle other than the vehicle in which it is currently installed." (Page 7). As pointed out by employees of the Requestor's own customer (CalAmp), the features of the claimed invention were the result of customer need to have multi-vehicle compatibility. (See *infra* §6(II)(F-G)). The "enabling data enables the recited controller to use a particular vehicle device code from among plural such codes for different vehicles", thereby providing the multi-vehicle compatibility. (Exhibit 8, Decision on Appeal, Page 12).

B. The Wireless Appliance of Lowrey et al. Is Not The Multi-Vehicle Compatible Controller As Defined in the Claims

The Patent Owner respectfully submits that Lowrey et al. fails to disclose "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.

In the final Official Action, the Examiner states:
a multi-vehicle compatible controller (see

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disclosure of the data-collection component of in-vehicle wireless appliance 13, and that said data-collection component includes a microcontroller, col. 6, lines 55-61; see also disclosure that the wireless appliance can be easily installed in nearly every vehicle with an OBD-II connector and can easily be transferred from one vehicle to another [i.e., multi-vehicle compatible], col. 4, lines 59-63) for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information.
(Page 29: Emphasis Added).

Whether the wireless appliance of Lowrey et al. can be physically and electrically installed in different vehicles is not pertinent. Rather, as supported in the Second McAlexander Declaration, Lowrey et al. is operationally compatible with one vehicle, namely the given vehicle whose memory locations correspond to that particular vehicle for which the wireless appliance and associated original schema were designed. (See Exhibit 7, page 6). As this Panel of the PTAB will recognize, this is similar to the deficiencies of Chou et al. correctly acknowledged by the PTAB in the related Second *ex parte* Reexamination of the '278 patent. Indeed, the PTAB noted:

[a]t best, Chou's controller is compatible with one vehicle, namely the particular vehicle whose fault codes correspond to that particular vehicle for which the controller was designed. Accord App. Br. 32 (noting that Chou's ECU s use their own respective trouble codes that are different for different

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vehicles). Although Chou's remote service center can work with different vehicle device codes using a server 201 and repository 203 in Figure 1 as Appellant acknowledges (App. Br. 37), Chou does not teach or suggest providing such a capability in a vehicle. (Exhibit 8, Decision on Appeal, pages 11-12: Emphasis Added).

In the Advisory Action, the Examiner stated:

Patent Owner's position seems to be that this disclosure supports physically installing the unit in a different vehicle, but that once installed in said different vehicle, it could not work.

However, there would be no point to disclosing the unit's ability to be transferred from one vehicle to another unless the unit had the capability to function in that different vehicle. Such a disclosure would be meaningless without the ability for the unit to actually function for its intended purpose once it has been 'easily transferred' from one vehicle to another. This ability is disclosed by virtue of the ability to download a new schema to the unit once installed in the different vehicle. (Page 8: Emphasis Added).

The Patent Owner respectfully submits that the Examiner is reading features into Lowrey et al. that are not disclosed therein. Just like the deficient device of Chou et al., the wireless appliance of Lowrey et al. can be transferred between vehicles,

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but it is not operationally compatible with the new vehicle. Rather, as disclosed in Lowrey et al., the schema will generate data and the remote technician will select a new schema, which is transmitted to the wireless appliance. (See Col. 7, lines 14-37). For these reasons, the Patent Owner submits that Lowrey et al. fails to disclose "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.

C. Lowrey Et Al. Teachings Are Similarly Deficient As Chou Et Al.

Lowrey et al., like much of the prior art repeatedly considered in previous reexaminations, 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 above).

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

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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.

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 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

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to raise a substantial new question of patentability by applying Flick '551, Brinkmeyer, Monroe, Drori, Space Daily Trimble, Mateja, and Holusha.

In the present *ex parte* 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]." (Official 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).

This same deficiency in multi-vehicle compatibility was found within Chou et al., as correctly recognized by the PTAB in the second reexamination of the '278 patent. Indeed, Chou et al.

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similarly could be physically and electrically installed in different vehicles. In that second reexamination, the current Requestor's customer also tried to make up for the multi-vehicle compatibility deficiency by relying on references to SAE manuals. The Patent Owner submits that the current rejection is similarly deficient to the rejection over Chou et al. and should be withdrawn.

In the Advisory Action, the Examiner responded that:

[alt col. 2, lines 2-3, Lowrey discloses that the in-vehicle wireless appliance 13 (i.e., the claimed multi-vehicle compatible controller) interfaces with other vehicle systems via the OBD-II connector, and furthermore that the OBD-II systems of the vehicle exchange data over a shared, standardized electronic buss which effectively functions as an on-board computer network in the vehicle, including many processors each of which transmits and receives data, col. 1, lines 14-22 et seq. These disclosures alone disclose the claimed "said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device."
(Page 9).

The Patent Owner respectfully submits that Lowrey et al. is similarly deficient to the Chou et al. prior art reference in the second reexamination of the '278 patent. Both Lowrey et al. and Chou et al. are reliant on remote staffed service centers

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to configure the vehicle controller to even work with the current vehicle, let alone multiple different vehicles.

Further, in the Advisory Action, the Examiner stated:

Lowrey discloses that the schema, which defines the data to be collected from the vehicle's engine computer, is specific to a given type of vehicle and is typically loaded onto the microcontroller before the wireless appliance is installed in the vehicle, col. 6, lines 62-65 et seq.
(Page 10).

In contrast, as previously recognized by the PTAB, the claims of the '278 patent have "enabling data [to] enable[] the recited controller to use a particular vehicle device code from among plural such codes for different vehicles", thereby providing the multi-vehicle compatibility. (Exhibit 8, Decision on Appeal, Page 12: Emphasis Added).

II. Evidence of Secondary Considerations and Declaration Evidence

A. There is Nexus Between The Evidence Of Secondary Considerations Supporting Non-obviousness And The Claimed Invention

In the Final Official Action, the Examiner stated:

"[i]n this case, upon consideration of Patent Owner arguments and the statements set forth in the McAlexander Declaration, it has been determined that there is no nexus between the merits of the claimed invention and the submitted evidence." (Official Action

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10-5-2021, page 17: Emphasis Added).

As detailed herein, the Patent Owner submits there is nexus between the copious amounts of evidence of secondary considerations supporting non-obviousness and the claimed invention. For example, there is a jury verdict finding the infringement/copying of the '278 patent's claims. (See Exhibit 2). This finding of infringement was confirmed by the Federal Circuit. Moreover, the jury verdict found evidence of that the licensing, commercial success, copying by others, and customer need was due to the merits of the claimed invention.

What more, the Jury Verdict indicated the limited value of products without the claimed invention. This finding was supported by the employees of the Requester's customer, who admitted during testimony that they copied the multi-vehicle compatibility of the '278 patent because their customers demanded the feature, and that their product had limited value without the critical multi-vehicle compatibility of the '278 patent. (See *infra* §6(I)(F). Peter Hergesheimer deposition, 46:25 - 47:19, "Do you know whether the LMU3000 would have any value if it didn't work on multiple vehicles? It would have a limited value.").

In the Advisory Action, the Examiner stated:

[w]ith respect to Patent Owner's secondary considerations arguments, the Office again notes the fact that Lowrey alone discloses that the wireless appliance can be easily installed in nearly every vehicle with an OBD-II connector and can be easily transferred from one vehicle to another (thus

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constituting the claimed multi-vehicle compatibility) at col. 4, lines 59-63.
(Page 11).

It appears the Examiner is proposing that since Lowrey et al. allegedly discloses a multi-vehicle controller, which the Patent Owner has argued to the contrary above, the Examiner may disregard the substantial amount of evidence of secondary considerations supporting non-obviousness of the claimed invention. This same evidence was found persuasive in both the Jury Trial and by the PTAB in the second reexamination of the '278 patent. Moreover, the Examiner may not disregard the substantial evidence of secondary considerations supporting non-obviousness of the claimed invention in the record of the present reexamination due to an alleged teaching within Lowrey et al. Indeed, the Examiner must carefully consider the evidence found favorable by the Jury and the PTAB and consider where the Patent Owner has rebutted the proposed conclusion of obviousness.

In the Advisory Action, the Examiner stated:
the fact that a jury and/or court considered 'secondary considerations' relevant to a finding of non-obviousness during previous litigation involving the '278 patent and two other patents is accorded little weight. The jury/court made their determination based upon evidence, including depositions and witness testimony, presented during the district court proceeding. However, that evidence, including depositions and witness testimony, is not of record in the instant reexamination proceeding such that the Office

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can make its own independent analysis
and determination.
(Page 11).

Again, this same evidence was found persuasive in both the Jury Trial and by the PTAB in the second reexamination of the '278 patent. Moreover, the Patent Owner has entered into the present record:

1. multiple Jury Verdicts from the related litigation with the Requester's customer
2. Final Order from the related litigation with the Requester's customer
3. Multiple Declarations from the technical expert from the from the related litigation with the Requester's customer
4. Decision on Appeal from prior reexamination finding the same evidence "further weighs in favor of Appellant." (Exhibit 8, page 14: Emphasis Added).

B. Introduction

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

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limited value for accused products without the invention, only further weighs in favor of Appellant." (Exhibit 8, Decision on Appeal, Application Serial No. 90/013,851, page 14: Emphasis Added).

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

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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.

C. 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

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multi-vehicle compatible controller.

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 First McAlexander 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

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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 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.

D. 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

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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:

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	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

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

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)).

E. 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

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

F. 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 provided:

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 First 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

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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.

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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

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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).

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G. Limited Value for Products Without the Invention

The Examiner's attention is directed to the section above regarding Commercial Success. (See *supra* §6(II)(D)). 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;

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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 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

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pending claims is rebutted.

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CONCLUSIONS

In view of the foregoing arguments, it is submitted that all of the claims are patentable over the prior art. Accordingly, the PTAB is respectfully requested to reverse the earlier unfavorable decision by the Examiner.

Respectfully submitted,
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