

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON CONNECT, INC.
Petitioner,

v.

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

Case No. IPR2023-01162

DECLARATION OF KENNETH E. FLICK

I, Kenneth E. Flick, declare as follows:

1. I am the president of Omega Patents, a business I started for the purpose of owning and licensing the patents for which I am inventor. I am the named inventor on over 100 issued patents.

2. Over the years I have assigned my patents to Omega Patents, which licensed many of them to industry participants. The patent portfolios that have generated the most revenue by far are the vehicle data bus portfolio and the vehicle tracker portfolio discussed below. Exhibit 2034 is a true and correct copy of a spreadsheet Omega Patents maintains to track its license revenue (through Q1 2023), including license revenue from the '278 patent.

3. I got involved in the vehicle accessory industry long before Omega Patents. My initial interest in the industry was approximately 50 years ago, and was the result of someone breaking into my car. After the break in, I went to an electronics store and bought a siren, relays, and an electrical lock switch, and wired it all up so that if you opened the door of my car, the alarm sounded.

4. From this initial alarm, I began installing alarms for friends and then for car dealerships. This led me to start a vehicle alarm business, which expanded its products and services to offering vehicle radios and other vehicle accessories.

5. Eventually my experience in the vehicle accessory industry led me to not only sell vehicle accessories at the retail level, but to also expand into the wholesale side of the industry. I formed a company called Omega Research and Development (“Omega R&D”) to design products for manufacture, and to sell those products, both at the wholesale and retail level. Years later, Omega R&D was the first licensee of patents owned by Omega Patents.

6. By the mid-1980s I was developing vehicle accessory products and having them manufactured overseas. I conceived of a number of innovative products in the vehicle accessory industry, but I subsequently saw products I developed being copied and sold by others in the marketplace. This was a trend I noticed -- I developed a product and sent it off for manufacturing, and within months of my product hitting the market there were other companies selling the same product.

7. In the mid-1990s, I decided I would begin seeking patents as I developed new technology. The first technology I sought patents on was several automatic transmitter verification or “ATV” patents.

8. A problem was encountered in trying to install an Omega R&D alarm system. Installers working on the Jeep Cherokee complained that the door locks were working differently. The Jeep was working differently because it was working from code on a data bus. It was one of the first cars I encountered that did door locks using codes on the data bus, where each door had a computer wire running into it. To install a traditional car alarm required taking apart a door panel and wiring relays to circumvent the data bus.

9. I recognized the need for devices that help interface and translate the signals from conventional vehicle accessories and devices into signals to use on data bus. But I also recognized that different manufacturers could use different codes. Based on this recognition, I conceived of U.S. Patent No. 5,719,551, a patent directed to a vehicle security system for a vehicle with a data bus which was enabled to operate with a desired set of signals for operating with a particular vehicle. From

the '551 patent sprang a number of other data bus inventions in the vehicle accessory industry, mostly focused on vehicle security and vehicle remote start.

10. In the 1990s I was operating Omega R&D on a daily basis, and I recognized the value as a manufacturer and seller of vehicle accessories of developing devices with multi-vehicle capability, such that only a few (or one) device(s) could be built and stocked. By inventing different embodiments of multi-vehicle compatibility, it limited the number of stock keeping units ("SKUs"), and therefore reduced the need to maintain inventory of numerous different units for different vehicles.

11. Around 2000 I developed a vehicle tracking system I referred to as the GPS 2000, which was a GPS tracking system that (among other features) communicated via a wireless interface (such as cellular) with a monitoring station. I also filed provisional patent applications related to my vehicle tracking system. The '278 patent was a subsequent invention that relates back to my other tracking inventions.

12. My data bus technology was not initially incorporated into vehicle tracking systems, as these were very different technologies. However, as I focused

more on vehicle tracking systems, I subsequently recognized the significant value that could be derived from combining the data bus technology I invented into the vehicle tracking systems. By combining my data bus technology into my ongoing development of vehicle tracking systems, it created an improved vehicle tracking system that could also be used to access and control vehicle devices, and/or read information from those devices, all via the vehicle data communications bus.

13. By incorporating multi-vehicle capability into these devices, as well as the ability to download data related to vehicle device codes, this further enhanced the benefits of these products and reduced the need for different SKUs (specific to particular vehicles). By also including a download interface, it provided the ability for the same tracking systems to operate in new vehicles as they are offered. I am unaware of any other approach available to achieve these benefits more directly than as described in the '278 patent. For example, I am not aware of any other commercially useful way for a vehicle tracking system to access the devices of the vehicle data bus to control or read data from the devices without the technology in the '278 patent. Shortly after I recognized the benefits of combining my data bus

technology into my vehicle tracking technology, I sought what became the '278 patent.

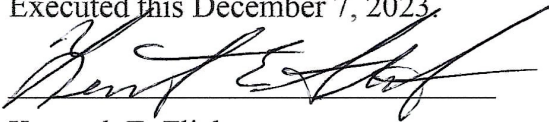
14. It was several years thereafter before the industry itself recognized these benefits and began to combine these technologies for commercial use.

15. By 2012 there were products being sold in the industry that took advantage of the '278 patent by companies that are now licensees. For example, Exhibit 2028 is a true and correct copy of Omega's license with Numerex Solutions, which offered products under the '278 patent. Exhibit 2025 is a true and correct copy of Omega's license with Enfora, another entity that accepted a license and sold products under the '278 patent. CalAmp Corp. began offering its LMU 3000 around the same time, as shown in Exhibit 2027, and a jury subsequently found that this product (and the LMU-3030, a subsequent model) infringed the '278 patent. Ex 2033. The products accused of infringement in litigation filed against Petitioner Verizon, as well as those of Geotab (which is a petitioner in another IPR proceeding), operate in the same manner as the CalAmp products already determined to infringe the '278 patent.

16. In addition to Numerex and Enfora, the '278 patent was also licensed to Directed Electronics, Cimble, Mid City Engineering, and Accele. True and correct copies of the licenses with these entities are at (respectively) Exhibits 2026, 2029, 2030 and 2031.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this December 7, 2023.

A handwritten signature in black ink, appearing to read "Kenneth E. Flick", written over a horizontal line.

Kenneth E. Flick