

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON CONNECT INC.,
Petitioner,

v.

OMEGA PATENTS, LLC
Patent Owner.

Case IPR2023-001162
Patent 8,032,278

PATENT OWNER'S SUPPLEMENTAL MANDATORY NOTICE

Pursuant to 37 C.F.R. §42.8(b), Patent Owner Omega Patents, LLC, submits the following Supplemental Mandatory Notice.

2. Related Matters

In accordance with 37 C.F.R. § 42.8(b)(3), Omega Patents, LLC identifies the following related matters at the time of this filing:

- 1) A civil action styled *Omega Patents, LLC v. Geotab USA, Inc., et al.*, No. 1:22-cv-01044-CFC (D. Delaware), which asserts U.S. Patent No. 8,032,278 assigned to Patent Owner Omega Patents, LLC.
- 2) A civil action styled *Omega Patents, LLC v. Verizon Connect, Inc., et al.*, No. 6:22-cv-02371-WWB-EJK (M.D. Florida), which asserts U.S. Patent No. 8,032,278 assigned to Patent Owner Omega Patents, LLC.
- 3) An *Inter Partes* Proceeding styled *Geotab USA, Inc. and Geotab, Inc. v. Omega Patents, LLC*, Proceeding Number IPR2023-00504.
- 4) An *ex parte* reexamination, application 90/014,419, was denied on January 27, 2020, but a Petition for Review of Reexam Denial filed on February 25, 2020, was granted in part on July 27, 2023. **On January 2, 2024, the USPTO mailed a Notice of Intent to**

Issue *Ex Parte* Reexamination Certificate with all claims confirmed patentable over the cited art, including the ‘885 patent to Flick and the ‘561 patent to Flick used by Petitioner in the present IPR. The Examiner also confirmed consideration of the present IPR and co-pending IPR proceeding referenced above.

Dated: January 3, 2024

Respectfully submitted,

/s/ Ryan T. Santurri

Lead Counsel

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on January 3, 2024, true and correct copies of the foregoing PATENT OWNERS' SUPPLEMENTAL MANDATORY NOTICE were served via electronic mail upon the following counsel for record for Petitioners:

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