

IPR2023-01162
U.S. Patent No. 8,032,278

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Verizon Connect Inc.,
Petitioner,

v.

Omega Patents, LLC,
Patent Owner.

IPR2023-01162
Patent No.: 8,032,278 B2

**PETITIONER VERIZON CONNECT INC.'S OBJECTIONS UNDER
37 CFR § 42.64(b)(1) TO PATENT OWNER'S SUPPLEMENTAL
MANDATORY NOTICE (PAPER 9)**

Petitioner Verizon Connect Inc. (“Petitioner” or “Verizon”) hereby submits these objections to the Supplemental Mandatory Notice (Paper 9) of Patent Owner Omega Patents, LLC (“Patent Owner” or “Omega Patents”).

On January 3, 2024, Patent Owner filed a Supplemental Mandatory Notice pursuant to 37 C.F.R. § 42.8(b) stating that a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (“Notice of Intent”) was mailed on January 2, 2024 in *Ex Parte* Reexamination Proceeding No. 90/014,419. Patent Owner did not provide notice to Verizon of its Supplemental Mandatory Notice prior to filing it.

In its Supplemental Mandatory Notice, Patent Owner highlighted and selectively discussed specific portions of the *ex parte* reexamination that it considered pertinent to this IPR proceeding. Among them, Patent Owner stated that the Examiner confirmed all claims patentable over the cited art, including two references cited in Verizon’s IPR Petition, U.S. Patent Nos. 6,756,885 (“’885 Patent”) and 6,606,561 (“’561 Patent”). Both references (and others) were cited in an Information Disclosure Statement on October 5, 2023. Patent Owner further stated in its Supplemental Mandatory Notice that the Examiner considered Verizon’s IPR proceeding and a co-pending IPR proceeding, the latter of which is understood to be a reference to the proceeding captioned as *Geotab USA, Inc. and Geotab, Inc. v. Omega Patents, LLC*, Proceeding Number IPR2023-00504 (the “Geotab IPR

Proceeding”). The Geotab IPR Proceeding was instituted on July 25, 2023. Both the Verizon and Geotab IPR proceedings are pending before the same three-judge panel.

The Board has stated that a Mandatory Notice cannot be used to advocate the conclusion a party urges in a pending matter and that an appropriate notice should only note that a determination in a proceeding involving the subject patent has been issued. See *Biodelivery Sciences International, Inc., v Monosol Rx, LLC*, IPR2015-00165, Paper 67, at pp. 2-3 (“Rather than merely identifying an allegedly related Board *inter partes* reexamination decision, Paper 61 quoted the portions of the decision that were considered pertinent, and implicitly explained why those portions of the decision were relevant to the instant proceedings. An appropriate notice simply would have noted that the Board had issued a decision in a related proceeding.”); *Masterimage 3D, Inc., et al., v. Reald Inc.*, IPR2015-00040, Paper 81, at pp. 2-3 (“Patent Owner has misused the filing of a Mandatory Notice under 37 C.F.R. § 42.8(b)(2) with regard to related matters by specifically highlighting and discussing the substantive contents of Judge Essex’s Initial Determination.... An appropriate notice simply would have noted that Judge Essex had issued an Initial Determination.”).

Patent Owner omitted from its Supplemental Mandatory Notice that the Notice of Intent was based on the Board's findings of secondary considerations in the *ex parte* reexaminations.¹ The Board addressed the issue of secondary considerations in the Geotab IPR Proceeding and found it to be an inappropriate basis to deny institution of Geotab's petition. *See* IPR2023-00504, Paper 11, at p. 48, Institution Decision ("We agree with Petitioner that it would [be] inappropriate at this stage of the proceeding to deny institution based on Patent Owner's evidence of secondary considerations. Secondary considerations are highly fact-intensive and implicate genuine issues of fact more appropriately resolved on a fully developed record. At this stage, Patent Owner does not appear to have fully supplied its secondary considerations evidence to the Board.").

Patent Owner further omitted from its Supplemental Mandatory Notice that the Examiner did not make any findings about Verizon's IPR Petition or any of the art cited therein. Instead, the Examiner specifically noted in the Notice of Intent at

¹ Reexamination Proceeding No. 90/014,419, Notice of Intent, at p. 9 ("The Patent Owner's Statement included a number of arguments. Among them, the Patent Owner argued that in view of Secondary Considerations, claims 1-22 are confirmable over the prior art cited in the Request. The Patent Owner cited the PTAB's decisions reversing the examiner's obviousness claim rejections in the Second Reexamination and the Fifth Reexamination, based upon evidence of Secondary Considerations made of record in the respective reexamination proceedings. These arguments are persuasive.")

pp. 9-10 (citing to MPEP §§ 2256² and 2656) that the degree of consideration with respect to the Patent Owner's IDS is "limited by the degree to which the party filing the information citation has explained the content and relevance of the information."

In its IDS, Patent Owner did not address Verizon's IPR Petition or explain the content or relevance of the art cited in Verizon's Petition.

Verizon brings this information to the Board's attention so that Board can consider Omega's Supplemental Mandatory Notice in the proper context.

² MPEP § 2256 states: "Where patents, publications, and other such documents are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the document. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08 or its equivalent, without an indication to the contrary in the record, do not signify that the document has been considered by the examiner any further than to the extent noted above." MPEP § 2656 tracks this language in all relevant parts.

Dated: January 8, 2024

/s/ Ashe Puri

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.105, the undersigned hereby certifies that on January 8, 2024, a true and correct copy of the foregoing PETITIONER VERIZON CONNECT INC.'S OBJECTIONS UNDER 37 C.F.R. § 42.64(b)(1) TO PATENT OWNER'S SUPPLEMENTAL MANDATORY NOTICE (PAPER 9) was served via electronic mail on the Patent Owner upon the following counsel of record:

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Dated: January 8, 2024

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