

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 8,032,278 B2

Before BARRY L. GROSSMAN, AMBER L. HAGY, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Verizon Connect Inc. (“Petitioner”) filed a petition to institute *inter partes* review of claims 1–22 of U.S. Patent No. 8,032,278 B2 (Ex. 1001, “the ’278 patent”). Paper 2 (“Pet.”). Omega Patents, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314 to determine whether to institute an *inter partes* review. The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” If the Board institutes trial, it “will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. § 42.108(a); *see also PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”).

Applying those standards, and upon considering the Petition, the Preliminary Response, and the evidence of record, we determine the information presented shows a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one of the challenged claims of the ’278 patent. Accordingly, we institute an *inter partes* review of all challenged claims (i.e., 1–22) of the ’278 patent, based on the grounds asserted in the Petition.

II. BACKGROUND

A. *Related Matters*

Petitioner identifies the following district-court proceedings as “pending” related matters involving the ’278 patent: *Omega Patents, LLC v. Geotab USA, Inc.*, Case No. 1:22-cv-01044-CFC (D. Del.); *Omega Patents, LLC v. Geotab USA, Inc.*, Case No. 1:23-cv-00382 (D. Del.); *Omega Patents, LLC v. Verizon Connect, Inc.*, Case No. 6:22-cv-02371-WWB-EJK (M.D. Fla.). Pet. 71; *see also* Paper 9, 2 (Patent Owner’s Supplemental Mandatory Notices). Petitioner also identifies several other district-court proceedings as related matters. *See* Pet. 71 (noticing *Omega Patents, LLC v. Enfora, Inc.*, Case No. 1:13-cv-00646 (N.D. Ga.); *Omega Patents, LLC v. Enfora, Inc.*, Case No. 1:17-cv-02769 (N.D. Ga.); *Omega Patents, LLC v. CalAmp Corp.*, Case No. 6:13-cv-01950 (M.D. Fla.); *Omega Patents, LLC v. DEI Holdings, Inc.*, Case No. 6:20-cv-00693 (M.D. Fla.)).

The parties also identify a pending *inter partes* review involving the ’278 patent: *Geotab USA, Inc. and Geotab, Inc. v. Omega Patents, LLC*, IPR2023-00504 (trial instituted July 25, 2023) (“the 504 IPR”). Pet. 71; Paper 9, 2.

Petitioner also states that the ’278 patent was the subject of several *ex parte* reexamination proceedings: Serial No. 90/013,587; Serial No. 90/013,851; Serial No. 90/014,309; Serial No. 90/014,419; and Serial No. 90/014,675. Pet. 71–72. Patent Owner also identifies *ex parte* reexamination Serial No. 90/014,419 as a related matter. Paper 9, 2–3.

B. *Real Parties in Interest*

Petitioner identifies itself and also identifies Verizon Communications Inc. and Verizon Corporate Resources Group LLC as its real parties in

interest. Pet. 70. Patent Owner identifies Omega Patents, LLC, as its real party in interest. Paper 3, 2 (Patent Owner's Mandatory Notices).

C. Overview of the '278 patent

The '278 patent, titled "Vehicle Tracking Unit with Downloadable Codes and Associated Methods," relates to multi-vehicle compatible tracking systems that can also remotely control various vehicle functions and/or read the status of various vehicle devices. Ex. 1001, code (57), 2:38–49. Figure 1, reproduced below, is a block diagram of a multi-vehicle compatible tracking system according to the '278 patent. *Id.* at 3:49–50.

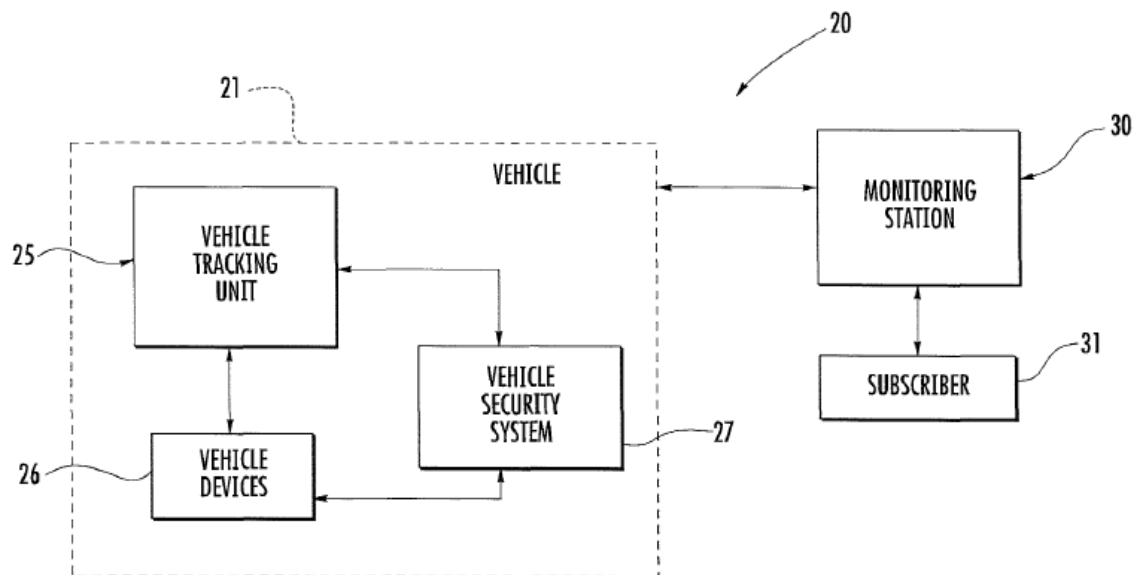


Fig. 1 is a block diagram of a multi-vehicle tracking system according to the '278 patent. Ex. 1001, 3:49–50.

As shown in Figure 1, the multi-vehicle tracking system 20 includes a vehicle tracking unit 25 mounted onto a vehicle 21 and a remote monitoring station 30. *Id.* at 4:32–37. The vehicle tracking unit may interact with various vehicle devices 26 to provide information about the vehicle to the monitoring station. *Id.* at 4:37–40.

Figure 10, reproduced below, provides a block diagram of a multi-vehicle compatible tracking unit according to one embodiment of the '278 patent. *Id.* at 4:4–5.

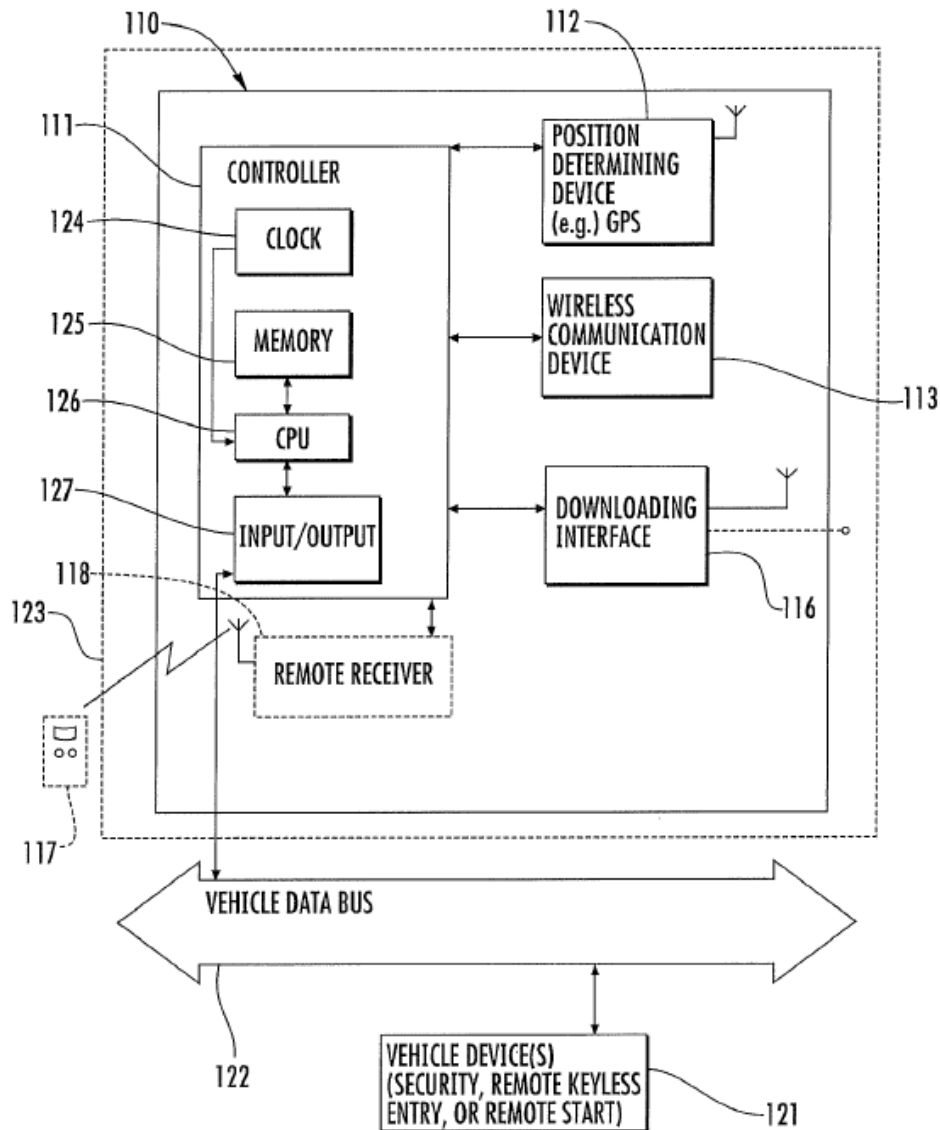


Fig. 10 is a simplified block diagram of a multi-vehicle compatible tracking unit according to the '278 patent. Ex. 1001, 4:5–6.

As shown in Figure 10, multi-vehicle compatible tracking unit 110 includes multi-vehicle compatible controller 111, vehicle position determining device 112 (e.g., GPS), wireless communications device 113,

and downloading interface 116. *Id.* at 23:46–51, 24:4–8. The multi-vehicle compatible controller cooperates with vehicle position determining device 112 and wireless communication device 113 to send vehicle location information. *Id.* at 23:48–51.

Multi-vehicle compatible controller 111 is also coupled to vehicle data bus 122 (i.e., an internal communications network) extending throughout the vehicle. *Id.* at 23:43–46, 23:59–61. Multi-vehicle compatible controller 111 uses the vehicle data bus to communicate with vehicle device(s) 121. *Id.* at 23:59–61. Specifically, the multi-vehicle compatible controller sends “at least one corresponding vehicle device code from among a plurality thereof for different vehicles” to vehicle devices 121 over vehicle data bus 122. *Id.* at 23:61–67. The vehicle codes may be for reading from, and/or writing instructions to, the vehicle devices. *Id.* at 23:67–24:3.

To be compatible with multiple vehicles, the multi-vehicle compatible controller receives, selects, and/or generates vehicle codes by receiving “enabling data” downloads through downloading interface 116. *Id.* at 24:4–12. 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.” *Id.* at 24:8–13. The downloading interface may be in the form of a wireless signal downloading interface or a wired signal downloading interface. *Id.* at 24:14–18, 24:33–34.

D. The Challenged Claims

Petitioner challenges claims 1–22 of the '278 patent. Pet. 6. Claim 1, reproduced below, is independent and illustrative of the subject matter recited in the challenged claims.¹

1. [1pre] 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:

[1a] a vehicle position determining device;

[1b] a wireless communications device;

[1c] a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information;

[1d] 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

[1e] 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.

Ex. 1001, 25:64–26:15.

¹ Herein, we use alphanumeric prefixes for each limitation consistent with Petitioner's usage. *See* Pet. 21–32.

E. Evidence

Petitioner submits evidence including:

Evidence	Exhibit No.
Declaration of Dr. Azim Eskandarian	1002
U.S. Patent No. 6,756,885 B1 (Jun. 29, 2004) (“Flick ’885”)	1003
U.S. Patent No. 6,606,561 B2 (Aug. 12, 2003) (“Flick ’561”)	1004
U.S. Patent App. No. 2006/0161315 A1 (pub. July 20, 2006) (“Lewis”)	1005
U.S. Patent App. No. 2003/0182033 A1 (pub. Sept. 25, 2003) (“Underdahl”)	1006

F. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 6):

Claim(s) Challenged	35 U.S.C. §	Reference(s)
1–22	103(a) ²	Flick ’885, Flick ’561
1–6, 8, 10–14, 16, 18, 19, 21	102(a)	Lewis
7, 9, 15, 17, 20, 22	103(a)	Lewis, Underdahl

Patent Owner disputes Petitioner’s asserted grounds of unpatentability and presents the testimony of Kenneth Flick (Ex. 2001) as well as Joseph McAlexander III (Ex. 2002).

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Because the ’278 patent was filed and issued before 2013, we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103. Our decision would be the same were we to apply the AIA versions of the statute.

G. The Prior Art

We provide brief summaries of the asserted references.

1. Flick '885 (Ex. 1003)

Flick '885, titled “Multi-Vehicle Compatible Control System for Reading From a Data Bus and Associated Methods,” was granted to the same inventor as the '278 patent, and relates to multi-vehicle compatible control (“MVCC”) systems for remotely controlling various vehicle functions, e.g., vehicle security, remote keyless entry, and remote starting. Ex. 1003, codes (57), (75). Flick '885 issued on June 29, 2004 (*id.* at code (45)), and Petitioner contends it is prior art under 35 U.S.C. § 102(b). Pet. 19. Patent Owner does not challenge the prior-art status of Flick '885. See Prelim. Resp. 6.

Figure 1, reproduced below, is a block diagram of a MVCC system according to Flick '885. Ex. 1003, 4:26–29.

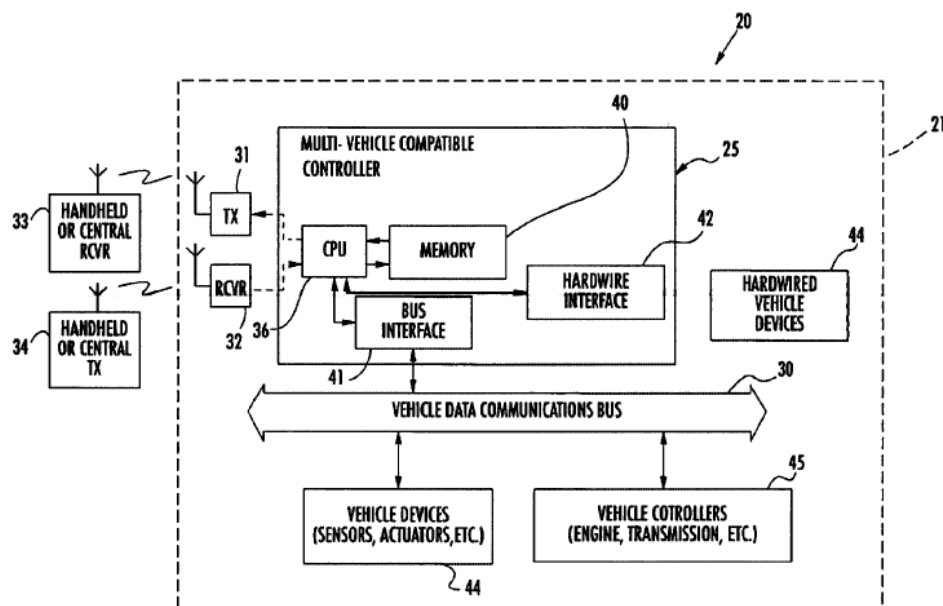


Fig. 1 is a schematic block diagram of a multi-vehicle control system including a multi-vehicle compatible controller connected to a data communications bus and other hard-wired devices. Ex. 1003, 4:27–30.

As shown in Figure 1, control system 20 for vehicle 21 includes MVCC 25 connected to vehicle devices 44 and vehicle controllers 45 through vehicle data communications bus 30. *Id.* at 5:5–8; *see also id.* at 6:41–52. The control system also includes transmitter 31 for communicating vehicle information (e.g., security alerts) to remote receiver 33, and receiver 32 for receiving instructions (e.g., remote starting) from remote transmitter 34. *Id.* at 5:16–29.

To be compatible with multiple vehicles, the multi-vehicle compatible controller generates multiple command signals or codes on the data communications bus for the vehicle device, “and only that code for the given vehicle and device will cause an operation or response from the vehicle device.” *Id.* at 7:23–38.

2. *Flick ’561 (Ex. 1004)*

Flick ’561, titled “Vehicle Tracker Including Input/Output Features and Related Methods,” was also granted to the same inventor as the ’278 patent, and relates to a vehicle tracking unit mounted in a vehicle to interface with various vehicle devices. Ex. 1003, codes (57), (75). Flick ’561 issued on August 12, 2003. *Id.* at code (45). Flick ’561 is listed in the priority chain for the ’278 patent, but the Board has previously determined that the earliest priority date for the ’278 patent is its filing date of July 3, 2007 (Ex. 1010, 5–6), and Patent Owner did not appeal that decision. *See* Pet. 6–9 (citing Ex. 1010, 1011). Petitioner, therefore, contends that Flick ’561 is prior art under 35 U.S.C. § 102(b). *Id.* at 19. Patent Owner does not challenge the prior-art status of Flick ’561. *See* Prelim. Resp. 6.

Figure 2, reproduced below, is a block diagram of a vehicle tracking unit according to Flick ’561. Ex. 1004, 3:39–40.

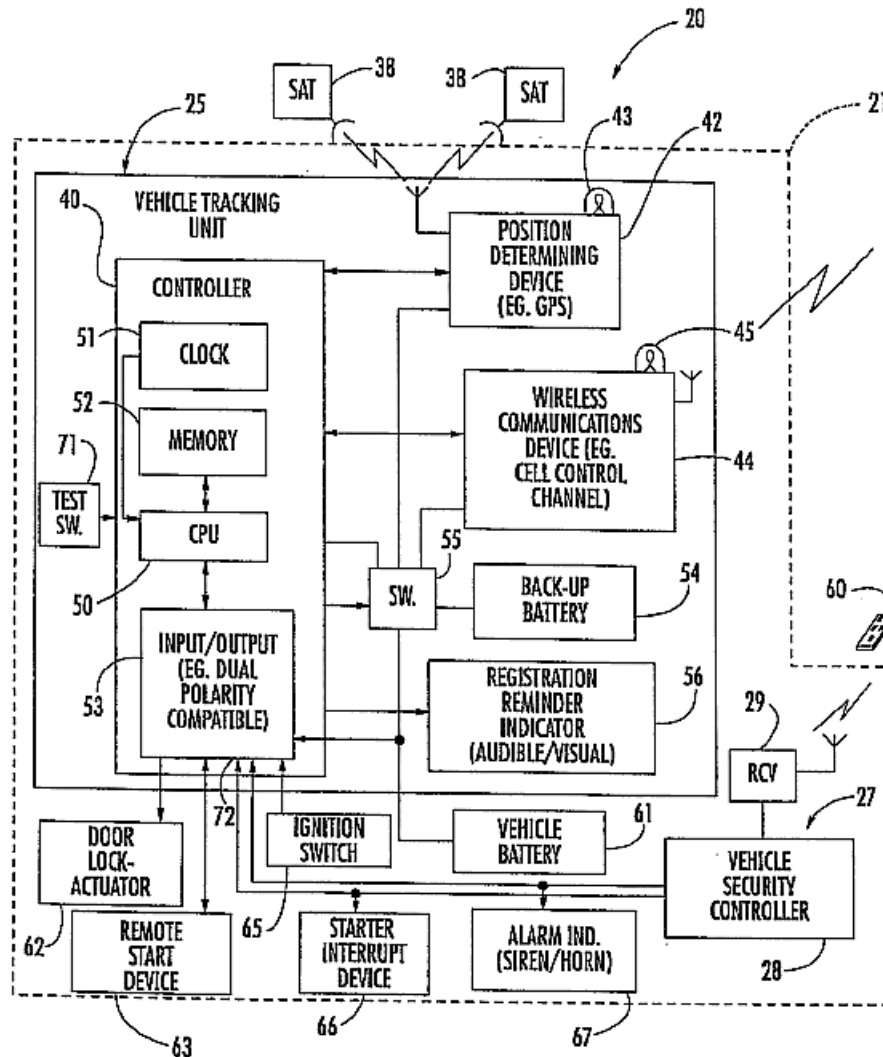


FIG. 2.

Fig. 2 is a detailed block diagram of a vehicle tracking unit. Ex. 1004, 3:39–40.

The vehicle tracking unit as described in Flick '561 includes vehicle position determining device 42 (e.g., GPS) and wireless communications circuitry cooperating to communicate a vehicle position to a monitoring station, such as based upon a vehicle alarm activation. *Id.* at 4:56–63, 8:6–20, 8:56.

3. *Lewis (Ex. 1005)*

Lewis is directed to a transportation system that integrates vehicle position and performance tracking and wireless networking to monitor vehicle position and performance over the Internet. Ex. 1005 ¶ 2. Lewis was filed on November 22, 2004, and was published on July 20, 2006. *Id.* at codes (22), (43). Petitioner contends that Lewis is prior art under 35 U.S.C. § 102(a). Pet. 48. Patent Owner does not contest the prior-art status of Lewis.

The system described in Lewis includes a GPS position receiver that collects position data of the vehicle. Ex. 1005 ¶¶ 24, 26. The GPS-based position data along with onboard diagnostic data is wirelessly communicated to off-site computers. *Id.* ¶¶ 26–27.

4. *Underdahl (Ex. 1006)*

Underdahl was filed on January 10, 2003, and was published on September 25, 2003. *Id.* at codes (22), (43). Petitioner contends that Underdahl is prior art under 35 U.S.C. § 102. Pet. 49. Patent Owner does not contest the prior-art status of Underdahl. Underdahl discloses a system for tracking usage habits of a vehicle. Ex. 1006, Abs., ¶ 3.

III. DISCRETION UNDER 35 U.S.C. § 325(d)

Patent Owner argues that we should exercise our discretion under § 325(d) and deny institution. Prelim. Resp. 54–58. Petitioner opposes. Pet. 69–70. Upon consideration of the parties’ respective arguments, discussed below, and the relevant non-exclusive factors set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton Dickinson*”), as applied to the record in this case, we find that the factors do

not weigh in favor of exercising our discretion to deny institution under § 325(d).

A. Legal Framework

Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).³ In evaluating matters under § 325(d), the Board uses the following two-part framework:

(1) determining whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, determining whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Id.* at 8.

We consider the non-exclusive *Becton Dickinson* factors, which “provide useful insight into how to apply the framework” under § 325(d). *Advanced Bionics*, 9. These non-exclusive factors include:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;

³ The Board institutes trial on behalf of the Director. 37 C.F.R. § 42.4(a); *Advanced Bionics*, 7, n.7.

- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton Dickinson, 17–18 (formatting added). “If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office.” *Advanced Bionics*, 10.

B. Analysis

The first part of the *Advanced Bionics* two-part framework relates to whether the same or substantially the same art or arguments were presented previously to the Office. *Advanced Bionics*, 10. As discussed below, although we agree that Flick ’885 was previously presented to the Office, we determine that the combination of Flick ’885 and Flick ’561 was not previously presented. Consequently, we determine that the same or substantially the same prior art or arguments were not previously presented to the Office, and we decline to exercise our discretion under § 325(d) to deny institution of trial.

1. Flick ’885 Combined with Flick ’561

Patent Owner argues that the Office already considered Flick ’885 during prosecution of the ’278 patent and notes that Flick ’561 “is in the priority chain” of Flick ’885. Prelim. Resp. 55–56.

There can be no dispute that Flick ’885 was presented previously to the Office because it is a reference cited on the face of the ’278 patent.

See Ex. 1001, code (56). *See Advanced Bionics*, 7–8 (indicating that “previously presented art” includes “art made of record by the Examiner”). Flick ’561, however, was not before the Examiner during the original prosecution leading to the ’278 patent.⁴ *See* Ex. 1001, code (56).

Patent Owner does not, moreover, contend that the *combination* of Flick ’885 and Flick ’561 was considered during prosecution of the ’278 patent, but asserts that it “is essentially the same novelty challenge as” the combination of Flick ’885 and the Hunt reference that the petitioner has presented in the pending 504 IPR (which was instituted on July 25, 2023). *See* Prelim. Resp. 56. In particular, Patent Owner asserts that, in the 504 IPR, “Hunt was used in the Geotab IPR just like Flick561 – as disclosing a tracker unit or GPS. Hunt is directed to the monitoring of a vehicle, particularly, for analyzing a vehicle’s GPS and diagnostic data Petitioner fails to present anything here not already before the PTAB.” *Id.*

⁴ In its Supplemental Mandatory Notice, filed January 3, 2024, Patent Owner notes that *Ex Parte* Reexamination No. 90/014,419, which was granted in part on July 27, 2023, resulted in issuance of a certificate on January 2, 2024, confirming all claims patentable. Paper 9, 2–3. Patent Owner represents that the Examiner confirmed patentability over the Flick ’885 and Flick ’561 patents at issue here. *Id.* We have reviewed the Notice of Intent to Issue *Ex Parte* Reexamination Certificate, mailed January 12, 2024, and note that neither Flick ’885 nor Flick ’561 are mentioned therein; rather, the basis for this reexamination was obviousness over U.S. Patent No. 5,719,551 to Flick. Flick ’885 and Flick ’561 were, however, each individually cited in an IDS, along with dozens of other references, but we have no indication that such references were substantively considered by the Examiner, alone or in combination. Moreover, the Examiner’s statement of reasons for allowance is reliance on evidence of secondary considerations made of record in previous reexamination proceedings, which we address *infra* Section IV.C.1.c). Accordingly, this recent development does not change our analysis herein.

In essence, Patent Owner argues that because a similar combination forms the basis for institution in a pending *inter partes* review, involving a different petitioner, the present Petition should be discretionarily denied institution under § 325(d). Under the facts before us, we decline to exercise discretion to deny institution.

First, we note that, under some circumstances, § 325(d) may provide a basis for discretionary denial based on prior art and arguments presented in a previous *inter partes* review.⁵ Although the *Becton Dickinson* factors are focused on the question of whether the same or substantially the same art or arguments were previously presented during initial examination of the challenged patent,⁶ *Advanced Bionics* explains that these factors “more broadly provide guidance as to whether the art presented in the petition is the ‘same or substantially the same’ as the prior art previously presented to the

⁵ See, e.g., *Medtronic, Inc. v. NuVasive, Inc.*, IPR2014-00487, Paper 8 at 5–7 (PTAB Sept. 11, 2014) (informative) (exercising discretion under section 325(d) to deny institution of third petition filed by same petitioner that raised same prior art as a petition for which review was already denied); *Unified Patents, Inc. v. PersonalWeb Techs., LLC*, IPR2014-0072, Paper 13 at 7–9 (PTAB July 24, 2014) (informative) (exercising discretion under section 325(d) to deny institution where petition challenged overlapping claims, over same prior art, as presented in two prior petitions, one of which had progressed to a final written decision).

⁶ *Becton Dickinson* involved prior art references that had previously been considered by the Examiner during prosecution. See *Becton Dickinson*, Paper 8 at 18 (“Woehr, relied upon by Petitioner as the base reference here, was also the base reference in the Examiner’s Woehr/Rogers obviousness rejection during examination.”). Thus, in *Becton Dickinson*, the Board weighed “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” *Id.* at 17.

Office during *any* proceeding, including prior AIA proceedings.” *Advanced Bionics*, Paper 6, at 9–10.

Nevertheless, *Advanced Bionics* counsels that the existence of a co-pending review of a patent over the same or similar prior art may not be sufficient to warrant denial. “At bottom,” noted the panel in *Advanced Bionics*, the two-part framework utilized for 35 U.S.C. § 325(d) “reflects a commitment to defer to *previous Office evaluations* of the evidence of record unless material error is shown.” *Id.* at 9 (emphasis added). Although the art in the 504 IPR at least overlaps with the art presented here, that art has not yet been fully considered or evaluated. There has been no final determination in that proceeding as to the scope of the prior art nor any final determination as to whether the submitted evidence is sufficient to show that any claims of the ’278 patent are unpatentable. As such, there is no reference point under the *Advanced Bionics* framework to determine whether the Office erred; there has simply been no final determination to analyze or reconsider. Accordingly, under the facts before us, we conclude that the preliminary consideration by the Board in the 504 IPR, determining to institute a trial based on a petition filed by an unrelated petitioner,⁷ is not a

⁷ When different petitioners challenge the same patent, discretionary denial may be appropriate under 35 U.S.C. § 314(a) upon evaluation of the non-exhaustive factors set forth in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 15–16 (Sept. 6, 2017) (precedential). See *Valve Corp. v. Elecs. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, at 2, 9 (April 2, 2019) (precedential) (applying the *General Plastic* factors to a second petition filed by a different party). Application of the *General Plastic* factors, however, requires analysis of, among other things, any relationship between the different petitioners and the timing of the second petition with respect to Patent Owner’s preliminary response and the Board’s institution decision in the first proceeding. *Valve Corp.*, Paper

sufficient demonstration that the prior art raised therein was “previously presented” so as to satisfy *Becton Dickinson* or the statute.

Thus, we decline to exercise our discretion to deny institution under 35 U.S.C. § 325(d) on these facts.

2. *Lewis Alone or Combined With Underdahl*

Because we decide to go forward on the Flick ’885 / Flick ’561 grounds (as explained below), and going forward on those grounds means going forward also on the remaining grounds,⁸ we need not reach Patent Owner’s § 325(d) arguments concerning Lewis and Underdahl.

Nevertheless, we note that Patent Owner, as the requesting party, fails to persuade us that Lewis and Underdahl are the same or substantially the same art as the Lowry and Lightner references. *See* 37 C.F.R. § 42.20(c).

Patent Owner argues that the Lewis reference, which forms the basis for Petitioner’s other two grounds, is “similar” to the Hunt reference that forms the basis for the 504 IPR, and is also similar to the Lowry and Lightner references addressed during prosecution of the ’278 patent. Prelim. Resp. 56–58. Patent Owner also contends that Underdahl is “like” Lewis “in that it can operate on different vehicles within the SAE J1850 network, includes a GPS receiver, and communicates vehicle information

11, at 9, 12. Patent Owner presents no arguments or evidence in favor of discretionary denial on this basis. Accordingly, we do not consider discretionary denial under § 314(a).

⁸ *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1353 (2018) (“The agency cannot curate the claims at issue but must decide them all.”); *see also* 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

and position remotely from the vehicle.” *Id.* at 58. But Patent Owner’s arguments are lacking in substantive analysis.

In support of its arguments, Patent Owner argues that Hunt, Lowrey, and Lightner share inventors in common, and “are directed to the same common technology”—i.e., wireless appliances that can track and transmit vehicle location. *See id.* at 57 (arguing that Lowrey “is directed to an internet-based vehicle diagnostic system that includes a wireless appliance in electrical contact with an in-vehicle computer and that can report position date [sic] from a GPS device,” Lightner “is directed to a wireless diagnostic system and method for monitoring vehicles that includes a wireless appliance that can be physically and electrically installed,” and Hunt “is directed to small-scale integrated vehicle telematics device that collects, transmits, and analyzes diagnostic and location-based data from a motor vehicle”). Notably, Patent Owner does not make specific representations about Lewis or Underdahl relative to Hunt, Lowrey, or Lightner, but appears to argue Hunt as a proxy for Lewis (*see id.*), and then simply makes conclusory statements as to Underdahl (*see id.* at 58).

We have considered Patent Owner’s arguments, but are not persuaded that either Lewis or Underdahl is substantially the same art as Hunt, Lowrey, or Lightner. As an initial matter, we are not persuaded that common technology—standing alone—satisfies the “substantially the same art” test of the *Advanced Bionics* two-part framework. *Advanced Bionics* counsels us to review whether Petitioner relies on Lewis and Underdahl in substantially the same manner that the Office relied on Lowrey or Lightner during reexamination. *See Advanced Bionics* at 15 (in analyzing whether Charvin and Zimmerling are “substantially the same art,” “review[ing] whether

Petitioner relies on Charvin in substantially the same manner as the Examiner cited Zimmerling during prosecution such that Charvin discloses substantially the same information as Zimmerling in relevant part”). As noted above, as the party requesting that we exercise our discretion to deny institution under § 325(d), Patent Owner fails to meet its burden in this regard. For example, Patent Owner does not explain how the Board or Examiner relied on the disclosures of Lowrey and Lightner during reexamination in the same manner as Petitioner relies on Lewis alone or in combination with Underdahl in the Petition. *See generally* Prelim. Resp. 56–58. Nor does Patent Owner present a detailed analysis of the similarities between the disclosures of Lewis or Underdahl as compared to Lowrey or Lightner sufficient for us to determine that Lewis alone or combined with Underdahl discloses the same relevant information as Lowrey or Lightner. *See id.*

Thus, on these facts, we decline to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

3. *Secondary Considerations*

Patent Owner also argues that “[t]he PTAB has twice considered the sufficiency of evidence of secondary considerations.” Prelim. Resp. 58 (citing *Ex parte Omega Patents, LLC*, Appeal No. 2018-008119 (Nov. 3, 2018) (“*Omega Patents I*,” Ex. 2005) and *Ex parte Omega Patents, LLC*, Appeal No. 2022-003758 (Dec. 1, 2022) (“*Omega Patents II*,” Ex. 1015)). As addressed in more detail below (Section IV.C.1.c), we are not persuaded that the Board’s treatment of secondary considerations in those cases compels discretionary denial under § 325(d) in this case. As noted above, all

of Petitioner's asserted grounds of unpatentability include combinations of references that were not presented previously to the Office.

Moreover, for the reasons explained below with respect to Petitioner's alleged grounds of unpatentability for obviousness, we determine that the combination of Flick '885 and Flick '561 provides strong evidence of unpatentability based on the record before us at this stage of the proceeding. *Infra* Section IV.C. This evidence may weigh differently against Patent Owner's evidence of secondary considerations than the other prior art weighed in previous cases. "Obviousness is ultimately a legal determination, and a strong showing of obviousness may stand even in the face of considerable evidence of secondary considerations." *ZUP, LLC v. Nash Mfg., Inc.*, 896 F.3d 1365, 1374 (Fed. Cir. 2018). Thus, while we do not second-guess our colleagues' decisions that Patent Owner's evidence of secondary considerations either outweighed or "further weigh[ed]" against the Examiner's evidence of obviousness based on other prior art, we cannot say the same at this stage of the proceeding based on Flick '885 and Flick '561.

Finally, this is not a case where Petitioner failed to address known evidence of secondary considerations. *See, e.g., Stryker Corp. v. KFX Medical, LLC*, IPR2019-00817, Paper 10 at 29 (PTAB Sept. 16, 2019) (finding that "Petitioner's failure to address the known evidence of secondary considerations further weighs in favor of denying institution" and collecting decisions).

C. Summary

For the reasons discussed above, we decline to exercise our discretion pursuant to 35 U.S.C. § 325(d) to deny institution of trial. In so doing, we

recognize the past considerations by the Office, by the Board, and by the courts, but, as explained above, we determine that this case includes different evidence and arguments than these previous cases, which merit our further consideration of patentability.

IV. PATENTABILITY ANALYSIS

In an *inter partes* review, “the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Petitioner ultimately bears the burden of persuasion to prove unpatentability of each challenged claim by a preponderance of the evidence. 35 U.S.C. § 316(e). This burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The Board may authorize an *inter partes* review if we determine that the information presented in the Petition and Patent Owner’s Preliminary Response shows that there is a reasonable likelihood that Petitioner will prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a).

A. Level of Ordinary Skill in the Art

We consider the asserted grounds of unpatentability in view of the understanding of a person of ordinary skill in the art. In assessing the level of ordinary skill in the art, various factors may be considered, including (1) educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology, and

(6) educational level of workers active in the field. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983). Not all of these factors may be present in every case, and one or more of these or other factors may predominate in a particular case. *Id.* Moreover, these factors are not exhaustive but are merely a guide to determining the level of ordinary skill in the art. *Daiichi Sankyo Co. Ltd, Inc. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007).

Relying on the declaration testimony of Dr. Eskandarian, Petitioner contends that an ordinarily skilled artisan for the '278 patent “would have been someone knowledgeable in mobile computing systems and location technology.” Pet. 18 (citing Ex. 1002 ¶ 39). Petitioner additionally contends

[t]hat person would have had either (1) a Bachelor of Science degree in Electrical Engineering, Mechanical Engineering, Automotive Engineering, Computer Engineering, or an equivalent field, with at least two years of academic or industry experience in the automotive industry; or (2) a Master of Science degree in Electrical Engineering, Mechanical Engineering, Automotive Engineering, Computer Engineering, or an equivalent field, with at least a year of academic or industry experience in the same field.

Id. (citing Ex. 1002 ¶ 40). Petitioner also states that “[w]ith more education, for example, postgraduate degrees and/or study, less experience is needed to attain an ordinary level of skill in the art. Similarly, more experience can substitute for formal education.” *Id.* at 19 (citing Ex. 1002 ¶ 40).

Patent Owner states that “applying this level of skill is sufficient for the Board to evaluate the Petition Grounds,” but “reserves the right to provide its own definition for person having ordinary skill in the art (POSA)

and support for that definition” in its Patent Owner Response, “including expert testimony regarding the appropriate definition.” Prelim. Resp. 12

Based on this record, we adopt Petitioner’s articulation of the level of ordinary skill in the art, which appears to be consistent with the ’278 patent and the asserted prior art, and we apply it in our obviousness evaluations below. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art, itself, can reflect appropriate level of ordinary skill in art).

B. Claim Construction

In interpreting the claims of the ’278 patent, we “us[e] the same claim construction standard that would be used to construe the claim[s] in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b). The claim construction standard includes construing claims in accordance with the ordinary and customary meaning of such claims as would have been understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (*en banc*).

Petitioner notes that, in co-pending litigation, Patent Owner “has taken positions on the meaning of key claim terms.” Pet. 16. Petitioner states only that it “seeks a construction of the claim term ‘*enabling data*.’” *Id.* Petitioner represents that Patent Owner has sought to construe “enabling data” to mean “data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.” *Id.*

Patent Owner notes that, in the pending 504 IPR, we construed “enabling data” according to the Board’s construction in *Omega Patents I*, as “data that ‘enables the recited controller to use a particular vehicle

device code from among plural such codes by providing either (1) the code itself to the controller, or (2) data that otherwise enables the controller to select or generate the code.” Prelim. Resp. 13 (citing 504 IPR Decision on Institution (“504 IPR DI”) at 25–27); *see also Omega Patents I* (Ex. 2005) at 12–13. Patent Owner does not, however, expressly advocate for adoption of that construction in this proceeding.

Petitioner filed its Petition on June 30, 2023 (Paper 2), and therefore did not have the benefit of our decision on institution in the 504 IPR, which was mailed on July 25, 2023 (504 IPR, Paper 11 (“504 IPR DI”)). Petitioner did, however, have access to the Board’s decision in *Omega Patents I*.

We see no reason, at this stage of the proceeding, to depart from the Board’s previous construction of this term in *Omega Patents I* and adopted by the Board in the 504 IPR. The Board’s previous construction is soundly premised on the written description of the ’278 patent, in accordance with *Phillips*. *See* 504 IPR DI, 415 F.3d at 12 (citing *Phillips*, 415 F.3d at 1315 (noting that the specification is the single best guide to the meaning of a disputed term)). As the Board noted in the 504 IPR DI, the ’278 patent describes “enabling data” as data that “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.” 504 IPR DI at 25 (quoting Ex. 1001, 24:8–13). This supports the Board’s construction of “enabling data” as data that “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 select or generate the code.”

Omega Patents I (Ex. 2005) at 12–13 (citing Ex. 1001, 24:5–25:28, Figs. 10–13). We adopt this construction for purposes of this decision herein. In so doing, we note that our construction is preliminary, and we advise the parties (as we did in the 504 IPR) that “[t]he parties may further develop the record at trial as to how an ordinarily skilled artisan, at the time of the invention, would have interpreted ‘enabling data’ in light of the written description of the ’278 patent, and more clearly explain any relevant differences between their respective interpretations.” 504 IPR DI at 27.

Patent Owner additionally seeks construction of the terms “vehicle tracking unit,” “vehicle position determining device,” and “vehicle position information” to mean tracking “with respect to a geographic position.”

Prelim. Resp. 14. As support for this construction, Patent Owner notes that “[t]he specification uses these terms consistent with the understanding of one of skill in the art, namely that they refer to the geographic position of the vehicle.” *Id.* at 13. Patent Owner also notes that the specification consistently refers to knowing the vehicle’s *geographic* “location” and also describes the vehicle position determining device as being a GPS receiver in some embodiments. *Id.* at 13–14 (citing Ex. 1001, 1:30–1:57, 2:5, 5:16–19, 12:20–12:40, 15:62, 16:16–17:5, 23:36–39). Patent Owner further asserts that, therefore, “a vehicle tracking unit, a vehicle position determining device, and vehicle position information all refer to tracking of and information of a *geographic position* of the vehicle, and not events local to the vehicle.” *Id.* at 14 (emphasis added) (citing Ex. 2002 (McAlexander Decl.) ¶ 31). Patent Owner offers this construction to address statements by Petitioner, which Patent Owner contends imply “that these terms include generally detecting movement, for example, in the

cases of shock and motion around the vehicle, but fail[] to address the actual location of the vehicle itself.” *Id.* (citing Pet. 22).

As noted above, Petitioner does not address construction of these terms. We also did not address construction of these terms in the 504 IPR DI, nor did the Board address these terms in *Omega Patents I*. We have reviewed Patent Owner’s proposed construction in light of the specification of the ’278 patent and we conclude that this proposed construction aligns with the disclosure therein, consistent with the principles of *Phillips*. Therefore, to the extent construction of these terms is necessary for our decision herein, we construe the terms “vehicle tracking unit,” “vehicle position determining device,” and “vehicle position information” to mean tracking “with respect to a geographic position.” Again, we emphasize that our construction is preliminary, and we advise the parties that they may further develop the record at trial as to how an ordinarily skilled artisan, at the time of the invention, would have interpreted these terms in light of the written description of the ’278 patent, and more clearly explain any relevant differences between their respective interpretations.

We determine that no express claim construction is necessary for any other claim term. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (holding that only claim terms in controversy need to be construed, and only to the extent necessary to resolve the controversy (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))). Any final written decision entered in this case may include a final claim construction based on the full trial record that

differs from this preliminary construction, or from any discussion of claim scope provided in our analysis below.

C. Alleged Grounds of Unpatentability

We now consider whether the Petition satisfies the threshold requirement for instituting an *inter partes* review under 35 U.S.C. § 314(a) by addressing each of Petitioner’s asserted grounds of unpatentability.

1. Ground 1: Obviousness Over Flick ’885 Combined with Flick ’561

In its first ground, Petitioner contends that all challenged claims of the ’278 patent are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Flick ’885 and Flick ’561. Pet. 19–48.

A claim is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103(a); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved based on underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any objective indicia of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). An obviousness determination requires finding a reason to combine accompanied by a reasonable expectation of achieving what is claimed in the challenged patent. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). “[A]ny need or problem known in the field of endeavor at the time of invention and

addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 550 U.S. at 419–20.

In essence, Petitioner contends that Flick ’885 discloses everything in the challenged claims except a vehicle tracking unit, which Petitioner contends is disclosed by Flick ’561. Pet. 2, 21–32. Petitioner contends that it would have been obvious to modify Flick ’885’s vehicle control system to obtain vehicle position information from a GPS and transmit it using a wireless communication system as taught by Flick ’561. *Id.* at 19–20 (citing Ex. 1002 ¶¶ 76–77).

At this stage of the proceeding, Patent Owner does not contest that the combination of Flick ’885 and Flick ’561 teaches or suggests each and every limitation of the claims. *See generally* Prelim. Resp. 14–15. Patent Owner takes issue with some of Petitioner’s contentions as to the scope of Flick ’885—namely, Petitioner’s assertions that Flick ’885 on its own discloses vehicle tracking. *Id.* at 17–19. We address those contentions below in the context of evaluating Petitioner’s showing. Patent Owner also argues that an ordinarily skilled artisan would not have been motivated to combine the teachings of Flick ’885 and Flick ’561, *id.* at 18, 21–24, and that Petitioner’s proposed combination fails to consider Patent Owner’s evidence of secondary considerations, *id.* at 25–38. We also address these contentions below. Aside from the merits, Patent Owner also argues in favor of discretionary denial under § 325(d) (*id.* at 16, 54–56), which we address *supra* Section III.

Having considered the arguments and evidence before us, we find that the record establishes a reasonable likelihood that Petitioner would prevail on this asserted ground of unpatentability.

a) Claim 1

Petitioner contends that Flick ’885 teaches each and every limitation of the claims except for limitation 1[a] (i.e., “a vehicle position determining device”). *See* Pet. 21–48 (claim chart); *cf.* Prelim. Resp. 14–21.

Taking claim 1 as illustrative, we have reviewed Petitioner’s contentions and supporting evidence regarding these limitations, and determine, at this stage and on this record, that Petitioner’s detailed mapping is sufficient to show a reasonable likelihood that the combination of Flick ’885 and Flick ’561 teaches or suggests every limitation of claim 1.

- (1) *[1pre] “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:”*

Petitioner presents evidence that the combination of Flick ’885 and Flick ’561 discloses the subject matter of the preamble.⁹ In particular, with regard to the vehicle data bus extending throughout the vehicle, Petitioner points to Figure 1 of the ’885 patent (which appears to be very similar to Figure 10 of the ’78 patent) and associated disclosure. Pet. 21 (citing Ex. 1003, Fig. 1, 2:67–3:4). With regard to the multi-vehicle compatible tracking unit, Petitioner first presents some arguments that Flick ’885 “inherently discloses” a tracking unit because it discloses sensors used to “detect movement of the vehicle.” *Id.* at 22 (citing Ex. 1003, 1:28–32). Petitioner then contends “[t]o the extent that the ’885 patent does not

⁹ Neither party takes a position at this stage on whether the preambles to the claims are limiting. On this record, and at this stage of the proceeding, we accept Petitioner’s showing that the preambles are taught by the prior art, without deciding whether the preambles are limiting.

explicitly disclose a tracking unit, the '561 Patent discloses and claims a vehicle tracking unit.” *Id.* (citing Ex. 1004, 2:13–17).

Patent Owner challenges Petitioner’s showing as to the preamble with regard to Petitioner’s statements that Flick ’885 “inherently discloses a multi-vehicle tracking unit.” Prelim. Resp. 17–18. Patent Owner argues that the various sensors described in Flick ’885 “detect movement in or around the vehicle, or movement of the vehicle,” but contends that “[t]his is not detecting the geographic position of the vehicle or vehicle tracking.” *Id.* at 18.

On this record, we agree that Flick ’885 does not, on its own, disclose vehicle tracking in the sense of tracking a geographic position of the vehicle. Rather, as Patent Owner notes, the “ultrasonic and microwave motion detectors” disclosed in Flick ’885 detect movement of the vehicle, but not necessarily geographic location. Prelim. Resp. 17. Given our preliminary construction of “vehicle tracking unit,” “vehicle position determining device,” and “vehicle position information” as meaning tracking “with respect to a geographic position” (*supra* Section IV.B), we agree with Patent Owner on this record that Flick ’885 does not, alone, disclose a vehicle tracking unit, as recited. Patent Owner does not, however, address the disclosure of Flick ’561 with regard to a geographic positioning unit or the combination of Flick ’885 and Flick ’561 in this regard (aside from challenging motivation to combine, which we address *infra*). Patent Owner, therefore, does not dispute that the combined disclosures of Flick ’885 and Flick ’561 teach or suggest the subject matter of the preamble of claim 1.

On this record, and for purposes of institution, we determine Petitioner has shown sufficiently that the combined disclosures of Flick ’885

and Flick '561 teach or suggest the subject matter of the preamble of claim 1.

(2) [1a] “a vehicle position determining device”

Petitioner presents evidence that Flick '561 discloses a vehicle position determining device. Pet. 23 (citing Ex. 1004, 4:59–5:4). Patent Owner does not specifically dispute this showing as to Flick '561. Patent Owner does dispute Petitioner's alternative argument that Flick '885 also “likely discloses a vehicle position determining device.” See Pet. 23; Prelim. Resp. 18–19. As noted above in the context of the preamble, we agree with Patent Owner on this record that Flick '885 discloses sensors used to monitor vehicle movement, but does not appear to disclose a device for determining the geographic position of a vehicle. Prelim. Resp. 19; *supra* Section IV.C.1.a)(1).

On this record, and for purposes of institution, we determine Petitioner has shown sufficiently that Flick '561 teaches or suggests the subject matter of this limitation of claim 1.

(3) [1b] “a wireless communications device”

Petitioner presents evidence that Flick '885 teaches this limitation by disclosing a control system that includes a transmitter and a receiver for receiving signals from the transmitter. Pet. 24–25 (citing Ex. 1003, Fig. 1 (boxes 31, 32), 2:66–3:8, 3:55–56, 5:58–62). Petitioner also notes that Flick '885 discloses “that the receiver at the vehicle is connected via a ‘direct radio frequency link’ or ‘via other communications infrastructure, such as via satellite, or cellular communications’” and other means. Pet. 25–26 (citing Ex. 1003, 5:42–50). Petitioner also notes that Flick '561 “similarly

discloses a wireless communications device.” *Id.* at 26 (citing Ex. 1004, 5:8–10, 5:20–25).

Patent Owner does not specifically contest Petitioner’s showing as to this limitation.

On this record, and for purposes of institution, we determine Petitioner has shown sufficiently that Flick ’885 and Flick ’561 each teach or suggest the subject matter of this limitation of claim 1.

(4) [1c] “a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information”

Petitioner presents evidence that the combination of Flick ’885 and Flick ’561 teaches this limitation. Pet. 26–28 (citing Ex. 1003, 3:6–9 (disclosing a control system including a transmitter and receiver), 8:50–54 (disclosing a data bus connected to vehicle sensors); Ex. 1004, claim 2 (reciting a vehicle tracking system “wherein said controller also cooperates with said vehicle position determining device and said wireless communications device to send vehicle position messages”)).

Patent Owner’s challenges to Petitioner’s showing as to this limitation are focused on Petitioner’s additional contentions that Flick ’885 “inherently discloses a multi-vehicle compatible tracking unit because one of the sensors disclosed is to ‘detect movement of the vehicle.’” Pet. 27–28; Prelim. Resp. 20. As noted above, given our preliminary construction of “vehicle tracking unit,” “vehicle position determining device,” and “vehicle position information” as meaning tracking “with respect to a geographic position” (*supra* Section IV.B), we agree with Patent Owner on this record that Flick ’885 does not, alone, disclose sending vehicle position information, as

recited. Patent Owner does not, however, address the disclosure of Flick '561 with regard to detecting vehicle positioning information or the combination of Flick '885 and Flick '561 in this regard (aside from challenging motivation to combine, which we address *infra*).

On this record, and for purposes of institution, we determine Petitioner has shown sufficiently that the combination of Flick '885 and Flick '561 teaches or suggests the subject matter of this limitation of claim 1.

(5) [1d] “said multivehicle 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”

Petitioner presents evidence that Flick '885 teaches this limitation by disclosing:

The multi-vehicle compatible controller is for storing a set of device codes for a given vehicle device for a plurality of different vehicles, for reading a device code from a data communications bus, and for determining a match between a read device code and the stored device codes to thereby provide compatibility with a plurality of different vehicles.

Pet. 28 (quoting Ex. 1003, Abs.). Petitioner also cites additional disclosure in Flick '885 describing how the MVCC is coupled to the vehicle data bus and how it communicates with at least one vehicle device using at least one corresponding vehicle device code from a plurality of such codes for different vehicles. *Id.* at 29–30 (citing Ex. 1003, 3:38–45, 6:50–54, Fig. 1).

Patent Owner does not specifically contest Petitioner's showing as to this limitation.

On this record, and for purposes of institution, we determine Petitioner has shown sufficiently that Flick '885 teaches or suggests the subject matter of this limitation of claim 1.

(6) [1e] *“a downloading interface for permitting downloading enabling data related to the at least one corresponding vehicle device code for use by said multivehicle compatible controller”*

Petitioner presents evidence that Flick '885 teaches this limitation by disclosing a downloading interface in terms of the downloading function of the MVCC with the vehicle's bus interface. Pet. 30 (citing Ex. 1003, 9:1-10). Petitioner contends the ordinarily skilled artisan would have understood this disclosure, along with the disclosure of a “bus interface,” to be a downloading interface “because the device codes read from the data communication bus must be downloaded first in order for the controller to perform the function of matching the read codes to any stored device codes.” *Id.* at 31 (citing Ex. 1003, 6:33–40). Petitioner additionally relies on the fact that Flick '885 incorporates by reference U.S. Patent No. 6,011,460 (“’460 patent”), which discloses a “remote control system” that includes “desired signal enabling means for causing the vehicle function controller to operate using a desired set of signals for a desired vehicle from a plurality of possible sets of digital signals for different vehicles, as may be downloaded from a downloading device temporarily connected thereto.” *Id.* (quoting Ex. 1007, 3:56–61). Petitioner additionally notes that Flick '885 also incorporates by reference the disclosures of an application that issued as U.S. Patent No. 6,812,829 (“the '829 patent”), which Petitioner contends also discloses the claimed downloading interface. *Id.* at 31–32 (citing Ex. 1008, 10:30–36, 11:50–57).

Patent Owner does not specifically contest Petitioner's showing as to this limitation.

On this record, and for purposes of institution, we determine Petitioner has shown sufficiently that the combination of Flick '885 and Flick '561 teaches or suggests the subject matter of this limitation of claim 1.

a) Additional Claims 2–22

We have reviewed Petitioner's contentions and evidence as to the remaining claims 2–22, and are satisfied on this record and for institution that Petitioner has shown sufficiently that the combination of Flick '885 (incorporating Flick '460) and Flick '561 teaches the limitations of these claims. Pet. 32–48: claim 2 (citing Ex. 1003, 6:16–18, 6:24–32; Ex. 1007, 7:49–56; Ex. 1008, Fig. 10, 11:66–12:6; Ex. 1002 ¶ 78); claim 3 (citing Ex. 1003, 7:19–20, Ex. 1007, Fig. 10, 7:49–56; Ex. 1008, 11:66–12:6; Ex. 1002 ¶ 78); claim 4 (citing Ex. 1003, Figs. 6A–6B, 5:41–49; Ex. 1007, 7:32–43, 7:49–56; Ex. 1008, Figs. 9, 10, 11:49–12:6; Ex. 1002 ¶ 78); claim 5 (citing Ex. 1007, 7:39–43; Ex. 1008, 11:57–61; Ex. 1002 ¶ 78); claim 6 (citing Ex. 1003, Fig. 8, 6:32–36, 8:64–9:7; Ex. 1002 ¶ 78); claim 7 (citing Ex. 1003, Fig. 7, 3:38–48, 6:32–36, 7:23–26, 8:64–9:7; Ex. 1002 ¶ 78); claim 8 (citing Ex. 1003, 7:15–19, 8:28–30; Ex. 1007, 8:9–17; Ex. 1002 ¶ 78); claim 9 (citing Ex. 1003, 5:18–29, 7:4–11; Ex. 1002 ¶ 78); claim 10 (citing evidence for claim 9 and Ex. 1002 ¶ 78); claim 11 (citing Ex. 1004, 4:59–63; Ex. 1002 ¶ 78); claim 12 (citing Ex. 1003 Fig. 1; Ex. 1002 ¶ 78); claim 13 (citing evidence for claim 1); claim 14 (citing evidence for claim 6); claim 15 (citing evidence for claim 7); claim 16 (citing evidence for claim 8); claim 17 (citing evidence for claim 9); claim 18 (citing evidence for claims 1

and 4); claim 19 (citing evidence for claim 6); claim 20 (citing evidence for claim 7); claim 21 (citing evidence for claim 8); claim 22 (citing evidence for claim 9).

Patent Owner does not present separate substantive arguments for the remaining claims, but argues all claims in Ground 1 collectively with claim 1, which we have addressed above. *See* Prelim. Resp. 38–41. Patent Owner does, to an extent, take issue with Petitioner’s reliance on material from other patents incorporated by reference into Flick ’885, asserting essentially that it is not clear whether Petitioner is relying on those patents incorporated by reference as separate prior art. *See id.* at 38–40. To the extent Patent Owner is suggesting that such references need to be called out separately as a basis for unpatentability, we disagree. Flick ’885 incorporates by reference U.S. Patent No. 6,011,460 (“the ’460 patent”) and U.S. Patent No. 6,812,829 B1 (“the ’829 patent”)¹⁰, which means that the ’460 and ’829 patents are part of the disclosure of Flick ’885, rather than separate references to be combined with Flick ’881. *See Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) (“Incorporation by reference provides a method for integrating material from various documents into a host document . . . by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein.”); MPEP 2163.07(b).

¹⁰ *See* Ex. 1003, 10:10–17 (incorporating by reference contents of ’460 patent), 10:62–11:4 (incorporating by reference, by docket number, contents of applications that issued as the ’829 patent and U.S. Patent 6,346,876). *See also* Pet. 31.

b) Motivation to combine/reasonable expectation of success

Even “[i]f all elements of the claims are found in a combination of prior art references,” “the factfinder should further consider whether a person of ordinary skill in the art would [have been] motivated to combine those references, and whether in making that combination, a person of ordinary skill would have [had] a reasonable expectation of success.” *Merck & Cie v. Gnosis S.P.A.*, 808 F.3d 829, 833 (Fed. Cir. 2015). The “motivation to combine” and “reasonable expectation of success” factors are subsidiary requirements for obviousness subsumed within the *Graham* factors. *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007).

As noted above, Petitioner relies primarily on Flick ’885 (incorporating Flick ’460) for teaching most limitations of the claims, but additionally relies on Flick ’561 for teaching a “tracking unit” as recited in the preamble, and a “vehicle position determining device” as recited in limitations [1a] and [1c]. Pet. 21–23, 26–28.

Petitioner argues an ordinarily skilled artisan would have been motivated to combine Flick ’561’s location services with Flick ’885’s multi-vehicle compatible control system with a reasonable expectation of success. Pet. 19–20. Petitioner argues that both Flick ’885 and Flick ’561 relate to vehicle security systems, and both address similar problems. *Id.* at 19 (citing Ex. 1002 ¶ 75). In particular, Petitioner notes that both patents recognize a need for a vehicle security system to deter theft, and Flick ’561 acknowledges that “it would be beneficial to know the vehicle’s location so that authorities could be promptly and accurately directed to retrieve the vehicle.” *Id.* at 19–20 (citing Ex. 1004, 1:25–28; Ex. 1003, 1:21–22; Ex. 1002 ¶ 75). Petitioner also contends that Flick ’885 discloses sensors to

detect movement of the vehicle, and asserts that Flick '561's disclosure of a GPS sensor to track movement is a similar type of disclosure, which would have motivated the ordinarily skilled artisan to include GPS for the vehicle security system disclosed in Flick '885. *Id.* at 20 (citing Ex. 1002 ¶ 76). Petitioner further asserts that Flick '561 similarly teaches toward Flick '885 because its objective is to “permit ready interface to devices in the vehicle, such as those devices which may be part of an existing vehicle security system,” as disclosed in Flick '885. *Id.* at 22 (citing Ex. 1004, 2:16–18).

In response, Patent Owner argues that an ordinarily skilled artisan would not have combined the teachings of Flick '885 with Flick '561. Prelim. Resp. 21–25. Patent Owner first argues that Mr. Flick, the named inventor on Flick '885, Flick '561, and the '278 patent before us, “did not recognize the benefits of combining these technologies until the '278 patent.” *Id.* at 21. Though this evidence is relevant, it cannot be considered in a vacuum, as the standard is not what the inventor himself knew or appreciated, but what an ordinarily skilled artisan would have understood. The ordinarily skilled artisan is a fictional construct that, for example, is aware of all prior art in existence. *Custom Accessories, Inc. v. Jeffrey–Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986) (“The person of ordinary skill in the art is a hypothetical person who is presumed to know the pertinent prior art.”); *Kimberly–Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437 (Fed. Cir. 1984) (stating that “[r]eal inventors, as a class, vary in their capacities from ignorant geniuses to Nobel laureates; the courts have always applied a standard based on an imaginary worker of their own devising”); *see also id.* at 1449–54 (providing a comprehensive discourse on the evolution of the person of ordinary skill body of law).

Patent Owner then argues that neither Flick '885 nor Flick '561 is directed specifically to “vehicle security” and Petitioner’s unjustified focus on vehicle security fails to consider the claims of the '278 patent “as a whole.” Prelim. Resp. 22. We disagree. The avowed purpose of the inventor of the '278 patent is not controlling; rather, any known problem in the art can serve as motivation to combine the references. *See In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996) (“[T]he motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness.”). Patent Owner also takes issue with Petitioner’s considering similarities in the teachings of the references with regard to vehicle sensors, with Petitioner’s reliance on the technical possibility of incorporating a vehicle tracker into the system of Flick '885, and with Petitioner’s reference to “common sense” and “market forces” as motivating the combination. Prelim. Resp. 22–24.

Although we have considered Patent Owner’s arguments carefully, we determine that Petitioner has sufficiently shown on this record and for institution that an ordinarily skilled artisan would have had a reason to combine the teachings of Flick '885 and Flick '561 to achieve the claimed invention with a reasonable expectation of success.

Specifically, taking claim 1 as illustrative, Flick '885 teaches most of the limitations of this claim except for a vehicle position determining device (e.g., GPS). *Supra* Section IV.C.1.a). But the evidence of record shows that the use of GPS was well known in the art for use in vehicle monitoring systems before the priority date of the '278 patent. Flick '561, for example, employs a GPS module in a wireless appliance that, like the control system disclosed in Flick '885, can communicate information about a vehicle to a

receiver. *See* Ex. 1004, 5:8–10, 5:20–25; *see also* Pet. 26. Patent Owner’s arguments that an ordinarily skilled artisan would not have combined Flick ’885 and Flick ’561 because each reference is allegedly directed to different subject matter is therefore not persuasive on this record. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”).

Moreover, we agree with Petitioner on this record that Flick ’561 and Flick ’885 each contain disclosures leading toward their combination. Flick ’885 discloses vehicle sensors for detecting vehicle movement (Ex. 1003, 1:27–28, 1:32–33), and Flick ’561 discloses use of GPS to more broadly track vehicle movement (Ex. 1004, 1:25–28 (such as to enable recovery of a stolen vehicle)). Flick ’561 also notes an objective of its system is to “permit ready interface to devices in the vehicle, such as those devices which may be part of an existing vehicle security system,” and thus discloses a motivation to look to a MVCC, such as disclosed in Flick ’885. Pet. 22 (citing Ex. 1004, 2:16–18).

Thus, we are not persuaded on this record by Patent Owner’s argument that Petitioner’s rationale to combine is merely hindsight. *See* Prelim. Resp. 25. And, in any event, the Federal Circuit explained even pre-*KSR* that a motivation to combine may be found where the “combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient.” *DyStar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1365 (Fed. Cir. 2006).

c) Secondary considerations

Finally, Patent Owner argues that Petitioner’s arguments for obviousness must also fail in light of Patent Owner’s “compelling evidence of secondary considerations of non-obviousness.” Prelim. Resp. 25. In support of its arguments, Patent Owner points to the Board’s decisions in *Omega Patents I* and *Omega Patents II*, and argues that the Board twice confirmed Patent Owner’s evidence of secondary considerations, and notes that the evidence of secondary considerations includes “licensing, commercial success, copying by others, customer need, and the limited value for products without the invention.” *Id.* at 26 (citing Ex. 1015; Ex. 2001 ¶¶ 2, 13–16; Ex. 2010, 26:11–20; Ex. 2011, 45:3–19, 46:25–47:19; Ex. 2012, 64:15–24, 102:16–103:13, 155:4–13; Ex. 2020; Ex. 2002 ¶ 83; Ex. 2019 ¶¶ 37–43; Ex. 2034); *id.* at 58–59.

Petitioner argues that Patent Owner’s secondary considerations do not provide a basis to deny institution of *inter partes* review. Pet. 66–68. Petitioner acknowledges that the Board previously credited Patent Owner’s secondary considerations in the reexamination proceedings, but argues that the Petition relies on different references than the reexamination proceedings and the Petition presents a strong case of obviousness that cannot be overcome by secondary considerations. *Id.* at 67–68.

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. Petitioner has not ignored Patent Owner’s prior evidence of secondary considerations (*see* Pet. 66–68), but has not had an

opportunity to present its own evidence and argument to rebut Patent Owner's evidence at trial, including a full opportunity to litigate the information included in Patent Owner's exhibits. Nevertheless, we have preliminarily considered Patent Owner's evidence and arguments and provide some comments below.

(1) Prior Board Decisions in Reexamination

Patent Owner relies on and repeatedly cites to the Board's decisions in *Omega Patents I* and *Omega Patents II*. Prelim. Resp. 29–32, 58–59. It is true that the Board previously considered evidence of secondary considerations presented by Patent Owner, including “licensing, commercial success, copying by others, customer need, and the limited value for accused products without the invention,” in *Omega Patents I* and *Omega Patents II*, and found that evidence persuasive. *See* Ex. 2005, 14; Ex. 1015, 13–15. Specifically, in *Omega Patents I*, the Board found that the asserted prior art reference Chou “does not teach or suggest the recited multi-vehicle compatible controller and downloading interface” and that “this deficiency is dispositive regarding [the Board's] reversing the Examiner's obviousness rejection.” Ex. 1015, 14. The Board added that Appellant's evidence of secondary considerations “only further weighs in favor of Appellant.” *Id.* In *Omega Patents II*, the Board found that the prior art taught a wireless appliance that was “multi-vehicle compatible,” but that “Appellant's evidence of secondary considerations . . . outweighs the evidence of obviousness on this record.” Ex. 1015, 16.

The Board weighs secondary considerations against the scope and content of the *asserted prior art* and any differences between that art and the challenged claims. *See WBIP*, 829 F.3d at 1328 (explaining that “the

strength of *each* of the *Graham* factors must be weighed in every case and must be weighted en route to the final determination of obviousness or non-obviousness”). The Board in *Omega Patents I* and *II* determined that Patent Owner’s evidence of secondary considerations either outweighed or “further weigh[ed]” against the Examiner’s evidence of obviousness based on different prior art than we have before us. *See* Ex. 2005, 14; Ex. 1015, 13–15.

In view of our analysis of the parties’ arguments and evidence for Ground 1, above, we determine that it would be premature at this stage of the proceeding to deny institution based on the secondary considerations evidence without a full consideration of that evidence as compared to the art presented in this matter. *See Nearmap US v. Eagle View Technologies*, IPR2022-00734, Paper 10, 8–9 (Nov. 1, 2022) (instituting review despite secondary considerations evidence presented in earlier IPR). Full consideration is warranted because (1) the Petition presents different obviousness arguments—using different references—than any earlier proceeding; and (2) Patent Owner’s secondary consideration arguments and evidence have never been presented to the Board in an adversarial proceeding.

While we do not second-guess our colleagues’ decisions that Patent Owner’s evidence of secondary considerations either outweighed or “further weigh[ed]” against the Examiner’s evidence of obviousness based on other prior art, as we note above, we cannot say the same at this stage of the proceeding based on Flick ’885 and Flick ’561. And despite Patent Owner’s representations that the art before us is “simply cumulative to art already considered by this PTAB and the many other tribunals” (Prelim. Resp. 32),

such determination is better made on a fully developed record at trial. Indeed, as discussed below, we observe potential deficiencies in Patent Owner's evidence even at this preliminary stage. Thus, we will permit the parties to develop a more complete record during discovery before further considering such evidence.

(2) *Jury Verdicts and Underlying Evidence*

Patent Owner argues that evidence of licensing, commercial success, copying, customer need, and nexus has already been considered and accepted in jury trials. Prelim. Resp. 32–38.¹¹ However, although Patent Owner represents that a jury has found that others accepted licenses under patents because of the merits of the claimed invention (*see id.* at 33 (citing Ex. 2032, verdict form)), Patent Owner does not acknowledge that the jury was considering infringement and validity of *several* patents, not just the '278 patent, and the underlying licenses themselves involved *dozens* of patents and pending applications, not just the '278 patent. *See* Ex. 2032 (verdict form, showing jury consideration of three patents in addition to the '278 patent); *id.* at 9 (Question 5, asking about different evidence of secondary considerations, none of which are broken out by patent)); Ex. 2025 (settlement agreement, covering two litigations and 8 patents in addition to the '278 patent); Exs. 2026–2031 (license agreements covering

¹¹ Patent Owner also notes that a 2016 jury verdict was challenged on appeal, and the Federal Circuit affirmed the finding rejecting invalidity of the '278 patent. Prelim. Resp. 33 (citing *Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1343 (Fed. Cir 2019)). In so doing, however, the Federal Circuit did not evaluate or otherwise comment on any evidence of secondary considerations; rather, the affirmance of the verdict against invalidity was premised on rejecting the defendant's arguments based on claim construction. *See Omega Patents*, 920 F.3d at 1342–43.

dozens of issued patents and pending applications). Patent Owner's reliance on a jury finding that others accepted licenses because of the merits of the claimed invention is, therefore, potentially misplaced because such finding did not, and could not, make a distinction between a license to the '278 patent and many other patents. *See, e.g., Merck & Cie v. Gnosis S.P.A.*, 808 F.3d 829, 838 (Fed. Cir. 2015) (“[T]he Board’s finding that the evidence of licensing should not be afforded much weight was reasonable” where license covered several patents.); *Iron Grip Barbell v. USA Sports*, 392 F.3d 1317, 1324 (Fed. Cir. 2004) (licenses taken to settle litigation have no probative value on non-obviousness “because it is often cheaper to take licenses than to defend infringement suits”).

Patent Owner's evidence of “commercial success” and “copying,” (Prelim. Resp. 35–36) is similarly premised on jury verdicts in cases involving multiple patents, and thus is of limited value for the reasons noted above. At minimum, such evidence bears scrutiny in a full adversarial proceeding relative to the '278 patent alone and the particular combination of prior art presented here. Similar reasoning applies to Patent Owner's proffered evidence of “customer need” and “nexus.” *See id.* at 35–38.

* * *

Our Decision on Institution is not a final determination of unpatentability; rather, a Decision on Institution decides whether a “reasonable likelihood” exists for such a determination to be made at a later time. *Compare* 35 U.S.C. § 314(a) (authorizing inter partes review only if “there is a reasonable likelihood that the petitioner would prevail”), *with* 35 U.S.C. § 316(e) (placing the burden on petitioner of “proving a proposition of unpatentability by a preponderance of the evidence”). In

view of our analysis of the parties' arguments and evidence for Ground 1, above, we determine that it would be premature at this stage of the proceeding to deny institution based on the secondary considerations evidence, or the alleged failure of Petitioner to address adequately such evidence. We will permit the parties to develop a more complete record during discovery before considering such evidence. We will consider the complete secondary-considerations record developed during trial as part of our analysis in the final written decision, where we make the ultimate determination on obviousness or non-obviousness.

d) Summary

Accordingly, for the reasons set forth above and based on the totality of the evidence currently in the record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in its challenge to claims 1–22 of the '278 patent as unpatentable for obviousness over Flick '885 and Flick '561.

2. Ground 2: Anticipation by Lewis; Obviousness over Lewis and Underdahl

In Ground 2(a), Petitioner contends that claims 1–6, 8, 10–14, 16, 18–19, and 21 are anticipated by Lewis (Ex. 1005); and in Ground 2(b), Petitioner contends that claims 7, 9, 15, 17, 20, and 22 are unpatentable as obvious over the combination of Lewis and Underdahl (Ex. 1006). Pet. 48–66 (consolidated claim chart).

Because, per *SAS*, an institution decision is an “all or nothing” decision,¹² and our decision to institute on Ground 1 means that we will

¹² *SAS Inst.*, 138 S. Ct. at 1353 (“The agency cannot curate the claims at issue but must decide them all.”).

institute on all grounds in the Petition, we need not undertake a fulsome analysis of Petitioner's Ground 2 in this Decision. Nevertheless, as an aid to the parties' development of the record at trial, we provide some preliminary observations below on potential deficiencies in Petitioner's showing as to Ground 2.

In Ground 2, Petitioner relies on Lewis as anticipating claims 1–6, 8, 10–14, 16, 18–19, and 21, and therefore as disclosing all of the elements of, *inter alia* claim 1. Pet. 51–57 (claim chart for claim 1); *id.* at 57–66 (claim chart for remaining claims).

Patent Owner challenges in particular Petitioner's showing as to limitation [1e], which recites “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.” Ex. 1001, 26:12–15; Prelim. Resp. 42–47. For this limitation, Petitioner argues that Lewis discloses allowing “vehicles to download vehicle diagnostic and position data of other vehicles within the peer network.” Pet. 55–56. Petitioner asserts that, in Lewis, the “diagnostic information includes data associated with a corresponding vehicle device code (or PID)”:

The communication subsystem 230 is capable of vehicle-to-vehicle (peer-to-peer) communication for relaying any data including vehicle location and performance data or Intelligent Transportation System (ITS) data; and/or exchanging personal (driver or vehicle), ITS, or Internet (restaurant location) data.

Pet. 56 (quoting Ex. 1005 ¶ 42). Petitioner further argues that Lewis discloses transmitting “diagnostic information from one vehicle . . . to another vehicle through wireless communication.” *Id.* (citing Ex. 1005 ¶ 22). In particular, Lewis discloses a “laptop, equipped with two serial ports (DB9) and a PCMCIA port, acts as a hub through which data is

routed.” Ex. 1005 ¶ 93. The downloaded data is displayed to a driver in playback form or real-time dashboard gauges, and the driver can determine what information from another vehicle is displayed. *Id.* ¶¶ 47, 91.

Petitioner also notes that Lewis discloses a PC interface that “provides “on-site debugging” of the system by which data is downloaded from the PC to the system in order to fix errors or bugs within the system.” Pet. 57 (citing Ex. 1005 ¶ 54).

Patent Owner argues, first, that even if Lewis discloses being able to perform peer-to-peer communications for relaying vehicle location, “[t]his relaying is nothing more than a remote downloading operation of the vehicle location and performance data from the vehicle device.” Prelim. Resp. 43 (citing Ex. 1005 ¶ 42; Ex. 2002 ¶ 107). Patent Owner further argues that “[a]nd even if the vehicle device in Lewis is capable of downloading position and performance data for another vehicle, this position and performance data is not enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller.” *Id.* (citing Ex. 2002 ¶ 109). Patent Owner makes similar arguments for the other portions of Lewis relied upon by Petitioner. *See id.* at 43–47 (arguing that none of the portions of Lewis cited by Petitioner disclose downloading enabling data related to at least one corresponding vehicle device code for use by the MVCC).

On this record, at this stage, Patent Owner appears to have the better of this argument. As noted above, we construe “enabling data” consistently with previous Board decisions as data that “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 select or generate the code.” *Supra* Section IV.C. Although this construction is not exactly as proposed by Petitioner, Petitioner’s showing for Ground 1 does provide evidence and argument that are consistent with this construction. *See* Pet. 30–32. In particular, Petitioner produces evidence that Flick ’885 (including through applications incorporated therein by reference) teaches a downloading function in which sets of digital signals, from among a plurality of possible sets, may be downloaded from a downloading device for causing a vehicle function controller to operate. *See id.* (citing Ex. 1003, 9:1–10; Ex. 1007, 3:56–61; Ex. 1008, 10:30–36, 11:50–57).

Petitioner’s showing as to Ground 2, however, does not, on this record, persuasively show that Lewis discloses that “enabling data” may be downloaded through a downloading interface. The only data that Petitioner discloses being “downloaded” in Lewis is vehicle location and performance data that is shared wirelessly (peer-to-peer) or is downloaded through a laptop. Pet. 56–57 (citing Ex. 1005 ¶¶ 22, 42, 47, 91, 93). Petitioner does not explain how such vehicle location and performance data maps to “enabling data” as we have construed it. *See supra* Section IV.C. Nor, for that matter, does Petitioner persuasively explain how such vehicle location and performance data maps to Petitioner’s own proposed construction of “enabling data,” which is “data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.” *See id.* at 16.

In short, for essentially the reasons argued by Patent Owner (Prelim. Resp. 42–47), we agree, on this record, that there is a fundamental deficiency in Petitioner’s showing as to Ground 2, in which Petitioner relies

on Lewis as disclosing the subject matter of limitation [1e] (which is also commensurately recited in independent claims 13 and 18).

We emphasize that this is a preliminary determination and not a final determination following a trial on the merits. Petitioner is cautioned, however, that although Petitioner is permitted in its Reply to address issues discussed in this Institution Decision, Petitioner may not submit new arguments that it could have presented earlier to make out a *prima facie* case of unpatentability. *See* CONSOL. TRIAL PRACTICE GUIDE (“CTPG”), 73 (Nov. 2019). We further caution that the opportunity to address issues discussed in an institution decision does not mean authorization to proceed in a new direction with a new approach compared to the position taken in the Petition. *See id.* at 74.

We also advise Patent Owner that arguments not included in its formal Response may be deemed waived. *See, e.g., In re NuVasive, Inc.*, 842 F.3d 1376, 1380 (Fed. Cir. 2016) (determining that an argument raised in a preliminary response, but omitted in the patent owner’s response, despite the Board’s “warn[ing] . . . that this would result in waiver,” is “abandoned” and deemed “waived”).

V. CONCLUSION

After considering the arguments presented in the parties’ respective papers and the evidence of record, we determine that Petitioner has demonstrated at least a reasonable likelihood of success in proving that at least one claim of the ’278 patent is unpatentable. *See* CTPG 53 (“The ‘reasonable likelihood’ standard is a somewhat flexible standard that allows the Board room to exercise judgment.”).¹³ Thus, we institute an *inter partes*

¹³ Available at: <https://www.uspto.gov/sites/default/files/documents/>

review of all challenged claims (i.e., claims 1–22) on all grounds set forth in the Petition. Our determinations at this stage of the proceeding are based on the evidentiary record currently before us.

This decision to institute trial is not a final decision as to patentability of any claim for which we have instituted an *inter partes* review.

See TriVascular, Inc. v. Samuels, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”). We will base any final decision on the full record developed during trial.

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claims 1–22 of the ’278 patent on the unpatentability grounds asserted in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this decision.

IPR2023-01162
Patent 8,032,278 B2

For PETITIONER:

Asheesh Puri
Sasha Rao
MAYNARD NEXSEN LLP
apuri@maynardnexsen.com
srao@maynardnexsen.com

For PATENT OWNER:

Ryan Santurri
Christopher Regan
David Carus
ALLEN, DYER, DOPPELT & GILCHRIST, P.A.
rsanturri@allendyer.com
cregan@addmg.com
dcarus@allendyer.com