

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON CONNECT, INC.,
Petitioner,

v.

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

Case No. IPR2023-01162

**PATENT OWNER'S RESPONSE UNDER 37
C.F.R. § 42.120**

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EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 8,032,278 to Flick (the '278 Patent)
1002	Declaration of Dr. Azim Eskandarian
1003	U.S. Patent No. 6,756,885 to Flick
1004	U.S. Patent No. 6,606,561 to Flick
1005	U.S. Patent Application Publication No. 2006/016315 to Lewis
1006	U.S. Patent Application Publication No. 2003/0182003 to Underdahl
1007	U.S. Patent No. 6,011,460 to Flick
1008	U.S. Patent No. 6,812,829 to Flick
1009	File History of Application No. 11/773,272, which issued as U.S. Patent No. 8,032,278 to Flick
1010	03-25-2021 Order Granting the Reexamination (Appl. No. 90/014,675)
1011	06-21-2021 Examiner's Non-Final Office Action (Appl. No. 90/014,675)
1012	08-21-2021 Declaration of Joseph C. McAlexander, III
1013	08-23-2021 Response to Non-Final Office Action (Appl. No. 90/014,675)
1014	04-01-2022 Patent Owner's Appeal Brief (Appl. No. 90/014,675)
1015	12-01-2022 Decision on Appeal (Appl. No. 90/014,675)
1016	Application No. 11/076,259 to Flick
1017	Application No. 10/383,496 to Flick
1018	Application No. 09/859,972 to Flick

1019	Application No. 60/264,811 to Flick
1020	Application No. 60/258,005 to Flick
1021	Application No. 60/251,552 to Flick
1022	Application No. 60/252,125 to Flick
1023	Application No. 60/236,890 to Flick
1024	Application No. 60/246,463 to Flick
1025	Application No. 60/222,777 to Flick
1026	Application No. 60/205,178 to Flick
1027	10-03-2014 Plaintiff’s Opposition to CalAmp’s Motion for Claim Construction, 6:13-cv-1950-ORL-40-DAB
1028	02-20-2015 Order on Claim Construction, 6:13-cv-1950-ORL-40-DAB
1029	<i>In Ex Parte A. James Smith, Jr.</i> , 2010 WL 3269939 (BPAI August 17, 2010).
2001	Declaration of Kenneth Flick
2002	Declaration of Mr. Joseph C. McAlexander, III
2003	Curriculum Vitae of Mr. Joseph C. McAlexander, III
2004	Decision Granting Institution of <i>Inter Partes</i> Review; Paper 11, IPR2023-00504 (July 25, 2023)
2005	<i>Ex Parte Omega Patents, LLC</i> , No. 2018-008119 (Nov. 13, 2018)
2006	D.I. 34, Claim Construction Order, <i>Omega Patents, LLC v. Firstech, LLC</i> , No. 2:20-cv-03144 (W.D. Wash. Nov. 22, 2021) (“ <i>Firstech-CC</i> ”)
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2008	<i>Omega Patents, LLC v. CalAmp Corp.</i> , 13 F.4th 1361 (Fed. Cir. 2021) (<i>CalAmp-II</i>)
2009	<i>Ex Parte</i> Reexamination Certificate for U.S. Patent No. 8,032,278 issued May 17, 2023
2010	D.I. 297-1, Deposition of Galin Chen, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)

2011	D.I. 297-4, Deposition of Peter Hergesheimer, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2012	D.I. 297-5, Deposition of Stephen Hall, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2013	U.S. Patent No. 6,636,790 to Lightner
2014	U.S. Patent No. 6,611,740 to Lowrey
2015	U.S. Patent No. 6,957,133 to Hunt
2016	U.S. 6,732,031 to Lightner
2017	U.S. 7,174,243 to Lightner
2018	Prosecution File History of U.S. Patent Application Publication No. 2006/016315 to Lewis
2019	Declaration of Mr. Christian Tregillis
2020	D.I. 145-43, PL47, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2021	D.I. 145-19, PL1, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2022	D.I. 145-20, PL2, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2023	D.I. 145-34, PL18, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2024	D.I. 145-36, PL20, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2025	D.I. 145-59, PL73, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2026	Master And Cross-License Agreement, dated May 12, 2007, between Omega R&D, Omega Patents and Directed Electronics, Inc.
2027	D.I. 145-38, PL22, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2028	D.I. 145-80, PL99, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2029	D.I. 145-54, PL68, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2030	D.I. 145-53, PL67, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)

2031	D.I. 145-67, PL81, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2032	D.I. 144, Jury Verdict, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 30, 2019)
2033	D.I. 310, Jury Verdict, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 24, 2016)
2034	Omega Royalty Report (April 2023)
2035	Prosecution History of Ser. No. 90/013,587 (RX1)
2036	Prosecution History of Ser. No. 90/013,851 (RX2)
2037	Prosecution History of Ser. No. 90/014,309 (RX3)
2038	Prosecution History of Ser. No. 90/014,419 (RX4)
2039	Prosecution History of Ser. No. 90/014,675 (RX5)
2040	D.I. 145-28, PL11, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2041	RESERVED
2042	U.S. Patent No. 7,149,623 to Flick
2043	U.S. Patent No. 6,028,537 to Suman et al.
2044	Supplemental Declaration of Mr. Joseph C. McAlexander, III
2045	Curriculum Vitae of Mr. Joseph C. McAlexander, III (updated 2Q2024)

I. INTRODUCTION

Ken Flick, the inventor of the ‘278 *Patent*, has been awarded over 100 patents for vehicle technologies, developed many of his inventions in two parallel paths. EX2001, ¶1. One considerable line of patents (developed in the mid-1990s) is mostly classified as vehicle security/remote start data bus patents, while a second significant line of patents (dating back to the early 2000s) are directed vehicle tracker technology. *Id.* at ¶8, 11. Mr. Flick recognized during the development of the tracker technology that he could combine multi-vehicle compatibility with his tracker technology, which resulted in the ‘278 *Patent*. *Id.* at ¶11-13. Before Mr. Flick’s recognition that the combination of multi-vehicle compatibility with tracker technology that resulted in the ‘278 *Patent*, POSAs (including Mr. Flick) often treated multi-vehicle compatibility and tracker technology as separate and distinct. EX2001, ¶12; EX2044, ¶11.

Petitioner is dismissive of Mr. Flick’s inventive efforts, characterizing the ‘278 *Patent* as the addition of an “insubstantial modification” to one of Mr. Flick’s earlier patents, U.S. Patent No. 6,756,885 (EX1003; *Flick885*). Petition, 2. Petitioner contends that the “only feature” added by Mr. Flick in the ‘278 *Patent* was a vehicle tracking unit from a different patent previously awarded to Mr. Flick -- U.S. Patent No. 6,606,561 (EX1004; *Flick561*). *Id.* Petitioner offers a baseless conspiracy theory on the development of the technology and the prosecution itself, contending that Mr.

Flick copied and pasted from *Flick885* to arrive at the ‘278 *Patent* because, “the time to file continuations lapsed.” *Id.* Petitioner’s speculation on the timing is both incorrect and irrelevant. The ‘278 *Patent* is an invention based upon a combination of features developed as Mr. Flick followed two parallel technology paths and concluded with the merger of Mr. Flick’s multi-vehicle data bus technology and his vehicle tracking technology. EX2001, ¶12.

Petitioner continues its guesswork, contending the filings are inconsistent with the purpose of continuation-in-part (CIP) applications, which the Petitioner contends is “not to revive a lapsed family by incorporating its subject matter into a CIP of another family.” Petition, 3 citing MPEP §201.08. The cited section of the MPEP does not address “lapsed” patent families, but rather defines a CIP application as, “an application filed during the lifetime of a prior-filed [application] repeating some substantial portion or all of the prior-filed application and adding matter not disclosed in the prior-filed application.” *See*, MPEP §201.08. The ‘278 *Patent* fits the MPEP definition of a CIP, and represents a filing based on how the claimed invention was invented by Mr. Flick. EX2001, ¶12.

After questioning the timing and motivations of the inventor, Petitioner argues multiple United States Patent and Trademark Office (USPTO) patent examiners, two different Patent Trial and Appeal Board (PTAB) panels, a jury, a District Court, multiple patent licensees, and the Federal Circuit are *all* wrong about the validity of

the ‘278 *Patent*, contending the USPTO somehow overlooked the inventor’s own cited art and a patent in the priority chain, U.S. Patent Nos. 6,756,885 (EX1003; *Flick885*) and 6,606,561 (EX1004; *Flick561*). These patents have been considered by examiners, juries, and judges alike because they have been of record since the filing of the ‘278 *Patent*. *Id.* *Flick885* was cited and expressly described in the background of the ‘278 *Patent*. ‘278 *Patent*, page 2, 2:29-37. *Flick561* was identified in the related applications section of the ‘278 *Patent* as being in the priority chain. ‘278 *Patent*, 1:13. Accordingly, the Examiner of the ‘278 *Patent* considered all the art in the parent application(s), including *Flick561*. *See*, MPEP §609.02. Yet, now, with more than seventeen years of hindsight, Petitioner argues that the inventor’s own art somehow renders the claims of the ‘278 *Patent* invalid. Petitioner’s characterization and combination of *Flick885* and *Flick561* is flawed. EX2002, ¶37. As set forth herein, a person of ordinary skill in the art (POSA) would not have combined *Flick885* and *Flick561* as contended by the Petitioner at the time of the invention, and any attempt to do so is fraught with impermissible hindsight. *Id.*

Also critical is the evidence of secondary considerations, which weighs heavily in favor of patentability. EX2002, ¶38. Petitioner’s characterization of the Patent Owner’s evidence of secondary considerations as “inadequate” is deficient. *Id.* Much of this evidence flows from infringement litigation involving the ‘278 *Patent*, where the infringing products provide significant evidence of commercial

success, while the ‘278 *Patent* was recognized as providing important features sought by its customers with technology that the infringer could not design around. EX2010, 26:11-20; EX2011, 45:3-19, 46:25-47:19; EX2012, 64:15-24, 102:16-103:13, 155:4-13; EX2020; EX2002, ¶39; EX2019, Declaration of Christian Tregillis (“*Tregillis*”), ¶37-43. Moreover, much of the same evidence of secondary considerations was twice considered by the PTAB in the second and fifth *Ex Parte* reexams – both with the benefit of having considered *Flick885. Ex-Parte Omega Patents, LLC*, Appeal 2018-008119 (EX2005); *Ex-Parte Omega Patents, LLC*, Appeal 2022-003758 (EX1015). More recently, this evidence of secondary considerations was also determined to be relevant a third time in issuing a Reexamination Certificate in the fourth reexamination. EX2038, pp. 2986, 3020.

Perhaps recognizing its primary theory combining the inventor’s own patents was flawed, Petitioner argues another cumulative reference –Lewis et al. (U.S. Patent Application Publication No. 2006/0161315) (EX1005; *Lewis*) – also renders the claims invalid. EX2002, ¶40. *Lewis*, like the many references considered in challenges of the ‘278 *Patent*, falls well short of disclosing all of the claim elements of the ‘278 *Patent*, including the claimed downloading interface. EX2002, ¶41. The many challenges to the ‘278 *Patent*, including those advanced by Petitioner, mirror one another – using the same technology, the same invalidity recipe, and the same art already considered – yet Petitioner contends this time it is somehow different. *Id.*

As set forth herein, it is no different and is destined to fail. *Id.*

Because Petitioner failed to meet its statutory burden of demonstrating unpatentability by a preponderance of the evidence pursuant to 35 U.S.C. §316(e), patentability of the challenged claims should be confirmed.

II. OVERVIEW OF THE PRIOR ART

The following references have been identified by Petitioner:

A. U.S. Patent No. 6,756,885 to Flick (Flick885)

Flick885 (EX1003), a patent to Mr. Flick, was cited by Patent Owner during prosecution of the ‘278 *Patent*. EX1009. Indeed, *Flick885* is described in the Background of the Invention section of the ‘278 *Patent* as disclosing “a multi-vehicle control system whereby a multi-vehicle compatible controller stores a set of device codes for a given vehicle device for a plurality of different vehicles.” ‘278 *Patent*, 2:29-33. *Flick885* was specifically disclosed and considered by the Examiner during prosecution. EX1009. The PTAB agrees. Decision, 14.

Flick885 discloses a multi-vehicle compatible control system for a vehicle that operates on a data communications bus. *Flick885*, 5:5-15. A multi-vehicle compatible controller of the system provides a bus interface for remote operation of devices on the data communications bus. *Id.*, 5:11-34, 6:33-40. The bus interface interfaces using proper signal levels and formats on the data communications bus. *Id.*, 6:35-40; EX2002, ¶43.

B. U.S. Patent No. 6,606,561 To Flick (*Flick561*)

Flick561 (EX1004), yet another earlier patent to Mr. Flick, is in the priority chain for the '278 *Patent* and was listed in the related applications section of the '278 *Patent*. EX1009; '278 *Patent*, 1:7-14. *Flick561* is also incorporated by reference into the '278 *Patent*. '278 *Patent*, 1:19-20 Accordingly, *Flick561* too was specifically considered by the Examiner. EX1009.

Flick561, which is one of a string of patents describing similar subject matter, discloses a vehicle tracking unit mounted in a vehicle to interface with various vehicle devices. *Flick561*, 4:7-15; EX2002, ¶45. The vehicle tracking unit includes a vehicle position determining device 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, 56; EX2002, ¶45.

Despite being in the priority chain of the '278 *Patent*, the PTAB states that “Flick ‘561, however, was not before the Examiner during the original prosecution of the ‘278 patent.” Decision, 15. *Flick561* is printed clearly in the related applications section of face of the '278 *Patent*. *Id.* MPEP §609.02 states, “[t]he examiner will consider information which has been considered by the Office in a parent application (other than an international application; see subsection I., above) when examining: (A) a continuation, divisional or continuation-in-part application. MPEP §609.02. Moreover, U.S. Patent No. 7,149,623 (*Flick623*) (EX2042) a

continuation of *Flick561*, has an identical specification as *Flick561*. *Flick623* was cited in an IDS document in the '278 *Patent*, meaning there can be no doubt that the original Examiner both had possession of and considered the shared disclosure of *Flick623* and *Flick561*. Thus, *Flick561* was before the Examiner in the original prosecution and considered by the Examiner in the original prosecution.

C. U.S. Patent Application Publication No. 2006/0161315 To Lewis et al. (Lewis)

Lewis (EX1005) is directed to a real time vehicle performance and position monitoring system. *Lewis*, 0023; EX2002, ¶46. A GPS position receiver collects position data of the vehicle. *Lewis*, 0024, 0026; EX2002, ¶46. The GPS based position data along with onboard diagnostic data is wirelessly communicated to off-site computers. *Lewis*, 0026-0027; EX2002, ¶46.

D. U.S. Patent Application Publication No. 2003/0182033¹ To Underdahl et al. (Underdahl)

Underdahl (EX1006) is directed to locking and unlocking vehicles at automobile dealerships; in particular, the problem of a dealership spending unnecessary overhead organizing remote transmitters. *Id.* at 0008; EX2002, ¶47. To address these shortcomings facing automobile dealerships, a removable door lock apparatus allows a dealer salesperson to control the door lock status by changing

¹ Petitioner erroneously refers to *Underdahl*'s publication no. as being 2003/0182003. Petition, 6, 77. *Underdahl*'s correct publication no. is 2003/0182033. Decision, 8.

between locked and unlocked states. *Id.* at 0033; EX2002, ¶47.

III. THE ‘278 PATENT

A. Overview of the ‘278 Patent

The Background of the Invention section of the ‘278 *Patent* (EX1001) states that, “[m]otor vehicles, such as passenger cars, trucks, busses, fleet vehicles, etc. are widely used and knowing the locations of such vehicles is often desired. For example, should a vehicle be stolen, it would be beneficial to know the vehicle's location so that authorities could be promptly and accurately directed to retrieve the vehicle. Indeed, the tracking system could plot the getaway path of the thief.” ‘278 *Patent*, 1:30-36.

The Background of the Invention discusses the technology in the context of tracking the geographic location of the vehicle. For example, it explains:

For a company with hired drivers, it may be desirable to know the driver's whereabouts during the course of the day. Similarly, a rental car agency or other fleet operator, for example, may wish to know the whereabouts of its fleet of vehicles.

It may also be desirable to track the location of a vehicle as it is used throughout the course of a normal day. For parents of younger or older drivers, for example,

knowledge of the vehicle's location may provide some assurance that the driver is at designated locations and following a prescribed route.

'278 Patent, 1:37-46.

The Background of the Invention also describes the inventor's prior developed technology relating to security and control systems that address data bus interoperability as follows:

U.S. Pat. No. 5,719,551, assigned to Omega Patents, LLC, the assignee of the present invention, discloses a vehicle security system for a vehicle including a data bus connecting a plurality of vehicle devices. A signal enabling circuit enables the alarm controller to operate using a set of desired signals selected from a plurality of possible sets for different vehicles. U.S. Pat. No. 6,011,460, assigned to Omega Patents, LLC, discloses a similar system where the set of desired signals from the plurality of different sets of signals for different vehicles is obtained, such as by connection and communication with a downloading device. Additionally, U.S. Pat. No. 6,756,885, also assigned to Omega Patents, LLC,

discloses a multi-vehicle control system whereby a multi-vehicle compatible controller stores a set of device codes for a given vehicle device for a plurality of different vehicles. Device codes are read from the data communications bus, and a match between a read device code and the stored device codes is determined to provide compatibility with different vehicles. *Id.* 2:19-37.

The written description and associated drawings of the ‘278 *Patent* include embodiments directed to stolen vehicle alerts and speeding alerts (Figs. 4-6) and fault alerts, such as low battery or GPS/cellular failure alerts (Figs. 8-9.) *See* ‘278 *Patent*, 15:4-15:53, 18:3-19:9; EX2002, ¶51. The ‘278 *Patent* also describes embodiments having a downloading interface to address the potential difficulties of interfacing to a vehicle data bus and devices connected thereto. ‘278 *Patent*, 23:41-25:4, and FIGS. 10-13; EX2002, ¶51. Embodiments include a remote transmitter, and a remote start controller including a receiver and at least one processor to generate a climate control command on the data communications bus of the vehicle and remote start the vehicle. *Id.*; EX2002, ¶51. The at least one processor of the remote start controller is also configured to perform a different respective function in each different embodiment. *Id.*; EX2002, ¶¶48-51.

There are two species or categories of signal downloading interfaces

disclosed and claimed in the ‘278 *Patent*: (1) a wired signal downloading interface (e.g. Claim 2) that may include a connector for temporary connection to a downloading device (e.g. Claim 3); and (2) a wireless signal downloading interface (e.g. Claim 4) that may include a wireless receiver for temporary connection to a downloading device (e.g. Claim 5). ‘278 *Patent* 24:14 – 25:28; 26:16-29. EX2002, ¶52.

B. The Validity of the ‘278 Patent Has Been Confirmed Repeatedly

Starting in 2013, Patent Owner was in protracted litigation with CalAmp Corp. asserting four patents, one of which was the ‘278 *Patent*. (the “CalAmp Litigation”). In the first trial in the CalAmp Litigation, a jury concluded that the asserted patents, including the ‘278 *Patent*, were infringed and not invalid. EX2032. On appeal, the Federal Circuit affirmed the jury’s finding of no invalidity as to the ‘278 *Patent* and the other asserted patents. *Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1343 (Fed. Cir. 2019).²

The parties conducted a second trial, which resulted in a finding of direct infringement of the ‘278 *Patent* and the award of damages for 917,000+ units based thereon³. EX2033. Infringement of the ‘278 *Patent* was affirmed by the Federal

² In the first appeal, the Federal Circuit reversed and remanded the case for a new trial on select issues of infringement, willfulness, damages and fees. *Omega Patents*, 920 F.3d at 1354.

³ The jury also found that CalAmp did not induce infringement of a different asserted patent, and found damages for a single unit on a third patent that CalAmp was determined to infringe in the first trial. EX2033.

Circuit on appeal, but the damages award was reversed and remanded for a third trial. *Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1382 (Fed. Cir. 2021). The case was resolved prior to a third trial.

In 2015, CalAmp filed a petition for *ex parte* reexamination, application 90/013,587 (RX1). EX2035 (RX1). The examiner reviewed the petition and evidence and confirmed the claims. EX2035, pp. 13-14. CalAmp filed another petition for reexamination in 2016, application 90/013,851 (RX2). EX2036.

In the second reexamination, the claims were rejected, the decision was appealed, the PTAB reversed, and the claims of the ‘278 *Patent* were confirmed. EX2036, p. 140-reversal, p. 20-confirmation of the claims). CalAmp filed a third reexamination in 2019, application 90/014,309 (RX3). EX2037. After ordering reexamination, the examiner confirmed the validity of the claims of the ‘278 *Patent*. EX2037, pp. 23-24.

A fourth petition for reexamination was filed in 2019, application 90/014,419 (RX4). The examiner initially denied institution of reexamination (EX2038, pp. 711-728), but petitioner filed a petition to review the refusal. EX2038, pp. 732-741. In July 2023, the petition was granted-in-part. EX2038 pp. 774-785. That reexamination has concluded with a Certificate of Reexamination finding all claims valid based upon substantial evidence of secondary considerations. EX2038, pp. 3031-3033, 2986, 3020. The Examiner in RX4 considered the instant IPR

proceeding, a co-pending IPR proceeding, and the petitions and art applied therein. EX2038, pp. 2809, 2898-2917, 2949-2955, 2959-2967, 2974, 2991, 2993-3001, 3008, 3024.

A fifth request for reexamination was submitted in 2021, application 90/014,675 (RX5). EX1009. In the fifth reexamination, the claims were rejected, the decision was appealed, the PTAB reversed, and the claims of the ‘278 *Patent* were confirmed, noting substantial evidence of secondary considerations. Ex. 1015, p. 17.

IV. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner articulates the skill of the art for a POSA. Petition at p. 18-19. In its Institution Decision, the PTAB applied this level of skill noting that it, “appears to be consistent with the ‘278 patent and the asserted prior art.” Decision, 24. For the purposes of this IPR proceeding, Patent Owner has applied this level of skill⁴, and notes that it is sufficient for the PTAB to evaluate the Petition Grounds.

V. CLAIM CONSTRUCTION

In its Institution Decision, the PTAB construed the term “enabling data” and adopted the construction applied in the related co-pending IPR proceeding (EX2004; 504 IPR) which is also consistent with the construction it adopted in *Omega Patents*

⁴ Patent Owner reserves the right to propose a different level of skill in the art and support in other proceedings, including the related district court proceedings between these parties.

I (EX2005). Decision, 25. The PTAB construed “enabling data” 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.” Decision, 25. Patent Owner agrees with the PTAB.

The Institution Decision also construed the claim terms “vehicle tracking unit”, “vehicle position determining device”, and “vehicle position information.” Decision 26. The ‘278 *Patent* 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. Decision, 26-27. The specification refers to knowing the vehicle’s geographic “location” dozens of times. (*See, e.g., ‘278 Patent*, 1:30-1:57, 2:5, 12:20-12:40, 15:62, 16:16-17:5, 23:36-39). The specification also describes the vehicle position determining device as being provided by a GPS receiver in some embodiments. ‘278 *Patent*, 5:16-19. The PTAB, based upon the specification of the ‘278 *Patent*, construed the claim terms “vehicle tracking unit”, “vehicle position determining device”, and “vehicle position information” to mean tracking “with respect to geographic position.” Decision, 27. Patent Owner agrees.

VI. GROUND 1: CLAIMS 1-22 ARE NOT OBVIOUS OVER *FLICK885* AND *FLICK561*

Petitioner relies on the selective combination of the *Flick885* and *Flick561* patents to challenge the patentability of Claims 1-22 as being obvious. Petitioner

attacks the patentability of the claims of the ‘278 *Patent* with the benefit of nearly seventeen years of hindsight in selecting and combining bits and pieces of art that was already considered by a multitude of tribunals and that has been of record since the ‘278 *Patent* was originally filed. EX1009; EX1015; EX2005; EX2007; EX2038; EX2002, ¶54.

Petitioner attempts to stretch the teachings of *Flick885* beyond what is disclosed to a POSA – contending that *Flick885* “inherently” discloses various claim elements that, which seemingly amount to a rejection under 35 U.S.C. §102 as they are framed by Petitioner. Yet Ground 1 is asserted only under 35 U.S.C. §103, rendering arguments as to inherency irrelevant (and incorrect from a factual perspective). Petition, 6.

Petitioner contends that a combination of *Flick885* and *Flick561* renders obvious the claims of the ‘278 *Patent*. More particularly, Petitioner contends that *Flick885* discloses “everything” except the “tracking unit” or GPS. Petition 5, 22-24; EX2002, ¶57. Petitioner’s contentions fail to consider the entire teachings of *Flick885* and *Flick561* and fail to supply the missing pieces and/or a proper rationale for combination. EX2002, ¶55. Moreover, *Flick885* and *Flick561* are of record, have been considered, and are cumulative of art before prior examiners. EX2002, ¶¶53, 56; *see also* Sections II.A and II.B, above. Petitioner’s arguments for unpatentability must also fail in light of the compelling evidence of secondary considerations of

non-obviousness. EX2002, ¶56.

A. *Flick885*

As noted above, *Flick885* (EX1003) was cited by Patent Owner during prosecution of the ‘278 *Patent* and is described in the Background of the Invention section of ‘278 *Patent*. EX1009. *Flick885* was also considered by the Central Reexamination Panel (“CRU Panel”) in RX4 by virtue of the review of this IPR proceeding. EX2048, pp. 2949-2955, 2959-2967, 2974, 2991, 2993-3001, 3008. 3024. Accordingly, *Flick885* was specifically considered during the original prosecution and the recent RX4. *Id.*

Also referenced by Petitioner is U.S. Patent No. 6,011,460 (*Flick460*), which is directed to a vehicle security system for a vehicle having a data communications bus. EX2002, ¶59; *Flick460*, abstract. *Flick460*, like *Flick885*, was cited in the prosecution of the ‘278 *Patent*, and also considered by the Examiner. EX1009; EX2002, ¶59. Like *Flick885*, *Flick460* was also described in the background section of the ‘278 *Patent*. ‘278 *Patent*, 2:25-29; EX2002, ¶60.

B. *A POSA Would Not Have Found the Claims Obvious Over the Combination of Flick885 and Flick561*

Petitioner asserts that the motivation to selectively combine the references is (1) because the use of sensors to detect movement proximate the vehicle would motivate a POSA to use a tracking unit; (2) “because both address similar problems with vehicle security systems”; and (3) “because common sense and market forces

would teach them to develop a system that could be implemented in any vehicle type”. Petition 19-20. Patent Owner respectfully submits that a POSA would not have combined *Flick885* and *Flick561* in the manner proposed by Petitioner to arrive at the claimed embodiments. EX2002, ¶61.

Petitioner contends that *Flick885* inherently discloses a multi-vehicle compatible tracking unit because “one of the sensors disclosed is to ‘detect movement of the vehicle.’” Petition, 22, citing *Flick885*, 1:28-29. Petitioner further contends that *Flick885* discloses ultrasonic and microwave motion detectors and radar sensors that may be used to monitor the area proximate the vehicle. *Id.*, citing *Flick885*, 1:29-32. However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See MPEP §2112. The various sensors described in *Flick885* detect movement in or around the vehicle, or movement of the vehicle. EX2002, ¶63; *Flick885*, 1:27-32. This is not detecting the geographic position of the vehicle or vehicle tracking. EX2002, ¶63. The PTAB agrees. Decision, 31.

Petitioner argues that a POSA would understand that sensors, particularly radar sensors, have been used to track the position and velocity of a moving object and are often used for tracking of terrestrial and airborne vehicles. Petition, 22. Petitioner’s argument is faulty. EX2002, ¶64. The various sensors that Petitioner argues perform “vehicle tracking” are physically at the vehicle. *Id.* Radar tracks

distant moving objects. A vehicle cannot be tracked if the radar device used for tracking is at the vehicle. EX2002, ¶65. The radar sensor described in *Flick885* may be “used to monitor the area proximate the vehicle.” EX2002, ¶65; *Flick885*, 1:31-32. There is nothing in *Flick885* that discloses or suggests a vehicle tracking unit or tracking the geographic position of the vehicle itself, and the PTAB agrees. EX2002, ¶65; *Flick885*, 1:31-32; Decision, 31.

Petitioner also contends that a POSA would use the vehicle tracker from *Flick561* because an objective of *Flick885* is to add devices to an existing system, such as, for example, a vehicle security system. Petition, 22. Vehicle security and vehicle tracking are two different problems, as described in *Flick885* and *Flick561*. EX2002, ¶66; *Flick*, ¶12. Vehicle tracking technology occurred later in time and involved reporting geographic location of a vehicle to a separate monitoring station or device. EX2002, ¶65; *Flick*, ¶11. Petitioner’s attempt to shoehorn vehicle tracking into vehicle security in the manner proposed by the Petitioner is an impermissible form of hindsight using the ‘278 *Patent* as a roadmap to identify and solve a problem not identified by others at the time. EX2002, ¶66.

Petitioner contends that *Flick885* “also likely discloses a vehicle position determining device since the vehicle sensors may detect movement of the vehicle.” Petition, 23. Again, Petitioner suggests a rejection under 35 U.S.C. §102 into Ground 1 – which is based upon 35 U.S.C. §103. Notwithstanding Petitioner’s confusion

between novelty and obviousness, whether a reference “likely” teaches an element is not the test of anything – the reference either teaches or does not teach the element in question. *See generally* 35 U.S.C. 102; MPEP §2112; MPEP §2131. In this case, *Flick885* fails to teach a vehicle position determining device. EX2002, ¶67. The sensors described in *Flick885* include sensors that detect opening of the trunk, hood, doors, windows, and movement of the vehicle or within the vehicle, and may include motion detectors, vibration sensors, sound discriminators, pressure sensors, and radar sensors “*used to monitor the area proximate the vehicle.*” *Flick885*, 1:26-32; EX2002, ¶68. This is not a vehicle position determining device as used in vehicle tracking technology. EX2002, ¶68.

Petitioner further contends that *Flick885* discloses an MVCC for cooperating with a vehicle position determining device and a wireless communications device to send vehicle position information. Petition, 26. The Petitioner cited to *Flick885* as disclosing, a control system including a transmitter and a receiver “***for receiving signals from the transmitter, and a multi-vehicle compatible controller cooperating with the transmitter and receiver.***” Petition, 26 citing *Flick885*, 3:6-9; emphasis added by Petitioner. The MVCC in *Flick885* does not cooperate with a vehicle position determining device, *nor does it send vehicle position data.* EX2002, ¶69. This is because *Flick885* does not have a vehicle position determining device. *Id.* *Flick885* discloses signals for providing vehicle security functions or remote

operations, such as, for example, remote start or remote door unlocking. EX2002, ¶70; *Flick885*, 5:16-34. In other words, the MVCC of *Flick885* permits compatibility with different codes on the data bus, which may vary by vehicle. EX2002, ¶70; *Flick885*, 5:12-15.

With respect to the MVCC cooperating with a vehicle position determining device and a wireless communications device to send vehicle position information, Petitioner again turns to what it contends is “inherently” disclosed by *Flick885*, despite Ground 1 being based upon 35 U.S.C. §103. Petition 27. Petitioner doubles down on its rationale that *Flick885* inherently discloses a multi-vehicle compatible tracking unit because “one of the sensors disclosed is to ‘detect movement of the vehicle.’” Petition, 27, citing to *Flick885*, 1:28-29. Petitioner further contends that, in addition to ultrasonic and microwave motion detectors, radar sensors may be used in *Flick885* to monitor the area proximate the vehicle. Petition, 27; emphasis added. Once again, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See MPEP §2112. The various sensors described in *Flick885* detect movement in or around the vehicle, or movement of the vehicle, but do not track or detect the vehicle’s geographic position. EX2002, ¶72; *Flick885*, 1:27-32. Particularly in the context of Petitioner’s citation to *Flick885* (1:28-29), a POSA would understand that the movement detected in or around the vehicle is NOT a detection of the position,

geographically, of the vehicle. EX2002, ¶72. The PTAB agrees. Decision 32-33.

1. Petitioner’s Motivation to Combine Flick885 and Flick561 Is Improper

Petitioner contends that a POSA would have combined *Flick885* and *Flick561* because “there are several interrelated teachings, motivations, and suggestions” and that both *Flick885* and *Flick561* “address problems with vehicle security systems.” Petition, 19. Vehicle tracking and data bus multi-vehicle compatibility are not interrelated – that is a POSA cannot simply cherry pick individual elements from each of *Flick885* and *Flick561* to combine *Flick885* and *Flick561*. EX2002, ¶73; *Flick*, ¶12. The prior art did not identify a commonly shared problem nor suggest the combination of *Flick885* and *Flick561*. *Id.* Mr. Flick, a prolific inventor in both data bus and vehicle tracking technologies, was the one to recognize the benefits of combining these technologies, but not until his invention in the ‘278 Patent. *Flick*, ¶12. Petitioner characterizes *Flick885* as focused on a vehicle security system and the problems of vehicle security systems. Petition, 19. However, a more careful reading of *Flick885* leads a POSA to understand that *Flick885* is directed to a control system providing multi-vehicle compatibility with different data bus codes. EX2002, ¶74; *Flick885*, 5:12-15. While security functions can be performed using the MVCC disclosed in *Flick885*, so can keyless entry and remote start functions. EX2002, ¶75; *Flick885*, 3:33-35, 5:39-40, 7:4-9.

Similarly, Petitioner mischaracterizes *Flick561* as directed to vehicle security

systems and addressing problems with vehicle security systems. Petition, 19. *Flick561* is directed to a tracking and an alerting system for a vehicle. EX2002, ¶76; *Flick561*, 1:17-20. The vehicle tracker may be used for reporting the geographic location of the vehicle, whether for fleet operators, parents or when a vehicle is stolen. EX2002, ¶76; *Flick561*, 1:17-40. The vehicle tracker may also be used with an “optional separate security system.” EX2002, ¶76; *Flick561*, 5:57-59. But *Flick561* is directed to a vehicle tracker, not to a vehicle security system, nor does it address the problems of vehicle security systems. EX2002, ¶76. A reference must be considered for what it teaches to a POSA, including portions that teach away from the claimed embodiments. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Having “some overlap” would not drive a POSA to combine *Flick561* with *Flick885* when properly considering the claims of the ‘278 *Patent* as a whole. EX2002, ¶77. The Petitioner’s unjustified focus on vehicle security fails to consider the claims of the ‘278 *Patent* as a whole, and the art for what it teaches to a POSA. EX2002, ¶77. The only rationale for Petitioner’s combination is hindsight. *Id.*

The PTAB takes the position that any known problem in the art can serve as a motivation to combine *Flick885* and *Flick561*. Decision, 40. The PTAB further determined that a POSA would have had reason to combine *Flick885* with *Flick561* to achieve the claimed invention with a reasonable expectation of success. *Id.* The

PTAB further reasons that the use of GPS was well known before the priority date of the '278 Patent (e.g., as in *Flick561*), and that the GPS module “like the control system disclosed in *Flick '885*, can communicate information about a vehicle to a receiver.” Decision 40-41.

The PTAB’s rationale is flawed -- compatibility because devices “can communicate information about a vehicle to a receiver” does not equate to a reason to combine the references. Emphasis Added; Decision, 40-41; EX2044, ¶15. Such a position improperly suggests all vehicle-based references should be combined merely because they are capable of communication. *Id.*

Moreover, while the PTAB considered Mr. Flick’s testimony of GPS communication in vehicles and multi-vehicle compatibility not being interrelated as relevant, the PTAB looked beyond Mr. Flick (himself a POSA) to what other POSAs allegedly would have understood. Decision, 39. Rejecting the testimony of Mr. Flick, the PTAB states “any known problem in the art can serve as motivation to combine the references.” Decision, 40. Who other than Mr. Flick recognized the problem? There is no evidence before the PTAB that a POSA recognized this “known problem” before Mr. Flick. In addition to Mr. Flick’s testimony, to determine what a POSA understood at the time of the invention, a POSA need look no further than the volumes of evidence and references previously cited against the '278 Patent, which treat multi-vehicle compatibility as it relates to security functions

as distinct from GPS tracking. EX2044, ¶20; EX2001, ¶12. Moreover, none of the references discloses or suggests combining GPS tracking with multi-vehicle compatibility in a vehicle security system. *Id.* In fact, Mr. Suman, the inventor of one of the prior art references at the time of the invention — a reference used as a basis for formulating a rejection — provided evidence that multi-vehicle compatibility was not a thought to a POSA with respect to GPS communication from a vehicle⁵ EX2044, ¶20; EX2035; EX2035, pp. 1531, 1570-1576. In other words, Mr. Suman, who was a POSA working in the field at the time of the invention, also did not recognize the benefits of combining GPS communication in vehicles (i.e., vehicle tracking) and multi-vehicle compatibility (i.e., data bus). *Id.* Instead, Mr. Flick was the first to recognize the benefits and combine vehicle tracking with multi-vehicle compatibility. EX2044, ¶19; EX2001, ¶12. The initial issuance and repeated confirmation of patentability of the ‘278 *Patent* is evidence that POSAs at the time of the invention treated GPS vehicle tracking and data bus with multi-vehicle compatibility as distinct rather than interrelated technologies that permit a POSA to selection individual elements from the prior art and combine them to arrive at the claimed invention. EX2044, ¶19-20.

Petitioner advances another rationale for combining *Flick561* with *Flick885*,

⁵ U.S. Patent No. 6,028,537 to *Suman* (EX2043) was used to formulate a rejection in the first reexamination – a rejection that was later withdrawn. See Reexamination Control No. 90/013,587 (RX1; EX2035).

this time contending that the discussion of vehicle sensors in *Flick885* would “teach towards” using a vehicle tracker in *Flick561*. Petition, 20. As discussed Supra, the sensors disclosed in *Flick885* are local sensors to detect movement proximate to the vehicle or movement of the vehicle, not the geographic location of the vehicle. EX2002, ¶78; See Section VI, supra. The Petitioner concludes that “these teachings of sensors to detect movement would motivate a POSITA to use a tracking unit, including a GPS sensor, as disclosed in the ‘561 Patent.” Petition, 20. Petitioner’s rationale is nothing more than a logical leap between attempting to monitor local activity in and around a vehicle (in one reference) to adding GPS sensors from a different reference, which do nothing to monitor local activity. EX2002, ¶79.

The PTAB concluded that *Flick885* discloses vehicle sensors for detecting vehicle movement while *Flick561* discloses using GPS to “more broadly track vehicle movement.” Decision, 41. The PTAB uses this as motivation to look at an MVCC, such as disclosed in *Flick885*. The PTAB determined that “detecting vehicle movement” as disclosed in *Flick885* was not detecting geographical location. Decision, 26-27, 30-31. Thus, *detecting* local vehicle movement is not the same as *tracking* vehicle movement. EX2044, ¶21. The teaching of GPS tracking, as in *Flick561*, does not provide a motivation for looking to an MVCC, as in *Flick885*. *Id.* In other words, doing something with “movement” does not provide any leading, or motivation, toward a combination of *Flick885* and *Flick561*. *Id.* *Flick885* and

Flick561 are separate in their teachings, and the only way to conclude there is a motivation to combine is by using hindsight improperly. *Id.*

Despite the technical distinctions in cited art, the PTAB turned to *Dystar* to support the position that making something “better” is acceptable as a motivation for combining references. Decision, 41; citing *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1365 (Fed. Cir. 2006). The PTAB oversimplifies *Dystar*, which held that an implicit motivation to combine exists ... when the “improvement” is technology-independent **and** 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. *Id.*, emphasis added. According to *Dystar*, where (as here) the “improvement” is technology dependent, a technical rationale is required; simply uttering the terms “desirable” or “better” is not sufficient. Because a combination of *Flick885* with *Flick561* results, in hindsight, in a “better” product is not a sufficient motivation to combine. A combination of *Flick885* and *Flick561* can only be achieved using improper hindsight. EX2044, ¶21.

Petitioner also argues that the “prospects of incorporating a vehicle tracking unit from the ‘561 Patent would have motivated skilled artisans to include it for the vehicle security system disclosed in the ‘885 Patent.” Petition, 20. In other words, Petitioner contends that the mere technical possibility of incorporating a vehicle

tracker into *Flick885* is all that is needed to provide a proper motivation. Just because something may possibly be done is not sufficient motivation by itself to support an obviousness rejection. See MPEP §2143. “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). There is nothing in *Flick885* or *Flick561* that would alert a POSA to this prospect. EX2002, ¶80. Indeed, any “prospects” necessarily come from using the inventor’s own work – the ‘278 *Patent* – which provided the roadmap now used by Petitioner in hindsight. *Id.*

Additionally, Petitioner contends a motivation for combining *Flick885* and *Flick561* results from “common sense” and “market forces.” Petition, 20. Reliance on “common sense” alone is never a sufficient rationale for combining references. *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002); *In re Van Os*, 844 F.3d 1359, 1361, 121 USPQ2d 1209, 1211 (Fed. Cir. 2017). “Absent some articulated rationale, a finding that a combination of prior art would have been ‘common sense’ or ‘intuitive’ is no different than merely stating the combination ‘would have been obvious.’” *Id.* Market demand as a motivation, particularly for inventions regarding some form of technology, similarly amounts to nothing more than a conclusion and

is also improper. *ActiveVideo Networks, Inc. v. Verizon Communs., Inc.*, 694 F.3d 1312, at 1329 (Fed. Cir. 2012)

“[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Personal Web Technologies, LLC v. Apple, Inc.* 848 F.3d 987 at 994 (Fed. Cir. 2017), citing *InTouch Techs., Inc. v. VGO Communications, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014). A clear, evidence-supported account of the contemplated workings of the combination is a prerequisite to adequately explaining and supporting a conclusion that a relevant skilled artisan would have been motivated to make the combination and reasonably expect success in doing so. *Personal Web Tech.*, 848 F.3d at 994. Petitioner falls well short of providing any evidence that a POSA would have, without hindsight and while considering *Flick881* and *Flick561* as a whole, arrived at the claimed invention in the ‘278 Patent. EX2002, ¶81.

Technical advance, like much of human endeavor, often occurs through incremental steps toward greater goals. These marginal advances in retrospect may seem deceptively simple, particularly when retracing the path already blazed by the inventor. *Mintz v. Dietz & Watson*, 679 F.3d 1372, 1378 (Fed. Cir. 2012). A combination of *Flick885* and *Flick561* can only be achieved through the use of improper hindsight, using the ‘278 Patent as a roadmap. EX2002, ¶82. Petitioner

fails to provide evidence establishing obviousness. EX2002, ¶82.

2. Petitioner's Proposed Combination of Flick885 and Flick561 Fails to Consider Compelling Evidence of Secondary Considerations

“[M]ost, if not all, [inventions] rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known,” yet this alone does not render an invention obvious. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-19. Evidence of secondary considerations must be evaluated when considering obviousness. *Graham v. John Deere Co.*, 383 U.S. 1 at 17-18 (1966). “[T]his court requires consideration of these objective indicia because they provide objective evidence of how the patented device is viewed in the marketplace, by those directly interested in the product.” *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1378 (Fed. Cir. 2012) (internal citations omitted).

Here, the evidence of secondary considerations weighs heavily in favor of patentability. Evidence of secondary considerations cannot be discounted: it plays a critical role in the obviousness analysis and, indeed, weighs in Patent Owner’s favor in this regard. See *Leo Pharm. Products, Ltd. v. Rea*, 726 F.3d 1346, 1358, (Fed. Cir. 2013); *Ex Parte Flick*, Appeal 2022-003758 at 15 (EX1015). That is, this evidence is not just a cumulative or confirmatory part of the obviousness analysis, but rather is independent evidence of non-obviousness that is the most probative evidence in that regard “in avoiding the trap of hindsight when reviewing what

otherwise seems like, a combination of known elements.” *Ex Parte Flick*, Appeal 2022-003758 at 15 (EX1015), citing *Leo Pharm. Products* at 1358 . Some of this evidence has already been considered and relied on multiple times by the PTAB. EX1015, EX2005.

Courts have cautioned against falling into the forbidden use of hindsight, and rely on evidence of secondary considerations to guard against this forbidden use. *Mintz*, 679 F.3d at 1379.

“The need for Graham findings can be important to ward against falling into the forbidden use of hindsight. Simply because the technology can be easily understood does not mean that it will satisfy the legal standard of obviousness. In fact, objective consideration of simple technology is often the most difficult because, once the problem and solution appear together in the patent disclosure, the advance seems self-evident. Instead, the proper analysis requires a form of amnesia that ‘forgets’ the invention and analyzes the prior art and understanding of the problem at the date of invention.” *Id.* .

When evidence of secondary considerations is considered, the claims of the ‘278 Patent are not obvious in view of *Flick885* and *Flick561*, particularly the

combination of a vehicle position determining device and a multi-vehicle compatible controller for cooperating with the vehicle position determining device to send vehicle position data. EX2002, ¶85. Petitioner’s suggestion is to slap GPS tracker technology from *Flick561* into the *Flick885* system in a single housing, with nearly seventeen (17) years hindsight, despite careful consideration by a multitude of tribunals. EX2002, ¶86. This is wrong and does not give proper weight to the evidence of secondary considerations. *Id.*

a. Multiple Decisions Confirming Validity

Petitioner wants the PTAB to ignore the prior decisions confirming validity. For example, Omega sued CalAmp, Corp. (“CalAmp”) for infringement of four patents, including the ‘278 Patent, in 2013. *See Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1342 (Fed. Cir. 2019). Some of the accused products included the CalAmp LMU-3000, LMU-3030 and LMU-3050 products. (EX2032, p. 5.) CalAmp challenged the validity of all asserted patents in the litigation, and after a first trial, the jury found the patents, including the ‘278 patent, were not invalid, (EX2032, p. 7.) The jury made specific findings on secondary considerations:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word "yes" in the blank below to any question that you answer "yes" to):

- | | |
|------------|--|
| <u>YES</u> | Were accused products covered by the claim commercially successful due to the merits of the claimed invention rather than due to advertising, promotion, salesmanship, or features of the product other than those found in the claim? |
| <u>X</u> | Was there long felt need for a solution to the problem facing the inventors, which was satisfied by the claimed invention? |
| <u>X</u> | Did others try, but fail, to solve the problem solved by the claimed invention? |
| <u>YES</u> | Did others copy the claimed invention? |
| <u>X</u> | Did the claimed invention achieve unexpectedly superior results over the closest prior art? |
| <u>X</u> | Did others in the field praise the claimed invention or express surprise at the making of the claimed invention? |
| <u>YES</u> | Did others accept licenses under patents because of the merits of the claimed invention? |

(EX2032, p. 9.) After trial, the Federal Circuit affirmed the jury's validity finding, but reversed and remanded on infringement, damages and fees. *Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1343 (Fed. Cir. 2019). Omega and CalAmp retried the case before a second jury, which again found the CalAmp LMU-3000, LMU-3030 and LMU-3050 products infringed the '278 Patent, this time awarding damages specific to the '278 Patent (to the exclusion of several other patents in suit):

Total damages awarded: \$ 4,586,111

Number of accused products included in damages award: 917,223

5.B. Of the total number of accused products found to infringe and therefore included in the damage award (see question 5.A. above), how many accused products have been found to infringe each patent (for any patents found not infringed, please leave that line blank):

'876 patent: Ø

'885 patent: Ø

'727 patent: 1 unit

'278 patent: 917,222 unit

(EX2033, p. 6.) Other than awarding \$1 for a single unit attributable to the '727 Patent, the jury only awarded damages of \$5/unit for infringement based on over 917,000 units tied specifically to the '278 Patent. (EX2033, p. 6.) This jury's verdict of infringement was confirmed, though the Federal Circuit reversed and remanded the damages award for a new trial on the amount of damages. *Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1365 (Fed. Cir. 2021).

The '278 *patent* has been the subject of five *ex parte* reexamination proceedings, all of which confirmed all claims patentable: Serial No. 90/013,587 (RX1); Serial No. 90/013,851 (RX2); Serial No. 90/014,309 (RX3); Serial No. 90/014,419 (RX4); and Serial No. 90/014,675 (RX5). EX2035-EX2039. In RX2 and RX5, after the examiner finally rejected the claims of the '278 *Patent*, on appeal

the PTAB reversed the examiner. (EX2036, pp. 2355-23870; EX2039, pp. 1114-1130). In RX5, the PTAB specifically cited to secondary considerations in its decision, holding that independent evidence of non-obviousness is often the most probative evidence “in avoiding the trap of hindsight when reviewing what otherwise seems like, a combination of known elements.” *Ex Parte Flick*, Appeal 2022-003758 at 15 (EX1017), citing *Leo Pharm. Prods.* at 1358. Explaining this further in the context of the ‘278 Patent, the PTAB found:

“A key aspect of our finding in this regard is, as it was in a related appeal, (1) the jury's verdict in related litigation that there was a nexus between the evidence of secondary considerations of non-obviousness and the claimed invention, and (2) the Federal Circuit's affirming the district court's upholding the jury's infringement verdict. *See Omega Patents*, 13 F.4th at 1365 (affirming the judgment of infringement of the '278 patent's asserted claims).

Our holding in a related appeal involving similar secondary considerations evidence is instructive in this regard, albeit in connection with a different patent. *Cf.*

Dec. 2019 Bd. Dec'n, at 10-18. In that appeal, we found Appellant's evidence of secondary considerations of non-obviousness of the claimed invention, including licensing, commercial success, and copying by others, outweighed the evidence of obviousness and was dispositive of error in the Examiner's rejections. *See id.* at 17-18.

In reaching this conclusion, we emphasized the jury's verdict that there was a nexus for each proffered secondary consideration to the claimed invention. *See id.* at 13 (noting the jury's finding that eight licenses were key factors in the claimed invention's non-obviousness because the licenses were accepted *due to the merits of the claimed invention*), 14 (noting the jury's finding that the commercial success of products embodying the claimed invention was due to the claimed invention's merits---not other factors), and 16 (noting the jury's verdict that others copying the claimed invention was a key factor indicating non-obviousness of that invention).

Notably, as Appellant indicates, the jury made similar findings here. *See* Appeal Br. 38 (reproducing jury verdict form indicating the jury's finding that others accepted licenses under patents *because of the merits of the claimed invention*), 39 (reproducing jury verdict form indicating the jury's finding that accused products covered by the claim were commercially successful *due to the merits of the claimed invention* rather than due to advertising, promotion, salesmanship, or product features other than those claimed), and 42 (reproducing jury verdict form indicating the jury's finding that others copying the claimed invention indicated non-obviousness of the claimed invention).”

Ex Parte Flick, Appeal 2022-003758 (EX1017), at 13-14 (internal footnotes omitted). More recently, the examiner in RX4 again cited to secondary considerations, again confirming validity after affirmatively noting his review of this pending IPR (and co-pending IPR2023-00504) on December 12, 2023, after both institution decisions had issued. EX2038, pp. 2898-2917, 2974, 2986, 2991, 3008, 3020, 3024. In other words, numerous examiners and the PTAB have carefully considered cumulative and duplicative references and found evidence of secondary

considerations sufficient to confirm the validity of the ‘278 *Patent*. This provides compelling evidence and persuasive authority for the decision in this IPR.

b. Omega-CalAmp Litigation Evidence

Mr. Flick recognized that while he had previously invented technologies for multi-vehicle control systems that interface the data bus, and that vehicle tracking systems previously existed, none provided “advanced techniques for dealing with multiple device codes for a vehicle having a data communications bus have not yet been developed for vehicle tracking units.” EX1001, 2:38-41. Similarly, CalAmp recognized strong industry need and market demand for such a system—only CalAmp recognized it years after Mr. Flick. EX2023, p. 1 (dated 2010).

As noted above, the CalAmp litigation involved products identified as the LMU-3000, LMU-3030 and LMU-3050, all of which infringed claims of the ‘278 Patent. (EX2033, p. 6.) When CalAmp began development of the infringing LMU-3000 in late 2010, its Commercial Requirements Specification articulated a need for an “OBDII product for a value added GPS tracking and cellular communication product,” which was based upon “customer opportunities” identified by CalAmp. EX2023, p. 4. CalAmp’s LMU-3030 Commercial Requirements Specification similarly recognized the unmet customer need for a “self-contained vehicle tracking and data monitoring unit,” which allowed for simple plug-in installation. (EX2024, p. 5.)

CalAmp's requirements documents are also consistent with the impressions of CalAmp's engineers, who recognized that the motivation for developing the LMU-3000 was based on customer demand for the features, while also recognizing products limited to a single vehicle would reduce the value and demand. EX2019, ¶40-41; EX2011, 46:25-47:19; EX2012, 40:20-41:4. Similarly, one of the engineers believed there were no design around options available to CalAmp. EX2011, 44:23-45:2; EX2019, ¶43. CalAmp executive Gallin Chen acknowledged to CalAmp's patent counsel the belief that claim 13 of the '278 Patent would be "harder to avoid" infringement because it implicated how CalAmp programmed its infringing units. EX2020.

c. The Infringing CalAmp Products Are Coextensive

"We presume that such a nexus applies for objective indicia when the patentee shows that the asserted objective evidence is tied to a specific product and that product 'embodies the claimed features, and is coextensive with them.'" *Polaris Indus. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018), quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000). Conversely, "[w]hen the thing that is commercially successful is not coextensive with the patented invention—for example, if the patented invention is only a component of a commercially successful machine or process—the patentee must show prima facie a legally sufficient relationship between that which is

patented and that which is sold.” *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). Where the infringing products are coextensive and a nexus presumed, the Petitioner must offer evidence to rebut the nexus. *See Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1393 (Fed. Cir. 1988).

The CalAmp litigation proves highly relevant to secondary considerations because the CalAmp LMU-3000, 3030 and 3050 products were found to infringe claims 1-6, 8, 11, 12-14, 16, 18, 19 and 21 of the ‘278 *patent* by a jury, and the verdict of infringement was subsequently affirmed by the Federal Circuit. *Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1373 (Fed. Cir. 2021). In contrast to a dispute where the claimed invention is merely a component of the commercial product, the scope of the claims of the ‘278 *Patent* is reflected by and coextensive with the CalAmp LMU-3000, 3030 and 3050. EX2044, ¶25. All independent claims of the ‘278 *patent* recite “a multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle”—just like the infringing products. EX2044, ¶26. CalAmp touted the technology claimed in the ‘278 *patent*, including the multi-vehicle controller, the downloading interface, and the ability to perform GPS tracking functionality—all claimed elements—which evidences the coextensive nature of the products with the claims. EX2019, ¶¶32-39; EX2044, ¶27.

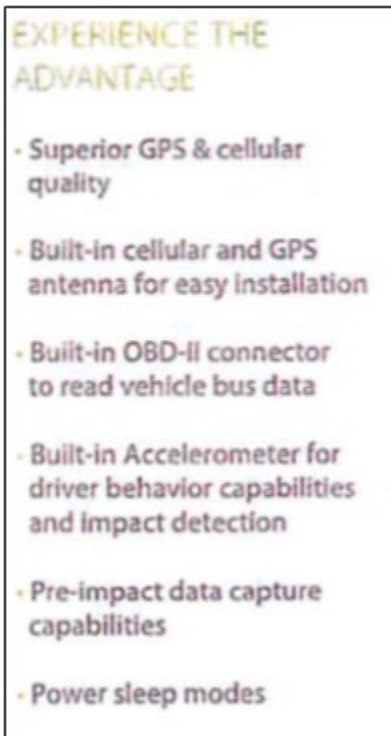
The Federal Circuit has recognized that “the purpose of the coextensiveness requirement is to ensure that nexus is only presumed when the product tied to the evidence of secondary considerations ‘is the invention disclosed and claimed.’” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019), citing *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). As the *Fox Factory* decision recognizes, where there are unclaimed features in a product, it can impact the determination of coextensiveness, but the Federal Circuit tempered this by recognizing that “we have never held that the existence of one or more unclaimed features, standing alone, means nexus may not be presumed.” *Fox Factory*, 944 F.3d 1366, 1374 (Fed. Cir. 2019) Instead, where “unclaimed features amount to nothing more than additional insignificant features, presuming nexus may nevertheless be appropriate.” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019).

Here, the relevant features of the CalAmp LMU-3000/3030/3050 are both disclosed and claimed. EX2044, ¶25-27. Consider claim 12, which incorporates all elements of claim 1 in a tracking unit within a single housing. EX2044, ¶27. Years after the invention, CalAmp recognized the benefits of the merger of an OBDII interface for multiple vehicles, a download interface, vehicle tracking (GPS), and wireless communication (cellular) technologies in a single housing. As set forth in the Commercial Requirements Specifications, CalAmp recognized the customer

demand for combining these technologies in a single housing configuration:

- “OBD-3000 Plug-on OBD-II product for a value added GPS tracking and cellular communication product;” EX2023, p. 4;
- “The OBD-3000 product is derived roughly from the LMU-2600 with an OBDII interface added and physical design to plug directly onto the OBDII connector;” EX2023, p. 4;
- “The device is packaged in a J1962 compatible OBDII plug form-factor plastic case. This configuration provides for an extremely simple installation...;” EX2024, p. 5;
- “The LMU-3030 is a self-contained vehicle tracking and data monitoring unit. The product is capable of monitoring and communicating with the vehicle Engine Control Unit via the OBD II port to retrieve vehicle status and diagnostic data;” EX2024, p. 5;

A review of the LMU-3000 confirms the features identified in product literature are either claimed or insignificant. For example, the “advantages” of the LMU-3000 are listed as follows:



EX2021. The first three advantages all expressly relate to the claimed data bus, vehicle location and wireless communication features. EX2044, ¶¶28-29. The inclusion of the accelerometer⁶ for driver behavior and impact detection was an insignificant feature, because (a) it was not pertinent to the primary goals of the vehicle tracking unit, and (b) the OBDII data available through the vehicle's data bus could provide driver behavior and impact detection, rendering the accelerometer data redundant. EX2044, ¶¶31. Data capture and power control were both insignificant features that would have commonly been provided by the STMicroelectronics 32F103REY6 microprocessor included with the LMU-3000.

⁶ Based on the schematics for the LMU-3000, the accelerometer was a common and simple component available at a trivial cost at the time. EX2044, ¶¶31.

EX2044, ¶31-32. Petitioner offered no evidence that any unclaimed feature of the infringing CalAmp products is significant. This is analogous to *Polaris Indus. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1073 (Fed. Cir. 2018), where the Federal Circuit confirmed that unrebutted evidence showing the claims are coextensive with the product establishes the presumption of a nexus.

d. The Evidence Establishes a Nexus to Secondary Considerations

i. CalAmp Infringing Products

Even if the PTAB deems the claims of the ‘278 Patent not fully coextensive with CalAmp’s infringing products, a nexus is established because the evidence shows the secondary considerations are the result of the claimed invention. “[T]here is no requirement that ‘objective evidence must be tied exclusively to claim elements that are not disclosed in a particular prior art reference in order for that evidence to carry substantial weight.’” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1331 (Fed. Cir. 2016).

In its press release for the LMU-3000, CalAmp—a “leading provider of wireless products, services and solutions”—touted its “new location monitoring and messaging device specifically for commercial and consumer auto insurance applications, a market that represents more than 250 million registered vehicles in the United States alone.” EX2019, ¶27. CalAmp promoted the LMU-3000 and LMU-3030 as being compatible with multiple OBD II bus protocols and “other

OEM interfaces,” as claimed by the ‘278 patent. EX2019, ¶32; EX2044, ¶26-27. CalAmp also promoted the ability to update the infringing products at later times via the download interface, again as claimed in the ‘278 patent. EX2019, ¶36; EX2044, ¶30. Mr. Tregillis’s opinions highlighted evidence supporting a general market need for the infringing products, including supporting testimony from individuals involved in developing the infringing products, who stated “sales-driven requests from customers” led to the combination of technologies in CalAmp’s infringing devices. EX2019, ¶¶39-40. As noted in the Tregillis declaration, the market need was for a combination of technologies, not discrete or unclaimed features already available separately. EX2019, ¶¶24, 26-28. The market need for the technology is relevant to the nexus with the ‘278 patent, which recognized the lack of comparable technology even years after the invention of the ‘278 patent.

Providing multi-vehicle capability and incorporating a downloading interface avoided the need to have multiple SKUs (stock keeping units), reduced the units needed by installers and expenses, and was a more desirable configuration. EX2044, ¶12; EX2011, 46:25-47:19, 47:25-48:19; EX2001, ¶13. Alternatively, without the patented ‘278 *Patent* technology, a vehicle tracking unit would have limited value because of the need to stock far more vehicle specific products, increasing the expense, the number of products, and the required stocking levels of such products. (EX2001, ¶10; EX2044, ¶12; EX2011, 46:25 –48:19; EX2019, ¶40. Moreover, both

the inventor and CalAmp recognized there were no viable design arounds incorporating the tracking and multi-vehicle data bus technologies, further linking the CalAmp units to the ‘278 Patent. EX2001, ¶13; EX2011, 45:15-19. This was echoed by a CalAmp representatives (Galin Chen) email to CalAmp’s outside patent counsel (David Bailey), referencing his belief that “[claim] 13 [of the ‘278 Patent] may relate to how we program a unit at the factory so it may be harder to avoid.” EX2020. Ultimately, CalAmp enjoyed significant commercial success with the infringing units, selling 917,222 infringing products at the time of the verdict in the second trial, and the success of these products were expressly tied to claims of the ‘278 patent at issue in this proceeding. EX2033, p. 6; EX2044, ¶27.

ii. Commercial Success

The evidence from the Omega-CalAmp litigation established for the jury that the commercial success of the infringing products was due to the merits of the claimed invention:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word “yes” in the blank below to any question that you answer “yes” to):

yes

Were accused products covered by the claim commercially successful due to the merits of the claimed invention rather than due to advertising, promotion, salesmanship, or features of the product other than those found in the claim?

EX1027. While the infringement finding was reversed by the Federal Circuit in the

first appeal, a second jury again found CalAmp's devices infringed the '278 Patent, and in a second appeal, the Federal Circuit affirmed the finding of infringement. *Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1373 (Fed. Cir. 2021). Importantly, the second CalAmp Jury Verdict establishes that CalAmp's commercial products correspond directly to the claimed invention in the '278 patent, finding CalAmp sold over 917,000 units that infringed the '278 Patent:

Total damages awarded: \$ 4,586,111

Number of accused products included in damages award: 917,223

5.B. Of the total number of accused products found to infringe and therefore included in the damage award (see question 5.A. above), how many accused products have been found to infringe each patent (for any patents found not infringed, please leave that line blank):

'876 patent: Ø

'885 patent: Ø

'727 patent: 1 unit

'278 patent: 917,222 unit

EX2033. The extensive sales of infringing products is evidence of commercial success directly tied to the '278 Patent, further supported by development documents and testimony establishing a nexus between the advantages of the combinations of technology by an industry leader, and the market demand for such features resulting in significant sales. Notably, the infringing CalAmp units operate

in the same manner as those products offered by Petitioner and accused of infringement in district court litigation. EX2001, ¶15.

iii. Licensing

The ‘278 *Patent* has been licensed by numerous parties over the years. EX2019, ¶18. Indeed, the ‘278 *Patent* has been included in multiple licenses provided by the Patent Owner, and is within the portfolios of patents that have generated in excess of \$70MM in patent royalties. EX2019, ¶18-20. The licensing of the ‘278 *Patent* (and several other asserted patents) was recognized by the jury in the first trial between Patent Owner and CalAmp, during which CalAmp unsuccessfully challenged the validity of the ‘278 *Patent*:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word “yes” in the blank below to any question that you answer “yes” to):

YES

Did others accept licenses under patents because of the merits of the claimed invention?

EX2032. More simply, having received the testimony of witnesses and the exhibits at trial, and applied the Court’s Jury Instructions, the Jury determined that the licenses were based on the merits of the claimed invention, including the ‘278 *Patent*. The 2016 Jury verdict was challenged on appeal by CalAmp, and the Federal Circuit affirmed the finding rejecting invalidity of the ‘278 *Patent*. *See Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1343 (Fed. Cir. 2019), which leaves

the Jury's finding on non-obviousness intact.

iv. Copying by Others

In the following excerpt from the First Jury Verdict from the CalAmp litigation as to invalidity, the Jury confirmed the evidence established copying of the patented inventions, including the '278 Patent:

5. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention (write the word "yes" in the blank below to any question that you answer "yes" to):

YES Did others copy the claimed invention?

EX2032. Some of the evidence presented to the jury and specific to copying and the '278 Patent, was the admission from CalAmp executive Gallin Chen to CalAmp's patent counsel—claim 13 of the '278 Patent would be “harder to avoid” infringement, yet CalAmp continued to infringe. EX2020. The Jury's finding of infringement established that CalAmp's products copied the claimed invention, and resulted in significant sales volume of products that embody the '278 Patent.

C. The Combination of Flick885 and Flick561 Has Already Been Considered

Flick885 and *Flick561* were both in the hands of the original Examiner. Accordingly, the Examiner considered *Flick885* and *Flick561* during the original prosecution of the '278 Patent. The Institution Decision, with reference to the Intent

to Issue *Ex Parte* Reexamination Certificate in RX4, contends that while *Flick885* and *Flick561* were “each individually cited in an IDS along with dozens of other references” there is “no indication that such references were substantively considered by the Examiner alone or in combination.” Decision, 15. In other words, the Examiner may not have considered them substantively despite their inclusion in the prosecution history. Decision, 15, Footnote 4. However, the CRU Panel is obligated to consider information cited in an IDS the same as any other documents considered while conducting a search of the prior art. MPEP §609. Additionally, the CRU Panel indicated that he considered the references by way of the indication of “all references considered except where lined though”. EX2038, pp. 2959-2967, 2993-3001.

Patent Owner has cited, individually and collectively, the different papers of both the present IPR and the co-pending IPR, including the Petitions themselves. EX2038, pp. 2959-2967, 2993-3001. The Petition for the present IPR sets forth the Petitioner’s theories for combining *Flick885* and *Flick561*. The CRU Panel in RX4 not only considered *Flick885* and *Flick561*, but considered these references in combination, and all the prior art, included in the co-pending IPR, given the review of the IPR petitions. EX2038, pp. 2809, 2898-2917, 2949-2955, 2959-2967, 2974, 2991, 2993-3001, 3008, 3024. This is confirmed because the Examiner’s Search Notes clearly indicate that the CRU Panel “reviewed” the present IPR, which

includes the combination of *Flick885* and *Flick561* in the manner set forth in the Petition and including any supporting evidence provided by the Petitioner. EX2038, pp. 2974, 2991, 3008, 3024. Given the critical importance of an IPR proceeding, it is a foregone conclusion that the CRU Panel substantively considered, in-depth, this IPR and its art, including *Flick885* and *Flick561*. EX2038, pp. 2809, 2898-2917, 2949-2955, 2959-2967, 2974, 2991, 2993-3001, 3008, 3024.

Search Notes 	Application/Control No. 90/014,419	Applicant(s)/Patent Under Reexamination 8032278
	Examiner Luke S Wassum	Art Unit 3992

CPC - Searched*		
Symbol	Date	Examiner

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
Reviewed prosecution history of US Pat No 8,032,278	01/07/2020	cmt
Reviewed related ex parte reexaminations: 90013587, 90013851, 90014309	01/08/2020	cmt
Reviewed prosecution history of appn 11/773,272	12/12/2023	lsw
Reviewed prosecution history of appns 90/013,587; 90/013,851; 90/014,309; 90/014,675	12/12/2023	lsw
Updated Litigation Search	12/04/2023	lsw
Patent Data Portal (PDP) for continuity data	12/12/2023	lsw
P-TACTS for AIA proceedings	12/12/2023	lsw
Reviewed IPR2023-00504	12/12/2023	lsw
Reviewed IPR2023-01162	12/12/2023	lsw

See EX2038, pp. 2991, 3024; Annotated by Patent Owner.

Reviewed IPR2023-00504	12/12/2023	lsw
Reviewed IPR2023-01162	12/12/2023	lsw

See EX2038, pp. 2991, 3024.

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
Inter Partes Review	IPR2023-00504 (open)
Inter Partes Review	IPR2023-01162 (open)

See EX2038, pp. 2974, 3008.

IPR2023-01162, Verizon Connect Inc. Vs. Omega Patents, LLC

US Patent Trial and Appeals Board - Alexandria

Alexandria

This case was retrieved on 12/04/2023

Header

Case Number: IPR2023-01162
Date Filed: 06/30/2023
Date Full Case Retrieved: 12/04/2023
Status: Open
Misc: (0) Unknown; Civil

Summary

Court Case Status: Corrected
Case Type: IPR: Inter partes review
Technical Center Number: 3600
Patent Application Number: 11773272
Patent Number: 8032278

Participants

Litigants Verizon Connect Inc. Petitioner Omega Patents, LLC PatentOwner	Attorneys
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Proceedings

Date	#	Proceeding Text	Details
06/30/2023	1	In Ex Parte A. James Smith, Jr., 2010 WL 3269939 (BPAI August 17, 2010)	Filed By: PETITIONER Document Type: EXHIBIT Paper/Exhibit No: 1029 Public? Yes
06/30/2023	2	02-20-2015 Order on Claim Construction, 6:13-cv-1950-ORL- 40-DAB	Filed By: PETITIONER Document Type: EXHIBIT Paper/Exhibit No: 1028 Public? Yes
06/30/2023	3	10-03-2014 Plaintiff???s Opposition to CalAmp???s Motion for Claim Construction	Filed By: PETITIONER Document Type: EXHIBIT

Karen Ward

EX2038, p. 2950.

Litigation Search Report CRU 3999

Reexamination Control No. 90/014419

To: Luke Wassum	From: Karen Ward
Location: CRU	
Art Unit: 3992	Phone: (571) 272-7932
Date: 12/04/2023	E-mail: karen.ward@uspto.gov

Search Notes

U.S. Patent No. 8,032,278

1. Performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.
2. Performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.
3. Performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.
4. Performed a search in Lexis in the IP Journal and Periodicals database for any articles on the patent.
5. Performed a search in Lexis in the news databases for any articles about the patent or any articles about litigation on this patent.

Litigation: Cases Found

Status	Docket	Description
Closed	6:13cv1950	Omega Patents, Llc V. Calamp Corp.
Open	IPR2023-00504	Geotab USA, Inc. et al. Vs. Omega Patents, LLC
Closed	6:20cv693	Omega Patents, Llc V. Dei Holdings, Inc.
Closed	1:17cv2769	Omega Patents, Llc V. Enfora, Inc.
Open	6:22cv2371	Omega Patents, Llc V. Verizon Connect, Inc.
Open	1:22cv1044	Omega Patents, Llc V. Geotab Usa, Inc. Et Al
Closed	2:20cv1344	Omega Patents Llc V. Firstech Llc
Open	1:23cv382	Omega Patents, Llc VB. Geotab, Inc.
Open	IPR2023-01162	Verizon Connect Inc. Vs. Omega Patents, LLC

EX2038, p. 2809.

IPR2023-01162, Verizon Connect Inc. Vs. Omega Patents, LLC

Date	#	Proceeding Text	Details
			Paper/Exhibit No: 4 Public? Yes
07/21/2023	34	Notice : Mandatory Notice	Filed By: PATENT OWNER Document Type: PAPER Paper/Exhibit No: 3 Public? Yes
06/30/2023	35	Petition : as filed	Filed By: PETITIONER Document Type: PAPER Paper/Exhibit No: 2 Public? Yes
06/30/2023	36	Notice : Power of Attorney	Filed By: PETITIONER Document Type: PAPER Paper/Exhibit No: 1 Public? Yes

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EX2038, p.2955.

Furthermore, during RX4, the CRU Panel could have formulated a rejection based upon the art cited in the present IPR. On taking up an application for examination or a patent in a reexamination proceeding, the CRU Panel shall make a “thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention.” 37 CFR §1.104. The available prior art in this case, thoroughly studied and investigated by the CRU Panel, included *Flick885* and *Flick561*. *Id.*

Additionally, during a reexamination, claims may be rejected based upon “old art” presented in a new light. See MPEP §2242 and paragraph 22.01.01.

Notwithstanding the original Examiner’s examination of the ‘278 *Patent*, the CRU Panel in RX4 could have formulated a rejection based upon *Flick885* and *Flick561* if the IPR Petition presented “old” art in a new light. *Id.* Yet, the CRU Panel in RX4 did not form any rejection, and instead properly confirmed patentability of all the claims. EX2038, pp. 3011-3023, 3031-3033.

D. Claims 2-3

Sections VI.A-C, above, explain that the selective combination of *Flick885* and *Flick561* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections VI.A-C, dependent Claims 2-3 are also patentable. EX2002, ¶94.

E. Claim 4

Sections VI.A-C, above, explain that the selective combination of *Flick885* and *Flick561* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections VI.A-C, dependent Claim 4 is also patentable. EX2002, ¶95.

Additionally, Petitioner contends that *Flick829*, which “is incorporated by reference in the ‘278 *Patent*” also discloses a wireless signal downloading interface. Petition, 35; emphasis added. First, it is incorrect that the ‘278 *Patent* incorporates *Flick829* by reference. Moreover, it is unclear what Petitioner is attempting to show

with reference to *Flick829*. If Petitioner is arguing that *Flick829* is additional prior art and is being used as a basis for formulating a rejection, Petitioner fails to set forth this ground in the Petition. Instead, Ground 1 is based upon the combination of *Flick885* and *Flick561*. Petition, 6. Regardless, Petitioner fails to establish or explain that even the selective combination of *Flick885* and *Flick561* discloses or renders obvious the claimed embodiments. EX2002, ¶96.

F. Claim 5

Sections VI.A-C, above, explain that the selective combination of *Flick885* and *Flick561* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections VI.A-C, dependent Claim 5 is also patentable. EX2002, ¶97.

Petitioner contends that *Flick460*, which “is incorporated by reference in the ‘278 Patent” also discloses the wireless signal downloading interface including a wireless receiver. Petition, 35; emphasis added. Like with the *Flick829* referenced with various claims, it is unclear whether Petitioner is arguing that *Flick460* is prior art and used as a basis for formulating a rejection. Again, there is no formal ground offered for such a combination. For Claim 5, like Claim 4, Petitioner again points to *Flick829* for this claim element. Petition, 35. Ground 1 is based upon the combination of *Flick885* and *Flick561*. Petition, 6. Petitioner fails to establish or

explain that the selective combination of *Flick885* and *Flick561* discloses or renders obvious the claimed embodiments, and the reference to *Flick829* and *Flick460* does not alter the analysis. EX2002, ¶98.

G. Claims 6-12

Sections VI.A-C, above, explain that the selective combination of *Flick885* and *Flick561* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections VI.A-C, dependent Claims 6-12 are also patentable. EX2002, ¶99.

H. Claim 13

Independent Claim 13 recites subject matter similar to Claims 1 and 3. EX2002, ¶100. Sections VI.A-C, above, explain that the selective combination of *Flick885* and *Flick561* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections VI.A-C, dependent Claim 13 is also patentable. EX2002, ¶100.

I. Claims 14-17

Dependent Claims 14-17 recite subject matter similar to dependent Claims 6-9, respectively. EX2002, ¶101. Sections VI.A-C, above, explain that the selective combination of *Flick885* and *Flick561* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections VI.A-C,

dependent Claims 14-17 are also patentable. EX2002, ¶101.

J. Claim 18

Independent Claim 18 recites subject matter similar to Claims 1 and 5. EX2002, ¶102. Sections VI.A-C, above, explain that the selective combination of *Flick885* and *Flick561* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections VI.A-C, dependent Claim 18 is also patentable. EX2002, ¶102.

K. Claims 19-22

Dependent Claims 19-22 recite subject matter similar to dependent Claims 6-9, respectively. EX2002, ¶103. Sections VI.A-C, above, explain that the selective combination of *Flick885* and *Flick561* fails to disclose or render obvious the claimed embodiments. For at least these reasons set forth above in Sections VI.A-C, dependent Claims 19-22 are also patentable. EX2002, ¶103.

VII. GROUND 2: CLAIMS 1, 4-6, 8, 11-12, 18-19, 21 ARE NOT ANTICIPATED BY *LEWIS*

Petitioner turns to *Lewis* to argue anticipation of Claims 1-6, 8, 10-14, 16, 18-19, and 21 of the '278 *Patent*. *Lewis*, much like all the other prior art references that were considered by the many tribunals up to now, is another cumulative reference located by using a word search feature. EX2002, ¶104. Like other art already considered, *Lewis* also fails to disclose all the claim elements. *Lewis*

discloses a real time vehicle performance and position monitoring system. *Lewis*, 0023; EX2002, ¶104 A GPS position receiver collects position data of the vehicle, which along with onboard diagnostic data is wirelessly communicated to off-site computers. *Lewis* at 0024, 0026-27; EX2002, ¶104.

Lewis addresses the problems with large scale deployment of real-time communication of vehicle tracking and monitoring data. *Lewis*, 0010-0013. *Lewis* discloses that certain events require a particular level of performance in terms of real-time monitoring using the internet, for example, roadside emergencies, hazardous material spills, and homeland security operations. *Lewis*, 0013-0014; EX2002, ¶105. *Lewis* uses peer-to-peer communications to address some of these problems and also makes the data available via a remote site via the Internet. *Lewis*, 0042, 0103; EX2002, ¶105. *Lewis* does not address ongoing compatibility with different vehicles and is no better than any other art already considered. EX2002, ¶105.

A. Lewis Fails to Disclose All the Claim Elements

Petitioner argues that disjointed passages of *Lewis* disclose the claimed downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. Petition, 56 (citing paragraphs 0042, 0022, 0093, 0047, 0091, and 0054 of *Lewis*). The cited passages of *Lewis* fail to support the Petitioner's contentions.

EX2002, ¶106. In other words, based upon the PTAB’s construction of the term “enabling data,” *Lewis* does not disclose or suggest a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller, and the PTAB agrees. EX2002, ¶106; Decision 49-50. Petitioner fails to provide an alternative construction that is consistent with the PTAB’s construction herein.

Lewis discloses the system being able to perform “vehicle-to-vehicle (peer-to-peer) communication for relaying any data including vehicle location and performance data...”. *Lewis*, 0042. This relaying is nothing more than a remote downloading operation of the vehicle location and performance data from the vehicle device. EX2002, ¶107. It does not matter whether the data is downloaded to a server, computer, or another vehicle, this is still a remote downloading of this data from the vehicle device. *Id.*

Moreover, from the perspective of any given vehicle device of *Lewis*, the location and performance data can be uploaded somewhere else, including another vehicle. *Lewis*, 0042; EX2002, ¶108. *Lewis* fails to disclose that the same vehicle device that uploads its data is itself capable of downloading this location and performance data from another vehicle device. EX2002, ¶108. And 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. EX2002, ¶109.

Paragraph 0022 of *Lewis* discloses that vehicles may communicate with each other in a peer-to-peer fashion. *Lewis*, 0022; EX2002, ¶110. Again, there is nothing in *Lewis* that discloses or suggests to a POSA that this data is downloaded by *the vehicle device* that collects the position and performance data. *Lewis* discloses that vehicles, and more particularly, busses, are communicating with one another. *Lewis*, 0074 0090; EX2002, ¶110. Even if the vehicle device of *Lewis* can download position and performance data from another vehicle, this is NOT enabling data as recited by the claims. EX2002, ¶111. The PTAB agrees. Decision, 49-50.

The PCMCIA port in paragraph 0093 of *Lewis* cited by Petitioner is simply a laptop interface by which performance and position data can be downloaded to the laptop. *Lewis*, 0093; Petition 56; EX2002, ¶112. This downloading is not by the vehicle device. *Lewis*, 0093; EX2002, ¶112. The data downloaded by the laptop is actually *uploaded* by the *Lewis* vehicle device. EX2002, ¶113. Thus, this too is not a downloading interface for permitting downloading of enabling data as recited by the claims. EX2002, ¶113.

Paragraphs 0047 and 0091, both cited by Petitioner, fail to disclose a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible

controller. EX2002, ¶114. Paragraph 0047, for example, discloses position and performance data being displayed on a graphical user interface (GUI) of a web-based data visualization system. Lewis, 0047; EX2002, ¶115. The GUI is a visual representation of the performance and position data downloaded FROM or OFF of the vehicle device. *Id.* This is not a downloading interface for permitting downloading to the multi-vehicle compatible controller of enabling data for by use by the multi-vehicle compatible controller. *Id.*

Petitioner's cited portion of paragraph 0091 has nothing to do with downloading or uploading. EX2002, ¶116. Instead, this paragraph of *Lewis* discloses video data being broadcast to all linked vehicles, and the receiving vehicles may determine what is downloaded. *Lewis*, 0091; EX2002, ¶116. This is not, whether alone or in combination with Petitioner's other cited portions of *Lewis*, a downloading interface for permitting downloading of enabling data as recited by the claims. *Id.*

Lastly, Petitioner turns to paragraph 0054 of *Lewis*, which discloses the I/O subsystem of the vehicle device including a PC interface (USB/RS232) for on-site debugging. Petition, 57. Petitioner contended that the PC (personal computer) provides the 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.” Petition, 57. Petitioner is providing its own theory of how *Lewis* performs the debugging—one

not disclosed or suggested in *Lewis*. EX2002, ¶117. *Lewis* is silent as to what is debugged or how this debugging is being performed. EX2002, ¶118. For example, debugging may include repositioning a GPS antenna for a better view of the satellites based upon data downloaded from the vehicle device to the PC or ensuring the connection between the GPS device and serial port is correct. EX2002, ¶118; *Lewis*, 0095. Debugging may include setting the proper protocol. EX2002, ¶118; *Lewis*, 0098. Debugging may include understanding why data may not be available to the remote site via the Internet. EX2002, ¶118; *Lewis*, 0103. Debugging may be performed simply by reviewing data downloaded from a vehicle device to the PC. EX2002, ¶118. Debugging does not necessarily involve changing the programming of the vehicle device or downloading data from the PC to the vehicle device. *Id.* Why should a POSA be left to guess how *Lewis* achieves this debugging?

There can be no anticipation where the POSA must guess how to arrange the disjointed elements and fill gaps to arrive at the claimed invention. *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008), citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983); *See also In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Because the hallmark of anticipation is prior invention, the prior art reference--in order to anticipate under 35 U.S.C. §102--must disclose all elements of the claim within the four corners of the document arranged as in the claim. *Net MoneyIN*, at 1369. The disclosure in an

assertedly anticipating reference must also provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient if it cannot be produced without undue experimentation. See MPEP §2121.01 citing *Elan Pharms., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003), emphasis added. There is nothing in *Lewis* that would teach or suggest to a POSA how to morph debugging using a PC interface into a downloading interface for downloading of enabling data as recited by the claims. EX2002, ¶119; ‘278 Patent, 26:12-15. Petitioner’s anticipation argument must be rejected.

B. Claim 2

Petitioner generically argues the claimed downloading of *enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller* is disclosed in *Lewis*. Petition, 57. As argued above, a wired signal downloading interface is missing from *Lewis*. EX2002, ¶120. The various input-output interconnections of the *Lewis* vehicle device have nothing to do with enabling data. *Id.* *Lewis* cannot disclose a wired downloading interface as claimed in the ‘278 Patent because it does not disclose a downloading interface for permitting downloading of enabling data as recited by the claims. *Id.*

For these reasons, and the reasons set forth above in Section VII.A that *Lewis* failing to disclose or suggest the claimed embodiments, dependent Claim 2 is also

patentable. EX2002, ¶121.

C. Claim 3

Section VII.A, above, explains that *Lewis* fails to disclose or suggest the claimed embodiments. For at least these reasons set forth above in Section VII.A, dependent Claim 3 is also patentable. EX2002, ¶122.

D. Claim 4

Petitioner leaps to yet another disjointed portion of *Lewis* to argue for a wireless signal downloading interface. Petition, 58; '278 Patent, 26:23-25. Petitioner cites paragraph 0022 of *Lewis*, which discloses vehicles wirelessly communicating with each other or with servers. *Lewis*, 0022. For at least the reasons set forth above in Section, VII.A, *Lewis* also fails to disclose a wireless signal downloading interface for permitting downloading of enabling data as recited by the claims. EX2002, ¶123. A POSA would further understand the wireless communication to the servers and other vehicles is for the communication of position and performance data so that it can be displayed on a remote web site. EX2002, ¶124; *Lewis*, 0103. This communication has nothing to do with enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. *Id.*

For these reasons, and the reasons set forth above in Sections VII.A that *Lewis* failing to disclose or suggest the claimed embodiments, dependent Claim 4 is also

patentable. EX2002, ¶125.

E. Claim 5

Section VII.A, above, explains that *Lewis* fails to disclose or suggest the claimed embodiments. Moreover, any temporary connection, such as the PC interface (USB/RS232), is wired. EX2002, ¶126; *Lewis*, 0054. For at least these reasons and those set forth above in Section VII.A, dependent Claim 5 is also patentable. EX2002, ¶126.

F. Claim 6

Section VII.A, above, explains that *Lewis* fails to disclose or suggest the claimed embodiments. For at least these reasons set forth above in Section VII.A, dependent Claim 6 is also patentable. EX2002, ¶127.

G. Claim 8

Lewis fails to disclose a downloading interface that permits downloading of at least one programming instruction for the multi-vehicle compatible controller. Petitioner regurgitates its “debugging” PC interface. Petition, 60-61. There is nothing in *Lewis* that discloses or suggests that debugging involves permitting downloading (from the PC to the vehicle device) of a programming instruction for the vehicle device. EX2002, ¶128.

For at least these reasons and those set forth above Section VII.A, above, which explain that *Lewis* fails to disclose or suggest the claimed embodiments,

dependent Claim 8 is also patentable. EX2002, ¶129.

H. Claims 10-12

Section VII.A, above, explains that *Lewis* fails to disclose or suggest the claimed embodiments. For at least these reasons set forth above in Section VII.A, dependent Claims 10-12 are also patentable. EX2002, ¶130.

I. Claim 13

Independent Claim 13 is similar to independent Claim 1 and dependent Claim 3. Sections VII.A and VII.C, above, explain that *Lewis* fails to disclose or suggest the claimed embodiments. For at least these reasons set forth above in Section VII.A and VII.C, independent Claim 13 is also patentable. EX2002, ¶131.

J. Claims 14 and 16

Dependent Claims 14 and 16 are similar to dependent Claims 6 and 8, respectively. Sections VII.A and VII.F-G, above, explain that *Lewis* fails to disclose or suggest the claimed embodiments. For at least these reasons set forth above in Section VII.A and VII.F-G, dependent Claims 14 and 16 are also patentable. EX2002, ¶132.

K. Claim 18

Independent Claim 18 is similar to independent Claim 1 and dependent Claim 5. Sections VII.A and VII.E, above, explain that *Lewis* fails to disclose or suggest the claimed embodiments. For at least these reasons set forth above in Section VII.A

and VII.E, independent Claim 18 is also patentable. EX2002, ¶133.

L. Claims 19 and 21

Dependent Claims 19 and 21 are similar to dependent Claims 6 and 8, respectively. Sections VII.A and VII.F-G, above, explains that *Lewis* fails to disclose or suggest the claimed embodiments. For at least these reasons set forth above in Section VII.A and VII.F-G, dependent Claims 19 and 21 are also patentable. EX2002, ¶134.

VIII. GROUND 3⁷: *LEWIS* AND *UNDERDAHL* DO NOT RENDER OBVIOUS CLAIMS 7, 9, 15, 17, 20, AND 22

A. Claims 7, 15, 20

Petitioner turns to *Underdahl* as allegedly disclosing the pieces unquestionably missing from *Lewis*, but this combination fails as well. Petitioner argues that a POSA would turn to *Underdahl* for the claimed vehicle device code for writing to at least one vehicle device because they both “relate to” “fleet management and tracking vehicle diagnostics and location information using a multi-vehicle compatible tracking unit.” Petition 59-60. This is nothing more than an unsupported conclusion. EX2002, ¶135.

While references that are directed to the same field of endeavor or have common subject matter may be combinable, this does not automatically mean that

⁷ The Petition refers to Ground 3 as Ground 2a. Petition 6.

a POSA would have been motivated to combine the references in the way specifically claimed. EX2002, ¶136. “[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Personal Web Tech.* at 848 F.3d at 994, citing *InTouch Techs.* 751 F.3d at 1352. Petitioner offers no technical explanation for why a POSA would have combined *Lewis* and *Underdahl* as contended. EX2002, ¶136. This lack of a technical rationale is a conclusion based upon hindsight. *Id.* For these reasons, and the reasons set forth Supra in Section VII.A, which explains that *Lewis* fails to disclose or suggest the claimed embodiments, a combination with *Underdahl* is also improper, and dependent Claims 7, 15, and 20 are patentable.

B. Claims 9, 17, 22

Sections VII.A, above, explains that *Lewis* fails to disclose or suggest the claimed embodiments. Section VIII.A, above, explains that a further combination with *Underdahl* does not supply the deficiencies of *Lewis* and is improper. For at least these reasons set forth above in Sections VII.A and VIII.A, dependent Claims 9, 17, and 22 are also patentable. EX2002, ¶137.

C. Petitioners’ Proposed Combinations Ignore Compelling Evidence of Secondary Considerations

As noted in Section VI.B.2 above, Patent Owner has presented compelling evidence of secondary considerations, most of which has been considered and

confirmed multiple times by the PTAB. The same evidence of secondary considerations applies equally to the combination in Ground 3. When evidence of secondary considerations is considered as addressed in significant detail above, the claims of the '278 *Patent* are not obvious in view of *Lewis* and *Underdahl*. EX2002, ¶138.

XI. CONCLUSION

The Petition is deficient in multiple respects, some of which were recognized in the Institution Decision. The prior art relied upon in the Petition fails to disclose the claimed embodiments when combined by a POSA. Moreover, a POSA would not have combined the prior art in the Petition and would not have done so for the reasons set forth in the Petition. Equally important is the consideration evidence of secondary considerations, much of which has been relied upon by juries and the PTAB in confirming the validity of the '278 *Patent*. The Petition offered nothing to substantively challenge the evidence of secondary considerations, coextensiveness of the claims to the infringing CalAmp products, or the nexus of the evidence to the claims. The Petition fails to carry its burden or establish any of the challenged claims are invalid.

Therefore, Patent Owner respectfully submits that the claims be confirmed as valid.

Dated: May 15, 2024

Respectfully submitted,

/s/ Ryan T. Santurri

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CERTIFICATION UNDER 37 C.F.R. §42.24(d)

Pursuant to 37 C.F.R. §42.24(a)(1)(i), the undersigned hereby certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE contains 13,898 words, excluding the parts of this Response that are exempted under 37 C.F.R. §42.24(a), as measured by the word-processing system used to prepare this paper.

/s/ Ryan T. Santurri

Ryan T. Santurri, Lead Counsel
Reg No. 61,894

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Patent Owner's Response, and Exhibits 2035 through 2045, are being served on May 15, 2024, by electronic mail at the following email addresses of record for the Petitioners:

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Dated: May 15, 2024

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