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Kenneth E. FLICK
Reexamination Control No. 90/013,851
Filed: OCTOBER 29, 2016

admitted materials, and is therefore not defective. Also, for clarity, the Patent Owner notes that there are two Declarations by Michael Suman. The first Declaration, as noted in the Evidence Appendix, was properly admitted with the response filed September 18, 2017. The second Declaration was refused, albeit improperly, admission by the Examiner, and was not included in the Evidence Appendix. The section of the first Appeal Brief noted in the Notice relates to arguments on the improper refusal to admit several exhibits, including the second Declaration of Michael Suman. Since these evidentiary items were not admitted, none of them are included in the Evidence Appendix, nor attached to the first Appeal Brief. The Patent Owner submits that the Notice is improper and submits that this Supplemental Appeal Brief overcomes the Notice.

To the extent the Paralegal and Supervisory Paralegal are contending that the mere mention of non-admitted evidence qualifies for a defective Evidence, the Patent Owner submits that that such a reading of the USPTO rules would run afoul of Rule 41.37(c)(2), which states: "[a] brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence." The rule does not preclude any utterance, or citation to non-admitted evidence, but rather the inclusion within the Evidence Appendix.

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(1) Real Party in Interest

The real party in interest is OMEGA PATENTS, L.L.C., assignee of the present application as recorded at reel 019515, frame 0350.

(2) Related Appeals, Interferences, and Trials

At present there are no related appeals, or interferences. There are two related trials.

I. First Trial

In the first trial, the '278 patent was subject to a litigation between the Requester and the Patent Owner. The Patent Owner filed its complaint alleging patent infringement against the Requester on December 20, 2013. After extensive discovery, including discovery from the trial experts, the trial commenced on February 16, 2016 and concluded on February 24, 2016. The jury found that all of asserted claims from all four of the asserted patents were infringed, and, as particularly relevant in this reexamination, that all of the asserted claims were not invalid -- rejecting Requester's invalidity contentions (See Jury Verdict, Evidence Appendix Item 1).

In an order dated November 14, 2017, the Court denied Requester's Renewed Motion for Judgment as a Matter of Law and Motion for New Trial, and denied Requester's Supplemental Renewed Motion for Judgment as a Matter of Law, for a New Trial, and to Vacate the Judgment. (See Order, Evidence Appendix Item 2).

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Of particular interest in the present reexamination, the Court provided the following judicial findings regarding Secondary Considerations:

"[t]he jury found three secondary considerations of nonobviousness – commercial success, copying, and licensing by others. Dkt. 144 at 9" (Doc. 216, p. 15). While this precise argument was not presented at either JMOL hearing, it is sufficiently tied to the issue of obviousness to warrant further examination. CalAmp [Requester] contends Omega failed to sufficiently demonstrate a nexus between the claimed invention and the secondary considerations. (Id.).

Plaintiff, in its response to this assertion, summarizes ample evidence presented at trial which rebuts CalAmp's claim that the secondary considerations are unsupported. (Doc. 226, pp. 10-11). Plaintiff observes that Defendant's [Requester] corporate representative and employees testified that the infringing products (and DEI's product) were "commercially successful due to the merits of Omega's invention." (Id. at p. 10). Witnesses testified that features on the infringing CalAmp products were requested by customers. (Id.). Additionally, Mr. Flick sold devices with the patented features, generating sales revenue of \$33 million annually. (Id.). Moreover, the jury heard testimony that Mr. Flick, via his company, issued dozens of licenses to the patents-in-suit and entered into settlement agreements with infringers. (Id.). Finally, Omega presented evidence that CalAmp knew of Omega's patents and discussed the difficulty of designing around the patents. (Id. At p. 11). This testimony was sufficient for an objectively reasonable jury to find the secondary considerations.

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(Pages 12-13, Emphasis added).

II. Second Trial

In the second trial, the Patent Owner filed a new patent infringement lawsuit on July 21, 2017 against Enfora, Inc. in the Northern District of Georgia, Atlanta Division (Case 1:17-cv-02769-TWT). The asserted patents in this Enfora suit include the '278 patent, which is the subject of this second reexamination by Requester.

(3) Related Reexaminations

The Requester filed a first reexamination (90/013,587) of the '278 patent on September 14, 2015, just prior to the scheduled start of trial, which was postponed. In that first reexamination, Requester initially presented invalidity positions based on: (1) U.S. Patent No. 6,028,537 (Suman et al.) alone; (2) U.S. Patent No. 5,732,074 (Spaur et al.) alone; and (3) Spaur et al. in combination with various secondary references. Requester added additional invalidity positions based on: (1) U.S. Patent No. 6,009,363 (Beckert et al.) alone; (2) U.S. Patent No. 7,484,008 (Gelvin et al.) alone; and Published Application 2001/0033225 (Razavi et al.) alone.

All of these invalidity positions of Requester were carefully considered and overcome as the Patent Office issued a Notice of Intent to Issue a Reexam Certificate on December 1, 2016, and issued a Reexamination Certificate on December 28,

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2016.

The second reexamination request was filed after the Patent Owner's response in the first reexamination, and before the decision of the Patent Office to confirm patentability of the claims. The second request included attacks on the Patent Owner's response. In other words, the second reexamination request was an improper attempt to convert an ex parte reexamination into an inter partes review (IPR).

This second reexamination request asserted invalidity positions based upon the same recycled Beckert et al., Spaur et al., and Suman et al. patents - sometimes in combination with an SAE document compendium, SAE HS-3000 which includes the SAE J1978 reference asserted at trial. The SAE HS-3000 is titled "SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual" (1994 Edition). Beckert et al. was asserted alone, and in combination with SAE HS-3000. Suman et al. was asserted alone, and in combination with SAE HS-3000. Spaur et al. was asserted in combination with SAE HS-3000.

Requester did add a new "old art" reference, U.S. Patent No. 6,330,499 (Chou et al.), to the request leading to this second reexamination. Despite the Requester's arguments to the contrary, Chou et al. is not a new reference. Indeed, Chou et al. was considered in the original prosecution of the '278 patent as correctly noted by the Examiner on page 41 of the Reexam Order Determination dated December 15, 2016.

Chou et al. is cited in the '278 parent patent, U.S.

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Patent No. 7,720,597 (Flick); grandparent patent, U.S. Patent No. 7,149,623 (Flick); and great-grandparent, U.S. Patent No. 6,606,561 (Flick). The MPEP provides that in continuation applications "[t]he examiner will consider information which has been considered by the Office in a parent application ... A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent." (MPEP §609.02II.A.2).

The Requester filed numerous reexamination requests against the three other patents of the Patent Owner found to be willfully infringed by the Court in the related Requester litigation. This is the list of the all prior and current reexaminations by the Requester:

- (1) U.S. Patent No. 8,032,278; Reexamination 90/013,587 - filed September 14, 2015. **Ex Parte Reexamination Certificate issued December 28, 2016.**
- (2) U.S. Patent No. 8,032,278; Reexamination 90/013,851 - filed October 29, 2016. [PRESENT REEXAMINATION]
- (3) U.S. Patent No. 6,756,885; Reexamination 90/013,741 - filed April 28, 2016. **Ex Parte Reexamination Certificate issued August 1, 2017.**

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- (4) U.S. Patent No. 6,756,885; Reexamination
90/014,038 - filed October 26, 2017. **Order**
Granting Reexamination issued December 27, 2017.
- (5) U.S. Patent No. 6,346,876; Reexamination
90/013,659 - filed December 11, 2015. **Ex Parte**
Reexamination Certificate issued September 1,
2017.
- (6) U.S. Patent No. 7,671,727; Reexamination
90/013,832 - filed October 12, 2016. **Ex Parte**
Reexamination Certificate issued August 1, 2017.

(4) Summary of the Claimed Subject Matter

Independent Claim 1 is directed to a multi-vehicle compatible tracking unit 110 for a vehicle comprising a vehicle data bus 122 extending throughout the vehicle. The multi-vehicle compatible tracking unit comprises a vehicle position determining device 112, a wireless communications device 113, and a multi-vehicle compatible controller 111 for cooperating with the vehicle position determining device and the wireless communications device to send vehicle position information. The multi-vehicle compatible controller is to be coupled to the vehicle data bus for communication thereover with at least one vehicle device 121 using at least one corresponding vehicle device code from among a plurality thereof for different

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vehicles. The multi-vehicle compatible tracking unit comprises a downloading interface 116 for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. (Figures 10-13, reproduced below, and Page 27, Col. 23, line 41 through Page 28, Col. 25, line 61).

Independent Claim 13 is directed to a multi-vehicle compatible tracking unit 110 for a vehicle comprising a vehicle data bus 122 extending throughout the vehicle. The multi-vehicle compatible vehicle tracking unit comprises a vehicle position determining device 112, a wireless communications device 113, and a multi-vehicle compatible controller 111 for cooperating with the vehicle position determining device and the wireless communications device to send vehicle position information. The multi-vehicle compatible controller is to be coupled to the vehicle data bus for communication thereover with at least one vehicle device 121 using at least one corresponding vehicle device code from among a plurality thereof for different vehicles. The multi-vehicle compatible vehicle tracking unit comprises a downloading interface 116 for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. The downloading interface comprises a connector 133a-133b for temporary connection to a downloading device 115''. (Figures 10 & 13, reproduced below, and Page 27, Col. 23, line 41 through Page 28, Col. 25, line 61).

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Independent Claim 18 is directed to a multi-vehicle compatible tracking unit 110 for a vehicle comprising a vehicle data bus 122 extending throughout the vehicle. The multi-vehicle compatible vehicle tracking unit includes a vehicle position determining device 112, a wireless communications device 113, and a multi-vehicle compatible controller 111 for cooperating with the vehicle position determining device and the wireless communications device to send vehicle position information. The multi-vehicle compatible controller is to be coupled to the vehicle data bus for communication thereover with at least one vehicle device 121 using at least one corresponding vehicle device code from among a plurality thereof for different vehicles. The multi-vehicle compatible vehicle tracking unit includes a downloading interface 116 for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. The downloading interface comprises a wireless receiver 114 for temporary connection to a downloading device 115. (Figures 10-11, reproduced below, and Page 27, Col. 23, line 41 through Page 28, Col. 25, line 61).

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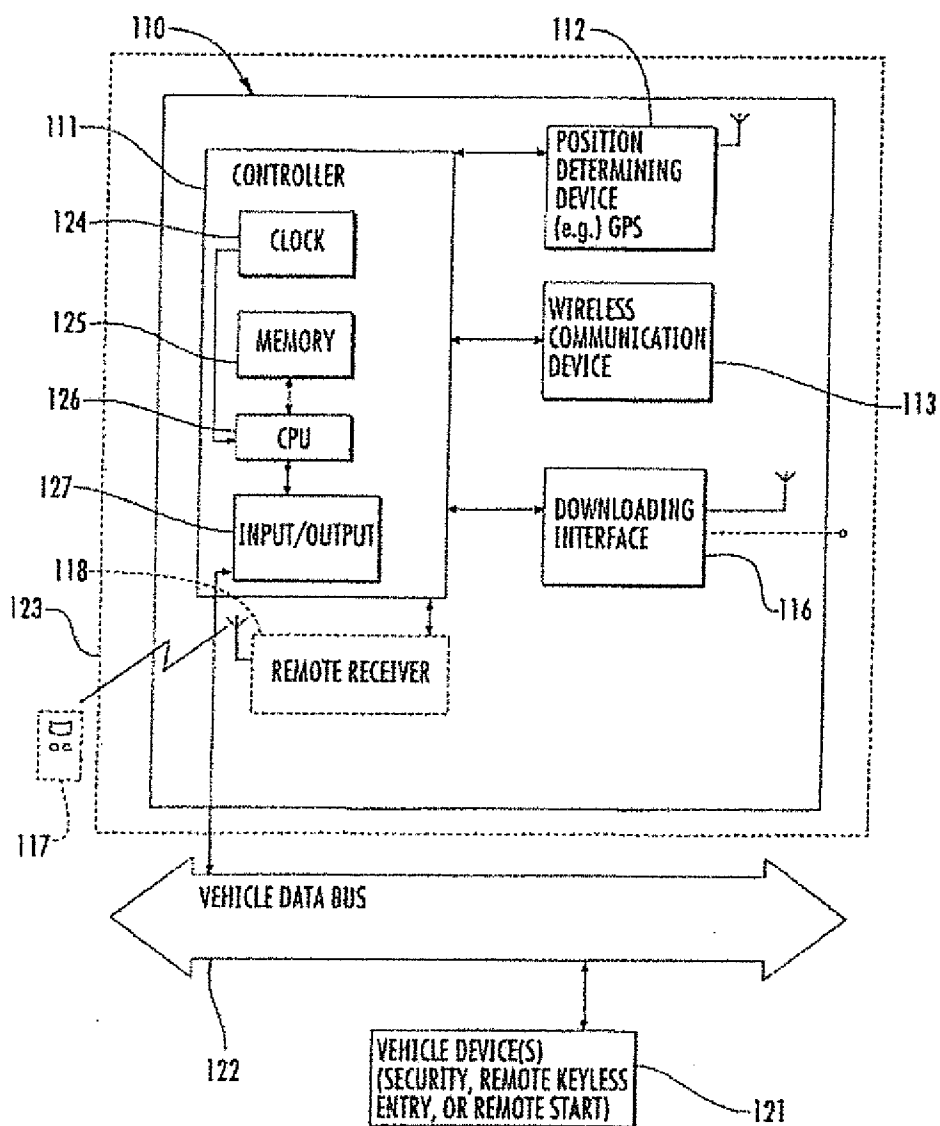


Figure 10 of the '278 Patent

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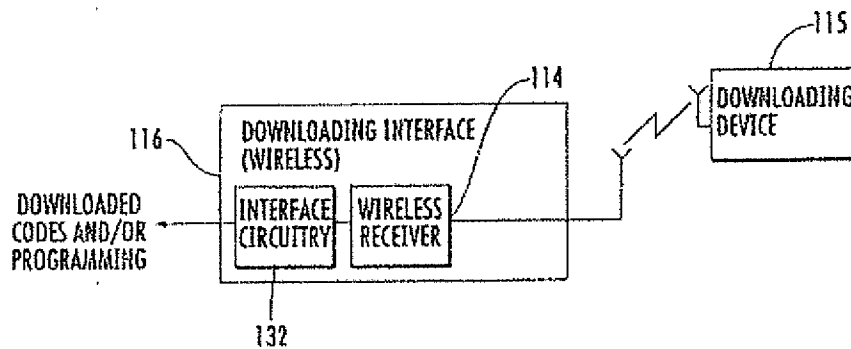


Figure 11 of the '278 Patent

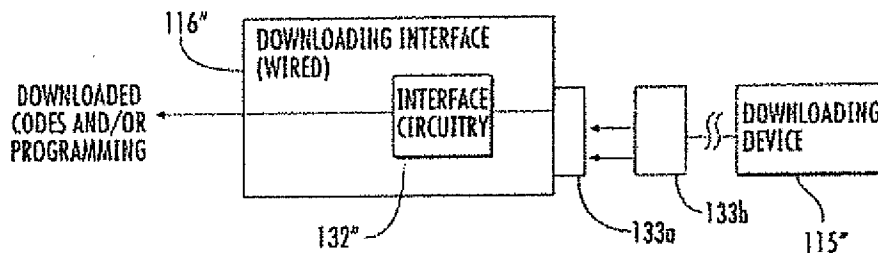


Figure 13 of the '278 Patent

(5) Evidence Improperly Refused Admission Into the Record

The Patent Owner submits that the exhibits attached to the Response to the Final Office Action, filed September 18, 2017 should have been properly admitted to the record.

The Patent Owner respectfully submits that the existing record demonstrates a showing under 37 C.F.R. §1.116(e), which recites: "[a]n affidavit or other evidence submitted after a

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final rejection or other final action (§1.113) in an application or in an ex parte reexamination filed under § 1.510, ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented."

With regards to prior Exhibit 4 filed September 18, 2017 (i.e. the new Rule 132 Declaration of Michael Suman), the Patent Owner firstly submits that this Rule 132 Declaration addresses the claim interpretation position taken by the Examiner in the Final Office Action dated June 19, 2017. Secondly, this Rule 132 Declaration supplements the nexus between the evidence of secondary considerations of non-obviousness and the claimed invention to address the Examiner's comments on prior declaratory evidence at Pages 9-10 of the Final Office Action. Because this declaration was submitted to address concerns noted by the Examiner in the Final Office Action, it could not be presented earlier, and it is necessary since it touches on the skilled person's interpretation of the claims and the nexus between the claimed invention and evidence for secondary considerations for non-obviousness. Accordingly, Exhibit 4 filed September 18, 2017 should be admitted and properly considered.

With regards to Exhibits 5-9 filed September 18, 2017 (i.e. respectively the Trial Transcript from related litigation with the Requester, the Requester Exhibit List from related litigation, the Patent Owner Exhibit List from related litigation, the Court Exhibit List from related litigation, and

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the Jury Instructions from related litigation), these exhibits were submitted to address comments and suggestions noted by the Examiner in the Final Office Action.

In particular, in the Final Office Action at page 10, the Examiner stated:

PO asserts litigation evidence (testimony/trial transcript, exhibits, instructions, see, e.g., page 26, first full paragraph, page 26, second to last line-page 27, line 12, page 28, line 4-page 30, last line, section 3 on page 31 and the testimony excerpts bridging pages 32-37) for the conclusions regarding the secondary considerations. However such referenced testimony/trial transcript, exhibits, instructions are not of record, e.g. jury instructions, or only partially of record, e.g. excerpts of testimony of trial transcript, as best understood. Finally PO asserts the declaration for the conclusions regarding the secondary considerations. However see the discussion of the declaration infra. Note also the evidence of record is silent with regard to the Chou '499 reference.
(Emphasis added).

The Patent Owner submits that these exhibits were introduced at the suggestion of the Examiner's helpful comments in the Final Office Action, and therefore could not have been presented earlier. Moreover, since the Examiner comments were made within the context of considering prior filed evidence of secondary considerations for non-obviousness, the new exhibits

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are necessary and should have been admitted and properly considered.

(6) Argument

As will be described in greater detail below, the Patent Owner respectfully submits that the Examiner erred in the rejections under §102 and §103 and over Chou et al. Chou et al. is not a long and complicated reference, and the Patent Owner submits it fails to render the claimed invention unpatentable. Chou et al. includes five drawing figures -- three of which are essentially the same -- and about eight columns of description.

Indeed, as a prior art reference cited in the prosecution history of the '278 patent, Chou et al. was known by Requester since at least the beginning of the related lawsuit in December of 2013. Having been known and given little value by all concerned in the related litigation with Requester and prior Patent Office proceedings, only now, in a second reexamination proceeding from the same Requester, has the well-known Chou et al. reference gained any traction at all for the Requester.

The Patent Owner respectfully submits that Chou et al. fails to disclose or fairly suggest the claimed multi-vehicle compatible controller and downloading interface in the vehicle tracking unit. Instead, data from the ECUs on the vehicle bus is merely passed from the in-vehicle system to the remote service center of Chou et al. And, in the reverse direction, data is passed to the in-vehicle system in Chou et al. There is no

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discussion in Chou et al. of downloading enabling data related to at least device code for use by the multi-vehicle controller in the vehicle. Detailed arguments supporting the patentability of the claimed invention follow.

I. The §102/§103 Rejections Over Chou et al. Should Be Overturned
A. The Teachings of Chou et al.

Figure 1 from Chou et al. is reproduced below for convenience.

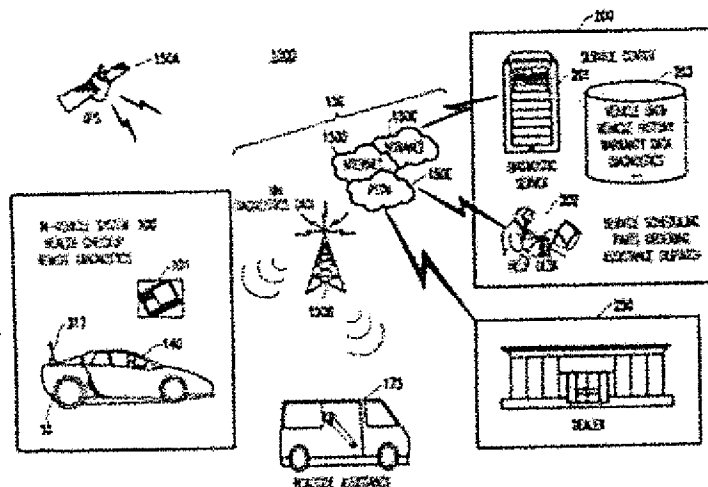


Figure 1 of Chou et al. Patent

The Chou et al. system includes a vehicle 10 having an in-vehicle computing system 100, and a client computer device 101 to enable vehicle health checkup and remote diagnostics. A communication link 150 is for communicating vehicle information (e.g., vehicle identification number, (VIN), diagnostic data, and

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the like). The vehicle location is established, for example, by a device 317 (e.g., antenna or the like) for receiving positioning information. A remote service center 200 is also provided having a diagnostic server 201, a help desk 202 and a data repository 203. The help desk 202 schedules services, orders parts, and dispatches assistance through the roadside assistance unit 175. The remote service center 200 of Figure 3 comprises a diagnostic server 201 that has access to data related to the vehicle such as as-built, history, diagnostics, warranty, service information and failure mode data. The diagnosis server 201 is linked to the data repository 203.

The Patent Owner submits that Chou et al. fails to disclose the claimed vehicle tracking unit including the multi-vehicle compatible controller and the downloading interface, as these terms are properly construed.

B. The Deficiencies of Chou et al.

1. Chou et al. is Merely Cumulative of Suman et al.

Chou et al. discloses a remote diagnostic system including a data bus interface, a GPS module, an RF transceiver, and a processor at the vehicle that communicates with a remote service center. The Suman et al. '537 patent, cited as an anticipation reference and overcome in the first reexamination, includes the same elements (see FIGS. 1a and 5, reproduced below, and col. 15, lines 52-63, for example).

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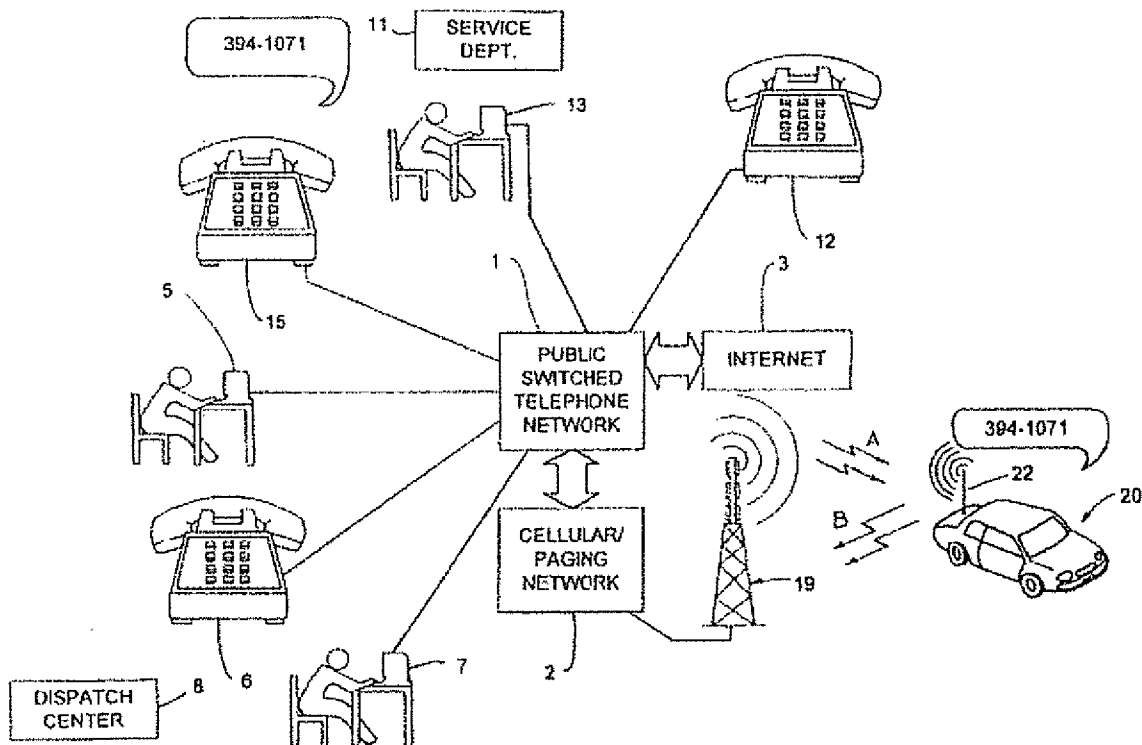


Figure 1a of Suman et al. '537 Patent

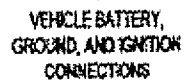


Figure 5 of Suman et al. '537 Patent

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As noted above, the Examiner's statement of reasons for patentability in the first reexamination was: "the Examiner agrees that the declarations by Suman and McAlexander provide sufficient evidence that Suman and Spaur each fail to disclose the multi-vehicle compatible controller as recited in independent claims 1, 13 and 18." (Notice of Intent to Issue a Reexamination Certificate, 12/01/2016, page 2, Evidence Appendix Item 9).

Chou et al., just like Suman et al., and as explained in greater detail below, fails to disclose a multi-vehicle compatible controller and downloading interface that permits downloading of enabling data for use by the multi-vehicle compatible controller. These deficiencies of Chou et al. are discussed in greater detail below.

2. Chou et al. Fails to Disclose the Multi-Vehicle Compatible Controller

Independent Claim 1, for example, recites a multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles.

Chou et al. provides the following description of the vehicle bus interface, as is pertinent to the different device codes for different vehicles:

[t]he vehicle bus interface 120 includes the following modules: vehicle bus adapter 120C, fault detector 120B, and diagnostic data service 120A.

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The fault detector 120B polls the vehicle bus 104 through the vehicle bus adapter 120C checking for fault codes reported by the vehicle ECUs 103. The vehicle bus adapter 120C translates the messages received from the vehicle bus into the language of the fault detector. It also translates messages from the fault detector into the language of the vehicle bus. The fault code specifications and protocols of the vehicle may be Original Equipment Manufacturer (OEM) and model dependent. The term "vehicle fault codes" is meant to be synonymous with the term "trouble code" or "diagnostic trouble code". A listing of such codes may be found in the publication of the Society of Automotive Engineers, "SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual". The diagnostic data service 120A accepts request for vehicle parametric data and retrieves the data using the vehicle bus adapter.

(Col. 4, lines 20-38; emphasis added).

The Examiner, on pages 35-36 of the Final Office Action, contended that "Chou either implicitly discloses or obviously suggests a 'multi-vehicle compatible controller' and such controller is coupled to a vehicle data bus, e.g. 335, 104, for communication thereover, e.g. via 330, 120, with at least one vehicle device, e.g. 103, using at least one corresponding vehicle device code, i.e. (DTC), vehicle fault codes/protocols, which is vehicle model dependent, i.e. from among a plurality thereof for 'different vehicles'".

The referenced SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual, i.e. the SAE HS-3000, provides that: "[c]urrently there is no uniformity in these

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numeric Diagnostic Trouble Codes (DTC) between manufacturers, and in some cases, even within the same manufacturer across different product lines." (SAE HS-3000, 1997, page 39).

Indeed, the lack of vehicle code compatibility among different vehicles for vehicle tracking units is the problem addressed by the claimed invention of the '278 patent. The inventor, Mr. Flick, recognized that having many different model vehicle tracking units for many different vehicles with different codes presented significant inventory control and product development challenges, particularly in the aftermarket vehicle tracking unit area.

3. Chou et al. Fails to Disclose the Downloading Interface

Independent Claim 1, for example, further recites that the vehicle tracking unit comprises "a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller". Accordingly, the combination of the multi-vehicle controller and downloading interface reduces the need for expansive inventory and simplifies supplying vehicle tracking units for new vehicles.

The Examiner has interpreted the downloading interface of the claimed vehicle tracking unit as structure "for permitting downloading of enabling data related to the at least one corresponding vehicle device code, e.g. vehicle device code or codes, an instruction to select a code or codes from among those

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already stored, or the data or sequence to allow the controller to generate the vehicle device code or codes, for use by said multi-vehicle compatible controller.” (Final Office Action, page 18; emphasis added).

The Examiner, on page 36 of the Final Office Action, contended that Chou et al. discloses the claimed downloading interface as follows:

interface circuitry, e.g. NETWORK INTERFACE, 320, 107, docking facility, and a temporary wireless communication link, e.g. arrow 7, 14, arrow 3, 9, with the downloading device, i.e. TCP/IP(an internet/the Internet), 201, provided by sharing the wireless communications device, e.g. 102, that sends position data, see, e.g. col. 7, lines 32-40, (see also discussion of claims 2-5) and such structure permits downloading of enabling data, e.g. instruction to gather data, vehicle parameter update/change, related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller, e.g. steps 2-6 in Figure 5.

Figure 5, which illustrates a health checkup event operation flow, is reproduced below for convenience.

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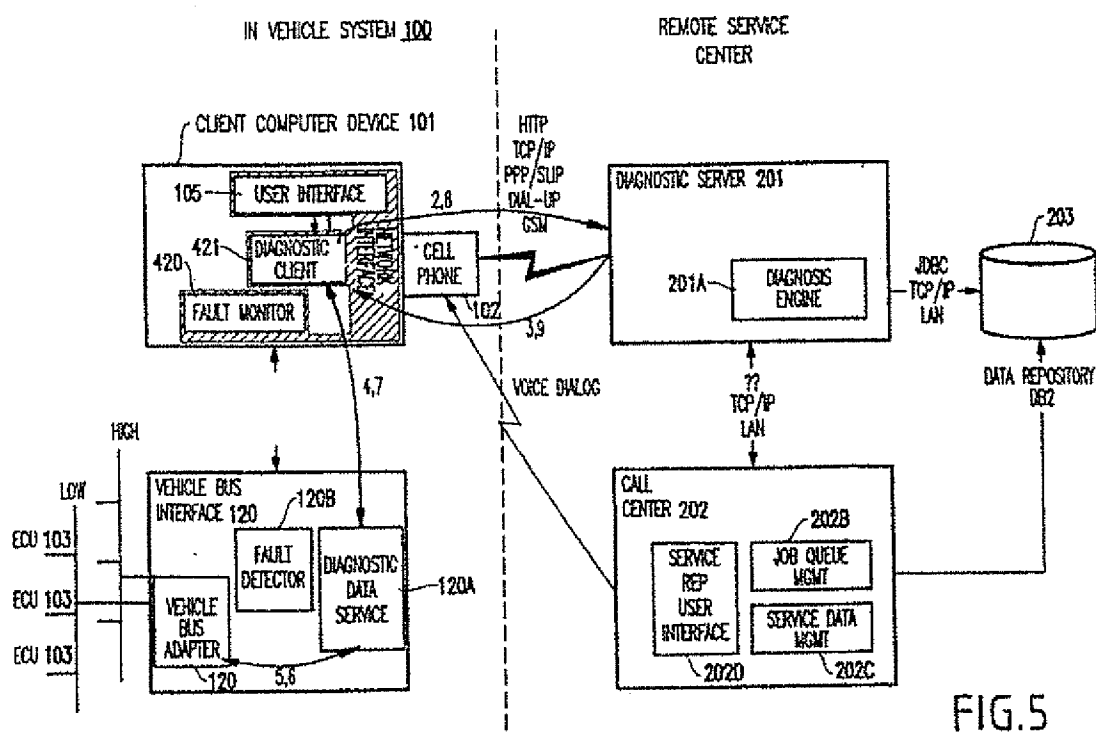


Figure 5 of Chou et al. Patent

Based upon Figure 5 and these cited portions of Chou et al., the Examiner contended that: "[t]hus '499 discloses or obviously suggests 'a downloading interface' and such permits downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller." (*Id.* at 36-37).

The Patent Owner respectfully submits that Chou et al. fails to disclose or obviously suggest the claimed multi-vehicle compatible controller and downloading interface in the vehicle

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tracking unit. Instead, data from the ECUs on the vehicle bus is merely passed from the in-vehicle system to the remote service center of Chou et al. And, in the reverse direction, data is passed to the in-vehicle system in Chou et al. There is no discussion in Chou et al. of downloading enabling data related to at least device code for use by the multi-vehicle controller in the vehicle.

4. Comments on Specific Cited Portions of Chou et al.

The Examiner expressed on page 8 of the Final Office Action that the Patent Owner did not "discuss the entirety of the rejection, i.e. all the cited portions of Chou, e.g. col. 9, lines 35-45, col. 4, lines 15-38, col. 10, lines 1-11, with regard to the corresponding structure and function/capability of the functional phase [downloading interface clause]". To more clearly address these cited portions, the Patent Owner offers the following:

a. Comments on Chou et al. col. 9, lines 35-45

This cited portion of Chou et al. is reproduced below:

[t]hen in step 2, the diagnostic client 421 initiates a health checkup session with the diagnostic server 201, and in step 3, the diagnostic server instructs the diagnostic client to gather vehicle data, such as VIN, malfunction codes, and/or a snapshot of the vehicle data.

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Then in step 4, the diagnostic client 421 requests the data from the diagnostic data service 120A at the vehicle bus interface 120. Then, in step 5, the diagnostic data service interrogates the ECUs 103 via the vehicle bus adapter 120C for the requested data.

The Patent Owner respectfully notes that this language is with reference to Figure 5 and merely states that the driver can trigger a request for the health checkup of the vehicle. And the driver can do so by pressing a "checkup" button which causes the client computer device in the vehicle to contact the diagnostic server at the remote service center. The diagnostic server at the remote service center reads the vehicle data from the client computer. The vehicle data can include malfunction codes from vehicle ECUs. These malfunction codes are often different for different vehicles.

The diagnostic server at the remote service center also includes the data repository 203 (Figure 1). Chou et al. discloses with respect to such a health checkup that:

[t]he vehicle client 101 combines vehicle ID information with the information from the vehicle bus interface 120 and sends the data to the Diagnostic Server 201 over a data link. The data link is kept open. The diagnostics server 201 retrieves vehicle information from the data repository 203 and compares the data from the vehicle with the repository data. Then, the diagnostic server 201 prepares a report listing any out-of-range parameters and actions required (e.g., "coolant level is low"). Trend analysis on the parameters may also be performed, based on the present and historical data collected from the

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vehicle, to detect any drifting of the performance characteristics and to provide early guidance for preventive maintenance (e.g., "change oil in 1500 miles"). (Col., lines 9-21).

Accordingly, the Patent Owner respectfully submits that there is no enabling data downloaded via a downloading interface for use by a multi-vehicle compatible controller for communication by a vehicle device using at least one corresponding code from among a plurality thereof for different vehicles. Instead, this cited portion of Chou et al. merely discloses obtaining diagnostic data at a remote service center from a vehicle. The Patent Owner also respectfully notes that this is cumulative with the teachings of Suman et al., an asserted anticipatory reference overcome in the first reexamination, as discussed above.

b. Comments on Chou et al. col. 4, lines 15-38

This cited portion of Chou et al. is reproduced below:

[t]he vehicle bus interface 120 is responsible for replying to requests for parametric data. It is also responsible for continuously monitoring the vehicle bus 104 for any fault reported by the ECUs 103, in terms of diagnostic trouble codes (DTCs).

The vehicle bus interface 120 includes the following modules: vehicle bus adapter 120C, fault detector 120B, and diagnostic data service 120A. The fault detector 120B polls the vehicle bus 104 through the vehicle bus adapter 120C checking for fault codes reported by the vehicle ECUs 103. The

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vehicle bus adapter 120C translates the messages received from the vehicle bus into the language of the fault detector. It also translates messages from the fault detector into the language of the vehicle bus. The fault code specifications and protocols of the vehicle may be Original Equipment Manufacturer (OEM) and model dependent. The term "vehicle fault codes" is meant to be synonymous with the term "trouble code" or "diagnostic trouble code". A listing of such codes may be found in the publication of the Society of Automotive Engineers, "SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual". The diagnostic data service 120A accepts request for vehicle parametric data and retrieves the data using the vehicle bus adapter.

As noted by the Patent Owner in the previous response and repeated above, the ECUs will indeed use their own respective trouble codes, and these codes are different for different vehicles. The SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual, i.e. the SAE HS-3000, referred to in Chou et al. and of record in the reexamination, provides that: "[c]urrently there is no uniformity in these numeric Diagnostic Trouble Codes (DTC) between manufacturers, and in some cases, even within the same manufacturer across different product lines." (SAE HS-3000, 1997, page 39). The lack of vehicle code compatibility among different vehicles for vehicle tracking units is the problem addressed by the claimed invention of the '278 patent.

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c. Comments on Chou et al. col. 10, lines 1-11

This cited portion of Chou et al. is reproduced
below:

[i]t may be desirable to bundle the remote health monitoring and diagnostics with other services or to extend it with related application functions. For example, the remote diagnostics service could certainly be offered on top of an Emergency/Mayday service (e.g., "OnStar"). Other applications and services that can be developed or bundled as extensions of the diagnostics services include: breakdown service, network diary, vehicle user manual update, OEM Callback Services, fleet management, theft prevention, vehicle parameter update/change, remote vehicle access, concierge services, etc.

The quoted language is highly generalized regarding possible additional services. It is unclear what if anything this language has to do with the claimed invention. It is unspecified and unclear which possible services are to be possibly implemented using one or more of the remote service center 200, the dealer 250, the roadside assistance vehicle 175, the in-vehicle system 100, and/or some other third party facility or equipment.

Chou et al. discloses that the diagnostic server at the remote service center lists "out-of-range parameters" and performs "trend analysis on the parameter values". (Col. 9, lines 12-21). Accordingly, the cited portion with respect to vehicle parameter update/change could readily be performed at the remote service center alone.

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The Patent Owner respectfully asserts that if a claim element is not expressly disclosed by the prior art, the prior art reference must inherently disclose the claim element to anticipate it. (See *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)). The court went on to state that:

[t]o establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). *Id.* at 745. (Emphasis added).

The Manual of Patent Examining Procedure (MPEP) also states: "[t]he 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." (MPEP §2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, (CCPA 1981); and *Metabolite Labs., Inc. v. Lab.Corp. of Am. Holdings*, 370 F.3d 1354, 1367 (Fed. Cir. 2004)).

The Patent Owner respectfully submits that this cited portion of Chou et al. adds nothing to the asserted deficiencies

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elsewhere in Chou et al. Moreover, there is no proper way to attempt to read this cited section as inherently disclosing any of the recited claim elements.

5. Chou et al. Teaches Away from the Claimed Invention

The Patent Owner again submits that the teachings of Chou et al. include that the in-vehicle computer system (the left hand side of Figure 5) simply interfaces to the various specific ECUs on the bus. Further, Chou et al. teaches that the diagnostic server of the remote service center (on the right hand side of Figure 5) provides the ability to read data from the data bus or write data to the data bus, even though different manufacturers and different models use different codes for their ECUs. In other words, Chou et al. teaches away from the claimed vehicle tracking unit including the multi-vehicle controller and downloading interface.

For example, Chou et al. provides that:

[t]he remote service center 200 of FIG. 3 comprises a diagnostic server 201 that has access to data related to the vehicle such as as-built, history, diagnostics, warranty, service information and failure mode data. The diagnosis server 201 is linked to the data repository 203 via a TCP/IP link, LAN, or the like.

(Col. 5, lines 34-39; emphasis added).

And Chou et al. also provides:

[w]ithin the diagnostic server 201 at the service center 200 is a diagnosis engine 201A. The main

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function of the diagnosis engine 201A is to provide a health checkup or a diagnosis using the data obtained from the vehicle, the vehicle's past history, and the diagnostics information about the particular model of the vehicle.

(Col. 5, line 53-58; emphasis added).

In operation, "[t]he diagnosis engine 201A first determines if a fault or a potential of a fault is present by checking if any trouble code is reported by the client, and checking a predetermined list of vehicle attribute values against their normal operating characteristics." (Col. 5, lines 61-64).

During the diagnosis session, "the diagnostic client 421 passes the fault codes, vehicle identification and other relevant information to the [diagnostic] server 201". (Col. 8, lines 19-21). The fault detector and diagnostic client are both at the vehicle, and, the diagnostic server is at the remote service center. The diagnostic server can also request data from the diagnostic client at the vehicle.

The vehicle driver may also initiate a vehicle health checkup. Chou et al. further describes this health checkup as follows:

[t]hen, vehicle information, estimated to be on the order of 1 kilobyte in size, including, for example, vehicle identification number (VIN), any trouble codes, and/or a snapshot of the vehicle data, are retrieved by the vehicle client 101 through the vehicle bus interface 120. The vehicle client 101 combines vehicle ID information with the information from the vehicle bus

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interface 120 and sends the data to the Diagnostic Server 201 over a data link. The data link is kept open. The diagnostics server 201 retrieves vehicle information from the data repository 203 and compares the data from the vehicle with the repository data. Then, the diagnostic server 201 prepares a report listing any out-of-range parameters and actions required (e.g., "coolant level is low").

(Col. 9, lines 3-16; emphasis added).

The Patent Owner submits that Chou et al. teaches that the ability to work with different vehicle device codes is provided at the remote service center using the diagnostic server 201 in combination with the data repository 203 (Figure 1) also at the remote service center - and not at the vehicle. Chou et al. provides no disclosure, express or inherent, and no reason, for this capability to be provided at the in-vehicle system.

Thus, Chou et al. teaches away from the vehicle tracking unit of the claimed invention that includes: the multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles, and the 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.

Accordingly, the Patent Owner submits that independent Claims 1 and 18 are patentable over Chou et al. Spaur et al. is cited for the teaching of a wired connection in the rejection of

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independent Claim 13, and, the Patent Owner submits that Spaur et al. adds nothing to the deficiencies of Chou et al. Accordingly, independent Claim 13 is also patentable. In view of the patentability of the independent Claims 1, 13 and 18, it is submitted that their dependent claims are also patentable, and require no further discussion herein.

C. Evidence of Secondary Considerations and Declaration Evidence

1. Secondary Considerations of Non-Obviousness

To rebut the Examiner's obviousness rejections based upon the Chou et al. patent, the Patent Owner can offer the following secondary considerations supporting non-obviousness. As noted by the Federal Circuit in *Mintz v. Dietz*, 679 F.3d 1372 (Fed. Cir. 2012), the following helpful guidance is provided with respect to the objective criteria of secondary considerations:

[t]hese objective criteria thus help turn back the clock and place the claims in the context that led to their invention. 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. For these reasons, this 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."
(*Id.* at 1378; emphasis added).

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Mintz further provides:

[i]ndeed, where the invention is less technologically complex, 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.* at 1379; emphasis added).

The Patent Owner sets forth below evidence of licensing, commercial success, copying by others, customer need, and limited value of products without the claimed invention.

a. Licensing

The '278 patent in Claim 1, for example, is directed to a multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle. The multi-vehicle compatible tracking unit comprises a vehicle position determining device, a wireless communications device, and a multi-vehicle compatible controller for cooperating with the vehicle position determining device and the wireless

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communications device to send vehicle position information. The multi-vehicle compatible controller is to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles. The multi-vehicle compatible tracking unit comprises 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.

The Patent Owner points to the following excerpt from the Jury Verdict form (Evidence Appendix Item 1) from the related litigation establishing the merits of the claimed invention and the licenses:

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?

In other words, after observing all of the testimony of the witnesses, reviewing the exhibits presented during trial, and applying the Court's Jury Instructions, the Jury determined that the licenses were based on the merits of the claimed invention, including the '278 patent.

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As noted in Mr. McAlexander's Declaration (Evidence Appendix Items 5-6), the Patent Owner has received in excess of \$50 million in licensing revenue, from the '278 patent and the other asserted patents in the related litigation.

Mr. McAlexander also notes that the '278 patent is one of three patents asserted in the related litigation providing features for multi-vehicle compatibility; and, multi-vehicle compatibility is important for the overall licensing program of the Patent Owner.

Mr. McAlexander cites to Requester's own employees' trial testimony for the propositions that the multi-vehicle compatibility provides for simplified installation and avoids the need to have multiple SKUs (stock keeping units). Further details regarding the "customer need" and "limited value" without the multi-vehicle compatibility are provided below.

b. Commercial Success

The Patent Owner respectfully points to the following excerpt from the Jury Verdict form from the related litigation that provides evidence of commercial success 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):

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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?

Furthermore, the Jury also determined that the features of the '278 patent were included in the infringing Requester devices. The Jury determined that asserted claims of the '278 patent were infringed, and the Court determined the infringement was willful. The Jury Verdict evidences that products sold by Requester correspond to the claimed invention.

This is the pertinent portion of the Jury Verdict form:

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	LMU-3000	LMU-3030	LMU-3050	VPOD	VPOD2
Claim 1	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 2	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 3	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 4	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 5	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 6	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 8	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 11	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No

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	LMU-3000	LMU-3030	LMU-3050	VPOD	VPOD2
Claim 12	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No		
Claim 13	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 14	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 16	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 18	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 19	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 21	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No

As noted in Mr. McAlexander's Declaration, Requester
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has sold over 466,000 units of the accused products, earning over \$4.1 million in gross profits (citing to the Tregillis financial expert report).

Mr. McAlexander also notes that the '278 patent is one of three patents asserted in the related litigation providing features for multi-vehicle compatibility; and, multi-vehicle compatibility is important for the overall licensing program of the Patent Owner. Mr. McAlexander cites to Requester's own employees' trial testimony for the propositions that the multi-vehicle compatibility provides for simplified installation and avoids the need to have multiple SKUs (stock keeping units).

c. Copying by Others

Once again, the Patent Owner points to the following excerpt from the Jury Verdict form from the related litigation that establishes copying:

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?

The Jury's finding of infringement of all of the asserted claims of the '278 patent (provided above) establishes

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that Requester's products correspond to the claimed invention. The Court's Final Order and Final Judgment (Evidence Appendix Items 3 and 7) confirm the Jury's Verdict.

d. Customer Need

The Patent Owner directs the Patent Trial and Appeal Board's (PTAB) attention first to the Court's determination in the related litigation. In its Final Order, the Court provides:

Rather than take a license, and choosing not to design around Omega's patents, CalAmp elected to sell infringing products and continues to do so to this day. CalAmp's motivation to engage in this behavior is obvious: their customers wanted this technology and CalAmp [Requester] wanted to provide it. (Final Order, page 19; Emphasis added.)

The McAlexander Declaration provides that the multi-vehicle accused products in the Requester litigation were developed because of "customer need" for a simple installation that did not require splicing of wires. Mr. McAlexander's position is supported by the following testimony of Mr. Stephen Hall and Mr. Peter Hergesheimer, both Requester employees, as follows:

Testimony of Requester Employee Stephen Hall

Q. Can you introduce yourself for the record

A. Yes. My name is Stephen Hall. The correct

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spelling is S-t-e-p-h-e-n.

Q. All right, sir. And by whom are you employed?

A. I'm an employee of CalAmp Corporation.

Q. Do you have a title at CalAmp?

A. My official title is director of system engineering and technology.

Q. What does it mean to be the director of system engineering and technology at CalAmp?

A. My role is to look at the needs of our customer and market and to match them up with various technologies that are going on in the industry component level and otherwise to make sure that we have an appropriate solution. (Stephen Hall deposition, 6:8-22).

Q. All right, sir. I'm going to hand you what was previously marked as Exhibit 1 to the deposition of Mr. Hergesheimer. Can you tell me what Exhibit 1 is?

A. I'm looking at a CalAmp datasheet for the LMU-3000 product.

Q. And were you involved in the development of the LMU-3000?

A. I was.

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Q. And what was your role in developing the LMU-3000?

A. My role on the 3000 was at the CRS level. I provided the requirements document for that. The various blocks within it were predefined by our existing partnerships, and so I didn't do a lot of component selection type of work, so it was really limited just to the CRS document.

Q. Was there a particular market need that you identified leading up to the creation of the CRS for the LMU-3000?

A. The 3000 was driven by a general market need that we heard from a number of customers. The primary interest was coming from a need for a simple installation type of solution and the opportunity to enhance the capability of the product that we could offer with certain data items coming off of the vehicle bus. (Stephen Hall deposition, 6:8-22; and 40:20-41:12; Emphasis added).

Testimony of Requester Employee Peter Hergesheimer

Q. You have been designated as a representative on whether CalAmp has willfully or deliberately infringed in this case. Beyond knowing about the devices and how they operate, do you know anything about CalAmp's assertions that its actions are not

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willful or deliberate?

A. I would say from my experience in the development of these devices that there's no willful infringement.

Q. And -- and what's that based on?

A. That's based on knowing where the -- the technology that we use came from and the fact that these were sales-driven requests and somebody had a problem to solve and we went about solving the problem.

Q. What do you mean sales-driven request?

A. Well, typically our -- typically we have a customer that says hey, I would like to do this particular -- have a product that has this feature and so CalAmp goes about designing that product.

Q. So the LMU3000 development was the result of -- or was -- was undertaken because customers expressed a demand to CalAmp for these products?

A. I -- I believe that's the case. I can't say specifically for these, but that's in general how our product development works. (Peter Hergesheimer deposition, 40:6 - 41:3).

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e. Limited Value for Products Without the Invention

The PTAB's attention is directed to the section above regarding Commercial Success. The Patent Owner asserts that the accused products as covered by the '278 patent would have "limited value" if it were not for multi-vehicle compatibility. Requester's own employee, Peter Hergesheimer, testified as follows:

Testimony of Requester Employee Peter Hergesheimer

Q. Can you state your name for the record.

A. Peter Hergesheimer.

Q. All right. Sir, and by whom are you employed?

A. CalAmp.

Q. Okay. And what's your position at CalAmp?

A. I'm the senior director of software and architecture in the MRM group. (Peter Hergesheimer deposition, 6:2-8).

Q. Do you know whether the LMU3000 would have any value if it didn't work on multiple vehicles?

A. It would have a limited value.

Q. You would need separate skus for each vehicle; right?

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A. That would be one way of solving that problem.

Q. Is there any other way?

A. Different skus could be different software got loaded onto the same sku.

Q. Okay. So you can -- whether you have a different sku or not, you would need to -- if -- if the LMU3000 was vehicle specific, it would need software for each vehicle in which it was -- separate software for each vehicle in which it was designed to work?

A. Each vehicle type I would guess, yes.

Q. And that would be a more expensive exercise, I would think, from CalAmp's perspective?

A. Yes.

Q. And less desirable than the -- than the option you have now where the LMU is able to service multiple vehicles?

A. Yes, even though it is still pretty painful.

(Peter Hergesheimer deposition, 46:25 - 47:19; Emphasis added).

In view of the evidence of secondary considerations the Patent Owner submits that any obviousness type rejection of the pending claims is rebutted.

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2. Nexus for Secondary Considerations of Non-Obviousness

On pages 9-10 of the Final Office Action, the Examiner contended that the "evidence of secondary considerations must be related to the claimed invention, i.e. a nexus between the invention as claimed and evidence of the secondary consideration." The Patent Owner submitted the relevant court documents finding evidence of secondary considerations which necessarily includes a finding of nexus, submitted trial testimony that constituted the evidence at trial resulting in finding of evidence of secondary considerations for the asserted patents including the '278 patent, and submitted the Declaration of Mr. McAlexander further explaining his analysis and conclusions from the evidence he considered, as set forth in paragraphs 19a-19j of his Declaration.

The Patent Owner respectfully submits that evidence of secondary considerations, including nexus, has been presented and requests favorable reconsideration.

Further, the Patent Owner highlights this passage from page 10 of the Court Order (Evidence Appendix Item 3), which highlights the nexus between the claims of the '278 patent and the copying by Requester, CalAmp:

[f]urther indicia of willful infringement by CalAmp is found in an e-mail sent by Mr. Chen to outside patent counsel, Mr. David Bailey 12, and senior vice president for corporate development, Mr. Garo Sarkissian. (Doc. 182, 112:13-19). On July 30, 2013, eight months after Omega instituted this lawsuit, Mr. Chen wrote to Messrs, Bailey, and

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asked them to look at the '278 patent. (Pl.'s Ex. 48). Referring to claim 13 of the '278 patent, Mr. Chen wrote: "13 may relate to how we program a unit at the factory so it may be harder to avoid." (Id.). The '278 patent has as an object of the invention to "provide a multi-vehicle compatible tracking unit which may be used to control operable vehicle devices, and/or read information therefrom via the vehicle data communications bus." (Joint Ex. 5, column 2, lines 46-49). Clearly, Mr. Chen was concerned as late as July 30, 2013, that the accused devices infringe claim 13 of the '278 patent, as the jury ultimately found. His admission in this e-mail that the units are programed at the CalAmp factory is further evidence that his trial testimony describing the LMU as a black box, programmed by the end-user, was false.

(Emphasis added).

The Examiner also noted that "the evidence of non-obviousness (i.e. testimony/trial transcript, exhibits, instructions) are not of record, e.g. jury instructions, financial expert Reports, or only partially of record, e.g. excerpts of testimony of trial transcript, as best understood." To address the Examiner's concern the following materials were submitted, yet the Examiner refused to enter and consider these materials in the response filed September 18, 2017: Exhibit 5, trial transcript; Exhibit 6, list of defendant's trial exhibits; Exhibit 7, list of plaintiff's trial exhibits; Exhibit 8, list of Court's trial exhibits; and Exhibit 9, jury instructions. Even without these further materials as requested by the Examiner, but not entered into the record or considered, the Patent Owner has

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still submitted evidence of secondary considerations and established the required nexus. In view of the evidence of secondary considerations, the Patent Owner submits that any obviousness type rejection of the claims is overcome.

3. Mr. McAlexander Declaration Evidence

The Examiner contended that the positions and opinions of Declarant, Mr. McAlexander, were merely conclusory. The Patent Owner points out that the McAlexander Declaration sets forth the analysis performed by highly experienced patent agent and technical expert whose analysis and trial testimony was persuasive at the related litigation, and whose earlier declaration was part of the basis for the USPTO confirming the claims of the '278 patent in the first reexamination. Mr. McAlexander states his understanding of the claims, cites to the specific relevant teachings of Chou et al. as would be understood by one of skill in the art, and renders his opinions. His opinions are not merely conclusory.

Mr. McAlexander's analysis also walks through the extensive evidence of secondary considerations in a detailed and thorough manner. Accordingly, the PTAB is respectfully requested to reconsider the McAlexander Declaration.

II. The Reexamination Was Improperly Granted

The Patent Owner respectfully submits that the present Requester's repeated request for ex parte reexamination should

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have been rejected as being wasteful of USPTO resources and being fundamentally unfair to the Patent Owner.

In the past, the USPTO has exercised discretion to deny third party requests for ex parte Reexamination. (See *In re Portola Packaging Inc.*, 110 F.3d 786, 791 (Fed. Cir. 1997) *superseded by* 35 U.S.C. §303(a) ("a rejection made during reexamination does not raise a substantial new question of patentability if it is supported only by prior art previously considered by the PTO in relation to the same or broader claims.")). In the legislative history of this statutory amendment to 35 U.S.C. §303(a), it was noted that the USPTO would stand as the gatekeeper for the ex parte reexamination procedure to prevent unfair harassment of the Patent Owner. The legislative history states:

[t]he bill preserves the necessary safeguard in the Patent Act against harassment of patentees with the safety-valve of a "substantial new question of patentability" standard, not merely "any sort of question." The agency has discretion in this determination to permit reexamination, but it is not absolute.

...
However, this bill is not a license to abuse patentees and waste the life of a patent.
(107 H. Rpt. 120).

Notwithstanding this legislative adjustment from Congress, this discretionary denial of serial post grant review requests has evolved in the relatively new IPR, provided by the

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Leahy-Smith America Invents Act (AIA). In a recent line of decisions, the PTAB has delineated a rule governing follow-on requests for IPR. (See *Nvidia Corp. v. Samsung Electronics. Co.*, 2016 Pat. App. Filings LEXIS 3606; and *General Plastic Indust. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357-61 (PTAB), available at <http://bit.ly/2zAOS3w>).

In *Nvidia*, the PTAB provided a list of factors to consider when exercising the statutory discretion to order the IPR. The list of factors included:

- (1) the finite resources of the Board;
- (2) the requirement under 35 U.S.C. §316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review;
- (3) whether the same petitioner already previously filed a petition directed to the same claims of the same patent;
- (4) whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known about it;
- (5) whether at the time of filing of the second petition the petitioner already received patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
- (6) the length of time that elapsed between the time petitioner learned of the prior art

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asserted in the second petition and filing of the second petition; and

(7) whether petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.
(*Id.* at 8-9).

The PTAB remarked about the: "potential inequity based on a petitioner's filing of serial attacks against the same claims of the same patent, while having the opportunity to adjust litigation positions along the way based on either patent owner's contentions responding to prior challenges or the Board's decision on prior challenges, is real and cannot be ignored." (*Id.* at 10; emphasis added). The PTAB stated that repeated requests for IPR would not be barred under a bright line rule, but each request would need to be reviewed under a case-by-case basis. (*Id.*).

In *General Plastics*, the PTAB again applied the *Nvidia* factors in denying follow-on requests for IPR. In making their determination, the PTAB noted that the petitioner had modified their requests based upon the Patent Owner's response in the first request for IPR and the PTAB's own comments. The PTAB went on to state: "[t]he filing of sequential attacks against the same claims, with the opportunity to morph positions along the way, imposes inequities on [Patent Owner]." (Slip. Op at 11).

In the current appeal, the present reexamination resulted from a request filed as a follow-on request to a first

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reexamination, then pending, that eventually resulted in a Reexamination Certificate. The present reexamination request was filed only after reviewing the Patent Owner's response in the first reexamination. Indeed, the present reexamination request was essentially an end-around third party reply to the Patent Owner's response in the first reexamination. To this end, the present reexamination request included a section titled: "PROCEEDINGS IN PENDING RE-EXAMINATION OF FLICK '278 PATENT WITH CONTROL NO. 90/013,587". (Pages 26-31 of the Request). In fact, the present reexamination request challenged the proper decision to drop rejections in the first reexamination. (See Page 7 of the Request ("the Beckert '363 patent was considered during the Flick '587 Reexam, but was inexplicably withdrawn from the Flick '587 Reexam with no reasons being made on the record as to why this rejection was being withdrawn. Accordingly, Requester is again resubmitting this reference"; emphasis added)).

The Patent Owner submits that the Requester's efforts are an improper and roundabout attempt to fashion the present ex parte reexamination into an IPR. The Patent Owner notes that the IPR option was available to the Requester, but the Requester rather chose to move forward with litigation in the Federal Court system, which ultimately resulted in a total rejection of the Requester's invalidity arguments and a finding of willful infringement. Nevertheless, not apt to be without options, the Requester filed the first request for ex parte reexamination just prior to the original scheduled start of trial.

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The Patent Owner notes that the present reexamination resulted from a request that was largely duplicative of the failed first reexamination. In particular, the Beckert, Spaur et al. and Suman et al. prior art references, each used to argue substantial new questions of patentability in the present reexamination's request, were all applied in rejections in the first reexamination.

Moreover, the only new prior art reference, Chou et al., was known to the Requester long before the filing of follow-on present reexamination's request. The Patent Owner notes that Chou et al. was considered in the original prosecution of the '278 patent, as correctly noted by the Examiner on page 41 of the Reexamination Order Determination dated December 15, 2016. Indeed, the Chou et al. prior art reference was cited in multiple parents of the '278 patent. (See U.S. Patent Nos. 7,720,597, 7,149,623, and 6,606,561). Yet further, the Chou et al. prior art reference was mentioned 2 times in the appendix of the Requester's own litigation expert (a document dated April 15, 2015, a full 4 months before the filing of the first request for reexamination). Hence, the Patent Owner notes that the Requester not only should have known about the Chou et al. prior art reference at the time of filing of request for the first reexamination, but actually did know about the Chou et al. prior art reference at the time of the filing of the request for the first reexamination, but did not include the Chou et al. reference in view of the deficiencies as noted herein.

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The Patent Owner submits that such sequential/serial requests for ex parte reexamination, which spend hundreds of pages arguing that the prior Examiner's panel in the first reexamination was wrong, is a waste of USPTO resources. The proper venue for such USPTO based litigation is the IPR, but the Requester strategically skipped that option, choosing rather to drag the Patent Owner through costly Federal Court litigation.

The Patent Owner submits that the Requester is abusing USPTO procedures in a fashion that is fundamentally unfair to the Patent Owner. Indeed, it is not only in this present reexamination where the Requester has continued to file sequential/serial requests after failing to invalidate the patent at trial, and after a first reexamination try. For U.S. Patent No. 6,756,885, which was successfully asserted against the Requester in the related litigation, the first reexamination resulted in a Reexamination Certificate issued August 1, 2017. Not three months later, the Requester filed yet another follow-on request for reexamination for U.S. Patent No. 6,756,885 (Reexamination 90/014,038 - filed October 26, 2017). Quite succinctly, the Requester has laid bare a strategy to serially attack the Patent Owner via the ex parte reexamination process.

Although the decision to order an ex parte reexamination is not expressly appealable, (see 35 U.S.C. §306), the Patent Owner contends that the PTAB should adopt an *Nvidia* style standard for reviewing serial requests for ex parte reexaminations. The Patent Owner notes that many of the same

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Kenneth E. FLICK
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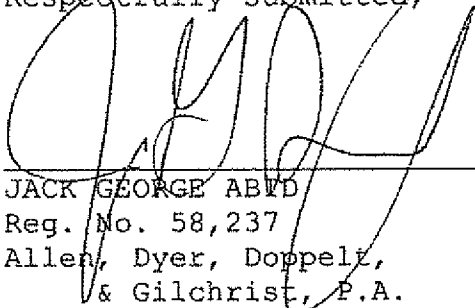
inequities from *Nvidia* are in play in the present reexamination. In particular, the present reexamination represents a waste of USPTO, Federal Court, and PTAB resources, and utilizes prior art references the Requester had knowledge of at time of the filing of the first request for reexamination. The Requester utilized the Patent Owner's response in the first reexamination to fashion a pseudo inter partes response in an end-around on the limits of post grant review procedures. Because of these inequities, the Patent Owner respectfully submits that the PTAB should apply an *Nvidia* standard to this particular ex parte reexamination and overturn the current rejection.

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CONCLUSIONS

In view of the foregoing arguments, it is submitted that all of the claims are patentable over the prior art. Accordingly, the PTAB is respectfully requested to reverse the earlier unfavorable decision by the Examiner.

Respectfully submitted,



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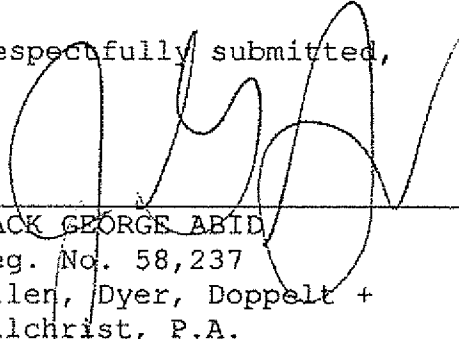
CERTIFICATE OF SERVICE

Certificate of Service in compliance with 37 C.F.R. §1.530(c)

Pursuant to 37 C.F.R. §§1.530(c), 1.248, I hereby certify that on February 27, 2018, a complete copy of this Amendment is being served via First Class U.S. Mail upon Third Party Requester at the correspondence address as shown in PAIR:

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APPENDIX A - CLAIMS ON APPEAL

1. A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible tracking unit comprising:

a vehicle position determining device;

a wireless communications device;

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

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.

2. The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface comprises a wired signal downloading interface.

3. The multi-vehicle compatible tracking unit according to claim 2 wherein said wired signal downloading interface comprises a connector for temporary connection to a downloading device.

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4. The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface comprises a wireless signal downloading interface.

5. The multi-vehicle compatible tracking unit according to claim 4 wherein said wireless signal downloading interface comprises a wireless receiver for temporary connection to a downloading device.

6. The multi-vehicle compatible tracking unit according to claim 1 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

7. The multi-vehicle compatible tracking unit according to claim 1 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

8. The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

9. The multi-vehicle compatible tracking unit according to claim 1 further comprising a remote transmitter; and wherein said multi-vehicle compatible controller also performs at

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least one vehicle remote control function responsive to said remote transmitter.

10. The multi-vehicle compatible tracking unit according to claim 9 wherein the at least one vehicle remote control function comprises at least one of a vehicle security function, a remote keyless entry function, and a remote engine starting function.

11. The multi-vehicle compatible tracking unit according to claim 1 wherein said wireless position determining device comprises a Global Positioning System (GPS) receiver.

12. The multi-vehicle compatible tracking unit according to claim 1 further comprising a housing containing said vehicle position determining device, said wireless communications device, said multi-vehicle compatible controller, and said downloading interface.

13. A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible vehicle tracking unit comprising:

- a vehicle position determining device;
- a wireless communications device;

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

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller;

said downloading interface comprising a connector for temporary connection to a downloading device.

14. The multi-vehicle compatible tracking unit according to claim 13 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

15. The multi-vehicle compatible tracking unit according to claim 13 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

16. The multi-vehicle compatible tracking unit according to claim 13 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

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17. The multi-vehicle compatible tracking unit according to claim 13 further comprising a remote transmitter; and wherein said multi-vehicle compatible controller also performs at least one vehicle remote control function responsive to said remote transmitter.

18. A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible vehicle tracking unit comprising:

- a vehicle position determining device;

- a wireless communications device;

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

- said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and

- a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller;

- said downloading interface comprising a wireless receiver for temporary connection to a downloading device.

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19. The multi-vehicle compatible tracking unit according to claim 18 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

20. The multi-vehicle compatible tracking unit according to claim 18 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

21. The multi-vehicle compatible tracking unit according to claim 18 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

22. The multi-vehicle compatible tracking unit according to claim 18 further comprising a remote transmitter; and wherein said multi-vehicle compatible controller also performs at least one vehicle remote control function responsive to said remote transmitter.

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APPENDIX B - EVIDENCE APPENDIX

In accordance with MPEP §1205.02

While it is no longer a requirement to include an evidence appendix, the Office strongly encourages and appreciates receiving copies of the evidence relied upon (e.g., copies of declarations and affidavits, evidence of secondary considerations, etc.). This ensures that the Board is considering the proper evidence and avoids any confusion as to the particular evidence referenced in the appeal brief. In the alternative, the Board recommends that appellants clearly identify in the appeal brief the evidence relied upon using a clear description of the evidence along with the date of entry of such evidence into the Image File Wrapper.

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Filed: OCTOBER 29, 2016

COURTESY COPIES OF PREVIOUSLY-ADMITTED DECLARATIONS AND EXHIBITS

1. Jury Verdict Judgment from related litigation with Requester (admitted with response filed June 12, 2017)
2. Ruling on JMOL and new trial from related litigation with Requester (admitted with response filed November 29, 2017) [Examiner did not address admission status in latest Advisory Action dated December 5, 2017]
3. Final Order from related litigation with Requester (admitted with response filed June 12, 2017)
4. Executed Rule 132 Declaration of Michael Suman July 5, 2016 (admitted with response filed September 18, 2017)
5. Executed Rule 132 Declaration of Joseph McAlexander July 6, 2016 (admitted with response filed September 18, 2017)
6. Executed Rule 132 Declaration of Joseph McAlexander June 12, 2017 (admitted with response filed June 12, 2017)
7. Final Judgment from related litigation with Requester (admitted with response filed June 12, 2017)
8. Markman Order from related litigation with Requester (admitted with response filed June 12, 2017)
9. Notice of Intent to Issue Ex Parte Reexamination Certificate from Serial No. 90/013,587 of the first reexamination (admitted with response filed September 18, 2017)

EXHIBIT 8



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/013,851	10/28/2016	8032278	C13-03896.RE2	8717

7590 05/14/2018
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ORLANDO, FL 32802-3791

EXAMINER

REICHL, KARIN M

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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05/14/2018

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

KPPB LLP

2400 EAST KATELLA AVENUE
SUITE 1050
ANAHEIM, CA 92806

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/013,851.

PATENT NO. 8032278.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Karin M. Reichle

Primary Examiner

PTOL-465 (Rev.07-04)



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Alexandria, VA 22313-1450
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 90/013,851
Filing Date: October 28, 2016
Appellant(s): 8032278

Jack G. Abid
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 27, 2018.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated July 19, 2016 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

The following ground(s) of rejection are applicable to the appealed claims.

Claim(s) 1, 4-8, 11-12, and 18-21 are rejected under pre-AIA 35 U.S.C. 102(b) as anticipated by or, in the alternative, under pre-AIA 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,330,499 to Chou et al (hereinafter also referred to as '499 or Chou).

See attached Appendix A, pages 30-42 *infra*.

Claims 9-10 and 22 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,330,499 to Chou et al (hereinafter also referred to as '499 or Chou) in view of U.S. Patent No. 6,028,537 to Suman et al, (hereinafter also referred to as '537 or Suman).

See attached Appendix A, pages 42-45 *infra*.

Claims 2-3 and 13-16 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,330,499 to Chou et al (hereinafter also referred to as '499 or Chou) in view of U.S. Patent No. 5,732,074 to Spaur et al (hereinafter also referred to as '074 or Spaur).

See attached Appendix A, pages 46-49 *infra*.

Art Unit: 3992

Claim 17 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,330,499 to Chou et al (hereinafter also referred to as '499 or Chou) in view of U.S. Patent No. 6,028,537 to Suman et al, (hereinafter also referred to as '537 or Suman) and U.S. Patent No. 5,732,074 to Spaur et al (hereinafter also referred to as '074 or Spaur).

See attached Appendix A, pages 49-50 *infra*.

(2) Response to Argument

As an initial matter, Appellant's remarks with regard to evidence not admitted into the record (see, e.g., pages 1-2, page 3, "(5) Evidence Improperly Refused Admission Into the Record 16", page 5, "37 C.F.R. §1.116(e)...15[sic]", pages 16-19, "(5) Evidence Improperly Refused Admission Into the Record", paragraph bridging pages 53-54 of "2. Nexus for Secondary Considerations of Non-Obviousness"), such remarks relate to issues which are petitionable not appealable. Accordingly such remarks have not been further addressed.

Continuing, Appellant's discussion of Related Appeals, Interferences and Trials, pages 7-12, including Evidence Appendix Items 1-3, has been noted.¹

Appellant's discussion of the Chou reference and claim 1 on pages 19-26 have been noted in their entirety.² The discussion is substantially the same as that set forth in the remarks of 9/18/2017 and 6/12/17. Specifically:

¹ Regarding Appellant's parenthetical in Item 2 on page 71, it is noted that the referenced ruling was rendered on November 14, 2017 and filed on 11/17/2017 along with the Notice of Appeal and a second after FINAL amendment but after both the 7/19/2017 FINAL and 9/18/2017 after FINAL amendment. Accordingly the ruling could not have been presented earlier. The ruling was discussed on pages 8-9, I. Updated Background, A. The Related Litigation. Documents referred to in such ruling/discussion, e.g. "(Doc. 216)", "(Doc. 226)" were not filed with the 11/17/2017 response.

Claim Patentability-Multi-Vehicle Compatible Controller

Appellant's discussion of the recitation "a multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles", pages 20-26, has been noted and considered.

Examiner respectfully disagrees with Appellant. As best understood, Appellant asserts/concludes (following a quotation of a portion of Chou (col. 4, lines 20-38 were reproduced) and an excerpt of part of the FINAL Office Action-see attached Appendix A, bridging pages 36-37) that Chou fails to disclose the recited controller because there is a lack of vehicle code compatibility among vehicles of different manufacturers and in some cases, even between different "products" of the same manufacturer which lack was discussed by SAE 3000 and the problem addressed by the '278 patent. However such assertions/conclusions are not commensurate with the terms of the claim/recited feature itself and/or such terms given the broadest reasonable interpretation consistent with the specification but not reading limitations in the specification into the claims, the teachings of Chou and/or the FINAL Office Action.

First, the language of the phrase does not require compatibility among vehicles of different manufacturers and/or different "product" lines of the same manufacturer. See the FINAL Office action at attached Appendix A, first full paragraph of page 11, i.e. "different vehicles" can be, e.g., same make and model with different trims (not different electronics).

² Appellant does not specifically address the rejection of claims 4-8, 11-12, 18-21 nor the rejections of claims 2-3 9-10, 13-17 and 22 relying on Chou in combination with Suman or Spaur.

Note also attached Appendix A, pages 18-23 and 33-35, in their entirety, as well as the Markman Order agreed construction of the claim term “Multi-vehicle compatible controller” during the related litigation³, Evidence Appendix Item 8, page 6, showing “multi-vehicle compatible controller” was construed as electronic circuitry that “can operate with more than one vehicle”, not vehicles of different manufacturers and/or different “product” lines of the same manufacturer. Continuing, the phrase, see again pages 21-23 of Appendix A, as construed does not require the corresponding structure (e.g. circuitry, memory, CPU) simultaneously store codes of vehicles of different manufacturers and/or different “product” lines of the same manufacturer and/or be capable of using any of such stored codes from vehicles of different manufacturers and/or different “product” lines of the same manufacturer. The phrase requires of corresponding structure merely the capability of using at least one code from among a plurality thereof for “different vehicles”, see again attached Appendix A, pages 11 and 33-35 of the Appendix A, i.e. teaching of such a capability by ‘499, i.e. capable of using a code from among a plurality thereof, i.e. model dependent.

Note also the discussion with regard to the declaration *infra*.

Claim Patentability-Downloading Interface

Appellant’s discussion of the recitation “a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for

³ “Electronic circuitry that performs one or more control function, and can operate with more than one vehicle”. In other words electronic circuitry that has the capability to operate with at least two vehicles but those vehicles do not have to be of different models and/or from different manufacturers, i.e. could be of the same make and model from the same manufacturer.

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use by said multi-vehicle compatible controller”, pages 19-24 and 26-35, has been noted and considered.

Examiner respectfully disagrees with Appellant. As best understood, Appellant asserts/concludes, (after quotations of the pertinent claim language and portions of attached Appendix A, pages 26-27 and 35-36 and a reproduction of Figure 5 of ‘499) that Chou does not discuss the recited feature but instead merely discloses passing data between the in-vehicle system and the remote service center. However such assertions/conclusions are not commensurate with the terms of the claim itself and/or such terms given the broadest reasonable interpretation consistent with the specification but not reading limitations in the specification into the claims, the teachings of Chou and/or the FINAL Office Action of Appendix A.

First see attached Appendix A at pages 23-25 as well as the cited page 26 with regard to the interpretation of the claim phrase. It is again noted such phrase recites the function or capability of the corresponding structure as “permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller”. Attention is again invited to the discussion in the Claim Patentability-Multi-Vehicle Compatible Controller section *supra*. Second, see again the entirety of the rejections of Appendix A at pages 36 and 46-48 as well as the cited page 35-36.

Appellant’s discussion of cited portions of Chou, e.g. col. 9, lines 35-45, col. 4, lines 15-38, col. 10, lines 1-11, introduced for the first time after FINAL, are also deemed not persuasive for the same reasons with regard to the corresponding structure and function/capability of the functional phrase.

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Claim Patentability-Teachings of Chou

Appellant's discussion of Chou teaching away from the invention, pages 35-38, which relies on the same portions of '278 cited in paragraph 17 of the declaration, has been noted and considered but are not persuasive.

Again Appellant's assertions/conclusions are not commensurate with the terms of the claim itself and/or such terms given the broadest reasonable interpretation consistent with the specification but not reading limitations in the specification into the claims. See again the prior discussion of the multi-vehicle compatible controller and downloading interface, i.e. the claim language does not require specifics (e.g. on-board structure with the ability to work with different vehicles having different codes, i.e. simultaneous storage data/codes of vehicles from different manufacturers and/or different models and use of such codes) as asserted, as best understood.

Note also the discussion with regard to the declaration *infra*.

Secondary Considerations

PO's discussion of secondary considerations, pages 38-53, which relies on the declaration, paragraph 19 of Evidence Appendix Item 6 and Evidence Appendix Item 1 (Jury Verdict Form) and Evidence Appendix Item 3 (The Final Order) and Evidence Appendix Item 7 (The Final Judgement) and excerpts of testimony (Stephen Hall and Peter Hergesheimer), has been noted and considered but are not persuasive.

First, to be of probative value, evidence of secondary considerations must be related to the claimed invention, i.e. a nexus between the invention as claimed and evidence of the secondary consideration. As discussed *supra*, the claimed invention as discussed by PO is not commensurate with the invention as claimed. Second, with regard to the litigation evidence relied upon, see again MPEP 2259. See also discussion of the declaration *infra*. Third, PO asserts litigation evidence (testimony/trial transcript, exhibits, instructions, see, e.g., page 39 second full paragraph, page 40 last two paragraphs, page 41, line 16-page 45, line 3, section c on pages 45-46 and the testimony excerpts bridging pages 46-51) for the conclusions regarding the secondary considerations. However such referenced testimony/trial transcript, exhibits, instructions are not of record, e.g. jury instructions, or only partially of record, e.g. excerpts of testimony of trial transcript, as best understood. Finally PO asserts the declaration for the conclusions regarding the secondary considerations. However see the discussion of the declaration *infra*. Note also the evidence of record is silent with regard to the Chou '499 reference.

6/12/2017 Declaratory Evidence

Section I, paragraphs 1-6, with regard to Background have been noted.

Section II, The '278 Patent and Current Office Action, paragraphs 7-9, with regard to evidence reviewed (e.g. "the related litigation trial transcript and exhibits", the statements of the statutory grounds of the pending rejections and the declarant's presentation of "representative" claims 1, 13 and 18 recitations) have been noted. As best understood from the identification of "the

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related litigation trial transcript and exhibits”, such are not of record or only partly of record. See again the Secondary Considerations section *supra*.

See MPEP 716.01 (c), I and III.

Section III, The Prior Art Analysis, paragraphs 10-17, (declarant’s understanding of what Chou and SAE HS-3000 disclose, declarant’s understanding of Examiner’s interpretation and prior art position with regard to “down loading interface”, declarant’s “opinion” that Chou “fails to disclose the multi-vehicle compatible controller and downloading interface of the claimed vehicle tracking unit, as these claim recitations are interpreted by the Examiner” and declarant’s “opinion” that “Chou teaches away from the claimed invention” including citations to columns and lines of ‘278) have been noted. However, declarant’s understanding of the Examiner’s interpretation/positions, as best understood (merely portions thereof reproduced without reference to, i.e. page, line nos/the pertinent portions of the 3/29/2017 Office action) and/or declarant’s “opinion” with regard to Chou’s disclosure as to “claim recitations as interpreted by the Examiner” are merely conclusory. Declarant’s “opinion” as to Chou teaching away is likewise conclusory (the cited portions as best understood are those of ‘499). See also the discussion *supra* of the multi-vehicle compatible controller and downloading interface of the claimed vehicle tracking unit.

Section IV, Evidence of Secondary Considerations, paragraphs 18-19 (including reliance on litigation evidence, i.e. Jury Verdict, The Final Judgement, portions of depositions, financial expert Reports), have been noted. Declarant’s submissions regarding non-obviousness are merely conclusory. See the discussion in Secondary Considerations section *supra*. Again the evidence of

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non-obviousness (i.e. testimony/trial transcript, exhibits, instructions) are not of record, e.g. jury instructions, financial expert Reports, or only partially of record, e.g. excerpts of testimony of trial transcript, as best understood.

As a final matter, Appellant's newly presented remarks with regard to grant propriety (see, e.g., pages 54-61, "II. The Reexamination Was Improperly Granted")⁰ relate to issues which are petitionable not appealable. Accordingly such remarks have not been further addressed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Karin Reichle/
Primary Examiner, Art Unit 3992

Conferees:

/Jalatee Worjloh/

Primary Examiner, Art Unit 3992

/Woo H. Choi/

SPRS, Art Unit 3992

Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.

Appendix A

Claim Interpretation/Analysis:

Lexicographic Definitions

See MPEP § 2111.01, IV and 2163.07(a). The original specification (col. 22, first full paragraph) incorporates by reference U.S. 6,011,460 with regard to the tracking device communicating with one or more other vehicle devices via a vehicle data communication bus which '460 at col. 6, lines 14-18 sets forth "As would be readily understood by those skilled in the art, the term different vehicles [sic] may include vehicles from different manufacturers, different models, or even different trim levels of the same make and model."

35 U.S.C. §112 Sixth Paragraph

"Means-plus function" language of a claim if meeting the 3-prong analysis set forth in MPEP 2181, I, "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof", see MPEP 2181, II. As also set forth in 2181, II, "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language", i.e. sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function.

Specifically:

...examiners will apply 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph to a claim limitation if it meets the following 3-prong analysis:

(A) the claim limitation uses the term “means” or “step” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;

(B) the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and

(C) the term “means” or “step” or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.

The Examiner concludes that claims 1-22 include a phrase or phrases that invokes/invoke 35 U.S.C. §112, 6th paragraph. For support of the Examiners conclusion the Examiner notes the following 3-prong analyses.

“a vehicle position determining device”

Analysis of Independent Claims 1, 13 and 18

The Examiner concludes the phrase “*a vehicle position determining device*,” as recited in claims 1, 13 and 18, line 5, (Functional Phrase #1) invokes 35 U.S.C § 112, 6th paragraph. To support the Examiner’s conclusion, the Examiner notes the following 3-Prong analysis:

a) 3-Prong Analysis Prong (A):

As an initial matter, the Examiner finds that Functional Phrase #1 does not use the term “means.” The issue arising under Prong (A) then becomes whether or not the claimed phrase “device” is a generic placeholder for ‘means’. *See MPEP 2181 I §3 and MPEP 2181 I (C) §4.*

The Examiner has reviewed the specification of ‘278 and finds: (1) insufficient evidence that ‘278 Patent lexicographically defines the phrase “device” as a particular structure for performing the entire claimed function; (2) insufficient evidence that ‘278 indicates that the phrase “device” refers to a particular structure in the art, that a person having ordinary skill in the art (PHOSITA) would recognize as a structure known to perform the entire claimed function. *See Williamson v. Citrix Online, L.L.C.*, 115 USPQ2d 1105, 1112 (Fed. Cir. 2015).

In addition the Examiner has reviewed the prior art and finds that while the phrase “device” can be a particular structure in the art, the Examiner finds insufficient evidence that the phrase “device” infers or requires any particular structure as related to the function of Functional Phrase #1.

Accordingly based upon a review of ‘278 itself and the prior art, the Examiner concludes that the phrase “device” as set forth in Functional Phrase #1 is being applied as a generic term/placeholder having no particular structure associated therewith as related to the entire claimed function. Because “device” is merely a generic placeholder having no specific structure

associated therewith, the Examiner concludes that Functional Phrase #1 meets invocation Prong (A).

b) 3-Prong Analysis Prong (B):

Based upon a review of claims 1, 13 and 18 in '278, the Examiner finds that the function associated with Functional Phrase #1 is: "*vehicle position determining*" ('278 Patent, Claims 1, 13 and 18, line 5). *See MPEP 2181 I (B) ¶2.*

Because Functional Phrase #1 includes the function expressly noted above, the Examiner concludes that Functional Phrase #1 meets invocation Prong (B). Additionally, the Examiner notes that because nothing in the written description contradicts the plain language describing this function, the function within Functional Phrase #1 will have its ordinary and accustomed meaning.

c) 3-Prong Analysis: Prong (C)

Based upon a review of the entire Functional Phrase #1, the Examiner finds that Functional Phrase #1 does not contain sufficient structure for performing the entire claimed function that is set forth within Functional Phrase #1. In fact, the Examiner finds that Functional Phrase #1 recites very little structure (if any) for performing the claimed function.

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Because Functional Phrase #1 does not contain sufficient structure for performing the entire claimed function, the Examiner concludes that Functional Phrase #1 meets invocation Prong (C).

d) Corresponding Structure

Based upon a review of the original disclosure, the Examiner finds that the corresponding structure for Functional Phrase #1 includes a device (42 in Figure 1, 112 in Figure 10) receiving multiple signals from spaced apart satellites (38 in Figure 1), e.g. a GPS receiver, or communications with the cellular telephone network, e.g. time of arrival techniques available based upon multiple reception paths to determine position via the cellular telephone network, or other satellite transmissions ('278 at col. 5, lines 15-26 and col. 23, lines 46-47 and 51-54) . Therefore the corresponding structure for Functional Phrase #1 is a receiver of communications/transmissions from satellites or cellular telephone networks for achieving the function.

Analysis of Dependent Claim 11

The Examiner concludes that dependent claim 11 modifies and/or adds to the structure of Functional Phrase #1 forming modified Functional Phrase #1. Accordingly the Examiner finds

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that the corresponding structure for modified Functional Phrase #1 is a GPS receiver of communications/transmissions with satellites for determining vehicle position.

Analysis of Other Dependent Claims

The Examiner finds that the dependent claims other than claim 11 do not modify the function of nor the corresponding structure for Functional Phrase #1.

“a wireless communications device”

Analysis of Independent Claims 1, 13 and 18

The Examiner concludes the phrase “*wireless communications device*” as recited in claims 1, 13 and 18, line 6, (Functional Phrase #2) invokes 35 U.S.C § 112, 6th paragraph. To support the Examiner’s conclusion, the Examiner notes the following 3-Prong analysis:

a) 3-Prong Analysis Prong (A):

As an initial matter, the Examiner finds that Functional Phrase #2 does not use the term “means.” The issue arising under Prong (A) then becomes whether or not the claimed phrase “device” is a generic placeholder for ‘means’. *See MPEP 2181 I §3 and MPEP 2181 I (C) §4.*

The Examiner has reviewed the specification of ‘278 and finds: (1) insufficient evidence that ‘278 lexicographically defines the phrase “device” as a particular structure for performing the entire claimed function; (2) insufficient evidence that ‘278 indicates that the phrase “device” refers to a particular structure in the art, that a person having ordinary skill in the art (PHOSITA)

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would recognize as a structure known to perform the entire claimed function. See *Williamson v. Citrix Online, L.L.C.*, 115 USPQ2d 1105, 1112 (Fed. Cir. 2015).

In addition the Examiner has reviewed the prior art and finds that while the phrase “device” can be a particular structure in the art, the Examiner finds insufficient evidence that the phrase “device” infers or requires any particular structure as related to the function of Functional Phrase #2.

Accordingly based upon a review of ‘278 itself and the prior art, the Examiner concludes that the phrase “device” as set forth in Functional Phrase #2 is being applied as a generic term/placeholder having no particular structure associated therewith as related to the entire claimed function. Because “device” is merely a generic placeholder having no specific structure associated therewith, the Examiner concludes that Functional Phrase #2 meets invocation Prong (A).

b) 3-Prong Analysis Prong (B):

Based upon a review of claims 1, 13 and 18 in ‘278, the Examiner finds that the function associated with Functional Phrase #2 is: “*wireless communications*” (‘278 Patent, Claims 1, 13 and 18, line 6.) See *MPEP 2181 I (B) ¶2*.

Because Functional Phrase #2 includes the function expressly noted above, the Examiner concludes that Functional Phrase #2 meets invocation Prong (B). Additionally, the Examiner notes that because nothing in the written description contradicts the plain language describing this function, the function within Functional Phrase #2 will have its ordinary and accustomed meaning.

c) 3-Prong Analysis: Prong (C)

Based upon a review of the entire Functional Phrase #2, the Examiner finds that Functional Phrase #1 does not contain sufficient structure for performing the entire claimed function that is set forth within Functional Phrase #2. In fact, the Examiner finds that Functional Phrase #2 recites very little structure (if any) for performing the claimed function.

Because Functional Phrase #2 does not contain sufficient structure for performing the entire claimed function, the Examiner concludes that Functional Phrase #2 meets invocation Prong (C).

d) Corresponding Structure

Based upon a review of the original disclosure, the Examiner finds that the corresponding structure for Functional Phrase #2 is a device (44 in Figure 1, 113 in Figures 10 and 12) configured to wirelessly transmit/communicate in a voice band or on a control channel, e.g. cellular phone transceiver, of a cellular network, over other networks, e.g. over satellite, or via wireless internet services ('278 at col. 5, lines 31-49 and col. 23, lines 47-48 and 55-58). Therefore the corresponding structure for Functional Phrase #2 is a transceiver for wirelessly communicating/transmitting in a voice band or on a control channel of a cellular network or over other networks, e.g. over satellite, or via wireless internet services.

Analysis of Dependent Claims

The Examiner finds that the dependent claims do not modify the function of nor the corresponding structure for Functional Phrase #2.

“a multi-vehicle compatible controller...”

Analysis of Independent Claims 1, 13 and 18

The Examiner concludes “*a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information; said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles*”⁴ as recited in claims 1, 13 and 18, lines 7-15, (Functional Phrase #3) invokes 35 U.S.C § 112, 6th paragraph. To support the Examiner’s conclusion, the Examiner notes the following 3-Prong analysis:

a) 3-Prong Analysis Prong (A):

As an initial matter, the Examiner finds that Functional Phrase #3 does not use the term “means.” The issue arising under Prong (A) then becomes whether or not the claimed phrase “device” is a generic placeholder for ‘means’. See *MPEP 2181 I ¶3 and MPEP 2181 I (C) ¶4*.

⁴ Again the original specification (col. 22, first full paragraph) incorporates by reference U.S. 6,011,460 with regard to the tracking device communicating with one or more other vehicle devices via a vehicle data communication bus which at col. 6, lines 14-18 sets forth “As would be readily understood by those skilled in the art, the term different vehicles [sic] may include vehicles from different manufacturers, different models, or even different trim levels of the same make and model.”

The Examiner has reviewed the specification of '278 and finds: (1) insufficient evidence that '278 lexicographically defines the phrase "multi-vehicle compatible controller" as a particular structure for performing the entire claimed function; (2) insufficient evidence that '278 indicates that the phrase "multi-vehicle compatible controller" refers to a particular structure in the art, that a person having ordinary skill in the art (PHOSITA) would recognize as a structure known to perform the entire claimed function. See *Williamson v. Citrix Online, L.L.C.*, 115 USPQ2d 1105, 1112 (Fed. Cir. 2015).

In addition the Examiner has reviewed the prior art and finds that while the phrase "multi-vehicle compatible controller" can be a particular structure in the art, the Examiner finds insufficient evidence that the phrase "device" infers or requires any particular structure as related to the function of Functional Phrase #3.

Accordingly based upon a review of '278 itself and the prior art, the Examiner concludes that the phrase "multi-vehicle compatible controller" as set forth in Functional Phrase #3 is being applied as a generic term/placeholder having no particular structure associated therewith as related to the entire claimed function. Because "multi-vehicle compatible controller" is merely a generic placeholder having no specific structure associated therewith, the Examiner concludes that Functional Phrase #3 meets invocation Prong (A).

b) 3-Prong Analysis Prong (B):

Based upon a review of claims 1, 13 and 18 in '278, the Examiner finds that the function associated with Functional Phrase #3 is: "*for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information*" and "*to be*

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coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles” (‘278 Patent, Claims 1, 13 and 18, lines 7-15).

Because Functional Phrase #3 includes the function expressly noted above, the Examiner concludes that Functional Phrase #3 meets invocation Prong (B). Additionally, the Examiner notes that because nothing in the written description contradicts the plain language describing this function, the function within Functional Phrase #3 will have its ordinary and accustomed meaning.

c) 3-Prong Analysis: Prong (C)

Based upon a review of the entire Functional Phrase #3, the Examiner finds that Functional Phrase #3 does not contain sufficient structure for performing the entire claimed function that is set forth within Functional Phrase #3. In fact, the Examiner finds that Functional Phrase #3 recites very little structure (if any) for performing the claimed function.

Because Functional Phrase #3 does not contain sufficient structure for performing the entire claimed function, the Examiner concludes that Functional Phrase #3 meets invocation Prong (C).

d) Corresponding Structure

Based upon a review of the original disclosure, the Examiner finds that the corresponding structure for Functional Phrase #3 is a controller including a central processing unit (CPU) (126, Fig. 10) or other logic circuitry, a memory (125, Fig. 10), a clock (124, Figure 10) and

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input/output circuitry (127, Fig. 10). The memory may store vehicle position information, and a vehicle device code or codes ('278 at col. 6, lines 28-35, col. 11, lines 24-35, col. 22, lines 1-7 (and thereby '460 at col. 3, lines first full paragraph and lines 52-60, col. 4, line 44-col. 5, line 31, col. 5, line 66-col. 6, line 23 and col. 6, lines 36-58 and Figure 1, elements 12, 15, and 17) and col. 23, line 41-col. 24, line 13). The corresponding structure for Functional Phrase #3, therefore, is a controller including CPU, operating under stored program control, or other logic circuit, a memory, a clock and input/output circuitry for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information and for coupling to a vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles.

Analysis of Dependent Claims 2-5, 8, 11-12, 16, and 21

The Examiner finds that these dependent claims do not modify the function nor the corresponding structure for Functional Phrase #3.

Analysis of Dependent claims 6-7, 14-15, and 19-20

The Examiner concludes that dependent claims 6-7, 14-15, and 19-20 modify and/or add to the function of Functional Phrase #3 forming first modified Functional Phrase #3. (See '278 at col. 23, line 67-col. 24, line 3.) Accordingly the Examiner finds that the corresponding structure for first modified Functional Phrase #3 is that same as that as for Functional Phrase #3 however for the modified function of communication over the data bus with at least one vehicle device

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using at least one corresponding vehicle device code from among a plurality thereof for different vehicles which is for reading from (claim 6, 14, or 19) or writing to (claim 7, 15, or 20) the at least one vehicle device.

Analysis of dependent claims 9-10, 17, and 22

The Examiner concludes that dependent claims 9-10, 17, and 22 modify and/or add to both the structure and the function of Functional Phrase #3 forming second and third modified Functional Phrase #3. (See '278 at col. 23, line 67-col. 24, line 3.) Accordingly the Examiner finds that claims 9, 17 and 22 additionally require a remote transmitter (117, Figure 10) and the corresponding structure for second modified Functional Phrase #3 additionally includes a remote receiver (118, Figure 10) (See '278 at col. 24, last full paragraph) for the additional function of, responsive to the remote transmitter, performing at least one vehicle remote control function responsive to the remote transmitter and that claim 10 additionally requires a remote transmitter (117, Figure 10) and the corresponding structure for third modified Functional Phrase #3 additionally includes a remote receiver (118, Figure 10) (See '278 at col. 24, last full paragraph) for the additional function of, responsive to the remote transmitter, performing at least one vehicle remote control function comprising at least one of a vehicle security function, a remote keyless entry function and a remote engine starting function.

“a downloading interface...”

Analysis of Independent Claim 1

The Examiner concludes the phrase “*a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.*” as recited in claim 1, lines 16-19, (Functional Phrase #4) invokes 35 U.S.C § 112, 6th paragraph. To support the Examiner’s conclusion, the Examiner notes the following 3-Prong analysis:

a) 3-Prong Analysis Prong (A):

As an initial matter, the Examiner finds that Functional Phrase #4 does not use the term “means.” The issue arising under Prong (A) then becomes whether or not the claimed phrase “downloading interface” is a generic placeholder for ‘means’. *See MPEP 2181 I §3 and MPEP 2181 I (C) §4.*

The Examiner has reviewed the specification of ‘278 and finds: (1) insufficient evidence that ‘278 lexicographically defines the phrase “downloading interface” as a particular structure for performing the entire claimed function; (2) insufficient evidence that ‘278 indicates that the phrase “downloading interface” refers to a particular structure in the art, that a person having ordinary skill in the art (PHOSITA) would recognize as a structure known to perform the entire claimed function. *See Williamson v. Citrix Online, L.L.C.*, 115 USPQ2d 1105, 1112 (Fed. Cir. 2015).

In addition the Examiner has reviewed the prior art and finds that while the phrase “downloading interface” can be a particular structure in the art, the Examiner finds insufficient evidence that the phrase “device” infers or requires any particular structure as related to the function of Functional Phrase #4.

Accordingly based upon a review of ‘278 itself and the prior art, the Examiner concludes that the phrase “downloading interface” as set forth in Functional Phrase #4 is being applied as a generic term/placeholder having no particular structure associated therewith as related to the entire claimed function. Because “downloading interface” is merely a generic placeholder having no specific structure associated therewith, the Examiner concludes that Functional Phrase #4 meets invocation Prong (A).

b) 3-Prong Analysis Prong (B):

Based upon a review of claim 1 in ‘278, the Examiner finds that the function associated with Functional Phrase #4 is: *“for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.”* (‘278 Patent, Claim 1, lines 16-19.)

Because Functional Phrase #4 includes the function expressly noted above, the Examiner concludes that Functional Phrase #4 meets invocation Prong (B). Additionally, the Examiner notes that because nothing in the written description contradicts the plain language describing this function, the function within Functional Phrase #4 will have its ordinary and accustomed meaning.

c) 3-Prong Analysis: Prong (C)

Based upon a review of the entire Functional Phrase #4, the Examiner finds that Functional Phrase #4 does not contain sufficient structure for performing the entire claimed function that is set forth within Functional Phrase #4. In fact, the Examiner finds that Functional Phrase #4 recites very little structure (if any) for performing the claimed function.

Because Functional Phrase #4 does not contain sufficient structure for performing the entire claimed function, the Examiner concludes that Functional Phrase #4 meets invocation Prong (C).

d) Corresponding Structure

Based upon a review of the original disclosure, the Examiner finds that the corresponding structure for Functional Phrase #4 is a downloading interface (Figure 10, 116), e.g. interface circuitry 132 (e.g. logic circuitry or other control circuitry along with switching components) for controlling communication with a downloading device, and either a wireless signal downloading interface (e.g. a wireless receiver 114, such as for temporary connection to the downloading device 115 via any one or more of a number of wireless technologies, such as cellular, satellite, IR, Bluetooth or WiFi technologies (Fig. 11) or a temporary wireless communication link with the downloading device provided by sharing the wireless communications device that sends position data (Fig. 12)) or a wired signal downloading interface (e.g. a connector 133a in the form of a socket to accept a memory card or other data storage medium capable of transferring data or a connector 133a for temporary connection to a mating connector 133b of the downloading device (Fig. 13) wherein the downloading device can be, e.g., a laptop computer,

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via RS232/429 protocol, USB, FireWire, TCP/IP (Internet), or any other wired protocol.) (See '278 at col. 24, lines 14-51.) The corresponding structure for Functional Phrase #4 is therefore such a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code, e.g. vehicle device code or codes, an instruction to select a code or codes from among those already stored, or the data or sequence to allow the controller to generate the vehicle device code or codes, for use by said multi-vehicle compatible controller ('278 at col. 24, lines 8-12).

Analysis of Dependent Claims 2-3 and Independent claim 13

The Examiner concludes that dependent claim 2, independent claim 13 and dependent claim 3 modify and/or add to the structure of Functional Phrase #4 forming first and second modified Functional Phrases #4. (See '278 at col. 24, second full paragraph.) Accordingly the Examiner finds that for claim 2 the corresponding structure for first modified Functional Phrase #4 additionally includes the structure of a wired signal downloading interface and that for claims 3 and 13 the corresponding structure for second modified Functional Phrase #4 additionally includes the structure of a wired signal downloading interface comprising a connector for temporary connection to a downloading device.

Analysis of Dependent Claims 4 and 5 and Independent Claim 18

The Examiner concludes that dependent claim 4, independent claim 18 and dependent claim 5 modify and/or add to the structure of Functional Phrase #4 forming third and fourth modified Functional Phrases #4. (See '278 at col. 24, second full paragraph.) Accordingly the

Examiner finds that for claim 4 the corresponding structure for third modified Functional Phrase #4 additionally includes the structure of a wireless signal downloading interface and that for claims 5 and 18 the corresponding structure for fourth modified Functional Phrase #4 additionally includes the structure of a wireless signal downloading interface comprising a wireless receiver connector for temporary connection to a downloading device.

Analysis of Dependent Claims 8, 16 and 21

The Examiner concludes these dependent claims modify and/or add to the function of Functional Phrase #4 forming modified, modified second and modified fourth Functional Phrases #4, respectively. (See '278 at col. 24, lines 46-51.) Accordingly the Examiner finds that with regard to claims 8, 16 and 21 the corresponding function for the respective phrases includes permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

Conclusion

Finally, see MPEP 2258, I., G, "During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (*In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). See also MPEP 2111, e.g. "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*) and "The ordinary and customary meaning of a term may be evidenced by a variety of sources, including 'the words of

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the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *Phillips v. AWH Corp.*, 415 F.3d at 1314, 75 USPQ2d at 1327.

Rejections based on Prior Art:

Statutory Bases

The following is a quotation of the appropriate paragraphs of pre-AIA 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(d) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under pre-AIA 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim Rejections

Claim(s) 1, 4-8, 11-12, and 18-21 are rejected under pre-AIA 35 U.S.C. 102(b) as anticipated by or, in the alternative, under pre-AIA 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,330,499 to Chou et al (hereinafter also referred to as '499 or Chou).

The patent to Chou includes a/an publication/issue date more than one year prior to the effective filing date of June 3, 2007 of '278, and thus are available as prior art under 35 USC 102(b) and 35 USC 103.

Claim 1

A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible tracking unit comprising:

See '499 at, e.g., Fig. 1, elements 1000, 100 and 317, col. 2, lines 39-43, Figure 2, esp. elements 330, 335 and the dotted line therebetween, col. 3 lines 33-46 ("The processor 300 is coupled to a vehicle bus 335 through a vehicle bus interface 330. The coupling between the client computer device and the vehicle bus interface 106 of FIG. 3, may be one of RS-232, USB (Universal Serial Bus), IDB (ITS Data Bus), Ethernet, and the like. The vehicle bus interface may support one of vehicle bus standards such as CAN (Controller Area Network) and the Society of Automotive Engineers' SAE J1850 - Class B Data Communication Network Interface. Alternatively, the processor supports some or all of the functions of the vehicle bus interface and connects directly to the vehicle bus 335. The vehicle bus shown in FIG. 2 is an inherent part of all new automobiles. The dotted line is used as an indication that the vehicle bus is built into the vehicle."), col. 3, lines 54-56, col.4, lines 2-38 (esp. "model dependent"), Fig. 3, elements 103 and 104, col. 1, lines 11-17 and col. 6, lines 39-41, col. 7, lines 32-40, and claims 2

and 7-9. Therefore '499 discloses a multi-vehicle compatible, i.e. multi-model compatible, tracking unit for a vehicle comprising a vehicle data extending throughout the vehicle.

a vehicle position determining device;

See Claim Interpretation/Analysis section, **"a vehicle position determining device"** *supra*, the discussion of claim 11 *infra* and '499 at, e.g., Figure 1, element 150A and 317, col. 2, lines 39-43, col. 3, lines 54-59 ("Optionally, the processor 300 may be coupled to a location sensing device such as a GPS receiver 317 (FIG. 1) to provide vehicle location information. The system may or may not assume the availability of the automatic vehicle position information. Location-related scenario, such as emergency help dispatch may use automatic vehicle positioning"), col. 7, lines 32-40 and claims 1-2. Therefore '499 discloses the tracking unit comprising "a vehicle position determining device".

a wireless communications device;

See Claim Interpretation/Analysis section, **"a wireless communications device"** *supra* and '499 at, e.g., Figure 1, element 150, Figure 2, element 320, col. 2, lines 30-39 ("As shown in FIG. 1, the system 1000 includes a vehicle 10 with a vehicle driver or user 140, having an in-vehicle computing system 100, a client computer device 101 installed to enable vehicle health checkup and remote diagnostics, a communication link 150 (e.g., via wireless base stations 150B, or the like) for communicating vehicle information (e.g., vehicle identification number, (VIN), diagnostic data, and the like). Such a link can be interfaced with an internet 150C, the

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Internet 150D, or a public (or private) switch telephone network (PSTN) 150E.”), col. 3, lines 15-32, Figure 3, elements 107 and 102, and col. 4, lines 39-42. Therefore ‘499 further discloses the tracking unit comprising “a wireless communications device”.

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

See *Claim Interpretation/Analysis* section, **“a multi-vehicle compatible controller...”** and prior discussion of the preamble, “a vehicle position determining device” and “a wireless communications device”. Additionally see Fig. 2, elements 300 and 350, col. 2, lines 44-52 and 55 et seq, col. 3, line 62-col. 4, line 14 and Figure 3, element 101/120. Therefore Chou discloses a CPU operating under stored program/software control, e.g. 300, 101, a memory, e.g. 350, and input/output circuitry, e.g. 330. ‘499 further discloses time stamping information or data, e.g. test data or fault codes (‘499 at col. 5, first full paragraph and the paragraph bridging cols. 7-8 and Figure 4). Therefore Chou is also considered to either implicitly disclose or obviously suggest a clock since it discloses some structure/device for providing an indication of time. Thus, ‘499 further implicitly or obviously discloses a “a multi-vehicle compatible controller” and such for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information.

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and

See *Claim Interpretation/Analysis* section, **“a multi-vehicle compatible controller...”**.

See also the prior discussion of the preamble, esp. col. 3 lines 33-46 (“The processor 300 is coupled to a vehicle bus 335 through a vehicle bus interface 330. The coupling between the client computer device and the vehicle bus interface 106 of FIG. 3, may be one of RS-232, USB (Universal Serial Bus), IDB (ITS Data Bus), Ethernet, and the like. The vehicle bus interface may support one of vehicle bus standards such as CAN (Controller Area Network) and the Society of Automotive Engineers’ SAE J1850 - Class B Data Communication Network Interface. Alternatively, the processor supports some or all of the functions of the vehicle bus interface and connects directly to the vehicle bus 335. The vehicle bus shown in FIG. 2 is an inherent part of all new automobiles. The dotted line is used as an indication that the vehicle bus is built into the vehicle.”), and col. 4, lines 15-38 (“The vehicle bus interface 120 is responsible for replying to requests for parametric data. It is also responsible for continuously monitoring the vehicle bus 104 for any fault reported by the ECUs 103, in terms of diagnostic trouble codes (DTCs). The vehicle bus interface 120 includes the following modules: vehicle bus adapter 120C, fault detector 120B, and diagnostic data service 120A. The fault detector 120B polls the vehicle bus 104 through the vehicle bus adapter 120C checking for fault codes reported by the vehicle ECUs 103. The vehicle bus adapter 120C translates the messages received from the vehicle bus into the language of the fault detector. It also translates messages from the fault detector into the language of the vehicle bus. **The fault code specifications and protocols of the vehicle may be Original Equipment Manufacturer (OEM) and model dependent.** The term ‘vehicle fault codes’ is meant to be synonymous with the term ‘trouble code’ or ‘diagnostic trouble code’. A listing of such codes may be found in the publication of the Society of

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Automotive Engineers, 'SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual'. The diagnostic data service 120A accepts request for vehicle parametric data and retrieves the data using the vehicle bus adapter." (Emphasis added).), and **"said multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information"**. Thus Chou either implicitly discloses or obviously suggests a "multi-vehicle compatible controller" and such controller is coupled to a vehicle data bus, e.g. 335, 104, for communication thereover, e.g. via 330, 120, with at least one vehicle device, e.g. 103, using at least one corresponding vehicle device code, i.e. (DTC), vehicle fault codes/protocols, which is vehicle model dependent, i.e. from among a plurality thereof for "different vehicles".

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.

See Claim Interpretation/Analysis section, **"a downloading interface..."**. See also, e.g., '499 at Figure 1, element 150, Figure 2, elements 320, 360, Figure 3, elements 102, 107, Figure 4, 102, NETWORK INTERFACE, arrow 7,14 and "HTTP, TCP/IP, PPP/SLIP, DIAL-UP, GSM", and Figure 5, 102, NETWORK INTERFACE, arrow 3,9, arrow 4,7, arrow 5,6 and "HTTP, TCP/IP, PPP/SLIP, DIAL-UP, GSM", col. 3, lines 49-53, col. 4, lines 15-19, and 36-46, col. 6, lines 11-14 and 37-47, col. 7, lines 32-40, col. 8, line 65-col. 10, line 11, and claim 10. See also the discussion of "a wireless communications device" limitation *supra* and claims 2-5 and 8 *infra*. '499 discloses, e.g., interface circuitry, e.g. NETWORK INTERFACE, 320, 107, docking facility, and a temporary wireless communication link, e.g. arrow 7, 14, arrow 3, 9, with

the downloading device, i.e. TCP/IP(an internet/ the Internet), 201, provided by sharing the wireless communications device, e.g. 102, that sends position data, see, e.g. col. 7, lines 32-40, (see also discussion of claims 2-5) and such structure permits downloading of enabling data, e.g. instruction to gather data, vehicle parameter update/change, related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller, e.g. steps 2-6 in Figure 5. Thus '499 discloses or obviously suggests "a downloading interface" and such permits downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.

Claim 4

The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface comprises a wireless signal downloading interface.

See Claim Interpretation/Analysis section and discussion of claim 1 *supra*, "downloading interface for ...controller" and "a wireless communications device" limitation *supra* esp. Figure 1, 150, Figure 2, elements 300, 320, Figs. 3-5, elements 107, 102, arrow 7, 14, arrow 3, 9, col. 3, lines 15-32 ("The processor is integrated with a network interface 320 to provide communication capability with the remote service center 200. Preferably, the network interface comprises a removable wireless telephone such as the Motorola i1000+ and a docking facility for the wireless phone integrated with the client computer device. Both voice and data connections can be supported by interfacing the processor 300 and the wireless phone. The telephone integration provides basic communication functions. It establishes a data (e.g. TCP/IP) connection with a remote service center (e.g., remote service center 200). Wireless technologies such as GSM

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(Global System for Mobile Communications), CDMA (Code Division Multiple Access), TOMA (Time Division Multiple Access), iDEN™ (a TOMA-based Motorola technology), and AMPS (Advanced Mobile Phone System) can all be supported. The phone may also be used for wireless voice communications.” Therefore ‘449 discloses or obviously suggests a wireless signal downloading interface.

Claim 5

The multi-vehicle compatible tracking unit according to claim 4 wherein said wireless signal downloading interface comprises a wireless receiver for temporary connection to a downloading device.

See Claim Interpretation/Analysis section and discussion of claim 1, “downloading interface for ...controller” limitation and “a wireless communications device” limitation, *supra* (e.g. col. 4, lines 39-43, col. 7, lines 32-40 col. 9, lines 1-59, i.e. data link/connection 150, arrows 3,9, 7,14, between wireless phone 102 and server 201 opened and terminated during health checkup process). Therefore ‘499 teaches or obviously suggests a wireless receiver 102 of the wireless signal downloading interface for temporary connection to a downloading device.

Claim 6

The multi-vehicle compatible tracking unit according to claim 1 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

See Claim Interpretation/Analysis section and discussion of claim 1 *supra*, e.g. col. 4, lines 15-38 (“The vehicle bus interface 120 is responsible for replying to requests for parametric data. It is also responsible for continuously monitoring the vehicle bus 104 for any fault reported

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by the ECUs 103, in terms of diagnostic trouble codes (DTCs). The vehicle bus interface 120 includes the following modules: vehicle bus adapter 120C, fault detector 120B, and diagnostic data service 120A. The fault detector 120B polls the vehicle bus 104 through the vehicle bus adapter 120C checking for fault codes reported by the vehicle ECUs 103. The vehicle bus adapter 120C translates the messages received from the vehicle bus into the language of the fault detector. It also translates messages from the fault detector into the language of the vehicle bus. The fault code specifications and protocols of the vehicle may be Original Equipment Manufacturer (OEM) and model dependent. The term 'vehicle fault codes' is meant to be synonymous with the term 'trouble code' or 'diagnostic trouble code'. A listing of such codes may be found in the publication of the Society of Automotive Engineers, 'SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual'. The diagnostic data service 120A accepts request for vehicle parametric data and retrieves the data using the vehicle bus adapter." (Emphasis added).), col. 5, lines 25-28 ("Similar to the health checkup request, the in-vehicle system collects and uploads a snapshot of vehicle data including any trouble code reported by the ECUs."), col. 6, lines 55-58 ("In such a case, for example, one or more diagnostic trouble codes, generated by the vehicles' ECUs 103, are detected in the vehicle bus interface 120 by the fault detector 120B. These trouble codes are sent to the fault monitor 420 component of the vehicle client computer device 101. The fault monitor may further process these trouble codes and finally sends them to the diagnostic client 421." (Emphasis added).), col. 8, lines col. 9, lines 35-48 ("Then in step 2, the diagnostic client 421 initiates a health checkup session with the diagnostic server 201, and in step 3, the diagnostic server instructs the diagnostic client to gather vehicle data, such as VIN, malfunction codes, and/or a snapshot of the

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vehicle data. Then in step 4, the diagnostic client 421 requests the data from the diagnostic data service 120A at the vehicle bus interface 120. Then, in step 5, the diagnostic data service interrogates the ECUs 103 via the vehicle bus adapter 120C for the requested data. In step 6, the ECUs 103 provide the requested data and in step 71 the data is returned to the diagnostic client 421. Then, in step 8, the data is in turn transmitted to the diagnostic server 201.” (Emphasis added).) and paragraph bridging cols. 9-10.

Therefore, since ‘499 discloses or obviously suggests fault codes or DTC reported or generated by the at least one vehicle device, ‘499 discloses or obviously suggests the corresponding at least one vehicle code is for reading from the at least one vehicle device.

Claim 7

The multi-vehicle compatible tracking unit according to claim 1 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

See Claim Interpretation/Analysis section and discussion of claim 6 *supra*. Since ‘499 further teaches or obviously suggests the fault codes/DTCs are Original Equipment Manufacturer (OEM) and/or the interface 120 polls or interrogates the ECUS for malfunction or fault codes, ‘499 discloses or obviously suggest the corresponding at least one vehicle code is for writing to the at least one vehicle device.

Claim 8

The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

See Claim Interpretation/Analysis section and discussion of claim 1 *supra*, e.g. ‘499 at col. 9, lines 28-62 (“Then in step 2, the diagnostic client 421 initiates a health checkup session with the diagnostic server 201, and in step 3, the diagnostic server instructs the diagnostic client to gather vehicle data, such as VIN, malfunction codes, and/or a snapshot of the vehicle data. Then in step 4, the diagnostic client 421 requests the data from the diagnostic data service 120A at the vehicle bus interface 120. Then, in step 5, the diagnostic data service interrogates the ECUs 103 via the vehicle bus adapter 120C for the requested data. In step 6, the ECUs 103 provide the requested data and in step 71 the data is returned to the diagnostic client 421. Then, in step 8, the data is in turn transmitted to the diagnostic server 201.” (Emphasis added).), and Figure 5, arrow 3, 9. Note also the paragraph bridging cols. 9-10. Therefore, ‘499 discloses or obviously suggests the downloading interface, 107/102, receives at least one programming instruction, e.g. data gather instruction, for the controller 300/101.

Claim 11

The multi-vehicle compatible tracking unit according to claim 1 wherein said wireless position determining device comprises a Global Positioning System (GPS) receiver.

See Claim Interpretation/Analysis section and discussion of claim 1, preamble and “a vehicle position determining device” limitation, *supra* (e.g. Figure 1, element 317). Therefore ‘499 discloses a Global Positioning System (GPS) receiver comprising the vehicle position determining device.

Claim 12

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The multi-vehicle compatible tracking unit according to claim 1 further comprising a housing containing said vehicle position determining device, said wireless communications device, said multi-vehicle compatible controller, and said downloading interface.

See '499 at, e.g., elements 10, elements 317 and 101 inside box designated 100 "IN-VEHICLE SYSTEM", Figure 2, col. 2, lines 55-56, col. 3, lines 15-61, Figure 3, element 100 "IN VEHICLE SYSTEM" and col. 4, lines 5-9. Therefore, '499 discloses or obviously suggests a housing, e.g. 10, "IN VEHICLE SYSTEM", containing said vehicle position determining device, said wireless communications device, said multi-vehicle compatible controller, and said downloading interface.

Claim 18

A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible vehicle tracking unit comprising: a vehicle position determining device; a wireless communications device; a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information; said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller; said downloading interface comprising a wireless receiver for temporary connection to a downloading device.

See discussion of claims 1 and 4-5 *supra*.

Claim 19

The multi-vehicle compatible tracking unit according to claim 18 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

See discussion of claim 6 *supra*.

Claim 20

The multi-vehicle compatible tracking unit according to claim 18 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

See discussion of claim 7 *supra*.

Claim 21

The multi-vehicle compatible tracking unit according to claim 18 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

See discussion of claim 8 *supra*.

Claims 9-10 and 22 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,330,499 to Chou et al (hereinafter also referred to as '499 or Chou) in view of U.S. Patent No. 6,028,537 to Suman et al, (hereinafter also referred to as '537 or Suman).

The patent to Suman includes a/an publication/issue date more than one year prior to the effective filing date of June 3, 2007 of '278, and thus are available as prior art under 35 USC 102(b) and 35 USC 103.

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Claim 9

The multi-vehicle compatible tracking unit according to claim 1 further comprising a remote transmitter;

See *Claim Interpretation/Analysis* section and discussion of claims 1 and 8 *supra*, '499 at, e.g., col. 3, lines col. 4, lines 39-42 ("The client computer device 101 performs several functions including communicating to the remote service center 200 by means of the network interface 107 using the cell phone 102."), col. 5, lines 1-3 ("The in-vehicle system establishes a data connection, using a cellular phone 102, with a diagnostic server at the service center 200,...), col. 7, lines 32-40 ("In this case, a data communication link is established through the network interface 320 to the service center 200, and data containing fault codes, DTCs, vehicle parameter values, and vehicle ID information, is sent to the diagnostic server 201. The size of the data stream is estimated to be on the order of 1 kilobyte. Optional information includes a callback number, GPS coordinates, etc. The exchange of information may be repeated more than once before the data link is closed."), col. 9, lines 28-62 ("Referring now to FIG. 5, a health checkup event flow is presented. The numbers of the steps refer to the numbers found in the flow, as shown in FIG. 5.... Then in step 2, the diagnostic client 421 initiates a health checkup session with the diagnostic server 201, and in step 3, the diagnostic server instructs the diagnostic client to gather vehicle data, such as VIN, malfunction codes, and/or a snapshot of the vehicle data. Then in step 4, the diagnostic client 421 requests the data from the diagnostic data service 120A at the vehicle bus interface 120. Then, in step 5, the diagnostic data service interrogates the ECUs 103 via the vehicle bus adapter 120C for the requested data. In step 6, the ECUs 103 provide the requested data, and in step 7, the data is returned to the diagnostic client

421. Then, in step 8, the data is in turn transmitted to the diagnostic server 201.... The diagnostic server 201 prepares a report and transmits it to the client computer 101.... Thereafter, the data connection is terminated. The above-described health checkup process may be completely automated without intervention or involvement by a person at the remote service center.”), Figures and claim 1 (“...a communication system, coupled to said client computer device, for providing remote communication of data including data derived from said monitoring systems of the vehicle; and a remote service center including a vehicle data store, a server computer, a diagnostic engine, and a communicator for communicating the results of analysis of vehicle information to said client computer device via said communication system, ...”). Therefore ‘499 discloses a remote transmitter, e.g., a communicator of the remote service center. See also the remainder of the discussion of this claim.

and wherein said multi-vehicle compatible controller also performs at least one vehicle remote control function responsive to said remote transmitter.

See discussion of this claim *supra* and, e.g., col. 9, line 63-10, line 11 (“The present invention is not limited to the scenarios and embodiments listed above, but instead may be practiced with a plurality of modifications and extensions. For example, remote health monitoring and diagnostics shares many features with other automotive applications and services. It may be desirable to bundle the remote health monitoring and diagnostics with other services or to extend it with related application functions. For example, the remote diagnostics service could certainly be offered on top of an Emergency/Mayday service (e.g., ‘OnStar’). Other applications and services that can be developed or bundled as extensions of the diagnostics services include: breakdown service, network diary, vehicle user manual update, OEM Callback

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Services, fleet management, theft prevention, vehicle parameter update/change, remote vehicle access, concierge services, etc.”). Therefore at the very least ‘499 suggests the controller, i.e. in-vehicle client computer device 101 and vehicle bus connected interface 120, performing functions, e.g. requests for diagnostic data, responsive to a remote transmitter and remote health/diagnostic services may be practiced/bundled with other services or extensions such as remote vehicle access. However ‘537 not only teaches a diagnostic system connected to the vehicle bus for remote diagnostics to be performed on the vehicle but also providing remote control to the vehicles accessories in response to a transmitted control signal from a service center, see, e.g., col. 15, line 52-col. 16, line 15 and Fig. 4. Therefore to employ the multi-vehicle compatible controller responsive to a remote transmitter, e.g. the communicator of the remote service center, in ‘499, if not already, as known from ‘537 to in order to provide the desired remote vehicle access, e.g. door unlocking, i.e. at least one vehicle remote control function, would have been obvious to one of ordinary skill in the art. Therefore the prior art obviously teaches said multi-vehicle compatible controller also performing at least one vehicle remote control function responsive to said remote transmitter.

Claim 10

The multi-vehicle compatible tracking unit according to claim 9 wherein the at least one vehicle remote control function comprises at least one of a vehicle security function, a remote keyless entry function, and a remote engine starting function.

See discussion of claim 9 *supra*, e.g. the prior art teaches the at least one vehicle remote control function of remote keyless entry.

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Claim 22

The multi-vehicle compatible tracking unit according to claim 18 further comprising a remote transmitter; and wherein said multi-vehicle compatible controller also performs at least one vehicle remote control function responsive to said remote transmitter.

See discussion of claim 9 *supra*.

Claims 2-3 and 13-16 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,330,499 to Chou et al (hereinafter also referred to as '499 or Chou) in view of U.S. Patent No. 5,732,074 to Spaur et al (hereinafter also referred to as '074 or Spaur).

The patent to Spaur includes a/an publication/issue date more than one year prior to the effective filing date of June 3, 2007 of '278, and thus are available as prior art under 35 USC 102(b) and 35 USC 103.

Claim 2

The multi-vehicle compatible tracking unit according to claim 1 wherein said downloading interface comprises a wired signal downloading interface.

See discussion of “a downloading interface...” and Claim Interpretation/Analysis section *supra*, e.g. Figure 2, elements 320 and 300, col. 2, lines 59-63 (“FIG. 2 is a block diagram providing an exemplary component overview for the in-vehicle hardware. The in-vehicle hardware provides a platform for the client computer device 101 and for the system functions shown in the architectural design in FIG. 3. As shown in FIG. 2, the in-vehicle hardware includes a processor 300 coupled with memory 350, a user interface 310, a network

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interface 320, a vehicle interface 330, at least one persistent storage device 340, and optional external devices 360.”), col. 3, lines 16-32 (“The processor is integrated with a network interface 320 to provide communication capability with the remote service center 200. Preferably, the network interface comprises a removable wireless telephone such as the Motorola i1000+ and a docking facility for the wireless phone integrated with the client computer device. Both voice and data connections can be supported by interfacing the processor 300 and the wireless phone. The telephone integration provides basic communication functions. It establishes a data (e.g. TCP/IP) connection with a remote service center (e.g., remote service center 200). Wireless technologies such as GSM (Global System for Mobile Communications), CDMA (Code Division Multiple Access), TDMA (Time Division Multiple Access), iDEN.TM. (a TDMA-based Motorola technology), and AMPS (Advanced Mobile Phone System) can all be supported. The phone may also be used for wireless voice communications.”), col. 3, last paragraph, col. 4, lines 7-9, Figure 3, “NETWORK INTERFACE” 107, and col. 4, lines 39-43. This claim requires the downloading interface comprising a wired signal downloading interface. While ‘499 teaches the signal downloading interface 320, 107, 102 coupled to the processor 300 and comprising a docking facility “integrated” with the computer device and a removeable cellular phone, it does specifically teach the interface being “wired”. See however ‘074 at, e.g., Figure 2, elements 80-82, 30 and col. 7, lines 45 et seq and thereby, ‘177 at, e.g., Figures 4 and 7, abstract, lines 1-5, col. 1, first and third full paragraphs, col. 2, lines 4-16, col. 3, second full paragraph, col. 5, lines 60-62, i.e. a known cellular phone/controller/processor interface which is wired. Therefore it would have been obvious to one of ordinary skill in the art to substitute a wired cellular phone interface, e.g., a connector/cable to removeably attach 102 and 107, for the ‘499 cellular phone

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interface, if such is not already “wired”, for the predictable result of interconnecting the cellular phone and processor/computer. Therefore the prior art obviously teaches the “downloading interface” comprises a wired signal downloading interface.

Claim 3

The multi-vehicle compatible tracking unit according to claim 2 wherein said wired signal downloading interface comprises a connector for temporary connection to a downloading device.

See Claim Interpretation/Analysis section and discussion of claims 1-2 *supra*, e.g., Fig. 3, elements 102 and 107, i.e. cell phone attached to network interface, and col. 3, lines 17-21 and cited portions of ‘074 and ‘177. The prior art obviously teaches a connector for temporary connection between 107 and 102 and thereby, the wired signal downloading interface comprising a connector for temporary connection to a downloading device, e.g. an internet, the Internet.

Claim 13

A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible vehicle tracking unit comprising: a vehicle position determining device; a wireless communications device; a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information; said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller; said downloading interface comprising a connector for temporary connection to a downloading device.

See discussion of claims 1-3 *supra*.

Claim 14

The multi-vehicle compatible tracking unit according to claim 13 wherein the corresponding at least one vehicle code is for reading from the at least one vehicle device.

See discussion of claim 6 *supra*.

Claim 15

The multi-vehicle compatible tracking unit according to claim 13 wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device.

See discussion of claim 7 *supra*.

Claim 16

The multi-vehicle compatible tracking unit according to claim 13 wherein said downloading interface is also for permitting downloading of at least one programming instruction for said multi-vehicle compatible controller.

See discussion of claim 8 *supra*.

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Claim 17 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,330,499 to Chou et al (hereinafter also referred to as '499 or Chou) in view of U.S. Patent No. 6,028,537 to Suman et al, (hereinafter also referred to as '537 or Suman) and U.S. Patent No. 5,732,074 to Spaur et al (hereinafter also referred to as '074 or Spaur).

Claim 17

The multi-vehicle compatible tracking unit according to claim 13 further comprising a remote transmitter; and wherein said multi-vehicle compatible controller also performs at least one vehicle remote control function responsive to said remote transmitter.

See discussion of claim 9 *supra*.

EXHIBIT 7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of KENNETH E. FLICK	)	
	)	
Request for Reexamination of	)	
U.S. PATENT NO. 8,032,278	)	
	)	
Control No. 90/013,851	)	Attorney Docket No.:
	)	C13-03895(58106CIP1_REX2)
Confirmation No. 8717	)	
	)	Examiner: K. REICHLE
Filing Date: OCTOBER 28, 2016	)	
	)	Art Unit: 3992
For: VEHICLE TRACKING UNIT WITH	)	
DOWNLOADABLE CODES AND	)	
ASSOCIATED METHODS	)	
	)	

CORRECTED REPLY BRIEF AND FILING UNDER 37 C.F.R. §1.565(a)

MAIL STOP EX PARTE REEXAM

Commissioner for Patents

Commissioner:

Herewith is the Patent Owner's Corrected Reply Brief that is submitted in reply to the Examiner's Answer and in furtherance to Patent Owner's Appeal Brief. The Corrected Reply Brief corrects the header error in the original Reply Brief. If any additional extension and/or fee is required, authorization is given to charge Deposit Account No. 08-0870.

First Named Inventor:
Kenneth E. FLICK
Reexamination Serial No. 90/013,851
Filed: **OCTOBER 28, 2016**

REMARKS

The Examiner is again thanked for the thorough examination of the present application, and for the Examiner's Answer mailed May 14, 2018, including the Response to Argument section. The Patent Owner updates the status of the related applications and litigations, and offers the following arguments for consideration by the Patent Trial and Appeal Board.

I. Update for Related Applications and Litigations

Pursuant to 37 C.F.R. §1.565(a), the Patent Owner has continued to inform the USPTO of the status of related and concurrent proceedings, both within the USPTO and judicial proceedings outside the USPTO.

To that end, in the related litigation between the Patent Owner and Requester, Calamp, which ultimately resulted in a rejection of the Requester's invalidity arguments and a finding of willful infringement, the Requester has on April 20, 2018 filed its appeal brief with the Court of Appeals for the Federal Circuit. The Patent Owner filed its responsive brief on May 30, 2018, and the Requester filed a reply brief on July 2, 2018. The Requester's briefs in the litigation raise no issues with respect to validity of any of the asserted patents (including the '278 patent) in view of the prior art carefully selected and presented at trial.

A second litigation against Enfora, Inc. is currently stayed pending the outcome of this reexamination.

Given the duplicative and sequential nature of the Requester's ex parte reexamination requests, the Patent Owner has provided below a chart for updating the USPTO proceedings.

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Serial No.	Filing Date	Issued	Patent No.	Status
90/013,659	12/11/15	9/1/17	6,346,876 C1	Ex Parte Reexamination Certificate Issued 9/1/17
90/014,122	4/19/18			Reexamination Ordered 5/2/18
90/013,741	4/28/16	8/1/17	6,756,885 C1	Ex Parte Reexamination Certificate Issued 8/1/17
90/014,038	10/26/17			Office action mailed 5/4/18; Response due 8/4/18
90/013,587	9/14/15	12/28/16	8,032,278 C1	Ex Parte Reexamination Certificate Issued 12/28/16
90/013,851	10/28/16			The Present Reexamination
90/013,832	10/12/16	8/1/17	7,671,727 C1	Ex Parte Reexamination Certificate Issued 8/1/17
90/014,121	4/10/18			Reexamination Ordered 5/16/18

The Patent Owner submits that the Requester's duplicative and harassing efforts are improper. The Requester, having failed in its initial round of *ex parte* reexamination requests for the litigated patents, is now on to round two. In addition, Patent Owner notes that two of the patents in round two of Requester's filings, the '885 and '876 patents, are already expired.

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The Examiner contended that the Patent Owner's only possible remedy for such harassment would have been via a petition that needed to be filed upon the order granting reexamination. Patent Owner points out that Requester's harassing efforts have been ongoing and many occurred after that time.

The Patent Owner submits that such sequential/serial requests for *ex parte* reexamination are a waste of USPTO resources. The Patent Owner submits that the Requester is abusing USPTO procedures in a fashion that is fundamentally unfair to the Patent Owner.

II. The Examiner's Interpretation of the Claims Is In Error

A. Overview

Independent Claims 1, 13 and 18 are rejected as anticipated by Chou et al. or as obvious in view Chou et al. The Chou et al. patent was cited in the parent (7,720,597), grandparent (7,149,623), and great-grandparent (6,606,561) of the present '278 patent. Chou et al. would also have been considered by the Examiner in the '278 patent original prosecution per the MPEP requirement for the Examiner to consider such prior art. Chou et al. would have been known by Requester, Calamp, in the related litigation, but was passed over in favor of other references by Calamp during the litigation, and was also passed over in the first reexamination request of the '278 patent filed by Calamp.

Chou et al. is not an unusually long or complicated reference. Its teachings are straightforward. It includes five drawing figures of which Figures 3, 4 and 5 are essentially the

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same, but show signal propagation based upon different scenarios. There are roughly eight columns of text in the detailed description of Chou et al.

Independent Claim 1, for example, of the '278 patent is directed to a vehicle tracking unit that includes three indented sections describing two claim elements that are at issue: the multi-vehicle compatible controller, and the downloading interface. The Patent Owner asserts that the Examiner's claim construction, including these claim terms, is incorrect.

The Patent Owner also submits that Chou et al. fails to disclose the claimed vehicle tracking unit including the multi-vehicle compatible controller and the downloading interface, as these terms are properly construed.

When evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation, that is, the claim as a whole must be considered. The Examiner's reading of the claim elements improperly dissects the claimed invention into discrete elements of a "multi-vehicle compatible controller", and a "downloading interface" and evaluates those elements in isolation. The Patent Owner submits that the multi-vehicle compatible controller must be interpreted with respect to the other recitations and elements in the claim, notably its cooperation with the downloading interface and the use of enabling data.

The Patent Owner respectfully submits that the Examiner cannot parse the claim so that the multi-vehicle

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controller is only defined by the language appearing in the clause "said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles". The claimed downloading interface permits downloading of enabling data related to the at least one corresponding vehicle device for use by the multi-vehicle compatible controller.

It is the claimed combination of the multi-vehicle compatible controller and the downloading interface along with the enabling data, and the associated recitations, that provide compatibility among vehicles of different manufacturers and/or different product lines of the same manufacturer, as noted in the specification of the '278 patent.

B. "Different Vehicles" Is Improperly Construed

Independent Claim 1, for example, recites: "said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles". In the Examiner's Answer, applying the broadest reasonable interpretation (BRI) standard, the Examiner contended that:

the language of the phrase does not require compatibility among vehicles of different manufacturers and/or different "product" lines of the same manufacturer. See the FINAL Office action at attached Appendix A, first full paragraph of page 11, i.e. "different vehicles" can be, e.g., same make and model with different trims (not

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different electronics). Note also attached Appendix A, pages 18-23 and 33-35, in their entirety, as well as the Markman Order agreed construction of the claim term "Multi-vehicle compatible controller" during the related litigation [cite omitted], Evidence Appendix Item 8, page 6, showing "multi-vehicle compatible controller" was construed as electronic circuitry that "can operate with more than one vehicle". (Examiner's Answer, pages 4-5: emphasis added).

The Patent Owner respectfully submits that this interpretation of the above noted claim recitation is erroneous. In short, the Examiner has contended that different vehicles can broadly equate with different vehicles of the same make and model, i.e. having identical electronics ("not different electronics"). By identical electronics, the Examiner must mean electronics operating with the same vehicle device codes.

The Federal Circuit established that claims in reexaminations should be given their "broadest reasonable interpretation, consistent with the specification". *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984); and see also MPEP §2258. In the present patent, the specification recites:

[a] number of patents disclose various security and control systems that address data bus interoperability. For example, 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.

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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. (Col. 2, lines 17-37).

The '551 patent recites: "[a]s would be readily understood by those skilled in the art, the term different vehicles may include vehicles from different manufacturers, different models, or even different trim levels of the same make and model." (Col. 6, lines 38-42). The Patent Owner submits that interpreting "different vehicles" to include vehicles with identical electronics (using the same vehicle codes) would make no sense to one of skill in the art in view of the specification.

Moreover, such an interpretation is inconsistent with the claims which recite that the multi-vehicle compatible controller is for communication over the vehicle data bus "with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles". The Examiner's interpretation also renders the recitation of "multi-vehicle compatible controller" in the

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claims as meaningless - another indicator of an improper claim construction.

The Patent Owner submits that the Examiner's unreasonably broad interpretation of the claims is in error as it is not consistent with the specification or consistent with the claim language of the '278 patent.

C. The Functional Language Is Entitled to Patentable Weight

Independent Claim 1, for example, recites:

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles;

...
a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.
(Emphasis added).

Regarding the multi-vehicle compatible controller of the claims, applying the BRI standard, the Examiner contended that: "[t]he phrase requires of corresponding structure merely the capability of using at least one code from among a plurality thereof for 'different vehicles', see again attached Appendix A, pages 11 and 33-35 of the Appendix A, i.e. teaching of such a capability by '499, i.e. capable of using a code from among a plurality thereof, i.e. model dependent." (Examiner's Answer, page 5: emphasis added).

Regarding the downloading interface of the claims, applying the BRI, the Examiner contended that: "the function or

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capability of the corresponding structure as 'permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller'." (Examiner's Answer, page 5: emphasis added).

Given the Examiner has issued integrated §102/103 rejections of the same claims, the Patent Owner submits that the Examiner appears to be dismissing the patentable weight of the claimed functional recitations, contending these features are somehow inherent to Chou et al., or that the mere capability of Chou et al.'s system of performing the claimed features would meet the bounds of the claims.

For the §102 rejections, the Patent Owner notes that if a claim element is not expressly disclosed by the prior art, the prior art reference must inherently disclose the claim element to anticipate it. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). The court went on to state that:

[t]o establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). *Id.* at 745. (Emphasis added).

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The Patent Owner submits that Chou et al. teaches that the ability to work with different vehicle device codes is provided at the remote service center using the diagnostic server 201 in combination with the data repository 203 (Figure 1) also at the remote service center - and not at the vehicle. Chou et al. provides no disclosure, express or inherent, and no reason, for this capability to be provided at the in-vehicle system.

III. The Admitted Evidence of Secondary Considerations and Declaratory Evidence is Persuasive

The Patent Owner submits that the admitted evidence of secondary considerations properly rebuts the Examiner's contentions of obviousness based upon Chou et al. Indeed, the Patent Owner has submitted evidence of Licensing, Commercial Success, Copying by Others, Customer Need (as noted by Requester's own employee under oath), and Limited Value for Products Without the Invention (as noted by Requester's own employee under oath). Moreover, notwithstanding the contentions of the Examiner in the Examiner's Answer, the Patent Owner has also introduced substantial evidence demonstrating nexus between the evidence and the claimed invention.

The Patent Owner has also submitted evidence from its trial expert, Mr. Joseph McAlexander, having a strong technical background in the relevant technology. Mr. McAlexander details the basis for his conclusions, and such should also be given full consideration.

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**IV. The Claims Are Patentable Over Chou et al. and the Other
Prior Art**

The Patent Owner submits that the Examiner has used an improperly broad claim construction. Chou et al. fails to disclose the claimed invention. The Patent Owner submits that independent Claims 1 and 18 are patentable over Chou et al. Spaur et al. is cited for the teaching of a wired connection in the rejection of independent Claim 13, and, the Patent Owner submits that Spaur et al. adds nothing to the deficiencies of Chou et al. Accordingly, independent Claim 13 is also patentable. In view of the patentability of the independent Claims 1, 13 and 18, it is submitted that their dependent claims are also patentable, and require no further discussion herein.

V. CONCLUSION

In view of the foregoing arguments, it is submitted that all of the claims are patentable over the prior art. Accordingly, the PTAB is respectfully requested to reverse the earlier unfavorable decision by the Examiner.

Respectfully submitted,
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CERTIFICATE OF SERVICE

Certificate of Service in compliance with 37 C.F.R. §1.530(c)

Pursuant to 37 C.F.R. §§1.530(c), 1.248, I hereby certify that on August 16, 2018, a complete copy of this Filing is being served via First Class U.S. Mail upon Third Party Requester at the correspondence address as shown in PAIR:

KPPB LLP
2400 EAST KATELLA AVENUE
SUITE 1050
ANAHEIM, CA 92806

Respectfully submitted,

/JACK ABID/

Jack Abid

EXHIBIT 6



UNITED STATES PATENT AND TRADEMARK OFFICE

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90/013,851	10/28/2016	8032278	C13-03896.RE2	8717

7590 11/13/2018
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EXAMINER
REICHLE, KARIN M

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
11/13/2018	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OMEGA PATENTS, L.L.C.
Patent Owner and Appellant

Appeal 2018-008119
Reexamination Control 90/013,851
United States Patent 8,032,278 B2
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and ERIC B. CHEN,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Patent Owner appeals under 35 U.S.C. §§ 134 and 306 the Examiner's decision to reject claims 1–22. We have jurisdiction under 35 U.S.C. §§ 134 and 306, and we heard the appeal on October 31, 2018. We reverse.

STATEMENT OF THE CASE

This proceeding arose from a request for *ex parte* reexamination filed on October 28, 2016 of United States Patent 8,032,278 (“the ’278 patent”), issued to Kenneth E. Flick on October 4, 2011.

The ’278 patent describes a tracking unit that is compatible with multiple vehicles. To this end, the tracking unit includes a multi-vehicle compatible controller that communicates with a vehicle device using a corresponding vehicle device code from among plural codes. The unit also has a downloading interface that permits downloading enabling data related to the corresponding vehicle device code, where enabling data may be (1) the vehicle device code; (2) an instruction to select a code from among those already stored; or (3) the data or sequence to allow the controller to generate the vehicle device code. *See generally* ’278 patent, Abstract; col. 23, l. 41 – col. 24, l. 4.

Claim 1 is illustrative of the invention and is reproduced below:

1. A multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible tracking unit comprising:
 - a vehicle position determining device;
 - a wireless communications device;
 - a multi-vehicle compatible controller for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information;

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles; and

a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller.

RELATED PROCEEDINGS

This appeal is said to be related to various proceedings. First, Appellant informs us that briefs have been filed with the Court of Appeals for the Federal Circuit in connection with related litigation between Patent Owner and Requester (CalAmp). App. Br. 7–8; Reply Br. 2.¹ Also, a second litigation against Enfora, Inc. is said to be stayed pending the outcome of this reexamination. App. Br. 9; Reply Br. 2.

Appellant also informs us of seven other *ex parte* reexamination proceedings involving four patents, one of which (Control No. 90/013,587) resulted in issuing a reexamination certificate confirming patentability of the '278 patent's claims. See App. Br. 9–12; Reply Br. 3; *see also* US 8,032,278 C1, issued Dec. 28, 2016.

THE REJECTIONS

The Examiner rejected claims 1, 4–8, 11, 12, and 18–21 under 35 U.S.C. § 102(b) as anticipated by Chou (US 6,330,499 B1; issued Dec.

¹ Throughout this opinion, we refer to (1) the Appeal Brief filed February 27, 2018 (“App. Br.”); (2) the Examiner’s Answer mailed May 14, 2018 (“Ans.”); and (3) the Reply Brief filed July 13, 2018 (“Reply Br.”).

11, 2011), or, alternatively, under 35 U.S.C. § 103 as obvious over Chou.
Ans. 30–42.

The Examiner rejected claims 9, 10, and 22 under 35 U.S.C. § 103 as obvious over Chou and Suman (US 6,028,537; issued Feb. 22, 2000). Ans. 42–46.

The Examiner rejected claims 2, 3, and 13–16 under 35 U.S.C. § 103 as obvious over Chou and Spaur (US 5,732,074; issued Mar. 24, 1998). Ans. 46–49.

The Examiner rejected claim 17 under 35 U.S.C. § 103 as obvious over Chou, Suman, and Spaur. Ans. 50.

PROCEDURAL MATTERS

Before addressing the merits of the Examiner’s rejections at issue in this appeal, we first address several procedural matters. First, Appellant’s contention that the Examiner improperly refused to enter various exhibits attached to the Final Office Action (App. Br. 16–19) is a petitionable—not appealable—matter and is, therefore, not before us.² *Accord* Ans. 3 (noting this petitionable matter).

We reach the same conclusion regarding Appellant’s contention that the present reexamination was allegedly improperly granted. App. Br. 54–

² See MPEP § 706.01 (“[T]he Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board.”); *see also* MPEP § 1201 (“The Board will not ordinarily hear a question that should be decided by the Director on petition . . .”).

61. To be sure, the propriety of an Examiner's determination that a substantial new question of patentability (SNQ) exists in an *ex parte* reexamination proceeding is appealable to this Board so long as certain procedural requirements are satisfied. *See* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2274(VI) (9th ed. Rev. 08.2017, Jan. 2018).

But that is not the case where, as here, Appellant does not squarely address—let alone persuasively rebut—the Examiner's SNQ determination. *See* App. Br. 54–61. Rather, Appellant argues that due to the alleged inequities of multiple reexamination requests against the same claims of the same patent in this proceeding, we should apply a standard similar to that used by the Board in deciding to institute trials for follow-on petitions in *inter partes* review proceedings. *See id.*

We decline to do so here. Not only are Appellant's procedural grievances petitionable matters, they do not show error in the Examiner's SNQ determination. To the extent Appellant contends otherwise, we disagree.

THE OBVIOUSNESS REJECTION OVER CHOU

The Examiner finds that Chou discloses or suggests every recited element of independent claim 1 including a multi-vehicle compatible controller (e.g., processor 300 and memory 350) to be coupled to a vehicle data bus 140 for communication thereover with at least one vehicle device (electronic control unit (ECU) 103) using at least one vehicle device code, namely a diagnostic trouble code (DTC) or fault code, from among a plurality thereof for different vehicles. Ans. 31–35. The Examiner reasons

that because Chou's fault code is vehicle model dependent, the code can be used by the vehicle device from among plural such codes. *See* Ans. 4–5, 35. The Examiner adds that Chou also discloses or suggests a downloading interface (e.g., network interface 107, 320) for permitting downloading “enabling data” (e.g., instructions to gather data and vehicle parameter changes) related to at least one corresponding vehicle device code for use by the controller. Ans. 35–36.

Appellant argues that Chou does not teach or suggest the recited multi-vehicle compatible controller and downloading interface. App. Br. 19–35; Reply Br. 4–11. Although Appellant acknowledges that Chou's vehicle-dependent fault codes are listed in a Society of Automotive Engineers (SAE) publication, Appellant nonetheless emphasizes that these codes lack uniformity between manufacturers, and even within product lines of the same manufacturer—a problem that is said to be addressed by the claimed invention. App. Br. 24–26. According to Appellant, the Examiner's equating different vehicles in the context of the claimed invention to those of the same make and model, namely vehicles with identical electronics and vehicle codes, but with different trims, is inconsistent with the disclosure and, therefore, unreasonable. Reply Br. 6–9.

Appellant also argues that Chou does not teach or suggest the recited downloading interface, but rather merely passes data between an in-vehicle system and a remote service center. App. Br. 25–29. According to Appellant, Chou teaches away from the claimed invention by working with different vehicle codes at the service center—not the vehicle. App. Br. 35–38. Appellant adds that evidence of secondary considerations of non-

obviousness, including licensing, commercial success, copying by others, customer need, and the limited value for accused products without the invention, further rebuts the Examiner's obviousness rejection. App. Br. 38–54; Reply Br. 11.

ISSUE

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Chou would have taught or suggested the recited multi-vehicle compatible controller and downloading interface?

ANALYSIS

We begin by construing a key disputed limitation of claim 1 which recites, in pertinent part, a multi-vehicle compatible controller. The Specification does not define the term, but does describe a multi-vehicle compatible controller 111 in Figure 10 that includes, among other things, a central processing unit 126 and input/output (I/O) circuitry 127 that interfaces with a vehicle device 121 using at least one corresponding vehicle device code from plural codes for different vehicles. '278 patent, col. 23, ll. 59–67. The corresponding vehicle code may be for reading from, or writing to, the vehicle device. *Id.* col. 23, l. 67 – col. 24, l. 3.

In related litigation involving the '278 patent, a U.S. District Court construed the term “multi-vehicle compatible controller” as “electronic circuitry that performs one or more control functions, and can operate with more than one vehicle”—a construction that neither party disputed. *See Omega Patents, LLC v. CalAmp Corp.*, No. 6:13-cv-1950-Orl-40DAB,

(M.D. Fla. Feb. 20, 2015) (“Dist. Ct. Claim Construction Order”), at 6, 24, *cited in* App. Br. Rel. Proc. App. (“Item 8”). Although we apply a claim construction standard in *ex parte* reexamination proceedings different from that used by the court, we nonetheless find that the court’s construction is consistent with the term’s broadest reasonable interpretation in light of the Specification. *Accord Power Integrations, Inc. v. Lee*, 797 F.3d 1318, 1326–27 (Fed. Cir. 2015) (emphasizing the Board’s obligation to (1) evaluate a district court’s claim construction for terms at issue, and (2) determine whether that construction is consistent with the term’s broadest reasonable interpretation).

Claim 1 further recites that the multi-vehicle compatible controller can communicate with at least one vehicle device using at least one corresponding vehicle device code from among plural device codes for different vehicles. The district court construed the term “device codes” as “signal from a vehicle device,” Dist. Ct. Claim Construction Order at 17, 25—a construction that is likewise consistent with its broadest reasonable interpretation. Although the court did not construe the term “different vehicles,” the ’278 patent in column 22, lines 3 to 7 incorporates by reference a related patent, namely U.S. Patent No. 5,719,551 (“the ’551 patent”), which explains that “the term different vehicles may include vehicles from different manufacturers, different models, or even different trim levels of the same make or model.” ’551 patent, col. 6, ll. 38–42. *Accord* Reply Br. 8 (acknowledging this explanation).

The term “trim level” in a vehicular context refers to a version of a vehicle model that comes equipped with a set combination of features. *See*

What is a Vehicle Trim Level?, THE NEWSWHEEL,
<http://thenewswheel.com/what-is-a-vehicle-trim-level> (Oct. 27, 2017)
("Newswheel"). In defining "trim level," this article explains that although trim packages previously were typically purely aesthetic and only added non-functional touches like chrome accents and upholstery stitching, many automakers today include sets of higher-technology features and/or performance upgrades in trim packages, resulting in offering as many as 6–10 different trim levels for a given vehicle model. *Id.*

Although the Examiner construes the recited term "different vehicles" to include vehicles that are the same make and model but with different trims consistent with the '551 patent, the Examiner nonetheless includes vehicles whose *electronics are not different* as "different vehicles." *See* Ans. 4.

We find this construction problematic on this record. To be sure, Newswheel indicates that differences among trim packages were formerly purely aesthetic and non-functional, thus suggesting that the electronics in these vehicles in these different trim packages would be the same despite the vehicles' aesthetic differences.

But as Appellant indicates (Reply Br. 6–9), vehicles with identical electronics would use the same vehicle codes and, therefore, their inclusion runs counter to the functionality of the recited *multi-vehicle compatible* controller that can communicate with a vehicle device using at least one corresponding vehicle device code *from among plural codes for different vehicles*. Indeed, this compatibility with different vehicles and their different codes is a fundamental aspect of the claimed invention that solves a

longstanding problem in the art as Appellant indicates. *See* App. Br. 32 (noting that the lack of vehicle code compatibility among different vehicles for vehicle tracking units is the problem addressed by the '278 patent). To the extent that the Examiner construes the different vehicles in claim 1 to include those with the same vehicle codes, we find such a construction unreasonable when interpreted in light of the Specification.

In reaching this conclusion, we emphasize that the broadest reasonable interpretation in light of the Specification is not whether the Specification precludes some broad reading of the claim term adopted by the Examiner. *See In re Smith Int'l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017). Nor is the broadest reasonable interpretation simply one that is not inconsistent with the Specification. *Id.* at 1383. Rather, it is an interpretation that corresponds with what and how the inventor describes his invention in the Specification, that is, an interpretation consistent with the Specification. *Id.* (citing *In re Suitco Surface*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010)).

Therefore, we find the Examiner's reliance on Chou for teaching the recited multi-vehicle compatible controller problematic on this record. In Chou, a vehicle's ECUs 103 (which the Examiner maps to the recited "vehicle device" (*see* Ans. 35)) report fault codes to fault detector 120B via vehicle bus 140 and vehicle bus adapter 120C, the latter translating messages received from the bus into the language of the fault detector and vice-versa. Chou, col. 4, ll. 20–28; Fig. 3. Although these fault codes' specifications and protocols depend on the manufacturer and vehicle model,

and the codes are listed in an SAE publication,³ that does not mean that Chou's controller is *compatible with multiple vehicles*, where the controller can communicate with a vehicle device using at least one corresponding vehicle device code from among plural codes for different vehicles as claimed. Indeed, this very SAE publication acknowledges the lack of uniformity in these codes between manufacturers and, in some cases, within the same manufacturer across different product lines. *See* App. Br. 26–27, 32 (quoting a passage from page 39 of the SAE HS-3000 manual). *Accord* Declaration by Joseph C. McAlexander, III Under 37 C.F.R. § 1.132, dated June 12, 2017 (“2017 McAlexander Decl.”) ¶ 13 (quoting this passage). *See also* Rule 132 Declaration by Michael J. Suman, dated July 5, 2016 (“Item 4”) (“Suman Decl.”) ¶¶ 11–12 (declaring that, at the time of his U.S. Patent 6,028,537 whose provisional application was filed June 14, 1996, vehicle device codes were (1) proprietary to different manufacturers, (2) not made freely available, and (3) difficult to obtain). *Accord* Rule 132 Declaration By Joseph C. McAlexander, III, dated July 6, 2016 (“Item 5”) (“2016 McAlexander Decl.”) ¶ 10 (corroborating this testimony).

At best, Chou's controller is compatible with *one* vehicle, namely the particular vehicle whose fault codes correspond to that particular vehicle for which the controller was designed. *Accord* App. Br. 32 (noting that Chou's ECUs use their own respective trouble codes that are different for different vehicles). Although Chou's remote service center can work with different

³ Chou refers to this publication as “SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual.” Chou, col. 4, ll. 33–36. For brevity and consistency, we refer to this manual consistent with Appellant's nomenclature, namely “SAE HS-3000.” *See* App. Br. 25.

vehicle device codes using a server 201 and repository 203 in Figure 1 as Appellant acknowledges (App. Br. 37), Chou does not teach or suggest providing such a capability in a vehicle.

Nor do we find that Chou teaches or suggests the recited 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. In the related litigation, the District Court did not construe the term “downloading interface,” but did construe the term “enabling data” as data relating to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller—a construction that matches the terms in the claim. *See* Dist. Ct. Claim Construction Order at 20–23, 25.

According to the Specification, enabling data *may be, for example*, (1) the vehicle device code or codes; (2) an instruction to select a code or codes from among those already stored; or (3) the data or sequence to allow the controller 111 to generate the vehicle device code or codes. ’278 patent, col. 24, ll. 9–13. Our emphasis on the permissive and exemplary language in this passage underscores that enabling data is not limited to these three alternatives.

But despite this non-limiting description, what is clear from Appellant’s disclosure is that downloading enabling data via the recited interface enables the recited controller to use a *particular* vehicle device code from among plural such codes for different vehicles by providing either (1) the code itself to the controller, or (2) data that otherwise enables the

controller to select or generate the code. *See* '278 patent, col. 24, l. 5 – col. 25, l. 28; Figs. 10–13.

Turning to the rejection, the Examiner refers to, among other things, Chou's network interface 320 and external device in Figure 2, as well as network interface 107 and cell phone 102 in Figure 3, in connection with the recited downloading interface. *See* Ans. 5–6, 35–36.

As shown in Chou's Figures 2 and 3, Chou's network interface 320 communicates wirelessly with remote service center 200 whose diagnostic server 201 accesses vehicle-related data, including diagnostics and failure mode data. *See* Chou, col. 3, ll. 15–32; col. 5, ll. 33–39. In one aspect, the diagnostic server sends a health report to a vehicle's client computer device 101, where the report is based on trouble codes reported by the client. Chou, col. 6, ll. 1–14. If a fault or fault potential is identified, the server (1) informs the vehicle's client computer device via the data connection, and (2) compiles the relevant data and creates a case for an associated call center system 202 to handle. Chou, col. 6, ll. 15–19.

Chou's system can also provide vehicle health checkups upon driver request. *See* Chou, col. 8, l. 65 – col. 10, l. 11; Fig. 5. After the driver triggers a health checkup session, vehicle data, including trouble codes, are sent to the diagnostic server where this information is compared with that stored in a repository, and a corresponding report is prepared and sent back to the vehicle for display. Chou, col. 9, ll. 1–59; Fig. 5.

Although this functionality facilitates downloading vehicle-related data and is, therefore, a “downloading interface” at least in that sense, it nevertheless does not permit downloading the *particular enabling data*

recited in the claim. As noted previously, this enabling data enables the recited controller to use a *particular* vehicle device code from among plural such codes for different vehicles by providing either (1) the code itself to the controller, or (2) data that otherwise enables the controller to select or generate the code. *See* '278 patent, col. 24, l. 5 – col. 25, l. 28; Figs. 10–13. To the extent that the Examiner finds that the data contained in the report sent from Chou's diagnostic server to the vehicle somehow contains this particular enabling data, there is no evidence on this record to substantiate such a finding.

Therefore, we agree with Appellant that Chou does not teach or suggest the recited multi-vehicle compatible controller and downloading interface. Although this deficiency is dispositive regarding our reversing the Examiner's obviousness rejection, we add that Appellant's evidence of secondary considerations of non-obviousness, including licensing, commercial success, copying by others, customer need, and the limited value for accused products without the invention (App. Br. 38–54; Reply Br. 11; 2017 McAlexander Decl. ¶ 19), only further weighs in favor of Appellant.

Therefore, we are persuaded that the Examiner erred in rejecting (1) independent claim 1; (2) independent claim 18 which recites commensurate limitations; and (3) dependent claims 4–8, 11, 12, and 19–21 for similar reasons. Because this issue is dispositive regarding our reversing the Examiner's obviousness rejection of these claims, we need not address Appellants' other associated arguments including whether Chou teaches away from the claimed invention. *See* App. Br. 35–38.

THE ANTICIPATION REJECTION

Although Appellant's arguments regarding (1) the submitted evidence of secondary considerations of non-obviousness (App. Br. 38–54; Reply Br. 11), and (2) Chou teaching away from the claimed invention (App. Br. 35–38) are irrelevant to the Examiner's anticipation rejection over Chou (Ans. 30–42),⁴ we nonetheless find that Chou does not necessarily disclose the recited multi-vehicle compatible controller and downloading interface expressly or inherently for the reasons previously discussed.

Therefore, we are persuaded that the Examiner erred in rejecting (1) independent claim 1; (2) independent claim 18 which recites commensurate limitations; and (3) dependent claims 4–8, 11, 12, and 19–21 for similar reasons.

THE OTHER OBVIOUSNESS REJECTIONS

Because the Examiner has not shown that the additional cited prior art cures Chou's above-noted deficiencies, we will not sustain the obviousness rejections of claims 2, 3, 9, 10, 13–17, and 22 (Ans. 42–50) for similar reasons.

⁴ See, e.g., *Leggett & Platt, Inc. v. VUTEk, Inc.*, 537 F.3d 1349, 1356 (Fed. Cir. 2008) (“‘[T]eaching away’ is irrelevant to anticipation.”); see also *Cohesive Technologies, Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008) (“[O]bviousness requires analysis of secondary considerations of nonobviousness, while secondary considerations are not an element of a claim of anticipation.”).

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CONCLUSION

The Examiner erred in rejecting (1) claims 1, 4–8, 11, 12, and 18–21 under § 102, and (2) claims 1–22 under § 103.

DECISION

The Examiner's decision to reject claims 1–22 is reversed.

Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

REVERSED

PATENT OWNER:

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EXHIBIT 5

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION**

OMEGA PATENTS, LLC,

Plaintiff,

v. .

Case No: 6:13-cv-1950-Orl-40DCI

CALAMP CORP.,

Defendant.

FINAL JUDGMENT

This case was tried to a jury which returned a verdict in favor of plaintiff on February 24, 2016. On April 5, 2017, this Court granted in part and denied in part plaintiff's motion for entry of judgment but did not enter a form of judgment specifying its terms. This Final Judgment reflects the substance of that ruling.

Pursuant to Rule 58 of the Federal Rules of Civil Procedure, in accordance with the jury verdict delivered on February 24, 2016, and this Court's Orders, Final Judgment is hereby entered in favor of Plaintiff, OMEGA PATENTS, LLC, and against CALAMP CORP., as follows:

- a. CALAMP CORP. willfully infringed OMEGA PATENTS, LLC's U.S. Patent No. 6,346,876, Claims 1, 3, 4, 5, 12, 14, and 16; U.S. Patent No. 6,756,885, Claims 1, 2, 3, 12, and 14; U.S. Patent No. 7,671,727, Claims 1, 10, and 11; and U.S. Patent No. 8,032,278, Claims 1, 2, 3, 4, 5, 6, 8, 11, 12, 13, 14, 16, 18, 19, and 21 (collectively, the claims of patents-in-suit);
- b. The claims of the patents-in-suit have not been proven invalid or unenforceable;

- c. The Court finds this to be an exceptional case and the amount of the damages awarded by the jury shall be trebled;
- d. OMEGA PATENTS, LLC, shall be entitled to recover its reasonable attorneys' fees; and
- e. The Court will not issue an injunction against further infringement.

Accordingly, it is hereby **ORDERED and ADJUDGED**:

1. Defendant CALAMP CORP. shall pay damages to OMEGA PATENTS, LLC, in the amount of \$2,975,200.00, which shall be trebled, for a total amount of **\$8,925,600.00**;
2. OMEGA PATENTS, LLC, shall be awarded prejudgment interest in the amount of \$302.00 *per diem*, from the date of the verdict on February 24, 2016, to entry of this Final Judgment (393 days) for the total amount of **\$118,686.00**;
3. By stipulation of the parties, the Court awards Reasonable Attorney's Fees and Costs to OMEGA PATENTS, LLC, in the amount of **\$1,100,000.00**. CalAmp Corp. reserves the right to contest the amount of and/or entitlement to fees in the event that this Final Judgment is modified or overturned as a result of CalAmp Corp.'s motions for judgment as a matter of law and for a new trial, or on appeal.
4. The Court reserves jurisdiction to consider an ongoing royalty for any infringing sales after February 24, 2016. If the parties cannot agree on an appropriate procedure, the parties shall submit legal memoranda outlining any requested relief within thirty (30) days.
5. This Final Judgment incorporates all previous orders in the case. CalAmp Corp.'s agreement to the form of this Final Judgment shall not be construed as a waiver

of CalAmp Corp.'s right to appeal, or to file a renewed motion for judgment as a matter of law pursuant to Fed. R. Civ. P. 50 or a motion for new trial pursuant to Fed. R. Civ. P. 59. The time for filing such motions shall run from the date of the entry of this Final Judgment.

6. Plaintiff OMEGA PATENTS, LLC, shall be awarded Final Judgment in its favor, against Defendant CALAMP CORP., in the amount of **\$10,144,286.00**.

FOR WHICH SUM, LET EXECUTION ISSUE.

DONE AND ORDERED in Orlando, Florida on April 24, 2017.


PAUL G. BYRON
UNITED STATES DISTRICT JUDGE

Copies furnished to:

Counsel of Record
Unrepresented Parties

EXHIBIT 4

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION**

OMEGA PATENTS, LLC,

Plaintiff,

v.

Case No: 6:13-cv-1950-Orl-40DCI

CALAMP CORP.,

Defendant.

ORDER

This cause is before the Court on the following:

1. Plaintiff's Motion for Entry of Final Judgment, Including Entitlement to Attorneys' Fees, Enhanced Damages, and Entry of a Permanent Injunction (Doc. 148), filed March 9, 2016;
2. Plaintiff's Renewed Motion to Award Prejudgment Interest (Doc. 154) filed March 18, 2016;
3. Defendant's Response in Opposition to Plaintiff's Renewed Motion to Award Prejudgment Interest (Doc. 166), filed April 4, 2016;
4. Defendant's Opposition to Plaintiff's Motion for Entry of Final Judgment, Including Entitlement to Attorneys' Fees, Enhanced Damages, and Entry of a Permanent Injunction (Docs. 169, 170), filed April 11, 2016;
5. Plaintiff's Notice of Filing Declarations (Doc. 187), filed April 28, 2016;
6. Defendant's Notice of Filing Responsive Declarations (Doc. 188), filed April 29, 2016;

7. Defendant's Notice of Supplemental Authority regarding Response in Opposition to Plaintiff's Motion for Entry of Final Judgment (Doc. 192), filed May 17, 2016;
8. Defendant's Notice of Grant of Reexamination of '885 Patent (Doc. 193), filed June 6, 2016;
9. Plaintiff's Notice of Supplemental Authority (Doc. 194), filed June 13, 2016;
10. Defendant's Response to Plaintiff's Notice of Supplemental Authority (Doc. 195), filed June 14, 2016;
11. Plaintiff's Response to Defendant's Notice of Supplemental Authority at Docket Number 192 (Doc. 198), filed July 19, 2016;
12. Defendant's Reply to Plaintiff's Response to Notice of Supplemental Authority (Doc. 199), filed July 22, 2016;
13. Defendant's Notice of Grant of Supplemental Authority (Patent Office Action) (Docs. 200, 201), filed August 30, 2016; and
14. Defendant's Notice of Supplemental Authority (Patent Office Action) (Doc. 202), filed September 19, 2016.

Upon due consideration, and after reviewing the pleadings and the transcript of the trial (Doc. 178–184) and the transcript of the post-trial motion's hearing (Doc. 196), Plaintiff's Motions for Entry of Final Judgment, Enhanced Damages, and Reasonable Attorneys' Fees are granted, and Plaintiff's motions for Permanent Injunction is denied.

I. BACKGROUND

Omega Patents, LLC ("Omega") brought the instant action against CalAmp Corp. ("CalAmp") and contends that CalAmp infringed the claims of U.S. Patent No. 6,346,876

("the '876 Patent")¹, U.S. Patent No. 6,756,885 ("the '885 Patent")², U.S. Patent No. 7,671,727 ("the '727 Patent")³, and U.S. Patent No. 8,032,278 ("the '278 Patent")⁴ (collectively, the "patents-in-suit").⁵ (Doc. 1). The trial of this matter commenced on February 16, 2016, and concluding on February 24, 2016, (Doc. 178–184), with the jury returning a verdict in favor of Omega in which they found that all of Omega's asserted claims were valid and had been infringed upon by CalAmp's accused devices: the LMU 3000, LMU 3030, LMU 3050, the V-Pod and the V-Pod 2. (Doc. 144, p. 1–6). The jury rejected the Defendant's invalidity contentions and made three findings for Plaintiff on secondary considerations indicating nonobviousness. (*Id.* at pp. 7–9). Finally, the jury found Plaintiff had proven by clear and convincing evidence that CalAmp acted despite an objectively high likelihood that its actions infringed a valid patent and that this high likelihood of infringement was either known or so obvious that it should have been known to CalAmp. (*Id.* at pp. 9–10). The jury awarded damages in the amount of \$2,975,200. (*Id.* at p. 10).

Omega contends the Court should award reasonable attorneys' fees pursuant to 35 U.S.C. § 285, enhanced damages pursuant to § 284, and a permanent injunction pursuant to § 283. (Doc. 148). CalAmp opposes the relief requested by Omega. (Doc. 169). The Court held oral argument on the post-trial motions on May 2, 2016. (Doc. 196).

¹ The jury found infringement of claims 1, 3, 4, 5, 12, 14, and 16. (Doc. 144, p. 2).

² The jury found infringement of claims 1, 2, 3, 12, and 14. (*Id.* at p. 3).

³ The jury found infringement of claims 1, 10, and 11. (*Id.* at p. 4).

⁴ The jury found infringement of claims 1–6, 8, 11–16, 18–19, and 21. (*Id.* at pp. 5–6).

⁵ The patents-in-suit relate to control systems for vehicles with a "data communication bus." The term "data communication bus" has been previously construed by the Court to mean "wired connection for communication of digital messages among vehicle devices, with each message including one or more device addresses." (Doc. 50, p. 25).

The parties subsequently submitted numerous pleadings consisting of supplemental authority and notices of *ex parte* reexamination by The Patent Office of the '278 patent, the '885 patent, and the '876 patent. (Docs. 198–202).

II. STANDARD

A. Enhanced Damages

When this litigation proceeded to trial, the issue of enhanced damages was governed by the two-step inquiry announced by the Federal Circuit in *In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (*en banc*). Following oral argument on Omega's motion for enhanced damages, the United States Supreme Court decided *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923 (2016). The Court in *Halo* rejects the *Seagate* two-part test for determining when a district court may increase damages pursuant to 35 U.S.C. § 284 as being inconsistent with the plain language of the statute. *Halo*, 136 S. Ct. at 1928. Following a historical exegesis of enhanced damages under the Patent Act, the Court concluded that "although there is 'no precise rule or formula' for awarding damages under § 284, a district court's 'discretion should be exercised in light of the considerations' underlying the grant of that discretion." *Halo*, 136 S. Ct. at 1932 (quoting *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1756 (2014)).

The Court in *Halo* remarked that enhanced damages under patent law "should generally be reserved for egregious cases typified by willful misconduct." *Halo*, 136 S. Ct. at 1934. The Court observed that "[t]he sort of conduct warranting enhanced damages has been variously described in our cases as willful, wanton, malicious, bad-faith, deliberate, consciously wrongful, flagrant, or—indeed—characteristic of a pirate." *Halo*,

136 S. Ct. at 1932. The Court rejected the heightened standard of proof provided for by the Federal Circuit in *Seagate* in favor of a preponderance of the evidence standard. *Halo*, 136 S. Ct. at 1934. The type of culpability that supports an award of enhanced damages is “measured against the knowledge of the actor at the time of the challenged conduct.” *Halo*, 136 S. Ct. at 1933.⁶ Once a jury determines that an infringer “is guilty of conduct upon which increased damages may be based [,] ... the court then determines, exercising its sound discretion, whether, and to what extent, to increase the damages award given the totality of the circumstances.” *Jurgens v. CBK, Ltd.*, 80 F.3d 1566, 1570 (Fed. Cir. 1996). While a finding of willful infringement does not mandate the imposition of enhanced damages, once the finding is made “the court must explain its reasons for declining to award enhanced damages.” *Carnegie Mellon Univ. v. Marvell Tech. Group, Ltd.*, No. CIV.A. 09-290, 2014 WL 1320154, at *9 (W.D. Pa. Mar. 31, 2014), *rev’d in part on other grounds*, 807 F.3d 1283 (Fed. Cir. 2015).

B. Attorney’s Fees

The Supreme Court in *Octane Fitness* rejected the “more rigid and mechanical formulation” for determining when the district court may award reasonable attorney fees to the prevailing party in favor of the plain statutory text of § 285, which provides “[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party.” 35 U.S.C. § 285; *Octane Fitness*, 134 S. Ct. at 1755. An exceptional case is “simply one that stands out from others with respect to the substantive strength of a party’s litigating

⁶ The Court in *Halo* criticized, in pertinent part, the second prong of the *Seagate* test which allowed an infringer to escape enhanced damages by mustering a defense of invalidity or noninfringement at trial “even if [the infringer] did not act on the basis of the defense or was even aware of it.” *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1933 (2016).

position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.” *Octane Fitness*, 134 S. Ct. at 1756. The district court applies the preponderance of the evidence standard and considers the totality of the circumstances. The district court may consider a number of factors in determining whether to award fees, including: (1) whether the infringer deliberately copied the invention; (2) whether the infringer had a good faith basis for believing it did not infringe or that the patent was invalid; (3) the closeness of the case; (4) conduct of the part in litigation; (5) defendant’s relative size and financial condition; (6) the duration of the infringement; (7) remedial action by the defendant; (8) defendant’s motivation for harm, and (9) whether defendant attempted to conceal its misconduct. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 827 (Fed. Cir. 1992).⁷

C. Permanent Injunction

The Supreme Court in *eBay Inc. v. MercExchange, L.L.C.*, 126 S. Ct. 1837, 1839 (2006), held that to obtain an injunction a party “must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.” The Federal Circuit subsequently held that *eBay* eliminates a presumption of irreparable injury to the patent holder after a judgment of infringement and of no invalidity is returned. *Robert Bosch LLC v. Pylon Mfg. Corp.*, 659 F.3d 1142, 1149 (Fed. Cir. 2011). Moreover, there must be a

⁷ The *Read* factors are equally applicable to the assessment of enhanced damages.

causal nexus between the irreparable injury and the patent infringement. *Apple Inc. v. Samsung Elecs. Co.*, 735 F.3d 1352, 1360 (Fed. Cir. 2013).

III. DISCUSSION

Mr. Flick, the inventor of the four patents at issue, met with representatives of CalAmp, including Mr. Gallin Chen, in 2009 at a trade show to discuss Omega's belief that CalAmp was infringing certain patents. (Doc. 179, 76:10-18). During this initial meeting, Mr. Chen expressed his view that the Omega patents were invalid, but he nonetheless requested a draft license agreement. (*Id.* at 78:1-11). Omega complied and sent CalAmp a license agreement that CalAmp rejected shortly thereafter, resulting in Omega filing suit against CalAmp on December 15, 2009.⁸ (*Id.*). Once litigation had commenced, Mr. Chen agreed to meet with Mr. Flick again at a trade show scheduled for January 2010. (*Id.* at 81:14-18). During the ensuing conversation, Mr. Chen represented to Omega that CalAmp did not program their products and any alleged infringement was caused by the end-user who programs the CalAmp devices. (*Id.* at 81:24– 82:13). Based upon this representation Mr. Flick stayed the litigation against CalAmp and sued two end users: Numerex and Sky Patrol. (*Id.*). Numerex quickly settled with Omega and entered into a licensing agreement. (*Id.* at 82:14-23). Sky Patrol, however, revealed that, contrary to Mr. Chen's representation, CalAmp was responsible for programing their offending devices.⁹ (*Id.* at 83:11–84:12). CalAmp subsequently settled with Omega and agreed to pay a royalty. (*Id.* at 84:13-21; Pl.'s Ex. 45).

⁸ The lawsuit filed by Omega in 2009 pertained to patents other than those at issue in the instant litigation.

⁹ The deposition of CalAmp engineer, Peter Hergesheimer, was played at trial, and Mr. Hergesheimer acknowledged that CalAmp programs LMUs for approximately 75% of their customers, contradicting Mr. Chen's claim that CalAmp sold a black box. Mr.

Against this backdrop, CalAmp introduced the accused devices in late 2011 or early 2012. (Doc. 182, 53:2-5). Prior to introducing the accused products, CalAmp's counsel, Mr. David Bailey, reviewed a number of patents held by the Plaintiff, including the '885 and '727 patents at issue in this litigation. (Pl.'s Ex. 39). At the same time counsel for Omega and for CalAmp engaged in discussions concerning Omega's "extensive patent portfolio" in the area of databus applications.¹⁰ (Pl.'s Ex. 34). It is, therefore, beyond dispute that CalAmp was fully aware of the Omega patents prior to introducing the accused products into the market.

Mr. Chen admitted on cross-examination that the LMUs and V-Pod and V-Pod2 were introduced as a direct result of consumer demand. (Doc. 182, 142:11-24). Mr. Chen explained that the LMUs connect to the vehicle data bus and read data from the bus. (*Id.* at 54:8-14). According to Mr. Chen, the LMU has a transmitter and a receiver, can read data from the vehicle data bus, can query a vehicle device for data, and can store the data received in response to the query. (*Id.* at 129:1-21). The '727 patent held by Omega, for example, claims a speed exceeded notification device for a vehicle comprising a "vehicle data communications bus" and "at least one vehicle device generating data related to vehicle speed on the" bus which determines when a vehicle's speed has exceeded a set threshold. (Joint Ex. 4, column 7, lines 4-17).

In an attempt to distinguish the LMU devices from the '727 patent, Mr. Chen testified that the LMU speed data is derived from the GPS module and not from the vehicle

Hergesheimer also testified that software is loaded on the LMU online, because that is more cost effective than loading it at the time of manufacture.

¹⁰ CalAmp engineer, Peter Hergesheimer, testified at trial via deposition that he did not design around the Omega patents.

bus.¹¹ (Doc. 182, 133:13-21). He added that the LMU has the capacity to read speed from the bus, but CalAmp does not allow this because speed data generated from GPS is more accurate. (*Id.*). However, Mr. Jerrery Eidberger, a CalAmp field application engineer, testified via deposition that a substantial percentage of customers do in fact have the LMU programmed by CalAmp to read the speed from the bus. Additionally, CalAmp responded to Omega's First Set of Interrogatories, wherein Omega asks CalAmp to "identify all customers for whom CalAmp has loaded scripts for geofencing or speed alerts into an Accused Product" by providing a long list of customers for whom CalAmp has loaded scripts related to speed alerts, noting that "some scripts do not cause a speed exceeded notification." (Pl.'s Ex. 16). CalAmp's acknowledgement that some scripts do not cause a speed exceeded notification means that other scripts do provide the speed exceeded notification from the vehicle bus as opposed to the GPS. Mr. Chen's testimony wherein he flatly denies the LMU reads vehicle speed from the bus is clearly contradicted by CalAmp's interrogatory answers.

Mr. Andrews, CalAmp's retained expert, echoed this misrepresentation when he testified that the CalAmp devices obtain speed data from the internal GPS sensor as opposed to obtaining speed from the bus. (Doc. 182, 248:3-5; 249:1-5). On cross-examination, Mr. Andrews admitted that if the LMU is programmed to read speed from the data bus and make the threshold determination that the speed has been exceeded, the accused device infringes the '727 patent. (Doc. 183, 172:19-22). Either Mr. Andrews ignored CalAmp's answers to Omega's interrogatories in reaching his opinion that the

¹¹ The '727 patent indicates that it is an object of the invention "to provide a speed exceeded notification device which may be readily used in a vehicle including a data communications bus and related methods." (Joint Ex. 4, column 2, lines 38-40).

accused products do not infringe the '727 patent because speed is derived via GPS, or CalAmp withheld this information from its expert in order to obtain a non-infringement opinion. Either way, the testimony of Mr. Chen and Mr. Andrews provide substantial support for the jury's finding of willful infringement of the '727 patent, and this Court concurs in the jury's finding of willful infringement.

Further indicia of willful infringement by CalAmp is found in an e-mail sent by Mr. Chen to outside patent counsel, Mr. David Bailey¹², and senior vice president for corporate development, Mr. Garo Sarkissian. (Doc. 182, 112:13-19). On July 30, 2013, eight months after Omega instituted this lawsuit, Mr. Chen wrote to Messrs. Bailey, and Sarkissian and asked them to look at the '278 patent. (Pl.'s Ex. 48). Referring to claim 13 of the '278 patent, Mr. Chen wrote: "13 may relate to how we program a unit at the factory so it may be harder to avoid." (*Id.*). The '278 patent has as an object of the invention to "provide a multi-vehicle compatible tracking unit which may be used to control operable vehicle devices, and/or read information therefrom via the vehicle data communications bus." (Joint Ex. 5, column 2, lines 46-49). Clearly, Mr. Chen was concerned as late as July 30, 2013, that the accused devices infringe claim 13 of the '278 patent, as the jury ultimately found. His admission in this e-mail that the units are programmed at the CalAmp factory is further evidence that his trial testimony describing the LMU as a black box, programmed by the end-user, was false.

In the same e-mail, Mr. Chen predicts what will ultimately become a defense theory advanced at trial, when he writes: the '727 patent "can be avoided by using GPS speed,

¹² Mr. Bailey is an attorney practicing in the same firm as trial defense counsel. (Doc. 182, 144:20-25).

not vehicle bus received speed, for speeding alerts." (Joint Ex. 5). It is difficult to ascribe a good faith basis for persisting at trial on the theory that the LMU determines speed from the GPS, as opposed to obtaining the data from the bus, when CalAmp's supplemental response to Omega's interrogatory, in which CalAmp admits to loading scripts for speed exceeded notification, was filed March 6, 2015—more two years after Mr. Chen suggested to his counsel and his colleague that using GPS speed will allow CalAmp to avoid the '727 patent. This email is consistent with an attempt to create a plausible defense at trial, perhaps in anticipation of the then-available *Seagate* enhanced damages analysis.¹³ That Mr. Chen continued to advance the GPS theory at trial and in view of CalAmp's interrogatory answer demonstrates willful copying of Omega's invention.

In an attempt to satisfy the *Seagate* two-part test at trial, Mr. Chen testified that prior to launching the accused devices, CalAmp investigated the vehicle data bus market. (Doc. 182, 55:21-24). Mr. Sarkissian directed Mr. Chen to search for prior art, resulting in Mr. Chen reviewing over 300 patents. (*Id.* at 57:12–58:2). Mr. Chen also stated that in late 2010, Mr. Sarkissian, Mr. Steven Moran (CalAmp's general counsel), and he had received verbal opinions from Mr. Bailey that the accused products did not infringe existing patents. (*Id.* at 114:7-25; 117:7-12). Mr. Chen stated that he did not request Mr. Bailey to memorialize these oral opinions in writing until after the lawsuit was commenced by Omega. (*Id.* at 145:1-3). The defense marked for identification exhibits 71–74, which are opinion letters written by Mr. Baily as to each patent-in-suit, and each opinion letter is

¹³ The Supreme Court in *Halo* disapproved of the *Seagate* test in part because it allowed an infringer to "escape any comeuppance under § 284 solely on the strength of his attorney's ingenuity." *Halo*, 136 S. Ct. at 1933. Hence, opinion letters issued after-the-fact shed little light upon the infringer's culpability which must be "measured against the knowledge of the actor *at the time* of the challenged conduct." *Id.* [emphasis added].

dated June 27, 2014.¹⁴ (Def.'s Exs. 71–74). However, it is curious—assuming Mr. Bailey had vetted the accused products against existing patents back in 2010—that in July 2013 Mr. Chen highlighted the difficulty of avoiding claim 13 of the '278 patent and suggested that the '727 patent can be avoided by focusing upon GPS speed determination. If, in fact, counsel had vetted the accused devices and the Omega patents three years earlier, there is no reason for Mr. Chen to suggest a noninfringement theory to his counsel, nor is there any reason for Mr. Chen to be concerned over claim 13 of the '278 patent. The Court does not find the testimony of Mr. Chen or of Mr. Bailey credible on the issue of whether counsel had rendered legal opinions prior to the launch of the accused products in which he opined the accused products do not offend any patent held by Omega. Mr. Chen's credibility is undermined by other evidence presented at trial¹⁵, and it is incomprehensible that counsel would refrain from issuing a written opinion of noninfringement or invalidity to his client at or near the time that CalAmp launched the accused products. No reasonable explanation for this highly unusual practice was offered by CalAmp or Mr. Bailey.

¹⁴ The Court sustained Omega's objection to the admissibility of Mr. Bailey's opinion letters on the grounds that the letters—offered during Mr. Chen's testimony—constitute hearsay, and the letters confer expert testimony which was not properly disclosed by the Defense. However, the Court has considered the four opinion letters for purposes of the enhanced damages analysis. The Court is unaware of the substance of the verbal opinions allegedly offered by Mr. Bailey in 2010 prior to the launch of the accused products.

¹⁵ Mr. Chen testified via deposition that he removed information from the CalAmp website regarding the LMU devices to make it more difficult for Omega to identify infringement. (Pl.'s Ex. 48) ("We don't want to make it easy for Omega to build their infringement case by just looking at the datasheets on our website. . . . the bigger hole is LMU 3000; it's launched, mature and broadly integrated by multiple partners. We can bury (i.e. omit) the LMU3030 for now on open website.").

The Court next considers whether this was a “close case” and whether CalAmp held a good faith belief the patents were not infringed or were invalid. CalAmp and their expert, Mr. Andrews, note that the Omega patents require the performance of a control function. (Doc. 182, p. 177:7-15; Doc. 195, p. 3). At trial Mr. Andrews defined “control function” as “a message on the bus that is going to control a device exhibiting a physical change in the device or the system.” (Doc. 182, 177:7-15). The notion that control function envisions a physical change is critical to the Defendant’s noninfringement arguments. Based upon the Court’s review of Mr. Andrew’s initial expert report, (Def.’s Ex. 38), this definition of control function does not appear in his original expert report. Mr. Andrews acknowledged on cross-examination that he did not apply the physical change qualifier to control function in his deposition. (Doc. 183, 103:10-14). Mr. Andrews explained that he had misspoken in his deposition when he failed to describe control function as requiring a physical change in the device or the system. (*Id.*). Mr. Andrews did, however, include in his rebuttal report the definition of control function as having the ability to enable a physical change in a device of the system; for example, locking a door, starting the engine, or turning on a light.” (Def.’s Ex. 47, pp. 11–12). The crux of the non-infringement defense is that the LMU merely sends a “query for data” and does not control a vehicle device. (Doc. 182, p. 177:20-22). Because the LMU does not control a vehicle device, Mr. Andrews argues the accused products cannot satisfy the multi-vehicle compatible controller claim in the patents. (*Id.* at 238:9-12; 238:25–239:6; 239:14–240:6). Accordingly, Mr. Andrews’ definition of control function as mandating a physical change precludes one from finding for Plaintiff Omega.

In order for Mr. Andrews' non-infringement argument to prevail, one must accept his opinion that the LMU is a passive device that uses the bus to request and receive data, but which does not "perform one or more control functions" with respect to the vehicle device. (Def.'s Ex. 47, p. 12; Doc. 182, 240:9-11). The difficulty lies in finding a basis for Mr. Andrews' interpretation of "control function." The Court construed the claim term "controller" to mean "electronic circuitry that performs one or more control functions." (Doc. 50, p. 24). The claim term "multi-vehicle compatible controller" was construed by the Court to mean "electronic circuitry that performs one or more control functions, and can operate with more than one vehicle." (*Id.*). The Court did not construe the term control function. CalAmp urged the Court to construe "function" as "[a]n operation of a vehicle device, such as remote starting the engine, remotely unlocking the vehicle doors, or changing the mode of a security system between armed and disarmed." (*Id.* at 18). But the Court observed: "The patent states the invention may be embodied in many different forms and should not be construed as limited to the illustrated embodiments set forth herein." (*Id.* at 18) (internal quotation marks and citations omitted). Accordingly, Mr. Andrews' interpretation of "control function" is not based upon the Court's claim construction. Similarly, nothing in any specification of the four patents-in-suit support Mr. Andrews' definition of "control function." (Joint Ex. 1-4; Doc. 183, 117:8-11; 118:1-6).

Mr. Andrews acknowledged that the microprocessor in the LMUs and the V-Pods sends a signal along the bus to the ECU and requests a response. (Doc. 183, 114:17–115:6). Omega's counsel engaged Mr. Andrews in the following colloquy:

Q: Let's say the ECU responds with the device code signal—that would be controlling the ECU, wouldn't it?

A: You're asking it for information. It's providing it back, yes.

Q: So that's a yes?

A: Okay.

(*Id.* at 118:9-24)

Q: And would you also agree with me ... that sending a signal and getting a response could be a control function?

A: Yes.

(*Id.* at 120:5-20)

Mr. Andrews admits that when the LMU seeks information from the ECU, the ECU must respond via the bus; however, he contends this is not a control function. (*Id.* at 143:1-6). Mr. Andrews argues that "one with ordinary skill in the art, in the automotive industry in telematics, would understand the difference between a command and a query." (*Id.* at 116:7-10). It is Mr. Andrews' contention that a command—or as he would call it a query—by the LMU that produces a mandatory response by the ECU does not meet the definition of controller and control function. The Defendant's attempt to cast a mandatory response to a query as a passive act that falls short of a control function is unsupported by the record and was conspicuously absent from Mr. Andrews' initial expert report. The emergence of this opinion late in the litigation is highly suspect, particularly when one considers that Mr. Andrews' also opined that the LMU cannot infringe the '727 patent because the LMU only generates speed data from the GPS—which is clearly contradicted by CalAmp's response to Omega's interrogatories.

Mr. Andrews and counsel for CalAmp presented other non-infringement arguments at trial. However, the Court finds that these additional grounds—all of which were rejected by the jury—do not, giving the totality of the circumstances, mitigate against an award of enhanced damages and reasonable attorneys' fees. For example, Mr.

Andrews took issue with whether signals were stored on the accused devices as required by the '885 patent. (Doc. 183, 122:6-9). However, on cross-examination, Mr. Andrews agreed that the LMU sends out signals and the ECU sends a response, "[a]nd those signals are stored on the controller." (*Id.* at 123:7–124:9). Mr. Andrews admits the signals are stored on the LMU until the device is unplugged and re-plugged at which time it starts over. (*Id.* at 125:5-9). In fact, Mr. Andrews agrees the LMU is intended to be used in a manner that would store the CAN data and can be used in multiple vehicles. (*Id.* at 162:6-13).

CalAmp also presented invalidity defenses by identifying prior art that, when considered with SAE standards, rendered the patents obvious. In supplemental filings by the parties, the Court has been made aware that CalAmp sought *ex parte* reexamination of three of the patents-in-issue. The United States Patent and Trademark Office ("USPTO") has reexamined the '278 patent¹⁶, (Doc. 192); the '885 patent¹⁷, (Doc. 193), and the '876 patent¹⁸, (Doc. 201). The USPTO rejected the pertinent claims of these three patents. While the USPTO issued Office Actions in *Ex Parte* Reexamination of the '278, '885, and '876 patents and rejected the relevant claims of these patents, the finding by the USPTO does not have preclusive effect as to the verdict rendered by the jury in the instant litigation unless the final USPTO decision is affirmed by the Federal Circuit before the jury's verdict become final. *Fresenius USA, Inc. v. Baxter Inter., Inc.*, 721 F.3d 1330,

¹⁶ Omega's response, including declarations from Mr. Suman, (Doc. 198-2), whose patent is being considered by the examiner as prior art, and Mr. McAlexander, (Doc. 198-3), demonstrates that the examination of '278 remains in a state of flux. (Doc. 198).

¹⁷ The USPTO rejected every claim of the '885 patent on anticipation and obviousness grounds. (Doc. 202, p. 1).

¹⁸ The USPTO rejected every claim of the '876 patent on anticipation and obviousness grounds. (Doc. 201, p. 2).

1346 (Fed. Cri. 2017). Accordingly, the Court is not bound by the examiner's non-final conclusions when determining whether the jury's verdict is supported by substantial evidence.

The Court recognizes that CalAmp does not suggest in their notices of supplemental authority that the non-final action of the PTO is outcome determinative. Rather, CalAmp cites to the examiner's findings to support the reasonableness of their reliance upon invalidity as a defense. The Court rejects CalAmp's position for a number of reasons. CalAmp's expert, Mr. Andrews, combined certain prior art, such as the Braitberg '497 patent, (Def. Ex. 10), with the Society of Automotive Engineers ("SAE") standard J1978, to predict the Omega '876 patent. (Doc. 182, 173:14–175:23; 178:8-15; 180:22–181:19). Mr. Andrews testified that "one of ordinary skill in the art [would] look to J1978 to determine how to connect the bus." (*Id.* at 184:13–18). However, Mr. Andrews, despite numerous questions posed on cross-examination, failed to articulate the motive for one of ordinary skill in the art to combine these references.¹⁹ The best Mr. Andrews could do in suggesting a motive to combine J1978 with Braitberg is that scan tools were being used at the relevant time; hence, one would know to combine SAE J1978 with Braitberg to make a device multi-vehicle compatible.²⁰ (Doc. 183, 149:21–150:3). Mr. Andrews applied the Braitberg reference to the '876 and '885 patents, (Doc. 182, p. 198:1-

¹⁹ "A party seeking to invalidate a patent on the basis of obviousness must demonstrate by clear and convincing evidence that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so." *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1360 (Fed. Cir. 2012) (internal quotation marks omitted).

²⁰ Mr. Andrews admits that Braitberg does not provide multiple vehicle compatibility, a claim that is necessary to invalidate the Omega patents, so he adds SAE J1978. (Doc. 183, p. 130:6-10). Interestingly, Mr. Chen testified he was unaware of J1978.

20), and he applied J1978 to all four patents-in-suit. (*Id.* 250:1–270:19). The motive to combine prior art is critical to CalAmp's invalidity defense, because Mr. Andrews could not find prior art that had all of the claims that Mr. Flick has in his patents. (*Id.* at 132:17–133:7). Mr. Andrews failed to provide more than a conclusory opinion that one of ordinary skill in the art at the relevant time would have known to look to SAE J1978 in combination with the various prior art references. In this regard, Mr. Andrews' fails to assist the Defendant in carrying its burden of proof on invalidity.

In addition, the Court in *Halo* has eliminated the ability of an accused infringer to posit reasonable invalidity defenses which were not relied upon at the time the accused products were introduced into the market. *Halo*, 136 S. Ct. at 1933. Under *Seagate*, "the ability of the infringer to muster a reasonable (even though unsuccessful) defense at the infringement trial" was dispositive of the issue of enhanced damages. *Id.* Post-*Halo*, however, "culpability is generally measured against the knowledge of the actor at the time of the challenged conduct." *Id.* There is no indication in the record that Mr. Andrews provided CalAmp his opinion on invalidity before the accused products went into production in 2011. While the opinion letters issued by Mr. Bailey as to the '885 patent refer to SAE J1978, J1979, (Def.'s Ex. 73), this letter was written in June 2014 long after infringement had begun. Thus, there is no record evidence that CalAmp had knowledge of the invalidity defense derived from the combination of prior art and SAE standards at the time of the challenged conduct.²¹ Since culpability is measured against the infringer's

²¹ In fact, Mr. Chen filed for patent US 2010/0158211 on December 21, 2011, claiming "[s]ystems and methods in accordance with embodiments of the invention continuously collect information from vehicle devices via a vehicle data bus, store information in a database, and retrieve information from the database in response to requests from

knowledge at the time of the challenged conduct, the after-the-fact invalidity defense is of little merit in assessing enhanced damages.²²

The next *Read* factor directs the Court to consider the Defendant's size and financial condition. According to Omega's expert, Mr. Christian Tregillis, "CalAmp has sold over 245,000 units of the Accused Products, for over \$21.5 million from April 2011 through November 2014," (Pl.'s Ex. 65, p. 37), "earning over \$4.1 million in gross profits." (Pl.'s Ex. 65, p. 47). CalAmp is a publicly-traded corporation with over \$75 million dollars in earnings last year. (Pl.'s Ex. 65). While CalAmp argues that the accused products are low-margin products sold in an extremely competitive market, this misses the point. The overall financial health of the infringer is evaluated—not the net profit generated by the offending conduct—to "ensure that enhanced damages would not prejudice defendant's non-infringing business." *Powell v. Home Depot U.S.A., Inc.*, 715 F. Supp. 2d 1285, 1298 (S.D. Fla. May 28, 2010). The Defendant has the financial wherewithal to endure the sanction of enhanced damages and an award of reasonable attorneys' fees.

A closely related factor for the Court to consider is the duration of CalAmp's conduct. As previously discussed, CalAmp was well aware of Omega's patents since at least 2010. Rather than take a license, and choosing not to design around Omega's patents, CalAmp elected to sell infringing products and continues to do so to this day. CalAmp's motivation to engage in this behavior is obvious: their customers wanted this technology, and CalAmp wanted to provide it. Moreover, as previously discussed,

remote devices." (Pl.'s Ex. 14, Abstract). The patent issued June 21, 2012, and Mr. Chen did not disclose the prior art relied upon to invalidate Omega's similar patents.

²² Assuming CalAmp had knowledge of the invalidity defense at the relevant time, the Court would not reach a different conclusion, since the motive to combine the prior art with the SAE standards is deficient.

CalAmp attempted to conceal its infringement by misrepresenting to Omega that it only sold black boxes which were programmed by customers and by removing information from the CalAmp website to make discovery of infringement more difficult. These additional factors all weigh in favor of an award of enhanced damages and reasonable attorneys' fees.

Based upon the foregoing, the Court finds CalAmp willfully infringed the Omega patents-in-suit, further finding that the jury's finding of willful infringement is supported by substantial evidence. The Court independently reviewed the record evidence and finds an award of enhanced damages of threefold the actual damages and an award of reasonable attorneys' fees is supported by the evidence.²³

The Court turns now to Omega's request for a permanent injunction. Omega quotes Chief Justice Robert's concurring opinion in *eBay* wherein he remarks that from "at least the early 19th century, courts have granted injunctive relief upon a finding of infringement in the vast majority of patent cases." *eBay*, 126 S. Ct. at 1841. However, Justice Thomas speaking for the majority clarified that "the decision whether to grant or deny injunctive relief rests within the equitable discretion of the district courts, and that such discretion must be exercised consistent with traditional principles of equity, in patent disputes no less than in other cases governed by such standards." *Id.* As Justice Kennedy elaborates in his concurrence, "trial courts should bear in mind that in many instances the nature of the patent being enforced and the economic function of the patent holder

²³ The Court notes that even if the PTO's non-final action rejecting the relevant claims of the '885 and '876 patents are affirmed by the Federal Circuit, enhanced damages and reasonable attorneys' fees are appropriate for the willful infringement of the '727 and '278 patents—assuming the '278 patent survives reexamination.

present considerations quite unlike earlier cases.” *Id.* at 1842. Justice Kennedy cautions trial courts to use care in issuing permanent injunctions in the context of patent holders who primarily employ their patent to obtain licensing fees. *Id.* “When a patented invention is but a small component of the product the companies seek to produce and the threat of an injunction is employed simply for undue leverage in negotiations, legal damages may well be sufficient to compensate for infringement and an injunction may not serve the public interest.” *Id.*

Mr. Flick is a patent holder who presently generates revenue by licensing his patents; he no longer manufactures products. While Omega argues that it has maintained a restrictive licensing program of the patents-in-suit and has selectively licensed only a limited number of entities in the marketplace, (Doc. 148, p. 17), it is equally true that Omega was willing to license its patents to CalAmp. While Mr. Flick testified that Omega requires most licensees to transfer rights of improvements to Omega in order to strengthen its patents, it is clear that Omega does not require every licensee to agree to this term. In fact, the License Agreement entered into between Omega and CalAmp in relation to the products sold to SKYPATROL does not provide for assignment of improvements to Omega. (Pl.’s Ex. 88).

While cognizant of Omega’s contention that a compulsory licensing agreement does not make Omega whole, and recognizing the Court need not balance the hardships in cases of willful infringement²⁴, the Court finds that monetary damages are adequate to compensate Omega for the injury sustained by CalAmp’s infringement. Moreover, as

²⁴ *United States v. Marine Shale Processors*, 81 F.3d 1329, 1358 (5th Cir. 1996); see also *Windsurfing Int’l v. AMF, Inc.*, 782 F.2d 995, 1003 (Fed. Cir. 1986).

indicated by the declaration of Mr. Michael Zachan, CalAmp's Senior Vice President, a number of public safety, local government, and utility providers would be placed at a considerable disadvantage in the execution of their important duties if a permanent injunction issues. The Court agrees with Omega that the logistic and financial turmoil that befalls CalAmp should an injunction be ordered is of their own design. However, the collateral impact upon important public safety functions weighs against a permanent injunction.

For the foregoing reasons, the Court denies Omega's request for a permanent injunction, finding that the payment of customary licensing fees to Omega is adequate to protect the interests of Omega.

IV. CONCLUSION

For the aforementioned reasons, it is **ORDERED AND ADJUDGED** as follows:

1. Plaintiff Omega Patents, LLC's Motion for Entry of Final Judgement (Doc. 148) is **GRANTED**.
2. Plaintiff Omega Patents, LLC's Renewed Motion to Award Prejudgment Interest (Doc. 154) is **GRANTED**.
3. Plaintiff Omega Patents, LLC's Motion for Enhanced Damages (Doc. 148) is **GRANTED** and Plaintiff is awarded treble damages in the amount of eight million, nine hundred and twenty-five thousand and six hundred dollars (\$8,925,600).
4. Plaintiff Omega Patents, LLC's Motion for Entitlement to Reasonable Attorneys' Fees (Doc. 148) is **GRANTED**.

5. Plaintiff Omega Patents, LLC's Motion for Entry of a Permanent Injunction (Doc. 148) is **DENIED**.

DONE AND ORDERED in Orlando, Florida, on April 6, 2017.


PAUL G. BYRON
UNITED STATES DISTRICT JUDGE

Copies furnished to:

Counsel of Record
Unrepresented Parties

EXHIBIT 3



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

027975 TM02/0824
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRI
1401 CITRUS CENTER 255 SOUTH ORANGE AVEN
P.O. BOX 3791
ORLANDO FL 32802-3791

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
09/583,332	05/31/00	051	PHAM, T	2632 08/24/01
First Named Applicant	FLICK, 35 USC 154(b) term ext. = 0 Days.			

TITLE OF INVENTION MULTI-VEHICLE COMPATIBLE CONTROL SYSTEM GENERATING COMMAND SIGNALS ON A DATA BUS AND ASSOCIATED METHODS

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
3 15635G	340-426.000	L01	UTILITY	YES	\$620.00	11/26/01

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
- B. If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

- A. Pay FEE DUE shown above, or
- B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

II. Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give application number and batch number.

Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PATENT AND TRADEMARK OFFICE COPY

Notice of Allowability

Application No.
09/583,332

Applicant(s)

Flick

Examiner

Toan Pham

Art Unit

2632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to request for consideration filed on June 25, 2001.
2. ☒ The allowed claim(s) is/are 1-51.
3. ☐ The drawings filed on _____ are acceptable as formal drawings.
4. ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

5. ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE FOR SUBMITTING NEW FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION.** This three-month period for complying with the REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL is extendable under 37 CFR 1.136(a).

6. ☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

7. ☒ Applicant MUST submit NEW FORMAL DRAWINGS

- (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☒ hereto or 2) ☐ to Paper No. _____.
(b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the examiner.
(c) ☐ including changes required by the attached Examiner's Amendment/Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

8. ☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any reply to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

- | | |
|--|---|
| 1 ☒ Notice of References Cited (PTO-892) | 2 ☐ Notice of Informal Patent Application (PTO-152) |
| 3 ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 ☐ Interview Summary (PTO-413), Paper No. _____ |
| 5 ☐ Information Disclosure Statement(s) (PTO-1449), Paper No(s). _____ | 6 ☐ Examiner's Amendment/Comment |
| 7 ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 ☒ Examiner's Statement of Reasons for Allowance |
| 9 ☐ Other | |

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Information Disclosure Statement

1. Applicant request that the examiner confirm consideration of the reference BG, the article of the Society of Automotive Engineers, "Surface Vehicle Standard," J1850 pp. 1-51. However, the reference is missing and are not enclosed as claimed by applicant. Therefore, the reference has not been considered.

Allowable Subject Matter

2. Claims 1-51 are allowed.
3. The application having been allowed, formal drawings are required in response to this Office action.
4. The following is an examiner's statement of reasons for allowance: The present invention is directed to a control system for a vehicle including the data communication bus for connecting multiple devices, and, moreover carries signals including both address and data communication on the data communication bus. Each independent claim identifies the uniquely distinct features "a multi-vehicle compatible controller at the vehicle and cooperating with said transmitter and receiver, said multi-vehicle compatible controller generating at least one set of command signals on the data communication bus for the at least one vehicle device, the at least one set of command signals comprising at least one working command signal and at least one non-working command signal for a given vehicle to thereby provide command compatibility with a plurality of different

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vehicles". In other words, multiple signals or codes are generated on the data communication bus, and only that code for the given vehicle and device will cause an operation or response from the vehicle device. The closest prior art, Dery et al. (US 5,673,017) and DiCroce (US 5,838,255) disclose conventional vehicle control systems, either singularly or in combination, fail to anticipate or render the above limitations obvious.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art reference of Flick (6,275,147) is cited to show parent application, now US patent.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Any inquiry concerning this communication should be directed to Examiner Toan Pham at telephone number (703) 306-3038. The examiner can normally be reached on Monday-Friday, 7:00am-5:00pm.

If attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Jeffery Hofsass, can be reached on (703) 305-4717.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700, Mon-Fri, 8:30am-5:00pm.

Examiner: Toan Pham

Date: August 15, 2001


DANIEL J. WU
Primary Examiner
8/23/01

Notice of References Cited

Applicant/Patent
Flick

ation/Control No.
09/583,332

Examiner
Toan Pham

Art Unit
2632

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Name	Classification ²	
X	A	6,275,147	8/2001	Flick	340	428
	B					
	C					
	D					
	E					
	F					
	G					
	H					
	I					
	J					
	K					
	L					
	M					

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Country	Name	Classification ²	
	N						
	O						
	P						
	Q						
	R						
	S						
	T						

NON-PATENT DOCUMENTS

*		Include, as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages
	U	
	V	
	W	
	X	

* A copy of this reference is not being furnished with this Office action. See MPEP § 707.05(a). ¹ Dates in MM-YYYY format are publication dates. ² Classifications may be U.S. or foreign.

EXHIBIT 2

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION**

OMEGA PATENTS, LLC,

Plaintiff,

v.

Case No: 6:13-cv-1950-Orl-40DAB

CALAMP CORP.,

Defendant.

_____ /

VERDICT FORM

1. Do you find Omega has proven by a preponderance of the evidence that any of the accused CalAmp devices infringed any of the asserted claims of Omega's asserted Patents?

 ✓ Yes (for Omega)

 No (for CalAmp)

If your answer to Question 1 is "No," proceed to Question 3. If your answer to Question 1 is "Yes," for any claim(s) Omega has proven by a preponderance of the evidence that any of the accused CalAmp devices infringed, indicate a finding of infringement by marking "Yes" in the corresponding space provided in Questions 2.A through 2.D. below; for any claim(s) Omega has failed to prove by a preponderance of the evidence that any of the accused CalAmp devices infringed, indicate a finding of non-infringement by marking "No" in the corresponding space provided in Questions 2.A through 2.D. below.

2.A. U.S. Patent No. 6,346,876 B1 ("the '876 patent")

Has Omega proven by a preponderance of the evidence that any of the accused CalAmp devices infringed any of the following claims of the '876 patent?

	LMU-3000	LMU-3030	LMU-3050	VPOD	VPOD2
Claim 1	☒ Yes ☐ No	☒ Yes ~~☐ No~~	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 3	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 4	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 5	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 12	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 14	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 16	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No

2.B. U.S. Patent No. 6,756,885 B1 ("the '885 patent")

Has Omega proven by a preponderance of the evidence that any of the accused CalAmp devices infringed any of the following claims of the '885 patent?

	LMU-3000	LMU-3030	LMU-3050	VPOD	VPOD2
Claim 1	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 2	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 3	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 12	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 14	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No

2.C. U.S. Patent No. 7,671,727 B2 ("the '727 patent")

Has Omega proven by a preponderance of the evidence that any of the accused CalAmp devices infringed any of the following claims of the '727 patent?

	LMU-3000	LMU-3030	LMU-3050	VPOD	VPOD2
Claim 1	☒ Yes	☒ Yes	☒ Yes	☒ Yes	☒ Yes
	☐ No	☐ No	☐ No	☐ No	☐ No
Claim 10	☒ Yes	☒ Yes	☒ Yes	☒ Yes	☒ Yes
	☐ No	☐ No	☐ No	☐ No	☐ No
Claim 11	☒ Yes	☒ Yes	☒ Yes	☒ Yes	☒ Yes
	☐ No	☐ No	☐ No	☐ No	☐ No

2.D. U.S. Patent No. 8,032,278 B2 ("the '278 patent")

Has Omega proven by a preponderance of the evidence that any of the accused CalAmp devices infringed any of the following claims of the '278 patent?

	LMU-3000	LMU-3030	LMU-3050	VPOD	VPOD2
Claim 1	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 2	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 3	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 4	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 5	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 6	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 8	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 11	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No

U.S. Patent No. 8,032,278 B2 ("the '278 patent") continued from previous page

	LMU-3000	LMU-3030	LMU-3050	VPOD	VPOD2
Claim 12	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No		
Claim 13	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 14	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 16	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 18	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 19	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No
Claim 21	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No	☒ Yes ☐ No

After answering Questions 2.A. through 2.D., proceed to Question 3.

3. Has CalAmp proven by clear and convincing evidence that any claim of the asserted Patents is invalid?

_____ Yes (for CalAmp) ✓ No (for Omega)

4. If your answer to Question 3 is "No," proceed to Question 5. If your answer to Question 3 is "Yes," answer Question 4 below by indicating with an X any claim(s) you find invalid by clear and convincing evidence and indicate the reasons for invalidity, namely, identify which prior art references disclose the elements of the claim.

PATENT CLAIM	YES, INVALID	REFERENCES DISCLOSING THE ELEMENTS OF THE CLAIM
U.S. Patent No. 6,346,876		
Claim 1		
Claim 3		
Claim 4		
Claim 5		
Claim 12		
Claim 14		
Claim 16		
U.S. Patent No. 6,756,885		
Claim 1		
Claim 2		
Claim 3		
Claim 12		

PATENT CLAIM	YES, INVALID	REFERENCES DISCLOSING THE ELEMENTS OF THE CLAIM
U.S. Patent No. 6,756,885 (continued from previous page)		
Claim 14		
U.S. Patent No. 7,671,727		
Claim 1		
Claim 10		
Claim 11		
U.S. Patent No. 8,032,278		
Claim 1		
Claim 2		
Claim 3		
Claim 4		
Claim 5		
Claim 6		
Claim 8		
Claim 11		
Claim 12		
Claim 13		
Claim 14		
Claim 16		
Claim 18		
Claim 19		
Claim 21		

After answering Question 4, answer Question 5.

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?
- X Was there long felt need for a solution to the problem facing the inventors, which was satisfied by the claimed invention?
- X Did others try, but fail, to solve the problem solved by the claimed invention?
- YES Did others copy the claimed invention?
- X Did the claimed invention achieve unexpectedly superior results over the closest prior art?
- X Did others in the field praise the claimed invention or express surprise at the making of the claimed invention?
- YES Did others accept licenses under patents because of the merits of the claimed invention?

If your answer to Question 1 is "Yes," answer Question 6.A. If your answer to Question 1 is "No," skip all remaining questions and proceed to sign and date this Verdict Form.

6.A. Has Omega proven by clear and convincing evidence that CalAmp acted despite an objectively high likelihood that its actions infringed a valid patent?

✓ Yes No

If your answer to Question 6.A. is "Yes," proceed to Question 6.B. If your answer to Question 6.A. is "No," proceed to Question 7.

6.B. Has Omega proven by clear and convincing evidence that this objectively high likelihood of infringement was either known or so obvious that it should have been known to CalAmp?

✓ Yes No

Proceed to Question 7.

7. What amount of damages, if any, do you find is adequate to compensate Omega for CalAmp's infringement of any claim found to be valid and not licensed?

\$ 2,975,200

After answering Question 7, sign and date this Verdict Form.

SO SAY WE ALL THIS 24th DAY OF FEBRUARY, 2016.


JURY FOREPERSON

EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of)
KENNETH E. FLICK)
)
Request for Reexamination of)
U.S. PATENT NO. 6,346,876)
)
Control No. 90/014,122) Attorney Docket No.:
) C13-04173.RE2 (016635G_REX2)
Confirmation No. 5791)
) Examiner: R. DESAI
Filing Date: 4/19/2018)
) Art Unit: 3992
For: MULTI-VEHICLE COMPATIBLE)
CONTROL SYSTEM GENERATING)
COMMAND SIGNALS ON A DATA)
BUS AND ASSOCIATED)
METHODS)

DECLARATION BY JOSEPH C. McALEXANDER, III
UNDER 37 C.F.R. §1.132

I, the undersigned, hereby declare that:

I. Background

1. I am the Founder and President of McAlexander Sound, formerly IP Director of CCI, Vice President of EPI Technologies, Inc., and Design and Product Manager at Texas Instruments. I have 46 years of experience in microcircuit and semiconductor technologies, including: device design, fabrication, assembly, testing, marketing, analysis, quality, reliability, defect/failure analysis, and control system design.

2. I am a Registered Professional Engineer (#79454) in the State of Texas and hold a Bachelor of Science degree in Electrical Engineering from North Carolina State University.

3. I am a named inventor on 31 U.S. patents and a number of foreign patents, and I am familiar with the patent process.

4. I have been an expert witness and technical consultant for the past 27 years in IP matters related to product/process and system analysis and investigation.

5. I prepared expert reports and provided trial testimony in the case of Omega Patents, LLC (the '876 Patent Owner) v. CalAmp Corp. (the Requester) that has concluded in the Middle District of Florida (hereinafter referred to as the "CalAmp litigation"). In that CalAmp litigation, the '876 patent was asserted and determined by the jury to be not invalid, to be infringed by CalAmp, and that CalAmp acted despite an objectively high likelihood that its actions infringed a valid patent, and that this objectively high likelihood of infringement was either known or so obvious that it should have been known to CalAmp. In the Court's Final Order of April 5, 2017 (Exhibit 4 filed with the accompanying Response to Office Action), the Court confirmed that the asserted claims were not invalid (including the claims of the '876 patent), and that CalAmp was a willful infringer. In the Court's Final Judgment (Exhibit 5 filed with the accompanying Response to Office Action), the Court awarded damages of \$10,144,286.

6. I was retained by the Patent Owner to provide technical consultation in the first reexamination of the '876 patent (90/013,659).

7. I have been retained by the Patent Owner to provide technical consultation in the present second reexamination of the '876 patent, particularly with respect to addressing rejections based upon:

Cell Port Labs Press Release in view of Spelt, and the 1994 SAE HS-3000 Manual;

Jones et al. in view of the 1994 SAE HS-3000 Manual;
and

Chou et al. in view of the 1994 SAE HS-3000 Manual.

II. The '876 Patent and Current Office Action

8. I have extensively reviewed the '876 patent, along with its file history, and arguments advanced by Requester's trial expert, Mr. Andrews, as part of my work on behalf of the Patent Owner during the course of the CalAmp litigation. I have reviewed: the Jury Verdict of February 24, 2016 (Exhibit 2 with the accompanying Response to Office Action); the Court's Final Order of April 5, 2017; and the Final Judgment of April 24, 2017.

9. I have reviewed the current Office Action dated August 13, 2018 for the current reexamination of the '876 patent. I understand that Claims 12, 27, 28, 33-41 and 51 are

canceled and that Claims 1-11, 13-26, 29-32 and 42-50 are subject to three separate grounds for rejection in view of the prior art.

10. Representative Claim 1 of the '876 patent is directed to a control system for a vehicle comprising a data communications bus and at least one vehicle device connected to the data communications bus. The control system includes a transmitter and a receiver for receiving signals from said transmitter, and a multi-vehicle compatible controller at the vehicle and cooperating with the transmitter and receiver. As further recited in independent Claim 1, the multi-vehicle compatible controller generates at least one set of command signals on the data communications bus for the at least one vehicle device. The at least one set of command signals comprises at least one working command signal and at least one non-working command signal for a given vehicle to thereby provide command compatibility with a plurality of different vehicles. Independent Claims 18 and 42 are directed to a related adaptor and associated adapting method, respectively. Claim 29 is directed to a method corresponding to independent Claim 1 with the express recitation of the transmitter and receiver.

**III. The First Examination of the '876 Patent (Reexamination
Serial No. 90/013,639) and the Related Cell Port Labs and SAE
Rejections**

11. In the first reexamination of the '876 patent, the Examiner rejected the claims in view of Spaur (U.S. Patent No. 5,732,074; a Cell Port patent reference) in combination with the SAE scan tool bus discovery description in SAE J1978 and SAE J1979 within the SAE HS-3000 Manual. Also, in the first reexamination of the '876 patent, the Examiner rejected the claims over the combination of Braitberg et al. (WO 94/24775, equivalent to the '479 Braitberg et al. patent; a Cell Port reference) and the SAE scan tool bus discovery description of the HS-3000 Manual. These rejections were properly overcome in the Response dated November 18, 2016 because the rejections were based upon impermissible hindsight reconstruction.

IV. The Prior Art Analysis

12. I understand that the Cell Port Labs Press Release discloses a release of a CP2100 product. The CP2100 comprises a mobile network server "designed to enable bi-directional data communications and network management functions within vehicles and provide real-time, wireless connectivity between vehicles and remote applications." (Page 2). The CP2100 may provide "protocol conversion for a variety of vehicle busses and devices, wireless gateway communications independent of wireless links, and embedded application router management capabilities." *Id.*

13. I understand that Spelt discloses an intent to perform a demonstration, and states:

[t]his paper presents a "snapshot" of an evolving project to demonstrate the installation of the IDB in production vehicles. The demonstration shows the operation of a variety of electronics components from different manufacturers. The goal of Demo98 is to demonstrate several of the functional requirements and capabilities of the IDB. These include "hot plug-and-play" of devices, interoperability of a device in different vehicles, and the information-sharing capacity of devices connected to the IDB. (Page I22-1).

14. I understand that the 1994 SAE HS-3000 and 1997 SAE HS-3000 manuals are essentially compendiums of nine individual Diagnostic Committee documents and 4-5 (depending on the year) individual Multiplex Committee Documents.

15. I understand that Jones et al. (the Cell Port patent) discloses a communication system comprising a management portal apparatus and a plurality of communications devices embedded within different vehicles within a fleet. (See Figure 3). In Figure 3, each of the communications devices is marked CP2100.

16. I understand that the Chou et al. system includes a vehicle having an in-vehicle computing system and a client computer device to enable vehicle health checkup and remote diagnostics. A communication link is for communicating vehicle information (e.g., vehicle identification number (VIN), diagnostic data, and the like). The vehicle location is established, for example, by a device (e.g., antenna or the like) for receiving positioning information. A remote service

center is also provided having a diagnostic server, a help desk and a data repository. The help desk schedules services, orders parts, and dispatches assistance through the roadside assistance unit.

17. I understand that the vehicle bus interface of Chou et al. includes the following modules:

vehicle bus adapter 120C, fault detector 120B, and diagnostic data service 120A. The fault detector 120B polls the vehicle bus 104 through the vehicle bus adapter 120C, checking for fault codes reported by the vehicle ECUs 103. The vehicle bus adapter 120C translates the messages received from the vehicle bus into the language of the fault detector. It also translates messages from the fault detector into the language of the vehicle bus. The fault code specifications and protocols of the vehicle may be Original Equipment Manufacturer (OEM) and model dependent. The term "vehicle fault codes" is meant to be synonymous with the term "trouble code" or "diagnostic trouble code." (Col. 4, lines 21-32).

18. It is my opinion that one of ordinary skill in the art would recognize that Chou et al. teaches away from the claimed invention. Chou et al. provides repeated disclosure that the diagnostic server at the remote service center permits multi-vehicle compatibility. See, for example, col. 5, lines 34-39; col 5, lines 53-58; col. 5, lines 61-64; col. 8, lines 19-21; and col. 9, lines 3-16.

19. I submit that one of ordinary skill in the art would treat the prior art previously asserted in the first

reexamination, i.e. Braitberg et al., to be very similar to currently asserted prior art of the Cell Port Labs Press Release and Spelt, the Jones et al. (Cell Port) patent, and Chou et al.

20. I understand that the SAE J1978 document, Section 6.5.1, teaches that "[w]hile there are three types of communication interfaces that could be used to access the OBD II functions in a given vehicle (i.e., SAE 1850 41.6 Kbps PWM, SAE J1850 10.4 Kbps VPW and ISO 9141-2), only one is allowed to be used in any one vehicle"; that "[w]hen connected to a vehicle [] the OBD Scan Tool will automatically attempt to determine which of the possible communication interfaces is being used;" and that "[n]o user input will be required, nor allowed, to determine the appropriate interface."

21. I understand that the Court's Final Order describes the deficiencies in CalAmp's asserted invalidity theories at trial on pages 17 and 18. In supporting the impropriety of adding the SAE J1978 document to Braitberg et al., the Court notes that CalAmp's Mr. Chen was unaware of the SAE J1978 document. (Footnote 20, pg. 17). Mr. Chen is the Sr. Director - Corporate Development for CalAmp. Mr. Chen admitted to having conducted extensive studies of the prior art and is an inventor of U.S. Published Application No. 2012/015821 (now U.S. Patent Nos. 8,812,173 and 9,171,460) which borrows heavily from one of Mr. Flick's earlier patents and is directed to data bus technology subject matter similar to the '876 patent.

V. Evidence of Secondary Considerations and
Nexus with the '876 Patent

22. I submit that the person of ordinary skill in the art would not find it obvious to selectively modify the Cell Port Labs Press Release in view of Spelt (the Cell Port documents), Jones et al. (Cell Port patent), or Chou et al. with selected portions of the SAE HS-3000 Manual. Instead, it is my opinion that such a selective modification or combination would only be motivated by improper hindsight reconstruction - here about twenty years of hindsight.

23. I submit that merits of the claimed invention extend to providing multi-vehicle compatibility, as described above, and that there exists a nexus between the claimed invention and the evidence of secondary considerations of non-obviousness including:

- a. The Jury Verdict, page 9, provides that others accepted licenses under the patents "because of the merits of the claimed invention."
- b. Omega currently has 8 licenses that specifically include the '876 patent based on the Expert Report of the financial expert, Mr. Christian Tregillis.
- c. I also understand that Omega has received in excess of \$50 million in licensing revenue, much of it from the '876 patent and the other asserted patents in the

CalAmp litigation. The Final Judgment adds another \$10M to this amount.

- d. The '876 patent is one of three patents asserted in the related litigation providing features for multi-vehicle compatibility as is important for the overall licensing program of the Patent Owner.
- e. The Jury Verdict, page 9, includes the Jury's determination that the accused products were "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." And the Jury determined that the asserted claims of the '876 patent were infringed by each of the accused CalAmp devices. (Jury Verdict, Page 3).
- f. CalAmp's employees testified in the related litigation that the multi-vehicle compatibility provides for simplified installation in a vehicle and avoids the need for separated stock keeping units (SKUs). Hall deposition, 40:25 - 41:2; and Hergesheimer deposition, 43:3-16).
- g. CalAmp telemetry devices have enjoyed significant commercial success, having sold over 466,000 units of the accused products, earning over \$4.1 million in gross profits based upon the financial Expert Report of Mr. Tregillis.

- h. The Jury Verdict, on page 9, includes a finding that others copied the claimed invention.
- i. Flick's claimed inventions were copied by CalAmp and used to receive a patent grant.
- j. The Court determined that "CalAmp was well aware of Omega's patents since at least 2010. Rather than take a license, and choosing not to design around Omega's patents, CalAmp elected to sell infringing products and continues to do so to this day. CalAmp's motivation to engage in this behavior is obvious: their customers wanted this technology, and CalAmp wanted to provide it." (Final Order, pg. 19).
- k. The Accused Products in the CalAmp litigation were developed because of "customer need." (Hall deposition portions, and Hergesheimer deposition portions reproduced below).
- l. Further, I submit that the infringing CalAmp Products would have "limited value" if it were not for the multi-vehicle compatibility. (Hergesheimer deposition portions reproduced below).

Testimony of Stephen Hall

Q. Can you introduce yourself for the record

A. Yes. My name is Stephen Hall. The correct spelling is S-t-e-p-h-e-n.

Q. All right, sir. And by whom are you employed?

A. I'm an employee of CalAmp Corporation.

Q. Do you have a title at CalAmp?

A. My official title is director of system engineering and technology.

Q. What does it mean to be the director of system engineering and technology at CalAmp?

A. My role is to look at the needs of our customer and market and to match them up with various technologies that are going on in the industry component level and otherwise to make sure that we have an appropriate solution. (Stephen Hall deposition, 6:8-22).

Q. All right, sir. I'm going to hand you what was previously marked as Exhibit 1 to the deposition of Mr. Hergesheimer. Can you tell me what Exhibit 1 is?

A. I'm looking at a CalAmp datasheet for the LMU-3000 product.

Q. And were you involved in the development of
the LMU-3000?

A. I was.

Q. And what was your role in developing the LMU-
3000?

A. My role on the 3000 was at the CRS level. I
provided the requirements document for that. The various
blocks within it were predefined by our existing
partnerships, and so I didn't do a lot of component
selection type of work, so it was really limited just to
the CRS document.

Q. Was there a particular market need that you
identified leading up to the creation of the CRS for the
LMU-3000?

A. The 3000 was driven by a general market need that
we heard from a number of customers. The primary interest
was coming from a need for a *simple installation type of
solution* and the opportunity to enhance the capability of
the product that we could offer with certain data items
coming off of the vehicle bus. (Stephen Hall deposition,
6:8-22; and 40:20-41:12).

Testimony of Peter Hergesheimer

Q. You have been designated as a representative on whether CalAmp has willfully or deliberately infringed in this case. Beyond knowing about the devices and how they operate, do you know anything about CalAmp's assertions that its actions are not willful or deliberate?

A. I would say from my experience in the development of these devices that there's no willful infringement.

Q. And -- and what's that based on?

A. That's based on knowing where the -- the technology that we use came from and the fact that these were sales-driven requests and somebody had a problem to solve and we went about solving the problem.

Q. What do you mean sales-driven request?

A. Well, typically our -- typically we have a customer that says hey, I would like to do this particular -- have a product that has this feature and so CalAmp goes about designing that product.

Q. So the LMU3000 development was the result of -- or was -- was undertaken because customers expressed a demand to CalAmp for these products?

A. I -- I believe that's the case. I can't say specifically for these, but that's in general how our product development works. (Peter Hergesheimer deposition, 40:6 - 41:3).

Q. Can you state your name for the record.

A. Peter Hergesheimer.

Q. All right. Sir, and by whom are you employed?

A. CalAmp.

Q. Okay. And what's your position at CalAmp?

A. I'm the senior director of software and architecture in the MRM group. (Peter Hergesheimer deposition, 6:2-8).

Q. Do you know whether the LMU3000 would have any value if it didn't work on multiple vehicles?

A. It would have a limited value.

Q. You would need separate skus for each vehicle; right?

A. That would be one way of solving that problem.

Q. Is there any other way?

A. Different skus could be different software got loaded onto the same sku.

Q. Okay. So you can -- whether you have a different sku or not, you would need to -- if -- if the LMU3000 was vehicle specific, it would need software for each vehicle in which it was -- separate software for each vehicle in which it was designed to work?

A. Each vehicle type I would guess, yes.

Q. And that would be a more expensive exercise, I would think, from CalAmp's perspective?

A. Yes.

Q. And less desirable than the -- than the option you have now where the LMU is able to service multiple vehicles?

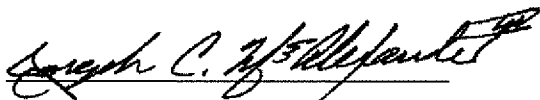
A. Yes, even though it is still pretty painful.

(Peter Hergesheimer deposition, 46:25 - 47:19).

24. I hereby declare further that all statements made herein are of my own knowledge and are true, and that all

In re Patent of
Kenneth E. FLICK
Reexamination Control No. 90/014,122
Filed: 4/19/2018

statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful and false statements may jeopardize the validity of the application or any patent issued thereon.



Joseph C. McAlexander, III

October 15, 2018

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of **KENNETH E. FLICK**)
)
Request for Reexamination of) Examiner: **Mark Alan Sager**
U.S. PATENT NO. 8,032,278)
) Art Unit: **3992**
Control No. **90/014,309**)
) Attorney Docket No.
Confirmation No. **8724**) **C13-03896.3**
) **(58106CIP1_REX3)**
Filing Date: **May 24, 2019**)
)
For: **VEHICLE TRACKING UNIT WITH**)
 DOWNLOADABLE CODES AND)
 ASSOCIATED METHODS)
)

CITATION UNDER 37 CFR § 1.555

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Attached is Form PTO/SB/08b listing several references for consideration in the examination of the above-identified application. It is requested that these references be considered by the Examiner and officially made of record. The Commissioner is hereby authorized to charge or credit any discrepancies in fee amounts to Deposit Account No. 01-0484.

Respectfully submitted,

/ CHRISTOPHER F. REGAN /

CHRISTOPHER F. REGAN
Reg. No. 34,906
Allen, Dyer, Doppelt,
+ Gilchrist, P.A.
255 S. Orange Avenue, Suite 1401
Post Office Box 3791
Orlando, Florida 32802
407/841-2330
Attorney for Patent Owner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of KENNETH E. FLICK	)	
	)	
Request for Reexamination of	)	
U.S. PATENT NO. 8,032,278	)	
	)	
Control No. 90/014,309	)	
	)	
Confirmation No. 8724	)	Examiner:
	)	
Filing Date: May 24, 2019	)	Art Unit
	)	
For: VEHICLE TRACKING UNIT WITH	)	Attorney Docket No.:
DOWNLOADABLE CODES AND	)	C13-03896.3
ASSOCIATED METHODS	)	(58106CIP1_REX3)
	)	

FILING UNDER 37 C.F.R. §1.565

EFILE

Commissioner for Patents

Commissioner:

Pursuant to 37 C.F.R. §1.565 and §41.37(c)(1)(ii), the Patent Owner respectfully advises that in the related litigation with the Requester, the second trial concluded with a Jury Verdict, on September 30, 2019, finding that the Requester infringed the present '278 patent and the related '727 patent. The Jury Verdict also found damages in the amount of \$4,586,111.

The Commissioner is hereby authorized to charge or credit any discrepancies in fee amounts to Deposit Account No. 01-0484.

Respectfully submitted,

/Jack G. Abid/

In re Patent of
Kenneth E. FLICK
Reexamination Control No. **90/014,122**
Filed: **04/19/2018**

JACK GEORGE ABID
Reg. No. 58,237
Allen, Dyer, Doppelt +
Gilchrist, P.A.
255 S. Orange Avenue, Suite 1401
Post Office Box 3791
Orlando, Florida 32802
407-841-2330
407-841-2343 fax
Attorney for the Patent Owner

In re Patent of
Kenneth E. FLICK
Reexamination Control No. 90/014,122
Filed: 04/19/2018

CERTIFICATE OF SERVICE

Certificate of Service in compliance with 37 C.F.R. §1.530(c)

Pursuant to 37 C.F.R. §§1.530(c), 1.248, I hereby certify that on November 22, 2019, a complete copy of this Request is being served via First Class U.S. Mail upon Third Party Requester at the correspondence address as shown in PAIR:

KPPB LLP
2190 S. Towne Centre Place
Suite 300
Anaheim CA 92806

Respectfully submitted,

/JACK GEORGE ABID/

Jack G. Abid

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of KENNETH E. FLICK	)	
	)	
Request for Reexamination of	)	
U.S. PATENT NO. 8,032,278	)	
	)	
Control No. 90/014,309	)	
	)	
Confirmation No. 8724	)	Examiner:
	)	
Filing Date: May 24, 2019	)	Art Unit
	)	
For: VEHICLE TRACKING UNIT WITH	)	Attorney Docket No.:
DOWNLOADABLE CODES AND	)	C13-03896.3
ASSOCIATED METHODS	)	(58106CIP1_REX3)
	)	

INTERVIEW SUMMARY OF TELEPHONE CALL OF NOVEMBER 11, 2019

EFILE

Commissioner for Patents

Commissioner:

The Patent Owner thanks the U.S. Patent and Trademark Office and Central Reexamination Unit Specialist Stephen Stein for extending all courtesies to the Patent Owner's Representative during the telephonic conference of November 11, 2019.

During the telephonic conference, Specialist Stein explained the rationale behind the prior Decisions Expunging/Returning Papers in Reexamination. In particular, Specialist Stein explained the USPTO's position that the scope of the Patent Owner's duties with regards to 37 C.F.R. §1.565 and §41.37(c)(1)(ii) relates only to proceedings and reexaminations related to the present U.S. Patent No. 8,032,278.

In re Patent of
Kenneth E. FLICK
Reexamination Control No. **90/014,122**
Filed: **04/19/2018**

Also, Specialist Stein explained the USPTO's position that the scope of the Patent Owner's duties with regards to 37 C.F.R. §1.565 and §41.37(c)(1)(ii) was not limited to simple bare notice, but should not include arguments for patentability.

The Commissioner is hereby authorized to charge or credit any discrepancies in fee amounts to Deposit Account No. 01-0484.

Respectfully submitted,

/Jack G. Abid/

JACK GEORGE ABID
Reg. No. 58,237
Allen, Dyer, Doppelt +
Gilchrist, P.A.
255 S. Orange Avenue, Suite 1401
Post Office Box 3791
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407-841-2343 fax
Attorney for the Patent Owner

In re Patent of
Kenneth E. FLICK
Reexamination Control No. 90/014,122
Filed: 04/19/2018

CERTIFICATE OF SERVICE

Certificate of Service in compliance with 37 C.F.R. §1.530(c)

Pursuant to 37 C.F.R. §§1.530(c), 1.248, I hereby certify that on November 22, 2019, a complete copy of this Request is being served via First Class U.S. Mail upon Third Party Requester at the correspondence address as shown in PAIR:

KPPB LLP
2190 S. Towne Centre Place
Suite 300
Anaheim CA 92806

Respectfully submitted,

/JACK GEORGE ABID/

Jack G. Abid

Electronic Acknowledgement Receipt

EFS ID:	37831984
Application Number:	90014309
International Application Number:	
Confirmation Number:	8724
Title of Invention:	Vehicle Tracking Unit with Downloadable Codes and Associated Methods
First Named Inventor/Applicant Name:	8032278
Correspondence Address:	CHRISTOPHER F. REGAN, ESQUIRE ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, PA PO BOX 3791 - ORLANDO FL 32802-3791 US 4078412330 -
Filer:	Jack G. Abid/Sheryl Scheibe
Filer Authorized By:	Jack G. Abid
Attorney Docket Number:	C13-03896.RE3
Receipt Date:	22-NOV-2019
Filing Date:	24-MAY-2019
Time Stamp:	13:08:25
Application Type:	Reexam (Patent Owner)

Payment information:

Submitted with Payment	no
------------------------	----

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		SS58106CIP1REX3MISC.pdf	137320 6d7ab06607483490164953349dfe9bb02ba5dd99	yes	6
Multipart Description/PDF files in .zip description					
	Document Description		Start	End	
	Miscellaneous Incoming Letter		4	6	
	Miscellaneous Incoming Letter		1	3	
Warnings:					
The page size in the PDF is too large. The pages should be 8.5 x 11 or A4. If this PDF is submitted, the pages will be resized upon entry into the Image File Wrapper and may affect subsequent processing					
Information:					
Total Files Size (in bytes):			137320		
This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503. <u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application. <u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course. <u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.					

<i>Index of Claims</i> 	Application/Control No. 90/014,309	Applicant(s)/Patent Under Reexamination 8032278
	Examiner MARK A SAGER	Art Unit 3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS										
☒ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47										
CLAIM			DATE							
Final	Original	11/13/2019								
	1	=								
	2	=								
	3	=								
	4	=								
	5	=								
	6	=								
	7	=								
	8	=								
	9	=								
	10	=								
	11	=								
	12	=								
	13	=								
	14	=								
	15	=								
	16	=								
	17	=								
	18	=								
	19	=								
	20	=								
	21	=								
	22	=								

Issue Classification 	Application/Control No. 90/014,309	Applicant(s)/Patent Under Reexamination 8032278
	Examiner MARK A SAGER	Art Unit 3992

CPC						
Symbol					Type	Version
G08G	/	1	/	20	F	2013-01-01
G07C	/	5	/	008	I	2013-01-01
B60R	/	25	/	33	I	2013-01-01
B60R	/	25	/	04	I	2013-01-01
B60R	/	25	/	102	I	2013-01-01
B60R	/	25	/	045	I	2013-01-01
G08G	/	1	/	127	I	2013-01-01
G08G	/	1	/	205	I	2013-01-01
B60R	/	25	/	104	I	2013-01-01
B60R	/	2325	/	205	A	2013-01-01
B60R	/	2325	/	202	A	2013-01-01
B60W	/	2550	/	402	A	2013-01-01

CPC Combination Sets					
Symbol				Type	Version
/	/				

NONE (Assistant Examiner) _____ (Date) _____		Total Claims Allowed: 22	
/Mark Sager/ (Primary Examiner) _____ (Date) _____		18 November 2019 (Date)	O.G. Print Claim(s) 1
			O.G. Print Figure 2

Issue Classification 	Application/Control No. 90/014,309	Applicant(s)/Patent Under Reexamination 8032278
	Examiner MARK A SAGER	Art Unit 3992

INTERNATIONAL CLASSIFICATION			
CLAIMED			
G01C	/	21	/ 00
NON-CLAIMED			
/		/	

US ORIGINAL CLASSIFICATION	
CLASS	SUBCLASS
701	36

CROSS REFERENCES(S)						
CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)					
382	104					
701	29.3	29.6				

NONE		Total Claims Allowed:	
(Assistant Examiner)	(Date)	22	
/Mark Sager/	18 November 2019	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	1	2

Issue Classification 	Application/Control No. 90/014,309	Applicant(s)/Patent Under Reexamination 8032278
	Examiner MARK A SAGER	Art Unit 3992

☒ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47
--

CLAIMS															
Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
	1		10		19										
	2		11		20										
	3		12		21										
	4		13		22										
	5		14												
	6		15												
	7		16												
	8		17												
	9		18												

NONE (Assistant Examiner) _____ (Date) _____		Total Claims Allowed: 22	
/Mark Sager/ (Primary Examiner) _____ (Date) 18 November 2019		O.G. Print Claim(s) 1	O.G. Print Figure 2

Reexamination 	Application/Control No. 90/014,309	Applicant(s)/Patent Under Reexamination 8032278
	Certificate Date February 6, 2019	Certificate Number C2

Requester Correspondence Address: ☐ Patent Owner ☒ Third Party
David J. Bailey KPPB LLP 2190 S. Towne Centre, Suite 300 Anaheim CA 92806

LITIGATION REVIEW ☒	/MS/ (examiner initials)	12 November 2019 (date)
Case Name		Director Initials
6:13cv1950-PGB-DAB (M.D. Fla. Dec 20, 2013)		
1:14cv2769 stayed pending outcome of reexam Jan 31, 2018		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,309	05/24/2019	8032278	C13-03896.RE3	8724

7590 11/27/2019
CHRISTOPHER F. REGAN, ESQUIRE
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, PA
PO BOX 3791
ORLANDO, FL 32802-3791

EXAMINER

SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
----------	--------------

3992

MAIL DATE	DELIVERY MODE
-----------	---------------

11/27/2019

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David J. Bailey
KPPB LLP
2190 S. Towne Centre, Suite 300
Anaheim CA 92806

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/014,309 .

PATENT UNDER REEXAMINATION 8032278 .

ART UNIT 3992 .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Notice of Intent to Issue Ex Parte Reexamination Certificate	Control No. 90/014,309	Patent Under Reexamination 8032278	
	Examiner MARK A SAGER	Art Unit 3992	AIA Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of
 - (a) ☐ Patent owner's communication(s) filed: _____.
 - (b) ☐ Patent owner's failure to file an appropriate timely response to the Office action mailed: _____.
 - (c) ☐ Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
 - (d) ☐ The decision on appeal by the ☐ Board of Patent Appeals and Interferences ☐ Court dated _____
 - (e) ☒ Other: Reasons for Allowance noted in #4.
 2. The Reexamination Certificate will indicate the following:
 - (a) Change in the Specification: ☐ Yes ☒ No
 - (b) Change in the Drawing(s): ☐ Yes ☒ No
 - (c) Status of the Claim(s):
 - (1) Patent claim(s) confirmed: 1-22.
 - (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
 - (3) Patent claim(s) canceled: _____.
 - (4) Newly presented claim(s) patentable: _____.
 - (5) Newly presented canceled claims: _____.
 - (6) Patent claim(s) ☐ previously ☐ currently disclaimed: _____
 - (7) Patent claim(s) not subject to reexamination: _____.
 3. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.
 4. ☒ Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
 5. ☐ Note attached NOTICE OF REFERENCES CITED (PTO-892).
 6. ☐ Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
 7. ☐ The drawing correction request filed on _____ is: ☐ approved ☐ disapproved.
 8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have
 - ☐ been received.
 - ☐ not been received.
 - ☐ been filed in Application No. _____.
 - ☐ been filed in reexamination Control No. _____.
 - ☐ been received by the International Bureau in PCT Application No. _____.
- * Certified copies not received: _____.
9. ☐ Note attached Examiner's Amendment.
 10. ☐ Note attached Interview Summary (PTO-474).
 11. ☐ Other: _____.

All correspondence relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

/Mark Sager/
Reexamination Specialist, Art Unit 3992

cc: Requester (if third party requester)

U.S. Patent and Trademark Office

PTOL-469 (Rev. 08-13)

Notice of Intent to Issue Ex Parte Reexamination Certificate

Part of Paper No. 20191031

Notice of Pre-AIA or AIA Status

1. The present application is being examined under the pre-AIA first to invent provisions.
2. The request (the “Request”) for *ex parte* reexamination of claims 1-22 of U.S. Patent No. 8,032,278 (“the ‘278 patent”) filed on May 24, 2019 was granted in Order mailed July 10, 2019.

References

3. The following references are relied on herein

(1) U.S. Patent No. **6,430,164** to **Jones et al**, published August 6, 2002, filed November 1 1999, (hereinafter also referred to as ‘**164, Jones**, or **Exhibit I**).

(2) “CellPort Delivers Wireless, Vehicle-Based Applications Platform; Announces CP2100 Mobile Network Server,” published July 26, 1999, (hereinafter also referred to as **Cell Port Labs Press Release**, as **CPL** or **Exhibit F**).

(3) “A Demonstration Project for the ITS Data Bus Prototype,” published in 1998, (hereinafter also referred to as **Spelt** or **Exhibit G**).

(4) “Prep for a Multimedia Future,” published August 19, 1999 (hereinafter also referred to as **Auto Electronics** or **Exhibit H**).

(5) **SAE HS-3000** publication, “SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual” (1994 and 1997 Editions), copyright 1994 and 1997 respectively, (hereinafter also referred to as **SAE HS-3000** or as **Exhibits J and K**).

Extensions of Time

4. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

Notification of Concurrent Proceedings

5. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving

Patent No. 8032278 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Amendment in Reexamination Proceedings

6. The patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

Submissions

7. In order to insure full consideration of any amendments, affidavits or declarations or other documents as evidence of patentability, such documents must be submitted in response to the first Office action on the merits (which does not result in a close of prosecution). Submissions after the second Office action on the merits, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and by 37 CFR 41.33 after appeal, which will be strictly enforced.

Claim Construction

8. The claims under reexamination are given the broadest reasonable interpretation consistent with the specification. See *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984). For claims of an expired patent, the standard for claim construction set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (words of a claim “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art at the time of the invention) would apply since expired claims are not subject to amendment.

See MPEP § 2258(I)(G). We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. See 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144-45 (2016). In applying a broadest reasonable construction, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. See *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). The '278 Patent at issue herein has not expired, so the claims in this reexamination are given the broadest reasonable interpretation consistent with '2786 disclosure where claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure.

Service of Papers

9. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

Filing Date

10. The earliest effective filing date the '278 patent is entitled to is July 3, 2007 (see paragraph 2 of the non-final rejection mailed 5/6/2016 in 90/013,587 discussed *infra*).

Reexamination

11. Claims 1-22 are confirmed.

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding: lacking evidence to the contrary in this record regarding cited claims at issue herein, with broadest reasonable interpretation of the claims in light of '278 without reading a limitation from '278 into the claims, upon consideration of the references (Jones, Cell Port Labs Press Release, Spelt, SAE HS-3000 and AutoElectronics) in Request, alone or in combination, lack suggesting/teaching "*said multi-vehicle controller* to be coupled to the *vehicle data bus* for communication thereover with *at least one vehicle device* using at least one corresponding vehicle device code from among a plurality thereof for different vehicles" and "*downloading interface* for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller" as particularly recited in independent claims 1, 13 and 18. For instance, although Cell Port Labs Press Release and Jones each describe CP2100 as vehicle controller in the Request, the discussion in these two references does not disclose, teach or suggest, alone or in combination with references in the Request, the specifically recited "*said multi-vehicle compatible controller* to be *coupled to the vehicle data bus* for communication thereover *with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles.*" Also, although Spelt discusses a demonstration of CellPort's ITS data bus (IDB), Spelt states the IDB is connected to the vehicle multiplex through a gateway, where the gateway, under control of the auto company, acts as a firewall allowing only authorized message traffic to pass between the auto's multiplex bus and the IDB devices. Further, the respective 1994 and 1997 SAE HS-3000 Manuals regard vehicle diagnostic by test equipment that discuss a bus discovery process used by a scan tool that

requires temporary hard-wire connection for the diagnostics. These respective Manuals state that vehicle device codes are proprietary to auto manufacturers. Thus, taken as a whole at time of the invention, there is a lack of a stated motivation/rationale in the Request to combine and, in any event, inadequate factual support in these references in the Request when taken as whole, either alone or in combination, to teach or suggest the specifically recited “*said multi-vehicle controller* to be coupled to the *vehicle data bus* for communication thereover with *at least one vehicle device* using at least one corresponding vehicle device code from among a plurality thereof for different vehicles” and “*downloading interface* for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller” The Request fails to present basis for limitations being inherent (i.e., including Request statements of “necessarily must”) and fails to clearly state rationale for combining these references to demonstrate an artisan would interpret the claimed invention including a multi-vehicle controller and a downloading interface as recited in claims at issue herein is unpatentable when taken as a whole for what the facts in the references describe at time of the invention.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

Correspondence

12. **All** correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
 Central Reexamination Unit
 Commissioner for Patents
 United States Patent & Trademark Office

P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://efs.uspto.gov/efile/myportal/efs-registered>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.

Other useful telephone numbers:

Reexamination Practice (571) 272-7703

/Mark Sager/
Patent Reexam Specialist, Art Unit 3992

/F.O.F/
Reexamination Specialist, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992

<i>Search Notes</i> 	Application/Control No. 90/014,309	Applicant(s)/Patent Under Reexamination 8032278
	Examiner MARK A SAGER	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 8032278 including 90/013587 and 90/013851. Also reviewed 90/03569, 90/013741, 90/01422 and 90/014038 discussed in Request.	06/17/2019	MS
updated review/search of file history	11/13/2019	MS

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner

/Mark Sager/ Primary Examiner, Art Unit 3992	
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PTO/SB/08b (07-09)

Approved for use through 07/31/2016. OMB 0651-0031

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Substitute for form 1449/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Complete if Known

Application Number	90/014,309
Filing Date	MAY 24, 2019
First Named Inventor	Kenneth E. Flick
Art Unit	3992
Examiner Name	Mark Alan Sager
Attorney Docket Number	0058106CIP8_REX2

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		UNITED STATES DISTRICT COURT MIDDLE DISTRICT OF FLORIDA ORLANDO DIVISION, Verdict Form, Case No. 6:13-cv-1950-Orl-40DCI, 7 pages, September 30, 2019.	
		FOSTER, EXAMINER ROLAND G., UNITED STATES PATENT AND TRADEMARK OFFICE, Notice of Intent to Issue ExParte Reexamination Certificate for Reexamination Control No. 90/014,038 dated August 21, 2019, 12 pages.	
		UNITED STATES PATENT AND TRADEMARK OFFICE, Ex Parte Reexamination Certificate US 6,756,885 C2, Certificate Issued October 25, 2019, 2 pages.	
		DESAI, EXAMINER RACHNA SINGH, UNITED STATES PATENT AND TRADEMARK OFFICE, Examiner's Answer for Reexamination Control No. 90/014,122 dated June 18, 2019, 27 pages.	
		ABID, ESQ. JACK G.; ALLEN, DYER, DOPPELT, MILBRATH + GILCHRIST, P.A., Patent Owner's Appeal Brief filed May 15, 2019 with the United States Patent and Trademark Office for Reexamination Control No. 90/014,122, 384 pages.	
		ABID, ESQ. JACK G.; ALLEN, DYER, DOPPELT, MILBRATH + GILCHRIST, P.A., Appellant's Reply Brief filed August 19, 2019 with the United States Patent and Trademark Office for Reexamination Control No. 90/014,122, 29 pages.	

Examiner Signature	/MARK SAGER/	Date Considered	12/09/2019
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /M.S./

Reexamination 	Application/Control No. 90/014,309	Applicant(s)/Patent Under Reexamination 8032278
	Certificate Date	Certificate Number C3

Requester Correspondence Address: ☐ Patent Owner ☒ Third Party
David J. Bailey KPPB LLP 2190 S. Towne Centre, Suite 300 Anaheim CA 92806

LITIGATION REVIEW ☒	/MS/ (examiner initials)	12 November 2019 (date)
Case Name		Director Initials
6:13cv1950-PGB-DAB (M.D. Fla. Dec 20, 2013)		SJS for JC
1:14cv2769 stayed pending outcome of reexam Jan 31, 2018		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
NONE	

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,309	05/24/2019	8032278	C13-03896.RE3	8724

7590 12/11/2019
CHRISTOPHER F. REGAN, ESQUIRE
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, PA
PO BOX 3791
ORLANDO, FL 32802-3791

EXAMINER

SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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12/11/2019

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David J. Bailey
KPPB LLP
2190 S. Towne Centre, Suite 300
Anaheim CA 92806

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/014,309.

PATENT UNDER REEXAMINATION 8032278.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR/ PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90/014,309	05/24/2019	8032278	C13-03896.RE3

CHRISTOPHER F. REGAN, ESQUIRE ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, PA PO BOX 3791 ORLANDO, FL 32802-3791		EXAMINER	
		Mark Sager	
		ART UNIT	PAPER
		3992	20191209

DATE MAILED: _____

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The information disclosure statement (IDS), received November 21, 2019, has been received and considered (See attached SB08b). The references listed on that IDS regard documents posted in related reexaminations that do not alter findings in the Notice to Issue Ex Parte Reexamination Certificate mailed November 27, 2019.

/Mark Sager/
Art Unit 3992, CRU

/Alex Kosowski/
Art Unit, 3992, CRU

/Stephen Stein/
MQAS, CRU



US008032278C3

(12) **EX PARTE REEXAMINATION CERTIFICATE** (11625th)
United States Patent
Flick

(10) **Number:** **US 8,032,278 C3**(45) **Certificate Issued:** **Jan. 8, 2020**

(54) **VEHICLE TRACKING UNIT WITH
DOWNLOADABLE CODES AND
ASSOCIATED METHODS**

(75) Inventor: **Kenneth E. Flick**, Douglasville, GA
(US)

(73) Assignee: **OMEGA PATENTS, L.L.C.**,
Douglasville, GA (US)

Reexamination Request:

No. 90/014,309, May 24, 2019

Reexamination Certificate for:

Patent No.: **8,032,278**
Issued: **Oct. 4, 2011**
Appl. No.: **11/773,272**
Filed: **Jul. 3, 2007**

B60R 25/04 (2013.01)
B60R 25/102 (2013.01)
B60R 25/045 (2013.01)
G08G 1/127 (2006.01)
B60R 25/104 (2013.01)
(52) **U.S. Cl.**
CPC **G08G 1/20** (2013.01); **B60R 25/04**
(2013.01); **B60R 25/045** (2013.01); **B60R**
25/102 (2013.01); **B60R 25/104** (2013.01);
B60R 25/33 (2013.01); **G07C 5/008** (2013.01);
G08G 1/127 (2013.01); **G08G 1/205**
(2013.01); **B60R 2325/202** (2013.01); **B60R**
2325/205 (2013.01); **B60W 2550/402**
(2013.01)

(58) **Field of Classification Search**

None

See application file for complete search history.

(56)

References Cited

To view the complete listing of prior art documents cited during the proceeding for Reexamination Control Number 90/014,309, please refer to the USPTO's public Patent Application Information Retrieval (PAIR) system under the Display References tab.

Primary Examiner — Mark Sager

(57)

ABSTRACT

A multi-vehicle compatible tracking unit is for a vehicle including a vehicle data bus extending throughout the vehicle. The vehicle tracking unit may include a vehicle position determining device, a wireless communications device, and a multi-vehicle compatible controller for cooperating with the vehicle position determining device and the wireless communications device to send vehicle position information. The multi-vehicle compatible controller may be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles. A downloading interface may be included for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multivehicle compatible controller.

Reexamination Certificate C1 8,032,278 issued Dec. 28, 2016

Reexamination Certificate C2 8,032,278 issued Feb. 6, 2019

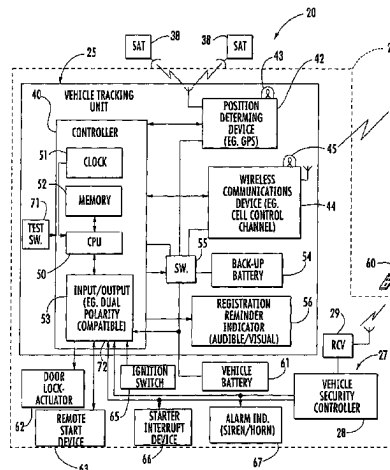
Related U.S. Application Data

- (63) Continuation-in-part of application No. 11/076,259, filed on Mar. 9, 2005, now Pat. No. 7,720,597, which is a continuation of application No. 10/383,496, filed on Mar. 7, 2003, now Pat. No. 7,149,623, which is a continuation of application No. 09/859,972, filed on May 17, 2001, now Pat. No. 6,606,561.
- (60) Provisional application No. 60/264,811, filed on Jan. 29, 2001, provisional application No. 60/258,005, filed on Dec. 22, 2000, provisional application No. 60/251,552, filed on Dec. 6, 2000, provisional application No. 60/252,125, filed on Nov. 20, 2000, provisional application No. 60/246,463, filed on Nov.

(Continued)

(51) **Int. Cl.**

G01C 21/00 (2006.01)
G08G 1/00 (2006.01)
G07C 5/00 (2006.01)
B60R 25/33 (2013.01)



Related U.S. Application Data

7, 2000, provisional application No. 60/236,890, filed on Sep. 29, 2000, provisional application No. 60/222,777, filed on Aug. 3, 2000, provisional application No. 60/205,178, filed on May 17, 2000.

1

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**EX PARTE
REEXAMINATION CERTIFICATE**

NO AMENDMENTS HAVE BEEN MADE TO
THE PATENT 5

AS A RESULT OF REEXAMINATION, IT HAS BEEN
DETERMINED THAT:

The patentability of claims 1-22 is confirmed. 10

* * * * *

Electronic Acknowledgement Receipt

EFS ID:	41313153
Application Number:	90014309
International Application Number:	
Confirmation Number:	8724
Title of Invention:	Vehicle Tracking Unit with Downloadable Codes and Associated Methods
First Named Inventor/Applicant Name:	8032278
Correspondence Address:	CHRISTOPHER F. REGAN, ESQUIRE ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, PA PO BOX 3791 - ORLANDO FL 32802-3791 US 4078412330 -
Filer:	Glen Madison Kellett/Stacy Tebo
Filer Authorized By:	Glen Madison Kellett
Attorney Docket Number:	C13-03896.RE3
Receipt Date:	07-DEC-2020
Filing Date:	24-MAY-2019
Time Stamp:	15:57:21
Application Type:	Reexam (Third Party)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Power of Attorney	324721_POA.pdf	733906	no	2
			2172d54246245a5c55a40c53038463d4073c78ac		
Warnings:					
Information:					
Total Files Size (in bytes):			733906		
This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503. <u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application. <u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course. <u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.					

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NOTE: This form is to be submitted with the Power of Attorney by Applicant form (PTO/AIA/82B) to identify the application to which the Power of Attorney is directed, in accordance with 37 CFR 1.5, unless the application number and filing date are identified in the Power of Attorney by Applicant form. If neither form PTO/AIA/82A nor form PTO/AIA82B identifies the application to which the Power of Attorney is directed, the Power of Attorney will not be recognized in the application.

Application Number	90014309
Filing Date	May 24, 2019
First Named Inventor	
Title	Vehicle Tracking Unit with Downloadable Codes and Associated Methods
Art Unit	3992
Examiner Name	Sager, mark Alan
Attorney Docket Number	C13-03896.RE3/324721

SIGNATURE of Applicant or Patent Practitioner

Signature	/GLEN M. KELLETT/	Date (Optional)	2020-12-07
Name	GLEN M. KELLETT	Registration Number	60202
Title (if Applicant is a juristic entity)	Attorney of Record		
Applicant Name (if Applicant is a juristic entity)			

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. If more than one applicant, use multiple forms.



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Application Number

Filing Date

(Note: The boxes above may be left blank if information is provided on form PTO/AIA/82A.)



I hereby appoint the Patent Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above:

23643

OR



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The address associated with Customer Number:

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Address

City

State

Zip

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Email

I am the Applicant (if the Applicant is a juristic entity, list the Applicant name in the box):

CALAMP CORP.



Inventor or Joint Inventor (title not required below)



Legal Representative of a Deceased or Legally Incapacitated Inventor (title not required below)



Assignee or Person to Whom the Inventor is Under an Obligation to Assign (provide signer's title if applicant is a juristic entity)



Person Who Otherwise Shows Sufficient Proprietary Interest (e.g., a petition under 37 CFR 1.46(b)(2) was granted in the application or is concurrently being filed with this document) (provide signer's title if applicant is a juristic entity)

SIGNATURE of Applicant for Patent

The undersigned (whose title is supplied below) is authorized to act on behalf of the applicant (e.g., where the applicant is a juristic entity).

Signature

Date (Optional)

Name

Stephen M. Moran, Esq.

Title

Senior Vice President, General Counsel & Secretary

NOTE: Signature - This form must be signed by the applicant in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. If more than one applicant, use multiple forms.



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Bib Data Sheet

CONFIRMATION NO. 8724

SERIAL NUMBER 90/014,309	FILING OR 371(c) DATE 05/24/2019 RULE	CLASS 701	GROUP ART UNIT 3992	ATTORNEY DOCKET NO. C13-03896.RE3
AIA (First Inventor to File): YES				
INVENTORS 8032278, Residence Not Provided; OMEGA PATENTS, LLC, DOUGLASVILLE, GA; DAVID J. BAILEY (3RD PTY REQ.), ANAHEIM, CA;				
APPLICANTS KPPB LLP, (CALAMP), ANAHEIM, CA				
** CONTINUING DATA ***** This application is a REX of 11/773,272 07/03/2007 PAT 8032278 which is a CIP of 11/076,259 03/09/2005 PAT 7720597 which is a CON of 10/383,496 03/07/2003 PAT 7149623 which is a CON of 09/859,972 05/17/2001 PAT 6606561 which claims benefit of 60/264,811 01/29/2001 and claims benefit of 60/258,005 12/22/2000 and claims benefit of 60/251,552 12/06/2000 and claims benefit of 60/252,125 11/20/2000 and claims benefit of 60/236,890 09/29/2000 and claims benefit of 60/246,463 11/07/2000 and claims benefit of 60/222,777 08/03/2000 and claims benefit of 60/205,178 05/17/2000				
** FOREIGN APPLICATIONS *****				
Foreign Priority claimed ☐ yes ☐ no 35 USC 119 (a-d) conditions ☐ yes ☐ no ☐ Met after met Allowance Verified and Acknowledged		STATE OR COUNTRY	SHEETS DRAWING	TOTAL CLAIMS 22
Examiner's Signature _____ Initials _____				INDEPENDENT CLAIMS 3
ADDRESS 27975				
TITLE				

Vehicle Tracking Unit with Downloadable Codes and Associated Methods

FILING FEE RECEIVED 12000	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:	<table border="1"> <tr> <td>☐ All Fees</td> </tr> <tr> <td>☐ 1.16 Fees (Filing)</td> </tr> <tr> <td>☐ 1.17 Fees (Processing Ext. of time)</td> </tr> <tr> <td>☐ 1.18 Fees (Issue)</td> </tr> <tr> <td>☐ Other _____</td> </tr> <tr> <td>☐ Credit</td> </tr> </table>	☐ All Fees	☐ 1.16 Fees (Filing)	☐ 1.17 Fees (Processing Ext. of time)	☐ 1.18 Fees (Issue)	☐ Other _____	☐ Credit
☐ All Fees								
☐ 1.16 Fees (Filing)								
☐ 1.17 Fees (Processing Ext. of time)								
☐ 1.18 Fees (Issue)								
☐ Other _____								
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/014,309	05/24/2019	8032278	C13-03896.RE3

CONFIRMATION NO. 8724

POA ACCEPTANCE LETTER

27975
ADD+G - 27975
1135 East State Road 434, Suite 3001
Winter Springs, FL 32708



Date Mailed: 01/15/2021

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/13/2021.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

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/rbell/



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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/014,309	05/24/2019	8032278	C13-03896.RE3

CONFIRMATION NO. 8724

POWER OF ATTORNEY NOTICE



23643
Barnes & Thornburg LLP (IN)
11 S. Meridian Street
Indianapolis, IN 46204

Date Mailed: 01/15/2021

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/13/2021.

- The Power of Attorney to you in this application has been revoked by the applicant. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

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/rbell/