

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON CONNECT INC.,
PETITIONER,

V.

OMEGA PATENTS, LLC
PATENT OWNER.

CASE IPR2023-001162
PATENT 8,032,278

**PATENT OWNER'S SUR-REPLY IN
RESPONSE TO PETITIONER'S REPLY IN
SUPPORT OF ITS PETITION**

TABLE OF CONTENTS

I.	GROUND 1: CLAIMS 1-22 ARE NOT OBVIOUS OVER THE ‘885 AND ‘561 PATENTS.....	1
A.	Both References Were Before the Initial Examiner	2
B.	The References Are Cumulative of Others Considered in Various Proceedings	3
C.	Petitioner Focuses on Issues Not in Dispute	6
D.	Strong Secondary Consideration Evidence Affirms Patentability.	8
II.	CONCLUSION	16

TABLE OF AUTHORITIES

Cases

<i>Brown & Williamson Tobacco Corp. v. Philip Morris Inc.</i> , 229 F.3d 1120 (Fed. Cir. 2000)	9
<i>Demaco Corp. v. F. Von Langsdorff Licensing Ltd.</i> , 851 F.2d 1387 (Fed. Cir. 1988)	9, 10, 11, 13
<i>Fox Factory, Inc. v. SRAM, LLC</i> , 944 F.3d 1366 (Fed. Cir. 2019)	12
<i>Omega Patents, LLC v. CalAmp Corp.</i> , 13 F.4th 1361 (Fed. Cir. 2021)	8
<i>Polaris Indus. v. Arctic Cat, Inc.</i> , 882 F.3d 1056 (Fed. Cir. 2018)	9

Rules

MPEP §609	2, 3
-----------------	------

EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 8,032,278 to Flick (the '278 Patent)
1002	Declaration of Dr. Azim Eskandarian
1003	U.S. Patent No. 6,756,885 to Flick
1004	U.S. Patent No. 6,606,561 to Flick
1005	U.S. Patent Application Publication No. 2006/016315 to Lewis
1006	U.S. Patent Application Publication No. 2003/0182003 to Underdahl
1007	U.S. Patent No. 6,011,460 to Flick
1008	U.S. Patent No. 6,812,829 to Flick
1009	File History of Application No. 11/773,272, which issued as U.S. Patent No. 8,032,278 to Flick
1010	03-25-2021 Order Granting the Reexamination (Appl. No. 90/014,675)
1011	06-21-2021 Examiner's Non-Final Office Action (Appl. No. 90/014,675)
1012	08-21-2021 Declaration of Joseph C. McAlexander, III
1013	08-23-2021 Response to Non-Final Office Action (Appl. No. 90/014,675)
1014	04-01-2022 Patent Owner's Appeal Brief (Appl. No. 90/014,675)
1015	12-01-2022 Decision on Appeal (Appl. No. 90/014,675)
1016	Application No. 11/076,259 to Flick
1017	Application No. 10/383,496 to Flick
1018	Application No. 09/859,972 to Flick
1019	Application No. 60/264,811 to Flick
1020	Application No. 60/258,005 to Flick
1021	Application No. 60/251,552 to Flick
1022	Application No. 60/252,125 to Flick
1023	Application No. 60/236,890 to Flick
1024	Application No. 60/246,463 to Flick
1025	Application No. 60/222,777 to Flick
1026	Application No. 60/205,178 to Flick
1027	10-03-2014 Plaintiff's Opposition to CalAmp's Motion for Claim Construction, 6:13-cv-1950-ORL-40-DAB
1028	02-20-2015 Order on Claim Construction, 6:13-cv-1950-ORL-40-DAB
1029	<i>In Ex Parte A. James Smith, Jr.</i> , 2010 WL 3269939 (BPAI August 17,

	2010).
1030	07-23-2024 Deposition of Joseph C. McAlexander, III, P.E.
1031	07-19-2024 Deposition of Christian Tregillis
1033	Supplemental Declaration of Dr. Azim Eskandarian
2001	Declaration of Kenneth Flick
2002	Declaration of Mr. Joseph C. McAlexander, III
2003	Curriculum Vitae of Mr. Joseph C. McAlexander, III
2004	Decision Granting Institution of <i>Inter Partes</i> Review; Paper 11, IPR2023-00504 (July 25, 2023)
2005	<i>Ex Parte Omega Patents, LLC</i> , No. 2018-008119 (Nov. 13, 2018)
2006	D.I. 34, Claim Construction Order, <i>Omega Patents, LLC v. Firstech, LLC</i> , No. 2:20-cv-03144 (W.D. Wash. Nov. 22, 2021) (“ <i>Firstech-CC</i> ”)
2007	<i>Omega Patents, LLC v. CalAmp Corp.</i> , 920 F.3d 1337 (Fed. Cir. 2019) (<i>CalAmp-I</i>)
2008	<i>Omega Patents, LLC v. CalAmp Corp.</i> , 13 F.4th 1361 (Fed. Cir. 2021) (<i>CalAmp-II</i>)
2009	<i>Ex Parte</i> Reexamination Certificate for U.S. Patent No. 8,032,278 issued May 17, 2023
2010	D.I. 297-1, Deposition of Galin Chen, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2011	D.I. 297-4, Deposition of Peter Hergesheimer, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2012	D.I. 297-5, Deposition of Stephen Hall, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13- cv-1950 (M.D. Fla. September 24, 2019)
2013	U.S. Patent No. 6,636,790 to Lightner
2014	U.S. Patent No. 6,611,740 to Lowrey
2015	U.S. Patent No. 6,957,133 to Hunt
2016	U.S. 6,732,031 to Lightner
2017	U.S. 7,174,243 to Lightner
2018	Prosecution File History of U.S. Patent Application Publication No. 2006/016315 to Lewis
2019	Declaration of Mr. Christian Tregillis
2020	D.I. 145-43, PL47, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2021	D.I. 145-19, PL1, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2022	D.I. 145-20, PL2, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-

	1950 (M.D. Fla. Feb 25, 2016)
2023	D.I. 145-34, PL18, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2024	D.I. 145-36, PL20, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2025	D.I. 145-59, PL73, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2026	Master And Cross-License Agreement, dated May 12, 2007, between Omega R&D, Omega Patents and Directed Electronics, Inc.
2027	D.I. 145-38, PL22, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2028	D.I. 145-80, PL99, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2029	D.I. 145-54, PL68, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2030	D.I. 145-53, PL67, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2031	D.I. 145-67, PL81, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2032	D.I. 144, Jury Verdict, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Sep. 30, 2019)
2033	D.I. 310, Jury Verdict, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb. 24, 2016)
2034	Omega Royalty Report (April 2023)
2035	Prosecution History of Ser. No. 90/013,587 (RX1)
2036	Prosecution History of Ser. No. 90/013,851 (RX2)
2037	Prosecution History of Ser. No. 90/014,309 (RX3)
2038	Prosecution History of Ser. No. 90/014,419 (RX4)
2039	Prosecution History of Ser. No. 90/014,675 (RX5)
2040	D.I. 145-28, PL11, <i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 6:13-cv-1950 (M.D. Fla. Feb 25, 2016)
2041	RESERVED
2042	U.S. Patent No. 7,149,623 to Flick
2043	U.S. Patent No. 6,028,537 to Suman et al.
2044	Supplemental Declaration of Mr. Joseph C. McAlexander, III
2045	Curriculum Vitae of Mr. Joseph C. McAlexander, III (updated 2Q2024)

Petitioner's theory is that two references offering teachings identical to what was before the initial Examiner, and before every panel in the five subsequent reexaminations thereafter, is suddenly sufficient to invalidate the claims of the '278 *Patent*. This contention is despite an acknowledgement that the Patent Office's Central Reexamination Unit (CRU), which includes highly qualified and trained patent examiner panels, not only considered this *Inter Partes* Review (IPR), but expressly considered the prior art references when confirming, yet again, the patentability of the claims of the '278 *Patent*. *See, e.g.*, Paper 14. Not only has a federal jury, numerous CRU panels, and two Board appellate proceedings confirmed the validity of the '278 *Patent* over such disclosures, but the strong secondary considerations evidence weighs heavily in favor of patentability. Here, as there, the claims of the '278 *Patent* should be confirmed patentable.

I. GROUND 1: CLAIMS 1-22 ARE NOT OBVIOUS OVER THE '885 AND '561 PATENTS

In Petitioner's Reply to Patent Owner's Response to the Petition, Petitioner concedes the lack of merit of Grounds 2 and 3, agreeing to "withdraw *Lewis* and *Underdahl* from its petition to narrow the issues before the Board." Paper 24, p. 4. Thus, the only remaining argument of Verizon in this IPR is Ground 1, the combination of two Flick patents referenced in the '278 *Patent* itself. This argument should also be rejected, having no merit and having been considered many times over.

A. Both References Were Before the Initial Examiner

U.S. Patent No. 6,756,885 (“*Flick885*”) (Ex-1003), a patent to Mr. Flick, was cited by Patent Owner during prosecution of the ‘278 *Patent*. Ex-1009. Indeed, *Flick885* is described in the Background of the Invention section of the ‘278 *Patent* as disclosing “a multi-vehicle control system whereby a multi-vehicle compatible controller stores a set of device codes for a given vehicle device for a plurality of different vehicles.” ‘278 *Patent*, 2:29-33. *Flick885* was also listed on the initial IDS submitted with the application on July 3, 2007, and was therefore specifically disclosed and considered by the Initial Examiner during prosecution. Ex-1009. The PTAB agrees. Decision (Paper 12), p. 14.

Similarly, U.S. Patent No. 6,606,561 (“*Flick561*”) (Ex-1004), yet another earlier patent to Mr. Flick, is in the priority chain for the ‘278 *Patent* and was listed in the related applications section of the ‘278 *Patent*. Ex-1009; ‘278 *Patent*, 1:7-14. *Flick561* is also incorporated by reference into the ‘278 *Patent*. ‘278 *Patent*, 1:19-20. Petitioner has argued and the Board initially found that “Flick ‘561, however, was not before the Examiner during the original prosecution of the ‘278 patent” (Paper 12, Decision, 15), but this is incorrect. *Flick561* is printed clearly in the related applications section on the face of the ‘278 *Patent*. *Id.* MPEP §609.02 required the Examiner to consider all related applications identified in this section, stating: “[t]he examiner **will** consider information which has been considered by the

Office in a parent application (other than an international application; see subsection I., above) when examining: (A) a continuation, divisional or continuation-in-part application.” MPEP §609.02 (emphasis added). Even ignoring an Examiner’s obligations under MPEP §609.02, Mr. Flick filed an IDS in the original prosecution that cited U.S. Patent No. 7,149,623 (*Flick623*) (Ex-2042), a continuation of *Flick561* that shares an identical specification. In other words, whether by virtue of the Examiner’s obligations under MPEP §609.02 or the submission of *Flick623*, the disclosure of *Flick561* was before the initial Examiner and considered in the original prosecution. These references also appeared on the face page of the ‘278 *Patent* for every subsequent proceeding, and, as Patent Owner noted previously (and the Board acknowledged), the *Flick885* and *Flick561* were again submitted in an IDS during the fourth reexamination, which subsequently confirmed the validity of the claims. Paper 9, 2-3; Paper 12, 15 n. 4.

B. The References Are Cumulative of Others Considered in Various Proceedings

Whether in the initial prosecution or through numerous subsequent challenges, the same basic formula has been relied upon time and again – a base primary reference disclosing a vehicle data bus, then a secondary reference that allegedly discloses GPS tracking. During the initial prosecution, numerous references that expressly disclosed GPS in a vehicle were also cited by the inventor and/or the examiner, including U.S. Patent No. 5,515,043 to Berard et al., U.S.

Patent No. 5,224,844 to Mansell et al., U.S. Patent No. 6,611,755 to Coffee et al., and U.S. Patent No. 6,628,233 to Knockeart et al. (Ex-1001.)

Once issued, the ‘278 *Patent* was subject to a litany of challenges, including federal court litigation and five (5) reexaminations. In the first reexamination (No. 90/013,587), U.S. Patent No. 5,732,074 to Spaur et al. was combined with U.S. Patent No. 5,557,254 to Johnson et al., which disclosed the vehicle data bus and GPS.¹ (RX1; Ex-2035). After considering the references, the Central Reexamination Unit (CRU) panel of examiners for the first reexamination withdrew the rejections and confirmed the claims of the ‘278 *Patent* over numerous references that disclosed the vehicle data bus and GPS. (*Id.*) In the second reexamination (No. 90/013,851), the CRU panel finally rejected the claims as anticipated by U.S. Patent No. 6,330,499 to Chou (which expressly discloses GPS), along with obviousness rejections combining Chou with Spaur and/or Suman. (Ex-2036.) Ultimately, the PTAB reversed all invalidity rejections on appeal, and the CRU panel of examiners confirmed the validity of the ‘278 *Patent* over references that disclosed a vehicle data bus and GPS. (*Id.*)

In the third reexamination (No. 90/014,309), the CRU panel of examiners

¹ Relied on by the Examiner for a separate rejection was U.S. Patent No. 6,028,537 to Suman et al. (under §102). In the Office Action the Examiner also referenced U.S. Patent Nos. 6,009,363 to Beckert et al., 7,484,008 to Gelvin et al., and U.S. Pub. No. 2001/0033225 to Razavi et al. (each under §103), which each expressly references a vehicle tracking unit with GPS. Ex-2035.

determined there was an SNQ based on (among other references) SAE HS-3000 and U.S. Patent No. 6,430,164 to Jones. (Ex-2037.) Again, the CRU panel of examiners confirmed the validity of the ‘278 *Patent* over references disclosing a vehicle data bus and GPS. (*Id.*) In the fifth reexamination of the ‘278 *Patent* (No. 90/014,675), the CRU and then the PTAB again considered references disclosing a vehicle data bus and GPS, U.S. Patent No. 6,611,740 to Lowrey (Ex-2014) and U.S. Patent No. 6,636,790 to Lightner (Ex-2039). *See Ex Parte Omega Patents, LLC*, Appeal 2022-003758 (Ex-1015). Ultimately, the PTAB reversed the obviousness rejection of the CRU panel based on Lowrey and Lightner on appeal. (Ex-1015, p. 17.)

While not the latest filed, the fourth *ex parte* reexamination (No. 90/014,419) is the most recent Patent Office proceeding and it concluded with confirmation of the validity of the ‘278 *Patent*. In the fourth *ex parte* reexamination, on January 2, 2024, the CRU panel of examiners considered the IDS submitted by Patent Owner that (again) listed both the *Flick885* and the *Flick561* patents. Ex-2038. On January 2, 2024, the CRU panel entered the search information in the fourth *ex parte* reexamination, wherein the CRU panel specifically confirmed consideration of this proceeding as of December 12, 2023, as well as another pending IPR proceeding (Ex-2038):

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

~ ~

Patent Data Portal (PDP) for continuity data	12/12/2023	lsw
P-TACTS for MA proceedings	12/12/2023	lsw
Reviewed IPR2023-00504	12/12/2023	lsw
Reviewed IPR2023-01162	12/12/2023	lsw

After considering the lengthy prosecution history and the references presented in the reexamination, the CRU panel of examiners confirmed the validity of the ‘278 *Patent* on January 17, 2024. *Id.* Ultimately, there is no meaningful difference between the litany of prior art references analyzed by the Examiner, five different CRU panels, and two PTAB appeal panels, compared to what is presented in this proceeding, with a reference disclosing a vehicle data bus plus a reference that allegedly discloses GPS tracking.

C. Petitioner Focuses on Issues Not in Dispute

Petitioner attempts to discredit Mr. McAlexander², one of Patent Owner’s experts, by mischaracterizing his opinions. Overall, it seems Petitioner’s goal in

² Petitioner also argues that Mr. Flick testified that the only reason he did not combine “a vehicle tracking unit with a multi-vehicle compatible controller” prior to 2007 was due to financial constraints. Paper 24, pp. 2-3. This was not his testimony. Mr. Flick merely testified that he did not “build data bus codes” into a tracking unit because of the expense, but he did not testify as to merging a multi-vehicle compatible controller with a vehicle tracking unit (Ex-1034, pp. 38-39), which he did not conceive until the ‘278 *Patent* (Ex-2001, p. 5-6).

attacking Mr. McAlexander was to prove that both GPS tracking units and data bus interfaces were known. This is not in dispute, as the same technology was considered during prosecution and in *ex parte* reexaminations (see above). For example, Petitioner argues that GPS in vehicles were “not new.” Paper 24, 7. However, the point Mr. McAlexander made was commercial products implementing GPS tracking in vehicles was relatively new at the time of the invention. Ex-1030, 39:16-24. Petitioner incorrectly converts this opinion into a strawman argument that prior art should be ignored until actual use. Paper 24, 8. This is a mischaracterization of his opinions. There is no dispute that GPS tracking was in the prior art, and Mr. McAlexander did not suggest otherwise—indeed, it was considered time and again in prosecution and various reexamination proceedings. Instead, in his supplemental declaration, Mr. McAlexander was discussing commercial products, noting the benefits to multi-vehicle compatibility and the download interface for reducing costs, while coupling these with the advantages of GPS tracking was unavailable commercially at the time of the invention. Ex-2044, ¶12-13. These opinions are consistent with the market demand subsequently recognized by CalAmp and the commercial success of the infringing CalAmp products. *Id.*

D. Strong Secondary Consideration Evidence Affirms Patentability

The ‘278 *Patent* has been litigated and licensed numerous times, thereby providing significant evidence of secondary considerations. For one, a federal jury found the ‘278 *Patent* (and other asserted patents) not invalid, while highlighting secondary considerations including commercial success, licensing, and copying by others. Ex-2032. Some of these same conclusions were referenced in an appeal in the fifth reexamination, where the PTAB reversed the Examiner’s rejection of the claims, finding “Appellant's evidence of secondary considerations of non-obviousness of the claimed invention, including licensing, commercial success, copying by others, customer need, and the limited value for accused products without the invention, outweighs the evidence of obviousness on this record.” (Ex-1015, p. 16.) In explaining the evidence of secondary considerations, the PTAB recognized that with the ‘278 *Patent*, there was “(1) the jury's verdict in related litigation that there was a nexus between the evidence of secondary considerations of non-obviousness and the claimed invention, and (2) the Federal Circuit's affirming the district court's upholding the jury's infringement verdict.” (Ex-1015, p. 13, citing to *Omega Patents, LLC v. CalAmp Corp.*, 13 F.4th 1361, 1365 (Fed. Cir. 2021) (affirming the judgment of infringement of the ‘278 *Patent's* asserted claims).)³ Not only was the evidence relied on in prior appeals submitted in this

³ Evidence of nonobviousness was also considered favorably in the second reexamination. Ex-

proceeding, but the Patent Owner submitted additional evidence and testimony regarding secondary considerations.

In contrast, Petitioner offered no evidence to rebut Patent Owner's submissions regarding secondary considerations, with its expert offering no testimony to address Patent Owner's evidence of secondary considerations in his declarations. Ex-1002, Ex-1033. Instead, Petitioner simply refers to the Board's findings in a different IPR with a different record.

Turning first to evidence of commercial success. "We presume that such a nexus applies for objective indicia when the patentee shows that the asserted objective evidence is tied to a specific product and that product 'embodies the claimed features, and is coextensive with them.'" *Polaris Indus. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018), quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000)). It is undisputed that the Omega-CalAmp litigation yielded a jury determination (subsequently affirmed by the Federal Circuit) that the CalAmp LMU-3000/3030/3050 products infringe claims 1-6, 8, 11, 12-14, 16, 18, 19 and 21 of the '278 patent. Ex-2032.

The '278 Patent is not an example where "the patented invention is only a component of a commercially successful machine or process." *Demaco Corp. v. F.*

2036, p. 14.

Von Langsdorff Licensing, Ltd., 851 F.2d 1387, 1392 (Fed. Cir. 1988)). To the contrary, Patent Owner’s expert explained in unrebutted testimony that all independent claims of the ‘278 *patent* recite “a multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle”—just like the infringing products. Ex-2044, ¶26 (with depictions of the OBD II tracking unit). In other words, the infringing products merged multiple technologies into a single, coextensive product, as recognized by the product development documents. *Id.*, ¶27; Ex-2014, ¶36; Ex-2018, p. 4; Ex-2019, p. 5.

There was considerable additional evidence supporting coextensiveness. For example, Patent Owner’s expert highlighted the marketing of the infringing products as the combination of a multi-vehicle controller with GPS tracking functionality (rather than for discrete features), evidencing the coextensive nature of the products and claims. Ex-2019, ¶¶32-41. CalAmp’s commercial requirements specification similarly confirmed the purpose of the infringing products was coextensive with the claims: “OBD-II product for a value-added GPS tracking and cellular communication product” Ex-2023, p. 4; *see also* Ex-2024, p. 5; Ex-2019, ¶35. Patent Owner’s expert highlighted a general market need to merge both multi-vehicle databus and GPS tracking technology, citing testimony of engineers involved in developing the infringing products, along with testimony that “sales-driven requests from customers” led to the combination of technologies in

CalAmp's infringing devices. Ex-2019, ¶¶38-40.

Patent Owner also submitted testimony establishing copying for the infringing products, with an executive of CalAmp explaining to CalAmp's patent counsel that claim 13 of the '278 *Patent* would be "harder to avoid" infringement because it implicated the way CalAmp programmed its infringing units. Ex-2019, ¶44; Ex-2020. None of this evidence was rebutted by evidence submitted by Petitioner – Petitioner's expert makes no mention of any of it.

The Federal Circuit has recognized "a patent challenger may rebut the presumption of nexus by presenting evidence to show that the commercial success was due to extraneous factors other than the patented invention such as additional unclaimed features and external factors." *Arctic Cat*, 882 F.3d at 1072 (cleaned up). Because the CalAmp products were found to infringe a nexus is presumed, the Petitioner was required—but failed—to offer evidence to rebut the nexus. *See Demaco*, 851 F.2d at 1393 . First, the Petitioner's expert makes no mention of any evidence of secondary considerations submitted by Patent Owner. Ex-1002, Ex-1033. Rather than offering any evidence to address coextensiveness, Petitioner cites the Federal Circuit decision reversing the jury's calculation as to the **amount** of damages. Paper 24, p. 14. Determining whether the jury correctly quantified damages does not negate the significant sales of the infringing products. Equally important, the Federal Circuit did not touch upon the coextensiveness of the claims

nor on secondary considerations, much less help carry Petitioner’s evidentiary burden to establish the claims were not coextensive.

Supposedly drawing from the Federal Circuit opinion, Petitioner argued that the infringing products include “*significant* unclaimed features...” Paper 24, p. 14. Yet the Federal Circuit does not reach any such conclusion, nor does Petitioner offer any testimony that any unclaimed features in the CalAmp products provided “significant” value. In contrast, Patent Owner’s expert noted that these supposed “significant” features (such as an accelerometer to detect hard braking, cornering, and acceleration) referenced by Petitioner (Paper 24, p. 14) were mundane and implemented by a \$1.26 component and an off-the-shelf microprocessor that was also used for claimed features. Ex-2044, ¶¶31-32. Critically, the Petitioner does not address the Federal Circuit’s statement in *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019)): “To be sure, we have never held that the existence of one or more unclaimed features, standing alone, means nexus may not be presumed.” Here, even if the Board concludes there were unclaimed features, there is no evidence any of these features overcome the presumption.

To be clear, the infringing CalAmp products included exactly what is claimed in the ‘278 *patent*. Petitioner offered no evidence supporting the assertion that the infringing products included “*significant unclaimed features.*” Petitioner’s attorney’s arguments are not evidence, and, therefore, cannot contradict the

presumed nexus for the commercial success, nor evidence of customer need and market demand that further reflect coextensiveness. With a jury finding that the CalAmp products infringe, considerable evidence that such products were designed to be coextensive, and no evidence to the contrary, a nexus between the commercial success of more than 900,000 infringing CalAmp products and the ‘278 *Patent* must be presumed. When, as here, there is a presumption of coextensiveness, and Petitioner offered no evidence, coextensiveness must be found. *See Arctic Cat*, 882 F.3d at 1072 (“A patent challenger may rebut the presumption of nexus by presenting evidence ‘to show that the commercial success was due to extraneous factors other than the patented invention,’” quoting *Demaco*, 851 F.2d at 1393).

Petitioner contends the evidence of secondary considerations is linked to a single feature—multi-vehicle compatibility—in the prior art. Paper 24, p. 16. It is true that multi-vehicle compatibility is one (claimed) feature of the infringing CalAmp units, but Petitioner’s argument ignores the documents focused on the combination of multi-vehicle data bus compatibility and GPS in a single unit. For example, CalAmp’s commercial requirements specification (CRS) focused on the combination of multiple technologies into a single product (while not even referencing multi-vehicle compatibility): “OBD-II product for a value added GPS tracking and cellular communication product” Ex-2023, p. 4; *see also* Ex-2024, p.

5; Ex-2019, ¶35. As explained by CalAmp’s engineer, the goal in developing the infringing products was to add value by merging the GPS tracking and databus technologies. EX-2012, p. 94. CalAmp’s engineer also acknowledged there was a “general market need” for the development of the infringing product’s solitary “simple plug-in solution” that merged databus functionality and GPS tracking as described in the CRS. Ex-2012, p. 40-41; Ex-2019, ¶41. Petitioner failed to offer any evidence to contradict the testimony of engineers who developed the infringing products, or for Patent Owner’s expert who recognized the value in the merger of these technologies.

Additionally, there are at least six licenses and/or settlement agreements that included the ‘278 *Patent*. Ex-2019, p. 10⁴. Patent Owner’s expert noted in deposition that the ‘278 *Patent* was the last patent standing and continued to collect royalties—even when others in the portfolio licenses expired—which is indicative of the value of the ‘278 *Patent*. Ex-1031, p. 29. Petitioner’s expert never even considered Patent Owner’s compelling evidence of secondary considerations, much less offered any rebuttal opinions. Ex-1002, Ex-1033. The finding of validity and infringement of the ‘278 *Patent*, numerous licenses, and evidence of copying and market demand

⁴ Petitioner argues Ex-2025 and Ex-2026 do not license the ‘278 *Patent*. Paper 24, p. 18. This is misleading. In Ex-2025, Enfora paid a Settlement Fee that included a standstill window, buying Enfora time to cease infringement or else face litigation from the Patent Owner. Ex-2025, p. 2-3. Ex-2026 included licenses for patents related to those referenced in the license, including the *Flick561 Patent*, which is related to the ‘278 *Patent*. Ex-2026, p. 42.

provided evidence of nonobviousness.

Petitioner next argues the evidence of commercial success is weak, claiming that Mr. Tregillis testified to considering three different markets. Paper 24, p. 20. This is a misinterpretation of Mr. Tregillis' testimony. Instead, Mr. Tregillis explained that the market initially reflected vehicle tracking devices (Ex-1031, p. 49), but once multi-vehicle compatibility was introduced to the market, marketplace acceptability changed because the merger of GPS tracking and multi-vehicle data bus compatibility as used in the '278 *Patent* was a "game changer" (*id.*, p. 55). Similarly, CalAmp's Hall testified in 2015 that the market for the infringing products was a "developing" marketplace that CalAmp had made "very good progress and inroads in penetrating..." Ex-2012, p. 69. Indeed, sales approximately doubled from the first verdict to the second verdict three years later, further emphasizing the significant sales (Ex-2031, Ex-2032), especially given the market was essentially developed by the launch of CalAmp's product. Ex-2012, p. 69. The evidence established no design around was identified, while CalAmp acknowledged claim 13 of the '278 *patent* as "harder to avoid" infringement, further supporting the recognition of this as evidence of secondary considerations. Ex-2019, ¶¶43, 44, citing Ex-2011, 44:23-45:19, and Ex-2020. Ultimately, a jury tied the commercial success of 917,222 units of infringing products specifically to the '278 *patent*. Ex-2033.

II. CONCLUSION

At bottom, Petitioner offers nothing but cumulative references disclosing a vehicle data bus and GPS tracking—the same teachings considered during prosecution and five different *ex parte* reexaminations. Even if there were a compelling reason to diverge from numerous other panels and Board decisions and contemplate combining the prior art in the manner claimed by the Patent Owner, evidence of secondary considerations rejects such a combination. Rarely does a Patent Owner have such compelling evidence of commercial success, with a jury finding nearly a million units of infringing product sold, while an infringer's own engineers acknowledge the market demand for a combination of technology as claimed. In response, Petitioner attempts to nitpick the evidence, but its expert ignored the secondary consideration evidence, leaving Petitioner with nothing but improper attorney argument to criticize the presumption of a nexus between the '278 *Patent* and evidence of secondary considerations. Given the unrebutted evidence and the significant resources of the USPTO (and a federal court jury) that have all confirmed the validity of the '278 *Patent*, the claims should be confirmed.

Respectfully submitted this September 17, 2024.

/s/Ryan T. Santurri

Ryan T. Santurri, Reg No. 61,894

rsanturri@allendyer.com

Allen, Dyer, Doppelt + Gilchrist, P.A.
255 South Orange Avenue, Suite
1401

Post Office Box 3791

Orlando, Florida 32801-3791

Telephone: 407-841-2330

Facsimile: 407-841-2343

Lead Counsel

David S. Carus. Reg No. 59,291

dcarus@allendyer.com

Christopher F. Regan, Reg No. 34,906

cregan@allendyer.com

Allen, Dyer, Doppelt + Gilchrist, P.A.
1135 E. State Road 434, Suite 3001
Winter Springs, FL 32709

Telephone: 407-796-5051

Facsimile: 407-796-5065

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

Pursuant to 37 C.F.R. §42.24(a)(1)(i), the undersigned hereby certifies that the foregoing PATENT OWNER'S SUR-REPLY IN RESPONSE TO PETITIONER'S REPLY IN SUPPORT OF ITS PETITION contains 3,601 words, excluding the parts that are exempted under 37 C.F.R. §42.24(a), as measured by the word-processing system used to prepare this paper.

/s/Ryan T. Santurri

Ryan T. Santurri

Reg No. 61,894

CERTIFICATE OF SERVICE UNDER 37 C.F.R. §42.6 (E)(4)

The undersigned certifies that the foregoing Patent Owner's Response under 37 C.F.R. §42.105, are being served on September 17, 2024, by electronic mail at the following email addresses of record for the Petitioner:

Asheesh (Ashe) P. Puri, Esq. Nixon Peabody LLP 300 South Grand Avenue, Suite 4100 Los Angeles, CA 90071-3151 apuri@nixonpeabody.com	Sasha G. Rao, Esq. Nixon Peabody LLP One Embarcadero Center, 32nd Floor San Francisco, CA 94111 srao@nixonpeabody.com
---	--

Dated: September 17, 2024

Respectfully submitted,

/s/Ryan T. Santurri

Ryan T. Santurri, Reg No. 61,894

rsanturri@allendyer.com

Allen, Dyer, Doppelt + Gilchrist, P.A.
255 South Orange Avenue, Suite 1401
Post Office Box 3791

Orlando, Florida 32801-3791

Telephone: 407-841-2330

Facsimile: 407-841-2343

Lead Counsel

David S. Carus, Reg No. 59,291

dcarus@allendyer.com

Christopher F. Regan, Reg No. 34,906

cregan@allendyer.com

Allen, Dyer, Doppelt + Gilchrist, P.A.
1135 E. State Road 434, Suite 3001
Winter Springs, FL 32709

Telephone: 407-796-5051

Facsimile: 407-796-5065