

U.S. Patent No. 8,032,278
Objections to Patent Owner's Demonstrative Exhibits
IPR2023-01162

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON CONNECT INC.,
Petitioner

v.

OMEGA PATENTS, LLC
Patent Owner

Patent No. 8,032,278

Inter Partes Review No. IPR2023-01162

PETITIONER'S OBJECTIONS TO PATENT OWNER'S
DEMONSTRATIVE EXHIBITS

Pursuant to the Board’s Order Setting Oral Argument (Paper 27), the parties conferred regarding the objections of Petitioner Verizon Connect Inc. (“Petitioner”) to the demonstrative exhibits of Patent Owner Omega Patents, LLC (“Patent Owner”) (individual pages identified below as “slides”) but were unable to resolve Petitioner’s objections, as set forth below:

Slide 11: Petitioner objects to Patent Owner’s demonstrative exhibit Slide 11 because Patent Owner has improperly introduced new evidence and arguments made for the first time in its Sur-Reply (outlined in red below) in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *See Google LLC v. Uniloc 2017 LLC*, IPR2020-00447, Paper 24, at 14 (“Patent Owner improperly made this new argument for the first time in the Sur-reply.”)¹; *Supercell Oy v. Gree, Inc.*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019) (“Patent Owner was unaware of any instance where the Board, essentially, de-instituted a trial portion of a proceeding based on 35 U.S.C. § 325(d) ... we decline

¹ *See also* Order Setting Oral Argument (Paper 27), at 3 (“[N]o new evidence may be presented at the oral argument. CTPG 85; *see also St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65, 2–3 (PTAB Jan. 27, 2014) (explaining that “new” evidence includes evidence already of record but not previously discussed in any paper of record).” *Promos Technologies, Inc. v. Samsung Electronics Co., Ltd.*, 809 Fed.Appx. 825, 834 (Fed. Cir. 2020) (“the new argument, raised for the first time in Patent Owner's Sur-Reply, will not be considered”).

to exercise our discretion under 35 U.S.C. §325(d) and deny the petition at this late stage in the proceeding”) (reversed on other grounds).

Flick561 is Like Art Already Considered When Combined with Flick885

- Petitioner relies on Flick561 solely as a GPS tracker. Numerous GPS trackers were considered across prosecutions, such as the following during the initial prosecution:
 - U.S. Patent No. 5,515,043 to Berard et al., U.S. Patent No. 5,223,844 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; PO Sur-Reply, p. 3-4

DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

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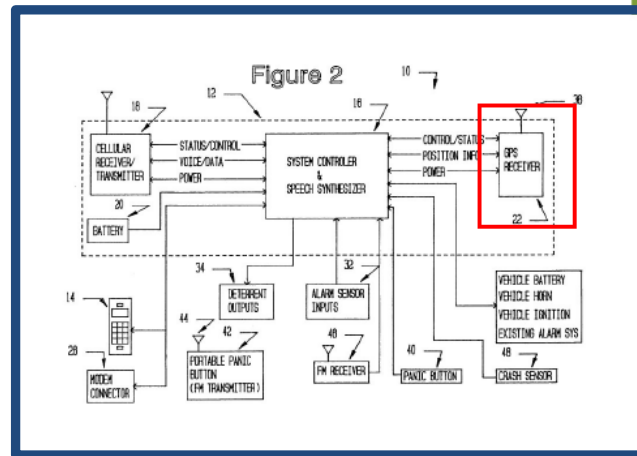
Slide 12: Petitioner objects to Patent Owner's demonstrative exhibit Slide 12 because Patent Owner has improperly: (i) introduced new evidence (Figure 2 of Berard) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) introduced new evidence (Berard) and arguments made for the first time in its Sur-Reply (outlined in red below), in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google*

LLC, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

**Flick561 is Like Art Already Considered When Combined
with Flick885 During Prosecution**

• U.S. Patent No.
5,515,043 to Berard

PO Sur-Reply, p. 3



DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

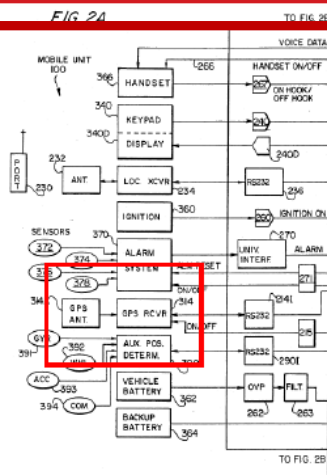
EX1001

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Slide 13: Petitioner objects to Patent Owner's demonstrative exhibit Slide 13 because Patent Owner has improperly: (i) introduced new evidence (Figure 2A of Mansell) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) introduced new evidence (Mansell) and arguments made for the first time in its Sur-Reply (outlined in red below), in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google*

- U.S. Patent No. 5,223,844 to Mansell

PO Sur-Reply, p. 4



DEMONSTRATION

Slide 14: Petitioner objects to Patent Owner’s demonstrative exhibit Slide 14 because Patent Owner has improperly: (i) introduced new evidence (Figure 6 of Coffee) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) improperly introduced new evidence (Coffee) and arguments made for the first time in its Sur-Reply (outlined in red below), in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d).

Google LLC, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

Flick561 is Like Art Already Considered When Combined with Flick885 During Prosecution

- U.S. Patent No. 6,611,755 to Coffee

FIG. 6

DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

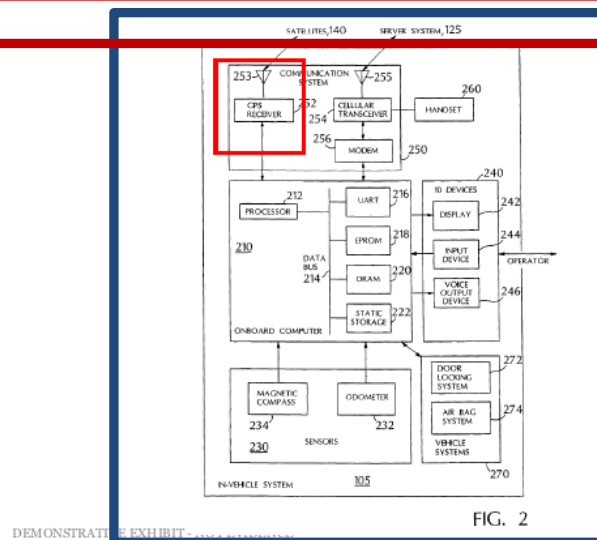
PO Sur-Reply, p. 4

Slide 15: Petitioner objects to Patent Owner's demonstrative exhibit Slide 15 because Patent Owner has improperly: (i) introduced new evidence (Fig. 2 of Knockart) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) introduced new evidence (Knockart) and arguments made for the first time in its Sur-Reply (outlined in red below), in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google LLC*, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

Flick561 is Like Art Already Considered When Combined
with Flick885 During Prosecution

- U.S. Patent No.
6,628,233 to
Knockart

PO Sur-Reply, p. 4



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Slide 16: Petitioner objects to Patent Owner's demonstrative exhibit Slide 16 because Patent Owner has improperly introduced new evidence and arguments made for the first time in its Sur-Reply (outlined in red below) in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google LLC*, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

**Flick561 is Like Art Already Considered When Combined
with Flick885 During Reexamination**

- Not only were numerous references with GPS considered during the initial prosecution, challengers continued to offer cumulative references as one reexamination after the next was filed

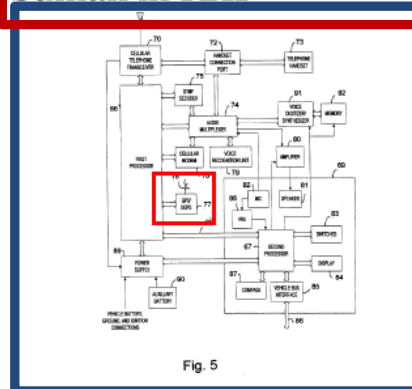
PO Sur-Reply, p. 4

DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

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Slide 17: Petitioner objects to Patent Owner's demonstrative exhibit Slide 17 because Patent Owner has improperly: (i) introduced new evidence (Figure 4A of Johnson and Figure 5 of Suman) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) introduced new evidence (Johnson and Suman) and arguments made for the first time in its Sur-Reply (outlined in red below) in what appears to be an improper attempt to raise a new challenge under 35 U.S.C. § 325(d). *Google LLC*, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

U.S. Patent No. 6,028,537 to
Suman in RX1



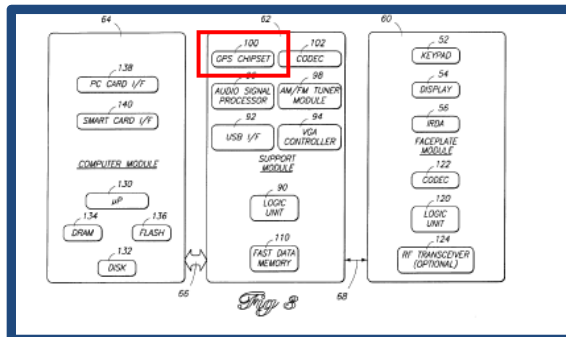
DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

17

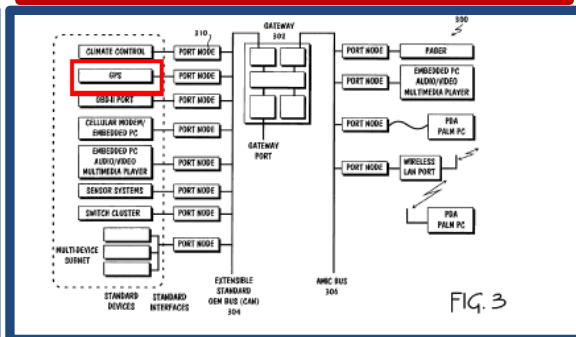
9

Flick561 is Like Art Already Considered When Combined with Flick885 During Reexamination

• U.S. Patent No. 6,009,363 to Beckert in RX1



• U.S. Patent No. 7,484,008 to Gelvin in RX1



PO Sur-Reply, p. 4; Ex. 2035

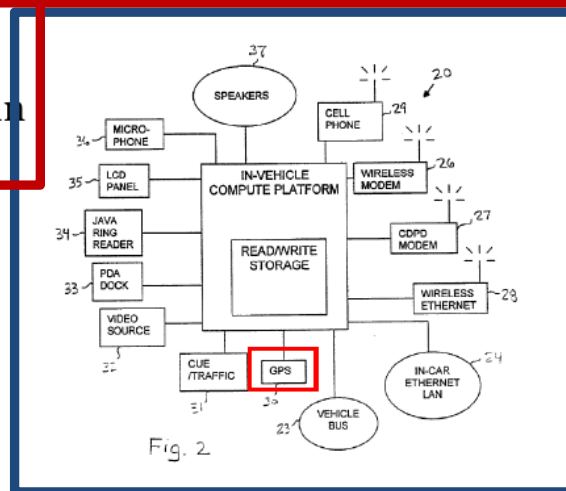
DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

18

Slide 19: Petitioner objects to Patent Owner's demonstrative exhibit Slide 19 because Patent Owner has improperly: (i) introduced new evidence (Figure 2 of Razavi) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) introduced new evidence (Razavi) and arguments made for the first time in its Sur-Reply (outlined in red below), in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google LLC*, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

**Flick561 is Like Art Already Considered When Combined
with Flick885 During Reexamination**

- U.S. Patent Application
Publication No.
2001/0033225 to Razavi in
RX1



PO Sur-Reply, p. 4; Ex. 2035

DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

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Slide 20: Petitioner objects to Patent Owner's demonstrative exhibit Slide 20 because Patent Owner has improperly: (i) introduced new evidence (selected portions of the specifications of Spaur and Chou) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) introduced new evidence (Spaur and Chou) and arguments made for the first time in its Sur-Reply (outlined in red below), in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google LLC*, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

Flick561 is Like Art Already Considered When Combined with Flick885 During Reexamination

- U.S. Patent No. 5,732,074 to Spaur in RX2
- U.S. Patent No. 6,330,499 to Chou in RX2 (Col. 2 shown)

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each vehicle in a fleet of vehicles might be required to report its location on a periodic basis to a remote station 10. The steps of FIG. 4 are next described in the context of such an example. At block 300, vehicle positioning data is available from one of the vehicle devices 50, which might be a GPS. On a requested or regular input scheme, such vehicle device data is sent to the CAN bus 126 at block 304. The CAN

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private) switch telephone network (PSTN) 150E. Further shown, the vehicle location is established, for example by a device 317 (e.g., antenna or the like) for receiving positioning information from orbiting Global Positioning System (GPS) satellites 150A.

PO Sur-Reply, p. 4; Ex. 2036

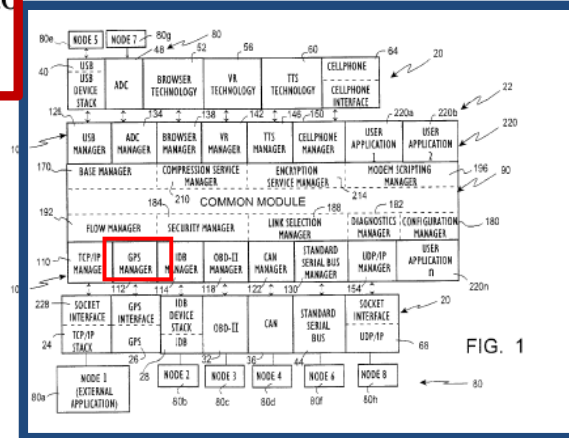
DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

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Slide 21: Petitioner objects to Patent Owner's demonstrative exhibit Slide 21 because Patent Owner has improperly: (i) introduced new evidence (Figure 1 of Jones) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) introduced new evidence (Jones) and arguments made for the first time in its Sur-Reply (outlined in red below), in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google LLC*, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

Flick561 is Like Art Already Considered When Combined with Flick885 During Reexamination

- U.S. Patent No. 6,430,164 to Jones in RX3



PO Sur-Reply, p. 4; Ex. 2037

DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

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Slide 22: Petitioner objects to Patent Owner's demonstrative exhibit Slide 22 because Patent Owner has improperly: (i) introduced new evidence (select portions of specifications from Lowrey and Lightner) that does not appear in the cited portions of the Sur-Reply (outlined in blue below); and (ii) introduced new evidence (Lowrey and Lightner) and arguments made for the first time in its Sur-Reply (outlined in red below), in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google LLC*, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

Flick561 is Like Art Already Considered When Combined with Flick885 During Reexamination

•U.S. Patent No. 6,611,740 to Lowrey in RX5

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each vehicle in a fleet of vehicles might be required to report its location on a periodic basis to a remote station 10. The steps of FIG. 4 are next described in the context of such an example. At block 300, vehicle positioning data is available from one of the vehicle devices 50, which might be a GPS. On a requested or regular input scheme, such vehicle device data is sent to the CAN bus 126 at block 304. The CAN

•U.S. Patent No. 6,636,790 to Lightner in RX5

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In other embodiments, additional hardware can be added to the in-vehicle unit. For example, hardware for global-positioning systems (GPS) may be added so that the location of the vehicle can be monitored along with its data.
In other embodiments, data from the data collector/router in the vehicle can be exchanged and used for remote location

PO Sur-Reply, p. 4; Ex. 2013, 2014,

EMONSTRATIVE EXHIBIT - NOT EVIDENCE

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Slide 29: Petitioner objects to Patent Owner's demonstrative exhibit Slide 29 because Patent Owner has improperly introduced new evidence and arguments made for the first time in its Sur-Reply (outlined in red below) in what appears to be an improper attempt to raise a new post-institution challenge under 35 U.S.C. § 325(d). *Google LLC*, IPR2020-00447, Paper 24, at 14; *Supercell Oy*, PGR2018-00008, 2019 WL 80477, at *24 (PTAB 2019).

Inconsistency of USPTO/PTAB Decisions

- Examiners in the original prosecution and reexaminations Rx1, Rx3 and Rx4 had the Flick885 and numerous GPS references before them but found the claims valid in each instance
- PTAB panels in reexaminations Rx2 and Rx5 had the Flick885 and numerous GPS references before them, along with limited evidence of secondary considerations, and both times found the claims valid
- In this proceeding (and in the Geotab proceeding), the universe of evidence of secondary considerations is even more developed and compelling, while Petitioner failed to offer rebuttal evidence

PO Sur-Reply, p. 6

DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

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IPR2023-01162

Respectfully submitted,

Verizon Connect Inc.

Date: November 15, 2024

/s/ Ashe Puri
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U.S. Patent No. 8,032,278
Objections to Patent Owner's Demonstrative Exhibits
IPR2023-01162

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PETITIONER'S
OBJECTIONS TO PATENT OWNER'S DEMONSTRATIVE EXHIBITS was
served on November 15, 2024, by email:

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Counsel for Patent Owner
Omega Patents LLC

By: /s/ Ashe Puri
Counsel for Petitioner