

U.S. Patent No. 8,032,278
Response to Request for Director Review
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

RESPONSE TO REQUEST FOR DIRECTOR REVIEW

The USPTO Director has authorized Petitioner, Verizon Connect Inc. (“Petitioner”), to submit this response to address the issues raised in the Request for Director Review (“Request”) of Patent Owner, Omega Patents, LLC (“Patent Owner”).

On January 28, 2025, the USPTO Patent Trial and Appeal Board (“Board”) issued a final written decision (“FWD”) determining Claims 1-22 of U.S. Patent No. 8,032,278 B2 (the “’278 Patent”) unpatentable. Approximately six months earlier, the Board issued a FWD in *Geotab USA, Inc. et al. v. Omega Patents LLC*, IPR2023-00504 (the “*Geotab* IPR”) where it also determined Claims 1-22 of the ’278 Patent unpatentable. On August 16, 2024, Patent Owner filed a Request for Director Review in the *Geotab* IPR addressing many of the same arguments presented in its current Request. See Request, at fn. 4 (asserting that the Board reached the “same improper rationale as here”). On September 17, 2024, the Director denied Patent Owner’s Request in the *Geotab* IPR (Paper 47).

The rules governing Director Review of Board Decisions provide “flexibility as to the standards of review to be applied in the Director Review process.”¹ For the reasons stated below, Verizon respectfully requests that the Director deny Patent Owner’s Request.

¹ 2024-22194 (89 FR 79744), at <https://www.federalregister.gov/documents/2024/10/01/2024-22194/rules-governing-director-review-of-patent-trial-and-appeal-board-decisions>

I. Background

Claims 1-22 of the '278 Patent are directed to a multi-vehicle compatible tracking unit comprising four elements: (1) a multi-vehicle compatible controller ("MVCC") to be coupled to a vehicle data bus, (2) a downloading interface; (3) a wireless communications device; and (4) a vehicle tracking device (e.g., GPS). Before filing the application that led to the '278 Patent, the inventor, Kenneth E. Flick ("Flick"), had already patented a system comprising an MVCC coupled to a vehicle data bus, a downloading interface and a wireless communications device. This patent issued into U.S. Patent No. 6,756,885 ("Flick '885"), which Petitioner asserted as prior art. The only feature added by Flick to the '278 Patent is a vehicle tracking unit (e.g., GPS), which is disclosed in the '278 Patent family within U.S. Patent No. 6,606,561 ("Flick '561"), another prior art asserted by Petitioner. The Board determined the '278 Patent was only entitled to a priority date of its July 3, 2007 filing date, citing to an Examiner's decision that the '278 Patent added new matter and that Patent Owner never appealed that decision. FWD, at 13.

Patent Owner has not challenged the priority date of the '278 Patent or that Flick '885 and Flick '561 are prior art. Patent Owner also has not challenged that every claim element is disclosed in the combination of Flick '885 and Flick '561. Further, Patent Owner has not challenged the Board's determination that an

ordinarily skilled artisan would have been motivated to combine the disclosures of Flick '885 and Flick '561.

II. Flick '885 and Flick '561 Are Not Cumulative of the Prior Art Previously Presented to the Office.

Patent Owner asserts that the Board erred because the Office “repeatedly considered” “Flick '885 plus GPS.” Request, at 2-3. Patent Owner does not cite to any specific instance where the Office ever considered Flick '885 plus GPS, and Petitioner is unaware of any such instance besides the *Geotab* IPR. Patent Owner does not cite any legal authority for reversing the Board’s FWD on this basis, but instead makes a vague policy argument about consistency—while ignoring that it is currently asking the Director’s Office to reach a different result on nearly identical arguments presented in the *Geotab* Request for Director Review. To the extent Patent Owner makes any legal argument, it seems Patent Owner may be challenging the Board’s institution under 35 U.S.C. § 325(d). But the issue under § 325(d) is whether Flick '561 was “previously presented to the Office as prior art.” Before this Petition, Flick '561 had never been presented to the Office as prior art because no party had ever challenged the validity of the '278 Patent based on another patent within the '278 Patent family qualifying as prior art. *See In re Chu*, 66 F.3d 292,297 (Fed. Cir. 1995) (finding parent of CIP is prior art where the CIP added new matter). Consequently, the Office never previously considered Flick '561 as prior art.

Patent Owner also argues that the Board erred because the prior art presented in the *ex parte* reexaminations of the '278 Patent “disclosed the vehicle data bus and GPS.” Request, at 4-6. The '278 Patent, however, is not directed to a vehicle data bus and GPS, but rather a combination of an MVCC coupled to a vehicle data bus, a downloading interface, a wireless communications device, and a vehicle tracking device. In the *Ex Parte* Reexamination Certificates, the Office stated that it confirmed the '278 Patent claims because the prior art was missing one or more of these claim elements. *See, e.g.*, Ex. 2039, at pp 474-482. Accordingly, Flick '885 and Flick '561 are not cumulative of the prior art previously presented to the Office.

III. The Board Properly Rejected Patent Owner's Objective Evidence of Nonobviousness as Weak.

Patent Owner argues that the Board erred because Petitioner did not present evidence to rebut testimony regarding an alleged coextensiveness between the CalAmp product and the '278 Patent claims. Request, at 9. Patent Owner's argument is incorrect. As the Board addressed, Petitioner had submitted evidence of CalAmp's marketing materials and product manuals touting the benefit and desirability of critical unclaimed features of the CalAmp product, including a three-axis accelerometer, hard braking, cornering, and impact detection, and an on-board alert engine programmable event. Patent Owner has not challenged that these unclaimed features are critical and of value to the functionality of the CalAmp

product. Petitioner also submitted a decision of the Federal Circuit vacating a jury's damage award based on these same unclaimed features. The marketing materials, the product manuals and the Federal Circuit decision strongly support that critical unclaimed features of value exist in the *CalAmp* product.

The Board identified other major shortcomings in Patent Owner's arguments of non-obviousness and concluded that even if a nexus existed between the '278 Patent and the CalAmp products, the evidence of nonobviousness is still weak. Patent Owner does not refute any of these shortcomings. Among them, the Board concluded that: (i) Patent Owner failed to present any evidence of relative market share, the scope of the industry or CalAmp's place in it; (ii) the juries in *CalAmp* found the same products infringe multiple claims of at least two patents other than the '278 Patent (including Flick '885, which was asserted as prior art), and that the jury findings on secondary considerations were not broken out by patent; and (iii) none of the six licenses before the Board are directed to only the '278 Patent and that at least one of the licenses is directed to Flick '885 and Flick '561.

IV. Conclusion

Petitioner respectfully requests that the Director deny Patent Owner's Request because Patent Owner has not shown that the Board committed any error.

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Respectfully submitted,

Verizon Connect Inc.

Date: March 4, 2025

/s/ Ashe Puri

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing RESPONSE
TO REQUEST FOR DIRECTOR REVIEW was served on March 4, 2025, by
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