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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.").

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

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