

**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.

ORDER

This cause comes before the Court without oral argument on the following:

1. Plaintiff's Motion and Memorandum for Summary Judgment as to Validity, Infringement, Enforceability and Unfair Competition (Doc. 54), filed July 1, 2015;
2. Defendant CalAmp Corp.'s Response in Opposition to Omega[']s Motion for Summary Judgment as to Validity, Infringement, Enforceability and Unfair Competition (Doc. 76), filed July 20, 2015;
3. Plaintiff's Reply in Support of its Motion for Summary Judgment as to Validity, Infringement, Enforceability and Unfair Competition (Doc. 79), filed August 3, 2015;
4. Plaintiff's Supplement Regarding Its Motion for Summary Judgment as to a Claim of Unfair Competition (Doc. 89), filed September 17, 2015;
5. Defendant CalAmp Corp.'s Motion for Summary Judgment and Memorandum of Law Regarding Invalidity and Noninfringement (Doc. 78), filed July 27, 2015;
6. Plaintiff's Opposition to Defendant CalAmp's Motion for Summary Judgment

(Doc. 81), filed August 6, 2015; and

7. Defendant CalAmp Corp.'s Reply Brief in Support of Motion for Summary Judgment Regrading Invalidity and Noninfringement (Doc. 83), filed August 24, 2015;

I. BACKGROUND

A. The Patents-In-Suit

Omega Patents, LLC (“Omega”) contends that CalAmp Corp. (“CalAmp”) infringes the claims of U.S. Patent No. 6,346,876 (“the ‘876 Patent”), U.S. Patent No. 6,737,989 (“the ‘989 Patent”), U.S. Patent No. 6,756,885 (“the ‘885 Patent”), U.S. Patent No. 7,671,727 (“the ‘727 Patent”), and U.S. Patent No. 8,032,278 (“the ‘278 Patent”) (collectively, the “patents-in-suit”). (Doc. 1). The patents-in-suit relate to control systems for vehicles with a “data communications bus.” (Doc. 54, pp. 1–2).¹ Omega asserts that CalAmp’s devices are used to monitor particular vehicle characteristics and conditions and report vehicle information to an end user, thus infringing on the patents-in-suit. (*Id.* at p. 2). CalAmp counterclaims and seeks a declaratory judgment of noninfringement, invalidity, and unenforceability for the patents-in-suit. (Doc. 20).

B. The Motions for Summary Judgment

Omega’s motion for summary judgment focuses on the alleged infringement of two of the patents-in-suit: the ‘876 and the ‘278 Patents. The devices that Omega accuses of infringement in the instant case are CalAmp’s location messaging units (“LMU”), specifically the LMU-3000, LMU-3030, and LMU-3050. Omega also moves for summary

¹ The Court has previously construed “data communications bus” 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).

judgment on CalAmp's counterclaims for invalidity and unenforceability.² CalAmp's motion for summary judgment asserts that the '876, '989, '885, and '278 Patents are all invalid in view of the prior art. Additionally, CalAmp argues that the accused devices do not infringe any claim of the '876, '885, '727, or '278 Patents.

C. The Accused Devices

As it relates to Omega's motion for summary judgment, CalAmp advertises the LMU-3000, LMU-3030, and LMU-3050 (the "Accused Devices")³ units as GPS Tracking Units with an on-board diagnostic ("OBD-II") interface. (Doc. 54, p. 5). CalAmp describes the Accused Devices as the "ideal solution for automotive insurance, driver behavior management, auto rental and automotive applications when access to the vehicle diagnostics interface (OBD-II) is required." (Docs. 114-1, p. 2; 114-2, p. 2). Broadly speaking, the Accused Devices are full-featured tracking systems which "access vehicle diagnostic interface data, track vehicle speed and location, plus detect hard braking, cornering, or acceleration." (*Id.*). CalAmp markets the devices as easy to install, inexpensive, and reliable. (*Id.*).

² Omega also moved for summary judgment on CalAmp's counterclaim for unfair competition. (Doc. 54, pp. 20–21). Subsequently, Omega realized that CalAmp no longer had a claim for unfair competition pending and filed a Supplement to the Court regarding this. (Doc. 89). Omega asserts that CalAmp withdrew its claim of unfair competition when it filed its Amended Counterclaim (Doc. 20) on February 24, 2014. CalAmp did not respond to Omega's Supplement contending otherwise. However, CalAmp asserts in its Trial Brief (Doc. 99) and in the Joint Pretrial Statement (Doc. 90) that its claim for unfair competition is still pending. Alas, a review of the Amended Counterclaim shows that a claim for unfair competition is not pleaded. CalAmp only asserts in its Prayer for Relief that the Court find that Omega's enforcement of the patents-in-suit constitutes unfair competition. However, this is not enough to assert a claim for unfair competition. Because CalAmp does not have a claim for unfair competition in its operative pleading, the portion of Omega's motion for summary judgment seeking a determination of CalAmp's counterclaim for unfair competition is denied as moot.

³ The LMU-3030 and LMU-3050 are identical—the LMU-3050 simply has a different model number because it is sold in the United Kingdom. (Doc. 54, p. 5).

II. STANDARD OF REVIEW

“The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). An issue of fact is “genuine” only if “a reasonable jury could return a verdict for the nonmoving party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A fact is “material” if the fact could affect the outcome of the lawsuit under the governing law. *Id.* The moving party bears the initial burden of identifying those portions of the record demonstrating a lack of genuine dispute of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Hickson Corp. v. N. Crossarm Co., Inc.*, 357 F.3d 1256, 1260 (11th Cir. 2004).

To defeat a motion for summary judgment, the non-movant must go beyond the pleadings and “come forward with specific facts showing that there is a genuine issue for trial.” *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986) (emphasis and internal quotation marks omitted). In determining whether a genuine dispute of material fact exists, the Court must read the evidence and draw all factual inferences therefrom in the light most favorable to the non-moving party and must resolve any reasonable doubts in the non-movant’s favor. *Skop v. City of Atlanta, Ga.*, 485 F.3d 1130, 1136 (11th Cir. 2007). Summary judgment should only be granted “[w]here the record taken as a whole could not lead a rational trier of fact to find for the non-moving party.” *Matsushita*, 475 U.S. at 587.

III. DISCUSSION

A. Omega's Motion for Summary Judgment

1. Infringement by CalAmp

Pursuant to 35 U.S.C. § 271, “whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.” 35 U.S.C. § 271(a) (2006). Direct infringement exists “when the properly construed claim reads on the accused device exactly.” *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 532 (Fed. Cir. 1996). The direct infringement analysis follows a two-step process: first, the Court interprets the claims in dispute, and second, the Court “compares the accused device to the properly construed claims to determine whether each and every limitation of a claim is present, either literally or equivalently, in the accused device.” *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1365 (Fed. Cir. 2002).

Interpretation of a patent claim is a question of law. *Cook Biotech Inc. v. Acell, Inc.*, 460 F.3d 1365, 1372 (Fed. Cir. 2006). However, determining whether the accused device satisfies every claim limitation is a question of fact. *Id.* at 1373. The burden is on the patentee to establish a prima facie showing of infringement as to each accused device by a preponderance of the evidence. *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843, 849 (2014) (“It is well established that the burden of proving infringement generally rests upon the patentee.”).

a. The '876 Patent

Omega argues that CalAmp has directly infringed Claims 1 and 3 of the '876 Patent by making and selling the Accused Devices. (Doc. 54, p. 9). Claim 1 of the '876 Patent provides:

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 comprising:

a transmitter and a receiver for receiving signals from said transmitter; and

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 communications 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 vehicles.

(Doc. 57-1, '876::11:30–48).

Omega asserts that the Accused Devices are part of a control system for a vehicle comprising a data communications bus and at least one vehicle device connected to the data communications bus, thus reading on the first portion of Claim 1. (Doc. 54, p. 9). A data communications bus has been interpreted by the Court to mean a wired connection for communication of digital messages among vehicle devices, with each message including one or more device addresses. (Doc. 50, p. 25). However, CalAmp responds that Omega has not provided evidence indicating that any of the Accused Devices are a “control system for a vehicle.” (Doc. 76, p. 13). Omega replies that this portion of the claim is simply a preamble which provides no limitation. Preambles can serve different purposes depending on the language of the preamble. *C.R. Bard, Inc. v. M3 Sys., Inc.*,

157 F.3d 1340, 1350 (Fed. Cir. 1998). The preamble can limit the scope of the claim “when patentability depends on limitations stated in the preamble” or it can simply state “the intended use or purpose of the invention” and, thus, not limit the scope of the claim. *Id.* The latter type of preamble “usually does not limit the scope of the claim unless the preamble provides antecedents for ensuing claim terms and limits the claim accordingly.” *Id.*

The preamble in Claim 1 does not set forth limitations on patentability for “a control system.” It establishes that a control system for a vehicle will be comprised of (1) a data communications bus and (2) at least one vehicle device connected to the data communications bus. The preamble ends with the phrase, “the control system comprising,” followed by a colon. This indicates that the necessary terms for patentability are contained not in the preamble but following the preamble. Moreover, CalAmp does not dispute that the Accused Devices contain (1) a data communications bus and (2) at least one vehicle device connected to the data communications bus. Hence, the Court concludes that the preamble does not limit the scope of the claim.

Next, Omega argues that the Accused Devices use a transmitter and a receiver for receiving signals from said transmitter because the Accused Devices include a cellular module that allows transmission to and reception from a central station, thus reading on the second portion of Claim 1. (Doc. 54, p. 9). Peter Hergesheiner, CalAmp’s Senior Director of Software and Architecture, testified that the Accused Devices all have GPS units and a wireless transmitter and receiver. (Hergesheiner Depo., Doc. 66-18, 30:35–31:4). CalAmp does not dispute this testimony.

The heart of the issue lies in the third portion of Claim 1: CalAmp argues that a multi-vehicle compatible controller must perform a control function. Previously, the Court

defined “multi-vehicle compatible controller” as “an electronic circuitry that performs *one or more control functions*, and can operate with more than one vehicle.” (Doc. 50, p. 24) (emphasis added). CalAmp asserts that the term “control function” within the term “multi-vehicle compatible controller” is undefined and open to further interpretation. CalAmp’s expert, Eric Andrews, opines that a control function would require a physical change in a device or the system, for example, turning on a light, and would not include simply reading a data value from a register. (Andrews Report, Doc. 66-7, pp. 10–11). CalAmp argues that the Accused Devices send a Mode 1, PID 0 request which simply obtains the data value of what parameters are available, rather than causing a physical change. It is Mr. Andrew’s opinion that neither of the Accused Devices performs a control function, and thus, they cannot contain multi-vehicle compatible controllers, making the Accused Devices noninfringing. The Court previously ruled that Mr. Andrews’ testimony as to this issue would not be excluded at trial under *Daubert*.

Omega responds that CalAmp is essentially re-interpreting the Court’s claim construction ruling. While it is improper to argue claim construction to the jury, *Cordis Corp. v. Bos. Sci. Corp.*, 561 F.3d 1319, 1337 (Fed. Cir. 2009), this is not what CalAmp seeks to do. CalAmp is permitted to introduce evidence of the plain and ordinary meaning of terms to one skilled in the art that were not construed by the Court through their expert, Mr. Andrews. *DNT, LLC v. Sprint Spectrum, LP*, No. 3:09CV21, 2010 WL 582164, at *4 (E.D. Va. Feb. 12, 2010). Mr. Andrews seeks to explain what “control function” means to a person of ordinary skill in the art and has not attempted to change or alter the Court’s claim construction. Omega’s definition of what constitutes a control function differs. It is an issue for the trier of fact whether the Accused Devices perform a control function and whether or not there is infringement. *Gentex Corp. v. Donnelly Corp.*, 69 F.3d 527, 530

(Fed. Cir. 1995) (“It is of course established that infringement of a patent claim is an issue of fact”)

Claim 3 states, “A control system according to claim 1 wherein said multi-vehicle compatible controller generates command signals sequentially.” As claim 3 is predicated on claim 1, summary judgment is also inappropriate as to claim 3. Thus, summary judgment is due to be denied as to the ‘876 Patent.

b. The ‘278 Patent

Omega argues that CalAmp has also directly infringed Claims 1 and 3 of the ‘278 Patent by making and selling the Accused Devices. (Doc. 54, p. 9). Claim 1 of the ‘278 Patent provides:

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.

(Doc. 57-5, ‘278::25:64–26:15). Again, CalAmp asserts that a multi-vehicle compatible controller must perform a control function, and for the same reasons articulated in Section III.A.1.a, summary judgment is due to be denied as to the ‘278 Patent.

2. Validity of the Patents-In-Suit

Omega also moves for summary judgment on Count 2 of CalAmp's Counterclaim, which seeks a declaratory judgment that the patents-in-suit are invalid. CalAmp cross-moves, seeking to invalidate Patents '876, '885, '278, and '989. Thus, the Court will resolve these motions together. Courts begin with the presumption that a patent is valid. 35 U.S.C. § 282(a); *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 885 (Fed. Cir. 1984) ("The decisionmaker is thus required to begin by accepting the proposition that the patent is valid and then look to the challenger for proof to the contrary."). However, this presumption can be overcome by clear and convincing evidence. *Iovate Health Scis., Inc. v. Bio-Engineered Supplements & Nutrition, Inc.*, 586 F.3d 1376, 1380 (Fed. Cir. 2009).

a. Invalidity Due to Anticipation

A patent is invalid for anticipation where "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 the application for a patent in the United States." 35 U.S.C. § 102(b) (2006). "Section 102 embodies the concept of novelty—if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is 'anticipated' by the prior invention." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). To this end, "anticipation requires all elements of a claim to be disclosed within a single reference." *Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008). Additionally, the prior art reference "must also disclose those elements 'arranged as in the claim.'"⁴ *Net*

⁴ "[T]he 'arranged as in the claim' requirement applies to all claims and refers to the need for an anticipatory reference to show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order. The test is thus more accurately understood to mean 'arranged or combined in the same way

MoneyIN, 545 F.3d at 1369. Anticipation is a question of fact but can be resolved on summary judgment if no genuine issue of material fact exists. *OSRAM Sylvania, Inc. v. Am. Induction Techs., Inc.*, 701 F.3d 698, 704 (Fed. Cir. 2012).

CalAmp argues that the '278 Patent and the '989 Patent are invalid due to anticipation. CalAmp contends that the '074 Patent to Spaur and the '392 Patent to Bambini are both instances of prior art which anticipate the '278 Patent. CalAmp asserts that the Trimble CrossCheck AMPS Product and Documentation anticipate the '989 Patent. The Court addresses each argument in turn.

CalAmp argues that the asserted claims of the '278 Patent (claims 1–6, 8, 11–14, 16, 18, 19, and 21) are anticipated by U.S. Patent 5,732,074 to Spaur. Omega responds that on June 10, 2015, three weeks prior to Mr. Andrews executing his Declaration in this case, Omega deposed Mr. Andrews who testified that he was not offering an invalidity opinion based on an anticipation theory that the '278 Patent is anticipated by the '074 Patent to Spaur. (Andrews Depo., Doc. 66-10, 115:4–22). Other than Mr. Andrews Declaration, CalAmp' relies solely on attorney argument in asserting its theory of anticipation and has not provided any other affirmative evidence in support. Without other evidence to support its theory, CalAmp's fails to carry its burden on summary judgment, and the motion is due to be denied.

CalAmp also contends that the '392 Patent to Bambini discloses each of the asserted claims of the '278 Patent and is therefore anticipated, once again relying on Mr. Andrews' opinion. However, Mr. Andrews testified during deposition that the Bambini patent does not disclose a multi-vehicle compatible controller as required by claim 1 of

as in the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1370 (Fed. Cir. 2008).

the '278 Patent. (Andrews Depo., Doc. 66-9, 63:6–15). Thus, CalAmp's motion for summary judgment on this basis is denied.⁵

Lastly, CalAmp argues that the asserted claims of the '989 Patent (claims 23, 31, 32, 34, and 35) are anticipated by the Trimble CrossCheck AMPS Product and Documentation (the "Trimble CrossCheck"). Mr. Andrews references four separate documents: (1) CrossCheck AMPS with IQ *Event Engine* Firmware Operation Manual (Doc. 59-4); (2) CrossCheck AMPS Cellular marketing material (Doc. 59-5); (3) the IQ*EventEngine* Configuration Utility Users Guide (Doc. 59-6) and; (4) The TAIP/IQ*Event Engine* Reference (Doc. 59-7).

Claim 23 of the '989 Patent, on which claims 31, 32, 34, and 35 depend, provides for:

A tracking unit for a vehicle comprising:

A vehicle position determining device, a wireless communication device, and a controller cooperating with said wireless communications device and said vehicle position determining device to determine and send vehicle position information to a monitoring station;

Said controller sorting a user selected reference location;

Said controller also sending the vehicle position information based upon the vehicle moving beyond a radial threshold distance from the user selected reference location.

(Doc. 57-2, '989::44:57–67).

⁵ To the extent that CalAmp argues that the '392 Patent to Bambini in combination with SAE J1978 invalidates the '278 Patent due to anticipation, that argument is rejected as contrary to case law. *Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008) ("Anticipation requires all elements of a claim to be disclosed within a *single* reference.") (emphasis added).

Omega points out that CalAmp cannot prove anticipation by combining the Trimble references because “anticipation requires all elements of a claim to be disclosed within a single reference.” *Cohesive Techs.*, 543 F.3d at 1364; *King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1274 (Fed. Cir. 2010). Mr. Andrews’ Declaration addresses the Crosscheck references in paragraphs 50 through 59. (Doc. 59). At least as to claim 23, CalAmp relies on the combination of the CrossCheck AMPS with IQ *Event Engine* Firmware Operation Manual (Doc. 59-4) and the IQ*EventEngine* Configuration Utility Users Guide. (Doc. 59, ¶¶ 50–55). In its reply, CalAmp argues that multiple documents may be used to identify the disclosure of a single piece of prior art device citing a string of cases. However, a review of the case law does not support CalAmp’s argument. Because CalAmp’s theory relies on more than one document to argue that the ‘989 Patent is anticipated, the argument fails for that reason: all the elements of the claim are not disclosed in a single reference. Thus, summary judgment is due to be denied.

b. Invalidation Due to Obviousness

A patent is invalid for obviousness where “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.” 35 U.S.C. § 103(a) (2006). “If a person of ordinary skill in the art can implement a predictable variation, . . . § 103 likely bars its patentability.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007); *Cohesive Techs.*, 543 F.3d at 1364 (“Obviousness can be proven by combining existing prior art references . . .”).

The test for obviousness is set forth as follows:

Obviousness is a question of law based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the prior art and the claimed invention as perceived before the time of invention; and (4) the extent of any objective indicia of non-obviousness.

Rolls-Royce, PLC v. United Techs. Corp., 603 F.3d 1325, 1338 (Fed. Cir. 2010). “If a person of ordinary skill, before the time of invention and without knowledge of that invention, would have found the invention merely an easily predictable and achievable variation or combination of the prior art, then the invention likely would have been obvious.” *Id.* (citing *KSR Int’l*, 550 U.S. at 421). “The Supreme Court has warned, however, that, while an analysis of any teaching, suggestion, or motivation to combine known elements is useful to an obviousness analysis, the overall obviousness inquiry must be expansive and flexible.” *OSRAM*, 701 F.3d at 707 (citing *KSR Int’l*, 550 U.S. at 415). Obviousness should be assessed at the time the invention was made; thus, hindsight analysis is inappropriate. *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1073 (Fed. Cir. 2012)

Additionally, “obviousness requires analysis of secondary considerations of nonobviousness.” *Cohesive Techs.*, 543 F.3d at 1364. Such secondary considerations can include a “long-felt but unresolved need, achieved commercial success, and . . . industry acclaim from the inventor’s peers.” *Rolls-Royce*, 603 F.3d at 1339. The parties agree that a claim based on obviousness is a legal issue for the Court to decide “when the factual inquiries into obviousness present no genuine issue of material facts.” *OSRAM*, 701 F.3d at 704.

CalAmp argues that the '876 Patent and the '885 Patent are both invalid due to obviousness. As to the '876 Patent, CalAmp contends that both the '479 Patent to Braitberg in combination with SAE J1978 and the '392 Patent to Bambini in combination with the SAE J1978 invalidate the '876 Patent. As to the '885 Patent, CalAmp contends that both the '479 Patent to Braitberg in combination with the SAE J1978 and the CellPort Labs MobileWeb Product/Publication either alone or in combination with the SAE J1978 invalidate the '885 Patent.

Turning first to the '876 Patent, CalAmp assert that the '479 Patent to Braitberg in combination with the SAE J1978 render claims 1, 3–5, 12, 14, and 16 of the '876 Patent obvious. The relevant elements of claim 1 in the '876 Patent, on which the other claims depend, are a control system comprising a multi-vehicle compatible controller generating at least one set of command signals on the data communications bus, and 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. (Doc. 57-1, '876::11:32–48).

CalAmp identifies U.S. Patent No. 5,479,479 to Braitberg as prior art. Omega correctly points out that each claim of the '876 Patent requires both (1) working and non-working command signals and (2) a multi-vehicle compatible controller. Omega directs the Court to CalAmp's expert, Mr. Andrews, who conceded that the Braitberg Patent (and the Bambini Patent) did not disclose a multi-vehicle compatible controller. (Andrews Depo., Doc. 66-8, 32:1–9). While CalAmp asserts that Mr. McAlexander, Omega's expert, admitted that a controller with a single bus could theoretically be multi-vehicle compatible, Omega argues that hypothetical disclosures of a multi-vehicle compatible controller do not reach the level of clear and convincing evidence required to prove obviousness. The Court

agrees that from an evidentiary standard, the evidence must be clear and convincing and a hypothetical possibility does not rise to this level.

CalAmp responds that one of ordinary skill in the art would be aware of the bus detection procedure of SAE J1978 providing multi-vehicle and multi-bus compatibility. (Doc. 78, p. 14). CalAmp goes on to argue that one skilled in the art of connecting the controller of Braitberg to the vehicle bus would have used the industry standard procedure for bus discovery. CalAmp contends that the SAE J1978, since 1994, has described how to connect a device to various types of vehicle buses, thereby making the device compatible with multiple buses and vehicles. (Doc. 78, p. 10).

On this point, Mr. Andrews opines:

The EPA has mandated a common, low cost service tool (Scan Tool) that would allow the service technician to diagnose all vehicles at least as early as 1996. To enable the Scan Tool to communicate across all vehicles, the Society of Automotive Engineers (SAE) and automotive industry experts developed The J1978 Publication. SAE J1978, issued 1992-03, Revised 1994-06 describes the communications protocols required to support OBD II diagnostic information and the development of a common diagnostic interface for the OBD II Scan Tool. The J1978 publication is required to be supported by all vehicle and testing equipment manufactures. This standard describes connecting to the vehicle bus using one of three interfaces by sending a signal (i.e. request message) on the data communications bus. It should be noted that current versions of the J1978 spec have increased the number of supported interfaces. This allows a scan tool to be compatible with various busses, and thus a variety of vehicles.

Additionally, a standard set of message formats, for both request and response messages, is defined in SAE J1979. This standard relates to the implementation of the Diagnostic Test Modes necessary to meet California On-Board Diagnostic (OBD) and Federal On-Board Diagnostic (OBD-II) requirements for emission related test data. This standard discloses the request and response messages necessary to be supported by vehicle manufacturers and test tools to meet the California and Federal regulations.

As both SAE J1978 and J1979 were mandated in California and federally prior to the earliest priority date of the asserted patents, one of ordinary skill in the art would be intimately familiar with both the SAE J1978 and J1979 standards at least as early as the earliest priority date of the asserted patents.

(Doc. 59, ¶¶ 9–11).

Critical to the Court’s determination of whether the CalAmp prevails on its obviousness argument is whether one of ordinary skill in the art would use SAE J1978 to disclose how to connect a device to various types of vehicle buses, thereby making the device compatible with multiple buses and vehicles. Omega’s expert, Mr. McAlexander, opines that there would have been no reason for one of skill in the art to combine the solutions in Braitberg or Bambini with the SAE J1978 OBD II Scan Tool reference. (McAlexander Report, Doc. 66-24, ¶¶ 133, 140). Accordingly, a material issue of fact exists as to whether the prior art references would have been combined prior to the invention, and summary judgment is due to be denied as to the ‘876 and ‘885 patents.⁶

3. Enforceability of the Patents-In-Suit

Omega also moves for summary judgment on Count 3 of CalAmp’s Counterclaim which seeks a declaratory judgment that the patents-in-suit are unenforceable due to inequitable conduct. “Inequitable conduct is an equitable defense to patent infringement that, if proved, bars enforcement of a patent.” *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1285 (Fed. Cir. 2011). To prevail, “the accused infringer must prove that the patentee acted with the specific intent to deceive the [Patent & Trademark Office].” *Id.* at 1290. A finding of negligence, or even gross negligence, is not enough to satisfy the intent requirement. *Id.* In this case, CalAmp must prove by clear and convincing

⁶ The Court need not yet reach the issue of whether the prior art references in fact render the invention obvious, if one skilled in the art had reason to combine the prior art.

evidence that the patent applicant “*made a deliberate decision* to withhold a *known* material reference.” *Id.*

There are two separate elements needed to establish a claim of inequitable conduct: intent and materiality. *Id.* at 1290. The Federal Circuit has instructed district courts to “weigh the evidence of intent to deceive independent of its analysis of materiality.” *Id.* First, in demonstrating intent, it is not enough to “[p]rove that the applicant knew of a reference, should have known of its materiality, and decided not to submit it to the PTO.” *Id.* While intent may be inferred, “intent to deceive must be ‘the single most reasonable inference able to be drawn from the evidence.’” *Id.* (quoting *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357,1366). Second, in demonstrating materiality, but-for materiality is required. *Id.* at 1291. “When an applicant fails to disclose prior art to the PTO, that prior art is but-for material if the PTO would not have allowed a claim had it been aware of the undisclosed prior art.” *Id.*

Omega asserts that CalAmp has failed to disclose any evidence of inequitable conduct. (Doc. 54, p. 21). Specifically, Omega argues that CalAmp can offer no evidence that Omega had knowledge of prior art but failed to submit it to the PTO or that there existed any intent to defraud the PTO. CalAmp responds that the inventor of the patents-in-suit, Mr. Flick, knew of prior art relating to the ‘254 Patent but failed to disclose it to the USPTO. Mr. Flick testified that he was aware of the company, Mobile Security Communications, Inc. as relates to the ‘254 Patent. Further, Mr. Flick testified that he is not familiar with SAE publications. However, two of the patents-in-suit, the ‘876 Patent and the ‘885 Patent, refer to SAE J1850 in the background section. CalAmp argues that while it appears Omega never disclosed the J1850 reference to the PTO during the prosecution of these two patents, its familiarity with the publication calls into question

whether it was truly unaware of the SAE bus standards. Lastly, CalAmp argues that Omega failed to disclose U.S. Patent No. 5,555,498 during the prosecution of the '278 Patent even though it was aware of the patent because it had been cited during the '876 and '885 prosecutions.

CalAmp also attempts to cast doubt on the credibility of Mr. Flick's testimony during his deposition in this case. Mr. Flick testified during his deposition that he relies on his counsel to draft his patents. (Doc. 76-1, 23:2-4). Thus, he was not comfortable during his deposition talking about the meaning of terms or figures contained within his patents. (See Doc. 76-1). From this, CalAmp urges the Court to draw the conclusion that this lack of understanding of the patents-in-suit raises serious questions as to inventorship and candor to the PTO.

However, even assuming all of CalAmp's assertions are true, CalAmp has not offered *clear and convincing* evidence to prove that Omega, Mr. Flick, or their attorneys acted with specific intent to deceive the PTO. Mr. Flick testified in deposition that he does not review SAE publications. Even if Omega did fail to disclose an SAE publication in one of the patents-in-suit, Omega is correct that this is not enough evidence to conclude that Omega was also aware of the thousands of other SAE publications, that these were material to the patent prosecution, and that Omega intended not to disclose those publications to the PTO. The evidence put forth by CalAmp at this stage of the litigation is not enough to hurdle the clear and convincing threshold. And while one might expect Mr. Flick to be more articulate regarding his patents-in-suit, his inability to answer targeted questions regarding the patents-in-suit does not rise to the level of specific intent to deceive the PTO. Lastly, CalAmp does not offer any evidence or argument on but-for

materiality. Thus, summary judgment is due to be granted in favor of Omega and against CalAmp on Count 3 of CalAmp's counterclaim for unenforceability.

B. CalAmp's Motion for Summary Judgment

Remaining for the Court's consideration is CalAmp's motion for summary judgment on Count 1 of its Counterclaim which seeks a declaratory judgment that the Accused Devices do not infringe the patents-in-suit. Specifically, CalAmp moves for summary judgment of noninfringement of the '876, '885, '278, and '727 Patents under 35 U.S.C. § 271 because no Accused Device includes each and every limitation of any asserted claim of these patents, and thus, do not infringe these patents.

1. Device Code Limitations

CalAmp argues that the Accused Devices do not include device code limitations. Both the '885 and '278 Patents include device codes. The '885 Patent requires a controller "for storing a set of device codes for a given vehicle for a plurality of different vehicles, for reading a device code from the data communications bus, and for determining a match between a read device code and the stored device codes to thereby provide compatibility with a plurality of different vehicles." (Doc. 57-3). The '278 Patent requires "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." (Doc. 57-5). The Court has previously construed "device code" as "a signal from a vehicle device." (Doc. 50, p. 25). Omega identifies the engine control unit ("ECU") as the vehicle device.

CalAmp's argument is composed of two parts. First, CalAmp submits that the Accused Devices do not store a set of device codes for a given vehicle device for a plurality of different vehicles, do not read such a code, and do not determine a match

between them as to the '885 Patent. Specifically, CalAmp contends that Omega has not identified any set of signals from the ECU for a plurality of different vehicles that the Accused Devices store. Instead, Omega identifies SAE J1978 queries from the Accused Devices. CalAmp contends these are not signals from the ECU and thus cannot infringe.

Further, CalAmp argues that the Accused Devices do not contain a “set of device codes for a given vehicle device for a plurality of different vehicles.” CalAmp argues that the VIN data received is unique to a particular vehicle. As the argument goes, because Omega does not identify any stored “set of device codes for a given vehicle device for a plurality of different vehicles,” there can be no determining a match between the VIN data and a stored set of device codes. CalAmp also argues that the Accused Devices do not communicate using at least one corresponding vehicle device code from among a plurality thereof for different vehicles as to the '278 Patent. CalAmp argues that Omega relies on the SAE J1978 bus determination procedure to satisfy the device code limitation, with the additional allegation that for the LMU-3030, reading VIN data satisfies this limitation.

Omega responds that Mr. McAlexander testified that the Accused Devices read the messages from the bus during the vehicle discovery process, thus reading a device code. They then match the read device code with messages in the Accused Devices. The data are then loaded through the serial port on the Accused Devices, enabling the Accused Devices to communicate with at least one vehicle device. (Doc. 81, pp. 17–18). Omega further avers that CalAmp is simply attempting to construe the term “vehicle devices,” a term for which CalAmp did not seek construction. Omega argues that CalAmp’s proposed definition for vehicle device contradicts that which is described in the '279 Patent. This issue must, at this stage in the proceedings, be resolved in favor of

Omega, because Mr. McAlexander's testimony creates a material issue of fact making summary judgement inappropriate.

2. Working and Non-Working Command Signals

Next, CalAmp argues that the Accused Devices do not generate the required working and non-working command signals required by each claim of the '876 Patent. As stated previously, claim 1 of the '876 Patent provides:

A control system . . . comprising:

. . .

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 communications 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 vehicles.

(Doc. 57-1, '876::11:30–48).

The Court has previously construed command signal as a “signal generated on the data communications bus for operating a vehicle device.” (Doc. 50, p. 25). Omega contends that the vehicle device is the ECU. CalAmp argues that Omega has not provided evidence that the Accused Devices “operate” the ECU. In response, Omega relies on the prior art bus detection procedure by which a list of parameters is obtained. CalAmp goes on to argue that even if the bus detection procedure is deemed to send command signals, if the first message sent matches the vehicle bus, there would be no non-working command signal and thus no infringement. Additionally, CalAmp argues that the signal must be compatible with the bus, and in the SAE J1978 bus detection procedure, only a single signal would be bus-compatible and, thus, there would be no non-working signal.

Omega responds that CalAmp is improperly construing the term “command signal” as argued in its motion for summary judgment on infringement. Previously, the Court determined that material issues of fact remained as to whether the term “command signal” required a physical change and thus whether the Accused Devices infringed. Omega asserts that CalAmp goes one step further in restricting the Patent to require the command signal that requires both working and non-working command signals to be compatible with a specific bus. The Court agrees with Omega’s assertion that the mere possibility that a successful signal sent by the Accused Devices along the bus may not require a non-working signal and thus, this is inadequate for a finding of noninfringement. Additionally, as set forth in the Court’s order on Plaintiff’s *Daubert* challenge of Mr. Andrews, several issues of fact remain regarding how one skilled in the art would interpret terms including whether a single bus interface protocol is envisioned. Defendant’s motion for summary judgment is, therefore, denied.

3. Speed Data

Lastly, CalAmp asserts that the Accused Devices use speed data from the GPS, not the vehicle bus, and thus do not infringe the ‘727 Patent. Each of the ‘727 Patent’s claims require “reading the data related to vehicle speed from the vehicle data communications bus, and determining when a vehicle speed exceeds a speed threshold for a first time period and based thereon cooperating with said wireless communications device to send a remote vehicle speed exceeded notification.” (Doc. 57-4, ‘727::7:13–18). CalAmp’s expert, Mr. Andrews, testified that the PEG Support Guide for Vehicle Bus indicates that the Accused Devices “can use an accumulator to accumulate a variety of data from a vehicle data bus, including vehicle speed.” (Doc. 61, ¶ 31). Mr. Andrews goes on to opine, however, that “none of the vehicle-speed related triggers and functionality

described [in the claim] are compatible with the vehicle data bus accumulators.” (*Id.*) Mr. Andrews concludes that even though it appears that the Accused Devices are capable of reading speed data from the vehicle bus data, “it is unclear how that speed data could be utilized to ‘determine when a vehicle speed exceeds a speed threshold for a first time period’ and ‘based thereon cooperating with said wireless communications device to send a remote vehicle speed exceeded notification’ as in claim 1.” (*Id.*) Thus, he asserts that the Accused Devices do not infringe on claim 1 of the ‘727 Patent.

Omega responds that their expert, Mr. McAlexander, testified that the programming tools provided with the Accused Devices can configure the Accused Devices to perform the claimed notification using vehicle speed from the bus. (McAlexander Report, Doc. 66-22, p. D-6). Given this testimony, further factfinding is required, because it is unclear whether the Accused Devices’ ability to read vehicle speed from the data communications bus can be activated using “means that are already present in the underlying software,” as opposed to whether an actual alteration must take place. *Fantasy Sports Props., Inc. v. Sportsline.com, Inc.*, 287 F.3d 1108, 1118 (Fed. Cir. 2002). Mr. Andrews agrees that the Accused Devices are capable of reading speed data from the vehicle bus, but whether this information can be used to cooperate with the wireless communication device to send the exceeded notification without some sort of alteration, rather than mere activation, is unclear. Thus, genuine issues of fact exist as to whether the Accused Devices infringe the ‘727 Patent.

IV. CONCLUSION

Accordingly, it is hereby **ORDERED AND ADJUDGED** that:

1. Plaintiff’s Motion and Memorandum for Summary Judgment as to Validity, Infringement, Enforceability and Unfair Competition (Doc. 54) is **GRANTED**

IN PART AND DENIED IN PART as follows:

- a. Summary judgment is **GRANTED** in favor of Omega and against CalAmp on Count 3 of CalAmp's counterclaim for unenforceability.
 - b. Summary judgment is **DENIED AS MOOT** to the extent Omega moves for summary judgment on CalAmp's counterclaim for unfair competition. As stated in this Order, CalAmp does not have a counterclaim for unfair competition pending.
 - c. The motion is otherwise **DENIED**.
2. Defendant CalAmp Corp.'s Motion for Summary Judgment and Memorandum of Law Regarding Invalidity and Noninfringement (Doc. 78) is **DENIED**.

DONE AND ORDERED in Orlando, Florida on December 23, 2015.


PAUL G. BYRON
UNITED STATES DISTRICT JUDGE

Copies furnished to:
Counsel of Record