

Filed on behalf of Desktop Alert Inc.

By: Andrew C. Aitken
Aitken Aitken Law Offices
P.O. Box 1810
Wheaton, MD 20915

IPR2024-00363

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALERTUS TECHNOLOGIES, LLC
Petitioner

v.

DESKTOP ALERT INC.
Patent Owner

Case No. IPR2024-00363
U.S. Patent No. 9,172,765

PRELIMINARY PATENT OWNER RESPONSE

Pursuant to 37 C.F.R. § 42.107, Desktop Alert Inc. (“CM”) submits this Patent Owner’s Preliminary Response in opposition to the Petition for *Inter Partes* Review (the “Petition”) filed by Alertus Technologies LLC (“ATL”), Jason A. Volk, The Volk Family Delaware Dynasty Trust I, and The Volk Family Delaware Dynasty Trust II (“Volk Parties”) (collectively, “Petitioner”) regarding claims 1-13 of U.S. Patent No. 9,172,765 (the “’765 Patent”). The Petition should be denied in its entirety for the reasons set forth below.

I. SECTION 325(d) DENIAL IS WARRANTED

The Petition asserts that U.S. Patent No. 6,067,561 to Dillon (Ex. 1005 or “Dillon”), U.S. Patent Application Publication No. 2009/0164586A1 to Douglas et al. (Ex. 1006 or “Douglas”), and U.S. Patent Application Publication No. 2010/0205243A1 to Brady et al. (Ex. 1007 or “Brady”) are not “the same or substantially the same as those previously presented to the Office.” Pet. at 15. That is incorrect.

Dillon discloses email polling systems, which the ‘765 Patent addressed in the disclosure and readily distinguished. *See* ‘765 Patent, 3:11-16 (“Polling models are commonly used for checking email....”). Further, Dillon is cumulative of U.S. Patent Application Publication No. 2007/0136464 to Gorty et al. (“Gorty”), which related to polling of email for unread messages. Gorty was distinguished by the Patent Owner during prosecution of the ‘765 Patent. *See* Ex. 1002, p.153.

Therefore, Dillon is either identical to prior art that was before the USPTO via the ‘765 Patent’s distinctions over the prior art or merely cumulative in view of Gorty which was distinguished from the Challenged Claims during prosecution of the ‘765 Patent.

Douglas discloses a system that implements a polling strategy that involves both push-message and pull messages between clients and server node. The ‘765 Patent expressly discloses, “[t]he present invention is an improvement to message systems wherein a plurality of clients are in communication with a server through a network that use a polling model, in contrast with systems that use a push model.” ‘765 Patent, 3:8-11. Therefore, Douglas is not only identical to prior art that was before the USPTO via the ‘765 Patent but discloses functionalities (push model) that were expressly distinguished from the ‘765 Patent Challenged Claims.

Brady discloses a system for polling for updates of a data object to be used on web-based customer relationship management (CRM) system (e.g., a webpage). Brady is as irrelevant and distinguishable from the subject matter of the Challenged Claims as was the Boland and Gorty references argued over by the Patent Owner during prosecution of the Challenged Claims. *See* Ex. 1002 p. 153.(“Applicant’s system and method does not require the downloading of a webpage as suggested by the teachings of Gorty.”)

II. INTRODUCTION TO THE ‘765 PATENT

The ‘765 Patent discloses an improvement to the polling protocols utilized by computers in a network that sends and receives emergency alerts from an alert message cache to end user computers (referred to as “client” computers). Polling is a computer-specific activity in which one machine will check on the status of another before taking a next action. See Ex. 1001 (‘765 Patent), 1:11-16¹ (“The basic concept behind polling models is that the client periodically provides queries to the host or server requesting updated messaging information. Polling models are commonly used for checking email and for other applications that require the timely updating of information such as stock prices and weather.”) In the context of the ‘765 Patent, a client will poll the central server over the network to determine whether there are alert messages for that particular client on the server that need to be retrieved. In response, the central server will either send an alert message destined for the client or will send back a responsive “empty” polling message.

Every polling message to and from the server takes up a certain amount of digital data space on the internet connection that binds the network, which is referred to as a payload. As the number of clients on the network increases, every instance of polling (either from the client to the server or from the server to the client) rapidly reduces the available bandwidth available over the internet network

¹ Citations to patents will follow the convention “column(s):line(s)” and citations to publications will refer to paragraphs as “[¶ [paragraph number]]”.

connection to send future polling requests and, more importantly, reduces the bandwidth available to send emergency alert messages to those clients that need them. *See* ‘765 Patent, 4:6-19 (“While polling architectures have been widely adopted, as the scaling increases, the performance of the system may be adversely affected.”) In other words, the basic act of polling by either the client or the server involved in an emergency alert messaging network can ultimately defeat the intended purpose of the network to expediently communicate emergency alerts to the end users, especially when the return message is empty. *See* ‘765 Patent, 8:20-24 (“The overhead associated with an “empty” call (no returned new alerts for GetUnreadAlerts) is larger than the payload by far (and this is the most frequent call). Increasing the polling interval only increases the number of these calls, thereby flooding the network.”)

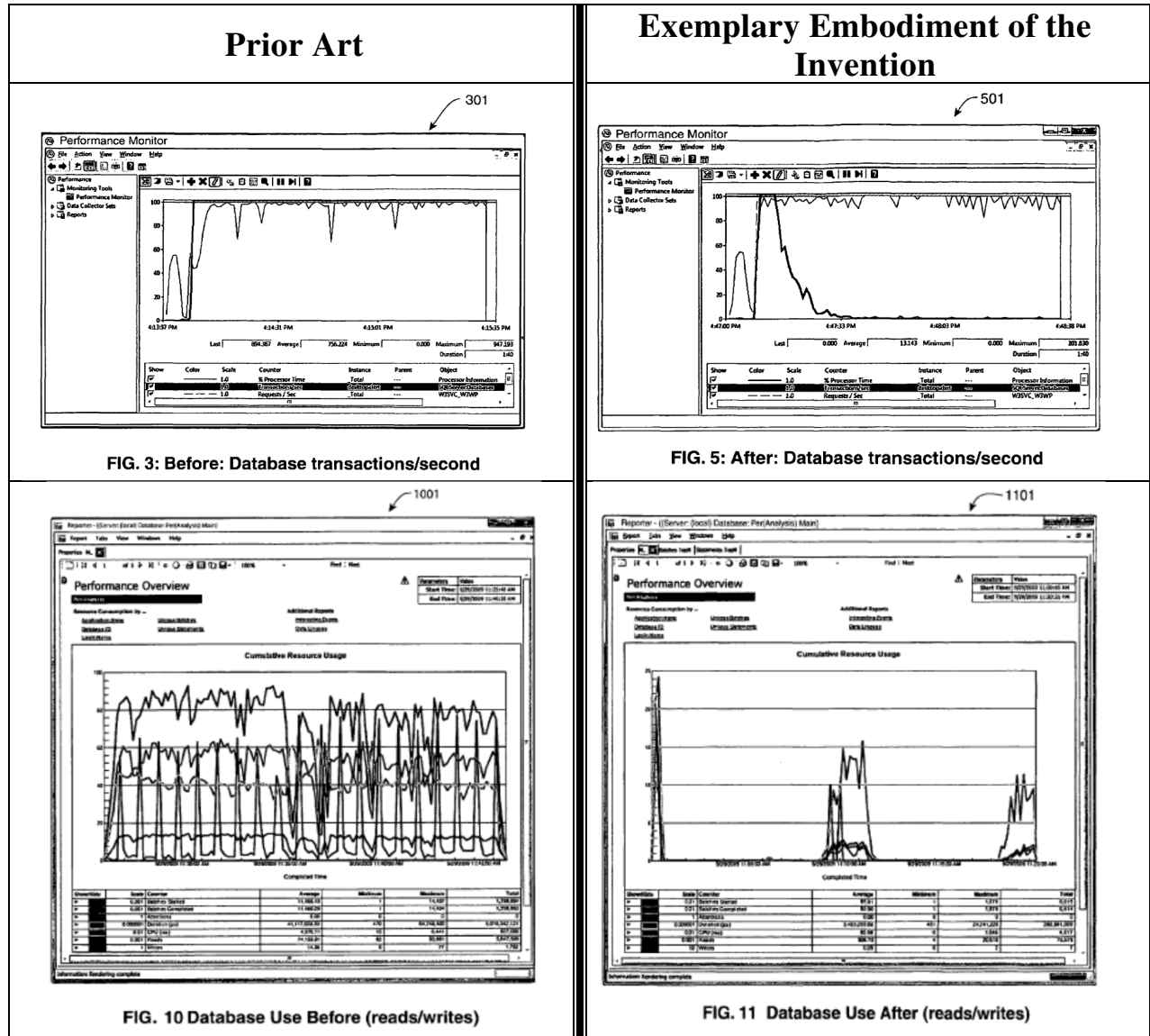
The ‘765 Patent solved this problem by creating a new polling call to be sent before the conventional polling communications take place. This new polling call asks the server whether there are any new alerts to be sent at all, and if none, then the normal polling communication does not transmit, which saves bandwidth and allows more frequent new polling calls to be made. The new polling call is comprised of a uniquely small payload so that it can be transmitted over the network at a higher frequency than was achievable using the normal polling communications but not overcrowd the network connection if and when an alert message is requested in response to one or more of the conventional polling calls:

An additional manner in which to improve performance to a polling based system such as the Desktop Alert system is to change the client-server protocol to use a format other than SOAP for the “triggering” GetUnreadAlerts call. In this alternative model, GetUnreadAlerts call remains intact but is not used for polling, rather a new polling call IsNewAlerts is added. This call passes the userId in a tight HTTP packet (not SOAP) to the webserver, approximately 20 bytes of payload. The result of this call is simply a Boolean value: true or false. If true is returned the client makes the formal (and existing) GetUnreadAlerts calls. IsNewAlerts does not require authentication and therefore can bypass the SOAP security layer. FIG. 7 depicts the client request data for GetUnreadAlerts from the server using the SOAP protocol. In contrast referring now to FIG. 8 is a screen shot 801 of a display depicting the improved Req.aspx call using the HTTP GET protocol and response messages is depicted which has a smaller communications and data payload.

See ‘765 Patent, 8:35-61; Figs. 7-8.

Therefore, the ‘765 Patent claimed technology transformed the computers in the alert network into more lean polling machines by **increasing** the number of polling actions but **reducing** the sequence and payload of these increased number of polling actions. In the case of emergency alerting, the ‘765 Patented improvement is critical for networks tasked with sending instant message emergency alerts to its end user client computers efficiently and effectively over the computer network. *See* ‘765 Patent, 2:11-18. Additionally, the alerts are sent in instant message format to display the alert to the end user’s computer graphical interface. *See id.* at 4:3-6.

Using Figures 3, 4, 5, 10, 11, and their related disclosures, the ‘765 Patent demonstrates how the claimed technology increases the computer performance on which it is implemented:



‘765 Patent, 2:45 – 3:4; 6:11-59. The ‘765 Patent also discloses how an embodiment of the patented improvement “greatly improve[s] the polling performance of the previously available Desktop Alert notification system. It is estimated that the present

system results in 300% improvement in comparison with the prior art system while at the same time vastly reducing the database use.”

TABLE 2

Process	Requests/ Second	Database Transactions/Second Required
Existing GetUnreadAlerts	215	756
Improved GetUnreadAlerts	709	3
Limit	1260	n/a

Id. at 6:62 – 7:8 (Table 2). The ‘765 Patent further discloses:

The improvements disclosed above result in significant improvements to the performance of the system. As the example demonstrates, by altering the logic so that the system will seek to obtain new alerts only when the system has created new alerts, the polling frequency may be increased from 215 requests/second to 709 requests/second while dramatically reducing database usage. This improvement allows a installation to drop the polling interval by a factor of 3 without the requirement of any hardware changes. In other words, if the polling interval of a system is at 60 seconds, the present improvement allows the polling interval to be set at 20 seconds without effecting performance. Even if one were to follow a very conservative approach the present improvement easily allows one to double the polling interval. Consequently, the speed in which messages are communicated to the users is increased. Furthermore, since the database use model has changed dramatically, the database is no longer the limiting factor—its the potential throughput of the GetUnread Alerts web Services calls.

Id. at 7:12-32.

The ‘765 Patent claims a “triggering step” that in combination with second through sixth steps reads on the above disclosures. *See, e.g.*, ‘765 Patent, Claim 1 (“...a first triggering step comprises the use of a HTTP packet comprising a request for a Boolean value relating to whether there are new alert messages and said packet

comprises approximately 20 bytes...” and “upon the reception of said unread alert messages in said sixth step, said alert messages are in instant message format and said client opens a window on a display panel to display said alert messages); ‘765 Patent, Claim 10 (“...a first triggering step comprises the use of a HTTP packet comprising a request for a Boolean value relating to whether there are new alert messages and said packet comprises approximately 20 bytes...” and “in response to said requests, said server transmits any unread alert messages and said unread alert message are in instant message format and upon the client's reception of said unread alert messages said client opens a window on a display panel at said client... .”)

Therefore, the ‘765 Patent discloses and claims a software-based solution to a problem that exists only in the realm of computer networks, such as, for example, the ‘765 Patent’s referenced prior art Desktop Alert web application/service+SQL Server. Furthermore, the ‘765 Patent’s claims recite the disclosed specific improvements to the computers in which they are embodied, namely, the generation of a new polling message to precede a subsequent polling message that is designed for reduced-sized transmission between the client and server to promote efficient and unhindered alert messaging in instant message format.

III. CLAIM CONSTRUCTION

A. PETITIONER’S PROPOSED CONSTRUCTIONS

Regarding the terms “said memory,” “its memory,” and “said processor,” Patent Owner believes each of these terms should be given their plain and ordinary meaning. Patent Owner otherwise disagrees with any of Petitioner’s proposed constructions or its assertion that they render any Challenged Claim indefinite for allegedly lacking antecedent basis. *See* Pet. at 5 (citing *Energizer Holdings Inc. v. United States ITC*, 435 F.3d 1366, 1370-71 (Fed. Cir 2006) (lack of antecedent basis does not render a claim *per se* indefinite)).

B. “ALERT MESSAGE”

The ‘765 Patent discloses an “alert message” as “a prewritten or prerecorded message stored in the dynamic information database for subsequent use by the administrator.” *See* ‘765 Patent, 3:67-4:2. The ‘765 Patent Claim 1 requires the central server to have an “alert message cache” or database and also requires “alert messages,” upon reception by the client, to be “in instant message format and said client opens a window on a display panel to display said alert messages.”

The ‘765 Patent distinguishes a “message” or an “alert” from an “e-mail,” such as when it discusses the prior art Desktop Alert System (“DAS”):

- “It is a multi-media, GIS enabled mass notification platform that is used to *deliver messages* and media including live surveillance video, images, audio files, giant voice, interactive Flash files and other

applications *to* desktops as well as other devices such as telephones, cell phones, e-mail and mobile devices.” 1:19-24 (emphasis added).

- “*Send Alerts to* Desktops, e-mails, cell phones and telephones, all with one command.” 1:50-51 (emphasis added).

As used in the ‘765 Patent, the term “alert message” does not mean an e-mail because the terms “alert” and “message” refer to things that are sent *to* e-mail but neither of which is an e-mail.

C. “ALERT MESSAGE CACHE”

The ‘765 Patent refers to an “alert message cache” in Claim 1, which would be understood by a person of ordinary skill in the art (“POSITA”) as being a database for the storing of “alert messages” to be used by a plurality of client computers. *See id.* at 3:43-48.

D. “ALERT ID NUMBERS”

An “alert ID number” is referred to as a value for a particular alert message for the entire system, and not merely a client-specific identification value. *See* ‘765 Patent, 5:1-20. The “alert ID number” does not relate to any given client, instead, all clients independently use the “alert ID number” to determine whether new “alert messages” are available. The central basis for the improvement of the Challenged Claims is that “the number of poll requests from the clients vastly outnumbers the number of new alerts that are posted in the server in any given day....” *Id.* at 5:21-24.

The '765 Patent describes the “Alert ID Number” as a “global alerted” value that is “incremented” to allow each client on the server to know when a new “alert message” is ready to be accessed from the central server database. *See id.* at 6:53-59.

In other words, the “Alert ID Number” refers to the number or tally of the alert messages that has been received by the central server. As the new alerts are issued, the value increases and enables the clients to determine whether a new alert has been issued and it must send a “GetUnreadAlert” message. An Alert ID Number is not a unique identifier related to a single e-mail relating to an email subscriber terminal that has access to the e-mail server on which that single email is stored. The ‘Alert ID Number’ is not related to any particular client or email at all; the ‘Alert ID Number’ is used by clients in the system to determine whether a request for unread alerts is required, as noted above.

E. “A FIRST TRIGGERING STEP”

The ‘765 Patent Claims 1 and 10 each recite “a first triggering step....” The ‘765 Patent refers to the “triggering step” as a “new polling call” that precedes the pre-existing polling calls to obtain unread alert messages. *See* ‘765 Patent, 8:35-52 (contrasting the “GetUnreadAlerts” call to the “IsNewAlerts” call). In other words, the “first triggering step” is a polling call that dictates whether the entire system needs to entertain any polling calls from the clients, which the ‘765 Patent describes and claims as a technical improvement over past remote alert messaging systems

due to reduced bandwidth usage. *See id.* at 7:12-28. Thus, the Challenged Claims specifically use the word “triggering,” which has an ordinary meaning of to “cause (an event or situation) to happen or exist.” In this way, the “triggering” step precedes any other activity between clients and server in the system.

The Petition fails to give any meaning to the limitation of “triggering” in analyzing any of the prior art by erroneously interpreting the “first triggering step” as if it were equivalent to a client sending its first polling message to a central server. *See* Pet. at 32 (“Such “requests” are sent by a ‘polling client ... that ... calls or queries the polling server.’”) The Petitioner goes on to contend “[a] POSITA would also understand that such an HTTP packet comprising a request could constitute a ‘triggering’ step because the use of the HTTP packet comprising a request can result in a function or process being initiated.”) (internal citations omitted). *Id.* However, the ‘765 Patent expressly calls the “triggering” step something that is new compared to the prior polling processes (e.g., such as e-mail polling processes), namely, a condition precedent to the polling and transmission of any queued, unread alert messages. *See* Ex 1001, C8:35-52 (describing triggering step claimed in limitation [1.4]. In other words, the Petition fails to give any meaning to the “triggering step,” and merely conflates it with the recited second, third, fourth, and fifth steps. *See* Pet. at 34-37.

The Petitioner's failure to recognize the distinction between the "triggering step" and any other claimed step over-generalizes what this limitation requires and/or means, causing the overall analysis to be flawed and incorrect.

IV. THE DEFICIENCIES IN PETITIONER'S CHALLENGES

A. DILLON FAILS TO DISCLOSE EACH ELEMENT OF LIMITATION [1.1], [10.1], AND [10.3] BECAUSE IT DOES NOT SEND ALERT MESSAGES TO A PLURALITY OF SUBSCRIBERS NOR STORES THE SAME

U.S. Patent No. 6,067,561 to Dillon ("Dillon") discloses a one-way, continuous, high-speed broadcast communication channel and a switched communication channel operating at a relatively lower speed to allow individual e-mail subscribers to be alerted when they have received new e-mail messages. *See* Dillon, 1:9-22; 2:41-46. Dillon does not disclose an alert message being stored in a central server (what Petitioner argues is system component 12 in Dillon Fig. 1) that is also sent to a plurality of client computers (what Petitioner argues are the subscriber terminals 18 in Dillon Fig. 1). Instead, Dillon discloses the use of audible or visual alerts 35 being triggered ***on the subscriber terminal 18*** to indicate to the subscriber that a new e-mail has arrived at the e-mail server 12. *Id.* at 8:29-33; Fig. 2. In other words, to the extent Dillon may be even considered to disclose "alerts" as defined in the '765 Patent, those "alerts" are not stored on the e-mail server 12 (Ppetitioner's alleged "central server" of Claim 1). Further, the "alerts" disclosed in Dillon are ***never*** transmitted to any e-mail received by any subscriber at the subscriber terminal 18 (Ppetitioner's alleged "client computer") nor are they provided to a subscriber in an instant message format. Dillon uses a front end 28 computer that issues the "alert"; the alert is not stored on server 12, but the new email is. Front end 28 generates and delivers the alert to client 18.

Petitioner argues that a POSITA “would have been motivated to modify the emails of Dillon to constitute alert messages.” Pet. at 25-26. Petitioner’s rationale is that the AAPA allegedly acknowledges that the prior art Desktop Alert System (“DAS”) sent alerts as emails, and “[u]sing e-mails for alert messages was well known in the art.” *Id.* citing Ex. 1001, 1:50-51; Ex. 1013, 3:14-28; Ex. 1015, ¶ [0009]. First, when discussing the DAS, the ‘765 Patent at column 1, lines 50-51 distinguishes an “alert” from an “email” and does not equate the two forms. *See also id.* at 1:19-24. Second, the Petition’s reliance on Exhibit 1013 and Exhibit 1015 to prove that a POSITA would understand the e-mail in Dillon to necessarily or inherently be an “alert” fails.

Exhibit 1013 merely states that e-mail is among several other forms of emergency alerts that are “possible.” A PHOSITA would not consider that the reference’s mere mention of e-mail transmission is inherently a disclosure of an “alert” message. Exhibit 1015 discloses that the “alert message” can be “displayed as at least one of a web feed, an email, and a text message with associated data,” but even that statement does not say the “alert message” *is* an email. There is simply nothing in the prior art that would teach, disclose, or suggest that the e-mail transmissions in Dillon necessarily must be “alert messages” as required by the Challenged Claims or that they are displayed on the subscriber terminal 12 in “instant message format” according to Claim Limitation [1.12]. *Par Pharmaceutical, Inc. v. TWi Pharmaceuticals, Inc.*, 773 F.3d 1186, 1195-96 (Fed.

Cir. 2014) (“A party must, therefore, meet a high standard in order to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis—the limitation at issue necessarily must be present, or the natural result of the combination of elements explicitly disclosed by the prior art.”)

B. DILLON’S E-MAIL SERVER DOES NOT GENERATE “ALERT ID NUMBERS”

For at least the reasons stated above, Dillon’s e-mail server 12 cannot generate “alert ID numbers,” because it does not store “alert messages.” In Dillon’s system polling messages are sent by the front end computer 28, not email server 12. Ex. 1005, 6:27-38, 7:30-36. Petitioner asserts that the “time stamps” of Dillon are the “alert ID numbers.” But the Petitioner is again mistaken. The “time stamps” disclosed in Dillon are associated with the e-mail service subscriber and more particularly uniquely identifies a particular e-mail message received by the e-mail server 12 for the given e-mail alert service subscriber....” Ex. 1005, 7:15-29. Unlike an alert ID that is associated with a particular “alert message” for all users of the claimed alert messaging system, Dillon’s “time stamps” are never associated with anyone other than one user of its e-mail system, making every time stamp a unique identifier that has to be continuously polled by the front-end computer 28 and matched to the particular subscriber terminal 18 to which the time stamp (and consequently, the e-mail message) is associated.

Therefore, Dillon's reliance on time stamps associated with the subscriber terminals fails to teach, disclose, or suggest the "alert ID numbers" of claim elements [1.3, 1.5].

C. DILLON DOES NOT DISCLOSE CLAIM ELEMENTS [1.4], [4.0], [5.0], [6.0], [7.0], [8.0], AND [10.6]

1. Dillon does not disclose a "first triggering step" but only conventional email polling.

Dillon proposes a front-end computer 28 that polls the e-mail server 12 via a high-speed LAN connection 31 to determine whether e-mail has been received for a particular service subscriber operating from a subscriber terminal 18. *Id.* at 3:36-45; Fig. 2. The front-end computer 28 polls the e-mail server 12 continuously, but at potentially variable intervals, to determine whether any of the various subscribers using a subscriber terminal network (22, 24, 26, 28) has a received email, and if so, transmit the email to that particular subscriber/recipient. *See id.* at 4:6-65. Dillon's use of front-end computer 28 to poll the email server for new emails is the same email polling architecture discussed and distinguished by the '765 Patent. *See* '765 Patent, 3:11-16 ("Polling models are commonly used for checking email..."); 4:14-19 ("The response to a remote method call has no explicit restrictions on size, but if large amounts of data per request are being passed to or from the server, this messaging architecture may be problematic. While polling architectures have been widely adopted, as the scaling increases, the performance of the system may be adversely affected.")

Nowhere does Dillon disclose the front-end computer 28 initiating a “triggering” step that is distinguishable from any other polling operation.

2. Dillon does not disclose a “triggering step” that makes “use of an HTTP packet ...said packet comprises approximately 20 bytes...”

The Petition admits that Dillon does not disclose the use of an HTTP packet whatsoever. The Petition makes the conclusory assertion that because HTTP was a “known computer communication protocol,” that “a POSITA would understand that AAPA’s admission of HTTP as known protocol would also include using an HTTP packet comprising a request.” Pet. at 32. The Petition offers *nothing* to explain why or how a POSITA would choose to use HTTP packets as part of a *polling* request or an HTTP GET request from a client to a server in Dillon as opposed to any other form of message using any other computer communications protocols (e.g., SOAP, RPC, RPC/UDP, RPC/TCP). *Eli Lilly v. Zenith Goldline Pharm.*, 471 F.3d 1369, 1380 (Fed. Cir. 2006) (“to establish a prima facie case of obviousness based on a combination of elements in the prior art, the law requires a motivation to select the references and to combine them in the particular claimed manner to reach the claimed invention”); *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1361 (Fed. Cir. 2011) (“When a field is “unreduced by direction of the prior art,” and when prior art gives “no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful,” an invention is not obvious to try.”)

The Petition fails to make out even the most basic argument that an HTTP polling request from a client to a server would have been “obvious to try” in Dillon or the DAS. As of the earliest effective filing date, the evidence supports that alert messaging systems, like the prior art DAS, used SOAP protocol for polling for alert messages, *not* HTTP.

The Petition’s next leap in logic comes by way of its assertion that not only would the POSITA understand that it *could* use HTTP in Dillon’s or the DAS’ polling protocol for a triggering step, which is not the standard for obviousness, but this same POSITA also some-how knows to use an HTTP packet that is approximately 20 bytes in size. *See* Pet. at 32-34. This entire analysis in the Petition is merely hindsight reconstruction of the Challenged Claims using their limitations as a roadmap to which disparate pieces of unrelated references can be attached to make out an obviousness argument. The Petition’s citation to §8.1 in Exhibit 1010, §9.3 in Exhibit 1011, and the entire 42 paragraphs of Exhibit 1023 does not provide any explanation, let alone an acceptable obviousness rationale for how a POSITA would divine the specific GET message presented on page 33 of the Petition. *See* 37 C.F.R. §42.22(a) (petition must include a full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence). While the Petition alludes to a generalized desire to reduce computer communication overhead, it does not specify a particular starting size or ending size for any particular type of computer communication and it does not

specify using this reduced computer communication overhead for a “triggering” step. Petitioner’s reliance on “routine optimization” case law is inapposite because it is premised on speculation over what the starting communication overhead is and fails to articulate how the POSITA would arrive at the claimed HTTP packet size other than through hindsight. *In re Stepan Co.*, 868 F.3d 1342, 1346 (Fed. Cir. 2017) (“Absent some additional reasoning, the Board’s finding that a skilled artisan would have arrived at the claimed invention through routine optimization is insufficient to support a conclusion of obviousness.”)

Therefore, there is no evidence in the Petition to indicate that Dillon would motivate a POSITA to select an HTTP packet, or an HTTP packet of the claimed size that achieves the claimed “comprising a request for a Boolean value relating to whether there are new alerts as recited in [1.4]. The Board should “resolve all vagueness and ambiguity in Petitioner’s arguments against the Petitioner.” *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, Case CBM-2012-00003, Paper 8 at 10 (PTAB Oct. 25, 2012); *see also Dominion Dealer Solutions, LLC v. Autoalert, Inc.*, IPR2013-00225, Paper 15 at 4 (PTAB Oct. 10, 2013) (“not the Board’s responsibility to search the record and piece together what may support Petitioner’s arguments.”)

For at least the same reasons stated above, namely the inability to prove what, if any, communications protocol is utilized by Dillon, the Petitioner cannot prove Challenged Claims 4, 5, 6, 7, and 8 unpatentable.

3. The Petition Uses Dillon’s “Time Stamp” to Satisfy Two Unique Claim Limitations

According to the Petition, Dillon’s disclosure of a “time-stamp [that] could...be a repeatable value, such as a binary (e.g., one or zero) indication of whether or not e-mail for an e-mail service subscriber has been received by the e-mail server,” as a “Boolean value.” Pet. at 30. However, the “time-stamp” disclosed with respect to column 4, lines 36-41 of Dillon is merely an alternative of the same “time-stamp” disclosure on which the Petition relies to show the presence of the claimed “alert ID numbers.” *See* Pet. at 28-29.

As discussed *supra*, because “Boolean value” and “alert ID numbers” are unique claim limitations, it is improper to use the same prior art disclosure of a “time stamp” to satisfy two different claim limitations. *See Hopkins Manufacturing Corp. v. Cequent Performance Products, Inc.*, IPR2015-00613, Paper 9 at 11-12 (PTAB Aug. 7, 2015).

D. DILLON FAILS TO DISCLOSE CLAIM ELEMENT [1.5]

In contrast to the “client” computers recited in the Challenged Claims, the alleged “clients” of Dillon (the email subscriber terminals 18) do not poll the alleged “central server” (email server 12) for uniquely time-stamped emails, but instead rely entirely on a separate device and/or software, the front-end computer 28, to do such polling. *See* Ex. 1005, 3:11-25, 36-46; 4:49-54; 6:30-38; 7:30-36; 8:1-5, 34-39, 56-65; Fig. 2. The Petition suggests -- without a single piece of

evidence in the prior art or otherwise -- that a “POSITA would be motivated to install Dillon’s computer program equivalent to the front-end computer on Dillon’s subscriber terminal (i.e., personal computer) to simplify the system design, reduce the number of hardware components, which would be less costly and more efficient.” Pet. at 35. But Dillon never suggests any of the Petition’s self-serving motivations or concerns about reduction in hardware components, cost, or efficiency being related to the front-end computer 28 being separated from the subscriber terminal 18. In fact, the Petition’s unsupported modification conflicts with the Dillon disclosure that between the email server 12 and subscriber terminal 18, the front-end computer 28 could be incorporated into the email server 12 only. *See* Ex. 1005, 3:16-19 (“the front-end computer can be replaced by an equivalent computer program running on the *e-mail server*....”)

Even assuming Dillon’s “alert ID number” could be the same as the “time-stamp” associated with the email received in the e-mail server 12, in Dillon, it is the front-end computer 28 that requests the time-stamp that is then communicated to the subscriber terminal 18 so that it can be compared to the time stamps in the subscriber terminal’s memory 40. *See* Ex. 1005, 4:58-65 (“a subscriber terminal may also include comparing means for comparing a time-stamp received from the front-end with the latest time-stamp stored in the time-stamp memory and for providing to the e-mail alert service subscriber an indication that e-mail for the e-mail alert service subscriber has been received by the e-mail server if the received

time-stamp differs from the latest time-stamp.”); 8:66 – 9:12 (“As illustrated by FIG. 2, the subscriber terminal 18 determines, based on each e-mail notification it receives from the front-end computer 28, whether e-mail for a subscriber has been received by the e-mail server 12. To do so, the subscriber terminal 18 includes a time-stamp memory 40 for storing a ‘latest’ time-stamp which the subscriber terminal 18 most recently received in an e-mail notification from the front-end computer 28 for the e-mail alert service subscriber. The comparison of the time-stamp received from the e-mail server 12 with the most recently received or ‘latest’ time-stamp stored in the time-stamp memory 40 of the subscriber terminal 18 is then made by the processor 34 or other suitable comparing means provided at the subscriber terminal 18.”)

Thus, unlike what is recited in Claim Limitation [1.5], Dillon’s subscriber terminal 18 cannot meet the claimed “client” limitation or the instant limitation [1.5] because that terminal 18 neither contacts the alleged “central server” (the e-mail server 12) nor requests the value of any alert ID number (Petitioner’s position is that this alert ID number is the time stamp for an email) from the e-mail server 12. According to the Petition, each of these functions are performed exclusively by the front-end computer 28 independently or potentially as part of the e-mail server 12 itself in the form of software.

Further, Dillon fails to disclose how the time stamp reflects the number of alert messages received by the email server. The fact that “the time-stamp stored

in the subscriber account memory of the e-mail server is updated each time e-mail for the e-mail service subscriber is received,” does not necessarily mean that the time-stamp “reflects the number of alert messages received by the email server.” Thus, this one-line disclosure from Dillon does not expressly or inherently disclose this portion of the Claim Limitation [1.5]. See Par Pharm., 773 F.3d at 1195-96.

E. DILLON FAILS TO DISCLOSE CLAIM ELEMENT [1.8]

The Petition asserts that because Dillon teaches “subscriber terminal 18 detects that the received time-stamp differs from the stored latest time-stamp,” then there is a possibility that Dillon’s disclosures can mean “exceed” the latest time stamp. See Pet. at 38. This speculation is impermissible to make out an obvious case *Ex parte Petruska*, Appeal 2017-011159, Application 14/436, 679 (P.T.A.B Sep 11, 2018) (a rejection based on § 103 must rest upon a factual basis rather than speculation. “Where the legal conclusion [of obviousness] is not supported by facts it cannot stand. *citing* In re Warner, 379 F.2d 1011, 1017 (CCPA 1967).) This teaching of possibilities is insufficient to prove what is necessarily present for a POSITA to find the same to be obvious.

F. DILLON FAILS TO DISCLOSE CLAIM ELEMENTS [1.11], [9.0], AND [10.10] BECAUSE IT DOES NOT USE INSTANT MESSAGE FORMATS AND ONLY E-MAIL.

The Petition appears to admit that Dillon and the AAPA do not disclose transmission of the alleged “alert message” in “instant message format.” See Pet. at 43-44. This is not surprising since Dillon only concerns transmission of e-mails

and has nothing to do with Instant Message (“IM”) transmissions. The Petition cites a portion of a claim in Exhibit 1015 to argue “it would have been obvious to POSITA to substitute the e-mail of Dillon with instant messages given that both instant messages and emails were known to be interchangeable in the context of alert messages.” *Id.* at 43. Despite what a published, non-issued claim 25 may have recited in Exhibit 1015, that exhibit makes clear that an IM can be “attached” to an email, which suggests that an IM is separable from and ***not interchangeable*** with e-mail². *See* Ex. 1015 at ¶ [0042].

For at least the same reasons stated above, the specifics of the IM required by Challenged Claim 9 are similarly not met by Dillon alone or in combination with any other reference.

G. DILLON FAILS TO RENDER CLAIM 2 OBVIOUS

For at least the same reasons discussed in Section D, the alleged “client” computer (Dillon’s subscriber terminal 18) does not poll the email server 12, but instead this is done by the front-end computer 28.

Therefore, Dillon fails to teach, disclose, or suggest each and every limitation of Claim 2 of the ‘765 Patent.

H. NEITHER BRADY NOR DOUGLAS CURE THE DEFICIENCIES OF DILLON AND THE AAPA.

1. Brady and Douglas Are Non-Analogous Art

The Petition suggests that Brady and Douglas are in the same field of “polling systems,” but that is not the relevant field of technology involved in the ‘765 Patent. Indeed, the ‘765 Patent refers to “polling” in many other contexts, but the invention is directed to alert message transmission systems. Therefore, it is the alert messaging system technology that governs the analogous art test to be applied to the Petition.

Neither Brady nor Douglas is directed to alert messaging and their solutions are nothing more than the non-alert messaging standard polling protocols distinguished by the ‘765 Patent. Therefore, neither of these references is properly combinable with Dillon and/or the AAPA.

2. Brady does not disclose a “triggering” step as required by the Challenged Claims.

The Petition relies on ¶¶ [0028] and [0053]-[0057] of Brady to suggest that it would have been obvious to use an HTTP triggering step in Dillon or the AAPA. *See* Pet. at 67.

The HTTP polling involved in Brady relates to refreshing web pages of on-demand database services, which Brady defines as “a database system that is made available to outside users that do not need to necessarily be concerned with building and/or maintaining the database system.” *See* Ex. 1008, ¶ [0025]. Thus, the Brady’s

HTTP polling does not otherwise have any of the other features required by the Challenged Claims to meet the “triggering step” limitation, namely, the request for Boolean value or a packet of approximately 20 bytes. The Petition does not articulate a rationale for why Brady’s HTTP polling would be used in Dillon, even assuming it disclosed the claimed features (which it does not).

3. Douglas fails to disclose a “triggering” step.

Douglas discloses conversion of its nodes from pull messaging technology to “more efficient ‘push’ messaging technology.” Given that polling by the client is a pull messaging technology, Douglas actually teaches away from a complete polling system and would reject periodic polling for its own hybrid approach disclosed in ¶¶ [0025]-[0032]; Figs. 4-5. For example, Douglas distinguishes periodic polling as disclosed in Dillon in its ¶¶ [0004]-[0005].

X. CONCLUSION

For the foregoing reasons, this Board should find that the Petition has failed

to show unpatentability of the challenged claims of the '765 Patent by the preponderance of the evidence.

Dated: April 7, 2024

Respectfully Submitted,

/s/

Andrew C. Aitken, Reg. No. 36,729

P.O. Box 1810

Wheaton, MD 20915 (301) 537-3299

acaitken@aitkenlawoffices.com

(301) 537-3299

ATTORNEY FOR PATENT OWNER
DESKTOP ALERT INC.

WORD COUNT CERTIFICATION

Pursuant to 37 C.F.R. § 42.24(d), I certify that this Petition contains 6,176 words (excluding the title page, table of contents, table of authorities, table of exhibits, mandatory notices, this certificate, and the certificate of service), as determined by Microsoft Word.

Dated: April 7, 2024

/Andrew C. Aitken/
Andrew C. Aitken, Reg 36,729
Attorney for Desktop Alert Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 21st day of February, 2022, a true and accurate copy of the foregoing *Patent Owner Response* was filed through the Patent Review Processing System and served on the following counsel for Petitioner via email:

Brian M. Koide, Esq. Millen, White Zelano,& Branigan, PC 2200 Clarendon Boulevard, Suite 1400 Arlington, VA 22201 AlertusPTAB@mwzb.com	William Nixon, Esq. Ryan Pool, Esq. Millen, White Zelano,& Branigan, PC 2200 Clarendon Boulevard, Suite 1400 Arlington, VA 22201 AlertusPTAB@mwzb.com
--	--

Dated: April 8, 2024

Respectfully Submitted,

/s/ Andrew C. Aitken

Andrew C. Aitken , Reg. No. 36.729

P.O. Box 1810

Wheaton, MD 20817

Tel.: (301) 537-3299

ATTORNEY FOR PATENT OWNER
DESKTOP ALERT INC.