

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALERTUS TECHNOLOGIES, LLC
Petitioner,

v.

DESKTOP ALERT, INC.
Patent Owner.

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

REPLY TO PRELIMINARY PATENT OWNER RESPONSE

TABLE OF CONTENTS

I.	325(d) DENIAL IS UNWARRANTED.....	1
II.	CLAIM CONSTRUCTION	2
A.	“alert message”.....	3
B.	“alert message cache”	4
C.	“alert ID numbers”	5
D.	“first triggering step”	6
	CERTIFICATE OF SERVICE.....	8

PETITIONER’S EXHIBIT LIST¹

EX-1001	U.S. Patent No. 9,172,765 (“the ’765 Patent”)
EX-1002	Prosecution History of U.S. Patent No. 9,172,765
EX-1003	Declaration of William Henry Mangione-Smith in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,172,765
EX-1004	CV of William Henry Mangione-Smith
EX-1005	U.S. Patent No. 6,067,561 (“ <i>Dillon</i> ”)
EX-1006	U.S. Patent Application Publication No. 2009/0164586A1 (“ <i>Douglas</i> ”)
EX-1007	U.S. Patent Application Publication No. 2005/0038791A1 (“ <i>Ven</i> ”)
EX-1008	U.S. Patent Application Publication No. 2010/0205243A1 (“ <i>Brady</i> ”)
EX-1009	U.S. Provisional Application No. 61/096,617 (“ <i>Brady</i> Provisional”)
EX-1010	Network Working Group, RFC 1945, Hypertext Transfer Protocol—HTTP/1.0 (May 1996) (available at https://www.rfc-editor.org/rfc/rfc1945.txt) (“RFC 1945”)
EX-1011	Network Working Group, RFC 2616, Hypertext Transfer Protocol – HTTP/1.1 (June 1999) (available at https://www.rfc-editor.org/rfc/rfc2616.txt) (“RFC 2616”)

¹ This paper uses **bold font** when quoting claim language of the ’765 Patent and *italic font* for added emphasis and for the names of prior art references. Colored markings on reproductions of Exhibit figures are annotations.

EX-1012	Network Working Group, RFC 5322, Internet Message Format (October 2008) (available at https://www.rfc-editor.org/rfc/rfc5322.txt) (“RFC 5322”)
EX-1013	U.S. Patent No. 8,825,092 B2 (“ <i>Sennett</i> ”)
EX-1014	U.S. Patent Application Publication No. 2005/0039048A1 (“ <i>Tosey</i> ”)
EX-1015	U.S. Patent Application Publication No. 2008/0034114A1 (“ <i>Ducey</i> ”)
EX-1016	Microsoft Corporation, <i>Microsoft Computer Dictionary</i> (5th ed. 2002) (excerpts)
EX-1017	U.S. District Courts—Federal Court Management Statistics—Profiles—During the 12-Month Periods Ending September 30, 2018 Through 2023 (available at https://www.uscourts.gov/statistics/table/na/federal-court-management-statistics/2023/09/30-1)
EX-1018	United States District Court for the District of Maryland, Local Rules (Jul. 1, 2023) (available at https://www.mdd.uscourts.gov/sites/mdd/files/LocalRules.pdf)
EX-1019	Docket, <i>Desktop Alert Inc. v. Alertus Technologies, LLC</i> , No. 8:22-cv-03337-DLB (D. Md.) (printed Jan. 7, 2024)
EX-1020	First Amended Complaint for Patent Infringement, <i>Desktop Alert Inc. v. Alertus Technologies, LLC</i> , No. 8:22-cv-03337-DLB (D. Md. Jun. 2, 2023) ²

² For documents filed in the Litigation (EX-1020—EX-1022), this Petition references page numbers inserted to the bottom left-hand corner of the page (as opposed to page numbering in the filed document itself).

EX-1021	Defendant Alertus Technologies, LLC's Motion to Dismiss, <i>Desktop Alert Inc. v. Alertus Technologies, LLC</i> , No. 8:22-cv-03337-DLB (D. Md. Jun. 22, 2023)
EX-1022	Plaintiff's Opposition to Defendant's Motion to Dismiss and, in the Alternative, Motion for Summary Judgment of No Invalidity Under 35 U.S.C. § 101, <i>Desktop Alert Inc. v. Alertus Technologies, LLC</i> , No. 8:22-cv-03337-DLB (D. Md. Jul. 6, 2023)
EX-1023	Declaration of David H. Crocker in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,172,765
EX-1024	CV of David H. Crocker
EX-1025	Claims Appendix: U.S. Patent No. 9,172,765

I. 325(d) DENIAL IS UNWARRANTED

Patent Owner makes the following erroneous Section 325(d) arguments.

First, Patent Owner fails to apply the controlling two-part test of *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). *See* POPR at 2-3.

Second, under Part 1, the asserted prior art is not the “same” prior art before the Office. While Patent Owner claims without explanation that *Dillon* and *Douglas* are each “identical” to and that *Brady* is “as irrelevant” as prior art before the Office (POPR at 3), Part 1 requires that the art be the “same.” *Dillon*, *Brady*, and *Douglas* were not before the Office previously, Pet. at 4, and thus, not the “same” prior art.

Third, under Part 1, *Dillon*, *Brady*, and *Douglas* are not “substantially the same” prior art before the Office. Contrary to Patent Owner’s suggestion, *Dillon* is not “substantially the same” as *Gorty*. Patent Owner had argued during prosecution that *Gorty* was distinguishable because the “instant message format was absent.” EX-1002 at 153. But *Dillon* discloses or suggests instant message format. Pet. at 43 (citing EX-1005, 9:13-27); *see also* EX-1003, ¶92. Accordingly, *Dillon* is not “substantially the same.” Nor is *Douglas* “substantially the same.” Patent Owner argues that *Douglas* “discloses functionalities (push model)” that were “distinguished.”³ POPR

³ The Challenged Claims do not recite the terms “push” or “push model.”

at 3. But the Petition does not rely on *Douglas* teaching of a “push model,” but relies instead on its disclosure of instant message format. Pet. at 68-70. But as noted above, the Patent Owner distinguished prior art (*Gorty*) for failing to disclose instant message format. EX-1002 at 153. Finally, Patent Owner suggests that *Brady* is cumulative of *Boland*. POPR at 3 (arguing that *Brady* is “as irrelevant and distinguishable ... as was *Boland*”). But *Boland*—according to Patent Owner—was insufficient as a reference because it purportedly lacked a “central server.” EX-1003 at 153. *Brady*, however, discloses a central server—*i.e.*, the polling server. EX-1008, ¶[0010]. Thus, *Brady* is not substantially the same as prior art before the Office.

Fourth, under Part 1, the arguments are not the same or substantially the same as arguments before the Office. It is undisputed that the combinations based on *Dillon*, *Brady*, and *Douglas* were not before the Office previously. Pet. at 4. Moreover, the Office did not apply the AAPA as prior art. *Id.* And the Office did not have the benefit of a POSITA’s knowledge that is reflected in EX-1003, EX-1007, EX-1010—EX-1016. Accordingly, the arguments are not the same or substantially the same. Because Part 1 is not satisfied, the Board need not address Part 2.

II. CLAIM CONSTRUCTION

“[O]nly two exceptions” exist to plain and ordinary meaning: “1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term.” *Thorner v. Sony Computer Ent. Am.*

LLC, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Neither exception applies to the terms.

A. “alert message”

Patent Owner wrongly argues that “**alert message**” “does not mean an e-mail.” POPR at 11.

First, the Applicant did not act as his own lexicographer because he did not “clearly express an intent” to redefine the term. *See Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed.Cir.2008). Here, the two portions of the specification referenced by Patent Owner do not even refer to the claim term “**alert message**,” but instead refer to the words “messages” and “alerts” separately. POPR at 10-11 (citing EX-1001 at 1:19-24, 1:50-51). Moreover, these portions of the specification describe the *prior art* Desktop Alert system, not the claimed invention. EX-1001 at 1:10-2:11 (describing various features of the “legacy” prior art system). Accordingly, the Applicant did not “clearly express an intent” to carve out email from the claim term “**alert message**” as that term is used *in the claims*.

Second, no disavowal of claim scope occurred. Rather than disavowal, the specification describes “**alert message**” broadly as a “prewritten or prerecorded message.” EX-1001 at 3:67-4:2; *see* POPR at 10 (citing same). During prosecution, the Applicant described the “*Gorty email system*.” EX-1002 at 153. If the Applicant truly believed that emails were carved out of “**alert messages**,” then it should have distinguished *Gorty* on that basis. But it did not and instead distinguished *Gorty*

because “instant message format is absent in *Gorty*.” *Id.* The Applicant thus acquiesced to the ordinary meaning of “**alert messages**” as including emails.

Third, even if the two cited portions of the specification were read in the context of “**alert messages**,” they do not carve out emails. For instance, the specification cited by Patent Owner describes “[s]end[ing] [a]lerts to ... e-mail” and “deliver[ing] messages ... to ... e-mail ... devices.” EX-1001 at 1:19-24, 1:50-51. Nothing in these two passages precludes the “alerts” or “messages” from being in email form prior to being sent or delivered to an email device.

B. “alert message cache”

Patent Owner claims that “**alert message cache**” means “a database for storing of ‘**alert messages**’ to be used by a plurality of client computers.” POPR at 11. The only support Patent Owner provides for its construction is reference to five lines in the specification as purportedly demonstrating what “would be understood by [a POSITA].” POPR at 11 (citing EX-1001 at 3:43-48).

First, the cited portion of the specification does not even refer to “**alert message cache**,” “**alert message**,” or “**cache**,” and thus cannot constitute evidence of a clear intent of lexicography or disavowal.

Second, Patent Owner has provided no explanation why the cited portion of the specification constitutes a POSITA’s knowledge. To the extent Patent Owner is suggesting that an “**alert message cache**” must constitute a database or be “used” by

a “plurality of client computers,” that would be nothing more than an improper attempt to import aspects of the preferred embodiments into the claim language.

C. “alert ID numbers”

Patent Owner proposes that “**alert ID number**” is a “value for a particular alert message for the entire system, and not merely a client-specification identification value” and also proposes to restrict “**alert ID number**” to the “number or tally of the alert messages that has been received by the central 1 [sic] server.” POPR at 11-12.

First, Patent Owner points to no lexicography or disavowal by Applicant, and therefore plain and ordinary meaning should apply. Indeed, the phrase “**alert ID number**” does not even appear in the specification (although the words “alertID” and “alertID” do).

Second, to the extent “alertID” is equated to “**alertID number**” as Patent Owner suggests, the specification establishes that the phrase “alert ID” can either be (a) “system wide” (or “global”) or (b) non-system wide or (non-global). In particular, the qualifies one type of “alert ID” as “system-wide.” EX-1001 at 5:2-3. The specification similarly qualifies one type of “alert ID” as “global.” EX-1001 at 6:55. The mere fact that “alert ID” is qualified by the adjective phrases “system-wide” and “global” indicates that the term by itself is not so limited and broader. Patent Owner should not be permitted to import limitations of preferred embodiments into the claims when such limitations are nonexistent in the claim language.

D. “first triggering step”

Patent Owner unexplainably provides multiple alternative definitions for “**first triggering step**”: (a) a “polling call that dictates whether the entire system needs to entertain any polling calls from the clients” and (b) “a condition precedent to the polling and transmission of any queued, unread alert messages.” POPR at 12-13.

First, Patent Owner concedes the existence of an “ordinary meaning” of “**triggering**” as “cause (an event or situation) to happen to exist.” POPR at 13 (no citation).

Second, contrary to Patent Owner’s assertion, the Petition did not “fail[] to give any meaning” to “**triggering**.” POPR at 13. Rather, the Petition *comports with* the Patent Owner’s proposed “ordinary meaning” by noting that “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*.” Pet. at 32 (citing EX-1008, ¶[0055]).

Third, the record lacks any lexicography or disavowal. In the specification, the word “**triggering**” appears only once in the context of “change the client-server protocol to use a format other than SOAP for the ‘triggering’ GetUnreadAlerts call.” EX-1001 at 8:37-38. In that passage, there is no indication (and certainly not a clear indication) that Applicant is acting as his own lexicographer to define “**triggering step**” as Patent Owner now proposes or disavowing any claim scope. Except for its

recitation in the claims and in the specification, the word “**triggering**” is mentioned only in passing in the prosecution history. EX-1002 at 152 (noting that an amendment included a “triggering message step that is transmitted in HTTP [sic].”). Accordingly, there is no disavowal.

Fourth, Patent Owner is wrong to assert that the “**triggering**” step should be construed as a “condition precedent to the polling and transmission of any queued, unread alert messages.” POPR at 13. “[A]lthough a method claim necessarily recites the steps of the method in a particular order, as a general rule the claim is not limited to performance of the steps in the order recited, unless the claim explicitly or implicitly requires a specific order.” *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1345 (Fed. Cir. 2008). Here, the “**triggering step**” recites “**use of a HTTP packet comprising a request for a Boolean value relating to whether there are new alert messages.**” EX-1001, claim 1 and 10. But the “**Boolean value**” is *never subsequently recited* in the claims 1 and 10 or any of the dependent claims. In particular, in the second through fifth steps ([1.5]-[1.8]), occur independent of the “**Boolean value.**” Thus, the “**triggering**” step is untethered to the remaining claim language, and, accordingly, there is no express or implicit requirement that the “**triggering**” step be a “condition precedent” as Patent Owner claims. *See* POPR at 13.

Dated: May 6, 2024

Respectfully submitted,
By: /s/ Brian M. Koide
Brian M. Koide (Reg. No. 41,123)
Lead Counsel

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on May 6, 2024, an electronic copy of the foregoing Reply to the Preliminary Patent Owner Response was served via the P-TACTS system, to Patent Owner's counsel at the following addresses identified in the Petition's consent to electronic service:

Lead Counsel:

Joseph A. Farco, Reg. No. 59,139
jfarco@norris-law.com

Back-up Counsel:

Andrew C. Aitken, Reg. No. 36,729
acaitken@yahoo.com

By: /s/ Brian M. Koide /
Brian M. Koide (Reg. No. 41,123)