

Filed on behalf of Desktop Alert Inc.

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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

PATENT OWNER'S RESPONSE TO PETITIONER'S REPLY

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I. INTRODUCTION

In IPR proceedings it is Petitioner's burden and obligation to include "[a] full statement of the reasons for relief requested, including a detailed explanation of the significance of the evidence including material facts," 37 C.F.R. § 42.22(a)(2), which must include a statement of "[h]ow the challenged claim is to be construed" and "[h]ow the construed claim is unpatentable." *Id.* § 42.104(b)(3)-(4). In view of the "expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute." *Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). "Failure to prove the matter as required ... means that the party with the burden of persuasion loses on that point—thus, if the fact trier of the issue is left uncertain, the party with the burden [the petitioner] loses." *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015). If a petition fails to adequately specify how the cited prior art aligns with each of the claimed elements as interpreted by the Petitioner, the Petitioner will fail to meet its burden. *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1341 (Fed. Cir. 2020)

Unsatisfied with its initial efforts, Petitioner requested permission to address claim constructions adopted by the Patent Owner or implicit in its reply which Petitioner contended were both unanticipated and presumably material to its

Petition. The Patent Owner consented to the request on the premise that Petitioner's reply would advance arguments supporting its position that, when the claims were properly construed, the prior art it has cited renders the claims obvious.

However, Petitioner's Reply first repeats and summarizes the arguments in its Petition and improperly replies to Patent Owner's arguments that are completely unrelated to the claim construction issues. It is submitted that this portion of the Reply should be stricken. Petitioner proceeds to identify four claims terms discussed by the Patent Owner in its Reply that Petitioner disputes but it fails to offer any alternative construction¹. Moreover, the Reply fails to logically establish how, after these claim elements when construed according to its phantom position, the prior art renders the claims obvious. Other arguments advanced in Petitioner's Reply are inconsequential or incorrect as a matter of law.

II. The Disputed Claim Terms

A. The "*Alert Message*" Claim Term.

Petitioner first disputes the Patent Owners' construction of the term "alert message." The term "alert message" is defined in the Patent Specification as "as a prewritten or prerecorded message stored in the dynamic information database for subsequent use by the administrator. '765 Patent, 3: 67 - 4:2. Petitioner does not

¹ It is Petitioner's burden to construe the claim terms. 37 C.F.R. § 42.22(a)(2),

provide an ordinary meaning to the term nor has it offered any meaning of the term at all.

While the Petitioner does not provide a proposed construction, it suggests the term “alert message” can include messages in email format. However, in both claims 1 and 10, the term “alert message” is further limited to be in “Instant Message” format upon reception of the unread alert messages in the sixth step of the claimed method. As such, the claim language itself contradicts Petitioner’s contention on reply.

Consequently, during the prosecution the Patent Owner’s distinction of Gorty system was accurate, because Gorty email server system did not teach, disclose, or contemplate its email system as an alert messaging system that delivered instant messages. The first claim construction dispute raised by Petitioner is both illusory and inconsequential to the Petitioner’s request for IPR.

B. The “Alert Message Cache” Claim Term

Petitioner next disputes the Patent Owner’s interpretation of “Alert Message Cache.” The term “Alert Message Cache” was interpreted by Patent Owner according to its use in the specification when discussing the method recited of claim 1. Petitioner’s brief did not provide a definition for this term nor did it ascribe a customary and ordinary meaning.

However, the analysis and arguments in Petitioner’s brief are devoid of any mention of the claim term “Alert Message Cache.” Further Petitioner’s Reply does not explain why it was unfairly surprised by Patent Owner’s discussion nor does it explain how the term’s construction by the Patent Owner in some way affects its invalidity arguments. Rather than use its reply to properly propose a different claim construction, Petitioner’s non-response leaves the Board with only one construction – that of Patent Owner.

C. The “Alert ID Numbers” Claim Term.

Independent claim 1 recites the use of an “alert ID number” in the claimed method of improved the dissemination of alert messages. (Claim 10 refers to an “alert ID value.”) Petitioner did not provide a proposed claim interpretation for the term “alert ID number” in its Petition nor in its latest Reply. In the Patent Owners’ Preliminary Response, Patent Owner described the “alert ID number” as *inter alia* 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. *See also* Preliminary Response by Patent Owner, pp. 11-12. The term is also used in the abstract which describes the steps of the invention. The Patent Owner interpretation of the term number is in accordance with its ordinary meaning. The ‘752 Patent described that the “alert Id” as having a “value” which is consistent with the Patent Owner’s construction.

Petitioner disputes Patent Owner's interpretation because the term "alert ID" can be "system wide" or "non-system wide" which, it further argues suggests that the term "is not so limited and broader [sic]." First, Petitioner does not explain whether the "alert ID number" being used "system wide" or "non-system wide" changes Patent Owner's arguments or supports Petitioner's arguments in these proceedings. Further, Petitioner fails to explain how its proposed interpretation is relevant to the meaning espoused by the Patent Owner. Even assuming the term is "alert ID" is somehow "broader," the term "alert ID" is modified in Claim 1 by the term "number," which necessitates that it be a numeral.

The Petitioner has argued that that Dillion's "time stamp" that is stored in the email server is equivalent to the claimed "alert ID number." But even if the term was construed "broader" as suggested by Petitioner, Dillion's time stamp functions differently than the "alter ID number" as set forth in Claim 1 of the '752 Patent. In this regard, Patent Owner previously explained:

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.

Preliminary Response by Patent Owner, p. 16.

Dillion's time stamp is not an indication associated with all users in an alert messaging system. In contrast, in the claimed system, the value of "alert ID number" reflects the number of alert messages "received by the central server." In other words, the number is a reflection of all of the alert messages in the system, and therefore patently distinguishes from Dillion. In any event, Petitioner's belated protests with respect to the meaning of the term should have been anticipated and made in its request for IPR.

D. The "Triggering Step" Claim Term.

Like the previous terms, Petitioner did not provide a proposed interpretation of the term "triggering" in its Petition or Reply. The disagreement between the parties centers on whether the "first triggering step" must be performed before (i.e., is a condition precedent to) all subsequent steps in the claims.

Both claims 1 and 10 of the '752 Patent both recite: "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."

As a general tenant of claim construction, Petitioner is correct that not all method claims require steps to be performed in the order recited. However a claim "requires an ordering of steps when the claim language, as a matter of logic or grammar, requires that the steps be performed in the order written, or the

specification directly or implicitly requires” an order of steps. *Mformation Technologies, Inc. v. Research in Motion Limited*, 764 F.3d 1392, 1398-99 (Fed. Cir. 2014) *citing* *TALtech Ltd. v. Esquel Apparel, Inc.*, 279 F. App’x 974, 978 (Fed. Cir. 2008); *see also* *Function Media, LLC v. Google, Inc.*, 708 F.3d 1310, 1320 (Fed. Cir. 2013) (concluding that a claim that recites “processing” an “electronic advertisement” necessarily indicates that “the creation of the ad must happen before the processing begins”).

The ‘752 Patent’s triggering step requires the use of the Boolean value to initiate the claimed method and uses the Boolean value in a call to the server to determine if there are new alert messages. The result of the inquiry is sent back to the client is also a simple Boolean true or false answer. If true is returned, the client makes the GetUnreadAlerts call to the server. See ‘765 Patent, 8:35-52. Accordingly, logic and necessity require the creation and transmission of the Boolean value before the initial call is made to determine if the server has new alert messages. Moreover, the claim language itself recites the terms “a first triggering step” and related “second step.” To the extent one can understand Petitioner’s reply arguments related to this limitation, any interpretation of the claims that allows the actions associated with the “first triggering step” to take place other than “first,” conflicts with the claim language as recited and renders the word “first” and “triggering” in the claims a nullity. " *See Power Mosfet Techs., LLC v. Siemens AG*,

378 F.3d 1396, 1410 (Fed. Cir. 2004) ('[Interpretations that render some portion of the claim language superfluous are disfavored.]')

Petitioner's contention that recited steps can be performed in any order is incorrect.

Dated May 13

Respectfully submitted,
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