

**From:** [Trials](#)  
**To:** [Brian M. Koide](#); [Trials](#)  
**Cc:** [acaitken@yahoo.com](#); [Joseph Farco, Esq.](#); [acaitken@aitkenlawoffices.com](#); [AlertusPTAB](#)  
**Subject:** RE: IPR2024-00363: Alertus Technologies, LLC v. Desktop Alert, Inc. (alertus-0004-x)  
**Date:** Tuesday, June 11, 2024 1:36:44 PM

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Counsel,

From the Board –

Petitioner’s email is unclear and does not identify any specific questions. The statement in Patent Owner’s brief (Paper 8) is not—and will not be treated as—a motion to strike. See 37 C.F.R. § 42.20(a), (b) (“Relief, other than a petition requesting the institution of a trial, must be requested in the form of a motion,” which “will not be entered without Board authorization.”). However, if the Board determines that a brief includes improper arguments, it has the independent authority to disregard those arguments. Any substantive arguments in Petitioner’s June 3<sup>rd</sup> email will not be considered by the panel.

Counsel is cautioned that official correspondence will be sent by the Board to the email address on file in P-TACTS. For assistance with updating this information, please consult the P-TACTS FAQs, available at [https://www.uspto.gov/sites/default/files/documents/p-tacts\\_faqs\\_20240404.pdf](https://www.uspto.gov/sites/default/files/documents/p-tacts_faqs_20240404.pdf).

Regards,

Esther Goldschlager  
Supervisory Paralegal Specialist  
Patent Trial & Appeal Board  
U.S. Patent & Trademark Office

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**From:** Brian M. Koide <bkoide@mwzb.com>  
**Sent:** Monday, June 3, 2024 2:42 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** [acaitken@yahoo.com](#); [Joseph Farco, Esq.](#) <jfarco@norris-law.com>; [acaitken@aitkenlawoffices.com](#); [AlertusPTAB](#) <AlertusPTAB@mwzb.com>  
**Subject:** IPR2024-00363: Alertus Technologies, LLC v. Desktop Alert, Inc. (alertus-0004-x)

**CAUTION:** This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Honorable Board:

As counsel for Petitioner, we write to seek guidance from the Board on an issue that we have been unable to resolve despite repeated efforts to obtain a substantive response Patent Owner’s counsel.

1. On April 29, 2024, the Board entered an Order authorizing Petitioner to “file a seven-page reply, limited to addressing the claim construction and § 325(d) arguments raised in the POPR.” Paper 6 at 2.
2. On May 6, 2024, Petitioner filed and served a Reply to the Preliminary Patent Owner

Response (Paper 7) as authorized by the Board's Order (Paper 6).

3. On May 13, 2024, Patent Owner filed a Patent Owner's Response to Petitioner's Reply (Paper 8) as authorized by the Board's Order (Paper 6). Patent Owner's Response included the following statement:

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.

Paper 8 at 2.

4. On May 15, 2024, counsel for Petitioner emailed both lead and backup counsel for Patent Owner seeking clarification on the above-listed statement and noting that the statement was inaccurate. The email was sent to backup counsel's email address of record ([acaitken@yahoo.com](mailto:acaitken@yahoo.com)) and lead counsel's email address. See attached email string.
5. On May 20, 2024, having received no response from Patent Owner's lead or backup counsel, counsel for Petitioner followed up by email asking for a response. Again, the email was sent to backup counsel's email address of record ([acaitken@yahoo.com](mailto:acaitken@yahoo.com)). See attached email string.
6. Later that same day, backup counsel for Patent Owner sent an email to lead counsel for Petitioner only from the [acaitken@yahoo.com](mailto:acaitken@yahoo.com) address and not copying other counsel of record stating:

I overlooked your message last week as the Patent Office has required me to use my Yahoo email account for IPR correspondence which is primarily full of junk mail. Please copy my [acaitken@aitkenlawoffices.com](mailto:acaitken@aitkenlawoffices.com) address in the future.

In any event, I have been out of the office and retuned today. I will review your email and respond later in the week as I have a hearing on Wednesday for TRO and need to prepare for this matter as well as file a motion in the Federal Circuit today.

See attached email string.

7. After receiving the email from Patent Owner's backup counsel, Petitioner's lead counsel emailed Patent Owner's backup counsel (at both his official and unofficial email addresses) and lead counsel noting that (a) lead counsel Mr. Farco has not articulated any reason for failing to respond and (b) asking for a response by COB on May 22, 2024.
8. Both the requested date to respond (May 22, 2024) and the date Patent Owner's backup counsel indicated he would respond (May 24, 2024) have passed without any response from Patent Owner's lead or backup counsel.
9. Petitioner's counsel apologizes to the Board for raising this matter, but the lack of response from Patent Owner's lead counsel and failure to respond as promised by Patent Owner's backup counsel has left Petitioner with no recourse. Petitioner believes that the above-quoted statement in Paper 8 is inaccurate and an inadequate basis to strike. Petitioner's counsel has diligently attempted to resolve this matter and/or seek clarification from Patent Owner's counsel as noted above. Petitioner seeks to bring attention to the Board that Patent Owner has not been able to justify its position and failed to respond to Petitioner's emails. Should the Board deem a hearing necessary, Petitioner's counsel is available on the following days and times:

June 4: 9 am – 5pm Eastern  
June 5: 9 am – 5 pm Eastern  
June 7: noon – 5 pm Eastern

Best regards,

Brian M. Koide  
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