

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALERTUS TECHNOLOGIES, LLC,
Petitioner,

v.

DESKTOP ALERT, INC.,
Patent Owner.

IPR2024-00363
Patent 9,172,765 B2

Before MICHELLE N. WORMMEESTER, JULIET MITCHELL DIRBA,
and ANDREW L. NALVEN, *Administrative Patent Judges*.

NALVEN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Alertus Technologies, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–13 of U.S. Patent No. 9,172,765 B2 (Ex. 1001, “the ’765 patent”). Desktop Alert, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 5, “Prelim. Resp.”). With our authorization (Paper 6), Petitioner filed a Reply to the Preliminary Response (Paper 7, “Pet. Reply”) and Patent Owner filed a Response to the Reply (Paper 8, “PO Resp. to Reply”).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in demonstrating the unpatentability of any of the challenged claims. Accordingly, we do not institute an *inter partes* review.

II. BACKGROUND

A. Real Parties-in-Interest

Petitioner identifies Alertus Technologies, LLC, Jason A. Volk, the Volk Family Delaware Dynasty Trust I, and the Volk Family Delaware Dynasty Trust II as real parties-in-interest. Pet. 2. Patent Owner identifies only Desktop Alert, Inc. as a real party-in-interest. Paper 4, 2 (Patent Owner’s mandatory notices).

B. Related Proceedings

The parties identify the following related case: *Desktop Alert, Inc. v. Alertus Technologies, LLC*, No. 8:22-cv-03337-DLB (D. Md.). *See* Pet. 2; Paper 4, 2.

C. The '765 Patent

The '765 patent describes a polling-based secure network message notification system for a group of clients communicatively coupled to a server over a network. Ex. 1001, code (54), 3:33–36. In particular, the message notification system allows dissemination of alert messages to a plurality of personal computers. *Id.* at Abstract. According to the '765 patent, the disclosed invention provides an increase in efficiency and decreased load on the servers over prior systems. *Id.* at 8:53–61.

The '765 patent explains that “[w]hile polling architectures have been widely adopted, as the scaling increases, the performance of the system may be adversely affected.” *Id.* at 4:17–19. To address this issue, the '765 patent describes methods of improving the performance issues raised by large numbers of clients repeatedly polling a server for unread alerts by adding a new polling request before the conventional polling requests. *Id.* at 1:10–12, 6:26–42, 8:35–52. Specifically, the '765 patent describes adding a new polling request using a different format than typical polling requests that use the Simple Object Access Protocol (SOAP). *Id.* at 8:35–41, 8:62–66. Because “SOAP is relatively heavy-weight protocol with an unfortunate amount of overhead,” performance is improved by “chang[ing] the client-server protocol to use a format other than SOAP for the ‘triggering’ GetUnreadAlerts call.” *Id.* at 8:38–41. The '765 patent describes the polling call as an IsNewAlerts polling call that is “a tight HTTP packet

. . . [of] approximately 20 bytes of payload,” that does not use the SOAP protocol. *Id.* at 8:41–47, 10:9–10. In operation, a client device sends a IsNewAlerts polling call to a server and the server responds with a Boolean value of true or false. *Id.* at 8:41–43. If the Boolean returns as true, the client makes the existing GetUnreadAlerts calls. *Id.* at 8:44–45. The ’765 patent explains that when new alerts are received, “an alert is transmitted to the client in instant message format that opens a window on the display panel at the client station.” *Id.* at 4:3–6.

D. Illustrative Claim

Petitioner challenges claims 1–13 of the ’765 patent, where claims 1 and 10 are independent claims. Claim 1 is illustrative of the claimed invention and is reproduced below.

1. An improved method for the dissemination of an alert message to a plurality of personal computers using a network communications protocol, said computers comprising clients, each said clients subscribing to a central server, said server comprising an alert message cache, said server adapted to receive and store alert messages, and said server adapted to generate and store alert ID numbers, said method comprising,
 - 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,
 - a second step wherein said client contacts the central server and requests the value of said alert ID number in said memory, said value reflecting the number of alert messages received by said central server,
 - a third step wherein said server transmits said value to said client,
 - a fourth step wherein said client compares a stored value at the client with the value of the transmitted alert ID number, and

if said transmitted value exceeds said stored value, a fifth step wherein said client transmits a second message to said server and requests for the server to transmit all unread alert messages in a GetUnreadAlerts request from said server that are specific to said client, and

if there are unread alert messages specific to said client in said server, a sixth step wherein said server sends to client all unread alert messages specific to the client, and,

a further step wherein said client updates the stored value in its memory to reflect the number of additional unread alert messages transmitted from said server to said client in response to said second message, and

wherein, 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,

wherein said communications protocol comprises protocols for the transmission of messages over the internet.

Ex. 1001, 12:37–13:8.

E. Asserted Challenges to Patentability

Petitioner asserts four challenges to claims 1–13 of the '765 patent as follows. Pet. 8–9, 15–72.

Claims Challenged	35 U.S.C. § ¹	References/Basis
1–13	103(a)	Dillon, ² Applicant Admitted Prior Art (“AAPA”) ³

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the '765 patent issued was filed before this date, the pre-AIA version of § 103 applies.

² Dillon, U.S. Pat. No. 6,067,561, issued May 23, 2000 (Ex. 1005).

³ Petitioner points to certain passages of the '765 patent’s specification as applicant admitted prior art (Pet. 17–20), and we understand Petitioner to contend that these passages are evidence of the general knowledge of an ordinarily skilled artisan (*see id.* at 9 n.5 (citing USPTO, Updated Guidance

Claims Challenged	35 U.S.C. § ¹	References/Basis
1–13	103(a)	Dillon, Brady, ⁴ AAPA
1–13	103(a)	Dillon, Douglas, ⁵ AAPA
1–13	103(a)	Dillon, Brady, Douglas, AAPA

In support of its challenges, Petitioner relies on a Declaration of William Henry Mangione-Smith, Ph.D. (Ex. 1003).

III. DISCUSSION

A. Principles of Law

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a

on the Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews Under § 311 (June 9, 2022), *available at* https://www.uspto.gov/sites/default/files/documents/signed_aapa_guidance_memo.pdf). Although we refer to these passages as “AAPA” in this Decision for clarity, we have not evaluated whether these passages constitute admitted prior art or evidence the general knowledge of an ordinary artisan.

⁴ Brady, U.S. Publ’n No. 2010/0205243 A1, published Aug. 12, 2010 (Ex. 1008).

⁵ Douglas et al., U.S. Publ’n No. 2009/0164586 A1, published June 25, 2009 (Ex. 1006).

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. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

At this preliminary stage, we determine whether the information presented shows a reasonable likelihood that Petitioner would prevail in establishing that at least one of the challenged claims would have been unpatentable over the asserted prior art. We consider Petitioner's asserted challenges with the above-noted principles in mind.

B. Claim Construction

In an *inter partes* review proceeding, we construe a claim of a patent “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b). That standard involves construing claims in accordance with the ordinary and customary meaning of such claims as would have been understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc).

Petitioner asserts that several claim elements lack antecedent basis and identifies its assumed understandings for those elements. Pet. 5–7. Petitioner further proposes a construction for “Get Alert Messages,” in claim

10 and “said client displays, display said alter messages,” in claim 12. *Id.* at 7–8. Patent Owner proposes a construction for the terms “alert message,” “alert message cache,” “alert ID numbers,” and “a first triggering step.” Prelim. Resp. 10–14.

Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). After reviewing the record, we determine that only the term “a first triggering step” requires express construction for purposes of this Decision.

1. “a first triggering step”

Both independent claims 1 and 10 recite a “first triggering step.” Patent Owner contends that the word “triggering” has an ordinary meaning of to “cause (an event or situation) to happen or exist.” Prelim. Resp. 13. From this, Patent Owner argues “the ‘triggering’ step precedes any other activity between clients and server in the system.” *Id.* Patent Owner further asserts that the “first triggering step” “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.” *Id.* at 12–13 (citing Ex. 1001, 7:12–28, 8:35–52). In other words, Patent Owner argues that the ’765 patent requires a “first triggering step” to be “a new polling call” that precedes pre-existing polling calls to obtain unread message alerts. *Id.* at 12 (citing Ex. 1001, 8:35–52); *see also* PO Resp. to Reply 7.

In response, Petitioner argues that the record does not provide any clear lexicography or disavowal to support Patent Owner’s asserted claim

construction. Pet. Reply 6–7. Petitioner contends that the ’765 patent only uses the term “triggering” once, and fails to provide any clear indication defining a triggering step as either “(a) a ‘polling call that dictates whether the entire system needs to entertain any polling calls from the clients’ or (b) ‘a condition precedent to the polling and transmission of any queued, unread alert messages.’” *Id.* (citing Prelim. Resp. 12–13; Ex. 1001, 8:37–38).

Petitioner further contends that the claim language similarly fails to support Patent Owner’s position. *Id.* at 7. Specifically, Petitioner contends that the “triggering step” recites “use of a HTTP packet comprising a request for a Boolean value relating to whether there are new alert messages,” but the “‘Boolean value’ is never subsequently recited in the claims 1 and 10 or any of the dependent claims.” *Id.* Consequently, Petitioner asserts that the first triggering step is untethered to the remaining claim language. *Id.* Further, Petitioner argues 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.*” *Id.* at 6 (citing Pet. 32; Ex. 1008 ¶ 55). In other words, “triggering” merely means to “cause (an event or situation) to happen to exist.” *Id.* (citing Prelim. Resp. 13).

Patent Owner replies that “[t]he 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.” PO Resp. to Reply 6. Patent Owner also argues that, while “not all method claims require steps to be performed in the order recited,” the Specification and the claim language both demonstrate that the “first triggering step” occurs first and triggers the other claimed steps. *Id.* at 6–7.

On this record, we agree with Patent Owner that the claimed “first triggering step” must precede the subsequent steps in the claim. In light of that determination, we need not address whether “a first triggering step” includes other requirements to determine whether Petitioner has satisfied its burden of demonstrating a reasonable likelihood of prevailing. *See Nidec Motor Corp.*, 868 F.3d at 1017.

First, claim 1 recites “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,” “a second step wherein said client contacts the central server and requests the value of said alert ID number . . . reflecting the number of alert messages,” and “a fifth step wherein said client transmits a second message to said server and requests for the server to transmit all unread alert messages.” Ex. 1001, 12:44–45, 12:48–49, 12:57–60. Claim 10 uses slightly different wording and recites “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,” “further communication from said client to said server requesting a Get Alert Messages,” and “the client will further request from said server any alert messages . . . and in response to said requests, said server transmits any unread alert messages.” *Id.* at 14:6–10, 14:12–14, 14:16–17.

Although claims 1 and 10 recite slightly different language, both clearly recite a “*first* triggering step” that precedes two subsequent polling steps. In the case of claim 1, the “first triggering step” precedes the “second step” and “fifth step.” *See id.* The explicit use of “second” and “fifth” supports limiting the steps to the recited order. *See Mformation Techs., Inc. v. Research in Motion Ltd.*, 764 F.3d 1392, 1398 (Fed. Cir. 2014) (“[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.” (cleaned up)).

Similarly, in claim 10, the “first triggering step” precedes the “further communication” and “further request.” The recitation of “*further* communication from said client to said server requesting a Get Alert Messages . . . wherein said client is transmitted an Alert ID message value” suggests that the “*further* communication” follows the “*first* triggering step.” Moreover, claim 10 further recites “if said Alert ID message value matches a stored message value, the client will *further request* from said server any alert messages to which it subscribes.” Claim 10’s requirement of a “further request” based on the Alert ID message value suggests that the “further request” follows the “further communication.” Hence, here again, claim 10 supports limiting the steps to the recited order. *See id.*

Furthermore, the ’765 patent specification supports this understanding of the claims. Specifically, the ’765 patent describes improving the performance of the prior art Desktop Alert system by

Chang[ing] the client-server protocol to use a format other than SOAP for the “triggering” GetUnreadAlerts call. In this alternative model, [the] 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.

Ex. 1001, 8:35–61, Figs. 7–8 (*quoted in* Prelim. Resp. 6). That is, “the ‘triggering’ step precedes any other activity between clients and server in the

system.” Prelim. Resp. 13. Consistent with claims 1 and 10, the ’765 patent describes the subsequent polling activity stating, “[a]s the client polls the server it requests the value of the alertID changes . . . if the alertID value has increased since the client last polled the server, the client then requests the unread alerts that are specific to the user.” Ex. 1001, 5:7–13, 12:44–45, 12:48–49, 12:57–60, 14:6–10, 14:12–14, 14:16–17.

Accordingly, on this record, we construe a “first triggering step” as a step that must precede the other steps recited in the claim (e.g., the “second step” of claim 1 and the “further communication” of claim 10).

C. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art (“POSITA”) “would have (i) a bachelor’s degree or equivalent in electrical engineering, computer engineering, network engineering, computer science, and/or a related field and (ii) 1-3 years of experience relating to computer and networking systems and/or methods including systems and methods for messaging.” Pet. 4–5 (citing Ex. 1003 ¶¶ 25–26). Patent Owner does not offer a position as to the level of ordinary skill in the art. *See generally* Prelim. Resp.

For purposes of this Decision, we adopt Petitioner’s assessment, which appears consistent with the level of skill reflected in the Specification and asserted prior art.

D. Alleged Obviousness over Dillon and AAPA

Petitioner asserts that claims 1–13 of the ’765 patent would have been obvious over Dillon and AAPA. Pet. 15–65. Patent Owner argues several aspects of Petitioner’s analysis. Prelim. Resp. 10–25. For the reasons explained below, we determine that Petitioner has not demonstrated a

reasonable likelihood of prevailing on its asserted challenge as to claims 1–13.

Before addressing the parties’ arguments, we provide an overview of the asserted reference, Dillon, and AAPA.

1. Overview of Dillon

Dillon describes an electronic mail notification system that uses a network “to transmit electronic mail status information from an electronic mail server to a terminal and to allow electronic mail to be retrieved from the electronic mail server via the terminal.” Ex. 1005, 1:18–23. Dillon addresses the situation where a user’s terminal connects to the Internet using a non-continuous connection such as a dial-up modem or Integrated Services Digital Network (ISDN) connection and notifying an e-mail recipient that they have received e-mail is problematic. *Id.* at 1:50–56. To address this issue, Dillon describes a hybrid network system with a one-way, continuous, high-speed broadcast communication channel to transmit e-mail status information to one or more terminals and a switched communication channel, which may operate at a relatively lower speed. *Id.* at 1:9–18. Figure 2 of Dillon, reproduced below, illustrates the electronic mail notification system.

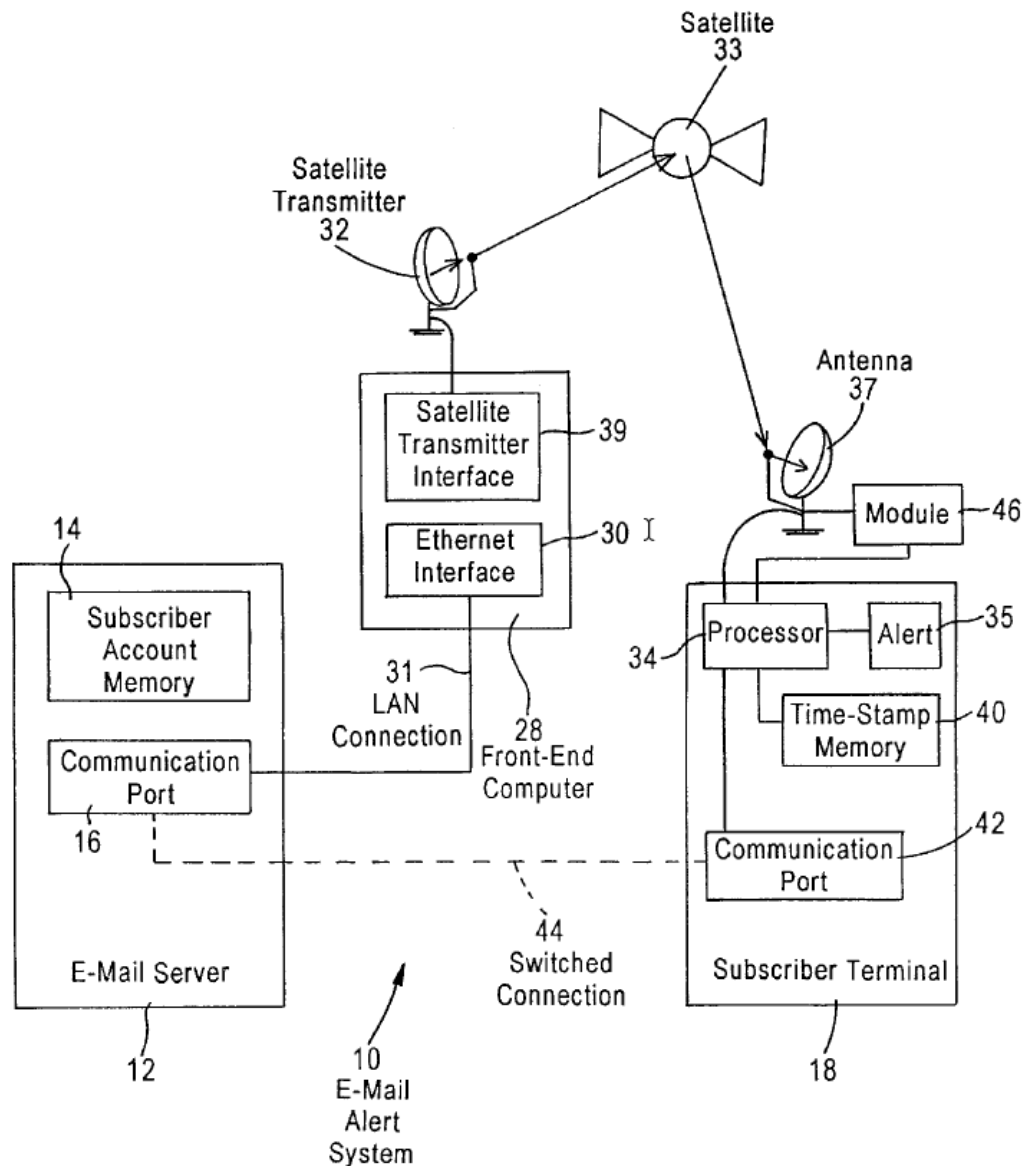


FIG. 2

Figure 2 of Dillon depicts an e-mail alert system 10. E-mail alert system 10 includes e-mail server 12, subscriber terminal 18, and front-end computer 28. *Id.* at 5:67–6:1, 6:17–19, 6:27–30. E-mail server 12 is communicatively coupled to subscriber terminal 18 via switched connection 44 and to front-end computer 28 via LAN connection 31. *Id.* at 6:11–16, 6:32–35. E-mail server 12 administers e-mail accounts for a plurality of

subscribers to an e-mail service. *Id.* at 7:1–3. Dillon explains that “[s]ome or all of the e-mail service subscribers may additionally subscribe to an e-mail alert service.” *Id.* at 7:5–7. E-mail server 12 includes a subscriber account memory 14 that “stores an indication that [an] e-mail has been received for the e-mail service subscriber,” which indication may include a time-stamp, “as well as storing the e-mail message itself.” *Id.* at 6:5–11, 7:15–17. Figure 2 further depicts “[t]he front-end computer 28 [that] may be located at the same site as the e-mail server 12 or may be located remotely therefrom.” *Id.* at 6:30–32. Subscriber terminal 18 includes a memory for receiving e-mail notifications and a processor for determining what the e-mail notification indicates. *Id.* at 8:23–29.

Dillon describes the operation of the e-mail notification system beginning with e-mail server 12 receiving an e-mail for a subscriber and updating a time-stamp memory. *Id.* at 8:34–37. Front-end computer 28 then polls e-mail server 12 via LAN connection 31 on behalf of e-mail subscribers who are subscribers to the e-mail alert service. *Id.* at 7:30–32, 8:34–37, Fig. 2. Dillon describes that in response to the polling, e-mail server 12 returns “an indication, such as the time-stamp stored in the subscriber account memory 14, of whether e-mail has been received by the e-mail server 12 for the one or more e-mail alert service subscribers.” *Id.* at 7:33–36. Dillon explains that time-stamps “may represent the status of the subscriber’s e-mail account in various ways.” *Id.* at 7:17–19. For example, a time-stamp may be an indication of the time and date when the e-mail server most recently received an e-mail message for a particular subscriber. *Id.* at 7:19–23. Alternatively, Dillon describes the time-stamp as a “version number, that uniquely identifies a particular e-mail message,” or as a “binary

indication of whether or not e-mail for the given e-mail alert service subscriber has been received . . . at any given time.” *Id.* at 7:23–29.

Dillon discloses that upon receiving the time-stamp from e-mail server 12, front-end computer 28 sends an e-mail notification to subscriber terminal 18. *Id.* at 7:37–47. Subscriber terminal 18 then “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.” *Id.* at 8:66–9:2. To determine whether a new e-mail was received, Dillon explains that subscriber terminal 18 compares the time-stamp received from the e-mail server with “the most recently received or latest time-stamp stored in the time-stamp memory 40 of the subscriber terminal 18.” *Id.* at 9:2–12.

Dillon teaches that if the received time-stamp differs from the latest time-stamp stored in the time-stamp memory, then subscriber terminal 18 provides an audible and/or visual indication to the user. Ex. 1005, 8:29–33, 9:13–17. For example, subscriber terminal 18 may display a blinking icon until a user acknowledges seeing the alert notification. *Id.* at 9:18–21. Subscriber terminal 18 may then “dial in to the e-mail server 12 and retrieve e-mail messages,” using switched connection 44. *Id.* at 9:21–27, Fig. 2.

2. Overview of AAPA

The ’765 patent describes the prior art Desktop Alert system as “a legacy system for which the present system provides improvements.” Ex. 1001, 1:13–19. According to the ’765 patent, the Desktop Alert system is a “mass notification platform that is used to deliver messages and media . . . to desktops as well as other devices such as telephones, cell phones, e-mail and mobile devices.” *Id.* at 1:19–24. The ’765 patent explains that the prior messaging systems used a polling model commonly used for checking

e-mail where the client periodically provides queries to the server requesting updated messaging information. *Id.* at 3:11–17. The Desktop Alert system used a “GetUnreadAlerts” based on the SOAP protocol that is “initiated by the client to the server and is communicated to the server at the polling frequency.” *Id.* at 4:42–44.

3. Analysis of Claims 1–13

a. Independent Claim 1

Independent claim 1 recites, *inter alia*,

[1.4] 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,

[1.5] a second step wherein said client contacts the central server and requests the value of said alert ID number in said memory, said value reflecting the number of alert messages received by said central server,

Ex. 1001, 12:37–13:8 (Petitioner’s reference designations added).

We first address Petitioner’s contentions in pertinent part as follows. Beginning with limitation 1.4, Petitioner contends that Dillon discloses “the front-end computer 28 polls the e-mail server 12 on behalf of one or more e-mail alert service subscribers as described above, [and] it obtains from the e-mail server 12, for each e-mail alert service subscriber, an indication, such as the time-stamp stored in the subscriber account memory 14, of whether e-mail has been received by the e-mail server 12.” Pet. 30 (quoting Ex. 1005, 7:30–41). Petitioner asserts that Dillon’s time-stamp teaches the claimed Boolean value because Dillon states that the time-stamp may be a “repeatable value, such as a binary (*e.g.*, one or zero) indication of whether

or not email for an e-mail service subscriber has been received by the e-mail server.” *Id.* at 30–31 (quoting Ex. 1005, 4:36–41; citing Ex. 1016, 67).

Turning to limitation 1.5, Petitioner contends that Dillon discloses a time-stamp stored in the e-mail server’s subscriber memory. Pet. 34–35 (citing Ex. 1005, 7:33). Petitioner asserts that Dillon further discloses “the polling means of the front-end *polls the e-mail server periodically to obtain the time-stamp for the e-mail service subscriber.*” *Id.* at 35 (quoting Ex. 1005, 13:8–9). Petitioner further contends that “a time-stamp may be . . . a version number, that uniquely identifies a particular e-mail message received by the e-mail server 12 for the given e-mail alert service subscriber.” *Id.* at 35–36 (quoting Ex. 1005, 7:23–26).

Patent Owner disputes certain portions of the above contentions. For the following reasons, we agree with Patent Owner that Petitioner fails to sufficiently show that Dillon in view of AAPA teaches or suggests elements 1.4 and 1.5.

First, Patent Owner argues that Dillon discloses a conventional e-mail polling system and does not teach or suggest a “triggering step” that is distinguishable from any other polling operation. Prelim. Resp. 17–18. As explained by Patent Owner, “the Petition fails to give any meaning to the ‘triggering step,’ and merely conflates it with the recited second, third, fourth, and fifth steps.” *Id.* at 13 (citing Pet. 34–37).

Second, Patent Owner argues that Petitioner improperly relies on the same prior art disclosure, Dillon’s time-stamp, to satisfy two different claim elements. *Id.* at 21 (citing Pet. 28–30). According to Patent Owner, Petitioner relies on Dillon’s time-stamp as “a Boolean value” when asserting that Dillon discloses a “first triggering step . . . comprising a request for a

Boolean value.” *Id.* (citing Pet. 30). Patent Owner further asserts that Petitioner again relies on Dillon’s time-stamp as an “alert ID number,” when asserting that Dillon discloses “a second step wherein said client contacts the central server.” *Id.* (citing Pet. 28–30).

As we discussed in our claim construction analysis above, on this record, we construe “a first triggering step” as a step that *precedes* the claimed “second step.” *See* § III.B.1.

The Petition contends that Dillon discloses a first triggering step by teaching “the front-end computer 28 polls the e-mail server 12 on behalf of one or more e-mail alert service subscribers,” to obtain a time-stamp that may 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.” Pet. 30–31 (citing Ex. 1005, 4:36–41, 7:30–41).

The Petition further contends that Dillon discloses the second request by disclosing “the polling means of the front-end polls the e-mail server periodically to obtain the time-stamp for the e-mail service subscriber.” *Id.* at 35 (quoting Ex. 1005, 13:8–9). Here, Petitioner cites to Dillon’s claim 22 (Ex. 1005, 13:8–9) rather than Dillon’s specification as disclosing the step of polling the e-mail server. *Id.* But, because Petitioner has not identified a second step of polling in Dillon’s specification, and we discern no second step of polling in the disclosure of Dillon, we consider Dillon’s claim 22 to refer to the same step of polling relied on for the first triggering step. *See* Ex. 1005, 7:30–36. Hence, we agree with Patent Owner that Petitioner relies on the same disclosure for the “first triggering step . . . comprising a request for a Boolean value” and the “second step wherein said client contacts the central server and requests the value of said alert ID number.” Prelim. Resp.

13. Thus, Petitioner fails to sufficiently show that Dillon teaches or suggests a “first triggering step” that precedes a “second step.”

Moreover, not only does the Petition rely on the same disclosure of the front-end polling the e-mail server for two distinct steps, the Petition also relies on the same time-stamp for two distinct elements. *See* Pet. 35–36 (citing Ex. 1005, 7:23–26). In the case of the claimed “first triggering step,” Petitioner relies on one embodiment of Dillon’s time-stamp, i.e., the “binary (*e.g.*, one or zero) indication of whether or not e-mail . . . has been received.” *Id.* at 30 (quoting Ex. 1005, 4:36–41). In the case of the claimed “second step,” Petitioner relies on an alternative embodiment of the time-stamp as “a version number, that uniquely identifies a particular e-mail message received by the e-mail server 12 for the given e-mail alert service subscriber.” *Id.* at 35–36 (citing Ex. 1005, 7:23–26). At most, we understand Dillon to teach a single request for a time-stamp from the front-end server to the e-mail server where the time-stamp is one of a time, version number, or Boolean value. Ex. 1005, 7:15–29; *see also id.* at 4:27–41. If the client determines that the time-stamp, either in Boolean or version number form, indicates that the e-mail server received a new e-mail for the subscriber, the subscriber terminal will request the unread e-mails. Pet. 38 (citing Ex. 1005, 9:13–27). As a result, we agree with Patent Owner that Dillon does not disclose both the claimed “Boolean value” and the claimed “alert ID number.” *See* Prelim. Resp. 21.

According to Petitioner, nothing in Dillon describes the Boolean time-stamp and unique ID time-stamps as mutually exclusive. Pet. 15–16, 31 (citing Ex. 1005, 7:15–29). In addition, Petitioner argues that a POSITA would have understood Dillon as disclosing the use of both time-stamps in

the same method or system. *Id.* Nevertheless, Petitioner states that to the extent that Dillon’s time-stamps are mutually exclusive, a POSITA would have been motivated to modify Dillon to include both a Boolean time-stamp and unique ID time-stamp because “the Binary Timestamp reduces messaging bandwidth and other resources which was a well-recognized problem,” and the version number time-stamp has the ability to “uniquely identif[y] a particular e-mail message received by the e-mail server.” *Id.* (citing Ex. 1014 ¶¶ 6, 9; Ex. 1005, 4:28–36); Ex. 1003 ¶ 62.

We are not persuaded by Petitioner’s contentions. First, we agree with Patent Owner that Dillon discloses time-stamps as “alternatives.” Prelim. Resp. 21 (citing Ex. 1005, 4:36–41). Dillon explains that “[t]he time-stamp . . . may represent the status of the subscriber’s e-mail account in various ways . . . [m]ost commonly, it is an indication of an actual time.” Ex. 1005, 7:19–21. However, Dillon explicitly states that “[a]lternatively, a time-stamp may be a number, such as a version number . . . or it may be a binary indication of whether or not e-mail . . . has been received.” *Id.* at 7:23–28 (emphasis added). Petitioner has not identified any portion of Dillon that suggests using more than one type of time-stamp in the same process. *See generally* Pet. 30–36.

Dillon’s lack of disclosure of using multiple time-stamps appears consistent with Dillon’s description of the time-stamp as providing “the status of the subscriber’s e-mail account.” Ex. 1005, 7:19–21. Each disclosed alternative — time, version number, or binary indication — provides status information for the same purpose, namely, to indicate “whether or not e-mail for the given e-mail alert service subscriber has been received by the e-mail server 12 at any given time.” *Id.* at 7:27–29, 9:7–17.

Because each of Dillon’s alternatives for a time-stamp serves the same purpose, we are not persuaded that Petitioner has provided sufficient reasoning to demonstrate that a POSITA would have been motivated to modify Dillon to both add a new polling step requesting a first time-stamp as a Boolean time-stamp and then request a second time-stamp as a version number or time indication. Indeed, Petitioner’s asserted rationale to modify Dillon here is conclusory and fails to explain sufficiently how using a second time-stamp will achieve the asserted benefits of reducing messaging bandwidth or uniquely identifying a particular message. *See* Pet. 31.

Because Dr. Mangione-Smith’s declaration testimony mirrors Petitioner’s argument, his supporting testimony is similarly insufficient. *Compare* Pet. 31, *with* Ex. 1003 ¶ 62. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); *see also In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (noting that “the Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations”).

Based on the foregoing, on this record, we are not persuaded that Petitioner has met its burden to demonstrate that Dillon in view of AAPA teaches or suggests a first step of requesting a Boolean value and a second step of requesting an alert ID number as claimed. Accordingly, we determine that the Petition fails to show that there is a reasonable likelihood that it would prevail in establishing unpatentability of claim 1.

b. Independent Claim 10

Independent claim 10 recites, *inter alia*,

[10.6] said protocol further comprises 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

[10.7] further communication from said client to said server requesting a Get Alert Messages using a SOAP communications protocol and [10.8] wherein said client is transmitted an Alert ID message value from said server to said client, and

Ex. 1001, 14:6–18 (Petitioner’s reference designations added).

We first address Petitioner’s contentions in pertinent part as follows. Beginning with limitation 10.6, Petitioner contends that Dillon and AAPA disclose the claim limitations for the same reason as discussed regarding limitation 1.4. Pet. 59. Namely, Petitioner contends that Dillon discloses “the front-end computer 28 polls the e-mail server 12 on behalf of one or more e-mail alert service subscribers as described above, it obtains from the e-mail server 12, for each e-mail alert service subscriber, an indication, such as the time-stamp stored in the subscriber account memory 14, of whether e-mail has been received by the e-mail server 12.” Pet. 30 (quoting Ex. 1005, 7:30–41). Petitioner asserts that Dillon’s time-stamp teaches the claimed Boolean value because Dillon states that the time-stamp may be a “repeatable value, such as a binary (e.g., one or zero) indication of whether or not email for an e-mail service subscriber has been received by the e-mail server.” *Id.* at 30–31 (quoting Ex. 1005, 4:36–41; citing Ex. 1016, 67).

Turning to limitation 10.7, Petitioner contends that AAPA discloses that “the GetUnreadAlerts call was used in the prior art Desktop Alert system and/or the ‘conventional polling system.’” Pet. 59 (citing Ex. 1005, 4:39–49, 4:46–48, 4:50–51, 5:59–61, 6:7, 6:11–24). Petitioner explains that

the '765 patent further admits that the prior art Desktop Alert system used a SOAP based GetUnreadAlerts call. *Id.* (citing Ex. 1005, 10:22–23).

Turning to limitation 10.8, Petitioner identifies Dillon disclosing the front-end computer polls the e-mail server periodically to obtain the time-stamp for the e-mail service subscriber. *Id.* at 60 (citing Ex. 1005, 4:49–54, 9:7–12). Petitioner further contends that the e-mail server updates the time-stamps stored in the subscriber memory each time an e-mail is received for a subscriber. *Id.* (citing Ex. 1005, 4:49–54). Petitioner further directs us to Dillon disclosing that the subscriber terminal compares the time-stamp received from the e-mail server with the most recently received time-stamp. *Id.* (citing Ex. 1005, 9:7–12).

Petitioner's contentions for claim 10 are substantially similar, in relevant part, to those of claim 1 with one significant exception. Claim elements 10.7 and 10.8 generally correspond to the "second step wherein said client contacts the central server and requests the value of said alert ID number" recited in claim element 1.5 with the additional requirement of "using a SOAP communications protocol." For this additional element, Petitioner asserts that the Desktop Alert system and conventional polling systems described in AAPA use a GetUnreadAlerts SOAP call. Pet. 59–60 (citing Ex. 1005, 4:39–51, 5:59–61, 6:7, 6:11–24, 10:22–23). Petitioner does not explain how the GetUnreadAlerts call would be incorporated into Dillon's system. *See id.* Hence, we understand Petitioner's contention as merely demonstrating that AAPA describes the GetUnreadAlerts. Hence, we are not persuaded that this contention changes our analysis from claim 1 that Petitioner has failed to demonstrate sufficiently that the combination of Dillon and AAPA teach the claimed "first triggering step." Prelim. Resp.

17–18; Pet. 59 (“[T]he GetUnreadAlerts call was used in . . . the ‘conventional polling system.’”).

As with claim 1, the Petition relies on the same disclosure of Dillon’s front-end computer polling the e-mail server for a time-stamp to address both claim elements 10.6 and 10.8. *Id.* at 30–31, 60 (citing Ex. 1005, 4:36–41, 4:49–54, 7:15–41, 9:7–12). Accordingly, for the same reasons we describe above, we are not persuaded that Petitioner has met its burden to demonstrate that Dillon in view of AAPA teaches or suggests a first triggering step of requesting a Boolean value and a further communication from said client to said server, wherein said client is transmitted an Alert ID message value from said server. Accordingly, we determine that the Petition fails to show that there is a reasonable likelihood that it would prevail in establishing unpatentability of claim 10.

4. Summary

For the foregoing reasons, Petitioner has not shown a reasonable likelihood of prevailing with respect to independent claims 1 or 10 for the asserted ground based on Dillon and AAPA. Petitioner’s additional contentions regarding dependent claims 2–9 and 11–13 do not cure these deficiencies regarding claims 1 and 10, and fail for the same reasons.

E. Alleged Obviousness over Dillon, Brady, and AAPA

1. Overview of Brady

Brady is directed to a system for automatically polling for data changes in an on-demand database service environment. Ex. 1008, Abstract. Figure 1 of Brady, reproduced below, illustrates the environment 10 of the on-demand database service. *Id.* ¶ 23.

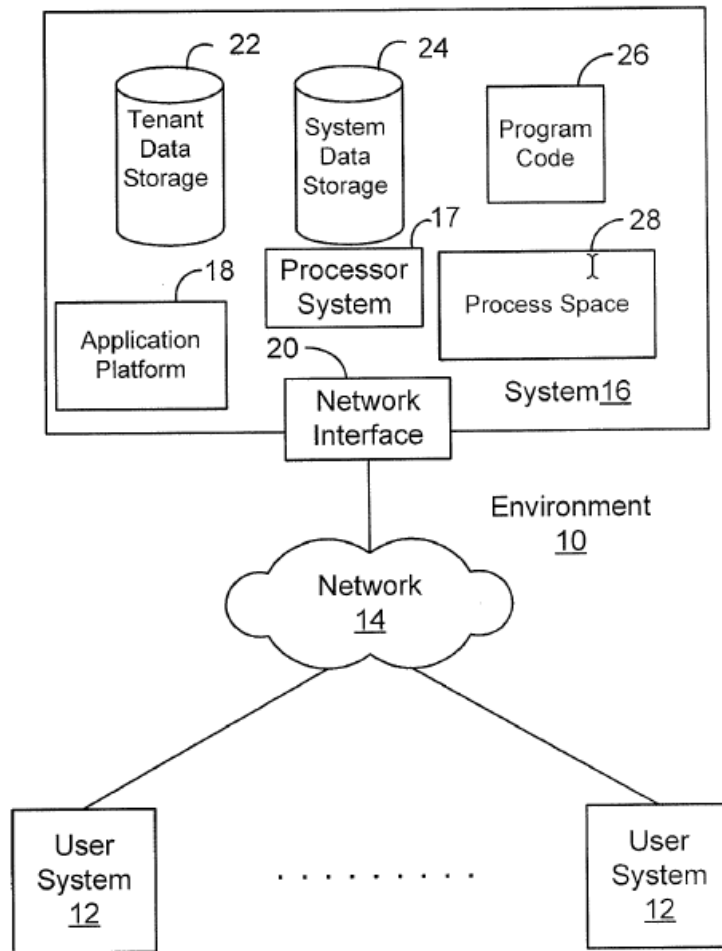


FIG. 1

Figure 1 depicts an environment 10 including user systems 12, network 14, system 16, processor system 17, application platform 18, network interface 20, tenant data storage 22, system data storage 24, program code 26, and process space 28. Brady explains that “[a]n on-demand database service, such as system 16, is 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.” *Id.* ¶ 25. The database stores rows of data for one or more customers. *Id.* ¶ 21. According to Brady, user systems 12 may communicate with system 16 using common Internet protocols such

as HTTP. *Id.* ¶ 28. In this embodiment, user system 12 may include a “HTTP client commonly referred to as a ‘browser’ for sending and receiving HTTP messages.” *Id.*

Brady describes the operation of the polling system beginning with a polling client periodically polling the server. *Id.* ¶ 53. The server receives the request from the client, “the request including data identifying a first user, e.g., user id information, and an object provided to the client system by an application server.” *Id.* ¶ 11. The server response may include information, such as a time-stamp, that allows the client to determine if there are updates to the pertinent database object. *Id.* ¶ 10. Brady explains that “[w]hen it has been determined that an update may have been made, the client system then sends a refresh request to the application server to request an update to the data object, thereby controlling (e.g., reducing) the number of refresh requests sent to the application server.” *Id.*

2. Analysis

Petitioner contends that the subject matter of claims 1–13 would have been obvious over Dillon, Brady, and AAPA. Pet. 24–68. Petitioner asserts that Dillon and AAPA render claims 1–13 obvious for the reasons described in Ground 1, but further contends that Brady discloses a “triggering step comprises the use of a HTTP packet comprising a request,” by disclosing an “HTTP client . . . for sending and receiving HTTP messages to and from an HTTP server” and specifically discloses “incoming HTTP requests.” *Id.* at 67 (citing Ex. 1008 ¶ 28).

Having reviewed the Petition, we find that Petitioner’s reliance on Brady does not cure the above-noted deficiencies with respect to independent claims 1 and 10, and claims 2–9 and 11–13 dependent

therefrom. Accordingly, Petitioner does not show that there is a reasonable likelihood that it would prevail in establishing unpatentability of claims 1–13 as obvious in view of Dillon, AAPA, and Brady.

F. Alleged Obviousness over Dillon, Douglas, and AAPA

1. Overview of Douglas

Douglas is directed to a system for managing the reception of messages in a communication network. Ex. 1006, Abstract, ¶ 14. Douglas describes a communication network including one or more client nodes and a server node, which stores messages associated with the client nodes. *Id.* ¶ 14. Each client node may have one or more messaging accounts that may include an e-mail message account or an instant message account. *Id.* ¶¶ 14, 17.

Douglas explains the operation of the described messaging system beginning with “[a] first client node of the one or more client nodes [that] has at least a first message account associated with it, and the first message account is configured as a pull-message configuration.” *Id.* ¶ 15. The client polls the server node to check for the arrival of one or more new messages. *Id.* Dillon states that “[w]hen there are new emails at the server node, the polling results show the arrival of new emails, and the first client node can retrieve and read the new emails.” *Id.*

2. Analysis

Petitioner contends that the subject matter of claims 1–13 would have been obvious over Dillon, Douglas, and AAPA. Pet. 24–65, 68–70. Petitioner asserts that Dillon and AAPA render claims 1–13 obvious for the reasons described in Ground 1, but further contends that Douglas describes

that “messages can be electronic mail messages (emails) or Instant Messages (IMs).” Pet. 70 (quoting Ex. 1006 ¶ 14).

Having reviewed the Petition, we find that Petitioner’s reliance on Douglas does not cure the above-noted deficiencies with respect to independent claims 1 and 10, and claims 2–9 and 11–13 dependent therefrom. Accordingly, Petitioner does not show that there is a reasonable likelihood that it would prevail in establishing unpatentability of claims 1–13 as obvious in view of Dillon, Douglas and AAPA.

G. Alleged Obviousness over Dillon, Brady, Douglas, and AAPA

Petitioner contends that the subject matter of claims 1–13 would have been obvious over Dillon, Brady, Douglas, and AAPA. Pet. 24–72. Petitioner asserts that Dillon, Brady, and AAPA render claims 1–13 obvious for the reasons described in Ground 2, but further contends that Douglas describes that “messages can be electronic mail messages (emails) or Instant Messages (IMs).” *Id.* at 70 (quoting Ex. 1006 ¶ 14).

Having reviewed the Petition, we find that Petitioner’s reliance on Brady and/or Douglas does not cure the above-noted deficiencies with respect to independent claims 1 and 10, and claims 2–9 and 11–13 dependent therefrom. Accordingly, Petitioner does not show that there is a reasonable likelihood that it would prevail in establishing unpatentability of claims 1–13 as obvious in view of Dillon, Douglas, Brady, and AAPA.

IV. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not demonstrated on the record a reasonable likelihood that it will prevail in showing at least one of the challenged claims of the ’765 patent is unpatentable.

V. ORDER

For the reasons given, it is

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

IPR2024-00363
Patent 9,172,765 B2

For PETITIONER:

Brian Koide
William Nixon
Ryan Pool
MILLEN, WHITE, ZELANO, & BRANIGAN, P.C.
bkoide@mwzb.com
nixon@mwzb.com
pool@mwzb.com

For PATENT OWNER:

Joseph Farco
NORRIS McLAUGHLIN, P.A.
jfarco@norris-law.com

Andrew Aitken
AITKEN LAW OFFICES
acaitken@yahoo.com