

Filed: January 22, 2015

Filed on behalf of:

Patent Owner AutoAlert, LLC

By: Craig S. Summers

Brenton R. Babcock

David G. Jankowski

KNOBBE, MARTENS, OLSON & BEAR, LLP

2040 Main Street, 14th Floor

Irvine, CA 92614

Tel.: (949) 760-0404 Fax: (949) 760-9502

Email: BoxAutoAlert@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEALERSOCKET, INC.

Petitioner,

v.

AUTOALERT, LLC

Patent Owner.

Case CBM 2014-00139

U.S. Patent No. 8,396,791

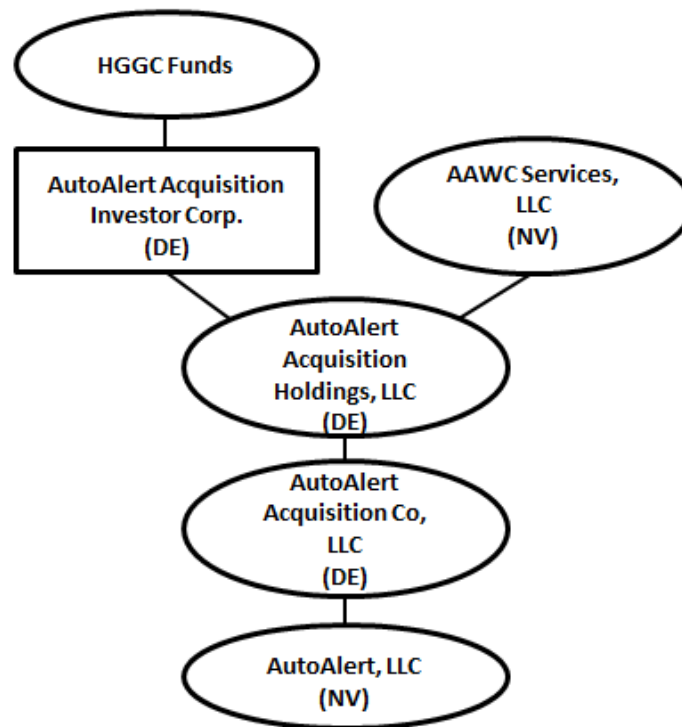
**PATENT OWNER AUTOALERT, LLC'S SUPPLEMENTAL
SUBMISSION OF MANDATORY NOTICE INFORMATION AND
ADDITION OF BACKUP COUNSEL PURSUANT TO 37 C.F.R. § 42.8(a)**

Pursuant to 37 C.F.R. § 42.8(a), Patent Owner AutoAlert, LLC respectfully submits the following required supplemental mandatory notice information.

I. The Real Party-In-Interest Pursuant to 37 C.F.R. § 42.8(b)(1)

The real party-in-interest is AutoAlert, LLC, a Nevada limited liability company having a principal place of business at 9050 Irvine Center Drive, Irvine, California 92618. AutoAlert, LLC is the owner of all right, title and interest in the subject patent, U.S. Patent 8,396,791 (“the ’791 patent”), by virtue of an assignment from the inventor, Jeffrey S. Cotton to AutoAlert, Inc. (recorded on 12/22/2011, at Reel 027437, Frame 0307), and by virtue of a corporate conversion under the state laws of Nevada of AutoAlert, Inc. to AutoAlert, LLC (recorded on April 8, 2014, at Reel 032640, Frame 0806).

Investment funds affiliated with HGGC, LLC, a Delaware limited liability company, own a majority interest in AutoAlert, LLC, under the following structure:



II. Related Matters Pursuant to 37 C.F.R. § 42.8(b)(2)

AutoAlert, LLC identifies the following judicial and administrative proceedings that may affect, or be affected by, a decision in this proceeding:

A. Related Patents or Patent Applications

Consistent with the PTO comment on “Related Matters” at 77 Fed. Reg. 157, p. 48760 (Aug. 14, 2012), AutoAlert, LLC provides the following list of applications claiming, or which may claim, the benefit of the priority date of the ’791 patent:

App. No.	Filing Date	Pub. No
13/831015	03/14/2013	2013/0211865

App. No.	Filing Date	Pub. No
13/797803	03/12/2013	2014/0006108
13/789510	03/07/2013	2013/0185190
14/324041	07/03/2014	
14/500890	09/29/2014	
14/506550	10/03/2014	
14/517566	10/17/2014	

B. Prior IPR Proceedings

a. The '791 patent was the subject of a previous petition for *inter partes* review filed on March 28, 2013 by Dominion Dealer Solutions (IPR No. 2013-00225). On August 15, 2013, the PTAB issued a Decision denying Dominion's petition (Paper 10). On October 10, 2013, the PTAB issued a Decision denying Dominion's request for rehearing (Paper 15).

b. Four other patents owned by AutoAlert from the same patent family as the '791 patent were also the subject of petitions for *inter partes* review filed by Dominion on March 28, 2013. The PTAB issued Decisions denying each of the four petitions, and it also issued Decisions denying Dominion's requests for rehearing on each of the four petitions. The details for these proceedings are shown below.

U.S. Patent No.	IPR No.	Denial of petition	Denial of request for rehearing
7,827,099	2013-00222	Aug. 12, 2013 (Paper 12)	Oct. 10, 2013 (Paper 17)
8,005,752	2013-00220	Aug. 15, 2013 (Paper 8)	Oct. 10, 2013 (Paper 13)
8,086,529	2013-00223	Aug. 15, 2013 (Paper 9)	Oct. 10, 2013 (Paper 14)
8,095,461	2013-00224	Aug. 15, 2013 (Paper 10)	Oct. 10, 2013 (Paper 15)

C. Judicial Proceedings Challenging the PTAB's Decisions

Dominion Dealer Solutions subsequently initiated two judicial proceedings for the purpose of challenging the PTAB's Decisions denying the five *inter partes* review petitions Dominion filed on AutoAlert's patents in March 2013, including the Decision involving the '791 patent. Both judicial proceedings ended unsuccessfully for Dominion. The details for these proceedings are shown below.

a. On October 15, 2013, Dominion filed a lawsuit in the Eastern District of Virginia under the Administrative Procedure Act seeking an order reversing the PTAB's Decisions and compelling the U.S. Patent and Trademark Office to institute *inter partes* reviews on all five of AutoAlert's patents. (*Dominion Dealer Solutions, LLC v. Rea*, Civil Action No. 3:13cv699-REP.) On April 18, 2014, the district court granted the Patent Office's motion to dismiss Dominion's lawsuit for lack of subject matter

jurisdiction. On June 17, 2014, Dominion filed an appeal to the United States Court of Appeals for the Federal Circuit from the district court's Order dismissing Dominion's lawsuit. The appeal is currently stayed pending the Federal Circuit's final disposition in *Versata Development Group, Inc. v. Lee*, 2014-1145.

b. On November 26, 2013, Dominion filed a Petition for Writ of Mandamus in the United States Court of Appeals for the Federal Circuit seeking a writ compelling the Patent Office to institute *inter partes* reviews on all five of AutoAlert's patents. (*In re Dominion Dealer Solutions, LLC*, Misc. Docket No. 2014-109). On April 24, 2014, the Federal Circuit denied Dominion's Petition. On June 9, 2014, Dominion filed a Petition for Rehearing En Banc seeking rehearing of the Federal Circuit denial of Dominion's Petition for Writ of Mandamus. On July 14, 2014, The Federal Circuit denied the Petition.

D. Current IPR Proceedings

The '791 patent, is the subject of a second petition for *inter partes* review filed by Dominion on April 23, 2014. (IPR2014-00684, Paper 1.) The PTAB issued a Decision instituting the *inter partes* review on October 6, 2014. (IPR2014-00684, Paper 9.)

E. Related CBM Proceedings

Four other patents owned by AutoAlert from the same patent family as the '791 patent are also the subject of previous CBM petitions filed by DealerSocket. On September 8, 2014, the PTAB issued Decisions dismissing two of the four petitions. (*See* CBM2014-00142, Paper 10 (dismissing the '099 patent) and CBM2014-00147, Paper 8 (dismissing the '752 patent)). DealerSocket subsequently re-filed two new CBM petitions directed at the '099 patent and one new CBM petition directed at the '752 patent. The remaining three earlier filed CBM petitions are still pending. Details for the CBM proceedings are shown below.

U.S. Patent No.	CBM No.	Petition Filed	Petition Dismissed
8,095,461	2014-00132	May 19, 2014	N/A
7,827,099	2014-00142	May 29, 2014	September 8, 2014 (Paper 10)
8,005,752	2014-00147	June 13, 2014	September 8, 2014 (Paper 8)
8,086,529	2014-00146	June 13, 2014	N/A
7,827,099	2014-00201	September 26, 2014	N/A
7,827,099	2014-00202	September 26, 2014	N/A
8,005,752	2014-00203	September 26, 2014	N/A

F. Pending Patent Infringement Lawsuits Asserting the '791 Patent

AutoAlert is the plaintiff in two patent infringement lawsuits pending in the U.S. District Court for the Central District of California that assert the '791 patent and the four related AutoAlert patents identified above. The details for these two lawsuits are shown below.

a. On October 1, 2012, AutoAlert filed a patent infringement lawsuit against Dominion and two related entities asserting infringement of AutoAlert's other four patents as identified herein. (*AutoAlert, Inc. v. Dominion Dealer Solutions, LLC, et. al.*, Case No. SACV 12-01661 JLS (JPRx).) On April 23, 2013, AutoAlert amended its complaint to add to the lawsuit the '791 patent, which had recently issued. This lawsuit, presided over by Hon. Josephine Staton, is scheduled to go to trial in August 2015. On December 23, 2014, Judge Staton issued a Claim Construction Order (Docket No. 139), an Order denying Defendant 110 Reynolds' Motion for Summary Judgment of Invalidity Under 35 U.S.C. § 112 For Indefiniteness (Docket No. 138), and an Order granting Defendant AutoBase's Motion for Summary Judgment of Invalidity Under 35 U.S.C. § 101 For Lack of Patent Eligibility (Docket No. 140).

b. On April 25, 2013, AutoAlert filed a patent infringement lawsuit against the Petitioner, DealerSocket, Inc., asserting infringement of

the '791 patent and AutoAlert's other four patents identified herein. (*AutoAlert, Inc. v. DealerSocket, Inc.*, Case. No. SACV 13-00657 SJO (JPRx).) This lawsuit, presided over by Hon. S. James Otero, is currently stayed pending the outcome of the first five CBM petitions discussed in Section II.E, above. On June 18, 2014, prior to entering the stay, Hon. S. James Otero issued an Order Construing Claim Terms Following Markman Hearing, construing five claim terms that appear in the '791 patent ("message," "if," "configuration request," "current information," and "different respective time periods") (Docket No. 180).

III. Lead and Back-Up Counsel Pursuant to 37 C.F.R. § 42.8(b)(3)

AutoAlert, LLC designates its lead and backup counsel as follows:

Lead counsel:

Craig S. Summers, Reg. No. 31,430

Craig.Summers@knobbe.com

Knobbe, Martens, Olson & Bear, LLP

2040 Main Street, 14th Floor

Irvine, CA 92614

Tel: (949) 760-0404

Fax: (949) 760-9502

Back-up counsel:

Brenton R. Babcock, Reg. No. 39,592

Brent.Babcock@knobbe.com

David G. Jankowski, Reg. No. 43,691

David.Jankowski@knobbe.com

Daniel C. Fullerton, Reg. No. 69,773

Daniel.Fullerton@knobbe.com

Knobbe, Martens, Olson & Bear, LLP

2040 Main Street, 14th Floor
Irvine, CA 92614
Tel: (949) 760-0404
Fax: (949) 760-9502

IV. Service Information Pursuant to 37 C.F.R. § 42.8(b)(4)

AutoAlert consents to electronic service using the email address:

BoxAutoAlert@knobbe.com

AutoAlert may be served by overnight or hand delivery as follows:

Craig S. Summers
Brenton R. Babcock
David G. Jankowski
Daniel C. Fullerton
Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Tel: (949) 760-0404

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 22, 2015

By /Daniel C. Fullerton/

Craig S. Summers, Reg. No. 31,430
Brenton R. Babcock, Reg. No. 39,592
David G. Jankowski, Reg. No. 43,691
Daniel C. Fullerton, Reg. No. 69,773

Email: BoxAutoAlert@knobbe.com
Attorneys for Patent Owner
AutoAlert, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **PATENT OWNER AUTOALERT, LLC'S SUPPLEMENTAL SUBMISSION OF MANDATORY NOTICE INFORMATION AND ADDITIONK OF BACKUP COUNSEL PURSUANT TO 37 C.F.R. § 42.8(a)** is being served on January 22, 2015, via email pursuant to 37 C.F.R. § 42.6(e) per agreement of the parties, to counsel for DealerSocket, Inc., at the addresses below:

Richard C. Gilmore
Sterling A. Brennan
L. Rex Sears
MASCHOFF BRENNAN LAYCOCK
GILMORE IRAELSEN & WRIGHT PLLC
201 South Main Street, Suite 600
Salt Lake City, Utah 84111
Tel: (435)252-1360
Fax: (435)252-1361
rgilmore@mabr.com
sbrennan@mabr.com
rsears@mabr.com

Dated: January 22, 2015

/Daniel C. Fullerton/
Craig S. Summers, Reg. No. 31, 430
Brenton R. Babcock, Reg. No. 39,592
David G. Jankowski, Reg. No. 43,691
Daniel C. Fullerton, Reg. No. 69,773

Attorney for Patent Owner
AutoAlert, LLC