

Filed: June 13, 2014

Filed on behalf of:

Patent Owner AutoAlert, LLC  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**DEALERSOCKET, INC.**

Petitioner,

**v.**

**AUTOALERT, LLC**

Patent Owner.

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**Case CBM 2014-00139**  
U.S. Patent No. 8,396,791

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**PATENT OWNER AUTOALERT, LLC'S SUBMISSION OF  
MANDATORY NOTICE INFORMATION  
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 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).

**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. 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.

<b>U.S. Patent No.</b>	<b>IPR No.</b>	<b>Denial of petition</b>	<b>Denial of request for rehearing</b>
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)

## **B. 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.

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.

### **C. 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 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 in the midst of discovery and is scheduled to go to trial in August 2015.

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 approaching the end of discovery and is scheduled to go to trial in December 2014.

#### **D. Co-Pending IPR Petition**

The '791 patent is also the subject of a pending petition for *inter partes* review filed by Dominion on April 23, 2014 (IPR No. 2014-00684). AutoAlert filed its Mandatory Notices on May 15, 2014 (Paper 7). The deadline for

AutoAlert to file a Preliminary Patent Owner's Response occurs next month, and the deadline for the Patent Trial and Appeal Board to make a decision whether to grant Dominion's petition occurs in October.

**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  
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**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](mailto:BoxAutoAlert@knobbe.com)

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

Craig S. Summers

CBM 2014-00139  
DealerSocket v. AutoAlert

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Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 12, 2014

By /Craig S. Summers/

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AutoAlert, LLC

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of **PATENT OWNER AUTOALERT, LLC'S SUBMISSION OF MANDATORY NOTICE INFORMATION PURSUANT TO 37 C.F.R. § 42.8(a)** is being served on June 12, 2014, 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:

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