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28UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIAGINEGAR LLC,  
Plaintiff,  
v.  
SLACK TECHNOLOGIES, INC.,  
Defendant.Case No. [22-cv-00044-WHO](#)**ORDER GRANTING MOTION TO  
DISMISS THIRD AMENDED  
COMPLAINT**

Re: Dkt. No. 78

Defendant Slack Technologies, Inc. (“Slack”) moves to dismiss the Third Amended Complaint (“TAC”) brought by plaintiff Ginegar LLC (“Ginegar”), which alleges that Slack infringed upon one of Ginegar’s patents. Slack asserts that the only remaining claim in this case, Claim 8, does not recite patentable subject matter under the *Mayo/Alice* framework. Claim 8 is directed to a system that allows participants in an instant messaging session to exchange both audio and text messages, and then logs a unified transcript of those messages. But it is directed to an ineligible concept (the abstract idea of combining different message types in a single transcript) and recites only an improved result to instant message technology, not the specific means or methods for accomplishing it. And Ginegar has not shown any inventive concept adding “significantly more” to the abstract idea. The purportedly inventive concept—the logic element that logs a single transcript of audio and text messages exchanged during an instant messaging session—is nothing more than using a computer to perform the abstract idea itself. For these reasons, Slack’s motion is GRANTED. And because I previously granted a motion to dismiss on this ground, dismissal is without leave to amend.

**BACKGROUND**

Ginegar is the assignee and owner of U.S. Patent No. 9,760,865 (the “’865 Patent”). TAC

United States District Court  
Northern District of California

1 [Dkt. No. 77] ¶¶ 1-2. The '865 Patent, issued on September 12, 2017, claims methods and  
 2 systems related to multi-modal instant messaging sessions, where users can communicate via text  
 3 and audio in a single chat session. *Id.* ¶¶ 10, 12, 15. It has 16 claims, only one of which, Claim 8,  
 4 remains at issue. *See* Order Granting Mot. to Dismiss (“First MTD Order”) [Dkt. No. 71] 21:8-10.

5 Claim 8 is directed to a system that maintains the multi-modal session and records a  
 6 corresponding transcript that contains both the audio and text messages exchanged in that session.  
 7 *See* TAC, Ex. B (“’865 Patent”) at 5:65-6:25. Claim 8 is an independent claim and recites the  
 8 following:

9 A collaborative computing data processing system comprising:

10 a processor;

11 an instant messenger configured to maintain a multi-modal instant messaging  
 12 session between first and second conversants; and

13 multi-modal transcript unification logic, executing on the processor, and configured  
 14 to

15 establish a single instant messaging session between two conversants,

16 receive text messages as part of a conversation between the two conversants,  
 17 through the single instant messaging session,

18 embed in the instant messaging session a voice message received from one of the  
 19 two conversants,

20 classify each one of the embedded voice message and the received text messages  
 21 by type, the type of message being one of a voice message and a text message,

22 determine if the one of the voice and text messages is classified as a voice message,  
 and

23 log the classified voice and text messages in a single transcript of conversation  
 24 between the two conversants occurring in the single instant messaging session in  
 25 response to determining that the one of the voice and text messages is classified as  
 a voice message.

26 *Id.*

27 According to the TAC, the multi-modal transcript unification logic in Claim 8 improves  
 28 the prior art (the technology of instant messaging systems) because it solves a shortcoming: it (1)

1 allows conversants to use both text and voice in a single session, and (2) automatically logs a  
2 unified chat transcript containing both text and voice messages. TAC ¶¶ 39-40.

3 In February 2021, Ginegar sued Slack in the District of Colorado, alleging infringement of  
4 two patents: the '865 Patent and U.S. Patent No. 9,367,521 (“the '521 Patent”). Dkt. No. 1. The  
5 complaint was later amended and the case transferred to this district in early January 2022. Dkt.  
6 Nos. 27, 47. Slack moved to dismiss the amended complaint two weeks later. Dkt. No. 55.

7 I granted Slack’s motion to dismiss, finding that the claims at issue recited an abstract idea  
8 and failed to include an inventive concept elevating them to more than a patent on the abstract idea  
9 itself. First MTD Order at 1:13-19. I granted Ginegar leave to amend only its claim premised on  
10 Claim 8 of the '865 Patent, finding that it had “alleged some facts supporting that the multi-modal  
11 transcript unification logic . . . is an improvement in instant messaging technology and/or an  
12 inventive concept.” *Id.* at 21 n.6. I further stated that should Ginegar file an amended complaint,  
13 “it must allege facts supporting how the logic element improves the technology of instant message  
14 systems . . . or how it constitutes an inventive concept.” *Id.*

15 Ginegar filed a Second Amended Complaint (“SAC”) on June 28, 2022, that went beyond  
16 the scope of amendment that I had permitted by alleging infringement of other claims in the '865  
17 Patent and '521 Patent. Dkt. No. 72. Ginegar then filed an unopposed motion for leave to file its  
18 TAC, which I granted. Dkt. Nos. 73, 76. Ginegar filed the TAC on July 12, 2022, and Slack  
19 again moved to dismiss. Dkt. Nos. 77, 78.

### 20 LEGAL STANDARD

21 Under Federal Rule of Civil Procedure 12(b)(6), a court must dismiss a complaint if it fails  
22 to state a claim upon which relief can be granted. To survive a Rule 12(b)(6) motion, the plaintiff  
23 must allege “enough facts to state a claim to relief that is plausible on its face.” *Bell Atl. Corp. v.*  
24 *Twombly*, 550 U.S. 544, 570 (2007). A claim is facially plausible when the plaintiff pleads facts  
25 that allow the court to “draw the reasonable inference that the defendant is liable for the  
26 misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citation omitted). There must  
27 be “more than a sheer possibility that a defendant has acted unlawfully.” *Id.* While courts do not  
28 require “heightened fact pleading of specifics,” a plaintiff must allege facts sufficient to “raise a

1 right to relief above the speculative level.” *See Twombly*, 550 U.S. at 555, 570.

2 In deciding whether the plaintiff has stated a claim upon which relief can be granted, the  
3 court accepts her allegations as true and draws all reasonable inferences in her favor. *See Usher v.*  
4 *City of Los Angeles*, 828 F.2d 556, 561 (9th Cir. 1987). However, the court is not required to  
5 accept as true “allegations that are merely conclusory, unwarranted deductions of fact, or  
6 unreasonable inferences.” *See In re Gilead Scis. Sec. Litig.*, 536 F.3d 1049, 1055 (9th Cir. 2008).

7 “[I]n many cases it is possible and proper to determine patent eligibility under 35 U.S.C. §  
8 101 on a Rule 12(b)(6) motion.” *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1373 (Fed.  
9 Cir. 2016). However, “plausible factual allegations may preclude dismissing a case under § 101  
10 where, for example, nothing on the record refutes those allegations as a matter of law or justifies  
11 dismissal under Rule 12(b)(6).” *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d  
12 1121, 1125 (Fed. Cir. 2018) (citations and internal modifications omitted). As the Federal Circuit  
13 stated in *Aatrix*:

14 [P]atentees who adequately allege their claims contain inventive concepts survive a  
15 § 101 eligibility analysis under Rule 12(b)(6). . . . While the ultimate determination  
16 of eligibility under § 101 is a question of law, like many legal questions, there can  
17 be subsidiary fact questions which must be resolved en route to the ultimate legal  
determination. . . . Whether the claim elements or the claimed combination are  
well-understood, routine, conventional is a question of fact.

18 882 F.3d at 1126-28.

## 19 DISCUSSION

20 There are four statutory categories of subject matter than can be patented: processes,  
21 machines, manufactures, and compositions. 35 U.S.C. § 101. Laws of nature, natural phenomena,  
22 and abstract ideas are considered ineligible subject matter and are not patentable. *See Diamond v.*  
23 *Chakrabarty*, 447 U.S. 303, 309 (1980). “Whether a claim is drawn to patent-eligible subject  
24 matter under § 101 is a threshold inquiry, and any claim of an application failing the requirements  
25 of § 101 must be rejected even if it meets all of the other legal requirements of patentability.” *In*  
26 *re Bilski*, 545 F.3d 943, 950 (2008) *aff’d but criticized sub nom. Bilski v. Kappos*, 561 U.S. 593  
27 (2010).

28 The Supreme Court established a two-step inquiry, known as the *Mayo/Alice* test, for

1 determining whether a claim recites patentable subject matter. *See Mayo Collaborative Servs. v.*  
2 *Prometheus Labs., Inc.*, 566 U.S. 66, 77-78 (2012); *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573  
3 U.S. 208, 217-18 (2014). At the first step, the court must determine whether the claim is directed  
4 to an ineligible concept. *Mayo*, 566 U.S. at 77-78. If so, the court moves to the second step,  
5 where it considers whether the claim recites additional elements that “transform the nature of the  
6 claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (citing *Mayo*, 566 U.S. at 78).  
7 The Supreme Court has described this second step as “search for an inventive concept”—  
8 something that adds “significantly more” to the otherwise-ineligible concept. *Id.* at 217-18 (citing  
9 *Mayo*, 566 U.S. at 72-73).

#### 10 **I. Whether Claim 8 is Directed to an Ineligible Concept**

11 Step one of the *Mayo/Alice* framework “applies a stage-one filter to claims, considered in  
12 light of the specification, based on whether their character as a whole is directed to excluded  
13 subject matter.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (citation  
14 and quotation marks omitted). “In cases involving software innovations, this inquiry often turns  
15 on whether the claims focus on the specific asserted improvement in computer capabilities or,  
16 instead, on a process that qualifies as an abstract idea for which computers are invoked merely as a  
17 tool.” *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018) (citation and  
18 quotation marks omitted). The Federal Circuit has found software inventions “to be patent-  
19 eligible where they have made non-abstract improvements to existing technological processes and  
20 computer technology.” *Koninklijke KPN N.V. v. Gemalto M2M GmbH*, 942 F.3d 1143, 1150  
21 (Fed. Cir. 2019) (citing cases).

22 But “[a]n improved result, without more stated in the claim, is not enough to confer  
23 eligibility to an otherwise abstract idea. To be patent-eligible, the claims must recite a specific  
24 means or method that solves a problem in an existing technological process.” *Id.* (citing cases).  
25 The Federal Circuit underscored this in *TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1293 (Fed. Cir.  
26 2020), noting that claims have been deemed directed to eligible matter where they focused “on a  
27 solution to a problem specifically arising in the realm of computer networks or computers” or  
28 where they identified “a specific improvement in computer capabilities or network functionality,

1 rather than only claiming a desirable result or function.” And both the Supreme Court and the  
 2 Federal Circuit also instruct courts to “compare claims at issue to those claims already found to be  
 3 directed to an abstract idea in previous cases.” *Enfish*, 822 F.3d at 1334.

4 I previously held that Claim 8 was directed to an abstract idea of combining different  
 5 message types into a unified transcript. First MTD Order at 17:15-17 (citing *Interval Licensing*  
 6 *LLC v. AOL, Inc.*, 896 F.3d 1335, 1345 (Fed. Cir. 2018) (“claims directed to a single display of  
 7 information collected from various sources are abstract”). I further held that (i) the additional  
 8 recited elements were not tied to an improvement in the technology of the instant messaging  
 9 system and that (ii) Ginegar only made conclusory allegations about the multi-modal transcript  
 10 unification logic and did not explain how it improves the technology. *Id.* at 17:18-18:14.

11 The TAC alleges that the logic element improves the technology of instant messaging  
 12 systems “because it solves a shortcoming in the prior art” by “automatically log[ging] a unified  
 13 chat transcript that contains both text and voice messages.” TAC ¶ 27.<sup>1</sup> The question is whether  
 14 the claim recites this with sufficient specificity, or whether it only claims a desirable result.

15 According to Slack, the TAC again falls short. MTD at 6:12-13. It argues that the TAC  
 16 either repeats the SAC’s conclusory allegations or adds new, also conclusory allegations that “do  
 17 nothing to explain how the logic element specifically operates or otherwise improves the  
 18 technology of instant message systems.” *Id.* at 7:1-4. Moreover, Slack contends, the TAC does  
 19 not explain “how ‘log[ging] a unified chat transcript that contains both text and voice messages’ is

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21 <sup>1</sup> The TAC also alleges that the logic element improves instant messaging technology because it  
 22 “allows conversants to use text and voice in a single chat session.” TAC ¶ 27. As Slack notes,  
 23 other allegations in the TAC, as well as the ’865 Patent itself, belie this. Mot. to Dismiss  
 24 (“MTD”) [Dkt. No. 78] 8:7-16. In describing the background of the invention, the ’865 Patent  
 25 states that “when involved in a chat session, a user may converse with another user by providing a  
 26 combination of text and audio messages in the chat session.” ’865 Patent at 1:44-46. The TAC  
 27 also asserts that “[t]he prior art also taught the use of multi-modal communication . . . where users  
 28 communicate via different modes of communication, such as text and audio, in a single chat  
 session.” TAC ¶ 15. Somewhat confusingly, the following sentence then alleges that “[u]sers  
 could not chat with each other by providing a combination text and message messages [sic] in the  
 chat session.” *See id.* Ginegar does not appear to respond to Slack’s argument or otherwise  
 explain this apparent discrepancy, instead focusing on the logic element’s purported improvement  
 of logging the unified chat transcript. *See generally* *Oppo*. [Dkt. No. 81]. Because the ’865 Patent  
 indicates that the prior art allowed conversants to use both text and audio in a single instant  
 message session, and because Ginegar does not argue otherwise, I too will focus on the transcript  
 as the improvement at issue.

1 any different from traditional methods of data combination and recording.” *Id.* at 7:8-10.

2 In response, Ginegar argues that Claim 8 improves computer functionality and solves a  
3 problem specifically arising in the realm of computers. *Oppo.* at 8:24-27. According to Ginegar,  
4 before the invention of the ’865 Patent, instant message users could communicate via text or audio  
5 in real-time but “could not go back later and review the entirety of their communications as they  
6 switched between text and audio.” *Id.* at 8:27-9:4 (citing TAC ¶¶ 13-15, 17-18; ’865 Patent at  
7 1:44-56). Instead, users would only find a chronological transcript of the text communications  
8 and separately stored individual audio files—if the audio conversation was even saved. *Id.* at 9:5-  
9 8 (citing ’865 Patent at 1:51-56). Ginegar contends that the logic element recited in Claim 8  
10 solves this problem by “automatically creating a unified multi-modal transcript that included both  
11 the text of the conversation and the audio files in one chronological and complete transcript.” *Id.*  
12 at 9:11-15 (citing TAC ¶¶ 26-38; ’865 Patent at 2:32-43, 6:4-25).

13 Ginegar analogizes to *Data Engine Technologies LLC v. Google LLC*, 906 F.3d 999, 1007-  
14 08 (Fed. Cir. 2018), where the Federal Circuit held that the asserted claims, which were directed to  
15 a “specific method for navigating” electronic spreadsheets, were directed to patent-eligible subject  
16 matter. *See id.* at 10:3-11:3. The court held that the method “provide[d] a specific solution to  
17 then-existing technological problems in computers and prior art electronic spreadsheets,” which  
18 were cumbersome to navigate, “by providing a highly intuitive, user-friendly interface with  
19 familiar notebook tabs for navigating the three-dimensional worksheet environment” that allowed  
20 users to locate information more simply and quickly. *Data Engine Techs.*, 906 F.3d at 1008-09.  
21 Similarly, Ginegar argues, Claim 8 “addresses what is otherwise an inefficient, burdensome, and  
22 sometimes completely missing instant messaging process, by providing a user friendly, efficient,  
23 and comprehensive transcript of text and audio conversations.” *Oppo.* at 10:23-25.

24 Finally, Ginegar asserts that Slack wrongly focuses on how the invention is accomplished,  
25 arguing that this analysis applies to enablement under section 112 of the Patent Act, not eligibility  
26 under section 101. *Id.* at 11:4-14 (citing *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d  
27 1285, 1302 (Fed Cir. 2020)). Under section 101, Ginegar argues, all it must show is that the claim  
28 “goes beyond ‘stating a functional result.’” *Id.* at 11:15-16 (citing *Am. Axle*, 967 F.3d at 1302).

1 Slack has the better argument. Although Ginegar identifies an improvement to instant  
2 messaging technology—automatically creating a single chat transcript with both text and audio  
3 messages—it does not explain the specific means or method underlying the improvement. It  
4 focuses only on the desired result: the unified chat transcript.

5 The cases that Ginegar rely on are distinguishable, primarily because the claims that were  
6 directed to a technological improvement or solution recited a level of detail not found in Claim 8.  
7 In *Finjan*, the patent at issue claimed a “behavior-based” method to virus scanning on computers.  
8 879 F.3d at 1303-04. The Federal Circuit held that the asserted claims recited “more than a mere  
9 result,” instead reciting “specific steps—generating a security profile that identifies suspicious  
10 code and linking it to a downloadable—that accomplish the desired result.” *Id.* at 1305-06.

11 In *Data Engine Technologies*, the asserted patent solved a technological problem in  
12 computers “by providing a highly intuitive, user-friendly interface with familiar notebook tabs for  
13 navigating the three-dimensional worksheet environment.” 906 F.3d at 1008. But the claim at  
14 issue recited “specific steps detailing the method of navigating through spreadsheet pages within a  
15 three-dimensional spreadsheet environment using notebook tabs.” *Id.* The claim required  
16 “displaying on a screen display a row of spreadsheet page identifiers,” which each “being a  
17 notebook tab.” *Id.* It also required “at least one user-settable identifying character to label the  
18 notebook tab” and described “navigating through the various spreadsheet pages through selection  
19 of the notebook tabs.” *Id.* Finally, the claim required a formula using those characters to “operate  
20 on information spread between different spreadsheet pages that are identified by their tabs.” *Id.*  
21 In other words, the asserted claim did not just claim a technological solution and improvement to  
22 computer functionality. It did this *and* identified the “specific interface and implementation” for  
23 accomplishing that solution and improvement. *Id.* at 1008-09.

24 *Data Engine Technologies* relied in part on *Core Wireless Licensing S.A.R.L. v. LG*  
25 *Electronics, Inc.*, 880 F.3d 1356, 1362-63 (Fed. Cir. 2018), where the Federal Circuit also held  
26 that the asserted claims were directed to an “improved user interface for computing devices” and  
27 disclosed a “particular” and “specific” manner of summarizing and displaying a limited set of  
28 information to the user. Again, the claims recited a certain level of detail: the “particular manner



1 by which the summary window must be accessed”; the limited data set listed in that window; and  
2 the window’s display. *Core Wireless*, 880 F.3d at 1362-63.

3 In contrast, Claim 8 lacks any such details when it comes to the asserted improvement,  
4 logging the unified chat transcript. The claim recites certain steps regarding the logic element  
5 itself, including that it establishes a single instant messaging session between two users, receives  
6 text messages, embeds voice messages, and classifies those messages by type. *See* ’865 Patent at  
7 6:4-25. Yet it does not explain how it “log[s] the classified voice and text messages in a single  
8 transcript of conversation.” *See id.* Ginegar’s argument that the logic element improves or solves  
9 a problem within instant messaging technology focuses on the prior art’s inability to log a single  
10 transcript containing multi-modal communications. *See* TAC ¶¶ 27-28. But “[a]n improved  
11 result, without more stated in the claim, is not enough to confer eligibility to an otherwise abstract  
12 idea.” *Koninklijke*, 942 F.3d at 1150. Claim 8 does not recite a “specific means or method” for  
13 accomplishing that result, beyond “log[ging] the classified voice and text messages in a single  
14 transcript.” *See id.*; ’865 Patent at 6:20-22. Without more, Claim 8 remains directed to an abstract  
15 idea: combining different message types into a single transcript.

16 For these reasons, Claim 8 is directed to an ineligible concept. Ginegar has not shown how  
17 the logic element recited in the claim improves or solves a problem in instant message systems,  
18 namely because it relies on an improved result (the unified chat transcript) and not the specific  
19 means or methods for accomplishing it. Accordingly, I must proceed to the second step of  
20 *Mayo/Alice* and determine whether the logic element adds an inventive concept.

## 21 **II. Whether Claim 8 Adds an Inventive Concept**

22 At step two of *Mayo/Alice*, the court must “search for an inventive concept” by  
23 “consider[ing] the elements of each claim both individually and as an ordered combination to  
24 determine whether the additional elements transform the nature of the claim into a patent-eligible  
25 application.” *Alice*, 573 U.S. at 217; *Enfish*, 822 F.3d at 1334 (citation and quotation marks  
26 omitted). For a concept to be inventive, it “must involve more than performance of ‘well-  
27 understood, routine, [and] conventional activities previously known to the industry.’” *Content*  
28 *Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347-48 (Fed. Cir.

1 2014) (citing in part *Alice*, 573 U.S. at 225).

2 On the last motion to dismiss, Ginegar failed to allege how the logic element elevated  
3 Claim 8 to patentable subject matter, relying on “only a vague reference to the specification and  
4 conclusory allegations in the FAC.” See First MTD Order at 20:10-13. More specifically, I found  
5 that Ginegar’s argument that automatically logging a chat transcript was an inventive concept  
6 amounted to “merely using a computer to perform an abstract idea.” *Id.* at 20:24-26 (citing *Alice*,  
7 573 U.S. at 223). I noted that even if this invention made recording a multi-modal instant message  
8 conversation “faster and more efficient,” “relying on a computer to perform routine tasks more  
9 quickly or more accurately is insufficient to render a claim patent eligible.” *Id.* at 20:26-21:2  
10 (citing *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015)).

11 According to Slack, Ginegar still has not shown how the logic element constitutes an  
12 inventive concept. MTD at 10:1-13. Instead, Slack argues, Ginegar only describes the step of  
13 recording both message types in one transcript. *Id.* (citing TAC ¶ 26). Moreover, Slack contends,  
14 Ginegar has not alleged facts showing that the logic element is not a “generic computer, network,  
15 or internet component, which does not constitute an inventive concept.” *Id.* at 10:14-15 (citing  
16 *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016)).

17 Slack’s primary argument is that the logic element amounts to the abstract idea itself and  
18 does not add “significantly more” as required to add an inventive concept. *Id.* at 11:14-13:1. It  
19 notes that the TAC “identifies the role of the logic element” as establishing concurrent voice and  
20 text messaging sessions, receiving both voice and text messages through those sessions, and  
21 automatically logging the unified chat transcript. *Id.* at 11:20-24 (citing TAC ¶¶ 22, 26). Because  
22 concurrent voice and text messaging were known in the prior art, Slack argues, and because  
23 Ginegar does allege that the first two steps were not routine or conventional, nor “carried out via  
24 anything other than generic, conventional, or routine components,” all that remains is the step of  
25 logging the unified transcript. *Id.* at 11:24-12:3. And that, according to Slack, is “nothing more  
26 than the abstract idea itself.” *Id.* at 12:2-3.

27 Slack relies in part on *ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 774 (Fed.  
28 Cir. 2019), where “the alleged ‘inventive concept’ that solves problems identified in the field” was

1 that electric vehicle charging stations were “network-controlled.” But the Federal Circuit held that  
2 “network control is the abstract idea itself, and ‘a claimed invention’s use of the ineligible concept  
3 to which it is directed cannot supply the inventive concept that renders the invention ‘significantly  
4 more’ than that ineligible concept.’” *Id.* (citing *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d  
5 1281, 1290 (Fed. Cir. 2018)).

6 In *BSG Tech*, to which Slack also analogizes, the Federal Circuit noted that the “only  
7 alleged unconventional feature” of the claims at issue was “the requirement that users are guided  
8 by summary comparison usage information or relative historical usage information.” *See* 899 F.3d  
9 at 1291. The court determined that this “simply restate[d] what we have already determined is an  
10 abstract idea,” and thus did not add “significantly more” to it. *Id.*

11 Ginegar responds that the logic element, “contained in a tangible, physical computer  
12 component,” constitutes an inventive concept because it solves deficiencies in the prior art by  
13 logging the unified chat transcript. *See* *Oppo*. at 13:14-14:5 (citing in part ’865 Patent at 1:38-56,  
14 5:65-6:25; TAC ¶¶ 25-29). It then cites to a handful of cases where the Federal Circuit held that  
15 solutions to deficiencies constituted inventive concepts, even if they used generic or well-known  
16 components. *Id.* at 13:25-14:5.

17 But Ginegar misses the point: the problem is not that Claim 8 uses generic or well-known  
18 components to carry out an inventive concept. It is that, as alleged, the logic element is not an  
19 inventive concept because it logs a unified chat transcript—*the abstract idea itself*. *See* TAC ¶¶  
20 27-29, 40-41. The use of an ineligible concept “cannot supply the inventive concept that renders  
21 the invention ‘significantly more’ than that ineligible concept.” *ChargePoint*, 920 F. 3d at 774.  
22 Moreover, Ginegar has not shown how the logic element amounts to more than using a computer  
23 to carry out that abstract idea, which does not confer eligibility. *See Alice*, 573 U.S. at 223 (“[I]f a  
24 patent’s recitation of a computer amounts to a mere instruction to implement an abstract idea on a  
25 computer, that addition cannot impart patent eligibility.”) (citation and modifications omitted); *see*  
26 *also Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017)  
27 (reciting a “generic computer element—a processor—and a series of generic computer  
28 ‘components’ that merely restate their individual functions” only “describes the functions of the

1 abstract idea itself”).

2 The cases that Ginegar cites are not particularly helpful because they do not speak directly  
3 to this issue. In *Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1318 (Fed. Cir. 2019), the  
4 question before the court was whether the claimed techniques were well-known or conventional.  
5 In *Aatrix*, it was whether the purported improvement was instead a routine and conventional use of  
6 a computer. 882 F.3d at 1129. And in *Berkheimer v. HP Inc*, 881 F.3d 1360, 1370 (Fed. Cir.  
7 2018), the Federal Circuit held that the lower court improperly granted summary judgment given  
8 the genuine dispute of fact over whether certain claims performed well-understood, routine, and  
9 conventional activities. Notably, the *Berkheimer* court held that other claims were ineligible  
10 because their limitations “amount to no more than performing the abstract idea of parsing and  
11 comparing data with conventional computer components.” *Id.*

12 It is that latter issue that renders Claim 8 ineligible, as were the claims in *ChargePoint* and  
13 *BSG Tech*. I agree with Ginegar that “[w]hether a particular technology is well-understood,  
14 routine, and conventional goes beyond what was simply known in the prior art.” *See Berkheimer*,  
15 881 F.3d at 1369. Whether the logic element recites an inventive concept does not depend on  
16 whether establishing a single instant message session or receiving both voice and text messages in  
17 that session were known in the prior art. But Ginegar does not explain how logging the unified  
18 chat transcript—which solves the problem identified in the TAC and ’865 Patent—is anything  
19 more than the abstract idea itself, let alone adds something “significantly more.” Nor has it shown  
20 how the logic element amounts to more than a computer carrying out that abstract idea.<sup>2</sup>

21 Because Ginegar has not adequately alleged that Claim 8 contains an inventive concept, it  
22 does not survive the section 101 eligibility analysis under *Mayo/Alice*. Slack’s motion to dismiss  
23 the infringement claim, which is premised on Claim 8 of the ’865 Patent, is GRANTED.

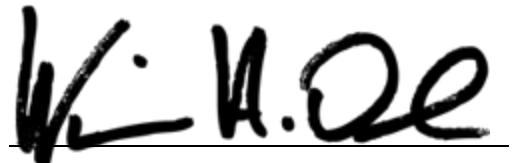
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25  
26 <sup>2</sup> Ginegar makes a similar burden of proof argument as it did on the prior motion to dismiss,  
27 arguing that under *Berkheimer*, the question of whether a claim element or elements are well-  
28 understood, routine, and conventional is a question of fact that must be proven by clear and  
convincing evidence. *Oppo*. at 14:7-18 (citing *Berkheimer*, 881 F.3d at 1368). It then contends  
that Slack has not met this burden. *See id.* But *Berkheimer* was appealed after summary  
judgment, not a motion to dismiss. 881 F.3d at 1362.

**CONCLUSION**

The motion to dismiss is GRANTED. Because Ginegar was unable to successfully amend the TAC after the First MDT Order, dismissal is without leave to amend. And as Claim 8 was the last potentially viable claim asserted by Ginegar, judgment shall be entered against it in this litigation.

**IT IS SO ORDERED.**

Dated: October 11, 2022



William H. Orrick  
United States District Judge

United States District Court  
Northern District of California

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