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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

MYMAIL, LTD.,  
Plaintiff,  
v.  
OOVVOO, LLC,  
Defendant.

Case No. 17-CV-04487-LHK  
**ORDER GRANTING OOVVOO’S  
MOTION FOR JUDGMENT ON THE  
PLEADINGS**  
Re: Dkt. No. 62

MYMAIL, LTD.,  
Plaintiff,  
v.  
IAC SEARCH & MEDIA, INC.,  
Defendant.

Case No. 17-CV-04488-LHK  
**ORDER GRANTING IAC’S MOTION  
FOR JUDGMENT ON THE  
PLEADINGS**  
Re: Dkt. No. 101

Plaintiff MyMail, Ltd. (“MyMail”) filed patent infringement actions against Defendants ooVoo, LLC (“ooVoo”) and IAC Search & Media, Inc. (“IAC”) (collectively, “Defendants”). MyMail alleges that Defendants infringe claims of U.S. Patent No. 8,275,863 (“the ’863 Patent”) and U.S. Patent No. 9,021,070 (“the ’070 Patent”). Before the Court are Defendants’ motions for

1 judgment on the pleadings. *See* ooVoo ECF No. 62; IAC ECF No. 101.<sup>1</sup> Having considered the  
2 submissions of the parties, the relevant law, and the records in these cases, the Court GRANTS  
3 Defendants’ motions for judgment on the pleadings.

4 **I. BACKGROUND**

5 **A. Factual Background**

6 **1. The Parties**

7 Plaintiff MyMail is a “Texas Limited Partnership” with a primary place of business in  
8 Athens, Texas. ooVoo ECF No. 1 ¶ 1. MyMail is the assignee of the ’863 and ’070 Patents. *Id.* ¶  
9 9. Defendant ooVoo is a Delaware corporation with its primary place of business in New York,  
10 New York. *Id.* ¶ 2. Defendant IAC is Delaware corporation with its primary place of business in  
11 Oakland, California. IAC ECF No. 1 ¶ 2.

12 **2. The Patents**

13 The ’863 Patent is titled “Method of Modifying a Toolbar.” ooVoo ECF No. 1 Exh. 1  
14 (’863 patent). It was filed on April 16, 2003, and issued on September 25, 2012. The ’070 Patent  
15 is titled “Dynamically Modifying a Toolbar.” *Id.* Exh. 2 (’070 patent). It was filed on June 20,  
16 2013, and issued on April 28, 2015. The two patents are related. Specifically, the ’070 Patent is a  
17 continuation of U.S. Application No. 13/573,311, which in turn is a continuation application of the  
18 ’863 Patent. Thus, the ’863 Patent and the ’070 Patent contain similar claims, have identical  
19 figures, and have nearly identical specifications.

20 The patents state that they relate “in general to digital data networks and, more particularly,  
21 to network access and to minimizing unauthorized interception of data and denial of network  
22 services.” ’863 patent at col. 1: 26-29. However, the patents also describe a method for updating  
23 toolbars or “button bars” that are displayed on Internet-connected devices such as personal  
24 computers. *Id.* at col. 10:7-11:16. Specifically, the patents disclose a toolbar database that stores  
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26 <sup>1</sup> “ooVoo ECF No.” denotes docket entries in Case No. 17-CV-4487-LHK, *MyMail, Ltd. v. ooVoo,*  
27 *LLC.* “IAC ECF No.” denotes docket entries in Case No. 17-CV-4488-LHK, *MyMail, Ltd. v. IAC*  
*Search & Media, Inc.*

1 data defining the attributes of the toolbar, like button captions and button functionality. *Id.* at col.  
2 10:38-11:4. When the device that displays the toolbar is connected to the Internet, the device  
3 executes software called a “client dispatch application” that initiates a “pinger” to update the  
4 toolbar database, along with other databases. *Id.* at col. 11:44-47, 12:16-17, 17:30-32. The pinger  
5 sends information about those databases to a network server, which in turn uses the sent  
6 information to determine whether any of the databases require updates. *Id.* at col. 11:47-52,  
7 12:17-24, 17:32-40. If any updates are required, the server sends those updates to the device. *Id.*  
8 at col. 17:40-66.

9 MyMail asserts claims 1–5, 9–13, 16–17, 19–20, and 23 of the ’863 Patent, but identifies  
10 claim 1 as the representative claim. ooVoo ECF No. 70 at 4. Similarly, MyMail asserts claims 1–  
11 13 and 15–22 of the ’070 Patent, but identifies claim 1 as the representative claim. *Id.* at 5. Claim  
12 1 of the ’863 Patent recites:

13 1. A method of modifying a toolbar, comprising the steps of:

14 a user Internet device displaying a toolbar comprising one or more buttons, the  
15 toolbar defined by toolbar data stored in one or more toolbar-defining databases, the  
16 toolbar data comprising a plurality of attributes, each attribute associated with a  
17 button of the toolbar, wherein for each button of the toolbar, at least one of the  
18 plurality of attributes identifying a function to be performed when the button is  
19 actuated by the user Internet device;

20 the user Internet device automatically sending a revision level of the one or more  
21 toolbar-defining databases to a predetermined network address;

22 a server at the predetermined network address determining, from the revision level,  
23 the user Internet device should receive the toolbar update data;

24 the user Internet device receiving toolbar update data from the Internet;

25 the user Internet device initiating without user interaction an operation to update the  
26 toolbar data in accordance with the toolbar update data received;

27 the user Internet device updating, by the operation, the toolbar data in accordance  
28 with the toolbar update data, thereby producing updated toolbar data, the updating  
comprising at least one of the following steps (a) and (b), each respectively  
comprising:

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(a) writing at least one new attribute to the original toolbar data, wherein the writing at least one new attribute to the toolbar data comprises changing the one or more buttons of the toolbar by adding a button; and

(b) updating at least one attribute of the toolbar data; and

the user Internet device displaying the toolbar as defined by the updated toolbar data.

'863 patent at col. 29:28-63. Similarly, claim 1 of the '070 Patent recites:

1. A method for dynamically modifying a toolbar, the method comprising:
  - displaying the toolbar, at a user Internet device, that includes one or more toolbar buttons, the toolbar defined by toolbar data stored in one or more toolbar-defining databases, the toolbar data comprising a plurality of toolbar button attributes associated with the one or more toolbar buttons of the toolbar, wherein at least one of the plurality of toolbar button attributes identifies a function to be performed by a specific toolbar button upon actuation of the specific toolbar button;
  - invoking, from the user Internet device without user intervention, communication of information associated with the one or more toolbar-defining databases to a server associated with a network address;
  - receiving, at the server, the information associated with the one or more toolbar-defining databases;
  - determining, based on the information associated with the one or more toolbar-defining databases, that the user Internet device should receive updated toolbar data;
  - receiving, at the user Internet device, the updated toolbar data in response to determining that the user Internet device should receive the updated toolbar data;
  - initiating, at the user Internet device and without user interaction, an operation to update the toolbar data in accordance with the received updated toolbar data;
  - updating the toolbar data at the user Internet device based on the operation and in accordance with the updated toolbar data, thereby updating the toolbar data, the updating comprising at least one member of a group comprising (a) and (b):

(a) updating the toolbar data to include at least one new attribute of the toolbar data to change the toolbar by adding a toolbar button to the toolbar; and

(b) updating the toolbar data to modify an attribute of at least one of the one or more toolbar buttons of the toolbar; and

1 displaying at the user Internet device the toolbar as defined by the updated toolbar  
2 data,

3 wherein the information associated with the toolbar data includes at least one  
4 member of a group comprising a revision level, version, time, date, user ID, account  
5 owner ID, PAP ID, IP address, session keys, billing data, name, address, account  
6 information, connection history, procedures performed by a user, group ID, e-mail  
7 address, e-mail ID, e-mail password, residential address, and phone number.

8 '070 patent at col. 29:40-30:20.

9 **B. Procedural History**

10 On November 18, 2016, MyMail filed its complaint for patent infringement against  
11 Defendant ooVoo in the United States District Court for the Eastern District of Texas. *See* ooVoo  
12 ECF No. 1. Then, on December 20, 2016, MyMail filed its complaint for patent infringement  
13 against Defendant IAC in the same court. *See* IAC ECF No. 1.

14 On February 2, 2017, ooVoo moved to dismiss MyMail's action for improper venue,  
15 answered MyMail's complaint, and asserted counterclaims against MyMail. ooVoo ECF Nos. 18  
16 & 19. On February 3, 2017, MyMail opposed ooVoo's motion to dismiss for improper venue.  
17 ooVoo ECF No. 24.

18 Similarly, on February 13, 2017, IAC moved to dismiss MyMail's action for improper  
19 venue, answered MyMail's complaint, and asserted counterclaims against MyMail. IAC ECF  
20 Nos. 16 & 17. On that same day, MyMail opposed IAC's motion to dismiss for improper venue.  
21 IAC ECF No. 20.

22 On February 23, 2017, MyMail answered ooVoo's counterclaims. ooVoo ECF No. 27.  
23 On March 6, 2017, MyMail answered IAC's counterclaims. IAC ECF No. 27.

24 On July 11, 2017, the United States District Court for the Eastern District of Texas  
25 transferred both of MyMail's actions to this district. ooVoo ECF No. 33; IAC ECF No. 70.  
26 MyMail's action against ooVoo was originally assigned to Magistrate Judge Susan van Keulen,  
27 *see* ooVoo ECF No. 35, while MyMail's action against IAC was originally assigned to Magistrate  
28 Judge Joseph Spero. *See* IAC ECF No. 72. However, MyMail declined Magistrate Judge

1 jurisdiction in both actions. ooVoo ECF No. 36; IAC ECF No. 74. Thus, on September 1, 2017,  
2 MyMail’s action against ooVoo was reassigned to the undersigned judge, ooVoo ECF No. 38,  
3 while MyMail’s action against IAC was reassigned to Judge Phyllis J. Hamilton. IAC ECF No.  
4 77.

5 On October 2, 2017, MyMail filed a motion to relate MyMail’s action against IAC to  
6 MyMail’s action against ooVoo. ooVoo ECF No. 48. On October 10, 2017, this Court granted  
7 MyMail’s motion to relate. ooVoo ECF No. 55. As a result, MyMail’s action against IAC was  
8 reassigned to the undersigned judge. IAC ECF No. 93.

9 On October 31, 2017, Defendants filed the instant motions for judgment on the pleadings.  
10 ooVoo ECF No. 62; IAC ECF No. 101 (collectively, “Mot.”). Defendants’ motions are identical.  
11 On November 21, 2017, MyMail opposed Defendants’ motions. ooVoo ECF No. 70; IAC ECF  
12 No. 109 (collectively, “Opp.”). MyMail filed the same opposition in both actions. On December  
13 5, 2017, Defendants filed the same reply in both actions. ooVoo ECF No. 71; IAC ECF No. 110  
14 (collectively, “Reply”).

15 **II. LEGAL STANDARD**

16 **A. Motion For Judgment on the Pleadings Under Federal Rule of Civil Procedure 12(c)**

17 “After the pleadings are closed—but early enough not to delay trial—a party may move for  
18 judgment on the pleadings.” Fed. R. Civ. P. 12(c). “Judgment on the pleadings is properly  
19 granted when, accepting all factual allegations in the complaint as true, there is no issue of  
20 material fact in dispute, and the moving party is entitled to judgment as a matter of law.” *Chavez*  
21 *v. United States*, 683 F.3d 1102, 1108 (9th Cir. 2012) (brackets and internal quotation marks  
22 omitted). Like a motion to dismiss under Rule 12(b)(6), a motion under Rule 12(c) challenges the  
23 legal sufficiency of the claims asserted in the complaint. *See id.* Indeed, a Rule 12(c) motion is  
24 “functionally identical” to a Rule 12(b)(6) motion, and courts apply the “same standard.” *Dworkin*  
25 *v. Hustler Magazine, Inc.*, 867 F.2d 1188, 1192 (9th Cir. 1989) (explaining that the “principal  
26 difference” between Rule 12(b)(6) and Rule 12(c) “is the timing of filing”); *see also U.S. ex rel.*

1 *Cafasso v. Gen. Dynamics C4 Sys.*, 637 F.3d 1047, 1054 n.4 (9th Cir. 2011).

2 Judgment on the pleadings should thus be entered when a complaint does not plead  
3 “enough facts to state a claim to relief that is plausible on its face.” *Bell Atl. Corp. v. Twombly*,  
4 550 U.S. 544, 570 (2007). “A claim has facial plausibility when the plaintiff pleads factual  
5 content that allows the court to draw the reasonable inference that the defendant is liable for the  
6 misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). “The plausibility standard is  
7 not akin to a probability requirement, but it asks for more than a sheer possibility that a defendant  
8 has acted unlawfully.” *Id.* (internal quotation marks omitted). For purposes of ruling on a Rule  
9 12(c) motion, the Court “accept[s] factual allegations in the complaint as true and construe[s] the  
10 pleadings in the light most favorable to the nonmoving party.” *Manzarek v. St. Paul Fire &*  
11 *Marine Ins. Co.*, 519 F.3d 1025, 1031 (9th Cir. 2008).

12 **B. Patent Eligibility Challenges Under 35 U.S.C. § 101**

13 Defendants’ motions argue that the patents-in-suit fail to claim patent-eligible subject  
14 matter under 35 U.S.C. § 101 in light of the U.S. Supreme Court’s decision in *Alice Corp. Pty.*  
15 *Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014). The ultimate question whether a claim  
16 recites patent-eligible subject matter under § 101 is a question of law. *Intellectual Ventures I LLC*  
17 *v. Capital One Fin. Corp.*, 850 F.3d 1332, 1338 (Fed. Cir. 2017) (“Patent eligibility under § 101 is  
18 an issue of law[.]”); *In re Roslin Inst. (Edinburgh)*, 750 F.3d 1333, 1335 (Fed. Cir. 2014) (same).  
19 However, the Federal Circuit has identified that there are certain factual questions underlying the  
20 § 101 analysis. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368-69 (Fed. Cir. 2018).  
21 Accordingly, a district court may resolve the issue of patent eligibility under § 101 by way of a  
22 motion for judgment on the pleadings. *See, e.g., buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350,  
23 1352 (Fed. Cir. 2014) (affirming determination of ineligibility made on motion for judgment on  
24 the pleadings).

25 Although claim construction is often desirable, and may sometimes be necessary, to  
26 resolve whether a patent claim is directed to patent-eligible subject matter, the Federal Circuit has

1 explained that “claim construction is not an inviolable prerequisite to a validity determination  
2 under § 101.” *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266,  
3 1273 (Fed. Cir. 2012). Where the court has a “full understanding of the basic character of the  
4 claimed subject matter,” the question of patent eligibility may properly be resolved on the  
5 pleadings. *Content Extraction*, 776 F.3d at 1349; *see also Genetic Techs. Ltd. v. Bristol-Myers*  
6 *Squibb Co.*, 72 F. Supp. 3d 521, 539 (D. Del. 2014), *aff’d sub nom. Genetic Techs. Ltd. v. Merial*  
7 *L.L.C.*, 818 F.3d 1369 (Fed. Cir. 2016).

8 **C. Substantive Legal Standards Applicable Under 35 U.S.C. § 101**

9 **1. Patent-Eligible Subject Matter Under 35 U.S.C. § 101**

10 Section 101 of Title 35 of the United States Code “defines the subject matter that may be  
11 patented under the Patent Act.” *Bilski v. Kappos*, 561 U.S. 593, 601 (2010). Under § 101, the  
12 scope of patentable subject matter encompasses “any new and useful process, machine,  
13 manufacture, or composition of matter, or any new and useful improvement thereof.” *Id.* (quoting  
14 35 U.S.C. § 101). These categories are broad, but they are not limitless. Section 101 “contains an  
15 important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not  
16 patentable.” *Alice*, 134 S. Ct. at 2354 (citation omitted). These three categories of subject matter  
17 are excepted from patent-eligibility because “they are the basic tools of scientific and  
18 technological work,” which are “free to all men and reserved exclusively to none.” *Mayo*  
19 *Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012) (citations omitted). The  
20 U.S. Supreme Court has explained that allowing patent claims for such purported inventions  
21 would “tend to impede innovation more than it would tend to promote it,” thereby thwarting the  
22 primary object of the patent laws. *Id.* However, the U.S. Supreme Court has also cautioned that  
23 “[a]t some level, all inventions embody, use, reflect, rest upon, or apply laws of nature, natural  
24 phenomena, or abstract ideas.” *Alice*, 134 S. Ct. at 2354 (alteration, internal quotation marks, and  
25 citation omitted). Accordingly, courts must “tread carefully in construing this exclusionary  
26 principle lest it swallow all of patent law.” *Id.*



1 In *Alice*, the leading case on patent-eligible subject matter under § 101, the U.S. Supreme  
2 Court refined the “framework for distinguishing patents that claim laws of nature, natural  
3 phenomena, and abstract ideas from those that claim patent-eligible applications of those  
4 concepts” originally set forth in *Mayo*, 566 U.S. at 77. *Alice*, 134 S. Ct. at 2355. This analysis,  
5 generally known as the “*Alice*” framework, proceeds in two steps as follows:

6 First, we determine whether the claims at issue are directed to one of those patent-  
7 ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before  
8 us?” To answer that question, we consider the elements of each claim both  
9 individually and “as an ordered combination” to determine whether the additional  
10 elements “transform the nature of the claim” into a patent-eligible application.  
11 We have described step two of this analysis as a search for an “‘inventive  
12 concept’”—*i.e.*, an element or combination of elements that is “sufficient to  
13 ensure that the patent in practice amounts to significantly more than a patent upon  
14 the [ineligible concept] itself.”

15 *Id.* (alterations in original) (citations omitted); *see also In re TLI Commc’ns LLC Patent Litig.*, 823  
16 F.3d 607, 611 (Fed. Cir. 2016) (describing “the now familiar two-part test described by the [U.S.]  
17 Supreme Court in *Alice*”).

18 **2. *Alice* Step One—Identification of Claims Directed to an Abstract Idea**

19 Neither the U.S. Supreme Court nor the Federal Circuit has set forth a bright-line test  
20 separating abstract ideas from concepts that are sufficiently concrete so as to require no further  
21 inquiry under the first step of the *Alice* framework. *See, e.g., Alice*, 134 S. Ct. at 2357 (noting that  
22 “[the U.S. Supreme Court] need not labor to delimit the precise contours of the ‘abstract ideas’  
23 category in this case”); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir.  
24 2014) (observing that the U.S. Supreme Court did not “delimit the precise contours of the ‘abstract  
25 ideas’ category” in *Alice* (citation omitted)). As a result, in evaluating whether particular claims  
26 are directed to patent-ineligible abstract ideas, courts have generally begun by “compar[ing]  
27 claims at issue to those claims already found to be directed to an abstract idea in previous cases.”  
28 *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016).

Two of the U.S. Supreme Court’s leading cases concerning the “abstract idea” exception  
involved claims held to be abstract because they were drawn to longstanding, fundamental

1 economic practices. *See Alice*, 134 S. Ct. at 2356 (claims “drawn to the concept of intermediated  
2 settlement, *i.e.*, the use of a third party to mitigate settlement risk” were directed to a patent-  
3 ineligible abstract idea); *Bilski*, 561 U.S. at 611-12 (claims drawn to “the basic concept of  
4 hedging, or protecting against risk” were directed to a patent-ineligible abstract idea because  
5 “[h]edging is a fundamental economic practice long prevalent in our system of commerce and  
6 taught in any introductory finance class” (citation omitted)).

7 Similarly, the U.S. Supreme Court has recognized that information itself is intangible. *See*  
8 *Microsoft Corp. v. AT & T Corp.*, 550 U.S. 437, 451 n.12 (2007). Accordingly, the Federal  
9 Circuit has generally found claims abstract where they are directed to some combination of  
10 acquiring information, analyzing information, and/or displaying the results of that analysis. *See*  
11 *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1094-95 (Fed. Cir. 2016) (claims  
12 “directed to collecting and analyzing information to detect misuse and notifying a user when  
13 misuse is detected” were drawn to a patent-ineligible abstract idea); *Elec. Power Grp., LLC v.*  
14 *Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (claims directed to an abstract idea because  
15 “[t]he advance they purport to make is a process of gathering and analyzing information of a  
16 specified content, then displaying the results, and not any particular assertedly inventive  
17 technology for performing those functions”); *In re TLI Commc’ns LLC*, 823 F.3d at 611 (claims  
18 were “directed to the abstract idea of classifying and storing digital images in an organized  
19 manner”); *see also Elec. Power Grp.*, 830 F.3d at 1353–54 (collecting cases).

20 However, the determination of whether other types of computer-implemented claims are  
21 abstract has proven more “elusive.” *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790  
22 F.3d 1343, 1345 (Fed. Cir. 2015) (“[P]recision has been elusive in defining an all-purpose  
23 boundary between the abstract and the concrete[.]”). As a result, in addition to comparing claims  
24 to prior U.S. Supreme Court and Federal Circuit precedents, courts considering computer-  
25 implemented inventions have taken varied approaches to determining whether particular claims  
26 are directed to an abstract idea.

1 For example, courts have considered whether the claims “purport to improve the  
2 functioning of the computer itself,” *Alice*, 134 S. Ct. at 2359, which may suggest that the claims  
3 are not abstract, or instead whether “computers are invoked merely as a tool” to carry out an  
4 abstract process, *Enfish*, 822 F.3d at 1336; *see also id.* at 1335 (“[S]ome improvements in  
5 computer-related technology when appropriately claimed are undoubtedly not abstract, such as a  
6 chip architecture, an LED display, and the like. Nor do we think that claims directed to software,  
7 as opposed to hardware, are inherently abstract[.]”). The Federal Circuit has followed this  
8 approach to find claims patent-eligible in several cases. *See Visual Memory LLC v. NVIDIA*  
9 *Corp.*, 867 F.3d 1253, 1259–60 (Fed. Cir. 2017) (claims directed to an improved memory system  
10 were not abstract because they “focus[ed] on a ‘specific asserted improvement in computer  
11 capabilities’—the use of programmable operational characteristics that are configurable based on  
12 the type of processor” (quoting *Enfish*, 822 F.3d at 1336)); *McRO, Inc. v. Bandai Namco Games*  
13 *Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) (claims directed to automating part of a preexisting  
14 method for 3-D facial expression animation were not abstract because they “focused on a specific  
15 asserted improvement in computer animation, i.e., the automatic use of rules of a particular type”);  
16 *Enfish*, 822 F.3d at 1335–36 (claims directed to a specific type of self-referential table in a  
17 computer database were not abstract because they focused “on the specific asserted improvement  
18 in computer capabilities (i.e., the self-referential table for a computer database)”).

19 Similarly, the Federal Circuit has found that claims directed to a “new and useful  
20 technique” for performing a particular task were not abstract. *See Thales Visionix Inc. v. United*  
21 *States*, 850 F.3d 1343, 1349 (Fed. Cir. 2017) (holding that “claims directed to a new and useful  
22 technique for using sensors to more efficiently track an object on a moving platform” were not  
23 abstract); *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1048, 1050 (Fed. Cir. 2016)  
24 (holding that claims directed to “a new and useful laboratory technique for preserving  
25 hepatocytes,” a type of liver cell, were not abstract); *see also Diamond v. Diehr*, 450 U.S. 175,  
26 187 (1981) (holding that claims for a method to cure rubber that employed a formula to calculate  
27

1 the optimal cure time were not abstract).

2 Another helpful tool used by courts in the abstract idea inquiry is consideration of whether  
3 the claims have an analogy to the brick-and-mortar world, such that they cover a “fundamental . . .  
4 practice long prevalent in our system.” *Alice*, 134 S. Ct. at 2356; *see, e.g., Intellectual Ventures I*  
5 *LLC v. Symantec Corp.*, 838 F.3d 1307, 1317 (Fed. Cir. 2016) (finding an email processing  
6 software program to be abstract through comparison to a “brick-and-mortar” post office);  
7 *Intellectual Ventures I LLC v. Symantec Corp.*, 100 F. Supp. 3d 371, 383 (D. Del. 2015) (“Another  
8 helpful way of assessing whether the claims of the patent are directed to an abstract idea is to  
9 consider if all of the steps of the claim could be performed by human beings in a non-  
10 computerized ‘brick and mortar’ context.” (citing *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350,  
11 1353 (Fed. Cir. 2014)).

12 Courts will also (or alternatively, as the facts require) consider a related question of  
13 whether the claims are, in essence, directed to a mental process or a process that could be done  
14 with pencil and paper. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1147 (Fed.  
15 Cir. 2016) (claims for translating a functional description of a logic circuit into a hardware  
16 component description of the logic circuit were patent-ineligible because the “method can be  
17 performed mentally or with pencil and paper”); *CyberSource Corp. v. Retail Decisions, Inc.*, 654  
18 F.3d 1366, 1372 (Fed. Cir. 2011) (claim for verifying the validity of a credit card transaction over  
19 the Internet was patent-ineligible because the “steps can be performed in the human mind, or by a  
20 human using a pen and paper”); *see also, e.g., Mortg. Grader, Inc. v. First Choice Loan Servs.*  
21 *Inc.*, 811 F.3d 1314, 1324 (Fed. Cir. 2016) (claims for computer-implemented system to enable  
22 borrowers to shop for loan packages anonymously were abstract where “[t]he series of steps  
23 covered by the asserted claims . . . could all be performed by humans without a computer”).<sup>2</sup>

24  
25 <sup>2</sup> One court has noted that, like all tools of analysis, the “pencil and paper” analogy must not be  
26 unthinkingly applied. *See Cal. Inst. of Tech. v. Hughes Commc’ns Inc.*, 59 F. Supp. 3d 974, 995  
27 (C.D. Cal. 2014) (viewing pencil-and-paper test as a “stand-in for another concern: that humans  
engaged in the same activity long before the invention of computers,” and concluding that test was  
unhelpful where “error correction codes were not conventional activity that humans engaged in

1           Regardless of the particular analysis that is best suited to the specific facts at issue in a  
2 case, however, the Federal Circuit has emphasized that “the first step of the [*Alice*] inquiry is a  
3 meaningful one, i.e., . . . a substantial class of claims are *not* directed to a patent-ineligible  
4 concept.” *Enfish*, 822 F.3d at 1335. The court’s task is thus not to determine whether claims  
5 merely involve an abstract idea at some level, *see id.*, but rather to examine the claims “in their  
6 entirety to ascertain whether their character as a whole is directed to excluded subject matter,”  
7 *Internet Patents*, 790 F.3d at 1346.

8           **3. *Alice* Step Two—Evaluation of Abstract Claims for a Limiting Inventive Concept**

9           A claim drawn to an abstract idea is not necessarily invalid if the claim’s limitations—  
10 considered individually or as an ordered combination—serve to “transform the claims into a  
11 patent-eligible application.” *Content Extraction*, 776 F.3d at 1348. Thus, the second step of the  
12 *Alice* analysis (the search for an “inventive concept”) asks whether the claim contains an element  
13 or combination of elements that “ensure[s] that the patent in practice amounts to significantly  
14 more than a patent upon the [abstract idea] itself.” 134 S. Ct. at 2355 (citation omitted).

15           The U.S. Supreme Court has made clear that transforming an abstract idea to a patent-  
16 eligible application of the idea requires more than simply reciting the idea followed by “apply it.”  
17 *Id.* at 2357 (quoting *Mayo*, 566 U.S. at 72). In that regard, the Federal Circuit has repeatedly held  
18 that “[f]or the role of a computer in a computer-implemented invention to be deemed meaningful  
19 in the context of this analysis, it must involve more than performance of ‘well-understood, routine,  
20 [and] conventional activities previously known to the industry.’” *Content Extraction*, 776 F.3d at  
21 1347-48 (alteration in original) (quoting *Alice*, 134 S. Ct. at 2359); *see also Mortg. Grader*, 811  
22 F.3d at 1324-25 (holding that “generic computer components such as an ‘interface,’ ‘network,’  
23 and ‘database’ . . . do not satisfy the inventive concept requirement”); *Bancorp Servs.*, 687 F.3d at  
24 1278 (“To salvage an otherwise patent-ineligible process, a computer must be integral to the  
25 claimed invention, facilitating the process in a way that a person making calculations or

26  
27 before computers”).

1 computations could not.”).

2 Likewise, “[i]t is well-settled that mere recitation of concrete, tangible components is  
3 insufficient to confer patent eligibility to an otherwise abstract idea” where those components  
4 simply perform their “well-understood, routine, conventional” functions. *In re TLI Commc’ns*  
5 *LLC*, 823 F.3d at 613 (citation omitted); *see also id.* (ruling that “telephone unit,” “server,” “image  
6 analysis unit,” and “control unit” limitations were insufficient to satisfy *Alice* step two where  
7 claims were drawn to abstract idea of classifying and storing digital images in an organized  
8 manner). “The question of whether a claim element or combination of elements is well-  
9 understood, routine and conventional to a skilled artisan in the relevant field is a question of fact”  
10 that “must be proven by clear and convincing evidence.” *Berkheimer*, 881 F.3d at 1368. This  
11 inquiry “goes beyond what was simply known in the prior art.” *Id.* at 1369.

12 In addition, the U.S. Supreme Court explained in *Bilski* that “limiting an abstract idea to  
13 one field of use or adding token postsolution components [does] not make the concept patentable.”  
14 561 U.S. at 612 (citing *Parker v. Flook*, 437 U.S. 584 (1978)); *see also Alice*, 134 S. Ct. at 2358  
15 (same). The Federal Circuit has similarly stated that attempts “to limit the use of the abstract idea  
16 to a particular technological environment” are insufficient to render an abstract idea patent-  
17 eligible. *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (internal quotation  
18 marks and citation omitted); *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792  
19 F.3d 1363, 1366 (Fed. Cir. 2015) (“An abstract idea does not become nonabstract by limiting the  
20 invention to a particular field of use or technological environment, such as the Internet.”).

21 In keeping with these restrictions, the Federal Circuit has found that claims “necessarily  
22 rooted in computer technology in order to overcome a problem specifically arising in the realm of  
23 computer networks” can be sufficiently transformative to supply an inventive concept. *DDR*, 773  
24 F.3d at 1257; *see also id.* at 1248, 1259 (concluding that claims that addressed the “Internet-  
25 centric problem” of third-party merchant advertisements that would “lure . . . visitor traffic away”  
26 from a host website amounted to an inventive concept).

1 In addition, a “non-conventional and non-generic arrangement of known, conventional  
2 pieces” can amount to an inventive concept. *BASCOM Glob. Internet Servs., Inc. v. AT&T*  
3 *Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016). For example, in *BASCOM*, the Federal  
4 Circuit addressed a claim for Internet content filtering performed at “a specific location, remote  
5 from the end-users, with customizable filtering features specific to each end user.” *Id.* Because  
6 this “specific location” was different from the location where Internet content filtering was  
7 traditionally performed, the Federal Circuit concluded this was a “non-conventional and non-  
8 generic arrangement of known, conventional pieces” that provided an inventive concept. *Id.* As  
9 another example, in *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, the Federal Circuit held that  
10 claims relating to solutions for managing accounting and billing data over large, disparate  
11 networks recited an inventive concept because they contained “specific enhancing limitation[s]  
12 that necessarily incorporate[d] the invention’s distributed architecture.” 841 F.3d 1288, 1301  
13 (Fed. Cir. 2016), *cert. denied*, 138 S. Ct. 469 (Nov. 27, 2017). The use of a “distributed  
14 architecture,” which stored accounting data information near the source of the information in the  
15 disparate networks, transformed the claims into patentable subject matter. *Id.*

16 **4. Preemption**

17 In addition to these principles, courts sometimes find it helpful to assess claims against the  
18 policy rationale for § 101. The U.S. Supreme Court has recognized that the “concern that  
19 undergirds [the] § 101 jurisprudence” is preemption. *Alice*, 134 S. Ct. at 2358. Thus, courts have  
20 readily concluded that a claim is not patent-eligible when the claim is so abstract that it preempts  
21 “use of [the claimed] approach in all fields” and “would effectively grant a monopoly over an  
22 abstract idea.” *Bilski*, 561 U.S. at 612. However, the inverse is not true: “[w]hile preemption may  
23 signal patent ineligible subject matter, the absence of complete preemption does not demonstrate  
24 patent eligibility.” *FairWarning*, 839 F.3d at 1098 (alteration in original) (citation omitted).

25 **III. DISCUSSION**

26 Defendants’ motions for judgment on the pleadings contend that the asserted claims of the  
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1 patents-in-suit fall within the patent-ineligible “abstract ideas” exception to § 101. The Court  
2 applies the *Alice* framework described above to these claims. However, the Court need not  
3 individually analyze every claim if certain claims are representative. *See generally Alice*, 134 S.  
4 Ct. at 2359–60 (finding claims to be patent-ineligible based on analysis of one representative  
5 claim). Here, the parties agree that claim 1 of the ’863 Patent and claim 1 of the ’070 Patent are  
6 representative. Mot. at 16; Opp. at 5–6. Further, because these claims contain substantially  
7 similar wording and have nearly identical specifications, the Court analyzes the claims together.

8 **A. *Alice* Step One**

9 Step one of the *Alice* framework directs the Court to assess “whether the claims at issue are  
10 directed to [an abstract idea].” *Alice*, 134 S. Ct. at 2355. The step one inquiry “applies a stage-  
11 one filter to claims, considered in light of the specification, based on whether ‘their character as a  
12 whole is directed to excluded subject matter.’” *Enfish*, 822 F.3d at 1335 (citation omitted). Thus,  
13 the Court conducts its step one inquiry by first identifying what the “character as a whole” of  
14 claim 1 of the ’863 Patent and claim 1 of the ’070 Patent (collectively, “the claims”) are “directed  
15 to,” and then discussing whether this is an abstract idea. In distilling the character of a claim, the  
16 Court is careful not to express the claim’s focus at an unduly “high level of abstraction . . .  
17 untethered from the language of the claims,” but rather at a level consonant with the level of  
18 generality or abstraction expressed in the claims themselves. *Enfish*, 822 F.3d at 1337; *see also*  
19 *Thales Visionix*, 850 F.3d at 1347 (“We must therefore ensure at step one that we articulate what  
20 the claims are directed to with enough specificity to ensure the step one inquiry is meaningful.”).

21 Defendants argue that the claims at issue are directed to “updating software stored on a  
22 computer.” Mot. at 9. Defendants further assert that “[c]ourts uniformly have found claims  
23 directed to updating software stored on a computer to be abstract.” *Id.*

24 MyMail counters that the claims “are directed to a process for the modification of toolbar  
25 data over a network by adding a toolbar button or otherwise updating toolbar data without user  
26 interaction.” Opp. at 11. MyMail asserts that the claims cover “a specific improvement in the  
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1 performance of a software tool—a toolbar on an end-user’s device—by enabling toolbar data  
2 determining the specific information displayed by the toolbar to the user to be updated  
3 automatically without user intervention.” *Id.* at 8. According to MyMail, this improvement  
4 provides “a solution to a problem in the software arts.” *Id.* at 13.

5 Defendants reply that MyMail’s characterization of the claims “is not meaningfully  
6 different” from Defendants’ characterization, such that “[t]he claims are non-statutory no matter  
7 which characterization” is used. Reply at 2.

8 The Court finds that the claims are directed to a process for updating toolbar software over  
9 a network without user intervention. Specifically, the claims recite a process of (1) sending data  
10 from a toolbar database to a server; (2) analyzing the data to determine whether the toolbar needs  
11 to be updated; (3) if the toolbar needs to be updated, sending toolbar update data from the Internet;  
12 and (4) automatically updating the toolbar in accordance with the toolbar update data. *See* ’863  
13 patent at col. 29:28-63; ’070 patent at col. 29:40-col. 30:20. Although the claims recite adding a  
14 button or changing at least one attribute of an existing button on the toolbar, the focus of the  
15 claims is on the process by which the toolbar is updated. Further, the specifications of both the  
16 ’893 Patent and the ’070 Patent, to the extent they describe toolbar updates, make no mention of  
17 adding or changing a button. Thus, updating toolbar software over a network without user  
18 intervention accurately captures what the “character as a whole” of the claims is “directed to.”  
19 *Enfish*, 822 F.3d at 1335.

20 Based on comparisons of the claims at issue “to those claims already found to be directed  
21 to an abstract idea in previous cases,” *Enfish*, 822 F.3d at 1334, this Court concludes that the  
22 claims at issue are directed to an abstract idea. First, the Court finds that the claims in the instant  
23 case are similar to claims that fall within the category of gathering and processing information,  
24 which the Federal Circuit has established is an abstract idea. Specifically, in *FairWarning IP,*  
25 *LLC v. Iatric Systems, Inc.*, the Federal Circuit considered a set of claims that recited a method of  
26 detecting fraud and misuse of personal health information that “collects information regarding  
27

1 accesses of a patient’s personal health information, analyzes the information according to one of  
2 several rules . . . to determine if the activity indicates improper access, and provides notification if  
3 it determines that improper access has occurred.” 839 F.3d 1089, 1093 (Fed. Cir. 2016).  
4 *FairWarning* concluded that the claims were directed to an abstract idea because they were  
5 “directed to a combination” of three “abstract-idea categories”: (1) collecting information; (2)  
6 analyzing information; and (3) presenting the results of the collection and analysis of information.  
7 839 F.3d at 1093–94. Similarly, in *West View Research, LLC v. Audi AG*, 685 F. App’x 923, 926  
8 (Fed. Cir. 2017) (unpublished), the Federal Circuit held that claims that “do not go beyond  
9 receiving or collecting data queries, analyzing the data query, retrieving and processing the  
10 information constituting a response to the initial data query, and generating a visual or audio  
11 response to the initial data query” were directed to the abstract idea of collecting, analyzing, and  
12 displaying information.

13 Like the claims in *FairWarning* and *West View Research*, the claims in the instant case  
14 recite a process comprised of transmitting data, analyzing data, and generating a response to  
15 transmitted data. Specifically, the claims recite a process of receiving and analyzing data to  
16 determine whether a toolbar requires an update, and if so, sending updated toolbar data and  
17 updating the toolbar. Thus, similar to the claims in *FairWarning* and *West View Research*, the  
18 claims at issue “do not go beyond receiving or collecting data queries, analyzing the data query,  
19 retrieving and processing the information constituting a response to the initial data query,” and  
20 prompting a toolbar update in “response to the initial data query.” *West View Research*, 685 F.  
21 App’x at 926. Further, this last step of initiating an update upon receipt of updated toolbar data is  
22 similar to “generating a visual or audio response to [a] . . . data query” in that both processes  
23 involve prompting some sort of generic function in response to a transmission of data. *West View*  
24 *Research*, F. App’x at 926 (holding claim that included generating a visual or audio response to a  
25 data query is directed to the abstract idea of collecting, analyzing, and displaying information).

26 Second, the Court finds that the claims in the instant case are analogous to claims that have  
27

1 been held by other district courts to be directed to an abstract idea because they relate to using  
2 communications networks to update software stored on computers. For example, in *White*  
3 *Knuckle Gaming, LLC v. Electronic Arts, Inc.*, 2016 WL 3129133 (D. Utah June 2, 2016), *aff'd*,  
4 683 F. App'x 931 (Fed. Cir. 2017) (per curiam), the United States District Court for the District of  
5 Utah considered the patent-eligibility of claims directed to updating sports video game data stored  
6 on a computer via the Internet. Specifically, the claims at issue in *White Knuckle Gaming* were  
7 directed to a process that “allows a gaming company to update the software parameters of sports  
8 video games to reflect recent real-life occurrences”—including changes in “performance statistics,  
9 athletes’ appearances, and uniform appearances”—by sending updated data from a data server to  
10 the video game console through the Internet. *Id.* at \*1. The court concluded that those claims  
11 “recite[d] a simple internet-based method of updating the software of sports video games,” and  
12 thus were directed to the abstract idea of “updating software in sports video games.” *Id.* at \*3.  
13 Further, the court noted that the updating process was “performed on a conventional computer,  
14 server, and network,” and thus the claims disclosed only “conventional components performing  
15 basic, intended functions, in a routine, conventional manner.” *Id.*

16 The claims in *White Knuckle Gaming* are analogous to the claims in the instant case.  
17 Specifically, the claims in both cases are directed toward updating data stored on a computer via  
18 the Internet. Although *White Knuckle Gaming* involved video game data, while this case concerns  
19 toolbar data, the two types of data are not materially different. That is, just as the video game data  
20 in *White Knuckle Gaming* determined the characteristics of the athletes in a video game, the  
21 toolbar data in the instant case determine the characteristics of toolbar buttons displayed on an  
22 Internet-connected device. Further, both sets of claims recite only conventional and generic  
23 components performing routine functions to carry out their respective updating process.  
24 Relatedly, as Defendants point out, “neither set of claims recites any software algorithms to  
25 accomplish the updating process.” Reply at 8.

26 Similarly, in *Personalized Media Communications, LLC v. Amazon.com, Inc.*, 161 F. Supp.

1 3d 325 (D. Del. 2015), *aff'd*, 671 F. App'x 777 (Fed. Cir. 2016) (per curiam), the United States  
2 District Court for the District of Delaware addressed the patent-eligibility of, inter alia, claims  
3 directed to a process for updating the operating system software stored on a remote computer via a  
4 transmission network. Specifically, the claims at issue in *Personalized Media Communications*  
5 recited an updating process comprised of (1) transmitting information about the specific version of  
6 the operating system of a remote receiver station to a “signal detector”; (2) determining whether  
7 the specific version matches a “designated version”; (3) if the specific version matches the  
8 “designated version,” sending updated operating system instructions to the remote receiver station,  
9 erasing the remote receiver station’s previous operating system instructions, and storing the  
10 updated operating system instructions in the receiver station’s memory. *Id.* at 331–32. The court  
11 held that those claims were directed to “the abstract idea of updating operating instructions” and  
12 remarked that the claims “seem[ed] quite generic” and “involve[d] only checking a receiver  
13 station to see if it has the current operating instructions, and, if it does, not updating them.” *Id.* at  
14 332. The court also stated that “[o]ther than the fact that the method [disclosed by the claims] is  
15 implemented on a computer, it is no different from checking to see if a copy of the Federal Rules  
16 is up to date, and, if it is not, replacing it with a new one.” *Id.*

17 The claims at issue in the instant case are very similar to the claims that were found to be  
18 directed to an abstract idea in *Personalized Media*. Like the *Personalized Media* claims, the  
19 claims in the instant case recite a process of updating software stored on a computer that is  
20 comprised of transmitting information about the software, determining based on that information  
21 whether the software needs to be updated, and if so, sending updated data to the device containing  
22 the software and updating the software in accordance with the updated data. Thus, the claims in  
23 the instant case also appear to be “no different from checking to see if a copy of the Federal Rules  
24 is up to date, and, if it is not, replacing it with a new one.” *Personalized Media*, 161 F. Supp. 3d at  
25 332. Although MyMail insists that the claims in the instant case are distinguishable because they  
26 describe an updating process that occurs “automatically without user intervention,” MyMail’s  
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1 argument is unavailing. As the Federal Circuit has stated, “mere automation of manual processes  
2 using generic computers does not constitute a patentable improvement in computer technology.”  
3 *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017).

4 The claims in the instant case are also analogous to one set of claims considered in  
5 *Intellectual Ventures I, LLC v. Motorola Mobility LLC*, 81 F. Supp. 3d 356 (D. Del. 2015). In  
6 *Intellectual Ventures I*, the relevant claims, “[w]hen broken into their fundamental elements,”  
7 recited: “(1) presenting a directory of software updates at [a] user station; (2) selecting and  
8 transmitting the desired software updates; and (3) receiving the requested software updates.” *Id.* at  
9 365–66. The court in *Intellectual Ventures I* noted that those claims “generically recite[d] the  
10 steps of ‘presenting,’ ‘sending,’ and ‘receiving,’ with no description of the underlying  
11 programming.” *Id.* at 366. The court also stated that “the limitations provided by the dependent  
12 claims—that the software updates be ‘automatically installed on the user station’ over ‘the  
13 Internet’—do not make the claimed invention any less abstract.” *Id.* Based on this analysis, the  
14 court concluded that “the claims [were] directed to the abstract idea of distributing software  
15 updates to a computer.” *Id.*

16 The same is true of the claims at issue in the instant case. Specifically, like in *Intellectual*  
17 *Ventures I*, the focus of the instant claims is on distributing updated software to a computer  
18 through the Internet. Further, as in *Intellectual Ventures I*, the instant claims also “generically  
19 recite the steps of” “displaying,” “sending,” “determining,” “receiving,” and “initiating” an update  
20 “with no description of the underlying programming.” *Id.* Finally, although the limitations in the  
21 instant claims specify that the toolbar updates and modifications will be done “without user  
22 interaction” and “dynamically,” as the *Intellectual Ventures I* court stated, these limitations “do  
23 not make the claimed invention any less abstract.” *Id.*

24 Accordingly, the Court finds that the claims at issue in the instant case are directed to an  
25 abstract idea. The Court next analyzes *Alice* step two.

26 **B. *Alice* Step Two**

27

28

1            “In step two of the *Alice* inquiry, [the Court] search[es] for an ‘inventive concept sufficient  
2 to transform the nature of the claim into a patent-eligible application.’” *RecogniCorp, LLC v.*  
3 *Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (quoting *McRO*, 837 F.3d at 1312 (internal  
4 quotation marks omitted)). “To save the patent at step two, an inventive concept must be evident  
5 in the claims.” *Id.* This inventive concept “must be significantly more than the abstract idea  
6 itself,” *BASCOM*, 827 F.3d at 1349, “must be more than well-understood, routine, conventional  
7 activity,” *Affinity Labs of Texas, LLC v. DIRECTV*, 838 F.3d 1253, 1262 (Fed. Cir. 2016), “and  
8 cannot simply be an instruction to implement or apply the abstract idea on a computer.”  
9 *BASCOM*, 827 F.3d at 1349. For example, it may be found in an “inventive set of components or  
10 methods,” “inventive programming,” or an inventive approach in “how the desired result is  
11 achieved.” *Elec. Power Grp.*, 830 F.3d at 1355.

12            The Court finds that none of the elements of the claims at issue, assessed individually,  
13 provide an inventive concept. All of the hardware components recited in the claims are generic,  
14 conventional components. The claims recite a “user Internet device” and a server, and the  
15 specifications refer only to generic Internet-connected computers and servers. Additionally, the  
16 claims recite a “toolbar” with “one or more buttons,” but the specifications confirm that toolbars  
17 were already in widespread use. *See* ’863 patent at col. 10:8-13 (“All functions may be initiated  
18 through the human interface—a Toolbar (also described in the art as a button bar and basic  
19 examples of which may be found in many present day computer applications).”). Moreover, the  
20 claims call on these conventional components to perform their routine functions, including  
21 “displaying” a toolbar, “sending” and “receiving” information, “determining” something based on  
22 that information, and “initiating . . . an operation to update” the toolbar software. No language in  
23 the claims or the specifications “demonstrat[es] that the generic computer components function in  
24 an unconventional manner or employ sufficiently specific programming.” *Intellectually Ventures*  
25 *I*, 81 F. Supp. 3d at 367. Instead, the functions recited by the claims at issue—that is,  
26 “displaying,” “sending,” “receiving,” “determining,” and “initiating”—are “specified at a high  
27

1 level of generality,” which the Federal Circuit has found to be “insufficient to supply an inventive  
2 concept.” *Ultramercial*, 772 F.3d at 716.

3 In its opposition, MyMail relies on the fact that the claims specify that “updating” the  
4 toolbar is comprised of either (1) adding a button to the toolbar; or (2) updating at least one  
5 attribute of an existing button. Opp. at 19. However, no language from either the claims or the  
6 specifications suggests that adding a button or changing an existing button is anything beyond a  
7 “routine and conventional” result of a toolbar update. *DDR*, 773 F.3d at 1258–59. On the  
8 contrary, this claim limitation does nothing more than recite the expected results of any toolbar  
9 update. Nor is there any indication that adding or changing a button is an inventive or non-  
10 conventional way of achieving the “desired result” of updating a toolbar, or that it involves  
11 “inventive programming.” *Elec. Power Grp.*, 830 F.3d at 1355. Indeed, the claims clearly state  
12 that a toolbar’s attributes are defined “by toolbar data stored in one or more toolbar-defining  
13 databases,” and that updating the toolbar (and thereby adding a button or changing an existing  
14 button) is done simply by updating the data in the toolbar-defining databases. ’863 patent at col.  
15 29:28-63; ’070 patent at col. 29:40-30:20. As Defendants point out, “[t]here is nothing  
16 particularized or non-conventional about modifying a software system either by adding to or  
17 updating data in a database.” Reply at 5.

18 The Court also finds that the ordered combination of the elements in the claims at issue  
19 does not yield an inventive concept. MyMail seeks to invoke *DDR*, in which the Federal Circuit  
20 found that the challenged patent was valid because it “specif[ied] how interactions with the  
21 Internet are manipulated to yield a desired result—a result that overrides the routine and  
22 conventional sequence of events ordinarily triggered by the click of a hyperlink.” 773 F.3d at  
23 1258–59. However, the claims at issue do not recite a process for updating software that deviates  
24 from the “routine and conventional” updating process. *Id.* On the contrary, the claims disclose  
25 the conventional and commonsensical steps of checking toolbar data to determine whether the  
26 toolbar needs an update, and if so, updating the toolbar. Thus, much like the claims in *Intellectual*

1 *Ventures I*, “instead of overriding a routine sequence of events,” the instant claims apply generic  
2 components performing their routine functions “to automate the delivery of software updates.” 81  
3 F. Supp. 3d at 367. The specifications further confirm this conclusion because nothing in the  
4 specifications remotely suggests that the claims in the instant case produce a result that “overrides  
5 the routine and conventional sequence of events” for updating software on a computer. 773 F.3d  
6 at 1258–59. Finally, although the claims recite that certain steps are done “automatically” and  
7 “dynamically,” “not every invention that automates a process . . . is patentable.” *Procter &*  
8 *Gamble Co. v. Quantificare, Inc.*, 2017 WL 6497629, \*14 (N.D. Cal. Dec. 19, 2017). Indeed, “[a]  
9 general purpose computer with minimal programming can perform functions ‘automatically’ and  
10 ‘dynamically,’ and implementation of an abstract idea on such a computer is not an inventive  
11 concept.” *Clear with Computers, LLC v. Altec Industries, Inc.*, 2015 WL 993392, \*4 (E.D. Tex.  
12 Mar. 3, 2015). Accordingly, the Court finds that nothing in the ordered combination of elements  
13 recited in the claims at issue bring them outside the realm of the abstract idea of updating toolbar  
14 software over a network without user intervention.

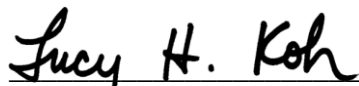
15 Because the Court finds at *Alice* step one that the claims in the instant case are directed to  
16 an abstract idea and at step two that there is no inventive concept sufficient to save the claims, the  
17 Court concludes that the asserted claims are patent-ineligible under § 101. Defendants’ motions  
18 for judgment on the pleadings are therefore GRANTED.

19 **IV. CONCLUSION**

20 For the foregoing reasons, the Court GRANTS Defendants’ motions for judgment on the  
21 pleadings.

22 **IT IS SO ORDERED.**

23  
24 Dated: March 16, 2018



LUCY H. KOH  
United States District Judge