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## District Court [Tool]barred From Ruling on Patent Eligibility without First Construing Claims

### *MYMAIL, LTD. v. OOVOO, LLC and IAC SEARCH & MEDIA INC.*

By: Francyn Brown and Reid Huefner | August 23, 2019

In *MyMail*, the Federal Circuit vacated the lower court’s judgment and remanded the case on the basis of the Federal Circuit’s new requirement that lower courts construe claims, first, before making any decision as to a patent’s eligibility. Here, the patent dispute arose between MyMail, LTD (“MyMail”) and ooVoo LLC, and IAC Search & Media Inc. (“Defendants”).<sup>1</sup> MyMail asserted patent infringement claims against Defendants for MyMail’s patents covering “methods of modifying toolbars that are displayed on Internet-connected devices such as personal computers.”<sup>2</sup> The district court concluded that MyMail’s patents were directed towards abstract, unpatentable technology; but, in its analysis, the district court failed to construe a claim term whose definition was in dispute. Specifically, the parties’ disputed the meaning of the term “toolbar.” The district court reasoned that the claims of MyMail’s patents were inherently abstract and, therefore, no claim construction was necessary to determine that the patents were ineligible.

In concluding that the MyMail patent claims were patent ineligible under 35 U.S.C. § 101, the district court determined that the claims failed both steps of the *Alice* test. In step one of the *Alice* test, the district court concluded that the patent claims are directed to a process for updating toolbar software over a network without user intervention. These claims were considered “abstract” ideas because they fall within the category of gathering and processing information and recite a process comprised of transmitting data, analyzing data, and generating a response to transmitted data and because they relate to using communications networks to update software stored on computers. In step two of the *Alice* test, the district court concluded that the claims fail to provide an inventive concept sufficient, reasoning that the claims recite generic, conventional components of interconnected computers and servers. Further, the district court reasoned that the specification of the MyMail patent confirmed that the toolbars were already in widespread use so that adding and/or changing a button based on data stored in toolbar-defining database is routine and conventional.

The Federal Circuit vacated and remanded, noting that, on a Rule 12 motion, “the district court must either adopt the non-moving party’s constructions or resolve the dispute to whatever extent is needed to conduct the § 101 analysis.”<sup>3</sup> Despite claim construction being a question of law, the Federal Circuit remanded and instructed the district court to make an initial claim construction determination and then decide whether the patent claims are still ineligible. The Federal Circuit explained that determining patent eligibility requires a full understanding of the basic character of the claimed subject matter and, therefore, if the parties raise a claim construction dispute, the district court must either explicitly adopted the non-moving party’s constructions or resolve the dispute before deciding the patent eligibility issue.

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<sup>1</sup> *MyMail, LTD. v. ooVoo, LLC and IAC Search & Media Inc.*, Case Nos. 2018-1758, 2018-1759 (Fed. Cir. 2019)

<sup>2</sup> *Id.* at \*3.

<sup>3</sup> *Id.* at \*9.