

# Intellectual Property & Technology Law Journal

Edited by the Technology and Proprietary Rights Group of Weil, Gotshal & Manges LLP

VOLUME 32 • NUMBER 9 • OCTOBER 2020

## District Court Again Finds Patents for Updating Toolbar Without User Intervention Invalid

Allison M. Lucier

On remand from the U.S. Court of Appeals for the Federal Circuit, the U.S. District Court for the Northern District of California once again found patents directed to a method of modifying computer toolbars without user interaction invalid under 35 U.S.C. § 101.

### BACKGROUND

MyMail asserted patents that are directed to a method of modifying computer toolbars without user interaction on internet connected devices. Specifically, the patents disclose a toolbar database that stores data defining the attributes of the toolbar, e.g., button captions and button functionality, such that when a device is connected to the internet, the server can send any updates to the toolbar database to the device.

The Northern District of California dismissed the complaint and found that the asserted claims were directed to the abstract idea of “updating toolbar software without user intervention.” The district court declined to address the parties’ claim construction dispute regarding the term “toolbar.”

---

**Allison M. Lucier**, a partner in the Boston office of Holland & Knight LLP, is a member of the firm’s Intellectual Property Group. Ms. Lucier, who focuses her practice on patent litigation, may be contacted at [allison.lucier@hklaw.com](mailto:allison.lucier@hklaw.com).

On appeal, the Federal Circuit vacated that, writing that determining patent eligibility requires a full understanding of the basic character of the claimed subject matter. Thus, if the parties raise a claim construction dispute at the Rule 12(c) stage, the district court must either adopt the non-moving party’s constructions or resolve the dispute to whatever extent is needed to conduct the Section 101 analysis. The Federal Circuit remanded for further proceedings.

On remand, the defendants’ renewed their motion for judgment on the pleadings. Following the Federal Circuit’s directive, the court held claim construction proceedings, construing the term “toolbar” as “a button bar that can be dynamically changed or updated via a Pinger process or a MOT script.”

Notably, the court adopted the construction proposed by MyMail, the patentee in this case.

On appeal, MyMail had argued that this construction of “toolbar” demonstrates that the claims of the patents are directed to a particular technological process for improving an exclusively computer-oriented device.

In finding that the claims were drawn to nonstatutory subject matter under Section 101, the district court applied the two-step *Mayo/Alice*<sup>1</sup> analysis.

---

## STEP ONE: ARE THE CLAIMS DIRECTED TO AN ABSTRACT IDEA?

When the court first considered *Alice* step one, it found that the claims were directed to the abstract idea of “a process for updating toolbar software over a network without user intervention,” noting that the “the focus of the claims is on the process by which the toolbar is updated.”

On remand, in light of the construction of the term “toolbar,” MyMail argued that the claims were directed to a specific improvement in the functioning of computing devices – namely, improving the updating process through the use of a Pinger process or a MOT script.

The court disagreed, maintaining that the claims were directed to the abstract idea of “updating toolbar software over a network without user intervention,” the claim construction of toolbar notwithstanding.

First, the court considered the character of the claims as a whole. The court noted that the Pinger process and the MOT script function were merely ways of performing the claimed steps of:

- (1) Sending data from a toolbar database to a server;
- (2) Analyzing the data to determine whether the toolbar needs to be updated;
- (3) If the toolbar needs to be updated, sending toolbar update data from the internet; and
- (4) Automatically updating the toolbar in accordance with the toolbar update data.

Thus, the court concluded that the construction of the term “toolbar” did not change the nature of the claims, as the claimed steps were nearly identical to the functions performed by the Pinger process and the MOT script function of the toolbar.

Second, the court compared the claims to those found to be directed to an abstract idea in prior cases and found the claims to be similar. Specifically, the court found the claims to be similar to the claims of:

- *FairWarning IP, LLC v. Iatric Systems, Inc.*,<sup>2</sup> finding claims directed to a method of detecting fraud and misuse of personal health information are directed to the abstract ideas of (1) collecting information, (2) analyzing information, and (3)

presenting the results of the collection and analysis of information;

- *West View Research, LLC v. Audi AG*,<sup>3</sup> finding claims directed to receiving, collecting, analyzing, retrieving and processing responses to a data query were directed to the abstract idea of collecting, analyzing and displaying information;
- *Personalized Media Communications, LLC v. Amazon.com, Inc.*,<sup>4</sup> finding claims directed to a process for updating the operating system software stored on a remote computer via a transmission network were directed to the abstract idea of updating operating instructions; and
- *Intellectual Ventures I, LLC v. Motorola Mobility LLC*,<sup>5</sup> finding claims directed to presenting, sending and receiving software updates were directed to the abstract idea of distributing software updates to a computer.

In its opposition, MyMail argued that the fact that the toolbar was updated via a Pinger process or a MOT script demonstrates the claims were directed to a specific improvement and not an abstract idea. The court dismissed this argument, finding that MyMail had failed to explain how this was a specific implementation of a solution to a problem in the prior art. The court noted that the specification fails to describe any problem associated with updating the toolbar, fails to identify either the Pinger process or a MOT script as an improvement, and fails to describe how either the Pinger process or a MOT script would be an improvement to the updating process.

## STEP TWO: IS THERE AN INVENTIVE CONCEPT?

MyMail argued that the use of the Pinger process/MOT script added the inventive step required by *Alice* step two. The court disagreed, finding that there was no inventive step because the claimed components, including the Pinger process/MOT script, are all conventional components performing their routine functions. Specifically, the court found that the claims require an internet connected device and a server, which perform routine functions such as displaying a toolbar, sending and receiving information, determining, and initiating

---

an update. The court further found that nothing in the claims or the specification showed these components functioned in an unconventional manner.

Likewise, the court found that the Pinger process and the MOT script did not add an inventive concept because they too use generic components in a conventional manner to update the toolbar. The court noted that its analysis accords with Judge Alan Lourie’s dissenting opinion in the Federal Circuit case. There, Judge Lourie found that “the claims at issue are clearly abstract regardless of claim construction” because “the specification is clear that neither the unclaimed pinger process nor the unclaimed MOT script can be the inventive concept.”

The court also distinguished *Berkheimer* and *Aatrix*, relying heavily on the specification. The court again noted that the specification did not identify

the toolbar’s ability to be dynamically changed as an inventive concept, did not identify how the toolbar’s ability to be dynamically changed solves any problem in the prior art, and did not identify how the either the Pinger process or the MOT script was used in a non-conventional manner.

### Notes

1. *Mayo v. Prometheus*, 566 U.S. 66 (2012); *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014).
2. *FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1093 (Fed. Cir. 2016).
3. *West View Research, LLC v. Audi AG*, 685 Fed. App’x 923, 926 (Fed. Cir. 2017).
4. *Personalized Media Communications, LLC v. Amazon.com, Inc.*, 161 F. Supp. 3d 325 (D. Del. 2015), *aff’d*, 671 F. App’x 777 (Fed. Cir. 2016).
5. *Intellectual Ventures I, LLC v. Motorola Mobility LLC*, 81 F. Supp. 3d 356 (D. Del. 2015).

Copyright © 2020 CCH Incorporated. All Rights Reserved.  
Reprinted from *Intellectual Property & Technology Law Journal*, October 2020, Volume 32,  
Number 9, pages 17–19, with permission from Wolters Kluwer, New York, NY,  
1-800-638-8437, www.WoltersKluwerLR.com

