

## MyMail Computer Toolbar Patent Survives PTAB Challenge

By **Matthew Bultman**

*Law360 (September 12, 2018, 6:33 PM EDT)* -- MyMail Ltd. beat a challenge to a patent related to computer toolbars at the Patent Trial and Appeal Board on Tuesday, a win that comes as MyMail seeks to overturn a court ruling that the patent is invalid under the U.S. Supreme Court's Alice test.

The board said in a final inter partes review decision that it was not convinced the disputed patent claims were anticipated or obvious. The IPR was brought by Unified Patents Inc., a tech industry consortium known to challenge patents owned by non-practicing entities.

"We determine that petitioner has not demonstrated by a preponderance of the evidence that any of challenged claims ... are unpatentable," the board wrote.

The patent, which dates back to the late 1990s, covers a method for updating a toolbar on a computer. According to MyMail, the invention solved a problem that existed at the time of keeping a user's toolbar up-to-date from a centralized server.

The PTAB has identified close to a dozen infringement cases involving the technology, including lawsuits MyMail previously brought against ESPN Inc. and Yahoo Inc. In March, U.S. District Judge Lucy H. Koh in California ruled that the patent was invalid because it covered nothing more than an abstract idea.

The U.S. Supreme Court in its landmark 2014 decision in *Alice v. CLS Bank* held that abstract ideas implemented on a computer are not patentable. MyMail has appealed Judge Koh's ruling to the Federal Circuit.

Another company that faced an infringement complaint, IAC Search & Media Inc., filed its own IPR challenge to the patent at the PTAB. The board denied review in June, finding IAC hadn't shown that any of the challenged claims were likely invalid.

ClientConnect Ltd. had also requested an IPR in November 2014. The case was settled after the board instituted review. Unified's challenge was "substantially the same" as the petition in that review, according to PTAB documents.

In its challenge, Unified argued that numerous claims were anticipated or obvious based on a collection of references that included several earlier patents.

"Well before the purported invention, it was widely known that software on a user's computer could be

automatically updated by use of revision levels sent to a server,” Unified wrote in its February 2017 petition. “Toolbars were similarly ubiquitous.”

“Not surprisingly,” it added, “printed publications predating the purported invention disclosed automatically updating toolbars using the claimed method.”

But the PTAB said Tuesday it was not persuaded.

For example, MyMail’s toolbar has a “pinger” process for obtaining updates to the toolbar database, according to PTAB documents. The board drew distinctions between this and an earlier patent cited by Unified, which described a program for displaying news stories.

“Although petitioner shows [the earlier invention] discloses that the categories can be automatically updated, petitioner does not persuade us that the ordinarily skilled artisan would have understood that [category buttons] could have been updated by a ... pinger process,” the board wrote.

Jon Wright of Sterne Kessler Goldstein & Fox PLLC, an attorney for MyMail, said they were pleased with the board’s decision.

On the other side, the chief IP counsel at Unified, Jonathan Stroud, said that as part of its decision, the PTAB took a narrow interpretation of “toolbar,” a key term in the patent. Were the patent to be revived by the Federal Circuit, he said, it's “highly unlikely that anyone would infringe with such a narrow claim construction.”

The patent at issue is U.S. Patent No. 8,275,863.

Unified is represented in-house by Jonathan Stroud and Roshan Mansinghani.

MyMail is represented by Jon Wright, Daniel Block and Steven Pappas of Sterne Kessler Goldstein & Fox PLLC.

The case is Unified Patents Inc. v. MyMail Ltd., case number IPR2017-00967, at the Patent Trial and Appeal Board.

--Editing by Haylee Pearl.