

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

EVERYMD.COM LLC,  
Plaintiff,

v.

FACEBOOK INC.,  
Defendant.

Case No. CV 16-06473-AB (JEMx)

**ORDER GRANTING  
DEFENDANT’S MOTION FOR  
JUDGMENT ON THE PLEADINGS**

Before the Court is Defendant Facebook Inc.’s Motion for Judgment on the Pleadings (“Motion”), filed December 2, 2016. (Dkt. No. 24.) Plaintiff EveryMD.com timely filed its Opposition on December 12, 2016, and Defendant timely filed its Reply on December 21, 2016.<sup>1</sup> (Dkt. Nos. 27, 29.) The Court heard oral argument on February 6, 2017, and took the matter under submission. (Dkt. No. 30.) For the following reasons, the Court **GRANTS** Defendant’s Motion.

///  
///

---

<sup>1</sup> Each party filed a Request for Judicial Notice, both of which were unopposed. (Dkt. Nos. 25, 28.) The Court **GRANTS** these requests to the extent the Court relied on the exhibits contained therein.

1           **I.       BACKGROUND**

2           **A. Patent Claims at Issue**

3           Plaintiff filed this action on October 7, 2016, alleging two claims for infringement  
4 of United States Patent Number 9,137,192 (“the ‘192 patent”), titled “Method and  
5 Apparatus for Generating Web Pages for members” (Dkt. No. 13, First Am. Compl.  
6 (“FAC”) ¶¶ 13, 20), and United States Patent Number 8,504,631 (“the ‘631 patent”),  
7 titled “Method Apparatus and Business System for Online Communications with Online  
8 and Offline Recipients.” (*Id.* at ¶¶ 23, 27.) Plaintiff alleges Defendant directly infringes  
9 these patents “by practicing the claimed invention” of these patents without Plaintiff’s  
10 authorization. (*Id.* at ¶¶ 20, 27.)

11           The two patents at issue share the same parent patent, No. 6,671,714, and are part  
12 of a multi-invention patent specification that enables Internet users to communicate with  
13 members of a group who have been designated web pages through which they may be  
14 contacted. Plaintiff provides as an example that this invention could serve groups of  
15 healthcare professionals by providing a searchable website through which potential  
16 patients, or “users” as described in the specification, could locate and communicate with  
17 doctors, or “recipients,” even if the professional is not active on the Internet. (RJN Ex.  
18 G (“‘631 Patent”) at col. 1:35-2:53.) Members of the given group would each have an  
19 Internet presence—in essence, a homepage—created for them that would display their  
20 contact information and provide users a means to initiate contact or otherwise  
21 communicate with members, either by providing a ranking, leaving a comment, or  
22 sending a message to the member through the user interface. (*Id.* at col. 2:9-17 (“[T]he  
23 invention . . . set[s] up a database of contact information for members of the group,  
24 creating an internet presence for each member of such group, creating an on-line user  
25 interface allowing a user to access the member’s created internet presence, and  
26 providing means of communications between the created internet presence and the  
27 member recipient.”).) User messages would be sent by email, or if members did not  
28 maintain an active Internet presence, the invention provided a method by which

1 messages could be transmitted by facsimile or telephone.

2 The '631 patent, which issued on August 6, 2013, "relates to the field of online  
3 communications, and more particularly to a method, apparatus, and business system for  
4 online communications with diverse online and offline recipients." (*Id.* at col. 1:29-31.)  
5 The patent presents a total of 10 claims, with only one independent claim.<sup>2</sup>

6 Claim 1 recites:

7 "A method for providing for communications by a server computer system among  
8 a first member of a group of members for whom said server computer system has  
9 created a first server created email box and a second member of said group of  
10 members for whom said server computer system has created a second server  
11 created email box, said method comprising the steps of:

12 Said server computer system transmitting a first server created web page to  
13 a first internet access device of said second member, said first server  
14 created web page comprising a message interface for receiving by  
15 said server computer system input data comprising a first message to  
16 said first member;

17 Said server computer system receiving first input data entered into said  
18 message interface from said first internet access device of said  
19 second member;

20 Said server computer system sending a second message to a telephone  
21 number associated with said first member notifying said first  
22 member of said first input data;

23 Said server computer system sending a third message to said first server

---

24  
25 <sup>2</sup> Plaintiff has not separately argued the patentability of any of the claims of either the  
26 '631 or '192 patents and has not presented "any meaningful argument for the  
27 distinctive significance of any claim limitations other than those included" in the first  
28 claim in the '631 and '192 patents. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d  
1350, 1352 (Fed. Cir. 2016). The Court therefore treats each patent's first claim as  
representative of all the claims in the respective patents for purposes of this motion.  
The Court addresses other independent or dependent claims as necessary.

1 created email box of said first member, said third message  
2 comprising said first input data.

3 (*Id.* at col. 14:13-35.) Stripped of its excess verbiage, claim 1 is directed to a method  
4 wherein a server-based system sends electronic messages to and from users and  
5 recipients by email, or by transmitting those messages by telephone or fax if the  
6 recipient does not have an Internet presence.

7 The ‘192 patent, which issued on September 15, 2015, “relates to the field of  
8 online communications, and more particularly to a method and apparatus for generating  
9 web pages for members.” (RJN Ex. H (“‘192 Patent”) col. 1:29-31.) The abstract of the  
10 ‘192 patent describes the invention simply as comprising “a method and apparatus for  
11 generating web pages for members.” (‘192 Patent at Abstract.) The patent presents a  
12 total of 20 claims, with two independent claims (claims 1 and 20).

13 Claim 1 recites:

14 A method for providing individual online presences for a each [sic] of a plurality  
15 of members of a group of members by an interface server computer comprising  
16 the steps of:

17 Maintaining by said interface server computer a database comprising  
18 information associated with each of said plurality of members at a  
19 database system connected to said interface server computer;  
20 allotting by said interface server computer individual URLs to each of said  
21 plurality of members by associating an individual URL with each  
22 individual member of said plurality of members in said database  
23 system;  
24 associating by said interface server computer an individual home page for  
25 each said individual member of said plurality of members with said  
26 individual URL allotted to said individual member in said database  
27 system, said individual home page comprising information from said  
28 database associated with said individual member; a first control for

1 submitting a comment about said individual member; and a second  
2 control separate from said first control for sending a message other  
3 than said comment to said individual member;  
4 receiving by said interface server computer an online request for said  
5 individual URL from a requesting source;  
6 providing said individual home page by said interface server computer to  
7 said requesting source.

8 (*Id.* at col.14:8-34.)

9 Claim 20 contains nearly identical elements as those in Claim 1, adding a  
10 limitation that not only allots, but also creates by the interface server computer an  
11 individual home page for each member. (*Id.* at col. 16:1-31.)

## 12 **B. Parties' Arguments**

13 Defendant argues in its motion that the claims in the '631 patent are not patent-  
14 eligible under 35 U.S.C. § 101 ("Section 101") because the claims are "directed to the  
15 abstract idea of storing a received message and notifying its recipient that the message  
16 has been received," which is "a longstanding practice of organizing human activity . . . ."  
17 (Mot. at 10.) Defendant contends the '631 patent fails both steps of the test outlined in  
18 *Alice Corp. Pty. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014) ("*Alice*")—the claims  
19 are directed to an unpatentable abstract idea and contain no additional inventive  
20 elements in computer or communications technology to make them patent eligible. (*Id.*  
21 at 10-11.)

22 Defendant likewise argues the claims in the '192 patent are not patent-eligible  
23 because they are "directed at a technique for providing individual home pages using  
24 well-known and generic Internet and Web technologies, and [are] not an improvement to  
25 those technologies." (Mot. at 14.)

26 Plaintiff, in turn, disagrees and argues the patent claims "turn otherwise generic  
27 computing devices into new, concrete machines and systems that provide previously . . .  
28 non-existing communications capabilities with online and offline recipients." (Opp'n at

1 9.) Plaintiff argues Defendant improperly interprets the claims at issue and asserts a  
2 claim construction hearing is necessary to adjudicate this motion. (*Id.* at 8.)

## 3 **II. LEGAL STANDARD**

### 4 **A. Motion for Judgment on the Pleadings**

5 Under Federal Rule of Civil Procedure 12(c) (“Rule 12(c)”), “[a]fter the pleadings  
6 are closed – but early enough not to delay trial – a party may move for judgment on the  
7 pleadings.” Fed. R. Civ. P. 12(c). A Rule 12(c) motion follows the same standard as a  
8 motion to dismiss. *Chavez v. United States*, 683 F.3d 1102, 1108 (9th Cir. 2012). A  
9 Rule 12(c) motion may thus be predicated on either (1) the lack of a cognizable legal  
10 theory, or (2) insufficient facts to support a cognizable legal claim. *See Balistreri v.*  
11 *Pacifica Police Dep’t*, 901 F.2d 696, 699 (9th Cir. 1990). In ruling on a Rule 12(c)  
12 motion, the Court “must accept all factual allegations in the complaint as true and  
13 construe them in the light most favorable to the non-moving party.” *Fleming v. Pickard*,  
14 581 F.3d 922, 925 (9th Cir. 2009). “Judgment on the pleadings is properly granted when  
15 there is no issue of material fact in dispute, and the moving party is entitled to judgment  
16 as a matter of law.” *Id.*

### 17 **B. Test for Patent Eligibility**

18 Section 101 “specifies four independent categories of inventions or discoveries  
19 that are eligible for patent protection: processes, machines, manufactures, and  
20 compositions of matter.” *Bilski v. Kappos*, 561 U.S. 593, 601 (2010). “In choosing such  
21 expansive terms . . . Congress plainly contemplated that the patent laws would be given  
22 wide scope.” *Id.* (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308–09 (1980)).  
23 Even so, the Supreme Court has carved out three exceptions to Section 101’s “broad  
24 patent-eligibility principles: ‘laws of nature, physical phenomena, and abstract ideas.’”  
25 *Id.* (quoting *Chakrabarty*, 447 U.S. at 309). These exceptions seek to protect concepts  
26 that “are part of the storehouse of knowledge of all men” and are “free to all men and  
27 reserved exclusively to none.” *Id.* (quoting *Funk Bros. Seed Co. v. Kalo Inoculant Co.*,  
28 333 U.S. 127, 130 (1948)).

1 The Supreme Court has also recognized that “[a]t some level, ‘all inventions . . .  
2 embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract  
3 ideas.’” *Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Services v. Prometheus*  
4 *Laboratories, Inc.*, 132 S. Ct. 1289, 1293 (2012) (“*Mayo*”)) (ellipses in original). “Thus,  
5 an invention is not rendered ineligible for patent simply because it involves an abstract  
6 concept. Applications of such concepts to a new and useful end . . . remain eligible for  
7 patent protection.” *Id.* (citations and quotations omitted).

8 Expanding on its decision in *Mayo*, the Supreme Court in *Alice* established a two-  
9 step process for resolving patent eligibility under Section 101. “First, a court must  
10 ‘determine whether the claims at issue are directed to one of those patent-ineligible  
11 concepts.’” *Timeplay, Inc v. Audience Entm’t*, No. CV-15-05202-SJO-JCx, 2015 WL  
12 9695321, at \*3 (C.D. Cal. Nov. 10, 2015) (quoting *Alice*, 134 S. Ct. at 2355). “If so,  
13 then the court must ask ‘[w]hat else is there in the claims,’ which requires consideration  
14 of ‘the elements of each claim both individually and as an ordered combination to  
15 determine whether the additional elements transform the nature of the claim into a  
16 patent-eligible application.’” *Id.* (quotations omitted). “In this second step, the court  
17 must ‘search for an inventive concept—i.e., an element or combination of elements that is  
18 sufficient to ensure that the patent in practice amounts to significantly more than a patent  
19 upon the ineligible concept itself.’” *Id.* (brackets and quotations omitted).

### 20 **III. DISCUSSION**

#### 21 **A. Timing of Patent Eligibility Inquiry**

22 As a threshold matter, the Court must first determine whether it may consider the  
23 question of patent eligibility without a claim construction hearing. “Patent eligibility  
24 under [Section] 101 is a question of law that may, in appropriate cases, be decided on the  
25 pleadings without the benefit of a claim construction hearing.” *Modern Telecom Sys.*  
26 *LLC v. Earthlink, Inc.*, No. SA-CV-14-0347-DOC, 2015 WL 1239992, at \*6 (C.D. Cal.  
27 Mar. 17, 2015) (citing *Content Extraction & Transmission LLC v. Wells Fargo Bank,*  
28 *Nat. Ass’n*, 776 F.3d 1343, 1349 (Fed. Cir. 2014) (affirming district court’s decision to

1 grant motion to dismiss based on patent-ineligible subject matter under Section 101  
2 without having a claim construction hearing)). Even so, it may be “desirable—and often  
3 necessary—to resolve claim construction disputes prior to a [Section] 101 analysis, for  
4 the determination of patent eligibility requires a full understanding of the basic character  
5 of the claimed subject matter.” *Bancorp Servs., L.L.C. v. Sun Life Assurance. Co. Can.*  
6 (*U.S.*), 687 F.3d 1266, 1273-74 (Fed. Cir. 2012); *but see Content Extraction*, 776 F.3d at  
7 1349 (“Although the determination of patent eligibility requires a full understanding of  
8 the basic character of the claimed subject matter, claim construction is not an inviolable  
9 prerequisite to a validity determination under [Section] 101.”).

10 Plaintiff argues this Court should delay consideration of the ‘192 and ‘631 patents  
11 for patent eligibility until after the Court holds a claim construction hearing. (Opp’n at 8  
12 (“Facebook’s motion is based on what EveryMD believes to be an improper  
13 interpretation of the claims by Facebook that is clearly incorrect and in any case disputed  
14 by EveryMD. Accordingly, it does not appear that the question of whether the ‘192 and  
15 ‘631 patents claim patent eligible subject matter can be determined under a motion for  
16 judgment on the pleadings.”).) Plaintiff fails to explain, however, how the claim  
17 construction process would significantly impact the Court’s assessment of patent  
18 eligibility in a way that the parties’ arguments do not already do. Instead, it appears that  
19 the claims of the ‘631 and ‘192 patents are “sufficiently straightforward that claim  
20 construction is not necessary to understand their content.” *See CMG Fin. Servs., Inc. v.*  
21 *Pac. Trust Bank, F.S.B.*, 50 F. Supp. 3d 1306, 1313-14 (C.D. Cal. 2014), *aff’d*, 616 F.  
22 App’x 420 (Fed. Cir. 2015) (considering patent eligibility on summary judgment prior to  
23 claims construction); *see also, e.g., Wolf v. Capstone Photography, Inc.*, No. 2:13-CV-  
24 09573, 2014 WL 7639820, at \*6 (C.D. Cal. Oct. 28, 2014) (considering patent eligibility  
25 on a motion for judgment on the pleadings prior to claims construction, observing that  
26 “beyond the conclusory statement that these terms would ‘have to be construed in order  
27 to determine whether they cover an abstract idea,’ plaintiff offers no argument as to how  
28 claim construction would aid the court in applying § 101 to these non-technical terms”);



1 *OIP Techs., Inc. v. Amazon.com, Inc.*, No. C-12-1233-EMC, 2012 WL 3985118, at \*5  
2 (N.D. Cal. Sept. 11, 2012), *aff'd*, 788 F.3d 1359 (Fed. Cir. 2015) (concluding 12(b)(6)  
3 motion under Section 101 was not premature where the plaintiff failed to explain how  
4 claims construction “would materially impact the § 101 analysis in the instant case”).  
5 As described in the claims, the ‘631 and ‘192 patents concern the relatively non-  
6 technical concepts of developing websites using servers, networks, and the Internet, and  
7 enabling electronic and telephonic communications initiated from these websites. These  
8 are not so “opaque such that claim construction would be necessary to flush out [their]  
9 contours” before determining whether the claims are patent eligible.<sup>3</sup> *See Lumen View*  
10 *Tech. v. Findthebest.com, Inc.*, 984 F. Supp. 2d 189, 205 (S.D.N.Y. 2013) (finding claim  
11 construction unnecessary before analyzing claims under Section 101) *quoted in CMG*  
12 *Fin. Servs., Inc.*, 50 F. Supp. 3d at 1313-14; *see also* Opp’n at 9 (describing ‘192 patent  
13 claims as presenting a method “performed by a server computer system for creating and  
14 serving web pages have a particular concrete form that turn[s] devices receiving those  
15 web pages (such as a computer) into new machines . . . .”). The Court ultimately finds  
16 that “the basic character of the claimed subject matter is readily ascertainable from the  
17 face of the patent, and that [P]laintiff’s arguments for delaying the § 101 inquiry are  
18 unpersuasive.” *Wolf*, 2014 WL 7639820, at \*6.

### 19 **B. Analysis of Patent Eligibility**

20 Having determined that Defendants’ Motion is not premature, the Court now  
21 addresses the Section 101 analysis for the patents at issue.

22 ///

23 ///

---

24 <sup>3</sup> Moreover, Plaintiff stipulated to additional case management deadlines by which  
25 Defendant would file a motion for judgment on the pleadings explicitly based on its  
26 theory of patent-ineligibility under 35 U.S.C. § 101. (*See* Dkt. No. 23.) The same  
27 stipulation set the claim construction hearing four months after the hearing on the  
28 motion for judgment on the pleadings. If Plaintiff thought claim construction was  
necessary to resolve this motion, it should have brought the matter to the attention of the  
Court, or at the very least, not stipulated to such a schedule.

1                                   **1.       Whether the ‘631 and ‘192 Patents are Directed to a**  
2                                                                                           **Patent-Ineligible Abstract Idea**

3           Turning to the first step in the *Alice/Mayo* test—whether the patent claims are  
4 “directed to an abstract idea”—courts in this district have adopted the approach in  
5 *Diamond v. Diehr*, 450 U.S. 175, 185 (1981) and held that the court should first  
6 “identify the purpose of the claim—in other words, what the claimed invention is trying  
7 to achieve—and ask whether that purpose is abstract.” *Cal. Inst. of Tech. v. Hughes*  
8 *Commc’ns Inc.*, 59 F. Supp. 3d 974, 991 (C.D. Cal. 2014); *accord Timeplay, Inc.*, 2015  
9 WL 9695321, at \*4; *Modern Telecom Sys. LLC v. Lenovo (United States) Inc.*, No. SA-  
10 CV-14-1266, 2015 WL 7776873, at \*6 (C.D. Cal. Dec. 2, 2015). “The *Diehr* majority  
11 took the correct approach of asking what the claim was trying to achieve, instead of  
12 examining the point of novelty.” *Hughes*, 59 F. Supp. 3d at 991-92. Thus, “courts  
13 should recite a claim’s purpose at a reasonably high level of generality,” using step one  
14 of the *Alice/Mayo* test as “a sort of ‘quick look’ test, the object of which is to identify a  
15 risk of preemption and ineligibility.” *Id.* Then, “[i]f a claim’s purpose is abstract, the  
16 court looks with more care at specific claim elements at step two.” *Id.*

17           Plaintiff argues the inventions claimed in the ‘192 and ‘631 patents “do not  
18 simply take an existing idea (abstract or otherwise) and implement that idea using  
19 computers. Instead, the processes claimed in the ‘192 and ‘631 patents turn otherwise  
20 generic computing devices into new, concrete machines and systems that provide  
21 previously (i.e. prior to November 1999) non-existing communications capabilities with  
22 online and offline recipients.” (Opp’n at 9.) In arguing these patents are not directed to  
23 an abstract idea, Plaintiff does not analyze them separately or provide any more  
24 meaningful distinction between the two.

25                                                                                           **a. The ‘631 Patent**

26           Claim 1 of the ‘631 patent claims a method for transmitting the email messages  
27 sent by users through the website to recipients without an online presence to their fax  
28 machine or their telephone, and then sending the user a reply message indicating the

1 status of the sent message. (‘631 Patent at col. 14:14-59.) Defendant characterizes this  
2 patent as “directed to the abstract idea of storing a received message and notifying its  
3 recipient that the message has been received. This idea is a longstanding practice of  
4 organizing human activity, as basic as the hotel front desk clerk who receives a package  
5 for a hotel guests, and then calls to inform the guests that the packages has been received  
6 and is awaiting pickup.” (Mot. at 10.)

7 Claim 1 of the ‘631 patent is directed to generic methods of routine business  
8 communications, and is therefore directed to an abstract idea. Just as a “user” might  
9 search a phonebook or directory and place a call and leave a message to inquire about  
10 pricing or services offered by a particular provider, a user of the claimed invention may  
11 search the database of members and send an email message to any one of them. The  
12 recipient would either receive the email in an email inbox, or if that particular recipient  
13 did not have an online presence, could receive a fax or a voicemail by telephone of the  
14 same message. This process is conceptually no different than thumbing through the  
15 phonebook or searching a healthcare insurance provider’s directory for in-network  
16 doctors, and placing a phone call and leaving a voicemail to schedule an appointment.  
17 As such, the claim is directed to a “longstanding commercial practice” and “method of  
18 organizing human activity” that falls “squarely within the realm of ‘abstract ideas’ as  
19 [the Supreme Court has] used that term.” *Alice*, 134 S. Ct. at 2356-57.

20 Plaintiff argues the claimed invention is not directed to an abstract idea because  
21 “the method claimed in claim 1 of the ‘631 creates both a particular and concrete  
22 machine and a particular and concrete communications system that together provide  
23 previously unavailable communications between an internet access device of a sending  
24 user and a telephone of a receiving user.” (Opp’n at 17.) Plaintiff’s characterization  
25 raises two points that merit discussion.

26 First, that the claim involves “particular and concrete” components is not itself  
27 dispositive. As the Federal Circuit has clarified, “a relevant inquiry at step one is ‘to ask  
28 whether the claims are directed to an improvement to computer functionality versus

1 being directed to an abstract idea.” *In re TLI Comm’ns LLC Patent Litig.*, 823 F.3d  
2 607, 611 (Fed. Cir. 2016) (“*TLI*”) (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327,  
3 1335 (Fed. Cir. 2016). Claims involving the latter include those that “simply add  
4 conventional computer components to well-known business practices or consist only of  
5 generalized steps to be performed on a computer using conventional computer activity.”  
6 *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1260 (Fed. Cir. 2016)  
7 (citing *TLI*, 823 F.3d at 612.) For example, in *TLI* the Federal Circuit held patents  
8 claiming a method of uploading, classifying, and storing digital images were patent-  
9 ineligible even though the claims involved tangible components like “a telephone unit”  
10 and a “server” because these physical components “merely provided a generic  
11 environment in which to carry out the abstract idea of classifying and storing digital  
12 images in an organized manner.” 823 F.3d at 611. The specification described these  
13 components as “having ‘the standard features of a telephone unit,’ with the addition of a  
14 ‘digital image pick up unit for recording images,’ that ‘operates as a digital photo camera  
15 of the type which is known.” *Id.* at 612 (citations to the patent specification omitted).  
16 “Likewise, the server [was] described simply in terms of performing generic computer  
17 functions such as storing, receiving, and extracting data.” *Id.* Thus, the components’  
18 functions were “described in vague terms without any meaningful limitations,”  
19 indicating “the focus of the patentee and of the claims was not on an improved telephone  
20 unit or improved server.” *Id.* at 613. The Federal Circuit therefore concluded the claims  
21 were “not directed to a solution to a ‘technological problem’” or to solving “a challenge  
22 particular to the Internet,” but were instead directed to an abstract idea. *Id.*

23 The same is true of the ‘631 patent here. The claim itself recites physical  
24 components of a server computer system, a telephone, and fax machine, and involves  
25 transmitting messages between these components. (‘631 Patent at col. 14:14-58.) But  
26 “the specification fails to provide any technical details for the tangible components,” and  
27 “instead predominately describes the . . . methods in purely functional terms.” *TLI*, 823  
28 F.3d at 612. For example, the claimed invention involves a “server computer system

1 transmitting . . . a web page to a[n] internet access device” which contains an interface to  
2 receive input that can then be sent as a message to a telephone number or to an email  
3 box. (‘631 Patent at col. 14:21-34.) These are standard components used in  
4 conventional ways that do not address a technological problem or solve a challenge  
5 particular to the Internet. *TLI*, 823 F.3d at 613; *cf. Affinity Labs*, 838 F.3d at 1261  
6 (“While the inventions in those cases involved tangible components, the components  
7 were conventional and were used in conventional ways. The same is true in this case, as  
8 the claimed cellular telephone is used to receive wireless signals, the claimed graphical  
9 user interface is used to display a menu of options to the use, and the claimed  
10 broadcasting system is used as the source of streaming content.”)

11 In fact, the specification clearly indicates these components are interchangeable  
12 with other existing computer and/or telephone components. (See ‘631 Patent at col.  
13 14:13-34. *See also* ‘631 Patent at col. 13:51-54 (“The computer systems described  
14 above are for purposes of example only. An embodiment of the invention may be  
15 implemented in any type of computer system or programming or processing  
16 environment.”); col. 14:7-10 (“Further, although certain functions have been described  
17 herein as being provided by an interface server computer, those functions may be  
18 provided by one or more other devices.”).) This interchangeability indicates the  
19 claimed invention uses the components’ conventional functions and does not address  
20 any particular technological problem. As in *TLI*, the components here are “merely a  
21 conduit for the abstract idea” of enabling business communications by providing a  
22 directory of contact information to customers or clients and the means to initiate that  
23 communication. 823 F.3d at 612; *cf. Affinity Labs*, 838 F.3d at 1258 (finding a claim  
24 non-abstract that involves a “broad and familiar concept concerning information  
25 distribution that is untethered to any specific or concrete way of implementing it”).  
26 Without any meaningful limitations on the functions of these components, the claim’s  
27 use of them, by itself, merely orients the abstract idea within a particular existing  
28 technological environment, which, as the Supreme Court and the Federal Circuit have

1 emphasized, “does not render the claim[] any less abstract.” *Affinity Labs*, 838 F.3d at  
2 1259 (citing, among others, *Alice*, 134 S. Ct. at 2358; *Mayo*, 132 S. Ct. at 1294; *Bilski v.*  
3 *Kappos*, 561 U.S. 593 (2010)).

4 Second, that the nature of the communications provided by this claimed invention  
5 was not “previously available” is a question of novelty or nonobviousness under 35  
6 U.S.C. §§ 102 and 103, not patent eligibility under § 101. “The ‘novelty’ of any element  
7 or steps in a process, or even of the process itself, is of no relevance in determining  
8 whether the subject matter of a claim falls within the § 101 categories of possibly  
9 patentable subject matter.” *Wolf*, 2014 WL 7639820, at \*10 (citing *Diehr*, 450 U.S. at  
10 189); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014)  
11 (“[A]ny novelty in implementation of the idea is a factor to be considered only in the  
12 second step of the *Alice* analysis.”). “[I]t may later be determined that the [claim] is not  
13 deserving of patent protection because it fails to satisfy the statutory conditions of  
14 novelty under § 102 or nonobviousness under § 103. A rejection on either of these  
15 grounds does not affect the determination that [the] claims recited subject matter which  
16 was eligible for patent protection under § 101.” *Diehr*, 450 U.S. at 191.

17 The asserted claims in the ‘631 patent are drawn to the basic idea the exchange of  
18 business communications that have long been accomplished through paper directories  
19 and telephone calls. That the ‘631 patent claims a method of doing so using computer  
20 servers and the Internet in their ordinary capacities does not render the claims non-  
21 abstract. *See TLI*, 823 F.3d at 613. Accordingly, the Court concludes the asserted  
22 claims in the ‘631 patent are drawn to an abstract idea under step one of the *Alice/Mayo*  
23 inquiry.

#### 24 **b. The ‘192 Patent**

25 Plaintiff similarly characterizes the ‘192 patent as “a particular and concrete  
26 method performed by a server computer system for creating and serving web pages  
27 having a particular, concrete form that turns devices receiving those web pages (such as  
28 a user computer) into new machines that provide previously unavailable

1 communications with online and offline recipients.” (Opp’n at 9.) Defendant, on the  
2 other hand, claims the ‘192 patent is “directed to the idea of disseminating information  
3 about an individual and allowing others to communicate with that individual,” or, on a  
4 more concrete level, the patent is “directed to the idea of providing a ‘home page’ for an  
5 individual.” (Mot. at 13-14.)

6 Claim one of the ‘192 patent claims a method for designating Internet home pages  
7 for individual members of a group with individual Uniform Resource Locators  
8 (“URLs”) for each member’s home page. Each home page would display the contact  
9 information of the individual member and an interface by which users could submit a  
10 comment, ranking, or message. (‘192 Patent at col. 14:8-34.) The dependent claims  
11 provide for the interfaces by which these comments, rankings, or messages are entered,  
12 received, and displayed, links to member home pages, and the method for members to  
13 reply to users’ messages. (*Id.* at col. 14:35-15:17; 15:21-32.) The dependent claims also  
14 provide the method for transmitting an email message from a user to a telephone voice  
15 message to the member or recipient. (*Id.* at col. 15:18-20.) Independent claim 20  
16 contains nearly identical elements as those in claim 1, adding a limitation that not only  
17 allots, but also creates by the interface server computer an individual home page for each  
18 member. (*Id.* at col. 16:1-31.)

19 The Court finds Defendant’s description better characterizes the nature of the  
20 asserted claims, and, as with the ‘631 patent, the ‘192 patent is directed to the abstract  
21 concept of business communications soliciting information and providing feedback  
22 between provider and customer. The claimed invention provides a method for  
23 individuals to inquire about a business or professional, a practice long prevalent in our  
24 system, accomplished, for example, by a telephone and paper directory. The fact that  
25 the ‘192 patent provides a method to use varying forms of technology to communicate  
26 the message is not dispositive—people have long engaged in the practice of leaving a  
27 written note to relay a message that was communicated verbally or by telephone to an  
28 unavailable party. As was the case with the ‘631 patent, these are “method[s] of

1 organizing human activity” that fall “squarely within the realm of ‘abstract ideas’ as [the  
2 Supreme Court has] used that term.” *Alice*, 134 S. Ct. at 2356-57.

3 And the fact that the claimed invention recites physical components does no more  
4 to save the ‘192 patent than it does the ‘631 patent. The patent does not solve a  
5 technological problem or challenge unique to the Internet. Instead, as discussed above,  
6 the specification recites standard components, including servers, a database, URLs,  
7 webpages, and interfaces, in conventional ways to accomplish standard Internet  
8 communications. The patent provides no meaningful limitations on the functions of  
9 these components; instead, they form an existing technological environment in which  
10 the abstract idea of transmitting routine business communications may be accomplished.  
11 Thus, the Court finds the ‘192 patent, too, is drawn to an abstract idea under step one of  
12 the *Alice/Mayo* inquiry.

## 13 **2. Whether the ‘631 and ‘192 Patents Recite an Inventive** 14 **Concept**

15 Having determined the ‘631 and ‘192 patents are directed to abstract ideas, in step  
16 two of the *Mayo/Alice* analysis the Court searches for an inventive concept, evaluating  
17 “whether the claims do significantly more than simply describe [the] abstract method’  
18 and thus transform the abstract idea into patentable subject matter.” *Affinity Labs*, 838  
19 F.3d at 1262 (citing *Ultramercial*, 772 F.3d at 715). The inventive concept “may arise  
20 in one or more of the individual claim limitations or in the ordered combination of the  
21 limitations.” *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341,  
22 1349 (Fed. Cir. 2016). But “[i]t is well-settled that mere recitation of concrete, tangible  
23 components is insufficient to confer patent eligibility to an otherwise abstract idea.  
24 Rather, the components must involve more than performance of ‘well-understood,  
25 routine, conventional activities previously known to the industry.’” *TLI*, 823 F.3d at 613  
26 (citing *Alice*, 134 S. Ct. at 2359).

27 Discussing the patents together, Plaintiff insists they “do not claim merely an  
28 abstract idea” such that any discussion of inventive features is “irrelevant and



1 unsupported.” (Opp’n at 17.) Plaintiff also argues that when evaluating the claims  
2 “from the point of view of one of ordinary skill in the art, and in light of the prior art,  
3 that existed in November 1999,” the patents do claim inventive features. (*Id.* at 18.)  
4 Both of these arguments are unavailing. First, the Court has found both patents are  
5 directed to an abstract idea, such that the analysis in step two of the *Alice/Mayo* test is  
6 necessary. Second, as already discussed, the patent eligibility inquiry under 35 U.S.C. §  
7 101 at issue in the present motion is distinct from the novelty and obviousness inquiries  
8 presented by 35 U.S.C. §§ 102 and 103. *See Diehr*, 450 U.S. at 190-91; *see also Netflix,*  
9 *Inc. v. Rovi Corp.*, 114 F. Supp. 3d 927, 937 (N.D. Cal. 2015), *aff’d*, No. 2015-1917,  
10 2016 WL 6575091 (Fed. Cir. Nov. 7, 2016) (“Notably, the search for an ‘inventive  
11 concept’ places no importance on the novelty of the abstract ideas. A novel abstract idea  
12 is still an abstract idea, and is therefore unpatentable.”). Having disposed of Plaintiff’s  
13 arguments, the Court evaluates each patent in turn.

14       Considering the claims themselves, the Court finds neither patent includes an  
15 inventive concept that transforms the nature of the claims into patentable inventions. As  
16 Defendant argues, the technological components recited in the ‘631 patent are well-  
17 known, routine, and conventional. (Mot. at 11.) Specifically, claim 1 recites a “server  
18 computer system transmitting a . . . webpage to a[n] internet access device,” with the  
19 webpage “comprising a message interface for receiving . . . input data,” with the server  
20 computer system sending this input data to an email box or a telephone. (‘631 Patent at  
21 col. 14:14-34.) The Federal Circuit has rejected the inventiveness of these components  
22 on their own. *See, e.g., TLI*, 823 F.3d at 614 (“[T]he telephone unit itself is not an  
23 inventive concept sufficient to confer patent eligibility;” “the server fails to add an  
24 inventive concept because it is simply a generic computer . . . .”); *Mort. Grader, Inc. v.*  
25 *First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324-25 (Fed. Cir. 2016) (“[T]he claims  
26 ‘add’ only generic computer components such as an ‘interface,’ ‘network,’ and  
27 ‘database. These generic computer components do not satisfy the inventive concept  
28 requirement.”); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363,

1 1370 (Fed. Cir. 2015) (stating an “interactive interface” is a “generic computer  
2 function”). And taken together, in the “ordered combination of the limitations,” the  
3 claim describes basic internet activity, in which a server transmits data through well-  
4 established computer components. *See TLI*, 823 F.3d at 612. Even considering that  
5 some of this data may be transmitted to a telephone, both the computer and the telephone  
6 behave as expected, transmitting and receiving data according to known methods. *See*  
7 *id.* at 614. Indeed, nowhere does Plaintiff claim it has altered the underlying  
8 functionality of the computer, internet, or telephone components involved in the claimed  
9 method. To the contrary, the specification reveals the invention does not claim any  
10 inventive technology since many of the generic computer components are  
11 interchangeable. (*See, e.g.*, ‘631 Patent at col. 12:14-43.) Thus, “the recited physical  
12 components behave exactly as expected according to their ordinary use,” and do not  
13 recite an inventive concept. *Id.* at 615. The ‘631 patent is therefore directed to patent-  
14 ineligible subject matter.

15 The same is true for the ‘192 patent. Allotting URLs, creating homepages with an  
16 interface for posting, receiving, and displaying comments, ratings, or messages, and  
17 sending voice messages to a telephone are ubiquitous tasks of conventional  
18 technologies. (*See* ‘192 Patent at col. 14:8-34.) Moreover, “[n]o meaningful limitations  
19 are placed on the hardware or software required to be used in the claimed methods or  
20 systems. In particular, the asserted claims themselves do not contain any limitations  
21 regarding specific hardware or software.” *Williamson v. Citrix Online, LLC*, No. CV-  
22 11-02409-SJO-JEMx, 2016 WL 6275177, at \*9 (C.D. Cal. Feb. 17, 2016), *aff’d*, No.  
23 2016-1714, 2017 WL 1291313 (Fed. Cir. Apr. 7, 2017).

24 The shared specification confirms neither patent recites an inventive concept.  
25 (*See, e.g.*, ‘192 Patent at col. 3:40-50 (“[A] user . . . uses the user’s computer and an  
26 internet connection to communicate with an interface server computer. In one or more  
27 embodiments, the user utilizes a web browser such as Netscape Navigator or Microsoft  
28 Internet Explorer running in user computer to access a website hosted by interface server

1 . . . .”); col. 3:64-4:5 (“In one or more embodiments, contact data base comprises a  
2 plurality of data sources that can be searched by interface server for contact information.  
3 For example, contact data base may comprise one of more online directory servers, such  
4 as, for example, www.411.com or www.switchboard.com, that can be searched by  
5 interface server.”); col. 4:13-20 (“Internet access device may be used when a recipient  
6 has an appropriate existing online presence. Fax machine and telephone may be used  
7 when a recipient does not have an appropriate existing online presence.”); col. 4:49-51  
8 (“The interface may, for example, be provided in the form of a webpage that utilizes  
9 hypertext markup language (HTML).”); col. 12:18-27 (“An embodiment of the  
10 invention can be implemented as computer software in the form of computer readable  
11 code executed on one or more general purpose computers . . . or in the form of byte-code  
12 class files executable within a Java TM runtime environment running on such a  
13 computer, or in the form of bytetimes running on a processor . . . .”); col. 12:49-55 (“In  
14 one embodiment of the invention, the processor is a microprocessor manufactured by  
15 Sun Microsystems, Inc., . . . . However, any other suitable microprocessor or  
16 microcomputer may be utilized.”); col. 13:44-48 (“Application code may be embodied  
17 in any form of computer program product. A computer program product comprises a  
18 medium configured to store or transport computer readable code, or in which computer  
19 readable code may be embedded.”.) It is well established this typical and expected use  
20 of these components does not add an inventive concept to confer patent-eligibility under  
21 § 101. *See Alice*, 134 S. Ct. at 2358 (quoting *Mayo*, 132 S. Ct. at 1297) (“Given the  
22 ubiquity of computers, wholly generic computer implementation is not generally the sort  
23 of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more  
24 than a drafting effort designed to monopolize the [abstract idea] itself.”); *Ultramercial*,  
25 772 F.3d at 716-17 (The Internet “is a ubiquitous information-transmitting medium, not  
26 a novel machine. And adding a computer to otherwise conventional steps does not make  
27 an invention patent-eligible. Any transformation from the use of computers or the  
28 transfer of content between computers is merely what computers do and does not change

1 the analysis.”).

2        Though “an inventive concept can be found in the non-conventional and non-  
3 generic arrangement of known, conventional pieces,” *Bascom*, 827 F.3d at 1350,  
4 Plaintiff does not meaningfully argue such is the case here. Even adopting Plaintiff’s  
5 preferred characterization that the patents “turn otherwise generic computing devices  
6 into new, concrete machines and systems that provide previously . . . non-existing  
7 communications capabilities with online and offline recipients” would not establish a  
8 non-generic arrangement of known technologies. (Opp’n at 9.) Setting aside the generic  
9 use of the computer components and the Internet, there is nothing unconventional or  
10 inventive about the computer-to-telephone transmission that enables these  
11 communications between online and offline users. Indeed, Plaintiff does not claim it  
12 invented the process for transmitting automated messages and data from computers to  
13 telephones. Nor do the patents specify how the transmission of these messages is to  
14 occur. *See Williamson*, 2016 WL 6275177, at \*9 (“[T]he recitation of limitations . . .  
15 cannot save the asserted claims, as these limitations embody the abstract concept to  
16 which the claims are directed and do not specify how [it] is to be generated.”). Instead,  
17 Plaintiff claims only that its website provides a way of doing so for certain recipients,  
18 which happens to be a method that enables communication between online and offline  
19 users. But the practical result—which appears to be critical to Plaintiff’s inventiveness  
20 argument, and, here, is the suggestion that online and offline users can communicate by  
21 using Plaintiff’s website—does not itself alter the underlying technology in any  
22 inventive way. Once again, the claimed invention uses existing technologies and  
23 components to accomplish a known means of transmitting information between  
24 telephones and computers. (*See, e.g.*, ‘192 Patent at col. 9:20-28 (“[T]he text of the  
25 sender’s e-mail message is converted to a voice message . . . using text-to-speech  
26 conversion techniques that are well known in the art.”); col. 9:34-10:2 (“[A] voice  
27 message relating instructions to the recipient is transmitted to the recipient’s telephone.  
28 For example . . . the instructions may consist of a statement indicating that a voice

1 message is being delivered to the recipient and prompting the recipient to press one or  
2 more buttons on the recipient's telephone.”.) At most, this is a description of a  
3 computer program that relays telephonic messages. And even when considered in  
4 conjunction with the other methods claimed in both patents, no new, concrete machine  
5 results from the arrangement of these conventional technologies. Thus, the Court does  
6 not find that the patents at issue present a non-conventional or non-generic arrangement  
7 of known pieces such that they would be eligible for patent protection.


8 Finding no inventive concept in either the '631 or '192 patents, the Court  
9 concludes they are not directed to patent-eligible subject matter. Accordingly, the Court  
10 **GRANTS** Defendant's Motion for Judgment on the Pleadings.

#### 11 **IV. CONCLUSION**

12 For the foregoing reasons, the Court concludes as a matter of law that the claims  
13 in the '631 and '192 Patents are ineligible for patent protection and are thus invalid  
14 under 35 U.S.C. § 101. The Court **GRANTS** Defendant's Motion.

15  
16 **IT IS SO ORDERED.**

17  
18 Dated: May 10, 2017

19   
20 \_\_\_\_\_  
21 HONORABLE ANDRÉ BIROTTE JR.  
22 UNITED STATES DISTRICT JUDGE  
23  
24  
25  
26  
27  
28