

**Docket No. 2016-2335**

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*In the*  
**United States Court of Appeals**  
*For the*  
**Federal Circuit**

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GODADDY.COM, LLC,

*Plaintiff-Appellee,*

v.

RPOST COMMUNICATIONS LIMITED, RMAIL LIMITED,  
RPOST INTERNATIONAL LIMITED  
and RPOST HOLDINGS INCORPORATED,

*Defendants-Appellants.*

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*Appeal from the United States District Court for the District of Arizona  
in Case No. 2:14-cv-00126-JAT · Honorable James A. Teilborg.*

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**BRIEF OF APPELLANTS**

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Incorporated*

September 26, 2016



# UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

GoDaddy.com, LLC

v.

RPost Communications Limited, et al.

Case No. 16-2335

## CERTIFICATE OF INTEREST

Counsel for the:

(petitioner)  (appellant)  (respondent)  (appellee)  (amicus)  (name of party)

RPost Communications Limited, RPost Holdings, Inc., RMail Limited, RPost International Limited

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10 % or more of stock in the party
RPost Communications Limited		None
RPost Holdings, Inc.		RPost Communications Ltd. (parent)
RMail Limited		None
RPost International Limited		None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

Lewis E. Hudnell, III, Hudnell Law Group P.C.; Kenneth Motolenich-Salas, Gallagher & Kennedy P.C.

Sep 26, 2016

Date

/s/ Lewis E. Hudnell, III

Signature of counsel

Please Note: All questions must be answered

Lewis E. Hudnell, III

Printed name of counsel

cc: \_\_\_\_\_

Reset Fields

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## TABLE OF ABBREVIATIONS

ABBREVIATION	TERM
RPost	Defendants-Appellants RPost Communications Limited, RPost Holdings, Inc., RMail Limited, and RPost International Limited
RPC	RPost Communications Limited
RPH	RPost Holdings, Inc.
RMail	RMail Limited
RPI	RPost International Limited
RPost	RPC, RPH, RMail, and RPI
GoDaddy	Plaintiff-Appellee GoDaddy.com, LLC
The '389 patent	U.S. Patent No. 8,209,389
The '913 patent	U.S. Patent No. 8,224,913
The '104 patent	U.S. Patent No. 8,161,104
The '198 patent	U.S. Patent No. 8,468,198
The '199 patent	U.S. Patent No. 8,468,199
The Tomkow patents	The '389, '913, '104, '198, and '199 patents
The '219 patent or the Feldbau patent	U.S. Patent No. 6,182,219
The '334 patent	U.S. Patent No. 6,571,334
The Feldbau patents	The '219 and '334 patents

The patents-in-suit	The Tomkow patents and the '219 patent
The '372 patent	U.S. Patent No. 7,966,372
The '389 claims	Claims 1, 7, 12, 14, and 15 of the '389 patent
The '913 claims	Claims 1 and 2 of the '913 patent
The '104 claims	Claims 1, 9, 27, and 32 of the '104 patent
The '198 claims	Claims 1, 6, 7, 10, 18, 23, 32, and 35 of the '198 patent
The '199 claims	Claims 1, 2, and 3 of the '199 patent
The '219 claims	Claims 60, 62, 66, and 69 of the '219 patent
USPTO	United States Patent and Trademark Office
PTAB	Patent Trial and Appeal Board
CBM	Covered Business Method
AIA	America Invents Act
The <i>Sophos</i> cases	<i>Sophos Inc. v. RPost Holdings, Inc. et al.</i> , 1:13-cv-12856-DJC (D. Mass.); <i>RPost Holdings, Inc. et al. v. Sophos, Inc.</i> , 1:14-cv-13628-DJC (D. Mass.)
The <i>Amazon</i> case	<i>RMail Limited v. Amazon.com, Inc.</i> , 2:10-cv-258-JRG (Lead Case) (E.D. Tex.)

## STATEMENT OF RELATED CASES

Under Federal Circuit Rule 47.5(a), RPost states that that there have been no other appeals in this civil action before this Court or any other appellate court.

Under Federal Circuit Rule 47.5(b), RPost further states that one or more of the '104, '389, '913, '198, '199, and '219 patents are the subject of the following patent infringement and patent declaratory judgment lawsuits that are pending in various district courts:

U.S. District Court Case	Patents in Common with this Case
<i>RMail Limited v. Amazon.com, Inc.</i> , 2:10-cv-258-JRG (Lead Case) (E.D. Tex.)	'219 patent
<i>RPost Holdings, Inc., et al. v. Constant Contact, Inc. et al.</i> , 2:12-cv-510 (E.D. Tex.)	'104, '389, '913, and '219 patents
<i>RPost Holdings, Inc. et al. v Epsilon Data Mgmt., Inc.</i> , 2:12-cv-511 (E.D. Tex.)	'104, '389, '913, and '219 patents
<i>RPost Holdings, Inc. et al. v Exact Target, et al.</i> , 2:12-cv-512-JRG (E.D. Tex.)	'219 patent
<i>RPost Holdings, Inc., et al. v. Experian Mktg. Solutions, Inc.</i> , 2:12-cv-513-JRG (E.D. Tex.)	'104, '389, '913, and '219 patents.
<i>RPost Holdings, Inc., et al. v. Strongmail Sys., Inc. et al.</i> , 2:12-cv-515-JRG (E.D. Tex.)	'104, '389, '913, and '219 patents
<i>RPost Holdings, Inc., et al. v. Vocus, Inc.</i> , 2:11-cv-516-JRG (E.D. Tex.)	'104, '389, '913, and '219 patents
<i>RPost Holdings, Inc., et al. v. Infogroup, Inc. et al.</i> , 2:12-cv-517-JRG (E.D. Tex.)	'104, '389, '913, and '219 patents
<i>RPost Holdings, Inc., et al. v. DocuSign, Inc. et al.</i> , 2:12-cv-683-JRG (E.D. Tex.)	'104, '389, '913, and '219 patents
<i>RPost Holdings, Inc., et al. v. Yesware, Inc. et al.</i> , 2:13-cv-953-RS (E.D. Tex.)	'104 and '198 patents
<i>Yesware, Inc. v. RPost Holdings, Inc. et al.</i> , 1:13-cv-12837-RS (D. Mass.)	'104 and '198 patents

<i>Sophos Inc. v. RPost Holdings, Inc. et al.</i> , 1:13-cv-12856-DJC (D. Mass.)	'389, '913, and '199 patents
<i>RPost Holdings, Inc. et al. v. Sophos, Inc.</i> , 1:14-cv-13628-DJC (D. Mass.)	'389, '913, and '199 patents
<i>MIS Sciences Corporation v. RPost Communications Limited</i> , 3:14-cv-376-VC (N.D. Cal.)	'104, '389, '913, '198, and '199 patents

One or more of these cases may be affected by this Court's decision in the pending appeal.

## **I. JURISDICTIONAL STATEMENT**

This Court has jurisdiction under 28 U.S.C. § 1295(a)(1). The district court purportedly had jurisdiction under 28 U.S.C. §1331 and §1338(a). In this appeal, RPost contends that the district court did not have jurisdiction over GoDaddy's §101 challenge and that the district court improperly exercised subject-matter jurisdiction over the '219 patent. The district court entered a final judgment on June 7, 2016. Appx61. RPost timely noticed this appeal on July 7, 2016. Appx132, #364.

## **II. STATEMENT OF THE ISSUES**

This appeal raises the following issues:

1. Did the district court err in deciding that it had jurisdiction to determine whether the patents-in-suit claim eligible subject matter, thereby exceeding its congressionally delineated authority?
2. Was the district court's grant of summary judgment of invalidity of the '219 claims under the abstract ideas exception to patentability erroneous?
3. Was the district court's grant of summary judgment of invalidity of the '913 claims under the abstract ideas exception to patentability erroneous?
4. Was the district court's grant of summary judgment of invalidity of the '104 claims under the abstract ideas exception to patentability erroneous?
5. Was the district court's grant of summary judgment of invalidity of the '198 claims under the abstract ideas exception to patentability erroneous?

6. Was the district court's grant of summary judgment of invalidity of the '389 claims under the abstract ideas exception to patentability erroneous?

7. Was the district court's grant of summary judgment of invalidity of the '199 claims under the abstract ideas exception to patentability erroneous?

8. Was the district court's denial of RPost motion to dismiss the '219 patent for lack of subject-matter jurisdiction erroneous?

### **III. STATEMENT OF THE CASE**

#### **A. Factual Background and Procedural History**

This action is a patent declaratory judgment action filed by GoDaddy that arose out of nearly six months of pre-suit communications between the parties. On July 16, 2013, Jake Finnell of RPost U.S., Inc., an email security company, sent a mass email to a number of companies advising them of RPost's patent rights. Appx164-166. The email requests that the addressees review and evaluate six patents owned by RPC relating to email tracking of and/or reports of delivery, email delivery failure, and/or determining opening of emails using SMTP, ESMTP, HTTP, or other data protocols—the '372 patent, the '104 patent, the '389 patent, the '913 patent, the '198 patent, and the '199 patent. Appx165. The July 16 email invites the addressees to review several other patents as background, including two patents owned by RMail—the '219 patent and its continuation, the '334 patent. Appx165-166. The signature block of the July 16 email contains a lengthy list of foreign and

U.S. patents and U.S. published applications that happens to include the patents-in-suit. Appx166. The July 16 email also invites the addressees to contact RPost within two weeks if they would like to engage in a confidential discussion related to their use of RPost's services and patented technology. *Id.* The July 16 email does not mention GoDaddy, does not identify any GoDaddy products, does not include any claim charts, and does not mention litigation. Appx164-166.

On October 4, 2013, Ray Owens of RPost U.S., sent a follow up letter to Nima Kelly, General Counsel of GoDaddy, with the Re: line "Claim Charts per Patent Infringement Notice." Appx168-176. The October 4 letter states that GoDaddy is "offering products and services, namely Express Mail Marketing, may infringe patents owned by RPost." Appx170. The October 4 letter includes preliminary summary analyses comparing the claims of the Tomkow patents against a generic description of a system that practices those patents. Appx171-176. The preliminary summary analyses do not refer to any specific GoDaddy product. *Id.* The October 4 letter also includes a list of over 60 foreign and U.S. patents and published U.S. Patent Applications owned by RPost and related entities, including the patents-in-suit. Appx176. The October 4 letter states that RPost "would like to discuss with you a business resolution to this matter in the next two weeks." Appx170.

On or about October 22, 2013, Jerry Silver of RPost U.S., contacted GoDaddy's Associate General Counsel, Karl Fazio, to discuss a potential business

arrangement. Appx1274, ¶3. Mr. Silver suggested that the parties enter into a mutual non-disclosure agreement which, once executed, would allow him to discuss previous agreements relating to the patents-in-suit. *Id.*, ¶4. On November 11, 2013, RPC entered into an NDA with GoDaddy. Appx1275, ¶5. After the parties executed the NDA, Mr. Silver provided Mr. Fazio a document entitled “Summary of Preliminary Infringement Analysis,” that lists the ’219 patent on the front page under the heading “Additional Recommend Review” along with four other patents. *Id.*, ¶7-8; Appx1279. The document, however, does not contain any analysis of the ’219 patent or the ’334 patent and does not reference the ’219 patent other than on the front cover. Appx1275, ¶10. During the course of the subsequent discussions, Mr. Silver did not threaten GoDaddy with litigation. Appx1275, ¶11. Mr. Silver also never asserted that GoDaddy infringes the Feldbau patents. *Id.*, ¶12. Mr. Silver further never asserted that any specific GoDaddy product infringes the Feldbau patents. *Id.*, ¶13.

On January 22, 2014, GoDaddy filed its Original Complaint for declaratory judgment of non-infringement and invalidity of the Tomkow patents (Counts III-XII). Appx68, #1. On May 22, 2014, RPI and RMail moved to dismiss Counts III-XII of the Original Complaint for lack of standing because these entities do not own a legal right to the Tomkow patents. Appx75, #38. GoDaddy, instead of responding to the motion to dismiss, filed a First Amended Complaint. Appx76, #46. The First

Amended Complaint adds Counts XIII-XVI, which seek declaratory judgment of non-infringement and invalidity of the Feldbau patents. Appx707-713.

On August 26, 2014, RPost moved to dismiss Counts XIII-XVI for lack of subject-matter jurisdiction. Appx81, #72. On September 30, 2014, the Court ordered that RPost answer Counts XIII-XVI while its motion to dismiss those counts was still pending. Appx84, #86. In its answer, RPost asserted infringement counterclaims on the Feldbau patents conditioned on the outcome of its motion to dismiss. Appx1860-1867. Subsequently, before the deadline to amend pleadings, RPost sought leave to file a first amended answer to Counts XIII-XVI. Appx87, #100. In its proposed amendments, RPost again asserted infringement counterclaims on the Feldbau patents conditioned on the outcome of its motion. Appx2220-2227.

On December 9, 2014, the Court granted RPost's motion to dismiss as to the '334 patent but denied it as to the '219 patent. Appx2371-2384. The only distinction that the district court drew between the alleged affirmative acts that RPost took with respect to the '334 patent and the '219 patent is that "RPost drew attention to [the '219 patent] by conspicuously listing it under 'Additional Recommended Review' on the title page of the Presentation alongside one of the Tomkow Patents." Appx2379. Given that the Court dismissed the counts relating to the '334 patent, the Court ordered that RPost file an amended answer that responds to the surviving counts. Appx2383. RPost filed an amended answer asserting counterclaims on the

patents-in-suit. Appx2400-2412. Accordingly, this case proceeded on the Tomkow patents and the '219 patent.

The district court conducted a claim construction hearing and issued a claim construction order construing several disputed terms of the patents-in-suit. Appx4675-4813. After the close of fact discovery, GoDaddy moved for summary judgment asserting, among other things, invalidity under §101 of the then remaining asserted claims of the patents-in-suit. Appx112, #257. The district court granted GoDaddy's motion and invalidated all of the asserted claims under §101. Appx1-60. RPost appeals from the district court's grant of summary judgment.

## **B. Overview of the Patents-in-suit**

### **1. The Tomkow patents**

Dr. Terrance Tomkow of RPost is the sole inventor of the Tomkow patents. The Tomkow patents all stem from the same parent application, which issued as the '372 patent, and all are titled "System and Method for Verifying Delivery and Integrity of Electronic Messages." Dr. Tomkow first conceived of the invention that led to the Tomkow patents when he was ordering something over the internet in the late 1990's. Appx604, 137:3-7. It occurred to him that if he provided his payment information over the internet and the merchant simply denied that they received it, then he had no way to prove that he actually ordered something from that merchant. *Id.*, 137:8-20. At that time, numerous techniques existed to protect the recipient of

an electronic message so that he or she could be sure that the sender was who he said he was and that the content of the message had not changed on its way to the recipient. *Id.*, 138:2-11. Dr. Tomkow realized, however, that no technology existed to protect the sender so that he or she could show that an electronic message that they had transmitted had been received. *Id.*

Dr. Tomkow then began to think about the problem of proving delivery of a message in the context of email. *Id.*, 138:13-139:24. The conventional thinking at the time was that such proof required some sort of action from the recipient acknowledging that he or she had received the email. *Id.* Dr. Tomkow thought, however, that if delivery could be proved to the recipient's email server or email client, then that delivery could serve as proof of delivery to the recipient without requiring the recipient's participation or cooperation. *Id.* Accordingly, Dr. Tomkow sought to discover technological methods to prove delivery of an email to a recipient's mail server or mail client. *Id.* Each of the Tomkow patents claims a different technical solution for proving email delivery or extensions of this technology. Appx.6005, 140:1-3.

Figure 1 of each of the Tomkow patents illustrates an email system in accordance with one embodiment of the invention claimed in the Tomkow patents:

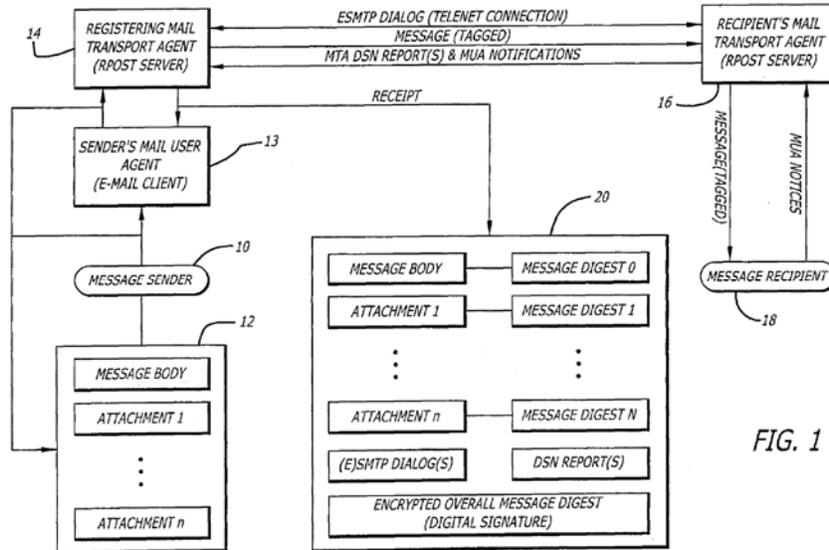


FIG. 1

Appx5722.

The '913 patent addresses the problem of verifying the delivery of an email from a sender to a recipient through an intermediate server. Appx5720-5754. As illustrated in Figure 1, a registering mail transport agent (MTA) of the sender establishes a dialog using a mail transport protocol, in this case Extended Simple Mail Transport Protocol (ESMTP), with a recipient MTA. The dialog includes a sequence of commands and responses exchanged between the two MTAs in which they communicate with each other in order to transmit the email. Appx5745, 12:16-13:65. The registering MTA will transmit the email to the recipient's MTA in accordance with the protocol. *Id.* In order to obtain proof of delivery, the registering MTA records a portion of the mail transport protocol dialog generated by the transmission of the message in which the recipient's MTA accepts or declines delivery of the message. *Id.*, 12:7-9. Because the registering MTA records proof of

delivery separate from the sender and the recipient, the system can provide proof of delivery of an email without requiring compliance or co-operation of the recipient and without requiring the sender or the recipient to use additional software. Appx5740, 2:64-3:1; Appx5751, 24:9-11.

The '389 patent addresses the problem of verifying the receipt of an email sent from a sender to a recipient through an intermediate server displaced from the recipient. Appx5682-5718. The claimed embodiments of the '389 patent build on the '913 patent in that in addition to recording a portion of the mail transport protocol dialog, the registering MTA also records other indications that the recipient has received the email, such as a Delivery Status Notifications (DSN). Appx5709, 12:11-15. As shown in Figure 1, the registering MTA also creates a receipt that includes the recorded protocol dialog and the DSN reports, which it in turn provides to the sender. Appx5710, 14:55-15:45.

The '199 patent, which is a continuation of the '389 patent, addresses the problem of verifying the failure to deliver an email sent from a sender to a recipient through an intermediate server displaced from the recipient. Appx5644-5680. The claimed embodiments of the '199 patent differ from those of '389 patent in that the registering MTA records a portion of the mail transport protocol dialog generated by the transmission of the message from the registering MTA to the recipient MTA and an indication that the registering MTA has failed to deliver the message, such as

a DSN that indicates delivery failure. Appx5669, 12:26-40; Appx5670, 13:44-49. In order to provide the sender proof of delivery failure, as shown in Figure 1, the registering MTA may provide the sender a receipt containing the recorded dialog and the DSN reports. Appx5670, 13:44-49, 13:57-60.

The '104 patent extends the concepts of the '913, '389, and '199 patent and addresses the problem of verifying the opening of an email sent from a sender to a recipient through an intermediate server displaced from the recipient. Appx5607-5642. As illustrated in Figure 1, the registering MTA receives an email from the sender. The registering MTA adds a link to the email that is configured to execute when the message is opened at the recipient, which is represented by the tagged message. Appx5592, 8:15-28. The registering MTA transmits the email to the recipient. When the email is opened, the link executes automatically and controls the registering MTA to provide an indication that the email has been opened independent of any configuration, capability, or action by the recipient's mail system, client, or agent. Appx5601, 26:49-27:7. The registering MTA may then create authenticable information related to the message, such as a receipt that includes the indication of opening and that the registering MTA signs with its digital signature, and transmit the authenticable information and the indication of opening to the sender. Appx5596, 15:31-41. Because the opening of the email can be verified without requiring the cooperation of the recipient or any additional software

at the sender and the recipient, and because the actual indication of opening occurs at the registering MTA, the recipient cannot repudiate that it opened the email. Appx5589, 2:62-3:2; Appx5600, 24:29-31.

The '198 patent, which is a continuation of the '104 patent, addresses the problem of verifying the opening or delivery of an email sent from a sender to a recipient through an intermediate server displaced from the recipient. Appx5607-5642. The claimed embodiments of the '198 patent differ from those of the '104 patent in that the registering MTA uses the executing of the link as an indication of the delivery of the email. Appx5640, 28:6-25. In order to provide the sender proof of delivery, as shown in Figure 1, the registering MTA may provide the sender authenticable information related to the message, such as a receipt that includes the indication of delivery and that the registering MTA signs with its digital signature, and transmit the authenticable information and the indication of delivery to the sender. Appx5634, 15:38-48.

The '389, '913, and '104 patents have each been the subject of CBM reviews before the PTAB. The PTAB denied petitions to institute CBM reviews of each of these patents. Appx6312-6324; Appx6325-6336; Appx6337-6348. The PTAB determined that the petitioner could not overcome RPost's arguments that the '104, '389, and '913 patents solve a technical problem—providing reliable proof of content and delivery of electronic messages—using technical solution—an

intermediate server without requiring the use of special email software by the sender or the recipient. Appx6319-6323; Appx6332-6335; Appx6344-6347. Thus, the petitioner failed to prove that these patents do not claim technological inventions. Therefore, these patents were not subject to CBM review. *Id.*; *see also* 37 C.F.R. § 42.301(b) (defining a technological invention as one in which “the claimed subject matter as a whole recites a technological feature that is novel and un-obvious over the prior art; and solves a technical problem using a technical solution.”). In fact, the denial of CBM review of the ’913 patent was the first of 69 decisions since the inception of CBM review in which the PTAB found a patent ineligible for CBM review. *See* <http://fishpostgrant.com/alert/ptab-first-cbm-review-denied-jurisdictional-grounds/> (last visited Jul. 8, 2016).

Just four days before the district court issued its summary judgment order, the court in the *Sophos* cases issued an order denying Sophos’s motion for judgment on the pleadings under §101. Appx7051-7078. The court found that claims 1, 4, 6, 7, and 10-16 of the ’389 patent; claims 1 and 2 of the ’913 patent; and claims 1-3, 6, and 7 of the ’199 patent were not directed to an abstract idea and claim an inventive concept. Appx7074-7078. Therefore, the court concluded that the claims were not ineligible under §101. *Id.*

## 2. The Feldbau patent

Ofra and Michael Feldbau are the inventors of the '219 patent, which is titled "Apparatus and Method for Authenticating the Dispatch and Contents of Documents." Appx5976-6001. Like the Tomkow patents, the '219 patent also addresses the problem of protecting the sender in case a dispute arises between the sender and the recipient regarding the transmission of electronic information. Appx5985, 1:20-239. Figure 2 of the '219 patent illustrates a communications system in accordance with one embodiment of the claimed invention:

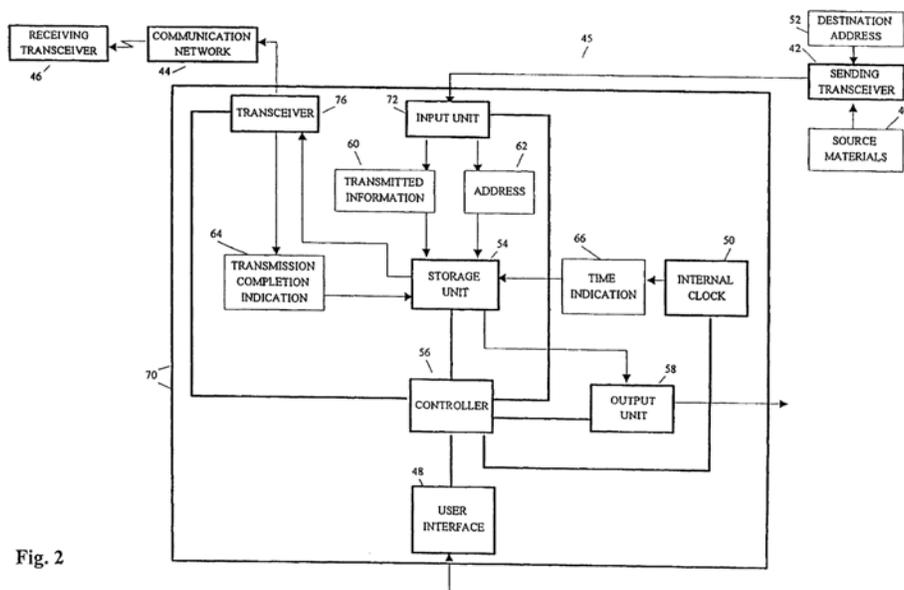


Fig. 2

Appx5979.

The '219 patent solves the problem by providing the sender with evidence that it sent a dispatch to a particular destination at a particular time and that it had particular content. Appx5985, 2:57-61. As shown in Figure 2, the sender transmits the dispatch to a non-interested third party, known as an authenticator. Appx5987,

6:38-44. The authenticator associates information such as a time of its successful transmission and its contents to generate evidence capable of proving the dispatch and the contents of the dispatch—“authentication information.” Appx5986, 3:29-36. The generation of evidence by the authenticator provides value and instills confidence in the transaction.

The authenticator secures the authentication information against tampering by the sender and the recipient by, for example, storing the information in a secure storage unit. Appx5988, 7:41-58. Alternatively, the authenticator may use mathematical association methods that would make any tampering easy to detect. *Id.* Such mathematical association methods may involve digital signatures, encryption, or a one-way hash. Appx5989, 10:47-11:2. Accordingly, the '219 patent improves upon conventional systems by providing non-repudiation evidence of electronically transmitted information. Appx5985, 2:57-61.

The validity of the '219 patent was challenged by an *ex parte* reexamination. The USPTO issued an *Ex Parte* Reexamination Certificate for the '219 patent confirming the validity of all of the reexamined claims. Appx5999-6001. In addition, the defendants in the *Amazon* case moved for summary judgment of invalidity of the '334 patent, the continuation of the '219 patent, under §101. The court summarily denied the motion. Appx6454-6455.

#### IV. SUMMARY OF THE ARGUMENT

The Court must reverse the district court's grant of summary judgment of invalidity of the patents-in-suit because the district court incorrectly concluded that it had statutory authority to decide GoDaddy's eligibility challenge under 35 U.S.C. §101. Section 101 is not one of the defenses enumerated in 35 U.S.C. §282(b) that Congress allowed to be raised in a patent infringement action. Only §282(b)(2) arguably covers eligibility under §101 and provides a defense of "[i]nvalidity . . . on any ground specified in part II as a condition for patentability". But the only grounds specified in part II of the Patent Act as a condition for patentability are novelty under §102 and obviousness under §103, not eligibility under §101. The legislative history of §282(b), and in particular the Federico Commentary to the 1952 Patent Act, also does not identify ineligibility as one of the permitted defenses.

Even if the district court had jurisdiction to decide GoDaddy's eligibility challenge, which it did not, the district court also erred in concluding that the patents-in-suit are invalid under §101. In doing so, the district court misapplied the Supreme Court's two-part test for determining whether the patents-in-suit claim unpatentable abstract ideas by overgeneralizing the claims of the patents-in-suit in a manner inconsistent with the patents' disclosures, the district court's own claim construction, and this Court's precedent.

Specifically, the '219 claims are not directed to the abstract idea of collecting and providing information about a dispatch using a third party intermediary. Rather, the '219 claims are directed to a specific method for improving the ability of conventional data transmission systems to provide evidence that a dispatch was sent at a specific time to a specific receiving party. The '219 claims implement this method using an authenticator, which generates authentication data regarding the dispatch and requires a special purpose computer to secure the authentication data against tampering by the sender and the recipient.

Contrary to the district court's erroneous characterization of the claims, the '219 claims are still patentable because they recite specific limitations that further define the special nature and function of the authenticator. The authenticator's specific combination of features adds an inventive concept to the claimed method because they ensure that the generated authentication data is reliable and non-tamperable.

Also contrary to what the district court found, the Tomkow patents are not directed to the abstract idea of collecting and providing information regarding the delivery, non-delivery, or opening of a message. The Tomkow patents are directed to specific implementations for providing verifiable proof of the delivery, non-delivery, or opening of an email.

Notwithstanding the district court's mischaracterizations, the Tomkow patents are patent eligible because they solve the technical problem—the lack of sufficient forms of proof of email delivery, non-delivery, and opening—using a technical solution—an intermediate server that record a portion or other verifiable information regarding the delivery, non-delivery, or opening of the email. As such, they recite an inventive concept that provides a technical way to overcome the deficiencies of the prior art.

Finally, the '219 patent should not have even been considered at summary judgment because the district court erroneously denied RPost's motions to dismiss GoDaddy's declaratory judgment counts on the '219 patent for lack of subject-matter jurisdiction. The only allegedly affirmative act that RPost took regarding the '219 patent that it did not take regarding the '334 patent, which the district court dismissed, is that RPost listed the '219 patent, along with several other patents, on the face of a presentation that it provided to GoDaddy. The presentation did not otherwise concern the '219 patent. Thus, the additional act of listing the '219 patent on the front of a presentation did not constitute an affirmative act and the '219 patent should have been dismissed.

For all of these reasons and those set forth below, the district court's judgment of invalidity of the patents-in-suit must be vacated and reversed.

## V. ARGUMENT

### A. Standard of Review

Every issue raised in this appeal is reviewed *de novo*. The Court reviews a grant of summary judgment under the law of the regional circuit. *See Grober v. Mako Prods., Inc.*, 686 F.3d 1335, 1344 (Fed. Cir. 2012). The Ninth Circuit reviews a grant of summary judgment *de novo*. *See Furnace v. Sullivan*, 705 F.3d 1021, 1026 (9<sup>th</sup> Cir. 2013). In deciding a motion for summary judgment, “[t]he evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (U.S. 1986).

The Court reviews determinations of patent eligibility under 35 U.S.C. §101 *de novo*. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1255 (Fed. Cir. 2014). Statutory interpretation is also reviewed *de novo*. *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 543 F.3d 657, 660 (Fed. Cir. 2008).

Finally, the Court reviews whether the district court lacked subject-matter jurisdiction *de novo*. *See Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 903 (Fed. Cir. 2014).

**B. The District Court Erroneously Determined that it Had Jurisdiction over GoDaddy’s Eligibility Challenge.**

**1. Ineligibility is not a litigation defense under §282(b).**

The district court erroneously determined that it had jurisdiction over GoDaddy’s §101 eligibility challenge because Congress never authorized ineligibility as a defense that can be raised in patent litigation. Patent defenses are statutory. If a patent defense is not denominated within the Patent Act, then the Court lacks jurisdiction to address it. *See Aristocrat Tech.*, 543 F.3d at 661-63. Section 282(b) of the Act enumerates the defenses that may be raised in a patent infringement action. *See* 35 U.S.C. §282(b). As the district court stated, the only paragraph of §282(b) that is pertinent to this case is §282(b)(2), which states a defense of “(2) Invalidity of the patent or any claim in suit on any ground specified in part II as a condition for patentability.” 35 U.S.C. §282(b)(2); Appx6. But the plain language of §282(b)(2) does not authorize ineligibility as a defense.

Only two sections of part II of title 35 are specified as a “condition for patentability”—§102 titled “Conditions for patentability; novelty” and §103 titled “Conditions for patentability; non-obvious subject matter.” Conversely, §101 is titled “Inventions patentable.” No other section contained in Part II is specified as or includes the phrase “condition for patentability,” either in the title or in the body. Thus “[t]he two sections of part II that Congress has denominated as ‘conditions of patentability’ are §102 (‘novelty and loss of right to patent’) and §103 (‘nonobvious

subject matter’).” *See MySpace, Inc. v. GraphOn Corp.*, 672 F.3d 1250, 1260 (Fed. Cir. 2012).

The first error that the district court made was that it only addressed RPost’s argument that the title of §101 proves that eligibility is not a valid patent litigation defense. Appx9. The district court never addressed the evidence in the actual text of §282(b)(2) that it does not apply to §101. *See Diamond v. Diehr*, 450 U.S. 175, 182 (1981) (“In cases of statutory construction, we begin with the language of the statute.”). First, §282(b)(2) states “invalidity,” not ineligibility. Invalidity and ineligibility are not the same. *See BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 2016 U.S. App. LEXIS 11687, at \*31-33 (Fed. Cir. June 27, 2016) (contrasting patentability and eligibility); *DDR Holdings*, 773 F.3d at 1259 n. 6 (“Of course, patent-eligible does not mean patentable under, e.g., 35 U.S.C. §§102 and 103”). Also, §282(b)(2) states “any grounds specified . . . as a condition for patentability.” The only grounds specified as a condition for patentability are §§102 and 103, not §101.

The district court also ignored evidence in the text of §101 that eligibility is not a condition of patentability. Section 101 states: “[w]hoever invents or discovers any new and useful process . . . or any new and useful improvement thereof, may obtain a patent therefore, *subject to the conditions and requirements of this title.*” 35 U.S.C. §101 (emphasis added). Section 101 expressly distinguishes between the

categories of patentable subject matter and the conditions that they are subject to. *See Diehr*, 450 U.S. at 189-91; *Research Corp. Techs. v. Microsoft Corp.*, 627 F.3d 859, 868 (Fed. Cir. 2010) (“The section 101 patent-eligibility inquiry is only a threshold test. *See Bilski*, 130 S. Ct. at 3225. . . . [Section 101] approves the broad categories of subject matter . . . itself directs primary attention to ‘the conditions and requirements of [Title 35].’”).

**2. *Versata* did not hold that a district court has authority to decide eligibility challenges.**

Instead, the district court relied on this Court’s holding in *Versata v. SAP America, Inc.* to conclude that it had jurisdiction over GoDaddy’s §101 challenge. *Versata*, however, is not dispositive. *Versata* addressed whether the PTAB, not a district court, exceeds the scope of its congressionally delineated authority in deciding a §101 challenge in a CBM review under the AIA. *See Versata Dev. Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1330 (Fed. Cir. 2015). Although *Versata* acknowledges that the section titles of the Patent Act supports the argument that §101 is not a condition for patentability, *Versata* relies on the legislative history of the AIA to conclude that the PTAB has the authority to consider §101 challenges. *Id.* The legislative history of the AIA, however, is not the legislative history of the 1952 Patent Act, which enacted §282(b)(2). The district court recognized this distinction but inexplicably failed to address any of the 1952 Patent Act legislative

history cited by RPost that shows that Congress did not intend ineligibility to be a litigation defense. Appx8.

**3. The legislative history of §282(b) shows that Congress never authorized ineligibility as a litigation defense.**

Before the 1952 Patent Act, Rev. Stat. §4886 specified the subject matter for which a patent could be obtained and recited conditions for patentability. *See* P.J. Federico, “Commentary on the New Patent Act,” 35 U.S.C.A. 1 (1954), reprinted at 75 J. Pat. & Trademark Off. Soc’y 161, 175-176 (1993). In the 1952 Patent Act, Congress divided §4886 into two sections—§101 relating to the subject matter for which a patent may be obtained and §102 defining novelty and other conditions for patentability. *See id.*; S. Rep. No. 1979, 82d Cong., 2d Sess., 5, 6, and 17 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6, 7, and 17 (1952). The 1952 Patent Act also derived the language of what is now §282(b) from the defenses enumerated in Rev. Stat. §4920 to state the defenses that may be raised in an action involving the validity or infringement of a patent. *See Federico*, 75 J. Pat. & Trademark Off. Soc’y at 216; S. Rep. No. 1979, 82d Cong., 2d Sess., 10 and 29 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 10 and 29 (1952). Section 4920 did not recite ineligibility as a defense and Congress incorporated the conditions that it did recite into §102. *See* Rev. Stat. §4920; *Federico*, 75 J. Pat. & Trademark Off. Soc’y at 216.

The Court recently examined the legislative history of §282(b) in *SCA Hygiene Products v. First Quality Baby Products* in order to determine whether

laches is a litigation defense under §282. In concluding that it is, the Court exclusively relied on the Federico Commentary of the 1952 Patent Act, which identified laches as one of the defenses available under §282(b)(1). *See SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 807 F.3d 1311, 1323 (Fed. Cir. 2015) (en banc), *cert. granted*, 136 S. Ct. 1824 (2016) (“We therefore consider the Federico Commentary to be a sufficiently reliable source on the meaning of §282.”). The Federico Commentary, however, does not recite ineligibility as one of the defenses under §282(b)(2):

The second item specifies ‘Invalidity of the patent or any claim in suit on any ground specified in Part II of this title as a condition for patentability’; this would include most of the usual defenses such as lack of novelty, prior publication, prior public use, lack of invention.

*See Federico*, 75 J. Pat. & Trademark Off. Soc’y at 215. Because the district court also ignored this commentary, the district court erroneously concluded that Congress authorized ineligibility as a litigation defense.

**4. The Supreme Court has never held that ineligibility is a litigation defense.**

The district court’s claim that the Supreme Court unwaveringly considers ineligibility to be a viable defense in patent infringement litigation is also erroneous. Appx9. The Supreme Court has never held that patent eligibility is a “condition of patentability” and therefore a viable invalidity defense under §282(b)(2). At most, the Supreme Court suggested in *dictum* that “utility” is “condition of patentability.”

*See Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966). *Graham* did not, however, hold that eligibility is a condition of patentability. In fact, *Graham* did not even involve patent eligibility under §101.

Other Supreme Court decisions actually addressing patent eligibility under §101 contradict the notion in *Graham* that §101 defines any conditions for patentability. For example, in *Diamond v. Diehr*, the Supreme Court expressly distinguished between §101 and the conditions for patentability that follow:

Section 101, however, is a general statement of the type of subject matter that is eligible for patent protection “subject to the conditions and requirements of this title.” Specific conditions for patentability follow and § 102 covers in detail the conditions relating to novelty.

*See Diehr*, 450 U.S. at 189-91 (citing *in accord* S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952)); *see also Bilski v. Kappos*, 561 U.S. 593, 602 (2010) (“The §101 patent-eligibility inquiry is only a threshold test. . . . the claimed invention must also satisfy ‘the conditions and requirements of this title.’”).

Further, the Supreme Court has only addressed the eligibility of an issued patent in three cases arising from litigation: *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012); *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 132 S. Ct. 1794 (2012); and *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014). These decisions, however, are not binding because they do not address whether a district court has jurisdiction to decide an eligibility challenge. *See Will v. Mich. Dept. of State Police*, 491 U.S. 58, 63 (1989) (citing *Hagans v.*

*Lavine*, 415 U.S. 528, 535 n. 5 (1974)) (“[T]his Court has never considered itself bound by [prior *sub silentio* holdings] when a subsequent case finally brings the jurisdictional issue before us.”). By assuming that it had jurisdiction over GoDaddy’s eligibility challenge simply because the Supreme Court has issued eligibility rulings in cases arising from litigation that do not address the jurisdictional issue, the district court erred. *See Webster v. Fall*, 266 U.S. 507, 511 (1925) (“Questions which merely lurk in the record, neither brought to the attention of the court nor ruled upon, are not to be considered as having so decided as to constitute precedents.”).

**5. The Court has never held that ineligibility is a litigation defense.**

The district court’s view that this Court has long held that §282’s defenses include ineligibility is also incorrect. Appx7. To support this view, the district court cited footnote 3 from this Court’s opinions in *DealerTrack, Inc. v. Huber* and *Aristocrat v. International Game Technology*. *Id.* *DealerTrack*, however, does not hold that ineligibility is a litigation defense. Footnote 3 in *DealerTrack* is just *dictum* written in response to the dissent, which opines that it was an error for the district court not to “initially address patent invalidity issues in infringement suits in terms of the defenses provided in the statute: ‘conditions of patentability,’ specifically §§102 and 103.” *See DealerTrack, Inc. v. Huber*, 674 F.3d 1315, 1335 (Fed. Cir. 2012) (Plager, J., dissenting). Footnote 3 of *DealerTrack* also relies on *dictum* from

*Aristocrat* that in turn relies on the *dictum* from *Graham* noted above, which states that utility under §101 is a condition for patentability, not eligibility. See *DealerTrack*, 674 F.3d at 1331 n.3; *Aristocrat*, 543 F.3d at 661 (citing *Graham*, 383 U.S. at 86). Although footnote 3 of *Aristocrat* states in *dictum* that “it is beyond question that section 101’s other requirement, that the invention be directed to patentable subject matter, is also a condition for patentability,” *Aristocrat* cites no authority for this statement. See *Aristocrat*, 543 F.3d at 661 n.3; Appx7.

Moreover, the Court’s more recent cases directly contradict the *dictum* in *Dealertrack* and *Aristocrat*. For example, in *Myspace, Inc. v. GraphOn Corp.*, the Court acknowledged that Congress specified the defenses in any action involving the validity of a patent as “any ground specified in part II of this title as a condition of patentability” and named only two Patent Act sections “conditions for patentability”—§§102 and 103. See *Myspace*, 672 F.3d at 1260; see also *CLS Bank Int’l v. Alice Corp.*, 717 F.3d 1269, 1335 (Fed. Cir. 2013) (Rader, J., dissenting) (“[T]he Supreme Court long ago held that Section 101 is not a ‘condition of patentability.’ [citing *Diehr*, 450 U.S. at 189-90] . . . Finally, the statute does not list Section 101 among invalidity defenses to infringement. See 35 U.S.C. §282 (while invalidity for failing to meet a ‘condition of patentability’ is among the authorized defenses, Section 101 is not a ‘condition of patentability’)), *aff’d by Alice Corp. Pty. Ltd. v. CLS Bank Int’l.*, 134 S. Ct. 2347 (2014). *Myspace* also

advises that courts could avoid the “murky morass” of §101 jurisprudence by insisting that “litigants initially address patent invalidity issues in terms of the conditions of patentability defenses as the statute provides, specifically §§102, 103, and 112.” *See Myspace*, 672 F.3d at 1260; *see also Research Corp.*, 627 F.3d at 868 (“[T]he Supreme Court advised that section 101 eligibility should not become a substitute for a patentability analysis related to prior art, adequate disclosure, or the other conditions and requirements of Title 35.”). Although *Myspace* did not state that §101 cannot ever be raised initially in a patent case, it stated that such cases would be an “unusual and infrequent circumstance.” *Id.* at 1261. Thus, even if the district court could decide eligibility, this case is not such a circumstance.

### **C. Framework for Determining Eligibility**

Even if the district court had jurisdiction to decide GoDaddy’s eligibility challenge, which it did not, the district court still erred by concluding that the asserted claims failed to satisfy the Supreme Court’s two-part test for determining their eligibility under §101. Under §101, patent-eligible subject matter includes “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The judicially recognized exceptions from this provision are for “[l]aws of nature, natural phenomena, and abstract ideas.” *Alice*, 134 S. Ct. at 2354 (2014). The rationale behind these exclusions is “one of pre-emption,” namely a “concern that patent law not inhibit further discovery by

improperly tying up the future use of these building blocks of human ingenuity.” *Id.* (quotation marks omitted). Courts, however, must “tread carefully in construing this exclusionary principle lest it swallow all of patent law.” *Id.* Thus, “for abstractness to invalidate a claim it *must ‘exhibit itself so manifestly* as to override the broad statutory categories of eligible subject matter and the statutory context that directs primary attention on the patentability criteria of the rest of the Patent Act.” *DealerTrack, Inc.*, 674 F.3d at 1333 (quoting *Research Corp.*, 627 F.3d at 868) (emphasis added).

The Supreme Court has “set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. First, the Court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* “If not, the claims pass muster under §101.” *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714 (Fed. Cir. 2014). Second, if the answer to the first step is “yes,” then the Court must “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297). This step essentially asks whether the claims add an “inventive concept” that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon

the ineligible concept itself.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297) (modification marks omitted).

Issued patents, such as the patents-in-suit, are entitled to a presumption of validity that applies to §101 challenges, placing a heavy burden on the party alleging that claims are patent ineligible. *CLS Bank Int’l*, 717 F.3d at 1284 (Lourie, J., concurring, joined by Dyk, Prost, Reyna, Wallach, JJ.) (“[A]s with obviousness and enablement, that presumption [of validity] applies when §101 is raised as a basis for invalidity in district court proceedings.”); *id.* at 1304–05 (Rader, J., concurring-in-part and dissenting-in-part, joined by Linn, Moore, O’Malley, JJ.) (“Because we believe the presumption of validity applies to all challenges to patentability, including those under Section 101 and the exceptions thereto, we find that any attack on an issued patent based on a challenge to the eligibility of the subject matter must be proven by clear and convincing evidence.”). To the extent that the district court considered ineligibility as an invalidity defense under §282, then GoDaddy bore the burden to prove invalidity by clear and convincing evidence. *See Microsoft Corp. v. i4i Ltd. Partnership*, 131 S. Ct. 2238, 2242 (2011) (“We consider whether §282 requires an invalidity defense to be proved by clear and convincing evidence. We hold that it does.”). As explained below, the district court incorrectly concluded that GoDaddy met this burden.

**D. The District Court Erred in Invalidating the '219 Claims under §101.**

**1. The '219 claims are not directed to an abstract idea.**

The district court erred in concluding that the '219 claims are directed to the abstract idea of “a general method of collecting and providing information about a dispatch using a third party intermediary.” Appx15. The district court arrived at this flawed conclusion because it improperly overgeneralized the '219 claims and disregarded their specific requirements. Instead of beginning its analysis with the claims, the district court hunted for an abstract idea in the specification’s description of the prior art: “the specification’s own language details how *the general concept at the heart of the Feldbau claims* is one that has been implemented for years.” *Id.* (emphasis added). In doing so, the district court ignored this Court’s warnings not to oversimplify the claimed invention. *See McRO, Inc. v. Bandai Namco Games Am. Inc.*, 2016 U.S. App. LEXIS 16703, at \*24-25 (Fed. Cir. Sep. 13, 2016) (“We have previously cautioned that courts “must be careful to avoid oversimplifying the claims” by looking at them generally and failing to account for the specific requirements of the claims.”) (citing *In re TLI Communs. LLC Patent Litig.*, 823 F.3d 607 (Fed. Cir. 2016). This error virtually ensured that the district court would find the '219 claims directed to an abstract idea. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). (“[D]escribing the claims at such a high level of abstraction and untethered from the language of the claims all but ensures that the

exceptions to §101 swallow the rule.”); *cf. Diehr*, 450 U.S. at 189 n.12 (cautioning that overgeneralizing claims, “if carried to its extreme, make[s] all inventions unpatentable because all inventions can be reduced to underlying principles of nature which, once known, make their implementation obvious”).

Contrary to what the district court found, the ’219 claims do not “simply recite conventional and generic technology to perform ‘generalized steps’ in a well-known computer environment.” Appx16. Rather, the claims are directed to a specific implementation of a solution to a problem in systems for transmitting electronic information. *See Enfish*, 822 F.3d at 1339. Specifically, the ’219 claims address the problem of proving that specific information has been sent at a specific time to a specific receiving party. Appx5985, 1:31-33. The claimed solution improves the capacity of conventional systems and methods for transmitting electronic information by providing the sender with evidence that the sender can use to prove both the dispatch and its contents. Appx5985, 2:57-61.

The ’219 claims do not claim any evidence for this purpose, but rather a specific type of evidence termed “authentication data.” The district court erroneously stated that the ’219 claims fail to explain what comprises the authentication data. Appx20. Rather, the district court construed “authentication data” to require three specific elements relating to the content, the time of successful transmission, and the destination of the dispatch. Appx4694.

In addition, the specific implementation claimed by the '219 claims requires an “authenticator.” Appx5986, 3:1-2. Contrary to what the district court stated, authenticator is not undefined-the district court defined authenticator to mean “a sub-system that operates to authenticate a dispatch.” Appx4700. The '219 claims also require that the authenticator function as a “non-interested third party.” Appx5986, 3:1-2. This limitation is significant because an interested third party could potentially comprise the authentication data. Appx5986, 4:16-29. Thus, the district court construed this limitation to require the authenticator carry out the authentication function “without bias and without the participation of the sender or the recipient.” Appx4700. The district court, however, failed to appreciate or even address the special role that the authenticator plays in the claims.

Further, the district court ignored the securing limitation of the authenticator. Appx5986, 3:8-10. In construing the securing function in claim 82, the district court determined that it “cannot be implemented by a general purpose computer but instead must be implemented in a special purpose computer.” Appx4806. The securing step in the '219 claims recites the same function and therefore further defines a specific implementation of the authenticator. *See Inverness Med. Switz. GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1371 (Fed. Cir. 2002) (“A claim term used in multiple claims should be construed consistently.”)

Moreover, the claims further require that the securing step or the associating step be performed by mathematical association. Appx5986, 3:11-14. The district court misinterpreted RPost's argument that the '219 claims do not require "pure math." Appx16. GoDaddy coined this catchy phrase to give the illusion that the '219 patent claims a mathematical equation. It does not. Rather, the mathematical association limitation defines how the authenticator associates or secures the authentication data. Appx5986, 3:11-14. In other words, like in *Enfish v. Microsoft Corp.*, the Court is "not faced with a situation where general-purpose computer components are added post-hoc to a fundamental economic practice or mathematical equation." *See Enfish*, 822 F.3d at 1339. The district court's observation that the claim do not detail the type of mathematical association is immaterial because that is a question of claim scope, not eligibility. *See BASCOM*, 2016 U.S. App. LEXIS 11687, at \*32 (Newman, J., concurring) ("Claims that are imprecise or that read on prior art or that are unsupported by description or that are not enabled raise questions of patentability, not eligibility.").

Conversely, the district court focused much of its analysis on whether the '219 claims cover a manual embodiment. Appx18-19. But the '219 patent plainly distinguishes between the clerk (manual) embodiment shown in Figure 1 and the authenticator (electronic) embodiments shown in Figure 2-7. Appx5986, 4:45-62. Not only does Figure 1 show humans 10 and 20 and not authenticator 70 as shown

in Figure 2, but the description of Figure 1 does not use the word “authenticator” at all. Appx18-19; Appx5986, 4:66-5:50. Rather, the specification describes authenticator 70 as part of a data communications system for transmitting information by electronic means and as comprising electronic components, such as input unit 72, output unit 58, storage unit 54, and controller 56. Appx5987, 6:31-8:40.

Moreover, during the prosecution of the ’219 claims, the applicants disclaimed the manual embodiment. Before the first office action, the independent ’219 claims did not recite an authenticator. Appx7549-7570. In light of a prior art rejection, the applicants amended each independent claim to require, among other things, “an authenticator functioning as a non-interested third party with respect to the sender and the recipient.” Appx7413-7431. The claim issued with this limitation and therefore encompass only the electronic embodiment.

Finally, the district court failed to perform any inquiry into whether the ’219 claims pose any risk of preemption. Preemption is the primary concern that drives the abstract idea exception to patent eligibility. *See Alice*, 134 S. Ct. at 2354 (“We have described the concern that drives this exclusionary principle as one of preemption.”). In assessing the preemption risk, the Court recently held that it must “look to whether the claims in these patents focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that

itself is the abstract idea and merely invoke generic processes and machinery.” *See McRO*, 2016 U.S. App. LEXIS 16703, at \*28. As detailed above, the ’219 claims are directed to a specific method that improves the ability of conventional data transmission systems to provide proof of a dispatch and its contents. Accordingly, the ’219 claims pose no risk of preemption and are not directed to an abstract idea.

**2. The ’219 claims recite an inventive concept.**

Even if the district court properly characterized the ’219 claims, which it did not, the district court’s judgment must still be reversed because the district court improperly determined that ’219 claims do not recite an inventive concept.

The district court’s step two analysis of the ’219 claims addresses concepts that have nothing to do with eligibility. The district court’s remarks that the mathematical association method is undefined and that the ’219 claims do not detail the type of mathematical association performed are immaterial. These purported deficiencies are issues of definiteness and claim scope, not eligibility. *See BASCOM*, 2016 U.S. App. LEXIS 11687, at \*32 (Newman, J., concurring). It is also immaterial that the ’219 claims allegedly do not explain how the content data is associated with the dispatch record data. This remark also concerns definiteness, not eligibility. *Id.*

The district court also misunderstood the authenticator, which it mistakenly believed was undefined. The district court found that the specification describes the

authenticator as encompassing “all types of apparatus” capable of performing the associating and securing function. Appx21. But this fact does not detract from the “something more” that the authenticator adds to the ’219 claims. Not only is what type of apparatus the authenticator is a question of claim scope, but the fact that the specification describes the authenticator as an apparatus underscores the district court’s mistaken belief that the ’219 claims are directed to a manual embodiment. Moreover, the district court overlooked that it expressly found that the securing function must be performed by a special purpose computer. Appx4806. The authenticator performs the securing in the ’219 claims and therefore must include a special purpose computer. Thus, the ’219 claims require a particular machine, which is an “important and useful clue” that they embody patent-eligible subject matter. *See Bilski*, 130 S. Ct. at 3227.

More importantly, the authenticator adds something more to the alleged abstract idea. The authenticator functions as a non-interested third party with respect to the sender and the recipient. This characteristic is critical because the authenticator must ensure that the authentication data is “provided and associated in a reliable manner” and is “secured against fraudulent actions such as disassociation, modification, replacement etc., attempted by an interested party such as the sending or receiving party . . . .” Appx5986, 4:25-28. By securing the authentication data against tampering, the authenticator transforms this data from data that is tamperable

to data that is non tamperable. Thus, the nature and function of the authenticator embodies the inventive concept of the '219 claims, which is to provide reliable evidence of the dispatch and its contents. Appx5986, 3:57-61.

The district court also misapplied step two by finding that the “associating” and “securing” functions are well-understood, routine, conventional activities previously known to the industry. The inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art. *See BASCOM*, 2016 U.S. App. LEXIS 11687, at \*20-21. Regardless, the district court should have recognized that “securing” is not a generic computer function, but rather must be performed by a special purpose computer. Appx4806.

The district court should have also looked at the claims as a whole as well as the individual claim elements to determine whether the claims contain “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *See McRO*, 2016 U.S. App. LEXIS 16703, at \*23 (citing *Alice*, 134 S. Ct. at 2355) (quoting *Mayo*, 132 S. Ct. at 1294) (alteration in original)). Contrary to what the district court found, the '219 claims do not merely convert input information (dispatch time, dispatch contents, and dispatch destination) to output information (authentication data). The claims require that the authenticator associate these alleged inputs or secure the authentication data by mathematical association. The

authentication data must also be secured against tampering of the sender and recipient by a special purpose computer, which is the authenticator. The authenticator must further function without bias and without participation of the sender or the recipient to ensure that the claimed methods generates reliable evidence of the dispatch and its contents. This combination of features, which the district court ignored, adds significantly more to the alleged abstract idea and renders the '219 claims patent eligible. *Id.*

**E. The District Court Erred in Invalidating the '913 Claims under §101.**

**1. The '913 claims are not directed to an abstract idea.**

The district court erroneously concluded that the '913 claims are directed to the abstract idea of “collecting information about the delivery of a message.” Appx25. As with the '219 claims, the district court overgeneralized the '913 claims and improperly applied step one. The district court’s belief that “[t]he ‘heart’ of a patent is determinative for *Alice* step one” is mistaken. Appx26. Neither the Supreme Court nor this Court have ever articulated such a test. “Rather, the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.” *See Enfish*, 822 F.3d at 1335 (citing *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, the '913 claims are not directed to any form of collecting information about the delivery of a message. The '913 claims are directed to providing verifiable proof of the delivery of an email that does not require the recipient cooperation or special email software. Appx5740, 1:21-24, 2:64-3:4.

The district court's belief that the '913 claims carry out the alleged abstract idea in a generic environment without special email software further shows it missed the point of the invention. Appx27. As this Court recently recognized, the use of generic computing components does not doom the claims. *See Enfish*, 822 F.3d at 1338. This rationale is particularly applicable to this case. As the specification states, the problem with prior art email systems that provide proof of delivery is that they require proprietary email clients or web browser plug-ins. Appx5740, 2:57-63. Such systems are undesirable because they require the sender and the recipient to use the same email client. *Id.* Thus, the claimed solution's ability to provide proof of delivery without special or additional software is part of the improvement over the prior art, not evidence of an abstract idea. *See Enfish*, 822 F.3d at 1335 (“‘improv[ing] an existing technological process’ might not succumb to the abstract idea exception”) (citing *Alice*, 134 S. Ct. at 2358-59); *Research Corp.*, 627 F.3d at 869 (“[I]nventions with specific applications or improvements to technologies in the marketplace are not likely to be so abstract that they override the statutory language and framework of the Patent Act.”).

The '913 claims are also not the electronic version of certified or registered mail. In making this comparison, the district court falsely assumed that postal mail and other hard copy mail delivery are the same as email. They are not. Certified mail and registered mail are two distinct services and each is distinct from email. Appx6231, n. 120. Certified mail provides proof of mailing of hard copy documents, not proof of email delivery. *Id.* Registered mail provides end-to-end delivery of hard copy documents in locked containers, which is not how emails are delivered. *Id.*; Appx6240-6241, ¶9. Although one of the goals of the Tomkow patents is to give email legal status comparable or greater than registered mail, that does not mean that the Tomkow patents claim an electronic version of certified mail or registered mail. The Tomkow patents expressly state that it is not necessary any legal status be accorded to emails sent using the claimed inventions. Appx571, 3:11-17. In fact, the district court expressly rejected GoDaddy's attempt to limit several of the disputed claim terms in this way. Appx4726; Appx4728-4729; Appx4731-4732; Appx4739-4742; Appx4745; Appx4757-4758. Thus, the district court's conclusion that the heart of the '913 claims is directed to a conventional business practice long prevalent in our system of commerce not only conflicts with its claim construction order, but is erroneous.

Furthermore, the '913 claims do not recite generalized steps to be performed on a computer using conventional computer activity. At the time of the invention,

recording the portion of the SMTP and ESMTP dialog in which the recipient's MTA accepts or declines the delivery of the transmitted message was hardly a conventional activity of an email server. Appx5753, 27:48-54. In fact, RPost submitted evidence through its expert, Dr. Jonathan L. Krein, that it was not known to record or store a portion of an SMTP or ESMTP dialog. Appx6239-6244, ¶¶12-14. Dr. Tomkow also testified that the practice of recording a portion of an SMTP dialog for the purpose of documenting message delivery, as required by claim 2, was entirely unknown. Appx6009-6010, 159:20-160:15. Not only did the district court not consider this evidence, the district court performed no analysis of the character of the claims as a whole, other than hastily concluding that they are directed to collecting information about the delivery of a message. This error, along with the errors mentioned above, merit reversal.

**2. The '913 claims recite an inventive concept.**

The district court's finding that the '913 claims do not recite an inventive concept should also be reversed. To say, as the district court did, that the '913 claims invoke three functions—"transmitting," "recording," and "storing"—that can be implemented by nearly every computer proves nothing. Appx28. Just because the '913 claims use common computer functions to introduce steps being performed at an intermediate server does not mean that the '913 claims fail to recite an inventive concept. As the Court has held, an inventive concept may lie "in the non-

conventional and non-generic arrangement of known conventional pieces.” *See BASCOM*, 2016 U.S. App. LEXIS 11687, at \*21. Although SMTP and ESMTP are used to transmit emails, as explained above, the recording and storing of a portion of an SMTP or ESMTP protocol dialog at an intermediate server adds to conventional email systems steps that were not previously known in the art. Appx6241-6243, ¶¶12-14, Appx6009-6010, 159:20-160:15.

Moreover, recording and storing a portion of an SMTP or ESMTP protocol dialog by an intermediate server is a technical solution to the technical problem of proving email delivery. *See DDR Holdings, L.P.*, 773 F.3d at 1257-58. Contrary to what the district court found, it is of consequence that the ’913 claims concern email. Because of its form, email presents unique challenges for establishing proof of delivery that do not exist in hard copy mail delivery systems. Appx7076-7077. One such challenge is proving email delivery without special or additional software as discussed above. One of the other drawbacks of prior art email systems that provide proof of delivery is that they require the recipient to collect their messages from a third party service without any assurance that the recipient would cooperate in receiving the email. Appx5740, 2:21-45. By recording a portion of the SMTP or ESMTP dialog between an intermediate server and the recipient’s MTA, the ’913 claims provide a technical solution to providing proof of email delivery without the cooperation of the recipient.

Notably, the district court in the *Sophos* cases agreed that the '913 claims use of the intermediate server provides a technical solution to establishing proof of email delivery and thus satisfy step two. Appx7077. RPost also presented the same arguments to the PTAB in response to a petition to institute CBM review of the '913 patent. Even under the preponderance of the evidence standard applied by the PTAB, the petitioner could not overcome RPost's arguments that the intermediate server provides a technical solution and that the '913 patent claims a technological invention. Appx6345-6347. Both of these decisions support the conclusion that the '913 claims recite an inventive concept. Appx7077, n. 6.

Finally, the notion that collecting delivery information about a message has been practiced in various forms further highlights the flaws of the district court's analysis. Appx25. The '913 claims are not designed to monopolize all forms of collecting delivery information about a message and thus pose no risk of preemption. *See Alice*, 134 S. Ct. at 2357. Rather, they claim only one way of documenting the delivery history of an email—recording and storing portions of the SMTP or ESMTP protocol dialog between an intermediate server and a receiving MTA. Thus, when properly viewed as a whole, the '913 claims recite an inventive concept and therefore are patent eligible.

**F. The District Court Erred in Invalidating the '104 Claims under §101.**

**1. The '104 claims are not directed to an abstract idea.**

The district court also erroneously concluded that the '104 claims are directed to the abstract idea of “collecting and providing information about the opening of a message.” Appx32. The district court again applied its improper heart-of-the-patent test but this time it did not state what it believed the heart of the '104 claims is. *Id.* Consequently, the district court oversimplified the '104 claims and ignored significant limitations that take them out of the realm of an abstract idea. *McRO*, 2016 U.S. App. LEXIS 16703, at \*24-25 (“We have previously cautioned that courts ‘must be careful to avoid oversimplifying the claims’ by looking at them generally and failing to account for the specific requirements of the claims.”) (citations omitted).

The '104 claims do not merely involve adding links to electronic messages that provide read notifications when activated at the recipient. As the specification points out, such prior art read notifications may be altered or forged. Appx5589, 2:9-14. Rather, the '104 claims also require that the claimed server create “authenticable information,” which the district court construed to be “information unique to the content and delivery of the message that can be verified.” Appx5602, 28:10-12; Appx4687. The authenticable information may include the indication of opening (claim 1), which must also be verifiable, or be transmitted with the

indication of opening in a secure and verifiable manner (claim 32). Appx4683. Either way, the '104 claims are not merely directed to collecting and providing any information about email opening, they are directed to a specific implementation for providing verifiable proof of email opening.

Finally, the district court agreed that the '104 claims are directed to proving opening in its claim construction order: “the '104 patent claims a system and method for verifying, i.e., proving, the opening of a message and the message’s contents.” Appx4715. The district court also detailed how the '104 claims are directed to a two-step verification process, which it found essential to understanding the Tomkow patents. Appx4715-4716; Appx4718 (“The intrinsic record conveys that the primary purpose of the invention is to provide information regarding the delivery, opening, and content of an electronic message that *can be* ‘verified’.”) (emphasis in original). The district court, however, never mentioned its narrower understanding of the '104 claims in its step one analysis and consequently incorrectly concluded that they are directed to an abstract idea.

**2. The '104 claims recite an inventive concept.**

Even if the Court accepts the district court’s flawed reasoning that the '104 claims are directed to an abstract idea, they still fit what the Court deems to be an inventive concept. *See DDR Holdings*, 773 F.3d. at 1259.

Contrary to what the district court found, the problem of proving email opening was not prevalent in the pre-Internet, analog world—it did not exist in that world. Appx35. Accordingly, technical solutions were developed specific to email to provide a form of proof of delivery or opening, such as request for notification tags. Appx5589, 1:41-62. But as noted above, such prior art notifications may be altered or forged. *Id.*, 2:11-14. The '104 patent claims a specific technical way to improve upon the prior art by providing verifiable proof of email opening.

Specifically, the '104 patent claims an intermediate server displaced from the recipient that creates “authentication information”—information unique to the content and delivery of the message that must be able to be verified using the Tomkow patents’ two-step verification process. Appx4735. In claim 1, the authentication information includes the indication of opening and therefore the indication must also be verifiable. Appx4718, Appx5602, 28:11-16. The district court erroneously concluded that the authentication information does not include the indication because it construed the claim that way. *Compare* Appx38, n.19 with Appx4718. In both claims 1 and 27, the server transmits the authentication information and the indication of opening to the sender, which provides the sender verifiable evidence of opening. Appx5602, 28:11-16; Appx5603, 29:33-37. This step is not part of conventional email transmissions and was not part of prior art solutions.

The '104 claim's technical solution fully fits what the Court deemed inventive in *DDR Holdings v. Hotels.com*. The claimed solution—providing verifiable proof of email opening through an intermediate server—is necessarily rooted in computer technology—email—in order to overcome a problem specifically arising in the realm of computer networks—the lack of sufficient forms of proof due to the alterability and forgeability of prior art email delivery notifications. *DDR Holdings*, 773 F.3d at 1257. Like the '913 patent, the PTAB's decision not to institute CBM review of the '104 patent supports this conclusion. Appx6319-6323.

The '104 claims provide the additional benefit of not requiring the recipient cooperation and not requiring special email software. Appx5589, 2:62-3:2. The district court's finding that the '104 claims employ generic, pre-existing computer steps and components does not detract from the '104 claims' inventiveness. The inventive concept inquiry requires more than finding that individual claim elements were known in the art. *See BASCOM*, 2016 U.S. App. LEXIS 11687, at \*21. An inventive concept may lie “in the non-conventional and non-generic arrangement of known conventional pieces.” *Id.* Thus, the district court's invalidity judgment must be reversed.

**G. The District Court Erred in Invalidating the '198 Claims under §101.**

**1. The '198 claims are not directed to an abstract idea.**

The district court erred in concluding that the '198 claims are directed to the abstract idea of “collecting and providing information about the opening and delivery of a message.” Appx42. Although the '198 patent is a continuation of the '104 patent, and therefore has similar claims, the district court incorrectly found that there is no practical difference between the '104 and '198 claims on the one hand and the '913 claims on the other hand. The '104 and '198 claims are directed to providing proof of opening or delivery of an email using authenticable information and a link that provides a verifiable indication that the email has been opened or delivered. The '913 claims, however, provide proof of email delivery by recording a portion of the SMTP or ESMTP dialog exchanged between devices during the transmission of an email. This distinction is significant because the Tomkow patents themselves demonstrate that they are not directed to any method of proving email delivery. Rather, they claim specific implementations of proving email opening or delivery. As such, the Tomkow patents, including the '198 patent, do not implicate the preemption concerns of the abstract idea exception to patent eligibility. *See McRO*, 2016 U.S. App. LEXIS 16703, at \*27. For this reason and the same reasons discussed regarding the '104 claims, the '198 claims are not directed to an abstract idea.

**2. The '198 claims recite an inventive concept.**

The district court also erred in determining that the '198 claims do not recite an inventive concept. As with the '104 claims, the district court failed to consider the '198 claims as an ordered combination in light of its own claim construction. Consequently, the district court failed to recognize that the '198 patent claims a specific technical solution for providing verifiable proof of the delivery and opening of an email without requiring recipient cooperation and without special email software. Appx5627, 2:65-3:5. In this way, like the '104 claims, the '198 patent claims a technical improvement upon prior art delivery notifications, thereby reciting an inventive concept. *Id.*, 2:12-17; *see DDR Holdings*, 773 F.3d at 1257.

The district court's step two reasoning was flawed because the district court again focused on features of the '198 claims that are not determinative of an inventive concept. The district court's finding that the '198 claims recite functions that can be performed by a computer means nothing—email is a computer technology, so of course the '198 claims recite functions that can be performed by a computer. The district court failed to recognize, however, that, at the time of the invention, the step of transmitting to an email sender authenticable and verifiable information regarding the delivery and opening of the email was not a conventional step. Appx5627, 2:12-17. Also, the district court's finding that the '198 claims recite a link that executes when activated at the recipient but do not recite when or

how the link is activated concerns definiteness, not eligibility, and therefore is not indicative of a lack of an inventive concept. Because the district court failed to identify any additional and legitimate reasons why the '198 claims do not recite an inventive concept, the same reasons why the '104 claims recite an inventive concept apply equally to the '198 claims.

#### **H. The District Court Erred in Invalidating the '389 Claims under §101.**

##### **1. The '389 claims are not directed to an abstract idea.**

The district court incorrectly concluded that “the heart of '389 Patent Claims is the general concept of collecting and providing information about a particular message.” Appx45. Again, the district court improperly applied its own heart-of-the-patent test and improperly overgeneralized the claims. *See McRO*, 2016 U.S. App. LEXIS 16703, at \*24-25. In doing so, the district court failed to account for the specific requirements of the '389 claims that show that they are not directed to an abstract idea.

The '389 claims are not merely directed to the collecting a providing information about a particular message; they are directed to verifying the delivery of an email. Like the '913 claims, the '389 claims employ an intermediate server displaced from the recipient that receives a portion of the mail transport protocol dialog during the transmission of the email from the server to the recipient. Appx5717, 28:58-67. The step was not conventional or known in prior art email

systems. Appx6241-6243, ¶¶12-14; Appx6009-6010, 159:20-160:15. In addition, the server receives from the recipient an indication of receipt of the message, which the district court construed to mean “verifiable information that indicates that the message was received by the recipient.” Appx5717, 28:58-67; Appx4684. The server forms a first information from the captured dialog and indication of receipt. The server may transmit the first information to the sender along with a copy of the message (claim 1) or it may store the first information along with a representation of the message (claim 14). Appx5717, 28:1-7; Appx5718, 30:6-8. Through this ordered combination of steps, the ’389 claims provide proof of email delivery without recipient cooperation and without special software, unlike the prior art. Appx5704, 2:62-3:2. As such, the ’389 patent claims a specific technical solution that overcomes the challenges of prior art proof of email delivery systems, not an abstract idea. *See Enfish*, 822 F.3d at 1335.

## **2. The ’389 claims recite an inventive concept.**

Irrespective of whether ’389 claims are directed to an abstract idea, which they are not, the ’389 claims recite an inventive concept. The district court erroneously concluded that the ’389 patent is not directed to a problem specifically arising in the realm of computer technology. Proving delivery of an email is a problem specific to email. Appx7076-7077. The specification details the prior attempts to solve this problem and why those solutions were inadequate. Appx5704-

5705, 2:15-3:2. Just because an allegedly analogous problem existed in the pre-email, analog world does not mean that the problems that the '389 claims address are not unique to email. Moreover, the '389 claims do not invoke computers to solve a problem in the pre-email world, they invoke computers to solve a problem in the email world.

Further, the district court did not address RPost's argument that the '389 claims recite a technical solution to the problem of providing verifiable evidence of email delivery. The claimed solution requires an intermediate server displaced from either a sender or a recipient of an email. Appx5717, 27:58-60, 28:37-39; Appx5718, 29:17-19. The server receives at least a portion of the mail transport protocol dialog generated during transmission of the message from the server to the recipient and a verifiable indication of receipt of the message. Appx5717, 27:63-67, 28:42-46; Appx5718, 30:1-5. As such, the claimed arrangement provides a technical way of providing verifiable evidence that an email was delivered without the sender or recipient doing anything other than use the claimed server to relay the email. *See DDR Holdings*, 773 F.3d at 1257-1259; Appx5704-5705, 2:15-3:2. Like the '913 claims, both the denial of Sophos's motion for judgment on the pleadings under §101 and the PTAB's denial of a petition to institute CBM review regarding the '389 patent support this conclusion. Appx7077, n.6; Appx6332-6335.

By saying that it is well-settled that the receiving and transmitting steps are conventional computer activities, the district court improperly took these claim terms out of context and ignored the rest of the limitations of the '389 claims. *See McRO*, 2016 U.S. App. LEXIS 16703, at \*25 (“[I]n determining the patentability of a method, a court must look to the claims as an ordered combination, without ignoring the requirements of the individual steps.”). The '389 claims do not merely receive and transmit information. Receiving a portion of a mail transport protocol dialog, forming new information from the portion and other verifiable information regarding email delivery, and transmitting the new information to the sender are not conventional steps in an email transmission system. Appx6241-6243, ¶¶12-14; Appx6009-6010, 159:20-160:15. They are ordered steps designed to address a specific problem—providing the sender verifiable evidence of email delivery.

The district court also improperly analyzed the forming step. Again, how the forming is done concerns definitiveness, not eligibility. Also by forming a first information, the '389 claims do not seek to patent the information or its inputs. Appx46. Rather, as discussed above, the '389 claims patent a specific system and method, including forming a first information, for providing verifiable evidence of email delivery. Thus, the district court's finding that the '389 claims do not recite an inventive concept was erroneous and should be reversed.

**I. The District Court Erred in Invalidating the '199 Claims under §101.**

**1. The '199 claims are not directed to an abstract idea.**

The district court erroneously concluded that the '199 claims are directed to the abstract idea of “collecting and providing information that a message was not delivered.” As with the '389 claims, the district court incorrectly framed the problem addressed by the '199 claims. The '199 claims are not directed to a problem in the pre-email, analog world where a computer is used as a tool to solve the problem. The '199 claims are directed to a problem in the email world where previous computer solutions did not solve the problem—the lack of verifiable evidence of email non-delivery. Appx5664, 2:11-16. The '199 claims employ the same technical solution to this problem as the '389 claims except that instead of receiving an indication of receipt, the intermediate server receives an indication of the failure to deliver the message. Appx5677, 27:66-67. Thus, for at least the same reasons as the '389 claims, the '199 claims are not directed to an abstract idea.

The district court also incorrectly found that “the concept of providing information that an electronic message failed to be delivered has been implemented by standard SMTP ‘bounce’ codes for dozens of years.” Appx48. RPost submitted evidence that SMTP codes simply provide a mechanism for a recipient MTA to acknowledge success or failure in responses to a sending MTA’s commands, such as after a DATA transmission step. Appx6242, ¶13. The concept of recording and

storing these codes was not known in the prior art at the time of the '199 patent. *Id.*, ¶14. The district court ignored this evidence and thus reached the erroneous conclusion that the '199 claims are directed to an abstract idea.

**2. The '199 claims recite an inventive concept.**

Even assuming that the '199 claims are directed to an abstract idea, which they are not, the '199 claims recite an inventive concept for the same reasons that the '389 recite an inventive concept. Specifically, the '199 claims recite a technical solution—an intermediate server displaced from the recipient that receives a portion of a data transport protocol dialog and an indication of failure to deliver a message—to solve a technical problem—providing reliable proof of content and delivery of an email. *See DDR Holdings*, 773 F.3d at 1257. The denial of the motion for judgment on the pleadings in the *Sophos* cases supports this point. Appx7077. The '199 claims improve upon the prior art because they describe a particular way to provide evidence of non-delivery that does not require the cooperation of the recipient or special email software. *See BASCOM*, 2016 U.S. App. LEXIS 11687, at \*23; Appx5664, 2:64-3:4.

The district court's analysis under step two is flawed for several reasons. First, the statement “at the heart of the '199 Patent Claims is a method ‘for which computers are invoked merely as a tool’” is erroneous. Appx48. Not only does a heart-of-the-patent test not exist, but the '199 claims do not invoke computers

merely as a tool; they recite an improved way for computers to provide proof of email non-delivery over the prior art. Second, the statement “[t]here is nothing new about the concept of providing information that a message was not delivered” is also erroneous. Not only is novelty not an appropriate consideration under step two, but, as discussed above, recording and storing a portion of a protocol dialog during an email transmission were not known. *See BASCOM*, 2016 U.S. App. LEXIS 11687, at \*20-21; Appx6242, ¶13. Thus, like the ’389 claims, the ’199 claims do not recite conventional email transmission steps. Because the district court incorrectly concluded that the ’199 claims do not recite an inventive concept, its judgment of invalidity of these claims must be reversed.

**J. The District Court Erred in Exercising Subject-Matter Jurisdiction over the ’219 Patent.**

Under the Declaratory Judgment Act, a district court has subject-matter jurisdiction over a declaratory judgment claim if “the facts alleged, under all the circumstances, show that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007) (quoting *Maryland Casualty Co. v. Pac. Coal & Oil Co.*, 312 U.S. 270, 273 (1941)). Specifically, “declaratory judgment jurisdiction will not arise merely on the basis that a party learns of the existence of an adversely held patent, or even perceives that such a patent poses a risk of infringement, in the absence of some

affirmative act by the patentee” directed at the plaintiffs regarding infringement of the patent at issue. *See Ass’n for Molecular Pathology v. USPTO*, 653 F.3d 1329, 1344, 1348 (Fed. Cir. 2011). RPost made no such affirmative act toward GoDaddy regarding the ’219 patent. Therefore, the district court improperly held that it had subject-matter jurisdiction over GoDaddy’s declaratory judgment claim of invalidity of the ’219 patent.

Because the district court entered a final judgment disposing of the case, the interlocutory issue of whether the district court lacked subject-matter jurisdiction over the ’219 patent merges into the final judgment and is appealable. *See, e.g., Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1069 (Fed. Cir. 2005) (citing *Hendler v. United States*, 952 F.2d 1364, 1368 (Fed. Cir. 1991)).

**1. The district court erroneously found that RPost took an affirmative act regarding the ’219 patent.**

Unlike the Tomkow patents, which RPost provided GoDaddy with detailed claim charts demonstrating GoDaddy’s infringement, RPost merely listed the Feldbau patents among many other RPost patents in its pre-suit communications. Appx164-166; Appx168-176; Appx1279. No RPost pre-suit communication contained an analysis of the Feldbau patents, nor did any RPost pre-suit communication accuse GoDaddy of infringing the Feldbau patents or threaten GoDaddy with litigation regarding the Feldbau patents. *Id.* The district court granted RPost’s motion regarding the ’334 patent and recognized that, “[s]imply

listing a patent among numerous other patents in pre-suit communications from a patent owner to a potential infringer is insufficient to establish a justiciable controversy.” Appx2376. Yet the district court improperly held that it had subject-matter jurisdiction over the ’219 patent, despite the fact that RPost never specifically directed GoDaddy to the ’219 patent outside of mere patent lists. Appx2382.

The only distinction between RPost’s pre-suit acts toward GoDaddy regarding the two Feldbau patents was that RPost listed the ’219 patent, among others, under the heading “Additional Recommended Review” on the title page of a presentation analyzing GoDaddy’s infringement of the Tomkow patents. Appx1279. RPost’s oblique, passing reference to one claim of the ’219 patent on the presentation cover page did little more than flag the ’219 patent as a potential topic for future discussions. The district court even acknowledged that this act alone may not be enough to establish subject-matter jurisdiction. Appx2379.

Because RPost’s listing of the ’219 patent did not constitute an affirmative act toward GoDaddy, the district court incorrectly considered RPost’s litigation history in finding that it had subject-matter jurisdiction. While prior litigation is a circumstance to be considered in assessing the totality of circumstances, the fact that RPost had filed infringement suits against other parties for other products does not, in the absence of any affirmative act directed toward GoDaddy, meet the minimum standard discussed in *MedImmune*. See *Innovative Therapies, Inc. v. Kinetic*

*Concepts, Inc.*, 599 F.3d 1377, 1382 (Fed. Cir. 2010) (citing *Prasco, LLC v. Medicis Pharm. Corp.*, 537 F.3d 1329, 1341 (Fed. Cir. 2008)). Thus, the district court improperly factored RPost’s litigation history in its jurisdictional analysis because it still needed to find an affirmative act, which the listing of the ’219 patent was not.

The district court also improperly factored RPost’s refusal to grant GoDaddy a covenant not to sue on the ’219 patent in its analysis. Critically, GoDaddy initiated the discussion when it demanded from RPost a covenant not to sue on the ’219 patent—which RPost had not threatened to assert—in exchange for GoDaddy dropping its original counts against RPI and RMail, neither of which were proper parties to the case based on the Original Complaint. Appx1802-1804. As this Court has made clear, “refusal to grant a covenant not to sue ‘is not sufficient to create an actual controversy’ because ‘a patentee has no obligation . . . to make a definitive determination, at the time and place of the competitors’ choosing, that it will never bring an infringement suit.’” *Microsoft*, 755 F.3d at 906 (quoting *Prasco*, 537 F.3d at 1341). Moreover, the only discussions between the parties regarding a covenant not to sue occurred one month after GoDaddy filed its Original Complaint. Appx1802-1804. Post-complaint facts cannot create jurisdiction where none existed at the time of filing. *Id.* (citing *Innovative Therapies*, 599 F.3d at 1383-84). Thus, the district court’s reliance on RPost’s refusal to grant a covenant not to sue was erroneous.

Finally, neither RPost’s litigation history nor its refusal to grant a covenant not to sue can substitute for the absence of an affirmative act regarding the ’219 patent toward GoDaddy. Because no “substantial controversy . . . of sufficient immediacy and reality” existed when GoDaddy filed its Original or its First Amended Complaint, the district court lacked subject-matter jurisdiction over the ’219 patent.

## VI. CONCLUSION

In conclusion, RPost respectfully requests that the Court vacate the judgement of invalidity of the ’219 patent because the district court lacked subject-matter jurisdiction. Additionally, RPost requests that the Court reverse the judgment and the order granting GoDaddy summary judgment of invalidity under §101 because the district court lacked jurisdiction to decide GoDaddy’s eligibility challenge and erroneously concluded that the patents-in-suit are not patent eligible. Accordingly, the Court should remand this case to the district court for further proceedings.

Dated: September 26, 2016

Respectfully submitted,

Hudnell Law Group P.C.

By: /s/ Lewis E. Hudnell, III  
Lewis E. Hudnell, III

Attorneys for Defendants-Appellants  
RPost Communications Limited  
RPost Holdings, Inc.  
RPost International Limited  
RMail Limited

# **ADDENDUM**

1 **WO**

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**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF ARIZONA**

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GoDaddy.com LLC,

No. CV-14-00126-PHX-JAT

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Plaintiff,

**ORDER**

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v.

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RPost Communications Limited, et al.,

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Defendants.

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Pending before the Court are Plaintiff GoDaddy.com LLC (“GoDaddy”)’s Motion for Summary Judgment, (Doc. 257), and Defendants’<sup>1</sup> Motion for Summary Judgment on Plaintiff’s Count I (Fraudulent Misrepresentation of Patent Ownership), (Doc. 284). The Court now rules on the motions.

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**I. Background**

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After multiple rounds of motions to dismiss, briefing for a three-month stay, complete *Markman* review, a *Daubert* motion, and dozens of other motions, the factual background of this case is well-established. In short, GoDaddy filed this Declaratory Judgment Action against RPost, seeking, among other things, damages for fraudulent misrepresentation and declarations of invalidity and non-infringement of various patents (the “Asserted Patents”)<sup>2</sup> after RPost attempted to enforce those patents against

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<sup>1</sup> Defendants are RPost Communications Ltd.; RPost Holdings, Inc.; RPost International Ltd.; and RMail Ltd. Defendants are collectively referred to as “RPost.”

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<sup>2</sup> The Asserted Patents are (1) U.S. Patent No. 8,224,913 (filed July 17, 2012) (the

1 GoDaddy. (Doc. 46 at 38). RPost counterclaimed, alleging that GoDaddy is liable for  
2 direct infringement of the Asserted Patents. (Doc. 108 at 20–27).

### 3 **II. Legal Standard**

4 Summary judgment is appropriate when “the movant shows that there is no  
5 genuine issue as to any material fact and that the moving party is entitled to summary  
6 judgment as a matter of law.” Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be  
7 or is genuinely disputed must support that assertion by “citing to particular parts of  
8 materials in the record,” including depositions, affidavits, interrogatory answers or other  
9 materials, or by “showing that materials cited do not establish the absence or presence of  
10 a genuine dispute, or that an adverse party cannot produce admissible evidence to support  
11 the fact.” *Id.* at 56(c)(1). Thus, summary judgment is mandated “against a party who fails  
12 to make a showing sufficient to establish the existence of an element essential to that  
13 party’s case, and on which that party will bear the burden of proof at trial.” *Celotex Corp.*  
14 *v. Catrett*, 477 U.S. 317, 322 (1986).

15 Initially, the movant bears the burden of pointing out to the Court the basis for the  
16 motion and the elements of the causes of action upon which the non-movant will be  
17 unable to establish a genuine issue of material fact. *Id.* at 323. The burden then shifts to  
18 the non-movant to establish the existence of material fact. *Id.* The non-movant “must do  
19 more than simply show that there is some metaphysical doubt as to the material facts” by  
20 “com[ing] forward with ‘specific facts showing that there is a genuine issue for trial.’”

21  
22 “’913 Patent”); (2) U.S. Patent No. 8,209,389 (filed June 26, 2012) (the “’389 Patent”);  
23 (3) U.S. Patent No. 8,161,104 (filed April 17, 2012) (the “’104 Patent”); (4) U.S. Patent  
24 No. 8,468,198 (filed June 18, 2013) (the “’198 Patent”); (5) U.S. Patent No. 8,468,199  
25 (filed June 18, 2013) (the “’199 Patent”); and (6) U.S. Patent No. 6,182,219 (filed  
26 January 30, 2001) (the “’219 Patent”). The ’104, ’389, ’913, ’198, and ’199 Patents are  
27 referred to herein as the “Tomkow Patents.” The ’219 Patent is referenced as the  
28 “Feldbau Patent.”

GoDaddy’s First Amended Complaint (“FAC”) also included Counts for  
declarations of invalidity and non-infringement of U.S. Patent No. 6,571,334. (Doc. 46 at  
33–34, 36–37). In a prior Order, the Court dismissed those Counts due to a lack of  
justiciable controversy. *See* (Doc. 107 at 9, 14).

1 *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586–87 (1986) (quoting  
2 Fed. R. Civ. P. 56(e) (1963) (amended 2010)). A dispute about a fact is “genuine” if the  
3 evidence is such that a reasonable jury could return a verdict for the nonmoving party.  
4 *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). The non-movant’s bare  
5 assertions, standing alone, are insufficient to create a material issue of fact and defeat a  
6 motion for summary judgment. *Id.* at 247–48. Further, because “[c]redibility  
7 determinations, the weighing of the evidence, and the drawing of legitimate inferences  
8 from the facts are jury functions, not those of a judge, . . . [t]he evidence of the  
9 nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor” at  
10 the summary judgment stage. *Id.* at 255 (citing *Adickes v. S.H. Kress & Co.*, 398 U.S.  
11 144, 158–59 (1970)); *Harris v. Itzhaki*, 183 F.3d 1043, 1051 (9th Cir. 1999) (“Issues of  
12 credibility, including questions of intent, should be left to the jury.” (citations omitted)).

13 At the summary judgment stage, the trial judge’s function is to determine whether  
14 there is a genuine issue for trial. There is no issue for trial unless there is sufficient  
15 evidence favoring the non-moving party for a jury to return a verdict for that party.  
16 *Liberty Lobby, Inc.*, 477 U.S. at 249–50. If the evidence is merely colorable or is not  
17 significantly probative, the judge may grant summary judgment. *Id.* Notably, “[i]t is well  
18 settled that only admissible evidence may be considered by the trial court in ruling on a  
19 motion for summary judgment.” *Beyene v. Coleman Sec. Servs., Inc.*, 854 F.2d 1179,  
20 1181 (9th Cir. 1988).

### 21 **III. GoDaddy’s Motion for Summary Judgment**

22 GoDaddy moves for summary judgment on seven issues. First, GoDaddy argues  
23 that “the asserted claims of the RPost Patents claim patent-ineligible abstract ideas and  
24 are invalid under 35 U.S.C. § 101.” (Doc. 257 at 7). Second, GoDaddy contends that the  
25 ’913 Patent is invalid as “obvious” under 35 U.S.C. § 103. (*Id.*) Third, GoDaddy  
26 maintains that the “earliest priority date claimable for the Tomkow Patents” is December  
27 17, 1999. (*Id.*) Fourth, GoDaddy asserts that it has “intervening rights as to the Feldbau  
28

1 Patent.” (*Id.*) Fifth, GoDaddy contends that the Accused Products<sup>3</sup> do not infringe the  
2 asserted claims of the Tomkow Patents that recite a “copy” or “representation” of “the  
3 message.” (*Id.*) Sixth, GoDaddy insists that the Accused Products do not infringe the  
4 asserted Feldbau Patent claims. (*Id.*) Finally, GoDaddy moves for summary judgment on  
5 the issue of damages. (*Id.*)

6 **A. Eligibility of the Asserted Patents**

7 GoDaddy contends that the Asserted Patents are invalid under 35 U.S.C. § 101  
8 because they claim patent-ineligible subject matter. (Doc. 257 at 9–10). Specifically,  
9 GoDaddy argues that the Asserted Patents claim “abstract ideas” lacking “inventive  
10 concepts sufficient to transform the claimed abstract idea into a patent-eligible  
11 application.” (Doc. 257 at 10–15) (citing *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134  
12 S. Ct. 2347, 2354–55 (2014) (“*Alice*”). As to the Feldbau Patent, GoDaddy argues that  
13 the claims are drawn to the “abstract idea of collecting and providing information for  
14 proving a message was sent to a recipient at a particular time with particular content”  
15 without adding an inventive concept sufficient to confer eligibility. (*Id.* at 18). Regarding  
16 the Tomkow Patents, GoDaddy contends that the claims are drawn to the abstract idea of  
17 “collecting and providing information for verifying transmission and/or delivery of a  
18 message” without including an inventive concept to transform that idea into a patent-  
19 eligible application. (*Id.* at 14).

20 In response, RPost asserts that an eligibility challenge under § 101 is not a  
21 statutory defense in patent infringement litigation and therefore the Court lacks  
22 jurisdiction over GoDaddy’s argument. (Doc. 299 at 8–13). According to RPost, neither  
23 the Supreme Court of the United States nor the Federal Circuit has expressly held that  
24 § 101 is a statutory defense. (*Id.*) RPost explains that the section heading of § 101,  
25 “Inventions patentable,” takes the statute out of the realm of statutory defenses  
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27 <sup>3</sup> The “Accused Products” are GoDaddy’s Express Email Marketing (“EEM”),  
28 GoDaddy Email Marketing (“GEM”), and the MadMimi email marketing product  
 (“MadMimi”).

1 demarcated in 35 U.S.C § 282(b). (*Id.*) In the alternative, RPost argues that the Asserted  
2 Patents are directed to patent-eligible subject matter and recite inventive concepts. (*Id.* at  
3 13–22). Specifically, RPost contends that the Feldbau Claims provide a technical solution  
4 to a technical problem using an “authenticator.” (*Id.* at 20–21). RPost further argues that  
5 the Feldbau Claims add an “inventive concept” because the invention requires a physical  
6 “transform[ation]” of the information. (*Id.* at 21–22) As to the Tomkow Patents, RPost  
7 asserts that GoDaddy’s characterization of the patents is a “gross oversimplification.” (*Id.*  
8 at 14). Instead, RPost insists that the asserted Tomkow Patent claims “recite specific  
9 ways to verify delivery of an electronic message using specific information.” (*Id.*)

### 10 **1. Jurisdiction**

11 Before reaching the merits of GoDaddy’s eligibility argument, the Court must first  
12 determine whether it has jurisdiction over patent-eligibility challenges brought pursuant  
13 to § 101. According to RPost, § 101 eligibility is not an authorized statutory defense  
14 because § 101 is not listed or referenced in § 282(b), the statute designating patent  
15 litigation defenses. (Doc. 299 at 8–13). GoDaddy, on the other hand, believes that its  
16 § 101 eligibility challenge is properly before the Court due to a long litany of Federal  
17 Circuit and Supreme Court cases interpreting § 101 in the context of patent litigation.  
18 (Doc. 314 at 7–8) (citing cases). Most notably, GoDaddy points to the recent landmark  
19 decision in which the Supreme Court further refined the standards applicable to § 101  
20 eligibility challenges in patent litigation, *Alice*. (*Id.*)

#### 21 **a. Legal Background**

22 Section 282(b) of Title 35 of the United States Code provides an exhaustive  
23 catalogue of defenses available to an alleged infringer in an action involving the validity  
24 or infringement of a patent:

- 25 (1) Noninfringement, absence of liability for infringement or  
26 unenforceability,
- 27 (2) Invalidity of the patent or any claim in suit on any ground specified in  
28 part II of this title as a condition for patentability,
- (3) Invalidity of the patent or any claim in suit for failure to comply with—
  - (A) any requirement of section 112, except that the failure to

1 disclose the best mode shall not be a basis on which any claim of a  
2 patent may be canceled or held invalid or otherwise unenforceable;  
3 or

(B) any requirement of section 251.

(4) Any other fact or act made a defense by this title.

4 § 282(b). For purposes of this case, the pertinent provision of § 282(b) is the second  
5 section, which authorizes defenses based on “invalidity of the patent on or any claim in  
6 suit on any ground specified in part II of this title as a condition for patentability.”  
7

8 Part II of Title 35 encompasses §§ 100–212. Of these sections, three are relevant  
9 here: §§ 101, 102, and 103. Section 101 is entitled “Inventions patentable” and states as  
10 follows: “Whoever invents or discovers any new and useful process, machine,  
11 manufacture, or composition of matter, or any new and useful improvement thereof, may  
12 obtain a patent therefor, subject to the conditions and requirements of this title.” § 101.  
13 Section 102 is labeled “Conditions of patentability; novelty” while Section 103 is  
14 designated “Conditions for patentability; non-obvious subject matter.” *See* §§ 102, 103.

15 Fifty years ago, the Supreme Court stated that,

16 The [Patent] Act sets out the conditions of patentability in three sections.  
17 An analysis of the structure of these three sections indicates that  
18 patentability is dependent upon three explicit conditions: novelty and utility  
as articulated and defined in § 101 and § 102, and nonobviousness, the new  
statutory formulation, as set out in § 103.

19 *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966). Fifteen years after *Graham*, the  
20 Supreme Court observed that “Section 101 sets forth the subject matter that can be  
21 patented, ‘subject to the conditions and requirements of this title.’ The conditions under  
22 which a patent may be obtained follow [§ 101].” *Diamond v. Diehr*, 450 U.S. 175, 190  
23 (1981) (citing S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); U.S. Code Cong. &  
24 Admin. News, 1952, p. 2399)). More recently, the Supreme Court explained that,

25 The § 101 patent-eligibility inquiry is only a threshold test. Even if an  
26 invention qualifies as a process, machine, manufacture, or composition of  
27 matter, in order to receive the Patent Act’s protection the claimed invention  
28 must also satisfy “the conditions and requirements of this title.” § 101.  
Those requirements include that the invention be novel, *see* § 102,  
nonobvious, *see* § 103, and fully and particularly described, *see* § 112.

1 *Bilski v. Kappos*, 561 U.S. 593, 602 (2010). Two years later, the Supreme Court  
2 identified a two-part analysis for determining § 101 eligibility in patent litigation. *See*  
3 *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012).  
4 Finally, in *Alice*, the Supreme Court further developed and refined the *Mayo* two-step  
5 inquiry. *See* 134 S. Ct. at 2354–55.

6 Similarly, although the Federal Circuit has recognized that only §§ 102 and 103  
7 are textually “denominated” as “conditions of patentability,” *MySpace, Inc. v. GraphOn*  
8 *Corp.*, 672 F.3d 1250, 1259–60 (Fed. Cir. 2012), it has long held that § 282’s defenses  
9 “include not only the ‘conditions of patentability’ in §§ 102 and 103, but also those in  
10 § 101,” *DealerTrack, Inc. v. Huber*, 674 F.3d 1315, 1330 n.3 (Fed. Cir. 2012); *see*  
11 *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 543 F.3d 657, 661, 661 n.3 (Fed.  
12 Cir. 2008) (observing that “it is beyond question that section 101’s other requirement,  
13 that the invention be directed to patentable subject matter, is also a condition for  
14 patentability” but noting that “sections 102 and 103,” unlike § 101, “are explicitly  
15 entitled conditions for patentability”). In other words, the Federal Circuit uniformly holds  
16 that § 101 can be raised as a defense in patent infringement litigation. *See, e.g., MySpace*,  
17 672 F.3d at 1261 (recognizing the benefits of shifting invalidity challenges towards  
18 §§ 102 and 103 but acknowledging that “Does this mean that § 101 can never be raised  
19 initially in a patent infringement suit? No.”).

20 **b. Analysis**

21 Notwithstanding the complexity of RPost’s argument, the Court finds that it has  
22 jurisdiction over GoDaddy’s § 101 eligibility challenge. In a slightly different context,  
23 the Federal Circuit recently addressed this precise question. In *Versata Development*  
24 *Group, Inc. v. SAP America, Inc.*, the Federal Circuit summarized the patentee’s  
25 argument as follows:

26 [Covered Business Method (“CBM”)] post-grant review must be limited to  
27 a ground that could be raised under paragraph (2) or (3) of section 282(b).  
28 [Patentee] then reasons that § 282(b)(2) authorizes defenses on any ground  
‘specified in part II as a condition for patentability,’ and that the part II  
reference includes under the headings in the compiled statutes only

1 ‘conditions for patentability,’ i.e., §§ 102 and 103, but not § 101. Based on  
2 the headings in part II of the statutes, [Patentee] draws a distinction  
3 between the heading under which § 101 appears, ‘inventions patentable,’  
and ‘conditions of patentability’ under which §§ 102 and 103 are listed.

4 793 F.3d 1306, 1329–30 (Fed. Cir. 2015). Ultimately, the Federal Circuit held that  
5 jurisdiction over the alleged infringer’s § 101 eligibility challenge was proper for the  
6 following reasons:

7 [Patentee] is correct that a strict adherence to the section titles can  
8 support an argument that § 101 is not listed as a ‘condition of patentability,’  
9 but rather has the heading of ‘inventions patentable.’ However, as noted by  
10 the [United States Patent and Trademark Office (“USPTO”)], both our  
11 opinions and the Supreme Court’s opinions over the years have established  
12 that § 101 challenges constitute validity and patentability challenges. *See*  
13 *also Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 453 (Fed. Cir.  
14 1985); *Aristocrat*, 543 F.3d at 661 n.3.

15 It would require a hyper-technical adherence to form rather than an  
16 understanding of substance to arrive at a conclusion that § 101 is not a  
17 ground available to test patents under either the [Post Grant Review] or  
18 § 18 processes. Section 101 validity challenges today are a major industry,  
19 and they appear in case after case in our court and in Supreme Court cases,  
20 not to mention now in final written decisions in reviews under the [America  
21 Invents Act (“AIA”)]. The numerous cases in our court and in the Supreme  
22 Court need no citation . . . .

23 It is often said, whether accurate or not, that Congress is presumed to  
24 know the background against which it is legislating. Excluding § 101  
25 considerations from the ameliorative processes in the AIA would be a  
26 substantial change in the law as it is understood, and requires something  
27 more than some inconsistent section headings in a statute’s codification.  
28 We agree with the USPTO and SAP and we so hold that, looking at the  
entirety of the statutory framework and considering the basic purpose of  
CBM reviews, the [Patent Trial and Appeal Board (“PTAB”)] acted within  
the scope of its authority delineated by Congress in permitting a § 101  
challenge under AIA § 18.

*Id.* at 1330. Of course, as RPost emphasizes, the *Versata* court decided a slightly different  
issue, i.e., the jurisdiction of a court to rule on a § 101 challenge brought under AIA § 18.  
*See id.* To that end, RPost contends that the statutory history of the AIA is different than  
that of the Patent Act, and thus argues that Congress did not specify § 101 as a “condition  
of patentability” for purposes of § 282 in *infringement* litigation. *See* (Doc. 299 at 8–13).

1 Similar to the Federal Circuit in *Versata*, the Court finds that a “hyper-technical  
2 adherence” to the section heading of § 101 is not enough to overcome decades of  
3 interpreting § 101 as a valid defense in patent infringement litigation. *See Lewis v.*  
4 *Hegstrom*, 767 F.2d 1371, 1376 (9th Cir. 1985) (noting that courts must not hinge  
5 “interpretation of a statute upon a single word or phrase but rather look to the statute as a  
6 whole, as well as its object and policies”); *see also Pa. Dep’t of Corrs. v. Yeskey*, 524  
7 U.S. 206, 212 (1998) (“The title of a statute . . . cannot limit the plain meaning of the text.  
8 For interpretive purposes, it is of use only when it sheds light on some ambiguous word  
9 or phrase.” (quotation omitted)). This is not a case where a mere sprinkling of district  
10 courts has incorrectly interpreted an infrequently-invoked statute or where a sharp divide  
11 exists in the judicial system. Indeed, the Supreme Court and Federal Circuit  
12 unwaveringly consider § 101 to be a viable and robust defense in the context of patent  
13 infringement litigation.<sup>4</sup> Whether couched as a “threshold test,” *see Bilski*, 561 U.S. at  
14 602, or a “condition of patentability,” *see Aristocrat*, 543 F.3d at 661 n.3, it is firmly  
15 decided that the Court has jurisdiction to determine whether the Asserted Patents claim  
16 eligible subject matter under § 101, and RPost’s reliance on § 101’s section heading is  
17 not enough to create a “substantial change in the law as it is understood,” *Versata*, 793  
18 F.3d at 1330.

### 19 c. Conclusion

20 For the foregoing reasons, the Court concludes that it has jurisdiction to consider  
21 whether the Asserted Patents claim patent-eligible subject matter as required by § 101.  
22 Accordingly, the Court now turns to the merits of GoDaddy’s § 101 argument.

### 23 2. Legal Standard for § 101 Eligibility

24 As quoted above, § 101 of the Patent Act defines the subject matter eligible for  
25

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26 <sup>4</sup> In fact, during the pendency of these motions, the Federal Circuit has decided  
27 multiple cases where a party accused of patent infringement has invoked § 101 as a  
28 defense. *See, e.g., In re TLI Commc’ns LLC Patent Litig.*, – F.3d –, 2016 WL 2865693, at  
\*3 (Fed. Cir. May 17, 2016); *Enfish, LLC v. Microsoft Corp.*, – F.3d –, 2016 WL  
2756255, at \*4 (Fed. Cir. May 12, 2016).

1 patent protection as follows: “Whoever invents or discovers any new and useful process,  
2 machine, manufacture, or composition of matter, or any new and useful improvement  
3 thereof, may obtain a patent therefor, subject to the conditions and requirements of this  
4 title.” § 101. “Issues of patent-eligible subject matter are questions of law” reserved  
5 exclusively to the Court. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366,  
6 1369 (Fed. Cir. 2011).

7 The Supreme Court, as noted above, has identified a two-part test for § 101 patent-  
8 eligibility in infringement litigation. *See Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct.  
9 at 1296–97). First, the Court must determine whether the claims at issue are directed to a  
10 patent-ineligible concept, i.e., “Laws of nature, natural phenomena, and abstract ideas.”  
11 *Id.* (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107,  
12 2116 (2013)). The term “abstract idea” embodies “the longstanding rule that an idea of  
13 itself is not patentable.” *Id.* (citing *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Not  
14 surprisingly, “precision has been elusive in defining an all-purpose boundary between the  
15 abstract and the concrete.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343,  
16 1345 (Fed. Cir. 2015); *see Versata*, 793 F.3d at 1331 (noting that the abstract ideas  
17 exception “is more of a problem, a problem inherent in the search for a definition of an  
18 ‘abstract idea’ that is not itself abstract”).<sup>5</sup>

19 Nonetheless, several guiding principles emerge from Supreme Court and Federal  
20 Circuit precedent. For example, if the heart of the patent is a “fundamental economic  
21 practice,” “conventional business practices,” or a “method of organizing human activity”  
22 that has long been “prevalent in our system of commerce,” then the patent is directed to  
23 an abstract idea. *Alice*, 134 S. Ct. at 2356; *see DDR Holdings LLC v. Hotels.com, L.P.*,  
24 773 F.3d 1245, 1256 (Fed. Cir. 2014) (same). Moreover, concepts involving processes  
25 humans can perform without the aid of a computer, such as processes that can be done

26  
27 <sup>5</sup> The Federal Circuit has strained for years to develop a coherent and consistent  
28 test for ascertaining what is or is not an “abstract idea.” *See MySpace*, 672 F.3d at 1259  
 (“This effort to descriptively cabin § 101 jurisprudence is reminiscent of the oenologists  
 trying to describe a new wine.”).

1 mentally or using pen and paper, are generally directed to abstract ideas. *See, e.g.,*  
2 *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347  
3 (Fed. Cir. 2014) (noting that “humans have always performed” the functions of  
4 collecting, recognizing, and storing data); *CyberSource*, 654 F.3d at 1373 (“[A] method  
5 that can be performed by human thought alone is merely an abstract idea and is not  
6 patent-eligible under § 101.”); *Gottschalk*, 409 U.S. at 67 (observing that the conversion  
7 of binary numerals can be done mentally using a mathematical table). Notably, method  
8 patents, like the ones at issue in this case, present “special problems in terms of  
9 vagueness and suspect validity.” *Bilski*, 561 U.S. at 608.

10 If the claims at issue are directed to a patent-ineligible concept, the Court must  
11 then consider “what else” encompasses the claims to determine whether an “inventive  
12 concept,” i.e., “an element or combination of elements that is ‘sufficient to ensure that the  
13 patent in practice amounts to significantly more than a patent upon the [ineligible  
14 concept] itself,’” exists. *Alice*, 134 S. Ct. at 2360 (quoting *Mayo*, 132 S. Ct. at 1298). The  
15 Supreme Court has recognized that “[a]t some level, all inventions embody, use, reflect,  
16 rest upon, or apply laws of nature, natural phenomenon, or abstract ideas.” *Id.* at 2354  
17 (citing *Diamond*, 450 U.S. at 187). Thus, only if an invention applies a patent-ineligible  
18 concept towards a “new and useful end” will it remain eligible for patent protection. *Id.*  
19 (citing *Gottschalk*, 409 U.S. at 67). To perform this analysis, the Court reviews “the  
20 elements of each claim both individually and as an ordered combination to determine  
21 whether the additional elements transform the nature of the claim into a patent-eligible  
22 application.” *Id.* (internal quotations omitted). Ultimately, the Court must “distinguish  
23 between patents that claim the building blocks of human ingenuity and those that  
24 integrate the building blocks into something more, thereby transforming them into a  
25 patent-eligible invention.” *Id.* (citing *Mayo*, 132 S. Ct. at 1303).

26 Notably, “[m]erely requiring a generic computer implementation fails to transform  
27 [an] abstract idea into a patent-eligible invention.” *Id.* at 2352; *see, e.g., buySAFE, Inc. v.*  
28 *Google, Inc.*, 765 F.3d 1350, 1354–55 (Fed. Cir. 2014) (noting that *Alice* “made clear that

1 a claim directed to an abstract idea does not move into § 101 eligibility territory by  
2 merely requiring generic computer implementation” (quotation omitted)); *Ultramercial,*  
3 *Inc. v. Hulu, LLC*, 772 F.3d 709, 717 (Fed. Cir. 2014) (“[A]dding a computer to  
4 otherwise conventional steps does not make an invention patent-eligible.”). If the claim  
5 purports to solve a problem arising only in the Internet context, the claim must be  
6 innovative enough to “override[] the routine and conventional” use of the computer. *DDR*  
7 *Holdings*, 773 F.3d at 1258–59.

### 8 **3. Burden of Proof**

9 By statute, issued patents are “presumed valid.” § 282(a). As the party challenging  
10 the validity of the Asserted Patents, GoDaddy bears the burden of proof. *See Microsoft*  
11 *Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238, 2242 (2011). RPost argues that GoDaddy must  
12 meet this burden by setting forth “clear and convincing evidence” of patent ineligibility.  
13 (Doc. 299 at 14). GoDaddy, however, contends that “the usual presumption of validity  
14 does not apply” to issues of patent-eligibility. (Doc. 257 at 8).

15 While district courts have varied in their approaches when ruling on a validity  
16 challenge based on patent-eligibility, *see, e.g., Broadband iTV, Inc. v. Oceanic Time*  
17 *Warner Cable, LLC*, 135 F. Supp. 3d 1175, 1180 (D. Haw. 2015) (declining to apply the  
18 presumption of validity but requiring clear and convincing evidence to prove underlying  
19 questions of fact); *Tranxition, Inc. v. Lenovo (U.S.) Inc.*, 2015 WL 4203469, at \*5 (D. Or.  
20 July 9, 2015) (“[T]he Court fails to see how the ‘clear and convincing’ standard applies to  
21 the validity analysis under Section 101 in this case.”), and at least one Federal Circuit  
22 judge believes that “applying a presumption of eligibility is particularly unwarranted,”  
23 *Ultramercial*, 772 F.3d at 720 (Mayer, J., concurring), neither the Supreme Court nor the  
24 Federal Circuit has issued a controlling decision designating which standard applies.  
25 Nonetheless, the Court finds it unnecessary to resolve this issue because even if the clear  
26 and convincing standard applied and the Asserted Patents were presumed eligible, the  
27 result of this case would be no different than if the preponderance of the evidence  
28 standard applied without a presumption of validity.

1                   **4. Feldbau Patent**<sup>6</sup>

2           The Feldbau Claims disclose a “method of authenticating” that a sender of a  
3 “dispatch” “electrically transmitted” it to a particular destination at a particular time and  
4 that it had a particular content. ‘219 Patent, col. 2 ll. 56–col. 3 ll. 14 (amended version).<sup>7</sup>  
5 The Feldbau Claims accomplish this objective by having the sender of the transmission  
6 “electrically transmit” the contents to a non-interested third party, i.e., “an authenticator.”  
7 *Id.* at col. 2 ll. 63–67. The authenticator then “associates” information such as the time of  
8 the successful transmission and the dispatch’s contents to “generate” data that  
9 “authenticate[s] the dispatch and the contents of the dispatch,” i.e., “authentication data.”  
10 *Id.* at col. 3 ll. 1–7. The authenticator must also “secure” the authentication data “against  
11 tampering.” *Id.* at col. 3 ll. 8–10. In full, the Feldbau Claims recite as follows:

12                   **60.** A method of authenticating a dispatch and contents of the  
13 dispatch successfully transmitted from a sender to a recipient, comprising  
14 the steps of:

15                   receiving content data representative of the contents of the dispatch  
16 originated from the sender and being electrically transmitted to said  
17 recipient, and a destination of the dispatch;

18                   providing an indicia [**relating to**] of a time of *successful*  
19 transmission of the dispatch *to the recipient*, said time related indicia being  
20 *recorded by an authenticator and* provided in a manner resistant to or  
21 indicative of tampering by either of the sender and the recipient;

22                   associating, by [**an**] the authenticator functioning as a noninterested  
23 third party with respect to the sender and the recipient, the content data with  
24 dispatch record data which includes at least said time related indicia and an  
25 indicia related to the destination of the dispatch, to generate authentication  
26 data which authenticate the dispatch and the contents of the dispatch; and

27                   securing by said authenticator at least part of the authentication data  
28 against tampering of the sender and the recipient;

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24                   <sup>6</sup> The asserted claims of the Feldbau Patent are Claim Nos. 60, 62, 66, and 69. *See*  
25 (Docs. 258 at 12; 271-5 at 2; 300 at 10). These claims will be referenced herein as the  
26 “Feldbau Claims.”

27                   <sup>7</sup> In 2012, the Feldbau Patent underwent an Ex Parte Reexamination by the  
28 USPTO. *See* (Doc. 271-16 at 25). Several claims—including two of the claims asserted  
against GoDaddy in this case—were amended upon Reexamination. *See (id.* at 26). When  
citing to the reexamined patent, the Court will refer to it as the “amended version.”

1 wherein at least one of the steps of associating and securing utilizes  
2 mathematical association methods for a selected portion of a combination  
of the content data and the dispatched record data.

3 *Id.* at col. 2 ll. 56–col. 3 ll. 14 (amendments by Ex Parte Reexamination Certificate are  
4 shown in italics; deletions in bolded square brackets).

5 **62.** A method according to claim **60**, further including the step of providing  
6 an output of at least part of the authentication data.

7 ‘219 Patent, col. 24 ll. 32–34.

8 **66.** A method according to claim **60**, wherein the step of providing the time  
9 **[related]** indicia includes generating the time **[related]** indicia.

10 ‘219 Patent, col. 3 ll. 17–19 (amended version) (amendments by Ex Parte Reexamination  
11 Certificate are shown in italics; deletions in bolded square brackets).

12 **69.** A method according to claim **60**, wherein the authentication data further  
includes a delivery indicia relating to said dispatch.

13 ‘219 Patent, col. 24 ll. 52–54.

14 To begin, the Court must determine whether the Feldbau Claims are drawn to a  
15 patent-ineligible concept, i.e., law of nature, natural phenomena, or abstract idea. *See*  
16 *Alice*, 134 S. Ct. at 2355. If so, the Court will then consider whether the claims add an  
17 “inventive concept” such that the ineligible concept transforms into a patent-eligible  
18 application. *Id.*

19 **a. Step One: Patent-Ineligible Concept**

20 GoDaddy argues that the Feldbau Claims are directed to the abstract idea of  
21 collecting and providing information about a dispatch and its contents using a third party  
22 intermediary. (Doc. 257 at 18). GoDaddy contends that the asserted claims simply apply  
23 “pure math” to accomplish its goals. (*Id.*) In response, RPost insists that the Feldbau  
24 Claims “address[] the specific technical problem of proving that specific information has  
25 been electronically sent at a specific time to a specific receiving party” by having an  
26 “authenticator [] generate authentication data which authenticate[s] the dispatch and the  
27 contents of the dispatch.” (Doc. 299 at 20). RPost explains that the Feldbau Claims do not  
28 use “pure math” but apply “specific functions” performed by the authenticator. (*Id.*)

1 Although RPost’s application of the Feldbau Claims may be phrased in its narrow,  
2 flowery rhetoric, the claim language is not nearly as particularized. Rather, the Feldbau  
3 Claims are directed to a general method of collecting and providing information about a  
4 dispatch using a third party intermediary. This is an abstract idea that has an extensive  
5 history dating back decades, if not centuries. For example, the Fedlbau Patent’s  
6 specification posits that “[p]ost, courier, forwarding and other mail services, which  
7 enable people to exchange documents and data, have been widely used both in the past  
8 and at the present time.” ‘219 Patent, col. 1 ll. 23–29. The specification further describes  
9 how third party intermediaries collect and provide certain information about a message in  
10 the modern world,

11 Proof of delivery of non-electronic documents is provided, for  
12 example, by Registered Mail and courier services. It is commonly used to  
13 authenticate the delivery of materials at a certain time to a certain party, and  
14 serves as admissible proof of delivery in a court of law. However, no proof  
15 is provided as to the information contents of the specific dispatch.

16 E-mail and other electronic messages forwarding services are  
17 commonly used today. The sender sends a message to the dispatching  
18 service which, in turn, forwards the message to the destination and provides  
19 the sender with a delivery report which typically includes the date and time  
20 of the dispatch, the recipient’s address, the transmission completion status,  
21 and sometimes even the transmitted data, the number of pages delivered,  
22 the recipient’s identification information, and so on. The provided delivery  
23 report mainly serves for accounting purposes and for notifying the sender  
24 of the dispatch and/or its contents. . . .

25 *Id.* at col. 2 ll. 26–44. Thus, the specification’s own language details how the general  
26 concept at the heart of the Feldbau Claims is one that has been implemented for years.

27 Moreover, despite the possibility for a narrow application, the Court finds that the  
28 claimed idea is comparable to claims that the Supreme Court and Federal Circuit have  
determined to be drawn to abstract ideas. *See, e.g., Gottschalk*, 409 U.S. at 71 (holding  
abstract and ineligible patent claims involving an algorithm for converting binary-coded  
decimal numerals into pure binary form); *Parker v. Flook*, 437 U.S. 584, 594–95 (1978)  
(holding abstract and ineligible a mathematical formula for computing “alarm limits” in a  
catalytic conversion process); *Alice*, 134 S. Ct. at 2360 (holding abstract and ineligible a

1 generalized computer method of intermediated settlement whereby two parties using a  
2 third-party intermediary exchange financial obligations); *Bilski*, 561 U.S. at 609 (finding  
3 that the concept of “hedging or protecting against risk” was drawn to an abstract idea);  
4 *buySAFE*, 765 F.3d at 1353, 1355 (finding that “transaction performance guaranty” was  
5 an abstract idea because the “narrowing of such long-familiar commercial transactions [to  
6 particular relationships] does not make the idea non-abstract for section 101 purposes”);  
7 *Digitech Image Techs. LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1348–51 (Fed.  
8 Cir. 2014) (holding that claims directed to digital image processing using math to  
9 combine data into a device profile were too abstract despite narrow application);  
10 *Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d 1363, 1367 (Fed. Cir. 2015)  
11 (holding that a method patent aimed at “tracking” and “storing” information was directed  
12 to patent-ineligible abstract idea of budgeting); *Bancorp Servs., L.L.C. v. Sun Life Assur.*  
13 *Co. of Canada (U.S)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (holding that a method patent  
14 to track, reconcile, and administer life insurance policies was not drawn to patent eligible  
15 subject matter); *In re TLI Commc’ns*, 2016 WL 2865693, at \*3 (concluding that claims  
16 directed to “classifying and storing digital images in an organized manner” were abstract  
17 and ineligible); *Content Extraction*, 776 F.3d.at 1347 (finding that claims directed to  
18 collecting, recognizing, and storing data were abstract and ineligible); *Cyberfone Sys.,*  
19 *LLC v. CNN Interactive Grp., Inc.*, 558 F. App’x. 988, 991–92 (Fed. Cir. 2014)  
20 (concluding that concept of “using categories to organize, store, and transmit  
21 information” is an abstract idea).

22 Moreover, the Feldbau Claims are not directed to a specific improvement in  
23 computer functionality but simply recite conventional and generic technology to perform  
24 “generalized steps” in a well-known computer environment. *Enfish*, 2016 WL 2756255,  
25 at \*4–5; see *In re TLI Commc’ns*, 2016 WL 2865693, at \*3 (same). RPost’s argument  
26 that the Feldbau Claims do not solely rely on “pure math” to “associat[e]” information is  
27 belied by a cursory review of the claim language. Particularly, the claims designate only  
28 one possible “association” or “securing” method: “mathematical association.” ‘219

1 Patent, col. 3 ll. 11–14 (amended version). Beyond “mathematical association,” the  
2 claims do not recite any other method for how the undefined “authenticator” is to  
3 associate or secure the data or detail what “mathematical association” method is to be  
4 applied. Even if the claim language did so, the claims would still be drawn to an abstract  
5 idea. *See Ultramercial*, 772 F.3d at 715 (“Although certain additional limitations, such as  
6 consulting an activity log, add a degree of particularity, the concept embodied by the  
7 majority of the limitations describes only the abstract idea[.]”).

8 Furthermore, the method outlined in the Feldbau Claims is directed to a patent-  
9 ineligible “mental” process. The claimed “associating” and “securing” functions, “while  
10 ‘primarily useful for computerized [applications],’ could still be made [using a] pencil  
11 and paper.” *Parker*, 437 U.S. at 586 (citations omitted). In fact, the Feldbau Claims are  
12 not even limited to an electronic embodiment. The only language plausibly requiring  
13 electronic implementation is “receiving content data representative of the contents of the  
14 dispatch originated from the sender and being electrically transmitted to said recipient,  
15 and a destination of the dispatch.” ‘219 Patent, col. 2 ll. 59–62. However, whether the  
16 “sender” or “recipient”<sup>8</sup> “electrically transmit” a dispatch has no bearing on whether the  
17 *authenticator’s* claimed functionality is restricted to an electronic embodiment.<sup>9</sup> To be  
18 sure, the specification teaches that the claimed authenticator-implemented functions of  
19 “associating” and “securing” can be performed *manually*. Particularly, Figure 1 illustrates  
20 as follows:

21  
22  
23 \_\_\_\_\_  
24 <sup>8</sup> The Court construed “sender” and “recipient” as requiring “computerized  
25 devices.” (Doc. 219 at 101–03). Nonetheless, whether the “sender” and “recipient”  
26 require computerized devices has no bearing on the functionality of the *authenticator*,  
which is a separate and distinct third-party intermediary.

27 <sup>9</sup> At *Markman*, the parties stipulated that “authenticator” be construed as “a sub-  
28 system that operates to authenticate a dispatch.” (Doc. 219 at 26). This construction does  
not necessarily limit the authenticator to an electronic embodiment.

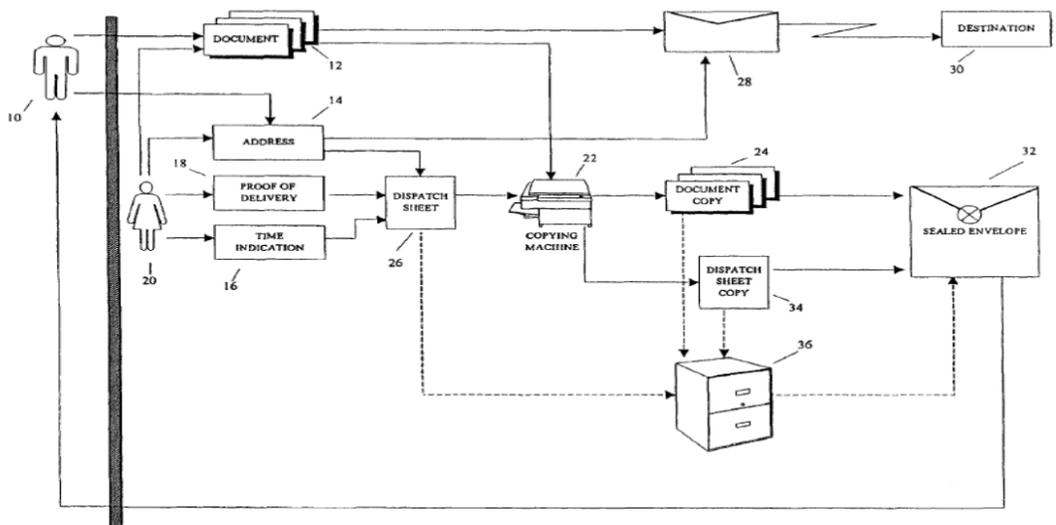


Fig. 1

‘219 Patent, Fig. 1. The specification defines Figure 1 as a “schematic pictorial illustration of the authentication method of the present invention implemented in a manual manner,” *id.* at col. 4 ll. 45–47, and describes Figure 1 as follows:

Reference is now made to FIG. 1 which illustrates the method of the present invention as it can be implemented for paper documents being sent non-electronically. The method of FIG. 1 can be implemented for documents sent via any document dispatching service, such as a courier service or the registered mail service of the post office.

The sender 10 provides the documents 12 to be sent and a destination address 14 to a clerk 20 of the document dispatching service. The clerk 20 prepares a dispatch sheet 26, which typically has a unique dispatch identifier (not shown) and has room for dispatch information such as the date and time of dispatch or delivery 16, the destination address 14, an indication 18 of proof of delivery such as the recipient’s identity and/or signature, and optionally, additional dispatch information such as the dispatcher’s signature and the identity of the sender.

The clerk 20 fills in the dispatch sheet 26 with the date/time 16 and the address 14, and then prepares a copy 24 of the documents 12 and a copy 34 of the dispatch sheet 26, typically by utilizing a copy machine 22 or an electronic scanner. The clerk 20 then places the original documents 12 into an envelope 28 carrying the address 14, and sends the envelope 28 to its destination 30. In one embodiment of the present invention the dispatching service utilizes a cash-register like device to fill in the dispatch sheet 26.

1 This provides for reliable time stamping and automated dispatch record  
2 keeping. *Furthermore, the electronic dispatch information produced by*  
3 *such device can be associated using a special mathematical method as*  
*discussed in greater detail below.*

4 *The clerk 20 associates the copy 24 of the documents 12 with the*  
5 *copy 34 of the dispatch sheet 26 by any method, a few examples of which*  
6 *follow:*

7 a) by inserting the documents copy 24 and the dispatch sheet copy  
8 34 into an envelope 32;

9 b) by inserting the copy 24 of the documents into an envelope 32 and  
10 marking the dispatch identifier on the outside of the envelope 32;

11 c) by printing the dispatch identifier on the documents copy 24; or

12 d) attaching the copies 24 and 34 and applying the stamp of the  
13 dispatch service in such a manner that part of the stamp is on the copy 24 of  
14 the documents and part of the stamp is on the copy 34 of the dispatch sheet  
15 26.

16 Preferably, the clerk 20 secures the copies 24 and 34 in a manner  
17 that makes it difficult to modify or replace the information contained  
18 therein, for example by marking the pages of the copy 24 with the  
19 dispatching service's signature, stamp or seal, by spreading each page with  
20 invisible or other ink, by sealing the envelope 32 or by retaining them in the  
21 service's secure file 36 and so forth.

22 *Id.* at col. 4 ll. 66–col. 5 ll. 50 (emphasis added); *see also id.* at col. 5 ll. 51–col. 6 ll. 30.

23 Based on this language, it is indisputable that the Feldbau Claims are directed to a  
24 concept that can be performed manually.<sup>10</sup> Regardless, even if an electronic limitation for  
25 the claimed method existed, it would do little to limit the Feldbau Claims' expansive  
26 scope. The specification makes clear that the Feldbau Claims are not restrained to a  
27 particular application as they encompass “all types” of information, “all types” of  
28 dispatch methods, and “all types” of methods and devices for “associating” and  
“securing” the authentication data. *Id.* at col. 4 ll. 1–7 ll. 16–19. This lack of specificity  
underscores the abstract nature of the claims. *See Internet Patents*, 790 F.3d at 1348–49

<sup>10</sup> During oral argument, RPost attempted to distinguish Figure 1 as not being a pictorial representation of the “authenticator” because the specification does not expressly define it as such. This argument is unpersuasive. The specification unambiguously defines Figure 1 as an illustration of “the authentication method of the present invention.” *Id.* at col. 4 ll. 45–47. There can be no dispute that the Feldbau Claims embody the “authentication method of the present invention.”

1 (finding that claims were directed to abstract idea of maintaining computer state without  
2 recitation of specific activity used to generate that result).

3 Finally, RPost’s argument that the Feldbau Claims “do not preempt all ways of  
4 accomplishing the alleged abstract idea,” (Doc. 299 at 21), is not dispositive. The Federal  
5 Circuit confirmed that the simple fact that “the claims do not preempt all [methods of  
6 providing information about a dispatch] or may be limited to [such activity in the  
7 electronic] setting do not make them any less abstract.” *OIP Techs., Inc. v. Amazon.com,*  
8 *Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (citing *buySAFE*, 765 F.3d at 1355).

9 For these reasons, the Court concludes that the Feldbau Claims, describing a  
10 method of collecting and providing information about a dispatch and its contents using a  
11 third-party intermediary, falls squarely within the “collection and organization of data”  
12 characterization deemed by the Federal Circuit to be abstract. *CyberSource*, 654 F.3d at  
13 1370; *see, e.g., YYZ, LLC v. Hewlett-Packard Co.*, 2015 WL 5886176, at \*3 (D. Del. Oct.  
14 8, 2015) (“Because computer software comprises a set of instructions, the first step of  
15 *Alice* is, for the most part, a given; i.e., computer-implemented patents generally involve  
16 abstract ideas.”). Thus, the Feldbau Claims are directed to an abstract idea.

17 **b. Step Two: Inventive Concept**

18 Because the Feldbau Claims are drawn to a patent-ineligible concept, the Court  
19 must next consider whether the claims add an “inventive concept” that transforms the  
20 claims into a patent-eligible application. *See Alice*, 134 S. Ct. at 2355. The Court finds  
21 that beyond the abstract idea of collecting and providing information about a particular  
22 dispatch, the claims merely recite “well-understood, routine conventional activities,” such  
23 as mathematical association or routine data-gathering and storing steps. *Id.* at 2359  
24 (quoting *Mayo*, 132 S. Ct. at 1294). Considered individually or taken together as an  
25 ordered combination, the claim elements fail to “‘transform’ the claimed abstract idea  
26 into a patent-eligible application.” *Id.* at 2357 (quoting *Mayo*, 132 S. Ct. at 1294, 1298).

27 RPost insists that the Feldbau Claims disclose at least two inventive concepts: the  
28 “authenticator”-implemented steps of (1) associating content data with dispatch record

1 data to generate authentication data and (2) securing the authentication data. (Doc. 299 at  
2 21–22). But beyond requiring that “at least one of the steps of associating and securing”  
3 be performed by an undefined “mathematical association method,” the Feldbau Claims  
4 do not specify what type of mathematical association is performed or explain how the  
5 content data is associated with the dispatch record data in a manner that generates  
6 authentication data. *See* ‘219 Patent, col. 3 ll. 11–14 (amended version). Similarly, the  
7 unremarkable claim that the authentication data “authenticate[s] the dispatch and the  
8 contents of the dispatch,” *id.* at col. 3 ll. 6–7, fails to explain what material comprises the  
9 authentication data.

10 Furthermore, the Feldbau Claims do not detail what the “authenticator” actually is  
11 or how the device secures the data against tampering beyond requiring “at least one of”  
12 the associating or securing steps be performed by an amorphous “mathematical  
13 association method.” *Id.* at col. 3 ll. 11–14. Instead, the “authenticator” is loosely defined  
14 as “all types of apparatus” capable of performing the associating and securing functions,  
15 *see* ‘219 Patent, col. 4 ll. 16–19, and therefore is not tied to “a particular machine or  
16 apparatus,” *Bilski*, 561 U.S. at 601. In other words, the Feldbau Claims broadly indicate  
17 what the “authenticator” *does*, but not what it *is*; this does not add “significantly more” to  
18 the abstract idea. *See Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1294).

19 Ultimately, the Court finds that the “associating” and “securing” “computer  
20 functions are ‘well-understood, routine, conventional activit[ies]’ previously known to  
21 the industry.” *Id.* at 2359 (quoting *Mayo*, 132 S. Ct. at 1294); *see buySAFE*, 765 F.3d at  
22 1355 (“That a computer receives and sends the information over a network—with no  
23 further specification—is not even arguably inventive.”); *OIP Techs.*, 788 F.3d at 1363  
24 (holding that “sending a first set of electronic messages over a network to devices, the  
25 devices being programmed to communicate, storing test results in a machine-readable  
26 medium, and using a computerized system . . . to automatically determine an estimated  
27 outcome and setting a price” were conventional activities); *CyberSource*, 654 F.3d at  
28 1373 (“[C]omputational methods which can be performed entirely in the human mind are

1 the types of methods that embody the ‘basic tools of scientific and technological work’  
2 that are free to all men and reserved exclusively to none.” (quoting *Gottschalk*, 409 U.S.  
3 at 67)). The Feldbau Claims merely “add” the generic computer functions of  
4 “associating” and “securing” to the claimed abstract idea of collecting and providing  
5 information about a particular dispatch. As explained above, these steps could be  
6 performed by humans without a computer as the only connection to an electrical  
7 embodiment concerns the sending of the message, not the functions of the authenticator.  
8 *See Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324 (Fed. Cir.  
9 2016) (“The series of steps covered by the asserted claims—borrower applies for a loan,  
10 a third party calculates the borrower’s credit grading, lenders provide loan pricing  
11 information to the third party based on the borrower’s credit grading, and only thereafter  
12 (at the election of the borrower) the borrower discloses its identity to a lender—could all  
13 be performed by humans without a computer.”). This is not enough to constitute an  
14 inventive concept under *Alice*. *See DDR Holdings*, 773 F.3d at 1256 (“[A]fter *Alice*, there  
15 can remain no doubt: recitation of generic computer limitations does not make an  
16 otherwise ineligible claim patent-eligible. The bare fact that a computer exists in the  
17 physical rather than purely conceptual realm is beside the point.” (internal citations and  
18 quotation marks omitted)); *Ultramercial*, 772 F.3d at 717 (“[A]dding a computer to  
19 otherwise conventional steps does not make an invention patent-eligible.”).<sup>11</sup>

20 Finally, nothing in the Feldbau Claims “purport[s] to improve the functioning of  
21 the computer itself,” *Alice*, 134 S. Ct. at 2359, “effect an improvement in any other  
22 technology or technical field,” *id.*; *see Enfish*, 2016 WL 2756255, at \*4, or solve a  
23 problem unique to the Internet, *see DDR Holdings LLC*, 773 F.3d at 1257. The Feldbau  
24 Claims’ method of converting input information (i.e., dispatch time, content, and  
25 destination data) to output information (i.e., authentication data) does not add  
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27 <sup>11</sup> In fact, the encryption and association methods described in the Feldbau  
28 Patent’s specification are described as “widely used for security and for authentication  
purposes.” ‘219 Patent, col. 2 ll. 9–18.

1 significantly more to the claimed abstract idea, *see Alice*, 134 S. Ct. at 2358, nor is it  
2 innovative enough to “override the routine and conventional” use of the computer, *see*  
3 *DDR Holdings*, 773 F.3d at 1258–59; *Enfish*, 2016 WL 2756255, at \*7–8.

4 In sum, the Feldbau Claims are directed to the abstract idea of collecting and  
5 providing information about a particular dispatch and its contents using an unspecified  
6 “authenticator” that applies an undefined “mathematical association method” to  
7 “associate” and “secure” pre-existing information. These generic conventional  
8 activities—even if carried out by a computer—are not sufficient to pass the second step  
9 of *Alice*. *See, e.g., Intellectual Ventures I*, 792 F.3d at 1368 (“Instructing one to ‘apply’  
10 an abstract idea and reciting no more than generic computer elements performing generic  
11 computer tasks does not make an abstract idea patent-eligible.” (quoting *Alice*, 134 S. Ct.  
12 at 2359–60)); *Digitech*, 758 F.3d at 1349–51 (holding ineligible a concept of gathering  
13 and combining data by reciting steps of organizing information through mathematical  
14 relationships where the gathering and combining merely employed mathematical  
15 relationships to manipulate existing information to generate additional information in the  
16 form of a “device profile” without limit to any use of the device profile).

### 17 c. Conclusion

18 For the foregoing reasons, the Court concludes that the Feldbau Claims are drawn  
19 to the abstract idea of collecting and providing information about a particular dispatch  
20 and fail to add “significantly more” such that an “inventive concept” “transforms” that  
21 idea into a patent-eligible application. *See Alice*, 134 S. Ct. at 2355. Accordingly, the  
22 Court will grant GoDaddy’s motion for summary judgment on this issue and declare that  
23 Feldbau Patent Claim Nos. 60, 62, 66, and 69 are invalid under § 101.

### 24 5. Tomkow Patents

25 GoDaddy also contends that the Tomkow Patents claim patent-ineligible subject  
26 matter without adding inventive concepts to confer validity. (Doc. 257 at 10–14). In  
27 GoDaddy’s view, the Tomkow Patents are all directed to the same abstract idea:  
28 “collecting and providing information for verifying transmission and/or delivery of a

1 message.” (*Id.* at 14). GoDaddy argues that no inventive concept is added because the  
2 claims merely address conventional activities without solving a problem unique to the  
3 Internet. (*Id.* at 14–15).

4 RPost responds that the Tomkow Patents do not simply recite the collection and  
5 provision of generic information about a message but provide “specific” steps to verify  
6 the receipt of a message using “specific information.” (Doc. 299 at 14). To that end,  
7 RPost argues that the Tomkow Patents provide a technical solution to a technical  
8 problem. (*Id.* at 17). RPost explains that “[t]he technical problem addressed by the  
9 Tomkow patents is providing reliable proof of content and delivery of electronic  
10 messages without requiring the co-operation of the recipient and without requiring  
11 special e-mail software,” while the technical solution entails “using an intermediate  
12 server between a sender and receiver of an electronic message” to provide a “first  
13 information” or “authenticatable information.” (*Id.* at 17–18). Thus, RPost insists that the  
14 inventive concept “does not lie in the computer hardware” or software but “in the  
15 technical features recited by the asserted claims.” (*Id.* at 19).

16 As noted above, the Tomkow Patents are the ‘913, ‘104, ‘198, ‘199, and ‘389  
17 Patents. These patents share a specification and are broadly described as “a system and  
18 method for verifying delivery and integrity of electronic messages.” *See* ‘913 Patent,  
19 (54). Nonetheless, each Tomkow Patent describes a slightly different method to provide  
20 slightly different information, and thus, the Court will address each patent separately.

21 **a. ‘913 Patent<sup>12</sup>**

22 The ‘913 Patent Claims disclose “a system and method for verifying delivery and  
23 integrity of electronic messages” sent by a sender to a recipient through a server. *Id.* The  
24 ‘913 Patent Claims accomplish this goal by having the server record “some portion” of a  
25 mail transport protocol dialog, either Simple Mail Transport Protocol (“SMTP”) or  
26 Extended Mail Transport Protocol (“EMTP”), in which a Mail Transport Agent (“MTA”)

27 \_\_\_\_\_  
28 <sup>12</sup> The asserted ‘913 Patent claims are Claim Nos. 1 and 2. *See* (Docs. 258 at 2;  
271-5 at 2; 300 at 2). These claims will be referenced as the “‘913 Patent Claims.”

1 for the recipient accepts or declines delivery of the message. *Id.* at col. 27 ll. 48–54. In  
2 full, the ‘913 Patent Claims recite as follows:

3 1. A method of transmitting a message from a sender to a recipient  
4 through a server acting as a Mail Transport Agent, including the steps at the  
5 server of:

6 transmitting the message to the recipient’s Mail Transport Agent in a  
7 protocol dialog selected from a group consisting of the selected one of the  
8 SMTP and ESMTP protocols; and

9 recording at the server some portion of the selected one of the SMTP  
10 and ESMTP protocol dialog between the server and the recipient through  
11 the server including those portions of the selected one of the SMTP and  
12 ESMTP protocol dialog between the server and the recipient in which the  
13 receiving Mail Transport Agent accepts or declines delivery of the  
14 transmitted message

15 2. The method as set forth in claim 1, including the step of:

16 storing the recorded dialog in some form in which it may be  
17 associated with the message and the sender and the recipient of the message  
18 in such a way that it may be used to document the delivery history of the  
19 message from the sender to the recipient.

20 *Id.* at col. 27 ll. 41–60.

21 **i. Step One: Patent-Ineligible Concept**

22 The Court finds that the ‘913 Patent Claims are directed to the abstract idea of  
23 collecting information about the delivery of a message. Similar to the Feldbau Claims,  
24 the concept of collecting delivery information about a message has been practiced in  
25 various forms for decades, if not centuries. Most notably, the method disclosed by the  
26 ‘913 Patent Claims is essentially an electronic version of certified or registered mail that  
27 has long been implemented by the United States Postal Service (“USPS”). *See* ‘913  
28 Patent, col. 1 ll. 33–37; (Docs. 258 at 5–8; 294 at 26).<sup>13</sup> In fact, the ‘913 Patent’s

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<sup>13</sup> To the extent RPost “objects” to GoDaddy’s provision of historical references concerning USPS under Local Rule of Civil Procedure for the District Court of Arizona 7.2(m)(2), *see* (Doc. 299 at 22–23), the Court overrules the objection. Not only do the Tomkow Patents disclose that the patented subject matter attempts to mirror the services provided by USPS, *see, e.g.*, ‘219 Patent, col. 2 ll. 26–33; ‘913 Patent, col. 1 ll. 28–42, GoDaddy analyzed the USPS relationship during *Markman* briefing, *see, e.g.*, (Doc. 117 at 12), and disclosed the USPS connection in its invalidity contentions, *see* (Doc. 304-1 at

1 specification details how USPS and private mail carriers such as the United Parcel  
2 Service (“UPS”) and Federal Express (“FedEx”) provide “confirmation that [a] letter was  
3 successfully delivered to the addressee or the addressee’s authorized agent.” ‘913 Patent,  
4 col. 1 ll. 33–42. The shared-specification goes on to teach that the goal of the Tomkow  
5 Patents is to reach if not surpass the evidentiary heights of USPS-registered mail. *See id.*  
6 at col. 3 ll. 11–14. In other words, the heart of the ‘913 Patent Claims is directed to a  
7 “conventional business practice” that has long been “prevalent in our system of  
8 commerce.” *Alice*, 134 S. Ct. at 2356.

9 Much of what RPost believes is pertinent under the first step of *Alice* is more  
10 applicable to the second step of the inquiry. For example, whether the ‘913 Patent Claims  
11 disclose “specific” or “defined” steps, *see* (Doc. 299 at 14), speaks to whether the claims  
12 add “something more” to transform the claimed concept into a patent-eligible application,  
13 not whether the concept itself is abstract. *See Ultramercial*, 772 F.3d at 715 (“We do not  
14 agree . . . that the addition of merely novel or non-routine components to the claimed idea  
15 necessarily turns an abstraction into, something concrete. In any event, any novelty in  
16 implementation of the idea is a factor to be considered only in the second step of the  
17 *Alice* analysis.”). Being abstract does not mean that a concept is devoid of steps. Multi-  
18 step, computer-implemented method patents are frequently found ineligible as directed to  
19 abstract ideas. *See, e.g., Digitech*, 758 F.3d at 1349–51; *Mortg. Grader*, 811 F.3d at 1324;  
20 *Internet Patents*, 790 F.3d at 1348–49. Here, although the ‘913 Patent Claims include  
21 “specific” steps, the steps are “generalized steps to be performed on a computer using  
22 conventional computer activity.” *Enfish*, 2016 WL 2756255, at \*7. The “heart” of a  
23 patent is determinative for *Alice* step one, *see Ultramercial*, 772 F.3d at 714, and as  
24 expressed above, the heart of the ‘913 Patent Claims is drawn to the abstract idea of  
25 collecting information about the delivery of a message.

26 RPost also argues that the numerous prior art references disclosed in the  
27 specification demonstrate that there is “no risk of preempting . . . the entire field of

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4). The Court finds these disclosures are adequate.

1 creating a delivery receipt using tracking information.” (Doc. 299 at 15–16). The Federal  
2 Circuit has soundly rejected this argument. In *Vehicle Intelligence & Safety LLC v.*  
3 *Mercedes-Benz USA, LLC*, the appellant argued that “the existence of prior art methods  
4 of equipment operator testing, evidenced by the eleven prior art references identified in  
5 the . . . specification, prove that the claims at issue do not preempt the abstract idea of  
6 performing equipment operator testing because these references describe non-infringing  
7 methods for doing so.” 2015 WL 9461707, at \*3 (Fed. Cir. Dec. 28, 2015). The Federal  
8 Circuit jettisoned this contention as “meritless” because “the mere existence of a non-  
9 preempted use of an abstract idea does not prove that a claim is drawn to patent-eligible  
10 subject matter.” *Id.* The Federal Circuit explained that if it adopted such an approach,  
11 then “all a patentee would need do to insulate itself from a § 101 challenge would be to  
12 identify a single prior art reference in the specification and state that its invention  
13 improves upon that reference.” *Id.*; *see also OIP Techs.*, 788 F.3d at 1362–63.

14 Furthermore, the tangible, physical components recited by the ‘913 Patent Claims  
15 “merely provide a generic environment in which to carry out the abstract idea” of  
16 collecting information about the delivery of a message. *In re TLI Commc’ns*, 2016 WL  
17 2865693, at \*3; *see ART+COM Innovationpool GmbH v. Google Inc.*, 2016 WL  
18 1718221, at \*4 (D. Del. Apr. 28, 2016) (finding that claim was drawn to “abstract idea of  
19 storing image data, then repeatedly requesting specific data, which is then stored and  
20 displayed”). The specification’s emphasis that the present invention “relates generally to  
21 a system and method for verifying delivery and content of an electronic message,” ‘913  
22 Patent, col. 1 ll. 21–22, without requiring any “special e-mail software,” *id.* at col. 2 ll.  
23 67–col. 3 ll. 1, underscores that the ‘913 Patent Claims are directed to an abstract idea.

24 Finally, the Court finds that the concept of collecting information about the  
25 delivery of a message is no less abstract than any of the concepts the Supreme Court and  
26 Federal Circuit have determined to be drawn to abstract ideas. *See, e.g., CyberSource*,  
27 654 F.3d at 1370 (“collection and organization of data”); *Gottschalk*, 409 U.S. at 71  
28 (algorithm for converting binary-coded decimal numerals into pure binary form); *Parker*,

1 437 U.S. at 594–95 (formula for computing “alarm limits” in a catalytic conversion  
2 process); *Alice*, 134 S. Ct. at 2360 (intermediated settlement whereby two parties using a  
3 third-party intermediary exchange financial obligations); *Bilski*, 561 U.S. at 609  
4 (“hedging or protecting against risk”); *buySAFE*, 765 F.3d at 1353, 1355 (“transaction  
5 performance guaranty”); *Digitech*, 758 F.3d at 1348–51 (digital image processing using  
6 math to combine data into a device profile); *Intellectual Ventures I*, 792 F.3d at 1367  
7 (“tracking” and “storing” information directed to abstract idea of budgeting).

8 For these reasons, the Court finds that the ‘913 Patent Claims merely “recite[]  
9 generalized steps to be performed on a computer using conventional computer activity,”  
10 *Enfish*, 2016 WL 2756255, at \*7 (citations omitted), and are directed to the abstract idea  
11 of collecting information about the delivery of a message.

12 **ii. Step Two: Inventive Concept**

13 Because the ‘913 Patent Claims are drawn to a patent-ineligible concept, the Court  
14 must now determine whether there is “significantly more” in the claims that “transforms”  
15 that concept into a patent-eligible application. *Alice*, 134 S. Ct. at 2355.

16 Claim 1 of the ‘913 Patent recites that a message is “transmitt[ed]” to the  
17 recipient’s MTA and the server “record[s] some portion of the selected one of the SMTP  
18 and ESMTP protocol dialog,” ‘913 Patent, col 27 ll. 48–49, while Claim 2 states that the  
19 server “stor[es] the recorded dialog,” *id.* at col. 27 ll. 55–56. The ‘913 Patent Claims  
20 therefore invoke three computer-executed functions—“transmitting” information,  
21 “recording” information, and “storing” information—all of which can be implemented by  
22 “nearly every computer.” *See Alice*, 134 S. Ct. at 2361 (“Nearly every computer [is]  
23 capable of performing . . . basic calculation, storage, and transmission functions.”);  
24 *buySAFE*, 765 F.3d at 1355 (“That a computer receives and sends the information over a  
25 network—with no further specification—is not even arguably inventive.”). As expressed  
26 above, the mere “recitation of generic computer limitations does not make an otherwise  
27 ineligible claim patent-eligible.” *DDR Holdings*, 773 F.3d at 1256; *see Ultramercial*, 772  
28 F.3d at 717 (“[A]dding a computer to otherwise conventional steps does not make an

1 invention patent-eligible.”). Here, the Court finds that the disclosed steps of  
2 “transmitting,” “recording,” and “storing” pre-existing information are “computer  
3 functions [that] are ‘well-understood, routine, conventional activit[ies]’ previously known  
4 to the industry.” *Alice*, 134 S. Ct. at 2359 (quoting *Mayo*, 132 S. Ct. at 1294); see *OIP*  
5 *Techs.*, 788 F.3d at 1363 (holding that “sending a first set of electronic messages over a  
6 network to devices, the devices being programmed to communicate, storing test results in  
7 a machine-readable medium, and using a computerized system . . . to automatically  
8 determine an estimated outcome and setting a price” were conventional activities).

9 RPost suggests “compelling evidence” exists that the ‘104, ‘389, and ‘913 Patents  
10 provide a “technical solution to a technical problem” because the PTAB denied petitions  
11 to institute CBM patent reviews of the three patents. (Doc. 299 at 18). The threshold  
12 standard for instituting a CBM review is whether it is “more likely than not” that a patent  
13 is un-patentable. 35 U.S.C. § 324(a). A CBM patent excludes patents for “technological  
14 inventions,” i.e., patents that claim “a technological feature that is novel and obvious over  
15 the prior art; and solves a technical problem using a technical solution.” 37 C.F.R.  
16 § 42.301(b). Regarding the ‘913 Patent, the PTAB denied the petitioner’s request because  
17 the “conclusory language in the petition that none of the steps of a claim requires any  
18 novel and unobvious technological implementation, or solves a technical problem,  
19 without more, is not sufficient to demonstrate that the claimed subject matter is not a  
20 technical invention.” (Doc. 304-5 at 10). The PTAB also faulted the petitioner for failing  
21 to “analyze[] the method steps separately, instead of examining each claim as a whole, as  
22 required” to determine whether the patent is a technological invention. (*Id.*)<sup>14</sup>

23 The Court has analyzed the ‘913 Patent Claims as a whole and concludes that no  
24 “inventive concept” is recited, nor do the claims purport to solve a technical problem  
25 using a technical solution. Instead, the claimed steps are conventional activities that  
26 “nearly every computer” can perform. *Alice*, 134 S. Ct. at 2361. To the extent RPost  
27

28 <sup>14</sup> The PTAB applied similar reasoning for the ‘104 and ‘389 Patents. See (Docs. 304-3 at 9–10; 304-4 at 9–10).

1 argues that the ‘913 Patent Claims solve a problem “necessarily rooted in computer  
2 technology” as illustrated in *DDR Holdings*, see (Doc. 299 at 17), that argument fails for  
3 two reasons. First, nothing in the claim language is innovative enough to “override[] the  
4 routine and conventional” use of the computer. *Enfish*, 2016 WL 2756255, at \*7–8; *DDR*  
5 *Holdings*, 773 F.3d at 1258–59. In fact, the generalized steps of the ‘913 Patent Claims  
6 are routine and conventional. Second, the problem purportedly addressed by the ‘913  
7 Patent Claims is not “necessarily rooted in computer technology” as explained by *DDR*  
8 *Holdings*. The “problem” of verifying the delivery of a message has long troubled mail  
9 delivery systems, and the facile fact that the ‘913 Patent Claims are drawn to electronic  
10 mailing is of no consequence. See, e.g., *Alice*, 134 S. Ct. at 2361; *buySAFE*, 765 F.3d at  
11 1355. Ultimately, the claims are “recited too broadly and generically to be considered  
12 sufficiently specific and meaningful applications of their underlying abstract ideas.” *DDR*  
13 *Holdings*, 773 F.3d at 1256; see also *Internet Patents*, 790 F.3d at 1348 (finding patent  
14 ineligible where claim “contain[ed] no restriction on how the result [was]  
15 accomplished”). Accordingly, RPost’s “rooted in computer technology” and “technical  
16 solution to technical problem” arguments do not furnish the necessary “inventive  
17 concept” to confer patent-eligibility.

### 18 iii. Conclusion

19 For the foregoing reasons, the Court concludes that the ‘913 Patent Claims are  
20 directed to the abstract idea of collecting information about the delivery of a message and  
21 fail to add an “inventive concept” that “transforms” the idea into a patent-eligible  
22 application. *Alice*, 134 S. Ct. at 2355. Accordingly, the Court will grant GoDaddy’s  
23 motion for summary judgment on this issue and declare that ‘913 Patent Claim Nos. 1  
24 and 2 are invalid under § 101.

### 25 b. ‘104 Patent<sup>15</sup>

26 The ‘104 Patent Claims disclose a method of providing information about the  
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28 <sup>15</sup> The asserted ‘104 Patent claims are Claim Nos. 1, 9, 27, 32. See (Docs. 258 at 2;  
271-5 at 2; 300 at 2). These claims will be referenced as the “‘104 Patent Claims.”

1 opening of an electronic message sent from a sender to a recipient through a server. *See*  
2 ‘104 Patent, col. 27 ll. 63–col. 28 ll. 16, col. 31 ll. 20–37. To accomplish this goal, the  
3 server “add[s] a link” to the electronic message that executes when the message is opened  
4 at the recipient to provide the server an indication that the message has been opened. *Id.*  
5 Pursuant to Claim 1, the server then “provid[es] an authenticatable information” related to  
6 the message, *id.* at col. 27 ll. 10–11, while under Claim 27, the server “constructs  
7 authenticatable information” and “transmits” the “indication of opening” and  
8 “authenticatable information” to the sender or originating processor, *id.* at col. 31 ll. 33–  
9 37. In full, the ‘104 Patent Claims recite as follows:

10           1. A method of transmitting a message from a sender to a recipient  
11 and providing an indication that the message was opened by the recipient,  
12 comprising:

13           receiving the message at a server from the sender, the server being  
14 displaced from the recipient,

15           adding a link to the message by the server, the link configured to  
16 execute when the message is opened at the recipient to provide an  
17 indication that the message has been opened by the recipient,

18           transmitting the message and the link from the server to the  
19 recipient,

20           executing the link when the message is opened at the recipient to  
21 control the server to provide an indication that the message has been  
22 opened at the recipient,

23           providing an authenticatable information related to the message,  
24 including the indication of the opening of the message at the recipient, at  
25 the server,

26           transmitting the indication of the opening of the message at the  
27 recipient, and the authenticatable information from the server to the sender.

28 *Id.* at col. 27 ll. 63–col. 28 ll. 16.

**9.** The method of claim 1, wherein transmitting the authenticatable  
information includes transmitting a representation of the message.

*Id.* at col. 28 ll. 49–51.

**27.** A system for transmitting a message from an originating  
processor to a recipient processor in an electronic mail system and  
providing an indication that the message was opened by the recipient  
processor, comprising:

1 a server in electronic communication in the electronic mail system,  
2 the server receiving the message from the originating processor and adding  
3 a link to the message before transmitting the message and link to the  
4 recipient processor, the link being configured to execute automatically  
5 when the message is opened at the recipient processor to control the server  
6 to provide an indication at the server that the message has been opened at  
7 the recipient processor; and

8 wherein the server constructs authenticatable information related to  
9 the message; and

10 wherein the server transmits the indication of the opening of the  
11 message at the recipient processor and the authenticatable information to the  
12 originating processor.

13 *Id.* at col. 31 ll. 20–37.

14 **32.** The system of claim 27, wherein the server transmits the  
15 indication of the opening of the message at recipient processor and the  
16 authenticatable information to the originating processor in a secure,  
17 verifiable manner.

18 *Id.* at col. 32 ll. 1–4.

19 **i. Step One: Patent-Ineligible Concept**

20 Similar to the ‘913 Patent Claims, the Court finds that the ‘104 Patent Claims are  
21 directed to the abstract idea of collecting and providing information about the opening of  
22 a message. The minor variation between the concepts—message “delivery” and message  
23 “opening”—is inconsequential. Rather, the concept at the heart of the ‘104 Patent Claims  
24 is directed to a generic idea that has been implemented in the electronic messaging  
25 industry for years. For example, the ‘104 Patent’s specification recites that,

26 Many existing e-mail systems and e-mail programs already provide  
27 for some form of proof of delivery. For instance, some e-mail systems  
28 today allow a sender to mark a message with ‘request for notifications’  
tags. Such tags allow a sender to request notification that the message was  
delivered and/or when the message was opened. When a sender requests  
delivery notification, the Internet e-mail system may provide the sender  
with an e mail receipt that the message was delivered to the mail server or  
the electronic inbox of the recipient. The receipt message may include the  
title of the message, the destination address, and the time of delivery. It  
may also include (depending on the types of “flags” that are provided and  
activated in the mailing software) a list of all the Internet “stations” that the  
message passed through en route to its destination. This form of reporting is

1 built into some of the rules and protocols which implement e-mail.  
2 Furthermore, when a message is sent with a ‘read notification’ request, the  
3 recipient’s email program may send to the sender an e-mail notification that  
4 the recipient opened that message for reading. Many electronic mail clients  
5 can and do support this kind of reporting; however, Internet protocols do  
6 not make it mandatory.

7 *Id.* at col. 1 ll. 41–62; *see* (Doc. 271-17 at 10) (portion of Dr. Terrance Tomkow’s  
8 deposition describing pre-existing process of adding links to electronic messages that  
9 provide “read notifications” when activated at the recipient).

10 Furthermore, the concept of collecting and providing information about the  
11 opening of a message is analogous to other data collection and tracking methods deemed  
12 by courts to be drawn to abstract ideas. *See, e.g., Content Extraction*, 776 F.3d at 1347  
13 (holding that a patent for reading and processing the data on checks was directed to the  
14 abstract idea of “data collection, recognition, and storage,” processes that are  
15 “undisputedly well-known”); *Wireless Media Innovations v. Maher Terminals*, 100 F.  
16 Supp. 3d 405, 413 (D.N.J. 2015) (concluding that concept of “monitoring locations,  
17 movement, and load status of shipping containers . . . and storing, reporting and  
18 communicating this information in various forms through generic computer functions”  
19 was too abstract for patent-eligibility); *YYZ*, 2015 WL 5886176, at \*7 (finding that  
20 apparatus and method for “measuring, monitoring, tracking, and simulating enterprise or  
21 business communications and processes in an asynchronous messaging environment”  
22 was directed to an abstract idea); *Neochloris, Inc. v. Emerson Process Mgmt. LLLP*, 2015  
23 WL 5951753, at \*4–5 (N.D. Ill. Oct. 13, 2015) (holding that claims describing process of  
24 collecting data, transmitting data to computer, monitoring data using computer and  
25 software, and sending alarms when problems arise, were directed to abstract idea).

26 RPost’s contention that the ‘104 Patent Claims are not directed to an abstract idea  
27 because they can verify the opening of a message without the recipient’s cooperation or  
28 compliance is unpersuasive. At their core, the ‘104 Patent Claims simply provide  
information that a particular message was opened. Whether or not the ‘104 Patent Claims  
require the recipient’s “cooperation” speaks not to whether the idea is abstract but to

1 whether the claims add an inventive concept, i.e., the second step in the *Alice* paradigm.  
2 *See Ultramercial*, 772 F.3d at 715 (“We do not agree . . . that the addition of merely  
3 novel or non-routine components to the claimed idea necessarily turns an abstraction into,  
4 something concrete. In any event, any novelty in implementation of the idea is a factor to  
5 be considered only in the second step of the *Alice* analysis.”).

6 Similarly, RPost’s argument that the ‘104 Patent Claims are not directed to an  
7 abstract idea because they require “specific” steps to verify the opening of a message via  
8 a tangible “intermediate server that records” and “forms” certain information is beside the  
9 point; the claims merely recite the abstract idea of collecting and providing information  
10 about the opening of a message. *See Alice*, 134 S. Ct. at 2358 (“The fact that a computer  
11 necessarily exist[s] in the physical, rather than purely conceptual, realm . . . is beside the  
12 point.”). The Federal Circuit recently explained that a relevant inquiry at the first step of  
13 *Alice* is to “ask whether the claims are directed to an improvement to computer  
14 functionality versus being directed to an abstract idea.” *Enfish*, 2016 WL 2756255, at \*4.  
15 Specifically, *Enfish* contrasted claims “directed to an improvement in the functioning of a  
16 computer” with claims “simply adding conventional computer components to well-  
17 known business practices,” or claims reciting “use of an abstract mathematical formula  
18 on any general purpose computer,” or “a purely conventional computer implementation  
19 of a mathematical formula,” or “generalized steps to be performed on a computer using  
20 conventional computer activity.” *Id.* at \*4–5; *see In re TLI Commc’ns*, 2016 WL  
21 2865693, at \*3 (same). Here, the ‘104 Patent Claims are not directed to a specific  
22 improvement in computer functionality, but use conventional and generic technology to  
23 perform “generalized steps” in a well-known environment. To be sure, the disclosed  
24 “server” is indisputably not new,<sup>16</sup> and the added “link” is nothing more than a standard  
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26 <sup>16</sup> RPost admits as much in its opposition to summary judgment. *See* (Doc. 299 at  
27 19) (“The inventive concept of the asserted claims does not lie in the computer  
28 hardware.”). Furthermore, the server is described simply in terms of performing generic  
computer functions such as transmitting, receiving, and storing data. *See* ‘104 Patent, col.  
27 ll. 63–col. 28 ll. 16, col. 31 ll. 20–37. But these functions are described in vague terms

1 hyperlink configured to execute at a certain time,<sup>17</sup> which certainly is not inventive.

2 Finally, the ‘104 Patent Claims do not solve “a challenge particular to the  
3 Internet.” *DDR Holdings*, 773 F.3d at 1256–57. As explained above, the problem  
4 purportedly “solved” by the Tomkow Patents was long prevalent in the pre-Internet,  
5 analog world, and there is nothing unique to the Internet about collecting and providing  
6 information about the opening of a message. Despite RPost’s endeavors to describe the  
7 ‘104 Patent Claims as performing “specific” steps to provide “specific” information, the  
8 claim language divulges nothing more than the process of transmitting a message, adding  
9 a link to the message, and storing information about the message. These are all abstract  
10 ideas individually, and in ordered combination, the steps recite an abstraction—an idea,  
11 having no particular concrete or tangible form; namely, a method of receiving and  
12 transmitting electronic messages and collecting the relevant data as to the opening of the  
13 message. *See Ultramercial*, 772 F.3d at 715 (“Although certain additional limitations,  
14 such as consulting an activity log, add a degree of particularity, the concept embodied by  
15 the majority of the limitations describes only [an] abstract idea.”).

16 For these reasons, the Court finds that, like the claims at issue in *Content*  
17 *Extraction* which were directed to “collecting data,” “recognizing certain data within the  
18 collected data set,” and “storing the recognized data in memory,” 776 F.3d at 1347,  
19 collecting and providing information about the opening and delivery of a message is a  
20 well-established “basic concept” that is patent-ineligible under *Alice* step one.

21 **ii. Step Two: Inventive Concept**

22 RPost insists that the ‘104 Patent Claims add an inventive concept to the abstract  
23 idea because after “receiving” the message, the server adds a link that is “configured to  
24 execute” upon opening of the message, thereby generating an “indication” that the  
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26 without any meaningful limitations and thus, the “focus of the patentee and of the claims  
27 was not on an . . . improved server.” *In re TLI Commc’ns*, 2016 WL 2865693, at \*4.

28 <sup>17</sup> At *Markman*, the Court construed the claim term “link” by its plain and ordinary  
meaning because it needed no clarification or explanation. (Doc. 219 at 35–36).

1 message was opened. (Doc. 299 at 18). RPost claims that evidence of an inventive  
2 concept is seen by the server “transforming” the indication into something more, i.e.,  
3 “authenticatable information.” (*Id.*) According to RPost, the inventive concept resides in  
4 these “technical features” which enable a sender to verify the opening of a message  
5 without the recipient’s “cooperation” or “compliance.” (*Id.* at 18–19).

6 To begin, “links” or “tags” have been added to electronic messages for decades.  
7 As the ‘104 Patent’s specification teaches, “read notifications” and “request for  
8 notification” tags have long been appended to electronic messages and are commonplace  
9 in the electronic messaging industry. *See* ‘104 Patent, col. 1 ll. 41–62. Moreover, Dr.  
10 Tomkow testified that the concept of inserting hyperlinks into e-mail was well-known  
11 before the Tomkow Patents, *see* (Doc. 294 at 30–31), as were Internet links and  
12 hyperlinks, *see (id.; Doc. 271-17 at 10)*. Thus, merely adding a “link” to a message is not  
13 inventive. *See Sovereign Software LLC v. Newegg Inc.*, 705 F.3d 1333, 1344 (Fed. Cir.  
14 2013) (finding that the use of “hypertext” to communicate information “was a routine  
15 incorporation of Internet technology into existing processes”).

16 Similarly, the claimed “server” “fail[s] to add an inventive concept sufficient to  
17 bring the abstract idea into the realm of patentability.” *In re TLI Commc’ns.*, 2016 WL  
18 2865693, at \*5. “For the role of a computer in a computer-implemented invention to be  
19 deemed meaningful in the context of [the inventive concept] analysis, it must involve  
20 more than performance of ‘well-understood, routine, [and] conventional activities  
21 previously known in the industry.’” *Content Extraction*, 776 F.3d at 1347–48 (quoting  
22 *Alice*, 134 S. Ct. at 2359). Here, the server merely “receives” a message, “adds” a link to  
23 the message, and “transmits” the message. These steps fall squarely within Supreme  
24 Court and Federal Circuit precedent finding generic computer components insufficient to  
25 add an inventive concept to an otherwise abstract idea. *See, e.g., id.* at 1345, 1348  
26 (holding that “storing information” into memory and using a computer to “translate the  
27 shapes on a physical page into typeface characters” was insufficient to confer patent  
28 eligibility); *Alice*, 134 S. Ct. at 2361 (“Nearly every computer will include a

1 ‘communications controller’ and a ‘data storage unit’ capable of performing the basic  
2 calculation, storage, and transmission functions required by the method claims.”);  
3 *buySAFE*, 765 F.3d at 1355 (“That a computer receives and sends the information over a  
4 network—with no further specification—is not even arguably inventive.”); *Mortg.*  
5 *Grader*, 811 F.3d at 1324–25 (holding that claimed components “interface,” “network,”  
6 and “database” were merely “generic computer components” insufficient to confer  
7 eligibility); *Intellectual Ventures I*, 792 F.3d at 1368 (finding that claimed components  
8 “database,” “user profile,” and “communication medium” did not confer eligibility).

9 To the extent RPost argues that the link itself is “inventive” because it is  
10 “configured to execute when the message is opened” thereby removing the need for  
11 recipient “cooperation,” *see* (Doc. 299 at 18), the Court disagrees. A component that “can  
12 be configured” to perform a claimed function—without more—is neither sufficiently  
13 described nor sufficiently innovative to transform an abstract idea into patent-eligible  
14 subject matter. *See Planet Bingo, LLC v. VKGS LLC*, 576 F. App’x 1005, 1008–09 (Fed.  
15 Cir. 2014) (rejecting argument that unclaimed features are relevant for patent-eligibility  
16 purposes). Thus, to broadly claim a method of accomplishing a routine function requires  
17 more than just an “apply it” directive, even if in a specific technical environment. *See,*  
18 *e.g., Alice*, 134 S. Ct. at 2358 (“[I]f a patent’s recitation of a computer amounts to a mere  
19 instruction to implement an abstract idea on . . . a computer, . . . that addition cannot  
20 impart patent eligibility.” (citing *Mayo*, 132 S. Ct. at 1301)); *Intellectual Ventures I*, 792  
21 F.3d at 1368 (“Instructing one to ‘apply’ an abstract idea and reciting no more than  
22 generic computer elements performing generic computer tasks does not make an abstract  
23 idea patent-eligible.” (quoting *Alice*, 134 S. Ct. at 2359–60)).

24 Equally unpersuasive is RPost’s thin argument that the ‘104 Patent Claims’  
25 “transform[ation]” of the “indication” into “authenticatable information” signals an  
26 inventive concept. The Federal Circuit has held that the machine-or-transformation test  
27 can provide a “useful clue” during the second step of the *Alice* framework. *See Bancorp*  
28 *Servs.*, 687 F.3d at 1278. Thus, a claimed process can be patent-eligible under § 101 if:

1 “(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article  
2 into a different state or thing.” *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (en banc),  
3 *aff’d on other grounds by Bilski*, 561 U.S. 593. In this case, the claim language does not  
4 substantiate RPost’s contention that the “indication” is “transformed” into  
5 “authenticatable information.” Rather, the claim language simply recites that the server  
6 “provid[es] an authenticatable information related to the message, including the indication  
7 of the opening of the message,” ‘104 Patent, col. 28 ll. 10–12, and “constructs  
8 authenticatable information,” *id.* at col. 31 ll. 33–34. The claim language does not  
9 disclose or even imply that the “indication” is in any way “transformed.”<sup>18</sup> RPost’s  
10 argument is therefore flawed from the start.<sup>19</sup> Even if the “indication” was “transformed”  
11 into “authenticatable information,” the ‘104 Patent Claims still do not disclose any details  
12 as to *how* the “transformation” transpires, nor do they inform that the “transformed”  
13 product, i.e., “authenticatable information,” is anything more than the general, pre-  
14 existing “indication.” Such free-standing information is simply not patentable. *See*  
15 *Digitech*, 758 F.3d at 1350 (“Data in its ethereal, non-physical form is simply information  
16 that does not fall under any of the categories of eligible subject matter.”).

17 As was the case in *Alice*, the Court finds that “the function performed by the  
18 computer at each step of the process is [p]urely conventional.” *Alice*, 134 S. Ct. at 2359  
19 (quoting *Mayo*, 132 S. Ct. at 1298). Simply narrowing an abstract idea implemented by  
20 pre-existing components to a particular technological environment is insufficient to pass  
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22 <sup>18</sup> This is in contrast to the ‘389 and ‘199 Patent Claims which, as discussed  
23 below, disclose that a “first information” is “form[ed] . . . *from*” a particular indication  
24 and certain other information.

25 <sup>19</sup> In fact, the claim language implies the *opposite* of RPost’s argument. Namely,  
26 the ‘104 Patent Claims disclose that at the end of the claimed process, the server  
27 transmits the “indication of the opening of the message . . . *and* the authenticatable  
28 information” to the sender. *Id.* at col. 28 ll. 14–16, col. 31 ll. 35–37 (emphasis added).  
Pragmatically, there would be no reason to provide the sender with *both* pieces of  
information if they included the *same* information. Thus, this suggests that the  
“authenticatable information” is formed from other, non-claimed information.

1 muster under § 101. *See, e.g., Digitech*, 758 F.3d at 1348–51 (holding that claims  
2 directed to digital image processing using math to combine data into a device profile  
3 were too abstract despite narrow application); *Planet Bingo*, 576 F. App’x at 1009  
4 (finding that claims failed to add an inventive concept to abstract idea because the claims  
5 merely “recite a program that is used for the generic functions of storing, retrieving, and  
6 verifying a chosen set of bingo numbers against a winning set of bingo numbers”). The  
7 § 101 inquiry is focused on the claim language and whether the ordered combination of  
8 the limitations disclose patent-eligible subject matter or add an inventive concept to an  
9 abstract idea. Here, the ‘104 Patent Claims fail to recite any elements that individually or  
10 as an ordered combination transform the abstract idea of collecting and providing  
11 information about the opening of a message into a patent-eligible application.

12 **iii. Conclusion**

13 For these reasons, the Court concludes that the ‘104 Patent Claims are directed to  
14 the abstract idea of collecting and providing information about the opening of a message  
15 and fail to add an inventive concept to confer patent eligibility. *Alice*, 134 S. Ct. at 2355.  
16 Accordingly, the Court will grant GoDaddy’s motion for summary judgment on this issue  
17 and declare that ‘104 Patent Claim Nos. 1, 9, 27, and 32 are invalid under § 101.

18 **c. ‘198 Patent<sup>20</sup>**

19 The ‘198 Patent, a continuation of the ‘104 Patent, claims a method of providing  
20 information about the opening and delivery of an electronic message sent from a sender  
21 to a recipient through a server. *See* ‘198 Patent, col. 28 ll. 6–25, col. 29 ll. 11–27, col. 30  
22 ll. 7–25. To achieve this goal, a server adds a link to the electronic message that is  
23 “configured to execute when the link is activated at the recipient” to provide the server an  
24 indication that the message has been opened or delivered. *Id.* The server then forms  
25 “authenticatable information” relating to the message, which includes the indication of  
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27 <sup>20</sup> The asserted ‘198 Patent claims are Claim Nos. 1, 6, 7, 10, 18, 23, 32, 35. *See*  
28 (Docs. 258 at 2; 271-5 at 2; 300 at 2). These claims will be referenced as the “‘198 Patent  
Claims.”

1 opening or delivery, and transmits the “authenticatable information” to the sender. *Id.* In  
2 full, the ‘198 Patent Claims recite as follows:

3           **1.** A method of transmitting a message from a sender to a recipient  
4 and providing an indication that the message was opened by the recipient,  
5 comprising:

6           receiving the message at a server from the sender, the server being  
7 displaced from the recipient,

8           associating a link with the message by the server, the link configured  
9 to execute when the link is activated at the recipient to provide an  
10 indication that the message has been opened by a recipient,

11           transmitting the message and the link from the server to the  
12 recipient,

13           executing the link when the link is activated at the recipient to  
14 control the server to provide an indication that the message has been  
15 delivered to the recipient,

16           providing an authenticatable information related to the message,  
17 including the indication of the delivery of the message at the recipient, at  
18 the server, and

19           transmitting the indication of the delivery of the message at the  
20 recipient, and the authenticatable information from the server to the sender.

21 *Id.* at col. 28 ll. 6–25.

22           **6.** The method of claim **1**, wherein the link is activated at the  
23 recipient to provide an indication that the message has been opened by the  
24 recipient.

25           **7.** The method of claim **6**, wherein the indication of the opening of  
26 the message at the recipient, and the authenticatable information are stored  
27 in a memory.

28 *Id.* at col. 28 ll. 39–44.

**10.** The method of claim **1**, wherein the indication of the delivery of  
the message, and the authenticatable information are stored in a memory.

*Id.* at col. 28 ll. 50–53.

**18.** A system transmitting a message from a sender to a recipient and  
providing an indication that the message was opened by the recipient,  
comprising:

          a server in electronic communication with the sender and the  
receiver, the server programmed to receive a message from the sender, to  
associate a link with the message, the link configured to execute when the  
link is activated at the recipient to provide an indication that the message

1 has been opened by a recipient, to transmit the message and the link from  
2 the server to the recipient, wherein

3 the link is executed when the link is activated at the recipient to  
4 control the server to provide an indication that the message has been  
5 opened at the recipient, and

6 wherein the server is programmed to form an authenticatable  
7 information related to the message, and to transmit the indication of the  
8 opening of the message at the recipient and the authenticatable information  
9 from the server to the sender.

10 *Id.* at col. 29 ll. 11–28.

11 **23.** The system of claim **18**, wherein the indication of the opening of  
12 the message at the recipient, and the authenticatable information are stored  
13 in a memory.

14 *Id.* at col. 29 ll. 41–43.

15 **32.** A system transmitting a message from a sender to a recipient and  
16 providing an indication that the message was opened by the recipient,  
17 comprising:

18 a server in electronic communication with the sender and receiver,  
19 the server programmed to receive a message from the sender, to associate a  
20 link with the message, the link configured to execute when the link is  
21 activated at the recipient to provide an indication that the message has been  
22 delivered to a recipient, to transmit the message and the link from the server  
23 to the recipient, wherein

24 the link is executed when the link is activated at the recipient to  
25 control the server to provide an indication that the message has been  
26 delivered to the recipient; and

27 wherein the server is programmed to form an authenticatable  
28 information related to the message, and to transmit the indication of the  
delivery of the message to the recipient and the authenticatable information  
from the server to the sender.

*Id.* at col. 30 ll. 7–25.

**35.** The system of claim **32**, wherein the indication of the delivery of  
the message to the recipient, and the authenticatable information are stored  
in a memory.

*Id.* at col. 30 ll. 31–33.

**i. Step One: Patent-Ineligible Concept**

As a continuation of the ‘104 Patent, the ‘198 Patent incorporates the same  
features and components as its parent, such as a “server,” a “link,” a “message,” an

1 “MTA,” a “recipient,” a “sender,” and “memory.” Also similar is the general concept of  
2 the ‘198 Patent. Like the ‘104 Patent Claims, the ‘198 Patent Claims disclose a method of  
3 providing information about the opening of a message. And like the ‘913 Patent Claims,  
4 the method described in the ‘198 Patent Claims also provides information about the  
5 delivery of a message, albeit via activation of a link.

6 Because there is no practical difference between the concepts of these three  
7 patents, the Court finds that the ‘198 Patent Claims are directed to the same abstract ideas  
8 as the ‘913 and ‘104 Patent Claims, to wit, collecting and providing information about the  
9 opening and delivery of a message. Consequently, for the reasons expressed above, the  
10 Court finds that the ‘198 Patent Claims are directed to the patent-ineligible abstract idea  
11 of collecting and providing information about the opening and delivery of a message.

12 **ii. Step Two: Inventive Concept**

13 Likewise, for the reasons detailed above regarding the ‘913 and ‘104 Patent  
14 Claims, the Court concludes that the ‘198 Patent Claims fail to add “significantly more”  
15 to the claimed abstract idea such that the idea is “transformed” into a patent-eligible  
16 application. *Alice*, 134 S. Ct. at 2355. The functions recited by the ‘198 Patent Claims,  
17 e.g., receiving a message, transmitting a message, adding a link, and storing information  
18 using pre-existing components, are “conventional activities” that “nearly every  
19 computer” can perform. *Id.* at 2361. Thus, because “[i]nstructing one to ‘apply’ an  
20 abstract idea and reciting no more than generic computer elements performing generic  
21 computer tasks does not make an abstract idea patent-eligible,” *Intellectual Ventures I*,  
22 792 F.3d at 1368 (quoting *Alice*, 134 S. Ct. at 2359–60), the Court concludes that the  
23 ‘198 Patent Claims do not add an inventive concept to the abstract idea.<sup>21</sup>

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26 <sup>21</sup> Additionally, the ‘198 Patent Claims recite that the “associated” link executes  
27 “when activated at the recipient.” ‘198 Patent, col. 28 ll. 17–19. Unlike the ‘104 Patent  
28 Claims, the ‘198 Patent Claims do not indicate *when* this activation takes place or *how*  
the link is activated. Rather, the link simply executes when it is activated, thereby causing  
the ‘198 Patent Claims to be even more opaque than the ‘104 Patent Claims.



1 *Id.* at col. 27 ll. 58–col. 28 ll. 7.

2           7. A system for transmitting a message through an electronic mail  
3 system from an originating processor to a recipient processor and providing  
4 proof of receipt of the message by the recipient processor, comprising:

5           a server displaced from the originating processor, the server capable  
6 of being configured by software commands to:

7           receive a message from the originating processor and to transmit the  
8 message to the recipient processor;

9           receive an indication of receipt of the message from the recipient  
10 processor and a mail transport protocol dialog generated by the electronic  
11 mail system during transmission of the message from the server to the  
12 recipient processor;

13           generate a first information including the indication of receipt of the  
14 message from the recipient processor and at least a portion of the mail  
15 transport protocol dialog generated by the electronic mail system during  
16 transmission of the message from the server to the recipient processor.

17 *Id.* at col. 28 ll. 33–52.

18           12. The system of claim 7, further comprising a memory and  
19 wherein the server is further configured to store a copy of the message and  
20 the first information to the originating processor in the memory before any  
21 authentication of the message by the server.

22 *Id.* at col. 29 ll. 8–12.

23           14. A method of transmitting a message from a sender to a recipient  
24 through a server displaced from the recipient, the steps at the server  
25 comprising:

26           receiving the message at the server from the sender, transmitting the  
27 message to the recipient;

28           receiving at the server from the recipient a first information  
including an indication of the receipt of the message by the recipient and at  
least a portion of a generated during transmission of the first information  
from the server to the recipient; and

          storing a representation of the message and the first information  
received by the server from the recipient in a memory, before any  
authentication of the message.

          15. The method of claim 14, further comprising:

          transmitting the representation of the message and the first  
information received by the server from the recipient to the sender from the  
server, before any authentication of the message.

*Id.* at col. 29 ll. 16–col. 30 ll. 13.

1 **i. Step One: Patent-Ineligible Concept**

2 Like the ‘913, ‘104, and ‘198 Patent Claims, at the heart of the ‘389 Patent Claims  
3 is the general concept of collecting and providing information about a particular message,  
4 which is similar to methods of “tracking,” “monitoring,” and “data collection,” that  
5 courts have deemed to be directed to abstract ideas. *See, e.g., Content Extraction*, 776  
6 F.3d at 1347–48 (“data collection, recognition, and storage”); *Wireless Media*  
7 *Innovations*, 100 F. Supp. 3d. at 413 (“monitoring locations, movement, and load status .  
8 . . and storing, reporting and communicating this information in various forms through  
9 generic computer functions”); *YYZ*, 2015 WL 5886176, at \*7 (“measuring, monitoring,  
10 tracking, and simulating enterprise or business communications and processes in an  
11 asynchronous messaging environment”); *Neochloris*, 2015 WL 5951753, at \*4–5  
12 (“collecting,” “transmitting,” and “monitoring” data). Consequently, the Court finds that  
13 the ‘389 Patent Claims are directed to the abstract idea of collecting and providing  
14 information about the receipt of a message.

15 **ii. Step Two: Inventive Concept**

16 RPost contends that the ‘389 Patent Claims add an inventive concept because they  
17 recite “specific ways to verify delivery of an electronic message using specific  
18 information.” *See* (Doc. 299 at 14). Particularly, RPost explains that the claims require  
19 the server to receive a “portion of a transport protocol dialog generated between the  
20 server and a recipient during transmission of an electronic message” and an “indication of  
21 receipt” of the message from the sender in order to “form” and “transmit” a “first  
22 information” to the sender. *Id.*

23 Arguing that something is specific does not make it so. To be sure, underpinning  
24 RPost’s “specifics” is “the performance of some business practice known from the pre-  
25 Internet world along with the requirement to perform it on the Internet.” *DDR Holdings*,  
26 773 F.3d at 1257. This is not a case where the claims are directed to “a problem  
27 specifically arising in the realm of computer technology.” *DDR Holdings*, 773 F.3d at  
28 1257. Rather, the problem of verifying the receipt of a message existed in the pre-

1 Internet, analog world, and the ‘389 Patent Claims simply disclose a process “for which  
2 computers are invoked merely as a tool.” *Enfish*, 2016 WL 2756255, at \*5.

3 Moreover, “whether or not [RPost] has added that special ‘something more’ to this  
4 conventional business practice is determined by the quality, not the quantity, of its  
5 specific adornments and limitations.” *Mobile Telecomms. Techs., LLC v. United Parcel*  
6 *Serv., Inc.*, 2016 WL 1171191, at \*7 (N.D. Ga. Mar. 24, 2016). Here, the server disclosed  
7 in the ‘389 Patent Claims performs three general functions: “receiving” information,  
8 “transmitting” information, and “forming” information. It is well-settled that “receiving”  
9 and “transmitting” functions are conventional activities. *See Alice*, 134 S. Ct. at 2355.  
10 The only arguably inventive concept is “forming” of “first information.” However, the  
11 ‘389 Patent Claims do not chronicle *how* the “forming” is performed or even indicate that  
12 the “first information” is anything more than the pre-existing input information, i.e., “at  
13 least a portion of the mail transport protocol dialog and the indication of the receipt of the  
14 message by the recipient.” ‘389 Patent, col. 28 ll. 1–3.<sup>23</sup> As stated above, mere  
15 information—even information formed from “verifiable information” as RPost  
16 contends—is not patentable. *See Digitech*, 758 F.3d at 1350. Consequently, no inventive  
17 concept has been added by the claims.

### 18 **iii. Conclusion**

19 For the foregoing reasons, the Court finds that the ‘389 Patent Claims are directed  
20 to the abstract idea of collecting and providing information about the receipt of a message  
21 and fail to add an inventive concept sufficient to confer eligibility. Accordingly, the  
22 Court will grant GoDaddy’s motion for summary judgment on this issue and declare that  
23 ‘389 Patent Claim Nos. 1, 7, 12, 14, and 15 are invalid under § 101.

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27 <sup>23</sup> Contrary to RPost’s argument, the PTAB did not “find” or “recognize” that the  
28 “forming” step of the ‘389 Patent was a “technical feature that solves a technical  
problem.” (Doc. 299 at 18–19). Instead, the PTAB merely determined that the petitioner  
failed to meet its burden of proof to institute a CBM patent review. (Doc. 304-4 at 9–10).

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**e. ‘199 Patent<sup>24</sup>**

The ‘199 Patent, a continuation of the ‘389 Patent, claims a method of providing information that an electronic message sent from a sender to a recipient through a server failed to be delivered. ‘199 Patent, col. 27 ll. 58–col. 28 ll. 15. To accomplish this objective, the ‘199 Patent Claims recite the same components and processes as the ‘389 Patent Claims, i.e., a server receives a portion of a mail transport protocol dialog generated by the transmission of the message from the server to the recipient and an indication from the recipient and then “form[s]” a “first information” from that data and “transmit[s]” it to the sender. *Id.* at col. 27 ll. 58–col. 28 ll. 7. The lone distinction between the ‘199 and ‘389 Patent Claims is that the “indication” received by the ‘199 Patent server indicates the failure of message delivery. *Id.* at col. 27 ll. 66–67. In full, the ‘199 Patent Claims recite as follows:

1. A method of transmitting a message from a sender to a recipient through a server displaced from the recipient, the steps at the server comprising:

- receiving the message at the server from the sender;
- transmitting the message to the recipient;
- receiving at the server at least a portion of a data transport protocol dialog generated during transmission of the message from the server to the recipient; and
- receiving at the server from the recipient an indication of the failure to deliver the message to the recipient;
- forming at the server a first information from the at least a portion of the data transport protocol dialog and the indication of the failure to deliver the message by the recipient; and
- transmitting, before any authentication of the message, a copy of the first information to the sender from the server.

2. The method of claim 1, wherein the copy of the first information is stored in a memory in communication with the server.

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<sup>24</sup> The asserted ‘199 Patent claims are Claim Nos. 1, 2, and 3. *See* (Docs. 258 at 2; 271-5 at 2; 300 at 2). These claims will be referenced as the “‘199 Patent Claims.”

1           3. The method of claim 1, wherein transmitting, before any  
2 authentication of the message, includes transmitting a copy of the message  
3 and the first information to the sender from the server.

4 ‘199 Patent, col. 27 ll. 58–col. 28 ll. 14.

5                           **i. Step One: Patent-Ineligible Concept**

6           Like the asserted claims of its parent application, the Court finds that the ‘199  
7 Patent Claims are directed to an abstract idea, namely, collecting and providing  
8 information that a message was not delivered. The problem purportedly solved by the  
9 ‘199 Patent Claims long permeated the pre-Internet, analog world, while the concept of  
10 providing information that an electronic message failed to be delivered has been  
11 implemented by standard SMTP “bounce” code for dozens of years. *See* (Docs. 258 at 8;  
12 271-11 at 6; 300 at 7). Moreover, the concept of collecting and providing information that  
13 a message was not delivered is similar to other concepts found by the Federal Circuit to  
14 be directed to abstract ideas. *See CyberSource*, 654 F.3d at 1370 (finding that “collection  
15 and organization of data” is directed to abstract idea); *Content Extraction*, 776 F.3d at  
16 1347–48 (finding that “collecting data,” “recognizing certain data within the collected  
17 data set,” and “storing the recognized data in memory” were directed to a patent-  
18 ineligible concept). Consequently, the Court finds that the ‘199 Patent Claims are drawn  
19 to an abstract idea.

20                           **ii. Step Two: Inventive Concept**

21           Like its parent application, at the heart of ‘199 Patent Claims is a method “for  
22 which computers are invoked merely as a tool.” *Enfish*, 2016 WL 2756255, at \*5. There  
23 is nothing new about the concept of providing information that a message was not  
24 delivered—generic SMTP code has performed this feat for decades. *See* (Docs. 258 at 8;  
25 271-11 at 6; 300 at 7). Further, as a continuation of the ‘389 Patent, the ‘199 Patent  
26 Claims merely recite the same conventional steps, e.g., “transmitting,” “receiving,” and  
27 “forming,” that are implemented by generic components, e.g., a “server,” a “sender,” and  
28 a “recipient,” that decidedly do not add an inventive concept to the claims. *See, e.g.,*  
*Ultramercial*, 772 F.3d at 717 (“[A]dding a computer to otherwise conventional steps

1 does not make an invention patent-eligible.”); *Intellectual Ventures I*, 792 F.3d at 1368  
2 (“Instructing one to ‘apply’ an abstract idea and reciting no more than generic computer  
3 elements performing generic computer tasks does not make an abstract idea patent-  
4 eligible.” (quoting *Alice*, 134 S. Ct. at 2359–60)). Accordingly, the Court concludes that  
5 no inventive concept has been added to the ‘199 Patent Claims sufficient to transform the  
6 abstract idea into a patent-eligible application.

7 **iii. Conclusion**

8 For these reasons, the Court finds that the ‘199 Patent Claims are directed to the  
9 abstract idea of collecting and providing information that a message was not delivered  
10 and failed to add an inventive concept sufficient to confer eligibility. The Court will  
11 therefore grant GoDaddy’s motion for summary judgment on this issue and declare that  
12 ‘199 Patent Claim Nos. 1, 2, and 3 are invalid under § 101.

13 **B. Conclusion for Patent-Eligibility**

14 For the foregoing reasons, the Court concludes that all asserted claims of the  
15 Feldbau and Tomkow Patents are ineligible and invalid under § 101.<sup>25</sup> The remainder of  
16 GoDaddy’s motion for summary judgment will therefore be deemed moot.<sup>26</sup>

17 **IV. RPost’s Motion for Summary Judgment**

18 RPost moves the Court for summary judgment on Count I of GoDaddy’s FAC.  
19 (Doc. 284). In Count I, GoDaddy asserts that during the parties’ pre-suit discussions,  
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21  
22 <sup>25</sup> On June 3, 2016, Judge Denise J. Casper of the United States District Court for  
23 the District of Massachusetts ruled on a motion for judgment on the pleadings in a similar  
24 case and held that the claims of the ‘389, ‘913, and ‘199 Patents are not directed to an  
25 abstract idea and claim an inventive concept. *See Sophos Inc. v. RPost Holdings, Inc.*,  
26 2016 U.S. Dist. LEXIS 72699 (D. Mass. June 3, 2016). The Court has considered Judge  
27 Casper’s order and gives it “weight,” *see, e.g., Stevenson v. Sears, Roebuck & Co.*, 713  
F.2d 705, 711 (Fed. Cir. 1983); *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720,  
723 (Fed. Cir. 1990), but “reach[es] a contrary legal conclusion” after exercising due  
“caution,” *see Mendenhall v. Cederapids, Inc.*, 5 F.3d 1557, 1569 (Fed. Cir. 1993).

28 <sup>26</sup> As the Federal Circuit stated, “[t]he claim being invalid there is nothing to be  
infringed.” *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1580 (Fed. Cir. 1983).

1 RPost fraudulently misrepresented that it had “unrestricted rights” to enforce the Asserted  
2 Patents in lieu of disclosing that the patents’ title was “clouded.” (Doc. 46 at 12–17).  
3 Specifically, GoDaddy complains that RPost did not inform GoDaddy about litigation in  
4 California and Texas that “clouded” ownership of the Asserted Patents. (*Id.* at 13).

5 In its motion for summary judgment, RPost contends that there is no disputed  
6 issue of material fact as to whether it fraudulently misrepresented its patent ownership  
7 during pre-suit discussions with GoDaddy. *See* (Doc. 284). RPost argues that GoDaddy  
8 failed to present any evidence that RPost lacked the legal right to enforce the Asserted  
9 Patents and therefore cannot be liable for not disclosing “clouded” title. (*Id.* at 13). RPost  
10 also maintains that GoDaddy had knowledge of the California and Texas lawsuits via  
11 discussions with RPost representatives and access to public records. (*Id.*) RPost finally  
12 contends that Count I suffers from two pleading errors, namely, that “omissions” cannot  
13 form the basis for a fraudulent misrepresentation claim under Arizona law and that  
14 GoDaddy failed to plead a necessary element of fraudulent misrepresentation. (*Id.* at 7).

15 In response, GoDaddy argues that a disputed issue of material fact exists as to  
16 whether title to the Asserted Patents is “clouded.” (Doc. 298). In GoDaddy’s view, if  
17 there is a “cloud” on a patent’s title, the patent owner must disclose that fact to an alleged  
18 infringer. (*Id.*) To that end, GoDaddy insists that there is a disputed issue of material fact  
19 as to whether RPost fraudulently misrepresented that it possessed “unrestricted title” to  
20 the Asserted Patents when a “cloud” on that title existed. (*Id.*)

21 **A. Background**

22 The ownership of the Asserted Patents has been detailed by the Court as follows:

23 Starting in 1999, Dr. Terrance Tomkow applied for the [Asserted  
24 Patents], which describe a way of tracking and confirming delivery of  
25 email. (Doc. 46 at 6). Kenneth Barton and Zafar Khan joined Tomkow in  
26 creating a corporate structure to protect this intellectual property and  
27 founded RPost International and a related organization called RPost, Inc.  
28 (*Id.*) Tomkow, Barton, and Khan were all shareholders in RPost  
International. (*Id.*) On September 13, 2000, Dr. Tomkow assigned his  
patent applications to RPost International, and the three principals  
unsuccessfully pursued funding to commercialize the intellectual property

1 owned by RPost International. (*Id.*)

2 Barton's relationship with Tomkow and Khan fell apart over time,  
3 and Barton eventually brought two actions against Tomkow and Khan (the  
4 "Barton Cases"). (*Id.*) First, on August 3, 2012, a California court found  
5 that Tomkow, Khan, and RPost International had acted with malice,  
6 oppression, and fraud when they converted Barton's RPost International  
7 shares. (*Id.* at 7). Tomkow, Khan, and RPost International were ordered to  
8 restore Barton's shares and to pay punitive and general damages. (*Id.*)  
9 Second, Barton brought another state action against RPost International,  
10 RMail, and RComm alleging that RPost International, Tomkow, and Khan  
11 fraudulently transferred corporate assets, including intellectual property  
12 assets, of RPost International to RComm and RMail. (*Id.*) Barton alleges  
13 that Tomkow and Khan formed the new off-shore entity, RMail, and then  
14 as officers of both RPost International and RMail, caused \$750,000 to be  
15 transferred from RPost International to RMail. (*Id.* at 8). RMail used that  
16 money to purchase RPost International's intellectual property assets,  
17 including the [Asserted Patents]. (*Id.*) RPost International then paid  
18 \$200,000 to RMail as a license fee for the use of those same intellectual  
19 property assets. (*Id.*) Barton did not approve or sign any of these property  
20 transfers. (*Id.* at 9). RPost has tried to exploit the [Asserted Patents] since  
21 these transfers have occurred. (*Id.*)

22 Khan and Tomkow have each filed for bankruptcy under Chapter 13  
23 (the "Bankruptcy Cases"), but Barton has objected to the bankruptcy filings  
24 for various reasons. (*Id.*) In December 2013, the bankruptcy court granted  
25 Barton's motions to convert Khan and Tomkow's Chapter 13 Bankruptcy  
26 Cases to Chapter 7 and appointed a trustee to manage their assets, including  
27 the [Asserted Patents]. (*Id.*)

28 RPost has filed lawsuits against several of GoDaddy's competitors  
alleging infringement of the Patents-in-Suit, which have been consolidated  
into one action called *Rmail Ltd. v. Amazon.com, Inc.*, No. 2:10-cv-258-  
JRG in the Eastern District of Texas (the "*Amazon Case*"), filed August 24,  
2012. (*Id.* at 10–11). Just before trial, one defendant in the *Amazon Case*  
received correspondence from the plaintiff in the Barton Cases advising  
that there should be no settlement or disposition in actions involving the  
Patents-in-Suit until their ownership has been determined. (*Id.* at 11). In  
light of this correspondence, on January 30, 2014, the judge in the Eastern  
District of Texas stayed and administratively closed the *Amazon Case*  
pending resolution of the patent ownership disputes. (*Id.* at 11).

*GoDaddy.com, LLC v. RPost Commc'ns Ltd.*, 2014 WL 6908507, at \*1–2 (D. Ariz. Dec.  
9, 2014); (Doc. 105 at 2–3). The Court has also described the party's pre-suit discussions  
as follows:

1 RPost first contacted GoDaddy via email on July 17, 2013 (“the  
2 Email”) and advised of its belief that GoDaddy was infringing [the  
3 Asserted Patents]. (Doc. 46-4). RPost alleged in the Email that GoDaddy’s  
4 “business processes and electronic messaging and document operations”  
5 infringed RPost’s patents. (Doc. 46-4 at 3). The Email also suggested that  
6 GoDaddy “review the RPost patents noted below for a more complete  
7 description of RPost patented technologies and review these in the context  
8 of your technology operations.” (*Id.*) The Email then listed seventeen  
9 patents owned by RPost including the Tomkow Patents, RMail Patents, and  
10 others, with no attention drawn to any particular patent in the list. (*Id.* at 3–  
11 4).

12 In a letter on October 4, 2013 (“the Letter”), RPost further asserted  
13 the Tomkow Patents by providing claim charts “identifying certain claims  
14 of certain patents and [GoDaddy’s] infringing conduct.” (Doc. 46-5 at 4).  
15 RPost brought specific attention to GoDaddy’s “Express Email Marketing”  
16 product and service. (*Id.*) Only claims from the Tomkow Patents were  
17 analyzed, but RPost advised GoDaddy that “[i]t is likely that [GoDaddy’s]  
18 products and services are infringing other claims of RPost’s patents.” (*Id.*)  
19 RPost provided a comprehensive list of patents owned by RPost at the end  
20 of the Letter, which included foreign and U.S. patents, the Tomkow  
21 Patents, RMail Patents, and pending patent applications, with no attention  
22 drawn to any specific patent.

23 On October 22, 2013, an RPost representative named Jerry Silver  
24 called GoDaddy’s Associate General Counsel for Intellectual Property,  
25 Karl Fazio, telephonically to discuss the Email and the Letter (“the Phone  
26 Call”). (Doc. 84-2 at 3). Silver accused GoDaddy of infringing RPost’s  
27 patents and brought up RPost’s past litigation, indicating that RPost is not  
28 afraid to litigate in order to enforce its patents. (*Id.* at 4). Silver and Fazio  
discussed RPost’s patents, but GoDaddy has provided no evidence that any  
specific patents were discussed in detail. (*See id.* at 3–4; doc. 84 at 3–4).

Finally, on or about November 19, 2013, RPost sent GoDaddy a  
PowerPoint presentation (“the Presentation”) entitled “Summary of  
Preliminary Infringement Analysis.” (Doc. 84 at 4). On the cover page of  
the Presentation, four of the Tomkow Patents were listed under a heading  
entitled “Patents & Claims in Analysis,” and the ’219 patent (an RMail  
Patent), along with one Tomkow Patent and three other patents, was listed  
under a heading entitled “Additional Recommended Review.” (Doc. 84-2 at  
10). On the next slide of the Presentation, there was a list of many patents  
owned by RPost with no attention drawn to any particular patent. (Doc. 84-  
2 at 11).

*GoDaddy.com, LLC v. RPost Commc’ns Ltd.*, 2014 WL 6908520, at \*1–2 (D. Ariz. Dec.

1 9, 2014); (Doc. 107 at 2–3).

2 **B. Fraudulent Misrepresentation**

3 In order to establish a fraudulent misrepresentation claim under Arizona law, a  
4 claimant must show: “1) a representation; 2) its falsity; 3) its materiality; 4) the speaker’s  
5 knowledge of the representation’s falsity or ignorance of its truth; 5) the speaker’s intent  
6 that it be acted upon by the recipient in the manner reasonably contemplated; 6) the  
7 hearer’s ignorance of its falsity; 7) the hearer’s reliance on its truth; 8) the right to rely on  
8 it; and 9) his consequent and proximate injury.” *Echols v. Beauty Built Homes*, 647 P.2d  
9 629, 631 (Ariz. 1982).

10 Because RPost also raises a pleading deficiency in addition to seeking summary  
11 judgment, the Court notes that certain elements of fraud claims carry a higher standard of  
12 pleading under the Federal Rules of Civil Procedure (“Rules”). Namely, “[i]n all  
13 averments of fraud or mistake, the circumstances constituting fraud or mistake shall be  
14 stated with particularity. Malice, intent, knowledge, and other condition of the mind of a  
15 person may be averred generally.” Fed. R. Civ. P. 9(b). “To allege fraud with  
16 particularity, a [claimant] . . . must set forth an explanation as to why the statement or  
17 omission complained of was false or misleading.” *In re GlenFed, Inc. Sec. Litig.*, 42 F.3d  
18 1541, 1548 (9th Cir. 1994). “While statements of the time, place and nature of the alleged  
19 fraudulent activities are sufficient, mere conclusory allegations of fraud are insufficient.”  
20 *Moore v. Kayport Package Exp., Inc.*, 885 F.2d 531, 540 (9th Cir. 1989).

21 **C. Analysis**

22 In Count I of its FAC, GoDaddy contends that because RPost’s ownership of the  
23 Asserted Patents was called into question by the Barton and Bankruptcy Cases, RPost is  
24 liable for fraudulently misrepresenting that it possessed “unclouded ownership in and  
25 rights to enforce” the Asserted Patents. *See* (Doc. 46 at 16). In other words, GoDaddy  
26 seeks to recover damages not because it believes (or has any evidence that) RPost does  
27 not have the legal right to enforce the Asserted Patents, but because RPost did not inform  
28 GoDaddy that a “cloud” shadows the patents’ title.

1 To begin, the Court questions the propriety of RPost challenging the adequacy of  
2 GoDaddy’s pleading via a motion for summary judgment where it is the movant’s burden  
3 to either set forth evidence proving that it is entitled to judgment as a matter of law or  
4 show that the non-movant cannot establish all necessary elements of its claim.  
5 Nonetheless, RPost argues that “[n]on-disclosure cannot form the basis of an Arizona-  
6 based fraudulent misrepresentation claim because those are well-recognized as separate  
7 torts under the Arizona common law.” (Doc. 315 at 7) (citing *Resort Funding, L.L.C. v.*  
8 *Canyonview Dev., L.P.*, 2012 WL 3760440, at \*9 (Ariz. Ct. App. Aug. 30, 2012)).  
9 Although it is true that Arizona distinguishes between tort claims for fraudulent  
10 misrepresentation, fraudulent concealment, and non-disclosure, *see Wells Fargo Bank v.*  
11 *Ariz. Laborers Local No. 395 Pension Trust Fund*, 38 P.3d 12, 34–36 (2002), Count I of  
12 GoDaddy’s FAC claims that RPost affirmatively misrepresented that it possessed  
13 “unclouded ownership in and rights to enforce” the Asserted Patents while failing to  
14 disclose the pending California and Texas actions, (Doc. 46 at 16). Because Count I  
15 alleges that RPost affirmatively represented a particular fact that was false, the Court  
16 finds that Count I falls within the contours of a claim for fraudulent misrepresentation.  
17 *See Wells Fargo Bank*, 38 P.3d at 34 (“Where failure to disclose a material fact is  
18 calculated to induce a false belief, ‘the distinction between concealment and affirmative  
19 misrepresentation is tenuous.’” (quoting *Schock v. Jacka*, 460 P.2d 185, 187 (Ariz.  
20 1969))).<sup>27</sup>

21 \_\_\_\_\_  
22 <sup>27</sup> The Court also rejects RPost’s argument that Count I suffers from a pleading  
23 deficiency because GoDaddy did not plead its ignorance of the falsity of RPost’s  
24 representations. Although GoDaddy did not plead that it lacked knowledge of the falsity  
25 of RPost’s representations in a separate number, the Rules permit a party to plead this  
26 element “generally.” *See* Fed. R. Civ. P. 9(b). In this regard, Count I incorporates  
27 assertions that generally and plausibly allege that GoDaddy lacked knowledge of the  
28 purported falsity of RPost’s representations. Namely, Count I claims that GoDaddy  
“reasonably relied to its detriment” on RPost’s representations. (Doc. 46 at 17). Under  
Arizona law, one cannot “reasonably rely” on information that is false. *See Fectay v.*  
*Tahiri*, 2015 WL 7710272, at \*2 (Ariz. Ct. App. Nov. 30, 2015). Thus, by pleading that it  
“reasonably relied” on RPost’s representations, GoDaddy “generally” pled that it lacked

1           Despite overcoming RPost’s pleading deficiency arguments, GoDaddy failed to  
2 establish that any of RPost’s representations were, in fact, false. After substantial review  
3 of the parties’ papers, the Court finds that GoDaddy has not articulated any disputed issue  
4 of material fact as to “why the statement or omission complained of was false or  
5 misleading.” *In re GlenFed, Inc. Sec. Litig.*, 42 F.3d at 1548. The fundamental problem  
6 with Claim I is its underlying assumption that RPost had an obligation to inform  
7 GoDaddy about the alleged “cloud” on the Asserted Patents’ title. *See* (Doc. 46 at 16).<sup>28</sup>  
8 GoDaddy, however, advanced no evidence or binding authority demonstrating that “free  
9 and clear” ownership is necessary to *assert* a patent. The lone case cited by GoDaddy in  
10 this regard is an unpublished decision from the Southern District of New York that  
11 insignificantly remarks that “people do not ordinarily pay lawyers to bring lawsuits to  
12 enforce patents that they do not own.” *Advanced Video Techs. LLC v. HTC Corp.*, 2015  
13 WL 7621483, at \*11 (S.D.N.Y. Aug. 28, 2015). Only through a particularly pretentious  
14 reading of this statement could a reader smoke out any indication that a patent owner  
15 must inform an alleged infringer about a “cloud” on the patent’s title, let alone arrive at  
16 the conclusion that a patent owner must own its patent “free and clear” to assert it.<sup>29</sup>

17           In any event, GoDaddy’s belief that RPost must have had “free and clear” title in  
18 \_\_\_\_\_  
19 knowledge of the representation’s alleged falsity.

20           <sup>28</sup> The half-page of footnotes in GoDaddy’s brief explaining the “clouded title”  
21 doctrine all relate to the *sale* of *real property*. *See* (Doc. 298 at 6). In contrast, the  
22 provision of the Patent Act describing patent ownership states that “patents shall have the  
23 attributes of *personal property*.” 35 U.S.C. § 261 (emphasis added). The only case  
24 GoDaddy cites to support its conclusory theory that “[t]he clouded or defective title  
25 doctrine, though typically arising in real property, applies with equal force to titles of  
26 patents” is a 114 year-old case issuing from the D.C. Circuit. *See* (Doc. 298 at 6) (citing  
*Columbia Nat’l Sand Dredging Co. v. Miller*, 20 App. D.C. 245, 252 (D.C. Cir. 1902)).  
In any event, GoDaddy cites no authority to establish that *asserting* a patent (personal  
property) against an alleged infringer is akin to the *sale* of real property.

27           <sup>29</sup> GoDaddy also cites Rule 11 to support its argument that a patent must be owned  
28 “free and clear” in order to be enforced. (Doc. 298 at 5). Rule 11, however, deals with  
pleadings made to a court of law and certainly has no bearing on whether a patent must  
be owned “free and clear” to be asserted before litigation. *See* Fed. R. Civ. P. 11(b).

1 order to assert its patents against GoDaddy in pre-litigation discussions is not required  
2 under the law. Rather, the question of patent ownership focuses on whether RPost had  
3 “legal title” to enforce the patents. *See, e.g., MyMail, Ltd. v. Am. Online, Inc.*, 476 F.3d  
4 1372, 1375–76 (Fed. Cir. 2007) (“A plaintiff must demonstrate legal title to the patent at  
5 the inception of the lawsuit to be entitled to sue for patent infringement.”); *Arachnid, Inc.*  
6 *v. Merit Indus., Inc.*, 939 F.2d 1574, 1579 (Fed. Cir. 1991) (“[O]ne seeking to recover  
7 money damages for infringement of a United States patent (an action ‘at law’) must have  
8 held the legal title to the patent during the time of the infringement.” (citing *Crown Die &*  
9 *Tool Co. v. Nye Tool & Mach. Works*, 261 U.S. 24, 40–41 (1923))); *Paradise Creations,*  
10 *Inc. v. UV Sales, Inc.*, 315 F.3d 1304, 1309 (Fed. Cir. 2003) (“[I]n order to assert  
11 standing for patent infringement, the plaintiff must demonstrate that it held enforceable  
12 title to the patent at the inception of the lawsuit.”).

13 Consequently, as the party alleging fraudulent misrepresentation of patent  
14 ownership, GoDaddy bears the burden of proving that RPost lacked “legal title” to the  
15 Asserted Patents at the time of the representations. In this regard, GoDaddy failed to  
16 provide any evidence showing that RPost did not have “legal title” to the patents, and no  
17 court has determined otherwise.<sup>30</sup> Alleged clouded title to a patent does not mean that the  
18 patent owner lacks legal title to assert that patent. *See Arachnid*, 939 F.2d at 1577–82  
19 (holding that although a third-party’s legal title to the asserted patent was questioned by a  
20 challenger’s equitable title at the time of the alleged infringement, only the legal title-  
21 holder had the right to sue for money damages).<sup>31</sup> Because GoDaddy “fail[ed] to make a  
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23 <sup>30</sup> The Court explained this concept in its prior Order dismissing Counts III–XII of  
24 GoDaddy’s FAC against certain RPost-affiliated entities. *See GoDaddy.com, LLC v.*  
25 *RPost Commc’ns Ltd.*, 2014 WL 7263537, at \*6 (D. Ariz. Dec. 9, 2014); (Doc. 106 at 9).  
26 Specifically, the Court identified that the “legitimacy of the assignment of the Tomkow  
27 Patents . . . is not the present issue before the Court, nor has that assignment been deemed  
28 fraudulent by any court to date.” *Id.*

<sup>31</sup> Again, the singular case cited by GoDaddy to argue that RPost should be liable  
for fraudulently misrepresenting “unrestricted patent infringement litigation rights” is  
untenable. *See* (Doc. 298 at 13) (citing *Intamin, Ltd. v. Magnetar Techs. Corp.*, 623 F.

1 showing sufficient to establish the existence of an element essential to [its] case, and on  
2 which [it] will bear the burden of proof at trial,” *Celotex*, 477 U.S. at 322, summary  
3 judgment in favor of RPost is appropriate.

4 Moreover, to prevail on a claim for fraudulent misrepresentation, GoDaddy must  
5 show that RPost made a misrepresentation of *fact*. See *Wells Fargo Bank*, 38 P.3d at 34  
6 n.22. In several instances, GoDaddy conflates representations of fact with representations  
7 of opinion. For example, GoDaddy asserts that Mr. Khan fraudulently termed RPost’s  
8 ongoing litigation in California and Texas as “nothing to worry about” and “frivolous.”  
9 (Doc. 308-1 at 189). These assertions, however, were certainly not representations of  
10 *fact*, but were Mr. Khan’s *opinions* that the ongoing cases concern unproven  
11 allegations—which, to this day, still do. Whether GoDaddy relied on these statements is  
12 inconsequential to the inquiry of whether the representations were of *fact*, an element of  
13 fraud to which GoDaddy bears the burden of proof. See *Caruthers v. Underhill*, 287 P.3d  
14 807, 816 (Ariz. Ct. App. 2012) (“Expressions of opinion are not material facts sufficient  
15 to support a claim of fraud.” (citation omitted)).

16 Finally, even assuming a “cloud” covered RPost’s title to the Asserted Patents and  
17 RPost’s representations of “unclouded ownership” were false, GoDaddy failed to present  
18 evidence that the representations were “material.” Namely, even if a “cloud” existed, that  
19 does not mean RPost did not have the legal right to enforce the patents, see *Arachnid*, 939  
20 F.2d at 1577–82, and GoDaddy provided no evidence proving that RPost did not possess  
21 legal title to the patents at the time of the representations. Without such evidence, RPost’s

22  
23 Supp. 2d 1055 (C.D. Cal. 2009)). In *Intamin*, the court determined that a patentee  
24 “misrepresent[ed] . . . its ownership interest in the patent” pursuant to the unclean hands  
25 doctrine when it sent a demand letter to an alleged infringer but *did not own* the patent.  
26 623 F. Supp. 2d at 1072, 1077–78. In this case, the doctrine of unclean hands is not at  
27 issue, and, more importantly, GoDaddy has set forth no evidence that RPost does not own  
28 the Asserted Patents. In fact, GoDaddy even appears to concede that RPost *currently*  
owns and has the right to enforce the patents. See (Doc. 298 at 10) (“A jury will see from  
these claims that they created a cloud on title to the RPost Patents, with the resulting  
material risk that RPost *would lose ownership of and the right to enforce the patents*  
*altogether . . .*” (emphasis added)).

1 representation of “unclouded ownership” could not have been “material” for fraud.

2 **D. Conclusion on RPost’s Motion for Summary Judgment**

3 Accordingly, the Court finds that even if all justifiable inferences are construed in  
4 GoDaddy’s favor, no disputed issue of material fact exists such that a reasonable jury  
5 could find RPost liable on Count I of the FAC. GoDaddy failed to set forth any evidence  
6 that RPost’s representations of legal title to the Asserted Patents were materially false  
7 even assuming the title was “clouded.” Simply because a third party makes a claim to a  
8 patent’s title does not mean the patent owner simultaneously forfeits its legal right to  
9 enforce the patent. Thus, the Court will grant RPost’s motion for summary judgment.

10 **V. Conclusion**

11 Based on the foregoing,

12 **IT IS ORDERED** that GoDaddy’s Motion for Summary Judgment (Doc. 257) is  
13 **GRANTED** and the Court **DECLARES** as follows:

- 14 • The asserted claims of the ‘219 Patent, Claim Nos. 60, 62, 66, and 69, are  
15 **INVALID** under 35 U.S.C. § 101.
- 16 • The asserted claims of the ‘913 Patent, Claim Nos. 1 and 2, are **INVALID**  
17 under 35 U.S.C. § 101.
- 18 • The asserted claims of the ‘104 Patent, Claim Nos. 1, 9, 27, and 32, are  
19 **INVALID** under 35 U.S.C. § 101.
- 20 • The asserted claims of the ‘198 Patent, Claim Nos. 1, 6, 7, 10, 18, 23, 32,  
21 and 35, are **INVALID** under 35 U.S.C. § 101.
- 22 • The asserted claims of the ‘199 Patent, Claim Nos. 1, 2, and 3, are  
23 **INVALID** under 35 U.S.C. § 101.
- 24 • The asserted claims of the ‘389 Patent, Claim Nos. 1, 7, 12, 14, and 15, are  
25 **INVALID** under 35 U.S.C. § 101.
- 26 • The remainder of GoDaddy’s motion for summary judgment and the  
27 remaining Counts seeking declarations in GoDaddy’s First Amended  
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Complaint are deemed moot.<sup>32</sup>

**IT IS FURTHER ORDERED** that RPost’s Motion for Summary Judgment on Plaintiff’s Count I (Fraudulent Misrepresentation of Patent Ownership) (Doc. 284) is **GRANTED**.

**IT IS FURTHER ORDERED** that the jury trial set for August 22, 2016 is **VACATED**.

**IT IS FINALLY ORDERED** that the Clerk of Court shall enter judgment in this case with prejudice in favor of Plaintiff and against Defendants on Counts VIII–XIII and XV of the First Amended Complaint.<sup>33</sup> Counts III–VII are **DISMISSED** without prejudice as moot, Plaintiff shall take nothing on these Counts and the Clerk of Court shall enter judgment accordingly on these Counts. The Clerk of Court shall enter judgment in favor of Defendants and against Plaintiff on Count I of the First Amended

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<sup>32</sup> RPost’s original infringement contentions included several claims that RPost decided to withdraw after the Court’s *Markman* Order. *See* (Docs. 258 at 2, 12; 300 at 2, 10). These originally-asserted but withdrawn claims are as follows: ‘198 Patent Claim No. 40; ‘199 Patent Claim No. 7; ‘389 Patent Claim Nos. 5 and 13; and ‘219 Patent Claim Nos. 82, 86, and 88. *See* (Docs. 191-1 at 1, 10; 258 at 2, 12; 271-5 at 2; 300 at 2, 10). In its statement of facts, GoDaddy stated that the currently-asserted claims are as follows: ‘219 Patent Claim Nos. 60, 62, 66, and 69; ‘199 Patent Claim Nos. 1, 2, and 3; ‘198 Patent Claim Nos. 1, 6, 7, 10, 18, 23, 32, and 35; ‘389 Patent Claim Nos. 1, 7, 12, 14, and 15; ‘913 Patent Claim Nos. 1 and 2; and ‘104 Patent Claim Nos. 1, 9, 27, and 32. (Doc. 258 at 2, 12). In support, GoDaddy attached an e-mail from RPost’s counsel dated February 24, 2016, confirming these claims. *See* (Doc. 271-5 at 2). RPost did not dispute these statements of fact or the e-mail. (Doc. 300 at 2, 10). Consequently, the Court will treat the statements of fact as true, *see* Fed. R. Civ. P. 56(e)(2), and, because GoDaddy moved for summary judgment on all currently-asserted claims, no claims remain pending before the Court. Finally, GoDaddy’s First Amended Complaint requested a declaration of invalidity of “each of the Patents-in-Suit.” (Doc. 46 at 38). To be clear, the Court does not declare the entirety of each Asserted Patent to be invalid; rather, the Court holds and declares invalid the currently-asserted claims expressly listed as invalid.

<sup>33</sup> Because the Counts on which Plaintiff prevailed seek only a declaration, Plaintiff is not awarded any monetary damages. Plaintiff, should it so desire, may move for an award of attorneys’ fees, consistent with the Federal and Local Rules, pursuant to 35 U.S.C. § 285.

1 Complaint. This judgment addresses the entire First Amended Complaint, (Doc. 46).<sup>34</sup>  
2 Due to the Declarations stated above, Defendants' Counterclaims, (Doc. 108), are  
3 **DISMISSED** in their entirety without prejudice, and the Clerk of Court shall enter  
4 judgment accordingly on the Counterclaims.

5 Dated this 7th day of June, 2016.

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James A. Teilborg  
Senior United States District Judge

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<sup>34</sup> Counts II, XIV, and XVI of the First Amended Complaint were dismissed by prior Orders. *See* (Docs. 105, 107). The Court also notes that the First Amended Complaint seeks injunctive relief. *See* (Doc. 46 at 38). However, in moving for summary judgment (as opposed to partial summary judgment), Plaintiff failed to mention injunctive relief. Accordingly, the Court deems any such request to be waived. *See* Fed. R. Civ. P. 56(a) advisory committee's note to 2010 amendment (explaining "that summary judgment may be requested not only as to an entire case but also as to a claim, defense, or part of a claim or defense" and that "'partial summary judgment' . . . describe[s] disposition of less than the whole action"); *see generally Jenkins v. Cty. of Riverside*, 398 F.3d 1093, 1095 (9th Cir. 2005) (observing that party "abandoned" two claims plead in complaint "by not raising them in opposition to the [defendant]'s motion for summary judgment").

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**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF ARIZONA**

GoDaddy.com LLC,  
Plaintiff,  
v.  
RPost Communications Limited, et al.,  
Defendants.

**NO. CV-14-00126-PHX-JAT  
JUDGMENT IN A CIVIL CASE**

**Decision by Court.** This action came for consideration before the Court. The issues have been considered and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that pursuant to the Court's Order filed June 7, 2016, judgment is entered with prejudice in favor of plaintiff and against defendant on Counts VIII-XIII and XV of the First Amended Complaint. Counts III-VII are Dismissed without prejudice as moot. Plaintiff shall take nothing on these counts. Judgment is entered in favor of Defendants and against Plaintiff on Count I of the First Amended Complaint. Defendants' Counterclaims are dismissed in their entirety without prejudice.

Brian D. Karth  
District Court Executive/Clerk of Court

June 7, 2016

By s/ E. Aragon  
Deputy Clerk

## CERTIFICATE OF FILING AND SERVICE

I hereby certify that on September 26, 2016, I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system.

I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

I further certify that, upon acceptance and request from the Court, the required paper copies of the foregoing will be shipped via overnight delivery to the Clerk, United States Court of Appeals for the Federal Circuit, 717 Madison Place, N.W., Washington, D.C. 20439.

Dated: September 26, 2016

Respectfully submitted,

Hudnell Law Group P.C.

By: /s/ Lewis E. Hudnell, III  
Lewis E. Hudnell, III

Attorneys for Defendants-Appellants  
RPost Communications Limited  
RPost Holdings, Inc.  
RPost International Limited  
RMail Limited

## CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rules of Appellate Procedure 28.1(e)(3) and 32(a)(7)(C), the undersigned hereby certifies that this brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 28.1(e)(2)(B)(i).

1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) and Federal Circuit Rule 32(b) because this brief contains 13,955 words, excluding the parts of the brief exempted by Federal Circuit Rule 32(b)(1)-(3).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word for Mac 2011 in 14-point Times New Roman Font.

Dated: September 26, 2016

Respectfully submitted,

Hudnell Law Group P.C.

By: /s/ Lewis E. Hudnell, III  
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