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A legal look at Patent Trial and Appeal Board decisions and trends

E-MESSAGE PATENTS SURVIVE ALICE CHALLENGE

By Tyrus S. Cartwright

Common computer technology has fallen victim to *Alice* in many recent cases. It is therefore noteworthy that the District of Massachusetts declined to invalidate e-mail management patents under §101 in *Sophos v. RPost*.

The patents-in-suit are directed to inventions that verify the delivery and integrity of electronic messages. RPost alleged Sophos infringed the patents-in-suit and Sophos defended such claims by alleging, among other things, that the patents-in-suit are invalid as being directed to patent ineligible abstract ideas.

The Court found that the patents-in-suit do not claim an abstract idea, and if even so, they also claim an inventive concept sufficient to satisfy step two under the *Alice* framework. Sophos argued that “the ‘628 patent claims the electronic equivalent of certified mail, the ‘389 patent recited the concept of notifying the sender that a message was successfully delivered, the ‘199 patent claims the concept of notification when the certified message was not successfully delivered and the ‘913 patent claims the concept of using a communication system or language when delivering certified mail.” (*Sophos v. RPost*, p. 25.) Further, Sophos argued that the patents-in-suit “do not teach an algorithm or other novel technique for certifying the delivery of e-mail...but simply computerize concepts that the post office has been using for years.” (*Sophos v. RPost*, pp. 25-26.)

The Court disagreed with Sophos’ assertions and held that “the patents-in-suit do not claim the abstract idea of certified mail because their methods do more than provide proof of mailing, they also provide proof of delivery and content.” (*Sophos v. RPost*, p. 26.) For support of its position, the Court pointed to RPost’s assertions, which “identified several different claims from the patents-in-suit that relate to verifying the content of messages, a task that the United States Postal Service cannot do.” (*Sophos v. RPost*, p. 26.)

Further, the Court held that, “even if the patents-in-suit claim an abstract idea, they also claim an inventive concept sufficient to pass muster under *Alice*.” (See *Sophos v. RPost*, at p. 26.) Although Sophos argued that “the patents-in-suit duplicate a pre-internet business practice on the internet because the patents-in-suit allegedly acknowledge that their solution is directed at the same problem that exists with regular mail, namely proof of delivery,” the Court maintained that the patents-in-suit address more than that. (See *Id.*) In its conclusion, the Court found that “the patents-in-suit aim to solve a technical problem of electronic messages, which because of their form, present unique challenges for establishing proof of receipt and delivery.” (See *Id.*)

Takeaway

Generally, over-generalizing patent claims under a §101 analysis may prove to be futile when the claims recite an inventive concept that is more than the proffered abstract idea. Patents directed towards solving a technical problem also appear to stand a greater chance of satisfying step two under the *Alice* framework.

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