UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

GINEGAR LLC,

           Plaintiff,

    v.

SLACK TECHNOLOGIES, INC,

           Defendant.

Case No. 22-cv-00044-WHO

ORDER GRANTING MOTION TO DISMISS

Re: Dkt. No. 55

Plaintiff Ginegar LLC ("Ginegar") filed suit against defendant Slack Technologies, Inc. ("Slack"), asserting that Slack infringed upon two patents owned by Ginegar related to instant messaging systems. Slack moves to dismiss, arguing that the claims are invalid because they are directed to ineligible subject matter and do not claim an improvement to instant messaging technology. Because the claims at issue recite an abstract idea and fail to include an inventive concept that elevates them to more than a patent on the abstract idea itself, Slack's motion to dismiss is GRANTED, with limited leave to amend.

BACKGROUND

I.   FACTUAL BACKGROUND

Ginegar is the assignee and owner of U.S. Patent Numbers 9,367,521 (the "'521 Patent") and 9,760,865 (the "'865 Patent") (collectively, the "Patents"). First. Am. Compl. ("FAC") [Dkt. No. 27] ¶¶ 2, 15-16, 31-32 (citing Exs. A ('521 Patent), B ('865 Patent)). The Patents are directed to instant messaging systems, where "individuals can communicate with one another using text-based or other forms of communications over a network in substantially real time." *Id*. at ¶ 17. These systems typically operate through programs installed on user devices (i.e., computers, phones, or tablets) that connect to at least one instant message server. *See id*. at ¶¶ 17-18. Instant

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messaging systems also enable users to communicate with each other in different ways; for

example, users may converse via text or audio messages. *See id.* at ¶¶ 34-35.

A.   The '521 Patent

The '521 Patent, entitled "Content and Context Based Handling of Instant Messages," was

issued on June 14, 2016, and claims a method of processing instant message transactions between

users during an instant messaging session. *See id.* at ¶¶ 15, 23-24 (citing '521 Patent).

The patent has two claims; Ginegar asserts both against Slack. *See* FAC at ¶ 53. The

claims are directed to handling rules—stored on and obtained from an instant message server—

that correspond to certain actions performed in response to receipt of an instant message. *See* '521

Patent at 18:2-26. Claim 1 is independent and recites the following:

> 1. A method of processing instant message transactions comprising:
>
> logging a first instant message client into an instant message server;
>
> obtaining from the instant message server, at least one handling rule that is evaluated in an instant messaging environment in response to receipt of a message, each handling rule defining a condition based upon at least one of identified content or identified context, and a corresponding event handling action to be performed within the instant message environment;
>
> identifying an instant message conversation within the instant message environment between a user and a correspondent;
>
> evaluating each handling rule;
>
> performing the corresponding event handling action of an associated handling rule if it is determined that the condition of that handling rule is satisfied; and
>
> conveying to the user participating in the instant message conversation, an indication that the corresponding event handling action was performed.

Id. at 18:2-22.

The '521 Patent's specification explains that a "handling rule" defines a condition, based

on content and/or context, and a corresponding "handling action" that occurs if that condition is

met. *See id.* at 3:25-32. In other words, when a user receives an instant message, the handling

rules are evaluated, and any corresponding handling action is performed. *See* FAC at ¶ 28. Those

1   actions include "showing another user's online status, filtering instant messages, generating

2   notifications, generating messages, or limiting display screen interruptions." *See id.* at ¶ 29.

3   There are two types of handling rules, based on conditions in the instant messaging

4   environment: (1) rules based on the content detected in an instant message; and (2) rules based on

5   the context of user activity. *See* '521 Patent at 3:7-24. Content-based rules respond to

6   information internal or external to the instant message system, such as designated words in a

7   message. *See id.* at 3:20-24. Context-based rules pertain to events that "characterize user

8   behavior, user activity, environment, setting, hierarchical prioritizations and/or other factors"—for

9   example, detecting when the user is typing on her device by monitoring the number of keystrokes

10 per unit of time. *See id.* at 3:16-19, 12:30-35. For both types of handling rules, once the

11 appropriate condition is satisfied, the corresponding action is performed, and the user is notified

12 that the action occurred. *See id.* at 2:11-16.

13   The instant message system may include a presence and awareness server to "support

14 instant messaging within a collaborative environment." *See id.* at 4:9-16. This server can notify a

15 user's designated contacts when that user is "present" in the instant message system and available

16 for conversation. *See id.* at 4:21-34. The server can also "execute components directed towards

17 other collaborative objectives such as on-line conferencing, paging, person locating and

18 contacting, [and] calendaring." *See id.* at 4:17-21.

19   Claim 2 is dependent on Claim 1 and recites the following:

20
21   2. The method according to claim 1, wherein at least one handling rule is
    autonomically generated based upon a dynamic evaluation of at least one of
    a user or a community of instant message users.

22 *Id.* at 18:23-26. Claim 2 thus recites the limitation of autonomically generating a handling rule in

23 response to instant message transactions within an instant messaging system. *See id.* The patent's

24 specification explains that the instant message server software "may comprise an adaptive and/or

25 autonomic behavior manager for providing dynamic autonomic features for instant message

26 enhancement." *Id.* at 6:66-7:2. For example, the manager may detect that a user quickly closes

27 instant message windows during certain hours of the day but responds to messages during other

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1   hours, and can build a rule predicated on designated time frames. *See id*. at 11:61-12:6.

2   **B.   The '865 Patent**

3   The '865 Patent, entitled "Multi-Modal Transcript Unification in a Collaborative

4   Environment," was issued on September 12, 2017, and claims methods and systems related to

5   multi-modal instant messaging systems, where users can communicate via text and audio in a

6   single chat session. *See* FAC at ¶¶ 31, 33, 36 (citing '865 Patent).

7   The patent has 16 claims; Ginegar asserts Claims 1, 8, and 10 against Slack. *See* FAC at ¶

8   76. The claims all relate to a single instant messaging session between two users that

9   "automatically log[s] a unified chat transcript that contains both audio messages and text

10   messages." *Id*. at ¶¶ 40-42. Claim 1 is directed to a method for generating a transcript that

11   contains both message types exchanged in a session; Claim 10 is directed to a computer program

12   product that essentially performs the method in Claim 1. *See* '865 Patent at Claims 1, 10. Claim 8

13   is directed to a system that contains an instant messenger which maintains the multi-modal session

14   and records the corresponding multi-modal transcript. *See id*. at Claim 8.

15   Claim 1 of the patent is an independent claim and recites the following:

16   1. A method for generating a unified chat transcript for a multi-modal
17   conversation in an instant messaging session, the method comprising:

18   establishing a single instant messaging session between two conversants;

19   receiving text messages as part of a conversation between the two
20   conversants, through the single instant messaging session;

21   embedding in the instant messaging session a voice message received from
                one of the two conversants;

22

23   classifying each one of the embedded voice message and the received text
                messages by type, the type of message being one of a voice message and a
24   text message;

25   determining if the one of the voice and text messages is classified as a voice
                message; and,

26

27   logging the classified voice and text messages in a single transcript of
                conversation between the two conversants occurring in the single instant
28   messaging session in response to determining that the one of the received

1

2   *Id*. at 5:24-44. Creation of the unified transcript is automatically initiated when, after text

3   messages are exchanged, one of the two users participating in the session sends a voice message.

4   *See id*. at 5:29-39. The patent's specification explains that automatically logging the unified chat

5   transcript cures a deficiency in prior instant message systems, which lacked the ability to log

6   multi-modal communication in one conversation. *See id*. at 1:38-43.

7   Claim 8 of the patent is an independent claim and recites the following:

8   8. A collaborative computing data processing system comprising:

9   a processor;

10   an instant messenger configured to maintain a multi-modal instant
            messaging session between first and second conversants; and
11

12   multi-modal transcript unification logic, executing on the processor and
            configured to
13
            establish a single instant messaging session between two conversants,
14

15   receive text messages as part of a conversation between the two
            conversants, through the single instant messaging session,
16

17   embed in the instant messaging session a voice message received from one
            of the two conversants,
18   classify each one of the embedded voice message and the received text
            messages by type, the type of message being one of a voice message and a
19   text message,

20   determine if the one of the voice and text messages is classified as a voice
21   message, and

22   log the classified voice and text messages in a single transcript of
            conversation between the two conversants occurring in the single instant
23   messaging session in response to determining that the one of the voice and
            text messages is classified as a voice message.
24

25   *Id*. at 5:65-6:25. Claim 8 differs from the other two asserted claims in that it claims the elements

26   of a processor, an instant messenger, and a multi-modal transcript unification logic. *See id*.

27   Within this system, the processor executes the logic to effect the method claimed in Claim 1; the

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