UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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IAC SEARCH & MEDIA, INC.,
Petitioner,

v.

MYMAIL, LTD.,
Patent Owner.

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Case IPR2018-00118
Patent 8,275,863 B2

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Before KEVIN F. TURNER, KAMRAN JIVANI, and
MONICA S. ULLAGADDI, *Administrative Patent Judges.*

ULLAGADDI, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

IAC Search and Media, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") for *inter partes* review of claims 1–5, 7–20, 22, and 23 ("the challenged claims") of U.S. Patent No. 8,275,863 B2 (Ex. 1001, "the '863 patent"). Mymail, Ltd. ("Patent Owner") timely filed a Preliminary Response (Paper 7, "Prelim. Resp.").

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

Upon consideration of the Petition, the Petition's supporting evidence, as well as Patent Owner's Preliminary Response and supporting evidence, we are not persuaded Petitioner has established a reasonable likelihood that it would prevail with respect to at least one of the challenged claims. Accordingly, for the reasons that follow, we do not institute an *inter partes* review of the '863 patent as to the challenged claims.

B. Related Proceedings

Petitioner informs us that the '863 patent is asserted in the following pending litigations: *MyMail, Ltd. v. Yahoo!, Inc.*, Case No. 2-16-cv-01000 (E.D. Tex.), filed September 7, 2016 ("*Yahoo!* litigation"); *MyMail, Ltd. v. ooVoo LLC*, Case No. 5:17-cv-04487 (N.D. Cal.); *MyMail, Ltd. v. IAC Search & Media, Inc.*, Case No. 3:17-cv-04488 (N.D. Cal.); and *MyMail, Ltd. v. Yahoo Holdings, Inc.*, Case No. 3-17-cv-03098 (E.D. Tex.). Pet. 1

(citing Exs. 1002–1004, 1028).

Exhibit 1003 is a complaint for infringement in *MyMail, Ltd. v. ooVoo LLC*, Case No. 2-16-cv-01281 (E.D. Tex.), filed November 18, 2016. Exhibit 1004 is a complaint for infringement in *MyMail, Ltd. v. IAC Search & Media, Inc.*, Case No. 2-16-cv-01434 (E.D. Tex.), filed December 20, 2016.

Patent Owner informs us the '863 patent was also asserted in the following litigations: *MyMail, Ltd. v. ESPN, Inc.*, Case No. 2-17-cv-00200 (E.D. Tex.), filed March 14, 2017, terminated June 6, 2017; *MyMail, Ltd. v. Duck Duck Go, Inc.*, Case No. 2-16-cv-01474 (E.D. Tex.), filed December 29, 2016, terminated January 31, 2017; *MyMail, Ltd. v. Panda Distribution, Inc.*, Case No. 2-16-cv-01282 (E.D. Tex.), filed November 18, 2016, terminated April 21, 2017; *MyMail, Ltd. v. Comcast Corp.*, Case No. 2-16-cv-01280 (E.D. Tex.), filed November 18, 2016, terminated October 24, 2017; *MyMail, Ltd. v. Oracle Corp.*, Case No. 2-16-cv-01249 (E.D. Tex.), filed November 9, 2016, terminated December 21, 2016; *MyMail, Ltd. v. Nasdaq, Inc.*, Case No. 2-16-cv-00889 (E.D. Tex.), filed August 10, 2016, terminated December 19, 2016; and *MyMail, Ltd. v. Conduit Ltd.*, Case No. 2-13-cv-00961 (E.D. Tex.), filed November 14, 2013, terminated January 8, 2016. Paper 5, 1–2.

Petitioner further informs us that it filed concurrently a petition for *inter parties review* of a child to the '863 patent, U.S. Patent No. 9,021,070 in the IPR2018-00117 proceeding. Pet. 1. The '863 patent is also the subject of the IPR2017-00967 proceeding, which is presently pending. The '863 patent was also the subject of IPR2015-00269, which was terminated

after institution.

C. The '863 Patent

The '863 patent relates to modifying a toolbar. Ex. 1001, [54]. Figure 16 is reproduced below:
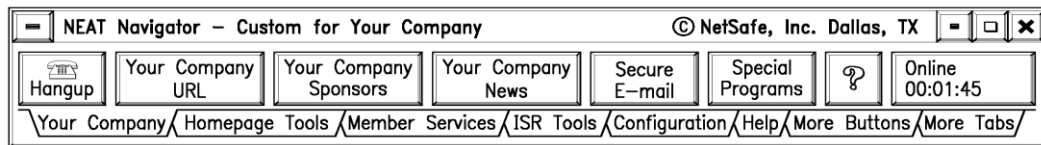

FIG. 16

Figure 16 of the '863 patent illustrates a toolbar According to the '863 patent, information related to updating the toolbar is obtained from button bar database 208, included in user (computer) 110, that stores attributes of the toolbar including: a button title or name; an attribute that enables or disables the function associated with a button; an execution type for the button; a hint that describes the functionality of the button; and an attribute that specifies a file to be executed or uniform resource locator (URL) to be opened when the button is actuated. *Id.* at 9:20–23, 10:38–62. A button can be configured, for example, to "go to the USA Today . . . web site." *Id.* at 10:63–11:4. The '863 patent further discloses how button bar database 208 and an MOT[1] script are used to build a button bar or toolbar according to the specifications of the MOT script. *Id.* at 11:10–13. The '863 patent also discloses a Pinger process that dynamically changes or

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[1] The '863 patent discloses that "MOT is not, however, an acronym for anything meaningful." Ex. 1001, 12:50–51.

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updates a toolbar via database updates to user (computer) 110. *Id.* at 10:15–32.

D. Illustrative Claim

As noted above, Petitioner challenges claims 1–5, 7–20, 22, and 23 of the '863 patent, of which claim 1 is independent. Claim 1 is representative:

1. A method of modifying a toolbar, comprising the steps of:

a user Internet device displaying a toolbar comprising one or more buttons, the toolbar defined by toolbar data stored in one or more toolbar-defining databases, the toolbar data comprising a plurality of attributes, each attribute associated with a button of the toolbar, wherein for each button of the toolbar, at least one of the plurality of attributes identifying a function to be performed when the button is actuated by the user Internet device;

the user Internet device automatically sending a revision level of the one or more toolbar-defining databases to a predetermined network address;

a server at the predetermined network address determining, from the revision level, the user Internet device should receive the toolbar update data;

the user Internet device receiving toolbar update data from the Internet;

the user Internet device initiating without user interaction an operation to update the toolbar data in accordance with the toolbar update data received;

the user Internet device updating, by the operation, the toolbar data in accordance with the toolbar update data, thereby producing updated toolbar data, the updating comprising at least one of the following steps (a) and (b), each respectively comprising:

(a) writing at least one new attribute to the original toolbar data, wherein the writing at least one new attribute to the toolbar

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