



# THINK FORWARD

## Claim Construction Disputes Must Be Decided Before Applying Alice

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September 11, 2019

On August 16, 2019, the Federal Circuit issued a 2-1 decision holding that a lower court erred by adjudicating patent eligibility without resolving the parties' claim construction dispute. See *MyMail, Ltd. v. ooVoo, LLC et al.*, Nos. 2018-1758, 2018-1759 (Fed. Cir. Aug. 16, 2019).

The patents at issue in *MyMail* cover methods for modifying toolbars displayed on Internet-connected devices. In response to defendants' motion for judgment on the pleadings that the patents claim ineligible subject matter, MyMail raised a legal dispute over the proper construction of "toolbar." The district court granted defendants' motions without addressing the parties' claim construction dispute, and without construing "toolbar." The Court found in a split decision that the district court erred.

The majority held that "[d]etermining patent eligibility requires a full understanding of the basic character of the claimed subject matter." Accordingly, "if the parties raise a claim construction dispute at the Rule 12(c) stage, the district court must either adopt the non-moving party's constructions or resolve the dispute to whatever extent is needed to conduct the § 101 analysis." Because the district court never addressed the parties' claim construction dispute, or otherwise construed "toolbar," the Federal Circuit vacated and remanded for further proceedings.

In his dissent, Judge Lourie argued that the facts of the case demonstrate that the parties' claim construction dispute is "little more than a mirage," and the claims at issue are "clearly abstract, regardless of claim construction."

### Implications

This decision provides patentees with another tool to help delay early patent eligibility decisions by raising legal issues over the proper scope of the claims. It is important to note, however, that this decision does not mean that judges must always construe the claims before ruling on patent eligibility—only when the parties raise a dispute. Further, patentees should weigh the relative pros and cons of raising claim construction issues early in a case, as this may come with some risks including putting a stake in the ground without sufficient discovery concerning the accused products.

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