

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

PATENT TRIAL AND APPEAL BOARD

FISERV, INC., JACK HENRY & ASSOCIATES, INC., Q2 SOFTWARE, INC.,
AMERICAN NATIONAL BANK OF TEXAS and HANMI BANK
Petitioner

v .

MIRROR IMAGING LLC
Patent Owner.

COVERED BUSINESS METHOD
REVIEW OF U.S. PATENT NO. 6,963,866

“Method Of Obtaining An Electronically Stored Financial Document”

**PETITION FOR COVERED BUSINESS METHOD REVIEW
OF U.S. PATENT NO. 6,963,866 CHALLENGING
CLAIMS 1-55**

Covered Business Method Review No. CBM2018-00014

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LIST OF EXHIBITS

EXHIBIT NO.	DESCRIPTION
Ex. 1001	U.S. Patent No. 6,963,866, entitled “Method Of Obtaining An Electronically Stored Financial Document”
Ex. 1002	File History of U.S. Patent Application No. 14/857,854
Ex. 1003	File History of U.S. Patent Application No. 09/548,490
Ex. 1004	File History of U.S. Patent Application No. 13/272,936
Ex. 1005	File History of U.S. Patent Application No. 12/902,973
Ex. 1006	File History of U.S. Patent Application No. 10/104,541
Ex. 1007	File History of U.S. Patent Application No. 11/202,790
Ex. 1008	File History of U.S. Patent Application No. 12/489,087
Ex. 1009	File History of U.S. Patent Application No. 13/840,892
Ex. 1010	USPTO Subject Matter Eligibility Guidelines, July 2015 Update, <i>available at</i> https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf
Ex. 1011	Joint Claim Construction Chart, <i>Mirror Imaging LLC v. Suntrust Banks, Inc.</i> , Case No. 2:08-cv-00295-DF, Dkt. No. 191-2, (E.D. Tex. Feb. 16, 2010)
Ex. 1012	Complaint, <i>Mirror Imaging LLC v. Austin Bancorp, Inc., et al.</i> Case No. 2:17-cv-00539-JRG, Dkt. No. 1, (E.D.Tex. July 16, 2017)
Ex. 1013	Claim Construction Order, <i>Mirror Imaging LLC v. Affiliated Computer Services, Inc., et al.</i> , Case No. 2:02-cv-73629-RHC, Dkt. No. 55, Claim Construction Order at pp. 18-19 (E.D. MI Feb. 26, 2004)
Ex. 1014	Patent Owner’s Claim Chart, <i>Mirror Imaging LLC v. Austin Bancorp, Inc., et al.</i> , Case No. 2:17-cv-00539-JRG, Dkt. No. 1, (E.D.Tex. July 16, 2017) <u>(Confidential-For Parties and Board Only)</u> .
Ex. 1015	Robert Hudson, <i>Finding Your Ancestors at the Troy Public Library</i> , Troy Public Library http://www.thetroylibrary.org/pdf/FindAncestors.pdf (February 1993)
Ex. 1016	Declaration, <i>Mirror Imaging LLC v. Affiliated Computer Services, Inc., et al.</i> , Case No. 2:02-cv-73629-RHC, Dkt. No. 48, (E.D. MI Oct. 21, 2003)

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Ex. 1017	Declaration of Donald Kenneth Hobday, Jr.
Ex. 1018	Reserved
Ex. 1019	Reserved
Ex. 1020	License Agreement [Redacted]
Ex. 1021	William R. Michalson CV.
Ex. 1022	Declaration of William R. Michalson
Ex. 1023	Online Computer Library Center, <i>Together We Make Breakthroughs Possible</i> , available at http://www.oclc.org/en/about.html
Ex. 1024	Society of American Archivists, microfiche, available at https://www2.archivists.org/glossary/terms/m/microfiche
Ex. 1025	Online Computer Library Center, <i>Dewey Decimal Classification summaries</i> , available at https://www.oclc.org/en/dewey/features/summaries.html
Ex. 1026	Online Computer Library Center, <i>Furthering Access to The World's Information for 30 Years</i> , (1997).
Ex. 1027	U.S. Patent No. 6,349,373 to Sitka, <i>et al.</i>
Ex. 1028	U.S. Patent No. 6,192,165 to Irons.
Ex. 1029	U.S. Patent No. 5,784,610 to Copeland, <i>et al.</i>
Ex. 1030	Muller, <i>Computerized Document Imaging Systems</i> , Artech House, Inc. (1993)
Ex. 1031	D'Alleyrand, <i>Networks and Imaging Systems in a Windowed Environment</i> , Artech House, Inc. (1996)
Ex. 1032	Robek, <i>Information and Records Management</i> , Glencoe/McGraw-Hill, Inc. (4 th ed. 1995)
Ex. 1033	Green, <i>Introduction to Electronic Document Management Systems</i> , Academic Press, Inc. (1993)
Ex. 1034	<i>Systems Analysis of Medical Records in Georgia</i> , Georgia Institute of Technology and Westinghouse Electric Corporation, Volume 1, September 1971
Exs. 1035-1039	Reserved
Ex. 1040	Declaration of Craig Morgan.
Ex. 1041	Complaint, <i>Mirror Imaging LLC v American National Bank of Texas</i> , Case No. 2:17-cv-00653-JRG, Dkt. No. 1, (E.D.Tex. Sept. 20, 2017)
Ex. 1042	Complaint, <i>Mirror Imaging LLC v Independent Bank Group</i> , Case No. 2:17-cv-00540-JRG, Dkt. No. 1, (E.D.Tex. July 16, 2017)

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Ex. 1043	Complaint, <i>Mirror Imaging LLC v LegacyTexas Group, Inc.</i> , Case No. 2:17-cv-00541-JRG, Dkt. No. 1, (E.D.Tex. July 16, 2017)
Ex. 1044	Complaint, <i>Mirror Imaging LLC v Southside Bank</i> , Case No. 2:17-cv-00543-JRG, Dkt. No. 1, (E.D.Tex. July 16, 2017)
Ex. 1045	Complaint, <i>Mirror Imaging LLC v Green Bancorp, Inc.</i> , Case No. 2:17-cv-00563-JRG, Dkt. No. 1, (E.D.Tex. Aug. 1, 2017)
Ex. 1046	Complaint, <i>Mirror Imaging LLC v Texas Bank and Trust Company</i> , Case No. 2:17-cv-00568-JRG, Dkt. No. 1, (E.D.Tex. Aug. 1, 2017)
Ex. 1047	Complaint, <i>Mirror Imaging LLC v IBERIABANK Corporation</i> , Case No. 2:17-cv-00581-JRG, Dkt. No. 1, (E.D.Tex. Aug. 9, 2017)
Ex. 1048	Complaint, <i>Mirror Imaging LLC v City Bank</i> , Case No. 2:17-cv-00596-JRG, Dkt. No. 1, (E.D.Tex. Aug. 22, 2017)
Exs. 1049-1051	Reserved
Ex. 1052	Product License and Services Agreement between Jack Henry & Associates and American National Bank of Texas [Redacted]
Exs. 1053-1062	Reserved
Ex. 1063	Indemnity Agreement between Jack Henry & Associates and American National Bank of Texas
Ex. 1064	Indemnity Agreement between Jack Henry & Associates and Independent Bank Group
Ex. 1065	Indemnity Agreement between Jack Henry & Associates and LegacyTexas Group, Inc.
Ex. 1066	Indemnity Agreement between Jack Henry & Associates and Southside Bank
Ex. 1067	Indemnity Agreement between Jack Henry & Associates and Green Bancorp, Inc.
Ex. 1068	Indemnity Agreement between Jack Henry & Associates and Texas Bank and Trust Company
Ex. 1069	Indemnity Agreement between Jack Henry & Associates and IBERIABANK Corporation
Ex. 1070	Indemnity Agreement between Jack Henry & Associates and City Bank
Exs. 1071-1073	Reserved
Ex. 1074	Declaration of Barry Benton
Ex. 1075	Complaint, <i>Mirror Imaging LLC v Hanmi Bank</i> , Case No. 2:17-

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	cv-00598-JRG, Dkt. No. 1, (E.D.Tex. Aug. 22, 2017)
Ex. 1076	Services Agreement between Q2 Software, Inc. and Hanmi Bank [Redacted] <u>(Confidential-For Parties and Board Only)</u> .
Ex. 1077	Agreement to Defend between Q2 Software, Inc. and Hanmi Bank <u>(Confidential-For Parties and Board Only)</u> .

1. **INTRODUCTION**

Pursuant to 35 U.S.C. § 321, § 18 of the Leahy-Smith America Invents Act, and 37 C.F.R. § 42.300 *et seq.*, Fiserv, Inc. (“Fiserv”), Jack Henry & Associates, Inc. (“Jack Henry”), Q2 Software, Inc. (“Q2”), American National Bank of Texas (“ANBTX”), and Hanmi Bank (“Hanmi”) (collectively, “Petitioner”) respectfully request that the Board institute a transitional post-grant review proceeding for covered business method patents for the challenged claims of U.S. Patent No. 6,963,866 (the “’866 Patent”) (Ex. 1001).

The claims of the ’866 Patent are solely directed to the long well-known abstract idea of simply storing and retrieving a financial document based on extremely basic information regarding the document (*e.g.*, the date of the document). Ex. 1022 at ¶50. This simple and age-old concept is a fundamental, long-standing, and well-known practice that is ineligible subject matter under Section 101. *See Bilski v. Kappos*, 561 U.S. 293, 310-12 (2010). Incorporating generic computer components to facilitate such basic storage and retrieval of electronically-stored financial documents does not and cannot convert the abstract idea into patentable subject matter. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2358 (2014). Indeed, the ’866 Patent concedes that techniques and computer components for storing, accessing, and retrieving financial documents from storage systems were well-known and conventional at the time of the alleged

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invention. Ex. 1022 at ¶50. Nothing in the claims of the '866 Patent renders the abstract idea patentable.

Petitioner respectfully requests that the Board institute a Covered Business Method (“CBM”) proceeding and find Claims 1-55 of the '866 Patent unpatentable, as they simply encompass abstract ideas contrary to 35 U.S.C. § 101.

2. MANDATORY NOTICES

A. Real Party-in-Interest.

In accordance with 37 C.F.R. § 42.8(b)(1), Petitioner states that the real parties-in-interest are Fiserv, Jack Henry, Q2, ANBTX and Hanmi.

B. Related Matters.

The following USPTO and district court proceedings are related matters pursuant to 37 C.F.R. § 42.8(b)(2):

Date	Case Name	Docket Number
01/11/18	PTAB Post-Grant Review of U.S. Patent No. 9,141,612	CBM2018-00015
01/10/18	PTAB Post-Grant Review of U.S. Patent No. 7,836,067	CBM2018-00016
01/10/18	PTAB Post-Grant Review of U.S. Patent No. 7,552,118	CBM2018-00017
10/05/17	PTAB Post-Grant Review of U.S. Patent No. 9,141,612	CBM2017-00067
10/04/17	PTAB Post-Grant Review of U.S. Patent No. 7,836,067	CBM2017-00066
10/02/17	PTAB Post-Grant Review of U.S. Patent No. 7,552,118	CBM2017-00065
10/02/17	PTAB Post-Grant Review of U.S. Patent	CBM2017-

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	No. 6,963,866	00064
09/18/15	Examination of U.S. Patent Application Serial No. 14/857,854	U.S. Pat. App. Ser. No. 14/857,854
09/20/17	Mirror Imaging LLC v. American National Bank of Texas	2-17-cv-00653
09/20/17	Mirror Imaging LLC v. Benchmark Bank	2-17-cv-00654
09/20/17	Mirror Imaging LLC v. Guaranty Bank & Trust, NA	2-17-cv-00655
09/20/17	Mirror Imaging LLC v. North Dallas Bank & Trust Co.	2-17-cv-00656
09/20/17	Mirror Imaging LLC v. Third Coast Bancshares, Inc., et al.	2-17-cv-00657
08/22/17	Mirror Imaging LLC v. BTH Bank, National Association, et al.	2-17-cv-00595
08/22/17	Mirror Imaging LLC v. City Bank	2-17-cv-00596
08/22/17	Mirror Imaging LLC v. East West Bank	2-17-cv-00597
08/22/17	Mirror Imaging LLC v. Hanmi Bank	2-17-cv-00598
08/22/17	Mirror Imaging LLC v. Texas Capital Bank, NA	2-17-cv-00599
08/09/17	Mirror Imaging LLC v. AFNB Holdings, Inc., et al.	2-17-cv-00578
08/09/17	Mirror Imaging LLC v. Bank of the Ozarks, Inc., et al	2-17-cv-00579
08/09/17	Mirror Imaging LLC v. Cathay General Bancorp, et al.	2-17-cv-00580
08/09/17	Mirror Imaging LLC v. IBERIABANK Corporation	2-17-cv-00581
08/09/17	Mirror Imaging LLC v. Regions Financial Corporation, et al.	2-17-cv-00582
08/01/17	Mirror Imaging LLC v. Green Bancorp, Inc., et al.	2-17-cv-00563
08/01/17	Mirror Imaging LLC v. Inwood Bancshares, Inc., et al.	2-17-cv-00564
08/01/17	Mirror Imaging LLC v. Origin Bancorp, Inc., et al.	2-17-cv-00565
08/01/17	Mirror Imaging LLC v. PlainsCapital Bank	2-17-cv-00566
08/01/17	Mirror Imaging LLC v. Texas Bank and	2-17-cv-00568

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	Trust Company	
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07/16/17	Mirror Imaging LLC v. Independent Bank Group, Inc., et al.	2-17-cv-00540
07/16/17	Mirror Imaging LLC v. LegacyTexas Group, Inc., et al.	2-17-cv-00541
07/16/17	Mirror Imaging LLC v. Prosperity Bancshares, Inc., et al.	2-17-cv-00542
07/16/17	Mirror Imaging LLC v. Southside Bank	2-17-cv-00543
06/19/17	Mirror Imaging LLC v. BOKF NA	2-17-cv-00507
06/19/17	Mirror Imaging LLC v. First National Bank of Omaha	2-17-cv-00508
06/19/17	Mirror Imaging LLC v. First National Bank Texas	2-17-cv-00509
07/29/08	Mirror Imaging LLC v. Suntrust Banks, Inc., et al.	2-08-cv-00295
09/11/02	Mirror Imaging LLC v. Affiliated Computer Services, Inc., et al.	2-02-cv-73629

C. Lead and Back-Up Counsel.

Pursuant to 37 C.F.R. § 42.8(b)(3), Petitioner identifies its lead counsel and back-up counsel below:

Lead Counsel	Back-Up Counsel
David A. Roodman (Reg. No. 35,663) daroodman@bryancave.com Bryan Cave LLP One Metropolitan Square 211 N. Broadway, Suite 3600 St. Louis, MO 63102-2750 Phone: (314) 259-2661 <i>Counsel for Fiserv, Inc.</i>	Nick Williamson (<i>Pro Hac Vice</i>) nick.williamson@bryancave.com Bryan Cave LLP One Metropolitan Square 211 N. Broadway, Suite 3600 St. Louis, MO 63102-2750 Phone: (314) 259-2661 <i>Counsel for Fiserv, Inc.</i>

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	<p>Henry Petri, Jr. (Reg. No. 33,063) hpetri@polsinelli.com Polsinelli PC 1401 Eye (“I”) Street, N.W. Suite 800 Washington, DC 20005 Phone: (202) 783-3300 <i>Counsel for Jack Henry & Associates, Inc. and American National Bank of Texas</i></p>
	<p>James Murphy (Reg. No. 55,474) jpmurphy@polsinelli.com Polsinelli PC 1000 Louisiana Street, 53rd Floor Houston, TX 77002 Phone: (713) 374-1631 <i>Counsel for Jack Henry & Associates, Inc. and American National Bank of Texas</i></p>
	<p>Jeff Cole (Reg. No. 56,052) jeff.cole@dlapiper.com DLA Piper LLP (US) 401 Congress Avenue Ste 2500 Austin, TX 78701 Phone: (512) 457-7035 <i>Counsel for Q2 Software, Inc. and Hanmi Bank</i></p>
	<p>Aaron Fountain (<i>Pro Hac Vice</i>) aaron.fountain@dlapiper.com DLA Piper LLP (US) 401 Congress Avenue Ste 2500 Austin, TX 78701 Phone: (512) 457-7190 <i>Counsel for Q2 Software, Inc. and Hanmi Bank</i></p>

D. Service Information.

Petitioner identifies the following service information, pursuant to 37 C.F.R. § 42.8(b)(4):

David A. Roodman
daroodman@bryancave.com
Bryan Cave LLP
One Metropolitan Square
211 N. Broadway, Suite 3600
St. Louis, MO 63102-2750
Phone: (314) 259-2614
Fax: (314) 259-2020

3. PAYMENT OF FEES PURSUANT TO 37 C.F.R. § 42.15.

An electronic payment in the amount of \$60,750.00 for the post-grant review fee specified by 37 C.F.R. § 42.15(b)—comprising the \$12,000.00 request fee—plus \$250.00 for 35 additional claims in excess of 20—and \$18,000.00 post-institution fee—plus \$550.00 for 40 additional claims in excess of 15—is being paid at the time of filing this petition. If there are any additional fees due in connection with the filing of this paper, please charge the required fees to Deposit Account No. 024467.

4. OVERVIEW OF THE '866 PATENT.

The '866 Patent was filed as U.S. Patent Application Serial No. 10/104,541 on March 22, 2002, and claims priority to April 13, 1999 through a series of U.S. patents and provisional applications:

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Priority App. No.	Priority Claim	Filing Date	Status
09/548,490	Continuation	April 13, 2000	U.S. Pat. No. 6,446,072
60/129,021	Provisional	April 13, 1999	-

Additionally:

- U.S. Patent No. 7,552,118 (“the ’118 Patent”) is a continuation of the ’866 Patent;

- U.S. Patent No. 7,836,067 (“the ’067 Patent”) is a continuation of the ’118 Patent;

- Abandoned U.S. Patent Application Serial No. 12/902,973 (“the ’973 Application”), filed on October 12, 2010, was a continuation of the ’067 Patent;

- Abandoned U.S. Patent Application Serial No. 13/272,936 (“the ’936 Application”), filed on October 13, 2011, was a continuation of the ’973 Application;

- Abandoned U.S. Patent Application Serial No. 13/838,554 (“the ’554 Application”), filed on March, 15, 2013, is likely a continuation of the ’936 Application;

- U.S. Patent No. 9,141,612 (“the ’612 Patent”) is a continuation of the ’936 Application; and

● U.S. Patent Application Serial No. 14/857,854 (“the ’854 Application”), filed on September 18, 2015, is a continuation of the ’612 Patent.

A. The Specification.

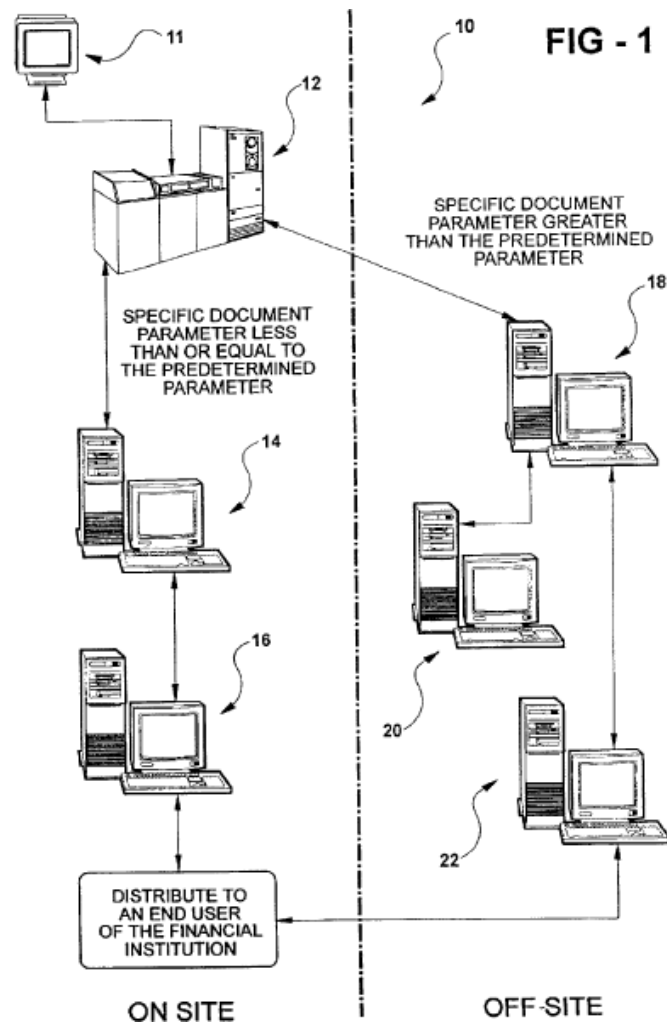
The ’866 Patent merely describes the age-old concept of storing and retrieving financial documents in storage systems using basic, common, and standard document information. Ex. 1022 at ¶42.

According to the specification of the ’866 Patent, financial institutions, banks, and credit unions would store financial documents such as paid checks, account statements, and other related documents in on-site or off-site storage systems, or both. Ex. 1001 at 1:21-32. The ’866 Patent alleges that a problem existed in the way financial institutions interfaced with on-site and off-site storage systems. Specifically, while on-site and off-site storage systems were admittedly well known, the alleged inventors contend that financial institutions failed to *directly* interface with both the on-site and off-site storage systems. Ex. 1001 at 2:6-13. According to the ’866 Patent, this rendered off-site storage inefficient and prohibited financial institutions from outsourcing storage to third-parties. Ex. 1001 at 2:21-33.

The ’866 Patent purports to solve this alleged deficiency by using a simple known “parameter” to regulate document storage and retrieval (whether via on or off-site facilities). Ex. 1022 at ¶43-44. As illustrated by Figure 1 of the ’866

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Patent, below, the alleged invention merely uses common computer components to apply the abstract concept of storing and recalling financial documents based upon fundamental document information – a so-called “document parameter.” What the patent refers to as a parameter may simply be, for example, a known “numerical sequence” (Claim 12), the “age” of the document (Claim 13), a “pre-selected date” (Claim 14), or an “account number” (Claim 15) – all common and known parameters to identify a document.



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The '866 Patent explains that whether a parameter is greater or less than a predetermined value determines which storage should house the financial document. Ex. 1001 at 4:41-51. For example, documents older than a certain date may go to off-site storage, while newer documents may be stored on-site.

The alleged invention's retrieval of financial documents is just as trivial, and equally abstract. Ex. 1022 at ¶45. When a financial institution receives a request for a financial document, a *financial institution employee* simply compares the financial document's "parameter" to a predetermined value. Ex. 1001 at 2:54-59, 6:39-7:3. That the '866 Patent openly concedes that its "comparing" step is a mental process performed by "a bank employee, such as a bank teller," further illustrates that the '866 Patent merely encompasses an abstract, mental-process. *Id.*^{1/}

^{1/} Patent Owner also admits, in its sole claim chart provided to-date in the litigation styled *Mirror Imaging LLC v. Austin Bancorp, Inc., et al.*, No. 2:17-cv-00539 (E.D. Tex.), that Petitioner allegedly infringes the related '612 Patent because one or more steps are performed manually by "customer service." Ex. 1014, Claim Chart, pp. 4-5 **(Confidential-For Parties and Board Only)**; *see also* Ex. 1013, *Mirror Imaging LLC v. Affiliated Computer Services, Inc., et al.*, Case

Just as the documents are stored, if the parameter is greater than a value, the employee accesses one storage location for document retrieval; if the parameter is less than or equal to the predetermined value, the employee accesses a second storage for document retrieval. Ex. 1001 at 2:62-3:5; Ex. 1022 at ¶46. After the document is retrieved, the document is then available for use by the financial institution or its customers/members. Ex. 1001 at 3:6-9.

According to the '866 Patent, one of the claimed storage locations is preferably located at the financial institution bank, and the other storage is located remotely. Ex. 1001 at 3:58-60. Allegedly, the remote location allows a third-party to manage (off-site) storage of financial documents. Ex. 1001 at 3:60-63; Ex. 1022 at ¶47.

Tellingly, the '866 Patent does not disclose any novel storage media, does not claim any specific software, and does not purport to improve actual on or off-site storage in any manner. Ex. 1022 at ¶48; *see* Ex. 1001 at 2:21-28. Rather, the alleged solution offered by the '866 Patent is only to use well-known generic computer components (*i.e.*, storage media, central processing units, and computer terminals) as they are commonly used, in combination with human activity, to

simply store and retrieve financial documents in one of two places using conventional and routine information well-known in the prior art. Ex. 1022 at ¶48; Ex. 1001 at 1:21-37, 6:28-38.

The '866 Patent also offers no technological improvement in or advancement to any interfaces that link the storage locations to a financial institution. Ex. 1022 at ¶49. Rather, according to the '866 Patent, the interfaces employed in the patent are nothing more than common and ordinary displays for inputting information used to retrieve a financial document. Ex. 1001 at 1:43-48. The '866 Patent merely enumerates unpatentable data fields for identifying financial documents, and wholly fails to disclose any technical details about the interfaces. Ex. 1022 at ¶49. For example, while the '866 Patent purports to enable a financial institution to bypass on-site storage and “directly” retrieve financial documents from off-site storage, it lacks any disclosure concerning *how* that direct link is allegedly achieved, *what* novel hardware or software (if any) comprises the interface that facilitates a direct link, or *how* the interface specifically differs or in any way is an improvement upon known prior art interfaces. Ex. 1001 at 2:21-28, 7:32-33; *see also* Ex. 1015, Ex. 1025, Ex. 1026, Ex. 1034.

Indeed, the '866 Patent admits that the use of on-site storage systems – including for financial documents -- was not new at the time of the alleged invention. Ex. 1001 at 2:6-7, 18-20; Ex. 1022 at ¶50. Nor was the use of off and

on-site storage systems, or the ability to store or retrieve documents in two locations, new at the time. *Id.* Beyond referencing generic, well-known computer components (*i.e.*, storage media, computer terminals, processing units), the '866 Patent is simply directed to an unpatentable and known method of storing and retrieving financial documents based on information that is basic and inherent to each financial document. Ex. 1022 at ¶50. Applying the known method of using computers and dressing up the basic document search term as a “parameter” does not and cannot confer patentability. Not only do the claims seek to patent nothing more than well-worn abstract ideas, as explained further below, all of the claimed features and limitations in the '866 Patent were well known and conventional in the art at the time of the alleged invention.

B. The Claims.

The specification and claims of the '866 Patent comprise nothing more than the abstract idea of storing and retrieving financial documents in one of two places based upon well-known and inherent document characteristics, such as the date or age of the document. Independent Claims 1, 23 & 45, the sole independent claims, are reproduced below. As highlighted in *italics* below, every claim is directed to financial activities.

	CLAIM 1	CLAIM 23	CLAIM 45
	A method of obtaining an electronically-stored	A method for a <i>financial institution</i> to	A method for a <i>financial institution</i> to

	CLAIM 1	CLAIM 23	CLAIM 45
	<p><i>financial document</i> from a first storage system remotely-located from a second storage system wherein the first and second storage systems each include <i>a plurality of financial documents</i> stored therein and wherein each of the <i>financial documents</i> include at least one specific document parameter, said method comprising the steps of:</p>	<p>obtain a stored <i>financial document</i> from an off-site storage system remotely-located from an on-site storage system wherein the <i>financial document</i> includes at least one specific document parameter with the specific document parameter being defined as a specific document age, said method comprising the steps of:</p>	<p>obtain a stored <i>financial document</i> from an off-site storage system remotely-located from an on-site storage system wherein the <i>financial document</i> includes at least one specific document parameter with the specific document parameter being defined as a specific document age, said method comprising the steps of:</p>
[A]			<p>providing an outsourcing institution associated with the off-site storage system and a requestor;</p>
[B]			<p>associating the <i>financial institution</i> with the on-site storage system wherein the outsourcing institution, requestor, and <i>financial institution</i> are different from each other;</p>
[C]	<p>storing a plurality of <i>financial documents</i> in a first fixed medium at the first storage system when the specific <i>document parameter of the financial</i></p>	<p>maintaining the <i>financial document</i> in the off-site storage system when the specific document age of the financial document is greater</p>	<p>maintaining the <i>financial document</i> with the outsourcing institution in the off-site storage system when the specific document age of the</p>

	CLAIM 1	CLAIM 23	CLAIM 45
	<i>document</i> is greater than a predetermined parameter;	than a predetermined age;	financial document is greater than a predetermined age;
[D]	storing a plurality of <i>financial documents</i> in a second fixed medium at the second storage system when the <i>specific document parameter of the financial document</i> is less than or equal to the predetermined parameter;	maintaining the <i>financial document</i> in the on-site storage system when the specific document age of the <i>financial document</i> is less than or equal to the predetermined age	maintaining the <i>financial document</i> with the <i>financial institution</i> in the on-site storage system when the specific document age of the <i>financial document</i> is less than or equal to the predetermined age;
[E]	utilizing a computer terminal connected to the first and second storage systems through a processing unit;	utilizing a computer terminal associated with the <i>financial institution</i> and connected to the off-site and on-site storage systems through a processing unit;	utilizing a computer terminal located at the <i>financial institution</i> and connected to the off-site and on-site storage systems through a processing unit;
[F]	receiving a request for at least one of the stored <i>financial documents</i> ;	receiving a request for the <i>financial document</i> ;	receiving a request from the requestor for the <i>financial document</i> at the <i>financial institution</i> ;
[G]	inputting the request into the computer terminal;	inputting the request into the computer terminal;	inputting the request into the computer terminal at the <i>financial institution</i> after the request is received;
[H]	comparing the specific document parameter of the requested <i>financial document</i> to the predetermined	comparing the specific document age of the requested <i>financial document</i> to the predetermined age to	comparing the specific document age of the requested <i>financial document</i> to the predetermined age to

	CLAIM 1	CLAIM 23	CLAIM 45
	parameter to determine if the specific document parameter is greater than, less than, or equal to the predetermined parameter after the request has been inputted;	determine if the specific document age is greater than, less than, or equal to the predetermined age after the request has been inputted;	determine if the specific document age is greater than, less than, or equal to the predetermined age after the request has been inputted;
[I]	automatically accessing the first storage system through the processing unit when the specific document parameter is greater than the predetermined parameter and automatically accessing the second storage system through the processing unit when the specific document parameter is less than or equal to the predetermined parameter; and	automatically accessing the off-site storage system through the processing unit when the specific document age is greater than the predetermined age and automatically accessing the on-site storage system through the processing unit when the specific document age is less than or equal to the predetermined age; and	automatically accessing the off-site storage system through the processing unit when the specific document age is greater than the predetermined age and automatically accessing the on-site storage system through the processing unit when the specific document age is less than or equal to the predetermined age; and
[J]	retrieving the requested <i>financial document</i> , as defined by the inputted request, in the first fixed medium when the specific document parameter is greater than the predetermined parameter and in the second fixed medium when a specific	automatically retrieving the requested <i>financial document</i> from the accessed storage system as defined by the inputted request.	automatically retrieving the requested <i>financial document</i> from the accessed storage system as defined by the inputted request.

	CLAIM 1	CLAIM 23	CLAIM 45
	document parameter of the <i>financial document</i> is less than or equal to the predetermined parameter.		

C. The Prosecution Histories.

The '866 Patent claims priority to April 13, 1999 through a continuation (the '072 Patent) and a provisional application. The '072 Patent issued on September 3, 2002, and the '866 Patent issued on November 8, 2005, long before the Supreme Court's *Alice* decision.

The USPTO has rejected the claims of the related pending '854 application under 35 U.S.C. § 101 as the claims are, just as the '866 Patent, directed to nothing more than the abstract idea of storing and obtaining a financial document from one of two storage systems based on the document's basic characteristics. Ex. 1002 at p. 142 ("Claims 23-29 and 31-43 are directed to the abstract idea of obtain[ing] electronically-stored financial documents from an off-site storage system remotely-located from an on-site storage system by storing, receiving, comparing, accessing, retrieving and providing electronic image of the financial document . . .").

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The following is a brief summary of the prosecution histories for the parent of the '866 Patent, and each descendant patent and application:^{2/}

The '072 Patent: The application for the '072 Patent was filed on April 13, 2000. Ex. 1003 at p. 22. During prosecution of this application, Applicant repeatedly argued that the prior art failed to identify the claimed “comparing” step. Ex. 1003, p. 83 (argument regarding U.S. Patent No. 5,784,610 to Copeland *et al.*); Ex. 1003, pp. 83-84 (argument regarding U.S. Patent No. 5,819,300 to Kohno *et al.*); Ex. 1003 at p. 131 (argument regarding U.S. Patent No. 5,783,808 to Josephson); Ex. 1003 at p. 132 (argument regarding U.S. Patent No. 6,029,175 to Chow).

Applicant’s focus on the “comparing” step was not limited to only the application for the '072 Patent. Notwithstanding that the disclosures teach that the “comparing” step is performed by a person (*i.e.*, “a bank employee, such as a bank teller,” Ex. 1001, 6:51-53; 7:4-5), the USPTO, then unarmed with the *Alice* decision, allowed this first patent in the '866 Patent’s family to issue.

^{2/} This summary does not address the '973 Application and '936 Application, each of which was deemed abandoned due to Applicant’s failure to respond to an Office Action. Ex. 1004 at p. 1; Ex. 1005 at p. 1. Further, the '554 Application’s prosecution history is not available for public inspection.

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The U.S. Supreme Courts *Alice* ruling had not issued when the application for the '866 Patent was pending, and there is no discussion of patent ineligibility in the file history.

The '866 Patent: The application for the '866 Patent was filed on March 22, 2002 and, through amendments, the Applicant cancelled and added certain claims, amended the claims to replace the term “computer terminal” with “processing unit,” and amended the specification to recite a “first or off-site storage” and a “second or on-site storage.” Ex. 1006 at pp. 91-108, 129-137, 140, and 143.

Of course, given the timing of the case, the unpatentability of the claims as abstract under *Alice* was not considered. The Examiner ultimately allowed the claims stating in the Notice of Allowance that the determination of allowability was based upon the simple limitations of “comparing the specific document parameter of the requested financial document to the predetermined parameter” to determine whether the parameter is greater than or less than a predefined parameter and “automatically accessing the first [or second] storage system through the processing [unit] when the specific document parameter” is greater than or less than the predetermined value. Ex. 1006 at pp. 19-20.

The '118 Patent: The application for the '118 Patent was filed on August 12, 2005 and, like the earlier application for the '866 Patent, both: (i) unpatentability under *Alice* was not considered, given the timing of the application;

and (ii) the “comparing” step again provided the USPTO with a purported basis for the Notice of Allowance. Ex. 1007 at pp. 23-24.

The ’067 Patent: The application for the ’067 Patent was filed on June 22, 2009. During prosecution, Applicant made several amendments to the claims including to “clarify differences” in scope by specifying that the step of utilizing the computer terminal is “through a user.” Ex. 1008 at pp. 89-105. As with the other cases, the unpatentability of the claims as abstract under *Alice* was not considered. And, again, the “comparing” step was again relied upon and cited by the USPTO in its Notice of Allowance. Ex. 1008 at p. 20.

The ’612 Patent: The application for the ’612 Patent was filed on March 15, 2013. Following various amendments, on May 21, 2015 the Examiner issued a Notice of Allowance that, yet again, focused on the claimed “comparing” step. Ex. 1009 at p. 44.

While the USPTO had issued interim guidance on patent subject matter eligibility in 2014 in view of *Alice* and *Mayo*, at the time of the Notice of Allowance, the USPTO had not yet issued its July 2015 and May 2016 updates on subject matter eligibility. The July 2015 update provided guidance on identifying abstract ideas under the first prong of the *Alice* framework, and synthesized the case law to identify “concepts relating to processes of organizing information that can be performed mentally abstract, such as using categories to organize, store and

transmit information (*Cyberfone*), data recognition and storage (*Content Extraction*), and organizing information through mathematical correlations (*Digitech*).” Ex. 1010 at p. 5. Thus, the Examiner did not yet have the requisite USPTO guidance which would have assisted the Examiner in finding the claimed concepts as abstract.

The ’854 Application: The ’854 Application was filed on September 18, 2015. In a first Office Action Pre-Interview communication, mailed July 19, 2017, the Examiner rejected the claims under, *inter alia*, 35 U.S.C. § 101 as directed to the abstract idea of obtaining electronically-stored financial documents from an off-site storage system remotely-located from an on-site storage system by storing, receiving, comparing, accessing, retrieving and providing electronic images of the financial document. Ex. 1002 at p. 142. The Examiner found the concepts analogous to those of data recognition and storage that were found abstract in *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343 (Fed. Cir. 2014) and, further, the concepts of remotely accessing and retrieving user specified information in *Intellectual Ventures I LLC v. Erie Indem. Co.*, 121 USPQ2d 1928 (Fed. Cir. 2017). Ex. 1002 at 142.

In issuing the refusal, the Examiner explained that the claims do not include limitations that are “significantly more” than the abstract idea because the claims do not include an improvement to another technology or technical field, an

improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment. *Id.*

According to the Interview Agenda appended to the Applicant's Reply, the Applicant (*i.e.*, Patent Owner here) appears to have argued that the claims are patent eligible because they purportedly provide a technological solution (*e.g.*, efficient accessibility and low expenses for retrieving financial documents from storage) for solving a technological problem (*e.g.*, no interface independently inter-linked with the off-site storage system). Ex. 1002 at pp. 112-124.

The Examiner maintained the rejection in a Final Office Action dated October 30, 2017 (Ex. 1002 at 32-43), "[n]o agreement was reached" during an Examiner-Applicant interview on November 28, 2017 (Ex. 1002 at 4-5), Applicant filed a Request for Continued Examination on December 4, 2017 (Ex. 1002 at 7-8, 19-29), and the applied-for claims of the '854 Application properly stand rejected.

5. GROUND FOR STANDING.

A. The '866 Patent Is Eligible For Covered Business Method Review.

A patent is eligible for CBM review if one or more of its claims are directed to "financial activity," and not directed towards a "technological innovation." AIA § 18(d)(1); *see also* 37 C.F.R. § 42.301(a); Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,734, 48,736 (Aug. 14, 2012).

The '866 Patent meets both prongs of this standard. As set forth above, the challenged claims of the '866 Patent recite limitations that are expressly directed to financial activity, including “financial institutions” and “financial documents.” None of the claims are directed to a “technological innovation.”

i. The Claims Of The '866 Patent Are Directed To A “Financial Activity.”

Here, multiple claims indisputably include several financial activity limitations. Ex. 1022 at ¶¶51-55. For example, Independent Claims 1, 23 & 45 expressly require storing, requesting, and retrieving “financial documents.” Moreover, Independent Claims 23 & 45 require “financial institutions.” The dependent claims are also directed to “financial activity” including, for example, those that recite an “account number” (Claim 15), a “check number” (Claim 16), a “payment date” (Claim 17), a “monetary amount” (Claim 18), and “distributing the reproduced financial document to a financial institution based on routing codes” (Claims 20, 31, 55). Each and every challenged claim independently meets the criteria for “financial activity.” Ex. 1022 at ¶¶51-55.

- (1) All claims are directed to a “financial activity” as they require storing, requesting, and retrieving “financial documents.”

To be CBM eligible, a claim “need only require one of a ‘wide range of finance-related activities.’” *Secure Access LLC v. PNC*, 848 F.3d 1370, 1381 (Fed.

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Cir. 2017). Such “finance-related activities” include the storage of financial documents. *Fid. Nat’l Info. Servs., Inc., vs. DataTreasury*, CBM2014-00021, 2014 WL 1729297, at *6 (PTAB Apr. 29, 2014). Indeed, the Board has repeatedly held that patents directed to collecting financial information, and providing a customer access to that information, meet the statutory requirements for “performing data processing or other operations used in the practice, administration, or management of a financial product or service.” *Life Technologies Corp., v. Unisone Strategic IP, Inc.*, CBM2016-00025, 2017 WL 2713466, at *7 (PTAB June 23, 2017); *IBG LLC et al., v. Trading Technologies International, Inc.*, CBM2015-00181, Paper No. 138 at pp. 12-14 (PTAB March 3, 2017). *United Servs. Auto. Ass’n v. Asghari–Kamrani*, CBM2016-00064, 2017 WL 3525359, at *9 (PTAB Aug. 15, 2017) (“...***access to a financial institution’s system*** for banking services amount[s] to providing a financial service.”) (emphasis added).

There can be no legitimate dispute that all challenged claims of the ’866 Patent are CBM eligible. Independent Claims 1, 23 & 45 (and all dependent claims) require “storing a plurality of *financial documents*,” “receiving a request for at least one of the stored *financial documents*,” and “retrieving the requested *financial document*.” Ex. 1001 at 11:35-67, 13:20-45, 14:62-15:31. The claims of the ’866 Patent are directed to performing operations used in the practice, administration, or management of a financial product or service (*i.e.*, storing,

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requesting, and retrieving “financial documents”), rendering the ’866 Patent directed to “financial activity” and eligible for CBM review. Ex. 1022 at ¶53.

The specification of the ’866 Patent also confirms that the challenged claims’ are directed to “performing data processing or other operations used in the practice, administration, or management of a financial product or service.” See *Unisone*, 2017 WL 2713466, at *7. Specifically, the ’866 Patent explains that requests for financial documents “are typically made for replacing lost or stolen financial documents, for *tax purposes*, for proof of *financial transactions*, for legal disputes, and other similar matters.” Ex. 1001 at 1:39-42 (emphasis added).

Moreover, in a previous lawsuit, Patent Owner conceded this issue by affirmatively construing the term “financial document” to mean “a document of a *financial nature* including, but not limited to, *checks, checking account statements, and documents related to check and checking account statements.*” Ex. 1011, *Mirror Imaging LLC v. Suntrust Banks, Inc.*, Case No. 2:08-cv-00295-DF, Dkt. No. 191-2, Revised P.R. 4-5(d) Joint Claim Construction Chart at p. 7 (E.D. Tex. Feb. 16, 2010) (emphasis added).

Although not required to demonstrate CBM eligibility, the financial nature of the “financial documents” claimed by the ’866 Patent are central to performing operations used in the practice, administration, or management of a financial product or service. See *Dish Network Corp. v. Customedia Technologies, L.L.C.*,

CBM2017-00032, 2017 WL 3209455, at *5 (PTAB July 28, 2017) (disagreeing with Patent Owner's assertion that "a claim must have 'an express financial component that is *central* to the operation of the claimed invention.'").

Specifically, the claims provide that the financial documents are stored according to "specific document parameter[s] of the financial document." *See, e.g.*, Ex. 1001 at 11:35-38. For example, as set forth in Dependent Claims 15-18, a parameter may be an "account number," a "check number," a "payment date," or a "monetary amount." All claims require the storage and retrieval of financial documents based on these parameters, and the financial nature of the documents is central to the claimed methods (*i.e.*, are central to operations used in the practice, administration, or management of a financial product or service). Ex. 1022 at ¶53. Accordingly, to the extent it is probative of the '866 Patent's financial activity, the financial nature of the claim elements are central to a financial service. Ex. 1022 at ¶¶51-55.

- (2) Independent Claims 23 & 45 and their dependent claims, including Claims 31 & 55, are directed to financial activity as they require "financial institutions."

Here, Independent Claims 23 & 45 and their dependent claims, including Claims 31 & 55 expressly require "financial institutions" to obtain or receive the financial documents. Further Claims 30 & 55 require "distributing the reproduced financial document to a financial institution based on routing codes."

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In *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, the Federal Circuit held that a patent directly affecting a “financial institution” meets the definition of “covered business method patent” and renders that patent eligible for review. *Versata*, 793 F.3d 1306, 1325 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 2510, 195 L. Ed. 2d 841 (2016) (“We agree with the USPTO that...the definition of ‘covered business method patent’ is not limited to products and services of only the financial industry, or to patents owned by or directly affecting the activities of financial institutions such as banks and brokerage houses.”); *see also United Servs. Auto. Ass’n*, 2017 WL 3525359, at *9; *Experian Mktg. Solutions, Inc. v. RPost Commc’ns Ltd.*, CBM2014-00064, 2014 WL 3810664, at *5 (PTAB July 31, 2014) (“Patent Owner’s argument that its claimed subject matter ‘would be no more related to the financial institution as would be a stapler’ (id. at 8) ignores the specific recitations in the ’104 Patent discussed above.”).

Like the patent in *United Servs. Auto. Ass’n*, the ’866 Patent provides access to a *financial institution’s* system, is directed to a financial service, and is eligible for CBM review.

- (3) The challenged claims are not merely “incidental to” or “complementary to” a financial activity.

All of the challenged claims of the ’866 Patent expressly, unequivocally, and consistently require the storage and retrieval of “financial documents” based on

parameters derived from those very “financial documents” such as an “account number,” a “check number,” a “payment date,” or a “monetary amount.” Other claims provide access to a financial institution’s system. The challenged claims’ financial activity is *not* merely “incidental to” or “complementary to” a financial activity. *Cf. Unwired Planet, LLC v. Google Inc.*, 841 F.3d 1376, 1382 (Fed. Cir. 2016); *Secure Access*, 848 F.3d at 1380-81.

Unwired Planet and *Secure Access* are in no way analogous to the facts and challenged claims here, and all challenged claims are unquestionably eligible for CBM review.

ii. The Claims Of The ’866 Patent Are Not Directed To A
“Technological Innovation”

Claims that cover a “technological innovation” are not CBM eligible. *See* AIA § 18(d)(1); 37 C.F.R. § 42.301(a). “In determining whether a patent is for a technological innovation,” the Board considers “whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution.” 37 C.F.R. § 42.301(b). The ’866 Patent is not directed to any “technological innovation.”

The ’866 Patent does not claim a novel “technological feature” as it admittedly only employs conventional computer components and well-known storage media. Ex. 1001 at 1:21-37, 43-47, 2:6-7, 4:29-34; Ex. 1022 at ¶¶56-62;

see also Ex. 1015, Ex. 1026, Ex. 1027, Ex. 1028, Ex. 1029, Ex. 1030. There are no allegedly new technological features, hardware, software, or even a novel arrangement of existing computing elements. Ex. 1022 at ¶¶56-62. The claims recite a general purpose “storage system,” “computer terminal,” and “processing unit” arranged in and operating in conventional ways. Ex. 1001 at 1:27-37. The claims at issue here lack a “technological feature” as their “elements are nothing more than general computer system components used to carry out the claimed process.” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1341 (Fed. Cir. 2016).

In describing the alleged invention, the ’866 Patent explains that the “processing, retrieval and reproduction of the requested financial document is typically controlled by one interlinked computer software program,” which may be one of any “frequently used software programs,” for “implementing the discussed procedures.” Ex. 1001 at 6:34-36. Indeed, “any of these computer software systems can provide the necessary means for implementing the discussed procedures.” *Id.* at 6:36-38.^{3/} There can be no dispute, the ’866 Patent does not claim any improvement of a computing device. *See IBG LLC, et al. v. Trading*

^{3/} As another example, the ’866 Patent admits that network nodes may be “any type of storage device as is known in the art.” Ex. 1001 at 9:19-20.

Technologies International, Inc., CBM2016-00032, 2017 WL 3479474, at *6
(PTAB August 14, 2017).

Further, the recited use of generic computers and storage media was well-known and conventional at the time of the alleged invention. Ex. 1022 at ¶¶59-62; *see also* Ex. 1015, Ex. 1026, Ex. 1027, Ex. 1028, Ex. 1029, Ex. 1030. The challenged claims use generic computers to, “stor[e] a plurality of financial documents,” “input [] requests,” and “access [] storage system[s].” Ex. 1022 at ¶60; Ex. 1001 at 11:35-67; *see also* Ex. 1026, Ex. 1028. The ’866 Patent openly admits that electronically storing financial documents was a well-known and conventional practice. Ex. 1001 at 1:21-22 (“Methods for obtaining electronically-stored financial documents are generally known in the art.”), at 1:54-57 (“storing, downloading, and retrieving of the financial document, including the reproduction and the distribution of the document, are known in the industry....”). Moreover, the use of on and off-site storage for documents, including financial documents, was known and conventional. Ex. 1022 at ¶¶61-62; Ex. 1001 at 1:28-32 (“financial documents are typically electronically-stored in an on-site storage system located at the financial institution or in an off-site storage system.”), at 2:6-7 (“financial institutions do electronically store financial documents in on-site and off-site storage systems.”); *see also* Ex. 1015, Ex. 1026, Ex. 1029, Ex. 1030, Ex. 1034. Thus, the “recited physical components behave exactly as expected

according to their ordinary use.” *See In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016).

In *Versata*, the court agreed with the Board’s conclusion that the patent at issue did not cover a “technological invention” because the invention “could be achieved ‘in any type of computer system or programming or processing environment,’ and accordingly ‘no specific, unconventional software, computer equipment, tools or processing capabilities are required.’” *Versata*, 793 F.3d at 1327; *see also SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1315 (Fed. Cir. 2015), *cert. denied*, 137 S. Ct. 813, 196 L. Ed. 2d 599 (2017). The same is true here.

The ’866 Patent’s claims are directed to nothing more than the use of generic computers and storage systems. For example, Claims 1, 23 & 45 recite only the use of a conventional “storage system,” “computer terminal,” and “processing unit,” which are all generic computer components and offer no technological innovation. In a previous lawsuit, Patent Owner aptly defined the term “computer terminal” to mean “a device having a display (*e.g.*, a monitor) and a data entry mechanism (*e.g.*, a keyboard and/or a mouse).” Ex. 1011, *Mirror Imaging LLC v. Suntrust Banks, Inc.*, Case No. 2:08-cv-00295-DF, Dkt. No. 191-2, Revised P.R. 4-5(d) Joint Claim Construction Chart at p. 5 (E.D. Tex. Feb. 16, 2010). Further, the Patent Owner defined “storage system” by merely referencing generic storage

system functionality: “related computer hardware and software that electronically stores and permits retrieval of the financial documents.” *Id.*

The challenged claims do not recite a technological innovation as the generic computer components perform nothing more than conventional functions that were well-known in the art at the time of the alleged invention. Ex. 1022 at ¶62; *Fed. Reserve Bank of Atlanta v. Bozeman*, CBM2017-00035, 2017 WL 3769230, at *8 (PTAB Aug. 29, 2017) (finding that “a database,” “a computer,” “a point-of-sale terminal,” “a portable electronic device,” and “a notification” recited in the claim did not, as a whole, “require any specific, unconventional software, computer equipment, processing capabilities, or other technological features to produce the required functional result.”); *see also IBG*, 2017 WL 3479474 at *6.

No limitations add any technological innovation. For example, the ’866 Patent openly concedes inputting a request to a computer terminal was well-known (indeed, inputting requests was not new at the time and has been performed manually as long as computers have existed). Ex. 1022 at ¶63; Ex. 1001 at 1:43-48 (“More specifically, conventional methods for obtaining an electronically-stored financial document enable an employee of the financial institution, such as a bank teller, to input the request into an interface incorporated into the computer terminal.”).

Similarly, the claims recite “comparing the specific document parameter of the requested financial document to the predetermined parameter to determine if the specific document parameter is greater than, less than, or equal to the predetermined parameter after the request has been inputted.” Ex. 1022 at ¶64. Comparing parameters was not new at the time and was well-known and conventional at the time of the alleged invention. Neither the claims nor the disclosure even suggest that the “comparing” step is performed using any supposed new hardware, software, or a novel combination that could even conceivably comprise a technological innovation. To the contrary, the ’866 Patent teaches that no hardware or software is even contemplated – as the claimed “comparing” step is simply performed by “a bank employee, such as a bank teller.” Ex. 1001, at 6:51-53, 7:4-5; Ex. 1022 at ¶65; *see also* Ex. 1030, Ex. 1034. By its own admission, Patent Owner seeks to claim “no more than a human automation of what ‘can be performed in the human mind, or by a human using a pen and paper.’” *Cogent Med. Inc. v. Elsevier Inc.*, 70 F.Supp.3d 1058, 1065 (N.D. Cal. 2014) (*quoting CyberSource*, 654 F.3d at 1375).

Likewise, nothing in the dependent claims recite any form of technological innovation. Ex. 1022 at ¶66.; *see also* Ex. 1024, Ex. 1030, Ex. 1031, Ex. 1032. For example, Dependent Claims 2-10 merely specify conventional media for storing financial documents. Ex. 1001 at 1:27-29 (“[F]inancial documents are typically

stored on microfiche, microfilm, digitally, or by some other electronic storage means”). Conventional storage is not a technological innovation.

The claims of the '866 Patent fail to recite any technological feature that is novel and nonobvious over the prior art even when viewed as a whole. Ex. 1022 at ¶67; *see also* Ex. 1023, Ex. 1024, Ex. 1026, Ex. 1029, Ex. 1030. The combination of storage systems does not include any “technological feature” not present when these elements are analyzed individually (albeit, the combination of storage systems was also old and not new). Ex. 1001 at 2:6-7; Ex. 1022 at ¶67. Instead, the combination of the claimed elements, even according to the '866 Patent's own characterization, only allegedly improve upon prior art systems “by providing a direct interface inter-linked with the off-site storage system.” Ex. 1001 at 2:27-28; Ex. 1022 at ¶67. That is not a technological feature, much less a technological innovation, because a direct link to an off-site storage system was admittedly well known and invented by others. Ex. 1022 at ¶67. Indeed, the '866 Patent concedes that the processing, retrieval, and reproduction of financial documents is controlled by interlinked computer software programs that were already commercially available from companies such as Antinori Software Incorporated and Carreker-Antinori.

“The processing, retrieval and reproduction of the requested financial document is typically controlled by one interlinked computer software

program. One such computer software program is a software program called Antinori Software Incorporated or ASI which is sold under the name of INNOVASION™ by Carreker-Antinori of Dallas, Tex.

However, other frequently used software programs include PEGA™ and Sterling™. *Any of these computer software systems can provide the necessary means for implementing the discussed procedures.*”

Ex. 1001 at 6:31-38 (emphasis added); *see also* Ex. 1016 at p. 2 (describing banks using software from vendors such as Antinori Software Inc. since at least 1993); Ex. 1022 at ¶68.

“Mere recitation of known technologies, such as ... software,” or “reciting the use of known prior art technology to accomplish a process or method” does not render a patent technological invention. Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,763–64; Ex. 1006 at p. 69 (rejection stating that the prior art patent to “Behera, discloses an interlinked computer program (Figure No. 1, Element No. 6 and corresponding text)”). Accordingly, the claimed subject matter of the ’866 Patent, even as a whole, fails to recite any technological feature or innovation that is purportedly novel and unobvious over the prior art, and the ’866 Patent, therefore, is not directed to a technological invention. Ex. 1022 at ¶69

For much the same reason, the ’866 Patent also does not “solve[] a technical problem using a technical solution.” *See* 37 C.F.R. § 42.301(b). In the related ’854 Application, the Applicant (*i.e.*, Patent Owner here) appears to have argued that the

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claims were patent eligible because they purportedly provide a technological solution (*e.g.*, efficient accessibility and low expenses for retrieving financial documents from storage) for solving an alleged technological problem (*e.g.*, no interface independently inter-linked with the off-site storage system). *Id.* at 9-21; *see also* Ex. 1001 at 2:15-17 (The problem allegedly addressed by the '866 Patent was the expense associated with “retrieving [] requested financial documents through [a] back office production [(i.e., off-site storage)].”). This is a red herring as there was no technical problem, much less a technological solution. Ex. 1001 at 2:15-17. Merely providing a generic, technological environment in which to carry out an abstract idea does not address a technological problem. *LendingTree, LLC v. Zillow, Inc.*, 656 F. App'x 991, 997 (Fed. Cir. 2016) (“The claims here, however, are not designed to solve a technological problem. Rather, they merely provide a generic, technological environment (i.e., computers and the Internet) in which to carry out the abstract idea of coordinating loans.”).

Moreover, with on-site and off-site storage systems already known in the art, the supposed problem the '866 Patent sought to solve was not a technical problem but, instead, a business issue: reducing “back office production” and outsourcing off-site storage. Ex. 1022 at ¶70; Ex. 1001 at 2:23-28 (“[I]t is desirable to implement a method for a financial institution to obtain electronically-stored financial documents from both on-site and off-site storage systems that reduces, if

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not eliminates, the back office production [T]he responsibility for retrieving financial documents from the off-site storage can be outsourced to third party entities”). Business issues are not technological problems, and Patent Owner’s attempted explanation does not except the ’866 Patent from covered business method review. *Google Inc. v. Performance Price Holdings, LLC*, CBM2016-00049, 2017 WL 4082446, at *7 (Sept. 13, 2017) (“Petitioner asserts that the ’195 patent does not solve a *technical problem* using a *technical solution*, but rather ‘tries to solve a *business problem* that generally affects buyers and sellers of advertising.’”) (emphasis added).

Should Patent Owner contend that the ’866 Patent somehow addresses “inefficiencies” relating to obtaining financial documents, that argument also fails. Merely using a computer to improve the speed or efficiency of a known process is insufficient under *Alice*. *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015) (“Nor, in addressing the second step of *Alice*, does claiming the improved speed or efficiency inherent with applying the abstract idea on a computer provide a sufficient inventive concept.”).

Furthermore, the ’866 Patent does not even offer a “technical solution” to the problem it purportedly solves. Rather, existing generic computing elements and known software are identified with an ambiguous reference to “a direct interface inter-linked with [an] off-site storage system.” Ex. 1001 at 2:27-28. Of

course, the disclosed methods for providing an inter-linked interface were well known software programs commonly used even before the purported invention of the '866 Patent. Ex. 1022 at ¶¶67-68; Ex. 1001 at 6:28-49 (discussing known, existing “computer software systems [that] provide the necessary means for implementing the discussed procedures.”).

Even if we were to assume, incorrectly and against the facts, that the '866 Patent somehow discloses “a direct interface inter-linked with [an] off-site storage system” improvement with sufficient detail, that would not save the claims as no such “interface” is claimed. *Two-Way Media Ltd. v. Comcast Cable Communications*, No. 2016-2531, -2532, slip. op. at 13 (Fed. Cir. Nov. 1, 2017) (“While...the specification of the '187 Patent describes a system architecture as a technological innovation, ... the claim does not recite this architecture....”).

The challenged claims are not directed to a “technological innovation.” Ex.1022 at ¶71.

B. Petitioner Has Standing And Is Not Estopped From Challenging The '866 Patent.

Petitioner certifies that it has standing to file this Petition because the '866 patent is a covered business method (“CBM”) patent and Petitioner meets the eligibility requirements to file a petition under 37 C.F.R. § 42.302.

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ANBTX and Hanmi have standing as each was directly “charged with infringement” in a complaint filed by Patent Owner. Exs. 1041, 1075. Fiserv, Jack Henry and Q2 have standing to file this Petition, because: (1) Fiserv’s privy Austin Bank, Texas National Association (“Austin Bank”) has been sued for infringement; (2) Jack Henry’s privy ANBTX has been sued for infringement; (3) Q2’s privy Hanmi has been sued for infringement and (4) each of Fiserv, Jack Henry, and Q2 have been “charged with infringement” within the meaning of § 42.302(a). See Exs. 1017-1020, 1040-1042, 1050-1052. Individually and collectively, these bases are sufficient to confer standing on Fiserv, Jack Henry, and Q2. *SAP Am., Inc. v. Pi-Net Int’l, Inc.*, CBM2013-00013, Paper No. 15 at 4-5 (PTAB Sept. 19, 2013); *GSI Commerce Solutions, Inc. v. Clear with Computers, LLC*, CBM2013-00055, Paper 16 at 9 (PTAB Mar. 6, 2014); *Arris Grp., Inc. v. British Telecomms. PLC*, 639 F.3d 1368, 1375 (Fed. Cir. 2011).

Petitioner further certifies that it is not barred or estopped from requesting CBM review on the identified grounds, including under any of 35 U.S.C. § 325(e) or 37 C.F.R. § 42.302(b) or (c).

i. The Law Concerning Petitioners, Privies, and Standing.

“A petitioner may not file with the Office a petition to institute a covered business method patent review of the patent unless the petitioner ... or a privy of

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the petitioner has been sued for infringement of the patent or has been charged with infringement under that patent.” 37 C.F.R. § 42.302(a).

The Board has expressly recognized that, under the legislative history of the Leahy-Smith America Invents Act, “‘privy’ ‘effectively means customers of the petitioner.’” *Pi-Net*, CBM2013-00013, Paper No. 15 at 3-5 (quoting 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer)) (finding standing where Petitioner’s customer had been sued and requested indemnity from Petitioner).

In addition, when a customer is accused of patent infringement, the supplier of the allegedly infringing product or service has CBM standing because the charge against the customer equates to the supplier being “charged with infringement” under § 42.302(a). *GSI*, CBM2013-00055, Paper 16 at 8-11 (*quoting Arris*, 639 F.3d at 1375 (“where a patent holder accuses customers of direct infringement based on the sale or use of a supplier’s equipment, the supplier has standing to commence a declaratory judgment action if ... the supplier is obligated to indemnify its customers from infringement liability”)); *see also* 37 C.F.R. § 42.302(a) (“[C]harged with infringement” is satisfied when the petitioner “would have standing to bring a declaratory judgment action in Federal court”).

Fiserv, Jack Henry, and Q2 have standing as Petitioner here because each supplies accused online banking products and systems to its respective customer

and privy (Austin Bank, ANBTX, and Hanmi), and because each is bound by an indemnity agreement with the same regarding certain alleged damages and losses arising out of their use of the supplied, allegedly-infringing products and systems. Ex. 1017, Fiserv Dec. ¶¶ 6-14; Ex. 1040, Ex. 1040, Jack Henry Dec. ¶¶ 6-14; Ex. 1074, Q2 Dec. ¶¶ 4-7.

ii. Fiserv's Privy Austin Bank Has Been Sued for Infringement of the '866 Patent.

Fiserv has standing at least because Austin Bank, its customer and privy, has been sued for infringement by Mirror Imaging on allegations that Austin Bank's use of Fiserv-supplied online banking products and systems somehow infringes upon one or more claims of the '866 Patent. Fiserv supplies various banking products and services to Austin Bank, including the Premier[®] bank platform and the accused Retail Online[™] banking and Business Online[™] banking products and services (collectively, "Fiserv Products"). Fiserv has been "charged with infringement" based on those same infringement allegations against Austin Bank's use of the Fiserv Products.

Patent Owner has accused Austin Bank's online banking system of allegedly infringing claims of the '866 Patent (and related patents). Ex. 1012, Austin Bank Complaint, ¶¶ 23, 32, 41, 50; Ex. 1014, Claim Chart, pp. 1-6 (**Confidential-For Parties and Board Only**). Austin Bank is a Fiserv customer, and the Fiserv

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Products comprise the accused Austin Bank online banking system. Ex. 1017, Fiserv Dec. ¶¶ 6-8, 10.

Fiserv has agreed to, and is thus obligated to, indemnify Austin Bank for certain damages and losses arising from Patent Owner's allegations that the Fiserv Products somehow infringe upon the claims of the '866 Patent. Ex. 1017, Fiserv Dec. ¶¶ 11, 14. For example, Fiserv and Austin Bank entered a Software License Agreement ("Fiserv Agreement"), for various banking products and services – including the Fiserv Products. Ex. 1017, Fiserv Dec. ¶¶ 7-8; Ex. 1020, Fiserv Agreement. Under the Fiserv Agreement, Fiserv provided and provides Austin Bank with the Fiserv Products for the accused online banking system. Ex. 1029, Fiserv Dec. ¶¶ 8, 10. The Fiserv Agreement's indemnification provision applies to certain damages and losses arising from patent infringement claims, including those brought by Patent Owner concerning Austin Bank's use of the Fiserv Products. Ex. 1017, Fiserv Dec. ¶ 11; Ex. 1020, Fiserv Agreement.

After Mirror Imaging sued Austin Bank, and pursuant to the Fiserv Agreement, Fiserv agreed to the defense and indemnification of Austin Bank against Mirror Imaging's allegations concerning the Fiserv Products. Ex. 1017, Fiserv Dec. ¶ 14.

Austin Bank uses the Fiserv Products, Patent Owner Mirror Imaging's allegations of infringement against Austin Bank are based on the Fiserv Products,

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Fiserv has agreed to a defense and indemnification of Austin Bank against those allegations, and Fiserv has been “charged with infringement.” Fiserv unquestionably has standing to bring this Petition and maintain a CBM proceeding against Mirror Imaging and the ’866 Patent.

iii. Jack Henry’s Privy ANBTX Has Been Sued for Infringement of the ’866 Patent.

Jack Henry has standing at least because its privy and customer, ANBTX, has been sued for infringement by Patent Owner. Ex. 1041 at ¶¶30-38 (allegations of infringement).

Jack Henry provides various banking products and services to ANBTX, including an e-statement platform used for online banking systems. Ex. 1040 at ¶6. These products and services are provided by Jack Henry to ANBTX according to an agreement, which obligates Jack Henry to indemnify ANBTX for certain damages and losses arising from claims that ANBTX’s use of the Jack Henry products allegedly infringes a third-party’s patent. Ex. 1040 at ¶¶6-7; Ex. 1052, p.7, Par. GEN10.1. Given that the allegations of infringement against ANBTX involve Jack Henry’s products and services, Jack Henry has agreed to a defense and indemnification of ANBTX concerning the ’866 Patent. Ex. 1040 at ¶¶8-12. Jack Henry and ANBTX then more formally recognized the obligation of Jack

Henry to indemnify ANBTX with regard to the '866 Patent by signing a Defense and Indemnity Agreement. Ex. 1040 at ¶13; Ex. 1063.

In addition, at least nine other Jack Henry customers have been sued by Patent Owner on the '866 patent. Ex. 1040 at ¶¶14-15; Exs. 1042-1048 (complaints alleging patent infringement). Just as with ANBTX, Jack Henry has an obligation to indemnify these customers against the alleged infringement in light of the service and indemnity agreements entered into between Jack Henry and the respective customers. Ex. 1040 at ¶15; Exs. 1064-1070 (indemnity agreements).

Therefore, ANBTX and the other customers sued by Patent Owner are Jack Henry's privies at least through these supplier-customer and indemnitor-indemnatee relationships. In addition, the obligation of Jack Henry to indemnify ANBTX and the other customers against infringement of the '866 Patent gives Jack Henry standing bring a declaratory judgment action against the '866 Patent. *Arris*, 639 F.3d at 1375. Either of which satisfies the requirement of 37 C.F.R. § 42.302(a) that the Petitioner or its privy be "charged with infringement."

iv. Q2's Privy Hamni Has Been Sued for Infringement of the '866 Patent.

Q2 has standing at least because its privy and customer, Hanmi, has been sued for infringement by Patent Owner based on its use of its Online Banking System. Ex. 1075 at ¶¶ 31-40 (allegations of infringement).

Q2 provides various banking products and services to Hanmi, including the Online Banking Solution. Ex. 1074 at ¶ 4. These products and services are provided by Q2 to Hanmi according to an agreement, which obligates Q2 to defend and indemnify Hanmi for certain damages and losses arising from claims that Hanmi's use of the Q2 products allegedly infringes a third-party's patent. Ex. 1074 at ¶¶ 4,5; Ex. 1052. Given that the allegations of infringement against Hanmi and its Online Banking Solution, Q2 and Hanmi agreed to Q2's defense of Hanmi with regard to the '866 patent by signing an Agreement to Defend. Ex. 1074 at ¶¶ 6, 7. Ex. 1076. By the Agreement to Defend, Q2 assumed the sole right to control the lawsuit against Hanmi with respect to the '866 patent. Ex. 1074 at ¶ 7; Ex. 1076.

Therefore, Hanmi is Q2's privy at least through these supplier-customer and indemnitor-indemnitee relationships. In addition, the obligation of Q2 to indemnify Hanmi against infringement of the '866 patent gives Q2 standing bring a declaratory judgment action against the '866 patent. *Arris*, 639 F.3d at 1375. Both conditions satisfy the requirement of 37 C.F.R. § 42.302(a) that the Petitioner or its privy be "charged with infringement."

C. Timing Requirements.

The '866 Patent issued on November 8, 2005, claims priority to applications filed before March 16, 2013, is not a "first-to-file" patent, and is eligible for CBM review. This Petition is filed outside the nine-month window after issuance of the

'866 Patent. The '866 Patent is not eligible for post-grant review, and is eligible for CBM review. *See* 37 C.F.R. § 42.303.

D. Board Should Not Exercise Discretion to Deny this CBM Petition.

The Board considers seven factors when determining whether to exercise discretion to deny follow-on petitions. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19 at 8-10 (PTAB Sept. 6, 2017) (Precedential). All of these factors weigh in favor of the Board not exercising its discretion here.

Factors 1-4 weigh in favor of not exercising discretion as the Petitioner has not filed a previous petition on this patent, no prior art is at issue in this Petition, and the Patent Owner has not yet filed a preliminary response to the previously filed petition. Factor 5 also weigh in favor of not exercising discretion as Petitioner has worked diligently since the previous filed petition and is filing the instant petition soon after the previously filed petition. Next, factors 6-7 weigh in favor of not exercising discretion since this Petition relies on a single ground of rejection under 35 U.S.C. §101, which would not result in substantial burden on Board resources or prevent the Board from issuing a final determination within 1 year. In addition, the instant petition is necessary to protect the interests of Petitioner (and privies) if petitioner in earlier-filed petitions settle with Patent Owner.

6. STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED

Petitioner respectfully requests review under 35 U.S.C. § 321 and AIA § 18 of claims 1-55 of the '866 Patent, and the cancellation of these claims as unpatentable under 35 U.S.C. § 101.

7. THE HYPOTHETICAL PERSON HAVING ORDINARY SKILL IN THE ART

A person of ordinary skill in the art at the time of the alleged invention of the '866 Patent would be someone with a degree in computer science, electrical engineering (the latter with a computer systems specialization), or equivalent training and/or two years of work experience with computer networking or information technology (IT) training, or the equivalent. Ex. 1022 at ¶¶27-32.

8. CLAIM CONSTRUCTION

Petitioner respectfully submits that no claim construction is necessary or required to address and properly resolve the ground of unpatentability raised here under 35 U.S.C. § 101.

Further, as the Board is required to apply the broadest reasonable construction, prior Court constructions are not relevant to the inquiry. *SAP Am., Inc. v. Versata Dev. Group, Inc.*, CBM2012-00001, 2013 WL 3167735 at *9 (PTAB June 11, 2013) ; 77 Fed. Reg. 48,680, 48,697 (Aug. 14, 2012).

Notwithstanding the foregoing, and as Patent Owner has made admissions concerning the meaning and scope of the challenged claims, Petitioner has cited herein and further identifies certain prior constructions and arguments concerning various terms of the '866 Patent (and related Mirror Imaging patents) for the Board's reference as appropriate.^{4/}

9. THE CHALLENGED CLAIMS ARE UNPATENTABLE UNDER 35 U.S.C. §101

The Supreme Court established a two-step framework for deciding whether a patent claims patentable subject matter under § 101. First, the Board “determine[s] whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355. Second, the Board “consider[s] 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.” *Id.* (citations omitted). At

^{4/} Petitioner recognizes that they are not bound by such prior constructions in judicial proceedings. Further, although Petitioner is not presently requesting that the Board hold claims of the '866 Patent unpatentable for failure to comply with, for example, 35 U.S.C. § 112, the claims should properly be cancelled on such grounds and Petitioner does not waive and reserves all rights to assert such grounds in other proceedings (whether before the Board or a Court).

the second step, the Board assesses whether there is an “inventive concept” that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon” an abstract idea or other patent-ineligible concept. *Id.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

Here, the challenged claims are directed to the abstract idea of storing and retrieving financial documents based on fundamental and long-used document characteristics (such as, for example, the document’s date or age). The claims merely apply this abstract idea in a purely conventional, non-inventive manner, and are therefore unpatentable.

A. The Challenged Claims Are Directed To An “Abstract Idea”

The first step of *Alice* examines the claim as a whole to determine whether the claim’s “character” or “focus” is that of an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). That determination includes whether the claims are directed to “a specific means or method that improves the relevant technology” or if the claims are instead directed to “a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016) (quotation marks and citation omitted). A claim is unpatentable under § 101 if it fails to “claim a particular way of programming or designing the software” and is only “directed to certain functionality.” *Id.*

The challenged claims are directed to nothing more than the abstract idea of storing and retrieving financial documents using known information masked as a “parameter.” Ex. 1022 at ¶¶73-74. Independent Claim 1 is directed to “[a] method of obtaining an electronically-stored financial document” and simply requires “storing a plurality of financial documents,” “utilizing a computer terminal,” “receiving a request for at least one of the stored financial documents,” “inputting a request,” “comparing [a] specific document parameter of the requested financial document,” “automatically accessing [a] storage system,” and “retrieving the requested financial document.” Independent Claims 23 & 45 recite substantially the same limitations, and are likewise directed to the same abstract idea. The specification of the ’866 Patent also confirms that the claims are directed to this abstract idea. Ex. 1001 at 3:10-24 (“[t]he ***subject invention*** therefore provides a method that enables financial institutions to ***obtain electronically-stored financial documents*** from an off-site storage system.”) (emphasis added).

Under *Alice*, such untethered processes are patent-ineligible abstract ideas. *Elec. Power*, 830 F.3d at 1354 (holding that the “process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions” is “directed to an abstract idea.”). Like the abstract idea at issue in *Alice*, the concept of storing and retrieving documents, including financial documents, based on the

documents’ basic information and characteristics is a “practice long prevalent in our system of commerce.” *Alice*, 134 S. Ct. at 2356, 2357; *see also* Ex. 1015, Robert Hudson, *Finding Your Ancestors at the Troy Public Library*, Troy Public Library at p. 4, <http://www.thetroylibrary.org/pdf/FindAncestors.pdf> (February 1993). As the ’866 Patent admits, methods for obtaining electronically-stored financial documents are generally known in the art. Ex. 1001 at 1:21-22. And, patents directed to the storage and retrieval of electronic documents have properly been invalidated as they are directed to an ineligible abstract idea. *See, e.g., Cogent*, 70 F.Supp.3d at 1064-66 (finding claims directed to “maintaining and searching a library of information” unpatentable abstract ideas as they are “little different than the basic concept of organizing a physical library so that an individual can search for information by going to the relevant portion of the library and picking a book”).

The ’866 Patent seeks to improperly monopolize the use of basic computer hardware and software to perform the decades-old process of storing and retrieving documents by using basic document information to identify the documents (Ex. 1022 at ¶¶72-73):

Abstract Idea – Documents Stored & Retrieved by Date	
Pen/Paper/Person	Exemplary Claim 1

Abstract Idea – Documents Stored & Retrieved by Date	
Pen/Paper/Person	Exemplary Claim 1
Libraries and other repositories have long used methods where documents are stored in and retrieved from two storage systems based on document characteristics. ^{5/}	A method of obtaining an electronically-stored financial document from a first storage system remotely-located from a second storage system wherein the first and second storage systems each include a plurality of financial documents stored therein and wherein each of the financial documents include at least one specific document parameter, said method comprising the steps of:
A library stores documents having a certain date range in one repository. Ex. 1015 at p. 4 (<i>e.g.</i> , vital records for “marriages” stored “in closet (Ask for assistance)” for years “1980-1984” and “1989-1990”).	storing a plurality of financial documents in a first fixed medium at the first storage system when the specific document parameter of the financial document is greater than a predetermined parameter;
A library stores documents having a different date range in a different repository. Ex. 1015 at p. 4 (<i>e.g.</i> , vital	storing a plurality of financial documents in a second fixed medium at the second storage system when the

^{5/} Exhibit 1015 is exemplary prior art from the Troy Public Library describing the same abstract idea as the asserted claims – performed solely by people rather than people & electronics. *See also* Ex. 1034 at 66-68 (describing storing medical records, including as microfilm and microfiche, on-site within a certain age and at remote locations after a certain age). The abstract, basic process has been used for many decades; adding a “computer” does not make it patent eligible. *See, e.g., Cogent*, 70 F.Supp.3d at 1064-66.

Abstract Idea – Documents Stored & Retrieved by Date	
Pen/Paper/Person	Exemplary Claim 1
records for “marriages” stored “in card catalog” for years “1985-1988”).	specific document parameter of the financial document is less than or equal to the predetermined parameter;
A library patron may access either document repository at the library. <i>See</i> Ex. 1015 at p. 4.	utilizing a computer terminal connected to the first and second storage systems through a processing unit;
A library patron may request a document having a certain date from a librarian. <i>See</i> Ex. 1015 at p. 4.	receiving a request for at least one of the stored financial documents;
The librarian considers the request. <i>See</i> Ex. 1015 at p. 4.	inputting the request into the computer terminal;
The librarian compares the requested document date to the fixed dates of the respective repositories. <i>See</i> Ex. 1015 at p. 4.	comparing the specific document parameter of the requested financial document to the predetermined parameter to determine if the specific document parameter is greater than, less than, or equal to the predetermined parameter after the request has been inputted;
The relevant repository is accessed, depending on the date of the requested document. <i>See</i> Ex. 1015 at p. 4 (<i>e.g.</i> , vital records for “marriages” stored “in closet (Ask for assistance)” for years “1980-1984” and “1989-1990”; vital records for “marriages” stored “in card catalog” for years “1985-1988”).	automatically accessing the first storage system through the processing unit when the specific document parameter is greater than the predetermined parameter and automatically accessing the second storage system through the processing unit when the specific document parameter is less than or equal to the predetermined parameter; and
The requested document is retrieved from the relevant repository. <i>See</i> Ex. 1015 at p. 4 (<i>e.g.</i> , vital records for	retrieving the requested financial document, as defined by the inputted request, in the first fixed medium when

Abstract Idea – Documents Stored & Retrieved by Date	
Pen/Paper/Person	Exemplary Claim 1
“marriages” stored “in closet (Ask for assistance)” for years “1980-1984” and “1989-1990”; vital records for “marriages” stored “in card catalog” for years “1985-1988”).	the specific document parameter is greater than the predetermined parameter and in the second fixed medium when a specific document parameter of the financial document is less than or equal to the predetermined parameter.

“[T]he fact that there are pre-Internet analogs to the patent claims suggests methods of organizing human (business activity) and, therefore, an abstract idea.” *Parus Holdings, Inc. v. Sallie Mae Bank et al.*, Civ. No. 14-1427-SLR, 2015 WL 5886170, *9 (D. Del. Oct. 8, 2015). Adding common hardware and generic software does not render the system and process patentable. Section 101 is not satisfied by translating an abstract idea merely by *using* hardware and software without in any way *improving* hardware or software. *See SiRF Techs., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1333 (Fed. Cir. 2010) (“In order for the addition of a machine to impose a meaningful limit on the scope of a claim, it must play a significant part in permitting the claimed method to be performed, rather than function solely as an obvious mechanism for permitting a solution to be achieved more quickly, *i.e.*, through the utilization of a computer for performing

calculations.”); *see also*, *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada* (U.S.), 687 F.3d 1266, 1278 (Fed. Cir. 2012).

Analogous abstract concepts involving “fundamental economic and conventional business practices” have all consistently been held unpatentable. *See, e.g., Parker v. Flook*, 437 U.S. 584, 585 (1978) (invalidating a patent covering an automated method for updating alarm limits consisting of gathering data, performing a calculation, and updating the alarm limit); *Intellectual Ventures I*, 792 F.3d at 1367-68 (invalidating a patent that used a user profile to determine whether a transaction would exceed a predetermined budget); *Cyberfone Sys., LLC v. CNN Interactive Group, Inc.*, 558 Fed. App’x 988, 991-92 (Fed. Cir. 2014) (collecting data, separating it into component parts, and transmitting the components to different destinations was an unpatentable abstract idea). In fact, the vague, abstract, concept claimed by the ’866 Patent is *more* abstract than at least those rejected in *Flook* and *Intellectual Ventures*, as the ’866 Patent does not even purport to perform calculations using data.

The Federal Circuit’s reasoning in *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343 (Fed. Cir. 2014) is particularly instructive. There, the court found that “the claims of the asserted patents are drawn to the abstract idea of 1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory.” *Id.* at

1347. The court explained that “[t]he concept of data collection, recognition, and storage is undisputedly well-known,” and that “[i]ndeed, humans have always performed these functions.” *Id.* In the particular context of financial institutions, the court found that “banks have, for some time, reviewed checks, recognized relevant data such as the amount, account number, and identity of account holder, and stored that information in their records.” *Id.* A comparison of the claims at issue in *Content Extraction* with the claims of the ’866 Patent illustrates that the ’866 Patent also is no different in claiming a similar abstract idea. Like the claims at issue in *Content Extraction*, the challenged claims here require “undisputedly well-known” steps of storing and retrieving financial documents in storage media. Ex. 1022 at ¶¶73-75. The claims of the ’866 Patent, just as the claims at issue in *Content Extraction*, are directed to nothing more than an abstract idea.

The Federal Circuit has repeatedly found similar claims to be directed to nothing more than unpatentable abstract ideas. For example, in *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, the Federal Circuit evaluated a method claim reciting steps that require “obtaining data, ‘exploding’ the data, i.e., separating it into component parts, and sending those parts to different destinations.” *Cyberfone*, 558 Fed. App’x. at 990. The court explained that the patent claimed an abstract idea because “using categories to organize, store, and transmit information is well-established.” *Id.* at 991. Specifically, the “well-known concept of

categorical data storage, i.e., the idea of collecting information in classified form, then separating and transmitting that information according to its classification, is an abstract idea that is not patent-eligible.” *Id.*

Similarly, in *Fid. Nat'l Info. Servs., Inc., vs. DataTreasury Corp.*, the Board held that claims directed to “transferring information from one location to another where the transferred information is unreadable without a secret decoder key,” are directed to an abstract idea. 2014 WL 1729297, at *11; *see also Bozeman*, 2017 WL 3769230, at *10 (finding that “steps directed to collecting and storing financial transaction information, comparing received financial transaction information against the stored information, and notifying the parties of any matches or mismatches between the sets of financial transaction information” were directed to an abstract idea). Like the claims in *Cyberfone* and *DataTreasury*, the claims of the '866 Patent simply require storing financial documents according to basic data -- “document parameter” (such as a date) -- and then retrieving the same financial documents according to the known and basic parameter. Ex. 1022 at ¶¶73-75. The challenged claims of the '866 Patent are directed to nothing more than an abstract idea -- the well-known concept of the storage and retrieval of financial documents using known information, such as dates.

Patent Owner may argue, as it did in connection with the refused, pending '854 Application, that the challenged claims cannot be directed to an abstract idea

because the claims are “limited to financial documents.” *See* Ex. 1002 at p. 111.

Both the Board and the Federal Circuit have expressly rejected this type of reasoning and held such claims unpatentable. “The Federal Circuit treats collecting information, which is intangible, ‘as within the realm of abstract ideas’—*even when collection of the information is limited to a particular content.*” *Nautilus Hyosung Inc. v. Diebold Nixdorf Inc.*, CBM2016-00034, 2017 WL 3479477, at *14 (PTAB Aug. 14, 2017)) (emphasis added); *Elec. Power*, 830 F.3d at 1353 (“[W]e have treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.”).

Even if limiting the claims to a particular context could change the analysis under step one, which it cannot, directing a patent to data storage and retrieval for financial purposes does not transform its claims to be outside the realm of an abstract idea. “[A] bare field of use limitation, without more, cannot make an otherwise abstract claim patent-eligible” and “restricting the abstract idea to a particular field is not an inventive application of an abstract idea as contemplated by *Alice*.” *Cogent*, 70 F.Supp.3d at 1065. Indeed, the Federal Circuit has appropriately held that “data processing to facilitate financing is a patent-ineligible abstract concept.” *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1056 (Fed. Cir. 2017). Similarly, “a method for collection, analysis, and

generation of information reports, where the claims are not limited to how the collected information is analyzed or reformed, is the height of abstraction.”

Clarilogic, Inc. v. FormFree Holdings Corp., 2017 WL 992528, at *2 (Fed. Cir. 2017). And, claims directed to processing information for loan applications, or to facilitate loan shopping, are abstract. *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324 (Fed. Cir. 2016); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012). Here, the challenged claims are directed to substantially less – simply storing and retrieving financial documents based upon a generic data point. Ex. 1022 at ¶¶73-75. The challenged claims are plainly nothing more than an unprotectable, unpatentable, abstract idea.

Patent Owner may also attempt to argue, as it did in connection with the refused, pending '854 Application, that the claims are somehow analogous to those in *Enfish LLC v. Microsoft Corp.*, *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, or *U.S. Bancorp v. Solutran*. See Ex. 1002 at pp. 106-107. Such argument would be materially misplaced, as the challenged claims are plainly distinguishable from the claims in each of those cases.

For example, the claims in *Enfish* were patent eligible because they were “designed to improve the way a computer stores and retrieves data in memory.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). The Federal Circuit explained that the key question is “whether the focus of the claims

is on the specific asserted improvement in computer capabilities (i.e., the self-referential table for a computer database) or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Id.* at 1337. Because the claimed technological improvement (i.e., self-referential table) was expressly embodied in the claim, the claim was patent-eligible. *Id.*

No similar facts exist here where, unlike *Enfish*, the alleged claimed invention of the ’866 Patent does not purportedly improve any aspect of computer technology. Ex. 1001 at 2:38-40. Rather, it merely uses generic, general purpose, computers in their known manner. Ex. 1022 at ¶¶73-75. In stark contrast to the claims in *Enfish*, the alleged improvement of the ’866 Patent is to simply direct the storage and retrieval of a financial document in one of two databases employing a known piece of information, such as a date.

Likewise, in *Amdocs*, the Federal Circuit held that the claim at issue was patent eligible as it was “tied to a specific structure of various components (network devices, gatherers, ISMs, a central event manager, a central database, a user interface server, and terminals or clients) [and] narrowly drawn to not preempt any and all generic enhancement of data in a similar system, and does not merely combine the components in a generic manner, but instead purposefully arranges the components in a distributed architecture to achieve a technological solution to a

technological problem specific to computer networks.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1301 (Fed. Cir. 2016).

Here no claim is tied to any specific structure, much less a new architecture to provide a technological solution to a technological problem. Ex. 1022 at ¶¶73-75. Rather, all of the challenged claims admittedly rely solely upon the use of conventional general purpose hardware and software elements used in their ordinary and normal manner.

Moreover, the problem purportedly solved by the '866 Patent—outsourcing the responsibility of retrieving financial documents to third parties—is a business problem associated with “back office” financial activities and cannot fairly be considered any “technological problem.” *TLI*, 823 F.3d at 613. In *TLI*, the Federal Circuit explained that the problem facing the inventor of a patent directed to taking, transmitting, and organizing digital images “was not how to combine a camera with a cellular telephone, how to transmit images via a cellular network, or even how to append classification information to that data.” *Id.* at 612. “Nor was the problem related to the structure of the server that stores the organized digital images.” *Id.* “Rather, the inventor sought to ‘provid[e] for recording, administration and archiving of digital images simply, fast and in such way that the information therefore may be easily tracked.’” *Id.*

Similar to the patent in *TLI*, the problem articulated by the applicant for the '866 Patent was not how to combine an interface with off-site storage, nor how to transmit financial documents to and from an off-site storage; nor was the problem related to the structure of the storage media that stored financial documents. Ex. 1022 at ¶42-43. Instead, the '866 Patent merely discloses and claims the storage and retrieval of financial documents in a manner that may be outsourced to third parties. In so doing, the '866 Patent “simply adds conventional components to well-known business practices.” *TLI*, 823 F.3d at 612; Ex. 1022 at ¶57. Further, like the patent in *TLI*, the '866 Patent “fails to provide any technical details for the tangible components, but instead predominately describes the systems and methods in purely functional terms.” *Id.* Accordingly, the claims at issue are readily and appropriately distinguishable from claims the Federal Circuit has deemed patent eligible.

Any reliance by Patent Owner on *Solutran* would be equally misplaced. In *Care N' Care*, the Board rejected a patentee's reliance on *Solutran* and the same reasoning applies here. *Care N' Care Ins. Co. v. Integrated Claims Systems, LLC*, CBM2015-00064, 2016 WL 3438926 (PTAB June 21, 2016). First, “the Board's Decision on Institution in *Solutran* is nonprecedential and, therefore, not binding.” *Id.* at *9. Second, in rendering the *Solutran* decision, the Board could not have taken into consideration the Federal Circuit's guidance in *Content Extraction*. *Id.*

The Federal Circuit’s ruling in *Content Extraction* rejected *Solutran*’s reasoning in finding that the use of scanners and computers is abstract and do not add “significantly more” that could conceivably render the claims patently eligible. *Content Extraction*, 776 F.3d at 1347-48. Moreover, it was “significant to the Board’s § 101 analysis in *Solutran* that the claim was for ‘a method of processing paper checks, which is more akin to a physical process than an abstract idea.’” *Care N’ Care*, 2016 WL 3438926 at *9. There is no “processing” (or similar) physical activity claimed in the ’866 Patent’s abstract storage and retrieval steps. *Solutran* cannot save the challenged claims.

B. The Challenged Claims Do Not Include an “Inventive Concept”

Because the challenged claims are directed to an abstract idea, they are unpatentable under § 101 unless they include an “inventive concept” that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon” the abstract idea. *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1294). The challenged claims fail to include the required inventive concept.

The claims require nothing more than off-the-shelf, general purpose, conventional computer, storage, network, and display technology—such as a “storage system,” “computer terminal,” and “processing unit”—for storing and retrieving financial documents. Ex. 1022 at ¶76; *Bozeman*, 2017 WL 3769230, at *8. Such invocations of generic computers and networks that are not even

arguably inventive are completely insufficient to pass the test of an inventive concept. *Id.*; *see also Alice*, 134 S. Ct. at 2358 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”).

In *Versata*, for example, the Federal Circuit analyzed claims involving substantially more than that which is claimed here – “arranging a hierarchy of organizational and product groups, storing product information, retrieving applicable pricing information, sorting pricing information, eliminating less restrictive pricing information, and determining the price.” 793 F.3d at 1334. Yet, the court properly held, citing Federal Circuit and Supreme Court authority, that “the recitation of a general purpose computer or the Internet” was insufficient to render the claims patent eligible. *Id.* Indeed, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358.

Like the claims in *Versata*, the computer components recited in the ’866 Patent are generic general-purpose computer components that add nothing to the patent-ineligible abstract idea of storage and retrieval of financial documents. Ex. 1022 at ¶76. For example, the specification makes clear that “the computer terminals and the accompanying PC bases are illustrated highly schematically in FIG. 1 and are not intended to be limiting in any manner.” Ex. 1001 at 6:12-21;

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Ex. 1022 at ¶77. The '866 Patent further provides that implementation details were well-known in the industry before the earliest priority date of the '866 Patent. Ex. 1001 at 6:36-38 (“Any of these computer software systems can provide the necessary means for implementing the discussed procedures”), *id.* at 6:31-36 (“One such digital electronic storage device is sold by Kodak under the name of IMAGELINK™ Digital Workstation (IDW)”); Ex. 1022 at ¶77; *see also* Ex. 1027, Ex. 1028, Ex. 1029, Ex. 1030, Ex. 1031, Ex. 1032.

A district court construing claims of the related '072 Patent came to the identical conclusion, finding that the patent did not involve any atypical computer hardware. Specifically, the district court construed the step of “inputting identification data of the requested financial document into the computer terminal” to mean that “human intervention is necessary” because a “computer terminal” is “[a] device, often equipped with a keyboard and a video display, through which data or information can be entered or displayed” and “[i]f other means of inputting data were contemplated, means that would be unusual or involve an atypical computer terminal or hardware, the patentee did not include these in the patent.” Ex. 1013, *Mirror Imaging LLC v. Affiliated Computer Services, Inc., et al.*, Case No. 2:02-cv-73629-RHC, Dkt. No. 55, Claim Construction Order at pp. 18-19 (E.D. MI Feb. 26, 2004). “[R]eceiving data electronically and displaying data for human beings are things that general purpose computers were made for, and do.”

Volusion, Inc. v. Versata Software Inc., CBM2013-00018, 2013 WL 8538866, at *7 (PTAB Oct. 24, 2013). Thus, even though the claims “‘require the use of computers,’ the recitations are not meaningful limitations on the scope of the claims.” *Id.*

Merely collecting information and making it accessible is also insufficient to transform and abstract idea into a patent-eligible claim. *Content Extraction*, 776 F.3d at 1347; *Cyberfone*, 558 Fed. App’x. at 990. Like the claims in *Content Extraction* and *Cyberfone*, all of the challenged claims here simply recite steps for: (1) storing/maintaining; (2) requesting; and (3) retrieving; financial documents. Ex. 1001 at 2:38-3:10.^{6/} These steps, viewed individually or together, do no more than disguise generic steps commonly performed by general-purpose computers, namely: (1) storing information; (2) receiving an input; and (3) retrieving the information. Ex. 1022 at ¶78. These steps do not and cannot constitute an inventive

^{6/} The ’866 Patent concedes that its “comparing” step is performed by “a bank employee, such as a bank teller.” Ex. 1001 at 2:54-59, 6:39-7:3; *see also* Ex. 1013, *Mirror Imaging LLC v. Affiliated Computer Services, Inc., et al.*, Case No. 2:02-cv-73629-RHC, Dkt. No. 55, Claim Construction Order at pp. 17-18 (E.D. MI Feb. 26, 2004).

concept—they simply apply the abstract concept of storing and retrieving financial documents employing computers.

The following sections provide a step-by-step analysis of each limitation of the challenged claims. It is clear that there is no “inventive concept” expressed in any of the limitations, individually or collectively.

i. The Limitations Of the Independent Claims Do Not Constitute An “Inventive Concept”

An analysis of Independent, Challenged Claims 1, 23 and 45 reveals the absence of any “inventive concept”:

Limitations 1[C], 1[D], 23[C], 23[D], 45[C], and 45[D]:⁷ storing or maintaining financial documents at a first/off-site storage system and a second/on-site storage system

Claim 1 in relevant part recites “storing a plurality of financial documents in a first fixed medium at the first storage system when the specific document parameter of the financial document is greater than a predetermined parameter,” and “storing a plurality of financial documents in a second fixed medium at the second storage system when the specific document parameter of the financial

⁷ To the extent the preambles may be deemed limiting, they likewise add no inventive concept. The preambles merely restate the claimed abstract idea by, for example, using generic “storage system” components and do not add any inventive concept. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014).

document is less than or equal to the predetermined parameter.” Claims 23 and 45 parallel the limitations in claim 1, but substitute “first” and “second” storage systems with “off-site” and “on-site” storage systems, and further define the document parameter to relate to the “specific document age of the financial document.” However, these limitations cannot transform the claims into patentable subject matter. Ex. 1022 at ¶79.

First, the claimed “storage systems” are nothing more than generic computer components. Ex. 1022 at ¶80; *see also* Ex. 1027, Ex. 1028, Ex. 1029, Ex. 1030, Ex. 1031, Ex. 1032; *Mortg. Grader*, 811 F.3d at 1324-25 (claims reciting an “interface,” “network,” and “database” are generic computer components directed to an abstract idea). In a previous lawsuit, Patent Owner defined “storage system” functionally, to mean “related computer hardware and software that electronically stores and permits retrieval of the financial documents.” Ex. 1011, *Mirror Imaging LLC v. Suntrust Banks, Inc.*, Case No. 2:08-cv-00295-DF, Dkt. No. 191-2, Revised P.R. 4-5(d) Joint Claim Construction Chart at p. 6 (E.D. Tex. Feb. 16, 2010). Claims that “recite both a generic computer element ... and a series of generic computer ‘components’ that merely restate their individual functions ... is simply not enough under step two.” *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017); *In re Salwan*, 681 Fed. App’x 938, 941 (Fed. Cir. 2017) (“[T]he claimed elements of a generic ‘network,’ ‘computer

program,’ ‘central server,’ ‘device,’ and ‘server for processing and transferring’ are simply not enough to transform the abstract idea into a patent-eligible invention”).

Further, as the ’866 Patent admits, storage systems for storing financial documents were not new at the time of the alleged invention. Ex. 1022 at ¶81; Ex. 1001 at 1:27-29 (“These financial documents are typically stored on microfiche, microfilm, digitally, or by some other electronic storage means”); *see also* Ex. 1026, Ex. 1030. Indeed, storage systems were well known in the art prior to the alleged invention of the ’866 Patent. *See* Ex. 1001 at 4:32-34 (“One such digital electronic storage device is sold by Kodak under the name of IMAGELINK™ Digital Workstation (IDW)”); Ex. 1022 at ¶81; *see also* Ex. 1026, Ex. 1030. The ’866 Patent provides absolutely no detail regarding any required, specific, allegedly inventive structure of the storage systems or their operations. Ex. 1022 at ¶81.

Second, choosing a storage location for a financial document based on a benign document parameter is similarly non-inventive. Ex. 1022 at ¶61; *see also* Ex. 1015, Ex. 1026, Ex. 1029, Ex. 1030, Ex. 1034. Indeed, the Federal Circuit has expressly rejected the notion that making information accessible to different destinations can somehow transform an abstract idea into a patent-eligible claim. *See Cyberfone*, 558 Fed. App’x. at 993 (the exploding step effects no meaningful transformation because it merely makes the originally-gathered information

accessible to different destinations without changing the content or its classification). Here, the '866 Patent admits that storing financial documents in both a first/on-site and a second/off-site storage system was also well known. Ex. 1001 at 2:6-7 (“Other financial institutions do electronically store financial documents in on-site and off-site storage systems”). Accordingly, the specification confirms that the claimed storage simply performs the basic and routine computer function of storing information that was well known in the art.

These limitations of Claim 1 also recite that the financial documents are stored “in a first fixed medium,” and “in a second fixed medium” – merely specifying the number of storage media to store the “financial documents.” The broad category of – “fixed medium” – remains generic. Further, the '866 Patent makes clear that the use of media to store financial documents was also indisputably well known at the time. Ex. 1001 at 1:27-29 (“These financial documents are typically stored on microfiche, microfilm, digitally, or by some other electronic storage means.”); Ex. 1022 at ¶82.

Limitations 1[E], 23[E], and 45[E]: utilizing a computer terminal connected to the first/off-site and second/on-site storage systems through a processing unit

Claim 1 recites “utilizing a computer terminal connected to the first and second storage systems through a processing unit.” Claims 23 and 45 recite parallel limitations, substituting the “first” storage system with “off-site” storage

system, and “second” storage system with “on-site” storage system, and adding that the computer terminal is “associated with the financial institution.” Like the “storage system” limitations discussed above, the “computer terminal,” and “processing unit” limitations recited in these limitations are transparently generic. Ex. 1022 at ¶83.

Again, Patent Owner previously and openly defined the term “computer terminal” generically as “a device having a display (e.g., a monitor) and a data entry mechanism (e.g., a keyboard and/or a mouse).” Ex. 1011, *Mirror Imaging LLC v. Suntrust Banks, Inc.*, Case No. 2:08-cv-00295-DF, Dkt. No. 191-2, Revised P.R. 4-5(d) Joint Claim Construction Chart at p. 11 (E.D. Tex. Feb. 16, 2010). Similarly, Patent Owner defined “processing unit” to mean a generic “computer,” in broad and general terms. Ex. 1011 at p. 5. Such generic computer components do not “do significantly more than simply describe [the] abstract method.” *Ultramercial*, 772 F.3d at 715–16.

Further, like the “storage system” limitations discussed above, the ’866 Patent admits that the utilization of computer terminals to input requests for documents was well-known and conventional. Ex. 1001 at 1:42-43; Ex. 1022 at ¶¶84-85; *see also* Ex. 1030. But, here, the ’866 Patent further concedes that this claimed step may be performed by a person.

“The client’s request is inputted into a computer terminal at the financial institution. *More specifically, conventional methods for obtaining an electronically-stored financial document enable an employee of the financial institution, such as a bank teller, to input the request into an interface incorporated into the computer terminal.*”

Id. at 1:42-48 (emphasis added); Ex. 1022 at ¶84. Other than human-intervention, the ’866 Patent does not teach or disclose means of “utilizing a computer terminal.”

There is no inventive concept in the claimed use of a “computer terminal.” *Content Extraction*, 776 F.3d at 1348 (“There is no ‘inventive concept’ in [Content Extraction]’s use of a generic scanner and computer to perform well-understood, routine, and conventional activities commonly used in industry.”). Further, the recited “computer terminal” merely amounts to “incidental use of a computer to perform the [claimed process]” and thus “does not impose a sufficiently meaningful limitation on the claim’s scope.”

Limitations 1[F], 1[G], 23[F], 23[G],45[F], and 45[G]: receiving a request for the financial document, and inputting the request into the computer terminal

Claim 1 recites “receiving a request for at least one of the stored financial documents,” and “inputting the request into the computer terminal.” Claim 23 similarly recites “utilizing a computer terminal associated with the financial institution and connected to the off-site and on-site storage systems through a

processing unit,” and “receiving a request for the financial document.” And, Claim 45 similarly recites “utilizing a computer terminal located at the financial institution and connected to the off-site and on-site storage systems through a processing unit” and “receiving a request from the requestor for the financial document at the financial institution.” The steps recited in these limitations also merely recite incidental use of generic general-purpose computer components that fail to recite an “inventive concept” capable of transforming the claim into a patent-eligible application of the otherwise ineligible abstract idea. Ex. 1022 at ¶86; *Content Extraction*, 776 F.3d at 1349.

Specifically, the ’866 Patent admits that such steps were both well known in the industry and manually performed. Ex. 1001 at 1:44-48 (“conventional methods for obtaining an electronically-stored financial document enable an employee of the financial institution, such as a bank teller, to input the request into an interface incorporated into the computer terminal.”), *id.* at 1:39-42 (“Client requests are made to replace lost or stolen documents, for tax purposes, for proof of financial transactions, for legal disputes, and other similar matters.”); Ex. 1022 at ¶87.

Indeed, at least one Court has recognized that these limitations require human intervention and manual performance. Claim limitations that can be performed manually underscore the unpatentable nature of the claim. *See Mortg.*

Grader, 811 F.3d at 1324 (noting that “[t]he series of steps covered by the asserted claims ... could all be performed by humans without a computer,” in concluding that the claims at issue were drawn to an abstract idea); *Google Inc. v. Zuili*, CBM2016-00008, 2016 WL 1622242, at *10 (PTAB Apr. 25, 2016) (“Petitioner has shown sufficiently that the underlying act of determining whether a request is valid could have been accomplished manually.”).

In connection with litigation concerning the related ’072 Patent, the Court found that “human intervention is necessary” to perform the step of “inputting identification data of the requested financial document into the computer terminal” because a “computer terminal” is “[a] device, often equipped with a keyboard and a video display, through which data or information can be entered or displayed” and “[i]f other means of inputting data were contemplated, means that would be unusual or involve an atypical computer terminal or hardware, the patentee did not include these in the patent.” Ex. 1012, *Mirror Imaging LLC v. Affiliated Computer Services, Inc., et al.*, Case No. 2:02-cv-73629-RHC, Dkt. No. 55, Claim Construction Order at pp. 17-18 (E.D. MI Feb. 26, 2004).

Limitations 1[H], 23[H], and 45[H]: comparing the specific document parameter/age of the requested financial document to the predetermined parameter/age to determine if the specific document parameter/age is greater than, less than, or equal to the predetermined parameter/age after the request has been inputted

Claim 1 recites “comparing the specific document parameter of the requested financial document to the predetermined parameter to determine if the specific document parameter is greater than, less than, or equal to the predetermined parameter after the request has been inputted.” Claims 23 and 45 recite parallel limitations and substitute “document parameter” with “document age.” These limitations compare document parameters (*e.g.*, a document’s date) with a predetermined value (*e.g.*, a set date).

Just as in *Content Extraction*, these limitations merely recite the use of existing technology to recognize and store well-known data points, and do not recite an “inventive concept.” Ex. 1022 at ¶¶88-90; *Content Extraction*, 776 F.3d at 1348; *see also* Ex. 1015, Ex. 1025, Ex. 1030, Ex. 1034. Further, simply using a set of basic parameters and predetermined rules to organize information cannot confer patent eligibility. *Intellectual Ventures I*, 850 F.3d at 1342 (“And the recited dynamic document provides little more than an unspecified set of rules for displaying and organizing MRTs in a user interface akin to the generic interfaces we have elsewhere explained impart no inventive concept.”).

Again, here, the ’866 Patent contemplates manual performance of the “comparing” step:

“In accordance with one contemplated embodiment of the invention, a bank employee, such as a bank teller first determines a status of the

requested document. More specifically, the employee compares the specific document parameter of the requested financial document to the predetermined parameter to determine if the specific document parameter is greater than, less than, or equal to the predetermined parameter. If the specific document parameter is a particular numerical sequence and the predetermined parameter is a predetermined numerical value, then the employee compares the particular numerical sequence of the financial document to the predetermined numerical value to determine if the particular numerical sequence is greater than, less than, or equal to the predetermined numerical value. Further, if as in the preferred embodiment, the particular numerical sequence is a record date of the financial document, and the predetermined numerical value is a pre-selected date, then the employee compares the record date of the financial document to the pre-selected date to determine if the record date is later than, earlier than, or equal to the pre-selected date.”

Ex. 1001 at 6:50-7:3 (emphasis added); Ex. 1022 at ¶89; *see also* Ex. 1013, *Mirror Imaging LLC v. Affiliated Computer Services, Inc., et al.*, Case No. 2:02-cv-73629-RHC, Dkt. No. 55, Claim Construction Order at pp. 17-18 (E.D. MI Feb. 26, 2004) (“comparing the specific document age of the requested financial document to the predetermined age to determine if the specific document age is greater than, less than, or equal to the predetermined age” “can be accomplished by a human employee or by some other means.”). As noted above, manual performance of a

claim limitation underscores unpatentability. *See Mortg. Grader*, 811 F.3d at 1324; *Google*, 2016 WL 1622242, at *10.

Tellingly, neither the challenged claims nor the specification provide any detail as to how the claimed methods implement the “comparing” steps using novel hardware or software, or combinations thereof. Indeed, the Federal Circuit has found it significant when a patent lacks any details of software for enhancing a process and only use vague generalities, as done here. *Credit Acceptance*, 859 F.3d at 1057 (“Significantly, the claims do not provide details as to any non-conventional software for enhancing the financing process.”); *Intellectual Ventures I*, 850 F.3d at 1342 (explaining that “[o]ur law demands more” than claim language that “provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it”).

Limitations 1[I], 1[J], 23[I], 23[J], 45[I], and 45[J]: automatically accessing and retrieving the financial document from the first/off-site storage system and the second/on-site storage system through the processing unit

Claim 1 recites the steps of “automatically accessing the first storage system through the processing unit when the specific document parameter is greater than the predetermined parameter and automatically accessing the second storage system through the processing unit when the specific document parameter is less than or equal to the predetermined parameter,” and “retrieving the requested

financial document, as defined by the inputted request, in the first fixed medium when the specific document parameter is greater than the predetermined parameter and in the second fixed medium when a specific document parameter of the financial document is less than or equal to the predetermined parameter.” Claims 23 and 45 parallel the limitations in Claim 1, but substitute “first” and “second” storage systems with “off-site” and “on-site” storage systems, and further specify which storage system is accessed based on whether the “specific document age” is greater than a predetermined age, or less than or equal to the predetermined age. The claims’ description of well-known and generic steps does not transform the abstract idea into patentable subject matter. Ex. 1022 at ¶91.

Here, these limitations amount to nothing more than retrieving financial documents from different storage destinations. The ’866 Patent explains that the “processing, retrieval and reproduction of the requested financial document is typically controlled by one interlinked computer software program,” which can be one of any “frequently used software programs,” for “implementing the discussed procedures.” Ex. 1001 at 6:36-38 (“Any of these computer software systems can provide the necessary means for implementing the discussed procedures.”); Ex. 1022 at ¶¶92-93. This is nothing more than generic, general purpose, computers and software. Ex. 1022 at ¶¶92-93. Indeed, as the ’866 Patent admits “storing, downloading, and retrieving of the financial document, including the reproduction

and the distribution of the document, are known in the industry....” Ex. 1001 at 1:54-57; Ex. 1022 at ¶¶92-93. Accordingly, these limitations were well known to those of ordinary skill in the art at the time. Ex. 1022 at ¶¶92-94. Further, like the claims in *Cyberfone*, these generic steps provide no meaningful limitations because they merely access simple information from different destinations. *Cyberfone*, 558 Fed. App’x. at 993. Nor does the particular configuration confer patentability because, as in *Mayo*, the common well-known steps follow from the underlying idea of categorical information storage.

Performing the steps of accessing and retrieving “automatically” does not add any inventive concept to the claims. The Federal Circuit has rejected any argument that configuring generic computers to “supplant and enhance” an otherwise abstract manual process renders a claim eligible under step two. *Credit Acceptance*, 859 F.3d at 1056. Similarly, using off-the-shelf generic, general purpose, components to increase the speed of a system will not make the claim patent eligible under step two. *Clarilogic*, 2017 WL 992528, at *3 (“[T]he claims require only off-the-shelf, conventional computer technology,” and “[e]ven if the ‘243 patent may be said to invoke internet-based systems to increase speed ... this does not make the claimed invention patent eligible.”); *Intellectual Ventures I*, 792 F.3d at 1367 (“Nor, in addressing the second step of Alice, does claiming the

improved speed or efficiency inherent with applying the abstract idea on a computer provide a sufficient inventive concept.”).

To the extent Patent Owner argues that accessing financial documents from a second/off-site storage provides any enhancement, that argument fails because, like the limitations at issue in *DataTreasury*, the limitations here “simply arrange[] old well-known elements with each performing the same function it had been known to perform.” *See DataTreasury*, 2014 WL 1729297, at *12.

Limitations 45[A], and 45[B]: providing an outsourcing institution associated with the off-site storage system and a requestor, and associating the financial institution with the on-site storage system wherein the outsourcing institution, requestor, and financial institution are different from each other

Independent Claim 45 further recites an “outsourcing institution,” and a “requestor.” The claim merely provides that a “request” is received from a “requestor”; yet nothing in the specification describes the claimed “requestor” or “outsourcing institution.” These claim terms are indisputably abstract, vague, and generic.

Moreover, “outsourcing institutions” are not new and were well known in the industry at the time of the alleged invention. Ex. 1001 at 1:66-2:3. Having an outsourcing institution, requestor, and financial institution separate from one another was also common, well-known and conventional. *Id.* at 2:6-7 (“Other financial institutions do electronically store financial documents in on-site and off-

site storage systems.”). Thus, like the claim terms discussed above, these limitations are generic, perform generic functions according to their ordinary use, and are arranged in a manner that was well-known and conventional. Accordingly, the additional limitations recited in Claim 45 do not contain an inventive concept sufficient to transform the abstract idea into a patent eligible claim.^{8/}

ii. The Dependent Claims Do Not Provide Any “Inventive Concept”

The ’866 Patent’s dependent claims are directed to the same abstract idea of storing and retrieving financial documents based upon common, generic, information – such as a document’s date. None of the dependent claims include an inventive concept sufficient to take them outside the realm of patent-ineligible abstract ideas.

Dependent Claims 3-9, 11, 42-44, 50-53 merely specify the type of medium in which the financial documents are stored. Ex. 1022 at ¶95. As explained above, the ’866 Patent makes clear that the use of such media to store financial documents was well known at the time. Ex. 1001 at 1:27-29 (“These financial documents are typically stored on microfiche, microfilm, digitally, or by some other electronic

^{8/} Moreover, Claim 45 underscores the fact that the alleged problem addressed by the ’866 Patent—“outsourc[ing] the responsibilities for back office production to third party entities” —is a business problem, not a “technological” problem.

storage means.”). Dependent Claims 2 and 10, which depend from Claim 1, simply require two of the same or different mediums, requiring “the first and second fixed mediums are different from each other,” and “the first and second fixed mediums are the same” respectively. Ex. 1022 at ¶95; Ex. 1001 at 12:1-2, 34-35. However, nothing in the specification teaches or suggests that having two of the same, or different, storage media was somehow novel, meaningful, or in any way would improve the claimed method’s operation. Indeed, using the same or different types of storage media at the time was common and well-known. Ex. 1001 at 1:27-29. Accordingly, Dependent Claims 2-11, 42-44 and 50-53 fail to add anything “inventive” to the claims under step two.

Dependent Claims 12-18 specify so-called document parameters. However, simply identifying a set of information fields for facilitating what are otherwise conventional and well-known steps of storing and retrieving financial documents does not amount to an “inventive concept.” Ex. 1022 at ¶96; *Content Extraction*, 776 F.3d at 1348.

Dependent Claims 19 and 20 recite the additional step of “reproducing the requested financial document after the requested financial document has been retrieved from the associated storage system,” and “distributing the reproduced financial document to a financial institution based on routing codes.” Ex. 1022 at ¶97; Ex. 1001 at 12:66-13:5. These steps were well-known and conventional in the

industry (*e.g.*, printing and distributing). Ex. 1022 at ¶97; Ex. 1001 at 1:54-57 (“The storing, downloading, and retrieving of the financial document, including the reproduction and the distribution of the document, are known in the industry as back office production.”). These claims are directed to a “well-understood, routine, conventional activit[y] previously known to the industry,” just like the human and generic computer steps recited in the Independent Claims, and, accordingly, cannot constitute an inventive concept. Ex. 1022 at ¶97; *see Alice*, 134 S. Ct. at 2359. Dependent claims 24, 25, 26, 54 and 55 recite similar limitations and are similarly unpatentable.

Dependent Claims 21, 36, 49 specify that the steps of automatically accessing the first and second storage systems access only one of the storage systems at a time. Automatically accessing one storage medium at a time was common, well-known, and certainly cannot save the idea from being abstract. Ex. 1022 at ¶98; Ex. 1001 at 6:31-36; *see also Ebay Inc. v. XPRT Ventures, LLC*, CBM2017-00026, 2017 WL 3206572, at *11 (PTAB July 26, 2017) (holding that whether a payment feature was performed automatically does not alter the essence of the claimed method”).

Dependent Claim 22 further recites the step of “including an outsourcing institution associated with the second storage system.” As such, Claim 22 merely recites the business objective of having an “outsourcing institution” involved in the

claimed method to achieve a desired result or outcome. The Federal Circuit has repeatedly invalidated as abstract claims directed to a result or outcome, rather than a specific technological way to achieve the directed result. *Intellectual Ventures I*, 850 F.3d at 1342 (“Indeed, the claim language here provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it. Our law demands more.”); *see also Apple*, 842 F.3d at 1244 (“Generally, a claim that merely describes an ‘effect or result dissociated from any method by which [it] is accomplished’ is not directed to patent-eligible subject matter.”).^{9/}

Dependent Claims 27-32, 37-41, and 47-48 include additional, common steps such as feeding, downloading, transmitting, reproducing, redistributing, and categorizing the requests and requested financial documents with the computer terminal and processing unit. Ex. 1022 at ¶¶99. These claims and their limitations merely invoke generic “computer terminals” and “processing units” to perform common computer functions and behave exactly as expected according to their ordinary use. *TLI*, 823 F.3d at 615. These claims also do not add any inventive concept sufficient to confer patentability. Further, like the patent in *TLI*, the ’866

^{9/} Moreover, Claim 22 also underscores the fact that the alleged problem addressed by the ’866 Patent—“outsourc[ing] the responsibilities for back office production to third party entities” —is not a technological problem.

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Patent “fails to provide any technical details for the tangible components, but instead predominately describes the systems and methods in purely functional terms.” *Id.* Accordingly, these dependent claims are similarly directed to a patent-ineligible abstract idea.

Dependent Claims 33-34 include steps of determining a sequence number and image reference number of the requested financial document. However, the ’866 Patent admits that the components for doing so were well known in the art at the time. Ex. 1001 at 4:29-34 (“As appreciated, the electronic storage of the financial documents is frequently created by taking an electronic photo image of the document and storing the photo image in a computer system. One such digital electronic storage device is sold by Kodak under the name of IMAGELINK™ Digital Workstation (IDW).”); Ex. 1022 at ¶100.

Dependent Claims 35 and 46 recite locating the requested financial document, a step well-known and conventional in the industry. Ex. 1001 at 2:18-20, 6:28-39. As a “well-understood, routine, conventional activit[y] previously known to the industry,” and like the generic computer steps recited in the independent claims, these claims also do not constitute an inventive concept. *See Alice*, 134 S. Ct. at 2359.

- iii. Even When Taken As A Whole, The Claims Do Not Add Any Inventive Concept

Finally, “when considered as an ordered combination, the components of each claim [of the ’866 Patent] add nothing that is not already present when [they] are considered separately.” *See Versata*, 793 F.3d at 1334. Unlike the claims found patent eligible in *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, the ’866 Patent does not “claim[] a technology-based solution,” but instead “an abstract-idea-based solution implemented with generic technical components in a conventional way.” *See Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1351 (Fed. Cir. 2016). More specifically, the ’866 Patent purports to obtain financial documents. Ex. 1001 at 1:15-18. As explained above, any technical components used to implement the abstract idea are generic, even if the claims on their face require computer implementation. *See Intellectual Ventures I LLC v. Erie Indemnity Co.*, 850 F.3d 1315, 1329 (Fed. Cir. 2017) (distinguishing *Bascom* on the basis that “[t]he use of metafiles ... is yet another natural consequence of carrying out the abstract idea in a computing environment and is, therefore, also insufficient to transform a patent-ineligible abstract idea into a patent-eligible invention”). The claims of the ’866 Patent do not “overcome a problem specifically arising in the realm of computer networks” and are thus distinguishable from the claims found patent eligible in *DDR Holdings, LLC v. Hotels.com, L.P.* *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014). Accordingly, even when the non-abstract limitations of the

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'866 Patent are viewed in combination, they do not include an inventive concept sufficient to confer patent eligibility.

10. CONCLUSION

For the foregoing reasons, Claims 1-55 of the '866 Patent recite and are directed to an abstract idea, and are not patentable under 35 U.S.C. § 101.

Petitioner therefore respectfully requests review and cancellation of these claims.

Respectfully Submitted

Dated: January 11, 2018

By: 

David A. Roodman, Lead Counsel
Reg. No. 35,663
Nick Williamson, Backup Counsel
Pro Hac Vice
Bryan Cave LLP
One Metropolitan Square
211 N. Broadway, Suite 3600
St. Louis, MO 63102-2750

Henry Petri, Jr. (Reg. No. 33,063)
Polsinelli PC
1401 Eye ("I") Street, N.W., Suite
800
Washington, DC 20005

James Murphy (Reg. No. 55,474)
Polsinelli PC
1000 Louisiana Street, 53rd Floor

Petition for Covered Business Method
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Houston, TX 77002

Jeff Cole (Reg. No. 56,052)
Aaron Fountain (*Pro Hac Vice*)
DLA Piper LLP (US)
401 Congress Avenue Ste 2500
Austin, TX 78701

CERTIFICATE OF COMPLIANCE; 37 C.F.R. § 42.24(d)

The undersigned hereby certifies that the foregoing Petition for Covered Business Method Review contains 18,508 words, excluding those portions identified in 37 C.F.R. § 42.24(a), as measured by the word-processing system used to prepare this paper. This Petition is in compliance with the 18,700 word limit set forth in 37 C.F.R. § 42.24(a)(1)(iii).

By: 

David A. Roodman, Lead Counsel
Reg. No. 35,663

CERTIFICATE OF SERVICE UNDER 37 CFR § 42.6(e)(4)

The undersigned hereby certifies that a copy of the foregoing, including any accompanying exhibits not filed under seal^{1/}, has been served via Priority Mail Express® to the Patent Owner on January 11, 2018, at the correspondence address of record for the subject patent:

Michael Adams
Corey Beaubien
E. Cicotte
Jeffrey Doyle
Michael Druzinski
William Francis
George Grove
Richard Hoffmann
Scott Hogan
Shelly Hokenstad
Eric Jones

William Kolakowski III
Stefan Osterbur
Steven Permut
Brian Ribando
Matthew Schmidt
Colleen Shovlin
Shannon Smith
James Stevens
Robin Stevenson
Steven Walmsley
Melinda Zatkoff

REISING ETHINGTON P.C.
755 W. Big Beaver Road Suite 1850
Troy, MI 48084

By:



David A. Roodman, Lead Counsel
Reg. No. 35,663

^{1/} Pursuant to 37 CFR §42.55, “the petitioner must file, but need not serve, the confidential information under seal.” Patent Owner may contact Petitioner for copies of documents filed under seal once Patent Owner agrees to be bound by the submitted protective order.