

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MIRROR IMAGING, LLC,  
Patent Owner.

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Case CBM2018-00014  
Patent 6,963,866 B2

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Before KARL D. EASTHOM, JUSTIN T. ARBES, and  
RAMA G. ELLURU, *Administrative Patent Judges*.

PER CURIAM.

DECISION

Denying Institution of Covered Business Method Patent Review  
35 U.S.C. § 324(a)

## I. INTRODUCTION

On January 11, 2018, Fiserv, Inc., Jack Henry & Associates, Inc., Q2 Software, Inc., American National Bank of Texas, and Hanmi Bank (collectively, “Petitioner”), filed a Petition (Paper 1, “Pet.”) seeking a covered business method (“CBM”) patent review of U.S. Patent No. 6,963,866 B2 (Ex. 1001, “’866 patent”), pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”).<sup>1</sup> Petitioner challenges claims 1–55 of the ’866 patent. Pet. 2. On May 3, 2018, Patent Owner, Mirror Imaging, LLC, filed a Preliminary Response (Paper 24, “Prelim. Resp.”)<sup>2</sup> opposing institution of a review.

For the following reasons, we exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition.

### *A. The ’866 Patent*

The ’866 patent discloses “a method for a financial institution to obtain electronically-stored financial documents from an off-site storage system remotely-located from an on-site storage system.” Ex. 1001, 1:15–18.

### *B. Related Cases*

On October 2, 2017, a different petitioner, Fidelity Information Services, LLC (“Fidelity”), filed a petition seeking CBM patent review challenging the same claims challenged here, claims 1–55, of the ’866 patent.

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<sup>1</sup> Pub. L. No. 112-29, 125 Stat. 284 (2011); *see also id.* at 329–31 (providing that the transitional program for covered business method patents will be regarded as a post-grant review under Chapter 32 of Title 35 of the United States Code, and will employ the standards and procedures of a post-grant review, subject to certain exceptions).

<sup>2</sup> Patent Owner filed Paper 15 as “Parties and Board Only,” and a redacted, public version of the Preliminary Response as Paper 24.

*Fidelity Information Services, LLC v. Mirror Imaging, LLC*, Case CBM2017-00064, Paper 2, 3. On April 10, 2018, we instituted a CBM patent review of claims 1–55 of the ’866 patent in that case (*i.e.*, the “Fidelity CBM proceeding”).<sup>3</sup> *Fidelity Information Services, LLC*, Case CBM2017-00064, slip op. at 44 (PTAB April 10, 2018) (Paper 21, confidential) (Paper 26, non-confidential). The Fidelity CBM proceeding, well under way, moves apace with Patent Owner’s response due shortly on July 26, 2018. *See* Fidelity CBM Paper 35.

In addition to the Fidelity CBM proceeding, Petitioner and Patent Owner collectively identify numerous related federal district court actions and USPTO proceedings relating to the ’866 patent. *See* Pet. 2–4; Papers 13, 14, 16, 22; Prelim. Resp. 46–48.

### *C. Asserted Ground of Unpatentability*

Petitioner contends claims 1–55 of the ’866 patent are unpatentable under 35 U.S.C. § 101 as directed to non-statutory subject matter. Pet. 48–87.

## II. ANALYSIS

Under 35 U.S.C. § 325(d), the Board may take into account and reject a petition because “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). In addition, 35 U.S.C. § 324(a) generally provides the Board with discretion on whether to institute. *Cf. Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under the parallel *inter partes* section, 35 U.S.C.

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<sup>3</sup> We similarly reference papers and exhibits from the Fidelity CBM proceeding with the “Fidelity CBM” prefix.

§ 314(a), which contains language similar to 35 U.S.C. § 324(a), “the PTO is permitted, but never compelled, to institute an [*inter partes* review] proceeding.”).

We considered the identical ground in the Fidelity CBM proceeding that Petitioner advances in the instant proceeding. Specifically, we instituted a CBM patent review of claims 1–55 of the ’866 patent under 35 U.S.C. § 101 in the Fidelity CBM proceeding. Fidelity CBM Paper 26, 22–41 (analyzing the claims, *inter alia*, under *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014)). Patent Owner asserts that instituting a second CBM patent review based on the instant Petition, filed “over three months” after the Fidelity CBM petition, unnecessarily “would duplicate the process” of reaching the exact same 35 U.S.C. § 101 legal issue involved in the Fidelity CBM proceeding. *See* Prelim. Resp. 2.

We agree with Patent Owner. Upon review of the record, the instant Petition presents the “same or substantially the same . . . argument[s]” regarding the § 101 challenge to claims 1–55 of the ’866 patent, as previously presented in the Fidelity CBM petition. With respect to the § 101 challenge, the instant Petition alleges under *Alice* step one that “[t]he challenged claims are directed to nothing more than the abstract idea of storing and retrieving financial documents using known information masked as a ‘parameter.’” Pet. 50. The Fidelity CBM petition presents substantially the same argument under *Alice* step one, stating “claims whose focus is organizing, storing, and retrieving information are directed to abstract ideas” (Fidelity CBM Paper 2, 46 (“Fidelity CBM Pet.”)) and representative claim 1 “recites nothing more than [an] abstract concept”—the claim “stores information based on a

categorical document parameter, receives a request, and locates and retrieves the stored information based on the categorical parameter” (*id.* at 54).

Petitioner and Fidelity also each allege under *Alice* step two that accessing two storage systems automatically (via an interlinked interface or otherwise), as allegedly required by the challenged claims, using generic purpose computers was well-known and does not transform the alleged abstract idea into an inventive concept. *Compare* Pet. 63 (asserting “[t]he claims require nothing more than off-the-shelf, general purpose, conventional computer, storage, network, and display technology”), 80 (arguing that the challenged claim limitations “‘simply arrange[] old well-known elements with each performing the same function it had been known to perform’”), *with* Fidelity CBM Pet. 59 (arguing the claimed invention “recites only generic computer components performing their conventional computer activities”), 68 (asserting “[i]nter-linked software connecting local and remote storage was conventional in existing document storage systems”), 81 (arguing “on-site and off-site storage was known in the art, as were computers for processing requests at those locations”).

The instant Petition also relies on much of the same supporting evidence in support of its § 101 challenge as the Fidelity CBM petition. For example, Petitioner and Fidelity, and their declarants, cite the same seven references in support of the contention that the challenged claims recite well-known computer components and software techniques, including references by authors Muller, D’Alleyrand, Robek et al., and Green, and including patents to Irons, Sitka et al., and Copeland et al. *See* Exs. 1027–33; Pet. 28–30, 33, 34, 42, 65, 67–69, 71, 75; Ex. 1022 ¶¶ 23, 60, 61, 65–67, 77, 80, 82, 84, 88, 95, 96, 100; Fidelity CBM Exs. 1011–14, 1018–20; Fidelity CBM Pet.

5–14, 40, 66–68, 70, 71, 73–75; Fidelity CBM Ex. 1007 ¶¶ 59, 61, 62–72, 74, 77, 78–83, 106, 123, 132–134, 138, 143, 147, 148, 152, 153.

Petitioner and Fidelity, and their declarants, also refer to the same '866 patent specification passages in support of the contention that the challenged claims do not involve an “inventive concept,” but rather that implementation of the challenged claims may be accomplished using well-known computer components and software, including an IMAGELINK system and other software systems. *See* Pet. 28, 29, 34–35, 65, 69, 78, 83, 85 (collectively citing Ex. 1001, 4:31–34, 6:31–36); Ex. 1022 ¶¶ 56, 59, 68, 77, 80, 93, 100 (collectively citing Ex. 1001, 4:31–34, 6:31–36); Fidelity CBM Pet. 11–12, 28–29, 34–35, 37–38, 65, 69, 78, 83, 85 (collectively citing Ex. 1001, 4:31–34, 6:31–36); Fidelity CBM Ex. 1007 ¶¶ 54–55, 96, 100, 122, 137, 138 (collectively citing Ex. 1001, 4:31–34, 6:31–36).

In addition, although Petitioner and Fidelity rely on supporting testimony from different declarants, *see* Ex. 1022 (declaration of William R. Michalson, Ph.D.), *with* Fidelity CBM Ex. 1007 (declaration of Stephen Gray), the respective testimony in each proceeding makes substantially similar assertions with respect to the allegedly generic nature of computing components claimed in the challenged claims. *Compare* Ex. 1022 ¶¶ 48 (“[T]he alleged solution offered by the '866 Patent is to use well-known generic computer components (*i.e.*, storage media, 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.”), 49 (“[T]he systems used in the '866 Patent could be any standard, generic storage and retrieval system.”), *with* Fidelity CBM Ex. 1007 ¶¶ 94 (“[T]he only

features recited in the claims are generic computer components, such as a ‘computer terminal,’ ‘storage system,’ ‘fixed medium,’ and ‘processing unit,’ none of which are described with any detail or specificity and therefore are neither unique nor improved upon from their pre-existing versions.”), 95 (“The claims recite the concept of on-site and off-site storage and retrieval of financial documents, but the patents acknowledge that this concept predates their filing date.”).

Patent Owner makes substantially similar arguments in response to the instant Petition and the Fidelity CBM petition, further showing the similarity in arguments made by Petitioner and Fidelity, and the supporting testimony of their declarants. For example, citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), Patent Owner responds that the claims recite statutory subject matter, contending the claims provide an inventive concept by providing the technological solution of an interface interlinked to different (*i.e.*, on-site and off-site) storage systems. *Compare* Prelim. Resp. 18–21, with Fidelity CBM Prelim. Resp. 18–19, 24. In short, both cases present substantially the same underlying facts and arguments undergirding the same § 101 challenge under *Alice* steps one and two.

As discussed above, the record shows the instant Petition presents “the same or substantially the same . . . arguments previously presented” in the Fidelity CBM petition and proceeding. *See* 35 U.S.C. § 325(d). Importantly, Petitioner does not contend that the arguments presented in the instant Petition differ from those presented in the Fidelity CBM petition.<sup>4</sup> Moreover, Petitioner neither explains why the instant Petition that asserts the same § 101

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<sup>4</sup> Nor did Petitioner timely file a motion for joinder with the Fidelity CBM proceeding pursuant to 37 C.F.R. § 42.222(b).

challenge as the previously filed Fidelity CBM petition necessitates a separate review, nor identifies a benefit in instituting a second CBM patent review of claims 1–55 of the ’866 patent based on the same statutory ground and substantially the same arguments as in the pending Fidelity CBM proceeding. For the foregoing reasons, we exercise the discretion granted under 35 U.S.C. § 325(d) to deny the Petition. *See Apple Inc. v. Smartflash LLC*, Case CBM2015-00015 (PTAB Apr. 10, 2015) (Paper 23) (denying institution of a second CBM patent review in similar circumstances).

### III. CONCLUSION

After considering the totality of the circumstances, we exercise our discretion to deny the Petition under 35 U.S.C. § 325(d).

### IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Petitioner’s request for covered business method patent review of claims 1–55 of the ’866 patent is denied and no covered business method patent review is instituted; and

FURTHER ORDERED that, because no covered business method patent review is being instituted and we do not consider or cite herein any sealed portion of any document filed in this proceeding, the parties’ Motions to Seal (Papers 7 and 23) are *dismissed* as moot, and all materials filed under seal (Paper 15, and Exhibits 1014 and 1076–1081) will be expunged from the record upon the expiration of any time for rehearing.



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