

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 CBM2018-00017  
Patent No. 7,552,118

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**MIRROR IMAGING'S PRELIMINARY RESPONSE**

Dated: April 23, 2018

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## TABLE OF CONTENTS

I.	INTRODUCTION .....	1
II.	MIRROR IMAGING AND THE '067 PATENT .....	3
III.	THE BOARD SHOULD NOT INSTITUTE CBM REVIEW.....	6
A.	Step One: The '067 patent claims patent-eligible subject matter. ....	6
1.	Legal standard.....	6
2.	Mirror Imaging's claims are not directed to an abstract idea.....	8
a)	Mirror Imaging's claims do not recite known business activities. ....	8
b)	Mirror Imaging's claims are not reducible to fundamental human activity. ....	12
c)	The Board has held that claims reciting closely similar concepts are not abstract ideas. ....	16
3.	Step Two: Mirror Imaging's claims recite an inventive concept.....	20
a)	Mirror Imaging's claims solve a specific technological problem arising in electronic financial document storage systems. ....	20
b)	The ordered combination of elements also provides an inventive concept.....	28
B.	The dependent claims further define the claims and Fiserv ignores inventive features added by these claims. ....	31
IV.	FISERV FILES THIS PETITION OVER THREE MONTHS AFTER A NEARLY IDENTICAL PETITION IS FILED AGAINST THE SAME PATENT, THE SAME CLAIMS, AND BASED ON THE SAME GROUNDS.....	33
V.	FISERV, JACK HENRY, AND Q2 LACK STANDING TO FILE THIS PETITION FOR CBM REVIEW. ....	34
A.	For a supplier to be "charged with infringement," a customer's request for indemnity does not suffice: a supplier must be <i>obligated</i> to indemnify customers accused of infringement.....	36
B.	Fiserv, Jack Henry, and Q2 have failed to show that they supplied any accused products to their alleged customers, nor that they are <i>legally</i>	

	<i>obligated</i> to indemnify those customers.....	37
1.	Fiserv removes appendices and redacts all but three paragraphs of its software agreement.....	37
2.	Jack Henry blanks-out the entire body of the agreement except a single paragraph, and its agreement indemnifies claims against customers based on a <i>valid</i> patent .....	38
3.	Q2 also redacts all but a single body paragraph of its services agreement, and its general counsel claims it supplies products not shown in its products list. ....	41
C.	<i>Every</i> named petitioner must have CBM standing at the time the petition is filed, or else CBM standing fails.....	43
D.	The petitioners’ exhibits violate established rules and procedures, their heavy redactions render them unreliable as evidence, and the Board should therefore not consider them. ....	44
VI.	THE PATENT OFFICE HAS <i>TWICE</i> CONFIRMED PATENTABILITY OF MIRROR IMAGING’S APPLICATIONS POST-ALICE.....	46
VII.	CONCLUSION .....	49

## TABLE OF AUTHORITIES

### Federal Cases

<i>Alice Corp. v. CLS Bank Int'l</i> , 134 S. Ct. 2347 (2014) .....	<i>passim</i>
<i>Arris Group, Inc. v. British Telecomms</i> , <i>PLC</i> , 639 F.3d 1368 (Fed. Cir. 2011).....	39, 40
<i>BASCOM Global Internet Services, Inc. v. AT&amp;T Mobility LLC</i> , 827 F.3d 1341 (Fed. Cir. 2016) .....	13, 25, 26
<i>Content Extraction &amp; Transmission v. Wells Fargo Bank, N.A.</i> , 776 F.3d 1343 (Fed. Cir. 2014) .....	12
<i>Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.</i> , 558 Fed. App'x. 988 (Fed. Cir. 2014) .....	11
<i>DDR Holdings, LLC v. Hotels.com, L.P.</i> , 773 F.3d 1245 (Fed. Cir. 2014) .....	<i>passim</i>
<i>Diamond v. Diehr</i> , 450 U.S. 175 (1981) .....	8
<i>Elec. Power Grp., LLC v. Alstom S.A.</i> , 830 F.3d 1350 (Fed. Cir. 2016) .....	9, 13
<i>Enfish, LLC v. Microsoft Corp.</i> , 822 F.3d 1327 (Fed. Cir. 2016) .....	<i>passim</i>
<i>In re TLI Commc'ns LLC Patent Litig.</i> , 823 F.3d 607 (Fed. Cir. 2016) .....	10, 11
<i>Intellectual Ventures I LLC v. Capital One Bank</i> , 792 F.3d 1363 (Fed. Cir. 2015) .....	26, 27
<i>Intellectual Ventures I LLC v. Erie Indem. Co.</i> , 850 F.3d 1315 (Fed. Cir. 2017) .....	13, 14, 26

<i>Internet Patents Corp. v. Active Network, Inc.</i> , 790 F.3d 1343 (Fed. Cir. 2015) .....	9, 26
<i>Mayo Collaborative Services v. Prometheus Laboratories, Inc.</i> , 132 S. Ct. 1289 (2012) .....	7, 27
<i>Mirror Imaging v. Affiliated Computer Services</i> , No. 02-73629 (E.D. Mich., 2002) .....	41
<i>McRO, Inc. v. Bandai Namco Games Am. Inc.</i> , 837 F.3d 1299 (Fed. Cir. 2016) .....	26, 27, 30
<i>Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.</i> , 811 F.3d 1314 (Fed. Cir. 2016) .....	23, 24
<i>Thales Visionix Inc. v. United States</i> , 850 F.3d 1343 (Fed. Cir. 2017) .....	14
<i>Ultramercial, Inc. v. Hulu, LLC</i> , 772 F.3d 709 (Fed. Cir. 2014) .....	7

## **Board Authority**

<i>Apple, Inc. et al. v. Mirror World Technologies, LLC</i> , CBM2016-00019, Paper 12 (May 26, 2016) .....	<i>passim</i>
<i>SAP America, Inc. v. PI-NET International, Inc.</i> , CBM2013-00013, (PTAB Sept. 8, 2011) .....	31, 33

## **Federal Statutes**

35 U.S.C. § 101 .....	6, 7
35 U.S.C. § 324(a) .....	2

## **Federal Regulations**

37 C.F.R. § 42.302 .....	32, 33
37 C.F.R. § 42.302(a) .....	31, 32

## **Other Authorities**

157 Con. Rec. S5432 (daily ed. Sept. 8, 2011).....	31
Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012).....	32

## LIST OF EXHIBITS

<b>Exhibit No.</b>	<b>Description</b>
2001	Notice and Reasons for Allowance re '854 Application
2002	U.S. Patent No. 9,928,275 to Schulze et al. (“the '275 patent”)
2003	U.S. Patent No. 9,141,612 to Schulze et al. (“the '612 patent”)
2004	U.S. Patent No. 7,836,067 to Schulze et al. (“the '067 patent”)
2005	U.S. Patent No. 6,963,866 to Schulze et al. (“the '866 patent”)
2006	U.S. App. No. 14/857,854 to Schulze et al. (“the '854 application”)
2007	IDS for the '854 application disclosing CBM
2008	'612 Patent Notice of Allowance
2009	'612 patent Image File Wrapper
2010	2014 Guidance on Patent Subject Matter Eligibility
2011	European Patent EP 0535398 to Kodak

## I. INTRODUCTION

The Fiserv, Inc., Jack Henry & Associates, Inc., Q2 Software, Inc., American National Bank of Texas and Hanmi Bank (collectively “Fiserv”) Petition for CBM review based on § 101 patentability against U.S. Patent No. 7,552,118 (“’118 patent,” attached as Ex. 1001) must be denied for three reasons.

First, the ’118 Patent articulates specific improvements to technological processes for selectively archiving and retrieving financial documents stored in separate electronic storage systems. Mirror Imaging’s claims resemble claims the Federal Circuit has found patent eligible, including those in *DDR Holdings*. The problems solved, core inventive concepts, and claims also resemble those in the CBM petition against *Mirror World*, where the Board denied institution on § 101 grounds.

Second, Fiserv (specifically, three of the five named petitioners: Fiserv, Jack Henry, and Q2) lacks standing to bring this CBM petition. These three petitioners provide only heavily redacted service agreement documents that fail to show that any of the services supplied are the ones accused of infringement against Fiserv’s alleged customers. And for a petition to have CBM standing, *all* petitioners must independently have standing—the majority do not, and the Board should deny institution for



lack of standing.

Third, Fiserv has virtually copied the arguments and basis for invalidity from a petition filed against these claims over three months ago. Allowing this petition would duplicate the process started by the other petitioner last year, waste scarce Board resources and double Mirror Imaging's expenditures to defend against redundant attacks on its patents. The Board should reject this petition because another petition presented the same arguments months earlier.

Four, the Patent Office has *doubly* confirmed that Mirror Imaging's family of patents are patent-eligible under *Alice*: (1) well *over one year* after the *Alice* decision, an Examiner amended claims and allowed the application leading to U.S. Patent No. 9,141,612 ("612 patent," attached as Ex. 2003); and (2) an Examiner recently allowed claims in another continuation and just issued U.S. Patent No. 9,928,275 ("275 patent," Ex. 2002). In fact, the Examiners of the '275 patent considered this very CBM Petition—including expert declaration and prior art—and found its § 101 arguments unavailing. Section VI elaborates on this key fact. The Examiners for these two post-*Alice* patents deliberated, interviewed, amended claims, and ultimately found that they passed § 101 muster—for the '275 patent, applying the most recent (2018) Federal Circuit caselaw and corresponding Patent Office

Guidances—and were thus patent-eligible. Mirror Imaging’s claims are therefore not abstract and do recite inventive concepts. Even if Fiserv had standing (it does not), it fails on the merits too: Fiserv has not shown “that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a) (2011). Its Petition for CBM review should be denied.

## **II. MIRROR IMAGING AND THE ’118 PATENT**

Mirror Imaging is a small business located in Warren, Michigan. The inventors of the Mirror Imaging patents, Michael D. Schulze and Richard J. Gagnon, formed Mirror Imaging to tackle an emerging and costly problem in the financial sector created by the trend toward electronic storage of financial documents.

The ’118 patent provides new systems and methods for selectively archiving and retrieving electronically stored financial documents. The family of related patents are as follows: the ’118 patent; the ’612 patent; the ’275 patent; U.S. Patent Nos. 7,836,067 (the “’067 patent,” Ex. 2004); and 6,963,866 (the “’866 patent,” Ex. 2005) (collectively the “Mirror Imaging patents”). The Mirror Imaging patents descend from a common provisional Application No. 60/129,021, filed on April 13, 1999. Each patent was issued by the Patent Office after a full and fair examination.

Examiners have already reviewed the arguments, prior art, and expert declaration of this very CBM petition in a related continuation application U.S. App. No. 14/857,854, Ex. 2006, (the “’854 application”)—and *allowed* those claims and issued the patent. *See* Ex. 2007 (IDS disclosing this CBM petition and all references cited therein, filed on February 1, 2018 during prosecution of the ’854 application); *see also* Ex. 2008 (Examiner’s Notice and Reasons for Allowance); *see also* Ex. 2002 (issued ’275 patent). Similarly, the ’612 patent was prosecuted, amended by the Examiner, and issued more than one year after the *Alice* decision.<sup>1</sup> Section VI elaborates on these key facts.

Mirror Imaging’s claims solve the specific problem of selectively archiving and retrieving financial documents stored in separate electronic storage systems by using an interface interlinked<sup>2</sup> to both storage systems.

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<sup>1</sup> Fiserv has acknowledged that the ’854 application (leading to the ’275 patent) and the ’612 patent are among the “Mirror Imaging patents,” which are “related patents” that collectively claim a priority date to the provisional application filed on April 13, 1999. Petition, 16-21.

<sup>2</sup> The claimed invention’s ability to interlink with on-site and off-site storage

*See, e.g.*, Ex. 1001 ('118 patent), 7:32-33; Ex. 2003 ('612 patent), 2:29-36.

All prior art financial document storage systems required financial institutions to use only on-site storage systems that were *not* interfaced with off-site systems, imposing high costs and causing slow retrieval, especially when a client requested an older financial document. *See, e.g.*, Ex. 1001 ('118 patent), 1:59-63; Ex. 2003 ('612 patent), 2:1-4.

Notably, even when financial institutions used both off-site and on-site storage systems, the prior art storage systems lacked an interface that interlinked with the off-site storage system. *See, e.g.*, Ex. 1001 ('118 patent), 1:64-2:4; Ex. 2003 ('612 patent), 2:5-13. Financial institutions were forced

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systems through a single interface is a core inventive concept that applies to all claims in the '118 patent. *See, e.g.*, Ex. 1001 ('118 patent), 2:21-34 (showing that the claims *require* an interface interlinked with on-site and off-site storage systems because it is *necessary* to solve a unique problem posed by prior art financial document archiving systems). So even though the words “interlinked” and “interface” need not appear in each claim (all claims inherently require this limitation), claim 26 expressly employs this language. *See* Ex. 1001 ('118 patent), claim 26; *see also* Section III.B.

to incur the same administrative burden of requesting and retrieving the off-site financial documents in-house, eliminating any efficiency in outsourcing the off-site storage system to a third party. *See, e.g.*, Ex. 1001 ('118 patent), 2:29-34, Ex. 2003 ('612 patent), 2:7-1. And no interface existed in the prior art interlinking on-site and off-site storage systems. *See, e.g.*, Ex. 1001 ('118 patent), 1:64-66; Ex. 2003 ('612 patent), 2:5-7.

Mirror Imaging's claims solve these problems by storing financial documents based on a specific document parameter in separate electronic on-site and off-site storage systems, and using an interface interlinked with each storage system. This technological solution empowers financial institutions to access and retrieve financial documents from both storage systems more quickly, efficiently, and cheaply. *See, e.g.*, Ex. 1001 ('118 patent), 3:42-46, Ex. 2003 ('612 patent), 3:35-39. The dependent claims in each patent further define the specific technological processes provided in the independent claims. Subsection III.B elaborates and provides several examples.

### **III. THE BOARD SHOULD NOT INSTITUTE CBM REVIEW.**

#### **A. Step One: The '118 patent claims patent-eligible subject matter.**

##### **1. Legal standard.**

Fiserv's Petition must be denied because Mirror Imaging's claims

satisfy the *Alice* test for patent eligibility under § 101. Patent-eligible subject matter includes “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101 (1952). The judicially recognized exceptions from this provision are for “[l]aws of nature, natural phenomena, and abstract ideas.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The Supreme Court has “set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355.

First, the court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts” (“*Alice* Step One”). *Id.* Otherwise, “the claims pass muster under § 101.” *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714 (Fed. Cir. 2014).

Second, only if the answer to the first step is “yes,” then the court must “consider 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” (“*Alice* Step Two”). *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1297 (2012)). This step asks whether the claims add an “inventive concept” that is “sufficient to

ensure that the patent in practice amounts to **significantly more** than a patent upon the ineligible concept itself.” *Id.* (internal citations omitted; emphasis added).

**2. Mirror Imaging’s claims are not directed to an abstract idea.**

**a) Mirror Imaging’s claims do not recite known business activities.**

Fiserv strips the claims of their inventive concept by reducing them to “the abstract idea of storing and retrieving financial documents based on fundamental and long-used document characteristics.” Petition, 47. Mirror Imaging’s claims overcome the problem of selectively archiving and retrieving financial documents stored in separate electronic storage systems by using an interface interlinked to both storage systems. By no means is Mirror Imaging’s technological solution a “practice long prevalent in our system of commerce.” Petition, 49 (citations omitted).

And paring Mirror Imaging’s claims down to “nothing more than the abstract idea of storing and retrieving financial documents using known information masked as a ‘parameter,’” Petition, 48, also oversimplifies the claims and departs from the actual language, an approach to the § 101 analysis prohibited by the Federal Circuit. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016) (“describing the claims at such

a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to §101 swallow the rule.”); *see also Diamond v. Diehr*, 450 U.S. 175, 189 n.12 (1981) (cautioning that overgeneralizing claims, “if carried to its extreme, make[s] all inventions unpatentable because all inventions can be reduced to underlying principles of nature which, once known, make their implementation obvious”).

*Alice* Step One must be meaningful: this step often ends the inquiry. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *see also Enfish*, 822 F.3d at 1335; *see also Alice*, 134 S. Ct. at 2354 (noting that “we tread carefully in construing this exclusionary principle [of laws of nature, natural phenomena, and abstract ideas] lest it swallow all of patent law”). Singling out individual steps to find a patent-ineligible concept does not demonstrate that the claims are abstract. *Enfish*, 822 F.3d at 1335.

Instead, a court must consider claims in light of the specification and find an abstract idea only when “their character **as a whole** is directed to excluded subject matter.” *See id.* (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)) (emphasis added). When understood this way, Mirror Imaging’s claims are not abstract.

Mirror Imaging’s claims solve the specific problem of selectively archiving and retrieving electronically stored financial documents. *See, e.g.,*



Ex. 1001 ('118 patent), 3:24-29; Ex. 2003 ('612 patent), 3:28-32. Mirror Imaging's claims solve these problems by using an interface interlinked with separate electronic storage systems that store financial documents based on a specific document parameter in those separate storage systems. *See* Sections II, III.A.2.a.

And the patent's specification *disparages* the conventional concept of storing financial documents in on-site and off-site electronic storage systems (i.e. multiple locations) that use separate (i.e. non-interlinked) interfaces and categorization methods. *See, e.g.*, Ex. 1001 ('118 patent), 2:9-22; Ex. 2003 ('612 patent), 2:14-28; *see also Enfish*, 822 F.3d at 1339 (“[T]he specification's **disparagement** of conventional data structures, combined with language describing the ‘present invention’ as including the features that make up a self-referential table” means that “we are not faced with a situation where general-purpose computer components are added post-hoc to a fundamental economic practice or mathematical equation. Rather, the claims are directed to a specific implementation of a solution to a problem in the software arts.”) (emphasis added).

Since Mirror Imaging's specification disparages the concept of “classifying and storing digital images in an organized manner” within a single, isolated system,” *see, e.g.*, Ex. 1001 ('118 patent), 2:8-11; Ex. 2003

(’612 patent), 2:14-28, Fiserv’s comparison of Mirror Imaging’s claims with *TLI*’s abstract claims is baseless. *See In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016). When Fiserv treats the claims as only providing “the storage/maintenance and retrieval of financial documents,” Petition, 64 (citations omitted), it cherry-picks the components and dodges the claims’ discrete solution to the problem posed by interlinking on-site and off-site financial document storage systems to a unified interface.

*Cyberfone*’s claims suffered from the same kind of abstractness as *TLI*’s by merely “obtaining data . . . separating it into component parts, and sending those parts to different destinations” and lacks both the interlinked interface and unified system that harmonizes on-site and off-site storage systems. *See Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 Fed. App’x. 988, 990 (Fed. Cir. 2014). Even less relevant, *DataTreasury*’s abstract claims combined the conventional concept of “transferring information from one location to another” with making the information “unreadable without a secret decoder key.” *Fidelity National Information Services, Inc., v. DataTreasury Corp.*, CBM2014-00021, 2014 WL 1729297, at \*11 (Apr. 29, 2014). These claims, like *Cyberfone*’s, lack the specific technical advancements of Mirror Imaging’s claims.

Mirror Imaging’s specification disparages the concepts found abstract

in *Cyberfone* and *DataTreasury*: classifying and transmitting data in an organized manner within a single, isolated system. *Compare* Ex. 1001 ('118 patent), 2:9-22 and Ex. 2003 ('612 patent), 2:14-28, *with Cyberfone*, 558 Fed. App'x. at 990. *DataTreasury*'s recitation of generic data encryption also "posed a risk of unacceptable preemption." *DataTreasury*, CBM2014-00021 at p. 15. No such preemption risk here, given the limiting nature of the specifications' disparagement of generic and conventional processes in the prior art. *See also* Section III.B (providing an example of how the specifications implement the technological concepts recited in the claims).

**b) Mirror Imaging's claims are not reducible to fundamental human activity.**

Fiserv again guts Mirror Imaging's claims of their inventive concept, comparing them to the routine human activity of "collecting data," "recognizing certain data within the collected data set," and "storing that recognized data in a memory." *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). Nor do the claims rely on adding a specialized machine—such as the scanner in *Content Extraction*—to an otherwise generic set of computer parts. *Id.*

The claims here go well beyond adding a scanner to the conventional process of collecting, recognizing, and storing data: the claimed invention

organizes and archives financial documents based on a parameter of the financial document itself in either an on-site or off-site electronic storage system, where the system is centralized and accessed through a single interlinked interface. Most importantly, the Examiner allowed and issued the '275 patent by accepting that the applicant had distinguished its claims over those in *Content Extraction*. Ex. 2001, 8.

Fiserv therefore cuts out the claims' requirement, in light of the specification, that both storage systems must work through an interface interlinked with both storage systems. *See, e.g.*, Ex. 1001 ('118 patent), 6:32-35; Ex. 2003 ('612 patent), 2:29-36; *see also* Section II. It does so by ignoring the claims' meaning *in light of the specification* and finding an abstract idea only when "their character **as a whole** is directed to excluded subject matter." *Enfish*, 822 F.3d at 1335 (emphasis added). Fiserv therefore oversimplifies and distorts claim elements; sidesteps the specification's technological explanations, *see* Section III.2.b; and disregards the dependent claims' further refinements. *See* Section III.B.

If we accept Fiserv's assertion that Mirror Imaging's improvements to technological processes in electronic archiving and retrieval systems are reducible to a librarian storing documents in one of two repositories based on a "certain date range" and responding to patron requests by retrieving

those documents, regardless of the unspoken claim limitations and the specification’s technological descriptions of implementation, then no patents in this field would survive *Alice* Step One, and the “exceptions to §101 [would] swallow the rule.” *Enfish*, 822 F.3d at 1327; *see also* Petition, 50-53 (providing a chart comparing the challenged claims with a library physically storing documents).

Fiserv thereby ignores claim limitations and patent disclosures—such as interlinking electronic storage systems to improve archiving technology—and equates those claims with a centuries-old, human-run library record storehouse. No authority permits this. Fiserv instead relies upon a series of “data manipulation” cases such as *Electric Power*. *See, e.g.*, Petition, 48, 57.

*Electric Power*’s claims analyzed information from a power grid by providing content and sources of information, and “select[ed] information, by content or source, for collection, analysis, and display.” *Elec. Power Grp., LLC*, 830 F.3d at 1355. Those claims provided no “*new technique* for analyzing that power grid information.” *Id.* (emphasis added).

In contrast, Mirror Imaging’s claims provide several new techniques for selectively archiving and retrieving electronically stored financial documents. *See, e.g.*, Section II; Section III.B. Unlike the prior art, these claims remove the ongoing document-management burden experienced by

financial institutions: this new technique and gain in efficiency over the prior art distinguish them from *Electric Power*'s claims. Mirror Imaging's claims thereby provide the "new technique[]" and "inventive programming" that go beyond "select[ing] and manipulate[ing]" information. *Id.*

Fiserv also suggests that data gathering and processing does not become non-abstract when limited to the field of financial transactions. Petition, 7363 (citations omitted). But *Credit Acceptance*'s claims differ from Mirror Imaging's claims in both subject matter (automating the "previously manual processing of loan applications") and in its failure to implement any technical improvement to its inventory database. *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017). Nor did *Credit Acceptance*'s specification disclose anything other than the conventional process of receiving financial information from a customer and processing the application based on that information. *Id.*

The claims here, unlike those in *Credit Acceptance*, do not automate the responsibilities of a loan officer (or any human-capable activity) that manages a physical database of customers' financial information. Rather, the claims require an integrated pair of on-site and off-site electronic storage systems that archive financial documents based on a predetermined document characteristic, through a unified system and accessible through a

single interlinked interface. *See, e.g.*, Ex. 1001 ('118 patent), 7:32-35; Ex. 2003 ('612 patent), 2:29-36; *see also* Section II.

Departing even further from Mirror Imaging's claims, *Clarilogic's* claims "collect[], analy[ze], and generat[e] information reports," when "the algorithm engine mentioned in the claim is not claimed, identified, or explained." *Clarilogic, Inc. v. Formfree Holdings Corp.*, 2016-1781 (Fed. Cir., 2017). Mirror Imaging's algorithm for processing, storing, and retrieving financial documents is found *in the language of the claims* and extensively described in the specification. *See, e.g.*, Section II.

Thus, Fiserv both misconstrues *Alice* Step One and fails to identify any abstract idea with enough specificity for a meaningful inquiry. *See Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1347 (Fed. Cir. 2017).

**c) The Board has held that claims reciting closely similar concepts are not abstract ideas.**

The unsuccessful CBM Petitioner in *Mirror World* leveled a similar § 101 argument against the challenged claims: they "are directed to the abstract idea of organizing items of information, i.e., 'data units,' in chronological order." *Apple, Inc. et al. v. Mirror World Technologies, LLC*, CBM2016-00019, Paper 12, p. 13 (May 26, 2016) ("*Mirror World* Board Decision"). Like the interlinked off-site (or first) and on-site (or second)

electronic document archiving system here, *Mirror World*'s claims involved using two channels to archive electronic information: a "main stream" and "substreams" to solve the problem of "organizing and finding electronic data units." *Id.* at 14.

In rejecting the Petitioner's position, the Board found the *Mirror World* patent solved several problems that "did not exist in the pre-computer world." *Id.* Each problem is analogous to those post-computer problems solved by the '118 Patent:

<b>Mirror World's Post-Computer Problem</b>	<b>Mirror Imaging's Technological Solution</b>
"naming and locating documents based on document name" <sup>3</sup>	The claimed system organizes, stores, and retrieves electronic images of financial documents in one of two storage systems based upon the value of a "specific document parameter." <i>See, e.g.</i> , Ex. 1001 ('118 patent), claims 1, 12, 13, 15, 16, 17, 18, 23.
"enabling multi-level branching tree folder systems"	An interconnected system of folders, i.e. digital storage locations, is much like the '118 Patent's interlinked system of on-site and off-site storage systems. <i>See, e.g.</i> , Ex. 1001 ('118

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<sup>3</sup> *Mirror World* Board Decision at p. 14. The other quotations below (left-hand column) are from this same citation.



Mirror World’s Post-Computer Problem	Mirror Imaging’s Technological Solution
	patent), claim 26.
“searching for documents created by different applications”	The financial document archiving system accepts electronic financial documents that were created by other applications and identifies a specific document parameter, including record date, to rationally organize those documents within an on-site or off-site storage system. <i>See, e.g.</i> , Ex. 1001 (’118 patent), claims 1, 12, 13, 15, 16, 17, 18, 23.
“archiving electronic documents”	Archiving electronic financial documents is a core function, including the ability to, for example, store and retrieve the most recent and therefore frequently accessed financial documents into an on-site storage system and store the older financial documents into an off-site storage system, based on a predetermined record date. <i>See, e.g.</i> , Ex. 1001 (’118 patent), claims 1, 12, 13, 14, 15, 16, 17, 18, 23.

*Mirror World* Board Decision at p. 14 (explaining that the four problems solved “did not exist in the pre-computer world”).

The Board was “not persuaded” by the Petitioner’s argument that the challenged claims recited only a “general purpose computer to perform an abstract process — organizing information in chronological order without claiming any technological improvement to the computer itself.” *Id.* at 15.

Rather, the Board concluded that, like the claims in *DDR*, the *Mirror World* patent provided a solution to a problem “necessarily rooted in computer technology” and thus not abstract under Alice Step One. *See id.* at 14-16; *see also* Section III.A.2.a (demonstrating the close likeness of Mirror Imaging’s claims to those in *DDR Holdings*). The Board also compared the claims to those in *Enfish* and was persuaded that the challenged claims of the *Mirror World* patent are directed to an “improvement in computer functionality.” *Id.* at 16-17 (citing *Enfish*, 822 F.3d at 1336).

The Board found further evidence of an inventive concept where core components of the invention—the “main stream” and “substream”—were newly coined by the inventors. *Id.* at 14. The ’118 Patent inventors also coined the term of a core feature—“interlinked”—to describe the unified interface system allowing for harmonized storage and retrieval of financial documents from on-site and off-site storage systems. *See* Ex. 1001 (’118 patent), 6:32-35.

And the Board also admonished the Petitioner for the same mistaken reasoning as *Fiserv*: “isolating individual claim elements separately abstracting each step of the claim, and never considering the claim as a whole.” *Id.* at 15 (internal marks omitted). Just as *Fiserv* has compared isolated steps of the claims to functionally-limited prior art storage

applications such as IMAGELINK<sup>TM</sup> (*see, e.g.*, Petition, 64, 68), the Board found the *Mirror World* petitioner's same approach "in relation to MEMOIRS and other art . . . flawed and therefore not persuasive." *Id.* at 15 (internal citation omitted).

Given the striking similarity of Mirror Imaging's claims, core inventive concepts, and the petitioner's "flawed" and "not persuasive" § 101 arguments to those in *Mirror World*, the Board should reach the same conclusion here and deny CBM institution on all grounds.

**3. Step Two: Mirror Imaging's claims recite an inventive concept.**

**a) Mirror Imaging's claims solve a specific technological problem arising in electronic financial document storage systems.**

Even if the Board finds that Mirror Imaging's claims are directed to an abstract idea, the claims would still fall within the realm of an inventive concept post-*Alice*. The problem and solution claimed here fit the description of *DDR Holdings*'s claims, which provided a hybrid web page for "product information from [a] third-party merchant, but retains the host website's 'look and feel.'" *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014).

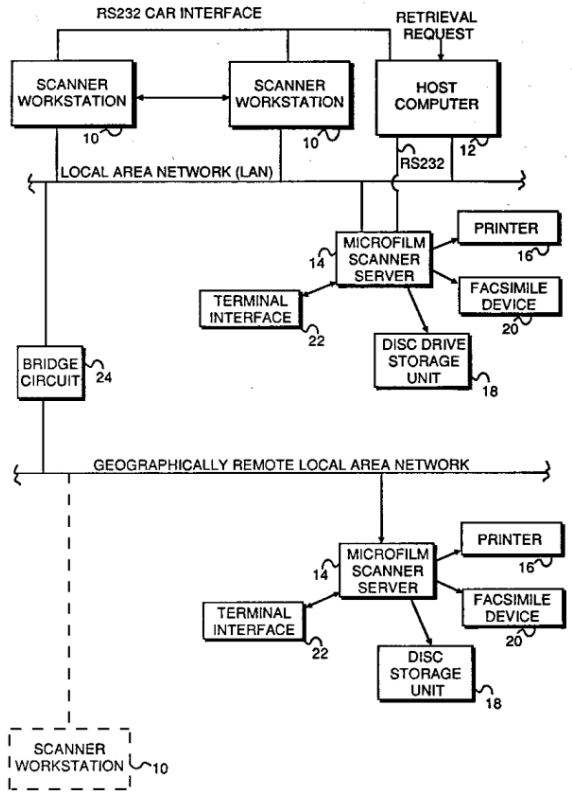
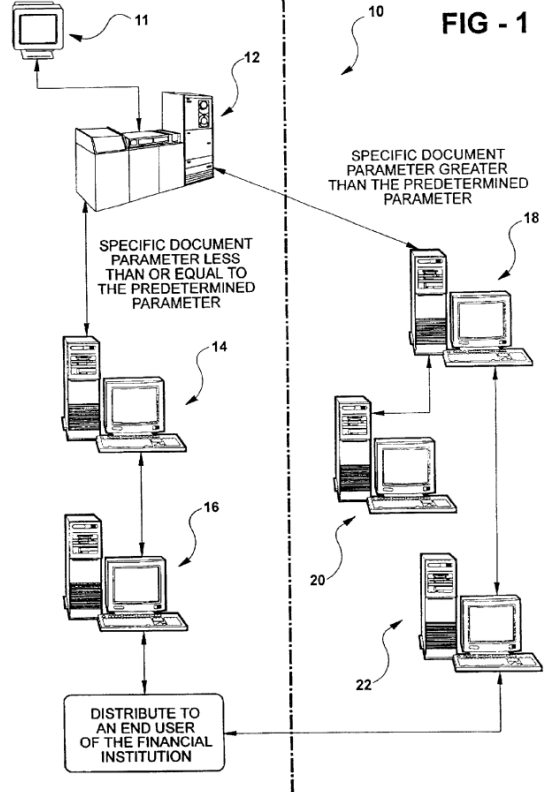
Those claims recited a technological solution to challenges arising in computer networks. *Id.* at 1248. Similarly, Mirror Imaging's claims provide

a hybrid on-site and third-party off-site storage solution within a single interface (like *DDR Holdings*'s single web page interface) interlinked with both storage systems. These claims thereby achieve a technological solution to challenges arising from electronic financial document archiving and retrieval by allowing financial institutions to offload that document-management burden onto third parties by using an interlinked and unified interface. *See also* Section III.A.2.c (showing that the Board has denied CBM institution on claims similar to those in *DDR Holdings* and those in the '118 Patent).

Fiserv's contention that the claims recite "nothing more than the use of generic computers accessing one of two storage systems" is not sufficient. Petition, 28 (citations omitted). *Alice* Step Two requires more than recognizing that each claim element, by itself, was known in the art. *Id.*

The Kodak IMAGELINK<sup>TM</sup> system (the "Kodak system") exemplifies a prior art digital storage system that could not overcome a unique problem in the field of financial document storage: the ability to store, organize, and retrieve financial documents based on a *predetermined* document parameter in off-site (or first) and on-site (or second) storage systems through an interlinked and unified interface. Ex. 2011 (disclosing the Kodak system in European Patent No. 0535398); *see also* Ex. 1001, 9:12-15 (the '118 patent

specification discusses the narrow utility of the Kodak system by showing how the claimed system improves and fundamentally expands that functionality). A side-by-side comparison of the Kodak system and Mirror Imaging's financial document archiving system brings the latter's inventive concept into stark relief.

Kodak system	Mirror Imaging system
 <p style="text-align: center;"><b>FIG. 1</b></p>	 <p style="text-align: center;"><b>FIG - 1</b></p>
<p>Ex. 2011, Fig. 1.</p> <p><b>Location.</b> Kodak provides a single <b>on-site</b> digital image storage system with two sets of Scanner Workstations 10 and corresponding</p>	<p>Ex. 1001, Fig. 1.</p> <p><b>Locations.</b> Mirror Imaging provides an <b>on-site</b> financial document archiving system within a financial insitution, and an <b>off-site</b> financial</p>

Kodak system	Mirror Imaging system
output devices (16, 18, 20) that are connected over a single local area network. Ex. 2011, Fig. 1.	document archiving system at an outsourced location. Ex. 1001 ('118 patent), Fig. 1.
<p><b>Request and sorting.</b> The storage and sorting of scanned digital images produced from microfilm is <b>not</b> based upon a predetermined document parameter, but instead is based upon user-specified criteria inputted into the host computer 12. A retrieval request for specific microfilm rolls (which are manually sorted in a physical microfilm library) is inputted into the host computer 12. <i>Id.</i>, 5:10-13.</p> <p>This request from host computer 12 “instruct[s] scanner workstation [10] operators to load a specific roll of microfilm.” <i>Id.</i>, 5:31-37. This request from host computer 12 also <b>manually</b> specifies which microfilm scanner server 14 the scanned digital images will be sent to and <b>manually</b> specifies the name of the <b>folder</b> and the <b>document name</b><sup>4</sup> where the scanned</p>	<p><b>Request, sorting, and storage.</b> A financial document is stored in an on-site storage system if, for example, the document has a record date (a predetermined parameter) that is equal or less than one year. <i>Id.</i>, 5:4-19. The document is otherwise stored in an off-site storage system, preferably provided by a third-party to eliminate back office production for such older, archived financial documents. <i>Id.</i></p>

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<sup>4</sup> The scanned images are organized and identified based on *nothing more* than the user-provided folder and document names: “[t]he folder name is used to link the folder to a specific retrieval request. Using the folder

Kodak system	Mirror Imaging system
images will be placed within that server. <i>Id.</i> , 5:50-6:7; 6:20-25.	
<p><b>Output.</b> A user makes a request through host computer 12 (after the scanned documents were placed in the specified folders within one of two microfilm scanner server 14) to direct the output of the requested images to any of the output devices (16, 18, 20) attached to the microfilm scanner server 14. <i>Id.</i>, 6:8-14.</p>	<p><b>Retrieval.</b> The computer terminal 11 receives a request (e.g., for a deposited check) in computer terminal 11 at a financial institution, and the request is fed into the bank's mainframe computer 12. <i>Id.</i>, 5:31-40; <i>see also</i> claims 1,18, 33, 43, 53, and 61. If the requested check is equal or less than one year old, then the request is processed in the bank's on-site storage system. <i>Id.</i>, 5:40-45. This allows banks to address the most common requests, those for financial documents up to one year old, in-house. <i>Id.</i>, 5:53-55. Otherwise, requests for older checks are <b>automatically</b> and completely offloaded, processed and retrieved from an off-site storage system. <i>Id.</i>, 5:59-60. This way, a bank is able to</p>

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concept, which forms a relation between the request and the documents it will come to contain, the folder provides the ability to group documents together which would otherwise have no relationship to one another.” *Id.*, 6:25-32.

Kodak system	Mirror Imaging system
	outsource the most expensive instances of financial document retrieval—those that are over one year old—but maintain the ability to retrieve those financial documents, whether stored in the on-site or off-site storage system, within an interlinked and unified interface. <i>Id.</i> , 5:60-66.

The above comparison shines an unflattering light on Fiserv’s assertion that the Kodak system, and others like it, disclosed Mirror Imaging’s claimed system and “were well known in the art prior to the alleged invention of the ’118 Patent.” Petition, 68. Those systems *do not* disclose the financial document archiving system that finally allowed banks to outsource older documents and in-source high-demand, newer documents through a unified, harmonized, and interlinked system. Mirror Imaging’s invention achieved that.

Fiserv also deploys *Versata*, whose claims use a “generic computer” to manipulate product pricing information by “storing, retrieving, sorting, eliminating and receiving.” *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1334 (Fed. Cir. 2015). Instead of *Versata*’s computer running conventional software that stores information within a single storage system,



Mirror Imaging’s claims build a novel idea into the hardware architecture *itself*: the claimed invention receives financial documents to archive in separate electronic storage systems, locally or remotely, based on a specific document parameter within an integrated system, and those separate storage systems are interlinked through a single interface. *See, e.g.*, Ex. 1001 (’118 patent), 7:60-63; Ex. 2003 (’612 patent), 2:29-36; *see also* Section II.

Fiserv employs *Mortgage Grader*—involving claims found abstract at *Alice* Step One—to try to show that the Mirror Imaging’s claims fail under *Alice* Step Two. To begin with, because it concerns *Alice* Step One, *Mortgage Grader* has no place in a Step Two analysis. *Mortgage Grader*’s claims, unlike those here, provided a method for anonymous loan shopping: it simply collected information to generate a credit rating (a task doable with pencil and paper), and attempted to create an inventive concept by adding generic computer components such as an interface, network, and database. *See Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324 (Fed. Cir. 2016).

Fiserv draws a strained comparison to Mirror Imaging’s claims. And while *all limitations* of *Mortgage Grader*’s claims “could all be performed by humans without a computer,” Fiserv plucks an example where a court found a *single* limitation (inputting information in a terminal) where “human

intervention is necessary.” Petition, 64; Ex. 1013 (citing a claim construction order in a district court case for a related Mirror Imaging patent that Fiserv has not challenged: *Mirror Imaging v. Affiliated Computer Services*, No. 02-73629 (E.D. Mich., 2002)).

And that same court found that the step of “comparing the specific document age of the requested financial document to the predetermined age” *does not require human intervention* and “can be accomplished . . . by some other means.” Ex. 1013, 17-18 (defining “automatically” as “without human intervention” with respect to independent claim 18 and dependent claims 19-32). The *Affiliated Computer Services* court therefore *rejects* Fiserv’s contention that the claims’ steps “require human intervention and manual performance.” Petition, 73. Fiserv later mentions in passing that claim 33 forbids “user intervention” for the step of utilizing a processing unit connected to the storage systems. Petition, 74. It ignores this limitation here to avoid undercutting its own argument. *See* Ex. 1001, claim 33. Dodging claim limitations and distorting prior claim construction, Fiserv’s comparison with *Mortgage Grader* fails.

The claims here solve the specific problem of selectively archiving and retrieving financial documents stored in separate electronic storage systems by using an interface interlinked to both storage systems. Mirror

Imaging’s claims are thus “specifically tailored to solve discrete problems that existed at the time,” do not use generic computer components, and, therefore, embody an inventive concept. *See BASCOM*, 827 F.3d at 1350.

**b) The ordered combination of elements also provides an inventive concept.**

Mirror Imaging’s claims also resemble those in *BASCOM*, which satisfied *Alice* Step Two. *BASCOM*’s claims provided an installation of a content filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user. *See BASCOM*, 827 F.3d at 1350. This particular arrangement of conventional elements represented a technological improvement over prior art methods of filtering content. *Id.* Similarly, Mirror Imaging’s claims recite an inventive combination and arrangement, because they provide an unconventional technological solution to the problem of traditional financial document archiving and retrieving systems. These claims also involve a separate or off-site storage system, remote from the financial institution, while providing an interface interlinking both on-site and off-site storage systems.

Fiserv also errs by focusing on the allegedly “generic” language of individual steps. Mirror Imaging’s claims do not patent individual steps. Rather, claims must be considered in their entirety, and found ineligible only

when their character *as a whole* is directed to excluded subject matter. *See McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (citing *Internet Patents Corp.*, 790 F.3d at 1346). When viewed holistically, Mirror Imaging’s claims solve a specific problem that financial institutions faced in financial document storage and retrieval.

That Mirror Imaging’s claims use known computer functions to execute steps performed by a computer does not mean that its claims fail to recite an inventive concept. An inventive concept may lie “in the non-conventional and non-generic arrangement of known conventional pieces.” *BASCOM*, 827 F.3d at 1349.

Fiserv commits the same error when it compares the claims here with those in *Erie*. In that case, “the claims [did] not sufficiently recite how the inclusion of XML tags or metadata leads to an improvement in computer database technology,” distinguishing them from the non-abstract claims in *BASCOM*. *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1329 (Fed. Cir. 2017). The abstract claims in *Erie* do not resemble Mirror Imaging’s claims for three reasons.

First, Mirror Imaging’s claims avoid the vague concept of executing conventional code based on user input. These claims solve the specific problem of selectively archiving and retrieving financial documents stored in

separate electronic storage systems by using an interface interlinked to both storage systems. *See, e.g.*, Ex. 1001 ('118 patent), 3:19-28; Ex. 2003 ('612 patent), 2:29-36. Second, the specification details the implementation of this technological solution. *See* Section II; *see also* Section III.A.2.b. Third, the dependent claims further define and extend the patent's inventive concepts. *See* Section III.B.

Nor do the claims here resemble *Capital One's* abstract claims: those claims simply employed generic computers to more efficiently “track[] financial transactions to determine whether they exceed a pre-set spending limit.” *Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d 1363, 1367 (Fed. Cir. 2015). Unlike *Capital One's* claims, which simply speed up budgeting calculations that could be done by hand, *Capital One Bank*, 792 F.3d at 1368, the '118 patent provides: (1) a solution to the specific problem posed by interlinking on-site and off-site financial document storage systems to a unified interface—a feat no human could perform; and (2) a specification with technical descriptions of how to implement those solutions. *See, e.g.*, Section II; *see also* Section III.A.2.b.

Thus, Fiserv has buried the inventive concepts by disregarding claim limitations and failing to consider them as an ordered combination. It dissects the claims, ignores their totality, and thereby misapplies the law.

*See Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297); *McRO*, 837 F.3d at 1313 (“[I]n determining the patentability of a method, a court must look to the claims as an ordered combination, without ignoring the requirements of the individual steps.”).

**B. The dependent claims further define the claims and Fiserv ignores inventive features added by these claims.**

The dependent claims provide additional details that show the claims in each patent are not abstract. Dependent claim 26, for example, expressly describes that the on-site and off-site storage systems are “inter-linked” through a single interface. Ex. 1001 (’118 patent), claim 26.

Not only does Fiserv ignore the interlinking interface limitation of claim 26, it denies its existence: as for “a direct interface inter-linked with [an] off-site storage system . . . no such ‘interface’ is claimed.” Petition, 32-33 (citations omitted). Claim 26 requires that the processing steps are controlled by an “interlinked computer program,” and depends on independent claim 23, reciting a computer terminal (necessarily providing an interface) when “submitting a request . . . into the computer terminal” “associated with the financial institution and connected to the off-site and on-site storage systems through a processing unit.” Ex. 1001, claims 23, 26 (emphasis added).

Yet Fiserv suggests that claim 26 does nothing more than “recite the additional step of ‘reproducing the requested financial document.’” Petition, 80. The claim language belies that assertion. And Fiserv’s cursory review of the claims and specification disclosures also fails to even mention the added technological implementation of the claimed interlinked interface. The ’118 specification technically details an embodiment to show how this document-selection interface is implemented.

When the particular numerical sequence of the financial document is greater than the predetermined numerical value, the employee selects an exit function at the primary interface. The exit function distinguishes that the request is to be sent to an outsourcing third party entity. Upon selection of the exit function at the primary interface, a secondary interface, inter-linked with the exit function, is initiated. The secondary interface is inter-linked with the off-site storage system.

Ex. 1001, 7:55-64.

Fiserv ultimately fails to consider any of the dependent claims *as a whole*—let alone all of their limitations—and in light of their added technical recitation. *See McRO, Inc.*, 837 F.3d at 1312. Instead, it singles out individual steps of those dependent claims to find a supposedly patent-ineligible concept, an approach prohibited by the Federal Circuit. *Enfish*,

822 F.3d at 1335.

**IV. FISERV FILES THIS PETITION OVER THREE MONTHS AFTER A NEARLY IDENTICAL PETITION IS FILED AGAINST THE SAME PATENT, THE SAME CLAIMS, AND BASED ON THE SAME GROUNDS.**

Fiserv has copied the arguments and basis for invalidity from a petition filed against these claims over three months ago. *See Fidelity Information Services, LLC v. Mirror Imaging, LLC*, Case CBM2017-00065 (Paper 2) (petition filed on October 2, 2017) (“FIS Petition”). The Board should reject this petition because the FIS Petition presented the same arguments months earlier. 35 U.S.C § 325(d) (2011) (“In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the **same or substantially the same prior art or arguments** previously were presented to the Office.”) (emphasis added).

Fiserv breaks no new ground, challenging the claims based on § 101 with nearly identical caselaw (among these, all of the same seminal Federal Circuit § 101 cases such as *Content Extraction, TLI, Mortgage Grader*, and *Electric Power*) and analysis. *Compare FIS*, CBM2017-00065 (Paper 1) (Petition), v-vii (listing cases in the table of authorities), *with* Petition, iv-viii (Fiserv’s cases, particularly the seminal Federal Circuit cases relating to § 101, mirror those found in the FIS petition). The PTAB has already rendered



an institution decision on FIS’s petition against the challenged patent here.

*FIS*, CBM2017-00065 (Paper 23) (institution decided on April 19, 2018).

Allowing this petition would duplicate the process started by FIS last year, waste scarce Board resources and double Mirror Imaging’s expenditures to defend against redundant attacks on its patents.

**V. FISERV, JACK HENRY, AND Q2 LACK STANDING TO FILE THIS PETITION FOR CBM REVIEW.**

These three parties purport to have standing based on (1) Mirror Imaging suing their privies, and (2) being charged with infringement under the challenged patent. Both theories fail, and *all* named parties must satisfy the CBM standing requirements or else “the petitioner” lacks standings.

*Acxiom Corp. v. Phoenix Licensing, LLC*, Case CBM2015-00068 (PTAB Aug. 11, 2015) (Paper 23), reh’g. denied (PTAB Oct. 29, 2015) (Paper 26).)

Generally, a petitioner for CBM review lacks standing “unless the petitioner, the petitioner’s real party-in-interest, or **a privy of 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) (2012). (emphasis added). The Board has defined the phrase “a privy of the petitioner” in the context of its legislative history:

As originally adopted in the Senate, subsection (a)(1)(B) only allowed a party to file a section 18 petition if either that party or

its real parties in interest had been sued or accused of infringement. In the House, this was expanded to also cover cases where a “privy” of the petitioner had been sued or accused of infringement. A “privy” is a party that has a direct relationship to the petitioner **with respect to the allegedly infringing product or service.**

*SAP America, Inc. v. PI-NET International, Inc.*, CBM2013-00013, slip op. at 4 (PTAB Sept. 8, 2011) (Paper 15) (quoting Senator Schumer at 157 Con. Rec. S5432 (daily ed. Sept. 8, 2011)) (emphasis added).

Rule 42.302(a) describes “charged with infringement” as meaning “a real and substantial controversy regarding infringement of a covered business method patent . . . such that the petitioner would have standing to bring a declaratory judgment action in Federal court.” 37 C.F.R. § 42.302(a) (2012). The Patent Office explained in comments to the final rules governing covered business method patent review that “[f]acially improper standing is a basis for denying the petition without proceeding to the merits of the decision.” *Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680, 48,709 (Aug. 14, 2012) (Response to Comment 102).

**A. For a supplier to be “charged with infringement,” a customer’s request for indemnity does not suffice: a supplier must be *obligated* to indemnify customers accused of infringement.**

An accused infringing customer’s request for indemnity—without a supplier’s *legal obligation* to indemnify—does not establish declaratory judgment jurisdiction. *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 904 (Fed. Cir. 2014) (explaining that the supplier would “stand in the shoes of the customers and would be representing the interests of their customers because of their legal obligation to indemnify.”). *DataTern* instructs that a customer’s request does not establish declaratory judgment jurisdiction without the supplier’s valid indemnity obligation: if a court improperly allowed this, the scope of such jurisdiction under Federal Circuit precedent would “broaden[] . . . quite substantially.” *Id.*

Though Fiserv argues (without supporting caselaw) that it would have been “charged with infringement” *without* an indemnity obligation, it quotes controlling caselaw which *requires* an indemnity obligation when a supplier’s customer is sued. Petition, 41 (citing *GSI*, which in turn quotes *Arris*); see *Arris Grp., Inc. v. British Telecomms. PLC*, 639 F.3d 1368 (Fed. Cir. 2011) (“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**”) (emphasis added).

As shown below, none of the supplier-parties to the petition have a legal obligation to indemnify their alleged customers.

**B. Fiserv, Jack Henry, and Q2 have failed to show that they supplied any accused products to their alleged customers, nor that they are *legally obligated* to indemnify those customers.**

Each alleged software supplier relies on almost *entirely* redacted customer software agreements that deny the Board and the patent owner the necessary context to confirm their veracity. These parties have made it impossible for the Board and Mirror Imaging to review the entire customer software agreements for conflicting provisions, qualifications, addenda, or other requirements that could radically alter or even reverse the effect of the visible text.

**1. Fiserv removes appendices and redacts all but three paragraphs of its software agreement.**

Fiserv completely removed Appendix A, which lists the very software subject to the Software License Agreement. Ex. 1020, 1. What remains is Fiserv’s general counsel’s testimony, swearing that: “Austin Bank uses the Fiserv Products in the Austin Bank online banking system. *See* Ex. 1020,

Agreement.” Ex. 1017, ¶ 10. But the Fiserv attorney cites its customer agreement while referring to a section—Appendix A, which allegedly lists the accused software—that Fiserv *removed* from the exhibit. Fiserv expects the Board to rely on the *petitioner’s words alone* to establish a material element of standing: that the software Fiserv supplied is the *accused* infringing software.

Likewise, one has no idea whether the indemnity provision applies to Austin Bank’s accused online banking system, when Fiserv fails to show that it has supplied that system. Fiserv reveals *only three paragraphs* of a six-page agreement, whiting-out all other text, removing appendices, and leaving us wondering what else was left out.

**2. Jack Henry blanks-out the entire body of the agreement except a single paragraph, and its agreement indemnifies claims against customers based on a *valid* patent**

Jack Henry’s Software Agreement with ANBTX—i.e. the single body-paragraph saved from redaction—says nothing about the software Jack Henry supplies. Jack Henry’s counsel testifies that “ANBTX uses JHA Products for an e-statement service of its online banking system,” and references Jack Henry’s master software license agreement. Ex. 1040, ¶¶ 6, 9. Strikingly, counsel fails to even allege that any *component* of ANBTX’s

online banking system accused of infringement includes a product supplied by Jack Henry:

9. I understand that ANBTX's online banking system has been accused of infringing certain claims of the Asserted Patents. Ex. 1041 at ¶¶ 21-58. (ANBTX Complaint). I also understand that ANBTX uses JHA Products for an e-statement service of its online banking system.

Ex. 1040, ¶¶ 6, 9. The "e-statement service" cannot comprise ANBTX's *entire* online banking system, nor does counsel suggest this is so. Jack Henry has thus failed to allege that its supplied product is what Mirror Imaging has actually accused of infringement, rather than one provided by ANBTX directly.

Even worse, Jack Henry relies upon an indemnity provision requiring that the third-party claim arise from the provided "Software" and "infringe any **valid** United States . . . patent." Ex. 1052, 7; Ex. 1040, ¶ 7 (testifying that under this agreement, "[Jack Henry] is obligated to indemnify ABTX . . . from claims that ANBTX's use of Products allegedly infringes [Mirror Imaging's] patent") (emphasis added). Mirror Imaging agrees that Jack Henry challenges a valid patent. But Jack Henry is estopped from invoking an indemnity provision requiring a *valid* patent so it can pursue CBM

standing in order to argue that same patent is *invalid*.

Nor does the “more formal[] and specific Defense and Indemnity Agreement” entered into after ANBTX’s request actually require indemnity here. Ex. 1040, ¶ 13; Ex. 1063. The preamble states that the customer requested indemnity “pursuant to the terms of the License Agreement” and Jack Henry “desires to provide protections” for its customer “with respect to the Lawsuit **subject to the terms and conditions in the License Agreement as more specifically outlined in this agreement.**” Ex. 1063, p. 1 (emphasis added). Though Jack Henry agreed to defend ANBTX pursuant to their *existing* license agreement (Ex. 1052), this indemnity agreement (Ex. 1063) adds no new obligations. Jack Henry even reserves the right to withdraw from defending ANBTX if the “claims against Customer in the Lawsuit do not, in any way, in whole or in part, arise out of the Software and/or Services provided by JBA to Customer pursuant to the terms of any agreement between the parties, including the License Agreement.” Ex. 1063, p. 3, § 1(f). Jack Henry defends ANBTX against what it (incorrectly) believes is an invalid patent: it has no legal obligation to indemnify ANBTX under any provided agreement. Absent a legal obligation to indemnify (which it does not have), Jack Henry would not have declaratory judgment standing and therefore was never charged with infringement.

And as with Fiserv, Jack Henry’s counsel relies on its software agreement to show that Jack Henry supplies ANBTX with an “e-statement” service. *See* Ex. 1052. But because Jack Henry whited out all but a single paragraph, the agreement says nothing about what software Jack Henry provides its customer. This petitioner counsel’s word alone—relying on redacted text about software services impossible to confirm—falls far below any reasonable standard of evidence and cannot establish Jack Henry’s CBM standing.

**3. Q2 also redacts all but a single body paragraph of its services agreement, and its general counsel claims it supplies products not shown in its products list.**

Like the others, Q2 provides a services agreement revealing a *single* body paragraph and snippets of a single attachment—it blacks out everything else. Q2 also fails to authenticate the service agreement with Hanmi (Ex. 1074) and an indemnity letter Q2 allegedly sent Hanmi (Ex. 1076). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

attached no such exhibits, nor has it separately filed any lettered exhibits (only numbered exhibits). We have no idea whether the “attached” exhibits



that the counsel reviewed perfectly correspond with exhibits 1076 (agreement) and 1077 (letter). It's Q2's burden to properly identify and authenticate its exhibits—not the reader's burden to guess what Q2 meant to do.

Even if the Board considers Q2's unauthenticated services agreement (Ex. 1076) and letter (1077), these documents do not establish standing. ■



petition is filed. Acxiom does not direct us to persuasive authority to the contrary. **A contrary interpretation would allow a person without standing readily to circumvent the statutory requirement for standing by simply associating, for purposes of filing a CBM petition, with a person that does have standing.** Thus, each petitioner must have standing at time of filing, and if instituted, the case will proceed procedurally with the multiple petitioners treated as a single entity, as was done in *Agilysis* and *Fandango*.” (*Acxiom*, CBM2015-00068 (Paper 26), slip op. at 6 (emphasis added)).

Co-petitioners that have standing also cannot confer standing on those without standing: “Acxiom’s unrelated co-petitioners, Ford Motor Company and AT&T Mobility, cannot confer their standing on Acxiom.” *Id.*, slip op. at 7.

The co-petitioners Fiserv, Jack Henry, and Q2 lack standing. Their petition must be dismissed.

**D. The petitioners’ exhibits violate established rules and procedures, their heavy redactions render them unreliable as evidence, and the Board should therefore not consider them.**

Fiserv, Jack Henry, and Q2’s heavily redacted exhibits—the documents required to show that they supplied *any* services to their customer banks—fall below any minimum standard of reliability as evidence.

The Board has admonished a petitioner, in a series of virtually identical CBMs filed against Mirror Imaging’s patents (including this one), that filing redacted exhibits in this matter violates the rules and procedures

of the Patent Office. *See Fidelity Information Services, LLC v. Mirror Imaging, LLC*, Case CBM2017-00066 (Paper 13), slip op. at 2. There, just like here, the supplier-petitioner Fidelity Information Services (“FIS”) filed heavily redacted service agreements and order forms to purportedly establish that it supplied the infringing products and must indemnify its customer banks. *Id.*

The Board criticized FIS for violating the rules and the trial practice procedures by filing only redacted exhibits. *Id.*, slip op. at 4 (“Petitioner should have filed unredacted confidential versions of the Exhibits with its Petition (*see* 37 C.F.R. §§ 42.14, 42.55; *supra* note 3).”); *see also id.*, slip op. at 2, n.3 (explaining that under 37 C.F.R. § 42.14, a document containing confidential information must be filed under seal); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48770 (Aug. 14, 2012) (requiring that a party must move to seal any confidential document and must explain why the redactions are confidential).

The Board’s criticism against Fiserv applies with equal force against the petitioners here. Under either of Fiserv’s theories of CBM standing (whether being charged with infringement or being in privity with customers), Fiserv must show that it supplied the alleged infringing products. It cannot do so with the almost-entirely-redacted (and rules-

violating) services agreements filed with its petition.

What remains to support the petitioners' standing is the testimony of their general counsel. That would mean allowing a petitioner to have CBM standing for supplying allegedly accused customer products *based on the petitioner's word alone*. But those declarations rely on provisions of the services agreements as the *only* basis for a contractual indemnity obligation and for having sold the alleged infringing products to the customer banks. *See* Section IV.B.

Fiserv has therefore failed to meet its burden to allege concrete facts to support any basis for declaratory judgment standing arising from the underlying Mirror Imaging litigation. Fiserv has no standing to petition the Board for CBM review over the Mirror Imaging patents, and therefore institution must be denied.

## **VI. THE PATENT OFFICE HAS *TWICE* CONFIRMED PATENTABILITY OF MIRROR IMAGING'S APPLICATIONS POST-ALICE**

The Patent Office has freshly reviewed—over the past two months during the '854 application's prosecution—and *rejected* the § 101 arguments, references, and expert declaration supplied by Fiserv's Petition here. *See* Ex. 2007 (Mirror Imaging disclosed this CBM Petition and references on February 1, 2018); *see also* Ex. 2001 (showing that the

Examiner submitted the Reasons for Allowance on January 5, 2018). Rather than accept Fiserv’s grounds for unpatentability, the Examiner allowed claims originating from the same disclosure and priority date as the Mirror Imaging patents and that patent has since issued. Ex. 2002. Fiserv acknowledges that the ’854 application claims are similar to the challenged claims in this CBM—but it relies on an outdated office action and subsequent interview summary to conclude that the claims “properly stand rejected.” Petition, 21. The Examiner’s Notice of Allowance and issued ’275 patent proves Fiserv wrong: Fiserv’s patent-ineligibility arguments fail. *See* Exs. 2001, 2002.

The Examiner’s ringing endorsement of those claims, even after considering Fiserv’s CBM petition, expert declaration, and prior art, applies with equal force to the claims here: “the claim limitations recited in claims 23 and 34, result in a combination of elements that **is both novel and unobvious over the prior art of record.**” Ex. 2001, pp. 8-9 (Reasons for Allowance) (emphasis added); *see also* Ex. 2001, pp. 4-7 (Examiner Amendment resulting in allowable independent claims 23 and 34).

Fiserv also neglects to mention that the Patent Office allowed the ’612

patent—which it acknowledges is among the “Mirror Imaging patents” that claim the same priority from a provisional application<sup>5</sup>—a full year after the *Alice* decision. ’612 patent Notice of Allowance, Ex. 2008. The Examiner conducted a substantive Examiner-initiated interview *one year after* the *Alice* decision, and submitted no office action until *one year after* the *Alice* decision. ’612 Image File Wrapper, Ex. 2009. The Examiner only granted the application when the applicant accepted all six pages of Examiner’s Amendments. Ex. 2008, pp. 3-9.

The amendments were consequential. For example, the Examiner more narrowly and concretely defined claim 33 by adding the following limitation:

wherein the specific document parameter of the financial document is a particular numerical sequence associated with the specific document parameter, and wherein the particular numerical sequence of the financial document includes a record date of the financial document.

Ex. 2008, p. 4; see also Ex. 1001 (’118 patent), claims 12, 14 (resembling

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<sup>5</sup> Petition, 15 (detailing that the ’612 patent has a priority date to the provisional application filed on April 13, 1999).

claim 33 of the '612 patent).

Most importantly, effectively *six months* before interviewing, amending, and issuing the claims, the Examiner received a Guidance that required Examiners to apply the *Alice* test. 2014 Guidance on Patent Subject Matter Eligibility, Ex. 2010. That guidance provided a detailed flow chart illustration of the *Alice* test and

set[] forth a two-part analysis for claims reciting judicial exceptions in view of recent decisions by the U.S. Supreme Court and the U.S. Court of Appeals for the Federal Circuit.

Available at: <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>.

The Board should not disturb the expert deliberations, claim amendments, and ultimate findings of the Examiners of the '275 and '612 patents: that those claims survive *Alice* and recite patent-eligible subject matter.

## **VII. CONCLUSION**

Mirror Imaging requests that the Board deny Institution on all grounds raised in Fiserv's Petition.

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Respectfully submitted,

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## CERTIFICATE OF SERVICE

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