

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIDELITY INFORMATION SERVICES, LLC,

Petitioner

v.

MIRROR IMAGING, LLC,

Patent Owner

Case CBM2017-00064
U.S. Patent No. 6,963,866

JOINT PROPOSED REDACTED FINAL WRITTEN DECISION

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Case CBM2017-00064
Patent 6,963,866 B2

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

ELLURU, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Covered Business Method Patent Review
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73



I. INTRODUCTION

A. *Background*

Petitioner, Fidelity Information Services, LLC (“Petitioner” or “FIS”), filed a Petition seeking a covered business method patent review of claims 1–55 of U.S. Patent No. 6,963,866 B2 (Ex. 1001, “’866 patent”), pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”).¹ Paper 2 (“Pet.”). On April 10, 2018, we instituted a covered business method patent review of claims 1–55 of the ’866 patent under 35 U.S.C. § 101. Paper 21 (“Decision on Institution” or “Inst. Dec.”), 43–44; *see* Paper 26 (public redacted version). Patent Owner, Mirror Imaging, LLC (“Patent Owner” or “Mirror Imaging”), filed a request for rehearing of the Decision on Institution, which was denied. Paper 31 (“Reh’g Dec.”); *see* Paper 33 (public redacted version).

Subsequently, Patent Owner filed a Patent Owner Response (Paper 38, “PO Resp.”),² and Petitioner filed a Reply (Paper 44, “Reply”). With authorization (Paper 56), Petitioner (Paper 59, “Pet. PEG Br.”) and Patent Owner (Paper 58, “PO PEG Br.”) filed supplemental briefing addressing the impact of the Office’s 2019 Revised Patent Subject Matter Eligibility

¹ 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).

² Patent Owner initially filed its Response under seal, but subsequently withdrew its Motion to Seal. *See* Papers 39, 40. Accordingly, the Response will be made public.



[REDACTED]

Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (the “Guidance”), available at <https://www.federalregister.gov/documents/2019/01/07/2018-28282/2019-revised-patent-subject-matter-eligibility-guidance>.

An oral hearing was held on January 15, 2019, and the record includes a transcript of the hearing. Paper 60 (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has established by a preponderance of the evidence that claims 1–55 of the ’866 patent are unpatentable under § 101.

B. Related Matters

Petitioner identifies numerous federal district court actions filed by Patent Owner involving the ’866 patent and related patents filed in the U.S. District Court for the Eastern District of Texas. Pet. 82–84. Petitioner also identifies two closed related district court matters filed in the same district. *Id.* at 84–85. Patent Owner provides a list of numerous district court actions in which the ’866 patent is asserted. Paper 5. Patent Owner also cites two recently allowed applications related to the ’866 patent. PO Resp. 62 (citing Exs. 2005, 2014, 2032); *see also* Paper 50 (citing a Notice of Allowance for U.S. Patent Application No. 15/990,160 (Ex. 2036)).


C. The ’866 Patent

The ’866 patent discloses methods and systems for financial institutions, such as banks and credit unions, to store and retrieve financial

[REDACTED]

documents from both on-site and off-site storage systems. Ex. 1001, [57], 1:38–63, 2:21–34. The '866 patent explains that conventional methods for retrieving a financial document by a financial institution enabled an employee of the financial institution (e.g., a bank teller) to input the client request for a particular document into an interface incorporated into a computer terminal. *Id.* at 1:38–48. “The interface is inter-linked with the on-site storage system.” *Id.* at 1:48–49. The '866 patent explains that the “[t]he storing, downloading and retrieving . . . including the reproduction and the distribution” of such financial documents is “known in the industry as back office production.” *Id.* at 1:54–58. According to the specification, the “majority of financial institutions electronically store financial documents only in an on-site storage system, and not in an off-site storage system.” *Id.* at 1:64–2:3. Thus, these institutions realize a significant financial burden because the back office production is “concentrated strictly at the financial institution” and cannot be outsourced to third parties. *Id.* at 2:3–5.


Further, according to the specification, “[o]ther financial institutions do electronically store financial documents on-site and off-site storage systems.” *Id.* at 2:6–7. But the methods used by these institutions to access “financial documents stored in the off-site storage system are deficient in that the interface utilized in such methods is only inter-linked with the on-site storage system.” *Id.* at 2:8–12. “That is, there is no interface independently inter-linked with the off-site storage system.” *Id.* at 2:12–13. Thus, according to the specification, the financial documents in the off-site storage system cannot be accessed efficiently. *Id.* at 2:13–15. The financial


institutions are still responsible for retrieving these documents through their back office production, and thus, their expenses remain high. *Id.* at 2:15–18.

The '866 patent specification, therefore, recognizes a need 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 not eliminates, the back office production . . . by providing a direct interface inter-linked with the off-site storage system.” *Id.* at 2:23–28. “With such an interface, the responsibility for retrieving financial documents from the off-site storage can be outsourced to third party entities while still providing the financial institution with efficient access to any financial documents electronically stored in the off-site storage system.” *Id.* at 2:28–33.

The specification discloses methods for a financial institution to obtain electronically stored financial documents having a specific document parameter, typically a particular numerical sequence, such as a record, from on-site and off-site storage systems. *Id.* at 2:38–53, 3:10–17. The specification explains that in one embodiment, the financial documents of the institution are maintained in the off-site storage system when the specific document’s parameter is greater than a predetermined parameter. *Id.* at 2:46–49. The documents having parameters that are less than or equal to the predetermined parameter are maintained in the on-site storage system. *Id.* at 2:50–53.

“When the financial institution receives a request for a financial document, the financial institution compares the specific document parameter of the requested document to the predetermined parameter to



[REDACTED]

determine if the specific document parameter is greater than, less than, or equal to the predetermined parameter.” *Id.* at 2:54–59. According to the specification, a computer terminal at the financial institution is “connected to both the off-site and on-site storage systems through a processing unit.” *Id.* at 2:59–62. The financial institution uses the processing unit, at least partially, to “automatically access one of the storage systems in response to the comparison of the specific document parameter to the predetermined parameter.” *Id.* at 2:62–65. For example, “if it is determined that the specific document parameter is less than or equal to the predetermined document parameter, then the processing unit accesses the second or on-site storage system.” *Id.* at 2:65–3:1. “[I]f it is determined that the specific document parameter of the financial document is greater than the predetermined parameter, then the processing unit accesses the first or off-site storage system.” *Id.* at 3:2–5. “After the requested financial document is inputted, the requested document is then retrieved in order to reproduce the financial document, and distribute the financial document to an end user of the financial institution.” *Id.* at 3:6–9.

D. Illustrative Claims

1. 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:

storing a plurality of financial documents in a first fixed medium at the first storage system when the specific document

[REDACTED]

parameter of the financial document is greater than a predetermined parameter;

storing a plurality of financial documents in a second fixed medium at the second storage system when the specific document parameter of the financial document is less than or equal to the predetermined parameter;

utilizing a computer terminal connected to the first and second storage systems through a processing unit;

receiving a request for at least one of the stored financial documents;

inputting the request into the computer terminal;

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;

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.

22. A method as set forth in claim 1 further including an outsourcing institution associated with the second storage system.

23. A method for a financial institution to obtain a stored financial document from an off site storage system remotely-

located from an on-site storage system wherein the financial document is associated with at least one specific document parameter with the specific document parameter being defined as a specific document age, said method comprising the steps of:

maintaining the financial document in the off-site storage system when the specific document age of the financial document is greater than a predetermined age;

maintaining the financial document in the on-site storage system when the specific document age of the financial document is less than or equal to the predetermined age;

utilizing a computer terminal associated with the financial institution and connected to the off-site and on-site storage systems through a processing unit;

receiving a request for the financial document;

inputting the request into the computer terminal;

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 after the request has been inputted;

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 retrieving the requested financial document from the accessed storage system as defined by the inputted request.

24. A method as set forth in claim 23 further including the step of processing the request to locate the requested financial document.

25. A method as set forth in claim 24 further including the step of reproducing the requested financial document after the request has been processed and retrieved.

26. A method as set forth in claim 25 wherein the steps of processing the request, retrieving the requested financial document, and reproducing the requested financial document are controlled by an interlinked computer program.

37. A method as set forth in claim 23 further including the step of inputting identification data of the requested financial document into the computer terminal through a primary interface inter-linked with the on-site storage system when the specific document age of the financial document is less than or equal to the predetermined age.

38. A method as set forth in claim 37 further including the step of inputting identification data of the requested financial document into the computer terminal by selecting an exit function at the primary interface when the specific document age of the financial document is greater than the predetermined age.

39. A method as set forth in claim 38 wherein the step of selecting the exit function is further defined by initiating a secondary interface inter-linked with the off-site storage system and inputting identification data into the secondary interface.

E. Instituted Ground of Unpatentability

We have instituted review on the sole asserted ground—that claims 1–55 of the '866 patent are unpatentable as directed to patent-ineligible subject matter under § 101.



II. ANALYSIS

A. *Claim Construction*

In a covered business method patent review based on a petition filed before November 13, 2018, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.300(b) (2017).³ Consistent with that standard, claim terms are generally given their ordinary and customary meaning, as would have been understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Only terms which are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner contends that no claim constructions are necessary to resolve the question of patent eligibility under § 101, but notes that a district court previously construed certain terms in a patent related to the '866 patent, and another district court preliminarily construed certain terms in the '866 patent and a related patent. Pet. 41–43 (citing Exs. 1024–26). Patent Owner does

³ A different rule applies for later cases. *See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (amending 37 C.F.R. § 42.300(b) effective November 13, 2018). The Petition was filed on October 2, 2017, prior to the effective date of the rule change.

[REDACTED]

not address claim construction of the challenged claims in its Response. We determine that no term requires express construction.

B. Covered Business Method

Section 18 of the AIA provides for the creation of a transitional program for reviewing covered business method patents, and limits review to persons or their privies that have been sued or charged with infringement of a “covered business method patent.” AIA § 18(a)(1)(B); *see* 37 C.F.R. § 42.302. In addition,

the term “covered business method patent” means a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.

AIA § 18(d)(1); *see* 37 C.F.R. § 42.301(a). A patent need have only one claim directed to a covered business method to be eligible for review. *See* Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention; Final Rule, 77 Fed. Reg. 48,734, 48,736 (Aug. 14, 2012) (“Final Rule”).

For the reasons set forth below, Petitioner has shown that it has standing to file the Petition to challenge the ’866 patent as a covered business method patent.

1. Charged with Infringement

Under 37 C.F.R. § 42.302(a),

[a] petitioner may not file with the Office a petition to institute a covered business method patent review of the patent unless the petitioner, the petitioner’s real party-in-interest, or a

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privity of the petitioner has been sued for infringement of the patent or has been charged with infringement under that patent. *See* AIA § 18(a)(1)(B). In addition, 37 C.F.R. § 42.302(a) provides that “[c]harged with infringement means a real and substantial controversy regarding infringement of a covered business method patent exists such that the petitioner would have standing to bring a declaratory judgment action.”

Petitioner asserts standing under 37 C.F.R. § 42.302(a) because “its customers and privies, PlainsCapital Bank (‘PlainsCapital’) and Origin Bank (‘Origin’), have been sued for infringement based on [Patent Owner’s] allegations that their respective online banking systems infringe the ’866 patent.” Pet. 21.⁴ Petitioner also asserts standing under § 42.302(a) because Petitioner “has been ‘charged with infringement’ based on Patent Owner’s infringement allegations against PlainsCapital and Origin Bank’s online banking systems provided by [Petitioner].” *Id.* Petitioner relies on originally filed redacted Exhibits 1030–32 and 1038–40 (*see infra* note 5) and other Exhibits cited in its Petition to support its standing showing. *Id.* at 23–26 (citing Exs. 1030–32, 1038–40).

The record also contains unredacted confidential versions of Exhibits 1030–32 and 1038–40. Because Exhibits 1030–32 and 1038–40 as filed with the Petition contain redactions, and Patent Owner asserted the redactions may omit, *inter alia*, “possible exemptions” about Petitioner’s indemnity obligations (Paper 7, 33–34), the panel ordered the parties to meet

⁴ Origin Bank changed its name from “Community Trust Bank” prior to the filing of the Petition. *See* Ex. 1043; Ex. 1044.

[REDACTED]

and confer to agree about the filing of confidential (non-public) material by Petitioner. *See* Paper 12. The record indicates the parties reached agreement, as Petitioner filed substantially unredacted (non-public) versions of Exhibits 1030–32 and 1038–40 (i.e., Exhibits 1048–53). *See* Paper 12, 2–3; Exs. 1048–53 (filed as “Board and Parties Only,” i.e., non-public material).⁵ We also authorized additional briefing (collectively, “Standing Briefing”) by the parties to address the standing issue prior to institution. *See* Paper 12; Inst. Dec. 9–17 (addressing the briefing); Paper 13 (Patent Owner’s Supplemental Brief filed under seal); Paper 15 (Patent Owner’s redacted Supplemental Brief); Paper 16 (Petitioner’s Reply to Patent Owner’s Supplemental Brief filed under seal); Paper 19 (Petitioner’s redacted Reply).

As explained more fully in the Decision on Institution and Rehearing Decision (*see* Inst. Dec. 9–17; Reh’g Dec. 5–7), and as further explained below, the Petition shows Petitioner agreed to defend and indemnify its customer banks (PlainsCapital and Origin Bank) for infringement of the ’866 patent under indemnity obligations for software services FIS supplied to the banks, namely “Business Electronic Banking (‘BeB’), and/or Consumer Electronic Banking (‘CeB’) services” (Ex. 1032 § 1; Ex. 1040

⁵ Exhibits 1048–53 constitute substantially unredacted versions of originally filed Exhibits 1030–32 (respectively, Information Technology Services Agreement (“ITSA”) between Petitioner and PlainsCapital Bank; Order Form for Plains Capital Bank; and Services Addendum to the ITSA (“Addendum”)) and 1038–40 (respectively, ITSA between Petitioner and Community Trust Bank; Order Form for Community Trust Bank; and Addendum to the ITSA).

[REDACTED]

§ 1). *See* Pet. 21–28 (citing Exs. 1028–44).

After institution, in its Response, Patent Owner maintains that Petitioner lacks standing to file the Petition.⁶ *See* PO Resp. 50–52. According to Patent Owner, neither “petitioner [nor] the petitioner’s real party-in-interest . . . ha[ve] been sued for infringement of the patent.”⁷ *Id.* at 52 (quoting 37 C.F.R. § 42.302 (alterations by Patent Owner)). Patent Owner also contends “[a]t best, FIS’s evidence suggests that the indemnity provision [in the ITSA] *might* cover the ‘CeB’ and BeB’ services provided—but the heavy redactions raise serious doubts about possible exemptions and requirements to satisfy such a provision.” *Id.* at 53. Patent Owner also contends Petitioner fails to show privity status for its customer banks. *See id.* at 53 (arguing a “privity is a party that has a direct relationship to the petitioner with respect to the **allegedly infringing product or service**—not simply *any* customer to which the petitioner may provide products or services unrelated to allegations of infringement” (internal quotation marks omitted)).

Regarding the allegedly infringing products, Patent Owner contends that Petitioner fails to show that its online services, BeB and CeB, “are the

⁶ We only consider arguments made during trial. To the extent any of the Standing Briefing arguments bear on the standing issue and Patent Owner did not waive them by failing to include the arguments in its Response, we incorporate by reference our findings and discussion regarding that issue from the Decision on Institution (Inst. Dec. 8–17) and from the Decision on Patent Owner’s Request for Rehearing (Reh’g Dec. 5–7).

⁷ Petitioner identifies itself and Fidelity National Information Services, Inc. as real parties-in-interest. Pet. 81.

services that infringe Mirror Imaging’s patent[.]” *Id.* at 55–56. Patent Owner explains as follows: “Mirror Imaging specifically identified the Plains Capital’s Remote Deposit Capture System as an infringing service. *See* Ex. 1028 (Complaint against Plains Capital), ¶ 23. Nowhere does FIS, nor the Plains Capital declarant, allege that ‘BeB’ or ‘CeB’ services provided by FIS include this allegedly infringing remote deposit system.” PO Resp. 56. In a similar argument about Origin Bank, Patent Owner alleges “neither FIS nor the Origin [Bank] declarant allege that the accused Origin [Bank]’s Remote Deposit Capture is supplied by FIS.” *Id.* (citing Ex 1036 (Complaint Against Origin Bank) ¶ 24). Comparing the two customer’s systems, Patent Owner contends that “[i]t is particularly suspicious that the listed features of the Plains Capital and Origin Bank deposit systems look quite different. *Compare* Ex. 2008 (screen capture of Plains Capital remote deposit website description), *with* Ex. 2009 (content download from Origin Bank website detailing its remote deposit system).” PO Resp. 56.

Patent Owner also argues that Petitioner’s exhibits filed originally with the Petition, including Petitioner’s Order Forms, contain heavy redactions with outdated “effective dates of over *2.5 years ago* for Plains Capital and *3 years ago* for Origin Bank, allegedly provided over an initial term (redacted), and potentially extended over a renewal term (also redacted).” *Id.* at 54 (citing Exs. 1031, 1039). Patent Owner also contends the Electronic Service Addenda (showing indemnity obligations) contain heavy redactions. *See id.* at 55 (citing Exs. 1032, 1038).

[REDACTED]

Lastly, quoting *Arris Group, Inc. v. British Telecommunications, PLC*, 639 F.3d 1368, 1375 (Fed. Cir. 2011), Patent Owner contends Petitioner relies only on the first prong of *Arris*, namely, “a supplier whose customers have been accused of direct infringement based on use of a supplier’s equipment has standing to commence a declaratory judgment action only if (1) ‘the supplier is obligated to indemnify its customers from the infringement liability.’” *See* PO Resp. 58–59. Under this first prong, Patent Owner maintains Petitioner failed to provide “*concrete evidence*” about its obligation to indemnify Origin Bank or PlainsCapital for “**infringement liability.**” *Id.* at 58–59 (citing *Arris*, 639 F.3d at 1375; *Creative Compounds, LLC v. Starmark Labs.*, 651 F.3d 1303, 1316–17) (Fed. Cir. 2011)).

Petitioner replies that Patent Owner “misunderstands the evidence presented”:

Anthony Giovannetti, as *FIS*’s in-house counsel (not a customer-bank declarant), is competent to attest to the facts in his declarations. *See* Exs. 1029, 1037. Mr. Giovannetti explained that *FIS* provides the accused online banking system—the BeB and CeB products—to the banks Mirror Imaging sued, and he testified that the contracts were in force. Pet. 23–26; Ex. 1029, ¶¶ 6–10, 13–14; Ex. 1037, ¶¶ 6–10, 13–14. Patent Owner speculates that the systems may have changed or the contracts are not in force (POR 53–58), but this is contrary to the evidence and Mr. Giovannetti’s testimony. Mr. Giovannetti also provided evidence that the banks requested indemnity and *FIS* accepted the indemnity under their contracts.

Reply 28 (citing Pet. 24–26; Ex. 1029 ¶¶ 12, 15; Ex. 1037 ¶¶ 12, 15).

Petitioner has established standing under § 42.302(a) because

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[REDACTED]

Petitioner has been “charged with infringement” of the ’866 patent “such that the petitioner would have standing to bring a declaratory judgment action.” According to *Arris*, “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.” *Arris*, 639 F.3d at 1375; *see also 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”). As summarized above, Petitioner agreed to indemnify its customer banks for infringement of the ’866 patent under applicable indemnity obligations, as set forth in the ITSA. *See* Pet. 21–28 (citing Exs. 1028–44).

The ITSA supports Petitioner’s position. Specifically, Section 10.2 of the ITSA requires Petitioner to “indemnify, defend and hold harmless” customer banks for “any and all Losses asserted by a third party that result from, relate to, arise out of, or are incurred in connection with . . . a claim that a Service, Software, or Deliverable infringes a . . . U.S. patent.” Ex. 1030 § 10.2; Ex. 1038 § 10.2 (materially similar language). An Electronic Banking Services “Addendum describes the provision of a service (‘Service’)” (Ex. 1030 § 2; Ex. 1038 § 2), and each Addendum in turn describes “Business Electronic Banking (‘BeB’), and/or Consumer Electronic Banking (‘CeB’) services” provided by Petitioner FIS (Ex. 1032 § 1; Ex. 1040 § 1).

[REDACTED]

Furthermore, Petitioner shows that its obligation to indemnify its customer banks, PlainsCapital and Origin Bank, derives from the customer banks' alleged "infringement liability" of the '866 patent. *See Arris*, 639 F.3d at 1375. Patent Owner's complaint against PlainsCapital and Origin Bank alleges infringement of the '866 patent based generally on each customer bank's "Online Banking system." *See* Ex. 1028 ¶ 32 (complaint against PlainsCapital); Ex. 1036 ¶ 33 (complaint against Origin Bank). As indicated above, Petitioner provides BeB and CeB services to Origin Bank (Ex. 1040 § 1; Ex. 1052, 2), and CeB services to PlainsCapital (Ex. 1032 § 1; Ex. 1049, 3).

In addition, Petitioner's declarant, Anthony Giovannetti, testifies he has "been in-house counsel for [Petitioner] since 2010." Ex. 1029 ¶ 5. He testifies that Petitioner provides "Business e-Banking ('BeB') and Consumer e-Banking ('CeB') products, for use in PlainsCapital's online banking system." *Id.* ¶ 7. He further testifies that PlainsCapital uses those products "in its *accused* online banking system." *Id.* ¶ 10 (emphasis added). He testifies that pursuant to a letter from PlainsCapital requesting indemnity under Sections 10.2 and 10.3 of the ITSA "for the accused products identified in paragraph 7" of his declaration—i.e., the BeB and CeB products and services—Petitioner agreed to indemnify PlainsCapital in accordance with its contractual indemnity obligations. *See id.* ¶¶ 7–15. Mr. Giovannetti provides substantially similar testimony with respect to Origin Bank. *See* Ex. 1037 ¶¶ 7–15.

Patent Owner's contention that Petitioner does not allege that the BeB or CeB services it provides pertain specifically to the "Remote Deposit

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[REDACTED]

Capture” systems of PlainsCapital and Origin Bank does not undermine Petitioner’s showing. *See* PO Resp. 56 (citing Ex. 1028 ¶ 23; Ex. 1036 ¶ 24). As noted above, Mr. Giovannetti testifies that FIS supplies services and products used in the accused online banking system and FIS agreed to indemnify the banks based on the services and products supplied under the indemnity obligations. *See* Ex. 1029 ¶¶ 7–15; Ex. 1037 ¶¶ 7–15. Also, in alleging infringement, each complaint alleges generally what each bank does, or what each bank’s “Online Banking system” does. *See* Ex. 1036 ¶ 35 (alleging generally what “Origin performs” and alleging “[f]or example, Origin’s Online Banking system stores online statements and check images”); Ex. 1028 ¶ 27 (similarly alleging that “Plains Capital performs the step of . . . retrieving” documents and alleging “[f]or example, Plains Capital’s Online Banking system’s processing unit . . . retrieves” check images). The complaints only list the “Remote Deposit Capture” systems as mere examples (via a website) of the respective Online Banking systems alleged to infringe. *See* Ex. 1028 ¶ 23 (“For example, Plains Capital’s Online Banking system stores online statements and deposited check images in remotely located, separate storage systems based on the date associated with that document. *See, e.g.,* [https://www.plainscapital.com/business/treasury-management/remote-deposit-capture.](https://www.plainscapital.com/business/treasury-management/remote-deposit-capture)”); Ex. 1036 ¶ 34 (similar allegation against Origin Bank). Stated differently, the complaints do not allege that the banks’ Remote Deposit Capture systems *exclusively* infringe the ’866 patent, as the complaints generally refer to the banks’ “system[s]” and even more generally refer to allegations about what the banks themselves do (e.g.,

[REDACTED]

[REDACTED]

including employees). *See, e.g.*, Ex. 1028 ¶ 25 (“Plains Capital further performs the step of receiving a request for at least one of the stored financial documents.”); Ex. 1036 ¶ 25 (“Origin performs the step of 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.”).

Patent Owner’s related argument that “the listed features of the PlainsCapital and Origin [Bank] deposit systems look quite different” (PO Resp. 56) also does not undermine Petitioner’s showing regarding the accused products and indemnity obligations. As noted above, the complaints do not allege infringement exclusively by the Remote Deposit Capture systems. Also, Patent Owner does not point to, and we do not see, any relevant features or differences between the banks’ Remote Deposit Capture systems that relate to Petitioner’s indemnity obligations. Exhibits 2008 and 2009, cited by Patent Owner to support its argument, merely represent advertisements for the “Remote Deposit Capture” system advertised by PlainsCapital and Origin Bank, respectively—and they tout similar attributes regarding the ability of customers to electronically *deposit* checks so that clients need not visit the bank—features which the challenged claims do not require and features Patent Owner does not rely upon in its infringement allegations. *See* Ex. 2008; Ex. 2009; Ex. 1028; Ex. 1036.

In addition, correspondence between Petitioner and each of PlainsCapital and Origin Bank corroborates Mr. Giovannetti’s testimony (Ex. 1029 ¶¶ 7–15; Ex. 1037 ¶¶ 7–15) and demonstrates that the customer banks and Petitioner agree that Petitioner will indemnify and defend the

[REDACTED]

[REDACTED]

customer banks for infringement of the '866 patent, including by possibly filing the Petitions here, pursuant to § 10.2 of the ITSA. *See* Ex. 1033, 1 (PlainsCapital requesting indemnification from Petitioner for alleged infringement of the '866 patent); Ex. 1035, 1 (Petitioner agreeing to indemnify PlainsCapital for the alleged patent infringement pursuant to § 10.2 of the ITSA, and stating it “may file petitions challenging the validity of the claims of the Patents with the [USPTO], along with pursuing other defenses”); Ex. 1041, 1 (Origin Bank requesting indemnification from Petitioner for alleged infringement of the '866 patent); Ex. 1042, 1 (Petitioner agreeing to indemnify Origin Bank for the alleged patent infringement pursuant to § 10.2 of the ITSA and stating it “may file petitions challenging the validity of the claims of the Patents with the [USPTO], along with pursuing other defenses”). These facts, in addition to the testimony of Mr. Giovannetti as discussed above, support Petitioner’s position that it has standing to file the instant Petition under § 42.302(a).⁸

⁸ Section 10.2 of the ITSA corroborates Mr. Giovannetti’s testimony. As noted above, originally-filed Exhibit 1030 requires Petitioner to “indemnify, defend and hold harmless” its customer bank for “any and all Losses asserted by a third party that result from, relate to, arise out of, or are incurred in connection with . . . a claim that a Service, Software, or Deliverable infringes a . . . U.S. patent.” Ex. 1030 § 10.2; *accord* Ex. 1038 § 10.2 (materially similar language). In addition, though not necessary to our determination, later-filed (i.e., post-institution) unredacted Exhibits 1048 and 1051 corroborate Mr. Giovannetti’s testimony. *See* Ex. 1048 § 10.2 [REDACTED]; Ex. 1051 § 10.2 [REDACTED]

[REDACTED]

Patent Owner’s argument that the Order Forms for PlainsCapital and Origin Bank submitted by Petitioner “fail[] to show that [Petitioner] supplies the *current* online banking services accused of infringement” also does not undermine Petitioner’s showing. *See* PO Resp. 54. No evidence of record indicates that the dates of about three years prior to the filing of the Petition for an initial agreement to provide BeB and CeB software services represents a stale period relative to the length of services provided or the filing of the Petition. *See id.*⁹ Also, even if Petitioner discontinued the services by the time of filing of the Petitions, this does not absolve Petitioner of its indemnity obligation, and Patent Owner fails to explain how it does. In any event, evidence filed with the Petition indicates Petitioner supplied the services as late as August, 2017. *See* Ex. 1033 (PlainsCapital letter of August 9, 2017 seeking indemnity, noting “Mirror Imaging’s patent infringement claims may arise out of the Bank’s *use* of certain software licensed under the Information Technology Services Agreement” (emphasis added)); Ex. 1041 (Origin Bank’s letter of August 18, 2017 seeking indemnity for what “Origin *purchases* from FIS, software and services” (emphasis added)). In addition, the later-filed unredacted Order Forms corroborate that the BeB and CeB services remain in effect. *See* Ex. 1049,

⁹ The originally filed redacted Order Forms show execution dates of June 24, 2015 (Ex. 1031, 5) and December 31, 2014 (Ex. 1039, 4), but redact the length of the contracted services. *See* PO Resp. 54 (describing “effective dates of over *2.5 years ago* for Plains Capital and *3 years ago* for Origin Bank”—i.e., characterizing the relative times between the Order Forms and the filing of the Petition.

[REDACTED]

1, 3 (showing an “Effective Date” of May 31, 2015, and an “Initial Term” of [REDACTED] months for CeB services); Ex. 1052, 1–3 (showing an “Effective Date” of January 1, 2015, and an “Initial Term” of [REDACTED] months for BeB and CeB services).¹⁰

Lastly, Patent Owner’s allegation describing redactions in the originally-filed Exhibits as “destroy[ing] any evidentiary value” and related arguments about redactions do not undermine Petitioner’s showing of standing. *See* PO Resp. 54–56. As discussed and summarized above, Petitioner shows standing despite the redactions in the Exhibits as originally filed.¹¹ Patent Owner also alleges it “required completely unredacted copies” and Petitioner rejected “multiple entreaties and offered only partial removal of redactions—requiring the Board and Mirror Imaging to entrust

¹⁰ These (unredacted) Order Forms (Exs. 1049, 1052), filed with Petitioner’s Standing Briefing, and showing the renewal terms noted, buttress Petitioner’s persuasive showing in its Petition and address Patent Owner’s arguments about the alleged staleness of the contracted services. *See* Inst. Dec. 14 n.5 (discussing Exs. 1049 and 1052 as showing, on that preliminary record, initial terms of [REDACTED] and [REDACTED] months respectively and showing that FIS still supplies BeB and CeB services).

¹¹ As we determined in the Decision on Institution and the Rehearing Decision (*see* Inst. Dec. 16; Reh’g Dec. 5–7), and as we determine here, despite redactions to Exhibits 1030–32 and 1038–40, Petitioner made a sufficient showing for institution purposes prior to the filing of Exhibits 1048–53 and the Standing Briefing. As noted above, Exhibits 1048–53 represent substantially unredacted versions of Exhibits 1030–32 and 1038–40. The originally filed Exhibits support standing by Petitioner for purposes of institution and for purposes of the Final Written Decision, and the later-filed Exhibits only further support our conclusion of standing.

[REDACTED]

FIS with revealing all relevant provisions.” PO Resp. 57 n.6. Patent Owner also contends it “offered to attach unredacted copies of all of the FIS service documents.” *Id.* Patent Owner does not explain how these allegations, even if accurate, alter the calculus regarding standing. Patent Owner primarily relied on comparing the unredacted Exhibits to the redacted Exhibits in its Standing Briefing to support allegations that the evidence shows Petitioner has no indemnity obligation, but Patent Owner does not pursue these comparison allegations in its Response. *See* Paper 13, 2–5.

Because we determine that Petitioner shows that it has standing under § 42.302(a), based on its indemnity obligation to PlainsCapital and Origin Bank, we need not address Petitioner’s alternative basis for standing that PlainsCapital and Origin Bank are customer “privies.” *See* Pet. 21–26.

Based on the foregoing, Petitioner shows that it had standing to file the Petition under § 42.302(a) and pursue the trial after being charged with infringement based on its obligation to indemnify customer banks PlainsCapital and Origin Bank.

2. *Used in the Practice, Administration, or Management of a Financial Product or Service*

A covered business method patent “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); 37 C.F.R. § 42.301. Hence, the Board “examine[s] the claims when deciding whether a patent is a CBM patent.” *Blue Calypso*,

[REDACTED]

[REDACTED]

LLC v. Groupon, Inc., 815 F.3d 1331, 1340 (Fed. Cir. 2016) (emphasis omitted).

Petitioner asserts that all the claims of the '866 patent claim methods for storing and retrieving “financial documents,” such as checks, including storing the documents in one of two separate storage systems based on characteristics of the documents. Pet. 30–31 (citing Ex. 1007 ¶ 89). Petitioner further asserts that “[t]he dependent claims confirm the financial nature of the claimed ‘financial documents.’ For example, claims 15–18 recite that the financial document parameter is an ‘account number,’ ‘check number,’ ‘payment date,’ or ‘monetary amount.’” *Id.* at 31 (citing Ex. 1007 ¶ 91).

Patent Owner does not contest Petitioner’s assertion. Rather, Patent Owner contends the '866 patent “claims solve the specific problem of selectively archiving and retrieving financial documents.” PO Resp. 4.

The record shows that at least one claim, including at least claims 1 and 15–18, recites financial document parameters and methods employed to retrieve stored financial documents. The claimed method is not “incidental to” or “complementary to” a financial activity because the claims are expressly directed to the storing and retrieving of financial documents upon a request. *See Unwired Planet, LLC v. Google Inc.*, 841 F.3d 1376, 1382 (Fed. Cir. 2016).

Therefore, we determine that at least one claim of the '866 patent is directed to “a method . . . for performing data processing or other operations used in the practice, administration, or management of a financial product or service.” AIA § 18(d)(1).

[REDACTED]



3. *Technological Invention*

As quoted above, under AIA § 18(d)(1), “the term ‘covered business method patent’ . . . does not include patents for technological inventions.” Under 37 C.F.R. § 42.301(b), “[i]n determining whether a patent is for a technological invention,” we consider “whether [1] the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art, and [2] solves a technical problem using a technical solution,” respectively, the first and second prongs of the technological invention exception.

In general, the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756 (Aug. 14, 2012) (“TPG”), provides the following guidance with respect to claim content that typically would exclude a patent from the category of a technological invention:

(a) Mere recitation of known technologies, such as computer hardware, communication or computer networks, software, memory, computer-readable storage medium, scanners, display devices or databases, or specialized machines, such as an ATM or point of sale device.

(b) Reciting the use of known prior art technology to accomplish a process or method, even if the process or method is novel and non-obvious.

(c) Combining prior art structures to achieve the normal, expected, or predictable result of that combination.

Id. at 48,763–64.

With respect to the first prong of § 42.301(b), Petitioner persuasively argues that “[t]he ’866 patent does not claim a technological feature that is novel and nonobvious over the prior art.” Pet. 35 (citing Ex. 1007 ¶ 94). Petitioner persuasively shows that “the claims recite only generic computer



hardware, computer-readable storage mediums, and databases.” *Id.* In particular, Petitioner persuasively points out that the “[t]he claims here recite only a ‘storage system,’ ‘fixed medium,’ ‘processing unit,’ and ‘computer terminal,’ which are generic, well-known components,” and do not recite any alleged improvements of these components. *Id.* at 36 (citing claims 1 and 23; Ex. 1007 ¶¶ 94, 96). Petitioner also persuasively argues that “the Background of the ’866 patent explains that a financial institution employee could previously retrieve electronically stored financial documents through an interface that is inter-linked with the on-site storage system, and electronically store and retrieve financial documents using on-site and off-site storage systems.” *Id.* at 36–37 (citing Ex. 1001, 1:43–52, 2:6–7, 2:18–20; Ex. 1007 ¶ 95). Petitioner also persuasively notes that the storing and retrieving of financial documents was known before the ’866 patent. For example, Petitioner notes that the ’866 patent specification admits that financial documents were previously stored on-site and off-site and that “a financial institution employee could previously retrieve electronically stored financial documents” from these storage systems. *Id.* at 36–37 (citing Ex. 1001, 1:21–22, 1:43–52, 2:6–7, 2:18–20; Ex. 1007 ¶ 95). As for the “comparing” step of the claims, Petitioner persuasively points out that the ’866 patent specification explains that it constitutes a mental process step and does not require technical features. *See id.* at 37 (citing Ex. 1001, 6:50–7:22; Ex. 1007 ¶¶ 98–99). Therefore, Petitioner persuasively shows that the claimed computer components constitute well-known computer hardware and technologies involving storage and retrieval of documents.

[REDACTED]

Patent Owner does not address specifically whether the challenged claims are for a technological invention. Patent Owner generally asserts the challenged claims solve a “technological *problem*,” although the arguments are directed to Petitioner’s challenge under 35 U.S.C. § 101 rather than ascertaining whether the ’866 patent is eligible for covered business method patent review. *See, e.g.*, PO Resp. 6. In particular, Patent Owner contends “the claims are directed to an interlinked interface that is connected to an off-site (or first) and an on-site (or second) storage system. *See id.* at 8. This argument is not persuasive because none of the challenged independent claims explicitly recite such an interface.

Even accepting Patent Owner’s assertion that one or more of the independent claims require on-site and off-site storage systems inter-linked through a single interface, the ’866 patent recognizes that the prior art disclosed storage systems with an interlinked interface. *See* Ex. 1001, 1:48–49 (describing known systems as including an “interface [that] is inter-linked with the on-site storage system”). It also recognizes that “financial institutions do electronically store financial documents in on-site and off-site storage systems.” *Id.* at 2:6–7. And the record includes evidence that an interface inter-linked to two separate storage systems (e.g., on-site and off-site systems) was well known. Ex. 1007 ¶ 81 (Petitioner’s declarant explaining that, in the 1990s, “[b]y associating pointers with documents, a database search at a single user interface allowed users to be inter-linked to all storage systems where they could find the desired document on those systems and retrieve the document,” and citing Ex. 1011 as support); *id.* ¶¶ 76–78; Ex. 1010, 24, 30 (“For instance, using the same index, it will be

[REDACTED]

[REDACTED]

possible to allocate ‘active’ files to short-term, fast-access storage, while ‘inactive’ material might be kept on long-term, slower memories.”); Ex. 1012, 28, 50–51 (“The centralized database concept provides a single point of access and distribution of all document data within the system. The distributed database concept may or may not require that all locations within a given system have the capability of accessing any document within the system, wherever it is stored.”); Ex. 1014, 108–09 (stating that searching and retrieval functions “from the same end-user interface, regardless of the information’s storage location.”); Ex. 1015, 18; Ex. 2034, 78:11–79:11, 89:5–19, 117:1–25, 119:8–18; *see* Reply 4–5, 16–17; *see also* Pet. 11–13 (Petitioner referring to evidence and arguing that at the time of the ’866 patent, systems existed allowing for access to different storage locations from the same end-user interface). Thus, even if one or more of the independent claims require an interface, reciting an interface to access both on-site and off-site storage systems to retrieve a financial document merely involves reciting known computer hardware (an interface), using known technology to accomplish a process or method (document storage and retrieval), or combining known storage system structures with a known interface to achieve the normal, expected, or predictable result of that combination. *See* TPG, 77 Fed. Reg. at 48,764.

Based on the foregoing, Petitioner persuasively shows that the ’866 patent is not exempt from covered business method patent review based on the “technological invention” exception under 37 C.F.R. § 42.301(b).

4. *Conclusion—A Covered Business Method Patent*

A single claim is sufficient to institute a covered business method patent review because § 18(d)(1) of the AIA indicates a *patent* is eligible for review if the subject matter of at least one claim is directed to a covered business method. *See* 35 U.S.C. § 324(a); Final Rule, 77 Fed. Reg. at 48,736 (Response to Comment 8). In view of the foregoing, the '866 patent is a covered business method patent under AIA § 18(d)(1).

C. *Law of Patent-Eligible Subject Matter Under 35 U.S.C. § 101*

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *E.g., Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See id.* at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, i.e., the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental

[REDACTED]

economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the

[REDACTED]

[REDACTED]

elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (some quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

D. USPTO 2019 Revised Patent Subject Matter Eligibility Guidance

The USPTO recently published revised guidance on the application of § 101. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“USPTO § 101 Guidance” or “Guidance”). Under the Guidance, we look to whether an otherwise statutory claim recites the following:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

See USPTO § 101 Guidance, 84 Fed. Reg. at 51–55. Only if a claim (1) recites a judicial exception, and (2) does not integrate that exception into a practical application, do we then look to whether the claim

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

[REDACTED]

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See id. at 56.

E. Subject Matter Eligibility of Challenged Claims Under § 101

As noted above, Petitioner challenges claims 1–55 of the '866 patent as reciting patent ineligible subject matter under § 101. Petitioner relies on the Declaration of Stephen Gray (Ex. 1007). Patent Owner disagrees that the challenged claims are patent ineligible, and relies on the Declaration of John V. Ashley (Ex. 2039).

1. Alice Step 1 and Guidance Step 1

As noted above, under *Alice* Step 1, we determine whether the claims are directed to an abstract idea. Under the Guidance, we first must determine “whether the claim is to a statutory category (Step 1).” USPTO § 101 Guidance, 84 Fed. Reg. at 53. Here, we determine the claims recite a statutory process, namely the process of organizing, storing, and retrieving financial documents based on document characteristics, as set forth further below.

a. USPTO Guidance Step 2A, Prong 1: Whether Challenged Claims are Directed to an Abstract Idea

In determining whether a method or process claim recites an abstract idea judicial exception, we must examine the claim as a whole. *Alice*, 573 U.S. at 218 n.3. “The § 101 inquiry must focus on the language of the [a]sserted [c]laims themselves.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016); *Accenture Global Servs., GmbH v.*

[REDACTED]

Guidewire Software, Inc., 728 F.3d 1336, 1345 (Fed. Cir. 2013) (admonishing that “the important inquiry for a § 101 analysis is to look to the claim”); *see also Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1346 (Fed. Cir. 2014) (“We focus here on whether the claims of the asserted patents fall within the excluded category of abstract ideas.”). “An abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). Yet our reviewing court has cautioned that characterizing claims at a “high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337. The Guidance, in agreement with case law, provides certain groupings of abstract ideas: mathematical concepts, certain methods of organizing human activity, such as fundamental economic principles or practices, and mental processes.¹² 84 Fed. Reg. at 52.

¹² The Guidance also advises that the “*Alice* Step 1” analysis should exclude analysis of whether elements represent well-understood, routine, and conventional activity. Guidance, 84 Fed. Reg. at 55. “[R]evised Step 2A specifically excludes consideration of whether the additional elements represent well-understood, routine, conventional activity. Instead, analysis of well-understood, routine, conventional activity is done in Step 2B.” *Id.* Although our Decision on Institution considered whether the claims recited well-understood, routine, and conventional activity under *Alice* Step 1, we do not so here and reach the same conclusion based on the full record of the trial. *See* PO PEG Br. 1 (citing Inst. Dec. 30); *see* Inst. Dec. 28–30.

[REDACTED]

Submitting that claim 1 of the '866 patent is representative of all challenged claims,¹³ Petitioner argues that the claims are directed to “organizing, storing, and retrieving financial documents based on document characteristics” that “merely implements a known business practice and human activity” and, thus, are directed to an abstract idea under Guidance judicial exception grouping (b). Pet. 48, 51–52; Pet PEG Br. 2. In addition, Petitioner contends that the “comparing” step recited in the claims is merely a “mental process,” “which the '866 patent discloses as being performed by an employee, who then determines whether to access the off-site storage system or the on-site storage system based on an attribute of the requested financial document.” Pet. 37 (emphasis omitted). According to Petitioner and its declarant, Stephen Gray, representative claim 1 is directed to obtaining a financial document by (1) storing financial documents in one of two storage systems (“first” and “second”) based on whether a specific document characteristic of the financial document (e.g., a date) is greater or less than or equal to a predetermined parameter; (2) receiving and inputting a request for at least one of the stored financial documents; (3) comparing the specific document parameter of the requested financial document to the predetermined parameter to determine whether the parameter is greater or less than or equal to the predetermined parameter; and (4) accessing and retrieving the requested financial document from one of the two storage

¹³ Patent eligibility is determined on a claim by claim basis. Petitioner argues that all the challenged claims are directed to the same abstract idea, discussing claim 1 as representative and accounting for additional limitations in the other claims. *See* Pet. 48–50, 62–76.

[REDACTED]

systems based on the determination. Pet. 49–51 (citing Ex. 1007 ¶¶ 109, 111).

Patent Owner argues that the claims are not directed to an abstract idea. According to Patent Owner, the challenged 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.” PO Resp. 25. Patent Owner notes that the patent specification disparages the conventional concept of storing financial documents in on-site and off-site electronic storage systems that “utilize separate (i.e., non-interlinked) interfaces and categorization methods.” *Id.* at 27. Patent Owner emphasizes that the challenged claims use “an interface interlinked with separate electronic storage systems that store financial documents based on a specific document parameter in those separate storage systems.” *Id.* at 26–27; *id.* at 28 (“interlinking on-site and off-site financial document storage systems to a unified interface”). Similarly, Patent Owner argues that the claims cannot be reduced to “fundamental human activity” because the claims require “that both storage systems must work through an interface interlinked with both storage systems.” *Id.* at 28–29; *see also id.* at 33 (“The human mind cannot provide the functionality or output of an interface interlinked to an on-site and off-site storage system, where electronic financial documents are stored within this integrated system based on a predetermined document parameter.”). In its supplemental briefing addressing the Guidance, Patent Owner maintains that “no claims are directed to an abstract idea,” but “addresses only the Guidance’s revised Prong Two procedure.” PO PEG Br. 2 n.1.

[REDACTED]

[REDACTED]

For the reasons discussed below, we determine that the challenged claims, viewed as a whole, are directed to a judicial exception for two reasons. First, the claims are directed to “organizing, storing, and retrieving financial documents.” *See* Pet. 47. Organizing, storing, and retrieving financial documents, such as checks or tax documents, is a long-established fundamental economic practice. Under the Guidance, a fundamental economic practice is one of certain methods of organizing human activity that is an abstract idea. USPTO § 101 Guidance, 84 Fed. Reg. at 51–55. Second, the claims, viewed as a whole, are directed to comparing a document characteristic to a predetermined document characteristic to determine how to organize, where to store, and how to retrieve financial documents. *See* Pet. 37. Comparing a document characteristic to a predetermined characteristic is a mental process that is an abstract idea under the Guidance. *Id.*

The challenged claims recite the steps of organizing, storing, and retrieving financial documents. The following specific limitations recite the steps of organizing, storing, and retrieving financial documents. Claim 1, for example, recites “*storing* a plurality of financial documents . . . at the first storage system [a storage system “remotely-located” from the second storage system, e.g., an off-site storage system],” “*storing* a plurality of financial documents . . . at the second storage system [e.g., an on-site storage system],” “*receiving a request* for at least one of the stored financial documents,” “*inputting the request* into the computer terminal,” “*accessing*” the first or second storage system, and “*retrieving*” the requested financial document from the accessed storage system. Ex. 1001, 11:28–67 (emphasis

[REDACTED]


[REDACTED]

added). Claim 23 similarly recites “maintaining” financial documents in off-site and on-site storage systems, “receiving a request” for a financial document, “inputting the request into the computer terminal,” “accessing” the off-site or on-site storage system, and “retrieving” the requested financial document from the accessed storage system. *Id.* at 13:13–45. Claim 45 similarly recites “providing an outsourcing institution associated with [an] off-site storage system,” “associating the financial institution with [an] on-site storage system,” “maintaining” a financial document with the outsourcing institution or financial institution, “receiving a request,” “inputting the request into the computer terminal,” “accessing” the off-site or on-site storage system, and “retrieving” the requested financial document from the accessed storage system. *Id.* at 14:55–1530.


In addition, the following specific limitations of the claims recite the step of “comparing.” Claim 1, for example, recites “comparing the specific document parameter of the requested financial document to the predetermined parameter” to determine which storage system to access to retrieve the financial document. Claim 23 recites “comparing the specific document age of the requested financial document to the predetermined age.” Claim 45 recites the same limitation as claim 23. In summary, independent claims 1, 23, and 45 recite materially similar limitations. As discussed further below, none of the dependent claims alter our analysis of the claims.

The specification also shows that the objective of the challenged claims is organizing, storing, and retrieving financial documents based on comparing a document characteristic to a predetermined document

[REDACTED]



characteristic. For example, the '866 patent specification discloses a method for a financial institution to obtain electronically stored financial documents having a specific document parameter, such as a record date of the financial document. Ex. 1001, 2:38–42. The disclosed method allows the financial institution to obtain the financial documents from an off-site or on-site storage system. *Id.* at 2:42–45. The financial documents are maintained in the on-site or off-site storage systems based on whether the documents have parameters that are greater than or less than or equal to a predetermined parameter. *Id.* at 2:46–53; 4:41–56. The predetermined parameter is a numerical value, such as a date, or a check series number, predetermined by the bank. *Id.* at 4:66–5:13. A client, such as a customer of the bank, requests an image of a particular financial document, such as a paid check. *Id.* at 5:14–28. In one embodiment, a bank employee first compares the specific document parameter of the requested financial document to the predetermined parameter to determine if the value of the financial document parameter is greater than, less than, or equal to the predetermined value in order to determine which of the on-site or off-storage systems to access. *Id.* at 6:50–7:18. The bank employee uses a computer terminal connected to both the off-site and on-site storage systems to access one of the systems in response to the comparison. *Id.* at 7:4–11. Once the bank employee has inputted the necessary identification data, the requested financial document is retrieved as defined by the inputted identification data. *Id.* at 8:35–39. Thus, the specification reinforces that the objective of the claims is organizing, storing, and retrieving financial documents based on a document characteristic comparison.



[REDACTED]

As Petitioner persuasively shows, the claimed concept of organizing financial documents in two separate storage systems based on a document characteristic, e.g., date, is analogous to a human placing and storing a check or tax document in one of two filing cabinets, each of which corresponds to a different records year, e.g., fiscal tax year. *See* Pet. 51; Ex. 1001, 1:38–42 (disclosing that a client may request an image of a particular financial document “for tax purposes, for proof of financial transactions, for legal disputes, and other similar matters”). For example, financial records for tax year 2017 could be stored in one cabinet and financial records for tax year 2018 in a different cabinet, such that an individual could easily locate a document in the cabinets if he or she knows its date. The process of organizing, storing, and retrieving checks or tax documents is a long prevalent, fundamental, financial economic practice. Indeed, the Federal Circuit held some claims directed to organizing and storing digital images alone (arguably broader than organizing and storing the claimed “financial documents”) to be directed to an ineligible concept. *See In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (determining claims directed to “classifying and storing digital images in an organized manner” alone are abstract, and that “attaching classification data, such as dates and times, to images for the purpose of storing those images in an organized manner, is a well-established ‘basic concept’ sufficient to fall under *Alice* step 1”).

In addition, storing a financial document, accessing one of two storage systems, and inputting a request, each based on a comparison of a document characteristic to a predetermined document characteristic, involves a

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comparison in a human’s mind—and that comparison drives the organization, storage, and retrieval of the documents according to the claim language and specification.¹⁴ The Federal Circuit has held similar claims that involve organizing data based on a mental process to be directed to an abstract idea. *See FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1097 (Fed. Cir. 2016) (“[M]erely selecting information, by content or source, for collection, analysis, and [announcement] does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.” (quoting *Electric Power Group*, 830 F.3d at 1355)); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”); *see also In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) (“[M]ental processes—or processes of human thinking—standing alone are not patentable even if they

¹⁴ Patent Owner alleges that the comparison step occurs after the document retrieval request is inputted into the computer terminal. PO Resp. 31–33. Petitioner disagrees. Reply 2 n.1. Regardless of when the “comparing” step occurs in the claim, what matters is that comparing a particular document characteristic to a predetermined characteristic can be performed by the human mind and that comparison drives the organization, storage, and retrieval of the documents. *See id.* at 13–14 (Petitioner arguing that “an employee can (1) store documents in on-site and off-site filing cabinets based on records years, (2) receive a request from a customer and input it into a written retrieval form, (3) compare the requested document’s date with each cabinet’s date, and (4) retrieve the document from either cabinet based on the document date”).

[REDACTED]

have practical application.”); *Benson*, 409 U.S. at 67 (“Phenomena of nature, . . . *mental processes*, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” (emphasis added)).

Patent Owner contends that the claims are not reducible to “fundamental human activity” because the claims require “that both storage systems must work through an interface interlinked with both storage systems,” an allegedly new technique for selectively archiving and retrieving electronically stored financial documents. PO Resp. 28–30. As an initial matter, we do not agree with Patent Owner that all of the challenged claims require an “inter-linked” “interface.” *See id.* at 4 n.2; Reply 1–2. Claim 1, for example, merely recites a “computer terminal connected to the first and second storage systems through a processing unit.” The only claims that recite “inter-link[ing]” or an “interface” are dependent claims 26 (“interlinked computer program”), 37 (“primary interface inter-linked with the on-site storage system”), 39 (“secondary interface inter-linked with the off-site storage system”), and 40 (depending from claim 39). None of the other claims recite such features.

Importantly, though, we find that *even if* the challenged claims require an interlinked-interface that interlinks two separate interfaces or interlinks with two separate storage systems, as Patent Owner contends, they still recite an abstract idea under Step 2A, Prong 1. Such a limitation, for example, does not alter our determination that the steps cited above are directed to “organizing, storing, and retrieving financial documents,” based on a “comparison.” The alleged interlinked “interface” aspect of the claims

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(either two interfaces that are interlinked or an interface that is interlinked to both on-site and off-site systems) is analogous to the mental process of determining which filing cabinet, on-site or off-site, to access to retrieve a document. Thus, even considering the alleged interlinked “interface,” the claims are directed to “organizing, storing, and retrieving financial documents,” which is a fundamental economic practice that is a certain method of organizing human activity, based on a comparison, a mental process.

In sum, we determine that the challenged claims, each considered as a whole, are directed to organizing, storing, and retrieving financial documents based on comparing a document characteristic to a predetermined characteristic. Organizing, storing, and retrieving financial documents is a fundamental economic or business practice, as Petitioner persuasively shows. Pet PEG Br. 2. Indeed, the ’866 patent explains that banks (i.e., businesses) organize, store, and retrieve financial documents. Ex. 1001, Abstract. In addition, comparing a document characteristic to a predetermined characteristic is a mental process, as Petitioner also persuasively shows. Pet. 37. Accordingly, we conclude the claims recite a fundamental economic or business practice, which is one of certain methods of organizing human activity, and a mental process, each of which are identified in the Guidance as an abstract idea. 84 Fed. Reg. at 52.

b. USPTO Guidance Step 2A, Prong 2

The Supreme Court has long distinguished between principles themselves (which are not patent eligible) and the integration of those principles into practical applications (which are patent eligible). *See, e.g.,*

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Alice, 573 U.S. at 217 (explaining that “in applying the § 101 exception, we must distinguish between patents that claim the ‘buildin[g] block[s]’ of human ingenuity and those that integrate the building blocks into something more” (quoting *Mayo*, 566 U.S. at 89), and stating that *Mayo* “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”); *Mayo*, 566 U.S. at 80, 84 (noting that the Court in *Diehr* found “the overall process patent eligible because of the way the additional steps of the process integrated the equation into the process as a whole,” but the Court in *Benson* “held that simply implementing a mathematical principle on a physical machine, namely a computer, was not a patentable application of that principle”); *Bilski*, 561 U.S. at 611 (“*Diehr* explained that while an abstract idea, law of nature, or mathematical formula could not be patented, ‘an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.’” (quoting *Diehr*, 450 U.S. at 187) (emphasis in original)); *Diehr*, 450 U.S. at 187, 192 n.14 (explaining that the process in *Flook* was ineligible not because it contained a mathematical formula, but because it did not provide an application of the formula). The Federal Circuit likewise has distinguished between claims that are “directed to” a judicial exception (which require further analysis to determine their eligibility) and those that are not (which are therefore patent eligible). *See, e.g.*, MPEP § 2106.06(b) (summarizing *Enfish, McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016), and other cases that found claims eligible as

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improvements to technology or computer functionality instead of abstract ideas).

In agreement with Supreme Court and Federal Circuit precedent, under the Guidance, if a claim recites an abstract idea, it must be analyzed to determine whether the recited judicial exception is integrated into a practical application of that exception. 84 Fed. Reg. at 53. Under USPTO Guidance Step 2A, Prong 2, a claim reciting an abstract idea is not “directed to” the abstract idea if the “claim as a whole integrates the recited judicial exception into a practical application of that exception.” *Id.* Step 2A, Prong 2 is evaluated by “(a) [i]dentifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application.” *Id.* at 54–55. “A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *Id.* at 53 (emphasis added). However, “[m]erely includ[ing] instructions to implement an abstract idea on a computer” and “merely us[ing] a computer as a tool to perform an abstract idea” are not “practical applications” under Step 2A, Prong 2. *Id.* at 55.

Petitioner argues that the claim elements beyond those that recite the abstract idea merely implement the abstract idea on generic computer components. Pet. PEG Br. 3–4 (citing Pet. 44–50, 56–62). For example, according to Petitioner, the following recited limitations of claim 1—

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“storage system,” “fixed medium,” “computer terminal,” and “processing unit”—are generic computer technology. Pet. 55. Petitioner asserts that claim 1 “recites nothing more than the use of generic computers accessing one of two storage systems,” and that “the *comparing* step and determination *which* storage system to access is a *human* activity, not a technological one.” *Id.* at 58–59. Petitioner also contends that an “interface” is a generic computer component. *Id.* at 59. According to Petitioner, the claims do not improve the functioning of a computer or improve another technology, but instead merely perform the abstract idea using a computer. Pet. PEG Br. 5 (citing Pet. 44–48, 56–62).

Patent Owner disagrees, arguing that the challenged claims integrate a “practical application” of any alleged abstract idea because the claims “provide several new techniques [or “improvement”] for selectively archiving and retrieving electronically stored financial documents.” PO Resp. 28–30; PO PEG Br. 2–4 (asserting that independent claims 1, 23, and 45 “integrate a practical application of the concept of organizing, storing, and retrieving financial documents”). Patent Owner further asserts that claim 23 “describes a system that stores (and later retrieves) into on-site or off-site systems automatically based on an inherent document characteristic through interfaces interlinked with each storage system”; claims 37–39, which depend from independent claim 23, “describe interlinked primary and secondary interfaces customized to the type of storage system”; claim 39 describes a “customized ‘primary interface inter-linked with the on-site storage system,’ and the specification provides an exemplary implementation of how this interface is customized for the on-site storage

[REDACTED]

[REDACTED]

system”; and claims 38 and 39 provide a “customized ‘secondary interface inter-linked with the off-site storage system,’ which is initiated by ‘selecting an exit function at the primary interface.’” PO PEG Br. 2–3. Patent Owner further contends that the claims require “that both storage systems must work through an interface interlinked with both storage systems.” PO Resp. 28–29. Patent Owner alleges that the claims solve the specific problem of selectively archiving and retrieving financial documents “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.” *Id.* at 26–27; *see id.* at 27–28 (alleging that the claims’ “discrete solution” to classifying and storing digital data in an organized manner within a single isolated system is “interlinking on-site and off-site financial document storage systems to a unified interface” and a “unified system that harmonizes on-site and off-site storage systems”); *id.* at 31 (arguing that the 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”).

We determine that the challenged claims do not integrate the abstract idea of organizing human activity (here, organizing, storing, and retrieving financial documents) or of a mental process (here, comparing a document characteristic to a predetermined characteristic) into a “practical application,” as recognized by precedent. In *Enfish*, for example, the Federal Circuit formulated the step-one *Alice* inquiry as “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,

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instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish*, 822 F.3d at 1335–36 (citing *Alice*, 573 U.S. at 217, 220–24). The Federal Circuit rejected a § 101 challenge because the claims “are directed to a specific improvement to the way computers operate, embodied in the self-referential table.” *Id.* at 1336. The *Enfish* Court was “not faced with a situation where general-purpose computer components are added post-hoc to a fundamental economic practice or mathematical equation.” *Id.* at 1339; see *Electric Power*, 830 F.3d at 1354 (characterizing the claims in *Enfish* as improving how computers carry out the “basic functions of storage and retrieval of data”). In *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014), the court determined that the invention was “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” and that the claimed invention did not simply use computers to serve a conventional business purpose.

Automating an abstract idea is not per se subject matter ineligible. However, the particular facts of this case dictate otherwise because the claims recite using generic computer components as tools to organize, storage, and retrieve financial documents. Patent Owner argues the limitations of independent claims 1, 23, and 45 that integrate the abstract idea into a “practical application” are “maintaining elements”—the financial document is maintained in an on-site or off-site storage system depending on the “predetermined age” of the document; a “utilizing element”—a computer terminal is associated with a financial institution and connected to the off-site and on-site storage systems through a processing unit; “inputting and

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[REDACTED]

“an interface interlinked with both storage systems,” the specification details the implementation of this technological solution, and the dependent claims further define and extend the patent’s inventive concepts. PO Resp. 6–9, 28–31; PO PEG Br. 3–4. In particular, claim 37 recites using a “primary interface inter-linked with the on-site storage system” when the specific document age of the financial document is less than or equal to the predetermined age. Claim 38, which depends from claim 37, recites “selecting an exit function at the primary interface when the specific document age of the financial document is greater than the predetermined age.” Claim 39, which depends from claim 38, recites “wherein the step of selecting the exit function is further defined by initiating a secondary interface inter-linked with the off-site storage system and inputting identification data into the secondary interface.”

The specification discloses an embodiment in which an employee utilizes a computer terminal located at the bank and connected to both the off-site and on-site storage systems to access one of the storage systems in response to the comparison of the specific document parameter of the requested financial document to the predetermined parameter. Ex. 1001, 7:6–11. “[W]hen the particular numerical sequence of the financial document is less than or equal to the predetermined numerical value, the employee inputs identification data [of the requested financial document] into a primary interface and selects the requested document.” *Id.* at 7:26–30. “The primary interface is inter-linked with the on-site storage system.” *Id.* at 7:32–33. The specification further discloses that in this embodiment, “[w]hen the particular numerical sequence of the financial document is

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greater than the predetermined numerical value, the employee selects an exit function at the primary interface.” *Id.* at 7:58–61. “The exit function distinguishes that the request is to be sent to an outsourcing third party entity,” and “[u]pon selection of the exit function at the primary interface, a secondary interface, inter-linked with the exit function, is initiated.” *Id.* at 7:61–65. “The secondary interface is inter-linked with the off-site storage system” and “[t]he employee inputs identification data into the secondary interface and selects the requested document.” *Id.* at 7:65–8:1. “Once the bank employee has inputted the necessary identification data into either the primary or secondary interface,” “the requested financial document is retrieved as defined by the inputted identification data.” *Id.* at 8:35–39.

Even assuming all the challenged claims are limited to “an interface interlinked to both storage systems” (PO Resp. 4), the claims do not limit the abstract idea to a practical application. Using an “interface” “inter-linked” with, or to, on-site and off-site storage systems is merely using the generic capability of a computer being connected to other computer systems to implement an ineligible method of organizing human activity directed to organizing, storing, and retrieving financial documents. The ’866 patent claims cannot fairly be read as reciting an “interface” that improves computer functioning. Here, neither the specification nor the claims provide details explaining that the claimed “interface” interlinked with, or to, two separate storage systems (e.g., on-site and off-site) improves computer functioning. *See Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271–72 (Fed. Cir. 2016) (“The only putatively narrowing limitation in that result-focused claim is the limitation requiring that the ‘network

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based media managing system' have 'a customized user interface page for the given user.'"). The '866 patent specification does not suggest that the computer is improved from a technical perspective, or that it would operate differently than it otherwise could. *See ChargePoint, Inc. v. SemaConnect, Inc.*, -- F.3d --, 2019 WL 1388304, at *5 (Fed. Cir. Mar. 28, 2019) ("Notably, however, the specification never suggests that the charging station itself is improved from a technical perspective, or that it would operate differently than it otherwise could."). In addition, the specification does not suggest that the invention involved overcoming "some sort of technical difficulty" in adding an "interface" interlinked to on-site and off-site storage systems—i.e., with the "interface" simply connecting the two storage systems together in a network. *See id.* ("Nor does the specification suggest that the invention involved overcoming some sort of technical difficulty in adding networking capability to the charging stations.").

Patent Owner contends that the '866 specification describes "customized" interfaces and "*technologically details*" an embodiment to show how the "specific 'exit function' document selection method can be implemented." PO Resp. 47; PO PEG Br. 4. However, these disclosures merely describe using the general purpose computer components, e.g., a primary interface with an exit function that initiates a second interface, to improve accessing one of two storage systems and retrieve financial documents efficiently. For example, the specification provides examples of "primary" and "secondary" interfaces (Ex. 1001, 7:32–57, 8:15–33), but neither the claims nor the specification reveal any concrete way of employing a customized user interface. *Affinity Labs*, 838 F.3d at 1271. In

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addition, the specification discloses that “the employee selects an exit function at the primary interface.” Ex. 1001, 7:60–61. The specification further states that “[u]pon selection of the exit function at the primary interface, a secondary interface, inter-linked with the exit function, is initiated” and “[t]he secondary interface is inter-linked with the off-site storage system.” *Id.* at 7:63–66. But the specification does not disclose a non-generic “exit function” in an interface that initiates a secondary interface when the “exit function” is selected resulting in improving computer functioning. The claims fare no better, as they merely recite using these generic components. For example, claim 39 recites “wherein the step of selecting the exit function is further defined by initiating a secondary interface inter-linked with the off-site storage system and inputting identification data into the secondary interface.” Thus, even if the claims require an interlinked interface, we determine that they are directed to organizing, storing, and retrieving financial documents from on-site and off-site storage systems using a computer as a tool. Specifically, a financial document is retrieved from the appropriate storage system based on a comparison of a document characteristic to a predetermined document characteristic.

Moreover, despite Patent Owner’s argument that the claims solve the problem of selectively archiving and retrieving financial documents stored in separate electronic storage systems does not render the claims patent eligible. *See e.g.*, PO Resp. 25–28, 31. Merely limiting the field of use of the abstract idea to a particular existing environment (i.e., limiting the methods to outsourcing institutions and/or financial institutions using

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separate storage systems), does not render the claims patent eligible. The Supreme Court and the Federal Circuit have repeatedly made clear that merely limiting the field of use of the abstract idea to a particular existing environment does not render the claims any less abstract. *See Alice*, 573 U.S. at 222–23; *Mayo*, 566 U.S. at 71–72; *Bilski*, 561 U.S. at 610–11; *Content Extraction*, 776 F.3d at 1348; *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014).

(1) *Example 37, Claim 1*

Patent Owner analogizes the challenged claims to Example 37, claim 1 of the Office’s “Subject Matter Eligibility Examples: Abstract Ideas” (“USPTO Eligibility Examples”),¹⁵ which Patent Owner describes as “integrat[ing] a mental process into a practical application.” PO PEG Br. 4–5. Example 37, claim 1 recites as follows:

A method of rearranging icons on a graphical user interface (GUI) of a computer system, the method comprising:

receiving, via the GUI, a user selection to organize each icon based on a specific criteria, wherein the specific criteria is an amount of use of each icon;

determining, by a processor, the amount of use of each icon over a predetermined period of time;

and automatically moving the most used icons to a position on the GUI closest to the start icon of the computer system based on the determined amount of use.

USPTO Eligibility Examples, 2. “Background” information for the example

¹⁵ Example 37, claim 1 can be found here:
https://www.uspto.gov/sites/default/files/documents/101_examples_37to42_20190107.pdf.

[REDACTED]

provides that “[t]raditionally . . . [t]he typically available ways to organize icons are alphabetically, by file size, and by file type. If a computer user wants a non-typical arrangement of icons, the user would need to manually manipulate the icons on their display.” *Id.* at 1. The information further indicates “[t]herefore, what is needed is a method that allows for such non-traditional arrangements to be performed automatically.” *Id.* Example 37, claim 1 “addresses this issue by providing a method for rearranging icons on a graphical user interface (GUI), wherein the method moves the most used icons to a position on the GUI, specifically, closest to the ‘start’ icon of the computer system, based on a determined amount of use.” *Id.*

Patent Owner’s reliance on Example 37, claim 1 is misplaced because this claim, unlike the challenged claims, is directed to improving the functioning of a computer. The example determines at the “Step 2A – Prong 2” analysis that a judicial exception is recited because “the limitation of determining the amount of use of each icon over a predetermined period of time” “is a process that, under its broadest reasonable interpretation, covers performance of the limitation in the mind but for the recitation of generic computer components.” *Id.* at 2. The example further determines, however, that the judicial exception is integrated into a practical application at the “Step 2A – Prong 2” analysis of the Guidance. *Id.* Specifically, “[t]he claim as a whole integrates the mental process into a practical application” because “the additional elements recite a specific manner of automatically displaying icons to the user based on usage which provides a specific improvement over prior systems, *resulting in an improved user interface for electronic devices.*” *Id.* at 2–3 (emphasis added).

[REDACTED]

[REDACTED]

Here, the challenged claims are not directed to improving the functioning of a computer by, for example, implementing an improved interface. As discussed above, the '866 patent is not directed to an improved "interface." Rather, at most, the claims recite organizing, storing, and retrieving financial documents based on comparing a document characteristic to a predetermined document characteristic, respectively a certain method of organizing human activity and a mental process under the Guidance.

For the foregoing reasons, we determine that the challenged claims do not integrate the abstract idea into a practical application under the Guidance.

2. *Alice Step 2/USPTO Step 2B: Whether Challenged Claims Contain an Inventive Concept*

Under the second step of the *Alice* inquiry, we must "scrutinize the claim elements more microscopically" for additional elements that might be understood to "transform the nature of the claim" into a patent-eligible application of an abstract idea. *Electric Power*, 830 F.3d at 1353–54; *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) ("To save a patent at [*Alice*] step two, an inventive concept must be evident in the claims."). That is, we determine whether the claims include an "inventive concept," i.e., an element or combination of elements sufficient to ensure that the patent in practice amounts to significantly more than a patent on the abstract idea itself. *Alice*, 573 U.S. at 221. "For the role of a computer in a computer-implemented invention to be deemed meaningful in the context of this analysis, it must involve more than performance of

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‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction*, 776 F.3d at 1347–48 (alteration in original) (quoting *Alice*, 573 U.S. at 225).

Petitioner argues that the claimed elements, viewed individually and as an ordered combination, do not transform the nature of the claims into a patent-eligible application of an abstract idea. Pet. 55–76. Specifically, Petitioner contends that the “‘computer technology’ of [claim 1]—‘storage system,’ ‘fixed medium,’ ‘computer terminal,’ ‘processing unit’—are previously known technologies performing only their conventional functions.” *Id.* at 55 (citing Ex. 1007 ¶ 116); *id.* at 56–58, 62–67. Petitioner also contends that the recitation of “storage medium,” “inter-linked” computer software, “outsourcing institution,” and document classification types, “well-known post-solution activities [recited] at a high level of generality,” and “routine computer activities or data processing functions to retrieve a document,” as recited in various claims, do not amount to an “inventive concept” or “something more” sufficient for eligibility. *Id.* at 65–76.

Patent Owner argues that the challenged claims do recite an “inventive concept” and are similar to those found patent eligible in *DDR* because they provide a “technological solution to challenges arising in computer networks.” PO Resp. 37–38. Patent Owner alleges that conventional systems “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

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interlinked and *unified* interface.” *Id.* at 38–42. Patent Owner urges that “it is [Patent Owner’s] idea to interlink [software that carries out conventional ‘processing, retrieval, and reproduction’] with off-site and on-site storage systems through a unified system and interface.” *Id.* at 49–50. According to Patent Owner, the challenged claims “finally allow[] banks to effectively outsource older documents and in-source high-demand, newer documents through a unified and harmonized and interlinked system.” *Id.* at 42 (citing Ex. 2039 ¶ 43); *id.* at 45 (the challenged 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.”). Patent Owner further contends that the ’866 patent provides the “**limiting detail** that confines the claims to a particular solution to an identified problem.” *Id.* at 43 (quoting *Affinity Labs*, 838 F.3d 1266 (emphasis added by Patent Owner)). Patent Owner also likens the challenged claims to those in *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016), contending that they “recite an inventive combination and arrangement, because they provide an unconventional technological solution to the problem of traditional financial document archiving and retrieving systems.” *Id.* at 44–45. With respect to the dependent claims, Patent Owner focuses on the recitation of an “interface,” stressing, for example, that certain claims “add the concept of employing an exit function at the primary interface” (claims 38 and 39), “describe that the on-site and off-site storage systems are ‘inter-linked’ through a single interface” (claims 26 and 37–40), and “recite that the second storage system is associated with an outsourcing institution, which

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the specification defines as a third-party entity” (claims 22 and 46–55). *Id.* at 45–47.

Notwithstanding Patent Owner’s arguments, as Petitioner persuasively shows, the challenged claims recite only well-understood routine and conventional technology. Claim 1, for example, only requires generic computer technology—“storage system[s],” a “fixed medium,” a “computer terminal,” and a “processing unit”—all previously known technologies performing only their conventional functions. Pet. 55 (citing Ex. 1007 ¶¶ 116); *see id.* at 56–58; Ex. 1007 ¶¶ 121–123. Moreover, the ’866 patent specification explains that “comparing” a document’s parameter to a predetermined parameter can be performed by a bank employee. Ex. 1001, 6:50–7:3; *see* Ex. 1007 ¶¶ 118, 120. Petitioner also establishes that migrating, storing, and retrieving documents, implemented on computers, based on the age or date of the document (i.e., a “retention schedule”) was routine. Pet. 8–9 (citing Ex. 1007 ¶¶ 68, 69; Ex. 1014; Ex. 1015); *see* Reply 2, 8–11; Ex. 1013, 81. Outsourcing documents off-site, as recited in claim 22, for example, was conventional as well. Ex. 1001, 2:6–7; Ex. 1014, 35, 170; Exs. 1021–23; Ex. 1007 ¶ 83. Similarly, the ’866 patent admits that “an interlinked computer program,” as recited in claim 26, was a conventional off-the-shelf computer program:

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

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PEGA™ and Sterling™. *Any of these computer software systems can provide the necessary means for implementing the discussed procedures.*

Ex. 1001, 6:28–38 (emphases added).

Patent Owner’s allegation that the challenged claims recite an “inter-linked” “interface” also does not render the claims patent eligible under Step Two of *Alice*. The use of interfaces to access and retrieve documents from storage systems was conventional. *See, e.g., Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016) (generic computer components such as an “interface,” “network,” and “database” “do not satisfy the inventive concept requirement”). Furthermore, the ’866 patent acknowledges that “an interlinked program” (Ex. 1001, 6:28–38) recited in claim 26, and an interface “inter-linked” with an on-site storage system (Ex. 1001, 1:43–49, 2:8–12) in claim 37, for example, are conventional. In addition, the recitation of an “exit function” in claims 38 and 39 also does not rise to the level of an inventive concept. As discussed above, the ’866 patent specification does not disclose implementing anything more than a conventional “exit function” in an interface. *See Affinity Labs*, 838 F.3d at 1271–72) (“The only putatively narrowing limitation in that result-focused claim is the limitation requiring that the ‘network based media managing system’ have ‘a customized user interface page for the given user.’ But neither the claim nor the specification reveals any concrete way of employing a customized user interface.”).

In addition, an interface that was “inter-linked” with both on-site and off-site storage systems was well-known. Ex. 1007 ¶ 81 (Petitioner’s

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declarant explaining that, in the 1990s, “[b]y associating pointers with documents, a database search at a single user interface allowed users to be inter-linked to all storage systems where they could find the desired document on those systems and retrieve the document”); *id.* ¶¶ 76–78; Ex. 1010, 24, 30 (“For instance, using the same index, it will be possible to allocate ‘active’ files to short-term, fast-access storage, while ‘inactive’ material might be kept on long-term, slower memories.”); Ex. 1012, 28, 50–51 (“The centralized database concept provides a single point of access and distribution of all document data within the system. The distributed database concept may or may not require that all locations within a given system have the capability of accessing any document within the system, wherever it is stored.”); Ex. 1014, 108–09 (stating that searching and retrieval functions “from the same end-user interface, regardless of the information’s storage location.”); Ex. 1015, 18; Ex. 2034, 78:11–79:11, 89:5–19, 117:1–25, 119:8–18; *see* Reply 4–5, 16–17; *see also* Pet. 11–13 (Petitioner referring to evidence and arguing that at the time of the ’866 patent, systems existed allowing for access to different storage locations from the same end-user interface).

Patent Owner’s argument that the challenged claims provide a technological solution to technological problem, likening the claims to those in *DDR*, is unpersuasive. PO Resp. 37–38. The ’866 patent, as discussed above, is not directed to resolving a technological problem in computer functionality as in *DDR*. *See id.* at 38 (Patent Owner acknowledging that the *DDR* “claims recited a technological solution to *challenges arising in computer networks*” (emphasis added)). Indeed, the ’866 patent addresses a

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problem in the method of storing, accessing, and retrieving financial documents—the inefficiency of accessing and retrieving documents from an off-site storage system. According to the '866 patent specification, the methods used by financial institutions to access “financial documents stored in the off-site storage system [were] deficient in that the interface utilized in such methods is only inter-linked with the on-site storage system.” Ex. 1001, 2:6–12; *see id.* at 2:12–15 (“[T]here is no interface independently inter-linked with the off-site storage system [in the prior art]. As a result, the financial documents stored in the off-site storage system cannot be efficiently accessed”). The '866 patent specification, thus, recognizes a need 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 not eliminates, the back office production . . . by providing a direct interface inter-linked with the off-site storage system.” *Id.* at 2:23–28. Moreover, the solution provided by the '866 patent *disclosure* is not a technological solution, but rather uses generic computer components (e.g., two interlinked interfaces or a single interface interlinked to on-site and off-site storage systems) to provide a business solution—allowing financial institutions to outsource document management off-site while maintaining access to the documents.

Patent Owner contends the challenged claims “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.*” PO Resp. 38 (emphasis added); *id.* (“[The] claims provide a hybrid on-site and third-party off-site storage

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solution within a single interface (like *DDR Holdings*'s single web page interface) interlinked with both storage systems.”). As discussed above, an interface interlinked to both on-site and off-site storage systems was not necessary to allow a financial institution to outsource the off-site storage system to a third-party. Outsourcing of document storage to an off-site storage system was conventional. Ex. 1001, 2:6–7; Ex. 1014, 35, 170; Exs. 1021–23; Ex. 1007 ¶ 83. In any event, using a generic interface interlinked to an off-site storage system that allows a financial institution to outsource the off-site storage system to a third-party while having efficient access to the outsourced documents does not render the abstract idea patent eligible. *See* Ex. 1001, 2:28–33 (“With such an interface, the responsibility for retrieving financial documents from the off-site storage can be outsourced to third party entities while still providing the financial institution with efficient access to any financial documents electronically-stored in the off-site storage system.”). As Petitioner argues (Reply 15), removing the financial institution’s document management burden of storing documents in an off-site storage system by using a generic interface is a business solution.

In addition, Patent Owner acknowledges that the challenged claims “use known computer functions to execute steps performed by a computer,” but contends they recite an inventive concept “in the nonconventional and non-generic arrangement of known conventional pieces.” PO Resp. 45 (quoting *BASCOM*, 827 F.3d at 1349). Patent Owner, however, again alleges that the challenged claims “recite an inventive combination and arrangement, because they provide an unconventional technological solution to the problem of traditional financial document archiving and retrieving

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factors between the challenged claims and these prior art systems does not contradict Petitioner’s showing, as discussed above, that the challenged claims recite only generic components. Also, Patent Owner does not dispute that an interface connected to different storage systems was known prior to the invention. *See* Tr. 106:20–107:6 (Patent Owner distinguishing such a known interface as not being customized and arguing “a generic interface that is connected to multiple storage systems wouldn’t render any of the inventive concepts conventional”).

In sum, we determine that the claims do not recite an unconventional and non-generic arrangement of generic computer components. Thus, whether we consider the limitations in isolation or as an ordered combination, we determine that the recited components are nothing more than well-understood routine and conventional technology.

F. Declarant’s Credibility

Patent Owner contends Mr. Gray “fails to mention his diametrically opposed understanding of inter-linked interfaces” in earlier testimony relative to his testimony in this proceeding. PO Resp. 60–61 (citing Ex. 1007 ¶ 76; Ex. 2007 ¶ 30). Based on this alleged “contradictory testimony” about what “interlinked interfacing” means, Patent Owner contends that we should not rely upon Mr. Gray’s testimony. *Id.* at 61–62. Specifically, Patent Owner contends Mr. Gray testifies in this proceeding that “Inter-linked Software and User Interfaces for Searching and Retrieving Documents Were Well-Known” and “[s]uch interfaces . . . were conventional in the art during the 1990s” (*id.* at 60 (quoting Ex. 1007 ¶ 76)), but in the earlier proceeding, he testified that “[t]he term ‘inter- linked’ used

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in the patent appears to be a **coined term**” (*id.* at 61 (quoting Ex. 2007 ¶ 30) (emphasis by Patent Owner)). Patent Owner contends that “interlinked interfacing between on-site and off-site storage systems is a core function and inventive feature of [Patent Owner’s] claims,” and Patent Owner also appears to assert that the named inventors of the ’866 patent coined the term “inter-linked.” *See id.* at 61–62 (“[Mr.] Gray’s conspicuous omission of the true source of the term ‘inter-linked’ in the field—the Mirror Imaging inventors—is telling.”). Petitioner responds that Mr. Gray’s testimony is not contradictory. Reply 27–28.

Mr. Gray’s testimony is credible and supports the assertions made by Petitioner in this proceeding. In the instant proceeding, Mr. Gray testifies that prior art systems used the same types of interfaces that the ’866 patent describes as “‘providing a direct interface inter-linked with the off-site storage system’ linked to both the on-site and off-site storage to mitigate back office production costs.” Ex. 1007 ¶ 76 (quoting Ex. 1001, 2:21–28). Regardless of whether or not the prior art literature refers specifically to the prior art interfaces (or programs) as “inter-linked,” Mr. Gray cites to evidence in the record in support of his opinion that “[s]uch interfaces . . . were conventional in the art during the 1990s, and certainly before 1999, to facilitate users’ ability to search, access, and retrieve documents and document images from both local and remote storage media.” *Id.* ¶¶ 76, 77–82 (citing Exs. 1010–12; Ex. 1014; Ex. 1015; Ex. 1018).

The record evidence supports Mr. Gray’s testimony (*see, e.g.*, Exs. 1010–12; Ex. 1014; Ex. 1015; Ex. 1018) as indicated above, supporting his credibility, and his testimony aids the panel in resolving issues. Patent

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Owner cross-examined Mr. Gray and does not point the panel to anything in his deposition testimony that undermines his credibility. *See* Ex. 2034 (deposition testimony); PO Resp. 61 (citing Ex. 2034, 112–113). We have reviewed the declaration and cross-examination testimony of the parties’ declarants, Mr. Gray (Ex. 1007) and Mr. Ashley (Ex. 2039), in light of the record evidence and issues discussed above, and find Mr. Gray’s testimony to be credible and supportive of Petitioner’s arguments that the challenged claims are not patent eligible.

Patent Owner has not shown that Mr. Gray’s testimony lacks credibility or reliability such that we should give it less weight or disregard it. *See In re TMI Litig.*, 193 F.3d 613, 692 (3d Cir. 1999) (“So long as the expert’s testimony rests upon ‘good grounds,’ it should be tested by the adversary process—competing expert testimony and active cross-examination” (quoting *Ruiz-Troche v. Pepsi Cola of Puerto Rico Bottling Co.*, 161 F.3d 77, 85 (1st Cir. 1998))).

III. CONCLUSION

Accordingly, Petitioner has met its burden of demonstrating that the ’866 patent is a covered business method patent eligible for review. Petitioner has also met its burden of demonstrating by a preponderance of the evidence that claims 1–55 of the ’866 patent are unpatentable under 35 U.S.C. § 101. This is a Final Written Decision of the Board under 35 U.S.C. § 328(a). Parties to the proceeding seeking judicial review of this decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IV. ORDER

It is

ORDERED that claims 1–55 of the '866 patent are unpatentable.

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Patent 6,963,866 B2



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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **JOINT PROPOSED REDACTED FINAL WRITTEN DECISION** was served on April 22, 2019, via email directed to counsel of record for the Patent Owner at the following:

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