

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

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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

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