

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 CBM2017-00067
U.S. Patent No. 9,141,612

JOINT PROPOSED REDACTED FINAL WRITTEN DECISION

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Case CBM2017-00067
Patent 9,141,612 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 1–18 of U.S. Patent No. 9,141,612 B2 (Ex. 1001, “’612 patent”), pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”).¹ Paper 1 (“Pet.”). On April 19, 2018, we instituted a covered business method patent review of claims 1–18 of the ’612 patent under 35 U.S.C. § 101. Paper 22 (“Decision on Institution” or “Inst. Dec.”), 40–41; *see* Paper 25 (public redacted version). Patent Owner, Mirror Imaging, LLC (“Patent Owner” or “Mirror Imaging”), filed a request for rehearing of the Decision on Institution, which we denied. Paper 32 (“Reh’g Dec.”); *see* Paper 34 (public redacted version).

Subsequently, Patent Owner filed a Patent Owner Response (Paper 39, “PO Resp.”),² and Petitioner filed a Reply (Paper 45, “Reply”). With authorization (Paper 58), Petitioner (Paper 61, “Pet. PEG Br.”) and Patent Owner (Paper 60, “PO PEG Br.”) filed supplemental briefing addressing the impact of the Office’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (the “Guidance”), available at

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 40, 41. Accordingly, the Response will be made public.

<https://www.federalregister.gov/documents/2019/01/07/2018-28282/2019-revised-patent-subject-matter-eligibility-guidance>.

An oral hearing occurred on January 15, 2019, and the record includes a transcript of the hearing. Paper 62 (“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 1–18 of the ’612 patent are unpatentable under § 101.

B. Related Matters

Petitioner identifies numerous federal district court actions filed by Patent Owner involving the ’612 patent and related patents in the U.S. District Court for the Eastern District of Texas. Pet. 80–83. Petitioner also identifies two closed related district court matters filed in the same district. *Id.* at 83. Patent Owner provides a list of numerous district court actions in which it asserts infringement of the ’612 patent. Paper 7. Patent Owner also cites two recently allowed applications related to the ’612 patent. PO Resp. 60–61 (citing Exs. 2005, 2014, 2030); *see also* Paper 52 (citing a Notice of Allowance for U.S. Patent Application No. 15/990,160 (Ex. 2034)). On April 9, 2019, we issued final written decisions in Cases CBM2017-00064 and CBM2017-00065 involving patents related to the ’612 patent.

C. The ’612 Patent

The ’612 patent discloses methods and systems for financial institutions, such as banks and credit unions, to store and retrieve financial

documents from both on-site and off-site storage systems. Ex. 1001, [57], 1:47–2:4, 2:29–41. The '612 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 1:52–56. “The interface is inter-linked with the on-site storage system.” *Id.* at 1:56–57. The '612 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 1:63–66. According to the '612 patent, 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 2:5–7. Therefore, 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 2:7–13.

Further, according to the '612 patent, “[o]ther financial institutions do electronically store financial documents in on-site and off-site storage systems.” *Id.* at 2:14–15. 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 2:15–19. “That is, there is no interface independently inter-linked with the off-site storage system.” *Id.* at 2:19–21. Therefore, according to the '612 patent, the financial documents in the off-site storage system cannot be accessed efficiently. *Id.* at 2:21–23.

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