

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIDELITY NATIONAL INFORMATION SERVICES, INC.,
Petitioner,

v.

DATATREASURY CORP.,
Patent Owner.

Case IPR2014-00491
Patent 5,910,988

Before MICHAEL P. TIERNEY, WILLIAM V. SAINDON, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Fidelity National Information Services, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 9, 11-21, 26, 27, 29-32, 34, 35, 51-53, 55-62, 64, and 65 (“the challenged claims”) of U.S. Patent No. 5,910,988 (Ex. 1001, “the ’988 patent”). Paper 2 (“Pet.”). DataTreasury Corp. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

Upon consideration of the Petition and Preliminary Response, we determine that the information presented by Petitioner has not established that there is a reasonable likelihood that Petitioner would prevail in showing unpatentability of the challenged claims of the ’988 patent. Accordingly, the Petition is denied.

A. *Related Proceedings*

Petitioner and Patent Owner indicate that the ’988 patent is involved in three co-pending district court cases in the United States District Court for the Eastern District of Texas: *DataTreasury Corp. v. Fiserv, Inc.*, 2:13-cv-00431 (E.D. Tex. filed May 28, 2013); *DataTreasury Corp. v. Jack Henry & Associates, Inc. et al.*, 2:31-cv-00433 (E.D. Tex. filed May 28, 2013); and *DataTreasury Corp. v. Fidelity National Information Services, Inc. et al.*, 2:13-cv-00432 (E.D. Tex. filed May 28, 2013). Pet. 4-5; Paper 4, 2-3. Petitioner and Patent Owner also identify several closed district court proceedings involving the ’988 patent. Pet. 4-5; Paper 4, 2-4.

Petitioner and Patent Owner also identify additional petitions for *inter partes* review and for covered business method review of the ’988 patent: CBM2014-00021, CBM2014-00057, CBM2014-00087, and IPR2014-00491. Pet. 4; Paper 4, 2; Paper 5, 1. Petitioner and Patent Owner also

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identify petitions for *inter partes* review and for covered business method review of Patent Owner's related U.S. Patent No. 6,032,137: CBM2014-00020, CBM2014-00056, CBM2014-00088, and IPR2014-00490. *Id.* Petitioner and Patent Owner also identify an *ex parte* reexamination of the '988 patent (Control No. 90/012,537) (pending). Pet. 3; Paper 4, 2.

B. The '988 patent

The '988 patent is directed to a system for remote data acquisition and centralized processing and storage of the acquired data. Ex. 1001, Abstract. An object of the invention is to provide an automated system to manage and store captured electronic and paper transactions from various activities including banking and consumer applications. *Id.* at 3:30–35. Generally, the '988 patent describes scanning documents using a scanner attached to a general purpose network computer that is connected via a carrier cloud to a server that inserts images and data received into a database. *Id.* at Figs. 1–2, 3:30–51, 4:60–67, 5:40–45, 16:38–45. Additionally, the general purpose network computer encrypts the images and data to provide a system with maximal security. *Id.* at 3:30–35, 7:31–35, 8:3–5.

Figure 1 of the '988 patent, provided below, depicts a preferred embodiment of the system having three major operational elements:

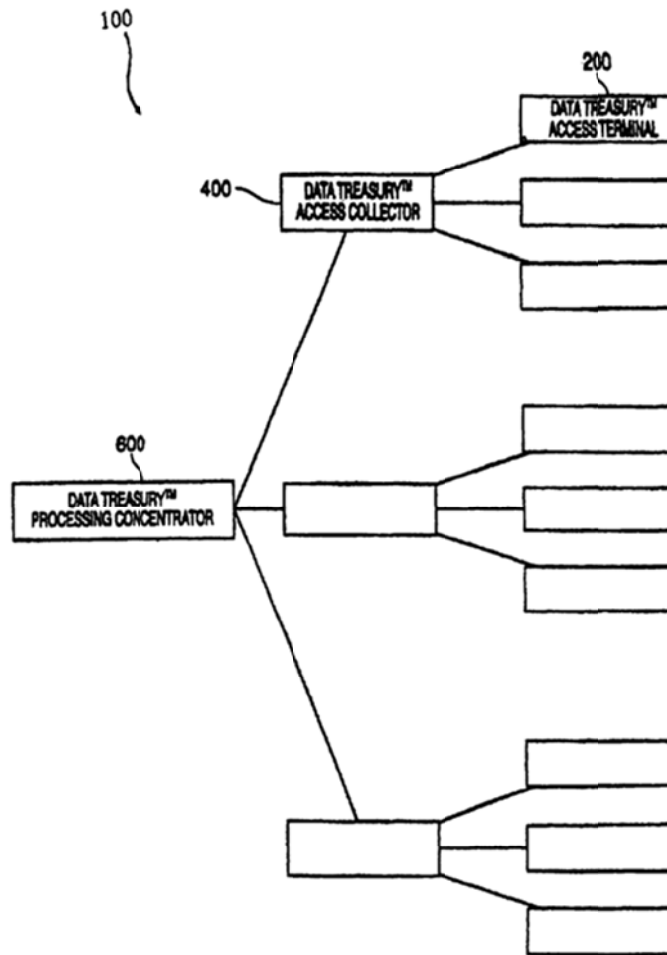


FIG. 1 (Amended)

The '988 patent describes the tiered arrangement depicted in Figure 1 as follows:

FIG. 1 shows the architecture of the DataTreasury™ System 100. The DataTreasury™ System 100 has three operational elements: the DataTreasury™ System Access Terminal (DAT) 200 (the remote data access subsystem), the DataTreasury™ System Access Collector (DAC) 400 (the intermediate data collecting subsystem), and the DataTreasury™ System Processing Concentrator (DPC) 600 (the central data processing subsystem).

Id. at 4:60–67.

Figure 2 of the '988 patent, provided below, depicts a block diagram of the DAT (remote data access subsystem terminal):

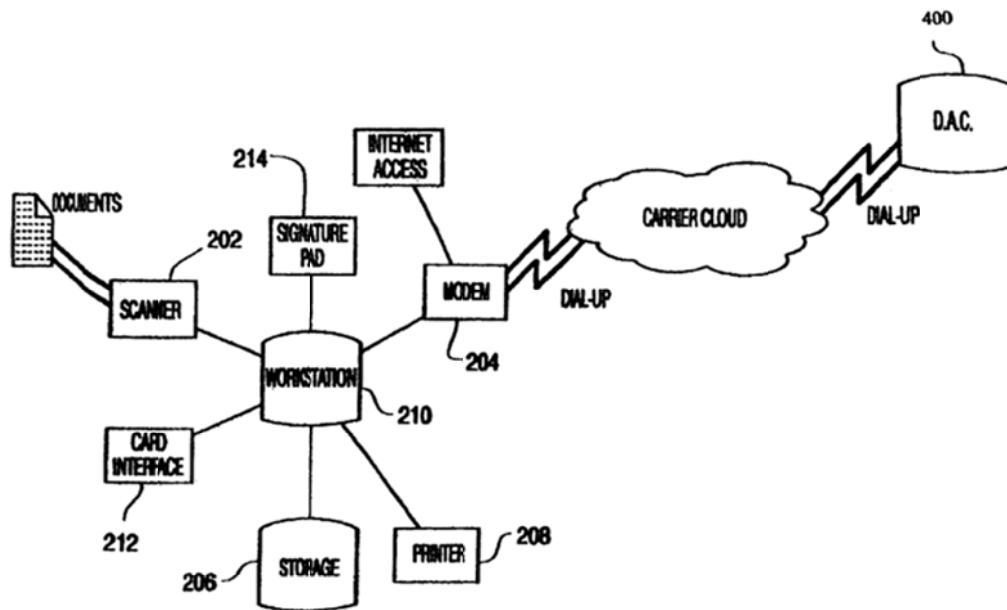


FIG. 2 (Amended)

As shown in Figure 2, a scanner 202 is connected to a workstation 210, which is connected to a data system access collector 300. The workstation can be a general purpose computer and performs tasks including compressing, encrypting, and tagging a scanned bitmapped image. *Id.* at 5:40–45, 7:31–35.

The '988 patent is said to improve upon the prior art by providing an automated, reliable, secure system to process electronic and paper transactions. *Id.* at 3:25–29.

C. Illustrative Claim

Independent claim 26 is illustrative of the challenged claims in the '988 patent and are reproduced below:

26. A method for central management, storage and verification of remotely captured paper transactions from documents and receipts comprising the steps of:

capturing an image of the paper transaction data at one or more remote locations and sending a captured image of the paper transaction data;

managing the capturing and sending of the transaction data;

collecting, processing, sending and storing the transaction data at a central location;

managing the collecting, processing, sending and storing of the transaction data;

encrypting subsystem identification information and the transaction data; and

transmitting the transaction data and the subsystem identification information within and between the remote location(s) and the central location.

D. References Relied Upon

Petitioner relies upon the following references and the declaration of

Mr. Stephen Gray (Ex. 1004):

NATHAN J. MULLER, COMPUTERIZED DOCUMENT IMAGING SYSTEMS: TECHNOLOGY AND APPLICATIONS (Artech House, Inc., 1993) (“Imaging Systems”) Ex. 1008

INTERNATIONAL BUSINESS MACHINES CORP., 3890 DOCUMENT PROCESSOR APPLICATION PROGRAMMING (1st ed. 1985) (“IBM”) Ex. 1009

Liu US 5,031,089 July 9, 1991 Ex. 1010

ROBERT P. DAVIDSON & NATHAN J. MULLER, INTERNETWORKING LANs (Artech House, Inc., 1992) (“Internetworking LANs”) Ex. 1011

Shyu US 5,923,792 July 13, 1999 Ex. 1017

Froessl US 5,109,439 Apr. 28, 1992 Ex. 1018

E. The Asserted Grounds of Unpatentability

Petitioner argues that the challenged claims are unpatentable based upon the following grounds:

Reference(s)	Basis	Claims Challenged
Imaging Systems and IBM	§ 103	1, 2, 16, 18, 26, 51, 52, 56-61, and 65
Imaging Systems, IBM, and Liu	§ 103	9, 11-14, and 19-21
Imaging Systems, IBM, and Internetworking LANs	§ 103	17 and 29
Imaging Systems, IBM, Internetworking LANs, and Liu	§ 103	30 and 31
Imaging Systems, IBM, Internetworking LANs, Liu, and Shyu	§ 103	32, 34, and 35
Imaging Systems, IBM, Liu, and Shyu	§ 103	15
Imaging Systems, IBM, and Froessler	§ 103	27

II. ANALYSIS

A. 315(b)

Patent Owner argues that the Petition should be denied under 35 U.S.C. § 315(b) because Petitioner was served with a Third Party Complaint around June 8, 2012, more than one year prior to the filing of the Petition. Prelim. Resp. 4-5. Section 315(b) of Title 35 of the United States Code bars institution of *inter partes* review when the petition is filed more than one year after the petitioner (or the petitioner's real party in interest or privy) is served with a complaint *alleging infringement of the patent*. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). Patent Owner does not allege, however, that the Third Party Complaint served upon Petitioner alleged infringement of the '988 patent. Based upon our review of the docket in *DataTreasury v. Austin Bank*, No. 6:11-CV-00470 (E.D. Tex.), the Third Party Complaint

(Dkt. No. 225) filed against Petitioner on June 8, 2012, did *not* allege infringement of the '988 patent. Ex. 3001. It alleged breach of contract and sought a declaratory judgment as to indemnity, warranty against infringement, and common law indemnity. *Id.* Because these causes of action are not an allegation of infringement of the '988 patent, we conclude that the Petition is not barred under § 315(b).

B. The Asserted Grounds

In light of the arguments and evidence, Petitioner has not established a reasonable likelihood that the challenged claims are unpatentable for the reasons discussed below.

Under our rules, the petition must contain a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence” 37 C.F.R. § 42.22(a)(2). We, therefore, decline to consider information presented in a supporting declaration, but not discussed sufficiently in a petition; among other reasons, doing so would permit the use of declarations to circumvent the page limits that apply to petitions. For the same reasons, our rules prohibit arguments made in a supporting document from being incorporated by reference into a petition. *See* 37 C.F.R. § 42.6(a)(3).

Petitioner alleges nine grounds of unpatentability. Pet. 17-43. For each ground, Petitioner provides a claim-by-claim analysis in which it alleges that the prior art teaches or suggests each element of the claim. *Id.* Petitioner cites primarily to the Declaration of Stephen Gray (“Gray Declaration”). *Id.* The Gray Declaration comprises 1,278 paragraphs across 287 pages. Ex. 1004. In those paragraphs, Mr. Gray cites almost exclusively to a 1,003-page, single-spaced, claim chart in landscape format

appended to his Declaration as Exhibit A. In the claim chart, Mr. Gray cites to the references themselves. Ex. 1004, Ex. A. As a result, the Petition involves three levels of incorporation: (1) the Petition incorporates the Gray Declaration; (2) the Gray Declaration incorporates the claim chart; (3) the claim chart incorporates from the references themselves.

For the first ground (Pet. 17-29), for example, Petitioner's analysis of independent claim 1 cites primarily to the Gray Declaration. Pet. 18-22. For example, for element T₂E₂ of claim 1, Petitioner cites only to the Gray Declaration. Pet. 19-20. In the twelve paragraphs of the Gray Declaration cited for claim 1, Mr. Gray cites exclusively to a claim chart appended to his Declaration as Exhibit A. Ex. 1004 ¶¶ 154-166. In the ten pages of claim chart analyzing claim 1, Petitioner cites, finally, to the references themselves. Ex. 1004, Ex. A, 2-12. The end result is that four pages of Petition expand to ten pages of citations to references. Petitioner uses the same approach for the other eight grounds.

On this record, the Petition's extensive reliance on citations to the Gray Declaration in lieu of citations to the references themselves amounts to an incorporation by reference of arguments made in the Gray Declaration into the Petition, thereby circumventing the page limits that apply to petitions. We, therefore, decline to consider the information found only in the Gray Declaration.

Based on the analysis presented in the Petition itself, and on our review of the portions of references cited in the Petition, Petitioner has not met its burden in establishing a reasonable likelihood that the challenged claims are unpatentable. Although the Petition includes some citations to the references themselves, those citations do not identify sufficiently the

portions of the references alleged to teach or suggest the limitations of the challenged claims. This is not a case where the references relied upon are short documents that may be understood easily absent direct pointers to relevant disclosure. The references are voluminous. The most frequently cited references—Imaging Systems, IBM, and Internetworking LANs—are 334 pages, 362 pages, and 296 pages, respectively. Exs. 1008, 1009, 1011. The few direct citations to the references themselves are not sufficient to establish a reasonable likelihood that the challenged claims are unpatentable.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition does not establish that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of the challenged claims of the '988 patent. Accordingly, we deny the Petition and do not institute an *inter partes* review of the challenged claims of the '988 patent.

IV. ORDER

Accordingly, it is

ORDERED that the Petition challenging the patentability of claims 1, 2, 9, 11-21, 26, 27, 29-32, 34, 35, 51-53, 55-62, 64, and 65 of U.S. Patent No. 5,910,988 is *denied* and no trial is instituted.

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