

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITEK SYSTEMS, INC.,
Petitioner,

v.

ROTHSCHILD MOBILE IMAGING INNOVATIONS, LLC,
Patent Owner.

Case IPR2015-00620
Patent 7,991,792 B2

Before JAMESON LEE, DAVID C. McKONE, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Mitek Systems, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute *inter partes* review of claims 1–11 of U.S. Patent No. 7,991,792 B2 (Ex. 1001, “the ’792 patent”). Rothschild Mobile Imaging Innovations, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Upon consideration of the Petition and Preliminary Response, we are *not* persuaded, under 35 U.S.C. § 314(a), that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of any of the challenged claims. Accordingly, we do not institute an *inter partes* review of claims 1–11 of the ’792 patent.

B. Related Matters

The ’792 patent has been asserted in several lawsuits in the United States District Court for the District of Delaware. Pet. 1–2; Paper 4, 2–3. It also is the subject patent of a petition filed in IPR2015-00621.

C. References Relied Upon

Petitioner relies on the following references:¹

¹ Petitioner also relies on the Declaration of Dr. Irfan Essa (Ex. 1010).

Reference		Date	Exhibit No.
Anderson	US Pat. 7,287,088 B1	Issued: Oct. 23, 2007 Filed: Oct. 6, 2000	Ex. 1003
Mortimore	US Pat. 5,950,207	Sept. 7, 1999	Ex. 1004
Miyawaki	US Pub. App. 2004/0119831 A1	June 24, 2004	Ex. 1006
Alattar	Adnan M. Alattar, “ <i>Smart Images</i> ” Using Digimarc’s Watermarking Technology, 25 IS&T/SPIE’s 12th Int’l Symp. on Elec. Imaging, Vol. 3971, 1–10 (Jan. 25, 2000)	Jan. 25, 2000	Ex. 1005

D. The Asserted Grounds

Petitioner contends that the challenged claims are unpatentable based on the following asserted grounds:

Reference(s)	Basis	Claims Challenged
Anderson	§ 102(e)	1, 3, 4, 7–9, and 11
Anderson and Mortimore	§ 103(a)	1–4 and 7–11
Anderson and Alattar	§ 103(a)	5, 6, and 11
Anderson and Miyawaki	§ 103(a)	9 and 10
Anderson, Mortimore, and Alattar	§ 103(a)	5, 6, and 11

II. ANALYSIS

A. *The '792 Patent*

The '792 patent relates generally to digital image processing. Ex. 1001, 1:25–27. It discloses a method that facilitates organizing and processing of digital and printed images. Ex. 1001, Abstr.

The '792 patent describes associating certain information with digital images, and then transferring that associated information from digital imaging devices to a local computer. Ex. 1001, 10:19–22. The local computer stores the associated information of each image in separate fields within a single record in a relational database. *Id.* at 10:22–27. With regard to encoding an identifier for each image, the '792 patent states:

Once transferred to the user's local computer or storage site, the identifier will be encoded by interacting with the relational database. The local computer processing unit (CPU) will extract the necessary information by parsing the associated information from the database and encode an identifier for each image (step 714) and, subsequently, store the identifier back in the database.

Id. at 16:49–55.

Claim 1 is the only independent claim. It recites particular steps to create an identifier for a digital image file,” and is reproduced below:

1. A method for managing a plurality of digital images over a network comprising:

receiving, at an imaging web server coupled to the network, a digital image file along with information associated to the digital image file, wherein the digital image file comprises data representing a digital image and the

associated information includes at least one of a location of the image web server, a customer identification number, a date image was taken, a picture sequence number, a name of the digital image, a time the digital image was taken, location where the image was taken at, author/publisher of the digital image, subject matter of the digital image; keyword for the digital image file and a name of the imaging web server;

parsing the associated information to extract multiple pieces of information from the associated information;

coding the multiple pieces of extracted information of the associated information to create an identifier for the digital image file;

storing the digital image file and the identifier in a database coupled to the imaging web server;

receiving a search request;

querying the database with the search request;

retrieving at least one requested digital image file matching the search request; and

presenting at least one requested digital image corresponding to the at least one requested digital image file to a user.

Ex. 1001, 18:6–33 (emphasis added).

B. Claim Construction

The Board interprets claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, No. 2014-1301, 2015 WL 4097949, at *6 (Fed. Cir. July 8, 2015). Claim terms generally are given their ordinary and customary meaning, as would be 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).

Claims are not interpreted in a vacuum but are a part of and read in light of the specification. *See Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987); *United States v. Adams*, 383 U.S. 39, 49 (1966). Indeed, although it is improper to read a limitation from the specification into the claims, the claims still must be read in view of the specification of which they are a part. *See Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1347 (Fed. Cir. 2004).

We provide a construction for the terms “parsing” and “extract” because our analysis hinges on their meaning.

“parsing”

Claim 1 recites “parsing the associated information to extract multiple pieces of information from the associated information” and “coding the multiple pieces of extracted information of the associated information to create an identifier for the digital image file.” No special definition is provided in the Specification for the term “parsing,” and neither party proposes an express construction for the term. The word “parse” or “parsing” is used in two instances in the Specification of the ’792 patent.

The Specification (Ex. 1001) states:

Referring to FIG. 6A, once information is associated to at least one digital image, the image and *associated information is transferred from device 100, 200 and received by local computer 402 (step 502). The local computer 402 will parse the associated information* and store each piece of data as a separate field in a single record in a relational database (step 504).

Ex. 1001, 10:19–25 (emphasis added). The Specification also states:

Once transferred to the user's local computer or storage site, the identifier will be encoded by interacting with the relational database. *The local computer processing unit (CPU) will extract the necessary information by parsing the associated information from the database* and encode an identifier for each image (step 714) and, subsequently, store the identifier back in the database.

Ex. 1001, 16:49–55 (emphasis added). We note further the following dictionary definition of “parse”: “To break down into components.”

WEBSTER'S NEW WORLD & TRADE; COMPUTER DICTIONARY (2003), available at

<http://search.credoreference.com/content/entry/webstercom/parse/0>.

In the first disclosure quoted above, the parsing is performed on information previously gathered and transmitted to the local computer. In the second disclosure quoted above, the parsing is performed on information collected and organized in the database. On this record, the broadest reasonable interpretation of “parsing” requires the information that is parsed be previously gathered, collected, or organized in some tangible form, such that it can be broken down from that state. Or else, parsing the associated information to extract multiple pieces of information would require no actual operation of any kind and the mere existence of different associated information would satisfy “parsing.” That is unreasonably broad, as it would read “parsing” out of the claim. No additional construction is necessary. Only terms which are in controversy need to be construed, and

then only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

In summary, we reiterate that on this record, the broadest reasonable interpretation of “parsing” requires the information that is parsed be previously gathered, collected, or organized in some tangible form, such that it can be broken down from that state.

“*extract*”

The term “extract” appears in claim 1 to refer to the result or objective of “parsing the associated information.” Specifically, claim 1 recites “parsing the associated information to extract multiple pieces of information from the associated information” and “coding the multiple pieces of extracted information of the associated information to create an identifier for the digital image file.” No special definition is provided in the Specification for the term “extract.” Neither party proposes a construction for the term.

The term “extract” is a common term in the English language and requires no construction, given our construction of “parsing,” other than to say that where information has been “parsed” from a larger set of information, it has been “extracted” from the set.

C. Alleged Anticipation of Claims 1, 3, 4, 7–9, and 11 by Anderson

Petitioner contends that claims 1, 3, 4, 7–9, and 11 are anticipated by Anderson. To establish anticipation of a claim, each and every claim element, arranged as recited in the claim, must be found in a single prior art reference. *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376,

1383 (Fed. Cir. 2001). We focus on these limitations emphasized in claim 1 as reproduced above:

parsing the associated information to extract multiple pieces of information from the associated information;
coding the multiple pieces of extracted information of the associated information to create an identifier for the digital image file;

The argument presented by Petitioner, directed to the feature of “parsing the associated information to extract multiple pieces of information from the associated information” is reproduced below:

Anderson discloses these limitations. For example, *Anderson* discloses using parts of the associated information, such as the image name and data identifying the camera that captured the image (*see supra* Section X.B.1.c), to create an image identifier 84 for a captured image. Ex. 1003, 6:26–31. In particular, as explained above for claim element 1(c), *Anderson’s* associated information includes header data, image tags, audio tags, name of images, camera information, etc. *See supra* Section X.B.1.c. *Anderson* discloses analyzing this additional information in parts such that the name of the image and camera information is extracted and considered apart from the other information that is associated with a captured image to create an image identifier 84 for the image. Ex. 1003, 4:63–5:12, 6:20–35. The information associated with the image (e.g., header data, image tags, audio tags, name of images, camera information, etc.) is thus parsed to extract the multiple pieces of information including the image name and camera information because *Anderson* discloses using this information to create the image identifier 84, where other additional information is not used. *Id.*; Ex. 1001, ¶ 31.

Pet. 17. The argument is unpersuasive. It lacks explanation on how the associated information, in order to be “parsed,” was gathered, collected, or organized in some tangible form, such that it can be broken down.

Based on Petitioner’s analysis, as quoted above, so long as some information that qualifies as associated information are used to put together an identifier, it is enough to say that associated information had been parsed to extract therefrom the actual pieces used to form the identifier. Such an interpretation of “parsing” is unreasonably broad. As we explained earlier, the larger collection of associated information has to have been gathered, collected, or organized in some tangible form. Petitioner does not identify any tangible gathering or collection of associated information that can be parsed to yield the camera information and the image name.

We have reviewed the portions of Anderson (Ex. 1003) cited specifically by Petitioner, i.e., column 4, line 63, to column 5, line 12, and column 6, lines 20–35. Nothing in the cited disclosure indicates that the name of the image and camera information, used to create an identifier, are extracted from a larger set of associated information that had been gathered, collected, or organized in some tangible manner.

We also have considered the declaration testimony of Dr. Essa in connection with the “parsing” feature of the claims. The pertinent testimony stems primarily from Paragraph 31 of the Declaration and largely parallels Petitioner’s argument reproduced above. It suffers from essentially the same deficiencies already discussed above in the context of Petitioner’s argument.

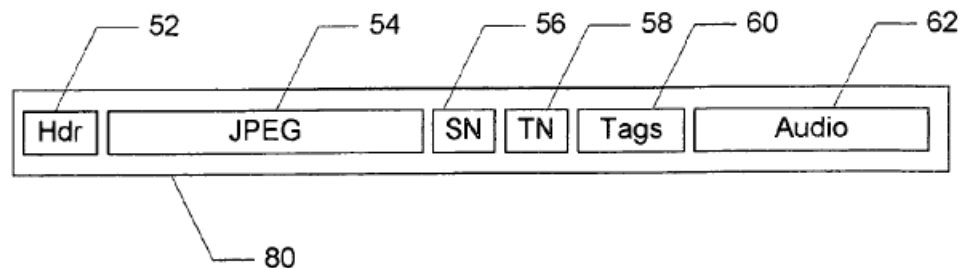
Dr. Essa states:

31. In my opinion, *Anderson* discloses the parsing of the associated information to extract multiple pieces of information. As I explained for claim element 1(c), *Anderson* discloses receiving a number of categories or types of information associated to stored image files, including at least header data, image tags, audio tags, name of images, camera information, etc. *Anderson* discloses that the image file's name and data identifying the camera that captured the image is used to create an image identifier 84 for the captured image. Ex. 1003, 6:26-31. *Anderson* discloses using some, but not all, of the associated information to create the image identifier, and thus analyzes the associated information in parts to consider and the image name and camera information apart from other available information. Thus, in my opinion, *Anderson* discloses that the information associated with the image (e.g., header data, image tags, audio tags, image name, camera information, etc.) is parsed to extract the multiple pieces of information (e.g., image name and camera information) used to create the image identifier 84, where the other associated information is not used. See also my discussion of *Anderson* above in Part VI.A.1.

Ex. 1010 ¶ 31. As argued by Petitioner and rejected above, according to Dr. Essa, so long as an identifier is assembled from some but not all associated information, then the feature of “parsing the associated information to extract multiple pieces of information from the associated information” is met. That is incorrect, as discussed above.

Patent Owner asserts that the Petition and Dr. Essa both regard *Anderson*'s image file as a collection of associated information, including the image name and camera identification information. Prelim. Resp. 9. Dr. Essa does make that representation. Specifically, Dr. Essa states:

30. In my opinion, *Anderson* discloses that the digital image files received by the imaging web server include several categories or types of associated information, including at least one of the specific types required by the claim limitation. For example, as illustrated below in Figure 3, *Anderson* discloses that image file 80 includes image data 54 that contains the captured image data and other information that is associated with the captured image, such as header 52 (identifying and describing content of image file 80), screenrail data 56, thumbnail data 58, image tags 60 (storing metadata associated with the image data), the name of the digital image, audio tag 62 (storing sound recorded for the image), and data identifying the camera that captured the image (e.g., serial number, make, model, etc. of the camera).



Id., Fig. 3. See also *id.*, 4:64-5:12, 6:28-35. Moreover, *Anderson* discloses that the name of the digital image may reflect a picture sequence number. See e.g., *Id.*, 6:25-35 (explaining that images are named using an “incrementing count of the total number of images captured so that each captured image is provided with a unique name”). Accordingly, *Anderson* discloses that the information associated with the image file includes at least the image name and picture sequence number. See also my discussion of *Anderson* above in Part VI.A.1.

Ex. 1010 ¶ 30. The Petition, on page 16, citing the above testimony of Dr. Essa, also makes the same representation about the content of the image

file, i.e., that the image file includes the name of the digital image and data identifying the camera that captured the image.

The above-quoted characterization of the image file, even if true, does not cure the deficiencies with regard to “parsing the associated information to extract multiple pieces of information from the associated information.” That is because neither the Petitioner in its Petition, nor Dr. Essa in his declaration testimony, asserts that the image file is broken down to extract the image name and camera identification information, with which to create the image identifier.

Moreover, the above-quoted characterization of the image file by Dr. Essa is ambiguous. Dr. Essa first indicates that the “image file includes” the plurality of items that are mentioned above, but ends with the very different language that “the information associated with the image file includes” The latter does not mean the image file itself includes the various items identified by Dr. Essa.

In any event, we are persuaded by Patent Owner that Petitioner has not shown that Anderson’s image file includes either the image name or camera identification information. None of the specific portions of Anderson cited by Dr. Essa indicates that an image file itself includes the image name or camera identification information. Anderson describes that “[i]mage file 80 preferably includes a header 52, image data 54, a scrennail 56, a thumbnail 58, image tags 60, and an audio tag 62.” Ex. 1003, 4:64–66. Image tags 60 are described as including various types of metadata that correspond and relate to particular captured image data 54. *Id.* at 5:9–11. Anderson describes the fully constructed image identifier itself, and not the

image name or camera identification information components, as metadata that may be stored in the image file. *Id.* at 6:31–35.

Anderson describes that the image identifier is created as a combination of the image name and camera identification information (Ex. 1003, 6:28–31), and that in a preferred embodiment the image identifier is stored in the image file as metadata (Ex. 1003, 6:31–34). That, however, does not mean the image name and camera identification information are stored in the image file, and then extracted by parsing the image file.

As noted above, claim 1 further recites “coding the multiple pieces of extracted information of the associated information to create an identifier for the digital image file.” Thus, even assuming that storing the image identifier in the image file equates to storing the image name and camera identification information themselves in the image file, that would not be helpful to Petitioner’s position. Because the image identifier already is created when placed into the image file, the image file cannot be parsed to obtain the image name and camera identification information with which to create the image identifier.

For the foregoing reasons, Petitioner has not shown a reasonable likelihood that it would prevail in establishing anticipation of any of claims 1, 3, 4, 7–9, and 11 by Anderson.

*D. Alleged Obviousness of Claims 1–4
and 7–11 over Anderson and Mortimore*

In the alternative, Petitioner asserts that claims 1–4 and 7–11 are unpatentable as obvious over Anderson and Mortimore. Petitioner states that if the Board is unpersuaded that Anderson teaches the “parsing” and “coding” limitations of claim 1, it would have been obvious to incorporate those features into Anderson in light of the disclosure of Mortimore.

Pet. 31. According to Petitioner, Mortimore discloses parsing the associated information to extract multiple pieces of that information, and then coding that extracted information to create an identifier for the digital image file.

Id. at 33. We have considered the reasoning on pages 26–36 of the Petition, and are no more persuaded by Petitioner’s assertions regarding Mortimore than those discussed above regarding Anderson.

As with Anderson, discussed above, Petitioner takes the view that because an identifier is formed including a plurality of fields that reflect various information associated with an image, previously gathered or collected information has been parsed to extract the fields therefrom with which to create the identifier for the image file. Pet. 32–34. Also as is the case with Anderson, discussed above, Petitioner does not point to anything in Mortimore that constitutes a tangible gathering or collection of associated information that is parsed to extract components with which to create the identifier for the image file.

Petitioner cites to Mortimore from column 4, line 63, through column 5, line 31, as supporting the assertion that Mortimore’s image identifier is coded from information extracted from associated information by parsing.

Pet. 34. We have reviewed the cited portion of Mortimore and do not find the assertion persuasive. The cited text discloses the structure and content of an image identifier, but does not reveal that associated information is parsed and that various fields within the image identifier are extracted from the associated information and coded to create the identifier. In pertinent part, the cited text is reproduced below:

The fields in the suffix in the above example illustrate a method for an organization to assure the uniqueness of its identifiers. The first digit (“3” in the example) in the suffix defines the device type, and the next three digits (“152”) contain the device serial number. Three more digits (“235”) identify the study number, followed by another digit (“2”) to identify the series number, and two more digits (“12”) to identify the image number within this particular study and series. Finally, the last nine digits (“187636473”) comprise an encoded date and time stamp of image acquisition. The respective identifier fields, when concatenated, uniquely identify original sets of image objects and each individual image within the set.

Ex. 1004, 4:63–5:8.

Accordingly, Petitioner’s reliance on Mortimore does not cure the above-noted deficiencies of Anderson. Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of any of claims 1–4 and 7–11 as obvious over Anderson and Mortimore. As explained above, on this record, the broadest reasonable interpretation of “parsing” requires that the information that is parsed be previously gathered, collected, or organized in some tangible form, such that it can be broken down from that state. The feature of “parsing the associated information to

extract multiple pieces of information from the associated information” is not sufficiently accounted for by either Anderson or Mortimore.

*E. Alleged Obviousness of Claims
5, 6, and 11 over Anderson and Alattar*

Each of claims 5, 6, and 11 depends from independent claim 1. Petitioner relies on Alattar to account for the respective features added by these dependent claims to the subject matter of claim 1. Petitioner’s reliance on Alattar does not cure the deficiencies discussed above with regard to the disclosure of Anderson and what is required by claim 1.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of any of claims 5, 6, and 11 as obvious over Anderson and Alattar.

*F. Alleged Obviousness of Claims
9 and 10 over Anderson and Miyawaki*

Each of claims 9 and 10 depends from independent claim 1. Petitioner relies on Miyawaki to account for the respective features added by these dependent claims to the subject matter of claim 1. Petitioner’s reliance on Miyawaki does not cure the deficiencies discussed above with regard to the disclosure of Anderson and what is required by claim 1.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of any of claims 9 and 10 as obvious over Anderson and Miyawaki.

*G. Alleged Obviousness of Claims 5, 6, and
11 over Anderson, Mortimore, and Alattar*

Each of claims 5, 6, and 11 depends from independent claim 1.

Petitioner relies on Alattar to account for the respective features added by these dependent claims to the subject matter of claim 1. Petitioner's reliance on Alattar does not cure the deficiencies discussed above with regard to the disclosure of Anderson and Mortimore for the features of claim 1.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of any of claims 5, 6, and 11 as obvious over Anderson, Mortimore, and Alattar.

III. CONCLUSION

Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of any of claims 1–11 of the '792 patent.

IV. ORDER

It is

ORDERED that the Petition is *denied* and no *inter partes* review is instituted as to any claim of the '792 patent.

IPR2015-00620
Patent 7,991,792 B2

For PETITIONER:

Naveen Modi
Joseph Palys
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com

For PATENT OWNER:

Kevin Guynn
Alanu Das
GREER, BURNS & CRAIN, LTD.
kguynn@gbclaw.net
adas@gbclaw.com