

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRAVELERS INDEMNITY COMPANY,
Petitioner,

v.

INTEGRATED CLAIMS SYSTEMS, LLC,
Patent Owner.

Case IPR2016-00659
Patent 6,338,093 B1

Before KALYAN K. DESHPANDE, HYUN J. JUNG, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Travelers Indemnity Company (“Petitioner”) filed a Petition (Paper 2, “Pet.”), requesting institution of an *inter partes* review of claims 28–32 of U.S. Patent No. 6,338,093 B1 (Ex. 1001, “the ’093 patent”). In support of its Petition, Petitioner submitted the Declaration of Paul C. Clark. Ex. 1005. Integrated Claims Systems, LLC (“Patent Owner”) did not file a preliminary response. We instituted an *inter partes* review of claims 28–32. Paper 6 (“Dec. on Inst.”).

After institution, Patent Owner filed a Response (Paper 10, “PO Resp.”) supported by the Declaration of Robert Gross (Ex. 2001)¹. Petitioner filed a Reply (Paper 14, “Reply”). A combined oral hearing in this proceeding and Case IPR2016-00660 was held on May 17, 2017, and a transcript of the hearing is included in the record. Paper 20 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 28–32 of the ’093 patent are unpatentable. See 35 U.S.C. § 316(e).

A. Related Matters

Patent Owner has asserted the ’093 patent against Petitioner in *Integrated Claims Sys., LLC v. Travelers Indemnity Co.*, Case No. 3:14-cv-

¹ After Petitioner filed an evidentiary objection to the original Exhibit 2001 (see Paper 11, 1–2), Patent Owner filed a Supplemental Exhibit 2001 that appears to be identical to the original version except that it includes an additional paragraph declaring the truthfulness of the statements therein. See Supp. Ex. 2001 ¶ 16. Petitioner did not object to the supplemental declaration, nor did it file a motion to exclude to preserve its objection to the original declaration. See 37 C.F.R. § 42.64(c). Given the overlapping content, in this Decision, we will simply refer to the original Exhibit 2001.

00892-RNC (D. Conn.). Pet. 58; Paper 5, 1. With respect to related proceedings at the Board, Petitioner indicates that the '093 patent is related to the patents at issue in Cases CBM2014-00186, CBM2014-00187, and IPR2016-00660. Pet. 58.

B. The '093 Patent

The '093 patent relates to “an attachment integrated claims (AIC) system for preparing and processing forms with integrated attachments.” Ex. 1001, 1:14–16. The Background of the '093 patent summarizes previous attempts to develop a faster and more cost effective claims processing system. *Id.* at 1:24–29. According to the '093 patent, the “original system involved hard copy paper claims only, with transmission and all processing done manually.” *Id.* at 1:30–32. The introduction of the mainframe computer was a significant advancement to that original system because it “allowed for electronic processing within a given insurance company, i.e., once the claim was on the computer inside the company, the paper form could be dispensed with.” *Id.* at 1:43–47. The next advancement, according to the '093 patent, was electronic filing of claim forms, which “was made possible by the introduction of the personal computer and modem into the provider’s office.” *Id.* at 1:66–2:1.

The '093 patent, however, describes that many claims require either additional text that does not fit into the prescribed format or non-text information. *Id.* at 2:54–57. Such claims are called “claims with attachments.” *Id.* at 2:57–58. An example of this type of claim is a PAC, which is a claim sent to an insurance carrier before a procedure is performed. *Id.* at 2:63–66. According to the '093 patent, many insurance companies require that PAC applications include additional medical

evidence, such as an x-ray. *Id.* at 3:2–7.

The '093 patent describes that “when attachments are required, providers are forced to submit hard copy claim applications, while insurance companies labor under an administrative system that is a hybrid between a manual and an electronic system.” *Id.* at 3:53–57. Because the insurance company’s goal is to review the claim, including both the text and the attachment, in a cost effective manner, the '093 patent states that the “natural next stage in the development of claims processing systems is to attempt to computerize[] this process.” *Id.* at 3:8–12.

Figure 3 is reproduced below:

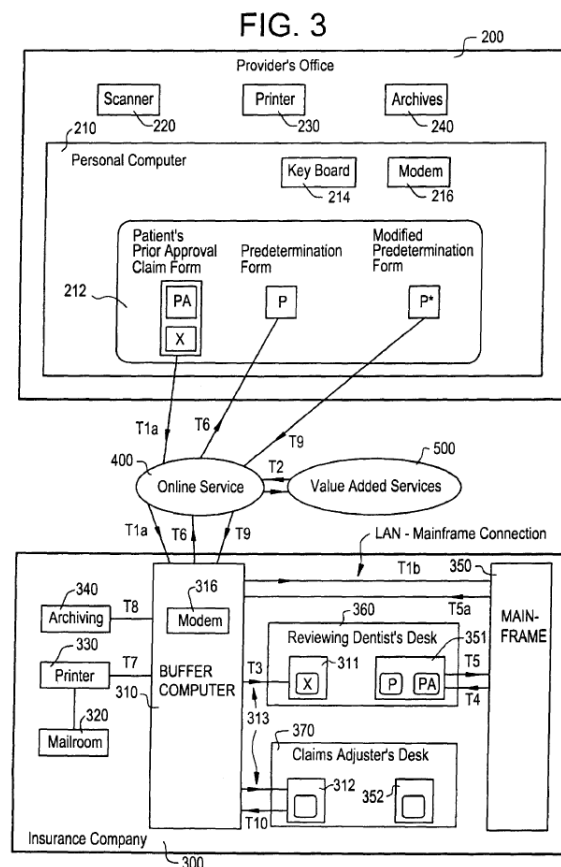


Figure 3 is a combination block and flow diagram. *Id.* at 12:38–41.

Components 200 located in the health care provider’s office “include a

personal computer 210 . . . and a modem 216, connected to a scanner 220.” *Id.* at 13:21–25, 49–51. “Components 300 located at the insurance company include the previously described mainframe or legacy computer 350 and associated terminals 351, 352.” *Id.* at 13:65–67.

The AIC software is stored in computer system 210. *Id.* at 14:64–67. “Contained within the AIC software are PAC forms for insurance companies using the AIC system,” and the PAC form “contains boxes . . . in which alpha-numeric characters can be entered so that, when the characters are entered in these boxes they are entered so as to fill a ‘field,’ a delimited alpha-numeric character string.” *Id.* at 15:21–31. “[T]he information denoted by the characters can be transferred to and used in completing other fields in related documents.” *Id.* at 15:32–33. A patient’s x-ray is digitized, such as by scanner 220 connected to the service provider’s computer system running the AIC software. *Id.* at 16:25–28. “[T]he PAC application is formed from the electronic PAC form and the digitized patient’s x-ray.” *Id.* at 16:51–52. The ’093 patent describes that “the format of the PAC application advantageously may consist of a text file and an associated digitized image file,” and “the text file (i.e., the PAC form) and the image file (i.e., the digitized x-ray) must cross reference one another (i.e., be correlated) so that these files can be continuously associated with one another after transmission to the insurance company.” *Id.* at 16:54–62. The PAC application is then sent to the insurance company. *Id.* at 17:42–44.

After the PAC application is received by the insurance company, a reviewing dentist calls up the PAC application from buffer computer 310 to personal computer 311. *Id.* at 20:21–29. The AIC software automatically inserts the company’s Predetermination form into the file, and can

automatically transfer useful information from the PAC application to the Predetermination form. *Id.* at 20:35–42. The reviewing dentist reviews the information in the PAC application and enters in the Predetermination form the information required to approve or disapprove the procedure. *Id.* at 21:8–12. The Predetermination form and the PAC application are downloaded to buffer computer 310, and the Predetermination form then is transmitted to the service provider. *Id.* at 21:39–50.

Claim 28, the only independent claim challenged by Petitioner, is reproduced below:

28. A method for operating a computer network including first and second computer systems connected via the Internet, each of the first and second computers including a memory, an input device, and a display, respectively, the method comprising:

(a) retrieving a first form from storage in the first computer system's memory and displaying the first form on the first computer system's display;

(b) writing first field data to the first form using the first computer system's input device;

(c) combining a digital attachment and the first form so as to generate an attachment integrated file;

(d) transmitting the attachment integrated file to the second computer system over the Internet;

(e) generating a second form upon receipt of the attachment integrated file, the first and second forms containing at least a portion of the first field data;

(f) displaying the second form and an image corresponding to the digital attachment on a graphical user interface (GUI) instantiated on the second computer system's display; and

(g) writing second field data to the second form using the second computer system's input device.

Id. at 32:41–64.

C. Instituted Grounds of Unpatentability

We instituted trial as to claims 28–32 on the following grounds:

Reference(s)	Basis	Claims
Borghesi ²	§ 103	28–32
Beizer ³ and Perlman ⁴	§ 103	28–32
Borghesi and Beizer	§ 103	28–32

See Dec. on Inst. 19.

II. CLAIM CONSTRUCTION

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); see *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard in *inter partes* review). Under that standard, claim terms 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. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). The Board’s construction under the broadest reasonable interpretation standard “cannot be divorced from the specification and the record evidence.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (quoting *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011)). Only those terms in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

² U.S. Patent No. 5,950,169, Sept. 7, 1999, Ex. 1002.

³ U.S. Patent No. 5,054,096, Oct. 1, 1991, Ex. 1003.

⁴ U.S. Patent No. 5,309,437, May 3, 1994, Ex. 1006.

A. “*field*”

Patent Owner proposes a construction for the term “field.” PO Resp. 11–14. This term appears in claim 28 as part of the phrases “first field data” and “second field data” in steps (b), (e), and (g).⁵

Patent Owner argues that we should construe “field” to mean “data comprised of ‘label data’ and ‘content’ data.” PO Resp. 13 (citing Ex. 2004⁶ ¶¶ 12–13). Initially, Patent Owner states that the term should be construed as “a delimited alpha-numeric character string.” *Id.* at 11. At the oral hearing, however, Patent Owner clarified that this initial statement was only part of its argument that a field must be delimited, and is not a proposed construction. *See* Tr. 20:18–21:10. Patent Owner quotes the Microsoft Computer Dictionary as defining “delimit” to mean “[t]o set the limits of some entity, generally by using a special symbol called a delimiter.” PO Resp. 11. Based on this definition and the testimony of Mr. Gross, Patent Owner argues that “there must be at least one delimiter” and that a field is comprised of delimiter data and content data. *Id.* at 11–12. Patent Owner also cites several portions of the specification that purportedly support Patent Owner’s proposal. *See id.* at 12–14.

In response, Petitioner argues that Patent Owner’s proposed construction is unsupported by either the cited intrinsic or extrinsic evidence.

⁵ In its claim construction argument, Patent Owner proposes a construction for the terms “field” and “identifiable field” as recited in claims 1, 2, 7, 14, and 19. PO Resp. 11. However, those claims are not challenged in this proceeding. Patent Owner appears to have conflated the claims of the ’093 patent at issue in this proceeding with the claims of the related ’129 patent being challenged in Case IPR2016-00660. *See* Tr. 37:9–13.

⁶ Patent Owner’s citations to Exhibit 2004 in this section of the Patent Owner Response appear to be intended to cite to the Declaration of Mr. Gross, which is Exhibit 2001.

See Reply 3–6. Regarding the intrinsic evidence, Petitioner asserts that the portions of the '093 patent Patent Owner cites do not support Patent Owner's proposal. *Id.* at 3–4. Regarding the extrinsic evidence, Petitioner notes that Patent Owner did not file the Microsoft Computer Dictionary as an exhibit and, therefore, Petitioner argues that any arguments concerning that dictionary should be ignored. *Id.* at 5. Petitioner further argues that the testimony of Mr. Gross is conclusory and that Patent Owner has not established that he qualifies as an expert. *Id.* at 5–6. Petitioner also argues that Patent Owner's proposal in this proceeding is inconsistent with the claim construction it advanced for this term in related patents in other Board proceedings. *Id.* at 6–7. Petitioner urges the Board to determine that “field” does not require construction. *Id.* at 8.

We agree with Petitioner that Patent Owner's proposed construction lacks support in the intrinsic record. The portions of the '093 patent cited by Patent Owner in support of its proposal simply do not relate to Patent Owner's arguments. See Prelim. Resp. 12–14. In those citations, Patent Owner relies almost entirely on columns 32–34, which is where the claims appear, not the detailed description. See *id.*; Ex. 1001. From our own review of the '093 patent, we note the following description that is relevant to the meaning of “field”:

It will be appreciated that the PAC form when displayed on the computer's screen 212 contains boxes, such as those depicted in FIGS. 5A and 5B, in which alpha-numeric characters can be entered so that, when the characters are entered in these boxes they are entered so as to fill a **“field,” a delimited alpha-numeric character string.**

Ex. 1001, 15:6–31 (emphasis added). Looking at the emphasized language in isolation suggests an attempt to define the term “field.” Considering the

surrounding context, however, we understand that clause as an explanation of the characteristics of the “field” in the exemplary embodiment of Figures 5A and 5B, not as a definition of what a “field” must be. Indeed, although Patent Owner relies on this passage to argue that a field must be delimited (Tr. 21:17–19, 22:4–11), neither party contends that in this excerpt, the patentee was acting as a lexicographer to define what a “field” is. *Id.* at 21:11–19, 8:3–13.

As Petitioner points out (*id.* at 8:8–25), the usage of the term “field” in U.S. Patent No. 7,694,129 (“the ’129 patent) supports the view that “field” is not limited to a delimited alpha-numeric character string because claim 1 of that patent specifies that “at least one of the fields of the GUI contains an image.” Ex. 1018, 44:43–44. Plainly, a “field” that contains an image is not an alpha-numeric character string. Moreover, Patent Owner does not explain persuasively, and it is unclear to us, how a “field” that contains an image could be delimited. The usage of “fields” in the ’129 patent is relevant here because the ’129 patent states that it is a continuation of the ’093 patent and both patents claim priority to the same chain of applications leading back to March 28, 1996. *See* Ex. 1001, at [63], [60]; Ex. 1018, at [63], [60]. “[W]here multiple patents ‘derive from the same parent application and share many common terms, we must interpret the claims consistently across all asserted patents.’” *Trs. of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005)).

Turning to Patent Owner’s extrinsic evidence, we agree with Petitioner that Patent Owner did not provide an evidentiary record to support its reliance on the Microsoft Computer Dictionary because it did not file the

dictionary excerpt as an exhibit. *See* 37 C.F.R. § 42.63(a) (“All evidence must be filed in the form of an exhibit.”). In any event, a dictionary definition of “delimit” is not a solid foundation for a construction of “field” because, as just explained, Petitioner does not convince us that a field must be delimited. Similarly, the testimony of Mr. Gross on which Patent Owner relies is also unpersuasive because its starting point is the premise that a field must be delimited. *See* Ex. 2001 ¶ 12. Neither Patent Owner nor Mr. Gross provides any persuasive evidence or explanation why delimiting inheres in the meaning of “field” as used in the ’093 patent.

Accordingly, we determine that the evidence does not support Patent Owner’s proposal that “field” should be construed to mean “data comprised of ‘label data’ and ‘content’ data.” In this proceeding, the disputed claim construction issue is whether “field” requires the features set forth in Patent Owner’s proposed construction. Thus, having resolved that dispute, we agree with Petitioner that it is unnecessary to set forth an express construction of the term “field.” *See Vivid Techs*, 200 F.3d at 803.

III. OBVIOUSNESS ANALYSIS

A. Legal Standards

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under § 103 that requires consideration of four factors: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of non-obviousness such as “commercial success, long-felt but unsolved needs, failure of others, etc.” *Id.* at 17–18. “While the sequence of these questions might be reordered in any particular

case,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the Federal Circuit has “repeatedly emphasized that an obviousness inquiry requires examination of all four *Graham* factors and that an obviousness determination can be made only after consideration of each factor.” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016).

In this case, the parties did not present any argument or evidence directed to secondary considerations of nonobviousness. We now turn to a discussion of the other three *Graham* factors.

B. Level of Ordinary Skill in the Art

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, and the sophistication of the technology. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986). With support from the testimony of its declarant, Dr. Clark, Petitioner argues that a person of ordinary skill in the art at the time of the invention “would have a bachelor’s degree in Computer Science or Computer Engineering, or two years of work experience in the field of network data processing.” Pet 2 n.1 (citing Ex. 1005 ¶ 22). No competing proposed definition of ordinary skill in the art or rebuttal to Petitioner’s proposal is offered by Patent Owner or its declarant, Mr. Gross. See PO Resp.; Ex. 2001. After considering the disclosures of the ’093 patent and the cited prior art references, we adopt Petitioner’s proposal.

C. Summary of Cited Prior Art

1. Borghesi

Borghesi describes “[a] system and method for managing and processing insurance claims.” Ex. 1002, at [57]. A drawback of prior

claims processing methods, according to Borghesi, was that different tasks in the process were accomplished using different systems, and “each of these separate computer programs requires certain types of data and each outputs a certain type of data. The data required for the separate programs may overlap and lead to redundant data entry tasks being performed.” *Id.* at 2:1–5. To address this shortcoming, Borghesi sought to provide a system having “a centralized electronic datafile containing all data relevant to a claim that would eliminate the need for separate paper files or datafiles and eliminate the need for wasteful reentry of existing data.” *Id.* at 2:25–29.

Borghesi describes systems in which

a remote computer and a computer in the home office of an insurance company . . . are in communication over a wide area network. An insurance claim datafile containing all data pertinent to an insurance claim is generated at the remote computer. A user transfers the datafile between the home office computer and at least one remote computer while the claim is being processed. A user modifies and builds sections of the insurance claim datafile at the remote computer based on information accessed from an external source such as a memory device or another computer.

Id. at 2:39–49. Borghesi describes many embodiments in the context of automobile insurance, but Borghesi also discloses that the same workflow can be utilized in “[o]ther types of insurance such as property or health insurance.” *Id.* at 4:66–67.

Figure 22 of Borghesi is reproduced below:

FIG. 22

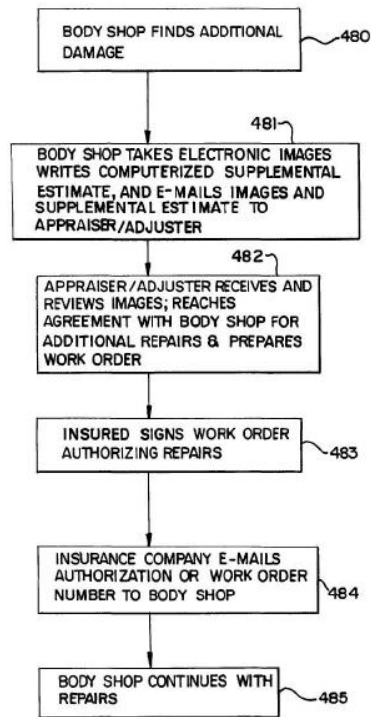


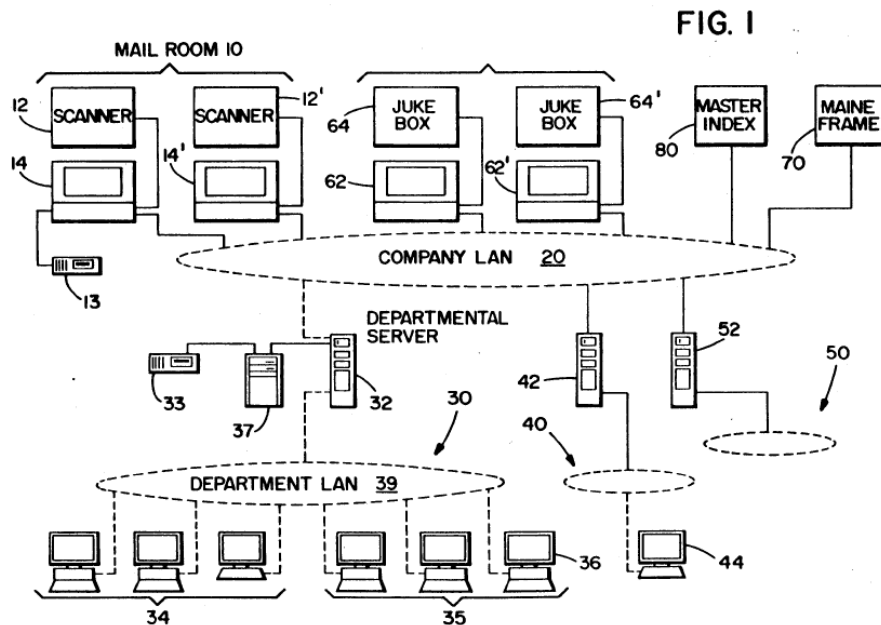
Figure 22 is a flow chart illustrating a procedure when an estimate requires supplements. *Id.* at 4:2–3. In that scenario, a body shop finds additional damage, takes electronic images, and prepares a computerized supplemental estimate. *Id.* at 19:7–9. The body shop then

emails 481 the images and supplemental estimate to an appraiser/adjuster, and the appraiser/adjuster receives and reviews 482 the images. The appraiser/adjuster reaches an agreement with the body shop on the additional repairs, and the appraiser/adjuster prepares 482 a work order. The insured signs 483 the work order authorizing repairs, and the insurance company e-mails 484 an authorization number or work order number to the body shop. Upon receipt of repair authorization, the body shop continues 485 with the repairs and the search for parts for the car.

Id. at 19:11–20.

2. *Beizer*

Beizer is titled “Method and Apparatus for Converting Documents into Electronic Data for Transaction Processing.” Ex. 1003, at [54]. *Beizer* seeks to improve on the methods of processing documents in paper-intensive businesses, such as insurance claim processing companies. *Id.* at 1:11–14, 30–32. In *Beizer*’s method, documents are scanned upon receipt, and all subsequent operations are carried out on the basis of the image of the scanned document. *Id.* at 3:24–29. Figure 1, reproduced below, shows the general layout for the system:



As depicted in Figure 1, documents are received in mailroom 10, where they are fed into scanners 12 to convert images of the documents into digital signals. *Id.* at 5:19–23. Computers 14 in the mailroom allow information from the scanners to be directed to particular departments, depending on the information in the documents. *Id.* at 6:26–29. As depicted in Figure 1, using local area network (LAN) 20, input from scanners 12 can be distributed to departments 30, 40, and 50. Data directed to department 30

via LAN 20 is received by LAN server 32 and transmitted to workstations within department 30 via department LAN 39. *Id.* at 6:58–61, 7:14–16.

Workstations may have different tasks in processing the data. For example, workstations 34 may be data input stations, where operators view the image of the document and enter data into a predetermined form. *Id.* at 7:27–34. The record, including the image and input data, is then sent to server 32, which then sends the record to workstation 35, where the claim is analyzed and payment is determined. *Id.* at 7:38–46. Operators can pass the record to supervisor workstation 36 if a question arises in the analysis. *Id.* at 7:46–49. Upon completion of the transaction at workstation 35 or 36, the record is transmitted to server 32 and then to archive 60. *Id.* at 8:27–32.

Because Beizer’s system “allows for distributed processing, the actual processing can take place at almost any location.” *Id.* at 11:49–50. Thus, Beizer teaches that the information can be sent via telephone modems to remote locations, such as a workstation at an employee’s home, for processing. *Id.* at 4:33–36, 11:50–54.

3. *Perlman*

As relevant to Petitioner’s challenges, Perlman describes that protocols “widely used in the industry . . . provide a set of services that permit users to communicate with each other across the entire Internet.” Ex. 1006, 3:35–37. These services include “file transfer, remote log-in, remote execution, remote printing, computer mail, and access to network file systems.” *Id.* at 3:39–41.

D. Obviousness Challenge Based on Borghesi

1. *Claim 28*

We conclude that Petitioner has presented persuasive evidence that the subject matter of claim 28 would have been obvious based on Borghesi. *See* Pet. 3–31. We agree with and adopt Petitioner’s analysis as our findings and conclusions, as summarized below.

In Borghesi’s Figure 22 embodiment, Petitioner’s analysis correlates the computer at the body shop to the claimed “first computer system” and the computer used by the appraiser/adjuster to the claimed “second computer system.” *Id.* at 5–6. Borghesi teaches that these computers can be connected through a “general wide area network provider such as America On Line (AOL),” which an ordinarily skilled artisan would recognize as an internet service provider. *Id.* at 4–5; Ex. 1002, 5:52–6:1; Ex. 1005 ¶ 29.

With respect to step (a), Petitioner relies on Borghesi’s computerized supplemental estimate as the claimed “first form.” Pet. 5–6. Borghesi describes storing a form for an electronic datafile in the computer’s hard drive and displaying that form so that users can enter and retrieve information from the datafile. *Id.* at 10–14 (citing Ex. 1002, Fig. 6, 5:26–36, 6:15–19, 7:24–28, 54–63, 9:29–32).

Borghesi also discloses “writing first field data to the first form using the first computer’s input device,” as recited in step (b), because Borghesi describes a variety of information, such as name, address, and telephone information, that is entered into fields using a keyboard or mouse. *Id.* at 14–16 (citing Ex. 1002, Fig. 6, 7:24–28, 9:29–32, 19:6–21).

Regarding steps (c) and (d), Borghesi teaches that a digitized image can be appended to the workfile, and that the body shop emails the images

and supplemental estimate to the appraiser/adjuster. *See id.* at 6 (citing Ex. 1002, 6:60–67, 19:6–21). Borghesi’s electronic images appended to the estimate correspond to the claimed “digital attachment,” and the workfile sent to the appraiser/adjuster via email correspond to the claimed “attachment integrated file.” *Id.* at 6, 16–19.

The work order prepared by the appraiser/adjuster in Borghesi corresponds to the “second form” recited in step (e). *See* Pet. 6, 19–21 (citing Ex. 1002, 19:6–21). Petitioner contends, and we agree, that it would have been obvious for this work order to contain at least a portion of the “first field data” because the appraiser/adjuster would generate other forms in the workfile using information from the body shop, and automatically generating the work order when the workfile is received from the body shop would increase efficiency. *Id.* at 6 (citing Ex. 1002, 11:65–12:13; Ex. 1005 ¶ 31). Although Borghesi provides little detail regarding the content of the work order that the appraiser/adjuster creates, we agree with Petitioner that it would have been obvious for the work order to incorporate, from the workfile, information previously entered because one of Borghesi’s primary objectives is to increase efficiency by eliminating redundant data entry. *See* Ex. 1002, 2:25–29.⁷

With respect to step (f), Borghesi discloses displaying “text, graphics, or a combination thereof” on the display monitor. Pet. 7 (quoting Ex. 1002, 6:15–19). Petitioner presents evidence that it was known at the time of the invention to display windows side-by-side on the same screen. *Id.* (citing Ex. 1004, Fig. 2, 2:35–37). Against this backdrop, we agree with

⁷ Patent Owner had notice of this reasoning and portion of Borghesi based on the discussion in our Decision on Institution. *See* Dec. on Inst. 10.

Petitioner's contention, which is supported by the testimony of Dr. Clark, that it would have been obvious "to display both the digital attachment, such as the electronic images sent by the body shop, along with the forms generated by the appraiser/adjuster, at least because the appraiser/adjuster would be able to more efficiently review relevant materials in preparing its work order." *Id.* at 7–8 (citing Ex. 1005 ¶ 32).

Regarding step (g), Borghesi describes that each computer allows users to view datafiles and other claims processing information through a monitor and to enter data using a keyboard, mouse, or pen attached to the computer. *See id.* at 24 (citing Ex. 1002, 7:24–28). Borghesi also describes the graphic user interface that permits users to enter and retrieve information from a datafile. *Id.* (citing Ex. 1002, 7:40–63). In the Figure 22 embodiment of Borghesi, after reviewing the images and supplemental estimate and reaching agreement with the body shop on additional repairs, "[t]he appraiser/adjuster prepares 482 a work order." Ex. 1002, 19:13–16. Thus, the claimed "second field data" is information the appraiser/adjuster enters using an input device in order to prepare the work order. *See* Pet. 25 (citing Ex. 1002, 19:6–21).

The evidence supports Petitioner's assertions and contentions as outlined above. We have considered Patent Owner's rebuttal arguments, but they are not persuasive for the reasons that follow. Patent Owner argues that the computer used by the appraiser/adjuster in Borghesi cannot be the claimed "second computer system" because dependent claims 29–32 require that the second computer system comprise a buffer computer system and a mainframe computer. PO Resp. 16. This argument is not persuasive as to claim 28, because that claim does not require that the second computer

system includes a buffer and a mainframe.

Patent Owner further argues that Borghesi has no interest in the compatibility problems of legacy mainframes with which the '093 patent is concerned because the assignee of Borghesi was a software provider and was, therefore, “interested in selling software to every participant in the insurance claim process, not providing a fix that would let the insurance company avoid its product.” PO Resp. 16. This argument is unpersuasive because it assumes that obviousness turns on the commercial interests of the inventor (or assignee) of the prior art reference. Yet “[t]he issue of obviousness is determined entirely with reference to a *hypothetical* ‘person having ordinary skill in the art.’” *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985). In other words, the relevant question is what an ordinarily skilled artisan would have understood from Borghesi’s disclosure, not whether Borghesi himself was or was not interested in particular applications or modifications of what is described in his patent.

Moreover, a conclusion of obviousness based on Borghesi’s disclosure is not dependent on whether a skilled artisan was interested in, or even recognized, the specific problem with which the '093 patent was concerned (i.e., the compatibility issues of legacy mainframes). A motivation to combine or modify references in an obviousness analysis “need not be the same motivation articulated in the patent for making the claimed combination.” *Outdry Techs. Corp. v. Geox S.p.A.*, 859 F.3d 1364, 1371 (Fed. Cir. 2017). Here, for each of the limitations of claim 28 not expressly taught by Borghesi, Petitioner articulates a reason based on rational underpinnings why it would have been obvious to incorporate that

feature based on Borghesi's teachings and the background knowledge of an ordinarily skilled artisan. *See id.* at 1370–71 (“Any motivation to combine references, whether articulated in the references themselves or supported by evidence of the knowledge of a skilled artisan, is sufficient to combine those references to arrive at the claimed process.”).

Patent Owner also contests Petitioner's showing on step (b), arguing that “Borghesi's ‘frames’ or ‘text fields’ are just GUI boxes, not the software ‘fields’ disclosed in the '093 patent.” PO Resp. 17. This argument is based on Patent Owner's proposed claim construction of “field,” which we do not adopt for the reasons discussed in Section II.A. Applying the plain meaning of the term “field,” we find that Borghesi's description of a graphical user interface through which information such as name, address, and phone information can be entered into text fields discloses “writing first field data” as recited in step (b). *See* Ex. 1002, Fig. 6, 9:29–32. Indeed, Borghesi literally uses the word “field” in describing data entry through that GUI. *See id.* (describing that the frame shown in Figure 6 includes “a number of text **fields** 110 for entering or viewing name, address and telephone information” (emphasis added)).

Next, Patent Owner seeks to rebut Petitioner's arguments on steps (c) and (d) by arguing that “*Borghesi's* workfile is just the digital equivalent of a manila file folder. Parts of the workfile cannot be automatically redirected or be used to automatically prepare portions of other files. And none of *Borghesi's* workfile gets anywhere near a mainframe computer.” PO Resp. 17. These arguments are not commensurate with the scope of claim 28, insofar as Patent Owner does not identify any limitations in that claim that require automatic redirection or a mainframe computer. Patent Owner's

assertion that Borghesi's workfile cannot be used to prepare portions of other files is unsupported and does not address the contrary evidence that Petitioner cited. *See* Pet. 20–21 (citing Ex. 1002, 11:35–42, 10:29–40); Reply 15.

Finally, Patent Owner argues that Petitioner's arguments concerning step (e) "make[] no sense" because the '093 patent "teaches a first form that is compatible with the legacy mainframe and a second form which is not. This has nothing to do with the various forms in *Borghesi's* workfile, none of which are compatible with a mainframe computer." PO Resp. 18. This argument is unpersuasive because it is not tethered to the language of claim 28. Specifically, Patent Owner does not point to, and we do not find, any limitation in claim 28 requiring that the first form is compatible with a legacy mainframe or that the second form is incompatible. Indeed, as we have already noted, claim 28 does not even recite a mainframe.

For the foregoing reasons, we determine that Petitioner has shown by a preponderance of the evidence that claim 28 would have been obvious based on Borghesi.

2. *Claims 29–32*

Claim 29 depends from claim 28 and adds the further limitations that the second computer "comprises a buffer computer system and a mainframe computer and further comprising the step of (h) transmitting selected portions of the first field data and the second field data between the mainframe computer and the buffer computer system." Petitioner explains how Borghesi discloses this subject matter. *See* Pet. 26–28. We agree with and adopt Petitioner's analysis as our findings and conclusions, as summarized below.

Borghesi teaches networking a single remote computer with a mainframe computer so that information can be transferred and processed between the computers. *Id.* at 25–26 (citing Ex. 1002, 20:34–41). Borghesi also discloses that some or all data in a file may be transferred between the mainframe and the computers with which it is networked. *Id.* at 27–28 (citing Ex. 1002, 5:32–36); Ex. 1005 ¶ 33. Although Petitioner does not direct us to any use of the phrase “buffer computer” in Borghesi, Petitioner asserts that in Borghesi, “the mainframe (‘or server’) is connected to a ‘primary workstation,’ which serves as the buffer computer.” Pet. 26 (citing Ex. 1002, 7:3–10). Borghesi’s description of the Figure 22 embodiment provides little information about the computer used by the appraiser/adjuster (*see* Ex. 1002, 19:6–21), but elsewhere Borghesi indicates that “the computer at each location may be a single user system such as shown in FIG. 4 or a multi user system as seen in FIG. 5.” Pet. 26 (quoting Ex. 1002, 6:32–35). We credit Dr. Clark’s testimony, with regard to Borghesi’s Figure 22 embodiment, that “[t]he second computer [i.e., the appraiser/adjuster computer], being a personal computer, also transfers the workfile to a mainframe or file server, where it is stored in a hard drive. Ex. 1002 at 5:26–36; 7:3–10; 20:34–41. This personal computer acts as the claimed buffer computer.” Ex. 1005 ¶ 33.

Petitioner also explains how Borghesi discloses the limitations of dependent claims 30–32, which overlap substantially with the features recited in dependent claim 29. *See* Pet. 28–31. Having reviewed the underlying evidence cited in support of Petitioner’s arguments, we agree with and adopt, as our findings and conclusions, Petitioner’s analysis of why the subject matter of claims 29–32 would have been obvious based on

Borghesi. Specifically, with respect to claims 30 and 32, Petitioner shows that Borghesi discloses transmitting data over an intranet, such as a local area network. *Id.* at 28, 31 (citing Ex. 1002, 7:3–10; 20:34–41). Regarding claim 31, Petitioner shows that Borghesi discloses transmitting first and second field data between the mainframe and the buffer computer insofar as some or all of the data in a file can be transmitted between computers. *Id.* at 29–30 (citing Ex. 1002, 5:32–36, 8:40–43, 20:45–50).

As discussed above, many of Patent Owner’s arguments concerning claim 28 related to the usage of a mainframe. Neither a mainframe nor a buffer computer is required by claim 28, but they are recited by dependent claims 29–32. However, the evidence summarized above supports Petitioner’s assertion that Borghesi discloses a mainframe (*see, e.g.*, Ex. 1002, 20:34–41) and that the appraiser/adjuster computer in Borghesi acts as a buffer computer when networked with a mainframe or server (*see, e.g.*, Ex. 1002, 7:3–10; Ex. 1005 ¶ 33). Patent Owner’s arguments concerning mainframes and buffer computers do not address that evidence. *See* PO Resp. 16–18. Aside from its comments regarding mainframes (which are nominally directed to claim 28), Patent Owner does not present any separate argument for dependent claims 29–32. *See id.* at 18 (“Petitioner has failed to show that claim 28 would have been obvious in view of *Borghesi*. . . . The same is equally true as to dependent claims 29–32.”).

For the foregoing reasons, we determine that Petitioner has shown by a preponderance of the evidence that claims 29–32 would have been obvious based on Borghesi.

E. Obviousness Challenge Based on Beizer and Perlman

1. *Claim 28*

We conclude that Petitioner has presented persuasive evidence that the subject matter of claim 28 would have been obvious based on Beizer and Perlman. *See* Pet. 31–54. We agree with and adopt Petitioner’s analysis as our findings and conclusions, as summarized below.

Petitioner relies on Perlman to support the obviousness of transmitting information over the internet. *See id.* at 37, 40–41, 46. For all other limitations, Petitioner relies on Beizer. *See id.* at 31–36, 38–48. In Petitioner’s analysis, Beizer’s computer in a remote location, such as a workstation in an employee’s home, corresponds to the “first computer system.” *Id.* at 33 (citing Ex. 1003, 4:33–36, 10:31–39, 11:48–62). Beizer’s additional computer systems, such as the computers of workstations 34, 35, 36, correspond to the claimed “second computer system.” *Id.* at 33, 40 (citing Ex. 1003, 7:19–37). With respect to the recitation in the preamble that the “first and second computer systems [are] connected via the Internet,” Petitioner points out that Beizer discloses that the remote workstations can be connected via telephone modems. *Id.* at 33 (citing Ex. 1003, 11:48–62). Perlman’s teaches networking computers using the Internet, which Petitioner argues is exemplary of how information was known to be transmitted via modems between remote computers. *Id.* at 37 (citing Ex. 1006, 3:29–41). Dr. Clark’s testimony supports Petitioner’s contention that a skilled artisan would have had reason to incorporate into Beizer the teaching from Perlman to use the Internet to transmit information because at the time of the invention, “the Internet was a well-known and popular communications alternative to prior more expensive wide area

network connections.” *Id.* at 37 (citing Ex. 1005 ¶ 45). This testimony supplies a reason based on rational underpinnings for the proposed combination of Beizer and Perlman.

Beizer teaches step (a) because it discloses that a form can be built at a workstation through a form building program that displays a form in one window while the document image is displayed in another window. *Id.* at 33–34, 41–42 (citing Ex. 1003, Fig. 6, 4:6–10, 8:3–5). With respect to step (b), the data entered by an operator into Beizer’s predetermined form corresponds to the claimed “first field data.” *Id.* at 34, 42–43 (citing Ex. 1003, 7:31–34, 9:51–57). Regarding step (c), Beizer’s electronic image corresponds to the claimed “digital attachment” and Beizer’s record, which includes the input data and the electronic image, corresponds to the claimed “attachment integrated file.” *Id.* at 34, 42–43 (citing Ex. 1003, 7:39–43). Regarding step (d), Beizer discloses transferring the record from a remote workstation to a workstation in the company LAN, such as when a claim is questionable and is sent to a supervisor workstation for review. *See id.* at 34 (citing Ex. 1003, 7:39–49, 10:31–39). Transmitting the record “over the Internet” as recited in step (d) would have been obvious in view of Perlman’s teachings for the reasons discussed above.

Concerning step (e), Petitioner argues that “[u]sing the aforementioned form-building process, which may be performed by any workstation, a second form may be generated at the second workstation, including upon receipt of the record.” *Id.* at 35 (citing Ex. 1003, 3:45–53, 8:3–5). Petitioner cites the testimony of Dr. Clark that it would have been obvious that generating the second form upon receiving the record would increase the overall efficiency of claim processing. *Id.* (citing Ex. 1005

¶ 41). Beizer discloses that “[e]ach workstation may perform the same function or the transaction may be divided into a series of steps with certain workstations performing one or more of the steps before the image and information are passed on to another workstation for further processing.” Ex. 1003, 3:49–53. Where claims processing tasks, such as data input, are divided between two workstations (the first being remote from the second), we agree with Petitioner that it would have been obvious for the second workstation to generate a second form containing the data already input in the first workstation when it receives the record.

Finally, Beizer teaches steps (f) and (g) because it discloses that the image and the form can be viewed side-by-side, that the operator can enter information into the form using a keyboard, and that tasks such as data input can be divided among different workstations. *See* Pet. 35–36, 47–48; Ex. 1003, Fig. 6, 7:27–34, 9:49–57, 10:5–8.

The evidence supports Petitioner’s assertions and contentions as outlined above. We have considered Patent Owner’s rebuttal arguments, but they are not persuasive for the reasons that follow. Patent Owner argues that “Beizer is a giant step backwards from the inventions of the ’093 patent” because its forms “are rudimentary image portions, not the computer software fields of the ’093 patent.” PO Resp. 19. This argument appears to be based on Patent Owner’s proposed construction of “fields,” which we do not adopt for the reasons discussed in Section II.A. Applying the plain meaning of “fields,” we find that the operator’s entry of data into the predetermined form in Beizer discloses “writing first field data” as set forth in step (b). *See* Ex. 1003, 7:31–34, 9:51–57, Fig. 6.

Patent Owner also argues that “*Beizer* had no reason to be interested in solving industry-wide legacy mainframe problems—he worked for Blue Cross/Blue Shield.” PO Resp. 19. For the same reasons as explained in Section III.D.1., by focusing on what *Beizer* or his employer was interested in, Patent Owner’s fails to address what would or would not have been obvious to a hypothetical person of ordinary skill in the art in view of the teachings of *Beizer* and *Perlman*.

For the foregoing reasons, we determine that Petitioner has shown by a preponderance of the evidence that claim 28 would have been obvious based on *Beizer* and *Perlman*.

2. *Claims 29–32*

Petitioner also explains how *Beizer* discloses the limitations of dependent claims 29–32. *See* Pet. 49–54. Patent Owner does not present any argument directed specifically to these dependent claims. *See* PO Resp. 18–20. Having reviewed the underlying evidence cited in support of Petitioner’s arguments, we agree with and adopt Petitioner’s analysis as our findings and conclusions, and we determine that Petitioner has shown by a preponderance of the evidence that claims 29–32 would have been obvious based on *Beizer* and *Perlman*. In particular, Petitioner shows that *Beizer* teaches a mainframe computer networked with workstations, which can be personal computers such as an IBM PS/2 Model 50 that act as a buffer computer. *See* Pet. 49–50; Ex. 1003, Fig. 1, 3:37–68, 8:9–26; Ex. 1005 ¶ 43. *Beizer* teaches that some or all of the information added at the workstations can be transmitted to the mainframe. *See* Pet. 51–53; Ex. 1003, 3:37–68, 8:27–37, 9:6–13; Ex. 1005 ¶ 43. *Beizer* also teaches transmitting data over an intranet. *See* Pet. 51–52; Ex. 1003, 8:9–26.

F. Obviousness Challenge Based on Borghesi and Beizer

In our Decision on Institution, we explained that this ground was not instituted “as a generalized fallback for any shortcoming of the previous two grounds” because doing so would deprive Patent Owner of meaningful notice of the challenge. *See* Dec. on Inst. 16–18. Nevertheless, we noted that the Petition included two examples of features that may be absent from Borghesi or Beizer individually but that would have been obvious based on the disclosure of the other reference:

Specifically, Petitioner argues that if Borghesi does not disclose the limitation in claim 28 of “displaying the second form and an image corresponding to the digital attachment on a graphical user interface (GUI) instantiated on the second computer system’s display,” it would have been obvious to use Beizer’s side-by-side approach in order to provide a more usable interface for the appraiser. *See* [Pet. 57] (citing Ex. 1003, 9:49–57; Ex. 1005 ¶ 50). Petitioner further argues that if Beizer does not disclose “transmitting the first field data and the second field data between the mainframe computer and the buffer computer system” as recited in claims 31 and 32, it would have been obvious, based on Borghesi’s teachings, that either portions of the first field data and second field data or all of the field data could be transferred from the buffer computer to the mainframe because storing duplicate information on the mainframe is unnecessary. *See id.* at 57–58 (citing Ex. 1002, 20:34–41; Ex. 1005 ¶ 41).

Id. at 18. Accordingly, this ground, as instituted, permitted Petitioner to argue that even if those specifically identified features were not disclosed by Borghesi or Beizer individually, the claimed subject matter would have been obvious based on the references in combination. *Id.* at 18–19. In view of their dependency from claim 28, claims 29 and 30 were also included in this ground. *Id.* at 19.

Patent Owner's only response to this ground is to argue that "both Borghesi and Beizer are stand-alone systems—they are not connected in any way to legacy mainframes. Since claims 28, 31 and 32 are all directed to systems incorporating a mainframe computer, the combination of Borghesi and Beizer falls as flat as they do on their own." PO Resp. 20. This argument is not persuasive as to claim 28 because, as noted previously, claim 28 does not recite a mainframe. The argument is also unpersuasive as to claims 31 and 32 because it ignores Petitioner's extensive arguments and evidence that both Borghesi and Beizer disclose using a mainframe in the computer network. See Pet. 5, 8, 36–37, 49–50; Reply 18–19; Ex. 1002, 7:3–10, 20:34–41; Ex. 1003, Fig. 1, 3:37–68, 8:9–26; Ex. 1005 ¶¶ 33, 43.

We agree with Petitioner that it would have been obvious to combine Borghesi and Beizer in the proposed manner, and that doing so would satisfy each of the limitations of claims 28–32. We adopt Petitioner's analysis as our findings and conclusions, as summarized above. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claims 28–32 would have been obvious based on Borghesi and Beizer.

G. Conclusions Regarding Obviousness Challenges

Petitioner has shown by a preponderance of the evidence that claims 28–32 would have been obvious in view of Borghesi. In addition, Petitioner has shown by a preponderance of the evidence that claims 28–32 would have been obvious in view of Beizer and Perlman. Finally, Petitioner has shown by a preponderance of the evidence that claims 28–32 would have been obvious in view of Borghesi and Beizer.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 28–32 of U.S. Patent No. 6,338,093 B1 have been shown to be unpatentable; and

FURTHER ORDERED that parties to the proceeding seeking judicial review of this Final Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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