

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 IPR2016-00660
Patent 7,694,129 B2

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

JUNG, *Administrative Patent Judge*.

DECISION
35 U.S.C. § 318(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 1–4, 14, 16, 19–21, 26, and 30–33 of U.S. Patent No. 7,694,129 B2 (Ex. 1001, “the ’129 patent”). Integrated Claims Systems, LLC (“Patent Owner”) did not file a Preliminary Response. Upon considering the Petition, we instituted *inter partes* review of claims 1–4, 14, 16, 19–21, 26, and 30–33 of the ’129 patent. Paper 6 (“Dec. on Inst.”).

After institution, Patent Owner filed a Response (Paper 10, “PO Resp.”), and Petitioner filed a Reply (Paper 14, “Pet. Reply”). Petitioner proffered a Declaration of Paul C. Clark (Ex. 1008, “Clark Declaration” or “Clark Decl.”) with its Petition, and Patent Owner proffered a Declaration of Robert E. Gross (Ex. 2001, “Gross Declaration” or “Gross Decl.”)¹ with its Response.

An oral hearing in this proceeding and Case IPR2016-00659 was held on May 17, 2017; 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

¹ We granted Patent Owner’s motion to deem the filing of the Gross Declaration (Ex. 2001) as timely. Paper 13. When citing to the Gross Declaration, this Decision refers to the exhibit filed on January 13, 2017 titled “Supplemental Exhibit 2001” which includes a statement at paragraph 16 that statements made therein are made with the knowledge that willful false statements are punishable.

preponderance of the evidence that claims 1–4, 14, 16, 19–21, 26, and 30–33 of the ’129 patent are unpatentable.

A. Grounds of Unpatentability at Issue

We instituted *inter partes* review on the grounds, under 35 U.S.C. § 103, that:

(1) claims 1–4, 14, 16, 19–21, 26, and 30–33 are unpatentable over U.S. Patent No. 5,950,169 to Borghesi (Ex. 1002, “Borghesi”); and

(2) claims 1 and 16 are unpatentable over U.S. Patent No. 5,054,096 to Beizer (Ex. 1003, “Beizer”). Dec. on Inst. 13–14.

B. Related Proceedings

The parties indicate that the ’129 patent has been asserted in *Integrated Claims Systems LLC v. Travelers Indemnity Co.*, Case No. 3:14-cv-00892-RNC (D. Conn.). Pet. 55; Paper 5, 1. Petitioner also indicates that patents related to the ’129 patent are the subjects of Cases CBM2014-00186, CBM2014-00187, and IPR2016-00659. Pet. 55.

C. The ’129 Patent (Ex. 1001)

The ’129 patent generally relates to “preparing and processing forms with integrated attachments,” such as a Prior Approval Claim (“PAC”) application containing both a text form and an integrated digitized attachment. Ex. 1001, 1:39–45.

The ’129 patent describes that the “original system involved hard copy paper claims only, with transmission and all processing done manually” and that the “first significant advancement resulted from the introduction of the mainframe computer,” which “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 1:54–55, 1:65–2:2. According to the ’129 patent, the “next advancement was the electronic filing of claim forms” that “was made possible by the introduction of the personal computer and modem into the provider’s office.” *Id.* at 2:20–22.

The ’129 patent also explains that a “National Electronic Information Corporation (NEIC) . . . interfaces between the insurance companies and the service providers” and “establishes rigid standards that must be met in order to transmit an electronic claim form to an insurance company.” *Id.* at 2:50–55. The ’129 patent, however, describes that many claims “require additional text information that doesn’t fit into the prescribed format” or “require non-text information,” such as “pictures, graphs, additional text not allowed on the standard claim form, sound recordings, etc.” *Id.* at 3:8–16. Such claims “are called ‘claims with attachments,’” and include the “PAC (Prior Approval Claim).” *Id.* at 3:11–12, 3:17–18. The ’129 patent states that “when attachments are required, providers are forced to submit hard copy claim applications,” and thus, “insurance companies labor under an administrative system that is a hybrid between a manual and an electronic system.” *Id.* at 4:7–11.

The ’129 patent explains that the “natural next stage in the development of claims processing systems is to attempt to computerize[] this process.” *Id.* at 3:31–33. The ’129 patent describes that “[s]canners are now available that can digitize a dental x-ray.” *Id.* at 3:34. However, the ’129 patent states that “transforming the medical evidence into digital form is not enough to facilitate electronic processing of claims with attachments,” and

“[o]ne must also take into consideration the existing claims processing infrastructure, i.e., the legacy infrastructure.” *Id.* at 3:36–40.

The ’129 patent “encompasses the preparation, transmission, and processing of data packages including a plurality of data fields wherein at least one of the data fields is a digital attachment, e.g., a digital or graphic image.” *Id.* at 10:55–59. “A field is created for each element of information requested.” *Id.* at 12:65–13:1. The “use of ‘fields,’ the customizable claim form, and the placing of coordinated AIC software . . . has eliminated the need for standardized forms.” *Id.* at 17:54–58. “[A]ll available forms are written into the AIC software so that they are coordinated with one another, that is, they know where each has a similar ‘field.’” *Id.* at 42:64–67.

Figure 3A is reproduced below:

FIG. 3A

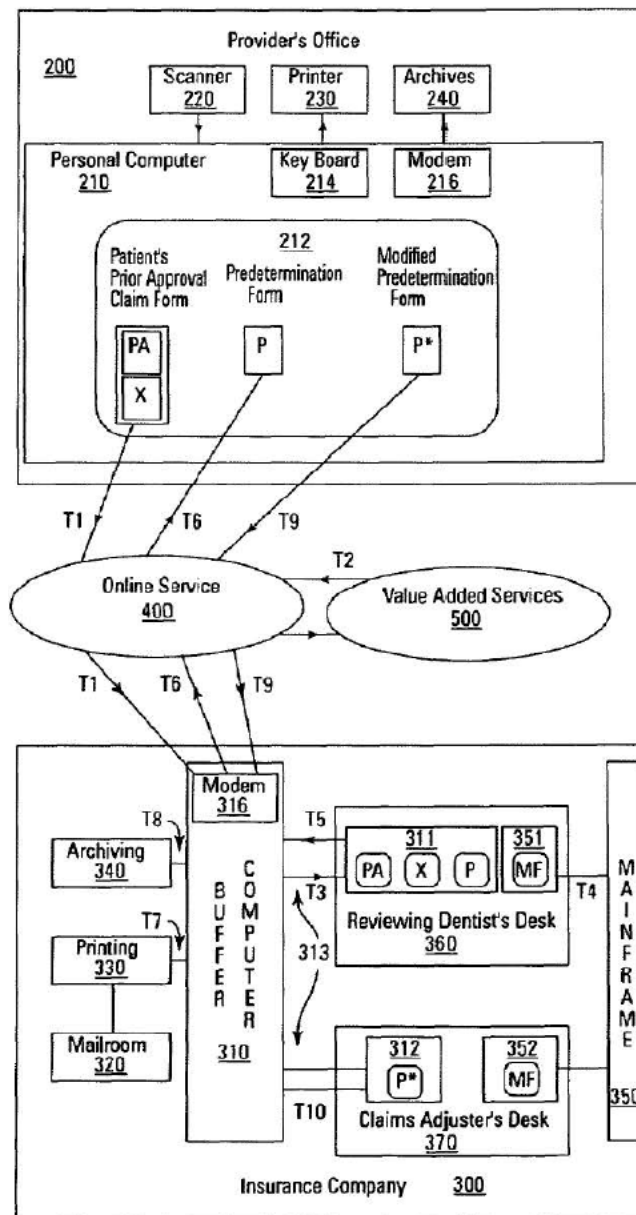


Figure 3A is a combination block and flow diagram. *Id.* at 10:1–5. Components 200 located in the health care provider's office “include a personal computer 210 . . . and a modem 216, connected to scanner 220.” *Id.* at 11:41–42, 11:56–58. “Components 300 located at the insurance company include the previously described mainframe or legacy computer 350 and associated terminals 351, 352.” *Id.* at 12:4–6. Value added services

500 can be a “National Dental Data Bank (NDDDB), i.e., a data bank storing patient dental images.” *Id.* at 41:64–66.

The AIC software is stored in computer system 210. *Id.* at 12:24–26. The software “advantageously is Graphic User Interface (GUI) software” and contains forms. *Id.* at 12:26–27, 13:23–27, 45–46. The ’129 patent describes that “commercial software packages, such as LOTUS NOTES™, have been designed with the capability of addressing combinations of text and graphics files,” but the “embodiments . . . are directed at providing integrated text and graphics files within a coherent system and methodology for addressing the specific needs of the work flow, preferably of a particular industry” or “a particular application.” *Id.* at 12:30–40. The ’020 patent states that “[i]t is possible, but not necessary, that the software needed to implement the preferred embodiments of the present invention can be developed within the frame work of the environment created by something such as LOTUS NOTES™.” *Id.* at 12:40–44.

“Once the insurance company is identified, the fields needed to complete the insurance company’s PAC form are displayed.” *Id.* at 13:26–28. Each 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 12:50–55. The “information denoted by the characters can be transferred to and used in completing other fields in related documents.” *Id.* at 12:55–57.

A patient’s x-ray is digitized, such as by “a scanner **220**, i.e., digitizer, connected to the service provider’s computer system running the AIC software.” *Id.* at 13:49–52. The “PAC application is formed from the

electronic PAC form and the digitized patient's x-ray." *Id.* at 14:8–9. 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 14:12–13, 14:15–19. The "patient's PAC application can be sent to the insurance company in several ways . . . including via normal phone service, an on-line service, or bulk data transmission lines." *Id.* at 15:53–56.

"[T]he information is stored in fields that can be read by the corresponding AIC software module in the computer system **310** at the insurance company." *Id.* at 15:41–44. PAC applications "are subsequently downloaded to a GUI-capable computer system **310**." *Id.* at 17:9–10. When a "reviewing dentist calls up a patient's PAC application," the "system AIC software automatically inserts the insurance company's Predetermination Form" and "can automatically transfer whatever information from the PAC application to the Predetermination form that is useful in completing the Predetermination form." *Id.* at 17:39–46. "When the transmit icon on the computer screen of the benefit reviewer's GUI-capable computer system is activated," the insurance company "transmits the Predetermination form, i.e., just the information 'fields,' to the service provider's e-mail address." *Id.* at 18:35–37, 18:45–48.

D. Illustrative Claim

The '129 patent has 33 claims, and claim 1, reproduced below, is the only independent claim.

1. A method of processing digital data and images, comprising:
receiving:
first data into identifiable fields to create a first set of filled identifiable fields, wherein at least one of the first set of filled identifiable fields contains at least one image; and
second data into identifiable fields to create a second set of filled identifiable fields, wherein the second set of filled identifiable fields is a nonempty set, and
wherein at least some of the first and second data are information that identifies the source of the first and second data;
presenting a graphic user interface (GUI) comprising a set of fields,
wherein at least one of the fields of the GUI contains an image from the first set of filled identifiable fields, and
wherein at least one of the fields of the GUI is filled with data from the second set of filled identifiable fields;
receiving an indication to proceed with processing data;
and
in response to receiving the indication:
using data from at least one field of the second set of filled identifiable fields to complete at least one field in at least one data bank.

Ex. 1001, 44:28–64.

II. CLAIM INTERPRETATION

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard). 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).

Petitioner proposed an interpretation of “subset” (Pet. 4), and Patent Owner did not file a preliminary response. We did not need to interpret any terms for the Decision on Institution. Dec. on Inst. 4.

A. “*Fields*” (*Claims 1, 2, 14, 19, and 26*)

The Petition does not present a proposed interpretation of the term “fields.” See Pet. 3–4. Patent Owner proposes interpreting “fields” in claims 1, 2, 7², 14, and 19 as “data comprised of ‘label data’ and ‘content data’” in light of the specification, particularly the description of a “field” as a “delimited alpha-numeric character string.” PO Resp. 13 (citing Ex. 1001, 10:55–59, 12:50–13:23, 22:30–23:3, 32:23–63; Microsoft Computer Dictionary Fifth Edition (2002), 152 (definition of “delimit”)); see also Tr. 18:21–24 (Patent Owner’s counsel arguing that “identifiable fields are delimited and include two parts . . . label data and content data”); *id.* at 20:2–5 (Patent Owner’s counsel arguing that “our definition which is that a field includes two parts, which is the label and the content” and “label indicates that the field is delimited”).

Patent Owner argues that the specification of the ’129 patent also defines properties of the “field” that can be summarized as containing label data and content data and thus defines “field.” PO Resp. 13–14 (citing Ex. 1001, 10:55–59, 32:23–38, 32:34–44, 32:52–58). Patent Owner contends that, based on the description that a field is “delimited” and the other described properties of a field, “field” should be construed as “data

² Petitioner does not challenge claim 7, but the term “fields” does appear in that claim.

comprised of ‘label data’ and ‘content data’” in view of the specification. *Id.* at 15 (citing Gross Decl. ¶¶ 12, 13) (emphasis omitted).

Patent Owner also contends that its proposed interpretation of “field” “is the mechanism [that] allows the claimed invention to operate.” *Id.* at 15 (citing Ex. 1001, 32:60–63, 33:10–63, 34:38–40; Gross Decl. ¶¶ 12, 13). Patent Owner further argues that Petitioner implicitly construes “field” as a “GUI data entry box,” as indicated by its arguments. *Id.* at 16 (citing Pet. 4–54); *see also* Tr. 20:7–9 (Patent Owner’s counsel arguing that “as opposed to a field of a GUI . . . which is merely data entry boxes”). Patent Owner, thus, asserts that Petitioner’s field contains data and executable code. PO Resp. 16.

Petitioner replies that Patent Owner’s proposed interpretation fails to distinguish the challenged claims from Borghesi or Beizer (Pet. Reply 8) and can still include “executable code” because Patent Owner’s proposed interpretation includes “comprised of” (*id.* at 9). Petitioner also argues that excluding a “GUI box” contradicts the language of claim 1 that recites “[p]resenting a graphic user interface (GUI) comprising a set of fields.” *Id.* at 9–10.

Petitioner also replies that Patent Owner’s proposed interpretation of “field” is incorrect. *Id.* at 7. Petitioner contends that Patent Owner offers no explanation as to why the proposed interpretation requires further construction beyond what Patent Owner cites in the specification. *Id.* at 7–8 (citing PO Resp. 13; Ex. 1001, 10:55–59, 12:50–13:23, 22:30–23:3, 32:23–63). Petitioner also contends that Patent Owner’s cited dictionary definition fails to support Patent Owner’s proposed interpretation of “field.” Pet. Reply 8 (citing PO Resp. 13). Petitioner additionally asserts that Patent

Owner's arguments regarding "executable code" are unsupported attorney argument. Pet. Reply 9.

Petitioner further replies that Patent Owner's proposed interpretation of "field" is at odds unjustifiably with its proposed interpretation of the same term in related patents in other Board proceedings (*id.* at 3–5 (citing PO Resp. 13–16; Exs. 1012–1014, 1016, 1017)) and that Patent Owner relies on a dictionary definition that was not submitted as an exhibit and thus should not be considered (Pet. Reply 5–6 (citing PO Resp. 13)). Petitioner also argues that the Gross Declaration does not explain any basis for its conclusions as to the meaning of "field," does not explain who the person of ordinary skill in the art is, and does not provide any evidence that the declarant is qualified as to the knowledge of one of ordinary skill in the art. Pet. Reply 6–7 (citing Gross Decl. ¶¶ 3–9, 12).

Based on the record before us, we are not persuaded to adopt Patent Owner's proposed interpretation for the reasons that follow. First, turning to the claims, claim 1 requires receiving first and second data "into identifiable fields" to create first and second sets of "filled identifiable fields." Ex. 1001, 44:28–40. The first set of identifiable fields "contains at least one image" and the second set of identifiable fields "is a nonempty set." *Id.* Claim 1 also requires presenting a graphic user interface or GUI that comprises a "set of fields," wherein at least one of the fields of the GUI contains an image from the first set of filled identifiable fields and at least one of the fields of the GUI is filled with data from the second set of filled identifiable fields. *Id.* at 44:41–46. Claim 1 further requires "using data from at least one field of the second set of filled identifiable fields" to complete one field in a data bank. *Id.* at 44:49–52.

Claim 2 depends from claim 1 and requires first subsets of the first and second sets of filled identifiable fields. *Id.* at 44:53–65. Claim 14 depends from claim 1 and recites “cross-referencing at least some of the filled identifiable fields with each other.” *Id.* at 45:44–46. Claim 19 also depends from claim 1 and requires second subsets of the first and second sets of filled identifiable fields. *Id.* at 45:60–46:1. Claim 26 depends from claim 19 and requires third subsets of the filled identifiable fields. *Id.* at 46:29–34.

We determine that the claims do not indicate that the term “fields” must include label data and content data. Claim 1, for example, indicates data is received in fields, a filled identifiable field contains an image, fields of a GUI contain an image and data from filled identifiable fields, and data from filled identifiable fields is used to complete at least one field in a data bank. *See* Ex. 1001, 44:28–52. Patent Owner’s proposed interpretation of “fields” is narrower than the claims because the claims do not require expressly that the fields also contain label data or are delimited. The claims require receiving first and second data into identifiable fields, and do not indicate the fields are also “data comprised of ‘label data’ and ‘content data,’” as proposed by Patent Owner. Therefore, we determine that Patent Owner’s interpretation is narrower than and inconsistent with the claims.

Turning next to the specification, Patent Owner relies on portions that describe data packages that include data fields with a digital attachment (Ex. 1001, 10:55–59), boxes in which alpha-numeric characters are entered to “fill a ‘field,’ a delimited alpha-numeric character string” (*id.* at 12:50–55, 22:30–35, 32:23–28), how fields are used and created from various forms to provide customized claim forms (*id.* at 12:55–13:23, 22:35–23:3, 32:28–63),

how some form of signature can be provided in a field (*id.* at 33:11–20), and how PAC forms are processed (*id.* at 33:21–63, 34:38–40). *See* PO Resp. 13–15. Although the specification describes a field as being a delimited alpha-numeric character string when alpha-numeric characters are entered (Ex. 1001, 12:50–55, 22:30–35, 32:23–28), Patent Owner also cites to a portion of the specification that explains “some form of signature can be provided in the appropriate field,” such as by “a special electronic pad and pen . . . that when the patient signs on the pad his signature is affixed to the electronic PAC form” (*id.* at 33:16–20; *see also id.* at 13:44–48, 23:23–27). *See* PO Resp. 15 (citing Ex. 1001, 33:10–63). The specification does not indicate that such a signature would be an alpha-numeric character string or delimited. The specification also states that the “present invention encompasses the preparation, transmission, and processing of data packages including a plurality of data fields wherein at least one of the data fields is a digital attachment, e.g., a digital or graphic image.” Ex. 1001, 10:55–59. Nowhere does the specification describe a field as delimited when a digital attachment or digital or graphic image is entered.

In view of the above, we also find that the specification of the ’129 patent does not provide a clear or precise definition of “fields.” Any special definitions for claim terms or phrases must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Instead of reasonable clarity, deliberateness, and precision, we find that the specification does not describe expressly that a field is “data comprised of ‘label data’ and ‘content data,’” as proposed by Patent Owner.

Therefore, based on our review, we determine that the specification of the ’129 patent does not support adequately Patent Owner’s proposed

interpretation of “fields.” Instead, the specification indicates that one of ordinary skill in the art would understand “fields” has a meaning broader than Patent Owner’s proposal. Also, because we do not find a definition of “fields” in the specification, we are not persuaded to read limitations, such as those based on “field” being “a delimited alpha-numeric character string” (Ex. 1001, 12:53–55, 22:33–35, 32:26–28), from the specification into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Neither party relies on the prosecution history of the ’129 patent to argue for a meaning of “fields.” *See* PO Resp. 12–16; Pet. Reply 3–10. Patent Owner, however, cites to paragraphs 12 and 13 of its Gross Declaration that, in turn, rely on portions of the specification discussed above and a definition from the Microsoft Computer Dictionary. *See* PO Resp. 13, 15 (citing Gross Decl. ¶¶ 12–13). For the reasons above, we determine that one of ordinary skill in the art would understand “field” as used in the cited portions of the specification and elsewhere to have a meaning broader than Patent Owner’s proposed interpretation. We also 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.”). Even if it were filed as an exhibit, a dictionary definition of “delimit” would not persuade us Patent Owner’s proposed interpretation is correct, because, as explained above, Patent Owner 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* Gross Decl. ¶ 12 (“A person of ordinary skill in the art would

know, at the time the applications leading to the patents were filed, that in light of the specification the term ‘field’ means a delimited alpha-numeric character string.”). Neither Patent Owner nor Mr. Gross provides any persuasive evidence or explanation why delimiting inheres in the meaning of “field” as used in the ’129 patent.

We find that the evidence cited by Patent Owner insufficiently supports that one of ordinary skill in the art would understand “fields” as “data comprised of ‘label data’ and ‘content data’” in the context of the entire disclosure of the ’129 patent. *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2011) (“Even under the broadest reasonable interpretation, the Board’s construction ‘cannot be divorced from the specification and the record evidence,’ and ‘must be consistent with the one that those skilled in the art would reach.’”).

Based on our review of the specification and the complete record before us, we interpret “fields” to mean “entries created for, at least, alphanumeric data or image data.” The ’129 patent states that “the present invention encompasses the preparation, transmission, and processing of data packages including a plurality of data fields wherein at least one of the data fields is a digital attachment, e.g., a digital or graphic image.” Ex. 1001, 10:55–59. It explains that a “field is created for each element of information requested,” that “when information i[s] entered into areas of the electronic PAC forms, it is entered as a ‘field,’” and that “all available forms are written into the AIC software so that they are coordinated with one another, that is, they know where each has a similar ‘field.’” *Id.* at 12:65–13:1, 42:52–54, 42:64–67. The specification describes boxes in which alpha-numeric characters are entered to “fill a ‘field,’ a delimited alpha-numeric

character string.” *Id.* at 12:50–55, 22:30–35, 32:23–28. The specification further explains “some form of signature can be provided in the appropriate field,” such as by “a special electronic pad and pen . . . that when the patient signs on the pad his signature is affixed to the electronic PAC form.” *Id.* at 33:16–20; *see also id.* at 13:44–48, 23:23–27.

Therefore, for purposes of this Decision, we interpret “fields” to mean “entries created for, at least, alphanumeric data or image data.”

B. Remaining Terms

Other than the term discussed above, we determine that an express interpretation of any other term is not necessary for the purposes of this Decision. *See also* PO Resp. 12 (Patent Owner stating that “[f]or the remaining terms . . . the plain and ordinary meaning should apply”).

III. OBVIOUSNESS CHALLENGES

To prevail in its challenge of claims 1–4, 14, 16, 19–21, 26, and 30–33 under 35 U.S.C. § 103(a) as unpatentable over Borghesi (Ex. 1002) and in its challenge of claims 1 and 16 under 35 U.S.C. § 103(a) as unpatentable over Beizer (Ex. 1003), Petitioner must prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). “A claimed invention may be obvious even when the prior art does not teach each claim limitation, so long as the record contains some reason

why one skill in the art would modify the prior art to obtain the claimed invention.” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016).

A patent claim composed of several elements, however, is not proved obvious merely by demonstrating that each of its elements was known, independently, in the prior art. *KSR*, 550 U.S. at 418. For an obviousness analysis, it is important to identify a reason that would have prompted one of skill in the art to combine prior art elements in the way the claimed invention does. *Id.* Obviousness can be established when the prior art, itself, would have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976).

A. Level of Ordinary Skill

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 3 n.1 (citing Clark Decl. ¶ 20). 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.; Gross Decl. After considering the disclosures of the ’129 patent and the cited prior art references, we adopt Petitioner’s proposal.

B. Challenge Based on Borghesi

1. Borghesi (Ex. 1002)

Borghesi relates to “a method and system of handling insurance claims from an initial claim through final settlement.” Ex. 1002, 1:26–28. It describes “claim processing by controlling the electronic transfer of files between various remote computers, including those located at . . . body shops, . . . insurance company, and other terminals which may be used in an insurance processing environment.” *Id.* at 4:24–30. Borghesi focuses its “description . . . on automobile claim processing but may equally apply to other types of insurance claim processing.” *Id.* at 4:33–35.

An insurance claim to be processed is defined as a “workfile,” which “contains all the necessary information for field processing of insurance claims,” and Borghesi provides networking capability for transferring all or part of the workfile between computers. *Id.* at 4:30–32, 37–39, 47–48. At each computer, “a user views datafiles and other insurance claim processing information . . . and can enter . . . data.” *Id.* at 7:24–28.

A system of Borghesi includes inputting a digitized image by a digital camera or scanning of a regular photograph. *Id.* at 6:52–60. A “digitized image of the damaged vehicle is appended to the workfile.” *Id.* at 6:60–61

Figure 6 of Borghesi is reproduced below.

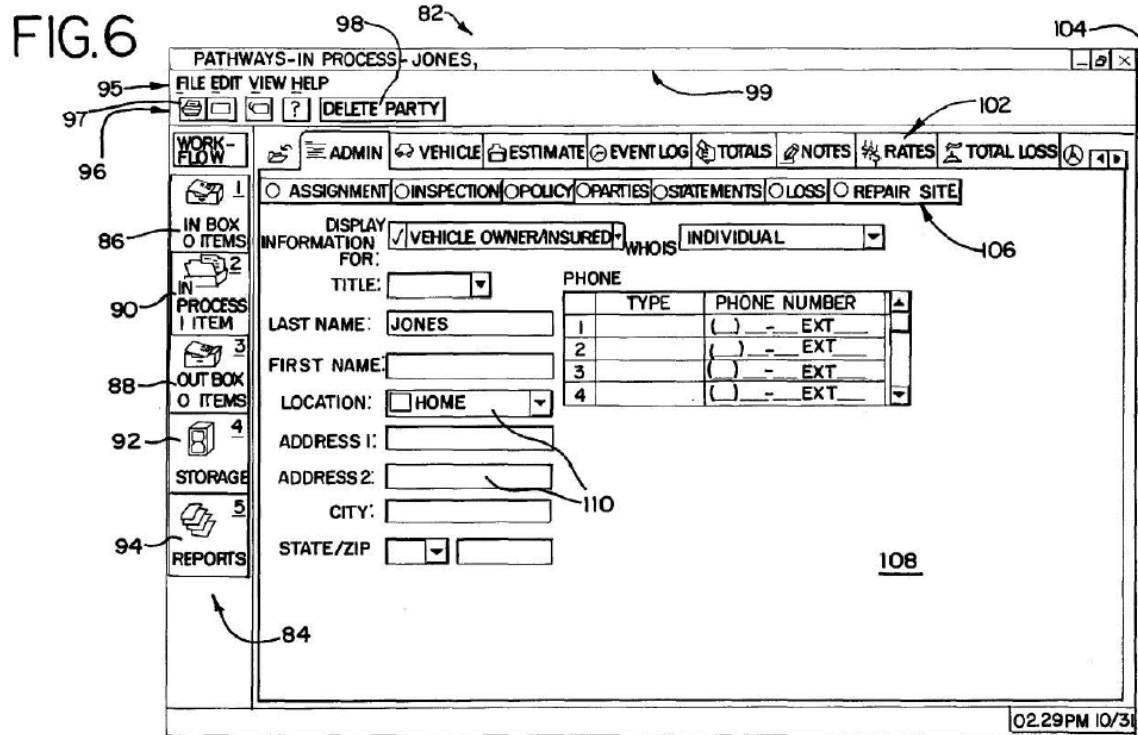


Figure 6 shows a screen from a graphic user interface for use with Borghesi's system. *Id.* at 3:44–45. “Each remote computer . . . provides an interface for a user to access the . . . workfile” that preferably is a “graphic user interface.” *Id.* at 7:40–46. The graphic user interface “displays at least one workfile/datafile” and permits a user to enter and retrieve information. *Id.* at 7:44–46, 54–59, Fig. 6. Also, “tasks involved in processing an insurance claim may be addressed through the graphic user interface.” *Id.* at 10:40–42.

The “graphic user interface . . . , an opened insurance claim datafile has a plurality of tabbed sections, each tabbed section representing a separate view of the datafile.” *Id.* at 7:49–51. In the “ADMIN” tab are several frames, one of which is the “parties” frame. *Id.* at 9:18–20, 9:29–30, Fig. 6. In Figure 6, the “parties” frame is selected, and the “selection reveals a number of text fields **110** for entering or viewing name, address and

telephone information.” *Id.* at 9:29–31. Borghesi also describes an event log that “records events/actions taken with respect to each insurance datafile,” “is attached to the datafile,” and shows the “author of each event.” *Id.* at 5:42–44, 15:11–14, 15:19–21.

In a situation where a damaged car is not driveable, a body shop prepares a computerized estimate of repairs for the damaged car. *Id.* at 17:6–16. The body shop sends an estimate and electronic images of the car as part of a workfile to an insurance company. *Id.* at 17:6–7, 25–28. If necessary, an appraiser/adjuster requests more images, the “body shop takes more electronic images, performs a computer EOR estimate, and e-mails the EOR and electronic images to the appraiser/adjuster.” *Id.* at 17:58–18:1.

2. *Independent Claim 1*

Petitioner contends that claim 1 is rendered obvious by Borghesi, with citations to the disclosure of Borghesi, a claim chart, and its Clark Declaration. Pet. 4–39.

As argued by Petitioner, we agree that Borghesi teaches or suggests a method of processing digital data and images. *Id.* at 18–19 (citing Ex. 1002, 4:24–30, 4:41–48, 17:64–18:1). We find that Borghesi describes “claim processing by controlling the electronic transfer of files between various remote computers, including those located at . . . body shops, . . . insurance company, and other terminals which may be used in an insurance processing environment” (Ex. 1002, 4:24–30) and that a body shop emails “computer EOR estimate” and “electronic images” to an appraiser/adjuster (*id.* at 17:64–18:1).

We also agree with Petitioner that Borghesi teaches or suggests “receiving: first data into identifiable fields to create a first set of filled

identifiable fields, wherein at least one of the first set of filled identifiable fields contains at least one image.” Pet. 17 (arguing a “first set of data input into filled identifiable fields, for example, is created by the initial estimate and images sent from the body shop to the appraiser through a workfile”) (citing Ex. 1002, 17:56–60; Clark Decl. ¶ 41), 19–24 (citing Ex. 1002, 5:26–30, 6:56–67, 7:24–28, 7:40–53, 8:65–9:21, 9:29–32, 10:43–45, 11:28–42, 13:42–43, 14:40–47, 17:52–18:1, Figs. 6, 7, 9–15, 19). We find that Borghesi teaches that “[a]ll the information related to a given claim is preferably contained in a single workfile such as an electronic datafile **24**” (Ex. 1002, 5:26–30), that “[o]n each computer . . . a user views datafiles and other insurance claim processing information . . . and can enter . . . data” (*id.* at 7:24–28), that “[e]ach remote computer . . . provides an interface for a user to access the . . . workfile” that preferably is a “graphic user interface” (*id.* at 7:40–46), and that in the “graphic user interface . . . , an opened insurance claim datafile has a plurality of tabbed sections, each tabbed section representing a separate view of the datafile” (*id.* at 7:49–51). We also find that Borghesi teaches that in the “ADMIN” tab are several frames, one of which is the “parties” frame, shown in Figure 6, which includes “a number of text fields **110** for entering or viewing name, address and telephone information.” *Id.* at 9:18–20, 9:29–32, Fig. 6. We further find that Borghesi teaches that “[o]ther options a user has while viewing items in the in box are to . . . attach **184** the transaction . . . to a workfile in the in process box” and the “transaction may be a digitized image.” *Id.* at 11:28–31, 11:35–37. Borghesi also teaches that a “digitized image of the damaged vehicle is appended to the workfile.” *Id.* at 6:60–61. Petitioner also persuades us that one of ordinary skill in the art

would have at least found it obvious to display a GUI where at least one of the fields contains an image and at least one of the fields is filled with data, such as information relating to the image, at least because the user would be able to more efficiently review relevant materials in preparing a work order.

Pet. 9 (citing Clark Decl. ¶ 31).

We further agree with Petitioner that Borghesi teaches or suggests “receiving . . . second data into identifiable fields to create a second set of filled identifiable fields, wherein the second set of filled identifiable fields is a nonempty set.” *Id.* at 17 (arguing “[s]econd data is entered into identifiable fields to create a second set of filled identifiable fields, for example, when the body shop prepares the workfile and sends the second set of EOR and images to the appraiser”) (citing Ex. 1002, 17:64–66; Clark Decl. ¶ 41), 19–20 (citing Ex. 1002, 6:56–67, 7:24–28, 17:56–18:1, Fig. 19), 24–25 (citing Ex. 1002, 7:40–53, 17:64–18:1). We find that Borghesi teaches receiving second data when the “body shop takes more electronic images, performs a computer EOR estimate, and e-mails the EOR and electronic images to the appraiser/adjuster.” Ex. 1002, 17:64–18:1. Petitioner also persuades us that a person of ordinary skill in the art “would understand that the fields containing information are ‘filled’ fields and thus ‘nonempty’ sets.” Pet. 7 (citing Clark Decl. ¶ 29).

We agree with Petitioner that Borghesi teaches or suggests “wherein at least some of the first and second data are information that identifies the source of the first and second data.” *Id.* at 26–27 (citing Ex. 1002, 5:42–50, 12:14–36, 15:11–23). We find that Borghesi teaches an event log that “records events/actions taken with respect to each insurance datafile,” “is attached to the datafile,” and shows the “author of each event.” Ex. 1002,

5:42–44, 15:11–14, 15:19–21. We also find that Borghesi teaches that “when a user is creating a workfile for a specific claim the user begins by entering vehicle identification **220** into the workfile via the keyboard.” *Id.* at 12:14–16. Petitioner also persuades us that it would have been obvious “to identify the source of any information added to the workfile, such as a body shop identifying itself as the source of an email to an appraiser/adjuster.” Pet. 8 (citing Ex. 1002, 17:51–18:6; Clark Decl. ¶ 30).

We also agree with Petitioner that Borghesi teaches or suggests “presenting a graphic user interface (GUI) comprising a set of fields.” *Id.* at 28–29 (citing Ex. 1002, 9:29–32, 10:40–46, 13:42–43, 17:64–18:1, Figs. 6, 7, 9–15). We find that Borghesi teaches “tasks involved in processing an insurance claim may be addressed through the graphic user interface” (Ex. 1002, 10:40–42) and would include an appraiser/adjuster reviewing a computer EOR estimate and electronic images (*id.* at 17:64–18:1).

We agree with Petitioner that Borghesi teaches or suggests “wherein at least one of the fields of the GUI contains an image from the first set of filled identifiable fields.” Pet. 29–30 (citing Ex. 1002, 17:52–60). We find that Borghesi teaches an “appraiser/adjuster subsequently receives **454** the electronic images for review” (Ex. 1002, 17:52–60), and as discussed above, “tasks involved in processing an insurance claim may be addressed through the graphic user interface” (*id.* at 10:40–42). Also, Petitioner persuades us that one of ordinary skill in the art

would have at least found it obvious to display a GUI where at least one of the fields contains an image and at least one of the fields is filled with data, such as information relating to the image, at least because the user would be able to more efficiently review relevant materials in preparing a work order.

Pet. 9 (citing Clark Decl. ¶ 31).

We also agree with Petitioner that Borghesi teaches or suggests “wherein at least one of the fields of the GUI is filled with data from the second set of filled identifiable fields.” *Id.* at 30–31 (citing Ex. 1002, 17:64–18:4, 18:41–46). We find that Borghesi teaches that, after a “body shop takes more electronic images” and “performs a computer EOR estimate,” an “appraiser/adjuster reviews **456** the computer EOR and electronic images” (Ex. 1002, 17:64–18:1). Also, as discussed above, we find that Borghesi teaches that “tasks involved in processing an insurance claim may be addressed through the graphic user interface” (*id.* at 10:40–42).

We further agree with Petitioner that Borghesi teaches or suggests “receiving an indication to proceed with processing data; and in response to receiving the indication: using data from at least one field of the second set of filled identifiable fields to complete at least one field in at least one data bank.” Pet. 31–33 (citing Ex. 1002, 8:38–40, 11:23–42, 11:46–50, 14:14–16, 17:24–29, 17:64–18:4, 18:41–46). We find that Borghesi teaches that “a user confirms the completion of the files contained in the out box **88**.” Ex. 1002, 8:38–40. We also find that Borghesi teaches that “[u]pon receiving the repair authorization **435**, the body shop . . . schedules the repair work.” *Id.* at 17:24–29. Petitioner further persuades us that it would have been obvious to one of ordinary skill in the art “to process information after receiving an indication to proceed, such as a body shop receiving confirmation to begin repairs on a car from the insurance company” or “such as when an appraiser/adjuster determines a car is a total loss and e-mails the insurance company.” Pet. 12–13 (citing Ex. 1002, 17:24–29, 18:41–46; Clark Decl. ¶ 35). We further find that Borghesi teaches that a “user may

connect **174** to the insurance database at the home office” (Ex. 1002, 11:46–47) and “[c]ompleted transactions are transmitted **190** from the out box to the home office” (*id.* at 11:48–50) or a user can “move **180** a workfile or other transaction to storage locations such as a memory . . . or network computer **76**” (*id.* at 11:23–28).

In view of Petitioner’s arguments and evidence as discussed above, Patent Owner’s arguments are not persuasive. Patent Owner responds that Petitioner’s obviousness arguments fail for several reasons with citations to its Gross Declaration. PO Resp. 23–33. First, Patent Owner contends that Petitioner erroneously identifies a “GUI box” as the claimed “identifiable field” and a “filled GUI box” as the claimed “filled identifiable field.” *Id.* at 18–19, 23–24 (citing Pet. 20–21; Clark Decl. ¶¶ 28, 29). Patent Owner argues that a GUI box does not have the properties of the “identifiable field,” as described by the ’129 patent. *Id.* at 25. In particular, Patent Owner contends that a GUI box does not have a delimiter or label, is comprised of executable code, and when filled, cannot be part of a file containing insurance claim data to be transmitted to an insurance company. *Id.* at 26.

Patent Owner also responds that a file cannot contain GUI boxes because they “only exist as a visual display element,” and GUI boxes cannot be the claimed “filled identifiable fields” because GUI boxes would render claim 2 inoperable. *Id.* at 27 (citing Ex. 1001, 10:55–59, 12:50–13:23, 22:30–23:3, 32:23–63). Patent Owner, thus, argues that GUI boxes cannot be the “identifiable fields” of claim 1, from which claim 2 depends, and therefore, Petitioner’s obviousness arguments fail. *Id.* at 27–28. In connection with dependent claim 2 but also relevant to claim 1, Patent

Owner responds that identifying a GUI box as the “identifiable field” would render the claims of the ’129 patent “ludicrous” because no person of skill in the art would interpret the claims to encompass GUI boxes which contain executable code. *Id.* at 28–29.

Petitioner replies that Patent Owner does not provide an argument that Borghesi fails to teach “field” under its proposed interpretation. Pet. Reply. 1, 11, 15–16. Petitioner also disputes that it offered an interpretation of “field” because Petitioner contends that the term does not warrant interpretation. *Id.* at 12. Petitioner contends that its Petition argued Borghesi teaches or suggests “fields” not only in Figure 6 which shows a GUI (*id.*) but also in other contexts (*id.* at 13 (citing Pet. 7; Clark Decl. ¶¶ 29, 31)). *See also id.* at 2 (arguing Petitioner “pointed to other examples of how the prior art use fields unrelated to a GUI”). Petitioner also contends that its Clark Declaration was not challenged or rebutted. *Id.* at 14–15 (citing Clark Decl. ¶¶ 32, 41).

As discussed in Section II.A., we do not adopt Patent Owner’s proposed interpretation of “fields” as “data comprised of ‘label data’ and ‘content data.’” Even if Patent Owner’s proposed interpretation is applied, Petitioner persuades us that Borghesi’s workfile or datafile, which a user accesses through a graphic user interface, would include label data and content data, as indicated by Borghesi’s Figure 6, which shows text fields 110 with labels and contents, such as “LAST NAME” and “JONES,” indicating that the accessed workfile or datafile has corresponding labels and content. *See* Ex. 1002, 5:26–30 (“All the information related to a given claim is preferably contained in a single workfile such as an electronic datafile **24**”); 7:40–46 (“Each remote computer . . . provides an interface for

a user to access the . . . workfile” that preferably is a “graphic user interface”). Borghesi also teaches that the fields of the graphic user interface are part of its access to the underlying datafile and do not have to be the fields of the datafile itself. *See id.* Furthermore, even under Patent Owner’s proposed construction that fields comprise label data and content data, the claims do not exclude the identifiable fields or filled identifiable fields from being part of a GUI or additionally containing executable code. Borghesi does not indicate that its fields contain executable code.

Patent Owner further responds that the event log shown in Figure 13 of Borghesi does not teach or suggest “information that identifies the source of the first and second data,” as required by claim 1. PO Resp. 32 (citing Pet. 7). Patent Owner asserts that the information in the event log does not constitute part of the first or second data received into identifiable fields. *Id.* Patent Owner also asserts that a subject and a source of data are not the same because a subject of data, such as Petitioner’s vehicle or patient, can generate or transmit data but a source of data cannot. *Id.* at 32–33 (citing Clark Decl. ¶ 31). Patent Owner, thus, contends that no reasoning or analysis supports Petitioner’s argument that it would have been obvious to have some of the first and second data include information that identifies the source of the data. *Id.* at 33.

Petitioner replies that the Petition argues Borghesi teaches some of the first and second data identifying the source of the first and second data. Pet. Reply 17–19 (citing Pet. 7, 8, 21, 26–27, 41, 46–47; PO Resp. 32; Clark Decl. ¶¶ 29, 30). Petitioner further replies that the source of the data can be “a patient from whom diagnostic information is gathered” under the broadest reasonable interpretation of “source.” *Id.* at 19. Petitioner also provides

additional arguments based on related proceedings. *Id.* at 20–21 (citing Exs. 1014, 1015).

Petitioner persuades us that Borghesi teaches or suggests “information that identifies the source of the first and second data,” as required by claim 1, for the reasons previously discussed. *See* Ex. 1002, 15:11–14 (“The event log records events/actions taken with respect to each insurance datafile” and “is attached to the datafile.”), 15:19–21 (“[A]n event screen is shown listing . . . author of each event.”). Claim 1, even if read together with claim 2, does not prevent “the source of the first and second data” from “transmitting the first file.” *See id.* at 44:28–65. Moreover, the record does not include an interpretation of “the source of the first and second data” that would indicate Petitioner insufficiently maps Borghesi to this element of claim 1.

After considering Petitioner’s arguments and evidence in view of Patent Owner’s response, the complete record persuades us that Petitioner has demonstrated by a preponderance of the evidence that claim 1 is rendered obvious by Borghesi.

3. *Dependent Claim 2*

Claim 2 depends from claim 1 and requires generating a first file that comprises first subsets of the first and second sets of filled identifiable fields. Ex. 1001, 44:53–57. Claim 2 also requires the first subset of the first set of filled identifiable fields contains at least one image and the first subset of the second set of filled identifiable fields is a nonempty set. *Id.* at 44:58–61. The data in the first file also “identifies the source of the first and second data.” *Id.* at 44:62–64.

Petitioner argues that Borghesi teaches or suggests the limitations of claim 2. Pet. 33–34 (citing Ex. 1002, 8:40–43, 10:6–28, 11:46–50, 13:20–

23, 13:42–43, 18:41–46, 18:58–59, 18:63–65, 20:45–50). Petitioner also refers to previous arguments regarding limitations of claim 1 and the understanding of one of ordinary skill in the art. *Id.*

As discussed above, we agree with Petitioner that Borghesi teaches or suggests first and second sets of filled identifiable fields. We also agree with Petitioner that Borghesi teaches or suggests that a first file is created when an appraiser sends two sets of estimates and images to the insurance company. *See id.* at 17 (citing Ex. 1002, 18:41–46, Fig. 21; Clark Decl. ¶ 42). We further agree with Petitioner that it would have been obvious “to send only some (i.e., subsets) of the data to the insurance company, rather than all of the data, when not all of the data is needed by the insurance company to process the claim.” *Id.* at 17 (citing Clark Decl. ¶ 42).

We find that Borghesi teaches that an “appraiser/adjuster e-mails **473** an estimate and electronic images to the insurance company” (Ex. 1002, 18:41–46) and that Borghesi teaches “a method of processing an insurance claim . . . that permits a user or users to create an insurance workfile and transfer all or part of the workfile” (*id.* at 20:45–50).

Patent Owner responds that a file cannot contain GUI boxes because they “only exist as a visual display element,” and GUI boxes cannot be the claimed “filled identifiable fields” because GUI boxes would render claim 2 inoperable. PO Resp. 27 (citing Ex. 1001, 10:55–59, 12:50–13:23, 22:30–23:3, 32:23–63). Patent Owner also responds that identifying a GUI box as the “identifiable field” would render the claims of the ’129 patent “ludicrous” because no person of skill in the art would interpret claim 2 to encompass GUI boxes which contain executable code. *Id.* at 28–29. Patent Owner contends that the skilled artisan would not interpret claim 2 as

transmitting a file that contains executable software to an insurance company and no insurance company would accept such a file. *Id.* at 29.

For the reasons discussed above for the “identifiable fields” and “filled identifiable fields” of claim 1, we are persuaded that Petitioner’s arguments and evidence show that Borghesi teaches or suggests these fields. Also, Borghesi teaches or suggests that its graphic user interface provides access to an underlying workfile or datafile that is transferred between remote computers and does not indicate that fields of its graphic user interface are transferred. *See* Ex. 1002, 4:24–30 (“The present method accomplishes claim processing by controlling the electronic transfer of files between various remote computers, including those located at . . . body shops, . . . insurance company, and other terminals which may be used in an insurance processing environment”), 5:26–30 (“All the information related to a given claim is preferably contained in a single workfile such as an electronic datafile **24**”); 7:40–46 (“Each remote computer . . . provides an interface for a user to access the . . . workfile” that preferably is a “graphic user interface”).

Patent Owner also faults Petitioner for arguing that Borghesi teaches or suggests transmitting data, but claim 2 requires transmitting the first file, not data. PO Resp. 31 (citing Pet. 33). Patent Owner contends that Petitioner shifts from “filled GUI boxes” to “data” in arguing Borghesi teaches or suggests “filled identifiable fields.” *Id.* Petitioner replies that its Petition argues Borghesi teaches receiving first data into identifiable fields to create a first set of filled identifiable fields and transmitting all or some of that data. Pet. Reply 16–17 (citing Pet. 20–24; PO Resp. 30–32); *see also id.* at 3 (arguing Borghesi “disclose[s] inputting data into the fields of forms

and transmitting that information, along with attachments such as images, to recipients in the insurance industry”).

Claim 2 requires a first file generated by a first subset of the first and second filled identifiable fields, and as discussed above, Petitioner persuades us that it would have been obvious “to send only some (i.e., subsets) of the data to the insurance company, rather than all of the data, when not all of the data is needed by the insurance company to process the claim.” Pet. 17 (citing Clark Decl. ¶ 42). Petitioner, therefore, persuades us that transmitting a first file or a subset of data would have been obvious.

Accordingly, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 2 is unpatentable over Borghesi.

4. Dependent Claims 3, 4, 14, 16, 19–21, 26, and 30–33

Claim 3 recites the “method of claim 2, further comprising, before transmitting the first file, applying data compression to the first file.” Ex. 1001, 44:66–67. We find that the portion of Borghesi cited by Petitioner teaches that “text and graphics may be stored in compressed form.” Ex. 1002, 6:30–32; Pet. 10, 34–35 (citing *id.*); Clark Decl. ¶ 33. Furthermore, the ’129 patent states that “as will be readily appreciated by those skilled in the art, the text and image data comprising the file can be encoded and compressed in any manner well known in the art in order to minimize data storage and transmitting claimed requirements.” Ex. 1001, 13:64–14:1; see also Pet. 10, 34–35 (citing *id.*); Clark Decl. ¶ 33. We credit Paragraph 33 of the Clark Declaration, in which Dr. Clark opines that it would have been obvious to compress Borghesi’s workfile before transmitting to minimize transmitting requirements. Petitioner, therefore, persuades us that in view of Borghesi, claim 3 would have been obvious.

Claim 4 recites the “method of claim 2, further comprising, before transmitting the first file, applying security measures to the first file.” Ex. 1001, 45:1–3. We find that the portions of Borghesi cited by Petitioner show a “SECURITY” tab in Figure 15. Ex. 1002, 11:7–9, 15:31–34, Fig. 15; Pet. 10–11, 35–36 (citing *id.*; Ex. 1009, 3:16–17, 4:6–7); *see also* Clark Decl. ¶ 33 (discussing Ex. 1002, 11:7–9, 15:31–34; Ex. 1009, 3:16–17, 4:6–7). Petitioner also argues, and we agree, that one of ordinary skill in the art would have been “well aware of security measures that could be applied to a file” and cites Exhibit 1009 as an example of a “way to send a particular file from one computer to others securely.” Pet. 11; Clark Decl. ¶ 33 (citing Ex. 1009). We, thus, find that Borghesi teaches or suggests the limitations of claim 4.

Claim 14 recites the “method of claim 1, further comprising cross-referencing at least some of the filled identifiable fields with each other.” Ex. 1001, 45:44–46. We find that the relied upon portion of Borghesi teaches or suggests “when a user is creating a workfile for a specific claim the user begins by entering vehicle identification **220** into the workfile via the keyboard.” Ex. 1002, 12:14–16; Pet. 36 (citing *id.*). Petitioner argues that a person of ordinary skill in the art would understand that information entered into a workfile “could overlap for multiple sets of field data relating to the same case, such as in an initial and revised estimate of a car repair job prepared by a body shop.” Pet. 10 (citing Ex. 1002, 17:56–66; Clark Decl. ¶ 32). The cited portion of Borghesi describes a body shop emailing a preliminary computerized estimate and electronic images to an adjuster/appraiser and the body shop emailing another computer estimate and more images to the adjuster/appraiser. Ex. 1002, 17:54–66. In view of

this description of updated estimates, Petitioner persuades us that it would have been obvious to “cross-reference data or files between related cases or multiple sets of data or files for the same case, such as to increase efficiency in managing administrative data for claim processing tasks and to ensure that all data and images are organized and tracked with respect to a particular claimant.” Pet. 10 (citing Clark Decl. ¶ 32); *see also id.* at 36 n.9 (arguing similarly).

Claim 16 recites the “method of claim 1, wherein receiving the first data comprises receiving at least one image created by a scanner.” Ex. 1001, 45:50–51. We are persuaded by Petitioner’s argument for claim 16 (Pet. 36 (citing Ex. 1002, 6:54–60), and find that Borghesi teaches “receiving at least one image created by a scanner” because it discloses that its “preferred method uses a captured digitized image” and that the “image may be taken by an image digitizing device” that “may be embodied as . . . a regular photograph . . . scanned into the computer” (Ex. 1002, 6:54–60).

Claim 19 recites the “method of claim 1, further comprising generating a second file, wherein the second file comprises: a second subset of the first set of filled identifiable fields; and a second subset of the second set of filled identifiable fields; and transmitting the second file.” Ex. 1001, 45:60–46:1. Petitioner refers to its arguments regarding similar limitations in claims 1 and 2. Pet. 36–37. As discussed above, we find that Borghesi teaches or suggests that a first file is created when an appraiser sends two sets of estimates and images to the insurance company. *See* Pet. 17 (citing Ex. 1002, 18:41–46, Fig. 21; Clark Decl. ¶ 42). We agree with Petitioner that Borghesi teaches or suggests a “second file would be created, for example, where the insurance company processes the file and sends the

workfile to the salvage company.” Pet. 18 (citing Ex. 1002, 18:55–65; Clark Decl. ¶ 43). Petitioner also persuades us that it would have been obvious “to send only some (i.e., subsets) of the data to the salvage yard, rather than all of the data, when not all of the data is needed by the salvage yard (for example, omitting the initial repair estimates from the body shop).” *Id.* (citing Clark Decl. ¶ 43).

Claim 20 recites the “method of claim 19, further comprising applying security measures to the second file.” Ex. 1001, 46:2–3. Petitioner refers to its arguments regarding similar limitations found in claim 4. Pet. 37; *see also id.* at 10–11 (citing Ex. 1002, 11:7–9, 15:31–34, Fig. 15; Ex. 1009, 3:16–17, 4:6–7). For the reasons discussed above for claim 4, we find that Borghesi teaches “applying security measures to the second file,” as recited by claim 20.

Claim 21 depends from claim 19 and recites “wherein transmitting the second file comprises transmitting the second file to a clearing house.” Ex. 1001, 46:4–6. Petitioner refers to its arguments for claim 2. Pet. 37. Petitioner also persuades us that “at least the insurance company, the third party provider, and the salvage yard are clearing houses” and that “the wide area network service provider, such as AOL, acts as a clearinghouse.” *Id.* (citing Ex. 1002, 5:52–6:1). We, therefore, determine that claim 21 would have been obvious in view of Borghesi.

Claim 26 recites the “method of claim 19, further comprising: generating a third file, wherein the third file comprises: a third subset of the first set of filled identifiable fields; and a third subset of the second set of filled identifiable fields; and transmitting the third file.” Ex. 1001, 46:29–35. Petitioner refers to its arguments for claim 2. Pet. 37–38. We agree

with Petitioner that Borghesi teaches or suggests that a “third file is created, for example, when a third file is processed by the salvage yard and sent to the dismantlers.” *Id.* at 18 (citing Ex. 1002, 18:59–65; Clark Decl. ¶ 44). Petitioner also persuades us that it would have been obvious “to send only some (i.e., subsets) of the data to the dismantlers, rather than all of the data, when not all of the data is needed by the dismantlers to process the claim (for example, omitting the initial repair cost estimates from the body shop).” *Id.* (citing Clark Decl. ¶ 44). We, therefore, determine that Borghesi would have rendered obvious claim 26.

Claim 30 recites the “method of claim 26 further comprises at least some of the data in the third file are information that identifies the source of the first and second data.” Ex. 1001, 46:56–58. Petitioner refers to its arguments for claim 2. Pet. 38. Petitioner also persuades us that it would have been obvious “to identify the source of any information added to the workfile, such as a body shop identifying itself as the source of an email to an appraiser/adjuster.” Pet. 8 (citing Ex. 1002, 17:51–18:6; Clark Decl. ¶ 30). We, thus, determine that claim 30 would have been obvious in view of Borghesi.

Claim 31 recites the “method of claim 26 further comprising cross-referencing the second and third files with each other.” Ex. 1001, 46:59–60. Petitioner refers to its arguments for claim 14. Pet. 38; *see also id.* at 10 (citing Ex. 1002, 17:56–66; Clark Decl. ¶ 32). For the reasons discussed above in connection with claim 14, Petitioner persuades us that claim 31 is unpatentable over Borghesi.

Claim 32 recites the “method of claim 26, further comprising applying security measures to the third file.” Ex. 1001, 46:61–62. Petitioner refers to

its arguments for claim 4. Pet. 38; *see also id.* at 10–11 (citing Ex. 1002, 11:7–9, 15:31–34, Fig. 15; Ex. 1009, 3:16–17, 4:6–7). For the reasons discussed above for claim 4, Petitioner’s argument for claim 32 persuades us, and we find that Borghesi teaches “applying security measures to the third file.”

Claim 33 recites the “method of claim 26, further comprising applying data compression to the third file.” Ex. 1001, 46:63–64. Petitioner refers to its arguments for claim 3. Pet. 38–39; *see also id.* at 10, 34–35 (citing Ex. 1001, 13:64–14:1; Ex. 1002, 6:30–32); Clark Decl. ¶ 33. For the reasons discussed above in connection with claim 3, Petitioner persuades us that claim 33 is unpatentable over Borghesi.

Patent Owner presents no argument or evidence that Borghesi fails to teach or suggest the limitations of claims 3, 4, 14, 16, 19–21, 26, and 30–33 or that Borghesi fails to render obvious these claims, other than the arguments and evidence discussed above in connection with claims 1 and 2. *See also* Tr. 28:22–29:25 (Patent Owner’s counsel agreeing that its declarant testimony does not mention Borghesi and does not apply its proposed interpretation of “field” to Borghesi).

Accordingly, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 3, 4, 14, 16, 19–21, 26, and 30–33 are unpatentable over Borghesi.

C. Challenge Based on Beizer

1. Beizer (Ex. 1003)

Beizer “is directed to a method . . . for handling a high volume of documents, essentially electronically, by immediately optically scanning and capturing the image of the document upon receipt, and carrying out all

subsequent operations on the basis of the image of the scanned document.”

Ex. 1003, 3:24–29. Figure 1 of Beizer is reproduced below.

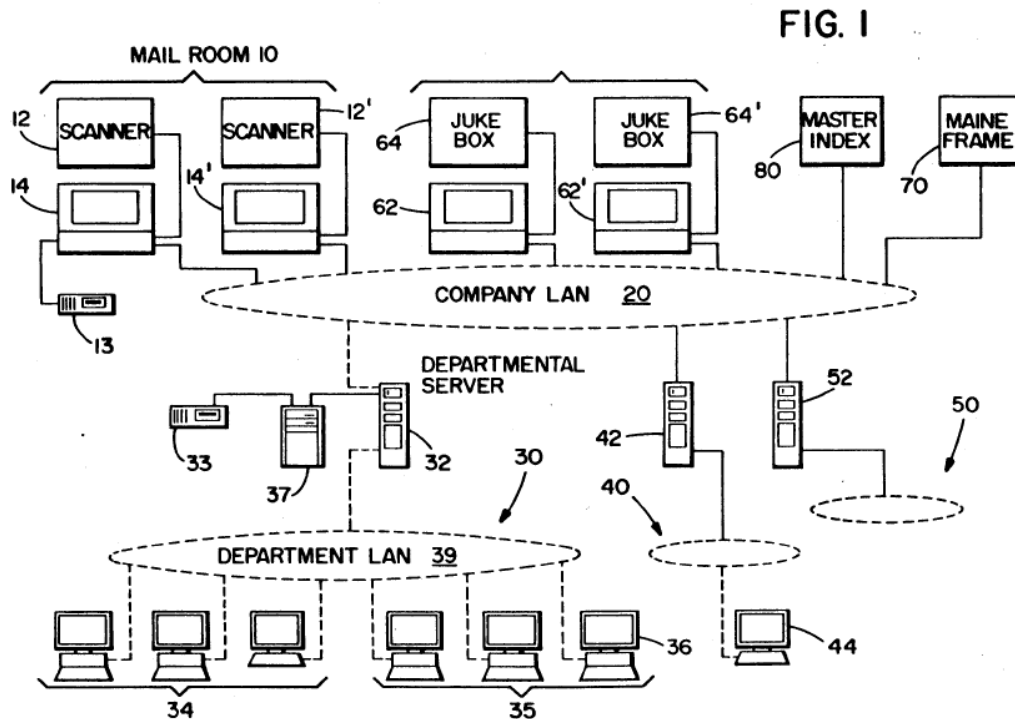


Figure 1 is a block diagram of a system for transaction processing high volumes of documents. *Id.* at 4:65–66. Documents are received in mailroom 10, where they are fed into scanners 12 to “convert the images of the documents into digital signals.” *Id.* at 5:19–23.

If the document has relevant information, the image of the document is directed to an optical character reader (“OCR”) where the information is extracted. *Id.* at 3:32–35. The electronic image of the document and the extracted information from the image are placed together as a “record” on a local area network (“LAN”). *Id.* at 3:37–39. Computer workstations for processing the image of the document and information from the OCR in order to complete a transaction are on the LAN. *Id.* at 3:45–59. A route program decides where to transmit the record, *i.e.*, the image of the

document, images of related documents, and data extracted by an OCR. *Id.* at 6:48–52. Figure 6 of Beizer is reproduced below.

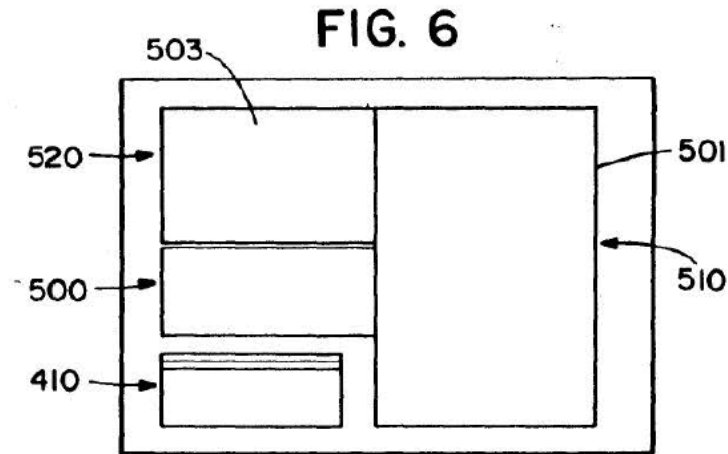


Figure 6 is a view of a screen of a workstation. *Id.* at 5:6. An operator can request a document at a workstation, and the workstation can display the document image on a right hand side of window 510 and form 417 with filled-in data on the left hand side of window 520. *Id.* at 9:43–57, Fig. 4 (steps 301, 303), Fig. 6. The workstation may decompress the image. *Id.* at 9:50–51. The workstation is programmed such that portion 501 of the document image is highlighted along with area 503 of the form into which information is to be inserted. *Id.* at 9:58–61. The workstation may be used only for data entry, and if so, the record is put in an out-box. *Id.* at 10:33–36, Fig. 4, steps 313, 315. “After each operation, the system checks to see if the operator has indicated that processing is complete.” *Id.* at 10:66–67.

A document “may be tagged for delivery to the archive or another workstation for processing.” *Id.* at 11:6–8. Beizer also states that it “provides a particularly useful means of transmitting visual type hospital records . . . to remote locations,” where images of medical records can be stored in an archive. *Id.* at 11:63–12:2.

2. Independent Claim 1

Petitioner contends that claim 1 is rendered obvious by Beizer with citations to its disclosure, a claim chart, and the Clark Declaration. Pet. 39–50.

As argued by Petitioner, we agree that Beizer teaches or suggests a method of processing digital data and images. Pet. 43 (citing Ex. 1003, 3:45–53). We find that Beizer describes “computer workstations” for processing an “image of the document, and any information from the OCR, in order to complete a transaction with a customer.” Ex. 1003, 3:46–49.

We also agree with Petitioner that Beizer teaches or suggests “receiving: first data into identifiable fields to create a first set of filled identifiable fields, wherein at least one of the first set of filled identifiable fields contains at least one image.” Pet. 40 (arguing a “first set would include the image”) (citing Ex. 1001, 1:46–53; Clark Decl. ¶ 47), 41 (arguing a “record includes first data in the form of scanned images that are received into identifiable fields to create a first set of filled identifiable fields) (citing Ex. 1003, 6:48–52, 9:49–64, 10:5–21; Clark Decl. ¶ 48), 43–45 (citing Ex. 1003, 6:48–50, 9:43–45, 9:49–64, 10:5–8, 10:13–21, Fig. 4). We find that Beizer teaches that “images of related documents and data extracted by an optical character reader (OCR) . . . together form the ‘record’” (Ex. 1003, 6:49–51) and “[i]f the document image **421** is selected, it is displayed as shown in Fig. **6**, wherein the image of the original document is on the right hand side in a window **510**” (*id.* at 9:51–54).

We further agree with Petitioner that Beizer teaches or suggests “receiving . . . second data into identifiable fields to create a second set of filled identifiable fields, wherein the second set of filled identifiable fields is

a nonempty set.” Pet. 40 (arguing “second set would include the text”) (citing Ex. 1003, 1:46–53; Clark Decl. ¶ 47), 41 (arguing the “record also includes second data filled in by OCR or an operator that is received into identifiable fields to create a second set of filled identifiable fields”) (citing Ex. 1003, 6:48–52, 9:49–10:21; Clark Decl. ¶ 48), 45–46 (citing Ex. 1003, 6:48–50, 9:49–10:2, 10:5–8, 10:13–21). We find that Beizer teaches that “images of related documents and data extracted by an optical character reader (OCR) . . . together form the ‘record’” (Ex. 1003, 6:49–51) and that “[i]f the document has been typed, the OCR would have automatically filled in the information on the form” (*id.* at 9:64–65).

We agree with Petitioner that Beizer teaches or suggests “wherein at least some of the first and second data are information that identifies the source of the first and second data.” Pet. 41 (arguing “[a]t least some of the first and second data are information that identifies the source of the first and second data, for example, the name of a patient”) (citing Ex. 1003, 10:13–21, 11:63–12:2), 46–47 (citing Ex. 1003, 10:13–21, 11:63–12:2). We find that Beizer teaches that “a supporting document can also be displayed in place of the original” (Ex. 1003, 10:14–15) and the “supporting document contains related information, for example, the patient[']s name” (*id.* at 10:20–21).

We also agree with Petitioner that Beizer teaches or suggests “presenting a graphic user interface (GUI) comprising a set of fields,” “wherein at least one of the fields of the GUI contains an image from the first set of filled identifiable fields,” and “wherein at least one of the fields of the GUI is filled with data from the second set of filled identifiable fields.” Pet. 41–42 (citing Ex. 1003, 9:49–64, 10:5–21, Figs. 5–8; Clark Decl. ¶ 49),

47–49 (citing Ex. 1003, 9:49–64, 10:5–8, 10:13–21, Figs. 5–8). We find that Figure 6 of Beizer teaches a graphic user interface and that Figure 6 shows an image of the original document in window 510 and form 417 with data in window 410. Ex. 1003, 9:49–57.

We further agree with Petitioner that Beizer teaches or suggests “receiving an indication to proceed with processing data; and in response to receiving the indication: using data from at least one field of the second set of filled identifiable fields to complete at least one field in at least one data bank.” Pet. 49–50 (citing Ex. 1003, 6:48–52, 11:6–8). We find that Beizer teaches that “[w]hen a document is sent to an out-box, it may be tagged for delivery to the archive.” Ex. 1003, 11:6–8.

Patent Owner responds that Beizer does not disclose “identifiable fields” and that a GUI box does not have the properties of an “identifiable field.” See PO Resp. 18, 25–30. As discussed in Section II.A., we do not adopt Patent Owner’s proposed interpretation of “fields” as “data comprised of ‘label data’ and ‘content data.’” Also, even under Patent Owner’s proposed construction, the claims do not exclude the identifiable fields or filled identifiable fields from being part of a GUI or additionally containing executable code. Beizer also does not indicate that its fields contain executable code.

Accordingly, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 1 is unpatentable over Beizer.

3. Dependent Claim 16

Claim 16 depends directly from claim 1 and recites “wherein receiving the first data comprises receiving at least one image created by a scanner.” Ex. 1001, 45:50–51. Petitioner contends that claim 16 is rendered

obvious by Beizer with citations to its disclosure, a claim chart, and the Clark Declaration. Pet. 39–42, 50–51. Petitioner asserts that Beizer teaches or suggests its limitations. *Id.* at 50–51 (citing Ex. 1003, 5:55–65)).

We agree with Petitioner and find that Beizer teaches or suggests “wherein receiving the first data comprises receiving at least one image created by a scanner” because the cited portion of Beizer states that “scanner and computer **14** may be programmed to search relevant portions . . . in the image to determine if there is typed or printed information” and “[i]f there is, it is sent to the OCR **13** for processing and the retrieved data is bundled with the image to form a record.” Ex. 1003, 5:55–65; *see also* Pet. 50–51 (citing *id.*), Ex. 1003, Fig. 2 steps 101–107 (showing steps for “Document Scanned and Identified,” “OCR,” and “Send Image & Associated Data”). Other than the arguments discussed above, Patent Owner presents no further argument or evidence that Beizer fails to teach or suggest receiving data comprising at least one image created by a scanner. *See* PO Resp. 23–27. Patent Owner does not provide arguments specifically for claim 16 and Beizer. *See* PO Resp.

In view of the foregoing, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 16 is unpatentable over Beizer.

IV. CONCLUSION

For the foregoing reasons, based on the full record before us, we determine that Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–4, 14, 16, 19–21, 26, and 30–33 of the ’129 patent

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are unpatentable over Borghesi, and claims 1 and 16 are unpatentable over Beizer.

V. ORDER

For the reasons given, it is:

ORDERED that claims 1–4, 14, 16, 19–21, 26, and 30–33 of U.S. Patent No. 7,694,129 B2 have been shown, by a preponderance of the evidence, to be unpatentable; and

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

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