

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

U.S. BANCORP,
Petitioner,

v.

SOLUTRAN, INC.,
Patent Owner.

Case CBM2014-00076
Patent 8,311,945 B2

Before MICHAEL W. KIM, BEVERLY M. BUNTING, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

DECISION
Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I. INTRODUCTION

U.S. Bancorp (“Petitioner”) filed a Petition (Paper 1, “Pet.”) on February 19, 2014, requesting a covered business method patent review of claims 1–6 of U.S. Patent No. 8,311,945 B2 (Ex. 1002, “the ’945 patent”). Solutran, Inc. (“Patent Owner”) filed a Patent Owner’s Preliminary Response (Paper 15, “Prelim. Resp.”) on May 27, 2014. We have jurisdiction under 35 U.S.C. § 324.¹

II. BACKGROUND

The standard for instituting a covered business method patent review is set forth in 35 U.S.C. § 324(a), which provides as follows:

THRESHOLD. – The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

35 U.S.C. § 324(a). Petitioner challenges the patentability of claims 1–6 (i.e., “the challenged claims”) under 35 U.S.C. § 101 and 35 U.S.C. § 103(a). Pet. 10. Upon consideration of the information presented in the Petition and Patent Owner’s Preliminary Response, we determine that Petitioner has demonstrated that it is more likely than not that the challenged claims are unpatentable. Pursuant to 35 U.S.C. § 324 and section 18(a) of

¹ See section 18(a) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011) (“AIA”).

the AIA, we institute a covered business method patent review as to claims 1–6 of the '945 patent on the grounds identified in the Order of this decision.

A. Related Proceedings

Petitioner asserts that the '945 patent is the subject of the following judicial matter: *Solutran, Inc. v. U.S. Bancorp and Elavon, Inc.*, Case No. 13-cv-2637, (D. Minn), filed September 25, 2013. Pet. 74.

B. The '945 Patent (Ex. 1002)

The '945 patent is directed to a system and method for processing paper checks and check transactions, in which check data is captured at point of sale and later a check image is captured remotely for subsequent matching of the check image with the check data. Ex. 1002, 1:13–17. Processing of the paper check entails transferring the check data independent of the check image, resulting in debiting of a consumer account and crediting of a merchant account prior to scanning and creating the check image (*id.* at 4:30–34) as shown in Figure 3 reproduced below:

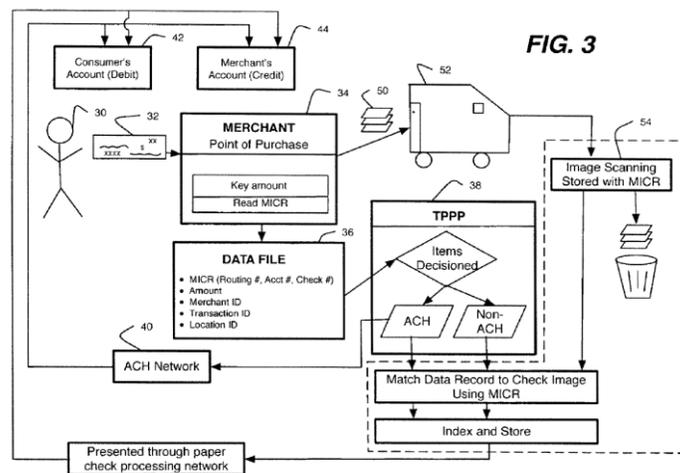


FIG. 3 illustrates the method of processing a check between a consumer and merchant using a third party processor.

Specifically, check data is captured at a point of purchase, and “is used to promptly process a deposit to the merchant’s account via a third party payment processor” (“TPPP”). *Id.* at 3:18–20. After the TPPP receives the check data, if determined to be eligible for processing via the Automated Clearing House (ACH), the check data passes “through the ACH network for processing and appropriate debiting of the consumer’s account **42** and ... crediting the merchant’s account **44**.” *Id.* at 5:37–42. Separately and subsequently, the paper check is transported physically from the merchant to the TPPP for scanning to create a check image that is stored in a digital image file. *Id.* at 3:23–28; 5:47–58.

C. Illustrative Claim

Petitioner challenges claims 1–6 of the ’945 patent. Of the challenged claims, claims 1, 4, and 5 are independent, and all are directed to a method for processing paper checks. Claim 1 is illustrative:

1. A method for processing paper checks, comprising:
 - a) electronically receiving a data file containing data captured at a merchant’s point of purchase, said data including an amount of a transaction associated with MICR information for each paper check, and said data file not including images of said checks;
 - b) after step a), crediting an account for the merchant;
 - c) after step b), receiving said paper checks and scanning said checks with a digital image scanner thereby creating digital images of said checks and, for each said check, associating said digital image with said check’s MICR information; and
 - d) comparing by a computer said digital images, with said data in the data file to find matches.

D. Prior Art

Petitioner relies on the following prior art references (Pet. 6):

Reference(s)	Patents/Printed Publications	Date	Exhibit
Figure 2 of the '945 patent	Figure 2 of U.S. Patent Number 8,311,945 B2	January 30, 2006	1002
Randle	U.S. Patent Publication No. US 2005/0071283 A1	March 31, 2005	1012

E. Asserted Grounds

Petitioner challenges claims 1–6 of the '945 patent based on the following statutory grounds. Pet. 10.

Claims Challenged	Basis	Reference(s)
1–6	§ 101	None
1–6	§ 103(a)	Figure 2 of the '945 patent and Randle

III. ANALYSIS

A. Standing to Seek Covered Business Method Patent Review

A “covered business method patent” is one that “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); *see also* 37 C.F.R. § 42.301(a) (2013). For the following reasons, we conclude the '945 patent meets the definition of a “[c]overed business method patent,” and Petitioner has standing to file a

petition for a covered business method patent review. *See* 37 C.F.R. § 42.301(a).

1. Petitioner Has Been Sued for Infringement of the '945 Patent

As discussed above in Section II-A, Petitioner represents it has been sued for infringement of the '945 patent. Pet. 74.

2. Claims 1–6 Are Directed to a Financial Product or Service

The legislative history of the AIA “explains that the definition of covered business method patent was drafted to encompass patents ‘claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.’” Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention, 77 Fed. Reg. 48,734, 48,735 (Aug. 14, 2012) (quoting 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011)). For purposes of determining whether a patent is eligible for covered business method patent review, we focus on the claims. *See id.* at 48,736 (responses to comments 4 and 8). A patent need have only one claim directed to a covered business method to be eligible for covered business method patent review. *See id.* In this case, we focus on claim 1 of the '945 patent.

Claim 1 of the '945 patent recites a method for processing paper checks. Ex. 1002, 10:54–67. Petitioner asserts that the processing of a paper check “clearly encompass[es] activities that are financial in nature.” Pet. 15. Moreover, the claim limitation of “crediting an account for the merchant” is an activity that is financial in nature. On these facts, we are persuaded that claim 1 satisfies the “financial product or service” component of the definition set forth in § 18(d)(1) of the AIA.

3. Exclusion for Technological Inventions

The definition of “covered business method patent” expressly excludes “patents for technological inventions.” AIA § 18(d)(1); *see also* 37 C.F.R. § 42.301(a) (2013). To determine whether a patent is for a technological invention, we consider on a case-by-case basis “whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution.” 37 C.F.R. § 42.301(b) (2013).²

Petitioner contends that the claims of the ’945 patent fail to disclose a technological invention because the claims include “only known generic hardware devices used in known ways and fail to include a technological feature that is novel and unobvious over the prior art.” Pet. 16–20. For example, Petitioner points to the claim features of “electronically receiving a data file”; ‘scanning checks with a digital image scanner thereby creating digital images of said checks’; and ‘comparing by a computer said digital images, with said data in the data file to find matches.’” *Id.* at 17, citing Ex. 1002 10:55–67. Moreover, Petitioner contends that because the claims of the ’945 patent do not contain a novel and unobvious technological feature, the claims do not solve a technical problem using a technical solution. *Id.* at 20–22. Patent Owner, in its Preliminary Response, does not dispute Petitioner’s standing to seek covered business method patent review.

We agree with Petitioner that the ’945 patent is not directed to a technological invention within the meaning of 37 C.F.R. § 42.301(b),

² For additional examples of “technological inventions” see Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763–64 (Aug. 14, 2012).

because checks, digital image scanners, and computers were known technologies in the prior art before the effective filing date of the '945 patent in 2006. In this context, we identify no limitation of claim 1 that represents a technological feature that is novel or unobvious over the prior art.

4. Conclusion

Based on the above, we are persuaded that the '945 patent is eligible for covered business method patent review.

B. *Claim Interpretation*

As a step in our analysis of whether to institute a review, we determine the meaning of the claims for purposes of this decision. In a covered business method review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764–66, (Aug. 14, 2012) (*Claim Construction*); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification “with reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner proposes express construction of several claim terms. Pet. 13. However, Petitioner does not indicate how these claim interpretations are relevant to the proposed grounds of unpatentability set forth in the

instant proceeding. Patent Owner does not address Petitioner's proposed claim construction; however, Patent Owner does proffer specific constructions for several claim terms, and points to the corresponding description from the Specification in support thereof. Prelim. Resp. 14–19. Like Petitioner, however, Patent Owner does not indicate how these claim interpretations are relevant to the proposed grounds of unpatentability set forth in the instant proceeding.

Having considered both Petitioner's and Patent Owner's proposed claim interpretations, we see no need to provide any express claim constructions at this time.

C. Non-Statutory Subject Matter

Petitioner challenges generally each claim of the '945 patent as failing to recite patentable subject matter under 35 U.S.C. § 101 because they fall within the judicially created exception encompassing “abstract ideas or mental processes.” Pet. 25–44. In the Preliminary Response, Patent Owner does not dispute Petitioner's challenge of the claims of the '945 patent based on 35 U.S.C. § 101. On the arguments and evidence presented, we are not persuaded that the challenged claims are directed to non-statutory subject matter.

Our analysis begins with the statute. 35 U.S.C. § 101 provides that a new and useful “process, machine, manufacture, or composition of matter” is eligible for patent protection. The Supreme Court has made clear that the test for patent eligibility under Section 101 is not amenable to bright-line categorical rules. *See Bilski v. Kappos*, 561 U.S. 593, 572–73 (2010). As

Petitioner indicates, there are three limited, judicially-created exceptions to the broad categories of patent-eligible subject matter in § 101: Laws of nature; natural phenomena; and abstract ideas. Pet. 23; *see Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012).

More recently, in *Alice Corporation Pty, Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014), the Supreme Court reiterated the framework set forth previously in *Mayo*, “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of [these] concepts.” Under *Alice*, the first step of such analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If determined that the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1297–8). In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294).

In the first step of determining whether a claim is directed to a patent-ineligible concept, the Supreme Court consistently begins its analysis by distilling the claim down to its basic, core concept. *See Alice Corporation Pty, Ltd. v. CLS Bank International*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*,

the use of a third party to mitigate settlement risk”); *Bilski v. Kappos*, 130 S. Ct. at 3231 (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter”); *Parker v. Flook*, 437 U.S. 584, 594-595 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values”); and *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals”).

After determining the basic, core concept, the Supreme Court then considers where the determined basic, core concept falls within a spectrum that extends from “abstract ideas” at one end to “technological processes” at the other. Claims that fall towards the abstract-idea end are generally not directed to patent-eligible subject matter under § 101, while those that fall towards the technological-process end are generally patent-eligible.

Compare Alice Corporation Pty, Ltd. v. CLS Bank International, 134 S. Ct. at 2356 with *Diamond v. Diehr*, 450 U.S. at 184. *See also Gottschalk v. Benson*, 409 U.S. at 64 (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals. The claims were not limited to any particular art or technology, to any particular apparatus or machinery, or to any particular end use”). The Supreme Court has determined that the abstract-idea end of the spectrum includes fundamental economic practices, *Alice Corp. Pty., Ltd. v. CLS Bank Int’l*, at 2357, *Bilski*

v. Kappos, 130 S. Ct. at 3231; mathematical formulas, *Parker v. Flook*, 437 U.S. at 594-595; and basic tools of scientific and technological work, *Gottschalk v. Benson*, 409 U.S. at 69. On the opposite technological-process end of the spectrum are physical and chemical processes, such as curing rubber, *Diamond v. Diehr*, 450 U.S. at 184, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour. *See Gottschalk v. Benson*, 409 U.S. at 69 (internal citations omitted).

1. Claims 1–3 and 6

Turning to the claims, Petitioner argues generally that the claim limitation of “shifting the step of scanning checks with a digital scanner from a merchant to another entity in a NACHA regulated back office conversion process” is an abstract idea, because it is not associated with any technological improvement in scanning, nor accompanied by any other limitation that would make the claim anything other than an abstract idea. Pet. 26. In particular, Petitioner argues “[o]ther than the claimed idea of a non-merchant entity performing check scanning, claim 1 includes nothing but mental process steps, insignificant extra-solution activity, and conventional computer hardware components for performing basic computer functions.” *Id.* at 28. According to Petitioner, this abstract idea of the non-merchant entity performing the scanning is not made patentable “by the addition of ‘well-understood, routine, conventional activity.’” *Id.*, citing *Mayo* 132 S. Ct. at 1298. Further, Petitioner argues that the limitation requiring that step (c) be performed after the merchant’s account is credited, represents “a disembodied abstract idea that is not patentable.” Pet. 32. With regards to claims 2, 3, and 6, all of which depend from claim 1 and

include additional limitations, Petitioner characterizes these additional limitations as “insignificant post-solution activity.” Pet. 33–35.

In determining whether a method or process claim recites an abstract idea, we must examine the claim as a whole. *Alice Corp. Pty., Ltd. v. CLS Bank Int’l*, at 2361, n. 3. On the record before us, Petitioner’s arguments are not persuasive because they are directed to each method step individually without accounting sufficiently for the claims as a whole. For when we mirror the first step of determining whether a claim is directed to a patent-ineligible concept, as set forth above, we find that the basic, core concept of independent claim 1 is a method of processing paper checks, which is more akin to a physical process than an abstract idea. Indeed, there is nothing immediately apparent about this basic, core concept that would indicate that it is directed to an abstract idea at all.

In reaching our determination, we are mindful of the Supreme Court’s implicit caution to maintain focus on the basic, core concept of the claim, particularly when the claim is dressed in technological language. Most instructive in this regard is *Parker v. Flook*, where the claim’s preamble indicated that the claim’s basic, core concept was ostensibly directed to a chemical process involving catalytic conversion of hydrocarbons. *Id.* at 594-595. The Supreme Court found, however, that when more closely scrutinized, the claim’s basic, core concept was actually calculating alarm limits—a mathematical algorithm, not a chemical process.

In further considering independent claim 1, we recognize that some fundamental economic practices are recited, such as “crediting an account for a merchant.” But application of the Supreme Court’s test cannot disembodied such recitations from the claim viewed as a whole—including its

recitation of other limitations such as “receiving said paper checks and scanning said checks with a digital scanner” and “comparing by a computer said digital images.” These are not fundamental economic practices, mathematical algorithms, or basic tools of scientific and technological work. The presence of isolated limitations that recite fundamental economic practices do not persuade us that the basic, core concept of independent claim 1—when all its limitations are considered collectively—is anything other than processing paper checks. Our analysis is no different for claims 2-3 and 6.

Given our determination that claims 1–3, and 6 are not directed to the patent-ineligible concept of an abstract idea, we need not consider the second step of whether the challenged claims lack an inventive concept.

Petitioner also argues that the challenged claims are unpatentable using the rationale provided by the preemption test. Pet. 37-39. Because we have determined that the challenged claims are not directed to a patent-ineligible abstract idea, we need not proceed with the preemption analysis for the reasons provided above. *See Accenture*, 728 F.3d at 1341.

2. Claims 4 and 5

Petitioner argues that independent claims 4 and 5 are similar to claim 1, and are likewise unpatentable because they recite an abstract idea. Pet. 39–44. Petitioner characterizes the additional recitations in claim 4 as “routine, post-solution activities associated with handling ACH and non-ACH presentment.” *Id.* at 40–41. With respect to claim 5, Petitioner argues that the additional recitations regarding the receipt of data from multiple merchants does not impart the necessary subject matter that is missing from claim 1 to make the claim patent eligible. *Id.* at 43.

Petitioner's arguments regarding claims 4 and 5 are likewise unpersuasive, because they are directed to each method step individually, and do not account sufficiently for the claims as a whole. Moreover, our own independent analysis does not dissuade us from the notion that the basic, core concept of claims 4 and 5 is processing paper checks, which is not an abstract idea for the reasons discussed above. On the present record, we determine that claims 4 and 5 are not directed to the patent-ineligible concept of an abstract idea. Given our determination that claims 4 and 5 are not directed to the patent-ineligible concept of an abstract idea, we need not consider whether the challenged claims lack an inventive concept.

3. Conclusion

Based on the record before us, Petitioner has not demonstrated that it is more likely than not that challenged claims 1–6 are unpatentable under 35 U.S.C. § 101.

D. Obviousness Based on Figure 2 of the '945 Patent and Randle

Petitioner contends that claims 1–6 of the '945 patent are unpatentable under 35 U.S.C. § 103 as obvious based on Figure 2 of the '945 patent and Randle. After considering the Petition and the Preliminary Response, we are persuaded that, based on the record before us, Petitioner has demonstrated that it is more likely than not that challenged claims 1–6 are obvious over Figure 2 of the '945 patent and Randle, for the reasons provided herein.

1. Overview of Figure 2 (Ex. 1002, fig. 2)

The specification of the '945 patent describes a prior art method of processing paper checks as shown in Figure 2 reproduced below:

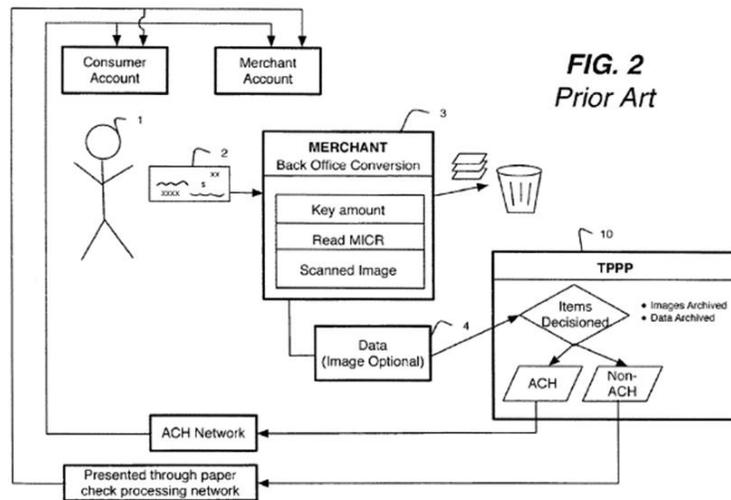


FIG. 2 is a schematic diagram of a prior art system for converting a check in a merchant's back office.

With the prior art system, a merchant scans checks in a back office conversion to generate a digital image file of each check. Ex. 1002, 3:1–4; 5:1–4. As shown in Figure 2, a check data file transferred to the TPPP via block 4 may *optionally* include the digital image file of the check. At block 10, the TPPP determines whether to direct the check data file through the ACH network or paper check processing network, both of which serve to debit a consumer account and credit a merchant account. The TPPP also archives the digital image file and the check data file.

2. Overview of Randle (Ex. 1012)

Randle is directed to electronic transaction processing, including “secure, accurate and verified imaging of financial instruments, check truncation and electronic funds payment, settlement and clearing.”

Ex. 1012, ¶ 2. Specifically, the system of Randle

allows for secure check truncation at the point of presentment or any other step in the item processing chain by creating a file containing an image of the check and a file containing transaction data related to the paper check, each of which can be transmitted together or separately in a network and subsequently uniquely matched and or integrated for check processing.

Id. ¶ 76. According to Randle, the deposit bank captures a check and related information by scanning to create an image of the check, which is in addition to creating a data file containing MICR data of the check. *Id.* ¶ 80. Specifically, “separate data file **10** and image plus data file **11** are separately manipulated and processed for settlement, payment and clearing.” *Id.* Noting that smaller size data files may be transferred more quickly than larger image files, Randle discloses that

the clearing house has a capability to timely notify financial institution participants of debit and credit obligations that will accrue upon actual receipt and processing of the imaged instruments upon conclusion of a periodic, or other, settlement . . . [a]fter clearing, the checks (in image/IRD form) are returned to payor banks **22** where they are separately processed and associated with individual payor's accounts, and returned, as data and/or a complete or partial image, to the payor in or accompanying an account statement **25**. The payee bank **21**, receiving funds, will assign the funds and credit the respective individual payee **3**.

Id.

3. Claim 1

Turning to claim 1, Petitioner contends that Figure 2 of the '945 patent discloses the limitations of step (a), step (b), and portions of step (c) of claim 1, and indicates where these limitations are disclosed by the drawing. *Id.* at 48–51. With regards to Randle, Petitioner contends that Randle discloses portions of step (c) and step (d), and sets forth where these

limitations are disclosed in Randle. *Id.* at 51–52. Acknowledging that Figure 2 and Randle do not expressly disclose performing step (c), i.e., scanning a paper check, after step (b), i.e. crediting the merchant account, Petitioner argues “this sequencing would be obvious to one of skill based on Figure 2 in view of Randle.” Pet. 52.

Specifically, Petitioner argues claim 1 is obvious because it merely reverses the sequence in which the steps of “[m]aking a digital image of a paper check and associating it with [] data regarding the check”, i.e., step (c), and “[c]rediting the merchant’s account,” i.e., step (b), are performed. *Id.* at 57. According to Petitioner, Figure 2 discloses that the merchant’s account can be credited without imaging the check at all, though imaging the check is optional, and Randle discloses that the check can be imaged before the merchant’s account is credited. *Id.* at 58–59. Thus, Petitioner reasons that the sequence between the steps of crediting the merchant’s account and imaging the check is based on “finite and well understood possibilities.” *Id.* Based on this understanding, Petitioner asserts that changing the order of steps from the prior art methods is *prima facie* obviousness. *Id.* (citing *Ex parte Rubin*, 128 USPQ 440 (BPAI 1959); *In re Burhans*, 154 F.2d 690 (CCPA 1946); *In re Gibson*, 39 F.2d 975 (CCPA 1930)). Changing the order of steps would not provide new or unexpected results, according to Petitioner, because one of skill in the art, as evidenced by prior art Figure 2 at the time of filing, would have readily recognized that a data file without the image may be sent for ACH processing, and Randle discusses the time-saving advantage of not having the merchant scan the check and associate the resulting image with the data file. *Id.* at 59.

On this record, we are persuaded by Petitioner's contentions that merely reversing the order of two steps is *prima facie* obvious, and that there is no new or unexpected result attained by changing the order between the scanning and crediting steps. *Id.* Specifically, Figure 2 suggests in blocks 3 and 4 that scanning and transmitting the scanned image to the TPPP is optional; and in block 10 the image is archived by the TPPP. Thus, based on these teachings, it follows that the check image would be scanned either by the merchant or the TPPP, that both techniques were known, and that it would have been within the abilities of one of ordinary skill to implement the techniques in any order, as two options is the epitome of a finite number of options. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 403 (2007) ("When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense"). On this record, we are persuaded that the known need to credit the merchant more quickly provides a sufficient rationale to carry out the admittedly known scanning and crediting limitations of independent claim 1 in any order that would expedite the process.

Accordingly, for the reasons explained above, we are persuaded Petitioner has demonstrated that it is more likely than not that claim 1 of the '945 patent is unpatentable as obvious over the combination of Figure 2 of the '945 patent and Randle.

4. Claims 2–6

Dependent claims 2, 3, and 6 each depend from claim 1 and include additional limitations. Likewise, independent claims 4 and 5 are similar to claim 1, and include additional limitations. Petitioner relies on the cited portions of Figure 2 of the '945 patent and Randle as satisfying the claim limitations of claims 2–6. Pet. 48-71. Petitioner argues that claims 2–6 are obvious for the reasons provided with respect to claim 1. *Id.*

For the reasons provided *supra* with respect to claim 1, we are persuaded similarly by Petitioner's contentions and supporting evidence concerning claims 2–6. Accordingly, we are persuaded that Petitioner has demonstrated that it is more likely than not that claims 2–6 of the '945 patent are unpatentable as obvious over the combination of Figure 2 of the '945 patent and Randle.

5. Conclusion

Petitioner has shown that it is more likely than not that claims 1–6 are unpatentable as obvious over the combination of Figure 2 of the '945 patent and Randle.

IV. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition demonstrates that it is more likely than not that Petitioner would prevail in establishing that claims 1-6 of the '945 patent are unpatentable based on 35 U.S.C. § 103(a). We also determine that the information presented in the Petition does not demonstrate that it is more likely than not that Petitioner would prevail in establishing that claims 1-6 of the '945 patent are unpatentable based on 35 U.S.C. § 101. The Board,

however, has not made a final determination, under 35 U.S.C. § 328(a), as to the patentability of any challenged claim.

V. ORDER

For the foregoing reasons, it is

Ordered that, pursuant to 35 U.S.C. § 324(a), a covered business method patent review of the '945 patent is hereby instituted as to the following claims and grounds: claims 1–6 as unpatentable under 35 U.S.C. § 103(a) as obvious over Figure 2 of the '945 patent and Randle;

FURTHER ORDERED that all other grounds raised in the Petition are denied for the reasons discussed; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 324(d) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial commences on the entry date of this decision.

CBM 2014-00076
Patent 8,311,945 B2

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