

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PNC BANK, N.A.,  
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,  
Patent Owner.

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IPR2021-01071  
Patent 10,482,432 B1

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Before KRISTEN L. DROESCH, TERRENCE W. McMILLIN, and  
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
*35 U.S.C. § 314*  
Granting Motions to Seal and Entering Protective Order  
*37 C.F.R. §§ 42.14, 42.54*

## I. INTRODUCTION

### A. *Background and Summary*

PNC Bank, N.A. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–23 of U.S. Patent No. 10,482,432 B1 (Ex. 1001, “the ’432 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 4 (“Petition” or “Pet.”). United Services Automobile Association (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Preliminary Response” or “Prelim. Resp.”). Pursuant to our authorization (*see* Paper 12, 2), Petitioner filed a Reply, Paper 13 (“Reply”), and Patent Owner filed a Sur-reply, Paper 17 (“Sur-reply”).<sup>1</sup>

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). After considering the Petition, the Preliminary Response, the Reply, the Sur-reply, and the evidence of record, we do not institute an *inter partes* review as to the challenged claims of the ’432 patent.

### B. *Related Proceedings*

The parties identify *United Services Automobile Association v. PNC Bank N.A.*, No. 2:20-CV-00319-JRG (E.D. Tex.) (“the District Court litigation”) as a related proceeding in which the ’432 patent is asserted. Pet. 2; Paper 6, 2. The parties also identify *United Services Automobile*

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<sup>1</sup> Papers 8, 13, and 17 were filed under seal, and Papers 11, 16, and 20, respectively, are the corresponding public versions. This Decision does not refer to any information that was redacted from the public documents.

IPR2021-01071  
Patent 10,482,432 B1

*Association v. PNC Bank N.A.*, No. 2:21-CV-00110-JRG (E.D. Tex.) as a related proceeding in which U.S. Patent No. 10,013,681, a parent of the '432 patent is asserted. Pet. 2; Paper 6, 2–3.

The parties further identify IPR2021-01074, an additional *inter partes* proceeding challenging the '432 patent, that was filed concurrently with this proceeding. Pet. 3; Paper 6, 3. The parties additionally identify post-grant proceedings involving patents in the '432 patent's family: CBM2019-00027 (institution denied (Paper 13)) (challenging U.S. 9,224,136); and IPR2020-01650 (institution denied (Paper 21)) and CBM2019-00028 (institution denied (Paper 14)) (challenging U.S. 10,013,681). Pet. 3; Paper 6, 3. And, although not identified by the parties, there are four other post-grant proceedings filed by Petitioner challenging patents in the '432 patent's family: IPR2021-01076 and IPR2021-01077 (challenging U.S. 10,621,559), IPR2021-01381 (challenging U.S. 10,013,681), and IPR2022-00075 (challenging U.S. 9,224,136).

### C. *The '432 Patent*

The '432 patent claims priority based on a series of continuation applications which began with the filing of U.S. Patent Application No. 11/591,247 (the "'247 application") (Ex. 1042) on October 31, 2006. Ex. 1001, code (63), 1:7–21. As these applications are continuations, the Specification of the '432 patent is substantively the same as the Specification of the earliest filed application in this chain, the '247 application. *Compare* Ex. 1001 (the '432 patent), *with* Ex. 1042 (the '247 application); *see also* Pet. 30 ("Oakes [Ex. 1038] is the patent that issued from the '247 application, and shares the specification with the '432 patent."); Prelim. Resp. 21 n.6 ("The Petitioner refers to the "'247

application,’ which is the first application in a chain of direct continuation applications leading to the ’432 patent and thus substantively identical to the ’432 patent specification.”). As related to the issues in this case, the text of the Specification of the ’432 patent (Exhibit 1001) is identical to the text of the ’247 application (Exhibit 1042) and Oakes (Exhibit 1038), the patent that issued from the ’247 application. Ex. 1038, code (21); *see also* Ex. 1001, 1:18–19.

The ’432 patent is titled “Systems and Methods for Remote Deposit of Checks.” Ex. 1001, code (54). The ’432 patent explains that “[c]hecks typically provide a safe and convenient method for an individual to purchase goods and/or services” but “receiving a check may put certain burdens on the payee, such as the time and effort required to deposit the check. For example, depositing a check typically involves going to a local bank branch and physically presenting the check to a bank teller.” *Id.* at 1:22–24, 2:1–6. In addition, traditional check deposit and clearing do not provide quick access to the funds from the check. *Id.* at 2:1–27. Thus, the ’432 patent explains, “there is a need for a convenient method of remotely depositing a check while enabling the payee to quickly access the funds from the check.” *Id.* at 2:27–30. The ’432 patent addresses this need by systems and methods for remote deposit of checks facilitated by a financial institution, whereby “[a] customer’s general purpose computer and image capture device may be leveraged to capture an image of a check and deliver the image to financial institution electronics” such that a “[check deposit] transaction can be automatically accomplished utilizing the images and data thus acquired.” *Id.*, code (57) (Abstract).

Figure 1 of the '432 patent is reproduced below.

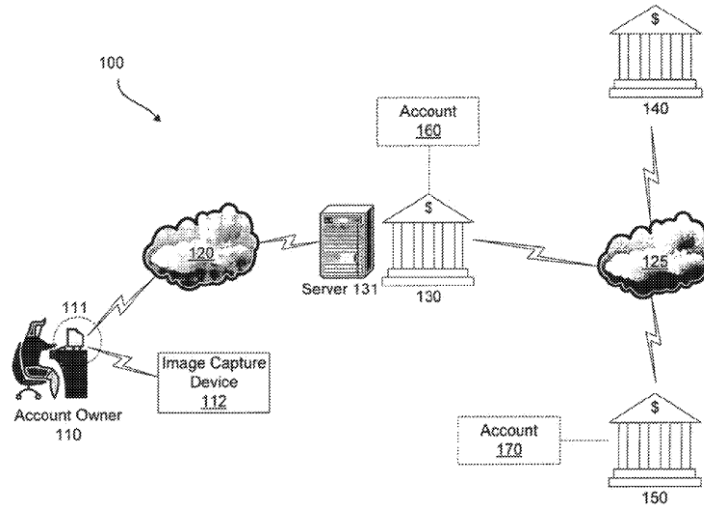


FIGURE 1

Figure 1 depicts a system in which the '432 patent's remote deposit systems and methods may be employed. *Id.* at 3:15–16, 3:46–47.

Figure 1 illustrates a system 100 including: (i) a “customer-controlled, general purpose computer 111” used by an account owner 110, e.g., a bank customer located at the customer’s private residence; (ii) an “image capture device 112 [that] may be communicatively coupled to the computer”; and (iii) financial institutions 130, 140, and 150, which are retail banks, investment banks, investment companies, or other type of entities capable of processing a transaction involving a negotiable instrument. *Id.* at 3:46–4:64, 5:4–14. Account owner 110 owns an account 160 held at financial institution 130. *Id.* at 5:26–31. When account owner 110 wishes to deposit a check into the account, “[a]ccount owner 110 may deposit the check into account 160 by converting the check into electronic data and sending the data to financial institution 130.” *Id.* at 5:62–65. “[A]ccount owner 110 may convert the check into a digital image by scanning the front

and/or back of the check using image capture device 112.” *Id.* at 6:4–7. Account owner 110 then sends the image to financial institution 130. *Id.* at 6:6–9. Upon receiving the image, financial institution 130 communicates with other financial institutions (e.g., 140 and 150) to clear the check and credit the funds to account 160. *Id.* at 6:12–49.

Figure 2 of the '432 patent is reproduced below.

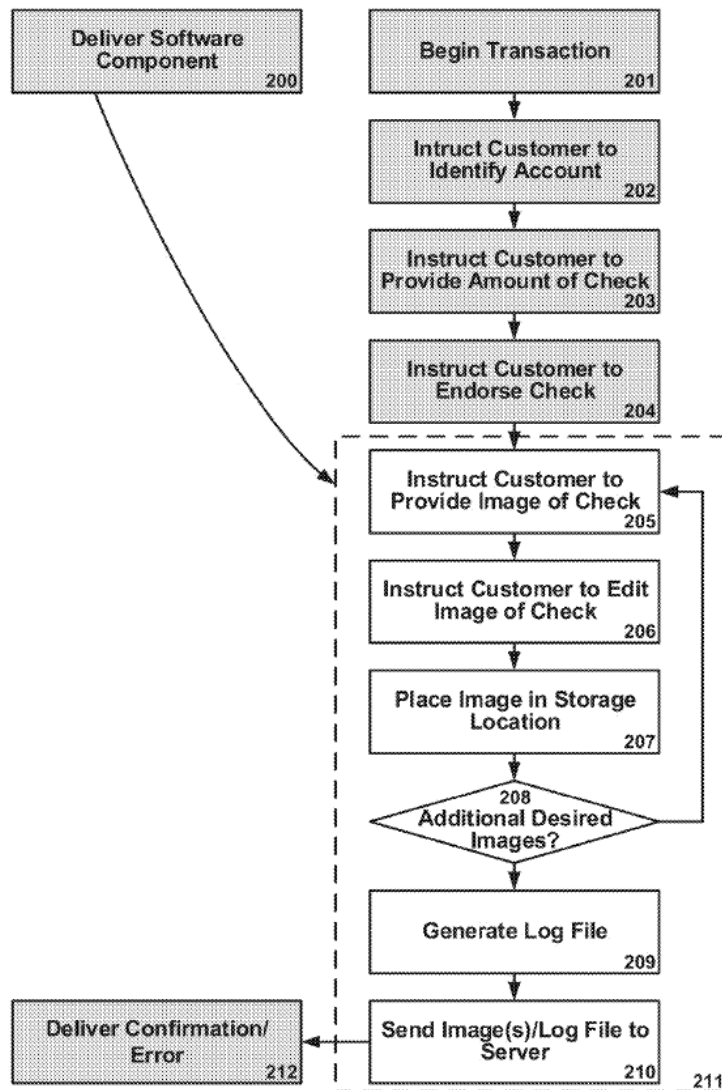


FIGURE 2

Figure 2 illustrates a method for facilitating deposit of a check from the customer-controlled general purpose computer. *Id.* at 3:17–19, 6:50–53.

The '432 patent explains that the steps in Figure 2 “may be viewed as performed by a server computer associated with a financial institution, in conjunction with a software component that operates from a customer-controlled general purpose computer.” *Id.* at 6:52–58. More particularly, “the darker boxes [in Figure 2] indicate steps that are performed by the server, for example by delivering information to the user through the user’s browser application,” while “[the] lighter boxes inside 211 indicate steps that are performed by the software component, as it executes on the customer computer,” with “alternative configurations . . . readily achievable by moving functions from server to software component or vice-versa.” *Id.* at 6:59–7:2. As shown in Figure 2, after downloading or otherwise accepting a software component (e.g., from a financial institution’s server) to be installed on the customer-controlled general purpose computer 200, the customer has the capability to make deposits from his general purpose computer. *Id.* at 7:3–42. After identifying a deposit account, identifying an amount of a check or other negotiable instrument the customer wishes to deposit, and endorsing the check (steps 201–204 in Figure 2), “[t]he customer may next be instructed to provide an image of a front side of a check 205, for example, by using an image capture device.” *Id.* at 7:47–8:7. For example, “the customer may be instructed to place the check face down on a flatbed scanner, and may further be instructed as to the location and orientation of the check on the scanner,” or “the customer is instructed to take a digital photograph of the check using a digital camera . . . [and] instructed as to the position and orientation of the check, lighting, angle of

camera, distance and focal length (zoom) of camera, and so forth.” *Id.* at 8:5–21. The software component on the customer’s device may guide the customer by providing a graphical illustration of how the customer should provide the image. *Id.*

The software component on the customer’s device “may next cause the image of the check to be presented to the customer for editing, e.g. by asking the customer to crop and/or rotate the check image to a predetermined orientation 206.” *Id.* at 8:45–48. The customer may also be asked to indicate the bottom right corner of the check image, and the image may be cropped to contain only the check image, thereby removing a portion of the originally obtained image. *Id.* at 8:51–55. After obtaining and storing (in a storage location, step 207) images of front and back sides of the check, a log file may be generated 209 to collect data for processing or troubleshooting the deposit transaction. *Id.* at 8:56–64. Once the desired images are collected and edited, they are delivered to the bank server for processing the deposit 210. *Id.* at 9:1–3. If the bank’s (or other financial institution’s) server determines that the delivered images and any corresponding data are sufficient to go forward with the deposit, the customer’s account is provisionally credited, and a confirmation page is delivered to the customer via customer's browser application 212. *Id.* at 9:3–11.

#### *D. Challenged Claims*

Petitioner challenges all 23 claims of the ’432 patent. Pet. 5. Claim 1 is the only independent claim. Ex. 1001, 14:23–48. Claim 1 recites:



1. A system comprising:
  - a customer's mobile device including a downloaded app, the downloaded app provided by a bank to control check deposit by causing the customer's mobile device to perform:
    - instructing the customer to have a digital camera take a photo of a check;
    - giving an instruction to assist the customer in placing the digital camera at a proper distance away from the check for taking the photo;
    - presenting the photo of the check to the customer after the photo is taken with the digital camera;
    - using a wireless network, transmitting a copy of the photo from the customer's mobile device and submitting the check for mobile check deposit in the bank after presenting the photo of the check to the customer; and
  - a bank computer programmed to update a balance of an account to reflect an amount of the check submitted for mobile check deposit by the customer's mobile device;
- wherein the downloaded app causes the customer's mobile device to perform additional steps including:
  - confirming that the mobile check deposit can go forward after optical character recognition is performed on the check in the photo; and
  - checking for errors before the submitting step.

*Id.* Our decision not to institute trial is based on our analysis of the arguments and evidence related to independent claim 1.

*E. The Asserted Ground*

Petitioner challenges claims 1–23 of the '432 patent based on the ground set forth in the table below.

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–23	103	Oakes <sup>2</sup> , Roach <sup>3</sup>

Pet. 5. Petitioner supports its assertions of unpatentability of the challenged claims of the '432 patent with the Declaration of Brian Noble, Ph.D. (Ex. 1002).

## II. ANALYSIS

### A. *Legal Standards*

A patent claim is unpatentable as obvious if the differences between the claimed subject matter 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). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Petitioner cannot satisfy its

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<sup>2</sup> US 7,873,200 B1, filed Oct. 31, 2006, issued Jan. 18, 2011 (Ex. 1038).

<sup>3</sup> US 2013/0155474 A1, published June 20, 2013 (Ex. 1040).

burden of proving obviousness by employing “mere conclusory statements.”  
*In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

*B. Level of Ordinary Skill in the Art*

With regard to the level of ordinary skill in the art, Petitioner contends that:

A person of ordinary skill in the relevant field or art (“POSITA”) at relevant times (2006–2017) of the ’432 patent would have had a Bachelor’s degree in computer science, computer engineering, electrical engineering, or equivalent field, and two years of experience in software development and programming in the area of image capturing/scanning technology involving transferring and processing of image data to and at a server. Less work experience may be compensated by a higher level of education, and vice versa.

Pet. 12 (citing Ex. 1002 ¶ 38). Patent Owner notes that “[f]or the purposes of this Preliminary Response only, [Patent Owner] applies the level of skill in the art proposed by Petitioner.” Prelim. Resp. 18. For purposes of this decision, we adopt Petitioner’s definition of the level of ordinary skill in the art because it is consistent with the ’432 patent and the asserted art.

*C. Obviousness Ground Based on Oakes and Roach*

Petitioner contends that the subject matter of claims 1–23 would have been obvious over the combination of Oakes and Roach. Pet. 5, 30–93. Petitioner argues that Oakes and Roach are prior art because the claims of the ’432 patent are not entitled to a priority date earlier than July 28, 2017. *Id.* at 12–30. In support of this contention, Petitioner argues that the specification of the ’247 application (Ex. 1042), the ultimate parent application of the ’432 patent, does not provide written description support for (1) a “mobile device” that has an integrated “digital camera” and (2)

“checking for errors before the submitting step” as recited in the claim 1 of the ’432 patent. *Id.* Patent Owner contends that Petitioner fails to establish a reasonable likelihood of succeeding on this challenge because Petitioner fails to sufficiently show that Oakes and Roach qualify as prior art. Prelim. Resp. 22–58.

Having reviewed the parties’ arguments and evidence, we determine that Petitioner has not demonstrated a reasonable likelihood that it will prevail in showing that Oakes and Roach are prior art,<sup>4</sup> and as a result, Petitioner fails to sufficiently show that any claim would have been unpatentable over Oakes and Roach.

*1. The ’432 Patent’s Priority Claim*

The application that led to the ’432 patent was filed on May 18, 2018. Ex. 1001, code (22). As noted above, the ’432 patent claims priority through a series of continuation applications back to U.S. Application No. 11/591,247 (“the 247 application”). *Id.* at code (63). The parties agree that the Specification of the ’432 patent is substantively identical to the specification of the ’247 application. Pet. 30; Prelim. Resp. 21 n.6.

The ’247 application was filed on October 31, 2006, and it issued as Oakes on January 18, 2011. Ex. 1038, codes (22), (45). Roach was published on June 20, 2013, and it claims the benefit of an application filed

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<sup>4</sup> “In an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ . . . and that burden never shifts to the patentee.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (quoting 35 U.S.C. § 316(e)). Although the burden of production can shift to Patent Owner (*id.* at 1380), Petitioner has the ultimate burden to persuade us that Oakes and Roach are prior art to the ’432 patent (*see id.* at 1378).

on December 30, 2008. Ex. 1040, codes (22), (43), (63). Thus, Oakes and Roach are prior art only if the '432 patent is not entitled to claim priority to the '247 application. *See* Pet. 4–5.

## 2. *The Parties' Dispute*

Petitioner contends that the '432 patent's priority claim to the '247 application is improper because the '247 application does not provide written description support for the claims of the '432 patent. Pet. 1, 12–13. Specifically, Petitioner asserts the Specification of the '432 patent does not provide written description support for: (1) “a mobile device with an integrated digital camera” (*id.* at 15–27)<sup>5</sup> and (2) “checking for errors before the submitting step” (*id.* at 27–30). Petitioner contends that “[t]his lack of written description support is fatal to the priority claim of all claims of the '432 patent.” *Id.* at 16.

In response, Patent Owner asserts that Petitioner “fails to put forth credible evidence supporting its assertion that the '432 patent claims lack support in the original specification.” Prelim. Resp. 23. Patent Owner contends that the '247 application provides written description support for: (1) “mobile device with an integrated digital camera” (*id.* at 27–52) and (2) “checking for errors before submitting the check” (*id.* at 52–58). From this, Patent Owner submits that Petitioner fails to sufficiently show that Oakes

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<sup>5</sup> Petitioner relies on Patent Owner's allegations in the District Court litigation that “claim 1 is broad enough to read on a mobile device with an integrated digital camera” based on Patent Owner's “construction and application of the terms ‘mobile device’ and ‘digital camera’” as recited in claim 1. *See* Pet. 10–13, 15.

and Roach qualify as prior art to the '432 patent and, thus, that institution should be denied. *Id.* at 22–23.

3. *Analysis of Written Description Support*

a) *Principles of Law*

“It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008). “To satisfy the written description requirement [in § 112,] the disclosure of the prior application must ‘convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention.’” *Id.* (alteration in original) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)).

“[T]he hallmark of written description is disclosure.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The sufficiency of written description support is based on “an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.* “Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Id.* “The level of detail required to satisfy the written description requirement” necessarily “varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* The invention need not be described *in haec verba*, but a disclosure that merely renders obvious the claims does not provide adequate written description support. *Id.* at 1352.

The written description requirement “guards against the inventor’s overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.” *Vas-Cath*, 935 F.2d at 1561; *see also Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1323 (Fed. Cir. 2002) (“[A] broad claim is invalid when the entirety of the specification clearly indicates that the invention is of a much narrower scope.”). However, “[a] claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language.” *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001) (“An applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention.”); *see also Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1582 n.7 (Fed. Cir. 1996) (“If [the applicant] did not consider the precise location of the lockout to be an element of his invention, he was free to draft [his claim] broadly (within the limits imposed by the prior art) to exclude the lockout’s exact location as a limitation of the claimed invention. Such a claim would not be unsupported by the specification even though it would be literally infringed by undisclosed embodiments.” (citations omitted)).

b) “a mobile device with an integrated digital camera”

We begin our analysis by clarifying the issue presented with respect to Petitioner’s first argument.<sup>6</sup> Petitioner contends the ’247 application does not provide sufficient written description support for claim 1, because claim 1 is broad enough to include “a mobile device with an integrated digital camera”<sup>7</sup> and such a device is not described in the ’247 application. *See* Pet. 15–27. Notably, elsewhere, Petitioner affirmatively contends that the ’247 application discloses the relevant limitations of claim 1 (i.e., “a customer’s mobile device” and “digital camera”)—in fact, Petitioner’s obviousness argument is predicated on this contention. *See* Pet. 33, 36–37 (arguing that Oakes, the patent that issued from the ’247 application, alone teaches these limitations). Accordingly, for its written description argument, Petitioner takes issue only with the scope of the claim. *See id.* at 17–18, 36–37 (addressing the interplay between the written description and obviousness arguments). Thus, this case is unlike many written description disputes, in which a party contends that the priority document fails to include a disclosure of a claim limitation. Here, the issue is specifically whether the claim is overbroad (and thus lacking in written description support) because it allows the digital camera to be integrated into the mobile device.

Petitioner begins its argument with two premises, which we assume *arguendo* to be true for purposes of this Decision. First, Petitioner contends

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<sup>6</sup> We consider only the arguments presented in the Petition. Although we reject these arguments, our Decision should not be construed as an independent assessment of whether the ’247 application provides written description support for the invention claimed in the ’432 patent.

<sup>7</sup> Claim 1 does not include this language; it recites a “customer’s mobile device” and a “digital camera.” Ex. 1001, 14:23–48.



that, “[f]or purposes of this IPR proceeding,” we should understand claim 1 to be broad enough to include a mobile device with an integrated digital camera. Pet. 10–13, 15; *see also* Ex. 1054 (District Court’s Claim Construction Order), 14–20 (construing the claim language in this manner). Second, Petitioner contends that the ’247 application—to which the ’432 patent claims priority—does not describe a mobile device with an integrated digital camera. Pet. 16; *see also id.* at 16–27 (analysis supporting assertion); *cf.* Prelim. Resp. 28–29 (appearing to agree that the document does not “expressly stat[e] that the two may be in a single housing”).

But, even accepting these premises, we disagree with the conclusion Petitioner asks us to draw from them. In particular, Petitioner appears to contend that we should find that the ’247 application does not provide written description support for claim 1 *merely because* the scope of the claim includes a configuration that is not expressly described in that document. *See* Pet. 15–16, 21. But this reflects a misunderstanding of the law—a claim *can* be broader than the embodiments disclosed. *See, e.g., Rextord*, 274 F.3d at 1344 (“An applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention.”); *see also Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1582 n.7 (Fed. Cir. 1996) (noting that a claim may be “literally infringed by undisclosed embodiments” and yet sufficiently supported); *Application of Smythe*, 480 F.2d 1376, 1384 (C.C.P.A. 1973) (“We cannot agree with the broad proposition . . . that in every case where the description of the invention in the specification is narrower than that in the claim there has been a failure to fulfill the description requirement in section 112.”).

There are situations where a claim’s breadth results in a lack of written description support, but Petitioner fails to show that such a situation is present here. In its argument, Petitioner primarily relies on *Reckitt*, but this case is unavailing. *See* Pet. 15–17, 21, 37 (citing *Reckitt Benckiser LLC v. Ansell Healthcare Products LLC*, IPR2017-00063, Paper 38 (Jan. 30, 2018)). First, *Reckitt* is a non-precedential Board decision, which is not binding on this panel.<sup>8</sup> Second, and perhaps more importantly, the case is readily distinguishable on its facts. *See* Prelim. Resp. 27–28, 39–40 (distinguishing *Reckitt*). In particular, in *Reckitt*, the panel found that claims lacking a pre-vulcanization requirement lacked written description support in the priority document, noting that “pre-vulcanization [was] not some ancillary feature *but rather the very heart of the invention.*” *Reckitt*, IPR2017-00063, Paper 38 at 12, 14–15 (emphasis added). However, “Petitioner identifies nothing whatsoever in the ’247 application suggesting that it is important—much less the ‘very heart of the invention’—that the described image capture device be in a housing entirely separate from the described general purpose computer.” Prelim. Resp. 28–29; *see also id.* at 39. In fact, the Petition identifies (and we perceive) no reason why the relative location of the general purpose computer and the image capture device is even *relevant* to the invention described in the ’247 application.

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<sup>8</sup> In addition, written description is an “intensively fact-oriented” inquiry, and consequently, another case, with its “necessarily varied facts,” is highly unlikely to “control[] the resolution of the written description issue in this case.” *Indivior UK Ltd. v. Dr. Reddy’s Lab ’ys S.A.*, 18 F.4th 1323, 1329 (Fed. Cir. 2021).

Stepping back, the '247 application describes an invention for remote deposit of a check using a general purpose computer (such as a laptop) that receives an image of the check from an associated image capture device (such as a digital camera). *E.g.*, Ex. 1042 ¶¶ 7–8, 20, 25, 32, 43. What is important to the invention is that the image capture device and general purpose computer are communicatively coupled, not their relative location. *See, e.g., id.; accord* Prelim. Resp. 29–30. Moreover, the '247 application does not limit its invention to only those remote deposits performed using a general purpose computer that is *separate* from an image capture device.<sup>9</sup> Indeed, the '247 application broadly describes the image capture device, noting it can be “a scanner or digital camera” or “other image capture apparatus.” Ex. 1042 ¶¶ 8, 25. It also indicates that the general purpose computer and image capture device are “customer-controlled” and “electronics that today’s consumers actually own or can easily acquire.” *Id.* ¶¶ 20–22. In light of this disclosure, we find that a person of ordinary skill in the art would have understood the '247 application to describe an invention that is agnostic to whether the mobile device and image capture device are separate or integrated. *See also In re Rasmussen*, 650 F.2d 1212, 1215 (C.C.P.A. 1981) (explaining that claims with generic step of “adheringly applying” one layer to an adjacent layer satisfied the written

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<sup>9</sup> Petitioner contends that a person of ordinary skill in the art would have understood that certain aspects of the disclosure would not be necessary if the image capture device were integrated into the general purpose computer. *See* Pet. 18–19 (citing Ex. 1042 ¶¶ 8, 25, 43–44, 75; Ex. 1002 ¶¶ 43, 45–47). Even if Petitioner were correct, those passages simply provide a discussion of an embodiment where these components are separate. They do not show that the invention *requires* the components to be separate.

description requirement because “one skilled in the art who read [the] specification would understand that it is unimportant how the layers are adhered, so long as they are adhered”).

Petitioner’s reliance on *LizardTech*, *Tronzo*, and *ICU Medical* is misplaced. See Pet. 22, 26–27 (citing *ICU Med., Inc. v. Alaris Med. Sys.*, 558 F.3d 1368 (Fed. Cir. 2009); *LizardTech*, 424 F.3d 1336; *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998)). As the Federal Circuit explained, “[i]n each of those cases, the specification unambiguously limited the scope of the invention.” *Crown Packaging Technology, Inc. v. Ball Metal Beverage Container Corp.*, 635 F.3d 1373, 1382 (Fed. Cir. 2011). However, Petitioner provides (and we perceive) no justification for coming to a similar conclusion here. Petitioner also cites to *Anascape*, but that case is similarly distinguishable. See Pet. 14, 21 (citing *Anascape, Ltd. v. Nintendo of Am. Inc.*, 601 F.3d 1333, 1335 (Fed. Cir. 2010)); *Anascape*, 601 F.3d at 1336–37 (“Nintendo counts over twenty explicit statements that the invention is directed to a single input member that is operable in six degrees of freedom,” and the patent “stresses the advantages of using a single input member operable in six degrees of freedom.”).

Finally, we disagree with Petitioner’s genus-species analysis, which effectively reorganizes the same considerations into a different framework.<sup>10</sup> See Pet. 21–24. According to Petitioner, the device limitation is a genus “that includes (1) a mobile device separate from a digital camera and (2) a

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<sup>10</sup> We query whether the genus-species framework is appropriate in this situation—where there are only two binary alternatives (i.e., the components are integrated or they are not)—but, for purposes of this discussion, we have assumed *arguendo* that the genus-species analysis is applicable.

mobile device with an integrated digital camera.” *Id.* at 22. Petitioner acknowledges that the ’247 application discloses the former, and we find that to be representative of both alternatives, given the ’247 application’s disclosure, as discussed above. *See, e.g.*, Ex. 1042 ¶¶ 7–8, 20, 25, 32, 43. We also find that a person of ordinary skill in the art could readily recognize the single non-enumerated species from the ’247 application—indeed, as Patent Owner notes, “one would only need to think of the *only other configuration of mobile device* in the market.” Prelim. Resp. 47. Further, there is no evidence that the other, non-enumerated species was in any way unpredictable. *Cf.* Pet. 26 (arguing instead that an ordinary artisan “would not have expected” the non-enumerated species to “have performed as well”). As a result, the general predictability of the electrical arts further supports our finding that disclosure of one of the two species sufficiently discloses the genus on these particular facts. *Cf. Bilstad v. Wakalopulos*, 386 F.3d 1116, 1125 (Fed. Cir. 2004) (“If the difference between members of the group is such that the person skilled in the art would not readily discern that other members of the genus would perform similarly to the disclosed members, i.e., if the art is unpredictable, then disclosure of more species is necessary to adequately show possession of the entire genus.”).

We have considered Dr. Noble’s testimony, but it suffers from the same deficiencies as Petitioner’s arguments. *See* Ex. 1002 ¶¶ 42–59. Moreover, in our view, Dr. Noble does not sufficiently explain his conclusions regarding what a person of ordinary skill would have understood the inventor of the ’247 application to possess (or not possess), and accordingly, we assign little weight to that testimony. *E.g., id.* ¶¶ 47, 53, 55; *see TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1358 (Fed.

Cir. 2019) (“Conclusory expert testimony does not qualify as substantial evidence.”).

In sum, even assuming, as we have, that the claim is broad enough to encompass a mobile device with an integrated image capture device and that the ’247 application does not expressly describe such a device, we do not agree with these arguments raised in the Petition alleging that the ’247 application fails to provide written description support for the claims.

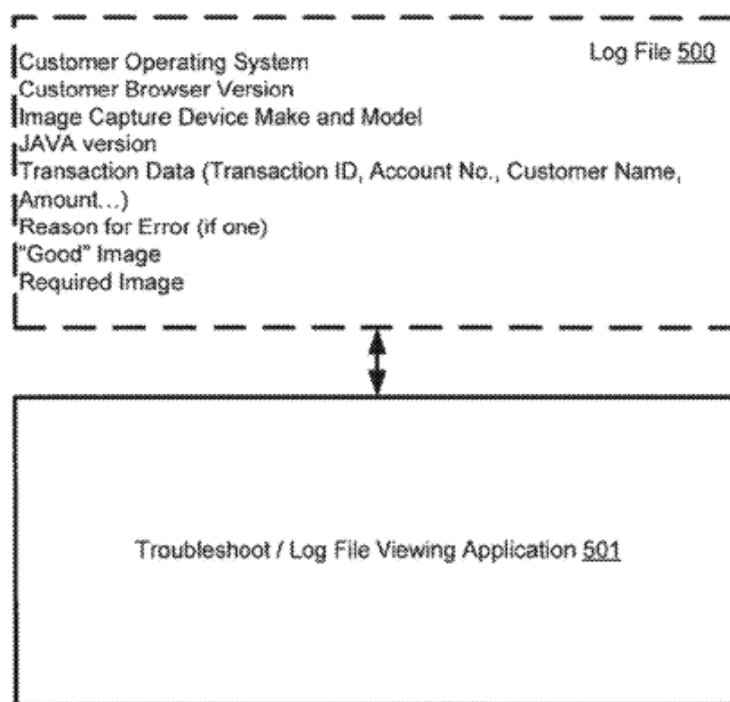
*c) “checking for errors before the submitting step”*

Petitioner also argues that the ’247 application does not provide written description support for “checking for errors before the submitting step” as recited in claim 1 of the ’432 patent. *See* Pet. 27–30. Independent claim 1 recites “[a] system comprising: a customer’s mobile device including a downloaded app . . . using a wireless network, transmitting a copy of the photo from the customer’s mobile device and submitting the check for mobile check deposit in the bank after presenting the photo of the check to the customer; and . . . **checking for errors before the submitting step.**” Ex. 1001, 14:23–48 (emphasis added). Specifically, Petitioner argues that “the ’247 application consistently describes error checking as being performed by a server.” *Id.* at 28. In support of this argument, Petitioner cites to Figure 3 and the related description. *Id.* at 28–29. With regard to Figure 3, the Specification of the ’432 patent (and the ’247 application) states, “[t]he method of FIG. 3 is designed to complement that of FIG. 2 and to illustrate exemplary steps that may be carried out by a server or other electronics operated by a financial institution before, during, and after the various steps of FIG. 2 are carried out.” Ex. 1001, 9:18–22; Ex. 1042 ¶ 50.

Patent Owner argues that this limitation is supported by portions of the Specification, “including description of error-checking that can be performed on either the mobile device before submitting the check for deposit or on the bank server, as well as an express example of the mobile device checking for errors before submitting the check for deposit.” Prelim. Resp. 53. Patent Owner argues that “Petitioner does not dispute that the figures and corresponding text describe various ways to check for errors, but argues that the error-checking steps are described as occurring on the server (i.e., in darker boxes [of Figure 2 of the ’432 patent]), rather than on the customer device.” Prelim. Resp. 54 (citing Pet. 28–29). Patent Owner relies on the following statement to show that the Specification provides for these error checking functions to be performed on the customer’s device: “[t]hose of skill will recognize that alternative configurations are readily achievable by moving functions from the server to software component [on the customer computer] or vice-versa.” Ex. 1001, 6:67–72; Ex. 1042 ¶ 36. Patent Owner interprets this statement as “[h]ere, the specification describes various functions performed during the check deposit process—including checking for errors—and expressly states that these functions may be performed on the customer device or on the server, with the specific assignments in the figures reflecting only an exemplary embodiment.” Prelim. Resp. 55. And, Patent Owner concludes, “[a] POSA would thus have understood the inventors to have possessed an invention in which checking for errors could occur on the server, on the customer device, or both.” *Id.*

Patent Owner argues that Figure 2 also explicitly supports “checking for errors before the submitting step.” Prelim. Resp. 55–56 (“Figure 2 itself

illustrates ‘checking for errors before the submitting step’ being performed by the software running on the customer computer, e.g., the mobile device.’”). Step 209 “Generate Log File” precedes step 210 “Send Image(s)/Log File to Server” in Figure 2. Figure 4 illustrates the financial server institution receiving the log file at step 405, “Receive Log File data from Software Component” (Ex. 1001, 12:38–40), and Figure 5, reproduced below, is an exemplary log file (*id.* at 13:8–9).



**FIGURE 5**

Figure 5 depicts a “Log File 500” that states in the seventh line “Reason for Error (if one).” The detailed description of Figure 5 provides, “Reason for error may be provided if an error occurred—for example due to an invalid check routing number, different amounts identified by the customer and the OCR process, etc.” *Id.* at 13:34–37. The Specification of the ’432 patent also provides:



[T]he log file maybe [sic] generated, for example by a software component on a customer-controlled general purpose computer. The log file comprises log file data, and may be delivered to the server by the software component. Log file data may comprise, for example the data illustrated in the log file 500 in FIG. 5.

*Id.* at 12:34–37. Patent Owner contends, “Figure 2 thus describes an embodiment in which the mobile device checks for errors (e.g., in order to store the reason for error, among other data, in a log file) prior to transmitting check images and submitting the check for mobile check deposit in the bank.” Prelim. Resp. 58.<sup>11</sup>

On this record, we determine that that Petitioner has not sufficiently shown that the ’247 application lacks written description support for the “checking for errors before the submitting step” limitation. Petitioner focuses on the ’247 application’s description of the server’s functionality and does not address the description of the customer device’s operation (e.g. the generation and transmission of the log file). Petitioner’s reliance on Dr.

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<sup>11</sup> Figure 4 (Step 405 “Receive Log File data from Software Component”) also depicts that, in some embodiments, the log file containing images is received from the software component of the costumer’s device. The detailed description of Figure 4 states:

[S]tep 407 [“Generate Log File with Log File Data Images”] illustrates generating a log file with log file data and images. The term “generating” may be exchanged for “modifying” in some embodiments, e.g. ***where the log file was received from the software component***, and simply modified to further comprise an additional check image that is in a different format.

Ex. 1001, 12:67–13:5 (emphasis added); *see also id.* at 11:3–5 (“The server may further receive and modify a deposit transaction log file 310. Alternate versions of the images received may be generated an[d] placed in the log file.”).

Noble's testimony is unavailing (*see* Ex. 1002 ¶¶ 60–65) because this testimony is conclusory and similarly fails to adequately address the relevant disclosure of the '247 application.

#### 4. Summary

Petitioner's contention that Oakes and Roach qualify as prior art is premised on its contention that the '432 patent is not entitled to the '247 application's priority date. That contention is, in turn, premised on Petitioner's argument that the '247 application fails to provide written description support for: (1) a mobile device with an integrated digital camera and (2) "checking for errors before the submitting step." As explained above, we are not persuaded by Petitioner's arguments. As a result, we determine that Petitioner has not shown a reasonable likelihood that it will establish that Oakes and Roach qualify as prior art. Thus, we determine that Petitioner has not shown a reasonable likelihood that it will prevail with respect to any of claims 1–23 as unpatentable over Oakes and Roach.

### III. MOTIONS TO SEAL

There are three joint motions to seal pending: Paper 9 (relating to the Preliminary Response and Exhibit 2006); Paper 14 (relating to the Reply); and Paper 19 (relating to the Sur-reply). In each of these motions, the parties seek to protect as confidential certain information that relates to the issue of whether Petitioner has properly identified all the real parties in interest in its Petition. *See* 35 U.S.C. § 312(a)(2). As we deny the Petition on the merits and do not grant the request to institute an *inter partes* review, the issue of identification of the real parties in interest to this proceeding is moot. Therefore, we do not reach the arguments and evidence of the parties relating to whether the Petitioner identified all the real parties in interest in

its Petition and we make no reference in this decision to the documents and information that the parties seek to protect as confidential.

In the first Joint Motion to Seal, the parties request entry of a Protective Order that is substantially the same as the Board’s Default Protective Order (*see* Consolidated Trial Practice Guide<sup>12</sup> at 107–122 (App. B, Protective Order Guidelines and Default Protective Order)). Paper 9, 2.<sup>13</sup> The parties also request sealing of Exhibit 2006 and sealing of portions of the Preliminary Response relating to that exhibit. *Id.* at 2–3. The portions of the Preliminary Response (Paper 8) requested to be sealed can be identified from the redacted version of the Preliminary Response filed as Paper 11. Based on the representations in the Joint Motion to Seal (Paper 9), the parties have shown good cause for entering the Protective Order and for sealing Exhibit 2006 and the identified portions of the Preliminary Response.

Paper 14 (Joint Motion to Seal the Reply) and Paper 19 (Joint Motion to Seal the Sur-reply) request sealing of the portions of the Reply and Sur-reply relating to Exhibit 2006. The portions of the Reply (Paper 13) and Sur-reply (17) requested to be sealed can be identified from the redacted version of the Reply filed as Paper 16 and from the redacted version of the Sur-reply filed as Paper 20. Based on the representations in these two Joint Motion to Seal (Papers 14 and 19), the parties have shown good cause for sealing the identified portions of the Reply and Sur-reply.

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<sup>12</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

<sup>13</sup> The pages in Paper 9 are not numbered accurately. Pages 1 and 2 are not numbered. Pages 3–11 are numbered 2–10, respectively. We refer to the actual page numbers.

Accordingly, we grant the three joint motions to seal (Papers 9, 14, 19).

#### IV. CONCLUSION

We determine that Petitioner has not demonstrated a reasonable likelihood of showing at least one of the claims challenged in the Petition would have been unpatentable. Accordingly, for the reasons stated herein, we deny the Petition.

#### V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), no *inter partes* review as to any claim of the '432 patent is instituted; and

FURTHER ORDERED that the motions to seal (Papers 9, 14, 19) are granted; a Protective Order in the form of Attachment A to Paper 9 is entered; and Exhibit 2006 and the portions of the Preliminary Response, Reply, and Sur-reply requested to be sealed are sealed until further order.<sup>14</sup>

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<sup>14</sup> The attention of the parties is directed to 37 C.F.R. § 42.56 (“After denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.”).

IPR2021-01071  
Patent 10,482,432 B1

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