

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PNC BANK N.A.,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2021-01077
Patent 10,621,559 B1

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

DIRBA, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request on Rehearing of
Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On January 20, 2023, the Board issued a Final Written Decision, which found claims 1–18 of U.S. Patent No. 10,621,559 B1 (Ex. 1001, “the ’559 patent”) to be unpatentable. Paper 73 (“Decision” or “Dec.”). United Services Automobile Association (“Patent Owner”) filed a Request for Rehearing. Paper 75 (“Req.”).

For the reasons provided below, we *deny* Patent Owner’s Request.

II. STANDARD FOR REHEARING

A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.” 37 C.F.R. § 42.71(d). “The burden of showing a decision should be modified lies with the party challenging the decision.” *Id.*

III. ANALYSIS

In the Request, Patent Owner argues that the Decision misapprehended or overlooked matters relevant to whether an ordinary artisan would have reasonably expected success in combining Garcia and Randle. Req. 1–5. We have reviewed and carefully considered all of the arguments presented, but determine Patent Owner fails to show that the Decision misapprehended or overlooked any material arguments or evidence. To provide context for our discussion, we begin with a targeted summary of the Decision, and then we turn to Patent Owner’s specific arguments.

In the Decision, the Board found that “Garcia describes a method for remotely depositing a check using a mobile device,” but “does not explain in

detail how the deposit is accomplished by the bank.” Dec. 30–31. The Decision found that Randle describes an engine used by a bank for this purpose and that an ordinarily skilled artisan would have been motivated to combine Garcia and Randle’s engine. *Id.* at 31–33. It also found that an ordinarily skilled artisan would have had a reasonable expectation of success in making the proposed combination and, in support, cited Dr. Noble’s testimony, which was supported by Garcia’s and Randle’s disclosures. *Id.* at 33 (citing Ex. 1102 ¶ 67; Ex. 1103, 11:7–19; Ex. 1104 ¶¶ 23, 25, 28); *see also* Paper 4 (“Pet.”), 28–29 (advancing contention).

At trial, Patent Owner presented arguments relating to “the differences between using a camera phone and a traditional check scanner to capture a check image,” but the Decision stated that “these arguments [were] fundamentally flawed because they fail[ed] to account for Garcia’s disclosure.” Dec. 34. The Decision found Garcia to be “strong evidence” that an ordinary artisan would have expected to be able to remotely deposit a check with a mobile phone. *Id.* at 34–35. As the Decision explained:

Patent Owner’s argument is that an ordinarily skilled artisan would not have reasonably expected to be able to use Randle’s system to remotely deposit a check using a mobile phone because he would not have expected a check image captured by a mobile phone to be sufficient. But Garcia specifically teaches a system that uses a mobile phone to capture a check image for this purpose. This is not a passing reference in Garcia; rather, this is Garcia’s invention. As a result, *Garcia is strong evidence that a person of ordinary skill in the art would have expected to be able to remotely deposit a check using a mobile phone.* In other words, even assuming *arguendo* that “there are significant [and important] differences between capturing check images for deposit using a cellular telephone and using a scanning device,” as Patent Owner argues, we find Garcia’s disclosure to be persuasive evidence that an ordinarily skilled

artisan would have expected to be able to successfully address those challenges. We note that *we assign significantly more weight to Garcia’s disclosure than we do to any expert’s testimony* because Garcia is documentary evidence written at the relevant time.

Id. (footnote and citations omitted) (emphases added). The Decision also addressed each of Patent Owner’s individual arguments regarding the differences between a camera phone and a scanning device. Dec. 35–40. Based on that evidence, the Decision found that a mobile device camera would not operate “just like” Randle’s scanners, despite Petitioner’s assertion to the contrary; however, the Decision determined that “Petitioner’s obviousness rationale [was] not materially diminished by rejecting” this assertion given Garcia’s disclosure. *Id.* at 40; *see also id.* at 40–41 (explaining that the challenges associated with using a mobile phone camera would further motivate the combination with Randle); Pet. 24–25 (advancing contention).

In the Request, Patent Owner first argues that, although the Board correctly rejected the Petition’s statement¹ that a camera phone was “just like” a scanner, it overlooked the importance of that statement. Req. 1–2 (citing Dec. 40; Pet. 28–29). According to Patent Owner, “as explained in the [Patent Owner’s Response], this [contention] was the sole basis for Petitioner’s assertion of reasonable expectation of success in the petition.”

¹ For simplicity, we refer to assertion at issue as a “statement,” but it is just a relative clause in one sentence. *See* Pet. 29 (“Accordingly, a POSITA would have reasonably expected that a check image captured by Garcia’s mobile device with an integrated camera—*which operates just like ‘an image-scanning device at the customer’s location’*—can be processed by Randle’s check processing system.” (emphasis added)).

Id. at 2 (citing Paper 35 (“PO Resp.”), 41–45). We are not persuaded by this argument because the Decision specifically addressed the importance of that statement to Petitioner’s contentions, as noted above. *See* Dec. 40–41.

Consequently, this argument amounts to mere disagreement with the Board’s Decision, which is not a proper basis for rehearing.

Patent Owner also argues that the Board overlooked evidence from the parallel district court proceeding (Req. 4–5), but this argument is similarly belied by the Decision. *See* Dec. 37–40 (addressing evidence from the district court proceedings); *also compare* Req. 4–5 (citing PO Resp. 43 (citing Ex. 2030 ¶¶ 94, 126), 44 (citing Ex. 2015 ¶ 58)), *with* Dec. 38 (discussing Ex. 2030 ¶¶ 94, 126; Ex. 2015 ¶ 58). Patent Owner argues that “the Board incorrectly treated this testimony as ‘marginally relevant’ because, in the Board’s view, it was directed to whether ‘the full scope’ of the claims was enabled” (Req. 4), but the Decision is to the contrary (*see* Dec. 38–40). The Decision noted the purpose of the testimony to explain why its contents were not particularly germane to the issues disputed in this proceeding:

Even considering [the district court testimony] (as we have), we find this evidence to be only marginally relevant to this proceeding. We note that the testimony is directed to a different question—i.e., is the full scope of these (and other) claims enabled—and *as a result, it conveys general concepts that are not particularly helpful to determining whether an ordinarily skilled artisan would have been motivated to combine Garcia and Randle and whether he would have had a reasonable expectation of success.*

Id. at 38 (emphases added). Indeed, the Decision then summarized the specific evidence introduced (*id.* at 38–39) and explained why that evidence is only marginally relevant to issues disputed in this proceeding (*id.* at 39–

40). Moreover, as noted above, the Decision assigned less weight to “any expert’s testimony” than to Garcia’s disclosure, which it found to be “strong evidence that a person of ordinary skill in the art would have expected to be able to remotely deposit a check using a mobile phone.” *Id.* at 35.

Consequently, this argument again amounts to a disagreement with the Board’s Decision, which is not a proper basis for rehearing.

Also, Patent Owner argues that the Decision overlooked or misapprehended Lev’s disclosure because it included a footnote discounting Lev’s statements regarding “special purpose flatbed scanners.” Req. 2–3 (citing Dec. 39 n.26). This argument is unpersuasive. The footnote clarified that Randle’s scanners were not shown to be “special purpose flatbed scanners,” as Lev describes, despite Patent Owner’s contrary assumption. *See* Dec. 39 n.26; *see also, e.g.*, PO Resp. 47 (addressing Lev’s statements regarding “‘special purpose flatbed scanners’ or ‘high-resolution cameras on fixtures’”), 49 (contending that Dr. Noble’s testimony regarding flatbed scanners is directly applicable to Randle’s scanners)). As a result, in this footnote, we explained the “marginal relevance” of Lev’s statements that distinguished “special purpose flatbed scanners” from “mobile imaging devices such as camera phones” and statements that camera phones “‘are typically not useful’ for faxing, archiving, or reading.” Dec. 39 n.26 (quoting Ex. 1106 ¶¶ 14–20) (cleaned up). The body of the Decision, however, specifically addressed and relied upon Lev’s explanation of the problems associated with capturing documents using a camera phone (*see* Dec. 39 (citing Ex. 1106 ¶¶ 21–23, 68, 70)), which was the thrust of the argument presented by Patent Owner (*see* PO Resp. 46–50). Frankly, the

challenged footnote is inconsequential to the Decision, and even if we were persuaded to omit it, such a change would have no impact on the Decision.

But the Request also does not identify any argument or evidence that was overlooked in the Decision. Although the Request argues that Lev lists other systems in the same “category” (*see* Req. 3), it fails to show that the Response sufficiently explained why Lev’s discussion was allegedly applicable to Randle’s scanners. *See* PO Resp. 10 (contending Randle describes only scanners), 13 (quoting Lev’s identification of those systems), 39–41 (arguing that Randle uses check scanners); *see also* PO Resp. 47 (pointing to Lev’s “special purpose flatbed scanners” and “high-resolution cameras on fixtures”). The Decision cannot have overlooked an argument that was never made, and a request for rehearing is not an opportunity to present new arguments.

Finally, we note that the Request pivots from the arguments actually presented in the Response and mischaracterizes aspects of the record. We specifically address three such instances to clarify the record. First, Patent Owner mischaracterizes the Decision by arguing that it “rejected Petitioner’s assertion that . . . [an ordinarily skilled artisan] would reasonably expect that images captured by it ‘can be processed by Randle’s check processing system’” (Req. 1–2)—the Decision said otherwise (*see* Dec. 40–41; *see also id.* at 33, 34–35). Second, we observe that the Response never argued that Petitioner’s “just like” statement “was the sole basis for Petitioner’s assertion of reasonable expectation of success.”² Req. 2 (citing PO

² We also disagree that the rejected contention was the sole basis for Petitioner’s contentions regarding reasonable expectation of success. *See* Pet. 24–25, 28–29; Dec. 33, 40–41; *see also* Dec. 34–35.

Resp. 41–45); *see* PO Resp. 41–45. Third, Patent Owner’s Request mischaracterizes Dr. Noble’s testimony and its prior arguments based upon it. *See* Req. 5 (citing PO Resp. 44 (citing Ex. 2015 ¶ 58)). Although Patent Owner now argues that Dr. Noble testified that a cell phone camera would not have been usable “as the capture device for check images *in combination with the processing steps recited in the ’559 patent claims*” (*id.* (emphasis added)), this argument does not appear in its Response. *See* PO Resp. 43–44. Instead, the Response asserted that Dr. Noble’s testimony showed that an ordinarily skilled artisan would not have expected a cell phone camera to be usable to capture a check image due to its “limited resolution.” *Id.* at 42–44; *see also id.* at 46–47, 51; *accord* Dec. 39 (finding that Dr. Noble testified that cell phone cameras had limited resolution at the time). We observe that the Request’s new argument is not supported by Dr. Noble’s testimony, which states that an ordinarily skilled artisan would not have known or predicted that a cell phone camera would have been “usable” to perform the steps recited by a *different* patent. Ex. 2015 ¶ 58; *see, e.g., id.* ¶ 59 (opining that the claims of US 10,482,432 B1 lack written description).³

³ Whether or not the written descriptions of these patents are the same (*see* PO Resp. 43 n.7), their claims impose substantially different requirements on the claimed “mobile device.” *E.g., compare* Ex. 1001, 14:22–65 (claim 1 of the ’559 patent), *with* Ex. 2015 ¶¶ 72–129 (addressing requirements of claim 1 of the ’432 patent). Thus, Dr. Noble’s testimony that a cell phone would not have been “usable” to perform the steps required by the ’432 patent’s claims does *not* address whether a cell phone would have been “usable” to perform the steps required by the ’559 patent’s claims.

IV. CONCLUSION

We have reviewed and considered the arguments in Patent Owner's Request, but Patent Owner fails to show that the Decision misapprehended or overlooked any matter. As a result, we are not persuaded to modify the Decision.

V. ORDER

Accordingly, it is:

ORDERED that Patent Owner's Request for Rehearing (Paper 75) is *denied*.

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