

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.

IPR2021-01399
Patent 10,013,605 B1

Before KRISTEN L. DROESCH, MICHAEL R. ZECHER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

PNC Bank N.A. (“Petitioner” or PNC) filed a Petition requesting *inter partes* review (“IPR”) of claims 1–29 of U.S. Patent No. 10,013,605 B1 (Ex. 1001, “‘605 Patent”). Paper 3 (“Pet.”). Petitioner filed a Declaration of Dr. Todd Mowry with its Petition. Ex. 1002. United Services Automobile Association (“Patent Owner”) filed redacted and unredacted versions of its Preliminary Response (Papers 8, 10 (“Prelim. Resp.”)), along with a Joint Motion to Seal Exhibit 2006 and certain portions of the Preliminary Response referencing Exhibit 2006 (Paper 9). With our authorization, Petitioner filed redacted and unredacted versions of its Preliminary Reply (Papers 11, 13), and Patent Owner filed redacted and unredacted versions of its Preliminary Sur-reply (Papers 14, 17). Petitioner filed a corresponding Motion to Seal certain portions of the Preliminary Reply that reference Exhibit 2006 (Paper 12) and Patent Owner filed a corresponding Joint Motion to Seal certain portions of the Preliminary Sur-reply that reference Exhibit 2006 (Paper 16).¹

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted unless it is determined that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail

¹ Papers 8, 11, and 14 were filed under seal, and Papers 10, 13, and 17, respectively, are the corresponding public versions. This Decision does not refer to any information that was redacted from the public documents.

with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018).

For the reasons provided below, we determine, based on the record before us, there is not a reasonable likelihood Petitioner would prevail in showing at least one of the challenged claims is unpatentable.

B. Related Matters

The parties indicate the ’605 Patent and several related patents are the subject of litigation in *United Services Automobile Association v. PNC Bank N.A.*, No. 2:20-cv-00319-JRG (E.D. Tex.), *United Services Automobile Association v. PNC Bank N.A.*, No. 2:21-cv-00246-JRG (E.D. Tex.) (“related district court proceeding”), and *United Services Automobile Association v. BBVA USA*, No. 2:21-cv-00311-JRG (E.D. Tex.). See Pet. 2; Paper 6, 2; Paper 18, 1.

The parties identify the following PTAB proceedings as involving the ’605 Patent and many related patents:

Challenged Patent	Case No.	Petitioner	Status
US 8,699,799	IPR2021-01070	PNC	Trial Instituted
US 8,977,571	IPR2021-01073	PNC	Trial Instituted
US 9,224,136	IPR2022-00075	PNC	Petition Filed
US 10,013,605	CBM2019-00029	Wells Fargo	Institution Denied
US 10,013,605	IPR2020-01742	Mitek	Institution Denied
US 10,013,681	IPR2021-01381	PNC	Institution Denied
US 10,402,638	IPR2020-01516	Wells Fargo	Settled Prior to Institution Decision
	IPR2022-00049	PNC	Petition Filed
	IPR2022-00050	PNC	Petition Filed

Challenged Patent	Case No.	Petitioner	Status
US 10,482,432	IPR2021-01071	PNC	Institution Denied
	IPR2021-01074	PNC	Institution Denied
US 10,621,559	IPR2021-01076	PNC	Institution Denied
	IPR2021-01077	PNC	Institution Denied
US 10,769,598	IPR2022-00076	PNC	Petition Filed

Pet. 2–3; Paper 6, 2–3; Paper 18, 1–2.

C. The '605 Patent (Ex. 1001)

The '605 Patent issued from U.S. Patent Application No. 15/663,284, filed on July 28, 2017. Ex. 1001, codes (21), (22). The '605 Patent, through intervening U.S. Patent Application No. 14/225,090, claims entitlement to the benefit of an earlier effective filing date of October 31, 2006, based on U.S. Patent Application No. 11/590,974 (Exhibit 1042, “'974 Application”), which issued as US. Patent No. 8,708,227 B1 (Ex. 1037, “Oakes I”). *Id.* at code (63); Ex. 1015, 105, 121.

The '605 Patent is directed to a system for depositing checks remotely. *See id.* at code (57), 2:10–54.

Figure 1 of the '605 Patent is reproduced below:

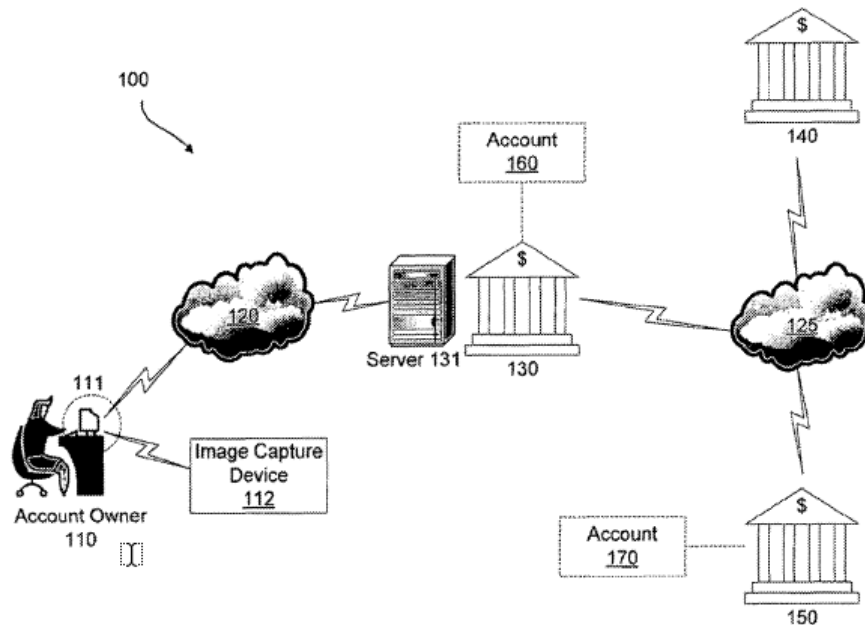


Figure 1 depicts a system in which the described method may be employed. *See* Ex. 1001, 2:63–64, 3:36–37. System 100 includes account owner 110 (e.g., a bank customer located at their private residence) and an associated customer-controlled general purpose computer 111 communicatively coupled to image capture device 112, as well as publicly accessible network 120, financial institution 130 and server 131, network 125, and other entities 140, 150 associated with account 170. *See id.* at 3:36–58, 6:27–28. For example, account owner 110 who has account 160 at financial institution 130 may use general purpose computer 111 and image capture device 112 to generate images of a check and send the images to server 131 associated with financial institution 130, via publicly accessible network 120. *See id.* at 3:40–41, 3:43–50, 7:1–17. Financial institution 130 may forward the image over network 125 to one or more other entities 140, 150, associated with account 170 on which the check was drawn. *See id.* at 3:55–58, 6:57–63, 7:43–50. General purpose computer 111 “may be in a desktop or laptop configuration.” *Id.* at 3:65–66.

“Image capture device 112 may be, for example, a scanner or digital camera.” *Id.* at 6:29–30.

To deposit a check drawn from account 170 at financial institution 150 into account 160, account owner 110 converts the check into a digital image by scanning the front and/or back of the check using image capture device 112. *See* Ex. 1001, 9:16–21, 9:27–29. A server includes a subsystem for analyzing the image of the front side of the check to see if it meets at least one criterion, for example, to recognize that the image is a check, the check is not a duplicate, and that the received image can be used to further process the transaction. *See id.* at 10:65–11:5. The server comprises a system for performing Optical Character Recognition (OCR) which can be useful for determining the check amount and magnetic ink character recognition (MICR) line information, such as routing number, account number, check number. *See id.* at 11:25–31. The aforementioned information can then be validated. *See id.* at 11:33–37. The server also includes a subsystem for error processing. *See id.* at 11:55–12:2.

D. Illustrative Claim

Claims 1 and 12 are independent, and claims 2–11 and 13–29 depend therefrom, respectively. *See* Ex. 1001, 15:10–18:22. Claim 1 is illustrative and reproduced below:

1. An image capture and processing system for use with a digital camera, the image capture and processing system comprising:
 - a portable device comprising a general purpose computer including a processor coupled to a memory, the memory storing:
 - camera software comprising instructions that, when executed by the processor, control the digital camera;

a downloaded software component configured to control the camera software and to manage capturing electronic images, the software component comprising instructions that, when executed by the processor, cause the portable device to perform operations including:

- instructing a user of the portable device to place a check in front of the digital camera and have the digital camera capture electronic images of front and back sides of the check;
- displaying an instruction on a display of the portable device to assist the user in having the digital camera capture the electronic images of the check;
- assisting the user as to an orientation for capturing the electronic images of the check;
- presenting the electronic images of the check to the user after the digital camera captures the electronic images;
- transmitting, using a wireless network, a copy of the electronic images over a public electronic communications network from the portable device, wherein the transmitted copy of the electronic images is a modified version of the electronic images captured with the digital camera, the modified version having a different electronic format than the images captured with the digital camera; and
- submitting the check for deposit after the system authenticates the user and after presenting the electronic images of the check to the user;

a plurality of processors coupled to a plurality of memory devices storing instructions that, when each instruction of the instructions is executed by a processor of the plurality of processors coupled to a memory device of the plurality of memory devices storing that instruction, cause the system to perform additional operations including:

- confirming that the deposit can go forward after performing an optical character recognition on the check, the optical character recognition including determining an amount of the check, comparing the

determined amount to an amount entered by the user into the portable device, and reading a MICR line of the check;
initiating the deposit after the confirming; and
generating a log file for the deposit, the log file including a bi-tonal image of the check; and
another computer, remote from the portable device, comprising a processor coupled to a memory storing instructions that, when executed by the processor, cause the other computer to update a balance to reflect the amount of the check submitted for deposit by the portable device.

Ex. 1001, 15:9–16:3.

E. Asserted Challenges to Patentability and Asserted Prior Art

Petitioner asserts that claims 1–29 would have been unpatentable based on the following grounds (Pet. 6):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
12–23, 26–29	103(a) ²	Oakes I ³ , Oakes II ⁴
12–23, 26–29	103(a)	Oakes I, Oakes II, Medina ⁵
1–11, 24, 25	103(a)	Oakes I, Oakes II, Roach ⁶ or Oakes I, Oakes II, Roach, Medina

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Because the '605 Patent claims an effective filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA version of § 103.

³ US 8,708,227 B1, issued Apr. 29, 2014 (Ex. 1037).

⁴ US 7,873,200 B1, issued Jan. 18, 2011 (Ex. 1038).

⁵ US 9,129,340 B1, issued Sept. 8, 2015 (Ex. 1058).

⁶ US 2013/0155474 A1, published June 20, 2013 (Ex. 1040).

II. REAL PARTY-IN-INTEREST AND DISCRETIONARY DENIAL

As explained in detail below, we deny institution of *inter partes* review on the merits because the Petition fails to demonstrate that Oakes I, Oakes II, Medina, and Roach qualify as prior art to the challenged claims of the '605 Patent. Based on our determination in this regard, we need not reach the following three issues: (1) whether the Petition should be denied under 35 U.S.C. § 312(a)(2) because Mitek should have been named as a real party-in-interest; (2) whether the arguments and evidence presented in the Petition were considered and rejected previously in prior proceedings; and (3) whether the non-exclusive list of six factors set forth in *Fintiv* warrants the exercise of the Board's discretion to deny institution when there is a related district court proceeding involving the '605 Patent. *See* Prelim. Resp. 5–21; Pet. Reply 1–8; PO Sur-reply 1–8. Because we deny institution of *inter partes* review on the merits of the Petition, we make no reference in this Decision to the documents and information that the parties seek to protect as confidential information in this proceeding. *See* Paper 21 (Order granting the parties Motions to Seal).

III. ANALYSIS

A. Claim Construction

In an *inter partes* review proceeding, the Board applies the same claim construction standard as applied in federal courts in a civil action under 35 U.S.C. § 282(b), which is generally referred to as the *Phillips* standard. *See* 37 C.F.R. § 42.100(b) (2021); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under the *Phillips* standard, words of a claim are generally given their ordinary and customary meaning. *Phillips*, 415 F.3d at 1312.

Petitioner contends that, for purposes of this proceeding, we should adopt the constructions that Patent Owner proposes in the related district court proceeding for the claim terms “handheld mobile device,” “portable device,” and “digital camera.” *See* Pet. 10–12. The constructions that Patent Owner proposes in the related district court proceeding for these three claims terms are set forth in the table below:

Claim Term	Patent Owner’s Proposed Construction
“handheld mobile device”	“handheld computing device”
“portable device”	“computing device capable of being easily moved manually”
“digital camera”	No further construction necessary

Pet. 11 (citing Ex. 1059, (Joint Claim Construction and Prehearing Statement), 17⁷; Ex. 1002 ¶ 41). According to Petitioner, “[f]or this IPR proceeding, Petitioner relies on [Patent Owner]’s constructions and applications of the terms ‘handheld mobile device,’ ‘portable device,’ and ‘digital camera.’” *See id.* at 12 (citing Ex. 1002 ¶ 42).

Petitioner also notes that Patent Owner, in the related district court proceeding, asserted that claims 1 and 12 are broad enough to read on a mobile device with an integrated digital camera. *See* Pet. 11 (quoting Ex. 1043 ¶¶ 47, 49, 51). Petitioner further notes that in the prior covered business method proceeding, Patent Owner made a similar contention. *See id.* at 11–12 (quoting *Wells Fargo Bank, N.A. v. United States Auto. Ass’n*, CBM2019-00029, Paper 10, 37 (PTAB July 17, 2019)).

Patent Owner contends that, on November 22, 2021, the district court issued a claim construction order that expressly rejected Petitioner’s

⁷ All page number references are to the page numbers inserted by Petitioner in the bottom, left-hand corner of each page in Exhibit 1059.

proposed constructions and, instead, adopts Patent Owner’s proposed constructions. *See* Prelim. Resp. 23 (citing Ex. 1061 (Claim Construction Memorandum Opinion and Order), 18–19). The district court’s constructions are summarized in the table below:

Clam Term	District Court’s Construction
“mobile device”	“handheld computing device”
“digital camera”	Plain meaning
“mobile device associated with an image capture device”	Plain meaning (apart from the district court’s construction of “mobile device”)
“portable device”	“computing device capable of being easily moved manually”

See Prelim. Resp 23 (citing Ex. 1061, 20).

Patent Owner contends that, for the purpose of this proceeding, Petitioner departs from its narrow constructions advanced in the related district court proceeding, and requests that we adopt the constructions proposed in the district court by Patent Owner and adopted by the district court. *See* Prelim. Resp. 22–24 (quoting Ex. 1059, 17; Ex. 2008, 10; Ex. 1061, 20; Pet. 10, 17; citing Pet. 16–25). Patent Owner asserts that Petitioner’s approach to claim construction violates the requirement of 37 C.F.R. § 42.104(b)(3) that the Petition set forth “how the challenged claim is to be construed.” *See id.* at 24–25. On this basis, Patent Owner asserts that we should decline to institute review. *See id.* at 25.

Although Patent Owner takes issue with Petitioner’s approach to claim construction for this proceeding, Patent Owner does not urge us to reject constructions for the claim terms proposed by Patent Owner and adopted by the district court. *See* Pet. 22–25; Ex. 1059, 17; Ex. 1061, 20. Because there is no dispute between the parties as to the construction of these claim terms, we need not construe these claim terms for the purpose of this Decision. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean*

Motor Co., 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

B. The Level of Ordinary Skill in the Art

Petitioner asserts that

[a] person of ordinary skill in the relevant field or art [] at relevant times (2006-2017) of the ’605 [P]atent 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 ¶ 39). For the purpose of the Preliminary Response only, Patent Owner applies Petitioner’s proposed level of ordinary skill at. Prelim. Resp. 21.

For the purpose of this Decision, we adopt Petitioner’s definition of a person of ordinary skill in the art.

C. Challenges to Patentability based on Oakes I, Oakes II, Medina, and Roach

The ’605 Patent issued from U.S. Patent Application No. 15/663,284, filed on July 28, 2017. Ex. 1001, codes (21), (22). The ’605 Patent, through intervening U.S. Patent Application No. 14/225,090, claims entitlement to the benefit to an earlier effective filing date of October 31, 2006, based on U.S. Patent Application No. 11/590,974, which issued as US. Patent No. 8,708,227 B1. *Id.* at code (63); Ex. 1015, 105, 121. The parties agree that the ’605 Patent Specification is substantively identical to the ’974

Application Specification. *See* Pet. 32 (stating that “*Oakes I* issued from the ’974 Application, and shares the specification and figures with the ’605 [P]atent.”); Prelim. Resp. 24 n.6 (stating that “[t]he ’974 Application is the first application in a chain of direct continuation applications leading to the ’605 [P]atent and thus substantively identical to the ’605 [P]atent specification”).

Petitioner argues that each of *Oakes I*, *Oakes II*, *Medina*, and *Roach*, qualify as prior art to the challenged claims of the ’605 Patent because these claims are not entitled to the benefit of a filing date earlier than July 28, 2017. Pet. 4–5, 12–32. To support its argument, Petitioner asserts that the ’974 Application, which is the basis for the ’605 Patent’s claim to entitlement to an earlier effective filing date of October 31, 2006, does not provide sufficient written description support for the following: (1) a portable/handheld mobile device with an integrated digital camera; (2) initiating the mobile check deposit after performing the confirming step and confirming that the mobile check deposit can go forward after performing OCR on the check; and (3) the transmitted copy of the electronic images having a different electronic format than the images captured with the digital camera. *See id.* at 12–32. In response, Patent Owner argues that Petitioner fails to demonstrate that *Oakes I*, *Oakes II*, *Medina*, and *Roach* qualify as prior art to the challenged claims of the ’605 Patent, because Petitioner fails to put forth credible evidence supporting its assertion that the ’605 Patent claims lack written description support in ‘the ’974 Application. *See* Prelim. Resp. 25–26.

After reviewing the parties’ arguments and cited evidence, we determine that Petitioner does not demonstrate that *Oakes I*, *Oakes II*, *Medina*, and *Roach* qualify as prior art to the challenged claims of the ’605

Patent. Accordingly, Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail in challenging any one of claims 1–29 of the '605 Patent. We begin our analysis with the principles of law that apply generally to a patent's entitlement to an earlier effective filing date based on written description support in the earlier-filed application. Next, we focus on the parties' disputes and analysis of whether Petitioner demonstrates the '605 Patent is not entitled to an earlier effective filing date, and, based on the outcome of this priority dispute, whether Oakes I, Oakes II, Medina, and Roach qualify as prior art to the challenged claims of the '605 Patent.

1. 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, first paragraph,] 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.* (second 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.* “[T]he 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) (“[A]n 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.” (citation omitted)).

2. The Parties’ Disputes

Petitioner contends that the ’605 Patent’s claim to entitlement of the earlier effective filing date of the ’974 Application is improper because the ’974 Application does not provide sufficient written description support for the claims of the ’605 Patent. *See* Pet. 4–5, 12–13. Specifically, Petitioner asserts that the following limitations are insufficiently supported: (1) “a portable device” and “a digital camera” recited in claim 1 and “handheld mobile device with a digital camera” recited in independent claim 12 (*see id.* at 16–29); (2) “confirming that the deposit can go forward after performing an optical character recognition on the check . . . ; initiating the deposit after the confirming [step]” recited in claims 1 and 12 (*see id.* at 30–31); and (3) “the transmitted copy of the electronic images is a modified version of the electronic images captured with the digital camera, the modified version having a different electronic format than the images captured with the digital camera” recited in claim 1, and similarly recited in claim 25 (*see id.* at 31–32). *See also* Ex. 1001, 15:10–15, 15:36–43, 15:65–62, 16:30–33, 16:61–67 (claims 1 and 12). Petitioner contends that the lack of written description support for these limitations “is fatal to the priority claim of all claims of the ’605 [P]atent.” *Id.* at 17.

In response, Patent Owner asserts that Petitioner “fails to put forth credible evidence supporting its assertion that the ’605 [P]atent claims lack support in the original specification.” Prelim. Resp. 26. Patent Owner contends that the ’974 Application provides written description support for all of the limitations identified by Petitioner. *See id.* at 30–65. Patent

Owner submits that Petitioner fails to sufficiently show that Oakes I, Oakes II, Medina, and Roach qualify as prior art to the challenged claims of the '605 Patent and, therefore, institution should be denied. *Id.* at 25–26.

3. Analysis of Written Description Support
“portable device” and “digital camera” /
“handheld mobile device with a digital camera”

We begin our analysis of the first disputed claim limitation (which we refer to as “the device limitations”) by clarifying the issue presented with respect to it.⁸

Petitioner contends the '974 Application does not provide sufficient written description support for the device limitations because the device limitations are broad enough to include “a mobile device with an integrated digital camera” and such a device is not described in the '974 Application. *See* Pet. 12–13, 16–29. Notably, elsewhere, Petitioner affirmatively contends that the '974 Application *discloses* the device limitations—in fact, Petitioner’s obviousness argument is predicated on this contention. *See* Pet. 35–40 (arguing that Oakes I, the patent that issued from the '974 Application, alone teaches this limitation). Accordingly, for its written description argument, Petitioner takes issue only with the *scope* of the device limitations. *See id.* at 39–40 (addressing the interplay between the written description and obviousness arguments). The issue is specifically whether the claim is overbroad (and thus lacking in written description

⁸ We consider only the arguments presented in the Petition. Although we do not agree with these arguments, our Decision should not be construed as an independent assessment of whether the '974 Application provides written description support for the invention claimed in the '650 Patent.

support) because the claim scope permits the image capture device 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 that we should understand the device limitations to be broad enough to include a mobile device with an integrated digital camera. Pet. 11–12, 14. Second, Petitioner contends that the ’974 Application does not disclose a digital camera integrated with the portable/mobile device. *See* Pet. 13, 25–26; *see also id.* at 19–26 (analysis supporting assertion).

But, even accepting these premises, we disagree with Petitioner’s conclusion. In particular, Petitioner appears to contend that we should find that the ’974 Application does not provide written description support for the device limitations *merely because* the scope of the claims encompass a configuration that is not expressly described in the ’974 Application. *See* Pet. 17–26. But this reflects a misunderstanding of the law—a claim *can* be broader than the embodiments disclosed. *See, e.g., Rexnord*, 274 F.3d at 1344 (“[A]n 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); *In re Smythe*, 480 F.2d 1376, 1384 (CCPA 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.”).

We acknowledge that 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. 16–18 (citing *Reckitt Benckiser LLC v. Ansell Healthcare Products LLC*, IPR2017-00063, Paper 38 (PTAB Jan. 30, 2018)). First, *Reckitt* is a non-precedential Board decision, which is not binding on this panel.⁹ Second, and perhaps more importantly, the case is readily distinguishable on its facts. *See* Prelim. Resp. 30–33 (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 “[p]re-vulcanization [was] not some ancillary feature *but rather the very heart of the invention.*” *Reckitt*, IPR2017-00063, Paper 38 at 12 (emphasis added); *see also id.* at 14–15. However, as pointed out by Patent Owner, “Petitioner identifies nothing whatsoever in the ’974 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. 31. 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 ’974 Application.

Returning to the ’974 Application, it 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

⁹ 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 Labs. S.A.*, 18 F.4th 1323, 1329 (Fed. Cir. 2021).

(such as a digital camera). *E.g.*, Ex. 1042 ¶¶ 9, 19, 21, 29, 33. What is important to the invention is that the image capture device and general purpose computer are communicatively coupled, not their locations relative to one another. *See, e.g., id.* ¶ 33; *accord* Prelim. Resp. 32–33. In addition, the ’974 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.¹⁰ The ’974 Application broadly describes the image capture device, noting it can be “a scanner or digital camera.” Ex. 1042 ¶¶ 21, 33. The ’974 Application 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.* ¶¶ 21, 29, 33; *see also id.* ¶ 19. In light of these disclosures, we find that a person of ordinary skill in the art would have understood the ’974 Application to reasonably convey possession of both integrated and non-integrated configurations. *See In re Rasmussen*, 650 F.2d 1212, 1215 (CCPA 1981) (explaining that claims with the generic step of “adheringly applying” one layer to an adjacent layer satisfied the written 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”).

¹⁰ Petitioner contends that certain aspects of the disclosure would not be necessary if the image capture device and general purpose computer were intended to be integral. *See* Pet. 29 (citing Ex. 1042 ¶ 33; Ex. 1002 ¶¶ 60–61). Even if Petitioner were correct, the cited passage simply provides a discussion of an embodiment where these components are separate. They do not show that the invention *requires* the components to be separate.

Petitioner’s reliance on *LizardTech* and *Tronzo* is misplaced. *See* Pet. 26 (*LizardTech*, 424 F.3d 1336; *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998)). As the U.S. Court of Appeals for the Federal Circuit explained, “[i]n each of those cases, the specification unambiguously limited the scope of the invention.” *Crown Packaging Tech., 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.

Finally, we disagree with Petitioner’s genus-species analysis, which effectively reorganizes the same considerations into a different framework. *See* Pet. 26–29. According to Petitioner, “this single species (general purpose computer separate from the digital camera that captures check images) fails to provide written description support for the full scope of the genus claimed . . . , which . . . includes an integrated digital camera that captures check images as claimed.” *Id.* at 26. Petitioner acknowledges that the ’974 Application discloses the former, and we find that to be representative of both alternatives, given the ’974 Application’s disclosure, as discussed above. *See, e.g.*, Ex. 1042 ¶¶ 9, 19, 21, 29, 33. We also find that a person of ordinary skill in the art, defined by Petitioner as having a relatively high level of skill in image capture/scanning technology, would have understood the ’974 Application to reasonably convey possession of the single non-enumerated species—indeed, as Patent Owner notes, “one would only need to think of the *only other configuration of portable/handheld mobile device* in the market.” Prelim. Resp. 53. Further, Petitioner does not provide evidence to demonstrate that the other, non-enumerated species was in any way unpredictable. *Cf.* Pet. 29 (arguing instead that an ordinary artisan “would not have expected” the non-

enumerated species to “have performed as well”). Moreover, 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. Mowry’s testimony, but it suffers from the same deficiencies as Petitioner’s arguments. *See* Ex. 1002 ¶¶ 43–63. Moreover, in our view, Dr. Mowry does not explain sufficiently his conclusions regarding what a person of ordinary skill would have understood the inventor of the ’974 Application to possess (or not possess), and accordingly, we assign little weight to that testimony. *E.g., id.* ¶ 57; *see also 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 claims are broad enough to encompass a portable/handheld mobile device with an integrated image capture device and that the ’974 Application does not expressly describe such a device, we are not persuaded by the arguments raised in the Petition alleging that the ’974 Application fails to provide written description support for the device limitations.

“confirming that the deposit can go forward after performing an optical character recognition on the check, . . . initiating the deposit after performing the confirming [step]”

Petitioner also argues that the '974 Application does not provide written description support for the “confirming that the deposit can go forward after performing an optical character recognition on the check,” and “initiating the deposit after performing the confirming [step],” (which we refer to as the “confirming” limitation and the “initiating” limitation). *See* Pet. 30–31; *see also* Ex. 1001, 15:55–62, 16:62–67 (claims 1 and 12). For these limitations, Petitioner contends that the '974 Application provides no written description of when the initiating step occurs relative to any confirming step, and provides no written description of confirming that the deposit can go forward. *See id.* at 30–31 (citing Ex. 1002 ¶¶ 64–69).

More specifically, Petitioner contends that the only disclosure of a confirmation in the '974 Application “is a disclosure that duplicate check detection can ‘be done in real time, i.e.,[.] while the customer waits for confirmation.’” Pet. 31 (emphasis omitted) (citing Ex. 1042 ¶ 61; Ex. 1002 ¶¶ 67–69). Petitioner asserts that this disclosure does not specify what the confirmation is supposed to be confirming, much less that the confirmation relates to confirming that the deposit can go forward. *See id.* Petitioner also asserts that the '974 Application discloses that the initiation of a deposit of a check can comprise a variety of possible actions, such as soft posting, forwarding an image, or placing data in a batch file, but provides no written description of when these possible initiation steps occur relative to any confirming step. *See id.* at 30 (citing Ex. 1002 ¶ 65). Petitioner contends the only antecedent basis for “confirming” is “confirming that the deposit

can go forward,” which is not disclosed in the ’974 Application. *See id.* (citing Ex. 1002 ¶ 66).

We are not persuaded by Petitioner’s arguments. We agree with Patent Owner that the ’974 Application describes the confirming limitation based on the following disclosures: (1) performing OCR on the image of the front of the check to determine information such as the routing number; (2) the routing number is used by the financial institution receiving the check for deposit to identify a financial institution as the paying bank; and (3) the OCR’d routing number is information that is validated by comparing it to a list of validated routing numbers. *See* Prelim. Resp. 56–57 (citing Ex. 1042 ¶¶ 51, 60, 61). We further agree with Patent Owner that the ’974 Application also describes the confirming limitation based on disclosures of error processing that includes determining whether a check is not a duplicate, and confirming the check amount. *See id.* at 58–60 (quoting Ex. 1042 ¶¶ 20, 61, 62). Finally, we agree with Patent Owner that a person of ordinary skill in the art would understand that confirming by any of these three examples must occur before the initiating the deposit of a check, which is described in the ’974 Application as any action that sets in motion a chain of automated events resulting in crediting of the customer’s account. *See id.* at 60–61.

Petitioner’s reliance on Dr. Mowry’s testimony is again unavailing. *See* Ex. 1002 ¶¶ 64–69. Dr. Mowry states that “the ’974 Application fails to disclose the order in which several steps must be performed,” “does not elaborate on when any . . . possible ‘initiating’ steps happen in relation to any ‘confirming’ step,” and “does not elaborate on what the ‘confirmation’ is supposed to be confirming.” *Id.* ¶¶ 64, 65, 67. We do not credit this testimony because it is conclusory and because it conflicts with the

disclosure of the '974 Application identified above. *See TQ Delta*, 942 F.3d at 1358.

Accordingly, we are not persuaded by Petitioner's arguments that the '974 Application fails to provide written description support for the confirming limitation and initiating limitation.

“the transmitted copy of the electronic images . . . having a different electronic format than the images captured with the digital camera;”

Turning to the last set of limitations, Petitioner contends that the '974 Application does not provide sufficient written description support for “the transmitted copy of the electronic images . . . having a different electronic format than the images captured with the digital camera,” as recited in claim 1 and similarly recited in claim 25, (which we refer to as the “different electronic format” limitations). *See* Pet. 31–32. More specifically, Petitioner contends that these limitations do not have written description support in the '974 Application because the '974 Application discloses that all the electronic image format modifications occur at the server after the images have been received from the portable/handheld mobile device. *See id.* (citing Ex. 1042 ¶¶ 8, 59, 65; Ex. 1002 ¶ 70).

In response, Patent Owner contends that the '974 Application provides sufficient written description support for the “different electronic format” limitations. *See* Prelim. Resp. 61–65. Patent Owner asserts that the '974 Application teaches customer-controlled computer 530 that is configured to carry out image conversion, and expressly discloses image capture device control software and/or image edit software 531. *See id.* at 61–62 (reproducing Ex. 1042, Fig. 5; quoting Ex. 1042 ¶¶ 54, 69). Patent Owner contends that, in the same paragraph cited by Petitioner, the '974 Application further discloses that “it can be useful to include in some

embodiments a mechanism for converting images from such first format to a second format such as bi-tonal TIFF,” which is “required by Check 21 legislation.” Ex. 1042 ¶ 65; *see* Prelim. Resp. 64. According to Patent Owner, “the ’974 Application explains that the bi-tonal TIFF format is a ‘second format’ produced by converting an original image that is in a ‘first format,’ and therefore bi-tonal TIFF images . . . would be in a ‘different electronic format than the images captured with the digital camera.’”

Prelim. Resp. 65 (citing Ex. 1042 ¶ 65). Finally, Patent Owner asserts that the ’974 Application acknowledges that, “[w]hile systems may be designed to handle checks in any format, it may be cost effective to require customers to send in only images of specified formats so as to lower development costs of the system.” Ex. 1042 ¶ 59; *see* Prelim. Resp. 64. On the forgoing bases, Patent Owner contends:

the ’974 Application discloses embodiments in which the customer sends images to the server in “specified formats” so that the server doesn’t have to “handle checks in any format.” Because check processing requires a bi-tonal TIFF image under the Check 21 legislation, as Petitioner acknowledges (*see* Pet. 81), a [person of ordinary skill in the art] would understand these “specified formats” to be sent by the customer would necessarily include the required bi-tonal TIFF format.

Prelim. Resp. 64–65.

On this record, we do not agree with Petitioner’s arguments that the ’974 Application does not provide sufficient written description support for the “different electronic format” limitations. The ’974 Application discloses: (1) a customer-controlled computer (such as a laptop) that has image capture device control software and/or image edit software; (2) it can be useful to include a mechanism for converting images from a first format to a second bi-tonal TIFF format required by Check 21 legislation; and (3) it

may be cost effective to require customers to send in only images of specified formats to lower development costs of the system. *See* Ex. 1042 ¶¶ 59, 65, 69, Fig. 5. Therefore, contrary to Petitioner’s argument, the ’974 Application discloses reducing system development costs by requiring customers to send in (i.e., transmit) images in bi-tonal TIFF format, which is required by Check 21 legislation, by first using the customer-controlled computer to convert a check image from a first format to the second bi-tonal TIFF format prior to sending (i.e., transmitting) the image to the server.

Once again, Petitioner’s reliance on Dr. Mowry’s supporting testimony is unavailing. *See* Ex. 1002 ¶ 70. We do not credit this testimony because it is conclusory and because it conflicts with the disclosure of the ’974 Application. *See TQ Delta*, 942 F.3d at 1358.

Accordingly, we do not agree with Petitioner that the ’974 Application fails to provide written description support for the “different electronic format” limitations.

4. Summary

Petitioner’s contention that Oakes I, Oakes II, Medina, and Roach qualify as prior art to the challenged claims of the ’605 Patent is premised on its arguments that the ’605 Patent is not entitled to the earlier effective filing date of the ’974 Application. That contention is, in turn, premised on Petitioner’s argument that the ’974 Application fails to provide written description support for the following limitations recited in the claims of the ’605 Patent: (1) “a portable device” and “a digital camera,” recited in claim 1, and “handheld mobile device with a digital camera,” recited in independent claim 12; (2) “confirming that the deposit can go forward after performing an optical character recognition on the check . . . ; initiating the

deposit after the confirming” recited in claims 1 and 12; and (3) “the transmitted copy of the electronic images is a modified version of the electronic images captured with the digital camera, the modified version having a different electronic format than the images captured with the digital camera” recited in claim 1, and similarly recited in claim 25. As explained above, we are not persuaded by Petitioner’s arguments regarding these limitations. As a result, we determine that Petitioner has not shown a reasonable likelihood that it would establish that Oakes I, Oakes II, Medina, and Roach qualify as prior art to the challenged claims of the ’605 Patent.

Accordingly, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail on its following assertions: (1) claims 12–23 and 26–29 are unpatentable as obvious over Oakes I and Oakes II; (2) claims 12–23 and 26–29 are unpatentable as obvious over Oakes I, Oakes II, and Medina; (3) claims 1–11, 24 and 25 are unpatentable as obvious over Oakes I, Oakes II, and Roach; and (4) claims 1–11, 24 and 25 are unpatentable as obvious over Oakes I, Oakes II, Roach, and Medina.

IV. CONCLUSION

In view of Patent Owner’s Preliminary Response, we conclude that the information presented in the Petition does not demonstrate that there is a reasonable likelihood that Petitioner would prevail in challenging any one of claims 1–29 of the ’605 Patent as unpatentable.

V. ORDER

In consideration of the foregoing, it is ORDERED that the Petition is *denied* and no trial is instituted.

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