

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.

IPR2022-00050
Patent 10,402,638 B1

Before MICHAEL R. ZECHER, 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”)¹ filed a Petition to institute an *inter partes* review of claims 1–30 of U.S. Patent No. 10,402,638 B1 (Ex. 1001, “the ’638 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 4 (“Petition” or “Pet.”). United Services Automobile Association (“Patent Owner”)² filed a Preliminary Response. Paper 11 (“Preliminary Response” or “Prelim. Resp.”). Pursuant to our authorization, Petitioner filed a Reply, Paper 14 (“Reply”), and Patent Owner filed a Sur-reply, Paper 18 (“Sur-reply”).³

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.

B. *Related Proceedings*

The parties identify *United Servs. Auto. Ass’n (“USAA”) v. PNC Bank N.A.*, No. 2:21-cv-00246-JRG (E.D. Tex.) as a related proceeding in which the ’638 patent is asserted. Pet. 2; Paper 6, 2. The parties further identify as

¹ Petitioner identifies PNC Bank N.A., as the real party-in-interest to this proceeding. Pet. 1.

² Patent Owner identifies United Services Automobile Association, as the real party-in-interest to this proceeding. Paper 6, 2.

³ Patent Owner also submitted a redacted version of its Preliminary Response as Paper 12, Petitioner submitted a redacted version of its Reply as Paper 16, and Patent Owner submitted a redacted version of its Sur-reply as Paper 20.

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related proceedings: *USAA v. PNC Bank N.A.*, No. 2:20-cv-00319-JRG (E.D. Tex.) in which four patents (U.S. Patent Nos. 7,949,788; 8,868,786; 8,380,623; and 8,682,754) are asserted; and *USAA v. PNC Bank N.A.*, No. 2:21-cv-00110-JRG (E.D. Tex.) in which two additional patents (U.S. Patent Nos. 7,949,788 and 8,886,768) are asserted, including the grandparent of the '638 patent. Pet. 2; Paper 6, 2.

Patent Owner also identifies *USAA v. Wells Fargo Bank*, No. 2:18-cv-00366-JRG (E.D. Tex.) in which Patent Owner asserted against Wells Fargo Bank, N.A. ("Wells Fargo") two patents from the '638 patent's family (U.S. Patent Nos. 10,013,605 and 8,708,227) as well as three patents not formally related to the '638 patent family, but containing overlapping inventors and related subject matter (U.S. Patent Nos. 8,392,332; 9,224,136; and 10,013,681). Paper 6, 3.

The parties identify additional *inter partes* review proceedings that challenge patents asserted against Petitioner: IPR2022-00049 (challenging the '638 patent); IPR2021-01070 (challenging U.S. Patent No. 8,699,779); IPR2021-01073 (challenging U.S. Patent No. 8,977,571); IPR2021-01071 (challenging U.S. Patent No. 10,482,432); IPR2021-01074 (challenging U.S. Patent No. 10,482,432); IPR2021-01076 (challenging U.S. Patent No. 10,621,559); IPR2021-01077 (challenging U.S. Patent No. 10,621,559); IPR2021-01399 (challenging U.S. Patent No. 10,013,605); and IPR2021-01381 (challenging U.S. Patent No. 10,013,681). Pet. 2–3; Paper 6, 3; Paper 15, 1. The parties also identify IPR2020-01516, in which Wells Fargo challenged the '638 patent, and CBM2019-00029 (challenging U.S. Patent No. 10,013,605) and IPR2020-01742 (challenging U.S. Patent No. 10,013,605) filed by Mitek Systems, Inc. The parties identify the following

other post-grant proceedings involving patents in the '638 patent's family, or involving patents not formally related to the '638 patent family but containing overlapping inventors and related subject matter: CBM2019-00027 (challenging U.S. Patent No. 9,224,136); CBM2019-00028 (challenging U.S. Patent No. 10,013,681); IPR2022-00075 (challenging U.S. Patent No. 9,224,136); and IPR2022-00076 (challenging U.S. Patent No. 10,769,598). Pet. 2; Paper 6, 3–4; Paper 8, 2. The parties also identify *inter partes* review petitions (IPR2021-01163 and IPR2021-01248) filed by Patent Owner to challenge the validity of U.S. Patent Nos. 7,949,788 and 8,868,786. Pet. 2; Paper 6, 2.

Patent Owner additionally identifies the following U.S. Patent Application Nos. that claim priority to U.S. Patent No. 8,708,227 (the oldest patent in the '638 patent's family): 15/709,071; 15/709,126; 15/709,143; 16/025,679; 16/025,701; 16/507,595; 16/657,677; and 16/871,681. Paper 6, 4.

C. The '638 Patent

The '638 patent is titled “Digital Camera Processing System.” Ex. 1001, code (54). The '638 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 1:19–20, 1:65–2:8. In addition, traditional check deposit and clearing do not provide quick access to the funds from the check. *Id.* at 2:19–25. Thus, the '638 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 2:23–25. The ’638 patent addresses this need by providing “a system, method and computer-readable medium with computer-executable instructions for remotely redeeming a negotiable instrument,” whereby “computer readable medium bearing instructions . . . configure a customer’s general purpose computer to facilitate a check deposit.” *Id.* at 2:26–30, 2:47–51. “Acting under direction of such instructions, the general purpose computer may instruct a customer, for example via a display coupled [to] such computer, in utilizing an image capture device to generate an electronic image of . . . a check,” whereby “the customer computer, acting under direction of the instructions, may deliver an approved electronic image [of the check] to financial institution electronics.” *Id.* at 2:51–3:2.

Figure 1 of the ’638 patent, reproduced below, illustrates a system for facilitating remote check deposit. *Id.* at 3:10–12, 3:50–55.

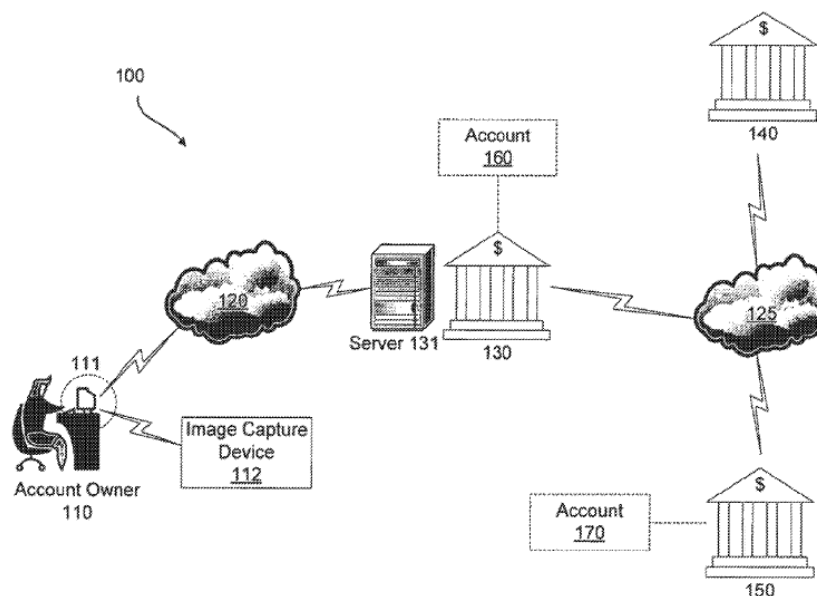


FIGURE 1

Figure 1 illustrates a system for facilitating remote check deposit. *Id.* at 3:10–12, 3:50–55.

Figure 1 depicts system 100 including: (i) “customer-controlled, general purpose computer 111” used by account owner 110 (e.g., a bank customer in a private residence); (ii) “image capture device 112 [that] may be communicatively coupled to the computer 111”; and (iii) financial institutions 130, 140, and 150, such as retail banks, investment banks, investment companies, or other types of entities capable of processing a transaction involving a negotiable instrument. *Id.* at 3:50–4:6, 6:40–44, 7:3–7. Account owner 110 owns account 160 held at financial institution 130. *Id.* at 3:63–65. 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 9:30–34. “[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 9:39–42. Account owner 110 then sends the digital image to financial institution 130. *Id.* at 9:42–44. Upon receiving the digital image, financial institution 130 may credit the funds to account 160. *Id.* at 9:46–52. Financial institution 130 may clear the check by presenting the digital image to an intermediary bank. *Id.*

Figure 5 of the ’638 patent, reproduced below, illustrates a system for facilitating and processing a check deposit transaction. *Id.* at 3:24–28, 10:19–23.

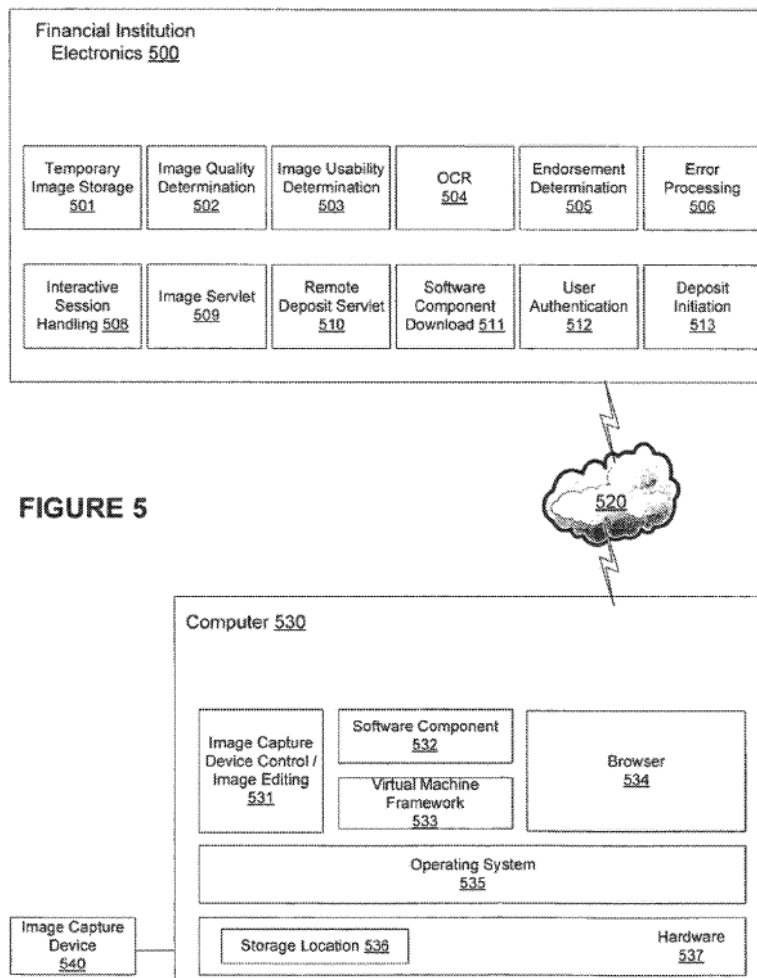


FIGURE 5

Figure 5 illustrates a system for facilitating and processing a check deposit transaction. *Id.* at 3:24–28, 10:19–23.

The system illustrated in Figure 5 facilitates deposit of a check via financial institution electronics 500 that communicates with computer 530 via network 520. *Id.* at 10:19–21. Financial institution electronics/server 500 includes: subsystem 511 for providing software component 532 to customer's/customer-controlled computer 530, to facilitate a deposit while allowing the financial institution to control certain aspects of the check image generation and delivery process; subsystem for user authentication 512 that requires a username and password; subsystem 510 for receiving

from customer's computer 530, an identification of an account for deposit of a check, and an amount of the check; image servlet 509 for receiving from computer 530 an image of the check; subsystems 502 (image quality determination subsystem) and 503 (image usability determination subsystem) for analyzing the check image to determine if it meets at least one criterion; a subsystem for performing Optical Character Recognition (OCR) on the check image, to determine, for example, MICR line information, such as routing number, account number, and check number; error processing subsystem 506 for determining if there is an error in the deposit of the check, and for comparing an amount of the check as provided by the customer to the amount determined by performing OCR on the check image; endorsement determination subsystem 505 for determining if a signature appears on the back side of the check; and subsystem 513 for initiating the deposit of the check into the specified account. *Id.* at 10:19–11:21, 11:38–12:15, 12:25–57.

Customer's computer 530 executes software component 532 to enable check image creation and delivery (to the financial institution) by computer 530. *Id.* at 10:33–40, 12:61–13:3. The customer connects to server 500 using browser application 543 that executes on computer 530. *Id.* at 13:4–12. Image capture device control software and/or image edit software 531 also executes on computer 530. *Id.* at 13:13–27. Software 531 interfaces with image capture device 540 to serve functions such as initiating image capture, managing image retrieval, facilitating image editing, and providing an interface so that it can be controlled to some extent by software component 532. *Id.* Additionally, “at any step along the way, the customer can be instructed to perform certain functions using software 531 or

component 432[sic], if such functions are better performed, or more conveniently performed by a human.” *Id.* The operations performed by computer 530, component 532, image capture software 531, image capture device 540, and the customer may include the following:

providing customer credentials, identifying an account, identifying an amount of a deposit, capturing an image of a front side of a check according to the criteria required by the bank via component 532, cropping and rotating the image of a front side of a check according to the criteria required by the bank via component 532, endorsing and capturing an image of a back side of a check according to the criteria required by the bank via component 532, and delivering such images to server 500.

Id. at 13:32–44.

Figure 6 of the ’638 patent, reproduced below, illustrates an embodiment (software component 600) of software component 532 in a system for facilitating deposit of a check from a customer-controlled general purpose computer. *Id.* at 3:29–32, 13:45–54.

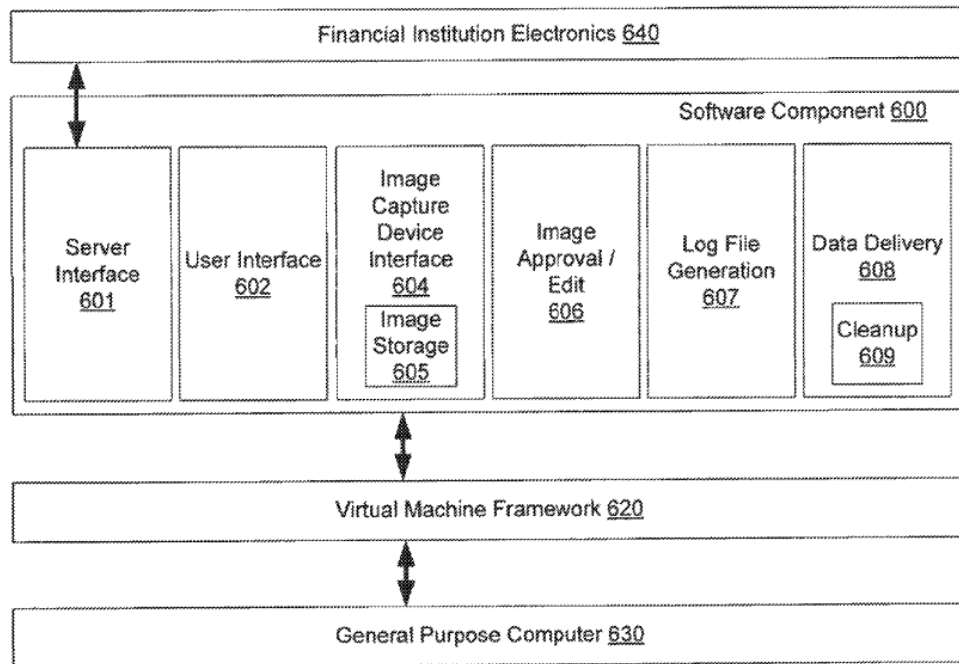


FIGURE 6

Figure 6 illustrates an embodiment (software component 600) of software component 532 in a system for facilitating deposit of a check from a customer-controlled general purpose computer. *Id.* at 3:29–32, 13:45–54.

Software component 600 illustrated in Figure 6 includes functional subsystems 601–609. *Id.* at 13:46–54. Subsystem 602 instructs the customer, via a user interface visible on a display coupled to the customer's computer 630, to use an image capture device to generate an electronic image of a check that meets at least one criterion. *Id.* at 13:63–14:9. For example, the customer may be instructed by subsystem 602 to place the check in a certain orientation. *Id.* Subsystem 604 (an image capture device interface) receives the check image from the image capture device, and enables the image to be immediately uploaded to server 640, or to be temporarily persisted pending certain customer modifications. *Id.* at 14:9–19. Software component 600 further instructs the customer to modify the

electronic check image such that the image meets an additional criterion. *Id.* at 14:40–51. For example, an image as scanned may be presented to the customer, and the customer may be asked to select a bottom right corner of the check in the image. *Id.* The customer’s selection of the bottom right corner of the check may then be used to crop out the image portion that goes beyond the boundaries of the check. *Id.*

D. Challenged Claims

Petitioner challenges claims 1–30 of the ’638 patent. Pet. 4. Of the challenged claims, claims 1, 20, 23, and 28 are independent system claims; claims 2–19 depend from claim 1; claims 21, 22, 26, and 27 depend from claim 20; claims 24 and 25 depend from claim 23; and claims 29 and 30 depend from claim 28. Ex. 1001, 15:20–18:56. Claim 1 recites:

1. A system for allowing a customer to deposit a check using a customer’s own handheld mobile device, the system including:
customer’s handheld mobile device including a downloaded app, the app associated with a bank and causing the customer’s handheld mobile device to perform the following steps:
receiving input entered by the customer indicating an amount of the check;
after the receiving, instructing the customer to take a photo of the check;
using a display of the customer’s handheld mobile device to assist the customer in having a digital camera take the photo of the check;
assisting the customer as to an orientation for taking the photo;
presenting the photo of the check to the customer after the photo is taken; and
using a wireless network, transmitting a copy of the photo over the Internet from the customer’s handheld mobile device and submitting the check for mobile check deposit

in the bank after presenting the photo of the check to the customer;
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 handheld mobile device;
the system being configured to check for errors before the submitting is performed by the customer's handheld mobile device;
the system being configured to confirm that the mobile check deposit can go forward after:
optical character recognition is performed on the check in the photo, the optical character recognition including determining an amount shown on the check, and the amount determined by optical character recognition is compared to the amount entered by the customer; and
the system being configured to update the balance of the account after optical character recognition is performed on a Magnetic Ink Character Recognition (MICR) line of the check in the photo.

Id. at 15:20–61.

E. The Asserted Grounds

Petitioner challenges claims 1–30 of the '638 patent based on the grounds set forth in the table below.

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
23–25, 28–30	103	Oakes-I, ⁴ Oakes-II ⁵
23–25	103	Oakes-I, Oakes-II, Medina ⁶
1–22, 26, 27	103	Oakes-I, Oakes-II, Roach ⁷

⁴ U.S. Patent No. 8,708,227 B1, issued April 29, 2014 (Ex. 1003).

⁵ U.S. Patent No. 7,873,200 B1, issued Jan. 18, 2011 (Ex. 1004).

⁶ U.S. Patent No. 9,129,340 B1, issued Sept. 8, 2015 (Ex. 1005).

⁷ U.S. Patent Application Publication No. 2013/0155474 A1, published June 20, 2013 (Ex. 1006).

Pet. 5. Petitioner supports its showing of unpatentability of the challenged claims of the '638 patent with the Declaration of Dr. Todd Mowry (Ex. 1002).

II. ANALYSIS

A. *Claim Construction*

Petitioner submits that “other than ‘handheld mobile device’ and ‘digital camera,’ resolving potential disputes over [claim terms] is unnecessary because those terms are taught by the prior art references regardless of the construction.” Pet. 9. Petitioner submits that, for purposes of this proceeding, it relies on Patent Owner’s district court construction for the phrase “handheld mobile device” found in U.S. Patent No. 10,013,605 (a grandparent of the '638 patent), that construction allegedly equating the “handheld mobile device” with a “handheld computing device.” *Id.* at 10. Petitioner further applies Patent Owner’s proposed claim interpretation from the litigation where Patent Owner “assert[ed] that the claimed ‘handheld mobile device’ and ‘digital camera’ in the '605 patent are broad enough to read on a mobile device with an integrated digital camera.” *Id.*

Patent Owner submits that “the deficiencies identified in this Preliminary Response are present regardless of which construction the Board adopts for ‘handheld mobile device,’ so no construction is necessary at this time.” Prelim. Resp. 17–18. Patent Owner does not address the construction of “digital camera.” *Id.*

Claim construction in this proceeding is governed by 37 C.F.R. § 42.100(b), which provides:

In an *inter partes* review proceeding, a claim of a patent, or a claim proposed in a motion to amend under §42.121, shall be construed using the same claim construction standard that

would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

Under the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–19 (Fed. Cir. 2005) (en banc), claim terms are given their ordinary and customary meaning, as would have been understood by a person of ordinary skill in the art at the time of the invention, in light of the language of the claims, the specification, and the prosecution history of record. *See Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365–66 (Fed. Cir. 2012). There is a “heavy presumption,” however, that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (citation omitted).

We determine we need not explicitly construe any claim terms for purposes of this Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“we 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. 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 Technology, 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 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).

C. 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 ’638 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. 11 (citing Ex. 1002 ¶¶ 38–40). Patent Owner notes that, “[f]or the purposes of this Preliminary Response only, Patent Owner applies the skill level of a POSITA proposed by Petitioner.” Prelim. Resp. 17.

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 ’638 patent and the asserted prior art.

D. Obviousness Grounds

Petitioner contends that the subject matter of claims 1–30 of the ’638 patent would have been obvious over various combinations of Oakes-I, Oakes-II, Medina, and Roach (collectively, “the asserted references”). Pet. 5, 32–100. Petitioner argues that the asserted references are prior art because the claims of the ’638 patent are not entitled to a priority date earlier than July 28, 2017. *Id.* at 4–5, 11–29. Patent Owner contends that Petitioner fails to establish a reasonable likelihood of success because Petitioner fails to sufficiently show that the asserted references qualify as prior art. Prelim. Resp. 18–59. Having reviewed the parties’ arguments and evidence, we determine that Petitioner has not demonstrated a reasonable likelihood that it will prevail in showing that the asserted references are prior art,⁸ and as a result, Petitioner fails to sufficiently show that any claim would have been unpatentable based on the asserted references.

I. The ’638 Patent’s Priority Claim

The application for the ’638 patent was filed on October 19, 2018. Ex. 1001, code (22). The ’638 patent claims priority through a series of

⁸ “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 the asserted references are prior art to the ’638 patent (*see id.* at 1378).

continuation applications to U.S. Patent Application No. 11/590,974 (“the ’974 application”), filed on October 31, 2006. *Id.* at code (63), 1:6–18.

Oakes-I is a U.S. patent that issued from the ’974 application and has the same specification as the ’638 patent. Ex. 1003, codes (21), (22); *see also* Pet. 29. Thus, Oakes-I is prior art only if the challenged claims of the ’638 patent are not entitled to claim priority to the ’974 application. *See* Pet. 4–5; Prelim. Resp. 18–19. The other asserted references are also prior art only if the challenged claims of the ’638 patent are not entitled to claim priority to the ’974 application: Oakes-II also issued from an application filed on October 31, 2006 (Ex. 1004, code (22)); Medina was filed on December 30, 2010 (Ex. 1005, code (22)); and Roach was filed on February 19, 2013 (Ex. 1006, code (22)).

2. *The Parties’ Dispute*

Petitioner contends that the ’638 patent’s priority claim to the ’974 application is improper because the ’974 application does not provide written description support for the claims of the ’638 patent. Pet. 1, 11–12. Specifically, Petitioner argues that the specification of the ’974 application (Ex. 1007), the ultimate parent application of the ’638 patent, does not provide written description support for the following: (1) “Using an Integrated Digital Camera to Capture an Image of a Check”⁹ (Pet. 13–26); (2) “Checking for Errors Before [the] Handheld Mobile Device Submits the

⁹ Petitioner relies on Patent Owner’s allegations in district court litigation that the terms “mobile device” and “digital camera” as recited in the claims of the ’638 patent are “broad enough to read on a mobile device with an integrated digital camera.” *See* Pet. 10–11, 13–14 (“[Patent Owner] alleges that these claim terms encompass a mobile device with an *integrated* digital camera.”), 32 (“Petitioner applies [Patent Owner]’s constructions and interpretations”).

Check” (*id.* at 26–27); (3) “Claimed Confirming” “that the mobile check deposit can go forward after optical character recognition is performed on the check” (*id.* at 27); and (4) “Claimed Ordering of Steps” specifically (i) “after receiving [of input entered by the customer indicating an amount of the check], instructing the customer to take a photo of the check” and (ii) “initiat[ing] the mobile check deposit after the confirming step is performed” (*id.* at 28–29 (alterations in original)). Petitioner contends that, “[b]ecause these limitations lack written description support in the [’974] application, the ’638 patent claims are not entitled to the claimed 2006 priority date.” *Id.* at 1.

In response, Patent Owner asserts that Petitioner “fails to put forth credible evidence supporting its assertion that the ’638 patent claims lack support in the original specification.” Prelim. Resp. 18. Patent Owner contends that the ’974 application provides written description support for: (1) “Handheld Mobile Device with an Integrated Digital Camera” (*id.* at 23–50); (2) “the Claimed ‘Checking for Errors’ Limitation” (*id.* at 50–54); (3) “the Claimed ‘Confirming’ Step” (*id.* at 54–56); and (4)(i) “‘Instructing the Customer to Take a Photo of the Check’ after ‘Receiving Input Entered by the Customer Indicating an Amount of the Check’” and (ii) “the Claimed ‘Initiating’ Step” (*id.* at 57–59). From this, Patent Owner submits “none of the relied-upon references qualify as prior art to the ’638 patent’s effective filing date of October 31, 2006,” and “there is no basis to institute review.” *Id.* at 18–19.

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 [first paragraph] 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.¹⁰ Petitioner contends the ’974 application does

¹⁰ We consider only the arguments presented in the Petition. Although we do not find these arguments persuasive, 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 ’638 patent.

not provide sufficient written description support for the claims of the '638 patent, because the claims of the '638 patent are broad enough to include “a mobile device with an integrated digital camera” and such a device is not described in the '974 application.¹¹ *See* Pet. 13–26. Notably, elsewhere, Petitioner affirmatively contends that the '974 application discloses a “mobile device” as recited in the claims of the '638 patent. *See id.* at 33 (relying on Oakes-I, which shares a specification with the '974 application, as “teach[ing] a system for allowing a check deposit ‘using a customer’s own handheld mobile device with a digital camera’”). And, similarly, Petitioner affirmatively contends that the '974 application discloses a “digital camera” as recited in the claims of the '638 patent. *See id.* at 34, 36 (relying on Oakes-I, which shares a specification with the '974 application, as teaching a “digital camera”). In fact, Petitioner’s obviousness argument is predicated on these contentions. *See* Pet. 33–34, 36 (arguing that Oakes-I, the patent that issued from the '974 application, alone teaches these limitations). Accordingly, for its written description argument, Petitioner takes issue only with the scope of the claims. *See id.* at 13–16. Petitioner argues that, “[a]fter prosecuting a chain of priority applications, [Patent Owner] pursued claims to a mobile device and a digital camera. The [Patent Owner] now applies these claims to encompass both (1) a mobile device *separate* from the digital camera used to capture check images, and (2) a mobile device with an *integrated* digital camera used to capture check

¹¹ The recited claim language in each of independent claims 1, 20, 23, and 28 of the '638 patent is, “using a display of the customer’s handheld mobile device to assist the customer in having a digital camera take the photo[s] of the check.” Ex. 1001, 15:31–33, 16:53–55, 17:23–25, 18:34–36.

images.” *Id.* at 15 (citations omitted). With regard to claim scope and its written description argument, Petitioner contends, “these claims are not entitled to claim priority to the applications in its priority chain because none of the priority applications provide adequate written description support for a mobile device with an **integrated** digital camera that is used to capture check images.” *Id.* at 15–16. 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 that, “[f]or purposes of this IPR proceeding,” we should understand the claims of the ’638 patent to be broad enough to include a mobile device with an integrated digital camera. Pet. 10–11, 13–14. Second, Petitioner contends that the ’974 application—to which the ’638 patent claims priority—does not describe a mobile device with an integrated digital camera. Pet. 14; *see also id.* at 14–22 (analysis supporting assertion); *cf.* Prelim. Resp. 23 (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 ’974 application does not provide written description support for the claims of the ’638 patent *merely because* the scope of the claims includes a configuration that is not expressly

described in that document. *See* Pet. 15–16, 22. 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 (“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 relies on *Reckitt*, but this case is unavailing. *See* Pet. 13–15 (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.¹² Second, and perhaps more importantly, the case is readily distinguishable on its facts. *See* Prelim. Resp. 23–24 (distinguishing *Reckitt*). In particular, in *Reckitt*, the panel found that claims lacking a pre-vulcanization requirement lacked written description support in the priority

¹² 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).

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 fails [to] identify any suggestion whatsoever in the ’974 Application 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. 24; *see also id.* at 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.

Stepping back, the ’974 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. 1007 ¶¶ 8–9, 19, 29, 33–34, 49–50, Figs. 1–3. 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. 24–27. Moreover, 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. Indeed, the ’974 application broadly describes the image capture device, noting that “a scanner or digital camera” are only examples. Ex. 1007 ¶¶ 33–34. 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.* ¶¶ 19, 21, 29. In light of these disclosures, we find that a person of ordinary skill in the art would have understood the ’974 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 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* is also misplaced. *See* Pet. 23 (citing *LizardTech*, 424 F.3d 1346). As the U.S. Court of Appeals for the Federal Circuit explained, in that case, “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. 12 (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.¹³

¹³ 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.

See Pet. 22–26. According to Petitioner, the device limitation is “a broad genus of a mobile device that can work with either a separate or an integrated digital camera.” *Id.* at 24. Petitioner acknowledges that the ’974 application discloses the former (*see id.* at 22–23), and we find that to be representative of both alternatives, given the ’947 application’s disclosure, as discussed above. See, e.g., Ex. 1007 ¶¶ 8–9, 19, 29, 33–34, 49–50, Figs. 1–3. We also find that a person of ordinary skill in the art would readily recognize the single non-enumerated species from the ’974 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. 25–26 (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. Mowry’s testimony, but it suffers from the same deficiencies as Petitioner’s arguments. See Ex. 1002 ¶¶ 53–69. Moreover, in our view, Dr. Mowry does not sufficiently explain his conclusions regarding what a person of ordinary skill would have

understood the inventors of the '974 application to possess (or not possess), and accordingly, we assign little weight to that testimony. *E.g., id.* ¶ 63; *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 claims are broad enough to encompass a mobile device with an integrated image capture device and that the '974 application does not expressly describe such a device, we do not agree with the arguments raised in the Petition alleging that the '974 application fails to provide written description support for “using a display of [a] customer’s handheld mobile device to assist the customer in having a digital camera take [a] photo of the check,” as required by the claims.

- c) *“check[ing] for errors before the submitting [of the check] is performed by the customer’s handheld mobile device”*

Petitioner also argues that the '974 application does not provide written description support for “check[ing] for errors before the submitting [of the check] is performed by the customer’s handheld mobile device” as recited in independent claims 1 and 20. *See* Pet. 26–27. Independent claims 1 and 20 recite “submitting the check for mobile check deposit” and “the system being configured to check for errors before the submitting is performed by the customer’s handheld device.” Ex. 1001, 15:20–61 (claim 1), 16:44–17:3 (claim 20). Specifically, Petitioner argues that “the '974 Application consistently describes error-checking as being performed by *a server*,” and “[t]he disclosure of a server performing error-checking cannot provide written description support for “*check[ing] for errors before the submitting is performed by the customer's handheld mobile device*” because the server would have received the check only *after* “*the submitting is performed by the customer's handheld mobile device*.” Pet. 26–27. In

support of this argument, Petitioner cites to paragraphs 8 and 61 of the '974 application. *Id.* at 26.

In response, Patent Owner submits that Petitioner's argument is premised on the contention that the '974 application discloses that error checking is "performed solely by a server" and that this premise is incorrect as error checking is also described as being performed at the customer's device. *See* Prelim. Resp. 50–54. Patent Owner cites paragraph 9 of the '974 application (*id.* at 51–52) which provides:

In another embodiment, a novel system may include, for example, a computer readable medium bearing instructions that can configure a customer's general purpose computer to facilitate a check deposit. Acting under direction of such instructions, the general purpose computer may instruct a customer, for example via a display coupled such computer, in utilizing an image capture device to generate an electronic image of a front side of a check, such that said electronic image of a front side of a check meets at least one first criterion such as image size, image legibility, image orientation, image quality, and location and/or orientation of the check within the image. ***Instructions may further be provided for receiving the image of a front side of a check from said image capture device, and optionally instructing the customer to process the image, e.g., by approving the image and/or modifying it to meet at least one second criterion.*** A second criterion might also be, for example, one or more of image size, image legibility, image orientation, image quality, and location and/or orientation of the check within the image. Finally, the customer computer, acting under direction of the instructions, may deliver an approved electronic image to financial institution electronics.

Ex. 1007 ¶ 9 (emphasis added). By providing instructions to the customer to approve the image and/or modify the image to meet certain criteria, the system performs error checking at the customer's general purpose computer

prior to delivering the image to the financial institution electronics (i.e., the server).

The '947 application also describes a system including “component 600[, which] may provide a subsystem 602 for instructing a customer, for example via a user interface visible on a display coupled to a customer-controlled general purpose computer 630, in utilizing an image capture device to generate an electronic image of a front side of a check.” Ex. 1007

¶ 74. With regard to subsystem 602, the '947 application further provides:

Once an image is generated, subsystem 602 may further instruct the customer to process the electronic image of a front side of a check. ***Processing the image may comprise simply approving the image if said image of a front side of a check meets said at least one first criterion.*** This aspect may also be provided by another subsystem such as 606. For example, the image may be presented to the customer and ***the customer may be asked if the image is right side up and legible. If so, the customer may approve the image, for example by selecting an appropriate approval button in the user interface.***

Components 602, 604, 605, and 606 may operate similarly with regard to capturing an image of a back side of a check. The customer may be instructed by 602 to capture an electronic image of a back side of a check meets at least one third criterion, which may in one embodiment be a same criterion as the first criterion, e.g. image size, image legibility, image orientation, and so forth. The image may be received by the component via 604. ***The customer may also be asked to approve by 602.***

Further to being instructed by 602 and/or 606 to process an image, ***a customer may be instructed to modify said electronic image of a front side of a check and / or a back side of the check, such that said electronic image of a front side of a check meets at least one second criterion.*** For example, an image as scanned may be presented to the customer, and the customer may be asked to select a bottom right corner of the check in the image. Assuming the top left corner of the check

is also in the top left corner of the image, the customer selection of the bottom right corner of the check can be used to crop out any and all of the image that goes beyond the boundaries of the check.

Id. ¶¶ 76–78 (emphasis added). In these passages, the '947 application describes error checking at the customer's computer.

In summary, we do not agree with Petitioner's argument because it is based on the false premise that all error checking described in the '974 application is done at the financial institution's server.

d) *“confirm[ing] that the mobile check deposit can go forward after optical character recognition is performed on the check”*

Petitioner argues that “the '974 application does not provide written description support for claimed confirming.” Pet. 27 (capitalization in heading removed). The entire argument in the Petition is reproduced below:

Claims 1-27 of the '638 patent require, in substance, *“confirm[ing] that the mobile check deposit can go forward after optical character recognition is performed on the check.”* This limitation, however, does not find written description support in the '974 Application. The only disclosure of a confirmation is a disclosure that duplicate check detection can “be done in real time, i.e. while the customer waits for **confirmation**...” EX1007, [0061]. This disclosure, however, does not specify what the “confirmation” is supposed to be confirming, much less that the confirmation *“confirm[s] that the [mobile check] deposit can go forward after optical character recognition is performed on the check....”* EX1002, ¶¶73-74.

Id. Petitioner's argument in this regard is not persuasive because it is contradicted by the disclosure of the '947 application.

As pointed out by Patent Owner, this argument fails to take into account the description of “confirmation” in the context of the '947

application. *See* Prelim. Resp. 54–55. Immediately preceding the paragraph that Petitioner cites (i.e., paragraph 61), paragraph 60 describes performing Optical Character Recognition (OCR) on the image of the check to determine “information such as routing number, account number, and check number,” and then validating the information “by comparing it to information such as a list of valid routing numbers, comparing an OCR-determined amount to a customer-entered amount, and so forth.” Ex. 1007 ¶ 60. Paragraph 61 then describes “a subsystem for determining if there is an error in said deposit of said check” which, in one embodiment, comprises “validating a routing number associated with said check” and, in another embodiment, “determining if said check was previously deposited” using the check number. *Id.* ¶ 61. Patent Owner contends:

Petitioner argues that it is somehow unclear what is being confirmed, but this argument is purely conclusory. Notably, Petitioner does not identify anything other than the deposit to which this text could plausibly refer, exactly as the plain language of the claim recites (“confirm that the mobile deposit can go forward after optical character recognition is performed on the check in the photo”).

Prelim. Resp. 55. We agree with Patent Owner that, in this context, the “confirmation” clearly relates to the “determining if there is an error in said deposit of said check” using information obtained after performing OCR on the check.

Patent Owner also argues that, although not using the word “confirm,” there are additional descriptions in the ’974 application of using OCR to confirm that the deposit can proceed. Prelim. Resp. 55–56. As pointed out by Patent Owner, paragraph 62 of the ’974 application describes “comparing an amount of a check as provided by a customer to an amount determined by

performing OCR on said image of said front side of said check” and, “[i]f the numbers do not match, the server can indicate an error and as a result, not proceed with the deposit transaction.” Ex. 1007 ¶ 62.

In summary, contrary to Petitioner’s argument, we determine that the ’974 application provides sufficient written description support for the claimed “confirm[ing].”

e) claimed ordering of steps

Petitioner argues that “[t]he ’974 application fails to provide written description support for the claimed order in which certain method steps are performed.” Pet. 28. Specifically, Petitioner argues that: (1) “after receiving [of input entered by the customer indicating an amount of the check], instructing the customer to take a photo of the check” as recited in independent claims 1 and 28, and (2) “initiat[ing] the mobile check deposit after the confirming step is performed” as recited in dependent claims 3 and 23–25 are not supported by the ’947 application. *Id.* at 28–29 (alterations in original). These arguments are not well developed in the Petition. Each argument consists only of a quote of claim language from the ’638 patent, a quote of a sentence from the ’947 application, and bare conclusions with little or no explanation. *See id.* Although, as discussed below, we consider (and we find not persuasive) these arguments on their merits, we also

determine that Petitioner has not sufficiently supported these arguments with adequate explanations or reasoning.¹⁴

First, Petitioner argues that the '974 application does not support “after the receiving [of input entered by the customer indicating an amount of the check], instructing the customer to take a photo of the check” as recited in independent claims 1 (Ex. 1001, 15:27–30) and 28 (*id.* at 18:30–33) of the '638 patent. *Id.* Both Petitioner (*see* Pet. 28) and Patent Owner (*see* Prelim. Resp. 57) direct our attention to paragraph 71 of the '947 application, which describes “operations that are performed” including “identifying an amount of a deposit [and] capturing an image of a front side of a check according to the criteria required by the bank via component 532.”¹⁵ Ex. 1007 ¶ 71. In considering whether the '947 application

¹⁴ 37 C.F.R. § 42.22(a)(2) provides that a “petition . . . must include: . . . [a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts;” and 37 C.F.R. § 42.104(b)(5) provides that “the petition must set forth . . . the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge. The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to specify specific portions of the evidence that support the challenge.”

¹⁵ “[C]omponent 532” refers to a software component provided by the server 500 of the financial institution (bank) to the user’s computer. *See* Ex. 1007 ¶¶ 53–54, Fig. 5. In discussing the operation of this embodiment, the description of “prompt[ing] a customer to enter information such as an account number and an amount of a check for deposit” in paragraph 56 precedes “software component 532 . . . delivering images” in paragraph 57. *Id.* at ¶¶ 56–57. And, in original system claim 1 of the '947 application, the first element directed to “a subsystem for receiving . . . an amount of said check” precedes the second element directed to “a subsystem for receiving . . . an image of a front side of said check.” *Id.* at 21 (claim 1).

describes the claimed order of these steps, we initially note that identifying the amount of a deposit precedes capturing the image of the check in this passage, and this alone indicates the order of these steps. In the “Summary” section of the ’947 application, the description of “receiving . . . an amount of said check” in paragraph 8 precedes a description of instructing the customer to generate an image of the check in paragraph 9. *Id.* at ¶¶ 8–9. In original method claim 9 of the ’947 application, “receiving . . . an amount of said check” in the first recited step precedes “receiving . . . an image of a front side of said check” in the second recited step. *Id.* at 22 (claim 9). In original claim 17 directed to “[a] computer readable medium bearing instructions,” “instructions for receiving . . . an amount of said check” precedes “instructions for receiving . . . an image of a front side of said check.” *Id.* at 23 (claim 17).

Based on these passages, we find support in the ’974 application for “after the receiving [of input entered by the customer indicating an amount of the check], instructing the customer to take a photo of the check” as recited in independent claims 1 and 28 of the ’638 patent. Accordingly, we do not agree with Petitioner’s contrary argument.

Second, Petitioner argues that “initiat[ing] the mobile check deposit after the confirming step is performed” as recited in claims 3 and 23–25 of the ’638 patent is not supported by the ’947 application. Pet. 29. The entire argument in the Petition is reproduced below:

The ’974 Application explains that “initiating a deposit of a check” “may comprise a wide variety of possible actions, depending on . . . particular bank systems” such as “soft posting,” “forwarding an image,” or “placing data in a batch file.” EX1007, [0066]. But the ’974 Application provides no written description of when any of these possible “initiating”

steps occurs relative to any “*confirming*” step, much less “*confirm[ing] that the mobile check deposit can go forward*,” which, as discussed above, is not even disclosed in the ’974 Application. EX1002, ¶¶78-79.

Id. at 29. As reflected in this passage, Petitioner admits that the ’974 application broadly defines “initiating a deposit of a check” such that this argument is linked to Petitioner’s argument that the ’947 application does not describe “confirm[ing] that the mobile check deposit can go forward.” In the context of the invention claimed in the ’638 patent, the confirming step precedes initiating the deposit. For example, claim 3, which depends directly from claim 1, recites, “the system is configured to initiate the mobile deposit after the confirming step is performed.” Ex. 1001, 15:65–67. And, paragraph 66 of the ’974 application provides this broad description of initiating the deposit:

Server 500 may further comprise a subsystem for initiating a deposit of a check into the specified account 513. Deposit initiation may comprise a wide variety of possible actions, depending on how such operations are initiated in particular bank systems. For example, a deposit might be initiated by ‘soft posting’ or provisionally posting a credit to the customer’s account. It might be initiated by forwarding an image to the payor’s bank or Federal Reserve. It might be initiated by placing data in a batch file for processing all the deposits for the day. Deposit initiation is any action that sets in motion a chain of automated events resulting in a crediting of the customer’s account.

Ex. 1007 ¶ 66. Paragraphs 60–63 of the ’974 application provide a number of examples of performing OCR to confirm information on the check prior to initiating the mobile check deposit as broadly defined in the ’974 application. *See* Ex. 1007 ¶¶ 60–63. Therefore, we are not persuaded by

Petitioner's argument that the '974 application lacks sufficient written description support for "initiat[ing] the mobile check deposit after the confirming step is performed" as recited in claims 3 and 23–25 of the '638 patent.

4. *Summary*

Petitioner's contention that the asserted references qualify as prior art is premised on its contention that the challenged claims of the '638 patent are not entitled to the '974 application's priority date. As explained above, we are not persuaded by Petitioner's arguments that the '974 application fails to provide written description support for the claims of the '638 patent. As a result, we determine that Petitioner has not shown a reasonable likelihood that it will establish that any of the asserted references qualify as prior art. Thus, we determine that Petitioner has not shown a reasonable likelihood that it will prevail with respect to any of the claims of the '638 patent.

III. MOTIONS TO SEAL

There are three joint motions to seal pending: Paper 9 (relating to the Preliminary Response and Exhibit 2006); Paper 13 (relating to the Reply); and Paper 17 (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 Petitioner identified all the real parties in interest in the

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 Guide¹⁶ at 107–122 (App. B, Protective Order Guidelines and Default Protective Order)). Paper 9, 2.¹⁷ 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 11) requested to be sealed can be identified from the redacted version of the Preliminary Response filed as Paper 12. 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 13 (Joint Motion to Seal the Reply) and Paper 17 (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 14) and Sur-reply (Paper 18) 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 Motions to Seal (Papers 13 and 17), the parties have shown good cause for sealing the identified portions of the Reply and Sur-reply.

¹⁶ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

¹⁷ Pages 2–11 of Paper 9 are numbered 1–10, respectively. We refer to the actual page numbers.

For these reasons, we *grant* the three joint motions to seal (Papers 9, 13, 17).

IV. CONCLUSION

For the reasons discussed above, we determine that Petitioner has not demonstrated a reasonable likelihood of showing that at least one of the claims challenged in the Petition would have been obvious.

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 '638 patent is instituted; and

FURTHER ORDERED that the motions to seal (Papers 9, 13, 17) 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.¹⁸

¹⁸ 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.”).

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