

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUIST BANK,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

Case No. IPR2023-00829
Patent No. 11,544,944

**UNITED SERVICES AUTOMOBILE ASSOCIATION (“USAA”)’S
PATENT OWNER PRELIMINARY RESPONSE**

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EXHIBIT LIST

Ex. #	Document
2001	“Bank Will Allow Customers to Deposit Checks by iPhone,” <i>NY Times</i> , Aug. 9, 2009 (available at https://www.nytimes.com/2009/08/10/technology/10check.html)
2002	<i>Wells Fargo Bank, N.A. v. United Services Automobile Association</i> , CBM2019-00029, Paper 13 (PTAB Oct. 1, 2019) (Institution Decision)
2003	U.S. 10,402,638
2004	U.S. 11,023,719
2005	Nokia N95 Datasheet (available at https://t1.daumcdn.net/cfile/tistory/1933BA3550069A5234?download)
2006	GSMarena, “Nokia N80 review,” May 17, 2006 (available at https://www.gsmarena.com/nokia_n80-review-84.php)
2007	Sprint PCS Mobile Browser Technology Paper, Version 1.0, July 2004 (available at http://4ourth.com/downloads/mobilebrowser_sprint-technologypaper.pdf)
2008	Blandford, “30 Minutes With The Nokia 7110,” published April 27th, 2005 (available at http://www.allaboutsymbian.com/features/item/30_Minutes_With_The_Nokia_7710.php)
2009	JP2002140499A
2010	Websydian 6.0 Documentation, “Web Applications in General,” May 26, 2006 (available at https://web.archive.org/web/20060526021611/http://www.websydian.com/websydiandoc/KnowledgeBase/WhitePapers/WebApplications.htm)

STATEMENT OF MATERIAL FACTS IN DISPUTE

Petitioner did not submit a statement of material facts in this Petition. No facts are admitted by Patent Owner.

I. Introduction

The ‘944 patent, which claims priority to an application filed in October 2006, protects USAA’s innovations in remote check deposit technology that resulted in USAA’s industry-first mobile check deposit application. The claims are directed to that system, which “allow[s] a customer to deposit a check using a customer’s own handheld mobile device” by way of a “download app associated with a bank [that] caus[es] the customer’s handheld mobile device” to perform the functions required to facilitate a successful check deposit, including, among other things, assisting the customer as to an orientation for taking photos of the check and transmitting the captured photos to the bank via the Internet for deposit. *See, e.g.*, Ex. 1001, cl. 1.

Petitioner presents six different grounds of invalidity based almost entirely on references that were already before the examiner during prosecution—which occurred recently, as the patent issued only six months ago. With respect to the download app limitations that the examiner found patentable over the prior art, Petitioner offers only conclusory statements about what a person of ordinary skill in the art “would have understood” the prior art to teach, rather than pointing to specific, competent evidence demonstrating the obviousness of all the claimed subject matter at the time of the invention.

In particular, Petitioner’s obviousness grounds are all based on primary references that do not themselves disclose a customer’s handheld mobile device

including a downloaded app associated with a bank that performs the claimed functionality, so it must rely on a secondary reference (King) to suggest and motivate that functionality. However, the only alleged motivation to implement a downloaded application is that, per King, such applications have the benefit of providing “uninterrupted functionality while offline”—a purported benefit having no relevance to the claimed invention that requires the customer’s device to be online and transmit captured check photos wirelessly via the Internet to the bank for deposit.

Petitioner’s analysis of the claims’ requirement that the downloaded app cause the mobile device to “assist the customer as to an orientation for taking the photo” also fails to engage with the actual claim language. Again lacking disclosure of this functionality in its primary references, Petitioner turns to secondary references King and Watanabe to supply the claimed assistance with orientation of the check, but only identifies generic disclosure of a camera “viewfinder” (in King) or positioning of a camera over top of a document (in Watanabe) rather than the orientation assistance required by the challenged claims.

As the Supreme Court held in *SAS Institute v. Iancu*, 138 S. Ct. 1348 (2018), “in an inter partes review the petitioner is master of its complaint.” *Id.*, at 1355. Here, Petitioner’s fundamental failure to “specify where each element of the claim is found in the prior art patents or printed publications relied upon” in its petition requires

denial of institution. *See, e.g.*, 37 C.F.R. § 42.104(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”); *Amazon Web Services, Inc. et al. v. St. Regis Mohawk Tribe*, IPR2019-00103, Paper 22, at 16 (PTAB May 10, 2019) (“Our rules require that a petition specify with particularity where each element of a claim is found in the prior art, and include a detailed explanation of the relevance of the prior art to the claim.”); *PNC Bank, N.A. v. United Services Automobile Association*, IPR2022-00049, Paper 22, at 20-21 (PTAB Apr. 27, 2022) (denying institution where articulated rationale for combination was “too general and conclusory to [be] accorded much weight and [] inadequate to support the finding of rationale to combine”).

II. Summary of the Challenged Patent and Prosecution History

The '944 patent is based on an application filed in 2006 and is the work of USAA's Innovation Lab, a group of engineers and technologists who work on disruptive technology solutions. When USAA launched mobile device check capture, it was immediately lauded by the industry with analysts “predict[ing] that other banks would follow USAA[.]” Ex. 2001 at 2.

The '944 patent discloses a technical solution to providing a remote check deposit system employing a customer's handheld mobile device with a downloaded app that controls the mobile device and digital camera. The specification describes

a customer device that can have installed on it electronically an application that controls the device and performs the steps of mobile check deposit. The customer device is not a purpose-built check scanner. Ex. 1001, 4:16-27. But of equal importance, the customer device is not a passive terminal; the installation of the application turns it into a specialized device that can deposit check images. *Id.*, 5:54-60 (“The owner of such a computer typically has the power to install programs and configure the computer as they wish”); *see also id.*, 10:41-45 (“[T]he customer downloads component 532 to facilitate a deposit...”).

The challenged claims recite a handheld mobile device with a downloaded app that causes the handheld mobile device to perform the recited operations including assisting the customer to take a photo of the check for deposit. *See, e.g.*, Ex. 1001, cl. 1 (“the system including: a customer's handheld mobile device including a downloaded app, the downloaded app associated with a bank and causing the customer's handheld mobile device to: ...”). In a previous institution decision involving the parent ’605 patent, the Board found that a POSITA would understand that there were ““technical challenges associated with capturing sufficient quality images such that they could be recognized by a machine,’ such as ‘the problem of skewing during image scanning”” *See* Ex. 2002 (CBM2019-00029, Paper 13), at 21. In particular, “inadequate imaging of checks (such as described above with respect to image quality and/or skewing) would result in errors in electronic

checking transactions” *Id.* Through the work of its Innovation Lab, USAA overcame these challenges and became the first bank to commercialize mobile check deposit technology, allowing USAA customers to capture check images using a phone app and submit them for deposit. See Ex. 2001, at 1 (“The Internet has taken a lot of the paperwork out of banking, but there is no avoiding paper when someone gives you a check. Now one bank wants to let customers deposit checks immediately – through their phones. USAA ... plans to update its iPhone application this week to introduce the check deposit feature, which requires a customer to photograph both sides of the check with the phone’s camera.”).

All but one of Petitioner’s asserted references—Garcia, King, Slater, Randle, and Watanabe—were provided to the USPTO and the examiner during prosecution of the ‘944 patent. See Ex. 1002, at 2-6, 14-16, 385-426, 984-1025. The only new reference relied upon by Petitioner is Kiessling, which Petitioner uses only in Grounds 3a and 3b and does not even contend discloses the elements missing from Petitioner’s combinations, i.e., the “downloaded app” and “assist the customer as to an orientation for taking the photo” limitations.

Petitioner does not deny that these references were available to the examiner during prosecution but asserts that they were somehow “buried” because a large number of references are cited on the face of the ‘944 patent. See Pet., at 78-79. However, a review of the actual prosecution history indicates that the examiner had

the relevant references at hand and simply concluded that they did not disclose or render obvious the applicant's claims. For example, Garcia was identified to the examiner in a supplemental IDS with only 18 other references. *See* Ex. 1002, at 6. Yet, shortly after considering this supplemental IDS, the examiner concluded that the "closest prior arts of record are Singfield ... and Hicks" and found the claims allowable over the prior art. Ex. 1002, at 10. Petitioner's assertion that Garcia contains crucial new disclosures that are absent from the other prior art of record is belied by the examiner's issuance of the notice of allowance after considering the supplemental IDS. *See id.* King was similarly provided to the examiner in a supplemental IDS with 80 other items, not thousands as Petitioner claims. *See* Ex. 1002, at 14-16. And while Watanabe, Slater, and Randle were included in longer IDS disclosures, that is because the applicant was—consistent with its duty of disclosure—re-submitting references that had been considered in prior prosecutions of patents in this family. *See, e.g.,* Ex. 2003, at 3-4, 6 (parent '638 patent identifying Watanabe, Slater, and Randle); Ex. 2004 at 3-4, 6 (grandparent '719 patent also identifying Watanabe, Slater, and Randle). Notably, both the '638 and '719 patents were examined by the same primary examiner, I Jung Liu, as the '944 patent. *See* Ex. 1001, Cover; Ex. 2003, Cover; Ex. 2004, Cover.

Moreover, the examiner indisputably considered the Singfield reference—which Petitioner asserts "discloses online check deposit transactions using an

Internet-capable mobile device that downloads computer program software”—and allowed the claims over it and the other prior art. *See* Ex. 1002, at 10-11 (identifying Singfield as the “closest prior art[] of record” but nonetheless failing to disclose, in combination with the other prior art, numerous limitations including “a downloaded app associated with a bank to control the camera software and to control submitting a check for deposit by causing the customer’s handheld mobile device to perform the [claimed] steps”).

III. The Petition Provides No Competent Evidence That A POSA Would Have Been Motivated To Modify Garcia or Kiessling To Use A Downloaded App As Required By All Challenged Claims

Each challenged claim requires, among other things, “a customer’s handheld mobile device including a downloaded app, the downloaded app associated with a bank and causing the customer’s handheld device to” perform various claimed functions including assisting the customer in capturing a photo of a check and then “using a wireless network, transmit[ing] a copy of the photo over the Internet from the customer’s handheld mobile device to the bank.” *See, e.g.,* ‘944 Pat., cl. 1.

Neither of Petitioner’s base references—Garcia and Kiessling—disclose a handheld mobile device including a downloaded app at all, much less using a downloaded app for the particular functions claimed. The only reference to an “application” anywhere in Garcia is the statement that the “equipment needed by the user must enable...identifying the user, wherein the user opens a computer

application on the mobile telephone in which an interactive session is established.” Garcia, at 9:18-22.¹ Garcia does not describe this as a downloaded application, nor does Petitioner argue (or provide any supporting basis) that downloading is inherent. To the contrary, Garcia describes the “computer application” as being part of the functionality that the “equipment needed by the user” must supply. *See id.* Mobile phones in 2006 commonly had, for example, camera, browser, and connectivity applications pre-installed on them. *See, e.g.,* Ex. 2005 (Nokia N95 spec sheet including “True web experience with Nokia Web Browser,” “3.5G” wireless connectivity, and “5 megapixel camera” with “on-device photo and video editor”); Ex. 2006 (Nokia N80 review noting “3 megapixel camera,” “advanced connectivity technologies,” and “incredible web browser”); Ex. 2007, at 7 (2004 white paper summarizing built-in web browsers by device manufacturer); Ex. 2008 (describing the 2005 Nokia 7710: “The built-in Opera web browser is as fast and shiny as usual, and allows you to browse in landscape mode with rich graphic resizing, and the ability to visit sites running Macromedia Flash 6.”).

¹ This Preliminary Response follows the Petition’s convention of citing to the internal page:line numbers present in the English-translated portion of Ex. 1005 beginning at page 27 of the exhibit.

Garcia confirms this, elsewhere describing that the “equipment needed by the user” is “a mobile device equipped with a built-in camera that is capable of capturing and transmitting digital images, in addition to performing standard telephone operations,” again without mentioning any need to download any software to the device to use this functionality. *Id.* at 4:13-19. Similarly, Garcia discusses existing systems for executing functions “through a mobile telephone connected to the internet,” e.g., by “display[ing] menus and forms from a given institution,” such as via a “web browser,” rather than downloading an application associated with that institution that controls the user’s device and causes it to perform mobile deposit functionality. *See, e.g., id.* at 3:1-7 (referring to Ex. 2009, which describes “provid[ing] a sales support menu showing a list of sales support functions to a browser of the mobile phone” via an Internet-accessible server); *see also id.* at 2:17-23 (highlighting various prior art documents discussing “making payments, billing, or performing other bank account transactions through a mobile telephone or other mobile terminal, such as a PDA,” none of which describe the use of a downloaded application); Ex. 2009, at 27 (¶ [0010]).

Petitioner simply asserts that a POSA “would have understood that Garcia’s [computer application] is a downloaded app associated with a bank” and that “Garcia’s mobile check deposit requires downloading an app associated with a bank,” but neither the Petition nor the expert declaration support those conclusory

assertions with evidence. *See* Pet., 24 (citing Doermann, 69-70). The sole cited support is an article discussing a “mobile phone banking venture” (unrelated to check deposit) in South Africa allowing customers to “transfer money, pay bills, or buy prepaid mobile airtime on their handsets.” *See* Ex. 1013, 1. The article generally states that one way customer can use that system is to “download” unspecified “banking software to their phones,” but this does nothing to support Petitioner’s conclusory assertion that Garcia’s bare reference to a “computer application” necessarily refers to “downloading an app associated with a bank.” To the contrary, the article itself states that the venture would also be available without downloading software, stating, “[s]tarting next year, the banking-services menu will be embedded on all SIM cards offered by MTN, including the prepaid SIM cards most South Africans use.” *Id.*

A POSA would thus have been well aware that all of the functionality described in Garcia, e.g., “identifying a user,” establishing an “interactive session,” entering information via a keypad, capturing photos, and transmitting information via the Internet, could be—and commonly was—implemented without the use of any downloaded applications. *See, e.g.,* Ex. 2010, at 1 (“As a user access technology, Web Browsers are simply unsurpassed: No other technology enables users on so many different platforms to access both information and applications.”), 2 (“Using HTML’s powerful <FORM> feature, which allows the user to enter data into the

application, Web Browsers can serve as user interface for a wide range of applications.”), 2 (“Web Applications are installed on the Web Server . . . All that must be installed [on the user’s device] is the Web Browser, and it can be used to access many different Web Applications.”).

Moreover, Petitioner does not contend that Kiessling discloses any downloaded application. *See* Pet. at 68-69 (relying entirely on alleged combination with King for downloaded application elements). To the contrary, Petitioner acknowledges when discussing Kiessling that mobile phones at the time of the invention were known to include pre-installed software such as camera software that (according to Petitioner) would be used to implement the functionality recited in the claims. *See* Pet., at 68 (not arguing that Kiessling discloses any downloaded application and stating, “Kiessling’s mobile communication device includes camera software that controls the digital camera.”).

Lacking disclosure of the downloaded app limitations in its primary references, Petitioner argues in the alternative that a POSA would have been motivated by King to utilize a downloaded application for the claimed functionality. *See* Pet., 24-25 (discussing Garcia/King), 68-69 (relying, for its Kiessling/King combination, on same obviousness rationale discussed previously with respect to Garcia/King). Specifically, Petitioner asserts that because “King explains that ‘modern phones have the ability to download software that could implement some

parts of the system’ to provide uninterrupted functionality while offline,” a POSA would have been motivated to implement a “downloaded application” into Garcia and/or Kiessling’s systems. *See* Pet., 24 (citing King, [0306], [0227]). But neither Petitioner, nor its declarant, provide any explanation as to why a desire to “provide uninterrupted functionality while offline” would motivate a POSA to use a downloaded application to implement the particular functionality recited in the challenged claims here. To the contrary, here the claimed functionality requires the downloaded application to, among other things, perform recited functions **online**, for example causing the mobile device to use a “wireless network” to “transmit a copy of the [captured check] photo over the Internet from the customer’s handheld mobile device to the bank.” *See, e.g.*, ‘944 Pat., cl. 1.

Moreover, nothing in King’s disclosure actually supports the motivation asserted by Petitioner here. Paragraph [0227] simply states that it is “desirable to allow the system to continue to function usefully” when “offline”; it does not teach that a downloaded application be used to achieve that functionality (which, as discussed above, is inapplicable to the present inventions). *See* King, [0227]. Paragraph [0306] of King states that “modern phones have the ability to download software that could implement some parts of the system,” but “the system” being discussed is “text capture...through voice recognition,” which King explains can be performed either locally via the phone or “by a system at the other end of a telephone

call.” *See* King, [0306]. Thus, in that instance, it is possible to implement the functionality within the mobile phone itself, although King itself warns that implementing the functionality via downloaded software “is likely to be suboptimal in many situations...for example when there is substantial background noise, and accurate voice recognition is a difficult task at the best of times.” *Id.* There is nothing in King suggesting to a POSA that it would be desirable to implement mobile deposit functionality, such as the wireless transmission of captured check photos recited in the challenged claims, in an offline form via a downloaded application.

IV. The Petition Does Not Identify Disclosure Of The Mobile Device “Assist[ing] The Customer As To An Orientation For Taking The Photo”

Each challenged claim requires that the downloaded app, among other things, cause the customer’s handheld mobile device to “assist[] the customer as to an orientation for taking the [check] photo.” *See, e.g.,* EX1001, cl. 1. Petitioner’s primary references, Garcia and Kiessling, contain no disclosure regarding assisting the customer as to an orientation for taking photos of a checks, which Petitioner appears to concede by relying on either King (Grounds 1a, 2a, and 3a) or Watanabe (Grounds 1b, 2b, and 3b) as purportedly teaching the limitation and motivating a POSA to combine those teachings with Garcia or Kiessling. *See, e.g.,* Pet., at 14-16, 31-33, 70-71. But Petitioner fails to identify disclosures in King or Watanabe that actually supply the limitations missing from Garcia/Kiessling, and thus has failed to

present a prima facie case of obviousness under any of its asserted grounds. *See, e.g., PAR Pharm. v. TWI Pharms.*, 773 F.3d 1186, 1194 (Fed. Cir. 2014) (“We first must determine whether TWi carried its burden to prove that all claimed limitations are disclosed in the prior art.”); *In re Miller*, 2022 WL 594417, at *4 (Fed. Cir. Feb. 28, 2022) (“all claim limitations must be taught or suggested by the prior art to establish obviousness of a claimed invention”); *accord* 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”).

1. Grounds 1a, 2a, and 3a (King)

In Grounds 1a, 2a, and 3a, Petitioner relies on paragraph [307] of King, which states that “the camera built into many mobile phones is used to capture an image of [] text” and the “phone display, which would normally act as a viewfinder for the camera, may overlay on the live camera image information about the quality of the image and its suitability for OCR, which segments of text are being captured,” or a “transcription of the text if the OCR can be performed on the phone.” EX1009, [0307]. But Petitioner identifies no disclosure in King, or in the primary references Garcia or Kiessling, regarding the mobile device assisting the user as to an orientation for taking the photo of a check—much less doing so using a downloaded application. *See Pet.*, 31-33, 70-71.

Instead, Petitioner primarily argues that the mere presence of a “viewfinder” satisfies this limitation because “the very purpose of a view finder and live display of the camera image is to allow the customer to properly frame and orient the photograph.” Pet., 31. But even if this were true, the mere fact that a customer could utilize the camera viewfinder as a tool to make his or her own judgment about the orientation of the camera with respect to the check being photographed is not the same as the *mobile device*, under the control of a downloaded app, “*assisting* the customer as to an orientation for taking the photos.” See, e.g., EX1001, cl. 1. Because the customer would always have the ability to adjust the orientation of the camera regardless of what functionality was being provided via the downloaded app’s control of the mobile device, Petitioner’s interpretation would read the “assisting...” limitation out of the claims entirely. See *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”); *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (“The purpose of a patent claim is to define the precise scope of a claimed invention....For that reason, claims are interpreted with an eye toward giving effect to all terms in the claim.”).

Petitioner’s only alternative argument with respect to King is that because King purportedly teaches “overlaying ‘information about the quality of the image and its suitability for OCR...,’” a customer could use that information to “adjust the

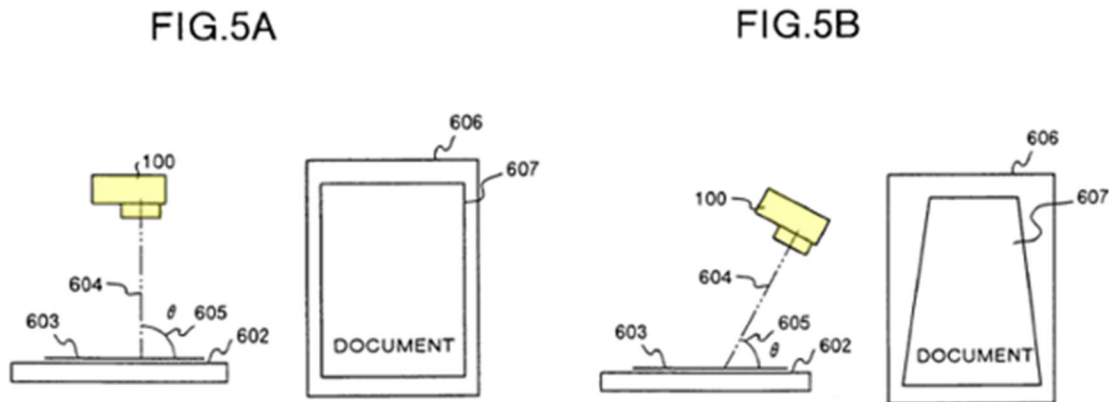
orientation of the document accordingly” and so satisfy the claim limitation. *See* Pet., at 32. Again, Petitioner identifies nothing in King (or any of the other references used in the asserted combinations) suggesting a relationship between “information about the quality of the image and its suitability for OCR” and a downloaded app (which Petitioner acknowledges is not present in King), via the mobile device, “assisting the customer as to an orientation for taking the [check] photos.”

At most, Petitioner asserts that improper orientation of a document could prohibit performing OCR, but never explains how informing the customer that OCR cannot be performed is “assisting the customer as to an orientation for taking the [check] photos” as required by the claims. *See id.* Petitioner’s own cited references also identify numerous other factors that can inhibit the ability to perform OCR on a document captured by a mobile device—for example, “variable lighting conditions, shadowing, defocusing effects due to the optics of the imaging devices, fisheye distortions of the camera lenses” as well as the limited “pixel resolution” of such devices. *See, e.g.,* EX1012, [0021]-[0023]. Petitioner’s interpretation would result in absurd scenarios where, for example, alerting the customer as to an OCR/readability issue with a check image that is correctly oriented but out of focus or poorly lit would nonetheless satisfy the claims’ requirement to assist the customer as to an orientation for taking photos of a check.

2. Grounds 1b, 2b, and 3b (Watanabe)

In Grounds 1b, 2b, and 3b, Petitioner instead relies on Watanabe's disclosure that "photography is started only when the angle of photography is substantially vertical to the surface of the subject." *See, e.g.*, Pet., 32-33 (citing Watanabe, 2:55-61, 8:9-16, and Fig. 5B). Petitioner does not contend that Watanabe performs any of the identified functionality using a downloaded application. Moreover, the disclosures of Watanabe that Petitioner relies on in these alternative grounds do not actually teach the mobile device assisting the customer as to an orientation for taking the photo at all; rather, they describe the conditions under which Watanabe's system will begin "photography,"² i.e., when the digital camera is held above the document, rather than to the side, as illustrated in Watanabe's Figure 5 that is cited by Petitioner:

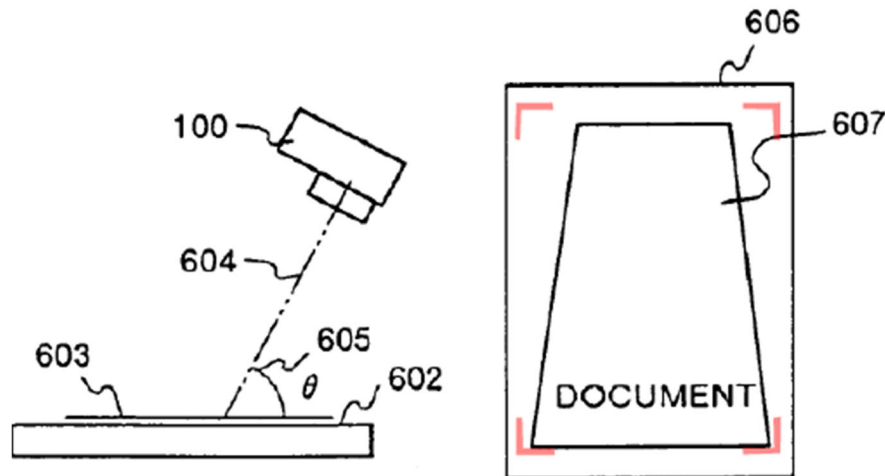
² Watanabe's system also requires other steps to be performed in order for a photograph of a document to be captured, e.g., the customer must press a "release button to instruct photographing." *See* EX1007, 3:60-62, 8:9-16.



Watanabe, Fig. 5 (highlighting added to indicate “digital camera” 100). There is nothing in Fig. 5 that discloses assisting the customer as to an orientation of the check photo; as illustrated above, the figures simply show how the document (element 607) appears within the LCD screen (element 606) depending on where the camera is located. *See id.* The ‘944 patent, by contrast, claims a downloaded app that controls the mobile device to provide assistance to the customer as to an orientation for taking the photos, e.g., “instruct[ing] [the customer] to place the check in a certain orientation” so that the “[check] image thus produced will meet criteria such as being upright and at a ‘right angle’ with respect to a rectangular image format.” *See* EX1001, 14:9-13.

Petitioner’s theory appears to be that the accompanying description of Figs. 5A/5B nonetheless shows that “Watanabe’s camera displays a guidance frame and messages assisting a customer with achieving a proper orientation of the document.” *See* Pet., 15 (citing Watanabe, 7:55-8:26). The Petition includes an altered version

of Watanabe's Fig. 5B, with red markings added by Petitioner purporting to "annotate [the figure] as disclosed by Watanabe":



Pet., 16. But contrary to the characterization by Petitioner's attorneys, the cited passage of Watanabe at 7:55-8:26 contains no discussion whatsoever of displaying a guidance frame or messages, much less the device assisting the customer as to the orientation of the check in the photo; rather, it describes how, as illustrated in Figs. 5A and 5B, the camera must be positioned vertically over the document in order to photograph it. *See* Watanabe, 7:55-8:26. And neither Figs. 5A/5B nor the cited description at 7:55-8:26 disclose anything like the red brackets that Petitioner added as "annotation" to the figure at page 16 of the Petition.

To the extent Watanabe discusses "guidance frames," it does so in the context of allowing the user to determine the "location of a document" and compare it to the "aspect ratio" of a paper document. For example, Watanabe states that the guidance frame may be displayed, in certain embodiments, "so that the user can recognize the

area at the aspect ratio of regular-size paper.” *See* Watanabe, at 8:44-47. Watanabe goes on to explain that the purpose of such a frame is to indicate, when the “destination [of the document] is a printer,” what paper size (e.g., “A4 size”) will be used for printing. *See id.* at 12:60-13:1. “When the destination is a computer, on the other hand, is it not required to match the image with the paper size, therefore, the guidance frame need not be displayed.” *Id.* at 13:1-4. In other words, Watanabe does not actually suggest use of its guidance frame in the proposed combinations³, and even if it did it does not teach using the guidance frame to assist with positioning the camera vertically over the document as illustrated in Figs. 5A/5B, much less using it to assist the user in properly orienting a check in the image. *See In re Miller*, 2022 WL 594417, at *4 (“all claim limitations must be taught or suggested by the prior art to establish obviousness of a claimed invention”); 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”).

³ Notably, all of the challenged claims here require “transmitting a copy of the [captured] photo over the Internet” and “submitting the check for mobile check deposit” to a bank, where a “bank computer” or “computer associated with the bank” processes the mobile check deposit. *See, e.g.*, EX1001, cls. 1, 14, 17.

V. CONCLUSION

Based on the foregoing, the Board should decline to institute *inter partes* review of the '944 Patent.

Dated: July 25, 2023

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I hereby certify, pursuant to 37 C.F.R. section 42.24, that the foregoing Patent Owner Preliminary Response contains 4,638 words, excluding the words in the table of contents, table of authorities, mandatory notices under section 42.8, this certificate of word count, certificate of service or exhibit list. The word count is based on the word count of the Microsoft Word program used to prepare the Patent Owner Preliminary Response.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. section 42.6, the undersigned certifies that on July 25, 2023, a complete copy of the foregoing document **USAA’S PATENT OWNER PRELIMINARY RESPONSE** and **EXHIBITS 2001-2010** were served upon the following, by ELECTRONIC MAIL:

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