

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

REGIONS BANK,

Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,

Patent Owner.

Case No. IPR2025-01356

U.S. Patent No. 12,211,095

PATENT OWNER REQUEST FOR DISCRETIONARY DENIAL

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PATENT OWNER'S EXHIBIT LIST

EXHIBIT LIST	
2001	National Judicial Caseload Profile - US District Courts June 30, 2024
2002	Docket Control Order in <i>United Services Auto Ass'n v. Regions Bank</i> , No. 2:25-cv-00082-JRG (E.D. Tex.) dtd May 30, 2025 (Dkt. 32)
2003	Second Amended Complaint in <i>United Services Auto Ass'n v. Regions Bank</i> , No. 2:25-cv-00082-JRG (E.D. Tex.) dtd June 23, 2025 (Dkt. 41)
2004	Defendant's Invalidity and Patent-Ineligibility Contentions in <i>United Services Auto Ass'n v. Regions Bank</i> , No. 2:25-cv-00082-JRG (E.D. Tex.) served July 9, 2005
2005	Docket Report for <i>United Services Auto Ass'n v. Regions Bank</i> , No. 2:25-cv-00082-JRG (9/23/2025)
2006	Plaintiff's Preliminary Infringement Contentions in <i>United Services Auto Ass'n v. Regions Bank</i> , No. 2:25-cv-00082-JRG (E.D. Tex.) served May 14, 2025
2007	Ex. 1004 from IPR2022-00076 (U.S. Pat. Pub. No. 2006/0249567 to Byrne)
2008	LegalMetric Report EDTX
2009	Ranjan – Using a Camera with Windows Mobile 5

I. INTRODUCTION

Pursuant to Acting Director Stewart’s March 26, 2025 Memorandum entitled “*Interim Processes for PTAB Workload Management*” (“March 26 Memo”), Patent Owner United Services Automobile Association (“USAA”) respectfully requests that the Director exercise discretion to deny institution of Petitioner Regions Bank’s Petition for *inter partes* review of U.S. Pat. No. 12,211,095 (“the ’095 Patent”).

First, the Petition should be denied pursuant to *Fintiv*. The district court in *United Services Automobile Association v. Regions Bank*, Case No. 2:25-cv-00082-JRG (E.D. Tex.) has scheduled a jury trial on the ’095 Patent more than ***four months before*** the expected date of the Final Written Decision. Furthermore, Petitioner has not mitigated the problem of overlap and inconsistent outcomes because it has submitted a standard *Sotera* stipulation that permits litigation of overlapping and duplicative invalidity theories in district court. Ex. 1081.

Second, the Petition should be denied under Section 325(d) because the same or substantially the same prior art was presented to the Office during the original prosecution of the ’095 Patent. For Ground 1 (Garcia, Luo, Cohen, and Meier) asserted against the independent claims, three of the four references—Garcia, Luo, and Cohen—were considered by the Examiner during prosecution.

The one reference that is added, Meier, is cumulative of the Byrne reference (Ex. 2007) that was already considered during prosecution.

Likewise, for Ground 5 (Garcia, Luo, Cohen, and Goyal) asserted against the independent claims, three of the four references (Garcia, Luo, and Cohen) were considered during prosecution. The one reference added, Goyal, is cumulative of the Byrne reference already considered during prosecution.

Third, institution should be denied because Petitioner's invalidity grounds are based on an extensive 254-page expert declaration that is repeatedly used to supply limitations missing from the references of the grounds. See Ex. 1002.

Finally, institution should be denied because Patent Owner USAA has settled expectations by virtue of having made a substantial investment over the years in its mobile deposit auto-capture patents by developing the invention, practicing the invention, licensing the invention, and asserting the patents.

II. THE DIRECTOR SHOULD EXERCISE DISCRETION PURSUANT TO *FINTIV*

The Director should deny institution under 35 U.S.C. §314(a) because the *Fintiv* factors strongly favor discretionary denial. The *inter partes* review statute leaves institution entirely at the discretion of the Director.

The Director has historically applied that discretion where efficiency considerations stemming from parallel proceedings on the same patent warrant denial of institution. *See NHK Spring Co. v. Intri-Plex, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (prec., designated May 7, 2019) (“*NHK Spring*”). The Director considers six factors for determining whether efficiency and fairness support the exercise of authority to deny institution based on a parallel proceeding. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (prec., designated May 5, 2020) (“*Fintiv I*”), 5-16; *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (order denying institution) (inform., designated July 13, 2020) (“*Fintiv II*”), 7-8.

Here, the *Fintiv* factors strongly weigh in favor of discretionary denial.

A. *Fintiv* Factor 2

The proximity of the court’s trial date to the Board’s projected statutory deadline for a Final Written Decision strongly weighs in favor of denial. For this IPR, a Final Written Decision (“FWD”) is due by February 13, 2027. *See* 35 U.S.C. §314(b); 35 U.S.C. §316(a)(11); Paper 4 (NFDA).

In the parallel EDTX action, the trial is scheduled for October 5, 2026, which is more than *four months* before the due date for the FWD in the IPR. Ex. 2002 (Docket Control Order), 1. The result is about the same when considering the

median time-to-trial statistics for the parallel litigation in EDTX. Ex. 2001, 35 (21.6 mo.); Ex. 2002 (complaint: Jan. 28, 2025), 5. These statistics indicate that the trial would occur in November 2026. Thus, the EDTX trial will take place three to four months before the FWD.

This weighs heavily in favor of discretionary denial. *See Fintiv I*, 9; *Ericsson Inc. v. Collison Communications, Inc.*, IPR2022-01233, Paper 12, (PTAB Jan. 19, 2023), 12-13 (“weighs in favor of denying institution, given that we would not expect to issue a final written decision until at least four months” after trial). *See also Full-Metal-Power B.V. v. InFocus Downhole Solutions USA LLC*, IPR2025-00391, Paper 14 (Director Review June 25, 2025) at *2 (non-institution where trial scheduled one month ahead of FWD); *Shenzen Tuozhu Technology Co., Ltd., v. Stratasys, Inc.*, IPR2025-00354, Paper 11 (Director Review June 12, 2025), at *2 (“it will be inefficient to maintain two parallel proceedings” where trial scheduled one month before FWD); *Samsung Electronics Co., Ltd. v. Genghiscomm Holdings, LLC*, IPR2025-00899, Paper 10 (Director Review Sept. 26, 2025), at *2 (discretionary denial because “it is unlikely that a final written decision in this proceeding will issue before the district court trial occurs, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions”); *Telsa, Inc. v. Granite Vehicle Ventures LLC*, IPR2025-00943, Paper

17 (Director Review Sept. 26, 2025), at *2 (discretionary denial even though patent issued in 2023 because trial that is scheduled one to four months before FWD means that it “is unlikely that a final written decision in this proceeding will issue before the district court trial occurs, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.”).

In short, granting institution here would frustrate one of the primary objectives of the AIA which is “to provide an effective and efficient **alternative**” to parallel litigation. *NHK Spring*, 19-20 (cited omitted).

B. *Fintiv* Factor 4

The fourth *Fintiv* factor, relating to overlap between issues raised in the petition and in the parallel proceeding, also strongly weighs in favor of denying institution. *Fintiv I* at 12. The Petition challenges independent Claims 1, 9, 18, and 26 (Pet., 8), which are asserted in the litigation. Ex. 2006 (infringement contentions, citation to bates-numbered pages), 3, 21.

The same grounds set forth in the petition (Pet., 8) are found in the invalidity contentions that were served in the parallel suit while Petitioner was preparing this Petition. See Ex. 2004 (invalidity contentions, citation to bates pages), 12 (Cohen), 13 (Garcia, Luo, Yoon), 14 (Meier, Goyal), 57 (Attia), 63 (Attia), 95 (Garcia, Luo, Meier/Goyal, and Cohen; Garcia, Luo, Meier/Goyal, Cohen, and Yoon).

The contentions also assert invalidity based on so-called system art (“public knowledge and uses and/or offers for sale or sales”) outside the ambit of Petitioner’s standard *Sotera* stipulation. Ex. 2004, 15; Ex. 1081. Further, the invalidity contentions assert that every patent or printed publication (including Garcia, Luo, Meier, Goyal, Cohen, Yoon, and Attia) is also system art that would be outside the reach of Petitioner’s *Sotera* stipulation. Ex. 2004, 6 (a reference can be deemed system art “irrespective and independent of the reference’s disclosure as a patent or a printed publication.”). Petitioner thus reserves the right to recharacterize references to take advantage of the loophole in its *Sotera* stipulation to present combinations based on the same references presented in this IPR. *See, e.g., id.* at 94-95. If that is not enough, Petitioner also asserts that it can present invalidity theories based on the same references from the IPR coupled with cumulative system art references. *Id.*, 19 (“Regions reserves the right to rely on any other combination of any prior art references disclosed herein”).

The substantial overlap between the IPR grounds and the combinations in the parallel litigation strongly weighs in favor of non-institution. The *Sotera* stipulation should be given little to no weight because it does not preclude Petitioner from reusing the same prior art with minor modifications, such as by adding in system art or recharacterizing references as system art and invoking the

Ingenico rule. See *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365 (Fed. Cir. 2025).

The Director has consistently explained that stipulations that do not preclude presenting invalidity arguments in the parallel suit using IPR references coupled with system art are given little weight. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (Director Review Mar. 28, 2025) at *3; *Cisco Systems, Inc. v. Wsou Investments LLC*, IPR2025-00188, Paper 14 (Director Review Aug. 22, 2025) at *2-4. See, e.g., *Shenzen Tuozhu Technology Co., Ltd., v. Stratasys, Inc.*, IPR2025-00354 (Director Review June 12, 2025) (“Petitioner’s invalidity arguments in district court, however, are more expansive and include combinations with ... system art”).

Accordingly, Factor 4 strongly favors discretionary denial.

C. *Fintiv* Factor 1

This factor, which addresses whether a stay exists or is likely to be granted if a proceeding is instituted, weighs heavily in favor of denial. Petitioner has not filed

a motion to stay based on the IPR petitions. See Ex. 2005.¹

Even if an IPR was instituted, the district court judge is unlikely to stay the case. Ex. 2008, 3 (15% win rate on contested motions to stay pending IPRs), 85 (8% win rate on contested motion to stay before Judge Gilstrap). This factor strongly weighs in favor of denial.

D. *Fintiv* Factor 3

This factor, which relates to the amount of work completed in the parallel litigation by the court and the parties at the time of the institution decision, also favors denial. The parties have completed their P.R. 3-1 and 3-2 disclosures (infringement contentions) and their P.R. 3-3 and 3-4 disclosures (invalidity contentions). Ex. 2004; Ex. 2006. See Ex. 2005 (Dkts. 48, 57). The parties have completed a full round of briefing on Regions' motion to dismiss under Section 101. Ex. 2005 (Dkts. 46, 50, 54, 56).. By the mid-February 2026 due date for the institution decision, the parties will have exchanged proposed terms for *Markman* and submitted their joint claim construction statement. Ex. 2002, 4.

¹ Judges in the Eastern District of Texas will typically not entertain motions to stay until after institution. See, e.g., *Trover Group, Inc. v. Dedicated Micros USA*, 2015 WL 1067179, at *6 (E.D. Tex. Mar. 11, 2015).

Thus, a significant amount of work will have been completed in the district court litigation as of the date of institution. *Fintiv I*, 10. Under these circumstances, it would be an inefficient use of the parties' and the Board's time and resources to conduct a parallel IPR that may generate results that conflict with those from the jury trial.

E. *Fintiv* Factor 5

The parties here are the same as the parties in the litigation. *Fintiv II*, 15.

F. *Fintiv* Factor 6

This factor, which relates to other circumstances that impact the Director's exercise of discretion, weighs in favor of discretionary denial.

1. Timeliness of Filing of the Petition

The *Fintiv* decision places a heavy emphasis on whether the petition was filed expeditiously. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (prec.), 11-12. In this case, the Petitioner waited more than 6 months after the complaint was filed to file the Petition. Ex. 2005, 6 (complaint).

2. Merits of the Petition

Patent Owner will address the deficiencies of Petitioner's references in greater detail in its forthcoming Preliminary Response (merits brief). For purposes

of this paper, USAA identifies examples of dispositive merits issues that weigh in favor of discretionary denial.

First, the Petitioner's merits arguments are based on its expert's 254-page declaration, which is repeatedly used to supply limitations missing from the references, as discussed in detail in Section IV.A below.

Second, the Petitioner's merits arguments are largely premised on its repeated citations to results from other IPRs. There are dozens of such citations in the Petition. However, Petitioner fails to inform the Board that these prior IPR decisions involved patents from different families, patents with different inventors, patents directed to different inventions, and/or proceedings involving different grounds than presented here. For example, the decisions cited from IPR2021-01070, IPR2021-01077, IPR2022-00076 were for patents from a different family, with different inventors, with different claimed inventions, and that involved different grounds compared to this IPR. See Pet., 1, 35, 34, 39-41, 50, 81 (citing -00076, submitted as Ex. 1010), 50, 54, 73 (citing -01077, submitted as Ex. 1041), 3 (citing -01070). The decision cited from IPR2021-01073 involved a different claimed invention and different grounds. Pet., 1, 33, 70, 81 (citing -01073, submitted as Ex. 1009).

Finally, the merits of the Petitioner's combinations are not strong. The independent claims (Claims 1, 9, 18, and 26) are challenged based on two grounds. Ground 1 is based on the combination of Garcia, Luo, Meier, and Cohen. Ground 5 is based on the same combination, except Goyal is used in place of Meier. Pet., 8.

Using Claim 1 as an example, Petitioner argues that Garcia discloses the remote submission of still images of a check to a bank by a user having a mobile device. Ex. 1008 (Garcia), Abstract, 4-8. Luo allegedly teaches the image capture of business cards using a camera having a viewfinder with reference lines that are used align a preview image before the still image is captured. Ex. 1004 (Luo), Abstract, Claims 1-7, 3-5, Figs. 2-5. Cohen describes a remote merchant check processing system on a PC (not a mobile device) connected to a scanner that can scan check images and send them directly to the Federal Reserve. Ex. 1006 (Cohen), Abstract, [0020] (running on a PC), Fig. 1 (PC 108, scanner 106). Meier allegedly teaches the use of Android APIs by mobile applications that can access the camera to "capture images and preview and capture live video." Meier, 315.

Petitioner's combination fails to teach or suggest multiple limitations of Claim 1. For example, none of the references teaches an app that is downloaded onto a mobile device for providing check image capture per limitation 1[c]. Meier discloses that the Software Development Kit (SDK) can be downloaded. Meier,

xviii. That teaches at most the download of the SDK onto a development platform, not the download of a software app for check imaging onto a mobile device per limitation 1[c].²

Petitioner's combination also fails to teach the capture of video frames from live video by a camera when monitoring criteria is satisfied, as set forth in limitations 1[e]-[h]. Garcia, Luo, and Cohen do not teach anything about generating live videos of checks, much less analyzing or capturing video frames as recited in the claims here. Meier refers at most to "[a]ccess to the device camera for taking pictures and previewing videos" and "captur[ing] images and preview[ing] and captur[ing] live video" (Meier, 315), not the monitoring, analysis, and capturing of video frames from live video recited in the claims here.

Petitioner's Ground 5 combination that replaces Meier with Goyal has the same defects highlighted above. Goyal indicates that Java applications can be used

² Meier's alleged status as a permissible printed publication under Section 311(b) is dubious. Petitioner's library science expert asserts that Meier was publicly available on June 25, 2008. Ex. 1062 (Munford Decl.), ¶ 18. However, that testimony conflicts with Meier's copyright date of **2009**. Meier (Ex. 1005), ("Copyright © 2009 by Wiley Publishing, Inc.").

to “capture snapshots or full videos”(Goyal, 127), not to capture a video frame from live video.

In sum, the merits of the Petition strongly weigh in favor of discretionary denial.

III. THE DIRECTOR SHOULD DENY INSTITUTION UNDER SECTION 325(D)

Under Section 325(d), a petition should be denied if “substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. §325(d). In this case, the same or substantially the same prior art was presented to the Office during prosecution.

The independent claims are challenged based on Ground 1 (Garcia, Luo, Cohen, and Meier) and Ground 5 (Garcia, Luo, Cohen, and Goyal). Pet., 8.

Petitioner admits that three of the four references in the Ground 1—Garcia, Luo, and Cohen—were considered during examination. Pet., 5-6. *Ecto World, LLC v. RAI Strategic Holdings, Inc*, IPR2024-01280, Paper 13 (Director Review May 19, 2025) (references in IDS satisfy first prong of *Advanced Bionics*); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (prec.), at *7-8 (references in IDS), 10.

Ground 1 (Meier) – Independent Claims

The only new reference in Ground 1, Meier, is cited for its purported teaching of APIs providing access through an abstraction layer to hardware such as a camera on a computing device to allegedly meet limitation 1[b]. *See, e.g.*, Pet., 22-23, 39, 41, 44. But Meier is cumulative of prior art that was considered during examination, including U.S. Pat. Pub. 2006/0249567 to Byrne. Ex. 2007. *See* Ex. 1001 ('095 Patent), Page 7 (references cited includes Byrne). Indeed, Petitioner admits that Byrne is “similar to Meier.” Pet., 33 (“combination of Garcia with [Byrne]” which is “similar to Meier”). Further, Petitioner’s invalidity contentions treat Meier as cumulative of Byrne. Ex. 2004, 182 (regarding “controlling the image capture process using a software abstraction layer, such as an application programming interface (API), that provides video frames ... a POSITA would have found such feature obvious in view of **Byrne, Meier**, Ranjan ... or Goyal”) (emph. added). Additionally, Petitioner’s invalidity contentions assert that Byrne discloses the use of APIs to access hardware through an abstraction layer to allegedly meet limitation 1[b], demonstrating that Meier is cumulative of Bryne. Ex. 2004, 1123-1142.

There is an alternative basis for denial pursuant to Section 325(d): Meier is also cumulative of Ranjan, “Using a Camera with Windows Mobile 5,” which was

considered by the examiner during prosecution. Ex. 2009. See Ex. 1001 ('095 Patent), Page 17. Petitioner's invalidity contentions treat Meier as cumulative of Ranjan. Ex. 2004, 182 (regarding "controlling the image capture process using a software abstraction layer, such as an application programming interface (API), that provides video frames ... a POSITA would have found such feature obvious in view of Byrne, **Meier, Ranjan** ... or Goyal") (emph. added). Also, Petitioner's invalidity contentions assert that Ranjan discloses the use of APIs to access hardware through an abstraction layer to allegedly meet limitation 1[b], demonstrating that Meier is cumulative of Ranjan. Ex. 2004, 1436-1452.

Ground 5 (Goyal) – Independent Claims

The only new reference in Ground 5, Goyal, is cited for its alleged teaching of APIs providing access through an abstraction layer to hardware such as a camera on a computing device to allegedly meet limitation 1[b]. *See, e.g.,* Pet., 77-78, 83-84.

Like Meier in Ground 1, Goyal is cumulative of prior art considered during examination, including Byrne (Ex. 2007) and Ranjan (Ex. 2009). Petitioner states that Byrne is "similar to Goyal." Pet., 81. Petitioner's invalidity contentions treat Goyal as cumulative of Byrne and Ranjan. Ex. 2004, 182 (for "controlling the image capture process using a software abstraction layer, such as an application

programming interface (API), that provides video frames ... a POSITA would have found such feature obvious in view of **Byrne, Meier, Ranjan ... or Goyal**") (emph. added). Finally, Petitioner's invalidity contentions assert that Byrne and Ranjan disclose the use of APIs to access hardware through an abstraction layer to allegedly meet limitation 1[b], demonstrating that Goyal is cumulative of each of Byrne and Ranjan. Ex. 2004, 1123-1142 (Byrne), 1436-1452 (Ranjan).

Grounds for Dependent Claims

Ground 2 adds Yoon to the combination of Garcia, Luo, Cohen, and Meier, to address certain dependent claims. Ground 6 adds Yoon to the combination of Garcia, Luo, Cohen, and Goyal for the same claims.

Petitioner concedes that Yoon was presented to the examiner during prosecution. Pet., 7. See '095 Patent, 8 (references cited). Accordingly, the same or substantially the same prior art was presented to the Office for Grounds 2 and 6.

Ground 3 adds Randle to the combination of Garcia, Luo, Cohen, and Meier, to address certain dependent claims. Ground 7 adds Randle to the combination of Garcia, Luo, Cohen, and Goyal for the same claims.

Petitioner concedes that Randle was presented to the examiner during prosecution. Pet., 7. See '095 Patent, 7 (references cited). Accordingly, the same or substantially the same prior art was presented to the Office for Grounds 3 and 7.

Patent Owner asks that the Director grant this request for discretionary denial based on Section 325(d) because the same or substantially the same prior art was presented to the Office.

IV. THE DIRECTOR SHOULD DENY INSTITUTION BASED ON OTHER RELEVANT CONSIDERATIONS

Acting Director Stewart’s March 26 Memo identifies other considerations that favor discretionary denial in this IPR.

A. Excessive Reliance on Expert Testimony Used To Supply Missing Limitations

Acting Director Stewart identified “the extent of the petition’s reliance on expert testimony” as a relevant consideration. March 26 Memo, 2.

Here, the Petition extensively relies on expert testimony in the form of a 254-page declaration. See Ex. 1002. Not only is this overwrought declaration unhelpful to the Board, but Petitioner relies on it repeatedly to gap-fill limitations missing from the references. For example, limitation 1[n]’s requirement that the user’s mobile device “*receiv[es] an [i]ndication of a result of the processing*” “*verifying that the digital image of the check is acceptable for mobile check deposit*” is not disclosed in any of the prior art (Garcia, Luo, Cohen, and Meier), but Petitioner relies on the expert to supply this limitation. Pet., 55 (expert

testimony that the user's device "would need" to receive an indication per limitation 1[n], citing Ex. 1002, ¶¶ 262-263).

Another example involves the requirement of Claim 4 (and also Claims 21 and 28) that "*the plurality of monitoring criteria [i]ncludes a criterion based on magnetic character recognition (MICR) line detection,*" which is not disclosed in any of the Garcia, Luo, and Meier references. As for Cohen, it teaches check imaging at a remote merchant system using a PC and a scanner, where MICR line data can be extracted. Cohen, Abstract, [0017], [0020], [0022], Fig. 1 (PC 108, scanner 106). There is no disclosure in Cohen of a mobile device with a camera using MICR line data as monitoring criteria to determine when to capture a video frame per Claim 4. Consequently, Petitioner argues that its expert's testimony teaches the use of MICR line detection for mobile device monitoring criteria. Pet., 62-63 (citing Ex. 1002, ¶¶ 296-298).

These are just examples of the numerous instances where Petitioner effectively relies on the expert declaration as a reference to supply missing claim limitations. The use of extensive expert declaration testimony to supply missing claim limitations weighs against institution. *See iRhythm Technologies v. Welch Allyn Inc.*, IPR2025-00363, Paper 10, (Director Review June 6, 2025), at *2 (extensive expert testimony is problematic if "[p]etitioner is using its expert to fill

gaps in the prior art”); *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 (Director Review June 26, 2025), at *2 (same).

B. Patent Owner’s Substantial Investment, Including Practicing the Invention and Licensing and Asserting the Patents, Establishes Settled Expectations.

Patent Owner USAA has settled expectations from having made a substantial investment in its mobile deposit patents over the years in developing and practicing the invention, marking its products and services, licensing the invention, and asserting the patents when infringers refuse to voluntarily agree to a license. See Ex. 2003 (Second Amended Complaint), ¶¶ 8, 11, 16-18, 22-24, 33 (licensing offer to Petitioner in 2020 including the family of the ’095 Patent), 36 (suit against Wells Fargo in 2018, settlement including license agreement in 2021), 37 (suit against PNC Bank in 2020), 38 (suit against Truist Bank in 2022), 43 (license with Discover in 2023), 44 (license with Esquire Bank in 2024), 45 (license with First Citizens Bank in 2024), 47 (marking). Thus, Patent Owner has spent years practicing, licensing, and enforcing the patents in the check processing technology space in which Regions operates. See *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 (Director Review June 26, 2025), at *2-3 (whether patent has been “commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space”); *Shenzen Tuozhu Technology Co.*,

Ltd. v. Stratsys, Inc., IPR2024-00438, Paper 10 (Director Review July 17, 2025), at *3 (same).

Patent Owner's substantial investment in its patented technology creates settled expectations that militate in favor of discretionary denial.

V. CONCLUSION

For the foregoing reasons, the Director should deny institution.

Dated: October 14, 2025

Respectfully submitted,

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VI. CLAIMS APPENDIX³

1[pre] 1. A system enabling mobile check deposit auto-capture functionality via video frame processing, the system comprising:

1[a] a mobile device of a user, the user's mobile device including a camera, a processor, and a memory coupled to the processor, the memory storing:

1[b] a software abstraction layer for controlling the camera, the software abstraction layer comprising Instructions that, when executed by the processor, control the camera; and

1[c] a downloaded app, the downloaded app associated with a bank to control check deposit by controlling the camera through the software abstraction layer, the downloaded app comprising Instructions that, when executed by the processor, cause the user's mobile device to perform operations including:

1[d] providing Instructions to the user for capturing an image of a check;

³ The claim limitations are numbered as they are in the petition filed in IPR2025-01356.

1[e] generating a live video of the check in a field of view of the camera, the downloaded app causing the live video to be generated by controlling the camera through the software abstraction layer;

1[f] overlaying an alignment guide on the live video of the check in the field of view of the camera;

1[g] monitoring the live video of the check in the field of view of the camera with respect to at least one monitoring criterion;

1[h] determining that a video frame of the live video of the check satisfies the at least one monitoring criterion and then automatically capturing the video frame;

1[i] when the video frame of the live video of the check in the field of view of the camera is determined to satisfy the at least one monitoring criterion, providing feedback advising the user that the check has been captured;

1[j] using a wireless network, transmitting a digital image of the check from the user's mobile device and submitting the check for mobile check deposit in the bank after automatically capturing the video frame, wherein the digital image is the captured video frame or is based on the captured video frame; and

1[k] confirming that the mobile check deposit can go forward after optical character recognition is performed on the check in the digital image, a magnetic

ink character recognition (MICR) line on the check in the digital image is recognized, and an amount payable on the check in the digital image is validated;

1[l] a server, remote from the user's mobile device, comprising a processor coupled to a memory storing Instructions that, when executed by the processor, cause the server to perform operations including:

1[m] receiving the digital image of the check transmitted by the user's mobile device, and

1[n] processing the digital image or the check including performing optical character recognition on the check in the digital image and verifying that the digital image of the check is acceptable for mobile check deposit, the user's mobile device receiving an Indication of a result of the server's processing before confirming that the mobile check deposit can go forward; and

1[o] a computer comprising a processor coupled to a memory storing Instructions that, when executed by the processor, cause the computer to update a balance of an account at a financial institution of the user to reflect an amount of funds associated with the check submitted for mobile check deposit by the user's mobile device, after the submitting the check for mobile check deposit in the bank, the confirming that the mobile check deposit can go forward, and the verifying that the digital image of the check is acceptable for mobile check deposit.

2[a] 2. The system of claim 1, wherein the downloaded app causes the user's mobile device to perform additional operations including:

2[b] before determining that the video frame of the live video of the check satisfies the at least one monitoring criterion, determining that a different video frame of the live video of the check does not satisfy the at least one monitoring criterion: and

2[c] after determining that the different video frame of the live video of the check does not satisfy the at least one monitoring criterion, providing feedback to the user.

3. The system of claim 1, wherein the at least one monitoring criterion is a plurality of monitoring criteria based on two or more selected from a group consisting of light contrast, light brightness, check positioning, check dimensions, character spacing, skewing, warping, corner detection, edge detection, and magnetic ink character recognition (MICR) line detection.

4. The system of claim 3, wherein the plurality of monitoring criteria includes a criterion based on magnetic ink character recognition (MICR) line detection.

5. The system of claim 3, wherein the plurality of monitoring criteria includes criteria based on light brightness, skewing, and warping.

6. The system of claim 1 wherein the confirming that the mobile check deposit can go forward is performed after the transmitting the digital image of the check from the user's mobile device.

7. The system of claim 1, wherein the digital image is a modified version of the captured video frame.

8. The system of claim 1, wherein the wireless network is a cellular network.

9[pre] 9. A system enabling mobile check deposit auto-capture functionality via video frame processing, the system comprising:

9[a] a mobile device of a user, the user's mobile device including a camera, a processor, and a memory coupled to the processor, the memory storing a downloaded app, the downloaded app associated with a bank to control check deposit by controlling the camera, the system to being configured to perform operations including:

9[b] providing Instructions to the user for capturing an image of a check;

9[c] generating a live video of the check in a field of view of the camera, the downloaded app causing the live video to be generated by controlling the camera;

9[d] overlaying an alignment guide on the live video of the check in the field of view of the camera;

9[e] monitoring the live video of the check in the field of view of the camera with respect to at least one monitoring criterion;

9[f] determining that a video frame of the live video of the check satisfies the at least one monitoring criterion and then automatically capturing the video frame;

9[g] when the video frame of the live video of the check in the field of view of the camera is determined to satisfy the at least one monitoring criterion, providing feedback advising the user that the check has been captured;

9[h] using a wireless network, transmitting a digital image of the check from the user's mobile device and submitting the check for mobile check deposit in the bank after automatically capturing the video frame, the digital image of the check being the captured video frame or being based on the captured video frame;

9[i] processing the digital image of the check Including performing optical character recognition and verifying that the digital image of the check is acceptable for mobile check deposit; and

9[j] confirming that the mobile check deposit can go forward after optical character recognition is performed on the check in the digital image, a magnetic ink character recognition (MICR) line on the check in the digital image is recognized, and an amount payable on the check in the digital image is validated; and

9[k] a bank computer programmed to update a balance of an account at a financial institution of the user to reflect an amount of funds associated with the check submitted for mobile check deposit by the user's mobile device, after the check is submitted for mobile check deposit in the bank, confirming that the mobile check deposit can go forward, and verifying that the digital image of the check is acceptable for mobile check deposit.

10[a] 10. The system of claim 9, wherein the system is configured to perform additional operations including:

10[b] before determining that the video frame of the live video of the check satisfies the at least one monitoring criterion, determining that a different video frame of the live video of the check does not satisfy the at least one monitoring criterion; and

10[c] after determining that the different video frame of the live video of the check does not satisfy the at least one monitoring criterion, providing feedback to the user.

11. The system of claim 9, further comprising one or more computers programmed to perform operations comprising the monitoring, the determining, or both the monitoring and the determining.

12. The system of claim 9, wherein the at least one monitoring criterion is a plurality of monitoring criteria based on two or more selected from a group consisting of light contrast, light brightness, check positioning, check dimensions. character spacing, skewing, warping, corner detection, edge detection, and magnetic ink character recognition (MICR) line detection.
13. The system of claim 12, wherein the plurality of monitoring criteria Includes criteria based on light brightness, skewing, and warping.
14. The system of claim 9, wherein the confirming that the mobile check deposit can go forward is performed after the transmitting the digital image of the check from the user's mobile device.
15. The system of claim 14, wherein the user's mobile device receives an Indication of a result of the processing the digital image of the check before the confirming step.
16. The system of claim 11, wherein the one or more computers include the bank computer.
17. The system of claim 9. wherein the wireless network is a cellular network.
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 18. A system enabling mobile check deposit auto-capture functionality via video frame processing, the system comprising:

18[a] a mobile device of a user, the user's mobile device including a camera, a processor, and a memory coupled to the processor, the memory storing:

18[b] a software abstraction layer, the software abstraction layer comprising Instructions that, when executed by the processor, control the camera; and

18[c] a downloaded app, the downloaded app associated with a bank to control check deposit by controlling the camera through the software abstraction layer, the downloaded app comprising Instructions that, when executed by the processor, cause the user's mobile device to perform operations including:

18[d] providing Instructions to the user for capturing an image of a check;

18[e] generating a live video of the check in a field of view of the camera, the downloaded app causing the live video to be generated by controlling the camera through the software abstraction layer;

18[f] monitoring the live video of the check in the field of view of the camera with respect to at least one monitoring criterion;

18[g] determining that a video frame of the live video of the check satisfies the at least one monitoring criterion and then automatically capturing the video frame;

18[h] when the video frame of the live video of the check in the field of view of the camera is determined to satisfy the at least one monitoring criterion, providing feedback advising the user that the check has been captured;

18[i] using a wireless network, transmitting a digital image of the check from the user's mobile device and submitting the check for mobile check deposit in the bank after automatically capturing the video frame, wherein the digital image is the captured video frame or is based on the captured video frame; and

18[j] confirming that the mobile check deposit can go forward after optical character recognition is performed on the check, a magnetic ink character recognition (MICR) line on the check is recognized, and an amount payable on the check is validated; and

18[k] a computer comprising a processor coupled to a memory storing Instructions that, when executed by the processor, cause the computer to update a balance of an account at a financial institution of the user to reflect an amount of funds associated with the check submitted for mobile check deposit by the user's mobile device, after the submitting the check for mobile check deposit and the confirming that the mobile check deposit can go forward.

19[a] The system of claim 18, wherein the downloaded app causes the user's mobile device to perform additional operations including:

19[b] before determining that the video frame of the live video of the check satisfies the at least one monitoring criterion, determining that a different video frame of the live video of the check does not satisfy the at least one monitoring criterion; and

19[c] after determining that the different video frame of the live video of the check does not satisfy the at least one monitoring criterion, providing feedback to the user.

20. The system of claim 18, wherein the at least one monitoring criterion is a plurality of monitoring criteria based on two or more selected from a group consisting of light contrast, light brightness, check positioning, check dimensions, character spacing, skewing, warping, corner detection, edge detection, and magnetic ink character recognition (MICR) line detection.

21. The system of claim 20, wherein the plurality of monitoring criteria being based on magnetic ink character recognition (MICR) line detection and one or both of corner detection and edge detection.

22. The system of claim 20, wherein the plurality of monitoring criteria Includes criteria based on light brightness, skewing, and warping.

23. The system of claim 18, wherein the confirming that the mobile check deposit

can go forward is performed after the transmitting the digital image of the check from the user's mobile device.

24. The system of claim 18, wherein the digital image is a modified version of the captured video frame.

25. The system of claim 18, wherein the wireless network is a cellular network.

26[pre] 26. A system enabling mobile check deposit auto-capture functionality via video frame processing, the system comprising:

26[a] a mobile device of a user, the user's mobile device including a camera, a processor, and a memory coupled to the processor, the memory storing:

26[b] a software abstraction layer, the software abstraction layer comprising Instructions that, when executed by the processor, control the camera; and

26[c] a downloaded app, the downloaded app associated with a bank to control check deposit by controlling the camera through the software abstraction layer, the downloaded app comprising Instructions that, when executed by the processor, cause the user's mobile device to perform operations including:

26[d] providing Instructions to the user for capturing a check;

26[e] generating a live video of the check in a field of view of the camera, the downloaded app causing the live video to be generated by controlling the camera through the software abstraction layer;

26[f] monitoring the live video of the check in the field of view of the camera with respect to at least one monitoring criterion;

26[g] determining that a video frame of the live video of the check satisfies the at least one monitoring criterion and then automatically capturing the video frame;

26[h] determining that a video frame of the live video of the check satisfies the at least one monitoring criterion and then automatically capturing the video frame;

26[i] using a wireless network, transmitting a digital image of the check from the user's mobile device and submitting the check for mobile check deposit in the bank after automatically capturing the video frame, wherein the digital image is the captured video frame or is based on the captured video frame; and

26[j] confirming that the mobile check deposit can go forward after optical character recognition is performed on the check, a magnetic ink character recognition (MICR) line on the check is recognized, and an amount payable on the check is validated;

26[k] the system configured to perform image processing operations on an image of the check, the image processing operations including performing optical character recognition and verifying that the image of the check is acceptable for

mobile check deposit, wherein the image of the check is the digital image transmitted by the user's mobile device or is based on the digital image transmitted by the user's mobile device; and

26[l] a computer programmed to update a balance of an account at a financial Institution of the user to reflect an amount of funds associated with the check submitted for mobile check deposit by the user's mobile device, after the submitting the check for mobile check deposit in the bank, the confirming that the mobile check deposit can go forward, and the verifying that the image of the check is acceptable for mobile check deposit.

27[a] The system of claim 26, wherein the downloaded app causes the user's mobile device to perform additional operations including:

27[b] before determining that the video frame of the live video of the check satisfies the at least one monitoring criterion, determining that a different video frame of the live video of the check does not satisfy the at least one monitoring criterion; and

27[c] after determining that the different video frame of the live video of the check does not satisfy the at least one monitoring criterion, providing feedback to the user.

28. The system of claim 26, wherein the at least one monitoring criterion is a plurality of monitoring criteria based on two or more selected from a group consisting of light contrast, light brightness, check positioning, check dimensions, character spacing, skewing, warping, corner detection, edge detection, and magnetic ink character recognition (MICR) line detection.

29. The system of claim 28, wherein the plurality of monitoring criteria Includes a criterion based on magnetic ink character recognition (MICR) line detection.

30. The system of claim 26, wherein the wireless network is a cellular network.

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Request for Discretionary Denial consists of 20 pages, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Response complies with the type-volume limitation of 20 pages as set forth by the Office at www.uspto.gov/patents/ptab/interim-director-discretionary-process at Section III.C.iii. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: October 14, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on October 14, 2025, I caused a true and correct copy of the foregoing Patent Owner Request for Discretionary Denial and Exhibits 2001-2009 to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

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