

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PNC BANK, N.A.,  
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,  
Patent Owner.

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IPR2021-01077  
Patent 10,621,559 B1

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

DIRBA, *Administrative Patent Judge*.

ORDER  
Granting Patent Owner's Motion to Submit Supplemental Information  
*37 C.F.R. § 42.123(b)*

On August 23, 2022, pursuant to our authorization, Patent Owner filed a Motion to Submit Supplemental Information. Paper 40 (“Mot.”). When requesting authorization to file its Motion via email, Patent Owner attached proposed Exhibits 2032 and 2033, which include testimony from co-pending district court litigations between the parties. Specifically, Exhibit 2032 consists of 22 pages of trial testimony of Omid Kia, Ph.D., and nine demonstrative slides from *United Services Automobile Association v. PNC Bank, N.A.*, No. 2:20-cv-319-JRG (E.D. Tex.), and Exhibit 2033 consists of 21 pages of deposition testimony of David Peterson from *United Services Automobile Association v. PNC Bank, N.A.*, No. 2:21-cv-246-JRG (E.D. Tex.). Petitioner filed an Opposition to Patent Owner’s Motion. Paper 42 (“Opp.”).

According to Patent Owner, Dr. Kia and Mr. Peterson are validity expert witness for Petitioner in the district court litigations. Mot. 1. Patent Owner contends that the testimony it requests to submit relates to “patents in the same family as the ’559 patent” and contradicts the arguments Petitioner makes in this proceeding regarding motivation to combine and reasonable expectation of success. *Id.*

According to our rules,

A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

37 C.F.R. § 42.123(b). Additionally, “[t]he supplemental information must be relevant to a claim for which the trial has been instituted.” *Id.* at § 42.123(a)(2). As noted above, Patent Owner requested, and received,

authorization to file a motion to submit supplemental information. The parties dispute whether the supplemental information reasonably could have been obtained earlier, whether it is relevant to a claim for which we instituted trial, and whether our consideration of this information would be in the interests-of-justice.

As to whether the information could have been obtained earlier, Patent Owner argues that Dr. Kia's testimony was elicited on May 12, 2022, and Mr. Peterson's testimony was obtained on June 1, 2022, after Patent Owner's Response was filed on May 5, 2022. Mot. 3. Patent Owner argues that Petitioner's Reply, filed on August 11, 2022, cites to the trial transcript and an expert deposition from one of the district court litigations. *Id.* at 5 (citing Exs. 1163, 1164). Patent Owner also argues that, prior to filing the Reply, Petitioner notified Patent Owner of its intent to submit those exhibits and Patent Owner notified Petitioner that it would seek to submit proposed Exhibits 2032 and 2033 as supplemental information to provide us with context. *Id.*

Petitioner responds that Patent Owner's delay in seeking to submit this information is unjustified because it is cumulative of Dr. Kia's and Mr. Peterson's expert reports from the district court litigations, which were served on Patent Owner before it filed the Patent Owner Response. Opp. 1, 3–4. Petitioner argues that Patent Owner introduced parts of Dr. Kia's report in this proceeding and cited "opinions consistent with" the testimony sought to be introduced now. *Id.* at 4 (citing Exs. 2018, 2030). Petitioner states that Mr. Peterson's testimony is consistent with his expert report. *Id.*

We are persuaded that Patent Owner timely seeks to introduce supplemental information. Dr. Kia's trial testimony and Mr. Peterson's deposition testimony did not exist at the time Patent Owner filed its Patent

Owner Response. Thus, Patent Owner could not have submitted them at that point.<sup>1</sup> *See Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017) (Jury trial testimony elicited after briefing before the Board “is not evidence that could have been located earlier through a more diligent or exhaustive search; it did not exist during the IPR discovery period. . . . That inconsistent testimony did not exist sooner and thus could not have been proffered to the Board sooner.”). Patent Owner also cannot, as a matter of right, submit such information along with its sur-reply. *See Consolidated Trial Practice Guide (“TPG”)*<sup>2</sup>, 73 (“The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.”). Thus, Patent Owner was correct to seek to submit this information as supplemental information. Moreover, Patent Owner states that this information provides context for other testimony submitted with Petitioner’s Reply, which was filed on August 11, 2022. *See Mot. 5.*

As to the relevance of the proposed supplemental information, Patent Owner argues that “it involves expert testimony offered by [Petitioner] regarding whether a [person of ordinary skill in the art] would have been able to solve the challenges with capturing check images using a mobile device in 2006.” *Mot. 3.* Patent Owner argues that Dr. Kia testified that capturing check images with a mobile phone was a “paradigm shift” that involved certain specific problems, and an ordinary artisan would not have

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<sup>1</sup> That Patent Owner had the corresponding expert reports does not detract from the fact that the testimony at issue did not exist when the Response was filed on May 5, 2022. In particular, we are not persuaded that the testimony is cumulative of those reports, and we question whether the expert reports would be inadmissible hearsay in this proceeding.

<sup>2</sup> *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

had the knowledge to deal with these challenges. *Id.* at 3–4 (emphasis omitted). Patent Owner argues that Mr. Peterson admitted that the primary reference in this proceeding “did not teach how to solve problems associated with using a handheld digital camera” and testified that replacing a scanner with a mobile camera was not predictable. *Id.* at 4.

Petitioner responds that the testimony relates to different patents with different claims. Opp. 2. In addition, Petitioner submits that the testimony relates to enablement, which is not at issue in this proceeding, and a reference need not be enabled under 35 U.S.C. § 315. *Id.* Petitioner also contends that Dr. Kia opined that the ’559 patent was obvious over the prior art asserted in this proceeding. *Id.* at 3 (citing Ex. 2018, 13).

Having considered the parties’ arguments, we determine that Patent Owner has met the threshold required to show that the proposed supplemental information has relevance in this proceeding, and that Patent Owner has shown that it would be in the interests of justice to grant the Motion. Although we will not be able to discern the relevance of this information (and the weight to assign to it) until the conclusion of trial, we are persuaded that we should allow Patent Owner to introduce this evidence so that it can be evaluated, as we are persuaded that the testimony may be inconsistent with contentions advanced by Petitioner in this proceeding. Moreover, we recognize that neither Dr. Kia nor Mr. Peterson offer expert testimony in this proceeding, but if Petitioner is offering conflicting testimony in two fora, albeit by different experts, that might impact the credibility of the testimony of Petitioner’s declarant in this proceeding. We recognize that Dr. Kia’s and Mr. Peterson’s testimony was not offered on the precise point on which Patent Owner seeks to use that testimony. Nevertheless, the state of the art and the skill level and knowledge of an

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