

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PNC BANK N.A.,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2021-01399
Patent 10,013,605 B1

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

DROESCH, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

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

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

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

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

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

B. Related Matters

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

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

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

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

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

C. The '605 Patent (Ex. 1001)

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

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

Figure 1 of the '605 Patent is reproduced below:

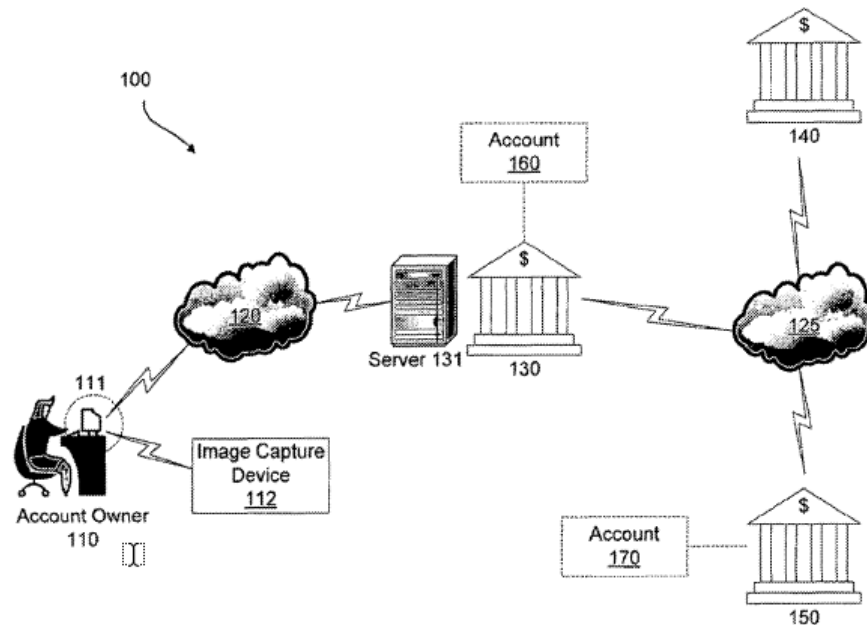


Figure 1 depicts a system in which the described method may be employed. *See* Ex. 1001, 2:63–64, 3:36–37. System 100 includes account owner 110 (e.g., a bank customer located at their private residence) and an associated customer-controlled general purpose computer 111 communicatively coupled to image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

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