

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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IPR2021-01399  
Patent 10,013,605 B1

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

DROESCH, *Administrative Patent Judge*.

DECISION  
Denying Petitioner's Request for Rehearing of Decision  
Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.71(d)*

## I. INTRODUCTION

On April 6, 2022, PNC Bank N.A. (“Petitioner”), filed a Request for Rehearing under 37 C.F.R. § 42.71(d). Paper 22 (“Req. Reh’g”). On the same day, Petitioner also filed a request for review by the precedential opinion panel (“POP”). Ex. 3002. On December 6, 2022, the POP denied review. Paper 24.

Petitioner’s Request for Rehearing seeks reconsideration of our Decision Denying Institution of *Inter Partes* Review with respect to claims 1–29 (“challenged claims”) of U.S. Patent No. 10,013,605 B1 (Ex. 1001, “’605 Patent”), in which we determined that Petitioner did not demonstrate that Oakes-I, Oakes-II, Medina, and Roach applied in each of the four asserted grounds of unpatentability qualify as prior art to the challenged claims of the ’605 Patent (Paper 20, “Decision” or “Dec.”). More specifically, Petitioner contends that we misapprehended the correct legal standard for written description support when determining that the parent application of the ’605 Patent (i.e., U.S. Patent Application No. 11/590,974 (Ex. 1042, “’974 Application”)) provided sufficient written description support for “a portable device” and “a digital camera”/“handheld mobile device with a digital camera” (“the device limitations”). Req. Reh’g 1–2, 5–9. Petitioner also asserts that we overlooked disclosures in the ’974 Application that conflict with the conclusion that the ’974 Application provides written description support for “the transmitted copy of the electronic images . . . having a different electronic format than the images captured with the digital camera” (“the ‘different electronic format’ limitations”). *Id.* at 2–3, 9–12. According to Petitioner, had we not misapprehended the legal standard for written description and had we considered the conflicting disclosures in the ’974 Application, we would

have concluded that the '974 Application does not provide sufficient written description support for the challenged claims of the '605 Patent. *See id.*

As explained below, we have considered the arguments presented by Petitioner in the Request for Rehearing. We are not persuaded that we misapprehended or overlooked arguments or evidence presented in the Petition, or that we abused our discretion in rendering our Decision. Accordingly, we deny Petitioner's Request for Rehearing.

## II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters it believed the Board misapprehended or overlooked, and the place where each matter was addressed previously. *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). "An abuse of discretion occurs if the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 442 (Fed. Cir. 2015) (quoting *Abrutyn v. Giovannello*, 15 F.3d 1048, 1050–51 (Fed. Cir. 1994) (citation omitted)).

## III. BACKGROUND

The Petition presented the following grounds of unpatentability: (1) claims 12–23 and 26–29 of the '605 Patent are unpatentable under § 103(a) over Oakes-I (Ex. 1037) and Oakes-II (Ex. 1038); (2) claims 12–23 and 26–29 of the '605 Patent are unpatentable under § 103(a) over Oakes-I, Oakes-II, and Medina (Ex. 1058); (3) claims 1–11, 24, and 25 of the '605

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Patent are unpatentable under § 103(a) over Oakes-I, Oakes-II, and Roach (Ex. 1040); and (4) claims 1–11, 24, and 25 of the '605 Patent are unpatentable under § 103(a) over Oakes-I, Oakes-II, Roach, and Medina. *See* Pet. 6, 34–91. Petitioner contends that each of Oakes-I, Oakes-II, Roach, and Medina qualifies as prior art because the challenged claims of the '605 Patent are not entitled to the benefit of a filing date earlier than July 28, 2017. *See id.* at 1, 12–32. To support this argument, Petitioner asserts that the '974 Application, the parent application of the '605 Patent, does not provide sufficient written description support for, *inter alia*, the device limitations and the “different electronic format” limitations. *See id.* at 12–29, 31–32.

The '605 Patent claims entitlement to the benefit of an earlier effective filing date through an intervening continuation application back to the '974 Application. Ex. 1001, code (63). The '974 Application was filed on October 31, 2006, and issued as Oakes-I on April 29, 2014. Ex. 1037, codes (21), (22), (45). Oakes-II issued on January, 18, 2011, and also was filed on October 31, 2006. Ex. 1038, codes (22), (45). Medina issued on September 8, 2015, and claims the benefit of the filing date of three provisional applications filed on June 8, 2010. Ex. 1058, codes (45), (60). Roach was published on June 20, 2013, and claims the benefit of a continuation-in-part application filed on December 30, 2008. Ex. 1040, codes (43), (63). On their faces, Oakes-I, Oakes-II, Medina, and Roach qualify as prior art to the challenged claims of the '605 Patent only if the

challenged claims are not entitled to the benefit of a filing date earlier than July 28, 2017. *See* Pet. 4.<sup>1</sup>

In the Decision, we did not agree with Petitioner’s contentions that the challenged claims are not entitled to the benefit of an earlier effective filing date. *See* Dec. 17–27. Beginning with the device limitations, we noted that, contrary to Petitioner’s suggestion, a claim *can* be broader than the embodiments disclosed in the specification. *See id.* at 18. We then explained that Petitioner did not show that the breadth of the claims that include the device limitations resulted in a lack of written description support. *See id.* at 18–22. In addition, after reviewing the ’974 Application, we made the following factual findings:

[T]he ’974 Application . . . describes an invention for remote deposit of a check using a general purpose computer (such as a laptop) that receives an image of the check from an associated image capture device (such as a digital camera). What is important to the invention is that the image capture device and general purpose computer are communicatively coupled, not their locations relative to one another. In addition, the ’974 Application does not limit its invention to only those remote deposits performed using a general purpose computer that is *separate* from an image capture device. The ’974 Application broadly describes the image capture device, noting it can be “a scanner or digital camera.” The ’974 Application also indicates that the general purpose computer and image capture device are “customer-controlled” and “electronics that today’s consumers actually own or can easily acquire.” In light of these disclosures, we find that a person of ordinary skill in the art would have understood the ’974 Application to reasonably convey possession of both integrated and nonintegrated configurations.

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<sup>1</sup> The parties do not appear to dispute that the ’605 Patent is identical substantively to Oakes–I and the ’974 Application. Pet. 32; Paper 10 (Patent Owner Preliminary Response), 24 n.6.

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