

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.

IPR2022-00050
Patent 10,402,638 B1

Before MICHAEL R. ZECHER, TERRENCE W. McMILLIN, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

On June 10, 2022, Petitioner, PNC Bank N.A. (“Petitioner”), filed the following: (1) a Request for Rehearing under 37 C.F.R. § 42.71(d) (Paper 23 (“Req. Reh’g”)); and (2) a request for review by the precedential opinion panel (Ex. 3001 (“POP Request”). On December 6, 2022, the POP Request was denied. Paper 25.

The Request for Rehearing seeks reconsideration of our Decision Denying Institution of *Inter Partes* Review (“IPR”) with respect to claims 1–30 of U.S. Patent No. 10,402,638 B1 (Ex. 1001, “the ’638 patent”), in which we determined that Petitioner did not demonstrate that Oakes-I,¹ Oakes-II,² Medina,³ and Roach,⁴ applied in the three asserted grounds of unpatentability presented in the Petition, qualify as prior art to the challenged claims of the ’638 patent (Paper 22, “Decision” or “Dec.”). More specifically, Petitioner contends that we misapprehended the legal standard for written description when determining that the ultimate predecessor application of the ’638 patent (i.e., U.S. Patent Application No. 11,590,974 (Ex. 1007, “the ’974 application”)) provided sufficient written description support for the following limitations: (1) “customer’s handheld mobile device” and “digital camera” (“the device limitations”); and (2) “the

¹ U.S. Patent No. 8,708,227 B1, filed Oct. 31, 2006, issued April 29, 2014 (Ex. 1003).

² U.S. Patent No. 7,873,200 B1, filed Oct. 31, 2006, issued Jan. 18, 2011 (Ex. 1004).

³ U.S. Patent No. 9,129,340 B1, filed Dec. 30, 2010, issued Sept. 8, 2015 (Ex. 1005).

⁴ U.S. Patent Application Publication No. 2013/0155474 A1, filed Feb. 19, 2013, published June 20, 2013 (Ex. 1006).

system being configured to check for errors before the submitting is performed by the customer's handheld device" ("the 'checking for errors' limitation"). Req. Reh'g 5–14. According to Petitioner, if we had not misapprehended the legal standard for written description, we would have concluded that the information presented in the Petition established that Petitioner was reasonably likely to prevail in challenging any one of claims 1–30 of the '638 patent. *See id.* at 3, 14.

As we explain below, we have considered the arguments presented by Petitioner in its Request for Rehearing. We, however, maintain our initial determination that Petitioner did not demonstrate that the '974 application fails to provide written description support for: (1) the device limitations and (2) the "checking for errors" limitation. As a result, we determine that Petitioner has not demonstrated that Oakes-I, Oakes-II, Medina, and Roach qualify as prior art to the challenged claims of the '638 patent and, therefore, 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 we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *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. Giovanniello*, 15 F.3d 1048, 1050–51 (Fed. Cir. 1994) (citation omitted)).

With this in mind, we address Petitioner’s arguments.

III. BACKGROUND

In the Petition, Petitioner contends that (1) claims 23–25 and 28–30 of the ’638 patent are unpatentable under § 103 as obvious over the combined teachings of Oakes-I and Oakes-II; (2) claims 23–25 of the ’638 patent are unpatentable under § 103 as obvious over the combined teachings of Oakes-I, Oakes-II, and Medina; and (3) claims 1–22, 26, and 27 of the ’638 patent are unpatentable under § 103 as obvious over the combined teachings of Oakes-I, Oakes-II, Medina, and Roach. Pet. 5, 32–100. Petitioner argues that each of Oakes-I, Oakes-II, Medina, and Roach qualifies as prior art because the challenged claims of the ’638 patent are not entitled to a priority date earlier than July 28, 2017. *Id.* at 4–5, 11–29. To support its priority argument, Petitioner asserts that the ’974 application does not provide sufficient written description support for the following limitations: (1) the device limitations and (2) the “checking for errors” limitation. *Id.* at 13–26.

The application that issued as the ’638 patent was filed on October 19, 2018. Ex. 1001, code (22). The ’638 patent claims priority through a series of continuation applications to the ’974 application filed on October 31, 2006. Ex. 1001, code (63), 1:6–18. Oakes-I is a U.S. patent that issued from the ’974 application and has the same specification as the ’638 patent.⁵

⁵ There does not appear to be a dispute between the parties that the specification of the ’638 patent is identical substantively to the specifications of Oakes-I and the ’974 application. Pet. 29 (“Oakes-I issued from the ’974

Ex. 1003, codes (21), (22); *see also* Pet. 29. Oakes-II also issued from an application filed on October 31, 2006. Ex. 1004, code (22). Medina issued from an application filed on December 30, 2010 (Ex. 1005, code (22)) and Roach issued from an application filed on February 19, 2013 (Ex. 1006, code (22)). On their faces, Oakes-I, Oakes-II, Medina, and Roach qualify as prior art to the challenged claims of the '638 patent only if the challenged claims are not entitled to claim priority to the '974 application. *See* Pet. 4–5.

In the Decision, we did not agree with Petitioner's priority arguments. *See* Dec. 16–36. 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.⁶ *Id.* at 23. We then explained that Petitioner had not shown that the breadth of the claims that include the device limitations resulted in a lack of written description support. *Id.* at 23–27. 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*

Application, and shares the specification and figures with the '638 patent."); Paper 12 (Patent Owner Preliminary Response), 26 n.5.

⁶ *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir. 2015) (“This court has repeatedly ‘cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.’” (*quoting Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002))); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005 (en banc)) (“[C]laims may embrace ‘different subject matter than is illustrated in the specific embodiments in the specification.’”) (citations and internal quotation marks omitted).

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