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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.

Case IPR2021-01070
U.S. Patent No. 8,699,779

**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 8,699,779
CHALLENGING CLAIMS 1, 2, 7-10, 15-17
UNDER 35 U.S.C. § 312 AND 37 C.F.R. § 42.104**

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I. INTRODUCTION

U.S. Patent No. 8,699,779 (the “’779 patent”) reuses known mobile technologies for capturing document images that are suitable for performing optical character recognition. Although the ’779 patent is specifically directed to capturing images of checks, it does not claim any special techniques for checks that have not already been applied to other kinds of documents. It is unpatentable at least because remote check deposit implemented on a camera phone predates the ’779 patent, as does complementary prior art (also using camera phones) that teaches monitoring of document features to improve image capture for optical character recognition.

More specifically, claim 1 of the ’779 patent recites “[a] system for depositing a check” that “project[s] an alignment guide in the display of the mobile device” and “determine[s] whether the image of the check aligns with the alignment guide.” Among other things, the claim recites that the system “monitor[s] an image of the check” and “automatically capture[s] the image of the check when the image of the check is determined to align with the alignment guide.” The check image is provided to “a depository via a communication pathway between the mobile device and the depository.”

These concepts were disclosed in prior art that was not considered during prosecution of the application that issued as the ’779 patent. As discussed below, U.S. Patent No. 8,768,836 to “*Acharya*” discloses software for capturing an image

of a check using the digital camera of a mobile device and providing that image to a depository. Further, Chinese Patent Application Publication No. CN 1897644A to “Luo” discloses a “method and system” of a “handheld” device for determining that a “preview image” “is clearer and more accurate” for performing “optical character recognition ... with high accuracy” by monitoring whether the edge of a document is “substantially parallel” to a “reference line” displayed on a preview screen of the system. EX1004, 7.¹ When this condition is met, “instructions” are provided to the user “before capturing the image of the object.” Additionally, *Acharya* was compatible with the implementation of *Luo*’s technique for image capture, and it would have been obvious to do so.

Furthermore, the grounds advanced in this Petition are distinguishable over the grounds presented in IPR2019-01083, a prior IPR challenge to the ’779 patent by an unrelated party. See *Wells Fargo Bank, N.A. v. United Services Automobile Association*, IPR2019-01083, Paper 39 (P.T.A.B. Nov. 24, 2020). In IPR2019-01083, the Board rejected the proffered combination of prior art references because they offered competing technical solutions for obtaining suitable images for optical character recognition. *Id.*, 27-31. As shown below, this Petition is based on a

¹ Page number citations to EX1004 refer to the page numbers of the Description section in the English translation, starting on page 4 of EX1004.

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