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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 IPR2021-01077
U.S. Patent No. 10,621,559

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,621,559 CHALLENGING CLAIMS 1-18 UNDER 35 U.S.C. § 312 AND 37 C.F.R. § 42.104

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I. INTRODUCTION

U.S. Patent No. 10,621,559 (the "'559 patent") reuses long-known and routine operations for depositing a bank check using a personal device. Although the '559 patent claims a novel system that processes a check deposit using only the check's image, every claim element was known in the prior art at the time the '559 patent was allegedly invented.

Specifically, claim 1 of the '559 patent recites (1) a "first processing circuitry" for "receiv[ing] a digital image … of the check … transmitted using a mobile device," "convert[ing] the digital image into a second image format," validating "an amount for the remote deposit of the check," and "perform[ing] duplicate check detection"; and (2) a "second processing circuitry" for "accepting the digital image for check deposit."

None of these claim requirements are new. WO 2005/043857 to Garcia discloses a remote check deposit system in which a bank computer receives a check image from a user's mobile device. U.S. Publication No. 2006/0106717 to Randle teaches a back-end check processing system that includes: (1) a payee's bank that performs routine check processing operations, including converting image formats and detecting duplicate check deposits, and (2) a payor's bank that accepts the digital image for check deposit. EP0984410 to Slater further teaches validating the check amount. It would have been obvious to combine Garcia's

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