

Declaration of Dr. Todd Mowry
In Support of Petition for *Inter Partes* Review
of U.S. Patent No. 10,013,605

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 IPR2021-01399

U.S. Patent No. 10,013,605

**DECLARATION OF DR. TODD MOWRY IN SUPPORT OF
PETITION FOR *INTER PARTES* REVIEW**

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF CONTENTS	ii
I. BACKGROUND.....	2
II. LEGAL PRINCIPLES	8
III. SUMMARY OF OPINION	11
IV. DESCRIPTION OF THE RELEVANT FIELD	13
V. DISCUSSION OF THE '605 PATENT	13
A. Overview.....	13
B. Prosecution History	15
VI. LEVEL OF ORDINARY SKILL IN THE ART	15
VII. CLAIM CONSTRUCTION.....	16
VIII. A PERSON OF ORDINARY SKILL IN THE ART WOULD NOT HAVE UNDERSTOOD THE INVENTOR TO BE IN POSSESSION OF THE CLAIMED INVENTION BEFORE JULY 28, 2017.....	18
A. The '974 Application Does Not Describe Using an Integrated Digital Camera to Capture An Image of a Check.....	20
1. The '974 Application Does Not Describe Using an Integrated Digital Camera to Capture an Image of a Check	20
2. The '974 Application Does Not Describe Examples That Include Using an Integrated Digital Camera to Capture an Image of a Check.....	28

Declaration of Dr. Todd Mowry
In Support of Petition for *Inter Partes* Review
of U.S. Patent No. 10,013,605

B.	The '974 Application Does Not Describe of the Claimed Sequences of Steps	31
1.	“initiating the [mobile check] deposit after [performing] the confirming [step]”	31
2.	“confirming that the [mobile check] deposit can go forward after performing an optical character recognition on the check”	32
3.	“the instructing [step] is performed after the receiving [step]”	33
C.	The '974 Application Does Not Describe the Claimed Electronic Format Modifications.....	34
IX.	OVERVIEW OF PRIOR ART REFERENCES	34
A.	<i>Oakes-I</i> (Ex. 1037).....	34
B.	<i>Oakes-II</i> (Ex. 1038)	35
C.	<i>Medina</i> (Ex. 1058).....	37
D.	<i>Roach</i> (Ex. 1040).....	40
X.	SPECIFIC GROUNDS FOR UNPATENTABILITY	43
A.	Ground I: Claims 12-23 and 26-29 Are Obvious Over <i>Oakes-I</i> and <i>Oakes-II</i>	43
1.	Independent Claim 12	43
2.	Dependent Claim 13	76
3.	Dependent Claim 14.....	76
4.	Dependent Claim 15.....	77
5.	Dependent Claim 16.....	79
6.	Dependent Claim 17.....	80

Declaration of Dr. Todd Mowry
In Support of Petition for *Inter Partes* Review
of U.S. Patent No. 10,013,605

7.	Dependent Claim 18.....	80
8.	Dependent Claim 19.....	81
9.	Dependent Claim 20.....	81
10.	Dependent Claim 21.....	82
11.	Dependent Claim 22.....	84
12.	Dependent Claim 23.....	84
13.	Dependent Claim 26.....	85
14.	Dependent Claim 27.....	86
15.	Dependent Claim 28.....	86
16.	Dependent Claim 29.....	87
B.	Ground II: Claims 12-23 and 26-29 Are Obvious Over <i>Oakes-I</i> , <i>Oakes-II</i> , and <i>Medina</i>	87
1.	Claim 12	87
2.	Claims 13-23 and 26-29	91
C.	Ground III: Claims 1-11, 24, and 25 are Obvious over <i>Oakes-I/II</i> Combined With <i>Roach</i> or <i>Oakes-I/II</i> Combined With <i>Roach</i> and <i>Medina</i>	91
1.	Independent Claim 1	92
2.	Dependent Claim 2.....	113
3.	Dependent Claim 3	113
4.	Dependent Claim 4.....	114
5.	Dependent Claim 5.....	114
6.	Dependent Claim 6.....	114

Declaration of Dr. Todd Mowry
In Support of Petition for *Inter Partes* Review
of U.S. Patent No. 10,013,605

7.	Dependent Claim 7.....	115
8.	Dependent Claim 8.....	115
9.	Dependent Claim 9.....	116
10.	Dependent Claim 10.....	116
11.	Dependent Claim 11.....	117
12.	Dependent Claim 24.....	117
13.	Dependent Claim 25.....	118
XI.	CONCLUSION.....	118
XII.	AVAILABILITY FOR CROSS-EXAMINATION.....	118
XIII.	RIGHT TO SUPPLEMENT.....	119
XIV.	ACKNOWLEDGMENT.....	120

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.