

Petition for *Inter Partes* Review
of U.S. Patent No. 10,402,638, Claims 20, 22

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Filed on behalf of PNC Bank N.A.

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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 IPR2022-00049

U.S. Patent No. 10,402,638

PETITION FOR *INTER PARTES* REVIEW
OF CLAIMS 20 AND 22

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I. INTRODUCTION

Claims 20 and 22 of U.S. Patent No. 10,402,638 (the “’638 patent”) recite long-known, routine operations for depositing a bank check using a personal computing device. Although the ’638 patent purports to claim a novel system for capturing a check image using a mobile device and submitting the check image to a bank computer for electronic processing, every element of the challenged claims was known at the time the ’638 patent was allegedly invented.

Specifically, claim 20 of the ’638 patent recites “a customer’s handheld mobile device including a downloaded app” that performs interactive operations for a remote check deposit. The claim further requires that the mobile device performs “instructing the customer to take a photo of the check,” “using a display of the customer’s handheld mobile device to assist the customer in taking the photo,” “assisting the customer as to an orientation for taking the photo,” and “check[ing] for errors before” submitting the check for deposit.

However, none of these features are new. WO 2005/043857 to “Garcia” discloses a remote check deposit system in which a user’s mobile device provides an interactive session for capturing a check image and submitting it to a bank computer. U.S. Publication No. 2006/0249567 to “Byrne” teaches an application downloaded from a bank that provides an interactive session for a check deposit

and checks for errors in the check image before it is sent to the bank. U.S.

Publication No. 2006/0164682 to “Lev” further teaches that the interactive session includes instructing a user to take a photo of the check. U.S. Patent No. 7,027,171 to “Watanabe” teaches using a display of a handheld mobile device to assist the customer in taking the photo and assisting the customer as to an orientation for taking the photo. It would have been obvious to combine Garcia’s system with Byrne’s downloaded application, Byrne’s error checking mechanism, Lev’s interactive session, and Watanabe’s use of the handheld mobile device’s display and assistance as to orientation for taking a photo of the check.

Accordingly, Petitioner respectfully requests cancellation of the claims challenged in this Petition.

II. MANDATORY NOTICES

A. Real Party-In-Interest

Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner certifies that PNC Bank N.A. (“Petitioner”) is the real party-in-interest.

B. Related Matters

Under 37 C.F.R. § 42.8(b)(2), Petitioner states that Patent Owner (“PO”) has asserted the ’638 patent and two additional patents in *United Servs. Auto. Ass’n (“USAA”) v. PNC Bank N.A.*, Case No. 2:21-cv-00246-JRG (E.D. Tex.) (“*PNC IIP*”). PO has also asserted four patents in *USAA v. PNC Bank N.A.*, Case No. 2:20-cv-00319-JRG (E.D. Tex.) (“*PNC P*”) and two additional patents—including a

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