

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUIST BANK,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2023-00144
Patent 10,482,432 B1

Before KRISTEN L. DROESCH, TERRENCE W. McMILLIN, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* McMILLIN.

Opinion Dissenting filed by *Administrative Patent Judge* DIRBA.

McMILLIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Truist Bank (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–8 and 10–23 (“the challenged claims”) of U.S. Patent No. 10,482,432 B1 (Ex. 1001, the “’432 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 1 (“Petition” or “Pet.”) 1, 3. United Services Automobile Association (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Preliminary Response” or “Prelim. Resp.”). With our authorization (*see* Ex. 1039), Petitioner filed a Reply to the Preliminary Response (Paper 12 (“Preliminary Reply” or “Prelim. Reply”)) and Patent Owner filed a Sur-reply to the Preliminary Reply (Paper 14 (“Preliminary Sur-reply” or “Prelim. Sur-reply”)).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018); 37 C.F.R. § 42.4(a) (“The Board institutes trial on behalf of the Director”).

The principal issue presented is whether the ’432 patent is entitled to the benefit of the filing date of the initial application (U.S. Patent Application No. 11/591, 247 filed October 31, 2006) in the chain of continuation applications from which the ’432 patent claims priority. Ex. 1001, code (63), 1:7–21. The primary reference asserted in the present challenges to the claims of the ’432 patent is the first patent to issue from this chain of applications (U.S. Patent No. 7,873,200 B1 (Ex. 1005, “Oakes”)). *See* Pet. 4. Petitioner asserts Oakes does not provide written

description support for a “mobile device” as recited in the challenged claims of the ’432 patent. *See, e.g.*, Ex. 1001, 14:23–48 (“A system comprising: a customer’s mobile device” (sole independent claim 1); “mobile device” recited four more times in claim 1). According to Petitioner, the lack of written description support breaks the ’432 patent’s chain of priority to Oakes for all of the challenged claims and Oakes qualifies as prior art to the ’432 patent. *See* Pet. 13–27. Petitioner characterizes this issue as “dispositive.” *Id.* at 1.

Patent Owner contends that we “should deny institution because Petitioner has failed to demonstrate a reasonable likelihood of success on the merits” of its priority/written description argument. Prelim. Resp. 12. Specifically, Patent Owner argues:

[A]ll of Petitioner’s asserted grounds rely on “Oakes,” which issued on January 18, 2011—several years after the claimed priority date of the ’432 patent—and is therefore not prior art unless Petitioner could demonstrate that the claims lack adequate written description in the originally-filed priority application. *See* Pet., 14 (not disputing the continuity of priority chain back to Appl. No. 11/591,247, filed October 31, 2006). Petitioner does not come close to meeting its burden to do so.

Id.

After considering the Petition, the Preliminary Response, the Reply, the Sur-reply, and the evidence of record, we agree with Patent Owner that Oakes provides written description support for “mobile device” as recited in the ’432 patent claims. As a result, Oakes is not prior art to the ’432 patent and the challenges to the claims fail.

B. Related Proceedings

The parties identify the following district court litigation as related matters because they involve the '432 patent: (1) *United Services Automobile Association v. Truist Bank*, 2:22-cv-00291-JRG-RSP (E.D. Tex.); (2) *United Services Automobile Association v. BBVA USA*, 2:21-cv-00311-JRG (E.D. Tex.); and (3) *United Services Automobile Association v. PNC Bank N.A.*, 2:20-cv-00319-JRG-RSP (E.D. Tex.). Pet. 83; Paper 5 (Patent Owner's Mandatory Notices), 2.

The parties also identify the following completed (institution denied) proceedings before the Board involving the '432 patent: *PNC Bank, NA v. United Services Automobile Association*, IPR2021-01071; and *PNC Bank, NA v. United Services Automobile Association*, IPR2021-01074. Pet. 83; Paper 5, 2.

And, Patent Owner identifies "IPR2023-00143 [that] was filed concurrently by Petitioner also challenging the '432 patent" as a related matter. Paper 5, 2.

C. The '432 Patent

The '432 patent is titled "Systems and Methods For Remote Deposit Of Checks." Ex. 1001, code (54). The disclosure relates to "[r]emote deposit of checks . . . facilitated by a financial institution[, a] customer's general purpose computer[, and] image capture device . . . leveraged to capture an image of a check and deliver the image to financial institution electronics" such that a "[check deposit] transaction can be automatically accomplished utilizing the images and data thus acquired." *Id.*, code (57).

The '432 patent explains that "[c]hecks typically provide a safe and convenient method for an individual to purchase goods and/or services" but

“receiving a check may put certain burdens on the payee, such as the time and effort required to deposit the check. For example, depositing a check typically involves going to a local bank branch and physically presenting the check to a bank teller.” *Id.* at 1:22–24, 2:1–6. In addition, traditional check deposit and clearing do not provide quick access to the funds from the check. *Id.* at 2:1–27. Thus, the ’432 patent addresses “a need for a convenient method of remotely depositing a check while enabling the payee to quickly access the funds from the check.” *Id.* at 2:27–30.

Figure 1 of the ’432 patent is reproduced below.

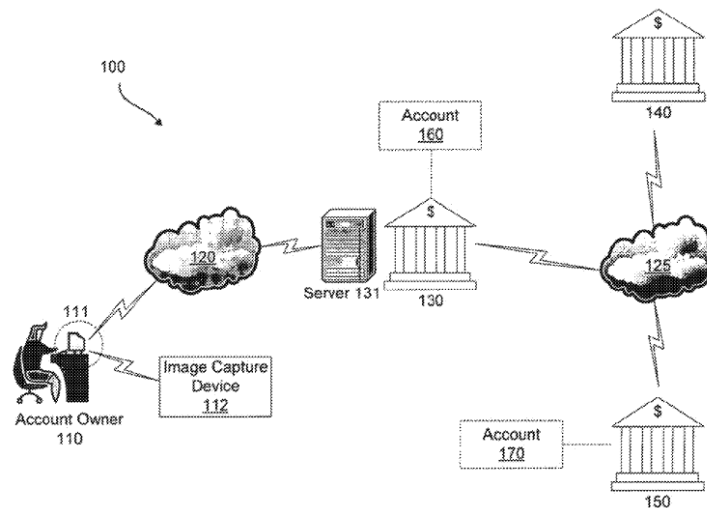


FIGURE 1

Figure 1 of the ’432 patent, reproduced above, “illustrates a broad view of a [network] system in which the described embodiments may be employed.” *Id.* at 3:15–16.

System 100 includes: (i) a “customer-controlled, general purpose computer 111” used by an account owner 110, e.g., a bank customer located at the customer’s private residence; (ii) an “image capture device 112 [that] may be communicatively coupled to the computer”; and (iii) financial institutions 130, 140, and 150, which are retail banks, investment banks,

investment companies, or other type of entities capable of processing a transaction involving a negotiable instrument. *Id.* at 3:46–4:64, 5:4–14.

Account owner 110 owns an account 160 held at financial institution 130. *Id.* at 5:26–31. When account owner 110 wishes to deposit a check into the account, “[a]ccount owner 110 may deposit the check into account 160 by converting the check into electronic data and sending the data to financial institution 130.” *Id.* at 5:62–65. “[A]ccount owner 110 may convert the check into a digital image by scanning the front and/or back of the check using image capture device 112.” *Id.* at 6:4–7. Account owner 110 then sends the image to financial institution 130. *Id.* at 6:6–9. Upon receiving the image, financial institution 130 communicates with other financial institutions (e.g., 140 and 150) to clear the check and credit the funds to account 160. *Id.* at 6:12–49.

Figure 2 of the ’432 patent is reproduced below.

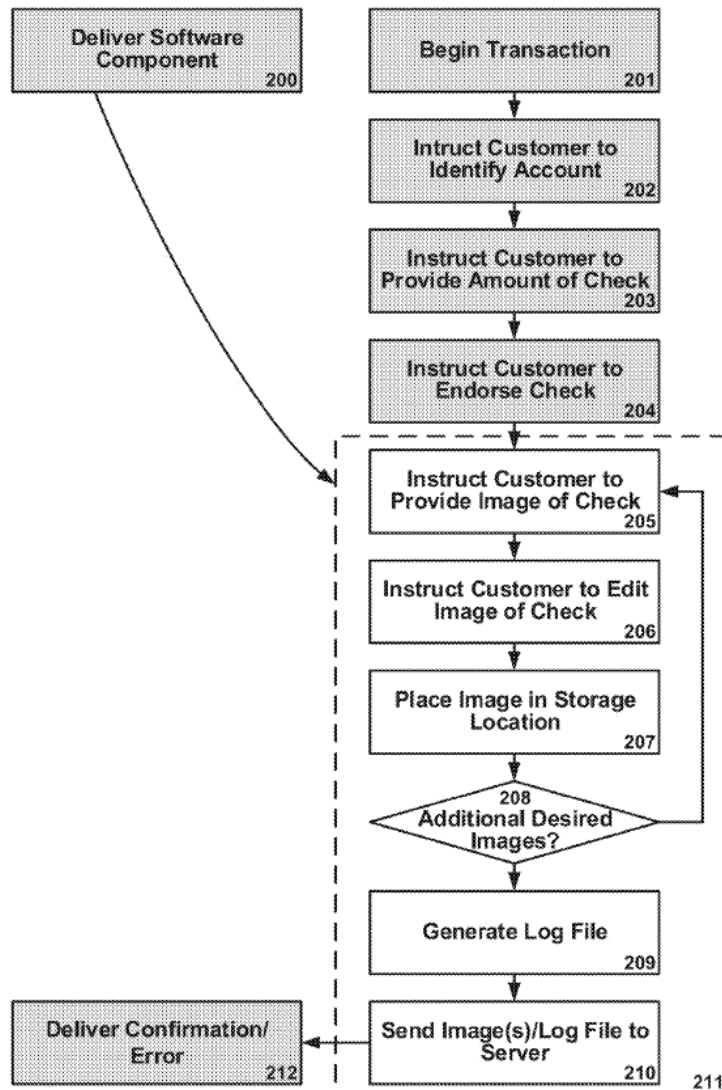


FIGURE 2

Figure 2, reproduced above, “illustrates a method for facilitating deposit of a check from the customer controlled general purpose computer.” *Id.* at 3:17–19.

The ’432 patent explains that the steps “may be viewed as performed by a server computer associated with a financial institution, in conjunction with a software component that operates from a customer-controlled general purpose computer.” *Id.* at 6:52–58. More particularly, “the darker boxes [in

Figure 2] indicate steps that are performed by the server, for example by delivering information to the user through the user's browser application," while "[the] lighter boxes inside 211 indicate steps that are performed by the software component, as it executes on the customer computer," with "alternative configurations . . . readily achievable by moving functions from server to software component or vice-versa." *Id.* at 6:59–7:2.

As shown in Figure 2, after downloading or otherwise accepting a software component (e.g., from a financial institution's server) to be installed on the customer-controlled general purpose computer 200, the customer has the capability to make deposits from his general purpose computer. *Id.* at 7:3–42. After identifying a deposit account, identifying an amount of a check or other negotiable instrument the customer wishes to deposit, and endorsing the check (steps 201–204 in Figure 2), "[t]he customer may next be instructed to provide an image of a front side of a check 205, for example, by using an image capture device." *Id.* at 7:47–8:7. For example, "the customer may be instructed to place the check face down on a flatbed scanner, and may further be instructed as to the location and orientation of the check on the scanner," or "the customer is instructed to take a digital photograph of the check using a digital camera . . . [and] instructed as to the position and orientation of the check, lighting, angle of camera, distance and focal length (zoom) of camera, and so forth." *Id.* at 8:5–21. The software component on the customer's device may guide the customer by providing a graphical illustration of how the customer should provide the image. *Id.*

The software component on the customer's device "may next cause the image of the check to be presented to the customer for editing, e.g. by

asking the customer to crop and/or rotate the check image to a predetermined orientation 206.” *Id.* at 8:45–48. The customer may also be asked to indicate the bottom right corner of the check image, and the image may be cropped to contain only the check image, thereby removing a portion of the originally obtained image. *Id.* at 8:51–55. After obtaining and storing (in a storage location, step 207) images of front and back sides of the check, a log file may be generated 209 to collect data for processing or troubleshooting the deposit transaction. *Id.* at 8:56–64. Once the desired images are collected and edited, they are delivered to the bank server for processing the deposit 210. *Id.* at 9:1–3. If the bank’s (or other financial institution’s) server determines that the delivered images and any corresponding data are sufficient to go forward with the deposit, the customer’s account is provisionally credited, and a confirmation page is delivered to the customer via customer’s browser application 212. *Id.* at 9:3–11.

D. Challenged Claims

Petitioner challenges claims 1–8 and 10–23 of the ’432 patent.¹ Pet. 4. Claim 1 is the sole independent claim. Ex. 1001, 14:23–16:20 (all claims). Claim 1 recites:

1. A system comprising:
a customer’s **mobile device** including a downloaded app, the downloaded app provided by a bank to control check deposit by causing the customer’s **mobile device** to perform:
instructing the customer to have a digital camera take a photo of a check;

¹ The only claim of the ’432 patent that is not challenged is claim 9 which recites “the customer’s mobile device is a laptop.” Ex. 1001, 15:5–6.

giving an instruction to assist the customer in placing the digital camera at a proper distance away from the check for taking the photo;

presenting the photo of the check to the customer after the photo is taken with the digital camera;

using a wireless network, transmitting a copy of the photo from the customer's **mobile device** and submitting the check for mobile check deposit in the bank after presenting the photo of the check to the customer; and

a bank computer programmed to update a balance of an account to reflect an amount of the check submitted for mobile check deposit by the customer's **mobile device**;

wherein the downloaded app causes the customer's **mobile device** to perform additional steps including:

confirming that the mobile check deposit can go forward after optical character recognition is performed on the check in the photo; and

checking for errors before the submitting step.

Ex. 1001, 14:23–48 (emphasis added).

E. The Asserted Grounds

Petitioner challenges claims 1–8 and 10–23 of the '432 patent based on the grounds set forth in the table below. Pet. 4.

| Ground | Claims Challenged | 35 U.S.C. | Reference(s) |
|--------|-------------------|-----------|--|
| 1 | 1–8, 10–23 | § 103 | Oakes, ² Singfield ³ |
| 2 | 3, 4 | § 103 | Oakes, Garcia ⁴ |

Petitioner additionally relies on the Declaration of Dr. David Doermann (Ex. 1003 (“Doermann Decl.”)).

II. ANALYSIS

A. *Legal Standards*

“It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008). “To satisfy the written description requirement [in § 112,] the disclosure of the prior application must ‘convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of *the invention*.’” *Id.* (alteration in original) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)).

“[T]he hallmark of written description is disclosure.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The sufficiency of written description support is based on “an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.* “Based on that inquiry, the specification must

² US7,792,753 B1, filed October 31, 2006; issued January 18, 2011. (Ex. 1005).

³ US 2005/0097046 A1, published May 5, 2005 (Ex. 1006).

⁴ WO 2005/043857 A1, published May 12, 2005 (Ex. 1008).

describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Id.* “The level of detail required to satisfy the written description requirement” necessarily “varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* The invention need not be described *in haec verba*, but a disclosure that merely renders obvious the claims does not provide adequate written description support. *Id.* at 1352.

The written description requirement “guards against the inventor’s overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.” *Vas-Cath*, 935 F.2d at 1561; *see also Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1323 (Fed. Cir. 2002) (“[A] broad claim is invalid when the entirety of the specification clearly indicates that the invention is of a much narrower scope.”). However, “[a] claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language.” *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001) (“An applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention.”); *see also Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1582 n.7 (Fed. Cir. 1996) (“If [the applicant] did not consider the precise location of the lockout to be an element of his invention, he was free to draft [his claim] broadly (within the limits imposed by the prior art) to exclude the lockout’s exact location as a limitation of the claimed invention. Such a claim would not be unsupported by the

specification even though it would be literally infringed by undisclosed embodiments.” (citations omitted)).

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Petitioner, however, cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

With regard to the level of ordinary skill in the art, Petitioner contends:

A person of ordinary skill in the art (POSA) of the ’432 patent would have had either: (1) a Bachelor of Science degree in Electrical Engineering, Computer Engineering, Computer Science, or an equivalent field, with at least two years of academic or industry experience in financial technology, including image processing; or (2) a Master of Science degree in Electrical Engineering, Computer Engineering, Computer Science, or an equivalent field, with at least a year of academic or industry experience in the same field. Higher levels of education may offset less experience and vice versa.

Pet. 4 (citing Doermann Decl. ¶¶ 4–13, 26–28). Patent Owner does not address the level of ordinary skill in the art. *See generally* Prelim. Resp.

Petitioner’s proposal is consistent with the technology described in the Specification of the ’432 patent and the cited prior art. For that reason, and in order to determine whether Petitioner has demonstrated a reasonable

likelihood of showing the unpatentability of at least one of the challenged claims, we adopt Petitioner’s proposed level of skill in the art.

C. Claim Construction

In an *inter partes* review, “[claims] of a patent . . . shall be construed using the same claim construction standard that would be used to construe the [claims] in a civil action under 35 U.S.C. § 282(b), including construing the [claims] in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2018); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005).

Because the dispositive priority/written description issue is related to the meaning of “mobile device,” the only claim term we need to consider is “mobile device.” *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (explaining that construction is needed only for terms that are in dispute, and only as necessary to resolve the controversy).

The Petition states:

For the purposes of this Petition, Petitioner adopts the claim constructions USAA advanced and the Court adopted in *USAA v. PNC Bank N.A.*, No. 2:20-CV-319 (E.D. Tex.) (“PNC Litigation”). Ex. 1009. USAA is estopped from arguing against this construction, including that the “mobile phone” means “handheld computing device” and excludes laptops from its scope. *Id.*, 20.

Pet. 8. Petitioner asserts that the District Court in the PNC Litigation construed “mobile device” as a “‘handheld computing device’ excluding laptops” as shown in this excerpt from a table in the Petition.⁵ *Id.* at 9.

| | |
|--|--|
| “mobile device” (claims 1, 8, 9, 13, 21, 23) | “handheld computing device” excluding laptops (Ex. 1009, 18, 20; Ex. 1015, 22, 25) |
|--|--|

Id. This table contains an inaccurate statement of the two cited district court claim construction orders⁶ in which “mobile device” was construed as “handheld computing device.” Ex. 1009, 20; Ex. 1015, 25. Critical to the issue before us, the two cited district court claim construction orders do not

⁵ In the Petition filed in IPR2023-00143 on the same day as the Petition in this proceeding, Petitioner provides a similar table but states that the District Court’s construction of “mobile device” in the PNC Litigation was simply “handheld computing device,” i.e., it did not contain the phrase “excluding laptops.” IPR2023-00143, Paper 1, 6. In support of this construction, Petitioner cites to page 20 of the same District Court Claim Construction Memorandum Opinion and Order (Exhibit 1015 in IPR2023-00143) that it relies on in this proceeding (Exhibit 1009). IPR2023-00143, Paper 1, 6. Petitioner does not ask that we construe “mobile device” in IPR2023-00143. *Id.* at 7. The Petition in IPR2023-00143 states, “laptops are mobile personal computers.” *Id.* at 15. Petitioner’s declarant, Dr. Doermann, testifies in IPR2023-00143 that “laptops are mobile personal computers.” IPR2023-00143, Ex. 1003 ¶ 65.

⁶ Exhibit 1009 is the “Claim Construction Memorandum Opinion and Order” in the PNC Litigation in which the construction of “mobile device” in the ’432 patent was at issue. Ex. 1009, 4, 14. Exhibit 1015 is the “Claim Construction Memorandum Opinion and Order” in *United Services Automobile Association v. Wells Fargo Bank, N.A.*, 2:18-cv-00366-JRG (E.D. Tex.) in which the construction of “mobile device” in U.S. Patent No. 10,013,681, (the parent of the ’432 patent through a continuation application and containing a substantially identical Specification as the ’432 patent) was at issue.

contain the phrase “excluding laptops,” as asserted by Petitioner. Ex. 1009, 20; Ex. 2015, 25. And, the cites to these two district court claim construction orders do not support adding “excluding laptops” to the construction of “mobile device.” To the contrary, Exhibit 1009 at page 18 states, “there may be some overlap between ‘handheld’ and ‘laptop.’” Page 20 of Exhibit 1009 has no discussion even reasonably related to excluding laptops from the construction of “mobile device” and states the construction of “mobile device” is “handheld computing device.” Page 22 of Exhibit 1015 provides that a “‘mobile device’ should . . . be understood as a device that is capable of easily being moved . . . with the understanding that the ease of movement is with reference to a human moving the device by hand.”⁷ Page 25 of Exhibit 1015 states “‘mobile device’ means ‘handheld computing device.’”

The only other evidence that Petitioner cites in support of its proposed claim construction is the Declaration of Dr. Doermann. *See* Pet. 10 (citing Ex. 1003 ¶¶ 37–42). However, it does not appear that Petitioner’s declarant, Dr. Doermann, conducted any analysis relating to claim construction. Dr. Doermann testifies “I have been informed that, for the purposes of this Petition, the Petitioner adopts the following claim constructions, which were

⁷ A laptop computer would be understood by a skilled artisan as a device that is capable of easily being moved by a human by hand. *See* Ex. 2011 (Merriam-Webster on-line dictionary), 2 (defining “laptop” as “a portable microcomputer”); IPR2023-00143, Ex. 1024 (Microsoft Computer Dictionary, Fifth Edition, Microsoft Corporation (2002)), 315 (defining “laptop” as a “small, portable personal computer”). Petitioner’s declarant, Dr. Doermann, agrees. *See* IPR2023-00143, Ex. 1003 ¶¶ 55 (“[P]rior to the ’423 patent, a ‘laptop’ was known to be ‘a small, portable *personal computer*.’”), 65 (“laptops are mobile personal computers”).

issued in a Claim Construction Order on November 22, 2021, in the PNC Litigation [Ex. 1009]” and “I apply these constructions throughout this declaration.” Ex. 1003 ¶¶ 40, 41. Dr. Doermann’s testimony on claim construction is not based on any independent analysis of any intrinsic or extrinsic evidence and is entitled to little or no weight. *See* 37 C.F.R. § 42.65(a). The total reliance by Petitioner’s declarant on Petitioner’s unsupported contention on the construction of “mobile device” provides a reason to give little or no weight to Dr. Doermann’s adopted construction of “mobile device” as a “‘handheld computing device’ excluding laptops” and his testimony based on this claim construction.

Petitioner asserts that it is adopting the construction of “mobile device” advanced by the Patent Owner in the PNC Litigation. Pet. 8. This also appears to be inaccurate. The construction of “mobile device” proposed by Patent Owner in the PNC litigation was “handheld computing device” (without the phrase “excluding laptops”). *See* Ex. 1009, 14. And, as noted by the District Court in its claim construction order in the PNC Litigation, Patent Owner argued “that ‘some handheld computing devices are configured as laptops’” and that the Specification of the ’432 patent states that “*any* ‘general purpose computer 111 may be in a *desktop* or *laptop configuration*,”” and “meaning that it encompasses systems configured with separate components (‘desktop configuration’) or with integrated components (‘laptop configuration’).” Ex. 1009, 16 (internal citations omitted).

Petitioner relies entirely on its misinterpretation of the district court claim construction order and Patent Owner’s arguments in the PNC Litigation to support its proposed construction of “mobile device” as a

“‘handheld computing device’ excluding laptops.” *See* Pet. 8–13 (addressing “Claim Construction”). And, as discussed above, both the claim construction order and Patent Owner’s argument contradict, rather than support, Petitioner’s proposed construction. Petitioner has provided no support for adding the phrase “excluding laptops” to the construction of “mobile device” as “handheld computing device.”

We also note that the claim construction proposed by Petitioner, especially as it relates to the phrase “excluding laptops,” is contradicted by claim 9 of the ’432 patent, which depends from claim 1 and explicitly recites, “the customer’s mobile device is a laptop.” Ex. 1001, 15:5–6. As noted previously, claim 9 is the only claim of the ’432 patent that is not challenged. Pet. 4. Petitioner does not address or discuss claim 9 anywhere in its Petition. *See generally id.*

For its part, Patent Owner states, “[t]he Board should apply the District Court’s actual claim construction . . . that ‘mobile device’ means ‘handheld computing device.’” Prelim. Resp. 18 (citing Ex. 1009, 20). With regard to “excluding laptops” from the construction of “mobile device,” Patent Owner provides extrinsic evidence supporting the conclusion that a skilled artisan would read “laptop” or “laptop configuration” as described in the Specification of the ’432 patent as “a portable microcomputer.” *Id.* at 19 (citing Ex. 2011, 2).

On this record and for purposes of deciding whether to institute trial, we construe “mobile device” as “handheld computing device,” because both parties ask us to adopt the District Court’s claim construction.⁸ We do not

⁸ Petitioner does not dispute that we should “adopt[] the claim constructions [Patent Owner] advanced and the Court adopted in [the PNC Litigation].”

include the phrase “excluding laptops” as part of this construction as the arguments in support of this construction in the Petition are contradicted by the evidence and Petitioner has otherwise failed to support the inclusion of this phrase in the construction.

D. Written Description

Petitioner asserts that Oakes is prior art because it and the other patents in the ’432 patent’s chain of priority reaching to Oakes lack a written description of “mobile device” as recited in the claims of the ’432 patent because:

[T]he priority documents predating July 28, 2017, which have identical disclosures, unequivocally limit [Patent Owner]’s claims to using general purpose computers or PCs, such as laptops and desktops, for remote check deposit and fail to include any support or suggestion for using handheld devices for remote check deposit or even mention the terms “mobile device” or “handheld computing device” (or variations thereof).

Pet. 16–17. In support, Petitioner contends that “[l]aptop computers, as mentioned in the *Oakes* disclosure, are not ‘mobile devices.’” *Id.* at 18. And, Petitioner therefore concludes that “[a] POSA reviewing *Oakes* would not have understood the inventors of the ’432 patent to be in possession of completing remote check deposits with handheld devices from 2006

Pet. 8. And, we adopt the construction of “mobile device” that Patent Owner advanced and the District Court adopted in the PNC Litigation. We acknowledge that Petitioner does not agree with the construction we adopt for “mobile device,” because we do not include the phrase “excluding laptops.” And, although Petitioner does not say so, it seems from Petitioner’s efforts to explicitly exclude “laptops” from the construction of “mobile device” that Petitioner, at least impliedly, acknowledges that without this exclusionary phrase “handheld computing device” would be understood by a skilled artisan to include “laptops.” Otherwise, the exclusionary phrase would be superfluous.

[because] *Oakes* lacks any disclosure of such devices.” *Id.* at 18–19. We reject this argument.

This argument appears to present a fairly simple issue for resolution—whether a skilled artisan would understand a “laptop” (as disclosed in the priority document, the Specification of *Oakes*) to be a “mobile device” (as recited in the challenged claims of the ’423 patent). Stated this way, after consideration of the evidence and arguments before us, we determine the answer is “yes.” Nonetheless, we believe that further discussion of the arguments and evidence, as set forth below, is warranted and we elaborate on the reasoning supporting the denial of institution.

We begin with a straightforward comparison of the language of the disclosure in *Oakes* with the relevant claim term. *Oakes* discloses a system that includes “[a] general purpose computer . . . in a . . . laptop configuration” (*see* Ex. 1005, 3:56–57) and the claims of the ’432 patent recite a “mobile device” (Ex. 1001, 14:23–16:20). We determine that a skilled artisan would readily and immediately understand that a general purpose, laptop computer is a mobile device.⁹ The well-known, conventional meaning of “laptop” is a mobile, general purpose computer.

⁹ In IPR2023-00143, Petitioner stated that, “prior to the ’432 patent, a ‘laptop’ was known to be a ‘small, portable *personal computer*.’” IPR2023-00143, Paper 1, 10 (citing the definition of “laptop” in the Microsoft Computer Dictionary, Fifth Edition, Microsoft Corporation (2002) (Exhibit 1024, 315). The Merriam-Webster dictionary defines “laptop” as “of a size and design that makes operation and use on one’s lap convenient” and “a portable microcomputer having its main components (such as processor, keyboard, and display screen) integrated into a single unit capable of battery-powered operation.” Ex. 2011, 2.

Claim 9 of the '432 patent recites, “the customer’s mobile device is a laptop.” Ex. 1001, 15:5–6. As noted above, claim 9 is the only claim of the '432 patent that Petitioner does not challenge, presumably because it directly contradicts its argument that “laptops” are not “mobile devices.” In the Declaration of Dr. Doermann filed by Petitioner in IPR2023-00143 (also challenging the '432 patent), Dr. Doermann (who is also Petitioner’s declarant in this proceeding), testifies that “I understand that ‘mobile device’ may encompass laptops, because dependent claim 9 says ‘the customer’s mobile device is a laptop’” and applies ‘an interpretation of ‘mobile device’ as including laptops.’” IPR2023-00143, Ex. 1003 ¶ 56.

We are troubled by the contradictory arguments and evidence in IPR2023-00143, especially the contradictory testimony of Dr. Doermann. The Petitions challenging the '432 patent (Paper 1 in this proceeding and IPR2023-00143) and the Declarations of Dr. Doermann (Exhibit 1003 in this proceeding and IPR2023-00143) were filed on the same day. Dr. Doermann signed both declarations on the same day. Ex. 1003, 81; IPR2023-00143, Ex. 1003, 105. We understand that a party may proffer alternative arguments, but do not understand that to allow offering contradictory testimony from the same witness on the same issue relating to the same patent on the same day.

The Petition in IPR2023-00143 (Paper 1) challenges claims of the '432 patent based on different prior art. IPR2023-00143, Paper 1, 2–3. The primary reference relied on by Petitioner in IPR2023-00143 is Acharya (U.S. Patent Application Publication No. 2005/0267843). *Id.* at 2. In the Petition in IPR2023-00143, Petitioner relies on paragraph 22 of Acharya as disclosing a “mobile device” as recited in the claims of the '432 patent. *See,*

e.g., id. at 9–11. Paragraph 22 of Acharya, in its entirety, provides, “The RCT [(Remote Customer Terminal)] may be a telephone, fax machine, personal computer, ATM, or any other computer, apparatus, or system capable of collecting data and communicating with BOFD [(Bank of First Deposit)] system.” IPR2023-00143, Ex. 1005 ¶ 22. Petitioner argues that this passage in Acharya “at least suggests using *a mobile device, such as a laptop*, because Acharya discloses using a PC or any type of computer.”¹⁰ IPR2023-00143, Paper 1, 9. In support of the Petition in IPR2023-00143, Petitioner’s declarant, Dr. Doermann, testifies:

Acharya discloses the same system components as the ’432 patent. Similar to a customer’s “general purpose computer 111” in the ’432 patent for initiating a check deposit (see ’432 patent, Fig. 1, 3:46-61), *Acharya* discloses a “Remote Customer Terminal 100” (RCT 100) that may be a personal computer “or any other computer, apparatus, or system capable of collecting data and communicating with” a banking system. Ex. 1005, [0021], Fig. 1. . . . *Acharya* and the ’432 patent disclose the same system architecture.

* * *

[T]he claims [of the ’432 patent] recite a “mobile device,” but the ’432 specification does not provide any particular reason for or benefit from using a mobile device; instead, the specification persistently discloses the use of a “general purpose” computer, that “may be in a desktop or laptop configuration.” ’432 patent, 2:46-64, 3:46-4:46, 6:50-58. Like the specification, *Acharya* teaches using “any [type of] computer.” Ex. 1005, [0022].

* * *

¹⁰ Petitioner does not reconcile this statement in the Petition in IPR2023-00143 to the effect that a “laptop” is a “mobile device” or the statement that “laptops are mobile personal computers” (IPR2023-00143, Paper 1, 15) with its argument in this proceeding that the meaning of “mobile device” excludes a “laptop.”

It was well known before the earliest priority date of the '432 patent for a customer to use a laptop for activities requiring a computer, because most laptops were “small, personal computer[s]” that “can run the same software as their desktop counterparts and can accept similar peripherals.” Ex. 1024, 315 (definition of “laptop”); *see also id.* at 409 (defining “personal computer” as “[a] computer designed for use by one person at a time.”).

* * *

Acharya teaches using “any computer, apparatus, or system, including “a telephone . . . **personal computer** . . . or **any other computer**.” Ex. 1005, [0022]. In my opinion, a person of ordinary skill in the art would have understood that *Acharya*’s non-limiting disclosure encompasses laptops. Indeed, prior to the '432 patent, a “laptop” was known to be “a small, portable personal computer.” Ex. 1024, 315 (definition of “laptop,” emphasis added).

* * *

In my opinion, the '432 patent disclosure of using personal computers in “desktop or laptop configuration[s]” confirms my opinion that a person of ordinary skill in the art would have understood that *Acharya*’s disclosure of “personal computers” would have included purportedly mobile devices like laptops. *See* '432 patent, 3:47-61, 4:3-25.

* * *

Acharya discloses using a personal computer and a scanner—arguably immobile devices (although laptops are mobile personal computers), but also teaches that any capable computer could have been used for capturing document images, thereby suggesting the use of a laptop or other computing device such as a mobile phone. Ex. 1005, [0022]-[0023].

* * *

Acharya suggests a customer’s laptop computer because *Acharya* discloses using a personal computer for remote check deposit, and discloses using any computer capable of collecting and communicating data. Ex. 1005, [0022].

IPR2023-00143, Ex. 1003 ¶¶ 41, 48, 52, 55, 58, 65, 126. In this testimony, Dr. Doermann clearly acknowledges that a skilled artisan would have understood the disclosure of a general purpose computer to include “laptops,” which are a type of “mobile device.”

Dr. Doermann’s testimony in this proceeding is strikingly different and inconsistent. In this proceeding, Dr. Doermann bases his testimony that Oakes fails to provide written description support for “mobile device” based on construing mobile device as “‘a handheld computing device’ that excludes laptops.” Ex. 1003 ¶ 45 (“In my opinion, the 2006 Oakes disclosure fails to provide sufficient written description support for ‘mobile device,’ as construed in this Petition (i.e., ‘a handheld computing device’ that excludes laptops.”). Here, Dr. Doermann testifies:

A person of ordinary skill in the art, reading *Oakes*, would have understood that *Oakes* only discloses using a “general-purpose computer” or “PC,” such as a “desktop or laptop,” to complete remote check deposit. *See Oakes*, Abstract, 2:37-44, 3:49-4:11, 6:46-51, 6:66-67, 7:20-38, 8:18-35, 8:62-64, 11:11- 15, 12:10-20, 13:5-7, 13:60-64, Fig. 1.

* * *

It is my opinion, *Oakes* discloses using a customer’s device with a downloaded app to control check deposit but does not disclose “customer’s mobile device,” as interpreted by the Patent Owner.

* * *

Oakes discloses a customer’s “general purpose computer.”

* * *

Oakes does not disclose a “mobile device” as interpreted by the Patent Owner and district court as a “handheld computing device.”

Ex. 1003 ¶¶ 46, 63, 64, 68. Dr. Doermann testifies in this case that the disclosure of a general purpose computer or PC fails to provide written description support for “mobile device” as recited and, in IPR2023-00143, Dr. Doermann testifies that a skilled artisan would interpret the disclosure of a general purpose computer or PC as disclosing a “mobile device.” Quite simply, Dr. Doermann’s testimony relating to the “mobile device” element of the claims of the ’423 patent does not appear to be reliable and we give it little or no weight.

Petitioner argues that, applying the construction of “mobile device” as meaning a “‘handheld computing device’ excluding laptops,” the claims as construed lack written description support. *See, e.g.*, Pet. 17–18. The Petition states:

[A]ll ’432 claims reciting a ‘mobile device’ require a ‘handheld device’ that cannot be a laptop. . . .

Because the 2006 *Oakes* disclosure unequivocally limits the claims to using general purpose computers or PCs to perform remote check deposit, it fails to provide written description support for the claimed “mobile device,” which has been interpreted by USAA and construed by the Court in two earlier proceedings as “handheld devices.” . . . Laptop computers, as mentioned in the *Oakes* disclosure, are not “mobile devices.”

Id. And, Petitioner’s declarant, Dr. Doermann, applies this construction (“‘handheld computing device’ excluding laptops”) “throughout []his declaration.” Ex. 1003 ¶ 41. As discussed above (Section II.C.), we reject Petitioner’s contention that the construction of the term “mobile device” explicitly excludes “laptops.”

Patent Owner contends that “Petitioner’s entire written description theory is based on a false premise, which is an independent basis to reject it.” Prelim. Resp. 17. We agree.

In support of its written description argument, Petitioner argues that “[l]aptop computers are not handheld computing devices.” Pet. 21. But, here again, Petitioner’s argument is based on construing “mobile device” as “excluding laptops.” *See id.* The Petition states:

“[M]obile device” means handheld devices excluding laptops. Thus, the “laptop” described in *Oakes* does not provide support for the claimed “mobile device.” And a POSA would not consider a laptop device to be a “handheld computing device” because the customary and intended use of a laptop is while the laptop is out of the user’s hand and resting on some object (e.g., lap, desk, table, etc.), not while it is being completely held in a user’s hand.

Id. (citing Doermann Decl. ¶ 52). The evidence cited in support of this contention is a paragraph in Dr. Doermann’s declaration. But, this evidence is tainted by Dr. Doermann basing his testimony “throughout []his declaration” (Ex. 1003 ¶ 41) on the incorrect construction of “mobile device” proposed by Petitioner. Petitioner’s argument and evidence fail to support its contention that “mobile device” lacks written description support in *Oakes* because Petitioner and its declarant base this argument on an improper claim construction.

Patent Owner provides argument and evidence showing that a skilled artisan would have understood *Oakes*’s disclosure to provide written description support for “mobile device” construed as “handheld computing device.” *See* Prelim. Resp. 18–33. Patent Owner argues Petitioner fails to address *Oakes*’s disclosure in view of the handheld, general-purpose

computers that by 2006 were widely available. *Id.* at 24–26. The Preliminary Response states:

[T]here is no basis for Petitioner’s argument that a POSA would not understand a “handheld computing device” to be a type of “general purpose computer.” *See* Pet., 18. In fact, handheld computing devices (such as mobile phones) in 2006 were understood to be “pocket-sized computers,” often running the same operating systems (such as Windows) that the specification describes as exemplary of general purpose computers. *See* Ex. 1001, at 3:51-56. For example, the Palm Treo smartphone announced in early 2006 was described as a “Treo smart phone that runs Microsoft Corp.’s Windows Mobile 5.0 operating system.” Ex. 1031, at 2. Even a decade earlier, the “CE” version of Windows was used to “run pocket-sized computers,” i.e., handheld computing devices. *See* Ex. 1029, at 2 (“ . . . Designed to run pocket-sized computers, CE brought the user-friendly Windows 95 interface to mobile computing for the first time. Its architecture also formed the basis of Microsoft’s later mobile computing and smartphone products.”).

Notably, Petitioner’s expert does not contest that these and other handheld computing devices known in the art were considered “computers.” *See* Pet., 22–23. That is because it is indisputable that these devices, such as the Palm Treo discussed in Exhibits 1030 and 1031, were handheld computers—as described in their documentation, they had processors, RAM, hard drive storage, a keyboard and display for input/output, and ran software such as an operating system, user interface, and user applications. *See, e.g.,* Ex. 1030, at 18-19, 23; Ex. 1031 (describing Palm Treo devices running Windows OS). This is the very same functionality described as characteristic of customer-controlled general purpose computers in the ‘432 patent specification. *See* Ex. 1001, at 3:51-56 (typically “running one of the well-known WINDOWS® brand operating systems made by MICROSOFT® Corp.”), 3:57-61 (“generally has the ability to run any number of applications that are written for and compatible with the computer’s operating system”). Indeed, the Palm documentation describes Palm OS as

“designed from the beginning for *mobile computing*” and “leading the *mobile computing revolution* since the introduction of the first Palm Pilot *in 1996*.” Ex. 1030, at 14. Consistent with this understanding in the art, mobile phones and other handheld computing devices were commonly referred to as “general purpose computers” in the literature prior to October 2006. *See, e.g.,* Ex. 2017, at 3:9–15 (“Portions of the present invention may be conveniently implemented on a ***general purpose computer, such as a modern PDA, Palm™, cell phone,*** satellite phone, or networked computers, and the results may be displayed on an output device connected to any of the general purpose, PDA, Palm™, networked computers, or transmitted to a remote device for output or display.”); Ex. 2018, at 2–3 (“squeezing a general-purpose computer into a small casing.”).

Prelim. Resp. 24–26. We determine that this argument and evidence is more persuasive and better supported than Petitioner’s contrary arguments and evidence.

We determine that Patent Owner’s position that a skilled artisan in the relevant time frame would have found clear support for the full-scope of the invention claimed including a “mobile device” as recited and construed as a “handheld computing device” is well-supported. In contrast, Petitioner’s argument and evidence are based on an improper claim construction and lack substantial supporting evidence.

For these reasons, we determine that Oakes does provide written description support for “mobile device” as recited in the challenged claims of the ’432 patent and the ’432 patent is entitled to claim priority to the filing date of the application that issued as Oakes. As a result, Oakes is not prior art to the ’432 patent and all the challenges in the Petition fail because they rely on Oakes as prior art.

III. CONCLUSION

Because Oakes has not been shown to be prior art, we determine that Petitioner has not demonstrated a reasonable likelihood of showing at least one of the claims challenged in the Petition is unpatentable.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that no *inter partes* review is instituted on any challenged claims under the grounds presented in the Petition.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUIST BANK,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2023-00144
Patent 10,482,432 B1

Before KRISTEN L. DROESCH, TERRENCE W. McMILLIN, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge, dissenting*.

In my view, the majority improperly denies institution in this proceeding. Petitioner advances a reasonable contention and cites competent evidence and authority in support (*see* Pet. 16–24; *see also, e.g.*, Ex. 1003 ¶ 52; Ex. 1015, 25), and Patent Owner neither directly disputes that contention nor identifies evidence that undermines it (*see* Prelim. Resp. 12–33). Although the majority determines that Petitioner’s showing is insufficient, I disagree.

As the majority explains, the dispositive issue is whether Petitioner has shown that there is insufficient written description support for the “mobile device” required by the claims of the ’432 patent. The majority construes the claim term “mobile device” to mean a “handheld computing device,” and I agree that this construction should apply at this stage: (1) a district court reached this construction, and (2) the parties agree that the district court’s construction should apply in this proceeding. *See* Ex. 1009, 20; Pet. 8; Prelim. Resp. 18. I also agree that the district court’s construction does not expressly exclude laptops per se, despite Petitioner’s argument to the contrary. *See* Ex. 1009, 20; Pet. 8–9. But I cannot agree with the majority’s treatment of Petitioner’s written description arguments.

The written description at issue does not refer to either a “mobile device” or a “handheld” device; instead, it describes a “general purpose computer” that may be a “laptop.” *See, e.g.,* Ex. 1005, Abstr., 2:37–44.¹¹ Specifically, the specification states:

A general purpose computer 111 is generally a Personal Computer (PC) running one of the well-known WINDOWS® brand operating systems made by MICROSOFT® Corp., or a MACINTOSH® (Mac) brand computer, running any of the APPLE® operating systems. General purpose computers are ubiquitous today and the term should be well understood. A general purpose computer 111 may be in a desktop or laptop configuration, and generally has the ability to run any number

¹¹ The ’432 patent claims priority through a series of continuation applications to the application that issued as Oakes (i.e., the prior art asserted by Petitioner). Ex. 1001, code 63; Ex. 1005. According to Petitioner, the term “mobile device” was first added to this patent family in 2017. Pet. 17. Petitioner uses Oakes’s disclosure as a proxy for the content of the priority applications (*see id.* at 18–21), and for convenience, so do I.

of applications that are written for and compatible with the computer's operating system.

Id. at 3:50–59 (emphases added) (*quoted in* Pet. 19–20); *see also id.* at 4:1–11 (providing examples of “a typical computer located in a private residence,” “college dormitor[y],” or “office[]”).

Petitioner’s expert, Dr. Doermann, testifies that an ordinary artisan “would not have considered a Windows PC, an Apple Mac computer, a desktop computer, or a laptop computer to be *handheld* computing devices.” Ex. 1003 ¶ 48 (*cited in* Pet. 20). Dr. Doermann explains that a laptop would not have been considered a “handheld computing device” by an ordinary artisan because “the customary and intended use of a laptop is while the laptop is out of the user’s hand and resting on some object (e.g., lap, desk, table, etc.), not while it is being completely held in a user’s hand.” *Id.* ¶ 52 (*cited in* Pet. 21). I credit this testimony because (1) Dr. Doermann explains his opinions and (2) I discern no evidence that contradicts his testimony.

Two district court orders also support Petitioner’s position. *See* Pet. 11–12 (citing Ex. 1015, 22, 25; Ex. 1009, 17–18). In 2019, a district court issued an order that construed the terms “mobile device” and “portable device,” as recited in the claims of U.S. Patent No. 10,013,681 (“the ’681 patent”), the immediate parent of the ’432 patent. Ex. 1015, 20–25. In the ’681 patent, some claims recited a “mobile device” where others recited a “portable device” (*see id.* at 20), and the court determined that these are “distinct” terms with different meanings (*id.* at 25; *see also id.* at 22). The court explained that both types of devices are “capable of easily being moved” by “a human moving the device by hand.” *Id.* at 22; *see also id.* at 25. The court also stated that these terms are different because a “mobile

device” is necessarily “handheld,” “whereas a ‘portable device’ would encompass a device such as a laptop computer.” *Id.* at 22, 25. The district court ultimately articulated the following constructions:

- “mobile device” means “handheld computing device”;
and
- “portable device” means “computing device capable of being easily moved manually.”

Id. at 25.

In 2021, a district court adopted these constructions when construing terms in both the ’432 and ’681 patents. Ex. 1009, 19–20. In its analysis, it quoted the prior statement indicating that a laptop is not a handheld device, but also stated that “there may be some overlap between ‘handheld’ and ‘laptop.’” *Id.* at 18. In addition, it noted that two other patents, both filed in 2009, referred to “handheld *or* laptop devices.” *Id.* (emphasis added). Finally, it addressed claim 9 of the ’432 patent, “which recite[s] that ‘the customer’s *mobile* device is a *laptop*,’” but determined that, even if the prior construction gives rise to an “internal inconsistency,” “this does not warrant a broader construction of the term ‘mobile device’ in all of the claims.” *Id.*

The analysis in these district court orders further supports Petitioner’s contention. The 2019 order indicates that the district court believed that an ordinary artisan would not have understood a “laptop” to be a “handheld device.” *See* Ex. 1015, 22, 25. The 2021 order indicates that the district court questioned whether there is any overlap between a “laptop” and a “handheld” device. *See* Ex. 1009, 18 (stating only that there “*may be some* overlap between” these terms (emphasis added)). But, even if there is overlap, that does not show that one *discloses* the other. For example, there is overlap between the terms “desk” and “kitchen table,” but a description of

a desk would not provide written description support for a claim requiring a kitchen table. Thus, the district court’s analysis leads me to believe that Petitioner is correct that, in 2006, an ordinary artisan would not have understood a “laptop” to disclose a “handheld computing device.”

For its part, Patent Owner never contends that a “laptop” is, in fact, a handheld device, but instead argues that a laptop is *portable*. See Prelim. Resp. 18–33. For example, Patent Owner points to a dictionary definition of “laptop” (*id.* at 20 (citing Ex. 2011, 2)), which states:

of a size and design that makes operation and use on one’s lap convenient – compare desktop . . .

a *portable* microcomputer having its main components (such as processor, keyboard, and display screen) integrated into a single unit capable of battery-powered operation.

Ex. 2011, 2 (emphasis added). In my view, this definition supports Petitioner’s position given the context provided by the district court orders. The majority also relies upon Patent Owner’s arguments that mobile phones and other handheld devices were considered a type of general purpose computer (*see* Prelim. Resp. 24–26), but in doing so, misses Patent Owner’s sleight of hand. The question is not whether a handheld device was a type of general purpose computer; instead, the question is whether reference to a “general purpose computer” (or a “laptop”) discloses a handheld device. So even if there were handheld devices that were also general purpose computers in 2006,¹² that does not mean that disclosure of a “general

¹² I also question whether the evidence would support such a finding. Patent Owner contends that there were “pocket-sized computers” at the time, pointing to the Palm Treo and Windows CE, but does not establish that an ordinary artisan would have considered these to be “general purpose computers.” See Prelim. Resp. 24–26.

purpose computer” demonstrates possession of a handheld device. A more specific example will illustrate my point: Even if the Palm Treo was a known general purpose computer in 2006, the specification’s disclosure of a “general purpose computer” would not provide written description support to a claim that requires a Palm Treo.

In my view, the majority opinion suffers from three other analytical errors. First, it fails to apply the agreed-upon construction of the term “mobile device,” and it instead evaluates whether a laptop was mobile in the sense of being *portable*. This error causes it to make findings that are not supported by the evidence of record. *See, e.g.*, Majority Op. 20 & n.9 (finding that “a skilled artisan would readily and immediately understand that a general purpose, laptop computer is a mobile device,” while citing evidence regarding a laptop’s portability).

Second, the majority improperly discounts Petitioner’s evidence in this proceeding because of perceived conflicts with another proceeding: *Truist Bank v. United Services Automobile Association*, IPR2023-00143 (“the 143 IPR”). In these two IPRs, Petitioner presents alternative contentions, but in my view, there is nothing inherently wrong with taking such positions at this stage. The majority unfairly accuses Dr. Doermann of presenting “contradictory testimony,” but his testimony is expressly premised on the claim constructions provided to him by counsel: In this proceeding, Dr. Doermann applies a construction of “mobile device” that *excludes* laptops (Ex. 1003 ¶¶ 40–41; *see also id.* ¶ 45), and in the 143 IPR, he applies a construction of “mobile device” that *includes* laptops (IPR2023-00143, Ex. 1003 ¶ 56 (“Solely for the purposes of this declaration, I have applied an interpretation of ‘mobile device’ as including laptops.”))).

Although the majority quotes from several paragraphs of Dr. Doermann’s declarations, it appears that the alleged conflict lies in his testimony that a particular reference asserted in the 143 IPR “at least suggests using a mobile device, such as a laptop, because [it] discloses using a PC” (IPR2023-00143, Ex. 1003 ¶ 52).¹³ I perceive no conflict between that testimony and his testimony in this proceeding for two reasons. First, as noted above, in the 143 IPR, he expressly assumed that the term “mobile device” includes laptops. Second, his assessment that a PC *suggests* a laptop is not in conflict with his assessment that a PC does not *disclose* a handheld device. Indeed, “a description that merely renders the invention obvious” is not enough to satisfy the written description requirement. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc).

Third, the majority erroneously determines that the Petition is premised on its incorrect claim construction. *See* Majority Op. 25–26. As explained above, the district court’s analysis certainly suggests that a laptop is not a “mobile device,” so Petitioner’s position is not unfounded.¹⁴ Also, as explained above, the district court’s analysis supports Petitioner’s ultimate contention, and the majority overlooks the import of this analysis.

¹³ The majority also asserts that “in IPR2023-00143, Dr. Doermann testifies that a skilled artisan would interpret the disclosure of a general purpose computer or PC as disclosing a ‘mobile device’” (Majority Op. 25); however, I disagree. In the cited passages, Dr. Doermann describes the similarities between the asserted prior art and the Specification of the ’432 patent, and he testifies that an ordinary artisan would have understood a PC to teach and suggest a laptop. *See id.* at 22–23.

¹⁴ Petitioner does itself no favors with the way it frames the district court’s claim construction in its two petitions, where Petitioner presents *different* assessments of the same district court order. *See* Pet. 9; IPR2023-00143, Paper 1 at 6. Both cannot be true.

In addition, the majority overlooks Dr. Doermann’s testimony regarding an ordinary artisan’s understanding of “handheld computing device,” which is not tainted by the construction he applied to “mobile device.” *See* Ex. 1003 ¶¶ 48, 52.

Finally, having reviewed the remainder of the record, I would institute *inter partes* review because Petitioner has demonstrated a reasonable likelihood that it will prevail in showing that the challenged claims are unpatentable. In particular, Petitioner provides a detailed showing that Oakes alone or in combination with either Randle or Garcia teaches or suggests each limitation of the challenged claims, and Petitioner provides a sufficient rationale for combining the references as proposed. *See* Pet. 28–74. Petitioner’s showings are reasonable and supported by the testimony of its declarant, Dr. Doermann (Ex. 1003). At this stage, Patent Owner does not dispute any of Petitioner’s substantive allegations (*see* Prelim. Resp.), and I would find that discretionary denial is not warranted because the arguments presented are *not* the same or substantially the same as the arguments previously presented to the Office in IPR2021-01071, IPR2021-01381, or during prosecution (*see id.* at 4–11; Reply 1–8; Sur-reply 3–4).

Accordingly, I respectfully dissent.

IPR2023-00144
Patent 10,482,432 B1

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