

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

United States Automobile Association,
Petitioner

v.

Auto Telematics Ltd.,
Patent Owner

Case No. IPR2025-00812
U.S. Patent No. 12,236,728

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. Introduction

Pursuant to 37 C.F.R. § 42.75, Patent Owner Auto Telematics Ltd. (“ATL”) respectfully requests Director Review of the Patent Trial and Appeal Board’s October 6, 2025 institution decision (“Institution Decision”, Paper 8) concerning U.S. Patent No. 12,236,728, App. 18/676,284 (USAA-1001, “the ’728 Patent”).

The Board first erred and abused its discretion by finding the independent claims’ limitation “throughout the driving period” was synonymous with “during the driving period”, Institution Decision at 9, 35, even though these are two distinct claim limitations. *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1382 (Fed. Cir. 2008) (“[D]ifferent claim terms are presumed to have different meanings.”); *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006). Specifically, several instances of “during the driving period” were amended during prosecution to “throughout the driving period” to overcome a rejection based on the Collopy reference. *See* USAA-1002 (’728 Patent file history) at 201-224; *see also* Paper 7 (“POPR”) at 6-7 and 9-10. The Board further erred by holding “the differentiation that Patent Owner attempts to make between “during” and “throughout” was unnecessary due to the synonymous meaning of these terms.” Institution Decision, Paper 8 at 9 and 35. This was error and an abuse of discretion.

Second, the Board erred by not considering ATL’s reasons for discretionary

denial with its Patent Owner Preliminary Response on July 18, 2025. Paper 7. ATL put forth reasons for discretionary denial, including that the Office had already received the same or substantially the same prior art or arguments (“Collopy” v. “Callopy” and Warren) during the prosecution of the ’728 Patent. *See* Paper 7; 35 U.S.C. §§ 314 and 325(d). The Board wholly failed to consider ATL’s reasons for discretionary denial. Further, the then Acting Director’s Interim Workload Memorandum of March 26, 2025, fails to comport with the timing requirements set forth in 37 C.F.R. § 42.107(a): specifically, “a patent owner may include one or more of the following arguments [in its preliminary response] (7) “Reasons why the Director should exercise his or her discretion and deny institution under 35 U.S.C. § 314 and/or § 325(d).” Further, “The Board institutes the trial on behalf of the Director.” 37 C.F.R. § 42.4(a). The Board will also consider whether the same or substantially the same prior art or arguments were previously presented to the Office. *See, e.g.*, 35 U.S.C. § 325(d). The Board’s abuse of discretion deprives ATL of its rights to due process when implicating a private property right and runs afoul of the stated goals of efficiency, consistency, and adherence to the statutory requirements for institution.

II. Procedural History

On March 26, 2025, then Acting Director, Morgan Coke Stewart, entered an

Interim Processes for PTAB Workload Management memorandum (“Interim Workload Memorandum”) which asserts that the Director is tasked with determining whether to deny a petition based on discretionary considerations.

The Petition was filed on March 31, 2025. Paper 2. The Notice of Filing Date Accorded was entered on April 18, 2025, which triggered the 3-month deadline for ATL’s POPR. Paper 3. On July 18, 2025, ATL filed its POPR. Paper 7.

On October 6, 2025, the Board entered a decision instituting trial “[u]pon consideration of the Petition, the Preliminary Response, and the evidence of record”. Paper 8 at 3.

III. Legal Standard for Director Review

“Requests for Director Review of a Board’s decision on institution . . . shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” USPTO, Revised Interim Director Review Process § 2.B (last modified March 18, 2025). “Both discretionary and merits-based issues may be raised”. *Id.* “The Director Review Process provides a mechanism to correct errors at the institution stage, for example, to avoid unnecessary trials for patent owners.” *Id.*

“Decisions of the Board under Director Review are reviewed *de novo*.” *Id.* at 5.A(ii)(c).

IV. Argument

A. The Board’s Institution Decision Is an Abuse of Discretion Based on Erroneous Factual Findings and Conclusions of Law.

The Board erred and abused its discretion when it failed to consider Patent Owner’s factual and legal reasons for discretionary denial of the Petition and by making erroneous findings of fact and conclusions of law. As set forth in ATL’s timely Patent Owner Preliminary Response, the Petition should be denied on discretionary and merits grounds for at least three reasons.

B. The Board Erred by Concluding “throughout the driving period” Is Synonymous with “during the driving period”.

First, the Board erroneously concluded that the “throughout the driving period” limitation was synonymous with Petitioner’s analysis of “during the driving period”. Institution Decision at 9, fn. 8, 33-34, 35. The Board held “the differentiation that Patent Owner attempts to make between “during” and “throughout” is unnecessary due to the synonymous meaning of these terms. Institution Decision at 9 and 35.

The Board’s erroneous conclusion flies in the face of long-standing precedent that “different claim terms are presumed to have different meanings.” *Helmsderfer* 527 F.3d at 1382 (Fed. Cir. 2008); *Applied Med. Res. Corp.*, 448 F.3d at 1333 n.3 (Fed. Cir. 2006).

The Board's finding of synonymy of "throughout" and "during" is an abuse of discretion and an error of law. First, because there is a presumption that different words are presumed to have different meaning. Second, the '728 Patent prosecution history demonstrates that the purposeful amendment from "during a driving period" to "throughout a driving period" was to traverse the Collopy reference and would support the presumption. USAA-1002 ('728 Patent file history) at 201-224; Paper 7 at 6-7 and 9-10.

Neither, Petitioner, nor the Board, rebutted this presumption and the Board's conclusory ruling that "throughout the driving period" and "during the driving period", when both terms appear in the independent claims, are synonymous is error warranting vacating the Institution Decision.

C. The Board Erred by Failing to Consider Discretionary Issues of Duplicative References Already Considered by The Office.

1. Callopy was considered by the Office by virtue of its consideration of Collopy.

Second, the Board erred by failing to consider whether Petitioner's main obviousness reference, WO 2010/062,899, PCT/US2009/065730, ("Callopy") (USAA-1004) was a substantively different reference than U.S. Pub. No. 2010/0131304, U.S. Pat. App. 12/547,800, ("Collopy") (USAA-1002) *e.g.*

[T]he grounds based on Callopy do not involve the same or substantially same art or arguments previously

presented during original prosecution. Collopy and Callopy do not have the same disclosures, and this Petition applies references that were not applied by the examiner in any rejections of the claims.

Pet. at 5, fn. 4. ATL demonstrated in its POPR that the disclosure of Collopy *is wholly contained within the relied upon reference Callopy*¹. POPR at 10-20. The Board did not mention the original reference Collopy at all. As set forth in its Preliminary Response, ATL asserted and demonstrated that Petitioner did not substantively rely on any material found exclusively in Callopy, alone, and instead relied on passages that are identically disclosed in *both* Callopy and Collopy. *Id.* at 12. Collopy was **disclosed, considered, and used** by the Examiner in a rejection during prosecution, which ATL overcame through amendment and argument. POPR at 6-7 and 9-10; USAA-1002 at 201-224. The USPTO issued the '728 Patent over the full disclosure of Collopy. The Board, accepted without question, the Callopy reference, even though the entire substantive disclosure of Collopy is found and additionally incorporated by reference within Callopy. The Board erred by not exercising its discretion to deny the Petition as duplicative of prior considerations of

¹ “[0001] This application claims the benefit of U.S. Provisional Application Serial No. 61/118,400 ... U.S. Patent Application Serial No. 12/547,800 entitled “REAL TIME INSURANCE GENERATION” and filed on August 26, 2009 [“Collopy”] ... The entireties of above-captioned applications are incorporated herein by reference.” Callopy at [0001].

the Office.

2. Warren was considered by the Office.

Further to this point, the Board erred and abused its discretion by failing to consider ATL’s argument concerning Petitioner’s assertion that U.S. Pat. Publication No. 2006/0053038 (USAA-1008) (“Warren”) “was never before the Office, and thus, not considered by the Examiner.” Paper 7 at 20-21 (quoting Paper 2 at 77 (IV.A)). The evidence of record directly and explicitly rebuts Petitioner’s assertion—the information disclosure statement filed on May 28, 2024, explicitly recites the same Warren reference (line 21) which was considered by the Examiner on July 23, 2024. USAA-1002 at 277.

It is unclear why or how Petitioner made such an assertion that “Warren was never before the Office”, or why the Board ignored it, when Warren is clearly identified in the file history numerous times as being presented by ATL and considered by the Examiner. *See* Petition at 77; USAA-1002 at 267, 269, 277, 279, 313, 315, 386, and 388; and POPR at 20-21. It was error for the Board to not consider this fact.

3. The Board erred by not considering Patent Owner’s reasons for discretionary denial in the Preliminary Response.

The Board wholly failed to consider ATL’s reasons for discretionary denial and the continually shifting rationales for discretionary, merits, or non-discretionary

considerations for denial of institution leads to inconsistency and inefficiencies at the Office and deprives Patent Owners of due process concerning their intellectual property rights. Further, then Acting Director's Interim Workload Memorandum of March 26, 2025, fails to comport with the timing requirements set forth in 37 C.F.R. § 42.107(a): specifically, "a patent owner may include one or more of the following arguments [in its preliminary response] (7) "Reasons why the Director should exercise his or her discretion and deny institution under 35 U.S.C. § 314 and/or § 325(d)." Further, "The Board institutes the trial on behalf of the Director." 37 C.F.R. § 42.4(a). The Board will also consider whether the same or substantially the same prior art or arguments were previously presented to the Office. *See, e.g.*, 35 U.S.C. § 325(d).

The Board erred by not considering ATL's discretionary considerations for denial of institution that were submitted with its timely filed Preliminary Response, *i.e.*, within 37 C.F.R. § 42.107(b)'s 3-month time window. *Id.* ("The preliminary response must be filed no later than three months after [the date of a notice of filing date accorded].").

The Board's abuse of discretion deprives ATL of its rights to due process when implicating a private property right. *See Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 584 U.S. 325, 337 (2018) ("The grant of a patent is a

matter between the public . . . and the patentee.”). Under *Mathews v. Eldridge*, the balancing test weighs (1) private interest (patent validity here), (2) error risk (opaque criteria, pro-institution tilt), and (3) government burden (minimal for hearings). See *Mathews v. Eldridge*, 424 U.S. 319, 335 (1976).

To further streamline the *inter partes* review process, the most recent memorandum of October 17, 2025, the Office, through the new Director, entered a Director Institution of AIA Trial Proceedings memorandum (“Director Institution Memorandum”) proclaiming that the “Director will determine whether to institute trial for *inter partes* review. . . proceedings.” *Id.* at 1. Upon review of discretionary considerations, the merits, **and** non-discretionary considerations, . . ., the Director will issue a summary notice to the parties. *Id.* at 2 (emphasis added).

To further the goal stated within the Director Institution Memorandum of “improv[ing] efficiency, consistency, and adherence to the statutory requirements for institution”, the Director should grant this request for director review and correct the errors made by the Board in the Institution Decision, Paper 8.

V. Conclusion

For the foregoing reasons and to correct errors at the institution stage, Patent Owner ATL requests Director Review of the Board’s Institution Decision, Paper 8, vacatur of the same, and denial of the Petition.

Date: October 20, 2025

Respectfully Submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this Request for Director Review complies with the type-volume limits of 37 C.F.R. § 42.24(a)(v) because it contains **1,949** words, excluding the parts of this Patent Owner's Request for Director Review that are exempted by 37 C.F.R. § 42.24(a)(1), according to the word processing system used to prepare this Patent Owner's Request for Director Review.

/Matthew C. Juren/
Matthew C. Juren

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 20th day of October, 2025, I electronically filed the foregoing document and served a copy of the same on counsel for Petitioner at the following e-mail addresses, as authorized in the Petition:

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