

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

REGIONS BANK,

Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,

Patent Owner.

Case No. IPR2025-001326

U.S. Patent No. 12,159,310

PATENT OWNER REPLY TO PETITIONER'S OPPOSITION TO
REQUEST FOR DISCRETIONARY DENIAL

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I. INTRODUCTION

Petitioner's strategy for this IPR is to argue for institution based on prior IPRs instead of the prior art references identified in its grounds. 35 U.S.C. § 311(b); 37 C.F.R. § 42.104(b)(4). Petitioner focuses on five cherry-picked prior IPRs and ignores dozens of other IPRs/CBMs where Patent Owner prevailed.

Additionally, Petitioner asserts that prior IPRs involving different patents canceled "claims reciting the same subject matter" as the '310 Patent. Opp., Paper 12, 2. This statement is incorrect on its face.

Petitioner's assertion that its standard, unmodified *Sotera* stipulation will remove any overlap with the parallel district court action is incorrect.

Finally, Petitioner's bare assertion that the examiner was "wrong" does not establish material error.

II. THE ASSERTION THAT PRIOR IPRs INVOLVING DIFFERENT PATENTS CANCELED "CLAIMS RECITING THE SAME SUBJECT MATTER" AS CLAIMS IN THE '310 PATENT IS FALSE

Petitioner's strategy is to argue that prior IPRs—not the references of its grounds—are "evidence" that the claims of the '310 Patent are unpatentable. Petitioner then states that the claims of the '310 Patent "recite the same subject matter" as claims from prior IPRs. See Opp., Paper 12, 1-2. That assertion is false.

Petitioner does not identify a claim from the '310 Patent that defines the same invention as a claim from a prior IPR. Instead, Petitioner presents an

unorthodox claim chart comparing limitations plucked from **five different claims** across **four different patents** to selected limitations of Claim 1 of the '310 Patent, as though prior IPR decisions were references to be used in an obviousness combination. Opp, 3-5. Plainly, this patchwork chart does not establish that Claim 1 of the '310 Patent “recite[s] the same subject matter” as a claim from a prior IPR.

Petitioner’s claim chart also fails to acknowledge multiple patentably significant limitations of the '310 Patent not found in the other patents, including (1) “*monitoring the live video*” of a check, (2) “*capturing [a] video frame*” of the “*live video*” when monitoring criteria is met, (3) “*controlling the camera through the software abstraction layer*” stored in memory, among others. See Opp., 3-5.

Petitioner presents another chart with a list of prior IPRs. Opp., 3 (IPR chart). Here, Petitioner cherry-picks five IPRs, ignoring **thirty-nine** other IPRs/CBMs where the Patent Owner prevailed by decision or termination.

Furthermore, all but one of these five IPRs involved serial petitions where the patent had survived earlier petitions. For example, the '571 Patent and the '779 Patent listed in Petitioner’s IPR chart were targeted with serial petitions after each had prevailed against **three earlier petitions**, including Final Written Decisions finding all challenged claims patentable. See Opp., 3; IPR2019-01082 (Paper 41, FWD, Nov. 24, 2020); IPR2019-01083 (Paper 39, FWD, Nov. 24, 2021). There,

serial petitioners received extra bites at the apple presenting similar or identical art to new panels at the Board and ultimately prevailed in convincing the new panels and Federal Circuit that those patent claims were unpatentable. Yet here, challenging later-issued USAA patents with new claims based on new grounds, Petitioner asserts that the Director should prejudge invalidity based on prior determinations, rather than the technical merits of its own challenges.

III. PETITIONER’S STANDARD *SOTERA* STIPLUATION DOES NOT ELIMINATE OVERLAP AND RISKS CONFLICTING RESULTS

Petitioner asserts there will be “no inefficiency” and “there will not be any overlap” between the IPR and the district court action. Opp., 1, 12. If so, Petitioner would have submitted a modified *Sotera* stipulation—but it chose not to.

Petitioner’s invalidity contentions in district court reserve the right to use overlapping system art despite its weak *Sotera* stipulation. Request, Paper 9, 6. Notably, Petitioner does not address the *Motorola Solutions* decision finding that standard *Sotera* stipulations allowing litigation of overlapping grounds with system art are given little weight. See Request, 7; Opp., 12-14. To give a specific example, every one of Petitioner’s asserted references—Garcia, Luo, Meier, Cohen, Yoon, and Goyal—is asserted in its district court invalidity contentions. Ex. 2004, 10-12. Petitioner also asserted six “system” references (*id.* at 15-18), and asserts that the

claims are obvious over these references “alone or in combination with other references” charted (*id.* at 20). In other words, Petitioner purports to preserve the right to present substantially identical grounds in both forums by tacking on a “system” reference to its printed publication combinations.

IV. THERE WAS NO MATERIAL ERROR BY THE EXAMINER

Petitioner argues that the examiner committed material error by failing to apply the art from prior IPR decisions. Opp., 2 (“failing to engage with that art”).

First, Petitioner fails to appreciate that the application leading to the ’310 Patent was filed well after the IPR decisions cited by Petitioner, and it included markedly different claims. Thus, it should come as no surprise that the examiner correctly decided to consider, but not apply, the prior art from the old decisions.

Second, Petitioner’s assertion that the art from prior IPRs “received no attention” is incorrect. Opp., 6. Each of the references applied against the independent claims for the patents listed in Petitioner’s IPR chart (Opp., 3) was considered by the examiner during prosecution of the ’310 Patent. ’310 Patent, (References Cited: 4-17).

The PTAB decisions cited by Petitioner (Opp., 8) are inapposite because the claims of the ’310 Patent have multiple, patentably distinguishable limitations not found in the other patents. See Section II, *supra*.

Petitioner’s argument boils down to its unsupported assertion of a “conflict between the Board’s prior IPR decisions and the examiner’s allowance of the challenged claims.” Opp., 8. This kind of bare argument that the examiner was “wrong” does not establish material error. Petitioner makes no showing that any art combination from a prior IPR renders the ’310 Patent claims unpatentable or that the examiner “misapprehended or overlooked” a material teaching. *See, e.g., Fitesa Simpsonville, Inc. v. Procter & Gamble Co.*, IPR2023-01451, Paper 11 (PTAB Mar. 20, 2024), at *20-21 (“Petitioner did not identify any specific error”); *Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01197, Paper 18 (PTAB June 13, 2023), at *20 (“Petitioner voiced no more than a disagreement”).

A party can petition for IPR “only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b); *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1374 (Fed. Cir. 2022). In this IPR, Petitioner is arguing for institution based on decisions in prior IPRs, instead of prior art patents or printed publications. Patent Owner respectfully submits that the Petition should be denied.

V. CONCLUSION

For the foregoing reasons, the Director should deny institution.

Dated: November 20, 2025

Respectfully submitted,

/ Stephen T. Schreiner /

Stephen T. Schreiner

Reg. No. 43,097

CARMICHAEL IP, PLLC

8607 Westwood Center Drive

Suite 270

Tysons, VA 22182

Tel: (703) 646-9248

schreiner@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on November 20, 2025, I caused a true and correct copy of the foregoing **PATENT OWNER REPLY TO PETITIONER'S OPPOSITION TO REQUEST FOR DISCRETIONARY DENIAL** to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

Regions Bank counsel:

David Cavanaugh
Gregory Lantier (notice of intent to designate as a
provisionally recognized PTAB attorney to be filed)
Andrew Danford (notice of intent to designate as a
provisionally recognized PTAB attorney to be filed)
Alexander J. Nemtzow, Amy L. Mahan, Chisom I. Nwakama
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109
David.Cavanaugh@wilmerhale.com
Alex.Nemtsov@wilmerhale.com
Gregory.Lantier@wilmerhale.com
Andrew.Danford@wilmerhale.com
Amy.Mahan@wilmerhale.com
Chisom.Nwakama@wilmerhale.com

By: /Stephen T. Schreiner/
Stephen T. Schreiner (Reg. No. 43,097)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive, Suite 270
Tysons, VA 22182
Tel: (703) 646-9254
schreiner@carmichaelip.com
Counsel for Patent Owner