No. 25-149

IN THE

Supreme Court of the United States

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner,

v.

PNC BANK, N.A.,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether the Federal Circuit's unpublished decision correctly affirmed the Patent Trial and Appeal Board's reasoned determination that an *inter partes* review proceeding involving different prior art, different arguments, and different evidence warranted a different outcome from an earlier proceeding brought by a different petitioner.

CORPORATE DISCLOSURE STATEMENT

PNC Bank, N.A. is a wholly owned, indirect subsidiary of The PNC Financial Services Group, Inc., which is a publicly traded company and does not have a parent corporation.

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INTRODUCTION

Petitioner United Services Automobile Association ("USAA") seeks nothing more than factbound review of a nonprecedential decision affirming a thoroughly supported agency ruling firmly grounded in the record. No circuit split exists, and the Federal Circuit most certainly did not hold as a matter of principle that like cases may be treated in an unlike manner. Rather, both the agency and the Federal Circuit correctly concluded that this case was unlike the previous case, and that the different evidence and arguments made warranted a different result. USAA may disagree with that result, but whether the successful challenge PNC presented is sufficiently like or unlike the unsuccessful challenge that another party (Wells Fargo) presented is not an important question of law warranting this Court's attention.

In an unpublished decision, the Federal Circuit affirmed the Patent Trial and Appeal Board's ruling in *inter partes* review ("IPR") proceedings that PNC met its burden to prove that certain claims in patents held by USAA were obvious in light of information already known in the field (referred to as "prior art"). USAA's petition tellingly does not suggest that the Board or the Federal Circuit erred in their obviousness analysis. Instead, USAA contends that the Board and the Federal Circuit were somehow bound by the Board's earlier finding that another party (Wells Fargo) failed to carry *its* burden to prove USAA's patent claims invalid in separate IPRs that Wells Fargo initiated based on different prior art and a different theory of invalidity.

The premise underlying USAA's petition—that PNC's and Wells Fargo's IPRs involved "the same facts" and "the exact same arguments," Pet.9, 22—is contrary to the express and thoroughly supported findings of the Board and the Federal Circuit. The petition does not acknowledge the Board's reasoned explanation of the numerous differences in the arguments and factual record between the two proceedings, which drove the difference in outcomes. To even reach the purported question presented, USAA would require this Court to reassess those factual findings, which is precisely the type of factbound error correction that this Court's rules deem unworthy of certiorari.

In any event, the record plainly shows that the Board and the Federal Circuit were correct: PNC and Wells Fargo invoked substantively different prior art, offered different expert testimony, and raised different arguments. Critically, Wells Fargo made binding concessions that PNC did not make. Not only does the Administrative Procedure Act ("APA") not *require* treating such cases identically; doing so would *violate* the APA, and also the IPR statute, which this Court has explained requires a "party-directed, adversarial process" in which "the petitioner's contentions … define the scope of the litigation all the way from institution through to conclusion," *SAS Institute, Inc.* v. *Iancu*, 138 S. Ct. 1348, 1355, 1357 (2018).

Simply put, USAA's stated question—"[w]hether an agency decision is arbitrary and capricious when it fails to justify" reaching a different result from a prior case that was "substantively the same," Pet.i—is not in fact presented. The PNC and Wells Fargo IPRs were not substantively the same, and the Board thoroughly justified its distinction between them. Whether the agency and lower court were right in reaching that conclusion is a case-specific question that has no significance for any other case and does not warrant this Court's review.

USAA grasps for a circuit split, but none exists. As USAA's own cases make perfectly clear, the Federal Circuit and the D.C. Circuit agree that agencies must treat like cases alike and explain any inconsistent findings. In fact, the Federal Circuit cases that USAA now argues are on the wrong side of a split are the very same cases it cited in its Federal Circuit rehearing petition as stating the correct rule of law. USAA was right the first time and is wrong now: The Federal Circuit applies the same correct rule of law as the D.C. Circuit.

The decision below correctly applied that rule. In any event, an assertedly erroneous application of a correct rule of law is not certworthy—particularly when done in an unpublished decision that does not create circuit precedent.

For all these reasons, the petition should be denied.

STATEMENT

A. USAA's Patents

USAA holds numerous patents purporting to cover aspects of remote check deposit, i.e., the process of depositing checks using a computer or mobile device such as a smartphone. Several claims of these patents have been invalidated as obvious in light of prior art, *see* 35 U.S.C. § 103, while others were recently invalidated as directed to abstract ideas and thus not patent-eligible under this Court's decision in *Alice Corp. Pty.* v. *CLS Bank International*, 573 U.S. 208 (2014). *See United Services Automobile Ass'n* v. *PNC Bank N.A.*, 139 F.4th 1332, 1334 (Fed. Cir. 2025); *United Services Automobile Ass'n* v. *PNC Bank, N.A.*, 2025 WL 1662737, at *1 (Fed.

Cir. June 12, 2025). This case concerns two USAA patents of which certain claims have been invalidated as obvious: U.S. Patent Nos. 8,977,571 ("the '571 patent") and 8,699,779 ("the '779 patent").

The '571 and '779 patents claim generic steps for automatically capturing a check image with a mobile device once the previewed image satisfies certain "monitoring criteria," such as alignment with an alignment guide. C.A.App.200. Specifically, the '571 patent describes (1) "monitoring" "[a]n image of a check that is in the field of view of a camera" of a mobile device; (2) providing "feedback" to the "user of the camera regarding the image of the check"; and (3) "[w]hen the image of the check in the field of view passes monitoring criteria, [taking] an image … by the camera and provid[ing] [that image] to a financial institution." C.A.App.200-202. The '779 patent is similar to the '571 patent, but recites claims that specify an "alignment guide" as the criterion used to trigger the automatic capture of the check image. C.A.App.230.

B. Wells Fargo's IPRs

USAA has sued or threatened to sue several banks for asserted infringement of its patents. One bank, Wells Fargo, sought to challenge the validity of the '571 and '779 patents through IPR, a congressionally-created agency procedure under which the Patent Trial and Appeal Board may "reexamine the claims in an already-issued patent and … cancel any claim that the agency finds to be unpatentable in light of prior art." *Cuozzo Speed Techs., LLC* v. *Lee*, 579 U.S. 261, 265 (2016). However, Wells Fargo failed to persuade the Board that the challenged patent claims were invalid under the particular theory of obviousness Wells Fargo asserted, which turned on the combination of two specific prior art references.

Wells Fargo argued that USAA's '571 and '779 patent claims were obvious in light of two prior art references that, according to Wells Fargo, a skilled artisan would have been motivated to combine: a patent called Nepomniachtchi, which disclosed the use of an image-correction algorithm in connection with a mobile device, and a patent called Yoon, which disclosed techniques for monitoring and automatically capturing images. *See Wells Fargo Bank, N.A.* v. *United Services Automobile Ass'n*, 2020 WL 6937381, at *10 (P.T.A.B. Nov. 24, 2020) ('571 patent); *Wells Fargo Bank, N.A.* v. *United Services Automobile Ass'n*, 2020 WL 6938004, at *10 (P.T.A.B. Nov. 24, 2020) ('779 patent). Recognizing that "[t]he burden of proof [was] on [Wells Fargo]," the Board rejected Wells Fargo's challenges on the record-specific grounds that Wells Fargo "fail[ed] to prove the facts that it allege[d] and the premise it offer[ed] for combining Nepomniachtchi and Yoon." 2020 WL 6937381, at *11, *26; 2020 WL 6938004, at *12, *27.

Computational burden. Wells Fargo's primary argument was that a skilled artisan would have been motivated to combine Nepomniachtchi and Yoon because "implementing Yoon's monitoring and capturing features on the mobile device in Nepomniachtchi would reduce the computation burden on the mobile device." 2020 WL 6937381, at *10; 2020 WL 6938004, at *11. The Board rejected this argument based on expert testimony that Yoon would actually "*increase* computational burden on [Nepomniachtchi's] mobile device." 2020 WL 6937381, at *14 (emphasis added); 2020 WL 6938004, at *15 (emphasis added). The Board also relied on Wells Fargo's "admi[ssion] that" a skilled artisan "would have been concerned with adding computational burden on [Nepomniachtchi's] mobile device," and found that Yoon's increase of computational burden would have *dissuaded*, not motivated, the combination Wells Fargo posited. 2020 WL 6937381, at *13; 2020 WL 6938004, at *14.

Image distortion. Wells Fargo next asserted that Nepomniachtchi's solution to image distortion—namely, post-capture correction of the image—"was inadequate" and could be improved by Yoon's technique for ensuring proper alignment of a check before an image is captured. 2020 WL 6937381, at *20; 2020 WL 6938004, at *21. But Wells Fargo's only evidence that Yoon would improve Nepomniachtchi's solution to image distortion was a "generic assertion" that "using an alignment guide" would "ensure that the check was properly aligned." 2020 WL 6937381, at *18; 2020 WL 6938004, at *19. Applying the "well established" maxim "that the reason for combining references in an obviousness analysis cannot focus on generic statements," the Board found that Wells Fargo's generic assertion, "without more," was "insufficient" to establish motivation for combining Nepomniachtchi and Yoon. 2020 WL 6937381, at *17-18; 2020 WL 6938004, at *18-19.

Need for retakes. Finally, Wells Fargo argued that combining Nepomniachtchi and Yoon would "minimize the need to ask the user to retake the photo." 2020 WL 6937381, at *10; 2020 WL 6938004, at *10. The Board rejected this argument based on Wells Fargo's "admi[ssion] that … 'combining Nepomniachtchi and Yoon would replace the user's judgment about whether the image was aligned.'" 2020 WL 6937381, at *22; 2020 WL 6938004, at *23. Wells Fargo's concession was fatal, the Board explained, because "replacing the user's judgment that is based on numerous factors, with an auto-capture system based solely on alignment, would not minimize the need for retaking the images." 2020 WL 6937381, at *23; 2020 WL 6938004, at *24.

In sum, the Board held Wells Fargo to its "burden of proof" and determined that what Wells Fargo "chose to argue" was, "without more, … insufficient" to invalidate the '571 and '779 patent claims. 2020 WL 6937381, at *11, *18, *26; 2020 WL 6938004, at *12, *19, *27.[1]

C. PNC's IPRs

Over seven months after the Board decided the Wells Fargo IPRs,[2] PNC brought separate IPRs challenging claims of the '571 and '779 patents as obvious in light of two different prior art references: a U.S. patent called Acharya and a Chinese patent application called Luo. Acharya described a method for depositing "a financial instrument, such as a paper check," by capturing a digital image of the check with a "cell phone" or other "wireless handheld device" that includes "a digital camera." C.A.App.1738, 1747. Luo disclosed techniques for

[1] The petition incorrectly states (at 10) that "Wells Fargo did not appeal." Wells Fargo did appeal. *See Wells Fargo Bank, N.A.* v. *United Services Automobile Ass'n*, No. 21-1593, Dkt. 1 (Fed. Cir. Jan. 28, 2021); *Wells Fargo Bank, N.A.* v. *United Services Automobile Ass'n*, No. 21-1594, Dkt. 1 (Fed. Cir. Jan. 28, 2021). Rather than await review by the Federal Circuit, USAA settled.

[2] The petition's assertion (at 11) that PNC filed its IPRs "[w]hile the *Wells Fargo* inter partes review was underway" is incorrect. PNC filed its petitions in July 2021, several months *after* the Board decided the Wells Fargo IPRs in November 2020. *See Wells Fargo*, 2020 WL 6937381 (P.T.A.B. Nov. 24, 2020) (judgment in Wells Fargo's '571 patent IPR); *Wells Fargo*, 2020 WL 6938004 (P.T.A.B. Nov. 24, 2020) (judgment in Wells Fargo's '779 patent IPR); C.A.App.528, 6203 (PNC IPR petitions filed July 7, 2021). The premise of USAA's petition—that PNC filed IPRs "substantively identical" to Wells Fargo's (Pet.9, 21, 23-25)—cannot be reconciled with that timeline. It would have made no sense for PNC to file IPRs re-raising the same arguments and prior art that the Board had already rejected. As the Board and Federal Circuit confirmed, PNC raised different arguments.

capturing "well-focused and clear document images" using "digital cameras in a variety of handheld electronic devices" such as "mobile phones," including by displaying "reference lines" in a "preview window" on the mobile device and autocapturing an image when the document is aligned with the reference lines. C.A.App.1754, 1756, 1759, 1762.

PNC articulated a motivation to combine Acharya and Luo that differed from Wells Fargo's asserted motivation to combine Nepomniachtchi and Yoon. PNC explained—and the Board agreed—that "Luo itself explains that the software that would implement [its] invention would be easy to produce for a generic processor, which Acharya also employs." Pet.App.47a, 143a. And, unlike Wells Fargo's prior art references—only one of which (Nepomniachtchi) was "directed to a mobile device or wireless handheld device," C.A.App.6382—"both Acharya and Luo describe their respective inventions as implemented on the same types of handheld devices," Pet.App.47a, 144a. As the Board noted, PNC "use[d] the presence of a wireless handheld device with a camera in both Acharya and Luo as part of its reasons to combine the references' teachings." C.A.App.6381. The Board found this overlap between Acharya and Luo persuasive, concluding that combining the two references was "a textbook example of using a technique that improved one device to improve a similar device in the same way." Pet.App.47a, 143a; *see also* C.A.App.6405 (recognizing that "adding monitoring and auto capture, per Luo's teaching, to Acharya would have been the predictable use of a known feature to improve a similar device"); C.A.App.732 (recognizing that Acharya and Luo "involve[] a similar use of the same technology").

The Board accordingly concluded that the "evidence of obviousness" based on the combination of Acharya and Luo was "particularly strong and straightforward." Pet.App.48a, 144a. And as detailed immediately below, the Board explained why each of its findings in the Wells Fargo IPRs was "of marginal relevance" to, and did not undermine, the Board's assessment of PNC's articulation of the motivation to combine Acharya and Luo. Pet.App.6a, 65a, 70a, 154a, 161a.[3]

Computational burden. The Board explained that, unlike Wells Fargo, PNC had "not made" an argument for combining its prior art references in order to "reduce the computation burden at the mobile device." Pet.App.64a, 160a. The Board's rejection of Wells Fargo's argument therefore had no "relevance to [PNC's] proceeding." Pet.App.63a, 159a. And in any event, whereas USAA's expert in the Wells Fargo IPRs had offered detailed evidence showing that Yoon would actually "*increase* computational burden on [Nepomniachtchi's] mobile device," 2020 WL 6937381, at *14 (emphasis added); 2020 WL 6938004, at *15 (emphasis added), here USAA provided no evidence to support a similar assertion about Luo's impact on Acharya other than expert testimony that "does not identify the basis for the testimony" and thus was "entitled to little weight," Pet.App.62a, 158a. Moreover, whereas the Board in the Wells Fargo IPRs determined that a skilled artisan would have worried about Yoon adding to

[3] USAA does not seek this Court's review of the Board's affirmative reasoning (affirmed by the Federal Circuit, *see* Pet.App.7a-9a) for finding that a skilled artisan would have been motivated to combine Acharya and Luo, and thus that the challenged claims of the '571 and '779 patents were obvious. The petition takes issue only with the fact that different results were reached in the Wells Fargo and PNC IPRs. *See, e.g.*, Pet.13 ("As relevant to this petition, the Federal Circuit affirmed the Board's turnabout.").

Nepomniachtchi's computational burden "because [Wells Fargo's] expert admitted as much," PNC's expert made no such admission about the combination of Acharya and Luo. Pet.App.64a, 161a.

Image distortion. In the Wells Fargo IPRs, the Board deemed Wells Fargo's "generic assertion" that Yoon would improve Nepomniachtchi's solution to image distortion to be, "without more, … insufficient" to establish motivation to combine Nepomniachtchi and Yoon. 2020 WL 6937381, at *18; 2020 WL 6938004, at *19. The Board found that PNC, in contrast to Wells Fargo, offered specific expert testimony, "consistent with the teachings of [PNC's] prior art," that Luo would improve Acharya's solution to image distortion. Pet.App.52a, 149a. Specifically, the Board found that "Luo expressly states that its technique reduces projective distortion and improves optical character recognition," and that PNC's expert credibly testified "that a skilled artisan would have recognized that Luo's solution could be used to improve check processing, as in Acharya's system, in the same manner." Pet.App.52a, 148a.[4]

Need for retakes. Finally, the Board explained why its rejection of Wells Fargo's argument concerning the need for retakes was irrelevant to the PNC IPRs. Specifically, the Board explained that its rejection of that argument in the Wells Fargo IPRs was "based … on admissions by [Wells Fargo] in that case that combining Nepomniachtchi and Yoon would replace the user's judgment about whether the image was aligned." Pet.App.69a, 166a. In contrast, the Board noted, PNC

[4] This belies USAA's false assertion that "neither PNC nor its expert could offer anything in its references that was not presented in the Wells Fargo proceeding." Pet.12; *see also* Pet.23, 26.

made no such admissions, and in fact affirmatively "argue[d] that" users of *its* prior art combination "would still apply judgement," "general logic[,] and common sense" to "adjust the position of [the] digital camera." Pet.App.68a, 164a.

In sum, the Board explained—in a passage conspicuously left out of USAA's petition—that "[t]he findings of the Wells Fargo IPR panel relating to the features of Nepomniachtchi and Yoon" were "based on the particular facts of that proceeding, including the express teachings of those references, not present in the references advanced by [PNC], and the particular arguments made by the petitioner in that proceeding." Pet.App.60a, 157a. The Board accordingly concluded that "the Wells Fargo IPR panel" had not "made general findings of teachings away that would be applicable to [PNC's] prior art references." Pet.App.65a, 161a.[5]

Given PNC's affirmative case for combining Acharya and Luo, and given that the Board's findings in the Wells Fargo IPRs were of marginal relevance to that affirmative case, the Board concluded that PNC "met its burden in this proceeding" to "demonstrate[] by a preponderance of the evidence" that the challenged claims of the '571 and '779 patents were obvious and therefore invalid. Pet.App.104a-106a.

[5] USAA incorrectly states that because it "submitted the prior-art references from Wells Fargo into evidence" in the PNC IPRs, the Wells Fargo and PNC IPRs had "identical record[s]." Pet.12. In fact, only the PNC IPRs included the additional prior art references—Acharya and Luo—that the Board found a skilled artisan would have been motivated to combine, as well as the specific evidence and arguments that the Board credited in making that finding (while distinguishing Wells Fargo's evidence and arguments).

In denying USAA's petition for rehearing, the Board confirmed that it had "fully considered … and disagreed with" USAA's arguments based on the Wells Fargo IPRs. C.A.App.161, 178. The Board reiterated that "the Wells Fargo panel's findings were based on the particular technical features of prior art references not asserted in this proceeding," and that "arguments and evidence particular to the Wells Fargo IPR and the findings based on those arguments and evidence are not general findings of teachings away that would be applicable to other prior art references, such as Acharya and Luo." C.A.App.161-162, 178. In short, the Board explained, whereas Wells Fargo "did not meet its burden," PNC did. C.A.App.161, 178.

D. Federal Circuit Proceedings

In an unpublished and thus "nonprecedential" decision, Pet.App.1a, the Federal Circuit affirmed. Recounting the ways in which "the Board distinguished the Wells Fargo IPR panel's findings from its findings in" the PNC IPRs, the Federal Circuit "agree[d] with the Board and thus reject[ed] USAA's argument that the Board erred in issuing inconsistent IPR decisions without rational explanation." Pet.App.6a-7a.

In a portion of the decision that USAA deems not "relevant to this petition," Pet.13, the court also found that "substantial evidence supports the Board's findings that a skilled artisan would have been motivated to combine Acharya and Luo," Pet.App.9a.

The Federal Circuit denied USAA's petition for rehearing. Pet.App.180a.

REASONS FOR DENYING THE PETITION

I. THIS CASE DOES NOT IMPLICATE USAA'S "QUESTION PRESENTED"

As explained at length above, the Board found, and the Federal Circuit agreed, that Wells Fargo's and PNC's IPRs featured materially different facts and arguments. By adopting the opposite premise—i.e., that the different challenges involved "the same facts" and "the exact same arguments," Pet.9, 22—USAA's petition disregards the Board's express factual findings concerning the numerous differences in the arguments and record between the Wells Fargo and PNC proceedings. This Court would have to reject the Board's numerous contrary factual findings to even reach the issue raised in the petition, which is exactly the type of factbound error correction that does not warrant certiorari.[6]

In any event, the record shows that the Board and the Federal Circuit were plainly correct: The different parties' challenges were based on different arguments and different expert testimony regarding different prior art references. Treating such challenges identically would violate the APA, the IPR statute, and the principle of party presentation that underlies not only those statutes but also this country's system of adjudication. The question purportedly presented—regarding the treatment of cases that are "substantively the same," Pet.i—thus is not implicated here.

1. The premise of USAA's question presented—that Wells Fargo and PNC brought "substantively the

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[6] Because this Court would have to wade into the facts and arguments presented to the Board in each IPR, USAA is wrong that "[t]his case turns" purely "on administrative-law principles, not patent law," Pet.6.

same" challenge based on "saliently similar facts," Pet.i—is contrary to the findings of both the Board and the Federal Circuit. Far from adopting USAA's premise, the Board "fully considered … and disagreed with" it. C.A.App.161, 178; *see supra* pp.7-12. As the Board expressly determined, its "findings [in] the Wells Fargo IPR[s]" were "based on … the express teachings of [Wells Fargo's prior art] references, not present in the references advanced by [PNC], and the particular arguments made by [Wells Fargo]." Pet.App.60a, 157a. The Federal Circuit agreed: Contrary to USAA's assertion that the court "made no mention of" the Board's treatment of "its past decisions in [the Wells Fargo IPRs]," Pet.26, the court in fact devoted Section I of its opinion to that topic, Pet.App.4a-7a, and found that the Board appropriately "distinguished the Wells Fargo IPR panel's findings from its findings in" the PNC IPRs, Pet.App.7a.

The petition thus effectively asks this Court to reexamine the Board's and the Federal Circuit's determination that the Wells Fargo and PNC cases did not in fact feature "the same facts" and "the exact same arguments," Pet.9, 22. Such factbound "error-correction" does not warrant "certiorari review in this Court." *Halbert* v. *Michigan*, 545 U.S. 605, 611 (2005). Indeed, this Court's rules specify that "[a] petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings." S. Ct. R. 10.

2. In addition to being inappropriate for this Court's review, the Board's and the Federal Circuit's factbound determination that the Wells Fargo and PNC cases were materially different is plainly correct. As the record makes abundantly clear, the Wells Fargo and PNC IPRs were based on materially different prior art references, and featured different evidence and

arguments as to why those prior art references rendered USAA's patent claims obvious. *See supra* pp.4-12.

To begin with, USAA acknowledges, as it must, that the Wells Fargo and PNC IPRs involved different prior art. The most USAA can say is that both cases involved "a combination of two *types* of prior-art references." Pet.2 (emphasis added). But the high level of generality at which USAA defines those "types" obscures important differences. Pet.2; *see also* Pet.8. For instance, USAA's assertion that Wells Fargo and PNC relied on "substantively identical art," Pet.9, ignores the key fact that, unlike Wells Fargo's prior art references, "both Acharya and Luo describe their respective inventions as implemented on the same types of handheld devices," Pet.App.47a, 144a. As noted, *see supra* p.8, PNC "use[d] the presence of a wireless handheld device with a camera in both Acharya and Luo as part of its reasons to combine the references' teachings," C.A.App.6381, and the Board expressly relied on that overlap in finding a motivation to combine PNC's references, *see* Pet.App.47a, 143a; *see also* C.A.App.6405; C.A.App.732. Wells Fargo made no such argument and, indeed, could not have, because one of its references (Yoon) did "not appear to be directed to a mobile device or wireless handheld device," C.A.App.6382.

USAA's assertion that PNC and Wells Fargo "rais[ed] the exact same arguments," Pet.9, is likewise wrong. As detailed above, *see supra* pp.7-12, the Board noted that PNC did "not ma[k]e" the same arguments as Wells Fargo, Pet.App.64a, 160a; that PNC's expert did not make the same critical "admissions" as Wells Fargo's expert, Pet.App.69a, 166a; and that PNC offered specific evidence that went above and beyond the "generic statements" that the Board in the Wells Fargo IPRs had deemed to be, "*without more*, … insufficient," 2020 WL

6937381, at *17-18 (emphasis added); 2020 WL 6938004, at *18-19 (emphasis added); *see* Pet.App.52a, 149a.

The Board thoroughly explained why each of these differences mattered. *See supra* pp.7-12. Rather than engage with that reasoning, USAA pretends it was never provided, asserting that the Board "complete[ly] fail[ed] to provide any explanation as to why it reached a different conclusion" in the two sets of IPRs. Pet.26. In fact, the Board enunciated why each of its findings in the Wells Fargo IPRs was "of marginal relevance" to, and did not undermine, its assessment of PNC's case. Pet.App.6a, 65a, 70a, 154a, 161a. And as noted, the Federal Circuit specifically affirmed the Board's analysis "distinguish[ing] the Wells Fargo IPR panel's findings from [the Board's] findings in" the PNC IPRs, Pet.App.7a, contrary to USAA's inexplicable assertion that the Federal Circuit "made no mention of" the Board's treatment of "its past decisions in [the Wells Fargo IPRs]," Pet.26.

Faced with a record that clearly reflects material differences between the Wells Fargo and PNC IPRs, USAA resorts to fabricating "an explicit admission" by PNC's expert "that the two cases have no material difference," Pet.26 (emphasis omitted); *see also* Pet.11-12, 23. Unsurprisingly, no such admission exists. As the Board explained in response to the same false claim, the testimony USAA cites simply states that Nepomniachtchi and Acharya are "directed to the same *problem*"; that "is not an admission that the particular *features* of" the references were the same. Pet.App.61a-62a n.22, 157a n.16 (emphases added).

3. Contrary to USAA's central argument that the APA required identical treatment of the Wells Fargo and PNC cases, *see* Pet.1, 15, 19, 21, 24, 28, the

differences between the proceedings mean that the APA actually *forbids* identical treatment. The APA provisions governing agency adjudications reflect "the principle of party presentation," *Greenlaw* v. *United States*, 554 U.S. 237, 243 (2008), in particular by requiring that agencies "shall give" parties the "opportunity for … the submission and consideration of facts [and] arguments," 5 U.S.C. § 554(c)(1). That requirement would be a dead letter if agencies could not reach different results in separate adjudications brought by different parties raising different arguments supported by different evidence.

Identical treatment of the Wells Fargo and PNC IPRs also would have violated the America Invents Act ("AIA"), which governs IPRs. The AIA requires IPR petitioners to identify, "with particularity," "the grounds on which the[ir] challenge" rests "and the evidence that supports the grounds for the challenge." 35 U.S.C. § 312(a)(3). It further provides that "the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence." *Id.* § 316(e); *see also* Pet.7 (conceding that "[t]he burden is on the [IPR] petitioner"). As this Court has accordingly explained, "Congress chose to structure a process in which it's the [IPR] petitioner … who gets to define the contours of the proceeding." *SAS Institute*, 138 S. Ct. at 1355. In other words, "Congress opted for a party-directed, adversarial process" in which "the petitioner's contentions … define the scope of the litigation all the way from institution through to conclusion." *Id.* at 1355, 1357. Thus, where, as here, different IPR petitioners invoke different prior art, offer different evidence, and make different arguments and concessions, the Board is free to explain why it reaches different results.

Simply put, there was nothing improper about the Board's finding that whereas Wells Fargo "did not meet its burden," PNC did. C.A.App.161, 178. Holding otherwise would "erod[e] the principle of party presentation so basic to our system of adjudication." *Arizona* v. *California*, 530 U.S. 392, 412-413 (2000).

II. THERE IS NO CIRCUIT SPLIT

USAA's attempt to manufacture a circuit split between the Federal Circuit and the D.C. Circuit is entirely unpersuasive. Contrary to USAA's repeated assertion, the Federal Circuit has never held—or even remotely suggested—that agencies "need only decide cases alike when those cases involve the same parties and virtually identical records," such that an "agency has unbridled discretion to reach opposite outcomes" in "materially identical cases" so long as it "can point to a cosmetic difference," Pet.1 (emphases omitted); *see also* Pet.14-15, 19, 20. In reality, the Federal and D.C. Circuits agree that like cases should be treated alike and inconsistent findings must be explained.

USAA's assertion that the decision below "exacerbates an existing circuit split," Pet.14, is reckless and unsupported. Notably, USAA cites three cases in which the Federal Circuit applied the very rule USAA contends for. Pet.20 (citing *Vicor Corp.* v. *SynQor, Inc.*, 869 F.3d 1309 (Fed. Cir. 2017); *BASF Corp.* v. *Enthone, Inc.*, 749 F. App'x 978 (Fed. Cir. 2018); *Emerson Electric Co.* v. *SIPCO, LLC*, 745 F. App'x 369 (Fed. Cir. 2018)). Contrary to USAA's suggestion, none of those cases held (or even implied) that inconsistent agency decisions should be vacated only where they involve the same parties. One of the cases did not even mention that the parties were the same, *see Emerson*, 745 F. App'x at 372 (referring simply to "another inter partes review"), which is why USAA had to supply that information outside of quotation marks, *see* Pet.20. As for the two remaining cases, one summarizes the other without any mention of party overlap. *See BASF*, 749 F. App'x at 986 (summarizing *Vicor* as "vacating and remanding where the PTAB failed to provide any reasoned explanation for reaching directly conflicting obviousness conclusions in two reexaminations involving closely-related subject matter"). USAA thus misrepresents the specific facts of these cases as exhaustive rule statements.

Nor does USAA identify any sign of conflict with the D.C. Circuit. Despite USAA's claim of "entrenched disagreement," Pet.22, no court has ever identified any discord. In its attempt to conjure a conflict, USAA strangely faults the Federal Circuit for using the phrase "'virtually identical,' rather than 'salient[ly] similar[],'" to describe cases that should be decided alike, Pet.19 (alterations in original)—without acknowledging that the previous paragraph of its petition approvingly quotes a D.C. Circuit case that likewise used the phrase "virtually identical," Pet.18 (quoting *Local 777, Democratic Union Organizing Committee* v. *NLRB*, 603 F.2d 862, 869-870 (D.C. Cir. 1978)). USAA likewise fails to acknowledge that the only precedential Federal Circuit decision it cites stated no disagreement with, but rather expressly relied on, one of USAA's cited D.C. Circuit decisions. *See Vicor*, 869 F.3d at 1322 (citing *Local 814, International Brotherhood of Teamsters* v. *NLRB*, 512 F.2d 564, 567 (D.C. Cir. 1975) (cited at Pet.18)).

Notably, the Federal Circuit cases USAA cites as purportedly on the wrong side of a circuit split, *see* Pet.19-20, are the very same cases USAA cited in its Federal Circuit rehearing petition as stating the *correct* rule of law, *see* C.A.Dkt.59 at 11, 13. Notwithstanding that "conflict with another circuit" is "[a]mong the reasons for en banc" rehearing, Fed. Cir. I.O.P. 13, USAA's rehearing petition made no mention of any supposedly "entrenched disagreement" with the D.C. Circuit, Pet.22. Rather, USAA correctly recognized that the Federal Circuit's decisions in *Vicor*, *BASF*, and *Emerson* reflect the "longstanding requirement that [an] agency provide a reasonable explanation for its conflicting holdings," consistent with the "fundamental norm of administrative procedure" that "like cases should be decided alike." C.A.Dkt.59 at 13-14. That is precisely the rule USAA advocates now. In the decision below, the Federal Circuit, applying *Vicor*, found that rule satisfied. *See* Pet.App.4a-7a. Hence, USAA seeks merely to correct what it (wrongly) claims was a "misapplication of a properly stated rule of law," S. Ct. R. 10—precisely what this Court has deemed unworthy of its review.

For the reasons explained in Part I, the Federal Circuit committed no error here; rather, it correctly applied the correct rule of law reflected in *Vicor* and other Federal Circuit cases. In any event, the unpublished decision below is "nonprecedential," Pet.App.1a, and thus does not "signal[]" anything to agencies, Pet.22. Neither does it bind future Federal Circuit panels, as the Federal Circuit "will not give one of its own nonprecedential dispositions the effect of binding precedent," Fed. Cir. R. 32.1(d). Nor does the decision below reflect some larger trend in the Federal Circuit; for all the statistics USAA offers, *see* Pet.27-28, it does not identify a single other case even allegedly featuring the error asserted here, relying instead on cases where the Federal Circuit *did* vacate inconsistent agency holdings, *see* Pet.19-20. Accordingly, even if the decision below were somehow an aberration in tension with D.C. Circuit precedent (though it is not), there is no reason for this Court to review it given that it binds neither the Federal Circuit nor the Board.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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