UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BANK OF AMERICA, N.A., TRUIST BANK, BOKF, N.A., WELLS FARGO BANK, N.A., and PNC BANK, N.A.,

Petitioner,

v.

DYNAPASS IP HOLDINGS, LLC

Patent Owner.

***Inter Partes* Review No. IPR2023-00367**

Patent No. 6,993,658

PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 6,993,658 PURSUANT TO 37 C.F.R. § 42.107

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TABLE OF AUTHORITIES

Cases

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