

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAYPAL HOLDINGS, INC., AND PAYPAL, INC.

Petitioners,

v.

FINTIV, INC.,

Patent Owner.

Case No. IPR2023-00744
U.S. Patent No 8,538,845

PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE '845 PATENT SPECIFICATION	1
A.	Deposit Transaction By Unbanked Subscriber	4
B.	Withdrawal Transaction By Unbanked Subscriber	7
III.	THE '845 PATENT PROSECUTION HISTORY	10
IV.	RECITATION OF UNBANKED SUBSCRIBER IN CLAIMS.....	14
V.	CONSTRUCTION OF “UNBANKED SUBSCRIBER”	14
A.	Construction Advanced In Petition	14
B.	Construction Set Forth In Institution Decision	16
1.	Having Found That The Specification Included An Express Definition, The Board Erred In Relying On Extrinsic Evidence To Alter That Definition.....	19
2.	It Would Be Erroneous To Premise Construction Of “Unbanked Subscriber” On A Requirement That The Challenged Claims Cover Every Embodiment Disclosed in the Specification.....	20
VI.	APPLICATION OF THE BOARD’S FINDINGS TO THE UNDISPUTED FACTS OF TUMMINARO	22
A.	The Petition Fails To Demonstrate That Tumminaro Meets Petitioners’ Construction Of “Unbanked Subscriber” (All Grounds).....	24
B.	The Petition Fails To Explain How Tumminaro’s So-Called “Unbanked Subscribers” Lack Access To A Financial Institution Account.....	25
C.	The Petition Fails To Explain How Tumminaro’s So-Called “Unbanked Subscribers” – Who Have Direct Access To Debit Accounts -- Lack Access To A Financial Institution Account	31
D.	Tumminaro Fails To Meet Petitioners’ Construction Of “Unbanked Subscriber”	33

VII.	TUMMINARO FAILS TO MEET THE EXPLICIT DEFINITION OF “UNBANKED SUBSCRIBER” IDENTIFIED BY THE BOARD (ALL GROUNDS).....	34
VIII.	THE PETITION FAILS TO DEMONSTRATE THAT TUMMINARO TEACHES SELECTING A PAYMENT METHOD AS RECITED IN CLAIM 5 (GROUNDS 1-2).....	39
A.	The Requirement That There Be More Than Payment Method Must Be Read In Conjunction With The Other Claim Limitations Requiring The Subscriber To Be An “Unbanked Subscriber”	42
B.	Tuminaro’s Pooled Accounts And Reloadable Prepaid Debit Accounts Are Bank Accounts, And Are Not Temporary	44
IX.	TUMMINARO FAILS TO TEACH A “LIMIT CHECK” AS RECITED IN CLAIM 1 (GROUND 3)	46
A.	Under The Federal Circuit’s Decision In <i>Superguide</i> , Claim 1 Requires A Limit Check And A Velocity Check	46
B.	Claim 1 Requires Both Performance Of A Limit Check (I) “On The Unbanked Subscriber’s Mobile Wallet Account,” And (Ii) That The Limit Check Determine Whether Sufficient Funds Are Available To Make The Deposit	48
C.	The Intrinsic Evidence Demonstrates That The Claimed Limit Check Is Not Met By An Agent Counting Cash Provided By The Customer	48
D.	The Petition Has Failed To Demonstrate That The References Teach Or Suggest The Limit Check Recited In Claim 1	53
X.	CONCLUSION.....	57

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>3M Innovative Props. Co. v. Avery Dennison Corp.</i> , 350 F.3d 1365 (Fed. Cir. 2003)	19
<i>August Tech. Corp. v. Camtek, Ltd.</i> , 655 F. 3d 1278 (Fed. Cir. 2011)	22
<i>CCS Fitness, Inc. v. Brunswick Corp.</i> , 288 F.3d 1359	16
<i>Honeywell Int’l, Inc. v. Universal Avionics Sys. Corp.</i> , 493 F.3d 1358 (Fed. Cir. 2007)	19
<i>Martek Biosciences Corp. v. Nutrinova</i> , 570 F.3d 1363 (Fed. Cir. 2009)	19
<i>Pacing Techs., LLC v. Garman Int’l, Inc.</i> , 776 F.3d 1021 (Fed. Cir. 2015)	22
<i>In re Paulsen</i> , 30 F.3d 1475 (Fed. Cir. 1994)	16
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	16, 19
<i>SAS Institute, Inc. v. IANCU</i> , 2018 WL 1914661, 138 S.Ct. 1348 (2018)	15
<i>Sinorgchem Co. v. ITC</i> , 511 F.3d 1132 (Fed. Cir. 2007)	20, 21
<i>SuperGuide Corp. v. DirecTV Enters.</i> , 358 F.3d 870 (Fed. Cir. 2004)	46
<i>TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.</i> , 529 F.3d 1364 (Fed. Cir. 2008)	22
<i>Vitronics Corp. v. Conceptronic</i> , 90 F.3d 1576 (Fed. Cir. 1996)	18, 19, 20

Statutes

15 U.S.C. §6827 (1999)	15
------------------------------	----

PATENT OWNER'S EXHIBIT LIST

Ex. 2001	Declaration of Kai Johnson
Ex. 2002	CV of Kai Johnson
Ex. 2003	File History for U.S. Provisional Patent Application No. 61/493,064
Ex. 2004	Collins English Dictionary, definition of “select”
Ex. 2005	American Heritage Dictionary, Fifth Edition, definition of “select”
Ex. 2006	Merriam-Webster Dictionary, definition of “select”
Ex. 2007	Declaration Of Kai Johnson In Support Of Patent Owner Response
Ex. 2008	U.S. Patent Appl. 2011/0145149 to Valdes et al.
Ex. 2009	U.S. Patent Appl. 2005/0187873 to Labrou et al.
Ex. 2010	M. Sherif, <i>Protocols for Secure Electronic Commerce</i> , CRC Press, 2004 (p. 47)
Ex. 2011	U.S. Pat. No. 9,892,386
Ex. 2012	U.S. Pat. No. 11,120,413
Ex. 2013	U.S. Pat. No. 9,892,386
Ex. 2014	The New Palgrave Dictionary of Money and Finance, edited by John Eatwell, Murray Milgate, and Peter Newman (definition of “scrip”)

I. INTRODUCTION

The Petition challenges claims 1-3 and 5-7 (“Challenged Claims”) of U.S. Patent No. 8,538,845 (“’845 Patent,” Ex. 1001) under three grounds of unpatentability. The Board should find that Petitioners have failed to demonstrate the unpatentability of the Challenged Claims. The cited references fail to meet either the Board’s or the Petitioners’ claim construction for “unbanked subscriber,” and the cited references do not meet multiple other aspects of each of the Challenged Claims. Patent Owner’s explanations herein are supported by the Declaration of Kai Johnson, an expert in the field of payment systems and financial transactions. Ex. 2007.

II. THE ’845 PATENT SPECIFICATION

The ’845 Patent specification discloses a mobile financial services (mFS) system for supporting *both* banked and unbanked subscribers. As explained in the ’845 Patent:

The subscriber *may* have *access to a bank account*, or may be an *unbanked subscriber*. Ex. 1001 at 1:51-53 (emphasis added).

* * *

The term “subscriber” refers to a participant of the mFS mobile wallet platform. The subscriber maintains a mobile wallet balance and performs transactions using the mFS application. *An “unbanked subscriber” is a subscriber that does not have (or does not have access to) a bank account or credit union account.* Ex. 1001 at 12:22-27 (emphasis added).

* * *

In this manner, any entity that has established itself as an agent branch (including retail stores, gas stations, service providers, etc.) can provide

cash withdrawal to a mobile wallet subscriber (whether banked or unbanked). Ex. 1001 at 16:25-29 (emphasis added).

While embodiments of the mFS platform disclosed in the Specification apply to both banked and unbanked subscribers, the claims of the '845 Patent are expressly limited to unbanked subscribers.¹

In the mFS system, an unbanked subscriber has a “mobile wallet account” that allows the subscriber “to pay for goods and services on the mFS platform.” (*id.*, 11:34-35), or transfer money to other subscribers and non-subscribers. *Id.*, 12:34-35. Ex. 2007, ¶ 32. As explained in the Specification of the '845 Patent, the mFS platform maintains the unbanked subscriber’s account balance in the form of virtual currency or “eMoney” (Ex. 2007, ¶ 32):

... The mFS platform manages the balance of mobile wallet accounts for each subscriber as value is transferred from one mobile wallet to another (e.g. from a subscriber’s mobile wallet to an agent’s mobile wallet in payment for goods or services). This value is referred to herein as “eMoney”.

As subscribers conduct business with mFS agents, they deposit or withdraw cash from their mobile wallet accounts. Virtual or eMoney credits are transferred between the subscriber’s mobile wallet account and the agent branch’s account as a form of currency to support the transaction. As agents accept cash into their cash register by mFS subscribers, they transfer the equivalent amount of eMoney credits into the mFS subscriber’s mobile wallet account. For instance, if an mFS subscriber gives an mFS agent \$10 to deposit into the subscriber’s

¹ U.S. Pat. Nos. 9,892,386, 11,120,413 and 11,295,281 are each continuations of the '845 Patent which claim other embodiments disclosed in the specification not limited to unbanked subscribers.

mobile wallet account, the agent would place the cash into his register and transfer \$10 from the agent branch's eMoney account into the subscriber's mobile wallet account. While the agent acquired \$10 in his register, he transferred out \$10 of eMoney credits from his branch eMoney account. Ex. 1001 at 7:55-67 (emphasis added).

In the example above, an agent in charge of supporting the mFS platform accepts cash deposits for unbanked subscribers and credits the subscriber's mobile wallet account with a corresponding amount of eMoney. Ex. 2007, ¶ 33. The agent, in turn, maintains its own bank account in order “to conduct everyday business such as accepting cash deposits and cash withdrawals from mFS subscribers.” *Id.*, 8:43-45; 11-56-59; Ex. 2007, ¶ 33.

In the context of the '845 Patent, a person of ordinary skill in the art at the time of the invention (POSITA) would have understood that the “eMoney” in the subscriber's mobile wallet was not legal tender (such as U.S. dollars), but was instead a form of scrip. Legal tender (e.g., U.S. dollars) is a form of payment that must, by law, be accepted as a means to settle a debt. By contrast, scrip is an alternative to legal tender.² Ex. 2007, ¶ 34.

The '845 Patent refers to eMoney (scrip) in the subscriber's account as a “stored value” or “stored value account”:

² In Dr. Chaterjee's Declaration, he identifies a form of scrip issued by Safaricom referred to as e-float.” See Ex. 1003, ¶ 53 (“Safaricom issues a commodity known as “e-float,” measured in the same units as money, which is held under the user's name.”)

The term “mobile wallet” or “mobile wallet account” refers to a stored value account or prepaid access account (PPA) that allows the owner (or “subscriber”) to pay for goods and services on the mFS platform from his or her mobile wallet account. When the mFS eMoney transaction processor is used, the mobile wallet balance is maintained by the mFS platform and value is exchanged within the mFS program as eMoney. Ex. 1001 at 11:32-39 (emphasis added).

* * *

Performing the specified transactions may include communicating with the monetary transaction database 225 to determine whether the transaction is permissible based on data indicated in the unbanked subscriber’s profile (for instance, whether the subscriber has enough eMoney in his or her stored value account ... Ex. 1001 at 14:19-24 (emphasis added).

In the parlance of the ’845 Patent, a POSITA would have understood that a stored value account for an “unbanked subscriber” stores eMoney (scrip) – rather than legal tender (U.S. dollars). Ex. 2007, ¶ 35.³

A. Deposit Transaction By Unbanked Subscriber

The process flows that occur when an unbanked subscriber makes a cash deposit with an agent using legal tender (e.g., U.S. dollars) are illustrated in Figures 3 and 12B of the ’845 Patent, discussed in detail below. In these figures, \$C refers legal tender (US dollars), and \$E refers to eMoney (scrip). Ex. 1001 at 15:15-16

³ In the Institution Decision, the Board saw “no meaningful difference between Tumminaro’s virtual pooled accounts and the ‘stored value accounts’ disclosed in the specification of the ’845 patent.” Institution Decision at note 3. However, there is a significant distinction between the two. Tuminnaro's virtual pooled accounts are bank accounts that hold dollars (legal tender), while the stored value accounts in the ’845 Patent are accounts with a non-bank that hold scrip. Ex. 2007, ¶¶ 34, 88.

(“\$C=Cash Balance and \$E=Electronic Money (eMoney) Balance.”); Ex. 2007, ¶ 36. Turning first to Figure 3, entitled “Subscriber Deposit,” this diagram (reproduced in part and annotated below) illustrates the process flow in a deposit transaction (a “cash-in” transaction) between an unbanked subscriber and an agent:

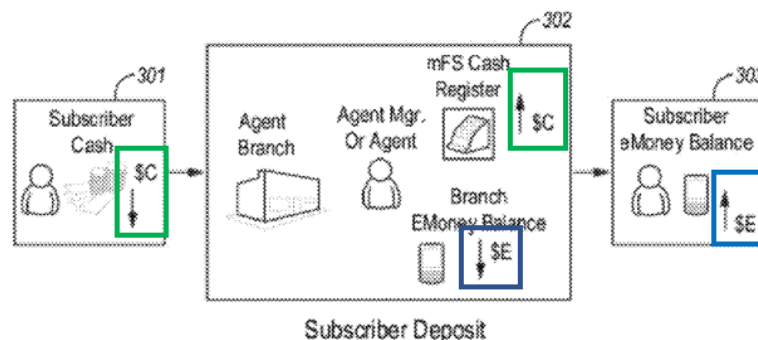


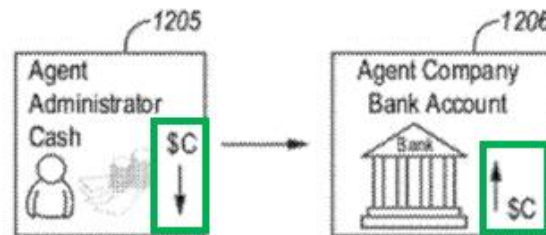
Figure 3 illustrates “an unbanked subscriber making a deposit using a mobile wallet.” Ex. 1001 at 15:7-8. In this process, the unbanked subscriber’s **cash** (i.e., legal tender in the form of U.S. dollars) goes down (represented by the down arrow in box 301), the agent’s **cash** (also legal tender in the form of U.S. dollars) goes up, the unbanked subscriber’s **eMoney** (scrip) balance goes up (as shown in box 303), and the **eMoney** (scrip) balance at the agent branch goes down. As a result of this process, the subscriber has exchanged cash (i.e., legal tender) for eMoney (i.e., scrip). Ex. 2007, ¶ 38. The Specification explains this process as follows:

...To deposit cash in order to get eMoney credit, the subscriber informs the agent manager or agent that they want to deposit a certain amount of cash (in **301**). The agent manager/agent takes the cash and notifies the mobile wallet transaction system of the deposit using their agent manager or agent application (**302**). The transaction system **210** then credits the subscriber’s eMoney account (**303**). ... The agent branch’s eMoney balance is reduced because their actual money balance was

increased by the amount of the deposit. The subscriber's mobile wallet account is credited with eMoney in the amount of the deposit. In this manner, a subscriber can deposit cash into their mobile wallet account (in the form of eMoney) at any retail location or other agent branch location.

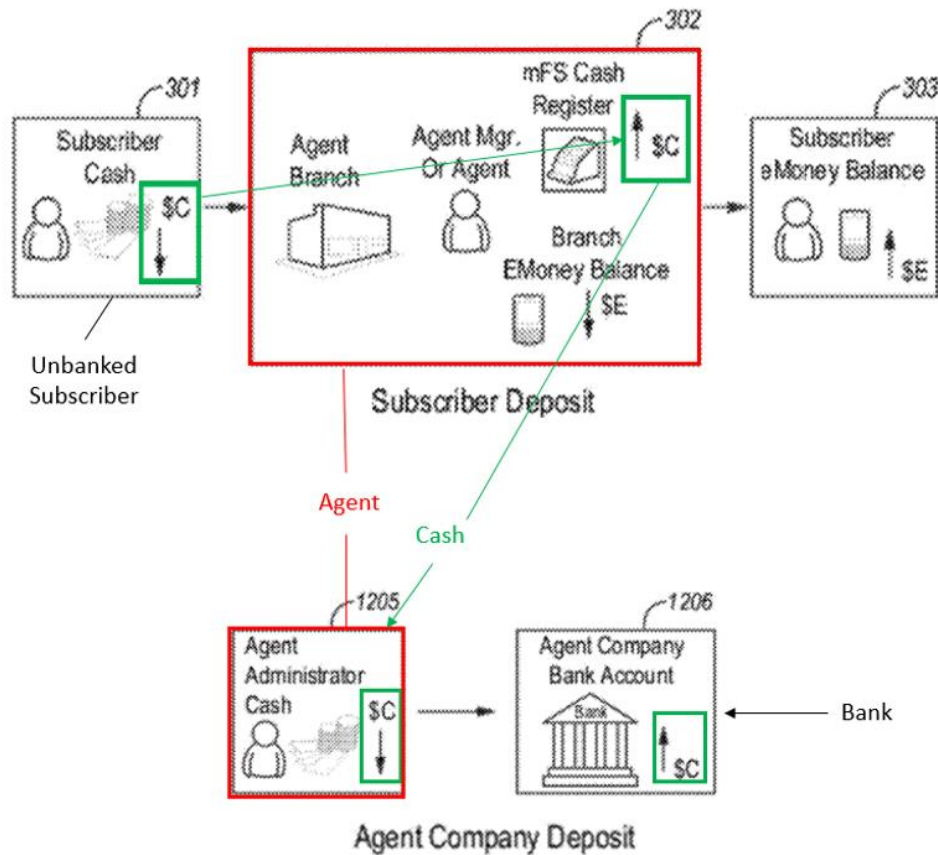
Thus, the agent manager receives the physical cash deposit into the subscriber's eMoney account via the agent manager or agent's application. The subscriber gives cash to agent manager or agent, and the mFS platform processes the request, updates the agent branch and subscriber's eMoney balances, ... Ex. 1001 at 15:21-42 (emphasis added).

The Specification explains that an agent receiving a deposit (in the form of legal tender) from an unbanked subscriber may, in turn, deposit the funds (legal tender) into the agent's bank account. Ex. 2007, ¶ 39. The process flow between the agent and the agent company bank is shown in Figure 12B, entitled “Agent Company Deposit” (reproduced in part below):



In this process, the agent administrator's **cash** (legal tender) goes down (as shown in box 1205), and the **cash** (legal tender) in the agent company's bank account goes up (as shown in box 1206). Ex. 2007, ¶ 40; Ex. 1001 at 22:19-22 (“After the agent company's bank account has been set up, the agent administrator can make deposits into that account. As FIG. 12B shows, once cash (**1205**) has been deposited into the bank account (**1206**), ...”).

Below is a diagram prepared by Patent Owner that combines the aspects of Figures 3 and 12B discussed above in order to illustrate the flow of cash (legal tender in the form of U.S. dollars) when an unbanked subscriber makes a cash deposit with an agent, and the agent administrator, in turn, deposits the cash in the agent company's bank account:



Ex. 2007, ¶ 41.

B. Withdrawal Transaction By Unbanked Subscriber

The withdrawal process described in the '845 Patent for an unbanked subscriber functions similarly to the deposit process described above, but the flows are reversed. Ex. 2007, ¶ 42. The process flows for withdrawals are shown in

Figures 4 and 13 of the '845 Patent. Turning first to Figure 4, entitled “Subscriber Withdrawal,” this diagram (reproduced in part below) illustrates the process flow between the unbanked subscriber and an agent in the context of a withdrawal:

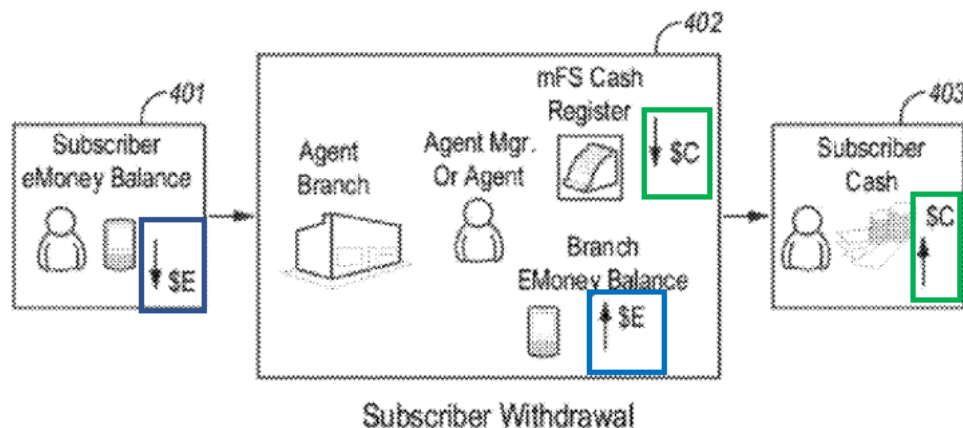
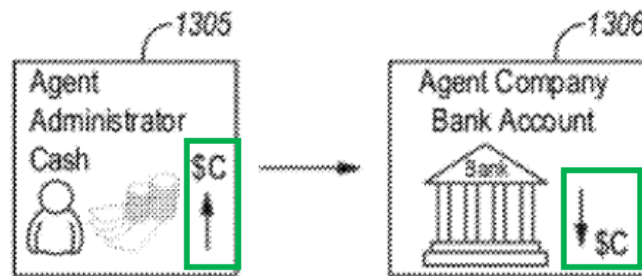


Figure 4 illustrates “an unbanked subscriber making a withdrawal using a mobile wallet.” Ex. 1001 at 16:9-10. In this process, the unbanked subscriber’s **cash** (legal tender) goes up (represented by the up arrow in box 403), the agent’s **cash** (legal tender) goes down, the unbanked subscriber’s **eMoney** (scrip) balance goes down (as shown in box 401), and the **eMoney** (scrip) balance at the agent branch goes down. As a result of this process, the subscriber has redeemed eMoney (i.e., scrip) for cash (i.e., legal tender). Ex. 2007, ¶ 44. The Specification explains this process as follows:

.. To withdraw cash at an agent branch, a subscriber submits a withdrawal request using their application (401). ... The transaction processor 216 may then determine whether the unbanked subscriber has enough eMoney to withdraw the requested amount. If he or she does have enough eMoney, then the subscriber’s eMoney is deducted and that amount is transferred to the agent branch’s eMoney account (402).

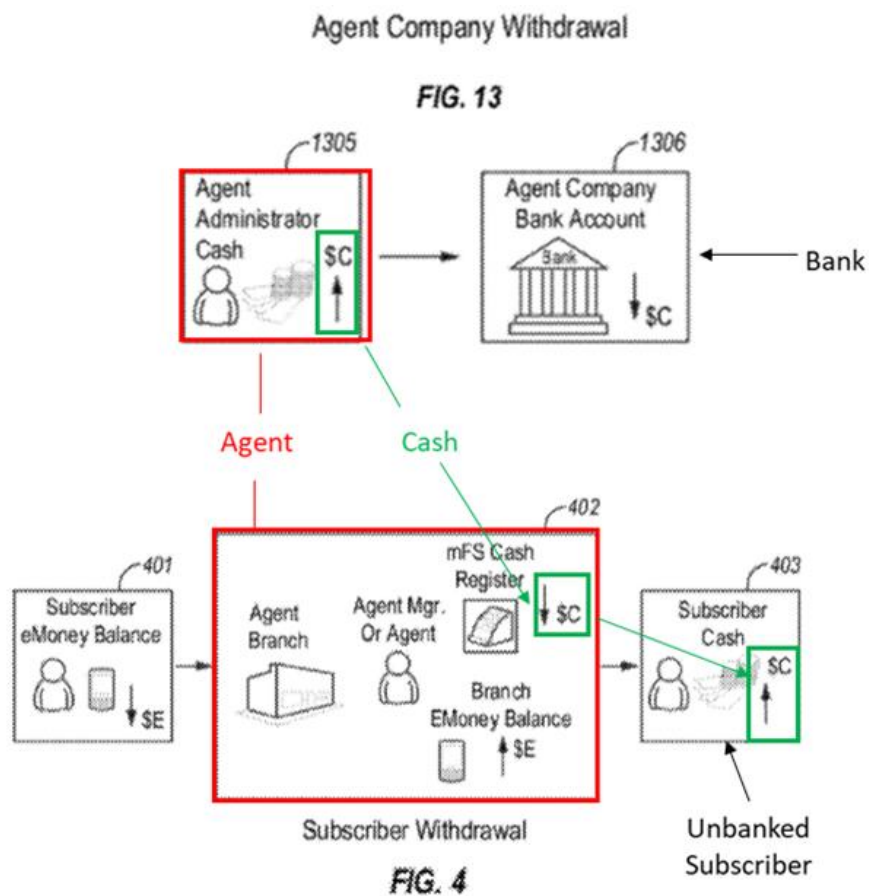
Then, the agent branch gives the subscriber the requested amount of cash (**403**). ... The agent's or agent manager's role is to verify the withdrawal request (e.g. via SMS on the agent's or agent manager's phone) and gives the cash to subscriber. Ex. 1001 at 16:14-32 (emphasis added).

As the Specification explains, “The agent administrator deposits, withdraws, and distributes funds into and out of the agent company's bank account.” (Ex. 1001 at 22:1-3.) This cash is distributed to the agent, so that the agent has physical cash (legal tender) ready for withdrawals. Ex. 1001 at 22:1-3; Ex. 2007, ¶ 45. The process flow between the agent administrator and the agent company bank is shown in Figure 13, entitled “Agent Company Withdrawal” (reproduced in part and annotated below):



In this process, the agent administrator's **cash** (legal tender) goes up (as shown in box 1305), and the **cash** balance in the agent company's bank account goes down (as shown in box 1306). Ex. 2007, ¶ 46; Ex. 1001 at 22:57-60 (“The agent administrator can request a withdrawal via the agent administrator mobile wallet application and physically withdrawal cash (**1305**) from the agent company's bank branch (**1306**).”)

Below is a diagram prepared by Patent Owner that combines the aspects of Figures 4 and 13 discussed above in order to illustrate the flow of cash (legal tender) when an unbanked subscriber makes a cash withdrawal with an agent, and the agent administrator withdraws cash (legal tender) from the agent company's bank account:



Ex. 2007, ¶ 47.

III. THE '845 PATENT PROSECUTION HISTORY

The '845 Patent matured from U.S. Patent Appl. 13/484,199, filed March 30, 2012. The Application was originally filed with three independent claims. Independent claim 1 was directed to a monetary transaction system for conducting

transactions between unbanked subscribers; independent claim 15 was directed to a monetary transaction system for conducting transactions between subscribers (in general) and other entities; and independent claim 20 was directed to a monetary transaction system with several recited components. Ex. 1002 at 1316-1332. Significantly, as filed, only independent claim 1 was limited to unbanked subscribers, while independent claims 15 and 20 were applicable to all subscribers (both banked and unbanked).

In the First Office Action, all claims were rejected over prior art. In rejecting independent claim 1, the Examiner relied on a specific form of scrip in the prior art, i.e., credits stored in a pre-paid telephone account,⁴ disclosed in U.S. Patent Appl.

⁴ Ex. 2007, ¶ 34 (explaining that prepaid phone cards are a form of scrip). As one author explained:

...virtual money may also be a virtual token ... issued by a trusted issuer for unique usage in a closed circuit. These [tokens] are different from the electronic versions of legal tenders because they are recognized only in a restricted commercial circuit. This contrasts with electronic money, which is a multipurpose payment mechanism recognized in general commercial circuits. Millicent, for example, is one system that proposes a method of micropayments with a virtual jeton, the "scrip." A service provider issues a scrip, which does not have any direct relationship with the banking system but is a promise for future service.

...

Telephone cards are a particular case of virtual purses issued by telephone companies. The cards are prepaid, and the values they store are dedicated to the settlement of telephone communications at a given service provider. ... M. Sherif, *Protocols for Secure Electronic Commerce*, CRC Press, 2004, at 47 (emphasis added) (Ex. 2010).

2011/014514 to Valdes et al. (“Valdes”) (Ex. 2008). In rejecting claim 1 over a combination of U.S. Patent Appl. 2005/0187873 to Labrou et al. (“Labrou”) (Ex. 2009) and Valdes, the Examiner stated in part:

Labrou specifically does not mention “*unbanked subscriber*.” But it is well known in the art to use “*pre-paid account*” as source of funding; this was also taught by Valdes. (emphasis added) (Ex. 1002 at 1197).

Independent claims 15 and 20, which were applicable to *all subscribers (both banked and unbanked)*, were rejected over Labrou alone. *Id.* at 1193-1195. Valdes’ teachings of prepaid telephone accounts (scrip) were not applied to claims 15 and 20, as those claims did not recite an “unbanked subscriber.”

In response to the First Office Action, the Applicant added additional limitations to claim 1, further emphasizing the unbanked nature of the subscriber recited in the claim. The additional limitations added to claim 1 are set forth below and include *seven* additional recitations (italicized below) identifying the subscriber as “*unbanked*”:

wherein the monetary transaction system is implemented to deposit funds at an agent branch through a mobile wallet, including performing the following steps:

receiving communication from an agent branch over one of a plurality of channels connected to the monetary transaction system, the agent communication indicating that the *unbanked* subscriber desires to deposit a specified amount of funds into the *unbanked* subscriber’s mobile wallet account;

validating the status of the *unbanked* subscriber’s mobile wallet account;

determining if the agent branch is authorized to receive deposited money;

performing one or more of a limit check and a velocity check on the unbanked subscriber's mobile wallet account, the limit check determining whether sufficient funds are available to make the deposit amount, the velocity check determining whether the unbanked subscriber has exceeded a specified number of transactions within a specified time period;

crediting the unbanked subscriber's mobile wallet account with the specified amount of funds;

returning a notification to the agent branch confirming the deposit; and

notifying the subscriber that the specified amount of funds was deposited in the unbanked subscriber's mobile wallet account over at least one of the plurality of channels connected to the monetary transaction system. Ex. 1002 at 1171-1172 (emphasis added).

The Applicant also significantly revised independent claim 15. In the connection with those amendments, claim 15 was transformed from a claim that applied to generally to both banked and unbanked subscribers, to one reciting a withdrawal transaction by an unbanked subscriber. Independent claim 20 was cancelled, and new independent claim 21 (directed to a monetary transaction system for conducting a transaction between unbanked subscribers) was also added. Following an Examiner's Amendment to claim 1 (Ex. 1002 at 54-55), the application was allowed. *Id.* at 47. Independent claims 1 and 21 in the Application matured into independent claims 1 and 5 in the '845 Patent.

The Applicant subsequently filed several continuations covering other aspects of the Specification, including aspects of the mFS platform generally applicable to

all subscribers (including banked subscribers). *See*, e.g., U.S. Pat. Nos. 9,892,386 Ex. 2011), 11,120,413 (Ex. 2012) and 11,295,281 (Ex. 2013).

IV. RECITATION OF UNBANKED SUBSCRIBER IN CLAIMS

The Petition challenges claims 1-3 and 5-7 of the '845 Patent, of which claims 1 and 5 are independent. Both independent claims are directed towards monetary transactions conducted by an “unbanked subscriber”.

V. CONSTRUCTION OF “UNBANKED SUBSCRIBER”

The Petition proffered its own construction of “unbanked subscriber.” In the Institution Decision, the Board did not adopt the construction advanced in the Petition, reasoning that the Specification of the '845 Patent “provides an explicit definition of the claim term ‘unbanked subscriber.’” Institution Decision at 11. The different constructions of “unbanked subscriber” advanced in the Petition and adopted by the Board are discussed below:

A. Construction Advanced In Petition

The Petition construed an “unbanked subscriber” as follows:

... an unbanked subscriber is one that does not have or have access to a financial institution account. (Pet., 16) (emphasis added)

The term “financial institution” is broader than banks and credit unions, and would be understood by a POSITA to encompass any institution that provides financial services to customers who maintain a financial account with the

institution.⁵ Ex. 2007, ¶ 50. For example, entities that manage debit card accounts (including prepaid debit card accounts) for customers qualify as financial institutions because they maintain a “deposit ... or other financial account or relationship” with the customer. Ex. 2007, ¶ 50. Similarly, institutions that manage Automated Clearing House (ACH) and/or ATM transactions, fall under the category of financial institutions because they maintain a “financial account or relationship” with customers. Ex. 2007, ¶50. Accounts maintained by such entities for customers are “financial institution accounts.” Ex. 2007, ¶ 50.

Petitioners were the masters of the Petition. *SAS Institute, Inc. v. IANCU*, 2018 WL 1914661, 138 S.Ct. 1348 (2018) (“[m]uch as in the civil litigation it mimics, in an inter partes review the petitioner is master of its complaint.”) As masters of their Petition, Petitioners chose to construe an “unbanked subscriber” as someone who, not only lacked (or lacked access to) a bank account, but as someone who also lacked (or lacked access to) a financial institution account with any of the numerous types of financial institutions besides banks. Ex. 2007, ¶¶ 51-52. To the extent that the construction proves detrimental to Petitioners’ arguments in these proceedings, it is

⁵ The term “financial institution” is defined in the U.S. Code as follows:

The term “financial institution” means any institution engaged in the business of providing financial services to customers who maintain a credit, deposit, trust, or other financial account or relationship with the institution. 15 U.S.C. §6827 (1999) (emphasis added).

only because Petitioners, for their own tactical reasons, chose to advance such a construction here.⁶

B. Construction Set Forth In Institution Decision

With respect to claim construction, the Institution Decision stated:

For purposes of institution, the only claim term that requires construction is “unbanked subscriber” because there appears to be a dispute between the parties regarding its scope and meaning. (citations omitted). *It is well-settled that “the specification may reveal a special definition given to a claim term by the patentee In such cases, the [patentee’s] lexicography governs.” Phillips*, 415 F.3d at 1316 (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)). Although the patentee is free to define the specific claim terms used to describe his or her invention, “this must be done with reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Upon reviewing the specification of the ’845 patent, it provides an explicit definition of the claim term “unbanked subscriber.” That is, the specification states that “[a]n ‘unbanked subscriber’ is a subscriber that does not have (or does not have access to) a bank account or credit union account.” Ex. 1001, 12:25–27. By using the verb “is” following “unbanked subscriber,” the specification sets forth an explicit definition for this claim term with reasonable clarity, deliberateness, and precision. Institution Decision at 10-11 (emphasis added).

Despite its finding that the Specification set forth an explicit definition of “unbanked subscriber” with “reasonable, clarity, deliberateness, and precision,” the Board failed to apply that definition as stated in the ’845 Patent. Instead, the Board

⁶ Patent Owner reserves the right to challenge the Petition's construction of “unbanked subscriber” or that of the Board in the Institution Decision, in any future proceeding. Nothing in this Patent Owner’s Response should be construed as an admission or concession by Patent Owner that either of such constructions is correct.

drew on extrinsic evidence to further limit an “unbanked subscriber” to one that does not have (or does not have access to) something that the Board termed to be a “traditional” bank account or credit union account:

Our preliminary determination in this regard is further supported by the testimony of PayPal’s declarant, Dr. Chatterjee. Relying on extrinsic evidence, he testifies that “unbanked” consistently refers to “individuals that cannot get accounts at traditional financial institutions, and typically rely on cash to perform transactions.”

... As we explain above, we understand Tumminaro to draw a distinction between a banked user (i.e., an individual that has (or has access to) a bank account) and an unbanked user (i.e., an individual that does not have (or does not have access to) a bank account). When making its payment system accessible to an unbanked user, Tumminaro discloses that the unbanked user may maintain money in a pooled account. ... Tumminaro further discloses that the pooled accounts may be virtual pooled accounts 134 that are “managed separately from the pooled accounts of the financial institution.”... In our view, Tumminaro discloses that the pooled accounts are not traditional bank accounts, but rather temporary virtual accounts created for an unbanked user that he/she may use to interact with the payment system.

Even if we were to agree with Fintiv that Tumminaro’s payment system allows an unbanked user to make deposits and withdraws from his/her pooled account using an ATM, this would not change our preliminary view that the pooled account is not a traditional bank account. ... *Id.* at 23-25 (emphasis added).

The Board found that the specification explicitly defined “[a]n ‘unbanked subscriber’ [as] a subscriber that does not have (or does not have access to) a bank account or credit union account.” This language from the Specification does not qualify the type of “bank account,” and certainly does not limit “unbanked subscribers” to those lacking “traditional” bank accounts. Put another way, the cited

passage from the Specification does not precede its recitation of “bank account” with the adjective “traditional.” In fact, nothing in the intrinsic record distinguishes between “traditional” and other bank accounts. As explained more fully in the next section, the Board’s reliance of extrinsic evidence to find that a subscriber who has access to a bank account (i.e., Tuminaro’s pooled banked account) is nonetheless an “unbanked subscriber” for purposes of the ’845 Patent so long as the bank account is not a “traditional”⁷ bank account cannot be reconciled with Federal Circuit precedent. See e.g., *Vitronics Corp. v. Conceptronic*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (“[i]n most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence.”)

Before discussing the Federal Circuit’s authority on express definitions, it should be noted that the extrinsic evidence relied on in the Institution Decision makes no mention of traditional bank accounts. In attempting to distinguish “traditional” bank accounts from “non-traditional” bank accounts, the Institution Decision relied on a statement from Petitioner’s expert that “unbanked” refers to “individuals that cannot get accounts at traditional financial institutions” (*Id.* at 23). This statement uses the adjective “traditional” to describe traditional financial

⁷ Nor is there any information in the record as to what does or does not constitute a “traditional” bank account.

institutions. It does not even suggest that, within a traditional financial institution (like the bank in Tuminnaro), there are “traditional” and “non-traditional” bank accounts.

1. Having Found That The Specification Included An Express Definition, The Board Erred In Relying On Extrinsic Evidence To Alter That Definition

Federal Circuit precedent relating to express definitions is clear and well settled: When a patentee explicitly defines a term in the Specification, that definition controls and cannot be altered. As the Federal Circuit has explained:

When a patentee explicitly defines a claim term in the patent specification, the patentee’s definition controls. *See, Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc) (“[T]he specification’ acts as a dictionary when it expressly defines terms used in the claims” (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)); *id.* at 1316 (“[O]ur cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs.”); see also *Honeywell Int’l, Inc. v. Universal Avionics Sys. Corp.*, 493 F.3d 1358, 1361 (Fed. Cir. 2007) (“When a patentee defines a claim term, the patentee’s definition governs, even if it is contrary to the conventional meaning of the term.”); *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1374 (Fed. Cir. 2003) (“Because 3M expressly acted as its own lexicographer by providing a definition of embossed in the specification, the definition in the specification controls the meaning of embossed, regardless of any potential conflict with the term’s ordinary meaning as reflected in technical dictionaries.”). *Martek Biosciences Corp. v. Nutrinova*, 570 F.3d 1363, 1380 (Fed. Cir. 2009) (emphasis added).

Simply put, once the Board found as it did that the Specification of the ’845 Patent set forth an express definition of “unbanked subscriber” with “reasonable, clarity,

deliberateness, and precision,” it should not have searched for further meaning of the term, or relied on extrinsic evidence to alter the express definition. *Vitronics*, 90 F.3d 1576, 1583 (“[i]n those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper. ... The same holds true whether it is the patentee or the alleged infringer who seeks to alter the scope of the claims”); *Sinorgchem Co. v. ITC*, 511 F.3d 1132, 1138 (Fed. Cir. 2007) (“When the specification explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term.”)

2. It Would Be Erroneous To Premise Construction Of “Unbanked Subscriber” On A Requirement That The Challenged Claims Cover Every Embodiment Disclosed in the Specification

In the Institution Decision, the Board appeared to premise its interpretation of “unbanked subscriber” on embodiments in the Specification directed to banked subscribers. For example, in finding that Tumminaro’s reloadable prepaid debit accounts are not “traditional” bank accounts, the Board noted that the ’845 Patent also contemplates prepaid debit cards:

... When making its payment system accessible to an unbanked user, Tumminaro discloses that the unbanked user may maintain money in a reloadable prepaid debit account. See, e.g., Ex. 1005 ¶¶ 278 (“[T]he user may sign up for with a particular banking partner to receive a card. This card may be a prepaid debit card.”), 196 (“In one embodiment of the present invention, an account holder adds money to a prepaid debit account in advance of purchases.”). Similar to our analysis of the

pooled account, Tumminaro discloses that reloadable prepaid debit accounts are not traditional bank accounts, but rather temporary accounts created for an unbanked user that he/she may use to interact with the payment system.⁴

⁴ We take this opportunity to note that the specification of the '845 patent explicitly contemplates using a prepaid debit card by stating that “the mobile wallet utilizes funds from a subscriber’s prepaid debit card . . . to exchange value on the mFS platform.” Ex. 1001, 11:39–42; *see also id.* at 23:10–13 (“The prepaid debit card . . . is linked to the subscriber’s account in the monetary transaction system 210.”). Institution Decision at 26 (emphasis added).

While the '845 Patent does contemplate prepaid debit cards, it only does so in connection with embodiments that apply to banked subscribers.⁸ Ex. 1001 at 27:22–24 (“Other functionality described above in relation to using an eMoney mobile wallet account may also apply to banked subscribers using a debit card associated with their mobile wallet.”) (emphasis added); Ex. 2007, ¶ 61. To the extent the Board reasoned that it needed to limit an unbanked subscriber to one lacking a “traditional” bank account in order to arrive at a construction that covered all of the embodiments (e.g., both banked and non-banked subscribers) disclosed in the Specification, such reasoning was erroneous. As the Federal Circuit explained in *Sinorgchem*, 511 F.3d 1132, 1138:

Where, as here, multiple embodiments are disclosed, we have previously interpreted claims to exclude embodiments where those

⁸ As explained more fully below in connection with the discussion of Tumminaro, users in Tumminaro with reloadable prepaid debit cards are carded users who have individual bank accounts. Ex. 2007, ¶ 80; *see also*, discussion of banked subscribers in the '845 Patent at Section VII, *infra*.

embodiments are inconsistent with unambiguous language in the patent’s specification or prosecution history.

While the ’845 Patent discloses embodiments that apply to banked subscribers and other embodiments that apply to unbanked subscribers, the *claims* of the ’845 Patent are unambiguously limited to *unbanked* subscribers. It, therefore, would be an error to interpret the claims of the ’845 Patent in a manner that required the claims to cover embodiments from the Specification directed to banked subscribers (e.g., subscribers with prepaid debit cards). See *August Tech. Corp. v. Camtek, Ltd.*, 655 F.3d 1278, 1285 (Fed. Cir. 2011) (“[t]he disclosure therefore teaches both using multiple die and multiple wafers to train. The fact that the claims at issue cover only the latter — a plurality of known good wafers — is little cause for concern. “The mere fact that there is an alternative embodiment disclosed in the [asserted patent] that is not encompassed by [our] claim construction does not outweigh the language of the claim, especially when the court’s construction is supported by the intrinsic evidence.”) (citations omitted); *TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1373 (Fed. Cir. 2008); *Pacing Techs., LLC v. Garman Int’l, Inc.*, 776 F.3d 1021 (Fed. Cir. 2015).

VI. APPLICATION OF THE BOARD’S FINDINGS TO THE UNDISPUTED FACTS OF TUMMINARO

In the Institution Decision, the Board found that “Tumminaro’s unbanked subscriber is *capable of accessing both a pooled account ...*.” Institution Decision

at 27. In addition, it is undisputable that Tumminaro's pooled account is a bank account. See, e.g., Ex. 1005 at [0242] (“[i]n an embodiment of the invention, a mobile device is associated to one or more bank accounts (checking, savings, credit, prepaid, or a pooled account, and the like)”) and [0183] (“The transactional databases 308 integrate directly with a pooled bank account 306 maintained at a partner bank. All funds stay within this account.”)⁹ Based on the above, the Board can and should conclude that Tumminaro fails to meet the “unbanked subscriber” limitation in the '845 Patent (i) under the construction advanced in the Petition and (ii) under the express definition found by the Board -- both of which are reproduced below:

Petitioners' Construction: “an unbanked subscriber is one that does not have or have access to a financial institution account.” (Pet., 16) (emphasis added).

Board's Construction: “Upon reviewing the specification of the '845 patent, it provides an explicit definition of the claim term ‘unbanked subscriber.’ That is, the specification states that ‘[a]n ‘unbanked subscriber’ is a subscriber that does not have (or does not have access to) a bank account or credit union account.’” (Institution Decision at 11) (emphasis added).

Neither of these constructions of “unbanked subscriber” is met by Tumminaro's subscriber, who is capable of accessing Tumminaro's pooled bank account.

⁹ The Petition directly acknowledges that the pooled accounts are bank accounts by stating that, “Pooled accounts are bank accounts for multiple users held at a partner financial institution or internally by the closed loop system itself.” (Pet. at 23) (emphasis added).

While there are additional reasons (discussed below) why Tumminaro fails to meet all of the limitations of the Challenged Claims, the Board need go no further than the analysis set forth immediately above to conclude that the Petitioners have failed to meet their burden of proving that the Challenged Claims are met by Tumminaro.

A. The Petition Fails To Demonstrate That Tumminaro Meets Petitioners’ Construction Of “Unbanked Subscriber” (All Grounds)

Under Petitioners’ construction, a subscriber who either has a financial institution account or has access to one, fails to meet the definition of an “unbanked subscriber.” Accordingly, under the Petition’s construction, for a subscriber to be “unbanked,” a subscriber can not have access to an account at any financial institution. Ex. 2007, ¶ 51.

The so-called unbanked subscribers in Tumminaro fail to meet Petitioner’s definition for three independent reasons, namely because such subscribers (i) have a financial institution account (on Tumminaro’s financial platform), (ii) have access to debit accounts which are financial institution accounts, and (iii) have access to a pooled account at a partner bank. These aspects of Tumminaro are discussed below. While Tumminaro may refer to “unbanked users” by name, the Petition fails to explain how such users lack a financial institution account or access to one, as required by Petitioners’ construction. Ex. 2007, ¶ 55.

B. The Petition Fails To Explain How Tumminaro’s So-Called “Unbanked Subscribers” Lack Access To A Financial Institution Account

The Petition argues that subscribers with funds held in Tumminaro’s “pooled accounts” are “unbanked subscribers”:

... Tumminaro discloses the payment system is capable of “*conducting monetary transactions between unbanked subscribers and other entities.*” Tumminaro explains that “[t]he stand-alone closed loop payment system of the present invention is designed to integrate with a companion bank account. This account can be a preexisting account or, **for unbanked users, accounts can be created or held in a pooled account with the partner bank.**” Ex-1005, [0447], emphasis added. (Pet. at 30-31) (emphasis in original).

* * *

... As explained above, Tumminaro’s “pooled account” serves as “the unbanked subscriber’s mobile wallet account. See Ex-1005, [0447]. Tumminaro discloses “crediting the unbanked subscriber’s mobile wallet account with the specified amount of funds.” Ex-1005, [0604] (“At times, account **holders may add funds to the pooled account as indicated at 5302. Such funds may be deposited at a partner merchant that has agreed to accept funds from account holders which are then deposited into the pooled account.**”). Thus, depositing funds into the pooled account “credit[s] the unbanked subscriber’s mobile wallet account with the specified amount of funds.” (Pet. at 66) (emphasis in original).

Tumminaro explains that its “pooled account” is a bank account:

In an embodiment of the invention, a mobile device is associated to one or more bank accounts (checking, savings, credit, prepaid, or a pooled account, and the like) ... Ex. 1005 at [0242] (emphasis added).

The transactional databases 308 integrate directly with a pooled bank account 306 maintained at a partner bank. All funds stay within this account, .. *Id.* at [0183] (emphasis added)

The Petition fails to explain how a subscriber whose funds are held in a “pooled account with a partner bank” meets the Petition’s definition of “unbanked subscriber,” i.e., “one that does not ... have access to a financial institution account.” Ex. 2007, ¶¶ 66-72. Simply put, Tumminaro’s mobile payment system clearly operates as a financial institution because each subscriber (including Tumminaro’s so-called “unbanked subscribers”) with funds in Tumminaro’s pooled account has access to a financial institution account. Ex. 2007, ¶ 71.

In addition, Tumminaro’s mobile payment system operates as a financial institution because it allows subscribers (including Tumminaro’s so-called “unbanked subscribers”) to make deposits to and withdrawals from their bank accounts (including pooled bank accounts) using ATMs:

The mobile payment system allows many different financial services for the user. Examples of Some services includes credit card load, debit card load, Automated Clearing House (ACH) load, ACH unload, person-to-person (P2P) payment, remote pay (RPAY), viral, person-to-merchant (P2M), and referrals. Other services may include automated teller machine (ATM) network load and unload such as through the NYCE, PLUS, or STAR ATM system. Ex. 1005 [0261] (emphasis added).

Ex. 2007, ¶ 57.

Tumminaro makes it clear that the “load” (i.e., deposit) and “unload” (i.e., withdrawal) transactions may be performed using the subscriber’s account managed

either by a partner financial institution (e.g., a partner bank) or internally by the mobile payment system itself – both of which are financial institutions:

Loading of an account refers to transferring of funds to an account on the mobile payment system where funds may be transacted. For example, a user may load funds from a checking account or credit card to the user's mobile payment system account, which may be managed by financial partner or managed by the operator of the mobile payment system. *Id.*, [0262] (emphasis added).

Unloading of an account refers to transferring of funds from the mobile payment system to another account. For example, a user may unload funds from the user's mobile payment system account, which may be managed by financial partner or managed by the operator of the mobile payment system, to a checking account or credit card. *Id.*, [0263] (emphasis added).

Ex. 2007, ¶ 58.

Tumminaro also makes it clear that the “load” (i.e., deposit) and “unload” (i.e., withdrawal) transactions apply to “pooled accounts,” and may be performed using any of the various “financial services” that the mobile payment system allows, including using ATMs:

Loading and unloading may be performed in any of the ways discussed in this application including through ACH, ATM, or credit card or interchange. *Id.*, [0264]

At times, account holders may add funds to the pooled account as indicated at 5302. Such funds may be deposited at a partner merchant that has agreed to accept funds from account holders which are then deposited into the pooled account. Alternatively, the account holder may utilize their plastic debit card at an ATM to deposit cash or checks ... *Id.*, [0604] (emphasis added)

Ex. 2007, ¶ 59.

By allowing its “unbanked subscribers” to deposit and withdraw funds from the pooled account using ATMs, the operator of Tumminaro’s mobile payment system is engaged in the business of providing financial services to customers who maintain a deposit account with the financial institution. Ex. 2007, ¶ 60. Unlike credit card, debit card, and ACH transactions, an ATM transaction occurs directly between the account holder and the financial institution that manages the deposit account. Ex. 2007, ¶ 60. And Tumminaro makes clear that the operator of the mobile payment system is responsible for managing customer accounts even if the funds are held in a pooled account at a partner bank. Accordingly, Tumminaro’s mobile payment system is a financial institution. Ex. 2007, ¶¶ 60, 96. Specifically, Tumminaro explains that:

The system may include a system of record managed by the financial transaction system, recording transaction executed through the consumer interface. The system may include a pooled account managed by the financial transaction system, where a number of the clients accessing the system through the consumer interface have an account in the pooled account. *Id.*, [0041] (emphasis added).

... funds from each account holder are pooled at a single financial institution and each account holder has an interest in the pooled account equal to the funds deposited, minus the funds transferred to another account plus the funds received from others. Account holders may withdraw some or all of their available funds from the pooled account. *Id.*, ¶[0197] (emphasis added).

Ex. 2007, ¶ 60.

Although the '845 Patent discusses that in some embodiments, subscribers can use ATMs and plastic debit cards with mFS platform, the subscribers in these instances are no longer “unbanked” under either Petitioners’ proposed construction or the express definition of “unbanked subscriber” found by the Board. Specifically, the '845 Patent states:

FIG. 17A illustrates a subscriber withdrawal using an automated teller machine (ATM). Subscribers in many countries have access to ATM machines and can use their mobile wallets to perform withdrawals using their (prepaid) debit card at most ATMs. Banks provide ATMs to their customers (typically at no charge) and to non-customers (typically for a small charge). The subscriber requests a cash withdrawal from the subscriber’s mobile wallet via the subscriber’s debit card that is associated with the mobile wallet. The bank providing the debit card may receive settlement reports from the card processor and may transfer and/or settle funds from subscriber’s account to the ATM network bank. An external card processor decrements the subscriber’s mobile wallet balance (1701) and sends transaction reports to the bank for settlement. Accordingly, once the withdrawal request has been received and the external card processor (e.g. Visa® or MasterCard®) (1702) has debited the debit card account, the ATM (1703) dispenses the withdrawn cash to the subscriber (1704). (Ex. 1001, 25:1-18, emphasis added.)

Ex. 2007, ¶ 61.

As described above, Figure 17A of the '845 Patent depicts an embodiment where “banked” subscribers under Petitioners’ proposed construction can make withdrawals from their mobile wallet using a plastic debit card. Notably, the bank, not the mFS platform, in the '845 Patent issues the debit card to the subscriber.

Ex. 2007, ¶ 62. Then the bank, not the mFS platform, performs the settlement for the ATM transaction. Ex. 2007, ¶ 62.

This is in stark contrast to Tumminaro, where the Obopay system manages the transaction. Specifically, Tumminaro explains that “**pooled accounts**” hold the funds of so-called “unbanked subscribers” who have **direct ATM access** to these accounts as illustrated in Figure 5 of Tumminaro, which is reproduced below with Patent Owners annotations:

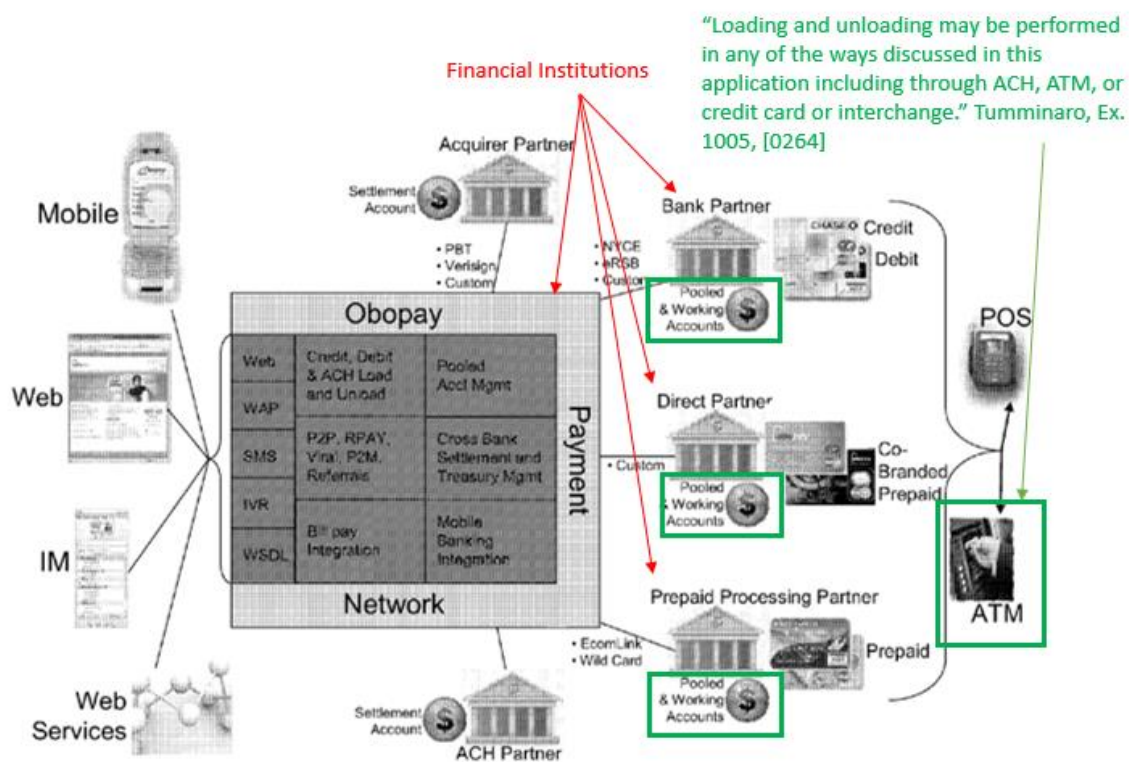


Fig. 5

Ex. 2007, ¶ 63.

Notably, Fig. 5 depicts an NYCE interface for ATM transactions between a bank partner and the mobile payment system operator (labelled Obopay in the diagram) indicating that mobile payment system operator indeed operates the system of record that maintains balances for pooled accounts and is responsible for processing ATM deposits and withdrawals. Accordingly, Tumminaro’s so-called “unbanked subscribers” have access to a financial institution account. Ex. 2007, ¶ 64.

The Petition does not dispute that the operator of Tumminaro’s mobile payment system is a financial institution. In fact, the Petition directly acknowledges this by stating that “Pooled accounts are bank accounts for multiple users held at a partner financial institution or internally by the closed loop system itself.” (Pet. at 23) (emphasis added). Ex. 2007, ¶ 65.

C. The Petition Fails To Explain How Tumminaro’s So-Called “Unbanked Subscribers” – Who Have Direct Access To Debit Accounts -- Lack Access To A Financial Institution Account

In Tumminaro, subscribers (including so-called “unbanked users”) each have access to a “financial institution account” on Tumminaro’s mobile payment system. In addition, Tumminaro describes its so-called “unbanked subscribers” as having a reloadable prepaid debit account:

In one embodiment of the present invention, an account holder adds money to a prepaid debit account in advance of purchases. ... Account holders then have access to these funds through their mobile devices to make payments and they may receive payments to their account activity

from others. In other embodiments, funds may be transferred from a designated credit card account into the prepaid debit account. Ex. 1005 at [0196].

The prepaid debit account to which an account holder may add funds is a “reloadable prepaid account” which is a financial institution account. Ex. 2007, ¶ 69; *see also*, note 5, *supra*.

Notably, Tumminaro makes it clear that the mobile payment service provides debit cards with direct access to the subscriber funds held in a pooled account. Ex. 2007, ¶ 70; Ex. 1005 at [0198] (“In another embodiment, each account holder may set up a prepaid debit account at any financial institution and access the account indirectly to transfer funds. Thus, account holders are not limited to a debit card with funds maintained in the pooled account at a particular financial institution. Rather, account holders may access a debit card account at a financial institution of their choosing.”) A general-purpose prepaid card of this type is certainly a financial institution account, and Tumminaro’s mobile payment system is therefore operating in the role of a financial institution when it issues a debit card that allows the user to access funds via the ATM network. Ex. 2007, ¶ 71.

The Petition does not dispute that the operator of Tumminaro’s mobile payment system is a financial institution, or that the accounts held by Tumminaro’s so-called “unbanked subscribers” are financial institution accounts. In Petitioner’s own language, “Pooled accounts are bank accounts ...,” (Pet. at 23, emphasis added)

and, accordingly, Tumminaro’s so-called “unbanked subscribers” have financial institution accounts. Ex. 2007, ¶ 72.

D. Tumminaro Fails To Meet Petitioners’ Construction Of “Unbanked Subscriber”

While Tumminaro does refer to “unbanked subscribers,” it is clear that such subscribers are not “unbanked subscribers” as that term has been construed in the Petition (“an unbanked subscriber is one that does not ... have access to a financial institution account.”) (Pet. at 16) (emphasis added).¹⁰ Ex. 2007, ¶ 73. As discussed above, the term “financial institution” adopted by Petitioners for their construction of “unbanked subscriber” is broader than banks and credit unions, and encompasses any institution that provides financial services to customers who maintain a financial account with the institution. Ex. 2007, ¶ 74. And as discussed above, the operator of Tumminaro’s mobile payment system is a “financial institution” as defined by Petitioners. Ex. 2007, ¶ 74.

The Petition does not dispute that Tumminaro’s mobile payment system itself provides “financial institution accounts,” such as a prepaid debit account or pooled account accessible via ATM deposits and withdrawals. Nor does the Petition offer

¹⁰ In the context of Tumminaro, an “unbanked subscriber” is merely someone who did not have a financial institution account before the operator of Tumminaro’s mobile payment system provided one. So, Tumminaro uses this term as a marketing phrase. Ex. 2007, ¶ 73.

any explanation why such accounts on Tumminaro’s mobile payment system are not “financial institution accounts.” Ex. 2007, ¶ 75. The failure of the Petition to explain why Tumminaro’s subscriber accounts are not “financial institution accounts,” and why the so called “unbanked subscribers” in Tumminaro have access to financial institution accounts, constitutes a fundamental deficiency in the Petition. In view of this deficiency, the Petition has not met its burden of establishing that the unbanked subscriber limitation in the Challenged Claims is met by Tumminaro.

VII. TUMMINARO FAILS TO MEET THE EXPLICIT DEFINITION OF “UNBANKED SUBSCRIBER” IDENTIFIED BY THE BOARD (ALL GROUNDS)

Under the express definition found by the Board, “[a]n ‘unbanked subscriber’ is a subscriber that does not have (or does not have access to) a bank account or credit union account.” (Institution Decision at 11) (emphasis added). The Board has also found that “Tumminaro’s unbanked subscriber is capable of accessing both a pooled account and a reloadable prepaid debit account” (Institution Decision at 27), and it is undisputable that Tumminaro’s pooled account is a bank account. See, Sections V-VI, *supra*. Accordingly, Tumminaro fails to meet the express definition of “unbanked subscriber” identified by the Board.

All of the so-called unbanked subscribers¹¹ in Tumminaro that are able make deposits or transfers either have or have access to a bank account or a credit union account. Ex. 2007, ¶ 76.

Tumminaro’s “no-card” user has registered with the operator of Tumminaro and has a virtual pooled account maintained by the operator of Tumminaro with funds held in a pooled bank account at Tumminaro’s partner bank. Ex. 2007, ¶ 79. Tumminaro’s “no-card” users have access to the pooled bank account because they can deposit funds into the pooled account at the partner bank (Ex. 1005 at Fig. 8 and [0290]-[0292]), withdraw funds from the pooled account at the partner bank (Ex. 1005 at Fig. 9 and [0293]-[0294]), and initiate P2P transfers (Ex. 1005 at Figs. 12, 13 and 16; [0344]-[0345], and [0348]). Ex. 2007, ¶ 79.

As the name suggests, Tumminaro’s “no-card” user does not have a credit or debit card associated with their account in Tumminaro. A “no-card” user may request a credit or debit card issued by Tumminaro’s partner bank but is not obligated to do so and may remain a “no-card” user indefinitely. Ex. 2007, ¶ 79.

¹¹ Tumminaro has at least three types of users. First, Tumminaro has a type of user that is variously referred to as “invited,” “viral,” “nonmember,” or “unregistered,” referred to herein as “unregistered.” This is a user who has been identified as a recipient of a P2P transfer from one of Tumminaro’s other types of users, but who has no direct relationship with the operator of Tumminaro. An “unregistered” user is not a subscriber and does not have an account in Tumminaro. The only operation available to an “unregistered” user is to register and become a “no-card” user. Ex. 1005 at [0285]-[0350]; Ex. 2007, ¶¶ 77-78.

After requesting a credit or debit card from Tumminaro's partner bank and activating the card, a "no-card" user becomes a "carded" user. Ex. 1005 at Fig. 18 and [0350]; Ex. 2007, ¶ 80. At the same time, the user's virtual pooled account is closed, a new individual card account for the user is opened at Tumminaro's partner bank, and the user's funds are moved from the pooled account to the new individual card account. Ex. 2007, ¶ 80. The individual card account is a bank account in every sense and form, with funds held in a bank account solely for the benefit of the user and available upon demand. Ex. 2007, ¶ 80. The user has provided an address, contact information, and Social Security Number (Ex. 1005 at [0277]-[0278]) and has passed compliance checks (Ex. 1005 at [0592]-[0593]) prior to establishing this bank account. Ex. 2007, ¶ 80.

Tumminaro's "unregistered" users are not subscribers, so whether they are banked or unbanked, they cannot be "unbanked subscribers." Ex. 2007, ¶ 78. Tumminaro's "carded" subscribers have a bank account, which is the individual card account at Tumminaro's partner bank, and so they are not "unbanked subscribers." Ex. 2007, ¶ 80. However, all of Tumminaro's "no-card" subscribers also have or have access to a bank account and therefore are also not "unbanked subscribers." Ex. 2007, ¶¶ 79, 82-88.

Tumminaro's system ultimately relies on funds that are deposited into accounts from external sources. Tumminaro describes several methods of depositing

these funds including credit or debit card charges (Ex. 1005 at Fig. 8 and [0290]-[0292]), and ACH transfers (Ex. 1005 at [0264]). All these methods require Tumminaro's users to have external bank accounts. Ex. 2007, ¶ 94. Credit card transactions are settled to a revolving credit account issued by a bank. Debit card transactions are settled to a demand deposit account issued by a bank. ACH transfers are settled to a deposit account issued by a bank. Any "no-card" user that would use these methods has a bank account and so is not an "unbanked subscriber." Ex. 2007, ¶ 94.

Tumminaro also permits several other types of transactions for "no-card" users. Each of these types of transactions clearly demonstrates that "no-card" users have access to a bank account. For example, "[t]he user may withdraw funds from a designated ATM or other facility associated with financial institution that manages the pooled funds" (Ex. 1005 at [0254]); Ex. 2007, ¶ 96.

As discussed below, the pooled account is a bank account. The ability to withdraw funds from an ATM means that the user has access to a bank account. Ex. 2007, ¶ 96. ATM withdrawals typically require the use of an ATM or debit card which would only be available to a "carded" user, but to the extent that Tumminaro permits cardless ATM withdrawals (which were available at the time), "no-card" users who could withdraw funds from an ATM have access to a bank account. Ex. 2007, ¶ 96. The same sentence in Tumminaro also permits withdrawals from

“[an]other facility associated with financial institution that manages the pooled funds.” (*Id.*) This is a facility that permits withdrawals other than an ATM, so for example, a bank branch where Tumminaro would permit users to walk into a bank branch and withdraw money from the pooled account held by that bank. Ex. 2007, ¶ 96. A pooled account held by a partner bank is unquestionably a bank account. Ex. 2007, ¶ 96. Anyone, including Tumminaro’s “no-card” users, who can walk into a bank branch and withdraw money from a bank account has access to a bank account. Ex. 2007, ¶ 96.

Tumminaro permits “no-card” users to establish direct deposits to their accounts: “[A] registered user may choose to have the user’s paycheck or a portion of the paycheck directly deposited into the system” (Ex. 1005 at [0512]). Ex. 2007, ¶ 97. The prerequisites to establish a direct deposit are the account holder’s name, the routing number for the bank that holds the account, the account number, and the type of account (i.e., checking or savings). By providing the account number associated uniquely with the user’s account in Tumminaro and the routing number associated with the bank holding the account, Tumminaro gives its users access to a bank account (i.e., pooled account) to make direct deposits. Ex. 2007, ¶ 97.

Tumminaro permits users to deposit and withdraw funds from the pooled account: “Consumers and merchants can load and unload from a pooled MSPS working account” (Ex. 1005 at [0499]). This gives subscribers access to the pooled

account, which is a bank account, so in this embodiment subscribers have access to a bank account. Ex. 2007, ¶ 98.

Tumminaro emphasizes that its subscribers have or have access to bank accounts in its own language in [0041]. Tumminaro says, “users through the consumer interface can access their money at a bank connected to the system,” which confirms that deposits in Tumminaro belong to the users (i.e., “their money”) and that the deposits are in a bank account that the users can access. Tumminaro emphasizes subscriber ownership of the funds in [0197]: “Account holders may withdraw some or all of their available funds from the pooled account.” Tumminaro continues in [0041] to say that, “a number of the clients accessing the system through the consumer interface have an account in the pooled account,” which confirms that “no-card” subscribers in Tumminaro have an account in the pooled account which is at the partner bank. That is, Tumminaro’s “no-card” subscribers have a bank account. Ex. 2007, ¶ 99.

VIII. THE PETITION FAILS TO DEMONSTRATE THAT TUMMINARO TEACHES SELECTING A PAYMENT METHOD AS RECITED IN CLAIM 5 (GROUNDS 1-2)

The Specification of the ’845 Patent describes multiple payment methods that may be added to an unbanked subscriber’s mobile wallet, including a stored value account from the platform or a stored value account from a third-party:

In one embodiment, the monetary transaction system 210 is implemented to add a mobile wallet platform stored value account to a mobile wallet. Ex. 1001 at 27:28-30 (emphasis added).

In another embodiment, the monetary transaction system 210 is implemented to add a third party stored value account to a mobile wallet. Ex. 1001 at 27:51-53 (emphasis added).

The Specification of the '845 Patent then explains that the subscriber selects from amongst various payment options for a transaction:

In one embodiment, the monetary transaction system 210 is implemented to pay a bill from a mobile wallet. The communications module 215 of the monetary transaction system 215 receives a subscriber communication over a communication channel 111 connected to the monetary transaction system (step 810). The subscriber communication indicates that unbanked subscriber 205 desires to pay a bill for a specified amount using a specified payment method from the unbanked subscriber's mobile wallet (e.g. eMoney). The monetary transaction system 210 validates the status of the selected payment method (step 820) and performs a limit check and/or a velocity check on the selected payment method to ensure the eMoney transfer is permissible (step 830). The monetary transaction system then debits the specified payment method by the specified amount of funds (step 840) ... Ex. 1001 at 19:31-46 (emphasis added).

The ability of an unbanked subscriber to select from multiple payment methods is reflected in claim 5, which recites in part:

receiving subscriber communication over one of a plurality of channels connected to the monetary transaction system, the subscriber communication indicating that an unbanked subscriber desires to transfer a specified amount of funds to specified recipient using a specified payment method from the subscriber's mobile wallet;

validating the status of the selected payment method;

performing at least one of a limit check and a velocity check on the selected payment method, ...

debiting the specified payment method by the specified amount of funds
...

A POSITA would have understood the limitations in claim 5, reciting “a specified payment method” and “the selected payment method,” to require the unbanked subscriber to specify/select a payment method from the mobile wallet. Ex. 2007, ¶ 102. The plain meaning of these limitations dictates that there must be more than one potential payment method available for selection in the unbanked subscriber’s mobile wallet. Otherwise, the limitations requiring the subscriber to specify/select a payment method would be superfluous. Ex. 2007, ¶¶ 126-127; Ex. 2004, *Collins English Dictionary*, definition of “select” (“If you select something, you choose it from a number of things of the same kind) (emphasis added); Ex. 2005, *American Heritage Dictionary*, Fifth Edition, definition of “select” (“selected, selecting, selects, v.tr. To take as a choice from among several”) (emphasis added); Ex. 2006, *Merriam-Webster Dictionary*, definition of “select” (“selected, selecting, selects, *transitive verb*: to choose (as by fitness or excellence) from a number or group.”)

A. The Requirement That There Be More Than Payment Method Must Be Read In Conjunction With The Other Claim Limitations Requiring The Subscriber To Be An “Unbanked Subscriber”

Significantly, the requirement in claim 5 that there be more than one potential payment method available for selection in the mobile wallet, must be read in conjunction with the other limitations of claim 5 requiring the subscriber to be an “unbanked subscriber.” Thus, the payment options cannot include options like a pooled bank account or debit card that would nullify a subscriber’s status as an “unbanked subscriber.” Ex. 2007, ¶¶ 104-105.

In arguing that this limitation is met by Tumminaro, the Petition argues as follows:

Tumminaro discloses that users/members may use a pooled account or a prepaid debit card. Ex-1003, ¶157, Ex-1005, [0447] (“for unbanked users, accounts can be created or held in a pooled account with the partner bank.”) Depending on the user’s account configuration, the communication to the financial transaction system indicating that the user wishes to transfer funds to a specified recipient will include the payment method to be used (i.e., pooled account or prepaid debit card). Ex-1003, ¶157. Additionally, a mobile device may be “associated to one or more bank accounts (checking, savings, credit, prepaid, or a pooled account, and the like).” Ex-1005, [0242]. In the multiple account scenario, a user would typically pick which account to use to fund a transfer. Ex-1003, ¶157. (Pet. at 43) (emphasis added).

Significantly, the selectable payment options from Tumminaro identified in the Petition are all options that would nullify a subscriber’s status as an “unbanked subscriber.” As explained above, Tumminaro’s pooled accounts are both financial institution accounts and bank accounts; Tumminaro’s individual card accounts and

individual prepaid debit card accounts are limited to carded users who are “banked,” and thus, by definition, such accounts could not be available to an “unbanked subscriber.” Ex. 2007, ¶¶ 80, 129.

Even more importantly, as explained in detail by Patent Owner’s expert, Tumminaro does not show that an unbanked subscriber can specify a payment method from the subscriber’s mobile wallet to be used for the transfer. Ex. 2007, ¶¶ 103-121. Tumminaro never shows a source of funds for a transfer other than the subscriber’s account at a partner bank and never shows any step where an unbanked subscriber could specify a payment method other than the account at the partner bank. Ex. 2007, ¶ 121.

Petitioners’ expert further alleges that “[w]here a given user has two or more accounts associated, for example, a pooled account and a separate prepaid account such as a gift card or prepaid debit card, the user would typically pick one of the multiple accounts to use as a funding source.” (Ex. 1003, ¶ 157). This assertion has no supporting citation to Tumminaro, and the term “gift card” does not appear anywhere in Tumminaro. Ex. 2007, ¶ 130. As explained above, the other two payment options identified by Petitioners’ expert – the pooled account or prepaid debit account – are financial institution/bank accounts that, even if available to the subscriber, would nullify a subscriber’s status as an “unbanked subscriber.” Ex. 2007, ¶ 130.

Simply put, in arguing that the limitations in claim 5 reciting “a specified payment method” and “the selected payment method” are met by Tumminaro, the analysis in the Petition has failed to consider that such payment methods cannot be ones that nullify a subscriber’s status as an “unbanked subscriber” under the Petition’s construction of that term. Ex. 2007, ¶ 131. This flaw in the Petition’s analysis renders the Petition’s arguments with respect to claim 5 (Grounds 1-2) deficient. For this further reason, the Petition has not established a reasonable likelihood of success on the merits with respect to Grounds 1-2.

B. Tumminaro’s Pooled Accounts And Reloadable Prepaid Debit Accounts Are Bank Accounts, And Are Not Temporary

With respect to Patent Owner’s argument in the Patent Owner Preliminary Response that having (or having access to) a pooled bank account and/or prepaid debit account would nullify a subscriber’s status as an “unbanked subscriber,” the Institution Decision stated:

... Fintiv argues that PayPal relies on Tumminaro’s pooled accounts and reloadable prepaid debit accounts to teach the selectable payment options required by independent claim 5, but, according to Fintiv, each of these options qualifies as financial institution accounts that, if available for selection by an “unbanked subscriber,” would nullify his/her status as an “unbanked subscriber.” ...

Fintiv’s arguments ... are predicated on the notion that Tumminaro’s pooled accounts and reloadable prepaid debit accounts qualify as traditional bank accounts, which, by definition, cannot be available to an “unbanked subscriber.” *See* Prelim. Resp. 23–25. For the same reasons we identify above when addressing the claimed “unbanked subscriber,” this argument is not persuasive because Tumminaro’s pooled accounts and reloadable prepaid debit accounts

are not **traditional** bank accounts, but rather **temporary** (and in the case of pooled accounts—also virtual) accounts created for an unbanked user that he/she may use to interact with the payment system. (Institution Decision at 27-28) (emphasis added).

As explained above, neither the construction advanced in the Petition, nor the express definition of “unbanked subscriber” identified by the Board limits the type of bank account a subscriber must lack to a “traditional” bank account. Nor does Tumminaro describe its pooled bank accounts or prepaid debit accounts as “temporary.” In fact, the term “temporary” appears nowhere in Tumminaro, and a POSITA would not have understood Tumminaro’s pooled bank accounts or prepaid debit accounts to be “temporary”—they are not. Ex. 2007, ¶ 81.

In rejecting Patent Owner’s argument that a prepaid debit card would nullify a subscriber’s status as an “unbanked subscriber,” the Board also stated:

We take this opportunity to note that the specification of the ’845 patent explicitly contemplates using a prepaid debit card by stating that “the mobile wallet utilizes funds from a subscriber’s prepaid debit card . . . to exchange value on the mFS platform.” Ex. 1001, 11:39–42; *see also id.* at 23:10–13 (“The prepaid debit card . . . is linked to the subscriber’s account in the monetary transaction system 210.”). Institution Decision at note 4.

As explained above, the Board’s point that the Specification of the ’845 Patent contemplates using a prepaid debit card misses the mark because the Specification of the ’845 Patent contemplates both unbanked subscribers (who lack a prepaid debit

card) and banked subscribers (who have a prepaid debit card).¹² As the Federal Circuit has explained, where, as here, multiple embodiments (e.g., banked subscribers and unbanked subscribers) are disclosed, but the claims unambiguously exclude some embodiments (i.e., banked subscribers), it is error to construe the claim as needing to cover the embodiments (banked subscribers) excluded by the claim. *See*, Section, V(B), *supra*.

IX. TUMMINARO FAILS TO TEACH A “LIMIT CHECK” AS RECITED IN CLAIM 1 (GROUND 3)

A. Under The Federal Circuit’s Decision In *Superguide*, Claim 1 Requires A Limit Check And A Velocity Check

In pertinent part, claim 1 recites:

“performing one or more of a limit check and a velocity check on the unbanked subscriber’s mobile wallet account, the limit check determining whether sufficient funds are available to make the deposit amount, the velocity check determining whether the unbanked subscriber has exceeded a specified number of transactions within a specified time period”

As explained by the Federal Circuit in *SuperGuide Corp. v. DirecTV Enters.*, 358 F.3d 870, 885-86 (Fed. Cir. 2004) where, as here, the phrase “one or more of” precedes a series of categories of criteria, and the claim uses the term “and” to

¹² *See, e.g.*, Ex. 1001 at 27:22-24 (“Other functionality described above in relation to using an eMoney mobile wallet account may also apply to banked subscribers using a debit card associated with their mobile wallet.”) (emphasis added).

separate the categories, the claim requires *at least one instance from each category in the list* be present. As explained by the Court:

We conclude that the plain and ordinary meaning of the disputed language supports the district court’s construction and that the phrase “at least one of” means “one or more.” The issue here is what does “at least one of” modify? The criteria listed in the claim at issue consist of four categories (program start time, program end time, program service, and program type). Each category is further comprised of many possible values. SuperGuide contends that the phrase “at least one of” modifies the entire list of categories, i.e., selection and storage of one or more values for one or more of the four listed categories is required.

DirecTV, on the other hand, argues that the phrase “at least one of” modifies each category in the criteria list, i.e., one or more values in each category are required. We agree with DirecTV. The phrase “*at least one of*” *precedes a series of categories of criteria*, and the patentee used the term “*and*” to separate the categories of criteria, which connotes a conjunctive list. A common treatise on grammar teaches that “an article of a preposition applying to all the members of the series must either be used only before the first term or else be repeated before each term.” Thus, “in spring, summer, or winter” means “in spring, in summer, or in winter.” Applying this grammatical principle here, *the phrase “at least one of” modifies each member of the list*, i.e., each category in the list. Therefore, the district court correctly interpreted this phrase as requiring that the user select at least one value for each category; that is, *at least one of a desired program start time, a desired program end time, a desired program service, and a desired program type*. *Id.* (emphasis added) (citations omitted).

Thus, the language in claim 1 reciting “performing *one or more of* a *limit check and a velocity check* on the unbanked subscriber’s mobile wallet account,” requires performing at least one limit check *and* at least one velocity check. With respect to claim 1, the Petition states that “the claim only requires at least one of a limit check and a velocity check.” (Pet. at 65). To the extent the Petition is suggesting

that the requirements of claim 1 can be met by either a limit or a velocity check, it is incorrect as a matter of law.

B. Claim 1 Requires Both Performance Of A Limit Check (I) “On The Unbanked Subscriber’s Mobile Wallet Account,” And (Ii) That The Limit Check Determine Whether Sufficient Funds Are Available To Make The Deposit

In pertinent part, claim 1 recites:

... performing one or more of a limit check and a velocity check on the unbanked subscriber’s mobile wallet account, the limit check determining whether sufficient funds are available to make the deposit amount, ...

Two aspects of this claim language are important. First, the claim language requires that the limit check “determines whether sufficient funds are available to make the deposit.” Second, the claim language recites that the limit check is performed “on the unbanked subscriber’s mobile wallet account.” A limit check unrelated to the unbanked subscriber’s mobile wallet account, or directed to an account different from the unbanked subscriber’s mobile wallet account, would, therefore, be outside the scope of this limitation. Ex. 2007, ¶ 135.

C. The Intrinsic Evidence Demonstrates That The Claimed Limit Check Is Not Met By An Agent Counting Cash Provided By The Customer

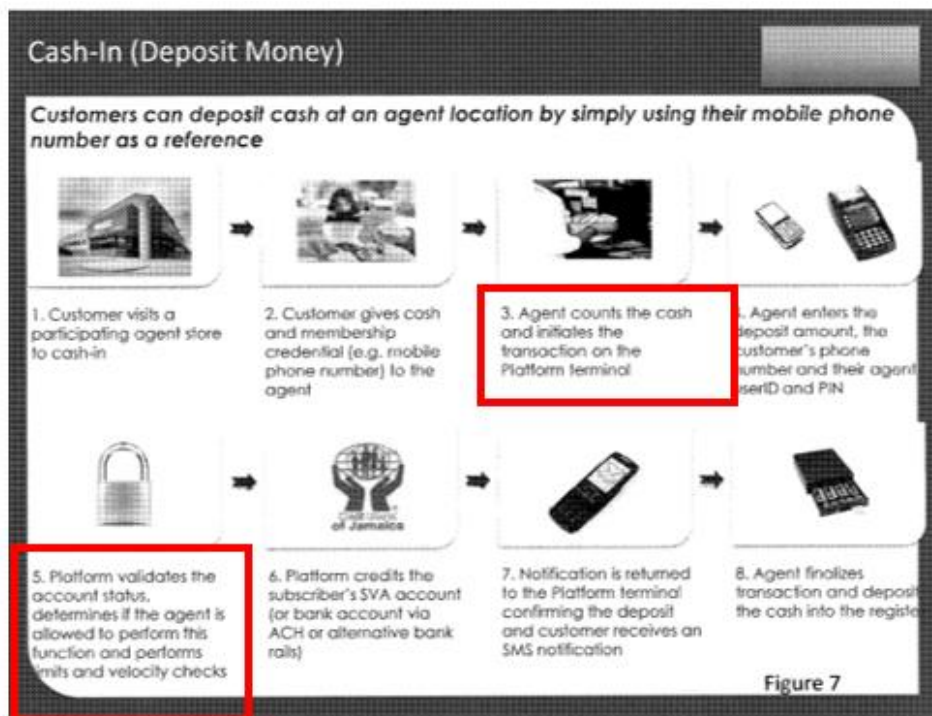
The Specification of the ’845 Patent discloses several examples of limit checks. See, e.g., Ex. 1001 at 15:61-62 (limit check in deposit transaction); 23:45 (limit check in deposit transaction) and 29:16 (“[t]ransaction limits can be placed on

user accounts. The transaction limits are fully configurable for each particular use case, channel and payment method that allows maximum flexibility to restrict higher risk use cases.”) None of these examples suggest that the performance of a limit check on the subscriber’s mobile wallet account is met by an agent simply counting physical cash. Ex. 2007, ¶ 138. In any event, as discussed below, the intrinsic record makes clear that an agent counting cash is not the same as a limit check.

The ’845 Patent incorporates by reference the entirety of Provisional Patent Application Nos. 61/522,099 and 61/493,064. Ex. 1001 at 1:10-12. The Petition relies on aspects of Provisional Application No. 61/522,099 (Ex. 1027) for claim construction of another term¹³ but fails to mention that the “limit check” is disclosed in Provisional Patent Application No. 61/493,064 (the “’064 Provisional Application”) (Ex. 2003 at 51).

Like claim 1, Figure 7 of the ’064 Provisional Application (reproduced below with Patent Owner’s Annotations) is directed to a deposit transaction.

¹³ See Pet. at 17-19 (relying on Ex. 1027 for construction of “(‘validating the status of the specified recipient to ensure the specified recipient has a valid mobile wallet account.’)”) ”



As shown above, in Step 3 of the deposit transaction, the “[a]gent counts the cash” provided by the customer. The limit check is a separate step that occurs in step 5. In step 5, the “Platform... performs limits and velocity checks.”. Figure 7 from the provisional application clearly identifies that an agent counting cash is not the same as a limit check. Ex. 2007, ¶ 141.

A POSITA would have understood that the steps illustrated in Figure 7 of the ’064 Provisional Application are performed sequentially. Ex. 2007, ¶ 142.

In particular, a POSITA would understand from Figure 7 that the agent counts the cash before the initiating the transaction¹⁴ (in Step 3); that the agent enters a deposit

¹⁴ The Board confirmed in the Institution Decision that “the agent first determines whether the funds presented for deposit are sufficient by physically counting cash

amount in Step 4; and that *the Platform performs the limit check* in Step 5. Ex. 2007, ¶ 142. In addition, a POSITA would understand the subject of each sentence describing a step as the actor responsible for performing the step. E.g., “*Agent* counts the cash ...” means that this step is performed by the Agent and not by another actor. In the context of this diagram, a POSITA could not come to the conclusion, as suggested by the Board in their Institution Decision, that Steps 3 and 5 are one and the same because each step in the diagram is clearly distinct, each step is performed in sequence, and the actors performing Steps 3 and 5 are different where the *Agent* counts the cash in Step 3 and the *Platform* performs limit and velocity checks in Step 5. A POSITA would understand the actor performing Step 5 (i.e., the *Platform*) to refer the “mobile wallet platform”¹⁵ of the ’845 Patent and not a person. Ex. 2007, ¶ 142.

In analyzing the description of the limit check in the Specification, the Board stated: “when describing the data flow for performing a subscriber deposit using a mobile wallet as illustrated in Figure 3, [the specification] states that [t]he monetary transaction may then *use rules engine 220 to perform a limit check* ...” Institution Decision at 45. Thus, the example in the Specification – like that in the provisional

presented for deposit (i.e., effectively performing a limit check) *prior* to initiating the deposit transaction process on the Platform terminal.” Institution Decision at 49.

¹⁵ It bears noting that claim 1 is *system* claim (performed by “a monetary transaction system *processor*”).

application – demonstrates that the limit check is performed by a machine rather than a person.

In the Institution Decision, the Board stated:

We fail to see why steps 3 and 5 must be mutually exclusive, as asserted by Fintiv. *See* Prelim. Resp. 29–30. Indeed, it seems logical, if not required, that the agent first determines whether the funds presented for deposit are sufficient by physically counting cash presented for deposit (i.e., effectively performing a limit check) prior to initiating the deposit transaction process on the Platform terminal. This holds true even when the platform terminal itself performs another limit check at step 5 of the deposit transaction process, especially if the platform terminal is seeking to maintain compliance with anti-money laundering regulations. Institution Decision at 48-49 (emphasis added).

The Board’s suggestion that Figure 7 discloses two limit checks – one at Step 3 before the transaction is initiated and a second limit check in Step 5 – is, with all due respect, inconsistent with the intrinsic record, which lacks any mention of two such limit checks. The ’845 Patent refers to “a limit check” in the singular and never refers to multiple limit checks Ex. 2007, ¶ 143.

Finally, with respect to the “limit check” limitation, the Board also stated:

As an initial matter, we look to the plain language of independent claim 1 and the specification of the ’845 patent to determine what it means to perform a limit check when depositing funds into the unbanked subscriber’s mobile wallet account. In our view, the plain language of independent claim 1 is controlling because it explicitly states that performing “the limit check” involves nothing more than “determining whether sufficient funds are available to make the deposit amount.” ... neither the plain language of independent claim 1 nor the specification of the ’845 patent indicates that determining whether sufficient funds are available when depositing funds into the unbanked

subscriber's mobile wallet account precludes physically counting cash presented for deposit. Institution Decision at 45-46 (emphasis added).

Patent Owner respectfully disagrees. The Board is incorrect when it states that performing “the limit check” involves nothing more than “determining whether sufficient funds are available to make the deposit amount.” The claim language indeed requires more. Specifically, the claim requires that the limit check is performed “on the unbanked subscriber's mobile wallet account.” A limit check that is not “on the unbanked subscriber's mobile wallet account” – such as an agent simply counting cash – does not meet the claim language. The Board is also incorrect to the extent it has reasoned nothing in the Specification of the '845 Patent precludes the claimed limit check from being met by an agent simply physically counting cash presented for deposit. Figure 7 of the '064 Provisional Application (incorporated by reference into the '845 Specification) indeed precludes such an interpretation.

D. The Petition Has Failed To Demonstrate That The References Teach Or Suggest The Limit Check Recited In Claim 1

Claim 1 is cast in the context of an unbanked subscriber making a deposit, and requires “a limit check ... on the unbanked subscriber's mobile wallet account, the limit check determining whether sufficient funds are available to make the deposit amount.” In arguing that this limitation is met by Tumminaro and Keena, the Petition states:

The combination of Tumminaro and Keena renders obvious this limitation. Ex-1003, ¶¶ 201-202. Tumminaro and Keena disclose performing a limit check to determine whether sufficient funds are available to make the deposit amount. A merchant load agent will only deposit or top off the amount of cash physically received from the unbanked subscriber. Ex-1003, ¶ 202. Kenna also describes performing a limit check to determine whether the vendor has sufficient funds to perform the top-up operation. Ex-1006 at [0052]. Both these operations satisfy the “limit check” requirement of this limitation, and the claim only requires at least one of a limit check and a velocity check. Ex-1003, ¶ 202. (Pet. at 65)

Neither of the two arguments made above satisfies the claim language specifying “a limit check ... on the unbanked subscriber’s mobile wallet account, the limit check determining whether sufficient funds are available to make the deposit amount.” Ex. 2007, ¶ 145.

With respect to the first argument, the counting by a merchant load agent of physically received cash is not a limit check “on the unbanked subscriber’s mobile wallet account,” as claimed. There is no check whatsoever on the unbanked subscriber’s mobile wallet account when a merchant agent counts physically received cash. Ex. 2007, ¶ 146. Moreover, the intrinsic record makes clear that an agent simply counting cash is not a limit check within the context of the ’845 Patent. *Id.*

With respect to the second argument, Kenna’s alleged disclosure of “a limit check to determine whether the vendor has sufficient funds to perform the top-up operation” is also deficient. The claimed “limit check” is performed “on the

unbanked subscriber's mobile wallet account.” Determining the sufficiency of funds of the vendor is not a “limit check” performed “on the unbanked subscriber's mobile wallet account,” as claimed. Ex. 2007, ¶ 147.

In the alternative, the Petition argues that the claimed “limit check” would have been obvious to “safeguard against fraud and maintain compliance” with regulations. In this regard, the Petition states:

Additionally, it would have been obvious at the time of invention to a POSA to implement either or both of limit and velocity checks. As discussed with respect to limitation 5[h], Tumminaro describes both limit checks and velocity checks. It would have been obvious to a POSA at the time of invention to implement one or both checks for a deposit, in order to safeguard against fraud and maintain compliance with AML regulations. *Id.* For example, adding a velocity check would guard against an attempt to fraudulently deposit numerous counterfeit bills by splitting up what would otherwise be a single large deposit into numerous smaller deposits. *Id.*, ¶204. (Pet. at 65-66) (emphasis added).

These arguments do withstand scrutiny. First, to the extent the Petition is implying that claim 1 can be satisfied by “either” a limit check or velocity check – as opposed to “both” -- it is incorrect as a matter of law. See, discussion of *Superguide, supra*.

Second, the cross-reference to “limitation 5[h]” for the claimed “limit check” in claim 1 is deficient. Claim 5 is directed to a transaction where an unbanked subscriber transfers funds from the unbanked subscriber's account to a specified recipient, and the limit check in that claim relates to whether the unbanked subscriber has sufficient funds in his account to fund the transfer to the recipient. By

contrast, claim 1 is directed to an unbanked subscriber depositing funds into the subscriber's own account.¹⁶ In connection with “limitation 5[h],” the Petition argues, “[c]hecking the balance on person A’s (“unbanked subscriber”) account serves as ‘performing ... a limit check.’” Pet. at 45. The Petition fails to explain how this mapping relates to claim 1, where the limit check determines whether sufficient funds are available to make the deposit into the unbanked subscriber’s account. Ex. 2007, ¶ 150.

Third, to the extent the Petition is suggesting that it would have been obvious to implement the claimed “limit check” to “guard against an attempt to fraudulently deposit numerous counterfeit bills by splitting up what would otherwise be a single large deposit into numerous smaller deposits,” the Petition has failed to explain how such a check would meet the claim language. Here, claim 1 recites “a limit check ... on the unbanked subscriber’s mobile wallet account, the limit check determining whether sufficient funds are available to make the deposit amount.” The Petition fails to explain how guarding “against an attempt to fraudulently deposit numerous counterfeit bills by splitting up what would otherwise be a single large deposit into

¹⁶ In Claim 5, the limit check is for “determining whether sufficient funds are available to make the deposit amount.” In the context of Claim 5, the “deposit amount” is the amount that an unbanked subscriber is transferring from his account and depositing in the account of the recipient. In addition, while Claim 1 recites that the claimed limit check is performed “on the unbanked subscriber’s mobile wallet account,” Claim 5 contains no parallel language.

numerous smaller deposits” relates to determining whether sufficient funds are available to make the deposit amount, as required by the “limit check” in claim 1. Ex. 2007, ¶ 151.

In summary, the Petition has failed to demonstrate that the “limit check” recited in claim 1 is met by Tumminaro and Keena. For this further reason, the Petition has not met its burden of proof with respect to Ground 3.

X. CONCLUSION

The “unbanked subscriber” limitation is at the heart of all of the Challenged Claims. Petitioners went out of their way to expressly define this term, and then failed to devote even a single sentence of the Petition to explain how the prior art met Petitioners’ construction of the term. The Petition also fails to demonstrate that the references disclose “selection of a payment method” by an unbanked subscriber (claim 5) and the “limit check” limitation (claim 1). The Board should find that the Petition has failed to demonstrate the unpatentability of any of the Challenged Claims.

Dated: January 11, 2024

Respectfully submitted,

By: /s/ Jonathan K. Waldrop

Jonathan K. Waldrop

USPTO Registration No. 50,334

Attorney for Patent Owner

CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this Patent Owner Response complies with the type-volume limits of 37 C.F.R. § 42.24(b)(1) because it contains 13,957 words, excluding the parts of this Patent Owner's Preliminary Response that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this Patent Owner's Response.

Dated: January 11, 2024

By: /s/ Jonathan K. Waldrop
Jonathan K. Waldrop
USPTO Registration No. 50,334
Attorney for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S RESPONSE** was served via email (as consented to by counsel) on January 11, 2024 to lead and backup counsel of record for Petitioners as follows:

Robert N. Kang WINSTON & STRAWN LLP 101 California Street San Francisco, CA 94111 rkang@winston.com	Barry K. Shelton WINSTON & STRAWN LLP 2121 N. Pearl Street, Suite 900 Dallas, TX 75201 bshelton@winston.com
Christopher T. Gresalfi WINSTON & STRAWN LLP 200 Park Avenue New York, NY 10166 cgresalfi@winston.com	Travis Jensen ORRICK, HERRINGTON & SUTCLIFFE LLP 1000 Marsh Road Menlo Park, CA 94025 tjensen@orrick.com

Dated: January 11, 2024

By: /s/ Jonathan K. Waldrop
Jonathan K. Waldrop
USPTO Registration No. 50,334
Attorney for Patent Owner
