

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 SUR-REPLY

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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. 2011/014514 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

I. INTRODUCTION

Petitioner's Reply is limited to attorney argument. The record (now closed) is devoid of any testimony from Petitioner's expert that Tumminaro invalidates the Challenged Claims under the explicit definition of "unbanked subscriber" found by the Board, or the construction of that term applied by the Board in the Institution Decision (hereinafter "ID"). Also absent is any testimony from Petitioner's expert explaining why Tumminaro's subscriber accounts are not "financial institution accounts" or how Tumminaro's subscribers lack access to such accounts, under Petitioner's proposed construction. POR, 33-34. It is now undisputed that "Tumminaro's unbanked subscriber is capable of accessing both a pooled account ..." (ID, 27), and that Tumminaro's pooled account is a bank account. These undisputed facts are case dispositive.

II. PATENT OWNER'S PRIOR STATEMENTS DO NOT SUPPORT PETITIONER AND ARE NOT INCONSISTENT WITH PATENT OWNER'S POSITIONS

Petitioner seeks to distract from its failures of proof by quoting Patent Owner (hereinafter "PO") and its expert out of context.

A. Petitioner's Motion To Invalidate The '845 Patent

In its motion to invalidate the '845 Patent under 35 U.S.C. §101, Paypal argued that the claims recited patent-ineligible subject matter because they recited "only 'generic,' 'routine,' or 'conventional' computing devices and functionality."

Ex. 1033 at 18. PO's response explained how the claims improved upon conventional activities. Ex. 1033, 3 (“[a]s alleged in the Amended Complaint, the '845 Patent's non-traditional, not well-known, and unconventional technical solutions to prior art problems in banking and financial transactions provides at least four benefits ...”) PO's point was that the claims did not extend to conventional activities like “traditional” financial services. However, the fact that the claims do not cover one area does not mean that the claims cover all other areas. Put another way, the fact that the claims do not cover conventional financial services does not mean that the claims extend to all other services. There is nothing inconsistent between PO's prior statement that the claims do not extend to conventional activities, and PO's position herein that the claims also do not extend to a system like Tumminaro.

B. Other Filings In the District Court

Petitioner has taken other statements made by PO and its expert out of context. Before getting into those statements, it is important to note that the context of those statements is grounded in the specification of the '845 Patent, which explains:

The subscriber may have access to a bank account, or may be an unbanked subscriber. The subscriber has a profile 211 with the monetary transaction system 210. The profile includes the subscriber's KYC information, as well as any associated bank accounts, credit union accounts, bill pay accounts or other accounts. Ex. 1001, 13:66-14:4 (emphasis added).

The “profile” is recited in the claims¹ and permits the platform to differentiate between a subscriber having a profile with an associated bank account and one whose profile lacks any associated bank account. In this context, a subscriber whose profile lacks an associated bank account may appear “unbanked” even if the subscriber actually has a bank account because the existence of such a bank account is unknown to the platform. PO’s expert explained this point during his deposition:

Q. Okay. Now, the last sentence of this Paragraph 47 reads, “Thus, Dr. Chatterjee’s proposed construction is at odds with the ’845 patent specification that indicates that an unbanked subscriber may have a bank account.”... Do you agree with this statement in your previous declaration?

A. Yeah, ... -- there’s a point here that an unbanked subscriber in the context of the ’845 patent could be one that has -- that has not disclosed whether they have a bank account; that is, from the point of view of the mobile financial system, it doesn’t know that the subscriber has a bank account. ...

Q. So sitting here today, can you reconcile that you say in Paragraph 47 “an unbanked subscriber may have a bank account” [as read], and the Board says an unbanked subscriber is one who does not have a bank account; right?

A. Right.

Q. Can you reconcile those two statements?

A. Well, just as I was saying, from the perspective of the mobile financial service, this could be a subscriber that has a bank account, but that has not disclosed it, which is what this sentence was referring

¹ See, e.g., Claim 1 (“an unbanked monetary transaction system subscriber that has a profile ...”).

to. That doesn't seem to me to be particularly at odds with the Board's construction. ...

Q. Okay. And so the moment I use my bank account with the mFS system, the mFS system knows that I am banked, right, and the -- from the perspective of the mFS system, I am no longer unbanked; fair?

A. Indeed. (Ex. 1037, 247:10-250:1) (emphasis added).

This testimony is consistent with PO's position that subscribers in Tumminaro -- whose ability to access funds from the pooled bank account is known to the platform -- are "banked" both under the construction advanced in the Petition² and under the express definition found by the Board.³

C. The "Specified Recipient" In Claim 5 Can Have A Mobile Wallet Connected To Credit Cards, Debit Cards Or Bank Accounts

The Reply suggests PO's statement that "***the claimed mobile wallet can have multiple accounts***, including a 'mobile wallet balance,' or accounts connected to ***credit cards, debit cards, or bank accounts***" is inconsistent with arguments advanced by PO. Reply, 3 (emphasis in original). Not so. Claim 5 recites two different mobile wallets: (i) an unbanked subscriber's mobile wallet, and (ii) the

² Pet., 16 ("an unbanked subscriber is one that does not have or have access to a financial institution account.")

³ ID, 11 ("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.")

mobile wallet of a specified recipient who can be banked. specifically, Claim 5 recites:

A monetary transaction system for conducting monetary transactions between unbanked subscribers and other entities, ...
wherein the monetary transaction system is implemented to transfer money between mobile wallets, including performing the following steps:
receiving subscriber communication ... the subscriber communication indicating that an unbanked subscriber desires to transfer a specified amount of funds ... from the subscriber's mobile wallet; ...
validating the status of the specified recipient to ensure the specified recipient has a valid mobile wallet account; ...

Claim 5 does not require the “specified recipient” to be “unbanked.” Instead, the claim permits the “specified recipient” to be banked. As a result, the claimed mobile wallet of a banked specified recipient “can have multiple accounts, including a mobile wallet balance,” or accounts connected to credit cards, debit cards, or bank accounts,” as set forth in PO’s Second Amended Complaint. Ex. 1032, ¶ 20.

D. Judicial Estoppel Has No Place In These Proceedings

Judicial estoppel is an equitable doctrine invoked at a court’s discretion, designed to protect the integrity of the judicial process. *New Hampshire v. Maine*, 532 U.S. 742, 749-50 (2001). The doctrine may be applied to prevent a party from asserting a claim in a legal proceeding that is inconsistent with a position that the party persuaded an earlier court to accept, where the inconsistencies were “calculated to make a mockery of the judicial system.” *Transamerica Leasing v. Inst.*

of London, 430 F.3d 1326, 1335 (11th Cir. 2005). Here, the PO did not persuade the district court that an unbanked subscriber can have a bank account. The district court made no such finding. Moreover, Patent Owner’s position that a subscriber may appear as “unbanked” to the platform if the subscriber has a bank account that is unknown to the platform, is not inconsistent with any position taken by PO herein. Finally, Petitioner does not even allege that PO’s statements “were calculated to make a mockery of the judicial system,” and no evidence exists to support such a finding. Judicial estoppel does not apply.

III. PATENT OWNER’S ARGUMENTS DO NOT EXCLUDE EVERY DISCLOSED EMBODIMENT

A. Petitioner’s Assertion That Every Embodiment Of The ’845 Patent “Holds” Subscriber Funds In A Partner Bank Is Not Pertinent

Petitioner’s argument that “every embodiment of the ’845 patent holds subscriber funds in a partner bank” misses the mark. (Reply, 1) (emphasis added). In the ’845 Patent, the bank account at the partner bank is the “agent company’s bank account,” and an unbanked subscriber cannot access the agent company’s bank account -- only the agent administrator can do that. Ex. 1001, 22:19-22 (“After the agent company’s bank account has been set up, the agent administrator can make deposits into that account”) and 22:46-48 (“When the money is in the agent company bank account, the agent administrator can withdraw the cash by traditional withdrawal means.”) Petitioner has proffered no evidence that an unbanked

subscriber in the '845 Patent owns (“has”) the agent company’s bank account, or can make deposits/withdrawals into/from (“has access to”) the agent company’s bank account. See, e.g., POR, 4-10 (describing transaction flows in '845 Patent where only the agent makes deposits/withdraws into/from the agent company’s bank account). Thus, contrary to Petitioner’s assertion, the express definition identified in the Institution Decision (see note 3, *supra*) does not exclude every embodiment in the '845 Patent specification, because the specification includes numerous embodiments (some of which were described in the POR at 4-10) where an unbanked subscriber neither has, nor has access to, the agent company’s bank account at the partner bank. Petitioner’s characterization of the agent company’s bank account as one that “holds” subscriber funds in no way diminishes the fact that the subscriber neither has, nor has access to, the agent company’s bank account.

The Reply (at 8) offers attorney argument that “all mFS subscribers in the '845 patent have access to funds held in master accounts at a partner bank,” citing Ex-1003, ¶ 65; Ex-1001, 11:56-12:21, 11:17-23, 16:14-38, 17:9-27, 10:17-26. None of these citations demonstrate that an unbanked subscriber in '845 Patent can access the agent company’s bank account (e.g., make deposits/withdrawals). By contrast, in Tumminaro, all subscribers can access the pooled bank account using, e.g., an

ATM.⁴ In this regard, the testimony of Patent Owner’s expert that Tumminaro “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” stands unrebutted - as Petitioner’s expert chose not to submit a Reply declaration in these proceedings. Ex. 2007, *e.g.*, ¶¶ 57-60 and 63-65.

B. Ample Authority Supports Excluding Embodiments That Are Inconsistent With The Claim Language

Petitioner is incorrect to allege that “Fintiv provides no support whatsoever ... justifying the exclusion of any disclosed embodiment.” (Reply, 10). As explained in the POR, during the prosecution history, the Patent Owner limited claim 15 -- which was applicable to both banked and unbanked subscribers -- to a withdrawal by an unbanked subscriber. At the same time, the Patent Owner added seven additional recitations of “unbanked” to claim 1. POR, 10-14. The Applicant subsequently filed continuations covering embodiments applicable to all subscribers (including banked subscribers). *Id.*, Exs. 2011-2013. The Reply does not address the Court’s finding in *Sinorgchem Co. v. ITC*, 511 F. 3d 1132, 1138 (Fed. Cir. 2007) that “[w]here, as here,

⁴ Citing Ex-1037 at 227:14-228:1, 228:15-19, the Reply at 23-24 falsely alleges that “Fintiv admitted ATM access is optional in Tumminaro.” The transcript does not say that. Citing Ex-1037 at 243:3-24, the Reply at 24-25 also falsely alleges that “Fintiv’s expert confirmed that” a particular passage of Tumminaro “relates to a no-card user, *i.e.*, “unbanked user.” (emphasis added). Again, the transcript does not say that a no-card user is an unbanked user.

multiple embodiments are disclosed, we have previously interpreted claims to exclude embodiments where those embodiments are inconsistent with unambiguous language in the patent’s specification or prosecution history.” POR, 21-22. The Reply fails to even acknowledge -- let alone distinguish -- the other cited decisions cited in the POR holding that the claims need not cover all disclosed embodiments. *See*, POR, 22.

IV. THE BOARD ERRED IN LIMITING AN UNBANKED SUBSCRIBER TO ONE NOT HAVING OR HAVING ACCESS TO A TRADITIONAL BANK OR CREDIT UNION ACCOUNT

In the Institution Decision, the Board found that the specification set forth an explicit definition of “unbanked subscriber” with “reasonable clarity, deliberateness, and precision,” -- “[a]n ‘unbanked subscriber is a subscriber that does not have (or does not have access to) a bank account or credit union account.” (ID, 10-11, *citing* Ex. 1001, 12:25-27). Nonetheless, the Board applied a different definition in its analysis, 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. POR, 16-18. Petitioner does not dispute the Board’s finding that the specification included a definition of “unbanked subscriber” was

clear and precise.⁵ Under Federal Circuit precedent, where a court finds that the patentee clearly and with precision explicitly defined a term in the specification, that definition controls and cannot be altered. See, e.g., *Martek Biosciences Corp. v. Nutrinova*, 570 F.3d 1363, 1380 (Fed. Cir. 2009); *Vitronics Corp. v. Conceptronic*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) and *Sinorgchem Co. v. ITC*, 511 F.3d 1132, 1138 (Fed. Cir. 2007); POR, 19-20.

The Reply identifies two decisions where courts looked to extrinsic evidence when the inventor acted as a lexicographer. In contrast to the present findings, the definition in the specification in those cases was neither clear nor precise. In *Nestle USA v. Steuben Foods*, 686 F. App'x 917, 919 (Fed. Cir. 2017), the specification defined “the term ‘aseptic’ as the United States’ FDA level of aseptic.” Neither party argued that this definition was clear or precise, and the Court made no such finding. Similarly, in *Baxter Healthcare v. Mylan Labs.*, 346 F. Supp. 3d 643, 655-656 (D.N.J. 2016), the definition in the specification included the phrase “state of sterility” -- which the court found to be ambiguous. *Id.* at 657. Petitioner has identified no authority that would permit alteration of an express definition set forth with “reasonable clarity, deliberateness, and precision” as found by the Board.

⁵ The Reply (at 10) asserts that “there is a dispute ... over the meaning of ‘have access to a bank account or credit union account.’” However, Petitioner does not identify any aspect of the quoted phrase as ambiguous.

A. The Intrinsic Record Is Devoid Of Evidence That Would Support Limiting An “Unbanked Subscriber” To One That Does Not Have (Or Have Access To) A “Traditional” Bank Account

It is undisputed that the intrinsic record is devoid of any evidence that would support limiting an “unbanked subscriber” to one that does not have (or does not have access to) a “traditional” bank or credit union account. With respect to extrinsic evidence, Petitioner has offered no expert testimony to support limiting an “unbanked subscriber” to one lacking a “traditional” bank or credit union account.

The Reply does not even attempt to defend the Board’s reliance on the statement from Petitioner’s expert that “unbanked” refers to “individuals that cannot get accounts at traditional financial institutions” (*Id.* at 23). As pointed out in the POR (at 18-19), this statement uses the adjective “traditional” to describe traditional financial institutions. It does not suggest that within a traditional financial institution there are “traditional” and “non-traditional” bank accounts.

Without support from its expert or any intrinsic evidence, Petitioner seeks to import the adjective “traditional” into the construction of “unbanked subscriber” based on citations to several articles. Reply, 11. None of these articles support limiting the claimed “unbanked subscriber” to someone lacking a “traditional” bank account: Exs. 1031 and 1049 are dated in 2019 and 2017, respectively, years after the ’845 Patent; Exs. 1020 and 1022 do not refer to unbanked persons in the context of “traditional” bank accounts; Ex. 1025 refers to “formal financial institutions” and

fails to distinguish between “traditional” and “untraditional” accounts at such institutions; Ex. 1043, 2 (Moneycard) states “This Card is issued by GE Money Bank” which means it is a bank account; and Ex. 1047 is a white paper written by CGAP -- not US law.

B. *Gillette* Does Not Permit Intrinsic Evidence To Be Cast Aside Based On A Party Admission

Petitioner cites *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1374 (Fed. Cir. 2005), suggesting that the Board is free to cast aside an express definition based on a party admission. Reply, 9. As explained above, PO has not “admitted” that unbanked subscribers are limited to those having (or having access to) traditional bank accounts. Moreover, in *Gillette*, the Court’s construction was based on a detailed analysis of intrinsic evidence. *Id.* at 1589-1592. After analyzing the intrinsic record, the Court noted that the alleged infringer’s admission before the EPO also supported the Court’s position. *Gillette* does not hold that where, as here, the Board has analyzed the intrinsic record and found an explicit definition with “reasonable clarity, deliberateness, and precision,” the Board is free to disregard that intrinsic evidence based on a party admission (even if one existed, which it does not).

V. PETITIONER HAS FAILED TO DEMONSTRATE THAT TUMMINARO DISCLOSES AN “UNBANKED SUBSCRIBER” UNDER ANY OF THE CONSTRUCTIONS ADVANCED HEREIN

In the Institution Decision, the Board found that “Tumminaro’s unbanked subscriber is capable of accessing both a pooled account” ID, 27. This finding is undisputed by the Reply. Also undisputed is the fact that Tumminaro’s pooled account is a bank account. See, e.g., Ex. 1005, [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.”) Based on these undisputed facts, the Board must conclude that Tumminaro fails to meet the “unbanked subscriber” limitation in the ’845 Patent under the construction advanced in the Petition⁶ and under the express definition found by the Board.⁷

In the event that the Board reverts to its construction limiting an “unbanked subscriber” to one who does not have (or have access to) a “traditional” bank

⁶ Pet., 16 (“an unbanked subscriber is one that does not have or have access to a financial institution account.”)

⁷ ID, 11 (“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.’”)

account or credit union account, the record is devoid of evidence demonstrating that Tumminaro's pooled accounts (which were in the prior art) are "untraditional" bank accounts. The Reply asserts that "there is no evidence in Tumminaro that an individual account for a carded user is a "traditional" bank account other than Fintiv's say-so." Reply, 20. Conversely, there is also no evidence that such an account is an "untraditional" bank account -- a fact which Petitioner bears the burden of proving.⁸ Petitioner's attorney argument in the Reply that "[t]his pooled prepaid debit account is also not a traditional bank account" (Reply, 21) is not supported by the testimony of Petitioner's expert or any other citation, and is not evidence. Thus, even under a construction requiring the absence of a "traditional" bank account, Petitioner has failed to carry its burden to demonstrate that Tumminaro's bank accounts were "untraditional" as of the priority date of the '845 Patent.

⁸ As a prerequisite, Petitioner would have needed to specify what the term "traditional" bank account meant to a POSITA at the time of the '845 Patent. Patent Owner's expert -- the only expert who offered testimony on the topic -- testified that terms like "traditional financial services" and "conventional banking products" are ambiguous and lack any precise definition. Ex. 1037, 240:23-241:4; *see also id.*, 138:24-139:4.

VI. THE REPLY FAILS TO DEMONSTRATE THAT *SUPERGUIDE* IS INAPPLICABLE

A. A Limit Check Is One Instance Of A Category Of Limit Checks

Without support from its own expert, the Reply asserts that “‘a velocity check’ and a ‘limit check’ are not categories” of criteria. Reply at 16. The specification teaches otherwise. For example, with respect to “limit checks,” the specification provides:

Embodiments of the invention can perform Anti-Money Laundering (AML) and Combating the Financing of Terrorism (CFT) checks. ... Transaction 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. Ex. 1001, 29:8-19 (emphasis added).

The specification teaches the transaction limits are “fully configurable” for different use cases. Clearly, “a limit check” (as recited in Claim 1) represents one instance from a category of “fully configurable” checks rather than “an individual parameter having only one value” as was the case in *Apple, Inc. v. Evolved Wireless LLC*, No. IPR2016-01177, 2017 WL 6543970, at *4 (P.T.A.B. Dec. 20, 2017) (finding that “a size of information to be transmitted by the specific UE” is limited to one individual parameter “having only one value” because “[a]t the time a UE initiates a transmission, there is only ... one size of information to be transmitted that is relevant to that particular UE.”) The Reply cites out of context Patent Owner’s statement that “[t]he ’845 Patent refers to “a limit check” in the singular and never

refers to multiple limit checks.” Reply, 16, *citing* POR, 52. That statement refers to examples in the ’845 Patent teaching that one instance of a limit check (from within the category of limit checks) is performed in connection with a particular transaction.

B. A Velocity Check Is One Instance Of A Category Of Velocity Checks

With respect to “velocity checks,” the specification explicitly refers to this category of checks in the plural:

Velocity checks can also be performed. Velocity Checks ensure that subscribers are not abusing the mobile wallet platform within the allowable limits. Ex. 1001, 29:20-22 (emphasis added).

It could not be more clear from the specification that “a velocity check” (as recited in Claim 1) represents one instance from a category of “velocity checks” (plural) rather than “an individual parameter having only one value” as in *Evolved Wireless*.

The Reply cites the deposition testimony of Patent Owner’s expert where he testified that -- in the context of Figure 3 -- that the specification does not describe multiple velocity checks in a single transaction. Reply at 16, *citing* Ex. 1037, 176:9-19. That testimony is completely consistent with the fact that “a velocity check” (as recited in Claim 1) represents one instance from a category of “velocity checks” (plural). See Ex. 1037, 267:9-14 (testifying that that specification refers to velocity in the plural).

C. Petitioner Has Failed To Carry Its Burden Of Demonstrating That SuperGuide Is Inapplicable

In *SIMO Holdings, Inc. v. H.K. uCloudlink Network Tech., Ltd.*, 983 F.3d 1367 (Fed. Cir. 2021), the Court found that “as a matter of ordinary and customary meaning,” the phrase “at least one of” followed by a list of items joined together by “and” applied to each item in the list, not to the list considered as a whole.” *Id.* at 1376-1377 (emphasis added), citing *SuperGuide Corporation v. DirecTV Enterprises, Inc.*, 358 F. 3d 870, 886 (Fed. Cir. 2004). The Petition did not set forth any construction for “performing one or more of a limit check and a velocity check on the unbanked subscriber’s mobile wallet account” in Claim 1, and the Reply lacks any evidence (e.g., no expert declaration or intrinsic evidence) that “a velocity check” and a “limit check” are something other than categories of criteria. Petitioner has thus failed to demonstrate that the Board should deviate from the ordinary and customary meaning of “performing one or more of a limit check and a velocity check on ...” which requires both a limit check and a velocity check.⁹

⁹ In *Power-One, Inc. v. Artesyn Techs., Inc.*, No. CIV.A. 2:05CV463, 2007 WL 896093, at *41 (E.D. Tex. Mar. 22, 2007), the claim recited “a control unit adapted to determine at least one timing parameter” and elsewhere set forth a list of possible “output data” that recited, *inter alia*, both “turn-on” data and “turn-off” data. Since the claim elsewhere required only one timing parameter, the trial court found it inconsistent to interpret the list to require multiple timing parameters (*i.e.*, “turn on” and “turn off” data). Claim 1 of the ’845 Patent contains no such inconsistency.

VII. THE REPLY FAILS TO DEMONSTRATE THAT THE REQUIRED LIMIT CHECK IS MET BY TUMMINARO AND KEENA

The Petition does not dispute the intrinsic evidence differentiating an agent counting case from a limit check. POR, 48-53. Consistent with the intrinsic record, Patent Owner's expert testified:

There is no check whatsoever on the unbanked subscriber's mobile wallet account when a merchant agent counts physically received cash. Ex. 2007, ¶ 146.

Petitioner's expert did not respond to this testimony. Instead, the Reply advances an attorney argument that "[b]ecause the limit check is performed on funds deposited by an unbanked subscriber *into* his mobile wallet *account* (*i.e.*, by the load agent counting the cash), it is necessarily performed on that user's mobile wallet account." Reply, 25-26 (emphasis in original). Petitioner does not explain why this is "necessarily" the case. The Petition alleged that "[a] merchant load agent will only deposit or top off the amount of cash physically received from the unbanked subscriber." Pet., 65. Thus, according to the Petition, the agent's counting of the cash is simply a prerequisite to the agent's initiation of a deposit transaction. Petitioner has failed to explain why the agent needs to check any information on the mobile wallet account (*e.g.*, information stored about the account in the MFS Platform) in order to count the cash. Thus, Petitioner has failed to carry its burden to demonstrate

that a merchant load agent counting physically received cash is a limit check “on the unbanked subscriber’s mobile wallet account,” as claimed.

Petitioner explored the meaning of a limit check performed “*on the unbanked subscriber’s mobile wallet account*” during the deposition of Patent Owner’s expert, and asked him to provide an example of such a limit check (which he did):

Q. Okay. Can you -- maybe before we go down this rabbit hole, can you give me an example of a limit check that determines whether sufficient funds are available to make the deposit amount in a cash deposit in the '845 patent?

A. Well, if we broaden that a little bit, I can give you a specific real world example, because we were talking about Google Wallet accounts before. Google Wallet has a deposit limit of \$10,000. You’re not allowed to have an account in the U.S. of more than that. Now, I don’t know that Google Wallet accepts cash deposits, but Google Wallet certainly accepts deposits of funds as required by Claim 1. There is a limit, there is a limit check, and that would be used to determine whether or not the deposit could be made.

Q. And so, when you said “let’s broaden that out a little bit,” you broadened it to outside of the '845 patent; fair?

A. No. I was merely replacing with your word “cash” with the word “funds.” Ex. 1037, 188:10-189:5 (emphasis added).

This example comports with the specification of the '845 Patent which states that “[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. Ex. 1001, 29:16-19

(emphasis added). The Reply characterizes this example as “facially untenable” and “illogical” (Reply, 17), but lacks evidence (such as testimony from Petitioner’s expert) or reasoning supporting these assertions.

The Reply states that “Johnson confirmed he did not opine on the obviousness of Ground 3.” Reply, 26. The Table of Contents of Johnson’s Declaration demonstrates the opposite:

XIII. THE PETITION FAILS TO DEMONSTRATE THAT TUMMINARO TEACHES A “LIMIT CHECK” AS RECITED IN CLAIM 1 (GROUND 3).....	61
A. Claim 1 Requires a Limit Check and a Velocity Check	61
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	61
C. The Intrinsic Evidence Demonstrates That the Claimed Limit Check Is Not Met by an Agent Counting Cash Provided by the Customer	62
D. The Petition Has Failed to Demonstrate That the Cited References Teach or Suggest the Limit Check Recited in Claim 1	66

Ex. 2007 at Table of Contents and, *e.g.*, ¶¶ 144-153.

The Reply advances an unsupported that “Tumminaro’s checks are applicable to all transactions” (Reply, 26). No citation is provided to Tumminaro stating as such, nor does the Reply cite testimony from Petitioner’s expert stating that Tumminaro would have been interpreted this way by a POSITA. This attorney argument lacks support and must be rejected. The citations to Tumminaro belatedly advanced for the first time in the Reply (at 26) (i.e., Ex. 1005, [0598] and [0298]) do

not describe the claimed checks in the context of a deposit transaction (as recited in Claim 1).

VIII. CLAIM 5 REQUIRES THE UNBANKED SUBSCRIBER TO SPECIFY/SELECT A PAYMENT METHOD

The Reply paints an incomplete version of the claim language in arguing that Claim 5 does not require “the *unbanked subscriber to specify/select* a payment method from the mobile wallet.” Reply, 13. Below are the claim language and Petitioner’s incomplete version thereof.

<u>Claim Language</u>	<u>Petitioner’s Incomplete Quotation Of Claim Language</u>
receiving subscriber communication ... <u>the subscriber communication indicating that an unbanked subscriber desires to transfer</u> a specified amount of funds to specified recipient <u>using a specified payment method from the subscriber’s mobile wallet;</u>	Claim 5 merely requires “receiving subscriber communication... indicating ...a specified payment method.” Reply 13 (emphasis added).

In the claim language, the “indicating” performed by the “subscriber communication” is that of the unbanked subscriber’s desire to transfer a specified amount of funds ... using a specified payment method.” This makes clear that the “specified payment method” is the one that the subscriber desires.

Uniloc 2017 LLC. v. Netflix, No. 2021-2085, 2022 WL 17688150, at *16 (Fed. Cir. Dec. 15, 2022) is distinguishable. There, the claim language did not connect the

“selected known coding technique” with the user’s desire.¹⁰ Moreover, in *Uniloc*, the Court did not read “selected” out of the claim, finding that “[t]he known coding technique must have been selected at some point -- just not as part of the coding method.” *Id.* By contrast, Petitioner’s position is that no user selection is ever required. Ex. 1003, ¶ 177 (“To the extent that Fintiv argues limitation 5[f] requires that the user specify or select a particular payment method for the transfer, there is nothing in the claim that requires that functionality under the plain and ordinary meaning of its terms.”)

Further, unlike *Uniloc*, Claim 5 performs additional operations on the “selected payment method” that are rendered superfluous by Petitioner’s proposed construction. Specifically, following the recitation of the subscriber communication, Claim 5 recites “validating the status of the selected payment method.” If there were not a selection made by the user, the validating step would be superfluous as the same payment method would always be used.

The Reply provides no evidence disputing that the plain meaning of “select” dictates that there must be *more than one potential payment method available for selection* in the unbanked subscriber’s mobile wallet. POR, 41, citing Ex. 2007, ¶¶ 126-127; Exs. 2004-2006. The conclusory assertion of Petitioner’s expert that “there

¹⁰ The claim in *Summit 6, LLC v. Samsung Elecs.*, 802 F.3d 1283, 1291 (Fed. Cir. 2015) similarly lacked a connection to the user’s desire.

is nothing in the claim that requires that functionality under the plain and ordinary meaning of its terms” is entitled to no weight. *See* Ex. 1003, ¶ 177.

Out of thin air, the Reply suggests (for the first time) that the selected/specified payment method “can be made by virtue of not changing a default payment method.” Reply, 24. Tumminaro makes no mention of a default payment method, nor does Petitioner’s expert. The Reply looks to the testimony of PO’s expert for support (*see* Reply, 24, *citing* Ex. 1037, 195:6-15); however, that testimony was directed to the operation of the ’845 Patent -- not Tumminaro.

Petitioner does not dispute the absence of a “gift card” in Tumminaro (POR, 43), but seeks to fill this gap with citations to Exs. 1017-1018 and 1043 for the proposition that “[various] gift cards, including reloadable” were known. Reply at 25. Significantly, Exs. 1017-1018 and 1043 were not part of the grounds set forth in the Petition or the Institution Decision. *EmeraChem v. Volkswagen Grp.*, 859 F.3d 1341, 1352 (*Fed. Cir.* 2017) (finding APA violation when reference relied upon in final written decision was not a part of the grounds in petition or institution decision.)

IX. FINTIV IS NOT ESTOPPED FROM ARGUING THAT THE “SPECIFIED PAYMENT METHOD” CANNOT INCLUDE CREDIT OR DEBIT CARDS

Based on Patent Owner’s statement that “the claimed mobile wallet can have multiple accounts, including a ‘mobile wallet balance,’ or accounts connected to

credit cards, debit cards, or bank accounts,” the Reply incorrectly maintains that “Fintiv argued that the claims encompass a system where unbanked subscribers may add credit and debit cards to their mobile wallets.” Reply, 15. PO’s quoted statement does not mention “unbanked subscribers” -- rather it refers to the claimed mobile wallet. As explained in Section II(C), in Claim 5 the “specified recipient” can be “banked” and, as a result, the claimed mobile wallet of a banked specified recipient “can have multiple accounts, including a “mobile wallet balance,” or accounts connected to credit cards, debit cards, or bank accounts.” Ex. 1032, ¶ 20. PO’s cited statement does not say that the claims encompass a system where unbanked subscribers add credit and debit cards to their mobile wallets.

X. CONCLUSION

Petitioner has failed to demonstrate that the Challenged Claims are unpatentable.

Respectfully submitted,

Dated: May 16, 2024

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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this Patent Owner's Sur-Reply complies with the type-volume limits of 37 C.F.R. § 42.24(b)(1) because it contains 5,582 words, excluding the parts of this Patent Owner's Sur-Reply 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.

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S SUR-REPLY** was served via email (as consented to by counsel) on May 16, 2024 to lead and backup counsel of record for Petitioners as follows:

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