

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAYPAL HOLDINGS, INC. and PAYPAL, INC.,
Petitioner,

v.

FINTIV, INC.,
Patent Owner.

IPR2023-00744
Patent 8,538,845 B2

Before MICHAEL R. ZECHER and GEORGE R. HOSKINS,
Administrative Patent Judges.

ZECHER, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

I. DISCUSSION

A conference call in this proceeding was held on June 25, 2024, among counsel for the parties and Judges Zecher and Hoskins. The conference call was requested by counsel for Petitioner, PayPal Holdings, Inc. and PayPal, Inc. (collectively, “PayPal”), to seek authorization to file a motion to submit supplemental information. Ex. 3002. More specifically, PayPal indicated its motion would request to submit an appeal brief filed by Patent Owner, Fintiv, Inc. (“Fintiv”), in an appeal to the U.S. Court of Appeals for the Federal Circuit from the Final Written Decision issued in a related proceeding, IPR2022-00976 (the “’976 IPR”). PayPal asserts that the identified Federal Circuit appeal brief makes relevant statements concerning the scope and meaning of the term “unbanked subscriber,” which is at issue in this proceeding. Fintiv arranged for a court reporter and agreed to file a transcript of the conference call as a separate exhibit in this proceeding. *See* 37 C.F.R. § 42.63(a) (“All evidence must be filed in the form of an exhibit.”) We reiterate some of the discussion here, but we need not repeat all of the details because the complete discussion will be reflected in the transcript. Ex. 2015.

During the conference call, PayPal asserted that the Federal Circuit appeal brief in the ’976 IPR was filed after PayPal filed its Reply to Fintiv’s Patent Owner Response to the Petition in this proceeding, but that statements contained therein are relevant here, and so should be considered. In particular, PayPal argued that the Federal Circuit appeal brief provides further evidence, in addition to Fintiv’s statements in a related district court case, showing that Fintiv has made contradictory statements about the scope

and meaning of the term “unbanked subscriber,” vis-à-vis Fintiv’s position on that same term in this proceeding.

In response, Fintiv read a portion of its Federal Circuit appeal brief from the ’976 IPR during the conference call, and the parties agreed this was the only portion that referenced the term “unbanked subscriber” in the Federal Circuit appeal brief itself. The parties also agreed that the recited portion of the Federal Circuit appeal brief was from an overview discussion of the challenged patent in the ’976 IPR, U.S. Patent No. 9,892,386 B2 (the “’386 patent”). Fintiv asserted that there is no need to include the Federal Circuit appeal brief from the ’976 IPR in the record of this proceeding because the reference to the term “unbanked subscriber” in the overview of the ’386 patent has little, if any, bearing on how that same term should be construed in this proceeding.

After a brief deliberation, we denied PayPal’s request for authorization to file a motion to submit supplemental information. Under 37 C.F.R. § 42.123(b), a motion to submit supplemental information more than a month after institution of trial must not only “show why the supplemental information reasonably could not have been obtained earlier,” but also that “the consideration of the supplemental information would be in the interests-of-justice.” Although the Federal Circuit appeal brief in the ’976 IPR was filed after PayPal filed its Reply in this proceeding, which explains PayPal’s belated request to file a motion to submit supplemental information, PayPal’s request does not meet the “interests-of-justice” standard.

In our Institution Decision, we preliminarily relied on a lexicographic definition of the term “unbanked subscriber” provided in the patent at issue

in this proceeding, U.S. Patent No. 8,538,845 B2 (the “’845 patent”). *See* Paper 10, 10–12. The ’386 patent is part of a chain of continuations of the ’845 patent and presumably contains the same, or essentially the same, disclosure. But, as the parties acknowledged during the conference call, the claims of the ’386 patent do not recite the term “unbanked subscriber,” nor did we address this term in the Final Written Decision issued in the ’976 IPR. Accordingly, Fintiv’s overview of the ’386 patent in the Federal Circuit appeal brief in the ’976 IPR has marginal, if any, relevance as to how we should construe the term “unbanked subscriber” in the context of the ’845 patent and, therefore, does not satisfy the “interests-of-justice” standard.

II. ORDER

Accordingly, it is hereby:

ORDERED that PayPal’s request for authorization to file a motion to submit supplemental information is *denied*.

IPR2023-00744
Patent 8,538,845 B2

For PETITIONER

Robert N. Kang
Barry K. Shelton
Christopher T. Gresalfi
WINSTON & STRAWN LLP
rkang@winston.com
bshelton@winston.com
cgresalfi@winston.com

Travis Jensen
ORRICK, HERRINGTON & SUTCLIFFE LLP
tjensen@orrick.com

For PATENT OWNER

Jonathan K. Waldrop
John W. Downing
KASOWITZ BENSON TORRES LLP
jwaldrop@kasowitz.com
jdowning@kasowitz.com

Brandon R. Theiss
Daniel H. Golub
VOLPE KOENIG
BTheiss@vklaw.com
DGolub@vklaw.com