

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

M&A VENTURES, LLC, REPAY HOLDINGS CORPORATION,
and REPAY HOLDINGS, LLC,
Petitioners,

v.

AUTOSCRIBE CORPORATION,
Patent Owner.

Case IPR2024-01159
Patent 11,620,621 B2

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.107(a), Patent Owner Autoscribe Corporation submits this Preliminary Response to the Petition in *Inter Partes* Review No. 2024-01159, filed against U.S. Patent No. 11,620,621 (“’621 Patent”) by Petitioners M&A Ventures, LLC, Repay Holdings Corporation, and Repay Holdings, LLC.

A. Overview of the ’621 Patent¹

The ’621 Patent covers methods of and apparatuses for processing payments. At a high level, the claimed invention allows, *e.g.*, a merchant to accept payments on their website from customers, where the payment is facilitated by a third party which gathers the customer’s sensitive financial account information in place of the merchant (so that the merchant can reduce its website’s security requirements and potential liabilities for data loss). To do this, the customer inputs their sensitive financial account information into a form displayed within a window or frame within the merchant’s webpage, which passes the (encrypted) information directly to the third party. This process appears to be a seamless feature of the merchant’s webpage from the viewpoint of the customer, but the form is provided by the third party, and the merchant itself never has access to the sensitive financial account information. The third party stores the information and provides the merchant with a “token” representing the information. The token allows the merchant to reference the customer’s information without having access to it. The merchant can then use the token (in place of the information itself) to request additional payments in the future.

The ’621 Patent contains five independent claims, covering this invention as a method and as an apparatus, both from the perspective of the third party and from the perspective of the

¹ This high-level overview is based on an embodiment from the specification of the ’621 Patent and is purely introductory—it is not intended to be limiting, to describe all claims, or to describe all limitations in any claim.

merchant server. Claim 1 (and its dependent claims 2–7) is a method claim covering this process from the perspective of the third party. Claim 8 (and its dependent claims 9–14) is an apparatus claim covering the third party’s secure server that processes the payment transaction. Claim 15 (and its dependent claims 16–22) is a method claim covering this process from the perspective of the merchant server. Claim 23 (and its dependent claim 24) is an apparatus claim covering the merchant server that processes the payment transaction. Claim 25 (and its dependent claims 26–27) is, like Claim 1, a method claim covering this process from the perspective of the third party.

B. The Petition

The Petition contains only two grounds. There is no overlap between these grounds—Ground 1 challenges only the method claims (Claims 1, 15, and 25, along with their corresponding dependent claims), and Ground 2 challenges only the apparatus claims (Claims 8 and 23, along with their corresponding dependent claims). As such, Petitioners’ likelihood of success hinges on only one ground per claim.

Additionally, Petitioners have largely put their eggs into a single basket: Ground 1, Claim 1. Petitioners raise almost all their arguments in the context of Claim 1 and its dependent claims, and then cross-reference those arguments heavily for the remaining twenty claims. As an example, for Claim 25, Petitioners do not raise a single new argument—they simply reference Claim 1 without modification. Petitioners’ recycling of arguments introduces two significant problems for their likelihood of success: the flaws in Petitioners’ arguments as to Claim 1 carry over to every other claim in the Petition, and Petitioners entirely fail to address several of the limitations that distinguish the later claims from the earlier claims (including at least Claims 5, 13, 20, 21, 25).²

² This problem is discussed in greater detail in Sections III(B)–(G) and IV, below.

C. The Cited References

For ground 1, Petitioners combine *sixteen* references: nine which they purport to be “a series of documents that describe the PayPal Express Checkout Product,” one U.S. Patent, four U.S. Patent Publications, and two other documents which appear to be taken from websites. *See* Paper 4, Petition at 25, 28–72. Ground 2 adds an additional reference, a U.S. Patent Publication. *See* Paper 4, Petition at 94.

Petitioners’ most-cited reference, EX. 1006 (“PayPal Express Checkout Integration Guide”), is a guide for a system which works quite differently than the method of Claim 1.³ In order to piece together even a flawed set of arguments, Petitioners had to entirely rearrange the steps of the primary embodiment from Ex. 1006 and supplement it with the fifteen other documents—and even then, as discussed in Sections III and IV, below, they were unable to show that these references disclosed or rendered obvious at least five distinct elements of Claim 1 (and several more elements of the remaining claims, as well).

D. The Board should exercise its discretion to deny institution of an *inter partes* review

As discussed in detail below, neither of the Petitioners’ grounds shows a reasonable likelihood that even a single challenged claim of the ’621 Patent is unpatentable. Instead, the Petition contains assertions that do not address (or do not adequately address) all the limitations of the challenged claims, that are from disparate references that a person of ordinary skill in the art would not combine (or are from multiple disparate embodiments within a reference), or that rely on references that do not disclose what Petitioners claims they disclose.

³ Patent Owner uses the claim terminology throughout this section for the sake of addressing Petitioners’ arguments, not as an admission that the cited references actually disclose the claim language.

Further, because Petitioners cross-reference their arguments so heavily among the challenged claims while entirely failing to address many of the distinctions among those claims, they have no possibility of success on several of the challenged claims. E.g., even if Petitioners were to succeed on every single limitation that they address, at least Claims 5, 13, 20, 21, and 25 contain unaddressed limitation—and each of these is asserted in the co-pending district court litigation between the parties. *See Autoscribe Corporation v. M&A Ventures, LLC*, Case No. 1:24-cv-04282 (N.D. Georgia), ECF No. 36 (Amended Complaint) at 5 (asserting all claims of the ’621 Patent against Petitioner M&A Ventures, LLC). Because this Petition cannot resolve the parties’ dispute, institution would not serve the just, speedy, and inexpensive resolution of the parties’ dispute, so the Board should exercise its discretion not to institute. *See, e.g., Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (P.T.A.B. March 6, 2019) (denying institution after finding that the petitioner failed to satisfy 35 U.S.C. §312(a) as to one of the five grounds).

II. CLAIM CONSTRUCTION

The ’621 Patent’s claims should be construed as they would be in a district court pursuant to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), rather than being given the “broadest reasonable interpretation.” 37 C.F.R. § 42.100(b). A basic principle of claim construction is that “the words of a claim are generally given their ordinary and customary meaning,” as understood by a person of ordinary skill in the art in question at the time of the invention.⁴ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal quotation marks and citation omitted). This general rule especially holds where the claim terms at issue are straightforward. *See Summit 6, LLC v. Samsung Elec. Co., Ltd.*, 802 F.3d 1283, 1291 (Fed. Cir. 2015) (noting that the

⁴ For the limited purposes of rebutting Petitioners’ claim construction arguments in the context of this Preliminary Response, Patent Owner does not contest the level of ordinary skill in the art proposed by Petitioners.

district court did not err in declining to construe a term when the term was straightforward); *see also CallWave Commc'ns, LLC v. AT&T Mobility, LLC*, 2014 WL 7205657, at *9 (D. Del. 2014) (finding construction unnecessary where a claim term “uses ordinary English words, which may be given their plain and ordinary meaning.”).

There are “only two exceptions to [the] general rule” of plain and ordinary meaning: “1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of the claim term either in the specification or during prosecution.” *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1365 (Fed. Cir. 2014) (quoting *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)). To change the meaning of a claim term, ***the redefinition or disavowal must be “clear” and “unmistakable.”*** *See GE Lighting Solutions, LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1309 (Fed. Cir. 2014) (To act as his own lexicographer, the patentee must “clearly set forth a definition of the disputed claim term” and “clearly express an intent to define the term.”); *see also Home Diagnostics, Inc. v. Lifescan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004) (“Absent a clear disavowal or contrary definition in the specification or the prosecution history, the patentee is entitled to the full scope of its claim language.”). “Where an applicant’s statements are amenable to multiple reasonable interpretations, they cannot be deemed clear and unmistakable.” *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326 (Fed. Cir. 2013).

As discussed below, Petitioners entirely fail to point to any evidence that the Patent Owner has acted as its own lexicographer or that the Patent Owner has disavowed the full scope of the terms that Petitioners seek to construe. Rather, Petitioners are trying to force a set of overly-broad constructions in an attempt to capture their cited references. Because neither of the *Golden Bridge*

exceptions apply in this case, the Board should decline to construe these terms. Instead, “plain and ordinary meaning” is proper.

A. “providing a non-sensitive electronic data token representing the sensitive financial account information to the merchant... without providing the non-sensitive electronic data token to the payer”⁵

Petitioners’ proposed construction adds a single phrase to the claim language: “**during execution of the token retrieval function**, providing a non-sensitive electronic data token representing the sensitive financial account information to the merchant ... without providing the non-sensitive electronic data token to the payer.” Paper 4, Petition at 11 (modifying Elements [1.4.1] and [8.2.1.8.1]). Petitioners’ intent is apparently to broaden the claim scope by mitigating this limitation—such that providing the non-sensitive electronic data token to the payer is only a bar to anticipation if it occurs during the portion of the art that Petitioners deem to be the “token retrieval function.” Petitioners’ arguments fail for several reasons.

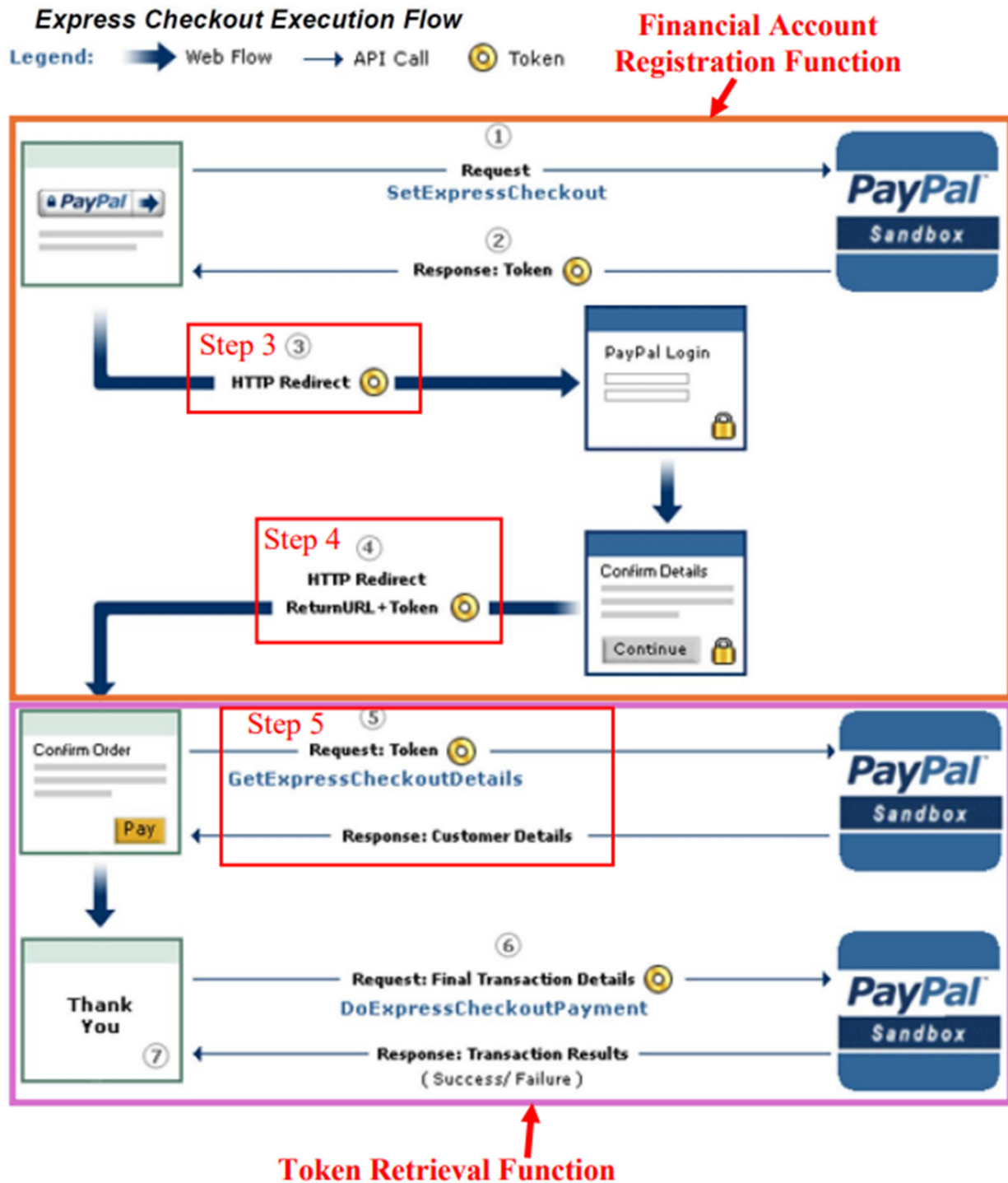
1. The Board need not construe this term, because construction would not impact validity.

As a preliminary matter, the Board need not construe this term, because Petitioners’ references do not disclose this limitation *regardless of how it is construed*. See *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”); see also *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs.* in an IPR context). In Petitioners’ primary reference for both grounds, the alleged token is provided to the payer *more than once* in the cited references—

⁵ Patent Owner uses the claim terminology throughout this section for the sake of addressing Petitioners’ arguments, not as an admission that the cited references actually disclose the claim language.

including during what Petitioners have identified as the token retrieval function and also during another portion of the cited method (which Petitioners attempt to avoid by manipulating the borders of their alleged token retrieval function). Specifically, as discussed in greater detail below,⁶ the alleged non-sensitive electronic data token in Petitioners' primary reference is provided to the payer at least at Steps 4 and 6 in the following diagram from Ex. 1006 (which Petitioners have annotated):

⁶ See Section III(A)(5), below (discussing Element [1.4.1]).



Paper 4, Petition at 37 (citing and annotating Ex. 1006 at 24). Petitioners dispute (incorrectly, as discussed below) that the alleged non-sensitive electronic data token is provided to the payer at Step 6, but Petitioners do not address the fact that it is also provided at Step 4. And as discussed

below, to the extent that the cited references *do* disclose a token retrieval function, it would include Step 4—Petitioner’s annotated boundaries of the token retrieval function are incorrect; they have been manipulated to avoid Step 4.⁷ In short, for at least two reasons, Petitioners’ references do not disclose this limitation *regardless of how it is construed*, so the Board need not construe it. *Nidec Motor*, 868 F.3d at 1017.

2. Petitioners’ argument based on the claim language—that the “without providing the [token] to the payer” limitation is “specifically delineated in the claim” as part of the token retrieval function—is inconsistent with other claim limitations.

One of the key purposes of ’621 Patent is to allow merchants to process payments without bearing the security requirements and potential liability that come with gathering customers’ sensitive financial account information. A claim construction argument that would gut this benefit must be viewed skeptically. But Petitioners’ “delineation” argument does just that.

Specifically, one of Petitioners’ main arguments in favor of their proposed construction is as follows:

“Claim 1 separately recites that ‘executing a token retrieval function, upon initiation by the merchant server via the API’ ([1.4]) includes the step of ‘providing a non-sensitive electronic data token ... to the merchant...without providing the non-sensitive electronic data token to the payer...’ ([1.4.1]). Thus, *as specifically delineated in the claim*, providing the token ‘without providing the non-sensitive electronic data token to the payer’ is performed during execution of the token retrieval function. Ex.1003, ¶54.”

Paper 4, Petition at 12 (emphasis added). This argument does not make sense if one looks at the language that Petitioners trim out with their ellipses:

“providing a non-sensitive electronic data token representing the sensitive financial account information to the merchant server *without providing the*

⁷ See Section III(A)(5), below (discussing Element [1.4.1]).

sensitive financial account information to the merchant server and without providing the non-sensitive electronic data token to the payer; and”

Element [1.4.1] (emphasis added). If Petitioners’ “delineation” argument holds up regarding the “non-sensitive electronic data token,” then it would also apply to the similarly situated language regarding the “sensitive financial account information,” such that the sensitive financial account information was also only not provided to the merchant server “during the token retrieval function.”

In other words, if Petitioners’ arguments as to the construction of this term are correct, then it would only make sense to apply it to the whole term. Petitioners cannot excise the beginning and end of the claim term and give them a different meaning from the language in the middle. Such a construction would clearly be a ridiculous result, as it would undermine a key purpose of the ’621 Patent—to *never* provide the sensitive financial account information to the merchant. For that same reason, a POSITA would not construe the claim language in the manner that Petitioners propose.

3. Petitioners’ proposed construction is inconsistent with the prosecution history.

Petitioners’ proposed addition of the phrase “during the token retrieval function” to this term adds an unsupported temporal relationship between the “token retrieval function” and the “without providing the non-sensitive electronic data token to the payer” limitation. The prosecution history demonstrates that this is improper—the terms were prosecuted separately, without dependency on each other.

Specifically, the “without providing the [token]” limitation has been in the claim language since early in the prosecution history, but the “token retrieval function” was not added until much later—in an examiner amendment dated February 22, 2023. *Compare* Ex. 1002 at 25 (an examiner amendment adds the Element [1.4] language discussing the “token retrieval function” to Claim 1)

with Ex. 1002 at 584 (the “without providing the [token]” language of [1.4.1] far predates the Examiner amendment, *e.g.*, by September 9, 2021). As can be seen from the prosecution history, the token retrieval function and the “providing . . . to the payer” term are each prosecuted separately with no relationship with each other, showing that there is no underlying “during the token retrieval function” limitation to the “providing . . . to the payer” term.

Patent Owner also notes that Petitioners’ prosecution history disclaimer argument is backwards, because it is *Petitioners* who are trying to broaden the scope of claim 1 (to help their invalidity arguments), not Patent Owner. That is, by constraining this limitation (“without providing the non-sensitive electronic data token to the payer”) by stating that it only applies “during the token retrieval function,” Petitioners’ construction would broaden the claim scope. Petitioners’ argument is based on the opposite situation—where a patent owner is trying to broaden the claim scope. *See* Paper 4, Petition at 13 (arguing that an “amendment that clearly narrows the scope of a claim, such as by the addition of a new claim limitation, constitutes a disclaimer of any claim interpretation that would effectively eliminate the limitation or that would otherwise *recapture the claim’s original scope.*”) (citing *Schindler Elevator Corp. v. Otis Elevator Co.*, 593 F.3d 1275, 1285 (Fed. Cir. 2010)).

For the above reasons, the Board should decline to construe the disputed term “providing a non-sensitive data token to the merchant . . . without providing the non-sensitive data token to the payer.”

B. “receiving the non-sensitive electronic data token from the secure server, wherein...the secure server does not provide the non-sensitive electronic data token to the payer”

The second term that Petitioners seek to construe is similar to the first term (though it is from the merchant server’s perspective, rather than from the secure server’s perspective), and Petitioners propose to add the same phrase (“during execution of the token retrieval function”)

here as well.⁸ As such, the arguments made above apply here as well, and Petitioners’ improper addition to this term is improper and should be rejected.

Petitioners do raise one new argument for this claim term, but it is based on a misunderstanding of the prosecution history. Petitioners compare Element [15.6.3] with Element [15.8] and argue that “claim 15 specifies that the *financial account information* is not sent to the merchant server both during the financial account registration function and during the token retrieval function. [...] In contrast, the claim only requires ‘the secure server does not provide the *non-sensitive electronic data token* to the payer’ during the token retrieval function.” Paper 4, Petition at 16 (emphasis added).

The reason Petitioners did not raise this argument for the first term is apparent from a comparison of Claim 1 to Claim 15—Claim 1 is missing this limitation for the “financial account information” in the element corresponding to Element [15.6.3]:

Element [1.1.5.4]

outputting instructions to the payer computing system, in response to the HTTP request for the generated URL, to encrypt the sensitive financial account information provided by the payer and transmit the encrypted financial account information to the secure server via the secure socket layer connection;

Element [15.6.3]

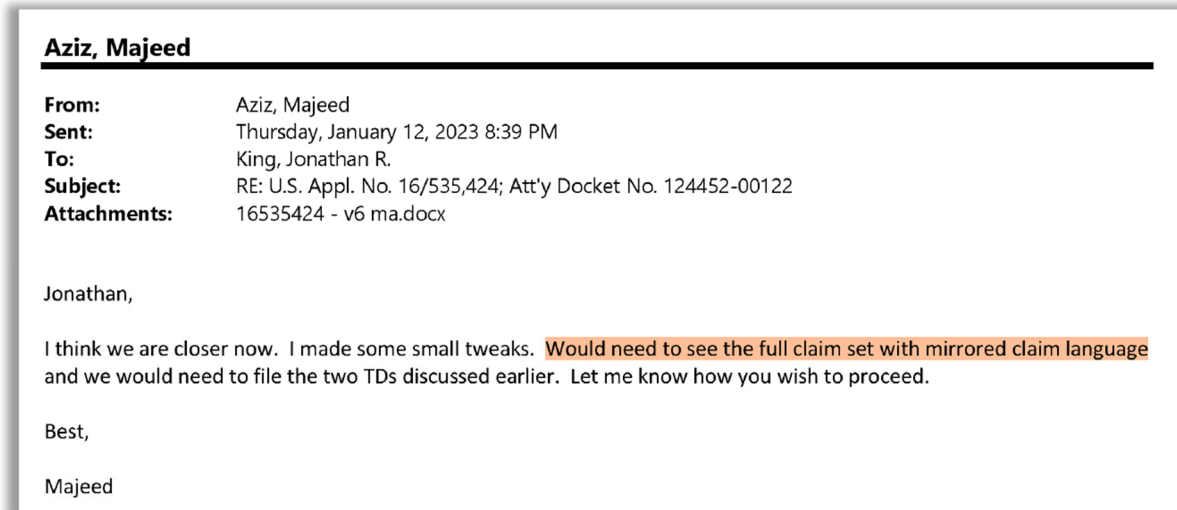
outputting instructions to the payer computing system to encrypt the sensitive financial account information provided by the payer and transmit the encrypted financial account information to the secure server, via the secure socket layer connection, **without providing the sensitive financial account information to the merchant server;**

(emphasis added). If Petitioners’ argument is correct as to Claim 15, then it would imply that Claim 1 (which lacks this limitation in Element [1.1.5.4]) permits “providing the sensitive financial account information to the merchant server,” *so long as it did not happen during the financial*

⁸ This term appears in Elements [15.8] and [23.2.8] (though it is somewhat reworded in the latter).

account registration function. But as discussed with regard to the first term, above, this is a nonsensical result.

The discrepancy that forms the basis of Petitioners’ argument arose in an examiner amendment to the claim language at the end of the prosecution history. *See* Ex. 1002 at 25, 33 (February 28, 2023 amendment, striking this limitation from the proposed claim language that became Element [1.1.5.4], but **adding** it into the proposed claim language in what became Element [15.6.3]). It appears that this difference between the claims was unintentional—Claim 15 was supposed to have “mirrored claim language”:



Ex. 1002 at 168 (January 12, 2023 email from the Examiner to prosecution counsel, showing that claim 1 was prosecuted first before the full claim set).

Aziz, Majeed

From: King, Jonathan R. <jonathan.king@blankrome.com>
Sent: Thursday, February 2, 2023 4:42 PM
To: Aziz, Majeed
Subject: RE: 16535424
Attachments: 124452-00122 Full Claim Set 2023-02-02(130485464.1).docx

CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Majeed:

I spoke to my client and they have authorized me to amend claim 1 as we discussed. Attached is a full claim set. Note that:

- The merchant-side claims (31 and 46) recite the feature of claims 4-5 you identified: “generating a payment transaction instruction, using the token retrieval function of the API, ...”
- The only differences between independent claims 48 and 1 are as follows:

establishing the secure socket layer connection, in response to an HTTP request received from the merchant server for the generated URL, between the secure server and the payer computing system within a window or frame that is displayed within the webpage provided by the merchant server;

I will file a terminal disclaimer tomorrow.

I am available if you wish to discuss.
Jonathan

Ex. 1002 at 197 (February 2, 2023 email from prosecution counsel to the Examiner, showing that claim 1 was prosecuted first before mirroring to other claims). *See Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1354 (Fed. Cir. 2003) (“We hold that a district court [can act to correct an error in a patent by interpretation of the patent where no certificate of correction has been issued] only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.”).

For the above reasons, the Board should decline to construe “receiving the non-sensitive electronic data token from the secure server, wherein...the secure server does not provide the non-sensitive electronic data token to the payer.”

C. “generating a uniform resource locator (URL), ... the URL comprising either: a dynamic URL generated by the secure server...; or a static URL and a hypertext transport protocol (HTTP) parameter...”

As discussed above, there are “only two exceptions to [the] general rule” of plain and ordinary meaning: “1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of the claim term either in the specification or during prosecution.” *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1365 (Fed. Cir. 2014) (quoting *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)). Petitioners raise no evidence of either of these occurring, so this term should be given its plain and ordinary meaning.

III. PETITIONERS’ GROUND 1 FAILS FOR SEVERAL REASONS

Petitioners’ ground 1 fails for several independent reasons—described below—which impact Petitioners’ arguments as to each of the challenged independent claims and further impact Petitioners’ arguments as to several of the challenged dependent claims.

A. Claim 1

Broadly,⁹ Claim 1 recites a method of processing a payment transaction from a payer to a payee, which enables, *e.g.*, a merchant to accept payments on their website from payers, where the payment is facilitated by a third party secure server which handles the gathering financial account information from the payer (so that the merchant can reduce its website’s security requirements and potential liabilities for data loss). Claim 1 focuses on the perspective of a third party “secure server.” Petitioners fail to show that the prior art teaches or renders obvious several key elements of this method, including the following elements:

⁹ This high-level overview of Claim 1 and its key elements is purely introductory—it is not intended to be limiting, to describe all claim elements, or to describe all limitations in any element.

Element [1.1.3] requires receiving, from the merchant server, a data element associated with the payer and a payment amount. Elements [1.1.5.1]–[1.1.5.4] then require generating a URL for establishing a secure connection between the secure server and the payer computing system; establishing the connection in a frame or window displayed within the webpage provided by the merchant server; outputting instructions to the payer computing system to render (within the window or frame) a form into which the payer can enter sensitive financial account information; and outputting instructions to the payer computing system to encrypt the provided information and transmit it to the secure server. Element [1.4.1] then requires providing a “non-sensitive electronic data token representing the sensitive financial account information” to the merchant server. The sensitive financial account information must not be provided to the merchant server and the token must not be provided to the payer. Later claims and elements describe how the token can be used for making payments.

1. Element [1.1.3]: Petitioners fail to show that Ex. 1006 teaches or renders obvious that that the “data element” is received “from the merchant server” or that it is “associated with the payer.”

Element [1.1.3] requires that the API provided by the one or more secure servers “receives, from the merchant server via the API, at least one data element associated with the payer and a payment amount from the payer to the payee.” To borrow an example from dependent Claim 5, this “data element associated with the payer” could be something like a “customer identification number generated by the merchant server to identify the payer.”

Petitioners rely exclusively on Ex. 1006 for the disclosure of this element, *see* Pet. at 38–40, but this fails for at least two separate reasons: first, Ex. 1006 works in the opposite direction

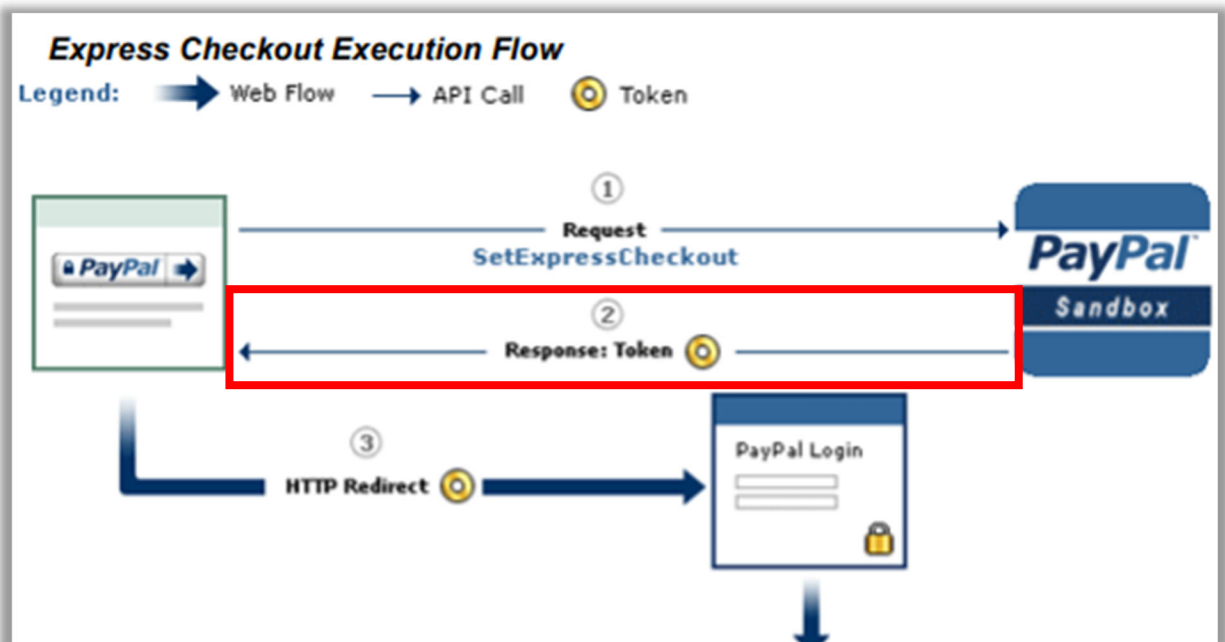
from the claim language (Ex. 1006's "data element"¹⁰ is received *by* the merchant servers *from* the API provided by the secure server); second, Ex. 1006's "data element" is not "associated with the payer."

a. Ex. 1006 works in the opposite direction from Element [1.1.3]

Regarding the first flaw, the claim language is very clear about the direction of this element: the API provided by the one or more secure servers must receive the "data element associated with the payer" *from* the merchant server. For the claimed "data element," Petitioners rely on Ex. 1006's "token."¹¹ See Paper 4, Petition at 38–39. But among other issues with relying on Ex. 1006's "token" for the disclosure of the claimed "data element" is that in Ex. 1006, the "token" is *generated by PayPal, and sent by PayPal to the merchant server*. See Ex. 1006 at 22–24. This is illustrated in the following diagram from Ex. 1006:

¹⁰ Patent Owner uses the claim terminology throughout this section for the sake of addressing Petitioners' arguments, not as an admission that the cited reference actually discloses the claim language.

¹¹ Ex. 1006's "token" is distinct from the '621 Patent's "token," and Patent Owner understands that Petitioners do not rely on the Ex. 1006's "token" as disclosure of the claimed "token."



Ex. 1006 at 24 (annotated); *see also id.* at 23 (“The pages on the left represent your site.”). At step 2 in Ex. 1006, the “token” is passed *from* the “PayPal Sandbox” (Petitioners’ argued “secure server,” *see* Paper 4, Petition at 42–43) *to* “your site” (Petitioners’ argued “merchant server,” *see id.*). *See* Ex. 1006 at 24; *see also id.* at 25 (“2. [...] PayPal responds with a message [...] which should include [...] a token.”). That is, *Ex. 1006 functions precisely the opposite of Element [1.1.3]*.

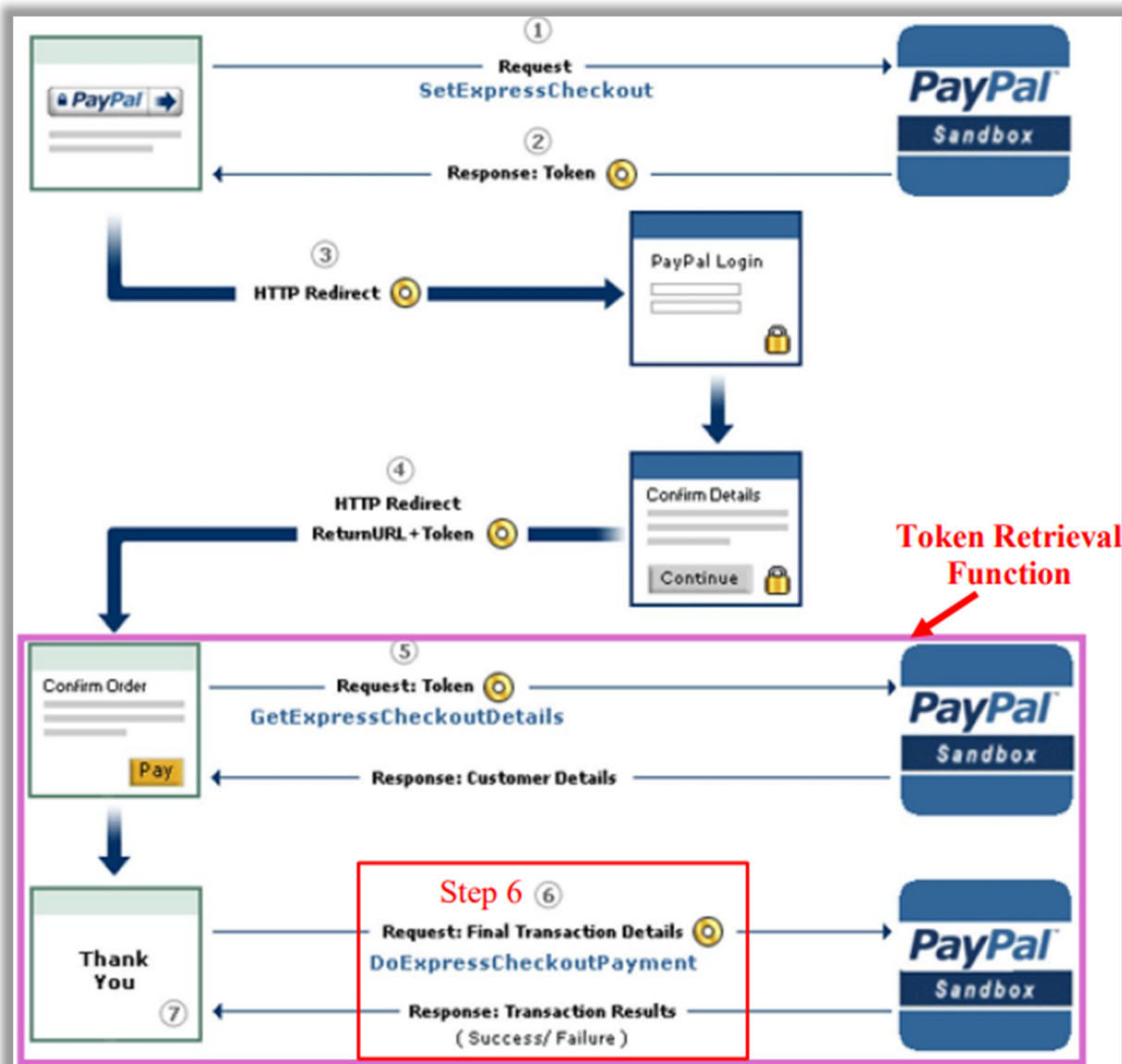
b. Ex. 1006’s “token” is not associated with the payer

Regarding the second flaw, the claim language also requires that the “data element” must be “associated with the payer.” But Ex. 1006’s “token” is not associated with the payer—rather, it is “a value *assigned by PayPal*,” before PayPal has any information about the payer. Ex. 1006 at 16; *see also* Ex. 1006 at 24–25 (describing steps 1 and 2 and showing that PayPal has no information about the payer at this point). Petitioners’ argument does not address this shortcoming—they simply argue that the token “associates the execution of the API [...] with a specific instance of a user experience flow” (and thus it is “associated with the payer”). Paper 4,

Petition at 38. But not only is being associated with a “user experience flow” not the same as being associated with the “user” (payer), but at this point, there is not even any association between the “user experience flow” and the “user.” *See* Ex. 1006 at 25 (showing that in steps 1 and 2, the “user flow” is not associated with the “user”).

c. Petitioners’ arguments regarding the claimed “data element” would moot this limitation.

The fundamental problem Petitioners face for Element [1.1.3] is that their cited references do not disclose “receiv[ing], from the merchant server via the API, at least one data element associated with the payer[.]” Possibly recognizing that Ex. 1006 contains no such disclosure, Petitioners attempt to sidestep these problems by recycling the portion of Ex. 1006 that they also cite for Element [1.4]: step 6 of the method illustrated in Ex. 1006 at 24. This is illustrated in Petitioners’ annotated diagram from their arguments for Element [1.1.3]:



Paper 4, Petition at 39 (citing and annotating Ex. 1006 at 24) (cropped).

The problem with Petitioners’ recycling of step 6 is that, under their interpretation of “data element associated with the payer,” it would be impossible to perform the token retrieval function (including at least Element [1.4]¹²) without also performing the “data element” aspect of Element [1.1.3]. That is, using Petitioners’ interpretation of the term “data element associated with the

¹² Element [1.4] reads: “executing a token retrieval function, upon initiation by the merchant server via the API, by”

payer” (*i.e.*, that a value merely designating “a specific instance of a user experience flow” would suffice), the claimed token retrieval function of Element [1.4] (which requires “initiation by the merchant server via the API” to retrieve the claimed “token”) would necessarily result in the secure server “receiv[ing] ... at least one data element associated with the payer”—because how else would the secure server know which token to return?

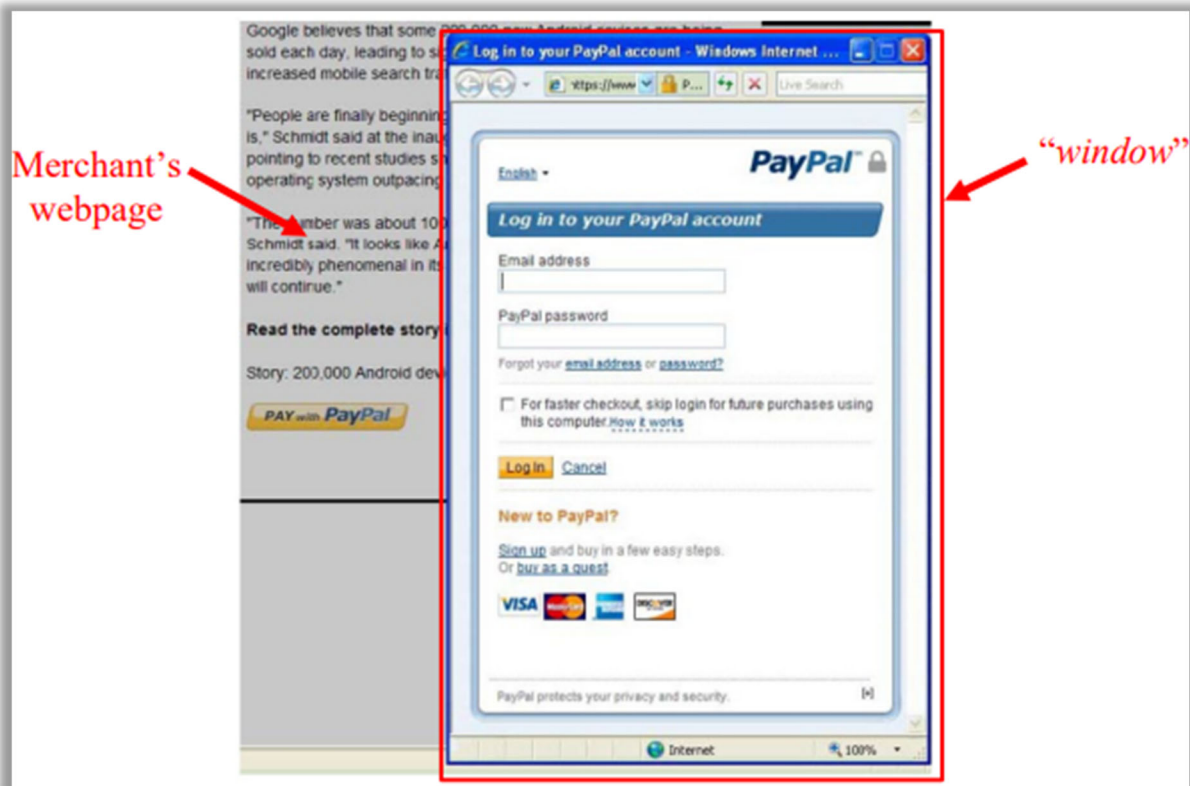
This would moot, or read out, the “data element” limitation of Element [1.1.3]—an improper result. *See Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (explaining that to read limitations out of a claim would “be contrary to the principle that claim language should not be treated as meaningless”); *see also Exmark Mfg. v. Briggs & Stratton Corp.*, No. 2019-1878, at *8 (Fed. Cir. Oct. 6, 2020) (same); *Microstrategy v. Bus. Objects*, 238 F. App’x 605, 609 (Fed. Cir. 2007) (“our case law instructs that different claim terms are presumed to have different meanings.”). As such, Petitioners’ argument cannot be correct, and they have failed to show that Ex. 1006 (the only reference they cite for Element [1.1.3]) teaches or renders obvious Element [1.1.3].

2. Elements [1.1.5.2] and [1.1.5.3]: Petitioners fail to show that the art teaches or renders obvious that the “secure socket layer connection” and “financial account registration request form” are established and rendered within a “window or frame that is displayed within the webpage provided by the merchant server.”

Element [1.1.5.2] requires “establishing the secure socket layer connection [...] within a window or frame that is displayed within the webpage provided by the merchant server.” Similarly, Element [1.1.5.3] requires “render[ing] a financial account registration request form, within the window or frame that is displayed within the webpage provided by the merchant server.” The ’621 Patent’s specification lays out one benefit of doing this within a window or frame that is displayed within the webpage: “If desired, the widget or window may be designed to appear as part of the

merchant's data entry screen [...] so that the process of registering with data stored on two separate servers is seamless from the viewpoint of the customer.” Ex. 1001 at 9:59–64.

Ex. 1006 does not do this—instead, it simply redirects the Buyer's browser to PayPal's log in page. *See* Ex. 1006 at 25. Petitioners do not attempt to argue that this limitation is disclosed in Ex. 1006. Rather, Petitioners rely on Ex. 1012 (The “PayPal Digital Goods Integration Guide”). *See* Paper 4, Petition at 49–50, 55–56. However, the Petition itself illustrates that the argued “window”¹³ of Ex. 1012 is not “displayed within the webpage provided by the merchant server:



Paper 4, Petition at 50 (citing and annotating Ex. 1012 at 12); *see also id.* at 56. As shown in this figure, the argued “window” of Ex. 1012 is not “displayed within the webpage provided by the merchant server”—rather, it is in a separate “mini-browser” which is clearly apart from the

¹³ Patent Owner uses the claim terminology here for the sake of comparison, not as an admission that Ex. 1012 actually discloses the claimed “window or frame” or any other aspect of the claim.

webpage. *See also* Ex. 1012 at 11 (“The DG flow opens the Log in to your PayPal account page ***in a mini-browser***, with a mask over the underlying page”) (emphasis added).

In the context of Element [1.1.5.2] only (that is, for “establishing the secure socket layer connection,” but not for “outputting instructions [...] to render a financial account registration form,” as is claimed in Element [1.1.5.3]), Petitioners make a perfunctory and unsupported argument that additional references disclose the “frame” option in this limitation. *See* Paper 4, Petition at 50 (citing Ex. 1013, “U.S. Patent Publication No. 2010/0094755 to Kloster” and Ex. 1015, “U.S. Patent No. 9,830,596 to Collison et al.”). However, Petitioners fail to show that a POSITA would have combined these references, and Petitioners further failed to even attempt to meet their burden of establishing that these references qualify prior art. *See* Paper 4, Petition at 5, 50, 71, 77 (Neither of the mentions of Ex. 1012 or 1015 mention their priority date); *see also Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008) (A party’s burden to prove anticipation of a patent includes initial burden of showing that the cited art was prior to the filing date of the challenged patent).

3. Element [1.1.5.3]: Petitioners fail to show that the prior art teaches or renders obvious “outputting instructions [...] to render a financial account registration request form, within the window or frame.”

As discussed in the previous section, Petitioners cite only Ex. 1012 for the disclosure of the “within the window or frame [...] server” Sub-element of Element [1.1.5.3], and Ex. 1012 does not teach “outputting instructions [...] to render a financial account registration request form, within the window or frame[,]” as is required by the claim language of this element. *See* Paper 4, Petition at 55–56. Therefore, Petitioners fail to show that the prior art teaches or renders obvious the limitations of Element [1.1.5.3].

However, even if the Board were to go outside the bounds of Petitioners’ arguments and consider Element [1.1.5.2], and even if Petitioners had met their burden of showing the Ex. 1013

and Ex. 1015 were prior art and that a POSITA would have combined them with the other references in Ground 1, Petitioner’s arguments would still fail: Petitioners fail to argue that Ex. 1013 or Ex. 1015 teach or render obvious this limitation.

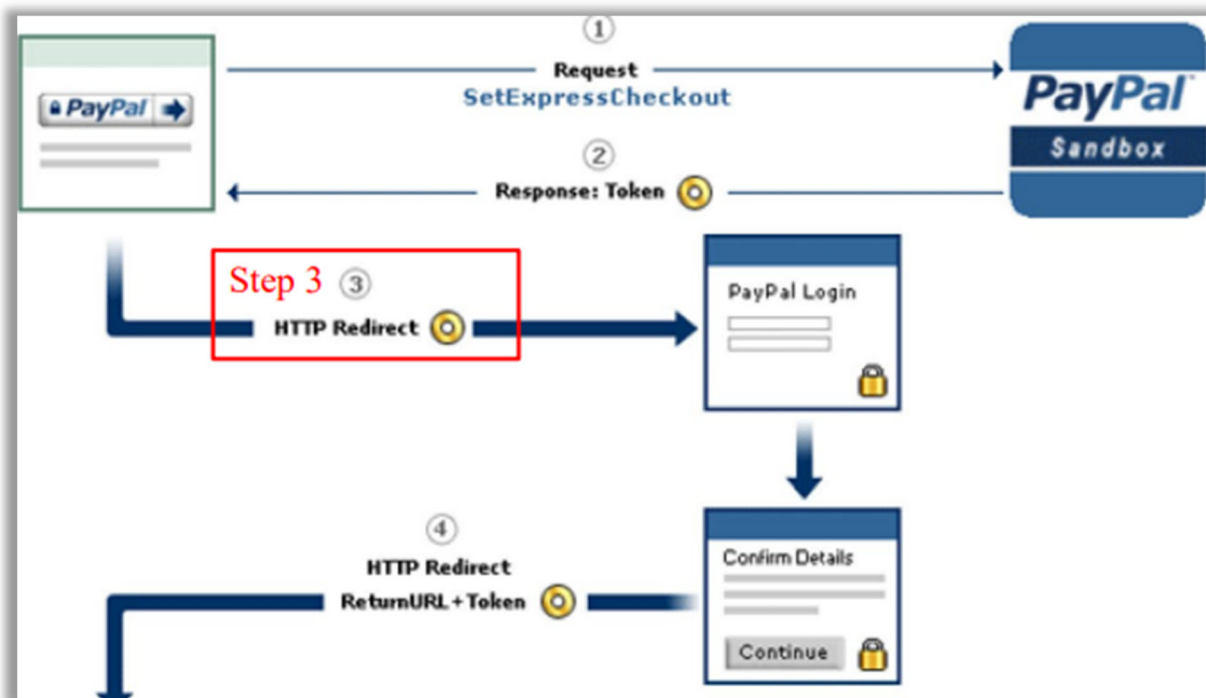
Regarding Ex. 1013, Petitioners provide no explanation as to how or whether the form is rendered within the alleged frame of Ex. 1012, *see* Paper 4, Petition at 50, but the cited portion of Ex. 1012 does not appear to show a form being rendered within a frame—rather, the only mentions of a “form” show that Ex. 1012’s frame is embedded within the merchant’s form, rather than the form being rendered within the frame. *See* Ex. 1012 at [0016] (“[...] providing one or more inline frames 122 for embedding directly in an online merchant’s forms [...]”). Similarly, regarding Ex. 1015, Petitioners provide no explanation as to how or whether the form is rendered within the alleged frame of Ex. 1015, *see* Paper 4, Petition at 50, but the cited portion of Ex. 1015 appears to show that the instructions to render the “Payment Form” are created by the *merchant* and the iframe is separate and apart from this. *See* Ex. 1015 at 8:50–57.

4. Element [1.1.5.4]: Petitioners fail to show that the art teaches or renders obvious “outputting instructions” “to encrypt the sensitive financial account information provided by the payer.”

In its arguments for Element [1.1.5.4], Petitioners again rely on Step 3 in Ex. 1006 (the HTTP Redirect). But Petitioners conflate the *URL* for the PayPal login page¹⁴ with *the instructions that are received from PayPal upon submitting an HTTP request for that URL* (Paper 4, Petition at 58–59). Petitioners do not address the second one (the nature of the instructions received from PayPal), they only address the URL itself—and further, this URL is received from “your site,” not

¹⁴ *See* Paper 4, Petition at 57 (Relying on Step 3, where “the merchant redirects the buyer’s browser to PayPal’s website using a URL including an HTTPS request.”)

from PayPal (as would be required by the claim language or Element [1.1.5.4], which is from the perspective of the secure servers providing an API):¹⁵



Paper 4, Petition at 58 (annotating Ex. 1006 at 24) (cropped); *see also* Ex. 1006 at 23 (“The pages on the left represent your site”). In other words, Petitioners’ citations do not discuss the workings of the form (such as any potential HTTPS connections created within the form itself), rather, *they discuss the connection used to request the form in the first place.*

Or, phrased using the claim language, there is nothing in the Petition that shows “outputting instructions to the payer computing system, *in response to the HTTP request for the generated URL*, to [...] transmit the encrypted financial account information to the secure server via the secure socket layer connection.” Instead, Petitioners focus entirely on “the HTTP request for the generated URL,” but do not show what instructions are output in response to that request. *See*

¹⁵ Patent Owner uses the claim terminology here for the sake of comparison, not as an admission that Ex. 1012 actually discloses the claimed “window or frame” or any other aspect of the claim.

Paper 4, Petition at 57–59. As such, Petitioners fail to show that the prior art teaches or renders obvious the limitations of Element [1.1.5.4].

5. Element [1.4.1]: Petitioners’ cited references do not teach or render obvious this element because Ex. 1006 repeatedly provides the alleged “non-sensitive electronic data token” to the payer.

Element [1.4.1] requires “providing a non-sensitive electronic data token representing the sensitive financial account information to the merchant server without providing the sensitive financial account information to the merchant server and *without providing the non-sensitive electronic data token to the payer.*” For disclosure of the “non-sensitive electronic data token,” Petitioners rely on Ex. 1006’s “Payer ID.” See Paper 4, Petition at 63–64. The reference Petitioners rely on for this element—Ex. 1006—does not meet the claim language of Element [1.4.1], because it describes a method where the non-sensitive electronic data token (the Payer ID) is repeatedly sent to the buyer.

First, the Payer ID is sent to the buyer at Step 4 in Ex. 1006, because it is part of the redirect URL provided by the PayPal Sandbox to the payer:

4. After logging into the buyer test account, confirm the details.

When you confirm, the Sandbox redirects your browser to the return URL you specified when invoking the SetExpressCheckout API operation, as in the following example:

`http://www.YourReturnURL.com/
?token=EC-1NK66318YB717835M PayerID=7AKUSARZ7SAT8`

Ex. 1006 at 25–26 (cropped and annotated). Ex. 1006 explains that if “the buyer approves the payment, PayPal redirects to the success URL with the following information: [...] The buyer’s unique identifier (*Payer ID*).” *Id.* at 17. That is, PayPal provides (via the redirect to the success URL) the Payer ID to the buyer, and so Element [1.4.1] (which requires “providing a non-sensitive

electronic data token [...] to the merchant server [...] *without providing the non-sensitive electronic data token to the payer*") is not met.

Petitioners attempt to avoid this problem by arguing that the claim language only forbids "providing the non-sensitive electronic data token to the payer" "*during* the token retrieval function," and that outside of the token retrieval function, it does not matter whether the non-sensitive data token is provided to the payer. *See* Paper 4, Petition at 66. And as described above, Petitioners try to carve Step 4 out of the "token retrieval function." *See* Paper 4, Petition at 63–64. But, to the extent Ex. 1006 does disclose "a token retrieval function," *Step 4 would be part of the token retrieval function rather than the financial account registration function*. The redirect of Step 3 is initiation of the token retrieval function by the merchant server, and (as discussed above) Step 4 is where the PayPal Sandbox provides the Payer ID (Petitioners' alleged token analog). Petitioners' allocation is unsupportable—to the extent Ex. 1006 discloses "financial account registration" and "token retrieval" functions, the dividing line would be above Step 4, not below it, as Petitioners argue. *See* Paper 4, Petition at 37 (citing and annotating Ex. 1006 at 24).

Second, Petitioners are focusing on *Step 4*, which is only *one* of the instances where Ex. 1006 describes providing the Payer ID to the buyer—as described above, there is more than one instance, so even if the Board were to accept Petitioners' proposed construction, Element [1.4.1] would still not be met. For example, the Payer ID is also sent to the buyer at *Step 6* in Ex. 1006, because it is part of the form that "invokes the DoExpressCheckoutPayment API operation on the Sandbox":

```
<form method=post action=https://api-3t.sandbox.paypal.com/nvp>
  <input type=hidden name=USER value=API_username>
  <input type=hidden name=PWD value=API_password>
  <input type=hidden name=SIGNATURE value=API_signature>
  <input type=hidden name=VERSION value=XX.0>
  <input type=hidden name=PAYMENTREQUEST_0_PAYMENTACTION
    value=Authorization>
  <input type=hidden name=PAYERID value=7AKUSARZ7SAT8>
  <input type=hidden name=TOKEN value= EC%2d1NK66318YB717835M>
  <input type=hidden name=PAYMENTREQUEST_0_AMT value= 19.95>
  <input type=submit name=METHOD value=DoExpressCheckoutPayment>
</form>
```

Ex. 1006 at 27 (discussing Step 6). As such, the Payer ID (which Petitioners point to as the “non-sensitive electronic data token,” *see* Paper 4, Petition at X) is provided to the payer. Step 6 falls within the bounds of what Petitioners point to as the “token retrieval function,” *see* Paper 4, Petition at 64 (because it is done “during execution of the token retrieval function”), so Petitioners have failed to show that Ex. 1006 teaches or renders obvious Element [1.4.1].

B. Claim 5

Element [1.1.3] requires that the API provided by the one or more secure servers “receives, from the merchant server via the API, at least one data element associated with the payer and a payment amount from the payer to the payee[.]” (emphasis added). Claim 5, Element [5.1] elaborates on this element, adding that “the at least one data element associated with the payer is a customer identification number generated by the merchant server to identify the payer.”

Petitioners attempt to add this limitation by relying on a single sentence from a new, unrelated reference, which simply recites storing “a unique customer identifier”—Petitioners do not even attempt to argue that Ex. 1013 discloses “receiving” this identifier. *See* Paper 4, Petition at 77 (citing Ex. 1013 at [0015]). As such, the Petition fails to establish that the prior art teaches or renders obvious Claim 5.

In arguing that PayPal teaches claim 5, Petitioner cites to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the ‘621 Patent. *See* Ex. 1003, ¶¶ 233, 235-236. The Board has repeatedly cautioned that conclusory, unsupported statements by an expert are entitled to little to no weight. *Tate & Lyle Americas*, IPR2014-00084, slip op. at 17-18; *Kamada, ITD.*, IPR2014-00899, slip op. at 10.

C. Claim 15

Broadly, claim 15 recites a method of enrolling a payer by a merchant server operated by or for the benefit of a payee. Petitioners mostly incorporate by reference their arguments as to Claim 1, and accordingly, Patent Owner incorporates its own corresponding arguments by reference. Specifically, for Elements [15.3], [15.4], [15.6.1], [15.6.2], [15.6.3], [15.7], and [15.8], Petitioners incorporate by reference their arguments for Elements [1.1.3], [1.1.5.2], [1.1.5.3], [1.1.5.4], and [1.4.1], and Patent Owner responds by incorporating its own corresponding arguments in all respects.

In arguing that PayPal teaches claim 15, Petitioner cites to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the ‘621 Patent. *See* Ex. 1003, ¶¶ 252-277. The Board has repeatedly cautioned that conclusory, unsupported statements by an expert are entitled to little to no weight. *Tate & Lyle Americas*, IPR2014-00084, slip op. at 17-18; *Kamada, ITD.*, IPR2014-00899, slip op. at 10.

D. Claim 18

For Claim 18, Petitioners simply cite their arguments for Claim 5, Element [5.1]. *See* Paper 4, Petition at 90. Patent Owner responds by incorporating its own corresponding arguments regarding Claim 5, Element [5.1] in all respects.

In arguing that PayPal teaches claim 18, Petitioner cites to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the ‘621 Patent. *See* Ex. 1003, ¶ 280. The Board has repeatedly cautioned that conclusory, unsupported statements by an expert are entitled to little to no weight. *Tate & Lyle Americas*, IPR2014-00084, slip op. at 17-18; *Kamada, ITD.*, IPR2014-00899, slip op. at 10.

E. Claim 20

For Claim 20, Petitioners simply cite their arguments for Claim 6, Element [6.1]. *See* Paper 4, Petition at 90. But Claim 20 is distinct from Claim 6:

Claim 6:

The method of claim 1, wherein the secure socket layer connection is synchronous or asynchronous with a process, performed by the merchant server, to receive enrollment data ***provided by*** the payer.

Claim 20:

The secure server of claim 8, wherein the secure socket layer connection is synchronous or asynchronous with a process, performed by the merchant server, to receive enrollment data ***from*** the payer.

Petitioners do not attempt to address the distinction between Claim 20 and Claim 6: whether the “enrollment data” received by the merchant server is “provided by” the payer or received “from” the payer. *See* Paper 4, Petition at 90. But in the context of Claim 6, Petitioners appear to argue that in their cited reference, the merchant “obtains information about the buyer ***from PayPal.***” Paper 4, Petition at 77. Because Petitioners merely cross-reference Element [6.1] and entirely fail to address whether the alleged disclosure of this enrollment data is received “from the payer,” the Petition fails to establish that the prior art teaches or renders obvious Claim 20.

In arguing that PayPal teaches claim 20, Petitioner cites to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the ‘621 Patent.

See Ex. 1003, ¶ 282. The Board has repeatedly cautioned that conclusory, unsupported statements by an expert are entitled to little to no weight. *Tate & Lyle Americas*, IPR2014-00084, slip op. at 17-18; *Kamada, ITD.*, IPR2014-00899, slip op. at 10.

F. Claim 21

Claim 21 fails for similar reasons as Claim 20. Claim 21 is a dependent claim, which depends on the method of Claim 15 and elaborates on Element [15.2]. Claim 15 is a method performed “by a merchant server operated by or for the benefit of a payee,” so per Element [15.2], the enrollment data is *received by the merchant server*. Claim 21 adds an additional element: that this enrollment data is “*received from the payer* over a network” (emphasis added). Petitioners’ arguments ignore that Element [15.2] is performed from the merchant server’s perspective—their citations to Ex. 1009 show that the merchant server receives the enrollment data from PayPal (not from the payer), and that it is PayPal (not the merchant server) that receives the enrollment data from the payer.¹⁶ See Paper 4, Petition at 90–91 (PayPal’s servers “returns information about the buyer such as her phone number, email, name or address.”), *see also id.* at 60 (“Thus, ‘[b]uyers enter and review information about their payments’ via these forms provided by PayPal, then submit them *to PayPal’s servers.*”).

In arguing that PayPal teaches claim 21, Petitioner cites to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the ‘621 Patent. See Ex. 1003, ¶ 283-286. The Board has repeatedly cautioned that conclusory, unsupported

¹⁶ Patent Owner uses the claim terminology here for the sake of comparison, not as an admission that Ex. 1012 actually discloses the claimed “window or frame” or any other aspect of the claim.

statements by an expert are entitled to little to no weight. *Tate & Lyle Americas*, IPR2014-00084, slip op. at 17-18; *Kamada, ITD.*, IPR2014-00899, slip op. at 10.

G. Claim 25

For Claim 25, Petitioners simply cite their arguments for Claim 1 without modification. *See* Paper 4, Petition at 92–93. Patent Owner responds by incorporating its own corresponding arguments regarding Claim 1 in all respects. And in addition to the flaws which are carried over from Petitioners’ arguments as to Claim 1, Petitioners’ arguments are flawed in an additional way: they entirely fail to address the fact that Claim 25 is distinct from Claim 1.

In arguing that PayPal teaches claim 25, Petitioner cites to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the ‘621 Patent. *See* Ex. 1003, ¶ 288. The Board has repeatedly cautioned that conclusory, unsupported statements by an expert are entitled to little to no weight. *Tate & Lyle Americas*, IPR2014-00084, slip op. at 17-18; *Kamada, ITD.*, IPR2014-00899, slip op. at 10.

1. Element [25.1.5.4]: Petitioners fail to show that the prior art teaches or renders obvious “outputting instructions [...] to encrypt the financial account information provided by the payer.”

Broadly, Element [25.1.5.4] recites similar subject matter to Element [1.1.5.4], but with the added limitation that the “instructions” must be “to encrypt the financial account information,” rather than just “to encrypt the *sensitive* financial account information.” That is, to address all limitations of Element [25.1.5.4], Petitioners must show, *e.g.*, that the instructions are to encrypt all of the financial account information. But Petitioners make no additional argument specific to Element [25.1.5.4] beyond those arguments that Petitioners make with regard to Element [1.1.5.4] (which, as discussed above, are deficient for their own reasons). Additionally, as discussed in the context of Element [1.1.5.4], above, Petitioners have failed to show any instructions to encrypt

financial account information at all, regardless of whether or not that financial account information is the *sensitive* financial account information. As such, Petitioners have failed to show that the prior art teaches Element [25.1.5.4].

In arguing that PayPal teaches claim 25, Petitioner cites to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the ‘621 Patent. *See* Ex. 1003, ¶ 288. The Board has repeatedly cautioned that conclusory, unsupported statements by an expert are entitled to little to no weight. *Tate & Lyle Americas*, IPR2014-00084, slip op. at 17-18; *Kamada, ITD.*, IPR2014-00899, slip op. at 10.

H. The Mott Declaration provides only unsupported, conclusory assertion in support of Petitioners’ Ground 1 arguments.

In arguing that PayPal teaches claim 1, Petitioner cites heavily to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the ‘621 Patent. *See, e.g.*, Ex. 1003, ¶¶ 113-119, 121-125, 127, 132-134, 136-156, 163-166, 170-174, 176, 179-182, 185, and 189-221 (Claim 1); ¶¶ 233, 235-236 (Claim 5); ¶¶ 252-277 (Claim 15); ¶ 280 (Claim 18); ¶ 282 (Claim 20); ¶¶ 283-286 (Claim 21); ¶ 288 (Claim 25). The Board has repeatedly cautioned that conclusory, unsupported statements by an expert are entitled to little to no weight. *Tate & Lyle Americas LLC v. Cargill, Inc.*, IPR2014-00084, slip op. at 17-18 (PTAB April 1, 2014) (Paper 12) (“We give such conclusory, unsupported assertions by an expert little to no weight.” And “Petitioner has failed to offer any persuasive evidence in support of its inherency argument.”); *Kamada, ITD. v. Grigols Therapeutics Inc.*, IPR2014-00899, slip op. at 10 (PTAB December 15, 2015) (Paper 43) (“Under our rules, unsupported expert testimony may be given little to no weight.”).

IV. PETITIONERS' GROUND 2 FAILS FOR SEVERAL REASONS

Petitioners' Ground 2 covers only the apparatus claims: Claim 8 and Claim 23, along with their corresponding dependent claims. Because Petitioners' arguments as to Ground 2 heavily rely on (and incorporate by reference) their arguments as to Ground 1, it fails for the same reasons discussed above in the context of ground 1.

A. Claim 8

Broadly, claim 8 recites a secure server that processes a payment transaction from a payer to a payee. Petitioners mostly incorporate by reference their arguments as to Claim 1, and accordingly, Patent Owner incorporates its own corresponding arguments by reference. Specifically, for Elements [8.2.1.3], [8.2.1.5.2], [8.2.1.5.3], [8.2.1.5.4], [8.2.1.5.3], and [8.2.1.8.1], Petitioners simply incorporate by reference their arguments for Elements [1.1.3], [1.1.5.2], [1.1.5.3], [1.1.5.4], [1.1.5.3], and [1.4.1], respectively, and Patent Owner responds by incorporating its own corresponding arguments in all respects.

B. Claim 12

For Claim 12, Petitioners simply cite their arguments for Claim 5, Element [5.1]. *See* Paper 4, Petition at 100. Patent Owner responds by incorporating its own corresponding arguments regarding Claim 5, Element [5.1] in all respects.

C. Claim 13

For Claim 13, Petitioners simply cite their arguments for Claim 6, Element [6.1]. *See* Paper 4, Petition at 100. But for the same reasons as discussed in the context of Claims 20 and 21, above, Claim 13 is distinct from Claim 6:

Claim 6:

The method of claim 1, wherein the secure socket layer connection is synchronous or asynchronous with a process, performed by the

Claim 13:

The secure server of claim 8, wherein the secure socket layer connection is synchronous or asynchronous with a process, performed by

merchant server, to receive enrollment data *provided by* the payer. the merchant server, to receive enrollment data *from* the payer.

Patent Owner responds by incorporating its own corresponding arguments regarding Claims 20 and 21 in all respects.

D. Claim 23

Broadly, claim 23 recites a secure server that processes a payment transaction from a payer to a payee. Petitioners mostly incorporate by reference their arguments as to Claim 15, and accordingly, Patent Owner incorporates its own corresponding arguments by reference. Specifically, for Elements [23.2.3], [23.2.4], [23.2.6.1], [23.2.6.2], [23.2.6.3], [23.2.7], and [23.2.8], Petitioners simply incorporate by reference their arguments for Elements [15.3], [15.4], [15.6.1], [15.6.2], [15.6.3], [15.7], and [15.8], respectively, and Patent Owner responds by incorporating its own corresponding arguments in all respects.

E. The Mott Declaration provides only unsupported, conclusory allegations in support of Petitioners' Ground 2 arguments.

In arguing that PayPal teaches the claims argued in Ground 2, Petitioner cites to the Mott Declaration. However, the Mott declaration only provides unsupported assertions that essentially parrot the language of the PayPal integration guide and developer reference and the claim language of the '621 Patent. *See, e.g.*, Ex. 1003, ¶ 316-340 (Claim 8), ¶ 346 (Claim 12), ¶ 347 (Claim 13), ¶¶ 349-369 (Claim 23). The Board has repeatedly cautioned that conclusory, unsupported statements by an expert are entitled to little to no weight. *Tate & Lyle Americas*, IPR2014-00084, slip op. at 17-18; *Kamada, ITD.*, IPR2014-00899, slip op. at 10.

V. CONCLUSION

Institution of the Petition should be denied.

Respectfully submitted,

Dated: October 31, 2024

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Response complies with the type-volume limitation of 37 C.F.R. § 42.24(b). The word count application of the word processing program used to prepare this Response indicates that the Response contains 9,152 words.

Respectfully submitted,

Dated: October 31, 2024

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing Patent Owner's Mandatory Notices was served on
October 31, 2024, by electronic mail to the following:

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