

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPITAL ONE, N.A. AND CAPITAL ONE SERVICES LLC,  
Petitioners,

v.

WAPP TECH CORP.,  
Patent Owner.

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Case IPR2025-01325  
Patent 8,924,192

**PATENT OWNER'S BIFURCATED  
DISCRETIONARY DENIAL BRIEFING PURSUANT  
TO THE DIRECTOR'S MARCH 26, 2025 MEMORANDUM**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
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**EXHIBIT LIST**

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                 |
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| EX2001         | <b>Complaint for Patent Infringement</b> , Dkt. No. 1, <i>Wapp Tech. Ltd. P'ship v. Apple, Inc.</i> , Case No. 4:25-cv-230 (E.D. Tex. Filed March 6, 2025)                                         |
| EX2002         | <b>Complaint for Patent Infringement</b> , Dkt. No 1, <i>Wapp Tech. Ltd. v. Micro Focus Int'l PLC</i> , Case No. 4:18-cv-469 (E.D. Tex. Filed July 2, 2018)                                        |
| EX2003         | <b>Complaint for Patent Infringement</b> in first Wells Fargo suit, Dkt. No. 1, <i>Wapp Tech. Ltd. v. Wells Fargo &amp; Co.</i> , Case No. 4:18-cv-501 (E.D. Tex., July 16, 2018)                  |
| EX2004         | <b>Complaint for Patent Infringement</b> in first Bank of America suit, Dkt. No. 1, <i>Wapp Tech. Ltd. v. Bank of America Corp.</i> , Case No. 4:18-cv-519 (E.D. Tex., July 20, 2018)              |
| EX2005         | <b>Markman Order</b> , Dkt. No. 176, <i>Wapp Tech. Ltd. v. Micro Focus Int'l PLC</i> , Case No. 4:18-cv-469, (E.D. Tex., April 27, 2020)                                                           |
| EX2006         | <b>Motion to Stay by Defendant Wells Fargo</b> , Dkt. No. 137, <i>Wapp Tech. Ltd. v. Wells Fargo &amp; Co.</i> , Case No. 4:18-cv-501 (E.D. Tex., Oct. 30, 2020)                                   |
| EX2007         | <b>Motion to Stay by Defendant Bank of America</b> , Dkt. No. 12, <i>Wapp Tech. Ltd. v. Bank of America Corp.</i> , Case No. 4:18-cv-519 (E.D. Tex., Oct. 17, 2018)                                |
| EX2008         | <b>Trial Transcript Volume 5 of 5</b> , Dkt. No. 478, <i>Wapp Tech. Ltd. v. Micro Focus Int'l PLC</i> , Case No. 4:18-cv-469, (E.D. Tex., March 5, 2021)                                           |
| EX2009         | <b>Order regarding Defendants' Opening Brief Opposing Enhancement of Damages</b> , Dkt. No. 486, <i>Wapp Tech. Ltd. v. Micro Focus Int'l PLC</i> , Case No. 4:18-cv-469 (E.D. Tex. April 22, 2021) |
| EX2010         | <b>Final Judgement</b> , Dkt. No. 487, <i>Wapp Tech. Ltd. v. Micro Focus Int'l PLC</i> , Case No. 4:18-cv-469 (E.D. Tex. April 22, 2021)                                                           |
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| EX2012         | <b>Docket sheet for <i>Wapp Tech. Ltd. v. Wells Fargo &amp; Co.</i></b> , Case No. 4:18-cv-501                                                                                                     |
| EX2013         | <b>Docket sheet for <i>Wapp Tech. Ltd. v. Bank of America Corp.</i></b> ,                                                                                                                          |

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| EX2014 | <b>Complaint for Patent Infringement</b> in second Wells Fargo suit, Dkt. No. 1, <i>Wapp Tech. Ltd. v. Wells Fargo Bank, N.A.</i> , Case No. 4:21-cv-00671 (E.D. Tex., August 27, 2021)    |
| EX2015 | <b>Complaint for Patent Infringement</b> in second Bank of America suit, Dkt. No. 1, <i>Wapp Tech. Ltd. v. Bank of America Corp.</i> , Case No. 4:21-cv-00670 (E.D. Tex., August 27, 2021) |
| EX2016 | <b>Markman Order</b> in second Wells Fargo suit, Dkt. No. 96, <i>Wapp Tech. Ltd. v. Wells Fargo Bank, N.A.</i> , Case No. 4:21-cv-00671 (E.D. Tex. July 6, 2022)                           |
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| EX2024 | <b>Order regarding Scheduling Conference</b> , Dkt. No. 161, <i>Oasis Research, LLC v. Adrive, LLC et al.</i> , Case No. 4:10-cv-00435 (E.D. Tex. Feb. 23, 2011)                           |
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| EX2027 | <b>Docket sheet for</b> <i>Imperium IP Holdings (Cayman), Ltd. v. Samsung Electronics Co., Ltd. et al</i> , Case No. 4:14-cv-00371 (E.D. Tex. Filed June 9, 2014)                          |
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|        | <i>al</i> , Case No. 4:14-cv-00371 (E.D. Tex. Oct. 15, 2014)                                                                                                     |
| EX2029 | <b>Docket sheet for <i>Tech Pharmacy Services, LLC v. Alixa Rx LLC et al</i></b> , Case No. 4:15-cv-00766 (E.D. Tex. Filed Nov. 2, 2015)                         |
| EX2030 | <b>Order Governing Proceedings</b> , Dkt. No. 21, <i>Tech Pharmacy Services, LLC v. Alixa Rx LLC et al</i> , Case No. 4:15-cv-00766 (E.D. Tex. Feb. 22, 2016)    |
| EX2031 | <b>Docket sheet for <i>Evicam International, Inc. v. Enforcement Video, LLC</i></b> , Case No. 4:16-cv-00105 (E.D. Tex. Filed Nov. 24, 2015)                     |
| EX2032 | <b>Order Governing Proceedings</b> , Dkt. No. 12, <i>Evicam International, Inc. v. Enforcement Video, LLC</i> , Case No. 4:16-cv-00105 (E.D. Tex. Feb. 22, 2016) |
| EX2033 | <b>Docket sheet for <i>Innovation Sciences, LLC v. Amazon.com Inc.</i></b> , Case No. 4:18-cv-00474 (E.D. Tex. Filed July 5, 2018)                               |
| EX2034 | <b>Order Governing Proceedings</b> , Dkt. No. 10, <i>Innovation Sciences, LLC v. Amazon.com Inc.</i> , Case No. 4:18-cv-00474 (E.D. Tex. Oct. 3, 2018)           |
| EX2035 | <b>Docket sheet for <i>SB IP Holdings LLC v. Vivint, Inc.</i></b> , Case No. 4:20-cv-00886 (E.D. Tex. Filed Nov. 17, 2020)                                       |
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| EX2037 | <b>Order Governing Proceedings</b> , Dkt. No. 82, <i>Wapp Tech. Ltd. v. Micro Focus Int’l PLC</i> , Case No. 4:18-cv-469 (E.D. Tex. Aug. 21, 2019)               |
| EX2038 | <b>Order Governing Proceedings</b> , Dkt. No. 56, <i>Wapp Tech. Ltd. P’ship v. Apple, Inc.</i> , Case No. 4:25-cv-230 (E.D. Tex. Aug. 20, 2025)                  |
| EX2039 | <b>Wapp’s Production Notice Letter to Capital One in <i>Wapp Tech. Ltd. P’ship v. Apple, Inc.</i></b> , Case No. 4:25-cv-230 dated Sept. 30, 2025                |
| EX2040 | <b>Wapp’s First Set of Interrogatories to Capital One (Nos. 1-2) in <i>Wapp Tech. Ltd. P’ship v. Apple, Inc.</i></b> , Case No. 4:25-cv-230 dated Sept. 30, 2025 |
| EX2041 | <b>Wapp’s Venue Interrogatories to Apple (Nos. 1-4) in <i>Wapp Tech. Ltd. P’ship v. Apple, Inc.</i></b> , Case No. 4:25-cv-230 dated Sept. 8, 2025               |
| EX2042 | <b>Wapp’s Request for Production to Apple (Nos. 1-7) in <i>Wapp</i></b>                                                                                          |

|  |                                                                                       |
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|  | <i>Tech. Ltd. P'ship v. Apple, Inc.</i> , Case No. 4:25-cv-230 dated<br>Sept. 8, 2025 |
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## **I. Introduction**

U.S. Patent No. 8,924,192 (“the ’192 patent”) has been in force almost 11 years since issuing, been asserted in six prior litigations, and had its validity confirmed following one trial already. The same district court judge who presided over those cases will preside over a second trial—this one against Petitioners—prior to the anticipated date of a final written decision in this IPR. That trial will resolve the validity of the ’192 patent’s claims, of which the challenged claims are only a small subset, as well as the validity of four related patents.

The district court’s substantial investment of resources in understanding and construing the claims of the ’192 patent in prior cases, and the prior and future investment by the parties and the court in preparation for the upcoming trial, weigh heavily against institution. Likewise, the strength of settled expectations in the ’192 patent—a patent that has been battle-tested in its nearly 11-year lifetime—weigh heavily in favor of discretionary denial. Petitioners’ arguments against discretionary denial are unfounded, and the merits of the Petition itself are weak. For all these reasons, as detailed below, WAPP Tech Corp. (“WAPP”) respectfully requests the Director exercise discretion to deny the Petition.

## **II. Factual Background**

### **A. The ’192 Patent Priority Chain and Expiration**

The ’192 patent issued on December 30, 2014, almost eleven years ago. The

'192 patent is a continuation of U.S. patent application number 12/759,543<sup>1</sup> (“the '543 application”), which is a continuation of U.S. patent application number 11/449,958 (“the '958 application”). The '958 application later issued as U.S. Patent No. 7,813,910, which Petitioners identify as “Poulin-910” (EX1009) and cite as prior art against the '192 patent. Petition at 46–47. The '958 application (and through it, the '192 patent) claims priority to provisional application number 60/689,101 (“2005 Provisional”), filed on June 10, 2005. *See* EX1009 at (60); EX1001 at (60); *see also* EX1004 ¶ [0001]. The '192 Patent expires on June 9, 2026. *See* EX1001 at (63), (\*).

**B. The Parallel Litigation Involves Over 200 Claims from Five Asserted Patents, of Which the '192 Patent Is Just One**

On March 6, 2025, WAPP filed suit asserting Petitioners have infringed the '192 patent, as well as four related patents in parallel litigation pending in the Sherman Division of the Eastern District of Texas (“the Parallel Litigation”). EX2001. All the asserted patents stem from the same parent, the '958 application, which issued as Poulin-910. The '192 Patent includes 69 claims, of which the Petition challenges only claims 60–69. EX1009; *see* Petition at 1. The remaining four asserted patents have a combined 152 claims; a total of 221 claims are at issue in the Parallel Litigation.

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<sup>1</sup> This application issued as U.S. Patent No. 8,332,203.

### **C. The '192 Patent Has Been Asserted in Six Prior Lawsuits**

Beginning in July 2018, WAPP asserted the '192 Patent in numerous lawsuits, all before Judge Mazzant in the Sherman Division of the Eastern District of Texas. The first lawsuit was filed on July 2, 2018, against Micro Focus International PLC (the "Micro Focus Suit"). *See* EX2002. Two other lawsuits were filed in parallel against Wells Fargo (on July 16, 2018) and Bank of America (on July 20, 2018). *See* EX2003; EX2004. The district court received briefing on claim construction and issued one order for all three cases addressing six terms in the '192 patent (and several terms in related patents). *See* EX2005. Following that order, Wells Fargo and Bank of America stipulated "to be bound by any final judgment in the [Micro Focus] Suit as to both infringement and invalidity," resulting in the cases against Wells Fargo and Bank of America being stayed. EX2006 at 8; *see* EX2007 at 2 (similar).

The Micro Focus jury trial, which began on March 1, 2021, ended with a decisive victory for WAPP. By the final day of trial, the defendant was forced to concede on nearly all its validity challenges, and WAPP was awarded judgment as a matter of law that the '192 patent was not invalid. *See* EX2008 at 1271:15–1274:16, 1275:18–1276:2, 1280:22–1282:23; EX2009 at 2 ("The Court granted Wapp's 50(a) motion on validity."). The court entered judgment of infringement on the jury's verdict, awarding WAPP about \$172.6 million in damages, EX2010, and the Micro Focus Suit ultimately settled for \$67.5 million. Between these first three

cases, there were a total of 904 docket entries (*see* EX2011; EX2012; EX2013), illustrating the tremendous amount of work done by the court.

On August 27, 2021, WAPP again filed suit asserting the '192 Patent (and four related patents) against Wells Fargo and Bank of America based on additional acts of infringement. *See* EX2014; EX2015. These two parallel cases proceeded to a joint claim construction hearing and order addressing nine terms in the '192 patent. *See* EX2016. Both cases settled in late 2022. *See* EX2017 at 24; EX2018 at 21. There were a total of 299 docket entries between the two cases. EX2017; EX2018.

The sixth case in which WAPP asserted the '192 patent (along with four related patents) was filed on December 22, 2023, against JPMorgan Chase. *See* EX2019. Once again, the district court held a claim construction hearing and issued an order, this time addressing ten terms in the '192 patent, six of which appear in the claims challenged in this proceeding. *See* EX2020. The following claim terms present in the challenged claims were construed by the district court:

- “simultaneously visually emulate, via one or more profile display windows” construed as “emulate simultaneously, and display one or more windows showing resources of the mobile device that are available to the application” (*see id.* at 7);
- “one or more profile display windows” construed as “one or more windows showing resources of the mobile device that are available to the

- application” (*see id.*);
- “configured to” construed as “actually programmed to” (*see id.*);
  - “emulate” construed to have plain meaning (*see id.* at 7–15);
  - “application” construed to have plain meaning (*see id.* at 16–19); and
  - “on the mobile device” construed to have plain meaning—not indefinite (*see id.* at 29–31).

WAPP and Chase filed a notice of a settlement in principle in late 2024, and the case was subsequently dismissed pursuant to a joint stipulation in early 2025. EX2021 at 15.

Adding the 96 docket entries from the Chase lawsuit (*id.*) brings the total number of docket entries in the six prior litigations involving the ’192 patent to roughly 1,300. During those six cases, Judge Mazzant held three claim construction hearings, issued three claim construction orders, presided over a jury trial on validity (among other issues), and rendered judgment as a matter of law that the ’192 patent is not invalid.

### **III. Argument**

As shown below, each of the six *Fintiv* factors “support[s] the exercise of authority to deny institution in view of an earlier trial date” in the Parallel Litigation on the facts of this case. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (PTAB March 20, 2020) (precedential) (“*Fintiv I*”). The assertions to the contrary in

the Petition (at 58) fail to consider the relevant facts and only address three of the factors. Taking “a holistic view,” as Board precedent requires, all six factors collectively show that the “efficiency and integrity of the system are best served by denying” the Petition. *Fintiv I*, at 6. In addition, the settled expectations of the parties support discretionary denial because the ’192 patent has been in force for over a decade, and its validity has been tested and confirmed in litigation. The Petition fails to show any reason why these factors would not justify discretionary denial.

**A. The *Fintiv* Factors Support Discretionary Denial**

**1. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted**

This factor favors discretionary denial because (i) Petitioners have not filed a motion to stay the Parallel Litigation, and (ii) any such request for a stay is very likely to be denied based on the court’s well-known practice. The Petition challenges only 9 of the more than 200 claims of the five patents asserted in the Parallel Litigation. And “[i]t has been [the district court’s] consistent and long established practice to deny motions to stay pending IPR . . . when the PTAB . . . [has] instituted review on less than all asserted claims of all asserted patents.” *AGIS Software Development LLC v. Google LLC*, No. 2:19-cv-361-JRG, 2021 U.S. Dist. LEXIS 24195, at \*9 (E.D. Tex. Feb. 9, 2021); *see Force Mos Tech., Co. Ltd. v. Asustek Computer, Inc.*, No. 2:22-cv-460-JRG, 2024 U.S. Dist. LEXIS 66423, at \*10 (E.D. Tex. Apr. 11, 2024) (similar). Accordingly, “there is insufficient evidence that the

district court is likely to stay its proceeding even if the Board were to institute trial.”  
*Coretronic Corp. v. Maxell, Ltd.*, IPR2025-00474, Paper 11 at 2 (PTAB Jul. 10, 2025) (Acting Dir. Stewart, C.M.).

**2. Factor 2: proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision**

Factor 2 weighs in favor of discretionary denial because the Board’s final written decision is unlikely to issue before trial in the Parallel Litigation. *See Fintiv I*, at 9 (“If the [district] court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution.”). If the Board institutes in this case, the anticipated deadline for the Board’s final written decision would be January 31, 2027. *See* Paper 3 (according July 31, 2025 filing date to Petition); *see also* 37 C.F.R. § 42.107(b); 35 U.S.C. §§ 314(b), 316(a)(11). Under the current schedule, the district court trial will occur over a month prior, in December 2026.

Judge Mazzant’s practice is to schedule a final pretrial conference, with the trial itself to follow by a few days. For example, in the Micro Focus Suit, the Court held its pretrial conference on February 22–23, 2021. EX2011. The Micro Focus trial commenced the following week on March 1. *See id.* A similar pattern holds in all ten intellectual property cases tried to a verdict before Judge Mazzant since 2008 (*i.e.*, the cases for which Docket Navigator has data), including the Micro Focus Suit, as the following table shows:

| Case          | Original Pretrial Conf. Date | Date Pretrial Conf. Held | Trial Start Date |
|---------------|------------------------------|--------------------------|------------------|
| 4:08-cv-00451 | 8/3/2010                     | 1/29/2015                | 2/9/2015         |
| 4:10-cv-00435 | 5/14/2012                    | 3/8/2013                 | 3/14/2013        |
| 4:12-cv-00074 | 2/8/2013                     | 2/8/2013                 | 2/11/2013        |
| 4:12-cv-00647 | 11/4/2014                    | 1/14/2016                | 1/19/2016        |
| 4:14-cv-00371 | 1/20/2016                    | 1/29/2016                | 2/1/2016         |
| 4:15-cv-00766 | 4/12/2017                    | 8/22/2017                | 8/25/2017        |
| 4:16-cv-00105 | 6/30/2017                    | 6/30/2017                | 7/10/2017        |
| 4:18-cv-00469 | 12/4/2020                    | 2/22/2021                | 3/1/2021         |
| 4:18-cv-00474 | 1/15/2020                    | 8/13/2020                | 8/24/2020        |
| 4:20-cv-00886 | 7/11/2022                    | 10/11/2023               | 10/16/2026       |

See EX2022 at 12, 49, 50; EX2024 at 8; EX2023 at 91; EX2025 at 15, 28, 29; EX2026 at 12, 30; EX2028 at 15; EX2027 at 36; EX2030 at 15; EX2029 at 50, 51; EX2032 at 15; EX2031 at 19, 20; EX2037 at 15; EX2011 at 58, 61; EX2034 at 15; EX2033 at 92, 94; EX2036 at 15; EX2035 at 52, 53. In three of those cases (highlighted green), the original pretrial conference setting was essentially maintained. In two of those cases (highlighted blue), the pretrial conference was held within about 2–4 months of the original setting, and in two others (highlighted orange), the pretrial conference was held within 10 months of the original setting. As shown, trial in each case started 3–11 days after the final pretrial conference. In short, the original pretrial conference setting is a reasonably reliable indicator of trial date in Judge Mazzant’s court.

In the Parallel Litigation, the final pretrial conference is scheduled for December 7, 2026. EX2038. Thus, the district court *has* “adopted a schedule,” notwithstanding Petitioners’ contrary assertion (Petition at 58), and the anticipated

trial date for the Parallel Litigation is December 10–18, 2026 given the court’s typical practice of starting trial within days of the final pretrial conference. Therefore, trial likely will occur more than a month before the anticipated deadline for the final written decision (January 31, 2027).

Factor 2 has been found to favor denial when the scheduled trial date precedes a final written decision deadline by similar amounts. *See, e.g., E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16, at 6–7, 9 (PTAB May 15, 2019) (one-month period between trial date and deadline for final written decision favored discretionary denial); *see also eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10, at 9 (PTAB Apr. 13, 2022) (trial date “one to two months before any final decision would have been due” favors discretionary denial); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18, at 8–9 (PTAB May 2, 2022) (two-month difference favors discretionary denial); *ARM Ltd. et al. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (PTAB May 16, 2025) (Acting Dir. Stewart, C.M.) (discretionarily denying institution because “it is unlikely that a final written decision [] will issue before district court trial”) (later vacated because litigation was dismissed); *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, at 13 (PTAB May 13, 2020) (informative) (second factor favors denial when “the currently scheduled District Court trial is scheduled to begin two months before our deadline to reach a final decision”).

**3. Factor 3: investment in the parallel proceeding by the court and the parties**

This factor weighs in favor of discretionary denial because of the significant investment the district court and the parties have already made, as well as the work that will be done before the institution decision. Indeed, the district court has held *three* claim construction hearings—each one resulting in an order construing multiple claim terms from the '192 patent—and entered judgment confirming the validity of claims from the '192 patent. *See* § II.C, *supra*. Having already invested significant time and effort in understanding, interpreting, and evaluating the '192 patent, the district court is well-equipped to efficiently resolve the issues presented in the Petition.

Furthermore, the parties have already invested significant efforts in advancing the Parallel Litigation. Petitioners filed a motion to dismiss asserting invalidity under 35 U.S.C. § 101; responsive and reply briefs have already been filed. Petitioners' co-defendants—Apple and Frost Bank—also filed motions to dismiss based on improper venue and Rule 12(b)(6), respectively, and many briefs have been filed. Wapp has served Petitioners with two interrogatories and a letter identifying 58 categories of relevant documents to produce. EX2039; EX2040. Wapp has already served four interrogatories and seven requests for production on co-defendant Apple, and Wapp anticipates serving additional discovery on all parties in the coming days. EX2041; EX2042

In short, the case is well under way. Petitioners’ assertion to the contrary appears to be improperly based on the state of the case at the time of the Petition. *See* Petition at 58 (“The district court litigation is at a very early stage.”). *But see Fintiv I*, at 9 (explaining the relevant timeframe is “the time of the institution decision”). By the anticipated deadline for any institution decision (around January 31, 2026), Patent Owner will have served its infringement contentions and the bulk of its document productions (November 6, 2025 deadline), and Petitioners will have served their invalidity contentions and documents sufficient to show the operation of the accused products (December 1, 2025 deadline). EX2038 at 12. The claim construction process will be well underway, with disclosures and filings required by Local Patent Rules 4-2 and 4-3 being completed and claim construction briefing to follow shortly thereafter. *Id.* The investment by the parties in fact discovery (including developing their contentions) and claim construction supports finding that Factor 3 favors discretionary denial. *See Arthrex, Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11, at 10–11 (PTAB Apr. 25, 2025) (noting relevance of work on fact discovery and claim construction).

Accordingly, the investment by the parties—and the extensive investment by the district court—militates in favor of denial.

**4. Factor 4: overlap between issues raised in the petition and in the parallel proceeding**

This factor weighs in favor of discretionary denial because the Petition does

not include claims or grounds that Petitioners could not address in the Parallel Litigation. *See Fintiv I*, at 13 (“[I]t may [] be inefficient to proceed because the district court may resolve validity of enough overlapping claims to resolve key issues in the petition.”). To the contrary, the scope of the Parallel Litigation—including 59 unchallenged claims of the ’192 patent, plus four unchallenged related patents—is much broader than, and fully encompasses, the scope of the Petition.

Petitioners also have not stipulated to forego even the challenges raised in the Petition, let alone challenges they reasonably could have raised. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential). Even if they did so, Petitioners’ stipulation would not bind Petitioners’ co-defendants. Thus, regardless of what happens in this proceeding, the Parallel Litigation will encompass the very same art and arguments presented in the Petition. Factor 4 therefore strongly favors discretionary denial.

**5. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party**

Petitioners Capital One and Patent Owner Wapp are both parties to the Parallel Litigation. *See EX2001*. When the parties are the same—like in this case—this factor favors discretionary denial. *Sotera Wireless*, IPR2020-01019, Paper 12 at 19.

**6. Factor 6: other circumstances that impact the Board’s exercise of discretion, including the merits**

Factor 6 weighs in favor of discretionary denial because each Petition Ground

rests on one of two flawed theories, making the merits in this case particularly weak. *See Fintiv I*, at 14–16. Grounds 1A–1C (collectively, “Ground 1”) require (improperly) construing system claims 60–69 as product-by-process claims. *See* Petition at 12–15 (omitting analysis of recited limitations based on asserted construction). In Grounds 2A–2C (collectively, “Ground 2”), the Petition asserts that Poulin-910 is prior art (*see id.* at 46–47, 51–54), even though the ’192 patent claims priority to Poulin-910 through continuation (not CIP) applications and the two patents have substantially identical disclosures. *Compare* EX1001 *with* EX1009.

Claims 60–69 are not product-by-process claims. Claim 60 recites “[a] system comprising” two structural components: (1) “an application” and (2) “a software authoring platform” that was used in developing “the application.” Claim 61 through 69, all of which depend from claim 60, similarly recite a system. On their face, none of these “system” claims facially resemble a “product-by-process” claim (which typically arise in the chemical arts). *See, e.g., In re Thorpe*, 777 F.2d 695, 696 (Fed. Cir. 1985) (quoting a product-by-process claim: “The product of the process of Claim 1.”); *Cont’l Circuits LLC v. Intel Corp.*, 915 F.3d 788, 794 (Fed. Cir. 2019) (quoting a product-by-process claim: “A product produced by the process of claim 2.”).

Furthermore, Petitioners neglected to identify the extent to which the terms of claim 60 have already been construed by the district court in the JPMorgan Chase

matter. *See* Petition at 10 (identifying only three of the six terms construed by the district court). As detailed above (*see* § II.C, *supra*), the JPMorgan Chase court construed six terms in claim 60 of the '192 Patent. These terms are highlighted below:

60. A system comprising:  
an application configured to enable a user to modify a photo on the mobile device, wherein the application is developed using a software authoring platform configured to simultaneously visually emulate, via one or more profile display windows, a plurality of hardware characteristics indicative of performance of the mobile device when executing the application.

Despite raising six terms in claim 60 as requiring construction (including one indefiniteness challenge), no party in the JPMorgan Chase case requested that the district court construe claim 60 as a “product-by-process” claim (because it is not). Nor did the Patent Office treat the claim as a product-by-process claim during prosecution.

Finally, none of Petitioner’s cases support construing the “application” limitation of claim 60—a software component of the claimed system—as a product-by-process limitation. Rather, each case involves a chemical structure resulting from an expressly recited chemical process. In *Greenliant Sys., Inc. v. Xicor LLC*, the claim recited a “silicon dioxide layer being *formed by low pressure chemical vapor*

*deposition comprising the use of tetraethylorthosilicate.*” 692 F.3d 1261, 1264 (Fed. Cir. 2012). In *Kamstrup A/S v. Axioma Metering UAB*, the claims recited a “monolithic polymer structure *being cast in one piece.*” 43 F.4th 1374, 1377 (Fed. Cir. 2022). And the other two cases expressly recite a “product” of a specified chemical (or biochemical) process. See *Amgen Inc. v. F. Hoffmann-La Roche, Ltd.*, 580 F.3d 1340, 1364 (Fed. Cir. 2009) (discussing claim 3, reciting in part: “A non-naturally occurring glycoprotein product of the expression in a mammalian host cell of an exogenous DNA sequence”); *Thorpe*, 777 F.2d at 696–97 (discussing claim reciting: “The product of the process of Claim 1”).

None of these cases involve construing a software application that is part of an overall system as product-by-process. In fact, the Federal Circuit held that the claim in *Amgen* was **not** a product-by-process claim, despite the “product of” language used by the claim. See 580 F.3d at 1368–69. The district court declined to instruct the jury on the standard for anticipation of a product-by-process claim. *Id.* at 1368. And the *Amgen* court affirmed that decision because the claim recited a product with a “source limitation.” *Id.* at 1369. Thus, even Petitioners’ own cases do not support its product-by-process argument.

Ground 2 is premised on the flawed assumption that claims 60–69 are not entitled to the priority date of the application that issued as Poulin-910. But Petitioners are incorrect in alleging a lack of written description support for claim

60. *See* Pet. at 42–45. Contrary to Petitioners’ arguments, the ’543 application provides support for the recited “application configured to enable a user to modify a photo on a mobile device.”

First, Petitioners concede that the ’543 application discloses “a frame based application being developed using the emulator” that “include[s] multiple frames,” which include “graphics and/or action scripts that generate the graphical image for display.” Petition at 44 (citing EX1004 ¶ [0043]). The same paragraph of the ’543 application explains that the application enables modification of an image (*e.g.*, “image manipulation”). *See* EX1004 ¶ [0043] (“[E]ach frame of frames 223 [included in application 104] includes multiple graphic elements and/or action scripts that involve image manipulation...”). Petitioners do not dispute that the mobile application supports image modification, and a photo is an image.

Rather, the crux of Petitioners’ argument is the purported absence of a “user” from this passage. *See* Petition at 44 (“But this does not disclose any ability for a **user** (i.e., a mobile device user) of an application to **modify** a photo.”). Petitioners ignore the 2005 provisional, however, which the ’543 application incorporates by reference. *See* EX1004 ¶ [0001]. The 2005 provisional discloses an “Active2Play<sup>TM</sup>” embodiment that includes “ImageVu<sup>TM</sup> (a personalized Over-the-Air photo imaging

line).” EX1031 at 10.<sup>2</sup> The 2005 provisional expressly teaches that one component, “Active2Play™ Consumer[,] allows *the end user* the ability *to personalize their content* operating experience Over-the-Air.” *Id.* (emphases added). Another component, “Active2Play™ UI” provides a user interface that “*can be managed and updated* Over-the-Air *by the consumer, . . . providing realtime personalization* and brand marketing *of the handset user interface.*” *Id.* (emphases added). This handset interface that can be customized and personalized by the user (or consumer) includes the graphics detailed in paragraph [0043] of the ’543 application, and the mobile application provides the software code for modifying these graphics.

Thus, the ’543 application discloses: (1) software for image manipulation, which includes photo modification; and (2) software for a “photo imaging line” that provides for “realtime personalization” by consumers of the user interface, which is comprised of images. In short, Petitioners’ statement that “the ’543 application does not provide any specific examples of the frame based applications that are developed using the emulator” (Petition at 43) is false. Not only are such applications disclosed, but the 2005 provisional teaches that they enable the user to customize graphics within those applications. Petitioners completely ignored the 2005 provisional disclosures, which are highly relevant (and counter) to their arguments.

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<sup>2</sup> Citation is to the tenth page of the Exhibit, which lacks pagination after page 5.

**B. Additional Considerations Also Support Discretionary Denial**

In addition to the *Fintiv* factor analysis discussed above, the settled expectations of the parties and the public, as reflected by the length of time the claims have been in force, also heavily favor discretionary denial.<sup>3</sup> Not only has the '192 patent been in force for over a decade (EX1001 at (45)), it withstood previous litigation challenges to its validity. *See* § II.C, *supra*. Indeed, the '192 patent has been repeatedly subjected to validity challenges spanning six different litigations (including one trial) prior to the Parallel Litigation.

Moreover, the '192 patent will expire about seven months before any final written decision is due to be rendered. *See* § II.A, *supra*. It makes no sense for the Board to expend its limited resources adjudicating the validity of claims that will expire before the conclusion of the IPR, particularly when the patent in question has been thoroughly tested in the crucible of multiple litigations.

The Petition also fails in its attempt to portray routine examination of the claims as an error in need of correcting. *See* Petition at 55–58. Instead, Petitioners' alleged "errors" rely on the same flawed theories as the asserted Grounds. The

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<sup>3</sup> *See* March 26, 2025 Memorandum re: Interim Processes for PTAB Workload Management at 2, *available at* <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (accessed on May 9, 2025).

Examiner could not have “appreciated that the challenged claims were not entitled to claim the benefit of the priority applications’ filing date,” *id.* at 56, because the claims *were* entitled to the benefit of the priority claim. *See* § III.A.6, *supra*. Indeed, there is no conceivable reason why the Examiner should have cited the identical grandparent application, Poulin-910, as prior art against the challenged claims. The Poulin-910, just like every disclosure in the chain, discloses the claimed limitations, and it fully supports the claim for priority.

Petitioners also cannot show that the Examiner erred by second-guessing the Examiner’s search strategy. *See* Petition at 57–58. Petitioners’ argument is premised on its construction of claim 60 as a product-by-process claim, as revealed by its emphasis on “the limiting language within claim 60.” *Id.* at 57; *see id.* at 10 (arguing that “the scope [of claim 60] is not limited by the recitation of [alleged] process steps but rather by the end product, an application configured to enable a user to modify a photo on the mobile device”). As noted above, however, Petitioners’ construction is contrary to the plain language of the claim. *See* § III.A.6, *supra*. The Examiner did not err by searching other limitations similar to limitations in many other claims (not just claims 60–69) when those limitations were already determined to be missing from the prior art of record. *See* EX1002 at 70–74 (rejecting claims 1–43 only for double patenting).

Petitioners therefore fail to show any error material to patentability during

prosecution or any other reason why the Petition should not be discretionarily denied.

#### **IV. Conclusion**

For all of the reasons discussed above, Patent Owner respectfully requests that the USPTO decline to institute *inter partes* review of the '192 Patent.

Dated: September 30, 2025

Respectfully submitted,

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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 Discretionary Denial Brief and accompanying Exhibits 2001-2042**, were served via email to counsel of record for Petitioners as follows:

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