

Filed on behalf of: Capital One, N.A. and Capital One Services, LLC

Entered: October 31, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPITAL ONE, N.A. and CAPITAL ONE SERVICES, LLC,
Petitioner,

v.

WAPP TECH CORP.,
Patent Owner.

IPR2025-01325
Patent 8,924,192

**PETITIONERS' OPPOSITION TO PATENT OWNER'S BIFURCATED
DISCRETIONARY DENIAL BRIEF**

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Factual Background.....	2
III.	The <i>Fintiv</i> Factors Weigh in Favor of Institution.....	2
A.	Factor 2: No Trial Date Weighs in Favor of Institution.....	3
B.	Factor 3: Limited Investment Weighs in Favor of Institution	5
C.	Factor 4: Limited Overlap Weighs in Favor of Institution	6
D.	Factors 1 and 5: No Stay Motion and Same Parties Weigh Neutrally for Institution.....	7
E.	Factor 6: Other Circumstances, Including the Merits, Weigh in Favor of Institution.....	7
1.	The Challenged Claims are Product-By-Process.....	7
2.	The Challenged Claims are Not Entitled to Earlier Priority	9
IV.	Additional Considerations Also Favor Institution.....	12
V.	Multiple Office Errors Favor Institution	16
VI.	Process Memorandum Relevant Considerations Favor Institution	19
A.	Reliance on Expert Testimony Supports Institution (Factor 4)	20
B.	Other Considerations Support Institution (Factor 7).....	20
VII.	Conclusion	20

TABLE OF AUTHORITIES**Page(s)****CASES**

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	3
<i>Apple Inc. v. Gesture Tech. Partners, LLC</i> , 127 F.4th 364 (Fed. Cir. 2025)	13
<i>Arthrex, Inc. v. Medshape, Inc.</i> , IPR2025-00053, Paper 11 (PTAB Apr. 25, 2025)	5, 6
<i>Aylus Networks, Inc. v. Apple Inc.</i> , 856 F.3d 1353 (Fed. Cir. 2017)	10
<i>Catalyst Orthoscience Inc. v. Shoulder Innovations, Inc.</i> , PGR2024-00042, Paper 17 (PTAB Dec. 19, 2024).....	5
<i>Celgene Corp. v. Peter</i> , 931 F.3d 1342 (Fed. Cir. 2019)	16
<i>In re Downing</i> , 754 F. App'x 988 (Fed. Cir. 2018)	8
<i>Flex Logix Techs., Inc. v. Konda</i> , IPR2020-00260, Paper 55 (PTAB July 29, 2021), <i>aff'd sub nom.</i> <i>Konda v. Flex Logix Techs., Inc.</i> , 2022 WL 1436144 (Fed. Cir. May 6, 2022)	17
<i>Greenliant Sys., Inc. v. Xicor LLC</i> , 692 F.3d 1261 (Fed. Cir. 2012)	8
<i>Harbor Freight Tools USA Inc. v. Champion Power Equip., Inc.</i> , IPR2025-00805, Paper 20 (Dir. Sept. 19, 2025)	20
<i>Home Depot U.S.A., Inc. v. H2 Intellect LLC</i> , IPR2025-00480, Paper 11 (Dir. Sept. 4, 2025)	14
<i>Hulu, LLC v. SITO Mobile R&D IP, LLC</i> , IPR2021-00298, Paper 11 (PTAB May 19, 2021)	7

<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327, Paper 12 (Dir. June 26, 2025)	15
<i>Kamstrup A/S v. Axioma Metering UAB</i> , 43 F.4th 1374 (Fed. Cir. 2022)	7
<i>Mercedes-Benz Grp. AG v. Phelan Grp., LLC</i> , IPR2025-00413, Paper 13 (Dir. June 25, 2025)	4
<i>Nokia of Am. Corp. v. Soto</i> , IPR2023-00680, Paper 30 (Dir. Dec. 3, 2024)	7
<i>Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC</i> , 584 U.S. 325 (2018)	13
<i>Parus Holdings, Inc. v. Google LLC</i> , 70 F.4th 1365 (Fed. Cir. 2023)	17
<i>In re Power Integrations, Inc.</i> , 884 F.3d 1370 (Fed. Cir. 2018)	9
<i>SAS Inst., Inc. v. Iancu</i> , 584 U.S. 357 (2018)	16
<i>Shenzen Chic Elecs. Co. v. Pilot, Inc.</i> , IPR2023-00810, Paper 12 (PTAB Nov. 8, 2023)	19
<i>USAA Fed. Sav. Bank v. PACid Techs., LLC</i> , IPR2025-00697, Paper 9 (Dir. Aug. 14, 2025)	4, 19

STATUTES

35 U.S.C. §287(a)	15
35 U.S.C. §324(b)	9
35 U.S.C. §325(d)	16

OTHER AUTHORITIES

AIA §18	16
AIA §3(n)(1)	16

AIA §6(f)(2)(A)	16
H.R. Rep. No. 112-98, pt. 1, at 46-48 (2011)	16

Exhibit List

Ex.	Description
1001	U.S. Patent No. 8,924,192 (“’192 patent”)
1002	Prosecution History of U.S. Patent No. 8,924,192 (“’192 PH”)
1003	Declaration of Nenad Medvidovic, Ph.D., with <i>curriculum vitae</i>
1004	U.S. Patent Application No. 12/759,543 (“’543 application”)
1005	Certified Translation of Korean Patent Publication No. KR 2003-0049670 (“Lee”)
1006	Korean Patent Publication No. KR 2003-0049670
1007	U.S. Patent Application Publication No. 2005/0102638 (“Jiang”)
1008	U.S. Patent Application Publication No. 2006/0015404 (“Tran”)
1009	U.S. Patent No. 7,813,910 (“Poulin-910”)
1010	Hassan Artail, <i>A Multiplatform Methodology: Developing Mobile Device Applications</i> , 4 IEEE Pervasive Computing 92 (Apr. – June 2005)
1011	Lynne Hall et al., <i>A Development Environment for Intelligent Applications on Mobile Devices</i> , 27 Expert Sys. Applications 481 (2004)
1012	U.S. Patent Application Publication No. 2002/0184610
1013	European Patent Specification No. EP 1 332 439 B1
1014	Stuart J. Barnes, <i>The Mobile Commerce Value Chain: Analysis and Future Developments</i> , 22 Int’l J. Info. Mgmt. 91 (2002)
1015	U.S. Patent Application Publication No. 2004/0192277
1016	Bert de Reyck & Zeger Degraeve, <i>Broadcast Scheduling for Mobile Advertising</i> , 51 Operations Rsch. 509 (2003)

Ex.	Description
1017	Ichiro Satoh, <i>Software Testing For Wireless Mobile Computing</i> , 11 IEEE Wireless Commc'ns 58 (Oct. 2004)
1018	Trevor J. Young, <i>Using AspectJ to Build a Software Product Line for Mobile Devices</i> (Aug. 2005) (Master's thesis, University of British Columbia)
1019	Microsoft Computer Dictionary (5th ed. 2002) (excerpts)
1020	Webster's Unabridged Dictionary of the English Language (2001) (excerpts)
1021	S. Kumar & C. Zahn, <i>Mobile Communications: Evolution and Impact on Business Operations</i> , 23 Technovation 515 (2003)
1022	Anthony Cataldo, <i>Kyocera Shows Portable Video Phone</i> , EDN (May 18, 1999), https://www.edn.com/kyocera-shows-portable-video-phone/
1023	Anita Wilhelm et al., <i>Photo Annotation on a Camera Phone</i> , CHI'04 Extended Abstracts of the 2004 Conference on Human Factors in Computing Systems 1403 (Apr. 2004)
1024	Risto Sarvas et al., <i>Metadata Creation System for Mobile Images</i> , Proceedings of the 2nd International Conference on Mobile Systems, Applications, and Services 36 (June 2004)
1025	Russell Beale, <i>Supporting Social Interaction with Smart Phones</i> , 4 IEEE Pervasive Computing 35 (Apr. – June 2005)
1026	BBC, <i>A History of Mobile Phones and Smartphones</i> , https://www.bbc.co.uk/bitesize/articles/z62gjfr (last visited July 10, 2025)
1027	Nenad Medvidovic, <i>Software Architectural Support for Handheld Computing</i> , 36 Comput. 66 (Sept. 2003)
1028	Tim Kindberg et al., <i>The Ubiquitous Camera: An In-depth Study of Camera Phone Use</i> , 4 IEEE Pervasive Computing 42 (2005)

Ex.	Description
1029	<i>App</i> , Britannica, https://www.britannica.com/technology/mobile-app (last visited July 10, 2025)
1030	U.S. Patent Application No. 11/449,958
1031	U.S. Provisional Application No. 60/689,101
1032	Matt Curtin, <i>Write Once, Run Anywhere: Why it Matters</i> (Apr. 9, 1998)
1033	Memorandum from the Chief Admin. Pat. Judge on Guidance on USPTO's Recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (Mar. 24, 2025), https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf ("Interim Procedure for Discretionary Denials")
1034	United States District Courts – National Judicial Caseload Profile (for period ending June 30, 2025), https://www.uscourts.gov/data-news/data-tables/2025/06/30/statistical-tables-federal-judiciary/c-5 ("Caseload Stats")
1035	U.S. District Courts – Table C-5. Median Time Intervals from Filing to Disposition of Civil Cases Terminated (for period ending June 30, 2025), https://www.uscourts.gov/data-news/data-tables/2025/06/30/statistical-tables-federal-judiciary/c-5 (printed July 31, 2025) ("Median Time Intervals")
1036	Lex Machina, District Judge Amos Louis Mazzant III: Federal District Court & Patent Cases Statistics (retrieved Oct. 28, 2025) ("Judge Mazzant Cases Statistics")
1037	RESERVED
1038	USPTO, Patent Trial and Appeal Board, https://www.uspto.gov/about-us/organizational-offices/patent-trial-and-appeal-board (last visited Oct. 15, 2025)

Ex.	Description
1039	<i>Reforming the Patent Trial and Appeal Board—The PREVAIL Act and Proposals to Promote U.S. Innovation Leadership: Hearing Before the Subcomm. on Intell. Prop., U.S. Sen. Comm. on the Judiciary</i> , 118th Cong. (Nov. 8, 2023) (statement of Joseph Matal, Clear IP, LLC)
1040	Memorandum Opinion and Order, <i>WAPP Tech Ltd. P’ship v. JPMorgan Chase Bank, N.A.</i> , No. 4:23-cv-01137 (E.D. Tex. Dec. 3, 2024), Dkt. No. 83
1041	Brief for the Federal Respondent in Opposition, <i>Gesture Tech. Partners, LLC v. Apple Inc.</i> , No. 24-1280 (U.S. Sept. 26, 2025), https://www.supremecourt.gov/DocketPDF/24/24-1280/378057/20250926164730081_24-1280_Gesture_Opp.pdf
1042	Sarah Perez, <i>Capital One Debuts New Apps To Accept Check Deposits By Phone</i> , TechCrunch (Dec. 3, 2012, 9:21 A.M. PST), https://techcrunch.com/2012/12/03/capital-one-debuts-new-apps-to-accept-check-deposits-by-phone/ (last visited Oct. 31, 2025)
1043	Jeffrey Kopchik, <i>Remote Deposit Capture: A Primer</i> , Supervisory Insights, (2009), https://www.fdic.gov/bank-examinations/remote-deposit-capture-primer-summer-09-article-2.pdf
1044	U.S. Patent No. 7,245,765 (“Myers”)
1045	Manual of Patent Examining Procedure (MPEP) ch. 900 (Mar. 2014), https://www.uspto.gov/web/offices/pac/mpep/old/e9r0/mpep-0900.pdf
1046	USPTO, USPC Class 703 – Data Processing: Structural Design, Modeling, Simulation, and Emulation (Jan. 2011), https://www.uspto.gov/web/patents/classification/uspc703/sched703.pdf
1047	USPTO, USPC Class 709 – Electrical Computers and Digital Processing Systems: Multicomputer Data Transferring (Jan. 2011), https://www.uspto.gov/web/patents/classification/uspc709/sched709.pdf

Ex.	Description
1048	USPTO, USPC Class 715 – Data Processing: Presentation Processing of Document, Operator Interface Processing, and Screen Saver Display Processing (Feb. 2011), https://www.uspto.gov/web/patents/classification/uspc715/sched715.pdf
1049	USPTO, USPC Class 345 – Computer Graphics Processing and Selective Visual Display Systems (Jan. 2011), https://www.uspto.gov/web/patents/classification/uspc345/sched345.pdf
1050	Manual of Patent Examining Procedure (MPEP) ch. 2100 (Mar. 2014), https://www.uspto.gov/web/offices/pac/mpep/old/e9r0/mpep-2100.pdf
1051	[Model] Order Focusing Patent Claims and Prior Art to Reduce Costs (E.D. Tex.), https://www.txed.uscourts.gov/sites/default/files/forms/ModelPatentOrder.pdf (last visited Oct. 27, 2025)
1052	Transcript of Case Management Conference, <i>Wapp Tech Ltd. P'ship v. Apple Inc.</i> , No. 4:25-cv-00230 (E.D. Tex. Oct. 27, 2025) (“CMC Tr.”)
1053	USPTO, USPC Class 345 – Computer Graphics Processing and Selective Visual Display Systems: Classification Definitions (Jan. 2011), https://www.uspto.gov/web/patents/classification/uspc345/defs345.pdf
1054	Order, <i>Wapp Tech Ltd. P'ship v. Apple Inc.</i> , No. 4:25-cv-00230 (E.D. Tex. Oct. 29, 2025), Dkt. No. 85 (“Claim Narrowing Order”)
1055	Exhibit A-15a to Defendant’s Invalidity Contentions, Invalidity of U.S. Patent No. 8,924,192 over Nokia 3650 User Guide, <i>WAPP Tech Ltd. P'ship v. JPMorgan Chase Bank, N.A.</i> , No. 4:23-cv-01137 (E.D. Tex.)
1056	Exhibit H to Plaintiff’s First Amended Complaint, <i>Wapp Tech Ltd. P'ship v. Apple Inc.</i> , No. 4:25-cv-00230 (E.D. Tex. Aug. 15, 2025)

I. Introduction

Petitioners Capital One N.A. and Capital One Services, LLC (“Capital One”) submit this opposition to Patent Owner’s Bifurcated Discretionary Denial Briefing (“PO Brief,” Paper 6), filed by Patent Owner WAPP Tech Corp. (“WAPP”). Contrary to WAPP’s narrow depiction of the circumstances of this case, reviewing the ’192 patent is an appropriate use of Office resources. The Director should institute the Petition for a merits review and not deny the Petition discretionarily.

First, *Fintiv* supports institution, because there is little risk of duplication of efforts between the Board and district court. There is no trial date in the parties’ co-pending litigation, and statistics show that trial will most likely occur long after a final written decision issues—indeed, up to *seven months* after such a decision. There has also been no invalidity investment in the challenged claims in any previous litigation. And here, there will have been minimal, if any, investment in validity, because the case is still in the pleadings stage. Moreover, the Petition’s merits are strong, and other relevant considerations support review by the Board.

Second, WAPP has no legitimate claim to settled expectations in the ’192 patent’s challenged claims. The Office erred by failing to properly search for relevant prior art and failing to evaluate priority, and it allowed WAPP’s claims with insufficient scrutiny. WAPP’s inefficient litigation strategy and its inexplicable delay in asserting the challenged claims against any defendant cut deeply against

any entitlement to settled expectations, and instead support Capital One's settled expectations that facially invalid claims would not be asserted against banking functionality released over a decade ago and known even earlier. Further, the Board and its specially-trained judges are best equipped to review validity of these claims.

The Director should institute this case for a merits panel review.

II. Factual Background

In an attempt to evade review, WAPP mischaracterizes the history of the '192 patent. Primarily, WAPP's contention that the '192 patent's validity has been "confirmed" in a trial (PO Brief 1, 6) is inaccurate on multiple levels.

First, claims 60-69 challenged here were not asserted or evaluated in the sole trial (against MicroFocus) involving the '192 patent. The trial only implicated claims 1 and 2 (*see* Ex.2008, 1227:14-16); claims 60-69 contain different limitations and are directed to distinct subject matter. As a result, the previous MicroFocus trial is largely irrelevant to this IPR. Second, even for those claims, prior art invalidity wasn't evaluated: WAPP moved for judgment as a matter of law, contending there was "no invalidity case put on here as to 102 and 103." *Id.* 1272:3-4. The challenged claims are therefore not at all "battle-tested"—instead, they have escaped review; the Board can and should review them now. After WAPP's pervasive misrepresentations are corrected, the facts show institution is warranted.

III. The *Fintiv* Factors Weigh in Favor of Institution

WAPP's misapplication of *Fintiv* does not suggest denial is warranted; instead, each factor weighs favorably, or neutrally, for institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*").

A. Factor 2: No Trial Date Weighs in Favor of Institution

Contrary to WAPP's speculation, trial will likely commence after a final written decision issues. Factor 2 weighs strongly in favor of institution.

There is no scheduled trial date: it is "**TBD**." Ex.2038, 16. At minimum, this factor weighs neutrally, contrary to WAPP's argument.

Further, the Board considers "**median time-to-trial statistics**," which reveal that trial will occur well after a final written decision. *See* Ex.1033, 3 (emphasis added). Statistics show the median time from filing to trial of cases in the Eastern District of Texas as 25-26 months. Ex.1034, 35; Ex.1035, 2. For Judge Mazzant's patent cases specifically, this figure is roughly 28.5 months. Ex.1036, 2. Measured from WAPP's March 2025 complaint, trial will not occur until at least March 2027, or more realistically, August 2027—two to seven months **after** the projected statutory deadline for a final written decision. And WAPP filed an amended complaint on August 15, 2025, which may further delay the projected trial date. Finally, the litigation involves three unrelated defendants with infringement allegations against distinct products, such that a single trial is unlikely. Indeed, during the Case Management Conference ("CMC"), Judge Mazzant explicitly

acknowledged that he usually tries multiple defendants separately, further increasing the likelihood that Capital One's trial will occur well-after any final written decision. *See* Ex.1052, 16:11-14; *see USAA Fed. Sav. Bank v. PACid Techs., LLC*, IPR2025-00697, Paper 9, 2 (Dir. Aug. 14, 2025) (referring petition: "a [FWD] in this proceeding will [likely] issue before...trial occurs, reducing the immediate concern of inconsistent outcomes or significant duplication of efforts" because statistics suggested trial would begin after FWD, and no trial date was scheduled).

In the absence of a scheduled trial date, time-to-trial statistics (and, specifically, Judge Mazzant's time-to-trial statistics) are more reliable than WAPP's self-serving proposal to rely on the initial pretrial conference setting as suggesting the trial date. PO Brief 7-8. But even WAPP's evidence supports that trial is unlikely to occur before a final written decision. For example, the majority (70%) of the cases WAPP analyzes (the blue, orange, and unhighlighted cases) had their pretrial dates delayed past their original setting, a minimum of two months and as much as **53 months**. *Id.* 8. If the court's December 2026 pretrial conference is delayed by even two months (which is likely, as Judge Mazzant expressed during the CMC that he typically takes vacation in early December and does not maintain a normal trial docket in December months (*see* Ex.1052, 16:15-24)), trial will certainly occur after the final written decision, supporting institution. *See Mercedes-Benz Grp. AG v. Phelan Grp., LLC*, IPR2025-00413, Paper 13, 2 (Dir. June 25, 2025) (FWD likely

issuing before trial weighed against denial). Factor 2 weighs strongly against denial.

B. Factor 3: Limited Investment Weighs in Favor of Institution

The minimal investment in the parties' litigation strongly weighs in favor of institution. No previous trial has invested any time into the 10 challenged claims. No court has considered the prior art invalidity of the challenged claims. No court has considered the product-by-process claim construction issue raised in the Petition, and no court has considered the priority date issue for these claims.

In this case, as WAPP concedes, the parties are still currently in the pleadings stage. Capital One has not filed an answer, and its Motion to Dismiss remains pending. According to the proposed schedule, by institution (January 2026), invalidity contentions will be exchanged, but claim construction briefing will not yet have begun, and fact/expert discovery will not close until well after institution. *Catalyst Orthoscience Inc. v. Shoulder Innovations, Inc.*, PGR2024-00042, Paper 17, 14-15 (PTAB Dec. 19, 2024) (factor 3 weighed against denial where significant work remained, including *Markman* hearing and completion of fact/expert discovery). WAPP's citation to *Arthrex, Inc. v. Medshape, Inc.* (PO Brief 11) is inapposite; in the litigation, claim construction work hasn't started. IPR2025-00053, Paper 11, 10-11 (PTAB Apr. 25, 2025). WAPP's arguments referring to the "many briefs" and discovery requests (many of which WAPP conveniently sent on the same day it filed the PO Brief) are irrelevant: *Fintiv* considers only the work "as it relates

to invalidity,” not any work in the litigation. *Id.* 11. WAPP’s previous litigations are also irrelevant: WAPP’s counsel admitted that claim construction would “happen anew here” and wouldn’t be the same as in previous proceedings. Ex.1052, 9:11-13.

The limited investment in the parallel proceeding and circumstances here indicate this factor weighs against discretionary denial.

C. Factor 4: Limited Overlap Weighs in Favor of Institution

WAPP’s entire argument rests on speculation. PO Brief 11-12. **First**, invalidity contentions have not yet been served, and WAPP has not provided infringement contentions, so the extent of any overlap between the IPR and litigation is unknown. **Second**, WAPP repeatedly overdramatizes the number of claims in the litigation (*see, e.g.*, PO Brief 6), but during the CMC, its counsel conceded that “this isn’t...a 200-claim case.” Ex.1052, 7:11-12; *contra* PO Brief 2 (referencing 221 claims). And after the CMC, the Court ordered WAPP to narrow the case to 16 asserted claims before claim construction begins in February 2026, i.e., near the time of institution. Ex.1054, 6; Ex.1051, 3. **Third**, the Board is undoubtedly the correct forum to review these claims: the public record reflects that Judge Mazzant has not previously evaluated product-by-process claims, which WAPP concedes is a relevant doctrine for analyzing these claims. By contrast, the Board’s judges, all of whom have “extensive patent legal experience” (Ex.1038), including some with experience as patent examiners, and who regularly aid “decision-making on...thorny

scientific questions endemic to patent law” (Ex.1039, 4), are uniquely suited to evaluate these claims; indeed, the Board’s judges have specialized knowledge of, for example, relevant Federal Circuit precedent and MPEP §2113 (“Product-by-Process Claims”). *See also, e.g., Kamstrup A/S v. Axioma Metering UAB*, 43 F.4th 1374 (Fed. Cir. 2022) (affirming Board IPR decision construing claim as product-by-process). Further, the Board’s judges are uniquely qualified to evaluate the priority date issue.

The Board’s specialized relevant experience, and the unknown overlap between the IPR invalidity issues and those in litigation, strongly support review.

D. Factors 1 and 5: No Stay Motion and Same Parties Weigh Neutrally for Institution

Capital One has not requested a stay, so factor 1 weighs neutrally; WAPP’s contrary suggestion is wrong. *See, e.g., Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11, 10-11 (PTAB May 19, 2021).

Further, when the parties are identical, factor 5 is weighed neutrally. *See, e.g., Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 30, 13 (Dir. Dec. 3, 2024).

E. Factor 6: Other Circumstances, Including the Merits, Weigh in Favor of Institution

WAPP’s unpersuasive arguments against the Petition’s merits fail to outweigh the fact that every *Fintiv* factor weighs in favor of institution.

1. The Challenged Claims are Product-By-Process

First, WAPP argues that its claims are not product-by-process claims, alleging that the claims do not “facially resemble a ‘product-by-process’ claim.” PO Brief 13.

WAPP is wrong: the product-by-process determination does not turn on the presence or absence of magic words. For example, as WAPP recognizes, the claims at issue in *Greenliant* did not use “product” or “process” yet were construed as product-by-process. *Greenliant Sys., Inc. v. Xicor LLC*, 692 F.3d 1261, 1268 (Fed. Cir. 2012).

Whether previous defendants construed claim 60 as product-by-process is also irrelevant. *See* PO Brief 13-14. As detailed below, claim 60 was only asserted against JPMorgan. And as Judge Mazzant recognized in granting JPMorgan leave to amend its answer to add allegations of WAPP’s inequitable conduct,¹ it is incorrect “to infer irrelevance from silence” (Ex.1040, 5)—JPMorgan’s decision to not advocate a product-by-process construction is immaterial to the correct claim construction. But WAPP is also wrong: JPMorgan **did** recognize claim 60 was a product-by-process claim. *See, e.g.*, Ex.1055, 13 (arguing limitation 60[b] is “directed to the process”).

WAPP’s argument that an application or software component cannot be a product-by-process is likewise wrong: the Federal Circuit has affirmed the Board’s conclusion that a software-focused claim was a product-by-process claim. *See In re Downing*, 754 F. App’x 988 (Fed. Cir. 2018) (nonprecedential). The determination

¹ Notably, less than three weeks after Judge Mazzant allowed JPMorgan’s inequitable conduct defense, WAPP and JPMorgan settled, suggesting WAPP’s “settled expectations” (addressed further below) suddenly became unsettled.

turns on claim language, as it must, not the particular technology. *In re Power Integrations, Inc.*, 884 F.3d 1370, 1376 (Fed. Cir. 2018) (“[C]laim construction must begin with the words of the claims themselves.”) (citation omitted)). Here, the product (the “application configured to enable a user to modify a photo on the mobile device”) is defined by the process by which it is made—i.e., development “using a software authoring platform” as recited. Ex.1001, cl. 60.

This conclusion is entirely in accord with WAPP’s own statements: WAPP accuses infringement because the “‘Capital One Mobile’ application” (a product) allegedly “was developed using ‘a software authoring platform configured to simultaneously emulate...’” (by a process), just as claim 60 recites. Ex.2001 ¶28. These statements parallel WAPP’s accusations against the other defendants. *See id.* ¶¶15 (Apple’s “Photos app was developed...”), 37 (“Frost’s application...was developed”). Even if construing a software application as product-by-process was a novel theory (it is not), that would be even more supportive of the Board’s review. *Cf.* 35 U.S.C. §324(b) (authorizing PGR institution when petition “raises a novel or unsettled legal question that is important to other patents....”).

WAPP’s merits arguments against a correct product-by-process construction fail, and the strength of Capital One’s Petition weighs in favor of institution.

2. The Challenged Claims are Not Entitled to Earlier Priority

WAPP’s second argument, against the Petition’s Ground 2, fares no better. Dr.

Medvidovic provided exhaustive testimony demonstrating and supporting his conclusion that a POSITA would understand that the '543 application did not contain written description support for the claimed limitations reciting an application configured to enable a user to modify a photo on a mobile device. WAPP's conclusory arguments, supported by only attorney argument and not any evidence, do not disturb that reasoned conclusion for multiple reasons.

First, WAPP's attempt to leverage the discussion of "image manipulation" to support "modification of an image" is inconsistent with the '543 application and its infringement contentions. PO Brief 15-16. The '543 application's "image manipulation" examples are "retrieving data from non-volatile storage, Avatar manipulations, animations, etc." (Ex.1004 ¶43). None of these "manipulation" functions correspond to, or provide written description support for, the claimed **user modifications** to a **photo**. WAPP's infringement theory alleges "modifications" that include "resizing, scaling, cropping, filtering, reformatting, and color adjustment" and WAPP doesn't establish equivalence between these allegedly-infringing options and the '543 application's different operations. Ex.1056, 63; *cf. Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1359-60 (Fed. Cir. 2017) ("prosecution disclaimer ensures that claims are not 'construed one way in order to obtain their allowance and in a different way against accused infringers'" and extending doctrine to IPR). Thus, WAPP is incorrect: Capital One does dispute that the application being developed,

as described in the '543 application, supports user photo modification (it does not (*see* Pet.44)) and conceded nothing like WAPP alleges.

Second, WAPP admits, as it must, that the '543 application passage doesn't support a user modifying a photo, turning instead to selective language from the provisional application. PO Brief 16-17. This, too, fails to satisfy WAPP's burden. WAPP doesn't establish, for example, whether the "ImageVu™," "Active2Play™ Consumer" and "Active2Play™ UI" components (Ex.1031, 10) are one application or many, much less that they support user photo modification on a mobile device as required. WAPP's statement that the "2005 provisional" allows "the user to customize graphics within those applications" is an unsupported conclusory allegation contradicted by WAPP's evidence. PO Brief 17. The customizing or personalization discussion of components in the provisional states only that these functions occur "Over-the-Air"—i.e., any customization or personalization (if that even included photo modification, which is not established or conceded) is **received** wirelessly from, e.g., a server, not performed by a user on a mobile device as written description support would require.

Third, WAPP doesn't establish the provisional application's support for the claim **as a whole**. WAPP's arguments only pertain, at best, to the "application configured to enable a user to modify a photo on the mobile device" language, but WAPP doesn't attempt to show that the provisional supports the rest of the claim—

i.e., the “process” portion of claim 60 reciting how the application is developed.

WAPP’s attempt to cobble together disparate disclosures of the ’543 application and its provisional, in the absence of any supporting evidence from an expert, does not reveal any weakness in the Petition. WAPP’s argument does not establish adequate written description support for the challenged claims’ photo modification application, much less the claim as a whole (as required). Capital One’s argument that the claims are not supported by any earlier application in the family remains correct. Ground 2’s strong merits further support institution.

IV. Additional Considerations Also Favor Institution

Capital One’s settled expectations and numerous other facts outweigh WAPP’s settled expectations. WAPP argues that “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.” PO Brief 18. That is wrong at least four times over, including because Capital One certainly had no expectations—let alone settled—that WAPP would claim infringement related to technology Capital One brought to market more than 13 years ago.

First, WAPP’s assertion that the ’192 patent has “withstood previous litigation challenges to its validity” is inaccurate as related to this proceeding. *Id.*. The claims challenged in Capital One’s IPR have **never** been subject to a litigation validity challenge; indeed, the public record shows that only claims 60-61 and 65

were at issue in the previous JPMorgan litigation (*see* Ex.2020, 16), which terminated before validity was evaluated, and shortly after JPMorgan was granted leave to show WAPP's inequitable conduct during prosecution. WAPP's assertions of the '192 patent before the JPMorgan litigation did not include claim 60 or its dependent claims. So, contrary to WAPP's argument, challenged claims 60-69 have never been tested, and the Board should conduct a merits evaluation of these claims.

Second, WAPP's argument that the Board should not use its limited resources for a near-expiring patent is contradicted by controlling law and the Office's own arguments. PO Brief 18. The Board has jurisdiction over IPRs concerning expired patents. *See Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 368 (Fed. Cir. 2025). As the Department of Justice recently argued in opposing the petition for certiorari seeking review of that decision, any contention against "inter partes review...of an expired patent" "is inconsistent with" Supreme Court precedent and "constitutional text and history." Ex.1041, 10 (citing *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 584 U.S. 325 (2018)). Indeed, "the possibility of inter partes review" after a patent's expiration "is 'one of th[e] conditions' that Congress has permissibly placed on the initial patent grant." *Id.* 15 (citing *Oil States*, 584 U.S. at 342). Accordingly, when WAPP filed, in November 2012, the application that led to the '192 patent, it did so knowing IPRs were the law of the land, and understood any resultant patent grant would be expressly conditioned on the possibility of IPR.

Third, WAPP's assertions that the Office did not err fail to withstand scrutiny.

The Office's multiple errors during prosecution are detailed in Section V, *infra*.

Fourth, the settled expectations of the "parties," including Petitioner Capital One must be considered. A petitioner arguing it "did not have reason to anticipate assertion of the patent," as here, weighs in favor of Capital One's expectations and review, against WAPP's settled expectations, and outweighs considerations favoring discretionary denial. *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11, 2-3 (Dir. Sept. 4, 2025). WAPP's previous patent assertions only alleged infringement by software development tools; WAPP did not accuse functionality within any mobile banking applications, including check deposit functionality, as allegedly infringing its '192 patent. *See, e.g.*, Ex.2019 ¶74 (alleging infringement when JPMorgan employees "use Apple's Xcode or Google's Android Studio...to author mobile applications"); Ex.1040, 1 (identifying same). The complaint and briefs in the JPMorgan case's public record don't mention check deposit functions.

It was only in 2025, against Capital One, that WAPP asserted claim 60 against mobile application check deposit functionality. *See* Ex.2001, 12 n.15. But Capital One first released mobile check deposit functionality as early as **2012** (*see* Ex.1042), before the challenged claims were added during prosecution (in April 2014), and well before WAPP's first assertion against this technology. And this functionality was well known even before 2012; for example, an FDIC report states that remote

check deposit functionality was enabled by the “Check Clearing for the 21st Century Act” passed in October 2004 (Ex.1043, 1, 6), **before** the ’192 patent’s claimed priority date. Mobile device-based check capture technology was known at least by November 2004. *See* Ex.1044, Abstract (“capturing paper-based information on a mobile computing device”), 2:24-30 (“mobile computing device (e.g., a cellular phone, a digital camera...[)]”), 2:41-46 (“‘paper-based information’...such as information found on...checks”). By 2025, when WAPP filed its complaint against Capital One, Capital One had a settled expectation that its mobile application-based check deposit functionality **did not** infringe the ’192 patent (and it maintains that belief to this day), and had no reason to anticipate WAPP’s assertion. Capital One’s settled expectations of non-assertion greatly outweigh WAPP’s expectations, especially given WAPP’s lack of, and delayed, assertion of the challenged claims.

Additionally, the lack of commercialization, marking, and licensing of WAPP’s claims cut against WAPP’s settled expectations claim and favor review. *See Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2-3 (Dir. June 26, 2025). For example, while products commercializing the challenged claims must be marked (*see* 35 U.S.C. §287(a)), WAPP hasn’t provided evidence of marking compliance, and WAPP is a non-practicing entity that hasn’t shown it commercialized the patent or commercialization or marking by licensees.

WAPP’s settled expectations arguments are also contradicted by precedent

and statute. WAPP would have expected patent validity challenges upon assertion. *See Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-62 (Fed. Cir. 2019) (patent owners have had “expectation...for nearly four decades” that “patents are open to PTO reconsideration”). And while Congress has expressly immunized patents of a certain age from post-issuance challenges (*see, e.g.*, H.R. Rep. No. 112-98, pt. 1, at 46-48 (2011) (certain patents immunized from *inter partes* reexamination)) or provided other limits (*see* AIA §§3(n)(1), 6(f)(2)(A) (immunizing from PGR); AIA §18 (CBMs sunset)), Congress took the opposite approach for IPRs, eliminating any date-based carveout such that “**all patents can be challenged** in” IPR, regardless of age. *See* H.R. Rep. No. 112-98, at 46-48 (emphasis added). “Congress’s choice to depart from the model of a closely related statute is a choice neither we nor the agency may disregard.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 364 (2018).

Capital One’s settled expectations weigh in favor of institution, and outweigh WAPP’s arguments of settled expectations.

V. Multiple Office Errors Favor Institution

The Office’s errors in allowing the ’192 patent’s challenged claims 60-69 without sufficient scrutiny weigh heavily in favor of institution.

Section 325(d) does not apply because the “same or substantially the same prior art” was not presented to the Office. 35 U.S.C. §325(d). Further, the Office’s errors detailed below overcome any previous prior art consideration.

WAPP first argues that the Examiner did not err in failing to cite Poulin-910 against the claims, because Poulin-910 is the “identical grandparent application.” PO Brief 18-19. But the Board and Federal Circuit routinely invalidate later-issued claims over earlier-issued patents in the same family where the later-issued claims are not entitled to earlier priority. *See, e.g., Flex Logix Techs., Inc. v. Konda*, IPR2020-00260, Paper 55 (PTAB July 29, 2021), *aff’d sub nom. Konda v. Flex Logix Techs., Inc.*, 2022 WL 1436144 (Fed. Cir. May 6, 2022). And the Federal Circuit commonly evaluates claims of priority in continuation applications with identical disclosures as a parent patent, and finds later-issued claims to lack §112 support and priority in the parent. *See, e.g., Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365 (Fed. Cir. 2023). The Examiner’s errors in not finding Poulin-910 to be prior art, and in not rejecting the claims over teachings in Poulin-910, support review.

Further, when an applicant adds new claims during prosecution, the MPEP instructs Office personnel to “determine whether applicant has demonstrated that the inventor was in possession of the claimed invention.” MPEP §2163 (Ex.1050). After WAPP added claims 60-69 during prosecution (*see* Ex.1002, 93-95) and identified Figures 1A and 8-13 and their associated description as allegedly providing support, the examiner should have reviewed the claims and specification and rejected the claims under §112 for not being supported by the written description: neither those figures nor their associated description support the recited photo modification

capability. In fact, even now, WAPP doesn't point to Figures 1A or 8-13 or their associated description in its allegations of support, conceding that those portions of the specification don't support the claims. WAPP instead relies on the description associated with Figure 2. *See* PO Brief 16 (citing "image manipulation" in Ex.1004 ¶43); Ex.1004 ¶43 (discussing Fig. 2). WAPP's arguments support that error occurred when the added, and now challenged, claims weren't rejected under §112.

WAPP next argues that the Examiner's search strategy was adequate, and that the "Examiner did not err by searching other limitations similar to limitations in many other claims." PO Brief 19. That argument flouts the MPEP, which requires the examiner to acquire a "thorough understanding of the invention disclosed **and claimed**" (MPEP §904 (Ex.1045 (emphasis added))) and the examiner's search is only compliant when the examiner considers areas of art with the highest probability of finding prior art "relevant to the **invention**," not just individual limitations. Though the examiner performed a search after WAPP added its new claims, there is no record of the examiner's search strategy, e.g., the keywords used in the examiner's search, and thus there is no record that the examiner considered "all areas with the highest probability of finding prior art relevant to the invention" as required.

Instead of relying on the art areas relevant to the previously examined claims, the examiner should have reviewed areas of prior art that were more likely to contain art relevant to the recited "application configured to enable a user to modify a photo

on the mobile device.” The Examiner did not do so. After the new claims were added, searches were performed in USPC 703 (“Data processing...modeling”), 709 (“multicomputer data transferring”), and 715 (“Data processing”). Ex.1002, 107; Exs.1046-1048. But conspicuously, and erroneously, missing from the Examiner’s searches was, for example, USPC 345, “Computer Graphics Processing” (*see* Exs.1049, 1053), which would have contained prior art related to image “Rotation” (Ex.1053, 39) and “Scaling” (*id.* 40), and “Character and graphics” functionality (*id.* 38; *see also* Ex.1001, cl. 62) and is accordingly an area of art relevant to the recited “application” for “modifying a photo” that the examiner missed. Thus, the examiner erred in not searching “all areas” of prior art “relevant to the invention” contrary to the instructions in the MPEP, yet another error supporting review. *See also* USAA, IPR2025-00697, Paper 9, 2-3 (error to maintain same prior art in child application as in parent applications when child application is directed to different technology).

Given these and other numerous errors by the Office during examination, the “first-action allowance” of claims 60-69 was “an error or oversight” by the Office, supporting institution. *See Shenzen Chic Elecs. Co. v. Pilot, Inc.*, IPR2023-00810, Paper 12, 21 (PTAB Nov. 8, 2023) (where prior art taught or suggested all claims’ limitations, first-action allowance was “error or oversight”).

VI. Process Memorandum Relevant Considerations Favor Institution

Process Memorandum factors 4 and 7 also support referral.

A. Reliance on Expert Testimony Supports Institution (Factor 4)

Consistent with precedent and Office guidance, Dr. Medvidovic's testimony (Ex.1003) weighs towards institution because it details relevant technologies, summarizes the art, and presents evidence-backed support for why and how the art would be combined to render obvious the claims. WAPP doesn't address this factor.

B. Other Considerations Support Institution (Factor 7)

WAPP's litigation strategy, serially asserting patents against defendants alleging infringement by similar products, imposes inefficiencies on the courts and Office, and justifies review. Also, the litigation involves three defendants with different products allegedly infringing the challenged claims (Apple's Photos app, Capital One's banking app, and Frost's banking app). Because "the litigation between the parties would" involve different issues and likely "proceed to several district court trials," addressing the challenged claims "at the Office would be more efficient." *Harbor Freight Tools USA Inc. v. Champion Power Equip., Inc.*, IPR2025-00805, Paper 20, 2 (Dir. Sept. 19, 2025). This is especially true where no trial date has been set and the parties have made little investment in the litigation.

VII. Conclusion

The litigation's early stage and resultant lack of potential overlap and duplication of efforts, the Office errors that occurred during prosecution, the strong merits of the Petition, and the relevant discretionary considerations, collectively demonstrate that the Director should institute the Petition for a merits evaluation.

Respectfully submitted,

Dated: October 31, 2025

By: / Raghav Bajaj /

Raghav Bajaj (Reg. No. 66,630)
raghav.bajaj@lw.com
Latham & Watkins LLP
300 Colorado Ave., Suite 2400
Austin, TX 78701
Telephone: 737.910.7370
Fax: 737.910.7301

*Counsel for Petitioners
Capital One, N.A. and Capital
One Services, LLC*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 31st day of October, 2025, a true and correct copy of the foregoing **Petitioners' Opposition to Patent Owner's Bifurcated Discretionary Denial Brief and all Exhibits** were served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

Kyle Friesen (Reg. No. 65,371)
Lily R. Glick (Reg. No. 78,569)
Heim Payne & Chorush, LLP
609 Main Street, Suite 3200
Houston, TX 77002
Telephone: (713) 221-2000
Facsimile: (713) 221-2021
kfriesen@hpcllp.com
lglick@hpcllp.com
wapptt@hpcllp.com

By: / Raghav Bajaj /

Raghav Bajaj (Reg. No. 66,630)
raghav.bajaj@lw.com
Latham & Watkins LLP
300 Colorado Ave., Suite 2400
Austin, TX 78701
Telephone: 737.910.7370
Fax: 737.910.7301

*Counsel for Petitioners
Capital One, N.A. and Capital
One Services, LLC*