

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FINTIV, INC.,
Patent Owner.

IPR2022-00976
Patent 9,892,386 B2

Before MICHAEL R. ZECHER, LYNNE E. PETTIGREW, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner, Apple Inc. (“Apple”), filed a Petition requesting *inter partes* review (“IPR”) of claims 1–3 of U.S. Patent No. 9,892,386 B2 (Ex. 1001, “the ’386 patent”). Paper 2 (“Pet.”). Patent Owner, Fintiv Inc. (“Fintiv”), filed a corrected Preliminary Response. Paper 7 (“Prelim. Resp.”). We granted the parties authorization to file preliminary briefs that were tailored narrowly to address the non-exclusive list of six factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”) that we consider in determining whether to exercise our discretion to institute an IPR when there is a related district court case involving the same patent. Apple filed a Preliminary Reply (Paper 8 (“Prelim. Reply”)); however, Fintiv elected not to file a preliminary sur-reply.

Based on the authority delegated to us by the Director under 37 C.F.R. § 42.4(a), we may not institute an IPR unless the information presented in the Petition and any response thereto shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). Taking into account Fintiv’s Preliminary Response, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Apple would prevail in challenging at least one of claims 1–3 of the ’386 patent as unpatentable. Pursuant to § 314, we hereby institute an IPR as to these claims of the ’386 patent.

A. *Related Matter*

The parties indicate that the ’386 patent is the subject of the district court case captioned *Fintiv, Inc. v. PayPal Holdings, Inc.*, No. 6:22-cv-

00288 (W.D. Tex.) (complaint filed Mar. 17, 2022) (“Texas Action”).

Pet. 1; Paper 4 (Fintiv’s Mandatory Notices), 2.¹

B. Real Party in Interest

Apple identifies itself as the only real party in interest. Pet. 1.

Fintiv identifies itself as the only real party in interest. Paper 4, 2.

C. The ’386 Patent

The ’386 patent, titled “Monetary Transaction System,” issued from U.S. Patent Application No. 15/201,152 (“the ’152 application”), filed on July 1, 2016. Ex. 1001, codes (54), (21), (22). The ’152 application includes an extensive chain of priority that ultimately results in it claiming the benefit of U.S. Provisional Patent Application No. 61/493,064 (“the ’064 application”), filed on June 3, 2011. *Id.* at code (60), 1:6–19.

The ’386 patent generally relates to a “monetary transaction system for conducting monetary transactions between transaction system subscribers and other entities.” Ex. 1001, 1:37–38. Figure 2 of the ’386 patent, reproduced below, illustrates one embodiment of a monetary transaction system. *Id.* at 2:37–38.

¹ Fintiv’s Updated Mandatory Notices, filed in accordance with 37 C.F.R. § 42.8, do not include page numbers. Paper 4. We consider the Title page as page 1 and then proceed from there in numerical order.

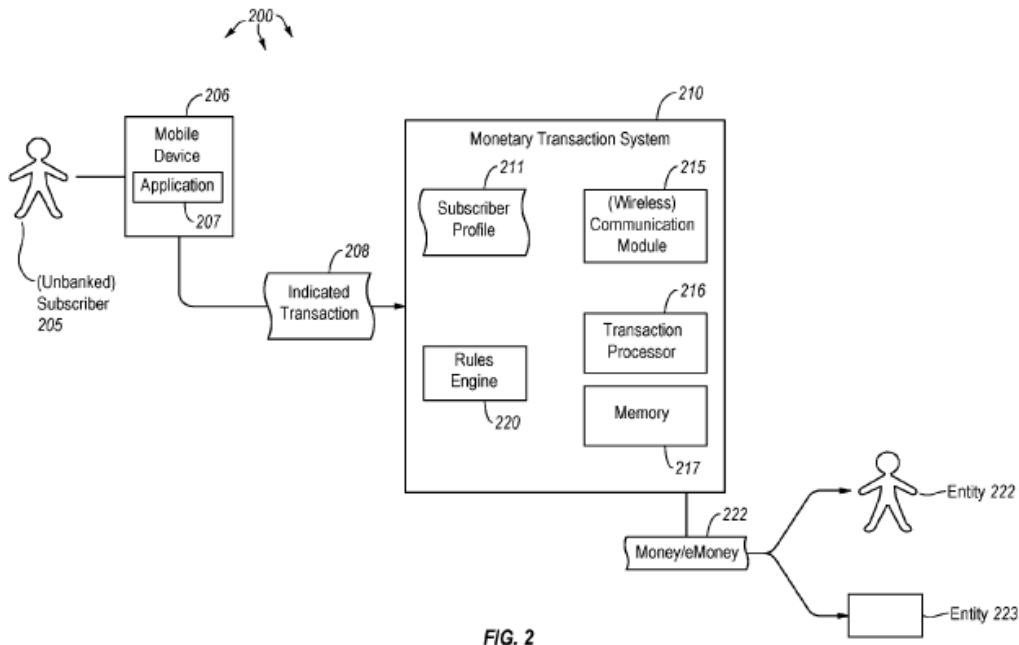


Figure 2, reproduced above, illustrates monetary transaction system 200 that includes first subscriber 205 using mobile device 206 that runs mobile wallet application 207 to conduct indicated transaction 208 with entity 222 or 223, which may be a second subscriber, a retail store, or an agent company. *Id.* at 14:27–64. Using mobile device 206 that runs mobile wallet application 207, first subscriber 205 sends indicated transaction 208 to transaction processor 216 in mobile wallet platform 210, which, in turn, may access subscriber profile information 211 about the first subscriber and consult rules engine 220 to determine whether the indicated transaction is permissible. *Id.*

D. Challenged Claims

Of the challenged claims, claims 1–3 are independent claims. Each of these three independent claims is directed to “[a] monetary transaction system for conducting monetary transactions between subscribers and other entities.” Ex. 1001, 30:54–55, 32:3–4, 33:34–35. The parties, however, appear to agree that these three independent claims differ in how the

monetary transaction is conducted (i.e., depositing in independent claim 1, withdrawing in independent claim 2, and transferring in independent claim 3). *Compare* Pet. 6, *with* Prelim. Resp. 7. Independent claim 1 is illustrative of the challenged claims and is reproduced below:

1. A monetary transaction system for conducting monetary transactions between subscribers and other entities, the system comprising one or more of:
 - an integration tier operable to manage mobile wallet sessions, the integration tier also including a communication application programming interface (API) and other communication mechanisms to accept messages from channels;
 - notification services operable to send notifications through different notification channels including one or more of short message peer-to-peer, short-message services and simple mail transfer protocol emails;
 - business process services operable to implement business workflows, including at least one of executing financial transactions, auditing financial transactions, invoking third-party services, handling errors, and logging platform objects;
 - database services operable to store financial transaction details, store customer profiles, and manage money containers;
 - a payment handler service operable to use APIs of different payment processors including one or more APIs of banks, credit and debit cards processors, bill payment processors;
 - a rules engine operable to gather financial transaction statistics and use the gathered financial transaction statistics to enforce constraints including transaction constraints;
 - a security service operable to perform subscriber authentication;
 - at least one entity that is to be involved in the specified transaction, the at least one entity having a profile with the monetary transaction system: wherein the at least one entity is the agent;
 - wherein the monetary transaction system is implemented to deposit funds at an agent branch, the funds being deposited

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