

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE

MASTERCARD INCORPORATED and
MASTERCARD INTERNATIONAL INCORPORATED,
Petitioner,

v.

OV LOOP, INC.,
Patent Owner.

IPR2023-01289
Patent 10,032,171 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Granting Director Review and Remanding to the Patent Trial
and Appeal Board for Further Proceedings

The Board issued a Final Written Decision (Paper 37, “Decision”) for the above-captioned case, finding that Mastercard Incorporated and Mastercard International Incorporated (“Petitioner”) had shown that claims 1–33 of U.S. Patent No. 10,032,171 are unpatentable as obvious over Collinge.¹ Decision 64–65.

OV Loop, Inc. (“Patent Owner”) filed a request for Director Review of the Decision and Petitioner filed an authorized response. *See* Paper 39 (“DR Request”), Paper 40. In its request, Patent Owner argues that the Board erred because it relied on components of Collinge that were outside of Petitioner’s identified “remote computer system” to meet the functionality of the “remote computer system” of claim 10. *See* DR Request 1, 6–9, 11. In particular, Patent Owner argues that the Petition relies on Collinge’s disclosure that the point-of-sale (POS) terminal may transmit transaction information to acquirer processing server 312, yet Petitioner does not identify this server as part of the alleged “remote computer system” of claim 10. *See id.* at 7 (citing Pet. 58 (citing Ex. 1011 ¶ 77)).

Petitioner argues in response that, for claim 10’s “remote computer system” functionality, it relies on Collinge’s issuer processing server 308 to validate a received authorization request, which is transmitted through payment network 124. *See* Paper 40, 3–4.

The Board’s Decision includes some discussion of Patent Owner’s arguments and concludes the discussion by adopting Petitioner’s contentions “as supported by the evidence cited by Petitioner” notwithstanding that Patent Owner disputed some of Petitioner’s contentions. Decision 57, 59 (citing Paper 1, 58–61; Paper 26, 24–25); *see also id.* at 56 (adopting

¹ US 2013/0262317 A1, published Oct. 3, 2013 (Ex. 1011).

Petitioner's contentions, citing Paper 1, 58–60). The Board also found that Petitioner's identification of Collinge's "remote computer system" was not limited to "remote-SE system 110," but also "include[s] other aspects of the Collinge computer system that Petitioner expressly relies upon, as shown in the annotated version of Collinge Figure 7 provided by Petitioner in Reply." *Id.* at 57 (citing Paper 26, 16–18).²

In reviewing the record, it is unclear which of Collinge's components the Board relied on for claim 10's limitation "receiving [at the remote computer system] an authorization request to authorize the transaction from the POS terminal." Accordingly, Director Review is granted, and this case is remanded to the Board for consideration of the arguments made in Patent Owner's DR Request.

On remand, the Board shall consider Patent Owner's arguments as to claims 10 and 27, and their dependent claims. Regardless of the Board's disposition on remand, the Board should address Patent Owner's arguments and explain more fully its findings as to claims 10 and 27. The Board should point more specifically to where in Collinge the argued limitation is taught, if anywhere, and which components of Collinge satisfy the limitation, if any. In doing so, the Board should limit itself to the teachings on which Petitioner relies.

Absent good cause, the Board shall issue a decision on remand within 30 days of this Order.

² Notably, Petitioner's annotated Figure 7 of Collinge on page 16 of Petitioner's Reply (Paper 26) has different item numbering and descriptions than Petitioner's annotated Figure 7 of Collinge's provisional (U.S. Provisional App. No. 61/619,095, Ex. 1009) on page 17 of Petitioner's Reply.

Accordingly, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the case is remanded to the Board for further proceedings consistent with this Order.

IPR2023-01289
Patent 10,032,171 B2

For PETITIONER:

Eliot D. Williams
Jennifer Tempesta
BAKER BOTTS L.L.P
eliot.williams@bakerbotts.com
jennifer.tempesta@bakerbotts.com

For PATENT OWNER:

Seth Lindner
Brett Cooper
BC LAW GROUP, P.C.
slindner@bc-lawgroup.com
bcooper@bc-lawgroup.com

Robert A. Auchter
AUCHTER PLLC
robert@auchterlaw.com