No. 2022-1963

In the
United States Court of Appeals
for the Federal Circuit

MANTISSA CORPORATION,

Plaintiff-Appellant,

v.

FIRST FINANCIAL CORPORATION; FIRST FINANCIAL BANK, N.A.,

Defendants-Appellees.

_____

Appeal from the United States District Court
for the Northern District of Illinois in Case No. 1:17-cv-09174.
The Honorable Virginia M. Kendall Presiding.

**MANTISSA CORPORATION'S COMBINED PETITION
FOR PANEL AND EN BANC REHEARING**

JOHN DEMARCO
YOUNG BASILE HANLON
& MACFARLANE, P.C.
700 Milam St., Suite 1300
Houston, TX 77002
(832) 871-5058

*Counsel for Plaintiff-Appellant
    Mantissa Corporation*

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number   2022-1963

Short Case Caption   Mantissa Corporation v. First Financial Corporation

Filing Party/Entity   Mantissa Corporation

Instructions:

1. Complete each section of the form and select none or N/A if appropriate.

2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.

3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.

4. Please do not duplicate entries within Section 5.

5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 03/20/2024

Signature: /s/ John Demarco

Name: John Demarco

i

FORM 9. Certificate of Interest

<div align="right">Form 9 (p. 2)
March 2023</div>

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☐ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☐ None/Not Applicable
Mantissa Corporation	None	None

<div align="center">☐   Additional pages attached</div>

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☐   None/Not Applicable   ☐   Additional pages attached

McDonald Hopkins LLC	Nicholas A. Kurk	

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

☑ Yes (file separate notice; see below)   ☐ No   ☐ N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☐   None/Not Applicable   ☐   Additional pages attached

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

<u>NOTICE OF RELATED CASE INFORMATION</u>

Case Number   2022-1963

Short Case Caption   Mantissa Corporation v. First Financial Corporation

Filing Party/Entity   Mantissa Corporation

Instructions: Do not duplicate information. The notice must only be filed at the time of filing the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. *See* Fed. Cir. R. 47.5(b). Attach additional pages as needed. This notice must not be included in a motion, petition, related response, or brief; please only include the Certificate of Interest (Form 9) in those documents.

---

1. **Related or prior cases.** Provide the case title, case number, and originating tribunal for each case. Fed. Cir. R. 47.5(b)(1).

Mantissa Corporation v. Great American Bancorp, Inc. et al., 2:18−cv−02103, U.S. District Court, Central District of Illinois

Mantissa Corporation v. FiServ Solutions, LLC, et al., 1:19−cv−03204, U.S. District Court, Northern District of Illinois

Mantissa Corporation v. Old Second Bancorp, Inc, et al., 1:17−cv−09175, U.S. District Court, Northern District of Illinois

Mantissa Corporation v. Polish & Slavic Federal Credit Union, et al., 1:17−cv−09176, U.S. District Court, Northern District of Illinois

---

☐   Additional pages attached

2. **Names of all parties involved in the cases listed above.** Do not duplicate the names of parties. Do not relist the case information. Fed. Cir. R. 47.5(b)(2)(A).

Great American Bancorp, Inc.; First Federal Savings Bank of Champaign-Urbana;

FiServ Solutions, LLC; Fiserv, Inc.;

Old Second Bancorp, Inc,; Old Second National Bank;

Polish & Slavic Federal Credit Union

☐   Additional pages attached

3. **Names of all law firms, partners, and associates in the cases listed above.** Do not duplicate the names of law firms, partners, and associates. Do not relist case information and party names. Fed. Cir. R. 47.5(b)(2)(B).

Krauskopf Kauffmann, P.C. (Stuart P. Krauskopf, Jamie S. Ritchie, Howard Schusteff, Amber S. Hemberger)

Wilson Sonsini Goodrich & Rosati, P.C. (Ryan R. Smith, Anjuli V. Nanda)

Meyer Capel (Lorna K. Geiler)

☐   Additional pages attached

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 03/20/2024

Signature: /s/ John Demarco

Name: John Demarco

TABLE OF CONTENTS

TABLE OF AUTHORITIES

RULE 35(b) STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States or the precedent(s) of this court: *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014); *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374 (Fed. Cir. 2015); *Biagro W. Sales, Inc. v. Grow-More, Inc.*, 423 F.3d 1296, 1302 (Fed. Cir. 2005); *Nevro Corp. v. Boston Scientific Corp.*, 955 F.3d 35 (2020); *Dow Chem. Co. v. NOVA Chems. Corp. (Can.)*, 809 F.3d 1223 (Fed. Cir. 2015); and *Nature Simulation Sys. Inc., v. Autodesk, Inc.*, 50 F.4th 1358 (Fed. Cir. 2022).

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

(1) In analyzing whether a claim of a patent is indefinite, should courts rely on or prioritize (a) the claim language and embodiments in the patent that correspond to the claim language over (b) embodiments in the patent that do <u>not</u> correspond to the claim language?

(2) In conducting claim construction, should courts choose a construction of a claim term that is based on corresponding embodiments in the specification over a determination of indefiniteness that is based on non-corresponding embodiments in the specification, particularly in view of construction requiring a burden of proof of a preponderance of evidence and indefinitness requiring clear and convincing evidence?

POINTS OF LAW OR FACTS OVERLOOKED BY THE PANEL MAJORITY

In determining that patent claims were indefinite, the panel majority overlooked the rules that (i) claim construction, including indefiniteness determinations, begins with and remains focused on the claim language (and instead started with and focused on embodiments in the patent that did not correspond to the claim language) and (ii) a claim term is not indefinite merely because it is susceptible to different constructions.

INTRODUCTION

Mantissa Corporation petitions for a rehearing of this Court's split decision on patent claim indefiniteness.[1] The Patent[2] at issue is directed to methods of preventing unauthorized uses of identity information over a computerized network. Appx19 (Patent 1:20-25). The methods do this by allowing an owner of the identity information to set conditions for use of the identity information. *Id.*; Op. 6.[3] The Patent describes various implementations of the method including use of a person's credit card information, obtaining a person's medical information, access to a person's passport information, and approval of a loan application for the person. Appx29 (5:50-55; 14:8-10).

The Claims[4] at issue are directed to <u>one of the implementations</u>, i.e., use of a "financial account," e.g., a credit card or bank account. The Claims are limited "to control[ing] use of [a] financial account to facilitate

---

[1] The split decision is attached as an Appendix. The majority opinion and dissent are cited as, respectively, "Op." and "Dissent."

[2] "Patent" refers to U.S. Patent No. 9,361,658.

[3] The panel majority understands the Patent as protecting against, *inter alia*, "identity theft." Op. 1, 6. A more accurate understanding is protecting against unauthorized <u>use</u> of identification information.

[4] "Claims" refers to claims 1, 3, 7, 8, 10-12, and 15 of the Patent.

transactions." In the Claims, "a proposed transaction that would use the account" is permitted depending on whether a "category is authorized or unauthorized for transactions using the financial account, each category representing a different type of transaction partner." Op. 3 (Patent, cl. 1). In that context, a person of ordinary skill in the art ("POSA") would have understood that "transaction partner" is not indefinite and means at least a party to the proposed financial transaction in the financial account.

ARGUMENT

I.   **The Claims and the term "transaction partner" therein would <u>not</u> have been indefinite to a POSA upon review of the Claims and embodiments in the Patents corresponding to the Claims.**

A. **In analyzing "transaction partner," the panel dissent correctly focused first on the claim language and then on embodiments in the Patents corresponding to the claim language.**

1. **Claim language**

The panel majority, the dissent, and the parties agree the issue of indefiniteness here is to be reviewed de novo and can be resolved on the intrinsic evidence alone. Op. 5-6; Dissent 2.

"It is a bedrock principle of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal quotations omitted, citation omitted). "[I]ndefiniteness is a question of law and in effect part of claim construction." *Eplus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 517 (Fed. Cir. 2013). "[C]laim construction begins with, and remains focused on, the language of the claims." *Biagro W. Sales, Inc. v. Grow-More, Inc.*, 423 F.3d 1296, 1302 (Fed. Cir. 2005).

The dissent correctly determined the term "transaction partner" does not render the Claims indefinite and "examination of the claims and specification does reveal the meaning of 'transaction partner.'" Dissent 2. The Dissent <u>starts its analysis with a review of the Claims</u>, highlighting relevant claim language regarding (i) setting scope of use of a financial account based on conditions including "for a plurality of individual categories, whether each category is authorized or unauthorized for transactions using the financial account, *each category representing a type of transaction partner*" and (ii) permitting/denying a "proposed transaction" "when…the proposed transaction falls within a category that is unauthorized" or "authorized." Dissent 3-4. Based on the claim language, the Dissent held:

> the plain language of the claims (references to facilitating transactions followed by references to 'transaction partner') compels the conclusion that a 'transaction partner' is a party to a transaction. This is further supported…by the claimed steps of setting parameters regarding whether certain transactions with certain categories of "transaction partner[s]" will be authorized or unauthorized, followed by "permitting" or "denying" a proposed transaction based in part upon whether the proposed transaction pertains to a category of transaction partner that is authorized or unauthorized…it is clear from this claim language that the claims pertain to permitting or denying a proposed transaction in which the financial account would be used, based upon whether the

7

party to the transaction is one that falls into a category that is authorized or unauthorized.

Dissent 5-6.

2. Specification embodiments

After analyzing the claim language, the Dissent turned to the specification and found it supports "transaction partner" meaning "a party to a transaction."

> [A]n embodiment of the claimed invention comprises "receiving, at a service provider, a request to determine whether the use of an entity's identity by a *party* is authorized for a requested application." '658 patent col. 3 ll. 34–35 (emphasis added). Of particular significance…the specification provides the example that "an identity owner 30 who spends too much money at a certain store or type of store can set identity attributes 13 in account profile 14 to deny requests from that store or type of store." Id. col. 6 ll. 47–51…Each of these situations involves a "transaction" in which a party to a transaction who is separate and distinct from the "entity" seeks to use what claims 1 and 7 both refer to as the entity's "financial account." *Id.* col. 15 l. 21, col. 16 l. 14.

Dissent 6.

B. The panel majority largely ignored the claim language and relied on embodiments in the Patent that do <u>not</u> correspond to the claim language.

The panel majority held the term "transaction partner" and, in turn, the Claims indefinite after focusing on and becoming confused by embodiments in the Patent that are not covered by the Claims. The

majority should have focused on the claim language. *See Biagro W. Sales*, 423 F.3d at 1302.

As the Dissent found, the Claims inform the meaning of "transaction partner." The preamble of the Claims recite: "method…to control use of [a] <u>financial account</u> to <u>facilitate transactions</u>." Op. 3 (Patent, cl. 1 (emphasis added)). In the Claims, "a proposed transaction that would use the account" is permitted or denied depending on "setting scope of use." *Id*. Setting scope includes setting the following three conditions (the second one being at issue here): (a) "the financial account to either OFF or ON," (b) "for a plurality of individual categories, whether each <u>category is authorized</u> or unauthorized for transactions using the <u>financial account</u>, each <u>category representing a different type of transaction partner</u>," and (c) "geographic area in which transactions are authorized." *Id*. Based on this claim language, a POSA would have understood that "transaction partner" is as at least <u>a party to the proposed financial transaction</u> in the financial account.

Here, the majority focused its analysis on the specification, particularly on (i) the term "users," which does not appear in the Claims, and (ii) embodiments in the specification that do not correspond to the

Claims. Op. 6-10 The majority wrote the "patent provides many examples of users, which include credit card companies or banks who hold the accounts of identity owners, healthcare related organizations who manage medical records for identity owners, lenders to identity owners, and security companies who control a specific secure location belonging to identity owners." Op. 7. Of the listed "examples," only the "credit card companies or banks" correspond to the Claims. The other examples that did not correspond to the Claims would be less helpful in an analysis of the definiteness of the Claims.

The majority supposed that "transaction partner" could confusingly correspond to "multiple parties to each transaction, which includes the user, the identity owner, and the service provider…in addition to [other parties], such as third-party merchants." Op. 9-10. However, the language of the Claims makes reasonably certain that "transaction partner" corresponds to the "third party merchants" in the majority's list of "multiple parties." First, "third party merchants" is the obvious "transaction partner" because it would be a source of a "proposed transaction" in the Claims. Further, achieving the goal of the Claims, i.e., preventing unauthorized use of the "financial account," would clearly

align the preventive measure of setting categories of "third-party merchants" as authorized or unauthorized for transactions in the account with the claim language "for a plurality of individual categories, whether each category is authorized or unauthorized for transactions using the financial account, each category representing a different type of transaction partner."

Second, the other parties in the majority's list—"user," "identity owner," and "service provider"—do not plausibly correspond to the claimed "transaction partner." The "service provider" is separately claimed in the Claims. The "identity owner" is also separately claimed as the "entity" "setting scope of use" of the "financial account." The "user," which is not recited in the Claims, was understood by the "majority" to include, among other things, a "bank" and "credit reporting agency". Op. 8. In the context of the Claims, the "bank" would be hosting the "financial account" and effecting or consummating the "proposed transaction." *See* Op. 8. The "credit reporting agency," which is not in the context of the Claims, would hold and produce credit information for, e.g., a loan application. *See* Appx32 (Patent 12:5-51). In both instances, a POSA would not expect an identity owner to authorize or not authorize a

"category representing a different type of" <u>user</u> when the user <u>is already involved in hosting the financial account</u> or credit information. Thus, only "merchants" in the majority's list plausibly corresponds to "transaction partner."

For the sake of simplicity and with support from the specification, Mantissa had proposed a construction of "transaction partner" as "seller.[5] *See* Appx31 (Patent 10:18-22 (referencing "merchant agent 24" and "merchant")). The majority appreciated "seller" "may make sense...if the user is a credit card company seeking permission from a service provider for a transaction partner to access a financial account maintained by the credit card company and the transaction partner is a seller seeking to process a charge to an individual's credit card account." Op. 8. This should have led to the conclusion that "transaction partner" is at least not indefinite. As the majority correctly described, a context of the Claims is "a credit card company seeking permission...for a transaction partner to access a financial account." *Id*. This context is consistent with the claim limitations of "financial account," "setting scope of use" based on

---

[5] The Dissent proposed the construction "a party to a transaction" and Mantissa agreed. Dissent n.1.

"category representing a different type of transaction partner," and "denying when…the proposed transactions falls within a category that is unauthorized," and other limitations. These limitations distinguish the Claims from the other contexts, e.g., controlling "medical records," "secure location[s]," and "credit worthiness report[s]," the majority mistakenly relied on in holding indefiniteness. *See* Op. 7-8.

Instead of relying on the apt context of "a seller seeking to process a charge to an individual's credit card account," the majority argued that "transaction partner" would not mean "seller" in a "broad array of scenarios involving financial accounts." Op. 8. The majority focused on "user" as "a credit card company, credit reporting agency, merchant, banking institution, brokerage firm, insurance provider, hospital, medical caregiver, computer, corporation, or family member." *Id.* This leads astray. Focusing on the claim language, the term "transaction partner" should be construed in context of "control[ling] use of a financial account," "setting scope of use" by authorizing or not authorizing a "category representing a different type of transaction partner," and "denying when…the proposed transactions falls within a category that is unauthorized." Op. 3 (Patent, cl. 1).

13

Turning to the specification, embodiments corresponding to the Claims involve a "merchant," "merchant agent 24," and "certain store or type of store" inform the meaning of the claimed "transaction partner" or "type of transaction partner." *See* Appx31 (Patent 10:18-22), Appx29 (Patent 6:47-51). The "merchant" communicates the transaction information to user 20," which then "generates an appropriate [ ] request 111 and sends it to service provider 10" for a determination of whether the proposed transaction is authorized. Appx31 (Patent 10:18-24). "[A]n identity owner 30 who spends too much money at a certain store or type of store can set identity attributes…to deny requests from that store or type of store." Appx29 (Patent 6:47-51). By underweighting the language of the Claims and embodiments corresponding to the Claims, and overweighting embodiments not corresponding to the Claims, the majority avoided understanding the meaning of "transaction partner."

C. The panel majority overlooked the rule that a claim term is not indefinite merely because it is susceptible to different constructions.

The majority essentially held "transaction partner" indefinite because it could mean "seller" as well as "multiple parties to each transaction, which includes the user, the identity owner, and the service

provider…in addition to [other parties], such as third-party merchants." Op. 7-10. However, the test for indefiniteness "is not merely whether a claim is susceptible to differing interpretations…[T]he Supreme Court declined to adopt such a rule in *Nautilus*." *Nevro Corp. v. Boston Scientific Corp.*, 955 F.3d 35 (Fed. Cir. 2020) (vacating district court's determination of indefiniteness because the specification was sufficient to inform a POSA, with reasonable certainty, as to the scope of claim terms). The "burden of proving indefiniteness includes proving not only that multiple [definitions] exist, but that one of skill in the art would not know how to choose among them." *Dow Chem. Co. v. NOVA Chems. Corp. (Can.)*, 809 F.3d 1223, 1227 (Fed. Cir. 2015) (Moore, J., concurring).

Here, a POSA would have known to choose a construction such as "a party to a transaction" over the majority's alternatives because that construction fits with the claim language and the alternatives do not. Relatedly, appellees First Financial et al. and the panel majority have not established by clear and convincing evidence that a POSA would have (i) found the different meanings equally plausible and (ii) not known how to choose among them. *Dow Chem.*, 809 F.3d at 1224.

15

The term "transaction partner" has readily plausible meanings. Alone it implies a partner to a transaction and, in the context of the Claims and the specification, means at least a party to the proposed transaction as explained above.

The majority's alternatives are inconsistent with the Claims as explained above. *See supra* I.B. The Claims lay out that "a proposed transaction" is to be "den[ied] or "permit[ted] depending on whether "a category representing a different type of transaction partner" has been "authorized or unauthorized for transactions using the financial account." Op. 3-4 (Patent, cl. 1). Correspondingly, the specification teaches "[a]n identity owner 30 who spends too much money at a certain store or type of store can set identity attributes…to deny requests from that store or type of store." Appx29 (Patent 6:47-51). Thus, a POSA would understand with reasonable certainty that "transaction partner" means at least a party to the proposed transaction.

D. The panel majority overly relied on the term "transaction partner" not appearing in the specification and the patent examiner not explaining the term during prosecution.

The majority writes that the term was introduced in a preliminary amendment and "[n]either the preliminary amendment nor the

16

communication between the patent examiner and the applicant discussed or explained the meaning of 'transaction partner.'" Op. 2. This is immaterial. First, a claim term is not required to be in the specification in order to "to inform, with reasonable certainty, those skilled in the art about the scope of the invention". *Nautilus, , Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 898-899 (2014); *see Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374 (Fed. Cir. 2015) (claim term "spaced relationship" held not indefinite despite not being in the written description); *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1373 (Fed. Cir. 2014) ("patent which defines a claim phrase through examples may satisfy the definiteness requirement") (citing *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1336 (claim term "not interfering substantially" is sufficiently definite because one could use "examples in the specification to determine whether interference with hybridization is substantial")).

Second, the lack of any explanation by the examiner is entitled to no deference. *See Nature Simulation Sys. Inc., v. Autodesk, Inc.*, 50 F.4th 1358 (Fed. Cir. 2022) (modified to reflect Judge Dyke's prior dissent that patent examiners are not entitled to deference in an indefiniteness

17

analysis). In any event, pursuant to patent examination procedure, the claim term "transaction partner" is presumed to have been found definite. Examination by the patent examiner includes examination that proposed claims are "definite — i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." U.S. Patent & Trademark Office, Manual of Patent Examining Procedure §2171 (citing pre-AIA 35 U.S.C. §112(b)).

II.   **A split panel decision on a review and analysis of intrinsic evidence relevant to indefiniteness does not meet the burden of establishing indefiniteness by clear and convincing evidence.**

"United States patents are accompanied by a presumption of validity, 35 U.S.C. § 282, and invalidity must be established by clear and convincing evidence." *Nature Simulation Sys.*, F.4th at 1361. The "clear and convincing" standard has been defined as evidence "so clear as to leave no substantial doubt" and "sufficiently strong to command the unhesitating assent of every reasonable mind." *Sheehan v. Sullivan*, 126 Cal. 189, 193 (Cal. 1899). A leading treatise on jury instructions defines the standard as "highly probable." *See* O'Malley, Federal Jury Practice and Instructions, §19.03 (West 2000 and 2005 supp.). The U.S. Supreme

Court also described it as "highly probable." *Colorado v. New Mexico*, 467 U.S. 310, 2437 (1984).

In this appeal, a three-judge panel conducted a de novo review of the intrinsic evidence relevant to indefiniteness of the claim term "transaction partner" and Claims containing the term. The panel was only 2/3 in favor of indefiniteness. One of the judges held the Claims not indefinite and construed "transaction partner" as "a party to a transaction." This fraction is below the standard of proof of "no substantial doubt" or "highly probable." Moreover, the fraction could be lower considering the analysis of the panel majority is inconsistent with the claim language while the analysis of the dissent is not, as explained above. Thus, a split panel decision on indefiniteness should not result in a holding of invalidity of the Claims.

CONCLUSION

For the foregoing reasons, panel or en banc rehearing should be granted.

Dated: March 20, 2024   Respectfully submitted,

                                /s/ John Demarco
                                John Demarco
                                Young Basile Hanlon & MacFarlane, P.C.
                                700 Milam St., Suite 1300
                                Houston, TX 77002
                                832-871-5058 Telephone
                                demarco@youngbasile.com

                                ***Counsel for Appellant Mantissa
                                Corp.***

ADDENDUM

Slip Opinion: *Mantissa Corporation v. First Financial Corporation, First Financial Bank, N.A.*, No. 2022-1963 (Fed. Cir.) (February 14, 2023).

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

———————————————

MANTISSA CORPORATION,
Plaintiff-Appellant

v.

FIRST FINANCIAL CORPORATION, FIRST FINANCIAL BANK, N.A.,
Defendants-Appellees

———————————————

2022-1963

———————————————

Appeal from the United States District Court for the Northern District of Illinois in No. 1:17-cv-09174, Judge Virginia M. Kendall.

———————————————

Decided: February 14, 2024

———————————————

ANTHONY JOHN DEMARCO, Young Basile Hanlon & MacFarlane, P.C., Houston, TX, argued for plaintiff-appellant.

RYAN RONALD SMITH, Wilson, Sonsini, Goodrich & Rosati, PC, Palo Alto, CA, argued for defendants-appellees.

———————————————

Before DYK, SCHALL, and REYNA, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* DYK.

Opinion concurring-in-part and dissenting-in-part filed by *Circuit Judge* SCHALL.

Dyk, *Circuit Judge*.

Mantissa Corporation ("Mantissa") appeals from a final judgment of invalidity with respect to certain claims of U.S. Patent No. 9,361,658 ("'658 patent"). We conclude that the district court correctly determined that the term "transaction partner" is indefinite and affirm the judgment of the district court that claims 1, 3, 7, 8, 10–12, and 15 of the '658 patent are invalid for indefiniteness. We also conclude that we lack the authority to determine whether the district court properly construed the term "OFF." We *affirm*.

BACKGROUND

Mantissa owns the '658 patent, titled "System and Method for Enhanced Protection and Control Over the Use of Identity." The patent concerns an improved way to protect against identity theft, fraud, and other unauthorized uses of identifying information. Mantissa brought suit against First Financial Corporation and First Financial Bank, N.A. (collectively, "First Financial") in the District Court for the Northern District of Illinois, alleging infringement of claims 1, 3, 7, 8, 10–13, and 15 of the '658 patent.

Independent claim 1 of the '658 patent is representative[1]:

---

[1]   Claims 1, 7, and 13 are independent claims. Claims 3 and 5 depend from claim 1. Claims 8, 10, 11, 12, and 15 depend from claim 7. Claim 13 was withdrawn from the suit.

1. A method for a service provider to control use of an entity's financial account to facilitate transactions, comprising:

setting scope of use, defined by the entity via a network, for the financial account, including at least:

(a) the financial account to either <u>OFF</u> or ON;

(b) for <u>a plurality of individual categories, whether each category is authorized or unauthorized for transactions using the financial account, each category representing a different type of transaction partner</u>; and

(c) a geographical scope reflecting a geographic area in which transactions are authorized;

receiving, via a network from a source other than the entity, an inquiry regarding a proposed transaction that would use the financial account;

determining, relative to the scope of use, whether the financial account may or may not be used for the proposed transaction, comprising:

denying when the financial account is <u>OFF</u>;

denying when the financial account is ON and the proposed transaction falls within a category that is unauthorized;

> denying when the financial account
> is ON, the proposed transaction
> falls within a category that is au-
> thorized and when a location of the
> proposed transaction is outside of
> the geographical area;
>
> permitting when (a) the financial
> account is ON, (b) the proposed
> transaction falls within a category
> that is authorized, (c) a location of
> the proposed transaction is inside
> the geographical area, and (d) the
> proposed transaction is not other-
> wise impermissible; and

> responding to the inquiry by providing, via
> a network to the source, first information
> based on the result of the determining.

'658 patent, col. 15, ll. 20–53 (emphasis added).

At the claim construction phase, the parties disputed two terms: (1) "transaction partner" and (2) "OFF." The district court determined that "transaction partner" was indefinite and construed "OFF" to mean "a status in which any use of the financial account is to be denied." *Mantissa Corp. v. First Fin. Corp.*, No. 17 C 9174, 2022 WL 1487577, at *8, *10 (N.D. Ill. May 11, 2022).

Based on the district court's determination that "trans-action partner" is indefinite, the parties filed a joint motion for entry of final judgment. Thus, all of the asserted claims, except claim 13, were invalidated as indefinite because they included the term "transaction partner." In accord-ance with the joint motion, Mantissa agreed to withdraw claim 13 and not assert it against First Financial. Pursu-ant to the stipulation, the district court entered final judg-ment under Fed. R. Civ. P. 54(b). J.A. 18.

Mantissa appeals. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

DISCUSSION

I.   Transaction Partner

"We review claim construction based on intrinsic evidence de novo and review any findings of fact regarding extrinsic evidence for clear error." *Grace Instrument Indus. v. Chandler Instruments Co.*, 57 F.4th 1001, 1008 (Fed. Cir. 2023). "[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). "The ultimate conclusion that a claim is indefinite under 35 U.S.C. § 112, ¶ 2 is a legal conclusion, which we review de novo." *Cox Commc'ns, Inc. v. Sprint Commc'n Co.*, 838 F.3d 1224, 1228 (Fed. Cir. 2016) (footnote omitted).

A

At the district court, First Financial relied on testimony from its expert, Dr. Rhyne, to support its argument that the term "transaction partner" is indefinite. The district court concluded that Dr. Rhyne was a person of ordinary skill in the art ("POSA") and relied on his testimony to conclude that "transaction partner" was indefinite. Mantissa argues that the district court's definition of a POSA is incorrect because it did not require that a POSA have "at least three years of experience in the field of systems for processing and authorizing transactions in a financial account over a computer network," Appellant Opening Br. 18 (emphasis omitted), that under the correct definition Dr. Rhyne was not a POSA, and that the district court erred in considering his testimony.

On appeal, both parties devote considerable attention to the arguments of whether Dr. Rhyne qualifies as a POSA

and whether the district court erred in relying on his testimony to determine that "transaction partner" was indefinite. We do not need to address this issue because in this case the issue of indefiniteness can be resolved based on the intrinsic evidence alone, as both parties agree. Oral Arg. at 4:42–5:06 (Mantissa agreeing we can rule on indefiniteness based on the intrinsic record), 24:22–25:00 (First Financial agreeing we can rule on indefiniteness based on the intrinsic record); *see Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 n.6 (Fed. Cir. 2014) (noting it was "unnecessary" to rely on expert testimony or "any other extrinsic evidence" to conclude the claims were indefinite).

B

Here the intrinsic evidence establishes that the claims are indefinite. The patent aims to address the problems of identity theft, fraud, and unauthorized access to an identity holder's account or identifying information "by giving an individual or other entity increased control over implied or direct use of his identity." '658 patent, col. 2, ll. 16–18. The invention "provides protection of the identity of an entity by placing limitations or conditions on its use, and whereby the entity's use-enabling identification information is not fully needed to authorize a transaction." *Id.*, col. 1, ll. 22–25. As part of the invention, use restrictions on an account (e.g., permitting uses only during certain times of day or prohibiting certain uses altogether, etc.) can be put in place such that "[a]ttempts to use [the] identity outside the authorized scope will be denied, preventing misuse before it takes place and identifying a possible fraud in progress . . . ." '658 patent, col. 5, ll. 57–60.

The invention involves, at least, three entities: an identity owner, a service provider, and a user. An identity owner is a person with identifying information who is the owner of an account or location. A service provider is a computer operator or automated program that authorizes or denies transactions involving the account or location

based on information it receives from the identity owner. A user is the entity that maintains the account or location and is in some circumstances either seeking permission from the service provider to access the identity owner's account or location or seeking permission for third parties to access the account or location. The patent provides many examples of users, which include credit card companies or banks who hold the accounts of identity owners, healthcare related organizations who manage medical records for identity owners, lenders to identity owners, and security companies who control a specific secure location belonging to identity owners.

The asserted claims also refer to a "transaction partner." The term "transaction partner" does not appear in the specification. Indeed, the term "transaction partner" does not appear in the claims or specification in U.S. Application No. 11/115,239, the application to which the '658 patent claims priority. Instead, the term first appeared in a preliminary amendment filed almost nine years later. Neither the preliminary amendment nor the communication between the patent examiner and the applicant discussed or explained the meaning of "transaction partner." There is also no commonly accepted definition for "transaction partner." The key issue on appeal is who or what is a "transaction partner" in the context of the patent claims.

In its briefing, Mantissa contended that "a POSA would be able to decide that 'transaction partner' means 'seller.'" Appellant Opening Br. 27. A transaction partner would seek permission to engage in a transaction with a user (e.g., a credit company) who would determine whether a proposed transaction (e.g., sale) is authorized. Mantissa's construction may make sense in some contexts, such as if the user is a credit card company seeking permission from a service provider for a transaction partner to access a financial account maintained by the credit card company and the transaction partner is a seller seeking to process a charge to an individual's credit card account. But the

8   MANTISSA CORPORATION v. FIRST FINANCIAL CORPORATION

claims and specification are not so limited, and "[i]t cannot be sufficient that a court can ascribe some meaning to a patent's claims . . . ." *Nautilus*, 572 U.S. at 911 (emphasis omitted); *see also TVnGO Ltd. (BVI) v. LG Elecs. Inc.*, 861 F. App'x 453, 458–59 (Fed. Cir. 2021) (non-precedential) ("Even if it may be possible to 'ascribe some meaning' to the disputed limitation, . . . more is required: one of ordinary skill must have reasonable certainty.").

The specification makes clear that the claims cover a broad array of scenarios involving financial accounts where construing "transaction partner" to mean "seller" would not make sense. For example, the specification recites a "[u]ser [] may be, by way of non-limiting example, a credit card company, credit reporting agency, merchant, banking institution, brokerage firm, insurance provider, hospital, medical caregiver, computer, corporation, or family member. User [] may also in theory be an imposter." '658 patent, col. 8, ll. 17–23; *see also id.*, col. 9, ll. 13–14, col. 14, ll. 21–27. In many of these situations there is no seller, and the term "transaction partner" in these contexts cannot mean "seller."

For example, the specification describes an embodiment where the user is a credit reporting agency seeking to "determine if [a] loan applicant had an identity account profile" and provide "a credit worthiness report for the loan applicant" to a bank. '658 patent, col. 12, ll. 12–17. When the credit reporting agency is seeking access to the financial account of the loan applicant, it is not maintaining an account or engaging in a transaction involving a seller of goods or services. As another example, a family member might seek to access the identity owner's financial account, but the family member is not maintaining an account or engaging in a transaction with a seller. In addition, the specification describes a situation where "a merchant user" requests permission for "a purchase at 3:00 AM" that is not authorized. '658 patent, col. 11, ll. 40–50. In this scenario, the merchant or "seller" is identified as the "user." *Id.* If

the seller is the user who is seeking permission to use the account, it would seem that whoever is on the other side of the transaction would not be characterized as a "seller." Given how broadly the specification defines users and transactions, the intrinsic evidence does not support construing "transaction partner" to mean "seller."

C

At oral argument, Mantissa argued that even if its proposed construction of "seller" does not solve the indefiniteness problem, "transaction partner" could be construed more broadly to mean "a party to a transaction"—a construction not offered at the district court or in the briefing in this court. Oral Arg. at 11:24–12:15. Even assuming that this argument is not forfeited, this construction exacerbates the indefiniteness problem rather than solves it.

The claims require defining "for a plurality of individual categories, whether each category is authorized or unauthorized for transactions using the financial account, each category representing a different type of transaction partner." '658 patent, col. 15, ll. 20–29. The proposed definition of "transaction partner" includes multiple transactions—those between the user and the identity owner, the user and the service provider, the identity owner and a third party, the user and a third party, and possibly other combinations of entities. The specification indicates that there are, or at least can be, multiple parties to each transaction, which includes the user, the identity owner, and the service provider. *See* '658 patent, col. 9, ll. 13–18 ("In a preferred embodiment, [the] user [] is a lending institution such as a bank, [the] identity owner [] is a person, and [the] service provider [] is a form of company that preferably would use, . . . electronic methodology such as a computer server to provide a network <u>through which all parties to the transaction can communicate</u>." (emphasis added)), Fig. 2 (illustrating how the service provider connects to the user and identity owner). Based on the specification, any one of

these parties, in addition to others, such as third-party merchants, would be "a party to a transaction."

There are also many examples of different transactions involving financial accounts. *See, e.g.*, *id.*, col. 2, l. 66–col. 3, l. 2; *id.*, col. 8, ll. 45–55 (making a credit card transaction); *id.*, col. 11, ll. 40–59 (making a purchase); *id.*, col. 12, ll. 7–19 (applying for a loan); *id.*, col. 13, l. 64–col. 14, l. 3 (withdrawing money from a bank account). Under the newly proposed definition, if transaction partner were defined as "a party to a transaction" (a conclusion not supported by the patent), a POSA would not understand with reasonable certainty how to categorize different types of transaction partners for the purpose of protecting an identity owner's financial account from unauthorized transactions. To construe the term "transaction partner" to include each of the multiple parties to the multiple types of transactions simply makes no sense if the purpose of categorizing is to determine whether a potential party is authorized or unauthorized to engage in a transaction. For example, the identity owner and service provider—who are parties to a transaction—do not require authorization.

Because the specification and claims fail to provide adequate guidance as to the identity of the "transaction partner," the term "transaction partner" is indefinite. In other cases, we have found terms to be indefinite when a POSA could not identify with reasonable certainty the identity of what the term refers to. *See HZNP Medicines LLC v. Actavis Lab'ys UT, Inc.*, 940 F.3d 680, 689–91 (Fed. Cir. 2019) (finding the term "Impurity A" indefinite when "the written description provides no clue as to the identity of" it). Given the breadth of transactions described, the dearth of details defining the contours of "transaction partner" and the "individual categories" creates a "zone of uncertainty," *Nautilus*, 572 U.S. at 909 (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942)). The public is not apprised of what is claimed by the patent. *See id.* We agree

with the district court that the term "transaction partner" is indefinite, and the asserted claims are invalid.

II.   OFF

Mantissa asks us to review the district court's construction of "OFF." We lack the jurisdiction to do so because the decision in the district court under review did not rest on any such determination. While the claim construction may have consequences for other cases, it has no significance for this case.

In the joint stipulation to enter final judgment at the district court, Mantissa acknowledged that the district court's holding that claims 1 and 7 are invalid for indefiniteness rendered all but one of the asserted claims invalid, and the one remaining claim was withdrawn. The parties agree that the judgment of invalidity rests on the indefiniteness of the term "transaction partner." The joint stipulation does not mention, let alone explain, the effect of the district court's construction of the term "OFF" on the issue of infringement or any other dispositive issue. At oral argument, both parties agreed that the construction of "OFF" would not affect the final judgment. Oral Arg. at 17:54–18:27, 33:25–34:03.

With some exceptions not applicable here, our jurisdiction is to review "a final decision of a district court of the United States." 28 U.S.C. § 1295(a)(1). The claim construction issue is not at issue in the final decision here. Therefore, we lack jurisdiction to review it. We have declined to address issues in similar circumstances when it is not possible to discern from the stipulated judgment how a district court's ruling on an issue would be dispositive. *See AlterWAN, Inc. v. Amazon.com, Inc.*, 63 F.4th 18, 22 (Fed. Cir. 2023) (declining to address claim construction issues when "the stipulate[d judgment] d[id] not provide sufficient detail to allow us to resolve the claim construction issues presented on appeal"); *Jang v. Bos. Sci. Corp.*, 532 F.3d 1330, 1336 (Fed. Cir. 2008) (declining to address a claim

construction ruling when "it is impossible to discern from the stipulated judgment which of the district court's claim construction rulings would actually affect the issue of infringement"); *Fresenius USA, Inc. v. Baxter Int'l*, Inc., 582 F.3d 1288, 1304 (Fed. Cir. 2009) ("Fresenius gave this court little guidance and cited no record support regarding why a modified claim construction would affect the infringement judgment, the validity judgment, or both. For that reason alone, we may decline to consider Fresenius's claim construction arguments."); *Mass. Inst. of Tech. & Elecs. for Imaging, Inc. v. Abacus Software*, 462 F.3d 1344, 1350 (Fed. Cir. 2006) (declining to address a district court's claim constructions that "would not affect the judgment of non-infringement").

The parties ask us to address the district court's construction of "OFF" because the same term is "pending claim construction under the same patent-in-suit in at least three parallel litigations," Appellee Br. 25–26, which are currently stayed pending this appeal, and in at least those cases, Mantissa agreed "to be bound by the claim construction on the two overlapping terms/phrases in" this case. Minute Entry, Mantissa Corp. v. Fiserve Sols., LLC, No. 19-cv-03204, ECF No. 42. We have refrained, and are indeed prohibited, from issuing opinions in such circumstances. *See Personalized User Model, LLP v. Google Inc.*, 797 F.3d 1341, 1349–50 (Fed. Cir. 2015) ("Despite PUM's concerns that the construction might be given preclusive effect in future litigation involving its related patents, we may not provide an advisory opinion on the meaning of a claim term that does not affect the merits of this appeal and thus is not properly before us.").[2]

---

[2]   This is not a situation in which we originally had jurisdiction to address the issue, and the claim construction issue became moot on appeal as to the particular case.

CONCLUSION

We affirm the district court's determination that the term "transaction partner" is indefinite and affirm the district court's determination that claims 1, 3, 7, 8, 10–12, and 15 are invalid for indefiniteness. We decline to address the district court's construction of "OFF."[3]

AFFIRMED

Under such circumstances collateral consequences would perhaps justify finding that the issue was not moot on appeal.

[3]   Because we lack authority to rule on the issue, the parties would not be collaterally estopped from contesting the issue in the other cases that adopted the district court's claim construction. *See Best Med. Int'l, Inc. v. Elekta Inc.*, 46 F.4th 1346, 1352–53 (Fed. Cir. 2022); *SkyHawke Techs., LLC v. Deca Int'l Corp.*, 828 F.3d 1373, 1376 (Fed. Cir. 2016); *see also* Restatement (Second) of Judgments § 28 (1982).

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

MANTISSA CORPORATION,
Plaintiff-Appellant

v.

FIRST FINANCIAL CORPORATION, FIRST FINANCIAL BANK, N.A.,
Defendants-Appellees

2022-1963

Appeal from the United States District Court for the Northern District of Illinois in No. 1:17-cv-09174, Judge Virginia M. Kendall.

SCHALL, *Circuit Judge*, concurring-in-part and dissenting-in-part.

The Supreme Court has instructed that, under pre-AIA 35 U.S.C. § 112, ¶2, "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). For our part, we have stated that "[o]nly if a disputed claim term remains ambiguous after analysis of the intrinsic evidence should the court rely on extrinsic evidence." *Actelion Pharms. Ltd. v.*

Mylan Pharms. Inc., 85 F.4th 1167, 1174 (Fed. Cir. 2023) (citing *Pickholtz v. Rainbow Techs., Inc.*, 284 F.3d 1365, 1372–73 (Fed. Cir. 2002)). I agree with the majority that, in this case, it is not necessary to resort to extrinsic evidence in order to determine whether claims 1, 3, 7, 8, 10–12, and 15 of the '658 patent are indefinite. However, I do not agree with the conclusion that the majority reaches after examining the intrinsic evidence: that those claims are indefinite.

The claim term at issue is "transaction partner." It appears in both independent claims at issue, claims 1 and 7. The majority holds these claims indefinite because it concludes that "the specification and claims fail to provide adequate guidance as to the identity of the 'transaction partner.'" Maj. Op. 10. In my view, however, examination of the claims and specification does reveal the meaning of "transaction partner."

Both before the district court and in its briefing on appeal, Mantissa argued that, in the context of the '658 patent, the term "transaction partner" means "seller." *See* J.A. 555, Appellant's Br. 25. The majority correctly rejects this construction. However, even if we disagree with the claim construction urged upon us by Mantissa, we are free to examine the intrinsic record ourselves and arrive at what we believe is the correct construction. *See Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1323–24 (Fed. Cir. 2008) (adopting "a new claim construction on appeal," and noting that "the court has an independent obligation to construe the terms of a patent [and] need not accept the constructions proposed by either party"). In my view, for the following reasons, the correct construction of "transaction partner" is "party to a transaction."[1]

---

[1]   At the conclusion of oral argument before us, counsel for Mantissa stated that he agreed with this

I begin with the claim language. Claim 1 of the '658 patent recites in pertinent part:

1. A method for a service provider to control use of an entity's financial account to facilitate transactions, comprising:

   setting scope of use, defined by the entity via a network, for the financial account, including at least:

   . . .

   (b) for a plurality of individual categories, whether each category is authorized or unauthorized for transactions using the financial account, *each category representing a different type of transaction partner*; . . .

   . . .

   receiving, via a network from a source other than the entity, an inquiry regarding a proposed transaction that would use the financial account;

   determining, relative to the scope of use, whether the financial account may or may not be used for the proposed transaction, comprising:

   . . .

_____

construction. Oral arg. 35:02–13; *see also id.* at 3:22–37 ("Our position is that 'transaction partner' refers to the parties to a transaction . . . .").

> denying when . . . the proposed
> transaction falls within a category
> that is unauthorized;
>
> . . .
>
> permitting when . . . the proposed
> transaction falls within a category
> that is authorized, ...

'658 patent, col. 15 ll. 20–53 (emphasis added).

Claim 7 of the '658 patent recites in pertinent part:

7. A method for a service provider to control use
of an entity's financial account to facilitate trans-
actions, . . . , the method comprising:

> setting scope of use, as defined by the entity
> via a network, for the financial account, in-
> cluding at least:
>
> > . . .
> >
> > (b) setting a category status for
> > each category of a plurality of cate-
> > gories as either authorized or un-
> > authorized for transactions using
> > the financial account, *each category
> > representing a type of transaction
> > partner*; . . .
> >
> > . . .
>
> receiving, via a network from a source
> other than the entity, an inquiry regarding
> a proposed transaction on the financial ac-
> count;
>
> determining, relative to the scope of use, a
> response status to the inquiry reflecting
> whether the financial account may or may

> not be used for the proposed transaction,
> comprising:
>
> . . .
>
> setting the response status to im-
> permissible when . . . the proposed
> transaction falls within a category
> having an unauthorized category
> status;
>
> . . .
>
> setting the response status to per-
> missible when . . . the proposed
> transaction falls within a category
> having an authorized category sta-
> tus . . . .

'658 patent, col. 16 ll. 12–56 (emphasis added).

The preambles of both claims 1 and 7 refer to control-
ling "use of an entity's financial account to facilitate trans-
actions." At the same time, both claims include a step of
"setting scope of use . . . for the financial account." That
step requires setting, for a "plurality of [ ] categories,"
whether each category is "authorized or unauthorized for
transactions using the financial account, each category rep-
resenting a [ ] type of transaction partner." I believe that
the plain language of the claims (references to facilitating
transactions followed by references to "transaction part-
ner") compels the conclusion that a "transaction partner" is
a party to a transaction. This is further supported, I think,
by the claimed steps of setting parameters regarding
whether certain transactions with certain categories of
"transaction partner[s]" will be authorized or unauthor-
ized, followed by "permitting" or "denying" a proposed
transaction based in part upon whether the proposed
transaction pertains to a category of transaction partner
that is authorized or unauthorized. To me, it is clear from
this claim language that the claims pertain to permitting

6   MANTISSA CORPORATION v. FIRST FINANCIAL CORPORATION

or denying a proposed transaction in which the financial account would be used, based upon whether the party to the transaction is one that falls into a category that is authorized or unauthorized.

The specification further supports this conclusion. It recites that an embodiment of the claimed invention comprises "receiving, at a service provider, a request to determine whether the use of an entity's identity by a *party* is authorized for a requested application." '658 patent col. 3 ll. 34–35 (emphasis added). Of particular significance, it seems to me, the specification provides the example that "an identity owner 30 who spends too much money at a certain store or type of store can set identity attributes 13 in account profile 14 to deny requests from that store or type of store." *Id.* col. 6 ll. 47–51. And, the specification recites at length the various types of situations in connection with which the claimed invention may be employed. These include credit card use, making a request for a loan, and bank account withdrawals. *Id.* col. 2 l. 64–col. 3 l. 2, col. 3 ll. 4–6, col. 5 ll. 48–50, 54–55, col. 6 ll. 47–51, col. 13 l. 64–col. 14 l. 3. Each of these situations involves a "transaction" in which a party to a transaction who is separate and distinct from the "entity" seeks to use what claims 1 and 7 both refer to as the entity's "financial account." *Id.* col. 15 l. 21, col. 16 l. 14.[2] In sum, a "party to a transaction" is plainly the "transaction partner" of claims 1 and 7.

The majority's view is that the specification provides "multiples parties to each transaction," i.e., the user, the

---

[2]   The specification also refers to situations involving gaining access to medical records. '658 patent col. 3 ll. 2–4, col. 3 l. 6, col. 5 ll. 51–53, col. 6 ll. 40–47. At first glance, these situations do not appear to fall within the scope of the claims of the '658 patent, which pertain to "financial transactions," although I recognize there may be financial transactions that pertain to medical records.

identity owner, the service provider, or a third party, any one of which could be a "party to a transaction." Maj. Op. 9–10. To the extent that is the case, I believe, though, that the claim language clarifies that a "transaction partner" is something or someone that could enter into a transaction using the financial account, authorization for the use of which must be obtained, and would not be the service provider, entity, or financial account owner. Thus, one of skill in the art would be informed of the scope of the invention with reasonable certainty.

In my view, the district court thus erred in holding independent claims 1 and 7 of the '658 patent and the related dependent claims indefinite. I would therefore reverse the decision of the district court and remand the case to the court for further proceedings.

Finally, the majority holds that, because there has been no final judgment relating to the district court's construction of the term "OFF" appearing in claims 1, 3, 7, 8, 10–12, and 15 of the '658 patent, we cannot consider that issue. I agree with this holding. Accordingly, I join that part of the majority opinion.

For the foregoing reasons, I respectfully concur-in-part and dissent-in-part.

FORM 19. Certificate of Compliance with Type-Volume Limitations

Form 19
July 2020

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2022-1963

Short Case Caption: Mantissa Corporation v. First Financial Corporation

> **Instructions:** When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it meets one of the following:

☑ the filing has been prepared using a proportionally-spaced typeface and includes __3,202__ words.

☐ the filing has been prepared using a monospaced typeface and includes _____ lines of text.

☐ the filing contains _____ pages / _____ words / _____ lines of text, which does not exceed the maximum authorized by this court's order (ECF No. _____).

Date: 03/20/2024

Signature: /s/ John Demarco

Name: John Demarco

Save for Filing