

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED
Petitioner

v.

JOHN D'AGOSTINO
Patent Owner

Patent No. 8,036,988
Application No. 12/902,399
Filed: October 23, 2010
Issued: October 11, 2011
Title: System and Method for Performing Secure Credit Card Transactions

PETITION FOR COVERED BUSINESS METHOD PATENT REVIEW
UNDER 35 U.S.C. § 321, 37 C.F.R. § 42.304

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PETITIONER’S LIST OF EXHIBITS

Exhibit 1001 – U.S. Patent No. 8,036,988

Exhibit 1002 – File History for U.S. Patent No. 8,036,988

Exhibit 1003 – File History for U.S. Reexamination No. 90/012,517

Exhibit 1004 – U.S. Patent No. 6,422,462 (“Cohen”)

Exhibit 1005 – U.S. Patent No. 6,636,833 (“Flitcroft”)

Exhibit 1006 – U.S. Patent No. 5,826,243 (“Musmanno”)

Exhibit 1007 – Complaint in D’Agostino v. MasterCard, Inc. et al. (13-cv-0738)

Exhibit 1008 – Declaration of Jack D. Grimes, Ph.D.

Exhibit 1009 – Excerpts from Random House Webster’s Unabridged Dictionary,
Second Edition

Exhibit 1010 – U.S. Patent No. 6,064,987 (“Walker”)

Exhibit 1011 – U.S. Patent No. 5,283,829 (“Anderson”)

Exhibit 1012 – ISO 8583 Financial Transaction Card Originated Messages –
Interchange Message Specifications (1992) (“ISO 8583”)

Pursuant to 35 U.S.C. § 321 and 37 C.F.R. § 42.304, MasterCard International Incorporated (“Petitioner” and real party in interest), hereby petitions for review under the transitional program for covered business method patents of claims 1-38 (all claims) of U.S. Pat. No. 8,036,988 (“the ‘988 Patent”), issued to John D’Agostino (“D’Agostino”). An Ex Parte Reexamination of the ‘988 Patent was filed on September 12, 2012, and is currently pending under Control No. 90/012,517. Petitioner hereby asserts it is more likely than not that at least one of the challenged claims is unpatentable and respectfully requests review of, and judgment against, Claims 1-38 as unpatentable under §§ 102, 103, and/or 112.

I. INTRODUCTION

The ‘988 Patent attempts to claim the use of a transaction code – in lieu of a credit card number – for making secure transactions that are limited to a specific merchant or group of merchants. This was a practice that was common in the credit card industry before the priority date of the ‘988 Patent. During prosecution, the ‘988 Patent issued only after the Applicant attempted to distinguish the claims over the prior art on the basis of the following limitation:

defining at least one payment category to include at least limiting a number of transactions to one or more merchants, said one or more merchants limitation being included in said payment category prior to any particular merchant being identified as one of said one or more merchants

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