

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. 7,840,486
Application No. 11/252,009
Filed: October 17, 2005
Issued: November 23, 2010
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

TABLE OF CONTENTS

LIST OF EXHIBITSiv

I. INTRODUCTION.....1

II. PETITIONER HAS STANDING2

A. The ‘486 Patent is a Covered Business Method Patent2

B. Petitioner is a Real Party in Interest Sued for Infringement5

C. Related Matters5

III. OVERVIEW OF SPECIFIC GROUNDS FOR WHICH IT IS MORE LIKELY THAN NOT THAT THE CHALLENGED CLAIMS (1-30) OF THE ‘486 PATENT ARE UNPATENTABLE.....6

IV. BACKGROUND INFORMATION FOR THE ‘486 PATENT7

A. Overview of the ‘486 Patent7

B. The ‘486 Patent Prosecution History7

C. The ‘988 Patent *Ex Parte* Reexamination File History10

V. DETAILED EXPLANATION OF REASONS FOR RELIEF SHOWING IT IS MORE LIKELY THAN NOT THAT THE CHALLENGED CLAIMS ARE UNPATENTABLE12

A. The Challenged Claims are Invalid under §§ 102 and/or 10312

1. Claim Construction13

2. Ground 1: Claims 1-15 and 22-30 are Anticipated Under 35 U.S.C. § 102 by Cohen15

3. Ground 2: Claims 16-21 are Obvious Under 35 U.S.C. § 103 by Cohen in View of Musmanno37

| | | |
|------------|---|-----------|
| 4. | Ground 3: Claims 1-15 and 22-30 are Anticipated Under 35 U.S.C. § 102 by Flitcroft | 45 |
| 5. | Ground 4: Claims 16-21 are Obvious Under 35 U.S.C. § 103 by Flitcroft in View of Musmanno | 69 |
| VI. | CONCLUSION | 79 |

PETITIONER’S LIST OF EXHIBITS

- Exhibit 1001 – U.S. Patent No. 7,840,486
- Exhibit 1002 – File History for U.S. Patent No. 7,840,486
- 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”)
- Exhibit 1013 – File History for U.S. Patent No. 8,036,988

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 1-30 (all claims) of U.S. Pat. No. 7,840,486 (“the ‘486 Patent”), issued to John D’Agostino (“D’Agostino”). 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 1-30 as unpatentable under §§ 102 and/or 103.

I. INTRODUCTION

The ‘486 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 single merchant. This was a practice that was common in the credit card industry before the priority date of the ‘486 Patent. During prosecution, the ‘486 Patent issued only after the Applicant attempted to distinguish the claims over the prior art on the basis of the following limitation:

defining a payment category including at least limiting purchases to a single merchant for at least one transaction, said single merchant limitation being included in said payment category prior to any particular merchant being identified as said single merchant

However, this limitation does not in fact distinguish the claims of the ‘486 patent from the prior art. The prior art already disclosed the use of credit card

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