UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED Petitioner

v.

D'AGOSTINO, JOHN Patent Owner

Case CBM2013-00058 Patent 7,840,486

Before PATRICK E. BAKER, Trial Paralegal

PATENT OWNER'S PRELIMINARY RESPONSE



A L A R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>.

TABLE OF CONTENTS

TABLE OF AUTHORITIES iv					
LIST OF EXHIBITS					
I.	IN	TRODUCTION 1			
II.	BA	CKGROUND			
	A.	Overview of the '486 Patent 2			
	B.	Status of Pending District Court Action			
III.	ST	ATEMENT OF RELIEF REQUESTED 4			
IV.	STATEMENT OF REASONS WHY THE COVERED BUSINESS METHOD REVIEW SHOULD BE DENIED				
	A.	MasterCard's proposed claim constructions			
	B.	The effective filing date of the '486 patent			
	C.	Flitcroft is not available as prior art against the '486 patent 5			
		1. Flitcroft's priorty claim			
		2. Flitcroft's prosecution history			
		3. The Flitcroft's provisional applications do not provide written description support for the claimed invention			
	D.	Even if Flitcroft was entitled priority to the Flitcroft provisional applications, Flitcroft does not antedate at least one material limitation of all the independent claims of the '486 patent			
	E.	The terminal disclaimer filed during examination of the '988 patent was not an admission that the '486 patent claims are patentably indistinct from the claims of the '988 patent			

F. The Ex Parte Reexamination of the '988 patent	14
G. Cohen does not disclose a material limitation of all the independent claims of '486 Patent	
1. Independent claim 1	
2. Independent claim 24	
3. Independent claim 25	
4. Independent claim 29	
CONCLUSION	

V.

TABLE OF AUTHORITIES

Cases

<i>In re Giacomini</i> , 612 F.3d 1380 (Fed. Cir. 2010)	
Quad Environmental Technologies Corp. v. Union Sanitary Dist., 946 F.2d 870 (Fed. Cir. 1991)	

Statutes

35 U.S.C. § 102	passim
35 U.S.C. § 103	1
35 U.S.C. § 119(e)	5
35 U.S.C. § 120	1
35 U.S.C. § 324(a)	

Other Authorities

Message from Chief Judge James Donald Smith,	
USPTO Discusses Key Aspects of New Administrative Patent Trials,	
http://www.uspto.gov/aia_implementation/smith-blog-extravaganza.jsp	
(last visited Dec. 18, 2013)	16

LIST OF EXHIBITS RELIED ON FOR THIS PRELIMINARY RESPONSE

Exhibit 2001 – File History for U.S. Patent No. 6,636,833

- Exhibit 2002 U.S. Provisional Application No. 60/092,500
- Exhibit 2003 U.S. Provisional Application No. 60/098,175
- Exhibit 2004 U.S. Provisional Application No. 60/099,614
- Exhibit 2005 Nov. 11, 2013 Patent Owner's Response in Reexamination No. 90/012,517

Exhibit 2006 – U.S. Patent No. 8,036,988

DOCKET A L A R M



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.