

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INC.,
Petitioner,

v.

JOHN D'AGOSTINO,
Patent Owner.

Case IPR2014-00543 (Patent 8,036,988 C1)
Case IPR2014-00544 (Patent 7,840,486 C1)

Before SALLY C. MEDLEY, KARL D. EASTHOM, AND
KALYAN K. DESHPANDE, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

ORDER
Authorization to File Additional Briefing
37 C.F.R. § 42.5

IPR2014-00543 (Patent 8,036,988 C1)

IPR2014-00544 (Patent 7,840,486 C1)

The Board held a conference call with Petitioner and Patent Owner on February 15, 2017. Petitioner and Patent Owner jointly request that (1) IPR2014-00543 and IPR2014-00544 are consolidated, as was handled by the United States Court of Appeals for the Federal Circuit, and (2) authorization to submit additional briefing, from both Petitioner and Patent Owner, in light of the decision by the United States Court of Appeals for the Federal Circuit in *John D'Agostino v. MasterCard International Incorporated*, 844 F.3d 945 (Fed. Cir. 2016). Petitioner and Patent Owner specifically request additional briefing to explain how, if at all, the decision impacts the application of the prior art on the “single merchant” limitation and the “one or more merchants” limitation. Petitioner and Patent Owner request fifteen pages of additional briefing. Petitioner and Patent Owner suggest that briefing can be submitted in a staggered format or submitted simultaneously. Petitioner and Patent Owner jointly submit that the additional briefing will not include any new evidence and Patent Owner requests that the briefing provide citations to already submitted papers to ensure no new evidence or arguments are submitted.

We grant both Petitioner’s and Patent Owner’s requests. IPR2014-00543 and IPR2014-00544 will be consolidated on remand. Petitioner and Patent Owner are reminded, however, to submit the consolidated filings to both IPR2014-00543 and IPR2014-00544 on the Patent Trial and Appeal Board electronic system. Petitioner is authorized to submit additional briefing, not to exceed fifteen pages, which will include citations to the previously existing record where the argument or evidence was originally introduced, due by Monday, March 13, 2017. Patent Owner is authorized to submit a response to Petitioner’s briefing, not to exceed fifteen pages, which will include citations to the previously existing record where the argument or evidence was originally introduced, due by Monday, March 27, 2017. Petitioner is

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further authorized to submit a reply to Patent Owner's response, not to exceed five pages, which will include citations to the previously existing record where the argument or evidence was originally introduced, due on Monday, April 10, 2017. All briefing submitted by Petitioner and Patent Owner shall not include any new evidence and is limited to addressing the effect of the Federal Circuit's decision on our Final Written Decision.

Order

It is

ORDERED that Petitioner's and Patent Owner's joint request to consolidate IPR2014-00543 and IPR2014-00544 is granted;

FURTHER ORDERED that Petitioner's and Patent Owner's joint request to submit additional briefing is granted;

FURTHER ORDERED that Petitioner is authorized to file additional briefing, where Petitioner's briefing shall not exceed fifteen pages, shall not include any new evidence and is limited to addressing the effect of the Federal Circuit's decision on our Final Written Decision, and is due no later than March 13, 2017;

FURTHER ORDERED that Patent Owner is authorized to file a response to Petitioner's additional briefing, where Patent Owner's reply shall not exceed fifteen pages, shall not include any new evidence and is limited to addressing the effect of the Federal Circuit's decision on our Final Written Decision and responding to Petitioner's arguments, and is due no later than March 27, 2017; and

FURTHER ORDERED that Petitioner is authorized to file a reply to Patent Owner's response, where Petitioner's reply shall not exceed five pages, shall not include any new evidence and is limited to responding to Patent Owner's additional briefing, and is due no later than April 10, 2017.

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