

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

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

Title: System and Method for Performing Secure Credit Card Transactions

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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PETITIONER'S UPDATED LIST OF EXHIBITS

<u>Exhibit No.</u>	<u>Description</u>
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")
Exhibit 1013	File History for U.S. Patent No. 7,840,486
Exhibit 1014	Patent Trial and Appeal Board's ("PTAB") 3/7/14 CBM Decision for U.S. Patent No. 8,036,988
Exhibit 1015	Patent Owner's 12/24/13 Preliminary Response to Petitioner's Request for CBM Patent Review of the '988 Patent

Petitioner's Reply to Patent Owner's Response

Exhibit 1016	U.S. Provisional App. No. 60/079,884 (“884 Provisional)
Exhibit 1017	U.S. Provisional App. No. 60/099,614 (“614 Provisional)
Exhibit 1018	U.S. Provisional App. No. 60/098,175 (“175 Provisional)
Exhibit 1019	U.S. Provisional App. No. 60/092,500 (“500 Provisional)
Exhibit 1020	Statement Regarding Prior or Concurrent Proceedings (37 C.F.R. § 1.565)
Exhibit 1021	Examiners “Statement of Reasons for Patentability and/or Confirmation”
Exhibit 1022	Patent Owner's 09/11/14 E-mail to Petitioner
Exhibit 1023	Petitioner's 09/11/14 E-mail to Patent Owner
Exhibit 1024	U.S. Census Bureau, “Statistics of U.S. Businesses Employment and Payroll Summary: 2012”

I. Introduction

Patent Owner's Response attempts to distinguish the claims of the '988 patent from Cohen by presenting three principal arguments. Patent Owner contends that Cohen does not disclose: (1) a payment category that limits transactions to a single merchant; (2) a payment category that limits transactions to one or more merchants; and (3) defining a payment category that places limitations on a transaction code before generating the transaction code. Response at 1-2. Patent Owner's arguments, however, are premised on claim constructions already rejected by the Board in its Decision to Institute ("ID"). ID at 6-10. Because Cohen explicitly discloses each of the limitations at issue, as properly construed by the Board, all claims of the '988 patent are unpatentable and should be canceled.

II. Claim Construction

Patent Owner and its declarant¹ premise their arguments on flawed claim constructions that are divorced from the broadest reasonable interpretation standard applicable to this proceeding. 37 C.F.R. § 42.100(b).

¹ Edward L. Gussin's testimony should be given no weight because his opinions are based on flawed claim constructions previously rejected by the Board, and because he lacks the minimum qualifications that he concedes are required of a person of ordinary skill in the art. Ex. 2007 ¶ 30; Ex. 1008 ¶ 18.

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