

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED
Petitioner

v.

D'AGOSTINO, JOHN
Patent Owner

Case IPR2014-00543
Patent 8,036,988

PATENT OWNER'S REQUEST FOR ORAL ARGUMENT

In accordance with 37 C.F.R. § 42.70(a) and the Scheduling Order entered on September 4, 2014 (Paper 9), Patent Owner requests oral argument on the patentability of the challenged claims in U.S. Patent No. 8,036,988. In particular, Patent Owner requests, without waiving consideration of any issue not listed below, argument on the following issues:

- (1) the proper construction of the term “generating a transaction code;”
- (2) the proper construction of the term “particular merchant;”
- (3) the proper construction of the term “single merchant;”
- (4) the proper construction of the term “said single merchant limitation;”
- (5) the proper construction of the term “said one or more merchants limitation;”

and any other disputed claim terms;

- (6) the patentability of the challenged claims 1-38 over instituted Grounds 1 and 2;
- (7) all motions to exclude filed by the parties; and
- (8) any other matters raised by Petitioner or the Board.

A similar request is being filed today in proceeding IPR2014-00544, which concerns U.S. Patent No. 7,840,486. Because of the similarities at issue in these two IPR proceedings, the Patent Owner requests one hour per side for the two IPR proceedings. The Board has already scheduled Oral Argument for May 12, 2015. *See* Paper 9.

Patent Owner requests the use of audio/visual equipment to display demonstrative exhibits, including the use of a projector and screen for power point display, and will

contact the Board Trial Division paralegal, per the Trial Practice Guide. 77 Fed. Reg. at 48768.

Respectfully Submitted,

April 2, 2015

By: /s/ Stephen Lewellyn
Stephen J. Lewellyn (Reg. No. 51,942)
Brittany J. Maxey (Reg. No. 57,621)
Maxey Law Offices, PLLC
100 Second Avenue South
Suite 401 North Tower
St. Petersburg, Florida 33701
Telephone: 727-230-4949
Facsimile: 727-230-4827
s.lewellyn@maxeyiplaw.com
b.maxey@maxeyiplaw.com
Agent and Attorney for Patent Owner,
John D'Agostino

CERTIFICATE OF SERVICE

Under 37 C.F.R. §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on April 2, 2015, a complete and entire copy of this Patent Owner's Request for Oral Argument was provided via email to the Petitioner by serving the correspondence email addresses of record as follows:

Robert Scheinfeld, Lead Counsel
Baker Botts LLP
30 Rockefeller Plaza, 44th Floor
New York, New York 10112-4498
Service Email: robert.scheinfeld@bakerbotts.com

Eliot William, Back-up Counsel
Baker Botts LLP
1001 Page Mill Road
Building One, Suite 200
Palo Alto, California 94304-1007
Service Email: eliot.williams@bakerbotts.com

Respectfully submitted,

/s/Stephen Lewellyn
Stephen J. Lewellyn
Reg. No. 51,942
Agent for Patent Owner