

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 OBJECTIONS UNDER 37 C.F.R. § 42.64
TO PATENT OWNER'S EVIDENCE SUBMITTED WITH
PATENT OWNER'S RESPONSE

Pursuant to 37 C.F.R. § 42.64, Petitioner MasterCard International Incorporated (“MasterCard”) submits the following objections to the evidence submitted with Patent Owner’s Response Under 37 C.F.R. § 42.120 (“Patent Owner’s Response”). MasterCard objects to the Declaration of Edward L Gussin (Exhibit 2007, hereafter “Gussin Declaration”) and all corresponding portions of Patent Owner’s Response that rely on the paragraphs of the Gussin Declaration, as follows:

- MasterCard objects, under Fed. R. Evid. 401, 402, 403, and 702 (respectively, “Rules 401, 402, 403, and 702”), to the admission into evidence of the entire Gussin Declaration because Mr. Gussin is not someone of ordinary skill in the art and, consequently, his opinions are irrelevant (under Rule 401), inadmissible (under Rule 402), should be excluded as prejudicial, confusing and wasteful (under Rule 403), and unqualified (under Rule 702). Mr. Gussin himself states that he “generally agree[s] with Dr. Grimes’s definition of a person of ordinary skill in the art,” which according to Dr. Grimes is “a person having a B.S. degree in Electrical Engineering or Computer Science, or the equivalent experience, *with at least three years of experience* (or post-graduate work) in payment card payment technologies, including experience in existing, accepted remote payment card transaction practices in 1998-1999, such as methods of performing secure credit card purchases of

goods and services which reduces the risk of potential fraud and theft by eliminating unauthorized access to a consumer's private credit card information.” Expert Declaration of Dr. Jack D. Grimes (Exhibit 1008), p. 10. Nowhere, however, in Mr. Gussin's declaration (or appendices in support) is there any evidence to suggest that Mr. Gussin satisfies this requirement or has any experience whatsoever with payment card payment technologies or methods of performing secure credit card purchases. As a result, Mr. Gussin is not someone of ordinary skill in the art; he lacks sufficient bases for his opinions, which accordingly should be excluded.

- MasterCard objects, under Fed. R. Evid. 701, to the admission into evidence of the entire Gussin Declaration because as a lay witness he is not entitled to present opinion testimony.
- MasterCard objects, under Fed. R. Evid. 401, 402, and 403, to the admission into evidence of paragraphs 7 to 28, and 33 to 57 of the Gussin Declaration because such paragraphs present either (1) claim construction opinions offering constructions different from this Board's prior conclusions; and/or (2) “[o]pinions about Cohen” and anticipation that are based on such different constructions. As a result, such paragraphs are irrelevant (under Rule 401), inadmissible (under Rule 402), and

Petitioner's Objections Under 37 C.F.R. § 42.64

should be excluded as prejudicial, confusing and wasteful (under Rule 403).

For the reasons set forth above, MasterCard objects to the Gussin Declaration and all corresponding portions of Patent Owner's Response that rely on the Gussin Declaration.

December 12, 2014

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CERTIFICATE OF SERVICE

The undersigned certifies that on the 12th day of December, 2014, a complete and entire copy of PETITIONER'S OBJECTIONS UNDER 37 C.F.R. § 42.64 TO PATENT OWNER'S EVIDENCE SUBMITTED WITH PATENT OWNER'S RESPONSE were served via Federal Express, postage prepaid, and electronic mail to the Patent Owner's attorneys of record at the following address:

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