IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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

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PETITIONER'S MOTION TO EXCLUDE

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PETITIONER'S UPDATED LIST OF EXHIBITS

Exhibit No.	Description
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.
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Exhibit 1010	U.S. Patent No. 6,064,987 ("Walker")
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Exhibit 1012	ISO 8583 Financial Transaction Card Originated Messages – Interchange Message Specifications (1992) ("ISO 8583")
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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

Exhibit 1016	U.S. Provisional App. No. 60/079,884 ("'884 Provisional)
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Exhibit 1020	Statement Regarding Prior or Concurrent Proceedings (37 C.F.R. § 1.565)
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Exhibit 1024	U.S. Census Bureau, "Statistics of U.S. Businesses Employment and Payroll Summary: 2012"
Exhibit 1025	Petitioner's Objections Under 37 C.F.R. § 42.64 to Patent Owner's Evidence Submitted with Patent Owner's Response
Exhibit 1026	Declaration of Edward L. Gussin Served By Patent Owner under 37 C.F.R. § 42.64(b)(2)

I.   Introduction

Pursuant to 37 C.F.R. § 42.64(c), Petitioner MasterCard International Incorporated ("MasterCard") submits this Motion to Exclude Evidence submitted by Patent Owner John D'Agostino ("Patent Owner"). MasterCard moves to exclude the declaration of Patent Owner's proffered expert, Edward L. Gussin, under Federal Rule of Evidence 702 because he is not qualified as an expert on the subject matter of U.S. Patent 8,036,988 (the "Challenged Patent").

The definition of a person of ordinary skill in the field of the Challenged Patent is not in dispute. Mr. Gussin agrees with the definition of a person of ordinary skill proposed by MasterCard's expert, Dr. Jack Grimes. However, there is no evidence that Mr. Gussin himself has the qualifications that he admits are required for a person of ordinary skill in the art. It is well-settled that, to be qualified as an expert, one must at least be a person of ordinary skill. *See Sundance, Inc. v. Demonte Fabricating Ltd.*, 550 F.3d 1356, 1363 (Fed. Cir. 2008). Mr. Gussin is not. Accordingly, Mr. Gussin's declaration (Patent Owner Exhibit 2007) should be excluded and any conclusions drawn therefrom deemed unsupported.

II.   Statement of Law

Under the rules governing *inter partes* review, "[e]xcept as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a

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