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 OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE EVIDENCE

Patent Owner's Updated List of Exhibits

Exhibit 2001:	File History for U.S. Patent No. 6,636,833 (Flitcroft)
Exhibit 2002:	CRU Statement (Reexamination No. 90/012,517)
Exhibit 2003:	Appeal Brief (Reexamination No. 90/012,517)
Exhibit 2004:	U.S. Patent No. 5,621,201
Exhibit 2005:	Excerpts from Oxford Dictionary, Eighth Edition
Exhibit 2006:	Excerpts from Random House Webster's College Dictionary
Exhibit 2007:	Declaration of Edward L. Gussin
Exhibit 2008:	Supplemental Declaration of Edward L. Gussin
Exhibit 2009:	Service of Supplemental Declaration of Edward L. Gussin.

1. Introduction

This opposition addresses Petitioner's objections to the Declaration of Patent Owner's expert Mr. Edward L. Gussin. These objections appear to be based on three errors by Petitioner: (1) its misinterpretation that an expert must have personal experience in the field of the invention to be qualified to testify; (2) that the Board's preliminary claim constructions bar the Patent Owner from submitting evidence on claim construction and patentability under those claim constructions; and (3) that the Board is unable to weigh Mr. Gussin's testimony without prejudice or confusion and without being misled.

2. Argument

A. An individual is not required to have personal experience in the field of an invention to qualify as an expert.

The Federal Circuit instructs that an individual not skilled in the field of an invention is qualified as an expert when his "testimony [establishes] an adequate relationship between his experience and the claimed invention."[1] Indeed, Federal Rule of Evidence 702 provides: "A witness who is qualified as an expert by knowledge, skill, experience, training or education may testify in

[1] *SEB S.A. v. Montgomery Ward & Co., Inc.*, 594 F.3d 1360, 1373 (2010).

the form of an opinion or otherwise."[2] Moreover, "[u]nlike an ordinary witness . . . an expert is permitted wide latitude to offer opinions, including those that are not based on firsthand knowledge or observation."[3] An expert witness in a patent case does not "need to be officially credentialed in the specific matter under dispute."[4] "Rule 702 imposes no requirement that experts have personal experience in an area to offer admissible testimony."[5] Furthermore, the Board recognizes "there is no requirement for a perfect match between the expert's experience and the field of the patent."[6]

Here, U.S. Patent Number 8,036,988 ("the '988 patent") is in the field of secure credit card purchases, which intrinsically involves computer hardware and software technology. Mr. Gussin testified that his education and extensive experience as it relates to computer hardware and software technology qualifies

---

[2] Fed. R. Evid. 702.

[3] *Daubert v. Merrell Dow Pharm. Inc.*, 509 U.S. 579, 592 (1993).

[4] *Massok v. Keller Indus. Inc.*, 147 Fed. Appx. 651, 656 (9th Cir. 2005).

[5] *Asetek Danmark A/S v. CMI USA, Inc.*, 2014 WL 5590699 at *2 (N.D. Ca. Nov. 2, 2014) (quoting *Abaxis Inc. v.Cepheid*, 2012 WL 2979019 (N.D. Ca. July 19, 2012)).

[6] IPR2013-00285, Paper 47, at 34-35 (PTAB Nov. 19, 2014) (citing *SEB S.A.*, 594 F.3d at 1372-73).

him as an expert to offer opinions in this proceeding. Specifically, Mr. Gussin testified that his relevant education and experience includes:

- An M.S. degree in Electrical Engineering from the University of Southern California.[7]
- 39 years of experience as an electrical engineer developing computer hardware and software systems with technology relating to the technology of the '486 patent.[8]
- Served as an expert on claim construction and patent validity in six prior patent litigation cases relating to computer hardware and software technology.[9]
- An inventor on four U.S. patents related to computer hardware and software technology.[10]

Mr. Gussin's testimony reveals that his extensive experience and knowledge as a degreed electrical engineer in computer hardware and software technology

[7] Declaration of Edward L. Gussin, Ex. 2007 ("Gussin Dec."), at ¶ 2; Supplement Declaration of Edward L. Gussin, Ex. 2008 ("Gussin Supp. Dec"), at ¶ 4.

[8] Ex. 2007 at ¶ 4; Ex. 2008 at ¶¶ 6-7.

[9] Ex. 2007 at App. A; Ex. 2008 at ¶¶ 10-15.

[10] Ex. 2007 at App. A; Ex. 2008 at ¶ 16.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.