

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 IN SUPPORT OF ITS MOTION TO EXCLUDE

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I. Introduction

Petitioner MasterCard International Incorporated (“MasterCard”) submits this Reply in support of its Motion to Exclude Evidence submitted by Patent Owner John D’Agostino (“Patent Owner”). In its Opposition, Patent Owner argues that the declaration of its proffered expert, Edward L. Gussin, is admissible because there is an “adequate relationship between his experience and the claimed invention.” Opposition, pp. 1, 5. Patent Owner, however, fails to explain in particular how Mr. Gussin’s general experience in computer hardware and software technology is related in any way to credit card controls or to performing secure credit card transactions, the technical fields underlying U.S. Patent 8,036,988 (the ‘988 Patent). Further, even if Mr. Gussin’s testimony is admissible, it should be entitled to little or no weight given the fact that his technical experience is unrelated to the technology at issue.

In addition, Patent Owner argues that the Board’s claim constructions in its Decisions to Institute are only preliminary and that, as a result, Mr. Gussin’s testimony need not be consistent with the Board’s constructions. Patent Owner, however, just repeats the same claim construction arguments without citing any authority supporting its contention that it should have another chance to present the same claim construction arguments.

II. Mr. Gussin's Proffered Expert Testimony Should be Excluded Because He Is Not Qualified as an Expert In the Pertinent Art

Contrary to Patent Owner's suggestion, the proffered expert in *Sundance* was not simply a patent attorney, but also was a mechanical engineer with practicing experience. *See Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1361 (Fed. Cir. 2008); *see also Brief of Appellant DeMonte Fabricating Ltd.*, 2007 WL 4739102, at *7 (Dec. 21, 2007). Despite having technical expertise, the Federal Circuit found that the proffered expert's testimony was inadmissible because his expertise was not sufficiently related to the specific mechanical field of the claimed invention, i.e., "the field of tarps or covers." *Id.* at 1361-62. Similarly, Mr. Gussin may have technical expertise as an engineer but this proffered expertise is not in any way related to the specific field of the claimed invention.

Patent Owner argues that Mr. Gussin's expert testimony is admissible under Federal Rule of Evidence 702 because his "testimony [establishes] an adequate relationship between his experience and the claimed invention." *SEB S.A. v. Montgomery Ward & Co., Inc.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010). But Patent Owner fails to explain how Mr. Gussin's experience is related to the claimed invention. In particular, Patent Owner admits that the '988 Patent is in the field of "secure credit card purchases" and it does not dispute that Mr. Gussin has no expertise in secure credit card purchases. (In fact, Mr. Gussin has no experience

whatsoever with the payment industry, with card payment technologies, or with remote payment card transaction practices.) Instead, Patent Owner only contends that Mr. Gussin has general experience in the field of “computer hardware and software technology.” This fails to meet the requirements of FRE 702, however, because none of Mr. Gussin’s computer-related experience is related to what he himself admits is the pertinent field of technology underlying the claimed invention – secure credit card purchases.

Unlike the expert in *SEB*, Mr. Gussin has not provided any evidence to demonstrate how his experience is relevant to the claimed invention. *See SEB*, 594 F.3d at 1373. In *SEB*, the Federal Circuit admitted the testimony of the expert because he explained that the claimed invention “involves the selection of particular ... polymer material that have certain characteristics and furthermore that [m]ost of the areas [he has] worked in ... have used polymers in one form or another.” *Id.* (internal quotations omitted). Having testified that he had “sufficient relevant technical expertise” to the claimed invention, the Federal Circuit permitted the expert’s testimony under FRE 702. *Id.*

Here, on the other hand, Mr. Gussin has failed to establish a relationship between his experience and the claimed invention. In fact, Mr. Gussin has not presented any evidence that his general experience in computer hardware and software technology is adequately related to the field of secure credit card

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