

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 PRELIMINARY RESPONSE

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A. Flitcroft does not have a prior art date as of the filing dates of the provisional applications to which it claims priority..... 8

 (1) Flitcroft’s disclosure of limiting to a specific merchant as determined by a first use is not supported by any of the Flitcroft provisional applications. 10

 (2) The Flitcroft provisional applications do not support Flitcroft’s independent claims 1, 3, 5, 7, and 19..... 13

 (3) MasterCard and its expert Grimes fail to demonstrate that Flitcroft is available as prior art under 102(e) against the ‘988 patent..... 17

B. MasterCard is not entitled to the relief sought on the basis of Cohen. 19

 (1) Cohen does not disclose a material limitation of each independent claim of the ‘988 patent..... 19

 (a) The petition impermissibly combines separate, distinct embodiments of Cohen in an attempt to satisfy all of the independent claim 21..... 19

 (b) Cohen does not disclose limiting transactions to a single merchant before identifying any particular merchant as the single merchant..... 22

(c) Cohen does not disclose designating/selecting a payment category that places limitations on a transaction code before the transaction code is generated for use to make purchases. 23

(d) Cohen does not disclose limiting use to one or more merchants before any particular merchant is identified as the one or more merchant. 26

(2) The petition does not identify the differences between the prior art and the claims or articulate a rationale for why a person of ordinary skill in the art would have modified the prior art to meet the claims. 28

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Cases

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