

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 C1

Before SALLY C. MEDLEY, KARL D. EASTHOM, and
KALYAN K. DESHPANDE, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

John D’Agostino (“Patent Owner”) filed a Request for Rehearing (Paper 29; “Req. Reh’g”) of our Final Decision (Paper 28, “Final Decision”), dated August 31, 2015, which held unpatentable claims 1–38 of Patent No. 8,036,988 C1¹ (Ex. 1001; “the ’988 patent”). Generally, Patent Owner contends the Board misapprehended or overlooked the proper interpretation for the claim term “as said single merchant,” as recited by claims 21 and 23–30, and, under Patent Owner’s interpretation, the prior art fails to disclose this limitation. Req. Reh’g 2–6. Accordingly, Patent Owner requests a rehearing for only claims 21 and 23–30. *Id.* at 1. For the reasons stated below, Patent Owner’s request for rehearing is *denied*.

II. STANDARD OF REVIEW

“The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

III. DISCUSSION

In its Final Decision, the Board determined, under the broadest reasonable interpretation, the limitation “said single merchant limitation being included in said payment category prior to any particular merchant being identified as said single merchant” means “the merchant transactions are limited to a single merchant and are included in the payment category prior to the customer selecting a particular merchant for a transaction.” Final Decision 13. The Board also determined that

¹ A Reexamination Certificate was issued on October 15, 2014.

the “single merchant” includes the “particular merchant” without identifying the “particular merchant.” *Id.* at 11–12.

Patent Owner contends that the Board misapprehended or overlooked the proper interpretation for the claim limitation “as said single merchant,” which immediately follows the claim language “prior to any particular merchant being identified,” and the Board dropped this limitation from the claims. Req. Reh’g 2–6. Patent Owner specifically argues that the Board improperly removed “as said single merchant” from the claim limitation because the claim requires that the “particular merchant” is the “single merchant.” *Id.* at 3–5. Patent Owner contends that the Board’s construction is erroneous because the Board did not account for the requirement that the “particular merchant” is the “single merchant.” *Id.* Patent Owner concludes that the erroneous claim construction “inevitably lead to the Board’s incorrect finding that Cohen’s chain of stores limit satisfies the claim limitation.” *Id.* at 5.

We are not persuaded by Patent Owner’s argument. The Board could not have misapprehended or overlooked Patent Owner’s argument because Patent Owner is raising this argument for the first time on rehearing. Patent Owner cites pages 18–22 and 31–32 of the Patent Owner’s Response to support their argument that this issue was raised during the proceeding. *Id.* at 2. However, we are unable to find this argument in the Patent Owner’s Response. Patent Owner had argued the broadest reasonable construction of “said one or more merchants limitation being included in said payment category prior to any particular merchant being identified as one of said one or more merchants” and “said single merchant limitation being included in said payment category prior to any particular merchant being identified as said single merchant.” PO Resp. 18-22. However, Patent Owner’s argument is directed towards the entire limitation and is not narrowly

tailored to “as said single merchant,” and the proper interpretation of “as said single merchant.” Patent Owner further argued the broadest reasonable construction of “said single merchant limitation,” which is not the same as “as said single merchant.” *Id.* at 18–22. Patent Owner additionally argued that Cohen’s chain of stores limit does not meet the claim limitation, as construed by Patent Owner. *Id.* at 31–32. However, the argument that the Board dropped “as said single merchant” from the claim limitation, and the Board’s construction results in the single store of the chain of stores as both the “single merchant” and as the “particular merchant” was not raised until this rehearing request. Accordingly, we are not persuaded that we misapprehended or overlooked Patent Owner’s argument because it was not raised.

Furthermore, the Board expressly construed the limitation “said single merchant limitation being included in said payment category prior to any particular merchant being identified as said single merchant” to mean “the merchant transactions are limited to a single merchant and are included in the payment category prior to the customer selecting a particular merchant for a transaction” and the “single merchant” includes the “particular merchant” without identifying the “particular merchant.” Final Decision 11–13. The Board determined that absent such a relationship between the recited “single merchant” and “particular merchant,” the claim language would be indefinite as ambiguously limiting transactions to an unidentified, particular merchant. *Id.* at 12. The Board further determined that Cohen’s disclosure limiting credit card purchases to a specific chain of stores, such as a specific chain of restaurants, meets this limitation. *Id.* at 18–19. Based on our claim construction, the chain of stores (the “single merchant”) does not identify the single store (the “particular merchant”), but the

single store (the “particular merchant”) is still a subset of the chain of stores (the “single merchant”).

Patent Owner explains that the Board’s error can be illustrated most easily by example, where Target is the “single merchant” and Location A is the “particular merchant.” Req. Reh’g 4–5. Patent Owner argues that in this example, it can be seen that the Board’s construction is erroneous because Target and Location A cannot work without dropping “as said single merchant” from the claim limitation. *Id.* However, Patent Owner’s analysis stops here.² Patent Owner does not provide any argument or rationale to illustrate why Target cannot be the “single merchant” and Location A cannot be the “particular merchant,” thereby Target is included in the payment category prior to any particular Target, such as Location A, is identified as the specific Target.

Accordingly, we are not persuaded that the Board misapprehended or overlooked the entire claim limitation “said single merchant limitation being included in said payment category prior to any particular merchant being identified as said single merchant.”

IV. ORDER

Accordingly, it is hereby

ORDERED that Patent Owner’s Request for Rehearing is *denied*.

² We note that although Patent Owner finds the Board’s construction erroneous and provides an example to illustrate its argument, Patent Owner does not provide a construction of this limitation, and is unable to offer the Board an example to illustrate its construction.

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