

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.

D'AGOSTINO, JOHN  
Patent Owner

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Case IPR2014-00543 (Patent 8,036,988)  
Case IPR2014-00544 (Patent 7,840,486)

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**PATENT OWNER'S BRIEF ON REMAND**

**Patent Owner's Updated List of Exhibits IPR2014-00543, IPR2014-00544**

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
Exhibit 2010:	Patent Owner's Demonstratives for Oral Hearing
Exhibit 2011:	Federal Circuit Briefing on Appeal

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## 1. Introduction

The Board, after fully considering Cohen and the parties' arguments, found it necessary to address only the "chain of stores" use restriction in the Final Written Decisions (FWDs). The Board found the "chain of stores" use restriction satisfied the claims based upon a claim construction that allowed identifying a chain store when the transaction code is requested. On appeal, the Federal Circuit found this claim construction, which allows for merchant pre-identification, was unreasonable. *D'Agostino v. MasterCard Int'l Inc.*, 844 F.3d 945, 950 (Fed. Cir. 2016). The claim construction was unreasonable because it impermissibly separated the connection between the "single merchant" and the "particular merchant," thereby allowing the claim to be incorrectly satisfied by use restrictions that include merchant pre-identification. *Id.*

The Court's reasoning in rejecting the claim construction of the "single merchant limitation" requires the Board to now revise the claim construction of the "one or more merchants limitation." Under the correct claim construction, the "chain of stores" use restriction cannot satisfy the "one or more merchants limitation" because identifying the chain store when requesting the transaction code does not withhold the identity of the particular merchant.

Petitioner offers no argument supporting the “chain of stores” or similar use restrictions (i.e., types of stores or types of charges) satisfying the “one or more merchants limitation” under the correct claim construction. The reason for this is quite simple, Petitioner’s original arguments are based upon a flawed claim construction that incorrectly separates the “particular merchant” from the “one or more merchants.” Indeed, Petitioner urges the Board to leave the original claim construction of the “one or more merchants limitation” intact because without this claim construction none of Cohen’s use restrictions meet the claim requirements.

Under the correct claim construction, Petitioner’s original arguments, which stand entirely upon that impermissible separation, simply fall short of meeting Petitioner’s burden. And the Board cannot jump in and bail Petitioner out by supplanting Petitioner’s arguments with its own. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380-81 (Fed. Cir. 2016).

For the reasons that follow, under the Federal Circuit’s decision, Cohen does not anticipate any of the independent claims of U.S. Patent Number 8,036,988 (“the ‘988 Patent”) and U.S. Patent Number 7,840,486 (“the ‘486 Patent”). Accordingly, the Board is requested to issue new Final Written Decisions that confirm the patentability of the ‘988 Patent and the ‘486 Patent.

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