

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED
Petitioner

v.

D'AGOSTINO, JOHN
Patent Owner

Case IPR2014-00544
Patent 7,840,486

**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 the form of an

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

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 7,840,486 (“the ‘486 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 provides him with the necessary skill and knowledge relevant to the technology of

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.

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