

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 PRELIMINARY RESPONSE

TABLE OF CONTENTS

TABLE OF AUTHORITIES.....	iv
LIST OF EXHIBITS	vi
1. Introduction	1
2. Overview of the '486 Patent.....	3
3. Claim Construction.....	4
4. The Petition Fails to Establish Unpatentability of the '486 Patent	6
A. Flitcroft does not have a prior art date as of the filing dates of the provisional applications to which it claims priority.	6
(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.	8
(2) The Flitcroft provisional applications do not support Flitcroft's independent claims 1, 3, 5, 7, and 19.	11
(3) MasterCard and its expert Grimes fail to demonstrate that Flitcroft is available as prior art under 102(e) against the '486 patent.	15
B. MasterCard is not entitled to the relief sought on the basis of Cohen.....	17
(1) Cohen does not disclose a material limitation of each independent claim of the '486.....	18
(a) The petition impermissibly combines separate, distinct embodiments of Cohen in an attempt to satisfy all of the independent claims.	18
(b) Cohen does not disclose limiting transactions to a single merchant before identifying any particular merchant as the single merchant.	20
(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

(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. 26

(3) The terminal disclaimer filed during examination of the '988 patent was not an admission that the '486 patent claims are patentably indistinct from the claims of the '988 patent. 30

5. Conclusion..... 31

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35 U.S.C. § 316(e) 7

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37 C.F.R. § 42.100(b)..... 4

37 C.F.R. § 42.108(c) 6

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