

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)
Case IPR2014-00544 (Patent 7,840,486)

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

DESHPANDE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Case IPR2014-00543 (U.S. Patent No. 8,036,988)
Case IPR2014-00544 (U.S. Patent No. 7,840,486)

On September 17, 2014, the initial conference call was held between counsel for the respective parties and Judges Medley, Easthom, and Deshpande.

Motions

Petitioner requests authorization to file a motion to stay Ex Parte Reexamination proceeding 90/012517. Petitioner specifically requests authorization to file this motion because a Notice of Intent to Issue a Reexam Certificate was mailed on September 12, 2014 and the position of Notice of Intent to Issue a Reexam Certificate and our position in our Decision to Institute are inconsistent. Patent Owner indicated that they will oppose Petitioner's motion to stay the Ex Parte Reexamination proceeding. We grant Petitioner's request for authorization to file a motion to stay the Ex Parte Reexamination proceeding for the reasons identified by the Petitioner. The motion is limited to five pages in length and must be submitted no later than September 22, 2014. Patent Owner is authorized to oppose Petitioner's motion, where the opposition is limited to five pages in length and must be submitted no later than September 27, 2014.

Neither party seeks authorization to file any additional motions at this time. As explained, if Patent Owner determines that it will file a motion to amend, Patent Owner must arrange a conference call with the Board and opposing counsel to discuss the proposed motion to amend. *See* 37 C.F.R. § 42.121(a).

The parties were reminded that if they seek authorization to file a motion not contemplated per the Scheduling Order, the party requesting such authorization must arrange a conference call with opposing counsel and the Board.

Schedule

Case IPR2014-00543 (U.S. Patent No. 8,036,988)
Case IPR2014-00544 (U.S. Patent No. 7,840,486)

Counsel for the respective parties indicated that they have no conflicts with the Scheduling Order entered September 4, 2014. Paper 9.

To the extent issues arise with DUE DATES 1-5 identified in the Scheduling Order, the parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DUE DATES 1-5, but no later than DUE DATE 6, as provided in the Scheduling Order, by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

Order

It is

ORDERED that Petitioner is authorized to file a motion to stay Ex Parte Reexamination Proceeding 90/012517 and Patent Owner is authorized to file an opposition to this motion.

FURTHER ORDERED Petitioner's motion to stay is limited to five pages in length and must be filed no later than September 22, 2014.

FURTHER ORDERED Patent Owner's opposition is limited to five pages in length and must be filed no later than September 27, 2014.

Case IPR2014-00543 (U.S. Patent No. 8,036,988)
Case IPR2014-00544 (U.S. Patent No. 7,840,486)

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