



## **PTAB Invalidates Method Claims of Two Patents Covering Secure Credit Card Transactions Based on 102(e) Prior Art Presented During Inter Partes Review**

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The petitioner, Mastercard International, Inc. (Mastercard) had previously petitioned for CBM review of claims from these same patents based on inter alia, the Cohen reference. See, e.g., CBM201300057. In its CBM petitions Mastercard contended that Cohen was 102(e) prior art to D'Agostino's claims. The Board declined to institute CBM review, concluding that Cohen had not been published before the D'Agostino patents' earliest effective filing dates. Cohen was, therefore, not prior art under § 18(a)(1)(C) of the AIA. Three weeks later Mastercard filed the IPR petitions that led to the PTAB's August 31 decision. In the IPRs the Board held that, because an IPR petitioner may challenge claims "on the basis of prior art consisting of patents or printed publications," Cohen was prior art in the IPR proceeding pursuant to 35 U.S.C. § 102(e). Thus, the very same reference that could not be used as prior art in a CBM review was available as prior art in an IPR. The PTAB then found that Mastercard had proved that Cohen anticipated, or, along with another reference, had rendered obvious, all claims challenged in the IPRs.

*Mastercard Int'l, Inc. v. D'Agostino*, IPR201400543, IPR201400544 (PTAB Aug. 31, 2015); see also *Mastercard Int'l, Inc. v. D'Agostino*, CBM201300057 (PTAB Mar. 7, 2014).

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