

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

UNIVERSAL SECURE REGISTRY LLC
Patent Owner

Case CBM2018-00024
U.S. Patent No. 8,577,813

**PATENT OWNER'S CONDITIONAL MOTION TO AMEND
UNDER 37 C.F.R. § 42.221**

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF AUTHORITIES	II
LIST OF EXHIBITS.....	III
I. INTRODUCTION.....	1
II. THE SUBSTITUTE CLAIMS ARE OF NARROWER SCOPE	2
III. THE NUMBER OF SUBSTITUTE CLAIMS IS REASONABLE.....	2
IV. THE SUBSTITUTE CLAIMS ADD NO NEW SUBJECT MATTER.....	2
V. THE PROPOSED SUBSTITUTE CLAIMS RESPOND TO AND OVERCOME THE GROUNDS OF RECORD	9
VI. CONCLUSION	9
APPENDIX A.....	1
APPENDIX B	1

TABLE OF AUTHORITIES

Page

Cases

Aqua Products, Inc. v. Joseph Matal et al.,
Case No. 2015-1177 (Fed. Cir. Oct. 4, 2017)..... 1

Statutory Authorities

35 U.S.C. § 326(d)..... 1, 2

Rules and Regulations

37 C.F.R. § 42.221(a)(2)(ii)..... 2

37 C.F.R. § 42.221(a)(3)..... 2

37 C.F.R. § 42.221 1, 2, 9

LIST OF EXHIBITS

Exhibit #	Description
Ex. 2001	Declaration by Dr. Markus Jakobsson Ph.D. in Support of Patent Owner's Preliminary Response.
Ex. 2002	Curriculum Vitae of Markus Jakobsson.
Ex. 2003	<i>Universal Secure Registry LLC v. Apple Inc.</i> , No. 17-585, Document 77 (D. Del., May 22, 2018)
Ex. 2004	Declaration by Allan Schiffman in Support of Patent Owner's Preliminary Response
Ex. 2005	Curriculum Vitae of Allan Schiffman
Ex. 2006	Declaration ISO of Unopposed Motion for Admission Pro Hac Vice of Harold A. Barza.
Ex. 2007	Declaration ISO of Unopposed Motion for Admission Pro Hac Vice of Jordan B. Kaericher.
Ex. 2008	U.S. Application No. 13/237,184.
Ex. 2009	U.S. Application No. 12/393,586.
Ex. 2010	Declaration by Dr. Markus Jakobsson Ph.D. in Support of Motion to Amend.

I. INTRODUCTION

Pursuant to 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221, Patent Owner Universal Secure Registry LLC (“PO”) submits this conditional motion (“Motion”) to substitute proposed claims 27-48 shown in Appendix A for original (*i.e.*, existing) claims 1, 2, 4-11, 13-20, and 22-26 of U.S. Patent No. 8,577,813 (“the ’813 Patent”) should any of claims 1-3, 16, 21-24, and 38 (“Challenged Claims”) be found unpatentable. That is, PO requests that for each original claim the Board deems invalid, the Board review and enter the corresponding substitute claim identified in Appendix A to replace the invalid claim. PO has conferred with the Board prior to filing this Motion, as required by 37 C.F.R. § 42.221, and the Board authorized the filing of this Motion in an Order *Conduct of the Proceeding* entered January 31, 2019. *See* Paper 17.

The proposed substitute claims satisfy the requisite showing for a motion to amend, as they (1) “do not impermissibly enlarge the scope of the claims;” (2) present a “reasonable number of substitute claims;” (3) “do not introduce new subject matter;” and (4) “respond to a ground of unpatentability in the trial.” *See* 35 U.S.C. § 326(d); 37 C.F.R. § 42.221. Patent Owner has thus met its burden of production. *Aqua Products, Inc. v. Joseph Matal et al.*, Case No. 2015-1177 (Fed. Cir. Oct. 4, 2017) (en banc). Accordingly, should the Board find any original Challenged Claim unpatentable in this proceeding, PO respectfully requests that

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