

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

**[CORRECTED] PATENT OWNER'S RESPONSE
PURSUANT TO 37 C.F.R. § 42.120**

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. OVERVIEW OF THE '813 PATENT	6
A. The '813 Patent Specification	6
B. The '813 Patent Claims	9
C. Prosecution History of the '813 Patent	9
III. OVERVIEW OF THE ASSERTED PRIOR ART	10
A. Maes (Ex. 1213)	10
B. Jakobsson (Ex. 1214)	13
C. Maritzen (Ex. 1215)	14
D. Labrou (Ex. 1216)	16
IV. LEVEL OF ORDINARY SKILL IN THE ART	18
V. CLAIM CONSTRUCTION	18
VI. STANDARD OF REVIEW	19
VII. THE '813 PATENT DOES NOT QUALIFY AS A "COVERED BUSINESS METHOD PATENT"	19
A. <i>IBG LLC v. Trading Technologies Int'l, Inc.</i> Mandates Dismissal	21
B. The Petition Fails To Prove The Claimed Subject Matter As A Whole Does Not Recite A Technological Feature That Is Novel And Unobvious Over The Prior Art	25
C. The Petition Fails To Prove The Claimed Subject Matter As A Whole Does Not Solve A Technological Problem Using A Technical Solution	31
VIII. GROUND 1: THE PETITION FAILS TO PROVE MAES IN VIEW OF JAKOBSSON RENDERS THE CHALLENGED CLAIMS OBVIOUS	38
A. The Petition Fails to Prove Maes Discloses A "Secure Registry"	38
B. The Petition Fails To Prove Jakobsson Discloses A "Secure Registry"	42

C.	The Petition Fails To Prove A POSITA Would Have Been Motivated To Combine Maes And Jakobsson To Teach A “Secure Registry”	43
1.	The Petition’s Arguments Are Conclusory.....	44
2.	The Petition Fails To Show How The Combination Would Work.....	46
3.	The Petition Fails To Prove Obvious To Try/Reasonable Expectation Of Success.....	47
4.	The Combination Would Change The Principal Of Operation Of Maes.....	47
D.	The Petition Fails To Prove Jakobsson Discloses “Generate Encrypted Authentication Information ...”	51
E.	The Petition Fails To Prove A POSITA Would Have Been Motivated To Combine Maes And Jakobsson To Teach “A Non-Predictable Value And To Generate Encrypted Authentication Information From The Non-Predictable Value, Information Associated With At Least A Portion Of The Biometric Input, And The Secret Information”	52
1.	The Petition Fails To Prove The References Propose The Same Solution For The Same Problem.....	53
2.	The Proposed Combination Changes The Basic Principles Of Maes.....	56
F.	The Petition Fails To Prove Dependent Claim 4 Is Invalid	59
G.	The Petition Fails To Prove Maes Discloses “Display Indicators For The Plurality Of Accounts In The User Interface, And The User Interface Is Configured To Accept User Selection Of A Respective One Of The Plurality Of Accounts.”/ “Displaying, On The User Interface Indicators For The Plurality Of User Accounts Stored In A Memory Of The Electronic ID Device” For Dependent Claims 13 And 17.....	60
H.	The Petition Fails To Prove Maes Discloses “De-Activating The Electronic ID Device...If The Identity Of The User Is Not Successful” For Dependent Claim 18	63
I.	The Petition Fails To Prove Jakobsson Discloses “An Act Of Generating A Seed” For Dependent Claim 19.....	64

J. The Petition Fails To Prove Dependent Claim 20 Is Invalid66

IX. GROUND 2: THE PETITION FAILS TO PROVE CLAIMS 6-10 ARE INVALID.....67

A. The Petition Fails To Prove Not Permitting User Input (Cl. 6-10).....67

1. The Petition Fails to Prove Maes Discloses Not Permitting User Input.....67

2. The Petition Fails to Prove Maritzen Discloses Not Permitting User Input.....69

3. The Petition Fails To Prove A POSITA Would Combine Maes And Maritzen.....69

B. The Petition Fails To Prove Dependent Claim 10 Is Invalid71

X. GROUND 3: THE PETITION FAILS TO PROVE CLAIMS 14-15, 22-23, 25-26 ARE INVALID72

A. The Petition Fails To Prove Maes Discloses Displaying Options For Purchase/Accepting Selections72

B. The Petition Fails To Prove A POSITA Would Combine Maes and Labrou.....73

XI. PETITIONER FAILED TO CONSIDER THE STRONG EVIDENCE OF SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS75

A. Long-felt Need and Failure of Others76

B. Commercial Success.....79

XII. CONCLUSION.....81

TABLE OF AUTHORITIES

<u>Cases</u>	<u>Page(s)</u>
<i>Apple Inc. v. Int’l Trade Comm’n</i> , 725 F.3d 1356 (Fed. Cir. 2013)	76
<i>Apple Inc. v. Samsung Elecs. Co. Ltd.</i> , 816 F.3d 788 (Fed. Cir. 2016)	76
<i>Apple v. Uniloc Luxembourg S.A.</i> , IPR2018-00420 (PTAB Aug. 6, 2018)	46
<i>Apple, Inc. v. Universal Secure Registry LLC</i> , CBM2018-00026 (PTAB Dec. 10, 2018)	2, 23, 24,28
<i>Arendi S.A.R.L. v. Apple Inc.</i> , 832 F.3d 1355 (Fed. Cir. 2016)	44
<i>Bloomberg L.P. v. Quest Licensing Corp.</i> , CBM2014-00205 (PTAB Apr. 7, 2015)	20, 25
<i>Cutsforth Inc. v. MotivePower, Inc.</i> , 636 F. App’x 575 (Fed. Cir. 2016)	44
<i>E*Trade Fin. Corp. v. Droplets, Inc.</i> , CBM2014-00123 (PTAB Oct. 30, 2014).....	28
<i>Emnos USA Corp. v. Dunnhumby Ltd.</i> , CBM2015-00116 (PTAB Nov. 10, 2015)	20
<i>Enfish, LLC v. Microsoft Corp.</i> , 822 F.3d 1327 (Fed. Cir. 2016)	30, 31
<i>Experian Mktg. Solutions, Inc. & Epsilon Data Mgmt. v. Rpost Commc’n Ltd</i> , CBM2014-00010 (PTAB. April 22, 2014).....	26, 29
<i>Finjan, Inc. v. Blue Coat Systems, Inc.</i> , 879 F.3d 1299 (Fed. Cir. 2018)	30
<i>General Electric Company v. United Technologies Corp.</i> , IPR2016-00531 (PTAB June 26, 2017).....	49
<i>Gillette Co. v. S.C. Johnson & Son, Inc.</i> , 919 F.2d 720 (Fed. Cir. 1990)	39

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.