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

REPLY TO PATENT OWNER'S RESPONSE

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I. Introduction

USR's Patent Owner Response ("POR") fails to rebut Petitioner's showing that the challenged claims are unpatentable. First, USR's assertion that the claimed invention is a "technological solution" fails because, as the Board already determined, "each [of the] steps uses a technological feature that was known in the art [and] the steps appear to be implemented in a conventional manner." DI, 12-13. Second, USR mischaracterizes the prior art references and the creativity and technical ability of persons having ordinary skill in the art. Finally, USR fails to demonstrate any secondary considerations of non-obviousness whatsoever.

II. The Board Correctly Found The '813 Patent To Be CBM Review Eligible.

A. The '813 Patent As A Whole Claims Subject Matter That Was Known And Obvious.

Despite the Board previously rejecting USR's argument that the '813 patent is ineligible for CBM review—finding that each claimed step uses a feature "that was known in the art" and that was "conventional"— USR wastes nearly half of its POR recycling its argument that the '813 patent solves a technical problem with a technical solution. DI, 12-13; Ex-1201, '813 patent, 43:54-44:7; Pet. 14.

Unsurprisingly, even USR's own expert, Dr. Jakobsson, admits that all the technology used by the '813 patent—from the hardware components, to the communication interface, to the database and encryption techniques—was known. Ex-1227, Jakobsson-Dep., 307:11-17 ('813 patent uses conventional biometric

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sensors), 308:19-21 ('813 patent uses a conventional user interface), 308:25-309:2 ('813 patent uses conventional fingerprint sensors), 309:16-18 ('813 patent uses conventional processors), 311:3-5 ('813 patent discloses no improvements to hardware), 312:3-5 ('813 patent discloses no new form of communication interface), 312:21-25 ('813 patent can be used with any form of database), 313:21-314:17 ('813 patent discloses no new form of encryption), 315:10-14 (temporary disabling of a device was prior art), 319:10-12 (point-of-sale terminals were prior art), 322:5-13 (multifactor authentication involving biometric information was prior art), 323:17-22 (authentication based on a time-varying token was prior art), 330:10-15 (limiting functionality of a user device based on a failed authentication was prior art), 355:22-356:2 (PIN and biometric based authentication was prior art); 357:9-11 (local authentication was prior art), 460:20-461:2 (combining local and remote authentication was prior art).

B. The Board Need Not Consider Whether The '813 Patent Is A Technical Solution To A Technical Problem.

Under 37 C.F.R. Section 42.401, CBM Review is inapplicable for patents directed toward "technological inventions" that either (1) claim subject matter that "as a whole recites a technological feature that is novel or unobvious over the prior art" or (2) "solves a technical problem using a technical solution." 37 C.F.R. § 42.401. The Board need not consider the second prong if, as here, the patent only recites technological features that were known or obvious. Final Written Decision,

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