

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

UNIVERSAL SECURE REGISTRY LLC,
Patent Owner.

Case IPR2018-00067
Patent 8,577,813 B2

Before BART A. GERSTENBLITH, SCOTT C. MOORE, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Petitioner, Unified Patents Inc., requests *inter partes* review of claims 1–3 and 5–26 of U.S. Patent No. 8,577,813 B2 (Ex. 1001, “the ’813 patent”). Paper 12 (“Pet.”).¹ Patent Owner, Universal Secure Registry LLC, filed a Preliminary Response (Paper 7, “Prelim. Resp.”) and a Supplemental Preliminary Response (Paper 13, “Supp. Prelim. Resp.”).²

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below, there is a reasonable likelihood that Petitioner will prevail in establishing the unpatentability of at least one claim. We, therefore, institute *inter partes* review of claims 1–3 and 5–26 of the ’813 patent. Our determinations at this stage of the proceeding are preliminary and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of the claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

A. RELATED MATTERS

The parties identify the following judicial matter involving the ’813 patent: *Universal Secure Registry LLC v. Apple Inc. et al.*, Case No. 1:17-cv-00585 (D. Del.) (filed May 21, 2017). Pet. 67; Paper 5.

¹ We authorized Petitioner to file a Corrected Petition. See Paper 11.

² We authorized Patent Owner to file a Supplemental Preliminary Response addressing claims 7–10. Paper 11, 5–7.

B. THE '813 PATENT

The '813 patent issued November 5, 2013, from an application filed September 20, 2011. Ex. 1001, [45], [22]. The '813 patent includes a number of priority claims, including dates as early as February 21, 2006. *Id.* at [63], [60], 1:6–32.

The '813 patent is titled “Universal Secure Registry” and is directed to authenticating a user using biometric and secret information provided to a user device, encrypted, and sent to a secure registry for validation. *Id.* at [57]. The Specification describes one aspect of the invention as an “information system that may be used as a universal identification system and/or used to selectively provide information about a person to authorized users.” *Id.*, 3:65–4:1. One method described for controlling access involves “acts of receiving authentication information from an entity at a secure computer network, communicating the authentication information to the secure registry system, and validating the authentication information at the secure registry system.” *Id.* at 4:43–48. The “universal secure registry” (“USR”) is described as a computer system with a database containing entries related to multiple people, with a variety of possible information about each person, including validation, access, and financial information. *Id.* at 9:35–12:18.

Validation information in the '813 patent “is information about the user of the database to whom the data pertains and is to be used by the USR software 18 to validate that the person attempting to access the information is the person to whom the data pertains or is otherwise authorized to receive it.” *Id.* at 12:19–23. Such information must “reliably authenticate the identity of the individual” and may include “a secret known by the user (e.g., a pin, a

phrase, a password, etc.), a token possessed by the user that is difficult to counterfeit (e.g., a secure discrete microchip), and/or a measurement such as a biometric (e.g., a voiceprint, a fingerprint, DNA, a retinal image, a photograph, etc.).” *Id.* at 12:23–31. The ’813 patent describes using such information in combination with other information “to generate a one-time nonpredictable code which is transmitted to the computer system” and used “to determine if the user is authorized access to the USR database.” *Id.* at 12:50–60; *see also id.* at 45:55–46:36. Communication between a user device and the secure registry may occur through a point-of-sale (“POS”) device in the ’813 patent. *Id.* at 43:4–44:31.

C. CHALLENGED CLAIMS

Petitioner challenges claims 1–3 and 5–26. Challenged claims 1, 16, and 24 are independent. Claim 1 (reproduced below) is illustrative of the claimed subject matter:

1. An electronic ID device configured to allow a user to select any one of a plurality of accounts associated with the user to employ in a financial transaction, comprising:
 - a biometric sensor configured to receive a biometric input provided by the user;
 - a user interface configured to receive a user input including secret information known to the user and identifying information concerning an account selected by the user from the plurality of accounts;
 - a communication interface configured to communicate with a secure registry;
 - a processor coupled to the biometric sensor to receive information concerning the biometric input, the user interface and the communication interface, the processor being programmed to activate the electronic ID device based on successful authentication by the electronic ID

device of at least one of the biometric input and the secret information, the processor also being programmed such that once the electronic ID device is activated the processor is configured to generate 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, and to communicate the encrypted authentication information via the communication interface to the secure registry; and wherein the communication interface is configured to wirelessly transmit the encrypted authentication information to a point-of-sale (POS) device, and wherein the secure registry is configured to receive at least a portion of the encrypted authentication information from the POS device.

Ex. 1001, 51:65–52:29.

D. PROPOSED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability, each based on 35 U.S.C. § 103(a):³

References	Challenged Claims
Maes, ⁴ Pare, ⁵ and Labrou ⁶	1–3, 5, 11–17, and 19–26
Maes, Pare, Labrou, and Burger ⁷	6–10 and 18

³ The America Invents Act included revisions to, *inter alia*, 35 U.S.C. § 103 effective on March 16, 2013. Because the '813 patent issued from an application filed before March 16, 2013, the pre-AIA version of 35 U.S.C. § 103 applies.

⁴ U.S. Patent No. 6,016,476, issued January 18, 2000 (Ex. 1003).

⁵ U.S. Patent No. 5,870,723, issued February 9, 1999 (Ex. 1004).

⁶ U.S. Patent Publication No. US 2004/0107170 A1, published June 3, 2004 (Ex. 1005).

⁷ International Publication WO 01/24123 A1, published April 5, 2001 (Ex. 1006).

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