

Exhibit 1045

Proposed Redacted Version of Final Written Decision

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*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner, Unified Patents Inc., requested *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 We instituted review. Paper 14 (“Inst.” or “Institution Decision”). Patent Owner filed a Response (Paper 28 (“PO Resp.”)) and a Conditional Motion to Amend (Paper 26 (“MTA”)); Petitioner filed a Reply (Paper 39 (“Reply”)) and an Opposition to Patent Owner’s Contingent Motion to Amend (Paper 34 (“MTA Opp.”)); Patent Owner filed a Surreply (Paper 42) and a Reply to Petitioner’s Opposition (Paper 43 (“MTA Reply”)); and Petitioner filed a Surreply to the Contingent Motion to Amend (Paper 44 (“MTA Surreply”)). We held a hearing on January 30, 2019, and a transcript is included in the record. Paper 51 (“Tr.”).

This is a final written decision as to the patentability of the challenged claims. For the reasons discussed below, we determine that Petitioner has proven by a preponderance of the evidence that each of claims 1–3, 5–9, 11, 13–18, 20, and 22–26 of the ’813 patent is unpatentable but has not proven that any of claims 10, 12, 19, and 21 is unpatentable. We deny Patent Owner’s Contingent Motion to Amend.

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.

A. RELATED MATIERS

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.

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 Abstract. 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.* at 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[P]. 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] a biometric sensor configured to receive a biometric input provided by the user;
 - [b] a user interface configured to receive a user input including secret information known to the user and

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