UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS INC.
Petitioner,

v.

UNIVERSAL SECURE REGISTRY LLC
Patent Owner

_____

Case IPR2018-00067
U.S. Patent No. 8,577,813

_____

**PATENT OWNER'S CONTINGENT MOTION TO AMEND
UNDER 37 C.F.R. § 42.121**

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LIST OF EXHIBITS

Exhibit #	Description
Ex. 2003	U.S. Application No. 13/237,184.

I.   INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner Universal Secure Registry LLC ("USR") submits this contingent motion ("Motion") to substitute proposed claims 27-52 shown in Appendix A for original claims 1-26 of U.S. Patent No. 8,577,813 ("the '813 Patent") should any of claims 1-3 and 5-26 ("Challenged Claims") be found unpatentable. Patent Owner has conferred with the Board prior to filing this Motion, as required by 37 C.F.R. § 42.121, and Board authorized the filing of this Motion in an Order *Conduct of Proceedings* entered June 20, 2018. *See* Paper 21.

In *Aqua Products*, *Inc. v. Joseph Matal et al.*, Case No. 2015-1177 (Fed. Cir. Oct. 4, 2017) (*en banc*), the Federal Circuit held that the burden of persuasion to establish that proposed amendments are patentable no longer rests with the patent owner. *Id*. at 5-6. Instead, it is the petitioner's burden to prove unpatentability of the proposed amendments. *Id*. In a motion to amend, a patent owner need only satisfy its burden of production under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121.

As explained below, the proposed substitute claims satisfy the requisite showing for a motion to amend. 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. § 316(d); 37 C.F.R. § 42.121. Patent Owner has thus met

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