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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

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IPR2018-00067
Patent 8,577,813

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**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT 8,577,813**

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I. INTRODUCTION

Petitioner Unified Patents Inc. ("Petitioner") respectfully requests *inter partes* review ("IPR") of claims 1-3 and 5-26 (collectively, the "Challenged Claims") of U.S. Patent 8,577,813 ("the '813 Patent") (EX1001).

The '813 Patent relates to a device onto which a user may store information regarding multiple financial accounts. The device is in communication with a secure registry—a system that includes a secure database that stores information, such as biometric data, that can be used to verify the user's identity to authorize a transaction. Named inventor Kenneth Weiss employed similar concepts in previous prior art published applications, such as U.S. Patent Application Publication 2002/0178364 ("*Weiss I*"), also titled "Universal Secure Registry," which describes limiting access to a database containing sensitive information using biometric verification. *Weiss I* (EX1008). Mr. Weiss has previously obtained patents for systems for personal identification that secure data using non-predictable codes, biocharacteristics, and/or secret information, such as a PIN, as far back as 1991. *See* U.S. Patent 4,998,279 (EX1019). The '813 Patent merely takes these old concepts, such as biometric and PIN verification and encrypting information using non-predictable values, and applies them in the context of wireless technology.

II. SUMMARY OF THE '813 PATENT

A. Description of the alleged invention

The '813 Patent relates to systems and methods for authenticating the identity of individuals and transmitting information to and from a user device. *See '813 Patent* (EX1001) at 1:37-47. The claims relate to methods and apparatuses for authorizing a transaction between a wireless electronic device capable of storing information related to a plurality of financial accounts and a point-of-sale ("POS") device using a secure registry.

Mr. Weiss described his system as one in which a user could securely perform transactions wirelessly without being required to carry around numerous financial and identification cards. *See '813 Patent* (EX1001) at 2:23-27, 3:26-28 (reducing fraud); *see also id.* at 3:48-50 (wireless transactions); *id.* at 3:57-64 (not requiring multiple forms of identification). The claims recite wirelessly transmitting encrypted authentication information from an electronic device to a POS device and subsequently transmitting at least a portion of that information from the POS device to a secure registry for authorization of a transaction. *See File History* (EX1002) at 447, 453. The claims also recite a user device generating encrypted authentication information from a non-predictable value, information associated with at least a portion of a user's biometric input and secret information. *Id.* at 454.

B. Summary of the prosecution history

Application 13/237,184, which resulted in the '813 Patent, was filed on September 20, 2011 as a member of a large chain of prior applications. '813 Patent (EX1001). For purposes of this proceeding, Petitioner simply assumes that the priority date for the Challenged Claims is February 21, 2006, the earliest claimed priority date.

During prosecution of the '813 Patent, the examiner relied primarily on a published application of Mr. Weiss to reject the pending claims. *See File History* (EX1002) at 467-479, 508-518; *see also Weiss I* (EX1008). Like the '813 Patent, *Weiss I* is titled "Universal Secure Registry" and relates to controlling access to secure systems, including by means of biometric verification and encrypting transaction information. *See, e.g., Weiss I* (EX1008) at Abstract, [0012].

The '813 Patent applicant raised two primary arguments for why his particular claimed variation of the universal secure registry system was not obvious over *Weiss I*. First, the applicant argued that *Weiss I* did not teach generating encrypted authentication information from a non-predictable value, where the information was associated with biometric input and secret information—the examiner disagreed. *See File History* (EX1002) at 493-94, 462-63, 454-55. Second, the applicant relied on amendments reciting transmitting the encrypted authentication information from an electronic ID device to a POS device, which in

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