

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.
Petitioner

v.

UNIVERSAL SECURE REGISTRY LLC
Patent Owner

IPR2018-00067
Patent 8,577,813

**PETITIONER'S RESPONSE IN OPPOSITION TO PATENT OWNER'S
CONTINGENT MOTION TO AMEND**

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I. INTRODUCTION

The proposed claim amendments are obvious. They add two concepts:

- (1) taking seed information from sources of data known in the art for use in generating a non-predictable value, and
- (2) using known mathematical operations (i.e., encryption and decryption) employing a PIN for performing the known process of reversibly rendering data stored on a device unintelligible.

As demonstrated below, each of these concepts was already well-known to a PHOSITA—hence, even if amended, the claims would remain obvious over prior art set forth in the Petition, as well as additional prior art introduced below.

In addition, the proposal results in claiming ineligible subject matter under § 101. The proposed claims recite performing abstract ideas related to account-verification using existing computer systems using well-known, generic encryption methods, as the Patent Office has found on substantially similar claims in related prosecution.

Therefore, Petitioner respectfully requests that the Board deny PO's contingent motion to amend.

II. ARGUMENT

A. The Proposed Amendments are Obvious over Prior Art Cited in the Petition

1. Proposed Claims 27-31, 37-44, and 46-52 are Obvious Over the Combination of *Maes* and *Labrou*

The proposed claims are obvious over *Maes* and *Labrou*, a combination set forth in the Petition. PO has introduced one new limitation (largely borrowed from prior dependent claims) into each of the proposed independent claims:

- Proposed Claims 27 and 50 (previously independent Claims 1 and 24) add language that is similar to the seed limitations in original dependent Claim 10;
- Proposed Claim 42 (previously independent Claim 16) adds language similar to the mathematical operation language in original dependent Claim 9.

i. Proposed Claims 27 and 50

Claims 27 and 50 introduce a new limitation (contained in limitations 27[e] and 50[d]) that requires generating a seed using at least two of an electronic serial number, a discrete code associated with the electronic ID device, a PIN, a time value, and the biometric input, wherein the seed is used to generate the non-predictable value. As discussed in the Petition, the combination of *Maes* and *Labrou* renders obvious the original limitations of claims 27 and 50. *See Petition* (Paper 12) at 9-27, 38-40; *see also Decision* (Paper 14) at 12-13. And *Labrou* teaches and renders obvious the additional limitation proposed by PO.

As set forth in the Petition, *Labrou's* “random sequence number (RSN)” satisfies the claimed “non-predictable value” used in generating the encrypted authentication information (“EAI”). Paper 12 at 20-21. Further, *Labrou* teaches generating a seed, *S'* (i.e., the claimed “seed”), which is employed to generate the RSN. Specifically, *Labrou* teaches a pseudorandom number generator function *R* is used in generating the RSN; in a process that uses the function *R* iteratively, both a time value (T_0 or T_0') and an original seed, *S*, can be used to generate a new seed, *S'*, to be used in generating the RSN (i.e., non-predictable value). *Labrou* (EX1005) at [0535]-[0536]; *see also Cole MTA Decl.* (EX1022), at ¶¶18-20. The original seed *S* is at least “a discrete code associated with the user’s device” because each device has its own *S*, which is determined from the UPTD’s device ID (DID):

Each AP device has its own R and S, which are securely stored on the device and at the AVP [Agreement Verification Party]. On the AVP, given the DID of an AP device by which a RSN is generated, a program can deterministically locate the same pseudorandom number generator function *R* and the corresponding pseudorandom number generation seed S for that device from the User and Device Database

Labrou (EX1005) at [0226]¹; *see also id.* at [0517], Figure 43 (Secure Transaction Server storing “Random Seed” “[f]or each Device ID”). Further, the Device ID used

¹ Unless otherwise indicated, all emphasis has been added by Petitioner.

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