

**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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Case IPR2018-00809

U.S. Patent No. 9,530,137

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

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## LIST OF EXHIBITS

<b>Exhibit #</b>	<b>Description</b>
Ex. 2001	Declaration of M. Jakobsson ISO Preliminary Response
Ex. 2002	CV of Markus Jakobsson
Ex. 2003	USR Disclaimer
Ex. 2004	Declaration ISO Motion Pro Hac Vice Harold Barza
Ex. 2005	Declaration ISO Motion Pro Hac Vice Jordan Kaericher
Ex. 2006	U.S. Application No. 15/019,660.
Ex. 2007	U.S. Application No. 11/677,490.
Ex. 2008	U.S. Provisional Application No. 60/775,046.
Ex. 2009	U.S. Provisional Application No. 60/812,279.
Ex. 2010	Declaration Jakobsson ISO Patent Owner's Response
Ex. 2011	Deposition Transcript of Victor Shoup
Ex. 2012	IBM Zurich – The State of the Art in Electronic Payment Systems
Ex. 2013	Vol. 5 No. 4 Baddeley Using E-cash
EX. 2014	Declaration by Dr. Markus Jakobsson Ph.D.
EX. 2015	U.S. Provisional Application No. 60/859,235.

## I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner Universal Secure Registry LLC (“PO”) submits this conditional motion (“Motion”) to substitute proposed claims 13-21 shown in Appendix A for original claims 1-7, 9, and 12 of U.S. Patent No. 9,530,137 (“the ’137 Patent”) should any of claims 1, 2, 5-7, 9, and 12 (“Challenged Claims”) be found unpatentable. PO has conferred with the Board prior to filing this Motion, as required by 37 C.F.R. § 42.121, and the Board authorized the filing of this Motion in an Order *Conduct of Proceeding* entered January 8, 2019. *See* Paper 17.

The proposed substitute claims satisfy the requisite showing for a motion to amend, as 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 its burden of production. *Aqua Products, Inc. v. Joseph Matal et al.*, Case No. 2015-1177 (Fed. Cir. Oct. 4, 2017) (en banc). Accordingly, should the Board find any original Challenged Claim unpatentable in this proceeding, PO respectfully requests that the Board grant this Motion to Amend with respect to each corresponding substitute claim presented herein.

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