# UNITED STATES PATENT AND TRADEMARK OFFICE ————— BEFORE THE PATENT TRIAL AND APPEAL BOARD —————

APPLE INC., VISA INC., and VISA U.S.A. INC.,

Petitioners,

v.

#### UNIVERSAL SECURE REGISTRY LLC,

Patent Owner

Case IPR2018-00809<sup>1</sup>

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

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE PORTIONS OF PAPER 31 AND EXHIBIT 2021



<sup>&</sup>lt;sup>1</sup> Visa Inc. and Visa U.S.A. Inc., which filed a petition in IPR2019-0174, have been joined as a party to this proceeding.

# **TABLE OF CONTENTS**

			<b>Page</b>
I.	INTRODU	CTION	1
II.	PETITIONER'S ARGUMENTS FOR STRIKING PATENT OWNER'S WRITTEN DESCRIPTION SUPPORT ARE MERITLESS		1
	1.	Petitioner Misapprehends Patent Owner's Arguments In Its CMTA	2
	2.	The Allegedly Offending Written Description Support Was Cited in the CMTA for the Preamble Elements of Both Claims.	5
	3.	Patent Owner's Reply and Supporting Declaration Properly Respond to Petitioner's Arguments Made in Opposition	7
III.	CONCLUSION		8



Universal Secure Registry LLC ("Patent Owner") submits this Opposition to Petitioner's Motion to Strike Portions of Patent Owner's Paper 31 and Exhibit 2021, Paper 35 ("MTS").

#### I. INTRODUCTION

The mainstay of Petitioner's arguments—that Patent Owner presents new written description support in its Reply in Support of its Conditional Motion to Amend (Paper 31, "Reply")—is false. Petitioner takes an improperly narrow view of the ample written description support contained in Patent Owner's Conditional Motion to Amend and misapprehends Patent Owner's written description arguments in connection with claims 13 and 21. Because Patent Owner's Reply and accompanying Exhibit 2021 are both fully supported by Patent Owner's Conditional Motion to Amend (Paper 19, "CMTA"), Petitioner's MTS should be denied.

# II. PETITIONER'S ARGUMENTS FOR STRIKING PATENT OWNER'S WRITTEN DESCRIPTION SUPPORT ARE MERITLESS

Petitioner incorrectly argues that Patent Owner has added new written description support for claim limitations 13[c], 13[e], 21[d], and 21[f]. According to Petitioner, Patent Owner cites to "new portions" of the specification in Reply "in an attempt to cure what Petitioner argued in its Opposition was a lack of support." MTS at 2-3. In particular, Petitioner argues that Patent Owner's references to page 23, lines 23-30 of the '660 application in its briefing or in Dr. Jakobsson's supporting



declaration (as well as associated discussion of this citation) should be struck.

Petitioner's arguments are unavailing for several reasons.

## 1. <u>Petitioner Misapprehends Patent Owner's Arguments</u> <u>In Its CMTA</u>

As conceded by Petitioner (MTS at 2-3), Patent Owner's CMTA cited to page 23, line 34 through page 24, line 2 of the '660 application as written description support for the disputed claim limitations. Petitioner fails to mention, however, that Patent Owner explained in connection with that citation that use of the public ID code by a credit card company was only "one non-limiting, non-exclusive example of a 'network validation-information entity' [] to map the ID code to the correct card number." CMTA at 4. Nowhere did Patent Owner argue (or even imply) that the claimed "network validation-information entity" must be a credit card company or even a financial institution.

Patent Owner also cited Figures 7, 21, and 23, and in particular, wireless signal 300 between first device 2110 and a second device. *Id.* at 3-4, 7-11. These figures (as well as the corresponding text within the specification of the '660 application) all support an embodiment where the "network validation-information entity" is a USR that receives the ID code and performs the claimed mapping. For

<sup>&</sup>lt;sup>2</sup> All emphases added unless otherwise noted.



example, Figure 21 of the '660 application generically shows a "responder" and "challenger." Ex. 2006 at Fig. 21. The corresponding text within the specification explains that the "challenger" (the second device) can determine the identity of the user and directly access the secure database 2146 in order to carry out the claimed mapping. *Id.* at 41:16-42:23; *see also id.* at 43:19-44:12 (second device verifying identity of first device). Read in context with the rest of the specification (and in particular the portions thereof cited in Patent Owner's CMTA), the cited "challenger" can clearly constitute the USR that both receives the ID code from the first device (the "responder") and performs the claimed mapping. *See, e.g., id.* at 6:26-7:26, 9:9-29, 10:23-11:6, 23:34-24:2, 38:6-19, 41:7-15, 42:24-44:16; 45:7-46:2, 47:1-13, 48:1-10, 51:8-16, 59:3-9.



# DOCKET

# Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

# **Real-Time Litigation Alerts**



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

# **Advanced Docket Research**



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## **Analytics At Your Fingertips**



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

#### API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

#### **LAW FIRMS**

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

#### **FINANCIAL INSTITUTIONS**

Litigation and bankruptcy checks for companies and debtors.

### **E-DISCOVERY AND LEGAL VENDORS**

Sync your system to PACER to automate legal marketing.

