| UNITED STATES PATENT AND TRADEMARK OFFICE |                |              |
|-------------------------------------------|----------------|--------------|
| BEFORE THE PAT                            | TENT TRIAL AND | APPEAL BOARD |
| -                                         | APPLE INC.,    |              |
|                                           | Petitioner,    |              |
|                                           | v.             |              |

UNIVERSAL SECURE REGISTRY LLC,

Patent Owner

Case IPR2018-00810

U.S. Patent No. 9,100,826

PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO AMEND PURSUANT TO 37 C.F.R. § 42.121



## **TABLE OF CONTENTS**

|      |                                                                                               |                                                                                                                                     | <b>Page</b> |
|------|-----------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------|-------------|
| PAT  | ENT (                                                                                         | OWNER'S LIST OF EXHIBITS                                                                                                            | 1           |
| I.   | INTRODUCTION                                                                                  |                                                                                                                                     | 3           |
| II.  | SUBSTITUTE CLAIMS DIRECTED AT UNCHALLENGED CLAIMS                                             |                                                                                                                                     |             |
| III. | CLA                                                                                           | AIM 56 HAS WRITTEN DESCRIPTION SUPPORT                                                                                              | 3           |
| IV.  | SUE                                                                                           | SSTITUTE CLAIMS ARE NOVEL AND NONOBVIOUS                                                                                            | 6           |
|      | A.                                                                                            | Petitioner Fails to Address "the digital signature generated using a private key associated with the first handheld device" (36[f]) | 6           |
|      | В.                                                                                            | Petitioner Fails to Address Several Limitations of Claim 45                                                                         | 8           |
|      | C.                                                                                            | A POSITA Would Not Combine Jakobsson, Maritzen, and Schutzer By Prepending First Authentication Information                         | 10          |
|      | D.                                                                                            | Prior Art Fails to Disclose Limitations 56[c] and 56[e]                                                                             | 14          |
| V.   | SUBSTITUTE CLAIMS ARE PATENT ELIGIBLE UNDER § 101                                             |                                                                                                                                     | 20          |
| VI.  | PETITIONER'S ALLEGATIONS CONCERNING PATENT OWNER'S BREACH OF ITS DUTY OF CANDOR ARE MERITLESS |                                                                                                                                     | 24          |
| VII. |                                                                                               | NCLUSION                                                                                                                            |             |



# **TABLE OF AUTHORITIES**

|                                                                          | <b>Page</b> |
|--------------------------------------------------------------------------|-------------|
| <u>Cases</u>                                                             |             |
| Alice,                                                                   |             |
| 134 S. Ct. at 2355                                                       | 21, 23      |
| Aqua Prods., Inc. v. Matal,                                              |             |
| 872 F.3d 1290 (Fed. Cir. 2017)                                           | 7           |
| Ariosa Diagnostics v. Verinata Health, Inc.,                             |             |
| 805 F.3d 1359 (Fed. Cir. 2015)                                           | 7, 8, 10    |
| Daikin Industries, Ltd. v. The Chemours Company FC, LLC,                 |             |
| IPR2018-00993, Paper 12                                                  | 25          |
| KSR Int'l. Co. v. Teleflex, Inc.,                                        |             |
| 550 U.S. 398 (2007)                                                      | 10, 23      |
| Lectrosonics, Inc. v. Zaxcom, Inc.,                                      |             |
| IPR2018-01129, -01130, Paper 15 (Feb. 25, 2019)                          | 24          |
| Ex parte Levy,                                                           |             |
| 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990)                             | 6           |
| In re Oda,                                                               |             |
| 443 F.2d 1200, 170 USPQ 268 (CCPA 1971)                                  | 3           |
| Polaris Industries, Inc. v. Arctic Cat, Inc.,                            |             |
| 882 F.3d 1056 (Fed. Cir. 2018)                                           | 10, 11      |
| Universal Secure Registry, LLC v. Apple, Inc.,                           |             |
| 1:17-cv-00585-JFB-SRF, Dkt. 137 (D. Del. Sep. 18, 2018)                  | 20, 21      |
| Statutory Authorities                                                    |             |
| 35 U.S.C. § 112                                                          | 3           |
| Rules and Regulations                                                    |             |
| 37 C.F.R. § 42.6(e)                                                      | 27          |
| 37 C.F.R. § 42.121                                                       |             |
| Ü                                                                        |             |
| Other Authorities Office Patent Trial Practice Guide August 2018 Update, |             |
| 02 F. 1 D 2000                                                           | 7           |



# PATENT OWNER'S LIST OF EXHIBITS

| Declaration ISO Motion Pro Hac Vice Harold Barza.                                                                                                                    |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Declaration ISO Motion Pro Hac Vice Jordan Kaericher.                                                                                                                |
| Declaration of Dr. Markus Jakobsson ISO                                                                                                                              |
| Patent Owner's Response.                                                                                                                                             |
| Curriculum Vitae of Dr. Markus Jakobsson.                                                                                                                            |
| Transcript of December 14, 2018 Deposition of Dr. Victor John Shoup.                                                                                                 |
| N. Asokan, et. al, The State of the Art in Electronic Payment Systems, IEEE Computer, Vol. 30, No. 9, pp. 28-35 (IEEE Computer Society Press, Sept. 1997).           |
| M. Baddeley, Using E-Cash in the New Economy: An Economic Analysis of Micropayment Systems, J. Electronic Commerce Research, Vol. 5, No. 4, pp. 239-253 (Nov. 2004). |
| U.S. Application No. 14/027,860.                                                                                                                                     |
| U.S. Application No. 11/677,490.                                                                                                                                     |
| U.S. Provisional Application No. 60/775,046.                                                                                                                         |
| U.S. Provisional Application No. 60/812,279.                                                                                                                         |
| U.S. Provisional Application No. 60/859,235.                                                                                                                         |
| Declaration by Dr. Markus Jakobsson ISO Motion to Amend.                                                                                                             |
| U.S. District Court for Delaware Report and Recommendation.                                                                                                          |
|                                                                                                                                                                      |



|          | Declaration by Dr. Markus Jakobsson ISO Reply to MTA Opposition. |
|----------|------------------------------------------------------------------|
| Ex. 2016 | Rough transcript of deposition of Dr. Ari Juels.                 |



# DOCKET A L A R M

# 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.

