UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

UNIVERSAL SECURE REGISTRY LLC,

Patent Owner.

Case IPR2018-00812

U.S. Patent No. 8,856,539

PETITIONER'S REPLY TO PATENT OWNER RESPONSE

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I.   Introduction

Universal Secure Registry LLC's ("USR") Patent Owner's Response

("POR") fails to rebut the obviousness showing set forth regarding U.S. Patent No.

8,856,539 ("'539 patent") in Apple's Petition because, where it does not simply

repeat arguments that the Board already rejected, it relies on unsupported claim

constructions or overly-narrow reads of the claims and the prior art. Because

USR's arguments are inconsistent with the factual record, the testimony of both

parties' experts, and the law, they should be rejected.

II.   Argument

A.   USR Fails To Overcome Petitioner's Showing That The Challenged Claims Are Obvious.

1.   The Petition Shows That Reber And Franklin Both Disclose The "Wherein The Account Identifying Information Is Not Provided To The Provider…." Limitation

As the Petition demonstrated, Reber and Franklin disclose the "the account

identifying information is not provided to the provider" limitations of claims 1, 22,

37, and 38. *See* Pet., 39-42, 60, 69, 71. In response USR merely reiterates its

Patent Owner Preliminary Response's ("POPR") argument – already rejected by

the Board (DI, 8-10, 17-18) – that the Petition fails to adequately map the

limitation. POR, 27-35. Reber and Franklin disclose this limitation because both

references teach that account identifying information (such as names, addresses,

and account numbers) should not be provided to the provider when such information is deemed sensitive. Pet., 19-23, 39-42. Ex-1135, Shoup-Decl., ¶18.

> a) *USR's Argument Fails to Apply the Broadest Reasonable Interpretation of "Account Identifying Information."*

USR's argument relies on the faulty premise that the challenged claims of the '539 patent exclude any system where a user's name or address is provided to a merchant. POR, 28. But that interpretation improperly narrows the claims and is inconsistent with the specification. **First,** claim 4 of the '539 patent explicitly *requires* the secure registry to transmit address information to the provider. Ex-1101, '539 patent, cl. 4. Thus, at least independent claim 1 must be construed broadly enough to encompass transmission of address information to the provider.[1] Shoup-Decl., ¶19.

Second, USR's position is inconsistent with the '539 specification because the secure registry, in at least some embodiments, must send personal information, such as a user's name or address. For instance, in some embodiments, name and address information is made available publicly or provided along with the

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[1] USR's expert has offered no opinion to the contrary. Ex-1137, Jakobsson-Dep., 343:8-17 ("Q. So you do not have an opinion one way or the other whether the '539 patent claims are or are not limited to anonymous systems, correct? A. So as I said, this is not something I believe that I have opined on.").

transaction. *Id.*, 17:34-38 ("[Users] can also indicate whether they wish their name given out in response to such an inquiry…."), 13:66-14:1 ("Having the USR system 10 provide the address … to the on-line merchant enables the user to purchase items…."), 12:57-62 ("In the embodiment of Fig. 9, the user initiates a purchase and writes a check to the merchant (900). The check may be a conventional check containing identifying information…."). The specification also states that the claimed invention can be used "to identify the person in many situations, and … take the place of multiple conventional forms of identification" and to "selectively provide personal … information about a person to authorized users." *Id.*, 3:5-9, 3:21-24. In other embodiments, personal information is withheld. The '539 patent explains that this is sometimes necessary to prevent fraud. Ex-1101, '539 patent, 3:47-54 ("… Enabling anonymous identification *may* be particularly advantageous in an unsecured environment, such as the Internet, where it has been found to be relatively trivial to intercept such credit card information.")[2]. As such, the '539 specification is clear that the types of "account identifying information" that are withheld from the provider can vary. Ex-2111, Shoup-Dep., 74:16-78:12; Shoup-Decl., ¶20.

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[2] Emphasis added unless otherwise specified.

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