

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

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

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35 U.S.C. § 11223

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37 C.F.R. § 1.3212

37 C.F.R. § 42.244

37 C.F.R. § 42.513

37 C.F.R. § 42.64, 13

OTHER AUTHORITIES

Office PTG Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012)3

PATENT OWNER'S LIST OF EXHIBITS

Ex. 2101	Declaration by Dr. Markus Jakobsson in Support of Patent Owner's Preliminary Response
Ex. 2102	Curriculum Vitae of Dr. Markus Jakobsson
Ex. 2103	Declaration ISO of Unopposed Motion for Admission Pro Hac Vice of Jordan B. Kaericher.
Ex. 2104	Declaration ISO of Unopposed Motion for Admission Pro Hac Vice of Harold A. Barza
Ex. 2105	U.S. Application No. 11/768,729
Ex. 2106	U.S. Application No. 09/710,703
Ex. 2107	Declaration by Dr. Markus Jakobsson in Support of Motion to Amend
Ex. 2108	Declaration of Dr. Markus Jakobsson in Support of Patent Owner's Response
Ex. 2109	Rough Deposition Transcript of Dr. Victor John Shoup
Ex. 2110	Disclaimer of Claims 5-8, 17-20, 26-30
Ex. 2111	Final Deposition Transcript of Dr. Victor John Shoup
Ex. 2112	U.S. District Court for Delaware Report and Recommendation.
Ex. 2113	Declaration by Dr. Markus Jakobsson in Support of Patent Owner's Reply to MTA Opposition

Universal Secure Registry LLC (“Patent Owner”) submits this Reply in support of its Conditional Motion to Amend, Paper 21 (“MTA”), and in response to Petitioner’s Opposition to the MTA, Paper 29 (“Op.”).

I. INTRODUCTION

Petitioner’s Opposition to the MTA is without merit: it improperly attacks the propriety of Patent Owner’s presentation of the substitute claims, including purported violations of duty of candor and the applicability of estoppel; and it also improperly incorporates substantive arguments from its Petition and Reply in an obvious attempt to circumvent this Board’s order on page limits. *See* Paper No. 17.

II. PETITIONER’S ARGUMENTS FOR DENIAL OF MTA BASED ON DUTY OF CANDOR VIOLATIONS AND ESTOPPEL LACK MERIT

Petitioner argues that (1) the MTA should be denied because Patent Owner allegedly violated its duty of candor with the Board, and (2) Patent Owner should be estopped from amending its claims to include what Petitioner believes is previously disclaimed subject matter. *See* Op. at 2-4. Petitioner’s contentions are factually and legally meritless.

First, substitute claim 47 does *not* include amendments that were “previously disclaimed in the -023 CBM proceeding.” *Id.* at 2. Substitute claim 47 unequivocally requires that the claimed “account identifying information” include a “*public ID code* that identifies a financial account number.” Paper 21 (MTA) at A3-A4. A third

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