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Paper 9
Entered: November 7, 2018

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
Patent 8,856,539 B2

Before PATRICK R. SCANLON, GEORGIANNA W. BRADEN, and JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner, Apple Inc., filed a Petition (Paper 3, "Pet.") requesting *inter partes* review of claims 1–3, 5–8, 16–24, 26–30, 37, and 38 ("the challenged claims") of U.S. Patent No. 8,856,539 B2 (Ex. 1101, "the '539 patent"). Patent Owner, Universal Secure Registry, LLC, timely filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review.

An *inter partes* review may not be instituted unless "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). For the reasons set forth below, we conclude that Petitioner has shown a reasonable likelihood it will prevail in establishing the unpatentability of at least one challenged claim. We, therefore, institute *inter partes* review of the challenged claims of the '539 patent in this proceeding.

A. RELATED MATTERS

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 3–4; Paper 7, 2 (Patent Owner's Updated Mandatory Notices).

B. THE '539 PATENT

The '539 patent is titled "Universal Secure Registry" and describes "a universal identification system . . . used to selectively provide personal, financial or other information about a person to authorized users." Ex. 1101,

[54], 3:5–9. The ’539 patent discloses that secure registry system may include “[a] multicharacter public code . . . which the system can map to provide permit delivery of items, complete telephone calls and perform other functions for entities. The system may also be utilized to locate an individual based on limited biological data.” *Id.* at [57].

The challenged patent describes a secure database called a “Universal Secure Registry,” which can be used as “a universal identification system” and/or “to selectively provide . . . information about a person to authorized users.” *Id.* at 3:5–9. The ’539 patent states that the USR database is designed to “take the place of multiple conventional forms of identification.” *Id.* at 3:22–24. According to ’539 patent, “the USR system may enable the user's identity to be confirmed or verified without providing any identifying information about the person to the entity requiring identification.” *Id.* at 3:25–27.

C. CHALLENGED CLAIMS

Challenged claims 1, 22, 37, and 38 are independent. Claim 1 is illustrative of the claimed subject matter and is reproduced below:

> 1. A secure registry system for providing information to a provider to enable transactions between the provider and entities with secure data stored in the secure registry system, the secure registry system comprising:
>
> [a] a database including secure data for each entity, wherein each entity is associated with a time-varying multicharacter code for each entity having secure data in the secure registry system, respectively, each time-varying multicharacter code representing an identity of one of the respective entities; and
>
> a processor configured

[b] to receive a transaction request including at least the time-varying multicharacter code for the entity on whose behalf a transaction is to be performed and an indication of the provider requesting the transaction,

[c] to map the time-varying multicharacter code to the identity of the entity using the time-varying multicharacter code,

[d] to execute a restriction mechanism to determine compliance with any access restrictions for the provider to secure data of the entity for completing the transaction based at least in part on the indication of the provider and the time-varying multicharacter code of the transaction request, and to allow or not allow access to the secure data associated with the entity including information required to enable the transaction based on the determined compliance with any access restrictions for the provider, the information including account identifying information,

[e] wherein the account identifying information is not provided to the provider and the account identifying information is provided to a third party to enable or deny the transaction with the provider without providing the account identifying information to the provider.

Ex. 1101, 18:29–60.[1]

[1] We add formatting and square-bracketed annotations to separate claim limitations as identified by the parties. Our formatting and annotations imply no functional or structural aspect of the claim beyond identifying limitations for discussion.

D. Proposed Ground of Unpatentability

Petitioner asserts claims 1–3, 5–8, 16–24, 26–30, 37, and 38 are unpatentable as obvious under 35 U.S.C. § 103(a) in view of Reber[2] and Franklin[3]. Pet. 24, 63. Petitioner also relies on the Declaration of Dr. Victor Shoup (Ex. 1102). Pet. 6.

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, the Board interprets claims of an unexpired patent using the broadest-reasonable construction in light of the specification of the patent. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under that standard, we generally give a claim term its "ordinary and customary meaning," which is "the meaning that the term would have to a person of ordinary skill in the art in question" at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). The specification may impose a specialized meaning, departing from the ordinary and customary meaning, by defining a term with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Furthermore, a party may prove "the existence of a 'clear and unmistakable' disclaimer" that narrowed a term's definition in the prosecution history of a challenged patent. *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063–64 (Fed. Cir. 2016) (quoting *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1371 (Fed. Cir. 2007)).

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[2] U.S. Patent No. 5,930,767 (filed May 28, 1997; issued July 27, 1999) (Ex. 1131).
[3] U.S. Patent No. 6,000,832 (filed Sept. 24, 1997; issued Dec. 14, 1999) (Ex. 1132).

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