

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNIVERSAL SECURE REGISTRY, LLC,
Patent Owner.

Case IPR2018-00813¹
Patent 9,100,826 B2

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

SCANLON, *Administrative Patent Judge*.

TERMINATION
Dismissal on Remand
35 U.S.C. § 144; 37 C.F.R. § 42.72

¹ Visa Inc. and Visa U.S.A. Inc., which filed a petition in IPR2019-00176, have been joined as parties to this proceeding.

I. BACKGROUND

Apple Inc. filed a Petition (Paper 3) requesting an *inter partes* review of claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34 of U.S. Patent No. 9,100,826 B2 (Ex. 1101, “the ’826 patent”). After institution of trial, Visa Inc. and Visa U.S.A. Inc. filed a petition and a Motion for Joinder to this proceeding. Case IPR2019-00176, Papers 2, 3. We granted the Motion for Joinder, and IPR2019-00176 was joined with this proceeding and dismissed. Paper 33, 5–6. Consequently, Apple Inc., Visa Inc., and Visa U.S.A. Inc. (collectively, “Petitioner”) are joined in this proceeding.

The parties filed various papers after institution of trial. Of note here, Universal Secure Registry, LLC (“Patent Owner”) Patent Owner filed a Conditional Motion to Amend (Paper 19, “Mot. Amend”). In its Conditional Motion to Amend, Patent Owner requested that we substitute claims 1–20 and 30–35 of the ’826 patent with proposed claims 36–61 “should any of claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34 be found unpatentable.” Mot. Amend 1.

On October 8, 2019, the Board issued a Final Written Decision in this proceeding. Paper 46; *see also* Paper 47 (errata). In the Final Written Decision, we determined that claims 1, 2, 10, 11, 15, 21, 22, 24, 27, 30, and 31 of the ’826 patent had been shown to be unpatentable, but that claims 7, 8, 14, 26, and 34 had not been shown to be unpatentable. Paper 47, 2. Regarding the Conditional Motion to Amend, we granted the Motion with respect to substitute claim 50, denied the Motion with respect to substitute claims 36, 37, 45, 46, 56, and 57, and did not consider substitute claims 42, 43, 49, and 60. Paper 46, 2.

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On appeal, the U.S. Court of Appeals for the Federal Circuit determined that, because claims 1–35 of the '826 patent were deemed ineligible under 35 U.S.C. § 101 in *Universal Secure Registry LLC v. Apple Inc.*, 10 F.4th 1342 (Fed. Cir. 2021), the appeal of the overlapping claims in this proceeding was rendered moot. *Apple Inc. v. Universal Secure Registry, LLC*, 857 F. App'x 658 (Fed. Cir. 2021) (citing *Apple Inc. v. Voip-Pal.com, Inc.*, 976 F.3d 1316, 1321 (Fed. Cir. 2020)). Thus, the Court vacated our Final Written Decision and instructed us to dismiss Apple's petition as to the overlapping claims. *Id.*

The Court further concluded that substitute claim 50 also is ineligible under 35 U.S.C. § 101 and reversed our determination as to substitute claim 50. *Id.*

II. ANALYSIS

As directed by the Federal Circuit, we dismiss the Petition in IPR2018-00813. 37 C.F.R. § 42.72.

III. ORDER

It is hereby:

ORDERED that the Petition in IPR2018-00813 is dismissed.

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