

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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UNIFIED PATENTS INC.

*Petitioner,*

v.

UNIVERSAL SECURE REGISTRY LLC

*Patent Owner*

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Case IPR2018-00813

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

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**PATENT OWNER'S CONDITIONAL MOTION TO AMEND  
UNDER 37 C.F.R. § 42.121**

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**LIST OF EXHIBITS**

<b>Exhibit #</b>	<b>Description</b>
Ex. 2001	Declaration ISO Motion Pro Hac Vice for Harold Barza
Ex. 2002	Declaration ISO Motion Pro Hac Vice for Harold Barza
Ex. 2101	Declaration of Markus Jakobsson in Support of Patent Owner's Response
Ex. 2102	Curriculum Vitae of Markus Jakobsson
Ex. 2103	Transcript of December 14, 2018 Deposition of Dr. Victor John Shoup
Ex. 2104	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)
Ex. 2105	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)
Ex. 2106	U.S. Application No. 14/027,860.
Ex. 2107	U.S. Application No. 11/677,490.
Ex. 2108	U.S. Provisional Application No. 60/775,046.
Ex. 2109	U.S. Provisional Application No. 60/812,279.
EX. 2110	U.S. Provisional Application No. 60/859,235.
EX. 2111	Declaration by Dr. Markus Jakobsson Ph.D.

## I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner Universal Secure Registry LLC (“PO”) submits this conditional motion (“Motion”) to substitute proposed claims 36-61 shown in Appendix A for original claims 1-20 and 30-35 of U.S. Patent No. 9,100,826 (“the ’826 Patent”) should any of claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34 (“Challenged Claims”) be found unpatentable. PO has conferred with the Board prior to filing this Motion, as required by 37 C.F.R. § 42.121, and the Board authorized the filing of this Motion in an Order *Conduct of Proceeding* entered January 8, 2019. *See* Paper 17.

The proposed substitute claims satisfy the requisite showing for a motion to amend, as they (1) “do not impermissibly enlarge the scope of the claims;” (2) present a “reasonable number of substitute claims;” (3) “do not introduce new subject matter;” and (4) “respond to a ground of unpatentability in the trial.” *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. Patent Owner has thus met its burden of production. *Aqua Products, Inc. v. Joseph Matal et al.*, Case No. 2015-1177 (Fed. Cir. Oct. 4, 2017) (en banc). Accordingly, should the Board find any original Challenged Claim unpatentable in this proceeding, PO respectfully requests that the Board grant this Motion to Amend with respect to each corresponding substitute claim presented herein.

## II. THE SUBSTITUTE CLAIMS ARE OF NARROWER SCOPE

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