

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNIVERSAL SECURE REGISTRY, LLC,  
Patent Owner.

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IPR2018-01350<sup>1</sup>  
Patent 8,856,539 B2

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

MELVIN, *Administrative Patent Judge*.

JUDGMENT  
Final Written Decision  
Determining No Challenged Claims Unpatentable  
*35 U.S.C. § 318(a)*

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<sup>1</sup> Apple Inc., which filed a petition in IPR2019-00727, has been joined as a party to this proceeding.

## I. INTRODUCTION

### A. BACKGROUND AND SUMMARY

Petitioner, Visa Inc. and Visa U.S.A. Inc., filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–9, 16–31, 37, and 38 of U.S. Patent No. 8,856,539 B2 (Ex. 1001, “the ’539 patent”). Patent Owner, Universal Secure Registry, LLC, filed a disclaimer of claims 5–8, 17–20, and 26–30. Ex. 2003. Thus, claims 1–4, 9, 16, 21–25, 31, 37, and 38 (“the challenged claims”) remain challenged in this proceeding.<sup>2</sup> Patent Owner timely filed a Preliminary Response. Paper 6. We instituted review. Paper 7 (“Inst.” or “Institution Decision”).

Patent Owner filed a Response (Paper 12 (“PO Resp.”)) and a Conditional Motion to Amend (Paper 13); Petitioner filed a Reply (Paper 16 (“Pet. Reply”)) and an Opposition to Patent Owner’s Conditional Motion to Amend (Paper 17); Patent Owner filed a Sur-Reply (Paper 21 (“PO Sur-Reply”)) and a Reply to Petitioner’s Opposition (Paper 20); and Petitioner filed a Sur-Reply to the Conditional Motion to Amend (Paper 24). We held a hearing on November 21, 2019, and a transcript is included in the record. Paper 34 (“Tr.”).

This is a final written decision as to the patentability of the challenged claims. For the reasons discussed below, we determine that Petitioner has not shown by a preponderance of the evidence that any of the challenged claims is unpatentable.

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<sup>2</sup> 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.”); *Vectra Fitness, Inc. v. TWNK Corp.*, 162 F.3d 1379, 1383–84 (Fed. Cir. 1998) (holding a disclaimer under § 253 removes a claim from the original patent for all purposes).

## B. 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. 12–13; Paper 4 (Patent Owner’s Mandatory Notices).

## C. 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, code (54), 3:5–9. The ’539 patent discloses that the 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 code (57).

The challenged patent describes a secure database called a “Universal Secure Registry” (“USR”), 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 the ’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. In one regard, the USR may restrict access to information based on the identity of the party requesting the information. *Id.* at 10:40–57.

The '539 patent describes an embodiment in which a user may use an electronic ID device to generate a code that a merchant passes on to the USR along with purchase information. *Id.* at 12:19–54. If the USR correctly validates the code, it may in turn pass transaction information to a credit-card company to facilitate the transaction. *Id.* at 12:27–46.

#### D. ILLUSTRATIVE 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:
  - [1.1] 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
    - [1.2] 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,
    - [1.3] to map the time-varying multicharacter code to the identity of the entity using the time-varying multicharacter code,
    - [1.4] 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

[1.5] 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,

[1.6] 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. 1001, 18:29–60.<sup>3</sup>

#### E. PRIOR ART AND ASSERTED GROUND

Petitioner asserts that all challenged claims are unpatentable under 35 U.S.C. § 103 as obvious over a combination of Brener,<sup>4</sup> Weiss,<sup>5</sup> and Desai.<sup>6</sup> Pet. 13–14. Petitioner also relies on the Declaration of Dr. Douglas Tygar (Ex. 1002). *See* Pet. 7.

## II. ANALYSIS

### A. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner submits that a person of skill in the art at the time of invention for the '539 patent would possess

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<sup>3</sup> We add formatting and square-bracketed annotations to separate claim limitations as identified by the parties. *See* Pet. 26–39. Our formatting and annotations imply no functional or structural aspect of the claim beyond identifying limitations for discussion.

<sup>4</sup> PCT Pub. App. WO 00/14648 (pub. Mar. 16, 2000) (Ex. 1005).

<sup>5</sup> U.S. Pat. No. 4,885,778 (iss. Dec. 5, 1989) (Ex. 1006).

<sup>6</sup> U.S. Pat. No. 6,820,204 B1 (iss. Nov. 16, 2004) (Ex. 1007).

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