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Paper No. 7
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNIVERSAL SECURE REGISTRY, LLC,
Patent Owner.

Case IPR2018-01350
Patent 8,856,539 B2

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

MELVIN, *Administrative Patent Judge*.

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

I. INTRODUCTION

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.[1] Patent Owner timely filed a Preliminary Response. Paper 6 ("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

[1] 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).

decision in this proceeding. Pet. 12–13; Paper 4 (Patent Owner's 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. 1001, [54], 3:5–9. The '539 patent explains that the disclosed 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 '539 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 '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:

[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.[2]

D. Proposed Ground of Unpatentability

Petitioner asserts that all challenged claims are unpatentable under 35 U.S.C. § 103 as obvious over a combination of Brener,[3] Weiss,[4] and Desai.[5] Pet. 13–14. Petitioner also relies on the Declaration of Dr. Douglas Tygar (Ex. 1002). *See* Pet. 7.

II. DISCUSSION

A. 35 U.S.C. § 325(d)

Patent Owner argues that we should deny institution because a patent claiming priority to Weiss was applied by the examiner in prosecution of the '539 patent, as a secondary reference teaching a "time-varying" code. Prelim. Resp. 48–49. When determining whether to institute review, we "may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." *See* 35 U.S.C. § 325(d). Even accepting Patent Owner's argument that the Office relied on a patent related to Weiss (U.S. Pat. No. 5,657,388 to Weiss ("Weiss '388")) for the same reason Petitioner relies on Weiss here, we conclude Petitioner does not present substantially the same prior art or arguments as at issue during prosecution. In particular, Petitioner relies on a different primary reference—where the examiner

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[2] 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.
[3] PCT Pub. App. WO 00/14648 (pub. Mar. 16, 2000) (Ex. 1005).
[4] U.S. Pat. No. 4,885,778 (iss. Dec. 5, 1989) (Ex. 1006).
[5] U.S. Pat. No. 6,820,204 B1 (iss. Nov. 16, 2004) (Ex. 1007).

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