

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
U.S. Patent No. 8,856,539

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

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LIST OF EXHIBITS

Exhibit #	Description
Ex. 2001	Declaration by Dr. Markus Jakobsson in Support of Patent Owner's Preliminary Response.
Ex. 2002	Curriculum Vitae of Markus Jakobsson.
Ex. 2003	Terminal Disclaimer of U.S. Patent 8,856,539
Ex. 2004	Declaration of Dr. Markus Jakobsson in Support of Patent Owner's Response.
Ex. 2005	Transcript of Dr. J. Douglas Tygar Deposition on April 19, 2019.
Ex. 2006	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. 2007	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. 2008	U.S. Application No. 11/768,729.
Ex. 2009	U.S. Application No. 09/710,703.
Ex. 2010	Declaration by Dr. Markus Jakobsson in Support of Motion to Amend.

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 39-52 shown in Appendix A for original (*i.e.*, original) claims 1-4, 9, 16, 21-25, 31, 37, and 38 of U.S. Patent No. 8,856,539 (“the ’539 Patent”) should any of claims 1-4, 9, 16, 21-25, 31, 37, and 38 (“Challenged Claims”) be found unpatentable. That is, PO requests that for each original claim the Board deems invalid, the Board review and enter the corresponding substitute claim on a claim-by-claim basis. 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 email correspondence dated April 11, 2019.

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

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