Filed on behalf of: Visa Inc. and Visa USA Inc.
By: Matthew A. Argenti
      Michael T. Rosato
      WILSON SONSINI GOODRICH & ROSATI
      650 Page Mill Road
      Palo Alto, CA 94304-1050

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.,
Petitioners,

v.

UNIVERSAL SECURE REGISTRY LLC,
Patent Owner.
_____

Case No. IPR2018-01350
Patent No. 8,856,539

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**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 8,856,539**

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I. INTRODUCTION

Visa Inc. and Visa U.S.A. Inc., (together, "Petitioner") hereby request review of U.S. Patent No. 8,856,539 to Weiss et al. (hereinafter "the '539 patent," Ex-1001) that issued on October 7, 2014, and is currently assigned to Universal Secure Registry LLC ("Patent Owner"). This Petition demonstrates that there is a reasonable likelihood that claims 1-9, 16-31, 37, and 38 of the '539 patent are unpatentable over the cited prior art. Thus, claims 1-9, 16-31, 37, and 38 of the '539 patent should be found unpatentable and canceled.

The '539 patent purports to be broadly directed to a "secure registry system" involving selective access to information stored in a database, and a multicharacter code corresponding to a user with information stored in the database. Ex-1001 at Abstract. Embodiments of the invention disclosed by the patent involve anonymous online transactions, such as online purchases where a customer's credit card number is disclosed to an authorizing financial institution but not the online merchant, or where the customer's address is revealed to a shipper but not the merchant. Ex-1002, ¶16. As might be expected, the field of e-commerce was rife with disclosure of such systems prior to the March 2001 priority date. *Id.*, ¶17. The '539 patent's requirement of a time-varying multicharacter code representing an identity of a user such as a customer does not convey a point of novelty. *Id.* The use of such time-varying multicharacter codes to identify or authenticate a

user was well-known, as demonstrated by the named inventor's own prior art patent disclosures predating the '539 patent by well over a decade as well as other prior art disclosing the use of such codes in an anonymous transaction context. *Id.*

A. Brief Overview of the '539 Patent

The '539 patent is entitled "Universal Secure Registry." Ex-1001. In a general sense, the '539 patent is directed to systems and methods for providing controlled access to secure data stored on a database using a time-varying multicharacter code. *See, e.g.*, Ex-1001, Abstract, claim 1; Ex-1002, ¶¶14-24. The secure registry system is "used to selectively provide personal, financial or other information about a person to authorized users." Ex-1001, 3:5-9.

As the Background section of the '539 patent states, "there are times when the individual may wish to be identified or at least verified without providing personal information." *Id.,* 2:17-19. Identification and authentication may occur, for example, when "a person may wish to purchase goods and/or services without publicly providing his/her credit card information for fear that the credit card information may be stolen and used fraudulently." *Id.,* 2:19-22; *see also id.,* 22-27 ("Likewise, the person may wish to purchase goods or order goods to be delivered to an address without revealing the address to the vendor."); Ex-1002, ¶18.

Patent Owner has characterized the '539 patent as directed to "an anonymous identification system that allows user verification without requiring the

user to share personal information with whomever is requesting verification, e.g., allows a person to purchase goods without publicly providing credit card information to the merchant, for fear that the credit card information may be stolen or used fraudulently." Ex-1014, 17; *see also id.*, 19 (describing "claim 22's innovation that allows transaction approval ***without providing account identifying information to the merchant***.") (emphasis original). Consistent with this description, the specification discloses "a system for

FIG. 8

facilitating purchases without providing financial information to the merchant as set forth in FIG.8." Ex-1001 at 12:19-54. As seen here in Figure 8, a user (customer) initiates a purchase and provides a code to a merchant, without providing identifying information or a credit card number. *Id.,* 12:21-24. The merchant then sends the purchase request to the universal secure registry system (USR), which uses the secret code to determine the identity of the customer and
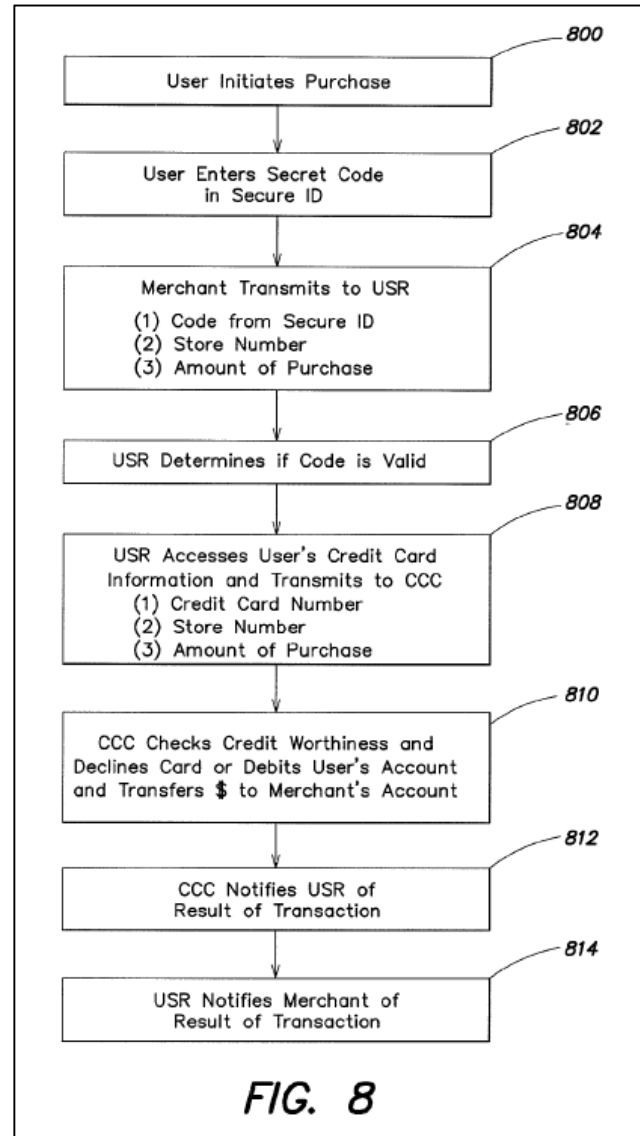
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