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Filed on behalf of: Visa Inc. and Visa USA Inc.
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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.,
Petitioners,

v.

UNIVERSAL SECURE REGISTRY LLC,
Patent Owner.

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

PETITIONERS' OPPOSITION TO PATENT OWNER'S CONDITIONAL MOTION TO AMEND

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Visa Inc. and Visa U.S.A. Inc., (together, "Petitioner") hereby oppose Patent Owner Universal Secure Registry LLC's ("PO") Conditional Motion to Amend ("CMTA," Paper 13). PO fails to meet its burden to show that it proposes a reasonable number of substitute claims and that the proposed amendments are supported by the specification, and fails to satisfy its duty of candor in seeking to recapture disclaimed subject matter. Moreover, PO's amendments do not avoid unpatentability. The substitute claims are obvious, directed to ineligible subject matter, and indefinite.

I. PO SEEKS TO DOUBLE THE NUMBER OF SUBSTITUTE CLAIMS AND PRESENTS IRRECONCILABLE CONFLICT WITH A PARALLEL IPR PROCEEDING

PO's CMTA proposes an unreasonable number of substitute claims in light of PO's pending Conditional Motion to Amend in IPR2018-00812, initiated by Apple Inc. ("Apple CMTA," Paper 21), in which PO requests substitutes for original claims 1-3, 16, 21-24, and 38. PO must limit amendments to "a reasonable number of substitute claims." 35 U.S.C. §316(d); 37 C.F.R. § 42.121(a)(3). Yet PO's present CMTA requests substitutes for original claims 1-4, 9, 16, 21-25, 31, 37, and 38, resulting in at least two substitute claims for original claims 1-3, 16, 21-24, and 38. Petitioner is prejudiced by PO's attempt to circumvent this proceeding by requesting amendment of challenged claims in another proceeding in which Petitioner is unable to respond.

PO's CMTA entirely disregards its proposed amendments in the Apple CMTA, failing to explain how the Board can resolve this motion in PO's favor without creating an irreconcilable conflict with the parallel proceeding. If the Board ***grants*** PO's Apple CMTA prior to a decision on PO's present CMTA, then PO's present CMTA must be denied as moot, and Visa will have had no opportunity to be heard. However, if the Board ***denies*** PO's Apple CMTA, PO will be precluded from obtaining "a claim that is not patentably distinct." 37 C.F.R. § 42.73(d)(3)(i). PO's motion makes no effort to explain whether the requested amendments are patentably distinct from those sought in the Apple CMTA.

II. PO IMPROPERLY REINTRODUCES DISCLAIMED SUBJECT MATTER TO AMEND SUBSTITUTE CLAIM 52

"[W]here a party assumes a certain position in a legal proceeding, … he may not thereafter, simply because his interests have changed, assume a contrary position." *New Hampshire v. Maine*, 532 U.S. 742, 749 (2001) (citation omitted). In CBM2018-00023, PO avoided institution by disclaiming claims 5-8, 17-20, and 26-30 of the '539 patent. *Apple Inc. v. USR, LLC*, CBM2018-00023, Paper 10, (Sept. 13, 2018). Yet now PO improperly seeks to reintroduce subject matter plainly directed to covered business methods it disclaimed in CBM2018-00023. PO's substitute limitations 52[f] and 52[g] recite "a public ID code that identifies ***a financial account number***" and that can be used "to obtain the ***financial account number*** associated with the entity." PO also disclaimed a nearly identical "public

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