

Paper No. _____
Filed: August 12, 2019

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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' REPLY TO PATENT OWNER RESPONSE

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Visa Inc. and Visa U.S.A. Inc., (together, “Petitioner”) request a final written decision finding claims 1-4, 9, 16, 21-25, 31, 37, and 38 of U.S. Patent No. 8,856,539 to Weiss et al. (“the ’539 patent,” Ex-1001) unpatentable as set forth in the petition (“Pet.,” Paper 2).¹ Petitioners’ rebuttal remarks to the Patent Owner (“PO”) Response (“Resp.,” Paper 12) are provided herein.

PO fails to show how any claim limitation is missing from the proposed combination of references. The only element PO alleges the prior art lacks (limitation 1.6) is taught by Brener in multiple ways. Moreover, PO’s attempts to rebut Petitioner’s rationale to combine the references repeatedly mischaracterize the proposed combination. In arguing that the combination would not be technically feasible, PO refashions a ground of its own design so it has a straw man to knock down, while completely disregarding the challenge actually presented in the petition. PO also fails to demonstrate any objective indicia of nonobviousness, as its arguments on that point lack any connection to the claimed invention.

I. CLAIM CONSTRUCTION

A. “Entity” Is Undisputed

PO does not dispute Petitioner’s construction of the term “entity” as

¹ Petitioner also challenged claims 5-8, 17-20, and 26-30. PO then disclaimed those claims to avoid institution in CBM2018-00023. Ex-2003.

“purchasing party to a transaction who has data stored in the secure registry,” nor does PO offer its own construction for the term. *See* Resp. 13.

B. The Claims Do Not Require the Access Restrictions Be “Based at Least in Part on the Indication of the Provider and the Time-Varying Multicharacter Code of the Transaction Request”

In view of the various embodiments disclosed by the ’539 patent, as well as the plain language of the claim itself, the clause “based at least in part on an indication of the provider and the time-varying multicharacter code of the transaction request” should be read to modify the element that immediately precedes it: “completing the transaction.” *See* Pet., 15-17. PO argues that the access restrictions themselves must be based on the indication of the provider and the time-varying multicharacter code. Resp., 13-16. Although the challenged claims are unpatentable under either interpretation of this limitation, construction of this term determines whether Brener alone teaches this limitation or whether the combination of Brener and Desai is necessary. Regardless, under either construction, the prior art teaches this limitation.

Although, as acknowledged by the Board, the specification describes “different levels of security to attach to different types of information stored,” and “provides that the user ‘specif[ies] the type of access restrictions and/or whom should be allowed to access the advanced personal data,” the specification does not *require* such granular access restrictions. Institution Decision (“D.I.”, Paper 7), 8.

For example, “[a]s shown in FIG. 6, the database will generally allow anyone to access basic personal data on anyone without performing any authorization check (600).” Ex-1001, 10:35-39.

Moreover, the specification provides examples where application of access restrictions does not involve consideration of the requestor’s identity but rather is based solely on whether the user’s electronic ID code is valid. *See* Pet., 16-17 (citing Ex-1001 12:19-31, 11:49-65, 12:55-13:8, 13:35-57); Ex-1002, ¶53. These embodiments equally map to the subject claim language, giving meaning to the term “access restrictions for the provider,” because the system provides role-based access restrictions allowing a bank access to the user’s credit card number but protecting the information from access by a vendor. *See, e.g.*, Ex-1001 12:19-31; 12:55-13:8.

PO’s rebuttal arguments should be rejected. PO’s expert declined to offer an opinion as to whether the ’539 patent describes access to information based solely on validity of the electronic ID code. Ex-1015, 50:1-11, 52:22-53:5. In addition, while his declaration testimony cites to the inclusion of a “store number” in the transaction request as evidence that access must be based on vendor identity, he later admitted that “there might be multiple purposes” for including the store number and at least one embodiment of the ’539 patent includes a store number where *no* information is communicated from the secure registry to the merchant,

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