Paper No. ____
Filed: October 11, 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.,
APPLE INC.,
Petitioners,

v.

UNIVERSAL SECURE REGISTRY LLC,
Patent Owner.

Case No. IPR2018-01350[1]
Patent No. 8,856,539

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

[1] Apple Inc., which filed a petition in IPR2019-00727, has been joined as a party to this proceeding.

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I. PO PROPOSES AN UNREASONABLE NUMBER OF CLAIMS

PO does not dispute that for claims 1-3, 16, 21-24, and 38, PO has proposed at least two substitute claims in proceedings before the Board. Yet the rule presumes "that ***only one*** substitute claim would be needed to replace ***each challenged claim***." 37 C.F.R. § 42.121(a)(3) (emphasis added). The plain language of the presumption is not limited to a single motion or proceeding.

PO's refusal to show whether its substitute claims are patentably distinct from the substitute claims pending in IPR2018-00812 does nothing to address the conundrum created by two competing motions to amend. If PO wanted to avoid the dilemma of multiple amendments, it could have requested consolidation or proposed the same amendments in both IPRs. It is not in the public interest to grant amendments in one proceeding that potentially would not survive the other.

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

PO's argument that claim 52's scope is "entirely different than disclaimed claims" is conclusory and unexplained. Reply 2-3. Disclaimed claims 5 and 7 recite "credit card account information" and "bank account information," respectively. Thus, each has overlapping scope with the substitute claim's "public ID number that identifies a financial account number."

PO also misses the point with respect to its disclaimer of a nearly identical "public ID code" limitation in the '137 patent. Both patents have the same

inventor and are directed to very similar subject matter. PO disclaimed a "public ID code" limitation to avoid a CBM challenge yet now seeks an end-run around the AIA's challenges by introducing equivalent subject matter. The Board should find PO is estopped from engaging in such gamesmanship and lack of candor.

III. PO'S PROPOSED SUBSTITUTE CLAIMS LACK WRITTEN DESCRIPTION SUPPORT

A. Limitations 39[c], 48[a], 51[d], and 52[pre]: The specification both fails to disclose and is inconsistent with a lack of communication between the secure registry and the entity

i. PO's citations do not disclose a lack of communications

PO cites to '729 Application 17:27-18:1 and Figure 8 as describing an embodiment with "no communications between the secure registry and the entity during the transaction process." Reply 4. *First*, PO recognizes that a user "presents the resultant code to the merchant," and the merchant sends that code to the secure registry. Reply 4. PO provides no reason to narrowly construe "communications" to exclude communications that pass through an intermediary.

Second, PO does not point to any positive disclosure of the claimed lack of communications during the transaction process. Because the specification is silent, it fails to allow a POSITA "to recognize the inventor invented what is claimed." *Q.I. Press Controls, BV v. Lee*, 752 F.3d 1371, 1380-81 (Fed. Cir. 2014) (negative limitation not supported by specification that lacks a positive disclosure); *Ex Parte Nam Khong Then*, Appeal 2018-006067, 2019 WL 2244822 at *2 (P.T.A.B. May

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