

Docket Nos. 2020-1223 (L), 2020-1243

In the
United States Court of Appeals
for the
Federal Circuit

APPLE INC., VISA INC. and VISA U.S.A., INC.,

Appellants,

v.

UNIVERSAL SECURE REGISTRY LLC,

Appellee.

*Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board
Case No. IPR2018-00813 · Georgianna W. Braden, Administrative Patent Judge
Jason Webley Melvin, Administrative Patent Judge · Patrick R. Scanlon, Administrative Patent Judge*

**COMBINED PETITION FOR PANEL REHEARING
AND REHEARING *EN BANC***

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Universal Secure Registry LLC v. Apple Inc.

Appeals Nos. 2020-1223, 2020-1243

CERTIFICATE OF INTEREST

Counsel for Universal Secure Registry certifies as follows:

1. Provide the full names of all entities represented by undersigned counsel in this case.

Universal Secure Registry LLC.

2. Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

Not applicable.

3. Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

KW Strategic Enterprises, LLC

4. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court.

QUINN EMANUEL URQUHART & SULLIVAN, LLP: Jim Glass, Nima Hefazi, Jordan Kaericher, Razmig Messerian.

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

- *Universal Secure Registry LLC v. Apple Inc., Visa Inc. and Visa U.S.A., Inc.*, Case No. 1:17-cv-00585-CFC-SRF (D. Del.).
- *Universal Secure Registry LLC v. Apple Inc.*, Federal Circuit, No. 20-2044

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

Not applicable.

Dated: September 27, 2021

Respectfully submitted,

By: /s/ Tigran Guledjian

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Universal Secure Registry LLC v. Apple, Inc.,
No. 20-2044 (Fed. Cir. Aug. 26, 2021)1

STATUTORY AUTHORITIES

35 U.S.C. § 1011

STATEMENT OF COUNSEL PURSUANT TO FED. CIR. R. 35(b)(2)

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States or the precedent(s) of this court:

- *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014)
- *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79 (2012)
- *Ancora Techs., Inc. v. HTC Am., Inc.*, 908 F.3d 1343 (Fed. Cir. 2018)
- *Finjan Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299 (Fed. Cir. 2018)

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting questions of exceptional importance:

- Whether step one of the *Alice* test for patentable subject matter requires a showing of “specificity,” “unexpected results,” or unconventional claim elements.
- Whether the two steps of the *Alice* test are distinct requirements that must both be separately met to invalidate a patent claim.

DATED: September 27, 2021

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ARGUMENT

Universal Secure Registry LLC (“USR”) submits this petition for panel rehearing and rehearing en banc contemporaneously with its petition for rehearing in *Universal Secure Registry LLC v. Apple, Inc.*, No. 20-2044 (Fed. Cir. Aug. 26, 2021). At issue in this appeal is a final written decision by the Patent Trial and Appeal Board (“the Board”) concerning U.S. Patent No. 9,100,826, one of four patents asserted by USR against Appellants Apple and Visa. The Board found that Apple and Visa failed to prove the unpatentability of the challenged claims of the ’826 patent and one proposed substitute claim 50. In case no. 20-2044, a panel of this Court (Stoll, J., joined by Taranto and Wallach, JJ.) affirmed a district court judgment that the claims of the ’826 patent are ineligible under 35 U.S.C. § 101. In light of that ruling, the same panel held in this case in an unpublished order (App.1-3 (Op.”)) that Apple’s and Visa’s appeal of the Board’s Final Written Decision concerning these overlapping claims was moot and “that proposed substitute claim 50 is ineligible under § 101 for the same reasons” articulated by the panel in *Universal Secure Registry*, No. 20-2044. Op. 2. The panel therefore reversed the Board’s eligibility determination as to substitute claim 50. *Id.* at 3.

USR has filed a combined petition for rehearing or rehearing en banc of the panel opinion in *Universal Secure Registry*, No. 20-2044. USR, therefore, respectfully submits this petition for rehearing or rehearing en banc of the panel

opinion in this case with respect to proposed substitute claim 50 for the same reasons articulated in the concomitantly filed petition for rehearing in No. 20-2044, which are expressly incorporated in their entirety by reference herein. Should the panel grant rehearing or the full Court grant en banc review in No. 20-2044, USR respectfully requests that this petition be granted as well.

CONCLUSION

The panel should grant rehearing in this case as well as in *Universal Secure Registry*, No. 20-2044, for the reasons stated in the concomitantly filed petition for rehearing in case No. 20-2044; alternatively, the Court should grant rehearing *en banc* of both decisions.

DATED: September 27, 2021

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ADDENDUM

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

APPLE INC., VISA INC., VISA U.S.A., INC.,
Appellants

v.

UNIVERSAL SECURE REGISTRY LLC,
Appellee

2020-1223, 2020-1243

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2018-00813.

Decided: August 26, 2021

MARK D. SELWYN, Wilmer Cutler Pickering Hale and Dorr LLP, Palo Alto, CA, argued for all appellants. Apple Inc. also represented by MONICA GREWAL, Boston, MA.

MATTHEW A. ARGENTI, Wilson, Sonsini, Goodrich & Rosati, PC, Palo Alto, CA, for appellants Visa Inc., Visa U.S.A., Inc. Also represented by MICHAEL T. ROSATO, Seattle, WA.

CHRISTOPHER MATHEWS, Quinn Emanuel Urquhart &

Sullivan, LLP, Los Angeles, CA, argued for appellee. Also represented by TIGRAN GULEDJIAN.

Before TARANTO, WALLACH,* and STOLL, *Circuit Judges*.

STOLL, *Circuit Judge*.

In our opinion in *Universal Secure Registry LLC v. Apple, Inc.*, No. 20-2044 (Fed. Cir. Aug. 26, 2021), issued concomitantly with this opinion, we held claims 1–35 of U.S. Patent No. 9,100,826 at issue in this appeal ineligible under 35 U.S.C. § 101. These thirty-five overlapping claims were at issue in the underlying *inter partes* review proceeding. Accordingly, for the reasons we explained in *Apple Inc. v. Voip-Pal.com, Inc.*, 976 F.3d 1316, 1321 (Fed. Cir. 2020), the appeal of these overlapping claims is rendered moot in light of our decision in *Universal Secure*. We vacate the Board’s final written decision and remand for the Board to dismiss Apple’s petition as to the overlapping claims.

This leaves us with proposed substitute claim 50, which depends from proposed substitute claim 45. The Board held this claim eligible. We conclude that proposed substitute claim 50 is ineligible under § 101 for the same reasons we found representative claim 10 ineligible in *Universal Secure*. While proposed substitute claim 50 includes more specific limitations not found in claim 10, our conclusion under *Alice* steps one and two remains the same: proposed substitute claim 50 is directed to an abstract idea and does not recite an inventive concept that transforms the abstract idea into a patent-eligible invention. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217–21 (2014).

* Circuit Judge Evan J. Wallach assumed senior status on May 31, 2021.

APPLE INC. v. UNIVERSAL SECURE REGISTRY LLC

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Accordingly, we reverse the Board's eligibility determination as to substitute claim 50.

**REVERSED IN PART, VACATED IN PART, AND
REMANDED**

COSTS

Costs to Appellants.

CERTIFICATE OF COMPLIANCE

The undersigned attorney certifies that this Petition For Rehearing complies with the type-volume limitation set forth in Fed. R. App. P. 35(b)(2). The relevant portions of the brief, including all footnotes, contain 356 words, as determined by Microsoft Word.

DATED: September 27, 2021

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CERTIFICATE OF SERVICE

I, Tigran Guledjian, hereby certify that on September 27, 2021, I will cause to be served electronically on all counsel of record the foregoing Petition For Rehearing.

DATED: September 27, 2021

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