

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNIVERSAL SECURE REGISTRY, LLC,
Patent Owner.

Case IPR2019-00175
Patent 9,100,826 B2

Before PATRICK R. SCANLON, GEORGIANNA W. BRADEN, and
JASON W. MELVIN, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION
Granting Motion for Joinder
35 U.S.C §§ 314, 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Visa Inc. and Visa U.S.A. Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34 of U.S. Patent No. 9,100,826 B2 (Ex. 1001, “the ’826 patent”). Petitioner also filed a Motion for Joinder with *Apple Inc. v. Universal Secure Registry, LLC*, Case IPR2018-00810. Paper 3 (“Mot.”). Universal Secure Registry, LLC (“Patent Owner”) did not file a Preliminary Response; nor did Patent Owner file an opposition to the Motion for Joinder. We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

II. BACKGROUND

A. *Related Matters*

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 3–4; Paper 6, 2 (Patent Owner’s Mandatory Notices).

B. *IPR2018-00810*

In IPR2018-00810, Apple, Inc., challenged claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34 of the ’826 patent, and the Board instituted an *inter partes* review of the challenged claims as unpatentable

under 35 U.S.C. § 103 over Maritzen,¹ Jakobsson,² and Niwa.³ *Apple, Inc. v. Universal Secure Registry LLC*, Case IPR2018-00810, slip op. at 5, 20 (PTAB Oct. 9, 2018) (Paper 8) (“Apple Inst.”).

III. *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same single ground of unpatentability as the one on which we instituted review in IPR2018-00810. *Compare* Pet. 19–77, with Apple Inst. 5, 20. Indeed, Petitioner states “the Petition is limited to the same grounds proposed in the IPR2018-00810 petition,” and it “relies on the same prior art analysis and identical expert testimony to that submitted by Apple.” Mot. 4. Petitioner also states the “Petition does not raise any new ground that is not raised in the IPR2018-00810 petition.” *Id.* Thus, for the same reasons stated in our Decision on Institution in IPR2018-00810, we determine institution is warranted here. *See generally* Apple Inst.

IV. MOTION FOR JOINDER

Having determined that institution is warranted, we consider Petitioner’s Motion for Joinder. Section 315(c) provides, in relevant part, that “[i]f the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311.” When determining whether to grant a motion for joinder we consider factors such as timing and impact of

¹ U.S. Patent Application Publication No. 2004/0236632 A1, published November 25, 2004 (Ex. 1004).

² International Patent Application Publication No. WO 2004/051585 A2, published June 17, 2004 (Ex. 1005).

³ U.S. Patent No. 6,453,301 B1, issued September 17, 2002 (Ex. 1007).

joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

The Board instituted an *inter partes* review in IPR2018-00810 on October 9, 2018. Petitioner's Motion for Joinder was filed November 2, 2018. Paper 3. Thus, Petitioner's Motion for Joinder is timely because joinder was requested no later than one month after the date of institution in IPR2018-00810. *See* 37 C.F.R. § 42.122(b).

The Petition in this case asserts the same unpatentability ground on which we instituted review in IPR2018-00810. *See* Mot. 4. Petitioner further explains that it relies on the same prior art analysis and expert testimony submitted in IPR2018-00810. *Id.* Thus, the Petition does not present any ground or matter not already at issue in IPR2018-00810, and it will have minimal impact on that proceeding.

If joinder is granted, Petitioner anticipates participating in the proceeding in a limited capacity absent termination of Apple as a party to the proceeding, and it is agreeable to the schedule set forth for IPR2018-00810. *Id.* at 2. Petitioner agrees that it "will not submit any separate filings unless it disagrees with Apple's position, and in the event of such disagreement, it will request authorization from the Board to submit a short separate filing directed only to points of disagreement with Apple." *Id.* at 6. Because Petitioner relies on the same expert declaration as Apple, no additional depositions will be required. *Id.* at 6–7.

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2018-00810.

We limit Petitioner's participation in the joined proceeding, such that (1) Apple alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) Petitioner is bound by all filings by Apple in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Petitioner receives permission to file an independent paper. Petitioner must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding, so long as Apple remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in IPR2018-00810 and protects the interests of Apple, as original petitioner in IPR2018-00810, and of Patent Owner.

For the foregoing reasons, and with the limitations discussed above, Petitioner's Motion for Joinder is *granted*.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review of claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34 of the '826 patent is warranted on the sole asserted ground of unpatentability;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2018-00810 is *granted*, and Visa Inc. and Visa U.S.A. Inc. are joined as petitioners in that proceeding pursuant to 37 C.F.R. § 42.122, subject to the conditions discussed above;

FURTHER ORDERED that the Petition is *dismissed*, pursuant to 37 C.F.R. § 42.71(a);

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FURTHER ORDERED that, subsequent to joinder, the Scheduling Order in place for IPR2018-00810 (Paper 9) remains unchanged and shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2018-00810;

FURTHER ORDERED that the case caption in IPR2018-00810 for all further submissions shall be changed to add Visa Inc. and Visa U.S.A. Inc. as named Petitioner after Apple and to indicate by footnote the joinder of IPR2019-00175 to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2018-00810.

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Sample Case Caption

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⁴ Visa Inc. and Visa U.S.A. Inc., which filed a petition in IPR2019-00175, have been joined as a party to this proceeding.