

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REGIONS FINANCIAL CORPORATION, ADVANCE AMERICA, CASH
ADVANCE CENTERS, INC., and CNU ONLINE HOLDINGS, LLC
F/K/A CASH AMERICA NET HOLDINGS, LLC
Petitioners

v.

RETIREMENT CAPITAL ACCESS MANAGEMENT COMPANY LLC
Patent Owner

Case CBM2014-00012
US Patent 6,625,582

Before GLENN J. PERRY, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

ORDER
Petitioners' Motion for Joinder
37 C.F.R. § 42.122

Introduction

Petitioners Regions Financial Corporation, Advance America, Cash Advance Centers, Inc., and CNU Online Holdings, LLC F/K/A Cash America Net Holdings, LLC (collectively, “Petitioners”) filed a Petition (Paper 9) to institute a covered business method patent review of claims 1, 13, 14, 18, 30, and 31 of Patent 6,625,582 B2 (Ex. 1003, “’582 patent”) pursuant to 35 U.S.C. §§ 311-319 and a motion for joinder with Case CBM2013-00014 (Paper 7) (“Mot.”). Patent Owner Retirement Capital Access Management Company LLC filed an opposition (Paper 14) (“Opp.”) to Petitioners’ motion. For the reasons that follow, Petitioners’ motion is *denied*.

Related Case CBM2013-00014

On February 1, 2013, U.S. Bancorp filed a petition to institute a covered business method patent review of claims 1, 13, 14, 18, 30, and 31 of the ’582 patent. CBM2013-00014, Paper 1. On June 5, 2013, the Board denied U.S. Bancorp’s request to add one or more of the current Petitioners to the proceeding for CBM2013-00014. CBM2013-00014, Paper 8. In that same Order, the Board stated that the U.S. Bancorp failed to provide any statute or rule that authorizes joinder of parties to an already-filed petition without the filing of an additional petition.

On September 20, 2013, the Board instituted a covered business method patent review in CBM2013-00014 of claims 1, 13, 14, 18, 30, and 31 of the ’582 patent. CBM2013-00014, Paper 12, 14. Petitioners subsequently filed their Petition in the instant proceeding, on October 15, 2014, challenging the same claims of the ’582 patent.

Analysis

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), created new administrative trial proceedings, including covered business method patent review, as an efficient, streamlined, and cost-effective alternative to district court litigation. The AIA permits the joinder of like proceedings. The Board, acting on behalf of the Director, has the discretion to join a covered business method patent review with another covered business method patent review. 35 U.S.C. § 325. Section 325(c) provides (emphasis added):

JOINDER. – If more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 325(c); 37 C.F.R. § 42.122. The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including “the breadth or unusualness of the claim scope” and claim construction issues). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 326(b); 37 C.F.R. § 42.1(b).

As the moving party, Petitioners have the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c). A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new

grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See e.g. Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013).

Patent Owner argues that Petitioners' motion for joinder should be denied as untimely under 37 C.F.R. § 42.122(b) because Petitioners waited over four months after the Board denied the request for joinder in CBM2013-00014 to file their Petition. *Opp.* at 3. Patent Owner argues that if Petitioners had filed their Petition for the instant proceeding shortly after the denial of the joinder request in CBM2013-00014, Petitioners could have avoided any significant prejudice associated with a consolidation of the proceedings.

Petitioners allege that the Petition raises the same grounds for invalidity as raised in the Petition for CBM2013-00014 or "otherwise addresses issues raised in Patent Owner's Preliminary Response to same." *Mot.* 2. Petitioners fail to address, however, that although the current Petition asserts the same challenge as the Petition in CBM2013-00014, the current Petition provides new arguments for why the challenged claims should be found patent ineligible under 35 U.S.C. § 101. *See* Paper 9, 43-50. Furthermore, the current Petition provides additional claim construction arguments not made in the Petition in CBM2013-00014. *See id.* 16-17.

Under the circumstances, joinder would have a significant adverse impact on the Board's ability to complete the existing proceeding in a timely manner, which weighs against granting the motion for joinder. The Board is charged with securing the just, speedy, and inexpensive resolution of every proceeding, and has the discretion to join or not join proceedings to ensure that objective is met. 37 C.F.R. §§ 42.1(b), 42.122. The related case, CBM2013-00014, was filed almost a

CBM2014-00012
US Patent 6,625,582

year ago (March 29, 2013) and is already well underway, with the oral argument scheduled for April, 1, 2014. *See* CBM2013-00014, Paper 13. Joinder at this stage would require a lengthy delay in the ongoing review.

Petitioners have not shown that the patentability issues raised in the instant Petition can be resolved in a joined proceeding without substantially affecting the schedule in CBM2013-00014. Petitioners, therefore, have not satisfied their burden of proof in showing entitlement to the requested relief—namely, joinder with Case CBM2013-00014. Accordingly, we decline to exercise our discretion under 35 U.S.C. § 315(c) to authorize joinder, and deny Petitioners' motion.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioners' motion for joinder is *denied*.

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