

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 CBM2019-00025
Patent 8,577,813

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

BRADEN, *Administrative Patent Judge*.

DECISION

Granting Motion for Joinder

35 U.S.C § 324; 35 U.S.C § 325(c); 37 C.F.R. § 42.222(b)

I. INTRODUCTION

Petitioner, Visa Inc. and Visa U.S.A. Inc., filed a Petition (Paper 2, “Pet.”) requesting covered business method review of claims 1, 2, 4–11, 13–20, and 22–26 of U.S. Patent No. 8,577,813 B2 (Ex. 1201, “the ’813 patent”). Patent Owner, Universal Secure Registry, LLC, did not file a Preliminary Response.

Petitioner also filed a Motion for Joinder to join as a petitioner in CBM2018-00024. Paper 3 (“Mot.”). Petitioner filed the Petition and Motion for Joinder on December 20, 2018, within one month after we instituted trial in CBM2018-00024.

As explained further below, we determine institution is warranted on the same grounds as instituted in CBM2018-00024 and grant Petitioner’s Motion for Joinder.

A. *Related Matters*

As required by 37 C.F.R. § 42.8(b)(2), Petitioner identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 3–5.

B. *IPR2018-00809*

In CBM2018-00024, Apple, Inc., challenged claims 1, 2, 4–11, 13–20, and 22–26 of the ’813 patent. After considering the Petition and Patent Owner’s Preliminary Response, we instituted review of the claims challenged in that case. *Apple, Inc. v. Universal Secure Registry LLC*, Case CBM2018-00024 (PTAB Nov. 20, 2018) (Paper 10, “Apple Inst.”). Thus, the instituted review in CBM2018-00024 involves the following grounds of unpatentability:

References	Basis	Claims Challenged
Maes ¹ and Jakobsson ²	§ 103(a) ³	1, 2, 4, 5, 11, 13, 16–20, and 24
Maes, Jakobsson, and Maritzen ⁴	§ 103(a)	6–10
Maes, Jakobsson, and Labrou ⁵	§ 103(a)	14, 15, 22, 23, 25, and 26

Apple Inst. 8. Apple also relied on the Declaration of Dr. Victor Shoup (CBM2018-00024, Ex. 1202). *See id.*

II. DISCUSSION

Petitioner’s Motion for Joinder states “the Petition is limited to the same grounds proposed in the CBM2018-00024 petition,” “relies on the same prior art analysis and identical expert testimony to that submitted by Apple.” Mot. 4; *accord id.* (“Indeed, the Petition is nearly identical with respect to the grounds raised in the CBM2018-00024 petition, and does not include any grounds not raised in that petition.”). Thus, for the same reasons

¹ U.S. Patent No. 6,016,476, issued Jan. 18, 2000 (“Maes,” CBM2018-00024, Ex. 1213).

² WO Patent Publication No. WO 2004/051585 A2, published June 17, 2004 (“Jakobsson,” CBM2018-00024, Ex. 1214).

³ The America Invents Act included revisions to, *inter alia*, 35 U.S.C. § 103 effective on March 16, 2013. Because the ’813 patent issued from an application filed before March 16, 2013, the pre-AIA version of 35 U.S.C. § 103 applies.

⁴ U.S. Patent Publication No. US 2004/0236632 A1, published Nov. 25, 2004 (“Maritzen,” CBM2018-00024, Ex. 1215).

⁵ U.S. Patent Publication No. US 2004/0107170 A1, published Jun. 3, 2004 (“Labrou,” CBM2018-00024, Ex. 1216).

stated in our Decision on Institution in CBM2018-00024, we determine institution is warranted here. *See generally* Apple Inst.

Having determined that institution is warranted, we consider Petitioner’s Motion for Joinder. Section 325(c) provides, in relevant part, that “[i]f 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.” When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *See Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Under the circumstances of this case, we determine that joinder is appropriate. Because the present Petition does not include any issues beyond those in the already instituted case, it will have minimal impact on the existing case. Petitioner agrees 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.” Mot. 6–7. Because Petitioner relies on the declaration as does Apple, no additional depositions will be required. *See id.* at 7.

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in CBM2018-00024. We limit Petitioner Visa’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) Visa is bound by all filings by Apple in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Visa receives permission to file an independent paper. Visa 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 Case CBM2018-00024 and protects the interests of Apple as original petitioner in Case CBM2018-00024, and of Patent Owner.

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

III. ORDER

Accordingly, it is:

ORDERED that a covered business method review is hereby instituted as to claims 1, 2, 4–11, 13–20, and 22–26 of the '813 patent on the following asserted grounds:

- (1) Claims 1, 2, 4, 5, 11, 13, 16–20, and 24 under 35 U.S.C. § 103 as unpatentable over Maes and Jakobsson;
- (2) Claims 6–10 under 35 U.S.C. § 103 as unpatentable over Maes, Jakobsson, and Maritzen;
- (3) Claims 14, 15, 22, 23, 25, and 26 under 35 U.S.C. § 103 as unpatentable over Maes, Jakobsson, and Labrou;

FURTHER ORDERED that Petitioner's Motion for Joinder with CBM2018-00024 is granted, and Visa Inc. and Visa U.S.A. Inc. are joined as petitioners in that case pursuant to 37 C.F.R. § 42.222, based on the conditions discussed above;

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