

Paper No. _____
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Filed on behalf of: Visa Inc. and Visa U.S.A. Inc.
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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.,
Petitioners,

v.

UNIVERSAL SECURE REGISTRY, LLC,
Patent Owner.

Case CBM2019-00026
Patent No. 8,577,813

**MOTION FOR JOINDER UNDER 35 U.S.C. § 325(c)
AND 37 C.F.R. §§42.22 AND 42.222(b)**

I. Statement of the Precise Relief Requested

Visa Inc. and Visa U.S.A. Inc. (together, “Visa” or “Petitioners”) submit, concurrently with this motion, a petition for covered business method review (“Petition”) of claims 1, 2, 4-11, 13-20, and 22-26 of U.S. Patent No. 8,577,813 (“the ’813 patent”), which is assigned to Universal Secure Registry, LLC (“Patent Owner”). Visa respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.222(b) of the concurrently filed Petition with a pending covered business method review initiated by Apple Inc. (“Apple”), CBM2018-00025.

Joinder will promote efficiency and consistent resolution of substantively identical challenges to the same patent. This motion for joinder is timely because it is filed within one month of the institution decision in CBM2018-00025. Joinder should create no unfair burden for the Board, Patent Owner, or Apple because these grounds are substantive copies of the instituted grounds from the original petition filed in CBM2018-00025. The present Petition contains only minor modifications from the petition in CBM2018-00025, such as changes to address the identity of the petitioner and the request for joinder with CBM2018-00025. The Petition relies upon the expert declaration of Dr. Victor Shoup (Ex. 1102), which was submitted in CBM2018-00025. Petitioner has updated the exhibit labeling to match the case information for this case.

Absent termination of Apple as a party to the proceeding, Visa anticipates participating in a joined proceeding in an understudy role. Moreover, joinder will have no impact on the trial schedule of CBM2018-00025 because that CBM is still in its early trial stages, and Visa, in its limited role, is agreeable to the same schedule.

Visa has conferred with counsel for Apple regarding the subject of this motion, and counsel for Apple indicated that Apple does not oppose joinder.

II. Background

On May 3, 2018, Apple filed a petition for covered business method review challenging claims 1, 2, 4-11, 13-20, and 22-26 of the '813 patent, Case No. CBM2018-00025. On December 3, 2018, the Board instituted review on claims 1, 2, 4-11, 13-20, and 22-26. This Petition is a practical copy of the CBM2018-00025 petition, including the same prior art analysis and identical expert testimony. *See* Pet.

III. Argument

A. Legal Standard

If more than one petition for a covered business method review is properly filed against the same patent and the Director determines that more than one of these petitions warrants the institution of a covered business method review under Section 324, the Director may consolidate such reviews into a single covered

business method review. 35 U.S.C. §325(c). In deciding whether to grant a motion for joinder, the Board considers several factors including: (1) the reasons why joinder is appropriate; (2) whether the party to be joined has presented any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See, e.g., Hyundai Motor Co. v. Am. Vehicular Sciences LLC*, IPR2014-01543, Paper No. 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)). Under this framework, joinder with CBM2018-00025 is appropriate.

B. Visa's Motion for Joinder Is Timely

Joinder may be requested no later than one month after the institution date of any post-grant review for which joinder is requested. 37 C.F.R. § 42.222. Here, because the Board issued its institution decision in CBM2018-00025 on December 3, 2018, this Motion for Joinder and the accompanying Petition are timely.

C. The Relevant Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder. As discussed below, granting joinder will not enlarge the scope of the CBM2018-00025 beyond that proposed in the original petition and will not negatively impact the CBM2018-00025 schedule.

1. Joinder is Appropriate

Joinder with CBM2018-00025 is appropriate because the Petition is limited to the same grounds proposed in the CBM2018-00025 petition. It also relies on the same prior art analysis and identical expert testimony to that submitted by Apple. Indeed, the Petition is nearly identical with respect to the grounds raised in the CBM2018-00025 petition and does not include any grounds not raised in that petition.¹

Joinder is also appropriate because it will promote the just, speedy, and inexpensive resolution of patentability issues, including the determination of patentability of the challenged claims of the '813 patent.

¹ As one example, Visa's petition presents identical claim construction analysis as found in the CBM2018-00025 petition, including application of the broadest reasonable interpretation standard. *See* Pet. 21-26. While Visa acknowledges that petitions filed after November 13, 2018 are subject to the same claim construction standard applied in district court proceedings, Visa applies the broadest reasonable interpretation standard to maintain consistency with CBM2018-00025. Should the Board have any concerns about the appropriate claim construction standard Visa would welcome the opportunity to address the issue in further briefing.

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