

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNIVERSAL SECURE REGISTRY LLC,
Patent Owner.

Case IPR2019-00727
Patent 8,856,539 B2

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 § 314; 35 U.S.C § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, Apple Inc., filed a Petition (Paper 3, “Pet.”) requesting *inter partes* review of claims 1–9, 16–31, 37, and 38 of U.S. Patent No. 8,856,539 B2 (Ex. 1001, “the ’539 patent”). Universal Secure Registry LLC, did not file a Preliminary Response.

Petitioner also filed a Motion for Joinder to join as a petitioner in IPR2018-01350. Paper 4 (“Mot.”). Petitioner filed the Petition and Motion for Joinder on March 11, 2019, within one month after we instituted trial in IPR2018-01350.

As explained further below, we determine institution is warranted on the same claims and the ground as instituted in IPR2018-01350 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. 13–14.

B. *IPR2018-01350*

In IPR2018-01350, Petitioner Visa, Inc., challenged claims 1–9, 16–31, 37, and 38 of the ’539 patent and Patent Owner, Universal Secure Registry, LLC, disclaimed claims 5–8, 17–20, and 26–30. After considering the Petition and Patent Owner’s Preliminary Response and Disclaimer, we instituted review of claims 1–4, 9, 16, 21–25, 31, 37, and 38 in that case. *Visa, Inc. and Visa U.S.A., Inc. v. Universal Secure Registry LLC*, Case IPR2018-01350 (PTAB Feb. 11, 2019) (Paper 7, “Visa Inst.”). The instituted review in IPR2018-01350 involved a challenged to patentability

under 35 U.S.C. § 103 as obvious over a combination of Brener,¹ Weiss,² and Desai.³ Visa Inst. 5. Visa also relied on the Declaration of Douglas Tygar, Ph.D. (“Dr. Tygar”) (IPR2018-01350, Ex. 1002). *See id.*

II. DISCUSSION

Petitioner’s Motion for Joinder states “the Petition presents only the grounds raised in the Visa IPR, and is based on the same prior art analysis and expert testimony submitted by Visa.” Mot. 6; *accord id.* at 1 (“The Petition is also narrowly tailored to raise only the grounds of unpatentability that are the subject of the Visa IPR, and is essentially a copy of the Visa IPR petition, including the same analysis of the same prior art and same expert testimony.”). Thus, for the same reasons stated in our Decision on Institution in IPR2018-01350, we determine institution is warranted here. *See generally* Visa Inst.

Having determined that institution is warranted, we consider the merits of Petitioner’s Motion for Joinder. Section 315(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

¹ PCT Pub. App. WO 00/14648 (pub. Mar. 16, 2000) (Ex. 1005).

² U.S. Pat. No. 4,885,778 (iss. Dec. 5, 1989) (Ex. 1006).

³ U.S. Pat. No. 6,820,204 B1 (iss. Nov. 16, 2004) (Ex. 1007).

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 has agreed to not materially participate in the joined proceedings unless and until the parties to the Visa IPR are dismissed from the joined proceedings or elect to transfer control to Petitioner, as may occur in the event of settlement or advanced settlement negotiations.” Mot. 7–8. According to Petitioner Apple Inc., if “either of the foregoing events occur[s], Petitioner intends to ‘step into the shoes’ of Visa and continue to prosecute the joined proceedings.” *Id.* at 8. Because Petitioner relies on the same declaration as does Visa, no additional depositions will be required. *See id.* at 6.

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2018-01350. We limit Petitioner Apple Inc.’s participation in the joined proceeding, such that (1) Visa 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) Apple Inc. is bound by all filings by Visa in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Apple Inc. receives permission to file an independent paper. Apple Inc. must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding, so long as Visa remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in Case

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IPR2018-01350 and protects the interests of Visa as original petitioner in Case IPR2018-01350, 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 *inter partes* review is hereby warranted as to claims 1–4, 9, 16, 21–25, 31, 37, and 38 of the '539 patent under 35 U.S.C. § 103 as unpatentable over a combination of Brener, Weiss, and Desai;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2018-01350 is granted, and Apple Inc. is joined as a petitioner in that case pursuant to 37 C.F.R. § 42.122, based on the conditions discussed above;

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

FURTHER ORDERED that the Scheduling Order in place for IPR2018-01350 (Paper 8) shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2018-01350;

FURTHER ORDERED that the case caption in IPR2018-01350 for all further submissions shall be changed to add Apple Inc. Inc. as a named Petitioner after Visa and to indicate by footnote the joinder of IPR2018-01350 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 IPR2018-01350.

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