

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 IPR2019-00174
Patent 9,530,137 B2

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

MELVIN, *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, Visa Inc. and Visa U.S.A. Inc., filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1, 2, 5–7, 9, and 12 of U.S. Patent No. 9,530,137 B2 (Ex. 1101, “the ’137 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 IPR2018-00809. Paper 3 (“Mot.”). Petitioner filed the Petition and Motion for Joinder on November 2, 2018, within one month after we instituted trial in IPR2018-00809.

As explained further below, we determine institution is warranted on the same grounds as instituted in IPR2018-00809 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. 3–4.

B. IPR2018-00809

In IPR2018-00809, Apple, Inc., challenged claims 1, 2, and 5–12 of the ’137 patent. Patent Owner disclaimed claims 8, 10, and 11, and, after considering the Petition and Patent Owner’s Preliminary Response, we instituted review of the non-disclaimed claims challenged in that case. *Apple, Inc. v. Universal Secure Registry LLC*, Case IPR2018-00809 (PTAB Oct. 9, 2018) (Paper 9, “Apple Inst.”). Thus, the instituted review in IPR2018-00809 involves the following grounds of unpatentability:

Basis	Reference(s)	Claim(s)
§ 103(a)	Jakobsson ¹ and Maritzen ²	1, 2, 6, 7, 9, and 12
§ 103(a)	Jakobsson, Maritzen, and Niwa ³	5

Apple Inst. 5–7. Apple also relied on the Declaration of Dr. Victor Shoup (IPR2018-00809, Ex. 1102). *See id.* 5.

II. DISCUSSION

Petitioner’s Motion for Joinder states “the Petition is limited to the same grounds proposed in the IPR2018-00809 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 IPR2018-00809 petition, and does not include any grounds not raised in that petition.”). Thus, for the same reasons stated in our Decision on Institution in IPR2018-00809, we determine institution is warranted here. *See generally* Apple Inst.

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 joinder on the trial schedule, cost, discovery, and potential simplification of

¹ International Patent Application Publication No. WO 2004/051585, published June 17, 2004 (Ex. 1113).

² U.S. Patent Application Publication No. 2004/0236632, published November 25, 2004 (Ex. 1114).

³ U.S. Patent No. 6,453,301, issued September 17, 2002 (Ex. 1117).

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. Because Petitioner relies on the declaration as does Apple, no additional depositions will be required. *See* Mot. 6–7.

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2018-00809. 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 IPR2018-00809 and protects the interests of Apple as original petitioner in Case IPR2018-00809, 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 *inter partes* review of claims 1, 2, 5–7, 9, and 12 of the '137 patent is warranted on the following grounds:

- A. claims 1, 2, 6, 7, 9, and 12 as unpatentable under 35 U.S.C. § 103 as obvious over Jakobsson and Maritzen;
- B. claim 5 as unpatentable under 35 U.S.C. § 103 as obvious over Jakobsson, Maritzen, and Niwa;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2018-00809 is granted, and Visa Inc. and Visa U.S.A. Inc. are joined as petitioners in that case pursuant to 37 C.F.R. § 42.122, 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 IPR2018-00809 (Paper 10) shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2018-00809;

FURTHER ORDERED that the case caption in IPR2018-00809 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 IPR2019-00174 to that proceeding, as indicated in the attached sample case caption; and

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