

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 IPR2019-00176
Patent No. 9,100,826 B2

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c)
AND 37 C.F.R. §§42.22 AND 42.122(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 *inter partes* review (“Petition”) of claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34 of U.S. Patent No. 9,100,826 (“the ’826 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. § 42.122(b) of the concurrently filed Petition with a pending *inter partes* review initiated by Apple Inc. (“Apple”), IPR2018-00813. Petitioner requests joinder as to the instituted grounds.

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 IPR2018-00813. Joinder should create no unfair burden for the Board, Patent Owner, or Apple because these grounds are substantive copies of grounds from the original petition filed in IPR2018-00813, which have all been instituted. The present Petition contains only minor modifications from the petition in IPR2018-00813, such as changes to address the identity of the petitioner, the request for joinder with IPR2018-00813. The Petition relies upon the expert declaration of Dr. Victor Shoup (Ex. 1102), which was submitted in IPR2018-00813. 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 IPR2018-00813 because that IPR 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 April 4, 2018, Apple filed a petition for *inter partes* review challenging claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34 of the '826 patent, Case No. IPR2018-00813. Patent Owner did not file a Preliminary Response. On October 9, 2018, the Board instituted review on claims 1, 2, 7, 8, 10, 11, 14, 15, 21, 22, 24, 26, 27, 30, 31, and 34. This Petition is a practical copy of the IPR2018-00813 petition, including the same prior art analysis and identical expert testimony. *See* Pet.

III. Argument

A. Legal Standard

The Board has authority to join as a party to an instituted *inter partes* review any person who properly files a petition for *inter partes* review. 35 U.S.C. §315(c). A motion for joinder must be filed within one month of institution of any *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). 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)).

B. Visa’s Motion for Joinder Is Timely

Joinder may be requested no later than one month after the institution date of an *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122. Here, because the Board issued its institution decision in IPR2018-00813 on October 9, 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 IPR2018-00813 beyond that proposed in the original petition and will not negatively impact the IPR2018-00813 schedule.

1. Joinder is Appropriate

Joinder with IPR2018-00813 is appropriate because the Petition is limited to the same grounds proposed in the IPR2018-00813 petition, all of which were instituted. 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 IPR2018-00813 petition, and does not include any grounds not raised in that petition.

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 '826 patent.

Moreover, granting joinder will not prejudice Patent Owner or Apple. As mentioned above, the accompanying Petition does not raise any new ground that is not raised in the IPR2018-00813 petition. Therefore, joinder should not significantly affect the timing in IPR2018-00813. Also, there should be little to no additional cost to Patent Owner or Apple given the absence of new grounds. On the other hand, Visa and the public may be potentially prejudiced if joinder is denied. For example, absent joinder, Patent Owner and Apple might settle and request termination of the proceedings, leaving facially intact a patent that the Board has already found is likely unpatentable.

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