

Filed on behalf of Apple Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

UNIVERSAL SECURE REGISTRY LLC

Patent Owner of

U.S. Patent No. 8,856,539 to Weiss

IPR Trial No. IPR2019-00727

MOTION FOR JOINDER

I. INTRODUCTION

Petitioner Apple Inc. (“Apple” or “Petitioner”) submits, concurrently with this motion, a petition for *inter partes* review (the “Petition”) of claims 1-9, 16-31, 37, and 38 of U.S. Patent No. 8,856,539 (“the ’539 patent”). Apple respectfully requests that this proceeding be joined with a pending *inter partes* review initiated by Visa Inc. and Visa USA Inc. (collectively “Visa”), the petitioners in IPR2018-01350 (“Visa IPR”).

Apple’s request for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b) because the Board issued an institution decision in the Visa IPR on February 11, 2019, which is within one month of the filing of this motion. 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. In addition, joinder is appropriate because it will efficiently resolve the validity of the challenged claims of the ’539 patent without prejudicing the parties in the Visa IPR.

Absent termination of Visa as party to the proceeding, Apple has agreed to participate in the proceeding in a very limited capacity. It will not separately examine any witness during deposition nor submit any separate filings in the proceeding. Apple also will not request any adjustments to the schedule. By doing so, Apple’s limited participation will not impact the timeline of the Visa IPR trial.

Apple has conferred with counsel for Visa. Counsel for Visa confirms that their client consents to this joinder.

II. BACKGROUND

Patent Owner has asserted the '539 patent against a number of defendants, including Apple. Petitioner was served with a complaint asserting infringement of the '539 patent more than one year before filing the Petition. *See Universal Secure Registry LLC v. Apple Inc. et al.*, Civ. No. 1:17-cv-00585 (D. Del.) (filed May 21, 2017).

On July 3, 2018, Visa filed a petition for *inter partes* review challenging claims 1-9, 16-31, 37, and 38 of the '539 patent, which was assigned case number IPR2018-01350. The Board instituted *inter partes* review on February 11, 2019.

Apple's Petition presents challenges which are substantively identical to those on which trial is requested in the Visa IPR. The Petition raises no new ground of unpatentability from those in the Visa IPR because the Petition in the instant case is a copy of the Visa IPR petition with respect to the proposed grounds, including the same prior art analysis and expert testimony.

III. ARGUMENT

A. Legal Standard

The Board has authority to join as a party any person who properly files a petition for *inter partes* review to an instituted *inter partes* review. 35 U.S.C. §

315(c). A request for joinder must be filed “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b) (“Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.”).

The one-year time bar of 35 U.S.C. § 315(b) does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence) (“[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)”); 37 C.F.R. § 42.122(b).

Joinder is appropriate when it results in the just, speedy, and inexpensive resolution of proceedings. 37 C.F.R. § 42.1(b). Joinder is particularly appropriate when a later petitioner presents the identical grounds of unpatentability as an earlier petitioner. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed *as of right* - if an *inter partes* review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.”) (emphasis added). *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)).

In deciding whether to grant a motion for joinder, the Board considers several factors including: (1) the rationale for why joinder is appropriate; (2) any new grounds of unpatentability asserted in the new petition; (3) the impact (if any) joinder would have on the trial schedule for the existing proceeding; and (4) how briefing and discovery may be simplified in the joined proceeding. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper No. 17 at *4 (PTAB July 29, 2013).

B. Apple's Motion is Timely

The Visa IPR petition was filed on July 3, 2018 and was instituted on February 11, 2019. Because it is filed no later than one month after the institution date, Apple's Motion is timely under 37 C.F.R. § 42.122(b), which allows joinder to be requested up to one month after the institution date of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). The Board has previously concluded that joinder requests filed within one month of institution, like Apple's, are timely under § 42.112(b). *See, e.g., Jaiwei Technology (HK) LTD. et al. v. Lighting Science Group Corp.*, IPR2018-00263, Paper 7 at *6 (finding timely a motion for joinder filed on November 30, 2017 of an *inter partes* review proceeding instituted on November 1, 2017).

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