

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

U.S. BANCORP
Petitioner

v.

RETIREMENT CAPITAL ACCESS MANAGEMENT COMPANY LLC
Patent Owner

Case CBM2013-00014
Patent 6,625,582

Before GLENN J. PERRY, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

On June 3, 2013, the following individuals participated in a conference call in this matter: (1) Brian Pandya, counsel for Petitioner; (2) Casey Griffith, counsel for Patent Owner; (3) Administrative Patent Judges Glenn J. Perry, Thomas L. Giannetti, and Trenton A. Ward.

The purpose of the call was to discuss Petitioner's request for authorization to file a motion to add two parties to the proceeding as petitioners and real parties-in-interest.

Counsel for Petitioner explained that after the petition was filed, two additional parties in related lawsuits pending in Delaware (*see* Paper 7) wished to join the case as petitioners and real parties-in-interest. Counsel referred to the petition in CMB2013-00005, in which Bloomberg Inc. and multiple other parties are named as petitioners.

DISCUSSION

The statute governing these proceedings provides for joinder of like instituted proceedings when more than one petition is filed against the same patent.

See 35 U.S.C. § 325(c)¹:

If more than 1 petition . . . is properly filed against the same patent and the Director determines that more than 1 of these petitions

¹ Under the AIA, this statutory provision directed to post-grant reviews is applicable also to covered business method patent reviews. *See* Pub. L. No.112-29, 125 Stat. 329, Sec. 18(a)

warrants the institution of a . . . review . . . the Director may consolidate such reviews into a single . . . review.

The regulation implementing this statutory provision is 37 C.F.R. § 42.222(b), which likewise provides;

Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 4.22, no later than one month after the institution date of any . . . review for which joinder is requested.

The statutory framework provided by Congress thus contemplates the situation where a party might wish to join an additional petition with an already instituted proceeding, and provides a way for that party to do so. The statute requires the filing of “more than 1” petition for joinder to take place. Furthermore, the statute requires that the additional petition “warrants the institution of a . . . review.” The corresponding USPTO regulation similarly specifies that “[j]oinder may be requested by a patent owner *or petitioner*.” 37 C.F.R. § 42.222(b) (emphasis added). Thus the statute and corresponding regulation are directed to joining of proceedings not parties.

Petitioner’s request to join additional parties to an existing proceeding presents a case of first impression. No other such motion has been presented, much less authorized by the Board previously. Furthermore, Petitioner has directed us to no provision in the statute or rules that authorizes joinder of parties to an already-filed petition without the filing of an additional petition.

In CBM2013-00005, referred to by Petitioner during the conference, Bloomberg Inc. and the other entities were parties to the petition as originally filed. There was no request to add parties post-filing of the petition. Thus, that proceeding is not helpful to Petitioner's request.

CONCLUSION

Petitioner has failed to provide any support in the AIA statute or rules for the proposed motion. In fact, Congress has provided another vehicle, namely joinder of proceedings under § 325(c), for achieving this result. We see no reason to depart from the statutory scheme provided by Congress, and therefore we deny the request and decline to authorize the proposed motion.

ORDER

In view of the foregoing it is

ORDERED that Petitioner's request for authorization to file a motion to join additional parties to the proceeding as petitioners and as real parties-in-interest is denied.

CBM2013-00014
Patent 6,625,582

PETITIONER:

Anthony H. Son
Brian H. Pandya
Ryan M. Corbett
Wiley Rein LLP
ason@wileyrein.com
bpandya@wileyrein.com
rcorbett@wileyrein.com

PATENT OWNER:

Casey Griffith
Shital Desai
Klemchuck Kubasta LLC
casey.griffith@kk-llp.com
sita.desai@kk-llp.com