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Filed on behalf of: VirnetX Inc.
By: Joseph E. Palys
Naveen Modi
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
11955 Freedom Drive
Reston, VA 20190-5675
Telephone: 571-203-2700
Facsimile: 202-408-4400
E-mail: joseph.palys@finnegan.com
naveen.modi@finnegan.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2013-00349
Patent 6,502,135

**VIRNETX'S OPPOSITION TO APPLE'S
MOTION FOR JOINDER**

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I. INTRODUCTION

Patent Owner VirnetX Inc. respectfully requests that the Board deny Apple Inc.'s motion requesting joinder of IPR2013-00348 and IPR2013-00349 ("Apple IPRs") with IPR2013-00375 ("New Bay IPR").¹ The Apple IPRs and the New Bay IPR each concern U.S. Patent No. 6,502,135 ("the '135 patent").

The Board should deny Apple's motion because joinder will add several new substantive issues to the New Bay IPR, require additional discovery and expert testimony, prevent a timely conclusion of the New Bay IPR, and prejudice VirnetX. New Bay identified similar reasons for opposing joinder in its petition. IPR2013-00375, Paper No. 4 at 4. In addition, joinder of Apple's untimely IPRs is statutorily barred.

Denying joinder will not prejudice Apple, which has a pending validity challenge to the '135 patent in *inter partes* reexamination (control no. 95/001,682), and has previously challenged claims of the '135 patent in district court. Apple argues that joining its IPRs with the New Bay IPR "will minimize any duplication of effort by the Board and the Court" (Apple Mot. at 4), but Apple itself has invited duplication by first seeking *inter partes* reexamination and then seeking

¹ Apple also asks the Board to join its own IPR2013-00348 and -00349 with each other. Apple Mot. at 1. The Board did not authorize Apple to move for this type of joinder, and it should be denied for the reasons stated in this opposition.

two *inter partes* reviews based on the same primary references. The Board and the Patent Owner should not be tasked with minimizing the burden of Apple's duplicative proceedings.

II. PRECISE RELIEF REQUESTED

VirnetX requests that the Board deny Apple's motion for joinder.

III. STATEMENT OF FACTS

On August 18, 2010, VirnetX served Apple with a complaint, alleging that certain Apple products infringe claims 1, 3, 7-10, and 12 of the '135 patent. Ex. 2001 (Complaint, *VirnetX Inc. v. Cisco Systems, Inc. et al.*, No. 6:10-cv-417 (E.D. Tex. Aug. 11, 2010)). A jury found that those products infringe and that the tried claims of the '135 patent are valid. Ex. 2002.

On June 11, 2011, Apple initiated an *inter partes* reexamination of all claims 1-18 of the '135 patent. The Office assigned that proceeding control no. 95/001,682 ("the '1,682 reexamination"). On December 18, 2012, the Office merged the '1,682 reexamination with an *inter partes* reexamination of the '135 patent initiated by Cisco Systems, Inc. The Office issued a non-final Office Action in the merged proceedings on March 11, 2013 (Ex. 1056), to which VirnetX responded on June 11, 2013. The parties await further action by the Office.

On December 31, 2012, VirnetX served Apple with another complaint, alleging that additional Apple products infringe claims 1, 3, 7-10, and 12 of the

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