

Paper No. \_\_\_\_\_  
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Filed on behalf of: VirnetX Inc.  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NEW BAY CAPITAL, LLC  
Petitioner

v.

VIRNETX INC.  
Patent Owner

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Case IPR2013-00376  
Patent 7,490,151

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**PATENT OWNER'S MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8**

VirnetX Inc., the Patent Owner, provides the following mandatory notices pursuant to 37 C.F.R. § 42.8.

**I. Real Party-in-Interest**

Pursuant to 37 C.F.R. § 42.8(b)(1), the real party-in-interest is VirnetX Inc., the assignee of record for U.S. Patent No. 7,490,151 (“the ’151 patent”).

**II. Related Matters**

Patent Owner identifies the following matters that may be deemed related pursuant to 37 C.F.R. § 42.8(b)(2).

**A. Proceedings Before the USPTO Involving the Patent-at-Issue**

The ’151 patent, which is the subject of this proceeding, is also at issue in the following *inter partes* review and *inter partes* reexamination proceedings:

Case IPR2013-00354
Control No. 95/001,697
Control No. 95/001,714

**B. Proceedings Before the USPTO Involving Related Patents**

Several patents, which stem from the same applications that led to the ’151 patent, are at issue in the following *inter partes* review and *inter partes* reexamination proceedings:

U.S. Patent No. 6,502,135	Case IPR2013-00348 Case IPR2013-00349 Case IPR2013-00375 Control No. 95/001,679 Control No. 95/001,682
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U.S. Patent No. 7,418,504	Case IPR2013-00377 Case IPR2013-00393 Case IPR2013-00394 Control No. 95/001,788 Control No. 95/001,851
U.S. Patent No. 7,921,211	Case IPR2013-00378 Case IPR2013-00397 Case IPR2013-00398 Control No. 95/001,789 Control No. 95/001,856
U.S. Patent No. 6,839,759	Control No. 95/001,746
U.S. Patent No. 7,188,180	Control No. 95/001,792
U.S. Patent No. 8,051,181	Control No. 95/001,949

**C. U.S. Patent Applications Related to the Patent-at-Issue**

The following applications, which stem from the same applications that led to the '151 patent, are currently pending before the Office:

11/839,937	13/181,041	13/615,436	13/620,534
11/924,460	13/285,962	13/615,528	13/620,550
13/049,552	13/336,958	13/615,536	13/890,206
13/075,081	13/337,757	13/615,557	13/903,788
13/080,680	13/339,257	13/617,375	13/911,792
13/080,684	13/342,795	13/617,446	13/911,813
13/093,785	13/343,465	13/618,966	--
13/154,021	13/474,397	13/620,270	--
13/155,039	13/475,637	13/620,371	--

**D. Litigations Involving the Patent-at-Issue and/or Related Patents**

The '151 patent and/or other patents, which stem from the same applications

that led to the '151 patent, are at issue in the following cases:

<i>VirnetX Inc. and Science Applications Int'l Corp. v. Cisco Systems, Inc., Apple Inc., Aastra USA, Inc., Aastra Technologies Ltd., NEC Corp., and NEC Corp. of America</i> , No. 6:10-cv-00417 (E.D. Tex.) <sup>1</sup>
<i>VirnetX Inc. and Science Applications Int'l Corp. v. Mitel Networks Corp., Mitel Networks, Inc., Siemens AG, Siemens Corp., Siemens Enterprise Communications GmbH &amp; Co. KG, Siemens Communications, Inc., Siemens Enterprise Communications, Inc., and Avaya Inc.</i> , No. 6:11-cv-00018 (E.D. Tex.) <sup>2</sup>
<i>VirnetX Inc. and Science Applications Int'l Corp. v. Apple Inc.</i> , No. 6:12-cv-00855 (E.D. Tex.)
<i>VirnetX Inc. v. Apple Inc.</i> , No. 6:11-cv-00563 (E.D. Tex.; consolidated with case No. 6:12-cv-00855)
<i>VirnetX Inc. and Science Applications Int'l Corp. v. Apple Inc.</i> , No. 6:13-cv-00211 (E.D. Tex.)
<i>VirnetX Inc. and Science Applications Int'l Corp. v. Microsoft Corp.</i> , No. 6:13-cv-00351 (E.D. Tex.)

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<sup>1</sup> VirnetX notes that NEC and Aastra have entered into a license agreement with VirnetX and have been dismissed from this case. The only remaining defendants in this case are Apple and Cisco.

<sup>2</sup> VirnetX notes that Mitel and Siemens have entered into a license agreement with VirnetX and have been dismissed from this case. The only remaining defendant in this case is Avaya.

### III. Lead and Back-Up Counsel and Service Information

In accordance with 37 C.F.R. § 42.8(b)(3) and (b)(4), Patent Owner identifies the following lead and back-up counsel and service information:

Lead Counsel	Back-Up Counsel
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Respectfully submitted,

Dated: July 12, 2013

By: \_\_\_\_\_ /Joseph E. Palys/  
Joseph E. Palys  
Reg. No. 46,508

Counsel for Patent Owner

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