

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW BAY CAPITAL, LLC
Petitioner

v.

VIRNETX, INC.
Patent Owner

Cases IPR2013-00375 (Patent 6,502,135 B1)
IPR2013-00376 (Patent 7,490,151 B2)
IPR2013-00377 (Patent 7,418,504 B2)
IPR2013-00378 (Patent 7,921,211 B2)¹

Before SALLY C. MEDLEY, MICHAEL P. TIERNEY, KARL D. EASTHOM,
and STEPHEN C. SIU, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

¹ This order addresses a similar issue in the four cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style of heading in subsequent papers.

Case and Patent No.

IPR2013-00375 – 6,502,135 B1

IPR2013-00376 – 7,490,151 B2

IPR2013-00377 – 7,418,504 B2

IPR2013-00378 – 7,921,211 B2

On October 29, 2013, a conference call was held between counsel for the respective parties and Judges Medley, Tierney, Easthom and Siu.²

The purpose of the conference call was for New Bay to seek Board authorization to file a motion to terminate the four proceedings. VirnetX does not oppose the filing of the motion.

Counsel for New Bay explained that New Bay is abandoning the contest. Paper 12 at 8 (IPR2013-00375). The Board explained that a motion to terminate making such a representation would be construed as a request for adverse judgment under 37 C.F.R. § 42.73(b)(4). Based on the facts presented, the Board further explained that if the Board grants a motion to terminate, New Bay likely would be estopped from challenging the same VirnetX patents before the Office at a later time under 35 U.S.C. § 325(d). Paper 12 at 10. (*Id.*)

Based on the facts of these proceedings, New Bay is authorized to file four motions to terminate the four proceedings briefly explaining that the motion is unopposed by VirnetX and why termination is appropriate in this case in accordance with the conference call held before the Board. Apple, as a third party, is not authorized to file an opposition to the motions to terminate.

Accordingly, it is

ORDERED that New Bay is authorized to file four motions to terminate the four proceedings;

FURTHER ORDERED that the motions are due November 6, 2013; and

² Counsel for Apple, Inc. in related proceedings IPR2013-00348, -00349, -00354, -00393, -00394, -00397, and -00398 was also on the call. A court reporter was present.

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FURTHER ORDERED that Apple, as a third party, is not authorized to file an opposition to the motions to terminate.

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IPR2013-00377 – 7,418,504 B2

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