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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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APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

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Case IPR2013-00394
Patent 7,418,504

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**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 IPR2013-00393 and IPR2013-00394 ("Apple

IPRs") with IPR2013-00377 ("New Bay IPR").[1] The Apple IPRs and the New

Bay IPR each concern U.S. Patent No. 7,418,504 ("the '504 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. In some of its *inter partes* review petitions, New Bay identified similar

reasons for opposing joinder. *See, e.g.*, 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 '504 patent in *inter partes* reexamination (control no. 95/001,788),

and has previously challenged claims of the '504 patent in district court. Apple

argues that joining its IPRs with the New Bay IPR "will minimize 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 two *inter*

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[1] Apple also asks the Board to join its own IPR2013-00393 and -00394 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.

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

infringement of certain VirnetX patents. Ex. 2001. On April 5, 2011, VirnetX

served Apple with an amended complaint, alleging that certain Apple products

infringe claims 1, 2, 5, 6, 14-23, 26-28, 33-47, 49-52, and 57-60 of the '504 patent.

Ex. 2005 (Second Amended Complaint, *VirnetX Inc. v. Cisco Systems, Inc. et al.*,

No. 6:10-cv-417 (E.D. Tex. Apr. 5, 2011)). A jury found that those products

infringe and that the tried claims of the '504 patent are valid. Ex. 2002.

On October 18, 2011, Apple initiated an *inter partes* reexamination of all

claims 1-60 of the '504 patent. The Office assigned that proceeding control no.

95/001,788 ("the '1,788 reexamination"). On June 25, 2013, the Office issued a

Right of Appeal Notice (Ex. 1071), in response to which VirnetX filed a Notice of

Appeal on July 25, 2013. Briefing for the appeal is currently underway.

On December 31, 2012, VirnetX served Apple with another complaint,

alleging that additional Apple products infringe claims 1, 2, 5, 6, 14-23, 26-28, 33-

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