

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

VIRNETX, INC. AND SCIENCE APPLICATION INTERNATIONAL
CORPORATION,
Patent Owner

Patent No. 7,921,211

Issued: April 5, 2011

Filed: August 17, 2007

Inventors: Victor Larson, *et al.*

Title: AGILE NETWORK PROTOCOL FOR SECURE COMMUNICATIONS
USING SECURE DOMAIN NAMES

Inter Partes Review No. IPR2013-00397

PETITIONER'S MOTION FOR JOINDER OF PROCEEDINGS

Pursuant to the authorization granted by the Panel on August 14, 2013 in Paper No. 7, Petitioner Apple Inc. (“Petitioner” or Apple) moves to have the Board join IPR proceedings IPR2013-00397 & -00398 to each other and with IPR proceeding IPR2013-00378 filed by New Bay Capital, LLC (“NBC”), each of which concerns U.S. Patent No. 7,921,211.

I. Relevant Facts

Apple filed petitions seeking *inter partes* review of the ’211 patent on July 1, 2013. Each petition challenged the patentability of claims 1-3, 5-8 and 14-60 based on three references: Aventail, Provino, and Beser (Exs. 1007-1009). On June 23, 2013, NBC filed its petition challenging the patentability of claims 36, 37, 47, and 51 over one references: Kiuchi (Ex. 1002 in IPR2013-00378). NBC also filed a petition challenging claims 1, 2, 5, 16, 21, and 27 of U.S. Patent No. 7,418,504 (IPR2013-00377). The claims of the ’504 and ’211 patents are effectively identical to each other,¹ and thus, the Board’s decisions on those two petitions will address the patentability of claims 1, 2, 5, 16, 21, 27, 36, 37, 47, and 51 of both the ’504 and ’211 patents.

¹ For example, claims 36 are identical, except the fourth element, in which the bracketed language is swapped: “[supporting an indication that | indicating in response to the query] whether the [DNS] system supports establishing a secure communication link.”

The '211 patent is a member of a family of patents owned by VirnetX that includes U.S. Patent Nos. 6,502,135, 7,490,151, and 7,418,504. The specifications of these patents are nearly identical. VirnetX has asserted varying sets of claims of the '211 and other of its patents against Apple and other entities in numerous lawsuits. In August of 2010, VirnetX sued Apple and five other entities (the “2010 Litigation”). VirnetX asserted “at least” claims 1, 2, 5, 6, 14-23, 26-28, 33-47, 50-52, and 57-60 of the '211 patent against Apple and claims 1, 6, 8, 9, 14-17, 19-23, 26-36, 38-41, 43-47, and 50-60 against co-defendant Cisco. After trial, it obtained a judgment of infringement against Apple on, *inter alia*, claims 36, 37, 47, and 51 of the '211 patent. That action now is on appeal to the Federal Circuit.

On December 31, 2012, VirnetX served a new complaint on Apple asserting infringement of “at least” claims 1, 2, 5, 6, 14-23, 26-28, 33-47, 50-52, and 57-60 of the '211 patent (the “2012 Litigation”). *See* Ex. 1050 at 9-10. When VirnetX served this new complaint on Apple, it established a 12 month period for Apple to submit a petition for *inter partes* review of the '211 patent that runs until December 31, 2013. 35 U.S.C. § 315(b); *see* Petition at 1-3. The new complaint led to a civil action, now pending in the Eastern District of Texas, that will go to trial on October 13, 2015.

VirnetX also asserted the '211 patent against Microsoft in a separate lawsuit filed in April 2013,² and it has asserted it against numerous other defendants in actions filed in 2010 and 2011.³

II. Argument

Apple submits that joinder of the proceedings is fully warranted. *See* IPR2013-00004, Paper 15 at 4; *Dell v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 2-3. Joinder is proper under the statutory design of *inter partes* review, will simplify and reduce the number of issues before the Board and will enable streamlined proceedings (*i.e.*, one coordinated proceeding instead of three separate proceedings). In addition, the Board can manage the joined proceeding in a way that does not impact scheduling or conduct of the proceedings. *See Motorola Mobility LLC v. Softview, LLC*, IPR2013-00256, Paper 10 at 2-3.

² The complaint broadly alleges infringement of the patent without specifying particular claims, and infringement contentions are not due until September 2013.

³ Specifically, VirnetX sued Avaya, Inc.; Mitel Networks Corp.; Mitel Networks, Inc.; Siemens Enterprise Commc'ns GmbH & Co. KG; Siemens Enterprise Commc'ns, Inc.; Siemens AG; Siemens Commc'ns, Inc.; and Siemens Corp. in Case No. 6:11-cv-00018-LED (E.D. Tex.) and Aastra Techs. Limited; Aastra USA, Inc.; Apple Inc.; Cisco Systems, Inc.; NEC Corp.; and NEC Corporation of America in Case No. 6:10-cv-00417-LED (E.D. Tex.).

A. Joinder Is Authorized and Appropriate

The Board is authorized to join these proceedings pursuant to 35 U.S.C. § 315(c). *Dell*, IPR2013-00385, Paper 17 at 2-6. In addition, joinder is not precluded by § 315(b), were that provision found to apply to the instant petitions. *Id.* As Apple explained in its petition, § 315(b) does not preclude the submission of its petition or institution of trial on the basis of this petition. *See* Petition at 1-3.

Joinder will further the statutory purpose of the *inter partes* review authority and is justified in this case. It will enable the Board to efficiently review, in a single proceeding, the patentability of all the claims in the '211 patent that VirnetX has asserted in multiple actions against multiple defendants, including Apple. The schedule of the joined proceedings is also fully compatible with the schedule of the 2012 Litigation. Because that litigation will not go to trial until October 2015, the Board will have ample time to conduct a trial in the joined proceeding and to issue a final written decision before the trial. The joined proceeding will thus provide an alternative forum to efficiently review the patentability of claims being asserted in district court litigation, will reduce the number of issues the district court must address and will minimize any duplication of effort by the Board and the Court. *See* Comments General Trial Rules, 77 Fed. Reg. at 48663. In other words, the Board will be able to issue a decision on the challenged claims that will have a meaningful impact on the 2012 Litigation without causing delay. *See* H.R. Rpt.

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