

Paper No. \_\_\_\_\_  
Filed: August 28, 2013

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 IPR2013-00397  
Patent 7,921,211

---

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

**TABLE OF CONTENTS**

I. INTRODUCTION .....1

II. PRECISE RELIEF REQUESTED .....2

III. STATEMENT OF FACTS .....2

IV. ARGUMENT.....4

    A. Joinder Will Significantly Increase the Complexity and  
    Duration of the New Bay IPR Proceeding and Prejudice  
    VirnetX.....4

    B. Apple Will Not Be Prejudiced if the Board Denies Joinder .....7

    C. Granting Apple's Motion for Joinder Is Statutorily Barred.....7

V. CONCLUSION.....10

**TABLE OF AUTHORITIES**

**Page(s)**

**PATENT TRIAL AND APPEAL BOARD DECISIONS**

*ABB Inc. v. Roy-G-Biv Corp.*,  
IPR2012-00282, Paper 6 (May 30, 2013).....6

*Ariosa Diagnostics v. ISIS Innovation, Ltd.*,  
IPR2012-00022, Paper 35 (May 1, 2013).....6

*Dell, Inc. v. Network-1 Security Solutions, Inc.*,  
IPR2013-00071, Paper 17 (July 29, 2013) .....8, 10

*Dell, Inc. v. Network-1 Security Solutions, Inc.*,  
IPR2013-00385, Paper 17 (July 29, 2013) .....6

*Microsoft Corp. v. Proxyconn, Inc.*,  
IPR2013-00109, Paper 14 (Feb. 25, 2013).....6

*Motorola Mobility LLC v. Softview LLC*,  
IPR2013-00256, Paper 10 (June 20, 2013).....4

*Sony Corp. of America et al. v. Network-1 Security Solutions, Inc.*,  
IPR2013-00386, Paper 16 (July 29, 2013) .....6

**FEDERAL STATUTES**

35 U.S.C. § 311 ..... 4, 8-10

35 U.S.C. § 315 ..... 4, 7-10

**LEGISLATIVE HISTORY**

Meeting of the H. Comm. on Judiciary,  
Transcript of Markup of H.R. 1249 (Apr. 14, 2011).....9

Statement of Senator Kyl,  
154 Cong. Rec. S9982-93 (daily ed. Sep. 27, 2008) .....9

## I. INTRODUCTION

Patent Owner VirnetX Inc. respectfully requests that the Board deny Apple Inc.'s motion requesting joinder of IPR2013-00397 and IPR2013-00398 ("Apple IPRs") with IPR2013-00378 ("New Bay IPR").<sup>1</sup> The Apple IPRs and the New Bay IPR each concern U.S. Patent No. 7,921,211 ("the '211 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 '211 patent in *inter partes* reexamination (control no. 95/001,789), and has previously challenged claims of the '211 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

---

<sup>1</sup> Apple also asks the Board to join its own IPR2013-00397 and -00398 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 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 '211 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 '211 patent are valid. Ex. 2002.

On October 18, 2011, Apple initiated an *inter partes* reexamination of all claims 1-60 of the '211 patent. The Office assigned that proceeding control no. 95/001,789 ("the '1,789 reexamination"). On June 26, 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-

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.