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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2013-00398
Patent 7,921,211

**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 IPR2013-00397 and IPR2013-00398 ("Apple IPRs") with IPR2013-00378 ("New Bay IPR").¹ 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 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*

¹ 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.

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-

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