

Filed on behalf of: RPX Corporation

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION,
Petitioner,

v.

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

Case IPR2014-00171
Patent 6,502,135

JOINT SUBMISSION OF REDACTED DECISION

JOINT SUBMISSION OF REDACTED DECISION

In accordance with the PTAB's instructions in the "Decision – Denial of *Inter Partes* Review" ("the Decision"; Paper No. 49, page 2, footnote 2, entered on June 5, 2014) and on the teleconference on June 10, 2014 (Ex. 1079, p. 15, lns. 8-10), counsel for the Petitioner (RPX), the Patent Owner (VirnetX), and Apple have conferred regarding redactions to the Decision. The attached copy of the Decision contains redactions proposed by Apple and, additionally, a redaction to footnote 2 proposed by RPX.

The undersigned is authorized to submit the attached redacted form of the Decision on behalf of RPX, VirnetX, and Apple. In view of footnote 2 of the Decision, this paper is submitted for access by the "Parties and Board Only" pending the Board's consideration of the proposed redactions and the Board's subsequent issuance of a public decision.

Respectfully submitted,

June 23, 2014

/Oliver R. Ashe, Jr./

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2014-00171 (Patent 6,502,135)
Case IPR2014-00172 (Patent 6,502,135)
Case IPR2014-00173 (Patent 7,490,151)
Case IPR2014-00174 (Patent 7,921,211)
Case IPR2014-00175 (Patent 7,921,211)
Case IPR2014-00176 (Patent 7,418,504)
Case IPR2014-00177 (Patent 7,418,504)

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

EASTHOM, *Administrative Patent Judge*

DECISION¹
Denial of *Inter Partes* Review
37 C.F.R. § 42.108

¹The Board exercises discretion to issue one identical Decision in each case using this caption style. Unless otherwise authorized, the parties are not permitted to use this style.

IPR2014-00171 (Patent 6,502,135); IPR2014-00172 (Patent 6,502,135); IPR2014-00173 (Patent 7,490,151); IPR2014-00174 (Patent 7,921,211); IPR2014-00175 (Patent 7,921,211); IPR2014-00176 (Patent 7,418,504); IPR2014-00177 (Patent 7,418,504)

I. INTRODUCTION²

Petitioner, RPX Corporation (“RPX”), filed Petitions in the above-listed cases. Patent Owner, Virnetx Inc. (“Virnetx”), submitted Preliminary Responses. Because the dispositive issues are similar, we treat IPR2014-00171 (“the ’171 proceeding”) as representative of the seven proceedings, which involve four Virnetx patents: U.S. Patent No. 6,502,135; U.S. Patent No. 7,490,151; U.S. Patent No. 7,921,211; and U.S. Patent No. 7,418,504 (“the Virnetx Patents”).

The seven proceedings involving the Virnetx Patents, challenged under 35 U.S.C. §§ 311–319, are summarized in the following table:

Proceeding	Claims	Virnetx Patents
IPR2014-00171	1–10, 12–15, and 18	6,502,135
IPR2014-00172	1–10, 12–15, and 18	6,502,135
IPR2014-00173	1–16	7,490,151
IPR2014-00174	1, 2, 5, 6, 8, 14, 17, 19, 20, 23, 27–30, 33, 34, 36, 47, 51, and 60	7,921,211
IPR2014-00175	1, 3, 15–18, 20–26, 31, 32, 35, 36, 37, 47, 51, and 60	7,921,211
IPR2014-00176	1, 2, 5, 6, 8, 14, 16, 17, 19, 20, 21, 23, 27–30, 33, 34, 36, 47, 51, and 60	7,418,504
IPR2014-00177	1, 2, 3, 5, 15–18, 20–27, 31, 32, 35, 36, 47, 51, and 60	7,418,504

As the table reflects, in the ’171 proceeding, RPX filed a Petition requesting *inter partes* review of claims 1–10, 12–15, and 18 of U.S. Patent

²

After receiving the Decision, the parties jointly may request a redacted version of the Decision. After consideration of the joint request, or, if no request is filed, the Board will issue a subsequent public Decision.

IPR2014-00171 (Patent 6,502,135); IPR2014-00172 (Patent 6,502,135); IPR2014-00173 (Patent 7,490,151); IPR2014-00174 (Patent 7,921,211); IPR2014-00175 (Patent 7,921,211); IPR2014-00176 (Patent 7,418,504); IPR2014-00177 (Patent 7,418,504)

No. 6,502,135 (“the ’135 Patent”). *See* Paper 1 (“Pet.”).³ Virnetx submitted a Preliminary Response under 37 C.F.R. § 42.107(b). Paper 35 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314. We determine that Apple Inc. (“Apple”) is a real-party-in interest.⁴ We deny the Petitions because the Petitions are time-barred. Contrary to the requirements of 35 U.S.C. § 315(b), the Petitions were “filed more than 1 year after the date on which the . . . real party in interest[, Apple,] . . . [wa]s served with a complaint alleging infringement of the patent.” Therefore, according to 35 U.S.C. § 315(b), “[a]n inter partes review may not be instituted.”

For an analysis of the time bar issue pursuant to 35 U.S.C. § 315(b), we refer to, and incorporate by reference, the Board’s previous decisions holding that earlier petitions filed by Apple, a real party-in-interest in those proceedings challenging the Virnetx Patents, were time-barred.⁵ As Apple is a real party-in-interest in the instant proceedings, the Petitions are time-

³ Record citations refer to the representative ’171 proceeding.

⁴ The Petitions do not list Apple, as 35 U.S.C. § 312(a)(2) requires: “A petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest.”

⁵ *See Apple Inc. v. Virnetx, Inc.*, IPR2013-00348 (PTAB Dec. 13, 2014) (denying *Inter Partes* Review of U.S. Patent No. 6,502,135), *reh’g denied*, (PTAB Feb. 12, 2014); IPR2013-00349 (same, Patent 7,490,151); IPR2013-00354 (same, Patent 7,490,151); IPR2013-00393 (same, Patent 7,418,504); IPR2013-00394 (same, Patent 7,418,504); IPR2013-00397 (same, Patent 7,921,211); IPR2013-00398 (same, Patent 7,921,211). In the latter four cases, the decisions were entered on December 18, 2013, although the rehearing decisions were entered on the same date in all the cases, February 12, 2014.

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