

Paper No. _____
Filed: February 11, 2014

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

RPX CORPORATION
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2014-00172
Patent 6,502,135

Patent Owner's Response to Board's Order Regarding Discovery



I. Introduction

In accordance with the Board's order during the February 7, 2014, teleconference, and Order entered on February 10, 2014 (Paper No. 23) (collectively referred to herein as "Board's Order"), VirnetX, RPX, and Apple conferred regarding VirnetX's discovery contained in Exhibits 2002-2005. Although the parties were able to reach agreement with respect to certain issues, the parties were not able to completely resolve all the issues. This paper describes the agreement the parties were able to reach, discovery that VirnetX continues to seek, and other related issues discussed by the parties.

II. Agreement Between the Parties

The parties agreed that RPX will respond to the following requests for production that were contained in Exhibit 2002, and RPX will produce the documents under seal in accordance with the provisions of the Default Protective Order. The parties also agreed that production of agreements in response to request (b) below shall not constitute waiver of any privilege with respect to those agreements.

Requests for Production to RPX



(b) Engagement agreements or retainer agreements and corresponding termination agreements between RPX and Sidley Austin relating to the RPX IPRs.

Other Agreement

In addition, to reduce redundancy, the parties agreed that in response to requests for production to Apple, Apple would not need to produce any documents that have been already produced by RPX. Accordingly, VirnetX has modified its discovery requests to Apple appropriately. *See* Section III.

III. Revised Discovery Sought By VirnetX

The parties discussed VirnetX's remaining requests and were not able to reach an agreement. In accordance with the Board's Order regarding the scope of discovery that the Board will allow, VirnetX has narrowed the discovery it is seeking.¹ First, VirnetX withdraws Request for Production No. 5 and Interrogatory Nos. 2 and 4 directed to RPX, and Request for Production No. 3 directed to Apple. Second, VirnetX requests that the Board order RPX and Apple to provide the following discovery, which has been narrowed. VirnetX's original instructions and definitions contained in Exhibits 2002-2005 would apply to these requests.

¹ VirnetX continues to believe that the discovery contained in Exhibits 2002-2005 is proper and in the interests of justice. Nonetheless, VirnetX has narrowed the discovery it seeks in accordance with the Board's Order.

Requests for Production to RPX

(a) Communications between you and Apple regarding the RPX IPRs, including communications relating to challenging U.S. Patent Nos. 6,502,135; 7,418,504; 7,490,151; and 7,921,211 at the United States Patent and Trademark Office and assistance with, filing, and/or preparation of any papers related to the RPX IPRs. Please note that in response to this request, you do not need to produce any communications that include VirnetX or its counsel.

(b) Communications through November 22, 2013 (the date of filing of corrected petitions in IPR2014-00176 and -00177) between you and Apple

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatories to RPX

(a) Identify communications and/or agreements called for in the Requests for Production to RPX that were not reduced to writing.

(b) Identify communications through January 16, 2014 (the date the Board authorized VirnetX to file a motion for additional discovery) between you and Sidley Austin regarding the RPX IPRs, including communications relating to the challenging of U.S. Patent Nos. 6,502,135; 7,418,504; 7,490,151; and 7,921,211 at the United States Patent and Trademark Office and assistance with, filing, and/or

[REDACTED]

preparation of any papers related to the RPX IPRs. Please note that in response to this interrogatory, you do not need to identify any communications that include VirnetX or its counsel.

Requests for Production to Apple

(a) Communications between you and RPX or Sidley Austin regarding the RPX IPRs (other than those produced by RPX), including communications relating to assisting with, filing, and/or preparing any papers related to the RPX IPRs. For the communications between Apple and Sidley Austin, VirnetX only seeks communications through the alleged termination date of Sidley Austin's representation of RPX.

(b) Communications through November 22, 2013 (the date of filing of corrected petitions in IPR2014-00176 and -00177) between you and RPX

[REDACTED]

[REDACTED]

[REDACTED]

Deposition Topic to Apple

Communications in the Requests for Production to Apple that were not reduced to writing, including identifying those communications.

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.