

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 IPR2014-00173

Patent 7,490,151

---

**Patent Owner's Motion for Discovery  
from RPX Corporation and Apple, Inc.**



**Table of Contents**

I. Precise Relief Requested .....1

II. Factual Background .....1

III. Reasons for the Relief Requested.....3

IV. Conclusion .....7

**Table of Authorities**

Statutes

35 U.S.C. § 312(a)(2).....3, 6

35 U.S.C. § 315(b) .....3, 6

35 U.S.C. § 316(a)(5).....3

Rules

37 C.F.R. § 42.51(b)(2).....1

37 C.F.R. § 42.52(a).....1

Cases

*Asahi Glass Co. v. Toledo Eng’g Co.*, 505 F. Supp. 2d 423  
(N.D. Ohio 2007) .....5

*In re Echostar Comms. Corp.*, 448 F.3d 1294, 1301 (Fed. Cir. 2006).....5

*Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26  
(P.T.A.B. March 5, 2013) .....3, 7

*In re Guan*, Control No. 95/001,045, Decision Vacating Filing Date  
(USPTO Aug. 25, 2008) .....4

*Phelps v. Hamilton*, 122 F.3d 1309 (10th Cir. 1997) .....5

Other

“Office Patent Trial Practice Guide,” 77 Federal Register 157  
(Aug. 14, 2012), pp. 48756-773 .....4, 6

**I. Precise Relief Requested**

VirnetX requests that the Board authorize the discovery from RPX and Apple contained in Exhibits 2002-2005. *See* 37 C.F.R. §§ 42.51(b)(2), 42.52(a).

**II. Factual Background**

RPX provides defensive patent services to its clients. It acts “as an extension of a client’s in-house legal team” and “as a trusted intermediary,” and when litigation arises, “selectively clear[s its] clients from the suit.” (Exs. 2006, 2007 at 3, 2008.) To fund these services, RPX collects fees from its clients. (Ex. 2007 at 9.) [REDACTED] (Ex. 1073 at 1.) [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

(*Id.* at 1-2; *see also* Ex. 2001 at 64:15-18.)

[REDACTED], RPX petitioned for IPR of four VirnetX patents Apple was found to infringe. (Ex. 2009.) RPX contends the grounds in its petitions are “substantially identical” to the time-barred, non-instituted Apple petitions. (Pet. at 6; Exs. 2010-2016.) But this is not an instance where the petitions were merely copied or modified from the public record. [REDACTED]

[REDACTED]

[REDACTED] (Ex. 2001 at 7:11-18; Ex. 1074 at 8:1-5, 25:13-14.) RPX also obtained access to Apple's alleged expert, Michael Fratto, who submitted declarations with the Apple and RPX petitions. (*See, e.g.*, Exs. 1003 and 2017.)

RPX has also advanced Apple's interests in these proceedings. Shortly after the RPX petitions were filed, it came to light that the petitions neglected to challenge three claims Apple was found to infringe. Over the next two days, corrected petitions were filed solely to add new challenges to the infringed claims, much to Apple's benefit. (*See* Ex. 2009; Ex. 1074 at 16:15-17:11.) RPX also requested that these proceedings be expedited, but RPX makes no products that could infringe VirnetX's patents. The urgency must be so RPX can "selectively clear" Apple from its suit with VirnetX.

[REDACTED], throughout these proceedings, they have attempted to give the impression they are operating independently to avoid real-party-in-interest ("RPI") and privity issues. For example, RPX and Apple took care not to share with the Board the relationship between RPX and Apple's counsel. (*See* Ex. 2001 at 69:6-71:4, demonstrating how both Apple and RPX refused to answer the Board's question about whether Apple had provided any assistance regarding the RPX petitions.) It was not until VirnetX mentioned the metadata in the RPX petitions (Ex. 2001 at 71:11-22), which demonstrates that Apple's counsel was involved with the RPX petitions (Ex. 1074 at 13:12-18:11),

# 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.