Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX, INC.

Petitioner,
v.

VIRNETX, INC. AND SCIENCE APPLICATION INTERNATIONAL CORPORATION,

Patent Owner

Patent No. 7,490,151
Issued: Feb. 10, 2009
Filed: Sep. 30, 2002
Inventors: Edmund C. Munger, *et al*
Title: Establishment of a Secure Communication Link Based Domain Name Service (DNS) Request

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Inter Partes Review No. IPR2014-00173

THIRD PARTY APPLE'S PROPOSAL CONCERNING THIRD PARTY DISCOVERY

Apple Inc. makes the following proposal concerning discovery in IPR2013-00171 to IPR2013-00177. Pursuant to the Panel's mandate, Apple met and conferred with VirnetX and RPX in an attempt to reach an agreement on discovery. Apple and RPX each made proposals in those discussions, but those proposals were not accepted by VirnetX. Apple believes certain principles have, however, been agreed upon by the three parties, namely: (i) that provision of a witness for deposition would obviate the need for interrogatories on the same topic; (ii) that Apple would only be required to produce responsive documents that were not independently produced by RPX, (iii) that parties are not be required to produce privileged documents or information, and (iv) that any production made responsive to the discovery would not constitute a waiver of privilege.

Apple's proposed discovery is focused on the issues directly relevant to VirnetX's theory of privity and or real parties in interest. As this Board has noted, those theories revolve around the question of whether Apple was in control of RPX's decision to file the IPRs at issue and the substance and parameters of the RPX IPRs. For evidence to be relevant under VirnetX's theory, that evidence necessarily must concern communications that *actually occurred* between Apple and RPX. The discovery proposed below would provide documents or information concerning any relevant communications that actually occurred between Apple and RPX, including both direct communications between Apple employees and RPX

employees and between agents of Apple or RPX. The proposed discovery excludes communications between Apple and its counsel (in-house or external) that were never conveyed to RPX. Such communications are privileged and are ultimately irrelevant to the question of control, as they could not have an effect on the conduct of RPX.

There also is a logical date boundary for any discovery; namely, the date on which the last amended RPX IPR petition was filed (i.e., November 22, 2013). Communications occurring after that date cannot under any reasonable theory be portrayed as influencing the decision of RPX *to file* its IPRs or *to affect the preparation* of those IPRs. VirnetX nonetheless contends it is entitled to discovery without regard to date. But as VirnetX must recognize, Apple and RPX have been forced to communicate about the RPX IPRs in order to respond to the discovery issues VirnetX has raised. Apple thus invites the Board to place an appropriate limitation on any discovery it orders (e.g., communications on or before November 22, 2013 or excluding any discovery concerning scheduling or discovery issues at issue in the proceedings following the filing of the RPX IPRs).

PROPOSED INSTRUCTIONS

1. In responding to and producing documents and things responsive to these requests, the responding party will comply with instructions in the Patent Trial Practice Guide.

2. A responding party shall timely amend its responses if it learns that the response is incomplete or additional responsive information is found.

3. All responsive documents must be produced as they are kept in the usual course of business, in the files or containers in which the responsive documents are maintained, and in the order within each file or container in which such documents are maintained; or all responsive documents shall be organized and labeled to correspond with the requests below.

DEFINITIONS AND CONDITIONS

1. The terms "document" and "thing" have the broadest meaning prescribed in Federal Rule of Civil Procedure 34, including ESI and any physical specimen or tangible item, in your possession, custody, or control.

2. "Communications" shall mean the transmission or receipt of information of any kind through any means (e.g., email, voicemail, audio, computer readable media or oral).

3. The term "RPX" means RPX Corporation, an employee of RPX Corporation or a person acting as an agent of RPX Corporation within the scope of that agency.

4. The term "Apple" means Apple Inc., an employee of Apple Inc. or a person acting as an agent of Apple Inc. within the scope of that agency.

5. "Sidley Austin" means Sidley Austin LLP or an employee or partner of Sidley Austin LLP.

6. "RPX IPRs" means *inter partes* review Case Nos. IPR2014-00171, IPR2014-00172, IPR2014-00173, IPR2014-00174, IPR2014-00175, IPR2014-00176, and IPR2014-00177.

7. A party is not required to produce documents, things or information subject to a claim of privilege, including attorney work product. A party withholding responsive documents on the basis of privilege shall provide a privilege log identifying the responsive documents or information being withheld.

8. The production of responsive documents or information shall not constitute an express or implied waiver of any privilege held by the producing party.

I. REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS AND INTERROGATORY

REQUEST FOR PRODUCTION NO. 1

Documents or things containing communications between Apple and RPX regarding the preparation or filing of the RPX IPRs to the extent such responsive documents are not otherwise produced by RPX.[1]

[1] Apple proposes to produce any responsive documents and to provide its response to the interrogatory 3 business days after the date of service of any production of documents or information is served on the other parties by RPX. This will enable review of the RPX produced documents to identify any other documents or information required to be produced or identified.

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