

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RPX CORPORATION  
Petitioner,

v.

VIRNETX INC.  
Patent Owner.

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Case IPR2014-000171 (Patent 6,502,135)  
Case IPR2014-000172 (Patent 6,502,135)  
Case IPR2014-000173 (Patent 7,490,151)  
Case IPR2014-000174 (Patent 7,921,211)  
Case IPR2014-000175 (Patent 7,921,211)  
Case IPR2014-000176 (Patent 7,418,504)  
Case IPR2014-00177 (Patent 7,418,504)<sup>1</sup>

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

TIERNEY, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5*

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<sup>1</sup> This decision addresses an issue that is identical in each case. We, therefore, exercise our discretion to issue one Order to be filed in each case. Unless otherwise authorized, the parties, however, are not authorized to use this style heading for any subsequent papers.

Case IPR2014-000171 (Patent 6,502,135); Case IPR2014-000172 (Patent 6,502,135); Case IPR2014-000173 (Patent 7,490,151); Case IPR2014-000174 (Patent 7,921,211); Case IPR2014-000175 (Patent 7,921,211); Case IPR2014-000176 (Patent 7,418,504); Case IPR2014-00177 (Patent 7,418,504)

Conference calls were held on January 8, 10 and 16, 2014, involving Administrative Patent Judges Tierney, Siu and Easthom and representatives from Apple, RPX and Virnetx.<sup>2</sup> The purpose of the calls was to discuss scheduling and concerns regarding identification of real party in interest and privies. A court reporter was present on the calls.<sup>3</sup>

## 1. Scheduling

RPX filed its involved petitions challenging Virnetx's patents on November 20, 2013. Apple filed on December 6, 2013, its petitions challenging a Virnetx patent, which claims 35 U.S.C. § 120 benefit of at least two of the RPX challenged patents.

The Board inquired as to whether the time for filing a patent owner preliminary response should be the same for both the RPX and Apple *inter partes* reviews. Based on the information provided by the parties, the Board concluded that the issues raised in the RPX petitions overlapped those raised in previously filed petitions and, further, that the issues raised in the RPX petitions overlapped those raised in the Apple petitions. Accordingly, the Board held that the time for filing patent owner preliminary responses in both the RPX and Apple proceedings is set for March 6, 2014.

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<sup>2</sup> Although Apple and RPX filed separate petitions, based on the nature of the issues raised by the petitions, the Board exercised its discretion and held a joint conference call.

<sup>3</sup> This Order summarizes statements made during the conference call. A more complete record may be found in the transcripts, which may be found in the record, e.g., IPR2014-00171, Exs. 1075, 1076 and 1077.

Case IPR2014-000171 (Patent 6,502,135); Case IPR2014-000172 (Patent 6,502,135); Case IPR2014-000173 (Patent 7,490,151); Case IPR2014-000174 (Patent 7,921,211); Case IPR2014-000175 (Patent 7,921,211); Case IPR2014-000176 (Patent 7,418,504); Case IPR2014-00177 (Patent 7,418,504)

## 2. Discovery

Virnetx raised concerns regarding the proper identification of the real parties in interest in the RPX petitions. Specifically, Virnetx contends that there exists a real party in interest issue and/or privity relationship between RPX and Apple that impacts the RPX proceedings. Virnetx requests additional discovery to further investigate the relationship between RPX and Apple as Virnetx believes that the issue may be case dispositive.

Based upon the information provided over the course of the three conference calls, the Board authorized Virnetx to file a motion for additional discovery. The motion is due no later than January 27, 2014, and Apple and RPX are authorized to file oppositions by no later than February 3, 2014. As the issues were discussed extensively during the calls, the Board limited the motions and oppositions to no more than seven (7) pages each.

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