

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.
Petitioner,

v.

VIRNETX INC.
Patent Owner.

Case IPR2014-000237 (Patent 8,504,697)
Case IPR2014-000238 (Patent 8,504,697)¹

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

TIERNEY, *Administrative Patent Judge.*

Decision
Scope of Discovery
37 C.F.R. § 42.5²

¹ 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.

² This Order is identical in substance to Order (Paper 22), which was entered in RPX proceeding IPR2014-00171. This Order is entered into the Apple proceedings given the nature of the issues discussed herein.

As stated during a February 7, 2014 conference call, the Board reviewed VirnetX's motion in the RPX proceedings for discovery and oppositions thereto. Based upon the specific facts of this proceeding, the Board determined that VirnetX had demonstrated that it is in the interests of justice that at least some discovery be permitted on the issue of control of the proceeding. To aid the Board in determining the scope of discovery to be permitted, the Board authorized the parties to file briefs by no later than February 11, 2014 where the briefs identified the scope of discovery to be permitted on the issue of control of the proceeding as it relates to questions of real party in interest and privity.

The parties have submitted their briefs and the Board concludes that the scope of discovery identified in the Apple proposal is best calibrated to produce useful evidence relevant to VirnetX's theory of privity and real-parties-in-interest. The Board orders (1) RPX to produce the information and response to the interrogatory identified in the Apple proposal within five business days of the entry this decision, and (2) Apple to produce any responsive documents and its response to the interrogatory three business days after the date of service by RPX of responsive documents or information. No deposition is authorized of any witness at this time.

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