

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

VIRNETX INC.
Patent Owner.

Case IPR2014-00237 (Patent 8,504,697)
Case IPR2014-00238 (Patent 8,504,697)¹

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

TIERNEY, *Administrative Patent Judge.*

Decision
Virnetx's Request for Rehearing
37 C.F.R. § 42.71

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.

Virnetx Inc. (“Virnetx”) requests rehearing of the Board decision (Paper 15),² which institutes an *inter partes* review on U.S. Patent 8,504,697. Paper 19, “Req.” In its request for rehearing, Virnetx contends that the Board failed to appreciate that Apple’s Petition contravened 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.104(b)(4) and that the trial should not be instituted.

A conference call was held on May 29, 2014, during which the request for rehearing was **denied**. As explained in during the conference call, the Board had reviewed Apple’s Petition and found it sufficient to meet the statutory and regulatory requirements necessary for institution.

In *inter partes* review, 35 U.S.C. § 312(a)(3) requires a petition identify each claim challenged, the grounds on which the challenge to each claim is based and the evidence that supports the grounds for the challenge to each claim. The Petition contains a table of contents, which has a heading “Precise Reasons for Relief Requested.” Under this heading, Apple identified claims 1-11, 14-25 and 28-30 as anticipated by Beser and claims 1-11, 14-25 and 28-30 as obvious over Beser in view of RFC 2401. Accordingly, the Board holds that the table of contents, by and of itself, identifies each challenged claim, the grounds on which the challenge is based and the evidence that supports the grounds for the challenge to each claim.

Additionally, 37 C.F.R. § 42.104(b)(4) requires a petition to identify how a construed claim is unpatentable by specifying where each element of the claim is found in the prior art patents or publications relied upon. The Petition provided a discussion of each element of the claim and citations to an expert declaration, which in turn provided citations to where each element of the claim could be found in the prior art relied upon. Apple’s Petition is not a model of clarity, but on the

² Citations are provided to IPR2014-00237.

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specific facts of this case, we hold that Apple's Petition meets the requirements of § 42.104(b)(4), albeit minimally. Additionally, even if the Petition failed to meet the requirements of § 42.104(b)(4), we would exercise our discretion under §42.5(b) and waive the rule as the Petition provides sufficient notice of the challenge to each identified claim.

Virnetx's request for rehearing is *denied*.

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