

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP. and APPLE INC.,
Petitioner,

v.

VIRNETX INC.,
Patent Owner.

Case IPR2014-00404¹
Patent 7,987,274 B2

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

EASTHOM, *Administrative Patent Judge.*

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

¹ Case IPR2014-00483 has been joined with Case IPR2014-00403

I. BACKGROUND

VirnetX, Inc. (“Patent Owner”), in its Request for Rehearing (“Req.” or “Request”), seeks reversal of the Board’s decision in IPR2014-00483 to institute an *inter partes* review of claims 1–5, 7, 8, 10, 12, 15, and 17 of U.S. Patent 7,987,274 B2 (“the ’274 Patent,” Ex. 1001) and to join IPR2014-00483 with the instant proceeding. *See* Paper 22, 1 (“Req. Reh’g.”). For the reasons that follow, the Board denies the requested relief.

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

II. DISCUSSION

Patent Owner argues “that Apple’s petition relies heavily on an expert declaration that makes no mention of the ’274 patent or how Provino applies to the ’274 Patent.” Req. Reh’g 4–5. Patent Owner also maintains that the Board abused its discretion because it “incorporate[d]” its analysis from IPR2014-00403, and the Board prejudiced Patent Owner by joining the two proceedings. *Id.* at 4.

Patent Owner has not shown an abuse of discretion or an overlooked material point. The declarant in the ’483 IPR discusses Provino at length, Ex. 1011 ¶¶ 26–39, discusses the grandparent application to the ’274 patent, *id.* ¶¶ 11–25 (grandparent U.S. Patent No. 7,188,180), and also describes how Provino discloses an “access request message[],” which claim 1 of the ’274 Patent recites. Ex. 1011

¶ 40. Patent Owner does not allege that the grandparent patent specification discussed by the declarant in the '484 IPR materially differs from the '274 Patent Specification.

In addition, Petitioner proposes grounds of unpatentability for claims 1–4, 7, 8, 10, 12, 15, and 17 as anticipated by Provino, and includes claim charts mapping specific citations of Provino to claim limitations recited in the '274 patent. *See, e.g.,* '483 IPR, Pet. 17–33. Petitioner provides similar arguments with respect to Provino in combination with other references. *See, e.g.,* Pet. 34–40. Patent Owner does not explain persuasively how we overlooked a point in '483 IPR Petition that would render institution and joinder deficient.

Patent Owner also argues that the Petition in the '483 IPR is defective as lacking “explanation and particularity required by 35 U.S.C. §§ 312(a)(3)-(4) and 37 C.F.R. §§ 42.104(b)(4)-(5).” Req. Reh’g 5. However, Patent Owner does not specify a claim element missing from the showing. Patent Owner maintains that “Apple at least fails to explain why Provino’s discussion of ‘generating message packets’ allegedly discloses the ‘access request message’ of claim 1.” *Id.* at 7. Patent Owner similarly alleges that that “none of these issues was addressed in the Board’s Decision instituting Apple’s petition.” Req. Reh’g. 8. Contrary to Patent Owner’s contentions, as noted above, the declarant in the '483 IPR discusses the claim element. '483 IPR, Ex. 1011 ¶ 40. Petitioner Apple and Microsoft each rely on Provino as disclosing the element. '483 IPR Pet. 36; '403 IPR, Pet. 37–39. The 'IPR 483 Institution Decision addresses it by incorporating the “previous analysis” from the '403 Institution Decision. *See* '403 IPR, Paper 13, 16–17; '483 IPR, Paper 6, 6.

Patent Owner also argues that our incorporation of the '403 IPR Institution Decision into the '483 IPR analysis is improper because “Apple’s contentions

regarding Provino are different than Microsoft's contentions at least because Apple's contentions are supported by a different expert declaration for a different patent." Req. Reh'g 9. Patent Owner also argues that joinder would be prejudicial because Patent Owner would need to "address two different expert declarations." *Id.* at 11–12. Patent Owner does not point out material differences between the two declarations, which involve the same declarant, the same or similar specification, and the same prior art to Provino. Patent Owner also does not explain persuasively how a "different" declaration by the same expert covering the same or similar specification and prior art would amount to prejudice in one joined proceeding as compared to two separate proceedings.

III. CONCLUSION

Based on the foregoing discussion, Patent Owner's requested relief for a reversal of the decision to join Apple and institute an *inter partes* review is denied because Patent Owner has not shown an overlooked or misapprehended material point.

IV. ORDER

For the reasons given, it is

ORDERED that the Request for Rehearing is denied.

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