

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

VIRNETX, INC. AND SCIENCE APPLICATION INTERNATIONAL

CORPORATION,

Patent Owner

Patent No. 8,051,181

Issued: November 1, 2011

Filed: February 27, 2007

Inventors: Victor Larson, *et al.*

Title: Method for establishing secure communication link between computers of
virtual private network

Inter Partes Review No. IPR2014-00485 and -00486

PETITIONER'S MOTION FOR JOINDER

I. INTRODUCTION

Six petitions filed separately by Apple Inc. and Microsoft Corp. against two very closely related patents raise a set of overlapping issues that are most efficiently addressed in one *inter partes* review proceeding. By this motion, Apple requests that its petitions regarding U.S. Patent No. 8,051,181 (the '181 patent) and U.S. Patent No. 7,987,274 (the '274 patent) be considered concurrently with Microsoft's petitions regarding the '274 patent, and moves to join any proceedings based on these petitions in a single proceeding.¹

Joinder is justified because it will enable the Office to efficiently and in a timely certain dispose of common issues of patentability affecting sets of patent claims that Patent Owner has admitted are not patentably distinct. Specifically, during examination of the '181 and '274 patents, the Office rejected claims in each patent as being unpatentable over claims in the other. SOF ¶¶ 9, 13. Patent Owner did not dispute the merits of these double patenting findings, but instead acquiesced by filing terminal disclaimers of each patent over the other.² SOF ¶¶ 6,

¹ IPR2013-00485 and -00486 were filed by Apple on the '181 patent, IPR2014-00483 and 00484 were filed by Apple on the '274 patent, and IPR2014-00403 and -00404 were filed by Microsoft on the '274 patent.

² Patent Owner also acquiesced to double patenting rejections of the '181 patent claims over U.S. Patent No. 7,188,180 (the '180 patent) by filing a terminal

Motion for Joinder in IPR2014-00485 & -00486

8, 11-12, 16-17. Patent Owner thus admitted the '181 and '274 patent claims are not patentably distinct.

Joinder is clearly justified given the interdependence of the patentability of the claims in the '181 and '274 patents. In addition, joinder is warranted in view of the substantial degree of commonality of issues presented in IPR2014-00483, -00484, -00485 and -00486 relative to IPR2014-00403 and -00404. For example, the petitions rely on substantially the same primary references and advance substantially similar grounds of unpatentability for the '181 and '274 patents.

Joinder also is warranted because it will enable *inter partes* review of the '181 patent claims alongside the patentably indistinct '274 patent claims. Although the '181 patent was asserted in an action for infringement more than one year before the date petitions in IPR2014-00485 and -00486 were filed, the Board is authorized to conduct *inter partes* review on the basis of these petitions as they are accompanied by a motion for joinder. *See* 35 U.S.C. § 315(b). Granting the present joinder motion will further the statutory purpose of the *inter partes* review system, as it will reduce the number of issues the district court in related litigation involving the '181 patent must resolve at trial (now scheduled for October 2015).

Other factors relevant to joinder favor granting this motion, including: (i) the same schedule for various proceedings can be adopted, (ii) discovery can be

disclaimer linking the '181 patent to the '180 patent. SOF ¶¶ 7, 10, 13.

coordinated to minimize burdens on the parties and witnesses, and (iii) joinder will not materially affect the range of issues needing to be addressed by the Board and by the parties in the joined proceedings. Because all these factors support joining these proceedings, Petitioner requests the Board to grant this motion for joinder.

II. STATEMENT OF MATERIAL FACTS

1. U.S. Patent No. 8,051,181 (the '181 patent) issued on November 1, 2011 from U.S. Application No. 11/679,416 (the '416 application). Ex. 1025.

2. U.S. Patent No. 7,987,274 (the '274 patent) issued on July 26, 2011 from U.S. Application No. 11/839,987 (the '987 application). Ex. 1027.

3. U.S. Patent No. 7,188,180 (the '180 patent) issued on March 6, 2007 from U.S. Application No. 10/702,486 (the '486 application). Ex. 1001.

4. The '181 and '274 patents each claim benefit, *inter alia*, to the '180 patent (*i.e.*, to the '486 application), and to earlier filed applications to which the '180 patent claims benefit, including, *inter alia*, U.S. Application No. 09/504,783 filed on February 15, 2000. *See* Exs. 1001, 1025 & 1027.

5. The '180, '274 and '181 patents have a nearly identical disclosure. *Id.*

6. The '181 patent is terminally disclaimed over the '274 patent. Ex. 1026 at 797, 1045.

7. The '181 patent is terminally disclaimed over the '180 patent. Ex. 1026 at 795, 1045.

8. The '274 patent is terminally disclaimed over the '181 patent. Ex. 1028 at 634, 2741.

9. On April 8, 2010, claims 2, 24, 26 and 28-30 of the '416 application (later issuing as claims 2, 24, 26, 28, 29 and 1, respectively of the '181 patent) were rejected for obviousness-type double patenting over claim 1 of the '987 application (which later issued as claim 1 of the '274 patent). Ex. 1026 at 783-785.

10. Also on April 8, 2010, claims 2, 24, 26 and 28-30 of the '416 application (later issuing as claims 2, 24, 26, 28, 29 and 1, respectively of the '181 patent) were rejected for obviousness-type double patenting over claim 1 of the '180 patent. Ex. 1026 at 783-785.

11. On October 8, 2010, in its response to the two double patenting rejections, Patent Owner did not dispute the merits of either finding of obviousness-type double patenting. Instead, Patent Owner argued the rejections should be withdrawn because it had terminally disclaimed the '181 patent over each of the '274 and '180 patents. Ex. 1026 at 799, 805-816.

12. Also on October 8, 2010, Patent Owner filed terminal disclaimers in the '181 patent relative to each of the '180 and '274 patents. Ex. 1026 at 795 (regarding the '180 patent) and at 797 (regarding the '987 application later issued as the '274 patent). The terminal disclaimer form used by Patent Owner in both instances was entitled "Terminal Disclaimer to Obviate a Double Patenting

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