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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

Case No. IPR2015-00185
U.S. Patent No. 7,921,211

PATENT OWNER'S OPPOSITION TO APPLE'S MOTION FOR JOINDER

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I. INTRODUCTION

For the third time, Apple has been responsible for filing a series of petitions for *inter partes* review of U.S. Patent No. 7,921,211 ("the '211 patent"). Its first two petitions, in IPR2013-00397 and IPR2013-00398, were denied as untimely under 35 U.S.C. § 315(b). Apple had RPX Corporation file its next two petitions in IPR2014-0174 and IPR2014-00175, but those were also dismissed as untimely. Apple then filed two more petitions, those in this proceeding, IPR2015-00185 ("the '185 proceeding"), and IPR2015-00186 ("the '186 proceeding"). This time Apple accompanied its petitions with motions for joinder with consolidated IPR2014-00615 and IPR2014-00618 (collectively, "the '615 proceeding"), filed by Microsoft. Apple's repeated filings and its requests for joinder are an attempt to evade the time bar of § 315(b) and should be rejected. Not only does the plain language of § 315(b) require this result, § 315(c) and Congress's express intent to avoid serial harassment of patent owners confirms it. In addition, Apple's petition includes a new ground that was not presented nor considered in the '615 proceeding. Thus, Patent Owner VirnetX respectfully requests that the Board deny Apple's motion requesting joinder of the '185 proceeding with the '615 proceeding.

II. PRECISE RELIEF REQUESTED

VirnetX requests that the Board deny Apple's motion for joinder ("Mot.").

III. STATEMENT OF FACTS

On April 5, 2011, VirnetX served Apple with a complaint alleging infringement of the '211 patent and other VirnetX patents. (Ex. 2001, VirnetX Inc.'s Second Amended Complaint in *VirnetX Inc. v. Cisco Sys., Inc. et al.*, Case No. 6:10-cv-00417 (E.D. Tex. Apr. 5, 2011) ("the '417 litigation").) In response, Apple alleged, among other things, noninfringement, invalidity, and unenforceability of the '211 patent. (Ex. 2002, Apple's Answer in the '417 Litigation at ¶¶ 37, 54-57, 122-123, counterclaim ¶¶ 6-10, 14-15, 45-46 (E.D. Tex. April 16, 2012).) Prior to trial, Apple also requested *inter partes* reexamination of the '211 patent. The proceeding was assigned Control No. 95/001,789 ("the '1,789 reexamination") and is ongoing.

Following a five day trial, the district court upheld the validity of the '211 patent. (Ex. 2003, Jury Verdict Form in the '417 litigation (E.D. Tex. Nov. 6, 2012); Ex. 2004, Final Judgment in the '417 litigation (E.D. Tex. Feb. 28, 2013).) Apple appealed to the U.S. Court of Appeals for the Federal Circuit, which affirmed that "none of the asserted claims are invalid[.]" *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F. 3d 1308, 1313-14 (Fed. Cir. 2014).

After trial, in November 2012, VirnetX served Apple with a related complaint involving the '211 patent and three other VirnetX patents. (Ex. 2005, VirnetX Inc.'s Original Complaint in *VirnetX Inc. v. Apple Inc.*, Case No. 6:12-cv-

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