

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2015-00186
Patent 7,921,211 B2

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

SIU, *Administrative Patent Judge.*

DECISION
Denying *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

A. *Background*

Apple Inc. (“Petitioner”) requests *inter partes* review of claims 1, 2, 5, 6, 14–17, 19–23, 26–41, 43–47, and 50–60 of U.S. Patent No. 7,921,211 B2 (“the ’211 Patent,” Ex. 1001) pursuant to 35 U.S.C. §§ 311 *et seq.* VirnetX Inc. (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.”) on January 16, 2015. Paper No. 10.

For the reasons that follow, the Board determines that the Petition was not filed timely within the statutory period of 35 U.S.C. § 315(b). Therefore, we decline to institute an *inter partes* review.

II. ANALYSIS

Petitioner states that “[t]he ’211 patent was asserted against Petitioner in proceedings alleging infringement more than one year ago.” Pet. 3. Title 35 of the United States Code, § 315(b), states that an “*inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” For an analysis of the time bar issue pursuant to 35 U.S.C. § 315(b), we refer to, and incorporate by reference, the Board’s previous decision holding that an earlier petition filed by Apple, a real party-in-interest in a proceeding challenging the ’211 patent, was time-barred. See *Apple Inc. v. Virnetx, Inc.*, IPR2013-00397 (PTAB Dec. 18, 2013) (denying *Inter Partes* Review of U.S. Patent 7,921,211) Paper 15, *reh’g denied*, (PTAB Feb. 12, 2014) Paper 20. Hence, pursuant to 35 U.S.C. § 315(b), we do not institute *inter partes* review.

Petitioner argues that “the one-year period in 35 U.S.C. § 315(b) does not apply to this petition pursuant to 35 U.S.C. § 315(c)” “because this petition is

IPR2015-00186
Patent 7,921,211 B2

accompanied by a motion for joinder to IPR2014-00618.” Pet. 3. Petitioner’s motion for joinder is dismissed because IPR2014-00618 has been terminated. IPR2014-00618, Paper 11.

III. CONCLUSION

Institution of *inter partes* review is denied because the Petition was not filed within the time limit pursuant to 35 U.S.C. § 315(b).

IV. ORDER

For the reasons given, it is
ORDERED that Petitioner’s motion for joinder is *dismissed*; and
FURTHER ORDERED that the petition challenging the patentability of claims 1, 2, 5, 6, 14–17, 19–23, 26–41, 43–47, and 50–60 of U.S. Patent No. 7,921,211 is *denied*.

IPR2015-00186
Patent 7,921,211 B2

For PETITIONER:

Jeffery P. Kushan
jkushan@sidley.com

Joseph A. Micallef
jmicallef@sidley.com

For PATENT OWNER:

Joseph E. Palys
josephpalys@paulhastings.com

Naveen Modi
naveenmodi@paulhastings.com

Jason E. Stach
jason.stach@finnegan.com