

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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APPLE INC.

Petitioner,

v.

VIRNETX, INC. AND SCIENCE APPLICATION INTERNATIONAL  
CORPORATION,

Patent Owner

Patent No. 7,490,151

Issued: Feb. 10, 2009

Filed: Sep. 30, 2002

Inventor: Edmund C. Munger, *et al.*

Title: ESTABLISHMENT OF A SECURE COMMUNICATIONS LINK  
BASED DOMAIN NAME (DNS) REQUEST

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*Inter Partes* Review No. IPR2015-00187

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**PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,490,151  
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.1-.80 & 42.100-.123**

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Petition for *Inter Partes* Review of U.S. Patent No. 7,490,151

Apple Inc. (“Petitioner” or “Apple”) petitions for *Inter Partes* Review (“IPR”) under 35 U.S.C. §§ 311–319 and 37 C.F.R. § 42 of claims 1, 2, 6-8, and 12-14 (“the Challenged Claims”) of U.S. Patent No. 7,490,151 (“the ‘151 patent”). By its accompanying Motion for Joinder, Petitioner seeks to join this petition to IPR2014-00610, a proceeding instituted on the same patent and the same prior art. The grounds identified in this petition are identical to the grounds in which the Board instituted trial on in IPR2014-00610.

**I. MANDATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1)**

**A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)**

The real party of interest of this petition pursuant to § 42.8(b)(1) is Apple Inc. (“Apple”) located at One Infinite Loop, Cupertino, CA 95014.

**B. Related Matters Under 37 C.F.R. § 42.8(b)(2)**

The ‘151 patent is the subject of a number of civil actions including: (i) Civ. Act. No. 6:13-cv-00211-LED (E.D. Tex.), filed February 26, 2013; (ii) Civ. Act. No. 6:12-cv-00855-LED (E.D. Tex.), filed November 6, 2012; (iii) Civ. Act. No. 6:10-cv-00417-LED (E.D. Tex.), filed August 11, 2010; (iv) Civ. Act. No. 6:11-cv-00018-LED (E.D. Tex.), (v) Civ. Act. No. 6:13-cv-00351-LED (E.D. Tex), filed April 22, 2013 (“the 2013 VirnetX litigation”); (vi) Civ. Act. No. 6:10-cv-00094 (E.D. Tex); and (vii) Civ. Act. No. 6:07-cv-00080 (E.D. Tex).

The ‘151 patent is also the subject of merged *inter partes* reexamination nos. 95/001,697 and 95/001,714. In the merged proceedings, the Office issued a Non-

Petition for *Inter Partes* Review of U.S. Patent No. 7,490,151

Final Action on April 20, 2012 rejecting all 16 claims of the '151 patent, including rejections based on several prior art references relied upon in this Petition.

The '151 patent is the subject of an inter partes review filed by Microsoft Corporation (IPR2014-00610), instituted on October 15, 2014. The '151 patent was also the subject of petitions for *inter partes* review filed by: New Bay Capital, LLC (IPR2013-00376, dismissed); Apple Inc. (IPR2013-00354, not instituted); and RPX Corporation (IPR2014-00173, not instituted).

**C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)**

<u>Lead Counsel</u> Jeffrey P. Kushan (Reg. No. 43,401) <a href="mailto:jkushan@sidley.com">jkushan@sidley.com</a> (202) 736-8914	<u>Backup Lead Counsel</u> Joseph A. Micallef (Reg. No. 39,772) <a href="mailto:jmicallef@sidley.com">jmicallef@sidley.com</a> (202) 736-8492
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**D. Service Information**

Service on Petitioner may be made by e-mail, or by mail or hand delivery to: Sidley Austin LLP, 1501 K Street, N.W., Washington, D.C. 20005. The fax number for lead and backup counsel is (202) 736-8711.

**II. PAYMENT OF FEES – 37 C.F.R. § 42.103**

The Director is authorized to charge the fee specified by 37 CFR § 42.15(a) to Deposit Account No. 50-1597.

**III. REQUIREMENTS FOR IPR UNDER 37 C.F.R. § 42.104**

**A. Grounds for Standing Under 37 C.F.R. § 42.104(a)**

Petitioner certifies that the '151 patent is available for *inter partes* review by Petitioner. The Petitioner is not barred or estopped from requesting an *inter*

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