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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. IPR2015-00187
U.S. Patent No. 7,490,151

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

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35 U.S.C. § 3116

35 U.S.C. § 315(b)*passim*

35 U.S.C. § 315(c)*passim*

I. INTRODUCTION

For the third time, Apple has been responsible for filing a petition for *inter partes* review of U.S. Patent No. 7,490,151 (“the ’151 patent”). Its first petition, in IPR2013-00354, was denied as untimely under 35 U.S.C. § 315(b). Apple had RPX Corporation file its next petition in IPR2014-0173, but it was also dismissed as untimely. Apple then filed yet another petition, IPR2015-00187 (“the ’187 proceeding”). This time Apple accompanied its petition with a motion for joinder with IPR2014-00610 (“the ’610 proceeding”), filed by Microsoft. Apple’s repeated filings and its request 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. Thus, Patent Owner VirnetX respectfully requests that the Board deny Apple’s motion requesting joinder of the ’187 proceeding with the ’610 proceeding.

II. PRECISE RELIEF REQUESTED

VirnetX requests that the Board deny Apple’s motion for joinder (“Mot.”).

III. STATEMENT OF FACTS

On August 11, 2010, VirnetX served Apple with a complaint alleging infringement of the ’151 patent and other VirnetX patents. (Ex. 2001, VirnetX Inc.’s Original Complaint in *VirnetX Inc. v. Cisco Sys., Inc. et al.*, Case No. 6:10-cv-00417 (E.D. Tex. Aug. 11, 2010) (“the ’417 litigation”).) In response, Apple

alleged, among other things, noninfringement, invalidity, and unenforceability of the '151 patent. (Ex. 2002, Apple's Answer in the '417 Litigation at ¶¶ 37, 43-45, 122-123, counterclaim ¶¶ 6-10, 12, 15, 31-37 (E.D. Tex. April 16, 2012).) Prior to trial, Apple also requested *inter partes* reexamination of the '151 patent. The proceeding was assigned Control No. 95/001,697 ("the '1,697 reexamination") and is ongoing.

Following a five day trial, the district court upheld the validity of the '151 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 '151 patent and three other VirnetX patents. (Ex. 2005, VirnetX Inc.'s Original Complaint in *VirnetX Inc. v. Apple Inc.*, Case No. 6:12-cv-00855 (E.D. Tex. Nov. 6, 2012) ("the '855 litigation").) In response, Apple again alleged, among other things, noninfringement and invalidity of the '151 patent. (Ex. 2006, Apple's Answer in the '855 Litigation at ¶¶ 16-18, 37-38, counterclaim ¶¶ 7, 9 (E.D. Tex. Jan. 23, 2013).)

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