

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VIRNETX INC.,
Patent Owner.

Case IPR2015-00810 (Patent 8,868,705 B2)
Case IPR2015-00811 (Patent 8,868,705 B2)
Case IPR2015-00812 (Patent 8,850,009 B2)¹

Before KARL D. EASTHOM, JENNIFER S. BISK, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5(a)(1)

¹ This Order addresses issues that are identical in all cases. The parties are not authorized to use this style heading for any subsequent papers.

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I. INTRODUCTION

In an email dated April 12, 2016, Petitioner, Apple Inc., asked that we change the final hearing date of June 8, 2016, set in the Scheduling Order (SO, Paper 9, 6)² to June 13 or 14, 2016. According to Petitioner's email, Patent Owner, VirnetX Inc., has no objection to the change in hearing date.

Petitioner's email represents that its lead counsel in each of the cases identified above "must conduct a deposition in Japan on June 6–10, which includes the date of the oral hearing in IPR2015-00810, -00811, -00812 (June 8th)." Lead counsel states this conflict has recently come to his attention. Lead counsel represents that scheduling issues prevent it from changing the dates of the Japanese depositions.

Patent Owner's position in the email is that it is agreeable to having backup counsel present argument for Petitioner. Patent Owner states that backup counsel has argued for Petitioner in the past. At present, lead counsel represents that it is not prepared to proceed with having backup counsel represent Petitioner at the hearing. Petitioner, however, has not explained why backup counsel is not available for the scheduled oral argument date. *See* 37 C.F.R. § 42.10(a) ("If a party is represented by counsel, the party must designate a lead counsel and at least one back-up counsel who can conduct business on behalf of the lead counsel.").

II. DISCUSSION

The Scheduling Order does not permit the parties to stipulate to a change in the final hearing date (DUE DATE 7). SO, 2.A. The Scheduling

² Unless otherwise noted, we refer to the papers in IPR2015-00811.

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Order also provides that the parties may contact the Board if there is a need for changes. *Id.* at 2.1. The Board may change the final hearing date at its discretion. Mere convenience of lead counsel does not, by itself, justify the burden on the Office of changing the date of a hearing that was scheduled seven months ago. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48758 (Aug. 14, 2012) (“The Office expects that lead counsel will, and back-up counsel may, participate in all hearings and conference calls with the Board In addition, the role of back-up counsel is to conduct business with the Office on behalf of lead counsel when lead counsel is not available.”). The schedules of all involved must be considered in determining whether to alter a scheduled oral argument date, including the resources of the Board.

With the preceding in mind, we authorize Petitioner to file a motion to change the hearing date. The motion should address, at least, the following questions in showing why we should change the final hearing date:³

1. When did lead counsel become aware of the need for his participation in the Japanese depositions?
2. Are other attorneys in lead counsel’s law firm representing lead counsel’s Japanese client? What has been done to have one or more of the other attorneys take the Japanese depositions?

³ None of the questions are intended to elicit privileged information or communications.

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3. Are there any specific reasons that Petitioner would prefer lead counsel, as opposed to backup counsel, make the argument at the final hearing?

4. In general, what efforts have been made to accommodate the current final hearing date?

We are mindful that Patent Owner's counsel has planned on a June 8, 2016, final hearing date. Accordingly, Patent Owner will be provided an opportunity to respond.

III. ORDER

ORDERED that by April 20, 2016, Petitioner is authorized to file a motion, not exceeding seven pages (excluding any attachments), to change the final hearing date from June 8, 2016, to June 13 or 14, 2016;

FURTHER ORDERED that by April 22, 2016, Patent Owner may, but is not required to, file a response, not exceeding five pages (excluding any attachments), to Petitioner's motion; and

FURTHER ORDERED that a copy of this Order shall be filed in IPR2015-00810, IPR2015-00811, and IPR2015-00812.

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