

Filed on behalf of: VirnetX Inc.

By:

Joseph E. Palys

Paul Hastings LLP

875 15th Street NW

Washington, DC 20005

Telephone: (202) 551-1996

Facsimile: (202) 551-0496

E-mail: josephpalys@paulhastings.com

Naveen Modi

Paul Hastings LLP

875 15th Street NW

Washington, DC 20005

Telephone: (202) 551-1990

Facsimile: (202) 551-0490

E-mail: naveenmodi@paulhastings.com

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

**Patent Owner's Opposition to Petitioner's Motion to Submit
Supplemental Information Pursuant to 37 C.F.R. § 42.123(a)**

Table of Contents

I. Introduction.....1

II. Argument1

III. Conclusion4

TABLE OF AUTHORITIES

Page(s)

Cases

Palo Alto Networks, Inc. v. Juniper Networks, Inc.,
 IPR2013-00369, Paper No. 37 (Feb. 5, 2014).....2

Redline Detection, LLC v. Star Envirotech, Inc.,
 IPR2013-00106, Paper No. 35 (Sept. 11, 2013).....1, 2, 4

Valeo North America, Inc. v. Magna Electronics, Inc.,
 IPR2014-01204, Paper No. 26 (Apr. 10, 2015).....2

VTech Communications, Inc. v. Shperix Inc.,
 IPR2014-01431, Paper No. 21 (Apr. 7, 2015).....2, 3

Federal Rules

37 C.F.R. § 42.123(a).....1, 2, 3

I. Introduction

Patent Owner VirnetX Inc. respectfully requests that the Board deny Petitioner Apple Inc.'s motion to supplement its original Petition with six supplemental exhibits purporting to show that RFC 2401 is a prior art printed publication. The Board's case law under 37 C.F.R. § 42.123(a) is not so broad as to allow for the submission of exhibits that a petitioner purposefully chose to withhold from its original petition, as the Petitioner has done here. Thus, Petitioner's motion should be denied.

II. Argument

37 C.F.R. § 42.123(a) requires a moving party to show that “(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted” and “(2) The supplemental information must be relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a). The Board has held that “nothing in 37 C.F.R. § 42.123 requires that a request to submit supplemental information satisfying these two criteria automatically be granted no matter the circumstance.” *Redline Detection, LLC v. Star Envirotech, Inc.*, IPR2013-00106, Paper No. 35 at 3 (Sept. 11, 2013) (citation omitted). And contrary to Petitioner's claim that the Board does not consider whether a petitioner could have reasonably obtained the supplemental

information earlier under Section 42.123(a) (*see* Mot. at 2), the Board has taken this fact into consideration.

In *VTech Communications, Inc. v. Shperix Inc.*, the Board addressed the petitioner's motion under Section 42.123(a), but still noted that "Petitioner did not explain sufficiently why Petitioner could not have reasonably submitted such evidence with its Petition, as required by 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b)." IPR2014-01431, Paper No. 21 at 3 (Apr. 7, 2015). Likewise, in *Palo Alto Networks, Inc. v. Juniper Networks, Inc.* and *Valeo North America, Inc. v. Magna Electronics, Inc.*, both relied on by Petitioner, the Board noted that there was no evidence that the petitioners intentionally withheld the information. *Palo Alto*, IPR2013-00369, Paper No. 37 at 4 (Feb. 5, 2014); *Valeo*, IPR2014-01204, Paper No. 26 at 4 (Apr. 10, 2015).

Here, the information shows that the Petitioner was in possession of the majority of the supplemental information well prior to the filing of its original Petition and thus must have knowingly omitted them. (*See, e.g.*, Mot. at Attachment A.) As the Board has found, "[t]he intentional delay in obtaining or presenting information to the Board is not in the interest of the efficient administration of the Office, nor does it further the ability of the Office to complete IPR proceedings in a timely manner." *Redline*, IPR2013-00106, Paper No. 35 at 4-5. Section 42.123(a) is not a back door to enter information that Petitioner could

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.