

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,

Petitioner

v.

VIRNETX, INC.,

Patent Owner

---

Case IPR2015-00811

Patent No. 8,868,705

---

**PETITIONER'S UPDATED MANDATORY NOTICES**

Petitioner, Apple Inc. (“Petitioner”) submits the following update to its Mandatory Notices to inform the Board about a developments in a related matter. *See Apple Inc. v. OpenTV, Inc.*, IPR2015-0980, Paper 11 (Sept. 28, 2015) at 8 n.2 (parties have a duty to disclose relevant developments in related matters).

On September 29, 2015, a panel of the Patent Trial and Appeal Board issued a decision in an *inter partes* reexamination involving a related patent, U.S. Patent No. 8,051,181, affirming the Examiner's rejection of the claims. *See* Control No. 95/001,949, Appeal No. 2015-004512.

On October 7, 2015, the Board issued decisions instituting trial in two *inter partes* reviews involving related patents. *See* IPR2015-01046 (U.S. Patent No. 6,502,135); IPR2015-01047 (U.S. Patent No. 7,490,151).

Petitioner is also supplementing its disclosure of related matters based on the Board's guidance in the Institution Decision. Paper 8 at 2-3.

**A. Mandatory Notices (37 C.F.R. § 42.8(b))**

**1. Real Party-in-Interest (§ 42.8(b)(1))**

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

**2. Related Matters (§ 42.8(b)(2))****a. *Patents and Applications***

U.S. Patent No. 8,868,705 (“’8705 patent”) is a member of a family of patents issued to Larson et al. and assigned to VirnetX, Inc. Like the ’8705 patent (Ex. 1001 at Face), the following patents claim priority to U.S. Provisional Application Nos. 60/106,261 and 60/137,704: 6,502,135; 6,618,761; 6,826,616; 6,834,310; 6,839,759; 6,907,473; 7,010,604; 7,133,930; 7,188,180; 7,418,504; 7,490,151; 7,921,211; 7,933,990; 7,945,654; 7,987,274; 7,996,539; 8,051,181; 8,458,341; 8,504,696; 8,504,697; 8,516,117; 8,516,131; 8,521,888; 8,554,899; 8,560,705; 8,572,247; 8,843,643; 8,850,009; 8,868,705; 8,874,771; 8,904,516; 8,943,201; 9,027,115; 9,037,713; 9,038,163; 9,077,694; 9,077,695; 9,094,399; and 9,100,375.

The following pending patent applications claim priority to U.S. Provisional Application Nos. 60/106,261 and 60/137,704: 13/475,637; 13/615,528; 13/617,375; 13/620,534; 13/620,550; 13/890,206; 13/950,897; 14/526,669; 14/702,630; 14/704,938; 14/710,470; and 14/815,869.

**b. *District Court Litigation***

Upon information and belief, the ’8705 patent has not been asserted in district court litigation.

The following district court proceedings involve patents related to the '8705 patent that may affect or be affected by a decision in this proceeding.

<b>Case/Matter</b>	<b>Status</b>	<b>Asserted Patents</b>
<i>VirnetX Inc. v. Apple Inc.</i> , Case No. 6-13-cv-00581 (E.D. Tex.)	Pending against Apple	8,504,697
<i>VirnetX Inc. v. Microsoft Corporation</i> , Case No. 6-13-cv-00351 (E.D. Tex.)	Dismissed with prejudice	6,502,135; 7,188,181; 7,418,504; 7,490,151; 7,921,211; 7,987,274
<i>VirnetX Inc. v. Apple Inc.</i> , Case No. 6-13-cv-00211 (E.D. Tex.)	Pending against Apple	6,502,135; 7,418,504; 7,490,151; 7,921,211
<i>VirnetX Inc. v. Apple Inc.</i> , Case No. 6-12-cv-00855 (E.D. Tex.)	Pending against Apple	6,502,135; 7,418,504; 7,490,151; 7,921,211; 7,188,181; 8,504,697
<i>VirnetX Inc. v. Apple Inc.</i> , Case No. 6-11-cv-00563 (E.D. Tex.)	Pending against Apple	7,188,181
<i>VirnetX Inc. v. Mitel Network Corporation</i> , Case No. 6-11-cv-00018 (E.D. Tex.)	Dismissed with prejudice	6,502,135; 7,418,504; 7,921,211
<i>VirnetX Inc. v. Cisco Systems, Inc.</i> , Case No. 6-10-cv-00417 (E.D. Tex.)	Pending against Apple after remand	6,502,135; 6,839,759; 7,188,180; 7,418,504; 7,490,151; 7,921,211
<i>VirnetX Inc. v. Apple Inc.</i> , Case Nos. 15-1934, 15-1935 (Fed. Cir.)		
<i>VirnetX Inc. v. Microsoft Corporation</i> , Case No. 6-10-cv-00094 (E.D. Tex.)	Dismissed with prejudice	6,502,135; 7,188,180
<i>VirnetX Inc. v. Microsoft Corporation</i> , Case No. 6-07-cv-	Dismissed with prejudice	6,502,135; 6,839,759; 7,188,180

00080 (E.D. Tex.)		
<i>In the matter of Certain Devices with Secure Communication Capabilities, Components thereof, and Products Containing the Same</i> (U.S. Int'l Trade Comm'n), Investigation No. 337-TA-858	Terminated	8,051,181

c. *Patent Office Proceedings*

IPR2015-00810 also involves the '8705 patent and may affect or be affected by a decision in this proceeding. The following proceedings before the United States Patent and Trademark Office involve patents related to the '8705 patent and may affect or be affected by a decision in this proceeding. Proceedings identified by an asterisk (\*) were filed by Apple.

Patent	Matter	Status
6,502,135	IPR2013-00348*	Institution Denied
	IPR2013-00349*	Institution Denied
	IPR2013-00375	Terminated
	IPR2014-00171	Institution Denied
	IPR2014-00172	Institution Denied
	IPR2014-00558	Institution Denied
	IPR2014-01046	Trial Instituted
	Control No. 95/001,682*	Pending before the Central Reexam Unit;

# 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.