

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

VIRNETX, INC.,

Patent Owner

Case IPR2015-00812

Patent No. 8,850,009

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. 8,850,009 (“’009 patent”) is a member of a family of patents issued to Larson et al. and assigned to VirnetX, Inc. Like the ’009 patent (Ex. 1003 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 ’009 patent has not been asserted in district court litigation.

The following district court proceedings involve patents related to the ’009 patent that may affect or be affected by a decision in this proceeding.

Case/Matter	Status	Asserted Patents
<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-00080 (E.D. Tex.)	Dismissed with prejudice	6,502,135; 6,839,759; 7,188,180
<i>In the matter of Certain Devices with Secure Communication</i>	Terminated	8,051,181

<i>Capabilities, Components thereof, and Products Containing the Same</i> (U.S. Int'l Trade Comm'n), Investigation No. 337-TA-858		
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c. *Patent Office Proceedings*

The following proceedings before the United States Patent and Trademark Office involve patents related to the '009 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; RAN issued on 9/15/2015
	Control No. 95/001,679	Pending before the Central Reexam Unit; RAN issued on 9/15/2015
6,839,759	Control No. 95/001,746;	Pending; Examiner's decision on appeal

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