Case No. IPR2015-00870

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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 IPR2015-00870
Patent 8,560,705

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

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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

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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

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