

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

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.  
Petitioner

v.

VIRNETX INC.  
Patent Owner

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Case IPR2015-00871  
Patent 8,560,705

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**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 nine supplemental exhibits totaling almost 900 pages that purport to show that RFC 2401 and Aventail are prior art printed publications. 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. Moreover, the sheer volume of pages Petitioner seeks to introduce at this stage of the proceeding is prejudicial to Patent Owner. 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-

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