

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE MANGROVE PARTNERS MASTER FUND, LTD. and APPLE INC.,
Petitioner,

v.

VIRNETX INC.,
Patent Owner.

Case IPR2015-01046
Patent 6,502,135 B1

THE MANGROVE PARTNERS MASTER FUND, LTD., APPLE INC.,
and BLACK SWAMP IP, LLC,
Petitioner,

v.

VIRNETX INC.,
Patent Owner.

Case IPR2015-01047
Patent 7,490,151 B2

Before MICHAEL P. TIERNEY, *Vice Chief Administrative Patent Judge*,
KARL D. EASTHOM and STEPHEN C. SIU, *Administrative Patent
Judges*.

EASTHOM, *Administrative Patent Judge*.

REMAND SCHEDULE
DISCOVERY MOTION and BRIEFING
35 U.S.C. § 316(c) and 37 C.F.R. §§ 5, 42.51

IPR2015-01046, Patent 6,502,135 B1
IPR2015-01047, Patent 7,490,151 B2

In IPR2015-01046 (“’46IPR”), the Mangrove Partners Master Fund, Ltd. and Apple Inc. (collectively “Petitioner”) requested *inter partes* review of claims 1, 3, 4, 7, 8, 10, and 12 of U.S. Patent No. 6,502,135 B1 (“the ’135 patent”).¹ The Board instituted reviews, conducted trials, and issued a Final Written Decision, holding claims 1, 2, 6–8, and 12–14 of the ’135 patent unpatentable. *See* ’46 IPR, Paper 71.

In IPR2015-01047 (the “’47IPR”), the Mangrove Partners Master Fund, Ltd., Apple Inc., and Black Swamp IP, LLC (collectively “Petitioner”) requested *inter partes* review of claims 1, 2, 6–8, and 12–14 of U.S. Patent No. 7,490,151 B2 (“the ’151 patent”).² The Board instituted reviews, conducted trials, and issued a Final Written Decision, holding claims 1, 2, 6–8, and 12–14 of the ’151 patent unpatentable. *See* ’47IPR, Paper 80.

VirnetX Inc. (“Patent Owner”) appealed the Final Written Decision in each case. Pursuant to the appeal, the United States Court of Appeals for the Federal Circuit issued a decision vacating each Final Written Decision and remanding to consider an issue on the merits of unpatentability and to allow Patent Owner to file a motion for additional discovery to support its real party in interest contentions. *See VirnetX Inc. v. The Mangrove Partners Master Fund, Ltd., Apple Inc.*, No 2017-1368, *VirnetX Inc. v. The Mangrove Partners Master Fund, Ltd., Apple Inc., Black Swamp*, No. 2017-1383, 2019 WL 2912776 (Fed. Cir. July 8, 2019) (the “Remand”).

¹ Apple Inc. filed a petition in IPR2016-00062, and the Board joined it as a Petitioner in IPR2015-01046.

² Apple Inc. and Black Swamp IP, LLC respectively filed a petition in IPR2016-00063 and IPR2016-00167, and the Board joined each as a Petitioner in IPR2015-01047.

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Pursuant to the Remand, during a teleconference, we instructed the parties to file a proposed briefing and discovery schedule and each party subsequently filed a respective schedule in each case. *See* '46IPR, Papers 78; '46IPR, Paper 79; '46IPR, Ex. 1047 (transcript of teleconference); '47IPR, Paper 87; '47IPR, Paper 88; '47IPR Ex. 1047 (same transcript).

“The Board has established a goal to issue decisions on remanded cases within six months of the Board’s receipt of the Federal Circuit’s mandate. The mandate makes the judgment of the Federal Circuit final and releases jurisdiction of the remanded case to the Board.” PTAB Standard Operating Procedure 9, Procedure for Decisions Remanded from the Federal Circuit for Further Proceedings (Nov. 9, 2017) (“SOP 9”), *available at* <https://usptogov.sharepoint.com/sites/bf319f98/Shared%20Documents/Forms/AllItems.aspx?FolderCTID=0x012000F14F79D244FFB74496C315D37020EB04>.

The mandate for the Remand issued on August 14, 2019. *See* '46IPR, Paper 78, 1. Accordingly, after reviewing the parties’ proposed schedules, the Board set the following schedule and page/word limits for discovery and briefing that shall apply to each case, such that the decision on remand may be completed by February 14, 2020 pursuant to SOP 9. Patent Owner bears the burden on its motion for discovery. Petitioner bears the ultimate burden on the real party in interest and unpatentability issues, and its opening brief (“Petitioner’s Brief”) should address both issues if Petitioner seeks consideration of each issue.³

³ The Briefs shall follow the court’s guidance as set forth in the Remand.

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REMAND SCHEDULING ORDER

REMAND DUE DATE 1..... September 27, 2019
Patent Owner's ("PO's") Motion for Additional Discovery
("Disc. Motion") (15 pages)

REMAND DUE DATE 2October 4, 2019
Petitioner's Opposition ("Opp.") to PO's Disc. Motion (15 pages)

REMAND DUE DATE 3October 11, 2019
PO's Reply to Petitioner's Opp. to PO's Disc. Motion (5 pages)

REMAND DUE DATE 4November 8, 2019
Close of Discovery (if Ordered)

REMAND DUE DATE 5December 6, 2019
Petitioner's Brief (7,500 words)

REMAND DUE DATE 6December 20, 2019
Patent Owner's Opposition Brief (7,500 words)

REMAND DUE DATE 7..... January 6, 2020
Petitioner's Reply Brief (7,500 words)

REMAND DUE DATE 8..... January 17, 2020
Patent Owner's Sur-Reply Brief (7,500 words)

REMAND DUE DATE 9..... January 24, 2020
Oral Hearing 10 AM Eastern Time
U.S. Patent & Trademark Office in Alexandria, Virginia

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