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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 IPR2015-01046¹
Patent No. 6,502,135

Patent Owner's Request for Rehearing and Suggestion for Expanded Panel

¹ Apple Inc., who filed a petition in IPR2016-00062, has been joined as a Petitioner in the instant proceeding.

Table of Contents

- I. INTRODUCTION AND PRECISE RELIEF REQUESTED1
- II. BACKGROUND3
 - A. Prior Challenges to the '135 Patent.....3
 - B. Current Challenge to the '135 Patent4
- III. LEGAL STANDARD6
- IV. STATEMENT OF REASONS FOR RELIEF REQUESTED7
 - A. The Board Should Have Found at Least the Mangrove Partners Hedge Fund, a Company That Provided Funding for the IPR Petition, and Whose Executives Dictated the Contents of the Petition and Corresponding Expert Declaration, to be an RPI7
 - B. The Board Should Not Have Given Any Weight to Dr. Guerin’s Declaration Given That It Was Altered, After Being Signed, by an Executive of a Company Involved in Preparing the IPR Petition.....11
- V. PATENT OWNER SUGGESTS REHEARING BY AN EXPANDED PANEL THAT INCLUDES THE CHIEF JUDGE.....14
- VI. CONCLUSION.....15

TABLE OF AUTHORITIES

Page(s)

Cases

Aceto Agricultural Chems. Corp. v. Gowan Co.,
 IPR2015-01016, Paper No. 15 at 11 (Oct. 2, 2015)11, 15

Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.,
 IPR2013-00453, Paper No. 88 at 13 (Jan. 6, 2015).....11, 15

Galderma S.A. v. Allergan Industrie, SAS,
 IPR2014-01422, Paper No. 14 at 6-7, 12 (Mar. 5, 2015)10, 15

Statutes

35 U.S.C. § 315(b)3, 4

Other Authorities

37 C.F.R. § 42.71(d)6

Office Patent Trial Practice Guide, 77 Fed. Reg. 157 (Aug. 14, 2012).....10, 14

Standard Operating Procedure 1, Rev. 14 (May 8, 2015)2, 14

I. INTRODUCTION AND PRECISE RELIEF REQUESTED

Patent Owner VirnetX Inc. requests rehearing of the Patent Trial and Appeal Board's Final Written Decision entered September 9, 2016 (Paper No. 71, "Decision"). This request presents two issues:

- (1) Whether a company that provides funding for an IPR petition, and whose executives dictate the contents of that petition and corresponding expert declaration, is a real party-in-interest ("RPI")?
- (2) Whether an expert declaration accompanying an IPR petition should be given any weight by the Board if, after being signed by the declarant, the declaration was altered by an executive of a company involved in preparing the petition?

The Decision misapprehended or overlooked arguments and evidence in the Patent Owner's Response as to each of these issues.²

With respect to the first issue, the Decision misapprehended or overlooked evidence regarding representations by The Mangrove Partners Master Fund, Ltd. ("Petitioner Mangrove") to the United States Securities and Exchange Commission ("SEC"), and evidence uncovered during additional discovery, showing that RPIs

² In presenting this Request for Rehearing, Patent Owner reserves all rights to appeal these and other aspects of the Decision.

were improperly omitted. Paper No. 44 (“Patent Owner’s Response” or “Response”) at 51–52, 54–56. The Board should vacate its Decision and terminate this proceeding for this failure to disclose RPIs, as other panels have done before.

With respect to the second issue, the Decision misapprehended or overlooked arguments and evidence that the content of the declaration of Dr. Roch Guerin (Petitioner’s expert), Exhibit 1003, was improperly changed, after being signed by Dr. Guerin, by (at a minimum) the Chief Operating Officer of an entity involved in preparing the Petition in this proceeding. *Id.* at 39–41. The Board should find that Exhibit 1003 is entitled to no weight and reverse its findings of unpatentability, which rely on Exhibit 1003.

VirnetX suggests rehearing by an expanded panel that includes the Chief Judge in deciding at least the RPI issues raised in this request. Standard Operating Procedure 1, Rev. 14 (May 8, 2015), Section III.D (“When a judge, a merits panel, or an interlocutory panel . . . receives a suggestion for an expanded panel, the judge, merits panel, or interlocutory panel shall notify the Chief Judge, Deputy Chief Judge, and the Vice Chief Judges of the suggestion, in writing.”). The RPI issues need to be considered “by an expanded panel . . . to secure and maintain uniformity of the Board’s decisions,” given that the Decision here conflicts with what other panels have done under similar circumstances. *See* Standard Operating Procedure 1, Rev. 14, Section III.A.

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