

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 VIRNETX INC.'S
AMENDED NOTICE OF APPEAL**

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

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
Madison Building East, 10B20
600 Dulany Street
Alexandria, VA 22314-5793

Patent Owner VirnetX Inc. (“VirnetX”) hereby amends its prior Notice of Appeal (Paper No. 113), filed on September 14, 2020, which noticed an appeal to the United States Court of Appeals for the Federal Circuit from the Final Written Decision on Remand entered on July 14, 2020 (Paper 112) (the “Final Written Decision”) by the United States Patent and Trademark Office, Patent Trial and Appeal Board (the “Board”), and from all underlying orders, decisions, rulings, and opinions, including, but not limited to, the Decision Granting In Part Patent Owner’s Motion for Additional Discovery, entered on October 23, 2019 (Paper 88) and the Decision Denying Patent Owner’s Request on Rehearing of Order Regarding Additional Discovery, entered on July 14, 2020 (Paper 111). With this amended notice of appeal, VirnetX further appeals to the United States Court of Appeals for the Federal Circuit from the Order entered on October 29, 2021 (Paper No. 116) by Andrew Hirshfeld, Commissioner for Patents, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, which denied VirnetX’s request for Director review of the Final Written Decision. Copies of the

Final Written Decision, the Decision Granting In Part Patent Owner's Motion for Additional Discovery, the Decision Denying Patent Owner's Request on Rehearing of Order Regarding Additional Discovery, and the Order denying VirnetX's request for Director review are attached.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), VirnetX indicates that the issues on appeal include, but are not limited to, whether the Board's use of joinder to consider new issues and evidence introduced by a joined party contravenes 35 U.S.C. § 315(c) and *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d. 1321 (Fed. Cir. 2020), the Board's interpretation and application of 35 U.S.C. § 315(b)-(c), the Board's denial of discovery sought by VirnetX, the Board's determination of unpatentability of claims 1, 3, 4, 7, 8, 10, and 12 of U.S. Patent No. 6,502,135 under 35 U.S.C. § 102, and any findings or determinations supporting or related to those rulings including, without limitation, the Board's construction and application of the claim language, the Board's interpretation of the references, and the Board's interpretation of expert evidence. The issues on appeal further include whether Commissioner for Patents, Andrew Hirshfeld, as the Official Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, was precluded from exercising the Director's review authority with respect to VirnetX's request by the Appointments Clause, *United States v.*

Arthrex, Inc., 141 S. Ct. 1970 (2021), or the Federal Vacancies Reform Act of 1998, 5 U.S.C. §§ 3345-3349c.

Simultaneous with this submission, a copy of this Amended Notice of Appeal is being filed with the Board. In addition, the Amended Notice of Appeal and the required fee are being filed electronically with the Clerk of Court for the United States Court of Appeals for the Federal Circuit.

Respectfully submitted this 3rd day of November, 2021.

By: /Naveen Modi/
Naveen Modi
Registration No. 46,224
Paul Hastings LLP
2050 M Street, N.W.
Washington, DC 20036
(202) 551-1700
naveenmodi@paulhastings.com

Counsel for VirnetX Inc.

CERTIFICATE OF SERVICE

The undersigned certifies that, in addition to being filed electronically through Patent Trial and Appeal Board End to End (PTAB E2E), the original version of this Notice of Appeal was filed by overnight express delivery on November 3, 2021 with the Director of the United States Patent and Trademark Office, at the following address:

Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

The undersigned also certifies that a true and correct copy of this Notice of Appeal and the required fee were filed electronically via CM/ECF on November 3, 2021, with the Clerk of Court for the United States Court of Appeals for the Federal Circuit.

The undersigned also certifies that a true and correct copy of this Notice of Appeal was served on November 3, 2021 on counsel of record for Petitioners by electronic mail (by agreement of the parties) at the following addresses:

Abraham Kasdan (akasdan@wiggin.com)
James T. Bailey (jtb@jtbaileylaw.com)
WIGGIN AND DANA LLP
IP@wiggin.com

Jeffrey P. Kushan
Scott Border
Thomas A. Broughan III
SIDLEY AUSTIN LLP
iprnotices@sidley.com

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