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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

VIRNETX INC.,  
Patent Owner

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Case IPR2015-01047<sup>1</sup>  
Patent No. 7,490,151

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**Patent Owner's Request for Rehearing  
Under 37 C.F.R. § 42.71(d)(1) of Institution Decision in IPR2016-00167**

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<sup>1</sup> Apple Inc. and Black Swamp, LLC, who filed petitions in IPR2016-00063 and IPR2016-00167, respectively, have been joined as Petitioners in the instant proceeding.

**Table of Contents**

- I. INTRODUCTION AND PRECISE RELIEF REQUESTED .....1
- II. LEGAL STANDARD .....2
- III. STATEMENT OF REASONS FOR RELIEF REQUESTED .....3
  - A. The Decision Is Inconsistent with the Decision in the '1047 IPR .....3
  - B. The Decision Is Legally Erroneous Because It Failed to Recognize That a Petition With a Joinder Motion Must Warrant Institution Before It Can Be Granted and Joined to Another Proceeding .....5
- IV. PATENT OWNER REQUESTS REHEARING BY AN EXPANDED PANEL THAT INCLUDES THE CHIEF JUDGE.....8
- V. CONCLUSION.....9

**TABLE OF AUTHORITIES**

**Page(s)**

**Federal Cases**

*Alexsam, Inc. v. IDT Corp.*,  
715 F.3d 1336 (Fed. Cir. 2013) .....6

*Alza Corp. v. Mylan Labs., Inc.*,  
464 F.3d 1286 (Fed. Cir. 2006) .....6

*Apple Inc. v. DSS Technology Management, Inc.*,  
IPR2015-00369, Paper No. 14 (Aug. 12, 2015) .....2

*Butamax Adv. Biofuels LLC v. Gevo, Inc.*,  
IPR2014-00581, Paper No. 8 (Oct. 14, 2014) .....5, 9

*Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*,  
800 F.3d 1375 (Fed. Cir. 2015) .....7

*Google Inc. v. SimpleAir, Inc.*,  
CBM2015-00019, Paper No. 15 (Aug. 19, 2015) .....8

*Koito Mfg. Co., Ltd. v. Turn–Key–Tech, LLC*,  
381 F.3d 1142 (Fed. Cir. 2004) .....6

*Proveris Scientific Corp. v. Innovasystems, Inc.*,  
536 F.3d 1256 (Fed. Cir. 2008) .....6

*Schumer v. Lab. Computer Sys., Inc.*,  
308 F.3d 1304 (Fed.Cir.2002) .....7

*Wyers v. Master Lock Co.*,  
616 F.3d 1231 (Fed. Cir. 2010) .....6

**Statutes**

35 U.S.C. § 315(c) .....5, 8

**Other Authorities**

37 C.F.R. § 42.71(c).....2

37 C.F.R. § 42.71(d) .....2  
Standard Operating Procedure 1, Rev. 14.....2, 8

## I. INTRODUCTION AND PRECISE RELIEF REQUESTED

Patent Owner VirnetX Inc. requests rehearing of the Patent Trial and Appeal Board's Institution Decision entered February 4, 2016 (Paper No. 12 in IPR2016-00167, "Decision"), granting Black Swamp LLC's petition and instituting trial in IPR2016-00167 ("the '167 IPR") and joining that proceeding with IPR2015-01047 ("the '1047 IPR").

The Decision found institution to be proper "[i]n view of the identity of each of the challenges in [the '167 IPR] Petition to at least one challenge presented in the petition in [the '1047 IPR]." (Decision at 3.) The Decision "institute[ed] an *inter partes* review in [the '167 IPR] on the same grounds as those on which [the Board] instituted *inter partes* review in [the '1047 IPR]." (*Id.* at 4.) The Decision thus did not include any independent analysis of the petition in the '167 IPR, instead relying on the analysis conducted when instituting the '1047 IPR. (*See id.* at 3-4.) As explained in more detail below, however, the Board relied on expert testimony submitted with the '1047 IPR, whereas no such expert testimony was submitted with the '167 IPR petition. Given that the Board relied on expert testimony in the '1047 IPR, the Decision does not establish Black Swamp to have met its burden of demonstrating a reasonable likelihood of prevailing in proving unpatentability of the challenged claims. As such, institution was improper.

VirnetX requests rehearing by an expanded panel that includes the Chief

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