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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

Case No. IPR2016-00062
U.S. Patent No. 6,502,135

PATENT OWNER'S OPPOSITION TO APPLE'S MOTION FOR JOINDER

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I. INTRODUCTION

For the fifth time, Apple has been responsible for filing a petition for *inter partes* review of U.S. Patent No. 6,502,135 ("the '135 patent"). Its first two concurrently filed petitions, in IPR2013-00348 and IPR2013-00349, were denied as untimely under 35 U.S.C. § 315(b). Apple had RPX Corporation file its next two petitions in IPR2014-00171 and IPR2014-00172, but they were also dismissed as untimely. Now, Apple has filed yet another petition, IPR2016-00062 ("the '062 proceeding"). This time, Apple accompanies its petition with a motion for joinder with IPR2015-01046 ("the '046 proceeding"), filed by The Mangrove Partners Master Fund, Ltd. ("Mangrove"). Apple's repeated filings and its request for joinder are an attempt to evade the time bar of § 315(b) and should be rejected. Not only does the plain language of § 315(b) require this result, § 315(c) and Congress's express intent to avoid serial harassment of patent owners confirms it. Thus, Patent Owner VirnetX respectfully requests that the Board deny Apple's motion requesting joinder of the '062 proceeding with the '046 proceeding.

II. PRECISE RELIEF REQUESTED

VirnetX requests that the Board deny Apple's motion for joinder ("Mot.").

III. STATEMENT OF FACTS

On August 11, 2010, VirnetX served Apple with a complaint alleging infringement of the '135 patent and other VirnetX patents. (Ex. 2002, VirnetX Inc.'s Original Complaint in *VirnetX Inc. v. Cisco Sys., Inc. et al.*, Case No. 6:10-

cv-00417 (E.D. Tex. Aug. 11, 2010) ("the '417 litigation").) In response, Apple alleged, among other things, noninfringement, invalidity, and unenforceability of the '135 patent. (Ex. 2003, Apple's Answer in the '417 Litigation at ¶¶ 37, 40-42, 122-123, counterclaim ¶¶ 6-10, 11, 15-30, (E.D. Tex. April 16, 2012).) Prior to trial, Apple also requested *inter partes* reexamination of the '135 patent. The proceeding was assigned Control No. 95/001,682 ("the '1,682 reexamination") and is ongoing.

Following a five day trial, the district court upheld the validity of the '135 patent. (Ex. 2004, Jury Verdict Form in the '417 litigation (E.D. Tex. Nov. 6, 2012); Ex. 2005, Final Judgment in the '417 litigation (E.D. Tex. Feb. 28, 2013).) Apple appealed to the U.S. Court of Appeals for the Federal Circuit, which affirmed that "none of the asserted claims are invalid[.]" *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F. 3d 1308, 1313-14 (Fed. Cir. 2014).

After trial, in November 2012, VirnetX served Apple with a related complaint involving the '135 patent and three other VirnetX patents. (Ex. 2006, VirnetX Inc.'s Original Complaint in *VirnetX Inc. v. Apple Inc.*, Case No. 6:12-cv-00855 (E.D. Tex. Nov. 6, 2012) ("the '855 litigation").) In response, Apple again alleged, among other things, noninfringement and invalidity of the '135 patent. (Ex. 2007, Apple's Answer in the '855 Litigation at ¶¶ 10, 13-15, 37-38, counterclaim ¶¶ 7, 9 (E.D. Tex. Jan. 23, 2013).)

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