

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACK SWAMP IP, LLC,
Petitioner

v.

VIRNETX INC.,
Patent Owner

Case IPR2016-00957
Patent 7,921,211

**PATENT OWNER VIRNETX INC.'S
PROTECTIVE AMENDED NOTICE OF APPEAL**

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. 17), filed on September 22, 2017, which noticed an appeal to the United States Court of Appeals for the Federal Circuit from the Final Written Decision entered on June 12, 2017, (Paper 14) (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, as well as the Board’s Decision on Request for Rehearing, entered on July 24, 2017 (Paper 16). 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 January 7, 2022 (Paper No. 21) 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 on Request for Rehearing, 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, the Board's authority to invalidate a granted patent through *inter partes* review proceedings, the Board's determination of unpatentability of claims 1, 2, 5, 6, 15, 16, 23, 27, 36, 37, 39, 40, 47, 51, and 60 of U.S. Patent No. 7,921,211 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. The issues on appeal also include whether the Board's unpatentability findings with respect to claims of U.S. Patent No. 7,921,211 that had already been cancelled should be vacated.

In its Notice of Denial of Director Rehearing filed with the United States Court of Appeals for the Federal Circuit on January 21, 2022, VirnetX indicated its belief that Appeal No. 17-2594, which arises from this proceeding, is moot because

all the patent claims at issue have already been cancelled as a result of other proceedings. *See* Docket No. 54 in Appeal No. 17-2593 at 3-4. VirnetX accordingly requested that the Federal Circuit vacate the Board's decision in IPR2016-00957 and dismiss appeal arising from that proceeding (Appeal No. 17-2594) as moot. *Id.* On March 8, 2022, Intervenor the United States Patent and Trademark Office informed the Federal Circuit that it agrees that the Board's decision in IPR2016-00957 should be vacated as moot. *See* Docket No. 62 in Appeal No. 17-2593 at 1. VirnetX continues to believe that vacatur of the Board's decision is the right course of action, and files this amended notice of appeal solely as a protective measure.

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 is being filed electronically with the Clerk of Court for the United States Court of Appeals for the Federal Circuit.

Respectfully submitted this 10th day of March 2022.

By: /Naveen Modi/

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