

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VIRNETX INC.,
Patent Owner.

Case IPR2015-00810 (Patent 8,868,705 B2)
Case IPR2015-00811 (Patent 8,868,705 B2)
Case IPR2015-00812 (Patent 8,850,009 B2)
Case IPR2015-00866 (Patent 8,458,342 B2)
Case IPR2015-00868 (Patent 8,516,131 B2)
Case IPR2015-00870 (Patent 8,560,705 B2)
Case IPR2015-00871 (Patent 8,560,705 B2)¹

Before KARL D. EASTHOM, JENNIFER S. BISK, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION
Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)(1)

¹ This Decision addresses issues that are identical in all cases. We exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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I. INTRODUCTION

Petitioner, Apple Inc., filed a Motion to Submit Supplemental Information Pursuant to 37 C.F.R. § 42.123(a). Paper 17 (“Motion” or “Mot.”).² Patent Owner, VirnetX Inc., opposed the Motion. Paper 19 (“Opposition” or “Opp.”). The Motion requests that supplemental information, represented by Exhibits 1057 to 1065 in IPR2015-00811 and -00871 and Exhibits 1060 to 1065 in IPR2015-00810, -00812, -00866, -00868, and -00871, be made of record in the respective proceedings. Mot. 1 n1.

Petitioner asserts Exhibits 1057 to 1059 are relevant to the public availability of Aventail Connect (Exhibits 1009–1011) and Exhibits 1060–1065 are relevant to the public availability of RFC 2401 (Ex. 1008). Mot. 1. Accordingly, Petitioner asserts that Aventail Connect and RFC 2401 were publicly available prior to the effective filing date of, in CBM2015-00811, US Patent 8,868,705 (the “’705 patent”). *Id.* Petitioner asserts public availability is an issue raised by Patent Owner in its Preliminary Response (Paper 6, 1–6, “Prelim. Resp.”) and Request for Rehearing (Paper 12, 3–4). *Id.* at 4.

For the reasons set forth below, the Motion is granted.

II. DISCUSSION

Pursuant to 37 C.F.R. § 42.123 (a), after institution of trial, a petitioner may request authorization to file a motion to submit supplemental information. The rule states:

² Unless otherwise noted, we refer to the papers in IPR2015-00811, which includes all supplemental information under consideration in all cases.

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§ 42.123 Filing of supplemental information.

(a) *Motion to submit supplemental information.* Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date for which the trial has been instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

Although Petitioner met the threshold requirements recited in subparts (a)(1) and (2) of 37 C.F.R. § 42.123(a) and was authorized via email to file a motion to submit supplemental information, authorization does not guarantee that the motion will be granted. The burden of proof remains with Petitioner to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). In construing our Rules, we are guided by our mandate “to secure the just, speedy, and inexpensive resolution” to this proceeding. *See* 37 C.F.R. § 42.1(b).

A. *Exhibits 1057–1059 (Aventail Connect Exhibits)*

Exhibits 1022, 1023, and 1043 were filed with the Petition and relate to public availability of Aventail Connect. Mot. 5 n.2. For example, Exhibit 1023, the Declaration of Chris Hopen (“Hopen Declaration”), describes the availability of Aventail Connect. *Id.* at 5 (citing Ex. 1023 ¶¶ 13–16)). Prior to the filing of the Motion, Patent Owner objected to Exhibits 1022, 1023, and 1043 (“First Objection,”

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Paper 11, 1).³ In response to the First Objection, Petitioner served Exhibits 1057–1059 as supplemental evidence under 37 C.F.R. § 42.64(b)(2). *Id.* 5 n.2.

Petitioner contends Exhibits 1057–1059 contain testimony from Mr. Hopen that corroborates the reliability of Exhibits 1022, 1023, and 1043 and are supplemental information. Mot. 5 n.2 (citing *Valeo North Am., Inc. v. Magna Elects., Inc.*, IPR2014-01204, Paper 26 at 5 (PTAB Apr. 10, 2015)). Specifically, Exhibit 1057 is a rough transcript of Mr. Hopen’s deposition in the related District Court litigation and Exhibit 1058 is an exhibit from that deposition. *Id.* at 6 (citing Ex. 1057, 4–6, 191; Ex. 1058, i (marked as deposition exhibit “P4”)). Exhibit 1059 is a transcript of part of the trial in the related District Court litigation. *Id.* at 8. Petitioner asserts that Exhibits 1057–1059 support its contention that Aventail Connect is prior art to the challenged claims. Mot. 8.

Patent Owner argues that all of the exhibits offered as supplemental information prejudicial, amount to almost 900 pages. Opp. 1, 3. Patent Owner also points out that “Petitioner was in possession of the majority of the supplemental information well prior to the filing of its original Petition and thus must have knowingly omitted them.” *Id.* at 2 (citing Mot., Attachment A). Patent Owner argues that the “intentional delay” in obtaining or presenting

³ Patent Owner objected on the grounds that the exhibits are: (1) not relevant to the grounds upon which trial was instituted; and (2) inadmissible hearsay. Paper 11, 1.

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information does not “further the ability of the Office to complete IPR proceedings in a timely manner.” *Id.* at 2–3. Patent Owner concludes all of the exhibits Petitioner seeks to make of record as supplemental information should have been filed with the Petition. *Id.* at 3–4.

Preliminarily, that Exhibits 1057–1059 have been served as supplemental evidence does not preclude those same exhibits from being supplemental information. “Nothing in the Board’s rules prohibits a party from filing, as supplemental information, evidence which also is responsive to evidentiary objections.” *Valeo*, Paper 26, at 5.

Under 37 C.F.R. § 42.123(a), unlike 37 C.F.R. § 42.123(b), Petitioner need not “show why the supplemental information reasonably could not have been obtained earlier.” While Petitioner does not allege the delay was unintentional, Petitioner argues that it is not relevant to the analysis under 37 C.F.R. § 42.123(a) that the supplemental information “could not have been obtained earlier.” *See* Mot. 2. Patent Owner asserts the delay was “intentional” without any evidence or authority that, even if the delay was intentional, we should preclude the supplemental information. Thus, we are not persuaded by Patent Owner’s argument regarding “intentional delay.”

We are not persuaded that there is any undue prejudice to Patent Owner by allowing the supplemental information as part of the record in this proceeding. Patent Owner’s prejudice argument relies on the volume of the exhibits, almost 900 pages. However, based on the quoted portions of the exhibits in the Motion the volume of

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relevant is evidence relating to whether Aventail Connect was publicly available is limited to a few pages. *See* Mot. 6–8. Thus, while we take at face value⁴ that the exhibits include many pages, the need to review and respond to them should be circumscribed by the limited issue on which the exhibits are proffered.⁵ Petitioner also alleges, and Patent Owner does not dispute, there is no prejudice to Patent Owner because Patent Owner has investigated and even had possession of some of the exhibits from the related litigation. Mot. 12–13.

Consideration of all of the supplemental information (Exhibits 1057—1065) will not change the grounds of unpatentability. *See* Mot. 11–12. The evidence is proffered solely on the limited issue of whether Aventail Connect was publicly available prior to the effective date. No new issues are added.

Neither will submission of Exhibits 1057–1059 likely interfere with the speed or efficiency of trial. *See* Mot. 13. As noted above, the exhibits in question are corroboration of evidence already of record, specifically the Hopen Declaration. Indeed, all of the exhibits relate to previous testimony of Mr. Hopen. Patent Owner’s Response is not due until December 11, 2015, and given the nature of the

⁴ Petitioner served but has not filed the supplemental information. Mot. 13, n.4.

⁵ Upon the filing of this Decision, we suggest Petitioner remove any pages in the exhibits that are not relevant to whether Aventail Connect was publicly available prior to the effective date prior to filing the exhibits.

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exhibits it would seem unlikely an additional deposition of Mr. Hopen will be necessary.

Petitioner may submit Exhibits 1057–1059 as supplemental information.

B. Exhibits 1060–1065 (RFC 2401 Exhibits)

In the Institution Decision, we determined preliminarily that Petitioner has made a threshold showing that RFC 2401, which displays a date of November 1998, constitutes a prior art printed publication. Dec. 10–11. Accordingly, we considered the disclosure of RFC 2401 for the purposes of the Institution Decision. Petitioner seeks to submit supplemental information (Exhibits 1060–1065) to prove that RFC 2401 was publicly available prior to effective date of the patents at issue.

The exhibits include testimony by Sandy Ginoza, a representative of the Internet Engineering Task Force (“IETF”), and additional documentation. Mot. 1. Exhibits 1060 and 1063 are respectively a declaration and deposition of Ms. Ginoza, acting as a designated representative of the IETF, testifying that RFC 2401 was publicly available in November 1998 produced during a trial before the International Trade Commission (ITC). Mot. 9, 10. Exhibit 1061 is a Bates stamped copy of RFC 2401 produced in the ITC. *Id.* Exhibit 1062 is a redline comparison of RFC 2401 from Exhibit 1061 in the ITC to Exhibit 1008 submitted here allegedly showing no substantive differences between the two. *Id.* at 9–10. Exhibit 1064 is an article from *InfoWorld* magazine and Exhibit 1065 is an article

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from *NetworkWorld* magazine which state that it was “known that RFCs, and RFC 2401 specifically, were publicly available through the Internet, such as through the IETF’s website.” *Id.* at 11.

Petitioner does not make any argument beyond those made above in connection with Exhibits 1057–1059. Similarly, Patent Owner makes no argument specific to Exhibits 1060–1065. Patent Owner’s arguments were all addressed above in II.A.

Petitioner may submit Exhibits 1060–1065 as supplemental information.

III. SUMMARY AND CONCLUSION

We are persuaded that all of the supplemental information (Exhibits 1057–1065) proffered by Petitioner under 37 C.F.R. § 42.123 (a) relates to the public accessibility of Aventail Connect and RFC 2401, the references upon which trial was instituted in these various proceedings. The supplemental information provides additional evidence that the prior art for each of the instituted grounds are indeed prior art and does not change “the grounds of unpatentability authorized in this proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability.” *Palo Alto Networks, Inc v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3 (PTAB Feb. 5, 2014).

Petitioner has established that all of the supplemental information should be filed and considered as part of the trial in the respective proceedings.

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IV. ORDER

ORDERED that Petitioner's Motion to Submit Supplemental Information under 37 C.F.R. § 42.123 (a) is granted as follows:

- (1) Exhibits 1057–1065 may be filed in IPR2015-00811 and IPR2015-00871;
- (2) Exhibits 1060–1065 may be filed in IPR2015-00810, IPR2015-00812, IPR2015-00866, IPR2015-00868, and IPR2015-00870;

FURTHER ORDERED that a copy of this Decision shall be filed in IPR2015-00810, IPR2015-00811, IPR2015-00812, IPR2015-00866, IPR2015-00868, IPR2015-00870, and IPR2015-00871.

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