

Paper No. \_\_\_\_\_  
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Filed on behalf of: VirnetX Inc.

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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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APPLE INC.  
Petitioner

v.

VIRNETX INC.  
Patent Owner

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Case IPR2014-00486  
Patent 8,051,181

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**UPDATED PATENT OWNER'S MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8**

VirnetX Inc., the Patent Owner, provides the following updated mandatory notices pursuant to 37 C.F.R. § 42.8.

**I. Real Party-in-Interest**

Pursuant to 37 C.F.R. § 42.8(b)(1), the real party-in-interest is VirnetX Inc., the assignee of record for U.S. Patent No. 8,051,181 (“the ’181 patent”).

**II. Related Matters**

Patent Owner identifies the following matters that may be deemed related pursuant to 37 C.F.R. § 42.8(b)(2).

**A. Proceedings Before the USPTO Involving the Patent-at-Issue**

The ’181 patent, which is the subject of this proceeding, is also at issue in the following *inter partes* review and *inter partes* reexamination proceedings:

Control No. 95/001,949
Case IPR2014-00485

**B. Proceedings Before the USPTO Involving Related Patents**

Several patents stemming from the same applications that led to the '181 patent are or were at issue in the following *inter partes* review and *inter partes* reexamination proceedings:

Patent	Matter
U.S. Patent No. 6,502,135	Case IPR2013-00348 <sup>1</sup>
	Case IPR2013-00349 <sup>2</sup>
	Case IPR2013-00375 <sup>3</sup>
	Case IPR2014-00171 <sup>4</sup>
	Case IPR2014-00172 <sup>5</sup>
	Case IPR2014-00558
	Control No. 95/001,679
	Control No. 95/001,682

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<sup>1</sup> The Board denied institution of this proceeding on December 13, 2013, and denied rehearing on February 12, 2014.

<sup>2</sup> The Board denied institution of this proceeding on December 13, 2013, and denied rehearing on February 12, 2014.

<sup>3</sup> The Board terminated this proceeding on November 12, 2013.

<sup>4</sup> The Board denied institution of this proceeding on June 5, 2014.

<sup>5</sup> The Board denied institution of this proceeding on June 5, 2014.

Patent	Matter
U.S. Patent No. 7,490,151	Case IPR2013-00354 <sup>6</sup>
	Case IPR2013-00376 <sup>7</sup>
	Case IPR2014-00173 <sup>8</sup>
	Case IPR2014-00610
	Control No. 95/001,697
	Control No. 95/001,714

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<sup>6</sup> The Board denied institution of this proceeding on December 13, 2013, and denied rehearing on February 12, 2014.

<sup>7</sup> The Board terminated this proceeding on November 12, 2013.

<sup>8</sup> The Board denied institution of this proceeding on June 5, 2014.

Patent	Matter
U.S. Patent No. 7,418,504	Case IPR2013-00377 <sup>9</sup>
	Case IPR2013-00393 <sup>10</sup>
	Case IPR2013-00394 <sup>11</sup>
	Case IPR2014-00176 <sup>12</sup>
	Case IPR2014-00177 <sup>13</sup>
	Case IPR2014-00612
	Case IPR2014-00613
	Case IPR2014-00614
	Control No. 95/001,788
	Control No. 95/001,851

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<sup>9</sup> The Board terminated this proceeding on November 12, 2013.

<sup>10</sup> The Board denied institution of this proceeding on December 18, 2013, and denied rehearing on February 12, 2014.

<sup>11</sup> The Board denied institution of this proceeding on December 18, 2013, and denied rehearing on February 12, 2014.

<sup>12</sup> The Board denied institution of this proceeding on June 5, 2014.

<sup>13</sup> The Board denied institution of this proceeding on June 5, 2014.

Patent	Matter
U.S. Patent No. 7,921,211	Case IPR2013-00378 <sup>14</sup>
	Case IPR2013-00397 <sup>15</sup>
	Case IPR2013-00398 <sup>16</sup>
	Case IPR2014-00174 <sup>17</sup>
	Case IPR2014-00175 <sup>18</sup>
	Case IPR2014-00615
	Case IPR2014-00616
	Case IPR2014-00618
	Control No. 95/001,789
	Control No. 95/001,856

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<sup>14</sup> The Board terminated this proceeding on November 12, 2013.

<sup>15</sup> The Board denied institution of this proceeding on December 18, 2013, and denied rehearing on February 12, 2014.

<sup>16</sup> The Board denied institution of this proceeding on December 18, 2013, and denied rehearing on February 12, 2014.

<sup>17</sup> The Board denied institution of this proceeding on June 5, 2014.

<sup>18</sup> The Board denied institution of this proceeding on June 5, 2014.

Patent	Matter
U.S. Patent No. 6,839,759	Control No. 95/001,746
U.S. Patent No. 7,987,274	Case IPR2014-00403 Case IPR2014-00404 Case IPR2014-00483 Case IPR2014-00484
U.S. Patent No. 7,188,180	Control No. 95/001,792 Case IPR2014-00401 Case IPR2014-00405 Case IPR2014-00481 Case IPR2014-00482
U.S. Patent No. 8,504,697	Case IPR2014-00237 Case IPR2014-00238

**C. U.S. Patent Applications Related to the Patent-at-Issue**

The following applications, which stem from the same applications that led to the '181 patent, are currently pending before the Office:

11/839,937	13/615,536	13/890,206	13/950,919
13/080,680	13/615,557	13/903,788	13/615,528
13/181,041	13/617,375	13/911,792	13/620,550
13/285,962	13/617,446	13/911,813	13/950,897
13/475,637	13/620,534	13/950,877	--

**D. Litigations Involving the Patent-at-Issue and/or Related Patents**

The '181 patent and/or other patents that stem from the same applications that led to the '181 patent are at issue in the following cases:

<i>VirnetX Inc. and Science Applications Int'l Corp. v. Cisco Systems, Inc., Apple Inc., Aastra USA, Inc., Aastra Technologies Ltd., NEC Corp., and NEC Corp. of America</i> , No. 6:10-cv-00417 (E.D. Tex.) <sup>19</sup>
<i>VirnetX Inc. and Science Applications Int'l Corp. v. Apple Inc.</i> , No. 6:12-cv-00855 (E.D. Tex.)
<i>VirnetX Inc. v. Apple Inc.</i> , No. 6:11-cv-00563 (E.D. Tex.; consolidated with case No. 6:12-cv-00855)

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<sup>19</sup> NEC and Aastra have entered into a license agreement with VirnetX and have been dismissed from this case. The Cisco portion of the case has concluded with a final judgment. The only remaining defendant in this case is Apple. The district court entered judgment in favor of VirnetX against Apple, and Apple has appealed that judgment to the Federal Circuit.

*VirnetX Inc. and Science Applications Int'l Corp. v.*

*Apple Inc.*, No. 6:13-cv-00211 (E.D. Tex.)

*VirnetX Inc. and Science Applications Int'l Corp. v.*

*Microsoft Corp.*, No. 6:13-cv-00351 (E.D. Tex.)

### III. Lead and Back-Up Counsel and Service Information

In accordance with 37 C.F.R. § 42.8(b)(3) and (b)(4), Patent Owner identifies the following lead and back-up counsel and service information:

Lead Counsel	Back-Up Counsel
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Respectfully submitted,

Dated: June 17, 2014

By:           /Joseph E. Palys/            
Joseph E. Palys  
Reg. No. 46,508

Counsel for Patent Owner

**Certificate of Service**

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Petitioner a true and correct copy of the foregoing Updated Patent Owner's Mandatory Notices Pursuant to 37 C.F.R. § 42.8 by electronic means on June 17, 2014 at the following address of record:

Jeffrey P. Kushan  
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Respectfully submitted,

Dated: June 17, 2014

By:           /Joseph E. Palys/            
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