

Paper No. _____
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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 IPR2014-00486
Patent 8,051,181

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

VirnetX Inc., the Patent Owner, provides the following 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 ¹
	Case IPR2013-00349 ²
	Case IPR2013-00375 ³
	Case IPR2014-00171
	Case IPR2014-00172
	Control No. 95/001,679
	Control No. 95/001,682

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

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

³ The Board terminated this proceeding on November 12, 2013.

Patent	Matter
U.S. Patent No. 7,490,151	Case IPR2013-00354 ⁴
	Case IPR2013-00376 ⁵
	Case IPR2014-00173
	Control No. 95/001,697
	Control No. 95/001,714

⁴ The Board denied institution of this proceeding on December 13, 2013, and denied rehearing on February 12, 2014.

⁵ The Board terminated this proceeding on November 12, 2013.

Patent	Matter
U.S. Patent No. 7,418,504	Case IPR2013-00377 ⁶
	Case IPR2013-00393 ⁷
	Case IPR2013-00394 ⁸
	Case IPR2014-00176
	Case IPR2014-00177
	Control No. 95/001,788
	Control No. 95/001,851

⁶ The Board terminated this proceeding on November 12, 2013.

⁷ The Board denied institution of this proceeding on December 18, 2013, and denied rehearing on February 12, 2014.

⁸ The Board denied institution of this proceeding on December 18, 2013, and denied rehearing on February 12, 2014.

Patent	Matter
U.S. Patent No. 7,921,211	Case IPR2013-00378 ⁹
	Case IPR2013-00397 ¹⁰
	Case IPR2013-00398 ¹¹
	Case IPR2014-00174
	Case IPR2014-00175
	Control No. 95/001,789
U.S. Patent No. 6,839,759	Control No. 95/001,856
	Control No. 95/001,746
U.S. Patent No. 7,987,274	Case IPR2014-00403
	Case IPR2014-00404
	Case IPR2014-00483
	Case IPR2014-00484

⁹ The Board terminated this proceeding on November 12, 2013.

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

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

Patent	Matter
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.) ¹²
<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)

¹² NEC and Aastra have entered into a license agreement with VirnetX and have been dismissed from this case. The only remaining defendants in this case are Apple and Cisco. The district court entered judgment in favor of VirnetX against Apple, and Apple has appealed that judgment to the Federal Circuit. The Cisco portion of the case remains pending at the district court, which is considering post-trial issues.

<i>VirnetX Inc. and Science Applications Int'l Corp. v.</i> <i>Apple Inc.</i> , No. 6:13-cv-00211 (E.D. Tex.)
<i>VirnetX Inc. and Science Applications Int'l Corp. v.</i> <i>Microsoft Corp.</i> , 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: March 28, 2014

By: /Joseph E. Palys/
Joseph E. Palys
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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 Patent Owner's Mandatory Notices Pursuant to 37 C.F.R. § 42.8 by electronic means on March 28, 2014 at the following address of record:

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Respectfully submitted,

Dated: March 28, 2014

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