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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 IPR2015-00812
Patent No. 8,850,009

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**Patent Owner's Request for Rehearing Under 37 C.F.R. § 42.71(d)(1)**

# TABLE OF CONTENTS

**Page**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED .....1

II. LEGAL STANDARD .....1

III. STATEMENT OF REASONS FOR RELIEF REQUESTED .....2

A. The Board Legally Erred by Overlooking the Absence of Evidence in Apple's Petition Tending to Show That RFC 2401 Is a Printed Publication .....2

B. The Board Erroneously Found That RFC 2401 Included Indicia Sufficient to Establish a Reasonable Likelihood That RFC 2401 Is a Printed Publication .....7

IV. CONCLUSION.....10

# TABLE OF AUTHORITIES

**Page(s)**

## Cases

*Apple Inc. v. DSS Technology Management, Inc.*,
IPR2015-00369, Paper No. 9 (June 25, 2015).....3, 4, 6

*Apple Inc. v. DSS Technology Management, Inc.*,
IPR2015-00369, Paper No. 14 (August 12, 2015) .....1, 3, 6, 10

*Dish Network L.L.C. v. Dragon Intellectual Property, LLC*,
IPR2015-00499, Paper No. 7 (July 17, 2015) .....3, 4, 10

*Elec. Frontier Found. v. Pers. Audio, LLC*,
IPR2014-00070, Paper No. 21 (Apr. 18, 2014).....9

*Google Inc. v. Art+Com Innovationpool GMBH*,
IPR2015-00788, Paper No. 7 (September 2, 2015).....3, 4, 6, 8

*In re Lister*,
583 F.3d 1307 (Fed. Cir. 2009) .....8, 9

*Samsung Elecs. Co. v. Rembrandt Wireless Techs., LP*,
IPR2014-00514, Paper No. 18 (Sep. 9, 2014).....9

*Square Inc. v. Unwired Planet, LLC*,
CBM2014-00156, Paper No. 22 (Feb. 26, 2015) .....4, 6

*Symantec Corp. v. Trustees of Columbia Univ. in the City of N.Y.*,
IPR2015-00371, Paper No. 13 (July 17, 2015) .....*passim*

## Statutes

35 U.S.C. § 314(a) .....4, 6

## Other Authorities

37 C.F.R. § 42.71(c).....1

37 C.F.R. § 42.71(d) .....1

37 C.F.R. § 42.104(b)(5).....5, 9

## I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Patent Owner VirnetX Inc. requests rehearing of the Patent Trial and Appeal Board's Decision entered September 11, 2015 ("Decision"), instituting an *inter partes* review of U.S. Patent No. 8,850,009 ("the '009 patent"). As explained in Patent Owner's Preliminary Response (Paper No. 6), the Petition (Paper No. 1) fails to establish a reasonable likelihood of prevailing with respect to any claim of the '009 patent and should be denied. Nonetheless, the Board instituted review and in doing so, it legally erred and overlooked certain matters with respect to whether Apple met its burden to show that one of the references at issue is a printed publication.

## II. LEGAL STANDARD

"A party dissatisfied with a decision may file a request for rehearing." 37 C.F.R. § 42.71(d). "The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." *Id*.

Institution decisions are reviewed on rehearing for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a "decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment." *Apple Inc. v. DSS Technology Management, Inc*., IPR2015-00369, Paper No. 14 at 3 (August 12, 2015) (hereinafter *DSS Technology*

*Management Rehearing Decision*) (citing *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988)).

## III. STATEMENT OF REASONS FOR RELIEF REQUESTED

Patent Owner respectfully requests rehearing of the Decision because the Board overlooked that the Petition offered no evidence tending to show that RFC 2401 (Ex. 1008) is a printed publication. Petitioner made only the naked assertion that "RFC 2401 (Ex. 1008) was published in November 1998." (Pet. at 26.) The absence of evidence should have been enough for the Board to deny institution. But the Board overlooked this deficiency in Apple's Petition, and found that Apple "made a threshold showing that RFC 2401 constitutes a prior art printed publication." (Decision at 7.) In doing so, the Board found that RFC 2401 included "indicia suggest[ing] that there is a reasonable likelihood the document was made available to the public . . . ." (*Id*.) The Board's own case law, however, contradicts the Board's conclusion that such "indicia" were sufficient to meet Apple's burden of establishing that RFC 2401 constitutes a printed publication.

### A. The Board Legally Erred by Overlooking the Absence of Evidence in Apple's Petition Tending to Show That RFC 2401 Is a Printed Publication

As explained in the Preliminary Response, to establish that RFC 2401 is a printed publication, the Petitioner must establish that RFC 2401 would have been sufficiently accessible to the public interested in the art on the alleged publication

date. (Prelim. Resp. at 2-3.) Indeed, the Board's case law is quite clear on this point. *See, e.g.*, *DSS Technology Management Rehearing Decision*, IPR2015-00369, Paper No. 14 at 5-8 (explaining that for a petition to even be instituted, the Petition must present sufficient evidence tending to show that a publication was publicly accessible as of the alleged publication date); *Symantec Corp. v. Trustees of Columbia Univ. in the City of N.Y.*, IPR2015-00371, Paper No. 13 at 5-9 (July 17, 2015) (same); *Dish Network L.L.C. v. Dragon Intellectual Property, LLC*, IPR2015-00499, Paper No. 7 at 10-11 (July 17, 2015) (same); *Google Inc. v. Art+Com Innovationpool GMBH*, IPR2015-00788, Paper No. 7 at 6-11 (September 2, 2015) (same).

Petitioner, however, falls short of meeting its burden because, as noted in Patent Owner's Preliminary Response, the Petition does nothing more than make the naked assertion that "RFC 2401 (Ex. 1008) was published in November 1998." (Prelim. Resp. at 3, citing Pet. at 26.) The Board has denied institution in similar situations several times. For instance, in *DSS Technology Management*, where Apple was also the Petitioner, Apple asserted, without more, that a cited reference (Barber, an archived MIT Thesis) "was published at least as early as April 11, 1996." *Apple Inc. v. DSS Technology Management, Inc.*, IPR2015-00369, Paper No. 9 at 12 (June 25, 2015) (hereinafter *DSS Technology Management Institution Decision*). There, the Board denied institution because the Petition lacked any

explanation or citation to evidence tending to show that Barber became publicly accessible as of April 11, 1996—the date stamped on the cover of Barber. *Id*. Citing to 35 U.S.C. § 314(a), which states that an institution decision must be made based on "the information presented in the petition," the Board explained that Apple's naked assertion of a publication date without more did not meet the threshold for institution. *Id*.

The Board's decision in *DSS Technology Management* is not without precedent. In *Square Inc. v. Unwired Planet, LLC*, CBM2014-00156, Paper No. 22 at 4-5 (Feb. 26, 2015), the Petitioner likewise made a naked assertion that the cited reference (Vazvan) was published on September 30, 1996 (the alleged publication date). The Board denied institution because *the Petition* lacked any explanation regarding the significance of the September 30, 1996, date printed on the cover of Vazvan. *Id*. at 5-7. Specifically, the Board explained that "despite the copyright notice in this case, **we do not assume facts that Petitioner must prove in its Petition**, namely, that the September 30, 1996, ISBN date that appears on the face of Vazvan *is its publication date* and that, as of that date, Vazvan was *publicly accessible*." *Id*. at 6-7 (emphasis in bold). Several other cases take the same approach as the Board in *DSS Technology Management* and *Square*. *See, e.g*., *Dish Network*, Paper No. 7 at 10-11; *Google*, Paper No. 7 at 6-11; *Symantec*, Paper No. 13 at 5-9.

Like the Petitions in *DSS Technology Management* and *Square*, Apple's Petition here (similar to its Petition in *DSS Technology Management*), includes nothing more than a naked assertion that "RFC 2401 (Ex. 1008) was published in November 1998." (Pet. at 26; *see also* Prelim. Resp. at 3, 4, 6.) Following the same protocol Apple followed in its petition in *DSS Technology Management*, Apple did not offer any explanation *in its Petition* as to why November 1998 is the publication date of RFC 2401 and how RFC 2401 was publicly accessible as of November 1998. (*Id*.)

Nevertheless, the Board found that Apple "made a threshold showing that RFC 2401 constitutes a prior art printed publication." (Decision at 7.) To support this finding, the Board performed its own analysis of RFC 2401 and assumed that (1) RFC 2401 was actually published on November 1998, and (2) that as of November 1998, RFC 2401 was sufficiently accessible to the public interested in the art—despite that nothing that Apple presented links the November 1998 date with public accessibility in RFC 2401. (*Id*.) In doing so, the Board erred in presuming facts that the Petitioner not only failed to establish, but failed to even attempt to show a reasonable likelihood of, in its Petition. *See Square*, Paper No.

22 at 6-7.[1] Indeed, the Board's decision is at odds with its own prior decisions and additionally violates 35 U.S.C. § 314(a), which requires the Board "to decide whether to institute a trial based on 'the information presented in the petition.'" *DSS Technology Management Institution Decision*, Paper No. 9 at 12; *see also DSS Technology Management Rehearing Decision*, Paper No. 14 at 11. Therefore, Patent Owner respectfully submits that the Board legally erred in finding that Apple met its threshold burden of proving that RFC 2401 is a printed publication and available as prior art in this proceeding.

[1] The Decision cites to Dr. Tamassia's declaration to support its conclusion. (*See* Decision at 7, citing Ex. 1005 at ¶¶ 148–155.) But the Board overlooked that the Petition never cites to or discusses this testimony. (Prelim. Resp. at 4, n.1.) Accordingly, it was improper for the Board to give any weight to this testimony. 37 C.F.R. § 42.104(b)(5); *see also Google*, Paper No. 7 at 10 (declining to give any weight to expert testimony regarding public accessibility because it was neither cited nor discussed in the Petition). As discussed in the next section and in the Preliminary Response, even if given weight, Dr. Tamassia's testimony cannot and does not establish that RFC 2401 was publicly accessible as of November 1998.

### B. The Board Erroneously Found That RFC 2401 Included Indicia Sufficient to Establish a Reasonable Likelihood That RFC 2401 Is a Printed Publication

The Board contends that RFC 2401 includes "indicia suggest[ing] that there is a reasonable likelihood the document was made available to the public . . . ." (Decision at 7.) The Board's rationale for this conclusion is that "[o]n its face . . . RFC 2401 is a dated 'Request for Comments' from the 'Network Working Group,' discussing a particular standardized security protocol for the Internet." (*Id*.) Furthermore, "RFC 2401 describes itself as a 'document [that] specifies an Internet standards track protocol for the Internet community, and requests discussion and suggestions for improvements . . . . Distribution of this memo is unlimited.'" (*Id*.) The Board's case law, however, demonstrates that these "indicia" are insufficient to constitute even a preliminary showing that RFC 2401 would have been sufficiently accessible to the public interested in the art as of November 1998.

For example, in *Symantec*, the Petitioner submitted as prior art a thesis whose cover page contained a date "March 1999," with the further notation "[a]pproved for public release; distribution unlimited." IPR2015-00371, Paper No. 13 at 6-7. The Board acknowledged these notations, but denied institution because Petitioner had "not provided evidence . . . tending to show when the thesis *actually* may have been released or distributed to the public." *Id*. at 8-9 (emphasis added). The Board explained that "[t]he Petition points to no evidence, however, that the

thesis was entered into an electronic database prior to the critical date, much less into a publicly accessible database prior to the critical date." *Id*. Similarly, in *Google*, the Board held that the notation "Approved for Public Release; Distribution Unlimited," on a cited reference was not a sufficient indicia of public accessibility because "[i]t is not enough that a reference is accessible, we must 'consider whether *anyone* would have been able to learn of its existence and potential relevance.'" IPR2015-00788, Paper No. 7 at 9-10 (emphasis added), citing *In re Lister*, 583 F.3d 1307, 1314 (Fed. Cir. 2009).

As in *Symantec*, RFC 2401's notation that "Distribution of this memo is unlimited" does not indicate that RFC 2401 was "*actually* . . . released or distributed to the public" to meet the requirement of public accessibility. IPR2015-00371, Paper No. 13 at 8-9 (emphasis added); (*see also* Prelim. Resp. at 4). Indeed, there are insufficient indicia of public accessibility because there is simply no evidence in RFC 2401 or in the Petition tending to show that any researcher interested in RFC 2401 could "locate and examine the reference." *In re Lister*, 583 F.3d at 1311.

While RFC 2401 is purportedly from a "Network Working Group" and is a "protocol for the Internet community, [requesting] discussion and suggestions for improvements," these vague statements provide no indication as to who is in the "Network Working Group" or the "Internet community," what the size of these

groups was as of November 1998, or whether anyone outside these groups could locate and examine RFC 2401 as of November 1998. *Id*.; (*see also* Prelim. Resp. at 5, 6, citing *Samsung Elecs. Co. v. Rembrandt Wireless Techs., LP*, IPR2014-00514, Paper No. 18 at 5-8 (Sep. 9, 2014) (finding that the petitioner had failed to establish that a Draft IEEE Standard qualified as a printed publication because the petitioner did not provide evidence as to whether the Draft Standard was made available to persons outside of the IEEE "Working Group" responsible for the Draft Standard and how members of the public would have known about the Draft Standard); *Elec. Frontier Found. v. Pers. Audio, LLC*, IPR2014-00070, Paper No. 21 at 22-24 (Apr. 18, 2014) (finding that a reference was not a printed publication where a "Petitioner fail[ed] to provide any information regarding [a reference] posting, the group [to which the reference was posted], who is in the group, or the size of the group.").)

Furthermore, like in *Symantec*, the Petition presents no evidence that the version of RFC 2401 with the November 1998 date on it was placed in a database or similar location that would have allowed anyone interested in RFC 2401 to retrieve and examine it. IPR2015-00371, Paper No. 13 at 8-9. Accordingly, the Board erred in concluding that RFC 2401 includes "indicia" sufficient to constitute a preliminary showing that RFC 2401 would have been sufficiently accessible to the public interested in the art as of November 1998.

Moreover, Dr. Tamassia's testimony does not provide evidence sufficient to make a preliminary showing that RFC 2401 was publicly accessible as of November 1998.[2] This is because neither Dr. Tamassia nor the Petition establish or even allege that Dr. Tamassia has personal knowledge that RFC 2401 was actually released to the public in November 1998. (Prelim. Resp. at 4.). Neither has Dr. Tamassia been established as someone familiar with, let alone an expert in, the workings of the Internet Engineering Task Force (IETF) – the body responsible for the RFCs such that he can opine on when and how RFC 2401 was made available to the public. Accordingly, Dr. Tamassia's testimony regarding RFC 2401's public accessibility should not be accorded any weight. *See DSS Technology Management Rehearing Decision*, Paper No. 14 at 7-8; *Dish Network*, Paper No. 7 at 11.

## IV. CONCLUSION

In view of the above, Patent Owner respectfully submits that the Board abused its discretion in finding that Apple made a preliminary showing that RFC 2401 is a printed publication. Because all of Apple's proposed rejections rely on

[2] As discussed earlier, Dr. Tamassia's should not be accorded any weight because the Petition never cites to or discusses this testimony. (Prelim. Resp. at 4, n 1.); 37 C.F.R. § 42.104(b)(5).

RFC 2401, the Petition should be denied because Apple has failed to show a reasonable likelihood of prevailing with respect to any claim of the ’009 patent.

Respectfully submitted,

Dated: September 25, 2015

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**Certificate of Service**

I certify that I caused to be served on the counsel identified below a true and correct copy of the foregoing Patent Owner's Request for Rehearing Under 37 C.F.R. § 42.71(d)(1) by electronic means on September 25, 2015:

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