

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

VIRNETX, INC.,

Patent Owner

Case IPR2015-00812

Patent No. 8,850,009

PETITIONER'S UPDATED MANDATORY NOTICES

Petitioner, Apple Inc. (“Petitioner”) submits the following update to its Mandatory Notices to inform the Board about a developments in a related matter. *See Apple Inc. v. OpenTV, Inc.*, IPR2015-0980, Paper 11 (Sept. 28, 2015) at 8 n.2 (parties have a duty to disclose relevant developments in related matters).

On September 29, 2015, a panel of the Patent Trial and Appeal Board issued a decision in an *inter partes* reexamination involving a related patent, U.S. Patent No. 8,051,181, affirming the Examiner's rejection of the claims. *See* Control No. 95/001,949, Appeal No. 2015-004512.

On October 7, 2015, the Board issued decisions instituting trial in two *inter partes* reviews involving related patents. *See* IPR2015-01046 (U.S. Patent No. 6,502,135); IPR2015-01047 (U.S. Patent No. 7,490,151).

Petitioner is also supplementing its disclosure of related matters based on the Board's guidance in the Institution Decision. Paper 8 at 2-3.

A. Mandatory Notices (37 C.F.R. § 42.8(b))

1. Real Party-in-Interest (§ 42.8(b)(1))

The real party in interest of this petition pursuant to § 42.8(b)(1) is Apple Inc. (“Apple”) located at One Infinite Loop, Cupertino, CA 95014.

2. Related Matters (§ 42.8(b)(2))**a. *Patents and Applications***

U.S. Patent No. 8,850,009 (“’009 patent”) is a member of a family of patents issued to Larson et al. and assigned to VirnetX, Inc. Like the ’009 patent (Ex. 1003 at Face), the following patents claim priority to U.S. Provisional Application Nos. 60/106,261 and 60/137,704: 6,502,135; 6,618,761; 6,826,616; 6,834,310; 6,839,759; 6,907,473; 7,010,604; 7,133,930; 7,188,180; 7,418,504; 7,490,151; 7,921,211; 7,933,990; 7,945,654; 7,987,274; 7,996,539; 8,051,181; 8,458,341; 8,504,696; 8,504,697; 8,516,117; 8,516,131; 8,521,888; 8,554,899; 8,560,705; 8,572,247; 8,843,643; 8,850,009; 8,868,705; 8,874,771; 8,904,516; 8,943,201; 9,027,115; 9,037,713; 9,038,163; 9,077,694; 9,077,695; 9,094,399; and 9,100,375.

The following pending patent applications claim priority to U.S. Provisional Application Nos. 60/106,261 and 60/137,704: 13/475,637; 13/615,528; 13/617,375; 13/620,534; 13/620,550; 13/890,206; 13/950,897; 14/526,669; 14/702,630; 14/704,938; 14/710,470; and 14/815,869.

b. *District Court Litigation*

Upon information and belief, the ’009 patent has not been asserted in district court litigation.

The following district court proceedings involve patents related to the ’009 patent that may affect or be affected by a decision in this proceeding.

Case/Matter	Status	Asserted Patents
<i>VirnetX Inc. v. Apple Inc.</i> , Case. No. 6-13-cv-00581 (E.D. Tex.)	Pending against Apple	8,504,697
<i>VirnetX Inc. v. Microsoft Corporation</i> , Case No. 6-13-cv-00351 (E.D. Tex.)	Dismissed with prejudice	6,502,135; 7,188,181; 7,418,504; 7,490,151; 7,921,211; 7,987,274
<i>VirnetX Inc. v. Apple Inc.</i> , Case. No. 6-13-cv-00211 (E.D. Tex.)	Pending against Apple	6,502,135; 7,418,504; 7,490,151; 7,921,211
<i>VirnetX Inc. v. Apple Inc.</i> , Case. No. 6-12-cv-00855 (E.D. Tex.)	Pending against Apple	6,502,135; 7,418,504; 7,490,151; 7,921,211; 7,188,181; 8,504,697
<i>VirnetX Inc. v. Apple Inc.</i> , Case. No. 6-11-cv-00563 (E.D. Tex.)	Pending against Apple	7,188,181
<i>VirnetX Inc. v. Mitel Network Corporation</i> , Case. No. 6-11-cv-00018 (E.D. Tex.)	Dismissed with prejudice	6,502,135; 7,418,504; 7,921,211
<i>VirnetX Inc. v. Cisco Systems, Inc.</i> , Case. No. 6-10-cv-00417 (E.D. Tex.) <i>VirnetX Inc. v. Apple Inc.</i> , Case Nos. 15-1934, 15-1935 (Fed. Cir.)	Pending against Apple after remand	6,502,135; 6,839,759; 7,188,180; 7,418,504; 7,490,151; 7,921,211
<i>VirnetX Inc. v. Microsoft Corporation</i> , Case. No. 6-10-cv-00094 (E.D. Tex.)	Dismissed with prejudice	6,502,135; 7,188,180
<i>VirnetX Inc. v. Microsoft Corporation</i> , Case. No. 6-07-cv-00080 (E.D. Tex.)	Dismissed with prejudice	6,502,135; 6,839,759; 7,188,180
<i>In the matter of Certain Devices with Secure Communication</i>	Terminated	8,051,181

<i>Capabilities, Components thereof, and Products Containing the Same</i> (U.S. Int'l Trade Comm'n), Investigation No. 337-TA-858		
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c. Patent Office Proceedings

The following proceedings before the United States Patent and Trademark Office involve patents related to the '009 patent and may affect or be affected by a decision in this proceeding. Proceedings identified by an asterisk (*) were filed by Apple.

Patent	Matter	Status
6,502,135	IPR2013-00348*	Institution Denied
	IPR2013-00349*	Institution Denied
	IPR2013-00375	Terminated
	IPR2014-00171	Institution Denied
	IPR2014-00172	Institution Denied
	IPR2014-00558	Institution Denied
	IPR2014-01046	Trial Instituted
	Control No. 95/001,682*	Pending before the Central Reexam Unit; RAN issued on 9/15/2015
	Control No. 95/001,679	Pending before the Central Reexam Unit; RAN issued on 9/15/2015
6,839,759	Control No. 95/001,746;	Pending; Examiner's decision on appeal

Patent	Matter	Status
	Appeal No. 2015-007843	to the PTAB
7,188,180	IPR2014-00401	Institution Denied
	IPR2014-00405	Institution Denied
	IPR2014-00481*	Final Written Decision; Patent Owner notice of appeal due 10/26/2015
	IPR2014-00482*	Final Written Decision; Patent Owner notice of appeal due 10/26/2015
	IPR2014-01418	Institution Denied
	IPR2014-01421	Institution Denied
	Control No. 95/001,792; Appeal No. 2014-000591	Pending; remanded to Examiner after PTAB Decision
7,418,504	IPR2013-00377	Terminated
	IPR2013-00393*	Institution Denied
	IPR2013-00394*	Institution Denied
	IPR2014-00176	Institution Denied
	IPR2014-00177	Institution Denied
	IPR2014-00612	Institution Denied
	IPR2014-00613	Terminated
	IPR2014-00614	Terminated
	IPR2015-00188*	Institution Denied
	IPR2015-00189*	Institution Denied

Patent	Matter	Status
	Control No. 95/001,788*	Appeal of RAN pending before PTAB for decision
	Control No. 95/001,851	Appeal of RAN pending before Examiner's answer
7,490,151	IPR2013-00354*	Institution Denied
	IPR2013-00376	Terminated
	IPR2014-00173	Institution Denied
	IPR2014-00610	Terminated
	IPR2015-00187*	Institution Denied
	IPR2015-01047	Trial Instituted
	Control No. 95/001,697*	Pending before the Central Reexam Unit
	Control No. 95/001,714	Pending before the Central Reexam Unit
7,921,211	IPR2013-00378	Terminated
	IPR2013-00397*	Institution Denied
	IPR2013-00398*	Institution Denied
	IPR2014-00174	Institution Denied
	IPR2014-00175	Institution Denied
	IPR2014-00615	Terminated
	IPR2014-00616	Institution Denied
	IPR2014-00618	Terminated
	IPR2015-00185*	Institution Denied

Patent	Matter	Status
	IPR2015-00186*	Institution Denied
	Control No. 95/001,789*	Appeal of RAN pending before PTAB for decision
	Control No. 95/001,856	Appeal of RAN pending before PTAB for decision
7,987,274	IPR2014-00403	Final Written Decision; Patent Owner filed notice of appeal on 9/28/15
	IPR2014-00404	Final Written Decision; Patent Owner filed notice of appeal on 9/28/15
	IPR2014-00483*	Final Written Decision; Patent Owner filed notice of appeal on 9/28/15
	IPR2014-00484*	Final Written Decision; Patent Owner filed notice of appeal on 9/28/15
8,051,181	IPR2015-00485*	Institution Denied
	IPR2015-00486*	Institution Denied
	Control No. 95/001,949*; Appeal No. 2015-004512	The PTAB affirmed Examiner rejections in decision dated 9/29/15
8,458,341	IPR2015-00866*	Trial Instituted
	IPR2015-00867*	Institution Denied
8,504,697	IPR2014-00237*	Final Written Decision; Patent Owner filed notice of appeal on 7/10/2015
	IPR2014-00238*	Final Written Decision; Patent Owner filed notice of appeal on 7/10/2015
8,516,131	IPR2015-00868*	Trial Instituted

Patent	Matter	Status
	IPR2015-00869*	Institution Denied
8,560,705	IPR2015-00870*	Trial Instituted
	IPR2015-00871*	Trial Instituted
8,843,643	IPR2015-01009*	Pending
	IPR2015-01010*	Pending
8,850,009	IPR2015-00812*	Trial Instituted
	IPR2015-00813*	Institution Denied
8,868,705	IPR2015-00810*	Trial Instituted
	IPR2015-00811*	Trial Instituted

3. Lead and Backup Counsel (§ 42.8(b)(3))

Lead Counsel is: Jeffrey P. Kushan (Reg. No. 43,401), jkushan@sidley.com, (202) 736-8914. Back-Up Lead Counsel are: Scott Border (*pro hac vice*), sborder@sidley.com, (202) 736-8818; and Thomas A. Broughan III (Reg. No. 66,001), tbroughan@sidley.com, (202) 736-8314.

4. Service Information (§ 42.8(b)(4))

Service on Petitioner may be made by e-mail (iprnotices@sidley.com), mail or hand delivery to: Sidley Austin LLP, 1501 K Street, N.W., Washington, D.C. 20005. The fax number for lead and backup lead counsel is (202) 736-8711.

Dated: October 7, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 7th day of October, 2015, I caused to be served a true and correct copy of the foregoing Petitioner's Updated Mandatory Notices on the following counsel for Patent Owner:

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Dated: October 7, 2015

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