Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

VIRNETX, INC.,

Patent Owner

Case No. IPR2015-00812
Patent No. 8,850,009

PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)

Table of Contents

I. Introduction

Petitioner Apple Inc. ("Petitioner") respectfully moves to submit Exhibits 1060 to 1065[1] as supplemental information under 37 C.F.R. § 42.123(a). Each exhibit is relevant to a claim at issue in this trial, as required by § 42.123(a)(2), because each is evidence that RFC 2401 was published and publicly available in November 1998. The exhibits include a declaration and deposition testimony concerning the public availability of RFC 2401 and numerous other RFCs by Sandy Ginoza, a representative of the Internet Engineering Task Force ("IETF"), and additional documentation that addresses RFC 2401's public availability.

The Board should admit these exhibits into the record because they are "additional evidence that allegedly confirms the public accessibility of" prior art references at issue in this trial. *Palo Alto Networks, Inc v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3 (Feb. 5, 2014). So, apart from being relevant to the claims at issue, these exhibits merely supplement information already present in the record, do not alter the scope of the instituted grounds, and their consideration

[1] Petitioner has moved to submit Exhibits 1057 to 1065 as supplemental information in the proceedings that primarily rely on Aventail (IPR2015-00811 and -00871), and Exhibits 1060 to 1065 in the proceedings that primarily rely on Beser (IPR2015-00810, -00812, -00866, -00868, and -00871).

will not unduly delay the trial's schedule. *Id.* at 3-4 (granting motion under § 42.123(a) based on consideration of these factors). Accordingly, Petitioner respectfully requests that its motion be granted.

II. Background

A. Legal Standard

A party may submit supplemental information under 37 C.F.R. § 42.123(a) if: (1) a "request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted" and (2) the "supplemental information [is] relevant to a claim for which the trial has been instituted." Unlike supplemental information submitted later in trial (§ 42.123(b)) or information not relevant to a claim for which trial was instituted (§ 42.123(c)), a motion under § 42.123(a) need not "show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice."

Instead, under § 42.123(a) the Board has considered whether the information changes "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*, IPR2013-00369, Paper 37 at 3; *see also Biomarin Pharma. Inc., v. Genzyme Therapeutic Prods Limited Partnership*, IPR2013-00534, Paper 80 at 5 (Jan. 7, 2015) (considering the same factors under §

42.123(b)). The Board has also considered whether granting the motion would prevent the just, speedy, and inexpensive resolution of the proceeding, *Palo Alto*, IPR2013-00369, Paper 37 at 4, or would prejudice the other party, *Unified Patents Inc., v. Dragon Intellectual Property, LLC*, IPR 2014-01252, Paper 43 at 3 (Apr. 14, 2015); *see also Rackspace US, Inc. v. Personal Web Techs., LLC*, IPR2014-00058, Paper 16 at 6 (Apr. 30, 2014) (denying motion to submit supplemental expert report that was presented to challenge the Board's claim constructions).

Where a party has sought to submit information that confirms the public accessibility of a prior art reference at issue in the trial, the Board has repeatedly found such evidence to be proper supplemental information. *See, e.g.*, *Biomarin*, IPR2013-00534, Paper 80 at 5 (granting motion under stricter standard of § 42.123(b)); *Valeo North Am., Inc. v. Magna Elecs, Inc.*, IPR2014-01204, Paper 26 at 2-5 (Apr. 10, 2015); *Palo Alto Networks*, IPR2013-00369, Paper 37 at 2-5; *Motorola Sol'ns, Inc. v. Mobile Scanning Techs, LLC*, IPR2013-00093, Paper 39 at 2 (July 16, 2013). As the Board has recognized, "a trial is, first and foremost, a search for the truth." *Edmund Optics, Inc., v. Semrock, Inc.*, IPR2014-00599, Paper 44 at 4 (May 5, 2015) (granting motion to submit supplemental information) (citing *TechSearch LLC v. Intel Corp.*, 286 F.3d 1360, 1378 (Fed. Cir. 2002)).

B. This Proceeding

On September 11, 2015, the Board instituted trial in this proceeding on

several grounds based on the combination of U.S. Patent No. 6,496,867 ("Beser") and RFC 2401, "Security Architecture for the Internet Protocol" ("RFC 2401"). *See* Paper 8 at 2-3, 7, 14. The Board found that the evidence supported a finding that RFC 2401 is a prior art printed publication. *Id.* at 7-8. In several papers it filed in this proceeding, Patent Owner VirnetX, Inc. has raised challenges as to whether RFC 2401 was publicly available. In its Preliminary Response and Request for Rehearing, Patent Owner VirnetX Inc. contended that RFC 2401 was not accessible to the public as of the relevant date to qualify as prior art in this proceeding. *See* Paper 6 at 2-6; Paper 12 at 7-10.

III. Argument

A. Petitioner's Motion Is Timely and the Supplemental Information Is Relevant as Required by § 42.123(a)

Petitioner requested authorization to file a motion to submit supplemental information via email on October 8, 2015, within one month of institution of trial. Thus, Petitioner's motion is timely under § 42.123(a)(1). In addition, the information Petitioner requests to submit into the record is "relevant to a claim [at issue in] the trial" as required by § 42.123(a)(2). As explained below, each exhibit is relevant because it supports Petitioner's assertions and the Board's preliminary findings about the publication and public availability of RFC 2401. Petitioner thus submits that the supplemental information is proper under § 42.123(a)(1) and should be entered into the record.

Exhibits 1060-1065 are evidence that RFC 2401 is a printed publication that was publicly available via the Internet by November 1998. *See* Paper 8 at 7-8; Ex. 1005 at ¶¶ 148-155; Ex. 1036 at 6, 8; Pet. at 26.

Exhibit 1060 is a declaration from Sandy Ginoza, acting as a designated representative of the IETF, created in response to a subpoena served as part of an investigation initiated by Patent Owner before the International Trade Commission (337-TA-858). Ex. 1060 at ¶¶ 1-5; Ex. 1063 at 6:23-7:4, 10:5-14. In her declaration, Ms. Ginoza testified that RFC 2401 was published on the RFC Editor's website and was publicly available in November 1998. Ex. 1060 at ¶¶ 105-107. For example, Ms. Ginoza explained:

> Based on a search of RFC Editor records, I have determined that the RFC Editor maintained a copy of RFC 2401 in the ordinary course of its regularly conducted activities. RFC 2401 has been publicly available through the RFC Editor's web site or through other means since its publication in November 1998.

Ex. 1060 at ¶ 107. Ms. Ginoza similarly testified that numerous other RFCs were published on the RFC Editor's website and were publicly available since the date on the face of the documents. *E.g.*, Ex. 1060 at ¶¶ 168-170. Exhibit 1061 is the bates stamped copy of RFC 2401 that IETF produced in conjunction with Ms. Ginoza's declaration. Exhibit 1062 is a redline comparison showing there are no substantive differences between Exhibit 1061 and Exhibit 1008, the copy of RFC

2401 Petitioner previously filed in this proceeding.

Exhibit 1063 is the transcript of Ms. Ginoza's February 8, 2013 deposition that was taken as part of the ITC action. At her deposition, Ms. Ginoza testified:

> Q []: You've just been handed what's been marked as Exhibit 16. It is titled "Request for Comments: 2401" with a Bates number of 337-TA-858-IETF001122 through 1183. Is that correct?
> A Yes.
> Q Was RFC 2401 produced in response to the subpoena?
> A Yes.
> * * *
> Q Is the document produced at this bits [sic] range a true and correct copy of the record of RFC 2401 as it's kept in the files of the RFC Editor?
> A Yes.
> * * *
> Q Was RFC 2401 publicly available as of the date listed on its face?
> A Yes.
> Q What date was RFC 2401 made publicly available?
> A November 1998.

Ex. 1063 at 39:14-24; *see id.* at 10:5-11:22 (confirming her knowledge of IETF publishing practices as they relate to RFCs). Ms. Ginoza offered similar testimony with respect to numerous other RFCs. *E.g.*, Ex. 1063 at 45:5-46:17. During the February 8, 2013 deposition, Patent Owner cross-examined Ms. Ginoza about her testimony and declaration. *See id.* at 55:3-16; *see also id.* at 50:7-69:1.

Exhibit 1064 is an article from InfoWorld magazine (dated August 16, 1999)

and Exhibit 1065 is an article from NetworkWorld magazine (dated March 15, 1999). Each exhibit is an excerpt from an industry publication that states it was known that RFCs, and RFC 2401 specifically, were publicly available through the Internet, such as through the IETF's website. *See, e.g.*, Ex. 1064 at 9 (discussing RFCs 2401 to 2408 and stating "All of these documents are available on the IETF website: www.ietf.org/rfc.html"); Ex. 1065 at 3 (discussing IP security protocols and stating "See the IETF documents RFC 2401 'Security Architecture for the Internet Protocol' at www.ietf.org/rfc/rfc2401.txt").

These exhibits support Petitioner's assertions that RFC 2401 is prior art to the challenged claims.

B. Consideration of the Supplemental Information Relating to the Public Availability of Prior Art References Is Appropriate

The exhibits proffered by Petitioner satisfies other factors the Board has considered when evaluating motions to submit supplemental information.

First, Petitioner's exhibits provide additional evidence that the prior art for each of the instituted grounds are indeed prior art, and as such 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." *See, e.g.*, *Palo Alto Networks, Inc v. Juniper Networks, Inc*. IPR2013-00369, Paper 37 at 3. Exhibits 1060 to 1065 supplement the information presented with the Petition with respect to RFC 2401, and are additional evidence that an RFC is published as

of the date listed on its face. *See* Pet. at 26; Ex. 1005 at ¶¶ 148-155; Ex. 1036 at 6, 8; *see also* Ex. 1036 at 19-21. Public availability evidence is precisely the type of information that is properly submitted as supplemental information.

Second, Petitioner's supplemental information will not prejudice Patent Owner or delay the proceedings. Patent Owner will have limited need (if any) to investigate the proffered information because Patent Owner already investigated most of the exhibits during one of the concurrent litigation proceedings. Patent Owner received Ms. Ginoza's declaration and RFC 2401 (Exs. 1060-1061) as part of the Section 337 action in 2013, and it had the opportunity to cross-examine Ms. Ginoza about RFC 2401's publication date. *See* Ex. 1063 at 50:7-69:1. In addition, Petitioner has served all of the exhibits on Patent Owner concurrently with this motion.[2]

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[2] Petitioner notes that while some panels of the Board have found it improper to file supplemental information as exhibits concurrently with the filing of the motion, *see, e.g., Unified Patents*, IPR 2014-01252, Paper 43 at 3 ("Our authorization to file the Motion was not an authorization to file the supplemental information as an exhibit with the Motion."), other panels have found that "filing proffered supplemental information" concurrently with the motion "facilitates review of a motion to submit that information," *see, e.g., Valeo*, IPR2014-1204,

Consideration of the supplemental information will not frustrate the Board's ability to complete this proceeding in a timely manner. The evidence supports the Board's preliminary findings, and Patent Owner will have an opportunity to address the evidence in its Patent Owner response.

IV. Conclusion

For the foregoing reasons, Petitioner respectfully requests that it be permitted to submit Exhibits 1060 to 1065 as supplemental information.

Dated: October 16, 2015

Respectfully Submitted,

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Paper 26 at 5. Because the Board did not explicitly authorize Petitioner to file the supplemental information as part of this motion, Petitioner is not concurrently filing it with this motion.

PETITIONER'S MOTION TO SUBMIT

SUPPLEMENTAL INFORMATION

Attachment A:

Exhibit List

Ex. #	Reference Name	Filing Status
1001	U.S. Patent 8,868,705	3/2/2015
1002	U.S. Patent 8,868,705 File History	3/2/2015
1003	U.S. Patent 8,850,009	3/2/2015
1004	U.S. Patent 8,850,009 File History	3/2/2015
1005	Declaration of Roberto Tamassia	3/2/2015
1006	Curriculum Vitae of Roberto Tamassia	3/2/2015
1007	U.S. Patent 6,496,867 to Beser	3/2/2015
1008	Kent, S., et al., RFC 2401, "Security Architecture for the Internet Protocol" (November 1998)	3/2/2015
1009	Aventail Connect v3.01/v2.51 Administrator's Guide (1996-1999)	3/2/2015
1010	Aventail Connect v3.01/v2.51 User's Guide (1996-1999)	3/2/2015
1011	Aventail ExtraNet Center v3.0 Administrator's Guide (NT and UNIX)	3/2/2015
1012	U.S. Patent 5,237,566 to Brand	3/2/2015
1013	Handley, M., et al., RFC 2543, SIP: Session Initiation Protocol (March 1999)	3/2/2015
1014	RFC 793, DARPA Internet Program Protocol Specification (September 1991)	3/2/2015
1015	U.S. Patent Number 6,430,176 to Christie	3/2/2015
1016	U.S. Patent Number 6,930,998 to Sylvain	3/2/2015
1017	Patent Owner Preliminary Response, IPR2014-00237, Paper 12 (March 6, 2014)	3/2/2015
1018	Leech, M., et al., RFC 1928, SOCKS Protocol Version 5 (March 1996)	3/2/2015
1019	Microsoft Computer Dictionary (4th Ed.)	3/2/2015
1020	U.S. Patent Number 6,408,336 to Schneider	3/2/2015
1021	U.S. Patent Number 5,633,934 to Hember	3/2/2015
1022	Exhibit E3 of Reexamination 95/001,697 - Declaration of	3/2/2015

Ex. #	Reference Name	Filing Status
	James Chester	
1023	Exhibit E1 of Reexamination 95/001,697 - Declaration of Chris Hopen,	3/2/2015
1024	U.S. Patent 6,557,037 to Provino	3/2/2015
1025	Gunter, M., "Virtual Private Networks Over the Internet" (1998)	3/2/2015
1026	Patent Owner Preliminary Response, IPR2014-00404, Paper 9 (May 19, 2014)	3/2/2015
1027	von Sommering, S., Space Multiplexed-Electrochemical Telegraph	3/2/2015
1028	Licklider, J.C.R., Memorandum for Members and Affiliates of the Intergalactic Computer Network (December 11, 2001)	3/2/2015
1029	BBN Report No. 1822, Interface Message Processor (January 1976)	3/2/2015
1030	Koblas, D., et al., "SOCKS-Usenix Unix Security Symposium III"	3/2/2015
1031	Windows NT for Dummies	3/2/2015
1032	Mockapetris, P., RFC 882, "Domain Names – Concepts and Facilities" (November 1983)	3/2/2015
1033	Mockapetris, P., RFC 883, "Domain Names – Implementation and Specification" (November 1983)	3/2/2015
1034	Mockapetris, P., RFC 1034, "Domain Names – Concepts and Facilities" (November 1987)	3/2/2015
1035	Mockapetris, P. RFC 1035, "Domain Names – Implementation and Specification" (November 1987)	3/2/2015
1036	Bradner, S., RFC 2026, "The Internet Standards Process – Revision 3" (October 1996)	3/2/2015
1037	Rosen, E., et al., RFC 2547, "BGP/MPLS VPNs" (March 1999)	3/2/2015
1038	W3C and WAP Forum Establish Formal Liason Relationship (December 8, 1999)	3/2/2015
1039	Wireless Application Protocol (WAP) Architecture Specification (April 30, 1998)	3/2/2015
1040	H.323 ITU-T Recommendation (February, 1998)	3/2/2015

Ex. #	Reference Name	Filing Status
1041	Kiuchi, T., et al., "C-HTTP – The Development of a Secure, Closed HTTP-Based Network on the Internet" (IEEE 1996) LOC Stamped	3/2/2015
1042	VirnetX's Opening Claim Construction brief, VirnetX, Inc. v. Cicso Systems, Inc., et al., Civil Action No. 6:10-cv-417 (EDTX) (November 4, 2011)	3/2/2015
1043	Exhibit E2 of Reexamination 95/001,682 - Declaration of Michael Fratto	3/2/2015
1044	U.S. Patent 5,898,830 to Wesinger	3/2/2015
1045	Steiner, J., et al., "Kerberos: An Authentication Service for Open Network Systems" (January 12, 1988)	3/2/2015
1046	Harkins, D., et al., RFC 2409, "The Internet Key Exchange (IKE) (November 1998)	3/2/2015
1047	Maughan, D., et al., "Internet Security Association and Key Management Protocol (ISAKMP)" (November 1998)	3/2/2015
1048	Data-Over-Cable Interface Specifications (DOCIS), Radio Frequency Interface Specification (March 26, 1997)	3/2/2015
1049	[RESERVED]	
1050	[RESERVED]	
1051	[RESERVED]	
1052	[RESERVED]	
1053	[RESERVED]	
1054	[RESERVED]	
1055	[RESERVED]	
1056	[RESERVED]	
1057 [New]	Information Disclosure Statement, U.S. Appl. No. 13/339,257 (May 3, 2012) (issued as U.S. Patent No. 8,504,697), *including* Rough Transcript of April 11, 2012 Deposition of Chris Hopen, *VirnetX Inc. v. Cisco Systems, Inc.*, Case No. 6:10-cv-00417 (E.D. Tex.)	Not filed; prev. served as suppl. evidence per 42.64(b)(2)

Ex. #	Reference Name	Filing Status
1058 [New]	Declaration of Chris Hopen, Control No. 95/001682, *filed as* Exhibit P4 in April 11, 2012 Deposition of Chris Hopen, *VirnetX Inc. v. Cisco Systems, Inc.*, Case No. 6:10-cv-00417 (E.D. Tex.)	Not filed; prev. served as suppl. evidence per 42.64(b)(2)
1059 [New]	Transcript of Jury Trial in *VirnetX v. Microsoft Corporation*, Case No. 6:07-cv-00080, Dkt. No. 398 (E.D. Tex) (March 15, 2010)	Not filed; prev. served as suppl. evidence per 42.64(b)(2)
1060 [New]	Declaration of Sandy Ginoza on behalf of the RFC Publisher for the Internet Engineering Task Force, dated January 23, 2013, submitted in Investigation No. 337-TA-858	Not filed; served with this motion
1061 [New]	Kent, S., et al., RFC 2401, "Security Architecture for the Internet Protocol" (November 1998), bearing Bates Nos. 337-TA-858-IETF001122 through 001183	Not filed; served with this motion
1062 [New]	Redline comparison of Exhibit 1008 (IPR2015-00810) to Exhibit 1061	Not filed; served with this motion
1063 [New]	Transcript of Feb. 8, 2013 deposition of Sandy Ginoza, ITC Inv. No. 337-TA-858	Not filed; served with this motion
1064 [New]	*The Reality of Virtual Private Networks*, InfoWorld, Aug. 16, 1999 (Advertising Supplement)	Not filed; served with this motion
1065 [New]	Mark Gibbs, *IP Security: Keeping your business private*, NetworkWorld, Mar. 15, 1999	Not filed; served with this motion

PETITIONER'S MOTION TO SUBMIT

SUPPLEMENTAL INFORMATION

Attachment B:

Proof of Service

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 16th day of October, 2015, I caused to be served a true and correct copy of the foregoing Petitioner's Motion to Submit Supplemental Information and Exhibits 1060-1065 on the following counsel for Patent Owner:

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Dated: October 16, 2015

Respectfully submitted,

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