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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 IPR2015-00812
Patent 8,850,009

**Patent Owner's Opposition to Petitioner's Motion to Submit
Supplemental Information Pursuant to 37 C.F.R. § 42.123(a)**

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I. Introduction

Patent Owner VirnetX Inc. respectfully requests that the Board deny Petitioner Apple Inc.'s motion to supplement its original Petition with six supplemental exhibits purporting to show that RFC 2401 is a prior art printed publication. The Board's case law under 37 C.F.R. § 42.123(a) is not so broad as to allow for the submission of exhibits that a petitioner purposefully chose to withhold from its original petition, as the Petitioner has done here. Thus, Petitioner's motion should be denied.

II. Argument

37 C.F.R. § 42.123(a) requires a moving party to show that “(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 must be relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a). The Board has held that “nothing in 37 C.F.R. § 42.123 requires that a request to submit supplemental information satisfying these two criteria automatically be granted no matter the circumstance.” *Redline Detection, LLC v. Star Envirotech, Inc.*, IPR2013-00106, Paper No. 35 at 3 (Sept. 11, 2013) (citation omitted). And contrary to Petitioner's claim that the Board does not consider whether a petitioner could have reasonably obtained the supplemental

information earlier under Section 42.123(a) (*see* Mot. at 2), the Board has taken this fact into consideration.

In *VTech Communications, Inc. v. Shperix Inc.*, the Board addressed the petitioner's motion under Section 42.123(a), but still noted that "Petitioner did not explain sufficiently why Petitioner could not have reasonably submitted such evidence with its Petition, as required by 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b)." IPR2014-01431, Paper No. 21 at 3 (Apr. 7, 2015). Likewise, in *Palo Alto Networks, Inc. v. Juniper Networks, Inc.* and *Valeo North America, Inc. v. Magna Electronics, Inc.*, both relied on by Petitioner, the Board noted that there was no evidence that the petitioners intentionally withheld the information. *Palo Alto*, IPR2013-00369, Paper No. 37 at 4 (Feb. 5, 2014); *Valeo*, IPR2014-01204, Paper No. 26 at 4 (Apr. 10, 2015).

Here, the information shows that the Petitioner was in possession of the majority of the supplemental information well prior to the filing of its original Petition and thus must have knowingly omitted them. (*See, e.g.*, Mot. at Attachment A.) As the Board has found, "[t]he intentional delay in obtaining or presenting information to the Board is not in the interest of the efficient administration of the Office, nor does it further the ability of the Office to complete IPR proceedings in a timely manner." *Redline*, IPR2013-00106, Paper No. 35 at 4-5. Section 42.123(a) is not a back door to enter information that Petitioner could

and should have included in its original petition. To allow it to be used in such a manner would be inconsistent with the Board's statutory mandate to provide "just, speedy, and inexpensive resolution of every proceeding."

Section 42.123(a) also should not be used "to bolster the challenges presented originally in the petition, based on feedback gleaned from the decision on institution or patent owner's preliminary response." *Vtech*, IPR2014-01431, Paper No. 21 at 3 (citations omitted). Though Petitioner could have submitted its exhibits with its Petition, Petitioner chose only to make the naked assertion that "RFC 2401 (Ex. 1008) was published in November 1998," relying solely on a date on the face of RFC 2401. (Pet. at 26.) Recognizing its mistake based on Patent Owner's Preliminary Response, Petitioner now improperly attempts to bolster the challenges presented in its Petition with almost 250 pages of exhibits. The sheer volume of pages Petitioner seeks to introduce is prejudicial to Patent Owner. Reviewing all of these pages imposes a great burden on Patent Owner and weighs against the interests of justice. Accordingly, the Board should deny Petitioner's attempt to submit its voluminous supplemental information after institution that should have been submitted with its Petition.¹

¹ Petitioner's motion should also be denied because Petitioner has not shown that all of its supplemental information is relevant to a *reference* upon which trial is instituted, much less to a *claim* for which trial is instituted, as Section 42.123(a)(2)

III. Conclusion

For these reasons, Patent Owner respectfully requests that the Board deny Petitioner's motion to submit supplemental information.

Respectfully submitted,

Dated: October 23, 2015

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requires. *See Redline*, IPR2013-00106, Paper No. 35 at 6. For example, Exhibits 1060 and 1061 relate to a different version of RFC 2401 than that relied upon by Petitioner in its Petition.

CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of October 2015, a copy of the foregoing Patent Owner's Opposition to Petitioner's Motion to Submit Supplemental Evidence Pursuant to 37 C.F.R. § 42.123(a) was served by electronic mail upon the following:

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