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 IPR2015-00812
Patent No. 8,850,009

PATENT OWNER'S MOTION TO EXCLUDE

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I. Precise Relief Requested

Pursuant to 37 C.F.R. § 42.64, Patent Owner VirnetX, Inc. ("Patent Owner") moves to exclude certain exhibits submitted by Apple Inc. ("Petitioner"). This motion is timely filed in accordance with the Board's Scheduling Order (Paper No. 9). In particular, Petitioner requests that Exhibits 1001, 1002, 1009-1035, 1037-1041, 1043-1048, 1060, 1063-1065, 1068, and 1069, and portions of Exhibit 1005 be excluded from the record.

II. Legal Standard

The Federal Rules of Evidence apply to *inter partes* review proceedings. 37 C.F.R. § 42.62(a), Office Patent Trial Practice Guide, 77 Fed. Reg. 48758. Under Federal Rule of Evidence 402, "irrelevant evidence is not admissible." Fed. R. Evid. 402. Also, unless an exception applies, an out of court statement offered for the truth of the matter asserted is inadmissible. Fed. R. Evid. 801, 802.

III. Exhibits 1001, 1002, 1009-1035, 1037-1041, 1043-1048, 1060, 1063-1065, 1068, and 1069, and Portions of Exhibit 1005 Should be Excluded from the Record

The Board should exclude exhibits 1001, 1002, 1009-1035, 1037-1041, 1043-1048, 1060, 1063-1065, 1068, and 1069 because one or more of these exhibits includes evidence that is inadmissible hearsay or the evidence in these exhibits is irrelevant to the instant proceeding. The Board should also exclude portions of Exhibit 1005 because they are irrelevant to the instant proceeding.

Patent Owner timely objected to these exhibits stating the precise grounds under which these exhibits are inadmissible. (Paper Nos. 11, 18, 30.)

A. Exhibits 1060 and 1063-1065 Constitute Inadmissible Hearsay

Exhibits 1060 and 1063-1065 should be excluded as inadmissible hearsay. *See* Fed. R. Evid. 801-802. Patent Owner previously objected to these exhibits on this ground. (Paper No. 18 at 1.) Petitioner has failed to rebut Patent Owner's objections. As such, these exhibits should be excluded.

In its Petition, Petitioner made the naked assertion that RFC 2401 "was published in November 1998." (Pet. at 26.) After trial was instituted, Petitioner submitted additional evidence (Exs. 1060-1065) as supplemental information in support of its contention that RFC 2401 qualified as a printed publication as of November 1998. (Paper No. 17 at 5-7.) Exhibit 1060 is a declaration from Sandy Ginoza, a representative of the IETF, submitted in litigation before the International Trade Commission (337-TA-858) and Exhibit 1063 is a "transcript of Ms. Ginoza's February 8, 2013 deposition that was taken as part of the ITC action." (*Id*. at 5-6.) Exhibit 1064 is allegedly "an article from InfoWorld magazine (dated August 16, 1999)" and Exhibit 1065 is allegedly "an article from NetworkWorld magazine (dated March 15, 1999)." (*Id*. at 6-7.) In its reply to the Patent Owner response, Petitioner further relied on the above exhibits to support its assertion regarding the publication date of RFC 2401. (Reply, Paper No. 28 at 19-

22.) Each of exhibits 1060 and 1063-1065 include out-of-court statements, i.e., statements that were not made for purposes of the present proceeding, and because Petitioner relies on the alleged truth of these out-of-court statements, they constitute hearsay and are inadmissible. Furthermore, in none of the papers that it has submitted so far in this proceeding has Petitioner explained that these out-of-court statements are admissible under a hearsay exception.

For at least the above reasons, the Board should exclude exhibits 1060 and 1063-1065 because they constitute inadmissible hearsay and no exception applies.

B. Exhibits 1001, 1002, 1009-1035, 1037-1041, 1043-1048, 1068, and 1069 Lack Relevance

Exhibits 1001, 1002, 1009-1035, 1037-1041, 1043-1048, 1068, and 1069 should be excluded because they lack relevance. Fed. R. Evid. 401-403. Patent Owner previously objected to these exhibits on this ground. (Paper No. 11 at 2; Paper No. 30 at 1.) Petitioner has failed to rebut Patent Owner's objections. As such, these exhibits should be excluded.

Specifically, each of these exhibits is inadmissible because Petitioner has not established that they are relevant. Fed. R. Evid. 401-403. For instance, Petitioner does not even cite to these exhibits in either the Petition or the Petitioner Reply. (Paper No. 1; Paper No. 28.) Accordingly, each of these exhibits should be excluded from the record.

C. Portions of Exhibit 1005 Lack Relevance

Portions of Exhibit 1005 should be excluded because they lack relevance. Fed. R. Evid. 401-403. Patent Owner previously objected to these portions on this ground. (Paper No. 11 at 1.) Petitioner has failed to rebut Patent Owner's objections. As such, these portions should be excluded.

Specifically, when Petitioner filed Exhibit 1005, which is the declaration of its alleged expert, Dr. Roberto Tamassia, Petitioner made the strategic choice of filing a single declaration for not one but four proceedings (IPR2015-00810, 811, 812, 813) that covered two patents (U.S. 8,868,705 and 8,850,009). (*See generally* Ex. 1005.) Accordingly, vast portions of Exhibit 1005 are simply irrelevant to the instant proceeding. For instance, the current proceeding is based on *Beser* as the primary reference but Dr. Tamassia's declaration includes several pages focusing on *Aventail*, which is irrelevant to the current proceeding. (*See, e.g.*, Ex. 1005 at ¶¶ 160-273, 365-382, 409-13, 421-22, 424-25.) Such irrelevant sections of Dr. Tamassia's declaration should be excluded under FRE 401-403.

IV. Conclusion

For the reasons set forth above, the Board should exclude exhibits 1001, 1002, 1009-1035, 1037-1041, 1043-1048, 1060, 1063-1065, 1068, and 1069 and portions of Exhibit 1005 from the record.

Respectfully submitted,

Dated: May 2, 2016

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Counsel for VirnetX, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 2nd day of May 2016, a copy of the foregoing Patent Owner's Motion to Exclude was served electronically, pursuant to agreement, upon the following:

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