

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
U.S. Patent No. 8,850,009

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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I. Introduction

The evidence of record establishes that Exhibits 1001, 1002, 1005, 1009-1035, 1037-1041, 1043-1048, 1060, 1063-1065, 1068, and 1069 are admissible. Patent Owner has failed to show otherwise, and thus, its motion must be denied. *See* Paper 35 (“Mot.”).

II. Argument

A. Patent Owner's Motion is Facially Deficient

With respect to the exhibits Patent Owner seeks to exclude based on hearsay (Exs. 1060 and 1063-1065), Patent Owner's motion is facially deficient – it does not identify any specific statements in those exhibits alleged to be hearsay. Mot. at 2-3; *see* 37 C.F.R. § 42.22(a)(2). Instead, Patent Owner alleges that the exhibits “*include* out-of-court statements” without identifying them. Mot. at 2-3 (emphasis added). It is not Petitioner's burden to identify purported hearsay – Patent Owner, as the moving party, “has the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c).

Patent Owner's failure to identify the putative hearsay also is prejudicial. For example, if Patent Owner in its reply attempts to cure these deficiencies, Petitioner will have no opportunity to respond. Patent Owner's motion to exclude these exhibits should therefore be denied.

B. Exhibits 1060 and 1063-1065 Are Admissible

Patent Owner moves to exclude Exhibits 1060 and 1063-1065 as inadmissible hearsay. Mot. at 3-4. That motion should be denied, as these exhibits qualify for the residual exception to hearsay. Fed. R. Evid. 807.

Under Federal Rule of Evidence 807, a “statement is not excluded by the rule against hearsay” if: “(1) the statement has equivalent circumstantial guarantees of trustworthiness; (2) it is offered as evidence of a material fact; (3) it is more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts; and (4) admitting it will best serve the purposes of these rules and the interests of justice.” Fed. R. Evid. 807(a). The proponent of the testimony must also give (5) “an adverse party reasonable notice of the intent to offer the statement and its particulars.” Fed. R. Evid. 807(b). Courts are accorded wide discretion in applying this exception. *Doe v. United States*, 976 F.2d 1071, 1076–77 (7th Cir. 1992), *cert. denied* 510 U.S. 812 (1993); *United States v. North*, 910 F.2d 843, 909 (D.C. Cir. 1990) *cert. denied* 500 U.S. 941 (1991).

Exhibits 1060 and 1063 include the testimony of Ms. Sandy Ginoza, Exhibit 1064 is an InfoWorld magazine article from 1999, and Exhibit 1065 is a NetworkWorld magazine article from 1999. Each of these exhibits is relied upon to show that each of RFC 2401 and RFC 2543 were publicly available for

distribution via the Internet prior to February 2000. Reply at 23-25; Paper 17 at 9-11.¹ As explained below, to the extent these exhibits contain statements that are hearsay, they satisfy the residual exception to hearsay, and are admissible.

First, Exhibits 1060 and 1063-1065 have equivalent circumstantial guarantees of trustworthiness. *See* Fed. R. Evid. 807(a)(1). Exhibits 1060 and 1063 contain the prior sworn testimony of Ms. Ginoza and IETF and reflect Patent Owner's cross-examination of Ms. Ginoza on the substance of her testimony. 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 and RFC 2543 were published on the RFC Editor's website and were publicly available before February 2000. Ex. 1060 at ¶¶ 105-107, 168-170. Exhibit 1063 is the transcript of Ms. Ginoza's February 8, 2013 deposition that was taken as part of the ITC action, where she

¹ Exhibits 1064-1065 are also relied upon to show that an interested ordinary artisan, exercising reasonable diligence, would have known how to locate RFC 2401 and RFC 2543. *See* Reply at 23-24; Paper 17 at 11. They are not hearsay when offered for that purpose. *See* Fed. R. Evid. 801(c)(2).

testified RFC 2401 and RFC 2543 were publicly available prior to February 2000. Ex. 1063 at 39:14-24, 45:5-46:17; *see id.* at 10:5-11:22 (confirming her knowledge of IETF publishing practices as they relate to RFCs). Patent Owner cross-examined Ms. Ginoza about her testimony and declaration, but developed no contrary testimony. *See id.* at 50:7-69:1.

This testimony is corroborated by *and* corroborates the disclosure in Exhibits 1064 and 1065, which are excerpts from industry publications that state 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").

Substantial circumstantial guarantees of trustworthiness are also provided by the evidence submitted with Petitioner's original filings, such as the testimony of Dr. Tamassia and RFC 2026. Dr. Tamassia explained that RFCs are the official publication channel for Internet standards, with the publication process described in RFC 2026 (Ex. 1036), Ex. 1005 at ¶¶148-55, which explains that anyone can obtain RFCs from a number of Internet hosts, Ex. 1036 at 5-6, and that each RFC "is made available for review via world-wide on-line directories," *id.* at 4; *see* Ex.

1005 at ¶149. Dr. Tamassia testified from his personal knowledge that RFCs list their publication date in the top corner of the first page (Ex. 1005 at ¶ 152), which in the case of RFC 2401 and RFC 2543 perfectly matches Ms. Ginoza's testimony. *Compare* Ex. 1063 at 40:20-24 (RFC 2401), 46:11-17 (RFC 2543) *with* Ex. 1008 at 1 *and* Ex. 1013 at 1. Further circumstantial guarantees of trustworthiness come from Dr. Monroe's refusal to testify on this topic. *See* Ex. 1066 at 112:25-114:6, 118:10-121:11; *see generally* Ex. 2016.

Second, Exhibits 1060 and 1063-1065 are offered as evidence of a material fact (Fed. R. Evid. 807(a)(2)): the public availability of RFC 2401 and RFC 2543 prior to February 2000. Paper 17 at 9-11.

Third, Exhibits 1060 and 1063-1065 are more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts. *See* Fed. R. Evid. 807(a)(3). The testimony is probative because Ms. Ginoza testified "on behalf of the Internet Engineering Task Force" as a designated corporate representative, (Ex. 1063 at 10:5-22; Ex. 1060 at 1 (entitled "Declaration of the RFC Publisher for the [IETF]")), and, as such, was testifying to "the knowledge of the corporation," *Poole v. Textron, Inc.*, 192 F.R.D. 494, 504 (D. Md. 2000). And, corporate witnesses like Ms. Ginoza commonly testify about publication date of a prior art document. *See, e.g., Ultratec, Inc. v. Sorenson Commc'ns, Inc.*, No. 13-CV-346, 2014 WL 4829173, at *6 (W.D. Wis. Sept. 29,

2014). Ms. Ginoza's testimony was developed during concurrent litigation between the parties, where Patent Owner had an incentive to develop any contrary testimony from Ms. Ginoza on the publication issue. The IETF has also already authenticated and corroborated the publication of RFC 2401 and RFC 2543 in the context of the parties' disputes, and it is not reasonable to force the IETF, who is not a party to these disputes, to do so again.

Fourth, it would be in the interests of justice to admit Exhibits 1060 and 1063-1065. *See* Fed. R. Evid. 807(a)(4). RFC documents, such as those at issue here, are perhaps one of the most well-known sources of technical information in the art at issue in this proceeding. *See, e.g.*, Control No. 95/001,789², Action Closing Prosecution (Sept. 9, 2012) ("Regarding the RFC(s), these publications are among the most authoritative publications for Internet systems and protocols."). Excluding Ms Ginoza's testimony about these documents—particularly where Patent Owner has already cross-examined her on that testimony—would not comport with "an administrative proceeding designed and intended to afford expedited and efficient relief." *See Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2014-00527, Paper 41 at 56 (May 18, 2015). Likewise, Exhibits 1064 and 1065 are journal articles from publications that were well-known to those of skill,

² Control No. 95/001,789 involves a family member of the patent at issue here.

and their exclusion would remove a reliable source of evidence from the record.

See Resp. at 48-50 (making no argument as to Exs. 1064-1065).

Lastly, Petitioner gave Patent Owner “reasonable notice of the intent to offer the statement and its particulars” (Fed. R. Evid. 807(b)), as evidenced by the discussion and reliance on the exhibits in the Motion to Submit Supplemental Information. *See* Paper 17 at 4-7. Therefore, Exhibits 1060 and 1063-1065 are admissible under the residual exception to the rule against hearsay.

C. Exhibits 1001, 1002, 1009-1035, 1037-1041, 1043-1048, 1068, and 1069 Are Admissible

Patent Owner moves to exclude Exhibits 1001, 1002, 1009-1035, 1037-1041, 1043-1048, 1068, and 1069 as lacking relevance because they are not cited in the Petition or Petitioner's Reply. Mot. at 3.³ This is an erroneous basis for lacking relevance, as evidence relied upon in forming an expert's opinion is relevant under FRE 401 and 402. *See Apple Inc. v. Smartflash LLC*, CBM2014-00180, Paper 50 at 19-20 (Sep. 25, 2015) (“Because [Petitioner's expert] attests that he reviewed these exhibits in reaching the opinions he expressed in this case, Patent Owner has not shown that they are irrelevant under FRE 401 and 402.”). The admissibility of this type of evidence is particularly important because “[e]xpert testimony that does not disclose the underlying facts or data on which the

³ Patent Owner is incorrect, as the Petition cites Exhibits 1009 and 1013. Pet. at 2.

opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65.

Dr. Tamassia, in forming his opinions, considered and relied on the materials listed in Appendix A to his report, which lists all but one of the purportedly irrelevant exhibits. Ex. 1005 at ¶ 9, Appendix A. Indeed, *most* of these relied upon exhibits are discussed explicitly in his report. *See, e.g.*, Ex. 1005 at ¶ 50 (Ex. 1001), ¶ 56 (Ex. 1002), ¶ 161 (Ex. 1009), ¶ 144 (Ex. 1010), ¶ 173 (Ex. 1011), ¶ 404 (Ex. 1012), ¶ 418 (Ex. 1013), ¶ 162 (Ex. 1018), ¶ 186 (Ex. 1019), ¶ 369 (Ex. 1020), ¶ 369 (Ex. 1021), ¶ 370 (Ex. 1024), ¶ 377 (Ex. 1025), ¶ 162 (Ex. 1030), ¶ 216 (Ex. 1031), ¶ 125 (Exs. 1032-1035), ¶ 160 (Ex. 1037), ¶ 290 (Ex. 1038), ¶ 292 (Ex. 1039), ¶ 313 (Ex. 1040), ¶ 57 (Ex. 1041), ¶ 56 (Ex. 1044), ¶ 137 (Ex. 1045), ¶ 139 (Ex. 1046), ¶ 139 (Ex. 1047), ¶ 297 (Ex. 1048). Other exhibits were specifically discussed in Dr. Tamassia's deposition. *See, e.g.*, Ex. 2015 at 62:20-63:21 (discussing Ex. 1043). The remaining exhibits that were not discussed explicitly in his report were nevertheless relied on by Dr. Tamassia in informing his understanding of the issues in this proceeding, Ex. 1005 at ¶ 9, Appendix A, and are thus relevant, *see Smartflash*, CBM2014-00180, Paper 50 at 19-20.

The only purportedly irrelevant exhibits not relied upon in Dr. Tamassia's declaration are his signature of his deposition transcript, Ex. 1068, which was submitted pursuant to 37 C.F.R. § 42.53(f)(5), and Exhibit 1069. The continued presence of this latter exhibit causes no conceivable prejudice to Patent Owner or

the Board. Patent Owner's challenge should therefore be dismissed.

D. Exhibit 1005 Is Admissible in Its Entirety

Patent Owner moves to exclude "vast portions" of Dr. Tamassia's declaration (Exhibit 1005) because they supposedly lacks relevance. Mot. at 4. Patent Owner's supposed justification is that certain testimony concerns grounds addressed in related proceedings. *Id.* Excluding such testimony, to the extent it is not relied upon in this proceeding, serves no purpose. The presence of other grounds in Dr. Tamassia's declaration is analogous to testimony and evidence related to non-instituted grounds, and the Board regularly rejects attempts to exclude such evidence. *See, e.g., Google Inc. v. Intellectual Ventures II LLC*, IPR2014-01034, Paper 41 at 9 (Dec. 7, 2015) (evidence); *Samsung Electronics America, Inc. v. Smarthflash LLC*, CBM2014-00193, Paper 45 at 24 (Mar. 30, 2016) (testimony).

It also is not confusing, as Patent Owner contends — the Board is more than capable of considering only the portions of Dr. Tamassia's declaration relevant to this proceeding. Patent Owner's request to exclude paragraphs of Dr. Tamassia's declaration would create unnecessary work and cause undue confusion, and should be denied.

III. Conclusion

For the foregoing reasons, the Board should deny Patent Owner's Motion.

Dated: May 16, 2016

Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 16th day of 2016, I caused to be served a true and correct copy of the foregoing by e-mail on the following counsel:

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