

Apple Inc. v. Virnetx, Inc.: Denying Joinder and Motion for Joinder IPR2014-00485

Article By:

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Takeaway: Joinder of two or more proceedings, such as the five proceedings in the instant case, for inter partes review is discretionary.

In its [Decision](#), the Board denied Petitioner's Motion for Joinder. This led the Board to also deny Petitioner's Petition, because it was not timely filed under 35 U.S.C. § 315(b). Thus, no trial was instituted.

The Petition was filed on March 10, 2014, challenging claims 1-29 of the '181 patent. Petitioner concurrently filed a Motion for Joinder requesting consideration of the Petition in the instant proceeding with petitions in IPR2014-00483, IPR2014-00484, IPR2014-00403, and IPR2014-00404, all of which were filed by a third party, and all of which challenged claims of a different patent, namely, the '274 patent. More particularly, Petitioner was moving "to join any proceedings based on these petitions in a single proceeding."

The '181 patent is directed to the establishment of a secure communication link between a first computer and a second computer over a computer network (e.g., the Internet). Claims 1-29 were challenged as anticipated under 35 U.S.C. § 102 by either RFC 2543 or Provino; and were challenged as obvious under 35 U.S.C. § 103 in view of various sets of combinations including RFC 2543, RFC 1889, RFC 2327, RFC 2401, Kiuchi, Provino, Beser, and Kosiur.

It was undisputed that Petitioner was served with a complaint for infringement of the '181 patent on November 1, 2011, well more than one year before the March 10, 2014 filing date of the instant Petition. Nonetheless, Petitioner asserted that the instant Petition was not untimely filed because it was accompanied by a Motion for Joinder seeking to join the instant proceeding with proceedings involving the '274 patent that were filed within the one-year time limit. In other words, if the Board was to grant the Motion for Joinder, then the instant Petition would be considered to be timely filed. But if the Board did not grant the Motion for Joinder, then the Petitioner would be time-barred as not having been filed within one year of service of the complaint under 35 U.S.C. § 315(b).

Joinder is governed by 35 U.S.C. § 315(c). It was Petitioner's position that joinder was warranted because the '181 and '274 patents were "very closely related" and "raise a set of overlapping issues that are most efficiently addressed in one *inter partes* proceeding." For example, it was

Petitioner's position that the two patents had certain claims reciting highly similar limitations, that the disclosures of these patents are nearly identical, and that the claims of the patents have the same effective filing date. Petitioner also asserted that the '181 patent petitions rely on the same four primary references as the '274 patent petitions.

Patent Owner replied by arguing, among other things, that terminal disclaimers are not an admission that claims are patentably indistinct, that Patent Owner never conceded that the claims of the '181 and '274 patents are patentably indistinct, and that joining these proceedings would add additional prior art references, "nineteen new grounds of unpatentability, three new declarations totaling over 660 pages, and one declarant."

The Board was "not persuaded that joinder of proceedings involving claims of differing scope in two distinct patents is warranted or justified on the facts presented." The Board pointed out that in accordance with 35 U.S.C. § 315(c), "joinder of two or more proceedings for *inter partes* review is discretionary." The Board then went on to exercise its discretion in denying the joinder of these proceedings. And as a result of Petitioner's Motion for Joinder being denied, the Petition was deemed to be untimely filed.

***Apple Inc. v. Virnetx, Inc.*, IPR2014-00485**

Paper 18: Decision Denying both Petitioner's Motion for Joinder and Institution of *Inter Partes* Review

Dated: September 16, 2014

Patent 8,051,181 B2

Before: Toni R. Scheiner, Michael P. Tierney, and Karl D. Easthom

Written by: Scheiner

Related Proceedings: *VirnetX Inc. v. Apple Inc.*, No. 11-cv-00563-LED (E.D. Tex.); *Inter Partes* Reexamination Control No. 95/001,949; IPR2014-00486; IPR2014-00403; and IPR2014-00404

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