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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 IPR2015-00866
Patent No. 8,458,341

PATENT OWNER'S MOTION TO EXCLUDE

Table of Contents

- I. Precise Relief Requested1
- II. Legal Standard1
- III. Exhibits 1002-1004, 1006, 1010-1041, 1043-1048, 1050, 1051, 1053, 1054, 1060, 1063-1065, 1069 and 1071, and Portions of Exhibit 1005 Should be Excluded from the Record.....1
 - A. Exhibits 1060 and 1063-1065 Constitute Inadmissible Hearsay2
 - B. Exhibits 1002-1004, 1006, 1010-1041, 1043-1048, 1050, 1051, 1053, 1054, 1069, and 1071 Lack Relevance5
 - C. Portions of Exhibit 1005 Lack Relevance.....6
- IV. Conclusion7

TABLE OF AUTHORITIES

Page(s)

Cases

Conoco Inc. v. Dep't of Energy,
99 F.3d 387 (Fed. Cir. 1996)3, 5

Actifio, Inc., v. Delphix Corp.,
IPR2015-00108, Paper No. 56 (Apr. 29, 2016).....5

Federal Regulations

Federal Rule of Evidence 401 5-6

Federal Rule of Evidence 402..... 1, 5-6

Federal Rule of Evidence 403..... 5-6

Federal Rule of Evidence 8011, 2

Federal Rule of Evidence 802.....1, 2

Federal Rule of Evidence 807..... 3-5

37 C.F.R. 42.62(a).....1

Other

Office Patent Trial Practice Guide,
77 Fed. Reg. 487581

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, Patent Owner requests that Exhibits 1002-1004, 1006, 1010-1041, 1043-1048, 1050, 1051, 1053, 1054, 1060, 1063-1065, 1069 and 1071 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 1002-1004, 1006, 1010-1041, 1043-1048, 1050, 1051, 1053, 1054, 1060, 1063-1065, 1069 and 1071, and Portions of Exhibit 1005 Should be Excluded from the Record

The Board should exclude Exhibits 1002-1004, 1006, 1010-1041, 1043-1048, 1050, 1051, 1053, 1054, 1060, 1063-1065, 1069 and 1071 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. 12, 15, 28.)

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. 12 at 1; Paper No. 15 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." (Paper No. 1 at 24.) 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. 14 at 4-8.) 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. 26 at 19-22.) Each of Exhibits 1060 and 1063-1065 include out-of-court

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