

No. 2016-\_\_\_\_

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IN THE  
**UNITED STATES COURT OF APPEALS**  
FOR THE FEDERAL CIRCUIT

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IN RE VIRNETX INC.,  
*Petitioner.*

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On Petition for a Writ of Mandamus  
to the United States Patent and Trademark Office,  
Patent Trial and Appeal Board in  
Nos. IPR2015-01046 & IPR2015-01047.

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**PETITION FOR A WRIT OF MANDAMUS**

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March 4, 2016

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## CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4, counsel of record for Petitioner VirnetX Inc. certify as follows:

1. The full name of every party or amicus represented by us is:

VirnetX Inc.

2. The name of the real party in interest represented by us is:

VirnetX Inc.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by us are:

VirnetX Inc. is a wholly owned subsidiary of VirnetX Holding Corporation (“VHC”). VHC’s stock is publicly traded on the New York Stock Exchange.

4. The names of all law firms and the partners or associates that appeared for the parties represented by us in the trial court, or are expected to appear in this Court, are:

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Dated: March 4, 2016

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## I. INTRODUCTION

The time-bar provision of the America Invents Act, 35 U.S.C. § 315(b), prohibits the Patent Trial and Appeal Board (“the Board”) from instituting an *inter partes* review proceeding “if the petition requesting the proceeding is filed more than 1 year” after the petitioner (or a privy) was “served with a complaint alleging infringement of the patent.” This statutory provision also provides an exemption—but only for “a request for joinder,” which is filed when a petitioner seeks to join another, already instituted *inter partes* review proceeding. The joinder provision, in turn, mandates that the party seeking joinder must have “properly file[d] a petition” warranting the institution of *inter partes* review. 35 U.S.C. § 315(c).

In the two *inter partes* review proceedings below, the Board granted Apple Inc.’s (“Apple’s”) requests for joinder based on petitions that were unquestionably time-barred. Apple filed its petitions *over five years* after VirnetX Inc. (“VirnetX”) first served Apple with a complaint alleging infringement of the patents at issue—U.S. Patent No. 6,502,135 (“the ’135 patent”) and U.S. Patent No. 7,490,151 (“the ’151 patent”). Apple previously filed (directly or through a proxy) *seven inter partes* review petitions against the same patents, in addition to having challenged their validity in two reexamination proceedings and (unsuccessfully) in district court litigation and on appeal before this Court. After the Board dismissed the first three petitions (filed in Apple’s own name) as time-



barred, Apple had its proxy—RPX Corporation (“RPX”)—file three new petitions challenging the same VirnetX patents. The Board dismissed these petitions as time-barred when VirnetX uncovered evidence that Apple was a real party in interest. Apple then tried another tack, and sought to join an *inter partes* review petition filed by Microsoft. Because the proceeding initiated by Microsoft was terminated based on a settlement, the Board dismissed Apple’s attempted joinder.

In a latest effort to evade section 315(b)’s timing restriction, Apple sought to join two new *inter partes* review proceedings brought by Mangrove Partners Master Fund, Ltd. (“Mangrove”). Despite Apple’s time-barred status, the Board permitted the joinder. When VirnetX identified evidence of a connection between Mangrove and Apple’s previous proxy, RPX, the Board refused even to entertain a request for discovery into the full extent of that connection. The Board also refused to place any real limitations on Apple’s involvement in the Mangrove proceedings.

The applicable statutory scheme, 35 U.S.C. § 315(b)-(c), unambiguously prohibits the joinder of Apple’s time-barred petitions to existing *inter partes* review proceedings. In authorizing this joinder, the Board effectively re-wrote the statute by extending the narrow statutory timing exemption, applicable only to joinder requests, to petitions as well. The Board’s statutory interpretation is patently erroneous, because it contradicts the plain statutory language, legislative

history, congressional purpose, and the Supreme Court's precedent construing the key statutory term. The Board's interpretation also unravels the careful balance struck by Congress between encouraging the use of *inter partes* review and "preventing the serial harassment of patent holders." The injury is magnified here, where Apple (the time-barred party) has effectively taken over the proceedings. This Court's immediate intervention is needed in order to prevent irreparable harm to VirnetX. A mandamus from this Court is both necessary and appropriate.

## **II. STATEMENT OF RELIEF SOUGHT AND ISSUES PRESENTED**

VirnetX respectfully requests that this Court grant this petition for a writ of mandamus and direct the Board to revoke its decisions joining Apple to the Mangrove *inter partes* review proceedings based on Apple's time-barred petitions.

The issues presented are:

Whether the Patent Trial and Appeal Board impermissibly exceeded its statutory authority by joining a time-barred entity to an existing *inter partes* review proceeding, in disregard of the unambiguous timing requirement of 35 U.S.C. § 315(b) and the corresponding requirement of 35 U.S.C. § 315(c) that a joinder request must be predicated on a timely filed petition?

## **III. FACTUAL AND PROCEDURAL BACKGROUND**

At issue in this petition are the Board's decisions to join two time-barred *inter partes* review petitions filed by Apple, IPR2016-00062 and IPR2016-00063, to the existing *inter partes* review proceedings initiated by Mangrove, IPR2015-

01046 and IPR2015-01047.<sup>1</sup> The petitions in IPR2015-01046 and IPR2016-00062 challenge the validity of claims of the '135 patent, and the petitions in IPR2015-01047 and IPR2016-00063 challenge the validity of claims of the '151 patent.

**A. Apple's Initial Attempts To Avoid Section 315(b)'s Time Bar**

On August 11, 2010, VirnetX served Apple with a complaint alleging infringement of the '135 and the '151 patents, among others. *See* Complaint, *VirnetX Inc. v. Cisco Sys., Inc.*, No. 6:10-cv-00417, Docket No. 1 (E.D. Tex. Aug. 11, 2010). In response, Apple challenged both patents as invalid and unenforceable. *See* Defendant Apple's Original Answer, Affirmative Defenses, and Counterclaims, *VirnetX Inc. v. Cisco Sys., Inc.*, No. 6:10-cv-00417, Docket No. 55 (E.D. Tex. Apr. 16, 2012).<sup>2</sup> The district court upheld the validity of the '135 and the '151 patents,<sup>3</sup> and this Court affirmed those rulings. *See VirnetX, Inc.*

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<sup>1</sup> The Board's decision in IPR2015-01046/IPR2016-00062 is attached as Exhibit 1, and the decision in IPR2015-01046/IPR2016-00063 is attached as Exhibit 2.

<sup>2</sup> Apple also requested *inter partes* reexamination of both patents, which are ongoing. *See* Request for *Inter Partes* Reexamination, Control No. 95/001,682 (July 11, 2011) (the '135 patent); Request for *Inter Partes* Reexamination, Control No. 95/001,697 (July 25, 2011) (the '151 patent).

<sup>3</sup> After trial, in November 2012, VirnetX served Apple with a related complaint involving the '135 and the '151 patents, among others. *See* Complaint, *VirnetX Inc. v. Apple Inc.*, No. 6:12-cv-00855, Docket No. 1 (E.D. Tex. Nov. 6, 2012). In response, Apple again challenged both patents as invalid. *See* Defendant Apple's Answer, Affirmative Defenses, and Counterclaims, *VirnetX Inc. v. Apple Inc.*, No. 6:12-cv-00855, Docket No. 77 (E.D. Tex. Jan. 23, 2013).

*v. Cisco Sys., Inc.*, 767 F.3d 1308, 1313, 1323-24 (Fed. Cir. 2014).

On June 12, 2013—almost three years after VirnetX originally asserted the patents at issue against Apple—Apple filed its first two *inter partes* review petitions challenging the '135 patent, in IPR2013-00348 and IPR2013-00349. Around the same time, on June 17, 2013, Apple filed an *inter partes* review petition against the '151 patent, in IPR2013-00354. On December 13, 2013, the Board denied all three petitions as time-barred under 35 U.S.C. § 315(b), because Apple had been served with a complaint alleging infringement in August 2010, more than a year before it filed its petitions. *See* Ex. 3 at 5; Ex. 4 at 5; Ex. 5 at 5.

Apple then tried again. On November 20, 2013, shortly before Apple's three petitions were denied, an entity named RPX Corporation filed two petitions challenging the '135 patent, in IPR2014-00171 and IPR2014-00172, and another petition challenging the '151 patent, in IPR2014-00173. RPX does not practice VirnetX's patents, nor is it in the business of technological invention or manufacturing. RPX's advertised business model is to "serve as an extension of a client's in-house legal team" in an effort to "efficiently remove threatening patents from the market"; RPX represents clients who are accused of patent infringement, acting as their proxy to "selectively clear" liability for infringement as part of RPX's "patent risk management solutions." *See* Ex. 6; Ex. 7; Ex. 8 at 3-5, 26, 53. Apple tried to hide its involvement in the RPX proceedings, in an effort to produce

the impression that Apple and RPX were unconnected entities without a privity or real party-in-interest relationship. These efforts included failing to disclose that Apple and RPX shared counsel and representing that Apple and RPX had no pre-filing communications. VirnetX uncovered evidence to the contrary, including metadata demonstrating that Apple's counsel had involvement in the preparation or review of RPX's filings in those proceedings. *See* Ex. 9 at 5-7; Ex. 10 at 5-7; Ex. 11 at 6-8. Based on this evidence, the Board concluded that "RPX [was] acting as a proxy" for the time-barred Apple, and that Apple was a real party-in-interest for all three of RPX's petitions. The Board then denied institution under section 315(b) because Apple, as the real party-in-interest, was time-barred. *See* Ex. 12 at 3, 10; Ex. 13 at 3, 10; Ex. 14 at 3, 10.

On April 10, 2014, Microsoft filed an *inter partes* review petition challenging the '151 patent, in IPR2014-00610, and the Board instituted the proceeding.<sup>4</sup> On October 30, 2014, Apple filed its own petition in IPR2015-00187, and sought to join the Microsoft proceeding. The Board, however, terminated that proceeding based on VirnetX and Microsoft's joint motion, *see* Ex. 15, and thereafter denied institution of Apple's petition, both due to the termination of the Microsoft proceeding and due to Apple's time-barred status. Ex. 16 at 2-3.

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<sup>4</sup> On March 31, 2014, Microsoft also filed a petition challenging the '135 patent, in IPR2014-00558. The Board denied institution because Microsoft was time-barred.

## **B. The Mangrove *Inter Partes* Review Petitions**

Having failed in initiating *inter partes* review of VirnetX's patents either directly, or through a proxy, or by tagging onto Microsoft's petition, Apple has embarked on a new attempt to evade the time bar of section 315(b). This new effort relates to the *inter partes* review petitions filed by Mangrove.

On April 14, 2015, Mangrove—a hedge fund entity—filed *inter partes* review petitions challenging the '135 and the '151 patents, in IPR2015-01046 and IPR2015-01047, respectively. VirnetX has never served Mangrove with a complaint alleging infringement of either patent, nor, to VirnetX's knowledge, does Mangrove practice VirnetX's patents. On October 7, 2015, the Board instituted the proceedings based on Mangrove's petitions. *See* Ex. 17; Ex. 18.

Both petitions named Mangrove as the only real party-in-interest. Mangrove's filings with the Securities and Exchange Commission ("SEC"), and the filings of entities that control Mangrove, however, revealed Mangrove to be part of a complex web of entities linked to a hedge fund registered in the Cayman Islands named (similarly) "Mangrove Partners." *See* Ex. 19; Ex. 20; Ex. 21 at 3-4; Ex. 22 at 1-2; Ex. 23 at 1. At least six different entities or persons appeared to be connected to, or possibly having an interest in, Mangrove (and its petitions), in addition to Mangrove Partners' unnamed investors. *Id.*

Evidence also demonstrated that Mangrove Partners pursued short positions in the publicly traded stock of VirnetX's parent company, VirnetX Holding Corporation ("VHC"). Mangrove Partners held VHC stock two months before the petitions were filed, yet had divested of that stock a month after the filing. Ex. 24 at 2; Ex. 25 at 3; Ex. 26 at 2. This timing suggested Mangrove Partners had interest in the outcome of Mangrove's petitions. Mangrove Partners also appeared to have complete discretionary control over Mangrove; Mangrove Partners and its officers have signed every single public document associated with Mangrove that is available in the SEC's EDGAR database. *See, e.g.*, Ex. 27 at 12; Ex. 28 at 12; Ex. 29 at 11; Ex. 30 at 11; Ex. 31 at 11; Ex.32 at 11; Ex. 33 at 5.<sup>5</sup>

After uncovering this evidence, which suggested that Mangrove had failed to disclose all the real parties in interest as required by the statute, VirnetX moved for additional discovery regarding the structure of the Mangrove entities. The Board initially denied the request. After VirnetX requested rehearing, Ex. 20; Ex. 36, the Board granted the request in small part, allowing discovery only as to

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<sup>5</sup> The Chief Operating Officer of Mangrove Partners (and of another related entity called Mangrove Capital), Ward Dietrich, has been involved in the Mangrove *inter partes* review proceedings, despite having no identified connection to the Mangrove entity that filed the petitions and without either Mangrove Partners or Mangrove Capital being disclosed as real parties-in-interest. Indeed, Ward Dietrich held himself out as an "authorized person" to sign the Power of Attorney on behalf of Mangrove in the proceedings below. *See* Ex. 34 at 2; Ex. 35 at 2.

“communications and/or agreements pertaining to Ward Dietrich’s involvement in the preparation and filing” of Mangrove’s petitions Ex. 37 at 3; Ex. 38 at 3. This discovery is ongoing. The Board denied the request as to any other discovery.

VirnetX also requested to file a motion for additional discovery related to Mangrove’s ties to RPX—the entity that had filed the prior *inter partes* review petitions where Apple was an undisclosed real party-in-interest. *See supra* at 5-6. VirnetX uncovered evidence that linked Mangrove specifically to RPX: (1) with respect to any proceedings before the Board, Mangrove’s backup counsel has worked only on these two *inter partes* review proceedings and a set of *inter partes* reviews explicitly filed by RPX; (2) during the pendency of the Mangrove proceedings, Mangrove has steadily gained increasing equity, into the millions, in RPX; and (3) RPX’s own public documents stated that it was seeking partnerships with financial companies like Mangrove, a hedge fund. *See Ex. 39* at 7-9, 12-14. VirnetX also noted “the relationship between RPX and Apple” that was established in the RPX proceedings, and “[t]he pattern of filing of companies that are coming out of nowhere, challenging these patents [belonging to VirnetX], yet they have no relationship other than relationships with other companies that seem to have statutory bar issues.” *Ex. 39* at 13. The Board, however, did not permit VirnetX even to file a motion for additional discovery into these issues, where VirnetX could have fully explained its basis for seeking this discovery. *See Ex. 40.*



### C. Apple's New Petitions and Requests for Joinder

On October 26, 2015, shortly after the Board had instituted the Mangrove proceedings—and *over five years* after having been served with VirnetX's infringement complaint—Apple filed new *inter partes* review petitions challenging the '135 and '151 patents in IPR2016-00062 and IPR2016-00063, respectively. Apple also sought to be joined in the two Mangrove proceedings. Apple claimed that the grounds and declarations submitted with its petitions were the same as those in the Mangrove petitions. Ex. 41 at 4; Ex. 42 at 4. Both petitions, however, also raised new issues and introduced new evidence. Ex. 43 at 39-42; Ex. 44 at 54-59. As an example, Apple introduced new arguments as to the alleged public availability of references at issue, including arguments based on a declaration from a new declarant. Ex. 43 at 39-42; Ex. 44 at 54-59.

VirnetX challenged the joinder requests, arguing that because of Apple's time-barred status under section 315(b), the petitions should be dismissed, similarly to the five prior petitions filed by Apple or by its proxy, RPX. *See* Ex. 45 at 1-3; Ex. 46 at 1-3. The Board, relying on 35 U.S.C. § 315(b)'s provision stating that “[t]he time limit ... shall not apply to a request for joinder,” instead concluded that section 315(b)'s time bar also does not apply to petitions accompanied by a joinder request. Ex. 47 at 4; Ex. 48 at 4. The Board instituted *inter partes* review based on Apple's petitions, and joined them with the Mangrove proceedings.

Subsequent to the joinder, Apple assumed an active, and even leading, role in the Mangrove proceedings. For instance, Apple's counsel prepared and defended the deposition of Mangrove's expert and communicated with VirnetX's counsel on behalf of all petitioners. Ex. 49; Ex. 50.<sup>6</sup>

On February 8, 2016, VirnetX sought rehearing of the Board's decision to institute proceedings based on Apple's petitions and to join them with the Mangrove proceedings. Ex. 51; Ex. 52. On February 25, 2016, after the Board took no action on VirnetX's rehearing requests, and with a deadline for VirnetX to file its Patent Owner's Responses to Mangrove's and Apple's petitions approaching, VirnetX sought the Board's permission to submit a request for a stay pending the Board's decision on the rehearing requests. Ex. 53. VirnetX also indicated that, if the Board denied rehearing, it would seek a writ of mandamus from this Court, and requested a stay pending the Court's consideration of the mandamus petition. *Id.*

The next day, on February 26, 2016, the Board issued its decisions denying rehearing. Ex. 54; Ex. 55. On March 1, 2016, the Board denied, without any

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<sup>6</sup> On February 4, 2016, the Board also instituted *inter partes* review of the '151 patent based on a petition filed by Black Swamp IP, LLC ("Black Swamp") in IPR2016-00167, and joined that petition with IPR2015-01047. Black Swamp was formed as a corporate entity six days before Mangrove filed its petitions. *See* Ex. 39 at 20. VirnetX has never asserted any of its patents against Black Swamp.

reasoned consideration, VirnetX's request for a stay pending this Court's consideration of the mandamus petition. Ex. 56. The Board opined that VirnetX "has failed to identify a sufficient rationale" for a stay, even though the Board prohibits (under sanctions) any argument when requesting to file a stay motion.

#### **IV. LEGAL STANDARD**

Mandamus is proper when the movant shows (1) a clear and indisputable right to relief (2) that cannot be obtained through other adequate means. *Kerr v. U.S. Dist. Ct.*, 426 U.S. 394, 403 (1976); *see also In re EMC Corp.*, 677 F.3d 1351, 1354 (Fed. Cir. 2012). The traditional use of mandamus has been to "confin[e] the inferior [tribunal] to a lawful exercise of its prescribed jurisdiction." *Ex Parte Rep. of Peru*, 318 U.S. 578, 583 (1943). Courts "have not limited the use of mandamus by an unduly narrow and technical understanding of what constitutes a matter of 'jurisdiction.'" *Mallard v. U.S. Dist. Ct.*, 490 U.S. 296, 309 (1989) (internal quotation marks and citation omitted). Rather, mandamus is "appropriate in certain cases to further supervisory or instructional goals where issues are unsettled and important." *In re Nintendo Co., Ltd.*, 544 F. App'x 934, 936 (Fed. Cir. 2013) (citing *In re BP Lubricants USA Inc.*, 637 F.3d 1307, 1313 (Fed. Cir. 2011)).

#### **V. REASONS WHY THE WRIT SHOULD ISSUE**

##### **A. VirnetX Has a Clear and Indisputable Right to Relief**

The writ of mandamus is an appropriate remedy where the movant can demonstrate a "clear and indisputable" right to relief. *Kerr*, 426 U.S. at 403. This

Court has granted mandamus, and set aside a lower tribunal's improper joinder ruling, where that tribunal has applied an incorrect legal standard. *See In re EMC Corp.*, 677 F.3d at 1355, 1360; *see also In re Nintendo*, 544 F. App'x at 939-43 (granting mandamus where the district court improperly permitted joinder of new claims). Here, mandamus should issue because the applicable statutory scheme unambiguously prohibits the joinder of Apple's time-barred petitions to existing *inter partes* review proceedings.

**1. The *Inter Partes* Review Statute Prohibits Joinder of Apple's Time-Barred Petitions**

Congress created the *inter partes* review scheme in 2011, when it enacted the America Invents Act. Enacted as part of that act, 35 U.S.C. § 315(b) imposes a mandatory time bar on the institution of *inter partes* review proceedings:

An *inter partes* review *may not be instituted* if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.

(Emphasis added.)

Section 315(b) provides an exception from this time bar, but only for “a request for joinder”:

The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

*Id.*

The joinder provision, section 315(c), in turn, grants the Board (as delegated by the Director of the Patent and Trademark Office) discretion to join a party to an existing *inter partes* review, provided certain criteria are met:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who *properly files* a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c) (emphasis added).

Under this statutory scheme, if a party “properly files *a petition*” within the one-year deadline specified in section 315(b), and then files “*a request for joinder* under subsection (c)” *after* the one-year deadline, section 315(b) would permit the Board to grant the joinder request. 35 U.S.C. § 315(b)-(c) (emphasis added). The requirement that the petition be “properly filed” is the predicate for the consideration of both the petition and the joinder request, and it encompasses the requirement that the petition would have been filed within the one-year period authorized under section 315(b).

The Board did not disagree that Apple’s petitions in IPR2016-00062 and IPR2016-00063 were time-barred under section 315(b) because they were filed long after the one-year period from the service of VirnetX’s complaint alleging infringement. *See* Ex. 47 at 4; Ex. 48 at 4. In fact, the Board has previously

denied institution of Apple’s petitions challenging claims of the same patents as time-barred. *See supra* at 5-6. The Board, however, interpreted the last sentence of section 315(b), which states that “[t]he time limit ... shall not apply to a request for joinder,” 35 U.S.C. § 315(b), to mean that “if a party filing a time-barred petition requests joinder, the one-year time bar ‘shall not apply.’” Ex. 47; Ex. 48.

In doing so, the Board treated the terms “petition” and “request for joinder” as interchangeable. But there is no basis for such a reading. Section 315(b), as well as the overall statute, carefully distinguishes between the terms “petition” and “request for joinder.” When Congress uses a particular statutory term, it does so advisedly, and an agency impermissibly departs from the statute when it disregards Congress’ intentional use of different statutory terms. *See Loughrin v. United States*, 134 S. Ct. 2384, 2390 (2014) (“when ‘Congress includes particular language in one section of a statute but omits it in another’—let alone in the very next provision—this Court ‘presume[s]’ that Congress intended a difference in meaning”) (quoting *Russello v. United States*, 464 U.S. 16, 23 (1983)) (alteration in original). Section 315(b) imposes a mandatory one-year time bar on any “petition requesting the [*inter partes*] proceeding.” 35 U.S.C. § 315(b). It then exempts “a request for joinder” made under section 315(c)—and only such a request— from that timing prohibition. *Id.* But section 315(b) does not extend that exemption to “a petition,” even though Congress clearly knew how to apply

such an exemption to a petition, as demonstrated elsewhere in the statute. *See, e.g.*, 35 U.S.C. §§ 311(c), 314(b). The Board's interpretation of section 315(b) effectively re-writes the statute by expanding the statutory exemption for joinder requests from a mandatory time bar to petitions. Nor is this the first time that the Board has adopted a contorted reading of this provision. As a dissent from the Board's similar misreading of the statute has observed, the Board's interpretation

effectively rewrites the second sentence of § 315(b) as follows, with added material underlined: The time limitation set forth in the preceding sentence shall not apply to a petition accompanied by a request for joinder under subsection (c) if that request is granted.

*Target Corp. v. Destination Maternity Corp.*, IPR2014-00508, Paper No. 28, Dissent Op. at 18 (P.T.A.B. Feb. 12, 2015) (emphasis in the original), attached as Ex. 60. Such re-writing of a statute under the guise of interpreting it is plainly impermissible, and constitutes an abuse of interpretive authority warranting mandamus. *Util. Air Regulatory Grp. v. EPA*, 134 S. Ct. 2427, 2445 (2014) (“An agency has no power to ‘tailor’ legislation to bureaucratic policy goals by rewriting unambiguous statutory terms. Agencies exercise discretion only in the interstices created by statutory silence or ambiguity; they must always ‘give effect to the unambiguously expressed intent of Congress.’”) (quoting *Chevron U.S.A. Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837, 843 (1984)) (selected internal quotation marks and citation omitted).

In extending section 315(b)'s exemption beyond the statutory mandate, the Board also relied on its regulation, 37 C.F.R. § 42.122(b), which provides that the one-year time bar "shall not apply when the petition is accompanied by a request for joinder." Ex. 41 at 4. But a regulation cannot alter a statute whose meaning is plain, *see Oshkosh Truck Corp. v. United States*, 123 F.3d 1477, 1481 (Fed. Cir. 1997) (agency regulation receives no deference where it is at odds with the statutory language), nor can it justify an agency's unlawful augmentation of authority. As shown below, *infra* at 20-24, the Board's interpretation of section 315(b)'s timing exemption is squarely contrary to congressional intent.

The Board's contorted construction of section 315(b)'s timing exemption impermissibly augments the Board's own power, in contravention of congressional command. The statutory scheme carefully delineates between the instances where the Board is vested with discretion and the instances where the statutory requirements are mandatory. Thus, section 315(c) expressly provides the Board with "discretion" to grant a joinder request where the underlying petition, in the Board's view, "warrants the institution of an *inter partes* review." 35 U.S.C. § 315(c). By contrast, the time limitation provision of section 315(b) is phrased in mandatory terms: an *inter partes* review where the petition is filed outside of the one-year bar "may not be instituted," and therefore is categorically barred. 35 U.S.C. § 315(b). In some instances, the statute sets forth certain mandatory



conditions but authorizes the Board to prescribe additional requirements. *Compare also* 35 U.S.C. § 312(a)(1)-(3) (listing the requirements that an *inter partes* review petition must contain to be considered), *with id.* § 312(a)(4) (authorizing the Director to prescribe additional requirements). Conversely, the Board is authorized to waive certain requirements that apply to the private parties, but other requirements are non-waivable, and bind both the private parties and the Board. *Compare* 35 U.S.C. § 316(d)(2) (authorizing the Director to prescribe regulations for additional motions to amend beyond the one contemplated in § 316(d)(a)), *with id.* § 316(d)(3) (prohibiting amendments that enlarge the scope of the claims of a patent or introduce new matter). The Board's interpretation effectively waives section 315(b)'s mandatory time bar with respect to all petitions accompanied by a joinder, but the statute does not grant the Board such waiver authority. This is precisely the kind of unlawful enlargement of an agency's "jurisdiction" that mandamus is designed to prevent. *In re Nintendo*, 544 F. App'x at 936.

The Board appears to have credited Apple's argument that VirnetX's interpretation of section 315(b) "would render its second sentence a legal nullity." Ex. 57 at 3; *see also* Ex. 47 at 4 (rejecting VirnetX's proposed interpretation for unspecified reasons advanced by Apple). Apple argued that, under VirnetX's interpretation, section 315(b)'s exemption "would *never* apply, as no petition filed

more than a year after service could ever be the basis of participation in any proceeding.” Ex. 57 at 3 (emphasis in the original).

This argument misunderstands VirnetX’s position, and misreads the statutory text. Section 315(b)’s timing exemption applies “to a request for joinder.” 35 U.S.C. § 315(b). Therefore, it would apply when a petition seeking *inter partes* review is filed timely before the one-year deadline, but a request for joinder is filed after that deadline. This reading is faithful to the statutory design because joinder is subsequent in time to a decision to institute. The timing exemption addresses this concern by making clear that the one-year time limitation shall not apply to a joinder request. There may be important advantages to joining an otherwise properly filed petition (which otherwise could continue as a separate *inter partes* review proceeding): availability of documentary or expert evidence submitted by the other petitioner; ability to benefit from additional invalidity theories raised by the other petitioner; ability to guide a proceeding based on arguments and positions that other petitioners may not be privy to in order to avoid an adverse decision by the Board; ability to benefit from a proceeding that is further advanced to obtain faster relief; and ability to pool resources (or share costs) with another petitioner. But what section 315(b) does not provide is a backdoor for time-barred petitions to be instituted through joinder irrespective of

how much time has passed since the putative petitioner has been on notice about the patent owner's infringement contentions.

**2. The Board's Patently Erroneous Interpretation Ignores the Statutory Language, Legislative Intent, and the Canons of Statutory Construction**

Critically, the Board's interpretation ignores altogether section 315(c)'s requirement that the petition with respect to which joinder is sought be "*properly file[d]*." 35 U.S.C. § 315 (c) (emphasis added). The legislative history of section 315(c)—which is one of the tools for determining the provision's intent, *see Escondido Mut. Water Co. v. La Jolla, Rincon, San Pasqual, Pauma, & Pala Bands of Mission Indians*, 466 U.S. 765, 779 (1984) (“[A]n agency's interpretation, even if well established, cannot be sustained if, as in this case, it conflicts with the clear language and legislative history of the statute.”); *NLRB v. Allis-Chalmers Mfg. Co.*, 388 U.S. 175, 179 (1967)—demonstrates both that the term “properly file[d]” was meant to encompass the timing requirement of section 315(b), and that section 315(b)'s timing exemption was not intended to alter that requirement. Commenting on the requirement that a petition based on which joinder is sought must be “properly file[d],” the statute's sponsor, Senator Kyl, explained the genesis of this phrase and its intended scope:

The words “properly filed” are a term of art that is also employed in section 2244 of title 28 and that has been given content no less than three times during this decade by the U.S. Supreme Court, *see Artuz v. Bennett*, 531

U.S. 4 (2000), *Pace v. DiGuglielmo*, 544 U.S. 408, and *Allen v. Siebert*, 128 S. Ct. 2 (2007). The gist of these decisions is that *a petition is properly filed when it is delivered and accepted in compliance with applicable rules governing filings*, though particular claims within filings be barred on other procedural grounds, *and that time deadlines for filing petitions must be complied with in all cases.*

154 Cong. Rec. S9988 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl) (emphasis added), attached as Ex. 58; *see also* Joe Matal, *A Guide to the Legislative History of the America Invents Act: Part II of II*, 21 Fed. Cir. B. J. 539, 613-14 (2012).<sup>7</sup>

In the decisions from which section 315(c)'s term "properly file[d]" was derived, the Supreme Court examined the meaning of 28 U.S.C. § 2244(d)(2)'s tolling provision, which tolled the limitation period for federal habeas upon "a properly filed application for State post-conviction collateral review." As the Supreme Court explained, "an application is 'properly filed' when its delivery and acceptance *are in compliance with the applicable laws and rules governing filings. These usually prescribe, for example, the form of the document [and] the time limits upon its delivery ... .*" *Artuz v. Bennett*, 531 U.S. 4, 8 (2000) (footnote

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<sup>7</sup> Although Senator Kyl was speaking about a joinder provision in the predecessor bill, he made clear subsequently that these comments were relevant to the corresponding provisions that eventually became law, including specifically "the meaning of 'properly filed' when used in the joinder provisions in sections 315(c) and 325(d)." 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl); *see also* Matal, *supra*, at 613 (noting that Senator Kyl was commenting on "a substantially identical joinder provision").

omitted) (emphasis added). The Supreme Court reiterated this conclusion in subsequent decisions, reaffirming that time limits are conditions of proper filing:

In *Artuz v. Bennett*, we held that time limits on postconviction petitions are “condition[s] to filing,” such that an untimely petition would not be deemed “properly filed.” *Id.* at 8, 11 (“[A]n application is ‘properly filed’ when its delivery and acceptance are in compliance with the applicable laws and rules governing filings” including “time limits upon its delivery”).

*Pace v. DiGuglielmo*, 544 U.S. 408, 413 (2005); *see also Allen v. Siebert*, 552 U.S. 3, 6-7 (2007) (reaffirming that “time limits generally establish ‘conditions to filing’”). Given the Supreme Court’s construction of the term “properly filed,” the fact that Congress deliberately used that term in section 315(c) demonstrates that it means to encompass “the time deadlines for filing petitions” prescribed by 35 U.S.C. § 315(b). *Austin v. Dep’t of Commerce*, 742 F.2d 1417, 1419 (Fed. Cir. 1984) (observing that “[t]he legislative history makes clear that prior judicial interpretations of the term ... should be applied” when construing the statute). The Board’s failure to even confront this evidence of congressional intent demonstrates the unreasoned (and unreasonable) nature of its statutory construction.<sup>8</sup>

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<sup>8</sup> Other agencies and federal courts similarly define the term “properly filed” to encompass timing requirements. *See, e.g.*, 8 C.F.R. § 245.10(a) (defining the statutory term “a petition [that] is properly filed” in 8 U.S.C. § 1154 with reference to the timing of its receipt or mailing); *United States v. Mendoza*, 581 F.2d 89, 90 (5th Cir. 1978) (*en banc*) (referring to a motion that “is properly filed within” the time limit of the statute)); *Drug Plastics & Glass Co. v. NLRB*, 44 F.3d 1017, (continued on next page)

The overall statutory scheme further supports reading the term “properly file[d]” in section 315(c) as encompassing section 315(b)’s one-year bar with respect to petitions. *See Davis v. Michigan Dep’t of Treasury*, 489 U.S. 803, 809 (1989) (“the words of a statute must be read in their context and with a view to their place in the overall statutory scheme”). Section 315(c) requires compliance with the requirements of section 311. *See* 35 U.S.C. § 315(c) (requiring that the person seeking joinder “properly file[] a petition under section 311”). Section 311, in turn, requires compliance with the other provisions of Title 35, Chapter 31 of the U.S. Code, which include section 315(b)’s timeliness requirement. *See* 35 U.S.C. § 311 (“*Subject to the provisions of this chapter*, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.”) (emphasis added). The Board’s interpretation disregards this portion of section 311, in contravention of the plain statutory language.

### **3. The Board’s Interpretation Contravenes the Statutory Purpose**

The Board’s interpretation upends the careful balance that Congress achieved between “the need to encourage [the] use [of the *inter partes* review] and

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1019-20 (D.C. Cir. 1995) (dismissing an NLRB unfair labor complaint because it could not be issued “except upon a properly filed charge” made within the statutory time frame, and the complaint at issue was untimely).

preventing the serial harassment of patent holders.” House Judiciary Transcript for Mark-Up of H.R. 1249, The America Invents Act, at 72 (Apr. 14, 2011) (statement of Cong. Smith), attached as Ex. 59; *see also* 157 Cong. Rec. S1041-42 (daily ed. Mar. 1, 2011) (statement of Sen. Kyl) (speaking about the need to avoid “serial challenges” and the resulting burden on the patent owners from multiple proceedings involving the same patent). As the Committee Report emphasized, the *inter partes* review proceedings “are not to be used as tools for harassment ... through repeated litigation and administrative attaches on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation.” H.R. Rep. No. 112-98, at 48 (2011), *as reprinted in* 2011 U.S.C.C.A.N. 67, 78. The one-year time bar provision of section 315(b) protects patent owners from belated challenges to the validity of the patents they had asserted in a federal court against potential infringers—such as the challenges that the time-barred Apple brought in the proceeding below over *five years* after having been served with VirnetX’s infringement complaint. The Board’s interpretation, which opens the floodgates for such repetitive belated challenges, cannot be squared with the statute’s purpose.

This proceeding presents a particularly vivid example of the extent to which the Board’s erroneous reading of the statute has distorted the law’s intent. VirnetX’s ’135 and the ’151 patents have been subjected to *seven* previous *inter*

*partes* review challenges (plus two reexamination challenges) filed directly by Apple or by RPX on Apple's behalf. All seven of these previous *inter partes* review petitions have been dismissed as time-barred, and there is evidence that Mangrove—the entity behind two of the recent *inter partes* review petitions against VirnetX's patents—is connected to Apple's proxy RPX. *See supra* at 9.<sup>9</sup> Section 315(b)'s time exemption was certainly not designed to permit such a systematic evasion of the statutory one-year limitation.

Nor is this an isolated instance of the Board using section 315(b) in ways Congress could not have intended (or envisioned). In *Zhongshan Broad Ocean Motor Co. v. Nidex Motor Corp.*, IPR2015-00762, the Board permitted a time-barred petitioner, whose prior petition was dismissed for failure to submit the required affidavits, to “secure[] evidence to correct the defect,” and then to file a new petition accompanied by a joinder request. *See* No. IPR2015-00762, 2015 WL 5895802, at \*6 (P.T.A.B. Oct. 5, 2015) (Boucher & Wood, APJ, dissenting). And in *Target Corp. v. Destination Maternity Corp.*, IPR2014-00508, the Board permitted a joinder of a time-barred petition to *the petitioner's own* previously filed petition, where the new petition presented previously omitted evidence.

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<sup>9</sup> All these proceedings are in addition to Apple's unsuccessful invalidity challenges in federal district court and this Court. *See supra* at 4-5; *see also* *Cisco Sys.*, 767 F.3d at 1313, 1323-24 (rejecting Apple's invalidity contentions).



No. IPR2014-00508, Paper No. 28, Maj. Op. at 2-3 (P.T.A.B. Feb. 12, 2015); *id.* at 5-6 (Fitzpatrick, Bisk & Weather, APJ, dissenting), attached as Ex. 60. The Board's joinder of the time-barred Apple in the proceedings below is the latest example of this systematic disregard of the statutory timing rule. This Court's intervention is urgently needed, via mandamus, to prevent further aberrational misreading of the timing exemption and the joinder provision by the Board.

**B. Mandamus Is an Appropriate Remedy in this Case**

Mandamus is warranted where, as here, the movant "ha[s] no other adequate means to attain the relief." *Kerr*, 426 U.S. at 403. As an initial matter, mandamus relief is not precluded by this Court's precedents construing the America Invents Act's prohibition on appellate review of the institution decisions in *inter partes* proceedings, 35 U.S.C. § 314(d). Section 314(d) limits only this Court's appellate review, not the availability of mandamus, which is an independent remedy. Moreover, the decision on whether to grant Apple's joinder petition is, by definition, subsequent to the institution decision, and therefore is not affected by the appellate prohibition of section 314(d).

This Court has recognized that mandamus is appropriate where a governmental entity has acted outside its statutory authority. *See, e.g., In re United States*, 877 F.2d 1568, 1572 (Fed. Cir. 1989) (granting mandamus where Article I court acted outside of the authority granted by the "plain language" of the statute,

as confirmed by the legislative history). This Court and other courts have granted mandamus where parties have been improperly joined or time limits impermissibly disregarded. *See, e.g., In re Nintendo*, 544 F. App'x at 937-38, 942-43 (granting mandamus where parties were not “properly joined”); *In re Allen*, 701 F.3d 734, 735 (5th Cir. 2012) (granting mandamus petition where district court’s denial of a request for “crime victim” status under federal law was based on timeliness but the statute had no time limit or time bar); *United States v. Spilotro*, 884 F.2d 1003, 1009 (7th Cir. 1989) (granting mandamus petition where district court “erred in ... ignoring the time limit” in Federal Rules for granting sentence reduction, and so was “without power” to do so); *United States v. U.S. Dist. Court*, 509 F.2d 1352, 1356 (9th Cir. 1975) (granting mandamus because a denial, where district court had failed to observe a time limit, would “nullify” the time limit and “undermine completely the purpose” of that limit).

While this Court in *In re Procter & Gamble Co.* refused to grant mandamus with respect to a decision to institute an *inter partes* review, it did so after finding that the movant could demonstrate no “irremediable interim harm [that] can justify mandamus,” and simply sought to avoid “the burden of going through the *inter partes* review.” 749 F.3d 1376, 1379 (Fed. Cir. 2014). Here, by contrast, it would be exceedingly difficult, if not impossible, to untangle the prejudice to VirnetX from participation of one party among several joined parties in an *inter partes*

review proceeding, once the proceeding is underway or concluded. *Cf. In re EMC Corp.*, 677 F.3d at 1355 (“a defendant would not have an adequate remedy for an improper failure to transfer or sever the case by way of an appeal from an adverse final judgment because the defendant would be unable to demonstrate that it would have won the case had it been tried in a convenient venue”) (internal quotation marks, citation, and alteration omitted). The time-barred Apple has assumed a leading role in the proceedings below. Despite VirnetX’s request, the Board placed no real limits on the extent of Apple’s involvement. While VirnetX cannot fully know the extent of Apple’s direct involvement in the formulation of petitioners’ strategy (and the preparation of the actual filings), the outward signs demonstrate that Apple is in the driver’s seat. Apple’s counsel has taken over communications between petitioners and VirnetX, and has prepared and defended the deposition of petitioners’ expert—even though that expert was originally engaged by Mangrove. *See* Ex. 49; Ex. 50; *supra* at 11.

The Board’s joinder of the time-barred Apple confers numerous advantages on the petitioners below. These include ability to access documentary or expert evidence submitted by the other petitioner; to benefit from additional invalidity theories raised by the other petitioner; to utilize arguments and positions of other petitioners that may not be public knowledge to avoid an adverse decision; to obtain relief faster because the other proceeding is further advanced; and to pool

resources (or share costs). For example, once VirnetX files its patent owner's responses, presently due March 8, 2016, Apple will be able to jointly work together with the other petitioners (Mangrove and Black Swamp) on how to respond. Given Mangrove and Black Swamp's apparent willingness to let Apple take control, there is little doubt they would listen and follow Apple's lead.

The joinder has already prejudiced VirnetX in concrete ways. VirnetX now has to defend itself against new issues and evidence introduced by Apple—issues and evidence that were not presented by Mangrove in the original proceedings. Ex. 43 at 39-42; Ex. 44 at 54-59; *supra* at 10. VirnetX is also being systematically disadvantaged because it is limited to a single response of a constrained length, while Apple, Mangrove, and Black Swamp submitted three separate petitions each presenting unique issues. Thus, VirnetX has to prepare its Patent Owner's Responses to invalidity issues raised in three separate petitions, yet the Board denied VirnetX's request for extra pages in order to be able to fully address all these multiple arguments. *See* Ex. 56.

Most importantly, VirnetX has a right to relief because the time-barred Apple's participation in the proceedings below is *ultra vires*. This Court has repeatedly recognized that the erroneous refusal to transfer venue warrants mandamus because a petitioner has no other means of relief. *See, e.g., In re TS Tech USA Corp.*, 551 F.3d 1315, 1322 (Fed. Cir. 2008) (citing *In re Volkswagen of*

*Am., Inc.*, 545 F.3d 304, 318-19 (5th Cir. 2008)); *see also In re EMC Corp.*, 677 F.3d at 1355. The harm from failure to transfer “will already have been done by the time the case is tried and appealed, and the prejudice suffered cannot be put back in the bottle.” *In re Volkswagen*, 545 F.3d at 318-19. Here, the harm from an improper party’s directing the case will be done (and cannot be effectively undone) before VirnetX is able to appeal that joinder. Nor can this harm be disregarded because *inter partes* review proceedings based on the Mangrove petitions may nevertheless continue.<sup>10</sup> Just as this Court did not hesitate to grant mandamus relief where the right to be tried in a proper venue was denied, so this Court should grant mandamus here, where VirnetX is entitled to defend its patents without the involvement of a party that is barred by statute.

## VI. CONCLUSION

This court should grant a writ of mandamus, and direct the Board to revoke its erroneous joinder decisions.

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<sup>10</sup> As discussed above, there is ongoing discovery as to real party-in-interest issues in the Mangrove proceedings. *See supra* at 8-9.