

NOTE: This order is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**VIRNETX INC.,**  
*Appellant*

v.

**ANDREW HIRSHFELD, Performing the Functions  
and Duties of the Under Secretary of Commerce for  
Intellectual Property and Director of the United  
States Patent and Trademark Office,**  
*Intervenor*

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2017-2593

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Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. IPR2016-  
00693.

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**VIRNETX INC.,**  
*Appellant*

v.

**ANDREW HIRSHFELD, Performing the Functions  
and Duties of the Under Secretary of Commerce for  
Intellectual Property and Director of the United  
States Patent and Trademark Office,**  
*Intervenor*

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2017-2594

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Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2016-00957.

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Before PROST, REYNA, and CHEN, *Circuit Judges*.

PROST, *Circuit Judge*.

### **O R D E R**

In response to this court's September 16, 2021 and February 15, 2022 orders, the parties inform the court how they believe these appeals should proceed.

In Appeal No. 2017-2594, VirnetX Inc. challenges the Patent Trial and Appeal Board's June 12, 2017 final written decision concerning claims of U.S. Patent No. 7,921,211. On August 1, 2019, this court issued its decision in *VirnetX Inc. v. Apple Inc.*, 931 F.3d 1363, 1380 (Fed. Cir. 2019), affirming separate Board decisions finding the same claims of the patent unpatentable. In light of that decision, the parties agree that Appeal No. 2017-2594 is moot and the underlying Board decision should be vacated.

In Appeal No. 2017-2593, VirnetX informs the court that its request for Director review was denied and it has filed an amended notice of appeal. VirnetX further proposes a briefing schedule to which the intervenor does not object.

Upon consideration thereof,

IT IS ORDERED THAT:

(1) The above-captioned appeals are deconsolidated. The revised official captions are reflected above.

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(2) The June 12, 2017 final written decision of the Patent Trial and Appeal Board in IPR2016-00957 is vacated, and Appeal No. 2017-2594 is remanded with instructions to dismiss.

(3) Each side to bear its own costs as to Appeal No. 2017-2594.

(4) No additional docketing fee is required for the amended notice of appeal in Appeal No. 2017-2593.

(5) The revised certified list in Appeal No. 2017-2593 is due no later than April 19, 2022. VirnetX's opening brief is due within 60 days of the date of filing of the certified list.

FOR THE COURT

April 4, 2022  
Date

/s/ Peter R. Marksteiner  
Peter R. Marksteiner  
Clerk of Court