

NOTE: This disposition is nonprecedential.

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

VIRNETX INC.,
Appellant

v.

**KATHERINE K. VIDAL, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2017-2593

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

Decided: October 20, 2023

DANIEL ZEILBERGER, Paul Hastings LLP, Washington,
DC, argued for appellant. Also represented by STEPHEN
BLAKE KINNAIRD, NAVEEN MODI, JOSEPH PALYS, IGOR
VICTOR TIMOFEYEV.

BRIAN RACILLA, Office of the Solicitor, United States
Patent and Trademark Office, Alexandria, VA, argued for

intervenor. Also represented by MICHAEL S. FORMAN, DANIEL KAZHDAN, THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED.

Before LOURIE, BRYSON, and CHEN, *Circuit Judges*.

PER CURIAM.

Appellant VirnetX Inc. (VirnetX) seeks review of a decision of the Patent Trial and Appeal Board (Board) holding that claims 1–2, 5–6, 15–16, 27, 33, 36–37, 39–40, 51, 57, and 60 of VirnetX’s U.S. Patent No. 7,418,504 (’504 patent) are unpatentable. VirnetX challenges the Board’s determination that dependent claim 5 is unpatentable and argues that the Board’s decision as to the other claims are moot in view of our affirmance of rejections of claims 36–37, 39–40, 51, 57, and 60 in *VirnetX Inc. v. Apple Inc.*, 931 F.3d 1363 (Fed. Cir. 2019) and our affirmance of rejections of claims 1–2, 6, 15–16, 27, and 33 in *VirnetX Inc. v. Cisco Systems, Inc.*, 776 F. App’x 698 (Fed. Cir. 2019). At oral argument, counsel for VirnetX further acknowledged that if we affirm in *VirnetX Inc. v. Cisco Systems, Inc.*, No. 22-2234, argued the same day as this case, this case would be entirely moot.

We have today affirmed the Board’s decision in the pending *Cisco* appeal. See *VirnetX Inc. v. Cisco Systems, Inc.*, No. 22-2234, slip op. 7, — F. App’x —, — (Fed. Cir. Oct. 20, 2023). This case is therefore moot, and the appeal will be dismissed. We decline to vacate the Board’s decision in this case as part of our judgment dismissing this appeal, as VirnetX has not offered any reason as to why the unreviewed Board decision would require the discretionary remedy of vacatur. See *U.S. Bancorp Mortg. Co. v. Bonner Mall P’ship*, 513 U.S. 18 (1994); *Apple Inc. v. Qualcomm Inc.*, 17 F.4th 1131, 1137 (Fed. Cir. 2021); see also *LSI Corp. v. U.S. Int’l Trade Comm’n*, 604 F. App’x 924, 930 (Fed. Cir. 2015) (noting that the decision whether to vacate a judgment when the case becomes moot by happenstance

VIRNETX INC. v. VIDAL

3

while on appeal is a matter “not of constitutional necessity but of remedial discretion”).

DISMISSED