

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

New Bay Capital, LLC,

Petitioner,

v.

VirnetX Inc.

Patent Owner.

IPR2013-00377

Patent 7,418,504

Issue Date: Aug. 26, 2008

Title: AGILE NETWORK PROTOCOL FOR SECURE COMMUNICATIONS
USING SECURE DOMAIN NAMES

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 7,418,504**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

**VIRNETX EXHIBIT 2012
Apple v. Virnetx
Case IPR2013-00354**

TABLE OF CONTENTS

I. COMPLIANCE WITH FORMAL REQUIREMENTS 1

A. REAL PARTIES IN INTEREST 1

B. STANDING..... 1

C. RELATED MATTERS..... 1

D. NOTICE OF LEAD AND BACKUP COUNSEL 6

E. SERVICE INFORMATION 6

F. PROOF OF SERVICE ON THE PATENT OWNER 7

G. FEE..... 7

II. STATEMENT OF PRECISE RELIEF REQUESTED 7

III. FACTUAL BACKGROUND..... 8

**A. The Claims Of The ‘504 Patent Purport To Improve Over Prior
 Art Domain Name Service Systems By Configuring Such
 Systems To Include “An Indication That The Domain Name
 Service System Supports Establishing A Secure
 Communication Link” 8**

1. Admitted Prior Art 8

**2. The Purported Improvement Over Prior Art Domain
 Name Service Systems: Configuring Such
 Systems To Include “An Indication That The
 Domain Name Service System Supports
 Establishing A Secure Communication Link” 9**

**B. The ‘504 Patent Does Not Define “An Indication That The Domain
 Name Service System Supports Establishing A Secure
 Communication Link” But Discloses Embodiments That
 Provide Such An “Indication” 10**

**C. The ‘504 Patent Was Granted Over Prior Art Which Established
 Secure Communications Without the Support of a Domain
 Name Service 13**

IV. CLAIM CONSTRUCTION	14
A. Legal Standards	14
B. Domain name	17
C. Top-level domain name	19
D. Domain name service	20
E. Secure communication link	21
F. Domain name service system	22
G. Configured...to comprise an indication that the domain name service system supports establishing a secure communication link	22
H. Transparently	26
V. FULL STATEMENT OF THE REASONS FOR CANCELLATION OF CLAIMS IN THE ‘504 PATENT	26
A. Kiuchi is Prior Art That Uses a Domain Name Service in Establishing Secure Communication Links Over the Internet	26
B. Claim 1 is Anticipated by Kiuchi	31
C. Claim 2 is Anticipated by Kiuchi	41
D. Claim 5 is Anticipated by Kiuchi	42
E. Claim 16 is Anticipated by Kiuchi	45
F. Claim 27 is Anticipated by Kiuchi	49
G. Claim 21 Would Have Been Obvious Over Kiuchi in View of Broadhurst	50
VI. CONCLUSION	54

TABLE OF AUTHORITIES

Cases

<i>AirCRAFT Medical LTD. v. Verathon Inc.</i> , Reexam. Control No. 95/000,161, Appeal 2012-007851, p. 16 (PTAB Dec. 11, 2012)	16
<i>Data General Corp. v. Johnson</i> , 78 F.3d 1556, 1565 (Fed.Cir.1996)	15
<i>Garmin Int’l Inc. v.Cuozzo Speed Technologies, Inc.</i> , IPR2012-00001, Paper 15 (PTAB, Jan. 9, 2013).....	14
<i>In re Am. Acad. of Sci. Tech. Ctr.</i> , 367 F.3d 1359, 1365 (Fed. Cir. 2004)	15
<i>In re Morris</i> , 127 F.3d 1048, 1056 (Fed. Cir. 1997).....	16
<i>Key Pharmaceuticals v. Hercon Laboratories Corp.</i> , 161 F.3d 709, 715, 48 USPQ2d 1911, 1916 (Fed. Cir. 1998).....	15
<i>Multiform Desiccants, Inc. v. Medzam, Ltd.</i> , 133 F.3d 1473, 1477 (Fed. Cir.1998)	14
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303, 1313 (Fed. Cir. 2005)(en banc).....	14
<i>RenishawPLC v. Marposs Societa per Azioni</i> , 158 F.3d 1243, 1249 (Fed. Cir. 1998).....	14
<i>VirnetX Inc. and Science Applications International Corporation v. Apple Inc.</i> , Case No. 6:12cv855 (E.D. Tex.)	1
<i>VirnetX Inc. v. Apple Inc.</i> , Case No. 6:13cv211 (E.D. Tex.)	1
<i>VirnetX Inc. v. Cisco Systems, et al.</i> , Case No. 6:10cv417 (E.D. Tex.).....	1, 2, 18
<i>VirnetX Inc. v. Mitel Networks Corp., et al.</i> , Case No. 6:11cv18(E.D. Tex.).....	2
<i>VirnetX Inc., and Science Applications International Corporation v. Microsoft Corporation</i> , Case No. 6:13cv351 (E.D. Tex.)	2
<i>VirnetX v. Microsoft Corporation</i> , Case No. 6:07 CV 80 (E.D. Tex. 2007)	17, 20
<i>York Prods., Inc. v. Central Tractor Farm & Family Ctr.</i> , 99 F.3d 1568,1572 (Fed. Cir. 1996).....	14

Statutes

35 U.S.C. §102(b)..... 7, 27
35 U.S.C. §103(a)..... 7
35 U.S.C. §301(a)(2), (d) 15
35 U.S.C. §317(b)..... 3

Treatises

18 Susan Bandes & Lawrence B. Solum, Moore's Federal Practice § 134-30, at
134-63 (3d ed.1998) 15

Regulations

37 C.F.R. § 42.8(b)(1) 1
37 C.F.R. §42.100 (b)..... 14
37 C.F.R. §42.15(a)..... 7

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.