

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of Munger et al.

U.S. Patent No. 6,502,135

Filed: February 15, 2000

Issued: December 31, 2002

Title: AGILE NETWORK PROTOCOL FOR
SECURE COMMUNICATIONS WITH
ASSURED SYSTEM AVAILABILITY

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REQUEST FOR *Inter Partes*
REEXAMINATION

Attorney Docket No.: 43614.92

Customer No.: 27683

Real Party in Interest:
Cisco Systems, Inc.

REQUEST FOR INTER PARTES REEXAMINATION

Mail Stop *Inter partes* Reexam
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the provisions of 35 U.S.C. §§ 311-318, David L. McCombs (“Requester”) hereby requests *inter partes* reexamination of claims 1-18 (all of the claims) of United States Patent No. 6,502,135 (“the ‘135 patent,” Ex. A) that issued on December 31, 2002, to Munger et al., on behalf of Cisco Systems Inc., the real party in interest.

This request presents prior art references that are better than and non-cumulative of the prior art that was considered during the original prosecution of the ‘135 patent and during a first reexamination proceeding, Reexamination Control No. 95/001,269. Claims 1-18 (all of the claims) are invalid over these new references. Requester asks that reexamination be ordered and that all of the claims be rejected and ultimately canceled.

The ‘135 patent is the subject of pending litigation, *VirnetX, Inc. v. Cisco Systems, Inc.*, Case No. 6:10-cv-417 (E.D. Tex. filed Aug. 11, 2010). No final decision has been entered in that case.

In accordance with 37 C.F.R. 1.915(b)(7), Cisco Systems Inc. hereby certifies that the estoppel provisions of 37 C.F.R. § 1.907 do not prohibit this request for *inter partes* reexamination.

VIRNETX EXHIBIT 2006

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I. Introduction

The claims of U.S. Pat. No. 6,502,135 describe transparently creating a virtual private network (“VPN”) in response to a Domain Name Service (“DNS”) request. The Patent Office has twice identified this feature—creating a VPN in response to a DNS request—in deciding to allow or confirm the claims. In the original prosecution, this feature was successfully argued by the applicants to distinguish over the Examiner’s rejections. In the previously filed *inter partes* reexamination, the Examiner found that the submitted prior art—with the exception of the Aventail reference—failed to adequately teach “establishing a VPN based on a DNS request for an IP address” or “using domain name resolution to establish a VPN.”¹

Unknown to those earlier Examiners, however, other people developed and publicized the same technology of creating a VPN in response to a DNS request more than a year earlier than the applicant for the ‘135 patent. This request shows how the claims of the ‘135 patent are invalid over four primary references. For example, the Kiuchi reference describes how a client sends a DNS request to a specialized name server. The specialized name server responds with the target computer’s address and encryption key. The client then begins communicating securely with the target computer using the encryption key. Thus, Kiuchi teaches that a DNS request is used to initiate a virtual private network connection.

Another reference, Wesinger, teaches that when a client requests the address for a host name, a DNS server returns the IP address of an envoy that will provide a transparent virtual private network connection to the requested host. The other references, Solana and Aziz, similarly provide new, non-cumulative disclosures of creating a VPN in response to a DNS request.

All four references present substantial new questions of patentability because their teachings undermine the earlier reasons for allowing or confirming the ’135 patent claims. Although Aziz and Wesinger are listed on the face of the ’135 patent, the substance of their teachings was never discussed during prosecution or the previously filed reexamination. Because

¹ The Examiner failed to find evidence of the publication date of the Aventail reference and withdrew his rejections based on the Aventail reference for that reason. *See, e.g.*, § III.B. herein.

they have never been considered on the record, this request presents them in a new light and they present substantial new questions of patentability.

Requester therefore asks that an Order for Reexamination be issued and that the reexamination proceeding continue on to reject and cancel claims 1-18 of the '135 Patent.

II. Description of the '135 Patent

The '135 patent currently has 18 total claims and four independent claims—claims 1, 10, 13, and 18. Independent claims 1, 10, and 13 were from the originally filed application, while claim 18 was added during the prior reexamination of the '135 patent.

Each of the independent claims describes a method (claims 1, 13, and 18) or a system (claim 10) for establishing a virtual private network (“VPN”) between two computers. Fig. 26 illustrates a “system employing a DNS proxy server with transparent VPN creation.”² Fig. 27 “shows steps that can be carried out to implement transparent VPN creation based on a DNS look-up function.”³

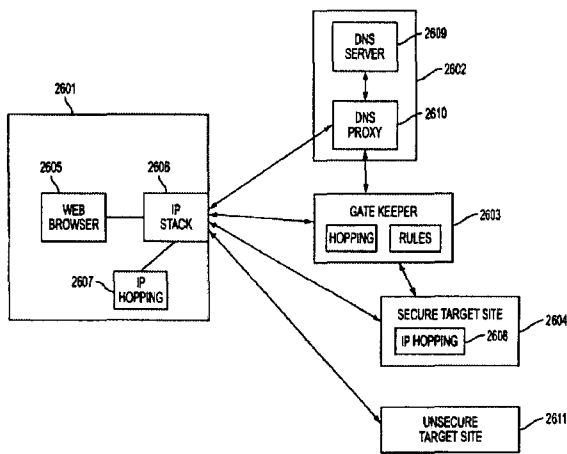


FIG. 26

'135 Patent, Fig. 26

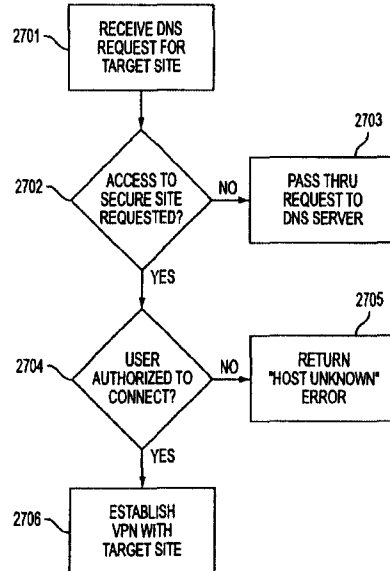


FIG. 27

² '135 Patent, 7:20-21.

³ '135 Patent, 7:22-23.

'135 Patent, Fig. 27

For example, claim 1 recites:

1. A method of transparently creating a virtual private network (VPN) between a client computer and a target computer, comprising the steps of:

(1) generating from the client computer a Domain Name Service (DNS) request that requests an IP address corresponding to a domain name associated with the target computer;

(2) determining whether the DNS request transmitted in step (1) is requesting access to a secure web site; and

(3) in response to determining that the DNS request in step (2) is requesting access to a secure target web site, automatically initiating the VPN between the client computer and the target computer.

III. Prosecution and Reexamination History of the '135 Patent

A. Initial Prosecution of the '135 Patent

During the prosecution of the application that issued as the '135 patent, the Patent Office rejected thirteen of the pending claims (claims 1-10 and 13-15 of the issued '135 patent) under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,330,562 to Boden et al. in view of U.S. Patent No. 6,332,158 to Risley et al. The four remaining pending claims (claims 11, 12, 16, and 17 of the issued '135 patent) were objected to as being dependent upon a rejected base claim.⁴

The Applicant traversed the rejections and argued that neither Boden nor Risley taught or suggested “establishing a VPN based on a DNS request for an IP address” or “using domain

⁴ See Ex. B-1, Non-Final Rejection mailed March 13, 2002, pp. 4-6.

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