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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2013-00354
Patent 7,490,151

**Patent Owner's Preliminary Response
to Petition for *Inter Partes* Review
of U.S. Patent No. 7,490,151**

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OTHER AUTHORITIES

157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011).....10, 11

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