

Filed on behalf of: VirnetX Inc.
By: Joseph E. Palys
Naveen Modi
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
11955 Freedom Drive
Reston, VA 20190-5675
Telephone: 571-203-2700
Facsimile: 202-408-4400
E-mail: joseph.palys@finnegan.com
naveen.modi@finnegan.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2014-00175
Patent 7,921,211

**Patent Owner's Preliminary Response
to Petition for *Inter Partes* Review
of U.S. Patent No. 7,921,211**

Table of Contents

- I. Introduction.....1
- II. The Petition Fails to Meet the Requirements for Instituting an *Inter Partes* Review2
 - A. The Petition Should Not Be Considered Under 35 U.S.C. §§ 312(a)(2) and 315(b)3
 - 1. There Is a Long-Standing Relationship Between RPX and Apple3
 - a) RPX and Apple Worked Jointly to Challenge VirnetX Patents.....3
 - b) RPX and Apple Have Tried to Hide Apple’s Involvement6
 - 2. The Petition Fails to Name a Real Party-in-Interest.....8
 - a) RPX and Apple Violated the First *Guan* Factor.....9
 - b) RPX and Apple Violated the Second *Guan* Factor10
 - c) RPX and Apple Violated the Third *Guan* Factor11
 - d) RPX Is Like the Requester in *Guan*12
 - 3. Trial May Not Be Instituted Under 35 U.S.C. § 315(b)14
 - a) Apple Is a Time-Barred Real Party-in-Interest14
 - b) Apple Is a Time-Barred Privy14
 - 4. Policy Considerations Support Denying the Petition17
 - B. The Petition Fails to Comply with 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.104(b)(4)18
 - C. Claim 37 Was Improperly Challenged for the First Time in the “Corrected Petition”22
 - D. RPX’s Petition Should Be Denied Under 35 U.S.C. § 325(d).....23

- E. The Board Should Not Institute Based on the Petition’s Redundant Grounds.....25
- III. The Petition’s Claim Constructions Are Flawed and Should Be Rejected31
 - A. Overview of the ’211 Patent.....32
 - B. Level of Ordinary Skill in the Art35
 - C. “Domain Name” (Claims 1, 2, 15-18, 20, 21, 24-26, 35-37, 39, 40, 42, 44, 45, 48-50, 59, and 60)36
 - D. “Top-Level Domain Name” (Claims 2-4 and 37).....38
 - E. “Domain Name Service System” (Claims 1, 5, 7, 8, 14-17, 19-24, 27, 33, 35, 36, 41, 48, 51, 57, 59, and 60).....39
 - F. “Secure Communication Link” (Claims 1, 9, 10, 16-18, 22, 24, 26-29, 33, 35, 36, 40-42, 46, 48, 50-53, 57, 59, and 60).....42
 - G. The “Indication” Phrases (Claims 1, 17, 24, 36, 41, 48, and 60).....46
 - H. “Transparently” (Claims 27 and 51)48
 - I. “Secure Name” (Claims 25 and 49)49
- IV. If Trial Is Instituted, VirnetX Requests an 18-Month Schedule52
- V. Conclusion53

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Apple Inc. v. VirnetX Inc.</i> , IPR2013-00348 (June 12, 2013) Paper No. 1	4
<i>Apple Inc. v. VirnetX Inc.</i> , IPR2013-00398 (Oct. 4, 2013) Paper No. 12	20, 30
<i>Asahi Glass Co. v. Toledo Eng'g Co.</i> , 505 F. Supp. 2d 423 (N.D. Ohio 2007)	16
<i>Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.</i> , 672 F.3d 1335 (Fed. Cir. 2012)	49
<i>In re Bigio</i> , 381 F.3d 1320 (Fed. Cir. 2004)	44
<i>EMC Corp. v. Personal Web Techs., LLC</i> , IPR2013-00087 (June 5, 2013) Paper No. 25	26
<i>Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC</i> , IPR2012-00001 (Jan. 9, 2013) Paper No. 15	32, 44
<i>Gustafson v. Alloyd Co., Inc.</i> , 513 U.S. 561 (1995)	15
<i>Idle Free Sys., Inc. v. Bergstrom, Inc.</i> , IPR2012-00027 (June 11, 2013) Paper No. 26	26
<i>In re Guan et al. Inter Partes</i> Reexamination Proceeding, Control No. 95/001,045, Decision Vacating Filing Date (Aug. 25, 2008)	<i>passim</i>
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , IPR2013-00324 (Nov. 21, 2013) Paper No. 19	24
<i>LaRose Indus., LLC v. Capriola Corp.</i> , IPR2013-00120 (July 22, 2013) Paper No. 20	26, 30

Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.,
 CBM2012-00003 (Oct. 25, 2012) Paper No. 7.....25, 26, 27, 30

Motorola Solutions, Inc. v. Mobile Scanning Techs., LLC,
 IPR2013-00093 (Apr. 29, 2013) Paper No. 28.....32, 45

Phelps v. Hamilton,
 122 F.3d 1309 (10th Cir. 1997)16

Phillips v. AWH Corp.,
 415 F.3d 1303 (Fed. Cir. 2005) (en banc)31

SAP Am., Inc. v. Versata Dev. Group, Inc.,
 CBM2012-00001 (June 11, 2013) Paper No. 7038

SAP Am., Inc. v. Pi-Net Int’l, Inc.,
 CBM2013-00013 (Sept. 19, 2013) Paper No. 1515

ScentAir Techs., Inc. v. Prolitec, Inc., Case
 IPR2013-00180 (Aug. 26, 2013) Paper No. 1827

Tasco, Inc. v. Pagnani,
 IPR2013-00103 (May 23, 2013) Paper No. 6.....19

Taylor v. Sturgell,
 553 U.S. 880 (2008).....17

Wowza Media Sys., LLC et al. v. Adobe Sys., Inc.,
 IPR2013-00054 (July 13, 2013) Paper No. 1619

Xilinx, Inc. v. Intellectual Ventures I LLC,
 IPR2013-00112 (June 27, 2013) Paper No. 14.....45

In re Zletz,
 893 F.2d 319 (Fed. Cir. 1989)31

ZTE Corp. & ZTE (USA) Inc. v. ContentGuard Holdings Inc.,
 IPR2013-00134 (June 19, 2013) Paper No. 12.....45

State Cases

Arpadi et al. v. First MSP Corp. et al.,
 68 Ohio St. 3d 453 (Sept. 21, 1993)16

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.