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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2014-00176
Patent 7,418,504

**Patent Owner's Preliminary Response
to Petition for *Inter Partes* Review
of U.S. Patent No. 7,418,504**

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 Apple4
 - a) RPX and Apple Worked Jointly to Challenge VirnetX Patents.....4
 - 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.....10
 - 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*13
 - 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 Privy15
 - 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)19
 - C. Claims 16 and 21 Were Improperly Challenged for the First Time in the “Corrected Petition”23
 - D. RPX’s Petition Should Be Denied Under 35 U.S.C. § 325(d).....24

- E. The Proposed Grounds Treat *Aventail* as a Single Document Instead of Two Separate Documents.....26
- F. The Board Should Not Institute Based on the Petition’s Redundant Grounds28
- III. The Petition’s Claim Constructions Are Flawed and Should Be Rejected34
 - A. Overview of the ’504 Patent.....35
 - B. Level of Ordinary Skill in the Art38
 - C. “Domain Name” (Claims 1, 2, 7, 8, 15-18, 20-21, 24-26, 35-37, 39-40, 42, 44-45, 48-50, and 59-60)39
 - D. “Top-Level Domain Name” (Claims 2-4 and 37).....41
 - 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).....42
 - 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).....45
 - G. The “Indication” Phrases (Claims 1, 17, 24, 36, 41, 48, and 60).....49
 - H. “Transparently” (Claims 27 and 51)51
 - I. “Secure Name” (Claims 25 and 49)52
- IV. If Trial Is Instituted, VirnetX Requests an 18-Month Schedule55
- V. Conclusion56

TABLE OF AUTHORITIES

Page(s)

Federal Cases

Apple Inc. v. Int’l Trade Comm’n,
725 F.3d 1356 (Fed. Cir. 2013)27

Apple Inc. v. VirnetX Inc.,
IPR2013-00348 (June 12, 2013) Paper No. 14

Apple Inc. v. VirnetX Inc.,
IPR2013-00393 (Oct. 4, 2013) Paper No. 1320, 26, 33

Asahi Glass Co. v. Toledo Eng’g Co.,
505 F. Supp. 2d 423 (N.D. Ohio 2007)16

Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.,
672 F.3d 1335 (Fed. Cir. 2012)52

In re Bigio,
381 F.3d 1320 (Fed. Cir. 2004)47

CallCopy, Inc. v. Verint Ams., Inc.,
IPR2013-00486 (Feb. 5, 2014) Paper No. 1128

EMC Corp. v. Personal Web Techs., LLC,
IPR2013-00087 (June 5, 2013) Paper No. 25.....29

Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC,
IPR2012-00001 (Jan. 9, 2013) Paper No. 15.....35, 47

Graham v. John Deere Co. of Kansas City,
383 U.S. 1 (1966).....28, 29

Gustafson v. Alloyd Co., Inc.,
513 U.S. 561 (1995).....15

Idle Free Sys., Inc. v. Bergstrom, Inc.,
IPR2012-00027 (June 11, 2013) Paper No. 26.....29

In re Guan et al. Inter Partes Reexamination Proceeding, Control No. 95/001,045, Decision Vacating Filing Date (Aug. 25, 2008).....*passim*

Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.,
IPR2013-00324 (Nov. 21, 2013) Paper No. 1924

LaRose Indus., LLC v. Capriola Corp.,
IPR2013-00120 (July 22, 2013) Paper No. 2029, 33

Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.,
CBM2012-00003 (Oct. 25, 2012) Paper No. 7.....28, 29, 30, 33

Motorola Solutions, Inc. v. Mobile Scanning Techs., LLC,
IPR2013-00093 (Apr. 29, 2013) Paper No. 28.....35, 48

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

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) (en banc)34

SAP Am., Inc. v. Versata Dev. Group, Inc.,
CBM2012-00001 (June 11, 2013) Paper No. 7041

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. 1830

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.....48

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