

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re *Inter Partes* Reexamination of: )  
 )  
Victor Larson et al. ) Control No.: 95/001,788  
 )  
U.S. Patent No. 7,418,504 ) Group Art Unit: 3992  
 )  
Issued: August 26, 2008 ) Examiner: Roland Foster  
 )  
For: AGILE NETWORK PROTOCOL FOR SECURE ) Confirmation No.: 5823  
COMMUNICATIONS USING SECURE )  
DOMAIN NAMES )

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

**PATENT OWNER'S RESPONSE TO**  
**OFFICE ACTION OF DECEMBER 29, 2011**

TABLE OF CONTENTS

|     |   |    |
|-----|---|----|
| I.  | INTRODUCTION .....  | 1  |
| A.  | Applicable Legal Standards .....  | 2  |
| 1.  | The Law of Anticipation .....   | 2  |
| 2.  | The Law of Obviousness .....  | 2  |
| 3.  | The Law of Inherency .....  | 3  |
| B.  | Background of the '504 Patent .....   | 3  |
| II. | CLAIMS 1-60 ARE PATENTABLE .....  | 5  |
| A.  | The Rejections Based on <i>Solana</i> and/or <i>Reed</i> Are Improper Because<br>Neither Reference Has Been Shown to Be Prior Art (Grounds 1-8, 11, 15,<br>19, 24, 28, and 33) .....                        | 5  |
| 1.  | A Reference Is a "Printed Publication" Only When the Requisite<br>Showing Is Made .....   | 6  |
| 2.  | Requester Failed to Satisfy Its Duty to Disclose Any Evidence of<br>Publication and Is Presumed to Have None.....   | 6  |
| 3.  | Requester's Bare Contention of Publication Is Inadequate .....  | 7  |
| B.  | The Rejections Based on the RFC Documents (Grounds 2, 5-8, 10, 13-20,<br>and 22-35) Are Improper Because the RFC Documents Have Not Been<br>Shown to Be Prior Art.....                                      | 8  |
| C.  | Independent Claims 1, 36, and 60 Are Patentable over the Cited Art<br>Applied in the Rejections of These Claims (Grounds 1, 5, 9, 13, 17, 21,<br>25, and 30) .....  | 10 |
| 1.  | Independent Claims 1, 36, and 60 Are Patentable over <i>Solana</i><br>(Ground 1).....   | 10 |
| a)  | Overview of <i>Solana</i> .....   | 10 |
| b)  | <i>Solana</i> Does Not Disclose the Elements of Independent<br>Claim 1 .....  | 11 |
| (1) | <i>Solana</i> Does Not Disclose "a Domain Name<br>Service System Configured to . . . Store Domain<br>Names and Corresponding Network Addresses".....  | 11 |
| (2) | <i>Solana</i> Does Not Disclose "a Domain Name<br>Service System Configured to . . . Receive a Query<br>for a Network Address" .....  | 13 |
| (3) | <i>Solana</i> Does Not Teach "a Domain Name Service<br>System Configured to . . . Comprise an Indication<br>that the Domain Name Service System Supports<br>Establishing a Secure Communication Link" ..... | 15 |

|     |  |    |
|-----|--|----|
| c)  | <i>Solana</i> Does Not Disclose the Elements of Independent Claims 36 and 60 .....   | 16 |
| 2.  | Independent Claims 1, 36, and 60 Are Patentable over <i>Solana</i> in View of RFC 2504 (Ground 5) .....  | 16 |
| 3.  | Independent Claims 1, 36, and 60 Are Patentable over <i>Provino</i> (Ground No. 9).....  | 18 |
| a)  | Overview of <i>Provino</i> .....   | 18 |
| b)  | <i>Provino</i> Does Not Disclose Each and Every Element of Independent Claims 1, 36, and 60.....   | 19 |
| 4.  | Independent Claims 1, 36, and 60 Are Patentable over <i>Provino</i> in View of RFC 2230 (Ground 13) .....  | 22 |
| 5.  | Independent Claims 1, 36, and 60 Are Patentable over <i>Provino</i> in View of RFC 2504 (Ground 17) .....  | 23 |
| 6.  | Independent Claims 1, 36, and 60 Are Patentable over <i>Beser</i> (Ground 21).....   | 24 |
| a)  | Overview of <i>Beser</i> .....   | 24 |
| b)  | <i>Beser</i> Does Not Disclose “a Domain Name Service System Configured . . . to Comprise an Indication that the Domain Name Service System Supports Establishing a Secure Communication Link” ..... | 25 |
| 7.  | Independent Claims 1, 36, and 60 Are Patentable over RFC 2230 (Ground 25).....   | 26 |
| a)  | Overview of RFC 2230.....  | 27 |
| b)  | RFC 2230 Does Not Disclose Each and Every Element of Independent Claim 1 .....   | 27 |
| (1) | A KX Resource Record Is Not “an Indication that the Domain Name Service System Supports Establishing a Secure Communication Link” .....  | 28 |
| (2) | The Alleged Establishment and Use of an IPsec Security Association Is Not “an Indication that the Domain Name Service System Supports Establishing a Secure Communication Link” .....                | 29 |
| (3) | RFC 2230 Discloses a Conventional Domain Name Service System Distinguished by the ‘504 Patent .....  | 30 |
| 8.  | Independent Claims 1, 36, and 60 Are Patentable over RFC 2538 (Ground 30).....   | 31 |
| a)  | Overview of RFC 2538.....  | 32 |
| b)  | RFC 2538 Does Not Disclose Each and Every Element of Independent Claims 1, 36, and 60.....   | 32 |

|    |  |    |
|----|--|----|
| D. | Dependent Claims 2-35 and 37- 59 Are Patentable over the Cited References (Grounds 1-35).....      | 34 |
| E. | Dependent Claims 5, 23, and 47 Are Patentable over the Cited References .....                      | 34 |
| 1. | Rejections Based on <i>Solana</i> (Grounds 1, 2, 5, and 6).....                                    | 35 |
| 2. | Rejections Based on <i>Provino</i> (Grounds 9, 10, 13, 14, 17, and 18).....                        | 35 |
| F. | Dependent Claims 8 and 9 Are Patentable over the Cited References .....                            | 36 |
| 1. | Rejections Based on <i>Solana</i> (Grounds 1 and 5).....   | 37 |
| 2. | Rejections Based on <i>Provino</i> (Grounds 9, 13, and 17).....                                    | 37 |
| 3. | Rejections Based on <i>Beser</i> (Ground 23).....  | 38 |
| 4. | Rejections Based on RFC 2230 (Ground 27) .....   | 39 |
| 5. | Rejections Based on RFC 2538 (Ground 32) .....   | 40 |
| G. | Dependent Claims 16, 17, 27, 33, 40, 41, 51, and 57 Are Patentable over the Cited References ..... | 40 |
| 1. | Rejections Based on <i>Solana</i> (Grounds 1 and 5).....   | 41 |
| 2. | Rejections Based on <i>Provino</i> (Grounds 9, 13, and 17).....                                    | 42 |
| 3. | Rejections Based on <i>Beser</i> (Ground 21).....  | 43 |
| 4. | Rejections Based on RFC 2230 (Ground 25) .....   | 43 |
| 5. | Rejections Based on RFC 2538 (Ground 30) .....   | 44 |
| H. | Dependent Claims 18 and 42 Are Patentable over the Cited References .....                          | 44 |
| 1. | Rejections Based on <i>Solana</i> (Grounds 1 and 5).....   | 45 |
| 2. | Rejections Based on <i>Beser</i> (Ground 21).....  | 45 |
| 3. | Rejections Based on RFC 2230 (Ground 25) .....   | 46 |
| 4. | Rejections Based on RFC 2538 (Ground 30) .....   | 47 |
| I. | Dependent Claims 24 and 48 Are Patentable over the Cited References .....                          | 47 |
| 1. | Rejections Based on <i>Solana</i> (Grounds 1, 2, 5, and 6).....                                    | 48 |
| 2. | Rejections Based on <i>Provino</i> (Grounds 9, 10, 13, 14, 17, and 18).....                        | 49 |
| 3. | Rejections Based on <i>Beser</i> (Grounds 21 and 22).....  | 50 |
| 4. | Rejections Based on RFC 2230 (Grounds 25 and 26).....  | 51 |
| 5. | Rejections Based on RFC 2538 (Grounds 30 and 31) .....   | 52 |
| J. | Dependent Claims 26 and 50 Are Patentable over the Cited References .....                          | 53 |
| 1. | Rejections Based on <i>Solana</i> (Grounds 1 and 5).....   | 53 |
| 2. | Rejections Based on <i>Provino</i> (Grounds 9, 13, and 17).....                                    | 54 |
| 3. | Rejections Based on <i>Beser</i> (Ground 21).....  | 55 |

- 4. Rejections Based on RFC 2230 (Ground 25) ..... 55
- 5. Rejections Based on RFC 2538 (Ground 30) ..... 56
- K. A *Prima Facie* Case of Obviousness Has Not Been Established ..... 56
- L. Secondary Considerations Demonstrate Nonobviousness..... 57
- III. CONCLUSION..... 60

# 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.