IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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

COMMENTS BY THIRD PARTY REQUESTER PURSUANT TO 37 C.F.R. § 1.947

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

Sir:

On March 29, 20102, Patent Owner filed an overlength response ("Response") to the December 29, 2012 Office action ("Office Action") and a petition under 37 C.F.R. § 1.183 seeking waiver of the page limit for that response. On May 25, 2012, the Examiner granted Patent Owner's petition, and set the date for a response by the Requestor for 30 days from the date of decision, which fell on Sunday June 24, 2012. This response is timely filed on the next business day. 35 U.S.C. § 21. Third Party Requester believes that no fee is due in connection with the present response. However, any fee required for entry or consideration of this paper may be debited from Deposit Account No. 18-1260.

I. Introduction

For reasons set forth in detail below, Requestor urges the Examiner to maintain the rejections of claims 1-60 set forth in the Office Action. Provided herewith is Declaration of Michael Allyn Fratto under 37 C.F.R. § 1.132 ("Fratto"). Pages 1-6 of that declaration response to contentions of the Patent Owner regarding the status of *Solana*, *Reed*, and several RFC publications. Requester submits those pages do not count against the 50-page limit for Response under 37 C.F.R § 1.943(b), pursuant to MPEP §2667.

II.   Response to Patent Owner Contentions on Status of References as Prior Art.

On pages 5-9 of the Response, Patent Owner argues that there is "no evidence" that the *Solana*, *Reed*, and "RFCs" are prior art under 35 U.S.C. § 102(a) or (b). The Patent Owner's claims border on the frivolous – each of the contested references is unquestionably a printed publication, and only by a studied ignorance of the facts can Patent Owner assert otherwise.

Patent Owner grossly misstates Requestor's burden to establish that the cited publications were publicly disseminated. According to Patent Owner, Requestor was required to provide "a showing" with "evidence proving" the date each reference was made publically available. Response at 6 (citing 37 C.F.R. §11.18). This is plainly incorrect – all that is required is that Requester represent that the reference was published. In fact, 37 C.F.R. § 11.18 (the regulation patent owner cites) states precisely this – it provides that the submission of a paper by a party is a certification that "[t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances… [t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery." 37 CFR 11.18(b)(2)(iii). Moreover, *In re Wyer*, 655 F.2d 221 (C.C.P.A. 1980) (cited by the Patent Owner) did not hold a party had to preemptively present evidence to prove public availability. To the contrary, it held only that "sufficient proof" as to the publication date must exist. *Id.* at 226-27. Thus, no authority supports Patent Owner's contention that Requestor was required to present independent evidence with its request proving the date of public availability of each reference.

Regardless, each of *Solana*, *Reed* and the RFC documents was publicly disseminated more than a year before February 15, 2000.[1] A reference is publicly accessible if it was "disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence can locate it." *Kyocera Wireless Corp. v. Int'l Trade Comm''n*, 545 F.3d 1340, 1350 (2008) (internal quotation marks omitted). Each of *Solana* and *Reed* was formally published as part of a compilation of technical papers originally presented to conferences of experts in network and security techniques. Each paper on its face states this, and provides the dates of each conference. Each paper, thus, was made publicly available to the relevant public more than year before the effective filing date of

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[1]   The Patent Owner did not contest Requester's assertions that the effective filing date of the '504 patent is no earlier than February 15, 2000, as set forth on page 10 of the Request.

the '504 patent. *See e.g., In re Bayer*, 568 F.2d 1357, 1361 (C.C. P.A.1978). Patent Owner does not seriously contest these facts. Instead, Patent Owner simply contends Requester did not present <u>additional</u> evidence <u>with the Request</u> proving that these statements were true. Requester had no such burden. Nonetheless, to remove any doubt, Requester presents additional evidence in the Declaration of Michael Fratto ("Fratto ") which conclusively establishes that each of *Solana* and *Reed* was formally published and distributed <u>years</u> before February 15, 2000.

Solana was published in a treatise called "Lecture Notes in Computer Science" (LCNS) by Springer-Verlag in 1998.[2] Fratto at ¶9-10.   The introduction to this treatise dated in December of 1997 indicates that *Solana* was first presented to the relevant public at a conference on networking in April of 1997. *Id.* at ¶11. As described, LCNS presents "the strictly refereed post-workshop proceedings of the 5th International Workshop on Security Protocols, held in Paris, France, in April 1997." *Id.* at ¶10. Consequently, *Solana* is a printed publication that was made publicly available in 1997, and was formally published no later than 1998.

Reed indicates that it was first distributed to the public at the 12th Annual Computer Security Applications Conference in December 1996. As Mr. Fratto explains, under the ACSA procedures, *Reed* would have been made publically available no later than the start date of the conference. Fratto at ¶12-13. Mr. Fratto also provides evidence showing the date and time that the *Reed* paper was presented at this conference. Additionally, Mr. Fratto provide evidences from the Association of Computing Machinery (ACM) website reporting the citation of the *Reed* paper, demonstrating its public availability. Thus, *Reed* is a printed publication that was made publicly available no later than December of 1996.

Next, Patent Owner challenges the status of several Request for Comment (RFC) documents cited in the Request, claiming that "the record is devoid of evidence that any of these references are … printed publications as of" each publication date listed on each RFC. This is a frivolous challenge. As anyone working in the field of network communications would know, RFC documents are published and disseminated to the relevant public by the Internet Engineering Task Force (IETF) pursuant to a transparent and well-known process. Under these well-known procedures, RFCs are self-authenticating printed publications – each contains

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[2]   Requester notes that the IDS submitted with the Request incorrectly lists the publication date of the LCNS treatise as "1997" – the actual publication date was 1998. This distinction has no consequence – *Solana* remains prior art under 35 U.S.C. § 102(b).

verifiable information documenting the date of its public distribution. Specifically: (i) each number assigned to an RFC is unique and is not "re-used" if the subject matter in an RFC is revised or updated, (ii) the date each RFC is distributed to the public is listed the front page of the RFC, (iii) RFCs are distributed to the public over the Internet, via numerous protocols, (iv) each RFC is announced via an email distribution list on the date it is released to the public, and (v) RFCs are maintained in numerous archives publicly accessible via the Internet. *Id.* at ¶18-22. Indeed, Patent Owner cites several RFCs as publications in the '504 disclosure. Given this, it is remarkable that Patent Owner can even suggest that RFCs are not publicly disseminated.[3] The evidence, thus, overwhelmingly establishes that *Solana*, *Reed* and the various RFCs are printed publications applicable as prior art to the '504 patent claims.

III. The Rejections Of the Claims Were Proper And Should Be Maintained

A. Claim Interpretation

Claims are given "their broadest reasonable interpretation, consistent with the specification, in reexamination proceedings." *In re Trans Texas Holding Corp.*, 498 F.3d 1290, 1298 (Fed. Cir. 2007). In determining that meaning "it is improper to 'confin[e] the claims to th[e] embodiments' found in the specification." *Id.* at 1299 (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*)). While "the specification [should be used] to interpret the meaning of a claim," the PTO cannot "import[] limitations from the specification into the claim." *Id.* "A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must *clearly* express that intent in the written description." *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) (emphasis added). No such definitions of key claim terms is provided in the '504 patent (i.e., "domain service system", "secure communication link", "indication", "supports", or "supporting", "connectable" or "enables").[4] Thus, these terms must be given their broadest reasonable interpretation in these reexamination proceedings.

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[3]   *See, e.g.,* '504 patent at page 3 (citing RFCs 2401 and 2543 as "publications").

[4]   At trial, Patent Owner argued that a "DNS proxy server" is simply "a computer or program that responds to a domain name inquiry in place of a DNS." Ex. A, Markman at 19-20. Patent Owner also argued that the phrase "Domain Name Service System" did not need a construction but if it did, it was just "a computer system that includes a domain name service (DNS)." *Id*. Patent Owner also asserted the claimed DNS systems did not have to be able to

B.   **Response to Patent Owner's Arguments Regarding the Rejection of Claims 1-2, 5-6, 8-9, and 14-60 Under 35 U.S.C. § 102(b) based on *Solana* (Ground Nos. 1, 5, 9, 13, 17, 21, 25, 30)**

1.   ***Solana* Describes the Claimed DNS Systems**

As explained in the Request, *Solana* describes domain name service systems ("DNS systems") that establish secure communication links between an initiator (the source domain) and a responder (the destination domain). *See* Request at 39- 46; *see also* Declaration of Angelos D. Keromytis ("Keromytis") at ¶ 20-21. *Solana* also describes that its DNS systems are connected to a communication network, store a plurality of domain names and corresponding network addresses, receive queries for a network address and comprises an indication that it (i.e., the "domain name service system") supports establishing secure communication links. Consequently, the Office properly found that *Solana* describes "DNS systems" that anticipate independent claims 1, 36 and 60. In response, Patent Owner asserts *Solana* does not teach DNS systems that: (1) "store domain names and corresponding network addresses"; [5] (2) "receive a query for network address" or (3) "comprise an indication that the domain name service system supports establishing a secure communication link." Each of these is incorrect.

a.   ***Solana* Describes DNS Systems that Store a Plurality of Domain Names and Corresponding Network Addresses and That Receive Requests for a Network Address**

The Office correctly found that *Solana* discloses both "a domain name service system configured to . . . store a plurality of domain names and corresponding network addresses" and that the system receives requests for a network address. As explained in the Request (*see, e.g.,* Request at 39- 46), *Solana* describes DNS systems that create domain-to-domain relationships to enable principals in different Internet domains to more efficiently and securely conduct "generic" Internet transactions. One of the elements of this scheme is the "Directory Service" (DS), which *Solana* explains publishes "naming information" and certificates that "securely bind domains to their public keys." *See Solana* at 43 (Fig. 1). This published "naming information" is used to retrieve public keys associated with and establish secure links between the domains. Logically,

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distinguish between secure and unsecure sites. *See Id*. Patent Owner's arguments at trial should be considered in determining the broadest reasonable construction of the claims.

[5]   The independent claims do not require the DNS system to actually resolve a domain name into an IP address – that is an additional step specified in dependent claims (e.g., claim 15). Thus, the independent claims only require DNS systems that, *inter alia*, store domain names and corresponding IP addresses.

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