

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

---

APPLE INC.  
Petitioner

v.

VIRNETX INC.  
Patent Owner

---

Case IPR2013-00398  
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 <i>Inter Partes</i> Review.....	3
A.	The Petition Must Be Denied Under 35 U.S.C. § 315(b) .....	4
1.	Procedural History Relevant to § 315(b) .....	5
2.	The Plain Meaning of § 315(b) and the Board’s Precedent Bar the Petition.....	6
3.	The Legislative History Confirms that the Petition Is Barred.....	9
4.	Denying the Petition Is Not Unjust.....	11
B.	The Petition Fails to Comply with 37 C.F.R. § 42.104(b)(4) .....	12
C.	The Board Should Not Institute Based on the Petition’s Redundant Grounds.....	13
III.	The Petition’s Claim Constructions Are Flawed and Should Be Rejected .....	18
A.	Overview of the ’211 Patent.....	20
B.	“Domain Name” (Claims 1, 2, 15-18, 20, 21, 24-26, 35-37, 39, 40, 42, 44, 45, 48-50, 59, and 60) .....	23
C.	“Top-Level Domain Name” (Claims 2-4 and 37).....	25
D.	“Domain Name Service” (Claims 1 and 60).....	27
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).....	29
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).....	32
G.	The “Indication” Phrases (Claims 1, 17, 24, 36, 41, 48, and 60).....	36

H. “Transparently” (Claims 27 and 51) .....38  
I. “Secure Name” (Claims 25 and 49) .....39  
IV. If Trial Is Instituted, VirnetX Requests an 18-Month Schedule .....42  
V. Conclusion .....43

## Table of Authorities

	<b>Page(s)</b>
<b>FEDERAL CASES</b>	
<i>Conn. Nat’l Bank v. Germain</i> , 503 U.S. 249 (1992).....	9
<i>Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC</i> , IPR2012-00001 (Jan. 9, 2013) Paper No. 15.....	19, 34
<i>In re Bigio</i> , 381 F.3d 1320 (Fed. Cir. 2004) .....	33
<i>In re Zletz</i> , 893 F.2d 319 (Fed. Cir. 1989) .....	19
<i>LaRose Indus., LLC v. Capriola Corp.</i> , IPR2013-00120 (July 22, 2013) Paper No. 20 .....	14, 18
<i>Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.</i> , CBM2012-00003 (Oct. 25, 2012) Paper No. 7.....	4, 14, 17, 18
<i>Motorola Solutions, Inc. v. Mobile Scanning Techs., LLC</i> , IPR2013-00093 (Apr. 29, 2013) Paper No. 28.....	19, 34
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc) .....	19
<i>Universal Remote Control, Inc. v. Universal Elecs., Inc.</i> , IPR2013-00168 (Aug. 26, 2013) Paper No. 9 .....	4, 5, 8, 9
<i>Xilinx, Inc. v. Intellectual Ventures I LLC</i> , IPR2013-00112 (June 27, 2013) Paper No. 14.....	34
<i>ZTE Corp. &amp; ZTE (USA) Inc. v. ContentGuard Holdings Inc.</i> , IPR2013-00134 (June 19, 2013) Paper No. 12.....	34
<b>FEDERAL STATUTES</b>	
35 U.S.C. § 313 .....	1
35 U.S.C. § 315(b) .....	passim

35 U.S.C. § 316(a)(1).....40

**FEDERAL REGULATIONS**

37 C.F.R. § 42.100(b) .....18

37 C.F.R. § 42.100(c).....40

37 C.F.R. § 42.104(b)(4).....3, 12, 13

37 C.F.R. § 42.107 .....1

**OTHER AUTHORITIES**

157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011)..... 9-11

Meeting of the H. Comm. on Judiciary, Transcript of Markup of H.R. 1249  
(Apr. 14, 2011).....10

# 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.