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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.  
Petitioner

v.

VIRNETX INC.  
Patent Owner

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Case IPR2014-00238  
Patent 8,504,697

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**Patent Owner's Preliminary Response  
to Petition for *Inter Partes* Review  
of U.S. Patent No. 8,504,697**

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## I. Introduction

Patent Owner VirnetX Inc. respectfully submits this Preliminary Response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107, responding to the Petition for *Inter Partes* Review of VirnetX's U.S. Patent No. 8,504,697 ("the '697 patent") filed by Apple Inc. VirnetX requests that the Board not institute *inter partes* review for several reasons.

First, the Petition proposes rejections that the Examiner considered during prosecution of the '697 patent and over which the Examiner allowed the claims. Specifically, the Petition proposes rejections based on *Wesinger* (Ex. 1008), *Kiuchi* (Ex. 1011), and a collection of documents it calls "*Aventail*" (Ex. 1007). (Pet. at 3.) During prosecution of the '697 patent, however, VirnetX submitted these references to the Examiner and the Examiner considered them. (See Ex. 1001 at 2, 4, 5, 7, 8, 16.) The Examiner also considered materials from reexaminations of patents related to the '697 patent, including claim charts applying *Wesinger*, *Kiuchi*, and *Aventail* to the claims of those patents. (See *id.* at 9-12, 14, 15, 16.) The Examiner had initially rejected the '697 patent claims based on *Wesinger*, (Ex. 1002 at 591, 711), but later withdrew the rejection and allowed the claims in light of VirnetX's arguments in support of patentability and claim amendments, (*id.* at 1033-35.) And although the Examiner never rejected the '697 patent claims over *Kiuchi*, the Examiner discussed it in his statement of reasons for allowance. (*Id.* at

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