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Paper 15
Date: May 14, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2014-00238
Patent 8,504,697 B2

Before MICHAEL P. TIERNEY, KARL D. EASTHOM, and STEPHEN C. SIU, *Administrative Patent Judges.*

SIU, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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I. BACKGROUND

A. Background

Apple, Inc. ("Petitioner") requests *inter partes* review of claims 1-11, 14-25, and 28-30 of U.S. Patent No. 8,504,697 B2 ("'697 Patent," Ex. 1001) pursuant to 35 U.S.C. §§ 311-319. VirnetX Inc. ("Patent Owner") filed a Preliminary Response ("Prelim. Resp.") on March 6, 2014. Paper No. 12.

We have jurisdiction under 35 U.S.C. § 314. The standard for instituting *inter partes* review is set forth in 35 U.S.C. § 314 (a) which provides:

> THRESHOLD The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

We determine, based on the record, that Petitioner has demonstrated, under 35 U.S.C. § 314(a), that there is a reasonable likelihood of unpatentability with respect to at least one of the challenged claims.

Petitioner relies on the following prior art:

US 5,898,830 (Wesinger) Apr. 27, 1999 (Ex. 1008)

Aventail Connect 3.01/2.51 Administrator's Guide, 1996-1999 (Ex. 1007 – "Aventail").

Takahiro Kiuchi and Shigekoto Kaihara, "*C-HTTP – The Development of a Secure, Closed HTTP-based Network on the Internet,*" PROCEEDINGS OF THE SYMPOSIUM ON NETWORK AND DISTRIBUTED SYSTEM SECURITY, IEEE (1996) (Ex. 1011 – "Kiuchi").

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H. Handley, H. Schulzrinne, E. Schooler, and J. Rosenberg, "*SIP: Session Initiation Protocol*," NETWORK WORKING GROUP, REQUEST FOR COMMENTS: 2543 (March 1999) (Ex. 1012 – "RFC 2543").

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. § 102 and § 103 based on the following specific grounds (Pet. 4, 15-60):

Reference(s)	**Basis**	**Claims challenged**
Wesinger	§ 102	1-3, 8-11, 14-17, 22-25, and 28-30[1]
Wesinger and RFC 2543	§ 103	4-7 and 18-21
Aventail	§ 102	1-3, 8-11, 14-17, 22-25, and 28-30[2]
Aventail and RFC 2543	§ 103	4-7 and 18-21
Kiuchi	§ 102	1-3, 8-11, 14-17, 22-25, and 28-30

B. The Invention

The '697 patent describes a system and method for establishing a secure communication link between a first computer and a second computer over a computer network. Ex. 1001, 6:42-45, 49:30-32. The user obtains a URL for a secure top-level domain name by querying a secure domain name service that contains a cross-reference database of secure domain names and corresponding secure network addresses. Ex. 1001, 50:66 – 51:2, 51:37-38. When the user

[1] Petitioner lists claims 1-3, 8-11, 14-25, and 28-30 as anticipated by either Wesinger or Aventail (Pet. 4) but provides arguments for only claims 1-3, 8-11, 14-17, 22-25, and 28-30. Pet. 15-60. We assume that Petitioner intends to apply this proposed ground of unpatentability under 35 U.S.C. § 102 to claims 1-3, 8-11, 14-17, 22-25, and 28-30 only.

[2] *See* note 1.

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queries the secure domain name service for a secure computer network address, the secure domain name service determines the particular secure computer network address and returns the network address corresponding to the request. Ex. 1001, 40:7-11, 39:44-47, 51:54-59.

Claim 1 of the '697 patent is reproduced below:

> 1. A method of connecting a first network device and a second network device, the method comprising:
>
> intercepting, from the first network device, a request to look up an internet protocol (IP) address of the second network device based on a domain name associated with the second network device;
>
> determining, in response to the request, whether the second network device is available for a secure communications service; and
>
> initiating a secure communication link between the first network device and the second network device based on a determination that the second network device is available for the secure communications service;
>
> wherein the secure communications service uses the secure communication link to communicate at least one of video data and audio data between the first network device and the second network device.

We note that the '697 patent is not subject to other proceedings. *See* Pet. 2.

C. Claim Interpretation

Consistent with the statute and the legislative history of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (Sept. 16, 2011) ("AIA"), the Board interprets claim terms by applying the broadest reasonable construction in the context of the specification in which the claims reside. 37 C.F.R. § 42.100(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012.)

Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary

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skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In this regard, however, we are careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

In assessing the merit of Petitioner's arguments, we have construed the following claim terms in light of the Specification of the '697 patent.

1. "secure communication link"

Claim 1, for example, recites initiating a "secure communication link" between devices. Petitioner argues that the term "secure communication link" should be construed to include "[a] communication link in which computers privately and directly communicate with each other on insecure paths between the computers where the communication is both secure and anonymous, and where the data transferred may or may not be encrypted." Pet. 9. Patent Owner argues that the term should be construed to mean "[a] direct communication link that provides data security through encryption." Prelim. Resp. 20.

As described above, Petitioner argues that the "secure communication link," as recited, for example, in claim 1, should include the features of computers "privately and directly" communicating with each other "on insecure paths" and that the "communication is both secure and anonymous." Petitioner has not demonstrated sufficiently that the Specification supports the contention that a "secure communication link" must include each of the proposed limitations. Therefore, we are not persuaded by Petitioner's arguments that a broad but

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