

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VIRNETX INC.,
Patent Owner.

Case IPR2014-00404¹

Patent 7,987,274 B2

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

SIU, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Microsoft Corp. filed a Petition (Paper 2) (“Pet.”) seeking an *inter partes* review of claims 1–5, 7, 8, 10, 12, 15, and 17 of U.S. Patent No.

¹ As discussed below, IPR2014-00484 has been joined with IPR2014-00404. This Final Written Decision applies to the joined case.

IPR2014-00404
Patent 7,987,274 B2

7,987,274 B2 (Ex. 1001, “the ’274 patent”) pursuant to 35 U.S.C. §§ 311–319. On July 31, 2014, the Board instituted an *inter partes* review of claims 1–5, 7, 8, 10, 12, 15, and 17 (Paper 13) (“Dec. on Inst.”).

Apple Inc. (“Petitioner”) filed a Petition (IPR2014-00484, Paper 1) seeking an *inter partes* review of claims 1–5, 7, 8, 10, 12, 13, 15, 17, and 18 of the ’274 patent pursuant to 35 U.S.C. §§ 311–319. On September 15, 2014, the Board instituted an *inter partes* review of claims 1–5, 7, 8, 10, 12, 15, and 17 (IPR2014-00484) and joined IPR2014-00484 with IPR2014-00404 pursuant to 35 U.S.C. § 315(c) (IPR2014-00484, Paper 11 – Dec. on Inst.). On April 16, 2015, the present proceeding was terminated with respect to Microsoft Corporation only. Paper 38.

Subsequent to institution, VirnetX Inc. (“Patent Owner”) filed a Patent Owner Response (Paper 26) (“PO Resp.”), and Petitioner filed a Reply (Paper 34) (“Pet. Reply”). An Oral Hearing was conducted on April 28, 2015.

The Board has jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–5, 7, 8, 10, 12, 15, and 17 of the ’274 patent are unpatentable.

A. *The ’274 Patent (Ex. 1001)*

The ’274 patent describes methods for communicating over the Internet. Ex. 1001, 9:38–39.

B. Illustrative Claim

Claim 1 of the '274 patent is reproduced below:

1. A method of accessing a secure network address, comprising:

 sending a query message from a first network device to a secure domain service, the query message requesting from the secure domain service a secure network address for a second network device;

 receiving at the first network device a response message from the secure domain name service containing the secure network address for the second network device; and

 sending an access request message from the first network device to the secure network address using a virtual private network communication link.

C. Cited Prior Art

| | | | |
|----------|-----------------|---------------|------------|
| Lindblad | US 6,225,993 B1 | May 1, 2001 | (Ex. 1009) |
| Bhatti | US 8,200,837 B1 | June 12, 2012 | (Ex. 1010) |

Takahiro Kiuchi and Shigekoto Kaihara, "C-HTTP – The Development of a Secure, Closed HTTP-Based Network on the Internet," Proceedings of SNDSS, 1996 (Ex. 1004 – "Kiuchi").

D. Instituted Grounds of Unpatentability

| References | Basis | Claims Challenged |
|------------------------------|-------|-------------------------------|
| Kiuchi | § 102 | 1–4, 7, 8, 10, 12, 15, and 17 |
| Kiuchi and Lindblad | § 103 | 5 |
| Kiuchi and Bhatti | § 103 | 1–4, 7, 8, 10, 12, 15, and 17 |
| Kiuchi, Bhatti, and Lindblad | § 103 | 5 |

E. Claim Interpretation

Virtual Private Network (VPN) Communication Link

We previously determined that, under a broadest reasonable construction, one of skill in the art would have understood the term “virtual private network communication link,” in light of the Specification, to include “a transmission path between two devices that restricts access to data, addresses, or other information on the path, generally using obfuscation methods to hide information on the path, including, but not limited to, one or more of authentication, encryption, or address hopping.” Dec. on Inst. 7.² Patent Owner disputes this interpretation and argues that the term “virtual private network communication link” 1) must be “a communication path between computers in a virtual private network” (PO Resp. 6), 2) “requir[es] computers within a VPN to communicate directly” (PO Resp. 9), and 3) requires a “network of computers,” which, according to Patent Owner must be “more than a ‘path between two devices.’” PO Resp. 14.

We decline to modify our previous construction of this term in the manner suggested by Patent Owner because such a modification is immaterial in this proceeding for reasons set forth below. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (claim terms need only be construed to the extent necessary to resolve the case).

² Our construction is consistent with the broadest, reasonable construction in *Inter Partes Reexamination Control No. 95/001,792*. *See Cisco Systems, Inc. v. VirnetX, Inc.*, Appeal 2014-000491, slip. op. at 4–8 (PTAB Apr. 1, 2014) (Decision on Appeal) (involving grandparent patent to the ’274 patent, U.S. Patent No. 7,188,180).

Secure Domain (Name) Service

Patent Owner argues that one of skill in the art would have understood the term “secure domain (name) service,” in light of the Specification, to require “recogniz[ing] that a query message is requesting a secure computer address.” PO Resp. 16. Petitioner proposes that a secure domain (name) service (SDNS) should be construed as “[a] service that can resolve secure computer network addresses for a secure domain name for which a conventional domain name service [(“DNS”)] cannot resolve addresses.” See Pet. 13; PO Resp. 15 (discussing Petitioner’s proposed construction).

Claim 1, for example, recites sending a query message to “a secure domain service” requesting a secure network address and receiving “a response message from the secure domain name service containing the secure network address.” Claim 1 does not recite “recogniz[ing] that the query message is requesting a secure computer address.” “[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms” and “the context in which a term is used in the asserted claim can be highly instructive.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). At least based on the context of the claim, we cannot agree with Patent Owner that one of ordinary skill in the art would have understood that “recogniz[ing]” is required by claim 1 in the absence of a recitation of this alleged requirement.

Based on the context of the claim, the Specification, and the prosecution history, claim 1 does not require “recogniz[ing]” as argued by Patent Owner. The Specification describes an “SDNS 313” that “contains a cross-reference database of secure domain names and corresponding secure network addresses. That is, for each secure domain name, SDNS 313

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