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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VIRNETX INC.
Patent Owner

Case IPR2014-00237
Patent 8,504,697

**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. For example, the Petition proposes rejections based on U.S. Patent No. 6,496,867 to *Beser* and RFC 2543 by *Handley et al.* (*See* Pet. at i-iii.) During prosecution of the '697 patent, however, VirnetX submitted these references through an Information Disclosure Statement and the Examiner considered them. (*See* Ex. 1001 at 2, 5.) The Examiner also considered materials from reexaminations of patents related to the '697 patent, including claim charts for *Beser* and RFC 2543 against the claims of those patents. (*See id.* at 9, 11, 14-16.) Accordingly, Apple asks the Board and VirnetX to divert resources to revisit issues that the Office has already considered.

Second, the Petition fails to comply with several rules and regulations regarding the content of petitions. The Petition either never or rarely cites the asserted prior art references, violating the particularity requirements of 35 U.S.C.

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