

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Larson et al.
Application Serial No.: 11/679,416
Filing Date: February 27, 2007
Title: METHOD FOR ESTABLISHING SECURE COMMUNICATION
LINK BETWEEN COMPUTERS OF VIRTUAL PRIVATE
NETWORK
Examiner: Lim, Krisna
Art Unit: 2453
Confirmation No.: 33528
Atty. Docket No.: 077580-0015 (VRNK-1CP2DVCON)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE AND REQUEST FOR RECONSIDERATION

The Applicants responds to the non-final Office Action mailed December 7, 2010 (“the Office Action”) as follows:

Remarks, beginning on page 2 of this paper.

Remarks

Applicants appreciate the Examiner's examination of the subject application. Claims 2-30 are currently pending. No claims have been amended or cancelled.

In the Office Action, the Examiner has rejected Claims 2-30 under 35 U.S.C. § 102(b), as being anticipated by Aventail Connect v 3.1/v2.6 Administrator's Guide ("Aventail").

Applicants respectfully traverse the outstanding rejection and requests reconsideration of the subject application in light of the following remarks.

Patentability under 35 U.S.C. § 102

The Examiner has rejected Claims 2-30 under 35 U.S.C. § 102(b), as being anticipated by Aventail. These rejections are respectfully traversed, and reconsideration and withdrawal of these rejections are respectfully requested.

Independent claim 2 recites the following:

A method of using a first device to communicate with a second device having a secure name, the method comprising:

from the first device, sending a message to a secure name service, the message requesting a network address associated with the secure name of the second device;

at the first device, receiving a message containing the network address associated with the secure name of the second device; and

from the first device, sending a message to the network address associated with the secure name of the second device using a secure communication link.

(emphasis added).

As a preliminary matter, Aventail has not been shown to be prior art to all pending claims in the present application, including claim 2. In fact, Aventail is not prior art. The present application claims priority to U.S. Patent Nos. 6,502,135 (hereinafter "the '135 patent") and 7,188,180 (hereinafter "the '180 patent"). The '135 and '180 Patents were subject to inter partes reexamination proceedings, Control Nos. 95/001,269 (hereinafter "the '269 Reexam") and

95/001,270 (hereinafter “the ‘270 Reexam”), respectively (collectively “Reexams”). In both Reexams, the USPTO determined that “Aventail cannot be relied upon as prior art to the [patents].” *See* Reexamination Control No. 95/001,269, Action Closing Prosecution, June 16, 2010, p. 3 (Exhibit A); Reexamination Control No. 95/001,270, Action Closing Prosecution, June 16, 2010, p. 3 (Exhibit B). This sound determination was based on the fact that no evidence was found to establish Aventail’s publication date.

Indeed, Aventail’s identification of a copyright date range of 1996 – 1999 is not equivalent to a publication date. The distinction between a publication date and a copyright date is critical. To establish a date of publication, the reference must be shown to have “been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *In re Wyre*, 655 F.2d 221 (C.C.P.A. 1981). Aventail, on its face, provides “© 1996-1999 Aventail Corporation.” The copyright date does not meet this standard. Unlike a publication date, a copyright date merely establishes “the date that the document was created or printed.” *Hilgraeve, Inc. v. Symantec Corp.*, 271 F. Supp. 2d 964, 975 (E.D. Mich. 2003).

Even presuming the author of the document accurately represented the date the document was created, a creation date alone is not evidence of any sort of publication or dissemination. Without more, this bald assertion of the creation of the document does not meet the “publication” standard required for a document to be relied upon as prior art.

Further exacerbating matters is the filing date of the ‘135 Patent: February 15, 2000. Suppose the relied upon sections of the Aventail reference were created on December 31, 1999, and the copyright date range were accordingly amended to read “1996-1999.” Under these circumstances, it is possible that the document, although created, was not made publicly

available until after the filing date of the '135 Patent, six weeks after creation. And, under these circumstances, Aventail clearly would not be eligible to be relied upon as prior art to the '135 Patent.

As an aside, the Applicant notes that the present assignee (VirnetX Inc.) and its prosecution counsel have been accused of inequitable conduct during the '269 Reexam in a litigation proceeding, *VirnetX Inc. v. Cisco Systems, Inc., et al.*, United States District Court for the Eastern District of Texas, Tyler Division, Case No. 6:10-cv-417. Exhibits C-E. In its Original Answer, Affirmative Defenses, and Counterclaims to the Virnetx's Original Complaint, the Defendant Apple Inc. ("Apple") alleges that evidence of Aventail's publication as early as June 1999 was presented in a different trial involving Microsoft Corporation. Exhibit C at ¶ 23 (p. 14). Apple further alleges that "VirnetX was aware that the Aventail reference may have been published at least as early as June 1999." Exhibit C at ¶ 23. Defendants Aastra Technologies Limited and Aastra USA Inc. ("Aastra") have made similar allegations in their responsive pleadings. Exhibit D at ¶ 86 (p. 19); Exhibit E at ¶ 86 (p. 19).

To the contrary, the applicants are unaware of evidence establishing Aventail's publication date, and specifically are unaware of the June 1999 publication date alleged by Apple and Aastra in their pleadings. The trial transcript from the Microsoft trial does not discuss anything about a publication date for the Aventail reference. Exhibit F. While the trial transcript references the Aventail product, it does not mention anything about a publication date. *See e.g.* Exhibit F-2, pp. 112, 146; Exhibit F-3, pp. 115, 119-20; Exhibit F-10 pp. 21-40; Exhibit F-11, pp. 21-32, 120-150. The deposition of Gary Tomlinson (former employee of Aventail) taken during discovery prior to the Microsoft trial is inconclusive, at best. Exhibit H at pp. 33-36. Thus, although an allegation of knowledge has been made by a third party, the applicants, the

assignee and applicants' prosecution counsel have not had and do not have such knowledge. To be sure, the Applicants will notify the USPTO immediately if it becomes aware of evidence of Aventail's publication date.

Assuming *arguendo*, that Aventail is prior art to the present application, it is not understood to disclose the features of claim 2, particularly with respect to at least the features of "a secure communication link," "a secure name service," and a "secure name."

Aventail's disclosure was summarized in the Declaration of Professor Jason Nieh in support of the '270 Reexam. Reexamination Control No. 95/001,270, *Declaration of Jason Nieh, Ph.D., Pursuant to 37 C.F.R. § 1.132*, April 19, 2010, ¶¶ 14 – 29 (Exhibit G) (hereinafter "Nieh Decl."). The Nieh Decl. is cited herein to characterize the cited references and their deficiencies.

Aventail discloses a system and architecture for transmitting data between two computers using the SOCKS protocol. Nieh Decl. at ¶ 14. The system routes certain, predefined network traffic from a WinSock (Windows sockets) application to an extranet (SOCKS) server, possibly through successive servers. Aventail at 7; Nieh Decl. at ¶ 14. Upon receipt of the network traffic, the SOCKS server then transmits the network traffic to the Internet or external network. Aventail at 7; Nieh Decl. at ¶ 14. Aventail's disclosure is limited to connections created at the socket layer of the network architecture. Nieh Decl. at ¶ 14.

In operation, a component of the Aventail Connect software described in the reference resides between WinSock and the underlying TCP/IP stack. *See* Aventail at 9; Nieh Decl. at ¶ 15. The Aventail Connect software intercepts all connection requests from the user, and determines whether each request matches local, preset criteria for redirection to a SOCKS server. *See* Aventail at 10; Nieh Decl. at ¶ 15. If redirection is appropriate, then Aventail Connect

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