

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Inter Partes* Reexamination of:)
)
Victor LARSON et al.) Control No.: 95/001,792
)
U. S. Patent No. 7,188,180) Group Art Unit: 3992
)
Issued: March 6, 2007) Examiner: Deandra M. Hughes
)
For: METHOD FOR ESTABLISHING) Confirmation No. 1972
SECURE COMMUNICATION LINK)
BETWEEN COMPUTERS OF)
VIRTUAL PRIVATE NETWORK)

Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PATENT OWNER'S COMMENTS IN RESPONSE TO
EXAMINER'S DETERMINATION PURSUANT TO 37 C.F.R. § 41.77(e)**

VirnetX Inc., the owner of U.S. Patent No. 7,188,180 (“the ’180 patent”), submits these Comments in Response to the Examiner’s Determination of February 11, 2015 (“Determination”) in the above-identified reexamination proceeding. On April 1, 2014, the Board decided an appeal in this proceeding (“Decision”) and reversed the Examiner’s confirmation of claims 1, 4, 6, 7, 9-15, 17, 20, 22, 23, 25-31, 33, 35, 37, 38, 40, and 41. (Decision at 3.) The Board issued the following “new grounds of rejection for these claims pursuant to 37 C.F.R. § 41.77(b)”:

Rejection of claims 1, 4, 6, 9-10, 12-15, 17, 20, 22, 25-26, 28-31, 33, 35, 37, and 40 under 35 U.S.C. § 102 based on *Kiuchi* (*id.* at 9, 23);

Rejection of claims 1, 4, 6, 9-15, 17, 20, 22, 25-31, 33, 35, 37, 40, and 41 under 35 U.S.C. § 103(a) based on *Kiuchi* (*id.* at 11, 23); and

Rejection of claims 7, 23, and 38 under 35 U.S.C. § 103(a) based on *Kiuchi* in view of *Martin* (*id.* at 17, 23).

The Board also affirmed the Examiner's decision confirming claims 8, 24, and 39. (*Id.* at 3.)

Pursuant to Rule 41.77(b)(1), Patent Owner filed a response requesting to reopen prosecution on June 2, 2014 ("Request to Reopen"), along with new evidence relevant to the Board's new grounds of rejection. Third Party Requester Cisco Systems, Inc. ("Cisco" or "Requester") filed its responsive comments on June 27, 2014. In an Order remanding the reexamination to the Examiner ("Remand Order") on November 11, 2014, the Board granted the Patent Owner's Request to Reopen, determined that Patent Owner's "new evidence relates to the claims so rejected," and entered Patent Owner's new evidence "for the Examiner's consideration." (Remand Order at 3.) On February 11, 2015, the Examiner issued a Determination under 37 C.F.R. § 41.77(d), that Patent Owner has "not overcome the new grounds of rejection by the Board." (Determination at 8.) In response to the Determination, Patent Owner is filing these timely comments pursuant to 37 C.F.R. § 41.77(e).

VirnetX does not believe any fee is due in connection with the filing of these Comments. If any fee is due, however, please charge the fee to Deposit Account 50-2613.

I. Background

As Patent Owner explained in its Request to Reopen, the Board entered new grounds of rejection in its Decision because it, among other things, advanced new constructions for the phrases "virtual private network communication link" and "client computer," newly construed a "version number" in *Kiuchi*, and advanced new obviousness grounds based on *Kiuchi* and *Kuichi* in view of *Martin*. (*See generally*, Request to Reopen; Decision.) Patent Owner traversed the Board's rejections by offering two supplemental declarations, sixteen new exhibits, and 29 pages of explanation in its Request to Reopen. Finding Patent Owner's Request to Reopen compliant

with the rules and further finding its submitted evidence to be relevant to the newly rejected claims, the Board remanded the proceeding to the Examiner for further consideration of both, stating the following:

In its response, Owner submitted additional evidence in the form of a Declaration from Fabian Monrose, Ph.D, a Supplemental Declaration of inventor Robert Dunham Short III, Ph.D, and Exhibits A-9 and A-34 through A-38 listed in Appendix. . . . [T]he new evidence is entered for the Examiner’s consideration.

The proceeding will be remanded to the Examiner for consideration of Owner’s Response and Requester’s Comments in connection with claims 1, 4, 6, 7, 9-15, 17, 20, 22, 23, 25-31, 33, 35, 37, 38, 40, and 41. As set forth in 37 C.F.R. § 41.77(d), **after due consideration of those submissions**, the Examiner is to issue a determination as to whether the Board’s new grounds of rejection as designated in the Decision have been overcome.

(Remand Order at 3, emphasis added.)

The Determination, however, fails to give “due consideration” to Patent Owner’s submissions. As explained below, the Determination considers only seven of the twenty-nine pages in Patent Owner’s Request to Reopen, only a portion of one of the two submitted declarations, and only six of Patent Owner’s sixteen entered exhibits—two of which the Examiner accords little weight. (Determination at 5-8.)

II. **Argument**

The Determination is in violation of 37 C.F.R. § 41.77(d) at least because it fails to give due consideration to all of Patent Owner’s submissions in response to the Board’s new grounds of rejection.¹ Where the Determination does address certain exhibits and one claim construction issue, it only provides general statements such as “the Patent Owner does not overcome the new grounds of rejection by the Board.” (*See e.g.*, Determination at 8.) Accordingly, contrary to the

¹ While arguments relative to rejections not designated as new grounds of rejection need not be considered (37 C.F.R. § 41.77(b)), all of Patent Owner’s traversals in its Request to Reopen properly address only those grounds of rejection identified as new by the Board in its Decision.

Office's standard procedures and practice, any analysis underlying the grounds of rejection is not clearly developed nor presented, making it difficult for Patent Owner to provide any response to why the claims-at-issue are rejected.

Given the Determination's scant analysis and failure to consider all of Patent Owner's submissions, the Determination should be found deficient under 37 C.F.R. § 41.77(d) and vacated and the Examiner should be required to review and give appropriate consideration to all the arguments and evidence submitted by Patent Owner.² Alternatively, the Office should find that for at least the reasons outlined in Patent Owner's Request to Reopen, claims 1, 4, 6, 7, 9-15, 17, 20, 22, 23, 25-31, 33, 35, 37, 38, 40, and 41 are patentable.

A. The Determination Fails to Address All of Patent Owner's Submissions

37 C.F.R. § 41.77(d) states that "[t]he examiner will consider any owner response under paragraph (b)(1)" of Section 41.77. Despite a finding by the Board that Patent Owner's Request to Reopen and accompanying evidence are compliant with the rules and relevant to the Board's new grounds of rejection, the Examiner failed to consider all of the positions raised in the Request and many of the exhibits. In particular, the Examiner did not address the following positions:

- The Board's claim construction of "client computer" is unreasonably broad (Request to Reopen at 11-13);
- The "request for connection" is not sent using a "virtual private network communication link," even under the Board's construction of that term (*id.* at 13-14);
- The Board's consideration of the "step (6) message" rearranges the features of *Kiuchi* relied upon for claims 1, 17, and 33 (*id.* at 14-15);
- The "step (6) message" is not an "access request message" (*id.* at 15-17);

² To the extent necessary, Patent Owner hereby requests that this paper be considered as a petition requesting that the Examiner review and give appropriate consideration to all the arguments and evidence submitted by Patent Owner.

- If the “step (6) message” is relied upon, *Kiuchi* does not disclose the step of “sending a query message” (*id.* at 17-18);
- *Kiuchi*’s “version number” does not represent a “predetermined level of service” as required by claims 6, 22, and 37 (*id.* at 18-19);
- *Kiuchi*’s “step (6) message” and “step (3) message”) do not contain a “request for information stored at the secure computer network address” as required by claims 12 and 28 (*id.* at 19-20);
- *Kiuchi*’s client-side proxy is not a “client computer” under a proper construction of the term (*id.* at 20-21);
- *Kiuchi* would not render obvious claims 1, 4, 6, 9-15, 17, 20, 22, 25-31, 33, 35, 37, 40, and 41 (*id.* at 22-23);
- *Kiuchi* in view of *Martin* would not render obvious claims 7, 23, and 38 (*id.* at 23-24);
- Objective evidence demonstrates nonobviousness (*id.* at 24-29).

The Determination also failed to address in any way Exhibits A-39 through A-48. (*See generally*, Determination.) The Rules require an examiner to review a patent owner’s response with respect to new grounds of rejection. (*See* Decision on Appeal in Reexamination Control No. 95/001,169 at 6-7) But here, each of the issues discussed by Patent Owner addresses what the Board expressly refers to as “new grounds of rejection . . . pursuant to 37 C.F.R. § 41.77(d).” (Decision at 3.) Indeed, the Board reversed the Examiner’s confirmation that claims 1, 4, 6, 7, 9-15, 17, 20, 22, 23, 25-31, 33, 35, 37, 38, 40, and 41 were patentable over the prior art. (*Id.*) Thus, it is error for the Examiner to refuse to consider the entirety of Patent Owner’s Request to Reopen and Exhibits A-39 through A-48. Because the Examiner’s Determination is in violation of Rule 41.77(d), it should be vacated and the Examiner should be required to review and give appropriate consideration to all the arguments and evidence submitted by Patent Owner.

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