

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE MANGROVE PARTNERS MASTER FUND, LTD., APPLE INC., and
BLACK SWAMP IP, LLC,
Petitioners,

v.

VIRNETX INC.,
Patent Owner.

Case No. IPR2015-01047¹
U.S. Patent No. 7,490,151

PETITIONERS' REMAND BRIEF

¹ Apple Inc. and Black Swamp IP, LLC, which filed petitions in IPR2016-00063 and IPR2016-00167, respectively, have been joined as Petitioners in the instant proceeding.

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I. Introduction

In its Final Written Decision (Paper 80, “Final Decision”), the Board correctly concluded that claims 1, 2, 6-8, and 12-14 of the ’151 patent (“challenged claims”) are unpatentable. Patent Owner VirnetX Inc. (“VirnetX”) appealed, and on July 8, 2019, the U.S. Court of Appeals for the Federal Circuit vacated the Final Decision and remanded for further consideration of certain issues. *VirnetX Inc. v. Mangrove Partners Master Fund, Ltd.*, 778 F. App’x 897 (Fed. Cir. 2019) (“CAFC Dec.”). None of those remanded issues warrants the Board reaching a different determination.

First, Kiuchi anticipates the challenged claims because Kiuchi’s client-side proxy, acting in concert with the C-HTTP name server, is a “DNS proxy module” that “*determin[es] whether the intercepted DNS request corresponds to a secure server.*” VirnetX no longer disputes that the client-side proxy performs the other claimed actions. It also is undisputed that the client-side proxy takes different actions in response to different messages it receives from the C-HTTP name server based on “*whether the intercepted DNS request corresponds to a secure server.*” Thus, to conclude that Kiuchi anticipates the challenged claims, the Board need only find that the client-side proxy, by requesting, receiving, and evaluating messages from the C-HTTP name server and then acting accordingly, performs the claimed “*determining*” step.

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