

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

BLACK SWAMP IP, LLC  
Petitioner

v.

VIRNETX INC.  
Patent Owner

---

Case IPR2016-00957  
Patent Number: 7,921,211

---

**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE**

**TABLE OF CONTENTS**

I. INTRODUCTION..... 1

II. NO REQUIREMENT FOR EXPERT TESTIMONY..... 1

III. CLAIM CONSTRUCTION FROM THE PETITION SHOULD BE ADOPTED.....5

    A. “Domain Name Service System.” .....5

    B. “Secure Communications Link.” .....7

    C. “Indicate”/“Indicating.” ..... 12

IV. THE ANTICIPATION REJECTION UNDER 35 U.S.C. § 102(B) BASED ON KIUCHI. .... 16

    A. Kiuchi Clearly Discloses the “Indication” Recitations of Independent Claims 1, 36, and 60. .... 16

    B. Kiuchi Clearly Discloses the “Plurality of Domain Names and Corresponding Network Addresses” Recitations of Independent Claims 1, 36, and 60. .... 19

    C. Kiuchi Clearly Discloses the “Supports Establishing a Secure Communication Link” Recitations of Independent Claims 1, 36, and 60. .... 21

    D. Kiuchi Clearly Discloses the “Machine-Readable Medium Comprising Instructions Executable in a Domain Name Service System” Recitations of Independent Claim 36. .... 23

    E. Dependent Claims 15 and 39. .... 23

    F. Dependent Claims 16 and 40. .... 25

    G. Dependent Claims 27 and 51. .... 26

V. CONCLUSION..... 27

**TABLE OF AUTHORITIES**

**Statutes**

35 U.S.C. § 102(b) .....1

**Federal Circuit Cases**

*Belden Inc. v. Ber-Tek LLC*, 805 F.3d 1064 (Fed. Cir. 2015) .....2  
*Brand v. Miller*, 487 F.3d 862, 869-71 (Fed. Cir. 2007) .....2, 3  
*SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1122 (Fed. Cir. 1985).....9  
*VirnetX Inc. v. Apple Inc.*, Fed. Cir. Appeal No. 2015-1934, 2015-1935 .....3, 4  
*Wyers v. Master Lock Co.*, 616 F.3d 1231, 1242 (Fed. Cir. 2010).....2

**Board Cases**

IPR2014-00615 ..... 7, 8, 9, 10, 15

**Other**

Webster’s Third New International Dictionary (1971) ..... 15, 16, 18

## EXHIBITS

- Exhibit 1001 U.S. Patent No. 7,921,211.
- Exhibit 1002 Institution Decision dated October 15, 2014 in IPR2014-00615, IPR2014-00616, and IPR2014-00618 requested by Microsoft Corp. (“Microsoft Institution Decision”).
- Exhibit 1003 Right of Appeal Notice in *Inter Partes* Reexam. 95/001,788.
- Exhibit 1004 Right of Appeal Notice in *Inter Partes* Reexam. 95/001,851.
- Exhibit 1005 Takahiro Kiuchi and Shigekoto Kaihara, “C-HTTP – The Development of a Secure, Closed HTTP-based Network on the Internet,” published by IEEE in the Proceedings of SNDSS 1996 (“Kiuchi”).
- Exhibit 1006 Patent Owner’s Preliminary Response in IPR2013-00397.
- Exhibit 1007 Patent Owner’s Preliminary Response in IPR2013-00398.
- Exhibit 1008 Selected Portions of Webster’s Third New International Dictionary (1971).
- Exhibit 1009 Right of Appeal Notice in *Inter Partes* Reexam. 95/001,789.
- Exhibit 1010 Right of Appeal Notice in *Inter Partes* Reexam. 95/001,856.

...

## **I. INTRODUCTION.**

The present proceeding involves claims 1, 2, 5, 6, 15, 16, 23, 27, 36, 37, 39, 40, 47, 51, and 60 (including independent claims 1, 36, and 60) of U.S. Patent No. 7,921,211 (“211 patent”). The present proceeding was instituted by the Board in an Institution Decision dated September 9, 2016 (“Institution Decision”) in accordance with a Petition for *Inter Partes* Review of U.S. Patent No. 7,921,211 filed April 27, 2016 (“Petition”).

Petitioner submits the following in response to the Patent Owner’s Response dated November 28, 2016 (“Patent Owner’s Response”). As discussed below, (1) the Patent Owner’s stated requirement for expert testimony is unfounded; (2) Petitioner’s claim construction from the Petition should be adopted; and (3) the Board should maintain the anticipation rejection under 35 U.S.C. § 102(b) based on Kiuchi (Ex. 1005).

## **II. NO REQUIREMENT FOR EXPERT TESTIMONY.**

Petitioner submits that the Patent Owner’s position regarding the absolute need for expert testimony to bolster Petitioner’s anticipation position is unfounded. The Patent Owner posits that the absence of expert testimony is somehow

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.