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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
95/001,851 12/13/2011 7418504 43614.101 1688

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EXAMINER

FOSTER, ROLAND G

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

02/26/2015

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

EXHIBIT 1004

Black Swamp IP, LLC v. VirnetX, Inc.
IPR of U.S. Patent No. 7,921,211

Transmittal of Communication to Third Party Requester <i>Inter Partes</i> Reexamination	Control No.	Patent Under Reexamination	
	95/001,851	7418504	
	Examiner	Art Unit	
	ROLAND FOSTER	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David L. McCombs
HAYNES AND BOONE, LLP, IP SECTION
2323 Victory Ave., Suite 700
Dallas, TX 75219

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Right of Appeal Notice (37 CFR 1.953)	Control No.	Patent Under Reexamination
	95/001,851	7418504
	Examiner	Art Unit
	ROLAND FOSTER	3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:
 Patent Owner on 30 July, 2014
 Third Party(ies) on 29 August, 2014

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed _____ will be entered will not be entered*

*Reasons for non-entry are given in the body of this notice.

- 1a. Claims 1-35 and 60 are subject to reexamination.
- 1b. Claims 36-59 are not subject to reexamination.
2. Claims _____ have been cancelled.
3. Claims _____ are confirmed. [Unamended patent claims].
4. Claims 11 are patentable. [Amended or new claims].
5. Claims 1-10, 12-35 and 60 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable. are not acceptable.
8. The drawing correction request filed on _____ is approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
 been received. not been received. been filed in Application/Control No. _____.
10. Other _____

Attachments

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

RIGHT OF APPEAL NOTICE

1. Procedural History

Prosecution after the ACP

This Office action addresses claims 1-35 and 60 of United States Patent No. 7,418,504 B2 (the "Larson" patent), for which reexamination was granted in the Order Granting *Inter Partes* Reexamination (hereafter the "Order"), mailed March 1, 2012, in response to a Request for Inter Partes Reexamination, filed December 13, 2011 (the "Request").

An Action Closing Prosecution ("ACP") mailed May 30, 2014 rejecting original claims 1-10 and 12-16 of the Larson patent. Original claim 11 was found patentable. The patent owner also filed a supplemental declaration of Angelos D. Keromytis, Ph.D., on January 2, 2013 (the "Supplemental Keromytis Declaration"), which is entered into the record and considered in the ACP in accordance with the Petition Decision mailed December 12, 2013.

The patent owner responded by filing arguments and associated evidence on July 30, 2014 (the "Response").

The third party requester responded by filing Comments on the Patent Owner's Response on August 29, 2014 (the "Comments").

Prosecution of Claims 36-59 Is Terminated.

In the decision mailed September 17, 2014, the Office determined that the estoppel provisions of pre-AIA 35 U.S.C. 317(b) apply to any rejection of claims 36-59 in this proceeding. Accordingly, the estoppel provisions of pre-AIA 35 U.S.C. 317(b) apply to all rejections of claims 36-59 of the Larson patent which were applied in the May 30, 2014 Action

Art Unit: 3992

Closing Prosecution. Pursuant to the September 17, 2014 decision, these rejections will not be further maintained by the Office, and have been withdrawn. No further rejection of claims 36-59 of the Larson patent will be made in the present reexamination proceeding.

Because all rejections of claims 36-59 of the Larson patent have been withdrawn pursuant to the estoppel provisions of pre-AIA 35 U.S.C. 317(b), the withdrawal of these rejections is not a “non-adoption of” or a “determination not to make” these rejections within the meaning of 37 CFR 41.61. Any notice of appeal or cross-appeal of the present determination not to make or maintain a rejection of claims 36-59 of the Larson patent will be held to be defective.

Prosecution of the Remaining Claims 1-35 and 60 Will Continue.

The Larson patent under reexamination (the '504 patent) was the subject of a Federal Circuit decision holding the claims were not proved invalid. *See Virnetx, Inc. v. Cisco Systems, Inc.*, 767 F.3d 1308 (Fed. Circ. 2014). The parties in that litigation are parties to this proceeding. However, the VirnetX decision remanded the case back to the district court for further proceedings on other grounds. The patent owner has not provided any evidence that this decision is a final decision that the subject claims are not invalid. MPEP § 2686.04.IV.

Prosecution of the remaining claims 1-35 and 60 will continue.

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