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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

FOSTER, ROLAND G

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

01/09/2015 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 1010

Black Swamp IP, LLC v. VirnetX, Inc.

<b>Transmittal of Communication to Third Party Requester Inter Partes Reexamination</b>	Control No.	Patent Under Reexamination	
	95/001,856	7921211	
	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)──────────┐

HAYNES AND BOONE, LLP  
 IP SECTION  
 2323 VICTORY AVENUE, 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
95/001,856	7921211
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 36-50 are subject to reexamination.
- 1b.  Claims 1-35 are not subject to reexamination.
2.  Claims \_\_\_\_ have been cancelled.
3.  Claims \_\_\_\_ are confirmed. [Unamended patent claims].
4.  Claims \_\_\_\_ are patentable. [Amended or new claims].
5.  Claims 36-50 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 36-60 of United States Patent No. 7,921,211 B2 (the "Larson" patent), for which reexamination was granted in the Order Granting *Inter Partes* Reexamination (hereafter the "Order"), mailed March 5, 2012, in response to a Request for Inter Partes Reexamination, filed December 16, 2011 (the "Request").

An Action Closing Prosecution ("ACP") mailed May 30, 2014, rejected original claims 1-10 and 12-16 of the Larson patent. Original claim 11 was found patentable. New claims 17-60 were rejected. 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 1-35 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 1-35 in this proceeding. Accordingly, the estoppel provisions of pre-AIA 35 U.S.C. 317(b) apply to all rejections of

Art Unit: 3992

claims 1-35 of the Larson patent which were applied in the May 30, 2014 Action 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 1-35 of the Larson patent will be made in the present reexamination proceeding.

Because all rejections of claims 1-35 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 1-35 of the Larson patent will be held to be defective.

***Prosecution of the Remaining Claims 36-60 Will Continue.***

The Larson patent under reexamination (the '211 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 36-60 will continue.

***Submissions of Evidence after the Action Closing Prosecution***

The patent owner also filed a declaration of Fabian Monrose, Ph.D., on July 30, 2014 (the "Monrose Declaration"). The Patent Owner asserts the ACP "advances new grounds of rejection

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