

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Larson et al.
Application Serial No.: 11/839,987
Filing Date: August 16, 2007
Title: METHOD FOR ESTABLISHING SECURE COMMUNICATION
LINK BETWEEN COMPUTERS OF VIRTUAL PRIVATE
NETWORK
Examiner: Lim, Krisna
Art Unit: 2453
Confirmation No.: 9470
Atty. Docket No.: 077580-0066 (VRNK-1CP2DVCN2)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

In response to the non-final Office Action mailed July 8, 2010 ("the Office Action"), please amend the above-identified application as follows:

Remarks, beginning on page 2 of this paper.

Remarks

Applicant appreciates the Examiner's examination of the subject application. Claims 1-18 are currently pending.

In the Office Action, the Examiner has rejected Claims 1-18 under 35 U.S.C. § 103(a), as being unpatentable over VPN Overview and Aventail Connect v 3.1/v2.6 Administrator's Guide ("Aventail"). The Examiner rejected claims 1-18 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-23 of co-pending Application No. 11/679,416.

Applicant respectfully traverses the outstanding objection and rejections and requests reconsideration of the subject application in light of the foregoing amendments and the following remarks.

Patentability under 35 U.S.C. § 103

The Examiner has rejected Claims 1-18 under 35 U.S.C. § 103(a), as being unpatentable over VPN Overview and Aventail. These rejections are respectfully traversed, and reconsideration and withdrawal of these rejections are respectfully requested.

Independent claim 1 recites the following:

A method of accessing a secure network address, comprising:

 sending a query message from a first network device to **a secure domain service**, the query message requesting from the secure domain service **a secure network address** for a second network device;

 receiving at the first network device a response message from the secure domain name service containing the secure network address for the second network device; and

 sending an access request message from the first network device to the secure network address using a **virtual private network communication link**.

(emphasis added).

As a preliminary matter, neither Aventail nor VPN Overview have been shown to be prior art to all claims in the present application, including claim 1. Aventail is not prior art because the present application claims priority to U.S. Patent Nos. 6,502,135 (hereinafter “the ‘135 patent”) and 7,188,180 (hereinafter “the ‘180 patent”). The ‘135 and ‘180 Patents have been subject to an inter partes reexamination proceedings, Control Nos. 95/001,269 (hereinafter “the ‘269 Reexam”) and 95/001,270 (hereinafter “the ‘270 Reexam”), respectively. In both Reexams, the USPTO determined that “Aventail cannot be relied upon as prior art to the [patents].” See Reexamination Control No. 95/001,269, Action Closing Prosecution, June 16, 2010, attached as Exhibit A, and Reexamination Control No. 95/001,270, Action Closing Prosecution, June 16, 2010, attached as Exhibit B. This determination was soundly based on the fact that no evidence was found that established Aventail’s publication date.

Indeed, Aventail’s identification of a copyright date range of 1996 – 1999 is not equivalent to a publication date. The distinction between a publication date and a copyright date is critical. To establish a date of publication, the reference must be shown to have “been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *In re Wyre*, 655 F.2d 221 (C.C.P.A. 1981). Aventail, on its face, provides “© 1996-1999 Aventail Corporation.” The copyright date does not meet this standard. Unlike a publication date, a copyright date merely establishes “the date that the document was created or printed.” *Hilgraeve, Inc. v. Symantec Corp.*, 271 F. Supp. 2d 964, 975 (E.D. Mich. 2003).

Presuming the author of the document accurately represented the date the document was created, this creation date is not evidence of any sort of publication or dissemination. Without

more, this bald assertion of the creation of the document does not meet the “publication” standard required for a document to be relied upon as prior art.

Further exacerbating matters is the filing date of the ‘135 Patent: February 15, 2000. Suppose the relied upon sections of the Aventail reference were created on December 31, 1999, and the copyright date range were accordingly amended to read “1996-1999.” Under these circumstances, it is possible that the document, although created, was not made publicly available until after the filing date of the ‘135 Patent, six weeks after creation. Under these circumstances, Aventail clearly would not be eligible to be relied upon as prior art to the ‘135 Patent.

As an aside, the Applicant notes that the present assignee (VirnetX Inc.) and its prosecution counsel have been accused of inequitable conduct during the ‘269 Reexam in a litigation proceeding, *VirnetX Inc. v. Cisco Systems, Inc., et al.*, United States District Court for the Eastern District of Texas, Tyler Division, Case No. 6:10-cv-417. Exhibits C-E. In its Original Answer, Affirmative Defenses, and Counterclaims to the Virnetx’s Original Complaint, the Defendant Apple Inc. (“Apple”) alleges that evidence of Aventail’s publication as early as June 1999 was presented in a different trial involving Microsoft Corporation. Exhibit C at ¶ 23 (p. 14). Apple further alleges that “VirnetX was aware that the Aventail reference may have been published at least as early as June 1999.” Exhibit C at ¶ 23. Defendants Aastra Technologies Limited and Aastra USA Inc. (“Aastra”) have made similar allegations in their responsive pleadings. Exhibit D at ¶ 86 (p. 19); Exhibit E at ¶ 86 (p. 19). To the contrary, the applicants are unaware of evidence establishing Aventail’s publication date, and specifically are unaware of the June 1999 publication date alleged by Apple and Aastra in their pleadings. The trial transcript from the Microsoft trial does not discuss anything about a publication date for the

Aventail reference. Exhibit F. While the trial transcript references the Aventail product, it does not mention anything about a publication date. *See e.g.* Exhibit F-2, pp. 112, 146; Exhibit F-3, pp. 115, 119-20; Exhibit F-10 pp. 21-40; Exhibit F-11, pp. 21-32, 120-150. The deposition of Gary Tomlinson (former employee of Aventail) taken during discovery prior to the Microsoft trial is inconclusive, at best. Exhibit H at pp. 33-36. Thus, although an allegation of knowledge has been made by a third party, the applicants, the assignee and applicants' prosecution counsel have not had and do not have such knowledge. To be sure, the applicants will notify the USPTO immediately if it becomes aware of evidence of Aventail's publication date.

VPN Overview has also not been shown to be prior art. On its face, VPN Overview only provides that it was copyrighted in 1998. VPN Overview at 2. Further, the reference identifies itself as being nothing more than a draft. VPN Overview at 1 (Stating the following: "White Paper – DRAFT"). The lack of a publication date in conjunction with the document's status as a draft fail to evidence that VPN Overview is prior art to the present application.

Assuming *arguendo*, that both of these references are prior art to the present application, neither VPN Overview nor Aventail, alone or in combination, are understood to disclose or suggest the features of claim 1, particularly with respect to at least the features of "a virtual private network communication link," "a secure domain name service" and a "secure computer network address."

Aventail's and VPN Overview's disclosures were summarized in the Declaration of Professor Jason Nieh in support of the '270 Reexam. Reexamination Control No. 95/001,270, *Declaration of Jason Nieh, Ph.D., Pursuant to 37 C.F.R. § 1.132*, April 19, 2010, attached as Exhibit G (hereinafter "Nieh Decl."). The Nieh Decl. is cited herein to characterize the cited references and their deficiencies.

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