

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VIRNETX INC.,
Patent Owner.

Case IPR2015-01010
Patent 8,843,643 B2

Before KARL D. EASTHOM, ROBERT J. WEINSCHENK, and
BETH Z. SHAW, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–9, 12–24, and 27–32 of U.S. Patent No. 8,843,643 B2 (Ex. 1001, “the ’643 patent”). VirnetX Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. On October 29, 2015, we instituted an *inter partes* review of claims 1–9, 12–24, and 27–32 (“the challenged claims”) of the ’643 patent on the following grounds:

Claim(s)	Statutory Basis	Applied Reference(s)
1–8, 12–23, and 27–32	35 U.S.C. § 103(a)	Nancy J. Yeager & Robert E. McGrath, <i>Web Server Technology: The Advanced Guide for World Wide Web Information Providers</i> (Michael B. Morgan et al. eds., 1st ed. 1996) (Ex. 1008, “Yeager”); and Microsoft Internet Explorer 5 Resource Kit (1999) (Ex. 1006, “IE5 Resource Kit”)
9 and 24	35 U.S.C. § 103(a)	Yeager; IE5 Resource Kit; and Network Working Group, Request for Comments: 1034 (Nov. 1987) (Ex. 1024, “RFC 1034”)

Paper 9 (“Dec. on Inst.”), 14.

After institution, Patent Owner filed a Response (Paper 15, “PO Resp.”) to the Petition, and Petitioner filed a Reply (Paper 23, “Pet. Reply”) to the Response. An oral hearing was held on July 19, 2016, and a transcript of the hearing is included in the record. Paper 32 (“Tr.”).

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, Petitioner has not

shown by a preponderance of the evidence that claims 1–9, 12–24, and 27–32 of the '643 patent are unpatentable.

A. *Related Proceedings*

The parties indicate that the Petition in this case is related to the petition for *inter partes* review in IPR2015-01009, which also involves the '643 patent. Pet. 2; Paper 5, 2. Patent Owner indicates that certain patents related to the '643 patent are at issue in various *inter partes* reviews, reexaminations, and district court cases. Paper 5, 2–12.

B. *The '643 Patent*

The '643 patent relates to, *inter alia*, establishing a secure communication link between a computer and a server without a user of the computer having to enter any identification information, passwords, or encryption keys. Ex. 1001, col. 48, l. 66–col. 49, l. 1, col. 50, ll. 9–16. For example, a user of a computer may connect to a non-secure server by entering a domain name for the non-secure server in a Web browser. *Id.* at col. 49, ll. 21–32. The user then can enable a secure communication mode simply by clicking a “go secure” hyperlink in the Web browser. *Id.* at col. 50, ll. 9–12. The '643 patent explains that a software module on the computer automatically replaces the domain name for the non-secure server with a secure domain name. *Id.* at col. 50, ll. 22–25. The software module then sends a query using the secure domain name to a secure domain name service (“SDNS”). *Id.* at col. 50, ll. 49–53. In response to the query, the SDNS returns an address for a secure server. *Id.* at col. 51, ll. 39–42. The computer then accesses the secure server through a virtual private network (“VPN”) communication link. *Id.* at col. 51, ll. 57–59.

C. *Illustrative Claim*

Claims 1 and 17 are independent. Claim 1 is reproduced below.

1. A method for establishing an encrypted communication link between a first device and a second device over a communication network, the method comprising:

enabling, at the first device, a secure communication mode without a user entering any cryptographic information for establishing the secure communication mode; and

establishing, based on a determination that the secure communication mode has been enabled, the encrypted communication link between the first device and the second device over the communication network, the establishing including:

constructing a domain name based on an identifier associated with the second device;

sending a query using the domain name;

receiving, in response to the query, at least one network address associated with the domain name; and

initiating establishment of the encrypted communication link between the first device and the second device over the communication network using the at least one network address and encrypted communication link resources received from a server that is separate from the first device.

Ex. 1001, col. 55, ll. 46–67.

II. ANALYSIS

A. *Claim Construction*

The claims of an unexpired patent are interpreted using the broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). The parties propose construing several claim terms in the '643 patent. Pet. 9–15; PO Resp. 4–32. For the reasons

discussed below, we determine that no claim terms require express construction to resolve the parties' disputes regarding the asserted grounds of unpatentability in this case. *See infra* Sections II.B–II.C; *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

B. *Obviousness of Claims 1–8, 12–23, and 27–32 Over Yeager and IE5 Resource Kit*

Petitioner argues that claims 1–8, 12–23, and 27–32 would have been obvious over Yeager and IE5 Resource Kit. Pet. 3. A claim is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any objective indicia of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

We have considered the parties' arguments and supporting evidence, and we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–8, 12–23, and 27–32 would have been obvious over Yeager and IE5 Resource Kit.

1. *Overview of Yeager and IE5 Resource Kit*

Yeager relates to, *inter alia*, transmitting secure communications over the Web. Ex. 1008, 349. Yeager explains that computers use a Uniform

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.