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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS INC.,
Requester,

v.

VIRNETX INC.,
Patent Owner.

Appeal 2016-005339
Reexamination Control 95/001,856
Patent 7,921,211 B2
Technology Center 3900

Before STEPHEN C. SIU, DENISE M. POTHIER, and
JEREMY J. CURCURI, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*

DECISION ON APPEAL

VirnetX Inc. (“Patent Owner”) appeals under 35 U.S.C. §§ 134 and 315 the Examiner’s rejections of claims 36–60 over various references. PO App. Br. 1–2.¹ We have jurisdiction under 35 U.S.C. §§ 134 and 315 (pre-AIA). An oral hearing was conducted on July 7, 2016.

This proceeding arose from a December 16, 2011 request for an *inter partes* reexamination of the claims of U.S. Patent 7,921,211 B2, titled “Agile Network Protocol for Secure Communications Using Secure Domain Names” and issued to Victor Larson, Robert Dunham Short, III, Edmund Colby Munger, and Michael Williamson, on April 5, 2011 (“the ’211 patent”).

The ’211 patent describes a secure mechanism for communicating over the internet. The ’211 patent 3:10.

Claim 36 reads as follows:

36. A non-transitory machine-readable medium comprising instructions executable in a domain name service system, the instructions comprising code for:

connecting the domain name service system to a communication network, storing a plurality of domain names and corresponding network addresses, receiving a query for a network address, and indicating in response to the query whether the domain name service system supports establishing a secure communication link.

¹ Patent Owner’s Appeal Brief, filed April 9, 2015 (PO App. Br.).

The cited references are as follows:

Ludwig	US 5,689,641	Nov. 18, 1997
Aziz	US 6,119,234	Sept. 12, 2000
Broadhurst	US 6,560,634 B1	May 6, 2003

Rolf Lendenmann, *Understanding OSF DCE 1.1 for AIX and OS/2*, IBM International Technical Support Organization, pp. 1–45 (Oct. 1995) (“Lendenmann”).

Takahiro Kiuchi and Shigekoto Kaihara, “C-HTTP – The Development of a Secure, Closed HTTP-based Network on the Internet,” Proceedings of the Symposium on Network and Distributed System Security, pp. 64–75, 1996 (“Kiuchi”).

Bryan Pfaffenberger, Netscape Navigator 3.0: Surfing the Web and Exploring the Internet, Academic Press, pp. 3–446 (1996) (“Pfaffenberger”).

Information Sciences Institute, “Transmission Control Protocol,” DARPA Internet Program Protocol Specification Request for Comments 793 (Sept. 1981) (“RFC 793”).

R.L. Rivest et al., “A Method for Obtaining Digital signatures and Public-Key Cryptosystems,” Communications of the ACM, Vol. 21, no. 2, pp. 120–126 (Feb. 1978) (“Rivest”).

Patent Owner appeals the Examiner’s rejection of

- 1) Claims 36–54 and 57–60 under 35 U.S.C. § 102(b) as anticipated by Lendenmann;
- 2) Claims 36–46, 48, 49, 51, 52, and 57–60 under 35 U.S.C. § 102(e) as anticipated by Aziz;

- 3) Claims 55 and 56 under 35 U.S.C. § 103(a) as unpatentable over Lendenmann, Ludwig, and RFC 793;
- 4) Claims 53–56 under 35 U.S.C. § 103(a) as unpatentable over Aziz and Ludwig;
- 5) Claims 36–43, 46, 48–54, and 57–60 under 35 U.S.C. § 103(a) as unpatentable over Kiuchi and Pfaffenberger;
- 6) Claim 47 under 35 U.S.C. § 103(a) as unpatentable over Kiuchi, Pfaffenberger, and Rivest;
- 7) Claims 44 and 45 under 35 U.S.C. § 103(a) as unpatentable over Kiuchi, Pfaffenberger, and Broadhurst;
- 8) Claim 56 under 35 U.S.C. § 103(a) as unpatentable over Kiuchi, Pfaffenberger, and Ludwig.

ISSUE

Did the Examiner err in rejecting claims 36–60?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

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, and

(3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Lendenmann

Patent Owner states that the Examiner erred in finding that any one of Lendenmann’s 1) “returning a network address” (PO App. Br. 18-19), 2) “access control list [ACL] integrated into the CDS” (PO App. Br. 19-20), 3) “binding handles” (PO App. Br. 20-22), and/or 4) “authentication challenge” (PO App. Br. 22-24) is code for “indicating in response to the query whether the domain name service system supports establishing a secure communication link,” as recited in claim 36.

Returning a Network Address (code for “indicating” in claim 36)

As Requester explains, Lendenmann discloses that the “Cell Directory Service (CDS) . . . stores names of resources . . . so that when given a name, CDS returns the network address of the named resource.” Lendenmann 21, *quoted in* Orig Req.² Exhibit F-1, 13. Requester also explains that “[b]y returning the network address corresponding to a secure domain name, the . .

² Request for Inter Partes Reexamination, filed December 16, 2011 (“Orig. Req.”).

. CDS . . .provides” the code for “indicating,” in response to a client request as recited in claim 36. *Id.* We agree with Requester.

One of skill in the art would have understood that a Cell Directory Service (CDS) can provide a requested element, such as a requested network address with which to establish a secure communication link in response to a query. By providing the requested network address, the CDS, in fact, establishes the secure communication link and would have “indicated” during the process that the system supports the establishing of the secure communication link because the secure communication link is, in fact, established, demonstrating that the system, in fact, supports the recited establishment. Otherwise, the system would be unable to establish the secure communication link and the user who requested the network address would not be able to connect. This inability to establish a secure communication link is in direct contrast with the teaching of Lendenmann, according to Requester and not disputed by Patent Owner, in which a communication link is, in fact, established by a system that supports such an establishment. Orig. Req. Exh. F-1 3–9, 13–18.

Patent Owner argues that the ’211 patent Specification discloses examples of two embodiments in which the domain name service system “do[es] more than just return a network address.” PO App. Br. 19. We are not persuaded by Patent Owner’s argument at least because, even assuming that Patent Owner is correct that the ’211 patent’s Specification discloses examples in which the domain name service system does “more than just return a network address,” Patent Owner does not demonstrate sufficiently that this alleged disclosure purported to be present in the ’211 patent

Specification demonstrates that Lendenmann fails to disclose the code for “indicating,” as recited in claim 36. For example, claim 36 does not recite that “indicating” includes doing “more than just return a network address” or what specifically “more than” would include assuming claim 36 provided such a recitation.

Access Control List Integrated into the CDS (code for “indicating” in claim 36)

Requester also explains that Lendenmann alternatively discloses “the Cell Directory Service (CDS) . . . provides name resolution services only for authenticated and authorized users” and “only completes an operation . . . if the user is authenticated and authorized” by “creating access control lists” that “determine which user can use the name and what management operations they are allowed to perform.” Orig. Req. Ex. F-1 13-14 (citing Lendenmann 34). Requester states that “[b]y only performing operations for authenticated and authorized users, the Cell Directory Services includes . . . an indication,” as recited in claim 36. Orig. Req. Ex. F-1 14. We agree with Requester. For example, Lendenmann discloses that a “CDS” provides user access (or establishes a secure communication link) “only . . . if the user is authenticated and authorized” as indicated by “creating access control lists . . . that determine which user . . . can use the name and what management operations they are allowed to perform.” Lendenmann 34. Lendenmann also discloses that the CDS “is integrated into the security service.” *Id.* Patent Owner does not explain a sufficient difference between the ACL entries that “indicate” whether the domain name service system supports

establishing a secure communication link by determining user access and permitted management operations for a given user indicated in the ACL entries and the claim feature of “indicating.”

Patent Owner argues that the CDS of Lendenmann only “‘returns the network address of the named resource’ when given a name in a request” and is a separate entity from the “security server” of Lendenmann, which Patent Owner alleges “plays a role to control access” but “has no bearing on the operations of the alleged domain name service system, the CDS.” PO App. Br. 19. In other words, Patent Owner argues that the “CDS” of Lendenmann fails to indicate that the system supports the establishing of a secure communication link, as recited in claim 36, because a separate entity (i.e., a “security server”) of Lendenmann allegedly authenticates a user. We are not persuaded by Patent Owner’s argument at least because, even assuming that Patent Owner is correct that Lendenmann discloses a separate entity (a “security server”) that performs the actual steps in establishing a secure communication link, Patent Owner does not demonstrate sufficiently how this alleged fact that a separate entity performs the actual steps to establish a communication link would indicate that the CDS of Lendenmann fails to comprise “indicating,” as recited in claim 36. For example, Patent Owner does not demonstrate sufficiently that claim 36 also recites or otherwise requires that the “indicating” requires that the domain name service perform the actual steps to establish a secure communication link.

We also note that Lendenmann discloses that the CDS “is integrated into the security service.” Lendenmann 34. Hence, even assuming without agreeing Patent Owner’s contention to be correct that the domain name

service system (e.g., Lendenmann's CDS) is somehow required by claim 36 to perform a process that is disclosed by Lendenmann to be performed by a "security server," Patent Owner does not explain how a CDS that is "integrated into the security service" somehow fails to perform a process that is performed by a service with which the CDS is integrated.

In addition, we note that Lendenmann discloses that "a DCE [Distributing Computing Environment] unit is referred to as a cell [that] must contain a Security Server, a Cell directory Server and distributed Timer Servers" and that "[a]ll of these services may run on one machine, or . . . can be spread among the machines that are to be part of the cell." Lendenmann 9 (Sec. 1.4.2). Hence, to the extent Patent Owner argues that the "Security Server" of the DCE unit establishes a communication link and not the separate Cell Directory Server of the DCE unit and assuming that claim 36, as Patent Owner appears to suggest, recites that the domain name service system must perform specific steps to establish a secure communication link with one and only one structure, we are not persuaded by Patent Owner's argument because, even assuming these contentions to be correct, the disputed function(s) may be "run on one machine" of the DCE unit as Lendenmann discloses.

Because Patent Owner has not demonstrated sufficiently that any one of either "returning a network address" or "access control list" (i.e., "ACLs") of Lendenmann is distinct from "indicating," as recited in claim 36, we need not further consider whether or not "binding handles" or "authentication challenge" of Lendenmann also discloses the claimed "indicating."

Purported Non-conventional DNS of Claims 36 and 48

Regarding claim 48, Patent Owner argues that Lendenmann discloses “a conventional feature that is both disparaged and disclaimed in the ’211 patent specification” (PO App. Br. 24) and, therefore, fails to disclose the invention as claimed in claim 48. In other words, Patent Owner argues that Lendenmann fails to disclose a “non-conventional” domain name service that performs no “conventional feature[s].” PO App. Br. 4-8, 24. We are not persuaded by Patent Owner’s argument.

Claim 36, for which claim 48 depends, recites a domain name service server. Patent Owner does not assert or demonstrate sufficiently that claim 36 also recites that the domain name service server is “non-conventional.” For at least this reason, we are not persuaded by Patent Owner’s argument.

Also, Patent Owner does not indicate where Lendenmann discloses a domain name service system that must be “conventional.” Therefore, even assuming that claim 36 recites that the domain name service server must be “non-conventional” and must not be “conventional,” Patent Owner does not demonstrate sufficiently that Lendenmann fails to disclose this feature.

Patent Owner argues that the Specification discloses that a “conventional” domain name service server “provide[s] a look-up function that *returns the IP address* of a requested computer or host.” PO App. Br. 6 (citing the ’211 patent 38:58–39:26). Because Patent Owner argues that claim 36, for example, must require that the “domain name service server” be “non-conventional,” Patent Owner appears to argue that claim 36 precludes the “domain name service server” from “returning the IP address

of a requested computer or host.” While we agree with Patent Owner that claim 36 does not recite “returning the IP address of a requested computer or host” (and, arguably, does not *require* this function), we also note that claim 36 does not recite that the domain name service server must *not* perform this function. Hence, this function is not precluded by claim 36. As such, even assuming Patent Owner’s contention to be correct that a “conventional” domain name service server provides a look-up function that returns the IP address of a requested computer or host, Patent Owner does not demonstrate persuasively that the domain name service server recited in claim 36 is, in fact, “non-conventional,” because claim 36 neither recites a “non-conventional” requirement nor does claim 36 preclude a function Patent Owner asserts to be solely “conventional.”

Patent Owner argues the Specification discloses various alleged features of a “conventional” domain name service server as undesirable (*see*, e.g., PO App. Br. 6–8). Patent Owner, therefore by inference and only after importing alleged features disclosed in the Specification into claim 36, argues that claim 36 also requires that the domain name service server must be “non-conventional” presumably to avoid the alleged undesirable characteristics disclosed in the Specification. For example, Patent Owner argues that the Specification discloses that a “conventional” domain name service server would permit “nefarious listeners on the Internet [to] intercept the DNS REQ and DNS RESP packets [which would] hamper anonymous communications on the internet.” PO App. Br. 6 (citing the ’211 patent 38:58–40:13).

We note that claim 36 does not recite that the domain name service server prevents nefarious listeners on the Internet from intercepting the DNS REQ and DNS RESP packets. Nor does Patent Owner provide an adequate rationale as to why one of skill in the art would have imported this particular claim limitation alleged to be in the Specification into claim 36. In any event, we also note that Patent Owner does not assert or demonstrate sufficiently that Lendenmann discloses a domain name service server that permits nefarious listeners on the Internet to intercept the DNS REQ and DNS RESP packets. Hence, even assuming Patent Owner's contention to be correct that a "conventional" system permits nefarious listeners on the Internet to intercept the DNS REQ and DNS RESP packets and claim 36 requires a "non-conventional" system in which nefarious listeners are *not* permitted to perform the stated act, Patent Owner still does not sufficiently distinguish Lendenmann because Patent Owner does not demonstrate persuasively that Lendenmann only discloses a system that permits nefarious listeners to intercept the DNS REQ and DNS RESP packets.

Patent Owner argues that "[o]ne of ordinary skill in the art would not have understood conventional domain name services . . . to have supported the establishment of a secure communication link." PO App. Br. 7. Presumably, Patent Owner argues that Lendenmann fails to disclose a system that supports the establishment of a secure communication link. This issue has been previously discussed. We are not persuaded by Patent Owner's argument in view of the numerous references in Lendenmann's disclosure of establishing a secure communication link. *See, e.g.*, Lendenmann 34 ("Security in CDS Environment"), 41 ("Security Service"),

42 (“Security Requirements”), 43 (“Security Policies”), 44 (“Security Standards”), 45 (“DCE Security Service Components and Facilities”), to name a few.

Patent Owner also argues that Lendenmann fails to disclose “at least one of the plurality of domain names” comprises “an indication that the domain name service system supports establishing a secure communication link” as recited. PO App. Br. 25; RAN 44. The Examiner finds that Lendenmann “does indeed teach that a domain name[] comprises an indication that the DNS system supports a secure communication link.” RAN 44 (citing Lendenmann 23); *see also* RAN 45 (“the claim permits the domain name . . . to provide an indication that the DNS supports establishing a secure communication link. *See* the [explanation provided regarding] the Lendenmann rejection”). We agree with the Examiner for at least the previously stated reasons with respect to Lendenmann.

Patent Owner argues that “[c]laim 48 describes a functional relationship.” PO App. Br. 25. This issue is moot, especially in view of the Examiner’s *prima facie* showing that Lendenmann discloses a domain name that “includes an indication that the domain name service system supports the establishment of a secure communication link,” as recited in claim 48. We refer to our previous discussion.

Obviousness – Secondary Considerations

Patent Owner argues it would not have been obvious to one of ordinary skill in the art to have combined the teachings of any of the cited references because there was a “long-felt need . . . to easily and conveniently

establish secure communication links” (PO App. Br. 43), “others attempted to create easy-to-enable secure communications [but] failed” (PO App. Br. 44), “the technology of the ’211 patent was also met with skepticism” (*id.*), “the claimed inventions have experienced commercial success” (*id.*), and “[t]hose in the industry have also praised the inventions.” PO App. Br. 45.

Long Felt Need

Patent Owner argues that “[p]rior to the claimed inventions . . . it was widely recognized that providing secure remote access to a LAN or WAN was extremely difficult for IT support desks” and that the claimed invention “combine[s] both the ease of use *and* the security aspects of a VPN, without sacrificing one or the other . . . by providing a domain name service for establishing a secure communication link.” PO App. Br. 43 (citing Declaration of Dr. Robert Dunham Short III, filed April 9, 2015 (“Short Decl.”) ¶¶ 8, 9, 11, PO App. Br., Evidence App’x, Ex. B-4 1-2).

Based on the evidence of record, we are not persuaded by Patent Owner’s argument that “it was widely recognized that providing secure remote access . . . was extremely difficult.” Rather, Patent Owner’s evidence indicate that “[r]emote access . . . [is] insecure and unreliable” but that “[y]ou can solve the security problem using client-to-LAN virtual private network (VPN) technology.” PO App. Br., Evidence App’x, Ex. B-4 at 1, *cited in* Short Decl. ¶ 8. Hence, rather than being “extremely difficult” to provide secure remote access, as Patent Owner alleges, Patent Owner’s declarant (Dr. Short) points out that, in fact, it was known in the art that any security problems associated with remote access could be solved. Hence,

solutions were known in the art that provided secure remote access. On this record, however, Patent Owner fails to demonstrate with specific and credible evidence that such solutions were “extremely difficult” to implement (*see e.g.*, Short Decl. Ex. B-4 at 1) prior to the filing of the ’211 patent.

Also, Patent Owner argues that there was a long felt need to combine both the ease of use *and* the security aspects of a VPN by automatically initiating an encrypted channel between a client and a secure server. PO App. Br. 43. As discussed above, Lendenmann predates the filing of the ’211 patent and also discloses this feature. Patent Owner does not explain how the claimed invention satisfies this alleged “long felt need” of providing secure remote access when Lendenmann, at least, already provided for secure remote access.

Patent Owner also argues that “the Defense Advanced Research Projects Agency (‘DARPA’) funded various research programs to . . . further the science and technology of information assurance and survivability” and that “SAIC . . . also spent significant resources of its own on their development [of “cutting edge technology].” PO App. Br. 43-44. Patent Owner does not explain sufficiently how the amount of resources spent by either “DARPA” or “SAIC” for various research programs to further “information assurance and survivability” or “cutting edge technology” demonstrates a long felt need for the claimed invention. We are not persuaded by Patent Owner’s argument.

Failure of Others

Patent Owner argues that “Dynamic Coalitions,” was specifically created to address the ability of the Department of Defense to quickly and easily set up secure communications over the Internet” but that “none of [the organizations operating under “Dynamic Coalitions”] came up with a solution . . . that was even close to providing the ease of use of the solutions provided in the claimed inventions of the ’504 patent.” PO App. Br. 44 (citing Short Decl. ¶¶ 4, 5, 10, 11, PO App. Br., Evidence App’x, Ex. B-4 at 1–2, Ex. B-3 at 1–4, Ex. B-1 at 1–2).

We are cautioned by the Federal Circuit that, with respect to secondary considerations alleged by Patent Owner in response to a prima facie showing of obviousness, “the obviousness inquiry centers on whether ‘the claimed invention as a whole’ would have been obvious.” *WBIP, LLC v. Kohler Co.*, Appeal Nos. 2015-1038, 2015-1044, slip op. at 15 (Fed. Cir., July 19, 2016). Looking at the “claimed invention as a whole,” we note that claim 36, for example, recites a non-transitory machine-readable medium comprising instructions executable in a domain name service, the instructions comprising code for connecting the domain name service system to a communication network, storing a plurality of domain names and corresponding network addresses, receiving a query for a network address, and to indicating in response to the query whether the domain name service system supports establishing a secure communication link.

As previously discussed in the record, Lendenmann discloses these features, either taken separately or as a “whole.” Patent Owner does not indicate a portion of the “whole” of the claimed invention that Lendenmann supposedly does not disclose. Not having identified sufficiently a part of the

“whole” of the claimed invention that Lendenmann does not disclose, we conclude that Lendenmann discloses the “whole” of the claimed invention. Therefore, Patent Owner fails to show a nexus to its evidence of secondary considerations.

While Patent Owner argues that DARPA-sponsored entities were supposedly unable to provide “a solution that allowed a user to easily and conveniently enable secure communications” (PO App. Br. 44 (citing Short Decl. ¶ 5; PO App. Br., Evidence App’x, Ex. B–3 at 1–4; Ex. B-1 at 1–2)), Patent Owner does not demonstrate persuasively and with credible evidence that Lendenmann, for example, was also unable to provide such a “solution.” As previously discussed, Lendenmann succeeded in providing such solutions.

Skepticism

Patent Owner argues that “a DARPA program manager informed one of the co-inventors that technology disclosed in the ’211 patent would never be adopted” and that “IT offices of many large companies and institutions expressed skepticism that secure connections could ever be enabled easily by regular computer users” because secure connections “could only be achieved through difficult-to-provision VPNs and . . . easy-to-set-up connections could not be secure.” PO App. Br. 44 (citing Short Decl. ¶¶ 13, 15). We are not persuaded by Patent Owner’s argument.

We are directed by the Federal Circuit to consider the “*claimed* invention as a whole,” when considering secondary considerations raised in response to a prima facie showing of obviousness. Patent Owner does not

indicate that the DARPA program manager in question informed the co-inventor that technology *claimed* in the '211 patent would never be adopted.

Further, even assuming that the manager's comment concerns the claimed invention, we are not persuaded by Patent Owner's argument because citing one person's opinion as to whether the claimed invention would be adopted does not constitute general skepticism in the industry. For example, Patent Owner does not list any credible publications on this point or indicate that any studies were performed over a statistically significant proportion of those of skill in the art that would indicate that there was, in fact, a general feeling of skepticism in the field that secure communications could be accomplished.

In any event, we note that not only does the record show that Lendenmann already solved the problem of providing secure remote access, as previously discussed, but that Patent Owner's evidence also indicates that the problem of providing secure remote access was already solved. *See, e.g.*, PO App. Br., Evidence App'x, Ex. B-4 at 1 ("But fear not: You can solve the security problem"), *cited in* Short Decl. ¶ 8. It is unlikely that those of skill in the art would have been skeptical that secure remote access, for example, could be achieved, given the fact that secure remote access was already being accomplished by ordinarily skilled artisans.

Commercial Success

Patent Owner argues that "the claimed inventions have experienced commercial success, with multiple companies licensing the technology." PO App. Br. 44. However, Patent Owner does not provide any data regarding

market share or revenue from sales of any products alleged to be encompassed by the claimed invention. Rather, Patent Owner argues commercial success based solely on the alleged fact that various business entities entered into licenses with Patent Owner. PO App. Br. 44–45. Even assuming that the cited business entities entered into licenses with Patent Owner, this allegation alone would be insufficient to demonstrate commercial success at least because Patent Owner provides insufficient evidence suggesting that the reason any of the business entities entered into licenses with Patent Owner was due to the merits of any claim at issue here, as opposed to any number of other reasons (e.g., expediency, advertising, or avoiding a lawsuit).

Even assuming that the cited business entities entered into licensing for the sole reason that Patent Owner’s claimed invention was a “commercial success,” we are still not persuaded by Patent Owner’s argument.

In discussing secondary considerations, Patent Owner generally alludes to allowing a user “to . . . establish a secure communication link.” *See, e.g.,* PO App. Br. 43, 46. To the extent Patent Owner argues that ability to establish a secure communication links is the nexus that ties the secondary consideration factors to the claimed invention, we note that Lendenmann discloses this feature and there can be no nexus when the alleged secondary consideration factors stem from what was known in the prior art. *Tokai Corp.*, 632 F.3d at 1369.

As previously stated and in accordance with instructions from the Federal Circuit, we consider the “*claimed* invention as a whole” when determining whether Patent Owner has provided a sufficient nexus between the alleged secondary considerations (e.g., commercial success) and the claimed invention (“as a whole”) to overcome the prima facie showing of obviousness. As previously discussed above and based on the evidence of record, Lendenmann discloses each of the parts of the claimed invention and, therefore, also discloses the “whole” claimed invention. Therefore, when considering the “claimed invention as a whole,” we still conclude that Patent Owner has not provided a sufficient showing of nexus between the alleged secondary considerations and the “claimed invention as a whole” to overcome the prima facie showing of obviousness.

Praise in the Industry

Patent Owner argues that “[t]hose in the industry have . . . praised the inventions . . . by investing in the technology or licensing it.” PO App. Br. 45. However, as previously discussed, Patent Owner does not demonstrate sufficiently any specific reason for any alleged investment and licensing activity on the part of business entities. As previously discussed, Patent Owner provided insufficient evidence to conclude that any licensing (or investing for that matter) activity was performed for any particular purpose or was related to any specific claim at issue in this proceeding. Nor does Patent Owner demonstrate sufficiently a nexus between the alleged praise and the “claimed invention as a whole.” Based on the evidence of record, we can only conclude that there is an allegation that licenses were entered

into and investments were made without any showing as to the motivation behind these alleged activities. This is insufficient to conclude that these alleged activities constitute an expression of “praise” for the “claimed invention as a whole” (or because of “commercial success”).

In summary, we are not persuaded by Patent Owner’s argument related to secondary considerations.

Patent Owner does not provide additional arguments in support of claims 36–47, 49–54, and 57–59 or arguments with respect to Lendenmann and Ludwig for claims 55 and 56. PO App. Br. 24–26. The Examiner did not err in rejecting claims 36–54 and 57–60 as anticipated by Lendenmann and claims 55 and 56 as unpatentable over Lendenmann and Ludwig.

In view of the above, we need not consider the propriety of the Examiner’s adoption or non-adoption of the rejection of claims 36–60 based on other grounds. *Cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009).

DECISION

We affirm the Examiner’s rejection of claims 36–54 and 57–59 under 35 U.S.C. § 102(b) as anticipated by Lendenmann and claims 55 and 56 under 35 U.S.C. § 103(a) as unpatentable over Lendenmann and Ludwig.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. *See* 37 C.F.R. § 41.79.

Appeal 2016-005339
Reexamination Control 95/001,856
Patent 7,921,211 B2

In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED

Patent Owner:

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 New York Avenue, NW
Washington DC 20001-4413

Third-Party Requester:

SIDLEY AUSTIN LLP
2001 Ross Avenue
Suite 3600
Dallas, TX 75201

pgc