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

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FOSTER, ROLAND G

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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 REQUEST FOR REHEARING

In papers filed October 12, 2016, VirnetX Inc. (“Patent Owner”) requests a rehearing responsive to the September 12, 2016 Decision on Appeal (“Decision”).

Patent Owner argues that “the Board . . . entered a new ground of rejection but did not indicate as much.” Request for Rehearing, filed October 12, 2016 (“Req. Reh’g.”) 2. In particular, Patent Owner argues that “the Board’s principal evidence, position, and rationale regarding how *Lendenmann* teaches the claimed ‘indicate’ feature¹ substantially differs from that of the Examiner” because “[t]he Board rejected VirnetX’s argument by *newly* finding that the CDS and DCE Security Service may run on the same machine and that therefore, the operation of the DCE Security Service (rather than the CDS) may be relied upon to address the claimed ‘indicate’ feature” but that “[t]he Examiner never found nor relied upon any teaching in *Lendenmann* that the CDS and DCE Security Service may run on the same machine. (*See, e.g.*, RAN at 39.).” Req. Reh’g. 3, 4.

Requester initially argued that *Lendenmann* discloses to “indicate” or “indicating,” as recited in claim 1 (and claim 36). In particular, Requester argued that *Lendenmann* discloses a “DCE Directory Service, including the Cell Directory Service (CDS)” as “support[ing] establishing a secure communication link by providing clients with the network address of a requested server.” Request for *Inter Partes* Reexamination, Exh. F-1, filed

¹ For example, claim 36 recites “indicating in response to the query whether the domain name service system supports establishing a secure communication link.”

December 16, 2011 (“Exh. F-1”) 13, 49². Requester also argued that “the Cell Directory Service (CDS) is integrated with the security services provided by DCE” and that “[t]he CDS, as any other DCE service, is integrated into the security service.” Exh. F-1, 13, 14.

The Examiner agreed with Requester and found that “the Cell Directory Service (CDS) . . . provides ‘an indication . . .’ as recited in the claim. (Request, Exhibit F-1, claim chart, p. 13)” and that “the CDS provides an indication that supports establishing a secure communication link. (*Id.* at 14).” RAN 39. In other words, the Examiner relied on Requester’s arguments (Exh. F-1) to determine that Lendenmann discloses that the Cell Directory Service (CDS) that is “integrated with the security services provided by DCE” and “is integrated into the security service” (Exh. F-1, 13, 14), provides an “indication” (or “indicates”) as recited in claim 1 (and claim 36).

Patent Owner argued that Lendenmann fails to disclose or suggest the “indication” (or “indicating”) as recited in claim 36, because, according to Patent Owner, “the ACLs [Access Control List] are functions of the DCE Security Service – not the Cell Directory Service.” PO App. Br. 19.

In the Decision, we concluded that “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.” Decision 9. We then cited an additional portion of

² Requester relies on much of the discussion for claim 1, when addressing the limitations in claim 36. See Exh. F-1, 46–49. We refer to the discussion of claim 1 as did Requester when appropriate.

Lendenmann which goes no farther than, and merely elaborates upon, what is taught in the cited portion of Lendenmann. Namely, the cited portion of Lendenmann, relied upon by the Examiner and Requester, stated that the CDS is “integrated with the security services provided by DCE” (Exh. F-1, 13) and that “[t]he CDS, as any other DCE service, is integrated into the security service” (Lendenmann 34). To highlight this fact, we observed that Lendenmann further discloses that security service (i.e., “Security Server”) of the DCE is, in fact, an “integrated” component as functions may be “run on one machine.” In other words, the functions and services of Lendenmann are, indeed, “integrated.”

Patent Owner now argues that our statement further demonstrating that the components and/or functions of Lendenmann are integrated (by emphasizing that such components and/or functions may be “run on one machine”) “differs from that of the Examiner,” “changes the thrust of the Examiner’s rejection,” and “is thus a new ground of rejection.” Req. Reh’g. 4. We disagree with Patent Owner’s argument. The mere use of different language or restating the reasoning previously presented does not constitute a new ground so long as the “basic thrust of the rejection” is the same. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976), *see also In re Jung*, 637 F.3d 1356, 1364-65 (Fed. Cir. 2001) (additional explanation responding to arguments offered for the first time “did not change the rejection” and appellant had fair opportunity to respond).

In this case, Requester argued and the Examiner determined that Lendenmann discloses that the CDS is “integrated” with security services of the DCE. We agreed with the Examiner and Requester that the CDS is

“integrated with security services of the DCE” and pointed out the Lendenmann even discloses that such components and services may be “integrated” to be “run on the same machine.” The basic thrust of the rejection is the same, which is that the CDS is “integrated” with security services of the DCE.

Patent Owner argues that “the Federal Circuit held that the Board issued a new ground of rejection when the Board offered a new rationale for combining the teachings of two references in an obviousness rejection.” Req. Reh’g 3 (citing *Rambus Inc. v. Rea*, 731 F.3d 1248, 1256 (Fed. Cir. 2013)). However, Patent Owner does not assert or demonstrate persuasively that the Federal Circuit also held that the Board issued a new ground of rejection when the Board restated the same argument(s) using different terminology, as in the present case. Therefore, we are not persuaded by Patent Owner’s argument.

We are also not persuaded by Patent Owner’s arguments for at least the reasons set forth by Requester. Third Party Requester Cisco Systems, Inc.’s Opposition to the Request for Rehearing, filed November 14, 2016, at 1–2.

We have considered Patent Owner’s Request for Rehearing but are not persuaded of error in the Decision. Patent Owner’s Request for Rehearing is denied.

DENIED

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PATENT OWNER:

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

THIRD PARTY REQUESTER:

HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219