

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPLUNK INC.,
Petitioner,

v.

SABLE NETWORKS, INC.,
Patent Owner.

IPR2022-00003
Patent 7,630,358 B1

Before KRISTEN L. DROESCH, SCOTT B. HOWARD, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

On October 4, 2021, Splunk Inc. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of claims 1–15, 23–28, 32, 43–51, and 97 of U.S. Patent No. 7,630,358 B1 (Ex. 1001, “the ’358 patent”). Paper 2 (“Pet.”). Sable Networks, Inc. (“Patent Owner”)² timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We may institute an *inter partes* review if the information presented in the Petition and the Preliminary Response shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. *See* 35 U.S.C. § 314. However, the Board has discretion to deny a petition even if a petitioner meets that threshold. *See, e.g.*, 35 U.S.C. § 325(d); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”).

Based on the record in this proceeding, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review.

I. BACKGROUND

A. Related Matters

The parties state that the ’358 patent is at issue in *Sable Networks, Inc. v. Splunk Inc.*, 5:21-cv-00040 (E.D. Tex.). Pet. 82; Paper 5, 1.

In addition, in IPR2021-01594, Petitioner filed another petition challenging the ’358 patent. Paper 5, 1; *see also* Paper 3, 5 (Petitioner’s

¹ Petitioner also identifies Critical Start Inc. as a real party in interest. Pet. 82.

² Patent Owner also identifies Sable IP, LLC as a real party in interest. Paper 5 (Patent Owner Mandatory Notices), 1.

ranking statement). Today, we issue a decision granting institution of that proceeding.

B. The Petition's Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 15):

Claim(s) Challenged	35 U.S.C. §³	Reference(s)/Basis
1–15, 23–28, 32, 43–51, 97	103(a)	Rao ⁴
1, 4–8, 10, 13, 26–28, 43–44, 47, 49, 96	103(a)	Rao, Pegrum ⁵

In support of its contentions, Petitioner relies on the testimony of Dr. Kevin Jeffay. Ex. 1002.

C. Summary of the '358 Patent

The '358 patent is titled “Mechanism for Implementing Multiple Logical Routers Within a Single Physical Router,” and the application that led to this patent was filed on July 9, 2002, claiming priority to a provisional application filed on July 9, 2001. Ex. 1001, codes (22), (54), (60).

The '358 patent begins by explaining that, at that time, “there ha[d] been a movement towards router aggregation”—in which “a plurality of standalone routers [were] incorporated into a single physical router”—because sharing resources reduced costs. Ex. 1001, 1:31–37. According to

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of § 103.

⁴ WO 2000/051290, published Aug. 31, 2000 (Ex. 1004).

⁵ EP 0 926 859 B1, issued Nov. 3, 2004 (Ex. 1005).

the Specification, “two approaches [were] used to implement router aggregation: virtual routers and multi-routers.” *Id.* at 1:38–39. The former approach used software to create multiple “router processes” (*id.* at 1:39–45), and the latter approach included multiple processors each assigned to a corresponding router process (*id.* at 1:49–55). In both approaches, each router process received packets, made routing decisions, and forwarded packets to external routers. *Id.* at 1:45–47, 1:55–58. “Thus, in many respects, each router process behave[d] like a standalone router.” *Id.* at 1:47–48, 1:58–60. However, in these existing approaches, the routers did not share information with each other, and they did not have links to each other. *Id.* at 2:4–9. The ’358 patent sought to remove these limitations for “other implementations in which it is desirable for the multiple routers within a single physical router to interact and to truly emulate the behavior of interconnected standalone routers.” *Id.* at 2:12–16.

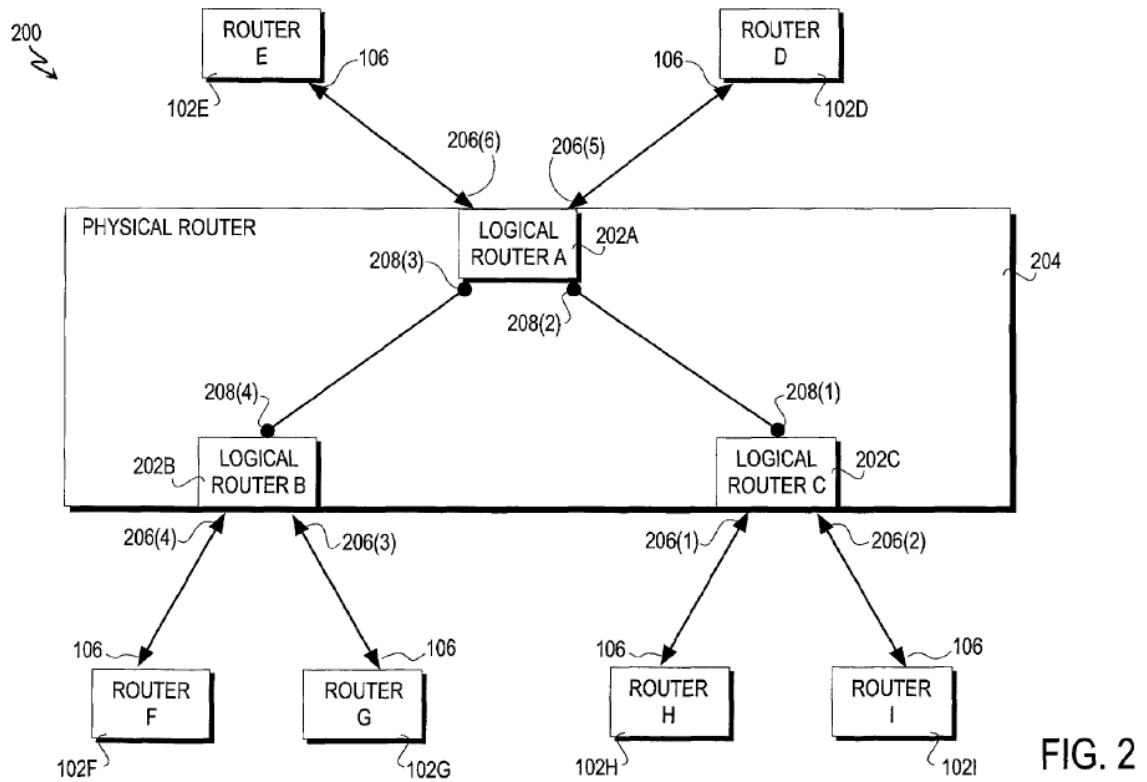
Consequently, the ’358 patent teaches that its logical routers “emulate the behavior of interconnected, standalone routers” (Ex. 1001, 2:25–26):

For example, the logical routers may be made aware of the presence of other logical routers within the same physical router. . . . In addition, the logical routers may send routing information to each other. In terms of protocol implementation, they act like separate standalone routers. Thus, to each other and to routers external to the single physical router, the logical routers appear as if they are interconnected standalone routers.

Id. at 2:26–34; *see also id.* at 5:15–23 (explaining that logical routers “truly emulate the behavior of standalone routers” by implementing the same forwarding and routing protocols as standalone routers). The ’358 patent also teaches that the logical routers can “determine whether the next hop for a set of information (e.g., a packet) is to a logical router within the same

physical router or to an external router,” and they can perform routing more efficiently by “tak[ing] advantage of the fact that the logical routers are not actual standalone routers.” *Id.* at 2:35–46; *see also id.* at 5:52–6:22 (providing example of bypassing the hop to a logical router).

An embodiment of the invention appears in Figure 2 (shown below).



As seen above, Figure 2 depicts network 200, which includes logical routers 202a, 202b, 202c located within the same physical router 204 as well as another six physical routers 102d, 102e, 102f, 102g, 102h, 102i. Ex. 1001, 4:41–56. Physical routers 102 are connected to logical routers 202 via external interfaces 106, 206 and external lines (*id.* at 4:57–64; *see id.* at 4:16–20, 4:45–56), and logical routers 202a, 202b, 202c are connected to each other via internal interfaces 208 and internal links (*id.* at 5:3–7). Internal interfaces 208 and links “are logical entities” rather than actual

physical interfaces and links. *Id.* at 5:8–12. Packets (or other units of information) are routed via these links. *See id.* at 4:65–5:45.

D. Challenged Claims

Petitioner challenges claims 1–15, 23–28, 32, 43–51, and 97 of the '358 patent. Of these, claims 1, 43, and 97 are independent. Independent claim 1 is illustrative:

1. A router, comprising:
 - a first set of one or more components capable of being configured to implement a first logical router within said router;
 - a second set of one or more components capable of being configured to implement a second logical router within said router; and
 - a forwarding routing table that comprises an identifier that indicates an internal link is internal rather than an external link;
- wherein said first and second sets of components comprise functionality for establishing said internal link between said first logical router and said second logical router and advertising said internal link to other routers external to said router such that said first and second logical routers appear to the other routers as interconnected standalone routers, wherein said internal link is a logical, non-physical entity.

Ex. 1001, 18:9–26.

II. DISCRETIONARY DENIAL

Patent Owner argues, *inter alia*,⁶ that we should exercise our discretion under 35 U.S.C. § 325(d) to deny institution. Prelim. Resp. 17–33. For the reasons explained below, we agree.

A. Legal Standard for Exercising Discretion under Section 325(d)

We may discretionarily deny institution of an *inter partes* review when a petition presents “the same or substantially the same prior art or arguments [that] previously were presented to the Office.” 35 U.S.C. § 325(d); *see also* 37 C.F.R. § 42.4(a) (the Board institutes trial on behalf of the Director). To evaluate whether such a denial is appropriate, the Board determines:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office;
- and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). In applying this two-part *Advanced Bionics* framework, we evaluate several non-exclusive factors, including:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;

⁶ We decline to address the other arguments advanced by Patent Owner for discretionary denial as they are moot. *See* Prelim. Resp. 2 n.1, 4, 57–66; Paper 7 (Patent Owner’s response to ranking of parallel petitions).

- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph). Factors (a), (b), and (d) relate to the first part of the *Advanced Bionics* framework (i.e., whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office), and factors (c), (e), and (f) relate to the second part (i.e., “whether the petitioner has demonstrated a material error by the Office” in its prior consideration of the prior art or arguments). *Advanced Bionics*, Paper 6 at 10. “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Id.* at 8–9. “[T]his framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

B. Analysis

1. Part 1: Whether the Same or Substantially the Same Art or Arguments Were Previously Presented

The first part of the *Advanced Bionics* framework requires us to determine whether the Petition advances the same or substantially the same art or arguments that were previously presented to the Office. *See Advanced Bionics*, Paper 6 at 8. For the reasons explained below, we determine that substantially the same art or arguments were previously presented, such that part one of the framework is satisfied.

The Petition’s primary reference is Rao: it forms the sole basis for Petitioner’s first ground, and it is the primary basis for Petitioner’s second ground. *See* Pet. 15. Although the second ground also includes a secondary reference (Pegrum), Petitioner relies on Rao for all claim limitations and points to Pegrum only “to the extent a logical, non-physical internal link between virtual routers was not obvious to the [person of ordinary skill in the art] from Rao alone.” *Id.* at 75–78; *see* Ex. 1001, 18:25–26 (claim 1 recites that “said internal link is a logical, non-physical entity”). Thus, we agree with Patent Owner that Petitioner relies on Pegrum “for a limited purpose only.” Prelim. Resp. 18 n.3. With this context, we consider both of Petitioner’s asserted references.

Petitioner asserts that the Examiner never considered Rao or Pegrum during prosecution. Pet. 2, 16 (citing Ex. 1003 (file history for ’358 patent)). Petitioner does not otherwise address the *Advanced Bionics* framework or the *Becton Dickinson* factors.⁷

⁷ Petitioner did not seek leave to file a pre-institution reply to address Patent Owner’s *Advanced Bionics* arguments.

Patent Owner argues that Rao “is substantially the same as, and cumulative of, U.S. Patent No. 6,674,756 to Rao et al., [(Ex. 2006, ‘the Rao Patent’)], one of the References Cited on the face of the ’358 patent.” Prelim. Resp. 18; *see also id.* at 15, 20–22 (citing Ex. 1003, 113). Patent Owner provides a redline copy of the written description of the Rao Patent showing the differences between the Rao Patent and Rao. *See* Ex. 2007 (*cited by* Prelim. Resp. 23). Patent Owner also contends that “the disclosures of Rao relied upon by Petitioner were previously presented to the Examiner” (Prelim. Resp. 28), and in support, Patent Owner includes a table identifying where the portions of Rao cited by Petitioner can also be found in the Rao Patent (*id.* at 23–27). Patent Owner explains that “[t]his significant substantive overlap makes sense given that the Rao reference cited in the Petition is the WIPO application corresponding to the Rao [Patent].” *Id.* at 28 (citing Ex. 2008 (USPTO Global Dossier)). Turning to Pegrum, Patent Owner contends that this secondary reference is “cumulative to Rao” because Petitioner relies on it only “[t]o the extent Rao does not teach” a claim limitation. *Id.* at 31 n.5 (alteration in original). Patent Owner further submits that, during prosecution, the Examiner found that the teaching alleged to be present in Pegrum would have been obvious from any software implementation of virtual routers. *Id.* (citing Ex. 1003, 194).

Having considered the record, we agree with Patent Owner that Rao (which we also call “the Rao Publication” for clarity) is substantially the same as the art that was previously presented to the Office. The Rao Patent was presented to the Office during the prosecution of the ’358 patent: the Examiner listed the Rao Patent in a Notice of References Cited (Ex. 1003, 113), and the face of the ’358 patent identifies the Rao Patent as a cited

reference (Ex. 1001, code (56)). *Accord* Prelim. Resp. 20–22. And the Rao Publication is substantially the same as the Rao Patent. *See* Ex. 2007, 1–37 (redline comparing the disclosures of these references); *see also* Ex. 2008 (indicating that the Rao Publication and the Rao Patent are members of the same patent family). Indeed, the specific portions of the Rao Publication that Petitioner relies upon are also present in the Rao Patent. *See* Prelim. Resp. 23–27 (table correlating citations to the Rao Publication with disclosures in the Rao Patent). For example, for representative independent claim 1, Petitioner relies upon the discussion of partitioning a switch into multiple virtual routers in the Rao Publication (*see* Pet. 21–36), and the relevant cited text appears substantially verbatim in the Rao Patent. *E.g., compare* Ex. 1004, 10:10–30, 12:20–32, 13:27–29, 14:4–15:2, 23:15–38, 30:24–31:1, Figs. 5, 6, 17 (*cited by* Pet. 21–36), *with* Ex. 2006, 8:7–37, 10:6–26, 11:6–9, 11:29–12:21, 19:28–65, 25:47–66, Figs. 5, 6, 17.

Moreover, we agree with Patent Owner that Petitioner’s reliance on Pegrum does not materially alter our analysis. First, as explained above, Petitioner only uses Pegrum for a limited purpose. Second, the cited disclosure of Pegrum is cumulative of the arguments previously considered by the Examiner. *See* Prelim. Resp. 31–32 n.5. Specifically, Petitioner uses Pegrum to teach “a logical, non-physical internal link” between virtual routers (*see* Pet. 75), but the Examiner found that this would have been obvious to a person of ordinary skill in the art because a software implementation of virtual routers “[would] automatically make the internal connection non-physical, as all software connections are not physical” (Ex. 1003, 194). Thus, the relied upon portion of Pegrum is cumulative of the arguments presented during examination. *See Regeneron Pharm., Inc. v.*

Merus N.V., 864 F.3d 1343, 1350 (Fed. Cir. 2017) (“A reference is cumulative when it ‘teaches no more than what a reasonable examiner would consider to be taught by the prior art already before the PTO.’” (citation omitted)).

Accordingly, having considered *Becton Dickinson* factors (a), (b), and (d), we determine that the first part of the *Advanced Bionics* framework is satisfied.

2. Part 2: *Whether the Petitioner Demonstrates Material Error*

Next, we consider “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6 at 8. To answer this question, we consider “(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; . . . (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.” *Becton Dickinson*, Paper 8 at 17–18. For the reasons set forth below, we determine that part two of the framework is also satisfied.

As for factor (c), the Examiner cited the Rao Patent, but did not rely upon it as a basis for rejection. *See* Ex. 1003, 113. However, it was one of only eleven references cited during prosecution. *See* Ex. 1001, code (56). Regarding factor (e), Petitioner has not alleged that the Examiner erred in his review of the Rao Patent and allowance of the ’358 patent’s claims in light of the Rao Patent’s teachings. *See* Prelim. Resp. 32–33. Indeed, as noted

above, Petitioner presents no arguments regarding the *Advanced Bionics* framework or the *Becton Dickinson* factors. Finally, turning to factor (f), we do not perceive a reason to reconsider this prior art. Having reviewed the Petition and the cited evidence therein, we question whether Rao discloses an “internal link” between its logical routers, as the challenged claims require. *See* Pet. 27–28 (alleging that an ordinary artisan would have understood this to be disclosed, but providing limited explanation).

Accordingly, we determine that the second part of the *Advanced Bionics* framework is also satisfied. As a result, we exercise our discretion to deny institution. *See Advanced Bionics*, Paper 6 at 8–9 (“If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.”).

III. CONCLUSION

In the specific factual circumstances of this case, consistent with the Board’s precedential decision in *Advanced Bionics*, we exercise our discretion to deny institution under Section 325(d).

IV. ORDER

It is:

ORDERED that the Petition is denied and no *inter partes* review is instituted.

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