UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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TALARI NETWORKS, INC.,
Petitioner,

v.

FATPIPE NETWORKS PRIVATE LIMITED[1],
Patent Owner.
_____

Case IPR2016-00977
Patent 7,406,048 B2
_____

Before STACEY G. WHITE, MICHELLE N. WORMMEESTER, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

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[1] We note that Patent Owner's Updated Mandatory Notice changed the name
of the Patent Owner. Paper 30.

I. INTRODUCTION

FatPipe Networks Private Limited ("Patent Owner") seeks rehearing (Paper 33, "Request" or "Req. Reh'g") of our determination in the Final Written Decision (Paper 32, "Decision" or "Dec.") that claims 7 and 19[2] of U.S. Patent No. 7,046,048 (Ex. 1003, "the '048 patent") would have been obvious. In our Decision, we determined that those claims would have been obvious over Karol[3] alone and Karol in combination with Stallings.[4] Dec. 35.[5] Patent Owner argues that we erred in our determination because (1) we misapprehended passages from the '048 patent describing path selection based on origin; and (2) we "overlooked and/or misapprehended that routing based on the source address will forward all packets from the same source to the same network." Req. Reh'g 1.

"The burden of showing a decision should be modified lies with the party challenging the decision." 37 C.F.R. § 42.71(d). When requesting rehearing of a decision, the challenging party must identify specifically all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in the record. *Id.* We have considered Patent Owner's Request and for reasons that follow, we maintain our Decision regarding the patentability of claims 7 and 19.

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[2] We also found that Petitioner demonstrated by a preponderance of the evidence that claims 1–6, 8–18, and 20–24 are unpatentable. Patent Owner provides no specific arguments as to these claims.

[3] U.S. Patent No. 6,628,617 B1 ("Karol," Ex. 1006).

[4] William Stallings, *Data and Computer Communications*, Prentice-Hall, 5th Ed, 1997, ISBN-81-203-1240-6 ("Stallings," Ex. 1011).

[5] There is a typographical error on page 35 of the Decision. Petitioner did not establish that claims 7 and 19 were anticipated by Karol. *See* Dec. 19–23, 35.

II. DISCUSSION

Patent Owner argues that we erred in our determinations regarding claims 7 and 19. Req. Reh'g 2–5. Petitioner asserted that claims 7 and 19 were anticipated by and would have been obvious over Karol. Pet. 22–26; 28–29 (anticipation arguments); *id.* at 53–56, 59 (obviousness argument). Claims 7 and 19 recite, in relevant part, "[selecting/selects], within the controller on a per-packet basis, between a path through an Internet-based network and a path through a private network that is not Internet-based." In our Final Written Decision, we construed "selecting/selects . . . on a per-packet basis" to mean "selecting a network path for each packet." Dec. 9. Based on the evidence and arguments presented, we found Petitioner's anticipation argument to be insufficient because "we determine[d] that Karol's routing decisions are made for a flow of packets and not for an individual packet." *Id.* at 22.

Petitioner also argued that these claims would have been obvious over Karol if we construed "per-packet basis" to require selection for each packet. Pet. 45. We found Petitioner's obviousness argument to be legally sufficient and held that Petitioner had meet its burden to establish the unpatentability of these claims as obvious over Karol. Dec. 22–24. On rehearing, Patent Owner asserts that this determination was incorrect because (1) the '048 patent's description of prior art does not disclose selecting on a per-packet basis (Req. Reh'g 2–4) and (2) modifying Karol to analyze only the source of the packet would not achieve the recited selection (*id.* at 5–6). We address each of these arguments in turn.

As an initial matter, we note that this argument is different from the argument presented during the trial. Patent Owner had argued that

> Karol does not disclose selecting a network on a per packet
> basis because (1) Karol does not "select" a network when a
> packet arrives but simply routes packets based on the
> forwarding database's pre-computed route and (2) Karol's
> forwarding database facilitates network path selection/changes
> only when updated with LSAs, which occurs only infrequently
> and not on a per-packet basis.

Paper 22 ("PO Resp.") 21. Thus, despite the fact that Patent Owner stated that "Claims 7 and 19 are not anticipated by Karol *or obvious over Karol alone* or in view of Stallings"[6] the argument was directed to Petitioner's anticipation argument with no discussion of the obviousness argument over Karol alone. *See id.* (emphasis added). As such, we could not have overlooked or misapprehended an argument that was not made. *See also* Paper 8, 6 ("The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.").

Even if these arguments had been raised, however, they would not have been persuasive because they misconstrue Petitioner's arguments. First, Patent Owner asserts that Petitioner's argument relies upon passage from the background of the '048 patent that discusses routing packets based on their origin. Req. Reh'g 2–3 (quoting Ex. 1003, 4:11–19). Petitioner, however, does not assert that these claims are obvious over Karol and any admitted prior art, but rather Petitioner asserts that the "combination of the knowledge of a POSITA with Karol would render this claim element obvious." Pet. 55, 59. Petitioner's declarant, Dr. Kevin Negus, opined that "the knowledge and common sense of the person of ordinary skill in the art

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[6] We note that Patent Owner's Request for Rehearing provides no discussion of Stallings and does not address our determination that claims 7 and 19 would have been obvious over the combination of Karol and Stallings.

at the time of the invention was sufficient to extrapolate from the disclosures of Karol to such an interpretation at least because this was within the skill of person of ordinary skill in the art at the time of the invention, obvious to try and yielded predictable results." Ex. 1005 ¶ 332.

In an obviousness analysis under 35 U.S.C. §103(a), "common sense" or the knowledge of the ordinarily skilled artisan may play a role in bridging gaps in prior art's explicit teachings. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 420–21 (2007) ("Common sense teaches ... that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle."). Although "common sense and common knowledge have their proper place in the obviousness inquiry," common sense "cannot be used as a wholesale substitute for reasoned analysis and evidentiary support, especially when dealing with a limitation missing from the prior art references specified." *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361–62 (Fed. Cir. 2016). We must proceed with caution because the use of common sense or knowledge of the artisan to supply a missing limitation ought to be treated as the exception, rather than the rule. *Id.* at 1361. As our reviewing court has observed, "[a]bsent some articulated rationale, a finding that a combination of prior art would have been 'common sense' or 'intuitive' is no different than merely stating the combination 'would have been obvious.'" *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Circ. 2017).

Thus, we were tasked with looking to see if the assertion of knowledge and common sense of the person of ordinary skill was supported with "articulated reasoning with some rational underpinning to support the

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