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Paper 9
Entered: April 4, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPLUNK INC.,
Petitioner,

v.

SABLE NETWORKS, INC.,
Patent Owner.

IPR2022-00228
Patent 8,243,593 B2

Before STACEY G. WHITE, GARTH D. BAER, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Petitioner's Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

On November 24, 2021, Splunk Inc. ("Splunk" or "Petitioner")[1] filed a Petition seeking institution of *inter partes* review of claims 1–44 of U.S. Patent No. 8,243,593 B2 (Ex. 1001, "the '593 patent"). Paper 2 ("Pet."). Sable Networks, Inc.[2] ("Patent Owner") elected not to file a Preliminary Response.

Concurrently with the filing of the Petition, Petitioner filed a Motion for Joinder, seeking to join itself as a petitioner in *Cloudflare, Inc. v. Sable Networks, Inc.*, IPR2021-00909 ("the 909 IPR"). Paper 3 ("Joinder Motion" or "Mot."). Patent Owner responded to the Joinder Motion (Paper 6 ("Mot. Resp.")), and Petitioner filed a reply (Paper 7 ("Mot. Reply")).

Upon considering the information presented in each of these papers, for reasons discussed below, we institute trial in this *inter partes* review, we grant Petitioner's Joinder Motion, and we join Petitioner as a party to the 909 IPR.

I. BACKGROUND

A. Related Matters

The parties indicate that the '593 patent has been asserted in several district court lawsuits, including *Sable Networks, Inc. v. Splunk Inc.*, 5:21-cv-00040 (E.D. Tex.) and *Sable Networks, Inc. v. Cloudflare, Inc.*, 6:21-cv-00261 (W.D. Tex.). Pet. 77; Paper 5, 1–3. The parties also identify the 909 IPR as a related proceeding. Pet. 77; Paper 5, 1.

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[1] Petitioner also identifies Critical Start Inc. as a real party-in-interest. Pet. 76.

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

B. The Petition's Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 1–2):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 4–7, 17, 18, 25–27, 37, 38	103(a)[3]	Yung[4]
9–13, 19–24, 29–33, 39–44	103(a)	Yung, Copeland[5]
3	103(a)	Yung, Four-Steps Whitepaper[6]
8, 14–16, 28, 34–36	103(a)	Yung, Copeland, Ye[7]

In support of its contentions, Petitioner relies on the testimony of Dr. Kevin Jeffay. Ex. 1003.

C. Summary of the 909 IPR

In the 909 IPR, Cloudflare, Inc. ("Cloudflare") challenges the patentability of the same claims (i.e., claims 1–44 of the '593 patent) on the same grounds as those identified above. *See* IPR2021-00909, Paper 1 at 1; *supra* § I.B (table of Petition's asserted grounds). After considering that

[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] US 7,664,048 B1, filed Nov. 24, 2003, issued Feb. 16, 2010 (Ex. 1005).

[5] US 7,185,368 B2, filed Nov. 30, 2001, issued Feb. 27, 2007 (Ex. 1007).

[6] "Four Steps to Application Performance Across the Network with Packeteer's PacketShaper®," *retrieved from* https://web.archive.org/web/20030317051910/http:/packeteer.com/PDF_files/4steps.pdf (Ex. 1006).

[7] US 7,295,516 B1, filed Nov. 13, 2001, issued Nov. 13, 2007 (Ex. 1008).

petition and Patent Owner's preliminary response in the 909 IPR, we determined that Cloudflare had demonstrated a reasonable likelihood of showing that claims 1, 2, 4–7, and 25–27 would have been obvious over Yung and that claims 9–13, 19–24, 29–33, and 39–44 would have been obvious over Yung and Copeland. *See* IPR2021-00909, Paper 16 at 24–48 (PTAB Nov. 19, 2021) ("909 Institution Decision"). In the 909 Institution Decision, we also queried whether dependent claims 17, 18, 37, and 38 should be included in the Yung-Copeland ground (rather than the Yung ground) (*see id.* at 3, 38–39), and we provided our initial assessment of other disputed issues (*see id.* at 48–57). Ultimately, in the 909 IPR, we instituted trial on all grounds of unpatentability specified in that petition. *Id.* at 57.

D. Statutory Disclaimer

On March 11, 2022, in the 909 IPR, Patent Owner filed an updated mandatory notice stating that it had filed and recorded "a statutory disclaimer disclaiming claims 1, 2, 4–8, 14–16, 25–28, 34–36 from challenged U.S. Patent No. 8,243,593 . . . under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a)." IPR2021-00909, Paper 29; *see also* IPR2021-00909, Ex. 2006 (statutory disclaimer of the '593 patent).

Based on our review of Exhibit 2006 in the 909 IPR and the Office's public records, we are persuaded that claims 1, 2, 4–8, 14–16, 25–28, 34–36 have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a). Consequently, for purposes of determining whether to institute review, we consider only claims 3, 9–13, 17–24, 29–33, and 37–44. *See* 37 C.F.R. § 42.107(e) ("No *inter partes review* will be instituted based on disclaimed claims.").

II. DISCUSSION

A. Institution of Trial

Petitioner here (Splunk) challenges all 44 claims of the '593 patent. Pet. 1–2. Petitioner represents that the present Petition is substantively identical to the petition in the 909 IPR, challenges the same claims based on the same grounds, and relies on the same expert declaration. Pet. 1 n.1; Mot. 4–5. We have considered the relevant petitions and we agree with Petitioner's representation that this Petition is substantially identical to the petition in the 909 IPR. *Compare* Pet., *with* IPR2021-00909, Paper 1.

Patent Owner did not file a Preliminary Response in this proceeding.

At this stage of the proceeding, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its challenge to claims 9–13, 19–24, 29–33, and 39–44 as unpatentable over Yung and Copeland for the reasons set forth in the 909 Institution Decision.[8] Accordingly, we institute *inter partes* review.

B. Motion for Joinder

Based on 35 U.S.C. § 315(c) and authority delegated to us by the Director, we have discretion to join a petitioner as a party to a previously instituted *inter partes* review. Section 315(c) provides, in relevant part, that "[i]f the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311."

[8] We incorporate the entire 909 Institution Decision into this Decision.

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