

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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KEYSIGHT TECHNOLOGIES, INC.  
Petitioner,

v.

CENTRIPETAL NETWORKS, INC.,  
Patent Owner.

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IPR2022-01421  
Patent 10,681,009 B2

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Before KATHERINE K. VIDAL, *Under Secretary of Commerce for  
Intellectual Property and Director of the United States Patent and  
Trademark Office.*

DECISION

Vacating the Decision Denying Institution, and  
Remanding to the Patent Trial and Appeal Board  
for Further Proceedings

## I. INTRODUCTION

Keysight Technologies, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–30 (the “challenged claims”) of U.S. Patent No. 10,681,009 B2 (Ex. 1001, “the ’009 patent”). Centripetal Networks, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). On March 22, 2023, the Patent Trial and Appeal Board (“Board”) issued a Decision exercising its discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d). Paper 9 (“Decision”). Petitioner subsequently filed a Request for Rehearing (Paper 10) and a request for review by the Precedential Opinion Panel (“POP”) (Ex. 3001).

On July 20, 2023, I issued an order granting *sua sponte* Director Review (Paper 12) and the POP dismissed the requests for rehearing and POP review (Paper 13).

For the reasons discussed in further detail below, I vacate the Board’s Decision denying institution based on 35 U.S.C. § 325(d) and remand to the Board to analyze the merits of Petitioner’s unpatentability challenges to determine whether to institute an *inter partes* review of the challenged claims.<sup>1</sup>

## II. BACKGROUND

The application that matured into the ’009 patent was filed on January 16, 2020, naming Patent Owner as Applicant. Ex. 1001, codes (21), (22), (71). The ’009 patent is related to, and has the same specification as, U.S. Patent No. 9,674,148 (“the ’148 patent”). Ex. 1001, code (63)

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<sup>1</sup> 35 U.S.C. § 325(d) is the only basis for the exercise of discretion at issue in this proceeding.

IPR2022-01421

Patent 10,681,009 B2

(indicating that the '009 patent is a continuation of application number 16/357,855, which is a continuation of application number 15/610,955, which is a continuation of application number 14/921,718, which issued as the '148 patent); Prelim. Resp. 1 n.2 (Patent Owner acknowledging that the '148 patent is the “great-grandparent” of the '009 patent). The '148 patent was challenged before the Board in IPR2018-01454. On March 5, 2020, the Board issued a Final Written Decision in IPR2018-01454, determining that claims 1, 2, 4–10, 12–18, and 20 of the '148 patent were unpatentable under 35 U.S.C. § 103(a) in view of Roese, Golnabi, Huima, and Hayter, and claims 3, 11, and 19 of the '148 patent were unpatentable under 35 U.S.C. § 103(a) in view of Roese, Golnabi, Huima, Hayter, and Esbensen. *See* Ex. 2001 (“the '148 FWD”).<sup>2</sup>

On April 9, 2020, during prosecution of the '009 patent, Patent Owner filed an Information Disclosure Statement that identified the '148 FWD. Ex. 1020, 155–156. The Examiner signed the Information Disclosure Statement on April 13, 2020. Ex. 1020, 223. On April 15, 2020, Patent Owner filed a Terminal Disclaimer listing, *inter alia*, the '148 patent. Ex. 1020, 160–165. The Examiner issued a Corrected Notice of Allowability<sup>3</sup> on April 29, 2020, and provided the following reasons for allowance:

the prior art fails to teach the combination of elements as put forth in the claims with respect to specific types of preprocessing performed on the rule set in combination with the details regarding the signaling to switch to the second rule set in

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<sup>2</sup> The Court of Appeals for the Federal Circuit issued a decision affirming the '148 FWD. *See* Ex. 1018 (dated May 11, 2021).

<sup>3</sup> The original Notice of Allowance, issued on April 23, 2023, identified the wrong pending and allowed claims. *Compare* Ex. 1020, 172–173 (identifying claims 1–48 as pending and allowed), *with id.* at 252 (identifying claims 1–17, 27–30, and 40–48 as pending and allowed).

particular that in response to this signaling the system starts to cache the packets such that they may be processed by the second rule set and not either dropped or processed under the first rule set.

*Id.* at 253. The '009 patent issued on June 9, 2020. Ex. 1001, code (45).

In the Decision denying institution of *inter partes* review in this proceeding, the Board addressed the parties' arguments regarding exercise of discretion under 35 U.S.C. § 325(d). Under the first part of the precedential *Advanced Bionics*<sup>4</sup> framework, the Board determined that Petitioner's arguments in the Petition were the same or substantially the same as those found in the '148 FWD, and explained that "*Advanced Bionics* makes clear that previously presented art includes art that was provided via an Information Disclosure Statement (IDS)." Dec. 9–10 (citing *Advanced Bionics* at 7–8). Under the second part of the *Advanced Bionics* framework, the Board held that "it was incumbent on Petitioner to demonstrate that the Office erred in a manner material to patentability of the challenged claims," and Petitioner failed to do so by "cabin[ing] its arguments to the Examiner not having considered the art and arguments" during prosecution of the '009 patent. Dec. 10. As a result, the Board exercised discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review.

### III. DISCUSSION

As explained in *Advanced Bionics*, the Board addresses § 325(d) by applying a "two-part framework." The first part of the framework asks whether the same or substantially the same prior art or arguments previously were presented to the Office. *Advanced Bionics* at 8. If either condition of the first part of the framework is satisfied, the second part of the framework

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<sup>4</sup> *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential).

IPR2022-01421

Patent 10,681,009 B2

asks whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *Id.* “[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.

Under current policy, I agree with the Board’s determination that the first part of the *Advanced Bionics* framework is met. Dec. 9–10. As expressly stated in *Advanced Bionics*, “[p]reviously presented art includes art . . . provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics* at 7–8. Contrary to Petitioner’s argument, the first part of the *Advanced Bionics* framework does not require that an Examiner provide a “discussion, analysis, or other findings on the applicability” of the relevant material contained in an IDS. *See* Pet. 8. The non-binding Board decisions cited by Petitioner to support such a requirement predate the precedential decision in *Advanced Bionics* and thus do not apply its two-step framework. *See id.* Moreover, to the extent the discussions cited by Petitioner in those decisions are relevant to the *Advanced Bionics* framework, they are more appropriately viewed as pertinent to assessing “material error” under the second step. *See Advanced Bionics* at 8–9 and n.9 (“An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.”).

I now turn to the second part of the *Advanced Bionics* framework—whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Id.* at 8. Petitioner argues that the ’009 patent and the ’148 patent are directed to the same subject matter. Pet. 4. Petitioner further submits that the Roese, Golnabi, Huima,

IPR2022-01421

Patent 10,681,009 B2

and Hayter references are the same as those asserted in IPR2018-01454. *Id.* at 9. Additionally, Petitioner indicates that the Esbensen reference asserted in this proceeding is the same as the Esbensen reference asserted in IPR2018-01454. *Id.* at 3–5, 64; Ex. 1009. Petitioner further asserts that the Board in the '148 FWD determined that claims 1, 2, 4–10, 12–18, and 20 of the '148 patent were unpatentable under 35 U.S.C. § 103(a) over Roese, Golnabi, Huima, and Hayter, and claims 3, 11, and 19 of the '148 patent were unpatentable under 35 U.S.C. § 103 (a) over Roese, Golnabi, Huima, Hayter and Esbensen. Pet. 11; Ex. 2001, 44.

I find that Petitioner's arguments and cited evidence establish that the Office erred in a manner material to patentability under the particular circumstances of this case. Specifically, Petitioner's arguments and cited evidence establish there is substantial overlap in the subject matter described in the '009 patent and the '148 patent (subject to the '148 FWD), generally, and the claimed subject matter recited by the challenged claims of the '009 patent and of the '148 patent, specifically. *See* Pet. 15–68; Ex. 1010; Ex. 2001.

I recognize that there are some differences between the language of the challenged claims here and the challenged claims of the '148 patent. Further, Patent Owner states that “[p]rosecution of the '009 Patent proceeded simultaneously with the '148 Patent IPR, and the claims were drafted to specifically recite that the preprocessing steps occur (1) prior to implementation and (2) to optimize the performance of the network protection.” Prelim. Resp. 14. Patent Owner argues these limitations are not found in the claims of the '148 patent and, based on the reasons for allowance recited in the Corrected Notice of Allowance regarding the '009 patent, further argues that the Examiner “concluded that the claimed

IPR2022-01421

Patent 10,681,009 B2

approach was an improvement over the art.” Prelim. Resp. 14–15 (citing and quoting Ex. 1020, 253).

The Examiner’s statement of reasons for allowance, however, is directed to limitations that appear in both the challenged claims of the ’009 patent and the challenged claims of the ’148 patent and do not refer specifically to the additional limitations recited only in the claims of the ’009 patent. *See, e.g.*, Pet. 8, 39; Ex. 1020, 253 (referring to “cach[ing] the packets” in response to signaling in the reasons for allowance); Ex. 1001, 11:1–4 (claim 1 of the ’009 patent reciting similar language); Ex. 1002, 10:45–47 (claim 1 of the ’148 patent reciting similar language). The overlap between claim limitations in the ’148 patent and the ’009 patent, and the reasons for allowance, suggests the Office erred by overlooking the significance of the ’148 FWD as it pertains to the patentability of the claims of the ’009 patent.

In the judicially affirmed ’148 FWD, the Board determined that the challenged claims of the ’148 patent were unpatentable over the same prior art references asserted against the challenged claims in this proceeding. *See* Ex. 2001. My review of the ’148 FWD, and the cited prior art references discussed therein, indicates that the Examiner, during examination of the ’009 patent, misapprehended or overlooked the determinations by the Board in the ’148 FWD—specifically, its findings and analysis of the disclosures of the Roese, Golnabi, Huima, Hayter, and Esbensen references—with respect to the challenged claims. *See* Ex. 1020, 153–157; *Advanced Bionics* at 10 (“[I]f the record of the Office’s previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive. . . .”). Accordingly, I determine that the

IPR2022-01421

Patent 10,681,009 B2

Examiner erred in a manner material to the patentability of the challenged claims in the '009 patent.

As a result, under the specific circumstances of this proceeding, I find the second part of the *Advanced Bionics* framework is satisfied.

Accordingly, the facts here do not warrant exercising discretion to deny institution under 35 U.S.C. §325(d). To be clear, I do not hold or suggest that the findings and conclusions reached in the '148 FWD compel the same final determinations here for the challenged claims in the '009 patent. I merely hold that the significant overlap between the challenged claims and asserted references here and those addressed in the '148 FWD, coupled with the absence of clear explanation from the Examiner as to why the latter did not impact the former's patentability, militates against exercising my § 325(d) discretion to deny institution. I, therefore, vacate the Board's Decision and remand to the Board to issue a new decision on institution. Specifically, the Board should evaluate the merits of the Petition to determine whether Petitioner has met its burden of establishing "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

#### IV. ORDER

Based on the foregoing, it is:

ORDERED that the Board's Decision denying institution is *vacated*;  
and

FURTHER ORDERED that this proceeding is remanded to the Board for further proceedings consistent with the instructions above.

IPR2022-01421  
Patent 10,681,009 B2  
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