

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CROWDSTRIKE, INC.
Petitioner

v.

OPEN TEXT INC.
Patent Owner

Case No. IPR2023-00124
Patent No. 9,578,045

**PRELIMINARY REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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Ground 1 seeks to remedy PO's attempt to recapture subject matter that was published in one of PO's unrelated patent applications nearly eight years before the '045 Patent's priority date. Paper 1 ("Petition"), 1-2. There is no dispute that this prior publication—"2007 Morris"—is prior art, and PO does not suggest that 2007 Morris or any cumulative teachings were actually considered by the Examiner during the '045 Patent's prosecution. The merits of Ground 1 are also compelling. Indeed, all key concepts were disclosed in 2007 Morris using nearly identical terminology. Confirming the strength of Ground 1, the POPR advances only a single tenuous argument seeking to distinguish the 2007 Morris disclosure from the Challenged Claims. POPR, 51-56 (arguing that information about an "originating object" should exclude "Genesisactor" information that indicates the object's "ultimate parent[,] i.e., its origin).

PO asks the Board to entirely ignore this straightforward invalidity case and exercise its discretion under §325(d) based on a misapplication of law and a convoluted interpretation of the prosecution history. PO's request largely mirrors the request it advanced in IPR2023-00126, which challenged a continuation of the '045 Patent (the '224 Patent) and also advanced invalidity grounds based on the 2007 Morris publication. Both there and here, PO asks this Board to speculate that the Examiner who handled the '224 Patent's prosecution considered (and rejected) these same key teachings that appeared in *another* of PO's prior publications. Paper 7

(“POPR”), 31-39 (speculating that the 2012 “Morris 340” was considered by the Examiner and arguing that it is cumulative of 2007 Morris).

For all the reasons the Board should reject PO’s request in the child ’224 Patent proceeding (summarized below), it should also reject PO’s request here. But there is an additional compelling reason¹ to institute here. PO’s theory is that Morris 340 should be deemed considered by the Office for the ’045 Patent by proxy because it was submitted in an International Search Report (“ISR”) during the child ’224 Patent’s prosecution—prosecution that occurred *after* the ’045 Patent issued.² The POPR provides no support for a §325(d) denial under these circumstances, and prior boards have refused to exercise their discretion where the allegedly considered prior art was merely cited in an IDS during a child patent’s prosecution.

I. PO mischaracterizes the law—Morris 340’s IDS submission in a child patent’s prosecution does not support denial

Only briefly acknowledging that Morris 340 was not cited or considered during the ’045 Patent’s prosecution and was only made of record in the child ’224 Patent’s prosecution, PO cites just one case for the proposition that “[a] § 325(d) discretionary denial may be based on prior art previously considered during the

¹PO also ignores that Ground 1 in the instant challenge proposes a combination of 2007 Morris with Van Oorschot—a reference that was not cited or considered during prosecution of either the ’045 or its child ’224 Patent.

²PO provides no explanation for its failure to submit the ISR during the ’045 Patent’s prosecution. The ISR issued on September 29, 2014 and the ’045 Patent did not issue until February 1, 2017.

prosecution of a related patent.” POPR, 25-26 (citing *Nespresso USA, INC., v. K-FEE System GMHB*, IPR2021-01221, Paper 11 (“*Nespresso*”), 17-18). But *Nespresso* expressly distinguished the instant fact pattern. Namely, that board rejected petitioner’s reliance on *Trend Micro*, noting its fact pattern involved “no substantive rejection during prosecution[,]” and emphasized the *Nespresso* fact pattern turned critically on the fact that “the prosecution history of the ’177 patent family includes substantive rejections, *including rejections based on Jarisch*, one of the references asserted in the Petition.” *Nespresso* at 18 (emphasis in original).

Here, as in *Trend Micro*,³ there were no substantive rejections based on Morris 340 during the ’224 Patent’s prosecution. PO’s entire §325(d) case turns on the ISR, which it contends provided the Examiner an invalidity roadmap. The board in *Apple Inc. v. Seven Networks, LLC* provided a well-reasoned analysis of a similar fact pattern. IPR2020-00285, Paper 10 at 29-32. There, not only had the IPR references been submitted in an IDS during a child patent’s prosecution, invalidity contentions from the parallel litigation were also submitted that charted the prior art teaching to “nearly identical” claim limitations. *Id.* at 29. The Apple board declined to exercise its discretion, reasoning that the examiner of the child patent “merely signed the [IDS] without explaining why he disagreed” with the invalidity theories submitted.

³ *Trend Micro Inc. v. Cupp Computing AS*, IPR2021-00813, Paper 7 at 23-26 (PTAB Oct. 25, 2021) (instituting and noting “citation of a reference in an IDS, without more, does not necessarily equate to evaluation of reference by the Examiner.”)

Id. at 30. It noted that “*Advanced Bionics* does not expressly extend the 325(d) inquiry to art considered in a related application.” *Id.* at 31. And, even if it were to consider the references as cited art based on their submission during a child patent’s prosecution, the board concluded that the examiner’s failure to explain why the child patent’s claims issued over the references weighs against denying institution. *Id.* Here, as in *Apple*, this Board should decline to speculate as to the Examiner’s undocumented process and should, accordingly, institute review.

II. The Board Should Reject PO’s §325(d) Request For All The Reasons Set Forth In IPR2023-00126

Even setting aside the parent/child problem that is fatal to PO’s request, its argument fails for all the reasons the parties have recently addressed in IPR2023-00126—the ’224 Patent proceeding. Indeed, PO’s arguments here largely mirror those advanced in IPR2023-00126 and the substance focuses entirely on the ’224 Patent’s prosecution. Although this Board need not reach these issues to rule in Petitioner’s favor, they are summarized for context and additional support.

First, Boards routinely refuse to speculate about an Examiner’s process and decline to exercise their discretion where, as here, a reference was not applied in a rejection or discussed by the Examiner. *See, e.g., Navistar, Inc. v. Fatigue Fracture Tech., LLC*, IPR2018-00853, Paper 13 at 16-17 (PTAB Sept. 12, 2018); *Vudu, LLC, v. Ideahub, Inc.*, IPR2020-01689, Paper 16 at 17-20 (PTAB Apr. 19, 2021).

Second, it is unreasonable to speculate that the '224 Patent Examiner considered Morris 340's teachings as prior art, but deemed them immaterial to patentability. Rather, on this record, a reasonable examiner could have concluded Morris 340 was not prior art at all because it: (1) was expressly incorporated by reference in the '224 Patent's specification, (2) published within a year of the '224 Patent's effective filing date, and (3) has an overlapping inventor with the '224 Patent. Accordingly, a more reasonable interpretation of the record is the Examiner deemed Morris 340 a non-prior art disclosure pursuant to 35 U.S.C. §102(b)(1)(A).⁴

Finally, assuming the Examiner did consider Morris 340 prior art and considered the ISR, it would have been error not to issue a rejection. At the EPO, the applicant implicitly accepted mapping GenesisActor to the claimed originating object and took issue only with a claimed "correlation." Ex. 1032, 74-80. The EPO rejected this position and applicant ultimately withdrew its application. Ex. 1032, 2-3. Accordingly, the Examiner would have erred by failing to issue a rejection in the U.S. where the European record revealed no material distinctions. *DJI Europe B.V. v. Textron Innovations Inc.*, IPR2022-00453, Paper 10 at 11-13 (PTAB Aug. 3, 2022) (finding error where examiner did not consider relevance of prior art addressed in EPO office action).

⁴ PO's Sur-Reply in IPR2023-00126 argues that Jaroch was not responsible for the overlapping subject matter, which strongly suggests improper inventorship. This Board need not resolve that issue here to rule in Petitioner's favor.

Respectfully submitted,

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**CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105(a)**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on April 12th, 2023, a complete and entire copy of this Preliminary Reply to Patent Owner's Preliminary Response was provided via email to the Patent Owner by serving the email address of record as follows:

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