

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CROWDSTRIKE, INC.
Petitioner

v.

OPEN TEXT INC.
Patent Owner

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

**PATENT OWNER'S PRELIMINARY SUR-REPLY
TO PETITIONER'S PRELIMINARY REPLY**

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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<i>SharkNinja Operating LLC et al., v. iRobot Corp.,</i> IPR2021-00545, Paper 11 (PTAB Sept. 8, 2021).....	3
Statutes	
35 U.S.C. § 325(d)	<i>passim</i>

EXHIBIT LIST

Exhibit	Description
2001	Declaration of Professor Nenad Medvidovic, Ph.D
2002	<i>Curriculum Vitae</i> of Professor Nenad Medvidovic, Ph.D.
2003	<i>Webroot, Inc. and Open Text Inc., v. CrowdStrike, Inc. and CrowdStrike Holdings, Inc.</i> , Case No. 6:22-cv-00241-ADA-DTG, First Amended Complaint for Patent Infringement, Dkt. 60 (W.D. Tex., Sept. 8, 2022) (excerpted)
2004	<i>Sonrai Memory Ltd. v. Kingston Tech. Co. and Kingston Tech. Corp.</i> , Case No. 6:21-cv-1284-ADA, Order Denying Kingston Tech. Co. and Kingston Tech. Corp.'s Opposed Motion to Stay Pending Resolution of <i>Inter Partes</i> Review, Dkt. 94 (W.D. Tex., Oct. 18, 2022)
2005	<i>mCom IP, LLC v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00261-ADA, Order Denying Defendant's Motion to Stay Pending <i>Inter Partes</i> Review, Dkt. 42 (W.D. Tex., Oct. 20, 2022)
2006	<i>Intellectual Ventures I LLC et al. v. Hewlett Packard Enterprise Co.</i> , No. 6:21-cv-00596-ADA, Order Denying Hewlett Packard Enterprise Company's Opposed Motion to Stay Pending Resolution of <i>Inter Partes</i> Review, Dkt. 104 (W.D. Tex., Dec. 22, 2022)
2007	<i>Webroot, Inc., Open Text Inc., v. AO Kaspersky Lab et al.</i> , Case No. 6:22-cv-00243-ADA-DTG, Order Granting Third Amended Scheduling Order, Dkt. 142 (W.D. Tex., Dec. 27, 2022)
2008	<i>Standing Order Governing Proceedings (OGP) 4.2 – Patent Cases</i> (W.D. Tex., Sept. 16, 2022), available at chrome-extension://efaid-nbmnnibpcajpcglclefindmkaj/https://www.txwd.uscourts.gov/wp-

Exhibit	Description
	content/uploads/Standing%20Orders/Waco/Albright/Stand-ing%20Order%20Governing%20Proceedings%20-%20Pa-tent%20Cases%20091622.pdf (excerpted)
2009	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab et al.</i> , Case No. 6:22-cv-00243-ADA-DTG, Defendants' Opening Claim Con-struction Brief, Dkt. 86 (W.D. Tex., Oct. 28, 2022) (excerpted)
2010	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab et al.</i> , Case No. 6:22-cv-00243-ADA-DTG, Defendants' Reply Claim Con-struction Brief, Dkt. 110 (W.D. Tex., Dec. 6, 2022) (excerpted)
2011	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab et al.</i> , Case No. 6:22-cv-00243-ADA-DTG, Scheduling Order, Dkt. 50 (W.D. Tex., Sept. 28, 2022) (excerpted)
2012	<i>Open Text Inc. et al., v. AO Kaspersky Lab</i> , Case No. 6:22-cv-00243-ADA-DTG, Defendant AO Kaspersky Lab's Preliminary In- validity Contentions Exhibit 4A (W.D. Tex., Sept. 14, 2022) (ex- cerpted)
2013	<i>Webroot, Inc. and Open Text Inc., v. Sophos Ltd.</i> , Case No. 6:22- cv-00240-ADA-DTG, Defendant Sophos Ltd.'s Preliminary Inva- lidity Contentions (W.D. Tex., Sept. 13, 2022) (excerpted)
2014	<i>Webroot, Inc. and Open Text Inc., v. Trend Micro Inc.</i> , Case No. 6:22-cv-00239-ADA-DTG, Defendant's Preliminary Invalidity Contentions (W.D. Tex., Sept. 13, 2022) (excerpted)
2015	<i>Webroot, Inc. and Open Text Inc., v. CrowdStrike, Inc. and CrowdStrike Holdings, Inc.</i> , Case No. 6:22-cv-00241-ADA, Com- plaint for Patent Infringement, Dkt. 1 (W.D. Tex., Mar. 4, 2022)
2016	<i>Open Text Inc. et al., v. AO Kaspersky Lab</i> , Case No. 6:22-cv- 00243-ADA-DTG, First Amended Complaint for Patent Infringe- ment, Dkt. 80 (W.D. Tex., Oct. 27, 2022)

Exhibit	Description
2017	<i>Webroot, Inc. and Open Text Inc., v. Trend Micro Inc.</i> , Case No. 6:22-cv-00239-ADA-DTG, First Amended Complaint for Patent Infringement, Dkt. 53 (W.D. Tex., Sept. 7, 2022)
2018	<i>Webroot, Inc. and Open Text Inc., v. Sophos, Ltd.</i> , Case No. 6:22-cv-00240-ADA-DTG, Second Amended Complaint for Patent Infringement, Dkt. 76 (W.D. Tex., Oct. 24, 2022)
2019	File History for Continuation Patent, U.S. Patent No. 10,257,224
2020	U.S. Publication No. 20080016570 to Capalik (“Capalik 570”)
2021	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, (W.D. Tex. Dec. 9, 2022) Dkt. 133, Transcript of Motions Hearing (excerpted)
2022	U.S. Patent No. 10, 257,224 to Joseph Jaroch (“’224 Patent”)
2023	Joseph Jaroch LinkedIn

In its Preliminary Response, Patent Owner asks the Board to exercise its discretion under Section 325(d) to deny institution because Petitioner's primary references, Morris and Capalik, are substantively the same prior art analyzed during prosecution of the '224 continuation patent. (Paper 6 at 24-38.) Petitioner does not dispute that Capalik is substantively the same as Capalik 570. In its Reply, Petitioner (1) argues that the Board should not consider, for purposes of Section 325(d), prior art that was before the Office during prosecution of a child patent (Paper 8 at 2–3) and (b) repeats the same arguments raised in its Reply in IPR2023-00126 (*Id.* 4–5). The Board should reject each of these arguments.

I. Denial Under Section 325(d) May be Based on Art Considered by the Office During Prosecution of a Child Patent.

Petitioner suggests that Section 325(d) denial is improper where the asserted art was first considered by the Office during prosecution of a child patent. (Paper 8 at 2–3.) That is wrong. The Board has denied petitions under Section 325(d) based on art considered in subsequent related applications. *See Live Nation Entm't, Inc. v. Complete Entm't Res. B.V.*, PGR2017-00038, Paper 11 at 15 (PTAB Jan. 16, 2018) (denying institution under §325(d) where there was overlap between parent and child claims); *see also Nespresso USA, INC., v. K-FEE System GMHB*, IPR2021-01221, Paper 11, 18-19 (PTAB May 6, 2022) (denying institution under §325(d) where “Petitioner focused on the very same disclosure in [the prior art] that was evaluated

during the prosecution history of the...patent family”) (emphasis omitted).¹

Here, as in *Live Nation*, there is significant overlap between the claims of the patent-at-issue and the related patent. As addressed in Patent Owner's Preliminary Response, the claims of the '224 continuation patent are similar to—and broader than—the claims in the '045 patent. (Paper 7 at 26-30.) Therefore, even though the '045 patent is earlier in time than the '224 continuation patent, the narrower claims of the '045 patent logically would not be unpatentable based on prior art over which the Office subsequently allowed even broader claims. (*Id.*) Relatedly, Petitioner's mapping of the “originating object” limitation to Morris's GenesisActor is identical for the '045 patent and the '224 continuation patent. (*Id.* at 45-46)

Petitioner cites *Apple Inc. v. Seven Networks, LLC*, IPR2020-00285, Paper 10 (July 28, 2020), to argue that *Advanced Bionics* does not extend to prior art considered in related applications. Petitioner's reliance on *Apple* is misplaced. As the panel in *Apple* noted, there were important distinctions between the claims at issue in that petition as compared to the claims of the child. *Id.* at 30. Therefore, *Apple* is not

¹Petitioner argues that Van Oorschot was not previously considered by the examiner. (Paper 8 at 2 n.1.) But in *Live Nation*, the Board declined to institute despite the addition of a new reference. And, in any event, Petitioner does not rely on Van Oorschot to argue that Morris discloses an “originating object.”

analogous to the facts here, where the claims of the '045 patent and the claims of the '224 continuation patent substantially overlap.

To the extent the panel in *Apple* concluded that prior art considered in related applications may *never* be considered as part of the Section 325(d) analysis, the Board should reject that view. As an initial matter, *Apple* has not been designated precedential (or informative) and therefore is not binding on this proceeding. Moreover, any suggestion that prior art from related applications may not be considered is inconsistent with other panel decisions. *See, e.g., Live Nation*, Paper 11 at 15; *Nespresso USA*, Paper 11 at 18-19. Indeed, even when other panels have declined to exercise discretion under Section 325(d) based on prior art considered in related applications, they have done so based on a lack of similarity in the claims, not a categorical prohibition. *See SharkNinja Operating LLC et al., v. iRobot Corp.*, IPR2021-00545, Paper 11 at 14 (PTAB Sept. 8, 2021) (finding “notable differences between the child-application claims and the challenged claims”).

II. The Examiner Considered Morris 340.

Petitioner argues it is not clear whether the Examiner considered Morris 340 during prosecution of the '224 continuation Patent. (Paper 8 at 4-5.) Not so. Patent Owner's responsive argument is set forth in Patent Owner's sur-reply in IPR2023-00126, Paper 8 at 1-2.

Petitioner relies on *Apple* to argue that the examiner must explain why the

claims issued over a reference if the Board is to consider it under Section 325(d). (Paper 8 at 3-4.) However, Petitioner's argument contradicts the Board's precedential holding that "[p]reviously presented art includes ... art provided to the Office by an applicant, such as on an [IDS]." *Advanced Bionics, LLC v. Med-El Elektromedizin-ische Geräte GMBH*, IPR2019-01469, Paper 6 at 7-8 (precedential) (PTAB Feb. 13, 2020). Board decisions following *Advanced Bionics* have rejected arguments that references must be included in a rejection. *See Medtronic Corevalve LLC v. Speyside Medical, LLC*, IPR2021-00310, Paper 9, 26 (PTAB July 23, 2021) ("Petitioner...seems to limit this factor to references that are expressly included in a rejection by the examiner. This factor is not so limited.").

Petitioner also argues that the Board's decision in *Nespresso* suggests that a "substantive rejection" involving the prior art at issue is required. (Paper 8 at 3.) However, in *Nespresso* only one of four references at issue was the subject of a rejection during the prosecution history. The Board held that the other three references were presented to the examiner based on their inclusion in an IDS alone. *See Nespresso USA*, Paper 9, 10-13 (PTAB Jan. 18, 2022) ("we find unpersuasive Petitioner's argument that the Board may dismiss as 'not considered' the four references").

III. Morris 340 Is Prior Art To The '224 Continuation Patent and '045 Patent.

Petitioner argues that Morris 340 is not prior art at all (Paper 8 at 5) and relies

on a comparison of the '224 continuation patent with Morris 340. However, the relevant comparison when assessing where the disclosures in Morris 340 originated is to the Morris reference. Patent Owner's responsive argument is set forth in full in IPR2023-00126, Paper 8 at 4-5.²

IV. Allowing The '224 Continuation Patent to Issue Over Morris 340 Was Not Material Error.

Petitioner argues, for the first time in its Reply, that it would have been error for the Examiner to have considered Morris 340 but not issued a rejection based on it. (Paper 8 at 5.) First, The Board should decline to consider this argument. *See Lab. Corp. of Am. Holdings, v. Ravgen, Inc.*, IPR2021-01054, Paper 11 at 24 n.19 (PTAB Nov. 5, 2021). Second, Petitioner fails to articulate how the Examiner erred with sufficient specificity. *See Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01197, Paper 9 at 23 (PTAB Jan. 3, 2023); *see also* IPR2023-00126, Paper 8 at 4-5. Petitioner has not met its burden to show material error by the Examiner, and therefore the Board should deny institution of a petition that merely rehashes art and arguments the Office has already rejected.

² Petitioner alludes to an improper inventorship issue but fails to articulate a factual basis for any cogent theory of improper inventorship. (*See* Petition at 5 n.4.)

Date: April 19, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S PRELIMINARY REPLY** was served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) and courtesy copies were also served on April 19, 2023 via electronic mail, in their entireties on the following:

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