

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CROWDSTRIKE, INC.

Petitioner

v.

OPEN TEXT INC.

Patent Owner

Case IPR2023-00556

Patent No. 8,726,389

PATENT OWNER'S PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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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., 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)
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. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Dec. 9, 2022 Transcript of Motions Hearing, Dkt. 133 (W.D. Tex. Dec. 15, 2022) (excerpted)
2008	Dani Kass, “Catching Up On Patent Litigation With Judge Albright” (Law360 Mar. 14, 2023); https://www.law360.com/pulse/articles/1582438/print?section=pulse/courts
2009	U.S. District Courts—Federal Court Management Statistics—Profiles—During the 12-Month Periods Ending March 31, 2018 Through 2023, “Table N/A—U.S. District Courts—Combined Civil

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	and Criminal Federal Court Management Statistics (March 31, 2023)", available https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf
2010	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Claim Construction Order, Dkt. 236 (W.D. Tex. Mar. 16, 2023)
2011	<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)
2012	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Scheduling Order, Dkt. 39 (W.D. Tex. Aug. 17, 2022)
2013	<i>Webroot, Inc. and Open Text Inc., v. ForcePoint LLC</i> , Case No. 6:22-cv-00342-ADA-DTG, Defendant ForcePoint LLC's Preliminary Invalidity Contentions (W.D. Tex., Sept. 13, 2022) (excerpted)
2014	<i>Webroot, Inc. and Open Text Inc., v. Sophos Ltd.</i> , Case No. 6:22-cv-00240-ADA-DTG, Defendant Sophos Ltd.'s Preliminary Invalidity Contentions (W.D. Tex., Sept. 13, 2022) (excerpted)
2015	<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)
2016	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab.</i> , Case No. 6:22-cv-00243-ADA-DTG, Defendant's Preliminary Invalidity Contentions Appendix A (W.D. Tex., Sept. 14, 2022) (excerpted)
2017	<i>Webroot, Inc. and Open Text Inc., v. CrowdStrike, Inc. and CrowdStrike Holdings, Inc.</i> , Case No. 6:22-cv-00241-ADA-DTG, Defendant's Preliminary Invalidity Contentions (W.D. Tex., Sept.

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Exhibit	Description
	13, 2022) (excerpted)
2018	<i>Ex Parte</i> James M. Brennan, et al., Appeal 2021-003606, Application 15/285,875, Decision On Appeal Statement of the Case (PTAB Jul. 26, 2022)
2019	File History of U.S. Patent No. 8,418,250 (“250 File History”)

Open Text Inc. ("Patent Owner") submits this Preliminary Response to the Petition of CrowdStrike, Inc. ("Petitioner") seeking *inter partes* review ("IPR") of U.S. Patent No. 8,726,389 ("the '389 patent").

I. INTRODUCTION

The Board should decline to institute IPR of the '389 patent because the petition duplicates the parties' district court litigation efforts, is based primarily—for most limitations, exclusively—on a prior art reference already considered during the examination of the '389 patent, and is otherwise a weak petition in which all grounds rely on a fundamentally dissimilar primary prior art reference that does not disclose each limitation of the '389 patent.

First, the Board should deny institution under *Fintiv* because institution would undermine the congressional purpose of IPRs to "limit unnecessary and counterproductive litigation costs." H.R. Rep. No. 112-98, pt. 1, at 40 (2011, 2011 U.S.C.C.A.N. 67, 69 (post-grant reviews were meant to be "quick and cost effective alternatives to litigations"). The validity of the '389 patent is currently being litigated in *five* consolidated district court cases in the Western District of Texas, which will proceed to trial a month *before* the final written decision on this petition is due. *See Webroot v. AO Kaspersky Lab*, No. 6:22-cv-00243-ADA-DTG (WDTX) (lead case) ("Kaspersky"); *Webroot v. Trend Micro Inc.*, No. 6:22-cv-00239-ADA-DTG

(WDTX); *Webroot v. Sophos Ltd.*, No. 6:22-cv-00240-ADA-DTG (WDTX); *Webroot v. CrowdStrike Inc.*, No. 6:22-cv-00241-ADA-DTG (WDTX); *Webroot v. Forcepoint LLC*, No. 6:22-cv-00342-ADA-DTG (WDTX).

The five district court cases will not be stayed in response to institution because they involve *39 patents* and four additional defendants/counterclaimants, and they will litigate the validity of the '389 patent in the district court based on the *same references* raised in this petition. The district court previously issued a claim construction order on March 16, 2023, and by the time of the Board's institution decision (in September 2023), the parties will have invested significant resources in over five months of fact discovery. Consequently, the only possible outcome of institution would be to needlessly increase litigation costs by forcing the parties to litigate validity before ***both*** the Board and the district court. The Board should decline to institute on this basis alone.

Second, the Board should deny institution under 35 U.S.C. § 325(d) because Petitioner presents the same art previously considered by the Office during prosecution of the '389 patent. All grounds raised in the petition rely on U.S. Patent Application Publication No. 2005/0210035 to Kester ("Kester") as the primary reference, and often the sole reference, allegedly disclosing limitations of the independent claims. The examiner signed an IDS to confirm he considered Kester and also

applied Kester in *two* rejections during prosecution of the '389 patent. (EX-1002 87, 106, 109, 111, 141, 163 - 164, 188, 257.). Despite considering Kester for all it discloses, the examiner only it applied against dependent claims 14 and 28 and did not find Kester disclosed any limitation of the independent claims.

Third, the Board should deny institution because the petition fails to “show[] that there is a reasonable likelihood that petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). All of Petitioner's grounds rely on Kester as the primary reference, which is non-analogous art to the '389 patent. Kester is not directed to the determination of whether a file is malware or safe and, in fact, embodies the very same problems that the '389 patent sought to solve—*i.e.*, unacceptable delays attributed to incorporating a human analyst to manually compare and classify computer objects residing on networked remote computers. In its Summary section, Kester details four distinct aspects of its claimed invention, but not one addresses (or even mentions) detecting or mitigating malware, viruses, trojans, etc. (*See* EX-1004 [0007]–[0011].) And a POSITA would not be motivated to modify Kester with Kennedy's automated heuristics and file set tracking because that modification obviates the tailored application-management benefits Kester purportedly achieves from comparison by a human analyst. Patent Owner respectfully requests that the Board deny the petition.

For each of these reasons, and as further addressed herein, the Board should deny institution of *inter partes* review.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314(a)

In view of the parallel litigations, in which a district court will adjudicate the same grounds raised in this petition, and on a faster timeline than the Board, the Board should exercise its discretionary denial authority under 35 U.S.C. § 314(a).

“Congress designed the America Invents Act (AIA) post-grant proceedings to ... limit unnecessary and counterproductive litigation costs.” Director’s Memo, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (“Guidance”) at 1 (June 21, 2022). Consequently, Director Vidal has instructed the Board not to institute IPR trials that, in view of parallel litigation, would “increase, rather than limit, litigation costs.” *Id.*

A district court stay is out of the question, and the district court will consider the very same arguments presented in the petition. Institution of an IPR would force the same parties to litigate the same issues to the Board and district court, only to have the district court resolve these issues before the Board’s final written decision. Institution would “increase, rather than limit, litigation costs,” create “potential conflict between the ... (PTAB) and district court proceedings,” and generally increase “the potential for inefficiency and gamesmanship.” Guidance 1. This is precisely

the situation that Director Vidal told the Board to avoid when she instructed the Board to take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Jun. 1, 2021).

Consistent with Director Vidal's guidance, every one of the *Fintiv* factors weighs for discretionary denial:

(1) The likelihood of a stay of the co-pending district court litigation is effectively nil because Petitioner has petitioned for review of only five of the twelve patents asserted against it and because the '389 patent is currently asserted against four other defendants in a now-consolidated case, where the claims have already been construed and discovery is well underway.

(2) Trial in the district court is expected one month *before* a final written decision.

(3) The parties and district court have already invested heavily in carrying the parallel litigation past claim construction (which issued six months before the anticipated institution decision) and are well into discovery.

(4) The issues raised in the petition are the same as those the district court has before it, and Petitioner's narrow stipulation will not change that because the stipulation does not apply to Petitioner's co-defendants, who have raised the same

grounds before the district court and will maintain those grounds irrespective of the Board's institution decision.

(5) Petitioner will get its chance to make its arguments before the district court because Petitioner is a defendant in the parallel litigation.

(6) And, as shown below, the grounds presented in the petition are weak. Thus, every *Fintiv* factor weighs for discretionary denial.

The goals of the AIA and the general welfare of the patent system would be best advanced by denying institution and not creating a parallel proceeding that will lag behind the district court's resolution of the '389 patent's validity.

A. Factor 1: The District Court Has Not Granted And Will Not Grant A Stay.

Fintiv factor 1, which considers the likelihood of a stay in the parallel district court litigation, weighs strongly for discretionary denial because no stay has been requested or ordered, and the circumstances and timing of the district court case demonstrate that a stay is out of the question. The first *Fintiv* factor asks "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted." *Fintiv*, IPR2020-00019, Paper 11 at 6. Here, the undisputed answer to both questions is **no**. To the contrary, overwhelming evidence indicates that a stay will not be granted.

First, a stay is unlikely because it would not simplify the issues before the court. The district court's record demonstrates that, when determining a stay, it considers issue simplification "the most important factor."¹ But here, no simplification is possible because the case involves numerous other issues and parties. The validity of the '389 patent is just one of many issues being litigated in a consolidated action involving *thirty-nine* patents and *five* defendants. The case against Petitioner alone involves fourteen patents—twelve asserted by Patent Owner and two by Petitioner.

¹ See, e.g., EX-2004, *Sonrai Memory Ltd. v. Kingston Tech. Co., Inc.*, No. 6:21-cv-1284-ADA, slip op. at **4-5 (W.D. Tex. Oct. 18, 2022) (denying a stay following IPR institution because issue simplification was the "most important factor" and the Court had already held a *Markman* hearing and "expended significant resources"); EX-2005, *mCom IP, LLC v. Cisco Sys., Inc.*, No. 6:22-00261-ADA, slip op. at *5 (W.D. Tex. Oct. 20, 2022) (finding "simplification is not likely" where the IPR did not challenge all of the claims asserted in the district court, since the other claims would still require a trial); EX-2006, *Intellectual Ventures I LLC v. Hewlett Packard Enterprise Co.*, No. 6:21-cv-00596-ADA, slip op. at *7 (W.D. Tex. Dec. 22, 2022) (denying a stay following IPR institution, as even IPR estoppel would not simplify the invalidity case, given the defendants' reliance on prior art systems).

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The table below identifies the patents asserted by Patent Owner against each WDTX defendant and the related petitions for review:

Table 1. Patent Owner's Asserted Patents

Patent	Kaspersky	CrowdStrike	Forcepoint	Sophos	Trend Micro
8,726,389	Asserted; no IPR	IPR2023- 00556	Asserted; no IPR	IPR2023- 00633	Asserted; no IPR
8,418,250	Asserted; no IPR	IPR2023- 00289	<i>N/A</i>	IPR2023- 0699	IPR2023- 00289
10,599,844	Asserted; no IPR	Asserted; no IPR	Asserted; no IPR	IPR2023- 00528	IPR2023- 00662
9,413,721	<i>N/A</i>	<i>N/A</i>	Asserted; no IPR	IPR2023- 00491	<i>N/A</i>
9,578,045	Asserted; no IPR	IPR2023- 00124	<i>N/A</i>	Asserted; no IPR	IPR2023- 00677
10,257,224	IPR2023- 01011	IPR2023- 00126	<i>N/A</i>	Asserted; no IPR	IPR2023- 00657
10,284,591	IPR2023- 00895	IPR2022- 01522	<i>N/A</i>	Asserted; no IPR	IPR2023- 00692
8,856,505	Asserted; no IPR	Asserted; no IPR	<i>N/A</i>	Asserted; no IPR	Asserted; no IPR
8,181,244	<i>N/A</i>	Asserted; no IPR	<i>N/A</i>	Asserted; no IPR	Asserted; no IPR
8,201,243	Asserted; no IPR	Asserted; no IPR	Asserted; no IPR	IPR2023- 00731	Asserted; no IPR
8,719,932	Asserted; no IPR	Asserted; no IPR	Asserted; no IPR	IPR2023- 00732	Asserted; no IPR

Patent	Kaspersky	CrowdStrike	Forcepoint	Sophos	Trend Micro
11,409,869	Asserted; no IPR	Asserted; no IPR	Asserted; no IPR	PGR2023- 00031	Asserted; no IPR
8,763,123	<i>N/A</i>	Asserted; no IPR	<i>N/A</i>	Asserted; no IPR	<i>N/A</i>
8,438,386	<i>N/A</i>	<i>N/A</i>	IPR2023- 00784	<i>N/A</i>	<i>N/A</i>
10,025,928	<i>N/A</i>	<i>N/A</i>	IPR2023- 00786	<i>N/A</i>	<i>N/A</i>

As U.S. Magistrate Judge Gilliland noted during a December 9, 2022 hearing, this is “a phenomenal case that I’m hoping one day maybe people will write songs about because it is about as complicated as you’re going to get with patent cases.” (EX-2007 52.)

In sum, the complexity of the parallel litigation—which involves numerous claims and issues unrelated to the validity of the ’389 patent—means that the district court will not stay the consolidated proceedings in response to institution.

Second, the district court has been clear in public comments that it will not order a stay in cases where, as here, the district court can resolve the case as quickly as the Board can. For example, Judge Albright has opined that:

“[T]here’s no unfairness to either side by not staying a case for the PTAB when I can try the case as quickly as they can resolve it.... And so far, I think that’s proven to be true.”

(EX-2008 3.) Indeed, as commentators have observed, “Judge Albright almost never stays proceedings to let the PTAB make its decision first.” (*Id.* 2.)

Judge Albright's public comments apply squarely to the situation here. The median time-to-trial in WDTX is 28.2 months, meaning that trial is expected in this case in mid-July 2024, long before a final written decision (expected September 16, 2024). That Judge Albright has made public comments indicating that his practice is to deny a stay in precisely these circumstances confirms that he would not stay this case in response to institution of this petition.

Petitioner argues that Factor 1 can only be neutral because the Board will not attempt to predict how district courts will proceed. (Petition 64.) But that is false: even where no stay has been requested, the Board has found Factor 1 to favor discretionary denial where (as here) “Petitioner present[ed] no evidence that it has requested a stay [] or that a stay is likely.” *Luxshare Precision Industry v. Amphenol Corp.*, IPR2022-00132, Paper 10, at 9 (PTAB May 3, 2022). And such a decision is particularly appropriate where the circumstances do show that “a stay...is unlikely.” *Nintendo Co. v. Gamevice, Inc.*, IPR2020-01197, Paper 13, at 11-12 (PTAB Jan. 12, 2021).

For example, in *Samsung Elecs. Co. v. Clear Imaging Research LLC*, the Board held that Factor 1 may weigh for denial where there is evidence that the

district court is unwilling “to avoid duplicative efforts and await the PTAB’s final resolution of the patentability issues...before proceeding with the parallel litigation.” IPR2020-01399, Paper 13 at 11-12 (PTAB Feb. 3, 2021). While the district court in that case had denied an earlier motion to stay *without* prejudice, the Board found the court’s statements regarding prejudicial delay and the expenditure of resources showed that a stay was unlikely. *Id.* at 10-13. Thus, although the petitioner could still seek a stay, the Board found that factor 1 “weigh[ed] slightly in favor of exercising [] discretion to deny institution.” *Id.* at 12; *see also Motorola Mobility LLC v. Ironworks Patents, LLC*, IPR2021-00421, Paper 11 at 7-8 (PTAB July 22, 2021).

When one considers the full circumstances of this case, the only plausible conclusion regarding a stay is that the district court will not grant one. Because institution will not result in a stay, Factor 1 weighs for discretionary denial. *Sam-sung*, IPR2020-01399, Paper 13 at 11-12; *Motorola*, IPR 2021-00421, Paper 11 at 7-8.

B. Factor 2: A District Court Trial Is Expected *Before* The Projected Statutory Deadline.

Factor 2, which considers the implications of the district court and IPR schedules, also weighs for denial. “[A] parallel proceeding in an advanced state implicates considerations of efficiency and fairness, which can serve as an independent reason

to apply discretion to deny institution.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 11-12, 17 (PTAB May 13, 2020) (*informative*); Guidance at 1.

Institution here would merely serve to “increase, rather than limit, litigation costs,” because the IPR trial would overlap almost entirely with the parallel district court litigation. WDTX’s median time-to-trial is 28.2 months (EX-2009 37), indicating a trial by mid-July 2024—a date consistent with the currently scheduled trial date of August 19, 2024. (EX-2003 9.) Should the Board institute, its final written decision deadline would be September 16, 2024, two months *after* WDTX’s median time-to-trial and one month *after* the scheduled trial date.

In other words, the district court will complete trial well before a final written decision in the IPR. Accordingly, “instituting a trial would be an inefficient use of Board resources.” *See Fintiv*, IPR2020-00019, Paper 15 at 17 (discretionarily denying institution where district court trial was scheduled two months before the final decision deadline); *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (*precedential*) (finding that institution of IPR when the district court trial would resolve validity before the PTAB “would not be consistent with an objective of the AIA...to provide an effective and efficient alternative to district court litigation”); *Samsung Elecs. Co. v. California Institute of Tech.*, IPR2023-00131, Paper 10 at 15, 24 (PTAB May 4, 2023) (discretionarily

denying institution where “[r]egardless of whether we consider the scheduled trial date or the trial date expected based on time-to-trial statistics, the trial in the underlying litigation would commence several months before the expected date of our final written decision”); *Eclinical Works, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (discretionarily denying institution where WDTX trial was scheduled “roughly one to two months before any final decision would have been due”).

Because no stay will be granted and the district court schedule overlaps almost entirely with the IPR schedule, the Board and district court will proceed in parallel for a year, resulting in precisely the “duplicative,” “unnecessary[,] and counterproductive litigation costs” that *Fintiv* and the AIA were designed to avoid. *Fintiv*, IPR2020-00019, Paper 11 at 10; Guidance at 1; *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 20 at 7 (PTAB Aug. 25, 2022) (Board should consider “the duplicative efforts that will occur during the [] duration of the inter partes review”).

Petitioner speculates that the district court may ultimately postpone the scheduled trial date (Petition 64-65), but that speculation carries little weight because Patent Owner does not rely only on the scheduled trial date, but on median time-to-trial statistics, as the Director has recommended. Guidance at 8-9. Moreover, Petitioner's assertion that delay is likely because each defendant may have a different

trial date (Petition 64) is unsupported by evidence and cannot, by itself, weigh against exercising discretion. *See NXP*, PGR2022-00005, Paper 20 at 8 (“[S]ome uncertainty as to the trial date...does not change the ultimate decision.”).

Because the district court will not stay the litigation, and the district court will resolve validity before the Board reaches its final written decision, the second *Fintiv* factor also favors discretionary denial.

C. Factor 3: The Parties Will Have Invested Significant Resources In The District Court Proceeding.

Factor 3, which considers the resources invested in the parallel district court proceeding, weighs strongly for denying institution.

The parties have invested significant resources in the parallel litigation over the last 15 months. For example, the parties long ago exchanged infringement and invalidity contentions (in July 2022 and September 2022 respectively), and the parties will have completed five months of fact discovery by the time the Board reaches an institution decision. Moreover, the district court issued its claim construction order three months ago, on March 16, 2023, (EX-2010), “indicat[ing] that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Fintiv*, IPR2020-00019, Paper 11 at 10.

In addition, the overlapping schedules here counsel the Board to further consider the redundant resources that *will be* wasted should IPR be instituted. *Id.* at 6;

NXP, PGR2022-00005, Paper 20 at 7 (Board should consider “the duplicative efforts that will occur during the [] duration of the inter partes review”); *Cisco Sys., Inc. v. Monarch Networking Solutions LLC*, IPR2020-01227, Paper 11 at 11-12 (PTAB Mar. 4, 2021) (finding that more work completed by the parties and the court suggests that institution would lead to duplicative costs).

The investment in this case is colossal. The district court's *Markman* order that included the '389 patent was twenty pages, without even considering the Court's substantive analysis or the additional *Markman* orders issued in this case. (EX-2010.) The Court considered and construed seven claim terms of the '389 patent, alone. (*Id.*) And as of the date of Patent Owner's preliminary response, the parties have engaged in extensive discovery on the parties' contentions. The Court has held multiple discovery hearings. Furthermore, Patent Owner's experts have already invested an extensive number of hours preparing for their reports by reviewing the patent, prior art, Defendants' invalidity contentions, and source code. *See Regeneron Pharmas. Inc. v. Novartis Pharma AG*, IPR2020-01317, Paper 15 at 17 (PTAB Jan. 15, 2021) (discretionarily denying institution where the parties had expended considerable resources in claim construction, substantial fact discovery, and preparation for expert reports).

Petitioner's delay in filing this petition further weighs for denial. Petitioner waited almost exactly twelve months after receiving Patent Owner's March 4, 2022 complaint, eight months after receiving Patent Owner's infringement contentions, and six months after serving its invalidity contentions before filing its petition. (EX-2011 1-2; EX-2012 1-2.) Petitioner offers no explanation for its delay, which weighs for denial. *Fintiv*, IPR2020-00019, Paper 11 at 11-12; *Ericsson Inc. v. Collision Comms., Inc.*, IPR2022-01233, Paper 12 at 15 (PTAB Jan. 19, 2023) (finding that where the parties invested significant resources and "Petitioner waited almost a year" to file its petition, "this factor weighs decidedly in favor of discretionary denial"); *Regeneron*, IPR2020-01317, Paper 15 at 17 (finding that even where the petition was filed "less than a month after learning of the complaints," the investment by the parties in the parallel proceeding "outweighs the effort expended so far in this proceeding").

D. Factor 4: The Issues Overlap Significantly.

Factor 4—the degree of overlap between the issues in the petition and those before the district court—also weighs strongly for discretionary denial. Regarding this fourth factor, *Fintiv* explains that "concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong" where "the Board [is] presented with substantially identical prior art arguments...at issue in district court." *Fintiv*,

IPR2020-00019, Paper 11 at 12. “Accordingly, if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Id.*

Here, the petition identifies substantially the same prior art arguments that Petitioner and multiple co-defendants have put before the district court, and no co-defendant has offered any type of stipulation. (EX-2013 1, 10-11; EX-2014 1, 14; EX-2015 1, 14, 42; EX-2016 1, 2 (incorporating Kester by reference to prior art cited in the '389 patent's prosecution history); EX-2017 1, 6, 7.) This fact favors denial.

The Board has held that, at least where the petitioner is the only defendant in the district court, a stipulation not to pursue at the district court “any ground raised or that could have been reasonably raised” in the petition is effective in mitigating concerns of duplicative efforts and conflicting decisions between the district court and the Board. *Sotera Wireless, Inc. v Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). However, a limited stipulation not to pursue only the same grounds weighs only “***marginally*** in favor of not exercising discretion to deny institution.”² *Sand Revolution II, LLC v. Cont'l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020).

² All emphases added unless otherwise noted.

Here, Petitioner has offered only the limited stipulation that it would not use in the district court any *instituted ground of invalidity*. (Petition 65.) Petitioner argues that Factor 4 favors institution because Petitioner's "consistent with the stipulation in *Sand Revolution*" *Id.* But Petitioner's stipulation (to not use the same instituted grounds) is even narrower than the "marginal" *Sand Revolution* stipulation. *Sand Revolution II* at 12 n.5. Petitioner's stipulation does no more than a *Sand Revolution* stipulation to "ensure that [the] IPR functions as a true alternative to litigation." *Sand Revolution II* at 12 n.5. To the contrary, the stipulation merely *compounds* litigation costs by allowing Petitioner to pursue separate invalidity theories in parallel at two different tribunals. Thus, Petitioner's narrow stipulation could not carry any more weight than a *Sand Revolution* stipulation, which weighs "only marginally in favor of [institution]." *Id.* at 11-12.

Petitioner further contends that its challenge to claims 15-29, which are not asserted in litigation, supports institution (Petition 65) but identifies no supporting precedent for this argument. Discovery is ongoing in the district court, and presently nothing precludes assertion of claims 15-29 in those proceedings if warranted.

Under the circumstances here, where Petitioner's co-defendants present the same prior art and offer no stipulation, Petitioner's stipulation carries *no weight* because it does not bar the *other defendants* in the parallel litigation from litigating the

very same invalidity challenges before the district court. Because Petitioner's stipulation does not "mitigate[] any concerns of duplicative efforts between the district court and the Board," or "of potentially conflicting decisions," Factor 4 weighs in favor of discretionary denial. *Sotera*, IPR2020-01019, Paper 12 at 19; *see Google LLC v. EcoFactor, Inc.*, IPR2021-00454, Paper 9 at 12-14 (PTAB July 22, 2021).

E. Factor 5: Both Parties Are Parties In The Parallel Litigation.

Factor 5—which considers overlap of the parties between the petition and the parallel litigation—favors denial because Petitioner is a defendant in the parallel litigation and will therefore get the opportunity to litigate the petitioned grounds there.

Because Petitioner is a defendant in the litigation, there are no fairness concerns that a denial would deprive Petitioner of its day in court. *Fintiv*, IPR2020-00019, Paper 11 at 13-14; *Vizio, Inc. v. Maxell, Ltd.*, IPR2022-01459, Paper 7 at 21-22 (PTAB Apr. 11, 2023) ("Because Petitioner is the litigation defendant, factor 5 weighs in favor of discretionary denial"); *Nokia of Am. Corp. v. Godo Kaisha IP Bridge*, IPR2022-00755, Paper 9 at 13 (PTAB Nov. 2, 2022) (holding that Factor 5 weighed for discretionary denial where Petitioner was defendant in parallel proceeding); *Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021) ("[T]his factor 'favors denial if trial precedes the Board's Final Written Decision.'").

That other defendants are also litigating the petitioned issues at the district court weighs yet further for discretionary denial. *Fintiv* holds that, “[e]ven when a petitioner is unrelated to a defendant...if the issues are the same as, or substantially similar to, those...about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.” *Id.* at 14. Because of this consideration, *Fintiv* goes on to state that “[a]n unrelated petitioner should, therefore...discuss why addressing the same or substantially the same issues would not be duplicative of the [other pending proceedings regarding the patent] even if the petition is brought by a different party.” *Id.*

Petitioner fails to offer such an explanation here. Thus, other defendants in the district court proceedings are already litigating the petitioned grounds, and Petitioner has offered no explanation as to why this petition is not duplicative. This weighs yet further for discretionary denial.

F. Factor 6: The Petition Does Not Present “Compelling Evidence Of Unpatentability.”

Factor 6—which considers the merits of the Petition—also weighs against institution because, as detailed below, the petition fails to show a “reasonable likelihood” that Petitioner would prevail on any challenged claim. *See* 35 U.S.C. § 314(a). None of the cited art teaches, suggests, or renders obvious the idea of

comparing, by the base computer, the data about the computer object received from multiple computers to identify relationships between the computer object and other computer objects. Moreover, as discussed in detail below, Petitioner's primary reference, Kester, was considered by the examiner during prosecution, cited by the examiner on a signed IDS, and applied by the examiner in *two* rejections. (EX-1002 87, 106–107, 109, 111, 141, 163, 164, 188, 257.) Despite the examiner's consideration of Kester, the examiner did not find Kester disclosed any limitation of any independent claim of the '389 patent. *Id.* And the '389 patent ultimately issued based on petitioner's distinction that "the cited references do not teach, suggest or describe at least comparing in the base computer the data about the computer object received from the plural computers to identify relationships between the object and other objects or entities." (EX-1002 189.) Because Petitioner fails to show a reasonable likelihood of success on the merits, IPR may not be instituted.

Even if the petition did pass the threshold of "reasonable likelihood" (it does not), it certainly would not pass the higher threshold of a "compelling" unpatentability challenge that could preclude discretionary denial. Guidance at 4. "[T]he compelling merits standard is a higher standard than the standard for institution set by statute." *Commscope Techs. v. Dali Wireless, Inc.*, IPR 2022-01242, Paper 23, 3 (PTAB Feb. 27, 2023). That higher standard requires determining that the

Petitioner's chances of succeeding on the merits are "highly likely." *Id.* at 4. But just the opposite is true here. As shown below, Petitioner's grounds are exceptionally weak, relying on the same primary prior art reference considered during prosecution, and failing to disclose multiple limitations due to the reference's fundamental differences from the '389 patent. *See* Section IV, *infra*.

In sum, all six factors weigh for discretionary denial. Accordingly, Patent Owner respectfully requests that the Board exercise its discretion to deny institution.

III. THE '389 PATENT

A. Inadequacy of the Prior Art & The Need for Improved Malware Detection.

"Malware" generally refers to an executable computer file or an object that is or contains malicious code, *e.g.*, viruses, trojans, worms, etc. (EX-1001 1:19-22; EX-2001 ¶¶28-29.) Much of the prior art anti-malware or anti-virus software focused on scanning and stopping *known* malware. (EX-1001 1:23-2:23.) For example, some prior art anti-virus software analyzed objects for "signatures"—something within the object that was known to be indicative of malware. (EX-1001 1:23-33.) Whenever new malware was detected by the industry, service providers would craft new signatures and release them as updates to their anti-malware programs. (*Id.*) Other prior art systems checked databases of known files to determine whether a file had been known for long enough that it could be deemed safe. (EX-1001 1:48-52.)

These prior art methods for detecting known malware suffered from considerable delays—either while waiting for malware to be detected and a signature generated or waiting a sufficient amount of time that a program could be deemed safe. (EX-1001 1:35-42, 1:53-59; EX-2001 ¶¶32-33, 45.)

Other anti-malware systems sought to protect from previously unknown malware. For example, many prior art community-based anti-malware systems—*e.g.*, having a central computer and local computers on a network—relied on analysis at the central computer to determine whether a file was known or unknown. (EX-1001 1:65-2:9.) But when a file was unknown, the system had to provide the entire file to the central computer, where a manual or semi-manual detailed analysis of the file would be performed. (EX-1001 2:9-17.) This analysis “can still take days given the human involvement that is typically required.” (*Id.*) Other prior art systems similarly relied on a human administrator to “make a better informed though still ‘manual’ decision as to whether or not the file is safe to run.” (*E.g.*, EX-1001 2:24-33.) Thus, such prior art systems still resulted in considerable delay before a new file could be classified as safe or malware. (EX-1001 2:18-19; EX-2001 ¶¶30-31.)

Accordingly, there was a long-felt need for an improved technique to efficiently determine whether files were safe or malware. (EX-2001 ¶¶30-33.)

B. Innovations of the '389 Patent.

Unlike the methods described in the prior art, the '389 patent describes a rapid determination of whether an object (e.g., a file) should be classified as safe or malware, without requiring a preliminary detailed analysis of the object. (EX-1001 3:14-24, Cls. 1, 15, EX-2001 ¶¶34-35.) “An object in this sense may be a computer file, part of a file or a sub-program, macro, web page or any other piece of code to be operated by or on the computer, or any other event when executed, emulated, simulated or interpreted.” (EX-1001 8:1-4.)

The '389 patent discloses a method which may be implemented in a distributed network having a “base” computer and multiple “remote” computers:

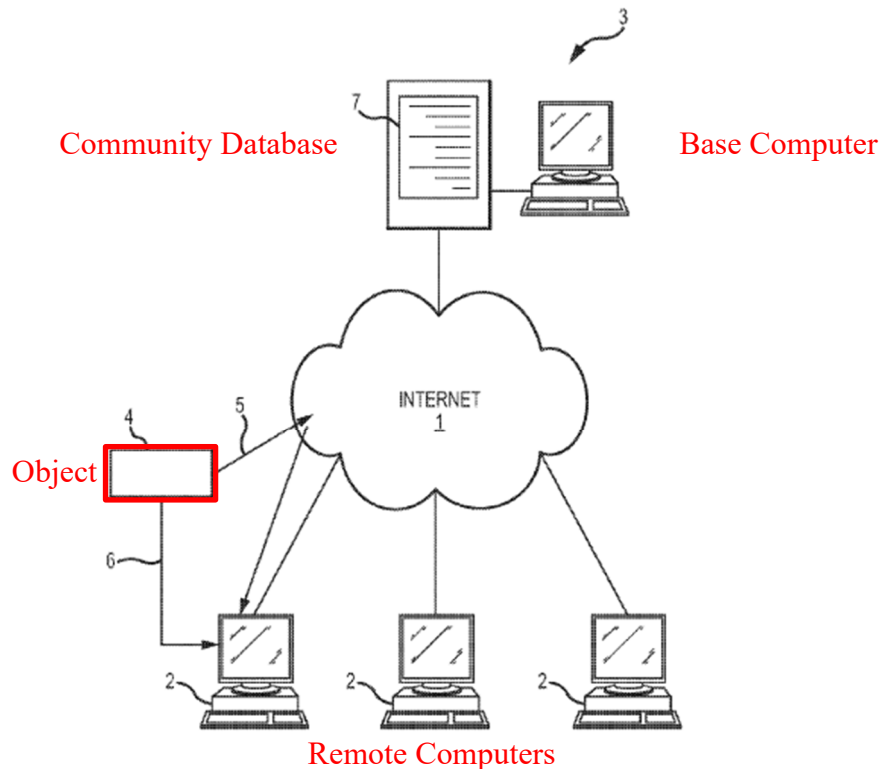


FIG.1

(EX-1001, Fig. 1, 7:59-8:20 (annotated).) The '389 patent discloses a “community database,” in which data about computer objects can be collected from across the network. (EX-1001 8:21-22, 8:47-50.) The data stored in the community database provides “an extensive corollary of an object’s creation, configuration, execution, behaviour, identities and relationships to other objects.” (EX-1001 10:37-42.)

The '389 patent’s collection of this object-specific data allows for a rapid and more efficient determination of whether a particular object is malware. (EX-2001 ¶¶ 39-40.) At a high level, the '389 patent discloses a method in which, for example, “a base computer” receives data about a computer object from at least two remote

computers, correlates that data, compares the correlated data to other objects or entities to identify a relationship, and classifies the computer object as malware based on this comparison. (EX-1001 3:4-14, cls. 1, 15.)

Specifically, when an unknown object is run at a remote computer, details of the object can be passed to the base computer for storage in the community database and further analysis. (EX-1001 8:21-22, 8:47-50.) When the base computer receives data about a particular object from two or more computers, the base computer may correlate this data about the object to facilitate a comparison with other objects or entities. (EX-1001 10:35-49, cls. 1, 15; EX-2001 ¶41.)

The '389 patent discloses a variety of heuristic processes that can be used to compare the correlated object data to other known objects. (EX-1001 10:35-42.) Preferably, the '389 patent compares the correlated data with other objects to identify relationships with those objects. (EX-1001 3:37-38, 11:5-60, 17:24-18:7; EX-2001 ¶¶40-43.) “[A]n object is considered to have a relationship based on the event performed by it upon another object, or upon it by another object”—for example, where one object created another object. (EX-1001 11:7-13.) Thus, “other objects” may include the object-in-question, parent objects (i.e., the object-in-question’s creator), child objects (i.e., objects the object-in-question has created), or other process related objects. (EX-1001 3:43-47; EX-2001 ¶42.)

The '389 patent provides an example using the notepad.exe program (*i.e.*, object), which is commonly installed on computers running the Windows operating system. (EX-1001 11:30-32.) Because the notepad.exe program has a “limited range of functionality,” certain actions like transmitting data to another computer or program would be flagged as unexpected. (*Id.* at 11:32-35; EX-2001 ¶44.) However, it is possible for notepad.exe's capabilities to be modified by injecting new code into it (*e.g.*, via a dynamic link library injection). (EX-1001 11:35-38.) By identifying relationships between notepad.exe and other objects, “it is possible to deduce that the new behaviours ... can be attributed to the association with another object” (*e.g.*, that notepad.exe's new behavior was a direct result of its relationship with another object). (*Id.* At 11:40-42; EX-2001 ¶45.) If the new behavior is malicious, or if the program that modified notepad.exe is known to be malicious, then it is possible to classify one or both processes as unsafe based on the comparison of the two (*Id.* at 11:42-44; EX-2001 ¶¶44-45.)

By enabling centralization of object-specific community data and a comparison between objects to identify a relationship, the '389 patent allows for “rapid identification and determination” of “whether or not a particular object should be classed as good or as malware.” (EX-1001 3:14-24, 11:55-59; EX-2001 ¶46.) Its methods and system decrease reliance on signature verification and negated the need for

manual, time-consuming “deep analysis” of an object. (EX-1001 3:14-24; EX-2001 ¶¶39-46.)

C. Claim Construction

1. Terms At Issue In The District Court.

Petitioner states that it relies on the plain and ordinary meaning of the claims. (Petition 6.) Petitioner and its co-defendants raised multiple terms for construction in the parallel district court litigation. On March 16, 2023, the Court determined that no terms of the '389 patent were indefinite and construed all terms to have their plain and ordinary meaning, while providing the following clarifying remarks:

Claims	Claim Term	Court's Construction
1, 15	“similar objects” / “similar computer objects”	Not indefinite. Plain-and-ordinary meaning. (EX-2010 3.)
14	“a mask for said computer object that defines acceptable behaviour for the computer object”	Plain-and-ordinary meaning Note not for the jury: the plain-and-ordinary meaning of this term is not the inverse of a mask of unacceptable behavior (<i>Id.</i> 4.)
1-14, 26, 30	“events initiated [by] or involving the computer object”	Plain-and-ordinary meaning Note: the plain-and-ordinary meaning of “events” includes but is not limited to “actions or behaviours of

Claims	Claim Term	Court's Construction
		an object acting upon another object or some other entity” (<i>Id.</i> 5.)
1	“first remote computer” / “second remote computer”	Plain-and-ordinary meaning (<i>Id.</i> 5.)
1	“correlating...at least a portion of the data about the computer object...comparing...the correlated data about the computer object”	Plain-and-ordinary meaning. The claim language recites that at least a portion of the data, but not all of the data, must be correlated before comparing. (<i>Id.</i> 6-7.)
1, 6, 8, 9, 12, 14, 30	“remote computer”	Plain-and-ordinary meaning (<i>Id.</i> 8.)

Accordingly, Patent Owner and its expert apply the plain and ordinary meaning of all claim terms in view of the district court's clarifying remarks. (EX-2001 ¶¶48-52.)

D. Level of Ordinary Skill in the Art.

A POSITA at the time of the invention of the '389 patent (which claims priority to an earlier application (GB 0513375.6) filed in Great Britain on June 30, 2005) would have had a Bachelor's degree in an accredited program of Electrical Engineering, Computer Engineering, or Computer Science or in a similar discipline,

and have 2-3 years of practical work or research experience in the general fields of electrical engineering, computer science, networking, communications, and device and network security. (EX-2001 ¶¶49-52.) More advanced degrees and/or training in a related discipline can compensate for shorter work experience. (*Id.*)

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(d)

The Board has discretion to deny institution of a petition when “the same or substantively the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). Here, discretionary denial under Section 325(d) is proper because the Office already considered Kester, which is Petitioner’s primary reference, in depth during prosecution of the ’389 patent. (Petition 2; EX-1002 87, 106, 109, 111, 141, 163-164, 188, 257). The ’389 patent issued over Kester and the examiner did not find Kester disclosed or rendered obvious any limitation of any independent claim of the ’389 patent.

When deciding whether to exercise its Rule 325(d) discretion, the Board considers a two-part framework: “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.”

Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

A. The Same Prior Art Was Previously Considered By the Examiner.

In considering the first part of the *Advanced Bionics* framework, the Board may consider the relevant *Becton Dickinson* factors: (a) the similarities of the asserted art and the art previously considered; (b) the cumulative nature of the asserted art and the art previously considered; and (d) the extent of the overlap between the arguments made during examination and Petitioner's arguments. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9-10 (citing *Becton, Dickinson and Co. v. B. Braun Mel-sungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (informative)).

The examiner considered the same Kester reference that Petitioner relies on for its primary reference. The examiner cited Kester on a signed IDS to confirm he considered it, and the examiner applied Kester in *two* separate rejections. (EX-1002 87, 106, 109, 111, 141, 163-164, 188, 257.) *See Nespresso USA, Inc. v. K-Fee Sys. GMHB*, IPR2021-01222, Paper 9 at 11-12 (PTAB Jan. 18, 2022) (citing *Advanced Bionics*, IPR2019-01469, Paper 6 at 7-8) (exercising discretion under Section 325(d) to deny institution where the petitioned prior art—while not considered in a rejection—was contained within an examiner-initialed IDS). Indeed, Petitioner acknowledges that “[d]uring prosecution, *Kester* was advanced in an office action” and

applied by examiner against a limitation found in dependent claims 14 and 28. (Petition 4; *see* EX-1002 163-164.) Despite considering Kester during prosecution of the '389 patent, the examiner did not identify Kester as disclosing or teaching any limitation of independent claims 1 and 15. (*See id.* at 141, 163-164, 188-192.)

Petitioner argues that the Office never previously considered Kester in combination with Kennedy and Honig during prosecution. (Petition 4.) However, Petitioner does not rely on Kennedy *or* Honig as disclosing or teaching any aspect of independent claim limitations 1.1, 1.2, 1.3, and 1.4 (Petition 13–24), or independent claim limitations 15.1, 15.2, and 15.3. (Petition 42–43.) Thus, neither Kennedy or Honig can be used to supplement what Kester fails to disclose for these limitations.

Petitioner relies on *Thorne Research, Inc. v. Trustees of Dartmouth College*, IPR2021-00491, Paper 18, 7-9 (PTAB Aug. 12, 2021) (“*Thorne*”) to argue that *Advanced Bionics*’s first prong is not met in this case because the petitioned grounds are different than the combination applied during prosecution. (Petition 5.) In *Thorne*, the Board noted that Patent Owner relied solely on the argument that the petition failed address the second prong of *Advanced Bionics* and, since the subject reference was cited during prosecution and discussed in response to an Office Action, that alone warranted discretionary denial. *Id.* at 7–8. This case is distinguishable given the examiner’s extensive consideration of Kester during prosecution. In

Thorne Research, by contrast, the reference was merely listed on an IDS and mentioned by the applicant to explain the knowledge of a POSITA as of the priority date. *Id.* It was not relied on by the examiner for its disclosure of a particular claim limitation. *See Thorne Research*, IPR2021-00491; Paper 18, 7-8; *cf. Nespresso USA, Inc. v. K-Fee Sys. GMHB*, IPR2021-01222, Paper 9 at 11-12 (PTAB Jan. 18, 2022) (citing *Advanced Bionics*, IPR2019-01469, Paper 6 at 7-8) (exercising discretion under Section 325(d) to deny institution where the petitioned prior art—while not considered in a rejection—was contained within an examiner-initialed IDS)

As described above, the examiner previously considered the same Kester reference at issue in the petition, and Petitioner does not cite Kennedy and Honig for independent claim limitations 1.1, 1.2, 1.3, 1.4, 15.1, 15.2, and 15.3. Accordingly, the Board should deny institution under Section 325(d).

B. Petitioner Does Not Claim that the Examiner Erred During Prosecution.

Where, as here, the Office has already considered the same prior art and arguments presented in the petition, institution may only be considered if the petition clearly identifies examiner error during prosecution. *Becton Dickinson* factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office. *Advanced Bionics*, IPR2019-01469, Paper 6 at 10; *see Becton*, IPR2017-01586, Paper 8, 17–18 (designated as informative). The examiner considered Kester

during prosecution of the '389 patent but never identified or cited it as disclosing any aspect of independent claim limitations 1.1, 1.2, 1.3, 1.4, 1.5, 15.1, 15.2, 15.3, and 15.4, *i.e.*, the limitations against which only Kester is cited, and the petition does not identify any examiner error regarding the aforementioned limitations. As the examiner made no error in issuing the '389 patent over Kester, the *Advanced Bionics* framework supports discretionary denial of institution under Section 325(d). *Advanced Bionics*, IPR2019-01469, Paper 6 at 9 (“If reasonable minds disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.”).

V. OVERVIEW OF THE RELEVANT PRIOR ART

A. Overview of Kester.

Kester recognized that the rise in internet connectivity meant an increase in employee communications and with that, an increased risk of employees installing applications or transmitting programs or files their employers may disapprove of. (EX-1004 [0005].) For example, instant messaging, while improving productivity, could pose a risk to sensitive data. (*Id.*) Media streaming, while useful, could drain network bandwidth. (*Id.*) Although traditional filter systems existed to manage how employees access the Internet in the workplace, the growth of these threats meant

“employers need[ed] new solutions to manage the broader intersection of employees with their computing environments.” (EX-1004 [0006]-[0007]; EX-2001 ¶¶67-68.)

Thus, Kester sought to provide a means for “controlling application files,” *i.e.*, controlling when a user (or workstation) was permitted to launch an application or access a network through an application. (EX-1004 Abstract, [0003], [0040]-[0042]; EX-2001 ¶¶68.) Kester discloses a method and system that is capable of controlling a wide variety of application categories and discloses more than forty different exemplary categories, including those related to productivity (e.g., project managers, word processing), communication (e.g., email, instant messaging), audio/video (e.g., media players), and entertainment (e.g., games). (EX-1004 Fig. 4A, [0082]; EX-2001 ¶¶69.) While one of these forty-four categories is “malicious applets and scripts,” Kester contains no discussion of why something should be categorized as malicious and/or what policy should be implemented for this category. Kester’s method was not directed to the *determination* of whether a file was safe or malware, but rather to controlling all types of application files. (EX-2001 ¶¶70-72.)

Because an employer’s policies regarding applications and/or their network access are often user- or workstation-specific, Kester discloses a workstation management module (“WMM”) that can “select a unique access privilege for the

workstation 101 and/or user” to control the launch of an application or a network access. (EX-1004 [0042], [0057] [0059]; EX-2001 ¶¶72-73.)

Figure 1 illustrates workstations 1 through N on a local area network 100, each of which includes a WMM:

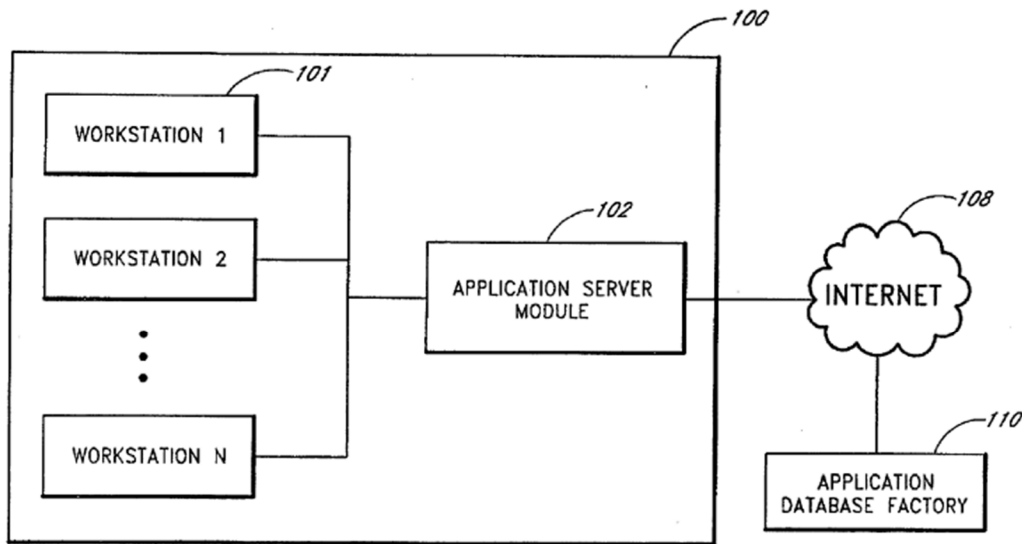


FIG. 1

(EX-1004 Fig. 1.) Each WMM includes a hash/policy table, in which a hash value corresponding to an application (or user) is optionally associated with a category and also associated with a policy specific to that application/user. (EX-1004 [0039], Fig. 2, [0102], [0144]; [0057] [0059]; EX-2001 ¶¶74-75.)

When the WMM detects a request to launch an application or access a network, a “hash” or “application digest” is created from properties unique to the

application requesting access, such as the network access data. (EX-1004 [0140]-[0142], Fig. 14 (steps 1402, 1404), [0051].) The WMM then “compares the network access request with the hash/policy table.” (EX-1004 [0053], [0142], Fig. 14 (step 1406).) “If the hash and collection data correspond to a hash stored in the hash/policy table 204 and the collection data associated with the hash in the hash/policy table 204...the policy associated with the hash is applied in response to the network access request.” (EX-1004 [0143], Fig. 14 (step 1410).)

But for the WMM to be able to consult such a hash/policy table, Kester teaches that a human administrator must review applications and make certain “pre-determined associations”—*i.e.*, determine the expected network activity, applicable category(ies), and policy for each application request and/or workstation. (EX-1004 [0040], [0043], [0072]; EX-2001 ¶77.) Kester teaches that a human reviewer interfaces with an “application analyst’s classification module” to determine these associations. (EX-1004 [0178], Fig. 20.)

Kester first discloses that the human reviewer is provided with a list of applications and determines the appropriate category or categories for each. (*Id.*; EX-2001 ¶78.) A list of applications is extracted from the “uncategorized application database 303 and/or the network access database 304 for classification by the human reviewer.” (EX-1004 [0178].) Kester teaches that the human reviewer conducts an

in-depth analysis of the application, related information, internet research, and/or related documentation to determine the appropriate categories. (EX-1004 [0134]-[0135], Fig. 13; EX-2001 ¶79-80.) As discussed above, this could include one or more of the forty-four exemplary categories Kester discloses. (EX-1004 Fig. 4A.) Kester additionally discloses two more categories: “expected or predetermined network access” and “unexpected network access.” (EX-1004 [0178].) Thus, Kester may use the term “expected” or “predetermined” when referring to the general category of expected network access. (EX-2001 ¶80.)

In addition to determining appropriate categories, Kester teaches that the human reviewer relies on his analysis of the related data and information “to determine an expected or allowed network activity.” (EX-1004 [0179]-[0182], Fig. 20 (steps 2004, 2006); EX-2001 ¶81.) Kester explains that the “[t]he expected network activity...can include one or more network attributes that are associated with the application,” such as a specific protocol, a specific IP address, and a specific access port. (EX-1004 [0184].) For the same application, network attributes may be different for each attempted access. (EX-1004 [0185].) Hash values are generated for each application, including the predetermined network access data, and the WMM “stores the expected network activity in the hash/policy table.” (EX-1004 [0011], [0183].) That is, Kester also uses “expected” or “predetermined” to refer to the expected

network activity/attributes that are unique to each entry of the hash/policy table.
(EX-2001 ¶81.)

Kester provides an illustrative example to help put these two different uses of
“expected” in context:

For example, a first entry in the application inventory database 103 corresponds to the application when the application is operating in a predetermined manner. These expected features relate to normal network activity by the application. A second entry corresponds to the same application hash but different parsed properties or features associated with the application when the application is not operating in a predetermined manner.

(EX-1004 [0070].)

Thus, a POSITA would understand that Kester first uses “expected” or “predetermined” to describe when an application/request to be evaluated matches with the expected network activity (or “expected features”) that are unique to each entry in the hash/policy table. (*See id.* [0070], [0179]-[0184]; EX-2001 ¶84.) But Kester also uses “expected” or “predetermined” to refer to the “expected network access” category—*i.e.*, in the example of paragraph [0070], whether the features for a particular application operation are “operating in a predetermined manner” and “relate

to normal network activity by the application.” (See EX-1004 [0070], [0178], [0134]-[0135].) Dr. Medvidovic supplies an example which further illustrates the nuanced use of these terms. (EX-2001 ¶71.)

“Each combination of the one or more attributes can be associated with one or more categories.” (EX-1004 [0185]-[0186].) These “categories can be further associated with the policies or rules for the workstation 101 and/or user,” including allow, disallow, or an alternative. (EX-1004 [0186]-[0187], [0055]-[0056].) “[T]he same application may be allowed to run on a workstation but not allowed to run on a different workstation.” (EX-1004 [0116]; EX-2001 ¶82.) “Thus, once [a] requested application is categorized, the application server module 102 can select the policy or rule that is associated with that category.” (EX-1004 [0082].)

Accordingly, Kester enabled a human to control application and network access requests on an individual basis, based on information about the application, the workstation, and/or the user, across all types of applications. (EX-2001 ¶86.)

B. Overview of Kennedy.

Kennedy discloses a “malicious software detection module” (or “MSDM”) that operates on a computer connected to a network. (EX-1005 1:42-52) The MSDM runs on a computer system and “monitors a storage device of the computer

system for the arrival of software from a suspicious portal.” (EX-1005 1:45-48.)

The MSDM's malicious software detection steps are illustrated in Figure 4:

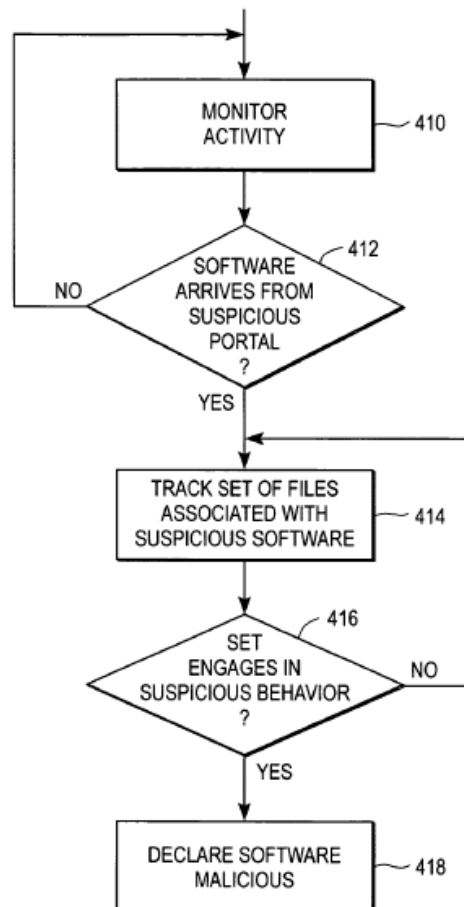


FIG. 4

(EX-1005 Fig. 4.)

“The MSDM 212 monitors 410 activity on the local storage device 108.” (EX-1005 5:51-52.) The computer system's MSDM will initially classify an object received by that computer system as suspicious if “the software arrived through a portal designated as suspicious.” (EX-1005 5:52–56.) Next, the MSDM tracks files

on the local storage device that are associated with the software it has designated as suspicious and, if the files in the set either individually or collectively engage in malicious behavior, the MSDM classifies “the software [as] malicious and notifies the end-user, quarantines the software, blocks the software from performing certain activities, and/or performs other actions.” (EX-1005 5:57–6:4.)

Kennedy's MSDM runs on a single computer system, whether implemented as an application or at the network stack layer (*See* EX-1005 3:14-21), in order to evaluate computer objects on that same computer system. (EX-1005 5:44–6:10.) Kennedy's MSDM does not disclose using information about objects on other computers to classify an object as malware. (*See* EX-1005 2:53–3:40). There is no “base computer” disclosed by or otherwise incorporated into Kennedy's systems and methods. (*See generally* EX-1005.)

VI. THE CHALLENGED CLAIMS ARE PATENTABLE

The petition presents two grounds challenging the claims of the '389 patent:

Ground 1	Section 103(a)	Obvious over Kester in view of Kennedy	Claims 1-13, 15-27, 29-30
Ground 2	Section 103(a)	Obvious over Kester in view of Kennedy and Honig	Claims 14, 18

“In an *inter partes* review, the burden of persuasion is on the petitioner Failure to prove the matter as required by the applicable standard means that the party with the burden of persuasion loses on that point—thus, if the fact trier of the issue is left uncertain, the party with the burden loses.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (noting petitioners have the “burden from the onset to show with particularity why the patent it challenges is unpatentable”). Petitioner fails to show a reasonable likelihood of success as to any challenged claim because (i) Kester is not analogous art; and (ii) Kester and Kennedy, even if combined, do not disclose or render obvious any of the challenged claims.

A. Petitioner Fails To Establish That Kester Is Analogous Art.

Kester is non-analogous art to the ’389 patent, as it is neither in the same field of endeavor nor reasonably pertinent to the problems considered by the inventors of the ’389 patent.

A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention. Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s

endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

In re Klein, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (internal citations omitted); *Ex Parte Sokoly*, No. 2019-006703, 2020 WL 5587537, *3 (PTAB Sept. 15, 2020) (the fact that the prior art was used to “hang the roof tiles on the roof” did not mean that it was analogous to the claimed “utility hanger”).

1. Kester Is Not In The Same Field Of Endeavor.

Kester is not in the same field of endeavor as the '389 patent. The '389 patent was classified as “information security” (EX-1001 p.1.) and explains that its particular field of endeavor is the rapid determination of whether an object is safe or malware. (EX-1001 1:9-10, 3:19-24, 5:4-8, 11:55-60; EX-2001 ¶¶88-95.)

Petitioner misstates the problems the '389 patent sought to solve, merely cherry-picking select limitations of the claims. (Petition 9-10.) The '389 patent explicitly identifies prior art problems, explaining that prior art methods for determining whether a file was malware involved considerable delay “given the human involvement that is typically required.” (EX-1001 2:9-34, 2:63-3:3.) The '389 patent sought to improve upon these prior art methods that relied on a human administrator and manual or semi-manual detailed analysis of an object to decide whether a file is malware. (EX-1001 2:4-27.) The '389 patent thus claims a method and

system which “allows a rapid determination of the nature of the object to be made, without requiring detailed analysis of the object itself as such to determine whether it [is] malware.” (EX-1001 3:19-24; EX-2001 ¶¶87, 88, 91, 125.)

By contrast, and contrary to Petitioner's characterizations, Kester relates to “data processing” and not the field of rapidly determining whether an object is malware. Kester was classified as “data processing” and explicitly defines its “[f]ield of [i]nvention” as “related to computing devices and, more particularly to monitoring and controlling application files operating thereon.” (EX-1004 [0002]-[0003], Title, cls. 1, 23, 37, 39; EX-2001 ¶89.) Kester explains that while prior art software was available for “preserving employee productivity, conserving network bandwidth and storage costs, limiting legal liability and improving network security,” Kester sought to provide a “new solution[] to manage the broader intersection of employees with their computing environments” through monitoring and control of application files. (EX-1004 [0006], Title, [0003].) Thus, Kester's field of endeavor (monitoring and controlling application files) is not the same field of endeavor as the '389 patent (rapid determination of whether an object is safe or malware). (EX-2001 ¶¶53-57.)

Petitioner wrongly characterizes Kester as directed to categorizing applications as malware based on a single passing reference to malicious applets found within forty-four examples of files that Kester can be used to monitor and control.

(Petition 8 (“categorizing an application running on a remote workstation (e.g., as malware) based on the application’s behavior”).) As discussed above, Kester is directed to monitoring and controlling a wide variety of application files and discloses forty-four exemplary categories of application files that can be monitored and controlled. One of these forty-four categories is “malicious applets and scripts.” (*See Section V.A., supra*; EX-1004 Fig. 4A, [0082].) Petitioner’s claims that Kester is in the general field of classifying an object as malware relies on this single passing reference (as one of forty-four examples). (Petition 8-9.) But Kester presupposes that the applets or scripts are “malicious” and contains no disclosure regarding how any determination is made that the “applets or scripts” are “malicious”, or what might distinguish “malicious” applets or scripts from non-malicious applet or scripts. An isolated, single reference to “malicious applets and scripts” as one category within the forty-plus enumerated categories of files that are controlled and monitored does not place Kester in the same field of endeavor as the ’389 patent. (EX-2001 ¶¶57-59, 90-91.)³

³ During prosecution, the Examiner stated that “Omate in view of Dozortsev and Kester are from the same field of endeavor, malware.” (EX-1002 107, 163; EX-2001 ¶¶92-94.) However, that is incorrect for the reasons addressed herein. The

In *Vizio, Inc. v. Nichia Corp.*, the Board found that prior art reference “Pinnow,” which was cited in an IDS during prosecution of the challenged patent, was non-analogous. IPR2017-00552, Paper 9 at 11, 20-21 (PTAB July 7, 2017). The Board characterized the challenged patent’s field of invention as relating to “a light emitting diode used in LED display, back light source, traffic signal, railway signal, illuminating switch, indicator, etc.” *Id.* at 21. In contrast, the Board defined Pinnow’s field of invention as “concerned with projection display systems and is primarily concerned with those producing black and white images.” *Id.* Thus, despite the fact that both the challenged patent and Pinnow “discuss” converting light from a monochromatic light source, the Board found Pinnow was not in the same field of endeavor. *Id.*

Similarly, in *Ex Parte Brennan*, the Board overturned an examiner’s obviousness rejection because the prior art was non-analogous. (EX-2018, Application No.

Examiner did not identify any basis for redefining Kester’s field of endeavor (monitoring and controlling application files) to be detecting malware, much less the specific field of endeavor of the ‘389 patent. Notably, despite incorrectly considering Kester in the malware field, the Examiner still did not map it to any independent claims of the ‘389 patent. *See* Section IV, *supra*; EX-1002 141, 163-164, 188-192.)

15/285,875, Appeal No. 2021-003606, Decision on Appeal at 7-8 (PTAB July 26, 2022).) While acknowledging that both references shared a common classification and both disclosed two-stage produce washing systems, the Board found that the challenged patent's field of endeavor was better defined as "the field of washing and sanitizing harvested produce," whereas the prior art's field was "more reasonably stated as the field of preserving produce freshness, especially for use in retail transport, storage and displays." *Id.* at 6-7.

If one were to accept Petitioner's assertion that this single exemplary category places Kester in the field of malware classification, it would mean that Kester is also in the field of "instant messaging" classification, "media player" classification, "gambling" classification, and more than forty other fields of endeavor despite Kester's lack of disclosure as to when or why each of these categories should be applied. (See EX-1004 Fig. 4A.) A POSITA would not have looked to Kester for a determination of whether an object is safe or malware. (EX-2001 ¶¶55, 91.)

As Kester is not directed to a determination of whether an object is safe or malware, and certainly not a "rapid determination," Kester is in a different field of endeavor than that of the '389 patent. *See In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (overruling a determination that patent and prior art were analogous finding

that one's field of endeavor was *storage* of refined liquid hydrocarbons, while the other's field was *extraction* of crude petroleum).

2. **Kester Is Not Reasonably Pertinent To The '389 Patent.**

Kester is also not reasonably pertinent to the problem faced by the '389 patent inventors. (EX-2001 ¶¶82-85.) A reference is reasonably pertinent if "it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Klein*, 647 F.3d at 1348 (internal citations omitted).

As discussed above, the '389 patent sought to improve upon time-consuming prior art methods for determining whether an object was malware or safe, including those that relied on manual or semi-manual detailed analysis of an object and a human administrator to make the determination. (EX-1001 2:9-34 ("However, in each of these prior art proposals, if the file is not known at the central computer, then the whole file is sent to the central computer where it can be analysed to determine whether it should be regarded as safe or malware. Such analysis is typically carried out manually or 'semi-manually' by subjecting the file to detailed analysis, for example by emulation or interpretation, which can still take days given the human involvement that is typically required.").)

A POSITA would not have looked to Kester in considering these problems because Kester itself embodies the same problems the '389 patent sought to solve. (EX-2001 ¶117.) Kester's approach to controlling application files requires that a human reviewer conduct a detailed analysis of each application such as Internet research, determine expected network activity, decide how applications should be categorized, and make policy decisions based on the specific user or workstation. (EX-1004 [0089], [0178]-[0179].) And, as discussed above, Kester contains no disclosure regarding how an application would be determined to be malicious versus safe. Thus, a POSITA would not have looked to Kester as reasonably pertinent to avoiding detailed analysis and need for human decision that slowed down prior art systems in the determination of whether or not an application contained malware. (EX-2001 ¶110.)

Accordingly, Kester is not reasonably pertinent to the particular problem with which the inventor of the '389 patent was involved. *See In re Klein*, 647 F.3d at 1348, 1351-52 (despite both patent and prior art disclosing a partitioned container intended to facilitate mixing of two separated substances, they were non-analogous because neither prior art reference would fulfill the patent's purpose); *In re Clay*, 966 F.2d at 659; *Smith & Nephew, Inc. v. Hologic, Inc.*, 721 F. App'x 943, 949 (Fed. Cir. 2018) ("Even though both [the patent and the reference] ended up with similar

mechanical solutions, it is beyond a stretch to say that [the reference] ‘logically would have commended itself to an inventor’s attention in considering his problem.’”).

As Kester is neither in the same field of endeavor nor reasonably pertinent to the particular problem with which the inventor of the ’389 patent was involved, Kester is non-analogous to the ’389 patent and cannot serve as a primary reference for the petition’s Section 103(a) grounds. (EX-2001 ¶¶82-85.) Accordingly, institution should be denied.

B. The Petitioner Fails To Establish That The Combination of Kester and Kennedy Renders Obvious Every Limitation of The Challenged Claims.

Claim limitations 1.5 and 15.4 each require comparing, by the base computer, the data about the computer object received from the first and second remote computers to other objects or entities to identify relationships between the correlated data and the other objects or entities. (EX-1001, cls. 1, 15.) Petitioner’s grounds do not disclose or render obvious this limitation.

Claim Limitation	Claim Language
[1.5]	<i>“comparing, by the base computer, the correlated data about the computer object received from the first and second remote</i>

	<i>computers to other objects or entities to identify relationships between the correlated data and the other objects or entities”</i>
[15.4]	<i>“the base computer being constructed and arranged to compare the data about the computer object received from the first and second remote computers to other objects or entities to identify relationships between the correlated data and the other objects or entities”</i>

Petitioner's obviousness arguments against claim limitations 1.5 and 15.4 fail because (1) neither Kester nor Kennedy disclose each element of the “comparing” limitation; (2) a POSITA would not be motivated to modify Kester in view of Kennedy; and (3) a POSITA would not expect to succeed in modifying Kester's application and file set tracking. Accordingly, the petition does not have a reasonable likelihood of success and should be denied.

1. Kester and Kennedy Do Not Disclose Each Element Of The “Comparing” Limitation.

For purposes of its preliminary response to the petition, Patent Owner identifies at least one element of the “comparing” limitation that Petitioner fails to show is disclosed in Kester or Kennedy. Specifically, Petitioner does not identify in the cited prior art a “base computer” that performs the claimed comparison. This

missing limitation is alone a sufficient basis for the Board to hold that Petitioner has not met its burden on institution.

In connection with limitation 1.1, Petitioner argues that Kester's "server module and/or application database factory" is a "base computer." (Petition 14 ("Kester teaches a base computer (application server module 102 and/or application database factory 110)...").) But for limitation 1.5, Petitioner does not argue that Kester's application server module and/or application database factory performs the comparison step. Instead, Petitioner acknowledges that Kester describes "a ***network administrator***" who "interface[s] with the application server module 102" to perform the comparison. (Petition 26 (emphasis added).) That is not what the claims require. The claims explicitly require that the "base computer"—and not a human "network administrator"—perform the comparison.

Although Petitioner relies in part on Kennedy for the "comparing" limitations, it does not identify any disclosure in Kennedy of a "base computer." Relatedly, therefore, Petitioner cannot identify any disclosure in Kennedy of a "base computer" that performs the claimed comparison. This is confirmed by Petitioner's description of a hypothetical "combined method/system" based on Kester and Kennedy. Petitioner expressly relies on the "server module and/or database factory" in Kester (as opposed to any disclosure in Kennedy) for the claimed comparison. (Petition at 29

(“In the combined method/system, the application’s file set behavior is collection data that is sent to the *server module and/or database factory* such that when the comparison of this collection data to other objects indicates the application is related to known malware, Kennedy’s automated heuristics can classify the application appropriately as malware.”).) However, as addressed above, Petitioner has acknowledged that in Kester, the comparison is not performed by the “server module and/or database factory” (or “base computer”), but rather by a network administrator. (Petition 26.)

Moreover, even if a POSITA considered modifying Kester by adding Kennedy’s automated heuristics, the resulting system would still require a human administrator to analyze the output of Kennedy’s automated heuristics to perform the comparison step, and would thus not teach the claimed comparison by the base computer. Put simply, the recited “comparison” is performed by a human administrator and is not “by the base computer” as claimed. (EX-2001 103.)

Petitioner cannot identify any “comparing” limitation that is performed “by the base computer” in Kester. Any “comparison” identified in Kester is performed mentally and manually by a network administrator. Given the absence of this element from the prior art relied upon in all grounds of the petition, Petitioner does not have a reasonable likelihood of success on the merits and should be denied.

2. **A POSITA Would Not Be Motivated to Combine Kester and Kennedy, or Have Had a Reasonable Expectation of Success Modifying Kester in View of Kennedy, to Perform the “Comparing” Step.**

“It [is] petitioner’s burden to demonstrate both that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.* , 821 F.3d 1359, 1367-68 (Fed. Cir. 2016) (internal quotation and citation omitted). Here, Petitioner fails to carry its burden for each of these obviousness requirements.

a) **A POSITA Would Not Be Motivated to Combine Kester with Kennedy Because Kester’s Human Administrator is Incompatible with Kennedy’s Alleged Automation**

As discussed above, the claimed invention would not be achieved even if a POSITA combined Kester with Kennedy. (*See* Section VI.B.1, *supra*.) Moreover, a POSITA would not have looked to the teachings of Kennedy and been motivated to modify Kester in the first place. Kester’s workstation- and application-specific management is incompatible with Kennedy’s heuristics and file set tracking modules that merely check whether a logical condition is satisfied.

Kester's comparison step depends on, and requires, manual human analysis. *See, e.g.*, EX-1004 Fig. 10 block 1006 ("Human Review of Application to Classify Application"); Fig. 13 block 1306 ("Human Reviewer Uses Hints and Web Information to research Application"); Fig. 17 block 1706 ("Human Review of Application to Determine Allowed Behavior"); Fig. 20 block 2006 ("Human Reviewer Uses Hints and Web Information to Research Network Access by Application"). Attempting to use Kennedy to eliminate the role of the human reviewer in the comparison process is contrary to the teachings of Kester. *See Polaris Indus, Inc. v. Artic Cat, Inc.*, 882 F.3d 1056, 1067-1070 (Fed. Cir. 2018) ("[E]ven if a reference is not found to teach away, its statements regarding preferences are relevant to a finding regarding whether a skilled artisan would be motivated to combine that reference with another reference.").

In addressing this limitation, Petitioner argues that a POSITA would have combined Kester and Kennedy to "predictably improve the system/method's ability to detect suspicious behavior of different but related files" and "to identify the types of rogue program threats *Kester* was designed to mitigate more effectively." (Petition 30–31). But Petitioner ignores Kester's requirement for a human analyst, and thus disregards the benefits of manual analysis and the negative consequences of automating Kester's manual analysis.

Kester teaches that manual analysis improves accuracy of application classifications across many remote workstations. In Kester, a human reviewer determines expected network activity and applicable categories within the context of a variety of information from many remote workstations, while keeping in mind that access privileges will be “unique...for the workstation 101 and/or user.” (EX-1004 [0042], [0090], [0180]-[0186]; EX-2001 ¶¶109-112.)

This human review includes conducting independent research about applications in order to improve the accuracy of Kester's application classification. (*See, e.g.*, EX-1004 [0135] (“The process continues to a state 1306 where the human reviewer uses the application, related information, and any Internet information to re-search the application. The internet information can be derived from a search using a web browser search engine The human reviewer can further review documents, specifications, manuals, and the like to best determine the category or categories to associate with the application.”); [0187] (describing “the human reviewer” “using the evidence associated with the application, any hints from related information, and/or other research” to determine the allowed behavior for an application); *see also* [0089] (“A human reviewer interacts with the application analyst's classification module 302 to perform the categorization or recategorization.”); [0093] (“[T]he application analyst classification module 302 accesses the Internet 108 and performs

a search based on the application and the collection data . . . The Internet search can provide the application analyst's classification module 302 with additional information for categorizing the application.”).

By contrast, Kester's accuracy with respect to determining expected network activity and applicable categories in the context of information received from many remote workstations would be compromised, not improved, by Kennedy's heuristic models. In Kennedy, the MSDM is also the decision-maker that determines whether to classify an object as malware. (EX-1005 5:64-6:4 (“If the files in the set either individually or collectively engage in behavior indicated that the software is malicious, in one embodiment, the MSDM 212 declares 418 that the software is malicious and notifies the end-user, quarantines the software, blocks the software from performing certain activities, and/or perform other actions.”); EX-2001 ¶¶110-111.) The MSDM executes locally on a computer system and “monitors a storage device of the computer system for the arrival of software from a suspicious portal.” (EX-1005 1:45-48.) As such, Kennedy uses a fixed set of protocols on a closed universe of information to determine whether a file's behavior indicates it is malware. (EX-1005 5:4–6:10 (describing implementation of the heuristics); *see, e.g., id.* at 5:13–20 (“In one embodiment, a heuristic is designed to detect a computer worm infection like that illustrated in FIG. 2. According to this heuristic, software is malicious if it

attempts to copy itself to another computer system via a technique such as email and/or an open drive share. The heuristic is satisfied if a file in a set attempts to send a copy of itself and/or any other file in the same set to the other computer system.”)

Kennedy thus introduces at least two shortcomings that compromise the accuracy of Kester's human analysis. One, Kennedy is limited to a closed universe of info on a single system and does not consider information shared across many remote workstations. Two, Kennedy's heuristics invoke a one-size-fits-all approach to analysis that prevents the individualized, case-by-case analysis enabled by Kester's manual review.

Kester and Kennedy thus employ conflicting approaches to the comparison limitation of the challenged claims, *i.e.*, incorporating simple automated heuristics versus applying an in-depth manual analysis. A POSITA therefore would understand that Petitioner's proposed combination obviates the benefit of a human administrator's external research for this comparison. *See Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 F. App'x 755, 758 (Fed. Cir. 2015) (holding “combinations that change the basic principles under which the prior art was designed to operate or that render the prior art inoperable for its intended purpose, may fail to support a conclusion of obviousness.”) (internal quotations and citations omitted)

Further, during prosecution of the related '250 patent (from which the '389 is a continuation and to which it claims priority), the applicant argued that it would not have been obvious to automate the human determinations disclosed by Kester because “[i]t is [] essential to have the Network Administrator review each program for each user to decide what policy is appropriate for their company.” (EX-2019 739-740.)

Kester does not suggest use of tools like Kennedy's heuristics at all for the administrator's determination of expected network activity. (*See* Section V.A., *supra*.) Automation of these steps within Kester would remove the control that Kester provides to determine application-specific policies across a wide variety of applications and workstations. (EX-1004 Abstract, [0006]-[0007], Fig. 4A; EX-2019 739-740.) In other words, the workstation- and application-specific control provided by Kester's workstation- and application- specific policies could not be achieved with Kennedy's heuristics, which merely check if a logical condition is satisfied. (*See* EX-1005 5:4–6:10.) Thus, Kester does not suggest, and a POSITA would not consider, automating Kester's determination of expected network activity or categorization of applications. (EX-2001 ¶115.) Accordingly, a POSITA would not be motivated to combine Kennedy with Kester in order to practice this limitation. (EX-2001 ¶116.)

b) A POSITA Would Not Expect to Succeed in Modifying Kester with Kennedy's Automated Classification Heuristics Because Kester Embodies the Problem Addressed by the '389 Patent

Petitioner provides no analysis of *how* a POSITA would combine Kester and Kennedy's teachings to practice the comparison limitation. (EX-2001 ¶¶117-120.) As a result, Petitioner overlooks the practical challenges a POSITA would encounter if attempting to combine Kester with Kennedy. Specifically, Petitioner does not address whether, or how, a POSITA would incorporate Kennedy's MSDM heuristics on every remote computer within Kester's network architecture; *or*, if somehow Kennedy's computer-specific MSDM heuristics could be integrated within Kester's centralized computer architecture. Petitioner fails to explain how a POSITA could successfully combine Kester and Kennedy without sacrificing the degree of control and accuracy that Kester's technique provides, or otherwise contend with the practical challenges associated with combining two very different approaches. Thus, Petitioner fails to show a POSITA would have a reasonable expectation of success combining Kester with Kennedy. *See Auris Health, Inc. v. Intuitive Surgical Operations, Inc.*, 2022 WL 1419593, at *4 (Fed. Cir. May 5, 2022) (for claims directed to performing robotically-assisted surgery using a master control, affirming the Board's determination that petitioner failed to demonstrate a reasonable

expectation of success modifying the prior art to arrive at the claimed invention where the patentee identified unaddressed practical challenges with modifying the prior art.)

Kennedy's MSDM application contains the file set tracking and behavior monitoring modules, but the MSDM resides on a user computer—not a base computer—and Kennedy's malware heuristics and file set tracking look only at the computer objects on that single user computer. (EX-1005 1:45-48 (“The MSDM executes on a computer system connected to a network. The MSDM runs on a computer system and ‘monitor a storage device of the computer system for the arrival of software from a suspicious portal.’”); *see also* Section V.B., *supra*.) Petitioner fails to address how, or even where, the MSDM could be incorporated into Kester's computer architecture, or explain how to reconfigure the MSDM within Kester in order to identify relationships with “other objects.”

Petitioner argues that a POSITA would have a reasonable expectation of success “using known methods with no change to their respective functions” (Petition 31) and that since “file set tracking and behavior monitoring was a well known-way to detect the presence of malware, there would have been a reasonable expectation of success configuring *Kester*'s application file monitoring system/method to perform *Kennedy*'s file set tracking and behavior monitoring.” *Id.* However, as

explained in the preceding section, a POSITA would understand that Petitioner's proposed combination to automate the comparison step obviates Kester's claimed benefit of a human administrator's external research and analysis for this comparison. (EX-2001 ¶120; *see Auris Health, Inc.*, 2022 WL 1419593, at *4 (Fed. Cir. May 5, 2022) (rejecting petitioner's argument that "a skilled person would have used common sense to engage or disengage Borst's 'control robotic instruments' from the surgical end effectors' given that 'this functionality was well known' at the time 'and described in many prior art references'"); *see also* MPEP §2143.01("if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification")) Thus, there would have been no likelihood of success modifying Kester in view of Kennedy to practice the comparison limitation.

Accordingly, Petitioner has not shown that such a combination would render obvious claim limitations 1.5 and 15.4.

C. Petitioner's Grounds Fail To Render Obvious All Dependent Claims.

Because Petitioner has failed to establish that any of its grounds render obvious all limitations of the independent claims, Petitioner cannot show that such grounds render obvious dependent claims 2-14 and 16-30.

D. Other Limitations Not Addressed.

At this preliminary stage, Patent Owner addresses those deficiencies in the prior art which clearly show a lack of reasonable likelihood of the petition's success. Patent Owner's decision not to address certain limitations at this preliminary stage in no way reflects Patent Owner's agreement with the petition or lack of dispute as to additional limitations.

E. There Are Secondary Objective Indicia Of Nonobviousness.

Patent Owner contends that secondary objective indicia of nonobviousness exist and reserves its right to provide evidence on this point, should the Board institute. (EX-2001 ¶162.)

VII. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Date: June 16, 2023

Respectfully submitted,

KING & SPALDING LLP

/Brian Eutermoser/

Brian Eutermoser
Registration No. 64,058

Attorney for Patent Owner
Open Text Inc.

CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PA-
TENT OWNER PRELIMINARY RESPONSE** specified in 37 C.F.R. § 42.24
have 13,130 words, in compliance with the 14,000 word limit set forth in 37 C.F.R.
§ 42.24. This word count was prepared using Microsoft Word version 2202.

Date: June 16, 2023

Respectfully submitted,

KING & SPALDING LLP

/Brian Eutermoser/

Brian Eutermoser
Registration No. 64,058

Attorney for Patent Owner
Open Text Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** and all supporting **EXHIBITS 2001-2019** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as sent via Federal Express on June 16, 2023 and courtesy copies were also served via electronic mail, in their entireties on the following:

Adam P. Seitz (Reg. No. 52,206)
Adam.Seitz@eriseip.com
Hunter A. Horton (*pro hac vice to be submitted*)
Hunter.horton@eriseip.com
ERISE IP, P.A.
7015 College Blvd., Suite 700
Overland Park, Kansas 66211
Telephone: (913) 777-5600
Fax: (913) 777-5601

*Counsel for Petitioner
CrowdStrike, Inc.*

Date: June 16, 2023

Paul R. Hart, (Reg. No. 59,646)
Paul.Hart@eriseip.com
ERISE IP, P.A.
5299 DTC Blvd., Suite 1340
Greenwood Village, CO 80111
Telephone: (913) 777-5600
Fax: (913) 777-5601

KING & SPALDING LLP

/Brian Eutermoser/

Brian Eutermoser
Registration No. 64,058

Attorney for Patent Owner
Open Text Inc.