

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOPHOS LTD. AND SOPHOS INC.
Petitioners,

v.

OPEN TEXT INC.,
Patent Owner.

Case No. IPR2023-00633
U.S. Patent No. 8,726,389

Petitioner's Reply to Patent Owner's Preliminary Response

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

Pursuant to the Board’s authorization of August 10, 2023 (Ex. 1014), Petitioner hereby submits this reply pursuant to 37 C.F.R. § 42.23.

I. Patent Owner Mischaracterizes the Record

In its POPR, Patent Owner accuses Petitioner of making “factually incorrect statements regarding the complete prosecution history” and submitting an “incomplete” prosecution history in support of its petition. POPR, 32. Patent Owner claims that “Exhibit 1002 omits the European Search Report in which Halperin ’490 (EX-2011) was discussed.” *Id.* Patent Owner’s suggestion that Petitioner purposefully submitted an incomplete record is misleading. *Id.*

What Patent Owner omits is that the file history available from the Patent Office’s website does not contain the search report that Patent Owner asserts Petitioner did not provide to the Board. Petitioner obtained the entire file history as it was available from the Patent Office’s website, which it does for any Petition, and submitted it with the Petition. There was no intent to omit. Indeed, Petitioner specifically noted that Halperin ’490—an “earlier-filed, abandoned” application not presented in this Petition—was before the Patent Office. Petition, 73–74 n.5 (explaining that although primary reference Halperin (Ex. 1006) was “not mentioned by the patentee during prosecution, nor otherwise cited by the Examiner during prosecution,” Halperin had a similar specification to Halperin ’490, which “was cited in the final [IDS] submitted at the end of the prosecution of the ’389 Patent.”).

Furthermore, the extent of the European Examiner’s discussion of Halperin ’490 was that it “appear[ed] to be very relevant for the claimed subject-matter,” but that “[d]ue to added subject-matter and clarity issues, the claims *[could not] be assessed* for [the] novelty/inventive step,” and did not perform any analysis, advance any arguments, or consider Halperin ’490 in any combinations. EX-2018, 225 (emphasis added). Step 1 of the *Advanced Bionics* framework—asking 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—is therefore not met, and the Board should not exercise its discretion to deny institution. *REG Synthetic Fuels, LLC v. Neste Oil, Oyj*, IPR2018-01375, 13 (PTAB February 19, 2019) (Paper 11) (collecting cases); *see also DJI Europe B.V. v. Textron Innovations, Inc.*, IPR2022-00453, 11–12 (PTAB August 3, 2022) (Paper 10).

Given Petitioner’s deliberate and specific discussion of Halperin ’490 in the Petition and regular practice of providing the file history as it is available from the Patent Office’s website and the European Examiner’s mere identification of Halperin ’490 as relevant and superficial discussion of its subject matter, both of Patent Owner’s suggestions that Petitioner intended to mislead the PTAB and that the same prior art disclosure was before the Office are incorrect.

DATED: August 18, 2023

Respectfully Submitted,

By: /s/ Benjamin Hershkowitz

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CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), (b) on the Patent Owner via electronic mail delivery of a true copy of the foregoing document to lead and backup counsel of record for Patent Owner as follows:

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