

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOPHOS LTD. & SOPHOS INC.,

Petitioners,

v.

OPEN TEXT INC.,

Patent Owner.

Case IPR2023-00633

Patent No. 8,726,389

PATENT OWNER'S PRELIMINARY SUR-REPLY

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

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<i>BMW of N. Am., LLC v. Stragent, LLC</i> , IPR2021-00418, Paper 19 (PTAB Mar. 21, 2022)	2
<i>Nespresso USA, Inc. v. K-Fee Sys. GMHB</i> , IPR2021-01222, Paper 9 (PTAB Jan. 18, 2022)	1

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EXHIBIT LIST

Exhibit	Description
2001	Declaration of Professor Nenad Medvidovic, Ph.D.
2002	<i>Curriculum Vitae</i> of Nenad Medvidovic, Ph.D.
2003	<i>Webroot, Inc. and Open Text Inc., v. Sophos LTD</i> , Case No. 6:22-cv-240-ADA-DTG, Complaint (W.D. Tex Mar. 4, 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	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
2008	U.S. District Courts – Combined Civil and Criminal Federal Court Management Statistics (Mar. 31, 2023), <i>available at</i> https://www.uscourts.gov/statistics/table/na/federal-court-management-statistics/2023/03/31-1
2009	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Order Granting Fourth Amended Scheduling Order, Dkt. 160 (W.D. Tex. Jan. 22, 2023)
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	U.S. Patent Application Publication No. 2002/0194490 (Halperin ’490)
2012	<i>Webroot, Inc. and Open Text Inc., v. Sophos LTD</i> , Case No. 6:22-cv-240-ADA-DTG, Scheduling Order, Dkt. 54 (W.D. Tex. Aug. 8, 2022)

Patent Owner's Preliminary Sur-Reply to
Petition for *Inter Partes* Review
Patent No. 8,726,389

Exhibit	Description
2013	<i>Webroot, Inc. and Open Text Inc., v. Forcepoint LLC</i> , Case No. 6:22-cv-00342-ADA-DTG, Defendant'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. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Defendant's Preliminary Invalidity Contentions Appendix A (W.D. Tex., Sept. 14, 2022)
2017	<i>Webroot, Inc. and Open Text Inc., v. CrowdStrike, Inc. and CrowdStrike Holdings, Inc.</i> , Case No. 6:22-cv-00241-ADA, Defendant's Preliminary Invalidity Contentions (W.D. Tex., Sept. 13, 2022) (excerpted)
2018	U.S. Patent 8,726,389 Certified File History
2019	July 13, 2022 Email from Jennifer Inghram of King & Spalding
2020	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Joint Defendants' Opening Claim Construction Brief, Dkt. 86 (W.D. Tex., Oct. 28, 2022)
2021	U.S. Patent and Trademark Office, General USPTO Customer Information, https://www.uspto.gov/ebc/pair/pair_faq_pt_general.html#certifiedcopy
2022	U.S. Patent and Trademark Office, Order Certified Copies, https://www.uspto.gov/patents/apply/checking-application-status/order-certified-copies

Patent Owner submits this sur-reply in support of its request that the Board exercise its discretion to deny institution under 35 U.S.C. § 325(d). (Ex. 1014.)

A. The Same Prior Art Was Previously Presented to the USPTO

Petitioner's sole, conclusory argument regarding step 1 of the *Advanced Bionics* framework is that the European Examiner "did not perform any analysis, advance any arguments, or consider Halperin '490 in any combinations." (Paper 15 2.) The Board should reject this argument as both wrong and irrelevant.

Petitioner's argument is wrong because the European Examiner plainly did analyze Halperin '490. The search report identifies specific features of Halperin '490—along with pinpoint citations—considered to be "very relevant for the claimed subject-matter." (EX-2018 225). Regardless, Petitioner's argument is irrelevant because *Advanced Bionics* does not require a particular level of detail in the examiner's analysis. When the "same or substantially the same *prior art*" previously was presented to the Office, the Board "need not reach whether the 'same or substantially the same *arguments*' previously were presented to the Office." *Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GMBH*, IPR2019-01469, Paper 6 at 20 (PTAB Feb. 13, 2020) (*precedential*) (emphasis added); *Nespresso USA, Inc. v. K-Fee Sys. GMHB*, IPR2021-01222, Paper 9 at 11-12 (PTAB Jan. 18, 2022) (denying institution where the petitioned prior art was presented in examiner-initialed IDS). Petitioner does not dispute that Halperin and Halperin '490

are identical in relevant disclosure. (Paper 13 (“POPR”) 33-34.) Petitioner also does not dispute that the U.S. Examiner initialed Halperin ’490 and the search report analysis in an IDS (POPR 32-33 (citing EX-2018 259)), indicating his consideration.

Petitioner’s reply does not advance any argument that the Examiner erred in issuing the ’389 patent over Halperin ’490, and he did not. (POPR 36-38.) “[I]t is Petitioner’s burden to show error....” *See BMW of N. Am., LLC v. Stragent, LLC*, IPR2021-00418, Paper 20 at 6-7 (PTAB Mar. 21, 2022). Therefore, denial is warranted.

B. Petitioner Omitted the Complete File History

Petitioner argues that it had “no intent to omit” portions of the prosecution history in its petition. (Paper 15 1.) However, Petitioner does not dispute that it was in possession of the certified file history that included the search report and examiner-initialed IDS (POPR 32), but instead submitted an uncertified version that omitted those key documents. (*See* EX-2021; EX-2022 (distinguishing between a “certified file wrapper” and “electronic uncertified copies”).) Notably, the omitted documents contradict Petitioner’s factually incorrect assertion that the Examiner did not consider Halperin ’490 during prosecution. (Petition 74, n.5; POPR 32-33.) Regardless of Petitioner’s intent, the omitted documents strongly support denial of institution under *Advanced Bionics*.

Patent Owner's Preliminary Response to
Petition for *Inter Partes* Review
Patent No. 8,726,389

Date: August 25, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER PRELIMINARY SUR-REPLY** and all supporting **EXHIBITS 2021-2022** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS), on August 25, 2023 and courtesy copies were also served via electronic mail, in their entireties on the following:

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