

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO, INC.,
Petitioner,

v.

OPEN TEXT, INC.,
Patent Owner.

IPR2023-00657 (Patent 10,257,224 B2)
IPR2023-00662 (Patent 10,599,844 B2)
IPR2023-00677 (Patent 9,578,045 B2)
IPR2023-00692 (Patent 10,284,591 B2)¹

Before PATRICK M. BOUCHER, KRISTINA M. KALAN,
MICHELLE N. WORMMEESTER, and AARON W. MOORE,
*Administrative Patent Judges.*²

KALAN, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order applies to each of the above-captioned proceedings, and we exercise our discretion to issue one Order to be filed in each proceeding. The proceedings have not been consolidated, and the parties are not authorized to use this style heading in any subsequent papers.

² This is not an expanded panel. Judges Boucher, Wormmeester, and Moore are on the panel for IPR2023-00657, IPR2023-00662, and IPR2023-00677, and Judges Kalan, Wormmeester, and Moore are on the panel for IPR2023-00692.

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On September 21, 2023, Petitioner emailed the Board in each of the above-captioned proceedings, requesting permission to file a *Sotera*-style stipulation in each proceeding. Ex. A (email sent to the Board in IPR2023-00692; similar emails were sent in the other captioned proceedings and are entered as exhibits in their respective proceedings). Petitioner does not indicate whether this request is unopposed, but, to date, Patent Owner has not contacted the Board opposing this request.

“A petitioner may seek leave to file a reply to the preliminary response” and “[a]ny such request must make a showing of good cause.” 37 C.F.R. § 42.108(c) (2022).

Petitioner requests to file a *Sotera* stipulation in each of the above-captioned proceedings to address arguments in Patent Owner’s Preliminary Response that we should exercise discretion under 35 U.S.C. § 314(a) to deny institution of the Petition based on parallel district court litigation. *See* Ex. A; *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”)); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (declining to apply *Fintiv* to deny institution based on petitioner’s stipulation not to pursue in the district court any ground that was raised or could have been reasonably raised in an IPR).

In *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 (PTAB Sept. 7, 2022) (precedential), the Director permitted filing a stipulation related to *Fintiv* prior to the Board’s decision of whether to institute review.

We have discretion to permit filing a stipulation at this stage, prior to institution. We authorize Petitioner to file a one-page *Sotera* stipulation as

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an exhibit in each of the above-captioned cases. The exhibit should not include any argument.

ORDER

It is, therefore,

ORDERED that Petitioner may file a one-page *Sotera* stipulation as an exhibit in each of the above-captioned cases within one week of the entry of this Order.

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EXHIBIT A

From: Bob Hansen <BHansen@MARBURLAW.COM>
Sent: Thursday, September 21, 2023 5:22 PM
To: Trials <Trials@USPTO.GOV>
Cc: beutermoser@kslaw.com; rblythe@kslaw.com;
mikaela.stone@kslaw.com; Scott B. Amankwatia
<samankwatia@MARBURLAW.COM>; Matthew Anderson
<MAnderson@MARBURLAW.COM>
Subject: IPR2023-00692 - Request for permission to file a *Sotera*
Stipulation

CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE
SOURCE before responding, clicking on links, or opening attachments.

Dear Board,

I am writing as lead counsel for Petitioner Trend Micro, Inc. in IPR2023-00692 (regarding U.S. Patent No. 10,284,591), filed March 7, 2023. We seek the Board's permission to submit a *Sotera* stipulation to be considered as part of the filed Petition.

We believe that this stipulation will not unduly prejudice the patent owner because the stipulation limits the scope of grounds that Petitioner will raise in the parallel District Court proceedings. If the *Sotera* stipulations are entered it will mitigate concerns of potentially conflicting decisions and duplicative efforts between the District Court and the Board. We believe the *Sotera* stipulation should be entered at this time because the Board has not made an institution decision.

Therefore, Petitioner requests permission to submit a *Sotera* stipulation as presented on the attached draft submission.

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Thank you for considering this request. We will await your guidance and instructions.

Best Regards,
Bob Hansen
Reg. No. 43,656
Lead Counsel for Petitioner, Trend Micro, Inc.

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