

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 IPR2023-00731

Patent No. 8,201,243

PATENT OWNER'S PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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EXHIBIT LIST

Exhibit	Description
2001	Declaration of Professor Ron Schnell
2002	<i>Curriculum Vitae</i> of Professor Ron Schnell
2003	<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)
2004	<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)
2005	<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)
2006	<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)
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	<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)
2009	U.S. District Courts—Federal Court Management Statistics—Profiles—During the 12-Month Periods Ending March 31, 2018

Exhibit	Description
	Through 2023, “Table N/A—U.S. District Courts—Combined Civil and Criminal Federal Court Management Statistics (March 31, 2023)”, available https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_dlistprofile0331.2023.pdf
2010	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, July 25, 2023 Claim Construction Order, Dkt. 391 (W.D. Tex. July 25, 2022)
2011	<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., Feb. 21, 2023) (excerpted)
2012	<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., Feb. 21, 2023) (excerpted)
2013	<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 C (W.D. Tex., Feb. 21, 2023) (excerpted)
2014	Website: About ResearchGate, https://www.researchgate.net/about
2015	Website: “Google Announces Beta Release of Google Scholar,” Univ. of Calif. (Nov. 17, 2004); <i>available</i> https://osc.universityofcalifornia.edu/2004/11/google-announces-beta-release-of-google-scholar/

Open Text Inc. ("Patent Owner") submits this Preliminary Response to the Petition of Sophos Ltd and Sophos Inc. ("Petitioners") seeking inter partes review ("IPR") of U.S. Patent No. 8,201,243 ("the '243 patent").

I. INTRODUCTION

The Board should decline to institute IPR of the '243 patent because the petition (1) duplicates the parties' district court litigation efforts and (2) is otherwise a weak petition that relies on non-analogous prior art as a primary reference in all grounds and fails to establish a reasonable likelihood of obviousness.

First, the Board should deny institution under *Fintiv* because instituting this IPR would undermine Congress's stated goals in creating IPR proceedings: to provide "quick and cost effective alternatives to litigations" and "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. An IPR here would be neither quicker than, nor an alternative to, ongoing district court litigation. The Western District of Texas ("WDTX") is scheduled to proceed to trial on the '243 patent almost three months *before* a final written decision on the petition would be due—so an IPR is not quicker. And, the district court has indicated it will not issue a stay when, as here, it can resolve the same issues prior to the Board—so an IPR is not an alternative to litigation. Moreover, other defendants have asserted the same prior art raised in the petition, which

the district court must address regardless of whether the Board institutes an IPR. Therefore, instituting an IPR would generate the unnecessary and counterproductive litigation costs that Congress sought to avoid.

Second, the Board should deny institution for the additional reason that Petitioners fail to demonstrate a reasonable likelihood that it will prevail on the merits. The '243 patent discloses a pestware monitoring and identification system that identifies an externally networked source from which a suspected pestware object originated and reports the source to an externally networked research entity. But none of the art on which Petitioners rely teaches or suggests those ideas. Instead, the cited art discloses identifying internal files or directories from which the pestware originated and alerting a human administrator that the internal file or directory shows signs of a malware infection. Because none of the cited art suggests identifying the externally networked source of a pestware object, let alone reporting that source to an external, networked research entity, the petition is not reasonably likely to succeed and must therefore be denied.

Patent Owner respectfully requests that the Board deny the petition.

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

The '243 patent is one of dozens of patents asserted in claims and counter-claims among six different parties in a series of cases pending in the Western District

of Texas. The district court has already issued its claim constructions and is on track to adjudicate the same prior art raised in the petition months before the Board issues a final written decision. Institution of a parallel IPR proceeding lagging well behind the district court would needlessly increase the cost of resolving the underlying dispute. Under these circumstances, the Board should exercise its discretionary authority to deny institution under 35 U.S.C. § 314(a).

Because Congress's goal in enacting post-grant proceedings like IPRs was "to ... limit unnecessary and counterproductive litigation costs," Director Vidal has instructed the Board not to institute IPRs that would "increase, rather than limit, 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).

Instituting this IPR would cause just such an increase. A district court stay is out of the question, and the district court will consider the very same arguments presented in the petition. Accordingly, for the next year, the Board and the district court will labor to decide the very same issues with the district court well ahead of—and scheduled to reach a final decision months before—the Board. The year-long parallel tracks of two adjudicatory bodies will "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 at 1. This is precisely the situation that Director Vidal sought 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 Mar. 20, 2020).

Confirming this conclusion, every one of the *Fintiv* factors weighs for discretionary denial:

- (1) A stay of the co-pending district court litigation—involving 39 patents and five defendants—is vanishingly unlikely. Petitioners cannot avoid that trial because it has petitioned for IPR of only some of the patents asserted against it. And this IPR will similarly not narrow the issues on which discovery and trial must proceed—the '243 patent is currently asserted against four other defendants, three of whom have not petitioned for IPR of the '243 patent. Moreover, none of Petitioners' codefendants have agreed not to litigate the validity of the '243 patent in the district court if the Board institutes this IPR.
- (2) Trial in the district court is expected almost three months before a final written decision. The district court case remains on track. The claims of the '243 patent have been construed, and discovery is well underway.

- (3) The parties and district court have already invested heavily in carrying the parallel litigation past claim construction and well into discovery.
- (4) The issues raised in the petition are the same as those the district court has before it, and Petitioners' narrow stipulation will not change that because the stipulation does not apply to all of Petitioners' co-defendants, who have raised the same prior art before the district court.
- (5) Petitioners will get their chance to make its arguments before the district court because Petitioners are defendants in the parallel litigation.
- (6) As shown below, the petition's grounds of unpatentability are weak.

Thus, every *Fintiv* factor here weighs for discretionary denial. The district court is well on its way to an efficient resolution of the disputes between Patent Owner, Petitioner, and Petitioners' codefendants. Both the goals of the AIA and the general welfare of the patent system would be best served by denying institution.

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

The first *Fintiv* factor asks "whether [1.] the court granted a stay or [2.] evidence exists that one may be granted if a proceeding is instituted." *Fintiv*,

IPR2020-00019, Paper 11 at 6.¹ Here, the undisputed answer to both questions is *no*: no stay has been requested or ordered, and Petitioners have identified no evidence that one will (or even might) be. To the contrary, specific evidence indicates that a stay is unlikely.

First, the district court considers issue simplification “the most important factor” in deciding whether to stay patent litigation²—and here, a stay would not

¹ The decision in *Fintiv* addresses various scenarios that may indicate whether a stay may be granted. *Fintiv*, IPR2020-00019, Paper 11 at 6-9. However, nothing in *Fintiv* suggests that these are the only scenarios that a panel may consider. In particular, *Fintiv* does not hold that an actual denial of a stay is the only consideration relevant to this factor. Rather, *Fintiv* contemplates that any type evidence may be relevant. For example, *Fintiv* holds that one way to “support the arguments that ... a stay may be less likely, and instituting would lead to duplicative costs” is to show the “work completed by the parties and court in the parallel proceeding.” *Fintiv* IPR2020-00019, Paper 11 at 10.

² See, e.g., EX-2003, *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

simplify anything. The validity of the '243 patent will be litigated in the consolidated action, whether this petition is instituted or not, because the patent is asserted against four other defendants, none of whom have promised not to pursue invalidity in the district court based on this institution decision.

Moreover, the validity of the '243 patent will be litigated in the district court alongside issues regarding 38 *other* patents asserted by and against Petitioners and *four other* defendants—issues that the district court is highly unlikely to delay deciding in favor of letting the Board proceed with *this* IPR. The case against Petitioners alone involves twenty patents—thirteen asserted by Patent Owner and seven asserted in counterclaims by Petitioners.

Court had already held a *Markman* hearing and “expended significant resources”); EX-2004, *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-2005, *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).

The table below illustrates the patents, parties, and IPR petitions involved in this highly complex litigation.

**Table 1. Patent Owner's Asserted Patents
Against Each WDTX Defendant and Resulting Review Petitions**

Patent	Kaspersky	CrowdStrike	Forcepoint	Sophos	Trend Micro
8,201,243	Asserted; no IPR	IPR2023-01052	Asserted; no IPR	IPR2023-00731	Asserted; no IPR
8,719,932	Asserted; no IPR	IPR2023-01051	Asserted; no IPR	IPR2023-00732	Asserted; no IPR
8,418,250	Asserted; no IPR	IPR2023-00289	N/A	IPR2023-0699	IPR2023-00655
8,726,389	Asserted; no IPR	IPR2023-00556	Asserted; no IPR	IPR2023-00633	Asserted; no IPR
10,599,844	Asserted; no IPR	Asserted; no IPR	Asserted; no IPR	IPR2023-00528	IPR2023-00662
9,413,721	N/A	N/A	Asserted; no IPR	IPR2023-00491	N/A
9,578,045	IPR2023-01199	IPR2023-00124	N/A	Asserted; no IPR	IPR2023-00677
10,257,224	IPR2023-01011	IPR2023-00126	N/A	Asserted; no IPR	IPR2023-00657
10,284,591	IPR2023-00895	IPR2022-01522	N/A	Asserted; no IPR	IPR2023-00692
8,856,505	Asserted; no IPR	IPR2023-01159	N/A	Asserted; no IPR	Asserted; no IPR
8,181,244	N/A	IPR2023-01158	N/A	Asserted; no IPR	Asserted; no IPR
11,409,869	IPR2023-01160	IPR2023-01053	Asserted; no IPR	PGR2023-00031	Asserted; no IPR
8,763,123	N/A	IPR2023-1050	N/A	Asserted; no IPR	N/A
8,438,386	N/A	N/A	IPR2023-00784	N/A	N/A

Patent	Kaspersky	CrowdStrike	Forcepoint	Sophos	Trend Micro
10,025,928	N/A	N/A	IPR2023-00786	N/A	N/A

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-2006 52.)

Second, the district court has been clear in public comments that it will not stay cases where, as here, the court can resolve the case as quickly as the Board can:

[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-2007 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. (EX-2007 37.) On that timeline, trial is expected in this case in mid-July 2024. Trial is currently scheduled for August 2024. (EX-2008 6.) The deadline for a final written decision in an IPR here would not be until many months later (in November 2024). That Judge Albright has made public comments indicating that his practice is to deny a stay in precisely the

circumstances presented here is further evidence that he would not stay the WDTX case in response to institution of this IPR.

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 show that “a stay ... is unlikely.” *Nintendo Co. v. Gamevice, Inc.*, IPR2020-01197, Paper 13, at 11-12 (PTAB Jan. 12, 2021); *Samsung Elecs. Co. v. Clear Imaging Research LLC*, IPR2020-01399, Paper 13 at 11-12 (PTAB Feb. 3, 2021) (holding 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”); *Motorola Mobility LLC v. Ironworks Patents, LLC*, IPR2021-00421, Paper 11 at 7-8 (PTAB July 22, 2021).

In sum, the district court has not granted a stay and there is no evidence suggesting that the district court would grant a stay of a multi-patent, multi-defendant case so that the Board can reach a decision months *after* the current trial date on *just one* patent. Factor 1 weighs in favor of discretionary denial. *Samsung*, IPR2020-01399, Paper 13 at 11-12; *Motorola*, IPR 2021-00421, Paper 11 at 7-8.

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

Factor 2—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.

Here, an IPR 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-2008 6.) Should the Board institute, its final written decision deadline would be November 10, 2024, nearly three months after the scheduled trial date.

In other words, the IPR proceedings will not produce a result before the trial, and the parties will spend a year expending precisely the “duplicative,” “unnecessary[,] and counterproductive litigation costs” that the AIA was designed to avoid. *Fintiv*, IPR2020-00019, Paper 11 at 5 (citing *Magellan Midstream Partners L.P v. Sunoco Partners Mktg. & Terms. L.P.*, IPR2019-01445, Paper 12 at 10 (PTAB Jan. 22, 2020)); 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”).

Petitioners speculate that the district court may ultimately postpone the scheduled trial date (Petition 70-72) but such speculation carries little weight where Petitioners provide no supporting evidence. Guidance at 8-9; *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 20 at 8 (PTAB Aug. 25, 2022). Petitioners rely on the Board's decision in *Cizion, LLC v. Kerr Machine Co.*, PGR2020-00065, Paper 10 (Dec. 3, 2020). (Petition 70-72.) However, *Cizion* was decided before Director Vidal

issued her guidance in June 2022. Moreover, *Cizion* particularly credited petitioner's supporting evidence regarding other then-scheduled trials that might conflict with the trial date and now-outdated statistics regarding the Western District of Texas. *Cizion*, PGR2020-00065, Paper 10 at 26. Petitioners present no such evidence here. In contrast, Patent Owner has presented evidence of a median time-to-trial that is consistent with the scheduled trial date, along with Judge Albright's commitment to quickly trying patent cases.

Because the district court will resolve validity before the Board reaches its final written decision, the second *Fintiv* factor also favors discretionary denial.

C. *Fintiv* Factor 3: The Parties Have Invested Significant Resources In The Parallel District Court Proceeding

Factor 3—the resources invested in the parallel district court proceeding—favors denial “if, at the time of the institution decision, the district court has issued substantive orders related to the patent.” *Fintiv*, IPR2020-00019, Paper 11 at 9-10; *see also id.* at n.16 (collecting cases). *Fintiv* holds specifically that “claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

The parties have invested significant resources in the parallel litigation over the last seventeen months. For example, the parties long ago exchanged infringement and invalidity contentions (in October 2022 and February 2023 respectively), and

fact discovery is underway. The Court issued its claim construction order for the '243 Patent on July 28, 2023. (EX-2010.)

And while *Fintiv* directs consideration of resource investment at the time of institution, the overlapping schedules here counsel the Board to further consider the redundant resources that *will be* wasted should IPR be instituted. *Fintiv*, IPR2020-00019, Paper 11 at 6; *NXP*, PGR2022-00005, Paper 20 at 7 (Board should consider “the duplicative efforts that will occur during the [] duration of a [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 '243 patent was 19 pages, without even considering the Court's substantive analysis or the two *additional Markman* orders issued in this case. (EX-2010.) The Court considered and construed eight claim terms of the '243 patent alone. (*Id.*) The parties have engaged in extensive discovery on the parties' contentions, during which Petitioners have produced more than 1.3 million pages of documents and Patent Owner has made approximately 50TB of source code available. The Court has held multiple discovery hearings. Furthermore, Petitioners' and Patent Owner's experts have already invested an extensive number of hours preparing

for their reports by reviewing the patent, prior art, and the defendants' invalidity contentions, as well as traveling to review source code for more than two months. *See Regeneron Pharms. Inc. v. Novartis Pharma AG*, IPR2020-01317, Paper 15 at 17 (PTAB Jan. 15, 2021) (denying institution where the parties had expended considerable resources in claim construction, substantial fact discovery, and preparation for expert reports).

Petitioners' delay in filing this petition further weighs for denial. Petitioners waited nearly six months after receiving Patent Owner's infringement contentions before filing its petition. During this time, Petitioners knew that the parties were investing in a rapidly proceeding litigation. Petitioners offer no explanation for its delay, which weighs for denial. *Fintiv*, IPR2020-00019, Paper 11 at 11-12; *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. *Fintiv* Factor 4: The Issues And Parties Overlap Significantly

Factor 4—the degree of overlap between the issues in the petition and those before the district court—also supports 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.*

Petitioners provide only a limited *Sand Revolution*-style stipulation, stating it will not rely on the ***same grounds*** in the district court. (Petition 74.) Such a stipulation can weigh only “***marginally*** in favor of not exercising discretion to deny institution.” *Sand Revolution II, LLC v. Cont’l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020).³

Under the circumstances here, Petitioners’ stipulation carries *no weight*. Petitioners’ co-defendants are collectively relying in the litigation on the same four prior art references asserted in the petition—but offer no stipulation.⁴ Thus, Petitioners’ stipulation does not bar the *other defendants* in the parallel litigation from litigating—and forcing Patent Owner to litigate—the very same invalidity challenges

³ All emphases added unless otherwise noted.

⁴ Codefendants *Crowdstrike* asserts Li, Yadav, and Hartrell; *Trend Micro* asserts Li, Yadav, Hartrell, and Mandujano; and *AO Kaspersky* asserts Hartrell. (EX-2011; EX-2012; EX-2013.)

before the district court. Not only does this multiply the burden on Patent Owner, it creates the possibility of inconsistent decisions between the district court and the Board.

Because Petitioners' 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 Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020); *Google LLC v. EcoFactor, Inc.*, IPR2021-00454, Paper 9 at 12-14 (PTAB July 22, 2021).

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

Factor 5—the overlap of the parties between the petition and the parallel litigation—favors denial because (1) Petitioners are defendants in the parallel litigation and, as such, will have a full, fair opportunity to litigate the petitioned grounds, and (2) the issues Petitioners raise are the same ones its co-defendants have *also* raised in the parallel litigation.

Under *Fintiv*, "[i]f a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution." *Fintiv*, IPR2020-00019, Paper 11 at 13-14. That is not the case here because Petitioners are defendants in the litigation. Accordingly, the circumstances raise no fairness concerns that denial would deprive Petitioners of their "day in

court.” *See 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).

That other defendants are *also* litigating the petitioned issues at the district court further suggests denial. *Fintiv* holds that, “[e]ven when a petitioner is unrelated to a defendant, however, 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.” *Fintiv*, IPR2020-00019, Paper 11 at 14. Because of this consideration, *Fintiv* goes on to require that “[a]n unrelated petitioner ... discuss why addressing the same or substantially the same issues would not be duplicative of the [other] case even if the petition is brought by a different party.” *Id.*

Petitioners offer no such explanation here. That other defendants are currently litigating the same issues raised in the petition raises serious concerns of duplicative work by adjudicators, and any public-policy concerns regarding patent validity will be thoroughly addressed by the parallel litigation. Thus, that *other* defendants in the

district court proceedings are *also* litigating the petitioned grounds weighs yet further for discretionary denial.

F. *Fintiv* Factor 6: The Petition Does Not Present “Compelling Evidence of Unpatentability”

Factor 6—the merits of the Petition—also counsels for denial because, as detailed below, the petition fails to show a “reasonable likelihood” that Petitioners would prevail on any challenged claim. *See* 35 U.S.C. § 314(a). For example, the ’243 patent discloses a pestware monitoring and identification system that an externally networked source from which a suspected pestware object originated and reports the source to an externally networked research entity. But none of the art on which Petitioners rely teaches or suggests those ideas. Instead, the cited art discloses identifying the internal files or directories from which the pestware originated and alerting a human administrator that the internal file or directory shows signs of a malware infection. *See* Section V, *infra*. Because the petition fails to show a reasonable likelihood of success on the merits, the petition may not be instituted.

Even if the Petition did have a “reasonable likelihood” of succeeding (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, at 3

(PTAB Feb. 27, 2023). That higher standard requires that the Petition is “highly likely” to succeed on the merits. *Id.* at 4. The opposite is true here.

* * *

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 ’243 PATENT

A. Inadequacy Of The Prior Art & The Need For Improved Pestware Detection

“Pestware” is a trojan, spyware, adware program, or malware program that collects information about a person or an organization. (EX-2010; EX-1001 1:43-54.) Much of the prior art anti-pestware or anti-virus software focused on scanning and stopping *known* pestware based on previously created pestware definitions. (EX-1001 1:63-65.) These prior art methods for detecting known pestware suffered from extensive delay—either while waiting for the pestware to be detected and a definition generated or in locating the pestware to create definitions in the first place. (EX-1001 1:65-67; EX-2001 ¶¶28-29.)

Accordingly, there was a need for an improved technique to efficiently determine whether files were safe or malware. (*Id.* ¶30.)

B. Innovations Of The '243 Patent

The '243 patent discloses identifying pestware by monitoring the activity of software in a reverse or “backwards” manner. Instead of looking for pestware files directly, the invention disclosed and claimed in the '243 patent monitors changes made to system resources, analyzes logs and traces of software execution, identifies patterns of behavior indicative of pestware, and classifies and categorizes detected pestware using heuristics and machine learning. (EX-1001 10:8-30.) The '243 patent uses heuristics modules to compare API call activities on the computer with weighted factors to make decisions relative to activities at the protected computer. (*Id.*)

Among the innovations of the '243 patent is the identification of an externally networked source from which a suspected pestware object originated. As stated by the applicant during prosecution, the prior art “is interested not in an externally networked source suspected of originating an attack (e.g., an Internet URL or Web site from which the pestware was downloaded), but in the internal network's user or process session through which the attack is made (i.e., the local ‘victim’ of the attack).” (EX-1002 167.) Unlike prior art systems, the '243 patent traces pestware activity both back to a pestware object *and* to a source that originated the pestware object. “As an example, if a pestware file is found on the file storage device 118,

then the cache index 243 of the browser cache 242 may be searched to identify the name of the file, *and if the originating URL is stored in connection with the file, the URL is identified as the source of the file.*" (EX-1001 7:48-52.) This represents a significant improvement over the prior art not found in the references cited by the Petitioner.

The '243 patent also discloses reporting the source of the suspected pestware object to an "externally networked pestware research entity." (EX-1001, claims 1, 6, 12.) "In this way, the suspicious objects and the [sources] originating the suspicious objects may be further researched to establish the extent to which they may be a threat." (*Id.* 8:35-38.) As the applicant explained during prosecution, prior art systems may have maintained their own logs of suspicious activity, but the prior art does not disclose reporting suspected sources of pestware to an externally networked entity. (EX-1002 71.) Doing so enables the claimed invention to leverage significantly more resources to research and combat suspected pestware and its sources. None of Petitioners' references disclose this limitation.

C. Level Of Ordinary Skill In The Art

A POSITA at the time of the invention of the '243 patent 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 ¶¶41-43.) More advanced degrees and/or training in a related discipline can compensate for shorter work experience. (*Id.*)

IV. OVERVIEW OF THE RELEVANT PRIOR ART

A. Overview Of Li

Li discloses a unified logging architecture that captures and analyzes correlations among entries on different types of logs on a single computer. Li discloses six different types of logs that often are stored in different formats from different sources, such that insight from cross-log or common analysis is challenging. Li's system ("UCLog") processes the logs through monitors, which audit, filter, and compare the data collected by the various loggers. (EX-1005 at 8). The monitors compare the data with existing models or signatures and send the compressed data to a centralized activity database for management and organization of the data. (EX1005 11.)

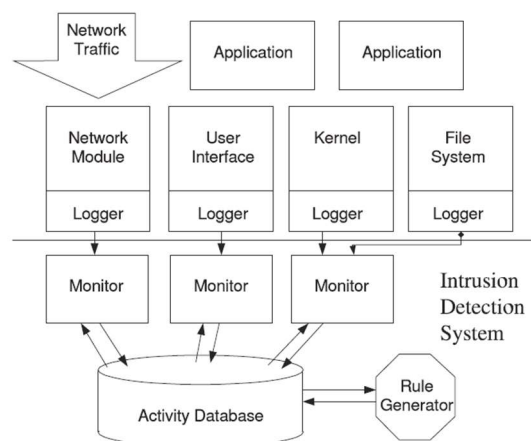


Figure 2. UCLog architecture

The monitors collaborate with other monitors of other loggers by sending queries

through the activity database to find correlated activities. (EX-1005 8, 11.) Based on the queries and correlation, the rule generator “produces the models for normal or abnormal behavior and signatures for previous intrusions.” (EX-1005 14.) Rules are stored in the activity database as training data or sent directly to the monitors. (*Id.*)

Unlike the invention of the '243 patent, Li's disclosure ends at identifying a potential pestware object. Li does not disclose identifying an externally networked source of that pestware object. Li also does not disclose reporting the identity of the pestware object or its source to any other entity, let alone an externally networked pestware research entity.

B. Overview Of Hartrell

Hartrell discusses a malware analysis system that initiates after a locally executing anti-malware system detects a suspected infection. (EX-1006 2:39-44) The system takes pre- and post-infection “snapshots” to provide a record of events and activities that occurred so that the collective snapshots can be used by experts to trace the sequence that led to an infection, understand how the infection spread through the system, and observe the impact on the system after the infection. (EX-1006 2:48-57). A “categorization component” of the malware analysis system processes the snapshots and normalizes the snapshot data by labeling and associating activities in the snapshots with predetermined categories of system activities. (EX-

1006 4:30-32). The categorization process can be tuned by an administrator to improve the data's usefulness to a "commonality analysis component," which analyzes the output from the categorization component and labels activities as suspicious or potentially normal. (EX-1006 4:32-37.) An administrator can then mark recurring suspicious activities as malicious. (EX-1006 4:51-53.) A "response recommendation generator" also reviews the commonality analysis component output and makes recommendations for response to the system administrators. (EX-1006 5:13-30.) Based on the analysis of the snapshots, a system administrator can reconfigure the security policies to prevent future infections. (EX-1006 3:8-16.)

Hartrell differs from the invention of the '243 patent. For example, Hartrell is directed at identifying and stopping an *ongoing* malware attack. Hartrell does not disclose identifying the pestware object that may be instigating the attack or the source from which that pestware object *originated*. Hartrell also discloses only sending *recommendations* to other systems with respect to the ongoing attack; it does not disclose sending any information to enable any entity to further investigate a suspected pestware object.

C. Overview Of Yadav

Yadav discloses an integrated intrusion detection system that uses a dynamically controlled firewall for integrated network intrusion detection. Yadav's

system integrates firewall filtering information with network intrusion analysis and monitors blocked network communications, thereby reducing the amount of network traffic that needs to be monitored. (EX-1008 3:1-14.) The system of Yadav only performs intrusion analysis on packets blocked by a firewall. (EX-1008 at 3:5-10). The blocked packets are checked for patterns spanning multiple channels or communication channels. (EX-1008 4:27-30.) An application behaving abnormally is added to a watchlist and monitored more frequently. (EX-1008 4:52-58.)

In Yadav's system, when an unauthorized communication comes in, a copy is sent to the intrusion detector component, and the communication is blocked. (EX-1008 8:25-33). If an intrusion prelude pattern is detected, then the source of the communication is added to the list of potential intruders to be monitored. (EX-1008 8:56-59.)

Based on an administrator's post hoc review of the snapshots, the response recommendation generator generates recommendations, which are made available to system or security administrators. (EX-1008 5:13-30.) The administrators can then decide what corrective measures, if any, to implement based on the recommendations. (*Id.*)

Yadav differs from the invention of the '243 patent. Like Hartrell, Yadav is directed to identifying and stopping an *ongoing* malware attack. Yadav does not

disclose identifying the pestware object that may be instigating the attack or the source from which that pestware object *originated*. Yadav also discloses only sending *recommendations* with respect to the ongoing attack; it does not disclose sending any information to enable any entity to further investigate a suspected pestware object.

D. Overview Of Mandujano

Mandujano discloses a score-based system to determine whether an outbound object is malware using outbound intrusion detection (sometimes referred to as “OID”). Outbound intrusion detection does not protect local resources from being compromised by other systems, but rather prevents local resources from compromising other systems by monitoring outbound activity. (EX-1007 67.) According to Madujano, “[a]n advantage of the OID approach ... is broader visibility: a host has total access and control over its own resources.” (*Id.* 70.) Specifically, Mandujano discloses using knowledge of the internal structures of a system to detect patterns that indicate abnormal behavior and define signatures of illicit activity. (*Id.* 78.) Armed with a more thorough understanding of the origin of the actual attack program and underlying commands used, an outbound intrusion detection system can provide potential victims with targeted security measures, thereby conserving resources. (*Id.* 71.)

Petitioners do not assert that Mandujano discloses or renders obvious identifying an externally networked source of a potential pestware object or reporting the identity of that source to an externally networked pestware research object. Mandujano does not teach these limitations.

V. THE CHALLENGED CLAIMS ARE PATENTABLE

The petition presents four grounds challenging the claims of the '243 patent:

Ground 1	Section 103(a)	Obvious over Li in view of Hartrell	Claims 1-14
Ground 2	Section 103(a)	Obvious over Li in view of Hartrell and Mandujano	Claims 1-14
Ground 3	Section 103(a)	Obvious over Li in view of Yadav	Claims 1-14
Ground 4	Section 103(a)	Obvious over Li in view of Yadav and Mandujano	Claims 1-14

“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 that a petitioner has

the “burden from the onset to show with particularity why the patent it challenges is unpatentable”).

Petitioners fail to show a reasonable likelihood of success as to any challenged claim because Petitioners have not shown that: (1) Li was publicly accessible before the priority date; (2) any of Petitioners' combinations render obvious every limitation of the challenged claims. Specifically, Petitioners fail to demonstrate that any of the cited prior art, alone or in combination, discloses or renders obvious at least the limitations (1) “identifying... a reference to an identity of an externally networked source of the suspected pestware object;” and (2) “reporting the identity of the particular externally networked source to an externally networked pestware research entity.”

**A. Li Was Not Known Art At The Time Of The Invention
Of The '243 Patent**

Each of Petitioners' grounds relies on Li, a purported conference paper that Petitioners fail to establish is prior art to the '243 patent. Specifically, Petitioners fail to meet their burden to show that Li was publicly available no later than April 20, 2006 (i.e., the filing date of the application that resulted in the '243 patent).

The petition must establish a reasonable likelihood that an asserted reference qualifies as a printed publication. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 3 (PTAB Dec. 20, 2019) (precedential). “[P]ublic

accessibility” is “the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C § 102(b).” *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986). “A reference is publicly accessible ‘upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it’” *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340,1350 (Fed. Cir. 2008) (quoting *SRI Int’l, Inc. v. Internet Sec. Sys. Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008)). “A party seeking to introduce a reference ‘should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.’” *Argentum Pharms. LLC v. Research Corp. Techs., Inc.*, IPR2016-00204, Paper 19 at 9 (P.T.A.B. May 23, 2016) (quoting *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981)).

To support their claim that Li was publicly accessible before the filing of the ’243 patent, Petitioners rely on the declaration of Dr. Sylvia D. Hall-Ellis. (Petition 6, citing EX-1009, ¶¶43-44.) As an initial matter, it is unclear from Dr. Hall-Ellis’s declaration exactly when she contends that Li was publicly available. Her declaration refers to various dates, including July 22-25, 2004 (EX-1009 ¶40), January 2004 (*id.* ¶¶41-42), July 25, 2006 (*id.* at ¶42), July 25, 2004 (*id.* at ¶43), and

January 31, 2005 (*id.* ¶44). Notably, although Petitioners appear to settle on January 31, 2005, as the date when they contend Li was publicly available (Petition 6, citing EX-1009, ¶¶43-44), neither Petitioners nor Dr. Hall-Ellis identify any basis for that seemingly arbitrary date. Instead, they rely on a series of conclusory and speculative statements that are not supported by the record.

Dr. Hall-Ellis does not claim to be a record custodian for any website or other publication that purportedly resulted in Li becoming publicly available. Nor does she claim any personal knowledge of when Li was first published. Rather, Dr. Hall-Ellis appears to base her opinions on reviewing online databases at an unspecified time (and presumably around the time of her declaration in this case). (*See, e.g.*, EX-1009 ¶40 (“I obtained this copy of the conference paper from the OPERA digital repository.”).) However, whether Li was publicly available at the time of Dr. Hall-Ellis’s March 27, 2023 declaration is irrelevant. The relevant question is whether Li was publicly available before April 20, 2006. And, on that point—for which Petitioners rely solely on Dr. Hall-Ellis’s declaration—Petitioners have not met its burden.

Dr. Hall-Ellis states that she obtained a copy of Li from “the digital repository Operating Systems Research on Energy, Reliability and Autonomy (OPERA) hosted by the Department of Computer Science and Engineering at the University of

California – San Diego.” (EX-1009 ¶40.) She does not claim to be affiliated with OPERA or the University of California – San Diego. Again, Dr. Hall-Ellis does not state when she obtained Li from OPERA, nor does she purport to establish when Li first became publicly available in that repository.

Dr. Hall-Ellis next states that “[t]he Li conference paper *is* also available in the digital repository ResearchGate, the digital repository Google Scholar, and the website CiteSeer.” (EX-1009 ¶41 (emphasis added, citations omitted).) Dr. Hall-Ellis further states that “[e]ach of the digital repository documents indicates a publication date of January 2004.” (*Id.*) These statements do not establish public availability for two reasons. First, whether Li “is” available in certain repositories does not establish that Li *was* publicly available in those repositories before the filing date. Second, these repositories listing a January 2004 date does not demonstrate that Li was actually *available* in those repositories as of January 2004. *See In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849, Paper 17 at 5, 12 (PTAB Mar. 30, 2020) (“Simply pointing to a date, alleged to be a ‘publication date,’ even where that date cascaded through various patent references, without interpretation or explanation, does not meet the threshold standard to show that it is reasonably likely that a reference was publically [sic] accessible on that date.”). Indeed, many of the repositories Dr. Hall-Ellis relies upon did not exist in January 2004. Research

Gate launched in 2008.⁵ Google Scholar launched in November 2004⁶ and links to the version of Li on Research Gate, which could not have been available before 2008. Also, Li could not have been published in January 2004 because it cites other publications with later dates. (EX-1005 at 14-15 (citations 8, 10, 14, 34, and 35 (February 2004) and citation 37 (June 2004).)

Dr. Hall-Ellis next suggests that Li's "citation by other researchers" establishes that it was publicly available before the filing date. (EX-1009 ¶42.) However, of the 31 citations Dr. Hall-Ellis references, nearly all do not list even a purported publication date before the filing date of the '243 patent. And Dr. Hall-Ellis singles out only two items. First, she notes that Li "is listed among the works of Jeff Rosendale." (*Id.*) But that is unremarkable since Jeff Rosendale is one of the authors of the Li paper, and the citation is merely to the same Research Gate repository addressed above, which did not launch until 2008. Second, Dr. Hall-Ellis notes that William Yurcik, another co-author of the Li paper, cited Li in a paper that lists July 25, 2006, as the publication date, which is after the filing date of the '243

⁵ <https://www.researchgate.net/about> (EX-2014.)

⁶ <https://osc.universityofcalifornia.edu/2004/11/google-announces-beta-release-of-google-scholar/> (EX-2015.)

patent. (*Id.*) Moreover, the Board has made clear that citations by authors who had “personal knowledge regarding the cited” reference does not demonstrate public availability. *Argentum*, IPR2016-00204, Paper 19 at 11-12; *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1372 (Fed. Cir. 2019) (a work is not publicly accessible if the only people who know how to find it are the ones who created it).

Dr. Hall-Ellis next states that “the Li conference paper was publicly available on or shortly before July 25, 2004, because by that date it had been written and presented at the 12th International Conference on Telecommunication Systems: Modeling and Analysis.” (EX-1009 ¶43.) But Dr. Hall-Ellis does not identify any factual support for this statement. *See Wagner Spray Tech Corp. v. Graco Minnesota Inc.*, PGR2018-00049, Paper 10 at 18-19 (Sept. 24, 2018) (finding that expert declaration that “does not disclose the underlying facts or data on which [it] is based...is entitled to little or no weight”).

Finally, Dr. Hall-Ellis describes the process for generating Machine-Readable Cataloging (“MARC records”) and their creation by Online Computer Library Center (“OCLC”) member institutions. (EX-1009 ¶¶23-33.) Dr. Hall-Ellis explains that when a MARC record is created in an OCLC database, “Field 005 of the MARC record is automatically populated with the date the MARC record was created in year, month, day format (YYYYMMDD).” (EX-1009 ¶31.) However, and quite

tellingly, Dr. Hall-Ellis never identifies a MARC Field 005 date for any of the versions of Li that Dr. Hal-Ellis found. (*See generally*, EX-1009.) *See Intel Corp. v. Alacritech, Inc.*, IPR2017-01395, Paper 13 at 4-5 (PTAB Jan. 25, 2018) (rejecting petitioner's argument regarding public availability based in part on declarant's failure to connect cataloging practices to the document at issue).

In sum, Petitioners and Dr. Hall-Ellis rely on nothing more than speculation that Li “was publicly accessible **in the relevant time frame**, how one might have obtained a copy of the thesis, or whether the thesis was reasonably accessible through generally available means.” *Argentum*, IPR2016-00204, Paper 19 at 12. Therefore, Petitioners have failed to meet their burden to show that Li is prior art, and because Petitioners rely on Li for every ground in the petition, the Board should deny institution on this basis alone.

B. Ground 1: Petitioners Fail To Establish That Li and Hartrell Renders Obvious Every Limitation of The Challenged Claims

Even if Petitioners had shown that Li were prior art, their first obviousness ground—Li in view of Hartrell—fails for at least three additional reasons: (1) neither Li nor Hartrell discloses or renders obvious “reporting... to an externally networked pestware research entity”; (2) neither Li nor Hartrell discloses or renders obvious “identifying ... a reference to an identity of an externally networked source

of the suspected pestware object”; and (3) a POSITA would not have been motivated to combine Li and Hartell.

1. Li and Hartrell do not render obvious “reporting ... to an externally networked pestware research entity.”

Independent claim limitations 1[e], 6[d], and 12[e] each require “*reporting the identity of the externally networked source to an externally networked pestware research entity.*” (EX-1001, cls. 1, 5, 12.)

Claim Limitation	Claim Language
1[e]	<i>“reporting the identity of the particular externally networked source to an externally networked pestware research entity so as to enable the externally networked pestware research entity to research whether the particular externally networked source is a source of pestware”</i>
6[d]	<i>“a reporting portion configured to generate a report that identifies the externally networked source of the file and to report an identity of the externally networked source to an externally networked pestware research entity so as to enable the externally networked pestware research entity to research</i>

	<i>whether the externally networked source is a source of pestware”</i>
12[e]	<i>“reporting the identity of the particular externally networked source to an externally networked pestware research entity so as to enable the externally networked pestware research entity to research whether the particular externally networked source is a source of pestware”</i>

Petitioners argue that Li alone and Li in view of Hartrell disclose this limitation. Both arguments fail.

a) Li Does Not Disclose “reporting... to an externally networked pestware research entity”

Petitioners first argue that Li alone discloses “reporting ... to an externally networked pestware research entity.” But Li does not disclose an externally networked pestware research entity. As shown in Figure 2, Li’s system design does not include any kind of research entity, let alone the claimed externally networked pestware research entity:

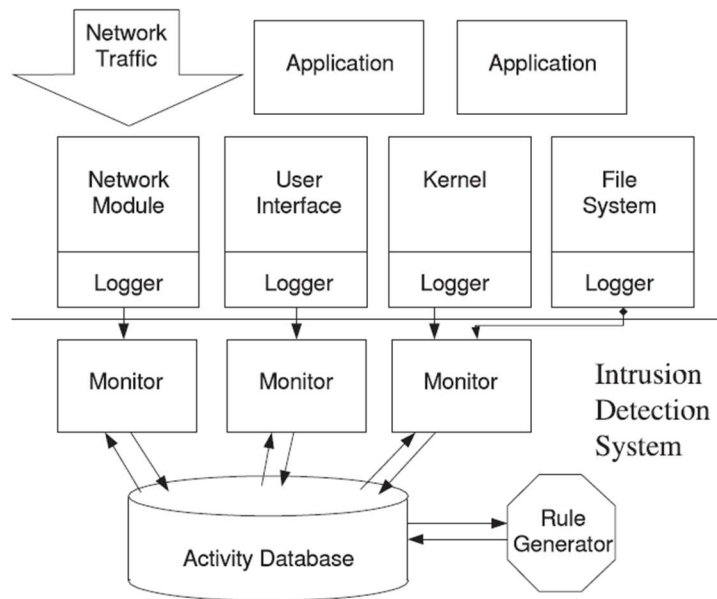


Figure 2. UCLog architecture

(EX-1005 8, Figure 2.)

Petitioners attempt to overcome this shortfall by correlating the claimed “*externally networked pestware research entity*” to Li’s disclosure of a human reviewer. Petitioners claim that Li discloses this limitation because “Li states that the user interface of an IDS ‘enables an administrator to view the output from the system,’” and because that interface is on a separate system, the administrator is externally networked. (Petition 28.) Petitioners cite nothing to support their speculation that the administrator views the output of the system on a separate, externally networked system.

Contrary to Petitioners' unsupported assertion, a POSITA would not understand a human administrator to be an externally networked pestware research entity. Li does not disclose or even suggest that an administrator reviews the output of the IDS on an externally networked system that might qualify as the claimed "pestware research entity." (EX-2001 ¶56.) To the contrary, Li discloses "running the activity database on a dedicated server" as a solution for sizable databases such as those running "on a large-scale network." (EX-1005 13.) Given this context, a POSITA would have understood that the "dedicated server" would be running *within* that "large-scale network." (EX-2001 ¶68.) Li does not disclose a server of any kind being externally networked, nor any indication that operating the server in such a way would be necessary or advantageous. (*Id.*)

The '243 patent claims all require an "externally networked pestware research entity." (See EX-1001, claims 1, 6, 12). Consistent with the claim language, the specification describes a "remote research entity." (EX-1001 9:50-52.) The specification distinguishes the remote research entity from a "research module," which locally searches activity logs and N files for information associating an object's suspicious activity to processes, which are related to "one or more files." (EX-1001 9:37-44.) This search provides information about the identity of the source of a suspicious process and/or files," and the source is then reported to a remote

research entity. (EX-1001 9:50-52.) (“Once the source of the suspicious object(s) is identified (Block **510**), the source is then reported (e.g., to a remote research entity) (Block **512**).”)

In this regard, Li is similar to art the applicant distinguished during prosecution, U.S. 2005/0268112 (“Wang”). The applicant distinguished Wang as follows: “the event log described by Wang is not an externally networked pestware research entity. The event log is a file that resides within the computer that runs Wang’s Gatekeeper engine software...Wang does not describe providing the event log to any externally networked entity...Further, Wang does not describe providing the event log to any externally networked entity. Rather, the event log and its data remain within the confines of Wang’s computer that runs the Gatekeeper engine.” (EX-1002 71.) The applicant distinguished the prior art because it addressed activities that were entirely internal to the computer without any external network involved, while the claims recited an externally networked entity. (*Id.*) As shown in Figure 2, all of the IDS activities disclosed by Li are internal to the computer, and involve no externally networked research entity.

b) Li In View of Hartrell Does Not Disclose “reporting... to an externally networked pestware research entity”

Petitioners argue in the alternative that Li in view of Hartrell also discloses “reporting... to an externally networked pestware research entity.” Petitioners cite

Hartrell's disclosure of alerting a system operator to a pattern of infected computer systems and providing recommendations to that same system operator. (Petition 28-29, EX-1006, 5:13-30.) But Hartrell does nothing to cure the deficiencies of Li.

Contrary to Petitioners' argument, a POSITA would not "recognize that the 'system operator' would be on an externally networked research entity." (Petition 28-29.) Hartrell's "system operator" is the operator of another potentially "infected computer system[]," not a research entity. (EX-1006 10:57-58.) Hartrell does not disclose that the system provides the operator with information sufficient to independently perform further research concerning the pestware; rather, the operator is simply "provide[d] a recommendation to block this web site." (*Id.* 10:49 Hartrell also does not disclose that an operator would use her computer system to further investigate the pestware, or that the alert provided would include enough detail to enable her to do so. Nor have Petitioners explained or shown how a human computer operator herself is "externally networked" to the Li computer system apart from the operator's computer. Thus, any connection to an operator's computer system would not recite an "externally networked pestware research entity" that provides a "report" sufficient "to enable the externally networked pestware research entity to research whether the externally networked source is a source of pestware." (EX-1001, claims 1, 6, 12.)

Petitioners also argue that Hartrell's "centralized data store" satisfies the "externally networked pestware research entity" limitation. In support of this argument, Petitioners incorrectly assert that Hartrell teaches that "[t]he centralized data store makes use of the website/IP address of the externally networked source to determine whether the externally network[ed] source is a source of pestware." (Petition 29.) Petitioners rely on Hartrell's disclosure of a "commonality analysis process" to support this assertion. (*Id.* (citing EX-1006 3:49-53, 10:44-50).) But Hartrell discloses that its "malware analysis system" conducts this "commonality analysis" to determine whether a particular website may be harmful. Hartrell teaches that its "malware analysis system" [is] running on each of the computer systems," (i.e., it is part of the internal network). It is not part of a separate externally networked entity. (EX-1006 10:36-37.) The malware analysis system then alerts the operators of various computer systems to block the suspicious website. (*Id.* 10:47-50.) Moreover, Hartrell does not disclose or suggest that its malware analysis system reports the results of its analysis to any pestware research entity, let alone an externally networked one, for any purpose, much less the recited purpose of researching whether the externally networked source is a source of pestware.

2. Li and Hartrell do not render obvious “identifying... a reference to an identity of an externally networked source of the suspected pestware object.”

Independent claim limitations 1[d], 6[d], and 12[d] each require that the claimed system or method *identify the “externally networked source” of the file or pestware object.*” (EX-1001, cls. 1, 6, 12.)

Claim Limitation	Claim Language
1[d]	<i>“accessing, in response to the identifying an object, at least a portion of a recorded history of externally networked sources that the computer received files from <u>so as to identify a reference to an identity of a particular externally networked source that the suspected pestware object originated from</u>”</i>
6[d]	<i>“a reporting portion configured to generate a report <u>that identifies the externally networked source of the file</u> and to report an identity of the externally networked source to an externally networked pestware research entity so as to enable the externally networked pestware research entity to research whether the externally networked source is a source of pestware”</i>

12[e]	<i>“accessing, in response to the identifying an object, at least a portion of a recorded history of externally networked sources that the computer received files from <u>so as to identify a reference to an identity of a particular externally networked source that the suspected pestware object originated from</u>”</i>
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As with the limitation discussed in the previous subsection, Petitioners argue that Li alone, and Li in view of Hartrell, disclose or render obvious this limitation. Both arguments fail.

**a) Li Does Not Disclose or Render Obvious
“identifying... a reference to an identity of an
externally networked source of the suspected
pestware object”**

Petitioners first argue that Li alone discloses the limitation “identifying ... a reference to an identity of an externally networked source of the suspected pestware object.” But Li contains no such disclosure. Contrary to Petitioners’ argument, Li’s system is limited to detecting intrusions; Li does not disclose the additional step of attempting to identify the *source* of an intrusion.

Li’s system detects the presence of a computer virus by “captur[ing] correlations among entries in different types of logs.” (EX-1005 1.) Li refers to various data sources for the log entries it monitors and correlates. For example, Li discloses

monitoring file input and output (or “I/O”) at specific files or directories (which Li refers to as “sources”) within an internal network. (EX-1005 19-20.) Li describes monitoring and correlating an “additional source”—the c:\recycler\directory—and states that adding this “additional source” could improve IDS accuracy. (*Id.* 20.) Li’s disclosure does *not* teach tracing the origin of an object that may have caused the file to be created; rather, it merely generates a warning that the behavior of the *internal directory* is abnormal. *Id.* A POSITA would therefore understand Li’s use of the term “source” to mean a data source, such as an internal file or directory. (EX-2001 ¶70.).

Petitioners rely on a single phrase containing the word “source” in Li: that the UCLog can be used to “***identify the source and the execution path of the occurring intrusion.***” (Petition at 24 (emphasis in original) (citing EX-1005 at 3, 13).) Leaning on this single phrase—divorced from its context—Petitioners assert that the “source” described in Li is a “source” of pestware. It is not. Li consistently uses the word “source” to describe a source of *data* gathered by the UCLog, not a source of pestware. Indeed, this is the key innovation described in Li: “UCLog organizes audit data from *heterogeneous sources* into a structured way and is closely integrated into the intrusion detection system.” (EX-1005 25.)

Petitioners' preferred quote first appears as part of a single bullet point on page 3 of Li.⁷ The first bullet point in that series makes clear what "source" the UCLog is "identify[ing]": "UCLog organizes all ***audit logs from heterogeneous sources*** in a very structured way and is closely integrated into the intrusion detection system." (*Id.* 3.) The remainder of Petitioners' cited language makes clear that the "source" Li refers to is one of the heterogeneous sources that feeds the audit logs: "At an intrusion, UCLog can be used to automatically identify the source and the execution path of the intrusion, ***whereas most current systems require an administrator to manually examine the logs to find such information.***" (*Id.*) Every other use of the term "source" or "sources" in Li confirms that a "source" is a source of *data* fed into the IDS:

- "... most of the previous work on intrusion detection focuses on activities generated by a single *source*" (*Id.* 2.)
- "... few studies have been conducted on fusing audit log data from heterogeneous *sources* into a single framework for assessing suspicious behavior." (*Id.*)
- "These systems provide a centralized mechanism to log activities from heterogeneous *sources*...." (*Id.*)

⁷ Petitioners incorrectly cite to page 2 of Li. (Petition 24.)

- “For example, it is very common for organizations to have dedicated servers that collect and store logs obtained from different *sources* (e.g. *syslogs* obtained from each host in the organization).” (*Id.* 10.)
- “Besides loggers, a monitor needs to interact with the centralized activity database to find correlated activities from other *sources*.” (*Id.* 11.)
- “The database schema is crucial to correlate audit data from different *sources*.” (*Id.* 13.)
- “... monitoring and correlating an additional *source* can help to improve the IDS accuracy.” (*Id.* 20.)
- “Their study only monitors file I/O operations, whereas UCLog monitors activities from multiple *sources*.” (*Id.* 23.)
- “... to improve IDS accuracy by correlating information from different and preferably disjoint *sources*.” (*Id.* 25.)
- “UCLog organizes audit data from heterogeneous *sources* into a structured way....” (*Id.*)

None of Li's references to “source” or “sources”—including those identified by Petitioners—disclose or even relate to an externally networked source of a suspected pestware object.

Petitioners also argue, based on Li's disclosure, that it “would have been obvious to a POSITA to check the source IP address” of packet headers stored in the “WinDump Log” in order to “see from where the malware came [and] to identify a

potentially malicious internet source.” (Petition at 26.) This argument fails for at least two reasons.

First, Petitioners fail to explain why a POSITA would be motivated to use packet headers stored in the WinDump Log to identify the source of an intrusion. As discussed above, Li is directed to a system for detecting the presence of an intrusion within a network, not obtaining additional information about the intrusion. Indeed, Li does not address identifying the *source* of an intrusion. Rather, Li is singularly focused on improving systems to detect intrusions themselves: “most of the previous work on intrusion detection focuses on activities generated by a single source, *resulting in many false positives and undetected intrusions.*” (EX-1005 2.) Li does not disclose any reason why tracing back to the source of an intrusion once it has been identified would improve its intrusion detection system, for example by reducing either false positives or undetected intrusions. (*See generally*, EX-1005.)

Second, even if Petitioners were correct that POSITA would have been motivated to manually examine one of Li's data sources to identify an intrusion's source—which they would not have been—such a manual identification would not satisfy all limitations of any challenged claim. As discussed above in Section V.B.1, the '243 patent's independent claims all require *reporting* the identity of an externally network source to an externally networked pestware research entity.

Petitioners do not explain how, under their Li-based obviousness theory, the results of a POSITA's source analysis would subsequently be reported to any entity at all. In fact, because neither Li nor Hartrell discloses identifying a pestware source through manual analysis by a human, neither discloses reporting the *results* any such analysis to an externally networked pestware research entity. Petitioners' argument that Li renders this limitation obvious for this additional reason.

Thus, Li does not disclose or render obvious "identifying, in response to the identifying the suspected pestware object, a reference to an identity of an externally networked source of the suspected pestware object."

b) Li In View of Hartrell Does Not Disclose "identifying... a reference to an identity of an externally networked source of the suspected pestware object"

Petitioners next argue in the alternative that Li in view of Hartrell also discloses "identifying ... a reference to an identity of an externally networked source of the suspected pestware object." But Hartrell cannot cure the deficiencies of Li because Hartrell does not address pestware objects at all, let alone "an identity of a particular externally networked source that the suspected pestware object originated from." (E.g., EX-1001, claim 1.)

Hartrell's "malware analysis system" "monitors and records computer system activities." (EX-1006 Abstract.) There is no disclosure or suggestion of tracing a

specific *object* back to an externally networked source. The “objects” described in Hartrell are not pestware objects but “operating system objects that were manipulated.” (*Id.* 3:6-7.) In other words, the “objects” identified by Hartrell are targets or victims of pestware, not pestware themselves.

Determining that “four infected machines visited the same web site prior to being infected” does not disclose or suggest identifying a “pestware object” that caused the infection. (*Id.* 3:48-49.) Hartrell’s “commonality analysis” merely identifies that several systems visited the same website and subsequently became infected. This disclosure does not disclose or render obvious tracing any particular pestware object back to that source. Because Hartrell does not disclose identifying a pestware object, it also does not disclose identifying the externally networked source *of* a pestware object.

Even if the website identified by Hartrell’s “commonality analysis” were an identified source of a pestware object (it is not), the methods taught by Hartrell to identify this information do not teach the relevant claim limitations. Hartrell’s commonality analysis requires correlating data from *several* computer systems to identify a potentially malicious website that all of them visited. (EX-1006 3:47-51.) This does not meet the limitations of the ’243 patent, which require identifying a source of pestware by analyzing the activity log of a *single* computer. (EX-1001

3:34-38.) The claims of the '243 patent recite that it is the “recorded information on the computer that relates the at least one file to an externally networked source.” (EX-1001 at claim 6; *see also id.* at claim 1, 12 (“accessing ... a portion of a recorded history ... to identify a reference to an identity of a particular externally networked source”.) The specification makes clear that identifying a relationship between the pestware object and its source means identifying a relationship between the two *within* the activity log. For example, “if the originating URL is stored in connection with the file, the URL is identified as the source of the file.” (*Id.* 7:50-52.) Hartrell does not disclose identifying any such relationship. Hartrell merely flags websites that all infected computers visited, without tracing that website to the suspected pestware object via the activity logs.

3. Petitioners fail to show that a POSITA would have been motivated to Combine Li with Hartrell.

Even if the Li/Hartrell combination disclosed or suggested “identifying... a reference to an identity of an externally networked source of the suspected pestware object,” which it does not for the reasons discussed in the previous section, Petitioners fail to demonstrate any motivation to combine Li and Hartrell. Petitioners assert that a POSITA would be motivated to “aggregate the system-wide unified log information disclosed in Li within the centralized database described in Hartrell.” However, Li *already discloses* an “activity database” to aggregate log information.

(EX-1005 12-14.) Li expressly contemplates that such a log may be used in a “large-scale network”—that is, a network running multiple computers—and offers solutions to manage such network-wide logging in an efficient manner. (*Id.* 13-14.) Petitioners fail to explain why a POSITA would abandon the database disclosed in Li for a different database, much less explain what advantages Hartrell's database offers over Li's.

Petitioners assert that a combination of Li and Hartrell would “aggregate the system-wide unified log information disclosed in Li with the centralized database described in Hartrell.” (Petition 17.) But Li by itself already does this. Li's activity database already “stores and manages audit data,” which comes from the system-wide loggers, “in a very organized way.” (EX-1005 12.) If a POSITA's motivation were to correlate system-wide data, the POSITA would not have needed to look anywhere else but Li.

Moreover, a POSITA would not have been motivated to substitute Hartrell's “centralized data store” for Li's “activity database” because the two operate differently and achieve different goals. Li's activity database aggregates *heterogenous* information from a variety of *different* types of data loggers on a *single* system to identify a potential intrusion. (See EX-1005 10-12 (identifying various types of loggers); *id.* 13 (explaining how the activity database correlates this

disparate information); EX-2001 ¶69.) Conversely, Hartrell aggregates “normalize[d]” or *homogenous* information from the *same* types of data loggers on *multiple* systems to identify potential intrusions affecting all the systems. (See EX-1006 10:36-50 (describing a “commonality analysis” on “normalize[d] ... snapshot data” from “ten computer systems”; (EX-2001 ¶ 69.) These systems operate in opposite ways. (*Id.*) They are not interchangeable. (*Id.*) Therefore, a POSITA would not have been motivated to attempt to substitute one for the other. Petitioners’ obviousness combination of Li and Hartrell fails for this additional reason.

C. Ground 2: Petitioners Fail To Establish That Li, Hartell, And Mandujano Render Obvious Every Limitation Of The Challenged Claims

Ground 2 fails for the same reasons as Ground 1. In Ground 2, Petitioners argue in the alternative that adding Mandujano to their Li/Hartrell combination renders obvious claim limitations [1B] and [1C] and their corresponding limitations in independent claims 6 and 12, reproduced below:

Claim Limitation	Claim Language
1[b]	<i>“analyzing, heuristically, computer activity to determine whether one or more weighted factors associated with an activity exceeds a threshold so as to arrive at a determination that the activity is indicative of pestware”</i>

1[c]	<i>“identifying, based upon the activity, an object residing on the computer that is a suspected pestware object”</i>
6[b]	<i>“a heuristics module configured to identify an activity on the computer that is indicative of pestware residing on the computer and to analyze the activity to determine whether one or more weighted factors associated with the activity exceeds a threshold”</i>
12[b]	<i>“analyzing, heuristically, computer activity to determine whether one or more weighted factors associated with an activity exceeds a threshold so as to arrive at a determination that the activity is indicative of pestware”</i>
12[c]	<i>“identifying, based upon the activity, an object residing on the computer that is a suspected pestware object.”</i>

Petitioners do not contend that Mandujano adds anything to the Li/Hartrell combination with respect to the “externally networked pestware research entity” and “externally networked source” requirements of claim limitations [1D] and [1E], respectively, and the corresponding claim 6 and 12 limitations. Because the Li/Hartrell combination does not render those limitations obvious for the reasons addressed above in Sections V.B.1-3, Petitioners’ second obviousness ground fails for the same reasons as the first.

D. Ground 3: Petitioners Fail To Establish That Li And Yadav Render Obvious Every Limitation Of The Challenged Claims

For their third obviousness ground, Petitioners substitute Yadav for Hartrell in the Lee/Hartrell combination of Ground 1, arguing that “Yadav would replace Hartrell in a similar combination with Li” for the following subset of limitations for which Petitioners relied on Hartrell in their first ground: 1[p]; 1[d]; 1[e]; 2[a]; 4[a]; 5[a]; 6[p]; 6[c]; 6[d]; 12[p]. (Petition 59-66.) But just as with the Li/Hartrell combination, Petitioners’ Li/Yadav combination fails because (1) Yadav does not disclose or render obvious “reporting... to an externally networked pestware research entity;” (2) Yadav does not disclose or render obvious “identifying... a reference to an identity of an externally networked source of the suspected pestware object;” and (3) a POSITA would not have been motivated to combine Li and Yadav.

1. Petitioners fail to show that Li in view of Yadav renders obvious “reporting the identity of the particular externally networked source to an externally networked pestware research entity.”

Petitioners fail to show that Yadav discloses reporting *of any kind* to an externally networked pestware research entity. Petitioners state that Yadav may “*report the intrusion to the central security server 292.*” (Petition 61 (emphasis in original) (citing EX-1008 10:25-28).) But this singular reference to a “central security server” would not have suggested to a POSITA that Yadav’s central security

server functions as a “pestware research entity.” (Petition 61 (citing EX-1008 10:25-28).) Nor do Petitioners cite anything that would have suggested to a POSITA that Yadav’s central server is externally networked. On the contrary, Yadav discloses that a key aspect of “network security is to install a firewall, which restricts and controls the flow of traffic between networks, *typically between an enterprise network and the Internet.*” (EX-1008 1:51-54.) Yadav is expressly directed to “integrating firewall filtering information with network intrusion analysis” by “performing intrusion analysis on packets blocked by a firewall.” (*Id.* 3:1-10.) In other words, the express purpose of Yadav is to protect an internal network (an enterprise network) from an external network (the internet). Given this context, it is clear that the “central security server” would be part of the internal network.

In short, Yadav does not disclose or suggest that its “central security server” is a pestware research entity, or is externally networked.

2. Petitioners fail to show that Li in view of Yadav renders obvious “identifying... a reference to an identity of an externally networked source of the suspected pestware object.”

Li fails to disclose or suggest identifying an “externally networked source of the suspected pestware object...” for the reasons described above with respect to Ground 1. *See* Section V.B.2 *supra*. Yadav does not cure this deficiency.

Yadav does not disclose or suggest identifying an “externally networked source of a suspected pestware object” because Yadav does not address pestware objects at all. The '243 patent describes its invention in part as “identifying ... an object *residing on the computer* that is a suspected pestware object.” (EX-1001 2:21-22.) It further explains that pestware is a “type of program[.]” (*Id.* 1:43-54.) The claimed invention attempts to identify “a particular source that the suspected pestware object *originated from*.” (*Id.* 2:25-26.) Petitioners point to no disclosure in Yadav that identifies a program residing on the computer that is a suspected pestware object, let alone any disclosure of an attempt to identify the origin of the suspected pestware object.

Rather than attempting to identify the source of a program residing on the computer, Yadav discloses identifying “a source of [an] intrusion prelude,” as Petitioners note. (Petition 60 (citing EX-1008 4:31-41).) An “intrusion” is defined by Yadav as “an attempt to break into and/or misuse a computing system,” while an “intrusion prelude” is defined as “communication activities that typically precede an intrusion.” (EX-1008 2:60-63.) In other words, Yadav discloses identifying and stopping an *ongoing* attempt to access or misuse the computer. By contrast, the '243 patent claims recite identifying an externally networked source of a suspected pestware object.

3. Petitioners fail to show that a POSITA would have been motivated to combine Li with Yadav.

Petitioners fail to demonstrate sufficient motivation to combine Li and Yadav. Petitioners assert that a POSITA would have been motivated to “aggregate the log information, including information about the source of pestware, within the central security server described in Yadav.” (Petition 58.) However, Li *already discloses* an “activity database” to aggregate log information. (EX-1005 12-14.) Li discloses “combining information from multiple computers in a central server.” (Petition 58.) Li expressly contemplates that its IDS may be used in a “large-scale network”—that is, a network running multiple computers—and offers solutions to manage such network-wide logging in an efficient manner. (EX-1005 13-14.) This includes loggers that obtain “system-wide information,” i.e., information from multiple computers, all of which is accessible via Li’s activity database. (*Id.* 10.) Yadav’s “central server” achieves nothing not already accomplished by Li’s “activity database.” Thus, Petitioners fail to explain why a POSITA would abandon the database disclosed in Li for a different database, much less explain what advantages the central server of Yadav offers over Li’s activity database.

Moreover, a POSITA would not look to Yadav to modify Li because the two differ in their purpose and implementation. While Li focuses on holistic analysis and correlation of logs to understand system activities, Yadav focuses on targeting

malicious activities and unauthorized access attempts on specific network traffic channels. (*Compare* EX-1005 at 8 *with* EX-1008 at 3:5-10.) Li aims to provide a comprehensive view of system activities to improve long-term analysis, prevention, and response, while Yadav monitors only a small subset of network traffic to react in real time. (EX-2001 ¶84.) Yadav teaches that monitoring “only a small portion of network communications ... blocked by a firewall.” (EX-1008 3:3-10.) Li criticizes this approach and instead advocates a holistic multi-data-stream approach: “most of the previous work on intrusion detection focuses on activities generated by a *single source*, resulting in many false positives and undetected intrusions.” (EX-1005 2.) A POSITA would not be motivated to improve upon Li by looking to the same types of systems that Li criticized.

A POSITA would not have looked to an intrusion detection system focused on real-time reactions to unauthorized network traffic to modify the log correlation system in Li. (EX-2001 ¶88.) A POSITA would not have looked to a system with a much more restricted scope to fulfill the now-perceived shortfalls of the whole-system approach disclosed in Li. (*Id.*) Certainly, a POSITA would not have looked to Yadav's system for an externally networked pestware research entity since such an entity was not disclosed in Yadav. (*Id.*) Thus, even if POSITA had sought to modify Li to incorporate an externally networked pestware research entity (they

would not have), they would not have turned to Yadav for guidance. (*Id.*) Petitioners thus fall short of meeting their burden to show that a POSITA would have modified Li based on the teachings of Yadav to disclose or render obvious any limitation of the challenged claims.

E. Ground 4: Petitioners Fail To Establish That Li, Yadav, And Mandujano Disclose Or Render Obvious The Independent Claims Of The '243 Patent

Ground 4 fails for the same reasons as Ground 3. In Ground 4, Petitioners argue in the alternative that adding Mandujano to their Li/Yadav combination renders obvious claim limitations [1B] and [1C] and their corresponding limitations in independent claims 6 and 12, reproduced below:

Claim Limitation	Claim Language
1[b]	<i>“analyzing, heuristically, computer activity to determine whether one or more weighted factors associated with an activity exceeds a threshold so as to arrive at a determination that the activity is indicative of pestware”</i>
1[c]	<i>“identifying, based upon the activity, an object residing on the computer that is a suspected pestware object”</i>
6[b]	<i>“a heuristics module configured to identify an activity on the computer that is indicative of pestware residing on the computer and to analyze the activity to determine whether one</i>

	<i>or more weighted factors associated with the activity exceeds a threshold”</i>
12[b]	<i>“analyzing, heuristically, computer activity to determine whether one or more weighted factors associated with an activity exceeds a threshold so as to arrive at a determination that the activity is indicative of pestware”</i>
12[c]	<i>“identifying, based upon the activity, an object residing on the computer that is a suspected pestware object.”</i>

Petitioners do not contend that Mandujano adds anything to the Li/Yadav combination with respect to the “externally networked source” and “externally networked pestware research entity” requirements of claim limitations [1D] and [1E], respectively, and the corresponding claim 6 and 12 limitations. Because the Li/Yadav combination does not render those limitations obvious for the reasons addressed above in Sections V.D.1-3, Petitioners’ second obviousness ground fails for the same reasons as the first.

1. Mandujano does not cure the deficiencies of Li and Yadav identified in Ground 3.

In Ground 4, Petitioners rely upon Mandujano to support disclosure of limitations 1B, 1C, 6B, 12B, and 12C. Because Petitioners do not rely upon Mandujano to support any of the limitations that are not disclosed in Ground 3, Ground 4 fails for the same reasons described above.

2. Petitioners fail to identify any motivation to combine Li, Yadav, and Mandujano.

Petitioners summarily explain that “A POSITA would have been motivated to combine the teachings of Li and Yadav with Mandujano for the same reasons a POSITA would have been motivated to combine Li, Hartrell, and Mandujano.” Hartrell and Yadav are two different references. Petitioners offer no explanation at all for why a POSITA would substitute the two in this combination. Petitioners have failed to meet their burden to show motivation to combine.

To the extent the Board entertains Petitioners' summary argument, it fails for the reasons explained in Ground 2. *See* section V.C *supra*.

F. Petitioners' Grounds Fail To Render Obvious All Dependent Claims

Because Petitioners have failed to establish that any of its grounds render obvious all limitations of the independent claims, Petitioners cannot show that such grounds render obvious dependent claims 2-5, 7-11, or 13-14.

G. 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.

H. 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.

VI. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Date: August 10, 2023

Respectfully submitted,

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Attorney for Patent Owner
Open Text Inc.

CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER PRELIMINARY RESPONSE** specified in 37 C.F.R. § 42.24 have 13,055 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 365 V.2022.

Date: August 10, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER PRELIMINARY RESPONSE** and all supporting **EXHIBITS 2001-2015** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) on August 10, 2023 and courtesy copies were also served via electronic mail, in their entireties on the following:

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Patent Owner's Preliminary Response to
Petition for *Inter Partes* Review
Patent No. 8,201,243

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