

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Sophos Ltd. and Sophos Inc.,
Petitioners

v.

Webroot Inc.,
Patent Owner.

Case No. IPR2023-00731

U.S. Patent No. 8,201,243

MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW

I. INTRODUCTION

Pursuant to the Board's October 2 Order (Paper 17), Petitioners move to dismiss and terminate without prejudice IPR2023-00731 regarding U.S. Patent No. 8,201,243 (the "'243 Patent"), which relies on the 2004 Li publication (EX-1005).¹

While Petitioners disagree with Patent Owner's arguments in the POPR, the merits of whether Li invalidates the claims should not be clouded by Patent Owner's allegations that Li is not prior art. Thus, Petitioners obtained further evidence that conclusively establishes that Li was publicly available before April 20, 2006. Petitioners intend to file a petition with new evidence establishing Li as prior art.

Termination will preserve the Board's resources at this early stage; the Board has not issued a decision on institution. Moreover, Patent Owner will not be unfairly prejudiced by granting Petitioners' motion to dismiss. The new petition will raise the *same invalidity grounds and arguments* presented in the instant petition, and thus, Patent Owner can maintain the same positions on the merits. In contrast, denial of the instant motion will drastically prejudice Petitioners.

II. BACKGROUND & PROCEDURAL HISTORY

This Petition was filed April 4, 2023. Paper 1. The POPR was filed August 10, 2023. Paper 13. The institution decision is not due until November 10, 2023.

¹ Petitioners also moved to dismiss IPR2023-00732 (U.S. Patent No. 8,719,932).

The POPR disputes that the declaration of Petitioners' librarian expert, Sylvia D. Hall-Ellis, Ph.D. (EX-1009) was sufficient to show that Li was publicly available as of January 31, 2005. Paper 13, 29-35. On September 15, 2023, the Board requested that Petitioners submit as exhibits to the Hall-Ellis Declaration copies of the linked webpages cited in the declaration. *See* Ex. A. In response, Petitioners requested permission to file the instant motion. *Id.* Following a conference call with the Board on September 29th, the Board granted Petitioners' request. *See* Paper 17.

III. ARGUMENT

The Board has the discretion to grant any motion or dismiss any petition under 37 C.F.R. § 42.71(a). The Board has previously dismissed pre-institution petitions over a patent owner's objections, *see Samsung Elecs. Co. et al. v. Nvidia Corp.*, IPR2015-01270 Paper 11, 3-4 (PTAB Dec. 9, 2015), and has further done so to allow a petitioner to file corrected petitions, even in instances where patent owner had already filed a POPR. *See Wavetamer Gyros, LLC v. Seakeeper, Inc.*, IPR2017-01931, Paper 13 (PTAB Jan. 9, 2018) (permitting petitioner to withdraw and file a corrected petition to substitute a published version of a reference in place of a non-prior art patent with similar disclosure, in view of arguments made in the POPR).

Like *Wavetamer*, this case is in a preliminary stage; the Board has not yet issued a decision on institution. As such, dismissal at this early juncture would preserve the Board's resources. Granting Petitioners' motion to dismiss will also

moot current arguments raised in the POPR with respect to the sufficiency of the evidence establishing Li as prior art, and the interests of justice will be served by having the Board address the prior art on its merits. Any prejudice that Patent Owner may incur by Petitioners' filing of a new petition will be minimal. Indeed, the re-filed petition will raise the same invalidity grounds—and identical arguments—as those presented in the instant petition. As such, Patent Owner's efforts to review and respond to the re-filed petition will be minimal.

The cases raised by Patent Owner during the September 29th conference are inapposite. For example, in *Unified Patents, LLC v. Motion Offense, LLC*, IPR2020-00705, Paper 14 (PTAB Sept. 23, 2020), the Board *granted* petitioner's motion and terminated the proceedings. To the extent Patent Owner relies on cases cited in *Unified Patents (LG Elecs. v. Koninklijke KPN N.V.*, IPR2018-00551, Paper 10 (PTAB Aug. 1, 2018) and *Fresenius Kabi USA, LLC v. AstraZeneca AB*, IPR2017-0190, Paper 7 (PTAB Nov. 2, 2017)), those cases are distinguishable for the same reason they were distinguished in *Unified Patents*. In *LG*, the motion to terminate was made on the eve of the institution decision; such is not the case here. And in *Fresenius Kabi*, the petitioner filed an identical petition to an earlier-filed petition, but that earlier petition was then denied institution. The petitioner tried to withdraw its copycat petition, but the Board denied the request because the petitioner would not agree that it would not file a subsequent petition, presumably on different

grounds, taking into account the institution decision reasoning. *Id.* at 4-5. Here, the Board has not issued a decision, and Petitioner has agreed that any subsequent petition will be identical in grounds and argument to the present petition.

Patent Owner's reliance on *Apple Inc. v. Papst Licensing GmbH & Co., KG*, IPR2017-00670, Paper 11 (PTAB May 22, 2017) fails as well because Apple was seeking to join a petition that had already been instituted on the same grounds as those in Apple's petition it sought to dismiss, and thus the Board would have to do the work involved in that petition anyway, and Apple would avoid estoppel. In contrast, there has been no institution decision on the grounds raised here.

In any event, any alleged prejudice Patent Owner may incur by the re-filing of a petition is not an issue to be resolved now, but an issue to be addressed once the petition has been re-filed. *See Wavetamer Gyros*, Paper 13 at 3-4. On the other hand, denial of this motion will drastically prejudice Petitioners. Denial would lead to a decision on the current record related to Li when there is irrefutable evidence that Li is prior art – evidence that Petitioners will present in a new petition.

IV. CONCLUSION

For the reasons stated above, Petitioners respectfully request that the Board dismiss the underlying Petition and terminate this IPR without prejudice.

Dated: October 10, 2023

Respectfully submitted:

/s/ Benjamin Hershkowitz

Benjamin Hershkowitz

(Reg. No. 41,833)

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on the 10th day of October, 2023, the foregoing was served via electronic mail upon the following counsel for Patent Owner:

- Brian J. Eutermoser, beutermoser@kslaw.com;
- Mikaela M. Stone, mikaela.stone@kslaw.com;
- Russell E. Blythe, rblythe@kslaw.com.

DATED: October 10, 2023

By: /s/ Benjamin Hershkowitz

Benjamin Hershkowitz
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EXHIBIT A

Brzozowski, David

From: Best, Timothy P.
Sent: Tuesday, September 26, 2023 8:35 PM
To: trials@uspto.gov
Cc: Brian Eutermoser; Mikaela Stone; Russell Blythe; *** Webroot-Sophos
Subject: IPR2023-00731 and IPR2023-00732

Dear Honorable Board:

To follow-up on our previous correspondence below sent on Friday, September 22nd, Petitioners request, pursuant to 37 C.F.R. § 42.72, permission to file a Motion to Dismiss both IPR2023-00731 and -00732 without prejudice. Petitioners seek such permission so as to enable Petitioners to re-file their petitions challenging U.S. Patent Nos. 8,201,243 and 8,719,932 to include new declarations supporting the public availability of a printed publication cited as invalidating prior art in the foregoing petitions.

Petitioners believe that 5 pages suffice for their Motion, should this request be granted.

The parties have conferred, and Patent Owner opposes Petitioners' request.

Should a conference call be required to discuss Petitioners' request, the parties are available at the below times/dates (all in ET):

1. 1PM - 2PM and 3PM – 3:30 PM ET on 09/27
2. 11 AM – 12:30 PM ET on 09/29
3. 1 PM – 3 PM ET on 10/02.

Sincerely,

Timothy P. Best

Partner

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GIBSON DUNN

Gibson, Dunn & Crutcher LLP
333 South Grand Avenue, Los Angeles, CA 90071-3197

From: Best, Timothy P. <TBest@gibsondunn.com>
Sent: Friday, September 22, 2023 12:05 PM
To: trials@uspto.gov
Cc: Brian Eutermoser <BEutermoser@kslaw.com>; Mikaela Stone <Mikaela.Stone@kslaw.com>; Russell Blythe <RBlythe@kslaw.com>
Subject: IPR2023-00731 and IPR2023-00732

Dear Honorable Board:

In response to your below communication requesting that we file copies of the linked webpages as exhibits to the Declaration of Sylvia D. Hall-Ellis, Petitioners intend to seek permission from the Board to withdraw the petitions instead. Specifically, Petitioners intend to request, pursuant to 37 C.F.R. § 42.72, permission to file a Motion to Dismiss both IPR2023-00731 and -00732 without prejudice. Petitioners have asked Patent Owner whether it opposes such a motion and we are waiting to hear from it on its position. As soon as Patent Owner provides its position, Petitioners will email the Board to seek permission to file a motion to withdraw.

Sincerely,
Timothy Best
Counsel for Petitioners

From: Trials <Trials@USPTO.GOV>
Sent: Friday, September 15, 2023 1:27 PM
To: Hershkowitz, Benjamin <BHershkowitz@gibsondunn.com>
Cc: Brian Eutermoser <BEutermoser@KSLAW.com>; Russell Blythe <RBlythe@KSLAW.com>; Mikaela Stone <Mikaela.Stone@KSLAW.com>; Trials <Trials@USPTO.GOV>
Subject: IPR2023-00731, 732

[WARNING: External Email]

Counsel,

From the Board –

In IPR2023-00731 and 732, Petitioner supplies a Declaration of Sylvia D. Hall-Ellis (Exhibit 1009) that cites several hyperlinks as evidence. *See, e.g.* Ex. 1009 nn.1-28. Our rules require that “[a]ll evidence must be filed in the form of an exhibit.” 37 C.F.R. § 42.63(a).

To comply with this rule, Petitioner must file copies of the linked webpages as exhibits no later than one week from today. Failure to do so will result in the Board not considering these hyperlinked webpages as evidence in these proceedings. Apart from filing an updated exhibit list, Petitioner should not file any briefing or further explanation of these exhibits.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office