

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SOPHOS LTD. AND SOPHOS INC.,  
Petitioner,

v.

OPEN TEXT INC.,  
Patent Owner.

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IPR2023-00731<sup>1</sup>  
IPR2023-00732  
Patent 8,201,243 B2  
Patent 8,719,932 B2

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Before JUSTIN T. ARBES, BARBARA A. PARVIS, and  
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

ORDER  
Denying Motion to Dismiss  
*37 C.F.R. § 42.71(a)*

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<sup>1</sup> The Board exercises its discretion to mail the same Order in both of these proceedings. The parties are not authorized to use this caption format.

IPR2023-00731 (Patent 8,201,243 B2)

IPR2023-00732 (Patent 8,719,932 B2)

Petitioner filed a Motion to Dismiss the Petitions (Paper 19, “Mot.”<sup>2</sup>) in IPR2023-00731 and IPR2023-00732 in accordance with our authorization (Paper 17). Patent Owner filed an Opposition to the Motion (Paper 20, “Opp.”).

Petitioner seeks dismissal of both Petitions without prejudice so that it can file new petitions with new public accessibility evidence regarding the Li reference (Ex. 1005). Mot. 1. Petitioner contends that prior Board decisions have dismissed pre-institution petitions over a patent owner’s objections. *Id.* at 2 (citing *Wavetamer Gyros, LLC v. Seakeeper, Inc.*, IPR2017-01931, Paper 13 (PTAB Jan. 9, 2018); *Samsung Elecs. Co. v. Nvidia Corp.*, IPR2015-01270, Paper 12<sup>3</sup> at 3–4 (PTAB Dec. 9, 2015)). Petitioner further asserts that “[t]ermination will preserve the Board’s resources at this early stage.” *Id.* at 1. Petitioner also asserts that any prejudice to Patent Owner will be minimal because the new petitions will raise the same unpatentability grounds and arguments. *Id.* at 3. Petitioner additionally contends that denying its Motion would “drastically prejudice” Petitioner because “[d]enial would lead to a decision on the current record related to Li when there is irrefutable evidence that Li is prior art.” *Id.* at 4.

Patent Owner argues that “Petitioners belatedly request a do-over for what they implicitly acknowledge is a deficient petition.” Opp. 1. Patent Owner asserts that “Petitioners’ approach would encourage gamesmanship through filing perfunctory placeholder petitions only to be dismissed and re-filed if necessary.” *Id.* at 2–3. In addition, Patent Owner disputes

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<sup>2</sup> This Order cites solely to papers in IPR2023-00731. Similar papers have been filed in IPR2023-00732.

<sup>3</sup> Petitioner incorrectly cites expunged Paper 11. Mot. 2.

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Petitioner’s assertion that termination would only result in minimal prejudice against Patent Owner, as new petitions would require Patent Owner to prepare new preliminary responses. *Id.* at 3. Patent Owner also argues that in past cases involving dismissal, “the potential for a follow-on petition is a reason to deny a motion to dismiss.” *Id.* (citing, e.g., *Fresenius-Kabi USA, LLC v. AstraZeneca AB*, IPR2017-01910, Paper 7 at 4–5 (PTAB Nov. 2, 2017)).

We agree with Patent Owner. In these circumstances, where the Preliminary Responses argue that Petitioner’s evidence fails to establish public accessibility for an asserted reference and then Petitioner essentially concedes the inadequacy of that evidence, it would be unjust not to decide the institution question based on what Petitioner originally filed. *See* Prelim. Resp. 29–36; Mot. 1; *see also* Ex. 3002, 2 (Petitioner requesting to file a Reply to “supplement the record” with additional public accessibility evidence). The *inter partes* review process is designed to be “an effective and efficient alternative to district court litigation.” *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Mar. 24, 2015) (Section II.B.4.i. precedential). As such, a petitioner should set forth its best evidence in a petition and not plan to dismiss and refile that petition when a preliminary response exposes its weaknesses. *See Fresenius-Kabi*, Paper 7 at 5 (determining that a petitioner’s lack of assurance that it will not file follow-on petitions counsels against dismissing the petitions over patent owner’s objections). The Board is also “concerned about encouraging, unnecessarily, the filing of petitions which are partially inadequate.” *ZTE Corp. v. ContentGuard Holdings, Inc.*, IPR2013-00454, Paper 12 at 5–6 (PTAB Sept. 25, 2013) (informative). Dismissing these

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petitions now, with knowledge of Petitioner’s intent to refile new petitions, would condone the filing of inadequate petitions in a “trial-and-error approach,” as Patent Owner correctly points out. *See* Opp. 1.

Petitioner’s reliance on prior, non-precedential Board decisions is unavailing because none of those cases involved a petitioner requesting to refile petitions with new public accessibility evidence. *See* Mot. 2–3. For example, Petitioner’s citation to *Wavetamer* is inapposite because the petitioner there intended to simply replace one mistakenly filed prior art reference with another nearly identical prior art reference, not supplement a defective declaration with three new declarations. IPR2017-01931, Paper 13 at 2–3. *Samsung* is also distinguishable because the petitioner there was time-barred from refiling a second petition. IPR2015-01270, Paper 12 at 3–4.

Petitioner’s assertion that “the interests of justice will be served by having the Board address *the prior art* on its merits” is also misplaced. *See* Mot. 3 (emphasis added). Petitioner asks us to assume that Li is prior art when Li’s prior art status is a major issue disputed by Patent Owner. *See* Prelim. Resp. 29–36. Petitioner’s assertion that denial of this motion “will drastically prejudice Petitioner[]” is also unavailing. Mot. 4. Petitioner reasons that prejudice will stem from denial “when there is irrefutable evidence that Li is prior art,” *id.*, but it is Petitioner who was in control of that evidence and chose not to submit it earlier. Petitioner provides no reason why it could not have filed the new evidence with its Petitions. To the extent there is any prejudice to Petitioner, it is prejudice of Petitioner’s own making. *See SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2018) (“[I]n an inter partes review the petitioner is master of its complaint . . .”);

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*Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. § 312(a)(3))). It is Patent Owner, not Petitioner, who will be prejudiced if we dismiss the Petitions because Patent Owner will have to expend additional resources to respond to new evidence that could have been submitted earlier.

We also disagree that “[t]ermination will preserve the Board’s resources at this early stage.” Mot. 1. First of all, these cases are not at an “early stage,” as Patent Owner has already filed its Preliminary Responses. Secondly, the Board has already expended significant resources analyzing the merits of the Petitions in light of the Preliminary Responses. Just because the Board has not issued an institution decision does not mean that the Board has not undertaken most of the work required to do so. And third, having to review new petitions with significant new evidence will entail expending *additional* Board resources.

Finally, to the extent Petitioner requests not only dismissal, but also permission to refile “without prejudice” (Mot. 1, 4), this is not a form of relief that our rules provide for. Should Petitioner choose to file new petitions, the principles set forth in our decisions related to serial petitions will govern. *See, e.g., General Plastic*, IPR2016-01357, Paper 19.

It is, therefore,

ORDERED that Petitioner’s motions to dismiss the petitions in IPR2023-00731 and IPR2023-00732 are *denied*.

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PETITIONER:

Benjamin Hershkowitz

Timothy Best

GIBSON, DUNN & CRUTCHER LLP

bhershkowitz@gibsondunn.com

tbest@gibsondunn.com

For PATENT OWNER:

Brian Eutermoser

Russell E. Blythe

Mikaela Stone

KING & SPALDING LLP

beutermoser@kslaw.com

rblythe@kslaw.com

mikaela.stone@kslaw.com