

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FORCEPOINT LLC,

Petitioner,

v.

OPEN TEXT INC.,

Patent Owner

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Case IPR2023-00784

Patent No. 8,438,386

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**PATENT OWNER'S REPLY TO STIPULATION**

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

### EXHIBIT LIST

| Exhibit | Description                                                                                                                                                                                                                                                                                                                                                                                                                                                                |
|---------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2001    | Declaration of Professor Alessandro Orso, Ph. D.                                                                                                                                                                                                                                                                                                                                                                                                                           |
| 2002    | <i>Curriculum Vitae</i> of Professor Alessandro Orso, Ph. D.                                                                                                                                                                                                                                                                                                                                                                                                               |
| 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);<br><a href="https://www.law360.com/pulse/articles/1582438/print?section=pulse/courts">https://www.law360.com/pulse/articles/1582438/print?section=pulse/courts</a>                                                                                                                                                                                                               |
| 2008    | U.S. District Courts—Federal Court Management Statistics—Profiles—During the 12-Month Periods Ending March 31, 2018 Through 2023, "Table N/A—U.S. District Courts—Combined Civil and Criminal Federal Court Management Statistics (March 31, 2023)", <i>available</i><br><a href="https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf">https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf</a> |

| Exhibit | Description                                                                                                                                                                                                            |
|---------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2009    | <i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Order Granting Fourth Amended Scheduling Order, Dkt. 160 (W.D. Tex. Jan. 22, 2023)                                |
| 2010    | <i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Claim Construction Order, Dkt. 236 (W.D. Tex. Mar. 16, 2023)                                                      |
| 2011    | <i>Webroot, Inc. and Open Text Inc., v. Forcepoint LLC</i> , Case No. 6:22-cv-342-ADA-DTG, Defendant Forcepoint LLC's Preliminary Invalidity Contentions (W.D. Tex. Sept. 13, 2022) (excerpted)                        |
| 2012    | <i>Webroot, Inc. et al. v. AO Kaspersky Lab et al.</i> , No 6-22-cv-00243, Dkt. 121, Second Amended Complaint For Patent Infringement ( <i>Forcepoint LLC</i> , Case No. 22-cv-00342-ADA-DTG) (W.D. Tex. Dec. 9, 2022) |
| 2013    | <i>Webroot, Inc. and Open Text Inc., v. Forcepoint LLC</i> , Case No. 6:22-cv-342-ADA-DTG, Defendant Forcepoint LLC's Final Invalidity Contentions (W.D. Tex. Nov. 1, 2023).                                           |

On October 24, 2023, Petitioner requested authorization to file a reply and a proposed stipulation regarding what grounds it would agree not to pursue in the co-pending district court litigation. On October 30, 2023, the Board denied Petitioner's request to file a reply, but (i) authorized Petitioner to file its stipulation and (ii) authorized Patent Owner to file a two-page brief addressing the impact of Petitioner's stipulation on factor 4 of the *Fintiv* analysis. IPR2023-00784, Paper 11. Petitioner filed its stipulation on November 1, 2023 (IPR2023-00784, Paper 12), and Patent Owner respectfully submits this reply.

Factor 4 of the *Fintiv* analysis addresses the degree of overlap between the issues in the petition and those before the district court. A stipulation not to pursue at the district court "any ground raised or that could have been reasonably raised" in the petition will mitigate concern over duplicative efforts and conflicting decisions. *Sotera Wireless, Inc. v Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). On the other hand, a limited stipulation not to pursue only the **same grounds** weighs 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) (emphasis added).

Here, Petitioner has offered only the limited stipulation that it "will not pursue in the parallel district court litigation the **specific grounds**" raised in its petition. IPR2023-00784, Paper 12 at 1 (emphasis added). Petitioner's narrow stipulation is

nowhere near the stipulation held to be effective in *Sotera Wireless* and does very little to “ensure that [the] IPR functions as a true alternative to litigation.” *Sand Revolution II*, Paper 24 at 12 n.5. To the contrary, Petitioner’s stipulation preserves its ability to pursue invalidity theories on the exact same prior art in parallel as long as the district court theory is not the specific grounds in the petition.

For example, Petitioner offers to stipulate it will not argue in the district court that the challenged ’386 patent claims are obvious over U.S. Patent No. 9,654,495 to Hubbard (“Hubbard-495”) in view of U.S. Patent No. 8,015,174 to Hubbard (“Hubbard-174”) and further in view of U.S. Patent Application Publication No. 2008/0175266 to Alperovitch (“Alperovitch”). But Petitioner’s final district court invalidity contentions include a nearly identical argument based on Hubbard-495 in view of Alperovitch and state that Hubbard-174 is “Background Art.” (Ex. 2013 144-150.) Petitioner has also presented ***fifty-eight (58)*** additional combinations in its final invalidity contentions to be pursued alongside any instituted *inter partes* review. (*Id.* 146-149.).

Petitioner has not explained its failure to offer this new stipulation along with its petition, or at any point before Patent Owner submitted its preliminary response. Petitioner’s belated concern that institution should be denied under *Fintiv* cannot be remedied by removing a single grain of sand from its pail of district court arguments. Factor 4 of the *Fintiv* analysis continues to weigh strongly for discretionary denial.

Patent Owner's Reply to Stipulation  
Patent No. 8,438,386

Date: November 3, 2023

Respectfully submitted,

KING & SPALDING LLP

/s/ Brian Eutermoser

Brian Eutermoser

Registration No. 64,058

Attorney for Patent Owner

*Open Text Inc.*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REPLY TO STIPULATION** was served by filing the document through the Patent Trial and Appeal Case Tracking System (P-TACTS) on November 3, 2023 and courtesy copies were also served via electronic mail, in their entirety on the following:

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