

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB,

Petitioner,

v.

OPEN TEXT INC.,

Patent Owner.

Case No. IPR2023-00895

Patent No. 10,284,591

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION

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Patent Trial and Appeal Board
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EXHIBIT LIST

Exhibit	Description
2001	Declaration of Professor Nenad Medvidovic, Ph.D in Support of Patent Owner's Preliminary Response To Petition
2002	<i>Curriculum Vitae</i> of Professor Nenad Medvidovic, Ph.D.
2003	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky.</i> , Case No. 6:22-cv-00243, Complaint for Patent Infringement, Dkt. 1 (W.D. Tex., March 4, 2022)
2004	<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)
2005	<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)
2006	<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)
2007	<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)
2008	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
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 Fifth Amended Scheduling Order, Dkt. 252 (W.D. Tex. March 29, 2023)

Exhibit	Description
2010	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)”, available https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf
2011	<i>Webroot, Inc. and Open Text Inc., v. AO Kaspersky Lab. et al.</i> , Case No. 6:22-cv-243-ADA-DTG, Defendant’s Preliminary Invalidity Contentions, Appx. B (W.D. Tex., Sept. 14, 2022)
2012	<i>Webroot, Inc. and Open Text Inc., v. Sophos Ltd.</i> , Case No. 6:22-cv-240-ADA-DTG, Defendant’s Preliminary Invalidity Contentions (W.D. Tex., Sept. 13, 2022)
2013	<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)
2014	<i>Setting Repository Visibility</i> , GITHUB DOCS, https://docs.github.com/en/repositories/managing-your-repositorys-settings-and-features/managing-repository-settings/setting-repository-visibility (last visited Sept. 11, 2023)
2015	<i>Calendar of archives for https://github.com/ivanfratric/ropguard</i> , INTERNET ARCHIVE WAYBACK MACHINE, https://web.archive.org/web/20180401000000*/https://github.com/ivanfratric/ropguard (last visited Sept. 11, 2023)
2016	<i>Reviewing Your Security Log</i> , GITHUB DOCS, https://docs.github.com/en/authentication/keeping-your-account-and-data-secure/reviewing-your-security-log (last visited Sept. 11, 2023)

Open Text Inc. ("Patent Owner") submits this Preliminary Response to the Petition of AO Kaspersky Lab ("Petitioner") seeking *inter partes* review ("IPR") of U.S. Patent No. 10,284,591 ("the '591 patent").

I. INTRODUCTION

The Board should deny institution for two reasons: (1) discretionary denial under *Fintiv* is appropriate because the '591 patent is part of an exceptionally complex parallel litigation that is scheduled for trial months before a final written decision, and (2) the petition is not reasonably likely to succeed on the merits because Petitioner fails to show the public availability of the primary reference on which it relies for both of its invalidity grounds and because Petitioner fails to demonstrate that the primary reference it relies on discloses all the limitations of any of the '591 claims.

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 '591 patent almost four 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, Petitioner asserts the same prior art references and another defendant asserts the same primary 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 under 35 U.S.C. § 314(a) because Petitioner has failed to show a reasonable likelihood of success on the merits of its petition. Petitioner relies on Fratric as the primary reference for both of its invalidity grounds, but Petitioner fails to show that Fratric is a prior art printed publication. Specifically, Petitioner does not show that the GitHub repository on which Fratric was allegedly stored was publicly available prior to the priority date of the '591 patent or that an interested POSITA would have been able to find Fratric at that time. This, alone, is fatal to the petition. Additionally, Petitioner relies on Fratric to disclose the independent claims of the '591 patent, but Frantic does not disclose claimed features of the '591 patent and neither Petitioner nor its expert (who simply

parrots the petition) even attempt to explain how the disclosures they rely on purportedly disclose those limitations.

For these reasons, the Board should deny institution.

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

The '591 patent is one of dozens of patents asserted in claims and counterclaims 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. The reasons are easy to see: a district court stay is out of the question, and the district court will consider the very same arguments presented in the petition. Accordingly, 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 highly unlikely. Petitioner cannot avoid the district court trial because it has petitioned for review of only some of the patents asserted against it. And this IPR will not narrow the issues on which discovery and trial must

proceed—the '591 patent is currently asserted against three other defendants, one of whom has not petitioned for IPR of the '591 patent. Moreover, none of Petitioner's codefendants have agreed not to litigate the validity of the '591 patent in the district court if the Board institutes this IPR.

(2) Trial in the district court is expected almost four months before a final written decision. The district court case remains on track. The claims of the '591 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 Petitioner offers no stipulation that it will discontinue pursuing the exact same invalidity theories at the district court.

(5) Petitioner will get its chance to make its arguments before the district court because Petitioner is a defendant 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 Petitioner's 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 Petitioner has identified no evidence that one will (or even might) be. To the contrary, all evidence indicates that a stay is unlikely.

¹ The decision in *Fintiv* addresses various scenarios that may indicate whether a stay may be granted. *Fintiv*, IPR2020-00019, Paper 11 at 6-14. 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.

First, the district court considers issue simplification “the most important factor” in deciding whether to stay patent litigation²—and here, a stay would not simplify anything. The validity of the ’591 patent will be litigated in the consolidated action, whether this petition is instituted or not, because the patent is asserted against three other defendants, none of whom have promised not to pursue invalidity in the district court based on this institution decision.

² See, e.g., EX-2004, *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 Court had already held a *Markman* hearing and “expended significant resources”); EX-2005, *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-2006, *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).

Moreover, the validity of the '591 patent will be litigated in the district court alongside issues regarding 38 *other* patents asserted by and against Petitioner 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 Petitioner alone involves fourteen patents—ten asserted by Patent Owner and four asserted in counterclaims by Petitioner.

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
10,284,591	IPR2023-00895	IPR2022-01522	N/A	Asserted; no IPR	IPR2023-00692
11,409,869	IPR2023-01160	IPR2023-01053	Asserted; no IPR	PGR2023-00031	IPR2023-01380
8,201,243	Asserted; no IPR	IPR2023-01052	Asserted; no IPR	IPR2023-00731	IPR2023-01390
8,719,932	Asserted; no IPR	IPR2023-01051	Asserted; no IPR	IPR2023-00732	IPR2023-01391
8,418,250	IPR2023-01334	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

Patent	Kaspersky	CrowdStrike	Forcepoint	Sophos	Trend Micro
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
8,856,505	Asserted; no IPR	IPR2023-01159	N/A	Asserted; no IPR	IPR2023-01389
8,181,244	N/A	IPR2023-01158	N/A	Asserted; no IPR	IPR2023-01392
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
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-2007 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-2008 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-2010 37.) On that timeline, trial is expected in this case in mid-July 2024. Trial is currently scheduled for August 2024. (EX-2009 8.) The deadline for a final written decision in an IPR here would not be until many months later (in December 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.

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 extend months past the parallel district court litigation. WDTX’s median time-to-trial is 28.2 months (EX-2010 37), indicating a trial by mid-July 2024—a date consistent with the currently scheduled trial date of August 19, 2024. (EX-2009 8.) Should the Board institute, its final written decision deadline would be December 11, 2024, nearly four months after the scheduled trial date.

In other words, if the Board institutes IPR here, the IPR proceedings would not produce a result before the trial, and the parties would 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 (Jan. 22, 2020)); *see id.*, 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”); *eclinicalWorks, 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”).

Petitioner speculates that the district court may ultimately postpone Petitioner's scheduled trial date (Petition 63.), but such speculation carries little

weight where Petitioner provides no supporting evidence. Guidance at 8-9; *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 20 at 8 (PTAB Aug. 25, 2022). Indeed, Petitioner's case is the lead case in the consolidated district court proceeding, suggesting Petitioner's trial would not be delayed. Furthermore, 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 eighteen months. For example, the parties long ago exchanged infringement and invalidity contentions (in July 2022 and September 2022 respectively), and fact

discovery is underway. The Court issued its claim construction order for the '591 Patent on March 16, 2023. (EX-2013.)

The investment in this case is colossal. The district court has already held multiple *Markman* hearings and completed claim construction. Its *Markman* order that included the '591 patent was 20 pages, without even considering the Court's substantive analysis or the additional *Markman* orders issued in this case. (EX-2013.) The Court considered and construed seven claim terms of the '591 patent. (*Id.*) The parties have engaged in extensive discovery on the parties' contentions, during which Petitioner has produced more than 157,000 pages of documents and Patent Owner has made approximately 97GB of source code available. The Court has held multiple discovery hearings. Patent Owner has noticed more than 35 depositions, and the Board's institution decision is not expected until December 11, 2023, just a month before fact discovery is set to close in the district court proceeding. (EX-2013 6.)

Furthermore, Petitioner's 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. *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).

This case is unlike the *Sand Revolution v. Continental Intermodal Group*, decision on which Petitioner relies. (Petition 64.) In *Sand Revolution*, the Markman order was two pages, the case was transferred to a new judge, and the parties had not yet invested in developing the merits. IPR2019-01393, Paper 24 at 11 (PTAB June 16, 2020). And even then, the Court found that this factor weighed at least marginally in favor of exercising discretion. *Id.* Here, where invalidity contentions were exchanged a year ago and the parties and their experts have been reviewing prior art and source code to prepare for expert reports that will be due just a month after the Board's institution decision, this factor weighs in favor of discretionary denial. *Regeneron*, IPR2020-01317, Paper 15 at 17.

Petitioner's delay in filing this petition further weighs for denial. Petitioner waited nearly one year after the complaint and seven months after receiving Patent Owner's infringement contentions before filing its petition. During this time, Petitioner knew that the parties were investing in a rapidly proceeding litigation. Petitioner offers 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.*

Here, Petitioner itself has not offered *any* stipulation that it will not simultaneously pursue in the district court *precisely the same arguments* based on *precisely the same grounds* asserted in its petition during the pendency of any IPR. Indeed, Petitioner raises the same prior art in its district court invalidity contentions.³ Even if Petitioner had offered a stipulation, such a stipulation would carry no weight

³ Petitioner asserts both Fratric and Sallam in its invalidity contentions. (EX-2011 1.)

because it does not bar the other defendants in the parallel litigation from litigating the very same invalidity challenges before the district court. Petitioner's co-defendant asserts the same primary prior art reference in the litigation that is asserted in the petition.⁴ Instituting an IPR would not only multiply the burden on Patent Owner, it would create the possibility of inconsistent decisions between the district court and the Board.

Because Petitioner makes no effort to “mitigate[] any concerns of duplicative efforts between the district court and the Board,” or “of potentially conflicting decisions,” Factor 4 weighs heavily in favor of discretionary denial. *Sotera Wireless v. Moasimo 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—suggests denial because Petitioner is a defendant in the parallel litigation and, as such, will have a full, fair opportunity to litigate its invalidity contentions. 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

⁴ Codefendant Sophos also asserts *Fratric*. (EX-2012 39.)

institution.” *Fintiv*, IPR2020-00019, Paper 11 at 13-14. That is not the case here because Petitioner is a defendant in the litigation. Accordingly, the circumstances raise no fairness concerns that denial would deprive Petitioner of its “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 another defendant is *also* litigating the primary prior art reference 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.*

Petitioner offers no such explanation here. That another defendant is 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, this factor 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 Petitioner would prevail on any challenged claim. *See* 35 U.S.C. § 314(a). For example, the petition is fatally flawed because Petitioner has failed to show that Fratric—its primary reference for both grounds—qualifies as a prior art printed publication. Additionally, Petitioner glosses over the limitations of the '591 patent or misrepresents what Fratric discloses in an attempt to show that Fratric discloses every independent limitation in both grounds. *See* Section III, *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.*, IPR2022-01242,

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. PETITIONER FAILS TO SHOW A REASONABLE LIKELIHOOD THAT IT WOULD PREVAIL WITH RESPECT TO ANY CHALLENGED CLAIM

An IPR may be instituted only if the petitioner demonstrates a “reasonable likelihood” that it would prevail as to at least one of the challenged claims. 35 U.S.C. §314(a). “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 petitioners have the “burden from the onset to show with particularity why the patent it challenges is unpatentable”).

Ground 1	Sections 102 and 103(a)	Anticipated by Frac tric or obvious over Fratric	Claims 1, 3, 4, 6, 9, 11, 12, 14, 17
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Ground 2	Section 103	Obvious over Fratric in view of Sallam	Claims 2, 5, 7, 8, 10, 13, 15, 16
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Petitioner relies on Fratric, in whole or in part, for every claim limitation. Petitioner's reliance on Fratric is flawed because Petitioner has not met its burden to prove that Fratric is a prior art printed publication. Additionally, Petitioner fails to explain how Fratric discloses or renders obvious every limitation of the '591 patent.

Petitioner contends that "Fratric is ... prior art under at least 35 U.S.C. § 102(a)(1)." (Petition at 15.) The touchstone inquiry for a printed publication under Section 102(a)(1) is whether "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." *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981). Petitioner has not met its burden to prove that the GitHub repository (where Fratric was purportedly hosted online) was publicly available before the priority date of the '591 patent. Moreover, Petitioner has not met its burden to prove that a POSITA exercising reasonable diligence would have been able to locate Fratric at that time, even if the repository was "public."

Petitioner additionally fails to explain how Fratric discloses or renders obvious every limitation of the '591 patent. Petitioner's expert does nothing more than generally repeat verbatim the insufficient arguments in the petition. Petitioner

also mischaracterizes the '591 patent claim limitations in order to allegedly find their equivalents in Fratric. Thus, as explained below, Petitioner has not met its burden, and institution should be denied.

A. Fratric Is Not a Printed Publication Under 35 U.S.C. § 102(a).

“At the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). It is Petitioner’s burden to “produce sufficient proof of [the reference’s] 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.” *Sandoz, Inc. v. AbbVie Biotechnology Ltd.*, IPR2018-00156, Paper 11 at 10 (PTAB June 5, 2018).

As such, it is not sufficient for the reference to have merely “***existed***.” *Topcon Medical Sys., Inc. et al v. Car Zeiss Meditec, Inc.*, IPR2021-00452, Paper 14 at 13 (PTAB July 21, 2021) (emphasis in original). An interested POSITA must have been able to access the reference, “for example, by clicking on operable links that led to” the document. *Id.* at 14.

Petitioner's only evidence that Fratric was publicly available at the critical date is an undated, unsourced, and unauthenticated screenshot of the repository on which Fratric is allegedly stored. (Petition at 16-17.) Notably, Petitioner does not show that Fratric was actually "publicly viewable" (as Petitioner claims to show) as of the critical date. (*Id.*) Petitioner glosses over the fact that GitHub repositories can be toggled between public and private at will. EX-2014 (<https://docs.github.com/en/repositories/managing-your-repositorys-settings-and-features/managing-repository-settings/setting-repository-visibility>.) Additionally, Petitioner makes no showing that, even if Fratric was public, an interested POSITA would have been able to locate Fratric through the use of GitHub's search functionality. (Petition at 16-17)

1. Petitioner has not provided evidence that Fratric was "publicly viewable" as of the priority date of the '591 patent.

Petitioner has not provided evidence that the GitHub repository where Fratric was purportedly located was "publicly viewable" as of January 27, 2014, the priority date of the '591 patent. (Petition 16-18.) Petitioner only states that "[t]he repository in which Fratric *is* stored *is* publicly viewable." (Petition 17⁵.) Although the

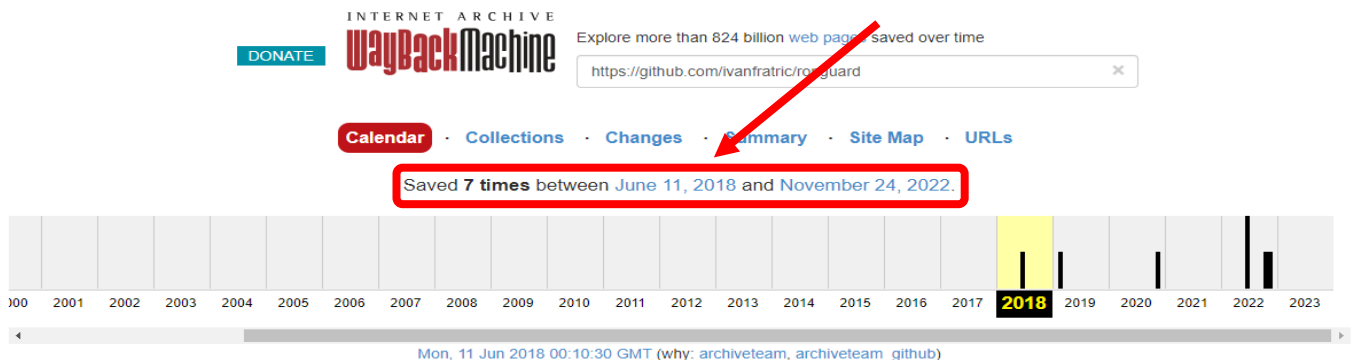
⁵ All emphasis is added unless otherwise noted.

repository is *currently* publicly viewable, as addressed below, evidence suggests that it was *not* publicly viewable in 2014. Thus, Petitioner's reliance on Fratric is misplaced. *Topcon*, IPR2021-00452, Paper 14 at 17 (finding that an "unexplained current link to a website that purports to contain [the document] dated years earlier" was insufficient to show it was available as of a particular date).

In *Topcon*, the petitioner relied on a research article referred to as "Abe," which was allegedly published as an online-only article in the summer of 2016 (before the critical date of the challenged patent). *Topcon*, IPR2021-00452, Paper 14 at 11. Though the copy of Abe that the petitioner submitted did not contain a publication date, the petitioner provided an Internet Archive record and affidavit purporting to show that the article was publicly available as a printed publication at the critical date. *Id.* However, the Internet Archive record showed a broken link for an image critical to the petitioner's substantive arguments. *Id.* at 13. The Board held that the missing piece of information rendered the petitioner's showing of public accessibility insufficient because the petitioner was unable to prove that the missing piece was public at the critical date. *Id.* at 20. The Board denied the petition as a result. *Id.* at 22.

Petitioner's evidence here is even more deficient than the petition in *Topcon*. Petitioner does not even allege that the repository containing Fratric was publicly

viewable at the critical date of the '591 patent, only that it is **currently** publicly viewable. Petitioner also has not provided an "Internet Archive record and affidavit purporting to show that the article was publicly available as a printed publication by at least [the critical date]." See *Topcon*, IPR2021-00452, Paper 14 at 11; *c.f. Sandoz*, IPR2018-00156, Paper 11 at 10 (holding evidence from the Internet Archive sufficient to show that a source was publicly available on the FDA's website at the critical date). On the contrary, the Internet Archive actually suggests the opposite: that Fratric was *not* publicly available at the critical date. The earliest record of Fratric on the Wayback Machine is from 2018, four years after the critical date of the '591 patent.



(EX-2015 (showing that the Fratric repository was first indexed only in June 2018, after the critical date of the '591 patent) (https://web.archive.org/web/20180401000000*/https://github.com/ivanfratric/ropguard)).)

As Petitioner explains, GitHub repositories can be designated “public,” “private,” or “internal.” (Petition 17.) Private repositories are hidden from the public, but the repository administrator can toggle a private repository to public (and vice versa) at any time. (EX-1011.) The record of when a repository was changed from private to public is not visible to anyone except the repository owner, even if the repository is public. (See EX-2016 (explaining that the security log enables the user to “understand actions you’ve performed.” <https://docs.github.com/en/authentication/keeping-your-account-and-data-secure/reviewing-your-security-log>.) The GitHub Security Log, where this information is stored, only lists actions performed in the last 90 days. (*Id.*)

Petitioner muddies the issue of Fratric’s alleged public availability by claiming that “Fratric was published at least as of the GitHub ‘Latest commit’ date of August 26, 2012.” (Petition 17.) To be clear, the “Latest commit” date is **not** the date the repository was changed from private to public. (EX-1010.) The “Latest commit date” is the last time information was committed to the repository; however, the “Latest commit” date does not indicate whether the repository was public or private on that commit date. (See *id.*)

Petitioner has failed to provide any evidence that the repository where Fratric was purportedly located was a public repository at the critical date, and the evidence

suggests the opposite. Thus, Petitioner's characterization of Fratric as a prior art printed publication is unsupported, and Fratric should not be considered prior art for purposes of Petitioner's invalidity challenge.

2. Petitioner has not proved that an interested POSITA would have been able to locate Fratric "using [GitHub's] own search functions."

One factor that bears on public availability is whether "a skilled artisan would have been independently aware of the prominence of the forum and would have used the website's own search functions to find the document." *Int'l Bus. Machs. Corp. v. EnvisionIT LLC*, IPR2017-01246, Paper 7 at 15 (PTAB October 16, 2017). Petitioner alleges only that "GitHub is meaningfully searchable," and provides no evidence of the prominence of the forum or that a POSITA exercising reasonable diligence would have actually been able to use GitHub's search functions to find Fratric. (Petition 18.)

Petitioner cites *In re Lister*, 583 F.3d 1307 (Fed. Cir. 2009) to support its argument that Fratric's alleged availability on GitHub means it is prior art. (Petition 18-19.) In *Lister*, the court held that certain relevant keywords could have been used to identify the reference in a search of a public database. *Lister*, 583 F.3d at 1310 ("an interested researcher would have been able to find the [reference in question] by searching the Copyright Office's catalog by title for the word 'golf' in

combination with the word ‘handicap.’”). Here, by contrast, Petitioner has not demonstrated that an interested POSITA exercising reasonable diligence could find Fratric through the use of keywords. Unlike in *Lister*, where the court identified specific keywords that could be used to locate the reference in a search, Petitioner has not identified any keywords that could be used to identify Fratric in a GitHub search. *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 774 (Fed. Cir. 2018) (upholding the Board’s finding that “although [the reference] was indexed by author and year, it was not meaningfully indexed such that an interested artisan exercising reasonable diligence would have found it, which is a proper consideration under our precedent.”); *see also Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1349 (Fed. Cir. 2016) (“indexing, whether through search engines or otherwise, is also an important question for determining if a reference stored on a given webpage in cyberspace is publicly accessible”) (cleaned up).

Petitioner’s unsupported assertion that “GitHub’s integrated search covers the many repositories, users, and lines of code on GitHub” is insufficient because it does not prove that a keyword search in GitHub would actually return Fratric as a result. (Petition 18.) Moreover, Petitioner acknowledges that GitHub’s search function only returns files in public repositories. (*Id.*; *see* EX-1013.) If Fratric’s repository was not public at the critical date, as addressed in Section III.A.2, a GitHub search would not

return Fratric as a result, no matter what search terms were used. Therefore, an interested POSITA exercising reasonable diligence could not find a private repository through GitHub's search.

In sum, Petitioner has failed to establish that Fratric is a prior art printed publication. Proving Fratric's public accessibility is the Petitioner's burden, and Petitioner has failed to meet it. *See Sandoz*, IPR2018-00156, Paper 11 at 10. Evidence suggests that the GitHub repository on which Fratric was allegedly stored before the priority date of the '591 patent was not publicly accessible. And Petitioner has failed to prove that an interested POSITA would have been able to locate Fratric. Because Petitioner relies on Fratric as the primary reference in both grounds of its petition, Petitioner's failure of proof on this issue is fatal to the entire petition.

B. Petitioner Fails to Explain How Fratric Discloses or Renders Obvious Every Limitation of the '591 Patent.

Petitioner does not demonstrate a reasonable likelihood of success in proving any challenged claim unpatentable because the petition fails to establish that Petitioner's prior art discloses or renders obvious every limitation of independent claims 1, 9, and 17 of the '591 patent. Petitioner relies on Fratric alone for these independent claims.

A petition must include "a detailed explanation of the significance of the evidence." *See* 37 C.F.R. § 42.22(a)(2); *see also* 35 U.S.C. § 312(a)(3); *Lumenis Be*

Ltd. v. BTL Healthcare Techs. A.S., IPR2021-01280, Paper 8 at 22 (PTAB Mar. 9, 2022) (declining to institute where petitioner's argument lacked explanation and the Board was unwilling to speculate). Petitioner's arguments are nothing more than vague assertions about the prior art that force both Patent Owner and the Board to speculate as to their significance.

Moreover, Petitioner's expert often repeats the same vague arguments presented in the petition nearly verbatim. Not only is this improper use of an expert declaration, but it also renders the petition inadequate. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (*precedential*) (designated Feb. 10, 2023) (finding an expert's declaration that "merely repeats" conclusory assertions without additional supporting evidence or any technical reasoning is "entitled to little weight," particularly where the testimony is offered to supply a limitation missing from the prior art); 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."). Because Petitioner's arguments are unsupported, the Board should deny institution.

1. [1.1.a] Fratric does not disclose "monitoring a memory space ... for execution of at least one monitored function."

The '591 patent requires "monitoring a memory space ... for execution of at least one monitored function." Petitioner does not explain how Fratric purportedly

teaches monitoring a memory space for the *execution* of monitored functions. Because Petitioner has failed to explain a crucial element of the limitation, Petitioner has not met its burden.

Petitioner addresses only the “monitored function” and “monitoring a memory space” elements of this limitation, ignoring the “execution” requirement. (Petition 25-26.) Petitioner argues that Fratric’s “critical function” is a “monitored function” in the ’591 patent and asserts that “Fratric discloses monitoring a memory space of a process.” (*Id.*) Then, Petitioner describes each of “six checks” that are “performed at each critical function call.” (Petition 20-23.) But Petitioner does not explain how Fratric discloses “monitoring a memory space ... for execution of at least one monitored function.”

Petitioner’s expert does not add any clarity. Dr. Subrahmanian misinterprets the claim by suggesting that “[l]imitation [1.1.a] first requires ‘execution of at least one monitored function of a plurality of functions.’” (EX-1002 ¶99.) But, the limitation requires ***monitoring the memory space for execution*** of the function, not merely that the function is executed. Dr. Subrahmanian explains that a POSITA “would have understood the call of at least one critical function from the ROP code is the execution of the at least one monitored function.” (EX-1002 ¶100.) But that statement merely describes the function being executed. It does not address the

relevant claim limitation, which requires monitoring a memory space for execution of a monitored function.

Petitioner thus falls short of its burden to show that Fratric discloses ***“monitoring a memory space ... for execution of at least one monitored function.”***

2. [1.2] Fratric does not disclose **“invoking one of the plurality of functions as a result of receiving a call from an application programming instance.”**

Petitioner fails to explain how Fratric purportedly teaches limitation [1.2] because Petitioner ignores the claim requirement that one of the plurality of functions is invoked “as a result of receiving a call from an application programming instance.” (Petition 28-29.) For this limitation, Petitioner—without any explanation—argues that “the ROP code” in Fratric is the “application programming instance” recited in the '591 patent claims. (*Id.*) To be clear, Petitioner does not include any explanation at all as to why it contends that “the ROP code” is equivalent to the claimed “application programming instance.” Rather, Petitioner relies solely on a parenthetical notation. (Petition 28-29 (“[T]he attacker will need to **call at least one critical function**’ (*invoking one of the plurality of functions*) ‘**from the ROP code**’ (*application programming instance*).” (emphasis in original).) Petitioner’s expert does not provide any explanation as to why the two are equivalent and simply repeats the same conclusory statement. (EX-1002 ¶122; *Xerox*, IPR2022-00624,

Paper 9 at 15 (*precedential*) (designated Feb. 10, 2023) (finding an expert's declaration that "merely repeats" conclusory assertions is "entitled to little weight.")).) For this reason alone, the Petition should be denied.

Setting aside Petitioner's insufficient explanation, Fratric's ROP code cannot be an "application programming instance" as claimed in the '591 patent because ROP code has several key characteristics that differentiate it from an application programming instance, even using Petitioner's definition. (EX-2001 ¶¶27-31.)

An application programming instance, by its very nature, is an *instance*. Petitioner's expert explains that "[i]n programming, an instance is an occurrence of a *class or object* of a computer program." (EX-1002 ¶122; EX-2001 ¶29.) However, neither Petitioner nor its expert make any attempt to show that the ROP code meets their own definition.

For example, a programming "class" is an extensible template that can be executed to create objects, which are manipulatable versions of that class template. (EX-2001 ¶29.) So, as a class or object, the application programming instance must be a section of code delineated by a definition or template or a manipulatable version of a class template. (EX-2001 ¶29.) Because it is clearly delineated by a standard structure, another characteristic of an application programming instance is that it is a consistent and repeatably executable part of the code. (EX-2001 ¶29.) Because

application programming instances are used to expose a particular functionality of one piece of code for use by other programs, they must also be readily identifiable and consistent. (EX-2001 ¶30.)

In contrast, ROP code is composed of various stitched-together fragments of existing executable code scattered in the computer's memory. (EX-1007 1.) The same ROP code could lead to entirely different results depending on how the stack is aligned (EX-1007 2 (“the attacker transfers the execution flow to the beginning of an existing function and *aligns the stack in such a way* that the return address of this function is in fact the address of the next function that the attacker wants to execute.”).) In other words, the attacker directs the flow of code by manipulating stack contents. As a result, ROP code is not located in one file or under one header, but rather is comprised of piecemeal code snippets executed *ad hoc* by the attacker through stack manipulation. (EX-2001 ¶31.) Thus, by its very nature, ROP code is not consistent, repeatably executable, or readily identifiable.

Petitioner's parenthetical notation—devoid of any elaboration—purports to equate ROP code to an application programming instance, but the two are different. Where ROP code is scattered in computer memory and has its control flow directed by the alignment of the stack, an application programming instance is a repeatable, well-defined class or object code. (EX-2001 ¶¶29-31.) Where ROP code is

comprised of piecemeal code snippets, an application programming instance is located under one file or header. (EX-2001 ¶¶29-31.)

Because Petitioner has failed to explain why ROP code is an application programming instance, Petitioner fails to establish that Fratric discloses the claim limitation “invoking one of the plurality of functions as a result of receiving a call from an *application programming instance*.” And as demonstrated above, the argument that Petitioner appears to be making is flawed. Accordingly, the Board should deny institution because Petitioner has failed to identify how Fratric purportedly discloses “invoking one of the plurality of functions as a result of receiving a call from an *application programming instance*.”

C. Petitioner fails to show a reasonable likelihood of success as to any of the challenged claims.

Petitioner offers no new reasoning for independent claims 9 and 17, except for their preambles and two unique limitations. (Petition 41-47.). Accordingly, for the reasons discussed above with reference to claim 1, Petitioner's failure to show a reasonable likelihood that claim 1 is obvious over Fratric extends to independent claims 9, 17, and their dependent claims.

Regarding the dependent claims, because Petitioner fails to establish a reasonable likelihood of success as to any independent claim, Petitioner has failed to show a reasonable likelihood of prevailing with respect to any of the challenged

claims. *Twinstrand Biosciences, Inc. v. Guardant Health, Inc.*, IPR2022-01115, Paper 14 at 19 (PTAB Dec. 30, 2022).

IV. OTHER LIMITATIONS NOT ADDRESSED

At this preliminary stage, Patent Owner addresses only those deficiencies in the prior art necessary to clearly show a lack of reasonable likelihood of the petition's success. Patent Owner's decision not to address certain limitations or secondary prior art references at this preliminary stage in no way reflects Patent Owner's agreement with any unaddressed contention in the petition or lack of dispute as to additional limitations or prior art.

V. THERE ARE SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS

In determining obviousness of the claimed invention, objective evidence of secondary considerations pertaining to nonobviousness must be considered, including long-felt but unsolved needs, failure of others, and commercial success. *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)); *Leo Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346, 1358 (Fed. Cir. 2013).

Patent Owner currently accuses at least four industry participants, including Petitioner, of infringing the innovative technology claimed in the '591 patent, demonstrating the critical need and widespread industry reliance on these novel

methods. (Paper 3 at 1.) Petitioner, for example, markets and provides Kaspersky Endpoint Security, the components of which practice the systems and methods claimed in the '591 patent. (EX-2003 ¶¶214-244.)

Accordingly, secondary objective indicia of nonobviousness exist, such that Petitioner's grounds fail. (EX-2001 ¶¶272-274.)

VI. CONCLUSION

For all the reasons stated herein, Petitioner has failed to establish that the challenged claims of the '591 Patent are unpatentable. Patent Owner respectfully requests the Board find the challenged claims patentable over the grounds in the Petition.

Date: September 11, 2023

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S PRELIMINARY RESPONSE** specified in 37 C.F.R. § 42.24 have 7,894 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.2202.

Date: September 11, 2023

Respectfully submitted,

King & Spalding LLP

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Attorney for Patent Owner
Open Text Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** and all supporting **EXHIBITS 2001 - 2016** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) on September 11, 2023 and courtesy copies were also served via electronic mail, in their entireties on the following:

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