

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB,
Petitioner

v.

OPEN TEXT INC.,
Patent Owner.

IPR2023-00895
Patent 10,284,591 B2

Before BARBARA A. PARVIS, MICHELLE N. WORMMEESTER, and
AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

AO Kaspersky Lab (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–17 of U.S. Patent No. 10,284,591 B2 (Ex. 1001, “the ’591 patent”) and Open Text Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). After consideration of the parties’ contentions and evidence, we declined to institute an *inter partes* review of the ’591 patent. *See* Paper 7 (“Decision” or “Inst. Dec.”).

Petitioner has now filed a Request for Rehearing of the Decision. *See* Paper 8 (“Request”). For the reasons that follow, Petitioner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. *See* 37 C.F.R. § 42.71(d). A petitioner who requests rehearing of a decision denying institution must specifically identify all matters that were allegedly misapprehended or overlooked, and where each matter was addressed in the petition. *See id.* When reconsidering such a decision, we review it for an abuse of discretion, which may exist if the decision was based on legal error, if a factual finding was not supported by substantial evidence, or if weighing of relevant factors was unreasonable. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

III. ANALYSIS

The Petition asserted that the challenged claims are unpatentable in view of Fratric (claims 1, 3, 4, 6, 9, 11, 12, 14, and 17) and Fratric and Sallam (claims 2, 5, 7, 8, 10, 13, 15, 16). *See* Pet. 15. We declined to institute an *inter partes* review because we concluded that Petitioner had not

made a sufficient showing that Fratric was publicly available prior to the critical date. *See* Decision 9–10.

Petitioner now argues that our decision was an abuse of discretion because (a) “[t]he record contains ample evidence to establish that [Fratric] meets the requirements of 35 U.S.C. § 102,” and (b) “additional evidence . . . which was unavailable to Petitioner when the Petition was filed . . . provides further indicia of public accessibility” and “[g]ood cause supports admission and consideration of this evidence.” Request 1. Petitioner’s arguments are not persuasive.

A. Evidence Filed with the Petition

The Petition relied on the screenshot reproduced on its page 17 to show that Fratric was publicly available prior to the critical date. According to Petitioner, the screenshot showed that “Fratric was published at least as of the GitHub ‘Latest commit’ date of August 26, 2012, displayed on the publicly-accessible GitHub, Inc. webpage.” Pet. 17 (citing Ex. 1002 ¶ 77). Petitioner argued that “[t]he GitHub repository of Fratric is a public repository” and that, “[t]herefore, Fratric was sufficiently accessible to [a person of ordinary skill in the art] at least as of the date of publication on GitHub.” *Id.* at 17–18.

We found Petitioner’s showing insufficient because “there [was] nothing in the record to show that the screenshot was of material that existed prior to the ’591 patent’s filing date” and “the record show[ed] that the visibility setting of a GitHub repository may be changed . . . and there [was] no evidence that the ‘Public’ setting shown in the screenshot had not changed over time.” Decision 9–10. In other words, if Petitioner’s argument was that the screenshot confirmed public availability because the

screenshot was *pre-critical date material* showing public visibility, there was no support for such a date, and if Petitioner’s argument was that the screenshot confirmed public availability *regardless of its actual date*, that also was insufficient, because the GitHub visibility setting can be changed, and there was nothing to show that the “public” setting indicated on the screenshot was the setting prior to the critical date.

Petitioner now contends that “[t]he screenshot in the Petition was annotated to highlight the very information the Board contends is missing from the Petition” because it shows the file name, visibility, and commit info. Request 4.¹ That simply ignores the problem, which is that, as explained above, the screenshot has not been shown to exist prior to the critical date, and the screenshot has not been shown to reflect the status of the document prior to the critical date.

Petitioner also asserts that “Exhibit 1007 and the Petition screenshot recite ‘[l]atest commit 5b31449 on Aug 26, 2012,’” which, Petitioner contends, “is a clear reference to August 26, 2012, a date preceding the critical date by 17 months.” Request 5. This is unpersuasive because, again, it does not show that the visibility was “public” when the document was committed in 2012. *See* Decision 10. Even if, as Petitioner argues, the screenshot proves that “the Fratric Whitepaper is a document saved in 2012,” that still would be insufficient to show that it was *publicly available* in 2012.

¹ Petitioner asserts that “[t]he screenshot in the Petition is simply a depiction of the first portion of Exhibit 1007 viewed within the GitHub webpage interface.” Request 4. To be clear, the screenshot is not taken from Exhibit 1007.

Petitioner additionally argues that “Dr. Subrahmanian noted several facts relevant” to whether the Petition showed a reasonable likelihood of proving public accessibility, including that “GitHub was established in 2008, six years before the critical date,” “GitHub is an open-source repository viewable by anyone,” “[t]he prior art reference authored by Ivan Fratric is a whitepaper,” “[t]he visibility of the Fratric Whitepaper is set at ‘Public,’” and “[t]he Fratric Whitepaper has a commit date of 2012.” Request 7. This is not persuasive. Given that GitHub submissions can be either public or private, none of the date GitHub was established, GitHub’s general mission, the fact that Fratric was a “whitepaper,” the fact that Fratric may have been “public” at some unspecified point in time, or the 2012 commit date are sufficient to show that Fratric was made public when it was committed.

Petitioner argues that “[b]y its very nature, a whitepaper is an informational document created to *promote* or highlight the features of a solution to a problem, not conceal them” and that “GitHub further articulates its objective to make ‘open source projects’ accessible and available to the public.” Request 8. These arguments are also unpersuasive, because the facts that whitepapers *in general* are disseminated, and that open source projects *in general* may be public, are insufficient to show that Fratric *in particular* was public. Fratric’s author may have originally made the document private and changed it later.

Petitioner’s argument that “there is no evidence the [”public”] setting was ever changed” is unpersuasive because it was Petitioner’s affirmative burden to establish public accessibility prior to the critical date. *See Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). The screenshot, which we assume

was generated recently, might be sufficient to show that Fratric was public at some unidentified point in time, but it is not sufficient to show that it was public prior to the critical date. The evidence submitted with the petition was simply insufficient to establish a reasonable likelihood that Petitioner would be able to prove public accessibility prior to the critical date.

Petitioner argues that we “presumed the GitHub visibility setting for the Fratric Whitepaper had at one time been set to private,” that “[t]here is no evidentiary basis or legal precedent for such a presumption,” and that we “then placed conclusive weight on the presumed ‘evidence’ and discounted all the other evidence that supports the contrary conclusion that the visibility was always set on ‘public.’” Request 9. That is not correct—we did not impose a presumption that the visibility had changed. Instead, we simply faulted Petitioner for not making a sufficient showing that the document was set to “public” prior to the critical date, which, again, was its burden. There is no evidence that “the visibility was always set on public,” as Petitioner argues.

For these reasons, we do not agree that we overlooked or misapprehended evidence submitted with the Petition concerning the public accessibility of Fratric on GitHub in 2012. Moreover, as we discuss in more detail below, the new exhibits Petitioner submitted with the rehearing request show that Fratric originally existed in a repository called Google Code and was only later moved to GitHub. Thus, Fratric was, in fact, *not* committed to and made public via GitHub on August 26, 2012, as argued in the Petition.

B. New Evidence

In addition to arguing that the original evidence was sufficient, Petitioner has filed new Exhibits 1032–1042 and asserts that good cause supports their admission.² For the reasons given below, we do not find good cause for the admission of these new exhibits.

Exhibits 1032–1042

Exhibits 1032–1042 are a collection of documents that Petitioner describes as “more fully demonstrat[ing] the public accessibility of the Fratric Whitepaper.” Request 16. Petitioner asserts that it “sought to obtain documentary and other evidence from the author of the Fratric Whitepaper for months prior to the filing of the Petition,” but “discovered that he resides in Zurich, Switzerland, beyond the subpoena power of U.S. courts.” *Id.* at 13. Petitioner further asserts that “[f]or months, [it] solicited assistance from Mr. Fratric to demonstrate the public accessibility of the Fratric Whitepaper with no success.” *Id.* Petitioner then asserts that “[a]fter receiving the [institution decision], Petitioner made a final effort to reach Mr. Fratric” and that “[o]n December 23, 2023, Mr. Fratric sent a LinkedIn message and again conveyed his desire to avoid involvement,” but that “he also provided a substantive response regarding the public accessibility of the Fratric Whitepaper.” *Id.*

Mr. Fratric’s LinkedIn response is shown in Exhibit 1036, stating that “[t]he ROPGuard project and everything around it is public” and that “the open-sourcing of the project was announced in multiple places” including on his blog and on Twitter. Exhibit 1037 shows a Tweet from Mr. Fratric stating that “ROPGuard, my #BlueHatPrize project is now available on

² Petitioner did not request authorization to file the new exhibits.

Google Code, code.google.com/ropguard.” Exhibit 1038 shows a blog post in which Mr. Fratric similarly asserts that he “published the entire [ROPGuard] project on Google Code.” Both the Tweet and the blog post are dated August 26, 2012. Exhibit 1040 is a printout from Google Code indicating that the ROPGuard project was created on August 26, 2012 but that “ROPGuard has moved to GitHub,” although the exhibit does not indicate when the project moved from Google Code to GitHub. Exhibits 1041 and 1042 are printouts from Twitter that, according to Petitioner, show that an individual named Gursev Kalra reposted Mr. Fratric’s August 26, 2012 Tweet that same day. *See* Pet. 14–15.

Petitioner argues that “good cause may exist . . . where new evidence comes to light after a Petition is filed or is highly relevant to the argument before the Board.” Request 10 (citing cases). We generally agree that is the standard, *see Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, IPR2018-00816, Paper 19 at 4 (PTAB Jan. 8, 2019), but find that Petitioner has not shown good cause to admit Exhibits 1032–1042.

First, although Petitioner argues that it did not “obtain this new evidence” “until two weeks after the [institution decision],” and that it “could not have been provided sooner,” all but Exhibit 1036 reflect information that was available on the Internet at the time the Petition was filed, and easily located using a common search engine. A Google search for “Ivan Fratric,” for example, quickly yields both his Twitter (now called “X”) profile and blog, searching Twitter/X for “ROPGuard” reveals the August 26, 2012 Tweet, and a Google search for “ROPGuard” produces links to the GitHub and Google Code entries for the project, as well as to the blog post. *See* Ex. 3001. Because the content of these exhibits appears to

have been readily available and Petitioner does not explain why it could not have been located earlier, we cannot agree that this material is “new evidence” that was not available to Petitioner at the time it filed the Petition.

Second, we find that this information is not “highly relevant” to Petitioner’s arguments, because it actually shows that Fratric was *not* publicly available on GitHub in 2012, as argued in the Petition, but instead was published to Google Code on August 12, 2012: “ROPGuard . . . is now available on Google Code, code.google.com/ropguard.” Ex. 1037; *see* Ex. 3001. This new evidence is thus *inconsistent* with the theory of public accessibility presented in the Petition.

Third, even if we were inclined to consider whether publication to Google Code, instead of GitHub, might be sufficient to show public accessibility despite that theory not appearing in the Petition, there would be insufficient evidence to support such a finding. The Petition included evidence purporting to show that GitHub was known to those interested in the field, publicly accessible, and searchable (*see* Pet. 17–19), but the record includes almost no corresponding evidence, or even argument, concerning the Google Code repository.

Finally, even if we were to admit these new exhibits, Petitioner fails to explain how they might support a rehearing request in which Petitioner must show that we misapprehended or overlooked material that was previously presented. *See* 37 C.F.R. § 42.71(d). Because these exhibits were filed after the Decision issued, they cannot logically support an argument that we abused our discretion in reaching the findings and conclusions in the Decision.

Exhibit 1034

Exhibit 1034 is an audit log Petitioner obtained from GitHub on December 6, 2023, the day before the institution decision. *See* Request 12.³ Petitioner argues that “[t]he log provides details regarding the accessibility of the Fratric Whitepaper,” as it includes the entries “‘visibility’: ‘public,’” “‘access’: ‘public,’” and “‘public_repo.’” Request 12. Petitioner also argues that “[t]he log contains no indication that the visibility of the Fratric Whitepaper was ever set to anything other than ‘public.’” *Id.*

Petitioner does not explain how to read the audit log, but it appears to be a series of entries beginning with “+0000” and ending with a timestamp of either November 30, 2021 or May 3, 2015, plus a first, undated entry. Viewed in the light most favorable to Petitioner, we find that this might suggest that Fratric was publicly available on GitHub as early as May 3, 2015, but that is after the critical date. Petitioner’s assertion that the log does not show that Fratric was ever set to anything other than “public” is unpersuasive because the log entries appear to be limited to November 30, 2021 and May 3, 2015, and thus are not probative of any earlier status.

Of more interest is that three of the May 3, 2015 entries make reference to “GoogleCode Exporter,” suggesting that the Fratric repository may have been moved (i.e., exported) from Google Code to GitHub in 2015. That would explain why there are no earlier entries in the GitHub audit log, and provides further support for the idea that, contrary to the arguments made in the Petition, Fratric was not publicly available on GitHub before the critical date.

³ Petitioner does not say when the subpoena to GitHub was issued, but we assume that was after the September 11, 2023 Preliminary Response.

As with Exhibits 1032–1042, Petitioner does not establish that it could not have obtained the audit log earlier, the exhibit does not include information that might aid Petitioner’s cause, and it cannot support a conclusion that we misapprehended or overlooked anything in the Decision because it was not filed until after the Decision issued. We accordingly find no good cause for the admission of Exhibit 1034.

Exhibits 1032 and 1033

Petitioner argues that Exhibits 1032 and 1033 “provide evidentiary continuity and demonstrate that the webpage from which Exhibit 1007 originates and the Fratric Whitepaper (Ex. 1007) provide the same information.” Request 11–12. Petitioner asserts that this new evidence “is highly relevant to issues of concern to the Board and relates to the previously advanced argument that the Fratric Whitepaper was an accessible printed publication in 2012.” *Id.* at 12.

Exhibit 1032 is a copy of Fratric with a first page that appears to be a printout of the GitHub header. It is dated January 4, 2024. Exhibit 1033 is a screenshot of a browser viewing the GitHub page, including the header. It reads “12 years ago,” indicating that it also is post-critical date material. These exhibits do not address the problem, which is that Petitioner has not shown that Fratric was publicly available prior to the critical date.

Because Exhibits 1032 and 1033 do not include any information that might be material to the outcome of this case, we find that there is no good cause for their admission.

IV. CONCLUSION

For the foregoing reasons, we conclude that Petitioner has not carried its burden of showing that we abused our discretion in denying institution.

We further find that Petitioner has not shown good cause for admission of new Exhibits 1032–1042, and, therefore, order that they be expunged. *See* PTAB Consolidated Trial Practice Guide (Nov. 2019) 90 (“Absent a showing of ‘good cause’ prior to filing the request for rehearing or in the request for rehearing itself, new evidence will not be admitted.”).

V. ORDER

In consideration of the foregoing, it is ORDERED that Petitioner’s Request for Rehearing is *denied*, and that Exhibits 1032–1042 are *expunged*.

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