

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CROWDSTRIKE, INC.
Petitioner

v.

OPEN TEXT INC.
Patent Owner

Case No. IPR2023-01052
Patent No. 8,201,243

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

Exhibit 1001	U.S. Patent No. 8,201,243 (“ <i>243 Patent</i> ”)
Exhibit 1002	File History of U.S. Patent No. 8,201,243 (“ <i>243 FH</i> ”)
Exhibit 1003	Declaration of Markus Jakobsson, Ph.D. (“ <i>Dec.</i> ”)
Exhibit 1004	U.S. Patent No. 7,979,889 to Gladstone et al. (“ <i>Gladstone</i> ”)
Exhibit 1005	U.S. Patent No. 6,775,780 to Muttik (“ <i>Muttik</i> ”)
Exhibit 1006	U.S. Patent No. 7,093,292 to Pantuso (“ <i>Pantuso</i> ”)
Exhibit 1007	U.S. Patent No. 8,321,910 to English et al. (“ <i>English</i> ”)
Exhibit 1008	22-cv-00241, Dkt. 304, Plaintiffs’ Responsive Claim Construction Brief (“ <i>Responsive Markman Brief</i> ”)
Exhibit 1009	22-cv-00241, Dkt. 263, Opening Claim Construction Brief (“ <i>Opening Markman Brief</i> ”)
Exhibit 1010	Richard D. Schneeman, Device Driver Development for Microsoft Windows NT: Accessing Motion Control Hardware Using a Multimedia Framework, 1996 (“ <i>Device Drivers for Windows</i> ”)
Exhibit 1011	US Patent Appl Publ No 2007/0174911 to Kronenberg et al. (“ <i>Kronenberg</i> ”)
Exhibit 1012	U.S. Patent Appl Publ No 2006/0253584 to Dixon et al. (“ <i>Dixon</i> ”)
Exhibit 1013	U.S. Patent No. 7,434,261 to Costea et al. (“ <i>Costea</i> ”)
Exhibit 1014	U.S. Patent No. 8,117,659 to Hartrell et al. (“ <i>Hartrell</i> ”)
Exhibit 1015	Sophos Petition for Inter Partes Review of U.S. Patent No. 8,201,243 (“ <i>Sophos Petition</i> ”)

Exhibit 1016	22-cv-00241,Dkt. 252, Order Granting Fifth Amended Scheduling Order (“ <i>Amendment to Scheduling Order</i> ”)
Exhibit 1017	22-cv-00243, Dkt. 350, Order Resetting Markman Hearing (“ <i>Dkt. 350</i> ”)
Exhibit 1018	Agreement

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board’s email of November 13, 2023, Petitioner CrowdStrike, Inc. (“CrowdStrike” or “Petitioner”) and Patent Owner Open Text Inc. (“Open Text” or “Patent Owner”) (collectively, the “Parties”) have reached a resolution and jointly move to terminate the above-captioned proceeding.

I. STATEMENT OF FACTS

The Parties have reached an agreement (the “Agreement”) to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Agreement is in writing, and a true and correct copy is being filed as Confidential Exhibit 1018. The Agreement is being filed electronically with access to “Board and Parties Only.” A “*Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate, to treat the Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial

Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Parties jointly request, for the following reasons.

First, CrowdStrike and Open Text have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, CrowdStrike and Open Text have reached a resolution as to all the disputes in this proceeding and as to the ’243 patent. A true copy of the Agreement is being filed concurrently herewith. *See* Confidential Exhibit 1018. CrowdStrike and Open Text request that the Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Parties.

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further resolutions, as patent owners in similar situations would have a strong disincentive to resolve the dispute if they perceived that an *inter partes* review would continue regardless of a resolution.

III. STATUS OF LITIGATION AND PROCEEDINGS INVOLVING THE CHALLENGED PATENT

When authorizing this Motion, the Board asked the Parties to “update the Board concerning the status of any litigation or proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future.”

U.S. Patent No. 8,201,243 (“the Challenged Patent”) has been involved in the following proceedings:

- Webroot, Inc. v. AO Kaspersky Lab, 6-22-cv-00243 (WDTX), active.
- Webroot, Inc. v. CrowdStrike Holdings, 6-22-cv-00241 (WDTX), terminated.
- Webroot, Inc. v. Sophos Limited, 6-22-cv-00240 (WDTX), active.

- Webroot, Inc. v. Trend Micro, Inc., 6-22-cv-00239 (WDTX), active.
- Trend Micro, Inc. v. Open Text Inc., IPR2023-01390, pre-institution and pending.
- Sophos, Inc. v. Open Text, Inc., IPR2023-00731, institution denied.

The Parties confirm that the Agreement resolves all disputes between the Parties concerning the Challenged Patent. Accordingly, no litigation or proceedings involving the Challenged Patent and the Parties is contemplated in the foreseeable future. Other than the proceedings listed above, and without waiving any applicable privilege, Open Text is not aware of any imminent litigation involving the Challenged Patent.

IV. CONCLUSION

For the foregoing reasons, CrowdStrike and Open Text respectfully request termination of this *inter partes* review.

Date: November 20, 2023

Respectfully submitted,

ERISE IP, P.A.

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on November 20, 2023, a complete and entire copy of this Joint Motion to Terminate and Confidential Exhibit 1018 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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