UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB
Petitioner

v.

WEBROOT, INC.
Patent Owner

IPR2023-_____
U.S. Patent No. 9,578,045

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

AO Kaspersky Lab ("Petitioner" or "Kaspersky") respectfully submits this Motion for Joinder, concurrently with a Petition ("Kaspersky's Petition") for *inter partes* review of U.S. Patent No. 9,578,045 ("'045 patent").

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b), Kaspersky requests institution of an *inter partes* review and joinder with IPR2023-00124 ("CrowdStrike IPR"), which was instituted on June 15, 2023. *CrowdStrike, Inc. v. Webroot Inc.*, IPR2023-00124, Paper 11 (PTAB June 15, 2023). Kaspersky's Petition is essentially a copy of the CrowdStrike IPR. It includes the identical grounds presented in the CrowdStrike IPR and therefore would create no additional burden for the Board, the CrowdStrike Petitioners, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the '045 patent.

Kaspersky is currently being sued by Patent Owner for infringement of the '045 patent, styled *Webroot, Inc. and Open Text, Inc.* v. *AO Kaspersky Lab* (Case No. 6:22-CV-00243-ADA-DTG), in the Western District of Texas, Waco Division. Kaspersky has not previously filed any petitions before the PTAB challenging the validity of the '045 patent.

Kaspersky stipulates that if joinder is granted, it will cooperate with CrowdStrike, whether at hearings, at depositions, in filings, or otherwise, as outlined below. Joinder will not impact the trial schedule because the proceeding based on

the CrowdStrike IPR is in its early stages.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by Kaspersky's cooperative participation in the CrowdStrike IPR proceeding in the event that CrowdStrike Petitioners' participation terminates, the Board should institute IPR and grant Kaspersky's Motion for Joinder.

II. ARGUMENT

A. Legal Standard

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board may grant a motion for joining a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. Kaspersky's Motion for Joinder Is Timely

Joinder may be requested "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b). The CrowdStrike IPR was instituted on June 15, 2023. IPR2023-00124, Paper 11 (PTAB June 15, 2023). Kaspersky's current motion is timely as it is being filed within one month of the institution date.

C. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting Kaspersky's Motion for Joinder. Kaspersky's Petition is substantively identical to the petition in the CrowdStrike IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the CrowdStrike IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of Kaspersky Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '045 Patent Without Prejudice to Any Party

Kaspersky seeks to join the CrowdStrike IPR proceeding in order to ensure that an accused infringer[1] with an active interest in the proceeding remains a party to this Trial if the CrowdStrike Petitioners' participation is terminated prior to

[1] Patent Owner has accused Kaspersky of infringing the '045 patent in *Webroot, Inc. and Open Text, Inc.* v. *AO Kaspersky Lab* (Case No. 6:22-CV-00243-ADA-DTG), in the Western District of Texas, Waco Division

completion. Thus, joining Kaspersky to the CrowdStrike IPR proceeding is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the ’045 patent. *See* 37 C.F.R. § 42.1(b).

If Kaspersky is joined as a party, the validity of the grounds raised in the CrowdStrike IPR can be determined in a single proceeding. Joinder is also appropriate because CrowdStrike’s petition challenges the validity of the same claims of the ‘045 patent on identical grounds to those in the CrowdStrike IPR. There are no substantive differences between Kaspersky’s and CrowdStrike’s Petition, IPR2023-00124, Paper 1 (Nov. 30, 2022). Kaspersky also relies on substantially the same supporting evidence in its Petition as is relied on in the CrowdStrike IPR.[2]

A consolidated proceeding, including Kaspersky and the CrowdStrike Petitioners, will therefore be more efficient and less wasteful, as only a single trial

[2] The supporting expert declaration of V.S. Subrahmanian, Ph.D. submitted by Kaspersky agrees with the facts, analysis, and conclusions of the expert declaration in the CrowdStrike IPR. The declaration of V.S. Subrahmanian does not contain any new opinions not included in the CrowdStrike IPR expert declaration. See *Everlight Elecs. Co., v. Document Security Sys., Inc.*, IPR2018-01260, Paper No. 12 at 6-7 (Nov. 14, 2018) (granting motion for joinder where petitioner submitted separate but substantially identical expert declaration).

on these common grounds would be required. *See, e.g.*, *Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board"). The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining Kaspersky as a party to the CrowdStrike IPR would promote the public interest relating to the unpatentability of the '045 patent and not cause any undue prejudice to the Patent Owner or the CrowdStrike petitioners. The Patent Owner must respond to the common invalidity grounds identified in the CrowdStrike and Kaspersky Petitions regardless of joinder.

2. Kaspersky's Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the CrowdStrike Petitioner's Petition

Kaspersky's Petition challenges the validity of the '045 patent on identical grounds to those in the CrowdStrike IPR. *See* IPR2023-00124, Paper 1 (Nov. 30, 2022). Kaspersky's supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are substantially identical to those

presented in the CrowdStrike IPR. *See supra*. While Kaspersky uses its own expert declarant, the expert's declaration agrees with the facts, analysis, and conclusions of the expert declaration in the CrowdStrike IPR and does not contain any new opinions not included in the CrowdStrike IPR expert declaration. See *Everlight Elecs. Co., v. Document Security Sys., Inc.*, IPR2018-01260, Paper No. 12 at 6-7 (Nov. 14, 2018) (granting motion for joinder where petitioner submitted separate but substantially identical expert declaration). Further, unity of exhibits and exhibit numbering with the CrowdStrike IPR has been maintained. Accordingly, no new grounds are being introduced. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015) (granting motion for joinder where petitioners relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration").

Therefore, consolidation of this proceeding with CrowdStrike's via joinder of Kaspersky's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or add additional complexity to the case.

3. Joinder Will Not Affect the Schedule in the CrowdStrike IPR

Given that the Board recently instituted review of the CrowdStrike IPR, joinder of Kaspersky would not affect the schedule in any forthcoming trial. Kaspersky's participation should result in no changes to the schedule.

Kaspersky agrees to adhere to all applicable deadlines set forth in the

CrowdStrike IPR Scheduling Order. The Patent Owner's Response will not be affected because the issues in Kaspersky's Petition are identical to those in the CrowdStrike IPR petition. Patent Owner will thus not be required to provide any additional analysis or arguments.

4. Joinder Will Simplify Briefing Because Kaspersky Has Agreed to Consolidated Filings and an Understudy Role if CrowdStrike Petitioners Remain

To further prevent joinder from imposing any burden on the CrowdStrike Petitioners or Patent Owner and to further ensure that there are no changes in the potential trial schedule, Kaspersky agrees, as long as the CrowdStrike Petitioners remain a party to the CrowdStrike IPR, to take an understudy role, which will simplify briefing and discovery. In this role, Kaspersky agrees to the following conditions:

(a) Kaspersky shall not make any substantive filing and shall be bound by the filings of the CrowdStrike Petitioners, unless a filing concerns termination and settlement, or issues solely involving Kaspersky;

(b) Kaspersky shall not present any argument or make any presentation at oral hearing unless an issue solely involves Kaspersky, or when addressing Board-approved motions that do not affect the CrowdStrike Petitioners, or their respective position;

(c) Kaspersky shall not seek to cross-examine or defend the cross-

examination of any witness, unless the topic of cross-examination concerns issues solely involving Kaspersky;

(d) Kaspersky shall not seek discovery from Patent Owner on issues not solely involving Kaspersky;

(e) Kaspersky will not rely on expert testimony beyond that submitted by the CrowdStrike Petitioners unless the CrowdStrike Petitioners are terminated from the case prior to any necessary depositions. If the CrowdStrike Petitioners are not terminated from the case prior to any necessary depositions, Kaspersky agrees to rely entirely on, and be bound by, the expert declarations and depositions in the CrowdStrike IPR. Kaspersky's expert declaration of V.S. Subrahmanian is substantially identical to the Lee declaration filed by the CrowdStrike Petitioners. V.S. Subrahmanian would not be relied on if the CrowdStrike Petitioners continue to participate in the CrowdStrike IPR. *See, e.g.*, *Noven Pharm., Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB April 10, 2015). Unless and until the current petitioners in IPR2023-00124 cease to participate in the instituted CrowdStrike IPR proceeding, Kaspersky will not assume an active role.[3]

[3] For clarity, should the CrowdStrike Petitioners' participation in this IPR proceeding terminate, Kaspersky would take over primary responsibility for subsequent filings and discovery.

Accordingly, due to Kaspersky taking only an "understudy" role, Patent Owner and the CrowdStrike Petitioners will only need to respond to one principal set of papers, will not require additional time to address additional arguments, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6-7 (PTAB Oct. 5, 2015) (granting motion because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where second petitioner agreed to "understudy" role). Kaspersky will also abide by any additional conditions the Board deems appropriate for an "understudy" role.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, Kaspersky's joining of the CrowdStrike IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of Kaspersky's joinder. Thus, the Patent Owner would not need to expend any additional resources beyond those required in the current CrowdStrike IPR proceeding.

III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

Factor 1: Under *General Plastic*, Factor 1 considers "whether the same petitioner previously filed a petition directed to the same claims of the same patent." *See Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 16 (Sept. 6, 2017) (Section II.B.4.i. precedential). Here, Kaspersky has not previously filed any petition against the '045 patent.

Kaspersky and the CrowdStrike Petitioners are separate, unrelated petitioners, and are not similarly situated for purposes of Factor 1. Kaspersky was sued separately and accused of infringement based on different products from CrowdStrike. Neither Kaspersky nor the CrowdStrike Petitioners have provided any products or technology to the other leading to an allegation of infringement of the '045 Patent. This factor weighs in favor of institution and against discretionary denial.

Factors 2, 4, and 5: As to the timing examined in these factors, Kaspersky did not previously file a first petition prior to this petition, and while Kaspersky became aware of the prior art references in the CrowdStrike IPR as of mid-2022, it made no serial attack on the '045 patent and has filed this IPR within the one-month time period under 37 C.F.R. § 42.122(b). These factors thus weigh in favor of institution and against discretionary denial.

Factor 3: This Petition is Kaspersky's first petition challenging the '045 patent, and Kaspersky has not filed a second petition challenging the same patent.

This factor weighs in favor of institution and against discretionary denial.

Factors 6 and 7: These factors weigh in favor of institution, as there should be no material impact on the Board's finite resources or its ability to issue a final determination on CrowdStrike's Petition within one year.

IV. INSTITUTION IS APPROPRIATE UNDER *FINTIV*

The "*Fintiv* factors" favor institution.

Factor 1: Stay

Parallel litigation is ongoing. While no stay has been requested, CrowdStrike (one of the defendants in the pending parallel litigation) indicated in the CrowdStrike IPR petition that it will seek a stay of the consolidated litigation if institution is granted. The CrowdStrike IPR was instituted on June 15, 2023, thus favoring institution. At worst, this factor is neutral because the Board "will not attempt to predict" how the district court will proceed. *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB Jun. 16, 2020).

Factor 2: Proximity of the Court's Trial Date

The District Court's current scheduling order sets the trial date for August 19, 2024, which date is assigned to each defendant in five separate lawsuits that have been consolidated for pretrial issues. *Scheduling Order* (Ex. 1033), 8. Because the court's consolidation is limited to pretrial issues, separate trials will be required, and trial cannot proceed on August 19, 2024, for all five defendants.

The Board's FWD deadline in this case is no later than June 2024, two months **before** the currently scheduled trial date. Further, "additional supporting factors" are at play weighing towards a longer than average filing-to-trial window. First, the Kaspersky District Court litigation involves fourteen patents, including ten asserted by Patent Owner against Petitioner and four counterclaim infringement allegations brought by Petitioner. There are five additional patents asserted by Patent Owner against the other defendants. Likewise, the non-Kaspersky defendants have asserted more than twenty additional counterclaim infringement allegations against Patent Owner. To accommodate the significant number of allegations, the Court has scheduled three Markman hearings. *Id.*, 3, 5, 6. Accordingly, with multiple Markman hearings, a multitude of claims, and an inability to hold five trials at the same time, the "actual trial date" is more likely to be delayed past the scheduled August 19, 2024, trial date and after FWD here.

In sum, the Board's FWD deadline in this case falls months **before** a trial would occur based on the court's scheduling order. But the additional complicating factors at issue here suggest trial will occur even later in time than the scheduling order sets forth, weighing heavily in favor of institution.

Factor 3: Investment in Parallel Proceeding

As indicated above, the parallel proceeding is in its early stages. While the first two Markman hearings have been held, the third is not scheduled until July 25,

2023. Fact discovery is not scheduled to close until January 18, 2024. The deadline to add parties is not until October 3, 2023. Opening expert reports are not due until January 30, 2024, and expert discovery does not close until March 12, 2024. Therefore, the parties have invested minimal time in the parallel proceeding. The lack of investment weighs in favor of institution or is at least neutral.

Factor 4: Overlap

Petitioner has raised Capalik and Morris in preliminary invalidity contentions filed in the parallel litigation. However, final infringement and invalidity contentions are not due until October 17, 2023. Therefore, the extent of overlap is unknown at this time. Further, the Petitioner reserves the right to stipulate to elimination of the overlap between this proceeding and the parallel litigation should the Board allow joinder of this petition with the already instituted CrowdStrike IPR. This would mitigate the concerns over duplication. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (PTAB Dec. 1, 2020); *SandRevolution II, LLC v. Cont'l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24, at 11-12, (PTAB June 16, 2020). Further, the request for institution of the IPR involves additional claims 8-10, 12, and 15-18 that are not asserted in the parallel proceeding. Therefore, this factor weighs in favor of institution.

Factor 5: Same Party

The Parties are the same in the district court litigation. However, members of

the Board have noted *Fintiv* addresses only the scenario in which the petitioner is unrelated to a defendant in a parallel proceeding, finding this should weigh against denying institution, but that *Fintiv* "says nothing about situations in which the petitioner is the same as, or is related to, the district court defendant." *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd*., IPR2020-00122, Paper 15 at 10-11 (PTAB May 15, 2020) (APJ Crumbley, dissenting) (noting that disfavoring a "defendant in the district court" is "contrary to the goal of providing district court litigants an alternative venue to resolve questions of patentability"). Therefore, this factor weighs slightly against institution.

Factor 6: Other Circumstances

"[W]here the PTAB determines that the information presented at the institution stage presents a compelling unpatentability challenge, **that determination alone** demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*." *Hewlett Packard Enterprise Co., et al. v. Billjco LLC*, IPR2022-00420, Paper 17, at 6 (PTAB July 12, 2022) ("[c]ompelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence."). The strength of Petitioner's proposed grounds weighs strongly in favor of institution. *Id*. (refusing to deny institution under the *Fintiv* framework based solely on the strength of Petitioner's grounds).

V. CONCLUSION

For the reasons above, Kaspersky respectfully requests that its Petition for *Inter Partes* Review of the '045 Patent be instituted and that Kaspersky be joined to the CrowdStrike IPR proceeding IPR2023-00124.

Dated: July 14, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6 and 42.105, I hereby certify that I caused a true and correct copy of the foregoing Petitioner's Motion For Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and § 42.122(b) to be served on the Patent Owner's counsel of record via U.S. Priority Mail Express delivery service at the following address listed on USPTO PAIR:

Date of service July 14, 2023

Manner of service FEDERAL EXPRESS

Persons served Sprinkle IP Law Group

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