

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB,

Petitioners,

v.

OPEN TEXT INC.,

Patent Owner.

Case IPR2023-01334

Patent No. 8,418,250

PATENT OWNER'S PRELIMINARY RESPONSE

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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EXHIBIT LIST

Exhibit	Description
2001	<i>Webroot, Inc. and Open Text Inc. v. AO Kaspersky Lab</i> , Complaint for Patent Infringement, Dkt. 1 (W.D. Tex. Mar. 4, 2022)
2002	<i>Webroot, Inc. and Open Text Inc. v. AO Kaspersky Lab</i> , Waiver of Service of Summons, Dkt. 16 (W.D. Tex. May 25, 2022)
2003	Email from J. Miotke to trials@uspto.gov re Crowdstrike v. Open Text Inc. - IPR2023-00126 & IPR2023-01011 (Patent No. 10,257,224) and IPR2023-00289 & IPR2023-001334 (Patent No. 8,418,250) / Conference Call Request

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. 8,418,250 ("the '250 patent").

On July 21, 2023, the Board instituted *inter partes* review of the '250 patent in *CrowdStrike, Inc. v. Webroot Inc.*, IPR2023-00289 (PTAB Dec. 29, 2022) (the "CrowdStrike IPR"). Petitioner filed with its petition for *inter partes* review a motion to join the CrowdStrike IPR. (Paper 1; Paper 2.)

The Board should deny institution for multiple reasons: (1) the petition does not show a reasonable likelihood of success as to any challenged claim; (2) the petition is time-barred under 35 U.S.C. § 315(b); and (3) Petitioner fails to identify all real-parties-in-interest under 35 U.S.C. § 312(a). Additionally, the Board should discretionarily deny institution under 35 U.S.C. § 314(a) because Petitioner's lack of diligence and failure to adhere to its obligations in this proceeding have contributed to further delay and cost.

I. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF SUCCESS

The grounds raised by Petitioner in this proceeding are identical in substance to the grounds raised by CrowdStrike, Inc. in the CrowdStrike IPR. For the same reasons set forth in Patent Owner's Preliminary Response in the CrowdStrike IPR, Petitioner has not shown a reasonable likelihood of success as to any challenged

claim. *See CrowdStrike*, IPR2023-00289, Paper 6. Patent Owner incorporates the arguments presented therein by reference.

II. THE PETITION IS TIME-BARRED UNDER 35 U.S.C. § 315(b)

The motion for joinder should be denied as moot, and institution of *inter partes* review denied, because there will be no proceeding to be joined and, without joinder, the petition is time-barred.

“An *inter partes* review may not be instituted if the petition requesting the proceedings is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complain alleging infringement of the patent.” 35 U.S.C. § 315(b). The one-year bar period began when Patent Owner filed Petitioner’s waiver of service with the district court. *Brinkmann Corp. v. A&J Mfg., LLC*, Case No. IPR2015-00056, Paper 10 at 6-7 (PTAB Mar. 23, 2015) (citing Fed. R. Civ. P. 4(d)(4) (“these rules apply as if a summons and complaint had been served at the time of filing the waiver”).) Patent Owner filed a complaint asserting the ’250 patent against Kasperksy on March 4, 2022, and filed Petitioner’s Waiver of Service of Summons on May 25, 2022. (EX-2001; EX-2002.) Petitioner did not file its petition until August 18, 2023. (Paper 1.) Thus, Petitioner was effectively served with a complaint alleging infringement of the ’250 patent on May 25, 2022, more than one year before filing its petition on August 18, 2023.

With its petition, Petitioner filed a motion to join the CrowdStrike IPR. Paper 2. But by the time the Board issues its institution decision in the instant proceeding, the CrowdStrike IPR will likely be terminated, as Patent Owner and CrowdStrike have already resolved their disputes with respect to the '250 patent and jointly filed a motion to terminate the CrowdStrike IPR on November 20, 2023. *CrowdStrike, Inc. v. Webroot Inc.*, IPR2023-00289, Paper 21, Paper 22 (PTAB Nov. 20, 2023).

Under these circumstances, the motion for joinder should be denied or dismissed as moot “because there is no instituted *inter partes* review for Petitioner to join,” and institution must be denied because the petition “was not filed within the time limits imposed under 35 U.S.C. § 315(b).” *See, e.g., Fresenius Kabi USA, LLC v. Hospira, Inc.*, IPR2017-01055, Paper 10 at 5-7 (PTAB Sept. 6, 2017) (dismissing petitioner’s motion for joinder as moot where the proceeding to be joined had been terminated, and denying institution because petitioner was time-barred); *Amazon.com, Inc. v. Almondnet, Inc.*, IPR2023-00227, Paper 10 at 6-7 (PTAB June 5, 2023) (same, noting potential delay); *CommScope, Inc. v. TQ Delta, LLC*, IPR2022-01443, Paper 13 at 3-4 (PTAB Dec. 13, 2022) (same, noting “the Board’s policy goal of fostering settlements”). Accordingly, the petition here is time-barred, and institution of *inter partes* review is prohibited by statute. 35 U.S.C. § 315(b).

III. PETITIONER FAILS TO IDENTIFY ALL REAL PARTIES-IN-INTEREST UNDER 35 U.S.C. § 312(a)

A petition for *inter partes* review “may be considered only if...(2) the petition identifies all real parties in interest....” 35 U.S.C. § 312(a). The Board’s rules require identification of real-parties-in-interest in the parties’ mandatory notices. 37 C.F.R. § 42.8; *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 12 (Nov. 2019) (“Practice Guide”) (noting that the “core functions” of the real-party-in-interest requirement “are to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions”). Requiring petitioners to identify all real-parties-in-interest protects a patent owner from “harassment via successive petitions by the same or related parties” and prevents parties from having a “second bite at the apple.” Practice Guide at 12; *Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 at 4 (PTAB Feb. 14, 2019) (*precedential*). When there is a change of real-party-in-interest information, a party must file a revised notice within 21 days of the change. 37 C.F.R. § 42.8(a)(3).

Here, Kaspersky Labs Limited and Kaspersky Lab Switzerland GmbH (the “Corporate Relatives”) are Petitioner’s co-defendants in parallel district court litigation in the Western District of Texas. *See Webroot et al. v. AO Kaspersky et al.*, No. 6:22-cv-00243-ADA-DTG. Both are corporate relatives of Petitioner, and both are

represented by the same counsel (DeWitt LLP) in the district court litigation. Thus, it appears that Petitioner's Corporate Relatives are in privity with Petitioner and also real-parties-in-interest in this proceeding. To date, Petitioner has failed to update its mandatory notices to identify its Corporate Relatives as real-parties-in-interest.

IV. THE BOARD SHOULD DISCRETIONARILY DENY THE PETITION UNDER 35 U.S.C. § 314(a)

For the same reasons set forth in Patent Owner's Preliminary Response in the CrowdStrike IPR, the Board should discretionarily deny the petition under 35 U.S.C. § 314(a). *See CrowdStrike*, IPR2023-00289, Paper 6 at 4-21. Patent Owner incorporates the arguments presented therein by reference.

In addition, institution of the petition and joinder of Petitioner to the settled and to-be-terminated CrowdStrike IPR would result in further delay and inefficiencies. Petitioner failed to comply with the Board's requirement that "[a] party who files a motion for joinder should arrange a conference call with the panel, petitioner, and patent owner of the first proceeding within five business days of filing the motion." Practice Guide at 76. Under this guidance, Petitioner was obligated to reach out to the Board and Patent Owner by August 25, 2023. Petitioner did not do so until three months later, on November 21, 2023, after CrowdStrike and Patent Owner had already moved to terminate the CrowdStrike IPR. (EX-2003.)

Were Petitioner to be joined to the CrowdStrike IPR following Patent Owner's and CrowdStrike's settlement, the existing schedule in the CrowdStrike IPR would require adjustment, as Patent Owner's response is due only a few weeks after the filing of this preliminary response and long before the Board's expected institution decision on Kaspersky's petition.

Petitioner has made no effort at diligence and ignored its obligations in this proceeding, having made no attempt to address the schedule or burden with the Board or Patent Owner and having failed to update its mandatory notices to identify all real parties-in-interest. Accordingly, the Board should exercise its discretion to deny the petition under 35 U.S.C. § 314(a).

V. CONCLUSION

For the foregoing reasons, the Board should decline to institute *inter partes* review of the '250 patent.

Date: November 28, 2023

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER PRELIMINARY RESPONSE** specified in 37 C.F.R. § 42.24 have 1,258 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.2022.

Date: November 28, 2023

Respectfully submitted,

KING & SPALDING LLP

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Attorney for Patent Owner
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER PRELIMINARY RESPONSE** and all supporting **EXHIBITS 2001-2003** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as sent via Federal Express on November 28, 2023 and courtesy copies were also served via electronic mail, in their entireties on the following:

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Patent Owner's Preliminary Response to
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