

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. IPR2023-01334
U.S. Patent No. 8,418,250 B2

SUPPLEMENTAL MANDATORY NOTICE UNDER 37 CFR § 42.8(a)(3)

Pursuant to 37 C.F.R. § 42.8(a)(3), Petitioner AO Kaspersky Lab, (“Petitioner”) submits this Supplemental Notice relating to two new entities—Kaspersky Labs Limited and Kaspersky Lab Switzerland GmbH—that Open Text recently sued in a parallel district court action involving U.S. Patent No. 8,418,250 B2. Petitioner is uncertain whether either of the two entities is in privity with Petitioner for purposes of this *Inter Partes* Review, although it does not believe either is a real party-in-interest. Out of an abundance of caution, Petitioner files this Supplemental Notice to apprise the Board of the situation consistent with the objective of such mandatory notices to assist members of the Board in identifying potential conflicts, and to assure proper application of any applicable statutory estoppel provisions.

In parallel district court litigation in the Western District of Texas, Plaintiffs Webroot, Inc. and Open Text Inc. (“Open Text”) originally filed suit only against Petitioner AO Kaspersky Lab in March 2022. *See Webroot et al. v. AO Kaspersky et al.*, No. 6:22-cv-00243-ADA-DTG. Open Text twice amended the complaint against Petitioner AO Kaspersky Lab without adding any new parties. On September 22, 2023, Open Text once again amended its complaint, filing a Third Amended Complaint that for the first time added Kaspersky Labs Limited and Kaspersky Lab Switzerland GmbH (“KL Switzerland”) as co-defendants.

The two new defendants each contested that they were not properly served. Open Text was unable to effect service of the Third Amended Complaint on KL Switzerland, and Kaspersky Labs Limited contended that the attempt to serve it under

the Hague Convention was defective. To avoid motion practice, KL Switzerland waived service, and the two newly added defendants agreed with Open Text that their deadline to respond to the Third Amended Complaint would be November 21, 2023. On that date, KL Switzerland filed an Answer and Kaspersky Labs Limited filed a motion to dismiss for lack of personal jurisdiction.

Notification is Timely Under 37 C.F.R. § 42.8(a)(3)

As Petitioner is filing this Supplemental Notice within 21 days of the November 21, 2023, responses to Open Text's Third Amended Complaint, it has complied with 37 C.F.R. § 42.8(a)(3).

The Newly Added Parties to the Parallel District Court Litigation

Kaspersky Labs Limited is a holding company located in London. Before the Petition was filed, Kaspersky Labs Limited was the indirect parent company of Petitioner through its ownership of Kaspersky Group LLC, which at that time owned AO Kaspersky Lab. That is no longer the case. In August 2023, all shares of AO Kaspersky Lab were sold to Eugeny Kaspersky and Vadim Bogdanov. In particular, the transaction commenced on August 15, 2023, (prior to the filing of the instant Petition and Joinder Motion) and closed on August 24, 2023. Even before August 2023, however, Kaspersky Labs Limited neither appointed directors of Petitioner AO Kaspersky Lab nor involved itself in the day-to-day business operations, strategy

decisions, appointment of managers and officers, or general policies of AO Kaspersky Lab.

KL Switzerland is an operating company located in Zurich. At all relevant times, it has been a wholly owned subsidiary of Kaspersky Labs Limited. Neither Kaspersky Labs Limited nor KL Switzerland is directing the strategy of or providing funding for this *Inter Partes* Review. Because Petitioner AO Kaspersky Lab is the party that sought review of the patent—not Kaspersky Labs Limited or KL Switzerland—and because Open Text did not add either of the two new defendants as a party to the lawsuit until *after* the Petition was filed, Petitioner does not believe either of the new defendants is a real party-in-interest. Although Petitioner believes neither of the two new entities are a real party-in-interest, it recognizes that the determination is heavily fact-dependent and made by the Board on a case-by-case basis.

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"). 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).

Whether a party who is not a named participant in a proceeding nonetheless

constitutes a “real party-in-interest” or “privity” to that proceeding is a highly fact-dependent question. *See generally Taylor v. Sturgell*, 553 U.S. 880 (2008). Such questions are handled by the Office on a case-by-case basis taking into consideration how courts have viewed the terms “real party-in-interest” and “privity.” Practice Guide at 13. Generally, a “real party-in-interest” is the party that desires review of the patent. Thus, the “real party-in-interest” may be the petitioner itself, and/or it may be the party or parties at whose behest the petition has been filed. Practice Guide at 14. The privity analysis ultimately seeks to determine whether the relationship between the purported “privity” and the relevant other party is sufficiently close such that both should be bound by the trial outcome and related estoppels. Practice Guide at 13-14.

Despite Petitioner’s belief that neither Kaspersky Labs Limited nor KL Switzerland are real parties-in-interest, it has timely filed this Supplemental Notice consistent with the governing regulations out of an abundance of caution. Should the Board determine that either or both of the new defendants are real parties-in-interest or in privity with Petitioner, Petitioner readily welcomes them and anticipates that they will be bound by the trial outcome and any related estoppel.¹

¹ Should the Board determine that Kaspersky Labs Limited or KL Switzerland to be a real party-in-interest or in privity with AO Kaspersky Lab in the instant case, Petitioner AO Kaspersky Lab will file Supplemental Notices in its other pending cases, IPR2023-00895; IPR2023-01011 (joined to IPR2023-00126); IPR2023-01160; IPR2023-01199; IPR2024-00035; IPR2024-00292; and IPR2024-00297.

Date: December 11, 2023

Respectfully submitted,

DEWITT LLP

BY: /Joseph T. Miotke/

Joseph T. Miotke, Reg. No. 47,798

Eric H. Chadwick, Reg. No. 41,664

Erin Block, Reg. No. 78,154

COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE ON PATENT OWNER

UNDER 37 C.F.R. § 42.105(a)

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on December 11, 2023, the foregoing *SUPPLEMENTAL MANDATORY NOTICE UNDER 37 CFR § 42.8(a)(3)* was served via electronic filing with the Board and via Electronic Mail on the following practitioners of record for Patent Owner:

Brian Eutermoser (beutermoser@kslaw.com)
Russell E. Blythe (rblythe@kslaw.com)
Mikaela Stone (mikaela.stone@kslaw.com)

/Joseph T. Miotke/

Joseph T. Miotke, Reg. No. 47,798
Eric H. Chadwick, Reg. No. 41,664
Erin Block, Reg. No. 78,154
DeWitt LLP
901 Marquette Avenue
Suite 2100
Minneapolis, MN 55042
T: (612) 305-1400
F: (612) 305-1414
jtm@dewittllp.com;
ehc@dewittllp.com;
eblock@dewittllp.com;
docketing@dewittllp.com