UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO, INC.

Petitioner,

v.

OPEN TEXT INC.

Patent Owner.

Patent No. 11,409,869

JOINT MOTION TO TERMINATE PROCEEDINGS

Case No. IPR2023-01380

LIST OF EXHIBITS

Exhibit No.	Description of Document
1001	U.S. Patent No. 11,409,869 to Schmidtler *et al*. ('869 patent).
1002	Prosecution History of '869.
1003	Expert Declaration of Dr. Seth Nielson.
1004	Curriculum Vitae of A.L. Seth Nielson, Ph.D.
1005	Gil Tahan, *Mal-ID: Automatic Malware Detection Using Common Segment Analysis and Meta-Features*, Journal of Machine Learning 13, 949-979, (April 13, 2012).
1006	Eitan Menahem, *Improving Malware Detection by Applying MultiInducer Ensemble*, Computational Statistics & Data Analysis 53, (2009).
1007	U.S. Patent Publication No. 2009/0254992 to Schultz *et al*.
1008	Stuart Russell, *Artificial Intelligence: A Modern Approach; The Intelligent Agent Book*, 749-751, (Prentice Hall 2) (2003).
1009	Lars Buitinck, *API design for machine learning software: Experiences from the scikit-learn project*, (September 2013).
1010	Declaration of Ingrid Hsieh-Yee, Ph.D.
1011	Dr. Solomon's Anti-Virus Toolkit Reference Guide (April 1999).
1012	George Karypis, *CHAMELEON: A Hierarchical Clustering Algorithm Using Dynamic Modeling*, IEEE 32 (8), (August 1999)
1013	Yingjie Tian, *Recent Advances on Support Vector Machine Research*, Technological and Economic Development of Economy 18(1), (April 2012).
1014	Ian H. Witten, *Data Mining*, Practical Machine Learning Tools and Techniques 2, (July 2005).
1015	Craig Szydlowski, *Multithreaded Technology & Multicore Processors*, Dr. Dobb's Journal, (May 2005).
1016	Webroot, Inc. and Open Text, Inc. v. Trend Micro Inc., Case No. 6:22-cv-00243-ADA-DTG, Claim Construction Order, Dkt. 391 (W.D. Tex., July 25, 2023).

Exhibit No.	Description of Document
1017	**U.S. Patent No. 7,657,838 to Daniell *et al*.**
1018	**U.S. Patent No. 8,885,928 to Forman.**
1019	**U.S. Patent Publication 2010/0082642 to Forman.**
1020	**Confidential Agreement**

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board's email of February 16, 2024, Petitioner Trend Micro, Inc. ("Trend Micro" 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 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner submit a true and correct copy of the Agreement in its entirety, filed electronically with access to "Board and Parties Only" as Exhibit 1020. 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). There are no other collateral agreements between the Parties made in connection with, or in contemplation of, the termination sought.

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, Trend Micro 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, Trend Micro and Open Text have reached a resolution as to all the disputes in this proceeding and as to the '869 Patent. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' agreement made in connection with, or in contemplation of, the termination of the proceeding is in writing, and a true and correct copy is being filed concurrently herewith as Confidential Exhibit 1020. The

Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat this agreement as business confidential information and keep it separate from the files of this proceeding. The Parties certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

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 "provide the status of any related cases."

U.S. Patent No. 11,409,869 has been involved in the following proceedings:

- Webroot, Inc. v. Trend Micro, Inc., 6-22-cv-00239 (WDTX), terminated.
- Webroot, Inc. v. Sophos Limited, 6-22-cv-00240 (WDTX), active.

- Webroot, Inc. v. CrowdStrike Holdings, 6-22-cv-00241 (WDTX), terminated.
- Webroot, Inc. v. AO Kaspersky Lab, 6-22-cv-00243 (WDTX), active.
- Webroot, Inc. v. ForcePoint LLC, 6-22-cv-00342 (WDTX), terminated.
- Sophos, Inc. v. Open Text Inc., IPR2023-00031, institution denied.
- CrowdStrike Holdings v. Open Text Inc., IPR2023-01053, terminated.
- AO Kaspersky Lab v. Open Text Inc., IPR2023-01160, institution denied.

IV. CONCLUSION

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

Respectfully submitted,

Dated: February 19, 2024



Robert M. Hansen (Reg. No. 43,656)
Email: rhansen@marburylaw.com
Matthew J. Anderson (Reg. No. 78,257)
Email: manderson@marburylaw.com
Scott B. Amankwatia (Reg. No. 78,226)
Email: samankwatia@marburylaw.com
THE MARBURY LAW GROUP, PLLC
11800 Sunrise Valley Drive, 15th Floor
Reston, VA 20191
Attorneys for Trend Micro Inc.

/Brian Eutermoser/

Brian Eutermoser (Reg. No. 64,058)
Email: beutermoser@kslaw.com
KING & SPALDING LLP
1401 Lawrence Street, Suite 1900
Denver, CO 80202
Telephone: (720) 535-2312

Russell E. Blythe (Reg. No. 58,440)
Email: rblythe@kslaw.com
KING & SPALDING LLP
1180 Peachtree Street NE Atlanta, GA
30309 Telephone: (404) 572-4600

Mikaela Stone (Reg. No. 70,404)
Email: mikaela.stone@kslaw.com
KING & SPALDING LLP
1401 Lawrence Street, Suite 1900
Denver, CO 80202 Telephone: (720) 535-2312

Attorneys for Open Text Inc.

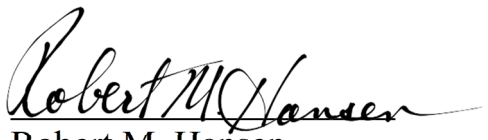
CERTIFICATE OF SERVICE

A copy of the JOINT MOTION TO TERMINATE PROCEEDINGS has been served on February 19, 2024, to Patent Owner's counsel of record as follows:

Brian Eutermoser, beutermoser@kslaw.com

Russell Blythe, rblythe@kslaw.com

Mikaela Stone, mikaela.stone@kslaw.com



Robert M. Hansen
Attorney for Petitioner

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JOINT REQUEST TO TREAT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION

Case No. IPR2023-01380

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35 U.S.C. § 317(b) provides that:

> *At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.*

Likewise, 37 C.F.R. § 42.74(c) provides that:

> *A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:*

(1) To a Government agency on written request to the Board; or

(2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

The present request, which is being filed contemparaneously with the Agreement, is timely and in accordance with the foregoing authority. The Agreement describes the confidential terms resolving the parties' dispute, which constitute confidential information under the Board's rules. *See* 37 C.F.R. § 42.54. The parties hereby certify that, to the best of their knowledge, the documents sought to be protected have not been made publicly available.

Respectfully submitted,

Dated: February 19, 2024



Robert M. Hansen (Reg. No. 43,656)
Email: rhansen@marburylaw.com
Matthew J. Anderson (Reg. No. 78,257)
Email: manderson@marburylaw.com
Scott B. Amankwatia (Reg. No. 78,226)
Email: samankwatia@marburylaw.com
THE MARBURY LAW GROUP, PLLC
11800 Sunrise Valley Drive, 15th Floor
Reston, VA 20191

Attorneys for Trend Micro Inc.

/Brian Eutermoser/

Brian Eutermoser (Reg. No. 64,058)
Email: beutermoser@kslaw.com
KING & SPALDING LLP
1401 Lawrence Street, Suite 1900
Denver, CO 80202
Telephone: (720) 535-2312

Russell E. Blythe (Reg. No. 58,440)
Email: rblythe@kslaw.com
KING & SPALDING LLP
1180 Peachtree Street NE Atlanta, GA 30309 Telephone: (404) 572-4600

Mikaela Stone (Reg. No. 70,404)
Email: mikaela.stone@kslaw.com
KING & SPALDING LLP
1401 Lawrence Street, Suite 1900
Denver, CO 80202 Telephone: (720) 535-2312

Attorneys for Open Text Inc.

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Robert M. Hansen
Attorney for Petitioner