

From: [Bob Hansen](#)
To: [Trials](#)
Cc: beutermoser@kslaw.com; mikaela.stone@kslaw.com; [Russell Blythe](#); [Scott B. Amankwatia](#); [Matthew Anderson](#)
Subject: Joint Email Regarding Petitioner's Request for Leave to File Appendices Missing from Dr. Yee's Declaration (Exhibit 1015) in IPR2023-01389
Date: Tuesday, January 23, 2024 4:47:32 PM
Attachments:

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board,

Pursuant to the Board's request, this email is submitted jointly by Petitioner, Trend Micro, Inc., and Patent Owner, Open Text Inc., to present our respective positions regarding Petitioner's request for leave to file exhibits EX1016-EX1024 (attached for information) providing the appendices missing from Dr. Yee's Declaration (Exhibit 1015) in reply to Patent Owner's Preliminary Response in IPR2023-01389.

On January 18, 2024, Petitioner submitted to Counsel for Patent Owner all documents subject to Petitioner's request. The parties conferred via a telephonic call today, January 23, 2024. Petitioner maintains its request to file exhibits providing the appendices referred to in but missing from Exhibit 1015. Patent Owner opposes Petitioner's request for leave to file the missing appendices and has further objections to the cited prior art in view of the documents involved in Petitioner's request.

Petitioner's Position (Trend Micro, Inc.):

Petitioner believes entering into the record Appendices 1006A-1006C, 1007A-1007D, A, and B cited in Exhibit 1015 is crucial to provide the Board and Patent Owner with the documentary evidence necessary to evaluate the public accessibility of the Høglund and Garfinkel prior art. Petitioner asserts that failure to include the appendices in Exhibit 1015 was an inadvertent error. Petitioner believes that if the Board grants Petitioner's request, Patent Owner would have a sufficient opportunity to challenge the evidence in the appendices in a sur-reply for consideration by the Board in deciding on institution. Further, if the Board institutes IPR, including the missing appendices in the records would provide Patent Owner with the evidence to conduct discovery and rely on in challenging the prior art in the formal Patent Owners Response. Petitioner does not object to Patent Owner's request to file a 6-page sur-reply.

Patent Owner's Position (Open Text, Inc.):

Patent Owner opposes Petitioner's request and maintains its objection to the prior art because the

IPR-2023-01389
Ex. 3001

appendices (specifically, appendices 1006A-1006C, 1007A, 1007B, and 1007D) introduce evidence not previously submitted or linked in Petitioner's original submission. Specifically, Patent Owner is prejudiced by belated submission of appendices 1007A, 1007B, and 1007D, which introduce new grounds for challenging the public accessibility of Hoglund, which could not be addressed in Patent Owner's preliminary response. Patent Owner maintains its objections to any portion of Dr. Yee's declaration that continues to rely on linked evidence not currently of record in this proceeding. Should the Board grant Petitioner's request to submit the appendices, Patent Owner requests a 6-page sur-reply to respond to the new evidence.

Conclusion:

Both parties have conferred and present their respective positions as requested. We thank the Board for its consideration of these positions and await further instructions on how to proceed.

Sincerely,

Robert M. Hansen
Counsel for Petitioner, Trend Micro, Inc.

Brian Eutermoser
Counsel for Patent Owner, Open Text, Inc.

Robert M. Hansen, Esq.

Co-Managing Partner
The Marbury Law Group, PLLC
11800 Sunrise Valley Drive, 15th Floor
Reston, VA 20191-5302
703-391-2900 Firm Telephone
571-267-7003 Direct Line
703-391-2901 Facsimile
703-909-5155 Cell
RHansen@MarburyLaw.com
www.marburylaw.com

This electronic message transmission contains information from the law firm of The Marbury Law Group, PLLC that may be confidential or privileged. The information is intended to be for the use of the individual or entity named above. If you are not the intended recipient, be aware that any disclosure, copying, distribution, or use of the contents of this information is prohibited. If you receive this electronic transmission in error, please notify us by telephone (703-391-2900) or by electronic mail (info@marburylaw.com) immediately.
