

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO, INC.,
Petitioner,

v.

OPEN TEXT INC.,
Patent Owner.

IPR2023-01389
Patent 8,856,505 B2

Before JUSTIN T. ARBES, MICHELLE N. WORMMEESTER, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call in the above proceeding was held on January 18, 2024, among respective counsel for Petitioner and Patent Owner, and Judges Arbes, Wormmeester, and Raevsky. The purpose of the call was to discuss an issue pertaining to the declaration of Ingrid Hsieh-Yee, Ph.D. (Ex. 1015), which addresses the alleged authenticity and public accessibility of two references asserted in this proceeding, Garfinkel (Ex. 1006) and Hoglund (Ex. 1007), and which cites Appendices A, B, 1006A–1006C, and 1007A–1007D. Prior to the call, Petitioner sent an email to the Board

explaining that it did not include the appendices with the declaration due to an inadvertent oversight when filing the Petition. Petitioner's email requested authorization to file four of the appendices (Appendices B and 1006A–1006C) and a three-page reply responding to Patent Owner's arguments regarding public accessibility of Garfinkel in the Preliminary Response. *See* Paper 6, 34–42.

Petitioner argued during the call that all of the omitted appendices should be filed to ensure a complete record with respect to Dr. Hsieh-Yee's testimony. Patent Owner responded that it did not oppose Petitioner's request provided Patent Owner would be permitted to file a sur-reply of equal length. It became apparent during the call, however, that the other five appendices not addressed by Petitioner's email (Appendices A and 1007A–D) had never been served on Patent Owner and, therefore, Patent Owner had no opportunity to address the substance of those documents in its Preliminary Response. We ordered Petitioner to provide copies of the appendices to Patent Owner and ordered the parties to meet and confer with each other and notify the Board of what relief they are requesting.

The parties responded by email on January 23, 2024. Ex. 3001. Petitioner "maintains its request to file exhibits providing the appendices referred to in but missing from Exhibit 1015." *Id.* Petitioner states that filing all nine appendices "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," "failure to include the appendices in Exhibit 1015 was an inadvertent error," and "Petitioner does not object to Patent Owner's request to file a 6-page sur-reply." *Id.* Patent Owner "opposes Petitioner's request and maintains its objection to the prior art because the appendices . . . introduce evidence not previously submitted or

linked in Petitioner’s original submission.” *Id.* Patent Owner states that it “is prejudiced by belated submission of appendices 1007A, 1007B, and 1007D, which introduce new grounds for challenging the public accessibility of Høglund, which could not be addressed in Patent Owner’s preliminary response,” and “requests a 6-page sur-reply to respond to the new evidence.” *Id.*

We accept Petitioner’s representation that the omission of Appendices A, B, 1006A–1006C, and 1007A–1007D to the declaration was inadvertent, and are persuaded that good cause exists to file them late. *See* 37 C.F.R. § 42.5(c)(3). Filing the appendices also will enable the Board to fully evaluate Dr. Hsieh-Yee’s testimony and the supporting evidence upon which she relies. Petitioner shall file a substitute copy of Exhibit 1015 including the appendices and adding a label page for each document. In future filings, however, the parties should file documents as separately numbered exhibits, rather than as attachments to another exhibit. *See* 37 C.F.R. § 42.63.

We further agree with Patent Owner that it should be permitted additional briefing, given that it did not have copies of the appendices at the time it filed its Preliminary Response. Petitioner does not object to Patent Owner’s request for authorization to file a brief of six pages. Ex. 3001. We do not authorize any additional briefing from Petitioner. Petitioner did not request authorization to file a reply in its email and, regardless, has not established good cause to file a reply responding to Patent Owner’s arguments concerning public accessibility. *See id.*; 37 C.F.R. § 42.108(c).

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner shall file, by January 30, 2024, a substitute copy of Exhibit 1015 including Appendices A, B, 1006A–1006C, and 1007A–1007D, with a label page preceding each appendix and making

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no other changes, after which the originally filed version of Exhibit 1015 will be expunged; and

FURTHER ORDERED that Patent Owner is authorized to file a supplemental brief addressing Dr. Hsieh-Yee's testimony and the supporting appendices, limited to six pages, by February 5, 2024.

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