

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. 8,181,244

JOINT MOTION TO TERMINATE PROCEEDINGS

Case No. IPR2023-01392

LIST OF EXHIBITS

Exhibit No.	Description of Document
1001	U.S. Patent No. 8,181,244 to Boney. (“’244”)
1002	Prosecution History of ’244.
1003	Expert Declaration of Dr. Seth Nielson.
1004	Curriculum Vitae of Dr. Seth Nielson.
1005	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).
1006	Kevin Chen, <i>ECF – Event Correlation for Forensics</i>, Australian Computer, Network & Information Forensics Conference (2003).
1007	U.S. Patent Publication No. 2007/0006310 to Piccard.
1008	Zhenmin Li, <i>UCLog: A Unified, Correlated Logging Architecture for Intrusion Detection</i>, Int’l Conf. on Telecomm. Sys.- Modelling & Analysis (2004).
1009	Declaration of Ingrid Hsieh-Yee, Ph.D.
1010	Peter G. Viscarola, <i>Windows NT Device Driver Development</i>, ORS Open Systems Resources, Inc., (1999).
1011	Nicholas Weaver, <i>Worms vs. Perimeters: The Case or Hard-LANS</i>, 12th Annual IEEE Symposium (Aug. 2004).
1012	Weidong Cui, <i>Design and Implementation of an Extrusion-based Break-In Detector for Personal Computers</i> (2006).
1013	Cristina Abad, <i>Log Correlation for Intrusion Detection: A Proof of Concept</i>, 19th Annual Computer Security Applications Conference (2003).
1014	Robert Rinnan, <i>Benefits of Centralized Log File Correlation</i>, Gjøvik University College (2005).

1015	Ed Skoudis, <i>Malware: Fighting Malicious Code</i> , Pearson (Nov. 2003).
1016	Platform SDK: Windows Management Instrumentation, <i>Win32_Process</i> , Win32_Process class [WMI] (archive.org) (Jul. 17, 2004).
1017	Matthew M. Lavy, <i>Windows Management Instrumentation (WMI)</i> , Sams (Oct. 2001).
1018	Yariv Kaplan, <i>API Spying Techniques for Windows 9x, NT and 2000</i> , API Spying Techniques for Windows 9x, NT and 2000 (archive.org) (Feb. 10, 2003).
1019	Stephanie Forrest, <i>Computer Immunology</i> , Communications of the ACM 40(1), (Oct. 1997).
1020	'244 IPR Petition Redline
1021	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 '244 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. 8,181,244 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.
- CrowdStrike Holdings v. Open Text Inc., IPR2023-01158, terminated.

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



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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

A handwritten signature in black ink that reads "Robert M. Hansen". The signature is written in a cursive style with a large, stylized 'R' and 'H'.

Robert M. Hansen
Attorney for Petitioner