

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. 8,726,389

JOINT MOTION TO TERMINATE PROCEEDINGS

Case No. IPR2023-01459

LIST OF EXHIBITS

Exhibit No.	Description of Document
1001	U.S. Patent No. 8,726,389 to Morris et al. (“’389 Patent”)
1002	File History of U.S. Patent No. 8,726,389 (“’389 File History”)
1003	Declaration of Dr. Wenke Lee (“Decl.”)
1004	U.S. Patent Application Publication No. 2005/0210035 A1 to Kester et al. (“Kester”)
1005	U.S. Patent No. 7,594,272 to Kennedy et al. (“Kennedy”)
1006	U.S. Patent No. 7,225,343 to Honig et al. (“Honig”)
1007	<i>PO Opposition Markman Brief, 22-cv-00243 WDTX, No. 98</i>
1008	<i>Defendants’ Markman Brief, 22-cv-00243 WDTX, No. 86</i>
1009	Order Granting Fourth Amended Scheduling Order, 22-cv-00243 WDTX, No. 160 (“<i>Fourth Amended Scheduling Order</i>”)
1010	SANS Institute (2000-2005) <i>Host- vs. Network-Based Intrusion Detection Systems</i>
1011	Intrusion Detection with Unlabeled Data Using Clustering by Leonid Portnoy, et al. (“<i>Portnoy</i>”)
1012	U.S. Patent No. 6,944,772 to Dozortsev (“<i>Dozortsev</i>”)
1013	U.S. Patent No. 6,772,346 to Chess et al. (“<i>Chess</i>”)
1014	WO 2002/033525 to Shyne-Song Chuang (“<i>Chuang</i>”)
1015	EP 1,549,012 to Kristof De Spiegeleer (“<i>De Spiegeleer</i>”)
1016	EP 1,280,040 to Alexander James Hinchliffe, et al. (“<i>Hinchliffe</i>”)
1017	U.S. Patent No. 7,089,428 to Farley et al. (“<i>Farley</i>”)
1018	U.S. Patent Publication No. 2004/0153644 to McCorkendale (“<i>McCorkendale</i>”)
1019	The NIDES Statistical Component: Description and Justification by Harold S. Javitz et al.
1020	U.S. Patent No. 7,516,476 to Kraemer et al. (“<i>Kraemer</i>”)

Exhibit No.	Description of Document
1021	U.S. Patent No. 8,418,250 to Morris et al. (“’250 Patent”)
1022	U.S. Patent No. 10,284,591 to Giuliani et al. (“’591 Patent”)
1023	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 1023. 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 ’389 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 1023. 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. 8,726,389 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., IPR2023-00633, institution denied.
- CrowdStrike Holdings v. Open Text Inc., IPR2023-00556, instituted (motion for termination pending).
- AO Kaspersky Lab v. Open Text Inc., IPR2024-00035, instituted (joined with IPR2023-00556).

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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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, reading "Robert M. Hansen", with a horizontal line drawn underneath the signature.

Robert M. Hansen
Attorney for Petitioner