

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB,
Petitioner,

v.

OPEN TEXT INC.,
Patent Owner.

IPR2024-00035
Patent 8,726,389 B2

Before BARBARA A. PARVIS, GARTH D. BAER, and AARON W.
MOORE, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

AO Kaspersky Lab (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–30 (the “challenged claims”) of U.S. Patent No. 8,726,389 B2 (Ex. 1001, “the ’389 patent”).

Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as a party to *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00556 (PTAB) (“CrowdStrike IPR”). Paper 2 (“Mot.”). Open Text Inc. (“Patent Owner”) did not file a Preliminary Response or an Opposition to Petitioner’s Motion for Joinder.

We have authority under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons described below, we institute *inter partes* review of all the challenged claims, and grant Petitioner’s Motion for Joinder.

B. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability. Pet. 6.

Claims Challenged	35 U.S.C. §	References/Basis
1–13, 15–27, 29, 30	103(a) ¹	Kester ² , Kennedy ³

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. § 103 that became effective after the filing of the application that led to the challenged patent.

Therefore, we apply the pre-AIA version of 35 U.S.C. § 103.

² US 2005/0210035 A1, Pub. Sept. 22, 2005 (Ex. 1004).

³ US 7,594,272 B1, Sept. 22, 2009 (Ex. 1005).

Claims Challenged	35 U.S.C. §	References/Basis
14, 28	103(a)	Kester, Kennedy, Honig ⁴

II. DISCUSSION

A. Institution of Inter Partes Review

Petitioner represents that the Petition includes “identical grounds” and “is essentially a copy” of the CrowdStrike IPR. Mot. 1. Further, Petitioner “relies on the same supporting evidence in its Petition as is relied on in the CrowdStrike IPR.” *Id.* at 4. At this stage of the proceeding and based on our preliminary review, we find Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of the challenged claims for the same reasons discussed in our Decision on Institution in the CrowdStrike IPR. *See* CrowdStrike IPR, Paper 9, 18–24. Accordingly, we grant the Petition, and institute *inter partes* review of the challenged claims.

B. Motion for Joinder

Joinder in *inter partes* reviews is governed by 35 U.S.C. § 315(c), which reads:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the

⁴ US 7,225,343 B1, May 29, 2007 (Ex. 1006).

existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We instituted the CrowdStrike IPR on September 12, 2023. *See* CrowdStrike IPR, Paper 9. Petitioner filed this Petition and Motion for Joinder on October 10, 2023, which is within one month of the institution date of the CrowdStrike IPR. *See* Paper 1; Mot. Thus, Petitioner timely filed its Motion for Joinder. *See* 37 C.F.R. § 42.122(b). As noted above, Petitioner represents that its Petition is substantively the same as the petition in the CrowdStrike IPR and relies on the same supporting evidence. Mot. 4. Petitioner further represents that joinder will not materially impact the CrowdStrike IPR's schedule. *Id.* at 7. We are persuaded by Petitioner's arguments. Because the Petition challenges the same claims on the same grounds using the same prior art, *Kyocera* factor (2) favors joinder. *See Kyocera*, IPR2013-00004, Paper 15 at 4. Indeed, the Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Company*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016). Moreover, because the issues to be decided are the same, *Kyocera* factors (3) and (4) also favor joinder. Thus, we find that joining Petitioner to the CrowdStrike IPR is appropriate under the present circumstances. We, therefore, *grant* Petitioner's Motion for Joinder.

III. CONCLUSION

For the foregoing reasons, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it will succeed in showing claims 1–30 are unpatentable under 35 U.S.C. § 103. At this preliminary stage, we

have not made a final determination with respect to the patentability of the challenged claims or any underlying factual and legal issues.

Given that Petitioner is being joined as a party to the CrowdStrike IPR, Petitioner is bound by the ultimate determination made in the CrowdStrike IPR. *See* 35 U.S.C. §§ 315(e)(1), 325(d); 37 C.F.R. § 42.73(d)(1). Accordingly, Petitioner shall not advance any arguments regarding these claims in this proceeding; all grounds raised by Petitioner regarding these claims will be addressed in the CrowdStrike IPR.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review is instituted in IPR2024-00035;

FURTHER ORDERED that the Motion for Joinder with IPR2023-00556 is *granted*, and Petitioner is joined as a petitioner in IPR2023-00556;

FURTHER ORDERED that all future filings shall be made in IPR2023-00556;

FURTHER ORDERED that Petitioner shall file each paper due in IPR2023-00556 as a consolidated filing with the petitioner in the CrowdStrike IPR, except for a paper that does not involve the petitioner in the CrowdStrike IPR;

FURTHER ORDERED that, for each paper due in IPR2023-00556, Petitioner may not file any paper in addition to the consolidated paper filed in the CrowdStrike IPR absent prior authorization from the Board;

FURTHER ORDERED that Petitioner and the petitioner in the CrowdStrike IPR shall collectively designate attorneys to conduct the cross-examination of any witness produced by Patent Owner and the redirect of

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any witness produced by the petitioner in the CrowdStrike IPR, within the timeframes set forth in 37 C.F.R. § 42.53(c) or agreed to by the parties;

FURTHER ORDERED that Petitioner and the petitioner in the CrowdStrike IPR shall collectively designate attorneys to present at the oral hearing, if requested and scheduled, in a consolidated argument;

FURTHER ORDERED that the case caption in IPR2023-00556 shall be changed to reflect joinder of AO Kaspersky Lab as a petitioner in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2023-00556.

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Example Case Caption for Joined Proceeding

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CROWDSTRIKE, INC., TREND MICRO, INC., and
AO KASPERSKY LAB
Petitioners,

v.

OPEN TEXT INC.,
Patent Owner.

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⁵ Trend Micro, Inc., who filed a petition in IPR2023-01459 has been joined as a petitioner in this proceeding. AO Kaspersky Lab, who filed a petition in IPR2024-00035 has also been joined as a petitioner in this proceeding.