

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO, INC.

Petitioners,

v.

OPEN TEXT INC.,

Patent Owner.

Case IPR2024-00106

Patent No. 8,418,250

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION FOR JOINDER**

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EXHIBIT LIST

Exhibit	Description
2001	<i>Webroot, Inc. and Open Text, Inc. 's v. Trend Micro Inc.</i> , Case No. 6:22-cv-0239-ADA-DTG, Defendants' Preliminary Invalidity Contentions, dated Sept. 13, 2022 (W.D. Tex)
2002	<i>Webroot, Inc. and Open Text, Inc. 's v. Trend Micro Inc.</i> , Case No. 6:22-cv-0239-ADA-DTG, Defendants' Final Invalidity Contentions, dated Nov. 1, 2023 (W.D. Tex)
2003	<i>Webroot, Inc. and Open Text, Inc. 's v. Trend Micro Inc.</i> , Case No. 6:22-cv-0239-ADA-DTG, Order to Amend the Scheduling Order, Dkt. 521, dated Dec. 7, 2023 (W.D. Tex)

Open Text Inc. ("Patent Owner") submits this opposition to the motion submitted by Trend Micro, Inc. ("Petitioner") seeking to join IPR2024-00106 regarding U.S. Patent No. 8,418,250 ("the '250 patent") with IPR2023-00699 filed by Sophos Ltd. and Sophos Inc. ("Sophos") (the "Sophos Petition").

I. STATEMENT OF PRECISE RELIEF REQUESTED

The instant IPR petition and the concurrently filed motion for joinder is the second attempt by Petitioner to institute an IPR on the same patent. Under the factors set forth in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 9-10, (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i), the Board should deny the petition and the motion for joinder.

II. BACKGROUND AND RELATED PROCEEDINGS

A. District Court Litigation

Concurrent district court litigation between Patent Owner, Petitioner, and two additional co-defendants of Petitioner is pending in a consolidated case in the United States District Court for the Western District of Texas. *Webroot, Inc. and Open Text, Inc. v. AO Kaspersky Lab*, Case No. 6:22-cv-00243 (W.D. Tex.). The district court litigation has progressed significantly. The Court has held three claim construction hearings and entered nine claim construction orders. Dkt. Nos. 235, 236, 293, 295, 296, 297, 391, 392, and 393. Petitioner served Defendants' Preliminary Invalidity

Contentions on September 13, 2022, (Ex. 2001), and served its Final Invalidity Contentions on November 1, 2023 (Ex. 2002). Trial is set to start on November 12, 2024. Dkt. No. 521 (W.D. Tex.) (Ex. 2003).

B. Petitioner's First and Second IPRs

In its first petition, Petitioner challenged claims 1-30 of the '250 patent on the grounds below. *See Trend Micro, Inc. v. Open Text, Inc.*, IPR2023-00655 ("First IPR"), Paper 2 at 20 (PTAB Mar. 2, 2023).

<u>Ground</u>	<u>Claims</u>	<u>Prior Art</u>
1	1-5, 12-17, 24	Halperin ¹ and Mankins ²
2	6 and 18	Halperin, Mankins, and Arnold ³
3	7-11, 19-23, and 25-30	Halperin, Mankins, Kirby ⁴ , and Carpentier ⁵
4	1-5, 12-17, and 24	Halperin and Inoue ⁶

¹ U.S. Published Patent Application No. 2004/0111632A1 ("Halperin").

² U.S. Patent No. 7,900,194 ("Mankins").

³ U.S. Patent No. 5,440,723 ("Arnold").

⁴ U.S. Patent 7,694,150 ("Kirby").

⁵ U.S. Patent Publication 2004/0068652 ("Carpentier").

⁶ Inoue et al., Anomaly Intrusion Detection in Dynamic Execution Environments, New Security Paradigms Workshop '02, September 23-26, 2002 ("Inoue").

In its petition in this IPR (“Second IPR”), Petitioner again challenges claims 1-30 of the ’250 patent and relies on a subset of the same references in its First IPR. IPR2024-00106, paper 2.

<u>Ground</u>	<u>Claims</u>	<u>Prior Art</u>
1	1, 2, 12-14, 24	Halperin and Mankins
2	1-30	Halperin, Mankins, and Kirby

Patent Owner filed its preliminary response in the First IPR on July 17, 2023. IPR2023-00655, Paper 6. On October 11, 2023, the Board denied institution of the First IPR. IPR2023-00655, Paper 7. On November 8, 2023—nearly a month after the Board’s institution decision in the First IPR—Petitioner filed its petition in this IPR, *i.e.*, its Second IPR, and a motion to join the Sophos Petition.

III. ARGUMENT

Petitioner addresses the *General Plastic* factors only briefly, arguing in effect that *General Plastic* does not bar its Second IPR because its Second IPR is a “substantial copy” of another petitioner’s petition and “involves different grounds and arguments” than its First IPR. Paper 3 at 8. Contrary to Petitioner’s argument, the Board has repeatedly denied institution and joinder under *General Plastic* in nearly identical circumstances to those at issue here. As discussed below, the Board should likewise deny institution and joinder in this case.

A. The Board has repeatedly denied institution and joinder of serial copycat petitions under *General Plastic*.

In *General Plastic*, the petitioner had filed a first set of petitions seeking *inter partes* review of two patents. *General Plastic*, IPR2016-01357, Paper 19 at 16 at 2-3. For each petition, the Board denied institution on the merits. *Id.* Nine months after the filing of the first set of petitions, the petitioner filed follow-on petitions against the same patents. *Id.* For each of those follow-on petitions, the Board exercised its discretion not to institute trial pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a). *Id.*

The same considerations underlying the Board's decision to deny institution in *General Plastic* are applicable in the context of joinder. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential). The petitioner in *Apple*, similar to Petitioner here, argued that it would have an "understudy role." *Id.* at 4. The Board was not persuaded by this argument because the copycat petition was still the petitioner's second challenge to the same patent, and "should [the first petitioner] settle, [the copycat petitioner] would stand in to continue a proceeding that would otherwise be terminated." *Id.* In effect, it would be as if the petitioner had brought the second challenge to the patent in the first instance. As the Board explained, "[t]his is the kind of serial attack that *General Plastic* was intended to address." *Id.* (quoting *General Plastic*, IPR2016-01357,

Paper 19 at 17) (“Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”).

Apple sets forth several factors for the Board to consider when determining whether to exercise its discretion to deny institution:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Id. at 9–10. Based on its evaluation of these factors, the Board in *Apple* denied institution and joinder of the second, copycat petition.

In *T-Mobile v VoIP-Pal.com*, faced with similar facts to those at issue here, the Board likewise denied institution and joinder based on the *General Plastic* factors. The petitioner in that case, T-Mobile, had filed four IPR petitions on June 27, 2022, and its co-defendant, Meta, had filed four IPR petitions on June 30, 2022. *T-Mobile v VoIP-Pal.com*, IPR2023-00641, Paper 11 at 6 (PTAB July 28, 2023) (“*T-Mobile*”) (citing *Apple*).) T-Mobile’s petitions were all substantively reviewed and denied on December 22, 2022, while Meta’s were instituted on January 31, 2023 (*Meta Platforms, Inc. v. VoIP-Pal, Inc.*, IPR2022-01234 and IPR2022-01235 (PTAB Jan. 31, 2023)). *T-Mobile*, IPR2023-00641, Paper 11 at 8. On February 28, 2023, T-Mobile filed four more petitions on the same claims, citing prior art that had been disclosed on January 25, 2022, and concurrently moved to join Meta’s instituted petitions. *T-Mobile*, IPR2023-00641, Paper 3 at 2. The Board applied the *General Plastic* factors and denied institution of all four petitions and denied the motion for joinder. In its analysis, the Board expressly rejected the “understudy” argument, finding that the effect of permitting the joinder would allow T-Mobile to “stand in to continue proceedings that would otherwise be terminated” if Meta were to settle. *Id.* at 4. The Board adopted the reasoning from *Apple* that the *General Plastic* factors “are to be considered in relation to motions for joinder when considering discretionary denial,” and denied institution and the motion for joinder. *Id.* at 5.

B. The Board should deny institution and joinder of Petitioner's copycat petition.

As discussed in more detail below, the *General Plastic* factors weigh against institution and joinder here, just as they did in *T-Mobile*.

1. Petitioner previously filed a petition directed to the same claims of the same patent.

There is no dispute that Petitioner has filed two petitions against the '250 patent and that all claims challenged in the second petition were challenged in the first petition. The Board denied institution in the First IPR because Petitioner failed to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims. This factor weighs in favor of denying institution.

2. When Petitioner filed the first petition, Petitioner knew or should have known of the prior art asserted in the second petition.

The three references asserted in the second petition (Halperin, Mankins, and Kirby) were asserted in the first petition. Petitioner knew of the prior art asserted in the second petition because it asserted that same art in the first petition on March 2, 2023 (IPR2023-00655, Paper 2) and in its September 13, 2022 Preliminary Invalidity Contentions (Ex. 2001). Because Petitioner knew of the art asserted in the second petition at the time of filing the first petition and had known it for at least six months, this factor weighs in favor of denying institution.

3. When Petitioner filed the second petition, Petitioner had already received Patent Owner's preliminary response to the first petition and the Board's decision denying institution.

As discussed above, by the time Petitioner filed the second petition and motion for joinder, Patent Owner had already filed its preliminary response to the first petition on July 17, 2023. IPR2023-00655, Paper 6. And on October 11, 2023, the Board denied institution in the First IPR because Petitioner failed to demonstrate a reasonable likelihood of prevailing with respect to any challenged claim. IPR2023-00655, Paper 7. In other words, Petitioner filed a prior petition and then received Patent Owner's preliminary response and the Board's decision before filing a second petition and joinder motion. This is the exact fact pattern *General Plastic* seeks to avoid, and this factor therefore weighs in favor of denying institution and joinder.

4. Petitioner waited more than a year after learning of the asserted prior before filing its second petition.

As discussed above, more than a year—from September 13, 2022, until November 8, 2023—had passed from the time Petitioner learned of the prior art and the time it filed the instant petition. Given that Petitioner's district court Preliminary Invalidity Contentions were served on Patent Owner on September 13, 2022, and cite Halperin, Mankins, and Kirby (Ex. 2001), Petitioner knew about those references even before the date of service. Yet, Petitioner waited until November 8,

2023, to file its second petition. Petitioner offers no explanation for this delay. This factor therefore weighs in favor of denying institution and joinder.

5. Petitioner provides no explanation for the time elapsed between the filings of its multiple petitions.

The issue to be addressed in factor 5 is why Petitioner delayed “between the filings of multiple petitions directed to the same claims of the same patent.” *General Plastic* at 9-10. The first petition—relying on the same primary references—was filed in March 2023. Nearly eight months passed between the filing of the initial petition and the filing of the second petition. Petitioner failed to provide any explanation at all for the time elapsed between these two filings. *See* Paper 3. Accordingly, this factor weighs in favor of denying institution and joinder.

6. The finite resources of the Board favor denial.

Petitioner had its chance to file IPRs citing the prior art it knew about in September 2022. It chose not to. The finite resources of the Board should not be used for a Petitioner who filed an IPR knowing it had previously failed to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims on the same grounds.

The Board has explained that “[i]n general, having multiple petitions challenging the same patent, especially when not filed at or around the same time ... is inefficient and tends to waste resources.” *Valve Corp. v. Elec. Scripting Prods.*,

Inc., IPR2019-00062, Paper 11, 15 (PTAB Apr. 2, 2019) (precedential). As in *Valve*, Petitioner has filed serial and repetitive attacks against the same patent relying on the same prior art. “These serial and repetitive attacks implicate the efficiency concerns underpinning *General Plastic* and, thus, favor denying institution.” *Id.*

Petitioner tries to justify its expenditure of Board resources in connection with these petitions by attaching itself to Sophos, noting the “current Petition is a substantial copy of the Sophos Petition.” Paper 3 at 8. But this argument assumes that Sophos will handle the Sophos Petition until it is complete. If Sophos were to settle before then, however, then the Board’s resources will be impacted because Petitioner will have the opportunity to continue the Sophos Petition even though the Sophos Petition should be terminated at that point. Petitioner has already made use of Board resources in connection with the First IPR. This factor weighs in favor of denying institution and joinder.

7. The one-year final determination deadline does not support institution and joinder.

Like the sixth *General Plastic* factor, the seventh factor, “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review,” implicates an efficiency consideration. This factor is neutral because while resolution should be quick and simple as the first petition was based on similar grounds and was denied institution,

it is still an inefficient use of the Board's time to review multiple petitions and motions based on the same grounds and asserted against the same patents, and to draft decisions on the same issues multiple times within a year.

IV. CONCLUSION

A holistic review of the *General Plastic* factors results in six of the seven factors weighing in favor of denying institution of these proceedings. Patent Owner respectfully requests that the Board deny Petitioner's Motion for Joinder.

Date: December 8, 2023

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER** specified in 37 C.F.R. § 42.24 have 2,316 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word 365 v.2022.

Date: December 8, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER** and all supporting **EXHIBITS 2001-2003** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as sent via electronic mail on December 8, 2023, in their entireties on the following:

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