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. 8,418,250

JOINT MOTION TO TERMINATE PROCEEDINGS

Case No. IPR2024-00106

LIST OF EXHIBITS

Exhibit No.	Description of Document
1001	U.S. Patent No. 8,418,250 ("the '250 Patent")
1002	File History for U.S. Patent No. 8,418,250
1003	Complaint, *Webroot Inc, et al. v. Sophos Ltd.*, No. 6:22-cv-240 (W.D. Tex.)
1004	Declaration of Dr. Richard Newman
1005	Curriculum Vitae of Dr. Richard Newman
1006	U.S. Patent Appl. Pub. No. 2004/0111632 to Halperin ("Halperin")
1007	U.S. Patent No. 7,694,150 to Kirby ("Kirby")
1008	U.S. Patent No. 7,900,194 to Mankins ("Mankins")
1009	Stipulation Waiving IPR Claims in District Court Litigation
1010	S. Forrest *et al.*, *Computer Immunology*, Comms. of the ACM, Vol. 40, No. 10, 88–96 (1997)
1011	A. Snoeren *et al.*, *Single-Packet IP Traceback*, IEEE/ACM Trans. on Networking (TON), Vol. 10, No. 6, 721–34 (2002)
1012	S. Hofmeyr, *Intrusion Detection Using Sequences of System Calls*, J. Computer Security, Vol. 6, Issue 3, 151–180 (Aug. 1998)
1013	S. Forrest *et al.*, *A Sense of Self for Unix Processes*, Proc. 1996 IEEE Symp. on Security and Privacy, 120–28 (1996)
1014	Order Granting Fourth Amended Scheduling Order, Dkt. 160, *Webroot, Inc., et al. v. AO Kaspersky Lab*, No. 6:22-cv-00243-ADA-DTG (W.D. Tex.) (Jan. 22, 2023)
1015	Excerpt from Transcript of Motions Hearing in *Webroot, Inc., et al. v. AO Kaspersky Lab*, No. 6:22-cv-00243-ADA-DTG (W.D. Tex.) (Dec. 9, 2022)
1016	*Threat Graphs examples: Malware detection*, Sophos Ltd., KB-000036359, https://support.sophos.com/support/s/article/KB000036359?language=en_US (Feb. 23, 2023)
1017	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 1017. 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 '250 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 1017. 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. 8,418,250 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.
- Sophos, Inc. v. Open Text Inc., IPR2023-00699, instituted.
- CrowdStrike Holdings v. Open Text Inc., IPR2023-00289, instituted (motion to terminate pending).
- AO Kaspersky Lab v. Open Text Inc., IPR2023-01334 (joined with IPR2023-00289), terminated.
- Trend Micro, Inc. v. Open Text Inc., IPR2023-00655, institution denied.

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

Robert M. Hansen (Reg. No. 43,656)
Email: rhansen@marburylaw.com
Matthew J. Anderson (Reg. No. 78,257)
Email: manderson@marburylaw.com
Scott B. Amankwatia (Reg. No. 78,226)
Email: samankwatia@marburylaw.com
THE MARBURY LAW GROUP, PLLC
11800 Sunrise Valley Drive, 15th Floor
Reston, VA 20191
Attorneys for Trend Micro Inc.

/Brian Eutermoser/

Brian Eutermoser (Reg. No. 64,058)
Email: beutermoser@kslaw.com
KING & SPALDING LLP
1401 Lawrence Street, Suite 1900
Denver, CO 80202
Telephone: (720) 535-2312

Russell E. Blythe (Reg. No. 58,440)
Email: rblythe@kslaw.com
KING & SPALDING LLP
1180 Peachtree Street NE Atlanta, GA
30309 Telephone: (404) 572-4600

Mikaela Stone (Reg. No. 70,404)
Email: mikaela.stone@kslaw.com
KING & SPALDING LLP
1401 Lawrence Street, Suite 1900
Denver, CO 80202 Telephone: (720) 535-
2312

Attorneys for Open Text Inc.

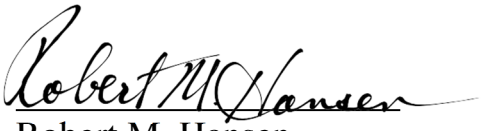
CERTIFICATE OF SERVICE

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



Robert M. Hansen
Attorney for Petitioner