UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB
Petitioner

v.

OPEN TEXT INC.
Patent Owner

IPR2024-00292
U.S. Patent No. 8,201,243

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED PETITIONER'S EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 8,201,243 (issued June 12, 2012)
1002	Declaration of Michael J. Donahoo, Ph.D. under 37 C.F.R. §1.68
1003	Curriculum Vitae of Michael J. Donahoo, Ph.D.
1004	File History of U.S. Patent No. 8,201,243
1005	U.S. Patent No. 8,719,924 to Williamson et al. (filed March 3, 2006) ("Williamson")
1006	U.S. Patent Publication No. 2007/0016951 to Piccard et al. ("Piccard")
1007	U.S. Patent No. 7,934,103 to Kidron (filed April 15, 2003) ("Kidron")
1008	WALTER ONEY, PROGRAMMING THE MICROSOFT WINDOWS DRIVER MODEL, (2nd ed. 2003)
1009	Ted Hudek & Don Marshall, *KMDF Version History*, MICROSOFT (Oct. 31, 2023), https://learn.microsoft.com/en-us/windows-hardware/drivers/wdf/kmdf-version-history
1010	TROY MOTT, LEARNING CARBON, (Apple Computer, Inc. eds., 1st ed. 2001)
1011	T JAMES GOSLING, FRANK YELLIN, & THE JAVA TEAM, *The Java™ Application Programming Interface, Volume 1: Core Packages in* THE JAVA SERIES . . . FROM THE SOURCE
1012	DICTIONARY OF COMPUTING, (4th ed. 1996)
1013	Sixth Amended Scheduling Order, Open Text Inc. v. AO Kaspersky Lab, 6:22-cv-00243-ADA-DTG (U.S. Dist. Ct. W. Dist. Tx. Waco Div., Oct. 30, 2023)
1014	Claim Construction Order, Webroot, Inc., Open Text Inc. v. AO Kaspersky Lab, 6:22-cv-00243-ADA-DTG (U.S. Dist. Ct. W. Dist. Tx. Waco Div., July 25, 2023)
1015	Fifth Amended Scheduling Order, Open Text Inc. v. AO Kaspersky Lab, 6:22-cv-00243-ADA-DTG (U.S. Dist. Ct. W. Dist. Tx. Waco Div., Mar. 29, 2023)
1016	Plaintiffs' Responsive Claim Construction Brief Regarding Patents Plaintiffs Added by Amendment [263], Open Text Inc. v. AO Kaspersky Lab, 6:22-cv-00243-ADA-DTG (U.S. Dist. Ct. W. Dist. Tx. Waco Div., May 5, 2023)
1017	JAMES BONEY, CISCO IOS IN A NUTSHELL (2001)

Exhibit	Description
1018	DAVID HUCABY, CISCO ASA AND PIX FIREWALL LOGGING, provided by Cisco Press (2005) https://www.ciscopress.com/articles/article.asp?p=424447&seqNum=2
1019	Jennifer M. Anderson, et al., Continuous Profiling: Where Have All the Cycles Gone?, 15 ACM Transactions on Computer Systems 357 (1997)
1020	Agreement
1021	Agreement

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board's email of April 9, 2024, Petitioner AO Kaspersky Lab ("Kaspersky" 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 37 C.F.R. § 42.74(b), the Agreement is in writing, and a true and correct copy is being filed as Confidential Exhibits 1020 and 1021. The Agreement is being filed electronically with access to "Board and Parties Only." 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 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)

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, Kaspersky 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, Kaspersky and Open Text have reached a resolution as to all the disputes in this proceeding and as to the '243 patent. A true copy of the Agreement is being filed concurrently herewith. *See* Confidential Exhibits 1020 and 1021. Kaspersky and Open Text request that the Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Parties.

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 "update the Board concerning the status of any litigation or proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future."

U.S. Patent No. 8,201,243 ("the Challenged Patent") has been involved in the following litigation:

- Webroot, Inc. v. AO Kaspersky Lab, 6-22-cv-00243 (WDTX), stipulation of dismissal filed.
- Webroot, Inc. v. Trend Micro, Inc., 6:22-cv-00239 (WDTX), terminated.
- Webroot, Inc. v. Sophos Ltd., 6:22-cv-00240 (WDTX), terminated.

- Webroot, Inc. v. CrowdStrike Holdings, Inc., 6:22-cv-00241 (WDTX), terminated.
- Webroot, Inc. v. Forcepoint LLC, 6:22-cv-00342 (WDTX), terminated.

The Challenged Patent has been involved in the following U.S. Patent and Trademark Office proceedings:

- Sophos Inc. et al. v. Open Text Inc. et al., IPR2024-00252, terminated.
- Trend Micro, Inc. et al. v. Open Text Inc. et al., IPR2023-01390, institution denied.
- CrowdStrike, Inc., et al. v. Open Text Inc. et al., IPR2023-01052, terminated.
- Sophos Inc. et al. v. Open Text Inc. et al., IPR2023-00731, institution denied.

The Parties confirm that the Agreement resolves all disputes between the Parties concerning the Challenged Patent. Accordingly, no litigation or proceedings involving the Challenged Patent and the Parties is contemplated in the foreseeable future. Other than the proceedings listed above, and without waiving any applicable privilege, Open Text is not aware of any imminent litigation involving the Challenged Patent.

IV. CONCLUSION

For the foregoing reasons, Kaspersky and Open Text respectfully request termination of this *inter partes* review.

Dated: April 12, 2024

Respectfully submitted,

DEWITT LLP

BY: */Joseph T. Miotke/*
Joseph T. Miotke, Reg. No. 47,798
901 Marquette Avenue
Suite 2100
Minneapolis, MN 55402
Tel: (612) 305-1400
COUNSEL FOR PETITIONER

KING & SPALDING LLP

BY: */Brian Eutermoser/*
Brian Eutermoser, Reg. No. 64,058
Russell E. Blythe, Reg. No. 58,440
Mikaela Stone, Reg. No. 70,404
COUNSEL FOR PATENT OWNER

CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on April 12, 2024, a complete and entire copy of this Joint Motion to Termination and Confidential Exhibits 1020 and 1021 were provided by email, to the Patent Owner by serving the email correspondence address of record as follows:

Dated: April 12, 2024

Respectfully submitted,

By: */Joseph T. Miotke/*

Joseph T. Miotke, Reg. No. 47,798
Dewitt LLP
901 Marquette Avenue
Suite 2100
Minneapolis, MN 55402
Tel: (612) 305-1400