

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

WEBROOT, INC. and OPEN TEXT, INC.,	§	
	§	
Plaintiffs	§	
	§	
v.	§	NO. 6:22-cv-239-ADA-DTG
	§	
TREND MICRO INC.,	§	JURY TRIAL DEMANDED
	§	
Defendant.	§	
<hr style="border: 0.5px solid black;"/>		
TREND MICRO INC.,	§	
	§	
Counter-Plaintiff	§	
	§	
v.	§	
	§	
WEBROOT, INC. and OPEN TEXT, INC.,	§	
	§	
Counter-Defendants,	§	
	§	
and	§	
	§	
OPEN TEXT CORP.	§	
	§	
Counter-Defendant.	§	
	§	

DEFENDANT’S PRELIMINARY INVALIDITY CONTENTIONS

Defendant Trend Micro Inc. (“Trend Micro” or “Defendant”), by their attorneys, make these Invalidity Contentions concerning U.S. Patent Nos. 8,181,244 (the “’244 patent”), 8,201,243 (the “’243 patent”), 8,719,932 (“the ’932 patent”), 8,856,505 (the “’505 patent”), and 11,409,869 (the “’869 patent”) (collectively, the “Asserted Patents”) to Open Text, Inc. (“Open Text”) and Webroot, Inc. (“Webroot”) (all together “Plaintiffs”) in connection with the above-referenced action, pursuant to the Court’s Scheduling Order (Dkt. 160) and the Court’s Order Governing

Invalidity Charts
Ex. 869-A-61 – McAfee Web Protection (“Web Protection”)
Ex. 869-A-62 – McAfee Endpoint Protection (“Endpoint Protection”)
Ex. 869-A-63 – Check Point Threat Prevention Appliance (“Threat Prevention Appliance”)
Ex. 869-A-64 – Symantec Endpoint Protection (“Endpoint Protection”)
Ex. 869-A-65 – McAfee Advanced Threat Defense (“Advanced Threat Defense”)
Ex. 869-A-66 – Symantec Email Security (“Email Security”)
Ex. 869-A-67 – Symantec IM Security (“IM Security”)
Ex. 869-A-68 – Symantec Web Security (“Web Security”)
Ex. 869-A-69 – Symantec AntiSpam (“AntiSpam”)
Ex. 869-A-70 – Webroot SecureAnywhere Endpoint Protection (“SecureAnywhere Endpoint Protection”)
Ex. 869-A-71 – Trend Micro InterScan VirusWall (“InterScan VirusWall”) – CONFIDENTIAL – OUTSIDE ATTORNEY’S EYES ONLY
Ex. 869-A-72 – U.S. Patent Application Publication No. 2014/0090061 to <i>Avasarala et al.</i> (filed Sept. 26, 2013, published Mar. 27, 2014) (“Avasarala”)
Ex. 869-A-73 – U.S. Patent No. 9,245,120 to <i>Friedrichs et al.</i> (filed July 15, 2013, issued Jan. 26, 2016) (“Friedrichs”)
Ex. 869-A-74 – U.S. Patent Application Publication No. 2015/0213376 to <i>Ideses et al.</i> (filed Jan. 29, 2015, published July 30, 2015) (“Ideses”)
Ex. 869-A-75 – <i>Masud et al.</i> , Data Mining Tools For Malware Detection, Taylor & Francis Group, LLC (CRC Press) (2011) (“Masud”)
Ex. 869-A-76 – U.S. Patent Application Publication No. 2017/0098074 to <i>Okano et al.</i> (filed June 11, 2014, published Apr. 6, 2017) (“Okano ’074”)
Ex. 869-A-77 – U.S. Patent No. 9,398,034 to <i>Ronen et al.</i> (filed Dec. 19, 2013, issued July 19, 2016) (“Ronen”)
Ex. 869-A-78 – U.S. Patent No. 8,799,190 to <i>Stokes et al.</i> (filed June 17, 2011, issued Aug. 5, 2014) (“Stokes”)

'505 patent, claim 14	"program instructions for: managing pestware-related events after the computer becomes configured to run native applications"
'505 patent, claims 15, 16	"the boot sequence" / "first and second periods in the boot sequence"
'505 patent, claim 17	"the scanned registry"
'505 patent, claim 19	"pestware-related invents"
'869 patent, claims 18, 32, 46	"identifying static data points that may be indicative of either a harmful or benign executable file"
'869 patent, claims 18, 32, 46	"associating the identified static data points with one of a plurality of categories of files, the plurality of categories of files including harmful files and benign files"
'869 patent, claims 18, 30, 31, 32, 44, 45, 46, 58, 59	"harmful [executable] file[s]" / "executable file [is/as] harmful"
'869 patent, claims 18, 32, 46	"benign [executable] file[s]"
'869 patent, claims 18, 32, 46	"generating a feature vector from the plurality of static data points using a classifier trained to classify the static data points based on training data, the training data comprising files known to fit into one of the plurality of categories of files"
'869 patent, claims 18, 30, 32, 44, 46, 58	"classifier"
'869 patent, claims 18, 32, 46	"classifier trained to classify the static data points based on training data, the training data comprising files known to fit into one of the plurality of categories of files"
'869 patent, claims 18, 32, 46	"files known to fit into one of the plurality of categories of files"
'869 patent, claims 18, 32, 46	"one or more features of the feature vector are selectively turned on or off based at least in part on evaluation of whether a value of one of the plurality of static data points is within a predetermined range"
'869 patent, claims 18, 32, 46	"selectively turned on or off"
'869 patent, claims 18, 32, 46	"predetermined range"
'869 patent, claims 18, 32, 46	"determine whether the executable file fits into one of the categories of files"
'869 patent, claims 29, 43, 57	"plurality of static data points represent predefined character strings in the executable file"

'869 patent, claims 30, 44, 58	"a determination of whether the executable file is harmful"
'869 patent, claims 31, 45, 59	"classifying the executable file as harmful"
'869 patent, claim 46	<p>"at least one processor configured to perform operation of: identifying static data points that may be indicative of either a harmful or benign executable file; and associating the identified static data points with one of a plurality of categories of files, the plurality of categories of files including harmful files and benign files"</p> <p>"at least one processor configured to perform operation of: identifying an executable file to be evaluated; extracting a plurality of static data points from the executable file; generating a feature vector from the plurality of static data points using a classifier trained to classify the static data points based on training data, the training data comprising files known to fit into one of the plurality of categories of files, wherein one or more features of the feature vector are selectively turned on or off based at least in part on evaluation of whether a value of one of the plurality of static data points is within a predetermined range; and evaluating the feature vector using a machine learning model to determine whether the executable file fits into one of the categories of files"</p>
'869 patent, claim 47	"The system according to claim 46, wherein the plurality of static data points are extracted without decrypting or unpacking the executable file."
'869 patent, claim 48	"The system according to claim 46, wherein the machine learning model comprises an artificial neural network."
'869 patent, claim 54	"The system according to claim 46, wherein the executable file is identified in response to a detected condition."
'869 patent, claim 55	"The system according to claim 54, wherein the detected condition is user request for a file download."
'869 patent, claim 56	"The system according to claim 54, wherein the detected condition is the detection of a new file attempting to execute."

'869 patent, claim 57	“The system according to claim 46, wherein the plurality of static data points represent predefined character strings in the executable file.”
'869 patent, claim 58	“The system according to claim 46, wherein a determination of whether the executable file is harmful is used to retrain the classifier.”
'869 patent, claim 59	“at least one processor configured to perform operation of: preventing execution of the executable file based on classifying the executable file as harmful”

To the extent other asserted claims contain one of these terms or phrases, either directly or through being a dependent claim of a claim that does, those asserted claims of the Asserted Patents are invalid under 35 U.S.C. § 112, ¶ 2 (pre-AIA) / 35 U.S.C. § 112(b) (AIA).

The claims are indefinite as they fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

B. Lack of Enablement under 35 U.S.C. §112, ¶ (1) (pre-AIA) / 35 U.S.C. § 112(a) (AIA)

The asserted claims of the Asserted Patents are invalid because they fail to meet the “enablement” requirement of 35 U.S.C. § 112, ¶ 1 (pre-AIA) / 35 U.S.C. § 112(a) (AIA), because the Asserted Patents do not disclose sufficient information to enable or teach one skilled in the field of the invention to make and use the full scope of the claimed invention without undue experimentation for at least the following terms or phrases:

Claim	Term / Phrase
'244 patent, claim 1	“suspected pestware activity”
'244 patent, claims 1, 4, 5, 9, 13, 16	“activity log”
'244 patent, claims 1, 2, 9, 10, 12, 14	“time of interest”
'244 patent, claim 1	“suspicion of pestware”
'244 patent, claim 1	“time of interest relating to a suspicion of pestware”

'505 patent, claim 6	"fifth instruction set configured to analyze the record of events so as to identify the pestware-related events"
'505 patent, claim 6	"sixth instruction set configured to modify the set of behavior rules so as to prevent the pestware related events"
'505 patent, claim 6	"seventh instruction set configured to scan data in a registry of the computer for pestware during the second period in the boot sequence"
'505 patent, claim 7	"eighth instruction set configured to launch, after an operating system is initiated, a pestware management engine"
'505 patent, claim 9	"a ninth instruction set configured to manage pestware-related events after the computer becomes configured to run native applications"
'505 patent, claim 10	"the boot sequence"
'505 patent, claim 14	"program instructions for: managing pestware-related events after the computer becomes configured to run native applications"
'505 patent, claims 15, 16	"the boot sequence" / "first and second periods in the boot sequence"
'505 patent, claim 17	"the scanned registry"
'505 patent, claim 19	"pestware-related invents"
'869 patent, claims 18, 32, 46	"identifying static data points that may be indicative of either a harmful or benign executable file"
'869 patent, claims 18, 32, 46	"associating the identified static data points with one of a plurality of categories of files, the plurality of categories of files including harmful files and benign files"
'869 patent, claims 18, 30, 31, 32, 44, 45, 46, 58, 59	"harmful [executable] file[s]" / "executable file [is/as] harmful"
'869 patent, claims 18, 32, 46	"benign [executable] file[s]"
'869 patent, claims 18, 32, 46	"generating a feature vector from the plurality of static data points using a classifier trained to classify the static data points based on training data, the training data comprising files known to fit into one of the plurality of categories of files"

'869 patent, claims 18, 30, 32, 44, 46, 58	“classifier”
'869 patent, claims 18, 32, 46	“classifier trained to classify the static data points based on training data, the training data comprising files known to fit into one of the plurality of categories of files”
'869 patent, claims 18, 32, 46	“files known to fit into one of the plurality of categories of files”
'869 patent, claims 18, 32, 46	“one or more features of the feature vector are selectively turned on or off based at least in part on evaluation of whether a value of one of the plurality of static data points is within a predetermined range”
'869 patent, claims 18, 32, 46	“determine whether the executable file fits into one of the categories of files”
'869 patent, claims 19, 33, 47	“plurality of static data points are extracted without decrypting or unpacking the executable file”
'869 patent, claims 29, 43, 57	“plurality of static data points represent predefined character strings in the executable file”
'869 patent, claims 30, 44, 58	“a determination of whether the executable file is harmful”
'869 patent, claims 31, 45, 59	“classifying the executable file as harmful”

To the extent other asserted claims contain one of these terms or phrases, either directly or through being a dependent claim of a claim that does, those asserted claims of the Asserted Patent are invalid under 35 U.S.C. § 112, ¶ 1 (pre-AIA) / 35 U.S.C. § 112(a) (AIA).

Thus, the claims lack written description.

VI. **Invalidity Under 35 U.S.C. § 101**

In addition to the other grounds of invalidity set forth herein, Defendant contends that the asserted claims of the Asserted Patents are invalid under 35 U.S.C. § 101 for at least the following reasons. The Subject-Matter Eligibility Contentions set forth below, pursuant to the Court’s Order Governing Proceedings – Patent Cases, are subject to revision and amendment pursuant to Federal Rule of Civil Procedure 26(e) to the extent appropriate in light of further investigation and discovery, the Court’s construction of the asserted claims, and/or the positions taken during expert

Dated: February 21, 2023

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document has been served on February 21, 2023, to all counsel of record via e-mail.

/s/ C. Daniel Treviño
C. Daniel Treviño