

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB,
Petitioner,

v.

OPEN TEXT INC.,
Patent Owner.

IPR2023-01334
Patent 8,418,250 B2

Before GREGG I. ANDERSON, MICHELLE N. WORMMEESTER, and
AARON W. MOORE, *Administrative Patent Judges*.

WORMMEESTER, *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

I. INTRODUCTION

AO Kaspersky Lab (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–30 of U.S. Patent No. 8,418,250 B2 (Ex. 1001, “the ’250 patent”). Petitioner also filed a Motion for Joinder (Paper 2, “Joinder Mot.”) seeking to join this proceeding with *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00289 (“the 289 IPR”). Open Text Inc. (“Patent Owner”)¹ did not file an opposition to the Motion for Joinder, but did file a Preliminary Response (Paper 7, “Prelim. Resp.”).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless . . . 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 that follow, we institute an *inter partes* review of the challenged claims and grant the Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

In the 289 IPR, we instituted an *inter partes* review of the challenged claims on the following grounds. 289 IPR, Paper 7.

¹ The Petition’s caption identifies Webroot Inc. as the patent owner. In Patent Owner’s mandatory notices, however, Patent Owner identifies itself, Open Text Inc., as the patent owner “due to a change in ownership of U.S. Pat. No. 8,418,250.” Paper 6, 1 n.1.

Claims Challenged	Basis	References
1, 2, 7–14, 19–30	35 U.S.C. § 103	Kester, ² Honig
3–6, 15–18	35 U.S.C. § 103	Kester, Honig, ³ Kennedy ⁴

Here, Petitioner represents that the instant Petition is “essentially a copy” of the petition in the 289 IPR, and that the instant Petition includes “the identical grounds presented” in the 289 IPR. Joinder Mot. 1.

In its Preliminary Response, Patent Owner argues that “the Board should deny institution for multiple reasons.” Prelim. Resp. 1. For example, Patent Owner argues that “[t]he grounds raised by Petitioner in this proceeding are identical in substance to the grounds raised by [the petitioner] in the [289] IPR,” and, “[f]or the same reasons set forth in Patent Owner’s Preliminary Response in the [289] IPR, Petitioner has not shown a reasonable likelihood of success as to any challenged claim” in the instant proceeding. *Id.* at 1–2. We have already found those reasons insufficient to avoid institution. Accordingly, for the reasons given in our institution decision in the 289 IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner will prevail in showing that the challenged claims would have been obvious. *See* 289 IPR, Paper 7.

Patent Owner further argues that Petitioner’s “motion for joinder should be denied as moot, and institution of *inter partes* review denied, because there will be no proceeding to be joined and, without joinder, the

² Kester et al., U.S. Publ’n No. 2005/0210035 A1, published Sept. 22, 2005 (Ex. 1004).

³ Honig et al., U.S. Patent No. 7,225,343 B1, issued May 29, 2007 (Ex. 1005).

⁴ Kennedy et al., U.S. Patent No. 7,594,272 B1, issued Sept. 22, 2009 (Ex. 1006).

petition is time-barred.” Prelim. Resp. 2. Patent Owner asserts that “by the time the Board issues its institution decision in the instant proceeding, the [289] IPR will likely be terminated,” as Patent Owner and the petitioner in the 289 IPR “have already resolved their disputes with respect to the ’250 patent and jointly filed a motion to terminate the [289] IPR.” *Id.* at 3.

Patent Owner’s argument is unavailing. The 289 IPR was instituted on July 21, 2023, and Petitioner filed its joinder motion on August 18, 2023, before the joint motion to terminate in the 289 IPR was filed on November 20, 2023. The joinder motion is timely because joinder was requested no later than one month after institution of the 289 IPR. *See* 37 C.F.R. § 42.122(b). Additionally, the 289 IPR is still pending. The Petition therefore is not time-barred. Under these circumstances, we may grant Petitioner’s joinder motion.

Patent Owner further argues that Petitioner fails to identify all real parties in interest, including Kaspersky Labs Limited and Kaspersky Lab Switzerland GmbH. Prelim. Resp. 4–5. According to Patent Owner, “it appears that [Kaspersky Labs Limited and Kaspersky Lab Switzerland GmbH] are in privity with Petitioner and also real-parties-in-interest in this proceeding.” *Id.* at 5. Patent Owner asserts that both unnamed parties are “Petitioner’s codefendants in parallel district court litigation,” that “[b]oth are corporate relatives of Petitioner,” and that “both are represented by the same counsel.” *Id.* at 4–5. Patent Owner adds that “Petitioner has failed to update its mandatory notices to identify its Corporate Relatives as real-parties-in-interest.” *Id.* at 5.

This argument also is unavailing. Since the filing of Patent Owner’s Preliminary Response in this proceeding, Petitioner has updated its

mandatory notices to include Kaspersky Labs Limited and Kaspersky Lab Switzerland GmbH as real parties in interest “out of an abundance of caution.”⁵ Paper 8, 5. Moreover, we need not decide whether a party has identified all real parties in interest at the institution stage absent an implication of a time bar or an estoppel under 35 U.S.C. § 315. *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18–20 (PTAB Oct. 6, 2020) (precedential). We recognize Patent Owner’s allegation that, “*without joinder*, the [P]etition is time-barred.” Prelim. Resp. 2 (emphasis added). As explained above, however, the Petition is not time-barred, given that Petitioner has timely filed its joinder motion and the 289 IPR is still pending. Patent Owner does not allege a time bar or other estoppel would prevent institution if an unnamed party were identified as a real party in interest.

Patent Owner further argues that we should discretionarily deny the Petition under 35 U.S.C. § 314(a) for the “same reasons” set forth in its preliminary response in the 289 IPR. We have already found those reasons insufficient to support exercising our discretion to deny institution. Thus, for the reasons given in our institution decision in the 289 IPR, we decline to exercise our discretion to deny institution here. *See* 289 IPR, Paper 7.

Lastly, Patent Owner argues that “institution of the [P]etition and joinder of Petitioner to the settled and to-be-terminated [289] IPR would result in further delay and inefficiencies.” Prelim. Resp. 5. According to Patent Owner, “Petitioner failed to comply with the Board’s requirement that ‘[a] party who files a motion for joinder should arrange a conference call

⁵ Petitioner maintains its “belief that neither Kaspersky Labs Limited nor KL Switzerland are real parties-in-interest.” Paper 8, 5.

with the panel, petitioner, and patent owner of the first proceeding within five business days of filing the motion.” *Id.* at 5 (quoting Patent Trial and Appeal Board Consolidated Trial Practice Guide 76 (Nov. 2019)).⁶ Patent Owner asserts that “[w]ere Petitioner to be joined to the [289] IPR following Patent Owner’s and [the 289 IPR petitioner’s] settlement, the existing schedule in the [289] IPR would require adjustment, as Patent Owner’s response is due only a few weeks after the filing of this [P]reliminary [R]esponse and long before the Board’s expected institution decision on [this] [P]etition.” *Id.* at 6.

We disagree with Patent Owner. Our Trial Practice Guide does not *require* Petitioner to arrange a conference call with the panel, petitioner, and patent owner of the 289 IPR; rather, it recommends arranging such a conference call where “[t]he purpose of the conference call is for the panel to timely manage the proceedings.” Trial Practice Guide 76. That Petitioner did not arrange this call is insufficient basis for denying institution. Moreover, we note that the parties in the 289 IPR have already stipulated to the modification of certain deadlines, including the deadlines for the patent owner response, petitioner reply, and patent owner sur-reply, and that Petitioner here “agrees to adhere to all applicable deadlines set forth in the [289] IPR Scheduling Order.” 289 IPR, Paper 20; Joinder Mot. 7.

In view of the foregoing, we institute an *inter partes* review on the same grounds on which we instituted review in the 289 IPR.

⁶ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

III. GRANT OF MOTION FOR JOINDER

The 289 IPR was instituted on July 21, 2023, and Petitioner filed its joinder motion on August 18, 2023. As explained above, the joinder motion is timely because joinder was requested no later than one month after institution of the 289 IPR. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which provides,

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

As noted above, the Petition asserts the same unpatentability grounds on which we instituted review in the 289 IPR, relying on substantially the

same evidence.⁷ Joinder Mot. 1. If joinder is granted, Petitioner agrees to assume an “understudy” role and states that “[u]nless and until the current petitioners in IPR2023-00289 cease to participate in the instituted [289] IPR proceeding, [Petitioner] will not assume an active role.” *Id.* at 7–9.

Petitioner represents that “[n]o additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of [Petitioner’s] joinder.” *Id.* at 9. Petitioner further “agrees to adhere to all applicable deadlines set forth in the [289] IPR Scheduling Order.” *Id.* at 7.

We agree with Petitioner that joinder with the 289 IPR is appropriate under these circumstances. Patent Owner did not file an opposition to Petitioner’s joinder motion. Accordingly, we grant the joinder motion.

IV. ORDER

For the reasons given, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted as to all challenged claims of the ’250 patent, namely, claims 1–30, based on all grounds presented in the Petition;

⁷ Petitioner represents that “[t]he supporting expert declaration of V.S. Subrahmanian, Ph.D. submitted by [Petitioner] agrees with the facts, analysis, and conclusions of the expert declaration in the [289] IPR,” and that “[t]he declaration of V.S. Subrahmanian does not contain any new opinions not included in the [289] IPR expert declaration.” Joinder Mot. 4 n.2. Patent Owner does not address this difference in its Preliminary Response.

FURTHER ORDERED that the Motion for Joinder is granted, and that Petitioner AO Kaspersky Lab is joined as a petitioner in IPR2023-00289;

FURTHER ORDERED that, subsequent to joinder, the grounds for trial in IPR2023-00289 remain unchanged and the scheduling order in place for IPR2023-00289 remains unchanged;

FURTHER ORDERED that the petitioner in IPR2023-00289 (i.e., CrowdStrike, Inc. and AO Kaspersky Lab) will file all papers in IPR2023-00289 as a single, consolidated filing, subject to the page limits set forth in 37 C.F.R. § 42.24;

FURTHER ORDERED that, for any consolidated filing, if AO Kaspersky Lab wishes to file an additional paper to address points of disagreement with the other petitioner, AO Kaspersky Lab must request authorization from the Board to file a motion for additional pages, and no additional paper may be filed unless the Board grants such a motion;

FURTHER ORDERED that the case caption in IPR2023-00289 shall be changed to reflect joinder of AO Kaspersky Lab as a petitioner; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2023-00289.

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PETITIONER:

Joseph Miotke
Eric Chadwick
Erin Block
DEWITT LLP
jtm@dewittllp.com
ehc@dewittllp.com
eblock@dewittllp.com

PATENT OWNER:

Brian Eutermoser
Russell Blythe
Mikaela Stone
KING & SPALDING LLP
beutermoser@kslaw.com
rblythe@kslaw.com
mikaela.stone@kslaw.com