

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AO KASPERSKY LAB  
Petitioner

v.

OPEN TEXT INC.  
Patent Owner

IPR2023-00289  
U.S. Patent No. 8,418,250

**JOINT MOTION TO TERMINATE PROCEEDING**

**UPDATED PETITIONER’S EXHIBIT LIST**

<b>Exhibit</b>	<b>Description</b>
1001	U.S. Patent No. 8,418,250 to Morris et al. (“’250 Patent”)
1002	File History of U.S. Patent No. 8,418,250 (“’250 File History”)
1003	Declaration of Dr. Wenke Lee (“Decl.”)
1004	U.S. Patent Application Publication No. 2005/0210035 A1 to Kester et al. (“Kester”)
1005	U.S. Patent No. 7,225,343 to Honig et al. (“Honig”)
1006	U.S. Patent No. 7,594,272 to Kennedy et al. (“Kennedy”)
1007	Plaintiff’s Opposition Markman Brief, 22-cv-00243 WDTX, No. 98
1008	INTENTIONALLY LEFT BLANK
1009	Intentionally left blank
1010	DEFENDANTS’ OPENING MARKMAN BRIEF, 22-CV-00243 WDTX, No. 86
1011	Intrusion Detection with Unlabeled Data Using Clustering by Leonid Portnoy, et al. (“Portnoy”)
1012	U.S. PATENT NO. 6,944,772 TO DOZORTSEV (“DOZORTSEV”)
1013	U.S. Patent No. 6,772,363 to Chess et al. (“Chess”)
1014	WO 2002/033525 to Shyne-Song Chuang
1015	EP 1,549,012 to Kristof De Spiegeleer
1016	EP 1,280,040 to Alexander James Hinchliffe, et al.
1017	U.S. Patent Publication No. 2004/0153644 to McCorkendale (“McCorkendale”)
1018	U.S. PATENT NO. 7,516,476 TO KRAEMER (“KRAEMER”) U.S. PATENT NO. 7,516,476 TO KRAEMER (“KRAEMER”)
1019	HAROLD S. JAVITZ ET AL., THE NIDES STATISTICAL COMPONENT: DESCRIPTION AND JUSTIFICATION” (“THE NIDES STATISTICAL COMPONENT: DESCRIPTION AND JUSTIFICATION”)
1020	U.S. Patent No. 7,448,084 to Apap et al.
1021	Order Granting Third Amended Scheduling Order, 22-cv-00243 WDTX, No. 142 (“Third Amended Scheduling Order”)
1022	Declaration of Hunter Horton in Support of Motion For Pro Hac Vice
1023	Agreement
1024	Agreement

Exhibit	Description
1025	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 1024 and 1025. 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 ’250 patent. A true copy of the Agreement is being filed concurrently herewith. *See* Confidential Exhibits 1024 and 1025. 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. 8,418,250 (“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:

- Trend Micro, Inc. et al. v. Open Text Inc. et al., IPR2024-00106, terminated.
- Sophos Inc. et al. v. Open Text Inc. et al., IPR2023-00699, terminated.
- Trend Micro, Inc. et al. V. Open Text Inc. et al., IPR2023-00655, 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,

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**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 1024 and 1025 were provided by email, to the Patent Owner by serving the email correspondence address of record as follows:

Dated: April 12, 2024

Respectfully submitted,

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