

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO, INC.,
Petitioner,

v.

OPEN TEXT INC.,
Patent Owner.

IPR2023-01390
Patent 8,201,243 B2

Before JUSTIN T. ARBES, BARBARA A. PARVIS, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Trend Micro, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–14 of U.S. Patent No. 8,201,243 B2 (Ex. 1001, “the ’243 patent”). Pet. 1. Open Text Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless it is determined that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. After considering the parties’ arguments and evidence, and for the reasons set forth below, Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to at least one of the challenged claims of the ’243 patent. Accordingly, we decline to institute an *inter partes* review.

II. BACKGROUND

A. The ’243 patent

The ’243 patent relates to systems and methods of detecting, controlling, and removing pestware. Ex. 1001, 1:35–38. Pestware includes, for example, any program, such as trojans, spyware, and adware, that collects information about a person or an organization. *Id.* at 1:43–54. Figure 4 is reproduced below.

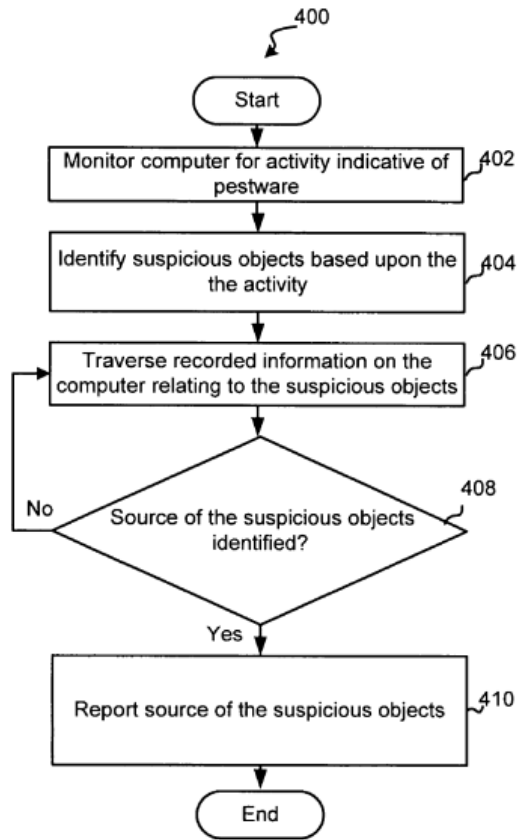


FIGURE 4

The method shown in Figure 4 monitors a computer for activity indicative of pestware 402 and identifies suspicious objects 404 based on that activity. *Id.* at 8:5–22. The method then checks recorded information on computer 406 to determine the source of suspicious objects 408. *Id.* at 8:23–31. If the source is identified, the computer will report that source “e.g., to a pestware research entity.” *Id.* at 8:32–35. In this way, the suspicious objects and the web sites originating the suspicious objects may be further researched to establish the extent to which they may be a threat. *Id.* at 8:35–38.

B. Challenged Claims

Claim 1, below, is illustrative of the challenged claims.

1. A method for identifying an origin of activity on a computer that is indicative of pestware comprising:

monitoring, using a kernel-mode driver, the computer for activity that is indicative of pestware, wherein the monitoring includes monitoring API calls and storing a history of at least a portion of the API calls in an activity log;

analyzing, heuristically, computer activity to determine whether one or more weighted factors associated with an activity exceeds a threshold so as to arrive at a determination that the activity is indicative of pestware;

identifying, based upon the activity, an object residing on the computer that is a suspected pestware object;

accessing, in response to the identifying an object, at least a portion of a recorded history of externally networked sources that the computer received files from so as to identify a reference to an identity of a particular externally networked source that the suspected pestware object originated from; and

reporting the identity of the particular externally networked source to an externally networked pestware research entity so as to enable the externally networked pestware research entity to research whether the particular externally networked source is a source of pestware.

Ex. 1001, 10:8–30.

C. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 4–5):

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–14	103	Abad, ² Piccard ³
1–14	103	Kilpatrick, ⁴ Piccard

Petitioner relies on the declaration of Dr. Seth James Nielson (Ex. 1003).

III. ANALYSIS

A. Level of Ordinary Skill in the Art

With regard to the level of ordinary skill in the art, we determine that no express finding is necessary on this record.

B. Claim Construction

Although Petitioner addresses the meaning of one claim term, Patent Owner construes no terms. Pet. 9–10; *see generally* Prelim. Resp. We determine that no terms require construction. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. The ’243 patent was filed before March 16, 2013, so we apply the pre-AIA versions of §§ 102, 103. Ex. 1001, code (22).

² C. Abad, *Log Correlation for Intrusion Detection: A Proof of Concept*, 19th Annual Computer Security Applications Conference (2003) (Ex. 1006).

³ U.S. Publication No. 2007/0006310 A1 to Piccard, published Jan. 4, 2007 (Ex. 1007).

⁴ U.S. Patent No. 6,735,703 B1 to Kilpatrick, issued May 11, 2004 (Ex. 1008).

necessary to resolve the controversy.” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

*C. Asserted Obviousness over Piccard in view of Other References
(Grounds 1 & 2)*

Both of Petitioner’s asserted grounds include the Piccard reference, which Petitioner relies on for asserted unpatentability of all claims. *See* Pet. 11–60. But Petitioner fails to establish a reasonable likelihood of prevailing on its challenges to patentability because Patent Owner sufficiently establishes, on this record, that Piccard is not prior art. *See* Prelim. Resp. 2–6.

Patent Owner contends that Piccard is disqualified as prior art under pre-AIA 35 U.S.C. § 103(c)(1). Prelim. Resp. 3. Because Petitioner relies on Piccard for every ground in the Petition, Patent Owner argues, the Board should deny institution on this basis alone. *Id.* at 6.

We agree with Patent Owner. Pre-AIA Section 103(c)(1) of Title 35 of the United States Code provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Petitioner asserts that Piccard qualifies as prior art under pre-AIA § 102(e). Pet. 4 (“Piccard . . . is prior art under pre-AIA § 102(e) because it was filed on June 30, 2005, before the earliest possible priority date of the ’243 patent.”). Piccard cannot qualify as prior art under § 102(a) or § 102(b), as Piccard published January 4, 2007, which is after the ’243 patent’s April 20,

2006 filing date. Ex. 1007, code (43); Ex. 1001, code (22). Therefore, Piccard could qualify as prior art *only* under § 102(e) and may be subject to disqualification under § 103(c)(1). *Cf. Unified Patents, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-02148, Paper 9 at 19–20 (PTAB Apr. 17, 2018) (determining that a reference was not disqualified under § 103(c)(1) because it qualified as prior art under § 102(a) and therefore was not “prior art *only* under one or more of subsections (e), (f), and (g) of section 102”).

Patent Owner explains that both Piccard and the ’243 patent “were owned by, and subject to an obligation of assignment to, the same entity—Webroot Software, Inc. [‘Webroot’]—at the time the invention was made.” Prelim. Resp. 3–4. At the time of filing of the ’243 patent, the sole inventor, Matthew Boney, was an employee of Webroot and subject to an obligation to assign inventions to Webroot. *Id.* at 4 (citing Ex. 2001, Declaration of Matthew L. Boney); Ex. 1001, code (75). Matthew Boney also executed an assignment of the ’243 patent to Webroot on June 7, 2006. Prelim. Resp. 4–5 (citing Exs. 2004, 2014 (recordation)). Also at the time of the ’243 patent’s filing, Piccard was already assigned to Webroot because the sole inventor of Piccard, Paul L. Piccard, was an employee at Webroot and executed an assignment of Piccard to Webroot on June 30, 2005. *Id.* at 4 (citing Exs. 2002, 2003, 2013 (recordation)). Throughout the time period of June 30, 2005 (the filing date of Piccard) to April 20, 2006 (the filing date of the ’243 patent), Mr. Boney was an employee of Webroot and obligated to assign his inventions to the company. *Id.* at 6 (citing Ex. 2001 (Mr. Boney testifying that he was employed at Webroot from 2003 until 2008 and signed an employment agreement obligating him to assign inventions made during the time of his employment)). Therefore, we agree with Patent Owner that

Piccard and the '243 patent were commonly owned by the same person, Webroot,⁵ at the time the invention claimed in the '243 patent was made. Thus, Piccard falls within § 103(c)(1) and “shall not preclude patentability” of the claims of the '243 patent.⁶

Each of Petitioner’s grounds relies in part on Piccard for each of the independent claims. *See* Pet. 11–60. Accordingly, we determine that, based on the record before us, Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1–14 over Abad and Piccard or over Kilpatrick and Piccard.

IV. CONCLUSION

We determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on its challenges as to at least one challenged claim. Accordingly, we do not institute *inter partes* review.

V. ORDER

It is, therefore,

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is *denied*.

⁵ “[P]erson” as used in § 103(c)(1) refers to “person(s) or organization(s)/business entity(ies).” Manual of Patent Examining Procedure § 2146.02 (9th Ed., Nov. 2015, Revision 07.2022).

⁶ We note that during prosecution of the '243 patent, the examiner rejected the pending claims as unpatentable over two references (Wang and Maddaloni), the applicant argued that Maddaloni was disqualified as prior art under pre-AIA § 103(c)(1) due to similar common ownership by Webroot, and the examiner subsequently withdrew the rejection based in part on Maddaloni. *See* Pet. 7; Ex. 1002, 84–85, 112, 137.

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