Declaration of Tal Lavian, Ph.D., in Support of Petition
for Covered Business Method (CBM) Review of
U.S. Patent No. 8,646,093

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ServiceNow, Inc.
Petitioner

v.

BMC Software, Inc.
Patent Owner

U.S. Patent No. 8,646,093
Filing Date: December 9, 2009
Issue Date: February 4, 2014

TITLE: METHOD AND SYSTEM FOR CONFIGURATION MANAGEMENT
DATABASE SOFTWARE LICENSE COMPLIANCE

<u>DECLARATION OF TAL LAVIAN, PH.D.</u>

Table of Contents

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I, Tal Lavian, Ph.D., declare as follows:

1.   I have been retained by counsel for ServiceNow, Inc. (Petitioner) in

this case as an expert in the relevant art.

2.   I have been asked to provide my opinions relating to claims 1, 5, 10-

13, and 16 of U.S. Patent No. 8,646,093 to Myers et al. ("the '093 patent"), which I

understand is owned by BMC Software, Inc.

3.   I have previously submitted a declaration in connection with a Petition

for *Inter Partes* Review of the '093 patent, IPR2015-01555 (filed July 3, 2015), in

which I provided opinions regarding application of certain prior art references to

claims 1, 5, 10-13, and 16 of the '093 patent. My opinions here regarding the level

of ordinary skill in the art and the construction of certain terms from the '093

patent are the same as those in my earlier Declaration in IPR2015-01555.

I.   BRIEF SUMMARY OF MY OPINIONS

4.   Claims 1, 5, 10-13, and 16 generally describe a method and system for

ensuring that an organization has deployed a software product in a manner that is

consistent with its software license contract. In my opinion, these claims are not

patentable because they are directed to an abstract idea.

5.   In particular, the challenged claims are directed to the abstract idea of

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ensuring that an enterprise is in compliance with its software license contracts. This abstract idea is composed of the abstract ideas of: (1) gathering information about how a software product has been installed in an enterprise, (2) locating the license contract for the product; and (3) comparing the product installations against the license contract to determine compliance or non-compliance. As I will show in **Part IV.B** and **Part VI.A.1** below, this abstract process is <u>performed manually by human</u> beings who create a list of where a software product is installed in an enterprise, and compare that list against the product's license contract.

6.   As explained in detail in **Part VI.B**, claims 1, 5, 10-13, and 16 also fail to recite any limitations or technical requirements that could meaningfully transform them into something more than the abstract idea. The claims instead recite technologies that were conventional and routine to persons of ordinary skill in the art, such as the use of a standard Configuration Management Database (CMDB) to store information about software products and software contracts. The bases for my opinions are set forth below.

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