

Petition for Covered Business Method (CBM)
Review of U.S. Patent No. 8,646,093

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

**PETITION FOR COVERED BUSINESS METHOD (CBM) PATENT
REVIEW OF U.S. PATENT NO. 8,646,093**

Table of Contents

	Page
I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(A)(1)	1
A. Real Party-In-Interest under 37 C.F.R. § 42.8(b)(1)	1
B. Related Matters Under 37 C.F.R. § 42.8(b)(2)	1
C. Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)	1
D. Service Information	2
E. Power of Attorney	2
II. PAYMENT OF FEES - 37 C.F.R. § 42.203	2
III. REQUIREMENTS FOR CBM PATENT REVIEW.....	3
A. Grounds for Standing Under 37 C.F.R. § 42.304(a).....	3
1. The Petitioner Has Been Sued For Alleged Infringement of the '093 Patent In Pending Litigation and Is Not Estopped.....	3
2. The '093 Patent Qualifies for CBM Review	4
a. “Covered Business Method Patent” Prong.....	4
b. “Technological Invention” Prong.....	11
B. Identification of Challenge under 37 C.F.R. § 42.304(b) and Statement of Precise Relief Requested	18
C. Claim Construction Under 37 C.F.R. § 42.304(b)(3)	19
IV. BRIEF BACKGROUND OF THE STATE OF THE ART	19
V. SUMMARY OF THE CLAIMED SUBJECT MATTER.....	25
A. The Specification of the '093 Patent.....	25
B. The Claims of the '093 Patent.....	29
VI. CLAIM CONSTRUCTION UNDER 37 C.F.R. § 42.304(B)(3) 	30
A. “license certificate”	31
B. “model” and “modeling”	33
VII. CLAIMS 1, 5, 10-13, AND 16 ARE UNPATENTABLE UNDER 35 U.S.C. § 101.....	34
A. The Challenged Claims Are Directed to an Abstract Idea.....	35

Table of Contents
(continued)

	Page
1. Claim 1 (Independent)	35
2. Claim 5	41
3. Claim 10	41
4. Claims 11-13 (“License Type” Claims).....	42
5. Claim 16 (Independent)	43
B. The Challenged Claims Do Not Recite Meaningful Limitations.....	44
1. Claim 1 (Independent)	45
2. Dependent Claims 5, and 10-13.....	51
3. Claim 16 (Independent)	52
VIII. CONCLUSION.....	53

List of Exhibits

Ex. No	Description of Document
1001	U.S. Patent No. 8,646,093 to Anthony George Myers et al.
1002	Declaration of Tal Lavian, Ph.D.
1003	<i>Best Practice for Software Asset Management</i> , published by the IT Infrastructure Library, 2003
1004	<i>Introduction to ITIL</i> , published by the IT Infrastructure Library, 2005
1005	<i>A Guide to Software Asset Management</i> , published by Microsoft Corporation, 2004
1006	Excerpts from Microsoft Computer Dictionary (5th ed. 2002)
1007	Provisional Application No. 61/165,505 (incorporated by reference into the '093 patent).
1008	Complaint for Patent Infringement in Case No. 14-CV-00903 JRG (E.D. Tex. filed September 23, 2014)
1009	Affidavit of Christopher Butler, Office Manager of the Internet Archive, dated August 4, 2015

Petition for Covered Business Method (CBM)
Review of U.S. Patent No. 8,646,093

Petitioner ServiceNow, Inc. (“Petitioner”) respectfully submits this Petition for Covered Business Method (CBM) Review of claims 1, 5, 10-13, and 16 of U.S. Patent No. 8,646,093 [Ex. 1001] (“’093 patent”).

I. **MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(A)(1)**

A. **Real Party-In-Interest under 37 C.F.R. § 42.8(b)(1)**

The Petitioner, ServiceNow, Inc., is the real party-in-interest.

B. **Related Matters Under 37 C.F.R. § 42.8(b)(2)**

The Petitioner was sued for alleged infringement of the ’093 patent in BMC Software, Inc. v. ServiceNow, Inc., Case No. 14-CV-00903 JRG (E.D. Tex. filed Sept. 23, 2014). A copy of the Complaint filed in that action is attached as **Exhibit 1008**. The Petitioner has denied infringement and contends that the patent is invalid. That action remains pending. On July 3, 2015, the Petitioner filed a petition for *inter partes* review (IPR) of the ’093 patent (Case No. IPR2015-01555). That IPR also remains pending.

C. **Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)**

Petitioner provides the following designation of counsel.

Lead Counsel	Back-Up Counsel
Heidi L. Keefe (Reg. No. 40,673) hkeefe@cooley.com zpatdcdocketing@cooley.com COOLEY LLP ATTN: Patent Group 1299 Pennsylvania Ave., NW, Suite 700	Phillip E. Morton (Reg. No. 57,835) pmorton@cooley.com zpatdcdocketing@cooley.com COOLEY LLP ATTN: Patent Group 1299 Pennsylvania Ave., NW, Suite 700

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.