Trials@uspto.gov
571.272.7822

Paper No. 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SERVICENOW, INC.,
Petitioner,

v.

BMC SOFTWARE, INC.,
Patent Owner.

Case IPR2015-01176
Patent 5,978,594

Before JUSTIN T. ARBES, BRIAN P. MURPHY, and JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Petitioner ServiceNow, Inc. ("ServiceNow") filed a Petition ("Pet.") (Paper 1) to institute *inter partes* review of claim 1 of Patent 5,978,594 ("the '594 patent") (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. Patent Owner BMC Software, Inc. ("BMC") filed a Preliminary Response ("Prelim.

Resp.") (Paper 9) to the Petition. We have jurisdiction under 35 U.S.C. § 314.

Under 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response "shows that 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 as to claim 1 of the '594 patent on the asserted ground of unpatentability.

I. BACKGROUND

A. Related Proceeding

The parties identify the following proceeding related to the '594 patent (Pet. 1; Paper 5, 1): *BMC Software, Inc. v. ServiceNow, Inc.*, Case No. 2:14-CV-00903 JRG (E.D. Tex. Sept. 23, 2014). On August 13, 2015, the U.S. District Court for the Eastern District of Texas issued a claim construction order in that action. *See* Ex. 2006.

B. The '594 Patent

The '594 patent is directed to managing a computer network, including "discovering which resources and applications are present on [a] computer system." Ex. 1001, 1:64–2:14. The process of discovering such resources may utilize a "script program that will search for the particular resource in question." *Id.* at 7:45–62. The script program can be written in a "high-level interpretable language" and compiled prior to execution if it has not previously been compiled. *Id.* at 7:45–8:2.

Figure 8 of the '594 patent is reproduced below.

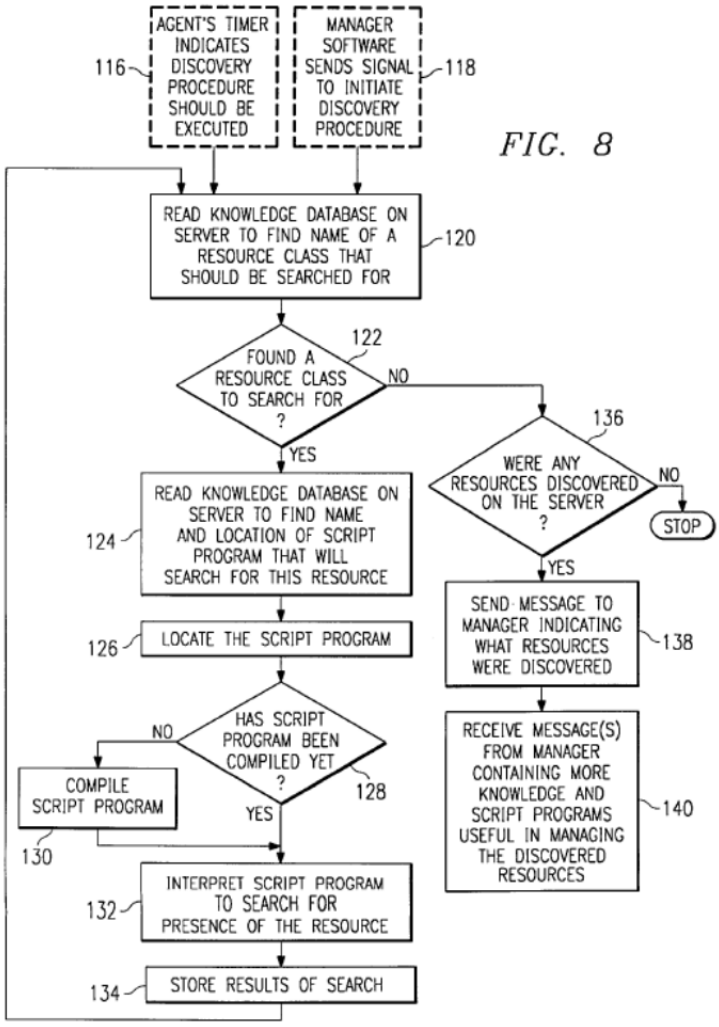

FIG. 8

Figure 8 illustrates an exemplary process flow for discovering resources on a computer system using a script program. *See id.* at 7:45–8:13.

The '594 patent issued on November 2, 1999, from an application filed March 6, 1997, and claims priority to a continuation application filed September 30, 1994. Ex. 1001, [11], [22], [63]. The '594 patent has expired. Pet. 13; Prelim. Resp. 12.

C. Claim 1

Claim 1 of the '594 patent recites:

> 1. A method of determining whether a resource is present on a computer system, comprising the steps of:
>
> (a) reading, from a storage device coupled to the computer system, discovery information about how to determine whether the resource is present on the computer system;
>
> (b) finding, on the storage device, instructions that are referred to in the discovery information, that are written in an interpretable high-level computer programming language, and that are stored on the storage device in their uninterpreted form;
>
> (c) interpreting the instructions for the purpose of collecting data for use in determining whether the resource is present on the computer system; and
>
> (d) determining, responsive to the collected data, whether the resource is present on the computer system.

Ex. 1001, 9:25–41.

D. The Prior Art

ServiceNow relies on the following prior art:

> U.S. Patent No. 5,410,681, which is a continuation of application 07/795,913 filed on Nov. 20, 1991, issued Apr. 25, 1995 (Ex. 1003, "Jessen");[1]
>
> Stephen Coffin, UNIX SYSTEM V, RELEASE 4: THE COMPLETE REFERENCE 45–74, 209–52 (1990) (Ex. 1004, "Coffin"); and
>
> Apple Computer, Inc., INSIDE MACINTOSH: FILES 2-14–15, 2-23–24, 2-31–32, 2-38–43 (1992) (Ex. 1005, "Inside Macintosh").

[1] Jessen is prior art under 35 U.S.C § 102(e). Pet. 3–4, 21–22.

E. The Asserted Ground

ServiceNow challenges claim 1 of the '594 patent under 35 U.S.C. § 103(a) over Jessen, Coffin, and Inside Macintosh. Pet. 3–4.

F. Claim Interpretation

The Board interprets claims of unexpired patents using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[]." 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015). For claims of an expired patent, however, the Board's claim interpretation analysis is similar to that of a district court. *See In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). Claim terms are given their plain and ordinary meaning as would be understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). "There are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution." *Thorner v. Sony Comput. Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). We apply this standard to the claims of the expired '594 patent.

ServiceNow identifies three terms for construction (i.e., "resource," "discovery information," and "uninterpreted form"), Pet. 13–20, and BMC provides responses to each of ServiceNow's proposed constructions. Prelim. Resp. 14–19. We find that, at this stage of the proceeding, we need only construe "resource." *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that

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