

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

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Case IPR2015-01176  
Patent 5,978,594

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**PETITIONER'S LIST OF PROPOSED MOTIONS**

Pursuant to the Patent Trial and Appeal Board instituting trial on November 16, 2015, and in advance of the initial conference call scheduled for December 18, 2015, Petitioner ServiceNow, Inc. hereby discloses the following regarding proposed motions in the above-captioned IPR proceeding:

Pursuant to 37 C.F.R. § 42.123(a), Petitioner requests authorization to file a motion to submit supplemental information with respect to the Coffin<sup>1</sup> and Inside Macintosh<sup>2</sup> prior art references submitted with the petition for *inter partes* review. The patent owner has objected to the admissibility of these references as, among other things, lacking authentication and containing hearsay, suggesting that the Petitioner's record evidence is insufficient to show that Coffin and Inside Macintosh qualify as prior art. The Petitioner believes that the patent owner's objections are without basis, but nevertheless, the Petitioner requests authorization to bring a motion to submit additional evidence that would remove any alleged evidentiary defect regarding the prior art status of these references. The supplemental information will include

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<sup>1</sup> Stephen Coffin, *UNIX System V, Release 4: The Complete Reference* (1990) ("Coffin") (Ex. 1004).

<sup>2</sup> *Inside Macintosh: Files*, Apple Computer, Inc. (1992) ("Inside Macintosh") (Ex. 1005).

date-stamped copies of excerpts of Coffin and Inside Macintosh as received by the Library of Congress and an accompanying declaration regarding how the Petitioner obtained those copies, as permitted by 37 C.F.R. § 42.63(a).

The supplemental information will be relevant to a claim for which the trial has been instituted because the ground on which the Board instituted trial includes the Coffin and Inside Macintosh references. (Paper 10 at 18.) The request is timely because it is being made within one month of the date the trial was instituted. The Board has previously authorized (and granted) motions to submit supplemental information under 37 C.F.R. § 42.123(a) to confirm the prior art status of references that serve as the basis of a ground of unpatentability on which trial has been instituted. *See, e.g., ServiceNow, Inc. v. Hewlett-Packard Company*, IPR2015-00523, Paper 21 at 3 (PTAB Aug. 31, 2015); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 2 (PTAB Feb. 5, 2014); *Valeo N. Am., Inc. v. Magna Elecs., Inc.*, IPR2014-01204, Paper 26 at 2-3 (PTAB Apr. 10, 2015); *Goertek, Inc. v. Knowles Elecs., LLC*, IPR2013-00614, Paper 25 at 2-3 (PTAB Apr. 8, 2014).

The Petitioner is aware of no other motions that it intends to file. The Petitioner notes that the Board has authorized motions to exclude evidence, motions for observations on cross-examination and motions to compel

discovery. The Petitioner reserves its right to seek permission to file these or additional motions as appropriate, based on the evidence or other materials presented by the patent owner in this proceeding.

Respectfully submitted,

Dated: December 16, 2015

/Heidi Keefe/

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**CERTIFICATE OF SERVICE**

I hereby certify, pursuant to 37 C.F.R. § 42.6, that a copy of the attached **PETITIONER'S LIST OF PROPOSED MOTIONS** is being electronically served on the 16th day of December 2015, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon counsel for the patent owner as follows:

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