

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SERVICENOW, INC.,
Petitioner

v.

BMC SOFTWARE, INC.,
Patent Owner

Case IPR2015-01211
Patent 7,617,073

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 Lewis¹ prior art reference submitted with the petition for *inter partes* review. The patent owner has objected to the admissibility of this reference as, among other things, lacking authentication and containing hearsay, suggesting that the Petitioner's record evidence is insufficient to show that Lewis qualifies 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 that reference. The supplemental information will include screenshots of web pages of the European Patent Office (Espacenet) regarding Lewis, a copy of Lewis

¹ International Patent Application Publication No. WO 00/72183 A2 to Lundy Lewis ("Lewis") (Ex. 1004).

retrieved from Espacenet via those web pages, and an accompanying declaration regarding those screenshots and the process of retrieving the copy of Lewis, 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 is based on the Lewis reference. (Paper 11 at 11.) 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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