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.
_____

Case IPR2015-01555
Patent 8,646,093 B2
_____

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

HUDALLA, *Administrative Patent Judge*.

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

Petitioner ServiceNow, Inc. ("ServiceNow") filed a Petition ("Pet.")

(Paper 1) to institute an *inter partes* review of claims 1, 5, 10–13, and 16 of

Patent 8,646,093 B2 ("the '093 patent") (Ex. 1001) pursuant to 35 U.S.C.

§§ 311–319. Patent Owner BMC Software, Inc. ("BMC") filed a

Preliminary Response ("Prelim. Resp.") (Paper 10) 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 have decided not to institute an *inter partes* review.

I. BACKGROUND

A.   *Related Proceedings*

The parties identify the following proceeding related to the '093 patent (Pet. 1; Paper 6, 1): *BMC Software, Inc. v. ServiceNow, Inc.,* Case No. 2:14-CV-00903 JRG (E.D. Tex. Sept. 23, 2014). The '093 patent is also the subject of a petition for covered business method review in CBM2015-00170.

B.   *The '093 Patent*

The '093 patent is directed to a software license system that "allows an enterprise to model software license contracts and evaluate deployment of software for compliance with the software license contracts." Ex. 1001, Abstract. Figure 2 of the '093 patent is reproduced below.
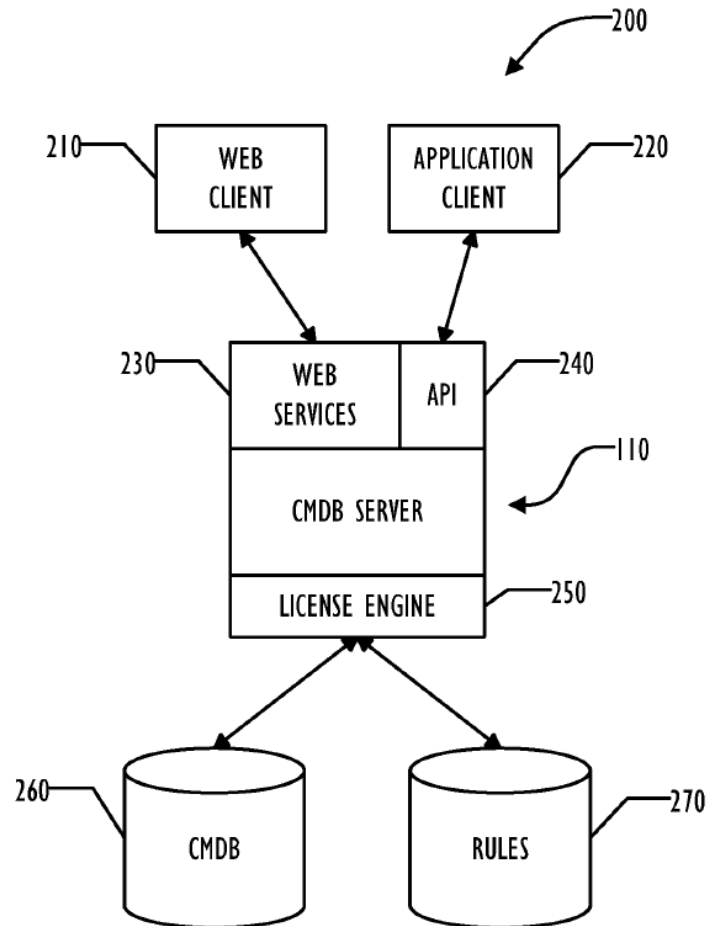
Figure 2 depicts system 200 having Configuration Management Database (CMDB) 260, which "contains data about managed resources known as Configuration Items (CIs)." *Id.* at 1:29–30. Information about the software contracts, which may include the information listed in Table 1 of the specification, may be stored as CIs in CMDB 260. *Id.* at 5:1–2, 9–55 (Table 1).

License datastore 270, which may be separate from or a part of CMDB 260, provides storage for license certificates "to model software contracts, including rules against which the CIs are evaluated for software license compliance and other information necessary for processing those rules." *Id.* at 4:11–17, 9:37–40. "A license certificate indicates the right to deploy software in the environment managed by the CMDB server 110," and

an exemplary license certificate may include the information listed in Table 3 of the specification. *Id.* at 8:61–63, 9:1–20 (Table 3).

C.   *Claim 1*

Claim 1 of the '093 patent recites:

1.   A computer-implemented method, comprising:

modeling deployment of a software product and a software license contract for the software product;

storing a first model of the modeled deployment of the software product in a configuration management database (CMDB) by storing information related to the software product as a first configuration item in the CMDB and by storing information related to the software license contract as a second configuration item in the CMDB;

storing a second model of the modeled software license contract for the software product in a license database by generating a license certificate corresponding to the software license contract and storing the license certificate in the license database; and

evaluating the deployment of the software product for compliance with the software license contract, comprising:

connecting and comparing the first model and the second model by comparing the first configuration item with the license certificate and connecting the license certificate with the second configuration item responsive to comparing the first configuration item with the license certificate; and

generating an exception indication if the act of comparing the first model and the second model indicates non-compliance with the software license contract.

D.   *The Prior Art*

ServiceNow relies on the following prior art:

U.S. Patent No. 6,810,389 B1 to Meyer, filed Nov. 8, 2000, issued Oct. 26, 2004 (Ex. 1003, "Meyer");

Excerpts from United Kingdom Office of Government Commerce, BEST PRACTICE FOR SOFTWARE ASSET MANAGEMENT, IT Infrastructure Library (ITIL) (2003) (Ex. 1004, "Best Practice");

Excerpts from Rob Addy, EFFECTIVE IT SERVICE MANAGEMENT, TO ITIL AND BEYOND! (2007) (Ex. 1005, "Addy"); and

U.S. Patent Application Publication No. 2005/0071276 A1 to Bruchlos, filed June 24, 2004, published Mar. 31, 2005 (Ex. 1006, "Bruchlos").

E.   *The Asserted Grounds*

ServiceNow challenges claims 1, 5, 10–13, and 16 of the '093 patent

on the following grounds (Pet. 4):

References	Basis	Claims Challenged
Meyer, Best Practice, Addy	35 U.S.C. § 103(a)	1, 5, 10, 16
Meyer, Best Practice, Addy, Bruchlos	35 U.S.C. § 103(a)	11–13

F.   *Claim Interpretation*

In an *inter partes* review, we construe claims by applying the broadest

reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b);

see In re Cuozzo Speed Techs., LLC, 793 F.3d 1268, 1275–78 (Fed. Cir.

2015). Under the broadest reasonable interpretation standard, and absent

any special definitions, claim terms are given their ordinary and customary

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