

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SERVICENOW, INC.,
Petitioner,

v.

BMC SOFTWARE, INC.,
Patent Owner.

Case CBM2015-00170
Patent 8,646,093 B2

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

HUDALLA, *Administrative Patent Judge*.

DECISION

Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

Petitioner's Motion for *Pro Hac Vice* Admission
37 C.F.R. § 42.10

Petitioner ServiceNow, Inc. ("ServiceNow") filed a Petition ("Pet.") (Paper 1) requesting covered business method patent review of claims 1, 5, 10–13, and 16 of U.S. Patent No. 8,646,093 B2 ("the '093 patent") (Ex. 1001) pursuant to 35 U.S.C. §§ 321–329. Patent Owner BMC Software, Inc.

(“BMC”) filed a Preliminary Response (“Prelim. Resp.”) (Paper 8) to the Petition. We have jurisdiction under 35 U.S.C. § 324.

Pursuant to 35 U.S.C. § 324(a), the Director may not authorize a covered business method patent review unless the information in the petition, if unrebutted, “would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” For the reasons that follow, we institute a covered business method patent review as to claims 1, 5, 10–13, and 16 of the ’093 patent.

I. BACKGROUND

A. *Related Proceedings*

The parties identify the following proceeding related to the ’093 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). The ’093 patent was also the subject of a petition for *inter partes* review in IPR2015-01555. *See* Pet. 1; Paper 5, 1. In that case, the Board denied institution of an *inter partes* review in a Decision dated January 14, 2016.

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.

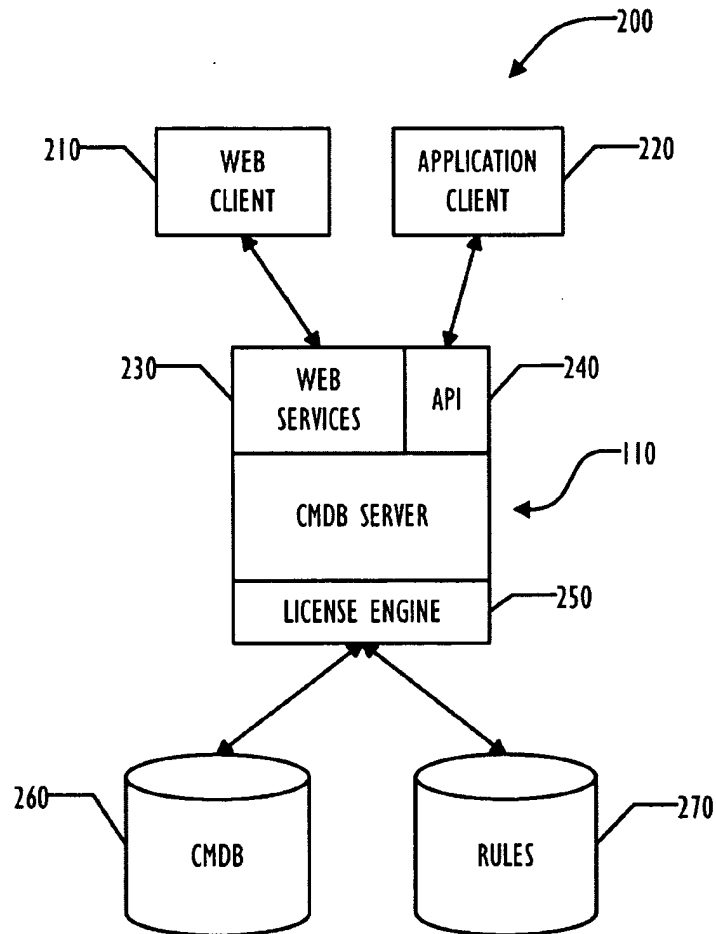


Figure 2 depicts system 200 having Configuration Management Database (CMDB) 260, which “contains data about managed resources known as Configuration Items (CIs).” *Id.* at 1:29–30. Information about the software contracts, which may include the information listed in Table 1 of the specification, may 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. Exhibit Description

ServiceNow relies on, *inter alia*, the following declaration and references in support of its ground of unpatentability:

Declaration of Tal Lavian, Ph.D. (Ex. 1002);

Excerpts from United Kingdom Office of Government Commerce, BEST PRACTICE FOR SOFTWARE ASSET MANAGEMENT, IT Infrastructure Library (ITIL) (2003) (Ex. 1003, “Best Practice”);¹

Excerpts from United Kingdom Office of Government Commerce, INTRODUCTION TO ITIL, IT Infrastructure Library (ITIL) (2005) (Ex. 1004, “Introduction to ITIL”); and

Microsoft Corporation, A GUIDE TO SOFTWARE ASSET MANAGEMENT (2004) (Ex. 1005, “Microsoft Guide”).

E. The Asserted Ground

ServiceNow challenges claims 1, 5, 10–13, and 16 of the ’093 patent as unpatentable under 35 U.S.C. § 101. Pet. 18.

F. Claim Interpretation

In a covered business method patent review, we construe claims by applying the broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.300(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) (“Trial Practice Guide”). Under the broadest reasonable interpretation standard, and absent any special definitions, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the

¹ When citing to non-patent references, we refer to the page numbers ServiceNow added to the bottom center of each page. *See* 37 C.F.R. § 42.63(d)(2).

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