

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SERVICENOW, INC.,
Petitioner,

v.

HEWLETT-PACKARD, CO.,
Patent Owner.

Case CBM2015-00108
Patent 7,945,860 B2

Before RAMA G. ELLURU, JAMES B. ARPIN, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

ServiceNow, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking a covered business method patent review of claims 1, 5, 7–10, 12, 15, and 24–26 of Patent No. US 7,945,860 B2 (Ex. 1001, “the ’860 patent”). Pet. 1. Hewlett-Packard Company (“Patent Owner”), filed a Patent Owner’s Preliminary Response. Paper 9 (“Prelim. Resp.”). Pursuant to 35 U.S.C. § 324(a), we may not institute a covered business method review “unless the Director^[1] determines that the information presented in the petition . . . , if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.”

The question of whether any of the challenged claims of ’860 patent is eligible for covered business method patent review is dispositive to this initial proceeding. Upon consideration of the Petition, Preliminary Response, and the evidence of record, we decline to institute a covered business method patent review as to any of claims 1, 5, 7–10, 12, 15, and 24–26 of the ’860 patent.

A. *Related Matters*

Petitioner was sued for infringement of the ’860 patent by Patent Owner: *Hewlett-Packard Co. v. ServiceNow, Inc.*, Case No. 14-CV-00570BLF (N.D. Cal. filed Feb. 6, 2014). Pet. 1; Paper 5, 2. Petitioner filed a petition seeking *inter partes* review of the ’860 patent (IPR2015-00716), which was *denied*, and petitioned seeking review of several of Patent Owner’s other patents – Patent Nos. US 6,321,229 B1 (IPR2015-00523); US

¹ “The Board institutes the trial on behalf of the Director.” 37 C.F.R. § 42.4(a).

7,392,300 B2 (IPR2015-00631); US 7610,512 B2 (IPR2015-00699); US 7,890,802 B2 (IPR2015-00702); and US 7,925,981 B2 (IPR2015-00707 and CBM2015-00077).

B. The '860 Patent

1. Background

The '860 patent, entitled “Systems and Methods for Managing Conversations Between Information Technology Resources,” relates to a web service management system for monitoring a “conversation.” Ex. 1001, col. 3, ll. 24–67. The Specification defines a “conversation” as “a set of related messages sent and received by a particular conversation.” *Id.* at col. 4, ll. 45–48. Figure 1A, depicting an embodiment of a conversation management system, is reproduced below:

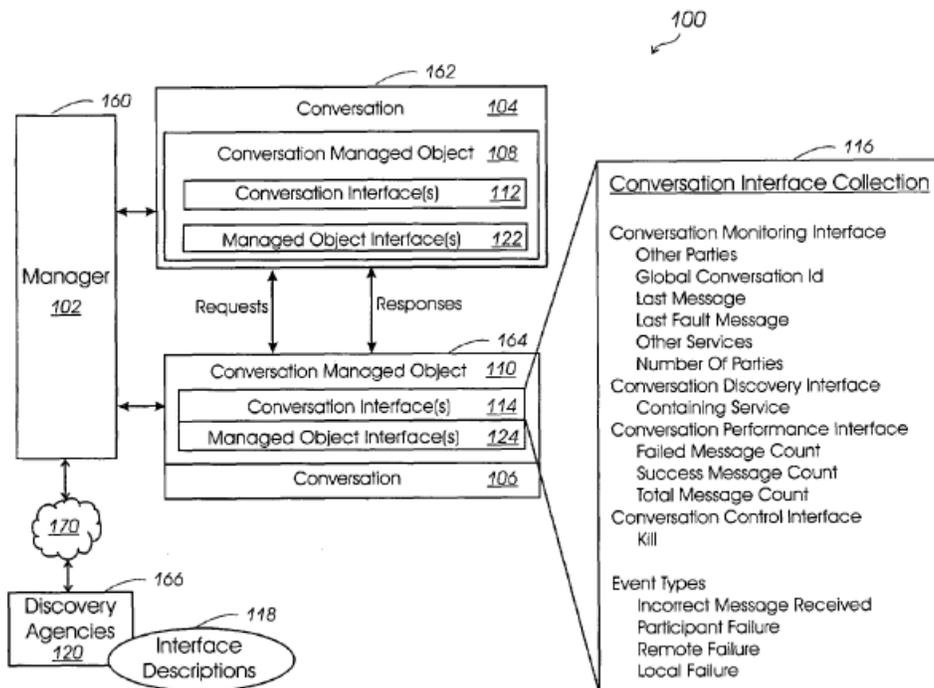


FIG. 1A

Id. at Fig. 1A.

In Figure 1A, management system 100 has conversation managed objects 108, 110 that have conversation interfaces 112, 114 for reporting management features of associated conversations 104, 106 to and receiving control instructions from manager 102. *Id.* at col. 4, ll. 23–40. In this embodiment, the Specification describes that:

Conversation managed objects 108, 110 represent the management features of resource(s) that conduct conversations 104, 106. Interfaces in one or more categories can be included in conversation interfaces 112, 114 for each conversation managed object 108, 110. Conversation interfaces 112, 114 allow manager 102 to access information regarding the state of messages related to corresponding conversations 104, 106.

Id. at col. 4, ll. 26–33 (emphases added).

Conversation managed objects “can each be considered managed objects 148.” *Id.* at col. 6, ll. 61–62. The Specification explains that a “[m]anaged object 148 implements managed object interfaces 150 to provide a common set of basic management capabilities to monitor and/or control the underlying resource(s) represented by managed object 148 through various features such as attributes, operations, and event notifications.” *Id.* at col. 6, ll. 63–67. Figure 1B, depicting an embodiment of a managed object interface collection for the conversation management system of Figure 1A, is reproduced below:

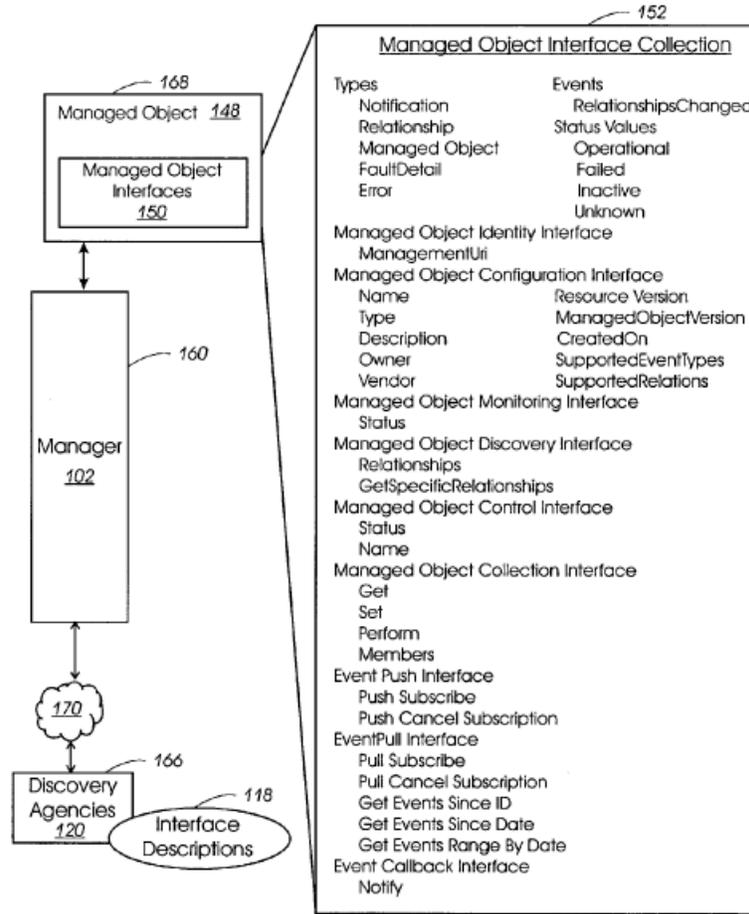


FIG. 1B

Id. at Fig. 1B. Figure 1B depicts Managed Object Interface Collection 152.

Managed Object Configuration Interface of Managed Object Interface Collection 152 includes Supported Relations, which is a read-only attribute that returns a list of the relations supported by managed object 148. *Id.* at col. 7, ll. 29–31. Relations in the returned list may be used in relationships managed object 148 has with other managed objects. “For example, managed object 148 can support relations such as Contains, Contained In, Depends On, Depended Upon, and Corresponds To.” *Id.* at col. 7, ll. 33–36. Thus, a conversation may “correspond to” one or more conversations

contained by the same or a different web service. *See id.* at col. 7, ll. 42–55. As depicted in Figure 1B, other features can be included in Managed Object Interface Collection 152.

The '860 patent discloses an additional “embodiment of an online shopping service system that can utilize the conversation management system of FIG. 1A.” *Id.* at col. 4, ll. 14–16. The Specification notes, that

FIG. 2 shows a diagram of components included in an embodiment of *an online shopping service system 200* that can utilize conversation management system 100 (FIG. 1A). A purchaser, referred to as client 202, accesses online ordering service 204 at online store 206 via a suitable interface through a network, typically using SOAP or other suitable messages. Online store 206 includes authentication service 208 and online ordering service 204. Online ordering service 204 accesses authentication service 208 and billing service 210. Billing service 210 is implemented by a third party in payment processor 212. Information regarding transactions, such as the amount to be charged and credit card charge authorizations, can be exchanged via conversations 214, 216 between online ordering service 204 and billing service 210. Manager 102 is configured to manage conversations 214, 216.

Id. at col. 9, ll. 26–41 (emphasis added). The Specification explains, however, that the described embodiments are illustrative and not limiting on the scope of the invention. *Id.* at col. 10, ll. 10–13.

2. *Illustrative Claim*

Petitioner challenges claims 1, 5, 7–10, 12, 15, and 24–26 of the '860 patent. Claims 1 and 24 are independent; each of claims 5, 7–10, 12, and 15 depends directly or indirectly from claim 1; and each of claims 25 and 26 depends directly or indirectly from claim 24. Claim 1 is directed to a system for a conversation in a Web service, and claim 24 is directed to a computer

program product tangibly embodied in a computer storage readable medium, comprising a service interface and a managed object interface. Claim 1 is illustrative of the claimed subject matter and is reproduced below:

1. A system for managing a conversation in a Web service, comprising:
 - a computer processor;
 - a conversation managed object executable on the computer processor, wherein:
 - the conversation managed object includes at least one interface configured to provide management information about the conversation to at least one manager; and
 - the at least one interface is configured to provide information regarding the Web service that contains the conversation.

Ex. 1001, col. 10, ll. 30–41 (claim 1).

C. The Asserted Grounds

Petitioner relies on the following references and declaration in support of its grounds of unpatentability:

Exhibit	Description
1002	Declaration of Tal Lavian Ph.D.
1004	Excerpts from Thomas Rizzo, PROGRAMMING MICROSOFT OUTLOOK AND MICROSOFT EXCHANGE, Microsoft Press 1999 (“Rizzo”)
1005	Excerpts from Scott Jamison <i>et al.</i> , DEVELOPING APPLICATIONS WITH EXCHANGE 2000, A PROGRAMMER’S REFERENCE, Addison-Wesley 2001 (“Jamison”)
1006	Excerpts from Jake Sturm, DEVELOPING XML SOLUTIONS, Microsoft Press 2000 (“Sturm”)

Pet. iv.

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 16, 31–77):

Claims	Grounds	References
1, 5, 7-10, 12, 15, and 24-26	35 U.S.C. § 101	NA
1, 5, 7-9, 12, 15, 24, and 25	35 U.S.C. § 103(a)	Rizzo and Jamison
10 and 26	35 U.S.C. § 103(a)	Rizzo, Jamison, and Sturm

For the reasons set forth below, we determine that, on this record, Petitioner fails to demonstrate that any challenged claim of the '860 patent is subject to covered business method patent review. Accordingly, we *deny* institution of covered business method patent review as to any of the challenged claims of the '860 patent.

II. ANALYSIS

Section 18 of the America Invents Act created a transitional program, limited to persons or their privies that have been sued or charged with infringement of a “covered business method patent,” which does not include patents for “technological inventions.” Leahy-Smith America Invents Act (“AIA”), §§ 18(a)(1)(B), 18(d)(1), Pub. L. No. 112-29, 125 Stat. 284, 329–331 (2011); *see* 37 C.F.R. § 42.302. A covered business method patent is one that “*claims* a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service.” AIA § 18(d)(1) (emphasis added); *see* 37 C.F.R. § 42.301(a). “In making this determination, our focus is firmly on the claims.” *Par Pharm., Inc. v. Jazz Pharms., Inc.*, Case CBM2014-00149, slip op. at 9 (PTAB Jan. 13, 2015) (Paper 12). The “legislative history explains that the definition of covered business method patent was drafted to encompass patents ‘*claiming* activities that are financial in nature, incidental to a financial activity or complementary to a

financial activity.” See Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention; Final Rule, 77 Fed. Reg. 48,734, 48,735 (Aug. 14, 2012) (quoting 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer) (emphasis added)). The focus is on what the patent *claims*, but a patent need only have one challenged claim directed to a covered business method to be eligible for review. *Id.*; see also *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1327 (Fed. Cir. 2015) (affirming a Board decision that used a single claim to determine eligibility for covered business method patent review).

Thus, analysis of whether a patent is a covered business method patent begins with the language of the challenged claims. The presence in the challenged claims of financial terminology, or a method step requiring the movement of money, weighs strongly in favor of a financial product or service. See *Apple, Inc. v. SightSound Techs., LLC*, Case CBM2013-00009, slip op. at 9–13 (PTAB Oct. 8, 2013) (Paper 17) (“transferring money electronically”); see also *FFF Enterprises, Inc. v. AmerisourceBergen Specialty Group, Inc.*, Case CBM2014-00154, slip op. at 7 (PTAB Jan. 29, 2015) (Paper 14) (“server system creates an invoice”).

Petitioner argues that claim 1 of the ’860 patent is eligible for covered business method patent review because it recites a system for monitoring conversations in a Web service, and “the specification explains that a ‘Web service’ can include any type of business or financial transaction.” Pet. 5–6 (citing Ex. 1001, Abstract, col. 1, ll. 36–40). Specifically, the Specification states that, “[f]or example, functions such as language translation or currency conversion, performing calculations for

medical claims processing, and handling certain aspects of travel planning *can be implemented in a Web service.*” Ex. 1001, col. 1, ll. 36–40 (emphases added). “Essentially any transaction or bit of business logic can become a Web service if it can be accessed and used by another system over a network such as the Internet.” *Id.* at col. 1, ll. 40–43. In sum, Petitioner contends that the claim recites “[a] system for managing a conversation in a Web service,” and the cited disclosure explains functions that *can be implemented in a Web service* – one step removed from the managed conversations. Pet. 6.

Petitioner directs our attention particularly to an illustrative embodiment in the Specification, depicted in Figure 2, which pertains to an online store. *Id.* at 6–9 (citing Ex. 1001, col. 9, ll. 26–46). In particular, referring to Figure 2, Petitioner asserts that “[i]nformation regarding transactions, such as the amount to be charged and credit card charge authorizations, *can be exchanged via conversations 214, 216* between online ordering service 204 and billing service 210.” *Id.* at 8 (quoting Ex. 1001, col. 9, ll. 36–39 (emphasis added)). Thus, Petitioner argues that “information” relating to a financial product or services can be exchanged in the managed conversations. *Id.* at 10–11.

According to Petitioner, “[t]he limitations [of claim 1] are directly reflected in the online ordering system described in the specification.” Pet. 6. Referring to Figures 2 and 3, Petitioner asserts that these figures read on the limitations of claim 1. *Id.* at 6–10. Thus, based on these disclosures, Petitioner argues that “[a]ll of [the challenged] claims therefore encompass management of a financial product or service, and claim activities that are incidental or complementary to a financial activity.” *Id.* at 11.

Petitioner notes that, “[i]n determining whether a patent qualifies as a ‘covered business method patent’ under the AIA, the Board has looked to the specification to determine whether it discloses use of the claimed invention for the practice, administration, or management of financial services.” *Id.* (citing *Salesforce.com v. VirtualAgility, Inc.*, Case CBM2013-0024, slip op. at 9 (PTAB Sept. 16, 2014) (Paper 47)). Statements in the specification that a claimed invention has particular utility in financial applications may weigh in favor of determining that a patent is eligible for a covered business method patent review. *See Salesforce.com*, Case CBM2013-0024, Paper 47, slip op. at 7–9; *see also CRS Advanced Techs., Inc. v. Frontline Techs., Inc.*, Case CBM2012-00005, slip op. at 8 (PTAB Jan. 23, 2013) (Paper 17) (noting a preferred embodiment directed to a “Substitute Teller Fulfillment System” that fulfills the temporary employment requirements of a “retail bank”). We note that other panels also have considered evidence of the problem addressed (*Sony Computer Ent. Am. LLC v. ADC Tech. Inc.*, Case CBM2015-00026, slip op. at 12 (PTAB July 3, 2015) (Paper 10)) and the parties against whom the patent is asserted (*PNC Bank, N.A. v. Secure Access, LLC*, Case CBM 2014-00100, slip op. at 11 (PTAB Sept. 8, 2015) (Paper 43); *cf. PNC Financial Services Group, Inc. v. Intellectual Ventures I LLC*, Case CBM2014-00032, slip op. at 14 (PTAB May 22, 2014) (Paper 13)). While each of these decisions identifies factors that a panel may weigh in reaching its eligibility decision, we are not in any way bound by the factors considered in these cited decisions, and we determine eligibility based on the arguments and evidence regarding the challenged claims of the patent before us.

Patent Owner disagrees that the challenged claims of the '860 patent are eligible for covered business method patent review, contending that covered business method patent review “is not available for patents that claim generally useful technologies that happen to be also useful to financial applications.” Prelim. Resp. 16 (citing *J.P. Morgan Chase v. Intellectual Ventures II LLC*, CBM2014-00160, slip op. at 6–9 (PTAB Jan. 29, 2015) (Paper 11)); *see also* Pet. 11–12 (anticipating this contention). Initially, Patent Owner argues that none of the challenged claims of the '860 patent “contains a single limitation that is financial in nature”; thus, the claims “are directed to generally useful technologies that may be applied to various industries and processes.” Prelim. Resp. 17–18. According to Patent Owner, there is no term in any of the challenged claims “that has any arguable, particular relationship to financial products or services, and there is no reasonable claim construction under which these claims could be interpreted as financial in nature – indeed, *not even Petitioner* proposes any claim construction that is financial in nature.” *Id.* at 18 (citing Pet. 22–31); *cf.* Prelim. Resp. 10–15. Considering the language of the challenged claims and parties’ proposed claim constructions, we agree.

Patent Owner contends that Petitioner ignores the general nature of the claims, instead improperly focusing on illustrative embodiments set forth in the Specification, whose financial aspects are not recited expressly in the claims. Prelim. Resp. 19–20; *see* Pet. 11–12. First, Patent Owner contends that the proper focus for the determination of eligibility for covered business method patent review is the claims, not the Specification, and that the Specification only is relevant to the extent that limitations of the claims are interpreted in the context of the Specification. Prelim. Resp. 19–20; *see*

Salesforce.com, Inc. v. Applications in Internet Time LLC, CBM2014-00162, slip op. 10 (PTAB Feb. 2, 2015) (Paper 11) (“Petitioner’s contentions based on the written description alone do not show that the ’111 patent *claims* a method or apparatus ‘for performing data processing or other operations used in the practice, administration, or management of a financial product or service’ or *claims* an activity that is ‘financial in nature, incidental to a financial activity or complementary to a financial activity.’”); *see also Symphony Health Solutions Corp. v. IMS Health Inc.*, Case CBM2015-00085, slip op. at 10–11 (PTAB Sept. 10, 2015) (Paper 7) (“[E]ach claim recites a ‘health care field’ relating to ‘health care data,’ which is described in the specification as including claims data, such as pharmaceutical, medical and hospital claims data, i.e., claims for receiving payment or reimbursement.”).

Second, Patent Owner contends that, although the Specification teaches that the recited systems and computer program products may be used in connection with activities involving financial products and services, that teaching is insufficient to show eligibility for covered business method patent review. Prelim. Resp. 21. As Patent Owner correctly notes, finding that anything with a possible use with respect to activities involving financial products and services would capture claimed inventions only tangentially related to activities involving financial products and services. *Id.* (citing *Sony Corp. of Am. v. Network-1 Techs., Inc.*, Case CBM2015-00078, slip op. at 11–12 (PTAB July 1, 2015) (Paper 7) (Ex. 2003)). As the Office has stated, the legislative history of the AIA indicates that “financial product or service” should be interpreted “broadly,” but “broadly” does not

mean “without limits.” *See* Transitional Program for Covered Business Method Patents, 77 Fed. Reg. at 48,736.

Third, Patent Owner contends that “the specification makes clear that the invention is generally directed to *managing* systems implemented using Web services, as opposed to performing any particular financial transaction.” Prelim. Resp. 22. The claims have broad application in fields—such as translation and travel planning—which are non-financial. *Id.* Moreover, even in the financial embodiments cited by Petitioner, Patent Owner contends, the relevance of the claims is to systems or computer program products “for *managing* a conversation in a Web service,” where the “information” that is the subject of the conversation can involve financial products or services, as opposed to the systems or computer program products performing any particular financial transaction. *Id.*; *see* Pet. 11 (citing Ex. 1001, col. 9, ll. 36–39).

We agree with Patent Owner that Petitioner has not established that the ’860 patent expressly claims systems or computer program products for performing data processing or other operations used in the practice, administration, or management of a financial product or service. Moreover, we note the similarity of this case to another Petition filed by Petitioner, in which another panel recently denied institution of review because it had not been established that challenged claims of the patent at issue therein were eligible for covered business method patent review. *ServiceNow, Inc. v. BMC Software, Inc.*, Case CBM2015-00107, slip op. at 10–15 (PTAB Sept. 11, 2015) (Paper 12) (“*ServiceNow ’107*”). Although not binding authority, we find that panel’s reasoning persuasive and adopt it herein. *See ServiceNow, Inc. v. Hewlett-Packard Co.*, Case CBM2015-00077, slip op. at

8 (PTAB Sept. 17, 2015) (Paper 12) (also adopting the reasoning of *ServiceNow '107*).

In *ServiceNow '107*, the panel noted that the claims at issue were directed to a method for fault analysis, and did not recite any step that involved a financial activity. *ServiceNow '107* at 10. While the specification of the patent at issue provided a single illustrative embodiment directed to the use of the claimed method in an automatic teller machine (“ATM”) network, and Petitioner explained how the claims encompassed that embodiment, the panel found the claims were “of general applicability for fault analysis.” *Id.* at 11. The panel also found instructive that the problem addressed by the patent was non-financial in nature, and that a significant portion of the specification described the claimed method in general terms, before turning to the illustrative ATM network embodiment. *Id.* at 11–12. With respect to the ATM network embodiment, the panel stated that “[n]otably, the Specification does not attribute any significance to the choice of an ATM network as the illustrative enterprise.” *Id.* at 13.

We are presented with a similar set of facts in the instant case. The challenged claims of the '860 patent are directed to systems or computer program products for managing a conversation in a Web service, and contain no finance-related terminology or limitations. *Cf. MaxMind, Inc. v. Fraud Control Systems.com Corp.*, Case CBM2015-00094, slip op. at 5–6 (PTAB Sept. 11, 2015) (Paper 7) (claim reciting method for “computerized fraud control” including the step of receiving a “transaction request”); *Square, Inc. v. Unwired Planet, LLC*, Case CBM 2014-00156, slip op. at 9–10 (PTAB Dec. 24, 2014) (Paper 11) (claim reciting method “for controlling

transactions” including the step of “charging the correlated transaction amount to a source of funds”).

We agree with Patent Owner that the claims are of general utility. The Specification of the ’860 patent supports this conclusion, stating that Web services may be used to implement language translation or travel planning functions, as well as financial functions. Ex. 1001, col. 1, ll. 36–40. The purpose of the invention is to detect problems with conversations generally and is not limited to financial or service problems. *See, e.g.*, Ex. 1001, Abstract. As in *ServiceNow ’107*, a considerable portion of the Specification of the ’860 patent is devoted to a general description of the claimed conversation management system and computer program, without reference to the particular application to financial activities. *Id.* at col. 4, l. 23–col. 9, l. 25. The clear implication is that the ’860 patent is directed to solving a problem of general applicability.

Although we acknowledge the inclusion in the Specification of at least one illustrative embodiment directed to applications of the claimed system in financial systems (*see* Ex. 1001, Fig. 2 (describing online shopping)), we agree with the *ServiceNow ’107* panel’s reasoning that such examples are insufficient to make the challenged claims of the ’860 patent eligible for covered business method patent review. First, we are not persuaded that the Specification indicates that the selection of these financial applications has any special significance. Second, the Specification expressly states that “these embodiments are illustrative and . . . the scope of the invention is not limited to them.” *Id.* at col. 10, ll. 10–13.

Finally, we agree with the *ServiceNow ’107* panel that it is insufficient simply to show how the claims may be mapped to a financial embodiment in

the specification, as Petitioner does in its Petition. Pet. 9–10 (chart mapping challenged claim 1 to Figs. 2 and 3). At most, this shows that the claimed system *could* be used in a financial product or service; another panel has held recently that this is insufficient to confer covered business method review eligibility. *See Sony*, Case CBM2015-00078, Paper 7, slip op. at 11–12. Congress defined a covered business method patent as one that claims “a method or corresponding apparatus for performing data processing or other operations *used* in the practice, administration, or management of a financial product or service,” not a method or apparatus that “can be used,” “may be used,” or “is capable of being used” in such a manner. AIA § 18(d)(1) (emphasis added). As the panel explained in *Sony*:

[T]he fact that [the claimed] devices *may* have uses . . . pertaining to banking, does not mean that claim 23 ‘covers’ such activities. Petitioner’s position, in essence, would mean that any patent claiming something that can be used in connection with a financial service (e.g., an Ethernet cable, a generic computer monitor, or even a ballpoint pen) would be eligible for covered business method patent review, regardless of what the patent claims.

Id. (emphasis added); *see* Prelim. Resp. 21.

The primary justification for covered business method review eligibility provided by Petitioner is that the illustrative embodiments in the Specification of the ’860 patent show that the invention *may* be used in a financial system. Financially-related, illustrative embodiments in the specification of the patent at issue may be sufficient in cases where the specification indicates particular advantages or applicability to financial embodiments, where the specification makes clear that claim limitations are interpreted expressly to cover financial embodiments, or where there is an absence of evidence that the claimed invention has general utility. The

present case, however, presents us with none of these supporting facts. The facts before us, as outlined above, establish that the claimed systems and computer program products are of general utility, and this weighs heavily in favor of finding the challenged claims of the '860 patent not eligible for covered business method patent review. As in *ServiceNow '107* and for the reasons set forth above, “the absence of any finance-related limitation in the claims is the primary driver of our determination,” and is supported by the general nature of the problem addressed and the illustrative nature of the embodiments. *ServiceNow '107* at 15.

III. CONCLUSION

The petitioner in a CBM proceeding must demonstrate that the patent for which review is sought is a covered business method patent. *See* 37 C.F.R. § 42.304(a). Here, we are not persuaded that Petitioner has established that the '860 patent “*claims* a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service” and that any of the challenged claims is eligible for covered business method patent review under Section 18 of the AIA. Therefore, we *deny* the Petition on all asserted grounds.

IV. ORDER

For the reasons given, it is

ORDERED that the Petition is *denied*, and no covered business method patent review is instituted.

CBM2015-00108
Patent 7,945,860 B2

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