

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SERVICENOW, INC.,
Petitioner,

v.

BMC SOFTWARE, INC.,
Patent Owner.

Case IPR2015-01176 (Patent 5,978,594)
Case IPR2015-01211 (Patent 7,617,073 B2)¹

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

HUDALLA, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This Order pertains to both of these cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2015-01176 (Patent 5,978,594)
IPR2015-01211 (Patent 7,617,073 B2)

On December 22, 2015, a conference call was conducted between respective counsel for the parties and Judges Arbes, Murphy, and Hudalla. Petitioner, ServiceNow, Inc., was represented by Heidi L. Keefe, Phillip E. Morton, and Andrew C. Mace. Patent Owner, BMC Software, Inc., was represented by Pierre Hubert and Phillip Lee. This call dealt with three topics: (a) the scheduling order, (b) ServiceNow’s requests for authorization to file motions to submit supplemental information in both of the instant cases, and (c) BMC’s proposed motions.

A. Scheduling Order

The parties indicated there are no problems with the Scheduling Order in these cases and that each party’s lead counsel will be available on the scheduled date for Oral Argument, August 19, 2016. Case IPR2015-01176, Paper 11; Case IPR2015-01211, Paper 12. The parties were reminded that they are free to stipulate to different dates for Due Dates 1–5, but not for Due Dates 6–7, as provided in the Scheduling Order. Any such stipulation must be filed with the Board.

B. ServiceNow’s Requests for Authorization to File Motions to Submit Supplemental Information

Pursuant to 37 C.F.R. § 42.123(a), ServiceNow seeks authorization to file motions to submit supplemental information related to certain prior art references in these cases:

Case IPR2015-01176	“Coffin”/“Unix System V”	Ex. 1004
Case IPR2015-01176	“Inside Macintosh”	Ex. 1005
Case IPR2015-01211	“Lewis”	Ex. 1004

IPR2015-01176 (Patent 5,978,594)
IPR2015-01211 (Patent 7,617,073 B2)

Case IPR2015-01176, Paper 14, 2; Case IPR2015-01211, Paper 15, 2. BMC has objected to these references as lacking authentication and containing hearsay, among other things. Case IPR2015-01176, Paper 12 § B; Case IPR2015-01211, Paper 13 § C. By its proposed motions, ServiceNow intends “to submit additional evidence that would remove any alleged evidentiary defect regarding the prior art status of these references.” Case IPR2015-01176, Paper 14, 1; Case IPR2015-01211, Paper 15, 2.

Counsel for ServiceNow indicated that ServiceNow has served, as supplemental evidence, much of the same evidence it now seeks to submit via its proposed motion. ServiceNow also intends to serve the remaining evidence (pertaining to the Lewis reference) that would be the subject of the motion within the next several days.

The Board has previously explained the difference between supplemental evidence under 37 C.F.R. § 42.64(b)(2) and supplemental information under 37 C.F.R. § 42.123(a):

[S]upplemental *evidence*—served in response to an evidentiary objection and filed in response to a motion to exclude—is offered solely to support admissibility of the originally filed evidence and to defeat a motion to exclude that evidence, and not to support any argument on the merits (i.e., regarding the patentability or unpatentability of a claim). Supplemental *information*, on the other hand, is evidence a party intends to support an argument on the merits.

Handi Quilter, Inc. v. Bernina Int’l AG, Case IPR2013-00364, slip op. at 2–3 (PTAB Jun. 12, 2014) (Paper 30) (emphasis in original). We find that the evidence identified and described by ServiceNow as the subject of ServiceNow’s proposed motions is more properly considered supplemental evidence under 37 C.F.R. § 42.64(b)(2), because ServiceNow intends to use it to attempt to cure BMC’s authenticity and hearsay objections and support

IPR2015-01176 (Patent 5,978,594)
IPR2015-01211 (Patent 7,617,073 B2)

the admissibility of the underlying exhibits. Indeed, counsel for BMC indicated that BMC's objections to these exhibits were limited to issues of admissibility. Moreover, counsel for ServiceNow did not articulate any bases beyond admissibility to justify its proposed motions to submit supplemental information. Accordingly, as stated during the call, we do not authorize ServiceNow to file motions to submit supplemental information under 37 C.F.R. § 42.123(a).

Counsel for ServiceNow indicated that it did not intend to file any other motions at this time.

C. BMC's Proposed Motions

BMC has indicated that it may file the following motions: (1) a motion to seal; (2) a motion for observations on cross-examination; (3) a motion for admission *pro hac vice*; and (4) a motion to seal. Case IPR2015-01176, Paper 13, 1–2; Case IPR2015-01211, Paper 14, 1–2. All of these motions are pre-authorized under our rules. Counsel for BMC indicated that it does not intend to file any other motions at this time.

Accordingly, it is

ORDERED that Petitioner's requests for authorization to file motions to submit supplemental information are *denied*.

IPR2015-01176 (Patent 5,978,594)
IPR2015-01211 (Patent 7,617,073 B2)

PETITIONER:

Heidi L. Keefe
Andrew C. Mace
Phillip E. Morton
Mark R. Weinstein
COOLEY LLP
hkeefe@cooley.com
amace@cooley.com
pmorton@cooley.com
mweinstein@cooley.com

PATENT OWNER:

Robert Cote
Pierre Hubert
Robert Auchter
Kevin Schubert
Phillip Lee
McKOOL SMITH, P.C.
rcote@mckoolsmith.com
phubert@mckoolsmith.com
rauchter@mckoolsmith.com
kschubert@mckoolsmith.com
plee@mckoolsmith.com