IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SERVICENOW, INCORPORATED,

Petitioner,

v.

INQUISIENT INCORPORATED

Patent Owner.

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Case No. IPR2023-01073

U.S. Patent No. 8,224,855

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PETITIONER'S PRELIMINARY REPLY

The POPR argues that the Board should grant the extraordinary relief of discretionary denial because Petitioner proposed—for purposes of the Petition—using PO's own definition of the term "module" (which only appears in one of three challenged independent claims). PO argues that in doing so, Petitioner has failed to set forth "how the challenged claim is to be construed," as required by 37 C.F.R. § 42.104(b)(3). This argument, however, ignores the weight of Board precedent and mischaracterizes PO's own litigation position. Simply put, the Board has held on numerous occasions that proffering PO's litigation construction without expressing a subjective belief in its correctness fully complies with § 42.104 and is not grounds for denial. Indeed, the Board has even found it proper for a Petitioner to propose a construction it believes is wrong. *See, e.g.*, *Lewis Machine & Tool Co. v. WHG Properties, LLC*, IPR2020-00373, Paper 6 (refusing to deny under § 42.104(b)(3) when Petitioner applied PO's construction that Petitioner believed was incorrect).

I. SUMMARY OF FACTS

Months before the Petition was filed in this case, on December 20, 2022, the District Court held a hearing on Petitioner's Motion to Dismiss under Section 101 ("101 Hearing"). In response to the Court's questioning as to whether the claimed "modules" have any specific structural improvements, or are merely abstract ideas that use a computer as a tool (*see Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016)), PO's counsel stated that the claim terms have "particular

structures," because, for example, the claimed "module" is "a table or a portion of a table." Ex. 1013 at 78. On June 5, 2023, a few weeks before the Petition was filed, the parties submitted a Joint Claim Construction Chart in the District Court case. Ex. 1011. PO proposed in that submission that "module" be given its "Plain and Ordinary Meaning," and did not specify what that "ordinary meaning" was. Ex. 1011 at 2. Petitioner at that time proposed that "module" be construed as "[a] table or, one or more columns of/within a single table." *Id.*

The Petition thus applied "[PO]'s own definition of 'module' throughout," which is "a table or a portion of a table," *i.e.* "module" includes database structures. Paper 6 at 3.[1] Contrary to PO's assertion, PO's statement at the hearing clearly intended to define the scope of "module." Petitioner therefore is not "incorrect." Paper 7 at 17. Instead, ***after*** Petitioner filed its Petition, Patent Owner abandoned its 101 Hearing position, arguing in its claim construction briefing (and here) that a

[1] PO also criticizes Petitioner for applying a construction of "module" that is directed to traditional object-oriented databases structures, as opposed to "relational databases." *See, e.g.*, Paper 7 at 2, 5. PO is simply wrong; PO's Section 101 "module" construction, applied throughout the Petition, is not directed to object oriented database structures. Accordingly, the Petition consistently points to relational database structures for the claimed modules.

"module" is "a table or, one or more columns of/within one or more tables." *Id.* Under either PO's 101 Hearing construction or its post-filing construction, the prior art nevertheless renders the claims unpatentable, thus Petitioner does not dispute either construction for purposes of this Petition. But PO is legally wrong to suggest the Petitioner is deficient for applying PO's own construction.

II. ANALYSIS

PO argues—incorrectly—that "[i]f the Petition asserts unpatentability solely under a construction that Petitioner believes is incorrect, then the Petition is deficient and it should not be instituted." Paper 7 at 18.[2] PO's position is wrong as a matter of law. The Board has found time and again that a Petition may rely on a PO's construction, ***even if*** Petitioner believes it is incorrect. For example, in *Western Digital Corp. v. SPEX Techs., Inc.*, IPR2018-00082, Paper 11 at 12 (Apr. 25, 2018), the Board held that "37 C.F.R. § 42.104(b)(3) does not require Petitioner to express its subjective agreement regarding correctness of its proffered claim constructions or to take ownership of those constructions" and that ***an explicit statement relying***

[2] As an initial matter, though PO fails to mention it, the term "module" only appears in one of the three independent claims of the '855 patent. It would therefore be improper to deny the entire Petition based on arguments that apply only to part of it. *See SAS Institute*.

on PO's litigation constructions "suffices to identify claim constructions Petitioner is adopting for purposes of the requested review in compliance with § 104(b)(3)."

In *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00921, Paper 13 at 42-44 (Aug. 5, 2021), the Board recognized that "[n]umerous decisions have held that [Section 42.104(b)(3)] does not require a petitioner to express a subjective belief in the correctness of its proffered claim constructions." Indeed, the Board expressly held that ***Petitioner can "rely[] on claim constructions that it believes are incorrect***." *Id.* (citing *Lewis* at 33-34). Many other cases, all of which PO fails to address, reiterate this well-accepted position. *See, e.g., 10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00086, Paper 8 at 17–22 (Apr. 27, 2020); *Google LLC v. AGIS Software Development, LLC*, IPR2018-01085, Paper 10 at 10 (Nov. 19, 2018); *General Electric Co. v. Vestas Wind Sys. A/S*, IPR2018-00928, Paper 9 at 12–17 (Nov. 5, 2018); *Apple, Inc. v. AGIS Software Development, LLC*, IPR2018-00821, Paper 9 at 10 (PTAB Oct. 23, 2018).

PO relies on a single case from the last 4 years, but that case is inapposite. Paper 7 at 20 (quoting IPR2020-01184, Paper 11 at 27 (Jan. 5, 2021) ("*Samsung*")). The *Samsung* Board denied institution under *Fintiv*, not § 42.104(b)(3). In holding that *Fintiv* Factor 6 did not outweigh the other factors supporting denial, the Board evaluated the ***merits*** of the Petition, pointing out flaws in Petitioner's proffered construction (which PO disputed), including its inconsistency with Petitioner's

litigation construction. *Samsung* at 24-27. *Samsung* did not hold that Petitioner's inconsistency warranted denial under § 42.104(b)(3). In this proceeding, the parties do not disagree on the construction of "module" and so there is no claim construction dispute that would affect the merits of the Petition.

PO's remaining cases are likewise distinguishable. As *SPEX* explained, *Toyota* and *Carefusion* are distinguishable because the Petitioner "impermissibly argued indefiniteness of a means-plus-function element." *SPEX* at 12. Moreover, *CareFusion* was denied on the merits, not § 42.104(b)(3). *CareFusion* at 18-19.

In IPR2018-01546 ("*K2M*"), Petitioner argued in the District Court that "grasping members" was subject to § 112, ¶6 and provided corresponding structure, but took the opposite position in its Petition. *K2M* at 11-12. The Board admonished Petitioner for not "address[ing] substantively the District Court's claim construction of a limitation when construction of that limitation is likely to be a focal point." *Id.* Here, no MPF limitations are involved, claim construction is not in dispute and is not a focal point of the proceeding, and there is no District Court construction.

Accordingly, institution should not be denied under § 42.104(b)(3).

Date: December 5, 2023

Respectfully submitted,

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James M. Glass

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on December 5, 2023, true and correct copies of the foregoing document were served in its entirety on the following parties via Electronic Mail.

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