UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SERVICENOW, INCORPORATED,
Petitioner

v.

INQUISIENT INCORPORATED,
Patent Owner

Case IPR2023-01073
Patent 8,224,855

PATENT OWNER'S SUR-REPLY TO PETITIONER'S PRELIMINARY REPLY TO PATENT OWNER'S RESPONSE

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I. INTRODUCTION

As authorized by the Board via email dated November 21, 2023, Patent Owner submits its Sur-Reply in response to Petitioner's Preliminary Reply filed December 5, 2023 (Paper 8).

II. ARGUMENT

A. The Preliminary Reply Is Based On An Incorrect Assumption Because The Petitions Do Not Use "PO's Construction"

In its POPRs, Patent Owner explained why each of the three Petitions are deficient ***on the merits*** and therefore should not be instituted. Patent Owner further pointed out that the Petitions are based on a claim construction that neither party proposed and that is contrary to the Joint Claim Construction Chart submitted to the District Court (Ex. 1011 to this proceeding). The Board should not conduct a proceeding based on a claim construction all parties contend is incorrect. On this basis alone, the Petitions are procedurally deficient.

Petitioner's Reply, like its Petitions, is based on the false premise that the Petitions rely on Patent Owner's proposed construction. This is incorrect as amply shown in the POPRs (*e.g.*, IPR2023-01071, Paper 7 at 19-21). Contrary to Petitioner's assertion, no claim construction was offered at the Section 101 hearing. The actual quote from Patent Owner's counsel at that hearing is: "***an example that's used in the specification*** is a table or a portion of a table." Ex.

1013 at 78 (emphasis added) (*compare with* Prelim Reply at 2 and Ex. 1011).[1] Counsel was clearly not providing a claim construction.

Moreover, even assuming Petitioner misunderstood Patent Owner's position at the Section 101 hearing, Petitioner knew full well that it was mistaken by the time the Petitions were filed based on the Joint Claim Construction Chart previously submitted to the District Court (Ex. 1011).

Also, Petitioner's Preliminary Reply asserts the "parties do not disagree on the construction of 'module'" and "claim construction is not in dispute." Prelim. Reply at 5. That is incorrect. The parties certainly have a claim construction dispute. However, because the Petitions are deficient ***even under the construction put forth in the Petitions***, the POPRs only address the merits under the incorrect construction of the Petitions. Thus, there is a dispute, but the Board need not resolve that dispute when deciding whether to deny institution.[2]

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[1] In footnote 1 of the Preliminary Reply, Petitioner asserts that it "consistently points to relational database structures" for the alleged module. That is incorrect. As one example, the POPRs explain that the Petitions point to "class Class 301" which is an object-oriented class (an object-oriented data type) without a corresponding table in the relational database. IPR2023-01071, Paper 7, 36-38.

[2] Petitioner asserts that because "module" is only in a subset of claims, institution denial is not warranted. Prelim. Reply, fn 2. On the contrary, each Petition selects

B. Petitioner's Cases Largely Stand For The Proposition That A Petitioner May Argue In The Alternative—A Point Not Disputed

37 C.F.R. § 42.104(b)(3) requires a Petition to set forth "how the challenged claim is to be construed." Here, the Petitioner asks the Board to evaluate the patents based on a claim construction no party contends is correct. Patent Owner submits that where a Petition puts forth arguments based on a construction that neither party has advocated for and that both parties disagree with, the Petitioner is asking the Board to undertake an analysis that is wasteful and pointless.

The Preliminary Reply takes issue with the POPRs statement that a Petition should not be instituted if it "asserts unpatentability solely under a construction that Petitioner believes is incorrect." The Preliminary Reply cites to various cases, but none address the situation presented here.

Rather, the Petitioner's cases reaffirm the unremarkable proposition that a Petitioner may argue in the alternative.[3] That is, a Petition may provide what it contends is the correct construction and further argue in the alternative under Patent Owner's construction, which Petitioner contends is incorrect. That is not

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"module" claims as representative and presents no independent argument for the non-module claims. The Board need only address the arguments presented.

[3] Petitioner refers to the cases as "the weight of the Board's precedent" (Prelim. Reply, 1), but none are precedential decisions.

what Petitioner has done here.[4]

Petitioner first cites *Lewis Machine & Tool Co. v. WHG Properties, LLC,* IPR2020-00373, Paper 6. In that case, the petitioner provided what it contended to be the correct constructions, and argued in the alternative that it would prevail under alternative constructions. The Board approved arguing in the alternative. IPR2020-00373, Paper 6, p. 33-34 ("Because the petition is the last word by the Petitioner . . .Petitioners . . . may argue in the alternative"). Nothing in *Lewis Machine & Tool Co.* suggests that the Board must decide a Petition on a claim construction neither party believes to be correct.

C. *Western Digital Corporation v. Spex Technologies* And Its Progeny Do Not Address The Situation Here

Petitioner next cites to the Board's opinion in *Western Digital Corp. v. SPEX Techs., Inc.,* IPR2018-00082, Paper 11 at 12 (Apr. 25, 2018). Prelim. Reply, 3. In that case, the Petition was based on the "claim constructions urged by the Patent Owner" as recorded in a District Court's tentative claim construction order attached as an exhibit. By contrast, here the construction used in the Petition is not one "urged by the Patent Owner" and does not reflect the Joint Claim Construction Chart attached to the Petition as Exhibit 1011 (a chart the Petition does not cite to).

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[4] Petitioner attempts to distinguish each case cited by Patent Owner, but the identified differences do not affect the relevance of the decisions.

Petitioner also cites to *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc*., IPR2020-00921, Paper 13 at 42-44 (Aug. 5, 2021), which cites to both *Western Digital* and *Lewis Machine & Tool, Co*. However, in that case, like *Lewis,* the Petition presented constructions it contended were correct and presented PO's constructions in the alternative. *Id.* at 40. The Board noted that the "regulatory history accompanying 37 C.F.R. § 42.104(b)(3) expressly contemplates that a petitioner may rely on alternative claim constructions." *Id.* at 43. The other cases cited by Petitioner similarly confirm alternative constructions may be presented. *See 10X Genomics, Inc. v. Bio-Rad Labs., Inc*., IPR2020-00086, Paper 8 at 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 (Nov. 5, 2018).

Finally, Petitioner cites to *Apple, Inc. v. AGIS Software Development, LLC*, IPR2018-00821, Paper 9 at 10 (PTAB Oct. 23, 2018). The Apple panel applied BRI and recognized that BRI and *Phillips* could yield inconsistent constructions.

Here, proceedings should not be instituted based on a construction that no party has advocated for.

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of Grounds 1-3 of the Petition.

Respectfully submitted,

Date: December 18, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), the undersigned certifies that on December 18, 2023, a complete and entire copy of this Patent Owner's Sur-Reply and associated exhibits were provided, via email to Petitioner by serving the correspondence email address of record as follows:

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