

IN THE UNITED STATES COURT OF FEDERAL CLAIMS

E-NUMERATE SOLUTIONS, INC., and  
E-NUMERATE, LLC

Plaintiff,

v.

THE UNITED STATES OF AMERICA,

Defendant.

No. 19-859 C

Judge Ryan T. Holte

**DEFENDANT’S REPLY IN SUPPORT OF  
MOTION TO DISMISS UNDER RULE 12(b)(6)**

**SUPPLEMENTAL APPENDIX**

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**U.S. Department of Justice**

Civil Division

SB  
154-19-859

Telephone: (202) 307-0262  
Facsimile: (202) 307-0345

Washington, DC 20530

January 3, 2020

**VIA EMAIL**

Sean T. O'Kelly  
O'KELLY & ERNST, LLC  
824 N. Market Street, Suite 1001A  
Wilmington, Delaware 19801  
302-778-4000  
[sokelly@oelegal.com](mailto:sokelly@oelegal.com)

Gerard M. O'Rourke  
O'ROURKE LAW OFFICE, LLC  
1201 N. Orange Street  
Suite 7260  
Wilmington, Delaware 19801-1186  
484-770-8046  
[gorourke@orourkefirm.com](mailto:gorourke@orourkefirm.com)

Re: *e-Numerate Solutions, Inc. et al. v. United States*,  
United States Court of Federal Claims No. 19-859 C

Dear Sean and Jerry:

We are writing to request that Plaintiffs provide their claim constructions for the terms that they claim are disputed. In Plaintiffs' recent brief in opposition, you argued that "claim construction issues compel denial of the Government's motion." ECF 15 at 48. Specifically, you asserted that

[a]t least the following terms/phrases warrant additional briefing . . . : "tags," "tags indicating characteristics of the numerical values," "tags reflecting characteristics of the numerical values," "computer readable semantic tags" (and related limitations), and "macro" (and related limitations).

Id. You further represented to the Court that "each of these terms have a concrete, technical meaning that distinguish the inventions from the prior art." Id.

Your brief, however, failed to provide the basis for your representation – *i.e.*, any proposed constructions for the identified terms. Accordingly, we request that you provide your proposed constructions, and that you identify all intrinsic and extrinsic evidence that supports the

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proposed constructions. We further note that Plaintiffs already provided (or adopted) claim constructions for “tags,” “semantic tags,” and “macros” for four of the patents-in-suit in *inter partes* review proceedings eight months ago, but you inexplicably failed to disclose these constructions in your opposition brief. Therefore, we request that you provide your constructions to us by January 13, 2020, so that we have sufficient time to evaluate the constructions for the Government’s reply brief.

If you have any questions, please do not hesitate to call me at the above number.

Very truly yours,



SCOTT BOLDEN  
Deputy Director  
Commercial Litigation Branch  
Civil Division

cc: Shahar Harel; Nelson Kuan (via email)

# O'Rourke Law Office, LLC

1201 N. Orange Street, Suite 7260  
Wilmington, DE 19801-1186  
Telephone: (484)770-8046

---

January 13, 2020

## VIA ELECTRONIC MAIL

Scott Bolden, Esq.  
Deputy Director  
Commercial Litigation Branch  
Civil Division  
Department of Justice  
Washington, DC 20530

Re: *e-Numerate Solutions, Inc. et al v. United States, USCFC No. 19-859*

Dear Scott:

We write in response to your letter of January 3, 2020 in the above-referenced matter. You request that Plaintiffs provide their claim constructions (and intrinsic and extrinsic evidence supporting same) for the terms Plaintiffs contend are in dispute. Plaintiffs will follow the claim construction schedule implemented by the Court in this matter and make its disclosures pursuant to that schedule. As a result, Plaintiffs will not provide claim constructions at this time.

We note that you have provided no authority compelling Plaintiffs to make such a disclosure. With regard to the claim construction positions in the *inter partes* review (“IPR”) proceeding, those claim constructions are not relevant to this litigation because of the claim construction standard employed in the IPR proceedings at that time. 83 Fed. Reg. 51340, 51340 (Oct. 11, 2018). It is not “inexplicable” that Plaintiffs did not disclose irrelevant information to the Court in Plaintiffs’ answering brief. Rather, it is perfectly understandable.

However, Plaintiffs are surprised that the Government did not apprise the Court of the presence of a claim construction dispute in the IPRs in the Government’s Opening Brief on its Section 101 motion. The presence of such a dispute, even under the claim construction standard then-employed in the IPR, is strong evidence that a dispute will exist here. This is an independent basis for the Court to deny the Government’s motion.

Very truly yours,

*/s/Gerard M. O'Rourke*

Gerard M. O'Rourke

Cc: Shahar Harel; Nelson Kuan; Sean O’Kelly (via electronic mail)

Trials@uspto.gov  
571-272-7822

Paper 12  
Entered: February 13, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MERRILL COMMUNICATIONS LLC d/b/a MERRILL CORPORATION,  
Petitioner,

v.

E-NUMERATE SOLUTIONS, INC.,  
Patent Owner.

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Case IPR2018-01389  
Patent 9,268,748 B2

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Before SALLY C. MEDLEY, KEN B. BARRETT, and JONI Y. CHANG,  
*Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314(a)

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