

Filed on behalf of: E-NUMERATE SOLUTIONS, INC.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

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

v.

E-NUMERATE SOLUTIONS, INC.,  
Patent Owner

Case IPR2018-01389  
U.S. Patent 9,268,748

---

**DECLARATION OF MICHAEL J. SMITH**

## **TABLE OF CONTENTS**

I. INTRODUCTION.....	4
II. PROFESSIONAL BACKGROUND .....	6
A. Education, Background and Experience .....	6
B. Compensation.....	7
III. APPLICABLE LAW .....	8
A. Person of Ordinary Skill in the Art .....	8
B. Obviousness .....	9
IV. CLAIM CONSTRUCTION.....	10
V. TECHNICAL BACKGROUND OF THE ‘748 PATENT .....	10
VI. SUMMARY OF THE ‘748 PATENT.....	42
VII. THE APPLIED PRIOR ART.....	42
A. Simpson (Ex. 1005) .....	42
B. Goldfarb (Ex. 1006).....	45
VIII. THE INSTITUTED GROUNDS .....	48
A. Grounds 1: Simpson In View Of Goldfarb .....	48
1. “an application including a network browser on the device for accessing a system configured for” as required by claim 1 .....	48
2. “calculation rule for validation of a calculation involving data values” as required by claim 1 .....	57
3. “a computer-readable calculation rule for validation of a calculation involving data values, and a computer-readable unit rule for validation of a unit of data values” as required by claim 1 .....	59
4. “code for mapping the one or more of the computer-readable semantic tags to the one or more of the original values” as required by claim 11 .....	64
5. “outputting at least one computer-readable Extensible Markup Language (XML)-compliant data document that is based on at least a portion of the at least one object and at least a portion of the mapping” as required by claim 11 .....	66

B.	A POSA Would Not Be Motivated To Modify Simpson In View Of Goldfarb .....	69
1.	Simpson Discloses Existing System With Limitations The Claimed Invention Overcomes .....	74
2.	The Proposed Modification Would Eliminate Goldfarb's Stated Improvement.....	75
3.	Petitioner Failed To Address The Inefficiencies Created .....	77
IX.	CONCLUSION.....	78

I, Dr. Michael J. Smith of Palo Alto, California, declare as follows:

## I. INTRODUCTION

1) I have been retained by e-Numerate Solutions, Inc. (“ENUM”) in this *Inter Partes* Review (“IPR”) as an independent expert to provide opinions regarding the subject matter recited in the claims of U.S. Patent No. 9,268,748 (Ex. 1001, “‘748 patent”). In particular, I have been asked to provide my opinion as to whether a person of ordinary skill in the art at the time of the invention (“POSA”) would have found claims 1, 11 and 19 of the ‘748 patent obvious in view of Alan Simpson & Elizabeth Olson, *Mastering Access* 97 (4th ed. 1997) (Ex. 1005, “Simpson”) in view of Charles F. Goldfarb & Paul Prescod, *The XML Handbook* (1998) (Ex. 1006, “Goldfarb”), based on the arguments and evidence submitted by Petitioner Merrill Communications LLC d/b/a Merrill Corporation (“Merrill”) and its declarant, Dr. Hospodor.

2) I understand that the Patent Trial and Appeal Board of the U.S. Patent and Trademark Office (“Board”) has instituted an IPR of the patentability of Claims 1, 11 and 19 of the ‘748 patent following the submission of a Petition by Merrill. I understand that Merrill also submitted a supporting declaration by Dr. Andrew David Hospodor.

3) I understand the Board has instituted review on the following grounds:

a. Claims 1, 11 and 19 of the '748 patent as obvious over Simpson in view of Goldfarb pursuant to 35 U.S.C. § 103.

4) My analysis and conclusions regarding the '748 patent and the instituted grounds are set forth below.

5) In connection with forming my opinions, I have considered the references and materials submitted by the parties in this proceeding, and in particular those cited herein, including the following:

Exhibit	Reference Name
N/A	Merrill's Petition
1001	U.S. Patent No. 9,268,748 to Davis
1002	File History of U.S. Patent No. 9,268,748
1003	Declaration of Andrew D. Hospodor Regarding '748 Patent
1004	<i>Curriculum Vitae</i> of Andrew D. Hospodor
1005	Alan Simpson & Elizabeth Olson, <i>Mastering Access 97</i> (SYBEX Inc. 1997)
1006	Charles Goldfarb & Paul Prescod, <i>The XML Handbook</i> (Prentice Hall PTR 1998)
1007	Declaration of Anne Rondoni Tavernier and Exhibits A-F Regarding Publication of <i>Mastering Access 97</i>
1008	Declaration of Peter Rolla and Exhibits A-B Regarding Publication of <i>The XML Handbook</i>
1009	Microsoft Computer Dictionary (4th ed. 1999)
1010	e-Numerate's original Complaint in Case No. 1:17-cv-00933-RGA in the U.S. District Court for the District of Delaware
1011	Affidavit of Service of e-Numerate's original Complaint in Case No. 1:17-cv-00933-RGA in the U.S. District Court for the District of Delaware
1012	e-Numerate's Amended Complaint in Case No. 1:17-cv-00933-RGA in the U.S. District Court for the District of Delaware
1013	Affidavit of Service of e-Numerate's Amended Complaint in Case No. 1:17-cv-00933-RGA in the U.S. District Court for the District of Delaware

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.