

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

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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

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