

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

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

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

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E-NUMERATE SOLUTIONS, INC'S PATENT OWNER RESPONSE  
PURSUANT TO 37 C.F.R. § 42.120

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**PATENT OWNER'S EXHIBIT LIST**

<b><u>Exhibit Number</u></b>	<b><u>Description</u></b>
2001	Expert Declaration of Dr. Michael J Smith
2002	U.S. Patent No. 7,249,328

## I. INTRODUCTION

The Petitioner did not demonstrate that any of the claims of U.S. Patent No. 9,268,748 (“the ‘748 patent”) are obvious because the Petitioner failed to show that a person of ordinary skill in the art (“POSA”) would have been motivated to modify the structure and components of either Simpson or Lyons to achieve the claimed invention or that a POSA “would have had a reasonable expectation of success in doing so.” *OSRAM Sylvania, Inc. v. Am Induction Techs., Inc.*, 701 F.3d 698, 706 (Fed. Cir. 2012). The Board has consistently declined to conclude that a claim is obvious when the Petition fails to identify any objective evidence such as experimental data, tending to establish that two different structures can be combined to achieve the claimed invention with a reasonable expectation of success.<sup>1</sup> Here, the Petitioner did not set forth any such objective evidence.<sup>2</sup> Rather, the Petitioner’s own expert made hand-waving arguments that the database system of Simpson, which did not support XML, and which required file-specific user-customized

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<sup>1</sup> *Epistar, et al. v. Trustees Of Boston University*, IPR2013-00298, Decision Not To Institute, Paper No. 18 (P.T.A.B. November 15, 2103).

<sup>2</sup> See e.g., Petition, pp. 21-23.

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