

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.

Patent No. 9,268,748

Issue Date: February 23, 2016

Title:

SYSTEM, METHOD, AND COMPUTER PROGRAM PRODUCT FOR
OUTPUTTING MARKUP LANGUAGE DOCUMENTS

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,268,748

UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.1-.80 & 42.100-.123

TABLE OF CONTENTS

I. COMPLIANCE WITH REQUIREMENTS FOR A PETITION FOR *INTER PARTES* REVIEW 1

 A. Grounds for Standing (37 CFR § 42.104 (a)) 1

 B. Fee for *Inter Partes* Review (37 CFR § 42.15(a)) 2

 C. Mandatory Notices (37 CFR § 42.8(b)) 2

 i. Real Party in Interest (37 CFR § 42.8(b)(1)) 2

 ii. Related Matters (37 CFR § 42.8(b)(2)) 2

 iii. Designation of Counsel and Service Information (37 CFR §§ 42.8(b)(3)-(4)) 3

 D. Proof of Service (37 CFR §§ 42.6(e) and 42.105(a)) 3

II. Introduction and Identification of the Claims Being Challenged (37 CFR § 42.104(b)(1)) 3

III. Background of the '748 Patent 11

 A. Effective Filing and Priority Dates of the '748 Patent 11

 B. Relevant Prosecution History of the '748 Patent 11

 C. Person of Ordinary Skill in the Art 13

IV. Claim Construction (37 CFR § 42.104(b)(3)) 13

 A. "Semantic Tags" 14

 B. "Mapping" 16

 C. "Validation" 16

V. Identification of Specific Statutory Grounds for Challenge (37 CFR § 42.104(b)(2)) 17

VI. Detailed Explanation and Evidence Supporting Grounds for Challenge (37 CFR §§ 42.104(b)(4)-(5)) 17

 A. Disclosure of *Mastering Access 97* 17

 B. Disclosure of *The XML Handbook* 19

 C. Rationale for Combining the Teachings of *Mastering Access 97* and *The XML Handbook* 21

 D. Comparison of Claims 1, 11, and 19 to *Mastering Access 97* and *The XML Handbook* 23

VII. CONCLUSION 54

Attachment A. Proof of Service of the Petition

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Petition for *Inter Partes* Review of U.S. Patent No. 9,268,748

Attachment B. List of Evidence and Exhibits Relied Upon in Petition

Attachment C. Word Count Compliance Certificate

Petitioner Merrill Communications LLC d/b/a Merrill Corporation (hereinafter “Merrill” or “Petitioner”) respectfully petitions for *inter partes* review of claims 1, 11, and 19 of U.S. Patent No. 9,268,748 (“the ’748 patent”) (Ex. 1001) in accordance with 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq.*

I. COMPLIANCE WITH REQUIREMENTS FOR A PETITION FOR *INTER PARTES* REVIEW

A. Grounds for Standing (37 CFR § 42.104 (a))

Petitioner certifies it is not barred or estopped from requesting *inter partes* review of the ’748 patent. Neither Petitioner, nor any party in privity with Petitioner, has filed a civil action challenging the validity of any claim of the ’748 patent. The ’748 patent has not been the subject of a prior *inter partes* review by Petitioner or a privy of Petitioner.

Petitioner also certifies this petition for *inter partes* review is filed within one year of the date of service of a complaint alleging infringement of a patent. Petitioner’s customer, Mattress Firm Holding Corp. (“Mattress Firm”), was served with a complaint alleging infringement of the ’748 patent on July 13, 2017, captioned No. 1:17-cv-00933 in the U.S. District Court for the District of Delaware. (*See* Ex. 1011, Affidavit of Service.) A copy of e-Numerate Solutions, Inc.’s (“e-Numerate”) Complaint is attached as Exhibit 1010. In the same suit, Petitioner and its parent, Merrill Corporation, were joined as defendants and served with an amended complaint alleging infringement of the ’748 patent on September

Petition for *Inter Partes* Review of U.S. Patent No. 9,268,748

19, 2017. (See Ex. 1013, Affidavit of Service.) A copy of e-Numerate's Amended Complaint is attached as Exhibit 1012.

Because this petition is filed within one year of July 13, 2017, this petition complies with 35 U.S.C. § 315(b).

B. Fee for *Inter Partes* Review (37 CFR § 42.15(a))

The Director is authorized to charge the fee specified by 37 CFR § 42.15(a) to Deposit Account No. 06-1910.

C. Mandatory Notices (37 CFR § 42.8(b))

i. Real Party in Interest (37 CFR § 42.8(b)(1))

The real parties in interest for this petition are Petitioner Merrill Communications LLC, Petitioner's parent Merrill Corporation, and Mattress Firm. Petitioner and its parent are located at One Merrill Circle, St. Paul, MN 55108. Mattress Firm is located at 5815 Gulf Freeway, Houston, TX 77023.

ii. Related Matters (37 CFR § 42.8(b)(2))

The '748 patent is the subject of a civil action in the U.S. District Court for the District of Delaware, captioned *e-Numerate Solutions, Inc., and e-Numerate, LLC, v. Mattress Firm Holding Corp., Merrill Communications LLC, and Merrill Corp.*, No. 1:17-cv-00933 ("the district court lawsuit"). Petitioner is contemporaneously filing three additional *inter partes* review petitions for U.S.

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