

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.

Cases IPR2018-01389 (Patent 9,268,748)
IPR2018-01391 (Patent 9,262,383)
IPR2018-01392 (Patent 8,185,816)
IPR2018-01394 (Patent 7,650,355)¹

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

CHANG, *Administrative Patent Judge.*

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.73

¹ This Order addresses issues that are identical in all four proceedings.
We exercise our discretion to issue one Order to be filed in each proceeding.

IPR2018-01389 (Patent 9,268,748); IPR2018-01391 (Patent 9,262,383)
IPR2018-01392 (Patent 8,185,816); IPR2018-01394 (Patent 7,650,355)

We instituted the above-identified *inter partes* reviews (“IPRs”) on February 13, 2019. Paper 12.² After institution, Patent Owner filed its Responses on May 6, 2019. Paper 14. However, Petitioner has not yet filed its Replies. And we have not held an Oral Hearing, nor have we entered a Final Written Decision in these IPRs.

On July 24, 2019, Petitioner contacted the Board, via email, to request “permission to file motions to withdraw from IPRs 2018-01389/91/92/94.” Ex. 3001, 1–2. Patent Owner indicated in its email that it does not oppose Petitioner’s request to withdraw, and that these instituted IPRs “should be terminated.” *Id.* at 1. Upon consideration, we granted Petitioner’s request, authorizing Petitioner to file a motion to withdraw in each of the IPRs. *Id.*

Subsequently, Petitioner filed unopposed Motions to Withdraw its participation in these IPRs. Paper 16 (“Mot.”).³ In its Motions, Petitioner indicates that the related district court litigation has been dismissed. Mot. 1. Petitioner also requests to withdraw its counsel from the IPRs, but does not provide any replacement counsel. *Id.*

In light of the particular facts before us, we find Petitioner’s actions amount to an abandonment of the contest. Under 37 C.F.R. § 42.73(b)(4),

² All citations are to IPR2018-01389, as representative, unless otherwise noted.

³ For the purposes of expediency, we cite to the Motion filed in Case IPR2018-01389. Similar Motions, were filed in Cases IPR2018-01391 (Paper 16), IPR2018-01392 (Paper 16), and IPR2018-01394 (Paper 15).

IPR2018-01389 (Patent 9,268,748); IPR2018-01391 (Patent 9,262,383)
IPR2018-01392 (Patent 8,185,816); IPR2018-01394 (Patent 7,650,355)

an abandonment of the contest is construed to be a request for adverse judgment. In view of the foregoing, we grant the request for adverse judgment in each of the above-identified proceedings.

Accordingly, it is

ORDERED that Petitioner's unopposed Motions to Withdraw, which are construed as requests for adverse judgment under 37 C.F.R.

§ 42.73(b)(4), are *granted*; and

FURTHER ORDERED that the above-identified IPR proceedings are *terminated*.

IPR2018-01389 (Patent 9,268,748); IPR2018-01391 (Patent 9,262,383)
IPR2018-01392 (Patent 8,185,816); IPR2018-01394 (Patent 7,650,355)

For PETITIONER:

Katherine Rahlin
FREDRIKSON & BYRON, P.A.
krahlin@fredlaw.com

For PATENT OWNER:

Gregory Gonsalves
GONSALVES LAW FIRM
gonsalves@gonsalveslawfirm.com

George Gordon
andrew@agordonlaw.com