

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

CORRECTED 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

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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

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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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Patent Nos. 7,650,355; 8,185,816; and 9,262,383, which are asserted in the district court lawsuit in addition to the '748 patent.

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

Petitioner identifies the following counsel (a power of attorney accompanies this Petition):

Lead Counsel	Backup Counsel
Katherine J. Rahlin Reg. No. 75,181 krahlin@fredlaw.com (612) 492-7370 Fredrikson & Byron, P.A. 200 South 6 th Street, Suite 4000 Minneapolis, MN 55402	Adam R. Steinert <i>pro hac vice</i> to be filed asteinert@fredlaw.com (612) 492-7436 Fredrikson & Byron, P.A. 200 South 6 th Street, Suite 4000 Minneapolis, MN 55402

Service information for counsel is provided above. Counsel may also be served by fax at (612) 492-7077.

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

Proof of service of this Petition is provided in **Attachment A**.

II. INTRODUCTION AND IDENTIFICATION OF THE CLAIMS BEING CHALLENGED (37 CFR § 42.104(B)(1))

This is a petition for *inter partes* review of claims 1, 11, and 19 of U.S. Patent No. 9,268,748 (“the ’748 patent”), titled “System, Method, and Computer Program Product for Outputting Markup Language Documents,” issued on February 23, 2016, to Davis and assigned to e-Numerate. The ’748 patent is

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