

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 IPR2018-01391
Patent 9,262,383 B2

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

CHANG, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Merrill communications LLC d/b/a Merrill Corporation (“Petitioner”) filed a corrected Petition requesting an *inter partes* review of claims 1, 17, and 18 (“the challenged claims”) of U.S. Patent No. 9,262,383 B2 (Ex. 1001, “the ’383 patent”). Paper 10 (“Pet.”). e-Numerate Solutions, Inc. (“Patent Owner”) filed a waiver of preliminary response. Paper 8.

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we determine that Petitioner has established a reasonable likelihood that it would prevail with respect to at least one challenged claim. We hereby institute an *inter partes* review as to all the challenged claims.

A. Related Matters

The parties indicate that the ’383 patent is involved in *e-Numerate Solutions, Inc. v. Mattress Firm Holding Corp.*, Case No. 1:17-cv-00933 (Del). Pet. 2; Paper 4, 2.

B. The ’383 Patent

The ’383 patent relates to a computer markup language for use in a data browser and manipulator. Ex. 1001, Abstract, 1:31–33. The ’383 patent discloses a system, method, and computer program product for processing markup documents. *Id.* In particular, the ’383 patent describes identifying two markup documents that include numerical values and tags reflecting characteristics of the numerical values. *Id.* At least a portion of

the numeric values is transformed automatically so that the numeric values of both documents have a common unit of measure. *Id.* And the documents are processed, resulting in a single markup document for display. *Id.*

Figure 2 of the '383 patent is reproduced below.

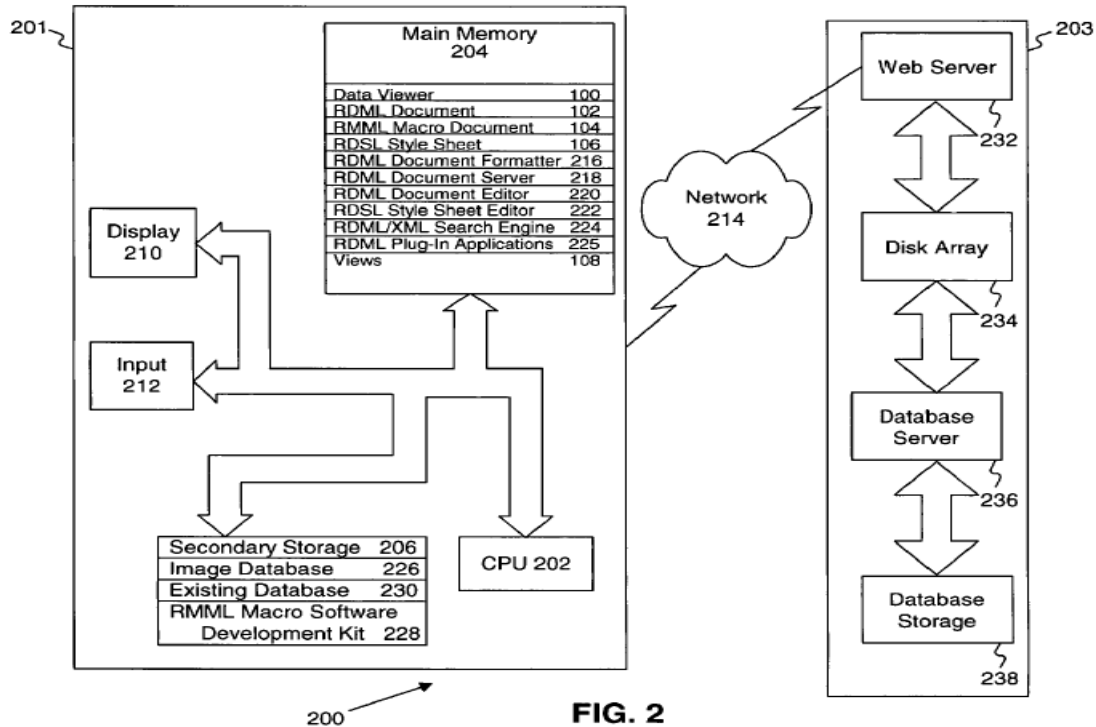


Figure 2 of the '383 patent depicts data processing system 200 that comprises computer 201 and server computer 203 interconnected via network 214, such as the Internet. Ex. 1001, 11:54–56. Computer 201 includes central processing unit 202, main memory 204, secondary storage device 206, display 210, and input device 212. *Id.* at 11:57–60. Server computer 203 may provide Reusable Data Markup Language (“RDML”) documents 102 to computer 201. *Id.* at 11:56–57.

C. Illustrative Claim

Each of the challenged claims is independent. Claim 1 is illustrative:

1. [1a] A computer program product embodied on a non-transitory computer-readable medium comprising:

[1b] code for identifying a first markup document including first numerical values and first tags reflecting first characteristics of the first numerical values associated with a first unit of measure, and a second markup document including second numerical values and second tags reflecting second characteristics of the second numerical values associated with a second unit of measure,

[1c] wherein the first tags and the second tags each include computer-readable semantic tags that describe a semantic meaning of a corresponding one of at least one of the first numerical values or the second numerical values, via a computer-readable tagging association therebetween,

[1d] where the first characteristics of the first numerical values associated with the first unit of measure are different from the second characteristics of the second numerical values associated with the second unit of measure;

[1e] code for causing automatic transformation of at least a portion of the first or second numerical values of at least one of the first markup document or the second markup document, so that at least some of the first numerical values of the first markup document and at least some of the second numerical values of the second markup document have a common unit of measure;

[1f] code for processing at least a part of the first markup document and at least a part of the second markup document, resulting in a single markup document; and

[1g] code for causing a display of at least a portion of the single markup document.

Ex. 1001, 143:2–32 (bracketed matters added).

D. Prior Art Relied Upon

Petitioner relies upon the references listed below (Pet. 8).

Lyons US Patent No. 5,189,608 Feb. 23, 1993 (Ex. 1007)

Alan Simpson & Elizabeth Olson, *Mastering Access 97* (SYBEX Inc. 1997) (Ex. 1005, “Simpson”)

Charles Goldfarb & Paul Prescod, *The XML Handbook* (Prentice Hall PTR 1998) (Ex. 1006, “Goldfarb”)

Based on the current record, Petitioner has made a threshold showing that Simpson and Goldfarb are prior art printed publications under § 102. See Pet. 5–8; Ex. 1005, Part 1; Ex. 1006, Part 1; Ex. 1008 ¶¶ 3–17; Ex. 1009 ¶¶ 6–11. At this juncture, Patent Owner does not challenge Petitioner’s showing on this issue. Paper 8.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 19):

Challenged Claims	Basis	Reference(s)
1, 17, and 18	§ 103	Simpson
1, 17, and 18	§ 103	Simpson in view of Goldfarb
1, 17, and 18	§ 103	Lyons
1, 17, and 18	§ 103	Lyons in view of Goldfarb

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