

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 IPR2018-01392
Patent 8,185,816 B2

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

BARRETT, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. *Background and Summary*

Merrill Communications LLC d/b/a Merrill Corporation (“Petitioner”)¹ filed a corrected Petition requesting *inter partes* review of U.S. Patent No. 8,185,816 B2 (“the ’816 patent,” Ex. 1001). Paper 11 (“Pet.”)². The Petition challenges the patentability of claims 1, 10, 17, 26, and 27 of the ’816 patent. e-Numerate Solutions, Inc. (“Patent Owner”)³ filed a Waiver of Patent Owner’s Preliminary Response. Paper 9.

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.” 35 U.S.C. § 314(a). Having considered the arguments and evidence presented by Petitioner, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of the challenged claims of the ’816 patent. We institute an *inter partes* review as to all the challenged claims of the ’816 patent on all the grounds of unpatentability set forth in the Petition.

¹ Petitioner identifies Merrill Communications LLC, Merrill Corporation, and Mattress Firm Holding Corp. as real parties-in-interest. Pet. 1–2.

² References herein are to the Corrected Petition filed December 17, 2018 (Paper 11). That paper was filed in response to a requirement to submit a corrected petition containing pinpoint citations to parts of certain large exhibits. *See* Paper 10.

³ Patent Owner identifies e-Numerate Solutions, Inc. and e-Numerate, LLC as real parties-in-interest. Paper 5, 1.

B. Related Proceedings

One or both parties identify, as matters involving or related to the '816 patent, *e-Numerate Solutions, Inc., and e-Numerate, LLC, v. Mattress Firm Holding Corp., Merrill Communications LLC, and Merrill Corp.*, No. 1:17-cv-00933 (D. Del.), and Patent Trial and Appeal Board cases IPR2018-01389 (Patent No. 9,268,748), IPR2018-01391 (Patent No. 9,262,383) and IPR2018-01394 (Patent No. 7,650,355). *See* Pet. 2; Paper 5, 2.

C. The '816 Patent

The '816 patent relates to a computer markup language for use in a data browser and manipulator. Ex. 1001, Abstract, 1:29–31. The '816 patent discloses a system and method for processing markup documents. *Id.* In particular, the '816 patent describes receiving two markup documents that include numerical values and tags reflecting characteristics of the numerical values. *Id.* at 3:65–4:3. The first markup document and the second markup document are combined into a single data set, which is displayed. *Id.* at 4:3–6.

Figure 2 of the '816 patent is reproduced below.

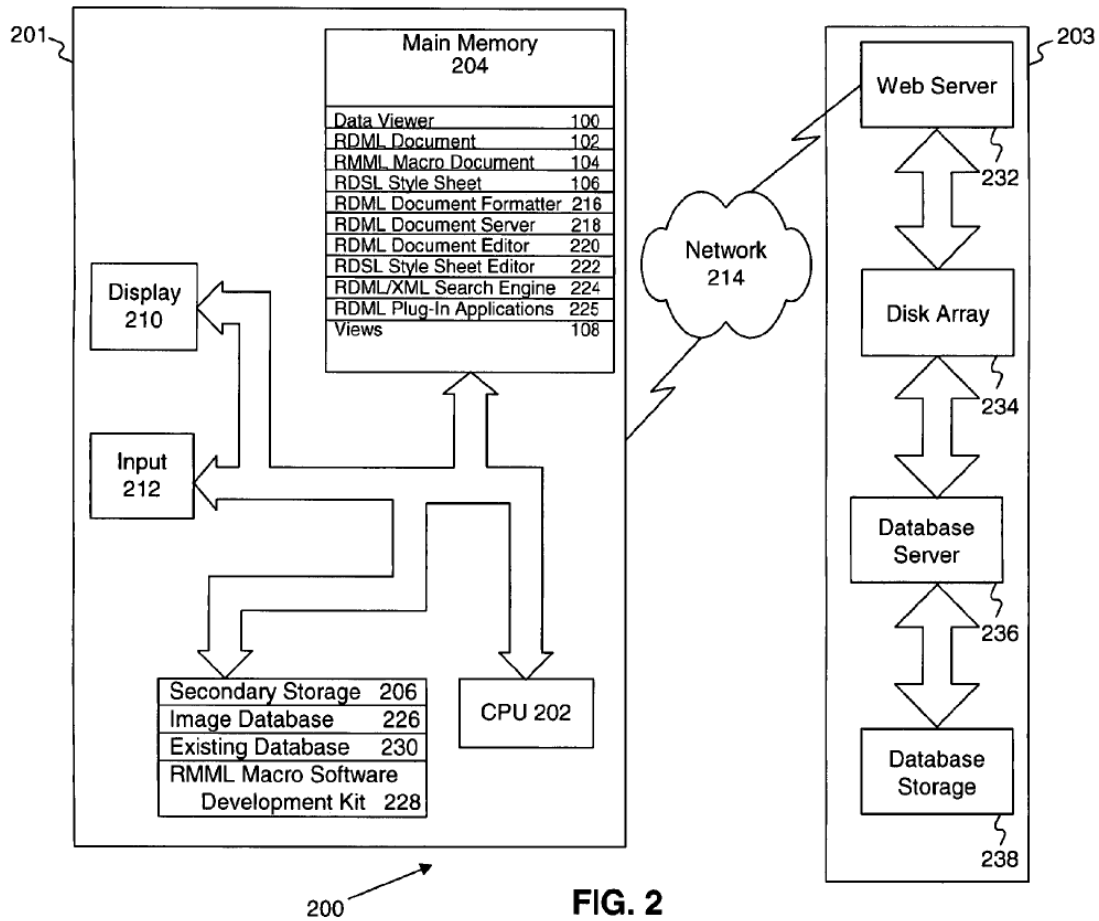


Figure 2 of the '816 patent depicts data processing system 200 that comprises computer 201 and server computer 203 interconnected via network 214, such as the Internet. *Id.* at 13:48–52. Computer 201 includes central processing unit 202, main memory 204, secondary storage device 206, display 210, and input device 212. *Id.* at 13:53–56. Server computer 203 may provide Reusable Data Markup Language (“RDML”) documents 102 to computer 201. *Id.* at 13:52–53.

D. Illustrative Claim

All of the challenged claims of the '816 patent, claims 1, 10, 17, 26, and 27, are independent claims. Claim 1, reproduced below, is illustrative:

1. [1a] A method in a data processing system, comprising the steps of:

[1b] receiving a first markup document and a second markup document, both the first markup document and the second markup document including numerical values and tags reflecting characteristics of the numerical values, [1c] wherein the characteristics indicate that the numerical values of the first markup document differ in format from the numerical values of the second markup document;

[1d] automatically transforming the numerical values of at least one of the first markup document and the second markup document, so that the numerical values of the first markup document and the second markup document have a common format;

[1e] combining the first markup document and the second markup document into a single data set; and

[1f] displaying the single data set.

Ex. 1001, 55:6–24 (bracketed matter added⁴).

E. Evidence

Petitioner relies on the following references:

Reference	Exhibit No.
Alan Simpson & Elizabeth Olson, <i>Mastering Access 97</i> [®] (4th ed. 1997) (“Simpson”)	Ex. 1005
Charles F. Goldfarb & Paul Prescod, <i>The XML Handbook</i> (1998) (“Goldfarb”)	Ex. 1006
Lyons, US Patent No. 5,189,608, issued Feb. 23, 1993	Ex. 1007

Petitioner also relies on the Declaration of Andrew David Hospodor, dated July 13, 2018, (Ex. 1003) in support of its arguments.

⁴ We utilize Petitioner’s bracketed annotations for claim 1 and have retained the paragraphing from the issued patent.

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