Filed on behalf of: E-NUMERATE SOLUTIONS, INC.

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
U.S. Patent 8,185,816

E-NUMERATE SOLUTIONS, INC'S PATENT OWNER RESPONSE PURSUANT TO 37 C.F.R. § 42.120

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TABLE OF CONTENTS

I. INTRODUCTION 5

II. BACKGROUND 8

A. Prior Art Markup Language Documents 8

B. The '816 Patent 40

III. DESCRIPTION OF THE PRIOR ART 41

A. Simpson (Ex. 1005) 41

B. Goldfarb (Ex. 1006) 43

C. Lyons (Ex. 1007) 47

IV. CLAIM CONSTRUCTION 49

A. "Markup Document" 50

V. PETITIONER FAILED TO DEMONSTRATE THAT THERE IS SUBSTANTIAL EVIDENCE THAT ANY OF THE CHALLENGED CLAIMS ARE OBVIOUS 53

A. Grounds 1 & 2: Simpson Or Simpson In View Of Goldfarb Does Not Render Claims 1, 10, 17, 26, And 27 Obvious 55

1. Petitioner Fails To Establish That Either Simpson Or Goldfarb Disclose "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" 55

2. Petitioner Fails To Establish That Either Simpson Or Goldfarb Disclose "a first markup document and a second markup document, both the first markup document and the second markup document [including/containing] numerical values and tags reflecting characteristics of the numerical values" 67

B. Grounds 3 & 4: Lyons Or Lyons In View Of Goldfarb Does Not Render Claims 1, 10, 17, 26, And 27 Obvious 77

1. Petitioner Fails To Establish That Either Lyons Or Goldfarb Disclose "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" 77

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2. Petitioner Fails To Establish That Either Lyons Or Goldfarb Disclose "a first markup document and a second markup document, both the first markup document and the second markup document [including/containing] numerical values and tags reflecting characteristics of the numerical values" 83

C. Grounds 2 & 4: A POSA Would Not Be Motivated To Modify Simpson or Lyons In View Of Goldfarb 86

1. Both Simpson And Lyon Disclose Existing Systems With Limitations The Claimed Invention Overcomes 90

2. The Proposed Modification Would Eliminate Goldfarb's Stated Improvement 95

3. Petitioner Failed To Address The Inefficiencies Created 97

4. Petitioner Fails To Show How A POSA Would Have Modified Lyons To Accept XML Data Files 99

VI. CONCLUSION 101

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PATENT OWNER'S EXHIBIT LIST

Exhibit Number	Description
2001	Expert Declaration of Dr. Michael J Smith

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I. INTRODUCTION

The Petitioner did not demonstrate that any of the claims of U.S. Patent No. 8,185,816 ("the '816 patent") are obvious because the Petitioner failed to show that a person of ordinary skill in the art ("POSA") would have been motivated to modify the structure and components of either Simpson or Lyons to achieve the claimed invention or that a POSA "would have had a reasonable expectation of success in doing so." *OSRAM Sylvania, Inc. v. Am Induction Techs., Inc.*, 701 F.3d 698, 706 (Fed. Cir. 2012). The Board has consistently declined to conclude that a claim is obvious when the Petition fails to identify any objective evidence such as experimental data, tending to establish that two different structures can be combined to achieve the claimed invention with a reasonable expectation of success.[1] Here, the Petitioner did not set forth any such objective evidence.[2] Rather, the Petitioner's own expert made hand-waving arguments that the two database systems of Simpson and Lyons, which did not support XML, and which required file-specific user-

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[1] *Epistar, et al. v. Trustees Of Boston University,* IPR2013-00298, Decision Not To Institute, Paper No. 18 (P.T.A.B. November 15, 2103).

[2] *See e.g.*, Petition, pp. 34-36 and 61-62.

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