

Petition for *Inter Partes* Review of U.S. Patent No. 8,185,816

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. 8,185,816

Issue Date: May 22, 2012

Title:

COMBINING REUSABLE DATA MARKUP LANGUAGE DOCUMENTS

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,185,816

UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.1-.80 & 42.100-.123

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Attachment A. Proof of Service of the Petition

Attachment B. List of Evidence and Exhibits Relied Upon in Petition

Attachment C. Word Count Compliance Certificate

Petitioner Merrill Communications LLC d/b/a Merrill Corporation (hereinafter “Merrill” or “Petitioner”) respectfully petitions for *inter partes* review of claims 1, 10, 17, 26, and 27 of U.S. Patent No. 8,185,816 (“the ’816 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 ’816 patent. Neither Petitioner, nor any party in privity with Petitioner, has filed a civil action challenging the validity of any claim of the ’816 patent. The ’816 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 ’816 patent on or about July 13, 2017, captioned No. 1:17-cv-00933 in the U.S. District Court for the District of Delaware. (*See* Ex. 1012, Affidavit of Service.) A copy of e-Numerate Solutions, Inc.’s (“e-Numerate”) Complaint is attached as Exhibit 1011. In the same suit, Petitioner and its parent, Merrill Corporation, were joined as defendants and

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served with an amended complaint alleging infringement of the '816 patent on or about September 19, 2017. (*See* Ex. 1014, Affidavit of Service.) A copy of e-Numerate's Amended Complaint is attached as Exhibit 1013.

Because the date of this petition is less than one year from 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, and Mattress Firm is located at 5815 Gulf Freeway, Houston, TX 77023.

ii. Related Matters (37 CFR § 42.8(b)(2))

The '816 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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