

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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THE UNITED STATES POSTAL SERVICE (USPS)  
AND THE UNITED STATES OF AMERICA,  
AS REPRESENTED BY THE POSTMASTER GENERAL,

Petitioner,

v.

RETURN MAIL, INC.,

Patent Owner.

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Case: CBM2014-00116

Patent: 6,826,548

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**Petitioner's Reply to Patent Owner's Response  
Pursuant to 37 C.F.R. § 42.24**

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## I. Preliminary Statement

“Looking at the ’548 patent, its architecture is **simple**... and is **specifically designed to support automating the address updating process.**” Ex.1015 at 22 (emphasis added). “The **entire purpose behind the patent is to convert a manual process to an integrated automated process.**” *Id.* at 23 (citing Ex.1001, 1:55-60)(emphasis added). In instituting this CBM Review, the Board found that “USPS has established that claims 39-44 more likely than not are directed to non-statutory subject matter under 35 U.S.C. § 101.” Institution Decision, at 19 (“ID”). Nothing in the Patent Owner’s Response (“POR”) changes the reasoned and correct conclusions in the Institution Decision. *Alice* reaffirmed that claims directed to abstract ideas, without limitations sufficient to tie them down, are patent ineligible. Rather than address this standard, RMI concocts its own misguided tests for patent-eligibility that have no basis in precedent and, in fact, run afoul of the holdings in *Alice*, *Bilski*, *Benson*, *Flook*, *Bancorp*, and *CyberSource*. POR at 27-51.

Having failed to move to amend claims, RMI now attempts to effect, through arguments improperly narrowing its claims, what it should have done through claim amendment. RMI attempts to turn a blind-eye to the entirety of the *1997 ACS* reference mischaracterizing it as a manual system. In so doing, RMI tacitly concedes the abstractness of its claims and the anticipation of *1997 ACS*. Therefore, USPS respectfully requests cancellation of asserted claims 39-44 of the ’548 patent as being

unpatentable under 35 U.S.C. § 101 and anticipated by *1997 ACS* under § 102 for the reasons set forth herein and in its Petition for CBM Review (Paper No. 2).

Lastly, RMI attempts to challenge USPS and its real party-in-interest standing to bring CBM review against the '548 patent. But as the Board has correctly found, USPS and the U.S. Government have standing to bring CBM Review here. ID at 18.

## II. Standing

The plain language of § 18(a) of the AIA does not limit covered business method reviews to persons sued for infringement under 35 U.S.C. §§ 271 and 281. RMI has sued USPS for infringement of the '548 patent. Ex.2002 ¶¶ 1, 21. Therefore, USPS has standing to bring CBM review of the '548 patent. RMI concedes that its '548 patent is financial in nature. ID at 12; Preliminary Response at 10-14; *see also* POR. Further, the '548 patent recites only nominal, generic, long-existing technologies, such as the common telephone, any computer, or any Internet or intranet address or location, therefore there is no technological innovation. Thus, the Board correctly concluded that the USPS has standing to bring CBM review and the '548 patent claims otherwise qualifies.

## III. Claims 39-44 of the '548 Patent Recite Only Non-Statutory Subject Matter

“[T]his case involves **changing and processing data** in a way that improves the overall **processing of returned mail.**” POR at 34 (emphasis added). The claims-at-issue do not include any meaningful, concrete limitations limiting the claims to a

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