

USPS NCOA address correction databases or the databases provided by licensed service providers. This processing step is indicated in logic block **308**.

Column 4, line 54 - Column 5, line 3 (emphasis added to non-numeric text).

In view of the foregoing, withdrawal of the rejection of claims 39-114 under 35 U.S.C. Section 112, first paragraph, is requested.

Rejection of claims 1-38 under 35 U.S.C. §103(a)

With regard to the rejection of claims 1-38 under 35 U.S.C. §103(a), Applicants have amended independent claims 1, 14, 25 and 32 to recite making a determination as to whether a sender wants a “corrected address provided” (or a “corrected address to be provided”). As noted above with regard to claims 39, 42-62, and 64-114, support for the amendment to claims 1-38 is found, for example, at least at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the ‘548 patent.

Independent Claim 1 and Dependent Claims 2-13

On page 3 of the Office Action, the Examiner cites column 8, lines 64-66 of Pintsov as allegedly disclosing “receiving those items of the plurality of mail items that are returned as being undeliverable....”

With regard to “receiving those items of the plurality of mail items that are **returned as being undeliverable**,” Pintsov discloses a technique that relies on the unique numeric identifier to provide a fundamentally different approach than that of the claimed invention. More particularly, Pintsov does not teach or suggest that mail is “**returned** as being undeliverable.” Instead, Pintsov discloses that “**change-of-address mail never reaches the old, incorrect destination**, but is intercepted at a very early point in the mail processing cycle and reaches its correct destination earlier and at very little cost to the carrier service.” Pintsov, column 7, lines 56-60 (emphasis

added). Accordingly, Pintsov does not receive “mail items that are returned as being undeliverable,” and instead teaches away from this aspect of the claimed invention.

On page 12 of the Office Action, the Examiner states that Column 8, lines 64-66 of Pintsov disclose that “mail is ‘returned as undeliverable’”

Column 8, lines 64-67 of Pintsov disclose the following:

As an option address cleansing can be done on-line and in real-time. In this case all mail which is undeliverable as addressed can be determined and corresponding data can be communicated back to the mailer.

Column 8, lines 64-67 of Pintsov indicate that mail is *undeliverable*, but not that the mail is “*returned as being undeliverable*” as recited in the present invention. Column 8, lines 56-61 of Pintsov, immediately preceding the passage above cited by the Examiner, make clear that Pintsov does not process mail that is “returned as being undeliverable”.

Column 8, lines 56-61 of Pintsov disclose the following:

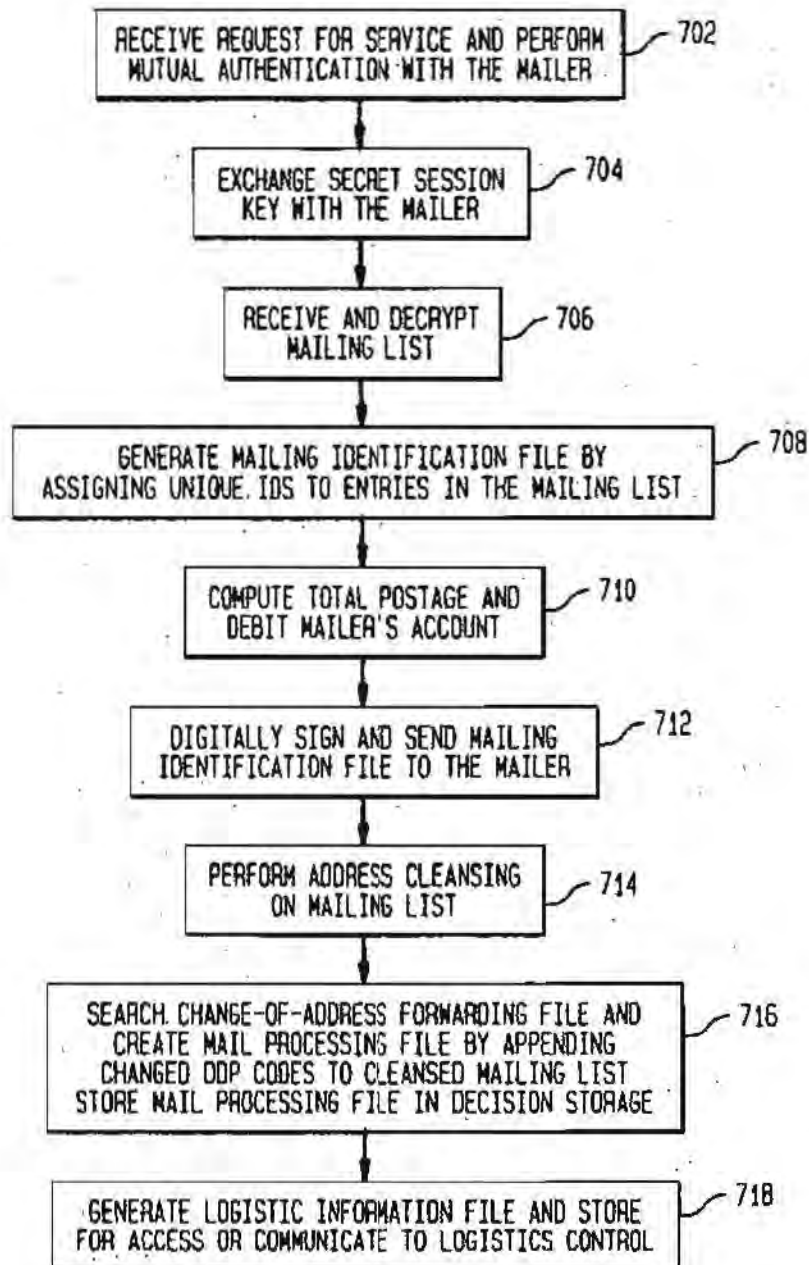
There is typically at least **several hours** between the moment mail is printed by the mailer and the moment when mail is delivered to the carrier and mail processing begins. This time can be used to correct addresses, produce and consolidate logistical information, arrange for special deliveries, etc. (emphasis added.)

Column 9, lines 1-3 of Pintsov disclose the following:

Deliverable mail (even where the address is not fully complete and/or accurate) can be addressed correctly during the **several available hours**. (emphasis added.)

Figure 7 of Pintsov also indicates that the mail in Pintsov is not “*returned as being undeliverable*” as recited in the present invention. Figure 7 of Pintsov, provided below, is a flow chart of the operation of the mailing list processing at the carrier data center. (Column 4, lines 14-15.)

FIG. 7
DATA CENTER MAILING LIST PROCESSING



The carrier data center is shown in Figure 1 of Pintsov. Figure 1 of Pintsov also indicates that the mailing file 120 and the mailing identification file 122 shown in Figure 1 are utilized prior to an initial mailing, and are not utilized in connection with returned mail items.

For example, Column 10, lines 25-31 of Pintsov disclose the following:

After receiving the mailing file 120 the mailpieces 104 are prepared at the mailer or other facility using the information from the mailing identification file [122] which includes a unique identifier such as an identification number (ID tag) associated with each mailpiece which is printed thereon. **The mailpieces 104 are then prepared and delivered to the carrier service for further processing.** (emphasis added to non-numeric text.)

Pintsov discloses that address correction occurs before attempted delivery. Accordingly, there is no mail that is “returned as being undeliverable” as recited in the present invention.

Other passages of Pintsov also indicate that Pintsov does not process or disclose mail that is “returned as being undeliverable.” For example, Pintsov discloses that “**change-of-address mail never reaches the old, incorrect destination**, but is intercepted at a very early point in the mail processing cycle and reaches its correct destination earlier and at very little cost to the carrier service.” Pintsov, Column 7, lines 56-60 (emphasis added). Accordingly, Pintsov does not receive “mail items that are returned as being undeliverable,” and instead teaches away from this aspect of the claimed invention.

On page 3 of the Office Action, the Examiner also cites Column 7, lines 37-39 of Pintsov as allegedly disclosing “receiving those items of the plurality of mail items that are returned as being undeliverable....” However, upon reading this passage, it is apparent that Column 7, lines 37-39 pertain to aspects of a prior art technique. In fact, Column 7, lines 39-41 of Pintsov describe a disadvantage of prior art techniques by stating that “[t]he cost to the United States Postal Service of such operation is very high because of all the handling and processing involved.” Still further, Column 7, lines 42-63 of Pintsov go on to describe how the invention of Pintsov “overcomes the difficulty” of prior art techniques because, for example, with the system of Pintsov, “change-of-address mail never reaches the old, incorrect destination, but is intercepted at a very early point in the mail processing cycle and reaches its correct destination earlier and at very little cost to the carrier service.” Accordingly, Column 7, lines 37-39 of Pintsov do not disclose or suggest “receiving those items of the plurality of mail items that are returned as being undeliverable....” as alleged by the Examiner on page 3 of the Office Action.

On page 12 of the Office Action, the Examiner also states that a corrected address “can be provided to the mailer immediately.” However, the “immediately” cited by the Examiner refers to a time that occurs within the “several hours” discussed above and in Column 8:56 - 9:3 of Pintsov, which occurs before mailing, and thus does not apply to or contemplate a context or application such as “*returned as being undeliverable*” as recited in the present invention.

In view of the foregoing, Applicants submit that Pintsov does not disclose or suggest at least the “*returned as being undeliverable*” limitation, as recited in claim 1 of the present invention.

Applicants further submit that Pintsov does not disclose or suggest at least the following, as now recited in claim 1:

determining, subsequent to decoding, if the sender wants a corrected address provided; and
if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients for the sender to update the sender’s mailing address files.

Applicants find no teaching or suggestion in Pintsov regarding the newly added underlined features now recited in claim 1.

Independent Claim 14 and Dependent Claims 15-24

For substantially the same reasons as set forth above with regard to claim 1 in connection with the “*returned as being undeliverable*” limitation, Applicants submit that Pintsov does not disclose or suggest “*collecting the returned mail items, not delivered to an intended recipient, at a processing location*” as recited in claim 14.

Applicants further submit that Pintsov does not disclose or suggest at least the following, as now recited in claim 14:

determining from the reading if the subscriber wants a corrected address provided for the returned mail items;

if the subscriber wants a corrected address provided, electronically gathering updated recipient identification information including an updated address of the intended recipient; and

Applicants find no teaching or suggestion in Pintsov regarding the newly added underlined features now recited in claim 14.

Independent Claim 25 and Dependent Claims 26-31

Applicants further submit that Pintsov does not disclose or suggest at least the following, as now recited in claim 25:

program instructions that capture optically scanned encoded data including intended recipient identification information and that capture data indicating whether a subscriber wants a corrected address to be provided for the intended recipient on each item of undeliverable mail, and ...

program instructions that update the stored data, based on the data indicating whether a subscriber wants a corrected address provided, to incorporate an updated address of the intended recipient of each item of undeliverable mail.

Applicants find no teaching or suggestion in Pintsov regarding the newly added underlined features now recited in claim 25.

Independent Claim 32 and Dependent Claims 33-38

Applicants further submit that Pintsov does not disclose or suggest at least the following, as now recited in claim 32:

- a scanner for reading optically encoded data that includes intended recipient identification information and data indicating whether a sender wants a corrected address provided on each item of undeliverable mail;
- a processor for operation of a computer program for decoding the scanned data, identifying the intended recipient identification information in the decoded data, writing the identified recipient identification information into a data file, and transferring to a sender information for the identified intended recipient for the sender to update the sender's mailing address files subsequent to and based on determining that the sender wants a corrected address provided; and

Applicants find no teaching or suggestion in Pintsov regarding the newly added underlined features now recited in claim 32.

Claims 39-114

Of claims 39, 42-62 and 64-114, claims 39, 57, 75, 88 and 101 remain independent claims. Each of claims 39, 57, 75, 88 and 101 has been amended to recite, inter alia, determining if a sender wants a "corrected address provided" or a "corrected address to be provided." Applicants have reviewed Pintsov, and find nothing in Pintsov that teaches or suggests at least these limitations. Accordingly, Pintsov does not show or suggest the combination of features recited in claims 39, 42-62 and 64-114. Withdrawal of the rejection of claims 39, 42-62 and 64-114 is respectfully requested.

Conclusion

For all of the above reasons, it is urged and respectfully submitted that claims 1-39, 42-62 and 64-114 are patentable over the prior art.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, to the extent Applicants have discussed specific elements of the claims, Applicants have merely provided examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited reference, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Prompt and favorable consideration of this reissue application is respectfully requested.

Dated: November 9, 2009

Respectfully submitted,

By 

Paul J. Berman

Registration No.: 36,744

Gregory S. Discher

Registration Number, 42,488

COVINGTON & BURLING LLP

1201 Pennsylvania Avenue, N.W.

Washington, DC 20004-2401

(202) 662-6000

Attorney for Applicant



11/09/09

Docket No.: 031073.00001-US03/US04
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:
Ralph M. Hungerpillar et al.

Reissue Application No.: 11/605,488 Group Art Unit: 3628
Reexamination Application No.: 90/008,470 Examiner: I. N. Borissov

Corresponding to U.S. Patent No. 6,826,548

For: SYSTEM AND METHOD FOR PROCESSING
RETURNED MAIL

INTERVIEW SUBSTANCE STATEMENT

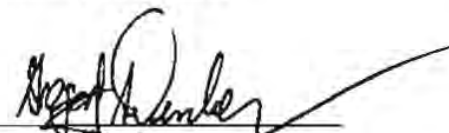
MS Reissue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On September 17, 2009, Applicants' representative (the undersigned) and Mr. Hungerpillar participated in a personal interview with the Examiner concerning the pending claims in this application. Attached is a copy of an Interview Summary prepared by the Examiner on September 17, 2009, subsequent to the interview. The Examiner's Interview Summary accurately summarizes the substance of the September 17, 2009 interview.

Dated: November 9, 2009

Respectfully submitted,

By 
Gregory S. Discher
Registration No.: 42,488
COVINGTON & BURLING LLP
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401
(202) 662-6000
Attorney for Applicants

Interview Summary	Application No.	Applicant(s)	
	11/805,488	HUNGERPILLER ET AL.	
	Examiner	Art Unit	
	Igor N. Borissov	3628	

All participants (applicant, applicant's representative, PTO personnel):

(1) Igor N. Borissov.

(3) Ralph M. Hungerpiller

(2) Gregory S. Discher

(4) _____

Date of Interview: 17 September 2009.

Type: a) Telephonic b) Video Conference
 c) Personal [copy given to: 1) applicant 2) applicant's representative]

Exhibit shown or demonstration conducted: d) Yes e) No.
 If Yes, brief description: _____

Claim(s) discussed: 4, 38, 75

Identification of prior art discussed: Pinto, 5,612,889.

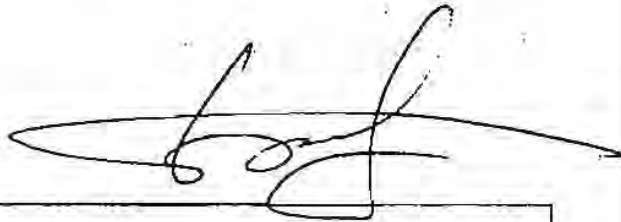
Agreement with respect to the claims f) was reached. g) was not reached. h) N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: _____

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

during interview the applicability of prior art of record was discussed. Also, possible amendments to the claims, 35 USC §112 and §101 issues were discussed.



Igor N. Borissov/
 Primary Examiner, Art Unit 3628

71338 U.S. PTO



11/09/09

Docket No.: 031073.00001-US03/US04
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:
Ralph M. Hungerpilller et al.

Reissue Application No.: 11/605,488
Reexamination Application No.: 90/008,470

Group Art Unit: 3628
Examiner: I. N. Borissov

Corresponding to U.S. Patent No. 6,826,548

For: SYSTEM AND METHOD FOR PROCESSING
RETURNED MAIL

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

MS Reissue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying PTO/SB/08a are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicant has listed publication dates on the attached PTO/SB/08a based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicant reserves the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior

In re Merger of Reissue and Reexamination Application of:
Reissue Application No.: 11/605,488
Reexamination Application No.: 90/008,470
Attorney Docket No.: 031073.00001-US03/US04

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art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicant has checked the appropriate boxes below.

- 1. This Information Disclosure Statement is being filed within three months of the U.S. filing date OR before the mailing date of a first Office Action on the merits. No statement under 37 C.F.R. § 1.97(e) or fee is required.
- 2. This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection or Notice of Allowance.
 - a. I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
 - b. I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

In re Merger of Reissue and Reexamination Application of:
Reissue Application No.: 11/605,488
Reexamination Application No.: 90/008,470
Attorney Docket No.: 031073.00001-US03/US04

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3. This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. It is hereby requested that the Information Disclosure Statement be considered.
- a. I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- b. I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- c. The Director is hereby authorized to charge \$ _____ for the Information Disclosure Statement fee.
4. Relevance of the non-English language document(s) is discussed in the present specification.
5. The document(s) was/were cited in a corresponding foreign application. An English language version of the foreign search report is attached for the Examiner's information.
6. A concise explanation of the relevance of the non-English language document(s) appears below:
7. The Examiner's attention is directed to co-pending U.S. Patent Application No. _____, filed _____, which is directed to related technical subject matter. The identification of this U.S. Patent Application is not to be construed as a waiver of secrecy

In re Merger of Reissue and Reexamination Application of:
Reissue Application No.: 11/605,488
Reexamination Application No.: 90/008,470
Attorney Docket No.: 031073.00001-US03/US04

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as to that application now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited application and the art cited therein during examination.

8. Applicant submits herewith copies of foreign patents in accordance with 37 CFR 1.98(a)(2).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO/SB/08a/b, and to indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 50-0740, referencing Docket No. 031073.00001-US03/US04.

Dated: November 9, 2009

Respectfully submitted,

By 

Gregory S. Discher

Registration No.: 42,488

Paul J. Berman

Registration No.: 36,744

COVINGTON & BURLING LLP

1201 Pennsylvania Avenue, N.W.

Washington, DC 20004-2401

(202) 662-6000

Attorneys for Applicant

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Substitute for form 1449/PTO			Complete if Known	
			Application Number	11/605,488-Conf. #5227
INFORMATION DISCLOSURE STATEMENT BY APPLICANT			Filing Date	November 29, 2006
			First Named Inventor	Ralph M. Hungerpiller
			Art Unit	3628
			Examiner Name	I. N. Borissov
			Attorney Docket Number	031073.00001-US03/US04
			Sheet	1
<i>(Use as many sheets as necessary)</i>				

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	CA	Address Change Service Application, Address Change Service Department, National Address Information Center.	
	CB	Letter from U. S. Postal Services addressed to Honorable Thomas C. Sawyer, November 24, 1993.	
	CC	Letter from U.S. House of Representatives addressed to Honorable Marvin Runyon, October 5, 1993.	
	CD	Letter from U.S. Postal Service addressed to Managers, Sales (Area), December 20, 1994.	
	CE	Letter from U.S. Postal Service, Customer and Automation Service Department, August 28, 1991.	
	CF	Letter from U.S. Postal Service, National Customer Support Center, August 8, 1996.	
	CG	Postal Automated Redirection System - The USPS Solution, 13th International Conference on Postal Automation, May 23-28, 1999.	
	CH	The Federal Register, Volume 62, Number 60, pp. 15055-15065, March 28, 1997.	
	CI	United States Postal Service, Your Guide to Address Change Services, pp. 1-25, May 1, 1991.	

Examiner Signature	Date Considered
--------------------	-----------------

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 809. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language translation is attached.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				<i>Complete if Known</i>		
				Application Number	11/605,488-Conf. #5227	
				Filing Date	November 29, 2006	
				First Named Inventor	Ralph M. Hungerpiller	
				Art Unit	3628	
				Examiner Name	I. N. Borissov	
Sheet	2	of	2	Attorney Docket Number	031073.00001-US03/US04	

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	CJ	United States Postal Service, Address Change Service, Addendum to Publication 8 Address Change Service, Publication 8, September 1998.	
	CK	United States Postal Service, Address Change Service, Creative Solutions for Your Business Needs, News Briefs, Publication 8, July 1990.	
	CL	United States Postal Service, Address Change Service, Third-Class Address Change Service, September 13, 1988.	
	CM	United States Postal Service, <i>Draft</i> Information-Based Indicia Program (IBIP) Performance Criteria for Information-Based Indicia and Security Architecture for Closed IBI Postage Metering Systems (PCIBI-C), January 12, 1999.	
	CN	United States Postal Service, National Customer Support Center, Move Update, pp. 1-12, April 1997.	
	CO	United States Postal Service, Postal Bulletin, Second-Generation Address Change Service, PB 21798, September 19, 1991.	
	CP	United States Postal Service, The Mallroom Companion, Volume 2, Number 2, pp. 1-8, February 1997.	

Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

In re Merged Reissue and Reexamination of:
Application No. 90/008,470
Application No. 11/602,488

Attorney Docket No.: 031073.00001-US04
Attorney Docket No.: 031073.00001-US03

Certificate of Service

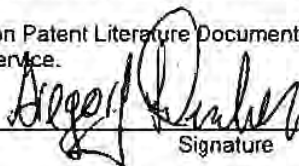
Pursuant to 37 C.F.R. § 1.248, I certify that the following documents were served by first-class mail on the following counsel of record for third party reexamination requester:

Drew S. Hamilton
Knobbe, Martens, Olson & Bear, LLP
550 West C Street, Suite 1200
San Diego, CA 92101

on this 9 day of November 2009
Date

Copies of the following documents were served:

1. Transmittal Letter;
2. Fee Transmittal;
3. Petition for Extension of Time under 37 C.F.R. § 1.136(a);
4. Request for Continued Examination Transmittal;
5. Amendment under 37 C.F.R. §§ 1.116 and 1.173;
6. Interview Substance Statement;
7. Interview Summary;
8. Supplemental Information Disclosure Statement;
9. PTO/SB/08a;
10. Sixteen (16) Non Patent Literature Documents; and
11. Certificate of Service.



Signature

Gregory S. Discher

Typed or printed name of person signing Certificate

42,488
Registration Number, if applicable

(202) 662-5485
Telephone Number



71338 U.S. PTO



11/09/09

Re-Exam

Docket No.: 031073.00001-US03/US04
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:
Ralph M. Hungerpiller et al.

Reissue Application No.: 11/605,488 Group Art Unit: 3628
Reexamination Application No.: 90/008,470 Examiner: I. N. Borissov

Corresponding to U.S. Patent No. 6,826,548

For: SYSTEM AND METHOD FOR PROCESSING
RETURNED MAIL

TRANSMITTAL LETTER

MS Reissue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:

1. Fee Transmittal;
2. Petition for Extension of Time under 37 C.F.R. § 3.73(b);
3. Request for Continued Examination Transmittal;
4. Amendment under 37 C.F.R. §§ 1.116 and 1.173 (in triplicate);
5. Interview Substance Statement;
6. Interview Summary;
7. Supplemental Information Disclosure Statement;

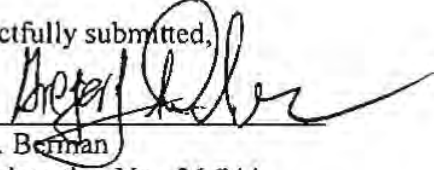
8. PTO/SB/08a;
9. Sixteen (16) Non Patent Literature Documents;
10. Certificate of Service; and
11. Return receipt postcard.

The Director is hereby authorized to charge \$940.00 to cover the \$810.00 Request for Continued Examination fee, and \$130.00 for the one month extension of time fee, as well as any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0740, under Docket No. 031073.00001-US03/US04.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740.

Dated: November 9, 2009

Respectfully submitted,

By 
Paul J. Berman

Registration No.: 36,744

Gregory S. Discher

Registration No.: 42,488

COVINGTON & BURLING LLP

1201 Pennsylvania Avenue, N.W.

Washington, DC 20004-2401

(202) 662-6000

Attorneys for Applicants

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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2009		Complete if Known		
		Application Number	11/605,488-Conf. #5227	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Filing Date	November 29, 2006	
		First Named Inventor	Ralph M. Hungerpiller	
		Examiner Name	I. N. Borissov	
		Art Unit	3628	
TOTAL AMOUNT OF PAYMENT	(\$)	940.00	Attorney Docket No.	031073.00001-US03/US04

METHOD OF PAYMENT (check all that apply)

Check
 Credit Card
 Money Order
 None
 Other (please identify): _____

Deposit Account
 Deposit Account Number: 50-0740
 Deposit Account Name: Covington & Burling LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below
 Charge fee(s) indicated below, except for the filing fee

Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17
 Credit any overpayments

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	330	165	540	270	220	110	
Design	220	110	100	50	140	70	
Plant	220	110	330	165	170	85	
Reissue	330	165	540	270	650	325	
Provisional	220	110	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	52	26
Each independent claim over 3 (including Reissues)	220	110
Multiple dependent claims	390	195

Total Claims Extra Claims Fee (\$) Fee Paid (\$) Multiple Dependent Claims
114 114 or HP x = Fee (\$) Fee Paid (\$)
 HP = highest number of total claims paid for, if greater than 20

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)
9 9 or HP x = Fee (\$) Fee Paid (\$)
 HP = highest number of independent claims paid for, if greater than 3.

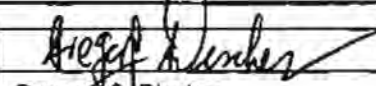
3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(c)), the application size fee due is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	- 100 = _____	/50 = _____ (round up to a whole number) x _____	= _____	= _____

4. OTHER FEE(S)

Description	Fee (\$)	Fees Paid (\$)
Non-English Specification,	\$130 fee (no small entity discount)	
Other (e.g., late filing surcharge):	1251 Extension for response within first month	130.00
	1801 Request for continued examination (RCE) (see 37 ...)	810.00

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	42,488
Name (Print/Type)	Gregory S. Discher	Telephone	(202) 662-5485
		Date	November 9, 2009



11/09/09

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) FY 2009 <i>(Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4810).)</i>		Docket Number (Optional) 031073.00001-US03/US04																									
Application Number 11/605,488-Conf. #5227		Filed November 29, 2006																									
For SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL																											
Art Unit 3628		Examiner I. N. Borissoy																									
<p>This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.</p> <p>The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):</p> <table style="width:100%; border-collapse: collapse;"> <thead> <tr> <th style="width:50%;"></th> <th style="text-align: center; border-bottom: 1px solid black;">Fee</th> <th colspan="2" style="text-align: center; border-bottom: 1px solid black;">Small Entity Fee</th> </tr> </thead> <tbody> <tr> <td><input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1))</td> <td style="text-align: center;">\$130</td> <td style="text-align: center;">\$65</td> <td style="text-align: center;">\$ 130.00</td> </tr> <tr> <td><input type="checkbox"/> Two months (37 CFR 1.17(a)(2))</td> <td style="text-align: center;">\$490</td> <td style="text-align: center;">\$245</td> <td style="text-align: center;">\$ _____</td> </tr> <tr> <td><input type="checkbox"/> Three months (37 CFR 1.17(a)(3))</td> <td style="text-align: center;">\$1110</td> <td style="text-align: center;">\$555</td> <td style="text-align: center;">\$ _____</td> </tr> <tr> <td><input type="checkbox"/> Four months (37 CFR 1.17(a)(4))</td> <td style="text-align: center;">\$1730</td> <td style="text-align: center;">\$865</td> <td style="text-align: center;">\$ _____</td> </tr> <tr> <td><input type="checkbox"/> Five months (37 CFR 1.17(a)(5))</td> <td style="text-align: center;">\$2350</td> <td style="text-align: center;">\$1175</td> <td style="text-align: center;">\$ _____</td> </tr> </tbody> </table> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number <u>50-0740</u>.</p> <p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p>I am the <input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration Number <u>42,488</u></p> <p><input type="checkbox"/> attorney or agent under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p style="text-align: center;"> _____ Signature</p> <p style="text-align: center;">November 9, 2009 _____ Date</p> <p style="text-align: center;">Gregory S. Discher _____ Typed or printed name</p> <p style="text-align: right;">(202) 662-5485 11/16/2009 11:00 AM 588748 9800478 Telephone Number</p> <p style="text-align: right;">01 EC:1251 130 00 00</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.</p>					Fee	Small Entity Fee		<input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$130	\$65	\$ 130.00	<input type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$490	\$245	\$ _____	<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$1110	\$555	\$ _____	<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$1730	\$865	\$ _____	<input type="checkbox"/> Five months (37 CFR 1.17(a)(5))	\$2350	\$1175	\$ _____
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<input type="checkbox"/> Five months (37 CFR 1.17(a)(5))	\$2350	\$1175	\$ _____																								



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/605,488	11/29/2006	Ralph Mitchell Hungerpillar	031073.00001-11S03	5227
26853 7590 02/17/2010 COVINGTON & BURLING, LLP ATTN: PATENT DOCKETING 1201 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004-2401			EXAMINER BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3628	
			MAIL DATE	DELIVERY MODE
			02/17/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 11/605,488	Applicant(s) HUNGERPILLER ET AL.	
	Examiner IGOR BORISSOV	Art Unit 3628	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 November 2009.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-39,42-62 and 64-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-39,42-62 and 64-114 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/09/2009 has been entered.

Response to Amendment

Amendment received on 11/09/2009 is acknowledged and entered. Claims 40, 41, 63 have been canceled. Claims 1, 14, 25, 32, 39, 48, 49, 53, 57, 66, 67, 71, 72, 75, 80, 83, 87, 88, 93, 94, 97, 101, 104, 105, 108, and 109 have been amended. Claims 1-39, 42-62, 64 -114 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12, 14-21, 23, 25-30, 32-39, 42-49, 51, 54-62, 64-67, 69, 72-85, 88-109, 11, 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postal Automated Redirection System – The USPS Solution (USPS Solution) in view of Second Generation Address Change Service (Second Generation) (See: IDS of 11/09/2009).

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USPS Solution, which appears to be published in May 1999, teaches:

Independent Claims

Claim 1

encoding data including intended recipient identification information on each of a plurality of mail items from a sender prior to mailing; (emphases added):

Page 2, 1st ¶:

In the past ten years, Optical Character Recognition (OCR) technology and the Remote Barcoding System (RBCS) for OCR read rejects have been fully deployed in our letter mail environment. Our automation program now gives us the capability to barcode and sort nearly all letter mail to the carrier route walk sequence, utilizing an 11 digit delivery point code. Processing technology now can be developed for potential redirection identification during initial processing, staging the physical mail, using our RBCS strategies to direct images for further computer or manual recognition, and print, label and sort redirection mail at high speed.

Page 3, 2nd ¶:

In the United States, an 11-digit numeric code uniquely identifies each delivery point in the country.

diverting items identified for redirecting into a redirection process;

Page 3, 2nd ¶:

The key to a point of entry solution for redirection is recognizing a potential redirection mailpiece and obtaining 'confirmation' that a mailpiece is in fact to be redirected. In the United States, an 11-digit numeric code uniquely identifies each delivery point in the country. For redirection confirmation, the delivery point barcode and the name of the customer as addressed must be positively confirmed with an entry in the national "Change Of Address" (COA) database. If an entry exist, there is confirmation and the mailpiece can be diverted into the redirection process, which allows processing to the final, proper destination without delay. Without this crucial step, the mailpiece must be processed to the customer addressed destination, manually identified and handled by the carrier, then rehandled and sent to the redirection process in the local plant. Point of entry redirection avoids the intermediate, inefficient, time and labor consuming step in delivery.

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scanning and decoding the encoded data, subsequent to receiving the items identified for redirecting, to identify intended recipients having incorrect addresses;

Page 3, 3rd and 4th ¶¶:

In a Processing and Distribution Center (P&DC), every effort is made to process letter mail with automated equipment. More than 35% of the mail that enters the mailstream will pass the scanning and OCR functions that provide the ability to automatically derive the 11digit barcode. (The other 65% arrive as prebarcoded by mailers and are directed to barcode sorters.) PARS will utilize the Advanced Facer Canceled / Optical Character Reader- Input Subsystem (AFCS/OCR-ISS) and MLOCR-ISS (Multiline Optical Character Reader - Input Subsystem) to scan the images and process the address line data. (See Figure 1)

With PARS, the automation equipment will process the customer name when the delivery point postcode is associated with a COA notification. The ISS's receive a bitmap from the National Customer Service Center (NCSC) via the Change of Address Record Server (CARS) that contains the 11 digit delivery point postcode / COA correlation. When the mailpiece is flagged as potential COA, the customer name OCR read result is compared to the expected customer name provided by CARS (containing customer name records) and a confirmation is

determining, subsequent to decoding, if the sender wants a corrected address provided; and

if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients for the sender to update the sender's mailing address files.

Page 2, 5th ¶:

Another service to help update mailer directory lists is the Address Correction Service (ACS). An endorsement "Address Correction Service Requested" is applied to the return address on letter mail when the mailer wants to be notified that a customer has moved. With this endorsement on a mailpiece, the USPS responds to the mailer with a new address when redirected mail is first encountered in our system. Either electronic or reply card response is available to the customer.

While USPS Solution teaches items identified for redirecting, USPS Solution does not explicitly teach that said items identified for redirecting are undeliverable items, and while teaching diverting said items identified for redirecting into a redirection

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process, it does not explicitly teach receiving those items of the plurality of mail items that are returned as being undeliverable, which is disclosed in Second Generation, which appears to be published in May 1999 (See: Page 4 (front page), 1st and 2nd ¶):

Delivery unit and Computerized Forwarding System (CFS) employees should follow the process for handling Address Change Service (ACS) mail. ACS is a national program primarily designed to provide First-, second-, third-, and fourth-class ACS mailers with address correction information electronically, rather than by hard copy—Forms 3547, Notice to Mailer of Correction in Address, and 3579, Undeliverable 2nd, 3rd, 4th Class Matter. They also expect to pay 20 cents for each electronic correction, rather than the hard copy price of 35 cents.

Delivery units should submit undeliverable-as-addressed ACS mail, bundled by reason for return, to the CFS unit. They should identify bundles by the one character computer code listed below. Mail received with return reasons other than those listed will be returned to the delivery unit for proper handling. Carriers should not make any corrections to the address on the mailpiece. Nixie (difficult to deliver) mail will be processed by return reason code, in the CFS unit without regard to the carrier route number.

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify USPS Solution to include receiving those items of the plurality of mail items that are returned as being undeliverable, as disclosed in Second Generation, because it would advantageously allow to be in compliance with the requirements and procedures of the Second Generation Address Change Service. Furthermore, it would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify USPS Solution to include receiving those items of the plurality of mail items that are returned as being undeliverable, as disclosed in Second Generation, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have

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recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claim 14. USPS Solution teaches:

diverting undeliverable items into a redirection process Page 3, 2nd ¶;
reading the encoded intended recipient identification information from the collected returned mail items to identify intended recipients having incorrect addresses (Page 3, 3rd and 4th ¶¶);

determining from the reading if the subscriber wants a corrected address provided for the returned mail items (Page 2, 5th ¶);

if the subscriber wants a corrected address provided, electronically gathering updated recipient identification information including an updated address of the intended recipient (Page 2, 5th ¶);

electronically transmitting updated recipient identification information to the subscriber for updating of a subscriber's address database (Page 2, 5th ¶).

While USPS Solution teaches diverting undeliverable items into a redirection process, it does not explicitly teach "collecting the returned mail items, not delivered to an intended recipient, at a processing location", which feature is disclosed in Second Generation, which appears to be published in May 1999 (See: Page 4 (front page), 1st and 2nd ¶).

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify USPS Solution to include receiving those items of the plurality of mail items that are returned as being undeliverable, as disclosed in Second Generation, because it would advantageously allow to be in compliance with the requirements and procedures of the Second Generation Address Change Service. Furthermore, it would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify USPS Solution to include receiving those items of the plurality of mail items that are returned as being undeliverable, as disclosed in Second Generation, since the claimed invention is merely a combination of

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old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claim 25. USPS Solution teaches:

program instructions that capture optically scanned encoded data including intended recipient identification information and that capture data indicating whether a subscriber wants a corrected address to be provided for the intended recipient on each item identified for redirecting and identify intended recipients having incorrect addresses (Page 3, 3rd and 4th ¶¶; Page 2, 5th ¶);

program instructions that store the captured data in a data file (Page 2, 4th ¶);

program instructions that update the stored data, based on the data indicating whether a subscriber wants a corrected address provided, to incorporate an updated address of the intended recipient of each item of undeliverable mail (Page 2, 5th ¶; Page 3, 3rd and 4th ¶¶; Page 4, 1st ¶);

program instructions that transmit the updated intended recipient address information to a subscriber electronically to update the address files of the subscriber (Page 2, 5th ¶).

While USPS Solution teaches identifying mail items for redirecting, USPS Solution does not explicitly teach that said identified mail items for redirecting are identified as undeliverable mail, which is disclosed in Second Generation, (See: Page 4 (front page 2nd ¶). Further, Second Generation teaches a customer number (a Participant Code/ACS participant ID).

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify USPS Solution to include that said identified mail items for redirecting are identified as undeliverable mail, as disclosed in Second Generation, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

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separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 32, 39, 57, 75, 88 and 101. USPS Solution teaches:

receiving from a sender a plurality of mail items, each including an addressee and incorporating encoded data indicating whether the sender wants a corrected address to be provided for the addressee (Page 2, , 5th ¶; Page 3, 3rd ¶);

identifying mail items for redirecting (Page 2, , 5th ¶);

decoding the encoded data incorporated in at least one of the redirected mail items (Page 2, 5th ¶; Page 3, 3rd and 4th ¶¶; Page 4, 1st ¶);

determining if the sender wants a corrected address provided based on the decoded data; and (Page 2, 5th ¶);

if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files (Page 2, 4th and 5th ¶¶).

While USPS Solution teaches identifying mail items for redirecting, USPS Solution does not explicitly teach that said identifying step includes identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable, which is disclosed in Second Generation, (See: Page 4 (front page 2nd ¶). Further, Second Generation teaches a customer number (a Participant Code/ACS participant ID).

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify USPS Solution to include that said identifying step includes identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable, as disclosed in Second Generation, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

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Dependent Claims

Claims 2. Storing the decoded data in a data file; updating the stored data to correct the address of each intended recipient of the items of undeliverable mail; and delivering the updated data to a subscriber electronically for use in updating the mailing address files of the subscriber (Same reasoning as applied to independent claims).

Claims 3, 26. Said method, wherein the recipient identification information encoded on each mail item includes a name and an address associated with an intended recipient of the mail item (Same reasoning as applied to independent claims).

Claims 4, 15, 34, 46, 64, 95, 106. Loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories (USPS Solution; Page 3, 3rd ¶).

Claims 5, 16, 47, 65, 107. The plurality of categories includes a barcode not decoded category and a barcode decoded successfully category. The use of barcode/automation tools in mail processing is old and well known for the benefit of increasing efficiency of the mail processing.

Claims 6, 17. The step of scanning the encoded data on the undeliverable mail includes reading an optically encoded barcode on each item and decoding the barcode to determine the intended recipient identification information associated with an intended recipient of the item (USPS Solution; Page 3, 2nd-4th ¶¶).

Claims 7, 18. The step of generating an output file of the identified intended recipients from the scanned and decoded data in the optically encoded barcode (USPS Solution; Page 4, 1st ¶).

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Claim 8, 19. The step of transmitting the generated output file to a mailing address service provider in order to obtain an updated address for each intended recipient of an undeliverable mail item (Same reasoning as applied to independent claims).

Claims 9, 12, 20, 23, 28, 29, 33, 51, 69, 85, 111. The step of encoding data includes placing an optically encoded barcode on each of the plurality of mail items (USPS Solution; Page 4, 3rd ¶).

Claims 10, 21, 30. The optically encoded bar code is placed on either the front side or the back side of each mail item (a well known feature for the benefit of increasing efficiency of mail processing).

Claims 27, 37, 38, 42-45, 48, 49, 54-56, 58-62, 66, 67, 72-74, 76-84, 88-94, 97, 99, 100, 102-105, 108, 109, 114. Same reasoning as applied to independent claims.

Claim 35. The scanner is a hand-held device (well-known feature for the benefit of convenience of operation).

Claim 36. The scanner is a mixed media optical character recognition (MLOCR) device (well-known feature).

Claims 11, 22, 31, 50, 68, 86, 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPS Solution in view of Second Generation and further in view of Petkovsek (US 6,371,521).

Claims 11, 22, 31, 50, 68, 86, 110. The combination of USPS Solution in view of Second Generation teaches all limitation of claims 11, 22, 31, 50, 68, 86, 110, except that the optically encoded bar code is placed in a return address section on each of the

Art Unit: 3628

plurality of mail items, which is disclosed in Petkovsek (Fig. 12, the return label 234, item 235).

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to include said feature, as disclosed in Petkovsek, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 13, 24, 52, 70, 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPS Solution in view of Second Generation and further in view of Pierce et al. (US 6,680,783).

Claims 13, 24, 52, 70, 112. The combination of USPS Solution in view of Second Generation teaches all limitation of claims 13, 24, 52, 70, 112, except that said barcode is a PDF417 barcode which is disclosed in Petkovsek teaching the use of PDF417 barcode for identification of mailing address (Fig. 3, item 330).

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to include said feature, as disclosed in Petkovsek, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 53, 71, 87, 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPS Solution in view of Second Generation and further in view of Postal Addressing Standards - Publication 28 (Publication 28).

Art Unit: 3628

Claims 53, 71, 87, 113. The combination of USPS Solution in view of Second Generation teaches all limitation of claims 53, 71, 87, 113, except that the encoded data is detectable with reference to either the front side or the back side of each of the plurality of mail items, which is suggested in Publication 28 of 11-2000, disclosing address formatting guidance including location of addresses and distances of said location to edges of a mailpiece (Page 57).

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to include said feature, as disclosed in Publication 28, because it would advantageously allow to be in compliance with USPS regulations. Furthermore, it would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to include said feature, as disclosed in Publication 28, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Response to Arguments

Applicant's arguments with respect to claims 1-39, 42-62, 64-114 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

Art Unit: 3628

supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

02/12/2010

Notice of References Cited	Application/Control No. 11/605,488	Applicant(s)/Patent Under Reexamination HUNGERPILLER ET AL.	
	Examiner IGOR BORISSOV	Art Unit 3628	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,371,521	04-2002	Petkovsek, Glenn	283/67
*	B	US-6,680,783	01-2004	Pierce et al.	358/1.14
*	C	US-7,647,231	01-2010	Kuebert et al	705/1
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			


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	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Postal Addressing Standards - Publication 28; 11-2000; Pages 129.
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Search Notes 	Application/Control No. 11605488	Applicant(s)/Patent Under Reexamination HUNGERPILLER ET AL.
	Examiner IGOR BORISSOV	Art Unit 3628

SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES		
Search Notes	Date	Examiner
Key terms search on EAST	02/11/2010	IB
NPL search	02/11/2010	IB

INTERFERENCE SEARCH			
Class	Subclass	Date	Examiner





PTO/SB/08a (02-09)

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Substitute for form 1449/PTO			<i>Complete if Known</i>		
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>			Application Number	11/605,488-Conf. #5227	
			Filing Date	November 29, 2006	
			First Named Inventor	Ralph M. Hungerpiller	
			Art Unit	3628	
			Examiner Name	I. N. Borissov	
Sheet	1	of	1	Attorney Docket Number	031073.00001-US03/US04

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number Number-Kind Code ² (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

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Examiner Initials*	Cite No. ¹	Foreign Patent Document Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T ⁴

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	CA	United States Postal Service, Postal Bulletin, PB 22042, January 25, 2001, pp. 1-112.	
	CB	United States Postal Service, Postal Bulletin, PB 22083, August 22, 2002, pp. 1-80.	
	CC	United States Postal Service, Postal Bulletin, PB 21993, March 11, 1999, pp. 1-88.	
	CD	United States Postal Service, Postal Bulletin, PB 22038, November 30, 2000, pp. 1-176.	
	CE	United States Postal Service, Confirmation Services Technical Guide, Publication 91, May 2008, pp. 1-104.	
	CF	Mailpiece Quality Control (MQC) Program-Contents, Self-Study Guide Modules, September 2007, Modules 1-10 and Appendix A.	
	CG	United States Postal Service, National Customer Support Center, ACS Service, http://ribbs.usps.gov/index.cfm?page=acs ; pp. 1-2.	
	CH	United States Postal Service, DMM 507 Mailer Services, http://pe.usps.com/text/dmm300/507.htm#wp1223780 ; pp. 1-80.	
	CI	United States Postal Service, Postal Bulletin, PB 21934, December 5, 1996, pp. 1-56.	

Examiner Signature	/Igor Borissov/ (02/03/2010)	Date Considered	
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		Application Number	11/605,488-Conf. #5227		
		Filing Date	November 29, 2006		
		First Named Inventor	Ralph M. Hungerpiller		
		Art Unit	3528		
		Examiner Name	I. N. Borissov		
Sheet	1	of	1	Attorney Docket Number	031073.00001-US03/US04

U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
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	CB	United States Postal Service, Postal Bulletin, PB 22083, August 22, 2002, pp. 1-80.			
	CC	United States Postal Service, Postal Bulletin, PB 21993, March 11, 1999, pp. 1-88.			
	CD	United States Postal Service, Postal Bulletin, PB 22038, November 30, 2000, pp. 1-176.			
	CE	United States Postal Service, Confirmation Services Technical Guide, Publication 91, May 2008, pp. 1-104.			
	CF	Mailpiece Quality Control (MQC) Program-Contents, Self-Study Guide Modules, September 2007, Modules 1-10 and Appendix A.			
	CG	United States Postal Service, National Customer Support Center, ACS Service, http://nibbs.usps.gov/index.cfm?page=acs ; pp. 1-2.			
	CH	United States Postal Service, DMM 507 Mailer Services, http://pe.usps.com/text/dmm300/507.htm#wp1223780 ; pp. 1-80.			
	CI	United States Postal Service, Postal Bulletin, PB 21934, December 5, 1996, pp. 1-56.			

Examiner Signature	/Igor Borissov/ (02/03/2010)	Date Considered	
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				Filing Date	November 29, 2006	
				First Named Inventor	Ralph M. Hungerpiller	
				Art Unit	3628	
				Examiner Name	I. N. Borisso	
Sheet	1	of	2	Attorney Docket Number	031073.00001-US03/US04	

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	CA	Address Change Service Application, Address Change Service Department, National Address Information Center.			
	CB	Letter from U. S. Postal Services addressed to Honorable Thomas C. Sawyer, November 24, 1993.			
	CC	Letter from U.S. House of Representatives addressed to Honorable Marvin Runyon, October 5, 1993.			
	CD	Letter from U.S. Postal Service addressed to Managers, Sales (Area), December 20, 1994.			
	CE	Letter from U.S. Postal Service, Customer and Automation Service Department, August 28, 1991.			
	CF	Letter from U.S. Postal Service, National Customer Support Center, August 8, 1996.			
	CG	Postal Automated Redirection System - The USPS Solution, 13th International Conference on Postal Automation, May 23-28, 1999.			
	CH	The Federal Register, Volume 62, Number 60, pp. 15055-15065, March 28, 1997.			
	CI	United States Postal Service, Your Guide to Address Change Services, pp. 1-25, May 1, 1991.			

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				Application Number	11/605,488-Conf. #5227
				Filing Date	November 29, 2006
				First Named Inventor	Ralph M. Hungerpiller
				Art Unit	3628
				Examiner Name	I. N. Borissov
Sheet	2	of	2	Attorney Docket Number	031073.00001-US03/US04

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	CJ	United States Postal Service, Address Change Service, Addendum to Publication 8 Address Change Service, Publication 8, September 1998.	
	CK	United States Postal Service, Address Change Service, Creative Solutions for Your Business Needs, News Briefs, Publication 8, July 1990.	
	CL	United States Postal Service, Address Change Service, Third-Class Address Change Service, September 13, 1988.	
	CM	United States Postal Service, Draft Information-Based Indicia Program (IBIP) Performance Criteria for Information-Based Indicia and Security Architecture for Closed IBI Postage Metering Systems (PCIBI-C), January 12, 1999.	
	CN	United States Postal Service, National Customer Support Center, Move Update, pp. 1-12, April 1997.	
	CO	United States Postal Service, Postal Bulletin, Second-Generation Address Change Service, PB 21798, September 19, 1991.	
	CP	United States Postal Service, The Mailroom Companion, Volume 2, Number 2, pp. 1-8, February 1997.	

Examiner Signature	/Igor Borissov/ (02/03/2010)	Date Considered	
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,470	01/31/2007	6826548		2122

26853 7590 03/10/2010
COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/10/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,470.

PATENT NO. 6826548.

ART UNIT 3993.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

PTOL-485 (Rev.07-04)



Covington & Burling LLP
Attn: Patent Docketing
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401

(For Patent Owner)

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MAR 10 2010

CENTRAL REEXAMINATION UNIT

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

(For Requester)

In re Reissue Application :
of Hungerpiller et al. :
Application No. 11/605,488 :
Filed: November 29, 2006 :

**DECISION,
SUA SPONTE,
SEVERING MERGER OF
REISSUE AND REEXAMINATION
PROCEEDINGS**

In re Hungerpiller et al. :
Reexamination Proceeding :
Control No. 90/008,470 :
Filed: January 31, 2007 :
For: U.S. Patent No. 6,826,548 :

The above-captioned merged reissue and reexamination proceeding are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the merger under 37 CFR 1.565(d) of the reissue and reexamination proceeding should be severed at this time.

REVIEW OF FACTS

1. U.S. patent No. 6,826,548 (the '548 patent) issued on November 30, 2004, with 38 claims.
2. An application for reissue of the '548 patent, assigned application No. 11/605,488 (the '488 application) was filed by the patent owner on November 29, 2006.
3. A request for reexamination was filed by a third party requester on January 31, 2007, and was assigned control No. 90/008,470 (the '470 proceeding).

4. Reexamination was ordered for the '470 proceeding on April 17, 2007.
5. On May 16, 2007, a petition under 37 CFR 1.182 to merge the reissue application and reexamination proceeding was filed by the patent owner in the '488 application.
6. On June 1, 2007, a decision was granted to merge the reissue application and reexamination proceedings.
7. The merged proceeding progressed to the point where, on November 9, 2009, a Request for Continued Examination (RCE) was filed by patent owner.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

"If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings.

Under 35 USC 305:

All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

DECISION SEVERING THE MERGED REISSUE AND REEXAMINATION PROCEEDINGS

Pursuant to 35 U.S.C. 305, reexamination proceedings must be conducted with "special dispatch". The filing of an RCE delays the reexamination proceeding, and the resolution of the substantial new question of patentability raised by the reexamination request, contrary to statutory mandate. Further, the filing of the RCE is effective for the reissue proceeding, but not for the reexamination proceeding; and it is tantamount to a filing of a reissue application after a

reexamination proceeding is well advanced, in which case the proceedings would generally not be merged and a decision suspending the reissue application would be issued. Accordingly, the merged proceedings must be severed to permit the reexamination proceeding to proceed to conclusion with special dispatch.

In order to prevent inconsistent, and possibly conflicting, responses and amendments from being introduced into the multiple proceedings on behalf of the patent owner, it is not appropriate to conduct the now-severed examination of the reissue and reexamination proceedings separately, and at the same time as to the same patent. Rather, prosecution of the reissue application is hereby suspended until the conclusion of the reexamination proceeding.

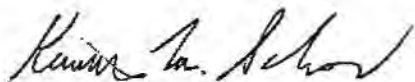
The reissue application suspension shall remain in effect until the conclusion of the '8470 proceeding by the issuance and publication of the reexamination certificate. To the extent that 37 CFR 1.570(d) would preclude prosecution of the '488 reissue application in the event that the prosecution in the '8470 proceeding results in cancellation of all claims of the '548 patent, patent owner has filed the '488 reissue application prior to publication of a reexamination certificate for the '548 patent. Therefore, patent owner would be entitled to file a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d) to request that prosecution of the reissue patent could continue, even if a reexamination certificate should issue canceling all patent claims (and not adding any new claims to the patent).

The patent owner is given ONE (1) MONTH from this decision, to revise the claims as patent owner deems appropriate in view of the differences in reexamination and reissue, after which, a new Office action will be issued for the reexamination proceeding. If broadened claims are not deleted, they will be rejected under 35 U.S.C. 305, which prohibits broadened claims in reexamination. Any rejection directed to the reissue application that does not apply in reexamination will be withdrawn in the new Office action. As pointed out above, the reissue application prosecution is being suspended, because the filing of the RCE of the reissue application is well after substantial prosecution has been conducted in the original reexamination proceeding.

CONCLUSION

1. The merged proceeding of reissue application number 11/605,488 and reexamination control No. 90/008,470 **are hereby severed**.
2. Prosecution of the reissue application is hereby suspended until the conclusion of the '470 reexamination proceeding by the issuance and publication of a reexamination certificate.

3. After the issuance and publication of a reexamination certificate, patent owner may call up the reissue application for action, by notifying the Office of such completion. The patent owner may include an amendment of the reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding. In the event that the prosecution in the '8470 proceeding results in cancellation of all claims of the '548 patent, the patent owner would need to file a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d) to request that prosecution of the reissue patent continue (see discussion above).
4. Jurisdiction over the reexamination and reissue is returned to Technology Center 3600.
5. Telephone inquires related to this decision should be directed to the undersigned at 571-272-7710.
6. Telephone inquires related to this matter should be directed to Teri Luu, Special Programs Examiner, at 571-272-7045.



Kenneth M. Schor
Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration.



APR - 8 2010

Covington & Burling LLP
Attn: Patent Docketing
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401

(For Patent Owner)

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

(For Requester)

In re Hungerpiller et al.
Reexamination Proceeding
Control No. 90/008,470
Filed: January 31, 2007
For: U.S. Patent No. 6,826,548

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**Letter Regarding
Restart of Period for Reply**

REVIEW OF FACTS

1. U.S. patent No. 6,826,548 (the '548 patent) issued on November 30, 2004, with 38 claims.
2. An application for reissue of the '548 patent, assigned application No. 11/605,488 (the '488 application) was filed by the patent owner on November 29, 2006.
3. A request for reexamination was filed by a third party requester on January 31, 2007, and was assigned control No. 90/008,470 (the '470 proceeding).
4. Reexamination was ordered for the '470 proceeding on April 17, 2007.
5. On May 16, 2007, a petition under 37 CFR 1.182 to merge the reissue application and reexamination proceeding was filed by the patent owner in the '488 application.
6. On June 1, 2007, a decision was granted to merge the reissue application and reexamination proceedings.
7. On November 9, 2009, a Request for Continued Examination (RCE) was filed by patent owner.

8. On February 17, 2010, a Non-Final Office action, setting forth a three month shortened statutory period for reply, was issued in response to the RCE. The Office action indicated that extensions of time under the provisions of 37 CFR 1.136(a) may be available.
9. On March 10, 2010, a decision, sua sponte, was made to sever the reissue and reexamination proceedings. Patent owner was given one month from the decision, to revise the claims as patent owner deems appropriate in view of the differences in reexamination and reissue proceedings.

DISCUSSION

35 U.S.C. 305 requires that all reexamination proceedings under this section be conducted with special dispatch within the Office. Pursuant to 37 CFR § 1.550(b), the patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. Additionally, pursuant to MPEP § 2265, *ex parte* prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response. Normally, a shortened statutory period of 2 months will be set for response to Office actions, see MPEP § 2263. Since the 3-month shortened statutory period for reply set in the February 17, 2010 Office action is contrary to the time period for reply used in reexamination proceedings, the time period to reply to the February 17, 2010 Office action is hereby reset to 2 months from the mailing date of this communication. Additionally, the time period provided to patent owner in the March 10, 2010 communication is also reset to run concurrently with this new time period (i.e., two months from the mailing date of this communication) so as to eliminate the two different time periods against patent owner.

An extension of time in an *ex parte* reexamination proceeding may be requested pursuant to 37 CFR 1.550(c). Accordingly, a request for an extension (A) must be filed on or before the day on which action by the patent owner is due and (B) must set forth sufficient reason for the extension, and (C) must be accompanied by the petition fee set forth in 37 CFR 1.17(g).

Telephone inquiries related to this communication should be directed to Teri P. Luu, Quality Assurance Specialist, at (571) 272-7045.



Wynn Coggins, Director
Patent Technology Center 3600
(571) 272-5350

Docket No.: 031073.00001-US04
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ralph M. Hungerpiller et al.

Control No.: 90/008,470

Confirmation No.: 5227

Filed: January 31, 2007

Group Art Unit: 3628

Corresponding to U.S. Patent No. 6,826,548

Examiner: I. N. Borissov

For: SYSTEM AND METHOD FOR PROCESSING
RETURNED MAIL

TRANSMITTAL LETTER

MS *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:


1. Fee Transmittal;
2. Amendment Transmittal Letter;
3. Response by Patent Owner to Office Action in Ex Parte Reexamination;
4. Patent Owner's Statement of the Interview Under M.P.E.P. § 2281; and
5. Certificate of Service.

The Director is hereby authorized to charge \$2,476.00 for the additional claims fee, as well as any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0740, under Docket No. 031073.00001-US04.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740.

Dated: June 8, 2010

Respectfully submitted,

By 
Paul J. Berajah

Registration No.: 36,744

Gregory S. Discher

Registration No.: 42,488

COVINGTON & BURLING LLP

1201 Pennsylvania Avenue, N.W.

Washington, DC 20004-2401

(202) 662-6000

Attorneys for Applicants

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2009		Complete if Known		
		Application Number	90/008,470-Conf. #5227	
		Filing Date	January 31, 2007	
		First Named Inventor	Ralph M. Hungerpiller	
		Examiner Name	I. N. Borissov	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Art Unit	3628	
TOTAL AMOUNT OF PAYMENT	(\$)	2,476.00	Attorney Docket No.	031073.00001-US04

METHOD OF PAYMENT (check all that apply)

Check
 Credit Card
 Money Order
 None
 Other (please identify): _____

Deposit Account
 Deposit Account Number: 50-0740
 Deposit Account Name: Covington & Burling LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below
 Charge fee(s) indicated below, except for the filing fee

Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17
 Credit any overpayments

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	330	165	540	270	220	110	_____
Design	220	110	100	50	140	70	_____
Plant	220	110	330	165	170	85	_____
Reissue	330	165	540	270	650	325	_____
Provisional	220	110	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	52	26
Each independent claim over 3 (including Reissues)	220	110
Multiple dependent claims	390	195

Total Claims Extra Claims Fee (\$) Fee Paid (\$) Multiple Dependent Claims
 132 - 114 or 130 = 18 x 52.00 = 936.00 Fee (\$) Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)
 16 - 9 or HP = 7 x 220.00 = 1,540.00

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

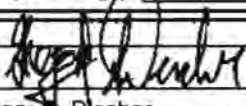
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	- 100 = _____	/50 = _____ (round up to a whole number) x _____	_____	_____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): _____

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	42,488
Name (Print/Type)	Gregory S. Discher	Telephone	(202) 662-5485
		Date	June 8, 2010

AMENDMENT TRANSMITTAL LETTER

Docket No.
031073.00001-US04

Control No. 90/008,470-Conf. #5227	Filing Date January 31, 2007	Examiner I. N. Broissoy	Art Unit 3628
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Applicant(s): Ralph M. Hungerpiller et al.

Invention: SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL


TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED						
	Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present		Rate	
Total Claims	132	- 114 =	18	x	52.00	936.00
Independent Claims	16	- 9 =	7	x	220.00	1,540.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>						
Other fee (please specify):						
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:						2,476.00

- Large Entity Small Entity
- No additional fee is required for this amendment.
- Please charge Deposit Account No. 50-0740 in the amount of \$ 2,476.00
- A check in the amount of \$ _____ to cover the filing fee is enclosed.
- Payment by credit card. Form PTO-2038 is attached.
- The Director is hereby authorized to charge and credit Deposit Account No. 50-0740 as described below. A duplicate copy of this sheet is enclosed.
- Credit any overpayment.
- Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17.



Gregory S. Discher
 Attorney/Agent Reg. No.: 42,488
 COVINGTON & BURLING LLP
 1201 Pennsylvania Avenue, N.W.
 Washington, DC 20004-2401
 (202) 662-5485

Dated: June 8, 2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reexamination of:

Application No.: 90/008,470

Confirmation No.: 5227

Filed: January 31, 2007

Art Unit: 3628

Corresponding to U.S. Patent No. 6,826,548

Examiner: I. N. Borissov

For: SYSTEM AND METHOD FOR PROCESSING
RETURNED MAIL

PATENT OWNER'S STATEMENT OF THE INTERVIEW
UNDER M.P.E.P. § 2281

MS *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with M.P.E.P. § 2281, Patentees provide the following statement of the in-person interview conducted on April 28, 2010 with Examiner Borissov, co-inventor Ralph Hungerpillar, and the undersigned. The interview was conducted prior to the response filed herewith to the outstanding Office Action dated February 17, 2010. A U.S. Patent and Trademark Office correspondence dated April 8, 2010 reset the time period to reply to the February 17, 2010 Office Action to 2 months from the date of mailing of the April 8, 2010 USPTO correspondence. In accordance with M.P.E.P. § 2281, this written statement is being timely filed as a separate part of the response filed herewith to the outstanding Office Action dated February 17, 2010.

No exhibit was shown and no demonstration was conducted. The claims discussed were independent claims 1 and 39. Two references cited in the February 17, 2010 Office Action were

discussed: i) Postal Automated Redirection System - The USPS Solution dated May 1999 (hereinafter "PARS"); and ii) Second-Generation Address Change Service dated September 19, 1991 (hereinafter "Second-Generation"). The arguments presented for the outstanding rejections in light of the amendments to claims 1 and 39 contained in the Informal Submission are presented below. The outcome of the interview was that no agreement was reached.

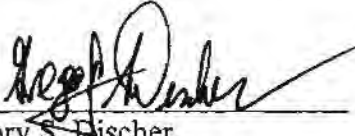
Rejection Under 35 U.S.C. § 103(a)

This rejection was traversed because proposed amended claim 1 requires encoding intended recipient identification information that includes the name and address of an addressee, as well as decoding the encoded data subsequent to receiving the returned mail items. This rejection was also traversed because the incorporation into PARS of returned mail processing as disclosed in Second-Generation would result in a new system, one very different from the system disclosed in PARS and one that operates in a very different manner from that taught by PARS. The rejection was also traversed because Second-Generation adds nothing of value to PARS, and would change the principle of operation of PARS. The rejection of claim 39 was traversed for the substantially the same reasons as claim 1. The undersigned indicated to Examiner Borissov the claim 39 does not include the "name and address" limitation recited in claim 1.

Dated: June 8, 2010

Respectfully submitted,

By


Gregory S. Discher

Registration No.: 42,488

COVINGTON & BURLING LLP

1201 Pennsylvania Avenue, N.W.

Washington, DC 20004-2401

(202) 662-6000

Attorney for Patentees

Certificate of Service

Pursuant to 37 C.F.R. § 1.248, I certify that the following documents were served by first-class mail on the following counsel of record for third party reexamination requester:

Drew S. Hamilton
Knobbe, Martens, Olson & Bear, LLP
550 West C Street, Suite 1200
San Diego, CA 92101

on this 8 day of June 2010
Date

Copies of the following documents were served:

1. Transmittal Letter;
2. Fee Transmittal;
3. Amendment Transmittal Letter;
4. Response by Patent Owner to Office Action in Ex Parte Reexamination;
5. Patent Owner's Statement of the Interview Under M.P.E.P. § 2281; and
6. Certificate of Service.



Signature

Gregory S. Discher

Typed or printed name of person signing Certificate

 42,488

Registration Number, if applicable

 (202) 662-5485

Telephone Number

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Hungerpillar et al.

Reexamination Proceeding:

Group Art Unit: 3628

Control No. 90/008,470

Examiner: I. N. Borissov

Filed: January 31, 2007

Corresponding to U.S. Patent No. 6,826,548

Office Action dated: February 17, 2010

USPTO Correspondence dated: April 8, 2010

For: SYSTEM AND METHOD FOR
PROCESSING RETURNED MAIL

**RESPONSE BY PATENT OWNER TO OFFICE ACTION
IN EX PARTE REEXAMINATION**

Mail Stop *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Response is filed in response to the Office Action dated February 17, 2010 and U.S. Patent and Trademark Office Correspondence dated April 8, 2010, captioned *Letter Regarding Restart of Period for Reply*. Claims 1-38 issued in U.S. Patent No. 6,826,548. After entry of the Response, claims 1, 2, 4-39, 42-62 and 64-136 are pending. Claims 1, 2, 4-39, 42-62 and 64-114 presently stand rejected, and claims 115-136 are newly added. In accordance with the requirements of 37 C.F.R § 1.530(j), this Response, including the new claims presented, does not enlarge the scope of the claims, and does not introduce any new matter.

A personal interview for this reexamination was conducted on April 28, 2010, at 12:30 PM with Examiner Borissov. The Patent Owner was represented by the undersigned. Co-inventor Ralph M. Hungerpillar was also present. The Patent Owner and his representative appreciate the

Application No.: 90/008,470

Filing Date: January 31, 2007

Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

courtesy extended by the Examiner in granting this interview and during the interview. An interview summary record is separately submitted herewith in accordance with M.P.E.P. § 2281.

Application No.: 90/008,470
Filing Date: January 31, 2007
Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

Amendments to the Claims in accordance with M.P.E.P. § 2250 I.B. are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 32 of this paper.

It is not believed that fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional fees are necessary to prevent abandonment of this application, then such fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740.

AMENDMENTS TO THE CLAIMS

1. (Currently Amended - Twice Amended) A method for processing a plurality of undeliverable mail items comprising the steps of:
 - encoding data including intended recipient identification information that includes the name and address of an addressee on each of a plurality of mail items from a sender prior to mailing;
 - receiving those items of the plurality of mail items that are returned as being undeliverable;
 - scanning and decoding the encoded data, subsequent to receiving the returned undeliverable mail items, on the items of undeliverable mail to identify intended recipients having incorrect addresses;
 - determining, subsequent to decoding, if the sender wants a corrected address provided; and if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients for the sender to update the sender's mailing address files.

2. (Original) The method for processing a plurality of undeliverable mail items of claim 1, further comprising the steps of:
 - storing the decoded data in a data file;
 - updating the stored data to correct the address of each intended recipient of the items of undeliverable mail; and
 - delivering the updated data to a subscriber electronically for use in updating the mailing address files of the subscriber.

3. (Canceled)

4. (Original) The method for processing a plurality of undeliverable mail items of claim 1 further comprising the step of loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories.

5. (Original) The method for processing a plurality of undeliverable mail items of claim 4 wherein the plurality of categories includes a barcode not decoded category and a barcode decoded successfully category.

6. (Original) The method for processing a plurality of undeliverable mail items of claim 1 wherein the step of scanning the encoded data on the undeliverable mail includes reading an optically encoded barcode on each item and decoding the barcode to determine the intended recipient identification information associated with an intended recipient of the item.

7. (Original) The method for processing a plurality of undeliverable mail items of claim 6 further comprising the step of generating an output file of the identified intended recipients from the scanned and decoded data in the optically encoded barcode.

8. (Original) The method for processing a plurality of undeliverable mail items of claim 7 further comprising the step of transmitting the generated output file to a mailing address service provider in order to obtain an updated address for each intended recipient of an undeliverable mail item.

9. (Original) The method for processing a plurality of undeliverable mail items of claim 1 wherein the step of encoding data includes placing an optically encoded barcode on each of the plurality of mail items.

10. (Original) The method for processing a plurality of undeliverable mail items of claim 9, wherein the optically encoded bar code is placed on either the front side or the back side of each mail item.

11. (Original) The method for processing a plurality of undeliverable mail items of claim 9, wherein the optically encoded bar code is placed in a return address section on each of the plurality of mail items.

12. (Original) The method for processing a plurality of undeliverable mail items of claim 9 wherein the barcode is a two-dimensional barcode.

13. (Original) The method for processing a plurality of undeliverable mail items of claim 12 wherein the two-dimensional barcode is a Portable Data File 417 (PDF417) barcode.

14. (Previously Presented) A method for processing returned mail items sent by a subscriber to a recipient, the returned mail items incorporating encoded intended recipient identification information, the method comprising the steps of:

collecting the returned mail items, not delivered to an intended recipient, at a processing location;

reading the encoded intended recipient identification information that includes the name and address of an addressee from the collected returned mail items to identify intended recipients having incorrect addresses;

determining from the reading if the subscriber wants a corrected address provided for the returned mail items;

if the subscriber wants a corrected address provided, electronically gathering updated recipient identification information including an updated address of the intended recipient; and

electronically transmitting updated recipient identification information to the subscriber for updating of a subscriber's address database.

15. (Original) The method for processing returned mail items of claim 14 further comprising the step of loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories.

16. (Original) The method for processing returned mail items of claim 15 wherein the plurality of categories includes a barcode not decoded category and a barcode decoded successfully category.

17. (Original) The method for processing returned mail items of claim 14 wherein the step of reading the encoded information includes scanning an optically encoded barcode on each item and decoding the barcode to determine identification information associated with the intended recipient of the item.

18. (Original) The method for processing returned mail items of claim 17 further comprising the step of generating an output file of the identified intended recipients from the scanned and decoded data in the optically encoded barcode.

19. (Original) The method for processing returned mail items of claim 18 further comprising the step of transmitting the generated output file to a mailing address service provider in order to obtain an updated address for each intended recipient of an undeliverable mail item.

20. (Original) The method for processing returned mail items of claim 14 wherein the encoded information is placed in an optically encoded barcode on each of the plurality of mail items.

21. (Original) The method for processing a plurality of undeliverable mail items of claim 20, wherein the optically encoded bar code is placed on either the front side or the back side of each mail item.

22. (Original) The method for processing a plurality of undeliverable mail items of claim 20, wherein the optically encoded bar code is placed in a return address section on each of the plurality of mail items.

23. (Original) The method for processing returned mail items of claim 20 wherein the barcode is a two-dimensional barcode.

24. (Original) The method for processing returned mail items of claim 23 wherein the two-dimensional barcode is a Portable Data File 417 (PDF417) barcode.

25. (Previously Presented) A computer readable medium containing a computer program product comprising instructions for controlling a computer system to process a plurality of undeliverable mail items, the computer program product comprising:

- program instructions that capture optically scanned encoded data including intended recipient identification information and that capture encoded data indicating whether a subscriber wants a corrected address to be provided for the intended recipient on each item of undeliverable mail and identify intended recipients having incorrect addresses;
- program instructions that store the captured [and identified intended recipient] data in a data file;
- program instructions that update the stored data, based on the data indicating whether a subscriber wants a corrected address provided, to incorporate an updated address of the intended recipient of each item of undeliverable mail; and
- program instructions that transmit the updated intended recipient address information to a subscriber electronically to update the address files of the subscriber.

26. (Original) The computer program product for controlling a computer system to process a plurality of undeliverable mail items of claim 25 wherein the encoded identification information includes a name and current address associated with the intended recipient of the mail item.

Application No.: 90/008,470

Filing Date: January 31, 2007

Title: *Ex Parte* Reexamination of Patent No. 6,826,548

27. (Original) The computer program product for controlling a computer system to process a plurality of undeliverable mail items of claim 25 further comprising program instructions that transmit the stored data file electronically to a mailing address service provider in order to obtain an updated address for each intended recipient of an undeliverable mail item.

28. (Original) The computer program product for controlling a computer system to process a plurality of undeliverable mail items of claim 25 wherein the encoded data is placed in an optically encoded barcode on each mail item.

29. (Original) The computer program product for controlling a computer system process a plurality of undeliverable mail items of claim 28 wherein the bar code is a two-dimensional bar code.

30. (Original) The computer program product for controlling a computer system to process a plurality of undeliverable mail items of claim 28, wherein the optically encoded bar code is placed on either the front side or the back side of each mail item.

31. (Original) The computer program product for controlling a computer system to process a plurality of undeliverable mail items of claim 28, wherein the optically encoded bar code is placed in a return address section on each of the plurality of mail items.

32. (Previously Presented) A system for processing a plurality of undeliverable mail items comprising:

a scanner for reading optically encoded data that includes intended recipient identification information and data indicating whether a sender wants a corrected address provided on each item of undeliverable mail returned subsequent to an attempted delivery;

a processor for operation of a computer program for decoding the scanned data, identifying the intended recipient identification information in the decoded data, writing the identified recipient identification information into a data file, and transferring to a sender

information for the identified intended recipient for the sender to update the sender's mailing address files subsequent to and based on determining that the sender wants a corrected address provided; and

a database for storing the data file containing identified recipient identification information.

33. (Original) The system for processing a plurality of undeliverable mail items of claim 32 wherein the optically encoded data contains a two-dimensional bar code.

34. (Original) The system for processing a plurality of undeliverable mail items of claim 32, further comprising a mail transport device for conveying the plurality of undeliverable items and sorting the undeliverable mail items into a plurality of bins.

35. (Original) The system for processing a plurality of undeliverable mail items of claim 32, wherein the scanner is a hand-held device.

36. (Original) The system for processing a plurality of undeliverable mail items of claim 32, wherein the scanner is a mixed media optical character recognition (MLOCR) device.

37. (Original) The system for processing a plurality of undeliverable mail items of claim 32 wherein the computer program includes instructions that update the stored data in the data file with an updated address associated with each of the intended recipients of the undeliverable mail items.

38. (Original) The system for processing a plurality of undeliverable mail items of claim 37 wherein the computer program includes instructions that deliver the updated address data to a subscriber in electronic form for use in updating the address files for the intended recipients.

39. (Previously Presented - Twice Amended) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including an addressee and incorporating encoded data indicating whether the sender wants a corrected address to be provided for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
determining if the sender wants a corrected address provided based on the decoded data; and
if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files.

40. (Canceled)

41. (Canceled)

42. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 39, further comprising returning the undeliverable mail items to a return mail service provider.

43. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 39, further comprising:
determining an updated mailing address for the at least one of the undeliverable mail items;
and
electronically transferring the updated mailing address to a transferee.

44. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 43, further comprising:

storing the updated mailing address in the data file; and
electronically transferring the data file to the transferee.

45. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 39, further comprising encoding information that allows a transferee of the undeliverable mail items to determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the undeliverable mail items.

46. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 39, further comprising loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories.

47. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 46, wherein the plurality of categories comprises a bar code not decoded category and a bar code decoded successfully category.

48. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 39, wherein the encoded data indicating whether the sender wants a corrected address provided comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

49. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 39, wherein the encoded data indicating whether the sender wants a corrected address provided is encoded in an optically encoded bar code.

50. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 49, wherein the optically encoded bar code is located in a return address section on each of the plurality of mail items.

51. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 49, wherein the optically encoded bar code is a two-dimensional bar code.

52. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 51, wherein the two-dimensional bar code is a Portable Data File 417 (PDF417) bar code.

53. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 39, wherein the encoded data is detectable with reference to either the front side or the back side of each of the plurality of mail items.

54. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 39, further comprising encoding and decoding a customer number associated with the sender.

55. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 54, further comprising generating a data file comprising the customer number.

56. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 55, further comprising obtaining an updated address for an intended recipient of the at least one of the undeliverable mail items, in accordance with the data indicating whether the sender wants a corrected address provided.

57. (Previously Presented - Twice Amended) A method for processing returned mail items sent by a sender to an intended recipient, the method comprising:

decoding, subsequent to mailing of the returned mail items, information indicating whether the sender wants a corrected address to be provided for the intended recipient, on at least one of the returned mail items;

obtaining an updated address of the intended recipient subsequent to determining that the sender wants a corrected address to be provided for the intended recipient; and electronically transmitting an updated address of the intended recipient to a transferee.

58. (Previously Presented) The method for processing returned mail items of claim 57, wherein the at least one of the returned mail items is an undeliverable as addressed mail item.

59. (Previously Presented) The method for processing returned mail items of claim 57, further comprising:

collecting the returned mail items at a processing location.

60. (Previously Presented) The method for processing returned mail items of claim 57, wherein the transferee is the sender.

61. (Previously Presented) The method for processing returned mail items of claim 57, wherein the transferee is a return mail service provider.

62. (Previously Presented) The method for processing returned mail items of claim 57, further comprising:

decoding an encoded customer number associated with the sender.

63. (Canceled)

64. (Previously Presented) The method for processing returned mail items of claim 57, further comprising loading the returned mail items on a transport mechanism for sorting into a plurality of categories.

65. (Previously Presented) The method for processing returned mail items of claim 64, wherein the plurality of categories comprises a bar code not decoded category and a bar code decoded successfully category.

66. (Previously Presented - Twice Amended) The method for processing returned mail items of claim 57, wherein the information indicating whether the sender wants a corrected address provided on at least one of the returned mail items comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

67. (Previously Presented - Twice Amended) The method for processing returned mail items of claim 57, wherein the information indicating whether the sender wants a corrected address to be provided is encoded in an optically encoded bar code.

68. (Previously Presented) The method for processing returned mail items of claim 67, wherein the optically encoded bar code is located in a return address section on each of the plurality of mail items.

69. (Previously Presented) The method for processing returned mail items of claim 67, wherein the optically encoded bar code is a two-dimensional bar code.

70. (Previously Presented) The method for processing returned mail items of claim 69, wherein the two-dimensional bar code is a Portable Data File 417 (PDF417) bar code.

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71. (Previously Presented- Twice Amended) The method for processing returned mail items of claim 57, wherein the information indicating whether the sender wants a corrected address to be provided is detectable with reference to either the front side or the back side of each of the returned mail items.

72. (Previously Presented - Twice Amended) The method for processing returned mail items of claim 57, wherein the information indicating whether the sender wants a corrected address to be provided indicates that the sender wants an updated address associated with the intended recipients to be provided.

73. (Previously Presented) The method for processing returned mail items of claim 72, further comprising generating a data file comprising a customer number associated with the sender.

74. (Previously Presented) The method for processing returned mail items of claim 73, further comprising transmitting the data file to an address service provider in order to obtain an updated address for an intended recipient of the at least one of the returned mail items.

75. (Previously Presented - Twice Amended) A computer program product residing on a computer readable medium comprising instructions for causing a computer to:
store decoded information indicating whether the sender wants a corrected address to be provided and a customer number, each associated with at least one of a plurality of mail items returned subsequent to mailing as being undeliverable;
determining from the decoded data that the customer wants a corrected address to be provided for at least one of the plurality of undeliverable mail items;
receive an updated address of an intended recipient for at least one of the undeliverable mail items, subsequent to and based upon the determining step; and
transmit the updated address to a transferee.

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76. (Previously Presented) The computer program product of claim 75, wherein the plurality of undeliverable mail items comprises undeliverable as addressed mail items.

77. (Previously Presented) The computer program product of claim 75, wherein the transferee is a sender of the at least one of the plurality of undeliverable mail items.

78. (Previously Presented) The computer program product of claim 75, wherein the transferee is a return mail service provider.

79. (Previously Presented) The computer program product of claim 75, further comprising instructions for causing a computer to:

store decoded data including intended recipient identification information from the at least one of the plurality of undeliverable mail items; and

update a data file to incorporate an updated address of an intended recipient of the at least one of the plurality of undeliverable mail items.

80. (Previously Presented - Twice Amended) The computer program product of claim 75, wherein the information indicating whether the sender wants a corrected address to be provided indicates whether to determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the plurality of undeliverable mail items.

81. (Previously Presented) The computer program product of claim 75, wherein the intended recipient comprises a name and an address associated with the intended recipient of the at least one of the plurality of undeliverable mail items.

82. (Previously Presented) The computer program product of claim 75, further comprising instructions that cause the computer to receive the updated address from a remote data repository.

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83. (Previously Presented - Twice Amended) The computer program product of claim 75, wherein the information indicating whether the sender wants a corrected address to be provided is incorporated in at least one of the undeliverable mail items comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

84. (Previously Presented) The computer readable medium of claim 75, wherein the encoded data is placed in an optically encoded bar code on the at least one of the plurality of undeliverable mail items.

85. (Previously Presented) The computer readable medium of claim 84, wherein the optically encoded bar code is a two-dimensional bar code.

86. (Previously Presented) The computer readable medium of claim 84, wherein the optically encoded bar code is placed in a return address section on each of the plurality of undeliverable mail items.

87. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 75, wherein the information indicating whether the sender wants a corrected address to be provided is detectable with reference to either the front side or the back side of each of the plurality of mail items.

88. (Previously Presented - Twice Amended) A system for processing a plurality of undeliverable mail items comprising:

- a first detector, wherein the first detector detects, subsequent to mailing the undeliverable mail items, encoded information on at least one of the plurality of undeliverable mail items indicating whether a sender wants a corrected address to be provided for at least one of the undeliverable mail items; and
- a processor that uses a computer program comprising instructions that cause the system to decode the information indicating whether the sender wants a corrected address to be provided.

89. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 88, further comprising encoding and decoding intended recipient identification information.

90. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 88, wherein the plurality of undeliverable mail items comprise undeliverable as addressed mail items.

91. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 89, wherein the instructions enable an updated address of an intended recipient to be sent to a transferee.

92. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 91, wherein the transferee is a return mail service provider.

93. (Previously Presented - Twice Amended) The system for processing a plurality of undeliverable mail items of claim 88, wherein the information indicating whether a sender wants a corrected address to be provided indicates whether to determine, directly or indirectly, an

updated address associated with an intended recipient of the at least one of the plurality of undeliverable mail items.

94. (Previously Presented - Twice Amended) The system for processing a plurality of undeliverable mail items of claim 88, wherein the encoded information indicating whether the sender wants a corrected address to be provided on the at least one of the undeliverable mail items comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

95. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 88, further comprising a mail transport device, wherein the mail transport device conveys the plurality of undeliverable mail items, and wherein the system sorts the plurality of undeliverable mail items into a plurality of bins.

96. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 88, wherein the first detector is a hand-held device.

97. (Previously Presented - Twice Amended) The system for processing a plurality of undeliverable mail items of claim 88, further comprising:
a second detector, wherein the second detector detects information for an intended recipient on the at least one of the plurality of undeliverable mail items; and
an updating processor that operates an updating computer program comprising instructions that direct the system, in accordance with the information indicating whether the sender wants a corrected address to be provided, to obtain updated address information for the intended recipient and to write the updated address information into the data file.

98. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 97, wherein the second detector comprises a mixed media optical character recognition (MLOCR) device.

99. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 97, wherein the updating computer program further comprises instructions that cause the system to transmit an updated address of an intended recipient of an undeliverable mail item to a transferee in electronic form.

100. (Previously Presented) The system for processing a plurality of undeliverable mail items of claim 97, wherein the first detector and the second detector are included in a detection unit.

101. (Previously Presented - Twice Amended) A method for processing a plurality of undeliverable mail items, comprising:
encoding information indicating whether the sender wants a corrected address to be provided for an intended recipient on a plurality of mail items;
arranging for a postal service provider to identify, as undeliverable mail items, mail items of the plurality of mail items that are undeliverable; and
arranging for a return mail service provider to decode, subsequent to identifying the undeliverable mail items, the information indicating whether the sender wants a corrected address to be provided for the intended recipient on at least one of the undeliverable mail items.

102. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 101, wherein the return mail service provider is the postal service provider.

103. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 101, wherein the plurality of undeliverable mail items comprise undeliverable as addressed mail items.

104. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 101, further comprising:

arranging for the return mail service provider to determine, as indicated by the information indicating whether the sender wants a corrected address to be provided, an updated mailing address for the at least one of the undeliverable mail items; and
arranging for the return mail service provider to store the updated mailing address in a data file.

105. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 101, wherein the information indicating whether the sender wants a corrected address to be provided indicates that the return mail service provider should determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the undeliverable mail items.

106. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 101, further comprising arranging for the return mail service provider to load the undeliverable mail items on a transport mechanism for sorting into a plurality of categories.

107. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 106, wherein the plurality of categories comprises an encoded mailpiece not decoded category and an encoded mailpiece decoded successfully category.

108. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 101, wherein the encoded information indicating whether the sender wants a corrected address to be provided on at least one of the undeliverable mail items comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

109. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 101, wherein the encoded information indicating whether the sender wants a corrected address to be provided is encoded in an optically encoded bar code.

110. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 109, wherein the optically encoded bar code is located in a return address section on each of the plurality of mail items.

111. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 110, wherein the optically encoded bar code is a two-dimensional bar code.

112. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 111, wherein the two-dimensional bar code is a Portable Data File 417 (PDF417) bar code.

113. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 101, wherein the encoded mailpiece address correction service type information is detectable with reference to either the front side or the back side of each of the plurality of mail items.

114. (Previously Presented) The method for processing a plurality of undeliverable mail items of claim 101, further comprising encoding customer identification information.

115. (New) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating output data that includes a customer number of the sender and at least a portion of
the decoded data;
determining if the sender wants a corrected address provided for intended recipients based
on the decoded data;
if the sender wants a corrected address provided, electronically transferring to the sender
information for the identified intended recipients that enable the sender to update the
sender's mailing address files; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

116. (New) The method of claim 115, further comprising transmitting the name and address
of the intended recipients to a mailing address service provider, subsequent to the determining
step, in order to obtain an updated address for each intended recipient of an undeliverable mail
item.

117. (New) The method of claim 115, wherein the encoded data further indicates a name
and address of the intended recipient

118. (New) The method of claim 115, wherein the plurality of mail items further include a
written return address that is not that address of the sender.

119. (New) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating output data that includes a customer number of the sender and at least a portion of
the decoded data;
determining, based on the decoding step, if the sender wants a corrected address provided
for intended recipients;
if the sender wants a corrected address provided, electronically transferring to the sender
information for the identified intended recipients that enable the sender to update the
sender's mailing address files, including a name change and a job change of intended
recipients; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

120. (New) The method of claim 119, further comprising transmitting the name and address
of the intended recipients to a mailing address service provider, subsequent to the determining
step, in order to obtain an updated address for each intended recipient of an undeliverable mail
item.

121. (New) The method of claim 119, wherein the encoded data further indicates a name
and address of the intended recipient

122. (New) The method of claim 119, wherein the plurality of mail items further include a
written return address that is not that address of the sender.

123. (New) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating first output data that includes a customer number of the sender and at least a portion
of the decoded data;
sorting the first output data by customer number, after creating the first output data;
creating second output data for a customer number that includes the name and address of the
intended recipients associated with the customer number, after the sorting step;
determining if the sender wants a corrected address provided for intended recipients;
if the sender wants a corrected address provided, electronically transferring to the sender
information for the identified intended recipients that enable the sender to update the
sender's mailing address files, including a name change and a job change of intended
recipients; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

124. (New) The method of claim 123, wherein the encoded data further indicates a name
and address of the intended recipient.

125. (New) The method of claim 123, wherein the plurality of mail items further include a
written return address that is not that address of the sender.

126. (New) The method of claim 123, further comprising transmitting the name and address
of the intended recipients to a mailing address service provider in order to obtain an updated
address for each intended recipient of an undeliverable mail item.

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127. (New) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating first output data that includes a customer number of the sender and at least a portion
of the decoded data;
sorting the content of the first output data by customer number;
creating second output data that includes a customer number and the name and address of
the intended recipients associated with the customer number, after the sorting step;
determining if the sender wants a corrected address provided for intended recipients based
on the decoded data;
if the sender wants a corrected address provided, i) electronically transmitting the name and
address of the intended recipient to an address correction service provider and receiving
an updated address of the intended recipient from the address correction service
provider; ii) electronically transferring to the sender, subsequent to receiving an updated
address of the intended recipient from the address correction service provider,
information for the identified intended recipients that enable the sender to update the
sender's mailing address files; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

128. (New) The method of claim 127, wherein the encoded data further indicates a name
and address of the intended recipient.

129. (New) The method of claim 127, wherein the plurality of mail items further include a
written return address that is not that address of the sender.

130. (New) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating first output data that includes a customer number of the sender and at least a portion
of the decoded data including the name and address of the intended recipient;
sorting the content of the first output data by customer number;
creating second output data for a customer number that includes the name and address of the
intended recipients associated with the customer number, after the sorting step;
determining if the sender wants a corrected address provided for intended recipients based
on the decoded data;
if the sender wants a corrected address provided, i) electronically transmitting the name and
address of the intended recipient to an address correction service provider and receiving
an updated address of the intended recipient from the address correction service
provider; and ii) electronically transferring to the sender, subsequent to receiving an
updated address of the intended recipient from the address correction service provider,
information for the identified intended recipients that enable the sender to update the
sender's mailing address files; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

131. (New) The method of claim 130, wherein the encoded data further indicates a name
and address of the intended recipient.

132. (New) The method of claim 130, wherein the plurality of mail items further include a written return address that is not that address of the sender.

133. (New) A system for processing a plurality of undeliverable mail items, comprising:
a letter transport for receiving from a sender a plurality of undeliverable mail items that are returned subsequent to mailing as being undeliverable, each undeliverable mail item including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;
a camera for decoding the encoded data incorporated in at least one of the undeliverable mail items; and
a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient; ii) sorting the content of the first output data by customer number, after creating the first output data; iii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;
wherein the computer, upon determining that the sender wants a corrected address provided,
i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider; and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and
wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

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134. (New) The method of claim 133, wherein the encoded data further indicates a name and address of the intended recipient.

135. (New) The method of claim 133, wherein the plurality of mail items further include a written return address that is not that address of the sender.

136. (New) A system for processing a plurality of undeliverable mail items, comprising: a hand-held barcode optical scanner for decoding encoded data on undeliverable mail items that are returned subsequent to mailing as being undeliverable, the encoded data indicating whether a sender wants a corrected address to be provided for the addressee incorporated, wherein each undeliverable mail item also includes a written addressee; and a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient; ii) sorting the content of the first output data by customer number, after creating the first output data; iii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

wherein the computer, upon determining that the sender wants a corrected address provided, i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider; and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

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wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

REMARKS

Reconsideration and further examination of this application are hereby requested.

A. Status of Claims

After entry of the Response, claims 1, 2, 4-39, 42-62 and 64-136 are pending.

Claims 1-38 were in originally issued patent 6,826,548.

Claims 39-136 were added in the present proceeding.

B. Explanation of Claim Language Changes and Support for Same

Claim 1 has been amended as follows:

1. (Currently Amended -Twice Amended) A method for processing a plurality of undeliverable mail items comprising the steps of:
encoding data including intended recipient identification information that includes the name and address of an addressee on each of a plurality of mail items from a sender prior to mailing;
receiving those items of the plurality of mail items that are returned as being undeliverable;
scanning and decoding the encoded data, subsequent to receiving the returned undeliverable mail items, on the items of undeliverable mail to identify intended recipients having incorrect addresses;
determining, subsequent to decoding, if the sender wants a corrected address provided; and
if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients for the sender to update the sender's mailing address files.

Support for the amendment to claim 1 is found at least at: i) column 2, line 66 - column 3, line 10; ii) column 3, lines 32-51, and Figure 1; and iii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

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Claim 14 has been amended as follows:

14. (Previously Presented) A method for processing returned mail items sent by a subscriber to a recipient, the returned mail items incorporating encoded intended recipient identification information, the method comprising the steps of:

collecting the returned mail items, not delivered to an intended recipient, at a processing location;

reading the encoded intended recipient identification information from the collected returned mail items to identify intended recipients having incorrect addresses;

determining from the reading if the subscriber wants a corrected address provided for the returned mail items;

if the subscriber wants a corrected address provided, electronically gathering updated recipient identification information including an updated address of the intended recipient; and

electronically transmitting updated recipient identification information to the subscriber for updating of a subscriber's address database.

Support for the amendment to claim 14 is found at least at: i) column 2, line 66 - column 3, line 10; ii) column 3, lines 32-51, and Figure 1; and iii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

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Claim 25 has been amended as follows:

25. (Previously Presented) A computer readable medium containing a computer program product comprising instructions for controlling a computer system to process a plurality of undeliverable mail items, the computer program product comprising:

program instructions that capture optically scanned encoded data including intended

recipient identification information and that capture encoded data indicating whether a subscriber wants a corrected address to be provided for the intended recipient on each

item of undeliverable mail and identify intended recipients having incorrect addresses;

program instructions that store the captured [and identified intended recipient] data in a data file;

program instructions that update the stored data, based on the data indicating whether a

subscriber wants a corrected address provided, to incorporate an updated address of the intended recipient of each item of undeliverable mail; and

program instructions that transmit the updated intended recipient address information to a subscriber electronically to update the address files of the subscriber.

Support for the amendment to claim 25 is found at least at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

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Claim 32 has been amended as follows:

32. (Previously Presented) A system for processing a plurality of undeliverable mail items comprising:
- a scanner for reading optically encoded data that includes intended recipient identification information and data indicating whether a sender wants a corrected address provided on each item of undeliverable mail returned subsequent to an attempted delivery;
 - a processor for operation of a computer program for decoding the scanned data, identifying the intended recipient identification information in the decoded data, writing the identified recipient identification information into a data file, and transferring to a sender information for the identified intended recipient for the sender to update the sender's mailing address files subsequent to and based on determining that the sender wants a corrected address provided; and
 - a database for storing the data file containing identified recipient identification information.

Support for the amendment to claim 32 is found at least at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

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Claim 39 has been amended as follows:

39. (Previously Presented - Twice Amended) A method for processing a plurality of undeliverable mail items, comprising:

- receiving from a sender a plurality of mail items, each including an addressee and incorporating encoded data indicating whether the sender wants a corrected address [correction service type identification information] to be provided for the addressee;
- identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;
- decoding the encoded [address correction service type identification information] data incorporated in at least one of the undeliverable mail items; [and]
- determining if the sender wants a corrected address [correction service type] provided based on the decoded [address correction service type identification information] data; and if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files.

Support for the amendment to claim 39 is found at least at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 48 has been amended as follows:

48. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 39, wherein the encoded [address correction service type identification information] data indicating whether the sender wants a corrected address provided comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

Support for the amendment to claim 48 is found at least at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 49 has been amended as follows:

49. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 39, wherein the encoded data indicating whether the sender wants a corrected address provided [correction service type identification information] is encoded in an optically encoded bar code.

Support for the amendment to claim 49 is found at least at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 53 has been amended as follows:

53. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 39, wherein the encoded [address correction service type identification information] data is detectable with reference to either the front side or the back side of each of the plurality of mail items.

Support for the amendment to claim 53 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 56 has been amended as follows:

56. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 55, further comprising obtaining an updated address for an intended recipient of the at least one of the undeliverable mail items, in accordance with the data indicating whether the sender wants a corrected address [correction service type identification information] provided.

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Support for the amendment to claim 56 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 57 has been amended as follows:

57. (Previously Presented - Twice Amended) A method for processing returned mail items sent by a sender to an intended recipient, [the returned mail items incorporating encoded address correction service type identification information,] the method comprising:

decoding, subsequent to mailing of the returned mail items, [the encoded address correction service type identification] information indicating whether the sender wants a corrected address to be provided for the intended recipient, on at least one of the returned mail items;

obtaining an updated address of the intended recipient [as determined by the address correction service type] subsequent to determining that the sender wants a corrected address to be provided for the intended recipient; and

electronically transmitting an updated address of the intended recipient to a transferee.

Support for the amendment to claim 57 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

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Claim 66 has been amended as follows:

66. (Previously Presented - Twice Amended) The method for processing returned mail items of claim 57, wherein the [encoded address correction service type identification] information indicating whether the sender wants a corrected address provided on at least one of the returned mail items comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

Support for the amendment to claim 66 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 67 has been amended as follows:

67. (Previously Presented - Twice Amended) The method for processing returned mail items of claim 57, wherein the [encoded address correction service type identification] information indicating whether the sender wants a corrected address to be provided is encoded in an optically encoded bar code.

Support for the amendment to claim 67 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 71 has been amended as follows:

71. (Previously Presented - Twice Amended) The method for processing returned mail items of claim 57, wherein the [encoded address correction service type identification] information indicating whether the sender wants a corrected address to be provided is detectable with reference to either the front side or the back side of each of the returned mail items.

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Support for the amendment to claim 71 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 72 has been amended as follows:

72. (Previously Presented - Twice Amended) The method for processing returned mail items of claim 57, wherein the [service type] information indicating whether the sender wants a corrected address to be provided indicates that the sender wants an updated address associated with the intended recipients to be provided.

Support for the amendment to claim 72 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 75 has been amended as follows:

75. (Previously Presented - Twice Amended) A computer program product residing on a computer readable medium comprising instructions for causing a computer to:
store decoded [address correction service type identification] information indicating whether the sender wants a corrected address to be provided and a customer number, each associated with at least one of a plurality of [undeliverable] mail items returned subsequent to mailing as being undeliverable;
determining from the decoded data that the customer wants a corrected address to be provided for at least one of the plurality of undeliverable mail items;
receive an updated address of an intended recipient for at least one of the undeliverable mail items, subsequent to and based upon the determining step; and
transmit the updated address to a transferee.

Support for the amendment to claim 75 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 80 has been amended as follows:

80. (Previously Presented - Twice Amended) The computer program product of claim 75, wherein the [service type identification] information indicating whether the sender wants a corrected address to be provided indicates whether to determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the plurality of undeliverable mail items.

Support for the amendment to claim 80 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 83 has been amended as follows:

83. (Previously Presented - Twice Amended) The computer program product of claim 75, wherein the [address correction service type identification] information indicating whether the sender wants a corrected address to be provided is incorporated in at least one of the undeliverable mail items comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

Support for the amendment to claim 83 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

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Claim 87 has been amended as follows:

87. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 75, wherein the [address correction service type identification] information indicating whether the sender wants a corrected address to be provided is detectable with reference to either the front side or the back side of each of the plurality of mail items.

Support for the amendment to claim 87 is found, is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 88 has been amended as follows:

88. (Previously Presented - Twice Amended) A system for processing a plurality of undeliverable mail items comprising:

a first detector, wherein the first detector detects, subsequent to mailing the undeliverable mail items, encoded [address correction service type identification] information on at least one of the plurality of undeliverable mail items indicating whether a sender wants a corrected address to be provided for at least one of the undeliverable mail items; and
a processor that uses a computer program comprising instructions that cause the system to decode the [detected address correction service type identification] information indicating whether the sender wants a corrected address to be provided.

Support for the amendment to claim 88 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 93 has been amended as follows:

93. (Previously Presented-Twice Amended) The system for processing a plurality of undeliverable mail items of claim 88, wherein the [address correction service type identification] information indicating whether a sender wants a corrected address to be provided indicates whether to determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the plurality of undeliverable mail items.

Support for the amendment to claim 93 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 94 has been amended as follows:

94. (Previously Presented - Twice Amended) The system for processing a plurality of undeliverable mail items of claim 88, wherein the encoded [address correction service type identification] information indicating whether the sender wants a corrected address to be provided on the at least one of the undeliverable mail items comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

Support for the amendment to claim 94 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 97 has been amended as follows:

(Previously Presented - Twice Amended) The system for processing a plurality of undeliverable mail items of claim 88, further comprising:

- a second detector, wherein the second detector detects information for an intended recipient on the at least one of the plurality of undeliverable mail items; and
- an updating processor that operates an updating computer program comprising instructions that direct the system, in accordance with the [service type identification] information indicating whether the sender wants a corrected address to be provided, to obtain updated address information for the intended recipient and to write the updated address information into the data file.

Support for the amendment to claim 97 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 101 has been amended as follows:

101. (Previously Presented - Twice Amended) A method for processing a plurality of undeliverable mail items, comprising:

- encoding [mailpiece address correction service type identification] information indicating whether the sender wants a corrected address to be provided for an intended recipient on a plurality of mail items;
- arranging for a postal service provider to identify, as undeliverable mail items, mail items of the plurality of mail items that are undeliverable; and
- arranging for a return mail service provider to decode, subsequent to identifying the undeliverable mail items, the [mailpiece address correction service type] information indicating whether the sender wants a corrected address to be provided for the intended recipient on at least one of the undeliverable mail items.

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Support for the amendment to claim 101 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 104 has been amended as follows:

104. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 101, further comprising:

arranging for the return mail service provider to determine, as indicated by the [mailpiece address correction service type] information indicating whether the sender wants a corrected address to be provided, an updated mailing address for the at least one of the undeliverable mail items; and

arranging for the return mail service provider to store the updated mailing address in a data file.

Support for the amendment to claim 104 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 105 has been amended as follows:

105. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 101, wherein the [mailpiece address correction service type] information indicating whether the sender wants a corrected address to be provided indicates that the return mail service provider should determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the undeliverable mail items.

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Support for the amendment to claim 105 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 108 has been amended as follows:

108. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 101, wherein the encoded [mailpiece address correction service type] information indicating whether the sender wants a corrected address to be provided on at least one of the undeliverable mail items comprises encoded information detectable by optical detection, magnetic detection or radiofrequency detection.

Support for the amendment to claim 108 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

Claim 109 has been amended as follows:

109. (Previously Presented - Twice Amended) The method for processing a plurality of undeliverable mail items of claim 101, wherein the encoded [mailpiece address correction service type] information indicating whether the sender wants a corrected address to be provided is encoded in an optically encoded bar code.

Support for the amendment to claim 109 is found, for example, at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

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115. (New) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating output data that includes a customer number of the sender and at least a portion of
the decoded data;
determining if the sender wants a corrected address provided for intended recipients based
on the decoded data;
if the sender wants a corrected address provided, electronically transferring to the sender
information for the identified intended recipients that enable the sender to update the
sender's mailing address files; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

Support for claim 115 is found, for example, at least at: i) column 2, line 66- column 5, line 39, and more particularly at: i) column 3, lines 32-51, and Figure 1; and ii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent.

116. (New) The method of claim 115, further comprising transmitting the name and address
of the intended recipients to a mailing address service provider, subsequent to the determining
step, in order to obtain an updated address for each intended recipient of an undeliverable mail
item.

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Support for claim 116 is found, for example, at least at column 4, line 50- column 5, line 39, and Figure 3 of the '548 patent.

117. (New) The method of claim 115, wherein the encoded data further indicates a name and address of the intended recipient.

Support for claim 117 is found, for example, at least at column 3, lines 4-9 of the '548 patent.

118. (New) The method of claim 115, wherein the plurality of mail items further include a written return address that is not that address of the sender.

Support for claim 118 is found, for example, at least at column 3, lines 16-20 of the '548 patent.

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119. (New) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating output data that includes a customer number of the sender and at least a portion of
the decoded data;
determining, based on the decoding step, if the sender wants a corrected address provided
for intended recipients;
if the sender wants a corrected address provided, electronically transferring to the sender
information for the identified intended recipients that enable the sender to update the
sender's mailing address files, including a name change and a job change of intended
recipients; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

Support for claim 119 is found, for example, at least at: i) column 2, line 66- column 5, line 39, and more particularly at: i) column 3, lines 32-51, and Figure 1; ii) column 4, lines 7-16, and iii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent. Support for the "output data" limitation is found at least at Figure 2, and column 4, lines 39-49.

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120. (New) The method of claim 119, further comprising transmitting the name and address of the intended recipients to a mailing address service provider, subsequent to the determining step, in order to obtain an updated address for each intended recipient of an undeliverable mail item.

Support for claim 120 is found, for example, at least at column 4, line 50- column 5, line 39, and Figure 3 of the '548 patent.

121. (New). The method of claim 119, wherein the encoded data further indicates a name and address of the intended recipient

Support for claim 121 is found, for example, at least at column 3, lines 4-9 of the '548 patent.

122. (New). The method of claim 119, wherein the plurality of mail items further include a written return address that is not that address of the sender.

Support for claim 122 is found, for example, at least at column 3, lines 16-20 of the '548 patent.

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123. (New). A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating first output data that includes a customer number of the sender and at least a portion
of the decoded data;
sorting the first output data by customer number, after creating the first output data;
creating second output data for a customer number that includes the name and address of the
intended recipients associated with the customer number, after the sorting step;
determining, based on the decoding, if the sender wants a corrected address provided for
intended recipients;
if the sender wants a corrected address provided, electronically transferring to the sender
information for the identified intended recipients that enable the sender to update the
sender's mailing address files, including a name change and a job change of intended
recipients; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

Support for claim 123 is found, for example, at least at: i) column 2, line 66- column 5, line 39, and more particularly at: i) column 3, lines 32-51, and Figure 1; ii) column 4, lines 7-16, and iii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent. Support for the "first output data" limitation is found at least at Figure 2, and column 4, lines 39-49. Support for the "second output data" limitation is found at least at Figures 2 and, and column 4, lines 49 - 63.

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124. (New) The method of claim 123, wherein the encoded data further indicates a name and address of the intended recipient.

Support for claim 124 is found, for example, at least at column 3, lines 4-9 of the '548 patent.

125. (New) The method of claim 123, wherein the plurality of mail items further include a written return address that is not that address of the sender.

Support for claim 125 is found, for example, at least at column 3, lines 16-20 of the '548 patent.

126. (New). The method of claim 123, further comprising transmitting the name and address of the intended recipients to a mailing address service provider in order to obtain an updated address for each intended recipient of an undeliverable mail item.

Support for claim 126 is found, for example, at least at column 4, line 50- column 5, line 39, and Figure 3 of the '548 patent.

127. (New). A method for processing a plurality of undeliverable mail items, comprising: receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee; identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable; decoding the encoded data incorporated in at least one of the undeliverable mail items; creating first output data that includes a customer number of the sender and at least a portion of the decoded data; sorting the content of the first output data by customer number; creating second output data that includes a customer number and the name and address of the intended recipients associated with the customer number, after the sorting step; determining, if the sender wants a corrected address provided for intended recipients based on the decoded data; if the sender wants a corrected address provided, i) electronically transmitting the name and address of the intended recipient to an address correction service provider and receiving an updated address of the intended recipient from the address correction service provider; ii) electronically transferring to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

Support for claim 127 is found, for example, at least at: i) column 2, line 66- column 5, line 39, and more particularly at: i) column 3, lines 32-51, and Figure 1; ii) column 4, lines 7-16, and iii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent. Support for

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the “first output data” limitation is found at least at Figure 2, and column 4, lines 39-49. Support for the “second output data” limitation is found at least at Figures 2 and, and column 4, lines 49 - 63.

128. (New) The method of claim 127, wherein the encoded data further indicates a name and address of the intended recipient.

Support for claim 128 is found, for example, at least at column 3, lines 4-9 of the '548 patent.

129. (New) The method of claim 127, wherein the plurality of mail items further include a written return address that is not that address of the sender.

Support for claim 129 is found, for example, at least at column 3, lines 16-20 of the '548 patent.

130. (New) A method for processing a plurality of undeliverable mail items, comprising:
receiving from a sender a plurality of mail items, each including i) a written addressee, and
ii) encoded data indicating whether the sender wants a corrected address to be provided
for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are
returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating first output data that includes a customer number of the sender and at least a portion
of the decoded data including the name and address of the intended recipient;
sorting the content of the first output data by customer number;
creating second output data for a customer number that includes the name and address of the
intended recipients associated with the customer number, after the sorting step;
determining if the sender wants a corrected address provided for intended recipients based
on the decoded data;
if the sender wants a corrected address provided, i) electronically transmitting the name and
address of the intended recipient to an address correction service provider and receiving
an updated address of the intended recipient from the address correction service
provider; and ii) electronically transferring to the sender, subsequent to receiving an
updated address of the intended recipient from the address correction service provider,
information for the identified intended recipients that enable the sender to update the
sender's mailing address files; and
if the sender does not want a corrected address provided, posting return mail data records on
a network that is accessible to the sender to enable the sender to access the records.

Support for claim 130 is found, for example, at least at: i) column 2, line 66- column 5, line 39, and more particularly at: i) column 3, lines 32-51, and Figure 1; ii) column 4, lines 7-16, and iii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent. Support for

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the “first output data” limitation is found at least at Figure 2, and column 4, lines 39-49. Support for the “second output data” limitation is found at least at Figures 2 and, and column 4, lines 49 - 63.

131. (New) The method of claim 130, wherein the encoded data further indicates a name and address of the intended recipient.

Support for claim 131 is found, for example, at least at column 3, lines 4-9 of the '548 patent.

132. (New) The method of claim 130, wherein the plurality of mail items further include a written return address that is not that address of the sender.

Support for claim 132 is found, for example, at least at column 3, lines 16-20 of the '548 patent.

133. (New) A system for processing a plurality of undeliverable mail items, comprising:
a letter transport for receiving from a sender a plurality of undeliverable mail items that are
returned subsequent to mailing as being undeliverable, each undeliverable mail item
including i) a written addressee, and ii) encoded data indicating whether the sender
wants a corrected address to be provided for the addressee;
a camera for decoding the encoded data incorporated in at least one of the undeliverable mail
items; and
a computer for i) creating first output data that includes a customer number of the sender and
at least a portion of the decoded data including the name and address of the intended
recipient; ii) sorting the content of the first output data by customer number, after
creating the first output data; iii) creating second output data for a customer number that
includes the name and address of the intended recipients associated with the customer
number, after the sorting the content of the output file by customer number; and iv)
determining if the sender wants a corrected address provided for intended recipients
based on the decoded data;
wherein the computer, upon determining that the sender wants a corrected address provided,
i) electronically transmits the name and address of the intended recipient to an address
correction service provider and receives an updated address of the intended recipient
from the address correction service provider; and ii) electronically transfers to the
sender, subsequent to receiving an updated address of the intended recipient from the
address correction service provider, information for the identified intended recipients
that enable the sender to update the sender's mailing address files; and
wherein the computer, upon determining that the sender does not want a corrected address
provided, posts return mail data records on a network that is accessible to the sender to
enable the sender to access the records.

Support for claim 133 is found, for example, at least at: i) column 2, line 66- column 5, line 39, and more particularly at: i) column 3, lines 32-51, and Figure 1; ii) column 4, lines 7-16, iii)

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column 4, line 34 - column 5, line 13, and Figures 2 and 3, and iv) column 5, line 54 - column 6, line 53 of the '548 patent. Support for the "first output data" limitation is found at least at Figure 2, and column 4, lines 39-49. Support for the "second output data" limitation is found at least at Figures 2, and column 4, lines 49 - 63.

134. (New) The method of claim 133, wherein the encoded data further indicates a name and address of the intended recipient.

Support for claim 134 is found, for example, at least at column 3, lines 4-9 of the '548 patent.

135. (New) The method of claim 133, wherein the plurality of mail items further include a written return address that is not that address of the sender.

Support for claim 135 is found, for example, at least at column 3, lines 16-20 of the '548 patent.

136. (New) A system for processing a plurality of undeliverable mail items, comprising: a hand-held barcode optical scanner for decoding encoded data on undeliverable mail items that are returned subsequent to mailing as being undeliverable, the encoded data indicating whether a sender wants a corrected address to be provided for the addressee incorporated, wherein each undeliverable mail item also includes a written addressee; and

a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data; ii) sorting the content of the first output data by customer number, after creating the first output data; iii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

wherein the computer, upon determining that the sender wants a corrected address provided, i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider; and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

Support for claim 136 is found, for example, at least at: i) column 2, line 66- column 5, line 39, and more particularly at: i) column 3, lines 32-51, and Figure 1; ii) column 4, lines 7-16, iii) column 4, line 34 - column 5, line 13, and Figures 2 and 3, and iv) column 5, lines 40-43 of the '548 patent. Support for the "first output data" limitation is found at least at Figure 2, and column 4,

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lines 39-49. Support for the “second output data” limitation is found at least at Figures 2, and column 4, lines 49 - 63.

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The Patent Owner requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

After entry of the amendment, claims 1-2, 4-39, 42-62, and 64-136 are pending.

On pages 3-10 of the Office Action, the Examiner rejected claims 1-10, 12, 14-21, 23, 25-30, 32-39, 42-49, 51, 54-62, 64-67, 69, 72-85, 88-109, 111 and 114 under 35 U.S.C. §103(a) as being unpatentable over Postal Automated Redirection System - The USPS Solution (hereinafter "PARS") in view of Second-Generation Address Change Service dated September 19, 1991 (hereinafter "Second-Generation").

On pages 10-11 of the Office Action, the Examiner also rejected claims 11, 22, 31, 50, 68, 86 and 110 under 35 U.S.C. §103(a) as being unpatentable over PARS in view of Second-Generation, and further in view of U.S. Patent No. 6,371,521 to Petkovsek (hereinafter "Petkovsek").

On page 11 of the Office Action, the Examiner rejected claims 13, 24, 52, 70 and 112 under 35 U.S.C. §103(a) as being unpatentable over PARS in view of Second-Generation, and further in view of U.S. Patent No. 6,680,783 to Pierce et al. (hereinafter "Pierce").

On pages 11-12 of the Office Action, the Examiner rejected claims 53, 71, 87 and 113 under 35 U.S.C. §103(a) as being unpatentable over PARS in view of Second-Generation, and further in view of Postal Addressing Standards - Publication 28 (hereinafter "Publication 28").

In view of the amendments to the claims set forth above and the remarks that follow, the Patent Owner believes that these rejections should be withdrawn.

The References Under 35 U.S.C. § 103(a) are Unsupported and Should be Withdrawn

A. Governing Criteria

For rejections under 35 U.S.C. Section 103(a), the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. Manual of Patenting Examining Procedure (hereinafter "M.P.E.P.") § 2143. The establishment of a *prima facie* case of obviousness also requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. M.P.E.P. § 2143.03.

In *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court set the standard for evaluating obviousness, and enunciated the following principles:

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. A court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1731.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002). The Supreme Court, while recognizing the need to "guard against slipping into the use of hindsight," acknowledged the following principles:

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006).

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“...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

The Supreme Court in *KSR* further stated that:

“...a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.” *Id.* at 1731.

An examiner may often find every element of a claimed invention in the prior art.

“Virtually all inventions are combinations and virtually all are combinations of old elements.”

Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80 (Fed. Cir. 1983).

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

“...when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR* at 1740, citing *United States v. Adams*, 383 U.S. 39, 51-52, 86 S.Ct. 708 (1966).

The claims at issue in the present proceeding define substantial improvements over the applied art in the form of combinations of functionalities, and system components and equipment

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that perform those functionalities. When properly viewed against the applicable standard and as shown in detail below, none of the asserted references, when considered either individually or collectively, teach or suggest the claimed combinations of functionalities and system components. The claimed subject matter of the presently pending claims would have been unobvious to a person of ordinary skill at the time of the effective filing date of the '548 patent.

B. The *Prima Facie* Case of Obviousness Has Not Been Met

The burden of establishing a *prima facie* case of obviousness based on the above references has not been met. Accordingly, the § 103(a) rejections are respectfully requested to be withdrawn.

Assuming, *arguendo*, that the concept of returned mail is present in the cited references, the arguments set forth below demonstrate that PARS, Second-Generation, Petkovsek, Pierce and/or Publication 28, alone or in combination, do not disclose all of the elements of the claims. For example, because none of the references disclose "receiving from a sender a plurality of mail items, each including an addressee and incorporating encoded data indicating whether the sender wants a corrected address to be provided for the addressee," as recited in claim 39 (and similarly recited, for example, in original independent claims 1, 14, 25 and 32), any combination of the references cannot disclose the receipt of "encoded data indicating whether the sender wants a corrected address to be provided for the addressee," as claimed. The Office Action's rejections under § 103(a) appear to be based largely on the Examiner's assertion of Second-Generation's alleged disclosure of the concept of processing returned mail. However, as will be demonstrated below, whether or not Second-Generation discloses the concept of returned mail is irrelevant. As such, no *prima facie* case of obviousness based on the other elements has been set forth.

C. No Rationale Supports a Finding of Obviousness Based on the References

Furthermore, no rationale exists that supports a *prima facie* case of obviousness based on PARS, Second-Generation, Petkovsek, Pierce and/or Publication 28, singly or in combination. The claims are not merely variations or combinations of the elements found in these references, but represent a paradigm shift in the technology for processing returned mail for customers (mailers). PARS, for example, describes a U.S. Postal Service system and method that attempts to obtain a correct address for a mail item prior to attempted delivery to an intended recipient. PARS is a system that does not consider or contemplate the processing of mail items that are incorrectly addressed and that are returned after an attempted delivery to an intended recipient, to then obtain a correct address of an intended recipient. In fact, as will be described in further detail herein, PARS was developed with the specific intent and purpose of providing a solution to systems, such as Second-Generation, that utilized a post-mailing address correction paradigm that obtained correct addresses after attempted delivery to an intended recipient.

The instant specification discloses, and the present claims exist in, a vastly different mailing and address correction paradigm than that of PARS -- one that employs methods and systems that start with an incorrectly addressed mail item that is first mailed, then returned for address correction, and subsequently re-mailed to the intended recipient for delivery. In contrast, PARS, the primary reference cited in the Office Action and relied upon by the Examiner, discloses a system, technique and elements that are dysfunctional in this post-mailing return for address correction paradigm, as recited in the presently pending claims. Moreover, the teaching away in PARS from the return of undeliverable mail items address correction paradigm that is disclosed in the Second-Generation reference would cause one of ordinary skill to look away from these references, rather than to combine them.

Rejection of claims 1-38 under 35 U.S.C. § 103(a)

With regard to the rejection of claims 1-38 under 35 U.S.C. §103(a), independent claims 1 and 14 have been amended to recite that intended recipient identification information "includes the name and address of an addressee." As noted above, support for the amendment to claims 1-38

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is found, for example, at least at: i) column 2, line 66 - column 3, line 10; ii) column 3, lines 32-51, and Figure 1; and iii) column 4, line 34 - column 5, line 13, and Figures 2 and 3 of the '548 patent. In particular, support for the "includes the name and address of an addressee" limitation added in the present Response is found at least at column 2, line 66 - column 3, line 10.

With regard to independent claim 1 and dependent claims 2-13, on page 3 of the Office Action, the Examiner cites page 2, paragraph 1, of PARS as allegedly disclosing "encoding data including intended recipient identification information on each of a plurality of mail items from a sender prior to mailing." Page 2, paragraph 1 of PARS is provided below:

Introduction

Point of entry redirection is the goal of the U.S. Postal Service design strategy during development of the PARS. Of the more than 100 billion first class mailpieces processed by the USPS in 1998, over 1% required redirection. This provides an opportunity for significant cost savings as the redirection processes are automated and streamlined. In the past ten years, Optical Character Recognition (OCR) technology and the Remote Barcoding System (RBCS) for OCR read rejects have been fully deployed in our letter mail environment. Our automation program now gives us the capability to barcode and sort nearly all letter mail to the carrier route walk sequence, utilizing an 11 digit delivery point code. Processing technology now can be developed for potential redirection identification during initial processing, staging the physical mail, using our RBCS strategies to direct images for further computer or manual recognition, and print, label and sort redirection mail at high speeds.

With over 300 automation capable processing facilities in the United States, any changes made to our infrastructure are serious endeavors. The strategy of the USPS is to inject our redirection process with a new state of the art strategy and technology.

The Patent Owner respectfully submits that this passage of PARS does not disclose "encoding data including intended recipient identification information" Instead, the 11 digit delivery point code disclosed in PARS, and referred to by the Examiner on page 3 of the Office Action, is merely a delivery point code -- i.e., only a place -- that is not and does not contain information pertaining to an "intended recipient" -- i.e. a person or entity -- as recited in claim 1. An "11 digit delivery point" as disclosed in PARS is not i) encoded and ii) does not provided "intended recipient identification information" such as a "name and address," as recited in claim 1. More particularly, PARS discloses:

In the United States, an 11-digit numeric code uniquely identifies

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each delivery point in the country. For redirection confirmation, the delivery point barcode and the name of the customer as addressed must be positively confirmed with an entry in the national "Change Of Address" (COA) database.

PARS, p. 3.

Accordingly, PARS discloses that the 11-digit numeric code is different from a name and address of an addressee.

With regard to "receiving those items of the plurality of mail items that are returned as being undeliverable," as recited in claim 1, PARS discloses a technique that relies on the 11 digit delivery point code to provide a fundamentally different approach than that of the claimed invention. More particularly, PARS does not teach or suggest that mail is "returned as being undeliverable," as acknowledged by the Examiner on pages 4-5 of the Office Action. Instead, PARS discloses a "**point of entry solution**" for "**redirection identification during initial processing**." (PARS, pp. 3, 2, respectively (emphasis added)). That is, PARS makes abundantly clear that the "initial processing" as disclosed in PARS is not the same as a mail item that is "returned," as recited in the claimed invention.

PARS also discloses that

[w]ithout this crucial step [of confirming that the mail should be redirected at the point of entry], the mailpiece must be processed to the customer addressed destination, manually identified and handled by the carrier, then rehandled and sent to the redirection process in the local plant. Point of entry redirection avoids the intermediate, inefficient, time and labor consuming step in the delivery.

PARS, pg. 3, emphasis added.

Accordingly, PARS does not receive "mail items that are returned as being undeliverable," and instead teaches away from this aspect of the claimed invention. In particular, PARS discloses that address correction occurs before attempted delivery, and before mail items are

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returned. Accordingly, there is no mail that is "returned as being undeliverable" as recited in the present invention.

In view of the foregoing, the Patent Owner submits that PARS does not disclose or suggest at least the "*returned as being undeliverable*" limitation, and in fact teaches away from this limitation, as recited in claim 1 of the present invention.

Because PARS does not disclose "receiving those items of the plurality of mail items that are returned as being undeliverable," the Patent Owner further submit that PARS does not disclose or suggest at least the following, as now recited in claim 1:

scanning and decoding the encoded data, subsequent to receiving the returned undeliverable mail items, on the items of undeliverable mail to identify intended recipients having incorrect addresses; determining, subsequent to decoding, if the sender wants a corrected address provided; and if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients for the sender to update the sender's mailing address files.

The Patent Owner finds no teaching or suggestion in PARS regarding at least these underlined features recited in claim 1, added by amendment.

To compensate for the deficiencies of PARS, the Examiner relies on the Second-Generation reference.

On page 5 of the Office Action, the Examiner states:

It would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to modify USPS Solution to include receiving those items of the plurality of mail items that are returned as being undeliverable, as disclosed in Second Generation, because it would advantageously allow to be in compliance with the requirements and procedures of the Second Generation Address Change Service.

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Office Action, p. 5.

The Patent Owner disagrees with the Office Action's contention. Moreover, the use of Second-Generation as proposed by the Examiner in the Office Action adds nothing of value to PARS. That is, PARS discloses a system for updating addresses for undeliverable mail items that makes it unnecessary to combine it with Second-Generation. This is perfectly consistent with the fact that PARS teaches away from the approach of processing undeliverable mail items as disclosed in Second-Generation (and vice-versa), and the chronological and historical development of the Second-Generation and PARS systems.

Even aside from the differences between PARS and the claimed invention, the combination proposed in the Office Action would significantly change the principle of operation of PARS. That is, and as noted above, PARS describes a U.S. Postal Service system and method that attempts to obtain a correct address for a mail item prior to attempted delivery to an intended recipient. PARS is a system that does not consider or contemplate the processing of mail items that are incorrectly addressed and that are returned after an attempted delivery to an intended recipient. Combining Second-Generation with PARS to achieve the functionality in PARS of receiving an incorrectly addressed mail piece that is returned after an attempted delivery to an intended recipient, to then obtain a correct address of an intended recipient, would change the principal operation of PARS. The extent of this change is highlighted by considering (a) the nature of the problem that PARS was trying to solve, and (b) the fact that Second-Generation teaches away from the approach to processing undeliverable mail items that is disclosed in PARS (and vice-versa).

In contradistinction to these facts, the Office Action goes on and contends that:

Furthermore, it would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify USPS Solution to include receiving those items of the plurality of mail items that are returned as being undeliverable, as disclosed in Second-Generation, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary

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skill in the art would have recognized that the results of the combination were predictable.

Office Action, pp. 5-6.

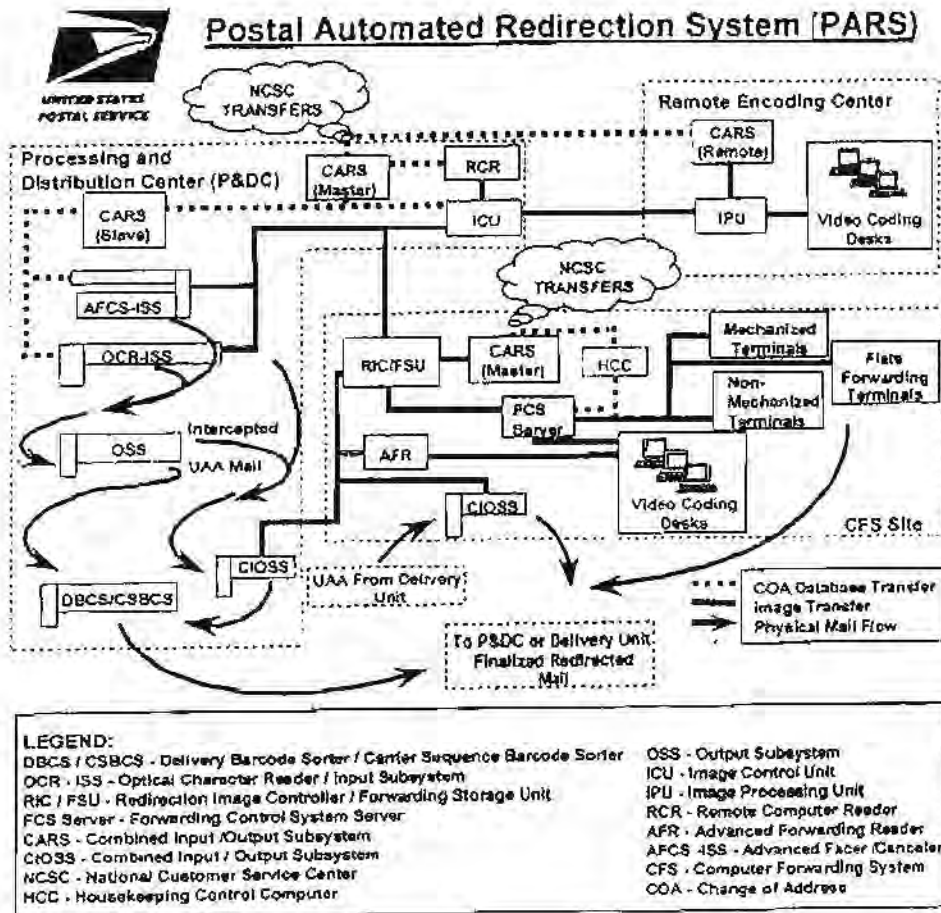
As noted above, the Supreme Court addressed the issue of combining prior art references in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). Although the Court rejected a rigid application of the “teaching, suggestion, or motivation” test, under which a patent claim is only proved obvious if some motivation or suggestion to combine the prior art teachings can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art, the Court also stated that it can still be “...important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.” *Id.* at 1741.

As will be discussed in further detail below, the combination of steps and elements as recited in the claimed invention would not have been predictable. Moreover, the combination of steps and elements, as set forth in the PARS and Second-Generation references, would have led to undesirable consequences. Specifically, one would have to ignore the fundamental problem that PARS was trying to solve, and destroy the operational principles upon which the PARS system is based. PARS was designed to identify undeliverable mail at the originating point. Adding the capability to process undeliverable mail items from Second-Generation would have undermined that purpose of PARS and its design.

In addition, the level of generality and lack of detail in the Second-Generation reference, and lack of substantial similarity between the PARS and Second-Generation references, does not suggest any motivation to combine these references. The fact that Second-Generation does not disclose any structural implementation or system architecture would not have suggested to one of ordinary skill to combine Second-Generation with PARS, particularly given the opposing functional approaches and operational objectives of these two systems.

Figure 1 of PARS is shown below:

Figure 1



As shown in Figure 1, lines with arrowheads (e.g., —>) indicate physical mail flow. As also shown in Figure 1, lines without arrowheads (e.g., —) indicate image transfer, and dotted lines (e.g., ····) indicate Change of Address (COA) database transfer. Figure 1 also shows the Processing and Distribution Center (P&DC) intercepts undeliverable as addressed (UAA) mail before it is returned as being undeliverable. That is, the PARS system does not perform “receiving those items of the plurality of mail items that are returned as being undeliverable,” as recited in claim 1. As PARS discloses, the Combined Input / Output Subsystem (CIOSS) “...prints and

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applies the forward address information” as part of the redirection process, before the mailpiece is returned as being undeliverable. (PARS, p. 4).

PARS is replete with references that indicate that PARS is intended to redirect mail before it is returned as being undeliverable. For example, page 1 of PARS states the following:

Redirection (or forwarding) mail service is provided to U.S. Postal Service (U.S.P.S.) customers free of charge, however the cost to process and deliver redirected mail is substantial because the redirection requirement is not currently recognized until the mail reaches the carrier (destination). Additionally, the operation is mechanized and uses outdated and obsolete controls, so technical improvements are difficult to migrate into the system. Redirected letter mail incurs delivery delays greater than normal service standards. As the USPS faces increased competition from alternative communication methods, redirection is one facet of letter mail processing where efficiency can be increased with advanced technology.

Engineering studies indicate that redirected mail can be processed more efficiently if the mailpiece is identified at the originating plant (or at point of entry) and redirected towards the proper destination. This eliminates the cost and delay of processing and capturing the mailpiece at the initial destination, then redirecting it to the forwarded address.

PARS, p. 1 (emphasis added).

PARS also states the following:

For redirection confirmation, the delivery point barcode and the name of the customer as addressed must be positively confirmed with an entry in the national “Change Of Address” (COA) database. If an entry exists, there is confirmation and the mailpiece can be diverted into the redirection process, which allows processing to the final, proper destination without delay. Without this crucial step, the mailpiece must be processed to the customer addressed destination, manually identified and handled by the carrier, then rehandled and sent to the redirection process in the local plant. Point of entry redirection avoids the intermediate, inefficient, time and labor consuming step in delivery.

PARS, p. 3 (emphasis added).

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To obtain a functional system that would, as proposed in the Office Action, "...modify USPS Solution [PARS] to include receiving those items of the plurality of mail items that are returned as being undeliverable, as disclosed in Second-Generation," one would, have to fundamentally disregard the purpose of PARS, and the function of the Processing & Distribution Center (P&DC), as shown in Figure 1 of PARS, which is to provide for "[t]he successful identification of an intercepted mailpiece..." before the mailpiece is returned as being undeliverable. (PARS, pp. 3-4 at 4.) The very purpose of PARS is to avoid mailpieces as having to be returned as undeliverable.

This change alone to PARS would result in a new system, one very different from the system disclosed in PARS. This hypothetical system would operate in a very different manner from that taught by PARS. The principle of operation disclosed by PARS would be fundamentally altered such that PARS would no longer operate as described. Significantly, one would have to remove or substantially modify the Processing & Distribution Center (P&DC), as shown in Figure 1 of PARS, which is a key element in the PARS system and method of operation, to enable it to avoid the "inefficient, time and labor consuming step in [the] delivery..." [PARS, p. 3] of mail that is not properly addressed. A combination requiring such fundamental changes to the system and method of operation disclosed by PARS would not and could not have been obvious to one of ordinary skill in the art, particularly since PARS—a U.S. Postal Service system being developed in 1999—was intended to address the problems with the Second-Generation Address Change Service used by the U.S. Postal Service circa 1991. PARS—a system developed years after the Second-Generation Address Change Service—was thus intended to move away from and solve the problems associated with the Second-Generation Address Change Service, and not adopt them as part of the PARS system and method of operation.

The M.P.E.P states that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01. In view of the foregoing, the Patent Owner submits that modifying PARS by combining it with Second-Generation, as proposed by the Examiner, would change the principle of operation of the

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prior art invention (PARS) being modified. Accordingly, for this reason as well, the combination of PARS and Second-Generation is not sufficient to render the claimed invention *prima facie* obvious.

See also *Application of Ratti*, 270 F.2d 810, 813 (CCPA 1959) (The suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the reference as well as a change in the basic principles under which the reference construction was designed to operate); also *Ex Parte William B. Greenwald and Richard C. Evans*, 2009 WL 1899597 *3 (Bd.Pat.App. & Interf.) (“[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR Int’l Co. v. TeleFlex, Inc.*, 550 U.S. 398, 416 (2007). Modifying Brock’s structure to meet the claim limitations would have required more than the mere substitution of a retention aperture for Brock’s raised portion 263, however.”).

For at least these reasons, it would not have been obvious to a person of ordinary skill, relying only on the teachings of PARS and Second-Generation, to make the modifications proposed in the Office Action. To achieve a workable modification of PARS in view of Second-Generation would require substantial non-obvious hindsight modifications that would result in a device having a fundamentally different principle of operation from that of PARS and that would reverse the functional advances that PARS was intended to provide vis-à-vis Second-Generation.

For all of the foregoing reasons, the invention of claim 1, and dependent claims 2-14 would not have been obvious to one of ordinary skill from the teachings of PARS and Second-Generation.

Independent Claim 14 and Dependent Claims 15-24

For the same or substantially the same reasons as set forth above with regard to claim 1 in connection with the “*returned as being undeliverable*” limitation, the Patent Owner submits that the combination of the PARS and Second-Generation references does not disclose or suggest at

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least “collecting the returned mail items, not delivered to an intended recipient, at a processing location” as recited in claim 14.

For the same or substantially the same reasons as discussed with regard to claim 1, the Patent Owner further submits that the combination of the PARS and Second-Generation references does not disclose or suggest at least the following, as now recited in claim 14:

reading the encoded intended recipient identification information that includes the name and address of an addressee from the collected returned mail items to identify intended recipients having incorrect addresses;
determining from the reading if the subscriber wants a corrected address provided for the returned mail items;
if the subscriber wants a corrected address provided, electronically gathering updated recipient identification information including an updated address of the intended recipient; and

The Patent Owner finds no teaching or suggestion in PARS or Second-Generation regarding at least the newly added underlined features now recited in claim 14.

PARS does not disclose “reading encoded intended recipient identification information that includes the name and address of an addressee.” Instead, as noted below, PARS uses a human-readable endorsement. Moreover, PARS discloses:

In the United States, an 11-digit numeric code uniquely identifies each delivery point in the country. For redirection confirmation, the delivery point barcode and the name of the customer as addressed must be positively confirmed with an entry in the national "Change Of Address" (COA) database.

PARS, p. 3.

Accordingly, if anything, PARS further discloses that the name and address of an addressee is obtained from a database, and not from a reading of “encoded” information as recited in the claimed invention.

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Further, with regard to the “determining from the reading [of encoded intended recipient identification information...] if the subscriber wants a corrected address provided for the returned mail items,” on page 6 of the Office Action the Examiner cites page 2, ¶ 5 of PARS, as follows:

Another service to help update mailer directory lists is the Address Correction Service (ACS). An endorsement “Address Correction Service Requested” is applied to the return address on letter mail when the mailer wants to be notified that a customer has moved. With this endorsement on a mailpiece, the USPS responds to the mailer with a new address when redirected mail is first encountered in our system. Either electronic or reply card response is available to the customer.

However, in contrast to the Examiner’s assertion, page 2, ¶ 5 of PARS does not disclose the recited “determining from the reading...” limitation. Instead, PARS merely discloses the use of an “Address Correction Service Requested” human-readable endorsement.

For the same or substantially same reasons as set forth above with regard to claim 1, the invention of independent claim 14, and dependent claims 15-24 would not have been obvious to one of ordinary skill from the teachings of PARS and Second-Generation.

Independent Claim 25 and Dependent Claims 26-31

For the same or substantially the same reasons as discussed with regard to claims 1 and 14, the Patent Owner further submits that the combination of the PARS and Second-Generation references does not disclose or suggest at least the following, as now recited in claim 25:

program instructions that capture optically scanned encoded data including intended recipient identification information and that capture encoded data indicating whether a subscriber wants a corrected address to be provided for the intended recipient on each item of undeliverable mail, and ...

program instructions that update the stored data, based on the data indicating whether a subscriber wants a corrected address provided, to

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incorporate an updated address of the intended recipient of each item of undeliverable mail.

The Patent Owner finds no teaching or suggestion in the PARS or Second-Generation references regarding at least the newly added underlined features now recited in claim 25.

More particularly, with regard to the "program instructions that capture optically scanned encoded data including intended recipient identification information and that capture encoded data indicating whether a subscriber wants a corrected address to be provided for the intended recipient," on page 7 of the Office Action the Examiner cites page 3, ¶¶ 3 and 4 of PARS, as well as page 2, ¶ 5 of PARS, as follows:

In a Processing and Distribution Center (P&DC), every effort is made to process letter mail with automated equipment. More than 35% of the mail that enters the mailstream will pass the scanning and OCR functions that provide the ability to automatically derive the 11 digit barcode. (The other 65% arrive as prebarcoded by mailers and are directed to barcode sorters.) PARS will utilize the Advanced Facer Canceler / Optical Character Reader- Input Subsystem (AFCS/OCR-ISS) and MLOCR-ISS (Multiline Optical Character Reader - Input Subsystem) to scan the images and process the address line data. (See Figure 1)

With PARS, the automation equipment will process the customer name when the delivery point postcode is associated with a COA notification. The ISS's receive a bitmap from the National Customer Service Center (NCSC) via the Change of Address Record Server (CARS) that contains the 11 digit delivery point postcode / COA correlation. When the mailpiece is flagged as potential COA, the customer name OCR read result is compared to the expected customer name provided by CARS (containing customer name records) and a confirmation is

PARS, page 3, ¶¶ 3 and 4.

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Another service to help update mailer directory lists is the Address Correction Service (ACS). An endorsement "Address Correction Service Requested" is applied to the return address on letter mail when the mailer wants to be notified that a customer has moved. With this endorsement on a mailpiece, the USPS responds to the mailer with a new address when redirected mail is first encountered in our system. Either electronic or reply card response is available to the customer.

PARS, page 2, ¶ 5.

The Patent Owner has reviewed these passages from PARS, and submits that these passages do not disclose or suggest "program instructions that capture optically scanned encoded data including intended recipient identification information and that capture encoded data indicating whether a subscriber wants a corrected address to be provided for the intended recipient," as recited in the claimed invention. PARS simply does not disclose or suggest the user encoded data that indicates that whether a subscriber wants a corrected address to be provided. As discussed above with regard to claims 14-24, the Patent Owner respectfully submits that a hand-written and/or human-readable endorsement such as "Address Correction Service Requested" does not constitute "encoded data," as recited in claim 25.

For the same or substantially same reasons as set forth above with regard to claims 1 and 14, the invention of independent claim 25, and dependent claims 26-31, would not have been obvious to one of ordinary skill from the teachings of the PARS and Second-Generation references.

Independent Claim 32 and Dependent Claims 33-38

For the same or substantially the same reasons as discussed with regard to claims 1, 15 and 25, the Patent Owner further submits that the combination of the PARS and Second-Generation references does not disclose or suggest at least the following, as now recited in claim 32:

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- a scanner for reading optically encoded data that includes intended recipient identification information and data indicating whether a sender wants a corrected address provided on each item of undeliverable mail;
- a processor for operation of a computer program for decoding the scanned data, identifying the intended recipient identification information in the decoded data, writing the identified recipient identification information into a data file, and transferring to a sender information for the identified intended recipient for the sender to update the sender's mailing address files subsequent to and based on determining that the sender wants a corrected address provided;

The Patent Owner finds no teaching or suggestion in the PARS or Second-Generation references regarding at least the newly added underlined features now recited in claim 32. In particular, neither PARS nor Second-Generation discloses or suggests at least "...optically encoded data that includes intended recipient identification information and data indicating whether a sender wants a corrected address provided on each item of undeliverable mail," as recited in the claimed invention.

For the same or substantially same reasons as set forth above with regard to claims 1, 14 and 25, the invention of independent claim 32, and dependent claims 33-38 would not have been obvious to one of ordinary skill from the teachings of the PARS and Second-Generation references.

Claims 39-114

Of claims 39, 42-62 and 64-114, claims 39, 57, 75, 88 and 101 remain independent claims. Each of claims 39, 57, 75, 88 and 101 has been amended to recite, inter alia, the use of encoded data to determine if a sender wants a "corrected address provided" or a "corrected address to be provided." The Patent Owner has reviewed PARS and the other references of record, and finds nothing in PARS or the other references of record that teaches or suggests at least these limitations. Accordingly, the PARS reference, alone or in combination with any other reference(s)

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of record, does not show or suggest the combination of features recited in claims 39, 42-62 and 64-114. Withdrawal of the rejection of claims 39, 42-62 and 64-114 is respectfully requested.

Independent Claim 39 and Dependent Claims 42-56

For the same or substantially the same reasons as discussed with regard to claims 1, 14, 25 and 32, the Patent Owner further submits that the combination of the PARS and Second-Generation references does not disclose or suggest at least the following underlined features, as now recited in independent claim 39:

receiving from a sender a plurality of mail items, each including an addressee and incorporating encoded data indicating whether the sender wants a corrected address to be provided for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
determining if the sender wants a corrected address provided based on the decoded data; and
if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files.

The Patent Owner finds no teaching or suggestion in the PARS or Second-Generation references regarding at least the underlined features recited in claim 39.

More particularly, with regard to the “receiving from a sender a plurality of mail items, each including an addressee and incorporating encoded data indicating whether the sender wants a corrected address to be provided for the addressee,” on page 8 of the Office Action the Examiner cites page 2, ¶ 5 of PARS, and page 3, ¶ 3 of PARS. These passages of PARS are provided below, as follows:

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Another service to help update mailer directory lists is the Address Correction Service (ACS). An endorsement "Address Correction Service Requested" is applied to the return address on letter mail when the mailer wants to be notified that a customer has moved. With this endorsement on a mailpiece, the USPS responds to the mailer with a new address when redirected mail is first encountered in our system. Either electronic or reply card response is available to the customer.

PARS, page 2, ¶ 5.

In a Processing and Distribution Center (P&DC), every effort is made to process letter mail with automated equipment. More than 35% of the mail that enters the mailstream will pass the scanning and OCR functions that provide the ability to automatically derive the 11digit barcode. (The other 65% arrive as prebarcoded by mailers and are directed to barcode sorters.) PARS will utilize the Advanced Facer Canceler / Optical Character Reader- Input Subsystem (AFCS/OCR-ISS) and MLOCR-ISS (Multiline Optical Character Reader - Input Subsystem) to scan the images and process the address line data. (See Figure 1)

PARS, page 3, ¶ 3.

The Patent Owner has reviewed these passages from PARS, and submits that these passages do not disclose "receiving from a sender a plurality of mail items, each including an addressee and incorporating encoded data indicating whether the sender wants a corrected address to be provided for the addressee," as recited in the claimed invention. PARS simply does not disclose or suggest the user encoded data that indicates that whether a subscriber wants a corrected address to be provided. The Patent Owner respectfully submits that a hand-written and/or human-readable endorsement such as "Address Correction Service Requested" does not constitute "encoded data," as recited in claim 39.

For the same or substantially same reasons as set forth above with regard to claims 1, 14, 25 and 32, the invention of independent claim 39, and dependent claims 42-56 would not have been obvious to one of ordinary skill from the teachings of PARS and Second-Generation.

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Independent Claim 57 and Dependent Claims 58-62 and 64-74

For the same or substantially the same reasons as discussed with regard to claims 1, 14, 25, 32 and 39, the Patent Owner further submits that the combination of the PARS and Second-Generation references does not disclose or suggest at least the following underlined features, as now recited in independent claim 57:

decoding, subsequent to mailing of the returned mail items, information indicating whether the sender wants a corrected address to be provided for the intended recipient, on at least one of the returned mail items;

obtaining an updated address of the intended recipient subsequent to determining that the sender wants a corrected address to be provided for the intended recipient; and

The Patent Owner finds no teaching or suggestion in the PARS or Second-Generation references regarding at least the underlined features recited in independent claim 57.

For the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32 and 39, the invention of independent claim 57, and dependent claims 58-62 and 64-74 would not have been obvious to one of ordinary skill from the teachings of the PARS and Second-Generation references.

Independent Claim 75 and Dependent Claims 76-87

For the same or substantially the same reasons as discussed with regard to claim 1, 14, 25, 32, 39 and 57, the Patent Owner further submits that the combination of the PARS and Second-Generation references does not disclose or suggest at least the following underlined features, as now recited in independent claim 75:

store decoded information indicating whether the sender wants a corrected address to be provided and a customer number, each associated with at least one of a plurality of mail items returned subsequent to mailing as being undeliverable;
determining from the decoded data that the customer wants a corrected address to be provided for at least one of the plurality of undeliverable mail items;
receive an updated address of an intended recipient for at least one of the undeliverable mail items, subsequent to and based upon the determining step; and
transmit the updated address to a transferee.

The Patent Owner finds no teaching or suggestion in the PARS or Second-Generation references regarding at least the underlined features recited in independent claim 75.

For the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39 and 57, the invention of independent claim 75, and dependent claims 76-87 would not have been obvious to one of ordinary skill from the teachings of the PARS and Second-Generation references.

Independent Claim 88 and Dependent Claims 89-100

For the same or substantially the same reasons as discussed with regard to claim 1, 14, 25, 32, 39, 57 and 75, the Patent Owner further submits that the combination of the PARS and Second-Generation references does not disclose or suggest at least the following underlined features, as now recited in independent claim 88:

a first detector, wherein the first detector detects, subsequent to mailing the undeliverable mail items, encoded information on at least one of the plurality of undeliverable mail items indicating whether a sender wants a corrected address to be provided for at least one of the undeliverable mail items; and
a processor that uses a computer program comprising instructions that cause the system to decode the information indicating whether the sender wants a corrected address to be provided.

The Patent Owner finds no teaching or suggestion in the PARS or Second-Generation references regarding at least the underlined features recited in independent claim 88.

For the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57 and 75, the invention of independent claim 88, and dependent claims 89-100 would not have been obvious to one of ordinary skill from the teachings of the PARS and Second-Generation references.

Independent Claim 101 and Dependent Claims 102-114

For the same or substantially the same reasons as discussed with regard to claim 1, 14, 25, 32, 39, 57, 75 and 88, the Patent Owner further submits that the combination of the PARS and Second-Generation references does not disclose or suggest at least the following underlined features, as now recited in independent claim 101.

encoding information indicating whether the sender wants a corrected address to be provided for an intended recipient on a plurality of mail items;
arranging for a postal service provider to identify, as undeliverable mail items, mail items of the plurality of mail items that are undeliverable; and
arranging for a return mail service provider to decode, subsequent to identifying the undeliverable mail items, the information indicating whether the sender wants a

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corrected address to be provided for the intended recipient on at least one of the undeliverable mail items.

The Patent Owner finds no teaching or suggestion in the PARS or Second-Generation references regarding at least the underlined features recited in independent claim 101.

For the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57, 75 and 88, the invention of independent claim 101 and dependent claims 102-114 would not have been obvious to one of ordinary skill from the teachings of the PARS and Second-Generation references.

Independent Claim 115 and Dependent Claims 116-118

For at least the same or substantially the same reasons as discussed with regard to claims 1, 14, 25, 32, 39, 57, 75, 88 and 101, the Patent Owner further submits that the prior art of record does not disclose or suggest at least the following underlined features, as now recited in independent claim 115.

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating output data that includes a customer number of the sender and at least a portion of the decoded data;
determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

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if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files; and
if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

The Patent Owner finds no teaching or suggestion in the prior art of record regarding at least the combination of the underlined features recited in independent claim 115.

For at least the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57, 75, 88 and 101, the invention of independent claim 115 and dependent claims 116-118 would not have been obvious to one of ordinary skill from the teachings of the prior art of record.

Independent Claim 119 and Dependent Claims 120-122

For at least the same or substantially the same reasons as discussed with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101 and 115, the Patent Owner further submits that the prior art of record does not disclose or suggest at least the following underlined features, as now recited in independent claim 119.

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating output data that includes a customer number of the sender and at least a portion of the decoded data;

determining, based on the decoding step, if the sender wants a corrected address provided for intended recipients;

if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files, including a name change and a job change of intended recipients; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

The Patent Owner finds no teaching or suggestion in the prior art of record regarding the combination of at least the underlined features recited in independent claim 119.

For at least the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101 and 115, the invention of independent claim 119 and dependent claims 120-122 would not have been obvious to one of ordinary skill from the teachings of the prior art of record.

Independent Claim 123 and Dependent Claims 124-126

For at least the same or substantially the same reasons as discussed with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115 and 119, the Patent Owner further submits that the prior art of

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record does not disclose or suggest at least the following underlined features, as now recited in independent claim 123.

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating first output data that includes a customer number of the sender and at least a portion of the decoded data;
sorting the first output data by customer number, after creating the first output data;
creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting step;
determining, based on the decoding, if the sender wants a corrected address provided for intended recipients;
if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files, including a name change and a job change of intended recipients; and
if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

The Patent Owner finds no teaching or suggestion in the prior art of record regarding the combination of at least the following underlined features recited in independent claim 123.

For at least the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115 and 119, the invention of independent claim 123 and

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dependent claims 124-126 would not have been obvious to one of ordinary skill from the teachings of the prior art of record.

Independent Claim 127 and Dependent Claims 128-129

For at least the same or substantially the same reasons as discussed with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115, 119 and 123, the Patent Owner further submits that the prior art of record does not disclose or suggest at least the following underlined features, as now recited in independent claim 127.

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating first output data that includes a customer number of the sender and at least a portion of the decoded data;
sorting the content of the first output data by customer number;
creating second output data that includes a customer number and the name and address of the intended recipients associated with the customer number, after the sorting step;
determining if the sender wants a corrected address provided for intended recipients based on the decoded data;
if the sender wants a corrected address provided, i) electronically transmitting the name and address of the intended recipient to an address correction service provider and receiving an updated address of the intended recipient from the address correction service provider; ii) electronically transferring to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider,

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information for the identified intended recipients that enable the sender to update the sender's mailing address files; and
if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

The Patent Owner finds no teaching or suggestion in the prior art of record regarding at least the following underlined features recited in independent claim 127.

For at least the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115, 119 and 123, the invention of independent claim 127 and dependent claims 128-129 would not have been obvious to one of ordinary skill from the teachings of the prior art of record.

Independent Claim 130 and Dependent Claims 131-132

For at least the same or substantially the same reasons as discussed with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115, 119, 123 and 127, the Patent Owner further submits that the prior art of record does not disclose or suggest at least the following underlined features, as now recited in independent claim 130.

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;
identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;
decoding the encoded data incorporated in at least one of the undeliverable mail items;
creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient;
sorting the content of the first output data by customer number;

creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting step;
determining if the sender wants a corrected address provided for intended recipients based on the decoded data;
if the sender wants a corrected address provided, i) electronically transmitting the name and address of the intended recipient to an address correction service provider and receiving an updated address of the intended recipient from the address correction service provider; and ii) electronically transferring to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and
if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

The Patent Owner finds no teaching or suggestion in the prior art of record regarding at least the underlined features recited in independent claim 130.

For at least the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115, 119, 123 and 127, the invention of independent claim 130 and dependent claims 131-132 would not have been obvious to one of ordinary skill from the teachings of the prior art of record.

Independent Claim 133 and Dependent Claims 134-135

For at least the same or substantially the same reasons as discussed with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115, 119, 123, 127 and 130, the Patent Owner further submits that the combination of the prior art of record does not disclose or suggest at least the following underlined features, as now recited in independent claim 133.

a letter transport for receiving from a sender a plurality of undeliverable mail items that are returned subsequent to mailing as being undeliverable, each undeliverable mail item including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

a camera for decoding the encoded data incorporated in at least one of the undeliverable mail items; and

a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient; ii) sorting the content of the first output data by customer number, after creating the first output data; iii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

wherein the computer, upon determining that the sender wants a corrected address provided,

i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider, and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

The Patent Owner finds no teaching or suggestion in the prior art of record regarding at least the underlined features recited in independent claim 133.

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For at least the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115, 119, 123, 127 and 130, the invention of independent claim 133 and dependent claims 134-135 would not have been obvious to one of ordinary skill from the teachings of the prior art of record.

Independent Claim 136

For at least the same or substantially the same reasons as discussed with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115, 119, 123, 127, 130 and 133, the Patent Owner further submits that the combination of the prior art of record does not disclose or suggest at least the following underlined features, as now recited in independent claim 136.

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a hand-held barcode optical scanner for decoding encoded data on undeliverable mail items

that are returned subsequent to mailing as being undeliverable, the encoded data indicating whether a sender wants a corrected address to be provided for the addressee incorporated, wherein each undeliverable mail item also includes a written addressee;
and

a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data; ii) sorting the content of the first output data by customer number, after creating the first output data; iii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

wherein the computer, upon determining that the sender wants a corrected address provided,

i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider; and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

The Patent Owner finds no teaching or suggestion in the prior art of record regarding at least the underlined features recited in independent claim 136.

For at least the same or substantially same reasons as set forth above with regard to claims 1, 14, 25, 32, 39, 57, 75, 88, 101, 115, 119, 123, 127, 130 and 133, the invention of

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independent claim 136 would not have been obvious to one of ordinary skill from the teachings of the prior art of record.

CONCLUSION

When ascertaining the differences between the prior art and the invention as a whole, one must consider the nature of the problem faced by the inventor, and whether that problem differed from the problems that the prior art sought to solve. It is error, and an improper application of hindsight, to identify alleged features in the prior art that the prior art does not, in fact, disclose. *See, e.g., Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 1094 (Fed. Cir. 1983). Thus, the Graham factual inquiries focus on the problem facing the inventor, and the problems identified in and addressed by the prior art, so as to avoid statutorily-proscribed hindsight. Evaluating obviousness "...requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999). This can be difficult when armed with knowledge of the invention: "[t]he genius of invention is often a combination of known elements which in hindsight seems preordained." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001).

The Supreme Court recognized the danger of hindsight in considering obviousness nearly 100 years ago, observing that "Many things, and the patent law abounds in illustrations, seem obvious after they have been done . . . Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forth to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention." *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 434-435 (1911); *see Graham v. John Deere, Co.*, 383 U.S. 1, 36 (warning against "slipping into use of hindsight"); *Interconnect Planning v. Feil*, 774 F.2d 1132, 1142-43 (Fed. Cir. 1985). Thus, the fundamental question is whether, at the time of the invention, a person of ordinary skill in the art, faced with the same problem as the inventors and with no knowledge of the claimed invention, would have selected the particular elements from the prior art and combined them to obtain the claimed invention. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

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The Patent Owner respectfully submits that it would not have been obvious to a skilled artisan in 2001 to select the elements of the references relied upon by the examiner and to combine them into the invention claimed in the '548 patent. Large organizations that receive thousands of returned mail items on a monthly basis did not have the benefits that the present invention provides. Even prior art that purported to address return mail problems, such as the system and method described in PARS, did not provide a return mail solution for large organizations that directed return mail to a return mail service provider for processing. The '548 patent disclosed innovations such as encoding intended recipient information such as the name and address of an addressee, and scanning and decoding encoded data to determine if the sender wants a corrected address provided with which to update the sender's records. These significant improvements reduce the mail processing burden on the sender, while also advantageously electronically transmitting to the sender an updated intended recipient addresses to prevent future returned mail. These are functions which would not have been achieved by the simple combination of two disparate systems -- one that is directed to preventing the receipt of returned mail (PARS), and another that is directed to processing returned mail (Second-Generation); on the contrary, the innovations disclosed in the '548 patent are directed to going beyond a simple identification of undeliverable mails items prior to attempted delivery by the U.S. Postal Service.

For the reasons given above the Patent Owner requests that a Notice of Intent to Issue *Ex Parte* Reexamination Certificate be issued for the presently pending claims.

Dated: June 8, 2010

Respectfully submitted,

By 

Paul J. Berman

Registration No.: 36,744

Gregory S. Discher

Registration Number, 42,488

COVINGTON & BURLING LLP

1201 Pennsylvania Avenue, N.W.

Washington, DC 20004-2401

(202) 662-6000

Attorney for Patent Owner

Electronic Patent Application Fee Transmittal

Application Number:	90008470			
Filing Date:	31-Jan-2007			
Title of Invention:	SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL			
First Named Inventor/Applicant Name:	6826548			
Filer:	Andrea Reister/Karen Ashton			
Attorney Docket Number:				
Filed as Large Entity				
ex parte reexam Filing Fees				
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Pages:				
Claims:				
Reexamination Independent Claims	1821	7	220	1540
Reexamination claims in excess of 20	1822	18	52	936
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Extension-of-Time:				
Miscellaneous:				
			Total in USD (\$)	2476

Electronic Acknowledgement Receipt

EFS ID:	7771082
Application Number:	90008470
International Application Number:	
Confirmation Number:	2122
Title of Invention:	SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL
First Named Inventor/Applicant Name:	6826548
Customer Number:	26853
Filer:	Andrea Reister/Karen Ashton
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
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1		Transmittals.pdf	150908 bb0cf92dc275667805f4e939c5d118927743 bc23c	yes	4
Multipart Description/PDF files in .zip description					
		Document Description	Start	End	
		Trans Letter filing of a response in a reexam	1	2	
		Reexam Fee Payment Only Filed	3	3	
		Reexam Miscellaneous Incoming Letter	4	4	
Warnings:					
Information:					
2	Reexam Miscellaneous Incoming Letter	Statement.pdf	82194 u3u2481759kcb841d17caadcbf1891631a1 35574	no	2
Warnings:					
Information:					
3	Reexam Certificate of Service	COS.pdf	24149 c1fb775d043c2cc27009d1058b5990b82c9 b8e0d	no	1
Warnings:					
Information:					
4	Response after non-final action-owner timely	Response.pdf	4258689 6bbeff665ccc951011d17864836e61037d37 1958b	no	97
Warnings:					
Information:					
5	Fee Worksheet (PTO-875)	fee-info.pdf	31600 1bfac3b54a7ab67a95aac83ddec334cb3d85 8173c	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			4547540		

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,470	01/31/2007	6826548	031073.00001-US04	2122

26853 7590 08/02/2010
COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/02/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,470.

PATENT NO. 6826548.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Office Action in Ex Parte Reexamination	Control No. 90/008,470	Patent Under Reexamination 6826548	
	Examiner LYNNE H. BROWNE	Art Unit 3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a Responsive to the communication(s) filed on 08 June 2010. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action, 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 3. Interview Summary, PTO-474.
2. Information Disclosure Statement, PTO/SB/08. 4. _____

Part II SUMMARY OF ACTION

- 1a. Claims 1-136 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims 3,40,41 and 63 have been canceled in the present reexamination proceeding.
3. Claims 115-136 are patentable and/or confirmed.
4. Claims 1, 2, 4-39, 42-60, 62, 64-77, 79-91 and 93-114 are rejected.
5. Claims 61,78 and 92 are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
1 been received.
2 not been received.
3 been filed in Application No. _____
4 been filed in reexamination Control No. _____
5 been received by the International Bureau in PCT application No. _____
* See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

Reexamination Procedures

~~In order to ensure full consideration of any amendments, affidavits or~~ ESK
~~declarations, or other documents as evidence of patentability, such documents must be~~
~~submitted in response to this Office action.~~ Submissions after this Office action will be
governed by the requirements of 37 C.F.R. 1.116, after final rejection and 37 C.F.R.
41.33 after appeal, which will be strictly enforced.

The patent owner is reminded of the continuing responsibility under 37 C.F.R. 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability of similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 C.F.R. 1.530(d)-(j), must be formally presented pursuant to 37 C.F.R. 1.52(a) and (b), and must contain any fees required by 37 C.F.R. 1.20(c). See MPEP § 2250(IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requested proceedings are

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merged) in the reexamination proceeding in the manner provided in 37 C.F.R. 1.248.

See 37 C.F.R.1.550(f).

Summary of the Proceeding to Date

- A request for reexamination of claims 1-10, 12-21, 23-30 and 32-38 of U.S. Patent No. 6,826,548 (hereinafter the '548 patent) was filed January 31, 2007.
- An order granting reexamination of claims 1-10, 12-21, 23-30 and 32-38 of the '549 patent was mailed on April 17, 2007.
- A decision merging the instant reexamination proceeding with reissue application no. 11/605,488 was mailed on June 1, 2007.
- A requirement for information under 37 C.F.R. § 1.105 was mailed on May 5, 2008.
- A response to the requirement was filed on June 25, 2008.
- A non-final Office action was mailed on December 29, 2008.
- A response to the non-final Office action was filed on April 29, 2009.
- A final Office action was mailed on July 8, 2009.
- A response to the final Office action was filed on November 9, 2009.
- A request for continued examination was filed on November 9, 2009.
- A non-final Office action was mailed on February 17, 2010
- A decision severing the merger of the instant reexamination proceeding and reissue application no. 11/605,488 was mailed on March 10, 2010.
- A response to the non-final Office action was filed on June 8, 2010.

Claim Objections

Claims 44 and 75 are objected to because of the following informalities:

Re claim 44, there is no antecedent basis in claim 43 for the claim terminology "the data file".

Re claim 75, there is no antecedent basis in the preamble for the claim terminology "the sender". In addition, it is unclear if the "at least one of the undeliverable mail items" recited in lines 8-9 is the same "at least one of a plurality of mail items" recited in lines 4-5 or a different mail item.

Appropriate correction is required.

Claim 89 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 89 recites the limitation "further comprising encoding and decoding intended recipient identification information". This limitation appears to be either a method step or functional language; however, claim 89 depends from claim 88 which is a system claim. Method steps or functional language alone fail to further limit the subject matter a system claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 89 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 89 recites the limitation "further comprising encoding and decoding intended recipient identification information". It is unclear what element of the system claim in claim 88 is required to perform this method step or function. Accordingly, the scope of claim 89 is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Rejections based on Uhl

Claims 88-91, 93-95, 97, 100-108, 113 and 114 are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,292,709 to Uhl et al.

(hereinafter "Uhl").

In regard to claim 88, the examiner finds:

1. Uhl discloses a system for processing a plurality of undeliverable mail items (Fig. 1).
2. The system comprises a first detector (213).
3. The first detector detects encoded information (advanced instructions) on at least one of the plurality of undeliverable mail items indicating whether a sender wants a corrected address to be provided for the at least one of the undeliverable mail items (column 4, line 66 - column 5, line 3).
4. The encoded information is detected subsequent to mailing the undeliverable mail items (column 6, lines 41-42).
5. The system comprises a processor (can be processing in column 8, line 51).
6. The processor uses a computer program comprising instructions that cause the system to decode (read) the information indicating whether the sender wants a corrected address to be provided (column 8, lines 43-45).

As to claim 89, the examiner finds:

Uhl discloses a system wherein encoding and decoding of the intended recipient identification information is done by numerous elements of the system (Fig. 1).

As to claim 90, the examiner finds:

Uhl discloses a plurality of undeliverable mail items comprising undeliverable as address mail items (column 6, lines 41-42).

As to claim 91, the examiner finds:

The instructions enable an updated address of an intended recipient to be sent to a transferee (column 6, lines 55-57).

As to claim 93, the examiner finds:

In Uhl the information indicating whether the sender wants a corrected address to be provided indicates whether to determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the undeliverable mail items (column 6, lines 56,57).

As to claim 94, the examiner finds:

In Uhl the encoded data that indicates whether the senders wants a corrected address provided comprises encoded information (advance instructions) is detectable by optical detection (208).

As to claim 95, the examiner finds:

1. Uhl discloses a mail transport device (Fig. 1).
2. The mail transport device conveys the plurality of mail items.

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3. The system sorts the plurality of undeliverable mail items into a plurality of bins (205, Fig. 13).

As to claim 97, the examiner finds:

1. Uhl discloses a second detector (209).
2. The second detector detects information for an intended recipient on the at least one of the plurality of undeliverable mail items (column 4, lines 9-15).
3. Uhl discloses an updating processor (215) that operates an updating computer program.
4. The updating computer program comprises instructions that direct the system to obtain updated address information for the intended recipient (column 4, lines 15-19).
5. The updating processor operates in accordance with the information indicating whether the sender wants a corrected address to be provided (column 6, lines 56-57).
6. The instructions direct the system to write the updated address information into a data file (column 6, lines 55-56).

As to claim 100, the examiner finds:

In Uhl the first detector and the second detector are included in a detection unit.

In regard to claim 101, the examiner finds:

1. Uhl discloses a method for processing a plurality of undeliverable mail items (entire document).

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2. The method includes the step of encoding information indicating whether the senders wants a corrected address to be provided for an intended recipient on a plurality of mail items (column 8, lines 38-42).
3. The method includes the step of arranging for a postal service provider to identify, as undeliverable mail items, mail items of the plurality of mail items that are undeliverable (column 6, lines 41-42).
4. The method includes the step of arranging for a return mail service provided to decode (read) the information indicating whether the sender wants a corrected address to be provided for the intended recipient on at least one of the undeliverable mail its (column 8, lines 52-54).
5. The step of decoding occurs subsequent to identifying the undeliverable mail items (Fig. 4).

As to claim 102, the examiner finds:

Uhl discloses a method wherein the return mail service provided is the postal service provider (USPS).

As to claim 103, the examiner finds:

Uhl discloses a method wherein the plurality of undeliverable mail items comprise undeliverable as addressed mail items (column 6, lines 41-42).

As to claim 104, the examiner finds:

1. Uhl discloses a method including the step of arranging for the return mail service provided to determine an updated mailing address for the at least one of the undeliverable mail items (column 6, lines 2-8).

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2. The step of arranging for the return mail service is done as indicated by the information indicating whether the sender wants a corrected address to be provided (column 6, lines 56-57).
3. Uhl discloses a method including the step of arranging for the return mail service provided to store the updated mailing address in a data file (column 6, lines 55-56).

As to claim 105, the examiner finds:

In Uhl the information indicating whether the sender wants a corrected address to be provided indicates that the return mail service provided should determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the undeliverable mail items (column 6, lines 56,57).

As to claim 106, the examiner finds:

Uhl discloses the step of arranging for the return mail service provider to load the undeliverable mail items on a transport mechanism for sorting into a plurality of categories (Fig. 13).

As to claim 107, the examiner finds:

In Uhl the plurality of categories comprises an encoded mail piece not decoded category (mail pieces that have to go through the video coding stage) and an encoded mail piece decoded successfully category (mail pieces that do not have to go through the video coding stage).

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As to claim 108, the examiner finds:

In Uhl the encoded information indicating whether the sender wants a corrected address to be provided on at least one of the undeliverable mail items comprises encoded information detectable by optical detection.

As to claim 113, the examiner finds:

In Uhl the encoded mail piece address correction service type information is detectable with reference to the front side of each of the plurality of mail items (Fig. 9).

As to claim 114, the examiner finds:

Uhl further comprises the step of encoding customer identification information (Fig. 9).

Claims 39, 42-48, 53-60, 62, 64-66, 71-77, 79-83, 87 and 99 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,292,709 to Uhl et al. (hereinafter "Uhl").

In regard to claim 39, the examiner finds:

1. Uhl discloses a method for processing a plurality of undeliverable mail items (Figs. 1-4).
2. The method comprises the step of receiving from a sender a plurality of mail items (column 6, lines 41-43).
3. Each mail item includes an addressee (132a).
4. Each mail item incorporates encoded data (213) indicating whether the sender wants a corrected address to be provided for the addressee (column 4, line 66 – column 5, line 3).

5. The method comprises identifying as undeliverable mail items, items of the plurality of mail items that are returned subsequent to mailing as undeliverable (column 6, lines 41-43).
6. The method comprises the step of decoding the encoded data incorporated in at least one of the undeliverable mail items (column 4, line 62 – column 5, line 3).
7. The method comprises the step of determining if the sender wants a corrected address provided based on the decoded data (column 6, lines 55-57).
8. The method comprises the step of transferring to the sender information identified for the intended recipients that enable the sender to update the sender's mailing address files, if the sender wants a corrected address provided (column 6, lines 55-58).
9. Uhl does not explicitly state that the information identified for the intended recipients is transferred to the sender electronically.
10. From the context of the sentence that discussed the transfer of this information to the sender (discussion of compiling the information) it appears that the transmission is electronic.
11. The equivalence of manual and electronic transmission of information identified for an intended recipient of a returned mail item was well known in the art at the time of the invention as evidenced by USPS Solution (page 2, 5th paragraph, lines 6-7).

Thus, Uhl appears to anticipate claim 39; however, if it is determined that Uhl does not anticipate claim 39, modification of Uhl to electronically transfer the information

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identified for the intended recipients would have been obvious to one of ordinary skill in the art at the time of the invention as such practice was well known in the art as evidenced by the U.S. Postal Service Publication "Postal Automated Redirection System – The USPS Solution" (hereinafter "USPS Solution").

As to claim 42, the examiner finds:

Uhl discloses a method including the step of returning the undeliverable mail items to a return mail service provider (all of the mail processed using the method of Fig. 4 is has been returned to the mail service provider).

As to claim 43, the examiner finds:

1. Uhl discloses a method comprising the step of determining an updated mailing address for the at least one of the undeliverable mail items (column 6, lines 34-37).
2. USPS Solution discloses a method wherein the updated mailing address is electronically transferred to the transferee page 2, 5th paragraph, lines 6-7).

As to claim 44, the examiner finds:

1. USPS Solution discloses storing the updated mailing address in a data file (inherent in the process of electronically transferring the updated mailing address).
2. USPS Solution discloses electronically transferring the data file to the transferee (page 2, 5th paragraph, lines 6-7).

As to claim 45, the examiner finds:

Uhl discloses a method step of encoding information that allows a transferee of the undeliverable mail items to determine, directly or indirectly, an updated address associated with an intended recipient of the at least one of the undeliverable mail items (column 4, lines 8-13).

As to claim 46, the examiner finds:

Uhl discloses a method comprising the step of loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories (Fig. 13).

As to claim 47, the examiner finds:

1. Uhl discloses a method wherein the plurality of categories comprises a bar code not decoded category (column 4, lines 19-21).
2. Uhl discloses a method wherein the plurality of categories comprise a bar code decoded successfully category (column 4, lines 53-55).

As to claim 48, the examiner finds:

In Uhl the encoded data that indicates whether the senders wants a corrected address provided comprises encoded information (advance instructions) is detectable by optical detection (208).

As to claim 53, the examiner finds:

In Uhl the encoded data is detectable with reference to the front side of each of the plurality of mail items (figs. 7-12).

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As to claim 54, the examiner finds:

Uhl discloses the steps of encoding and decoding a customer number associated with the sender (column 6, lines 43-44).

As to claim 55, the examiner finds:

Uhl discloses the step of generating a data file comprising the customer number (column 6, lines 43-44).

As to claim 56, the examiner finds:

1. Uhl discloses the step of obtaining an updated address for an intended recipient of the at least one of the undeliverable mail items (column 6, lines 53-55).
2. The updated address is obtained in accordance with the data indicating whether the sender wants a corrected address provided (column 6, lines 53-57).

In regard to claim 57, the examiner finds:

1. Uhl discloses the step of decoding information indicating whether the sender wants a corrected address to be provided for the intended recipient on at least one of the returned mail items (column 6, lines 41-44).
2. The step of decoding is done subsequent to mailing of the returned mail items (column 6, line 40).
3. Uhl discloses the step of obtaining an updated address of the intended recipient (column 6, lines 53-55).
4. The step of obtaining an updated address occurs subsequent to a step of determining that the sender wants a corrected address to be provided for the intended recipient (column 6, lines 40-52).

5. Uhl discloses transmitting an updated address of the intended recipient to a transferee (column 6, lines 55-57).
6. Uhl does not explicitly state that the information identified for the intended recipients is transferred to the sender electronically.
7. From the context of the sentence that discussed the transfer of this information to the sender (discussion of compiling the information) it appears that the transmission is electronic.
8. The equivalence of manual and electronic transmission of information identified for an intended recipient of a returned mail item was well known in the art at the time of the invention as evidenced by USPS Solution (page 2, 5th paragraph, lines 6-7).

Thus, Uhl appears to anticipate claim 57; however, if it is determined that Uhl does not anticipate claim 57, modification of Uhl to electronically transfer the information identified for the intended recipients would have been obvious to one of ordinary skill in the art at the time of the invention as such practice was well known in the art as evidenced by USPS Solution.

As to claim 58, the examiner finds:

Uhl discloses a method wherein the at least one of the returned mail items is an undeliverable as addressed mail item (column 6, lines 41-43).

As to claim 59, the examiner finds:

Uhl discloses the step of collecting the returned mail items at a processing location (column 5, lines 34-35).

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As to claim 60, the examiner finds:

In Uhl the transferee is the sender (column 6, lines 55-57).

As to claim 62, the examiner finds:

Uhl discloses a method including the step of decoding an encoded customer number associated with the sender (Fig. 8).

As to claim 64, the examiner finds:

Uhl discloses a method comprising the step of loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories (Fig. 13).

As to claim 65, the examiner finds:

1. Uhl discloses a method wherein the plurality of categories comprises a bar code not decoded category (column 4, lines 19-21).
2. Uhl discloses a method wherein the plurality of categories comprise a bar code decoded successfully category (column 4, lines 53-55).

As to claim 66, the examiner finds:

In Uhl the information indicating whether the senders wants a corrected address provided on at least one of the returned mail items comprises encoded information (advance instructions) detectable by optical detection (208).

As to claim 71, the examiner finds:

In Uhl the information indicating whether the sender wants a corrected address to be provided is detectable with reference to the front side of each of the returned mail items (Figs. 8 and 9).

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As to claim 72, the examiner finds:

In Uhl the information indicating that the sender wants a corrected address to be provided indicates that the senders wants an updated address associated with the intended recipients to be provided (column 6, lines 55-57).

As to claim 73, the examiner finds:

In Uhl a data file comprising a customer number associated with the sender is generated (column 6, lines 41-43).

As to claim 74, the examiner finds:

Uhl discloses the step of transmitting the data file to an address service provider (forwarding data bank) in order to obtain an updated address for an intended recipient of the at least one of the returned mail items (column 6, lines 2-7).

In regard to claim 75, the examiner finds:

1. Uhl discloses an online processing system (Fig. 1).
2. The online processing system includes a computer program product comprising instructions for causing a computer to store decoded information indicating whether sender of a mail item wants a corrected address to be provided (column 6, lines 55-57).
3. The computer program product comprises instructions for causing a computer to store a customer number (column 8, lines 48-50).
4. In Uhl both the corrected address instruction and the customer number are associated with the at least one of a plurality of mail items.

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5. The at least one of the plurality of mail items is returned subsequent to mailing as being undeliverable (column 6, lines 41-42).
6. The computer program product comprises instructions for causing a computer to determine from the decoded data that the customer wants a corrected address to be provided for at least one of the plurality of undeliverable mail items (column 6, lines 55-57).
7. The computer program product comprises instructions for causing a computer to receive an updated address of an intended recipient for the at least one of the undeliverable mail items (column 6, lines 53-55).
8. In Uhl the receiving instruction is executed subsequent to and based upon the determining step (Fig. 4).
9. The computer program product comprises instructions for causing the updated address to be transmitted to a transferee (column 6, lines 55-57).
10. Uhl does not explicitly state that the computer transmits the updated address to the transferee.
11. From the context of the sentence that discusses the transfer of this information to the sender (discussion of compiling the information) it appears that the computer transmits the updated address.
12. The equivalence of manual and electronic transmission of information identified for an intended recipient of a returned mail item was well known in the art at the time of the invention as evidenced by USPS Solution (page 2, 5th paragraph, lines 6-7).

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Thus, Uhl appears to anticipate claim 75; however, if it is determined that Uhl does not anticipate claim 75, modification of Uhl to include an instruction for the computer to transfer the information identified for the intended recipients would have been obvious to one of ordinary skill in the art at the time of the invention as such practice was well known in the art as evidenced by USPS Solution.

As to claim 76, the examiner finds:

In Uhl the plurality of undeliverable mail items comprises undeliverable as addressed mail items (column 6, line 42).

As to claim 77, the examiner finds:

In Uhl the transferee is a sender of the at least one of the plurality of undeliverable mail items (column 6, lines 55-57).

As to claim 79, the examiner finds:

1. Uhl discloses instructions for causing the computer to store decoded data including intended recipient identification information from the at least one of the plurality of undeliverable mail items (column 6, lines 53-55).
2. Uhl discloses instructions for updating a data file to incorporated an updated address of an intended recipient of the at least one of the plurality of undeliverable mail items (column 6, lines 55-57).

As to claim 80, the examiner finds:

In Uhl the information indicating whether the sender wants a corrected address to be provided indicates whether to determine, directly or indirectly, an updated address

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associated with an intended recipient of the at least one of the undeliverable mail items (column 6, lines 56,57).

As to claim 81, the examiner finds:

In Uhl the intended recipient comprises a name and an address associated with the intended recipient of the at least one of the plurality of undeliverable mail items (column 6, lines 2-5).

As to claim 82, the examiner finds:

Uhl discloses instructions that cause the computer to receive the updated address from a remote data repository (forwarding data bank).

As to claim 83, the examiner finds:

In Uhl the information indicating whether the sender wants a corrected address to be provided incorporated in at least one of the undeliverable mail items comprises encoded information (advance instructions) detectable by optical detection (column 5, lines 4-5).

As to claim 87, the examiner finds:

In Uhl the information indicating whether the sender wants a corrected address to be provided is detectable with reference to the front side of each of the returned mail items (Figs. 8 and 9).

In regard to claim 99, the examiner finds:

1. Uhl does not explicitly state that the computer transmits the updated address to the transferee.

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2. From the context of the sentence that discusses the transfer of this information to the sender (discussion of compiling the information) it appears that the computer transmits the updated address electronically.
3. The equivalence of manual and electronic transmission of information identified for an intended recipient of a returned mail item was well known in the art at the time of the invention as evidenced by USPS Solution (page 2, 5th paragraph, lines 6-7).

Thus, Uhl appears to anticipate claim 99; however, if it is determined that Uhl does not anticipate claim 99, modification of Uhl to include an instruction for the computer to transfer the information identified for the intended recipients electronically would have been obvious to one of ordinary skill in the art at the time of the invention as such practice was well known in the art as evidenced by USPS Solution.

Claims 87 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uhl in view of USPS Solution as applied to claims above, and further in view of U.S. Patent Application Publication No. 2001/0010334 to Park et al. (hereinafter "Park").

In regard to claims 87 and 109, the examiner finds:

1. Uhl discloses encoded information (advance instructions) indicating whether the sender wants a corrected address to be provided.
2. The encoded data is placed on the at least one of the plurality of undeliverable mail items (Fig. 9).
3. Uhl fails to disclose encoded data provided as an optically encoded bar code.

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4. Park discloses the use of optically encoded bar codes to provide customer information (paragraph 20).
5. In Park the bar code can be used to provide a variety of information.

Based on the evidence set forth in findings 1-5, the examiner additionally finds:

6. The prior art contained a "base" product and method (Uhl) upon which the claimed invention can be seen as an "improvement".
7. The prior art contained a "comparable" product and method (Park) that was improved in the same way as the claimed invention (by using bar codes).
8. One of ordinary skill in the art could have applied the known "improvement" technique to the "base" product and method and the results would have been predictable to one of ordinary skill in the art.

Based on findings 1-8, the examiner concludes that claims 87 and 109 would have been obvious to one of ordinary skill in the art at the time of the invention because a technique (using bar codes) for improving a particular class of products and methods (mail processing products and methods) was made part of the ordinary capabilities of one skill in the art based on the teaching of such improvement in other situations (Park).

Claim 96 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uhl in view of U.S. Patent No. 5,612,889 to Pintsov et al. (hereinafter "Pintsov").

As to claim 96, the examiner finds:

1. Uhl does not specify the type of first detector that is used.
2. Pintsov discloses a mail processing system wherein the first detector is a hand held device (column 6, line 31).

3. In Pintsov the first detector is used when traditional scanners will not work (column 6, lines 26-31).

Based on the evidence set forth in findings 1-3, the examiner additionally finds:

4. The prior art contained a "base" system (Uhl) upon which the claimed invention can be seen as an "improvement".
5. The prior art contained a "comparable" system (Pintsov) that was improved in the same way as the claimed invention.
6. One of ordinary skill in the art could have applied the improvement in the same way to the "base" system as it was applied to the "comparable" system and the results would have been predictable.

Based on findings 1-7 the examiner concludes that claim 96 would have been obvious to one of ordinary skill in the art at the time of the invention because an improvement that enhances a particular class of systems was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such an improvement in other situations. Specifically, the improvement of providing a hand held scanner for use when a traditional scanner cannot be used was made a part of the ordinary capabilities of one of ordinary skill in the art by the use of this improvement in a mail processing (Pintsov).

Claim 98 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uhl in view of U.S. Patent No. 5,422,821 to Allen et al. (hereinafter "Allen").

As to claim 98, the examiner finds:

1. Uhl does not specify the type of scanner that is used.

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2. Allen discloses a mail processing system wherein the scanner is a mixed media optical character recognition (MLOCR) device (66).
3. Allen states "As the FC 48, MLOCR 66, RBCS 70 and BCS 76 are common pieces of USPS automated mail processing equipment whose function, operation and design are well known in the art, detailed functional. Operational and design description beyond that needed for an understanding of the present invention is deemed unnecessary".

Based on the evidence set forth in findings 1-3, the examiner that the use of a MLOCR device in the system disclosed by Uhl would have been obvious to one of ordinary skill in the art at the time of the invention as the use of such a device in a mail processing system was well known in the art as described by Allen.

Claims 110 and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uhl in view of Park as applied to claim 109 above, and further in view of U.S.

Patent No. 6,371,521 to Petkovsek.

As to claim 110, the examiner finds:

1. Park does not address the placement of the optically encoded bar code.
2. Petkovsek discloses a method of labeling mail items requiring special mailing services that places a bar code in a return address section on each mailed item (column 12, lines 9-11).

Based on the evidence set forth in findings 1-2, the examiner additionally finds:

3. The prior art contained a "base" method upon which the claimed invention can be seen as an "improvement".

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4. The prior art contained a "comparable" method (Petkovsek) that was improved in the same way as the claimed invention.
5. One of ordinary skill in the art could have applied the improvement in the same way to the "base" method as it was applied to the "comparable" method and the results would have been predictable.

Based on findings 1-5 the examiner concludes that claim 110 would have been obvious to one of ordinary skill in the art at the time of the invention because an improvement that enhances a particular class of methods was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such an improvement in other situations. Specifically, the improvement of placing a bar code in the return address portion of a mail item was made a part of the ordinary capabilities of one of ordinary skill in the art by the use of this improvement in a method of labeling mail items (Petkovsek).

As to claim 111, the examiner finds:

Park discloses an optically encoded bar code that is a two-dimensional bar code.

Claim 112 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uhl in view of Park and Petkovsek as applied to claims above, and further in view of U.S.

Patent No. 5,731,574 to Bodie et al. (hereinafter "Bodie").

As to claim 112, the examiner finds:

1. Park does not state what type of bar code is used.
2. Bodie discloses that the U.S. Postal Service required the use of Portable Data File 417 (PDF417) barcodes (column 1, lines 24-26).

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Based on the evidence set forth in finding 2, the examiner concludes that claim 112 would have been obvious to one of ordinary skill in the art at the time of the invention in order for the method claimed therein to comply with U.S. Postal Service requirements and thus be a commercially viable method for use in the United States.

Rejections with Park as the base reference

Claims 1, 4-10, 12, 14-21, 23, 32-34, 49, 51, 57-62, 64, 65, 67, 69 and 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Park and USPS Solution.

With respect to Claim 1, the examiner finds:

1. Park discloses a method for processing a plurality of undeliverable mail items (140).
2. The method comprises the step of encoding data including intended recipient identification information (paragraph 25, lines 1-3) on each of a plurality of mail items from a sender.
3. The recipient identification information includes the name and address of an addressee (paragraph 9, lines 5-8 and paragraph 25, lines 4-6).
4. The step of encoding data occurs prior to mailing (paragraph 7 lines 1-5).
5. The method includes the step of receiving those items of the plurality of mail items that are returned as being undeliverable (paragraph 21, lines 12-13).
6. The method includes the step of scanning and decoding the encoded data (paragraph 21, lines 14-16) on the items of undeliverable mail to identify intended recipients having an incorrect address.

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7. The steps of scanning and decoding occur subsequent to receiving the returned undeliverable mail items (paragraph 21 lines 12-16).
8. The method includes the step of electronically transferring to the sender information for the identified intended recipients for the sender to update the sender's mailing address files (paragraph 21, lines 16-20).
9. The step of electronically transferring occurs subsequent to decoding (paragraph 21, lines 1-20).
10. The method disclosed by Park does not determine if the sender wants a corrected address provided.
11. The USPS Solution discloses a method for processing a plurality of undeliverable mail items (CFS and PARS).
12. In both CFS and PARS address correction service (ACS) must be requested so that the USPS doesn't waste time sending address correction information when it is not wanted.

Based on these findings the examiner additionally finds:

13. The prior art included each method step claimed, although not necessarily in a single prior art reference.
14. The only difference between the claimed invention and the prior art is the lack of actual combination of the method steps in a single prior art reference.
15. One of ordinary skill in the art could have combined the method steps into one comprehensive method.

16. In combination the method steps would have performed the same functions as they did separately.

17. One of ordinary skill in the art would have found the results of the combined method predictable.

Based on the evidence set forth in items 1-17 the examiner concludes that claim 1 would have been obvious because all the claimed method steps were known in the prior art and one skilled in the art could have combined the method steps as claimed with no change to the function of the method steps and the results of the method would have been predictable. Specifically, Park discloses every step except for determining if the sender wants a corrected address. USPS Solution teaches this step, thus every step was known in the prior art. Adding the step of checking to see if the sender wants a corrected address would not have changed the function of the method disclosed by Park and the results of the method would have been predictable in that there is nothing unpredictable about checking to see if a sender wants a corrected address.

Accordingly, the combined teachings of Park and USPS solution would have rendered claim 1 obvious to one of ordinary skill in the art at the time of the invention.

As to claim 4, the examiner finds:

Park discloses the step of loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories (paragraph 20, lines 23-34).

As to claim 5, the examiner finds:

1. Park discloses a method wherein the plurality of categories includes a barcode not decoded category (situation where there is not barcode, see Fig. 4).
2. Park discloses a method wherein the plurality of categories includes a barcode decoded successfully category (situation where barcode is read and mailing address is updated).

As to claim 6, the examiner finds:

1. Park discloses a method wherein the step of scanning the encoded data on the undeliverable mail includes reading an optically encoded barcode on each item (paragraph 20, lines 15-16).
2. Park discloses a method wherein the step of scanning the encoded data on the undeliverable mail includes decoding the barcode to determine the intended recipient identification information associated with an intended recipient of the item (paragraph 20, lines 15-19: note, the step of reading a barcode inherently include decoding the barcode. Otherwise the barcode is not "read").

As to claim 7, the examiner finds:

Park discloses the step of generating an output file of the identified intended recipients from the scanned and decoded data in the optically encoded barcode (paragraph 20, lines 18-19: an output file must necessarily be generated in order for information from the customer ID to be searched).

As to claim 8, the examiner finds:

Park discloses the step of transmitting the generated output file to a mailing address service provided in order to obtain an updated address for each intended recipient of an undeliverable mail item (Fig. 1).

As to claim 9, the examiner finds:

Park discloses a method wherein the step of optically encoding includes placing an optically encoded barcode on each of the plurality of mail items (paragraph 2, lines 1-3).

As to claim 10, the examiner finds:

Park does not specify the side of the mail items on which the optically encoded barcode is to be placed; however, as the front side and the back side are the only two options available, Park necessarily discloses a method wherein the barcode is placed on either the front side or the backside.

As to claim 12, the examiner finds:

Park discloses a barcode that is a two-dimensional barcode.

In regard to claim 14, the examiner finds

1. Park discloses a method for processing returned mail items sent by a subscriber to a recipient (Fig 1).
2. In Park's method the returned mail items incorporate encoded intended recipient identification information (paragraph 20, lines 3-7)

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3. The method comprises the step of collecting the returned mail items, not delivered to an intended recipient, at a process location (paragraph 21, lines 12-13).
4. The method includes the step of reading the encoded intended recipient identification information (paragraph 20, lines 15-16) from the collected returned mail items.
5. The encoded intended recipient identification information includes the name and address of an addressee (paragraph 9, lines 5-8 and paragraph 25, lines 4-6).
6. The encoded intended recipient identification information is used to identify intended recipients having incorrect addresses (paragraph 20, lines 18-19).
7. The method includes the step of electronically gathering updated recipient identification information including an updated address of the intended recipient (paragraph 21, lines 12-16).
8. The method includes the step of electronically transferring to the sender information for the identified intended recipients for the sender to update the sender's mailing address files (paragraph 21, lines 16-20).
9. The step of electronically transferring occurs subsequent to decoding (paragraph 21, lines 1-20).
10. The method disclosed by Park does not determine if the sender wants a corrected address provided.
11. The USPS Solution discloses a method for processing a plurality of undeliverable mail items (CFS and PARS).

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12. In both CFS and PARS address correction service (ACS) must be requested so that the USPS doesn't waste time sending address correction information when it is not wanted.

Based on these findings the examiner additionally finds:

13. The prior art included each method step claimed, although not necessarily in a single prior art reference.

14. The only difference between the claimed invention and the prior art is the lack of actual combination of the method steps in a single prior art reference.

15. One of ordinary skill in the art could have combined the method steps into one comprehensive method.

16. In combination the method steps would have performed the same functions as they did separately.

17. One of ordinary skill in the art would have found the results of the combined method predictable.

Based on the evidence set forth in items 1-17 the examiner concludes that claim 14 would have been obvious because all the claimed method steps were known in the prior art and one skilled in the art could have combined the method steps as claimed with no change to the function of the method steps and the results of the method would have been predictable. Specifically, Park discloses every step except for determining if the sender wants a corrected address. USPS Solution teaches this step, thus every step was known in the prior art. Adding the step of checking to see if the sender wants a corrected address would not have changed the function of the method disclosed by

Park and the results of the method would have been predictable in that there is nothing unpredictable about checking to see if a sender wants a corrected address.

Accordingly, the combined teachings of Park and USPS solution would have rendered claim 14 obvious to one of ordinary skill in the art at the time of the invention.

As to claim 15, the examiner finds:

Park discloses the step of loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories (paragraph 20, lines 23-34).

As to claim 16, the examiner finds:

1. Park discloses a method wherein the plurality of categories includes a barcode not decoded category (situation where there is not barcode, see Fig. 4).
2. Park discloses a method wherein the plurality of categories includes a barcode decoded successfully category (situation where barcode is read and mailing address is updated).

As to claim 17, the examiner finds:

1. Park discloses a method wherein the step of scanning the encoded data on the undeliverable mail includes reading an optically encoded barcode on each item (paragraph 20, lines 15-16).
2. Park discloses a method wherein the step of scanning the encoded data on the undeliverable mail includes decoding the barcode to determine the intended recipient identification information associated with an intended recipient of the

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item (paragraph 20, lines 15-19: note, the step of reading a barcode inherently include decoding the barcode. Otherwise the barcode is not "read").

As to claim 18, the examiner finds:

Park discloses the step of generating an output file of the identified intended recipients from the scanned and decoded data in the optically encoded barcode (paragraph 20, lines 18-19: an output file must necessarily be generated in order for information from the customer ID to be searched).

As to claim 19, the examiner finds:

Park discloses the step of transmitting the generated output file to a mailing address service provided in order to obtain an updated address for each intended recipient of an undeliverable mail item (Fig. 1).

As to claim 20, the examiner finds:

Park discloses a method wherein the step of optically encoding includes placing an optically encoded barcode on each of the plurality of mail items (paragraph 2, lines 1-3).

As to claim 21, the examiner finds:

Park does not specify the side of the mail items on which the optically encoded barcode is to be placed; however, as the front side and the back side are the only two options available, Park necessarily discloses a method wherein the barcode is place on either the front side or the backside.

As to claim 23, the examiner finds:

Park discloses a barcode that is a two-dimensional barcode.

In regard to claim 32, the examiner finds:

1. Park discloses a system for processing a plurality of undeliverable mail items (Fig 1).
2. The system includes a scanner (123) for reading optically encoded data.
3. The optically encoded data includes intended recipient identification information on each item of undeliverable mail (paragraph 25).
4. The undeliverable mail is returned subsequent to an attempted delivery (paragraph 21, lines 11-16).
5. The system includes a processor for operation of a computer program for decoding the scanned data (paragraph 21, line 14).
6. The computer program identifies the intended recipient (paragraph 21, lines 15-16).
7. The computer program writes the identified recipient identification information into a data file (the computer program must necessarily do this in order to search the customer database as described in paragraph 21, lines 15-16).
8. The computer program transfers to a sender information for the identified intended recipient for the sender to update the sender's mailing address files (paragraph 21, lines 16-20).
9. The system includes a database (customer database) for storing the data file containing the identified recipient identification information.
10. The method disclosed by Park does not determine if the sender wants a corrected address provided.

11. The USPS Solution discloses a method for processing a plurality of undeliverable mail items (CFS and PARS).
12. In both CFS and PARS address correction service (ACS) must be requested so that the USPS doesn't waste time sending address correction information when it is not wanted.

Based on these findings the examiner additionally finds:

13. The prior art included each method step claimed, although not necessarily in a single prior art reference.
14. The only difference between the claimed invention and the prior art is the lack of actual combination of the method steps in a single prior art reference.
15. One of ordinary skill in the art could have combined the method steps into one comprehensive method.
16. In combination the method steps would have performed the same functions as they did separately.
17. One of ordinary skill in the art would have found the results of the combined method predictable.

Based on the evidence set forth in items 1-17 the examiner concludes that claim 32 would have been obvious because all the claimed method steps were known in the prior art and one skilled in the art could have combined the method steps as claimed with no change to the function of the method steps and the results of the method would have been predictable. Specifically, Park discloses every step except for determining if the sender wants a corrected address. USPS Solution teaches this step, thus every step

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was known in the prior art. Adding the step of checking to see if the sender wants a corrected address would not have changed the function of the method disclosed by Park and the results of the method would have been predictable in that there is nothing unpredictable about checking to see if a sender wants a corrected address.

Accordingly, the combined teachings of Park and USPS solution would have rendered claim 32 obvious to one of ordinary skill in the art at the time of the invention.

As to claim 33, the examiner finds:

Park discloses optically encoded data containing a two-dimensional barcode.

As to claim 34, the examiner finds:

Park discloses a mail transport device for (145) for conveying the plurality of undeliverable items and sorting the undeliverable mail items into a plurality of bins.

As to claim 49, the examiner finds:

Park discloses the use of an optically encoded bar code to present the encoded data (113).

As to claim 51, the examiner finds:

Park discloses an optically encoded bar code that is a two-dimensional bar code.

In regard to claim 57, the examiner finds:

1. Park discloses a method of processing returned mail items sent by a sender to an intended recipient (Fig. 1).
2. The method is performed subsequent to mailing of the returned mail items (paragraph 21, lines 12-13).
3. The method includes the step of obtaining an updated address of the intended recipient (paragraph 21, lines 14-16).

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4. The method includes the step of electronically transmitting an updated address of the intended recipient to a transferee (paragraph 21, lines 25-27).
5. The method disclosed by Park does not determine if the sender wants a corrected address provided.
6. The USPS Solution discloses a method for processing a plurality of undeliverable mail items (CFS and PARS).
7. In both CFS and PARS address correction service (ACS) must be requested so that the USPS doesn't waste time sending address correction information when it is not wanted.

Based on these findings the examiner additionally finds:

8. The prior art included each method step claimed, although not necessarily in a single prior art reference.
9. The only difference between the claimed invention and the prior art is the lack of actual combination of the method steps in a single prior art reference.
10. One of ordinary skill in the art could have combined the method steps into one comprehensive method.
11. In combination the method steps would have performed the same functions as they did separately.
12. One of ordinary skill in the art would have found the results of the combined method predictable.

Based on the evidence set forth in items 1-12 the examiner concludes that claim 57 would have been obvious because all the claimed method steps were known in the prior

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art and one skilled in the art could have combined the method steps as claimed with no change to the function of the method steps and the results of the method would have been predictable. Specifically, Park discloses every step except for determining if the sender wants a corrected address. USPS Solution teaches this step, thus every step was known in the prior art. Adding the step of checking to see if the sender wants a corrected address would not have changed the function of the method disclosed by Park and the results of the method would have been predictable in that there is nothing unpredictable about checking to see if a sender wants a corrected address.

Accordingly, the combined teachings of Park and USPS solution would have rendered claim 57 obvious to one of ordinary skill in the art at the time of the invention.

As to claim 58, the examiner finds:

Park discloses a method wherein at least one of the returned mail items is an undeliverable as address mail item (paragraph 21, lines 12-13).

As to claim 59, the examiner finds:

Park discloses a method comprising collecting the returned mail items at a processing location (paragraph 20, lines 33-34).

As to claim 60, the examiner finds:

Park discloses a method wherein the transferee is the sender.

As to claim 62, the examiner finds:

Park discloses a method comprising the step of decoding an encoded customer number associated with the sender (paragraph 21, lines 17-20).

As to claim 64, the examiner finds:

Park discloses the step of loading the plurality of undeliverable mail items on a transport mechanism for sorting into a plurality of categories (paragraph 20, lines 23-34).

As to claim 65, the examiner finds:

1. Park discloses a method wherein the plurality of categories includes a barcode not decoded category (situation where there is not barcode, see Fig. 4).
2. Park discloses a method wherein the plurality of categories includes a barcode decoded successfully category (situation where barcode is read and mailing address is updated).

As to claim 67, the examiner finds:

Park discloses the use of an optically encoded bar code to present the encoded data (113).

As to claim 69, the examiner finds:

Park discloses an optically encoded bar code that is a two-dimensional bar code.

As to claim 71, the examiner finds:

Park necessarily discloses a method wherein the information indicating whether the senders wants a corrected address to be provided is detectable with reference to either the front side or the back side of each of the returned mail items in that the front side and the back side are the only two options available.

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As to claim 72, the examiner finds:

USPS Solution discloses a method step wherein the information indicating whether the sender wants a corrected address to be provided is the statement "Address Correction Service Requested" applied to the return address which clearly indicates that the sender wants an updated address associated with the intended recipients to be provided.

As to claim 73, the examiner finds:

Park discloses generating a data file comprising a customer number associated with the sender (paragraph 21, lines 17-20).

Claims 11, 22, 50 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of USPS Solution as applied to claims above, and further in view of U.S. Patent No. 6,371,521 to Petkovsek.

In regard to claim 11, 22, 50 and 68, the examiner finds:

1. Park does not address the placement of the optically encoded bar code.
2. USPS Solution does not address the placement of the optically encoded bar code.
3. Petkovsek discloses a method of labeling mail items requiring special mailing services that places a bar code in a return address section on each mailed item (column 12, lines 9-11).

Based on the evidence set forth in findings 1-3, the examiner additionally finds:

4. The prior art contained a "base" method (Park) upon which the claimed invention can be seen as an "improvement".

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5. The prior art contained a "comparable" method (Petkovsek) that was improved in the same way as the claimed invention.
6. One of ordinary skill in the art could have applied the improvement in the same way to the "base" method as it was applied to the "comparable" method and the results would have been predictable.

Based on findings 1-6 the examiner concludes that claims 11, 22, 50 and 68 would have been obvious to one of ordinary skill in the art at the time of the invention because an improvement that enhances a particular class of methods was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such an improvement in other situations. Specifically, the improvement of placing a bar code in the return address portion of a mail item was made a part of the ordinary capabilities of one of ordinary skill in the art by the use of this improvement in a method of labeling mail items (Petkovsek).

Claims 13, 24, 52 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of USPS Solution as applied to claims above, and further in view of Bodie.

In regard to claims 13, 24, 52 and 70, the examiner finds:

3. Park does not state what type of bar code is used.
4. Bodie discloses that the U.S. Postal Service required the use of Portable Data File 417 (PDF417) barcodes (column 1, lines 24-26).

Based on the evidence set forth in finding 2, the examiner concludes that claims 13, 24, 52 and 70 would have been obvious to one of ordinary skill in the art at the time of the

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invention in order for the method claimed therein to comply with U.S. Postal Service requirements and thus be a commercially viable method for use in the United States.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of USPS Solution as applied to claim 32 above, and further in view of Pintsov.

As to claim 35, the examiner finds:

7. Park does not specify the type of scanner that is used.
8. USPS Solution does not specify the type of scanner that is used.
9. Pintsov discloses a mail processing system wherein the scanner is a hand held device (column 6, line 31).
10. In Pintsov the hand held scanner is used when traditional scanners will not work (column 6, lines 26-31).

Based on the evidence set forth in findings 1-4, the examiner additionally finds:

11. The prior art contained a "base" system (Park) upon which the claimed invention can be seen as an "improvement".
12. The prior art contained a "comparable" system (Pintsov) that was improved in the same way as the claimed invention.
13. One of ordinary skill in the art could have applied the improvement in the same way to the "base" system as it was applied to the "comparable" system and the results would have been predictable.

Based on findings 1-7 the examiner concludes that claim 35 would have been obvious to one of ordinary skill in the art at the time of the invention because an improvement that enhances a particular class of systems was made part of the ordinary capabilities

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of one skilled in the art based upon the teaching of such an improvement in other situations. Specifically, the improvement of providing a hand held scanner for use when a traditional scanner cannot be used was made a part of the ordinary capabilities of one of ordinary skill in the art by the use of this improvement in a mail processing (Pintsov).

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of USPS Solution as applied to claim 32 above, and further in view of Allen.

As to claim 36, the examiner finds:

4. Park does not specify the type of scanner that is used.
5. USPS Solution does not specify the type of scanner that is used.
6. Allen discloses a mail processing system wherein the scanner is a mixed media optical character recognition (MLOCR) device (66).
7. Allen states "As the FC 48, MLOCR 66, RBCS 70 and BCS 76 are common pieces of USPS automated mail processing equipment whose function, operation and design are well known in the art, detailed functional. Operational and design description beyond that needed for an understanding of the present invention is deemed unnecessary".

Based on the evidence set forth in findings 1-4, the examiner that the use of a MLOCR device in the system disclosed by Park would have been obvious to one of ordinary skill in the art at the time of the invention as the use of such a device in a mail processing system was well known in the art as described by Allen.

Claims 2, 25-30, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of USPS Solution as applied to claims above, and further in view of Uhl.

As to claim 2, the examiner finds:

1. Park discloses the step of storing the decoded data in a data file (paragraph 21, lines 14-16: in order to search a customer database for a customer ID that has been read by an automatic mail sorting system, the customer ID must necessarily be stored in a data file).
2. Park discloses the step of delivering updated data to the subscriber electronically for use in updating the mailing address files of the subscriber (paragraph 21, lines 25-27).
3. Park fails to disclose the step of updating the stored data to correct the address of each intended recipient of the items of undeliverable mail.
4. Uhl discloses a method of processing a plurality of undeliverable mail items (Fig. 1).
5. Uhl discloses the step of storing decoded data for an item of undeliverable mail to identify the intended recipient (column 4, lines 14-16).
6. Uhl discloses the step of updating the stored data to correct the address of each intended recipient of the items of undeliverable mail (column 6, lines 3-7 and lines 53-55).
7. Uhl discloses the step of delivering the updated data to a subscriber for use in updating the mailing address files of the subscriber (column 6, lines 55-58).

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Based on the evidence set forth in findings 1-7, the examiner additionally finds:

8. The prior art contained a "base" method (Park) upon which the claimed invention can be seen as an "improvement".
9. The prior art contained a known technique (updating the stored data as in Uhl) that is applicable to the base method.
10. One of ordinary skill in the art would have recognized that apply the known technique of Uhl to the "base" method of Park would have yielded predictable results and resulted in an improved system.

Based on the evidence set forth in findings 1-10, it is clear that the method step of updating stored data was recognized as part of the ordinary capability of one skilled in the art at the time of the invention. Accordingly, including this method step in the method disclosed by Park would have been obvious to one of ordinary skill in the art at the time of the invention because the method disclosed by Park was ready for improvement and the results including the step would have been predictable. Accordingly, the combined teachings of Park and Uhl render claim 2 obvious.

In regard to claim 25, the examiner finds:

1. Park discloses a computer readable medium containing a computer program product comprising instructions for controlling a computer system to process a plurality of undeliverable mail items (Fig. 4).
2. The computer program product comprises program instructions that capture optically scanned encoded data (S404) on each item of the undeliverable mail.

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3. The optically scanned encoded data includes recipient identification information (zip code and name).
4. The program instructions store the captured data in a data file (the computer program must necessarily do this in order to search the customer database as described in paragraph 21, lines 15-16).
5. The program instructions transmit the updated intended recipient address information to a subscriber electronically to update the address files of the subscriber (paragraph 21, lines 25-27).
6. The program instructions disclosed by Park do not capture encoded data indicating whether a subscriber wants a corrected address provided.
7. The USPS Solution discloses a computer program product comprising instructions for processing a plurality of undeliverable mail items (CFS and PARS).
8. In both CFS and PARS address correction service (ACS) must be requested so that the USPS doesn't waste time sending address correction information when it is not wanted.
9. The program instructions disclosed by Park do not update the stored data.
10. Uhl discloses a computer program product comprising instructions for capturing optically scanned encoded data (column 4, lines 14-16 and 50-53).
11. The instructions update the stored data to incorporate an updated address of the intended recipient for each item of undeliverable mail (column 6, lines 3-7 and lines 53-55):

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12. The instructions update the stored data based on data indicating whether a subscriber wants a corrected address to be provided (column 6, lines 55-57).
13. Uhl discloses the step of delivering the updated data to a subscriber for use in updating the mailing address files of the subscriber (column 6, lines 55-58).

Based on these findings the examiner additionally finds:

14. The prior art included each program instruction claimed, although not necessarily in a single prior art reference.
15. The only difference between the claimed invention and the prior art is the lack of actual combination of the program instructions in a single prior art reference.
16. One of ordinary skill in the art could have combined the program instructions into one comprehensive computer program product.
17. In combination the computer program product would have performed the same functions as they did separately.
18. One of ordinary skill in the art would have found the results of the combined computer program product predictable.

Based on the evidence set forth in items 1-18 the examiner concludes that claim 25 would have been obvious because all the claimed program instructions were known in the prior art and one skilled in the art could have combined the program instructions as claimed with no change to the function of the program instructions and the results would have been predictable. Specifically, Park discloses every instruction except for determining if the sender wants a corrected address and updating the stored data. USPS Solution teaches an instruction for determining if the sender wants a corrected

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address and Uhl teaches an instruction for updating the stored data; thus, every program instruction was known in the prior art. Adding an instruction to check if the sender wants a corrected address and adding an instruction to store the updated data would not have changed the function of computer program product disclosed by Park and the results of these instructions would have been predictable in that there is nothing unpredictable about checking to see if a sender wants a corrected address or updating data. Accordingly, the combined teachings of Park, USPS Solution and Uhl would have rendered claim 25 obvious to one of ordinary skill in the art at the time of the invention.

As to claim 26, the examiner finds:

Uhl discloses encoded identification information that includes a name and current address associated with the intended recipient of the mail item (column 3, lines 1-2).

As to claim 27, the examiner finds:

Park discloses program instructions that transmit the stored data file electronically to a mailing address service provider (126) in order to obtain an updated address for each intended recipient of an undeliverable mail item (Fig. 1).

As to claim 28, the examiner finds:

Park discloses encoded data (132) placed in an optically encoded barcode on each mail item.

As to claim 29, the examiner finds:

Park discloses a bar code that is a two-dimensional bar code.

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As to claim 30, the examiner finds:

Park discloses an optically encoded bar code that is placed on either the front side or the back side of each mail item.

As to claim 37, the examiner finds:

Uhl discloses a computer program including instructions that update the stored data in the data file with an updated address associated with each of the intended recipients of the undeliverable mail items (column 6, lines 53-55).

As to claim 38, the examiner finds:

1. Uhl discloses instructions that deliver the updated address data to a subscriber for use in updating the address files for the intended recipients (column 6, lines 55-58).
2. Uhl does not explicitly state that the delivery occurs electronically.
3. USPS Solution discloses the equivalent of electronic and manual transmission of updated address information.

As discuss above in the rejections based on the combined teachings of Uhl and USPS Solution, the use of electronic transmission would have been obvious to one of ordinary skill in the art at the time of the invention.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of USPS Solution and Uhl as applied to claims above, and further in view of Petkovsek.

In regard to claim 31, the examiner finds:

1. Park does not address the placement of the optically encoded bar code.

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2. USPS Solution does not address the placement of the optically encoded bar code.
3. Petkovsek discloses a method of labeling mail items requiring special mailing services that places a bar code in a return address section on each mailed item (column 12, lines 9-11).

Based on the evidence set forth in findings 1-3, the examiner additionally finds:

4. The prior art contained a "base" method (Park) upon which the claimed invention can be seen as an "improvement".
5. The prior art contained a "comparable" method (Petkovsek) that was improved in the same way as the claimed invention.
6. One of ordinary skill in the art could have applied the improvement in the same way to the "base" method as it was applied to the "comparable" method and the results would have been predictable.

Based on findings 1-6 the examiner concludes that claim 31 would have been obvious to one of ordinary skill in the art at the time of the invention because an improvement that enhances a particular class of methods was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such an improvement in other situations. Specifically, the improvement of placing a bar code in the return address portion of a mail item was made a part of the ordinary capabilities of one of ordinary skill in the art by the use of this improvement in a method of labeling mail items (Petkovsek).

Allowable Subject Matter

Claims 115-136 are allowed.

The following is an examiner's statement of reasons for allowance:

Claims 115, 119, 123, 127 and 130 recite "if the sender does not want a corrected address provided, *posting* return mail data records on a network that is *accessible to the sender* to enable the sender to access the records"(emphasis added). Claims 133 and 136 similarly recite "upon determining that the sender does not want a corrected address provided, *posts* return mail data records on a network that is *accessible to the sender* to enable the sender to access the records" (emphasis added).

The prior art of record fails to disclose or suggest these limitations. Accordingly, it would not have been obvious to modify the teachings of Uhl, Park or any of the prior art of record to include a method of "posting return mail data records on a network that is accessible to the sender" or a system that "posts return mail data records on a network that is accessible to the sender as claimed. Claims 116-118, 120-122, 124-126, 129, 131, 132, 134 and 135 depend from claims 115, 119, 123, 127, 130 or 133, respectively, and likewise are allowable.

Claims 61, 78 and 92 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

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Claims 61, 78 and 92 recite "wherein the transferee is a return mail service provider". All of the prior art of record disclose a transferee that is the sender. None of the prior art of record discloses or suggests a transferee that is a return mail service provider. Accordingly, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the method or system disclosed by Park, Uhl or any of the prior art of record to have a transferee that is a return mail service provider.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. See MPEP § 706.07(a).

THIS ACTION IS MADE FINAL.

A shortened statutory period for response to this action is set to expire 2 months from the mailing date of this action.

Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings. The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee

set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

Conclusion

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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Any inquiry concerning this communication or earlier communications from the Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

____/Lynne H Browne/____

Lynne H. Browne
CRU Examiner
GAU 3992
(571) 272-3670

Conferee: ESK

Conferee: JOT

Notice of References Cited	Application/Control No. 90/008,470	Applicant(s)/Patent Under Reexamination 6826548	
	Examiner LYNNE H. BROWNE	Art Unit 3992	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A US-5,731,574	03-1998	Bodie et al.	235/375
*	B US-5,422,821	06-1995	Allen et al.	700/219
	C US-			
	D US-			
	E US-			
	F US-			
	G US-			
	H US-			
	I US-			
	J US-			
	K US-			
	L US-			
	M US-			

FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
	O				
	P				
	Q				
	R				
	S				
	T				

NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	
V	
W	
X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	999	"Portable Data File 417" or PDF417 or "PDF-417"	USPAT	OR	OFF	2010/07/26 18:02
L2	895	"Portable Data File 417" or PDF417 or "PDF-417" and mail	USPAT	OR	OFF	2010/07/26 18:02
L3	852	"Portable Data File 417" or PDF417 or "PDF-417" same mail	USPAT	OR	OFF	2010/07/26 18:02
L4	849	"Portable Data File 417" or PDF417 or "PDF-417" same mail same "bar code"	USPAT	OR	OFF	2010/07/26 18:03
L5	29	("Portable Data File 417" or PDF417 or "PDF-417")same mail	USPAT	OR	OFF	2010/07/26 18:06

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	10013	hand same scanner	USPAT	OR	OFF	2010/07/26 19:18
L2	145	L1 same mail	USPAT	OR	OFF	2010/07/26 19:18
L3	3445	hand near3 scanner	USPAT	OR	OFF	2010/07/26 19:18
L4	59	L3 same mail	USPAT	OR	OFF	2010/07/26 19:19
L5	46	MLOCR same mail	USPAT	OR	OFF	2010/07/26 19:54

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Hungerpiller et al.

Reexamination Proceeding:

Group Art Unit: 3992

Control No. 90/008,470

Examiner: Lynne H. Browne

Filed: January 31, 2007

Corresponding to U.S. Patent No. 6,826,548

Office Action dated: August 2, 2010

For: SYSTEM AND METHOD FOR
PROCESSING RETURNED MAIL

**RESPONSE BY PATENT OWNER TO OFFICE ACTION
IN EX PARTE REEXAMINATION**

Mail Stop *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Further to 37 C.F.R. § 1.116 and M.P.E.P § 2272, this paper is filed in response to the Final Office Action dated August 2, 2010.

Claims 1-38 issued in U.S. Patent No. 6,826,548.

Claims 39-136 were added in the present proceeding.

After entry of the Response, claims 57, 75, 88 and 115-136 are pending.

In accordance with the requirements of 37 C.F.R § 1.530(j), this Response does not enlarge the scope of the claims, and does not introduce any new matter.

Application No.: 90/008,470
Filing Date: January 31, 2007
Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

Amendments to the Claims in accordance with M.P.E.P. § 2250 I.B. are reflected in the listing of claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 14 of this paper.

It is not believed that fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional fees are necessary to prevent abandonment of this application, then such fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740.

AMENDMENTS TO THE CLAIMS

1. - 56. (Cancelled).

57. (Currently Amended - Three Times Amended) A method for processing returned mail items sent by a sender to an intended recipient, the method comprising:

- decoding, subsequent to mailing of the returned mail items, information indicating whether the sender wants a corrected address to be provided for the intended recipient, on at least one of the returned mail items;
- obtaining an updated address of the intended recipient subsequent to determining that the sender wants a corrected address to be provided for the intended recipient; and
- electronically transmitting an updated address of the intended recipient to a transferee, wherein the transferee is a return mail service provider.

58. - 74. (Cancelled).

75. (Currently Amended - Three Times Amended) A computer program product residing on a computer readable medium comprising instructions for causing a computer to:

- store decoded information indicating whether a sender wants a corrected address to be provided and a customer number, each associated with at least one of a plurality of mail items returned subsequent to mailing as being undeliverable;
- determining from the decoded data that the customer wants a corrected address to be provided for at least one of the plurality of undeliverable mail items;
- receive an updated address of an intended recipient for at least one of the plurality of undeliverable mail items, subsequent to and based upon the determining step; and
- transmit the updated address to a transferee, wherein the transferee is a return mail service provider.

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76. - 87. (Cancelled).

88. (Currently Amended - Three Times Amended) A system for processing a plurality of undeliverable mail items comprising:

a first detector, wherein the first detector detects, subsequent to mailing the undeliverable mail items, encoded information on at least one of the plurality of undeliverable mail items indicating whether a sender wants a corrected address to be provided for at least one of the undeliverable mail items; and
a processor that uses a computer program comprising instructions that cause the system to: i) decode the information indicating whether the sender wants a corrected address to be provided; ii) encode and decode intended recipient identification information; and iii) enable an updated address of an intended recipient to be sent to a transferee, wherein the transferee is a return mail service provider.

89. - 114. (Cancelled).

115. (Previously Presented) A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating output data that includes a customer number of the sender and at least a portion of the decoded data;

determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

116. (Previously Presented) The method of claim 115, further comprising transmitting the name and address of the intended recipients to a mailing address service provider, subsequent to the determining step, in order to obtain an updated address for each intended recipient of an undeliverable mail item.

117. (Currently Amended) The method of claim 115, wherein the encoded data further indicates a name and address of the intended recipient.

118. (Previously Presented) The method of claim 115, wherein the plurality of mail items further include a written return address that is not that address of the sender.

119. (Previously Presented) A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating output data that includes a customer number of the sender and at least a portion of the decoded data;

determining, based on the decoding step, if the sender wants a corrected address provided for intended recipients;

if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files, including a name change and a job change of intended recipients; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

120. (Previously Presented) The method of claim 119, further comprising transmitting the name and address of the intended recipients to a mailing address service provider, subsequent to the determining step, in order to obtain an updated address for each intended recipient of an undeliverable mail item.

121. (Currently Amended) The method of claim 119, wherein the encoded data further indicates a name and address of the intended recipient.

122. (Previously Presented) The method of claim 119, wherein the plurality of mail items further include a written return address that is not that address of the sender.

123. (Previously Presented) A method for processing a plurality of undeliverable mail items, comprising:

- receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;
- identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;
- decoding the encoded data incorporated in at least one of the undeliverable mail items;
- creating first output data that includes a customer number of the sender and at least a portion of the decoded data;
- sorting the first output data by customer number, after creating the first output data;
- creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting step;
- determining if the sender wants a corrected address provided for intended recipients;
- if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files, including a name change and a job change of intended recipients; and
- if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

124. (Previously Presented) The method of claim 123, wherein the encoded data further indicates a name and address of the intended recipient.

125. (Previously Presented) The method of claim 123, wherein the plurality of mail items further include a written return address that is not that address of the sender.

126. (Previously Presented) The method of claim 123, further comprising transmitting the name and address of the intended recipients to a mailing address service provider in order to obtain an updated address for each intended recipient of an undeliverable mail item.

127. (Previously Presented) A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating first output data that includes a customer number of the sender and at least a portion of the decoded data;

sorting the content of the first output data by customer number;

creating second output data that includes a customer number and the name and address of the intended recipients associated with the customer number, after the sorting step;

determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

if the sender wants a corrected address provided, i) electronically transmitting the name and address of the intended recipient to an address correction service provider and receiving an updated address of the intended recipient from the address correction service provider; ii) electronically transferring to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

128. (Previously Presented) The method of claim 127, wherein the encoded data further indicates a name and address of the intended recipient.

129. (Previously Presented) The method of claim 127, wherein the plurality of mail items further include a written return address that is not that address of the sender.

130. (Previously Presented) A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient;

sorting the content of the first output data by customer number;

creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting step;

determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

if the sender wants a corrected address provided, i) electronically transmitting the name and address of the intended recipient to an address correction service provider and receiving an updated address of the intended recipient from the address correction service provider; and ii) electronically transferring to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

Application No.: 90/008,470
Filing Date: January 31, 2007
Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

131. (Previously Presented) The method of claim 130, wherein the encoded data further indicates a name and address of the intended recipient.

132. (Previously Presented) The method of claim 130, wherein the plurality of mail items further include a written return address that is not that address of the sender.

133. (Previously Presented) A system for processing a plurality of undeliverable mail items, comprising:

a letter transport for receiving from a sender a plurality of undeliverable mail items that are returned subsequent to mailing as being undeliverable, each undeliverable mail item including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

a camera for decoding the encoded data incorporated in at least one of the undeliverable mail items; and

a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient; ii) sorting the content of the first output data by customer number, after creating the first output data; iii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

wherein the computer, upon determining that the sender wants a corrected address provided,

i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider; and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

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134. (Previously Presented) The method of claim 133, wherein the encoded data further indicates a name and address of the intended recipient.

135. (Previously Presented) The method of claim 133, wherein the plurality of mail items further include a written return address that is not that address of the sender.

136. (Previously Presented) A system for processing a plurality of undeliverable mail items, comprising:

a hand-held barcode optical scanner for decoding encoded data on undeliverable mail items that are returned subsequent to mailing as being undeliverable, the encoded data indicating whether a sender wants a corrected address to be provided for the addressee incorporated, wherein each undeliverable mail item also includes a written addressee; and

a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient; ii) sorting the content of the first output data by customer number, after creating the first output data; iii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

wherein the computer, upon determining that the sender wants a corrected address provided,

i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider; and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

Application No.: 90/008,470
Filing Date: January 31, 2007
Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

REMARKS

A. Status of Claims

After entry of the Response, claims 57, 75, 88 and 115-136 are pending.

Claims 1-38 were in originally issued patent 6,826,548.

Claims 39-136 were added in the present proceeding.

B. Explanation of Claim Language Changes and Support for Same

Claim 57 has been amended as follows:

57. (Currently Amended - Three Times Amended) A method for processing returned mail items sent by a sender to an intended recipient, the method comprising:
decoding, subsequent to mailing of the returned mail items, information indicating whether the sender wants a corrected address to be provided for the intended recipient, on at least one of the returned mail items;
obtaining an updated address of the intended recipient subsequent to determining that the sender wants a corrected address to be provided for the intended recipient; and
electronically transmitting an updated address of the intended recipient to a transferee, wherein the transferee is a return mail service provider.

On page 53 of the Office Action, the Examiner indicated that claim 61 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 57 has been amended to incorporate the subject matter of claim 61. Accordingly, claim 57 is in condition for allowance.

Application No.: 90/008,470
Filing Date: January 31, 2007
Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

Claim 75 has been amended as follows:

75. (Currently Amended - Three Times Amended) A computer program product residing on a computer readable medium comprising instructions for causing a computer to:

- store decoded information indicating whether [the] a sender wants a corrected address to be provided and a customer number, each associated with at least one of a plurality of mail items returned subsequent to mailing as being undeliverable;
- determining from the decoded data that the customer wants a corrected address to be provided for at least one of the plurality of undeliverable mail items;
- receive an updated address of an intended recipient for at least one of the plurality of undeliverable mail items, subsequent to and based upon the determining step; and
- transmit the updated address to a transferee, wherein the transferee is a return mail service provider.

On page 4 of the Office Action, the Examiner objected to claim 75 because there is no antecedent basis for the claim terminology "the sender." In addition, on page 4 of the Office Action, the Examiner states for claim 75 that it is unclear if the "at least one of the undeliverable mail items" in lines 8-9 is the same as "at least one of a plurality of mail items" recited in lines 4-5 or a different mail item. On page 53 of the Office Action, the Examiner indicated that claim 78 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As set forth in the amendments above, claim 75 has been amended to address the Examiner's objection(s), and incorporate the subject matter of claim 78. Accordingly, claim 75 is in condition for allowance.

Application No.: 90/008,470
Filing Date: January 31, 2007
Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

Claim 88 has been amended as follows:

88. (Currently Amended - Three Times Amended) A system for processing a plurality of undeliverable mail items comprising:

a first detector, wherein the first detector detects, subsequent to mailing the undeliverable mail items, encoded information on at least one of the plurality of undeliverable mail items indicating whether a sender wants a corrected address to be provided for at least one of the undeliverable mail items; and

a processor that uses a computer program comprising instructions that cause the system to i) decode the information indicating whether the sender wants a corrected address to be provided; ii) encode and decode intended recipient identification information; and iii) enable an updated address of an intended recipient to be sent to a transferee, wherein the transferee is a return mail service provider.

On page 53 of the Office Action, the Examiner indicated that claim 92 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 88 has been amended to incorporate the subject matter of claim 92, and the subject matter of intervening claims 89 and 91. The Examiner objected to claim 89 under 37 C.F.R. § 1.75 on page 4 of the Office Action. The Examiner's objection to claim 89 is addressed in the amendments to claims 88 set forth above. Accordingly, the Examiner's objection to claim 89 is rendered moot. The Examiner also rejected claim 89 under 35 U.S.C. § 112, second paragraph, on page 5 of the Office Action. The Examiner's rejection of claim 89 under 35 U.S.C. § 112, second paragraph, is addressed in the amendments to claims 88 set forth above. Accordingly, the Examiner's rejection of claim 89 under 35 U.S.C. § 112, second paragraph, is rendered moot. Accordingly, claim 88 is in condition for allowance.

Application No.: 90/008,470

Filing Date: January 31, 2007

Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Claim 117 has been amended as follows:

117. (Currently Amended) The method of claim 115, wherein the encoded data further indicates a name and address of the intended recipient.

As seen, a purely administrative amendment to claim 117 has been made, adding a period (".") at the end of the claim to place it in proper form.

Claim 121 has been amended as follows:

121. (Currently Amended) The method of claim 119, wherein the encoded data further indicates a name and address of the intended recipient.

As seen, a purely administrative amendment to claim 121 has been made, adding a period (".") at the end of the claim to place it in proper form.

Application No.: 90/008,470
Filing Date: January 31, 2007
Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

After entry of the amendment, claims 57, 75, 88 and 115-136 are pending.

Claims 1-56, 58-74, 76-87 and 89-114 are cancelled. Claims 3, 40, 41 and 63 were cancelled prior to the Patent Owner's Amendment filed on June 8, 2010. The Examiner's rejection of claims 1, 2, 4-39, 42-60, 62, 64-77, 79-91 and 93-114 in the August 2, 2010 Office Action is therefore rendered moot.

As noted above, the amendments to claims 57, 75 and 88 place them in condition for allowance. In the August 2, 2010 Office Action, the Examiner has indicated that claims 115-136 are patentable.

Application No.: 90/008,470
Filing Date: January 31, 2007
Title: *Ex Parte* Reexamination of Patent No. 6,826,548

Docket No.: 031073.00001-US04

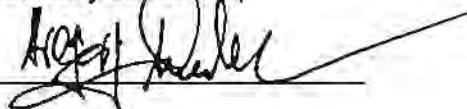
CONCLUSION

In view of the foregoing amendments and the remarks, the Patent Owner requests that a Notice of Intent to Issue *Ex Parte* Reexamination Certificate be issued for presently pending claims 57, 75, 88 and 115-136.

If there are any other issues remaining which the Examiner believes could be resolved, she is requested to contact the undersigned at the telephone number indicated below.

Dated: September 2, 2010

Respectfully submitted,

By 

Gregory S. Discher
Registration Number, 42,488
COVINGTON & BURLING LLP
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401
(202) 662-5485
Attorney for Patent Owner

Certificate of Service

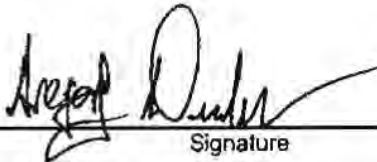
Pursuant to 37 C.F.R. § 1.248, I certify that the following documents were served by first-class mail on the following counsel of record for third party reexamination requester:

Drew S. Hamilton
Knobbe, Martens, Olson & Bear, LLP
550 West C Street, Suite 1200
San Diego, CA 92101

on this 2 day of September 2010
Date

Copies of the following documents were served:

1. Transmittal Letter;
2. Amendment Transmittal Letter;
3. Response by Patent Owner to Office Action in Ex Parte Reexamination; and
4. Certificate of Service.



Signature

Gregory S. Discher

Typed or printed name of person signing Certificate

42,488
Registration Number, if applicable

(202) 662-5485
Telephone Number

Electronic Acknowledgement Receipt

EFS ID:	8346759
Application Number:	90008470
International Application Number:	
Confirmation Number:	2122
Title of Invention:	SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL
First Named Inventor/Applicant Name:	6826548
Customer Number:	26853
Filer:	Andrea Reister/Karen Ashton
Filer Authorized By:	Andrea Reister
Attorney Docket Number:	031073.00001-US04
Receipt Date:	02-SEP-2010
Filing Date:	31-JAN-2007
Time Stamp:	15:41:17
Application Type:	Reexam (Patent Owner)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Reexam Miscellaneous Incoming Letter	Transmittals.pdf	89469 <small>1e7a0acc52ad0c31679b1d03e113eb115817e05c</small>	no	3

Warnings:

Information:

2	Reexam Response to Final Rejection	Response.pdf	704380	no	19
			e14923b09f48171f280424a216cb745a6c1ffe1		

Warnings:

Information:

3	Reexam Certificate of Service	COS.pdf	24490	no	1
			9568aa2a7c16b7bc1177e599edbc8d53c9eadb1d		

Warnings:

Information:

Total Files Size (in bytes):	818339
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Ralph M. Hungerpiller et al.

Reexamination Proceeding

Confirmation No.: 2122

Control No.: 90/008,470

Group Art Unit: 3992

Filed: January 31, 2007

Examiner: Lynne H. Browne

Corresponding to U.S. Patent No. 6,826,548

For: SYSTEM AND METHOD FOR PROCESSING
RETURNED MAIL

TRANSMITTAL LETTER

MS Ex Parte Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:

1. Amendment Transmittal Letter;
2. Response by Patent Owner to Office Action in Ex Parte Reexamination; and
3. Certificate of Service.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0740, under Docket No. 031073.00001-

Application No.: 90/008,470

2

Docket No.: 031073.00001-US04

US04.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740.

Dated: September 2, 2010

Respectfully submitted,

By 

Gregory S. Discher

Registration No.: 42,488

COVINGTON & BURLING LLP

1201 Pennsylvania Avenue, N.W.

Washington, DC 20004-2401

(202) 662-6000

Attorney for Patent Owner

AMENDMENT TRANSMITTAL LETTER

Docket No.
031073.00001-US04

Control No.
90/008,470-Conf. #2122

Filing Date
January 31, 2007

Examiner
Lynne H. Browne

Art Unit
3992

Applicant(s): Ralph M. Hungerpilller et al.

Invention: SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED					
	Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present	Rate	
Total Claims	21	- 132 =		x 52.00	0.00
Independent Claims	8	- 16 =		x 220.00	0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					
Other fee (please specify):					
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:					0.00

Large Entity

Small Entity

No additional fee is required for this amendment.

Please charge Deposit Account No. 50-0740 in the amount of \$ _____

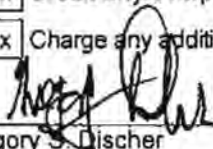
A check in the amount of \$ _____ to cover the filing fee is enclosed.

Payment by credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge and credit Deposit Account No. 50-0740 as described below. A duplicate copy of this sheet is enclosed.

Credit any overpayment.

Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17.



Gregory S. Discher
Attorney/Agent Reg. No.: 42,488
COVINGTON & BURLING LLP
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401
(202) 662-5485

Dated: September 2, 2010



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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,470	01/31/2007	6826548	031073.00001-US04	2122
26853	7590	09/27/2010	EXAMINER	
COVINGTON & BURLING, LLP ATTN: PATENT DOCKETING 1201 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004-2401			ART UNIT	PAPER NUMBER

DATE MAILED: 09/27/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Knobbe, Martens, Olsen & Bear, LLP
2040 Main St., 14th Floor
Irvine, CA 92614

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,470.

PATENT NO. 6826548.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Notice of Intent to Issue Ex Parte Reexamination Certificate	Control No.	Patent Under Reexamination	
	90/008,470	6826548	
	Examiner	Art Unit	
	LYNNE H. BROWNE	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of

- (a) Patent owner's communication(s) filed: 02 September 2010.
- (b) Patent owner's late response filed: _____.
- (c) Patent owner's failure to file an appropriate response to the Office action mailed: _____.
- (d) Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
- (e) Other: _____.

Status of *Ex Parte* Reexamination:

- (f) Change in the Specification: Yes No
- (g) Change in the Drawing(s): Yes No
- (h) Status of the Claim(s):

- (1) Patent claim(s) confirmed: _____.
- (2) Patent claim(s) amended (including dependent on amended claim(s)): _____.
- (3) Patent claim(s) canceled: 1-38.
- (4) Newly presented claim(s) patentable: 57, 75, 88, 115 ^{through} and 136.
- (5) Newly presented canceled claims: 39-56, 58-74, 76-87 and 89-114.
- (6) Patent claim(s) previously currently disclaimed: _____.
- (7) Patent claim(s) not subject to reexamination: _____.

2. Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."

3. Note attached NOTICE OF REFERENCES CITED (PTO-892).

4. Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).

5. The drawing correction request filed on _____ is: approved disapproved.

6. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).

- a) All b) Some* c) None of the certified copies have
- been received.
- not been received.
- been filed in Application No. _____.
- been filed in reexamination Control No. _____.
- been received by the International Bureau in PCT Application No. _____.

* Certified copies not received: _____.

7. Note attached Examiner's Amendment.

8. Note attached Interview Summary (PTO-474).

9. Other: _____.

/Lynne H Browne/
Lynne H. Browne
Art Unit 3992

cc: Requester (if third party requester)

U.S. Patent and Trademark Office
PTOL-469 (Rev. 05-10)

Notice of Intent to Issue Ex Parte Reexamination Certificate

Part of Paper No 20100922

787
ESK

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Application Number	11/605,488-Conf. #5227
		Filing Date	November 29, 2006
		First Named Inventor	Ralph M. Hungerpiller
		Art Unit	3628
		Examiner Name	I. N. Borissov
Sheet	1	of	1
		Attorney Docket Number	031073.00001-US03


U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ²	(if known)			

FOREIGN PATENT DOCUMENTS							
Examiner Initials*	Cite No. ¹	Foreign Patent Document		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	†
		Country Code ²	Number-Kind Code ³ (if known)				

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS					
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, page(s), volume-issue number(s), publisher, city and/or country where published.			†
		ESK	AA	United States Postal Service, Volumes, Characteristics, and Costs of Processing Undeliverable-As-Addressed Mail (September 10, 1999).	

Examiner Signature	<i>E. N. Borissov for Lynne Broune</i>	Date Considered	24 SEP 2010
-----------------------	--	--------------------	-------------

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. * CITE NO.: Those application(s) which are marked with an asterisk (*) next to the Cite No. are not supplied (under 37 CFR 1.98(a)(2)(ii)) because that application was filed after June 30, 2003 or is available in the IFW. ** CITE NO.: Those document(s) which are marked with a double asterisk (**) next to the Cite No. are not supplied because they were previously cited by or submitted to the Office in a prior application relied upon in this application for an earlier filing date under 35 U.S.C. 120. † Applicant's unique citation designation number (optional). ‡ See Kind Codes of USPTO Patent Documents at www.uspto.gov or MPEP 801.04. § Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ¶ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. †† Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ††† Applicant is to place a check mark here if English language Translation is attached.

Reexamination 	Application/Control No. 90/008,470	Applicant(s)/Patent Under Reexamination 6826548
	Certificate Date	Certificate Number C1

Requester	Correspondence Address:	<input type="checkbox"/> Patent Owner	<input checked="" type="checkbox"/> Third Party
<p>Knobbe, Martens, Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614</p>			

LITIGATION REVIEW <input checked="" type="checkbox"/>	/LHB/ (examiner initials)	9/23/10 (date)
Case Name		Director Initials
Dantom Systems, Inc. v. Return Mail, Inc. 2:05 CV 70956 U.S. District Court for the Eastern Dist. of Michigan (closed)		<i>P. Hessel for GM</i>

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
1. none reissue application	11/605,488
2.	
3.	
4.	



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
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 Alexandria, Virginia 22313-1450
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BIB DATA SHEET

CONFIRMATION NO. 2122

SERIAL NUMBER 90/008,470	FILING or 371(c) DATE 01/31/2007 RULE	CLASS 705	GROUP ART UNIT 3992	ATTORNEY DOCKET NO. 031073.00001-US04		
APPLICANTS 6826548, Birmingham, AL; Return Mail Inc(Owner), Birmingham, AL; Knobbe Martens Olson & Bear LLP(3rd pty req), Irvine, CA; Knobbe Martens Olson & Bear LLP, Irvine, CA;						
** CONTINUING DATA ***** This application is a REX of 10/057,608 01/24/2002 PAT 6,826,548 which claims benefit of 60/263,788 01/24/2001						
** FOREIGN APPLICATIONS *****						
** IF REQUIRED, FOREIGN FILING LICENSE GRANTED **						
Foreign Priority claimed <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	35 USC 119(a-d) conditions met <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	<input type="checkbox"/> Met after Allowance	STATE OR COUNTRY AL	SHEETS DRAWINGS 38	TOTAL CLAIMS 4	INDEPENDENT CLAIMS 4
Verified and Acknowledged	/LYNNE HAMBLETON BROWNE/ Examiner's Signature	Initials				
ADDRESS COVINGTON & BURLING, LLP ATTN: PATENT DOCKETING 1201 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004-2401 UNITED STATES						
TITLE SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL						
FILING FEE RECEIVED 2520	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:		<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees (Filing) <input type="checkbox"/> 1.17 Fees (Processing Ext. of time) <input type="checkbox"/> 1.18 Fees (Issue) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit			



US006826548C1

(12) **EX PARTE REEXAMINATION CERTIFICATE** (7964th)
United States Patent
Hungerpiller et al.

(10) **Number:** **US 6,826,548 C1**
(45) **Certificate Issued:** **Jan. 4, 2011**

(54) **SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL**

(75) **Inventors:** **Ralph Mitchell Hungerpiller**, Birmingham, AL (US); **Ronald C. Cagle**, Birmingham, AL (US)

(73) **Assignee:** **Return Mail, Inc.**, Birmingham, AL (US)

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5,422,821 A *	6/1995	Allen et al.	700/219
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(Continued)

Reexamination Request:

No. 90/008,470, Jan. 31, 2007

Reexamination Certificate for:

Patent No.: **6,826,548**
Issued: **Nov. 30, 2004**
Appl. No.: **10/057,608**
Filed: **Jan. 24, 2002**

FOREIGN PATENT DOCUMENTS

EP	0 673 686 A1	9/1995
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JP	7-171505 A	7/1995
JP	2000-334389 A	12/2000
KR	2001-0064264	7/2001
WO	WO 00/10113 A1	2/2000

OTHER PUBLICATIONS

Postal Addressing Standards—Publication 28, Nov. 2000, pp. 129.*

(Continued)

Related U.S. Application Data

(60) Provisional application No. 60/263,788, filed on Feb. 24, 2001.

(51) **Int. Cl.**
B07C 3/00 (2006.01)
B07C 3/18 (2006.01)
G06Q 10/00 (2006.01)

(52) **U.S. Cl.** **705/401; 382/101**

(58) **Field of Classification Search** **None**
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

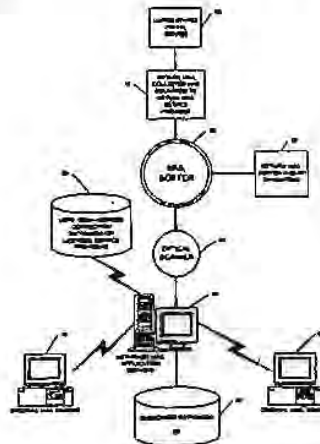
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(57) **ABSTRACT**

A method, system and program product for processing returned mail includes the steps of encoding pieces of mail with data including the identity of the intended recipient, mailing the pieces of mail to the intended recipients, collecting at a processing location those pieces of mail that are returned as undeliverable, scanning the data from the returned pieces of mail, electronically updating at least address information for the intended recipients of the returned mail, and electronically transmitting the updated address and other information to a subscriber for updating the subscriber's database of recipient addresses.

At the time of issuance and publication of this certificate, the patent remains subject to pending reissue application number 11/605,488 filed Nov. 29, 2006. The claim content of the patent may be subsequently revised in the reissue processing.



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1
EX PARTE
REEXAMINATION CERTIFICATE
ISSUED UNDER 35 U.S.C. 307

THE PATENT IS HEREBY AMENDED AS
INDICATED BELOW.

Matter enclosed in heavy brackets [] appeared in the patent, but has been deleted and is no longer a part of the patent; matter printed in italics indicates additions made to the patent.

AS A RESULT OF REEXAMINATION, IT HAS BEEN DETERMINED THAT:

Claims 1-38 are cancelled.

New claims 39-63 are added and determined to be patentable.

39 A method for processing returned mail items sent by a sender to an intended recipient, the method comprising:

decoding, subsequent to mailing of the returned mail items, information indicating whether the sender wants a corrected address to be provided for the intended recipient, on at least one of the returned mail items;

obtaining an updated address of the intended recipient subsequent to determining that the sender wants a corrected address to be provided for the intended recipient; and

electronically transmitting an updated address of the intended recipient to a transferee, wherein the transferee is a return mail service provider.

40. A computer program product residing on a computer readable medium comprising instructions for causing a computer to:

store decoded information indicating whether a sender wants a corrected address to be provided and a customer number, each associated with at least one of a plurality of mail items returned subsequent to mailing as being undeliverable;

determining from the decoded data that the customer wants a corrected address to be provided for at least one of the plurality of undeliverable mail items;

receive an updated address of an intended recipient for at least one of the plurality of undeliverable mail items, subsequent to and based upon the determining step; and

transmit the updated address to a transferee, wherein the transferee is a return mail service provider.

41. A system for processing a plurality of undeliverable mail items comprising:

a first detector, wherein the first detector detects, subsequent to mailing the undeliverable mail items, encoded information on at least one of the plurality of undeliverable mail items indicating whether a sender wants a corrected address to be provided for at least one of the undeliverable mail items; and

a processor that uses a computer program comprising instructions that cause the system to: i) decode the information indicating whether the sender wants a corrected address to be provided; ii) encode and decode intended recipient identification information; and iii) enable an updated address of an intended recipient to be sent to a transferee, wherein the transferee is a return mail service provider.

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42. A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating output data that includes a customer number of the sender and at least a portion of the decoded data;

determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

43. The method of claim 42, further comprising transmitting the name and address of the intended recipients to a mailing address service provider, subsequent to the determining step, in order to obtain an updated address for each intended recipient of an undeliverable mail item.

44. The method of claim 42, wherein the encoded data further indicates a name and address of the intended recipient.

45. The method of claim 42, wherein the plurality of mail items further include a written return address that is not that address of the sender.

46. A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating output data that includes a customer number of the sender and at least a portion of the decoded data;

determining, based on the decoding step, if the sender wants a corrected address provided for intended recipients;

if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files, including a name change and a job change of intended recipients; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

47. The method of claim 46, further comprising transmitting the name and address of the intended recipients to a mailing address service provider, subsequent to the determining step, in order to obtain an updated address for each intended recipient of an undeliverable mail item.

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48. The method of claim 46, wherein the encoded data further indicates a name and address of the intended recipient.

49. The method of claim 46, wherein the plurality of mail items further include a written return address that is not that address of the sender.

50. A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating first output data that includes a customer number of the sender and at least a portion of the decoded data; sorting the first output data by customer number, after creating the first output data;

creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting step;

determining if the sender wants a corrected address provided for intended recipients;

if the sender wants a corrected address provided, electronically transferring to the sender information for the identified intended recipients that enable the sender to update the sender's mailing address files, including a name change and a job change of intended recipients; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

51. The method of claim 50, wherein the encoded data further indicates a name and address of the intended recipient.

52. The method of claim 50, wherein the plurality of mail items further include a written return address that is not that address of the sender.

53. The method of claim 50, further comprising transmitting the name and address of the intended recipients to a mailing address service provider in order to obtain an updated address for each intended recipient of an undeliverable mail item.

54. A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating first output data that includes a customer number of the sender and at least a portion of the decoded data; sorting the content of the first output data by customer number;

creating second output data that includes a customer number and the name and address of the intended

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recipients associated with the customer number, after the sorting step;

determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

if the sender wants a corrected address provided, i) electronically transmitting the name and address of the intended recipient to an address correction service provider and receiving an updated address of the intended recipient from the address correction service provider;

ii) electronically transferring to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified recipients that enable the sender to update the sender's mailing address files; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

55. The method of claim 54, wherein the encoded data further indicates a name and address of the intended recipient.

56. The method of claim 54, wherein the plurality of mail items further include a written return address that is not that address of the sender.

57. A method for processing a plurality of undeliverable mail items, comprising:

receiving from a sender a plurality of mail items, each including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

identifying, as undeliverable mail items, mail items of the plurality of mail items that are returned subsequent to mailing as undeliverable;

decoding the encoded data incorporated in at least one of the undeliverable mail items;

creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient;

sorting the content of the first output data by customer number;

creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting step;

determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

if the sender wants a corrected address provided, i) electronically transmitting the name and address of the intended recipient to an address correction service provider and receiving an updated address of the intended recipient from the address correction service provider; and ii) electronically transferring to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

if the sender does not want a corrected address provided, posting return mail data records on a network that is accessible to the sender to enable the sender to access the records.

58. The method of claim 57, wherein the encoded data further indicates a name and address of the intended recipient.

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59. The method of claim 57, wherein the plurality of mail items further include a written return address that is not that address of the sender.

60. A system for processing a plurality of undeliverable mail items, comprising:

a letter transport for receiving from a sender a plurality of undeliverable mail items that are returned subsequent to mailing as being undeliverable, each undeliverable mail item including i) a written addressee, and ii) encoded data indicating whether the sender wants a corrected address to be provided for the addressee;

a camera for decoding the encoded data incorporated in at least one of the undeliverable mail items; and

a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient, iii) sorting the content of the first output data by customer number, after creating the first output data; ii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

wherein the computer, upon determining that the sender wants a corrected address provided, i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider; and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

61. The method of claim 60, wherein the encoded data further indicates a name and address of the intended recipient.

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62. The method of claim 60, wherein the plurality of mail items further include a written return address that is not that address of the sender.

63. A system for processing a plurality of undeliverable mail items, comprising:

a hand-held barcode optical scanner for decoding encoded data on undeliverable mail items that are returned subsequent to mailing as being undeliverable, the encoded data indicating whether a sender wants a corrected address to be provided for the addressee incorporated, wherein each undeliverable mail item also includes a written addressee; and

a computer for i) creating first output data that includes a customer number of the sender and at least a portion of the decoded data including the name and address of the intended recipient; ii) sorting the content of the first output data by customer number, after creating the first output data; iii) creating second output data for a customer number that includes the name and address of the intended recipients associated with the customer number, after the sorting the content of the output file by customer number; and iv) determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

wherein the computer, upon determining that the sender wants a corrected address provided, i) electronically transmits the name and address of the intended recipient to an address correction service provider and receives an updated address of the intended recipient from the address correction service provider; and ii) electronically transfers to the sender, subsequent to receiving an updated address of the intended recipient from the address correction service provider, information for the identified intended recipients that enable the sender to update the sender's mailing address files; and

wherein the computer, upon determining that the sender does not want a corrected address provided, posts return mail data records on a network that is accessible to the sender to enable the sender to access the records.

* * * * *

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:
Ralph M. Hungerpiller et al.

Patent No.: 6,826,548 C1

Issued: January 4, 2011

For: SYSTEM AND METHOD FOR PROCESSING
RETURNED MAIL

**REQUEST FOR CERTIFICATE OF CORRECTION OF PATENT
FOR PTO MISTAKE (37 C.F.R. § 1.322(a))**

Attention: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

The assignee of record, Return Mail, Inc., through its undersigned attorney, respectfully submits this request for Certificate of Correction of patent due to PTO mistake arising during prosecution of the application for the above-referenced patent, pursuant to the provisions of 37 C.F.R. § 1.322(a). Upon reviewing the above-identified patent, Patentee noted a typographical error which should be corrected. It is respectfully submitted that correction of the identified mistake or error in the patent would not constitute new matter, nor would it require reexamination of the patent. A Certificate of Correction is therefore respectfully requested.

Attached hereto is a form PTO/SB/44 (form PTO/1050), setting forth the error or mistake sought to be corrected with the present request for Certificate of Correction.

The exact page and line number where the error is shown correctly in the application file is:

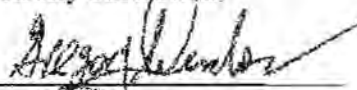
- The error that appears on the *Ex Parte* Reexamination Certificate Title page for U.S. Patent No. 6,826,548 C1, Item (60), under Related U.S. Application Data, is that Provisional application no. 60/263,788 was filed on Feb. 24, 2001. As stated in Para. [0001] of application serial 10/057,608, filed on January 24, 2002, Provisional application no. 60/263,788 was in fact filed on January 24, 2001. In addition, Item (60), under Related U.S. Application Data of U.S. Patent No. 6,826,548 B2 indicates that Provisional application no. 60/263,788 was filed on Jan. 24, 2001. Column 1, lines 6-11 of U.S. Patent No. 6,826,548 B2 also indicate that Provisional application no. 60/263,788 was filed on Jan. 24, 2001.

Since the error sought to be corrected in the patent under the present request for Certificate of Correction is believed to be caused by a mistake on the part of the PTO, it is respectfully submitted that no fee is required for this Certificate of Correction under 37 C.F.R. § 1.322. In the event that any fees are required, however, the Commissioner is authorized to charge any fee deficiency, or credit any overpayment of fees, to Deposit Account No. 50-0740.

Transmitted herewith is a proposed Certificate of Correction effecting such amendment. Patentee respectfully solicits the granting of the requested Certificate of Correction.

Dated: March 8, 2012

Respectfully submitted,

By 
Gregory S. Discher
Registration No.: 42,488
COVINGTON & BURLING LLP
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401
(202) 662-6000
Attorneys for Applicant

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**Page 1 of 1

PATENT NO. : 6,826,548 C1
APPLICATION NO. : 90/008,470
ISSUE DATE : January 4, 2011
INVENTOR(S) : Ralph M. Hungerpiller et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Ex Parte Reexamination Certificate Title page, Item (60), under Related U.S. Application Data, delete "Feb." and insert "--Jan.--" therefor.

MAILING ADDRESS OF SENDER (Please do not use customer number below):

COVINGTON & BURLING LLP

1

Attn: Patent Department

1201 Pennsylvania Avenue, N.W.

Washington, DC 20004-2401

Electronic Acknowledgement Receipt

EFS ID:	12256764
Application Number:	90008470
International Application Number:	
Confirmation Number:	2122
Title of Invention:	SYSTEM AND METHOD FOR PROCESSING RETURNED MAIL
First Named Inventor/Applicant Name:	6826548
Customer Number:	26853
Filer:	Andrea Reister/Jenn Augsburg
Filer Authorized By:	Andrea Reister
Attorney Docket Number:	031073.00001-US04
Receipt Date:	08-MAR-2012
Filing Date:	31-JAN-2007
Time Stamp:	14:31:51
Application Type:	Reexam (Third Party)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		6826548_ReqCertCorrection. PDF	967921 <small>14ae2831a3bd1fb6dd014a159458f84b397197a</small>	yes	5

Multipart Description/PDF files in .zip description			
Document Description	Start	End	
Transmittal Letter	1	2	
Request for Certificate of Correction	3	5	

Warnings:

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Total Files Size (in bytes):

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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ralph M. Hungerpiller et al.

Patent No.: 6,826,548 C1

Group Art Unit: 3992

Filed: January 4, 2011

Examiner: L. H. Browne

For: SYSTEM AND METHOD FOR PROCESSING
RETURNED MAIL

TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:

1. Request for Certificate of Correction Pursuant to 37 C.F.R. § 1.322;
2. Form PTO/SB/44.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0740, under Docket No. 031073.00001-US04.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such

extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740.

Dated: March 8, 2012

Respectfully submitted,

By 

Gregory S. Discher

Registration No.: 42,488
COVINGTON & BURLING LLP
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401
(202) 662-6000
Attorneys for Applicant

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

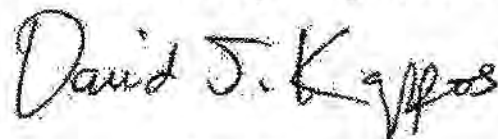
PATENT NO. : 6,826,548 C1
APPLICATION NO. : 90/008470
DATED : January 4, 2011
INVENTOR(S) : Ralph M. Hungerpiller et al.

Page 1 of 1

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Ex Parte Reexamination Certificate Title page, Item (60), under Related U.S. Application Data, delete "Feb." and insert --Jan.-- therefor.

Signed and Sealed this
Seventeenth Day of April, 2012



David J. Kappos
Director of the United States Patent and Trademark Office