

Paper No. _____
Filed: April 27, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

RETURN MAIL, INC.,

Patent Owner.

Case: CBM2014-00116

Patent: 6,826,548

**Petitioner's Reply to RMI's Opposition
to Petitioner's Motion to Exclude**

TABLE OF CONTENTS

I. USPS’s Motion to Exclude Should Be Granted 1

 A. Exhibits 2013 – 21st Century Dictionary of Computer Terms (1994)..... 1

 B. Exhibit 2015 – Declaration of Scott M. Nettles 1

 C. Exhibits 2016 - 2020 and Exhibit 2031 – Improper Reliance on USPS’s Systems 2

 D. Exhibits 2021 - 2029 – Patents Filed After the Priority Date of the ’548 Patent 3

 E. Exhibit 2030 – PARS Excellence – New Processing System Development Complete..... 3

 F. Exhibit 2032 – File History of U.S. Patent No. 8,195,575 (“the ’575 patent”) 4

 G. Exhibit 2035 - Exhibit 2052..... 5

II. Conclusion 5

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Fidelity National Information Services, Inc. v. Checkfree Corp.</i> CBM2013-00031, 2014 WL 7330475 (PTAB Dec. 22, 2014)	1, 2
<i>Interthinx, Inc. v. Corelogic Solutions, LLC</i> , CBM2012-00007, 2014 WL 587149 (PTAB Jan. 30, 2014) (Paper 54).....	1
<i>SAP America, Inc. v. Versata Development Group, Inc.</i> , CBM2012-00001, 2013 WL 3167735 (PTAB June 11, 2013)	1
Statutes	
35 U.S.C. § 101.....	4
Other Authorities	
37 C.F.R. § 42.24	5
37 C.F.R. § 42.65	1
Fed. R. Evid. 401	2
Fed. R. Evid. 403	1, 4
Fed. R. Evid. 704.....	1

I. USPS's Motion to Exclude Should Be Granted

At each turn, RMI has failed to effectively show why its Exhibits should not be excluded. As explained herein, these Exhibits should be excluded as failing to comport with the rules of evidence.

A. Exhibits 2013 – 21st Century Dictionary of Computer Terms (1994)

In its Opposition (Paper 33 “Opp.”), RMI provides no arguments how the term “decoder” is relevant to this proceeding. *Id.* at 2. The term “decoder” is not found in any of the claims nor the specification. RMI does not explain how the term would assist the Board in this proceeding. Therefore, the Board should exclude Ex. 2013 because it is not relevant.

B. Exhibit 2015 – Declaration of Scott M. Nettles

Dr. Nettles opines not based on his scientific or technical knowledge, but rather on issues that are ultimately determinations of law including issues of patent law and/or patent examination practice in contravention of 37 C.F.R. § 42.65 (FRE 403 and 704). RMI arguments rest on decisions where the Board considered expert testimony related to what technology was available at the time, field of use, concepts recited in the claims, and whether the claims-at-issue were mere routine, conventional steps or meaningful limitations¹. Opp. at 5 (citing *SAP America, Inc. v. Versata Development Group, Inc.*, CBM2012-00001; *Interthinx, Inc. v. Corelogic Solutions, LLC*, CBM2012-00007; *Fidelity National Information Services, Inc. v. Checkfree Corp.*, CBM2013-

00031). But, Dr. Nettles opinions in paragraphs 37-95 do not relate to his scientific or technical knowledge. Thus, the Board should exclude paragraphs 37-95.

C. Exhibits 2016 - 2020 and Exhibit 2031 – Improper Reliance on USPS's Systems

RMI argues that Exs. 2016-2020 and 2031 were used to “described the state of the technology for return mail processing before the ’548 patent. However, the earliest issue date of the patents cited by RMI in Exhibits 2016–2020 and 2031 is March 8, 2011, which is after the relevant time frame of 2001 (or 2002, the appropriate date if priority date not accorded). RMI provides no support that Ex. 2016, nor Exs. 2017-2020 and 2031, “describe[s] the state of the technology for return mail processing before the ’548 patent.” *Id.* In the Patent Owner Response, RMI incorrectly offers Ex. 2021 to prove the truth of a matter asserted, and does not have a non-hearsay purpose. POR at 61. Ex. 2021, for example, does not make “certain facts more or less probable than they would be without this evidence.” Fed. R. Evid. 401. Nothing in Ex. 2021 contradicts that the CFS units in 1997 had scanners for scanning the mail piece. Therefore, because the probative value of Exhibits 2021-2029 and 2031 is substantially outweighed by a danger of confusing the issue and wasting time addressing systems not relevant to the current proceeding, these exhibits should be excluded.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.