# Petitioner's Demonstratives

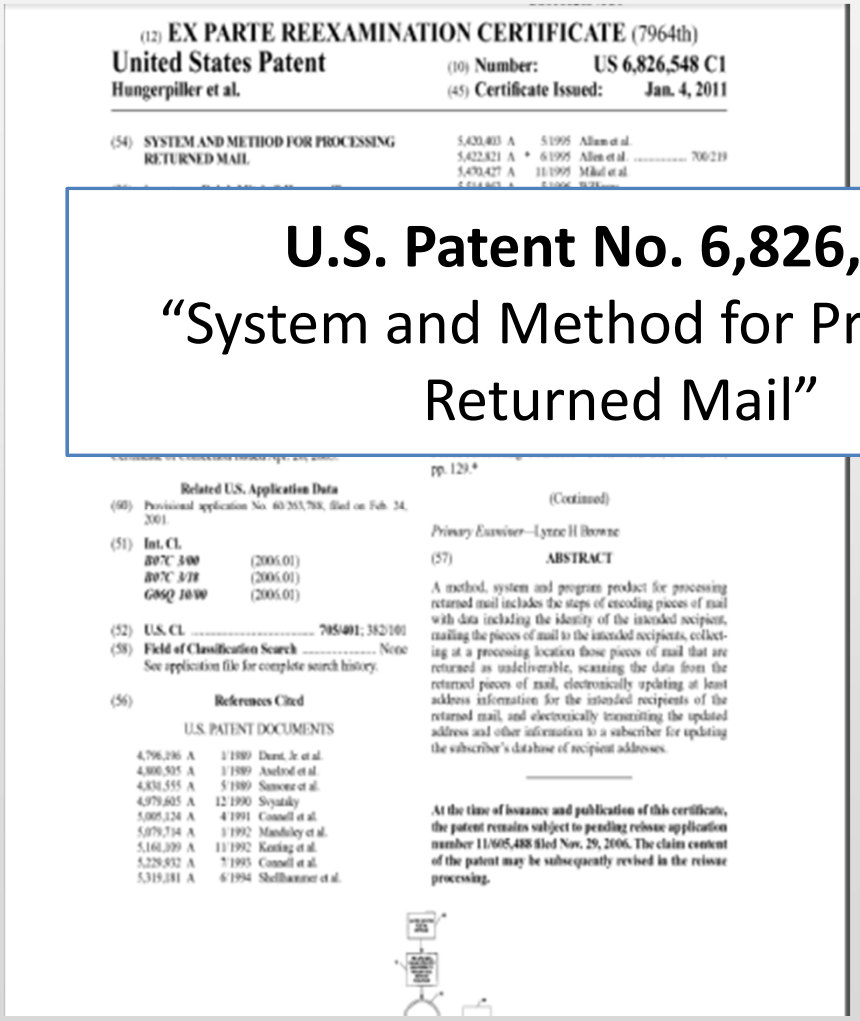
**The United States Postal Service (USPS)**
**And The United States of America,**
**As Represented By The Postmaster General**
**v.**
**Return Mail, Inc. (RMI)**

**PTAB Hearing for**
**CBM2014-00116**

**May 12, 2015**

**USPS EXHIBIT 1029**
**USPS v. RMI**
**CBM2014-00116**

# Patent Owner's Business Method Patent



(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**

**U.S. Patent No. 6,826,548**
"System and Method for Processing Returned Mail"

(52) **U.S. Cl.** ..... **705/401**; 382/101

USPTO identified CBM patents by class 705

# Instituted Grounds of Unpatentability

## All Challenged Claims:

- ✓ Claims 39-44 Unpatentable Subject Matter Under 35 U.S.C. § 101
- ✓ Claims 39-44 Anticipated by *1997 ACS* Under 35 U.S.C. §102

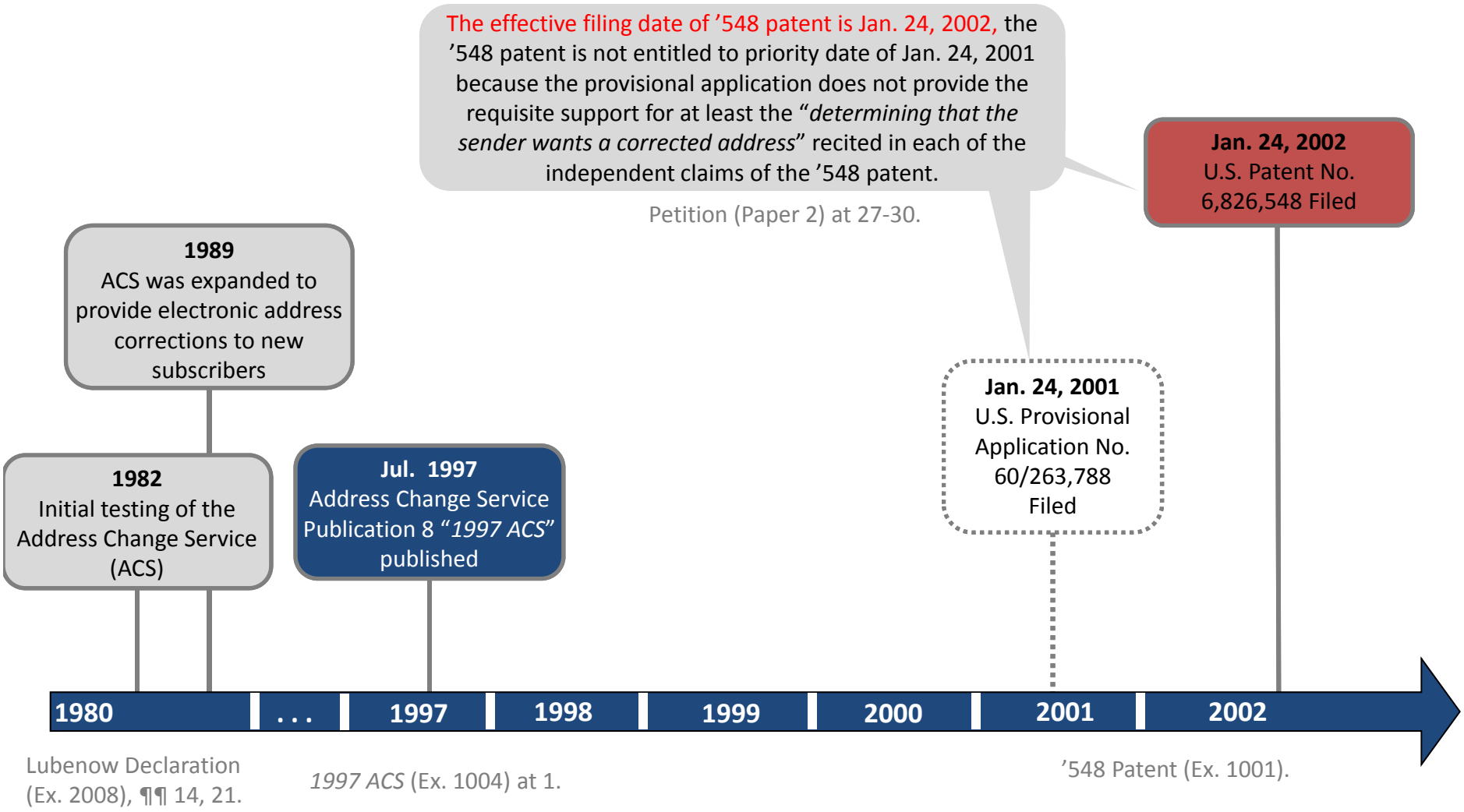

UNITED STATES POSTAL SERVICE

Address Change Service

Page 1 of 34 USPS EXHIBIT 1004

Institution Decision (Paper 11) at 35.

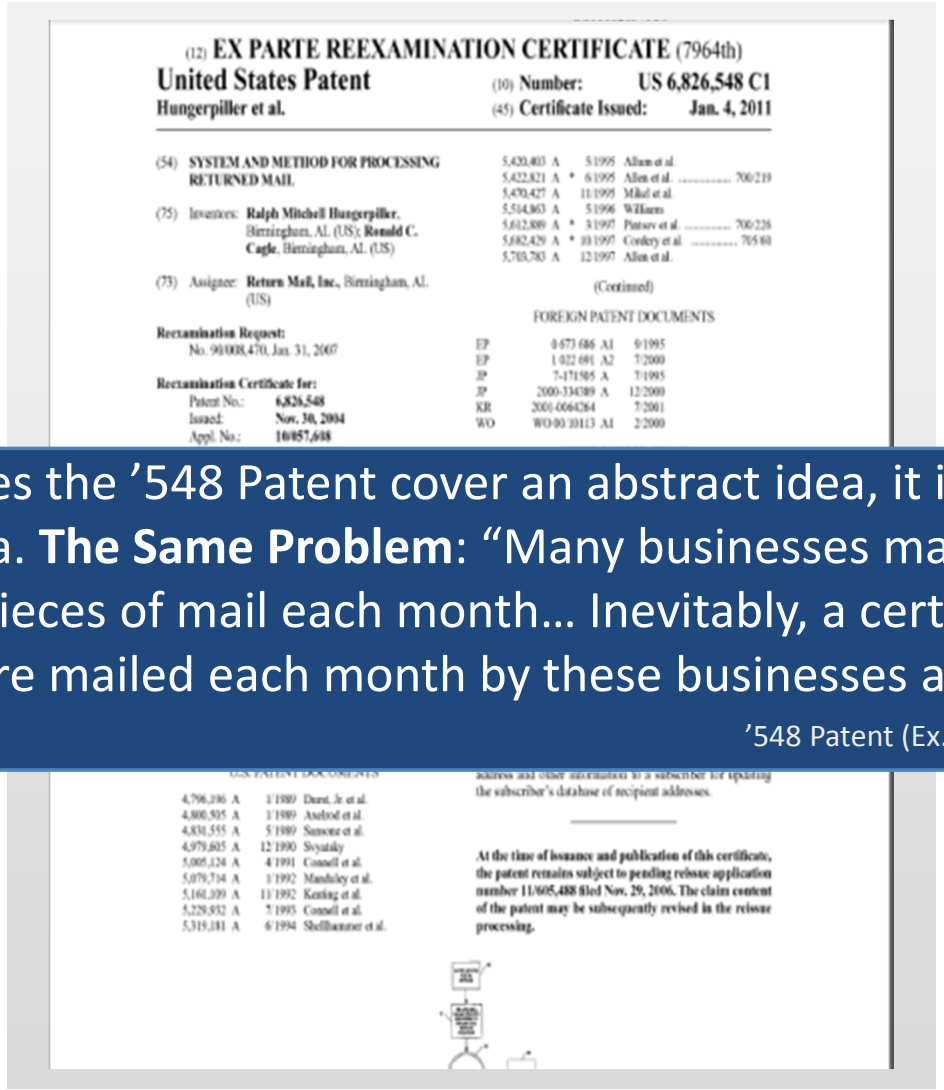
# Timeline


The effective filing date of '548 patent is Jan. 24, 2002, the '548 patent is not entitled to priority date of Jan. 24, 2001 because the provisional application does not provide the requisite support for at least the "*determining that the sender wants a corrected address*" recited in each of the independent claims of the '548 patent.
Petition (Paper 2) at 27-30.
**Jan. 24, 2002**
U.S. Patent No. 6,826,548 Filed
**1989**
ACS was expanded to provide electronic address corrections to new subscribers
**Jan. 24, 2001**
U.S. Provisional Application No. 60/263,788 Filed
**1982**
Initial testing of the Address Change Service (ACS)
**Jul. 1997**
Address Change Service Publication 8 "*1997 ACS*" published
1980
. . .
1997
1998
1999
2000
2001
2002
Lubenow Declaration (Ex. 2008), ¶¶ 14, 21.
*1997 ACS* (Ex. 1004) at 1.
'548 Patent (Ex. 1001).

# The ’548 Patent
# System and Method for Processing Returned Mail

Unpatentable Under § 101

# The ’548 Patent Covers an Old Abstract Idea



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(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)

**Reexamination Request:**
No. 90/008,470, Jan. 31, 2007

**Reexamination Certificate for:**
Patent No.: **6,826,548**
Issued: **Nov. 30, 2004**
Appl. No.: **10/057,618**

5,420,403 A 5/1995 Allum et al.
5,422,821 A * 6/1995 Allen et al. ..... 700/219
5,450,427 A 11/1995 Mikel et al.
5,514,863 A 5/1996 Williams
5,612,889 A * 3/1997 Pintsov et al. ..... 700/226
5,682,425 A * 10/1997 Cordery et al. ..... 705/60
5,703,783 A 12/1997 Allen et al.

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4,800,505 A 1/1989 Axelrod et al.
4,831,555 A 5/1989 Sansone et al.
4,979,605 A 12/1990 Svyatsky
5,005,124 A 4/1991 Connell et al.
5,079,714 A 1/1992 Manduley et al.
5,161,109 A 11/1992 Keating et al.
5,229,932 A 7/1993 Connell et al.
5,315,181 A 6/1994 Shellhammer et al.

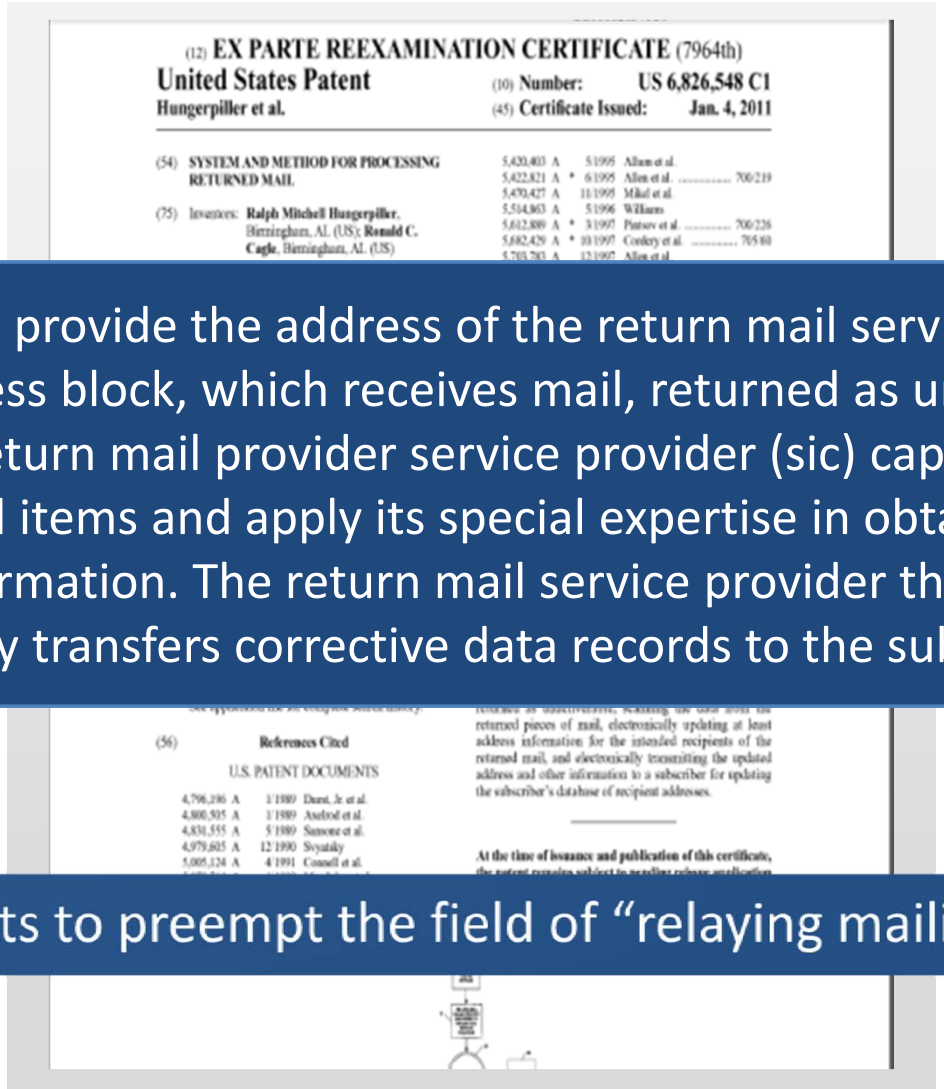
address and other information to a subscriber for updating the subscriber's database of recipient addresses.

**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.**

Not only does the ’548 Patent cover an abstract idea, it is not even a new abstract idea. **The Same Problem**: “Many businesses mail thousands or even millions of pieces of mail each month… Inevitably, a certain percentage of the items that are mailed each month by these businesses are returned to the sender.”

’548 Patent (Ex. 1001), 1:25-46 (emphases added).

# The ’548 Patent Covers an Old Abstract Idea



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5,514,863 A 5/1996 Williams
5,612,889 A * 3/1997 Pintsov et al. ..... 700/226
5,682,425 A * 10/1997 Cordery et al. ..... 705/60
5,703,783 A 12/1997 Allen et al.

(56) **References Cited**

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4,796,196 A 1/1989 Durst, Jr. et al.
4,800,505 A 1/1989 Axelrod et al.
4,831,555 A 5/1989 Sansone et al.
4,979,605 A 12/1990 Svyatsky
5,005,124 A 4/1991 Connell et al.

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,**

“Subscribers provide the address of the return mail service provider in the return address block, which receives mail, returned as undeliverable by the USPS. The return mail provider service provider (sic) captures the data from the returned items and apply its special expertise in obtaining corrected address information. The return mail service provider then electronically transfers corrective data records to the subscriber.”

’548 Patent (Ex. 1001), 2:8-13.

RMI attempts to preempt the field of “relaying mailing address data.”

# The Background of the ’548 Patent Discloses the Claims

“It is not uncommon for such high volume users to retain a staff of several employees whose job it is to[:]

- receive the returned mail,
- manually research the reasons for the unsuccessful delivery, obtain, where possible, the correct addressing information for the intended [] recipient, and
- oversee a second mailing to the corrected address.” ’548 Patent (Ex. 1001), 1:41-47.

39. A method for processing returned mail items sent by a sender to an intended recipient, the method comprising:

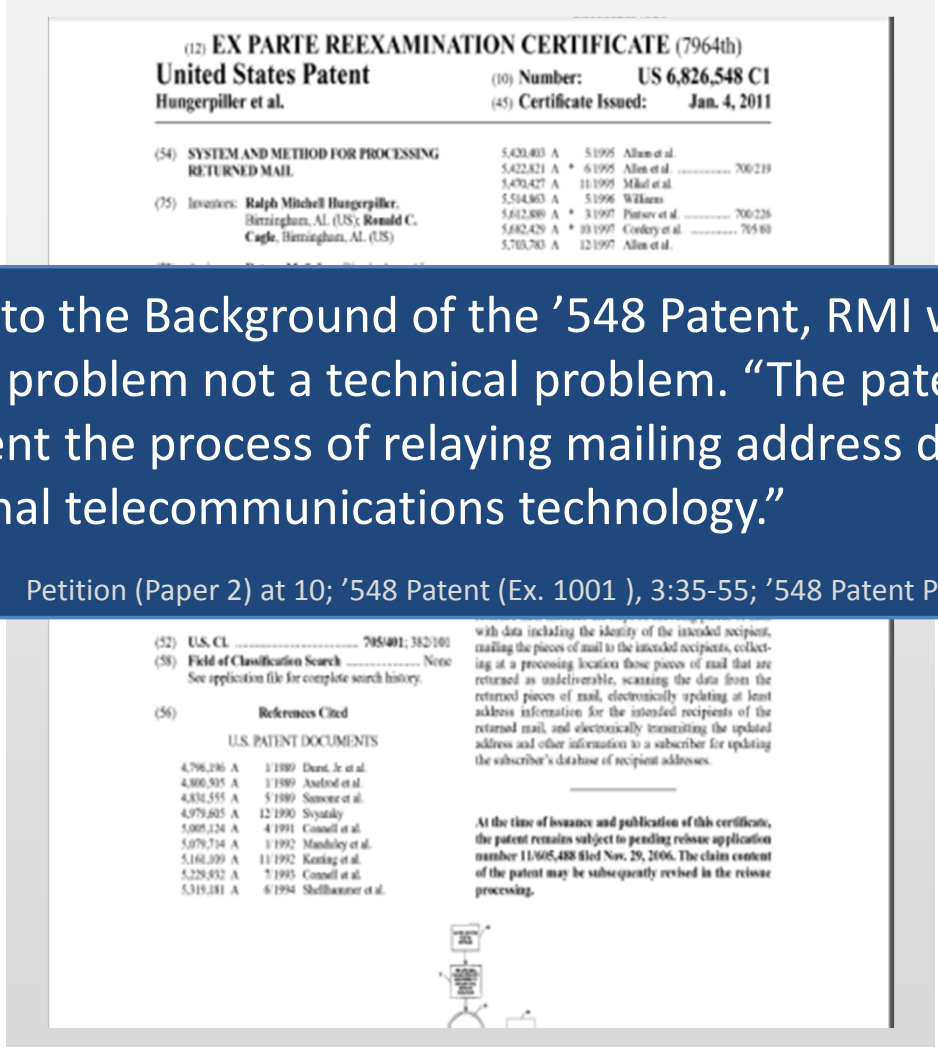
decoding, subsequent to mailing of the returned mail items, information indicating whether the sender wants a corrected address to be provided for the intended recipient, on at least one of the returned mail items;

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.

The ’548 Patent discloses that encoding and decoding (e.g. barcode reading) were old and well-known at the time the application. ’548 Patent (Ex. 1001), 3:11–15.

# The ’548 Patent Solves a Financial Problem Not a Technical One



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| 5,703,783 | A | 12/1997 | Allen et al. | |

(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

| | | | |
|---|---|---|---|
| 4,796,196 | A | 1/1989 | Durst, Jr. et al. |
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| 4,831,555 | A | 5/1989 | Simone et al. |
| 4,979,605 | A | 12/1990 | Svyatsky |
| 5,005,124 | A | 4/1991 | Connell et al. |
| 5,079,734 | A | 1/1992 | Mandsley et al. |
| 5,161,109 | A | 11/1992 | Keeling et al. |
| 5,229,832 | A | 7/1993 | Connell et al. |
| 5,319,181 | A | 6/1994 | Shellhammer et al. |

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.**



According to the Background of the ’548 Patent, RMI was attempting to solve a financial problem not a technical problem. “The patent merely makes more cost efficient the process of relaying mailing address data by using conventional telecommunications technology.”

Petition (Paper 2) at 10; ’548 Patent (Ex. 1001 ), 3:35-55; ’548 Patent Prosecution History (Ex. 1015) at 250.

# The Solution Already Existed Decades Before RMI

The Postal Service was already addressing the problem identified in the '548 Patent, filed Jan. 24, 2002, long before RMI tried to preempt the field of relaying mailing address data.

Dr. Joe Lubenow

- The USPS as early as 1982 began initial testing of the Address Change Service (ACS) system to provide electronic transmission of address correction notification to mailers.
- In 1986 National Change of Address (NCOA) venders obtained update addresses, "matching" subscriber's existing mailing list with change-of-address information entered at CFS sites.
- In 1989, ACS was expanded to provide electronic address corrections to mailers for mailpieces that were undeliverable for reasons other than a customer move.

Dr. Lubenow Declaration (Ex. 1008) at ¶¶ 14, 20, & 21 (emphases added).

# RMI Agrees The ’548 Patent is Abstract

Certainly USPS believes the ’548 Patent covers the abstract idea of relaying mailing address data but hear RMI’s words:

## RMI’s Own Words

- “[T]his case involves *changing and processing data* in a way that improves the overall *processing of returned mail*.”

RMI Response (Paper 21) at 34 (emphases added).

- The claimed features merely “eliminates the very labor intensive task of manually updating individual mailing address records.”

’548 Patent Prosecution History (Ex. 1015) at 250.

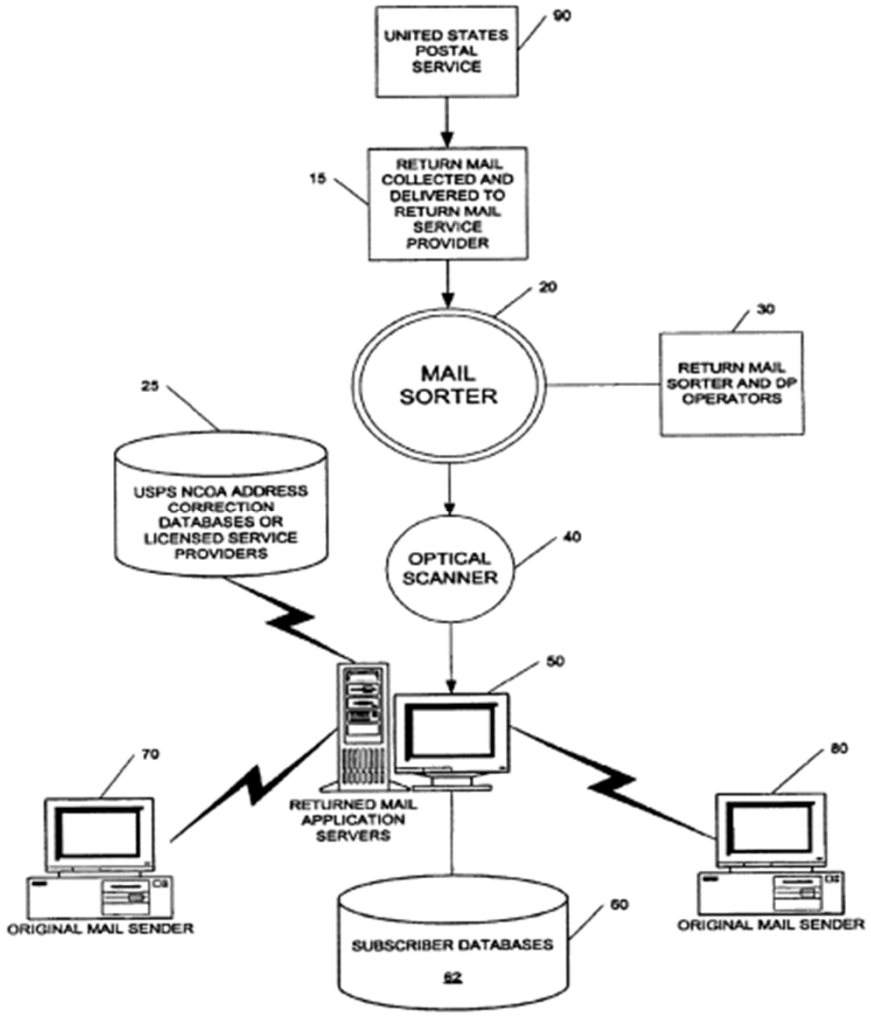
- “[T]he ’548 patent uses a combination of known machines…”

RMI’s Response (Paper 21) at 40.

As stated by the Board, “[t]he ’548 Patent discloses that encoding and decoding (e.g. barcode reading) were old and well-known at the time the application.”

Institution Decision (Paper 11) at 14 (citing ’548 Patent (Ex. 1001), 3:11–15).

# Claims Employ No Specific Technology

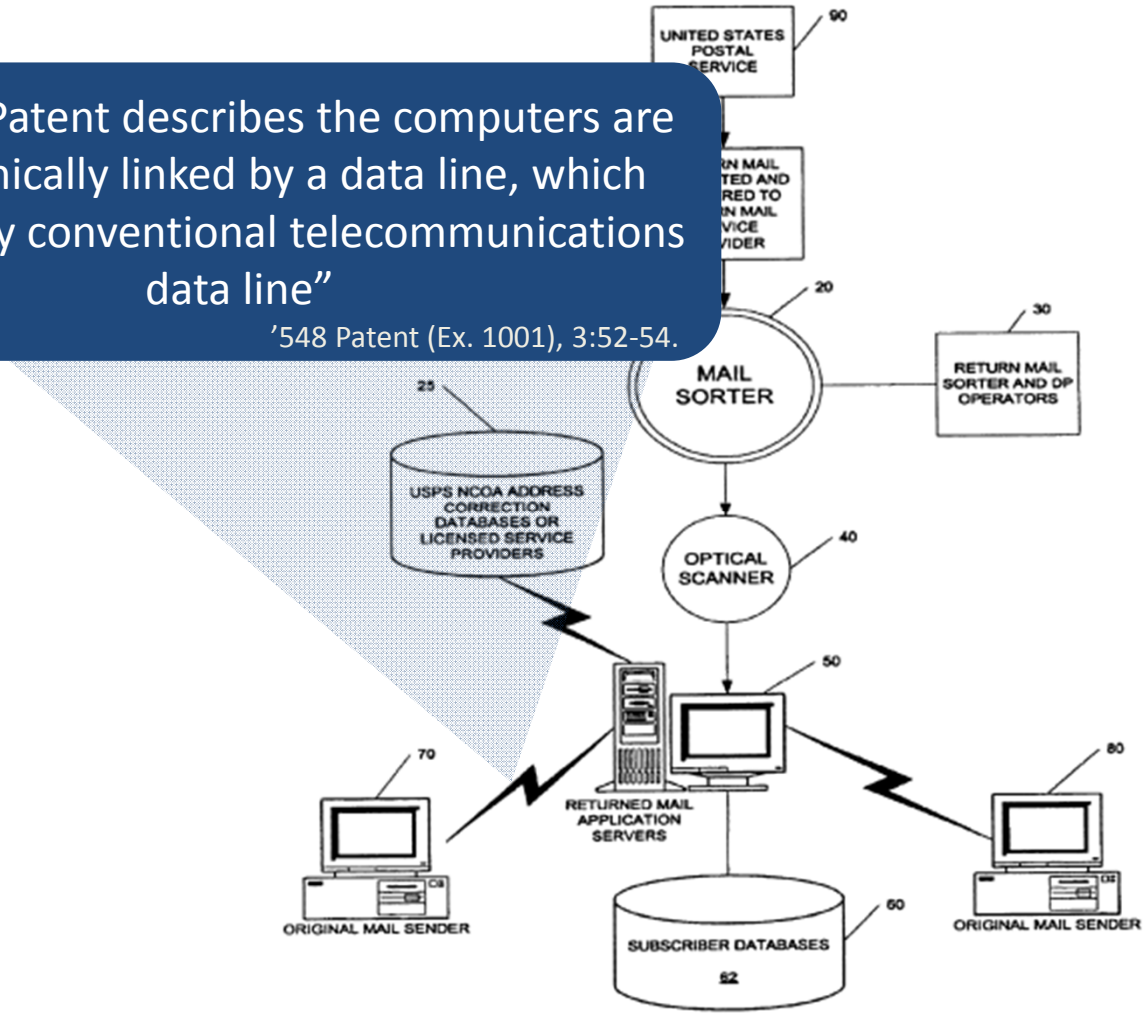



'548 Patent (Ex. 1001) Fig. 1.

# Claims Employ No Specific Technology

The ’548 Patent describes the computers are “electronically linked by a data line, which may be any conventional telecommunications data line”

’548 Patent (Ex. 1001), 3:52-54.

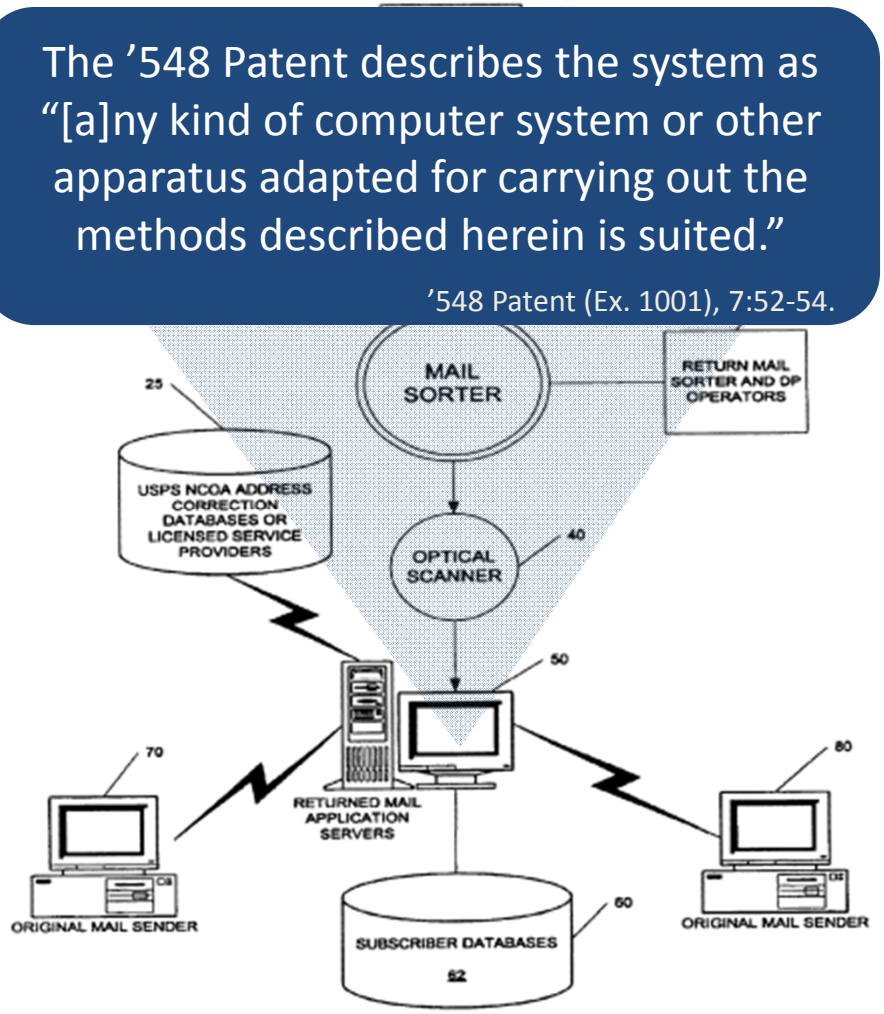



’548 Patent (Ex. 1001) Fig. 1.

# Claims Employ No Specific Technology

The ’548 Patent describes the system as “[a]ny kind of computer system or other apparatus adapted for carrying out the methods described herein is suited.”

’548 Patent (Ex. 1001), 7:52-54.

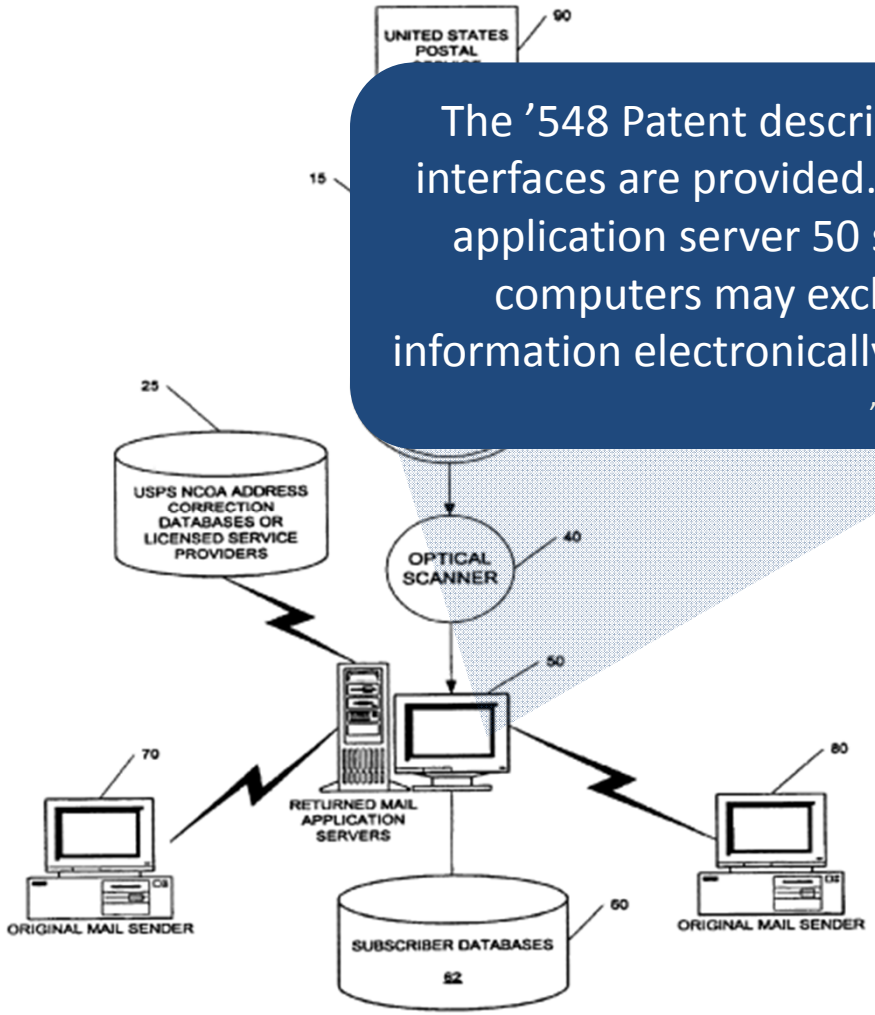



’548 Patent (Ex. 1001) Fig. 1.

# Claims Employ No Specific Technology

The ’548 Patent describes the “Software interfaces are provided… in the return mail application server 50 such that the two computers may exchange data and information electronically and automatically”

’548 Patent (Ex. 1001), 3:52-54.




’548 Patent (Ex. 1001) Fig. 1.

# Mere Generic "[Computer] Instructions" is Not Enough

RMI added generic "[computer] instructions" functionality, in an amendment dated Nov. 5, 2003, to overcome the rejection of its original (now cancelled) claims under 35 U.S.C. § 101.

25 19. (currently amended) 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

ch item of undeliverable

ect addresses;

~~scanned~~ and identified

intended recipient data in a data file;

RMI argued "[i]n view of the amendments to claim 19, the rejection of claims 19-23, 34 and 35 as directed to non-statutory subject matter is overcome."

'548 Patent Prosecution History (Ex. 1015) at 250.

# ’548 Patent – Prosecution History

The PTO originally rejected the claims under 35 U.S.C. § 101. RMI added generic “[computer] instructions” functionality to overcome the rejection, but this is no longer sufficient.

Claim 19 has been amended to recite that program instructions identify intended recipients having incorrect addresses, and program instructions transmit the updated intended recipient the sender's mailing address files is a useful and non-abstract result that enables the sender to resend items such as bills to its customers, and eliminates the very labor intensive task of manually updating individual mailing address records for its customers. In view of the amendments to claim 19, the rejection of claims 19 – 23, 34 and 35 as directed to non-statutory subject matter is overcome.

’548 Patent Prosecution History (Ex. 1015) at 250.

> “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”
>
> *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2358 (2014).

# Conventional Functionality Is Not Patent Eligible

"The Court in *Alice* made clear that a claim directed to an abstract idea does not move into section 101 eligibility territory by 'merely requir[ing] generic computer implementation.' *Alice*, 134 S. Ct. at 2357."

*buySAFE, Inc. v. Google, Inc.*, No. 2013-1575, slip op. at 7 (Fed. Cir. Sept. 3, 2014).

"The computer functionality is generic—indeed quite limited: a computer receives a request for a guarantee and transmits an offer of guarantee in return . . . . That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive."

*buySAFE, Inc. v. Google, Inc.*, No. 2013-1575, slip op. at 9 (Fed. Cir. Sept. 3, 2014).

# The Claims are Merely Automating a Manual Process

Merely automating an abstract idea is insufficient to constitute an "inventive concept."

*Alice Corp. Pty. Ltd. V. CLS Bank Int'l*, 134 S.Ct. 2347, 2359 (2014).

## RMI's Expert, Dr. Scott Nettles

- "Looking at the '548 patent, its architecture is **simple**… and is **specifically designed to support automating the address updating process**."

  Nettles Declaration (Ex. 2015) at ¶ 52 (citing Ex. 1001, 1:55-60) (emphases added).

- "**The entire purpose behind the patent is to convert a manual process to an integrated automated process**."

  Nettles Declaration (Ex. 2015) at ¶ 75 (emphases added).

- The **high-level improvement that '548 patent claims** provide is **automating the process of generating address corrections for mailers that request them**.

  Nettles Declaration (Ex. 2015) at ¶ 49 (emphases added).

# The ’548 Patent Recites Known Technology

Mere recitation of known technologies, such as **computer hardware**, **communication or computer networks**, software, memory, **computer-readable storage medium**, **scanners**, display devices or databases, or specialized machines, such as an ATM or point of sale device typically do not render a patent a “technological invention.”

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48763-64 (Aug. 14, 2012).

The ’548 Patent discloses that encoding and decoding were old and well-known at the time the application leading to the ’548 Patent was filed.

Institution Decision (Paper 11) at 14 (citing ’548 Patent (Ex. 1001), 3:11–15).

# Claim 39 Claims the Idea of Relaying Mailing Address Data

Claim 39: A method for processing returned mail:

decoding… information indicating whether the sender wants a corrected address…;

obtaining an updated address…; and

electronically transmitting an updated address ….

'548 Patent (Ex. 1002), 1:21-33 (emphases added).

"We are persuaded that the steps are directed to the abstract idea of relaying mailing address data, with the inclusion of an electrical transmission step."

Institution Decision (Paper 11) at 21.

# Claim 40 Does Not Add "Significantly More" Than the Abstract Idea

Claim 40: 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 and a customer number…;

determining from the decoded data that the customer wants a corrected address…;

receive an updated address ….; and

transmit the updated address….

'548 Patent (Ex. 1002), 1:34-51 (emphases added).

Claim 40 adds a "computer program product for causing a computer to store" to the steps recited in claim 39 but this step is conventional, non-technological step that simply ensnare the abstract business process of relaying mailing address data.

Further RMI states, "[a]ny kind of computer system or other apparatus adapted for carrying out the methods described herein is suited."

'548 Patent (Ex. 1001), 7:7-9.

# Claim 41 Does Not Add "Significantly More" Than the Abstract Idea

Claim 41: A system for processing a plurality of undeliverable mail items comprising:

a first detector, wherein the first detector detects… encoded information … indicating whether a sender wants a corrected address…; 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 … information; and iii) enable an updated address … to be sent ….

'548 Patent (Ex. 1002), 1:52-67 (emphases added).

Claim 41 adds a "detector" and a "processor" to perform the steps recited in claim 39 but those components are "well-known, generic computing technology being asked to do their generic function without any specified constraints, and without being a part of any technological advance used to implement an abstract idea unrelated to that technology." CRS Adv. Techs, CBM2012-00005, Paper 66, at 15 (PTAB 2014).

# The Abstract Idea of Claim 39 Taints Claims 40 and 41

"[S]ystem claims that closely track method claims and are grounded by the same meaningful limitations will generally rise and fall together."

*Accenture Global Services, GmBH v. Guidewire Software, Inc.*, 728 F.3d at 1341 (Fed. Cir. Aug. 06, 2011).

"[T]he format of the various method, system, and media claims asserted [] 'd[id] not change the patent eligibility analysis under § 101.'"

*Bancorp Services, L.L.C. v. Sun Life Assurance. Co. of Canada (U.S.)*, 687 F.3d 1266, 1276-77 (citation omitted).

# Claim 42 Claims the Idea of Relaying Mailing Address Data

Claim 42: A method for processing a plurality of undeliverable mail items:

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

identifying … mail items …;

decoding the encoded data…;

creating output data…; (Created but never used)

determining if the sender wants a corrected address …;

if sender wants a corrected address…, electronically transferring to the sender…; and

if the sender does not want a corrected address… posting… records on a network…

'548 Patent (Ex. 1002), 2:1-24.

Claim 42 adds "posting" and "creating output data" steps to the steps recited in claim 39 but those steps are conventional, non-technological steps that simply ensnare the abstract business process of relaying mailing address data.

# Dependent Claims 43 and 44 Add Nothing Patent-Eligible

Dependent Claims 43 and 44 add nothing patentable to an otherwise-abstract method patent.

Claim 43: The method of claim 42, further comprising transmitting the name and address of the intended recipient 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.

Claim 44: The method of claim 42, where the plurality of mail items further indicate a name and address of the intended recipient.

'548 Patent (Ex. 1002), 2:25-32 (emphases added).

Claim 43 adds "transmitting the name and address" and Claim 44 adds where the mail item "indicates a name and address" steps to the steps recited in claim 42 but neither of these claims adds non-generic technological limitations—they ensnare the abstract business process of relaying mailing address data.

# Recognizing Data is Not Patent Eligible

"The concept of data collection, recognition, and storage is undisputedly well-known. Indeed, humans have always performed these functions."

*Content Extraction & Transmission LLC, v. Wells Fargo Bank, No.* 2013-1588, 2014 WL 7272219 at 7 (Fed. Cir. Dec. 23, 2014).

"CET attempts to distinguish its claims from those found to be abstract in *Alice* and other cases by showing that its claims require not only a computer but also an additional machine—a **scanner**. CET argues that its claims are not drawn to an abstract idea because human minds are unable to process and recognize the stream of bits output by a scanner… CET's claims are drawn to the basic concept of data recognition and storage."

*Id*. at 8 (citation omitted).

# RMI Attempts to "Narrow" Its Abstract Idea

RMI attempts to "narrow" its abstract idea to avoid patent ineligibility. These allegations are based on ideas not recited in Claims 39-44 of the '548 patent, as will be explained.

## RMI Alleges Incorrectly:

- "the piece of mail can be read directly by an optical scanner, and then processed by the application server"

  RMI Response (Paper 21) at 36.

- "the encoded information… is decoded and *transforms incorrect address information into correct address information after checking the available databases or alternatively a notification that the prior address is incorrect.*

  RMI Response (Paper 21) at 39 (emphases added).

# RMI Attempts to "Narrow" Its Abstract Idea

## RMI Alleges Incorrectly:

- "the piece of mail can be read directly by an optical scanner, and then processed by the application server"

  RMI Response (Paper 21) at 36.

- 
  - Not a single claim recites an "optical scanner" or "application server."
  - Even if the claims included these generic components, which they do not, as the Board correctly noted, "at the time of the invention of the '548 Patent, neither decoding, such as bar code reading, nor electronically transmitting, was unknown, unachievable, or incapable of being combined in the manner claimed."

    Institution Decision (Paper 11) at 14.

Institution Decision (Paper 11) at 14.

# RMI Attempts to "Narrow" Its Abstract Idea

## RMI Alleges Incorrectly:

Claims 39-44 simply do not contemplate, let alone claim, "transform[ing] incorrect address information into correct address information after checking the available database" or providing a "notification that the prior address is incorrect."

USPS Reply (Paper 22) at 4.

- and then processed by the application server"

RMI Response (Paper 21) at 36.

- "the encoded information… is decoded and *transforms incorrect address information into correct address information after checking the available databases or alternatively a notification that the prior address is incorrect.*

RMI Response (Paper 21) at 39 (emphases added).

# RMI Attempts to "Narrow" Its Abstract Idea

RMI efforts to "narrow" its abstract idea by importing language and limitations not recited by the claims to avoid preemption (and later will be shown anticipation) run afoul of Supreme Court precedent.

*Mayo* holds that the breadth or narrowness of an abstract idea is not relevant to the application of the exclusionary rule itself. Rather, the exclusionary rule applies "even if the particular… abstract idea at issue is narrow."

*buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 133 (quoting *Mayo*, 132 S.Ct. at 1303).

UNITED STATES POSTAL SERVICE.

# Claims 39-44 Fail the Machine-or-Transformation Test

RMI's last attempt is to argue that its claims "satisfy both the machine or transformation tests ('MOTT')."

RMI Response (Paper 21) at 39.

"[T]here can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible."

*DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (citing *Alice*, 134 S.Ct. at 2358).

# Claims 39-44 Should be Cancelled Under 35 U.S.C. § 101

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

Therefore, USPS respectfully requests cancellation of asserted claims 39-44 of the '548 patent as being unpatentable under 35 U.S.C. § 101 and anticipated by *1997 ACS* under § 102 for the reasons set forth herein, in USPS Reply (Paper 22) and in its Petition for CBM Review (Paper 2).

USPS Reply (Paper 22) at 1-2.

# The ’548 Patent
# System and Method for Processing Returned Mail

*1997 ACS* Anticipates the ’548 Patent

Under 35 U.S.C. § 102

# *1997 ACS* Anticipates the ’548 Patent


- *1997 ACS* is a practical system used to actually practice processing return mail.

  *1997 ACS* (Ex. 1004).

- RMI attempts to muddy the water by arguing that *1997 ACS* is significantly more complicated than the ’548 Patent.

  USPS Reply (Paper 22) at 6-7.

- But the USPS system (1997 ACS) is an operational system in the real world, which has to solve a problem as oppose to just covering an abstract idea of “relaying mailing address data.”

  *1997 ACS* (Ex. 1004).

- *1997 ACS* may be more complicated than the ’548 Patent but *1997 ACS* discloses each limitation at least once regardless of the “particular circumstances.”

  USPS Reply (Paper 22) at 6-7.

# Reduce Undeliverable-as-Addressed (UAA) Mail Volume


## Major Benefits of ACS

- Time and money are saved when electronic address corrections are compared with manual address corrections.
- Undeliverable-as-addressed (UAA) mail volume is reduced.
- Manual address corrections are reduced.
- Labor-intensive address change functions are reduced.
- Electronic address change information is available for specific mailings.
- Timely information is provided on a schedule you determine.
- Changes can be made electronically rather than manually.
- Address change information can be retrieved electronically by large-volume mailers via a telecommunications network.

*1997 ACS* (Ex. 1004) at 5.

# Automated Electronic Process for Providing Address Correction


## What Is Address Change Service?

### ACS Change-of-Address Notifications

Address Change Service (ACS) is an automated electronic enhancement to our traditional manual process for providing address corrections to mailers. It is not a replacement for the manual process; instead, it allows the opportunity for a reduction in the volume of manual address correction notifications provided. Therefore, ACS reduces both USPS and mailer costs for this activity.

*1997 ACS* (Ex. 1004) at 5.

# *1997 ACS* "Codes" Indicate the Sender Wants a Corrected Address

Senders place an intended recipient on the mail piece and encode an Address Change Service ("ACS") participant code or an ACS participant code and endorsement on the mail piece for which they would like a corrected address.


## Participation Requirements

**Participant Code**

To use ACS, you must add to your mailpiece address block the ACS participant code assigned by the USPS. This code can be provided only by the ACS Department at the NCSC. The participant code consists of seven alpha characters and must be printed on the first line of the address block (the optional endorsement line), aligned left, preceded by a single pound sign (#) delimiter, and followed by at least one space before any further information (carrier route, presort, etc.) is printed on that line.

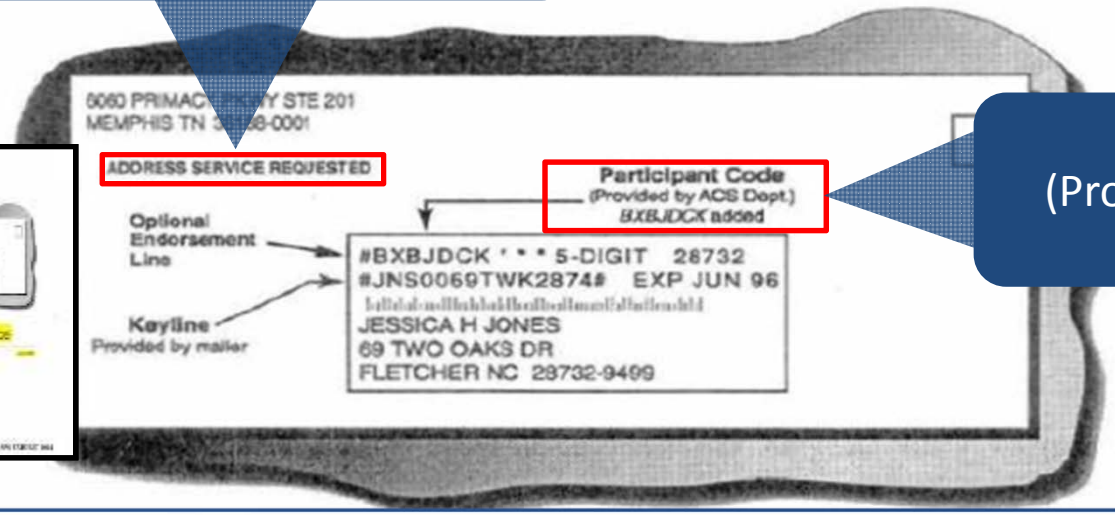
**Notes:**

- The pound sign (#) delimiter must precede the ACS participant code. The pound sign should not be used on any non-ACS mailings.
- The participant code must be placed on each mailpiece for which an electronic notification is requested.
- The participant code for a specified class of mail must be placed on the correct class of mail.
- Incorrect placement of the participant code decreases electronic ACS volumes.

*1997 ACS* (Ex. 1004) at 8.

# *1997 ACS* "Codes" Indicate the Sender Wants a Corrected Address

ADDRESS SERVICE REQUESTED

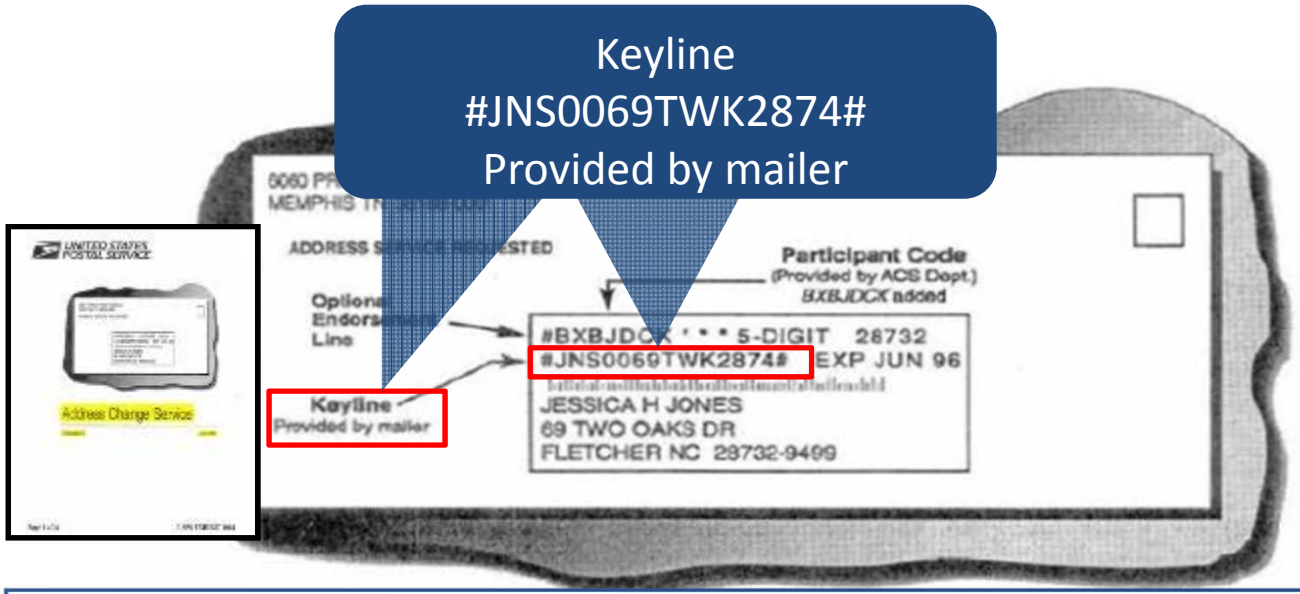




Participant Code
(Provided by ACS Dept.)
BXBJDCK

A properly coded ACS participant code includes information about the additional service (known as an "ancillary service") or set of services the mailer is requesting (e.g., corrected address requested or destroy mail piece subsequent to mailing).

*1997 ACS* (Ex. 1004) at 8.

# *1997 ACS* "Codes" Indicate the Sender Wants a Corrected Address




"[K]eylines are required if the mailer wants to receive electronic ACS nixie notifications."

*1997 ACS* (Ex. 1004) at 6.

"The keyline is generated by the mailer and is composed of information that may be used to identify a specific customer, such as an account number, subscription number, record number, parts of the name, etc."

*1997 ACS* (Ex. 1004) at 19.

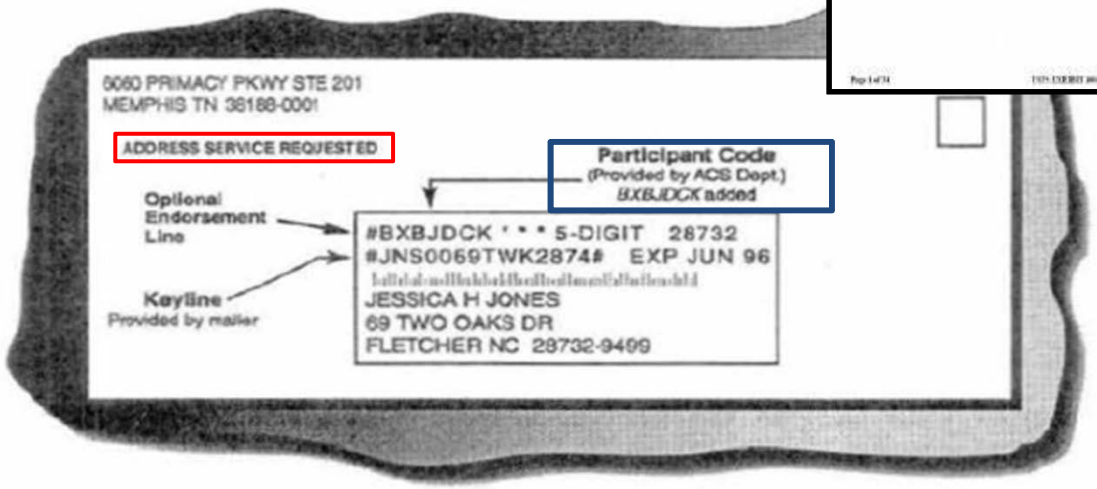
# *1997 ACS* "Codes" Indicate the Sender Wants a Corrected Address

To receive Address Change Services a sender must place either an Address Change Service participant code or an Address Change Service participant code and endorsement on the mail piece.

**Notes:**

- The pound sign (#) delimiter must precede the ACS participant code. The pound sign should not be used on any non-ACS mailings.
- The participant code must be placed on each mailpiece for which an electronic notification is requested.
- The participant code for a specified clas
on the correct class of mail.
- Incorrect placement of the participant c
ACS volumes.

*1997 ACS* (Ex. 1004) at 9.


*1997 ACS* (Ex. 1004) at 8.

Figure from page 8 of 1997 ACS illustrating the participation

# *1997 ACS* "Codes" Indicate How to Process Return Mail

When the mail is undeliverable-as-addressed (e.g., the intended recipient moved and did not file a change of address), the carrier sends the mail to the Computerized Forwarding System (CFS), where the CFS decodes the ACS participant code (optionally decoding endorsements if required) and determines how to process the returned piece of mail.


When a carrier receives a mailpiece and it is undeliverable-as-addressed at the old address due to customer relocation, the mailpiece (depending on its mail class and endorsements) is sent by the postal employee to the CFS unit responsible for forwarding mail destined to that old address. An attempt is then made to match the name and address to a COA on file at the CFS unit. If a match is attained from the CFS database and the mailpiece bears an active ACS participant code, the opportunity exists for an electronic notification to be generated. Otherwise, the COA notification is provided manually. Depending on its mail class and endorsements, the mailpiece is forwarded, discarded, or returned to sender.

More than 200 CFS units nationwide serve the majority of the United States and generate ACS fulfillment notifications. It should be noted, however, that some areas of the country and smaller post offices lie

*1997 ACS* (Ex. 1004) at 4.

# RMI Agrees *1997 ACS* Discloses "Processing Returned Mail Items"

Certainly USPS believes the '548 Patent is anticipated by *1997 ACS* but hear RMI's words:

## RMI's Own Words

"[I]f a postal carrier receives a mail item that is undeliverable-as-addressed because the intended recipient has moved, in certain situations, the mail item is sent to a CFS unit."

RMI Response (Paper 21) at 53.

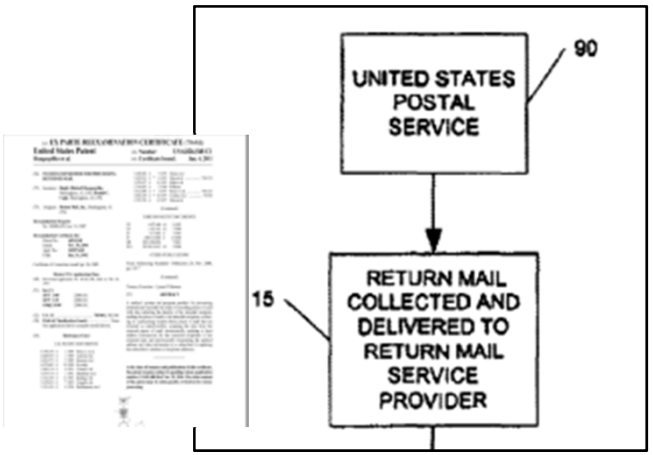
# RMI Agrees *1997 ACS* Discloses "Processing Returned Mail Items"

RMI discloses receiving "returned mail" from the United States Postal Service.

## RMI's Own Words

"Referring to FIG. 1, at the return mail service provider's location, the **returned mail (block 15) is received from the United States Postal Service** (block 90)."

'548 Patent (Ex. 1001), 3:32-34 (emphasis added).




'548 Patent (Ex. 1001), Fig. 1

# RMI Agrees *1997 ACS* Discloses "Obtaining a Corrected Address"

Certainly USPS believes the '548 Patent is anticipated by *1997 ACS* but hear RMI's words:

## RMI's Own Words

"A CFS clerk **looks up the name and address on the mail item** in the look-up database, and **if the clerk finds a match** between the name and address on the hard copy mail item and the information in the look-up database, then in certain situations there is an opportunity for an electronic notification to be generated."

RMI Response (Paper 21) at 53 (emphases added).

# RMI Agrees *1997 ACS* Discloses "Obtaining a Corrected Address"

Certainly USPS believes the '548 Patent is anticipated by *1997 ACS* but hear RMI's words:

RMI's Expert, Dr. Scott Nettles' Own Words

"1997 ACS discloses for using a computer is having a CFS clerk **match the name and address information on a mail item to information in a database**."

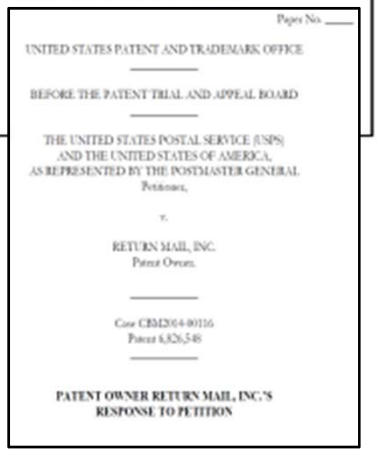
Dr. Scott Nettles Declaration (Ex. 2015) at ¶ 119 (emphases added).

# RMI Agrees *1997 ACS* Discloses "Obtaining a Corrected Address"

RMI alleges (incorrectly) that *"1997 ACS* does not describe or disclose the limitation "subsequent to determining that the sender wants a corrected address to be provided for the intended recipient," but does not argue that *1997 ACS* does not discloses "obtaining an updated address of the intended recipient."

| Claim 39 | |
|---|---|
| | Petitioner does not attempt to address the limitation of "returned mail items," which are "items that are mailed and come back to a post office facility." (Decision, Paper 11, at 10). *1997 ACS* does not describe or disclose this limitation.[31] |
| [39.2] obtaining an updated address of the intended recipient subsequent to determining that the sender wants a corrected address to be provided for the intended | *1997 ACS* does not describe or disclose the limitation "subsequent to determining that the sender wants a corrected address to be provided for the intended recipient."[32] |

RMI Response (Paper 21) at 64.



Paper No. ____

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

PATENT OWNER RETURN MAIL, INC.'S
RESPONSE TO PETITION

# RMI Agrees *1997 ACS* Discloses "Electronically Transmitting"

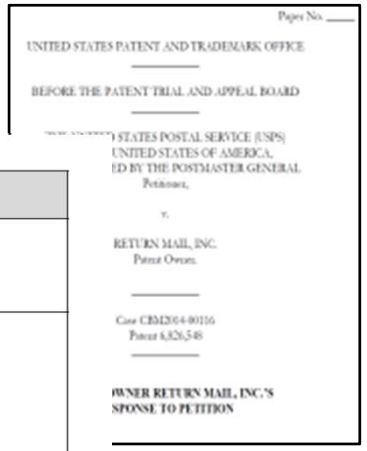
Certainly USPS believes the '548 Patent is anticipated by *1997 ACS* but hear RMI's words:

## RMI's Own Words

"A CFS clerk looks up the name and address on the mail item in the look-up database, and if the clerk finds a match between the name and address on the hard copy mail item and the information in the look-up database, then in certain situations there is an **opportunity for an electronic notification to be generated**."

RMI Response (Paper 21) at 53 (emphasis added).

# RMI Agrees *1997 ACS* Discloses "Electronically Transmitting"


Paper No. ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STATES POSTAL SERVICE (USPS)
UNITED STATES OF AMERICA,
ED BY THE POSTMASTER GENERAL
Petitioner,

v.

RETURN MAIL, INC.
Patent Owner.

Case CBM2014-00116
Patent 8,820,548

WNER RETURN MAIL, INC.'S
SPONSE TO PETITION

| Claim 39 | Claim 39 is not anticipated by *1997 ACS* |
|---|---|
| recipient; and | |
| [39.3] electronically transmitting an updated address of the intended recipient to a transferee, wherein the transferee is a return mail service provider. | |

RMI Response (Paper 21) at 65.

- RMI presents no arguments that *1997 ACS* does not disclose limitation 39.3; thus, RMI has conceded that *1997 ACS* discloses limitation 39.3 "electronically transmitting an updated address of the intended recipient to a transferee, wherein the transferee is a return mail service provider.

# Claim 39 is Anticipated by *1997 ACS*

RMI agrees that *1997 ACS* discloses the following elements (✓). The dispute is over the "decoding" limitation, which *1997 ACS* discloses.

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.


RMI Response (Paper 21) at 53, 64-65.

# Claim 40 is Anticipated by *1997 ACS*

RMI agrees that *1997 ACS* discloses the following elements (✓). The dispute is over the "decoding" limitations, which *1997 ACS* discloses.

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.


RMI Response (Paper 21) at 53, 64-65.

# Claim 41 is Anticipated by *1997 ACS*

RMI agrees that *1997 ACS* discloses the following elements (✓). The dispute is over the "decoding" and "encoding" limitations, which *1997 ACS* discloses.

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 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.


RMI Response (Paper 21) at 53, 64-65.

# Claim 42 is Anticipated by *1997 ACS*

Claim 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 including 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 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.

'548 Patent (Ex. 1002) at 2:1-24.

# Only "Decoding" in Dispute

Trial has simplified the issues in this proceeding. The only element in debate is whether *1997 ACS* discloses "decoding … information indicating whether the sender wants a corrected address"

Claim 3
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.

'548 Patent (Ex. 1002) at 1:21-33.

# *1997 ACS* Discloses at Least Three Types of "Encoded/Decode Data"

RMI repeatedly argues to no effect that *1997 ACS* does not disclose any "codes" that can be encoded and decoded.

## RMI Alleges Incorrectly:

(1) The "participant code is simply a[n] arbitrarily assigned list of seven letters, and the specific letters used have no meaning behind them."

RMI Response (Paper 21) at 57.

(2) The Ancillary Service Endorsements (i.e. Address Service Requested and Change Service Requested) are in plain English "[t]hus, they do not meet the definition of 'encoded data.'"

RMI Response (Paper 21) at 58.

(3) "The keyline is simply additional identification information."

RMI Response (Paper 21) at 71.

# *1997 ACS* Discloses at Least Three Types of "Codes"

- There is no question that *1997 ACS* discloses *three* such codes:
  - (1) ACS Participant Code (e.g., "#BXBJDCK"); *1997 ACS* (Ex. 1004) at 9.
  - (2) Ancillary Service Endorsement ("ASE") (e.g., "ADDRESS SERVICE REQUESTED"); and *1997 ACS* (Ex. 1004) at 10.
  - (3) Keyline (e.g., #JNS0069TWK2874#) *1997 ACS* (Ex. 1004) at 14.
- Each represents "data converted into code" and each is "decipherable."

USPS Reply (Paper 22) at 7-8.

# *1997 ACS* Discloses at Least Three Types of "Codes"

- There is no question that *1997 ACS* discloses *three* such codes:
  - (1) ACS Participant Code (e.g., "#BXBJDCK");
  - (2) Ancillary Service Endorsement ("ASE") (e.g., "ADDRESS SERVICE REQUESTED"); and
- The (1) ACS Participant Code, (2) Ancillary Service Endorsement, and (3) Keyline "indicat[es] a sender wants a corrected address provided for the intended recipient," as required by Claims 39-44.

# *1997 ACS* Discloses at Least Three Types of "Codes"

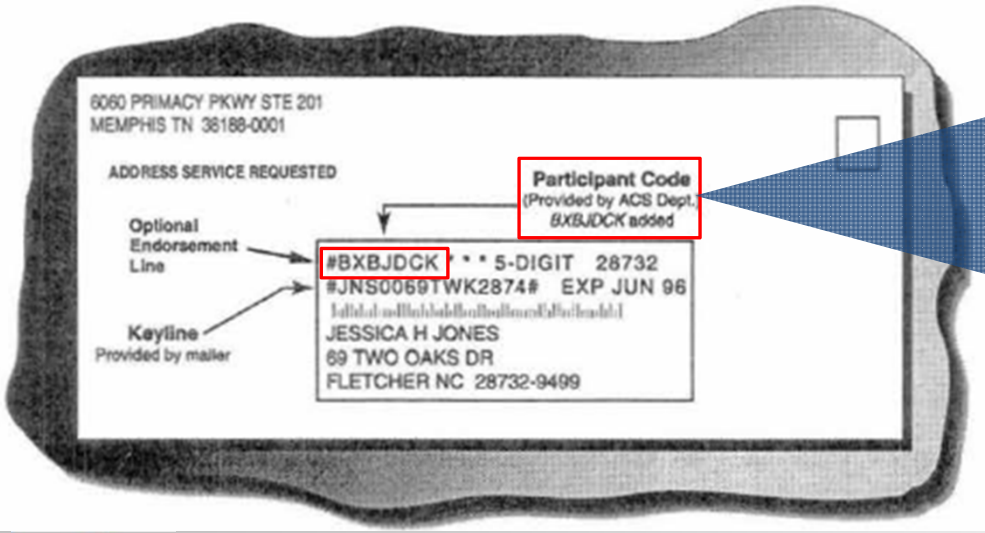
- There is no question that *1997 ACS* discloses *three* such codes:

The (3) Keyline discloses "encode[d] and decode[d] intended recipient identification information," as required by Claim 41.

  - "ADDRESS SERVICE REQUESTED"); and *1997 ACS* (Ex. 1004) at 10.
  - (3) Keyline (e.g., #JNS0069TWK2874#) *1997 ACS* (Ex. 1004) at 14.
- Each represents "data converted into code" and each is "decipherable."

USPS Reply (Paper 22) at 7-8.

# (1) ACS Participant Code is Encoded/Decoded Data




Participant Code
(Provided by ACS Dept.)
BXBJDCK

*1997 ACS* (Ex. 1004) at 8.


Dr. Joe Lubenow

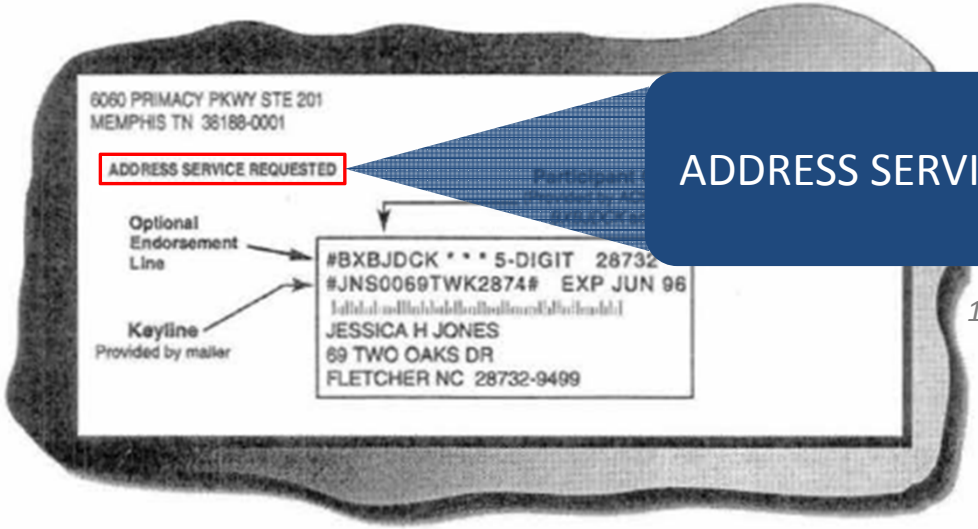
- "The ACS Participant Code includes seven alphabetical characters preceded by a pound sign (#)."

  Lubenow Supplemental Declaration (Ex. 1028) at ¶ 15 (citing *1997 ACS* at 9).

- The CFS Unit must decode this code to determine if the customer is participating in electronic notification.

  Lubenow Supplemental Declaration (Ex. 1028) at ¶ 15 (citing *1997 ACS* at 5).

# (2) Ancillary Service Endorsement (ASE) is Encoded/Decoded Data




*1997 ACS* (Ex. 1004) at 8.


## Dr. Joe Lubenow

"There is no inherent meaning in those three words that would tell you, for instance, that if the same three words were put on a first class mail endorsement, it would mean something during months 1 to 12 and something else during the period after 12 months."

Lubenow Deposition (Ex. 1023) at 158.

# (2) Ancillary Service Endorsement (ASE) is Encoded/Decoded Data

ASE are a short hand code for a "complex set of rules and behaviors."

## Dr. Joe Lubenow

Q: If something is simply written in plain English on an envelope, "Address Service Requested," how is that encoded or decoded?

A: "That is encoded or decoded because it stands for a complex set of rules and behaviors." "It's a short form of describing a much longer series of behavior. If you had to write on the mail piece I would like a mail piece to be forwarded if it's within one to 12 months, but I understand that if it's after 12 months something different is going to happen and I accept that…"

Lubenow Deposition (Ex. 1023) at 156, 159).

# (2) Ancillary Service Endorsement (ASE) is Encoded/Decoded Data

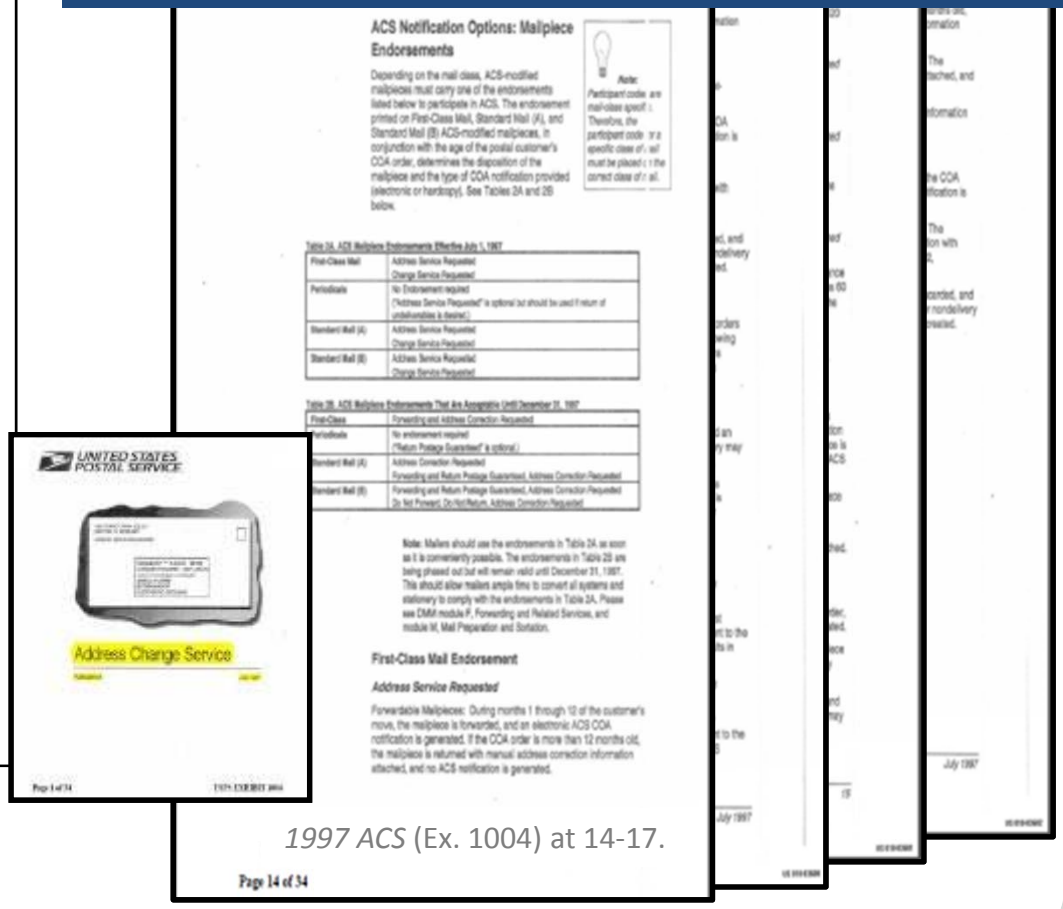
## Dr. Joe Lubenow

Q. And then depending on the mail class and the endorsement on the mail item, the mail item is either forwarded, discarded, or returned to the sender; correct?

A. Yes. There's -- in the ACS guide, it's rather complicated. … What I am pointing out is there's four pages of rules that govern what you're supposed to do, depending on the mail class and the term.

Lubenow Deposition (Ex. 1023) at 122-123.

ACS Notification Options: Mailpiece Endorsements




*1997 ACS* (Ex. 1004) at 14-17.

# (2) Ancillary Service Endorsement (ASE) is Encoded/Decoded Data

## Dr. Joe Lubenow

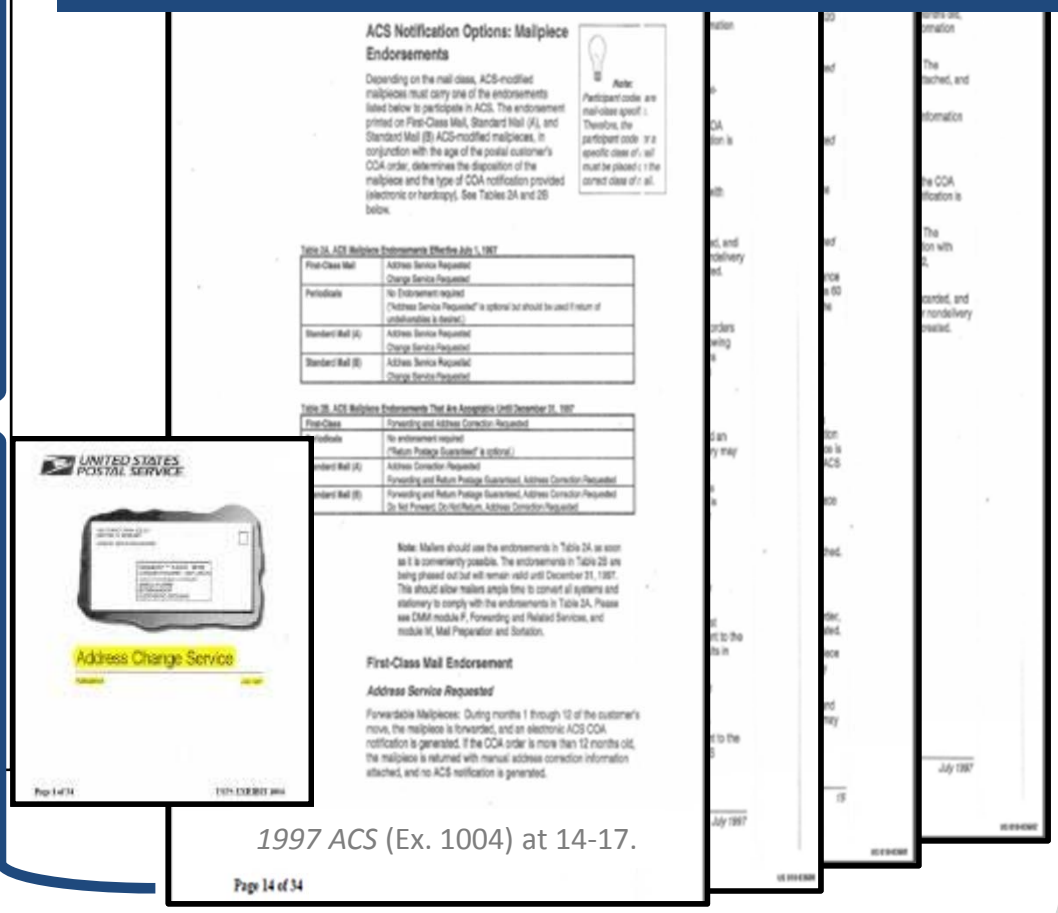
Q. And then depending on the mail class and the endorsement on the mail item, the mail item is either forwarded, discarded, or returned to the sender; correct?

Pages 14-17 of *1997 ACS* describing the Address Change Service Options for each mail class

…de, it's
…m
…es of
rules that govern what you're supposed to do, depending on the mail class and the term.

Lubenow Deposition (Ex. 1023) at 122-123.

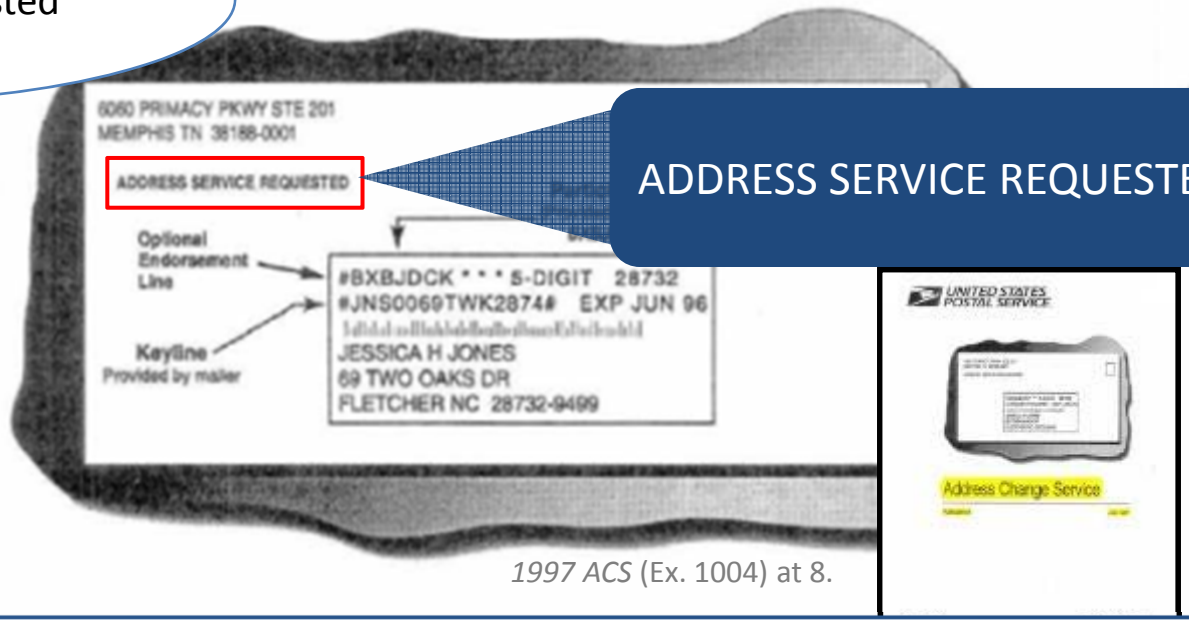
ACS Notification Options: Mailpiece Endorsements




*1997 ACS* (Ex. 1004) at 14-17.

# (2) Ancillary Service Endorsement (ASE) is Encoded/Decoded Data

What does "Address Service Requested" mean?




*1997 ACS* (Ex. 1004) at 8.

If my grandmother saw "ADDRESS SERVICE REQUESTED" on her mail she would not understand how to "decode" that information.

Dr. Lubenow, an expert with 35+ years of postal experience, states "[t]he phrase does not have a generally understood meaning, as would be the case if the code phrase was plain English." Lubenow Supplemental Declaration (Ex. 1028) at 7.

# (2) Ancillary Service Endorsement (ASE) is Encoded/Decoded Data

## Standard Mail (A) Endorsement

***Address Service Requested***

Forwardable Mailpieces: During months 1 through 12 of the customer's move, the mailpiece is forwarded, and an electronic ACS COA notification is generated. If the COA order is more than 12 months old, the mailpiece is returned with manual address correction information attached, and no ACS notification is generated.

Undeliverable Mailpieces Matched to Carrier-Filed Actions: The mailpiece is returned with manual nondelivery information attached. No ACS notification is generated.

Nixies: Mailpiece is returned with manual nondelivery information attached. No ACS notification is generated.

***Change Service Requested***

Forwardable Mailpieces: During the entire 18-month life of the COA order, the mailpiece is discarded, and an electronic ACS notification is generated.

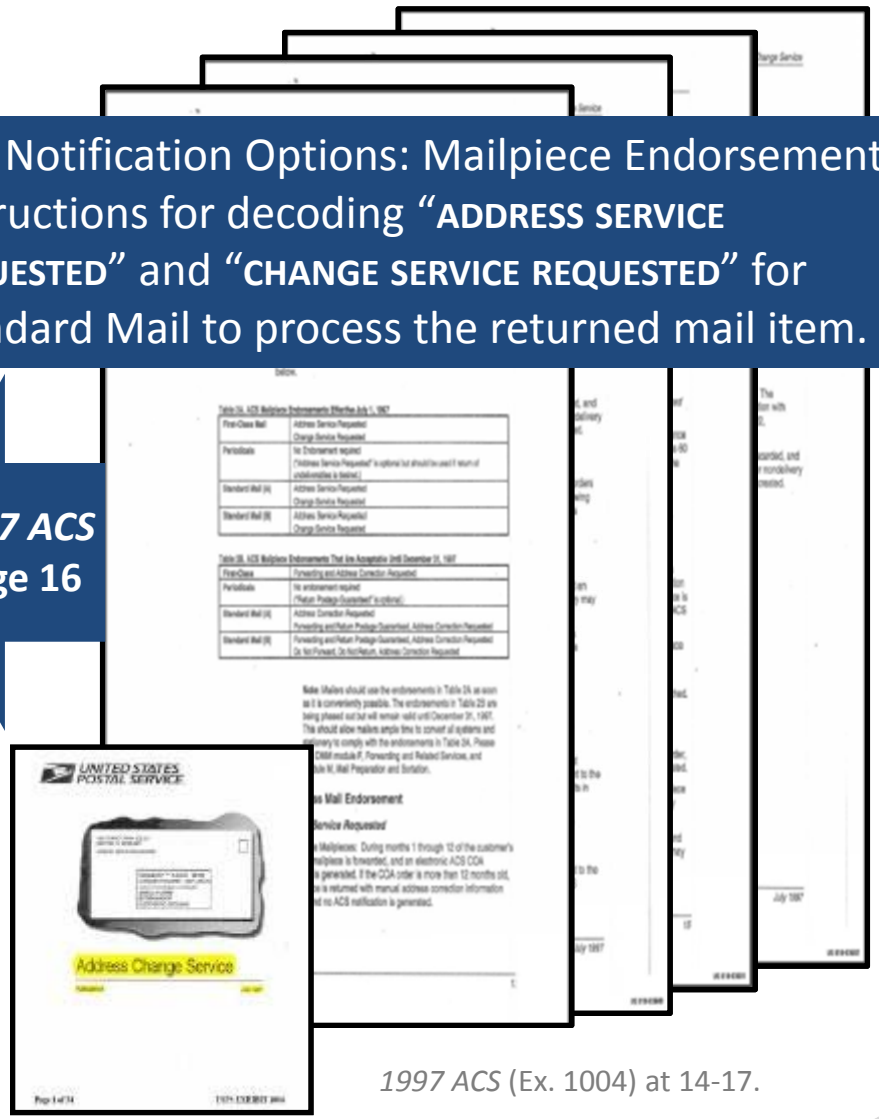
Undeliverable Mailpieces Matched to Carrier-Filed Actions: The mailpiece is discarded, and an electronic ACS COA notification with Deliverability Code "K," "G," or "C" is generated (see page 22, Deliverability Code).

Nixies: If the mailpiece is sent to CFS for processing, it is discarded, and an electronic ACS nixie notification stating the reason for nondelivery may be generated; otherwise, a manual nixie notification is created.

*1997 ACS* (Ex. 1004) at 16.

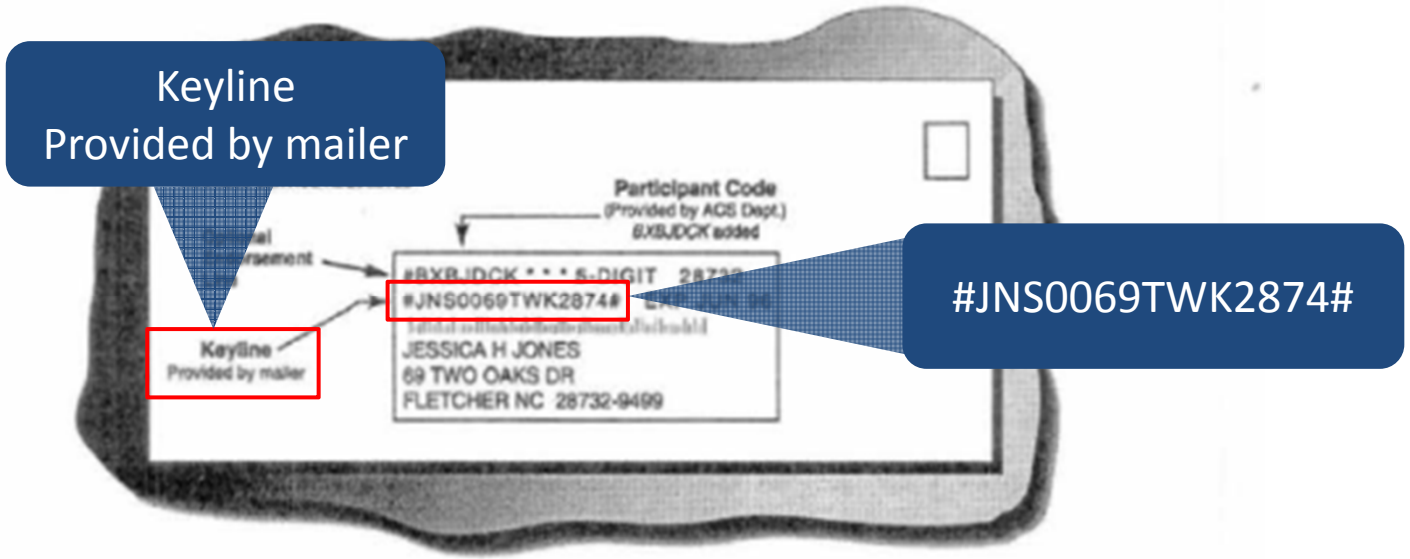
ACS Notification Options: Mailpiece Endorsements Instructions for decoding "**ADDRESS SERVICE REQUESTED**" and "**CHANGE SERVICE REQUESTED**" for Standard Mail to process the returned mail item.

***1997 ACS***
**Page 16**




*1997 ACS* (Ex. 1004) at 14-17.

# (3) Keyline is Encoded/Decoded Data





*1997 ACS* (Ex. 1004) at 8.

- "The keyline is generated by the mailer and is composed of information that may be used to identify a specific customer, such as an account number, subscription number, record number, parts of the name, etc."
- "The keyline printed on an ACS-modified mailpiece is returned as part of an ACS fulfillment record and can therefore be used to find the relocating customer on the mailer's address list."

*1997 ACS* (Ex. 1004) at 19.

# (3) Keyline is Encoded/Decoded Data

Example 1: Computation of Check Digit for Keyline **JLSTMS6796**

| Character | J | L | S | T | M | S | 6 | 7 | 9 | 6 |
|---|---|---|---|---|---|---|---|---|---|---|
| Position | 1(O) | 2(E) | 3(O) | 4(E) | 5(O) | 6(E) | 7(O) | 8(E) | 9(O) | 10(E) |
| Value | 10 | 12 | 3 | 4 | 13 | 3 | 6 | 7 | 9 | 6 |
| Weighted Value | 20 | 12 | 6 | 4 | 26 | 3 | 12 | 7 | 18 | 6 |
| Sum | 2+0 | +1+2 | +6 | +4 | +2+6 | +3 | +1+2 | +7 | +1+8 | +6 = 51 |

Rightmost Digit of Sum: 1

Check Digit: 10-1=9

Complete Keyline: JLSTMS67969

*1997 ACS* (Ex. 1004) at 12.

## Dr. Joe Lubenow

- "[Keyline] would need to be decoded in order to validate it, at least to the point of it being a valid set of information."

  Lubenow Deposition (Ex. 1023) at 163-164).

- "The Keyline is decoded by both the USPS (as part of the Check Digit Computation) and by the sender to allow matching the ACS notification with the sender's records."

  Lubenow Supplemental Declaration (Ex. 1028) at ¶¶ 19-20 (citing *1997 ACS* at 10-11).

# Claim 39 is Anticipated by *1997 ACS*

RMI agrees that *1997 ACS* discloses the following elements (✓). The dispute is over the "decoding" limitation, which *1997 ACS* discloses.

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.


RMI Response (Paper 21) at 52-65.

# Claim 39 is Anticipated by *1997 ACS*

*1997 ACS* discloses "[t]o use ACS, you must add to your mailpiece address block the ACS participant code assigned by the USPS." *1997 ACS* (Ex. 1004) at 5.

*1997 ACS* discloses "Although optional for COA information, keylines are required if the mailer wants to receive electronic ACS nixie notifications. Also, each keyline must end with a check digit correctly calculated using the USPS standard for check digit computation." *1997 ACS* (Ex. 1004) at 6.

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.

# Claim 39 is Anticipated by *1997 ACS*

*1997 ACS* discloses "when a carrier receives a mailpiece and it is undeliverable-addressed at the old address due to customer relocation, the mailpiece (*depending on its . . . endorsements*) is sent by the postal employee to the CFS unit . . . " *1997 ACS* (Ex. 1004) at 5.

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.

# Claim 40 is Anticipated by *1997 ACS*

RMI agrees that *1997 ACS* discloses the following elements (✓). The dispute is over the "decoding" limitations, which *1997 ACS* discloses.

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.


RMI Response (Paper 21) at 52-62, 65-69.

# Claim 40 is Anticipated by *1997 ACS*

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.

***Participant Code***

"Contains the USPS assigned participant code. The field length is seven alpha characters."

*1997 ACS* (Ex. 1004) at 23.

**ACS Fulfillment File COA Record Format**

| Field ID | Position | Length | Type |
|---|---|---|---|
| Record Type ID | 1 | 1 | N |
| Sequence Number | 2 – 9 | 8 | N |
| Participant Code | 10 – 16 | 7 | A |
| Keyline | 17 – 32 | 16 | A/N |


*1997 ACS* (Ex. 1004) at 22.

# Claim 40 is Anticipated by *1997 ACS*

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 m l items returned subsequent to mailing as being undeliverable;

determining from the decoded data tha he customer wants a corrected address to be provided for at least e of the plurality of undeliverable mail items;

receive an updated address of an intend recipient for at least one of the plurality of undeliverable mail items, su equent to and based upon the determining step; and

transmit the updated address to a trans ee, wherein the transferee is a return mail service provider.

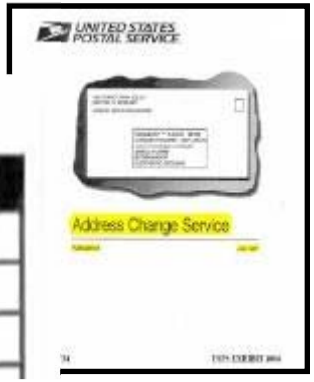
***Hdr-Customer-ID***

"Contains a string of characters unique to each ACS customer. The field length is six numeric characters."

*1997 ACS* (Ex. 1004) at 20.

**ACS Fulfillment File Header Record Format**

| Field ID | Position | Length | Type |
|---|---|---|---|
| Hdr-Indication | 1 | 1 | A |
| Hdr-Customer-ID | 2 – 7 | 6 | N |
| Hdr-Date | 8 – 13 | 6 | N |




*1997 ACS* (Ex. 1004) at 20.

# Claim 40 is Anticipated by *1997 ACS*

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.


- *1997 ACS* discloses "[t]he participant code must be placed on each mailpiece for which an electronic notification is requested."
- "The mailpiece is sent to CFS for processing, it is discarded, and an electronic ACS nixie notification containing the reason for nondelivery may be generated." *1997 ACS* (Ex. 1004) at 9 & 15.

# Claim 41 is Anticipated by *1997 ACS*

RMI agrees that *1997 ACS* discloses the following elements (✓). The dispute is over the "decoding" and "encoding" limitations, which *1997 ACS* discloses.

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 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.


RMI Response (Paper 21) at 52-62, 69-72.

# Claim 41 is Anticipated by *1997 ACS*

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

## Dr. Joe Lubenow

Q. The first question is, does the CFS unit have scanners?

A. To the best of my knowledge, yes, it does.

Q. And what is scanned by the scanners in the CFS Unit?

A. I will refer you to the cover of the Address Change Service, Exhibit 1004… And it scans the participant code, the optional endorsement line if present, the keyline, the barcode if present, the name and address and ZIP code. And it scans the ancillary service endorsement, in this case ADDRESS SERVICE REQUESTED.

Lubenow Deposition (Ex. 1023) at 168-169 (emphases added).

# Claim 41 is Anticipated by *1997 ACS*

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 infor

encode and dec

intended recipie

*1997 ACS* discloses "when a carrier receives a mailpiece and it is undeliverable-addressed at the old address due to customer relocation, the mailpiece (*depending on its . . . endorsements*) is sent by the postal employee to the CFS unit . . . ." *1997 ACS* (Ex. 1004) at 4.


When a carrier receives a mailpiece and it is undeliverable-as-addressed at the old address due to customer relocation, the mailpiece (depending on its mail class and endorsements) is sent by the postal employee to the CFS unit responsible for forwarding mail destined to that old address. An attempt is then made to match the name and address to a COA on file at the CFS unit. If a match is attained from the CFS database and the mailpiece bears an active ACS participant code, the opportunity exists for an electronic notification to be generated. Otherwise, the COA notification is provided manually. Depending on its mail class and endorsements, the mailpiece is forwarded, discarded, or returned to sender.

More than 200 CFS units nationwide serve the majority of the United States and generate ACS fulfillment notifications. It should be noted, however, that some areas of the country and smaller post offices lie

*1997 ACS* (Ex. 1004) at 4.

# Claim 41 is Anticipated by *1997 ACS*

*1997 ACS* discloses "[t]o use ACS, you must add to your mailpiece address block the ACS participant code assigned by the USPS." *1997 ACS* (Ex. 1004) at 5.

*1997 ACS* discloses "Although optional for COA information, keylines are required if the mailer wants to receive electronic ACS nixie notifications. Also, each keyline must end with a check digit correctly calculated using the USPS standard for check digit computation." *1997 ACS* (Ex. 1004) at 6.

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 information; and iii) enable an updated a to be sent to a transferee, wherein the transferee provider.

*1997 ACS* (Ex. 1004) at 8.

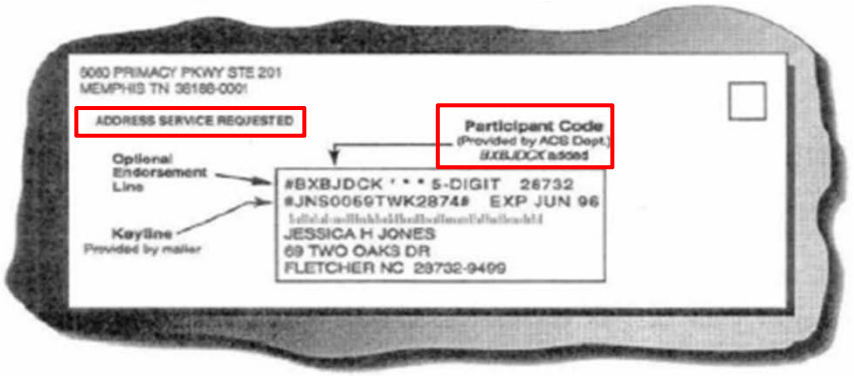



Figure from page 8 of 1997 ACS illustrating the participation

# Claim 41 is Anticipated by *1997 ACS*

address file. Because these differences may require complex matching logic to locate a customer within the address file, the ACS keyline can b used to ensure a match. The keyline is generated by the mailer and is composed of information that may be used to identify a specific customer, such as an account number, subscription number, record number, parts of the name, etc.

Encode

The keyline printed on an ACS-modified mailpiece is returned as part of an ACS fulfillment record and can therefore be used to find the relocating customer on the mailer's address list.

Decode

*1997 ACS* (Ex. 1004) at 19.


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 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.

# Claim 41 is Anticipated by *1997 ACS*

Encode

Decode

**Keyline**

Most ACS participants choose to use the keyline option, which provides an effective means of matching ACS notifications with the appropriate records in their address files. Although optional for COA information, keylines are required if the mailer wants to receive electronic ACS nixie notifications. The keyline can consist of 4 to 16 characters, including a check digit that is calculated according to the USPS standard for check digit computation (see page 11, USPS Standard for Check Digit Computation).

*1997 ACS* (Ex. 1004) at 10.


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 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.

# Claim 41 is Anticipated by *1997 ACS*

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 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.

## RMI's Own Words:

"The keyline described or disclosed in *1997 ACS* is simply additional identification information."

RMI Response (Paper 21) at 71.

# Claim 41 is Anticipated by *1997 ACS*

## Dr. Joe Lubenow

*1997 ACS* discloses that the keyline has a length of 16 characters that must occupy bit positions 17-32 in the ACS Fulfillment File Change of Address Record. This indicates to me that a person of ordinary skill in the art would understand that a computer would be encoding the keyline into the fulfillment file before transmission to the mailer.

Dr. Lubenow Supplemental Declaration (Ex. 1028) at ¶ 20 (citing *1997 ACS* (Ex. 1004) at 22).

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 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.

# Claim 42 is Anticipated by *1997 ACS*

Claim 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 including 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;

RMI agrees that *1997 ACS* discloses the following elements (✓). The dispute is over the "decoding," "encoding," and "creating output" limitations, which *1997 ACS* discloses.

determining if the sender wants a corrected address provided for intended recipients based on the decoded data;

if 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.

'548 Patent (Ex. 1002) at 2:1-24.

# Claim 42 is Anticipated by *1997 ACS*

Claim 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 including 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 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.

'548 Patent (Ex. 1002) at 2:1-24.

# Claim 42 is Anticipated by *1997 ACS*

*1997 ACS* discloses "when the mail is undeliverable-as-addressed (e.g., the intended recipient moved and did not file a change of address), the carrier sends the mail to the Computerized Forwarding System (CFS), where the CFS decodes the ACS participant code (optionally decoding endorsements if required) and determines how to process the returned piece of mail."

*1997 ACS* (Ex. 1004) at 5.

Claim 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 including 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;

(cont.)

# Claim 42 is Anticipated by *1997 ACS*

RMI incorrectly argues that the USPS does not identify a "plurality of mail items."

Claim 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 including 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;

## Major Benefits of ACS

- Time and money are saved when electronic address corrections are compared with manual address corrections.
- Undeliverable-as-addressed (UAA) mail volume is reduced.
- Manual address corrections are reduced.
- Labor-intensive address change functions are reduced.
- Electronic address change information is available for specific mailings.
- Timely information is provided on a schedule you determine.
- Changes can be made electronically rather than manually.
- Address change information can be retrieved electronically by large-volume mailers via a telecommunications network.


*1997 ACS* (Ex. 1004) at 5

# Claim 42 is Anticipated by *1997 ACS*

*1997 ACS* discloses "[t]o use ACS, you must add to your mailpiece address block the ACS participant code assigned by the USPS."

*1997 ACS* discloses "Although optional for COA information, keylines are required if the mailer wants to receive electronic ACS nixie notifications. Also, each keyline must end with a check digit correctly calculated using the USPS standard for check digit computation."

*1997 ACS* (Ex. 1004) at 6.

data including 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;

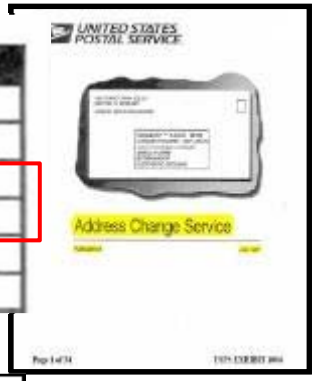
(cont.)

# Claim 42 is Anticipated by *1997 ACS*

**ACS Fulfillment File COA Record Format**

| Field ID | Position | Length | Type |
|---|---|---|---|
| Record Type ID | 1 | 1 | N |
| Sequence Number | 2 – 9 | 8 | N |
| Participant Code | 10 – 16 | 7 | A |
| Keyline | 17 – 32 | 16 | A/N |
| Move Effective Date | 33 – 36 | 4 | N |
| Move Type | 37 | 1 | A/N |

*1997 ACS* (Ex. 1004) at 22.




Claim 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 including wh[ether] the sender wants a corrected address to be provided for the addressee;

identifying, as u[n]iverable mail items, mail items of the plurality of mail items that are returned subsequent to ma[iling] as undeliverable;

decoding the e[n]d 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;

(cont.)

"More than 200 CFS units nationwide serve the majority of the United States and generate ACS fulfillment notifications."

*1997 ACS* (Ex. 1004) at 22.

# Claim 42 is Anticipated by *1997 ACS*

**ACS Fulfillment File Header Record Format**

| Field ID | Position | Length | Type |
|---|---|---|---|
| Hdr-Indication | 1 | 1 | A |
| Hdr-Customer-ID | 2 – 7 | 6 | N |
| Hdr-Date | 8 – 13 | 6 | N |

*1997 ACS* (Ex. 1004) at 20.


Claim 42: A meth or processing a plurality of undeliverable mail items, comprising:

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

identifying, a deliverable mail items, mail items of the plurality of mail items that are returned su quent to mailing as undeliverable;

decoding the oded 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;

cont.

"More than 200 CFS units nationwide serve the majority of the United States and generate ACS fulfillment notifications."

*1997 ACS* (Ex. 1004) at 22.

# Claim 42 is Anticipated by *1997 ACS*

- *1997 ACS* discloses "[t]he participant code must be placed on each mailpiece for which an electronic notification is requested."
- "The mailpiece is sent to CFS for processing, it is discarded, and an electronic ACS nixie notification containing the reason for nondelivery may be generated." *1997 ACS* (Ex. 1004) at 9 & 15.

Claim 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 including 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;

(cont.)

# Claim 42 is Anticipated by *1997 ACS*

Claim 42: A method for processing a plurality of undeliverable mail items, comprising:

(cont.)

if 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 sen

network tha


Participation Requirements

**Participant Code**

To use ACS, you must add to your mailpiece address block the ACS participant code assigned by the USPS. This code can be provided only by the ACS Department at the NCSC. The participant code consists of seven alpha characters and must be printed on the first line of the address block (the optional endorsement line), aligned left, preceded by a single pound sign (#) delimiter, and followed by at least one space before any further information (carrier route, presort, etc.) is printed on that line.

**Notes:**

- The pound sign (#) delimiter must precede the ACS participant code. The pound sign should not be used on any non-ACS mailings.
- The participant code must be placed on each mailpiece for which an electronic notification is requested.
- The participant code for a specified class of mail must be placed on the correct class of mail.
- Incorrect placement of the participant code decreases electronic ACS volumes.

*1997 ACS* (Ex. 1004) at 8

# Claim 42 is Anticipated by *1997 ACS*


The telecommunications option requires that ACS participants regularly dial into the NCSC's computer system or bulletin board system to receive their files. Users incur all costs for telephone line usage along with any hardware or software configuration costs at their facilities.

*1997 ACS* (Ex. 1004) at 7.

Claim 42: A method for processing a plurality of undeliverable mail items, comprising:

(cont.)

if 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.

# Claim 43 is Anticipated by *1997 ACS*


Electronic ACS fulfillment notifications generated by the CFS units are transmitted daily to the National Customer Support Center (NCSC) in Memphis, Tennessee, where they are consolidated and provided to ACS-participating mailers.

*1997 ACS* (Ex. 1004) at 6.

| | | | |
|---|---|---|---|
| COA Name | 42 – 88 | 47 | A/N |
| Old Address Type | 89 | 1 | A |
| Old Urbanization Name | 90 – 117 | 28 | A/N |
| Parsed Old Address | 118 – 177 | 60 | A/N |
| Old City-State-ZIP | 178 – 212 | 35 | A/N |
| New Address Type | 213 | 1 | A |
| New Urbanization Name | 214 – 241 | 28 | A/N |
| Parsed New Address | 242 – 301 | 60 | A/N |
| New City-State-ZIP | 302 – 344 | 43 | A/N |

*1997 ACS* (Ex. 1004) at 22.

43. The method of claim 42, further comprising transmitting the name and address of the intended recipient 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.

# Claim 43 is Anticipated by *1997 ACS*

## RMI's Own Words:

"The Fulfillment file disclosed in *1997 ACS* is at the end of the process ."

RMI Response (Paper 21) at 74.

43. The method of claim 42, further comprising transmitting the name and address of the intended recipient 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.

# Claim 44 is Anticipated by *1997 ACS*


**COA Name**

Identifies the moving customer's name as provided on the COA.

**Note:** This name may not exactly match the customer's name as it appears on your mailing list.

If the Move Type is "F" (Family) or "I" (Individual), the COA Name field i parsed (i.e., subdivided) into the following components:

*1997 ACS* (Ex. 1004) at 24.

| | | | |
|---|---|---|---|
| COA Name | 42 – 88 | 47 | A/N |
| Old Address Type | 89 | 1 | A |
| Old Urbanization Name | 90 – 117 | 28 | A/N |
| Parsed Old Address | 118 – 177 | 60 | A/N |
| Old City-State-ZIP | 178 – 212 | 35 | A/N |
| New Address Type | 213 | 1 | A |
| New Urbanization Name | 214 – 241 | 28 | A/N |
| Parsed New Address | 242 – 301 | 60 | A/N |
| New City-State-ZIP | 302 – 344 | 43 | A/N |

*1997 ACS* (Ex. 1004) at 22.

44. The method of claim 42, where the encoded data further indicates a name and address of the intended recipient.

# Claims 39-44 Should be Cancelled Under 35 U.S.C. § 102

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

Therefore, USPS respectfully requests cancellation of asserted claims 39-44 of the '548 patent as being unpatentable under 35 U.S.C. § 101 and anticipated by *1997 ACS* under § 102 for the reasons set forth herein, in USPS Reply (Paper 22) and in its Petition for CBM Review (Paper 2).

USPS Reply (Paper 22) at 1-2.

# USPS v. RMI
# CBM2014-00116

Claims 39-44 Should Be Cancelled Under 35 U.S.C. §§ 101 and 102

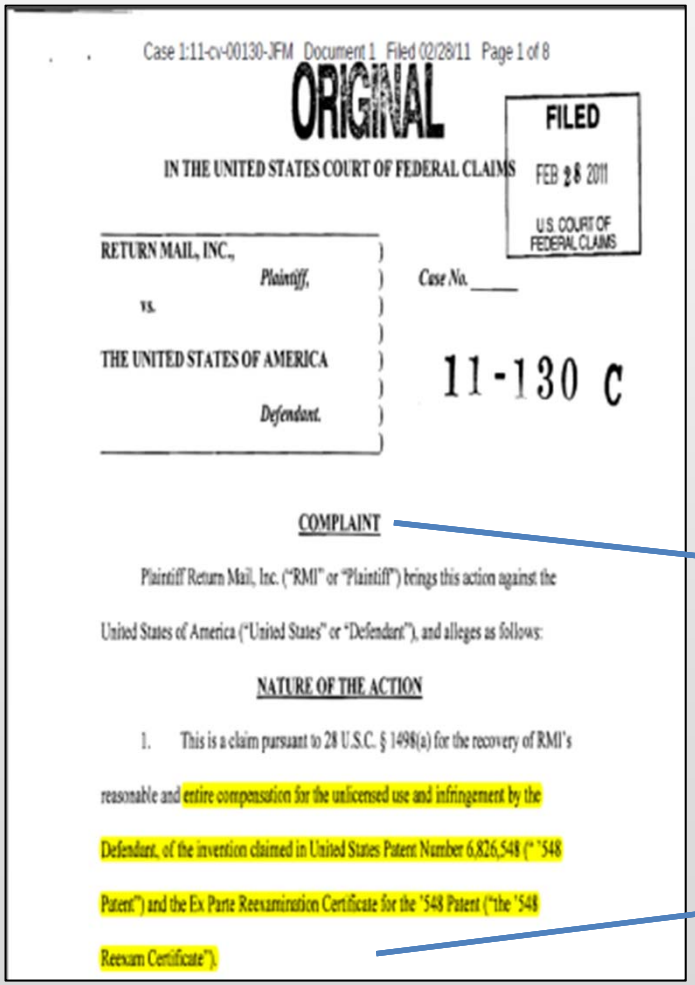
# USPS Has Standing to Bring CBM Review

The ’548 Patent is a CBM Patent, Financial in Nature, and is Not a Technological Invention

# USPS Has Standing to Bring CBM Review of the ’548 Patent

- RMI sued USPS for patent infringement; thus, USPS has standing to bring CBM
- RMI does not dispute that claim 39 recites subject matter that is financial in nature.
- The ’548 Patent is not a technological invention

# USPS Has Standing to Bring CBM Review



Case 1:11-cv-00130-JFM Document 1 Filed 02/28/11 Page 1 of 8

ORIGINAL

FILED
FEB 28 2011
U.S. COURT OF FEDERAL CLAIMS

IN THE UNITED STATES COURT OF FEDERAL CLAIMS

RETURN MAIL, INC.,
*Plaintiff,*
vs.
THE UNITED STATES OF AMERICA
*Defendant.*

*Case No.* 11-130 C

COMPLAINT

Plaintiff Return Mail, Inc. ("RMI" or "Plaintiff") brings this action against the United States of America ("United States" or "Defendant"), and alleges as follows:

NATURE OF THE ACTION

1. This is a claim pursuant to 28 U.S.C. § 1498(a) for the recovery of RMI's reasonable and entire compensation for the unlicensed use and infringement by the Defendant, of the invention claimed in United States Patent Number 6,826,548 (" '548 Patent") and the Ex Parte Reexamination Certificate for the '548 Patent ("the '548 Reexam Certificate").

We disagree with Return Mail. The plain language of § 18(a) of the AIA limits covered business method patent reviews to persons sued or charged with infringement of the covered business method patent. There is no dispute that Return Mail sued the United States in the U.S. Court of Federal Claims under 28 U.S.C. § 1498 for unlicensed use of the '548 Patent. *See* Prelim. Resp. 6-8; Pet. 10. The question before us, then, is whether an action brought against the United States under Section 1498(a) is a suit for infringement.

Institution Decision (Paper 11) at 16.

RMI brought suit for the recovery of "RMI's reasonable and entire compensation for the unlicensed use and **infringement** by the [USPS]."

Ex. 2002 (RMI v. US Complaint) at ¶ 1.

# RMI Erroneously Argues USPS Does Not Have Standing

Under RMI's theory, no Governmental Agency could bring a Covered Business Method Post Grant Review
















# RMI Mischaracterizes the Board's Determination

Whether the one-year statutory bar began when Tessera alleged infringement in a counterclaim during arbitration.

- In *Alcon Research, Ltd. v. Dr. Joseph Neev*, the Board evaluated the meaning of "served with a complaint alleging infringement of the patent" as stated in 35 U.S.C. § 315(b).
- We do not adopt Tessera's interpretation *that an allegation of infringement in an arbitration proceeding triggers the one-year time period of section 315(b). Within the context of section 315(b), the phrase "served with a complaint alleging infringement of the patent" means a complaint in a civil action for patent infringement. What matters is that the complaint pleads a cause of action for patent infringement and is served lawfully on the accused infringer in a civil action.* Once that happens, the accused infringer is subject to the time limit set forth in section 315(b) to petition for *inter partes* review.

IPR2014-00217, Paper 21, 2014 WL 1917933 at *4-5 (PTAB May 9, 2014).

# USPS Has Standing to Bring CBM Review of the ’548 Patent

- RMI sued USPS for patent infringement; thus, USPS has standing to bring CBM
- RMI does not dispute that claim 39 recites subject matter that is financial in nature.
- The ’548 Patent is not a technological invention

# The ’548 Patent is Financial in Nature

- RMI does not dispute that claim 39 recites subject matter that is financial in nature.

Prelim. Resp. (Paper 6) at 10–14; *see also* Institution Decision (Paper 11) at 12.

- Independent claim 39 of the ’548 Patent includes subject matter that is financial in nature because it “provides a method for easing the administrative burden of finance companies, mortgage companies, and credit card companies by making relaying updated mailing address data more cost effective.”

Petition (Paper 2) at 7–8 (citing Ex. 1001, 1:25–38).

- The method of claim 39 “is particularly applicable to high volume (bulk) mail users such as credit card companies,” but “is also applicable to any mail user who experiences and must deal with quantities of returned mail each month.”

*Id*. at 8 (citing Ex. 1001, 2:60–65).

# The Board Agrees the ’548 Patent is Financial in Nature

- RMI does not dispute that claim 39 recites subject matter that is financial in nature. Prelim. Resp. (Paper 6) at 10–14; *see also* Institution Decision at 12.

> “We agree with USPS that independent claim 39 satisfies the ‘financial product or service’ component of the definition set forth in AIA § 18(d)(1). In addition, we note that independent claim 40 is directed to a computer program embodied on a computer-readable medium, yet recites similar claim limitations as those recited in independent claim 39.”
>
> Institution Decision ( Paper 11 ) at 12.

effective.” Petition (Paper 2) at 7–8 (citing Ex. 1001, 1:25–38).

- The method of claim 39 “is particularly applicable to high volume (bulk) mail users such as credit card companies,” but “is also applicable to any mail user who experiences and must deal with quantities of returned mail each month.”

*Id*. at 8 (citing Ex. 1001, 2:60–65).

# USPS Has Standing to Bring CBM Review of the ’548 Patent

- RMI sued USPS for patent infringement; thus, USPS has standing to bring CBM
- RMI does not dispute that claim 39 recites subject matter that is financial in nature
- RMI incorrectly argues that the ’548 Patent is a technological invention; the ’548 Patent is not a technological invention

# The ’548 Patent is Not a Technological Invention

Mere recitation of known technologies, such as **computer hardware**, **communication or computer networks**, software, memory, **computer-readable storage medium**, **scanners**, display devices or databases, or specialized machines, such as an ATM or point of sale device typically do not render a patent a “technological invention.”

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48763-64 (Aug. 14, 2012).

The ’548 Patent discloses that encoding and decoding were old and well-known at the time the application leading to the ’548 Patent was filed.

Institution Decision (Paper 11) at 14 (citing ’548 Patent (Ex. 1001), 3:11–15).

# Claim Construction

# Claim Construction is Preliminary at Institution

It is well established that the Board's claim construction is not final, and "is reviewable in light of both parties' subsequent briefings and oral argument."

*Facebook, Inc., LinkedIn Corp., Twitter, Inc., v. Software Rights Archive, LLC*, IPR2013-00481 at 33 (PTAB Jan. 29, 2015) (Paper 54).

"The construction of claim terms in a Decision to Institute is not final, and is reviewable in light of both parties' subsequent briefings and oral arguments."

*Facebook, Inc., LinkedIn Corp., Twitter, Inc., v. Software Rights Archive, LLC*, IPR2013-00481 at 33 (PTAB Jan. 29, 2015) (Paper 54).

## RMI Arguments Supports USPS Claim Construction Under the BRI

- USPS  agrees with the Board's claim construction but maintains that the constructions of "decode" and "detect" are not the Broadest Reasonable Interpretations (BRI).
- The Board should adopt the USPS's constructions as the BRI for "decode" and "detector" because, the Board now has information that it did not previously when it made its constructions, RMI's own arguments.

# USPS Constructions Are the Broadest Reasonable Interpretation

- The BRI of “decoding” is “to convert into intelligible form”
- The BRI of “detector” is “one who detects”

RMI’s own arguments supports the above constructions. In view of the new material, RMI’s Response (Paper 21), before the Board USPS respectfully ask the Board to adopt the above constructions.

# RMI Agrees "Decodes" Means "Converts"

## RMI's Own Words:

> The "optical scanner is the key hardware that **converts (decodes)** the information encoded." RMI Response (Paper 21) at 12 (emphasis added).

- USPS maintains that the BRI of "decode" is "to convert into intelligible form."
- As Dr. Lubenow explained, the Postal Carrier, even before the CFS Unit, decodes the ACS Endorsement and Participant Code to determine whether the sender wants a corrected address provided following the four pages of information required to process one of the Ancillary Service Endorsements.

Dr. Lubenow Deposition (Ex. 1023) at 156-159.

# RMI Agrees a Device is Not Required For a "First Detector"

## RMI's Own Words:

"**After the scanning stage**, the process for providing updated address information **now becomes electronic/computerized**."

RMI Response (Paper 21) at 12-13 (emphases added).

- RMI does not dispute that *1997 ACS* detects. RMI broadly argues the claims require complete electronic processing. But this is incorrect.

RMI Response (Paper 21) at 69-71.

- Dr. Lubenow explained that a carrier detects the Ancillary Service Endorsements, even before the CFS Units, and detects the code and processes the mail piece accordingly.

Dr. Lubenow Deposition (Ex. 1023) at 156-159.

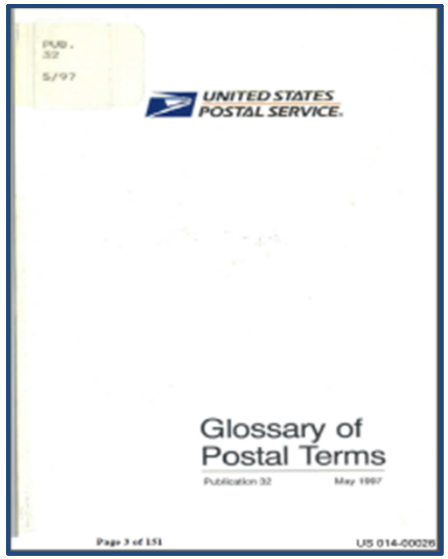
The Board has preliminary found that "decoding…does not necessarily require an electronic means."

Institution Decision (Paper 11) at 14.

# Glossary of Postal Terms, Published 1997

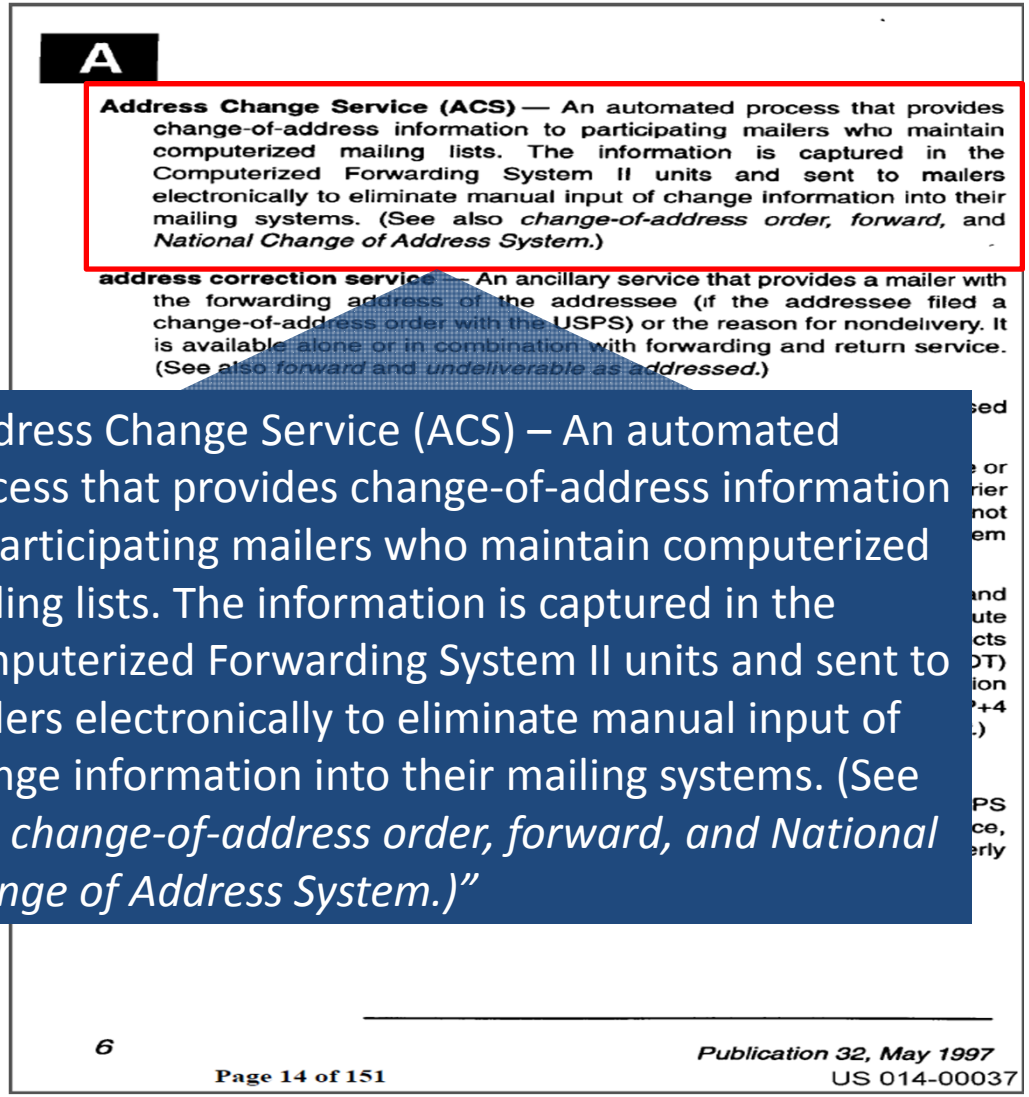
# Glossary of Postal Terms, Published 1997

- Address Change Service (ACS)
- Computerized Forwarding System II (CFS)
- Nixie
- Returned Mail
- Undeliverable-as-Addressed




Glossary of Postal Terms (Ex. 1027)

# Glossary of Postal Terms, Published 1997



**A**

**Address Change Service (ACS)** — An automated process that provides change-of-address information to participating mailers who maintain computerized mailing lists. The information is captured in the Computerized Forwarding System II units and sent to mailers electronically to eliminate manual input of change information into their mailing systems. (See also *change-of-address order, forward,* and *National Change of Address System.*)

**address correction service** — An ancillary service that provides a mailer with the forwarding address of the addressee (if the addressee filed a change-of-address order with the USPS) or the reason for nondelivery. It is available alone or in combination with forwarding and return service. (See also *forward* and *undeliverable as addressed.*)

6

Publication 32, May 1997

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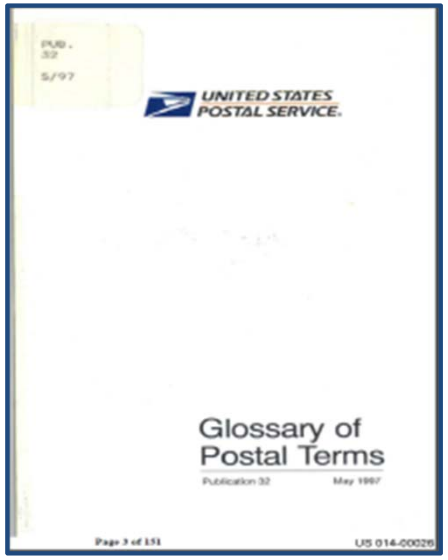
"Address Change Service (ACS) – An automated process that provides change-of-address information to participating mailers who maintain computerized mailing lists. The information is captured in the Computerized Forwarding System II units and sent to mailers electronically to eliminate manual input of change information into their mailing systems. (See also *change-of-address order, forward, and National Change of Address System.)*"




Glossary of Postal Terms (Ex. 1027) at 14.

# Glossary of Postal Terms, Published 1997

C

**commercial mailing agent (CMA)** — A private third party that engages in a principal-agent relationship to mail bulk business mail.

**commercial mail receiving agency (CMRA)** — A private business that acts as the mail-receiving agent for specific clients. The business must be registered with the post office responsible for delivery to the CMRA.

"Computerized Forwarding System II (CFS) – A centralized or computerized address label-generating operation that forwards the mail to customers who have moved and filed Form 3575, *Change of Address Order*. (See also *markup* and *undeliverable as addressed*.)"

development, [illegible] initiatives at USPS.

**computer-assisted keyboard training (CAKT)** — A method of using computer simulation to teach machine mail sorting.

**computer-assisted scheme training (CAST)** — A means of providing scheme training to and testing of manual distribution clerks through computer graphic representation of sortation items.

**Computerized Forwarding System II (CFS II)** — A centralized or computerized address label-generating operation that forwards the mail to customers who have moved and filed Form 3575, *Change of Address Order*. (See also *markup* and *undeliverable as addressed*.)

**Computerized On-Site Data Entry System (CODES)** — Automation of major USPS statistical programs that are designed to attribute costs to each mail class. Data and voice communications are used for data collection and associated field administrative functions.

*Glossary of Postal Terms* 25

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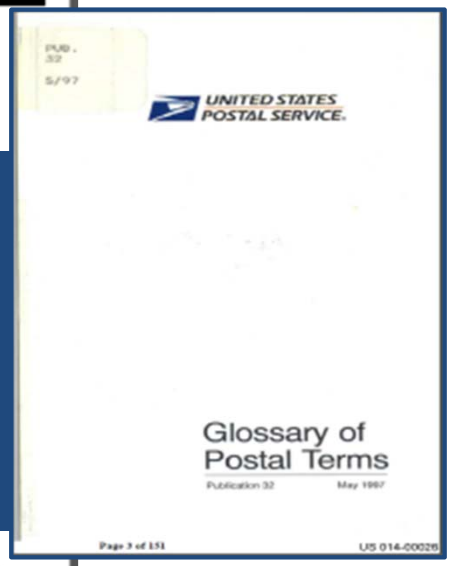
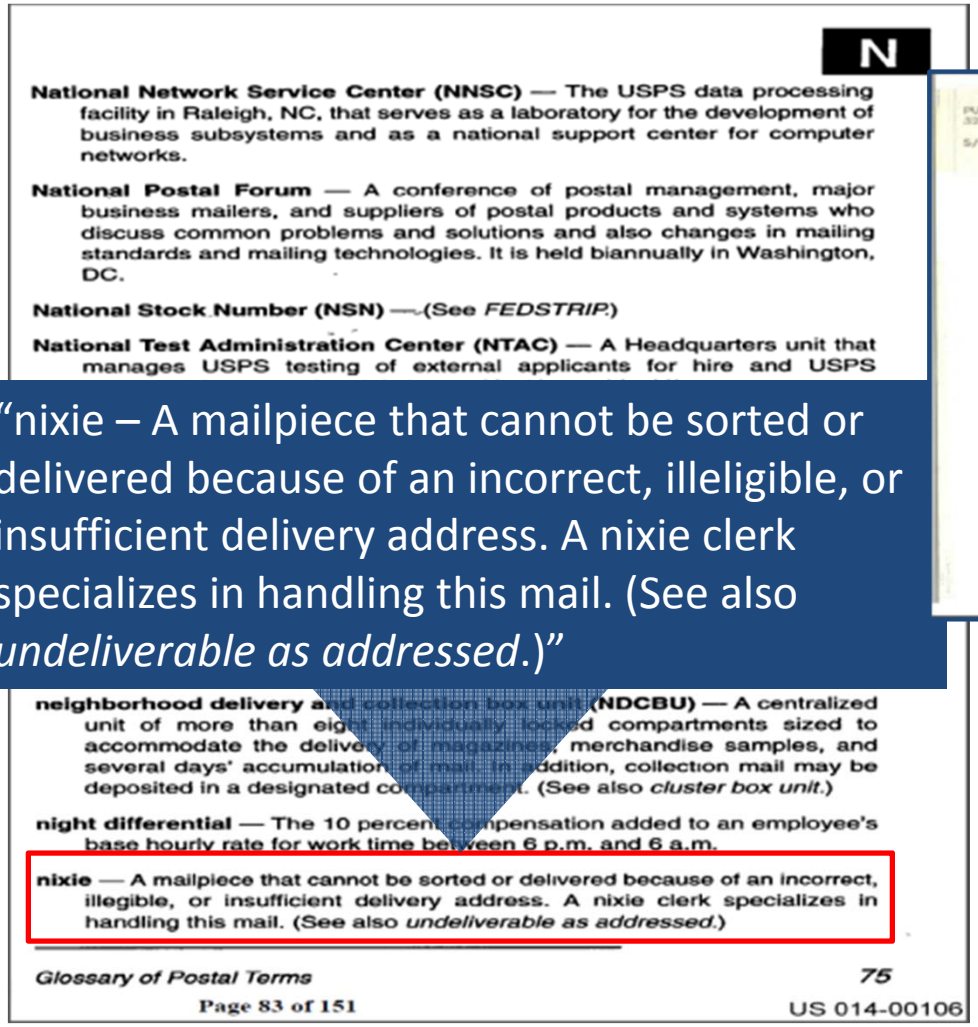



Glossary of Postal Terms (Ex. 1027) at 33.

# Glossary of Postal Terms, Published 1997



N

**National Network Service Center (NNSC)** — The USPS data processing facility in Raleigh, NC, that serves as a laboratory for the development of business subsystems and as a national support center for computer networks.

**National Postal Forum** — A conference of postal management, major business mailers, and suppliers of postal products and systems who discuss common problems and solutions and also changes in mailing standards and mailing technologies. It is held biannually in Washington, DC.

**National Stock Number (NSN)** — (See *FEDSTRIP.*)

**National Test Administration Center (NTAC)** — A Headquarters unit that manages USPS testing of external applicants for hire and USPS

"nixie – A mailpiece that cannot be sorted or delivered because of an incorrect, illeligible, or insufficient delivery address. A nixie clerk specializes in handling this mail. (See also *undeliverable as addressed*.)"

**neighborhood delivery and collection box unit (NDCBU)** — A centralized unit of more than eight [illegible] compartments sized to accommodate the delivery of magazines, merchandise samples, and several days' accumulation of mail. In addition, collection mail may be deposited in a designated compartment. (See also *cluster box unit.*)

**night differential** — The 10 percent compensation added to an employee's base hourly rate for work time between 6 p.m. and 6 a.m.

**nixie** — A mailpiece that cannot be sorted or delivered because of an incorrect, illegible, or insufficient delivery address. A nixie clerk specializes in handling this mail. (See also *undeliverable as addressed.*)

*Glossary of Postal Terms* 75

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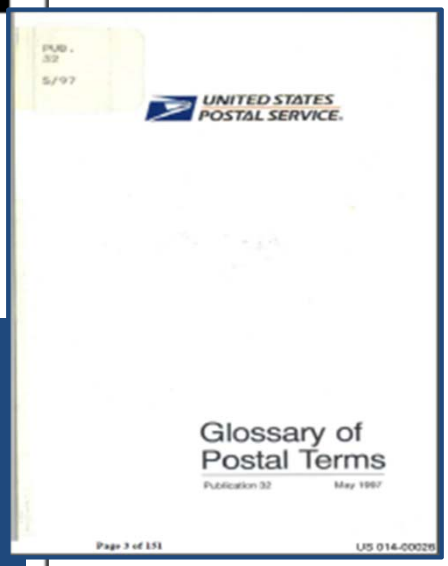

UNITED STATES POSTAL SERVICE.

Glossary of Postal Terms

Publication 32 May 1997

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Glossary of Postal Terms (Ex. 1027) at 75.

# Glossary of Postal Terms, Published 1997

**R**

**restricted matter** — Any item on which certain mailing restrictions have
imposed for legal reasons other than risk of harm to persons or pro
involved in moving the mail and that require specific endorsements
markings. Examples include intoxicating liquors, abortive or contrace
devices, odd-shaped items in envelopes, motor vehicle master
locksmithing devices as well as odor-producing materials, certain li
and powders, and battery-powered devices. (Compare with *hazar
matter* and *perishable matter.*)

**Retail Analysis Program (RAP)** — A program to monitor customer t
transactions, and other retail operations. Information from pro
surveys aids management decisions in areas such as staffing, work
facility location, and service requirements.

**retail facility** — A postal unit (a post office and its subordinate units as w
military post offices) that sells postage stamps and provides other p

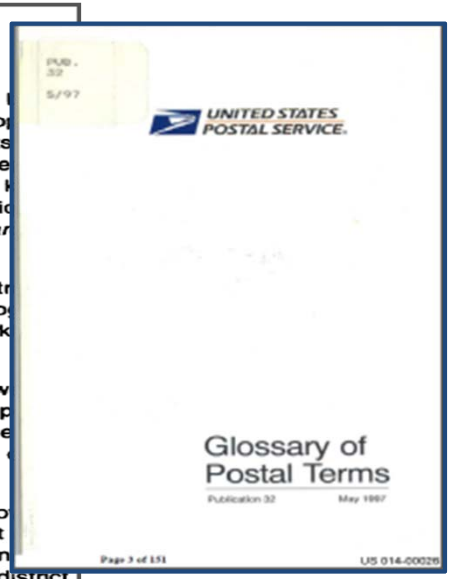
**retrace** — The part of a rural route traversed twice by the rural carrier. To travel past the part of the route already served.

**return address** — A mailpiece element that is usually placed in the upper left corner of the mailpiece to indicate the address of the sender. This address indicates where the sender wants the mail returned if it is undeliverable and where the sender will pay any fee due for that mail. (See also *undeliverable as addressed.*)

**return mail** — Mail that must be sent in the opposite direction for proper dispatch. (Also called *turnback mail.*)

100 *Publication 32, May 1997*
Page 108 of 151 US 014-00131

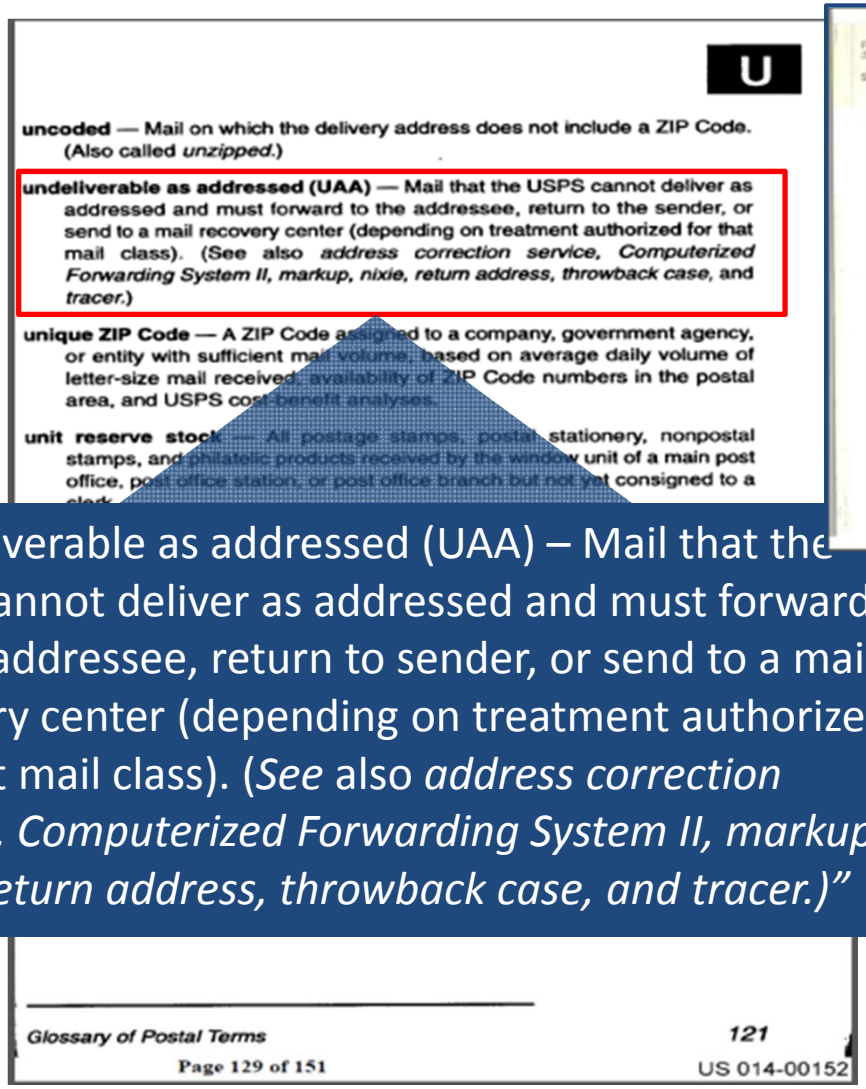
"return mail – Mail that must be sent in the opposite direction for proper dispatch. (Also called *turnback mail.*)"




Glossary of Postal Terms (Ex. 1027) at 108.

UNITED STATES POSTAL SERVICE.

# Glossary of Postal Terms, Published 1997



U

**uncoded** — Mail on which the delivery address does not include a ZIP Code. (Also called *unzipped.*)

**undeliverable as addressed (UAA)** — Mail that the USPS cannot deliver as addressed and must forward to the addressee, return to the sender, or send to a mail recovery center (depending on treatment authorized for that mail class). (See also *address correction service, Computerized Forwarding System II, markup, nixie, return address, throwback case,* and *tracer.*)

**unique ZIP Code** — A ZIP Code assigned to a company, government agency, or entity with sufficient mail volume, based on average daily volume of letter-size mail received, availability of ZIP Code numbers in the postal area, and USPS cost-benefit analyses.

**unit reserve stock** — All postage stamps, postal stationery, nonpostal stamps, and philatelic products received by the window unit of a main post office, post office station, or post office branch but not yet consigned to a

*Glossary of Postal Terms* 121

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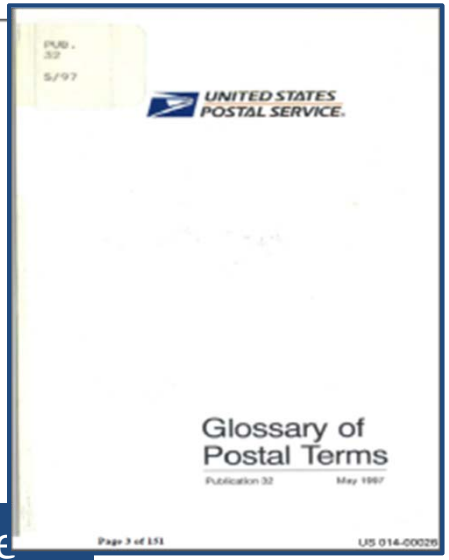

UNITED STATES POSTAL SERVICE.

Glossary of Postal Terms

Publication 32 May 1997

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"undeliverable as addressed (UAA) – Mail that the USPS cannot deliver as addressed and must forward to the addressee, return to sender, or send to a mail recovery center (depending on treatment authorized for that mail class). (*See* also *address correction service, Computerized Forwarding System II, markup, nixie, return address, throwback case, and tracer.)"*

Glossary of Postal Terms (Ex. 1027) at 129.

# Section 101

All Claims Ineligible for Patent Protection

# § 101 Framework

"Whoever invents or discovers any new and useful ***process***, ***machine***, ***manufacture***, or ***composition of matter***, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

35 U.S.C. § 101 (emphasis added).

Excluded from patent protection: "laws of nature, natural phenomena, and abstract ideas."

*Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014);
*Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012);
*Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

# A Two-Part Test for Patent Eligibility

(1) "First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts [e.g., laws of nature, natural phenomena, or abstract ideas]," and

(2) "[i]f so, we then ask, [w]hat else is there in the claims before us?"

*Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014);
*Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293-94 (2012).

"We have described step two of this analysis as a search for an '***inventive concept***'– i.e., an element or combination of elements that is 'sufficient to ensure that the patent in practice amounts to significantly more than a patent on the [ineligible concept] itself.'"

*Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014) (emphasis added);
*Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012).

# Conventional Computer Functionality Is Not Meaningful Limitation

"Simply appending conventional steps, specified at a high level of generality,' [is] not 'enough' to supply an 'inventive concept.'"

*Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2357 (2014).

"We have held that mere '[data-gathering] step[s] cannot make an otherwise nonstatutory claim statutory.'"

*CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (quoting *In re Grams*, 888 F.2d 835, 840 (Fed. Cir. 1989)) (alteration in original).

Moreover, … even if some physical steps are required to obtain information from the database (e.g., entering a query via a keyboard, clicking a mouse), such data-gathering steps cannot alone confer patentability."

*CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011).

# Conventional Computer Functionality Is Not Meaningful Limitation

"The computer functionality is generic—indeed, quite limited: a computer receives a request for a guarantee and transmits an offer of guarantee in return . . . **That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive**."

*buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (emphasis added).

# Claims 39-44 Should Be Cancelled Under § 101

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- RMI Cannot Import Language to Overcome Invalidity
- The Purpose of the ’548 Patent is Automating an Abstract Goal
- RMI Mischaracterizes the Importance of “Encoding”
- Changing From One Form to Another Is Not Enough
- RMI Does Not Create a Novel Method For Decoding

# RMI Cannot Import Language to Overcome Invalidity

RMI argues that the claims require "encoded data" but RMI's own expert states otherwise:

RMI's Expert, Dr. Scott Nettles

"Essentially, [the '548 patent] is a pipeline…The first stage of this pipeline (**which is not claimed**) takes mail pieces that have been **encoded with whether the sender wants corrected addresses** as input."

Dr. Nettles Declaration (Ex. 2015) at ¶ 52.

RMI's expert alleges the claims are a "technological improvement" based on language not recited in the claims. But RMI cannot overcome invalidity by importing language not recited in its claims.

Dr. Nettles Declaration (Ex. 2015) at ¶ 52.

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

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- Changing From One Form to Another Is Not Enough
- RMI Does Not Create a Novel Method For Decoding

# The Purpose of the ’548 Patent is Automating an Abstract Goal

Purpose of the ’548 patent pipeline is to support an abstract goal of “automating the mailing address updating process.”

Dr. Nettles Declaration (Ex. 2015) at ¶ 52.

## RMI’s Expert, Dr. Scott Nettles

- “Looking at the ‘548 patent, its architecture is simple (which is desirable) and is specifically designed to support automating the address updating process.” Dr. Nettles Declaration (Ex. 2015) at ¶ 52.
- “This pipeline is purposely designed to support the high-level goal of automating the mailing address updating process.” Dr. Nettles Declaration (Ex. 2015) at ¶ 55.
- “[T]he ‘548 patent claims are … centered on the automated processing of return mail” Dr. Nettles Declaration (Ex. 2015) at ¶ 40.

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- RMI Cannot Import Language to Overcome Invalidity
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- Changing From One Form to Another Is Not Enough
- RMI Does Not Create a Novel Method For Decoding

# RMI Mischaracterizes the Importance of "Encoding"

*The IRIS* Court was not evaluating whether the claims meet patent eligibility standards set forth in *Mayo* and *Alice* when it discussed the "benefit" of the "seal encoding.".

- RMI mischaracterizes that the Federal Circuit has "recognized that encoded information processing can create a technological advantage or benefit" in *IRIS Corp. v. Japan Airlines Corp.*

RMI Response (Paper 21) at 34.

- In *IRIS*, the Court was trying to determine whether the use of the "seal encoding" system was "for the government."
- "A use is 'for the Government' if it is 'in furtherance and fulfillment of a stated Government policy' which serves the Government's interests and which is 'for the Government's benefit.'"

*IRIS Corp. v. Japan Airlines Corp.*, 769 F.3d 1359, 1362 (Fed. Cir. 2014).

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

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- The Purpose of the ’548 Patent is Automating an Abstract Goal
- RMI Mischaracterizes the Importance of “Encoding”
- Changing From One Form to Another Is Not Enough
- RMI Does Not Create a Novel Method For Decoding

# Changing From One Form to Another Is Not Enough

RMI argues its claims are patent eligible because they "change inaccurate address information into either accurate address information or a notice of inaccuracy." The claims simply do not recite this limitation; however, even if it did transforming from one form to another is not enough.

Transforming data from one form to another does not qualify as the kind of transformation that the Supreme Court in *Bilski* regarded as an important indicator of patent eligibility. *See CyberSource Corp. v. Retail Decisions, Inc.,* 654 F.3d 1366, 1375 (Fed. Cir. 2011) ("[T]he mere manipulation or reorganization of data ... does not satisfy the transformation prong.").

*Card Verification v. Citigroup, Docket No. 13 C 6339* (N.D. Ill. Sept. 29, 2014); *See CyberSource Corp. v. Retail Decisions, Inc.,* 654 F.3d 1366, 1375 (Fed.Cir.2011) ("[T]he mere manipulation or reorganization of data ... does not satisfy the transformation prong.").

UNITED STATES POSTAL SERVICE.

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

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- The Purpose of the ’548 Patent is Automating an Abstract Goal
- RMI Mischaracterizes the Importance of “Encoding”
- Changing From One Form to Another Is Not Enough
- RMI Does Not Create a Novel Method For Decoding

# RMI Does Not Create a Novel Method For Decoding

- RMI argues that the ’548 patent uses a combination of known machines to accomplish a novel method for the decoding and processing of return mail address information is sufficient to show that the ‘548 patent does not claim an abstract idea.

RMI Response (Paper 21) at 40.

- But the specification states that Portable Data File 417 (PDF417) is the most widely used 2-D barcode. developed by Symbol Technologies, Inc.
- RMI did not create a “novel method for [] decoding and processing of return mail address information.”

’548 Patent, 3:11-12.

# Claims 39-44 Should Be Cancelled Under § 102

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"
- Fulfillment Files are Stored Pursuant via a Computer
- Claims 39-44 Do Not Require a Barcode
- A Device is Not Required For "Detecting"
- *1997 ACS* Meets the Claimed "Arrangement"
- Returned Mail Data Records Include Corrected Addresses
- *1997 ACS* Endorsements Generates Electronic Notifications
- RMI Cannot Import Language to Overcome Invalidity

# *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"

- RMI incorrectly argues that *1997 ACS* does not disclose mail items that have been mailed and then come back to a post office facility.
- *1997 ACS* discloses "[w]hen a carrier receives a mail piece and it is undeliverable-as-addressed at the old address due to customer relocation, the mail piece…is **sent** by the postal employee to the CFS Unit[.]"

*1997 ACS* (Ex. 1004) at 5.

Dr. Joe Lubenow

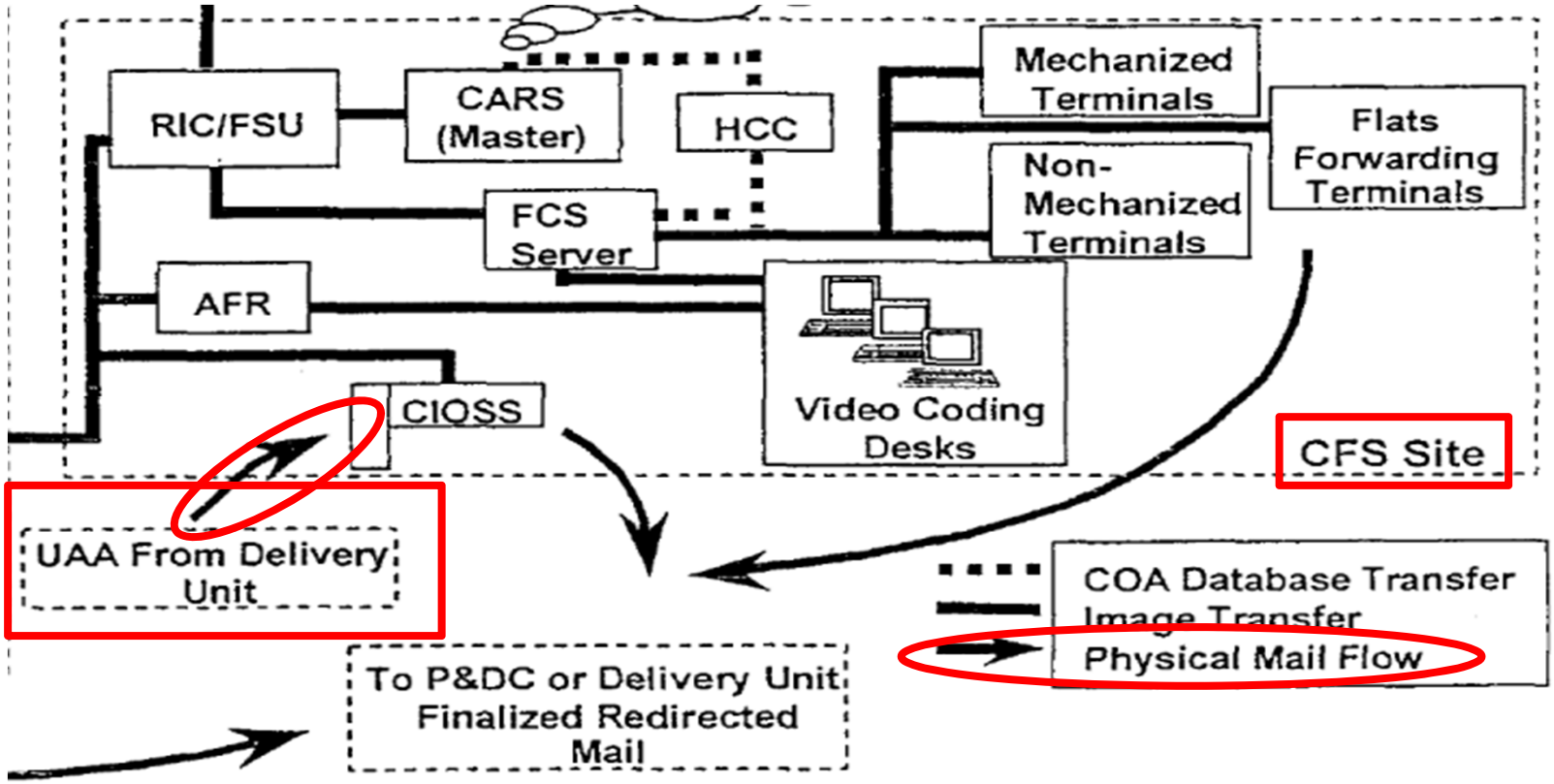
"In this instance 'sent' means to go 'back' from the Delivery Unit to a post office facility, in this case the CFS Unit…. My observations are supported by the USPS's Postal Automated Redirection System – The USPS Solution, dated May 1999." Shown on next slide.

Lubenow Supplemental Declaration (Ex. 1028) at 20 (citing Ex. 1026 at 6).

# *1997 ACS* Discloses "Return Mail Items"

Dr. Lubenow explained "sent" means to go "back" as supported by Ex. 1026 below showing UAA mail from Delivery Unit to CFS Site.

Lubenow Supplemental Declaration (Ex. 1028) at 20 (citing Ex. 1026 at 6).




Postal Automated Redirection System –The USPS Solution (Ex. 1026) at 6.

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"
- Fulfillment Files are Stored Pursuant via a Computer
- Claims 39-44 Do Not Require a Barcode
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- Returned Mail Data Records Include Corrected Addresses
- *1997 ACS* Endorsements Generates Electronic Notifications
- RMI Cannot Import Language to Overcome Invalidity

# Fulfillment Files are Stored Pursuant via a Computer

- RMI argues, incorrectly that *1997 ACS* does not disclose that the fulfillment file is stored pursuant to computer program instructions.
- ACS does require that "you develop your own matching software and configure your mailing address labels or address blocks to comply with the ACS format."

*1997 ACS* (Ex. 1004) at 4.

Dr. Joe Lubenow

"A person of ordinary skill would understand that this Fulfillment File (complete with its headers, field length, bit position, and bit length) would be stored by a computer program," (e.g. "stored pursuant to computer program instructions).

Lubenow Supplemental Declaration (Ex. 1028) at ¶ 38.

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"
- Fulfillment Files are Stored Pursuant via a Computer
- Claims 39-44 Do Not Require a Barcode
- A Device is Not Required For "Detecting"
- *1997 ACS* Meets the Claimed "Arrangement"
- Returned Mail Data Records Include Corrected Addresses
- *1997 ACS* Endorsements Generates Electronic Notifications
- RMI Cannot Import Language to Overcome Invalidity

# Claims 39-44 Do Not Require a Barcode

- RMI agrees that “barcodes” are only a suggestion not required or disclosed by Claims 39-44.

## RMI’s Own Words:

“The ’548 patent suggests using a barcode to encode this information.”

RMI Response (Paper 21) at 1-2 (citing Ex .1001 at 2:66-3:3).

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"
- Fulfillment Files are Stored Pursuant via a Computer
- Claims 39-44 Do Not Require a Barcode
- A Device is Not Required For a "First Detector"
- *1997 ACS* Meets the Claimed "Arrangement"
- Returned Mail Data Records Include Corrected Addresses
- *1997 ACS* Endorsements Generates Electronic Notifications
- RMI Cannot Import Language to Overcome Invalidity

# A Device is Not Required For a "First Detector"

- RMI argues in favor of USPS construction that "detect" can be performed by a person.
- RMI broadly argues the claims require complete electronic processing. But this is incorrect.

USPS Reply (Paper 22) at 10.

## RMI's Own Words:

"**After the scanning stage**, the process for providing updated address information **now becomes electronic/computerized**."

RMI Response (Paper 21) at 12-13 (emphases added).

The Board has preliminary found that "decoding…does not necessarily require an electronic means."

Institution Decision (Paper 11) at 14.

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"
- Fulfillment Files are Stored Pursuant via a Computer
- Claims 39-44 Do Not Require a Barcode
- A Device is Not Required For "Detecting"
- *1997 ACS* Meets the Claimed "Arrangement"
- Returned Mail Data Records Include Corrected Addresses
- *1997 ACS* Endorsements Generates Electronic Notifications
- RMI Cannot Import Language to Overcome Invalidity

# *1997 ACS* Meets the Claimed "Arrangement"

RMI cannot escape the plain language of their claims by importing limitations.

- RMI argues that *1997 ACS* does not anticipate, not because the elements are not disclosed, but because elements are not disclosed as "arranged in the claim." PO Response (Paper 21) at 65 (citing *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1370-71 (Fed. Cir. 2008)).
- RMI tries to extend its argument to creating the "output file" in claim 42.4, by arguing that this output file must be created before the determining step. See, e.g., Patent Owner Response (Paper 21) at 65.
- But, this order is not in the claim language. 42.4 recites "creating output data that includes a customer number of the sender and at least a portion of the decoded data;"

'548 Patent (Ex. 1002), 2:12-13.

# *1997 ACS* Meets the Claimed "Arrangement"

- RMI allegations are incorrect. *Net MoneyIN* involved an attempt to combine two distinct protocols from a single reference, which is not the case here. Rather, *1997 ACS* discloses all steps in a single example and the steps are disclosed as related to one another.

USPS Reply (Paper 22) at 14-15.

- The Board should reject RMI's attempt to save its claims by arguing that *1997 ACS* does not meet the non-claimed arrangements.

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"
- Fulfillment Files are Stored Pursuant via a Computer
- Claims 39-44 Do Not Require a Barcode
- A Device is Not Required For "Detecting"
- *1997 ACS* Meets the Claimed "Arrangement"
- Returned Mail Data Records Include Corrected Addresses
- *1997 ACS* Endorsements Generates Electronic Notifications
- RMI Cannot Import Language to Overcome Invalidity

# Returned Mail Data Records Include Corrected Addresses

- RMI argues that "returned mail data records [] are different from corrected addresses," but the '548 Patent describes "returned mail data records" as including corrected address data.

RMI Response (Paper 21) at 76.

- If a determination is made in decision block 302 that the sender wants to have correct addresses provided for the intended recipients, then the return mail application server then **sends the returned mail data records to an address update service bureau, such as the USPS NCOA address correction databases** or the databases provided by licensed service providers... **The addresses of the intended recipients are then updated** when possible based on information provided by the service bureau as indicated in output block 310. The **updated records are provided to the return mail service provider** as indicated in logic block 312. The **returned mail data records are then placed on the Internet website of the service provider or a dialup service for sender pickup** as indicated in logic block 314.

Ex. 1001 at 5:3-13 (emphases added).

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"
- Fulfillment Files are Stored Pursuant via a Computer
- Claims 39-44 Do Not Require a Barcode
- A Device is Not Required For "Detecting"
- *1997 ACS* Meets the Claimed "Arrangement"
- Returned Mail Data Records Include Corrected Addresses
- *1997 ACS* Endorsements Generates Electronic Notifications
- RMI Cannot Import Language to Overcome Invalidity

# *1997 ACS* Endorsements Generates Electronic Notifications

- RMI agrees that *1997 ACS* discloses electronic notifications by the endorsements.

RMI's Own Words:

> *"1997 ACS* describes two possible endorsements for the possibility of an electronic notification: 'Address Service Requested' and 'Change Service Requested.'"
>
> RMI Response (Paper 21) at 58.

# Claims 39-44 Should Be Cancelled Under §§ 101 and 102

- *1997 ACS* Discloses "Return Mail Items/Undeliverable Mail Items"
- Fulfillment Files are Stored Pursuant via a Computer
- Claims 39-44 Do Not Require a Barcode
- A Device is Not Required For "Detecting"
- *1997 ACS* Meets the Claimed "Arrangement"
- Returned Mail Data Records Include Corrected Addresses
- *1997 ACS* Endorsements Generates Electronic Notifications
- RMI Cannot Import Language to Overcome Invalidity

# RMI Cannot Import Language to Overcome Invalidity

RMI argues that the claims require that all "information is placed on the *actual mailpiece*." But the claims simply do not recite such a limitation.

## RMI's Expert, Dr. Scott Nettles

- "Indirection (or its lack) comes into play because the encoded information is placed *on the actual mailpiece*."

  Dr. Nettles Declaration (Ex. 2015) at ¶ 62 (emphasis added).

- "There are two important … concepts that work together to help the idea of *on-envelope* encoding act as an enabler: encoding and indirection (or lack thereof)."

  Dr. Nettles Declaration (Ex. 2015) at ¶ 58 (emphasis added).

RMI's expert opinion that *1997 ACS* does not anticipate is based on language imported by himself, namely, that all information "is placed on the actual mailpiece." The abstract idea claimed in Claims 39-44 do not recite such a requirement.

Dr. Nettles Declaration (Ex. 2015) at ¶ 62.

# RMI Cannot Import Language to Overcome Invalidity

RMI argues that the claims require that all "information is placed on the *actual mailpiece*." But the claims simply do not recite such a limitation.

It is well-established that "whether the asserted claims…are invalid for failure to claim statutory subject matter under 35 U.S.C. § 101, is a question of law[.]" *AT&T v. Excel Comm., Inc.*, 172 F.3d 1352, 1355 (Fed. Cir. 1999).

- "[illegible] information is placed *on the actual mailpiece*."

Dr. Nettles Declaration (Ex. 2015) at ¶ 62 (emphasis added).

- "There are two important … concepts that work together to help the idea of *on-envelope* encoding act as an enabler: encoding and indirection (or lack thereof)."

Dr. Nettles Declaration (Ex. 2015) at ¶ 58 (emphasis added).

RMI's expert opinion that *1997 ACS* does not anticipate is based on language imported by himself, namely, that all information "is placed on the actual mailpiece." The abstract idea claimed in Claims 39-44 do not recite such a requirement.

Dr. Nettles Declaration (Ex. 2015) at ¶ 62.

# RMI Cannot Import Language to Overcome Invalidity

RMI argues that the claims require that all "information is placed on the *actual mailpiece*." But the claims simply do not recite such a limitation.

Return Mail responds that claim 39 deals with "actual hard copy mail," and not just abstract ideas. Return Mail also argues that claim 39 does not rely merely on a computer to be patent-eligible. We do not agree with Return Mail.

Institution Decision (Paper 11) at 20 (citations omitted).

- "There are two important ... concepts that work together to help the idea of *on-envelope* encoding act as an enabler: encoding and indirection (or lack thereof)."

Dr. Nettles Declaration (Ex. 2015) at ¶ 58 (emphasis added).

RMI's expert opinion that *1997 ACS* does not anticipate is based on language imported by himself, namely, that all information "is placed on the actual mailpiece." The abstract idea claimed in Claims 39-44 do not recite such a requirement.

Dr. Nettles Declaration (Ex. 2015) at ¶ 62.

# USPS's Motion to Exclude

USPS Motion to Exclude Should be Granted

# Support of USPS Motion to Exclude

- RMI mischaracterizes Exhibit 2030
- Dr. Nettles Improperly Substitutes His Opinions for the Board
- RMI's Expert Opinions are Based Off Language Not in the Claims and Should be Excluded

# Exhibit 2030 is Not Relevant and Should be Excluded

- RMI continues to mischaracterize Exhibit 2030. RMI alleges that this exhibit "directly contradicts allegations made by Petitioner."

RMI Opposition (Paper 33) at 10.

- Nothing in Ex. 2030 relates to or contradicts that the CFS units in 1997 had scanners for scanning the mail piece.

*Change of Address Forms Processing System scanners (left) scan newly-designed Change of Address cards for employees at Remote Encoding Centers (right) to process.*

The equipment is part of the Change of Address Forms Processing System replacing mechanized terminals previously used to manually enter information.

Ex. 2030 actually states "*Change of Address Forms Processing System scanners (left) scan newly-designed Change of Address Cards*."
Ex. 2030 at 1 (Italics in original; emphasis added).

Engineering Program Director Raj Kumar states, "[t]he **cards** can be read by an optical character reader,"—not referring to the mail piece. Ex. 2030 at 2 (emphasis added).

USPS Opposition (Paper 37) at 3-4.

# Support of USPS Motion to Exclude

- RMI mischaracterizes Exhibit 2030
- Dr. Nettles Improperly Substitutes His Opinions for the Board
- RMI's Expert Opinions are Based Off Language Not in the Claims and Should be Excluded

# Dr. Nettles § 101 Should be Excluded

- RMI criticizes the USPS for not relying on its technical expert to support its § 101 arguments.
- Dr. Nettles testimony in paragraphs 37-95 should be excluded for providing a *legal opinion* based on his two-part test (of his own creation).

RMI's Expert, Dr. Scott Nettles

"First, [the patent] has an overall structure or 'architecture' that supports automation. Second, it has key technological enablers that support and enable the architecture."

Dr. Scott Nettles Declaration (Ex. 2015) at ¶ 50.

# Dr. Nettles § 101 Should be Excluded

- RMI criticizes the USPS for not relying on its technical expert to support its § 101 arguments.
- Dr. Nettles testimony in paragraphs 37-95 should

It is well-established that "whether the asserted claims…are invalid for failure to claim statutory subject matter under 35 U.S.C. § 101, is a question of law[.]" *AT&T v. Excel Comm., Inc.*, 172 F.3d 1352, 1355 (Fed. Cir. 1999).

RMI's Expert, Dr. Scott Nettles

"First, [the patent] has an overall structure or 'architecture' that supports automation. Second, it has key technological enablers that support and enable the architecture."

Dr. Scott Nettles Declaration (Ex. 2015) at 25.

# Support of USPS Motion to Exclude

- RMI mischaracterizes Exhibit 2030
- Dr. Nettles Improperly Substitutes His Opinions for the Board
- RMI's Expert Opinions are Based Off Language Not in the Claims and Should be Excluded

# RMI Cannot Import Language to Avoid Invalidity

RMI cannot escape the plain language of their claims by importing limitations. RMI's expert opinions are based off language not in the claims and should be excluded.

USPS Reply (Paper 22) at 5.

- RMI cannot point this Panel to one claim where it claims "information [is] placed on the face of the envelope that the sender wants address updates or not."

  Dr. Scott Nettles Declaration (Ex. 2015) at ¶ 57.

- RMI cannot point this Panel to one claim where it claims "encoding the sender's preferences is done by a creating a bar code with the information."

  Dr. Scott Nettles Declaration (Ex. 2015) at ¶ 59.

# RMI's Expert Opinions Are Based on Language Not in Claims

Dr. Nettles opinions that *1997 ACS* does not anticipate the '548 patent are based on imported language of his choosing.

RMI's Expert, Dr. Scott Nettles

- "[T]here is no possible way for a customer to encode information or data into a participant code given that the customer has nothing to do with its creation."
  Dr. Scott Nettles Declaration (Ex. 2015) at ¶ 102.
- "*1997 ACS* does not disclose any data being converted into the participant code."
  Dr. Scott Nettles Declaration (Ex. 2015) at ¶ 103.
- "Claim 39 is an electronic method of processing."
  Dr. Scott Nettles Declaration (Ex. 2015) at ¶ 109.

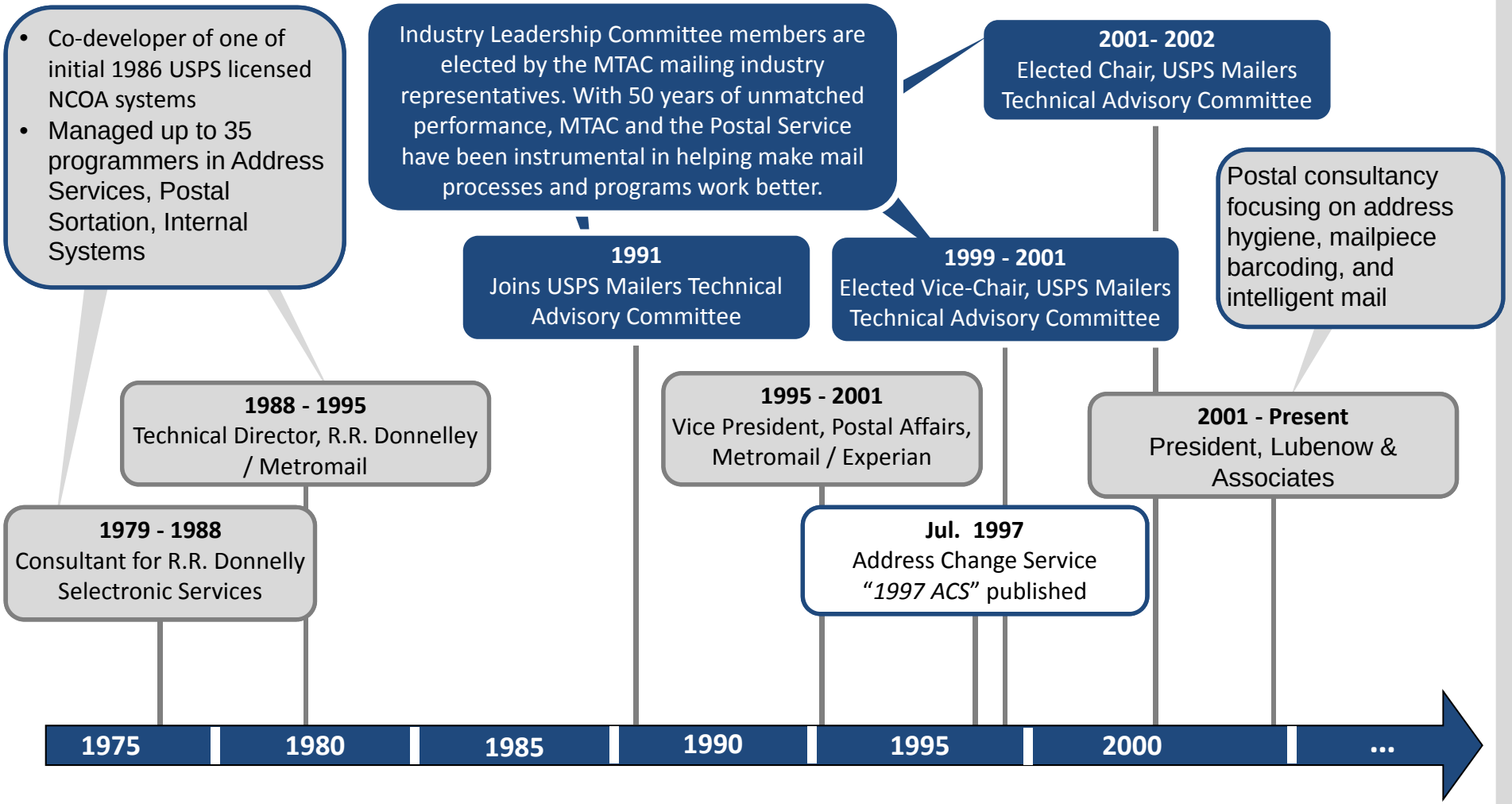
# RMI's Motion to Exclude

RMI's Motion to Exclude Should be Denied

# RMI's Motion to Exclude Should be Denied

- Dr. Lubenow Has 35 Plus Years of Postal Experience
- RMI Attempts to Mischaracterize Dr. Lubenow's Testimony
- Dr. Lubenow's Demonstrative Present Little Danger of Unfair Prejudice
- RMI Fails to Show One Example of Dr. Lubenow's Supplemental Declaration Presenting "New" Arguments

# Dr. Joe Lubenow 35 Plus Years of Postal Experience




Lubenow Updated CV (Ex. 2008).

# RMI's Motion to Exclude Should be Denied

- Dr. Lubenow Has 35 Plus Years of Postal Experience
- RMI Attempts to Mischaracterize Dr. Lubenow's Testimony
- Dr. Lubenow's Demonstrative Present Little Danger of Unfair Prejudice
- RMI Fails to Show One Example of Dr. Lubenow's Supplemental Declaration Presenting "New" Arguments

# RMI Attempts to Mischaracterize Dr. Lubenow's Testimony

RMI attempts to mislead the Board and mischaracterize Dr. Lubenow's testimony. RMI would like you to believe that Dr. Lubenow states he does not "know the internal details of the CFS operation."

But Dr. Lubenow was asked:

**Q**: But would [fulfillment files] have been created in hard copy and then transferred to tape or some kind of disk, or were they actually created in electronic form to begin with, in 1997?

**A**: I don't know the internal details of the CFS operation.

Lubenow Deposition (Ex. 1023) at 145.

Never did Dr. Lubenow state that he did not "know the internal details of the CFS operation" as it relates to "what the prior art contained, including the operation of CFS units with respect [to] the disclosures of the *1997 ACS*," as falsely suggested by RMI.

PO Motion to Exclude at 5.

# RMI's Motion to Exclude Should be Denied

- Dr. Lubenow Has 35 Plus Years of Postal Experience
- RMI Attempts to Mischaracterize Dr. Lubenow's Testimony
- Dr. Lubenow's Demonstrative Present Little Danger of Unfair Prejudice
- RMI Fails to Show One Example of Dr. Lubenow's Supplemental Declaration Presenting "New" Arguments

# Dr. Lubenow's Demonstrative Facilitated His Deposition

- Merely a reorganization of existing material already in the record (much of which RMI has not challenged)
- The annotations were created at the direction of Dr. Lubenow to facilitate his oral cross-examination by RMI

USPS Opposition (Paper 34) at 9.

The Board has found little danger of unfair prejudice where an expert prepared "excerpts and annotations [that] are demonstrative in nature and may been useful in focusing [the witness's] attention to specific features [] and, thus, facilitated oral examination of the witness."

*See, Intri-Plex Technologies, Inc. and MMI Holdings, LTD., v. Saint-Gobain Performance Plastics Rencol Limited*, IPR2014-00309 at 18 (PTAB Mar. 23, 2014) (Paper 83).

# RMI's Motion to Exclude Should Be Denied

- Dr. Lubenow Has 35 Plus Years of Postal Experience
- RMI Attempts to Mischaracterize Dr. Lubenow's Testimony
- Dr. Lubenow's Demonstrative Present Little Danger of Unfair Prejudice
- RMI Fails to Show One Example of Dr. Lubenow's Supplemental Declaration Presenting "New" Arguments

# Dr. Lubenow's Supplemental Declaration Is Proper

RMI improperly seeks to exclude ¶¶ 11-21 and 26 because RMI alleges they "present new arguments." But RMI does not present one example of any "new arguments."

PO Motion to Exclude at 11.

A motion to exclude is not a mechanism to argue that a reply contains new arguments or relies on evidence necessary to make a *prima facie* case.

*Microsoft v. SurfCast*, IPR2013-00292 at 53 (PTAB Oct. 14, 2014) (Paper 33).

Whether a reply contains arguments or evidence that are outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to our determination.

*Microsoft v. SurfCast*, IPR2013-00292 at 53 (PTAB Oct. 14, 2014) (Paper 33).

# Dr. Lubenow's Supplemental Declaration Is Proper

RMI improperly seeks to exclude ¶¶ 11-21 and 26 because RMI alleges they "present new arguments."

Even if RMI's allegations are not improper under 37 C.F.R. § 42.23(b), "Dr. Lubenow's Supplemental Declaration appropriately responded to new arguments presented in RMI's response and Dr. Nettles declaration."

Petitioner's Opposition to Patent Owner's Motion to Exclude at 14.

Whether a reply contains arguments or evidence that are outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to our determination.

*Microsoft v. SurfCast*, IPR2013-00292 at 53 (PTAB Oct. 14, 2014) (Paper 33).

UNITED STATES POSTAL SERVICE.

# Dr. Lubenow's Supplemental Declaration Is Proper

- RMI fails to show one example of Dr. Lubenow's Supplemental Declaration presenting "new" arguments

RMI Motion (Paper 25); *see also* RMI Reply Motion (Paper 36).

- Dr. Lubenow's supplemental declaration appropriately responded to new arguments presented in RMI's response and Dr. Nettles declaration

USPS Opposition (Paper 34) at 14.