Paper No. __________
CBM2014-00116

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

Petitioners,

v.

RETURN MAIL, INC.

Patent Owner.

Case: CBM2014-00116
Patent: 6,826,548

PETITIONER'S SUPPLEMENTAL BRIEF

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Table of Contents

I. *ALICE* BUILDS AND EXPANDS THE *MAYO* TEST FOR PATENT INELIGIBILITY 2

II. THE CLAIMS AT ISSUE BY RMI ARE NOT PATENT ELIGIBLE UNDER *ALICE* 3

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Table of Authorities

Page(s)

FEDERAL CASES

Alice Corporation v. CLS Bank International,
573 U. S. ___ (2014) .... passim

Diamond v. Diehr,
450 U.S. 175 (1981) 5

Mayo Collaborative Services v. Prometheus Labs., Inc.,
132 S. Ct. 1289 (2012) 2, 5

PATENT AND TRADEMARK OFFICE DECISIONS

Anova Food LLC v. Kowalski,
IPR2013-00114, Paper 11 (June 25, 2013) 1

FEDERAL STATUTES

35 U.S.C. § 101 .... passim

REGULATIONS

37 C.F.R. § 42.5(a) 11

37 C.F.R. § 42.301(b) 4

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Pursuant to the Board's July 25, 2014 Order, Petitioner United States Postal Service (USPS) hereby submits its supplemental brief addressing the *Alice* issues.[1]

Claims 39-44 at issue merely instruct a practitioner to implement the abstract idea of "relaying mailing address data" on a generic computer, which is just like the ineligible patent claims in *Alice* ("here the representative claim does no more than instruct the practitioner to implement the abstract idea of intermediate settlements on a generic computer"). *Alice*, Slip. op. 3. Specifically, in its Response, RMI asserts that its claims pass muster under *Alice* because they "deal" with "actual hard copy mail." (Response at 26.) But, how can a generic process for "deal[ing]" with "hard copy mail" be patent eligible? RMI is wrong on several levels, at least because the claims of the '548 patent are all limited to relaying data on a generic computer. In a direct affront to the Supreme Court's guidance in *Alice*, RMI seeks to preclude others from practicing the abstract idea of "relaying mailing address data." Indeed, even if the claims are directed to "hard copy mail" (which they are not), generic "relaying mailing address data" for "hard copy mail" is also abstract and not patent eligible. Therefore, like the ineligible claims in *Alice*, RMI is grasping at any physical element ("deal[ing]" with "hard copy mail") in a vain effort to save its claims under § 101.

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[1] The Board may consider supplemental briefing on institution. *Anova Food LLC v. Kowalski*, IPR2013-00114, Order, Paper No. 11 at 4 (June 25, 2013) (considering supplemental briefing on real party in interest); *see also* 37 CFR § 42.5 (a).

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I. *Alice* Builds and Expands the *Mayo* Test for Patent Ineligibility

Alice adds to the existing jurisprudence in two ways—and thereby demonstrates that claims 39-44 are not patent eligible under § 101. ***First***, *Alice* confirms that the *Mayo Collaborative Services v. Prometheus* test should be used to determine if abstract ideas are ineligible under § 101. *Id.* at 7. Building on *Mayo*, the Supreme Court in *Alice* reiterated that abstract ideas are not patentable, because granting a monopoly over an abstract idea threatens innovation. And, to be patentable, a claim that recites an abstract idea *must include* "additional features" to ensure "that the [claim] is more than a drafting effort designed to monopolize the [abstract idea]." *Id.* at 11 (citation omitted). ***Second***, *Alice* also confirms that the same two-step *Mayo* analysis should be applied to all types of claims—method, system, and media claims.[2] *Id.* at 16. Thus, for all types of claims, the Supreme Court in *Alice* applies the single two-step framework from *Mayo* to assess the existence of any "additional features": (1) whether the claims at issue are "directed to one of those patent ineligible concepts," such as an abstract idea, and (2) if so, whether the claim has an "inventive concept"—an element or combination of elements "sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself." *Id.* at 7 (citation omitted). For corresponding system and media claims, if *nothing of substance* is added to

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[2] *Accord* USPTO Preliminary Examination Instructions, June 25, 2014, at 2 (*Alice* "establishes that the same analysis should be used for all categories of claims . . .").

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