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 PRELIMINARY SURREPLY

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I. *Alice* merely reiterates previous U.S. Supreme Court holdings.

Alice does not establish a "new standard," but instead applies an existing standard.[1] As explained in the Preliminary Response, the two-part analysis for evaluating patent eligibility in *Alice* is set forth in *Mayo Collaborative Svcs. v. Prometheus Labs., Inc.*, 132 S.Ct. 1289 (2012). (Paper 6 at 22-25). The legal standards and holdings expressed in *Alice* date back at least to Supreme Court decisions from the 1970's. Petitioner already has relied on *Mayo* and the other Supreme Court holdings; Petitioner's Reply adds nothing substantive to the § 101 discussion. Petitioner essentially repeats its Petition arguments, which still fail because they ignore many of the claims' limitations. *LinkedIn Corp. v. AvMarkets Inc.*, CBM2013-00025, Paper 13 at 19 (PTAB Nov. 12, 2013). Moreover, *Alice* reiterates that at "some level, 'all inventions…embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas,'" and thus, "an invention is not rendered ineligible for patent simply because it involves an abstract concept." *Alice*, 134 S.Ct. at 2354. Applications of such concepts to a new and useful end remain eligible, as they were before *Alice*, for patent protection. *Id*. Claims 39-44 are patent eligible.

II. Claims 39-44 are patent eligible under § 101.

In its Preliminary Response, Patent Owner showed in detailed discussions that Claims 39-44 each contains meaningful limitations that are significantly more than just an abstract idea and that these claims do not simply rely on a computer to be patent

[1] *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S.Ct. 2347 (2014).

eligible. (Paper 6 at 22-36). Petitioner's Reply is nothing more than a mischaracterization of *Alice's* meaning combined with a scrambled hash of unsupported assertions already made in the Petition.

Claim 39 is a method claim "for processing returned mail items sent by a sender to an intended recipient." It recites three elements, and each contains meaningful limitations that are significantly more than just an abstract idea. Petitioner does not address any of these limitations in its Reply. Further, its assertion that "hard copy mail" is not a part of Claim 39 is incorrect in view of the limitation "returned mail items." Also, Claim 39's "decoding" limitation clearly establishes that it passes the machine-or-transformation test. Claim 40 is directed to a "computer program product residing on a computer readable medium comprising instructions for causing a computer" to perform certain steps. Petitioner continues to ignore Claim 40's second and third elements completely, and it ignores most of the limitations associated with the first and fourth elements for "stor[ing] decoded information" and "transmitting the updated address." Likewise, for Claim 41, Petitioner discusses the "detector" and "processor," but fails to address the limitations associated with these elements, as required. Claim 42 has seven elements, and each one contains many meaningful limitations none of which Petitioner addressed. Petitioner merely asserts

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