

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.

CBM2014-00116
Patent 6,826,548 B2

Before KEVIN F. TURNER, BARBARA A. BENOIT, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*

ORDER
Termination of Proceeding
37 C.F.R. § 42.71, 42.72

Previously, the United States Postal Service and United States of America, as represented by the Postmaster General (“Petitioner”) filed a Petition requesting a covered business method patent review of claims 39–44 of U.S. Patent No. 6,826,548 B2 (Ex. 1001), pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”). Paper 2. In response, Return Mail, Inc. (“Patent Owner”) filed a Patent Owner Preliminary Response. Paper 6. On October 16, 2014, we instituted a transitional covered business method patent review (Paper 11) based upon Petitioner’s assertion that the challenged claims are unpatentable based on multiple grounds of unpatentability. Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 21) and Petitioner filed a Reply (Paper 22) to Patent Owner’s Response. An oral hearing was held on May 12, 2015, and we subsequently issued a Final Written Decision (Paper 41), on October 15, 2015, ordering that all challenged claims were determined to be unpatentable. Patent Owner then appealed that Decision to the Court of Appeals for the Federal Circuit on December 11, 2015 (Paper 42).

The Court of Appeals for the Federal Circuit affirmed the Decision on August 28, 2017 (*Return Mail, Inc. v. U.S. Postal Service*, 868 F.3d 1350 (Fed. Cir. 2017)), determining, in part, that Petitioner had not failed to meet the statutory standing requirements to petition for a transitional covered business method patent review because Petitioner was a “person” per AIA § 18(a)(1)(B). *Return Mail*, 868 F.3d at 1356, 1365–66, 1372–76. Patent Owner appealed to the Supreme Court of the United States, which held that a federal agency is not a “person” able to seek review of the validity of a patent post-issuance pursuant to the three types of administrative review proceedings set forth in the Leahy-Smith America Invents Act of 2011 (AIA). *Return Mail, Inc. v. U.S. Postal Service*, 139 S. Ct. 1853 (2019). The Court of Appeals for the Federal Circuit, in response, vacated our

CBM2014-00116
Patent 6,826,548 B2

Decision and remanded to the Board to dismiss for lack of jurisdiction in its Order dated August 9, 2019.

Under these circumstances, we determine that it is appropriate to vacate the Final Written Decision (Paper 41) and dismiss the Petition. *See* 35 U.S.C. §§ 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate.”), 42.302(b) (“Who may file a petition for a covered business method patent review.”).

Accordingly, it is

ORDERED that the Final Written Decision (Paper 41) is *vacated*;

FURTHER ORDERED that the Petition is *dismissed*; and

FURTHER ORDERED transitional covered business method patent review of claims 39–44 of U.S. Patent No. 6,826,548 B2 is terminated.

CBM2014-00116
Patent 6,826,548 B2

PETITIONER:

Lionel Lavenue

Erika Arner

Elizabeth Ferrill

Joshua Goldberg

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP

lionel.lavenue@finnegan.com

erika.arner@finnegan.com

elizabeth.ferrill@finnegan.com

joshua.goldberg@finnegan.com

USPS-RMI-CBM@finnegan.com

PATENT OWNER:

Douglas H. Elliot

Eric M. Adams

The Elliott Law Firm, PLLC

delliott@elliottiplaw.com

eric@elliottiplaw.com