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 B2

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

TURNER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I.   INTRODUCTION

A.   *Background*

The United States Postal Service and United States of America, as represented by the Postmaster General (collectively "USPS"), 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, "the '548 Patent"), pursuant to § 18 of the Leahy-Smith America Invents Act ("AIA"). Paper 2 ("Pet."). In support of that Petition, USPS also included a declaration from Joe Lubenow, Ph.D. (Ex. 1008, "Lubenow Decl."). In response, Return Mail, Inc. ("Return Mail") filed a Patent Owner Preliminary Response. Paper 6 ("Prelim. Resp."). On October 16, 2014, we instituted a transitional covered business method patent review (Paper 11, "Dec.") based upon Petitioner's assertion that the challenged claims are unpatentable based on the following grounds:

Reference	Basis	Claims Challenged
	§ 101	39–44
1997 ACS[1]	§ 102	39–44

Dec. 35.

Subsequent to institution, Return Mail filed a Patent Owner Response (Paper 21, "PO Resp.") and, in support, a declaration from Scott M. Nettles, Ph.D. (Ex. 2015, "Nettles Decl."). Petitioner filed a Reply (Paper 22, "Reply") to Patent Owner's Response, and, in support, a supplemental declaration from Dr. Lubenow (Ex. 1028, "Lubenow Supp. Decl.").

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[1] United States Postal Service, *Address Change Service*, Publication 8 (July 1997) (Ex. 1004, "1997 ACS").

An oral hearing was held on May 12, 2015, and a transcript of the hearing is included in the record (Paper 40, "Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 39–44 of the '548 Patent are unpatentable.

B. The '548 Patent

The '548 Patent relates to a system and method of processing returned mail. Ex. 1001, Abs. Returned mail is received from United States Postal Service 90 and passed through high volume mail sorter 20 and optical scanner 40, where the optical scanner reads the information previously optically encoded onto each mail piece before it was sent. This information is stored through application server 50 in mass storage device 60, containing a plurality of subscriber databases 62. The addresses may then be extracted from the scanned data for processing. *Id*. at 3:32–51; Fig. 1.
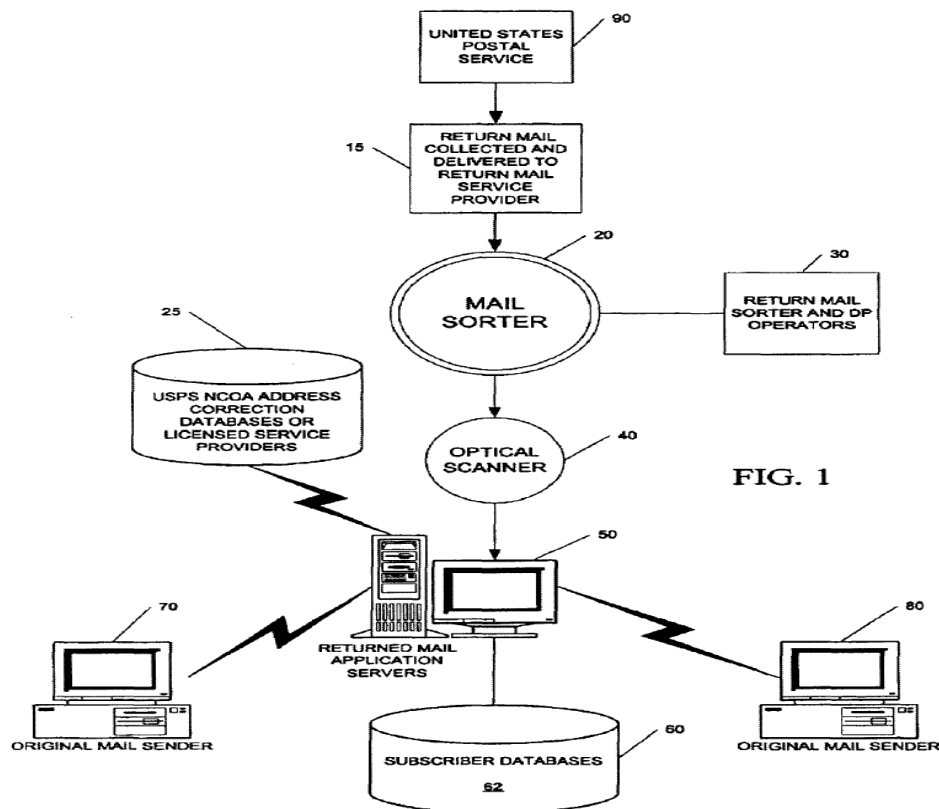
FIG. 1

Fig. 1 of the '548 Patent illustrates the processing flow
for the returned mail handling system.

C. Procedural History

The '548 Patent issued on November 30, 2004, based on a provisional

application, No. 60/263,788, filed January 24, 2001, and a non-provisional

application, No. 10/057,608, filed January 24, 2002. USPS points out that

Return Mail applied for a reissue of the '548 Patent (reissue application No.

11/605,488, filed November 29, 2006), which was subsequently abandoned.

Pet. 4. The challenged claims in this proceeding were obtained during a

reexamination of the '548 Patent requested by USPS, also cancelling the

original claims (Reexamination Control No. 90/008,470, Ex Parte

Reexamination Certificate issued January 4, 2011 as U.S. Patent No. 6,826,548 C1). Ex. 1002, 1:21–2:32; Prelim. Resp. 3.

In addition, Return Mail sued the United States for infringement of the '548 Patent in the U.S. Court of Federal Claims. *See Return Mail, Inc. (RMI) v. United States*, No. 1:11-cv-00130 (Fed. Cl. Filed Feb. 28, 2011). The Court construed the subject claims in an Order issued on October 4, 2013. Ex. 1011.

D. The Instituted Claims

The challenged claims include four independent claims, claims 39–42, and dependent claims 43 and 44, which depend from claim 42. Claims 39 and 42 are illustrative of the subject matter of the claims at issue and are reproduced below:

> 39. A method for processing returned mail items sent by a sender to an intended recipient, the method comprising the steps of:
>
> 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.
>
> 42. A method for processing a plurality of undeliverable mail items, comprising:

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