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*.

DECISION
Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

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 on April 15, 2014, 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"). Paper 2 ("Pet."). In response, Return Mail, Inc. ("Return Mail") filed a Patent Owner Preliminary Response on July 16, 2014. Paper 6 ("Prelim. Resp.").

We also authorized the filing of a Supplemental Response (Paper 9) by USPS, limited to addressing Patent Owner's arguments, based on *Alice Corp. Pty, Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) ("the Alice decision"), with respect to Petitioner's asserted ground of unpatentability under 35 U.S.C. § 101 in the Petition. Paper 7. We also authorized the filing of a Sur-Reply (Paper 10) to Petitioner's Supplemental Response. Paper 7.

We have jurisdiction under 35 U.S.C. § 324, which provides that a post-grant review may not be instituted "unless … the information presented in the petition … would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable." Taking into account the arguments presented in Return Mail's Preliminary Response, we determine that the information presented in the Petition establishes that claims 39–44 are more likely than not unpatentable. Pursuant to 35 U.S.C. § 324 and § 18(a) of the AIA,[1] we

---

[1] Section 18(a) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011) ("AIA").

hereby institute a covered business method patent review of claims 39–44 of the '548 Patent.

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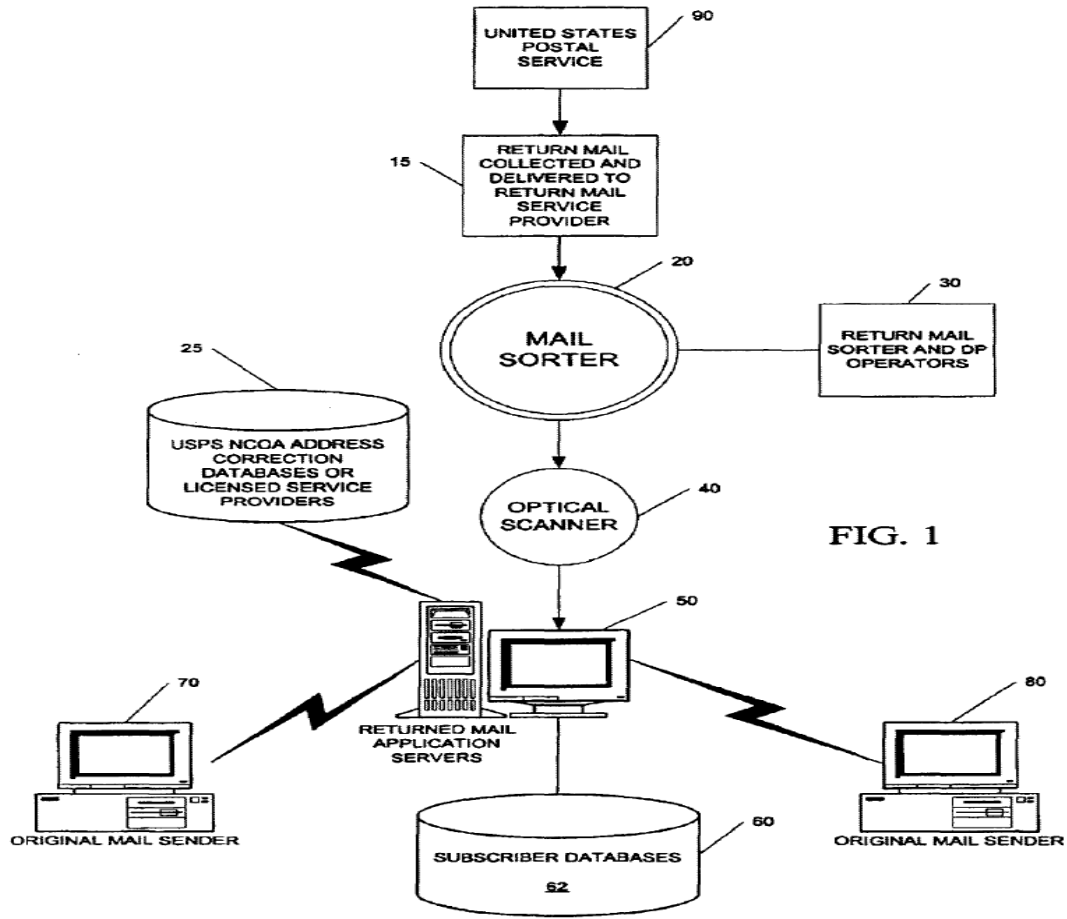
Fig. 1 of the '548 Patent illustrates the processing flow
for the returned mail handling system.

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, cancelling the original claims. Pet. 4.

The challenged claims in this proceeding were obtained during a reexamination of the '548 Patent requested by USPS (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 brought a suit against 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. Illustrative 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

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.