

Paper No. \_\_\_\_\_  
Filed: October 30, 2014

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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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.

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Case: CBM2014-00116

Patent: 6,826,548

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**Petitioner's Request for Rehearing  
Pursuant to 37 C.F.R. § 42.71(d)**

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## I. Statement of Relief Requested

Pursuant to 37 C.F.R. §§ 42.71(c)-(d), the United States Postal Service and the United States of America (collectively, “Petitioner”) request partial rehearing of the Patent Trial and Appeal Board’s Decision, entered October 16, 2014 (Paper 11, the “Decision”). The Decision instituted review of claims 39-44 of U.S. Patent No. 6,826,548, adopting the proposed grounds of unpatentability of these claims under 35 U.S.C. § 101 and the proposed grounds of unpatentability of these claims under 35 U.S.C. § 102 as being anticipated by *1997 ACS*. While Petitioner certainly agrees with the Decision’s institution of these proposed grounds, and while Petitioner recognizes that 35 U.S.C. § 326(b) contemplates “the efficient administration of the office” and “the ability of the office to timely complete [instituted] proceedings,” Petitioner requests rehearing of any reliance on 35 U.S.C. § 326(b) to deny institution of certain other proposed grounds to explicitly preserve its rights to later argue the same grounds before the Court of Appeals for the Federal Circuit and/or the Court of Federal Claims, or in a future post-grant proceeding. Thus, in effect, Petitioner only seeks rehearing to ensure that those remaining unpatentability grounds are either instituted as part of this proceeding or are available later. The Decision’s deferral of the remaining unpatentability grounds based on “administrative necessity” leaves Petitioner with uncertainty. Petitioner seeks certainty.

## II. Legal Standards

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “An abuse of discretion occurs when a ‘decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.’” *Illumina, Inc. v. The Trustees of Columbia University in the City of New York*, IPR2012-00006, Paper 43 at 2 (May 10, 2013) (quoting *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988)). “A decision based on an erroneous view of the law . . . *invariably* constitutes an abuse of discretion.” *Atl. Research Mktg. Sys. v. Troy*, 659 F.3d 1345, 1359 (Fed. Cir. 2011)(emphasis added). The party seeking rehearing bears the burden of demonstrating grounds for the relief it seeks and must “specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

## III. Reason for Rehearing

Petitioner respectfully seeks rehearing for institution of:

(1) the proposed grounds of unpatentability of claims 39-44 under 35 U.S.C.

§ 102 as being anticipated by *Park*;

(2) the proposed grounds of unpatentability of claims 39-41 under 35 U.S.C.

§ 102 as being anticipated by *Uhl*; and

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