

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 B2

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

KOKOSKI, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

A conference call in the above proceeding was held on July 24, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Turner, Benoit, and Kokoski. A court reporter was present on the call, and a transcript will be filed by Petitioner as an exhibit in this proceeding in due course.<sup>1</sup> Petitioner initiated the conference call to seek authorization to file a five page supplemental brief addressing the Supreme Court's recent decision in *Alice Corp. Pty, Ltd. v. CLS Bank Int'l*, No. 13-298, 2014 WL 2765283 (June 19, 2014).

Petitioner filed the petition in this case on April 15, 2014, two months prior to the Supreme Court's *Alice* decision. Paper 2 ("Petition"). The Petition includes a ground of unpatentability based upon 35 U.S.C. § 101. Pet. 17-27. According to Petitioner, Patent Owner relies on *Alice* in the Preliminary Response to criticize Petitioner's analyses under 35 U.S.C. § 101, and to support Patent Owner's argument that the patent claims at issue recite patent-eligible subject matter. *See* Prelim. Resp. 22-36. Petitioner requested supplemental briefing in order to address Patent Owner's arguments based on the *Alice* decision.

Patent Owner objected to Petitioner's request, arguing that the Board does not have authority to authorize supplemental briefing before a proceeding is instituted. Patent Owner further stated that the *Alice* decision is a restatement of holdings in other cases, and because the arguments in the Petition address those previous cases, supplemental briefing is not appropriate. Patent Owner requested, however, that if Petitioner is

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<sup>1</sup> This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

authorized to file a supplemental response, Patent Owner be allowed to file a sur-reply.

Based on the circumstances of this case, we authorize Petitioner to file a five page supplemental response, limited to responding to Patent Owner's arguments, based on the *Alice* decision, with respect to Petitioner's asserted ground of unpatentability under 35 U.S.C. § 101. Patent Owner is authorized to file a three page sur-reply to address Petitioner's supplemental response, optionally addressing whether we should consider the supplemental response in determining whether to institute a trial based on the Petition.

Accordingly, it is

ORDERED that Petitioner is authorized to file a supplemental response of no more than five pages no later than one week after the date of this Order;

FURTHER ORDERED that Petitioner's supplemental response shall be limited to addressing Patent Owner's arguments, based on the *Alice* decision, with respect to Petitioner's asserted ground of unpatentability under 35 U.S.C. § 101; and

FURTHER ORDERED the Patent Owner is authorized to file a surreply to Petitioner's supplemental response of no more than three pages no later than one week after the Petitioner's filing of the supplemental response.

Case CBM2014-00116

Patent 6,826,548 B2

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