

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*.

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.¹ 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

¹ 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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