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“Oh Yes, Wait a Minute, Mr. Postman” — Supreme Court Says Post Office (and the Government) Can’t Challenge Patents in Patent Office Proceedings

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Who — or what — is a “person” authorized under the America Invents Act (“AIA”) to challenge the validity of patents in Patent Office proceeding? That is the question that the Supreme Court answered on Monday, holding that the United States Postal Service (and the Government generally) may not seek to invalidate patents in these proceedings.

The AIA, which was enacted in 2011, provides for three types of litigation-like proceedings in the Patent Office for challenging the validity of patents: *inter partes* review (or “IPR” for short), post-grant review (“PGR”), and covered business method patent review (“CBM”). These proceedings have become popular and cost-effective alternatives to federal court litigation for those companies or people seeking to invalidate patents. Under the AIA, any “person” other than the patent owner may file one of these proceedings. That is just what the U.S. Postal Service did after Return Mail, Inc., accused it of infringing a patent directed to methods of processing undeliverable mail due to inaccurate or outdated recipient addresses. The Postal Service filed a CBM proceeding that, ultimately, invalidated Return Mail’s patent.

In *Return Mail, Inc. v. United States Postal Service*, the Supreme Court held that the Government (including government agencies like the U.S. Postal Service) is not a “person” and thus was not authorized to file the CBM proceeding in the first place. The Court first applied a “longstanding interpretive presumption that ‘person’ does not include the sovereign.” The Court then reasoned that because the AIA does not expressly define “person,” and because the Postal Service could point to nothing else in the text or context of the AIA to show affirmatively that the Government should be included within the definition, the Government could not be considered a “person” for purposes of filing IPRs, PGRs, and CBMs.

The Government, however, has not filed that many AIA review proceedings (only about 20), and thus the immediate impact of this ruling may be small. But the lesson from this case may have a broader reach because many statutes, not just the AIA, use the term “person” to define who may take or receive the benefit of certain actions. Thus, the Court’s reasoning could limit government action in other contexts. But the effect of this case will depend on the particular statute in question.

The case is *Return Mail, Inc. v. United States Postal Service et al.*, Case No. 17-1594 (U.S., June 10, 2019).



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