

People are persons. Corporations are persons. But, is the government a person? This is the question that is going to be before the U.S. Supreme Court in *Return Mail v. U.S. Postal Service*.

Return Mail owns U.S. Patent No. 6,826,548, which is directed towards an improved method for processing mail that is not deliverable due to incorrect addressing information for the recipient. The claims describe a method for encoding data on the mail before the mail is sent. The encoded data is then used to increase the efficiency of handling returned mail.

Initially, Return Mail attempted to license the patent to the Postal Service. When licensing failed, Return Mail sued the Postal service in Claims Court under 28 U.S.C. § 1498(a) for engaging in unlicensed use of the '548 Patent. In response, the Postal Service challenged the patent under the AIA-created Covered Business Method Review ("CBM Review").

Of the AIA-created review processes, the CBM Review has several unique features. First, the CBM Review is limited to a particular subject-matter. As the name indicates, "covered business methods" are the only patents that can be challenged under this review. Second, CBM Reviews are also limited to only allow petitioners that have been sued for infringement or charged with infringement of the particular patent. AIA § 18(a)(1)(B) states this rule as follows:

[a] person may not file a petition for [CBM review] unless the person or the person's real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent.

During the Federal Circuit appellate stage of *Return Mail*, a substantial portion of the focus of the parties and the court centered on whether the government (i.e., the Postal Service) "[had] been sued for infringement of the patent or [had] been charged with infringement under that patent." This question arose due to differences between 28 U.S.C. § 1498(a), which allows the government to be sued for unlicensed use, and 35 U.S.C. § 281, which allows a patentee to pursue civil action for infringement of a patent. Notably, due to

sovereign immunity, a patentee is not allowed to pursue a civil action under 35 U.S.C. § 281 against the government. The Federal Circuit affirmed the board's decision that the Postal Service had been sued for infringement or charged with infringement as per the requirement of AIA § 18(a)(1)(B).

While the court agreed on the disposition of this particular issue, the court was split regarding whether the government qualifies as a person under AIA § 18(a)(1)(B). Interestingly, neither party discussed this issue during the appeal, which led to some discussion by the court as to whether the issue had been waived. The resulting majority opinion found that regardless of whether the issue had been waived, the government qualified as a "person" under AIA § 18(a)(1)(B).

Judge Newman split with the majority and dissented. In Judge Newman's view, the government does not qualify as a person. While neither the majority nor the dissent delved deeply into the language of the actual statute, the dissent focused on general principles of statutory interpretation. In particular, the dissent noted that "the Dictionary Act, 1 U.S.C. § 1, defines "person": In determining the meaning of any Act of Congress, unless the context indicates otherwise— . . . the word 'person' . . . include[s] corporations, companies, associations, firms, partnerships, societies, and joint stock companies, as well as individuals." The dissent further noted an imbalance would occur within the statutory scheme if the government were allowed to pursue a CBM Review because the government would not be bound by the attending estoppel provisions within the statute.

After the issuance of the Federal Circuit opinion, Return Mail petitioned the Supreme Court for *certiorari*, which has now been granted. While the issue before the Supreme Court will not likely impact many patentees, it will provide an interesting insight into under what circumstances the government qualifies as a "person" for statutory purposes.