

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXPERIAN MARKETING SOLUTIONS, INC. and
EPSILON DATA MANAGEMENT, LLC
Petitioner

v.

RPOST COMMUNICATIONS LIMITED
Patent Owner

Case CBM2014-00010
Patent 8,224,913 B2

Before KEVIN F. TURNER, TREVOR M. JEFFERSON, and
JAMES B. ARPIN, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION

Denying Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I. BACKGROUND

Petitioner, Experian Marketing Solutions, Inc. and Epsilon Data Management, LLC, filed a petition (Paper 1, “Pet.”) to institute a covered business method patent review of claims 1-11 of U.S. Patent No. 8,224,913 B2 (“the ’913 Patent”) pursuant to 35 U.S.C. §§ 321-29. Patent Owner, RPost Communications Limited, filed a preliminary response (Paper 18, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 324.

The standard for instituting a covered business method patent review is set forth in 35 U.S.C. § 324(a):

THRESHOLD.—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

Petitioner challenges claims 1-11 as unpatentable under 35 U.S.C. §§ 102 and 103. For the reasons that follow, the petition is *denied*.

A. The ’913 Patent (*Ex. 1001*)

The ’913 Patent, titled “System and Method for Verifying Delivery and Integrity of Electronic Messages,” issued on July 17, 2012. The ’913 Patent relates to systems and methods of later providing proof regarding the delivery and content of an e-mail message. *Ex. 1001*, 1:21-24. This is accomplished when a system delivers the electronic message to all recipients, and, thereafter, the system returns a receipt of delivery to the originator of the electronic message. *Id.* at 3:18-37. The receipt includes, among other things: the original message, the digital signature of the

message, and a handshaking and delivery history including times of delivery to the recipients. *Id.* To later verify and authenticate information contained in the receipt, the originator or user sends a copy of the receipt to the system, and the system then verifies that the digital signature matches the original message and the rest of the receipt. *Id.*

B. Related Matters

The '913 Patent has been asserted in the proceedings listed in the petition. Pet. 7. The '913 Patent currently is being asserted against Petitioner in *RPost Holdings, Inc. v. Epsilon Data Management, LLC*, No. 2:12-cv-00511-JRG (E.D. Tex.) and *RPost Holdings, Inc. v. Experian Marketing Solutions, Inc.*, No. 2:12-cv-00513-JRG (E.D. Tex.). Exs. 1009, 1010.

C. Illustrative Claim

Claim 1 of the '913 Patent is reproduced below and is illustrative of the claims at issue:

1. A method of transmitting a message from a sender to a recipient through a server acting as a Mail Transport Agent, including the steps at the server of:

transmitting the message to the recipient's Mail Transport Agent in a protocol dialog selected from a group consisting of the selected one of the SMTP and ESMTP protocols; and

recording at the server some portion of the selected one of the SMTP and ESMTP protocol dialog between the server and the recipient through the server including those portions of the selected one of the SMTP and ESMTP protocol dialog between the server and the recipient in which the receiving Mail

Transport Agent accepts or declines delivery of the transmitted message.

D. Asserted References

In its petition, Petitioner refers to the following references:

B. Al-Hammadi et al., Certified Exchange of Electronic Mail (CEEM), Proceedings IEEE Southeastcon '99, 40-43 (Mar. 25–28, 1999) (Ex. 1012, hereinafter “CEEM”).

A. Bahreman et al., Certified Electronic Mail (CEM), Proceedings — Symposium on Network and Distributed Systems Security, 3-19 (Feb. 1994) (Ex. 1013, hereinafter “CEM”).

Michael A. Gurski, Privacy-Enhanced Mail (PEM), Oct. 24, 1995, available at: <http://www.csee.umbc.edu/~woodcock/cmssc482/proj1/pem.html> (Ex. 1014, hereinafter “PEM”).

Release notes from the 1999 version of Postfix, available at: http://web.archive.org/web/19990508202510/http://www.postfix.org/RELEASE_NOTES (Ex. 1016, hereinafter “Postfix”).

E. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1-11 of the '913 Patent based on the following asserted grounds of unpatentability:

Reference(s)	Basis	Claims challenged
CEEM	§ 102	1-11
CEM	§ 102	1-9
CEM and PEM	§ 103	10 and 11
Postfix	§ 102	1-3

II. ANALYSIS

A. *Financial Product or Service*

A “covered business method patent” is a patent that “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) § 18(d)(1); *see* 37 C.F.R. § 42.301(a). For purposes of determining whether a patent is eligible for a covered business method patent review, the focus is on the claims. *See* Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention; Final Rule, 77 Fed. Reg. 48,734, 48,736 (Aug. 14, 2012). A patent need have only one claim directed to a covered business method to be eligible for review. *Id.*

In promulgating rules for covered business method patent reviews, the Office considered the legislative intent and history behind the AIA’s definition of “covered business method patent.” *Id.* at 48,735-36. The “legislative history explains that the definition of covered business method patent was drafted to encompass patents ‘claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.’” *Id.* (citing 157 CONG. REC. S5432 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer)). The legislative history indicates that “financial product or service” should be interpreted broadly. *Id.*

As Petitioner points out, the Specification of the ’913 Patent details that the claimed electronic messaging systems and methods are directed to financial, monetary, and commercial applications. Pet. 10-11. Specifically,

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