

17-1594 RETURN MAIL, INC. V. UNITED STATES POSTAL SERVICE

DECISION BELOW: 868 F3d 1350

LOWER COURT CASE NUMBER: 2016-1502

QUESTION PRESENTED:

The government cannot be sued for patent infringement under the Patent Act, 35 U.S.C. §§ 1 et seq., because it can take "a license to use the inventio[n]" by "exert[ing] the power of eminent domain." *Crozier v. Fried. Krupp Aktiengesellschaft*, 224 U.S. 290, 305 (1912). Thus, a patent owner's exclusive remedy for governmental use is to pursue a compensation action under 28 U.S.C. § 1498(a) at the U.S. Court of Federal Claims.

In 2011, Congress enacted the Leahy-Smith America Invents Act (AIA), which allows a "person" who has been sued for patent "infringement" to challenge the patent's validity through a covered business method (CBM) review before the Patent Trial and Appeal Board. Respondent, the U.S. Postal Service, petitioned for CBM review of Petitioner's patent after Petitioner filed suit under § 1498(a). The Board instituted the review, concluding that it has authority to adjudicate proceedings initiated by the government, and later issued a final decision invalidating Petitioner's patent. The Federal Circuit affirmed, over a dissenting opinion. The questions presented are:

1. Whether the government is a "person" who may petition to institute review proceedings under the AIA.

2. Whether a § 1498(a) action for the eminent domain taking of a patent license by the government is a suit for patent "infringement" under the AIA.

LIMITED TO QUESTION 1 PRESENTED BY THE PETITION.

CERT. GRANTED 10/26/2018