

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIBERTY MUTUAL INSURANCE CO.
Petitioner

v.

PROGRESSIVE CASUALTY INSURANCE CO.
Patent Owner

Case CBM2012-00002
Patent 6,064,970

PATENT OWNER'S RESPONSE
PURSUANT TO 37 C.F.R. § 42.220

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Pursuant to the Board's Decision – Institution of Covered Business Method Review (Paper 10) (“Institution Decision”), entered January 25, 2013, and 37 C.F.R. § 42.220(c), Patent Owner Progressive Casualty Insurance Co. (“Progressive” or “Patent Owner”) submits this Response in opposition to the Petition for Covered Business Method Patent Review of United States Patent No. 6,064,970 (the “’970 patent”) filed by Liberty Mutual Insurance Co. (“Liberty” or “Petitioner”).

I. PRELIMINARY STATEMENT

The Board should issue judgment that claims 1, 3-6 and 9-18 of the ’970 patent are patentable over Kosaka, Herrod, the Florida Guide and Black Magic. The evidence shows that the combinations of these references identified by the Board as grounds for unpatentability do not render any of the claims of the ’970 patent obvious. The combinations cited by the Board rely on hindsight analysis to fill gaps that the ordinary skilled artisan in 1996 would not have filled and would not have found obvious. Each of the claims, considered as a whole, is nonobvious over the combination of references cited in the grounds for unpatentability in the Institution Decision. Not only are the combinations nonobvious, but, even if made,

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