

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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| LIBERTY MUTUAL INSURANCE |) | Attorney Docket No.: LMIC-021-801 |
| CO. |) | Customer No. 28120 |
| Petitioner, |) | |
| |) | |
| v. |) | Case CBM-2012-00003 (JL) |
| |) | Patent 8,140,358 |
| PROGRESSIVE CASUALTY |) | |
| INSURANCE CO. |) | |
| |) | |
| Patent Owner. |) | |

**PETITIONER LIBERTY MUTUAL INSURANCE CO.'S REQUEST FOR
REHEARING ON ORDER (REDUNDANT GROUNDS)**

Pursuant to 37 CFR § 42.71(d), the undersigned, on behalf of and acting in a representative capacity for Petitioner, Liberty Mutual Insurance Company (“Petitioner”), hereby submits this Request for Rehearing on portions of this Board’s October 25, 2012 Order (Redundant Grounds) (Paper No. 7, “Order”) in connection with the Petition for Covered Business Method Patent Review of United States Patent No. 8,140,358 (“358 Patent”) Pursuant to 35 U.S.C. § 321, 37 C.F.R. § 42.304 (“Petition” or “Pet.”).

As stated in Petitioner’s Notification in Response to Order (Redundant Grounds), filed concurrently herewith, Petitioner had undertaken in the space permitted in the Petition (*see* 37 CFR § 42.24) to present pertinent art confirming that the claims at issue are obvious not only in light of a single combination of references, but based on information that was very widely known in the art. Petitioner believed that—while the challenged patent’s large proportion of dependent claims yielded a large *absolute* number of combinations—those alternatives would not unduly increase the burden of this proceeding, and Petitioner understood from USPTO guidance that alternative arguments are to be permitted in the trial process in the transitional program for covered business method patents. *See, e.g.*, 77 FR 48,640 (“Section 42.51(b)(1)(iii), as adopted, does not preclude a party from arguing in the alternative...”); 77 FR 48,700 (“The rules do not preclude providing alternative claim constructions in a petition...”). However, Petitioner also recognizes and shares the Board’s concern with efficiency and timing. Accordingly, Petitioner has indicated in its Notification which combinations it will pursue as required by the Order,¹ while also indicating three instances (detailed below) in which Petitioner is seeking rehearing to allow the inclusion of particular combinations the Board’s Order does not, by its present terms, permit – including, in particular, the inclusion of sufficient alternatives to address the differing alternative limitations of *Markush* groups found in the

¹ Petitioner notes that, in light of the requirements of the Board’s Order, the grounds not selected pursuant to the Order are not grounds the Petitioner is raising in the requested trial. *See, e.g.*, 125 Stat 284 §§ 18(a)(1)(A), 18(a)(1)(D).

challenged claims, and the inclusion of express prior art disclosures as an alternative to expert testimony about the common knowledge of one of ordinary skill.

37 CFR § 42.71(d) provides that a party dissatisfied with a decision of the Board may request a rehearing. As detailed herein, Petitioner respectfully submits that the Board misapprehended or overlooked certain matters raised in the Petition, and that this supports rehearing on the portions of the Order identified below. *See* 37 CFR § 42.71(d).

I. “Horizontal Redundancy C” & “Vertical Redundancy A” – Bouchard, Gray or Lewis for Claims 17 and 18

Petitioner respectfully requests rehearing on the portions of the Order requiring Petitioner to (a) select one of two groups of obviousness grounds relying on Gray or Lewis, and (b) select one of three groups of obviousness grounds relying on Bouchard, Gray or Lewis, for claims 17 and 18 of the ‘358 Patent. (*See* Order at 11:26-12:4; 14:2-12).

Claim 18 depends upon claim 17, which, in turn, depends upon claim 16. Claim 16, in turn, depends upon independent claim 1. Dependent claim 16 recites “where the wireless transmitter is further configured to respond to a trigger event by transmitting an alert to a third party when a driving incident occurs.” Dependent claim 17 is a *Markush*-type claim that recites three alternatives: “where the driving incident comprises [1] exceeding a speed threshold, [2] traveling outside of a designation, or [3] a lock out condition.”

The Order acknowledges that Petitioner asserts nine grounds of obviousness against claims 17 and 18, designated as grounds 17:(1) to 17:(9) and 18:(1) to 18:(9) in the chart appearing on pages 20-21 of the Petition. (*See* Order at 13:2-4). Each of these nine grounds relies on Bouchard, which Petitioner expressly described as disclosing, *inter alia*, transmitting an alert to a third party when the “driving incident” is “exceeding a speed threshold”—*i.e.*, the first alternative recited in the Markush-group of claim 17. (*See, e.g.*, Pet. 66) (“**Bouchard discloses that the driving incident comprises exceeding a speed threshold at 30:29-38; 31:41-46.**”) (emphasis original).

The Order, however, states that “for no apparent or explained need, Petitioner then adds Gray (Ex. 1012) to the mix to support an additional 9 grounds against claims 17 and 18.” (Order at 13:4-8). Petitioner respectfully submits that this is incorrect, and that the Board overlooked the fact that Petitioner added Gray specifically to assert additional alternative grounds against the second alternative recited in the *Markush* group of claim 17—*i.e.*, “where the driving incident comprises . . . [2] traveling outside of a designation.” Petitioner expressly described Gray as disclosing transmitting an alert to a third party when the driving incident is “traveling outside of a designation.” (*See, e.g.*, Pet. 67-68) (“**Gray discloses . . . transmitting an alert to a third party (e.g., central station) when a driving incident occurs, where the driving incident comprises traveling outside of a designation (e.g.,**

vehicle has moved outside of a predetermined circle of protection) at 4:17-21, 5:67-6:21.”) (emphasis original).

The Order further states that “for no further apparent or explained need, Petitioner adds Lewis (Ex. 1024) to the mix to support an additional 9 grounds against claims 17 and 18.” (Order at 13:8-11). Petitioner respectfully submits that, again, the Board overlooked the fact that Petitioner added Lewis specifically to assert additional alternative grounds against the third alternative recited in the *Markush* group of claim 17—*i.e.*, “where the driving incident comprises . . . [3] a lock out condition.” For example, Petitioner expressly described Lewis as disclosing transmitting an alert to a third party when the driving incident is a “lock out condition.” (*See, e.g.*, Pet. 69) (“**Lewis discloses that the driving incident comprises a lock out condition at 2:58-67.**”) (emphasis original).

Similarly, in the portion of the Order addressing “Horizontal Redundancy C,” the Order states that “[a]s applied by the Petitioner to account for the features of claim 17 and 18, there is no substantive difference between Gray and Lewis.” (Order at 10:18-20). Petitioner respectfully submits that the Board overlooked the fact that, as expressly indicated in the Petition, substantive differences do exist between Gray, which discloses transmitting an alert when “traveling outside of a designation,” and Lewis, which discloses transmitting an alert during a “lock out condition”—two separate members of the *Markush* group of claim 17.

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