Trial@uspto.gov
571-272-7822

Paper 11
Entered: 26 November 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIBERTY MUTUAL INSURANCE COMPANY
Petitioner,

v.

PROGRESSIVE CASUALTY INSURANCE COMPANY
Patent Owner,

Case CBM-2012-00003 (JL)
Patent 8,140,358

Before JAMES DONALD SMITH, *Chief Administrative Patent Judge*, JAMES T. MOORE, *Vice Chief Administrative Patent Judge*, MICHAEL P. TIERNEY, *Lead Administrative Patent Judge,*[1] and JAMESON LEE, SALLY G. LANE, SALLY C. MEDLEY, JONI Y. CHANG, MICHAEL R. ZECHER, and BRIAN J. McNAMARA, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

1 **ORDER ON REHEARING**
2 **(REDUNDANT GROUNDS)**
3
4 Introduction

5 Petitioner requested rehearing of our order entered October 25, 2012,
6 requiring a reduction of the number of unpatentability grounds asserted against the

---

[1] Judge Tierney serves as Lead Judge of the Board's Trial Section.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

claims of Patent 8,140,358. Petitioner seeks rehearing only on some of the grounds we identified as redundant. Two arguments are raised by Petitioner: (1) where a claim includes a feature which is well known, Petitioner can attempt to meet that limitation by reliance on expert testimony without need of specific references, and alternatively by reliance on specific references disclosing that feature; and (2) where a claim includes a limitation which can be met in multiple ways, Petitioner should be free to present different alternatives, each one tailored to one of the many ways for meeting that limitation. The arguments are either not applicable to the facts of this case or unpersuasive.

Discussion

We disagree that Petitioner may hold back in reserve references disclosing a claim feature while relying on expert testimony urging that the feature was well known in the art. The references should be cited in support of the expert's opinion. Presenting different grounds based separately on expert opinion and on references creates redundancy, promotes inefficiency, causes confusion, and imposes unnecessary burden both on the Board and the Patent Owner.

We also could not have misapprehended or overlooked something not adequately explained in the initial petition. For instance, Petitioner did not "explain" in the initial petition the reasons it now presents as to why it supposedly relied on each of Bouchard, Gray, and Lewis separately, *i.e.*, to present three alternative ways a feature in claim 17 may be met. A request for rehearing is not an opportunity to supplement the initial petition. It is also not the case that Bouchard, Gray, and Lewis were cited "separately" to account for different alternatives recited in claim 17. Bouchard is included in all grounds 17:(1) to

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

1 17:(27) and 18:(1) to 18:(27). Petitioner added Gray to one third of those grounds
2 and Lewis to another one third of those grounds.
3 A petitioner is not generally precluded from arguing alternatives. As was
4 made clear in our initial decision, alternative grounds may be presented if an actual
5 need for presenting alternatives exists and is adequately explained in the petition.
6 That the Patent Owner may amend a challenged claim to recite something other
7 than what the Petitioner has initially cited does not generally present a genuine
8 need, because Petitioner may oppose a motion to amend and respond to new issues
9 arising from the amendment including evidence supporting the opposition. *See* 37
10 C.F.R. § 42.23 and Section H of the *Office Patent Trial Practice Guide*, 77 FR
11 48756, 48767 (Aug. 14, 2012).
12 Conclusion
13 For the foregoing reasons, Petitioner's request for rehearing is granted to the
14 extent that we have reconsidered our decision in light of Petitioner's request and
15 otherwise denied because we see no basis to change that decision.
16

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

1 By Electronic Transmission
2
3 Attorney for Petitioner Liberty Mutual Ins. Co.:
4
5 J. Steven Baughman, Esq.
6 Ropes & Gray LLP
7 steven.baughman@ropesgray.com
8
9
10 Attorneys for Patent Owner Progressive Casualty Ins. Co.:
11
12 Calvin P. Griffith, Esq.
13 James L. Wamsley, III, Esq.
14 John V. Biernacki, Esq.
15 Jones Day
16 cpgriffith@jonesday.com
17 jlwamsleyiii@jonesday.com
18 jvbiernacki@jonesday.com
19
20

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.