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 CBM2012-00003
Patent 8,140,358

PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.207

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I. INTRODUCTION

Liberty Mutual Insurance Company ("Petitioner") asserts that U.S. Patent No. 8,140,358 (the "'358 Patent") is nothing more than a combination of known elements – "merely an attempt to claim an old idea long known in the art." (Petition at 1; *see also* Petition at 2-5.) But "[m]ost if not all inventions arise from a combination of old elements." *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000); *accord In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The Petitioner's argument ignores a bedrock principle of United States patent law: It is improper to *dissect* a claimed invention into discrete elements and then evaluate those elements one-by-one. Rather, the claims must be considered *as a whole*, because it is the *combination of claim limitations functioning together* that constitutes the claimed invention. *See*, *e.g.*, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567 (Fed. Cir. 1987) ("Courts are required to view the claimed invention *as a whole*.") (emphasis in original); *see also* M.P.E.P. § 2141.02. The combinations of claim elements set forth in the '358 patent claims recite a novel configuration of technological features that operates in a unique manner. The '358 claims are not invalid in view of the art cited by the Petitioner.

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