

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 CBM2012-00004
Patent 6,064,970

Before JAMESON LEE, JONI Y. CHANG, and MICHAEL R. ZECHER,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION
Progressive's Request for Rehearing
37 C.F.R. § 42.71

INTRODUCTION

Progressive Casualty Insurance Company (“Progressive”) requests rehearing of the final written decision (Paper 60), holding claims 1 and 3-18 of U.S. Patent No. 6,064,970 (“the ’970 patent”) unpatentable. Paper 62 (“Req.”). Progressive proffers a declaration of Mr. James Wamsley to support its arguments. Ex. 2026.

On January 25, 2013, the Board instituted the instant covered business method patent review as to claims 1 and 3-18 of the ’970 patent, as well as CBM2012-00002 with respect to claims 1, 3-6, and 9-18 of the ’970 patent. Paper 10; *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00002, Paper 10. The trial schedules for both reviews were synchronized, as they involved the same patent and parties. Paper 11; CBM2012-00002, Paper 11. Also, the oral hearings for both reviews were merged and conducted at the same time, and the transcript for the oral hearing was made useable for both reviews. Papers 50, 58; CBM2012-00002, Papers 55, 64. The Board issued the final written decision in the instant proceeding and the final written decision for CBM2012-00002, on January 23, 2014, concurrently. Paper 60, p. 3 (“A final written decision in CBM2012-00002 is entered concurrently with this decision.”); CBM2012-00002, Paper 66, p. 3 (“A final written decision in CBM2012-00004 is entered concurrently with this decision.”).

In its request for rehearing, Progressive takes the position that the Board lacks statutory authority to issue the final written decision in the instant proceeding because it was posted electronically *50 seconds* after the final written decision in CBM2012-00002 was posted. Req. 4; Ex. 2026 ¶¶ 4-6. For the reasons stated below, Progressive’s request for rehearing is *denied*.

ANALYSIS

In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

In support of its position, Progressive argues the following: (1) the Board misapprehended or overlooked that posting to the Board's public electronic system, Patent Review Processing System (PRPS), "enters" a final written decision (Req. 3-4, 6-8 (citing Ex. 2026)); (2) the Board misapprehended or overlooked the application of 35 U.S.C. § 325(e)(1) (Req. 8-13); and (3) the Board misapprehended or overlooked the prohibition on issuing an advisory opinion (Req. 14-15). We disagree.

1.

Section 18(a) of the Leahy-Smith America Invents Act ("AIA") provides that a covered business method patent review "shall be regard as, and shall employ the standards and procedures of, a post-grant review" with certain exceptions. Pub. L. No. 112-29, § 18(a)(1)(A), 125 Stat. 284, 329 (2011). The Board's statutory authority for issuing a final written decision in an instituted covered business method patent review is set forth in 35 U.S.C. § 328(a), which states:

(a) FINAL WRITTEN DECISION.—If a post-grant review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 326(d).

Progressive does not dispute that both final written decisions holding the claims of the '970 patent unpatentable were issued on the same day, January 23, 2014. Req. 3. Progressive also acknowledges that the final written decision in the instant proceeding, itself, states that it is entered *concurrently* with the final written decision in CBM2012-00002. *Id.* Nonetheless, Progressive maintains that there is “no evidence to support the Board’s finding that its Final Decisions were ‘entered concurrently’ in CBM2012-00002 and CBM2012-00004.” *Id.* at 7.

That characterization is incorrect, as the Board did not make a finding in that regard, but simply declared how it was issuing the final written decisions in the instant proceeding and CBM2012-00002 pursuant to 35 U.S.C. § 328(a). The Board’s statement, itself, is an operative fact and requires no further supporting fact or evidence. Nothing in the statute prohibits the Board from issuing the final written decisions in two different proceedings for the same patent concurrently.

To support its position that an electronic posting “enters” a final written decision, Progressive proffers metadata and courtesy electronic mail notifications as evidence to show the times of the day when the final written decisions were posted in PRPS. Req. 3-4 (citing Ex. 2026 ¶¶ 4-7; *see, e.g., id.* at ¶ 5 (“The metadata . . . indicate[s] that [the final written decision in CBM2012-00002] was . . . available over the PRPS on January 23, 2014 at 1:25:52 PM EST (18:25:52.294 GMT).”); *id.* at ¶ 6 (“The metadata . . . indicates that [the final written decision in CBM2012-00004] was . . . available over the PRPS on January 23, 2014 at 1:26:42 PM EST (18:26:42.301 GMT).”). According to Progressive, because its supporting evidence shows that the final written decision of the instant proceeding was posted *50 seconds* after the final written decision in CBM2012-

00002 was posted, the final written decisions were *not issued concurrently*.
Req. 7-8; Ex. 2026 ¶¶ 4-7.

Progressive’s reliance on the metadata and electronic mail notifications associated with the electronic postings is misplaced. Public accessibility is not a requirement for issuing a final written decision under 35 U.S.C. § 328(a), but rather a requirement to make the file history available to the public under 35 U.S.C. § 326(a)(1). Progressive does not direct us to any authority to support its position that an electronic posting “issues” a final written decision.

Moreover, the Board has not implemented the statutory provision under 35 U.S.C. § 328(a) to define the precise moment when the Board issues a final written decision as the exact time of the day—measured *in seconds*—when the final written decision is posted in PRPS. In fact, the Board consistently has defined *the entry date* on the first page of each final written decision, as *the day* when the Board issues the final written decision, regardless of the mode of delivery or notification—mailing or posting electronically. That is consistent with the Office’s procedure for entering other official papers in this proceeding, and official papers in other proceedings. For instance, the Office accords the *filing date* of a patent application, and not the *filing time* of a patent application. The “entry date” procedure also is consistent with the procedure for setting time periods for the parties to file their papers, which is measured in the number of *days*, as opposed to *seconds*, from the *entry date* of a final written decision. *See, e.g.*, 37 C.F.R. § 42.71 (d)(2) (“Any request must be filed . . . [w]ithin 30 days of the entry of a final written decision or a decision not to institute a trial.”); 37 C.F.R. § 90.3(a)(1)

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