

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 CBM2013-00009
Patent 8,140,358

PATENT OWNER'S REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Patent Owner Progressive Casualty Insurance Co. (“Progressive”) hereby submits this Request for Rehearing of the final written decision (the “Final Decision”) entered February 11, 2014 (Paper 68) by the Patent Trial and Appeal Board (“Board”). Progressive respectfully submits that the Board misapprehended or overlooked the applicable law in entering its decision in CBM2013-00009 cancelling claims 1-20 of U.S. Pat. No. 8,140,358 (“the ’358 Patent”) because: (1) 35 U.S.C. § 325(e)(1) prohibits the Board from allowing CBM2013-00009 to be maintained by Petitioner once the Board issued its Final Decision in CBM2012-00003; and (2) the CBM2013-00009 Final Decision constitutes an improper advisory opinion.

II. FACTUAL BACKGROUND

A. Liberty Filed Two Petitions Challenging The Same ’358 Patent Claims, And The Board Declined To Join The Proceedings

On September 16, 2012, Liberty filed the CBM2012-00003 Petition to institute Covered Business Method Review of all 20 claims in the ’358 Patent. (CBM2012-00003, Paper No. 1.) On November 19, 2012, Liberty filed a second Petition on those same claims. (CBM2013-00009, Paper No. 1.) All the references that Liberty relied on therein had been asserted in CBM2012-00003, except for the article titled “Understanding Radio Determination Satellite Service” (“RDSS article”) describing the Geostar RDSS system. (CBM2013-00009, Ex. 1004.) Liberty was nonetheless

unquestionably aware of Exhibit 1004 when it filed its CBM2012-00003 Petition since the cover declaration authenticating the article was signed September 14, 2012 (two days *prior* to the filing date of the CBM2012-00003 Petition), and it was received by fax the very next day. (CBM2013-00009, Ex. 1004, at 1.) Liberty’s CBM2012-00003 Petition had relied on the Geostar RDSS system as a basis for unpatentability, and the Andrews declaration it submitted in support also discussed RDSS. (CBM2012-00003, Paper No. 1, at 55-56; *Id.* Ex. 1025, at ¶ 26.)

The Board itself was well aware of this overlap of references in CBM2012-00003 and CBM2013-00009. It characterized the two proceedings as “involv[ing] the same parties, the same prior art references, and the same patent.” (CBM2013-00009, Paper 16, at 2.) Indeed, even before the Board instituted CBM2013-00009, Liberty “proposed joining [CBM2012-00003] with any covered business method patent review to be instituted on CBM2013-00009[.]” (CBM2012-00003, Paper No. 19, at 2.)

The Board was also aware that the timing of its Final Decisions in CBM2012-00003 and CBM2013-00009 could have substantive implications. On December 2, 2013, Liberty initiated a conference call requesting joinder of these two proceedings. (CBM2013-00009, Paper No. 64.) It requested joinder because it was concerned about the possible application of 35 U.S.C. § 325(e) and 37 C.F.R. § 42.73(d)(1). (*Id.* at 2.) Progressive requested briefing on these issues and argued that “nothing should be created or engineered to avoid whatever consequences that naturally flow from the

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