Trial@uspto.gov
571-272-7822

Paper 78
Entered: April 1, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LIBERTY MUTUAL INSURANCE CO.
Petitioner

v.

PROGRESSIVE CASUALTY INSURANCE CO.
Patent Owner

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Case CBM2013-00009
Patent 8,140,358

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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*

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## INTRODUCTION

Progressive Casualty Insurance Company ("Progressive") requests rehearing of the final written decision (Paper 68), holding claims 1-20 of U.S. Patent No. 8,140,358 ("the '358 patent") unpatentable. Paper 71 ("Req."). Liberty Mutual Insurance Company ("Liberty") filed an opposition to Progressive's requests for rehearing. Paper 76 ("Opp.").[1] For the reasons stated below, Progressive's request for rehearing is *denied*.

On March, 28, 2013, the Board instituted the instant covered business method patent review as to claims 1-20 of the '358 patent. Paper 10. The Board also instituted a review in CBM2012-00003 with respect to claims 1-20 of the '358 patent. *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00003, Paper 15. In response to the parties' joint request, the Board synchronized the trial schedules for both reviews, as they involved the same patent and parties. Papers 16-17; CBM2012-00003, Papers 29-30. 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 47, 65; CBM2012-00003, Papers 62, 76. The Board in effect consolidated the reviews, except that papers and exhibits are stored in separate files for case management. *See* 35 U.S.C. § 325(d).

Pursuant to 35 U.S.C. § 328(a), the Board issued the final written decision in the instant proceeding and the final written decision for CBM2012-00003 on February 11, 2014, concurrently. Paper 68, p. 2 ("A final written decision in Case

[1] The Board authorized each party to file an opposition to the opposing party's request for rehearing. Paper 75.



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CBM2012-00003 is entered concurrently with this decision."); CBM2012-00003, Paper 78, p. 3 ("A final written decision in CBM2013-00009 is entered concurrently with this decision."). In its request for rehearing, Progressive takes the position that, although the decisions were issued on the same day, the Board lacks statutory authority to issue the final written decision in the instant proceeding because it was posted electronically by the Board's paralegal after the final written decision in CBM2012-00003 was posted. Req. 4.

## 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. 3-5, 7-8 (citing Ex. 2036)); (2) the Board misapprehended or overlooked the application of 35 U.S.C. § 325(e)(1) (Req. 8-14); and (3) the Board misapprehended or overlooked the prohibition on issuing an advisory opinion (Req. 14-15). Progressive also proffers a declaration of Mr. James Wamsley to support its arguments. Ex. 2036.

Liberty opposes and argues that Progressive's request for rehearing is improper for the following reasons: (1) Progressive's request "rests on the time Final Written Decisions were uploaded to PRPS *by a paralegal after* the Board



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completed the Final Written Decisions and could not be something *the Board* misapprehended or overlooked in issuing those decisions"; and (2) Progressive attempts to rely on evidence from after the decisions. Opp. 1 (emphasis in the original). Liberty also submits that the Board's Order entered on February 20, 2014, (Paper 69, p. 2) stating that "the two final written decisions [in CBM2012-00003 and CBM2013-00009] were entered at the same time" is correct, "regardless of the actual time of day each paper was uploaded by the Board's administrative staff." *Id*. According to Liberty, Progressive's arguments are premised on an erroneous interpretation of 35 U.S.C. § 325(e) to read the "petitioner" qualification entirely out of the statutory provision and misconstrue what it means to "maintain a proceeding." Opp. 2-3.

We have reviewed Progressive's request for rehearing and carefully considered Progressive's arguments. However, we are not persuaded that the final written decisions, with respect to the patentability of the claims of the '358 patent, are not issued concurrently under 35 U.S.C. § 328(a), and that the Board lacks statutory authority to issue the final written decision in the instant proceeding. Rather, we agree with Liberty that, regardless of the actual time of day each paper was uploaded by the Board's paralegal, the final written decisions are issued concurrently, and 35 U.S.C. § 325(e) does not preclude the Board from issuing the final written decision in the instant proceeding.

We now address Progressive's arguments in turn.

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



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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 '358 patent unpatentable were issued on the same day, February 11, 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 CBM2012-00003. *Id*. Nonetheless, Progressive maintains that there is "no evidence to support the Board's finding that its Final Decisions were 'entered concurrently' in CBM2012-00003 and CBM2013-00009." *Id*. at 8.

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 CBM2012-00003 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



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