

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 RESPONSE
PURSUANT TO 37 C.F.R. § 42.220**

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Pursuant to the Board’s Decision – Institution of Covered Business Method Review (Paper 10) (“Institution Decision”), entered March 28, 2013, and 37 C.F.R. § 42.220(c), Patent Owner Progressive Casualty Insurance Co. (“Progressive” or “Patent Owner”) submits this Response in opposition to the Petition for Covered Business Method Patent Review of United States Patent No. 8,140,358 (the “’358 patent”) filed by Liberty Mutual Insurance Co. (“Liberty” or “Petitioner”).

I. PRELIMINARY STATEMENT

The instant Petition represents the FOURTH time in a span of two months that Liberty has filed a Petition seeking Covered Business Method review of a Progressive patent based on Kosaka.¹ It is the second such Petition filed by Liberty against Progressive’s ’358 patent. In response to the first Petition (CBM2012-00003), the Board issued an Order *sua sponte* denying all of Petitioner’s grounds based on Kosaka in combination with other references disclosing wireless transmission of data from a vehicle. (*See* Ex. 2005.) And in CBM2013-00003, the Board denied Liberty’s Petition, which was based on the

¹ The other three Petitions are: (1) CBM2012-00002; (2) CBM2012-00003; and (3) CBM2013-00003.

same combination of Kosaka and the GEOSTAR system disclosed in the RDSS references on which Liberty relies here.² (Ex. 2022.)

The Institution Decision in this proceeding is inconsistent with the Board’s prior rulings rejecting Liberty’s repeated contention that it would have been obvious to relocate components of Kosaka to a remote location and wirelessly transmit Kosaka’s data to it. Even though the record here is slightly different, the difference is immaterial. The record here – as in the prior proceedings – does not disclose that any advantage would have been gained by “modify[ing] Kosaka’s in-vehicle integrated system (which has the risk evaluation device onboard to provide real-time risk evaluation) to transmit the monitored vehicle data wirelessly to a . . . server” (Ex. 2022 at 21.) Quite the contrary, a person of ordinary skill in the art (“POSITA”) would have had no reason or motivation to do so because the modification provided no advantage, was unnecessary, would have resulted in

² The RDSS reference was not asserted in the CBM2012-00003 Petition, but that was evidently a strategic choice, because it was known and available to Liberty at the time that Petition was filed. (*See* Cheston Declaration, Ex. 1004 at 000001, executed on September 14, 2012, two days before Liberty filed its Petition in CBM2012-00003.) In addition, the same GEOSTAR system described in RDSS was disclosed in the Scapinakis reference that Liberty submitted in CBM2012-00003. (Ex. 1016 in CBM2012-00003.)

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