

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 OPPOSITION TO LIBERTY'S
IMPROPERLY FILED PAPER NO. 81

Petitioner flaunted this Board's rules in filing Paper 81 in this proceeding, calling its paper a "request for rehearing" in order to file it without the Board's prior approval. Yet Paper 81 does not request the Board to rehear its final decision. Rather, it seeks relief contingent on how the Board will in the future rule on the rehearing request filed by the Patent Owner in CBM2013-00009, Paper 71.

If the Board denies Patent Owner's rehearing request in CBM2013-00009, then it asks the Board to deny its own request as well. (Paper 81 at 2.) If, on the other hand, the Board decides to grant Patent Owner's rehearing request, then Petitioner asks that the Board "issue a single combined final decision" in CBM2012-00003 and CBM2013-00009. (*Id.*) That Petitioner is asking the Board to deny its own request demonstrates that Paper 81 is an abuse of the Board's rules. Moreover, Petitioner has also violated the December 4, 2013 Order (Paper 75, at 3), that "Petitioner is not authorized to file a motion to join this proceeding with CBM2013-00009 [or] to seek that a single joint decision be issued for CBM2012-00003 and CBM2013-00009[.]"

As demonstrated herein, Petitioner's Paper 81 is not a proper rehearing request under 37 C.F.R. § 42.71. The Board should so rule and reject it as an unauthorized filing made in an effort to circumvent the Board's rules and in violation of the Board's December 4, 2013 Order.

I. BACKGROUND

On February 11, 2014, the Board entered its final written decision in

CBM2012-00003 (Paper 78) and CBM2013-00009 (Paper 68). Patent Owner filed a timely Request for Rehearing on March 12, 2014 in CBM2013-00009. (Paper 71.) The next day, Petitioner filed its purported “request for rehearing.” (Paper 81.) Petitioner filed the same request in the CBM2013-00009. The Board ordered in Paper 83 that Patent Owner could file oppositions to those papers.

II. LEGAL ARGUMENT

A request for rehearing may be filed if the Board has made a “decision” with which a party is dissatisfied. 37 C.F.R. § 42.71(d). By its very nature, such a request is to *re*-hear a decision already rendered. A party cannot seek “rehearing” of something which has yet to be decided. Yet, that is what Petitioner purports to do. It titled Paper 81 a “request for rehearing” although the relief it seeks depends on how the Board rules in the future on Patent Owner’s Request for Rehearing. Paper 81 does not request rehearing but is an improper motion or opposition directed to Patent Owner’s Request. Petitioner deliberately titled it as a rehearing request so that it could be filed without the Board’s prior approval.

Paper 81 is a transparent attempt to oppose Patent Owner’s Request for Rehearing. The Board prohibits filing such an opposition “absent a request from the Board.” (77 Fed. Reg. 48756, 48768 at § II(P)(Aug. 14, 2012).) Petitioner violated that prohibition by unilaterally filing Paper 81 as a rehearing request.

By contrast, Patent Owner has requested rehearing as to the Board's final written decision in CBM2013-00009 because the Board misapprehended or overlooked the applicable law that prohibited it from entering that decision. (Paper 71.) That is a proper request pursuant to Section 42.71, whereas Petitioner's Paper 81 is not a bona fide request. It does not seek to rehear any decision the Board has actually rendered. And, while it claims that the Board "misapprehended" that Patent Owner "would take the position" that the timing of entry of final written decisions could affect their resolution (Paper 81, at 3), Petitioner knows that the Board was not under any such misapprehension, as it plainly stated "nothing unusual should be arranged to avoid a potential issue that hinges on when the Board renders final written decisions in CBM2012-00003 and CBM2013-00009" (Paper 75, at 2).

Petitioner "ask[s] that the Board . . . consolidate the two actions and/or enter a combined single Final Written Decision." (Paper 81 at 5.) However, this is the same relief Petitioner requested in the December 2, 2013 conference call, and which the Board expressly ordered that Petitioner was "not authorized" to seek. (Paper 75.) Petitioner chose not to file a timely request for rehearing of that Order, and cannot do so now. (37 C.F.R. § 42.71(d)(1); 77 Fed. Reg. 48612, 48624 (Aug. 14, 2012).)

III. CONCLUSION

For the above reasons, Paper 81 should be ruled an improper rehearing request and rejected as an unauthorized filing.

Respectfully submitted,

JONES DAY

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CERTIFICATE OF SERVICE

I certify that a copy of the foregoing PATENT OWNER'S OPPOSITION TO LIBERTY'S IMPROPERLY FILED PAPER NO. 81 was served on March 28, 2014 by causing it to be sent by email to counsel for Petitioner at the following email addresses:

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