

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 CBM2012-00004  
Patent 6,064,970

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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*

## 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)

(The notice of appeal must be filed no later than 63 days after the date of the final Board decision.).

Indeed, the final written decision of the instant proceeding and the final written decision issued in CBM2012-00002 each set forth *the same entry date* of January 23, 2014. Paper 60, p. 1; CBM2012-00002, Paper 66, p. 1. Additionally, the final written decision, itself, clearly sets forth that “[a] final written decision in CBM2012-00002 is entered concurrently with this decision.” Paper 60, p. 3. Similarly, the final written decision in CBM2012-00002 states that “[a] final written decision in CBM2012-00004 is entered concurrently with this decision.” CBM2012-00002, Paper 66, p. 3. Each final written decision was decided by the same panel and is, itself, part of the official record. Progressive simply ignores the official records of both proceedings, including the final written decisions.

The PRPS also displays *the entry date* for both final written decisions. A screenshot of the PRPS entry listing for this proceeding is reproduced below.

| Documents     |                                                                             |                      |                      |                          |                                                                                                                                                                   |                      |
|---------------|-----------------------------------------------------------------------------|----------------------|----------------------|--------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------|
| CBM2012-00004 |                                                                             |                      |                      |                          |                                                                                                                                                                   |                      |
|               | Name                                                                        | Type                 | Exhibit/Paper Number | Filing Date              | Filing Party                                                                                                                                                      | Availability         |
|               |                                                                             |                      |                      | <a href="#">Previous</a> | <a href="#">1</a> <a href="#">2</a> <a href="#">3</a> <a href="#">4</a> <a href="#">5</a> <a href="#">6</a> <a href="#">7</a> <a href="#">8</a> <a href="#">9</a> | <a href="#">Next</a> |
| 41            | <a href="#">Notice of Objections to Evidence and Objections to Evidence</a> | Notice               | 41                   | 9/25/2013                | Patent Owner                                                                                                                                                      | Public               |
| 42            | <a href="#">Transcript of 8-29-13 Board Teleconference</a>                  | Notice               | 42                   | 9/30/2013                | Patent Owner                                                                                                                                                      | Public               |
| 43            | <a href="#">Order Conduct of the Proceeding § 42.5</a>                      | Notice               | 44                   | 9/30/2013                | Board                                                                                                                                                             | Public               |
| 44            | <a href="#">Request for Oral Hearing</a>                                    | Motion               | 45                   | 10/1/2013                | Petitioner                                                                                                                                                        | Public               |
| 45            | <a href="#">Patent Owner's Motion to Exclude Evidence</a>                   | Motion               | 46                   | 10/1/2013                | Patent Owner                                                                                                                                                      | Public               |
| 46            | <a href="#">Patent Owner's Updated Exhibit List</a>                         | Motion               | 47                   | 10/1/2013                | Patent Owner                                                                                                                                                      | Public               |
| 47            | <a href="#">Patent Owner's Observations on O'Neil Testimony</a>             | Motion               | 48                   | 10/1/2013                | Patent Owner                                                                                                                                                      | Public               |
| 48            | <a href="#">Patent Owner's Request for Oral Hearing</a>                     | Motion               | 49                   | 10/1/2013                | Patent Owner                                                                                                                                                      | Public               |
| 49            | <a href="#">Order - Trial Hearing Notice</a>                                | Notice               | 50                   | 10/7/2013                | Board                                                                                                                                                             | Public               |
| 50            | <a href="#">Petitioner Opposition to Motion to Exclude</a>                  | Opposition           | 51                   | 10/11/2013               | Petitioner                                                                                                                                                        | Public               |
| 51            | <a href="#">Petitioner's Response to Owner's Observations</a>               | Reply                | 53                   | 10/11/2013               | Petitioner                                                                                                                                                        | Public               |
| 52            | <a href="#">Petitioner's Updated Exhibit List 10-11-13</a>                  | Reply                | 54                   | 10/11/2013               | Petitioner                                                                                                                                                        | Public               |
| 53            | <a href="#">Patent Owner's Updated Exhibit List</a>                         | Notice               | 55                   | 10/16/2013               | Patent Owner                                                                                                                                                      | Public               |
| 54            | <a href="#">Patent Owner's Reply in Support of Motion to Exclude</a>        | Reply                | 56                   | 10/17/2013               | Patent Owner                                                                                                                                                      | Public               |
| 55            | <a href="#">Order - Conduct of the Proceeding</a>                           | Notice               | 57                   | 12/4/2013                | Board                                                                                                                                                             | Public               |
| 56            | <a href="#">Oral Hearing Transcript</a>                                     | Notice               | 58                   | 1/14/2014                | Board                                                                                                                                                             | Public               |
| 57            | <a href="#">BLANK</a>                                                       | Institution Decision | 59                   | 1/23/2014                | Board                                                                                                                                                             | Public               |
| 58            | <a href="#">FINAL WRITTEN DECISION</a>                                      | Final Decision       | 60                   | 1/23/2014                | Board                                                                                                                                                             | Public               |
| 59            | <a href="#">Order - Conduct of the Proceeding - 37 CFR 42.5</a>             | Order                | 61                   | 2/20/2014                | Board                                                                                                                                                             | Public               |
| 60            | <a href="#">Patent Owner Request for Rehearing</a>                          | Rehearing Request    | 62                   | 2/21/2014                | Patent Owner                                                                                                                                                      | Public               |

As shown in the screenshot above, PRPS displays January 23, 2014, as the entry date for the final written decision. Notably, PRPS does not display the time of the day when the final written decision or any other document was posted in PRPS. The Office does not expect the public to retrieve the metadata of each paper using Internet Explorer Tools, as Progressive did (Ex. 2026 ¶ 4; Attachments A, B), because the time of day when each paper is uploaded by the administrative staff has no legal significance.

For the foregoing reasons, the evidence before us establishes that the final written decisions with respect to the patentability of the '970 patent were issued concurrently.

We disagree with Progressive's assertion that, by issuing the final written decisions with respect to the patentability of the claims of the '970 patent concurrently, the Board "favors" Liberty. Req. 6. It is important to note that the concurrent issuance of the final written decisions is a natural consequence from synchronizing the trial schedules for both proceedings, which was requested by Progressive jointly with Liberty. Paper 15; CBM2012-00002, Paper 16.

Liberty filed the petition in the instant proceeding and the petition in CBM2012-00002 on the same day, September 16, 2012. The Board instituted both covered business method patent reviews on the same day, January 25, 2013, and both proceedings advanced on the same schedule to the concurrent issuance of the final written decisions. During the trials, Progressive also merged and conducted discovery for both proceedings at the same time (*see, e.g.*, Papers 22-24; CBM2012-00002, Papers 21-23) and conducted conference calls with the Board and Liberty for both proceedings concurrently (*see, e.g.*, Papers 15-16; CBM2012-

00002, Papers 16-17). The final oral hearings for both proceedings 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. In effect, the proceedings were consolidated, except that the papers and exhibits are stored in separate files for case management. *See* 35 U.S.C. § 325(d).

In an order dated December 4, 2013, we stated: “The parties can expect that the final written decisions for the two cases will issue on the same date, as that has been the plan according to the formal schedule.” Paper 57, pp. 2-3. The parties did not object to the advance notice to the parties that the final written decisions for the two cases will issue on the same date. Therefore, it should not be a surprise to Progressive that the final written decisions for both proceedings were issued concurrently—which was a natural result from synchronizing the trial schedules for both proceedings.

2.

Progressive alleges that the Board misapprehended or overlooked the application of 35 U.S.C. § 325(e)(1). Req. 8-13. According to Progressive, the estoppel of 35 U.S.C. § 325(e)(1) “attached as soon as the Board entered its Final Decision in CBM2012-00002, and the Board was then without authority to enter a Final Decision in the CBM2012-00004 proceeding.” Req. 8. Progressive maintains that the legislative history makes clear that 35 U.S.C. § 325(e)(1) is intended to prevent multiple challenges to a patent. Req. 13. We disagree.



The estoppel provision as to a final written decision in a covered business method patent review is provided in 35 U.S.C. § 325(e)(1), which states (emphases added):

PROCEEDINGS BEFORE THE OFFICE. — The *petitioner* in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, *may not request or maintain a proceeding before the Office* with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that post-grant review.

Progressive does not dispute that 35 U.S.C. § 325(e)(1) places a restriction on a petitioner's ability to "request or maintain a proceeding before the Office" *after* a final written decision under 35 U.S.C. § 328(a) has issued on the challenged claims. The estoppel provision under 35 U.S.C. § 325(e)(1) could not have terminated the instant proceeding prior to issuance of the final written decision, because the final written decision was issued *concurrently* with the final written decision in CBM2012-00002.

In addition, nothing in 35 U.S.C. § 325(e)(1) precludes the Board from proceeding to a final written decision when a petitioner can no longer maintain a proceeding, or requires the Board to terminate the second proceeding with respect to both the petitioner and patent owner when a final written decision has issued in a first proceeding on the same claims of the same patent. To the contrary, 35 U.S.C. § 327(a) provides that "[i]f no petitioner remains in the post-grant review, *the Office may terminate the post-grant review or proceed to a final written decision under section 328(a)*" (emphases added). Although Progressive interprets that statutory authorization narrowly, limiting it only to settlement situations,

Progressive fails to recognize that 35 U.S.C. § 328(a) expressly requires the Board to issue a final written decision if the instituted covered business method patent review is not dismissed, as is the case here.

With respect to Progressive's argument that the legislative history makes clear that 35 U.S.C. § 325(e)(1) is intended to prevent multiple challenges to a patent (Req. 13), the statute does not prohibit the Board from maintaining multiple parallel proceedings that conclude concurrently. As discussed above, Liberty filed the petition in the instant proceeding and the petition in CBM2012-00002 on the same day, September 16, 2012. The Board instituted both covered business method patent reviews on the same day, January 25, 2013, and the trial schedules for both proceedings were synchronized. Papers 10, 15; CBM2012-00002, Papers 10, 16. Progressive also merged and conducted discovery for both proceedings at the same time (*see, e.g.*, Papers 22-24; CBM2012-00002, Papers 21-23) and conducted conference calls with the Board for both proceedings concurrently (*see, e.g.*, Papers 15-16; CBM2012-00002, Papers 16-17). In sum, both proceedings advanced on the same schedule to the concurrent issuance of the final written decisions. Therefore, the Board does not view these two parallel proceedings as multiple "serial" attacks on the '970 patent.

For the foregoing reasons, we are not persuaded that, once the final written decision in CBM2012-00003 was entered, the estoppel provision under 35 U.S.C. § 325(e)(1) terminated the instant proceeding or prohibited the Board from issuing the final written decision.

3.

Progressive alleges that the Board misapprehended or overlooked the prohibition on issuing an advisory opinion. Req. 14-15. According to Progressive, the Board's unpatentability determination as to claims 1 and 3-18 of the '970 patent in the instant proceeding became an advisory opinion once the Board determined that claims 1, 3-6, and 9-18 of the '970 patent were unpatentable in CBM2012-00002 and, subsequently, cancelled those claims. *Id.*

We disagree. Again, Progressive's arguments rest on the erroneous premise that the final written decision of the instant proceeding was issued 50 seconds later than the issuance of the final written decision in CBM2012-00002. In fact, the final written decisions were issued *concurrently* on January 23, 2014. The final written decision of the instant proceeding, therefore, is not an advisory opinion, but rather a patentability determination under 35 U.S.C. § 328(a) as to claims 1 and 3-18 of the '970 patent.

Pursuant to 35 U.S.C. § 328(a), upon consideration of the parties' arguments and supporting evidence, the Board determined that claims 1 and 3-18 of the '970 patent were unpatentable under 35 U.S.C. § 103(a) based on several combinations of Bouchard, Pettersen, Herrod, Florida Guide, Camhi, and Dorweiler. Paper 60, p. 52. In the CBM2012-00002, the Board determined that claims 1, 3-6, and 9-18 of the '970 patent were unpatentable under 35 U.S.C. § 103(a) based on several combinations of Kosaka, Florida Guide, Black Magic, and Herrod. CBM2012-00002, Paper 66, p. 70. The final written decision in CBM2012-00002 does not address claims 7 and 8, as the grounds of unpatentability with respect to these claims were denied in the Decision on Institution (CBM2012-00002, Paper 10,

p. 31-32). Therefore, the patentability determinations of the instant proceeding and CBM2012-00002 are based on different grounds of unpatentability.

It is important to note that the Order set forth in the final written decision in CBM2012-00002 (Paper 66, p. 71) to cancel claims 1, 3-6, and 9-18 of the '970 patent is not effective until the Director issues a certificate under 35 U.S.C.

§ 328(b), canceling those claims. Section 328(b) states:

CERTIFICATE.—If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.

More significantly, a certificate under 35 U.S.C. § 328(b) cannot be issued until the time for appeal has expired or any appeal has terminated. Here, no certificate, cancelling any claims of the '970 patent, has been issued. Therefore, the final written decision of the instant proceeding was issued before any cancellation of the claims of the '970 patent.

For the foregoing reasons, we are not persuaded that the final written decision issued in the instant proceeding is an advisory opinion.

## CONCLUSION

In view of the foregoing, Progressive has not carried its burden of demonstrating that the Board's final written decision misapprehended or overlooked any matters. 37 C.F.R. § 42.71(d).

Progressive's request for rehearing is *denied*.

Case CBM2012-00004  
Patent 6,064,970

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