

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIBERTY MUTUAL INSURANCE COMPANY

Petitioner,

v.

PROGRESSIVE CASUALTY INSURANCE COMPANY

Patent Owner,

Case CBM-2012-00003 (JL)

Patent 8,140,358

Before JAMES DONALD SMITH, *Chief Administrative Patent Judge*, JAMES T. MOORE, *Vice Chief Administrative Patent Judge*, MICHAEL P. TIERNEY, *Lead Administrative Patent Judge*,¹ and JAMESON LEE, SALLY G. LANE, SALLY C. MEDLEY, JONI Y. CHANG, MICHAEL R. ZECHER, and BRIAN J. McNAMARA, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
(REDUNDANT GROUNDS)

Introduction

This petition for covered business method patent review of Patent 8,140,358 ('358 patent) was filed on September 16, 2012. Against all 20 claims of the '358

¹ Judge Tierney serves as Lead Judge of the Board's Trial Section.

1 patent, Petitioner asserts four hundred and twenty two (422) grounds of
2 unpatentability over prior art on a unit claim basis thus averaging more than 21
3 grounds per claim. They include the four hundred and twenty grounds in
4 Petitioner's chart on pages 17-22 of the petition, an alleged anticipation of claim
5 19 on page 70 of the petition, and an alleged anticipation of claim 20 on page 76 of
6 the petition. We note that numerous redundant grounds would place a significant
7 burden on the Patent Owner and the Board, and would cause unnecessary delays.

8 Part 42 of Title 37, Code of Federal Regulations, governs proceedings before
9 the Board and 37 C.F.R. § 42.1(b) provides that "[t]his part shall be construed to
10 secure the just, speedy, and inexpensive resolution of every proceeding." When
11 promulgating the regulations, the Board considered "the effect of the regulations
12 on the economy, the integrity of the patent system, the efficient administration of
13 the Office, and the ability of the Office to timely complete proceedings" as
14 mandated by 35 U.S.C. § 326(b). Conducting a proceeding contrary to those
15 statutory considerations would frustrate Congressional intent.

16 We take this opportunity to note that multiple grounds, which are presented
17 in a redundant manner by a petitioner who makes no meaningful distinction
18 between them, are contrary to the regulatory and statutory mandates, and therefore
19 are not all entitled to consideration. In the present situation, the multiplicity of
20 grounds requires so much of the petition that the Petitioner has failed to expressly
21 identify the differences between any claim and the prior art in the Petitioner's
22 assertions of obviousness.

23 A petitioner has the burden of proof to establish that it is entitled to the
24 requested relief. 37 C.F.R. § 42.20(c). Differences between the claimed invention

1 and the prior art are a critically important underlying factual inquiry for any
2 obviousness analysis. *Graham v. John Deere Co. of Kansas City*,
3 383 U.S. 1, 17 (1966). A petitioner who does not state the differences between a
4 challenged claim and the prior art, and relies instead on the Patent Owner and the
5 Board to determine those differences based on the rest of the submission in the
6 petition risks having the corresponding ground of obviousness not included for trial
7 for failing to adequately state a claim for relief.

8 Here, we discuss only redundancy. Two types of redundancy are common
9 in the instant petition. The first involves a plurality of prior art references applied
10 not in combination to complement each other but as distinct and separate
11 alternatives. All of the myriad references relied on provide essentially the same
12 teaching to meet the same claim limitation, and the associated arguments do not
13 explain why one reference more closely satisfies the claim limitation at issue in
14 some respects than another reference, **and** vice versa. Because the references are
15 not identical, each reference has to be better in some respect or else the references
16 are collectively horizontally redundant.

17 The second type of redundancy involves a plurality of prior art applied both
18 in partial combination and in full combination. In the former case, fewer
19 references than the entire combination are sufficient to render a claim obvious, and
20 in the latter case the entire combination is relied on to render the same claim
21 obvious. There must be an explanation of why the reliance in part may be the
22 stronger assertion as applied in certain instances **and** why the reliance in whole
23 may also be the stronger assertion in other instances. Without a bi-directional
24 explanation, the assertions are vertically redundant.

Horizontal Redundancy

A. Scapinakis, Eisenmann, or Stanifer

Claim 1 is the only independent claim. Petitioner first asserts obviousness of claim 1 over Kosaka, over Herrod, over Kosaka and Bouchard, and also over Herrod and Bouchard. Then, for each of those four grounds of obviousness, Petitioner adds either Scapinakis, Eisenmann, or Stanifer. The three references Scapinakis, Eisenmann, and Stanifer are each applied to account for the same feature of claim 1 that pertains to a wireless transmitter, and Petitioner's description of how each of the three is pertinent to that feature is substantively essentially the same.

With regard to **Scapinakis** (Ex. 1016), Petitioner states (Pet. 37:29 to 38:9):

Scapinakis – which is directed to vehicle telematics and was not previously cited to the PTO – discusses wirelessly transmitting recorded vehicle data (*e.g.*, road speed) from “on-board recorder[s]” to a distributed network (*e.g.*, radio, cellular, or satellite network) and a server (*e.g.*, remote central computer) in real-time. Ex. 1016 at 26-27.

A POSITA would have been motivated to combine the teachings of each of (1) Kosaka, (2) Herrod, (3) Kosaka in view of Bouchard, or (4) Herrod in view of Bouchard, with Scapinakis, given their similar purpose of using vehicle telematics to evaluate driving characteristics. For example a POSITA would have recognized that Kosaka's or Herrod's teachings of evaluating driving characteristics using monitored vehicle operation data would be enhanced by incorporating the similar but more sophisticated wireless telematics system discussed in Scapinakis in order to provide different types of data more efficiently to better determine driver performance.

1 With regard to **Eisenmann** (Ex. 1006), Petitioner states (Pet. 39:23 to 40:8):

2 Eisenmann – which is directed to vehicle telematics and was not
3 previously cited to the PTO in connection with the ‘358 Patent –
4 discusses the use of a wireless transmitter (*e.g.*, cellular mobile
5 transceiver) configured to transfer vehicle data retained within the
6 memory (*e.g.*, smart card) to a distributed network (*e.g.*, cellular
7 telephone network, public switched telephone network) and a server
8 (*e.g.*, insurance company computer and database) in real-time. Ex.
9 1006 at 2:36-49; 7:33-44; 22:29-26; 23:1-12; 23:13-27; Fig. 12.

10
11 A POSITA would have been motivated to combine the
12 teachings of each of (1) Kosaka, (2) Herrod, (3) Kosaka in view of
13 Bouchard, or (4) Herrod in view of Bouchard, with Eisenmann, given
14 their similar purpose of using vehicle telematics to evaluate driving
15 characteristics, such as for insurance purposes. For example a
16 POSITA would have recognized that Kosaka’s or Herrod’s teachings
17 of evaluating driving characteristics from monitored data would be
18 enhanced by incorporating Eisenmann’s more sophisticated wireless
19 telematics system to convey different types of data more efficiently to
20 better determine driver performance.

21
22 With regard to **Stanifer** (Ex. 1007), Petitioner states (Pet. 42:7 to 43:5):

23 Stanifer – which is directed to vehicle telematics and was not
24 previously cited to the PTO – discusses a wireless transmitter (*e.g.*,
25 “terminal node controller” and “radio transceiver”) configured to
26 transfer selected vehicle data (*e.g.*, geographic location) retained
27 within memory (*e.g.*, “computer memory”) to a distributed network
28 (*e.g.*, “packet radio link”) and a server (*e.g.*, base station). Ex. 1007 at
29 2:35-50; 4:4-17; 11:41-44; 12:18-22.

30
31 A POSITA would have been motivated to combine the
32 teachings of (1) Kosaka, (2) Herrod, (3) Kosaka in view of Bouchard,
33 or (4) Herrod in view of Bouchard, with [Stanifer], given their similar
34 purpose of using vehicle telematics to evaluate driving characteristics,

1 such as for insurance purposes. For example a POSITA would have
2 recognized that Kosaka's or Herrod's teachings of evaluating driving
3 characteristics using monitored data would be enhanced by
4 incorporating Stanifer's teachings of a similar but more sophisticated
5 wireless telematics system in order to convey different types of data
6 more efficiently to better determine driver performance.
7

8 As is evident from the above-quoted text, and as has been presented by the
9 Petitioner, in order to satisfy the wireless transmitter feature of claim 1, none of
10 Scapinakis, Eisenmann, and Stanifer is a better reference than the other two
11 references. Petitioner does not articulate any relative weakness in any respect for
12 any one of the three references. Petitioner does not articulate any relative strength
13 in any respect for any one of the three references. On this record, we conclude that
14 Scapinakis, Eisenmann, and Stanifer have been applied to meet the wireless
15 transmitter feature of claim 1 redundantly. The redundancy carries forward to the
16 various grounds of unpatentability of dependent claims 2-20, as additional
17 references are appended to each basic combination to account for respective
18 additional features in dependent claims.

19 It is

20 **ORDERED** that Petitioner has seven (7) days from the date of this
21 communication to notify the Board which **one** of three groups of obviousness
22 grounds it chooses to maintain against claim 1, as represented by the designation
23 1:(6) to 1:(9) in the chart on page 17 of the petition (grounds relying on
24 Scapinakis), the designation 1:(10) to 1:(13) in the chart (grounds relying on
25 Eisenmann), and the designation 1:(14) to 1: (17) in the chart (grounds relying on
26 Stanifer); the grounds that are not selected by Petitioner will not be considered;

1 **FURTHER ORDERED** that the Petitioner’s notification as to claim 1 in
2 response to this order shall carry through in effect to all associated obviousness
3 grounds asserted against dependent claims 2-20; for instance, with respect to claim
4 2, if the Petitioner selects the grounds 1:(6) to 1:(9) based on Scapinakis, this
5 selection will carry forward automatically to grounds 2:(6) to 2:(9) based on
6 Scapinakis, and grounds 2:(10) to 2:(17) based on Eisenmann and Stanifer will not
7 be considered;

8 **FURTHER ORDERED** that if Petitioner fails to notify the Board timely as
9 to which group of grounds to maintain, the Board will consider the grounds based
10 on Scapinakis, as Scapinakis has the earliest date of publication as compared to
11 Eisenmann and Stanifer, and that the grounds based on Eisenmann and Stanifer
12 will not be considered.

13
14 B. Kosaka, Black Magic, or Pettersen

15 Claims 19 and 20 each depend on independent claim 1. Claim 19 adds that
16 the server “is further configured to calculate an insured’s premium under the
17 insured’s insurance policy based on the rating factor, or a surcharge or a discount
18 to the insured’s premium, based on the rating factor.” Claim 20 adds that the
19 server “is further configured to process selected vehicle data that represents one or
20 more aspects of operating the vehicle with data that reflects how the selected
21 vehicle data affects an insured’s premium under an insured’s insurance policy.”

22 According to the Petitioner, each of Kosaka (Ex. 1003), Black Magic (Ex.
23 1015), and Pettersen (Ex. 1013) discloses the features added by claims 19 and 20.
24 Thus, for each of the 17 grounds Petitioner asserts against independent claim 1,

1 Petitioner adds Kosaka to make 17 grounds against each of claims 19 and 20, adds
2 Black Magic to make 17 more grounds against each of claims 19 and 20, and adds
3 Pettersen to make still 17 further more grounds against each of claims 19 and 20.

4 Petitioner asserts simply that Kosaka teaches the claim features added to
5 claim 1 by claims 19 and 20, that Black Magic teaches the claim features added to
6 claim 1 by claims 19 and 20, and that Pettersen teaches the claim features added to
7 claim 1 by claims 19 and 20, without relative distinction, in claim charts presented
8 on pages 72-75 of the petition for claim 19 and on pages 77 and 78 for claim 20.

9 With regard to **Kosaka** as applied to claims 19 and 20, Petitioner states (Pet.
10 71:37 to 72:5):

11 A POSITA would have been motivated to combine the
12 teachings of each of combination 1:(1)-1:(17) with Kosaka, given
13 their similar purpose of using vehicle telematics to evaluate driving
14 characteristics, including for insurance purposes. For example, a
15 POSITA would have recognized that the system disclosed in each of
16 combinations 1:(1)-1:(17) would be enhanced by implementing them
17 with Kosaka's teachings of making insurance premium calculations
18 based on the evaluations in order to make advantageous use of the
19 vehicle data for insurance purposes.
20

21 With regard to **Black Magic** as applied to claims 19 and 20, Petitioner states
22 (Pet. 73:15-21):

23 A POSITA would have been motivated to combine the
24 teachings of each of combination 1:(1)-1:(17) with Black Magic,
25 given their similar purpose of using vehicle telematics to evaluate
26 driving characteristics, including for insurance purposes. For
27 example, a POSITA would have recognized that the system disclosed
28 in each of combinations 1:(1)-1:(17) would be enhanced by
29 implementing them with Black Magic's teachings of premium

1 determinations to make advantageous use of the vehicle data for
2 insurance purposes.

3
4 With regard to **Pettersen** as applied to claims 19 and 20, Petitioner states
5 (Pet. 75:3-9):

6 A POSITA would have been motivated to combine the
7 teachings of each of combination 1:(1)-1:(17) with Pettersen, given
8 their similar purpose of using vehicle telematics to evaluate driving
9 characteristics, such as for insurance purposes. For example, a
10 POSITA would have recognized that the system disclosed in each of
11 combinations 1:(1)-1:(17) would be enhanced by implementing them
12 with Pettersen's teachings of insurance premium evaluations to make
13 advantageous use of the vehicle data for insurance purposes.
14

15 As explained above, for satisfying the additional feature of claims 19 and 20,
16 and as has been presented by the Petitioner, none of Kosaka, Black Magic, and
17 Pettersen is stated by Petitioner to be a better reference than the other two
18 references. Petitioner does not articulate any relative weakness for any one of the
19 three references. Petitioner does not articulate any relative strength for any one of
20 the three references. On this record, we conclude that Kosaka, Black Magic, and
21 Pettersen have been redundantly applied to meet the claim features added by
22 claims 19 and 20 relative to independent claim 1.

23 It is

24 **ORDERED** that Petitioner has seven (7) days from the date of this
25 communication to notify the Board which **one** of three groups of obviousness
26 grounds it chooses to maintain against each of claims 19 and 20, as represented by
27 the designation 19:(1)-19:(17) and 20:(1)-20:(17) in the chart on page 21 of the
28 petition (grounds relying on Kosaka), the designation 19:(18)-19:(34) and 20:(18)-

20:(34) in the chart on pages 21-22 of the petition (grounds relying on Black Magic), and the designation 19:(35)-19:(51) and 20:(35)-20:(51) in the chart on page 22 of the petition (grounds relying on Pettersen); the grounds that are not selected by Petitioner will not be considered;

FURTHER ORDERED that if Petitioner fails to notify the Board timely as to which group of grounds to maintain, the Board will consider the grounds based on Pettersen, as Pettersen has the earliest date of publication as compared to Kosaka and Black Magic, and that the grounds based on Kosaka and Black Magic will not be considered.

C. Gray or Lewis

Claim 16 depends on independent claim 1. Claim 17 depends on claim 16 and claim 18 depends on claim 17. Petitioner asserts 9 grounds of obviousness against claim 16, designated as grounds 16:(1) to 16:(9) in the chart on pages 20-21 of the petition. On that foundation, Petitioner asserts 18 grounds of obviousness against each of claims 17 and 18, the first 9 relying on the addition of Gray to all the grounds of obviousness of base claim 16, and the second 9 relying on the addition of Lewis to all the grounds of obviousness of base claim 16. As applied by the Petitioner to account for the features of claims 17 and 18, there is no substantive difference between Gray and Lewis. Each purportedly discloses the features additionally required by claims 17 and 18 relative to base claim 16. Petitioner has not articulated any deficiency of Gray relative to Lewis or of Lewis relative to Gray. The explanations of their application are essentially the same.

1 With respect to Gray, the Petitioner states (Pet. 67:11-16):

2 A POSITA would have recognized that the systems disclosed in
3 each of the combinations 16:(1) to 16:(9), which describe systems for
4 evaluating driving characteristics using monitored vehicle data
5 received wirelessly from a vehicle telematics device with the ability to
6 communicate in the event of certain situations, would be enhanced by
7 implementing them with the ability to communicate in the event of
8 certain additional situations as discussed in Gray.
9

10 With respect to Lewis, the Petitioner states (Pet. 69:3-8):

11
12 A POSITA would have recognized that the systems disclosed in
13 each of combinations 16:(1) to 16:(9), which describe systems for
14 evaluating driving characteristics using monitored vehicle data
15 received wirelessly from a vehicle telematics device with the ability to
16 communicate in the event of certain situations, would be enhanced by
17 implementing them with the ability to communicate in the event of
18 certain additional situations as discussed in Lewis.
19

20 As explained above, Petitioner has applied Gray and Lewis in a manner that
21 presents no distinction. On this record, Petitioner has not established a case that
22 Gray may be better prior art for some reasons and Lewis better for other reasons.
23 We conclude that Gray and Lewis have been redundantly applied to meet the
24 features added by claims 17 and 18 relative to base claim 16.

25 It is

26 **ORDERED** that Petitioner has seven (7) days from the date of this
27 communication to notify the Board which **one** of Gray and Lewis it chooses to add
28 to the grounds asserted against claim 16, to render obvious claims 17 and 18; the
29 reference that is not selected by Petitioner and corresponding grounds will not be
30 considered;

FURTHER ORDERED that if Petitioner fails to notify the Board timely as to which reference to consider, the Board will consider the grounds based on Gray, because Gray has the earlier date of publication, and that the alleged grounds based on Lewis will not be considered.

Vertical Redundancy

Vertical redundancy exists when there is assertion of an additional prior art reference to support another ground of unpatentability when a base ground already has been asserted against the same claim without the additional reference and the Petitioner has not explained what are the relative strength and weakness of each ground. To move forward with such a multiplicity of grounds, Petitioner must articulate a reasonable basis to believe that from a certain perspective the base ground is stronger, and that from another perspective the ground with additional reference is stronger.

The underlying principle is this: If either the base ground or the ground with additional reference is better from all perspectives, Petitioner should assert the stronger ground and not burden the Patent Owner and the Board with the other. If there is no difference, Petitioner should assert just one ground. Only if the Petitioner reasonably articulates why each ground has strength and weakness relative to the other should both grounds be asserted for consideration.

1 A. Adding Gray or Lewis for Claims 17 and 18

2 Petitioner first asserts 9 grounds of obviousness against claims 17 and
3 18. They are designated as grounds 17:(1) to 17:(9) and 18:(1) to 18:(9) in
4 the chart appearing on pages 20-21 of the petition. For no apparent or
5 explained need, Petitioner then adds Gray (Ex. 1012) to the mix to support
6 an additional 9 grounds against claims 17 and 18; they are designated as
7 grounds 17:(10) to 17:(18) and 18:(10) to 18:(18) in the chart on page 21 of
8 the petition. And for no further apparent or explained need, Petitioner adds
9 Lewis (Ex. 1024) to the mix to support an additional 9 grounds against
10 claims 17 and 18; they are designated as grounds 17:(19) to 17:(27) and
11 18:(19) to 18:(27) in the chart on page 21 of the petition.

12 The Petitioner states merely that one with ordinary skill would have
13 recognized that the system disclosed in each of the 9 base grounds “would
14 be enhanced by implementing them with the ability to communicate in the
15 event of certain additional situations discussed in Gray” (Pet. 67:11-16) and
16 also “would be enhanced by implementing them with the ability to
17 communicate in the event of certain additional situations discussed in
18 Lewis” (Pet. 69:3-8). That the base combination can be enhanced tells
19 nothing about why it may be inadequate to meet the requirements of claims
20 17 and 18 and why either Gray or Lewis can help to shore up that infirmity.
21 Furthermore, if either Gray or Lewis can shore up an infirmity in the base
22 combination, then the base combination should not be asserted concurrently
23 with another ground including the base combination and Gray or Lewis.

1 It is

2 **ORDERED** that Petitioner has seven (7) days from the date of this
3 communication to notify the Board which **one** of three groups of grounds it
4 chooses to maintain against claims 17 and 18, the base combination of
5 grounds 17:(1) to 17:(9) and 18:(1) to 18:(9) against claims 17 and 18,
6 grounds 17:(10) to 17:(18) and 18:(10) to 18:(18), or grounds 17:(19) to
7 17:(27) and 18:(19) to 18:(27); the grounds that are not selected by
8 Petitioner will not be considered;

9 **FURTHER ORDERED** that if Petitioner fails to notify the Board
10 timely which grounds to maintain, the Board will consider the base
11 combination of grounds 17:(1) to 17:(9) and 18:(1) to 18:(9) and the grounds
12 based on Gray and Lewis will not be considered.

13 B. Adding Scapinakis, Eisenmann, or Stanifer for Claim 1

14 As we discussed earlier in the section titled “Scapinakis, Eisenmann,
15 or Stanifer,” Petitioner first asserts obviousness of claim 1 over Kosaka, over
16 Herrod, over Kosaka and Bouchard, and also over Herrod and Bouchard.
17 Then, for each of those initial four grounds of obviousness, Petitioner adds
18 Scapinakis, Eisenmann, or Stanifer, to make 12 more grounds of
19 obviousness for claim 1. Of those 12 additional grounds, 4 are from adding
20 Scapinakis, 4 are from adding Eisenmann, and 4 are from adding Stanifer, to
21 each of the initial 4 obviousness grounds for claim 1.

22 Petitioner does not explain why the addition of any one of Scapinakis,
23 Eisenmann, and Stanifer, is needed to augment the initial four grounds of
24 obviousness directed against claim 1, *i.e.*, over Kosaka, over Herrod, over

1 Kosaka and Bouchard, and over Herrod and Bouchard. Petitioner articulates
2 no infirmity or deficiency in the initial four grounds of obviousness rejection
3 of claim 1, which would be made up or otherwise remedied by relying on
4 Scapinakis, Eisenmann, or Stanifer.

5 The Petitioner states merely that one with ordinary skill would have
6 recognized that the system disclosed in each of the 4 initial obviousness
7 grounds would be enhanced by incorporating the more sophisticated wireless
8 telematics system to provide different types of data more efficiently to better
9 determine driver performance as is discussed in Scapinakis, Eisenmann, and
10 Stanifer. (Pet. 38:5-9; 40:4-8; 42:16 to 43:5). That the initial 4 grounds can
11 be enhanced tells nothing about why it may be inadequate to meet the
12 requirements of claim 1 and why any of Scapinakis, Eisenmann, and Stanifer
13 can help to shore up that infirmity. And if any of Scapinakis, Eisenmann,
14 and Stanifer can shore up an infirmity in the initial four obviousness
15 grounds, then the initial four grounds should not be asserted concurrently
16 with a separate ground adding Scapinakis, Eisenmann, or Stanifer.

17 It is

18 **ORDERED** that Petitioner has seven (7) days from the date of this
19 communication to notify the Board which **one** of four groups of grounds it
20 chooses to maintain against claim 1, *i.e.*, first group with grounds designated
21 as 1:(2) to 1:(5) in the chart on page 17 of the petition, second group with
22 grounds designated as 1:(6) to 1:(9) including Scapinakis, third group with
23 grounds designated as 1:(10) to 1:(13) including Eisenmann, and fourth
24 group with grounds designated as 1:(14) to 1:(17) including Stanifer; the

1 grounds in the non-selected groups will not be considered and neither will

2 grounds which dependent on any ground in the non-selected groups;

3 **FURTHER ORDERED** that if Petitioner fails to notify the Board
4 timely as to which group of grounds to maintain, the Board will consider
5 grounds 1:(6) to 1:(9) relying on the addition of Scapinakis; grounds 1:(2) to
6 1:(5), 1:(10) to 1:(13), and 1:(14) to 1:(17) and grounds dependent thereon
7 will not be considered.

8 C. Adding Bouchard for Claim 1

9 According to claim 1, a processor must collect vehicle data from a vehicle
10 bus. Petitioner first asserts obviousness of claim 1 over Kosaka and also over
11 Herrod, in grounds designated as 1:(2) and 1:(3) in the chart on page 17 of the
12 petition. For those grounds, Petitioner alleges that collection of vehicle diagnostic
13 data from a vehicle bus was well known in the art, without citing to any particular
14 reference. In support of that assertion, Petitioner's technical witness Andrews
15 testified in his declaration ¶ 21, lines 10-14, that the On-Board Diagnostics II
16 (OBD-II) vehicle bus was used in vehicles since 1994 and has, in fact, been
17 required in passenger vehicles and light duty trucks since January 1996, as
18 mandated by the Environmental Protection Agency.

19 Nevertheless, Petitioner adds the prior art reference Bouchard to each of the
20 two obviousness grounds based on Kosaka and Herrod to provide two additional
21 grounds of obviousness, one based on Kosaka and Bouchard and the other based
22 on Herrod and Bouchard. Bouchard is relied on as disclosing a processor that
23 collects vehicle data from a vehicle bus. (Pet. 36:3-5). In that regard, Bouchard is
24 said to be directed to a method and system for monitoring vehicle sensors to obtain

1 various data elements and determine the operational status of a vehicle. (Pet.
2 35:28-30). The Petitioner nowhere explains why reliance on Bouchard is needed
3 in light of the alleged fact that collection of vehicle diagnostic data from a vehicle
4 bus was well known to one with ordinary skill in the art and was actually required
5 by law on certain types of vehicles since January of 1996. It is unknown why
6 without reliance on Bouchard the obviousness grounds based on Kosaka and
7 Herrod would be deemed inadequate insofar as the vehicle data bus limitation is
8 concerned. If they are not inadequate in that connection, then additional grounds
9 including Bouchard should not be asserted. If Bouchard is necessary, then Kosaka
10 and Herrod should not be asserted without Bouchard.

11 It is

12 **ORDERED** that Petitioner has seven (7) days from the date of this
13 communication to notify the Board which **one** of two groups of obviousness
14 grounds it chooses to maintain against claim 1, *i.e.*, first group with grounds based
15 on Kosaka and Herrod and designated as 1:(2) and 1:(3) in the chart on page 17 of
16 the petition, and second group with grounds designated as 1:(4) and 1:(5) which
17 include the addition of Bouchard; the grounds in the non-selected group will not be
18 considered and neither will grounds which depend on any ground in the non-
19 selected group;

20 **FURTHER ORDERED** that if Petitioner fails to notify the Board timely,
21 the Board will consider grounds 1:(2) and 1:(3) which rely on the alleged fact that
22 collecting diagnostic data from a vehicle bus was well known; grounds 1:(4) and
23 1:(5) which rely on Bouchard for its disclosure of a vehicle data bus and grounds
24 dependent thereon will not be considered.

CBM-2012-00003

Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.

1 ack

2 By Electronic Transmission

3

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