

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Control No. : 95/001,577
Filing Date : March 16, 2011
Patent Under Reexamination : 6,788,314
Issue Date : September 7, 2004
TC/A.U. : Central Reexamination Unit 3992
Examiner : Deandra M. Hughes
Confirmation No. : 1540
Customer No. : 27896
Docket No. : 2230.0001L
Title : Attention Manager for Occupying the Peripheral
Attention of a Person in the Vicinity of a Display Device

Mail Stop *Inter Partes* Reexam

Attn: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.956

Sir:

This is a request under the provisions of 37 C.F.R. § 1.956 to extend the period for filing a response in the above identified *inter partes* reexamination proceeding. The Patent Owner herewith petitions the Director of the United States Patent and Trademark Office (USPTO) to extend the time for responding to the Office Action dated May 19, 2011 for one month from July 19, 2011 to August 19, 2011 for the following reasons.

A Petition for Extension of Time Under 37 C.F.R. § 1.956 was filed by the Patent Owner on June 15, 2011 requesting a two-month extension of time. On June 20, 2011, the USPTO mailed a Decision Dismissing the Petition.¹ The Decision emphasized the USPTO's policy that requests for extensions of more than one month will be granted only in "extraordinary situations." The Decision concluded that the circumstances explained by the Patent Owner in the

¹ While the mailing date listed on the Decision is June 20, 2011, the Decision could not be obtained via PAIR or otherwise until today.

Petition do not rise to the level of an extraordinary situation. In view of the Decision, the Patent Owner now requests a one-month extension of time, which request is not subject to the "extraordinary situation" standard set forth in M.P.E.P. § 2665. Provided below in support of the Petition is a summary of what actions the Patent Owner has taken to timely provide a response and why, in spite of the actions taken thus far, the requested additional time is needed. Further, the Patent Owner provides comments responsive to the Analysis and Findings contained in the Decision mailed June 20, 2011.

A. Statement of What Actions the Patent Owner Has Taken to Timely Provide a Response

On August 27, 2010, the Patent Owner filed a lawsuit asserting infringement of the subject patent by AOL, Inc.; Apple Inc.; eBay, Inc., Facebook, Inc.; Google Inc.; Netflix, Inc.; Office Depot, Inc.; OfficeMax Inc.; Staples, Inc.; Yahoo! Inc.; and YouTube LLC (see Civil Action No. 2:10cv01385-MJP).

In anticipation of one or more of the Defendants in this lawsuit filing a Request for Reexamination of the subject patent, the Patent Owner diligently sought patent counsel having the specific skills and experience necessary for representing the Patent Owner in a reexamination proceeding before the USPTO. On November 9, 2010, several months before the Third Party Requester filed a Request for *Inter Partes* Reexamination for the subject patent, the Patent Owner retained the law firm of Harness, Dickey & Pierce, PLC ("the Harness firm") for the specific purpose of representing the Patent Owner in any reexamination of the subject patent that might ensue.

The Harness firm promptly filed a Power of Attorney with the USPTO upon learning of the Request for *Inter Partes* Reexamination filed on March 16, 2011 for the subject patent. Since a decision to grant the Request for *Inter Partes* Reexamination would result in an Office Action being mailed within three months of the Request, the Harness firm immediately began preparing for a potential Office Action. An extensive effort was undertaken involving reviewing the patent, the prosecution history, and the lengthy Request, including the cited prior art and the arguments and claim charts presented therein and preliminarily developing a response. Thus,

preparation for timely responding began well before the actual mailing date of the Office Action on May 19, 2011, and continued after the mailing of the Office Action.

Prior to June 8, 2011, the Patent Owner believed that the Harness firm's preparation for responding to the Office Action was on course and fully expected that a timely response would be ready and filed by the due date of July 19, 2011. This belief was based at least in part on communications with the Harness firm, including telephone calls and email messages relating to the Order granting the reexamination request and the Office Action.

B. Why The Requested Additional Time Is Needed

On June 8, 2011, without any prior notice, the Harness firm informed the Patent Owner that one of its clients recently had been acquired by a Defendant in the aforementioned lawsuit in which the subject patent is asserted. This acquisition resulted in a direct conflict of interest for the Harness firm. On June 9, 2011, the Harness firm informed the Patent Owner that it had elected to represent the Defendant and withdrew from representation of the Patent Owner with just over a month remaining until the due date of the Patent Owner's response to the Office Action.

Because of the direct conflict of interest now existing between the Harness law firm and the Patent Owner, none of the preparatory work performed by the Harness law firm since March 16, 2011 (when the Request for *Inter Partes* Reexamination was filed) is available to the Patent Owner or its new patent counsel.

The Patent Owner immediately initiated a search for new patent counsel and engaged Edell, Shapiro & Finnan LLC on June 14, 2011. The Patent Owner's new patent counsel has begun diligently reviewing the materials relating to this reexamination proceeding. However, as a result of the timing of the Harness firm's notice of withdrawal, nearly three months of preparation have been lost, and the Patent Owner has been left with very little time to prepare a complete response to the pending Office Action. Consequently, additional time is needed to allow sufficient time for the new patent counsel to become educated on the subject matter of the patent and the reexamination proceeding, and for the new patent counsel to work with the Patent

Owner to prepare a suitable response to the Office Action dated May 19, 2011. In view of these extenuating circumstances, Patent Owner respectfully requests that a one (1) month extension of time be granted.

C. Response to Analysis and Findings in Decision of June 20, 2011

In dismissing the original Petition requesting a two-month extension of time, the Decision notes that the Office Action mailed May 19, 2011 contains rejections relying on just two references; thus, the two month response period is considered sufficient to provide the Patent Owner with a fair opportunity to respond. Respectfully, this reasoning does not consider the complete scope of the effort required to fully respond to the Office Action under the present circumstances.

The Third Party Requester filed a 185-page Request for *Inter Partes* Reexamination containing extensive claim charts and arguments. To provide a complete response to the Office Action within the context of the Request, the Patent Owner's new patent counsel will need to study not only the Office Action but the Request, the related litigation between Patent Owner and the Third Party Requester cited in the Request, the documents relied upon in the Request, and the arguments, documents, and claim charts supporting the proposed grounds of rejection. In addition, the Patent Owner's new patent counsel will need to study the patent itself and its prosecution history.

It is unrealistic to assume that the Patent Owner will not need to address the Third Party Requester's proposed rejections and arguments at some point during prosecution or on appeal. Under the circumstances, the fraction of the two-month response period remaining when new patent counsel was secured does not provide sufficient time to consider the full record of the reexamination proceeding and places the Patent Owner at an unfair procedural disadvantage. Normally, the Patent Owner's counsel would have the opportunity to begin this time-consuming analysis at the time of the filing of the Request, which can be up to three months prior to the mailing date of the first Office Action. In this case, this analysis could not possibly have begun

with the Patent Owner's new patent counsel until almost a full month into the two-month response period.

Moreover, even assuming the Decision's argument that two months is a sufficient period to prepare a response is correct, the Patent Owner has effectively been given only one month. The Patent Owner lost nearly an entire month of the two-month response period (and several months of preparation ahead of that time that occurred since the Request for *Inter Partes* Reexamination was filed in March, 2011) due to the Harness firm's withdrawal. The Analysis and Findings section in the Decision notes that the Patent Owner spent one week of the two-month response period seeking new representation, which seems to suggest that the Patent Owner lost only one week of the two-month response period. The relevant fact, however, is not that the Patent Owner quickly acquired new patent counsel but rather that nearly one month of the two-month response period had elapsed by that point in time. The Harness firm did not inform the Patent Owner of its intent to withdraw until three weeks into the response period. If anything, the fact that the Patent Owner quickly found new patent counsel demonstrates its ongoing reasonably diligent behavior, which should not be held against the Patent Owner in requesting this one-month extension of time. If, as argued in the Decision, a two month period is a fair amount of time for the Patent Owner to prepare a response, then this Petition for a one-month extension of time should be granted to restore the nearly one month lost after the mailing date of the Office Action as a result of the withdrawal of the Harness firm. The additional month would do no more than restore the nearly one month lost through no fault of the Patent Owner. Thus, the Patent Owner respectfully submits that, taking into account the full scope of effort required to respond to the Office Action and the fraction of the two-month response period remaining at the time the new patent counsel was engaged, the request for a one-month extension of time is justified under the circumstances described above.

Credit card payment has been submitted concurrently with the filing of this transmittal for payment of the fee of \$200 under 37 C.F.R. § 1.17(g). The Director is hereby authorized to charge any additional appropriate fees that may be required for the above-identified reexamination proceeding, and to credit any overpayment, to Deposit Account No. **05-0460**.

Dated: June 22, 2011

Respectfully submitted by:

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