

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Reexam of Patent No. 7,987,285

Confirmation No.: 1919

Control No.: 90/019,523

Group Art Unit: 3992

Filed: May 24, 2024

Examiner: Michael Roswell

For: **ADAPTIVE BITRATE  
MANAGEMENT FOR STREAMING  
MEDIA OVER PACKET  
NETWORKS**

**Patent Owner's Petition for Extension  
of Time Under 37 C.F.R. § 1.550(c)**

Mail Stop *Ex Parte* Reexam  
Central Reexamination Unit  
Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

November 25, 2024

Dear Sir:

Pursuant to 37 C.F.R. § 1.550(c), Patent Owner OptiMorphix, Inc. ("OptiMorphix" or "Patent Owner") requests a two (2) month extension of time to respond to the first Office Action ("OA") mailed November 1, 2024. The extension is requested to allow reasonable time to prepare an amendment and/or response, which rejects all but two claims subject to reexamination on multiple combinations. The request is further based on circumstances as the response is prepared and limited availability of personnel, including an extraordinary number of non-extendible filings counsel must file in other matters in the holiday period leading up to the current January 2 deadline.

The maximum statutory period permitted for response ends May 1, 2025. 35 U.S.C. § 133; M.P.E.P. § 710.02(b). The OA (at 1) sets a deadline of New Year's Day, rolling to Thursday, **January 2, 2025**, which is two months from the Office Action. The requested deadline is Monday, **March 3, 2025**, as March 1, 2025 is a Saturday. The present petition is being filed with the fee specified under 37 C.F.R. § 1.17(g).

### **STATEMENT OF FACTS (“SOF”)**

1. On July 26, 2011, U.S. Patent No. 7,987,285 (the “’285 Patent” or “Patent-at-Issue”), issued with 16 claims, from an application filed on January 15, 2009 and a provisional application 60/948,917 filed on July 10, 2007.
2. The ’285 patent, owned by Patent Owner, was formerly a subject of litigated charges of patent infringement in federal court, as described below. *See infra* SOF ¶ 3.
3. Patent Owner’s district court litigations involving the ’285 patent have all been dismissed with one exception. On September 27, 2023, Patent Owner filed a federal district court litigation matter against, *inter alia*, Alphabet, Inc. for infringing fourteen patents; on October 23, 2023, Patent Owner filed a federal district court litigation matter against, *inter alia*, Amazon.com, Inc. for infringing twelve patents; on November 2, 2023, Patent Owner filed a federal district court litigation matter against Cisco Systems, Inc. for infringing nine patents; on December 20, 2023, Patent Owner filed a federal district court litigation matter against Microsoft Corporation for infringing ten patents; on October 11, 2024, Patent Owner filed a federal district court litigation matter against, *inter alia*, Brightcove Inc. for infringing eleven patents. Each of these matters involved the ’285 patent and each, with the exception of the matter filed October 11, 2024, have since been dismissed.
4. On May 24, 2024, the 34-page request for reexamination in the instant *ex parte* reexamination was filed (the total length of the filed document being 180 pages), requesting reexamination of the ’285 Patent claims 1, 6, 9-11, 14, and 15 (“Request”), and the matter was assigned Control No. 90/019,523.
5. On July 3, 2024, reexamination was ordered as to the 7 challenged claims.
6. On November 1, 2024, the Examiner issued a Non-Final Office Action rejecting the 7 challenged claims (SOF ¶4), addressing four references raised in the Request as well as the declaration of Dr. Karam submitted therewith. The OA enters non-final anticipation and obviousness rejections for claims 9, 10, and 15 based on one reference (anticipation) and one combination (obviousness), and claims 1, 6, 11, and 14 based on another reference (anticipation). The references used for anticipation include *van Beek* and *Yano*, while the references used for obviousness include *Urzaiz* in view of combinations of *Gupta*, further citing testimony in the Karam declaration.
7. Patent Owner’s counsel was retained in this case shortly prior to the Request due to related reexamination matters and is working with a technical subject matter expert.
8. Patent Owner’s counsel have their sole office at Santa Monica, California.

## **DISCUSSION**

Extensions of time to respond to an action in reexamination may be granted on a showing of "sufficient cause." 37 C.F.R. §1.550(c); M.P.E.P. § 2265. In this determination, the Office balances the requirement to conduct proceedings with special dispatch with "the desire to provide the patent owner with a fair opportunity to respond." M.P.E.P. § 2265.

Patent Owner respectfully requests an extension of time of two months to respond to the first Office Action in view of the nature, quantity and complexity of issues raised by the Action (SOF ¶ 6), the timing of counsel's retention with respect to this case (SOF ¶ 7), the voluminous relevant prior proceedings involving challenges and other interpretation of the patent rights challenged in this case (SOF ¶¶ 3, 6), the falling of the current due date exactly on the conclusion of the extended holiday period, and exactly on the same due date as another reexamination, and the extraordinary number of other, non-extendible filings in that holiday period in other cases which counsel must prepare and file. Despite diligent effort since the Office Action, it is already apparent that additional time is needed to prepare a response. Patent Owner respectfully specifies that given these circumstances and the course of the present reexamination to date, a reasonable period of extension is two (2) months.

Patent Owner notes that no prior extension of time has been requested or granted.

### ***I. There Is Sufficient Cause For Granting An Extension.***

This is "a first request for an extension of time" "in third party requested ex parte reexamination." M.P.E.P. § 2265(VI). That provision states in pertinent part:

[I]n third party requested ex parte reexaminations, a first request for an extension of time will generally be granted if a sufficient cause is shown, and for a reasonable time specified . . . . The reasons stated in the request will be evaluated by the CRU SPRS or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

Because no prior extension has been requested, no extraordinary situation need be shown for the present first request for extension to be granted. *Id.* The situation is amply supportive of an extension. For the reasons stated below, it is respectfully submitted that the present first request for an extension of time should be granted.

*a. Availability Of Counsel Is Limited.*

The availability of Patent Owner's counsel is unavoidably circumscribed in the current response period as well as the months following.

Patent Owner's counsel has been and will continue to be heavily engaged on numerous concurrent matters, including involvement in multiple pending *inter partes* reviews before the PTAB, *ex parte* reexaminations, reissue applications and reissue continuation applications, and appeal proceedings before the Office's reviewing Court. Most of these matters cannot be extended except by order of the relevant tribunal or with opposing parties' consent and present major filing deadlines that fall during, or closely follow, the period between this request and the current deadline of January 2, 2025 to respond to the Office Action.

For example, as to other cases, counsel must prepare and file two IPR responses on December 11, 2024 (IPR2024-01252/3), a response to reexamination office action on December 23, 2024 (two days before Christmas) (90/019,415), an IPR response on January 8, 2025 (IPR2024-00707), and a response to reexamination office action on January 23, 2024 (90/019,458).

Lastly and perhaps most significantly, on the very same day as the current **January 2** due date in this case, counsel has due a response to an office action in another reexamination (90/019,264).

These activities, in the circumstances, create a need for the extension requested here.

*b. Counsel Need Additional Time To Analyze The Patent, Related Patents, The Art, And The Office Action, And Conduct An Interview.*

Patent Owner's counsel have been diligently analyzing the patent, references, testimony submitted and relied upon, and Office Action. The Office Action, rejecting seven issued claims on two anticipation references and one obviousness combination, and the request papers on which it is based are of significant length and complexity and raise an unusual number of issues. Significantly:

- the OA is 12 pages, but the references on which it relies are 121 pages and the Karam Declaration on which it relies is 37 pages. SOF ¶ 6.
- the Request itself is 34 pages, but the full length of the Request document is 180 pages. SOF ¶ 4.

- the Request relies on six references, four of which the OA addressed, as well as a declaration, together amounting to 169 pages. Request, Exs. 1003, 1004, 1005, 1006, 1007, 1011, 1012; OA, 3.

These documents thus reflect a large number of issues that must be analyzed.

Furthermore, Patent Owner presently expects to request an Examiner interview to discuss the rejections, potentially amendments, and developments in related proceedings. Patent Owner and counsel will need sufficient time to prepare for this interview.

The necessity of an extension to accommodate the timeline above is further heightened due to the sharply limited availability of counsel, as discussed above.

*c. Additional Time Is Required To Ensure Appraisal Of Prior And Concurrent Litigation Activities Under 37 C.F.R. § 1.565(a).*

The effort required for appraisal of prior proceedings in this case is significantly increased because of the prior litigation of the '285 patent on top of the prior prosecution. (SOF ¶¶ 1-3). This additional complexity contributes to the need for an extension of time.

Patent Owner's counsel did not previously participate in any of the previous litigation proceedings involving the patent-at-issue (SOF ¶¶ 3, 7).

To prepare Patent Owner's response and satisfy its Rule 11.18(b) and other obligations, it is necessary for counsel to coordinate with counsel who have represented Patent Owner in other proceedings involving the '285 Patent, for review of what, if any, litigation materials bear on the response to the Office Action and must be disclosed; to determine pertinent positions taken and evidence; and to ensure consistency with positions. Patent Owner's litigation counsel from whom this information and with whom this coordination must be obtained has limited availability due to other unavoidable obligations.

*d. The Patent Owner's Activity To Date Has Been Reasonable and Diligent.*

In addition to the diligence already described above, an additional contributor to the complexity is that patents related to the patent-at-issue have been the subject of extensive litigation in numerous previous district court filings, and counsel in the present reexam have been analyzing these filings and underlying work and discussing the same with Patent Owner and Patent Owner's other counsel. Despite these limitations, Patent Owner and its associated consultants have already done significant work in connection with responding to the OA, but it is respectfully submitted that more time is needed.

## ***II. The Length Of The Extension That Patent Owner Requests Is Reasonable.***

As already noted, Patent Owner requests two (2) months extension of time. This extension is reasonable in the circumstances in light of the need to prepare testimony and other evidence, limited availability, and the Office Action's statements regarding extensions.

The M.P.E.P. states that a reasonable extension of time in third-party requested reexaminations is "usually one month," and that "requests for an extension of more than one month in third party requested reexaminations will only be granted in extraordinary situations." M.P.E.P. § 2265(VI). Such circumstances exist here, as shown above.

It is further noted that M.P.E.P. § 2265(VI) should be interpreted in light of M.P.E.P. § 2265(VII), which suggests that "an additional two months" is a reasonable extension of a shortened statutory period for response of even a rejection made final, let alone a non-final rejection presenting new rejections for the first time. It therefore follows that a two month extension of such a period is at least as, if not more, reasonable for responding to an office action presenting *new* rejections. M.P.E.P. § 2265(VII) states (emphasis added):

In any *ex parte* reexamination proceeding, ***including third party requested reexaminations . . .***, the filing of a timely first response to a ***final*** rejection ***having a shortened statutory period for response*** is construed as including a request to extend the shortened statutory period for an additional ***two months***, but in no case may the period for response exceed six months from the date of the final action.

To be sure, the rejections in the present Office Action are not made final (OA at 1-2), so M.P.E.P. § 2265(VI) is not by its terms applicable to Patent Owner's response to the present Office Action or to the present request for extension. However, it remains the case that the M.P.E.P. expressly contemplates a default construction of Patent Owner's response to final rejections in third party requested reexaminations as requesting extension of the shortened statutory period by two months.

It is further noted that "***no cause***" extensions of time of two months, and for-cause extensions of additional months, are available in patent owner requested or Director ordered *ex parte* reexaminations (M.P.E.P. § 2265(V)). While these provisions do not directly apply to the present request, they strongly suggest that depending on the circumstances, a reasonable time for extension may be significantly more than a single month.

Patent Owner is aware of no basis for deeming a two month extension of a shortened statutory period for response to an office action with new rejections *less* reasonable than such an extension for response to an office action that merely makes final *prior* rejections.

For this additional reason, it is respectfully submitted that two months is reasonable.

**CONCLUSION AND RELIEF REQUESTED**

Based on the foregoing, it is respectfully submitted that there is cause under 37 C.F.R. § 1.550(c) for a two (2) month extension of time, extending the time period to at least Monday, **March 3, 2025**, as March 1, 2025 falls on a Saturday, for Patent Owner to prepare its response to the Office Action.

If the requested two-month period of extension is not found to be for a reasonable time (*see* M.P.E.P. § 2265(VI)), an extension is respectfully requested for a reasonable time.

Date: November 25, 2024

Respectfully submitted,

/ Kenneth J. Weatherwax /  
Kenneth J. Weatherwax (Reg. No. 54,528)  
LOWENSTEIN & WEATHERWAX LLP