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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/019,476	04/09/2024	11455678	DKR678	4924
75120	7590	11/15/2024	EXAMINER	
Maulin Shah			WORJLOH, JALATEE	
Envision IP LLC			ART UNIT	PAPER NUMBER
2020 Progress Court			3992	
Suite 100-158			MAIL DATE	DELIVERY MODE
Raleigh, NC 27608			11/15/2024	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

November 15, 2024

UNIFIED PATENTS, LLC
4445 WILLARD AVE.
SUITE 600
CHEVY CHASE, MD 20815

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90019476
PATENT NO. : 11455678
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Decision on Petition for Extension of Time in Reexamination	Application No.: 90/019,476	Applicant(s): US 11,455,678	
	Examiner Jalatee Worjloh	Art Unit 3992	

1. THIS IS A DECISION ON THE PETITION FILED November 13, 2024.

2. THIS DECISION IS ISSUED PURSUANT TO:

A. ☒ 37 CFR 1.550(c) – The time for taking any action by a patent owner in a third party requested *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☐ 37 CFR 1.550(c) – The time for taking action by a patent owner in a patent owner requested *ex parte* reexamination proceeding will only be extended for more than two months for sufficient cause and for a reasonable time specified.

C. ☐ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS: Patent Owner requests that the time period for filing a response to the non-final Office action mailed on September 18, 2024, which set a two (2) month shortened statutory period for response, be extended by one (1) additional month.

4.

A. Petition fee per 37 CFR § 1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☒ Petition includes authorization to charge a credit card account.

iii. ☐ Other: _____.

B. ☐ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester).

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

5. DECISION (See MPEP 2265 and 2665)

A. ☐ Granted for: _____ or ☐ Granted-in-part for _____. 37 CFR 1.550(c) and 37 CFR 1.956).

i. ☐ Other/comment: _____.

B. ☒ Dismissed because:

i. ☒ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 3 above).

ii. ☒ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. See below.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☒ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☒ Other/comment: (See page 2 and 3 of the decision).

6. CONCLUSION: **The petition is Dismissed.**

Direct telephone inquiries to either <u>Stephen J. Stein</u> at <u>571-272-1544</u> or <u>Andrew J. Fischer</u> at <u>571-272-6779</u> .	/Stephen J. Stein/ Managing Quality Assurance Specialist, CRU
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Patent Owner's November 13, 2024 petition seeks an extension of time of one (1) additional month to file a response to the September 18, 2024 non-final Office action which set a two (2) month shortened statutory period for responding.

MPEP § 2265 VI states in relevant part:

Requests for any extension of time in third party requested reexaminations, and requests for an extension of more than two months from the time period set in the Office action in patent owner requested or Director ordered reexaminations, **must include a showing of sufficient cause**, and the extension must be for a reasonable time.

Any evaluation of whether sufficient cause has been shown for an extension must balance the need to provide the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceeding be conducted with special dispatch.

Any request for an extension of time, except for the "no cause" extension in patent owner requested or Director ordered reexamination provided in 37 CFR 1.550(c), must fully state the reasons therefor. **The reasons must include a statement of what action the patent owner has taken to provide a response as of the date the request for extension is submitted, and why, in spite of the action taken thus far, the requested additional time is needed. The statement must include a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.**

...

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.** [Emphasis added.]

Further, 37 CFR § 1.550(f) states:

The reexamination requester will be sent copies of Office actions issued during the ex parte reexamination proceeding. **After filing of a request for ex parte reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.** [Emphasis added.]

The November 13, 2024 Petition states:

"The Patent Owner filed a patent infringement suit under 35 U.S.C. § 271 against Shopify, Inc. on August 22, 2023 where the '678 Patent was asserted against the defendant (DKR Consulting, LLC v. Shopify, Inc., cacd-2:2023-cv-06904). On August 1, 2024, the district court found the claims of the '678 Patent invalid under 35 U.S.C. § 101.

The Office Action was issued approximately one month after the district court ruling. The Patent Owner was unsure as to whether an appeal to the district court decision would be filed, and thus, did not instruct its counsel to commence work on a response to the Office Action.

Ultimately, an appeal was filed at the Federal Circuit on October 29, 2024. Considering the recent filing of the appeal, the Patent Owner requests a one-month extension of time so that its counsel can diligently prepare a response to the Office Action.”

(See pages 1 and 2 of the November 13, 2024 petition).

Based upon a review of the entire November 13, 2024 petition and with particular emphasis on both MPEP § 2265 VI. and the portion of the November 13, 2024 Petition quoted above, the undersigned finds that Patent Owner has, among other things, failed to provide any “statement [which] include[s] a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.”

In addition, the undersigned finds that Patent Owner has not established any showing of sufficient cause, that when balanced with the statutory requirement of special dispatch under 35 USC § 305, warrants that granting of an extension of time beyond the 2 month period for response given in the September 18, 2024 non-final Office action. Patent Owner’s sole basis for their request for a one-month extension of time is that Patent Owner did not instruct their counsel to commence work on responding to the non-final Office action until deciding on whether to appeal the district court’s holding of invalidity of the claims of the ‘678 patent.

This reasoning does not establish sufficient cause to grant Patent Owner’s petition. A decision as to whether to appeal a district court decision related to the patent is completely ancillary to responding an outstanding Office action in a pending reexamination proceeding. At most, such reasoning is merely a financial or manpower resources consideration. Thus, when balanced with requirement of special dispatch, this reasoning does not rise to the level of sufficient cause so as to grant the petition.

In addition, it is noted that Patent Owner has not submitted any certificate of service which indicates that Patent Owner has served a copy of the petition on third party requester, as required by 37 CFR §1.550(f).

Accordingly, the November 13, 2024 Petition for a one (1) month extension of time is hereby **dismissed**.

Patent Owner’s time for responding to the September 18, 2024 non-final Office action remains due two (2) months from the mailing date of that Office action.