

the final Office Action dated June 14, 2011, in the above-identified *ex parte* reexamination. The new deadline for response would be September 14, 2011. This is the first request for an extension.

The request for *ex parte* reexamination of the above identified U.S. Patent No. 6,064,970 (“the ‘970 patent”) was filed on September 22, 2010. The request was granted on November 24, 2010. On March 7, 2011, a non-final Office Action issued and a Response was filed on April 6, 2011. A final Office Action was mailed on June 14, 2011 (more than two months after the Patent Owner’s Response), but was not available until June 15, 2011. The final Office Action sets a response date of one month from mailing, *i.e.*, July 14, 2011.

Because the Patent Owner has one last opportunity to present arguments and evidence as a matter of right to the examiner during this reexamination proceeding, such a short period of time is inadequate to prepare a full and complete response, particularly in a case where the patent is the subject of complex litigation. Further, as discussed below, the reply to the pending final Office Action is due two weeks before the Patent Owner’s arguments and/or amendments (*e.g.*, through the Patent Owner Statement) are due for a second reexamination filed by the same Third Party Requestor. The Patent Owner submits that due to these reasons, and those explained below, sufficient cause exists for extending the time for responding to the Office Action by two months.¹

Patent Owner’s prosecution counsel has been diligently reviewing the final Office Action and the references cited therein. Specifically, prosecution counsel, with the assistance of representatives of the Patent Owner, has been actively analyzing the final Office Action and working on a response during this one-month shortened statutory period. This work has included additional review of the

¹ If granted, a two month extension of time would provide the Patent Owner with an amount of time that is normally given to Patent Owners not subject to a stayed litigation but granted a one month extension. If a two month extension is not granted, in the alternative, the Patent Owner requests a one month extension. Since August 14th falls on a Sunday, the Patent Owner requests that the period for filing (if extended for one month) run to and include August 15, 2011.

prior art applied in the rejections of the claims and the examiner's response to the Patent Owner's arguments. Conversations between the undersigned and other representatives of the Patent Owner responsible for assisting prosecution counsel have occurred from the time of receipt of the final Office Action through today. Also, prosecution counsel is conducting research for documents in support of positions expressed in the Patent Owner's April 6, 2010 Response and the new extrinsic evidence partially cited in the final Office Action (*i.e.*, *Barron's Dictionary of Finance and Investment Terms*; *Barron's Dictionary of Legal Terms, etc.*). Only a portion of the documents found have been reviewed to date and the new extrinsic evidence has not been found. The final Office Action is over 200 pages long and introduces new explanations and rationale in rejecting the claims besides referencing the prior 220 page non-final Office Action for additional support through multiple incorporations by reference, *see e.g.*, pgs. 52 and 191 (enlarging the final Office Action to over 400 pages). Analyzing the Office Action in preparation for a response has already taken a significant amount of time and will continue to take a large amount of time and resources.

Furthermore, since the final Office Action addresses declarations submitted by two different experts under 37 C.F.R. § 1.132, the Patent Owner will submit responsive declarations if necessary. After prosecution counsel completes an initial analysis, additional time will be needed to confer with these experts in connection with any potential responsive declarations. For example, prosecution counsel's initial analysis found 58 rejections under 35 U.S.C. § 112, second paragraph, that the experts may need to review. Conversations between the experts of record and prosecution counsel have already occurred, however, their availability is very limited in this shortened period, in part, due to prior business commitments and the July 4th holiday. Ms. Vecchioli is unavailable from June 29 – July 4, and Mr. McMillan is unavailable July 4, 6-8, and 11. In view of the Office Action's length (collectively over 400 pages), the number of rejections, and due to the limited availability of the

experts of record, the current deadline does not provide a fair opportunity for the experts to review the rejections, confer with counsel, and assist in the preparation of a response.

Moreover, the '970 patent is currently involved in two separate actions.

- *Progressive Casualty Ins. Co. v. Safeco Ins. Co. of IL* No. 1:10-cv-01370 (N.D. Ohio); and
- *Progressive Casualty Ins. Co. v. Allstate Ins. Co.* No. 1:11-cv-00082 (N.D. Ohio).

Prosecution counsel also needs to review the public records in these proceedings to ensure the analysis of the final Office Action and the Patent Owner's response is consistent with the Patent Owner's briefings.

Finally, prosecution counsel must analyze the Reexamination Request (filed by the same Third Party Requestor) involving another patent assigned to the Patent Owner. In particular, two Orders for reexamination were granted in Reexamination Control No. 90/011,612 (involving U.S. Patent No. 7,124,088). The Request for Reexamination and references it relies on are over 680 pages long. The Patent Owner's arguments and/or amendments (e.g., through the Patent Owner Statement) are due about two weeks (July 31, 2011) after a reply is due for this Office Action. Unless an extension is granted, the co-pendency of the multiple replies, with the complex issues each raise, will unfairly limit the time available for the Patent Owner to formulate a response.

By granting this extension, the Patent Owner will be provided with a fair opportunity to defend a patent awarded by the United States Patent Office and which resulted in a substantial investment in a new program now offered in 35 states that evaluates insurance parameters on when, where, and how much a vehicle is driven. Besides investing in the '970 patent's prosecution and now its defense, the Patent Owner is a practicing entity that has made a substantial investment in its commercial embodiments since introducing the program and its devices in Texas in 1998. A two

month extension will allow the Patent Owner a fair opportunity to present arguments and evidence in this reexamination proceeding and allow the Patent Owner to defend its investment, while still preserving the special dispatch requirement that is required for reexaminations.

Based on the foregoing, the Patent Owner respectfully submits that the current circumstances represent "sufficient cause" under 37 C.F.R. § 1.550(c). The Patent Owner therefore respectfully requests that this Petition be granted and that the time period for response be extended by two months. A copy of this submission is being served on the Third Party Requester pursuant to 37 C.F.R. § 1.550(f) as indicated on the attached certificate of service. The petition fee under 37 C.F.R. § 1.17(g) is being submitted herewith. The Commissioner is hereby authorized to charge any fee deficiencies, or credit any overpayments, to Deposit Account No. 23-1925 under Request 12741-32.

Respectfully submitted,

Date: June 21, 2011

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CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: June 21, 2011 Name: James A. Collins Signature: /James A. Collins/

**BRINKS
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& LIONE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Ex parte Reexamination of U.S. Patent 6,064,970

Robert J. McMillan, et al.

Patent Filing Date: August 17, 1998

Reexamination Filing Date: September 22, 2010

Control No.: 90/011,252

For: **MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE**

Examiner: Karin M. Reichle

Group Art Unit: 3992

Conf. No.: 4116

Attorney Docket No.: 12741/32

CERTIFICATE OF SERVICE

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that a true copy of the foregoing **PATENT OWNER'S PETITION FOR EXTENSION OF TIME FOR RESPONSE PURSUANT TO 37 C.F.R. § 1.550(c)**, was served this June 21, 2011 by First Class United States Mail, postage prepaid, on:

J. Steven Baughman
Ropes & Gray LLP
One International Place
Boston, MA 02110

Respectfully submitted,

June 21, 2011
Date

/James A. Collins/
James A. Collins (Reg. No. 43,557)

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