No. 18-A-___

IN THE SUPREME COURT OF THE UNITED STATES

HP INC., f/k/a HEWLETT-PACKARD COMPANY,

Applicant,

v.

STEVEN E. BERKHEIMER,

Respondent.

APPLICATION TO THE HONORABLE JOHN G. ROBERTS, JR., CHIEF JUSTICE, FOR AN EXTENSION OF TIME WITHIN WHICH TO FILE A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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RULE 29.6 STATEMENT

HP Inc. is a publicly traded company. No publicly held corporation owns 10% or more of the stock of HP Inc.

TO THE HONORABLE JOHN G. ROBERTS, JR., CHIEF JUSTICE OF THE SUPREME COURT OF THE UNITED STATES AND CIRCUIT JUSTICE FOR THE FEDERAL CIRCUIT:

Pursuant to Supreme Court Rules 13.5, 22, and 30, Applicant respectfully requests a 30-day extension of time, up to and including September 28, 2018, to file a petition for a writ of certiorari to the United States Court of Appeals for the Federal Circuit to review that court's decision in *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018) (attached as Exhibit A). A petition for rehearing *en banc* was denied on May 31, 2018 (attached as Exhibit B). The jurisdiction of this Court will be invoked under 28 U.S.C. § 1254(1), and the time to file a petition for a writ of certiorari will expire without an extension on August 29, 2018. This application is timely because it has been filed more than ten days prior to the date on which the time for filing the petition is to expire.

1. This case presents substantial and important questions involving Section 101 of the Patent Act. As this Court has held, Section 101 "contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable." *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). This Court has created a two-part test to determine patent eligibility: The first step is whether the claims (as a whole) are directed to a patent-ineligible concept under Section 101, such as an abstract idea or a law of nature. If they are, then the second step instructs courts to ask whether the limitations add

significantly more to "transform a patent-ineligible abstract idea into a patent-eligible invention." *Alice*, 134 S. Ct. at 2351; *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77 (2012) (same for laws of nature). The second step of the Section 101 inquiry requires courts to "examine the elements of the claim" to determine whether it contains an "'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Alice*, 134 S. Ct. at 2357. The inquiry must focus on "the steps in the claimed processes" "apart from the [patent-ineligible concept]." *Mayo,* 566 U.S. at 73.

After this Court's decisions in *Alice* and *Mayo,* district courts and the Federal Circuit routinely decided issues of patent eligibility raised in motions to dismiss stage and motions for summary judgment. As Judge Reyna, dissenting from the denial of rehearing *en banc* in this case, explained: "Perhaps the single most consistent factor in this court's § 101 law has been our precedent that the § 101 inquiry is a question of law." Reyna Dissent at 2. In this case, for the first time, the Federal Circuit held that disputed issues of material fact precluded summary judgment on patent eligibility. This decision marks a sea change in the Federal Circuit's Section 101 jurisprudence and dramatically constrains the effects of *Alice* and *Mayo.*

The petition for a writ of certiorari will present the following questions: (1) Whether courts should determine whether claims are patent eligible as a matter of law or whether, as the Federal Circuit held, patent eligibility can turn on disputed questions of fact; and (2) Whether the Federal Circuit correctly held that the test for an "inventive concept" is whether the claim limitations are well-understood, routine, and conventional to a skilled artisan at the time of the patent.

2. Applicant has recently added additional counsel to assist in the preparation of a petition for a writ of certiorari. The extension is needed for the newly added counsel to fully analyze the record, decisions below, and relevant statutes and case law. The additional time will also permit potential *amici* to bring important practical implications of the Federal Circuit's decision to the Court's attention. In addition, Applicant's counsel have several deadlines in other matters that will limit counsels' availability to work on this matter between today and August 29, 2018.

Accordingly, Applicant respectfully requests that an order be entered extending the time to file a petition for a writ of certiorari for 30 days, up to and including September 28, 2018.

Dated: July 20, 2018

Respectfully submitted,

/s/ David B. Salmons

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