

No.

IN THE
Supreme Court of the United States

STEPHEN THALER

Petitioner,

v.

KATHERINE K. VIDAL, Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office;
UNITED STATES PATENT AND TRADEMARK OFFICE,

Respondents.

**APPLICATION 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**

Application to the Honorable John G. Roberts, Jr.,
as Circuit Justice for the Federal Circuit

Pursuant to Supreme Court Rule 13.5, Applicant Stephen Thaler requests a 60-day extension of time, to and including March 20, 2023, within which to file a petition for a writ of certiorari.

1. The decision below is *Thaler v. Vidal*, No. 21-2347 (Fed. Cir. 2022). The Federal Circuit issued its opinion on August 5, 2022, *see* App. A, and denied rehearing and rehearing en banc on October 20, 2022, *see* App. B. Unless extended, Applicant's time to seek certiorari in this Court expires January 18, 2023. Applicant is filing this application at least ten days before that date. *See* S. Ct. R. 13.5. This

Court's jurisdiction would be invoked under 28 U.S.C. § 1254(1). Respondents do not object to this extension request.

2. An extension is warranted because Dr. Thaler only recently engaged additional counsel—Mark Davies and the Orrick firm—to assist him before the Supreme Court. Neither Mr. Davies nor Orrick represented Petitioner at any earlier point in the lengthy proceedings below, before any of the Patent Office, district court, or the Federal Circuit.

3. An extension is also warranted because this case presents novel, complex, and fundamental issues of patent law, including the Federal Circuit's interpretation of Congress's inventorship requirement enshrined in the Patent Act and its application to new technological methods of invention. Specifically, this case arises from the Federal Circuit's denial of a patent to an invention created by an artificial intelligence (AI) system, holding that an AI system is categorically unable to meet the definition of "inventor" under the Patent Act. The questions presented in Dr. Thaler's petition will have a significant impact on Congress's carefully balanced scheme for protecting the public interest in promoting innovation and ensuring the United States' continued international leadership in the protection of intellectual property. An extension of time will help to ensure that the petition effectively presents the important issues raised by this complex case.

4. Good cause also exists for an extension because of the press of business on other pending matters that have thus far affected counsel's availability and will continue to do so. The undersigned is responsible for ongoing activities in *Thaler v.*

Perlmutter, No. 1:22-cv-01564-BAH (D.D.C.), including summary judgment motions due on January 10, 2023, and responses due on February 7, 2023; a hearing on a motion for new trial and JNOV in *Andrews v. RA_Bar Beauty Inc.*, No. SC129884, (Cal. Sup. Ct, L.A., West Dist.), on January 13, 2023; an all-day mediation in *Pro-Immune Co., LLC v. Lile*, No. 7:22-cv-07242-KMK (S.D.N.Y.), on January 16, 2023; oral argument in *Thaler v. Comptroller-General of Patents*, No. 2021/0201 (U.K. Supreme Court), on March 2, 2023; and ongoing activities in *Tom v. Stanford*, No. 20CV367303 (Cal. Sup. Ct., Santa Clara), including summary judgment briefing due on March 7, 2023. In addition, recently-engaged co-counsel Mark S. Davies has been responsible for a brief in *Sonos v. Google*, Nos. 22-1421, 22-1573 (Fed. Cir.), filed on December 21, 2022; and a brief in *Apple Inc. v. Corephotonics, Ltd.*, No. 22-1350 (Fed. Cir.), filed on December 23, 2022; and is responsible for a brief in *Sentius International, LLC v. Apple Inc.*, No. 22-1980 (Fed. Cir.), due January 19, 2023; and an amicus brief in *Lacy v. San Francisco*, No. A165899 (Cal. App.), due February 14, 2023.

5. For the foregoing reasons, Applicant hereby requests that an extension of time be granted, up to and including March 20, 2023, within which to file a petition for writ of certiorari. The requested 60-day extension would cause no prejudice to Respondents, who have advised that they have no objection to the extension.

Respectfully submitted,

/s/Ryan Abbott

Ryan Abbott

Counsel of Record

BROWN, NERI, SMITH & KHAN, LLP

11601 Wilshire Blvd., Ste. 2080

Los Angeles, CA 90025

(310) 593-9890

ryan@bnsklaw.com

Mark S. Davies

ORRICK, HERRINGTON & SUTCLIFFE LLP

1152 15th Street, NW

Washington, DC 20005

(202) 339-8400

mark.davies@orrick.com

January 6, 2023