No. _____

In the Supreme Court of the United States

INGENIO, INC., D/B/A KEEN, ETHER, THRYV, INC., APPLICANTS,

v.

CLICK-TO-CALL TECHNOLOGIES LP, Respondents.

APPLICATION FOR EXTENSION OF TIME TO FILE A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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To the Honorable John G. Roberts, Jr., Chief Justice and Circuit Justice for the United States Court of Appeals for the Federal Circuit:

Applicants Ingenio, Inc., d/b/a Keen, Either, and Thryv, Inc. (collectively, "Thryv"), respectfully request that the time to file a petition for a writ of certiorari in this case be extended for 30 days, to and including March 9, 2023. The United States Court of Appeals for the Federal Circuit issued its opinion on August 17, 2022. (App. A, *infra*.). Thryv timely filed a combined petition for panel rehearing and rehearing en banc on September 16, 2022, which was denied by the Federal Circuit on November 9, 2022 (App. B, *infra*.). Thus, without an extension of time and pursuant to S. Ct. R. 13.3, Thryv's petition would be due on February 7, 2023, 90 days after the denial of the petition for rehearing in the Federal Circuit. Thryv files this application more than 10 days before that date, and no prior application has been made in this case. S. Ct. R. 13.5. This Court's jurisdiction would be involved under 28 U.S.C. § 1254(1).

Background

This case is the sister case to the *inter partes* review ("IPR") considered by this Court in *Thryv, Inc v. Click-to-Call Technologies, LP*, 140 S. Ct. 1367 (2020). This case was originally filed in the U.S. District Court for the Western District of Texas in May, 2012, but was stayed pending Thryv's IPR. In addressing Thryv's IPR, the PTAB elected not to institute as to certain grounds and claim 27 addressed in Thryv's petition but instead focused its institution and ultimate review on other claims and a different ground. App. A, at 4. Thryv's IPR ultimately resulted in a finding that the other claims as to which IPR was instituted were invalid.

Click-to-Call appealed the IPR decision based on a procedural challenge to the PTAB's ruling that Thryv's IPR was not time-barred, but did not challenge the substance of the invalidity determination. *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1327-28 (Fed. Cir.

2018). The Federal Circuit eventually decided that the IPR had been time-barred, and that the issue was appealable. *Id.* Thryv then petitioned for certiorari, which this Court granted. This Court held that the PTAB's ruling on the time bar was not appealable, and therefore the PTAB's finding of invalidity stood. *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1372 (2020).

Following this Court's decision on Thryv's IPR, the district court lifted the stay of this case to consider disposition of dependent patent claims 24, 26 and 27 that had not been instituted or addressed in the IPR. Thryv moved for summary judgment that only one such claim was relevant to the case and that all of three of the dependent claims were invalid. The district court found that only claim 27 properly remained in the case, and further found that claim 27 was invalid as anticipated. App. A, at 5. Click to Call appealed, urging among other issues that Thryv was estopped from challenging the validity of claim 27.

During the pendency of the resulting appeal, the Federal Circuit decided *Cal. Inst. of Tech. v. Broadcom Ltd*., 25 F.4th 976, 989 (Fed. Cir. 2022) ("*Caltech*"), and in the process overruled *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016), a case that confirmed that estoppel did not apply to claims that were not adjudicated in an IPR's final written decision. On August 17, 2021, relying on *Caltech's* overruling of *Shaw*, the Federal Circuit granted-in-part Click-to-Call's appeal, reversing the district court's determination that Thryv was not estopped under 35 U.S.C. § 315(e)(2) from asserting the invalidity of claim 27 based on anticipation by Dezonno and, accordingly, its determination of invalidity. App. A at 11, 16.

Apple was one of the defendants in the *Caltech* case and petitioned for certiorari on September 7, 2022. *Apple Inc., v. California Institute of Technology*, Docket No. 22-203, Pet. For Writ of Certiorari. The question presented in Apple's petition is:

> Whether the Federal Circuit erroneously extended IPR estoppel under 35 U.S.C. § 315(e)(2) to all grounds that reasonably could have been raised in the petition filed before an inter partes review is instituted, even though the text of the statute applies estoppel only to grounds that "reasonably could have [been] raised during that inter partes review."

Id., at (i). This Court has initially considered Apple's petition and issued an order on January 17, 2023 calling for the views of the Solicitor General.

Reasons for Granting an Extension of Time

The time to file a petition for a writ of certiorari should be extended for 30 days for the following reasons:

1. Since the decision below was issued, Applicants' counsel has been considering the record below and the legal issues in the case and similarly situated cases in order to prepare a petition. Counsel has a number of other pending matters with proximate due dates that would interfere with counsel's ability to file the petition on or before February 7, 2023. A 30-day extension would allow counsel sufficient time to fully examine the decision below and lengthy case records, research and analyze the issues presented and prepare the petition for filing.

2. No prejudice would arise from the requested extension. Respondent CTC will not be harmed in the event that this Court extends the time for Thryv's petition by 30 days. Additionally, this Court should in the interim receive the benefit of the Solicitor General's views on Apple's petition for certiorari, which raises similar issues to those to be addressed by Thryv's petition.

3. There is a reasonable prospect that this Court should grant the petition. The Federal Circuit's decision conflicts with the plain text of 35 U.S.C. § 315(e)(2). That section is clear that when there is "inter partes review of a claim in a patent [] that results in a final written decision," the petitioner may not assert that "***the claim*** is invalid on any ground that the

petitioner raised or reasonably could have raised during that inter partes review." *Id*. (emphasis added). In other words, IPR estoppel only applies to claims that are addressed during IPR proceedings and result in a final written decision. By expanding statutory estoppel to cover any claim that could have been raised in a petition before an IPR is instituted, but which was not addressed in the actual IPR as instituted, the Federal Circuit effectively rewrote the statute. To reach such a result required the Federal Circuit to overrule prior precedent. In light of both the importance of the issue and the division within the Federal Circuit there is a reasonable prospect that the Court should grant the petition.

Conclusion

For these reasons, Applicants respectfully request that the time to file a petition for a writ of certiorari should be extended 30 days to and including March 9, 2023.

DATED: January 25, 2023.

Respectfully submitted,

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RULE 29.6 CORPORATE DISCLOSURE STATEMENT

Petitioners are Ingenio, Inc. d/b/a Keen, Ether, a division of Ingenio, Inc. and Thryv, Inc., which are wholly owned subsidiaries of Thryv Holdings, Inc., a publicly traded company.