No. _____

IN THE

Supreme Court of the United States

VIRENTEM VENTURES, LLC,

Applicant,

v.

GOOGLE LLC,

Respondent.

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

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

1. Pursuant to Supreme Court Rules 13.5, 22, and 30, Applicant Virentem Ventures, LLC respectfully requests an extension of fifty-nine (59) days to file a petition for a writ of certiorari in this Court, to and including April 21, 2023. The United States Court of Appeals for the Federal Circuit entered judgment in seven separate appeals, which were consolidated into three Federal Circuit proceedings, each captioned as *Virentem Ventures, LLC v. Google LLC*, all of which were summarily affirmed under Federal Circuit Rule 36 in Judgments entered on November 21, 2022. Applicant therefore seeks an extension for the following Federal Circuit proceedings:

a. No. 2021-1764 as the lead case consolidating Nos. 2021-1764, -1765, -1804, and -1822;

b. No. 2021-1805 as the lead case consolidating Nos. 2021-1805 and -1806; and

c. No. 2021-1934.

See 1a-6a.

2. Counsel for Applicant contacted Counsel for Respondent before the start of business on February 8, 2023 to ascertain whether Respondent would consent to the requested extension, but has not received any response.

3. Without an extension, the petition for a writ of certiorari in each of these appeals is due on February 21, 2023. Pursuant to Supreme Court Rule 13.5, this application is being filed more than 10 days before that date. The jurisdiction of this Court will be invoked under 28 U.S.C. § 1254.

4. Each of these cases presents important issues regarding claim construction jurisprudence and how the Federal Circuit applies the canons of claim construction. In particular, the petition will focus on the Federal Circuit's use of Rule 36 affirmances in cases where a Patent Owner argues for and is denied a narrow claim construction based on the same well-established canons of claim construction that are regularly invoked to adopt or affirm narrow constructions when requested by a patent challenger.

5. This Court determined that claim construction is a question of law. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996). It follows, then, that the construction of a claim term should be the same regardless of which party

requests that it be construed. But the outcomes in the underlying appeals and the initial results of an on-going statistical analysis of over a decade's worth of Federal Circuit outcomes (including, in particular, positions summarily rejected by the Federal Circuit through its use of "Rule 36" affirmances in appeals in which claim construction challenges were raised), suggest that is not the case.

6. For example, certain claim construction doctrines, such as the doctrine of prosecution disclaimer—which as the Federal Circuit explained in *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323–24 (Fed. Cir. 2003), is "well established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution" and "a fundamental precept in [the Federal Circuit's] claim construction jurisprudence"—are consistently used to limit claims when requested by a patent challenger, but not when requested by the patentee. Aside from the fundamental notion that a question of law should be decided the same way regardless of which party is advocating that such a doctrine be invoked, the rationale underlying this doctrine provides no justification for disparate application. The doctrine stems from the notion that the patentee should be limited to what she told the public (via interactions with the Patent Office) she invented; it stands to reason that, she should be equally free to advocate that same meaning to an arbiter of infringement or validity, as long as she advances the same meaning in all contexts. But critically, the Federal Circuit regularly uses Federal Circuit Rule 36 affirmances to dispense with appeals where a patentee requested a narrowing construction in the proceeding below, including based on prosecution disclaimer, without providing a

written opinion or providing its reasoning for refusing to apply the doctrine—leaving litigants and the public with only speculation as to how the Federal Circuit interprets and applies legal doctrine that informs (or, in many cases, is determinative of) whether a patent claim is valid or infringed.

7. In the cases at issue here, Patent Owner proposed limiting constructions of certain claim terms. One critical construction was based on clear, unequivocal, and undisputed statements in the prosecution history in which the patentee declared to the public what he invented. *See Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940); *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1332 (Fed. Cir. 2003). The Patent Trial and Appeal Board ("PTAB") rejected Patent Owner's limiting constructions, and instead adopted broad claim constructions that, when applied to the prior art of record, it determined invalidated all challenged claims of seven patents across three patent families. The Federal Circuit affirmed each of PTAB's seven Final Written Decisions without opinion. *See* 1a-6a.

8. Several petitions for a writ of certiorari have questioned the Federal Circuit's use of Rule 36 affirmances, including with regard to PTAB decisions.[1] And there has been much public commentary on the issue as well.[2] This petition,

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[1] *See, e.g.*, *Fote v. Iancu*, 206 L. Ed. 2d 938, 140 S. Ct. 2765 (2020); *SPIP Litigation Group, LLC v. Apple, Inc.*, 2019 WL 4072816 (U.S.).

[2] *See, e.g.*, G. Quinn & S. Brachmann, *No End in Sight for Rule 36 Racket at Federal Circuit*, IP WATCHDOG, Jan. 29, 2019, https://ipwatchdog.com/2019/01/29/no-end-sight-rule-36-racket-cafc/id=105696/; D. Crouch, *Federal Circuit Continues to Remain Silent about its R.36 Opinions*, PATENTLY-O, Jan. 14, 2021,

however, will take the new approach. Virentem will invite and enable this Court to analyze the substance of the disparate application of the canons of claim construction in cases where the Federal Circuit affirmed under Rule 36.

9. To support its Petition, Virentem is undertaking a comprehensive quantitative and qualitative study and statistical analysis of approximately a decade's worth of Federal Circuit decisions, including Rule 36 affirmances, where a primary issue presented on appeal was claim construction. There is good cause for the requested extension because the analysis of the briefing in these cases where there is no written opinion is time consuming. Virentem requires additional time to complete this review and analysis to support its petition for writ of certiorari.

10. In addition, Virentem recently retained a statistical expert and scientific advisor who was not involved in the proceedings below to assist in the preparation of its petition. This extension of time is necessary to allow the expert to familiarize himself with the record, and to conduct empirical studies on Federal Court decisions related to the matters raised by the proceedings below. Applicant requires additional time to prepare the petition based on his analysis and findings.

11. WHEREFORE, for the foregoing reasons, Applicant respectfully requests that an order be entered extending the Applicant's time to file a petition for a writ of certiorari for fifty-nine (59) days, to and including April 21, 2023.

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https://patentlyo.com/patent/2021/01/federal-continues-opinions.html; R. Lindhorst, *Because I Said So: The Federal Circuit, The PTAB, and the Problem With Rule 36 Affirmances*, 69 CASE W. RSRV. L. REV. 247 (2018), *available at* https://scholarlycommons.law.case.edu/caselrev/vol69/iss1/9.

Respectfully Submitted,

Dated: February 10, 2023

/s/ Denise M. De Mory

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Corporate Disclosure Statement

VIRENTEM VENTURES, LLC has no parent corporations and no publicly held companies own 10% or more of stock in the party.