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IN THE  
**Supreme Court of the United States**

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PERSONALIZED MEDIA COMMUNICATIONS, LLC,  
*Applicant,*

v.

APPLE, INC.

*Respondent.*

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**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**

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June 16, 2023

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## **RULE 29.6 STATEMENT**

Applicant Personalized Media Communications, LLC, has no parent corporations and no publicly held company owns 10% or more of its stock.

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:

Pursuant to Supreme Court Rule 13.5, Personalized Media Communications, LLC (PMC), respectfully requests a 30-day extension of time, until September 7, 2023, within which to file a petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case. For the following reasons, good cause exists for PMC's extension request.

1. The Federal Circuit issued a precedential decision and entered judgment in this case on January 20, 2023. See *Personalized Media Commc'ns v. Apple, Inc.*, 57 F.4th 1346 (Appendix A). The court of appeals denied PMC's timely petition for rehearing and rehearing en banc on May 10, 2023 (Appendix B). Unless extended, the time to file a petition for a writ of certiorari will expire on August 8, 2023. The jurisdiction of this Court would be invoked under 28 U.S.C. §1254(1).

2. PMC seeks review of a split decision of the Federal Circuit that invalidated one of PMC's patents under the judge-made doctrine of prosecution laches. As Judge Stark explained in dissent below, the panel majority incorrectly found that PMC engaged in unreasonable and unexplained delay of the prosecution of its patent application during PMC's "years of" cooperation with the U.S. Patent and Trademark Office (PTO). Appendix, *infra*, at 32a (App. 32a). The Federal Circuit's precedential decision, which allows judges to second-guess the PTO's reasonable docket-management decisions and cancel patents long after they have issued, warrants this Court's review.

3. As the petition will explain, PMC's founder, John Harvey, pioneered novel communications technology using signals embedded in broadcast programming. *See* C.A. App. 5608-5609. PMC filed patent applications related to that technology in 1981 and 1987 and secured a number of patents between 1987 and 1994. *See* C.A. App. 8075-8077.

4. In 1994, Congress passed the Uruguay Round Agreements Act, Pub. L. 103-465, 108 Stat. 4809, which changed the duration of a U.S. patent from 17 years after issuance of the patent to 20 years after the filing of the patent application. As part of this change, Congress grandfathered applications filed before June 8, 1995. *See* 35 U.S.C. §154(a)(2), (c)(1); 37 C.F.R. §1.129.

5. In the run-up to the June 1995 deadline, PMC conducted a detailed study of the specifications of its 1981 and 1987 applications and concluded that they "disclosed many separate and distinct inventions which had not yet been patented." C.A. App. 38488. Accordingly, PMC filed 328 applications—one for each invention it had identified—between March and June of 1995. C.A. App. 8077.

6. To streamline review of these applications, PMC and the PTO entered into a "consolidation agreement" in 1999. *See* C.A. App. 27639. The agreement reduced the number of PMC's applications and grouped them into 56 subject-matter categories. *See* C.A. App. 27711-27735. PMC and the PTO agreed that patent examiners would focus first on relatively undisputed applications (designated "A" applications), before turning to companion applications that required further analysis (designated "B" applications). *See* C.A. App. 40250-40252.

7. The patent at issue in this lawsuit—U.S. Patent No. 8,191,091 (’091 patent)—originated as one of the “B” applications whose examination would be deferred until after that of the related “A” application. C.A. App. 8079, 8082. The PTO expressly acknowledged this arrangement, confirming in correspondence with PMC that, “per the consolidate[ion] agreement,” its examination of the relevant “B” application would be “suspended and held in abeyance pending the outcome of the corresponding ‘A’ application.” C.A. App. 16847-16848.

8. PMC engaged in good-faith efforts to advance the prosecution of its applications, consistent with the A/B tracking system. In 2003, however, the PTO suspended examination of all of PMC’s pending applications while it reexamined certain previously issued patents. *See* PMC C.A. Br. 20-22. PMC objected and repeatedly tried to restart examination, but the PTO did not lift the suspensions until 2009. *See id.*; *see also* C.A. App. 9568.

9. After examination resumed in 2009, the PTO began issuing patents to PMC almost immediately. The PTO issued 41 patents in 2010, 14 patents in 2011, and 2 patents—including the ’091 Patent—in 2012. *See* C.A. App. 8526, 9569.

10. PMC brought this lawsuit to seek recovery for Apple’s infringement of the ’091 patent. Apple uses a software called “FairPlay” that it began to develop in the early 2000s to protect digital content delivered to customers through its iTunes and App Stores. C.A. App. 8085. As PMC explained during a week-long trial, FairPlay infringes several claims of the ’091 patent. Apple did not contest the validity of the ’091 patent under 35 U.S.C. §§102, 103, or 112 at trial, instead arguing only that

its FairPlay software was noninfringing. The jury found Apple liable for infringement and awarded PMC \$308.5 million in damages. C.A. App. 3694-3700.

11. The district court threw out the jury's verdict, concluding that the '091 patent is unenforceable under the equitable doctrine of prosecution laches. C.A. App. 30-38. Under Federal Circuit precedent, to prove prosecution laches, an accused infringer must establish that (1) the patentee engaged in "unreasonable and inexcusable" delay during prosecution, and (2) the accused infringer "suffered prejudice attributable to the delay" because, for example, it worked on the claimed technology during the period of delay. App. 9a; *see, e.g., Hyatt v. Hirshfeld*, 998 F.3d 1347, 1362 (Fed. Cir. 2021). The district court found both elements satisfied. C.A. App. 30-38. It acknowledged that, in 1999, PMC had "develop[ed] a consolidation agreement" with the PTO "and demarcated its applications by subject matter." C.A. App. 34. But the court found that the PTO consolidation "agreement itself . . . contributed to delays." C.A. App. 35-36. The court then found that Apple had suffered prejudice because "[b]y 2005 . . . FairPlay had matured into the version accused of infringement." C.A. App. 39.

12. The Federal Circuit affirmed in a 2-1 decision. The majority agreed with the district court that PMC had engaged in "unreasonable and inexcusable delay" during prosecution of the '091 patent. App. 10a. The majority acknowledged that PMC had complied with its 1999 consolidation agreement with the PTO. But the majority concluded that "PMC's compliance with the Consolidation Agreement supports, rather than refutes, a finding of unreasonable and inexcusable delay." App.

11a. In the majority’s view, “PMC’s agreement to structure a serial examination of a claim through first an A application and then a B application gave PMC the very kind of prosecution delays that supported” a laches determination. *Id.*; see also App. 17a (reasoning that the A/B tracking system allowed PMC to “tak[e] a second bite at the examination apple,” thereby “creating improper delay”).

13. Judge Stark dissented. Among other things, Judge Stark rejected the majority’s conclusion that PMC’s compliance with the 1999 consolidation agreement could be deemed a cause of unreasonable delay. As Judge Stark explained, the panel’s decision was

in tension with [the Federal Circuit’s] holding in *Hyatt*, in which [the court] suggested that that, even decades into the prosecution, when the PTO ‘notified Hyatt of its own obligations and requirements and thereby gave him the opportunity *to avoid prosecution laches*,’ Hyatt’s subsequent cooperation with the PTO could, even then, have saved his patents.

App. 32a-33a (citation omitted) (quoting *Hyatt*, 998 F.3d at 1366).

14. The Federal Circuit’s precedential decision warrants this Court’s review. The panel held that a patentee’s compliance with a PTO-approved prosecution plan can constitute “unreasonable” delay, thereby justifying the judicial cancellation of a duly issued patent. That radical intrusion into the PTO’s reasonable docket-management decisions is wrong for several reasons.

15. First, the Federal Circuit’s decision is inconsistent with this Court’s precedents, including its decisions in *Overland Motor Co. v. Packard Motor Car Co.*, 274 U.S. 417 (1927), and *SCA Hygiene Products v. First Quality Baby Products*, 580 U.S. 328 (2017). In *Overland*, the Court declined to apply prosecution laches to a

patent that took more than 12 years to issue because the applicant repeatedly took the maximum allowable time (up to a year) to respond to the PTO. *See* 274 U.S. at 418-419, 424. Writing for the Court, Chief Justice Taft explained that there was no “principle [that allowed the Court to] apply the equitable doctrine of abandonment by laches in a case where the measure of reasonable promptness is fixed by statute, and no other ground appears by reason of which laches could be imputed to the applicant.” *Id.* at 424. More recently, in *SCA*, the Court held that an accused infringer could not assert the defense of post-issuance laches where the patentee brought suit within the statute of limitations. *See* 580 U.S. at 335 (“Laches is a gap-filling doctrine, and where there is a statute of limitations, there is no gap to fill.”). In other words, “separation-of-powers principles” bar judges from using laches to second-guess the deliberate decisions by other branches. *Id.* at 334. Yet that is exactly what the Federal Circuit did here in holding that PMC’s compliance with the 1999 consolidation agreement gave rise to laches. Under *Overland* and *SCA*, the consolidation agreement should have precluded laches.

16. Second, the decision below has left Federal Circuit precedent in this area in disarray. Most notably, as Judge Stark noted in dissent, the majority’s holding conflicts with the Federal Circuit’s decision in *Hyatt*. *See* App. 32a. There, the court explained that the PTO’s instructions to the applicant—including “its instructions to demarcate the applications”—“gave him the opportunity to avoid prosecution laches.” 998 F.3d at 1366. *Hyatt* thus shows that an applicant who cooperates with the PTO during examination has not engaged in the “egregious” conduct necessary to support



a laches defense. The panel majority in this case, however, held precisely the opposite: not only was PMC's entry into the consolidation agreement in 1999 insufficient to avoid laches, but the majority actually condemned an examination plan entered by the PTO as a "scheme" to "extend out prosecution." App. 5a.

17. Third, the Federal Circuit's decision is inconsistent with Congressional design and separation-of-powers principles. Congress has granted the PTO the power to grant and issue patents. 35 U.S.C. §2(a). That delegation of authority includes "inherent authority to govern procedure before the [office]" and to "set reasonable deadlines and requirements for the prosecution of applications." *In re Bogese*, 303 F.3d 1362, 1368 (Fed. Cir. 2002); see §2(b)(2)(A) (authorizing the PTO to "establish regulations, not inconsistent with law," to "govern the conduct of proceedings in the Office"). In keeping with that authority, courts have recognized that "[w]hen a patent has been examined and duly granted," courts must adhere to "the presumption of administrative correctness of actions of the agency charged with examination of patentability." *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1569 (Fed. Cir. 1996). The PTO's entry into the consolidation agreement with PMC streamlined the agency's docket and represented a reasonable exercise of its docket-management authority—not egregious conduct by PMC. By holding that agreement against PMC, the Federal Circuit turned the presumption of administrative correctness on its head.

18. Finally, the majority's decision introduces unpredictability and unfairness into the patent-prosecution process. Now, even if an applicant reaches and

complies with an express agreement with the PTO, it must worry that, years later, a district judge might second-guess the PTO's deliberate decisionmaking and find the patent unenforceable for procedural reasons. The consequence of the panel's decision is to rob the PTO of an important tool to manage its own docket—and to rob patentees of the certainty that the patent system requires. For all these reasons, the Court should grant certiorari to realign the doctrine with precedent and sound policy.

19. In the alternative, this case warrants the Court's review to address whether prosecution laches remains a valid defense to patent infringement. The Court's recent decision in *SCA* rejected the defense of post-issuance laches—*i.e.*, laches based on a patentee's delay in filing an infringement suit. *See* 580 U.S. at 959-967. The principles announced in *SCA* apply equally to the defense of pre-issuance laches—*i.e.*, laches during the prosecution of a patent application. It has been decades since the Court has considered the defense of prosecution laches, and it has not passed on the defense since its decision in *SCA*. Especially in light of the Federal Circuit's sweeping conception of the defense in the decision below, the time is ripe for the Court to revisit the issue.

20. Good cause exists for an extension of time to file a petition raising these questions. PMC's appellate counsel have been heavily engaged with other matters and have other commitments that make the preparation of a petition for a writ of certiorari by the existing deadline impracticable, including a bench trial in the District of Delaware on June 14, an argument in the Federal Circuit on July 10, a principal brief in the Federal Circuit due on July 10, a principal brief in the Tenth Circuit

due on July 12, a mediation on July 25, a reply brief in the Federal Circuit due on August 11, an argument in the Ninth Circuit's Alaska sitting on August 15, and a principal brief in the Massachusetts Appeals Court likely to be due on August 16. The requested extension would allow counsel to continue to research the relevant legal issues and to prepare a petition that fully addresses the important questions raised by the proceedings below.

For the foregoing reasons, PMC respectfully requests an extension to file a petition for a writ of certiorari to and including September 7, 2023.

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Respectfully submitted.



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