

App. No. 19-

In the Supreme Court of the United States

SOLUTRAN, INC.,

Petitioner,

v.

ELAVON, INC., U.S. BANCORP,

Respondents.

PETITIONER'S APPLICATION TO EXTEND TIME TO
FILE PETITION FOR A WRIT OF CERTIORARI

To the Honorable Chief Justice Roberts, as Circuit Justice for the United States
Court of Appeals for the Federal Circuit:

Pursuant to 28 U.S.C. § 2101(c) and Supreme Court rules 13.5, 22, and 30.3,
petitioner Solutran, Inc. respectfully requests that the time to file a Petition for a Writ of
Certiorari in this case be extended for forty-five days to and including February 13, 2020.
The court of appeals issued its opinion on July 30, 2019. *See App. A, infra.* The court
denied a timely petition for rehearing en banc on October 1, 2019. *See App. B, infra.*
Absent an extension of time, the petition therefore would be due on December 30, 2019.
Petitioner is filing this application at least ten days before that date. *See Sup. Ct. R. 13.5.*
This Court has jurisdiction under 28 U.S.C. § 1254(1) to review this case.

Rule 29.6 Statement

Petitioner Solutran, Inc. discloses that it has no parent corporation and no publicly held company owns 10% or more of its stock.

Background

This case involves the standard for determining whether a patent is directed to ineligible subject matter under 35 U.S.C. § 101 because it is directed to an abstract idea. The case exemplifies the uncertainty and inconsistency that underlies current Section 101 analysis, particularly in the context of business-method patents.

1. Petitioner's patent, issued in 2012, is directed to a physical method of processing paper checks. Petitioner's innovative check-processing method comprises (1) receiving a data file containing data created by scanning paper checks at a merchant's point of purchase; (2) crediting an account for the merchant; (3) after crediting, receiving and scanning the paper checks at a new location to create digital images of the checks; and (4) comparing the digital image and data in the data file to find matches. Unlike the previous methods used by merchants, the patent provides for each paper check to be scanned at two different times by two different pieces of equipment. This innovation in paper-check processing provides a method by which merchants can receive the traditional benefits of electronic-check processing while avoiding the cost and practical challenges associated with buying and using their own scanning equipment to capture digital images of paper checks.

2. In 2013, petitioner filed a patent-infringement action against respondents. In February 2014, respondents sought review of the patent-at-issue before the U.S. Patent

and Trademark Office's Patent Trial and Appeal Board ("PTAB"), arguing that the patent was invalid under Section 101 as an abstract idea and under Section 103 as obvious.

During the PTAB proceeding, the district court action was stayed.

3. The PTAB, applying this Court's decision in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 573 U.S. 208 (2014), declined review under Section 101. The PTAB reasoned that the patent's core concept was "more akin to a physical process than an abstract idea." App. A. at 5 (quoting *U.S. Bancorp v. Solutran, Inc.*, No. CBM2014-00076, 2014 WL 3943913 (P.T.A.B. Aug. 7, 2014)). The PTAB granted review on, but ultimately rejected, respondents' Section 103 challenge. Respondents sought review of the PTAB's decision from the Court of Appeals for the Federal Circuit. The Federal Circuit summarily affirmed in an unpublished decision.

4. After the PTAB proceeding concluded, the parties cross-moved for summary judgment before the district court. The district court denied respondents' motion for summary judgment and granted petitioner's motion for summary judgment on the issue of infringement. In rejecting respondents' Section 101 argument at *Alice* step one, the district court "focused on the physical nature of checks' processing and movement and accused U.S. Bank of improperly construing the claim to 'a high level of abstraction.'" App. A at 5. The district court also concluded that, in the alternative, the patent-at-issue had the requisite innovative concept at *Alice* step two. *Id.* Following trial, a jury awarded petitioner damages for the infringement.

5. Respondents appealed, and the Federal Circuit reversed. App. A. The Federal Circuit concluded that the patent-at-issue was directed to the abstract idea of

crediting a merchant's account as early as possible during the electronic processing of a check. Instead of examining the physical nature of the process or the inventors' claimed advance over the prior art, the Federal Circuit adopted a broad statement of the underlying business method (crediting a merchant's account as early as possible while electronically processing a check) as the claims' focus.

Petitioner filed a petition for rehearing en banc. The Federal Circuit denied the petition. App. B.

Reasons for Granting an Extension of Time

The time to file a Petition for a Writ of Certiorari should be extended for forty-five days, to and including February 13, 2020, for several reasons:

1. The forthcoming petition will present important questions about the scope of patent-eligible subject matter under 35 U.S.C. § 101. The lower courts' application of this Court's Section 101 decisions has led to extensive confusion, inconsistency, and criticism. *See* Megan Thobe, *A Call to Action: Fixing the Judicially-Murkied Waters of 35 U.S.C. § 101*, 50 IND. L. REV. 1023, 1031-1033 (2017). This case exemplifies the ways in which the Federal Circuit's attempts to apply this Court's Section 101 decisions are effectively eliminating the ability to enforce business-methods patents, no matter how physical they are in their nature, in contravention of this Court's holding in *Bilski v. Kappos*, 561 U.S. 593 (2010). The current lack of clear standards for whether something is patentable under Section 101 stifles innovation, abrogates important property rights, and undermines the patent system established by Congress. This Court's intervention to

clarify the standards for patent eligibility under Section 101 jurisprudence is urgently needed.

2. Good cause exists for this application. Counsel for Solutran has had significant professional commitments in recent weeks and has such commitments in the upcoming weeks. Counsel also has pre-arranged travel plans and family commitments between now and when the petition would currently be due, given the upcoming holidays. Counsel's pre-existing professional and personal commitments would make it extremely difficult to complete this petition without an extension.

3. No prejudice would arise from the extension. Whether the extension is granted or not, the petition will likely be considered before the Court's summer recess. Further, irrespective of whether there is an extension, it is unlikely that the petition would be resolved this Term if the petition is granted.

Conclusion

For the foregoing reasons, the time to file a Petition for a Writ of Certiorari in this matter should be extended for forty-five days to and including February 13, 2020.

Dated: December 11, 2019.

Respectfully submitted,

KATHERINE M. SWENSON
Counsel of Record

ROBERT J. GILBERTSON
GREENE ESPEL PLLP
222 South Ninth Street
Suite 2200
Minneapolis, MN 55402
(612) 373-0830
kswenson@greeneespel.com

*Counsel for Petitioner
Solutran, Inc.*