IN THE

Supreme Court of the United States

PERSONALIZED MEDIA COMMUNICATIONS, LLC,

Applicant,

v.

APPLE, INC.

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

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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

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