
IN THE
Supreme Court of the United States

PERSONALIZED MEDIA COMMUNICATIONS,

Petitioner,

v.

APPLE INC.,

Respondent.

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Petitioner entered a docket-management agreement with the Patent and Trademark Office (PTO) establishing a process for examination of petitioner's patent applications. Over the next two decades, petitioner complied with that agreement and the PTO issued petitioner nearly 100 patents, including a patent petitioner successfully asserted against respondent in an infringement action. But in a 2-1 decision, the Federal Circuit held that the patent was unenforceable under the equitable doctrine of prosecution laches, reasoning that the PTO's docket-management decisions had allowed "unreasonable" delays during examination.

Where an applicant has complied with statutory deadlines, this Court has refused to find patents unenforceable on the basis of laches. *Overland Motor Co. v. Packard Motor Car Co.*, 274 U.S. 417 (1927); *SCA Hygiene Prods. v. First Quality Baby Prods.*, 580 U.S. 328 (2017). And Congress has given the PTO authority to set rules "govern[ing] the conduct of proceedings in the Office." 35 U.S.C. §2(b)(2)(A). Thus, the Federal Circuit has held elsewhere that compliance with PTO instructions during examination affords an applicant "the opportunity to avoid prosecution laches." *Hyatt v. Hirshfeld*, 998 F.3d 1347, 1366 (2021).

The questions presented are:

1. Whether prosecution laches can be based on an applicant's prosecution of a patent application in compliance with the PTO's docket-management decisions.
2. Whether the doctrine of prosecution laches, as articulated by the Federal Circuit, is a valid patent-infringement defense in light of *SCA Hygiene*.

PARTIES TO THE PROCEEDING

All parties appear in the caption of the case on the cover page.

CORPORATE DISCLOSURE STATEMENT

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

RELATED PROCEEDINGS

U.S. District Court for the Eastern District of Texas:

Personalized Media Communications, LLC v. Apple Inc., No. 2:15-cv-1366 (Aug. 6, 2021)

U.S. Court of Appeals for the Federal Circuit:

Personalized Media Communications, LLC v. Apple Inc., No. 2021-2275 (Jan. 20, 2023)

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