

No. _____

In the
Supreme Court of the United States

TECHNOLOGY PROPERTIES LIMITED LLC, PHOENIX DIGITAL SOLUTIONS LLC,
and PATRIOT SCIENTIFIC CORPORATION,

Applicants,

v.

HUAWEI TECHNOLOGIES CO., LTD., FUTUREWEI TECHNOLOGIES, INC., HUAWEI
DEVICE CO., LTD., HUAWEI DEVICE USA INC., HUAWEI TECHNOLOGIES USA INC.,
ZTE CORPORATION, ZTE USA, INC., SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., LG ELECTRONICS, INC., LG ELECTRONICS
U.S.A., INC., NINTENDO CO., LTD., and NINTENDO OF AMERICA, INC.,

Respondents.

**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**

DIRECTED 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

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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, Applicants
Technology Properties Limited LLC, Phoenix Digital Solutions LLC, and Patriot
Scientific Corporation respectfully request an extension of sixty (60) days to file a
petition for a writ of certiorari in this Court, to and including September 7, 2019.

2. Counsel for Applicants contacted Counsel for Respondents regarding
this application. Respondents do not object to Applicants' requested extension.

3. The United States Court of Appeals for the Federal Circuit entered
judgment on February 6, 2019. *See* 3a-5a. Applicants filed a timely petition for
rehearing *en banc*, which was denied on April 10, 2019. *See* 1a-2a. Without an
extension, the petition for a writ of certiorari is due on July 9, 2019. 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. This case presents important issues relating to the propriety of Federal
Circuit jurisprudence that authorizes district courts, during claim construction
proceedings, to add limitations to patent claims that were duly issued by the United
States Patent and Trademark Office. In this patent infringement action, at the
Defendants' urging, the district court added two negative limitations to the issued
patent claims during claim construction, thereby significantly diminishing claim
scope in contravention of this Court's authority under *Goodyear Dental Vulcanite
Co. v. Davis*, 102 U.S. 222 (1880). The district court added the two negative
limitations even though the statements that gave rise to the alleged "prosecution

disclaimer” were not germane to the Patent Office’s patentability determination. On appeal, the Federal Circuit modified the negative limitations imposed by the district court and remanded. *See Tech. Properties Ltd. v. Huawei Techs. Co., Ltd.*, 849 F.3d 1349 (Fed. Cir. 2017) (12a-28a). On remand, the accused infringers moved for and were granted summary judgment of non-infringement based on the added limitations as further interpreted by the district court. *See* 6a-11a. That decision was affirmed without opinion under Fed. Cir. R. 36 in the instant appeal. *See* 3a-5a.

5. This case presents important questions of constitutional and patent law. The law of prosecution disclaimer, as applied in this case and in other cases, has morphed in a manner inconsistent with the Patent Act. The Federal Circuit’s increasingly anti-textualist methodology also conflicts with this Court’s long-established precedent. The improper expansion of this judicially-created doctrine upsets the balance between the role of the Patent Office and the role of the judiciary, as established by Congress, and injects great uncertainty into the public-notice function of patents. Congress delegated the examination and issuance of patents to the Patent Office and requires deference to the agency’s decision-making. The expanded disclaimer doctrine calls into question the Patent Office’s authority to examine and issue patents, and the limited role of the judiciary in reviewing the Patent Office’s determinations. Encouraging litigants and courts to wade through the back-and-forth between the Patent Office and a patent applicant to rewrite the issued claims through imposition of additional limitations under the guise of “claim construction” runs afoul of Congress’s delegation.

6. Since the 1880's, this Court's precedent has consistently restricted prosecution disclaimer to the amendment, cancellation, or surrender of patent claims during prosecution. When an applicant narrows claims during prosecution, the applicant disclaims the scope of the original claims; in such circumstances, the applicant's statements related to an amendment may shed light on the scope of the disclaimer. But an applicant's other statements in the examination process that are untethered to claim amendments should not be used to find disclaimer. That is what this Court held in *Goodyear Dental Vulcanite Co. v. Davis*: "We do not mean to be understood as asserting that any correspondence between the applicant for a patent and the Commissioner of Patents can be allowed to enlarge, diminish, or vary the language of a patent afterwards issued." 102 U.S. 222, 227 (1880). The Federal Circuit quoted this language in its seminal *en banc* opinion on claim construction, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995).

7. Over the past two decades, however, district courts and panels of the Court of Appeals for the Federal Circuit have eroded this directive, relying on all manner of statements in the prosecution history to limit claim scope and rewrite claims. This is the wrong approach. It introduces uncertainty into the scope of the patent grant and undermines the public-notice function of patent claims.

8. In the instant case, the Patent Office had already been asked to reconsider its decision to issue the asserted patent six times. Each time, the asserted patent emerged from reexamination with the same limitations approved by the Patent Office challenged in the lower court. Indeed, the same patent was

asserted and tried to a verdict of infringement, without application of prosecution history disclaimer, in a prior infringement action concerning similar accused devices. *See HTC Corp. v. Tech. Properties Ltd.*, No. 5:08-cv-882, 2014 WL 549710 (N.D. Cal. Jan. 21, 2014).

9. The expanded disclaimer doctrine leads to widely divergent results in the district courts and between panels of the Court of Appeals for the Federal Circuit. The unpredictability of the doctrine creates, rather than clarifies, uncertainty regarding the boundaries of what should be well-settled property rights. The result in this case undermines the very rationale underlying the disclaimer doctrine, and evidences the extent to which the doctrine has led to highly unpredictable and manifestly unjust results.

10. For the aforementioned reasons, this case is a strong candidate for certiorari review. The Court of Appeals' ruling disregards both its own precedent and this Court's holding in *Goodyear Dental*, and presents an excellent opportunity for this Court to affirm that precedent against the wrong and harmful expansion of the disclaimer doctrine.

11. This case presents recurring and important questions of patent law. Additional time will allow for the preparation of a petition that fully addresses the complex and important issues raised by this case, and frame those issues in a manner that will be most helpful to the Court.

12. In addition, the Applicants recently retained Kenneth W. Starr, Of Counsel with The Lanier Law Firm, who was not involved in the proceedings below, to assist in the preparation and filing of their petition for a writ of certiorari. The

Corporate Disclosure Statement

Technology Properties Limited LLC has no parent corporations and no publicly held companies own 10% or more of stock in the party.

Patriot Scientific Corporation is a publicly held company. No parent corporations or publicly held companies own 10% or more of stock in the party.

More than 10% of the membership interest in **Phoenix Digital Solutions LLC** is held by **Patriot Scientific Corporation**, a publicly traded company.

ADDENDUM

Order denying petition for rehearing *en banc* in *Technology Properties Ltd. v. Huawei Techs. Co., Ltd.* (No. 2018-1439) (Fed. Cir. Apr. 10, 2019)..... 1a

Judgment under Fed. Cir. Rule 36 in *Technology Properties Ltd. v. Huawei Techs. Co., Ltd.* (No. 2018-1439) (Fed. Cir. Feb. 6, 2019)..... 3a

Order granting defendants’ motions for summary judgment of non-infringement in *Technology Properties Ltd. v. Huawei Techs. Co., Ltd.* (No. 3:12-cv-3865) (N.D. Cal. Dec. 13, 2017) 6a

Order re-construing claims and remanding in *Technology Properties Ltd. v. Huawei Techs. Co., Ltd.*, 849 F.3d 1349 (No. 2016-1306) (Fed. Cir. Mar. 3, 2017) 12a