IN THE SUPREME COURT OF THE UNITED STATES

No. ____

IMPACT ENGINE, INC.,

Applicant,

v.

GOOGLE LLC,

Respondent.

APPLICATION TO THE HON. JOHN G. ROBERTS, JR. FOR AN EXTENSION OF TIME WITHIN WHICH TO FILE A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Pursuant to Supreme Court Rule 13(5), Impact Engine, Inc. hereby moves for an extension of time of 60 days, to and including February 3, 2025, for the filing of a petition for a writ of certiorari. Unless an extension is granted, the deadline for filing the petition for certiorari will be December 5, 2024.

In support of this request, Applicant states as follows:

1. The United States Court of Appeals for the Federal Circuit rendered its initial decision in this case on July 3, 2024 (Exhibit 1). Applicant filed a timely petition for rehearing, which the Federal Circuit denied on September 6, 2024 (Exhibit 2). This Court has jurisdiction under 28 U.S.C. § 1254(1).

2. This case concerns whether the specific structure defining the scope of a means-plus-function patent claim under 35 U.S.C. § 112(f) must be considered when resolving whether the claimed invention is eligible for patenting under 35 U.S.C.

§ 101. A panel majority of the Federal Circuit determined the eligibility of means-plus-function patent claims under § 101 without considering those claims' specific corresponding structure under § 112(f). However, in a vigorous dissent, Judge Reyna would have held the opposite—that the eligibility of a means-plus-function patent claim cannot be determined as a matter of law without first determining its specific scope. This Court should intervene to correct the collision course on which the Federal Circuit has set these two fundamental statutory pillars of patent law.

3. Section 101 of the Patent Act defines inventions eligible for patenting as "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. This Court has stated that, although patents claiming "laws of nature, natural phenomena, and abstract ideas" are not patent-eligible, certain "applications of those concepts" may be patentable. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014). To distinguish eligible from ineligible patent claims, this Court set forth a two-part test: *first*, "whether the claims at issue are directed to one of those patent-ineligible concepts," and *second*, if so, whether "the elements of each claim both individually and 'as an ordered combination'" recite an "inventive concept" that "'transform[s] the nature of the claim[s]' into a patent-eligible application." *Id.* (quoting *Mayo Collaborative Servs. v. Prometheus Lab'ys, Inc.*, 566 U.S. 66, 72, 77-80 (2012)). Applying this framework, although claims staking rights to a mere "function or result" itself are not patent eligible, *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996),

claims reciting a "particular manner" of solving a technological problem are eligible for patenting, *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

4. At the same time that it enacted § 101, Congress also envisioned that patentees could claim their inventions in purely functional terms by simultaneously enacting § 112. 35 U.S.C. § 112(f). The tradeoff Congress recognized for such functional claiming is that patent claims recited in purely functional terms "shall be construed to cover the corresponding structure, material, or acts described in the specification [of the patent] and equivalents thereof." *Id.* By definition, these means-plus-function patent claims are limited to a particular manner of achieving a claimed result—*i.e.*, the specific corresponding structures in the patent specification.

5. The problem with the Federal Circuit's decision here is that it effectively nullifies § 112(f) by crushing it under the weight of § 101. The Federal Circuit's decision—which divorces the claimed function from its required corresponding structure—renders virtually all § 112(f) means-plus-function patent claims ineligible for patenting under § 101. Congress could not have intended that result when it simultaneously enacted those complementary provisions of the Patent Act.

6. Indeed, the Federal Circuit's decision is a symptom of an even larger problem that has plagued patent law since this Court's decision in *Alice* ten years ago. Courts (including panels of the Federal Circuit itself) remain deeply divided and confused about how to apply the two-part *Alice* framework to determine patent eligibility under § 101, both with respect to means-plus-function as well as non-means-plus-function patent claims. *See, e.g.*, *Am. Axle & Mfg., Inc. v. Neapco*

Holdings LLC, 966 F.3d 1347 (Fed. Cir. 2020) (denying petition for rehearing en banc of a fractured panel decision, with two concurring and three dissenting opinions); *Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC*, 927 F.3d 1333 (Fed. Cir. 2019) (denying petition for rehearing en banc of another fractured panel decision, with four concurring and four dissenting opinions); *SRI Int'l, Inc v. Cisco Sys., Inc.*, 930 F.3d 1295 (Fed. Cir. 2019) (disagreement over how to apply the *Alice* framework).

7. The inconsistency and unpredictability of adjudication in § 101 disputes such as this one threatens the entire purpose of the patent system enshrined in the Constitution "[t]o promote the progress of science and useful arts." U.S. Const. Art. I § 8, cl. 8. In the wake of the impenetrable patchwork of lower court decisions espousing conflicting views on how to apply § 101 to patent claims (let alone those recited in functional terms as endorsed by Congress under § 112(f)), inventors have been left with no reliable way to predict whether they will obtain protection for participating in the public good of disclosing their innovations for others to build on.

8. There is good cause to grant an extension. Between the Federal Circuit's denial of rehearing in this matter and the current due date of the petition, Applicant's Counsel of Record, Jason M. Wilcox, has substantial briefing and oral argument obligations, including (a) an opposition to a petition for rehearing *en banc* in *Motorola Solutions, Inc. v. Hytera Communications Corp.*, No. 22-2370 (7th Cir.), filed September 19, 2024; (b) a response brief in *DexCom, Inc. v. Abbott Diabetes Care, Inc.*, No. 24-1325 (Fed. Cir.), filed on September 23, 2024; (c) a petition for rehearing *en banc* in *Speerly v. General Motors*, No. 23-1940 (6th Cir.), filed September 25, 2024;

(d) oral argument on motions for judgment as a matter of law in *Abbott Diabetes Care Inc. v. DexCom Inc.*, No. 21-977 (D. Del.), argued October 8, 2024; (e) confidential proceedings on October 10 and 11, 2024; (f) post-trial briefing in *Omnitracs, LLC v. Platform Science, Inc.* (S.D. Cal.), filed October 4, 2024 and October 24, 2024; (g) post-trial briefing in *Finch Therapeutics Group, Inc. v. Ferring Pharmaceuticals Inc.*, No. 21-1694 (D. Del.), filed November 4, 2024; (h) oral argument in *Painters & Allied Trades District Council 82 Health Plan v. Takeda Pharma Co. Ltd.*, No. 23-55742 (9th Cir.), on November 12, 2024.

9. In addition, Applicant's Counsel of Record has substantial briefing and oral argument obligations between December 5 and February 3, including (a) *Oasis Tooling, Inc. v. Siemens Industry Software Inc.*, No. 24-2085 (Fed. Cir.), due December 9, 2024; (b) a reply brief in *Abbott Diabetes Care, Inc. v. DexCom Inc.*, No. 24-1449 (Fed. Cir.), due December 18, 2024; (c) a response brief in *ImmerVision, Inc. v. Apple Inc.*, No. 24-2220 (Fed. Cir.), due January 6, 2025; and (d) a response brief in *PACT XPP Schweiz AG v. Intel Corp.*, No. 25-1003 (Fed. Cir.), due January 27, 2025. An extension will also permit Applicant sufficient time to secure *amicus* support for its forthcoming petition, which will further illustrate the importance and impact of the Federal Circuit's decision.

10. Applicant thus requests a modest extension to prepare a petition that fully addresses the important issues raised by the decision below and that frames those issues in a manner that will be most helpful to the Court.

WHEREFORE, for the foregoing reasons, Applicant requests that an extension of time to and including February 3, 2025, be granted within which Applicant may file a petition for a writ of certiorari.

Respectfully submitted,

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