

No. _____

In the
Supreme Court of the United States

GILBERT P. HYATT

Petitioner,

v.

JOHN A. SQUIRES, Under Secretary of Commerce for
Intellectual Property and Director of the U.S. Patent
and Trademark Office,

Respondent.

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

PETITION FOR WRIT OF CERTIORARI

STEVEN A. ENGEL
DECHERT LLP
1900 K Street, NW
Washington, DC 20006

G. ERIC BRUNSTAD JR.
DECHERT LLP
199 Lawrence Street
New Haven, CT 06511

ANDREW M. GROSSMAN
MARK W. DELAQUIL
BAKER & HOSTETLER LLP
1050 Connecticut Ave., NW
Suite 1100
Washington, DC 20036

MARTIN J. BLACK
Counsel of Record
MICHAEL H. MCGINLEY
SHARON K. GAGLIARDI
JUDAH BELLIN
BRIAN A. KULP
DECHERT LLP
Cira Centre
2929 Arch Street
Philadelphia, PA 19104
(215) 994-4000
martin.black@dechert.com

Counsel for Petitioner

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QUESTION PRESENTED

Congress has enacted a comprehensive set of legal rules governing the timing of each step in the patent examination process. Yet, invoking the doctrine of “prosecution laches,” the Patent and Trademark Office (“PTO”) claims an equitable power to refuse to issue a patent, even when the applicant (as in this case) has met all the statutory requirements. Two decades ago, the Federal Circuit approved the doctrine in a pair of split decisions. Since then, this Court has twice held that laches is a limited “gap-filling doctrine” that does not apply when, as here, Congress has filled the gaps with statutory timelines. *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 335 (2017); *see also Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 679 (2014). The Federal Circuit has nevertheless stood by its “prosecution laches” doctrine.

The question presented is:

Whether the PTO may invoke the equitable doctrine of “prosecution laches” to deny a patent to an applicant who has complied with all the Patent Act’s timeliness provisions.

PARTIES TO THE PROCEEDING

Petitioner Gilbert P. Hyatt was the plaintiff in the District Court and the appellant before the Federal Circuit. Respondent is John A. Squires, in his official capacity as the Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office, and as successor to the prior holders of his office involved in this matter. Respondent and his predecessors were the defendant in the District Court and the appellee in the Federal Circuit.

STATEMENT OF RELATED PROCEEDINGS

This case arises from and is related to the following proceedings within the meaning of Rule 14.1(b)(iii):

- *Hyatt v. Vidal*, No. 1:05-cv-02310-RCL (D.D.C.), judgment entered August 1, 2018, order on remand entered May 16, 2024;
- *Hyatt v. Vidal*, No. 1:09-cv-01864-RCL (D.D.C.), judgment entered August 1, 2018, order on remand entered May 16, 2024;
- *Hyatt v. Vidal*, No. 1:09-cv-01869-RCL (D.D.C.), order dismissing case entered August 1, 2018, order on remand entered May 16, 2024;
- *Hyatt v. Vidal*, No. 1:09-cv-01872-RCL (D.D.C.), judgment entered August 1, 2018, order on remand entered May 16, 2024;
- *Hyatt v. U.S. Patent & Trademark Off.*, No. 1:18-cv-00234-RCL (D.D.C.), stipulated dismissal filed November 30, 2018;
- *Hyatt v. Hirshfeld*, Nos. 20-2321, 20-2323, 20-2324, 20-2325 (Fed. Cir.), judgment entered October 12, 2021; and
- *Hyatt v. Squires*, Nos. 18-2390, 18-2391, 18-2392, 19-1038, 19-1039, 19-1049, 19-1070, 24-1992, 24-1993, 24-1994, 24-1995 (Fed. Cir.), partial judgment entered June 1, 2021, final judgment entered August 29, 2025.

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PETITION FOR WRIT OF CERTIORARI

The Patent Act carefully and comprehensively regulates the timing of each step of the patent prosecution process—and for good reason. Patents and the technologies they protect often require enormous investments of time and resources, and certainty in the prosecution process is critical to preserving and encouraging those investments. To these ends, Congress has set hard-and-fast deadlines for inventors to apply for their patents, to file continuation applications, to respond to actions by the Patent and Trademark Office (“PTO”), and to seek judicial review.

Congress did not grant the PTO any authority to refuse to issue patents that meet the requirements of the law. On the contrary, Congress charged the PTO with assessing when an application meets the statutory “conditions and requirements of [the Patent Act].” 35 U.S.C. § 101. And it directed that the PTO “*shall* issue a patent” to any applicant who “is entitled to a patent under the law.” *Id.* § 131 (emphasis added).

The PTO, however, has disregarded those congressional commands. Specifically, it claims authority to make equitable adjustments to the timeliness conditions that Congress has mandated. And the Federal Circuit has sustained this claim, embracing a doctrine of “prosecution laches” that allows the PTO to deny an application as untimely, even when the applicant has complied with each and every prosecution deadline. Under this approach, timeliness is “decided as a matter of equity,” based on the “totality of the circumstances,” and “subject to the

discretion of a district court before which the issue is raised.” *Symbol Techs., Inc. v. Lemelson Med., Educ. & Rsch. Found., LP*, 422 F.3d 1378, 1385-86 (Fed. Cir. 2005).

This Court has long rejected that legislation-overriding view of equity. *See, e.g., Chapman v. Wintroath*, 252 U.S. 126, 137-39 (1920); *Syngenta Crop Protection, Inc. v. Henson*, 537 U.S. 28, 31-32 (2002). And the Court has done so twice in recent years specifically with respect to laches. In *Petrella v. Metro-Goldwyn-Mayer, Inc.*, the Court explained that laches is available only in limited circumstances when “the Legislature has provided no fixed time limitation” to act. 572 U.S. 663, 678 (2014). Accordingly, this Court held that “laches cannot be invoked” to override the Copyright Act’s statute of limitations. *Id.* at 679. This Court then applied the same principle to the Patent Act in *SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC*, 580 U.S. 328 (2017). There, the Court rejected the Federal Circuit’s effort to override the Patent Act’s six-year limitations period for infringement actions for damages. *See id.* at 346. And, again, the Court reiterated that laches is a “gap-filling doctrine” that cannot apply when “there is no gap to fill.” *Id.* at 335. Invoking laches to bar relief within a “period specified by Congress would give judges a ‘legislation-overriding’ role that is beyond the Judiciary’s power.” *Id.* (citation omitted).

The Federal Circuit’s “prosecution laches” doctrine cannot be squared with these fundamental and longstanding principles. Certiorari is warranted to review whether the PTO may invoke the equitable doctrine of “prosecution laches” to deny a patent to an

applicant who has complied with all the Patent Act's statutory timeliness requirements.

OPINIONS BELOW

The District Court's initial decision rejecting the PTO's prosecution laches defense is reported at 332 F. Supp. 3d 113 and is reproduced at Pet.App.265-315. The Federal Circuit's opinion vacating that decision is reported at 998 F.3d 1347 and is reproduced at Pet.App.215-64. The District Court's later decision finding for the PTO on prosecution laches is available at 2024 WL 2208581 and is reproduced at Pet.App.17-209. The Federal Circuit's opinion affirming the District Court's judgment is reported at 148 F.4th 1376 and is reproduced at Pet.App.1-16.

JURISDICTION

The Federal Circuit issued its decision on August 29, 2025. A timely petition for rehearing was denied on January 22, 2026. Pet.App.214. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Relevant statutory provisions are reproduced in the Appendix. See Pet.App.316-29; 35 U.S.C. §§ 101-02, 120, 131-34, 141-42, 145, 151.

STATEMENT OF THE CASE

A. Legal Background

"Inventors look to the patent system to obtain valuable rights." *Minerva Surgical, Inc. v. Hologic, Inc.*, 594 U.S. 559, 563 (2021). "In exchange for bringing 'new designs and technologies into the public domain through disclosure,'" inventors receive "a limited term of 'protection from competitive

exploitation” by others. *Amgen Inc. v. Sanofi*, 598 U.S. 594, 604 (2023) (citation omitted).

Patent law thus reflects “a carefully crafted bargain” between inventors and the public. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 63 (1998). And the Framers entrusted Congress alone with the task of defining that bargain’s terms. See U.S. Const. art. I, § 8, cl. 8. As a result, “[t]his Court has more than once cautioned that courts should not read into the patent laws limitations and conditions which the legislature has not expressed.” *Bilski v. Kappos*, 561 U.S. 593, 602 (2010) (quotation marks omitted); see also *Amgen*, 598 U.S. at 612 (“Judges may no more subtract from the requirements for obtaining a patent that Congress has prescribed than they may add to them.”).

“The Patent Act of 1952 establishes the process by which the PTO examines patent applications.” *Kappos v. Hyatt*, 566 U.S. 431, 434 (2012). Through that Act, Congress prescribed the “conditions and requirements” for an applicant to “obtain a patent.” 35 U.S.C. § 101. It then charged the PTO with assessing whether those statutory conditions and requirements are met in a patent “examination.” *Id.* § 131. And it directed that the PTO “shall issue a patent” to any applicant who “is entitled to a patent under the law.” *Id.*; see also *id.* § 102(a) (“A person shall be entitled to a patent unless” certain patentability criteria are not met.). In other words, Congress required the PTO to issue patents to those who “satisf[y] the statutory prerequisites for granting” them. *Hyatt*, 566 U.S. at 434.

As part of this regime, Congress enacted detailed provisions governing the timing of patent prosecution.

Those begin with an application's filing: The Patent Act of 1952, for instance, limited applicants to filing within "one year" of the first publication or sale of an invention. Pub. L. No. 82-593, § 102(b), 66 Stat. 792, 797 (1952) (the "Patent Act" or "Act"). And although Congress has amended the Act from time to time, it has continued to require inventors to file their applications by set times. *See* 35 U.S.C. § 102(a)-(b).

Congress also fixed the timing for filing "continuation applications." "A continuation application enables an inventor to add to or modify the claims set out in his original application" if he does not "materially change the written description of the invention." *Minerva*, 594 U.S. at 564 n.1. When that occurs, the inventor can benefit from the original application's filing date. *See* 35 U.S.C. § 120. But he can do so only if the continuation application is "filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application." *Id.* Or, to put it simply: Congress expressly "allow[ed] multiple links of such 'continuation' applications in a chain leading back to an earlier application as long as each link meets [§ 120's] requirements." *Immersion Corp. v. HTC Corp.*, 826 F.3d 1357, 1360 (Fed. Cir. 2016).

Beyond that, Congress comprehensively regulated the timing of applicants' interactions with the PTO. If the PTO rejects an application, it must notify the applicant of its decision and provide its reasoning. *See* 35 U.S.C. § 132. Then, if "the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined." *Id.* This back-and-

forth process can occur multiple times. *See id.* §§ 132, 134. But an application is deemed “abandoned” if the applicant fails to further “prosecute the application within six months after *any action*” on the application, “or within such shorter time, not less than thirty days, as fixed by the [PTO] in such action.” *Id.* § 133 (emphasis added).

Deadlines apply for applicants following allowances too. The 1952 Congress directed that when the PTO granted an application, “the patent shall issue within three months from the payment of the final fee,” which generally had to be paid within “six months” of the examiner’s decision. Pub. L. No. 82-593, § 151, 66 Stat. at 803-04. Congress has since shortened that payment period to three months, and if “payment is not timely made, the application shall be regarded as abandoned.” 35 U.S.C. § 151(a).

Additional timing provisions govern judicial review. After two rejections, an applicant may appeal to the Patent Trial and Appeal Board (“PTAB”) once he files a fee for such an appeal. *Id.* § 134. From there, the applicant has no less than 60 days to either appeal to the Federal Circuit or commence a civil action in federal district court. *See id.* §§ 141-42, 145.

B. Factual Background

Petitioner is a “prolific inventor.” Pet.App.38. He has obtained 75 patents for his inventions, which cover technologies ranging from computer designs to industrial control systems. Pet.App.43; *see*

Appx39183-85; Appx56143-44.¹ These technologies have been widely licensed for use in consumer products—including cameras, displays, televisions, memory products, and computers—by manufacturers such as Sony, Nikon, Sharp, Toshiba, Philips, and Panasonic. Appx42831-32.

Petitioner filed the continuation applications at issue, along with many others, in 1995. Pet.App.39-40. At the time, the United States had recently “agreed to change the term of U.S. patents from 17 years following the date of issuance to 20 years following the patent’s priority date.” *Personalized Media Commuc’ns, LLC v. Apple Inc.*, 57 F.4th 1346, 1350 n.2 (Fed. Cir. 2023); *see* Pet.App.39. As part of that change, Congress decided that applications “pending for 2 years or longer as of the [law’s] effective date” would receive “further limited reexamination”—and if granted, could benefit from the prior 17-year patent term. Uruguay Round Agreements Act, Pub. L. No. 103-465, §§ 531(a), 532(a)(1), 108 Stat. 4809, 4983, 4985 (1994) (“URAA”); *see* 37 C.F.R. § 1.129 (codifying limited reexamination procedures). This prompted a “surge in applications”—commonly known as the “GATT Bubble”—before the new law took effect. Pet.App.40.²

Petitioner prosecuted his applications at a rapid clip. Within just a few years, the PTO issued more

¹ “Appx__” citations are to the joint appendix filed in the lead case below. *See* Joint Appendix, *Hyatt v. Squires*, No. 18-2390 (Fed Cir. July 18, 2019), ECF No. 57.

² The changed structure for patent terms “was part of the implementation of the Uruguay Round Agreements Act of the General Agreement on Tariff and Trade (‘GATT’).” Pet.App.39.

than a dozen patents to Petitioner, and he appealed from the PTO's rejections for approximately 100 other applications. Pet.App.293. But then the PTO stalled the process. By 1997, the PTO "ordered group directors to stop issuing patents to [Petitioner] until [it] could consolidate his applications for examination." Pet.App.157. The PTO also "withdrew" several of Petitioner's allowed applications, in which the issue fee was already paid, "from issuance as patents." Pet.App.159. Then, between "2003 and 2012, the PTO largely suspended examination of [Petitioner's] applications" altogether. Pet.App.172. Petitioner filed over a hundred petitions asking the PTO to resume its work. See Appx29187-97; Appx29322; Appx30243-916. But to no avail. The PTO refused to file examiner's answers for dozens of Petitioner's applications, which blocked them from proceeding to the PTAB, sometimes for as long as a decade. See Appx29180-98; Appx30243-916. These applications were stuck—in the District Court's words—in a "proverbial Never-Never Land." Pet.App.293.

C. Procedural History

This case relates to four continuation applications. All agree that each application fully complied with the continuation process prescribed by Congress. See 35 U.S.C. § 120. And all agree that Petitioner never missed a deadline when prosecuting the applications at issue. As a result, three of them made their way through the PTO's back-and-forth process entirely by 1999. Pet.App.283 ('211 Application); Pet.App.285-86 ('062 Application); Pet.App.286-87 ('639 Application). As to the fourth, it was one of the few examined by the

PTO during the suspension period (though the PTO suspended prosecution on this application as well for nearly two years). Pet.App.284 ('398 Application). The PTO's last rejection of that application occurred in 2004. Pet.App.284.

Petitioner timely appealed the PTO's rejections for each application to the PTAB. Pet.App.283-87. And the PTAB issued split decisions: It reversed numerous grounds for rejection on claims in all four applications, but it affirmed other grounds for some claims. Pet.App.284-87.

In each case, Petitioner timely filed suit in the U.S. District Court for the District of Columbia to obtain a patent on claims for which the PTAB affirmed at least one of the PTO's grounds for rejection. *See* 35 U.S.C. § 145; Pet.App.284-87. The parties cross-moved for summary judgment, and the District Court (Lamberth, J.) largely denied the motions. Appx47211; Appx55447-48; Appx55470; Appx56065-66.

Then, with only a few months until trial, the PTO moved for leave to seek dismissal on the ground of "prosecution laches." Appx18847. The PTO had not raised this purported defense in its examiner rejections, in its answers, or in its summary judgment motions. *See* Pet.App.267-68; Pet.App.293-94. But the Office represented that it would "issue prosecution laches rejections based on the issues identified in its prosecution laches motion when the applications return[ed] to the [PTO]." Appx18880. The District Court granted the PTO's request. Appx18889.

Following additional discovery, the District Court ruled in Petitioner's favor after a five-day bench trial

on the PTO's laches defense. Pet.App.269. Petitioner "did not cause unreasonable and unexplained delay" that might "warrant dismissal of these four matters for prosecution laches." Pet.App.313. The District Court then held trials on the merits and found that Petitioner was entitled to patents for dozens of claims across three applications. Appx111-12.

On appeal, the Federal Circuit vacated the lower court's judgment. The Federal Circuit reiterated its view—which it first expressed in a split 2002 decision—that "prosecution laches" is an "available defense to patent infringement." Pet.App.238 (citing *Symbol Techs., Inc. v. Lemelson Med., Educ. & Rsch. Found., L.P.*, 277 F.3d 1361, 1363, 1366-68 (Fed. Cir. 2002)). The court then extended that holding to make this defense "available to the [PTO] in an action to obtain a patent under 35 U.S.C. §145." Pet.App.216. From there, the court held that the District Court misapplied the Federal Circuit's "totality of the circumstances" test for prosecution laches. Pet.App.244-46. According to the Federal Circuit, a "delay of six years or more" in prosecution creates a "presumption that it is unreasonable, inexcusable, and prejudicial." Pet.App.258 (quotation marks omitted). When that happens, an applicant can avoid prosecution laches only by proving a negative—"that [his] delay has *not* caused the PTO or any third party material prejudice." Pet.App.263 (emphasis added).

On remand, the District Court found that Petitioner had "failed to meet his specific burdens" detailed by the Federal Circuit. Pet.App.208. It thus entered judgment for the PTO. Pet.App.209-11. The court took "no pleasure in this result," but felt

compelled to rule for the PTO based upon the Federal Circuit's decision. Pet.App.208-09.

The Federal Circuit affirmed. Pet.App.7-8. Petitioner timely sought rehearing en banc and urged the Federal Circuit to reconsider prosecution laches. The Federal Circuit denied this request. Pet.App.213-14.

REASONS FOR GRANTING THE PETITION

Certiorari is warranted because the decision below conflicts with this Court's precedents at every turn. In direct conflict with *SCA Hygiene*, the Federal Circuit has once again applied laches to override the clear statutory text of the Patent Act. *See* 580 U.S. at 331-32; *see also Petrella*, 572 U.S. at 679. In so doing, the decision threatens the validity of thousands of issued patents nationwide based on a judge-made and highly discretionary doctrine that disregards Congress's carefully crafted patent scheme. Given the Federal Circuit's exclusive jurisdiction over patent appeals, this Court's intervention is necessary to enforce the Patent Act's text, uphold this Court's precedents, and resolve this critically important question of great public significance.

I. The Court Should Grant Review to Reject the Judge-Made Doctrine of Prosecution Laches.

For more than a century, this Court has made clear that a "party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one." *United States v. Am. Bell Tel. Co.*, 167 U.S. 224, 247 (1897). To that end, "[n]o court can disregard any statutory provisions in respect to these matters on the

ground that in its judgment they are unwise or prejudicial to the interests of the public.” *Id.* Indeed, the Court has relied on exactly that principle in concluding that the equitable doctrine of laches is unavailable to shorten deadlines governing the patent application process. *See Chapman*, 252 U.S. at 137-39.

But that is precisely what the Federal Circuit has endorsed. A divided panel of the court first conceived of the doctrine of prosecution laches as a litigation defense in 2002—fifty years after Congress enacted detailed provisions in the Patent Act governing the timing of patent prosecutions. *See Symbol Techs.*, 277 F.3d at 1363. In doing so, the Federal Circuit created “a new ground on which to challenge patents that fully comply with the statutory requirements.” *Id.* at 1369 (Newman, J., dissenting). The Federal Circuit then extended that doctrine to invest the PTO with “authority to reject patent applications” in the first instance based on prosecution laches. *In re Bogese*, 303 F.3d 1362, 1367 (Fed. Cir. 2002). And, in this case, it took that yet a step further in holding that a “delay of more than six years” in prosecution raises a “presumption that it is unreasonable, inexcusable, and prejudicial.” Pet.App.258 (quotation marks omitted).

None of that was ever authorized by Congress. To the contrary, the Federal Circuit’s freewheeling decisions conflict with the timing requirements that Congress has set. Those decisions further conflict with *SCA Hygiene* and *Petrella*, which hold that laches is a limited “gap-filling doctrine” that has no application when, as here, Congress has enacted a rule

of timeliness. *SCA Hygiene*, 580 U.S. at 335; *see Petrella*, 572 U.S. at 679. And more generally, the Federal Circuit’s position conflicts with this Court’s precedents establishing that—even when generally authorized or historically recognized—resort to equitable doctrines must yield to more specific statutory commands. *See, e.g., Syngenta Crop*, 537 U.S. at 31-32; *Young v. United States*, 535 U.S. 43, 49 (2002). The doctrine of “prosecution laches” is neither a recognized historic artifact nor authorized by some general equitable grant in the administration of patent cases. Because the Patent Act, as amended, comprehensively regulates the timing of patent prosecution, there is no room for “prosecution laches” to override Congress’s judgment.

**A. The Doctrine of Prosecution Laches
Conflicts with the Patent Act’s Text and
this Court’s Precedents.**

The judicial power does not permit courts to rewrite a statutory scheme by claiming an equitable power to craft their own rules. *See United States v. Oakland Cannabis Buyers’ Coop.*, 532 U.S. 483, 497 (2001). Rather, when “Congress explicitly puts a limit upon the time” to act, that is the “end of the matter.” *Holmberg v. Armbrecht*, 327 U.S. 392, 395 (1946); *see also Chapman*, 252 U.S. at 137-38. This Court has applied that rule twice in recent years to reject laches defenses—including under the Patent Act—and the court below should have done the same.

1. Take *Petrella* first. In that case, this Court canvassed the history of laches, observing that it evolved as a “defense” in the “courts of equity.” 572 U.S. at 678. “[I]ts principal application was, and

remains, to claims of an equitable cast for which the Legislature has provided no fixed time limitation.” *Id.* Thus, the doctrine “cannot be invoked” when a party acts “within the time allowed” by law. *Id.* at 679.

Petrella put that principle to practice in a copyright case. As the Court explained, federal copyright law lacked a statute of limitations before 1957. *See id.* at 669. So, to fill the legislative gap as to timeliness of suit, courts “used analogous state statutes of limitations to determine the timeliness of infringement claims.” *Id.* Borrowing analogous state limitations periods was a recognized common-law practice. *See Holmberg*, 327 U.S. at 395. But once Congress passed a timeliness rule for copyright claims, there was no longer a temporal gap in the law. *See Petrella*, 572 U.S. at 670; 17 U.S.C. § 504(b). And so the equitable doctrine of laches had no place. Recognizing “the essentially gap-filling, not legislation-overriding, office of laches,” the Court ruled that laches was no defense to a copyright action filed “within the time allowed” by Congress. *Petrella*, 572 U.S. at 679-80. That limitations period “itself [took] account of delay.” *Id.* at 677.

Three years later, *SCA Hygiene* extended *Petrella*’s reasoning to the Patent Act, holding that laches is not a defense to patent-infringement damages claims. *See* 580 U.S. at 337-39. The Federal Circuit had held that the Patent Act implicitly codified a laches defense, even though it “never identified which word or phrase” of the Patent Act did so. *Id.* at 338. Yet this Court squarely rejected such reasoning, explaining that *Petrella*’s holding—that laches serves only a “gap-filling” role—rests “on both separation-of-powers

principles and the traditional role of laches in equity.” *Id.* at 334-35. “When Congress enacts a statute of limitations, it speaks directly to the issue of timeliness and provides a rule for determining whether a claim is timely.” *Id.* at 334. And allowing courts to apply their own rule of timeliness “would give judges a ‘legislation-overriding’ role that is beyond the Judiciary’s power.” *Id.* at 335 (citation omitted). Thus, the Court ruled that laches could not bar an infringement claim filed “within the period prescribed by [35 U.S.C.] § 286.” *Id.* at 346.

2. The doctrine of prosecution laches cannot be squared with *Petrella* or *SCA Hygiene*. The Patent Act contains comprehensive timing provisions that govern patent prosecution from start to finish, without gap. And with “no gap to fill,” courts cannot exercise their own assessments of timeliness to “jettison Congress’ judgment.” *Id.* at 335 (quotation marks omitted).

To start, the 1952 Congress authorized applicants to file their applications within “one year” of first publication or sale of an invention. Pub. L. No. 82-593, § 102(b), 66 Stat. at 797. And the most recent amendments to the Patent Act likewise contemplate filing by a set time. *See* 35 U.S.C. § 102(a)-(b).

Congress provided an additional deadline for continuation applications. Namely, it authorized their filing “before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application.” *Id.* § 120; *see also id.* § 121 (similar timing requirements for divisional applications). By statutory command, an application filed within this period is timely.

Once an application is filed, the Patent Act comprehensively regulates the timing of the applicant's prosecution actions. It commands the PTO to examine applications and make any rejections through office actions. *See id.* §§ 131-32. And it requires applicants to respond to office actions "within six months." *Id.* § 133. Otherwise, the application is generally considered "abandoned." *Id.* Following two rejections, the applicant who has persisted in his prosecution may appeal to the PTAB. *See id.* § 134. From there, the applicant has no less than 60 days to appeal to the Federal Circuit under §§ 141 and 142 or commence a civil action in federal district court under § 145.

In short, the Patent Act authorizes applicants to take all steps of patent prosecution at prescribed times. Applicants who take those steps, and whose inventions satisfy the criteria for patentability, are entitled to patents. *See id.* §§ 101, 102(a), 131. Courts may not apply equitable doctrines to override that statutory scheme. *See SCA Hygiene*, 580 U.S. at 334-35; *Petrella*, 572 U.S. at 679-80. But that is exactly what the Federal Circuit has done by endorsing prosecution laches.

3. The conflict is particularly acute with respect to continuation practice. *Symbol* recognized that § 120 "provide[s] the backbone for the modern continuation" practice. 277 F.3d at 1365. But it failed to heed the statutory text, which requires that continuation applications filed with co-pendency "shall have the same effect, as to such invention, as though filed on the date of the prior application." *Id.* (quoting 35 U.S.C. § 120). In other words, the statute contains an

express timeliness rule requiring the PTO to give effect to such continuation applications as if filed with the original application. The Federal Circuit concluded that a court may negate the statutory framework in the name of laches and deprive an inventor of the benefit of the statutory priority rule as a penalty for “undue delay.” *Bogese*, 303 F.3d at 1367. But delay *cannot* be “undue” if an application is filed within the statutory period. It is not within a court’s power to say otherwise, and the Federal Circuit’s disregard for § 120 is precisely the type of error that this Court corrected in *Petrella* and *SCA Hygiene*.

4. Nor can prosecution laches be sustained as part of the “background of common-law adjudicatory principles” that Congress generally “expects . . . to apply.” *Minerva*, 594 U.S. at 572 (alteration adopted; quotation marks omitted). *Minerva* upheld the equitable doctrine of “assignor estoppel.” *Id.* at 578. But that was because the doctrine was “well grounded in centuries-old fairness principles.” *Id.* at 566. It “got its start in late 18th-century England and crossed the Atlantic about a hundred years later.” *Id.* at 567.

Prosecution laches has no such pedigree. There was no doctrine of “prosecution laches” in either English common law or available in Chancery. Nor did this Court recognize one before Congress passed the Patent Act in 1952. On the contrary, this Court had “settled” the rule that, when a patent is “prosecuted strictly as required by the statutes and the rules of the Patent Office,” an inventor’s “rights may not be denied or diminished on the ground that [his] delay may have been prejudicial to either public or private interests.” *Chapman*, 252 U.S. at 136-37.

Like this case, *Chapman* involved an applicant who complied with all relevant statutory timeliness requirements, only to have his filing rejected on grounds of “equitable laches.” *Id.* at 132-34. Determining that the deadline at issue was properly based on “statutory” requirements, this Court rejected the use of laches to shorten the period, ruling that equitable principles “cannot prevail against the provisions of the statutes.” *Id.* at 135, 138 (citing *Am. Bell Tel. Co.*, 167 U.S. at 247).

This Court reiterated that rule in *Overland Motor Co. v. Packard Motor Co.*, 274 U.S. 417 (1927). The patentee there filed an original application in 1901, which the Patent Office “repeatedly rejected.” *Id.* at 419. At the time, an applicant had “one year” to file a response to a rejection. *Id.* at 423 (quoting Rev. Stat. § 4894). And the applicant took full advantage of the statute by slow-playing his responses: “on seven different occasions he delayed more than eleven months before filing his response to the Patent Office ruling.” *Id.* at 419. As a result, the application lingered in the Patent Office for more than a decade before a patent was granted. *See id.* An alleged infringer claimed that the patentee abused the statutory time limit and sought dismissal for “want of equity” in delaying prosecution. *Id.* at 422. But the Court rejected that laches defense. Chief Justice Taft explained that he did “not know on what principle [the Court] could apply the equitable doctrine of abandonment by laches in a case where the measure of reasonable promptness is fixed by statute, and no other ground appears by reason of which laches could be imputed to the applicant.” *Id.* at 424. Even though that might allow an applicant to “keep his application

pending so as to enable him to withhold, indefinitely, his invention from the public” and postpone its issuance as a patent, the “answer” to that objection “is that the matter is entirely within the control of Congress.” *Id.* at 423.

Despite these precedents, the court below believed that “[t]he prosecution laches defense originates from two Supreme Court cases in the early 1900s.” Pet.App.236 (citing *Woodbridge v. United States*, 263 U.S. 50 (1923), and *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463 (1924)). Neither decision articulates such a defense. In fact, both *Woodbridge* and *Webster Electric* confirm that courts may not rewrite the deadlines prescribed by Congress.

The applicant in *Woodbridge* originally lost his patent because he did not comply with the law. He took advantage of a statutory right to place a pending application “in the secret archives of the office” before the patent was issued, “not exceeding the term of one year.” 263 U.S. at 52-53 (quoting Act of July 4, 1836, 5 Stat. 121). But *Woodbridge* then let the application languish: “nothing was done” by him for “nine years and a half.” *Id.* at 53. That course of non-action “was in plain violation of the statutory law.” *Id.* at 63. And that failure to comply with the statutory law was the reason *Woodbridge* “forfeited his right to a patent by his delay.” *Id.*; see also *Overland Motor*, 274 U.S. at 427 (“[*Woodbridge*] was denied a patent, for failure to comply with the statute.”).

To the extent the Court discussed laches at all, that too was a result of congressional command. *Woodbridge* successfully petitioned Congress to adopt a “special act” to permit him to sue the United States

for compensation despite his failure to comply with the statute. 263 U.S. at 51. Yet the act provided that Woodbridge could recover only if the court were “satisfied that the said Woodbridge did not forfeit, or abandon, his right to a patent, by publication, delay, laches, or otherwise.” *Id.* (quoting Act of Mar. 2, 1901, 31 Stat. 1788). If anything, this shows that congressional authorization is required before courts can engage in a laches analysis. If laches were otherwise available as a defense, there would have been no need to specify that in Woodbridge’s case. And so *Woodbridge* provides no justification for the Federal Circuit’s rule.

The Federal Circuit’s reliance on *Webster Electric* fares no better. That case involved an interference proceeding, which is an abolished adversarial process within the PTO to determine the priority of an invention between two inventors. *See* 264 U.S. at 464. An interference could be provoked by an applicant who copied the exact claims in an issued patent into a new amended application. *See generally* 3A *Chisum on Patents* § 10.09 (2026). With two identical claim sets in front of the office, the PTO would then declare an interference and take evidence to determine the identity of the first inventor. *See id.* For many years, there was no statutory time limit for “copying for interference.” *Webster Elec.*, 264 U.S. at 469. So the Court borrowed from “analog[ous]” statutes to develop a “two-year time limit” for “cases involving laches.” *Id.* at 469-71. Unlike here, then, the Court did not override any statutory provisions concerning timeliness. And in 1939, Congress amended the patent laws to “expressly dea[l]” with the “*Webster Electric* problem” by adding a one-year deadline. 4

Chisum on Patents § 11.05[1][b] (2026). It therefore closed the timing gap that *Webster Electric* had filled.

The PTO has also sought to ground prosecution laches in *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159 (1938). Again, that case provides no help. The lower court there held that “an applicant who waits longer” than two years from his original patent before asserting a claim “must justify his delay.” *Id.* at 164. But this Court rejected that freewheeling approach. The applicant’s “disclosure was continuously before the patent office,” as required for him to claim priority. *Id.* at 165. And it made no difference that an intervening patent was issued to another inventor. The law said so. “By R. S. § 4886, delay in filing an application for not more than two years after an intervening patent or publication does not bar a patent unless the invention ‘is proved to have been abandoned.’” *Id.* at 168 (citation omitted). The “mere delay in filing a divisional application for not more than two years after an intervening patent or publication” did “not operate to enlarge the patent monopoly beyond that contemplated by the statute.” *Id.* So the applicant was entitled to his patent. *See id.*

The PTO gets no further by relying upon *General Talking Pictures Corp. v. Western Electric Co.*, 304 U.S. 175 (1938). That case did not even mention the word “laches.” The question presented was whether an inventor could use a continuation application to assert additional claims more than two years after he first publicly used the invention. *Id.* at 177, 182. The Court held that under the statute, “[t]he effective dates of the claims in the continuation applications are those of the original applications.” *Id.* at 183. And

“[i]n the absence of intervening adverse rights for more than two years prior to the continuation applications, they were in time.” *Id.* (citing Rev. Stat. § 4886). Once again, the statutory timing provisions controlled.

Thus, the cases that the Federal Circuit and PTO rely upon do not indicate that a prosecution laches doctrine existed in 1952. And, even if one did, equitable doctrines must yield where their application would be “inconsistent with the text of the relevant statute.” *Young*, 535 U.S. at 49 (citation omitted); *see also Syngenta Crop*, 537 U.S. at 31-32. That is precisely the case here. Congress passed a comprehensive set of timing provisions that “take[] account of delay.” *Petrella*, 572 U.S. at 677. Laches, as a “gap-filling doctrine,” simply does not apply because “there is no gap to fill.” *SCA Hygiene*, 580 U.S. at 335; *see also Oakland Cannabis*, 532 U.S. at 497 (“Courts of equity cannot, in their discretion, reject the balance that Congress has struck in [the] statute.”).

* * *

The Federal Circuit’s prosecution laches doctrine finds no support in statutory text or historical practice. And it squarely conflicts with *SCA Hygiene* and *Petrella*. The Court should grant certiorari to review and reject the Federal Circuit’s judge-made doctrine.

B. The PTO’s Assertion of Prosecution Laches Further Conflicts with the Patent Act’s Text and this Court’s Precedents.

Even if prosecution laches were available as a defense in infringement litigation (notwithstanding *SCA Hygiene*), it still would not follow that the PTO could rely upon the doctrine itself to deny the issuance of a patent. After all, “[a]dministrative agencies” like the PTO “are creatures of statute.” *Nat’l Fed’n of Indep. Bus. v. OSHA*, 595 U.S. 109, 117 (2022). “They accordingly possess only the authority that Congress has provided.” *Id.* The PTO’s power to assert laches thus must rest on a statutory grant. But there is none.

1. The statutory text provides just the opposite. The Patent Act confers on applicants the right to a patent—and the commensurate duty of the PTO to issue a patent—upon satisfaction of the Act’s “conditions and requirements”:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 101; *see also id.* § 102(a) (“A person shall be entitled to a patent unless . . .”). The plain meaning is that the inventor’s right to a patent is governed by the “conditions and requirements” of Title 35—not principles of equity.

Consistent with that text, this Court has recognized that the PTO’s examination role is limited to “determin[ing] whether the application satisfies the *statutory prerequisites* for granting a patent.” *Hyatt*,

566 U.S. at 434 (emphasis added). When those statutory conditions are met, the applicant is “entitled to a patent,” and “the Director *shall* issue a patent therefor.” 35 U.S.C. § 131 (emphasis added). Congress’s “use of the word ‘shall’ ‘creates an obligation impervious to judicial discretion’” or administrative fiat. *Smith v. Spizzirri*, 601 U.S. 472, 476 (2024) (citation omitted). The Director thus has no discretion to deny issuance based on equity.

2. The Federal Circuit has failed to grapple with this statutory text. In *Bogese*, it approved the PTO’s use of prosecution laches to deny patent issuance but identified no express statutory authorization for such authority. At most, the Court relied upon 35 U.S.C. § 2(a), which states the PTO’s general powers, including that it shall be “responsible for the granting and issuing of patents.” 303 F.3d at 1368. As in *SCA Hygiene*, Section 2(a) “does not specifically mention laches,” and the Federal Circuit “never identified which word or phrase in [§ 2(a)] codifies laches” as a ground for rejection. 580 U.S. at 338. *Bogese* thus relied on the same error that this Court corrected in *SCA Hygiene*.

Nothing in that general statement of the PTO’s authority to issue patents confers upon the agency an equitable discretion to deny issuance when the “statutory prerequisites” are otherwise met. *Hyatt*, 566 U.S. at 434. Nor could such a general statement be plausibly read to override the specific timing provisions that Congress has adopted. See *Fourco Glass Co. v. Transmirra Prods. Corp.*, 353 U.S. 222, 228 (1957) (“[G]eneral language of a statute . . . will not be held to apply to a matter specifically dealt with

in another part of the same enactment.” (citation omitted)). Section 2(a) provides no basis to override Congress’s express command that the PTO “shall” issue patents upon satisfaction of the Patent Act’s “conditions and requirements.” 35 U.S.C. §§ 101, 131.

3. Amendments following the Patent Act’s passage in 1952 only confirm that Congress intended for patent applicants with long-pending applications to have the same rights to review as all other applications. The Uruguay Round Agreements Act amended the law to provide that the patent term runs from the time of filing, rather than issuance, thereby putting a hard limit on possible delay attributable to the applicant. *See* 35 U.S.C. § 154. Congress was well aware of the effects this could have on lawful continuation application practice. But it directed the PTO “to provide for *further limited* reexamination” of applications that had been pending more than two years prior to the URAA’s effective date. URAA § 532(a)(1) (emphasis added). The associated Statement of Administrative Action, which has the force of law, *see* 19 U.S.C. § 3512(d), sets a limit requiring the PTO to “consider on the merits the first and second such submissions.” H.R. Rep. No. 103-316, Vol. 1, at 1006 (1994); *see also* 37 C.F.R. § 1.129.

What Congress did not do was direct the PTO to examine each application chain for laches. Instead the mandate was just the opposite—to provide specific limited examination of new submissions. Petitioner fully complied with the requirements for making those submissions.

4. The PTO’s practice for decades following the adoption of the Patent Act further confirms that it

does not, and has never had, the power to assert laches. As late as 1992, the PTO's Board of Patent Appeals and Interferences stated:

Obviously, laches does *not* apply to an application pending in the Patent and Trademark Office The examiner has not cited any case law in support of his position, and we are aware of none.

Fed. Cir. Dkt. 121-1, at 517 (emphasis added) (Supplemental JA). Thus, 40 years after passage of the Patent Act in 1952, the PTO's appellate body remained unaware of any claimed laches power.

* * *

Nothing in the Patent Act authorizes the PTO to assert prosecution laches. And absent statutory authorization, there is simply “no basis on which to grant authority to the patent examination agency to impose its own non-statutory time limits” and “refuse to grant a patent on an otherwise patentable invention.” *Bogese*, 303 F.3d at 1370 (Newman, J., dissenting). This Court should grant review to reject that administrative overreach.

C. The Federal Circuit's Standard for Prosecution Laches Only Underscores the Arbitrary Nature of the Doctrine.

The Federal Circuit's “prosecution laches” doctrine was not only wrong from the outset, but it has steadily drifted over time from any kind of traditional or predictable doctrine. “Laches is ‘a defense developed by courts of equity’ to protect defendants against ‘unreasonable, prejudicial delay in commencing suit.’” *SCA Hygiene*, 580 U.S. at 333 (quoting *Petrella*, 572

U.S. at 667, 678); *see also* 1 Dan B. Dobbs, *Law of Remedies* 89 (2d ed. 1993) (“The equitable doctrine of laches bars the plaintiff whose unreasonable delay in prosecuting a claim or protecting a right has worked a prejudice to the defendant.”). Thus, laches has always required proof of two elements—undue delay and prejudice. *See, e.g., Kansas v. Colorado*, 514 U.S. 673, 687-88 (1995).

The Federal Circuit’s test pays mere lip service to these elements. Rather than assess the applicant’s delay in prosecuting the application at issue, the court has embraced a “totality of the circumstances” approach that scrutinizes anything the applicant has done in the broader “statutory patent system.” Pet.App.236 (citation omitted). The court here thus faulted the District Court for “focus[ing] its analysis on the four specific applications at issue in this case.” Pet.App.246. And it criticized the District Court for “refus[ing] to consider evidence of [Petitioner’s] pattern of prosecution conduct after 2012”—years after the applications here left the PTO’s domain. Pet.App.245. That type of roving assessment of the equities has no place in the traditional laches inquiry.

Worse yet, the Federal Circuit has now created a six-year “presumption” for undue delay. *See* Pet.App.258. This shifts the burden from the party asserting the “affirmative defense[]” of laches (here the PTO) to the party charged with it. *Petrella*, 572 U.S. at 680. So, after six years of prosecution, any resulting patent is presumed unenforceable, even though Congress has said the opposite—that a “patent shall be presumed valid.” 35 U.S.C. § 282(a). This

only underscores the errors in the Federal Circuit's approach.

With respect to prejudice, the Federal Circuit has adopted the same six-year presumption. Pet.App.263. That makes no sense either, particularly for cases in which the PTO asserts laches. The PTO is not a private rightsholder. And unlike traditional laches—which is a personal defense—PTO-asserted laches negates the patent right against the world for all time.

The Federal Circuit's six-year cutoff also lacks any basis in logic or law. The court's standard traces to *A.C. Aukerman Co. v. R.L. Chaides Construction Co.*, 960 F.2d 1020, 1034-35 (Fed Cir. 1992) (en banc), where the Federal Circuit crafted a "presumption of laches" by "borrow[ing] the six-year damage limitation period in the patent statute now set out in section 286." The lower court uncritically imported that presumption here. But this Court rejected *Aukerman's* view of laches entirely in *SCA Hygiene*. See 580 U.S. at 332-33. And, even if it did not, the six-year damages period of § 286 bears no relation to the length of prosecution. The selection of that time period in the prosecution context is entirely arbitrary, particularly because the calculated delay period includes the time the PTO takes to respond to the applicant's submissions.

Moreover, the Federal Circuit failed to explain how the PTO might suffer the types of "evidentiary or economic" prejudice from delay that laches traditionally requires. 27A *American Jurisprudence 2d Equity* § 144 & n.1 (2026). The court avoided the issue by claiming that where "the applicant's conduct unduly increases the administrative burden of the

PTO,” it “thereby effectively taxes everyone using the system,” allegedly creating a “dangerous likelihood” of “harming the public’s interest more broadly.” Pet.App.259. Whatever the merit of that policy rationale, it is not laches. And it cannot be found in the statute that Congress adopted.

* * *

In short, the Federal Circuit’s nebulous laches doctrine for the PTO is untenable, unsupported by any statutory authorization, and beyond the proper role of the judiciary. This Court should intervene to restore the clear timing provisions that Congress prescribed in the Patent Act.

II. The Question Presented Is of Great Importance, and this Case Offers an Excellent Vehicle for Resolving It.

A. The question presented is also exceptionally important and worthy of this Court’s review. The Federal Circuit’s unprecedented and highly problematic expansion of “prosecution laches”—including the new presumption that any delay over six years is “unreasonable, inexcusable, and prejudicial”—has “upset the very foundation of patent prosecution in America.” Gene Quinn, *Prosecution Laches and the Death of Continuations*, IPWatchdog (July 1, 2024), <https://bit.ly/4cwZ5mw>. It threatens the rights of innumerable patentholders and patent applicants, creates massive uncertainty that will disrupt critical industries worth billions of dollars, and has set off a surge in litigation.

Consider the far-reaching threats posed by the doctrine. It jeopardizes the rights of patentholders

and patent applicants alike. *See Symbol Techs.*, 277 F.3d at 1363 (patentholders); *Bogese*, 303 F.3d at 1367 (patent applicants). And because the Federal Circuit has exclusive appellate jurisdiction over patent cases, 28 U.S.C. § 1295(a), its continuing reliance upon prosecution laches affects *all* patentholders and patent applicants nationwide.

The implications are staggering. According to PTO data, nearly twenty percent of all continuation patent applications have filing dates more than six years after their earliest priority date. *See* Setting and Adjusting Patent Fees During Fiscal Year 2025, 89 Fed. Reg. 91,898, 91,911 (Nov. 20, 2024). So do over a third of the patents protecting the most successful pharmaceutical products. *See* Kate Gaudry, *Does Hyatt v. Hirshfeld Mean That More than One-Third of Patents on the Top Pharmaceuticals are Presumed Invalid?*, IPWatchdog (Feb. 6, 2023), <https://bit.ly/3ZFSOgU>. Under the Federal Circuit’s view, *all* of these applications and patents are now under a cloud of potential invalidity. That will disrupt the settled expectations of companies across the globe that obtained their patents by following the law Congress enacted, as well as those applying for patents through lawful, ordinary-course patent prosecution practice. *See id.*

This uncertainty harms the many industries that rely on patent protection to both recoup their investments and fund research and development. Patents confer “rights of immense value . . . upon the patentee”—specifically, “the right to exclude others from making, using, offering for sale, or selling [their] invention throughout the United States.” *Oil States*

Energy Servs., LLC. v. Greene’s Energy Grp., LLC, 584 U.S. 325, 335 (2018) (citations omitted). Companies rely on these rights to recoup “rewards commensurate with the[ir] services rendered” to the public, through “[s]acrificial days devoted to . . . creative activities.” *Mazer v. Stein*, 347 U.S. 201, 219 (1954). And companies “will not invest sufficiently in invention or creation unless the expected return from doing so exceeds the cost of doing so”—which patent protection enables. Herbert Hovenkamp et al., *IP and Antitrust: An Analysis of Antitrust Principles Applied to Intellectual Property Law* § 1.01 (3d ed. 2025). This is particularly true in the pharmaceutical field, where companies invest billions of dollars in clinical development for patent-protectable innovations. See Gaudry, *supra*. By casting a cloud over the patent rights of these companies—and thus their ability to recoup their substantial investment in research and development—the Federal Circuit’s judge-made doctrine undermines the very incentive to invest in critical research and development that the patent laws are supposed to provide.

Further, the Federal Circuit’s decision in this case has triggered a predictable surge in litigation. While the Federal Circuit initially recognized prosecution laches in 2002, this defense “is relatively new in that it is now being asserted” frequently following the court’s 2021 decision. Shashank Upadhye, *Generic Pharmaceutical Patent & FDA Law* § 20:10 (2024). Based on publicly available sources, prosecution laches has been asserted in hundreds of patent cases

since the court issued its decision.³ Those numbers will only grow unless this Court steps in now.

B. Finally, this case is an ideal vehicle for review. It presents a clean question of law that was fully vetted below. There are no preservation issues, as Petitioner has argued at every stage of the case that the PTO cannot assert prosecution laches. And the issue is outcome-determinative. The District Court held that Petitioner was entitled to patents after a full trial, and the Federal Circuit vacated that judgment solely on the ground of “prosecution laches.” Pet.App.216, 234.

The court below has also made clear that it stands by its prosecution laches precedents. The panel suggested at oral argument that, notwithstanding *Petrella* and *SCA Hygiene*, only the en banc court could reconsider the doctrine. See Oral Arg. Audio (No. 18-2390) at 11:47-11:59, 14:10-14:20, 14:48-15:17. Yet when presented with the opportunity to do so, the Federal Circuit declined to rehear the case en banc. As a result, this Court’s review is the only avenue for resolving the conflict between the Federal Circuit’s ill-considered doctrine and this Court’s precedents.

* * *

In the end, the Federal Circuit’s conception of prosecution laches imperils existing patent rights worth billions of dollars, and it will chill legitimate patent practice going forward. This Court should

³ For example, on Docket Navigator—an online resource that compiles publicly available pleadings, decisions, and orders in patent cases—a search for the term “prosecution laches” in Answers filed after August 1, 2021 returned hundreds of cases.

grant certiorari to resolve this exceptionally important issue and uphold the patent regime that Congress enacted.

CONCLUSION

The Court should grant the petition.

Respectfully submitted,

STEVEN A. ENGEL
DECHERT LLP
1900 K Street, NW
Washington, DC 20006

G. ERIC BRUNSTAD JR.
DECHERT LLP
199 Lawrence Street
New Haven, CT 06511

ANDREW M. GROSSMAN
MARK W. DELAQUIL
BAKER & HOSTETLER LLP
1050 Connecticut Ave., NW
Suite 1100
Washington, DC 20036

MARTIN J. BLACK
Counsel of Record
MICHAEL H. MCGINLEY
SHARON K. GAGLIARDI
JUDAH BELLIN
BRIAN A. KULP
DECHERT LLP
Cira Centre
2929 Arch Street
Philadelphia, PA 19104
(215) 994-4000
martin.black@dechert.com

Counsel for Petitioner

March 2, 2026

APPENDIX

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**APPENDIX A — OPINION OF THE UNITED
STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED AUGUST 29, 2025**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2018-2390, 2018-2391, 2018-2392, 2019-1049,
2024-1992, 2024-1993, 2024-1994, 2024-1995,
2019-1038, 2019-1039, 2019-1070

GILBERT P. HYATT,

Plaintiff-Cross-Appellant

v.

COKE MORGAN STEWART, ACTING
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND ACTING
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE,

Defendant-Appellant

Decided: August 29, 2025

Appeals from the United States District Court for the
District of Columbia in Nos. 1:05-cv-02310-RCL, 1:09-cv-
01864-RCL, 1:09-cv-01869-RCL, 1:09-cv-01872-RCL,
Senior Judge Royce C. Lamberth.

Before REYNA, WALLACH, and HUGHES, *Circuit Judges*.

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REYNA, *Circuit Judge*.

This case is back before us following our earlier decision in *Hyatt v. Hirshfeld*, 998 F.3d 1347 (Fed. Cir. 2021). For the reasons discussed below, we affirm the district court’s judgment for the United States Patent and Trademark Office on the affirmative defense of prosecution laches. As to Mr. Hyatt’s cross-appeal, we conclude that the district court correctly determined that it lacked Article III jurisdiction over a set of pending claims.

BACKGROUND

The facts and legal issues presented in this appeal are similar to those that we addressed in *Hyatt v. Hirshfeld*, 998 F.3d 1347 (Fed. Cir. 2021) (“*Hyatt I*”). So, we offer an abbreviated version of the background facts, including the district court’s decision on remand.

I. Initial Proceedings

Gilbert P. Hyatt is an inventor and registered patent agent. In the early 1970s, Mr. Hyatt began filing patent applications with the United States Patent and Trademark Office (“PTO”). In the months leading to the June 8, 1995 effective date for certain commitments and obligations undertaken at the Uruguay Round for the General Agreement on Tariffs and Trade (“GATT”), Mr. Hyatt filed nearly 400 applications (“GATT Bubble Applications”).

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This appeal concerns four of Mr. Hyatt’s GATT Bubble Applications. *Hyatt I*, 998 F.3d at 1353. The patent examiner rejected most, if not all, of the claims for each application. *Id.* at 1355. Mr. Hyatt appealed these rejections to the Board of Patent Appeals and Interferences (“Board”). *Id.* For each application, the Board affirmed the examiner’s rejections of certain claims. *Id.* For some applications, the Board reversed the examiner’s rejections of certain claims. *Id.*

In 2005 and 2009, Mr. Hyatt filed four actions in federal district court under 35 U.S.C. § 145 to secure allowance of all claims in his four GATT Bubble Applications.¹ *Id.* The PTO asserted affirmative defenses of prosecution laches and invalidity for anticipation and lack of written description for all claims. *Id.* at 1351, 1355-56.

In all four actions, the district court determined that the PTO’s defenses of prosecution laches and invalidity failed, granting judgment in favor of Mr. Hyatt as to the pending claims for which the Board had affirmed the patent examiner’s rejections. *Id.* at 1359. As to the pending claims for which the Board reversed the patent

1. An applicant may appeal an adverse decision by the Patent Trial and Appeal Board (“PTAB”) directly to this court or may file a civil action in U.S. District Court for the Eastern District of Virginia. 35 U.S.C. § 145 (2025). For the remainder of this opinion, we cite to the 2002 version of 35 U.S.C. § 145, which was in force at the time Mr. Hyatt filed his § 145 actions. The two substantive differences between the current version and the 2002 version are that the latter referred to the Board of Patent Appeals and Interferences, the predecessor to the PTAB, and allowed suits in the U.S. District Court for the District of Columbia.

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examiner's rejections, the district court determined that it lacked jurisdiction over those claims. J.A. 77 n.12.² The district court explained that “[t]he Constitution’s case or controversy requirement bars the Court from issuing an Order on claims not in dispute before it.” *Id.* (citing U.S. Const. Art. III, § 2, cl. 1).

The PTO appealed the four judgments, arguing that prosecution laches prevented issuance of the pending claims at issue, and in the alternative, the pending claims were invalid. *Hyatt I*, 998 F.3d at 1359. Mr. Hyatt cross-appealed three of the judgments, raising the single issue of whether the district court had Article III jurisdiction over the set of pending claims for which the Board reversed the patent examiner’s rejections, i.e., the portion of the Board’s decisions which were decided in Mr. Hyatt’s favor. *Id.*

II. *Hyatt I*

We consolidated the PTO’s appeals, Appeal Nos. 18-2390, 18-2391, 18-2392, and 19-1049, and Mr. Hyatt’s cross-appeals, Appeal Nos. 19-1038, 19-1039, and 19-1070. Following briefing and argument, we vacated the district court’s judgments in the four § 145 actions, concluding that the court had misapplied the standard for prosecution laches and that under the correct legal standard, the PTO satisfied its burden of proving that Mr. Hyatt engaged in unreasonable and unexplainable delay in prosecuting his applications at issue. *Id.* at 1369. We explained that, like

2. This is the joint appendix filed in Appeal Nos. 18-2390, 18-2391, 18-2392, and 19-1049, and Mr. Hyatt’s cross-appeals, Appeal Nos. 19-1038, 19-1039, and 19-1070.

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the party asserting a prosecution laches defense in an infringement action, the party asserting a prosecution laches defense in a § 145 action must show the delay was prejudicial. *Id.*

We therefore remanded the issue of prosecution laches to allow for Mr. Hyatt to present evidence on whether the delay was prejudicial. *Id.* at 1371. We, however, retained jurisdiction over the PTO's appeals with respect to the anticipation and written description issues, holding these issues in abeyance pending the district court's remand decision on prosecution laches. *Id.* at 1371-72. Mr. Hyatt's cross-appeals remain pending before this court.

III. Proceedings on Remand

On remand, the district court held a nearly three-week bench trial on the issue of prosecution laches. SAppx4.³ The district court then issued a 102-page remand decision, finding that “the complete trial record require[s] a singular result—judgment for the PTO. No other result is even colorable.” SAppx102. The district court noted that it “takes no pleasure in this result,” but that Mr. Hyatt “at last received a full and fair hearing on prosecution laches.” *Id.*

The district court transmitted its decision to this court, prompting Mr. Hyatt to file notices of appeal in

3. “SAppx” refers to the joint supplemental appendix filed in Mr. Hyatt's most recent appeals, Nos. 24-1992, 24-1993, 24-1994, and 24-1995.

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each underlying action. These four appeals, Appeal Nos. 24-1992, 24-1993, 24-1994, 24-1995, have now been consolidated with the actions we have held in abeyance, Appeal Nos. 18-2390, 18-2391, 18-2392, and 19-1049, and with Mr. Hyatt's cross-appeals, Appeal Nos. 19-1038, 19-1039, and 19-1070.

IV. Most Recent Appeals 24-1992, 24-1993, 24-1994, 24-1995

In the most recent appeals, Mr. Hyatt raises two challenges. He first argues that the defense of prosecution laches is not available in a § 145 action. Appellant Br. 14-29. He then argues in the alternative that the district court abused its discretion in determining that prosecution laches applied in the four § 145 actions. *Id.* at 29-33. For the reasons discussed more fully below, we disagree with Mr. Hyatt on both points and thus affirm the district court's judgments for the PTO based on a defense of prosecution laches. As a result, we do not address the PTO's pending appeals of anticipation and lack of written description support, which are now moot. *eSimplicity, Inc. v. United States*, 122 F.4th 1373, 1376 (Fed. Cir. 2024). We address Mr. Hyatt's cross-appeals, which remain at issue. We have jurisdiction under 28 U.S.C. § 1295(a)(4).

STANDARD OF REVIEW

We review a district court's conclusions of law de novo and its factual findings for clear error. *Endo Pharms. Sols., Inc. v. Custopharm Inc.*, 894 F.3d 1374, 1379 (Fed. Cir. 2018). We review a district court's determination of

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prosecution laches for abuse of discretion. *Hyatt I*, 998 F.3d at 1359 (citing *Cancer Rsch. Tech. Ltd. v. Barr Lab’ys Inc.*, 625 F.3d 724, 728-29 (Fed. Cir. 2010)). “We may find an abuse of discretion on a showing that the court . . . exercised its discretion based upon an error of law or clearly erroneous factual findings.” *Id.* (citation omitted).

DISCUSSION**I.**

Mr. Hyatt first argues that the defense of prosecution laches is unavailable in a § 145 action. According to Mr. Hyatt, prosecution laches “is inconsistent with” the Patent Act of 1952 and recent Supreme Court precedent confirms this. *See* Appellant Br. 14-16, 18-19. Specifically, Mr. Hyatt argues that *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 134 S.Ct. 1962, 188 L.Ed.2d 979 (2014) and *SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC*, 580 U.S. 328, 137 S.Ct. 954, 197 L.Ed.2d 292 (2017) foreclose the defense of prosecution laches in a § 145 action.⁴ Appellant Br. 15-16. Mr. Hyatt also argues more narrowly, that even if prosecution laches survived the passage of the Patent Act for certain actions, such as an infringement action, it is not valid in the narrow

4. In *Petrella*, the Supreme Court held that Congress displaced the defense of litigation laches to copyright-infringement damages by specifying a statute of limitations in the Copyright Act. 572 U.S. at 677, 134 S.Ct. 1962. Three years later in *SCA Hygiene*, the Supreme Court held that litigation laches is not a defense to patent-infringement damages claims under the Patent Act. *See* 580 U.S. at 331-32, 137 S.Ct. 954.

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circumstances presented here, a § 145 action involving transitional applications like Mr. Hyatt's four GATT Bubble Applications. *Id.* at 13-14.

We already considered and rejected these same arguments in *Hyatt I*, and thus, they are foreclosed by the law-of-the-case doctrine. “The law-of-the-case doctrine posits that when a court decides upon a rule of law, that decision should continue to govern the same issues in subsequent stages in the same case.” *ArcelorMittal France v. AK Steel Corp.*, 786 F.3d 885, 888 (Fed. Cir. 2015) (quotations omitted). Issues decided “explicitly or by *necessary inference from the disposition*” constitute the law of the case. *Kori Corp. v. Wilco Marsh Buggies & Draglines, Inc.*, 761 F.2d 649, 657 (Fed. Cir. 1985) (emphasis added).

In *Hyatt I*, Mr. Hyatt argued that (1) the defense of prosecution laches did not survive the passage of the Patent Act; (2) even if it did survive the passage of the Patent Act, *Petrella* and *SCA Hygiene* now foreclose the defense of prosecution laches in a § 145 action; and (3) at a minimum, this defense did not extend to transitional applications in a § 145 action. *See* Corrected Brief of Plaintiff-Cross-Appellant Gilbert P. Hyatt (“Prior Cross-Appellant Br.”), *Hyatt v. Stewart*, No. 18-2390, ECF No. 47 at 49-54. We explicitly rejected Mr. Hyatt's first argument. *Hyatt I*, 998 F.3d at 1362 (“Before turning to the merits of prosecution laches, we address the threshold issue of whether the PTO can assert the defense of prosecution laches in a § 145 action. *We hold that it can.*” (emphasis added)). We then explained why that is and provided a

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detailed history of the prosecution laches defense in patent actions. *See id.* at 1359-63. As to Mr. Hyatt's second and third arguments, we necessarily considered them and did not find them convincing, as evidenced by our remand for further proceedings on prosecution laches. *See id.* at 1371-72.

Thus, given that we already considered and rejected Mr. Hyatt's arguments, we will not address them again. They are foreclosed by the law of the case. *See ArcelorMittal France*, 786 F.3d at 888.

II.

Mr. Hyatt's second challenge is that the district court abused its discretion in ruling in the PTO's favor on prosecution laches. Appellant Br. 29-33. Specifically, Mr. Hyatt raises one narrow argument: that his prosecution conduct from 1992 until 2002 was justified by a 1992 decision from the Board on one of his applications ("1992 Board Decision") that reversed a rejection based on prosecution laches. *See id.* at 29-30. Mr. Hyatt argues that in light of the 1992 Board Decision, he had no reason to change the manner in which he prosecuted his applications until 2002, when this court announced in *Symbol Technologies, Inc. v. Lemelson Medical, Education & Research Foundation, L.P.*, 277 F.3d 1361 (Fed. Cir. 2002), that prosecution laches was an available defense in district court infringement actions. Appellant Br. 30-31.

Mr. Hyatt's argument is forfeited because he failed to make it before the district court. *Ironburg Inventions*

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Ltd. v. Valve Corp., 64 F.4th 1274, 1286 (Fed. Cir. 2023); *In re Google Tech. Holdings LLC*, 980 F.3d 858, 863 (Fed. Cir. 2020). Before the district court, Mr. Hyatt did not present the same argument he now makes on appeal. Across his more than 500 pages of post-trial briefing, Mr. Hyatt mentioned the 1992 Board Decision twice and only in the context of noting that it supported his serial prosecution practice in the 1990s. *See* SAppx235798-99 (¶ 72); SAppx236359. He never developed the argument that the 1992 Board Decision justified his prosecution delay up until 2002, when this court issued *Symbol*, and which allegedly changed the reasonableness of his reliance on the 1992 Board Decision. So understandably, the district court did not consider this argument. We, too, will not consider this argument.

And in any event, the district court recognized Mr. Hyatt's narrow reliance on the 1992 Board Decision as support for his serial prosecution practice, SAppx20, but ultimately determined that Mr. Hyatt's prosecution delay was unreasonable. *See* SAppx102. The district court arrived at this conclusion following more than 1,000 pages of post-trial briefing, and a nearly three-week trial, during which the district court admitted hundreds of exhibits into evidence. *See id.* The district court then weighed the testimony and evidence, making 247 findings of fact, none of which Mr. Hyatt challenges on appeal. SAppx16-78. The district court also made various conclusions of law, ultimately concluding that the "complete trial record require[s] a singular result—judgment for the PTO. No other result is even colorable." SAppx102. Given the

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record, we see no abuse of discretion in the district court's judgment for the PTO.

III.

We turn to Mr. Hyatt's cross-appeals. To start, no party disputes that the district court had Article III jurisdiction over the portion of the Board's decisions that affirmed the examiner's rejections. Rather, the parties dispute whether the district court had Article III jurisdiction over the portion of the Board's decisions that reversed the examiner's rejections.⁵ The district court concluded that there was no "case or controversy" as to these pending claims. J.A. 77 n.12. For the following reasons, we agree with the district court that Article III jurisdiction is lacking as to the pending claims for which the Board reversed the examiner's rejections.

Article III of the Constitution imposes a threshold requirement "that those who seek to invoke the power of federal courts must allege an actual case or controversy." *O'Shea v. Littleton*, 414 U.S. 488, 493, 94 S.Ct. 669, 38 L.Ed.2d 674 (1974); *Lujan v. Defs. of Wildlife*, 504 U.S. 555, 559-61, 112 S.Ct. 2130, 119 L.Ed.2d 351 (1992). As part of the case or controversy requirement, the party invoking a federal court's jurisdiction must demonstrate standing. *Wittman v. Personhuballah*, 578 U.S. 539, 543, 136 S.Ct.

5. In the four Board decisions giving rise to Mr. Hyatt's four § 145 actions, one affirmed all the examiner's rejections. The other three reversed certain rejections and affirmed others. It is with respect to these three decisions that Mr. Hyatt focuses his cross-appeals.

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1732, 195 L.Ed.2d 37 (2016). “A party has standing only if he shows that he has suffered an ‘injury in fact,’ that the injury is ‘fairly traceable’ to the conduct being challenged, and that the injury will likely be ‘redressed’ by a favorable decision.” *Id.* (quoting *Lujan*, 504 U.S. at 560-61, 112 S.Ct. 2130).

Relevant here, “Congress may enact statutes creating legal rights, the invasion of which creates standing, even though no injury would exist without the statute.” *Linda R.S. v. Richard D.*, 410 U.S. 614, 617 n.3, 93 S.Ct. 1146, 35 L.Ed.2d 536 (1973). The statute at issue provides a patent applicant with the legal remedy of a “civil action against the [PTO] Director,” when the applicant is “*dissatisfied*” with a Board decision in an appeal from a patent examiner’s rejection of pending claims. 35 U.S.C. § 145 (emphasis added). The statute provides that:

[a]n applicant *dissatisfied with the decision of the [Board]* in an appeal under section 134(a) may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in [district court]. . . . The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the [Board], as the facts in the case may appear and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law.

35 U.S.C. § 145 (emphasis added).

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Mr. Hyatt fails to establish Article III jurisdiction over pending claims for which the Board reversed the examiner's rejections. In his complaints, Mr. Hyatt made a bare allegation of dissatisfaction with the Board's decision. *See* Complaint, *Hyatt v. Stewart*, No. 09-cv-1864, (D.D.C. Sept. 25, 2009), ECF No. 5 at 3-4 ('398 App. Complaint) (discussing the Board's *affirmance* of the examiner's rejections and then stating, "[b]eing dissatisfied with the decision of the Board, Mr. Hyatt now seeks relief from this Court as statutorily permitted under 35 U.S.C. § 145"); Complaint, *Hyatt v. Stewart*, No. 09-cv-1869, (D.D.C. Sept. 25, 2009), ECF No. 5 at 3-4 ('062 App. Complaint) (similar); Complaint, *Hyatt v. Stewart*, No. 09-cv-1872, (D.D.C. Sept. 25, 2009), ECF No. 5 at 3-4, ('639 App. Complaint) (similar). We assume, without deciding, that Mr. Hyatt's bare allegation of dissatisfaction with the Board's decision is enough to establish Article III jurisdiction over the Board's reversal of the examiner's rejections at the pleading stage. However, this bare allegation is not enough to establish Article III jurisdiction for the remainder of litigation. *See Lujan*, 504 U.S. at 561, 112 S.Ct. 2130; *Wittman*, 578 U.S. at 543, 136 S.Ct. 1732 ("The need to satisfy these [Article III] requirements persists throughout the life of the lawsuit."). When jurisdiction is disputed during later phases of litigation, the party invoking federal jurisdiction must show he suffered an injury by submitting "affidavit[s] or other evidence." *Wittman*, 578 U.S. at 545, 136 S.Ct. 1732 (alteration in original) (citation omitted). The party simply cannot allege nonobvious harm, without more. *Id.*

Here, there is no "more." Mr. Hyatt made no argument below that he was dissatisfied with the Board's reversal

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of the examiner’s rejections or presented evidence of harm stemming from the Board’s reversal. *See* Corrected Response and Reply Brief for the Defendant-Appellant, Andrei Iancu, *Hyatt v. Stewart*, No. 18-2390, ECF No. 50 at 49-54, 65 (“Mr. Hyatt presented no argument to the district court as to why he was dissatisfied with the Board’s reversal on those claims.”); *see, e.g.*, Plaintiff Gilbert P. Hyatt’s Proposed Findings of Fact and Conclusions of Law, *Hyatt v. Stewart*, No. 09-cv-1864 (D.D.C. March 6, 2018), ECF No. 220 at 1, 167 ¶ 497 (noting in conclusory fashion that “Mr. Hyatt is also entitled to a patent on claims . . . , the rejections for which were all reversed by the Board”). Nor can we discern, without more, how Mr. Hyatt was injured from the Board’s reversal of the examiner’s rejections. Thus, we need go no further. Based on this record, Mr. Hyatt does not have standing under Article III to bring a § 145 action as to the pending claims for which the Board reversed the examiner’s rejections.

Mr. Hyatt, however, argues that there is Article III jurisdiction over all claims he put forth before the district court. Prior Cross-Appellant Br. 87-88. Mr. Hyatt argues that § 145 treats “the decision of the Board” as “an undivided whole, thereby encompassing all the claims subject to that decision—including those for which the Board reversed all rejections.” *Id.* at 88. In other words, § 145 “extends district-court jurisdiction to the entire decision, without differentiation among claims addressed by the decision.” Reply Brief of Plaintiff-Cross-Appellant Gilbert P. Hyatt, *Hyatt v. Stewart*, No. 18-2390, ECF No. 54 at 5.

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We reject Mr. Hyatt’s argument. Though Congress may provide a party with statutory standing, the party must nonetheless satisfy threshold Article III requirements. *Spokeo, Inc. v. Robins*, 578 U.S. 330, 339, 136 S.Ct. 1540, 194 L.Ed.2d 635 (2016) (“Injury in fact is a constitutional requirement, and [i]t is settled that Congress cannot erase Article III’s standing requirements by statutorily granting the right to sue to a plaintiff who would not otherwise have standing.” (alteration in original) (quotations omitted)). Thus, although § 145 provides an applicant with a statutory right to sue in district court when dissatisfied with a Board’s decision, § 145 does not override Article III’s threshold requirements. A patent applicant must still satisfy Article III’s requirements as to each pending claim that the applicant seeks to submit to the district court in a § 145 suit. *See id.*

In sum, because Mr. Hyatt failed to establish that he was injured by the Board’s reversal of the examiner’s rejection of certain pending claims, the district court lacked Article III jurisdiction over these claims.⁶

6. Mr. Hyatt argues on appeal that he has standing to sue as to the pending claims for which the Board reversed the examiner’s rejections. Prior Cross-Appellant Br. 88. According to Mr. Hyatt, his “injury is [the] PTO’s failure to issue them” following the Board’s reversal. *Id.* Mr. Hyatt’s alleged injury does not establish Article III standing because it rests on the false notion that the PTO must issue a patent on claims for which the Board reversed an examiner’s rejection. This is not so. When rejections are reversed, a patent may not necessarily issue at that time. Prosecution may continue until the PTO is satisfied that an “applicant is entitled to a patent under the law.” 35 U.S.C. § 151(a); *see also BlackLight Power, Inc. v. Rogan*, 295 F.3d 1269, 1273-74 (Fed. Cir. 2002).

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CONCLUSION

We have considered the parties' remaining arguments and do not find them persuasive. For the foregoing reasons, we affirm the district court's judgment for the PTO on the affirmative defense of prosecution laches. We also affirm the district court's determination that it lacked Article III jurisdiction over certain pending claims.

AFFIRMED

Costs

No costs.

Thus, the Board's reversal here did not necessarily require the PTO to issue Mr. Hyatt a patent on the pending claims at issue.

**APPENDIX B — MEMORANDUM OPINION OF
THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA, FILED MAY 16, 2024**

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Case No. 05-cv-2310-RCL
Case No. 09-cv-1864-RCL
Case No. 09-cv-1869-RCL
Case No. 09-cv-1872-RCL

GILBERT P. HYATT,

Plaintiff,

v.

KATHERINE K. VIDAL, IN HER OFFICIAL
CAPACITY AS UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,

Defendant.

Filed May 16, 2024

MEMORANDUM OPINION

When this Court held in 2017 that Plaintiff Gilbert P. Hyatt's patent applications should not be barred from issuance based on prosecution laches, it did not have

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the benefit of consulting the Federal Circuit’s landmark opinion in *Hyatt v. Hirshfeld*. That opinion clarified the law of prosecution laches, vacated this Court’s earlier holding, and remanded for further proceedings. Thus, the Court must now revisit its factual findings and legal conclusions concerning Mr. Hyatt’s applications. More precisely, it must evaluate the complete evidentiary record in light of the Federal Circuit’s binding instructions on remand and this Court’s post-remand rulings.

Mr. Hyatt has now received a full and fair opportunity to present his side of the story. Alas, the scope of remand and recent precedent commands a different result from that expounded by this Court in 2017. Today, the Court must enter judgment in favor of the Patent and Trademark Office. This memorandum opinion, which comprises the Court’s findings of fact and conclusions of law on the issue of prosecution laches, explains why that is so.¹

Mr. Hyatt is an inventor of computer technologies who filed hundreds of patent applications in the lead-up to the 1995 change in patent term. Four of those applications are now before the Court in actions filed by Mr. Hyatt under 35 U.S.C. § 145. *Hyatt v. Vidal*, No. 05-cv-2310 (RCL), Compl., ECF No. 3 (D.D.C. Nov. 18, 2005); *Hyatt v. Vidal*, No. 09-cv-1864 (RCL), Compl., ECF No. 5 (D.D.C. Sept. 25, 2009); *Hyatt v. Vidal*, No. 09-cv-1869 (RCL), Compl.,

1. The Court’s findings of fact appear in Part III of this opinion. The Court cites its factual findings using the acronym “FOF” followed by the relevant paragraph(s) (e.g., FOF ¶ 45). The Court’s conclusions of law appear in Part IV.

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ECF No. 5 (D.D.C. Sept. 25, 2009); *Hyatt v. Vidal*, No. 09-cv-1872 (RCL), Compl., ECF No. 5 (D.D.C. Sept. 25, 2009).²

In early 2017, after years of litigation, the Patent and Trademark Office (“PTO”) asserted the affirmative defense of prosecution laches. *E.g.*, 2d Am. Answer, ECF No. 123, at 1 (No. 05-cv-2310).³ Later that year, the Court held a five-day consolidated bench trial on that issue. Min. Entries (Oct. 6, 10-13, 16, 2017). At the close of the PTO’s case-in-chief, the Court granted Mr. Hyatt’s motion for judgment on partial findings under Federal Rule of Civil Procedure 52(c), finding that the PTO had failed to meet its burden of proving prosecution laches. Min. Entry (Oct. 16, 2017).⁴ The Court then issued written findings of fact and conclusions of law. *Hyatt v. Iancu (Hyatt I)*, 332 F. Supp.

2. When filed, the named defendants in these matters were Jon W. Dudas (2005 action) and David J. Kappos (2009 actions). In the intervening years since filing, a succession of defendants have automatically substituted for Mr. Dudas and Mr. Kappos under Federal Rule of Civil Procedure 25(d). Fed. R. Civ. P. 25(d). The current named defendant is Katherine K. Vidal, in her official capacity as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. FOF ¶ 2.

3. When referring to procedural events or filings that span all four Section 145 actions at issue in these consolidated proceedings, the Court will generally cite only the procedural event or filing in Case No. 05-cv-2310. When citing electronic filings, the Court refers to the ECF header page numbers, not the page numbers of the filed documents.

4. All references to “Rule 52” in this opinion are to Federal Rule of Civil Procedure 52. Fed. R. Civ. P. 52.

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3d 113 (D.D.C. 2018), *vacated in part sub nom. Hyatt v. Hirshfeld (Hyatt II)*, 998 F.3d 1347 (Fed. Cir. 2021). In 2021, the Federal Circuit partly vacated this Court's decision, finding that the PTO had carried its burden of proving prosecution laches, thereby shifting the burden to Mr. Hyatt; the Federal Circuit remanded the case so that Mr. Hyatt would have the opportunity to present evidence and rebut the PTO's showing. *Hyatt II*, 998 F.3d at 1372. The Federal Circuit retained jurisdiction over the PTO's other defenses. *Id.*

Trial on prosecution laches resumed in September 2023. Min. Entry (Sept. 18, 2023). During the 2023 phase of trial, the Court heard from several witnesses, including Mr. Hyatt, and admitted hundreds of exhibits. At the end of trial, the Court took these cases under advisement and set a briefing schedule for the parties' proposed findings of fact and conclusions of law. Min. Entry (Oct. 5, 2023); ECF No. 344 (revised briefing schedule). Pursuant to that schedule, the parties submitted proposed findings, followed by an exchange of responses and replies. Hyatt Proposal, ECF No. 345; PTO Proposal, ECF No. 346; Hyatt Resp., ECF No. 351; PTO Resp., ECF No. 352; Hyatt Reply, ECF No. 355; PTO Reply, ECF No. 354. The Court has now reviewed the parties' filings, the trial record, and the applicable law. For the following reasons, the Court finds in favor of the PTO on the issue of prosecution laches and will enter judgment on that issue for the PTO.

*Appendix B***I. PROCEDURAL HISTORY**

The complicated procedural history of these cases is already well-documented. *See Hyatt II*, 998 F.3d at 1355-59; *Hyatt I*, 332 F. Supp. 3d at 117-19; *see also Hyatt v. Vidal Hyatt III*, Nos. 09-cv-1864, 09-cv-1869, 2022 WL 17904225, at *2-3 (D.D.C. Dec. 23, 2022). Instead of recounting events that predate *Hyatt II*, the Court will detail the progress of litigation since remand.

After the Federal Circuit remanded these consolidated proceedings in mid-2021, the parties jointly proposed a schedule for resuming trial. ECF No. 283. They each then filed amended pretrial statements, ECF Nos. 286, 287, followed by responses to each other's statements, ECF Nos. 288, 290. A few months later, the PTO moved in limine to exclude evidence of unclean hands and certain witnesses that Mr. Hyatt had added to his witness list following remand. ECF No. 296. After the motion became ripe, the Court issued a memorandum opinion granting in part and denying in part the PTO's motion. *Hyatt III*, 2022 WL 17904225, at *1. Specifically, the Court barred Mr. Hyatt from introducing evidence of unclean hands but permitted him to call several additional witnesses contingent on the PTO receiving the opportunity to depose them first. *Id.* at *8, *16. Shortly after the Court issued its opinion, it scheduled a pretrial conference for September 1, 2023, with trial set to resume on September 18. ECF No. 313.

The parties submitted amended exhibit lists about two months before trial was scheduled to resume, ECF Nos. 320, 321, followed by a round of written objections,

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ECF Nos. 323, 324. Approximately one month before trial resumed, the PTO filed its final pretrial statement. ECF No. 325. A few days later, the PTO moved in limine to exclude several of Mr. Hyatt's exhibits. ECF No. 326. The Court set an expedited briefing schedule that ensured the motion would be ripe before the pretrial conference. ECF No. 327. During the conference, the Court granted the PTO's motion for the reasons stated on the record. Min. Entry (Sept. 1, 2023); ECF No. 330. The Court also chastised Mr. Hyatt for failing to file his final pretrial statement before the pretrial conference. Mr. Hyatt filed his final pretrial statement later that day. ECF No. 331. The Court issued its final pretrial order on September 13, 2023, ECF No. 334, and trial resumed on September 18, Min. Entry (Sept. 18, 2023).

The 2023 phase of trial took roughly 14 trial days and concluded on October 5, 2023. Min. Entries (Sept. 18-22, 25-29, 2023; Oct. 2-5, 2023). During this phase of trial, Mr. Hyatt presented his case-in-chief and personally testified for several days. Multiple fact witnesses also testified for Mr. Hyatt, virtually all of whom were former PTO employees. At the end of Mr. Hyatt's case-in-chief, the Court heard and denied the PTO's oral motion for judgment on partial findings under Rule 52(c). Min. Entry (Oct. 4, 2023). The PTO then presented its rebuttal case. During trial, Mr. Hyatt submitted two bench briefs. ECF No. 337. At the conclusion of trial, the Court took the PTO's prosecution laches defense under advisement and set a schedule for filing proposed findings of fact and conclusions of law, followed by responses and replies. Min. Entry (Oct. 5, 2023). The parties then filed their

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final exhibit lists. ECF Nos. 339, 340. Approximately two months later, the parties jointly moved to limit the number of pages in their post-trial briefs. ECF No. 341. The Court granted that motion, ECF No. 342, and revised the applicable filing deadlines, ECF No. 344.

Mr. Hyatt and the PTO filed their proposed findings of fact and conclusions of law on December 22, 2023. Hyatt Proposal; PTO Proposal. They filed their responses on February 23, 2024, Hyatt Resp.; PTO Resp., followed by replies on March 5, Hyatt Reply; PTO Reply.⁵ The Court, having reviewed the parties' filings along with the entire trial record, is now prepared, consistent with the scope of the remand from the Federal Circuit, to render its decision on the PTO's prosecution laches defense.

II. LEGAL PRINCIPLES

The doctrine of prosecution laches is an equitable affirmative defense to infringement or issuance of a patent that originates from two Supreme Court cases from the early 1900s. *Hyatt II*, 998 F.3d at 1360; *see Woodbridge v. United States*, 263 U.S. 50, 44 S.Ct. 45, 68 L.Ed. 159 (1923); *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463, 44 S.Ct. 342, 68 L.Ed. 792 (1924). Prosecution laches may render a patent unenforceable when an applicant's conduct "constitutes an egregious misuse of the statutory

5. Mr. Hyatt initially filed a version of his reply that exceeded the Court-ordered page limit. ECF No. 353. Mr. Hyatt filed a corrected version on March 6, 2024, which the Court considers to be his reply. Hyatt Reply. The Court will treat Mr. Hyatt's corrected reply as though it were timely filed on March 5.

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patent system under a totality of the circumstances.” *Hyatt II*, 998 F.3d at 1360 (quoting *Cancer Rsch. Tech. Ltd. v. Barr Lab’s Inc.*, 625 F.3d 724, 728 (Fed. Cir. 2010)). In the context of an action under 35 U.S.C. § 145, prosecution laches requires the PTO to prove that (1) the applicant’s delay in prosecution was unreasonable and inexcusable under the totality of the circumstances and (2) the applicant’s delay caused prejudice. *Id.* at 1361-62. When defending a Section 145 action, the PTO may establish prejudice by evidencing intervening rights, which may be presumed if the PTO shows a sufficient magnitude of applicant delay, or by proving that the applicant clearly abused the patent examination system. *Id.* at 1370.

The Federal Circuit has carefully delineated the scope of the issues before this Court on remand. *See id.* at 1371-72. This Court must apply the law as the Federal Circuit has given it. *Hyatt III*, 2022 WL 17904225, at *3-4 (discussing the mandate rule).⁶ Accordingly, the Court will reach its conclusions of law by applying the legal standard elucidated in *Hyatt II* to the facts the Court finds in Part III of this opinion. Thus, the Court will begin, as it must, by retracing the analysis and holding of *Hyatt II*, which effectively crystallized the law of prosecution laches as it applies in Section 145 actions before applying it to the specific facts of these consolidated proceedings. *See generally* 998 F.3d 1347. The Court will also briefly

6. For this reason, the Court declines to consider Mr. Hyatt’s argument that prosecution laches is inconsistent with the Patent Act, Hyatt Proposal 273-77, which this Court has already rejected in any event, Tr. Oct. 13, 2017 PM (43:17-44:14, 54:8-55:3) (Rule 52(c) Argument and Oral Ruling).

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discuss *Personalized Media Commc'ns, LLC v. Apple, Inc.*, 57 F.4th 1346 (Fed Cir. 2023), which applied *Hyatt II* to new facts and helpfully clarified certain legal principles underlying that decision, and the Court's opinion in *Hyatt III*, 2022 WL 17904225, at *1, which ruled out unclean hands as a defense to prosecution laches and clarified what constitutes relevant evidence on remand.

A. *Hyatt II*

This Court initially granted Mr. Hyatt's motion for judgment on partial findings under Rule 52(c) because it was persuaded that the PTO had not shown unreasonable and unexplained delay. *Hyatt I*, 332 F. Supp. 3d at 138. This Court limited its review of Mr. Hyatt's prosecution conduct to that occurring before 2002. *Id.* at 131. However, the Court broadly took issue with the PTO's examination of Mr. Hyatt's applications, which the Court deemed relevant under the totality of the circumstances. The Court principally focused on two issues. First, the Court took issue with a period of PTO inaction between 2003 and 2012, which the Court attributed to the PTO and found undermined its present entitlement to relief. *Id.* at 131-32. Second, the Court took issue with the PTO's failure to deploy bespoke procedures earlier to ensure timely examination of Mr. Hyatt's highly unusual patent applications. *Id.* at 133-34. The Court considered other matters as well, but the crux of its decision was that the onus was on the PTO, as a government agency, to ensure timely examination of Mr. Hyatt's applications or, in the alternative, expeditiously notify Mr. Hyatt that his prosecution conduct was outrageous and take definitive

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action against his claims and applications. *See id.* at 134-36.

Hyatt II disagreed with this Court’s reasoning, holding that it had applied the wrong legal standard and given too much weight to PTO conduct. 998 F.3d at 1363-66. “The mandate rule means a district court must do as it was told by the court of appeals.” *United States v. Little*, No. 21-cr-315 (RCL), 2024 WL 181260, at *3 (D.D.C. Jan. 17, 2024). The Federal Circuit has now provided significant clarification regarding the controlling law, much of which was lacking when the Court first considered this matter in 2017. As an outsider to the patent system, this Court continues to be troubled by the conduct of the PTO during the nearly decade-long suspension period. FOF ¶¶ 234-235. Nevertheless, *Hyatt II* tightly constrains this Court on remand, with the result that the factual focus of *Hyatt I*—and the legal conclusions that followed from that focus—is no longer tenable, no matter how concerned this Court may be with PTO inaction. The Court is not inclined to develop the law in a direction contrary to the Federal Circuit. Thus, this Court’s opinion on remand—including its findings of fact—differ dramatically from those the Court expounded in *Hyatt I*.

The Court largely sets aside matters it once considered necessary, such as PTO delay, while giving significant weight to matters it once did not focus on, such as Mr. Hyatt’s prosecution conduct after 2002. *See infra* Parts III-IV. The Court also resolves various factual disputes on which it was once noncommittal, such as alleged claim shifting, reflecting that *Hyatt II* has since

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clarified which factual disputes are important. Because *Hyatt II* constrains this Court and directs it in an entirely different direction from that adopted in *Hyatt I*, the Court will spend considerable time detailing *Hyatt II*'s specific holdings and directives on remand. The Court's explanation will hopefully make clear to the parties and the general public why its opinion here differs from *Hyatt I* in many important respects.

1. Errors Identified in *Hyatt I*

The Federal Circuit identified two errors in this Court's opinion granting Mr. Hyatt's motion for judgment on partial findings under Rule 52(c). *Hyatt I*, 332 F. Supp. 3d 113.

First, the Federal Circuit found that this Court failed to properly consider the totality of the circumstances. *Hyatt II*, 998 F.3d at 1363. This Court in *Hyatt I* primarily focused on the prosecution history of the four patent applications at issue in Mr. Hyatt's pending Section 145 actions. *See* 332 F. Supp. 3d at 122-39. It also only considered Mr. Hyatt's prosecution conduct through 2002. *Id.* at 131. From this limited view of the record, the Court concluded that Mr. Hyatt's prosecution conduct was insufficient to trigger prosecution laches. *Id.* at 138. However, the Federal Circuit determined that the Court's inquiry was too narrow. *See Hyatt II*, 998 F.3d at 1363-64. Per the Federal Circuit, "[t]he district court did not appreciate the PTO's evidence as that of a consistent pattern of conduct across an enormous body of similar applications." *Id.* at 1364. On remand, the Court

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must consider the entirety of Mr. Hyatt's prosecution conduct across all his related applications, including the prosecution period from 2002 through the present day.

Second, the Federal Circuit found that this Court placed undue emphasis on the PTO's conduct rather than Mr. Hyatt's. *Id.* at 1366. This Court in *Hyatt I* acknowledged the peculiarity of Mr. Hyatt's applications but largely focused its attention on delay attributable to the PTO, including its decision to mostly suspend examination of Mr. Hyatt's applications from 2003 to 2012 and its failure to deploy special procedures for examining Mr. Hyatt's unusual applications earlier than it did. *See* 332 F. Supp. 3d at 131-36. The Federal Circuit disagreed with this focus and clarified that the Court should have emphasized Mr. Hyatt's conduct instead. That is because "a delay by the PTO cannot excuse the appellant's own delay." *Hyatt II*, 998 F.3d at 1364 (quoting *In re Bogese*, 303 F.3d 1362, 1369 (Fed. Cir. 2002)). Indeed, "the patent statute already deals with delay by the PTO." *Id.* at 1366. Prosecution laches, in contrast, "is one example of an [applicant's] obligation to tailor prosecution conduct in pursuit of patent rights." *Id.* at 1365. Accordingly, applicants must "not only comply with the statutory requirements and PTO regulations but must also prosecute [their] applications in an equitable way that avoids unreasonable, unexplained delay that prejudices others." *Id.* at 1366 (citing *Cancer Rsch.*, 625 F.3d at 729). "The PTO's delay therefore provides a weak reason to negate prosecution laches, which asks a separate question . . . in light of the applicant's prosecution conduct." *Id.* On remand, the Court must focus on delay attributable to Mr. Hyatt; delay caused by the PTO is only weakly relevant.

*Appendix B***2. Unreasonable and Inexcusable Delay**

After identifying these errors, the Federal Circuit turned to the merits and assessed whether the factual record adduced during the PTO's case-in-chief was sufficient to show unreasonable and inexcusable delay and thereby shift the burden to Mr. Hyatt to prove that his delay was reasonable or excusable under the circumstances or to prove lack of prejudice.⁷ The Federal Circuit concluded that the PTO had made the requisite showing.

First, the Federal Circuit found that under either the PTO's or Mr. Hyatt's measure of delay, Mr. Hyatt had delayed filing his applications for a quantity of time sufficient to trigger prosecution laches. *Id.* at 1367-68. Both parties measured delay as the difference between his applications' earliest claimed priority dates and their actual filing dates. *Id.*⁸ The parties disagreed over the earliest priority dates, but the Federal Circuit nevertheless found that Mr. Hyatt had conceded at least seven years of delay. *Id.* at 1368.

Second, the Federal Circuit found that Mr. Hyatt's approach to prosecuting his applications "all but

7. The Federal Circuit also affirmed this Court's holding that the PTO may assert the defense of prosecution laches in a Section 145 action and may do so even when it had not previously issued laches rejections or warnings during prosecution of the patent application at issue. *Hyatt II*, 998 F.3d at 1362-63.

8. As detailed *infra*, FOF ¶¶ 48-50, patent applicants may claim the benefit of the filing date of an earlier application under 35 U.S.C. § 120. This is known as "priority."

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guaranteed indefinite prosecution delay.” *Id.* The Federal Circuit based this conclusion on the PTO’s evidence that Mr. Hyatt’s applications contained complex priority chains and lengthy specifications; that Mr. Hyatt repeatedly failed to identify written description support for his claims; that Mr. Hyatt routinely amended his claims in a manner that effectively restarted examination; and that this prosecution conduct created a “perfect storm” at the PTO that made it virtually impossible for the Office to perform double-patenting analysis, determine priority dates, or identify written description support. *Id.* The Federal Circuit noted other issues with Mr. Hyatt’s applications, including his attempts to reclaim counts lost in an interference proceeding and his failure to demarcate his applications per his agreement with Group Director Nicholas Godici. *Id.* at 1368-69.

Third, the Federal Circuit rejected various explanations for Mr. Hyatt’s conduct as insufficient to justify his prosecution approach, including his goal of “correctly capturing his inventions or steering clear of prior art” and that his conduct “was not literally violative of law or PTO regulation.” *Id.* at 1369.

Fourth, the Federal Circuit compared Mr. Hyatt’s conduct to that deemed unreasonable in *Bogese*, observing that “[Mr.] Hyatt’s pattern of conduct resembles, but goes well beyond, Bogese’s consistent pattern of receiving a rejection on an application, filing a continuation application without any amendments, and abandoning the original application. *Id.* (citing *Bogese*, 303 F.3d at 1364-65). The Federal Circuit noted that Mr. Hyatt’s “time-wasting

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process” affected “nearly all of his [relevant] applications.”
Id.

3. Prejudice

After concluding that the PTO had shown unreasonable and inexcusable delay and shifted the burden to Mr. Hyatt, the Federal Circuit made findings concerning prejudice.

First, the Federal Circuit concluded that although prosecution laches ordinarily requires its proponent to show intervening rights to establish prejudice—i.e., that members of the public invested in, worked on, or used the claimed technology during the period of delay—an unreasonable and unexplainable delay of six or more years suffices to raise a presumption of prejudice that includes intervening rights. *Id.* at 1370. Accordingly, the PTO’s showing that Mr. Hyatt unreasonably and inexcusably delayed filing his applications for at least seven years raised a presumption of intervening rights that Mr. Hyatt bears the burden of rebutting. *Id.*

Second, the Federal Circuit concluded that where an applicant clearly abused the patent examination system, the prejudice requirement is satisfied. *Id.* Based on the evidence adduced during the PTO’s case-in-chief, the Federal Circuit found that Mr. Hyatt had, intentionally or otherwise, engaged in a clear abuse of the PTO’s examination system that caused delay in the four applications in suit. *Id.* Accordingly, “[b]arring significant evidence to the contrary from [Mr.] Hyatt,” the PTO had demonstrated material prejudice stemming from

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Mr. Hyatt's unreasonable and inexcusable delay. *Id.* The Federal Circuit noted specific ways in which Mr. Hyatt's clearly abusive conduct had given rise to material prejudice, including because his conduct had made ordinary compact prosecution impossible; the PTO had created a specialized art unit to examine his applications; after 2013, the PTO had spent \$10 million examining Mr. Hyatt's applications whereas he had only paid \$7 million in fees; the art unit could barely reach its expected production rate because of the complex nature of Mr. Hyatt's applications; the amount of time it would take the art unit to examine Mr. Hyatt's approximately 400 applications was equivalent to the amount of time ordinarily required to examine 40,000 normal applications; Mr. Hyatt's applications had forced the PTO to issue requirements to get examination back on track; and the PTO's examiners had spent inordinate amounts of time since 2013 preparing office actions. *Id.* at 1370-71.

4. Remand

The Federal Circuit then remanded the prosecution laches issue to this Court while retaining jurisdiction over the PTO's other defenses to patentability. The Federal Circuit gave this Court specific guidance, explaining that it was remanding "to the district court for the limited purpose of affording [Mr.] Hyatt the opportunity to present evidence on the issue of prosecution laches, consistent with the standards set forth in this opinion." *Id.* at 1371. The Federal Circuit specifically limited the scope of this Court's review on remand.

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First, the Federal Circuit stated that the following explanations for Mr. Hyatt’s delay are insufficient as a matter of law to explain or excuse his conduct: he completed examination of the four applications in suit in a timely manner; his conduct prosecuting his other applications is irrelevant; he filed his applications to cover a number of inventions he believed he had made; and he met statutory requirements and followed PTO’s rules in prosecuting his applications. *Id.*

Second, the Federal Circuit clarified that Mr. Hyatt bears the burden of showing by a preponderance of the evidence that he “had a legitimate, affirmative reason for his delay” that “operate[s] to excuse [him] from responsibility for the sizable undue administrative burden that his applications have placed on the PTO[,]” which “the record before [the Federal Circuit] demonstrates to be extreme.” *Id.* at 1371-72.⁹ The Federal Circuit noted that at a minimum, Mr. Hyatt must “justify [his] decision to ignore Director Godici’s instruction to demarcate his applications in 1995,” “justify his decision to adopt the specific prosecution approach that he did—unique in its scope and nature—as detailed in the PTO’s Requirements,” and “justify his failure to develop a plan for demarcating his applications over at least the 20 year period from 1995 to 2015.” *Id.* at 1372. Per the Federal

9. This Court in *Hyatt I* applied a preponderance standard to the PTO’s affirmative defense of prosecution laches. 332 F. Supp. 3d at 131. The Federal Circuit in *Hyatt II* stated that Mr. Hyatt’s burden on remand is by a preponderance of the evidence, so the Court will presume that the same burden applies at the outset to the PTO. 998 F.3d at 1371-72.

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Circuit, “[a]ny reasons that fall short of justifying those decisions or omissions fail to negate that his delay has been unreasonable and unexplained.” *Id.* Thus, Mr. Hyatt bears the burden of making these specific showings. Not every justification or reason will suffice; Mr. Hyatt’s reasons must be persuasive enough to absolve him from responsibility for the burden he placed on the PTO. *See id.* at 1372.

Third, the Federal Circuit directed this Court to consider two points regarding prejudice. *Id.* The first was that any delay by Mr. Hyatt of more than six years shifts the burden to him of showing that he has not caused the PTO or any third-party material prejudice. *Id.* The second was that absent significant negating evidence, Mr. Hyatt’s prosecution conduct amounted to a clear abuse of the PTO’s patent examination system, which suffices to establish prejudice even in the absence of intervening rights. *Id.*

B. Other Sources of Law

In *Personalized Media*, the Federal Circuit evaluated the district court’s application of *Hyatt II* to the facts of an unrelated infringement action. *See generally Personalized Media*, 57 F.4th 1346. Besides confirming that *Hyatt II* has not been superseded by more recent decisions, *Personalized Media* confirmed two principles that are salient here. First, the fact that a patent applicant complied with the law does not obviate their obligation to prosecute their applications “in an equitable way.” *Id.* at 1354 (quoting *Hyatt II*, 998 F.3d at 1366). Accordingly, conduct that was lawful or expressly permitted by the

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PTO may nevertheless support prosecution laches. *See id.*; *see also Hyatt II*, 998 F.3d at 1369. Second, the fact that an applicant previously obtained many patents does not by itself defeat prosecution laches or outweigh other evidence of unreasonable conduct. *See Personalized Media*, 57 F.4th at 1356.

In *Hyatt III*, this Court concluded that the unclean hands doctrine is unavailable to Mr. Hyatt because the PTO is enforcing a congressional mandate in the public interest. 2022 WL 17904225, at *5-8. Accordingly, this Court barred Mr. Hyatt from introducing evidence that the PTO is “tainted with inequitableness or bad faith.” *See id.* at *5-6 (quoting *United States v. Philip Morris Inc.*, 300 F. Supp. 2d 61, 74-75 (D.D.C. 2004)). However, the Court permitted Mr. Hyatt to introduce evidence that specific witnesses were biased against him. *Id.* at *17. The Court, consistent with this ruling, will not consider implied or express allegations of bad faith on the part of the PTO, though it will entertain particularized charges of bias against testifying witnesses.

Additionally, this Court in *Hyatt III* explained that evidence of PTO conduct may be relevant for specific limited purposes. For example, to show that Mr. Hyatt was aware of PTO conduct that explains why he acted the way he did or to establish that administrative expense and burden on the PTO was due to independent choices by the PTO and not Mr. Hyatt’s conduct. *Id.* at *13. The Court will consider evidence of PTO conduct for these limited purposes, though its focus, consistent with *Hyatt II*, will be on Mr. Hyatt.

*Appendix B***C. The Court's Duty on Remand**

The Court's duty on remand is clear. The Court must find facts based on the now-complete trial record. Then, the Court must apply the legal standard articulated by the Federal Circuit in *Hyatt II*, consistent with its instructions for further proceedings on remand. In doing so, the Court must evaluate the totality of the circumstances while focusing on Mr. Hyatt's—and not the PTO's—conduct.

Because the Federal Circuit has already evaluated the evidence adduced during the PTO's case-in-chief and explained its legal importance standing alone, this Court is bound, should it find equivalent facts after reviewing the whole record, to give those facts the same legal weight the Federal Circuit did. For example, if the Court's factual findings confirm that Mr. Hyatt's applications and prosecution conduct are afflicted by the same characteristics and exemplary figures that the Federal Circuit held in *Hyatt II* would constitute a clear abuse of the patent examination system, then the Court must conclude that Mr. Hyatt clearly abused the patent examination system and materially prejudiced the PTO. The Court is duty-bound to draw the legal conclusion the Federal Circuit has already stated follows from those facts. In any event, even if the facts shake out differently on consideration of the entire record than they did based solely on the PTO's case-in-chief, Mr. Hyatt still bears burdens of persuasion prescribed by the Federal Circuit. The Court will hold Mr. Hyatt to those burdens.

*Appendix B***III. FINDINGS OF FACT**

The Court’s findings of fact, set forth below pursuant to Rule 52(a), are based on the record as a whole, including a four-week bench trial.¹⁰ The PTO presented its case-in-chief during the first phase of trial, which ran from October 6, 2017, to October 16, 2017. After the Federal Circuit vacated in part and remanded to this Court, trial resumed on September 18, 2023, and concluded on October 5, 2023. During the second phase of trial, Mr. Hyatt presented his case-in-chief, followed by the PTO’s rebuttal case. In total, across both phases of trial, the PTO presented three fact witnesses (Gregory Morse, Robert Clarke, and Vincent Turner) and one expert witness (Stephen Kunin). Mr. Hyatt presented six fact witnesses, five of whom appeared live (Gilbert Hyatt, Howard Goldberg, Edward Kazenske, Jessica Harrison,

10. The Court’s factual findings are its own. *Hyatt II* undoubtedly dictates the legal significance of certain facts once found by the Court. *See, e.g.*, 998 F.3d at 1369 (explaining that certain prosecution conduct, including “delay[ing] in presenting claims, . . . creat[ing] . . . an overwhelming, duplicative web of applications and claims, . . . and fail[ing] to cooperate with the PTO” constitutes “a clear abuse of the patent system,” which establishes prejudice). However, it does not require the Court to find facts that are no longer tenable now that the trial record is complete. *See id.* at 1371 (remanding so that Mr. Hyatt may present evidence on the issue of prosecution laches); *Hyatt III*, 2022 WL 17904225, at *13 (explaining that Mr. Hyatt is entitled to present evidence that rebuts the PTO’s case). In finding the following facts, the Court has exercised its independent judgment and reviewed all of the evidence, including Mr. Hyatt’s testimony and rebuttals of the PTO’s evidence. Mr. Hyatt, therefore, has now received a full and fair hearing on prosecution laches.

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and John LeGuyader), and one of whom appeared by deposition designation (Richard Bawcombe). Mr. Hyatt presented one expert witness (Arthur Steiner).

The Court's findings of fact are calibrated to the issues the Federal Circuit has indicated are legally relevant. The Court will not reach factual disputes that cannot move the needle or are directed to evidence the Federal Circuit or this Court have already deemed irrelevant or improper. The Court will not acknowledge literally every factual dispute identified by the parties; some are best regarded as legal arguments or are more efficiently resolved through broader findings that necessarily subsume other issues. The Court's findings reflect careful consideration of the testimony of these witnesses along with the over five hundred documentary exhibits submitted by the parties.¹¹

A. Parties

1. Plaintiff Gilbert P. Hyatt is a prolific inventor who has received more than seventy issued patents. He is the applicant of and named inventor on four patent applications that are the subject of the present matter. In each action, filed under 35 U.S.C. § 145, Mr. Hyatt asks the Court to review the PTO's final decision denying him a patent.
2. Katherine K. Vidal is the named defendant in these matters in her official capacity as the Under

11. Any finding of fact more appropriately characterized as a conclusion of law is adopted as such, and any conclusion of law more properly characterized as a finding of fact is adopted as such.

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Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. The PTO is the federal agency responsible for examining patent applications and for granting U.S. patents.

B. Background

3. Each of the applications at issue in these cases was filed before June 8, 1995, the effective date of the law that changed the term of a patent from 17 years from issuance to 20 years from the effective filing date.¹² This change in the U.S. patent term was part of the implementation of the Uruguay Round Agreements Act of the General Agreement on Tariff and Trade (“GATT”). Tr. Oct. 6, 2017 PM (43:8-44:3) (Clarke); Tr. Oct. 10, 2017 PM (20:8-14) (Morse).
4. To address circumstances where an applicant had the right under U.S. patent law to file a new patent application to pursue claims that the applicant had disclosed in an earlier-filed application (known as a “continuing application”), *see generally* FOF ¶¶ 59-63, Congress required the PTO to promulgate rules to provide applicants further examination, without loss of patent term, of additional patent claims that claim priority to pre-GATT applications. Uruguay Round Agreements Act (“URAA”), Pub. L. No. 103-

12. *See supra* note 8.

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465, § 532(a)(1), 108 Stat. 4809 (1994) (codified as amended at 35 U.S.C. § 154). The PTO's rule implementing this legislation is 37 C.F.R. § 1.129 ("Rule 129"), which was promulgated on April 25, 1995. *See* Changes to Implement 20-Year Patent Term and Provisional Applications ("Final Rule"), 60 Fed. Reg. 20195, 20226-27 (Apr. 25, 1995); *see also* Tr. Oct. 6, 2017 PM (45:18-47:11) (Clarke).

5. To preserve the opportunity to obtain a 17-year pre-GATT patent term, many applicants filed patent applications between April 25, 1995, when the PTO promulgated Rule 129, and June 8, 1995, when the new patent term law went into effect. Applicants filed approximately 52,000 applications during this period. Tr. Sept. 27, 2023 (1240:11-13) (Goldberg). This surge in applications is known as the "GATT Bubble." Tr. Oct. 6, 2017 PM (104:17-22) (Clarke).
6. Mr. Hyatt filed approximately 400 GATT Bubble applications. These applications, including the four pending before the Court, are continuing applications that claim the benefit of—priority to—the filing dates of many earlier filed applications, some of which date to the late 1960s and early 1970s. If Mr. Hyatt were to receive a patent on these applications, he would be entitled to a pre-GATT patent term that starts from the date of issuance, not the effective filing date.

*Appendix B***C. Pre-GATT Bubble Applications****1. Early Warnings**

7. In the late 1960s, Mr. Hyatt began filing patent applications with the PTO. PTX-569.00002. Mr. Hyatt became a registered patent agent in 1975. Tr. Sept. 25, 2023 (856:17-20) (Hyatt). Mr. Hyatt testified that he was familiar with patent prosecution practices from the 1970s through the 1990s, and that he followed the Manual of Patent Examining Procedure (“MPEP”) closely. Tr. Sept. 18, 2023 PM (131:17-23) (Hyatt). However, PTO personnel told Mr. Hyatt on several occasions that his prosecution conduct did not conform to PTO norms.
8. On May 11, 1973, in Application No. 05/135,040 (#104),¹³ the examiner rejected Mr. Hyatt’s pending claims for double patenting, warning him that he “may not claim the same thing in two different applications.” DX2220-000005-06.

13. When referring to Mr. Hyatt’s applications, the Court will provide the serial number assigned to the application by the PTO, followed by Mr. Hyatt’s docket number (e.g., Application No. 05/135,040 (#104)). The serial number is denoted by “Application No.” followed by a specially formatted eight-digit number (e.g., Application No. 05/135,040). Mr. Hyatt’s docket number is denoted by the hashtag symbol followed by a three-digit number (e.g., #104). The Court will occasionally refer to Mr. Hyatt’s applications using only his docket numbers (e.g., the Court will refer to “the #104 application”). The Court will do so only when it is exceedingly clear from context which application the Court is referring to.

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9. On August 1, 1975, in Application No. 05/101,881 (#101), Mr. Hyatt received an office action in which the examiner claimed that he “continually added claims in response to any Office Action. Applicant has thus continually increased the burden upon the Office and particularly upon the Examiner.” DX2226-000002. The examiner noted that “[t]hese added claims have been continually directed to new, diverse and different inventions than were presented previously,” and that “[t]he sheer bulk of the application and the complexity and number of issues, the number of outstanding claims, the number of independent claims, etc.[,] all contribute to the mushrooming complexity of examining this application to the extent that a proper and complete examination [sic] of all c[l]aims approaches unmanageability.” DX2226-000002. The examiner issued written description rejections and noted that “[t]he specification is in a confused state in view of the prolixity of new matter added to this application.” DX2226-000013. The examiner further observed that Mr. Hyatt’s application imposed a “tremendous” burden on the PTO’s ability to determine double patenting. DX2226-000017.

10. On November 16, 1978, in Application No. 05/860,257 (#157), Mr. Hyatt “was informed that claims of the instant application cross-read on claims of related applications and that the claims of the instant application are directed to multiple inventions.” DX11-000001. Recognizing “the

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burden on the PTO for examination of the instant application,” Mr. Hyatt sought “an opportunity to amend the claims . . . to correct any cross reading and any multiple inventions before examination.” DX11-000001.

11. On June 15, 1989, in Application No. 06/849,243 (#310), Mr. Hyatt was informed that his application’s “disclosure[,] which encompasses 449 pages of text, w[h]ere 34 documents whose disclosures are incorporated by reference, and an untold number of cross references to related applications and other documents, creates an unreasonable and largely unnecessary burden on anyone attempting to understand applicant’s invention.” DX2132-000008.

2. Successful Patent Prosecution

12. Despite these issues, between 1971 and 1997, Mr. Hyatt successfully prosecuted 75 patent applications to issuance as patents. *See* PTX-569.00002-03. In some instances, prosecution concluded after only a few years. For example, Mr. Hyatt obtained a patent on Application No. 06/160,871 (#168) on April 24, 1984, less than four years after he filed the application on June 19, 1980. PTX-2008.0001. He obtained a patent on Application No. 06/160,872 (#169) on January 1, 1985, less than five years after he filed the application on June 19, 1980. PTX-2010.0001. He obtained a patent on Application No. 06/425,731

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(#191) on April 8, 1986, less than four years after he filed the application on September 28, 1982. PTX-2011.0001. And he obtained a patent on Application No. 07/343,112 (#325) on January 23, 1990, less than a year after he filed the application on April 24, 1989. PTX-2020.0001.

3. Serial Prosecution Norms

13. Mr. Hyatt filed continuing, or “child,” applications in his prosecutions to pursue subject matter disclosed in the “parent” or “ancestor” applications by establishing a “chain of continuity” with the ancestor applications. *E.g.*, Tr. Sept. 18, 2023 PM (99:19-22) (Hyatt). Mr. Hyatt testified that filing continuing applications was a “common practice among patent applicants at the time.” Tr. Sept. 19, 2023 AM (174:10-13) (Hyatt).
14. Mr. Hyatt testified that PTO was reluctant to examine continuing applications in parallel with their ancestor applications before 1995. Tr. Sept. 26, 2023 (1062:25-1064:17) (Hyatt). He testified that for this reason, he chose to prosecute his continuing applications serially—one after the other—often waiting to file child applications until after allowance or abandonment of the parent application. Tr. Sept. 29, 2023 (1587:14-21) (Hyatt). Mr. Hyatt intended to maintain his serial prosecution practice until the GATT transition forced him to file his applications in parallel or risk losing the benefit of earlier priority dates. *See* Tr.

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Sept. 18, 2023 PM (124:19-21) (Hyatt). This means that had the GATT transition not occurred, Mr. Hyatt would have continued to file his applications serially for decades, if not centuries. *See* Tr. Sept. 19, 2023 AM (187:25-188:12) (Hyatt). For example, Mr. Hyatt counted at least 100 inventions in the 700 Family specification. DX233-000008; Tr. Sept. 18, 2023 AM (58:19-59:3) (Hyatt). Assuming Mr. Hyatt pursued one application per invention and took two years to prosecute each application, then following a serial prosecution approach, it would have taken Mr. Hyatt approximately 200 years to prosecute each invention disclosed in the 700 Family specification.¹⁴

15. Mr. Hyatt testified that a March 16, 1992 decision by the Board of Patent Appeals and Interferences (the “Board”)¹⁵ reversing a prosecution laches rejection in Application No. 07/128,659 (#315) persuaded him that his serial prosecution approach was reasonable. PTX-1717.0009. In that decision, the Board explained that “35 U.S.C. 120 does not place a time limit on filing the continuing application; rather, all that is required in this regard to preserve an earlier effective filing

14. This estimate is conservative given the multi-year timeline typical of Mr. Hyatt’s successful patent prosecutions. *See* DX268-000001-03; *see also* FOF ¶ 12.

15. The Board of Patent Appeals and Interferences is now known as the Patent and Trial Appeal Board. “Generally speaking, they are the same body.” Tr. Oct. 6, 2017 PM (56:15-56:23) (Clarke).

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date as to common subject matter is copendency or a continuous chain of copendency.” PTX-1717.0008. Mr. Hyatt testified that this decision “reinforced [his] previous perception that [he] was prosecuting [his] applications correctly.” Tr. Sept. 18, 2023 PM (138:6-21) (Hyatt). That perception included the propriety of prosecuting continuing applications serially.

16. However, in a Reply Brief filed on September 15, 2020, appealing a prosecution laches rejection in Application No. 08/455,320 (#380), Mr. Hyatt represented to the Board that he “pursued many applications in parallel, rather than ‘waiting’ to file claims, both before and during the ‘GATT bubble.’” PTX-836.51. Mr. Hyatt relied on his record of parallel prosecution to distinguish his applications from the prosecution conduct deemed unreasonable by the Federal Circuit in *Bogese*. PTX-836.51. He further argued that “the pendency of parallel filings rebuts the accusation of delay.” PTX-836.52. These prior representations are inconsistent with Mr. Hyatt’s trial testimony that he could not prosecute his ancestor applications in parallel or that doing so would have been futile. *See* Tr. Sept. 29, 2023 (1587:6-13) (Hyatt).
17. In fact, Mr. Hyatt often prosecuted his ancestor applications in parallel. *See, e.g.*, PTX-1830.0002 (graphically illustrating parallel prosecution of ancestor applications); PTX-1831.0002 (same);

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PTX-1832.0002 (same); PTX-1835.0002 (same);
PTX-1837.0002 (same); PTX-1839.0002 (same).

4. Restrictions

18. When a patent applicant presents more than one independent or distinct invention in a patent application, the PTO may require the applicant to restrict the application to a single invention. MPEP § 803 (6th ed., Jan. 1995).¹⁶ The office action containing such a requirement is referred to as a “restriction.” MPEP § 802.02. “[F]iling a divisional application in response to a restriction requirement, even if the filing occurs immediately before issuance of the parent application” can constitute reasonable delay. *Hyatt II*, 998 F.3d at 1361-62. During trial, Mr. Hyatt testified that his GATT Bubble applications were divisional applications filed in response to restriction requirements in his ancestor applications. *E.g.*, Tr. Sept. 18, 2023 PM (124:14-24) (Hyatt); Tr. Sept. 19, 2023 AM (172:8-174:5) (Hyatt).

i. Finality

19. Mr. Hyatt testified that he needed to wait for pre-GATT restrictions in his ancestor applications to become final before he could file continuing

16. All MPEP citations in this opinion are to the Sixth Edition, published January 1995. https://www.uspto.gov/web/offices/pac/mpep/old/mpep_E6R0.htm [<https://perma.cc/NJ7X-3C36>]. The Court will elsewhere omit this parenthetical information.

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applications claiming restricted inventions. *E.g.*, Tr. Sept. 18, 2023 PM (123:18-124:18) (Hyatt). According to Mr. Hyatt, “[o]nly a few, very few of the restriction requirements pre-1995 were made final,” and “without the restriction requirement being made final, everything is on hold relative to the prosecution of that application.” Tr. Sept. 18, 2023 PM (129:7-15) (Hyatt). The non-finality of restrictions in Mr. Hyatt’s ancestor applications through 1995 purportedly explains why he waited until shortly before the GATT transition to file his continuing applications. However, Mr. Hyatt also testified that a restriction not being “made final does not prevent [an applicant] from filing a divisional application.” Tr. Sept. 18, 2023 PM (130:12-14) (Hyatt).

20. There were 63 restrictions in Mr. Hyatt’s ancestor applications before the GATT transition on June 8, 1995. PTX-895. Of the 63, all but one became final well before Mr. Hyatt filed his GATT Bubble applications. That is so because: (1) the applications in which the restrictions appeared were no longer pending because examiners allowed the applications; (2) the applications in which the restrictions appeared were no longer pending because Mr. Hyatt abandoned the applications; (3) Mr. Hyatt did not challenge the restrictions; and (4) the examiners had made the restrictions final.

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21. Petitions challenging a restriction must be filed while an application is pending. MPEP § 818.03(c) (citing 37 C.F.R. § 1.144). Thirty-two (32) out of 63 of Mr. Hyatt's pre-GATT restrictions were no longer petitionable because the corresponding ancestor application issued as a patent, and thus was no longer pending. Those restrictions are described below:
 - a. A restriction mailed on July 17, 1972, in Application No. 05/152,105 (#105). PTX-895. The application issued as U.S. Patent No. 3,738,242 on June 12, 1973. DX268-000001.
 - b. A restriction mailed on November 17, 1972, in Application No. 05/229,213 (#106). PTX-895. The application issued as U.S. Patent No. 3,820,894 on June 28, 1974. DX2112-000001.
 - c. Restrictions mailed on January 27, 1976, May 28, 1976, January 24, 1977, April 9, 1979, and January 7, 1983, in Application No. 05/230,872 (#107). PTX-895. The application issued as U.S. Patent No. 4,531,182 on July 23, 1985. DX268-0000001.
 - d. Restrictions mailed on March 28, 1979, and July 3, 1979, in Application No. 05/232,459 (#108). PTX-895. The application issued as U.S. Patent No. 4,370,720 on January 25, 1983. DX268-000001.

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- e. A restriction mailed on March 27, 1975, in Application No. 05/288,247 (#110). PTX-895. The application issued as U.S. Patent No. 4,121,284 on October 17, 1978. DX268-000001.
- f. Restrictions mailed on April 25, 1977, July 30, 1979, and December 27, 1982, in Application No. 05/291,394 (#111). PTX-895. The application issued as U.S. Patent No. 4,396,976 on August 2, 1983. DX268-000001.
- g. A restriction mailed on April 11, 1975, in Application No. 05/325,941 (#114). PTX-895. The application issued as U.S. Patent No. 4,060,848 on November 29, 1977. DX268-000001.
- h. Restrictions mailed on September 19, 1974, and February 14, 1975, in Application No. 05/366,714 (#118). PTX-895. The application issued as U.S. Patent No. 3,986,022 on October 12, 1976. DX268-000001.
- i. Restrictions mailed on July 14, 1975, and January 4, 1979, in Application No. 05/476,743 (#125). PTX-895. The application issued as U.S. Patent No. 4,364,110 on December 14, 1982. DX268-000001.
- j. Restrictions mailed on December 27, 1977, and June 26, 1979, in Application No. 05/522,559 (#127). PTX-895. The application issued as

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U.S. Patent No. 4,209,852 on June 24, 1980.
DX268-000001.

- k. Restrictions mailed on September 9, 1976, and December 9, 1976, in Application No. 05/550,231 (#128). PTX-895. The application issued as U.S. Patent No. 4,209,843 on June 24, 1980. DX268-000001.
- l. A restriction mailed on August 17, 1977, in Application No. 05/754,660 (#135). PTX-895. The application issued as U.S. Patent No. 4,486,850 on December 4, 1984. DX268-000001.
- m. Restrictions mailed on November 29, 1979, and February 19, 1980, in Application No. 05/860,256 (#153). PTX-895. The application issued as U.S. Patent No. 4,829,419 on May 9, 1989. DX268-000001.
- n. A restriction mailed on April 21, 1981, in Application No. 05/860,257 (#157). PTX-895. The application issued as U.S. Patent No. 4,371,923 on February 1, 1983. DX268-000001.
- o. A restriction mailed on September 9, 1985, in Application No. 05/950,901 (#164). PTX-895. The application issued as U.S. Patent No. 4,225,225 on September 30, 1980. DX268-000002.

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- p. Restrictions mailed on October 20, 1981, and June 2, 1982, in Application No. 06/160,872 (#169). PTX-895. The application issued as U.S. Patent No. 4,491,930 on January 1, 1985. DX268-000002.
 - q. A restriction mailed on December 5, 1986, in Application No. 06/676,769 (#304). PTX-895. The application issued as U.S. Patent No. 4,744,042 on May 10, 1988. DX268-000002.
 - r. Restrictions mailed on July 1, 1991, and November 22, 1991, in Application No. 07/495,808 (#330). PTX-895. The application issued as U.S. Patent No. 5,339,275 on August 16, 1994. DX268-000002.
22. Seven (7) out of 63 of Mr. Hyatt's pre-GATT restrictions were no longer petitionable because Mr. Hyatt had abandoned the corresponding ancestor application. Those restrictions are described below:
- a. Restrictions mailed on April 8, 1975, and August 1, 1975, in Application No. 05/101,881 (#101). PTX-895. Proceedings terminated in the application no later than February 4, 1981. PTX-1835.0002-03; *see also* PTX-932.14222-29 (United States Court of Customs and Patent Appeals decision affirming the examiner's rejection of the #101 application).

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- b. A restriction mailed on December 16, 1974, in Application No. 05/495,349 (#126). PTX-895. Mr. Hyatt abandoned the application when he failed to seek judicial review of the Board's April 30, 1986 decision on Mr. Hyatt's request for reconsideration. DX2128-000001-04.
- c. A restriction mailed on August 28, 1980, in Application No. 05/860,260 (#152). PTX-895. Mr. Hyatt expressly abandoned the application on April 20, 1987. DX2130.
- d. A restriction mailed on April 13, 1981, in Application No. 05/860,254 (#151). PTX-895. Mr. Hyatt abandoned the application when he failed to seek judicial review of the Board's July 28, 1983 decision affirming the examiner's rejection. DX2129-000001-06.
- e. A restriction mailed on January 31, 1985, in Application No. 06/223,959 (#175). PTX-895. Mr. Hyatt expressly abandoned the application on June 12, 1989. DX2131.
- f. A restriction mailed on July 14, 1986, in Application No. 06/661,649 (#301). PTX-895. Mr. Hyatt abandoned the application on March 14, 1989, when he failed to pay the issue fee after receiving a notice of allowance. DX2218.

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23. Eight (8) out of 63 of Mr. Hyatt's pre-GATT restrictions became final when he elected to prosecute one claimed invention "without traverse," meaning he acquiesced in the restriction and forfeited his right to petition the requirement. Tr. Sept. 27, 2023 (1247:15-19) (Goldberg). Those restrictions are described below:
- a. A restriction mailed on July 20, 1978, in Application No. 05/849,812 (#145). PTX-895. Mr. Hyatt elected "without traverse" on August 15, 1978. DX2221-000001.
 - b. A restriction mailed on May 19, 1986, in Application No. 06/662,211 (#302). PTX-895. Mr. Hyatt elected "without traverse" on July 23, 1986. PTX-945.165.
 - c. A restriction mailed on January 8, 1987, in Application No. 06/663,094 (#303). PTX-2255.0004. Mr. Hyatt elected "without traverse" on February 5, 1987. PTX-2255.0004.
 - d. A restriction mailed on December 18, 1989, in Application No. 07/059,286 (#313). PTX-895. Mr. Hyatt's April 23, 1990 response did "not traverse [the] restriction and constructive election." DX2135.000008.
 - e. A restriction mailed on September 27, 1990, in Application No. 07/279,592 (#319). PTX-

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895. Mr. Hyatt elected “without traverse” on November 29, 1990. PTX-1162.0175.
- f. A restriction mailed on September 27, 1990, in Application No. 07/289,355 (#321). PTX-895. Mr. Hyatt elected “without traverse” on March 22, 1991. PTX-1046.18262.
 - g. A restriction mailed on May 18, 1990, in Application No. 07/357,570 (#324). PTX-895. Mr. Hyatt elected “without traverse” on June 19, 1990. PTX-932.13665.
 - h. A restriction mailed on October 23, 1990, in Application No. 07/506,642 (#332). PTX-895. Mr. Hyatt elected “without traverse” on November 26, 1990. DX2134.
24. Two (2) out of 63 of Mr. Hyatt’s pre-GATT restrictions became final when he failed to traverse the restriction, effectively acquiescing in it and forfeiting his right to petition that requirement. MPEP § 818.03(c). Those restrictions are described below:
- a. A restriction mailed on September 13, 1988, in Application No. 05/849,812 (#145). PTX-895. Mr. Hyatt’s July 9, 1991 response did not traverse the restriction. DX2222. Instead, Mr. Hyatt canceled certain claims as “being directed to a non-elected invention” without traversing the restriction. DX2222-000002.

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- b. A restriction mailed on February 22, 1988, in Application No. 06/662,211 (#302). PTX-895. Mr. Hyatt's June 24, 1988 response did not traverse the restriction. PTX-945.69-76. Instead, it "affirm[ed]" his election without traversing. PTX-945.70.
25. Thirteen (13) out of 63 of Mr. Hyatt's pre-GATT restrictions were made final by the examiner. Those restrictions are described below:
- a. Mr. Hyatt identified restrictions dated December 5, 1972, and May 11, 1973, in Application No. 05/135,040 (#104). PTX-895. The May 11, 1973 restriction repeats the December 5, 1972 restriction and makes it "Final." DX2220-000003.
 - b. Mr. Hyatt identified restrictions dated August 23, 1973, January 11, 1974, March 14, 1974, and September 13, 1974, in Application No. 05/302,771 (#112). The January 11, 1974 restriction repeats the August 23, 1973 restriction and makes it "final." DX2207-000002. The September 13, 1974 restriction repeats the March 14, 1974 restriction and makes it "Final." DX2205-000002.
 - c. Mr. Hyatt identified a restriction dated April 21, 1988, in Application No. 07/059,286 (#313). In an advisory action dated June 27, 1988, the examiner stated that the restriction would "not be withdrawn." DX2136-000002.

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- d. Mr. Hyatt identified a restriction dated March 1, 1989, in Application No. 06/849,243 (#310). In an office action dated June 22, 1989, the examiner stated that Mr. Hyatt's arguments directed to the restriction were "not deemed to be persuasive." DX2132-000002. In his response dated November 15, 1989, Mr. Hyatt did not further dispute or attempt to traverse the March 1, 1989 restriction. PTX-937.228-47.
- e. Mr. Hyatt identified a restriction dated July 29, 1991, in Application No. 07/419,911 (#326). In an office action dated April 3, 1992, the examiner stated that the restriction was "deemed proper" and "therefore made FINAL." DX2133-000003.
- f. Mr. Hyatt identified restrictions dated July 23, 1992, and July 19, 1993, in Application No. 07/774,159 (#344). In an office action dated November 24, 1992, the examiner stated that the July 23, 1992 restriction was "deemed proper" and "therefore made FINAL." DX2215-000002. In an office action dated May 12, 1994, the examiner stated that the July 19, 1993 restriction was "deemed proper" and "therefore made FINAL." DX2214-000002.
- g. Mr. Hyatt identified a restriction dated August 17, 1992, in Application No. 07/357,570 (#324). In an office action dated January 11, 1993, the examiner stated that the restriction

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was “deemed proper” and “therefore made FINAL.” DX2210-000035.

- h. Mr. Hyatt identified a restriction dated August 5, 1993, in Application No. 08/034,627 (#349). In an office action dated November 29, 1994, the examiner made the restriction “FINAL.” PTX-943.210.
- 26. The sole remaining pre-GATT restriction was issued on April 8, 1991, in Application No. 06/848,017 (#307). PTX-895. None of Mr. Hyatt’s GATT Bubble applications are children of this application. DX231.
- 27. Accordingly, Mr. Hyatt did not need to wait for pre-GATT restrictions in his ancestor applications to become final before filing his continuing applications. The written record contradicts Mr. Hyatt’s testimony that the non-finality of restrictions in his ancestor applications caused him to delay filing his continuing applications until shortly before the GATT transition.
- 28. Thirty-two (32) out of 63 restrictions date to the 1970s. PTX-895. Twenty-two (22) out of 63 date to the 1980s. PTX-895. Even if Mr. Hyatt were correct that these restrictions were non-final as of the GATT transition, that means Mr. Hyatt passively waited for approximately 6 to 23 years for the PTO to make these restrictions final, rather than actively seeking their finalization.

*Appendix B***ii. Number of Non-Elected Species**

29. Mr. Hyatt testified that the impending GATT transition caused him to file divisional applications to protect restricted species (i.e., independent inventions) in his ancestor applications. FOF ¶ 18.

30. The total number of species in the 63 pre-GATT restrictions issued in Mr. Hyatt's ancestor applications is 206. PTX-895; *see also* Tr. Sept. 18, 2023 PM (122:22-123:2) (Hyatt). However, the total number of *non-elected* species in the 63 pre-GATT restrictions is lower. The number of non-elected species is lower than the total number of species because the PTO requires applicants to respond to restriction requirements by making a "provisional election of one invention for prosecution." 37 C.F.R. § 1.143; *see also* MPEP § 818.03(b). Accordingly, to determine the total number of non-elected species, the total number of restricted species (206) must be reduced by the number of species that Mr. Hyatt elected in his ancestor applications (49).¹⁷ This gives a total of 157 non-elected species.

17. The number of elected species is less than the total number of pre-GATT restrictions (63) because 14 of these restrictions simply repeated prior restrictions and made them final. *E.g.*, DX2220-000003. Accordingly, there were no species in these 14 restrictions for Mr. Hyatt to elect. Mr. Hyatt only made elections in the 49 pre-GATT restrictions with listed species.

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31. The total number of non-elected species in Mr. Hyatt's ancestor applications (157) is less than half of the approximately 400 GATT Bubble applications that Mr. Hyatt filed.
32. For example, the total number of non-elected species in the applications that Mr. Hyatt claims are ancestors to the 700 family is 6. PTX-1838.0002 (showing claimed ancestors); PTX-895 (showing number of restricted species). The 700 Family includes 100 applications. Tr. Sept. 18, 2023 PM (96:22-97:2) (Hyatt); *see also* PTX-271.00001 (grouping application families by docket number).
33. As a further example, the total number of non-elected species in the application that Mr. Hyatt claims is the ancestor to the 600 family is three. PTX-1836.0002; PTX-895. The 600 Family includes 29 applications. PTX-271.00001.
34. Thus, Mr. Hyatt did not file a number of GATT Bubble applications commensurate with the number of restricted species in his ancestor applications.
35. Mr. Hyatt's testimony that he filed his GATT Bubble applications in response to restrictions in his ancestor applications is inconsistent with prior representations to this Court. Mr. Hyatt previously represented that he "filed about 100 patent applications [in the 700 Family] in 1995

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because an initial count of inventions contained in the [700 Family] specification exceeded 100 inventions.” DX233-000008. Mr. Hyatt further stated that he “made sure . . . to file enough applications to address the quantity of inventions described in [his] large and diverse disclosures.” DX233-000008. In his 2017 opening statement, counsel for Mr. Hyatt stated that Mr. Hyatt “went and he counted what he believed to be the inventive features in those applications. That count led to 400 patent applications. So he submitted 400 patent applications.” Tr. Oct. 6, 2017 AM (59:17-20) (Plaintiff’s Opening Statement). Mr. Hyatt has made similar representations to the PTO. PTX-828.14081-82; *see also* PTX-2250.4297. In other words, Mr. Hyatt has historically tied his decision to file GATT Bubble applications in the manner that he did to the number of inventions he counted in his disclosures, not the existence of restricted species in his ancestor applications.

36. Mr. Hyatt’s testimony that he filed his GATT Bubble applications in response to restrictions in his ancestor applications is inconsistent with his other trial testimony. Mr. Hyatt testified that to protect each invention “in [his] 11 [application] families, [he] filed numerous applications that were copies of the ancestor application.” Tr. Sept. 18, 2023 AM (58:19-23) (Hyatt). He further testified that because the 700 Family’s specification disclosed “at least 100 inventions,” he “filed 100 copies of the ancestor application,

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so that [he] could focus each one of them on a different one of the inventions” he had disclosed. Tr. Sept. 18, 2023 AM (58:24-59:3) (Hyatt). In other words, during trial, Mr. Hyatt tied his decision to file GATT Bubble applications in the manner that he did to the number of inventions he counted in his disclosures.

37. During trial, Mr. Hyatt attempted to reconcile his earlier contention that he filed a certain number of GATT Bubble applications based on the number of inventions he believed he had disclosed with his more recent contention that he filed divisional applications to protect restricted species. He testified that he filed more GATT Bubble applications than he had restricted species because the restricted species in his ancestor applications were broad, and he expected to narrow them in his continuing applications by adding many narrower claims to cover the same inventions. Tr. 10/2/23 PM (1780:21-1781:9) (Hyatt). The Court finds this explanation unpersuasive and not credible. If Mr. Hyatt’s applications had been directed to broad restricted species, such that he needed to add many narrower claims, he could have done so by adding narrower claims to a single application drawn to that species rather than filing additional applications. Mr. Hyatt did not explain why adding more claims required additional applications rather than additional claims per application.

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38. The only explanation the Court can divine is that Mr. Hyatt believed he would need additional applications pursuing narrower claim sets to avoid the PTO issuing post-GATT restriction requirements. *See* Tr. Oct. 2, 2023 PM (1781:3-16) (Hyatt). To that point, Mr. Hyatt suggested that he should have filed *more* transitional applications than he did because the PTO ultimately issued a substantial number of post-GATT restriction requirements. *See* Tr. Oct. 2, 2023 PM (1781:10-16) (Hyatt). But this explanation—that he filed more GATT Bubble applications than there were non-elected species in anticipation of future restrictions—is inconsistent with his testimony that he filed a certain number of applications based on the number of inventions he believed he had disclosed. It is inconsistent with Mr. Hyatt’s concession that he filed his GATT Bubble applications to protect both restricted species and unclaimed—i.e., never before presented and, therefore, never before broadly restricted—inventions. Hyatt Resp. 32 (citing Tr. Sept. 18, 2023 PM (124:21-24, 140:1-9) (Hyatt) and Tr. Sept. 19, 2023 AM (172:8-174:5) (Hyatt)). And it is inconsistent with Mr. Hyatt’s testimony that he believed Rule 129 authorized him to claim more than one invention in a GATT Bubble application, which indicates Mr. Hyatt believed post-GATT restriction requirements would not be a problem so long as he paid the requisite fees. *See* Tr. Oct. 2, 2023 AM (1740:10-23) (Hyatt). Mr. Hyatt is not credible on this point.

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39. Mr. Hyatt's shifting explanations and representations to this Court on this point are incapable of neat resolution except by recourse to his originally proffered explanation that he filed a certain number of GATT Bubble applications based on the number of inventions he believed he had disclosed. The discrepancy between the total number of GATT Bubble applications (approximately 400) and the total number of non-elected species in Mr. Hyatt's ancestor applications (157) fatally undermines Mr. Hyatt's more recent contention that he filed divisional applications to protect restricted species. The Court concludes that Mr. Hyatt filed his GATT Bubble applications to protect the inventions he believed he had disclosed, regardless of whether they were previously restricted.

5. #303 Application

40. Mr. Hyatt abandoned Application No. 06/663,094 (#303) rather than pay the issue fee and receive a patent on allowed claims. On October 6, 1988, the PTO informed Mr. Hyatt that claims 1-10 (as renumbered) in the application were allowable. DX260-000001. If Mr. Hyatt had paid the \$280 issue fee, the PTO would have issued him a patent on those claims. DX260-000001. Instead, Mr. Hyatt abandoned the application in favor of a continuation-in-part application, Application No. 07/289,355 (#321). PTX-060.00003. That continuation-in-part application became the parent of Mr. Hyatt's 700 Family of applications.

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41. Mr. Hyatt testified at trial that he abandoned the #303 application and filed a continuation-in-part to obtain consideration of new prior-art references that called into question the patentability of claims the examiner had allowed in the #303 application. Tr. Sept. 22, 2023 (711:20-712:18) (Hyatt). The Court does not credit Mr. Hyatt’s testimony that he abandoned the #303 application to ensure he obtained a valid patent rather than to delay issuance and pursue other unrelated claims.

42. Mr. Hyatt did not use the #321 application to submit the allowed claims to the examiner for consideration. Instead, he filed “*nearly identical*” claims. DX233-000012 (emphasis in original). Although similar, these claims are not the same as the claims allowed in the #303 application. DX233-000068. Additionally, Mr. Hyatt introduced several claims drawn to new subject matter. *See* PTX-1046.18315 (showing 57 total claims). This caused the examiner to issue a restriction requirement in the #321 application. PTX-1046.18278. In response, Mr. Hyatt elected a group of claims that did not include any of the “nearly identical” claims from the #303 application. *Compare* DX1640-000001 (electing “without traverse . . . the group II invention including claims 11-21”) *with* DX233-000069-71 (representing that claims 23 and 31-38 of the #321 application correspond to the #303 application allowed claims). Put differently, Mr.

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Hyatt did not elect any of the claims previously allowed in the #303 application for examination in the #321 application. Mr. Hyatt's testimony that he abandoned the #303 application to obtain review of the allowed claims in light of new prior-art references is inconsistent with his decision not to elect any of those claims (more precisely, the "nearly identical" claims filed in the #321 application) for examination.

43. Further, if Mr. Hyatt wanted his allowed claims examined in light of new prior art references, he could have filed a file wrapper continuation ("FWC") under 37 C.F.R. § 1.62. MPEP § 201.06(b). The FWC rule provided a streamlined process for reconsidering the patentability of allowed claims in view of new prior art. *See* MPEP § 609B(3); *see also* DX233-000011-12. Filing a FWC containing the allowed claims from the #303 application would not have prevented Mr. Hyatt from also filing a continuation-in-part application directed to new subject matter. Mr. Hyatt used the FWC rule in other applications, but not here. PTX-1833.0002-03; PTX-1834.0002-03.
44. Mr. Hyatt attempted to reinsert his previously allowed claims in a different application nearly ten years after he prevented them from issuing. Tr. Oct. 10, 2017 PM (9:21-12:4) (Morse); Tr. Oct. 12, 2017 PM (38:24-41:18) (Kunin). Specifically, more than ten years after abandoning the #303

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application, Mr. Hyatt filed claims in another application, Application No. 08/458,004 (#713), that were substantially similar to the allowed claims in the #303 application. DX131-000039-40 (explaining substantial subject matter correspondence between allowed claims in the #303 application and claims in the #713 application); PTX-5007, Slide 30 (showing claims side-by-side). The claims in the #303 application were originally allowed on October 6, 1988; Mr. Hyatt effectively refiled them in the #713 application on December 22, 1998. Tr. Oct. 10, 2017 PM (10:7-18) (Morse).

D. GATT Bubble Applications**1. Application Families**

45. As of October 2013, there were 399 applications pending with the PTO that name Mr. Hyatt as the inventor and were filed before June 8, 1995 (the effective date of the GATT transition). DX144-000004. Mr. Hyatt filed 381 of these applications between April 6, 1995, and June 7, 1995. DX253-000005-16. Three hundred and thirty one (331) of those applications were filed in the eight days before the 20-year term went into effect—from May 31, 1995, to June 7, 1995. DX253-000007-16. On June 5, 1995 alone, Mr. Hyatt filed 65 applications. DX253-000011-13. On June 6, he filed another 115 applications. DX253-000013-16.

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46. Mr. Hyatt groups his GATT Bubble applications into 11 families according to his assigned docket numbers. PTX-271.00001. Each of Mr. Hyatt's families corresponds to a family of applications identified in the PTO's Requirements. *E.g.*, DX140-000005-07.¹⁸ Mr. Hyatt's applications within the same family share an identical specification. PTX-271. Those families are described below:
- a. The 360 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 360 through 369. PTX-271.00001. This family's general subject matter is "analog memory." Tr. Sept. 18, 2023 AM (59:24-60:1) (Hyatt). This family corresponds to the PTO's Family 1. DX200-000005-06. Mr. Hyatt provided the Court with a chart showing five ancestor applications for this family and an earliest priority date of October 25, 1977. PTX-1830.0002-03. The chart further shows that Application No. 08/429,272 (#360), a member of the family, was filed on April 24, 1995. PTX-1830.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 36 applications, with an earliest claimed priority date of December 28, 1970, the filing date of Application No. 05/101,881 (#101). PTX-1069.17624-27. The earliest identical specification for this family was filed on

18. The "PTO's Requirements" refers to the 2013 Requirements, detailed *infra*, FOF ¶¶ 228-231.

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March 13, 1990, in Application No. 07/493,061 (#329). DX1486-000052.

- b. The 370 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 370 through 393. PTX-271.00001. This family's general subject matter is "illumination control systems." Tr. Sept. 18, 2023 PM (81:9-11) (Hyatt). This family corresponds to the PTO's Family 11. DX69-000007-08. Mr. Hyatt provided the Court with a chart showing three ancestor applications for this family and an earliest priority date of June 4, 1973. PTX-1831.0002-03. The chart further shows that Application No. 08/456,138 (#382), a member of the family, was filed on May 31, 1995. PTX-1831.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 29 applications, with an earliest claimed priority date of December 28, 1970, the filing date of Application No. 05/101,881 (#101). PTX-836.6365-68. The earliest identical specification for this family was filed on December 3, 1987, in Application No. 07/128,659 (#315). DX1486-000052.
- c. The 410 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 410 through 439. PTX-271.00001. This family's general subject matter is "signal processing technology." Tr. Sept. 18, 2023 PM (85:7-10) (Hyatt). This family corresponds to the

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PTO's Family 7. DX46-000005-07. Mr. Hyatt provided the Court with a chart showing four ancestor applications for this family and an earliest priority date of February 14, 1975. PTX-1832.0002-03. The chart further shows that Application No. 08/426,554 (#435), a member of the family, was filed on April 21, 1995. PTX-1832.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 34 applications, with an earliest claimed priority date of December 28, 1970, the filing date of Application No. 05/101,881 (#101). PTX-826.17232-34. The earliest identical specification for this family was filed on April 7, 1986, in Application No. 06/849,243 (#310). DX1486-000052.

- d. The 450 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 400 through 409, 440 through 442, and 450 through 499. PTX-271.00001. This family's general subject matter is "visual processing for host systems, where the host system performs various functions." Tr. Sept. 18, 2023 PM (87:7-11) (Hyatt). This family corresponds to the PTO's Family 9. DX27-000005-07. Mr. Hyatt provided the Court with a chart showing two ancestor applications, with an earliest priority date of June 15, 1983. PTX-1833.0002-03. The chart further shows that Application No. 08/464,995 (#442), a member of the family, was filed on

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June 5, 1995. PTX-1833.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 43 applications, with an earliest claimed priority date of November 24, 1969, the filing date of Application No. 04/879,293 (#100). DX27-000008-09. The earliest identical specification for this family was filed on June 15, 1983, in Application No. 06/504,691 (#193). DX1486-000052.

- e. The 500 Family contains Mr. Hyatt's GATT Bubble applications with docket number 500 through 548. PTX-271.00001. This family's general subject matter is "memory architecture." Tr. Sept. 18, 2023 PM (88:17-20) (Hyatt). This family corresponds to the PTO's Family 12. DX179-000005-07. Mr. Hyatt provided the Court with a chart showing three ancestor applications, with an earliest priority date of October 18, 1984. PTX-1834.0002-03. The chart further shows that Application No. 08/470,080 (#529), a member of the family, was filed on June 6, 1995. PTX-1834.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 14 applications, with an earliest claimed priority date of February 14, 1975, the filing date of Application No. 05/550,231 (#128). PTX-002.00897-98. The earliest identical specification for this family was filed on October 18, 1984, in Application No. 06/662,211 (#302). PTX-1834.0003.

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- f. The 550 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 550 through 569. PTX-271.00001. This family's general subject matter is "computer architecture," especially that pertaining to "computer machine control." Tr. Sept. 18, 2023 PM (90:15-19) (Hyatt). This family corresponds to the PTO's Family 2. DX158-000005-06. Mr. Hyatt provided the Court with a chart showing four ancestor applications for this family and an earliest priority date of December 28, 1970. PTX-1835.0002-03. The chart further shows that Application No. 08/470,075 (#567), a member of the family, was filed on June 6, 1995. PTX-1835.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 10 applications. DX158-000007. December 28, 1970, the filing date of Application No. 05/101,881 (#101), is the correct priority date. DX2204. The earliest identical specification for this family was filed on December 27, 1989, in Application No. 07/457,451 (#327). DX1486-000052.

- g. The 600 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 600 through 628. PTX-271.00001. This family's general subject matter is improvement on memory systems. Tr. Sept. 18, 2023 PM (93:1-3) (Hyatt). This family corresponds to the PTO's Family 8. DX140-000005-07. Mr.

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Hyatt provided the Court with a chart showing one ancestor application for this family and an earliest priority date of December 2, 1988. PTX-1836.0002-03. The chart further shows that Application No. 08/434,424 (#604), a member of the family, was filed on May 3, 1995. PTX-1836.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 43 applications, with an earliest claimed priority date of December 28, 1970, the filing date of Application No. 05/101,881 (#101). DX61-000002-06. The earliest identical specification for this family was filed on December 2, 1988, in Application No. 07/279,592 (#319). DX1486-000052.

- h. The 650 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 650 through 678. PTX-271.00001. This family's general subject matter is "fault tolerant systems associated with the [370 Family's] illumination control technology." Tr. Sept. 18, 2023 PM (95:22-96:1) (Hyatt). This family corresponds to the PTO's Family 6. DX129-000005-06. Mr. Hyatt provided the Court with a chart showing three ancestor applications and an earliest priority date of June 4, 1973. PTX-1837.0002-03. The chart further shows that Application No. 08/458,579 (#677), a member of the family, was filed on June 1, 1995. PTX-1837.0003. Contrary to Mr. Hyatt's chart, this family actually claims

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priority to 34 applications, with an earliest claimed priority date of December 28, 1970, the filing date of Application No. 05/101,881 (#101). DX129-000006-07. The earliest identical specification for this family was filed on October 10, 1989, in Application No. 07/419,911 (#326). DX1486-000052.

- i. The 700 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 700 through 799. PTX-271.00001. This family's general subject matter is "image processing." Tr. Sept. 18, 2023 PM (96:11-13) (Hyatt). This family corresponds to the PTO's Family 10. DX144-000005-07. Mr. Hyatt provided the Court with a chart showing two ancestor applications for this family and an earliest priority date of October 19, 1984. PTX-1838.0002-03. The chart further shows that Application No. 08/457,208 (#711), a member of the family, was filed on June 1, 1995. PTX-1838.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to six applications, with an earliest priority date of June 15, 1983, the filing date of Application No. 06/504,691 (#193). PTX-001.05093-94. The earliest identical specification for this family was filed on October 19, 1984, in Application No. 06/663,094 (#303). Tr. Oct. 2, 2023 AM (1751:5-13) (Hyatt).

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- j. The 800 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 800 through 829. PTX-271.00001. This family's general subject matter is "duty cycle modulated illumination control systems." Tr. Sept. 18, 2023 PM (99:3-6) (Hyatt). This family corresponds to the PTO's Family 5. DX75-000005-06. Mr. Hyatt provided the Court with a chart showing five ancestor applications for this family and an earliest priority date of June 4, 1973. PTX-1839.0002-03. The chart further shows that Application No. 08/454,879 (#816), a member of the family, was filed on May 31, 1995. PTX-1839.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 30 applications, with an earliest claimed priority date of December 28, 1970, the filing date of Application No. 05/101,881 (#101). PTX-2212.2292-95. The earliest identical specification for this family was filed on May 25, 1989, in Application No. 07/357,570 (#324). DX1486-000052.

- k. The 850 Family contains Mr. Hyatt's GATT Bubble applications with docket numbers 850 through 869. PTX-271.00001. This family's general subject matter is "sound and speech processing." Tr. Sept. 18, 2023 PM (100:3-6) (Hyatt). This family corresponds to the PTO's Family 4. DX196-000006-07. Mr. Hyatt provided the Court with a

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chart showing two ancestor applications for this family and an earliest priority date of January 22, 1973. PTX-1840.0002-03. The chart further shows that Application No. 08/486,151 (#855), a member of the family, was filed on June 6, 1995. PTX-1840.0003. Contrary to Mr. Hyatt's chart, this family actually claims priority to 19 applications, with an earliest claimed priority date of December 28, 1970, the filing date of Application No. 05/101,881 (#101). DX196-000008. The earliest identical specification for this family was filed on November 9, 1977, in Application No. 05/849,812 (#145). DX 1486-000052.

2. Pre-Filing Delay

47. Mr. Hyatt delayed filing his GATT Bubble applications for 12 to 26 years. FOF ¶ 51. Even if the Court were to credit his claimed priority dates, that would mean he delayed filing for 6 to 24 years, or 11 to 24 years, excluding the 600 Family. *Id.* In other words, Mr. Hyatt has conceded significant pre-filing delay. Mr. Hyatt further delayed by amending his claims late in prosecution, effectively presenting new claims for examination decades after he could have first filed them. FOF ¶ 56. For instance, in certain of his applications, Mr. Hyatt delayed 46 years before presenting claims for examination. *Id.*

*Appendix B***i. GATT Bubble Applications**

48. Mr. Hyatt's GATT Bubble applications claim priority to a series of applications filed from the late 1960s through the 1980s. A claim of priority to those earlier applications, if valid, would give Mr. Hyatt the benefit of the filing date of those applications. 35 U.S.C. § 120. Put differently, a valid claim of priority would require the PTO to treat Mr. Hyatt's GATT Bubble applications as if they were filed on those earlier dates. *Id.* Thus, if Mr. Hyatt's priority claims to those earlier applications are proper, Mr. Hyatt's GATT Bubble applications, which were filed in 1995, would be treated as if they were filed decades earlier. *Id.*
49. For Mr. Hyatt's priority claims to be valid, his earlier applications have to provide adequate support for the inventions claimed in his GATT Bubble applications. *Id.* More precisely, those earlier applications must provide written description and enablement support for his later claims. *Id.*; *see also* 35 U.S.C. § 112.
50. By claiming priority to those earlier applications, Mr. Hyatt represented to the PTO that he believed his earlier applications provided written description and enablement support for his later claims. Accordingly, Mr. Hyatt represented to the PTO that he could have filed his later claims with his earlier applications.
51. Mr. Hyatt waited decades to file his later claims rather than include them with his

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earlier applications. The below table shows the approximate magnitude of filing delay across Mr. Hyatt’s GATT Bubble applications. The table shows delay based on the Court’s findings respecting Mr. Hyatt’s claimed priority dates (“Actual Filing Delay”), as well as delay based on the priority dates presented in Mr. Hyatt’s charts (“Admitted Filing Delay”), which the Court has now largely rejected. FOF ¶ 46.

| Family | Hyatt Chart Priority Date | Actual Claimed Priority Date | Filing Date¹⁹ | Admitted Filing Delay²⁰ | Actual Filing Delay²¹ |
|---------------|----------------------------------|-------------------------------------|---------------------------------|---|---|
| 360 | 10/25/1977 | 12/28/1970 | 4/24/1995 (#360) | 17 years | 24 years |

19. The Court used the filing dates provided in Mr. Hyatt’s charts as exemplars for the whole family when calculating the delays displayed in this summary chart. PTX-1830.0003 (360 Family); PTX-1831.0003 (370 Family); PTX-1832.0003 (410 Family); PTX-1833.0003 (450 Family); PTX-1834.0003 (500 Family); PTX-1835.0003 (550 Family); PTX-1836.0003 (600 Family); PTX-1837.0003 (650 Family); PTX-1838.0003 (700 Family); PTX-1839.0003 (800 Family); PTX-1840.0003 (850 Family).

20. The Court rounded each year to the nearest integer. For example, there were 24 years, 5 months, and 9 days of pre-filing delay in the 550 Family. That amounts to approximately 24.44 years of pre-filing delay. Rounding that number to the nearest integer yields 24 years of pre-filing delay, which is what appears in the table.

21. *See supra* note 20.

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|-----|----------------|----------------|---------------------|----------|-------------|
| 370 | 6/4/1973 | 12/28/ 1970 | 5/31/1995 (#382) | 22 years | 24 years |
| 410 | 2/14/ 1975 | 12/28/ 1970 | 4/21/1995 (#435) | 20 years | 26 years |
| 450 | 6/15/ 1983 | 11/24/ 1969 | 6/5/1995 (#442) | 12 years | 20 years |
| 500 | 10/18/ 1984 | 2/14/ 1975 | 6/6/1995 (#529) | 11 years | 24 years |
| 550 | 12/28/ 1970 | 12/28/ 1970 | 6/6/1995 (#567) | 24 years | 24 years |
| 600 | 12/2/ 1988 | 12/28/ 1970 | 5/3/1995 (#604) | 6 years | 24 years |
| 650 | 6/4/ 1973 | 12/28/ 1970 | 6/1/1995 (#677) | 22 years | 24 years |
| 700 | 10/19/ 1984 | 6/15/ 1983 | 6/1/1995 (#711) | 11 years | 12 years |
| 800 | 6/4/ 1973 | 12/28/ 1970 | 5/31/1995 (#816) | 22 years | 24 years |
| 850 | 1/22/ 1973 | 12/28/ 1970 | 6/6/1995 (#855) | 22 years | 24 years |

52. Mr. Hyatt significantly delayed presenting his GATT Bubble applications for examination, with delays ranging from 12 to 26 years. Even if the Court were to adopt the priority dates presented in Mr. Hyatt's charts, the delay range would be 6 to 24 years. Excluding the applications that comprise the 600 Family, the delay range would be 11 to 24 years. In other words, Mr. Hyatt has conceded significant periods of pre-filing delay in his GATT Bubble applications.

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53. Mr. Hyatt has indicated that he would have waited even longer to file his continuing applications if not for the GATT transition. Mr. Hyatt previously represented to this Court that he was “forced by the change of law to provide in co-pending applications for all inventions that [he] would need to cover,” and therefore “could not wait to file until after examination of some claims to address additional subject matter later because filing after June 8, 1995 would have resulted in loss of patent term.” DX233-000009. Examiners noted that this meant Mr. Hyatt “was simply waiting and, if not for the change in law in 1995, he would *have waited even longer*” to file additional applications. PTX-2250.1983 (emphasis in original). Mr. Hyatt included similar language in his appeal briefs, but eventually stopped including it in his filings. DX1922-000047 & n.8.

ii. Presenting Newly Amended Claims

54. In addition to delaying filing his GATT Bubble applications, Mr. Hyatt delayed presenting amended claims for examination. As detailed *infra*, FOF ¶¶ 122-142, Mr. Hyatt routinely filed amendments in his GATT Bubble applications that shifted his claims to new inventions and restarted examination years after he initially filed his applications.

55. By amending his claims while maintaining his claimed priority dates, Mr. Hyatt represented to

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the PTO that he believed his earlier applications provided written description and enablement support for his newly amended claims. Accordingly, Mr. Hyatt represented to the PTO that he could have filed his newly amended claims with his earlier applications.

56. Mr. Hyatt waited decades to file his newly amended claims rather than include them with his earlier applications. The below table shows non-exhaustive examples of delay in presenting amended claims for examination across many of Mr. Hyatt's application families. FOF ¶¶ 122-142. The table shows delay based on the Court's findings respecting Mr. Hyatt's claimed priority dates ("Actual Filing Delay"), as well as delay based on the priority dates presented in Mr. Hyatt's charts ("Admitted Filing Delay"). FOF ¶ 46.

| Fa- mily | Appli- cation | Hyatt Chart Priority Date | Actual Claimed Priority Date | Amend- ed Date | Ad- mitted Filing Delay²² | Actual Filing Delay²³ |
|---------------------|------------------------------|--|---|-------------------------------|---|---|
| 360 | 08/ 428, 737 (#361) | 10/25/ 1977 | 12/28/ 1970 | 2/23/ 2015 | 37 years | 44 years |

22. *See supra* note 20.

23. *See supra* note 20.

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|-----|------------------------------|----------------|----------------|----------------|-------------|-------------|
| 370 | 08/ 455, 320 (#380) | 6/4/ 1973 | 12/28/ 1970 | 4/27/ 2017 | 44 years | 46 years |
| 410 | 08/ 418, 213 (#412) | 2/14/ 1975 | 12/28/ 1970 | 1/7/ 2016 | 41 years | 45 years |
| 450 | 08/ 417, 530 (#450) | 6/15/ 1983 | 11/24/ 1969 | 8/3/ 2015 | 32 years | 46 years |
| 500 | 08/ 471, 704 (#514) | 10/18/ 1984 | 2/14/ 1975 | 10/22/ 1998 | 14 years | 24 years |
| 500 | 08/ 472, 062 (#524) | 10/18/ 1984 | 2/14/ 1975 | 10/21/ 1996 | 12 years | 22 years |
| 600 | 08/ 431, 639 (#601) | 12/2/ 1988 | 12/28/ 1970 | 8/19/ 1998 | 10 years | 28 years |
| 700 | 08/ 457, 211 (#708) | 10/19/ 1984 | 6/15/ 1983 | 2/22/ 1999 | 14 years | 16 years |

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|-----|------------------------------|----------------|----------------|----------------|-------------|-------------|
| 700 | 08/ 456, 398 (#717) | 10/19/ 1984 | 6/15/ 1983 | 1/30/ 2002 | 17 years | 19 years |
| 700 | 08/ 463, 823 (#758) | 10/19/ 1984 | 6/15/ 1983 | 12/21/ 1996 | 12 years | 14 years |
| 700 | 08/ 471, 553 (#783) | 10/19/ 1984 | 6/15/ 1983 | 5/11/ 1999 | 15 years | 16 years |
| 700 | 08/ 469, 580 (#789) | 10/19/ 1984 | 6/15/ 1983 | 2/10/ 2015 | 31 years | 32 years |
| 700 | 08/ 471, 042 (#798) | 10/19/ 1984 | 6/15/ 1983 | 6/1/ 2015 | 31 years | 32 years |
| 800 | 08/ 456, 126 (#817) | 6/4/ 1973 | 12/28/ 1970 | 10/15/ 2014 | 41 years | 44 years |

57. Mr. Hyatt significantly delayed presenting his newly amended claims for examination, with delays in some applications reaching as high as 46 years. Mr. Hyatt's delay in presenting amended claims exceeded his delay in filing his GATT Bubble applications. For example, Mr.

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Hyatt delayed 24 years in filing Application No. 08/428,737 (#361) because he filed it on April 25, 1995, 24 years after his earliest claimed priority date for the 360 Family. DX253-000006; FOF ¶ 51. Approximately 20 years later, on February 23, 2015, Mr. Hyatt submitted an amendment that substantially rewrote claim 168 in the #361 application, shifting it to a new invention. FOF ¶ 135. In other words, Mr. Hyatt introduced a substantially new claim for examination 44 years after his earliest claimed priority date. FOF ¶ 56. That constituted additional delay, such that Mr. Hyatt delayed at least 24 to 44 years in the #361 application—24 years to file the application and 44 years to present newly amended claim 168 for examination. Even if the Court were to adopt the priority dates presented in Mr. Hyatt’s charts, Mr. Hyatt still would have delayed at least 18 to 37 years. Although this example is emblematic of Mr. Hyatt’s amendment practice, Mr. Hyatt’s delay in presenting newly amended claims is not limited to claim-shifting amendments.

3. Application Types

58. During trial, Mr. Hyatt testified that his GATT Bubble applications were divisional applications filed in response to restriction requirements in his ancestor applications. *E.g.*, Tr. Sept. 18, 2023 PM (124:14-24) (Hyatt); Tr. Sept. 19, 2023 AM (172:8-174:5) (Hyatt). Mr. Hyatt’s testimony is inconsistent with prevailing practices at the

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time and the file histories of his GATT Bubble applications.

i. Prevailing Practice

59. The PTO allows an applicant to file one of three types of continuation applications: continuation, continuation-in-part (“CIP”), and divisional. MPEP §§ 201.06-08; Tr. Oct. 5, 2023 AM (2373:10-2375:3) (Kunin).
60. “A continuation is a second application for the same invention claimed in a prior application and filed before the original becomes abandoned or patented.” MPEP § 201.07; *see also* Tr. Oct. 5, 2023 AM (2373:22-25) (Kunin).
61. “A continuation-in-part is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application and *adding matter not disclosed* in the said earlier case.” MPEP § 201.08 (emphasis in original); *see also* Tr. Oct. 5, 2023 AM (2374:8-15) (Kunin).
62. A divisional is “[a] later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application.” MPEP § 201.06; *see also* Tr. Oct. 5, 2023 AM (2374:20-2375:2) (Kunin). “The divisional application should set forth only that

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portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.” *Id.*

63. There are two types of divisional applications: voluntary and involuntary. Tr. Oct. 5, 2023 AM (2376:21-2377:7) (Kunin). Voluntary divisionals involve situations where “the applicant discloses but does not claim multiple inventions in an application, and then chooses to file a divisional application claiming those disclosed but unclaimed inventions.” Tr. Oct. 5, 2023 AM (2377:3-7) (Kunin). A voluntary divisional is indistinguishable from a continuation. Tr. Oct. 3, 2023 AM (1944:17-1945:4) (Steiner). Involuntary divisionals, in contrast, are filed “if the USPTO makes a restriction requirement and then the applicant files a divisional application.” Tr. Oct. 5, 2023 AM (2376:-2377:2) (Kunin). Only involuntary divisionals qualify for safe harbor protection under 35 U.S.C. § 121, whereby the earlier application may not be used as a reference against the divisional. Tr. Oct. 5, 2023 AM (2377:8-11) (Kunin).
64. To be considered a divisional application, the claims of the application must be “consonant” with the restriction: the applicant must “cabin[] that divisional to claims that . . . corresponded [to] or . . . were consonant with the claims in the group that [the applicant] didn’t elect.” Tr. Oct. 4, 2023 PM (2246:9-23) (Morse). Put

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differently, the claims in the divisional must be drawn to substantially the same invention as the set of claims that were restricted into the non-elected species corresponding to that divisional application. If the applicant “went off in some other direction, it’s not a divisional that gets that protection.” Tr. Oct. 4, 2023 PM (2246:22-23) (Morse).

65. In 1995, it was generally understood that the terms “continuation,” “continuation-in-part,” and “divisional” referred to distinct application types. Tr. Oct. 5, 2023 AM (2375:4-8) (Kunin); Tr. Oct. 4, 2023 PM (Tr. 2224:16-2225:15) (Morse); Tr. Sept. 27, 2023 (1248:17-22) (Goldberg); *cf.* DX2109-000003 (Official Gazette notice dated March 18, 2003). Although the PTO acknowledged that the application type was “immaterial” to “the right [applicants possess] under [35 U.S.C. § 120],” MPEP § 201.11, the PTO otherwise treated these applications differently, *see* MPEP §§ 201.06-.08, and the Federal Circuit acknowledged in a contemporaneous decision that they differ by claiming different things, *see Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 555 (Fed. Cir. 1994); *see also Pfizer, Inc. v. Teva Pharms. USA, Inc.*, 518 F.3d 1353, 1362 (Fed. Cir. 2008) (later decision clearly distinguishing divisionals and continuations-in-part and declining to apply 35 U.S.C. § 121’s safe harbor to the latter); *Amgen Inc. v. F. Hoffman-La Roche Ltd.*, 580 F.3d 1340, 1354 (Fed. Cir. 2009) (later

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decision clearly distinguishing divisionals and continuations and declining to apply 35 U.S.C. § 121's safe harbor to the latter).

66. Mr. Hyatt understood that the terms “continuation,” “continuation-in-part,” and “divisional” referred to distinct application types and used them accordingly. *See, e.g.*, Tr. Sept. 28, 2023 (1505:7-1507:22) (Hyatt) (discussing PTX-003.01380, PTX-1069.17624, PTX-826.17232, PTX-828.17782, PTX-286.08453, and DX2110). Indeed, Mr. Hyatt was “very particular in the terms” he used when constructing his applications. Tr. Sept. 19, 2023 PM (261:12-18) (Hyatt).
67. For example, in the “CROSS REFERENCE TO RELATED APPLICATIONS” section in Mr. Hyatt’s 550 Family specification, Mr. Hyatt used the term “continuation” to describe the relationship between the GATT Bubble applications in the 550 Family and Application No. 07/457,451 (#327), but used the term “divisional” to describe the relationship between Application No. 05/402,520 (#122) and Application No. 05/101,881 (#101). DX2204.
68. Similarly, in the “CROSS REFERENCE TO RELATED APPLICATIONS” section in Mr. Hyatt’s 360 Family specification, Mr. Hyatt used the term “continuation” to describe the relationship between the GATT Bubble

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applications in the 360 Family and Application No. 08/254,818 (#350), but used the term “continuation in part” to describe the relationship of Application No. 06/160,871 (#168) to 29 listed applications. PTX-1069.17624-27. Mr. Hyatt used the term “divisional” to refer to the relationship between Application No. 08/254,818 (#350) and Applications Nos. 08/283,374 (#351), 08/285,669 (#352), and 08/286,620 (#353). PTX-1069.17624. He also used the term “divisional” to refer to the relationship between Application No. 06/520,277 (#195) and Application No. 06/160,871 (#168). PTX-1069.17624.

ii. Designation in Mr. Hyatt’s Applications

69. To claim the benefit of an earlier filing date, a patent applicant must include in their application a specific reference to the earlier application to which they claim priority. MPEP § 201.11. That reference usually occurs in the first sentence of the specification. Tr. Oct. 5, 2023 AM (2366:8-12) (Morse); Tr. Oct 3, 2023 AM (1944:7-15) (Steiner).
70. Mr. Hyatt included the required references to the applications to which he claimed priority in a section entitled the “cross-reference to related applications” (often styled “CROSSREFERENCE TO RELATED APPLICATIONS”). *E.g.*, DX2204. In this section of Mr. Hyatt’s GATT Bubble applications, he consistently denominated

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his applications “continuation[s],” “continuation[s] in part,” or more generically, “continuing applications.” *E.g.*, PTX-1069.17624-27; *see* Tr. Sept. 19, 2023 AM (176:12-177:4) (Hyatt). Mr. Hyatt did not designate any of his GATT Bubble applications as divisionals.

71. Mr. Hyatt designated the following application families as “continuation[s]”: 360 Family (PTX-1069.17624); 410 Family (PTX-826.17232); 450 Family (PTX-828.17782); 550 Family (DX2204); 600 Family (PTX-003.01380); 800 Family (DX2110-000003).
72. Mr. Hyatt testified that the 650 Family and 800 Family applications “were really continuations in part of the 370 [F]amily.” Tr. Sept. 18, 2023 AM (59:20-21) (Hyatt).
73. Mr. Hyatt designated the 500 Family a “continuation” of one application and a “continuation in part” of another. DX225-000002.
74. Mr. Hyatt labeled his 700 Family applications “continuing application[s]” of two ancestor applications, Applications No. 06/663,094 (#303) and Application No. 07/289,355 (#321). DX104-000002. The 700 Family applications further identified the #303 application as a “continuation in part” of Application No. 06/661,649 (#301) and Application No. 06/662,211 (#302). DX104-000002. During prosecution of Application No.

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08/457,211 (#708) and Application No. 08/456,398 (#717), both members of the 700 Family that Mr. Hyatt had labeled “continuing application[s],” the examiner noted that the “continuing application” label was “vague because it can be interpreted as a continuation or a continuation-in-part.” DX112-000002 (#708 application); DX81-000004 (#717 application). Notably, the examiner did not indicate that the term “continuing application” could be interpreted to refer to a divisional application. DX112-000002; DX81-000004. In response, Mr. Hyatt stated that each application was a “continuation.” DX112-000002; DX81-000004. Based on Mr. Hyatt’s characterizations, the PTO would have treated these applications as continuations, not divisionals. Tr. Oct. 5, 2023 AM (2379:14-2380:14) (Kunin).

75. The file history record demonstrates that Mr. Hyatt’s GATT Bubble applications are continuations or continuations-in-part, *not* divisional applications.
76. Additionally, Mr. Hyatt’s prior representations to this Court, conflicting trial exhibits, and passivity in the face of prior examiner findings that his applications are not divisionals, further supports the Court’s conclusion that Mr. Hyatt’s GATT Bubble applications are not divisional applications.

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77. Mr. Hyatt previously represented to this Court that the applications in suit are “continuation applications.” DX233-000008. In his Proposed Findings of Fact and Conclusions of Law filed after the first phase of trial, he referred to the applications in suit as continuations. ECF No. 200 ¶¶ 18, 26, 34, 41. He also described them as “continuation[s]” in his brief before the Federal Circuit. *Hyatt v. Vidal*, No. 18-2390, ECF No. 43 at 19, 22-24 (Fed Cir. Apr. 25, 2019).
78. Mr. Hyatt’s own trial exhibits referred to three of the four applications in suit—Application No. 08/431,639 (#601), Application No. 08/457,211 (#709), and Application No. 08/456,398 (#717)—as “continuation[s].” PTX-1585 (#601 application); PTX-1587 (#708 application); PTX-1589 (#717 application). He identified Application No. 08/472,062 (#524) as a “New Application,” but not a “divisional.” PTX-1583.
79. In Application No. 08/471,633 (#779), on March 23, 2020, the examiner issued a final office action in which they responded to Mr. Hyatt’s arguments concerning prosecution laches. PTX-2250.1725-988. The examiner found that “[n]one of [Mr. Hyatt’s] pending applications appear to be proper divisions of prior applications.” PTX-2250.1983. Mr. Hyatt filed two responses but did not dispute the examiner’s determination that Mr. Hyatt’s applications are not divisionals. PTX-2250-0146-59, 0112-42. Although the Court does not defer

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to the examiner's finding, the Court finds Mr. Hyatt's reticence in the face of it suggestive that he did not believe his applications were divisionals and only developed this argument as a litigating position in preparation for the second phase of trial.

80. Mr. Hyatt's preliminary amendment practice also supports the Court's conclusion that Mr. Hyatt's GATT Bubble applications are not divisional applications. Mr. Hyatt testified that he did not file his applications with preliminary amendments because "[i]t was impossible to file" them in the period between when Rule 129 became final and the GATT implementation. Tr. Sept. 19, 2023 AM (187:19-24) (Hyatt). As detailed *infra*, FOF ¶¶ 91-92, Mr. Hyatt anticipated that he would have more time to file preliminary amendments before the PTO began examining his GATT Bubble applications. When the PTO accelerated this timeline, he filed identical preliminary amendments instead of filing amendments that focused his claims. *See infra* FOF ¶¶ 93-98. However, if Mr. Hyatt's GATT Bubble applications were divisionals, preparing his preliminary amendments would not have been difficult because Mr. Hyatt had already written the claims for his ancestor applications in which the PTO issued restriction requirements. Mr. Hyatt needed time to write new claims, which indicates that he was not simply filing divisional applications directed to non-elected species.

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81. The Court does not credit Mr. Hyatt's testimony that his applications were divisionals because, in addition to conflicting with the file history record and his prior representations to this Court, it conflicts with his prior deposition testimony. Mr. Hyatt stated during his deposition that the applications in suit are "continuations." DX2165-000095:1-6 (located at ECF No. 338-1). The Court does not credit his explanation at trial that these statements resulted from a vague recollection made without the benefit of recollection-refreshing documents or were inadvertent. Tr. Oct. 2, 2023 PM (1806:9-21, 1808:10-19) (Hyatt).

iii. Applications in Suit: Whether Directed to Non-Elected Species

82. Mr. Hyatt's applications in suit are not directed to non-elected species from his ancestor applications:
- a. Application No. 08/472,062 (#524) is one of four applications in suit. According to Mr. Hyatt, there are three ancestors to the #524 application: Application Nos. 06/662,211 (#302), 07/815,644 (#345), and 08/034,627 (#349). *See* PTX-1834.0003. The #524 application is not directed to a non-elected species from any of these three ancestor applications. *Compare, e.g.*, PTX-002.00760-61 (extant claim 81 in the #524 application, which Mr. Hyatt alleged is drawn to an

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invention restricted at claims 1-8 in the #302 application) *with* PTX-945.454-55 (restricted claims 1-8 in the #302 application).²⁴

- b. Application No. 08/431,639 (#601) is one of four applications in suit. According to Mr. Hyatt, there is one ancestor to the #601 application: Application No. 07/279,592 (#319). *See* PTX-1836.0003. The #601 application is not directed to a non-elected species from the #319 application. *Compare, e.g.,* PTX-003.00849 (extant claim 94 in the #601 application, which Mr. Hyatt alleged is drawn to an invention restricted at claims 51-57, 71-77, 84-91, 102, 103, and 112-118 in the #319 application) *with* PTX-1162.0206-34 (restricted claims 51-57, 71-77, 84-91, 102, 103, and 112-118 in the #319 application).²⁵
- c. Application No. 08/457,211 (#708) is one of four applications in suit. According to Mr. Hyatt, there are two ancestors to the #708 application: Application Nos. 06/663,094 (#303) and 07/289,355 (#321). *See* PTX-1838.0003. The #708 application is not

24. Claims 1-8 in the #302 application, which the PTO labeled restricted species group “I,” are drawn to an “image analysis system.” PTX-945.169.

25. Claims 51-57, 71-77, 84-91, 102, 103, and 112-118 in the #319 application, which the PTO labeled restricted species group “IV,” are drawn to a “shared memory storage accessing.” PTX-1162.0177.

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directed to a non-elected species from either of these two ancestor applications. *Compare, e.g.*, PTX-004.05164-65 (extant claim 503 in the #708 application, which Mr. Hyatt alleged is drawn to an invention restricted at claims 1-10 and 31-51 in the #321 application) *with* PTX-1046.18281-83, 18290-94 (restricted claims 1-10 and 31-51 in the #321 application).²⁶

- d. Application No. 08/456,398 (#717) is one of four applications in suit. According to Mr. Hyatt, there are two ancestors to the #717 application: Application Nos. 06/663,094 (#303) and 07/289,355 (#321). *See* PTX-1838.0003. The #717 application is not directed to a non-elected species from either of these two ancestor applications. *Compare, e.g.*, PTX-001.05025 (extant claim 129 in the #717 application, which Mr. Hyatt alleged is drawn to an invention restricted at claims 15, 16, and 18-20 in the #303 application) *with* DX261-000007-10 (restricted claims 15, 16, and 18-20 in the #303 application).²⁷

26. Claims 1-10 and 31-51 in the #321 application, which the PTO labeled restricted species group, “I,” are drawn to a “display device and processor.” PTX-1046.18278.

27. Claims 15, 16, and 18-20 in the #303 application, which the PTO labeled restricted species group, “IV,” are drawn to an “image processing system using image transformation.” PTX-2255.0002.

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83. These examples further undermine Mr. Hyatt's testimony that his GATT Bubble applications are divisionals drawn to restricted species. They support the Court's conclusion that Mr. Hyatt's GATT Bubble applications are not divisional applications.

4. GATT Transition

84. Mr. Hyatt filed his GATT Bubble applications in the days and weeks leading to the effective date of the new 20-years-from-earliest-priority-date patent term regime. He filed most of his applications during the six weeks between the date the PTO finalized Rule 129, April 25, 1995, and the effective date of the patent term changeover, June 8, 1995. *See* DX144-000004; DX253-000006-16. Mr. Hyatt filed his GATT Bubble applications as photocopies of approximately 11 ancestor applications. Tr. Sept. 18, 2023 AM (58:19-23) (Hyatt). Shortly after the changeover, the PTO began rejecting his GATT Bubble applications. Tr. Sept. 19, 2023 PM (233:20-234:13) (Hyatt). In response, Mr. Hyatt filed duplicate preliminary amendments in an attempt to delay examination and stay off rejections. *E.g.*, DX1841 (identical claim sets filed by Mr. Hyatt in the 700 Family). Around this time, Mr. Hyatt met with Group Director Nicholas Godici to discuss his applications. DX84-000001-02. During the meeting, Mr. Hyatt agreed to focus his claims on a single different

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invention in each application. DX84-000001-02. Mr. Hyatt made this promise despite lacking a “master plan” for demarcating his applications. DX2000-69.

i. Window to File

85. The change to the patent term became law on December 8, 1994. URAA § 532(a)(1). Mr. Hyatt testified that he did not begin filing his GATT Bubble applications immediately after the patent term became law because he was waiting for the PTO to publish final rules implementing the GATT legislation. Tr. Sept. 25, 2023 (922:13-19) (Hyatt).
86. Four days after the change became law, the PTO published its proposed rule package to “implement the changes related to patent term.” Changes to Implement 20-Year Patent Term and Provisional Applications (“Draft Rule”), 59 Fed. Reg. 63951 (Dec. 12, 1994). That rule package included a draft of Rule 129 that permitted an application to have two submissions “considered on the merits after final rejection” under certain circumstances. *Id.* at 63964. Mr. Hyatt, who was “tremendously interested in technology and IP protection,” Tr. Sept. 18, 2023 PM (131:21-22) (Hyatt), was aware of the efforts by the Japanese government to secure changes to the U.S. patent system that culminated in the enactment of the URAA, Tr. Sept. 25, 2023 (917:22-918:5)

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(Hyatt); *see also* Tr. Sept. 25, 2023 (912:22-913:7) (Hyatt). Additionally, Mr. Hyatt testified that he “reviewed . . . the federal register where it was published after it was signed.” Tr. Sept. 19, 2023 AM (171:11-16) (Hyatt). Accordingly, the Court concludes that Mr. Hyatt was aware of the impending patent term changeover and knew of the proposed rule changes within a reasonable time after they were published.

87. The final Rule 129, issued on April 25, 1995, contained substantively identical provisions to the proposed Rule 129. *Compare* Draft Rule, 59 Fed. Reg. at 63964 *with* Final Rule, 60 Fed. Reg. at 20226-27.
88. According to Mr. Hyatt, one of the reasons why he waited so long to file his GATT Bubble applications is that the PTO did not publish its final rules until April 25, 1995. He testified that it would not have been “practicable” to file his applications earlier. Tr. Sept. 19, 2023 AM (173:15-22) (Hyatt). As a result, Mr. Hyatt had only “about six weeks” to file his applications. Tr. Sept. 18, 2023 AM (171:23-172:1) (Hyatt). This testimony is inconsistent with the file histories of his GATT Bubble applications.
89. Mr. Hyatt started filing GATT Bubble applications as early as April 6, 1995. DX253-000005. In total, he filed 36 GATT Bubble applications (one of which he later abandoned) before April 25,

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1995. DX253-000005-06. At trial, Mr. Hyatt attempted to justify this inconsistency with his other testimony by explaining that Application No. 06/849,243 (#310) was about to be issued as a patent and that he needed to file continuing applications before it was issued or else lose his chain of continuity. Tr. Tr. Oct. 2, 2023 AM (1692:12-1693:14) (Hyatt). However, several of the applications Mr. Hyatt filed before April 25, 1995, were unrelated to the #310 application. Tr. Oct. 2, 2023 AM (1693:15-18) (Hyatt); Tr. Oct. 2, 2023 PM (1828:17-1829:24). Mr. Hyatt was unable to explain why he filed these applications before April 25, 1995.

90. Mr. Hyatt filed his applications earlier when he believed it was advantageous for him to do so, for example, to preserve a chain of continuing applications. His actions belie his testimony that he needed to wait to file his GATT Bubble applications until after the PTO finalized Rule 129 or that filing earlier would have been impracticable.

ii. Identical Preliminary Amendments

91. Mr. Hyatt filed his GATT Bubble applications as photocopies of approximately 11 ancestor applications. Tr. Sept. 18, 2023 AM (58:19-23) (Hyatt). Mr. Hyatt's photocopied claim sets were placeholders, and he did not intend for the PTO to examine them. Tr. Sept. 25, 2023

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(936:25-937:7) (Hyatt); DX2165-000097:21-98:4. Instead, he intended to file preliminary amendments later that would differentiate the claim sets in his applications. Tr. Sept. 25, 2023 (937:14-22) (Hyatt); DX167-000016. Mr. Hyatt could have filed preliminary amendments contemporaneously with his GATT Bubble applications but did not do so. Tr. Oct. 4, 2023 PM (2231:23-2233:14) (Morse); *see also* Tr. Sept. 19, 2023 AM (186:20-21) (Hyatt).

92. Mr. Hyatt inferred from the PTO's Official Gazette that he had approximately 20 months to file preliminary amendments before the PTO would begin examining his GATT Bubble applications. Tr. Sept. 19, 2023 PM (231:13-232:12) (Hyatt). However, due to the age of Mr. Hyatt's applications in light of their claimed effective filing dates, the PTO began examinations within weeks, not the months that Mr. Hyatt had expected. Tr. Sept 19, 2023 PM (234:7-13) (Hyatt) (testimony that Mr. Hyatt began receiving final office actions in his applications shortly after filing and before he had submitted new claim sets); DX152-000002 (petition decision explaining that the PTO considered "effective filing dates" in determining the order of examination) (emphasis in original). Although Mr. Hyatt characterized the PTO as examining his applications "out of turn," Tr. Sept. 25, 2023 (937:20-22) (Hyatt), Director Godici contemporaneously explained that the PTO considers the claimed priority

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date in selecting applications for examination. DX152-000002. For example, in one application that claimed an October 17, 1984 priority date, Director Godici noted that “[t]he subject matter ha[d] been before the Office for eleven years,” and therefore, it was “certain[l]y ripe for action.” DX152-000002.

93. Once the PTO began issuing final office actions on his identical claim sets, Mr. Hyatt began filing identical preliminary amendments to stay off rejections. *E.g.*, DX120 (Application No. 08/457,211 (#708)). Mr. Hyatt filed identical amendments within his application families, meaning, his amended applications contained the same claims; the amendments did not focus his applications on distinct inventions. *E.g.*, DX1841 (documenting 51 identical claim sets filed in the 700 Family between August 11 and 14, 1995); DX1842 (documenting 48 identical claim sets filed in the 500 Family on August 23, 1995); *see also* Tr. Sept. 26, 2023 (1028:21-1029:2) (Hyatt) (testimony concerning identical preliminary amendments in the 700 Family); Tr. Sept. 19, 2023 PM (244:3-10) (Hyatt) (testimony explaining that Mr. Hyatt filed substantially similar or identical preliminary amendments in his applications).
94. Even where Mr. Hyatt’s claim amendments were not identical across applications in a given application family, they were highly similar. For example, one examiner noted that Mr. Hyatt

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added new claims 21-97 in approximately half of the applications in the 700 Family, and that “[t]hese new sets of claims only differed in substance from one another by which adjective was used in which independent claim to modify the type of ‘information’ that was being ‘generated.’” DX1654-000004. Otherwise, the claims appeared to be substantially identical.

95. In other applications, Mr. Hyatt filed identical claims back-to-back. *E.g.*, DX1311-000002-03 (identical claims 90-91 in Application No. 08/471,704 (#514)). He also filed identical preliminary amendments months apart. For example, in Application No. 08/472,062 (#524), claim 16 filed on August 23, 1995, is identical to claim 90 filed on December 29, 1995. *Compare* DX222-000003 (August 23, 1995 amendment) *with* DX223-000002 (December 29, 1995 amendment).
96. Mr. Hyatt did not intend for the PTO to examine these duplicate-amended claim sets. Tr. Sept. 25, 2023 (944:8-11) (Hyatt). Instead, he amended his applications to avoid final rejections and buy time to prepare additional preliminary amendments that would introduce the claims he actually wanted examined. Tr. Sept. 19, 2023 PM (244:4-10) (Hyatt); Tr. Sept. 25, 2023 (944:5-7, 945:3-8) (Hyatt); *see also* PTX-004.06653. In other words, Mr. Hyatt interposed these identical preliminary amendments to delay examination and prevent the PTO from issuing final rejections before he

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was ready to present his claims. He did so by presenting claims that he never intended the PTO to examine.

97. Mr. Hyatt testified that it was “improper” for the PTO to issue final office actions on the basis of his original claim sets. Tr. Sept. 25, 2023 (945:3-8) (Hyatt). However, as the MPEP explained, “[e]ach examiner will give priority to that applicant in his or her docket, whether amended or new, which has the *oldest effective U.S. filing date*. Except as rare circumstances may justify group directors in granting individual exceptions, this basic policy applies to all applications.” MPEP § 708 (emphasis in original). Director Godici explained this to Mr. Hyatt contemporaneously with the PTO issuing final office actions in his unamended GATT Bubble applications. DX152-000002.
98. Mr. Hyatt further testified that he relied on guidance from Vincent Turner and other PTO personnel that filing identical preliminary amendments would prevent the PTO from issuing final rejections in his applications. Tr. Sept. 26, 2023 (1029:4-16) (Hyatt). At the time, Mr. Turner was a PTO employee and, therefore, was prohibited from providing legal advice to applicants. Tr. Oct. 4, 2023 AM (2157:23-2158:7) (Turner). Mr. Turner credibly testified that he did not provide Mr. Hyatt with legal advice. Tr. Oct. 4, 2023 AM (2164:21-23) (Turner). At most,

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Mr. Turner provided Mr. Hyatt with generalized “guidance.” Tr. Oct. 4, 2023 AM (2165:4-8) (Turner). Mr. Hyatt indicated that he relied on this guidance—which Mr. Turner could not confirm he had given—in formulating his plan to file identical preliminary amendments and thereby forestall examination. Tr. Sept. 19, 2023 PM (234:16-235:3) (Hyatt); Tr. Oct. 4, 2023 AM (2169:14-2170:3) (Turner).

iii. Director Godici Meeting

99. Mr. Hyatt met with Director Godici on October 24, 1995, to discuss his preliminary amendment practice. DX84-000001. The parties contest the content of an agreement that Mr. Hyatt and Director Godici reached during that meeting.
100. Mr. Hyatt’s contemporaneous written meeting description recorded that: “Director Godici met with the Applicant on October 24, 1995. The Applicant was asked to file supplemental preliminary amendments that better focused the claims on *a different invention in each application* in order to simplify examination and the Applicant agreed.” DX84-000001-02 (emphasis added).
101. During trial, Mr. Hyatt testified that Director Godici “wanted different inventions, not single inventions.” Tr. Oct. 2, 2023 AM (1741:21-1742:4) (Hyatt). Mr. Hyatt testified that Director Godici

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wanted him to “focus the claims on a different invention, emphasis on different, not on a singular ‘a.’” Tr. Oct. 2, 2023 AM (1747:5-8) (Hyatt). In other words, Mr. Hyatt testified that he agreed to focus his applications but only to the extent that he could still claim multiple inventions in a single application. *See* Tr. Oct. 2, 2023 AM (1741:24-1742:2) (Hyatt).

102. The Court does not credit Mr. Hyatt’s testimony that his agreement with Director Godici permitted him to claim multiple inventions in a single application. The Court finds that the plain meaning of Mr. Hyatt’s contemporaneous written description, read in context, provides the substantive content for his agreement with Director Godici: a promise to focus each application on a distinct (i.e., singular) invention.
103. Mr. Hyatt’s testimony is inconsistent with his contemporaneous written meeting description. Mr. Hyatt used a singular indefinite article (“a”) in his memorialization of his agreement with Director Godici. DX84-000001. The singular article indicates that Mr. Hyatt agreed to focus his claims on a singular different invention in each application. Mr. Hyatt is “very particular in the terms” he uses while prosecuting his applications. Tr. Sept. 19, 2023 PM (261:12-18). Mr. Hyatt’s attempt to walk back his use of the singular indefinite article, nearly three decades after he entered that language in his prosecution

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file histories, is dubious at best. *Cf.* 37 C.F.R. § 1.2 (directing applicants to conduct business with the PTO in writing and wholly discounting oral promises, stipulations, and understandings as evidence of contested issues).

104. The Court’s reading of the contemporaneous written record is consistent with Mr. Hyatt’s explanation for the number of GATT Bubble applications he filed. The Court has found that Mr. Hyatt filed his applications based on the number of inventions disclosed in his ancestor applications. FOF ¶ 39. For example, Mr. Hyatt testified that the 700 Family’s specification disclosed “at least 100 inventions,” so he “filed 100 copies of the ancestor application.” Tr. Sept. 18, 2023 AM (58:24-59:3) (Hyatt). He also represented in a sworn declaration that he “filed about 100 patent applications [in the 700 Family] in 1995 because an initial count of inventions contained in the [700 Family] specification exceeded 100 inventions.” DX233-000008. In other words, when Mr. Hyatt filed his applications in 1995, he had in mind a one-to-one correspondence between his inventions and his applications—he filed the number of applications equal to his number of disclosed inventions. The Court’s interpretation of the record—that Mr. Hyatt agreed to focus each application on a singular different invention—is consistent with Mr. Hyatt’s intended one-to-one correspondence. Mr. Hyatt’s current testimony, in contrast, is inconsistent with his longstanding

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explanation for the number of applications he filed because it would require that Mr. Hyatt believed in 1995 that he had more inventions than he had filed applications.²⁸

105. Mr. Hyatt's testimony is inconsistent with a later meeting summary submitted by his then-attorney, Vincent Turner. On April 30, 1997, Special Patent Examiner ("SPE") Michael Razavi called Mr. Turner to discuss Mr. Hyatt's applications. DX2203-000002. According to Mr. Turner's contemporaneous written summary, "SPE Razavi stated that examination would be simplified if the claims were focused. In particular, SPE Razavi suggests that the Applicant (1) focus *each application on a single invention*; e.g., a topographical system rather

28. The Court's reading would be correct even if Mr. Hyatt's applications were divisionals drawn to non-elected species because Mr. Hyatt testified that he filed his applications based on his count of restricted *and* unclaimed inventions. Hyatt Resp. 32 (citing Tr. Sept. 18, 2023 PM (124:21-24, 140:1-9) (Hyatt) and Tr. Sept. 19, 2023 AM (172:8-174:5) (Hyatt)). Every distinct restricted and unclaimed invention should map to a single application in that scenario. The Court's interpretation of the agreement with Director Godici is consistent with that intended one-to-one correspondence. In contrast, Mr. Hyatt's proffered interpretation would mean he met with Director Godici believing he had more inventions than he had filed applications, even though the PTO largely had not yet examined his claims or identified additional distinct species. *See* PTX-895 (indicating that the PTO issued its first post-GATT restrictions in Mr. Hyatt's applications a few days before he met with Director Godici).

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than claims directed to many different systems and (2) indicate the basis in the specification for the particular claimed invention.” DX2203-000002 (emphasis added). SPE Razavi’s request to Mr. Turner aligns with the Court’s reading of the contemporaneous written record of the October 1995 Director Godici meeting.

106. Mr. Hyatt’s testimony is inconsistent with the general context in which Director Godici asked him to focus his application. For example, on September 28, 1995, approximately one month before he met with Director Godici, Mr. Hyatt spoke with Examiner Jeffrey Brier concerning his applications. PTX-002.01101. Examiner Brier “indicated that some of [Mr. Hyatt’s] applications had claims that were directed to multiple inventions. In order to simplify the issues, the Applicant agreed to amend the claims to be more focused.” PTX-002.01101; *see also* FOF ¶ 10 (identifying issues with Mr. Hyatt submitting claims directed to multiple inventions as early as 1978). If the issue with Mr. Hyatt’s applications was that his claims were directed to multiple inventions, then it is unclear how Mr. Hyatt could resolve that issue and simplify examination except by focusing each application on a single different invention. Accordingly, the best interpretation of the record is that Mr. Hyatt promised Director Godici he would do so shortly after Examiner Brier put him on notice.

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107. Given the unfavorable written record, Mr. Hyatt introduced evidence that he relied on a conversation with Jessica Harrison, an examiner who was then detailed to the MPEP help desk, in which she relayed that Rule 129(b) permitted him to pursue multiple inventions in a single GATT Bubble application. Tr. Oct. 2, 2023 PM (1846:19-1847:4) (Harrison); *see also* Tr. Sept. 19, 2023 AM (207:4-208:11) (Hyatt); Tr. Oct. 2, 2023 AM (1740:10-23) (Hyatt). Any such conversation occurred in or after December 1995 and therefore post-dated Mr. Hyatt's meeting with Director Godici. Tr. Oct. 2, 2023 PM (1842:9-13) (Harrison). Ms. Harrison was not involved in examining Mr. Hyatt's applications and had no personal knowledge of his applications or examination history. Tr. Oct. 3, 2023 AM (1892:13-1893:7, 1900:2-12) (Harrison). Accordingly, any such conversation between Mr. Hyatt and Ms. Harrison cannot explain or clarify the specific agreement he reached with Director Godici at least one month prior. At best, Mr. Hyatt's conversation with Ms. Harrison may explain why he disregarded his agreement with Director Godici. However, Mr. Hyatt did not record his conversation with Ms. Harrison in writing, and Ms. Harrison credibly testified that she did not give Mr. Hyatt legal advice. Tr. Oct. 3, 2023 AM (1906:21-1907:4) (Harrison).

*Appendix B***iv. Plan to Demarcate**

108. Mr. Hyatt admitted he lacked a “master plan” for prosecuting his GATT Bubble applications. DX2000-69 (admission by Mr. Hyatt); Tr. Oct. 11, 2017 AM (74:7-74:19) (Morse) (testimony describing Mr. Hyatt’s admission).
109. Although Mr. Hyatt later testified that he had a plan to focus his applications through preliminary amendments, *e.g.*, Tr. Sept. 19, 2023 PM (240:11-241:3) (Hyatt), Mr. Hyatt failed to timely prepare his applications for examination, *see* FOF ¶¶ 91-98, which undermines his testimony. Mr. Hyatt believed he had many more months to prepare preliminary amendments than he reasonably should have expected based on his effective filing dates, *see* FOF ¶¶ 92, 97, which suggests that when he filed his applications, he at most *intended* to develop a plan to file focusing amendments, not that he had already prepared one. Possessing the diffuse intention to focus applications in the future is not the same as possessing an operationalizable plan to demarcate them. And filing dozens of identical preliminary amendments evinces that Mr. Hyatt had formulated a reactionary plan to delay, not a plan to demarcate. Mr. Hyatt did not have a plan to demarcate during the GATT transition period.
110. Moreover, as detailed *infra*, FOF ¶¶ 160-168, Mr. Hyatt failed to abide by his agreement with

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Director Godici to focus each of his applications on a single different invention, and he failed to maintain consistent lines of demarcation between his applications. Mr. Hyatt also routinely filed amendments that shifted his claims to new inventions and restarted examination. FOF ¶¶ 122-142. The Court concludes from Mr. Hyatt's lack of plan during the GATT transition period, FOF ¶ 109, and his ultimate failure to demarcate, FOF ¶¶ 122-142, 160-168, that he did not have a plan to demarcate his applications between 1995 and 2015.

5. Complex Priority Chains

111. Mr. Hyatt's applications claim priority to a large number of applications and a broad range of priority dates:
 - a. The 360 Family claims priority to 36 applications, with claimed priority dates starting December 28, 1970, to August 5, 1994. PTX-1069.17624-27; *see also* FOF ¶ 46(a).
 - b. The 370 Family claims priority to 29 applications, with claimed priority dates ranging from December 28, 1970, to April 27, 1990. PTX-836.6365-68; *see also* FOF ¶ 46(b).

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- c. The 410 Family claims priority to 34 applications, with claimed priority dates ranging from December 28, 1970, to April 7, 1986. PTX-826.17232-34; *see also* FOF ¶ 46(c).
- d. The 450 Family claims priority to 43 applications, with claimed priority dates ranging from November 24, 1969, to April 6, 1995. DX27-000008-09; *see also* FOF ¶ 46(d). Many of those priority claims stem from the 450 Family's express priority claim to Application No. 06/504,691 (#193), which incorporated by reference another 42 applications, including Application No. 04/879,293 (#100), which was filed on November 24, 1969. PTX-828.17782-84.
- e. The 500 Family claims priority to 14 applications, with claimed priority dates ranging from February 14, 1975, to April 6, 1995. PTX-002.00897-98; *see also* FOF ¶ 46(e).
- f. The 550 Family claims priority to 10 applications, with claimed priority dates ranging from December 28, 1970, to December 27, 1989. DX158-000007; DX2204; *see also* FOF ¶ 46(f).
- g. The 600 Family claims priority to 43 applications, with claimed priority dates ranging from December 28, 1970, to

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September 4, 1990. DX61-000002-06; *see also* FOF ¶ 46(g).

- h. The 650 Family claims priority to 34 applications, with claimed priority dates ranging from December 28, 1970, to May 25, 1989. DX129-000006-07; *see also* FOF ¶ 46(h).
- i. The 700 Family claims priority to six applications, with claimed priority dates ranging from June 15, 1983, to December 22, 1988. PTX-001.05093-94; *see also* FOF ¶ 46(i).
- j. The 800 Family claims priority to 30 applications, with claimed priority dates ranging from December 28, 1970, to April 27, 1990. PTX-2212.2292-95; *see also* FOF ¶ 46(j).
- k. The 850 Family claims priority to 19 applications, with claimed priority dates ranging from December 28, 1970, to November 9, 1977. DX196-000008; *see also* FOF ¶ 46(k).

112. Mr. Hyatt's applications overlap in their priority claims. For example, the 360, 370, 410, 600, 650, 800, and 850 Families all claim priority to Application No. 05/101,881 (#101), which Mr. Hyatt filed on December 28, 1970. PTX-1069.17624 (360 Family); PTX-836.6365 (370

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Family); PTX-826.17232 (410 Family); DX61-000003 (600 Family); DX129-000006-07 (650 Family); PTX-2212.2292 (800 Family); DX196-000008 (850 Family). The #101 application “is identified as a priority parent in more than half of” Mr. Hyatt’s GATT Bubble applications. Tr. Oct. 4, 2023 PM (2230:9-17) (Morse). The overlap in Mr. Hyatt’s priority claims between application families indicates that they include overlapping technologies.

113. The PTO introduced an exhibit visually representing the overlapping nature of Mr. Hyatt’s applications and their priority claims. DX231. Gregory Morse prepared the exhibit using data exported from the PTO’s case database, PALM. Tr. Oct. 4, 2023 PM (2267:21-2268:4) (Morse). Although Mr. Hyatt vociferously disputed the accuracy of DX231 during his testimony, *e.g.*, Tr. Sept. 21, 2023 (543:20-25) (Hyatt) (characterizing DX231 as “absolutely false and absolutely horrible”), the Court has been unable to replicate or confirm any of his claimed errors or deficiencies, *e.g.*, Tr. Sept. 21, 2023 (544:12-545:7) (Hyatt) (criticizing DX231 for connecting child applications together even though they are not connected in the exhibit). Consequently, the Court concludes that DX231 accurately represents the priority claims in Mr. Hyatt’s applications and, to that extent, is a useful indicator of the complex, overlapping nature of his priority claims as defined in his specifications.

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114. The crux of Mr. Hyatt’s testimony and objections to the PTO’s evidence appears to be that his priority date *entitlements*—as opposed to his unvarnished priority date *claims*—are the proper objects of judicial inquiry into the reasonableness of his prosecution conduct. *See, e.g.*, Tr. Sept. 21, 2023 (524:16-19) (Hyatt) (testifying that “examiners did not have any problems” determining the priority dates to which his applications were entitled). In several applications, the PTO identified priority dates, meaning they evaluated his priority claims against his ancestor applications and determined the effective filing dates to which he was entitled. *E.g.*, PTX-1799.00003. The priority *entitlements* alleged by Mr. Hyatt (i.e., the chains of priority to which his applications are entitled) are orders of magnitude simpler than his priority *claims*.
115. However, Mr. Hyatt’s complex priority claims burdened the PTO’s examination of his applications. For example, Mr. Morse credibly testified that the complexity of Mr. Hyatt’s priority claims caused examiners “trouble identifying the priority date for each claim to appropriately apply art.” Tr. Oct. 10, 2017 AM (77:9-10) (Morse); Tr. Oct. 10, 2017 PM (23:6-24:1) (Morse). Moreover, the wide range of Mr. Hyatt’s priority date claims compounded examiners’ difficulties because the rapid progression of computer technologies over even relatively short periods of time meant that examiners would

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need to search dramatically different prior art depending on the applicable priority date. Tr. Oct. 10, 2017 PM (17:1-7) (Morse). The Court credits Mr. Morse's testimony that Mr. Hyatt's complex priority claims impacted the burden on examination "in terms of identifying written description support" and in "terms of identifying the correct date for application of prior art." Tr. Oct. 10, 2017 PM (34:4-7) (Morse). The file history record demonstrates that examiners routinely engaged in complicated reviews of dozens of ancestor applications to determine whether Mr. Hyatt was entitled to his claimed priority dates. *See, e.g.*, PTX-828.17286 (reviewing 42 ancestor applications); PTX-428.00003 (same); PTX-1799.0002-03 (same); *see also* PTX-1800.0003 (failing "to find support" for subject matter in ancestor applications after review); PTX-1809.0002 (same). The fact that the PTO was ultimately able to determine priority dates in some of Mr. Hyatt's applications does not mean that the process of parsing his priority claims, reviewing his ancestor applications, and making the determinations was trivial. Indeed, Stephen Kunin testified that Mr. Hyatt's complex priority claims, combined with his other prosecution conduct, made it "extremely difficult" for the PTO "to conclude prosecution and examination" of his applications. Tr. Oct. 13, 2017 AM (13:2-15:11) (Kunin).

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116. Additionally, Mr. Hyatt’s testimony concerning his priority claims was not credible. For example, Mr. Hyatt answered “yes” when asked on direct examination whether “all it takes to determine that true ancestor relationship [of his applications] is to look at the applications that are listed before the list of numbers” in the cross-reference to related applications section of his specifications. Tr. Sept. 21, 2023 (549:14-20) (Hyatt). Mr. Hyatt then contradicted himself on cross-examination. Tr. Sept. 28, 2023 (1468:3-5) (Hyatt) (agreeing that “[w]hether [an application] appears before the list, or in the list, . . . it’s one of [his] [a]ncestor [a]pplications.”).
117. In addition to contradicting himself on cross-examination, Mr. Hyatt also introduced several exhibits that identified applications as ancestors of his GATT Bubble applications even though they did not appear “before the list of numbers.” Tr. Sept. 21, 2023 (549:14-20) (Hyatt); *compare*, *e.g.*, PTX-1830.0003 (identifying Application No. 05/844,765 (#143) as an ancestor of the 360 Family to which Mr. Hyatt claimed priority) *with* PTX-1069.17626 (containing the #143 application within “the list of numbers”). When confronted with these inconsistencies on cross-examination, Mr. Hyatt became obstinate and, by his evident shift in demeanor and substantive position based on the identity of his questioner, severely undermined the Court’s faith in the accuracy of his testimony. Tr. Sept. 28, 2023 (1463:11-1466:25) (Hyatt); *see* FOF ¶ 247.

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118. Mr. Hyatt's testimony that examiners determining priority dates for his application families would not consider continuation-in-part applications and would "know to stop" at the earliest identical specification also is not credible. *E.g.*, Tr. Oct. 2, 2023 AM (1754:18-23) (Hyatt) (discussing the 500 Family). Continuation-in-part applications can obtain the benefit of filing dates of earlier ancestor applications, so there is no reason why the PTO would categorically exclude them from consideration. 35 U.S.C. §§ 112, 120; MPEP § 201.11. Mr. Hyatt, in fact, included continuations-in-part in his priority charts. *E.g.* PTX-1831.0003 (370 Family). And examiners routinely reviewed his continuation-in-part ancestors for written description support when determining priority for claims in his GATT Bubble applications. *E.g.*, PTX-828.17286.
119. Furthermore, whether a particular patent claim is entitled to the benefit of a particular filing date is evaluated on a claim-by-claim basis. Tr. Oct. 4, 2023 PM (2229:19-22) (Morse). Accordingly, different patent claims in a single patent application may be entitled to the benefit of different filing dates. *See, e.g.*, DX2105-000007 (appeal brief submitted by Mr. Hyatt in Application No. 08/454,878 (#383) contending that claim 105 has the benefit of a June 4, 1973 priority date while claims 213 and 276 have the benefit of a December 28, 1970 priority date). There are many instances where Mr. Hyatt claimed different

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priority dates within the same application or application family. *E.g.*, DX2107-000021. Mr. Hyatt’s testimony that examiners would “know to stop” at the earliest identical specification is inconsistent with his actual priority claims. *See* Tr. Oct. 2, 2023 AM (1754:18-23) (Hyatt).

120. Mr. Hyatt testified that he included many priority claims because “they [were] necessary for the best mode requirement and for the avoidance of prior art in [his] earlier applications.” Tr. Sept. 28, 2023 (1470:11-16) (Hyatt). This testimony is not credible because Mr. Hyatt’s application families expressly claim “the benefit of the filing dates of *all* of the above-listed applications.” *E.g.*, PTX-1069.17627 (360 Family) (emphasis added). None of Mr. Hyatt’s applications limit the purpose of the included priority claims to meeting the best mode requirement or avoiding prior art. Mr. Hyatt was unable to direct the Court to a single piece of evidence—other than his testimony, which the Court does not credit—showing he relied on a priority claim for the best mode requirement and the avoidance of prior art only and not to claim the benefit of an earlier filing date. Mr. Hyatt included priority claims *to claim priority*—not solely to satisfy other requirements.

121. Determining the effective filing date for Mr. Hyatt’s applications is far more complicated than identifying the earliest identical specification. Examiners must compare each of Mr. Hyatt’s

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claims to each application to which he claimed the benefit of a priority date, including continuations-in-part. Mr. Hyatt's application families contained dozens of complex, overlapping priority claims. The volume of claims burdened examination of Mr. Hyatt's applications, even though the PTO made priority date determinations in his applications. Mr. Hyatt's testimony to the contrary is not credible because it is contradictory and unsupported by the written record. Further, it is not helpful because it conflates ostensibly simple priority date *entitlements* with Mr. Hyatt's unquestionably complex and burdensome priority *claims*.

6. Claim Shifting

122. Mr. Hyatt routinely filed amendments in his GATT Bubble applications that shifted his claims to new inventions and restarted examination years after he initially filed his applications. Substantially rewriting claims effectively restarted examination because it required the PTO to perform a new written description analysis, double patenting analysis, and prior art search. Tr. Oct. 10, 2017 PM (77:4-14, 86:5-88:15) (Morse). Mr. Hyatt filed such amendments before and after the PTO issued the 2013 Requirements. Mr. Hyatt testified that his amendments did not shift his claimed inventions and merely narrowed or conformed his claims. The Court has closely reviewed the examples raised or contested by the

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parties and made findings concerning nearly all of them. The Court's findings reflect its considered conclusion that Mr. Hyatt's testimony is not credible and that his claim-rewriting amendments were not routine narrowing amendments.

i. Pre-2013 Requirements

123. In Application No. 08/417,530 (#450), Mr. Hyatt filed an amendment on June 22, 1998, that shifted several claims and restarted examination. DX22.
124. In Application No. 08/471,704 (#514), Mr. Hyatt filed an amendment on October 20, 1998, that shifted several claims and restarted examination. DX188.
125. In Application No. 08/470,082 (#520), Mr. Hyatt filed an amendment on November 14, 1996, that amended several claims and restarted any pre-mailing examination that had already commenced. DX1856.
126. In Application No. 08/472,062 (#524), Mr. Hyatt filed an amendment on October 14, 1996, that shifted claim 17 and restarted examination. PTX-002.01018-20.
127. In Application No. 08/471,710 (#532), Mr. Hyatt filed an amendment on November 6, 1996, that amended several claims and restarted

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any pre-mailing examination that had already commenced. DX1858.

128. In Application No. 08/431,639 (#601), Mr. Hyatt filed an amendment on January 16, 1996, that shifted claim 58 and restarted examination. PTX-003.01262.
129. In Application No. 08/431,639 (#601), Mr. Hyatt filed an amendment on February 19, 1997, that shifted claim 91 and restarted examination. PTX-003.01177.
130. In Application No. 08/431,639 (#601), Mr. Hyatt filed an amendment on August 19, 1998, that shifted claim 58 and restarted examination. DX50-000003-05.
131. In Application No. 08/457,211 (#708), Mr. Hyatt filed an amendment on February 22, 1999, that shifted claims 125 and 128 and restarted examination. PTX-004.05869-71.
132. In Application No. 08/456,398 (#717), Mr. Hyatt filed an amendment on January 30, 2002, that shifted claims 283 and 421 and restarted examination. DX90-000103, 114.
133. In Application No. 08/463,823 (#758), Mr. Hyatt filed an amendment on December 21, 1996, that shifted claims 98 and 100 and restarted examination. PTX-2269.0002-05.

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134. In Application No. 08/471,553 (#783), Mr. Hyatt filed an amendment on May 11, 1999, that shifted claims 99 and 102 and restarted examination. DX1868-000005-08. Mr. Hyatt entered this amendment pursuant to Rule 129(a). PTX-2260.0299.

ii. Post-2013 Requirements

135. In Application No. 08/428,737 (#361), Mr. Hyatt filed an amendment on February 23, 2015, that shifted claim 168 and restarted examination. PTX-1069.16148-49.

136. In Application No. 08/455,320 (#380), Mr. Hyatt filed an amendment on April 27, 2017, that shifted claim 128 and restarted examination. PTX-836.3740-41.

137. In Application No. 08/418,213 (#412), Mr. Hyatt filed an amendment on January 7, 2016, that shifted claim 10 and restarted examination. PTX-826.11437-38.

138. In Application No. 08/417,530 (#450), Mr. Hyatt filed an amendment on August 3, 2015, that shifted several claims and restarted examination. DX25.

139. In Application No. 08/469,580 (#789), Mr. Hyatt filed an amendment on December 10, 2015, that redesignated the claims selected for examination

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pursuant to the 2013 Requirements and shifted claims 175, 180, 191, 205, and 283. DX1666-000077, 79, 83-84, 90-91, 122-123. The PTO did not enter the amendment because it was shifting. *See* DX1179-000011-12; *see also* Tr. Oct. 2, 2023 PM (1791:3-9) (Hyatt).

140. In Application No. 06/469,580 (#789), Mr. Hyatt filed an amendment on October 6, 2016, that redesignated the claims selected for examination pursuant to the 2013 Requirements, thereby shifting the claims and restarting examination. DX1180-000003.
141. In Application No. 08/471,042 (#798), Mr. Hyatt filed an amendment on June 1, 2015, that shifted claim 95 and restarted examination. PTX-1148.35530.
142. In Application No. 08/456,126 (#817), Mr. Hyatt filed an amendment on October 15, 2014, that shifted claims 309 through 317 and restarted examination. DX670-000110-19.

iii. Reliance on Rule 129(a) to Shift Claims

143. Mr. Hyatt testified that he believed Rule 129(a) entitled him to entry and examination of a new claim set directed to different inventions than his previously examined claims. Tr. Oct. 2, 2023 AM (1716:4-12) (Hyatt); *see also* PTX-2260.0299. Mr.

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Hyatt based his understanding on the text of the rule and written PTO commentary. Tr. Sept. 19, 2023 AM (201:6-202:16) (Hyatt). Mr. Hyatt also testified that he spoke directly to PTO personnel, who provided him with guidance regarding his rights under the rule. *E.g.*, Tr. Oct. 2, 2023 PM (1850:4-1851:8) (Harrison). Only a subset of Mr. Hyatt's claim shifting amendments were submitted under Rule 129(a). *E.g.*, PTX-2260.0299 (pre-2013 Requirements Rule 129(a) submission in Application No. 08/471,553 (#783)).

7. Specification Length

144. A typical specification is 20 or 30 pages long. Tr. Oct. 6, 2017 PM (23:15-16) (Clarke). Mr. Hyatt's specifications, in contrast, were lengthy, complex, and incorporated upwards of dozens of earlier applications by reference. The applications in suit are illustrative:
- a. Application No. 08/472,062 (#524) includes 238 pages of written description, PTX-002.01223-460, 40 pages of drawings, PTX-002.01183-222, and four earlier applications incorporated by reference, PTX-002.01224.
 - b. Application No. 08/431,639 (#601) includes 517 pages of written description, PTX-003.01380-896, 46 pages of drawings, PTX-003.01333-78, and 43 earlier applications incorporated by reference, PTX-003.01380-83.

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- c. Application No. 08/457,211 (#708) includes 576 pages of written description, DX121-000078-653, 66 pages of drawings, DX121-000012-77, and three earlier applications incorporated by reference, DX121-000079.
 - d. Application No. 08/456,398 (#717) includes 576 pages of written description, PTX-001.05255-830, 66 pages of drawings, PTX-001.05840-905, and three earlier applications incorporated by reference, PTX-001.05256.
145. The applications in any given application family share the same lengthy specification. *E.g.*, DX144-000006 (700 Family). For example, all 100 applications in the 700 Family, including applications in suit #708 and #717, include 576 pages of written description, 66 pages of drawings, and three earlier applications incorporated by reference. *See* DX144-000006; FOF ¶ 144(c)-(d).
146. The 500, 600, and 700 Families were not the only families with lengthy, complex specifications. The 360 Family specification is 251 pages long. DX200-000008. The 370 Family specification is 280 pages long. DX69-000011. The 410 Family specification is 508 pages long. DX46-000008. The 450 Family specification is 840 pages long. DX27-000011. The 550 Family specification is 171 pages long. DX158-000007. The 650 Family specification is 708 pages long. DX129-000007.

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The 800 Family specification is 456 pages long. DX75-000008. The 850 Family specification is 135 pages long. DX196-000009. Again, a typical specification is 20 or 30 pages long. Tr. Oct. 6, 2017 PM (23:15-16) (Clarke).

147. The length and complexity of Mr. Hyatt's specifications burdened examination by making it more difficult for examiners to identify written description support. Tr. Oct. 10, 2017 PM (22:4-23:5) (Morse). Examiners faced significant hurdles searching Mr. Hyatt's specifications for support for claimed interconnections of elements. *See* Tr. Oct 10, 2017 PM (41:16-42:1) (Morse); Tr. Oct. 11, 2017 AM (5:2-16, 31:16-32:5) (Morse); *see also* Tr. Oct. 11, 2017 AM (6:10-23) (Morse). These difficulties were even greater before the PTO digitized its records in 2003 because, in the pre-digital era, examiners had no choice but to wade through large stacks of paper to identify written description support or search for double patenting. Tr. Oct. 10, 2017 PM (25:9-26:13) (Morse).
148. Mr. Hyatt testified that he believed his lengthy disclosures were necessary to satisfy the best mode requirement, Tr. Sept. 18, 2023 AM (42:2-43:1, 43:12-44:2) (Hyatt), facilitate examination by the PTO, Tr. Sept. 18, 2023 AM (48:20-49:16) (Hyatt), and benefit interested members of the public, Tr. Sept. 18, 2023 PM (114:13-16) (Hyatt). According to Mr. Hyatt, his "patent applications

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were large” because they “were system patent applications” that made use of a top-down disclosure method that resulted in an exceptional degree of detail. *See* Tr. Sept. 18, 2023 AM (57:19-24) (Hyatt).

149. Whatever his reasons, the Court credits the PTO’s evidence that Mr. Hyatt’s lengthy and complex disclosures burdened examination. Although the PTO was able to issue a patent on pre-GATT Application No. 07/763,461 (#341) (Patent No. 5,487,172), which included “something more than 800 pages for the specification,” Tr. Sept. 18, 2023 PM (118:16-17) (Hyatt), as detailed *infra*, FOF ¶ 173, that application is distinguishable from Mr. Hyatt’s GATT Bubble applications because it contains significantly fewer claims. That the PTO serially examined a single application with an unusually lengthy specification says nothing about the burden of examining hundreds of applications with lengthy specifications in parallel while Mr. Hyatt was routinely entering claim shifting amendments that restarted examination, FOF ¶¶ 122-142, and refusing to identify written description support for his claims, FOF ¶¶ 153-159.

8. Large Number of Claims

150. Mr. Hyatt increased the number of claims in his GATT Bubble applications through amendments. As of the 2013 Requirements, Mr. Hyatt’s

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applications contained approximately 117,000 claims. Tr. Oct. 3, 2023 PM (2085:13-16) (Morse). This yields an average of 121 independent claims and 303.5 total claims per application. DX256-000009. Only 0.02% of applications filed between 1995 and 2013 contain more than 299 claims. DX251-000001 (providing data as of the 2013 Requirements). The large number of claims made double patenting analysis impracticable. Tr. Oct. 10, 2017 PM (50:10-20, 72:11-73:2) (Morse); *see also* DX1486-000094-95.

151. Mr. Hyatt suggested at trial that he needed so many claims to cover the “very significant number of features and subfeatures” in his applications. *Cf.* Tr. Sept. 20, 2023 PM (455:7-9) (Hyatt). He further testified that he needed many more narrow claims to avoid prior art, Tr. Sept. 22, 2023 (697:7-15) (Hyatt), and that he filed many more dependent claims than independent claims to lessen the burden on examination, Tr. Sept. 20, 2023 AM (345:8-12) (Hyatt). Mr. Hyatt understood that there was no formal limit on the number of claims he could file, Tr. Sept. 20, 2023 AM (343:10-345:3) (Hyatt), and that the PTO had considered but declined to promulgate a rule capping the number of claims an applicant could file in a single application, Tr. Sept. 20, 2023 AM (346:7-12) (Hyatt).

152. The Court does not credit Mr. Hyatt’s testimony that he needed many more narrow claims to

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avoid prior art because he has not persuasively explained why he needed to add more claims rather than amending existing ones. Additionally, approximately 40% of Mr. Hyatt's claims—or nearly 47,000 claims—are independent claims. DX256-000009. Mr. Hyatt's applications on average contain 121 independent claims. Even ignoring his dependent claims, that places Mr. Hyatt's applications in the top 0.46% of applications by number of claims. DX251-000001.

9. Failure to Identify Written Description Support

153. Applicants who submit new or amended claims are expected to provide the PTO with a roadmap between their claims and supporting written description. Tr. Oct. 12, 2017 PM (5:16-23) (Kunin). This expectation comprises part of the applicant's duty of candor and good faith. *See* Tr. Oct. 13, 2017 AM (7:4-25) (Kunin).

154. Mr. Hyatt went many years failing to identify written description support for his claims. Tr. Oct. 13, 2017 AM (9:6-18) (Kunin). The applications in suit are illustrative:

- a. In Application No. 08/472,062 (#524), the examiner issued an office action on January 29, 1997, just under two years after filing, which noted that Mr. Hyatt “has failed to point out where in the specification support

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may be found for the amended and added claims.” PTX-002.01009.

- b. In Application No. 08/431,639 (#601), the examiner issued an office action on May 19, 1999, more than four years after filing, which noted that “[a]dditional support is needed to determine when and where the claimed elements were first introduced into the chain of continuations in order to verify Applicant’s claim to priority.” PTX-003.00963.
- c. In Application No. 08/457,211 (#708), the examiner issued an office action on August 27, 1999, more than four years after filing, which noted that “none of the arguments presented” by Mr. Hyatt purporting to traverse the examiner’s written description rejection “specifically addresses any of the rejections nor do any of the arguments specifically address any of the claims nor where the alleged support for the claims can be found in the originally filed specification.” PTX-004.05785.
- d. In Application No. 08/456,398 (#717), the examiner issued an office action on September 7, 2004, more than nine years after filing, which noted that “[t]hus far in the prosecution history, [Mr. Hyatt] has made no attempt” to identify written description support for his claims. PTX-001.04042.

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155. Mr. Hyatt failed to identify written description support in other applications, as well:

- a. In Application No. 08/458,143 (#702), the examiner issued an office action on December 2, 2004, which noted that “to date the applicant has made absolutely no attempt to show possession of the claimed invention; despite the filing of numerous lengthy responses that generally cite case law, and specifically allege that the examiner has not made a prima facie case.” PTX-220.02242. The examiner then observed that “[t]hus far in the prosecution history, [Mr. Hyatt] has made no attempt” to identify written description support for his claims. PTX-220.02242; *see also* PTX-1148.37749-50 (similar office action issued on July 15, 2005, in Application No. 08/471,042 (#798)).
- b. In Application No. 08/456,901 (#715), the examiner issued an office action on December 21, 1999, which noted that “none of the arguments presented by applicant in these sections specifically addresses any of the rejections nor do any of the arguments specifically address any of the claims nor where the alleged support for the claims can be found in the originally filed specification.” PTX-217.05311; *see also* PTX-220.01449 (similar office action issued on June 14, 2000, in Application No. 08/456,901 (#715));

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PTX-826.14630 (similar office action issued on August 9, 2005, in Application No. 08/418,213 (#412)); PTX-2250.7068 (similar office action issued on September 13, 1999, in Application No. 08/471,633 (#779)).

156. Mr. Hyatt does not persuasively contest any of these examples, contending instead that he cannot be faulted for failing to identify written description support before the Federal Circuit decided *Hyatt v. Dudas (Dudas I)*, 492 F.3d 1365 (Fed. Cir. 2007). *See* Hyatt Resp. 101-02. Accordingly, the Court concludes that Mr. Hyatt routinely failed to identify written description support in the pre-*Dudas I* era.
157. Mr. Hyatt presented evidence that he identified written description support in applications after the 2013 Requirements. PTX-420 (application attachment dated March 30, 2017); PTX-884 (appeal brief appendix dated August 9, 2021); PTX-885 (same); PTX-887 (same). However, the PTO disputes that these submissions to the Office adequately identified written description support for claimed interconnections of elements or were otherwise helpful to examiners. PTO Resp. 157-58. And, in Application No. 08/464,007 (#747), in an office action dated September 26, 2016, the examiner noted that “[t]hrough extensive amendment after actions subsequent to the 2013 Requirements, Applicant has demonstrated a willingness to amend his claims such that they

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are not meaningfully supported by the same written description in the specification as the current claims.” DX143-000107. Though this language might suggest mere disagreement over the patentability of Mr. Hyatt’s newly amended claims, the examiner took pains to remind Mr. Hyatt that “the USPTO *requires* [his] cooperation in . . . identifying support for all pending claims.” DX143-000108 (emphasis in original). Thus, when read in its full context, the import of the examiner’s exhortation is that Mr. Hyatt had entered at least some post-Requirements amendments without identifying written description support for his newly amended claims. *See* DX143-000108.

158. Mr. Hyatt also presented evidence that the Board reversed various written description rejections in his applications, including in the applications in suit. PTX-893. But these reversals do not undermine the Court’s conclusion that he routinely failed to identify written description support, since the Board in any event *affirmed* many of the examiners’ rejections, and they at most establish that the Board determined there was written description support for certain of his claims, not that he adequately assisted examiners in identifying that support.

159. The Court is well aware of the complexities of identifying written description support for Mr. Hyatt’s claims. *See Hyatt v. Iancu*, 332 F. Supp. 3d 83, 99 n.22 (D.D.C. 2018) (statement by this

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Court observing that it was able to find written description support for certain of Mr. Hyatt's claims only by "rely[ing] heavily upon the new evidence presented at trial," which included "many hours of expert testimony over many weeks"). Mr. Hyatt's failures to identify written description support for his claims exacerbated the burdens on the PTO created by his complex priority claims, FOF ¶¶ 111-121, claim-shifting amendments that restarted examination, FOF ¶¶ 122-142, lengthy specifications, FOF ¶¶ 144-149, and large number of claims, FOF ¶¶ 150-152.

10. Failure to Demarcate

160. Mr. Hyatt failed to demarcate his applications pursuant to his agreement with Director Godici to focus each application on a single different invention. FOF ¶¶ 99-107. Mr. Hyatt did not testify at trial that he abided by this agreement. Instead, he acknowledged that he claimed more than one invention in certain applications, Tr. Oct. 2, 2023 AM (1741:2-9) (Hyatt), but offered a competing interpretation of the meeting under which Director Godici permitted him to do so. FOF ¶ 101. The Court has already rejected that interpretation as unsupported by the contemporaneous written record of the meeting, read in context. FOF ¶ 102. The Court concludes that Mr. Hyatt's GATT Bubble applications were not focused as required by his agreement with Director Godici because he claimed more than

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one invention per application. Tr. Oct. 2, 2023 AM (1741:2-9) (Hyatt); *see also* Tr. Sept. 20, 2023 AM (342:15-23) (Hyatt) (indicating that the PTO determined Mr. Hyatt's applications contained more than 1500 independent and distinct inventions); Tr. Oct. 2, 2023 PM (1781:3-16) (Hyatt) (same).

161. Additionally, Mr. Hyatt's claim-shifting amendments demonstrate that instead of keeping his applications focused on single inventions (or sets of inventions), he regularly and repeatedly amended his applications to claim different inventions from the ones he had previously claimed, which restarted examination. FOF ¶¶ 122-142. Mr. Hyatt also amended his applications to contain numerous duplicate and patentably indistinct claims. *See* DX200-000014-36 (360 Family); DX69-000020-46 (370 Family); DX46-000013-29 (410 Family); DX27-000019-30 (450 Family); DX179-000016-26 (500 Family); DX158-000011-30 (550 Family); DX140-000014-18 (600 Family); DX129-000014-28 (650 Family); DX144-000016-25 (700 Family); DX75-000014-19 (800 Family); DX196-000023-41 (850 Family); *see also* DX1654-000004-05 (detailing adjective-cycling amendments in the 700 Family). Regardless of how the Court interprets the Director Godici meeting, Mr. Hyatt's prosecution conduct demonstrates that his applications were not focused.

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162. Subject matter tables prepared and filed by Mr. Hyatt further demonstrate that he did not focus his applications. Mr. Hyatt prepared tables in 1997 and 2016 that described the subject matter of applications in the 410 Family. PTX-826.16629-30 (1997 Table); PTX-826.11405 (2016 Table). Those subject matters shifted over time. Tr. Oct. 4, 2023 PM (2248:19-2252:1) (Morse). For example, Application No. 08/418,213 (#412) shifted from “FILTER” to “Multiple channel communication systems.” Application No. 08/418,996 (#418) shifted from “MEDICAL DIAGNOSTIC” to “Radar and sonar control systems.” Application No. 08/420,170 (#419) shifted from “MACHINE DIAGNOSTIC” to “Data link control systems.” Application No. 08/420,470 (#425) shifted from “LOCATION” to “Peripheral memory controller systems.” Application No. 08/423,235 (#427) shifted from “MACHINE CONTROL” to “A three dimensional processing system.” Application No. 08/423,390 (#429) shifted from “UNDERWATER ACOUSTIC” to “Fourier transform communication systems.” Application No. 08/426,554 (#435) shifted from “IMAGE PROCESSING” to “A solid state memory for an integrated circuit computer system.” And Application No. 08/427,547 (#439) shifted from “MICROWAVE” to “An improved frequency domain processing system.”

163. The tables also demonstrate that Mr. Hyatt shifted subject matter from one application to another.

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Tr. Oct. 4, 2023 PM (2251:10-20) (Morse). For example, in 1997, the subject matter of Application No. 08/418,213 (#412) was “FILTER.” In 2016, the subject matter of Application No. 08/419,682 (#417) was “Recursive filter systems.” In 1997, the subject matter of Application No. 08/417,532 (#413) was “FOURIER TRANSFORM.” In 2016, the subject matter of Application No. 08/423,390 (#429) was “Fourier transform communication systems.”

164. Mr. Hyatt also prepared tables in 2015 and 2020 that described the subject matter of and lines of demarcation between applications in the 700 Family. *See* DX1666-000011-13 (characterizing the subject matter descriptions within the 2015 table as “line[s] of demarcation”). These tables show significant shifting of inventions. *Compare* DX1666-000012 (2015 table) *with* PTX-2250.2004-06 (2020 table).
165. In 2016, Mr. Hyatt prepared another chart that identified 105 separate inventions that he believed were disclosed in the 700 Family specification. DX150-000026-30. Mr. Hyatt marked the corresponding 700 Family application next to 27 listed inventions. DX150-000026-27. However, he left this field blank for 77 of them. DX150-000027-30. This indicates that as of 2016, Mr. Hyatt had not yet claimed any of these 77 inventions in his 700 Family applications, or at the very least, demarcated his applications to focus on them. For

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the 27 inventions he marked, Mr. Hyatt indicated that any such focusing was due to amendments he had submitted on October 9, 2015. DX150-000014-15. This demonstrates that Mr. Hyatt lacked a plan to demarcate the applications in his largest application family and had failed to do so by 2015.

166. Mr. Hyatt also prepared tables in 2016 and 2018 that described the subject matter of and lines of demarcation between applications in the 450 Family. *See* PTX-828.15173-75 (characterizing the subject matter descriptions within the 2016 table as “line[s] of demarcation”). These tables show significant shifting of inventions. *Compare* PTX-828.15173-74 (2016 table); *with* PTX-828.16365 (2018 table).

167. As another exemplary instance where Mr. Hyatt failed to demarcate his applications, on the same day that Mr. Hyatt represented to the Board that no applications other than Application No. 08/471,553 (#783) contained certain claim limitations, Mr. Hyatt filed an amendment in Application No. 08/469,580 (#789) that added those same claims limitations. Tr. Oct. 4, 2023 PM (2261:15-25, 2262:6-20) (Morse); DX1922-000080. Mr. Hyatt engaged in similar behavior in other applications. DX1922-000075-91. The Court finds unpersuasive Mr. Hyatt’s argument that he demarcated the #783 and #789 applications because certain claims in the latter application include welding limitations. Hyatt Resp. 90-91. Only a subset

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of claims includes welding limitations, and Mr. Hyatt did not even select them for examination. The Court also finds unpersuasive his argument that he was not actually representing to the PTO that the claimed subject matter did not appear in any other of his applications.

168. Accordingly, the Court concludes that Mr. Hyatt failed to demarcate his applications. Even setting aside the details of Mr. Hyatt's agreement with Director Godici, Mr. Hyatt routinely shifted his claims, FOF ¶¶ 122-142, added duplicate and patentably indistinct claims, FOF ¶ 161, shifted the general subject matter of his claims, FOF ¶¶ 162-164, 166, failed to claim certain inventions until extremely late in prosecution, FOF ¶ 165, and failed to maintain consistent positions before the PTO regarding the focus of his claims, FOF ¶ 167. Mr. Hyatt's failure to focus his claims is the natural and probable consequence of his failure to develop a plan to focus his claims during the lifetime of his GATT Bubble applications.

11. Comparing Pre-GATT and GATT Bubble Applications

169. Between 1971 and 1997, Mr. Hyatt successfully prosecuted 75 patent applications to issuance as patents. PTX-569.00001-03; *see also* DX268-000001-03. During this period, Mr. Hyatt obtained an average of two to three issued patents per year.

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170. Mr. Hyatt's GATT Bubble applications differ from these issued patents by the number of claims presented in them. For example, Mr. Hyatt's GATT Bubble applications averaged 303.5 claims per application as of the 2013 Requirements. DX256-000009. Mr. Hyatt's issued patents, in contrast, averaged 40.25 claims. DX268-000003.
171. They also differed by the number of co-pending applications. Mr. Hyatt filed the applications that ultimately issued as his patents between 1967 and 1995, a span of approximately 28 years. DX268-000001-03. That means, on average, he filed less than three such applications per year. In some years, he filed only a single application that ultimately issued as a patent. The most applications he ever filed in a single year that ultimately issued as patents is nine. Mr. Hyatt's approximately 400 GATT Bubble applications, in contrast, were filed within weeks of each other, resulting in a massive number of complex co-pending applications for which he is simultaneously seeking patents. *See* FOF ¶¶ 45, 84. Mr. Hyatt escalated the number of claims in these applications through amendments, bringing his total number of claims (as of the 2013 Requirements) on which he is simultaneously seeking patents to approximately 117,000. FOF ¶ 150.
172. Additionally, Mr. Hyatt's GATT Bubble applications include unusually complex priority

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chains, FOF ¶¶ 111-121, and large specifications, FOF ¶¶ 144-149. During prosecution, Mr. Hyatt repeatedly entered claim-shifting amendments that restarted examination, FOF ¶¶ 122-142, and failed to identify written description support for his claims, FOF ¶¶ 153-159. Mr. Hyatt also failed to demarcate his applications. FOF ¶¶ 160-168. Thus, Mr. Hyatt's GATT Bubble applications are materially different from the ancestor applications on which he obtained issued patents. They are also materially different from other applicant's GATT Bubble applications, which, on average, have undergone approximately three office actions; Mr. Hyatt's applications, in contrast, have undergone, on average, approximately 15 office actions. Tr. Oct. 13, 2017 AM (20:20-21:3) (Kunin); *see also* DX1486-000094.

173. Patent No. 5,487,172 issued with 72 claims. DX268-000002. Mr. Hyatt filed the application that ultimately issued as Patent No. 5,487,172 on September 20, 1991, several years before he filed hundreds of GATT Bubble applications. DX268-000002.

12. Boone Interference Count

174. Some applications in the 550 Family present claims regarding a single-chip microprocessor that Mr. Hyatt previously lost in an interference proceeding, namely, *Hyatt v. Boone*, 146 F.3d 1348 (Fed. Cir. 1998).

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175. Claim 186 in Application No. 08/470,879 (#554) was directed to the single-chip microprocessor Mr. Hyatt lost in *Boone*. DX1244-000002. Mr. Hyatt testified only that he added this claim inadvertently and that he cancelled it once he became aware of his error. Tr. Sept. 25, 2023 (830:6-13) (Hyatt). The #554 application is a member of the 550 Family and, therefore, claims priority to December 28, 1970, the date Mr. Hyatt lost in the interference. PTX-1835.0003; *see also* Tr. Sept. 25, 2023 (876:3-7) (Hyatt).
176. Claim 314 in Application No. 08/470,879 (#554) was directed to the single-chip microprocessor Mr. Hyatt lost in *Boone*. DX158-000011-12; *see also* Tr. Oct. 11, 2017 PM (10:1-6) (Morse). Mr. Hyatt testified at trial that the #554 application is *entitled* to a later priority date than the lost interference count. Tr. Sept. 25, 2023 (829:8-17) (Hyatt). But the #554 application is a member of the 550 Family and, therefore, *claims* priority to December 28, 1970, the date he lost in the interference. PTX-1835.0003; *see also* Tr. Sept. 25, 2023 (876:3-7) (Hyatt).
177. Claim 180 in Application No. 08/470,671 (#558) was directed to the single-chip microprocessor Mr. Hyatt lost in *Boone*. DX1205-000002. Mr. Hyatt testified at trial that claim 180 materially differed from the *Boone* interference count because it was directed to “a system embodiment,” whereas the *Boone* count was “focused on a computer.”

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Tr. Sept. 25, 2023 (829:18-830:5) (Hyatt). This difference is not material here, and the Court does not credit this testimony. The #558 application is a member of the 550 Family and, therefore, claims priority to December 28, 1970, the date Mr. Hyatt lost in the interference. PTX-1835.0003; *see also* Tr. Sept. 25, 2023 (876:3-7) (Hyatt). Mr. Hyatt testified similarly regarding claim 155 in the #554 application (Application No. 08/470,879). Tr. Sept. 25, 2023 (829:18-830:5) (Hyatt).

178. Claim 173 in Application No. 08/471,599 (#561) was directed to the single-chip microprocessor Mr. Hyatt lost in *Boone*. DX158-000011-12; *see also* Tr. Oct. 11, 2017 PM (10:1-6) (Morse). Mr. Hyatt testified at trial that the #561 application is *entitled* to a later priority date than the lost interference count. Tr. Sept. 25, 2023 (829:8-17) (Hyatt). But the #561 application is a member of the 550 Family and, therefore, *claims* priority to December 28, 1970, the date he lost in the interference. PTX-1835.0003; *see also* Tr. Sept. 25, 2023 (876:3-7) (Hyatt).

179. Claim 155 in Application No. 08/471,547 (#565) was directed to the single-chip microprocessor Mr. Hyatt lost in *Boone*. DX1279-000002. Mr. Hyatt testified at trial that claim 155 materially differed from the *Boone* interference count because it recites “essentially a whole system,” rather than just a computer, and that although

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“there is no single-chip limitations” in the claim, “they totally dominate the count.” Tr. Oct. 3, 2023 AM (1693:19-1694:20) (Hyatt). But the Court understands this testimony to convey that claim 155 is *broader* than the count Mr. Hyatt lost in the *Boone* interference, which means he was attempting to reclaim it. *See* Tr. Oct. 4, 2023 PM (2267:15-20) (Morse); *see also* MPEP § 804(II). Mr. Hyatt further testified that claim 155 has written description support in the application to which he lost his priority claim in *Boone*. Tr. Oct. 2, 2023 AM (1694:21-1695:4) (Hyatt). Even setting aside that the #565 application is a member of the 550 Family and therefore claims priority to that date, PTX-1835.0003, Mr. Hyatt’s testimony confirms that he intended as much.

180. Accordingly, the Court concludes that Mr. Hyatt attempted to reclaim the single-chip microprocessor he lost in the *Boone* interference. Indeed, in at least one context, Mr. Hyatt proceeded before the PTO as though he had not lost the *Boone* interference, providing a “description of the interference proceedings” that was “affirmatively misleading,” failing to “even acknowledge that he was the losing party in that interference due to a lack of written description,” and presenting “apparently identical declarations to establish the same facts that were finally decided adversely to him.” DX264-000010-11. Mr. Hyatt’s claims, conduct, and conflicting testimony amply support the Court’s finding.

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And even assuming Mr. Hyatt presented these claims with the expectation that he would not ultimately be entitled to the priority date he lost in the interference, he failed to notify the PTO of this, forcing it to expend time and resources relitigating a priority claim he had already lost.

13. Mr. Hyatt's Cooperation with the PTO

181. Mr. Hyatt communicated with PTO personnel at least 239 times between 1988 and 2019. PTX-897. He also met with two heads of the PTO. Tr. Sept. 25, 2023 (840:8-15) (Hyatt).
182. Mr. Hyatt worked with PTO personnel to avoid mail room delays by having amendments hand-delivered to supervisors and examiners, Tr. Sept. 19, 2023 PM (255:1-10) (Hyatt), and by faxing amendments, *e.g.*, PTX-861.3.
183. Mr. Hyatt provided certain materials to PTO personnel upon request. *E.g.*, PTX-002.01096 (lists of serial numbers and examinable applications); Tr. Sept. 20, 2023 PM (430:20-431:2) (Hyatt) (copies of nonpatent references).
184. Mr. Hyatt sent drafts of amendments to the specification and figures in the 700 Family to SPE Michael Razavi. PTX-215.00003; PTX-216.00012-13.

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185. Mr. Hyatt worked with SPE Richard Hjerpe to improve the process of submitting information disclosure statements filed in multiple applications. PTX-1941.0001.

14. Dismissal of Section 145 Actions

186. Mr. Hyatt failed to advance prosecution of certain Section 145 actions in district court after receiving appellate decisions from the Federal Circuit and the Supreme Court, which resulted in the presiding judge dismissing those actions.

187. For example, in *Hyatt v. Lee*, District Judge Emmet Sullivan granted the PTO's motion to dismiss for failure to prosecute, noting that "Mr. Hyatt cannot convincingly explain away his delay before this Court and the PTO. The only explanation that reasonably emerges is that Mr. Hyatt has sought to delay prosecution in order to obtain the latest possible start date for the 17-year patent term." 232 F. Supp. 3d 148, 158 (D.D.C. 2017) (Sullivan, J.).

188. In another case, this Court granted the PTO's motion to dismiss for failure to prosecute, noting that Mr. Hyatt's delay caused prejudice "not only to the public generally, from whom [his] inaction took three additional years of freely using the technology, but also to any companies in related industries who may have unknowingly incorporated the plaintiff's patent." *Hyatt v. Lee*,

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No. 03-cv-901, 2016 WL 11480814, at *5 (D.D.C. June 6, 2016) (Lamberth, J.). This Court further stated that “[i]t is unacceptable . . . for the Court to be used not as a forum for litigation but a tool in manipulation patent issuance dates.” *Id.*

189. Mr. Hyatt’s explanation for failing to prosecute these cases was that he was unfamiliar with federal court proceedings and erroneously believed that he needed to wait for the appellate court to issue a mandate. Tr. Sept. 25, 2023 (828:9-23) (Hyatt). However, Mr. Hyatt was represented by counsel in these cases. Tr. Sept. 25, 2023 (828:24-829:1) (Hyatt). The Court does not credit his explanation.

E. Applications in Suit**1. Application No. 08/457,211 (#708) [05-CV-2310]**

190. Mr. Hyatt filed Application No. 08/457,211 (#708) on June 1, 1995. DX121-000004. The application is a continuation of Application Nos. 06/663,094 (#303) and 07/289,355 (#321). DX112-000002; Tr. Oct. 2, 2023 PM (1808:6-19) (Hyatt). The #708 application is not a divisional, FOF ¶ 74, and is not directed to a non-elected species, FOF ¶ 82(c).

191. The PTO rejected all then-pending claims on August 27, 1999. PTX-004.05743-807. The claims were rejected based on lack of enablement under

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35 U.S.C. § 112, first paragraph, PTX-004.05746-56, lack of written description under 35 U.S.C. § 112, first paragraph, PTX-004.05756-58, obviousness over prior art, PTX-004.05758-70, and obviousness-type double patenting, PTX-004.05770-72. The examiner later withdrew the double patenting rejections, while maintaining the other grounds of rejection. PTX-004.04742, 04744-906.

192. The Board affirmed the examiner's final rejection of the appealed claims, though it reversed certain non-enablement and obviousness rejections. PTX-004.00103-04. The Board denied Mr. Hyatt's request to withdraw additional rejections on rehearing. PTX-004.00024.

193. On November 18, 2005, Mr. Hyatt filed an action in this Court under 35 U.S.C. § 145, seeking issuance of a patent from the #708 application. PTX-004.00004-10.

194. The #708 application shares many delay- and burden-causing features common to Mr. Hyatt's GATT Bubble applications. For instance:

- a. Mr. Hyatt waited 12 to 16 years to present his claims. FOF ¶¶ 51, 56. The application now contains 311 claims. PTX-004.05867-963, 06389-455, 06464-65, 06866-90, 08130-39.

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- b. The application includes 576 pages of written description, 66 pages of drawings, and three earlier applications incorporated by reference. FOF ¶ 144(c).
- c. Mr. Hyatt avoided final rejections and bought time by filing a preliminary amendment that was identical to other preliminary amendments he filed in the 700 Family. DX120; DX1841.
- d. Mr. Hyatt filed at least one amendment that shifted his claims and restarted examination. FOF ¶ 131.
- e. Mr. Hyatt failed to identify written description support for his claims. FOF ¶ 154(c).

2. Application No. 08/456,398 (#717) [09-CV-1864]

195. Mr. Hyatt filed Application No. 08/456,398 (#717) on June 1, 1995. PTX-001.05255. The application is a continuation of Application Nos. 06/663,094 (#303) and 07/289,355 (#321). PTX-001.05170. The #717 application is not a divisional, FOF ¶ 74, and is not directed to a non-elected species, FOF ¶ 82(d).

196. The PTO rejected all-then pending claims on September 7, 2004. PTX-001.04025-167. The claims were rejected for lack of written

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description under 35 U.S.C. § 112, first paragraph, PTX-001.04029.

197. The Board affirmed the examiner's rejections in part and entered a new ground of rejection. PTX-001.00208-424. The Board reversed certain rejections on rehearing. PTX-001.00055-110.
198. On September 25, 2009, Mr. Hyatt filed an action in this Court under 35 U.S.C. § 145, seeking issuance of a patent from the #717 application. PTX-001.00006-10.
199. The #717 application shares many delay- and burden-causing features common to Mr. Hyatt's GATT Bubble applications. For instance:
 - a. Mr. Hyatt waited 12 to 19 years to present his claims. FOF ¶¶ 51, 56. The application now contains 350 claims. PTX-001.04268-345, 04951-81, 05011-92, 05230-54, 05907-15.
 - b. The application includes 576 pages of written description, 66 pages of drawings, and three earlier applications incorporated by reference. FOF ¶ 144(d).
 - c. Mr. Hyatt avoided final rejections and bought time by filing a preliminary amendment that was identical to other preliminary amendments he filed in the 700 Family. DX103; DX1841.

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- d. Mr. Hyatt filed at least one amendment that shifted his claims and restarted examination. FOF ¶ 132.
- e. Mr. Hyatt failed to identify written description support for his claims. FOF ¶ 154(d).

3. Application No. 08/472,062 (#524) [09-CV-1869]

200. Mr. Hyatt filed Application No. 08/472,062 (#524) on June 6, 1995. PTX-002.01223. The application is a continuation-in-part of Application Nos. 07/774,159 (#344), 06/849,243 (#310), and 07/279,592 (#319), and a continuation of Application No. 08/034,627 (#349). PTX-002.01224. The #524 application is not a divisional, FOF ¶ 73, and is not directed to a non-elected species, FOF ¶ 82(a).

201. The PTO rejected all-then pending claims on October 16, 1997. PTX-002.00953-80; *see also* PTX-002.00838-39 (Advisory Action dated April 16, 1998, finalizing the October 1997 rejections). The claims were rejected based on lack of enablement under 35 U.S.C. § 112, first paragraph, PTX-002.00958-75, lack of written description under 35 U.S.C. § 112, first paragraph, PTX-002.00958-75, and obviousness-type double patenting, PTX-002.00975-78. The examiner later withdrew some rejections, while maintaining any entered under 35 U.S.C. § 112, first paragraph. PTX-002.00472.

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202. The Board affirmed in part and reversed in part. PTX-002.00133-88. The Board withdrew one written description rejection on rehearing. PTX-002.00097.
203. On September 25, 2009, Mr. Hyatt filed an action in this Court under 35 U.S.C. § 145, seeking issuance of a patent from the #524 application. PTX-002.00007-11.
204. The #524 application shares many delay- and burden-causing features common to Mr. Hyatt's GATT Bubble applications. For instance:
 - a. Mr. Hyatt waited 20 to 22 years to present his claims. FOF ¶¶ 51, 56. The application now contains 89 claims. PTX-002.01485, 01462-66, 01180, 01140-68.
 - b. The application includes 238 pages of written description, 40 pages of drawings, and four earlier applications incorporated by reference. FOF ¶ 144(a).
 - c. Mr. Hyatt avoided final rejections and bought time by filing a preliminary amendment that was identical to other preliminary amendments he filed in the 500 Family. DX222; DX1842.
 - d. Mr. Hyatt filed at least one amendment that shifted his claims and restarted examination. FOF ¶ 126.

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e. Mr. Hyatt failed to identify written description support for his claims. FOF ¶ 154(a).

4. Application No. 08/431,639 (#601) [09-CV-1872]

205. Mr. Hyatt filed Application No. 08/431,639 (#601) on May 1, 1995. PTX-003.01379. The application is a continuation of Applications Nos. 07/279,592 (#319), 07/517,005 (#335), and 07/578,041 (#338). PTX-003.01380; Tr. Oct. 2, 2023 PM (1811:21-1812:15) (Hyatt). The #601 application is not a divisional, FOF ¶ 71, and is not directed to a non-elected species, FOF ¶ 82(b).

206. The PTO rejected all-then pending claims on May 19, 1999. PTX-003.00960-89. The claims were rejected based on lack of written description under 35 U.S.C. § 112, first paragraph, PTX-003.00963-69, and obviousness over prior art, PTX-003.00971-77.

207. The Board affirmed in part and reversed in part, placing some claims in condition for allowance. PTX-003.00292-93.

208. On September 25, 2009, Mr. Hyatt filed an action in this Court under 35 U.S.C. § 145, seeking issuance of a patent from the #601 application. PTX-003.00005-09.

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209. The #601 application shares many delay- and burden-causing features common to Mr. Hyatt's GATT Bubble applications. For instance:

- a. Mr. Hyatt waited 24 to 28 years to present his claims. FOF ¶¶ 51, 56. The application now contains 271 claims. PTX-003.00990-1115, 01170-230, 01257-305, 01314-24, 01897-939.
- b. The application includes 517 pages of written description, 46 pages of drawings, and 43 earlier applications incorporated by reference. FOF ¶ 144(b).
- c. Mr. Hyatt filed at least three amendments that shifted his claims and restarted examination. FOF ¶¶ 128-130.
- d. Mr. Hyatt failed to identify written description support for his claims. FOF ¶ 154(b).

F. PTO Conduct

210. Mr. Hyatt, through his fact witnesses, introduced significant evidence of the PTO's conduct concerning his applications. Much of this testimony was directed to issues that the Federal Circuit and this Court on remand have effectively determined are irrelevant to evaluating the PTO's prosecution laches defense. However, some of this evidence is relevant, for example, because it suggests bias on the part

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of testifying witnesses. To the extent that the Court makes findings concerning exhibits or testimony introduced at trial under the umbrella of “PTO conduct,” it is because the Court finds it relevant to the credibility of witnesses or the specific questions before it on remand. The Court has refrained from making findings where it has determined that such evidence is not relevant, material, or helpful given the scope of remand or the legal elements of laches.

1. Pre-Requirements Consolidation

211. Edward Kazenske was Deputy Assistant Commissioner of Patents from 1994 to 1997. Tr. Sept. 29, 2023 (1611:7-14, 1612:3-5) (Kazenske). At trial, he testified that he ordered group directors to stop issuing patents to Mr. Hyatt until the PTO could consolidate his applications for examination and “issues related to them could be fully coordinated and resolved.” Tr. Sept. 29, 2023 (1625:3-6) (Kazenske); *see also* Sept. 29, 2023 Tr. (1623:21-25) (Kazenske).²⁹ Mr. Kazenske explained that this consolidation was “no different than the current structure of the PTO: You form a unit around similar subject matter, and you put a group of examiners having expertise in that subject matter to examine those applications in

29. Mr. Kazenske also testified that the PTO was concerned that issuing a patent to Mr. Hyatt around that time would undermine Congress’s willingness to pass certain pending litigation. Tr. Sept. 29, 2023 (1600:20-1601:6) (Kazenske).

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that technology.” Tr. Sept. 29, 2023 (1624:3-6) (Kazenske); *see also* Sept. 29, 2023 (1602:11-20, 1604:18-25, 1624:18-1625:15) (Kazenske). Mr. Kazenske explained that without consolidation, it would have been difficult to assure examination quality and efficiency. Tr. Sept. 29, 2023 (1624:22-1625:2) (Kazenske); *see also* Tr. Sept. 29, 2023 (1624:14-17) (Kazenske).

212. Mr. Kazenske sought to place Mr. Hyatt’s applications in “a common unit” of “examiners familiar with this technology.” Tr. Sept. 29, 2023 (1624:1-9) (Kazenske). The PTO created the unit sometime in early 1997 and moved all of Mr. Hyatt’s applications to it for examination. Tr. Sept. 29, 2023 (1625:7-24, 1632:4-7) (Kazenske); *see also* Tr. Sept. 29, 2023 (1605:1-5) (Kazenske). Mr. Kazenske testified that consolidating Mr. Hyatt’s applications into one unit would “help with the efficiency” and “help with the integrity of the examination” and allow the PTO to “get a handle on all of his applications.” Tr. Sept. 29, 2023 (1624:10-17) (Kazenske); *see also* Tr. Sept. 29, 2023 (1602:11-20, 1604:18-25, 1624:18-1625:15) (Kazenske). Consolidation was not an attempt to halt the examination of Mr. Hyatt’s applications. Tr. Sept. 29, 2023 (1632:16-1633:2) (Kazenske). As Mr. Kazenske explained, his order to stop issuing patents to Mr. Hyatt “lasted only until [his] patent applications could be consolidated for further examination.” Tr. Sept. 29, 2023 (1623:21-25) (Kazenske). Indeed, examination

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continued after early 1997. *E.g.*, PTX-1799 (1999 office action).

213. Around the same time, the PTO withdrew certain of Mr. Hyatt's applications from issuance as patents. These withdrawals occurred contemporaneously with Mr. Kazenske centralizing examination of Mr. Hyatt's applications to "help with the integrity of the examination." Tr. Sept. 29, 2023 (1624:10-13) (Kazenske). The PTO has the authority to withdraw an application from issuance, including for "[u]npatentability of one or more claims." 37 C.F.R. § 1.313.

214. Mr. Hyatt's applications were later placed in the Sensitive Application Warning System ("SAWS"), which was a process by which the PTO flagged sensitive or unusual applications for review by senior personnel before they could issue as patents. PTX-1266.00001-02; PTX-1314.00001. The purpose of SAWS was to "notify upper management when there was a potentially problematic application." Tr. Sept. 28, 2023 (1419:8-18) (LeGuyader). However, SAWS-flagged applications could and often did issue as patents. Tr. Sept. 28, 2023 (1420:9-11, 1422:2-5) (LeGuyader); *see also* PTX-1266.00002; PTX-1314.00001. The SAWS program was not an attempt to halt the examination of Mr. Hyatt's applications or implement a PTO policy to never issue Mr. Hyatt another patent. *See* Tr. Sept. 28, 2023 (1422:21-1423:9) (LeGuyader) (fact witness

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failing to recall any instances where SAWS was used to prevent one of Mr. Hyatt's applications from issuing as a patent).

215. Mr. Kazenske's order, the consolidation of Mr. Hyatt's applications into a single examination unit, and the inclusion of Mr. Hyatt's applications in SAWS were direct consequences of Mr. Hyatt's prosecution conduct and were attempts by the PTO to get a handle on his applications. Although Mr. Hyatt testified that the PTO had a policy never to issue him another patent, that testimony is belied by his own fact witnesses. That the PTO has not issued Mr. Hyatt a patent since 1997 or has withdrawn a handful of allowed applications from issuance does not establish a policy never to issue Mr. Hyatt another patent. As the Court has already determined, Mr. Hyatt's applications and approach to prosecution had many unique and highly burdensome characteristics. *See* FOF ¶¶ 45-189 (describing Mr. Hyatt's GATT Bubble applications). Those characteristics largely explain the PTO's treatment of his applications.
216. Mr. Hyatt argues that Stephen Kunin's testimony is not credible because he is biased against him, as evidenced by his alleged involvement in SAWS and Mr. Kazenske's decision to stop issuing patents to Mr. Hyatt pending consolidation. Hyatt Proposal 241. However, the Court generally finds Mr. Kunin credible. His testimony is consistent

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with the file history record, and Mr. Hyatt has not persuasively substantiated his charges of bias.

2. AU 2615

217. After the Supreme Court's decision in *Kappos v. Hyatt*, 566 U.S. 431, 132 S.Ct. 1690, 182 L.Ed.2d 704 (2012), the PTO created art unit 2615 ("AU 2615") to complete examination of Mr. Hyatt's applications. PTX-141.00004; Tr. Oct. 11, 2017 AM (28:8-22) (Morse).

218. Gregory Morse became the SPE of AU 2615 in early 2013, about six months after its establishment. Tr. Oct. 10, 2017 AM (74:22-24, 75:14-19) (Morse). When Mr. Morse took over AU 2615, the 12 examiners assigned to it had already begun to write comprehensive office actions in some of Mr. Hyatt's applications. Tr. Oct. 10, 2017 AM (75:20-25) (Morse). The resulting twelve office action drafts spanned approximately 600 pages each, ranging from 500 to 1000 pages. Tr. Oct. 10, 2017 AM (75:24-76:2, 76:8-12) (Morse). Normally, office actions are about ten pages. Tr. Oct. 10, 2017 AM (76:3-7) (Morse). Each draft took approximately six months to write. Tr. Oct. 10, 2017 AM (76:13-16) (Morse). At that pace, completing examination of Mr. Hyatt's applications would have taken approximately 600 years of examiner time. Tr. Oct. 10, 2017 AM (76:17-25) (Morse). Normally, a typical examination of an entire case takes about

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20 hours of examiner time. Tr. Oct. 11, 2017 AM (30:24-31:2) (Morse).

219. The AU 2615 examiners faced numerous problems in examining Mr. Hyatt's applications, including "the number of claims, the interrelationship of the applications, . . . the range of claim priority dates, . . . the identification of written description support" and that "it was impractical to identify all of the double patenting issues." Tr. Oct. 11, 2017 AM (17:3-12) (Morse). After mailing the first set of office actions, the AU 2615 examiners began working on a second round of applications and "ran into the same issues in the second application they ran into in the first one." Tr. Oct. 10, 2017 AM (77:1-7) (Morse). The issues included that there was no "clear identification of written description support[,] . . . [t]hey had trouble identifying the priority date for each claim to appropriately apply art[,] . . . there were serious double patenting issues where the same invention was being claimed in different [applications]" and there was no discernable line of demarcation between the applications. Tr. Oct. 10, 2017 AM (77:1-15) (Morse). With those issues, there "was no way to complete examination of all of these applications within anyone's lifetime or certainly anyone's career." Tr. Oct. 11, 2017 AM (32:6-16) (Morse).

220. Mr. Hyatt's applications presented other issues as well. To "efficiently find examples of double

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patenting in Mr. Hyatt's applications," the examiners in AU 2615 used a "Microsoft Word and Excel combination, a phrase finder macro to try to find similar to identical claims." Tr. Oct. 3, 2023 PM (2083:22-2084:2) (Morse). Mr. Morse testified that "[t]hat's not something that an examiner would normally do, but it was something we had to do to try and" identify double patenting issues. Tr. Oct. 3, 2023 PM (2083:24-2084:2) (Morse). Mr. Morse also testified that Mr. Hyatt's applications presented unique issues, such as "issues related to correction of the spec[ification]" and "issues relating to written description rejections for amended claims that are atypical for most examiners." Tr. Oct. 3, 2023 PM (2084:2-7) (Morse).

221. Examiners typically work on a production system akin to a quota for the number of applications they are expected to examine in a particular period. Tr. Oct. 4, 2023 PM (2263:18-2264:17) (Morse). On the production system, examiners are assigned cases, and each case is expected to take a certain number of hours. Tr. Oct 4, 2023 PM (2264:5-6) (Morse). For example, if an examiner had 60 hours of examining time, and each case was expected to take 30 hours, they would be expected to examine two cases to achieve 100% production. Tr. Oct. 4, 2023 PM (2264:6-10) (Morse). If they examined three cases, that would be 150%, Tr. Oct. 4, 2023 PM (2264:10-11) (Morse), and if they examined one case, that would be 50%, Tr. Oct. 4, 2023

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PM (2264:11-12) (Morse). Examiners are then evaluated on the percentage of the expectancy they achieved over a fiscal year. *See* Tr. Oct. 4, 2023 PM (2264:13-17) (Morse).

222. Because of the unique characteristics of Mr. Hyatt's applications, examiners in AU 2615 are not evaluated based on their production. Tr. Oct. 4, 2023 PM (2264:18-2265:4) (Morse). In effect, Mr. Hyatt's applications are so far outside the norm that evaluating examiners who work on his applications based on their production as though they were typical examiners would not accurately reflect the work they had done. *See* Tr. Oct. 4, 2023 PM (2265:2-4) (Morse).

223. There were approximately 13 examiners in AU 2615. Tr. Oct. 4, 2023 PM (2266:1-8) (Morse). They are GS-15 examiners with yearly salaries between \$130,000 and \$180,000. Tr. Oct. 4, 2023 PM (2266:9-16) (Morse). Thirteen (13) examiners at an average salary of \$155,000 per year means that, on average, the PTO pays the examiners working on Mr. Hyatt's applications about \$2 million per year. Over the course of ten years, that totals about \$20 million that the PTO has spent examining Mr. Hyatt's applications in examiner salaries alone.

224. In Technology Center 2600, where Mr. Hyatt's cases are being examined, the average primary examiner examined approximately 78 applications

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in Fiscal Year 2012. PTX-141.00004. If Mr. Hyatt's applications were average applications, the examiners in AU 2615 would have been able to complete examination of "more than double the number of pending Hyatt applications" in a single year. PTX-141.00004. However, "[d]ue to the number of claims, the variety of continuing relationships, the complex procedural history of these applications, the number of issued patents directed to the same specifications, the apparent presence of new matter, and the unwillingness of Mr. Hyatt to identify written description support, progress [was] very slow." PTX-141.00005.

225. Due to those issues with Mr. Hyatt's applications, in ten years the examiners in AU 2615 have examined 330 of Mr. Hyatt's applications. Tr. Oct. 4, 2023 AM (2125:1-10) (Morse). At a rate of 78 applications per year, in the ten years that AU 2615 has existed a primary examiner would be expected to examine 780 applications. Tr. Oct. 4, 2023 AM (2123:16-19) (Morse). In other words, a single primary examiner would have been expected to examine more than double the number of applications that all of AU 2615 has examined in the past ten years. With 13 examiners, an art unit of primary examiners working on typical applications would be expected to examine about 10,140 applications, about 30 times the number that AU 2615 examined. Tr. Oct. 4, 2023 AM (2123:20-2124:1) (Morse). In the amount of time that the PTO estimated would have been needed

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to examine Mr. Hyatt's applications without the 2013 Requirements, the examiners in AU 2615 could have examined approximately 41,496 typical applications. DX27-000031.

226. Altogether, the experience of AU 2615 illustrates that Mr. Hyatt's conduct has significantly burdened the PTO as it has sought to examine Mr. Hyatt's applications.

227. Mr. Hyatt argues that Mr. Morse's testimony is not credible because he is biased against him, as evidenced by incidents involving AU 2615 that occurred under his supervision. For example, an examiner in the art unit created an unflattering and unprofessional "wrestler chokehold" meme depicting Mr. Hyatt, PTX-760, and circulated a news article describing Mr. Hyatt's divorce, PTX-642. However, the Court generally finds Mr. Morse credible. His testimony is consistent with the file history record, and Mr. Hyatt has not presented persuasive evidence that such incidents tainted the PTO's examination of his applications. Although the Court finds the relevant incidents inappropriate, they do not cast a negating pall over Mr. Morse's testimony. Mr. Morse testified credibly concerning the unique characteristics of Mr. Hyatt's applications and the difficulties these created for the PTO. That Mr. Morse could have better managed his team's (or his own) evident frustrations with Mr. Hyatt's applications does not obviate his testimony's truthfulness

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or general import. And Mr. Hyatt's internal recommendation that the PTO issue a patent on certain of Mr. Hyatt's claims persuasively rebuts the charge that he was biased against Mr. Hyatt and had no intention of ever issuing him another patent. *See* PTX-1364 (memo prepared by Mr. Morse identifying certain claims as allowable); Tr. Oct. 4, 2023 AM (2131:16-24) (Morse) (describing the same and noting that had the Office of Patent Legal Administration agreed, "[w]e probably would have issued the application").

3. 2013 Requirements

228. After determining in 2013 that it could not examine Mr. Hyatt's applications effectively, AU 2615 issued Requirements to "requir[e] Mr. Hyatt to help" the PTO examine his applications. Tr. Oct. 11, 2017 AM (33:1-3) (Morse). The goal of the Requirements was "to allow effective examination" and "to narrow the issues that were in front of [the PTO] to get anywhere." Tr. Oct. 11, 2017 AM (33:4-9) (Morse). The Requirements provided an overview of issues with Mr. Hyatt's applications, including the large number of applications and claims, extended and complicated priority chains, and the lack of written description support. *E.g.*, DX27-000004-05. The Requirements concluded that the PTO "has been unable to efficiently examine these applications" and "develop a clear prosecution record that adequately notifies the public as

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to [Mr. Hyatt's] invention." DX27-000005. Accordingly, the Requirements further concluded that "it does not appear that the USPTO's expense and effort in writing actions on every claim presented is leading to identification of either patentable subject matter or specific and focused issues in dispute." DX27-000005.

229. The Requirements detailed the applications to which they applied and generally addressed applications that "share a common specification." *E.g.*, DX27-000005-07. The Requirements all followed a similar structure, describing the challenges created by Mr. Hyatt's applications, including complex priority chains, unusually lengthy specifications, the proliferation of claims, and the proliferation of duplicate and patentably indistinct claims. *See generally* DX200 (360 Family); DX69 (370 Family); DX46 (410 Family); DX27 (450 Family); DX179 (500 Family); DX158 (550 Family); DX140 (600 Family); DX129 (650 Family); DX144 (700 Family); DX75 (800 Family); DX196 (850 Family). The Requirements required Mr. Hyatt to take steps to further examination, including (1) selecting a reasonable number of claims for examination, with no more than 600 total claims selected per family, *e.g.*, DX27-000033-34; (2) identifying the earliest priority date for each selected claim and where the claimed embodiment appears in the priority applications, *e.g.*, DX27-000034-35; and (3)

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providing a complete copy of the claims in each application, *e.g.*, DX27-000035-36.

230. The PTO issued the 2013 Requirements in response to Mr. Hyatt's unique and highly burdensome prosecution conduct; they were an attempt by the PTO to get examination back on track. Although Mr. Hyatt testified that the Requirements were error-ridden, the file history record belies his testimony. Indeed, there is ample record support for the Requirements' characterization of Mr. Hyatt's applications. The Court finds that the Requirements were generally accurate and fairly described Mr. Hyatt's applications as of when they were issued. The Court only wishes the PTO had issued them sooner. *See Hyatt I*, 332 F. Supp. 3d at 133 (criticizing the PTO not earlier recognizing that "Mr. Hyatt's GATT Bubble applications required it to employ and embrace atypical procedures for addressing the challenge before them").

231. After the Requirements, Mr. Hyatt filed amendments that rewrote his claims, shifted his claimed inventions, and effectively restarted examination. FOF ¶¶ 135-142. These amendments were particularly burdensome because they required the PTO to redo its double patenting analysis. *See* Tr. Oct. 11, 2017 AM (71:4-12) (Morse); Tr. Oct. 4, 2023 PM (2233:24-2235:23) (Morse). Mr. Hyatt also entered at least some post-Requirements amendments without identifying

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written description support for his newly amended claims. FOF ¶ 157. Although the PTO labeled many of his amendments “bona fide,” this indicates that Mr. Hyatt had made “a reasonable attempt to respond to what was required” by the PTO, something “good enough” to continue prosecution. Tr. Oct. 4, 2023 PM (2247:21-2248:11) (Morse). It did not constitute an endorsement of Mr. Hyatt’s practice of filing amendments that rewrote his claims and restarted examination. *See* Tr. Oct. 4, 2023 PM (2248:13-18) (Morse).

4. Continued PTO Examination After Board Decisions

232. Mr. Hyatt testified that the PTO “recycled” his applications by reopening examination after the Board reversed the examiners’ rejections. Tr. Sept. 20, 2023 PM Tr. (426:20-427:23) (Hyatt). Mr. Hyatt’s testimony consisted of his recollection of a meeting with Technology Center Director Andrew Christensen. PTX-54.00001. According to Mr. Hyatt, Mr. Christensen told him that the PTO would “recycle” his applications if he prevailed before the Board. Tr. Sept. 20, 2023 PM (427:4-6) (Hyatt). The Court does not credit Mr. Hyatt’s testimony that Mr. Christensen himself characterized the PTO as having a “recycling” policy. It is clear on the face of Mr. Hyatt’s meeting conference record that Mr. Hyatt, not Mr. Christensen, used the “recycling” label, which for Mr. Hyatt is a pejorative term. PTX-54.00001.

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Mr. Christensen apparently “confirmed” that the PTO had reopened prosecution of two of Mr. Hyatt’s applications after reversals by the Board. PTX-54.00001. However, it does not follow that Mr. Christensen used the “recycling” label, characterized it as problematic, or stated that the PTO had a policy of reopening prosecution every time Mr. Hyatt prevailed before the Board, regardless of whether such action was merited. *See* PTX-54.00001.

233. Indeed, when the PTO reopened prosecution of applications after reversals by the Board, it did so to ensure the patentability of Mr. Hyatt’s claimed inventions. For example, the PTO reopened prosecution of Application No. 07/289,355 (#321) after the Board issued a decision in which it reversed the examiner’s rejections, PTX-1046.17994-8035, but left “it to the examiner to decide whether to make an anticipation rejection based on” a prior art reference, PTX-1046.18022 n.2. Additionally, one of the concurring patent judges observed that certain claims limitations had written description issues. PTX-1046.18025, 18030-32. The PTO reopened prosecution and mailed an office action entering additional rejections under MPEP § 1214.04, which permits the examiner to reopen prosecution and enter a new rejection after obtaining group director approval. MPEP § 1214.04; PTX-1046.17990 (showing the examiner obtained group director approval); *see also* 37 C.F.R. § 1.198; MPEP

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§ 1002.02(c). In other words, the PTO reopened prosecution not because it intended to delay the examination or issuance of Mr. Hyatt's application but because it needed to consider other possible grounds for rejection identified by the Board. Reopening prosecution furthered the PTO's goal of issuing valid patents.

5. Suspension Period

234. Between approximately 2003 and 2012, the PTO largely suspended examination of Mr. Hyatt's applications. PTX-009; *see also* Tr. Oct. 11, 2017 PM (46:19-47:2) (Morse). The PTO sent Mr. Hyatt documents that explained the suspensions by reference to pending court decisions. *E.g.*, PTX-003.00050; *see also* PTX-009 (identifying where suspension-related communications appear in the file history record). During this period, Mr. Hyatt had three significant cases moving through the courts: *Dudas I*, 492 F.3d 1365; *Hyatt v. Dudas (Dudas II)*, 551 F.3d 1307 (Fed. Cir. 2008); and *Kappos*, 566 U.S. 431, 132 S.Ct. 1690. These cases had the potential to affect the PTO's handling of his applications. *See generally* Tr. Oct. 11, 2017 AM (17:23-26:17) (Morse).

235. In at least some Section 145 cases filed in this District, Mr. Hyatt represented that he was taking steps with the PTO to stay examination of related applications. *E.g.*, *Hyatt v. Dudas*, No. 04-cv-1138 (HHK), Compl. ¶ 9, ECF No. 4 (D.D.C.

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July 1, 2004). However, during the suspension period, Mr. Hyatt filed more than 1000 petitions seeking action on his applications or updates concerning their status. PTX-10 (2005 petitions); PTX-37 (example 2005 petition for action on the merits); PTX-12 (2007 petitions); PTX-36 (example 2007 petition for action on the merits); PTX-13 (requests for status updates). Thus, Mr. Hyatt largely opposed the PTO's decision to broadly stay his applications and sought to have the stays lifted.

G. Public Availability of Specifications

236. Certain of Mr. Hyatt's specifications—identical to the specifications of his GATT Bubble applications—have been publicly available for years or decades.
237. The 360 Family claims priority to a patent whose specification has been publicly available for over 38 years. PTX-1830.0003 (claiming priority to Application No. 05/844,765 (#143), which issued as Patent No. 4,523,290); DX268-000001 (showing that Patent No. 4,523,290 issued on June 11, 1985, meaning the specification of that patent has been publicly available since that date). That patent expired in 2002.
238. The 370 Family claims priority to a patent whose specification has been publicly available for over 47 years. PTX-1831.0003 (claiming priority to

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Application No. 05/366,714 (#118), which issued as Patent No. 3,986,022; DX268-000001 (showing that Patent No. 3,986,022 issued on October 12, 1976, meaning the specification of that patent has been publicly available since that date). That patent expired in 1993.

239. The 410 Family claims priority to a patent whose specification has been publicly available for over 43 years. PTX-1832.0003 (claiming priority to Application No. 05/550,231 (#128), which issued as Patent No. 4,209,843; DX268-000001 (showing that Patent No. 4,209,843 issued on June 24, 1980, meaning the specification of that patent has been publicly available since that date). That patent expired in 1997.

240. The 500 Family claims priority to a patent whose specification has been publicly available for over 27 years. PTX-1834.0003 (claiming priority to Application No. 08/034,627 (#349), which issued as Patent No. 5,584,032; DX268-000003 (showing that Patent No. 5,584,032 issued on December 10, 1996, meaning the specification of that patent has been publicly available since that date). That patent expired in 2013.

241. The 550 Family claims priority to a patent whose specification has been publicly available for over 35 years. PTX-1835.0003 (claiming priority to Application No. 05/402,520 (#122), which issued as Patent No. 4,825,364; DX268-000001 (showing

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that Patent No. 4,825,364 issued on April 25, 1989, meaning the specification of that patent has been publicly available since that date). That patent expired in 2006.

242. The 600 Family claims priority to a patent whose specification has been publicly available for over 28 years. PTX-1836.0003 (claiming priority to Application No. 07/279,592 (#319), which issued as Patent No. 5,459,846); DX268-000002 (showing that Patent No. 5,459,846 issued on October 17, 1995, meaning the specification of that patent has been publicly available since that date). That patent expired in 2012.

243. The 650 Family claims priority to a patent whose specification has been publicly available for over 47 years. PTX-1837.0003 (claiming priority to Application No. 05/366,714 (#118), which issued as Patent No. 3,986,022); DX268-000001 (showing that Patent No. 3,986,022 issued on October 12, 1976, meaning the specification of that patent has been publicly available since that date). That patent expired in 1993.

244. The 800 Family claims priority to a patent whose specification has been publicly available for over 47 years. PTX-1839.0003 (claiming priority to Application No. 05/366,714 (#118), which issued as Patent No. 3,986,022); DX268-000001 (showing that Patent No. 3,986,022 issued on October 12, 1976, meaning the specification of that patent

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has been publicly available since that date). That patent expired in 1993.

245. Mr. Hyatt tailored the claims of his applications to cover emerging technologies. DX241-000033-34 (in response to the defendant's interrogatory as to "why [he] maintain[s] that rewriting [his] claims to cover a different invention was not unreasonable," Mr. Hyatt responded that "in the decades in which the PTO delayed the issuance of patents on these applications, the technology changed and Plaintiff amended the claims to focus on other inventive features").

H. Gilbert P. Hyatt Testimony

246. Mr. Hyatt's testimony is not credible in important respects. The Court has noted several instances where it found Mr. Hyatt's testimony not credible, inconsistent with the file history record, inconsistent with other witness testimony, or contradicted by Mr. Hyatt's prior statements or actions. FOF ¶¶ 16, 27, 35-38, 41-42, 58, 81, 88, 102-106, 113, 116-122, 152, 177, 189, 232. It has also made several broad swaths of factual findings, grounded in the file history record and other witness testimony, that directly contradict critical aspects of his testimony or reflect the Court's adverse assessment of his credibility. *See, e.g.*, FOF ¶¶ 18-39 (ancestor restriction finality and alignment with number of GATT Bubble applications), 58-83 (whether Mr. Hyatt's

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GATT Bubble applications are divisionals filed in response to restriction requirements), 99-107 (Director Godici meeting), 111-121 (complex priority claims), 122-142 (claim shifting), 150-152 (large number of claims), 153-159 (failure to identify written description support), 108-110 (plan to demarcate), 160-168 (failure to demarcate), 174-180 (*Boone* interference count).

247. Even setting aside inconsistencies with the file history record and other witness testimony, Mr. Hyatt undermined his credibility with the Court through his general demeanor and answers to certain questions. *E.g.*, Tr. Sept. 25, 2023 (905:13-907:7, 929:10-25) (Hyatt); Tr. Sept. 28, 2023 (1463:11-1466:25) (Hyatt). Although the Court appreciates the strain imposed by testifying over many days, Mr. Hyatt's testimony often exhibited unhelpful evasiveness, as well as occasional bouts of hyperbole and exaggeration. Given that Mr. Hyatt's other witnesses largely did not exhibit these issues, and much of Mr. Hyatt's testimony is in direct tension with the file history record or directed to matters outside his knowledge or control, the Court is confident that its credibility determinations and assessments of the evidence give Mr. Hyatt his fair due. The Court has treated his testimony with the utmost respect and seriousness. However, the Court cannot credit it at the expense of ignoring the entire record.

IV. CONCLUSIONS OF LAW

The Court's conclusions of law apply the analytical structure of *Hyatt II*. See 998 F.3d at 1366-1371. The Court begins by analyzing whether Mr. Hyatt unreasonably and inexplicably delayed prosecuting his GATT Bubble applications. The Court starts with Mr. Hyatt's pre-filing delay, which it finds inexcusable and of sufficient magnitude to trigger a presumption of intervening rights, before turning to Mr. Hyatt's post-filing prosecution conduct, which the Court finds constituted a clear abuse of the patent examination system. The Court then addresses both forms of prejudice, finding that Mr. Hyatt has failed to rebut the presumption of intervening rights and that the Court's conclusions regarding "clear abuse" establish that Mr. Hyatt materially prejudiced the PTO. The Court analyzes Mr. Hyatt's burdens of persuasion as they arise in context, concluding that Mr. Hyatt has failed to meet each of them.

A. Unreasonable and Inexcusable Delay

The Court considers Mr. Hyatt's pre-filing delay separately from his post-filing prosecution conduct because finding in the PTO's favor on either issue will have distinct implications for prejudice. See *id.* at 1369-70. The former triggers a presumption of intervening rights. *Id.* at 1370. The latter, if it amounts to a clear abuse of the patent examination system, "can alone suffice to prove prejudice." *Id.*

*Appendix B***1. Pre-Filing Delay**

The Court found that Mr. Hyatt delayed filing his GATT Bubble applications for 12 to 26 years. FOF ¶ 51. Even if the Court were to credit his claimed priority dates, that would mean he delayed filing for 6 to 24 years, or 11 to 24 years, excluding the applications in his 600 Family. *Id.* Mr. Hyatt further delayed by amending his applications late in prosecution to present new claims for examination. FOF ¶ 56. For instance, in certain of his applications, Mr. Hyatt delayed 46 years before presenting new claims through amendments. *Id.* Even crediting his claimed priority dates in those cases, he delayed presenting new claims for 32 to 44 years. *Id.*

“[T]hese quantities of time are enough to trigger prosecution laches” and raise a presumption of intervening rights. *Hyatt II*, 998 F.3d at 1368, 1370. The only remaining question is whether Mr. Hyatt has sufficiently rehabilitated the record that was before the Federal Circuit in *Hyatt II* and, as a result, established “a legitimate, affirmative reason for his delay.” *Id.* at 1371-72. The Court concludes that he has not, and therefore, has failed to meet one of his burdens on remand.

Mr. Hyatt principally advanced two arguments during the 2023 phase of trial that his pre-filing delay was justified. First, he argued that he prosecuted his applications in a manner consistent with then-prevailing serial prosecution norms. *See Hyatt Proposal 247*. Second, he argued that his GATT Bubble applications were divisional applications filed in response to restriction requirements issued in

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his ancestor applications. *See* Hyatt Proposal 267. Both arguments are legally and factually untenable.

i. Serial Prosecution Norms

A common practice when Mr. Hyatt filed his ancestor applications was for applicants to pursue continuing applications serially. FOF ¶ 13. Under this serial prosecution norm, even if the applicant knew they needed to file dozens of continuing applications that claimed priority to a single parent, they would file their continuing applications serially, one at a time, so they never had more than one pending child application. FOF ¶ 14. Once that child application neared allowance, abandonment, or termination, the applicant would file a second child application and conclude prosecution on the first. *Id.* They would then prosecute the second child application until it neared allowance, abandonment, or termination, and then file the third. And so on.

Mr. Hyatt contends that he filed his applications serially until the GATT transition forced him to simultaneously file hundreds of applications to cover his remaining unprotected inventions. FOF ¶ 14. Mr. Hyatt's position seems to be that complying with the serial prosecution norm during the pre-GATT period justifies any resulting delay in presenting his GATT Bubble applications for examination, mainly because he alleges the PTO was unwilling to engage in parallel examination—simultaneous examination of multiple co-pending child applications—during the pre-GATT

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period. *Id.* Put differently, Mr. Hyatt claims that filing his applications earlier would have been futile.

As a factual matter, it is doubtful that a serial prosecution norm or PTO policy constrained Mr. Hyatt from filing his GATT Bubble applications earlier. As this Court has observed, Mr. Hyatt specifically argued to the Board in 2020 that he had prosecuted many of his applications in parallel during the pre-GATT period; he lodged this position to rebut the charge that he had delayed filing his applications. FOF ¶ 16. The record confirms that Mr. Hyatt prosecuted many of his ancestor applications in parallel. FOF ¶ 17. These facts severely undermine his argument that the PTO or then-prevailing norms *compelled* him to prosecute his applications serially. At best, his serial prosecution practice was consistent with what other patent applicants commonly were doing at the time. That falls far short of justifying decades of resulting delay. *See Personalized Media*, 57 F.4th at 1354. And it says nothing about Mr. Hyatt's delay in belatedly presenting new claims through post-filing amendments.

More to the point, regardless of then-prevailing prosecution norms, it was facially unreasonable for Mr. Hyatt to serially prosecute the number of applications he believed he was entitled to file based on the number of inventions disclosed in his specifications. *See Hyatt II*, 998 F.3d at 1366, 1369. Mr. Hyatt gave the specific example of the 700 Family, in which he filed 100 GATT Bubble applications because he had counted 100 inventions in that family's specification. FOF ¶ 14. As this Court found, the necessary implication of Mr. Hyatt's articulation of the

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serial prosecution norm is that he would have prosecuted each of the 100 applications in his 700 Family serially had the GATT transition not occurred. *Id.* Assuming it would have taken two years to prosecute each child application serially, it would have taken Mr. Hyatt 200 years to complete prosecuting all the inventions disclosed in that family. *Id.* Put another way, Mr. Hyatt apparently believed that, but for the GATT transition, he and his successors-in-interest reasonably could have presented claims for examination nearly two centuries after he originally disclosed them. *Id.* No inventor could have reasonably believed that then-prevailing prosecution norms entitled them to a de facto monopoly on inventive technology limited only by the number of successive continuing applications they could plausibly justify given their specification's length and complexity. Such a belief is nakedly at odds with the beneficent aims of the patent system.

Moreover, if Mr. Hyatt is correct that serial prosecution was the then-prevailing norm and that abiding by contemporary prosecution norms suffices to excuse pre-filing delay, then it is hard to imagine how dilatory pre-GATT serial prosecution practices could *ever* trigger prosecution laches. That is obviously in tension with the Federal Circuit's decisions in *Symbol II* and *Bogese*, which confirmed that at least some lawful pre-GATT serial continuation chains—i.e., even those conforming to legal norms—could trigger prosecution laches. *See Symbol Techs., Inc. v. Lemelson Med., Educ. & Rsch. Found. (Symbol II)*, 422 F.3d 1378, 1386 (Fed. Cir. 2005); *Bogese*, 303 F.3d at 1369; *see also Hyatt II*, 998 F.3d at 1366, 1369.

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Furthermore, the Federal Circuit has taken pains to distinguish reasonable from unreasonable dilatory prosecution practices. *See Hyatt II*, 998 F.3d at 1361-62 (citing *Symbol II*, 422 F.3d at 1385) (enumerating examples). The Federal Circuit's careful circumscription of these categories makes no sense if all it takes to excuse pre-filing delay is to have conformed to a common practice or prevailing prosecution norm. *See id.* Indeed, the Federal Circuit's analysis does not even reference prevailing norms. *Id.* Thus, even if Mr. Hyatt is correct that many other applicants delayed the presentation of their claims during the ancestor period, that, standing alone, does nothing to excuse his delays or justify his prosecution conduct. Mr. Hyatt must go further and affirmatively show that *his* dilatory conduct was reasonable—for example, by proving that he filed divisional applications in response to restriction arguments. *See id.* As detailed *infra*, Part IV.A.1.ii, the facts fail to support Mr. Hyatt's only meaningful attempt to make that showing.

Finally, Mr. Hyatt's argument that he delayed his GATT Bubble applications because he was prosecuting them serially ultimately reduces to the contention, already rejected by the Federal Circuit, that his pre-filing delay was justified because he filed his applications to protect the number of inventions he believed he had made. *See id.* at 1371. The Court understands Mr. Hyatt's explanation for his delay to be that he had a certain number of inventions he needed to protect and that the serial prosecution norm required (or justified) serializing the filing of applications to protect those inventions. FOF ¶ 14. Because Mr. Hyatt had many inventions to protect,

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by the time the GATT transition rolled around, he still had many more applications to file—these became his GATT Bubble applications. In other words, Mr. Hyatt’s beliefs concerning how many inventions he had made are part and parcel of his norm-based justification for his pre-filing delay.³⁰ But the Federal Circuit has already made itself clear—the number of inventions Mr. Hyatt believed he had made *cannot* justify his delay. *Hyatt II*, 998 F.3d at 1371.

ii. Divisional Applications

Recall the Court’s observation that the Federal Circuit has already developed examples of reasonable and unreasonable pre-filing delay. *See supra* Part IV.A.1.i. One example of reasonable pre-filing delay is “filing a divisional application in response to a restriction requirement, even if the filing occurs immediately before issuance of the parent application.” *Hyatt II*, 998 F.3d at 1361-62 (citing *Symbol II*, 422 F.3d at 1385). At trial, Mr. Hyatt attempted to justify his pre-filing delay by arguing that his GATT Bubble applications were divisional applications filed in response to restriction requirements in his ancestor applications. FOF ¶ 18. The Court’s factual findings, however, entirely foreclose this argument.

30. Consider the scenario where Mr. Hyatt believed he had only disclosed a handful of inventions. Even with serial prosecution, it is hard to imagine Mr. Hyatt having any remaining applications to file by the time of the GATT transition. Mr. Hyatt’s argument only works by combining the number of inventions he believed he had made with the alleged requirement or norm that he prosecute them serially.

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As this Court found, when Mr. Hyatt filed his GATT Bubble applications, it was generally understood that the terms “continuation,” “continuation-in-part,” and “divisional” referred to distinct application types. FOF ¶ 65. Although these application types are immaterial to rights under 35 U.S.C. § 120, they claim different things and are used in different contexts. *Id.* Quite revealingly, Mr. Hyatt’s applications self-identify as continuations, continuations-in-part, or “continuing applications” but never as divisionals. FOF ¶¶ 70-75. Mr. Hyatt’s applications in suit are not directed to non-elected species from his ancestor applications, as would be expected if his applications were, in fact, divisionals. FOF ¶ 82. Mr. Hyatt’s difficulties preparing preliminary amendments indicate that his GATT Bubble applications are not divisionals. FOF ¶ 80. And Mr. Hyatt has consistently represented to this Court and the Federal Circuit that his applications are continuations. FOF ¶ 77; *see also* FOF ¶¶ 78-79. Thus, Mr. Hyatt’s GATT Bubble applications are not divisionals.

Moreover, if Mr. Hyatt really filed his GATT Bubble applications as divisionals directed to non-elected species, then the number of applications he filed should correspond to the number of restricted species in his ancestor applications. However, the number of applications he filed (approximately 400) and the number of non-elected restricted species (157) are incommensurable, which fatally undermines his argument. FOF ¶ 31. Mr. Hyatt’s only explanation for this incommensurability is that he filed many more applications than he had restricted species because he also wanted to cover unclaimed inventions and

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because he anticipated receiving additional restrictions. FOF ¶¶ 37-38. But that gives up the game; it confirms that Mr. Hyatt filed his GATT Bubble applications for purposes significantly broader than claiming restricted species—namely, to pursue new claims, as in continuation and continuation-in-part applications, and to get ahead of possible adverse office actions. In any event, the Court did not credit these shifting explanations and found that Mr. Hyatt filed his GATT Bubble applications based on the number of inventions he believed he disclosed, regardless of whether they were restricted. FOF ¶ 39. Mr. Hyatt’s prosecution approach flatly contradicts his claim that he filed divisionals.

Perhaps seeing the writing on the wall, Mr. Hyatt argues in his reply brief that the specific label used in his applications, and by implication, their incommensurability with and lack of conformance to his restricted species, is immaterial. *See* Hyatt Reply 75-76.³¹ All that matters is that Mr. Hyatt had restriction requirements in his ancestor applications and filed GATT Bubble applications in response. He claims that this brings his applications

31. Mr. Hyatt also stated in his reply brief that the “PTO simply contends that [Mr.] Hyatt’s transitional applications are not divisionals, without any indication of why that would matter in the laches analysis.” Hyatt Reply 76. Mr. Hyatt introduced this issue to the Court. Mr. Hyatt dedicated a substantial portion of his case-in-chief to arguing that his applications were divisionals. The Court has understood all along that this argument is important because it goes to whether Mr. Hyatt’s applications fall under the Federal Circuit’s divisional-based example of reasonable delay. To disclaim this argument now, as though it did not originate with Mr. Hyatt, is stunning.

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within the spirit, if not the letter of the Federal Circuit's examples of reasonable delay. But the "divisional" label matters, given that the Federal Circuit used it, and Mr. Hyatt's applications hardly fit within the definition of divisional applications or the Circuit's other examples of reasonable delay. *See Hyatt II*, 998 F.3d at 1361-62; *see also* MPEP § 201.06. In any event, it is hard to see how Mr. Hyatt's ancestor restrictions on their own could explain his delay, as virtually all of them became final well before 1995, meaning he could have filed his continuing applications much earlier than he did. FOF ¶¶ 19-28.

* * *

Mr. Hyatt's other arguments concerning his pre-filing delay are either unsupported by the Court's factual findings or insufficient to justify or excuse his delay. Accordingly, the Court concludes that Mr. Hyatt delayed filing his GATT Bubble applications by a magnitude of time sufficient to trigger prosecution laches, *see Hyatt II*, 998 F.3d at 1368, and has failed to meet his burden of excusing or justifying his delay, *see id.* at 1371-72. Under the prejudice prong of prosecution laches, Mr. Hyatt bears the burden of disproving intervening rights. *Id.* at 1370.

2. Post-Filing Prosecution Conduct

After considering the totality of the circumstances with a focus on Mr. Hyatt's conduct, the Court concludes, consistent with the standard announced in *Hyatt II*, that Mr. Hyatt engaged in a clear abuse of the patent examination system. *See id.* at 1369.

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Mr. Hyatt has failed to meet his burden on remand of justifying (a) his decision to ignore Director Godici's instruction to demarcate his applications in 1995, (b) his decision to adopt the specific prosecution approach that he did, and (c) his failure to develop a plan for demarcating his applications. *See id.* at 1372. Mr. Hyatt has not persuasively rebutted the PTO's evidence establishing the nature and consequence of his actions or omissions. He has not introduced evidence of PTO conduct that adequately explains or justifies *his* conduct or establishes that prejudice to the PTO is traceable to its independent decision-making. And, even on a complete record, the Court is persuaded that Mr. Hyatt "adopted an approach to prosecution that all but guaranteed indefinite prosecution delay." *Id.* at 1368.

The Court will begin with Mr. Hyatt's 1995 meeting with Director Godici and proceed through each aspect of Mr. Hyatt's post-filing prosecution conduct that the Federal Circuit thought significant in *Hyatt II*. *See id.* at 1368-69. The Court will also address the sufficiency of Mr. Hyatt's proffered justifications for his conduct and his strained attempts at absolution from the burden he placed on the PTO.

i. Director Godici Meeting

The Federal Circuit held that Mr. Hyatt must "justify [his] decision to ignore Director Godici's instruction to demarcate his applications in 1995." *Id.* at 1372. Mr. Hyatt did not attempt to justify his decision to ignore Director Godici. Instead, he argued that the PTO misconstrued

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his 1995 meeting with the Director and that he followed all his instructions. *See* Hyatt Proposal 97-99. Mr. Hyatt’s argument can only succeed if the Court credits his testimony concerning his meeting with Director Godici over his contemporaneous written record of it. *See* FOF ¶ 99.

According to his testimony, Mr. Hyatt entered an agreement with Director Godici that required him to focus his claims but permitted him to claim multiple inventions in a single application. FOF ¶ 101. According to his written record, Mr. Hyatt entered an agreement that required him to focus his claims “on a different invention in each application.” FOF ¶ 100. The Court has already resolved this credibility-driven fact dispute, finding, contrary to Mr. Hyatt’s testimony, that he promised Director Godici that he would focus each GATT Bubble application on a distinct (i.e., singular) invention. FOF ¶ 102; *see also* FOF ¶¶ 103-107. There is no question that Mr. Hyatt claims more than one invention per application. FOF ¶ 160. Thus, Mr. Hyatt ignored Director Godici’s instructions. *Id.*; *see also* FOF ¶¶ 161, 168. Mr. Hyatt has not offered any other justification or explanation for his decision to ignore Director Godici, and the Court can discern none from the record. Mr. Hyatt has failed to meet another of his burdens on remand. *See Hyatt II*, 998 F.3d at 1372.

ii. Specific Prosecution Approach

The Federal Circuit further held that Mr. Hyatt must “justify his decision to adopt the specific prosecution approach that he did—unique in its scope and nature—as

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detailed in the PTO's Requirements." *Id.* at 1372. The Court will address the characteristics of Mr. Hyatt's applications and prosecution approach that the Federal Circuit specifically discussed in *Hyatt II*. For instance, his complex priority claims, *id.* at 1368, lengthy specifications, *id.*, amendment practice, *id.*, and specific exemplary actions such as filing claims he had previously lost in an interference proceeding, *id.* at 1368-69. The Court will address some related issues as well.

a. Complex Priority Claims

Mr. Hyatt's GATT Bubble applications claim priority to a large number of ancestor applications and a broad range of priority dates. FOF ¶ 111. Mr. Hyatt's applications substantially overlap in their priority claims, which is well illustrated by the evidence adduced by the PTO at trial and which Mr. Hyatt has failed to persuasively rebut. FOF ¶¶ 112-113. Indeed, the Court found Mr. Hyatt's testimony concerning his priority claims—and his heated attacks on the PTO's evidence—largely incredible. FOF ¶¶ 113, 116-121.

As a consequence of Mr. Hyatt's complex priority claims, examiners had "trouble identifying the priority date for each claim to appropriately apply art." FOF ¶ 115. The wide range of Mr. Hyatt's priority date claims exacerbated these issues because even relatively small changes in the applicable priority date can cause significant changes in the relevant prior art. *Id.* Examiners further faced issues identifying written description support for Mr. Hyatt's claims and, in some cases, searched dozens of

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ancestor applications for written description support. *Id.* Mr. Hyatt's priority claims, combined with other aspects of his prosecution conduct, made it "extremely difficult" for the PTO to examine his applications. *Id.*; *see also* FOF ¶ 121.

Through his testimony, Mr. Hyatt lodged several responses and objections to the PTO's evidence concerning his priority claims. The Court has made factual findings adverse to each of his arguments. FOF ¶¶ 113-121. Besides lacking evidentiary support, Mr. Hyatt's arguments fall short because they attempt to shift the Court's focus from his priority *claims* to his priority date *entitlements*. FOF ¶ 114. The Court has already found that the complexity of Mr. Hyatt's priority claims burdened examination. FOF ¶ 115. The simplicity of his alleged priority entitlements does not mitigate that fact. *Id.* Mr. Hyatt's examples where examiners were ultimately able to determine priority dates do not mean that parsing his priority claims, reviewing his ancestor applications, and making the determinations was trivial. *Id.* The record amply confirms that Mr. Hyatt's complex priority claims drove examiners to undertake onerous searches for prior art and written description support. *Id.*

Thus, as should be apparent from the Court's findings of fact, Mr. Hyatt has not persuasively rebutted the PTO's evidence that his applications contained complex, overlapping priority claims that significantly burdened examination.

*Appendix B***b. Specification Length**

Mr. Hyatt's GATT Bubble applications contained lengthy, complex specifications and incorporated upwards of dozens of earlier applications by reference. FOF ¶¶ 144, 146. All of Mr. Hyatt's co-pending applications in a given application family share the same lengthy specification. FOF ¶ 145.

As a consequence of Mr. Hyatt's complex and lengthy specifications, it was more difficult for examiners to identify written description support for Mr. Hyatt's claims. FOF ¶ 147. For example, it was difficult for examiners to identify support for claimed interconnections of claim elements. *Id.* These difficulties were particularly acute during the pre-digital era because examiners had to wade through massive stacks of paper and could not conduct digital searches or double-patenting analyses. *Id.* Mr. Hyatt worsened the burden on the PTO by going many years without identifying written description support for his claims, despite his duty of candor and good faith requiring him to do so. FOF ¶¶ 153-156. Even after the 2013 Requirements, Mr. Hyatt provided only questionable assistance to the PTO. FOF ¶ 157. This Court has direct experience identifying written description support for Mr. Hyatt's claims and is well aware of its complexity and onerousness. FOF ¶ 159. Mr. Hyatt's proffered reasons for his complex specifications are not sufficient to "operate to excuse [him] from responsibility for the sizable undue administrative burden that his applications have placed on the PTO." *See Hyatt II*, 998 F.3d at 1372.

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Additionally, although Mr. Hyatt has successfully prosecuted applications with lengthy specifications to issuance, at that time he never had the number of claims and complex co-pending applications he has now. FOF ¶ 149, 169-173. Thus, the Court is not persuaded that Mr. Hyatt's past success in prosecuting applications with complex specifications indicates the reasonableness of his conduct; if anything, it indicates how unreasonable his prosecution approach became after the GATT Bubble. *Cf. Personalized Media*, 57 F.4th at 1356.

c. Claim Amendments

Mr. Hyatt's claim amendment practice has been highly unusual and burdensome on the PTO. In addition to filing identical preliminary amendments across his applications shortly after the GATT transition to delay examination, FOF ¶¶ 91-96, Mr. Hyatt routinely filed amendments that dramatically escalated his number of claims, FOF ¶¶ 150-152, entirely rewrote existing claims, FOF ¶¶ 122-142, and shifted existing claims to new inventions, *id.* This conduct had broad ramifications for the PTO's ability to examine Mr. Hyatt's applications.

Shortly after the GATT transition, the PTO began examining Mr. Hyatt's applications based on their claimed priority dates. FOF ¶ 92. Mr. Hyatt's applications were indistinguishable from the ancestor applications they copied, so the PTO began rejecting them. FOF ¶ 91. Mr. Hyatt responded by filing identical preliminary amendments to stay off rejections. FOF ¶ 93-95. However, Mr. Hyatt did not intend for the PTO to examine his

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amended claim sets. FOF ¶ 96. Instead, he amended his applications to avoid final rejections and buy time to prepare additional preliminary amendments that would introduce the claims he actually wanted examined. *Id.* It was unreasonable for Mr. Hyatt to intentionally delay the examination of his applications in order to overcome a crisis of his own making—his failure to create a reasonable plan or organized approach for focusing his GATT Bubble applications after filing. FOF ¶¶ 108-110.

Then, after Mr. Hyatt began filing amendments directed to examinable claims, he dramatically escalated the total number of claims in his GATT Bubble applications to more than 117,000. FOF ¶ 150. That yielded an average of 121 independent claims and 303.5 total claims per application, placing Mr. Hyatt's GATT Bubble applications, on average, in the top 0.02% of applications filed between 1995 and 2013 by claim count. *Id.* This extremely unusual proliferation of claims made double patenting analysis impracticable, *id.*, which was especially problematic for the PTO because so many of Mr. Hyatt's claims were duplicates or patentably indistinct. FOF ¶ 161. Mr. Hyatt's explanations for his claim escalation are not credible. FOF ¶¶ 151-152. Even if his explanations were credible, they would be legally insufficient to excuse his conduct because they reflect little more than his desire to avoid prior art. *See Hyatt II*, 998 F.3d at 1369. Mr. Hyatt's other attempts at justifying his claim count—for example, noting that many of his claims are dependent claims—still render his applications extreme outliers. FOF ¶ 152.

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Mr. Hyatt also entirely rewrote claims midway through examination or shifted them to claim new inventions. FOF ¶¶ 122-142. This practice, before and after the Requirements, forced the PTO to perform new written description analyses, double patenting analyses, and prior art searches. FOF ¶ 122. Mr. Hyatt disputed that his amendments shifted his claims to new inventions. *Id.* However, the Court has reviewed the exemplary amendments discussed by the parties and found that Mr. Hyatt shifted his claims in nearly all of them. *Id.*; *see also* FOF ¶¶ 123-142. Mr. Hyatt did not otherwise attempt to rationalize his claim shifting, nor did he rebut the PTO's evidence that rewriting his claims restarted examination and burdened the PTO.

Mr. Hyatt entered some of his claim amendments under Rule 129(a), 37 C.F.R. § 1.129(a), which he believed entitled him to the entry and examination of new claim sets, FOF ¶ 143. However, the fact that PTO regulations permitted certain conduct, including claim shifting amendments, does not preclude a finding of prosecution laches. *See Hyatt II*, 998 F.3d at 1369; *Personalized Media*, 57 F.4th at 1354. If lawful conduct unreasonably delayed prosecution or burdened the PTO, as Mr. Hyatt's claim shifting amendments indeed did, then that conduct can (and here does) support a finding of prosecution laches.³²

32. For this reason, the Court is unpersuaded by Mr. Hyatt's arguments that Rule 129 or guidance from PTO officials made his delay- or burden-causing prosecution conduct reasonable. For example, Mr. Hyatt suggested that Rule 129(b) permitted him to claim multiple inventions in a single application and that Jessica Harrison and other PTO personnel confirmed this understanding.

*Appendix B***d. Specific Exemplary Actions**

Certain “exemplary acts during prosecution” of Mr. Hyatt’s GATT Bubble applications “were patently unreasonable” and further show “that his prosecution approach had overwhelmed even his own ability to manage his applications and claims.” *Hyatt II*, 998 F.3d at 1368-69. For instance, Mr. Hyatt attempted to reclaim the single-chip microprocessor count he had lost in the *Boone* interference proceeding. FOF ¶ 174. The Court’s factual findings, based on the complete record adduced at trial, confirm that Mr. Hyatt presented claims for examination directed to this previously lost count. FOF ¶¶ 175-179. It was unreasonable for Mr. Hyatt to seek to reclaim a count he had lost in an interference proceeding. FOF ¶ 180. And it was unreasonable not to tell the PTO that the interference meant he could only receive the benefit of a later priority date. *Id.* His failure to do so forced the PTO to needlessly expend examination time and resources relitigating a priority claim he had already lost. *Id.*

* * *

Mr. Hyatt’s specific prosecution approach cumulatively made it “extremely difficult” for the PTO “to conclude prosecution and examination” of his applications. FOF ¶ 115. The PTO faced significant burdens in searching for prior art, identifying written description support, and

But that directly contradicts his agreement with Director Godici, *see supra* Part IV.A.2.i, and fails to explain or justify his applications’ total lack of demarcation, *see infra* Part IV.A.2.iii.

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conducting double-patenting analyses. *E.g.*, FOF ¶¶ 115, 147, 150. The sheer number of claims Mr. Hyatt presented for examination, FOF ¶ 150, the length of his specifications, FOF ¶¶ 144-147, the complex and overlapping nature of his priority claims, FOF ¶¶ 111-113, 115, 121, his refusal to identify written description support, FOF ¶¶ 154-159, and his claim rewriting and shifting amendments that repeatedly restarted examination compounded these burdens, FOF ¶¶ 122-142. Mr. Hyatt's applications in suit notably share many of these features. FOF ¶¶ 194, 199, 204, 209.

Mr. Hyatt's purported justifications or explanations for his specific prosecution approach are factually and legally untenable. Thus, Mr. Hyatt has failed to meet another of his burdens on remand. *See Hyatt II*, 998 F.3d at 1372.

iii. Failure to Demarcate

Finally, the Federal Circuit held that Mr. Hyatt must "justify his failure to develop a plan for demarcating his applications over at least the 20 year period from 1995 to 2015." *Id.* Mr. Hyatt did not attempt to justify his failure to develop a plan. Instead, he argued that he actually developed a plan and succeeded in demarcating his applications. *See Hyatt Proposal 97-99.*

The Court concluded in its factual findings that Mr. Hyatt did not have a plan to demarcate his applications during the GATT transition period, as evidenced by his failure to timely prepare his applications for examination.

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FOF ¶¶ 108-109. The Court further concluded that Mr. Hyatt ultimately failed to demarcate his applications and that this fact, combined with his lack of plan during the GATT transition period, demonstrated that Mr. Hyatt did not have a plan to demarcate his applications between 1995 and 2015. FOF ¶ 110.

As this Court has already concluded, Mr. Hyatt failed to demarcate his applications pursuant to his agreement with Director Godici. *See supra* Part IV.A.2.i; *see also* FOF ¶ 160. However, regardless of how the Court interprets the Director Godici meeting, the record demonstrates that Mr. Hyatt's applications are not focused or demarcated. FOF ¶¶ 161-168. The Court found that Mr. Hyatt routinely shifted his claims, FOF ¶¶ 122-142, added duplicate and patentably indistinct claims, FOF ¶ 161, shifted the general subject matter of his claims, FOF ¶¶ 162-164, 166, failed to claim certain inventions until extremely late in prosecution, FOF ¶ 165, and failed to maintain consistent positions before the PTO regarding the focus of his claims, FOF ¶ 167. Mr. Hyatt has not provided persuasive justifications for these aspects of his applications and prosecution approach; he has only provided alternative histories that this Court has definitively rejected. Mr. Hyatt has failed to meet the last of his specific burdens on remand. *See Hyatt II*, 998 F.3d at 1372.

iv. Impact on the PTO

Mr. Hyatt's prosecution approach had an extraordinary impact on the PTO. The period immediately before, during, and after the issuance of the 2013 Requirements is instructive.

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After the Supreme Court's 2012 decision in *Kappos*, 566 U.S. 431, 132 S.Ct. 1690, the PTO created a dedicated art unit, AU 2615, to complete the examination of his applications, FOF ¶ 217. The art unit, which consisted of 13 examiners, FOF ¶ 223, picked up examination after the end of the 2003 to 2012 suspension period, FOF ¶¶ 234-235, and expended considerable time, effort, and financial resources examining Mr. Hyatt's applications, FOF ¶¶ 218-225. The experience of AU 2615 demonstrates that Mr. Hyatt's conduct has significantly burdened the PTO. FOF ¶ 226.

For instance, the art unit's first round of office actions ranged from 500 to 1000 pages in length. FOF ¶ 218. Normally, office actions are about ten pages. *Id.* These drafts took approximately six months to write. *Id.* At that pace, it would have taken approximately 600 years of examiner time to complete examination of Mr. Hyatt's applications, even though an application typically takes only about 20 hours of examiner time to complete. *Id.* Examiners took considerable time to prepare these office actions because of the myriad burdensome features of Mr. Hyatt's applications, including the extremely high number of claims, multitude of complex overlapping priority claims, difficulty identifying written description support, double-patenting issues, and lack of discernable lines of demarcation between applications. FOF ¶ 219.

In light of these issues, the PTO went to unusual lengths to ensure its examiners could not only complete their work in a relatively timely manner but receive appropriate credit for it, too. For example, because

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it was impracticable for examiners to identify double patenting issues using ordinary means, the PTO developed a specialized tool using Microsoft Word and Excel, “a phrase finder macro,” that could locate similar or identical claims. FOF ¶ 220. Examiners normally do not need such bespoke tools. *Id.* The PTO also took its examiners off of its production quota system because it was not giving examiners sufficient credit for their work examining Mr. Hyatt’s applications. FOF ¶¶ 221-222. Mr. Hyatt’s applications were so far outside the norm that evaluating AU 2615 examiners as though they were working on typical applications—holding them to the same productivity measures as other examiners—would severely understate the extent and quality of their work. FOF ¶ 222.

In 2013, the PTO determined it could not effectively examine Mr. Hyatt’s applications using ordinary means and issued the 2013 Requirements. FOF ¶ 228. The 2013 Requirements surveyed the issues with Mr. Hyatt’s applications, directed him to assist with examination, and created special procedures for obtaining his assistance. FOF ¶ 229. In the ten years after their issuance, AU 2615’s examiners completed examination of 330 of Mr. Hyatt’s applications. FOF ¶ 225. However, each examiner in AU 2615’s technology center would ordinarily be expected to complete the examination of 78 applications in a single year. FOF ¶ 224. At that rate, AU 2615’s thirteen examiners could have examined 10,140 applications in the amount of time it took them to examine 330 of Mr. Hyatt’s applications (or roughly 30 times the number of applications that AU 2615 actually examined). FOF

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¶ 225.³³ The PTO estimated that in the time it would have taken to examine Mr. Hyatt's applications without the 2013 Requirements, the examiners in AU 2615 could have examined approximately 41,496 typical applications. *Id.*

Since its formation, the PTO has spent approximately \$20 million on AU 2615 examiner salaries. FOF ¶ 223. That sum ordinarily buys the PTO many more completed applications than its examiners were able to deliver. *See* FOF ¶ 223-225. Again, this costly inefficiency is attributable to Mr. Hyatt's burdensome prosecution conduct.

Mr. Hyatt's only response is to argue that the PTO completed examination of most of his applications by the mid-2000s using ordinary compact prosecution methods, Hyatt Proposal 121-125, that the PTO's decision to resume examination in 2012 after it had already completed examining his applications was an independent PTO decision not attributable to Mr. Hyatt, Hyatt Proposal 222-223, and to attack the veracity of the 2013 Requirements, Hyatt Proposal 150-159. Mr. Hyatt here attempts to recharacterize the record—specifically, to take the PTO's decision to *suspend* examination in 2003 and transform it into examination reaching its natural end-state after years of business-as-usual prosecution. If correct, Mr. Hyatt can arguably absolve himself from responsibility for the burdens he created on the PTO through AU 2615

33. Thirteen (13) examiners, times 78 applications per year, times ten years, equals 10,140 applications over the approximately ten-year period that AU 2615 has been examining Mr. Hyatt's applications.

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and the 2013 Requirements. If the PTO really “completed” examination of his applications by the mid-2000s using ordinary examination methods, it cannot blame him for the costs of needlessly reopening examination. However, these arguments are unpersuasive.

First, Mr. Hyatt’s arguments concerning the alleged completion of examination in the mid-2000s stretch the record too far. Although examination stopped in the mid-2000s, it does not follow that the PTO had completed examination in the ordinary course. In fact, this Court previously faulted the PTO for insisting on following compact prosecution procedures even though they made it “*impossible* to complete examination.” *See Hyatt I*, 332 F. Supp. 3d at 128, 132-34 (emphasis added). The PTO clearly did not know what to do with Mr. Hyatt’s extraordinary applications in the pre-Requirements era and came to believe its examination approach was failing to identify “patentable subject matter or specific and focused issues in dispute.” FOF ¶ 228. So, it started suspending examination around 2003 under cover of ongoing litigation. FOF ¶¶ 234-235. However much the Court might dislike that the PTO suspended examination, it cannot pretend that Mr. Hyatt’s applications were ordinary or that their features—which the Court has now discussed at length—did not unduly burden the PTO before 2003 or contribute to the suspension period.

Second, the Court has already considered Mr. Hyatt’s attacks on the 2013 Requirements and determined that they are unfounded. FOF ¶ 230. As this Court has now held, the 2013 Requirements were a direct response to

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Mr. Hyatt's unique and highly burdensome prosecution conduct, which started as early as 1995. *Id.* They were not something the PTO generated in a vacuum in 2013 out of the desire to punish Mr. Hyatt; they were an attempt by the PTO to get examination back on track. *Id.* In other words, Mr. Hyatt caused the PTO to issue the 2013 Requirements by prosecuting his applications unreasonably before 2003. The PTO is not to blame.

Moreover, at all times, Mr. Hyatt bore the burden of conducting himself equitably before the PTO. *See Hyatt II*, 998 F.3d at 1366. Thus, even if the Requirements were baseless, Mr. Hyatt would still be responsible for the burden he created through his prosecution conduct after the Requirements, which exhibited claim shifting, FOF ¶¶ 135-142, deficient identification of written description support, FOF ¶ 157, shifting subject matter, FOF ¶¶ 164-167, and other issues that predate the Requirements.

Thus, Mr. Hyatt's strained attempt to recharacterize the record in his favor fails. The 2013 Requirements and the burden on the PTO, illustrated by the experiences of AU 2615, are directly attributable to Mr. Hyatt's conduct, and any consequent prejudice was caused by Mr. Hyatt and not the PTO's independent choices. At bottom, the exemplary figures and evidence that the Federal Circuit cited as substantiating Mr. Hyatt's extraordinary burden on the PTO remain intact.

*Appendix B***v. Other Matters**

Before wrapping up, the Court will briefly consider other matters raised by Mr. Hyatt.

Mr. Hyatt alleges that the PTO had a policy never to issue him another patent. Hyatt Proposal 125-138. Mr. Hyatt argues that because the PTO had no intention of ever issuing him another patent, his prosecution conduct could not have effectively “guaranteed indefinite prosecution delay.” *Hyatt II*, 998 F.3d at 1368. Put differently, Mr. Hyatt believes that prosecution would never advance no matter what he did, so he is not responsible for his dilatory conduct. As a matter of law, this argument is doubtful. Whether an “approach to prosecution” guarantees delay depends principally on the nature of that approach and its probable impact on examination, not hidden PTO policies that applied to that applicant. *See id.* at 1365-66, 1368. An applicant plausibly can still abuse the patent examination system even though the PTO no longer intended to issue that applicant patents—for example, by consuming an inordinate amount of PTO resources at the expense of other applicants. *See id.* at 1370 (referring to prosecution conduct that “effectively taxes everyone using the system”).

In any event, the Court concludes that no such policy existed. FOF ¶ 215. At most, Mr. Hyatt has shown that there was a temporary order not to issue him patents while his applications were undergoing consolidation in the late 1990s. FOF ¶¶ 211-212. However, that consolidation order was intended to streamline and improve examination

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quality. *Id.* The PTO terminated the “no patents” order once it completed the consolidation. FOF ¶ 212. Mr. Hyatt’s other pertinent evidence, which addresses topics such as SAWS and certain withdrawals from allowance, again does not evince that there was any such policy. FOF ¶¶ 213-214. At most, Mr. Hyatt’s evidence describes procedures the PTO reasonably put in place in connection with examining his highly unusual applications—i.e., mechanisms the PTO deployed to ensure it would not issue him an invalid patent while trying to get a handle on his applications. FOF ¶ 215. Although it appears that Mr. Hyatt was singled out for many of these procedures, the PTO understandably regarded his applications as *sui generis*. The Court cannot stretch Mr. Hyatt’s meager evidence of an indefinite “no patents” policy to absolve him from responsibility for how he prosecuted his applications.

The Court finds that in light of the overwhelming evidence of Mr. Hyatt’s unreasonable post-filing prosecution conduct, the fact that Mr. Hyatt successfully obtained 75 other patents, FOF ¶ 12, frequently communicated with the PTO, FOF ¶ 181, personally provided materials to PTO personnel, FOF ¶ 183, and pre-cleared certain amendments and filings with SPEs Razavi and Hjerpe, FOF ¶¶ 184-185, cannot “operate to excuse [Mr.] Hyatt from responsibility for the sizable undue administrative burden that his applications have placed on the PTO,” *see Hyatt II*, 998 F.3d at 1372. Mr. Hyatt’s other arguments concerning his post-filing prosecution conduct are either unsupported by the Court’s factual findings or insufficient to justify or excuse his conduct.

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* * *

Accordingly, the Court concludes that Mr. Hyatt’s post-filing prosecution conduct constituted a clear abuse of the patent examination system. *See id.* at 1369-71 (“[Mr.] Hyatt’s conduct—including his delay in presenting claims, his creation of an overwhelming, duplicative web of applications and claims, and his failure to cooperate with the PTO—was a clear abuse of the patent system, even if it did not literally violate regulations or statutory provisions.”); *see also supra* Part IV.A.1 (addressing his significant delay in presenting claims). The Court further concludes that Mr. Hyatt has failed to excuse or justify his abusive prosecution conduct or meet any of his specific burdens of persuasion. *See id.* at 1371-72.

“[W]here a patent applicant has committed a clear abuse of the PTO’s patent examination system, the applicant’s abuse and its effects meet the prejudice requirement of prosecution laches.” *Id.* at 1370. As discussed *infra*, Part IV.B.2, the Court’s conclusion that Mr. Hyatt clearly abused the patent examination system suffices to establish prejudice for prosecution laches purposes.

B. Prejudice

A finding in the PTO’s favor on either prejudice prong will establish that the PTO has prevailed on the issue of prosecution laches. *See Hyatt II*, 998 F.3d at 1370. The Court will consider each prong in turn, though both favor the PTO.

*Appendix B***1. Intervening Rights**

Because Mr. Hyatt unreasonably and inexcusably delayed filing his GATT Bubble applications by more than six years, a presumption of intervening rights applies. *Id.* Mr. Hyatt, therefore, bears the burden of proving a lack of intervening rights. *Id.* He has not done so.

As far as the Court is aware, Mr. Hyatt did not introduce any evidence directed to rebutting the presumption of intervening rights. The Court is also unaware of any evidence that indirectly rebuts this presumption. The PTO, on the other hand, has introduced evidence that Mr. Hyatt's specifications have been publicly available for decades. FOF ¶ 236-245. Although not necessary given the operative evidentiary presumption, this evidence indicates the difficulties and prejudice the public likely faces determining patentable subject matters while Mr. Hyatt's applications are pending. In any event, because the presumption of intervening rights applies, and Mr. Hyatt has not averred any evidentiary or legal basis for rebutting it, the Court finds that the intervening rights requirement is satisfied. *See Hyatt II*, 998 F.3d at 1370. The PTO has established prejudice and, therefore, is entitled to judgment on the issue of prosecution laches.

2. Clear Abuse of the Patent Examination System

Mr. Hyatt's prosecution conduct clearly abused the patent examination system, *see supra* Part IV.A, and materially prejudiced the PTO, *see Hyatt II*, 998 F.3d at 1370-72.

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The exemplary figures discussed *supra*, Part IV.A.2.iv, stand un rebutted. Notably, the Federal Circuit found them sufficient, “combined with the details surrounding [Mr.] Hyatt’s pattern of prosecution conduct, [to] show that the PTO ha[d] carried its burden of proving that [Mr.] Hyatt’s prosecution of his applications clearly abused the PTO’s patent examination system and . . . contributed to the delay that occurred with respect to the four applications at issue.” *Hyatt II*, 998 F.3d at 1371. This combination alone suffices to establish prejudice for prosecution laches purposes. *Id.* at 1370-71. Thus, because that same combination of facts is present here, following *Hyatt II*, the Court concludes that Mr. Hyatt’s abusive prosecution conduct created a material burden on the PTO that itself suffices to establish prejudice for prosecution laches purposes. *See id.* Again, the PTO is entitled to judgment on the issue of prosecution laches.

* * *

The PTO has shown to this Court’s satisfaction that Mr. Hyatt unreasonably and inexcusably delayed filing his GATT Bubble applications and engaged in prosecution conduct that constituted a clear abuse of the patent examination system. As a result, Mr. Hyatt prejudiced the PTO and third parties. Additionally, Mr. Hyatt has failed to meet his specific burdens on remand as detailed by the Federal Circuit. Accordingly, the Court will enter judgment for the PTO on the issue of prosecution laches.

To be clear, the Court takes no pleasure in this result. The Court once castigated the PTO for its “chutzpah” in

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chafing against Mr. Hyatt's efforts to vindicate his rights under Section 145 and for falling well short of how this Court believes government agencies should engage with zealous members of the public who seek to vindicate their rights. *Hyatt I*, 332 F. Supp. 3d at 133 n.14. Nevertheless, *Hyatt II* is clear. Given the scope of remand and binding case law, the facts this Court has found based on the complete trial record require a singular result—judgment for the PTO. No other result is even colorable. The Court recognizes that this ruling may significantly impact Mr. Hyatt's other pending applications. But Mr. Hyatt has now at last received a full and fair hearing on prosecution laches.

A separate order consistent with this memorandum opinion shall issue.

Date: May 16, 2024

/s/ Royce C. Lamberth
Royce C. Lamberth
United States District Judge

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**APPENDIX C — ORDER OF THE
UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA, FILED MAY 16, 2024**

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Case No. 05-cv-2310-RCL
Case No. 09-cv-1864-RCL
Case No. 09-cv-1869-RCL
Case No. 09-cv-1872-RCL

GILBERT P. HYATT,

Plaintiff,

v.

KATHERINE K. VIDAL, in her official
capacity as Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office,

Defendant.

Filed May 16, 2024

ORDER

The Clerk of Court shall transmit the Court's findings of fact and conclusions of law issued this date, along with this order, to the United States Court of Appeals for the Federal Circuit.

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Appendix C

Upon return of jurisdiction from the United States Court of Appeals for the Federal Circuit, the Court will enter the following order:

The Court, having now afforded Mr. Hyatt the opportunity to present evidence on prosecution laches, hereby enters **JUDGMENT** in favor of the defendant and against the plaintiff on the defense of prosecution laches and **DISMISSES** these cases with prejudice, for the reasons stated in the Court's accompanying findings of fact and conclusions of law.

SO ORDERED.

Date: May 16, 2024

/s/ Royce C. Lamberth
Royce C. Lamberth
United States District Judge

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**APPENDIX D — ORDER OF THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT,
FILED JANUARY 22, 2026**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2018-2390, 2018-2391, 2018-2392, 2019-1049, 2024-1992,
2024-1993, 2024-1994, 2024-1995, 2019-1038, 2019-1039,
2019-1070

GILBERT P. HYATT,

Plaintiff-Cross-Appellant,

v.

JOHN A. SQUIRES, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,

Defendant-Appellant.

Appeals from the United States District Court for the
District of Columbia in Nos. 1:05-cv-02310-RCL, 1:09-cv-
01864-RCL, 1:09-cv-01869-RCL, 1:09-cv-01872-RCL,
Senior Judge Royce C. Lamberth.

Filed January 22, 2026

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Appendix D

ON PETITION FOR REHEARING EN BANC

Before MOORE, *Chief Judge*, LOURIE, DYK, PROST, REYNA,
WALLACH¹, HUGHES, CUNNINGHAM, and STARK, *Circuit
Judges*.²

PER CURIAM.

ORDER

Gilbert P. Hyatt filed a petition for rehearing en banc. A response was invited by the court and filed by John A. Squires. Inventors Network of Minnesota, Michigan Inventors Coalition, San Diego Inventors Forum, Tampa Bay In-ventors Council and US Inventor, Inc., Small Business Technology Council, and Keiji Masaki moved for leave to file briefs as amici curiae, which the court granted.

The petition was first referred to the panel that heard the appeal, and thereafter the petition was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

1. Circuit Judge Wallach participated only in the decision on the petition for panel rehearing.

2. Circuit Judge Newman, Circuit Judge Taranto, Circuit Judge Chen, and Circuit Judge Stoll did not participate. Case: 18-2390 Document: 171 Page: 1 Filed: 01/22/2026

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The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

FOR THE COURT

January 22, 2026
Date

/s/ Jarrett B. Perlow
Jarrett B. Perlow
Clerk of Court

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**APPENDIX E — OPINION OF THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT,
FILED JUNE 1, 2021**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2018-2390, 2018-2391, 2018-2392, 2019-1038, 2019-1039,
2019-1049, 2019-1070

GILBERT P. HYATT,

Plaintiff-Cross-Appellant,

v.

ANDREW HIRSHFELD, PERFORMING
THE FUNCTIONS AND DUTIES OF THE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR
OF THE UNITED STATES PATENT AND
TRADEMARK OFFICE,

Defendant-Appellant.

Appeals from the United States District Court for the
District of Columbia in Nos. 1:05-cv-02310-RCL, 1:09-cv-
01864-RCL, 1:09-cv-01869-RCL, 1:09-cv-01872-RCL,
Senior Judge Royce C. Lamberth.

Decided June 1, 2021

Before REYNA, WALLACH, and HUGHES, *Circuit Judges.*

Appendix E

REYNA, *Circuit Judge*.

The United States Patent and Trademark Office appeals a judgment of the United States District Court for the District of Columbia. Patent applicant Gilbert P. Hyatt filed an action under 35 U.S.C. § 145 against the Patent and Trademark Office to obtain four patents. The Patent and Trademark Office asserted affirmative defenses of prosecution laches and invalidity for anticipation and lack of written description. The district court first held a trial on prosecution laches and subsequently held trials on anticipation and written description. Following a Rule 52(c) motion at the first trial, the district court decided that the Patent and Trademark Office failed to carry its burden of proving prosecution laches. Following the patentability trials, the district court decided that certain claims were not invalid for anticipation or lack of written description and ordered the Patent and Trademark Office to issue patents as to those claims.

We hold that prosecution laches is a defense available to the Patent and Trademark Office in an action to obtain a patent under 35 U.S.C. §145. We further hold that the district court erred in concluding that the Patent and Trademark Office had failed to prove prosecution laches. Accordingly, consistent with the principles of fairness and due process, we vacate and remand the district court's decision on prosecution laches for further proceedings consistent with this opinion and to provide Hyatt the opportunity to present evidence on that issue. We hold the remainder of the case in abeyance, retaining jurisdiction over the anticipation and written description issues.

*Appendix E***BACKGROUND****Submarine Patents**

Prior to 1995, a patent's term was measured as 17 years from the date of issuance. *See, e.g., Gilead Scis., Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1211 (Fed. Cir. 2014). The fact that patent term was keyed to the date of issuance, rather than the date of filing, incentivized certain patentees to delay prosecuting their patents by abandoning applications and filing continuing applications in their place. By doing so, patentees could obtain a patent at a financially desirable time when the accused product market had become suitably developed. *See, e.g.,* Thomas J. Kowalski & Pamela G. Salkeld, *The Impact of GATT on the United States Patent and Trademark Office*, 11 ST. JOHN'S J. LEGAL COMMENT. 455, 456 (1996) [hereinafter Kowalski] ("Under the old law, United States patent applications could theoretically remain pending indefinitely through use of the 'continuation' procedure of refiling."). This delay strategy has allowed some submarine patentees to specifically target competitors' new products. Mark A. Lemley & Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U. L. REV. 63, 76-78 (2004) [hereinafter Lemley]; *see also* Steve Blount & Louis S. Zarfes, *The Use of Delaying Tactics to Obtain Submarine Patents and Amend Around a Patent That a Competitor Has Designed Around*, 81 J. PAT. & TRADEMARK OFF. SOC'Y 11, 13, 28-30 (1999); John W. Schlicher, 2 Patent Law, Legal and Economic Principles § 13:11 (2d ed. 2015) [hereinafter Schlicher]. Critics of this practice have argued that it harms industries by upsetting the expectations of product

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manufacturers who have invested in manufacturing facilities. *See, e.g.*, Lemley, 84 B.U. L. REV. at 80; *see also* Schlicher, 2 Patent Law, Legal and Economic Principles § 13:11. The ability to avoid publication of an application offers further opportunity for abuse because it deprives the public of timely disclosure, which is a central goal of the patent system. Lemley, 84 B.U. L. REV. at 73.

Submarine patents have also added to the administrative burdens on the U.S. Patent and Trademark Office (“PTO”). Long chains of applications increase patent examiners’ caseloads, which have long tended to be large. *See, e.g.*, Eugene R. Quinn, Jr., *The Proliferation of Electronic Commerce Patents: Don’t Blame the PTO*, 28 RUTGERS COMPUTER & TECH. L.J. 121, 123 (2002) (stating that “patent examiners are simply too overworked” to weed out “patents that ought not see the light of day”); John R. Thomas, *The Question Concerning Patent Law and Pioneer Inventions*, 10 HIGH TECH. L.J. 35, 100 (1995) (stating that examiners are “notoriously overworked”). Aware of this reality, some submarine patentees have employed the strategy of “wearing down” patent examiners over time and thereby obtaining a broader patent scope than warranted. *See, e.g.*, Lemley, 84 B.U. L. REV. at 74-75.

During negotiations of the Agreement on Trade-Related Aspects of Intellectual Property (“TRIPS Agreement”) at the Uruguay Round of the General Agreement on Tariff and Trade (“GATT”), the U.S. sought to address the problem of submarine patents by agreeing

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to change the term of U.S. patents from 17 years following the date of issuance to 20 years following the filing date of the application or an earlier non-provisional application to which the subject application claims priority. TRIPS Agreement art. 33, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197, https://www.wto.org/english/docs_e/legal_e/27-trips.pdf. Congress then enacted this change in patent term into law. Uruguay Round Agreements Act, Pub. L. No. 103-465, § 532, 108 Stat. 4809, 4984 (1994) (amending 35 U.S.C. § 154 to provide a patent term of 20 years); *see also Supernus Pharms., Inc. v. Iancu*, 913 F.3d 1351, 1353 (Fed. Cir. 2019).

The U.S.'s change in patent term, which would become effective on June 8, 1995, triggered a patent application gold rush in the spring of 1995 often referred to as the "GATT Bubble." *See Hyatt v. Iancu*, 332 F. Supp. 3d 113, 122 (D.D.C. 2018) ("*Iancu*"); Kowalksi, 11 ST. JOHN'S J. LEGAL COMMENT. at 456-57. Applicants filed a large number of applications in the short period before the change in patent term. For example, in the nine days leading to June 8, 1995, the PTO reported that it received and processed over 50,000 applications—one-quarter of the entire year's projected filings. *PTO Applications*, 50 PAT., TRADEMARK & COPYRIGHT J. 253 (July 13, 1995). The influx from the GATT Bubble was so large that the PTO hired hundreds of patent examiners in 1995 and 1996 to process it. *See Kowalski*, 11 ST. JOHN'S J. LEGAL COMMENT. at 457.

*Appendix E***Hyatt's Applications**

As relevant to this appeal, Gilbert P. Hyatt is the named inventor on 399 patent applications, 381 of which he filed during the GATT Bubble. *See Iancu*, 332 F. Supp. 3d at 118; J.A. 31859. Hyatt bulk-filed the 381 applications, each one being a photocopy of one of 11 earlier parent applications. *See, e.g.*, J.A. 29444, 31859, 29407, 18944; *Iancu*, 332 F. Supp. 3d at 118. When filed, the applications contained small claim sets, many of which were identical to each other. *See, e.g.*, J.A. 29444, 29406-07.

This appeal specifically involves four of Hyatt's GATT Bubble applications: U.S. Patent Application No. 08/457,211 ("211 application"), U.S. Patent Application No. 08/456,398 ("398 application"), U.S. Patent Application No. 08/472,062 ("062 application"), and U.S. Patent Application No. 08/431,639 ("639 application"). These four applications relate to various computer technologies¹ and claim priority to applications filed in the 1970s and 1980s, which pre-date the applications by a range of 12 to 25 years.²

1. The specifics of the disclosed technologies do not materially affect this opinion.

2. The '211 application was filed on June 1, 1995, and claims priority to an application filed 12 years earlier in 1983. J.A. 7606-07, 8705, 14397-98. The '398 application was filed on June 1, 1995, shares the same specification as the '211 application, and claims priority to the same 1983 application. J.A. 8705, 14397-98, 14560. The '062 application was filed on June 6, 1995, and claims priority to an application filed 20 years earlier in 1975. J.A. 16071-73, 16453. The '639 application was filed on May 1, 1995, and claims priority to an application filed 25 years earlier in 1970. J.A. 18097-101.

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Hyatt's GATT Bubble applications, including the four at issue here, are atypically long and complex. According to PTO data, a typical patent application contains about 20 to 30 pages. *Iancu*, 332 F. Supp. 3d at 124. In contrast, the '211 and '398 applications have 576 pages of text and 65 pages of figures; the '062 patent includes 238 pages of text and 40 pages of figures; and the '639 application includes 518 pages of text and 46 pages of figures. *Id.*

On October 24, 1995, about five months after Hyatt filed his GATT Bubble applications, PTO group Director Nicholas Godici met with Hyatt to discuss the applications. Director Godici asked Hyatt, and Hyatt agreed, to focus each application's claims on distinct subject matter. *Id.* at 128. Neither party memorialized the agreement at the time, but neither party disputes that it occurred. *Id.*; J.A. 41516, 29348 ll. 3-14.

Between that meeting and 2003, Hyatt filed a series of amendments in his applications that grew the number of claims to a total of approximately 115,000, including approximately 45,000 independent claims. *See, e.g.*, J.A. 38154, 38161-62, 29555, 29444; *Iancu*, 332 F. Supp. 3d at 124. Hyatt's GATT Bubble applications therefore eventually contained, on average, 300 claims per application, which far exceeded the average number of claims in applications pending before the PTO. *See Iancu*, 332 F. Supp. 3d at 124. The four specific applications at issue here included a total of 1,592 claims, i.e., an average of 398 claims per application. *See id.*

Mr. Hyatt's claim amendments adding hundreds of claims per application on average meant that Hyatt had

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presented claims for examination between 12 and 28 years after their alleged priority dates. Specifically, Mr. Hyatt waited from 25 to 28 years to present his claims in the '639 application, J.A. 18614-56, 18033-41, 17976-8022, 17889-947, 17707-832; 12 to 16 years to present those in the '211 application, J.A. 9281-89, 8018-40, 7983-8015, 7825-49, 7640-719, 7539-93, 7019-111; 12 to 20 years to present those in the '398 application, J.A. 15210-19, 14536-58, 14317-96, 14288-314, 14257-85, 14118-204, 13574-685, 13520-49, 47748; and 20 to 21 years to present those in the '062 application, J.A. 16690-95, 16367-97, 16330-37, 16243-314. For these many years, Mr. Hyatt's inventions were submerged.

From 2003 to 2012, the PTO stayed the examination of many of Hyatt's applications pending litigation. Hyatt's applications have been involved in various cases before the federal courts whose outcomes were likely to affect PTO's handling of most or all of his other applications.³ See J.A. 18944; *Hyatt v. USPTO*, No. 1:13-CV-1535, 2014 U.S. Dist. LEXIS 74145, 2014 WL 2446176, at *1 (E.D. Va. May 29, 2014).

3. Hyatt's lawsuits have addressed a variety of issues, such as challenging examiners' written description rejections, *Hyatt v. Dudas*, 492 F.3d 1365 (Fed. Cir. 2007); challenging the PTO's ability to use representative claims in Board decisions, *Hyatt v. Dudas*, 551 F.3d 1307 (Fed. Cir. 2008); and challenging the PTO's position that plaintiffs in § 145 actions may present new evidence only if it had no reasonable opportunity to present it to the PTO in the first instance, *Kappos v. Hyatt*, 566 U.S. 431, 132 S. Ct. 1690, 182 L. Ed. 2d 704 (2012).

*Appendix E***The PTO's Requirements**

In 2013, the PTO resumed examination of Hyatt's applications. Around that time the PTO created an art unit, comprised originally of 12 experienced examiners, dedicated to examining Hyatt's applications. *See Iancu*, 332 F. Supp. 3d at 119; J.A. 29366, 29567-68. Initially the examiners took a compact prosecution approach, in which they prepared a fulsome set of rejections on the first office action so that the next action might become final. J.A. 29433, 29569. The examiners took approximately four to five months to write their first office actions, each of which spanned hundreds of pages. *See, e.g.*, J.A. 29567-69, 38187 n.7. In contrast, a typical examination took 20 hours, or two to three business days, of examiner time. J.A. 29570.

To facilitate the examination process, from August to October 2013, the PTO issued 11 notifications to Hyatt called "Requirements." *See, e.g.*, J.A. 31856-96, 32885-923, 33585-645, 33646-73, 36310-47, 36565-93, 36705-38, 37031-69, 37837-72, 38094-150, 38151-96. Each Requirement corresponded to a set of applications that shared a common specification belonging to one of the GATT Bubble applications' 11 parent applications. *See, e.g.*, J.A. 31860-62. These Requirements were designed to solicit information from Mr. Hyatt that would streamline prosecution of his applications.

The PTO first described the challenges that Hyatt's applications had created. For example, the PTO could not reasonably ascertain the priority dates of the claimed inventions because the applications claimed priority to

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numerous applications. *See, e.g.*, J.A. 31863-64 (listing the 43 applications filed from 1969 to 1983 to which one group of applications claimed priority). The length of the applications, as well as the length of the priority applications, also hindered examiners' ability to determine compliance with 35 U.S.C. § 112. *See, e.g.*, J.A. 31865-66. The PTO further explained that the number of claims, and their multiplication through amendments since 1995, also posed a significant hurdle to processing the applications. *See, e.g.*, J.A. 31869-72. The PTO also pointed out a large amount of repetition and redundancy of claims across applications. J.A. 31872-85. Because of these factors, the PTO estimated it would take 532 years of examiner time at its then current rate to process Hyatt's applications. J.A. 31886 & n.14. The PTO therefore instructed Hyatt to (i) select no more than 600 total claims to pursue for each of the 11 specifications; (ii) identify the priority date and support for that date with respect to each chosen claim; and (iii) submit a clean copy of the claims. *See, e.g.*, J.A. 31888-91.

Examination and Review by the Board

The four Hyatt applications' claims were finally rejected and reviewed on appeal by the Board of Patent Appeals and Interferences ("Board"), which affirmed rejections of certain claims in each application. *Iancu*, 332 F. Supp. 3d at 124-26. Specifically, during examination of the '639 application, an examiner rejected all pending claims for lack of written description or obviousness. J.A. 626-27. The Board affirmed in part and reversed in part,

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placing some claims in condition for allowance. J.A. 715-16. On rehearing, the Board withdrew only certain additional rejections. J.A. 762.

During examination of the '211 application, an examiner rejected all but a small number of claims for lack of written description, lack of enablement, and obviousness, and the Board reversed certain non-enablement and obviousness rejections. J.A. 207, 213, 262-63. On rehearing, the Board denied Hyatt's request to withdraw additional rejections. J.A. 280.

Further, an examiner rejected all claims in the '398 application for lack of written description and some of those claims for obviousness or anticipation. J.A. 285. The Board affirmed in part and found a new ground for rejection under § 101. J.A. 286, 383-84. On rehearing, the Board withdrew certain additional written description and prior art-based rejections. J.A. 554.

As for the '062 application, an examiner rejected all claims for lack of written description and enablement, as well as for obviousness-type double patenting. J.A. 557, 564. The Board affirmed certain § 112 rejections and the double patenting rejection for one claim and reversed rejections as to other claims. J.A. 601. On rehearing, the Board withdrew its written description rejection with respect to one claim. J.A. 624.

*Appendix E***Hyatt's § 145 Actions**

On November 18, 2005, Hyatt filed a § 145 action⁴ in the U.S. District Court for the District of Columbia seeking issuance of a patent from the '211 application. J.A. 60284-89. On September 25, 2009, he filed three additional § 145 actions in the same court with respect to the '398, '062, and '639 applications. J.A. 60291-304. In each complaint, Hyatt alleged that the PTO had made factual errors and failed to comply with the law in refusing to issue patents from these applications. *See* J.A. 60284-304.

On August 23, 2016, the district court issued a series of orders on the parties' motions for summary judgment. The court denied Hyatt's motions, and granted the PTO's motions in part. J.A. 195, 47210-11, 55447-70, 56065-82. The district court explained that factual issues precluded summary judgment on certain issues, including written description, anticipation, and obviousness-type double patenting. J.A. 55449-70, 56067-82.

4. An applicant may appeal an adverse decision by the Board directly to this court or may file a civil action in district court under 35 U.S.C. § 145 to obtain a patent. 35 U.S.C. § 145; *Hyatt v. Kappos*, 625 F.3d 1320, 1322 (Fed. Cir. 2010), *overruled on other grounds by Kappos v. Hyatt*, 566 U.S. 431, 132 S. Ct. 1690, 182 L. Ed. 2d 704 (2012). We have explained that the § 145 action is a hybrid action. *Hyatt*, 625 F.3d at 1322. It is unlike an appeal because the plaintiff can present new evidence. *Id.* However, if the applicant presents no new evidence, then the district court reviews the action on the administrative record, *id.*, and the district court reviews de novo any issue for which the applicant presents new evidence, *id.* at 1336.

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The next month, the PTO filed a motion to dismiss each case on prosecution laches grounds. *Iancu*, 332 F. Supp. 3d at 117-18; J.A. 134-35, 155-56, 176-77, 196-97, 18891-941. The PTO argued that Hyatt had engaged in a “pattern of delay in prosecuting his nearly 400 patent applications from 1969 through the present day.” J.A. 18902. According to the PTO, that was true even disregarding the period from 2003 to 2012—which the PTO did not rely on—when the PTO suspended prosecution of most of Hyatt’s applications due to pending litigation. *Iancu*, 332 F. Supp. 3d at 124, 129, 133 n.14. The PTO argued that Hyatt forfeited his patent rights by, for example, claiming priority to applications more than 45 years old; bulk-filing about 400 photocopies of 11 applications in the days before the U.S.’s patent term changed on June 8, 1995; and agreeing to focus each application on a different invention but not doing so and later revealing that he never had a “master plan” for demarcating the applications. *Id.* at 117-18.

Hyatt responded that his prosecution of applications other than the four at issue was legally irrelevant; that the PTO itself engaged in extensive delays in administering his applications; that the PTO did not warn him, as allegedly required, that he was in jeopardy of losing his patent rights; and that the PTO failed to prove intervening rights as necessary to establish prosecution laches. J.A. 19289. Hyatt also argued that his delays were explainable because, for example, PTO rules permitted Hyatt to add and amend claims, and Hyatt did so to correctly capture his inventions and steer clear of prior art. *See, e.g.*, Pl.’s Opp. to Def.’s Mot. to Dismiss for Prosecution Laches at

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10, *Hyatt v. Matal*, No. 1:05-cv-02310-RCL (D.D.C. Jan. 9, 2017), ECF No. 101.⁵ The court treated the PTO's motions to dismiss as motions for summary judgment and denied them because genuine issues of material fact existed. *Iancu*, 332 F. Supp. 3d at 118.

In October 2017, the district court held a five-day, consolidated bench trial on whether prosecution laches barred the issuance of patents from the '211, '398, '062, and '639 applications. *Id.* The PTO presented three witnesses: (i) Robert Clarke; (ii) Gregory Morse; and (iii) Stephen Kunin. *Id.* at 118-19.

Mr. Clarke testified on behalf of the PTO about its patent examination procedures. Mr. Clarke served as the editor of the Manual of Patent Examining Procedure ("MPEP") and had previously held other high-level positions at the PTO, including Chief of Staff and Director of the Office of Patent and Legal Administration. J.A. 29185. He testified, for example, that Director Godici met with Hyatt on October 24, 1995, and asked Hyatt to demarcate his applications. *See* J.A. 29348, 41516. Mr. Clarke further testified that the PTO's practice is to bring prosecution to a close as quickly as possible. J.A. 29320. He also testified that "it's possible" that the PTO could have devoted more resources to Hyatt's applications. J.A. 29320-21.

5. Hyatt filed apparently identical oppositions in the other three cases, No. 1:09-cv-01864-RCL (regarding the '398 application); No. 1:09-cv-01872-RCL (regarding the '639 application); and No. 1:09-cv-01869-RCL (regarding the '062 application).

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Mr. Morse served as the supervisor of Group Art Unit 2615, the unit dedicated to Hyatt's applications. J.A. 29363-64; *Iancu*, 332 F. Supp. 3d. at 119. Mr. Morse's testimony focused on the history and nature of Hyatt's applications, the unique challenges they posed to the PTO, and the PTO's handling of the applications. *See, e.g.*, J.A. 29363-67, 29399-486, 29543-620, 29639-50, 29657, 29807, 29823. According to Mr. Morse, the complexity, number, size, and overlap of Hyatt's applications and claims made it difficult, if not impossible, for examiners to determine the claims' priority dates for purposes of identifying the relevant body of prior art, to determine whether the claims satisfy the written description requirement, and to identify double patenting issues. *See, e.g.*, J.A. 29368, 29417-26, 18944. Further complicating the examiners' task was their need to find not only disclosures of individual claim elements, but more specifically disclosures of interconnections between those elements. J.A. 29435-36. Hyatt's tendency to rewrite claims in whole or in significant part midway through prosecution effectively restarted prosecution for the newly rewritten claims. J.A. 29464-66, 19471-72. When asked whether Hyatt had been forthcoming about priority dates before the PTO issued its Requirements in the fall of 2013, Mr. Morse responded, "No. That has been a persistent issue across this entire family of applications." J.A. 29429.

Mr. Kunin testified as an expert witness regarding the PTO's patent policy, practice, and procedure. Mr. Kunin opined, in summary, that "Mr. Hyatt's pattern of conduct unreasonably and unexplainably delayed prosecution, resulting in needlessly increased examiner time and its

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associated costs to the USPTO to conclude examination of his applications.” J.A. 39235-83; *see also* J.A. 30200, 29990. Mr. Kunin pointed to several factors in support. For example, Hyatt had delayed years and sometimes multiple decades after his alleged priority dates to submit claims. J.A. 30201. According to Mr. Kunin, unreasonable and unexplainable delay also resulted from Hyatt’s pattern of conduct during prosecution, including (i) dramatically increasing, i.e., unduly multiplying, the number of claims⁶ contrary to 37 C.F.R. 1.75(b); (ii) rewriting, i.e., shifting, claims in large portions or in their entirety contrary to 37 C.F.R. § 1.145; (iii) presenting numerous duplicate or patentably indistinct claims across applications without informing the PTO contrary to MPEP §§ 2001.06(b), 2004(9); and (iv) failing to identify written description support for claims contrary to MPEP §§ 714.02, 2163.06. *See, e.g.*, J.A. 30201; *see also* J.A. 39238. Mr. Kunin pointed to additional specific instances of prosecution conduct that evinced the unreasonableness of Hyatt’s prosecution conduct, namely (i) filing claims that Hyatt had already lost in interference proceedings without informing the examiner; (ii) failing to take allowed claims but rather refiling them years after their allowance in a separate application; and (iii) failing to prosecute district court actions under § 145. *See, e.g.*, J.A. 30202.

At the close of the PTO’s case-in-chief on prosecution laches, Hyatt moved for judgment on partial findings pursuant to Rule 52(c) of the Federal Rules of Civil

6. Mr. Kunin also testified that fewer than 0.02% of all applications filed from 1995 to 2013 included 299 or more claims. J.A. 39243.

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Procedure.⁷ *Iancu*, 332 F. Supp. 3d at 119. Hyatt argued that the PTO failed to prove prosecution laches because the PTO (i) did not show it provided Hyatt with adequate warnings of laches rejections; (ii) did not prove intervening rights; (iii) never issued laches rejections for the four applications at issue; and (iv) failed to meet its burden of proving unreasonable and unexplained delay by a preponderance of the evidence. *Id.*

In the months following the prosecution laches trial, the district court conducted additional bench trials on the patentability of the four applications' claims. *See* J.A. 140-43, 160-63, 182-83, 202-04.

The District Court's Decisions

On August 1, 2018, the district court issued a series of orders resolving the issues in the four cases. First, it dismissed the case with respect to the '062 application because the parties no longer disputed claim 45, the only claim that remained after the court's summary judgment orders. J.A. 120.

The court issued a separate order pursuant to Rule 52(c) of the Federal Rules of Civil Procedure concluding that prosecution laches did not bar issuance of patents

7. Rule 52(c) provides that, in a nonjury trial, if a party has been fully heard on an issue and the court finds against the party on that issue, "the court may enter judgment against the party on a claim or defense that, under the controlling law, can be maintained or defeated only with a favorable finding on that issue." FED. R. CIV. P. 52(c).

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from the '211, '398, '062, and '639 applications. *See Iancu*, 332 F. Supp. 3d at 131, 138. The central thrust of the district court's analysis was that the PTO had failed to take the actions necessary to advance the prosecution of Hyatt's applications. *See id.* at 131-38. At the outset, the court explained that it would only consider delay up to 2002 in its analysis because (i) the PTO "shoulders responsibility" for suspending prosecution of Hyatt's applications pending litigation from 2003 to 2012, and (ii) after 2012, the relevance of Hyatt's delays in prosecuting applications other than the four at issue "is so circumspect that the [c]ourt must decline to consider it here." *Id.* at 131-32.

The district court reasoned that the uniqueness of Hyatt's voluminous applications "required [the PTO] to employ and embrace atypical procedures for addressing" his applications. *See id.* at 133. The court faulted the PTO for trying to "fit the large proverbial square peg of Hyatt's applications into the rounded-out and well-trodden hole of its 3,000 page practice manual." *Id.* According to the court, the PTO's refusal to adopt "atypical procedures" made a finding of prosecution laches "[un]warrant[ed]." *Id.*

The district court then found the PTO's efforts to advance prosecution—including the October 1995 meeting between Hyatt and Director Godici—were so informal and inadequate as to preclude a finding of prosecution laches. *Id.* at 134-37. The court faulted the PTO for not using "specific and formal" measures up to 2002 to obtain the information it needed from Hyatt to successfully administer his applications. *Id.* at 134. According to the

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court, the PTO should have used formal measures “rather than await Mr. Hyatt’s help, which, it appears obvious, was not forthcoming.” *Id.* The court stated that “it would seem to have been in Mr. Hyatt’s interest to assist examination when invited to do so, if he had indeed prioritized having his applied-for patents issue at the earliest possible date.” *Id.* The court further found that the PTO’s non-use of more formal measures to seek information and amendments deprived Hyatt of an “opportunity to amend or cancel claims to avoid rejections.” *Id.* at 134-35. If the PTO had used such measures, the court reasoned, “[i]t is entirely likely that Mr. Hyatt could have been more helpful during the examination process.” *Id.* at 135 (quotation omitted). The court explained that it was “left with no choice but to conclude that the PTO itself ignored for 20 years the details of whatever informal agreement Mr. Hyatt and Mr. Godici had.” *Id.* The PTO “cannot have it both ways here,” the court explained, by “lament[ing] decades of allegedly outrageous conduct” while arguing its own inaction is irrelevant. *Id.* at 136.

The district court made various additional determinations in a section at the end of its order titled “Other Matters.” *Id.* at 137. First, the district court assigned little weight to the fact that the PTO spent more than \$10 million in the last five years examining claims in Hyatt’s GATT Bubble applications whereas Mr. Hyatt had only paid about \$7 million in fees. *Id.*

Second, the court concluded that Mr. Hyatt’s “claim shifting”—or amending claims so significantly “as to effectively create a new claim”—did not warrant a finding

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of prosecution laches. *Id.* at 137-38. The district court again faulted the PTO for “accept[ing] the amendments and continu[ing] examination” in such cases. *Id.* at 137. The court “appreciate[d] the challenge that faced the PTO in processing these unusual applications,” but nevertheless stated it could not bar the patents for prosecution laches because “the PTO itself did nothing to police the conduct they now complain of for the better part of two decades.” *Id.*

The court next found insufficient the PTO’s evidence that Hyatt had re-introduced claims in the applications at issue even though he had previously lost them in interference proceedings. *Id.* at 138. The court found Hyatt’s conduct “was not reasonable,” and that the PTO is entitled to assume that an application is not claiming an invention he already lost. *Id.* But nevertheless, the court reasoned, Hyatt’s “unreasonable conduct as to four allegedly illustrative claims does very little to move the ball in consideration of the totality of Mr. Hyatt’s conduct across approximately 115,000 claims.” *Id.*

That same day, August 1, 2018, the district court issued another order addressing the patentability of the four applications’ claims at issue. *See* J.A. 71-113, 144, 165, 184, 205. The court concluded certain claims in the ’211, ’398, and ’639 applications met the written description, non-obviousness and novelty requirements for patentability and ordered the PTO to issue patents for those claims. *See id.* at 85-113.

The PTO appeals the district court’s decision on prosecution laches, written description, and novelty, and

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challenges the district court's authority to order the PTO to issue a patent. *See* Appellant's Br. 5-6. Hyatt cross-appeals the district court's decision not to enter judgment on claims for which the Board reversed the examiner's rejections and that the PTO failed to dispute in court. Appellee's Br. 87-88. We have jurisdiction under 28 U.S.C. § 1295(a)(4).

STANDARD OF REVIEW

We review the district court's factual findings for clear error and its legal conclusions de novo. *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1312 (Fed. Cir. 2016). We review a district court's determination of prosecution laches for abuse of discretion. *Cancer Research Tech. Ltd. v. Barr Lab'ys Inc.*, 625 F.3d 724, 728-29 (Fed. Cir. 2010). "We may find an abuse of discretion on a showing that the court . . . exercised its discretion based upon an error of law or clearly erroneous factual findings." *SiOnyx LLC v. Hamamatsu Photonics K.K.*, 981 F.3d 1339, 1349 (Fed. Cir. 2020) (quoting *Innogenetics, N.V. v. Abbott Lab'ys*, 512 F.3d 1363, 1379 (Fed. Cir. 2008)).

DISCUSSION**Prosecution Laches****A**

The doctrine of laches is an equitable affirmative defense. *Cancer Research*, 625 F.3d at 728. Prosecution laches may "render a patent unenforceable when it has issued only after an unreasonable and unexplained delay

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in prosecution that constitutes an egregious misuse of the statutory patent system under a totality of the circumstances.” *Id.* (quotation and citation omitted). Finding an unreasonable and unexplained delay in prosecution “includes a finding of prejudice[.]” *Id.* at 729.

The prosecution laches defense originates from two Supreme Court cases in the early 1900s. *See Woodbridge v. United States*, 263 U.S. 50, 44 S. Ct. 45, 68 L. Ed. 159, 59 Ct. Cl. 952, 1924 Dec. Comm’r Pat. 534 (1923); *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463, 44 S. Ct. 342, 68 L. Ed. 792, 1924 Dec. Comm’r Pat. 520 (1924). In *Woodbridge*, the Court applied the doctrine to render a patent unenforceable based on a nine-year delay in prosecution. 263 U.S. at 53. The PTO had agreed with Woodbridge’s request to delay the issuance of his patent for one year. *Id.* at 52. At the end of the year, the PTO neglected to issue the patent. *Id.* at 53. Woodbridge waited an additional eight-and-a-half years before sending a letter to the PTO calling attention to the application and explaining that he had waited because the delay enabled him to best avail himself of the patent’s value. *Id.* He then sought to amend the specification and claims to capture related innovations that arose during the course of the delay. *Id.* The Court held that, by delaying to “mak[e] the term of the monopoly square with the period when the commercial profit from it would have been highest,” Woodbridge “forfeit[ed] the right to a patent by designed delay.” *Id.* at 56. The Court reasoned that

[a]ny practice by the inventor and applicant for a patent through which he deliberately and without excuse postpones beyond the date of the

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actual invention, the beginning of the term of his monopoly, and thus puts off the free public enjoyment of the useful invention, is an evasion of the statute and defeats its benevolent aim.

Id. at 56.

The next year, in *Webster Electric*, the Court similarly held that an unreasonable delay of eight years rendered a patent unenforceable. 264 U.S. at 465, 471. The applicant filed a patent application in 1910. *Id.* at 464. In 1915, to provoke an interference against a separate, recently issued patent, the applicant filed a divisional application copying the patent's claims. *Id.* The applicant lost the interference and then amended the divisional application by adding two new claims, claims 7 and 8, which issued in 1918 and were the subject of the litigation. *Id.* at 464-65. The Court explained that it was not until 1918 that the applicant intended to assert claims 7 and 8, which were broader than any he previously sought. *Id.* at 465-66. Meanwhile, “[d]uring all of this time the subject matter was disclosed and in general use, and [the applicant] and his assignee, so far as claims 7 and 8 are concerned, simply stood by and awaited developments.” *Id.* at 465. The Court held claims 7 and 8 unenforceable, noting it had “no hesitation in saying that the delay was unreasonable, and, under the circumstances shown by the record, constitutes laches, by which the petitioner lost whatever rights it might otherwise have been entitled to.” *Id.* at 466.

We have observed that, in enacting the Patent Act of 1952, Congress intended the prosecution laches defense to remain available. *Symbol Techs., Inc. v. Lemelson*

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Med., Educ. & Research Found., LP, 277 F.3d 1361, 1365-66 (Fed. Cir. 2002). P.J. Federico, an original drafter of the Act, explained in a renowned series of lectures following the Act's enactment that § 282 incorporated the defenses to infringement that were available at that time, including laches, such that they remained available to accused infringers. Pub. L. No. 82-593, 66 Stat. 792, 812; *see also* 35 U.S.C. § 282; P.J. Federico, *Commentary on the New Patent Act* (West 1954), *reprinted in* 75 J. PAT. & TRADEMARK OFF. SOC'Y 161, 215 (1993) (referring to defenses that may be raised in an action involving the validity or infringement of a patent and stating "this would include . . . equitable defenses such as laches, estoppel, and unclean hands").

Nearly eighty years after *Webster Electric*, we confirmed that prosecution laches, as a matter of law, is an available defense to patent infringement. *Symbol Techs.*, 277 F.3d at 1363, 1366-68. Soon after that we applied the doctrine for the first time, concluding that a patentee had forfeited his right to a patent. *In re Bogese*, 303 F.3d 1362, 1363 (Fed. Cir. 2002). In *Bogese*, between 1987 and 1995, the applicant engaged in "deliberate and consistent course of conduct that has resulted in an exceptional delay in advancing the prosecution and the issuance of a patent." *Id.* at 1365. Specifically, he filed 12 continuation applications without amendment or addressing the reasons for the rejection and each time abandoned the previous application. *Id.* at 1363-65. The patent examiner ultimately rejected all pending claims on the grounds that the applicant's actions "deliberately postponed meaningful prosecution, deliberately postponed the grant of any

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patent to which he may be entitled, and deliberately postponed the free public enjoyment” of the claimed inventions, evading the patent statute and defeating its benevolent aim. *Id.* at 1365.

On review, the Board agreed with the examiner’s decision, calling the applicant’s actions “so egregious in defeating the policy of the patent laws of promoting science and the useful arts as to be presumed unreasonable.” *Id.* at 1366. The harm caused by the applicant, the Board explained, was not only the delayed disclosure of his invention, but also the “deliberate delay of the term of any monopoly granted by a patent” until a time “when the industry has developed and matured to such a point as to be more financially beneficial to the applicant and hence more harmful or prejudicial to the public.” *Id.*

Bogese appealed to this court, challenging the PTO’s exercise of authority to require him to advance the prosecution of his patent application. *Id.* at 1369. We held that that the PTO’s sanction for undue delay under the doctrine of prosecution laches was not arbitrary, capricious, or contrary to law under the Administrative Procedure Act, 5 U.S.C. § 706. *Id.* at 1366-69.

Since *Bogese*, we have affirmed a prosecution laches determination one other time. See *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., LP*, 422 F.3d 1378, 1385 (Fed. Cir. 2005) (“*Symbol Technologies II*”). In *Symbol Technologies II*, the patentee’s delays resulted in 18-to 39-year time periods between the filing of applications to the issuance of the patents in suit. See

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id. at 1386. The district court found that the patentee’s patents ranked in the “‘top thirteen positions’ for the longest prosecutions” for the period from 1914 to 2001. *Id.* (citation omitted). On appeal, we explained that this type of delay “is not what is contemplated by the patent statute when it provides for continuation and continuation-in-part applications,” and that such delay creates an “adverse effect on businesses that [are] unable to determine what [is] patented from what [is] not patented.” *Id.*

In *Symbol Technologies II*, we provided examples of both reasonable and unreasonable delay. *Id.* at 1385. Three examples of reasonable delay include: (i) filing a divisional application in response to a restriction requirement, even if the filing occurs immediately before issuance of the parent application; (ii) refiling an application to present new evidence of an invention’s unexpected advantages; and (iii) refiling an application “to add subject matter in order to attempt to support broader claims as the development of an invention progresses.” *Id.* We clarified that these examples are not exhaustive and that an applicant could reasonably refile an application where that refiling “is not unduly successive or repetitive.” *Id.*

In contrast, we explained, unreasonable delays involve repetitive refilings that demonstrate unjustifiable prosecution delay, for example, “refiling an application solely containing previously-allowed claims for the business purpose of delaying their issuance.” *Id.* (citations omitted). We reasoned that the determination of unreasonable delay is not limited to the circumstances surrounding the particular application at issue; instead,

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“an examination of the totality of the circumstances, including the prosecution history of all of a series of related patents and overall delay in issuing claims, may trigger laches.” *Id.* at 1385-86.

In *Cancer Research Technology Ltd. v. Barr Laboratories, Inc.*, we expanded the requirements for prevailing on a prosecution laches defense to infringement. 625 F.3d 724 (Fed. Cir. 2010). Specifically, we held that prosecution laches requires proving two elements: (a) that the patentee’s delay in prosecution was unreasonable and inexcusable under the totality of circumstances, and (b) that the accused infringer suffered prejudice attributable to the delay. *Id.* at 728-29. To establish prejudice, we explained, an accused infringer must show evidence of intervening rights, that is, that the accused infringer or others “invested in, worked on, or used the claimed technology during the period of delay.”⁸ *Id.* at 729. Because the defendant had not proven prejudice, we reversed the district court’s judgment that the patent at issue was unenforceable for prosecution laches. *Id.* at 726, 731-32.

Although *Woodbridge*, *Webster Electric*, *Bogese*, *Symbol Technologies II*, and *Cancer Research* provide guidance on the application of laches in certain circumstances, we now address for the first time the PTO’s assertion of a prosecution laches defense in a civil action brought by a patentee under 35 U.S.C. § 145 to obtain a patent.

8. See, e.g., *John Bean Techs. Corp. v. Morris & Assocs., Inc.*, 988 F.3d 1334, 1338 (Fed. Cir. 2021) (discussing intervening rights).

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Before turning to the merits of prosecution laches, we address the threshold issue of whether the PTO can assert the defense of prosecution laches in a § 145 action. We hold that it can. As we have explained, the PTO has the authority to deny patent issuance on prosecution laches grounds. *Bogese*, 303 F.3d at 1367 (“It necessarily follows that the PTO has the authority to reject patent applications for patents that would be unenforceable” for prosecution laches.). The PTO also has the right to defend, in appeals before this court, its rejections of patent claims based on prosecution laches. *See id.* Further, the language of § 282 demonstrates Congress’s desire to make affirmative defenses, including equitable ones such as prosecution laches, broadly available. *See* 35 U.S.C. § 282 (making available affirmative defenses, including “any other fact or act made a defense by this title,” “in any action involving” patent validity); P.J. Federico, *Commentary on the New Patent Act* (West 1954), reprinted in 75 J. PAT. & TRADEMARK OFF. SOC’Y 161, 215 (1993) (explaining that Congress intended to incorporate equitable defenses including laches into the Patent Act of 1952). Defendants may accordingly assert the prosecution laches defense in district court infringement cases. *See Symbol Techs.*, 277 F. 3d at 1363. These factors point to the conclusion that the PTO should be permitted to assert the prosecution laches defense in a § 145 action. In our view it would make little sense for the PTO to have the authority to use prosecution laches as a basis for denying a patent, but to lack the authority to defend against issuance of a patent in a § 145 action on the same basis. Hyatt articulates no

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principled reason why we should adopt such an approach, and we are not otherwise aware of one.

Further, the PTO may assert the prosecution laches defense in a § 145 action even if it did not previously issue rejections based on, or warnings regarding, prosecution laches during the prosecution of an application that is at issue in the § 145 action. In *Kappos v. Hyatt*, the Supreme Court concluded that “there are no limitations on a patent applicant’s ability to introduce new evidence in a § 145 proceeding beyond those already present in the Federal Rules of Evidence and the Federal Rules of Civil Procedure.” 566 U.S. 431, 445-46, 132 S. Ct. 1690, 182 L. Ed. 2d 704 (2012). Following *Kappos*, we held that new evidence may be admitted “without regard to whether the issue was raised before the Board.” *Troy v. Samson Mfg. Corp.*, 758 F.3d 1322, 1325 (Fed. Cir. 2014). Under these holdings, § 145 actions open the door to new evidence and arguments. Fairness dictates that the door must also remain open for the PTO to assert its meritorious defenses under the circumstances, including prosecution laches. Moreover, reserving the prosecution laches determination for infringement actions, but not § 145 actions, would harm the public’s interest by allowing a patentee to enforce a patent that could have been barred for prosecution laches in an earlier § 145 action. While the PTO’s failure to previously warn the applicant or reject claims based on prosecution laches may be considered as part of the totality of the circumstances in determining prosecution laches, it does not bar the PTO from asserting the defense in a § 145 action.

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C

We turn next to the district court's decision on prosecution laches. We conclude that the district court misapplied the legal standard for prosecution laches in several respects. We address each in turn.

Totality of the Circumstances

The district court failed to properly consider the totality of the circumstances. The court stated that “th[e] totality principle does not apply in a manner as to require this Court to account for the entirety of the prosecution history of each related application from its inception to final disposition.” *Iancu*, 332 F. Supp. 3d at 131. The district court then focused predominantly on the PTO's role in the prosecution of Hyatt's four applications at issue and repeatedly discounted or ignored evidence showing that Hyatt's conduct caused unreasonable and unexplained delay. *See Iancu*, 332 F. Supp. 3d at 122-39.

For example, the district court ignored evidence of Hyatt's pattern of rewriting or shifting claims midway through prosecution in applications other than the four at issue in this case because that claim shifting “long postdate[d] the close of prosecution” of the four applications at issue here. *Id.* at 129-30. The court later concluded that the PTO's claim shifting evidence failed to meet the PTO's burden because “it is ‘not unusual to see a few claims rewritten’” and because “the PTO accepted the amendments and continued examination” of the applications in question. *Id.* at 137 (citation omitted).

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The court also refused to consider evidence of Hyatt’s pattern of prosecution conduct after 2012, when the PTO resumed prosecution of Hyatt’s applications. *Id.* at 132. It explained that it “ascribe[d] no weight to the subsequent prosecution history of other applications not before the Court following the onset of litigation in these matters.” *Id.* The district court likewise reasoned, “That the PTO finally, in 2015, got fed-up enough with the difficulties of examining Mr. Hyatt’s claims that it began issuing prosecution laches rejections, does not itself have any relevance to this Court’s treatment of the applications’ respective prosecution histories through 2002.” *Id.* at 136-37.

The district court also discounted evidence of Hyatt’s October 1995 agreement with Director Godici because the parties “did not reach any agreement that the Court can now enforce.” *Id.* at 135. The district court further gave “little weight” to the fact that, in recent years, the PTO has spent more than \$10 million administering Hyatt’s applications whereas Hyatt has spent approximately \$7 million in fees. *Id.* at 137.

In addition, the court discounted evidence that Hyatt had filed four claims that he had already lost in interference proceedings. The court explained that this “unreasonable conduct as to four allegedly illustrative claims does very little to move the ball in consideration of the totality of Mr. Hyatt’s conduct across approximately 115,000 claims.” *Id.* at 138.

These examples of discounting or ignoring evidence—indeed swaths of evidence in certain situations—regarding

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Hyatt’s prosecution conduct as a cause for delay illustrate that the district court failed to follow this court’s guidance on considering the totality of the circumstances. We have explained that “an examination of the totality of the circumstances, including the prosecution history of all of a series of related patents and overall delay in issuing claims, may trigger laches.” *Symbol Technologies II*, 422 F.3d at 1386. Rather than consider the relevant evidence of conduct causing delay across Hyatt’s GATT Bubble applications—which overlapped, for example, in subject matter, claim scope, and priority disclosures, and were filed together as photocopies of a small group of applications—the district court erred in considering only the period up to 2002 and erred insofar as it focused its analysis on the four specific applications at issue in this case to the exclusion of Hyatt’s other GATT Bubble applications. The district court did not appreciate the PTO’s evidence as that of a consistent pattern of conduct across an enormous body of similar applications. The district court’s review of the evidence did not, therefore, encompass the totality of the circumstances.

Undue Emphasis on the PTO’s Conduct

The district court further applied an incorrect legal standard in a way that affected its entire decision: Rather than analyze the evidence to determine whether Hyatt’s conduct warrants a finding of prosecution laches, the court repeatedly placed blame on the PTO for the slowness with which Hyatt’s applications were prosecuted.

We have explained that “a delay by the PTO cannot excuse the appellant’s own delay.” *Bogese*, 303 F.3d at

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1369. Although the district court gave lip service to this principle, it effectively used the “totality of the circumstances” standard as a vehicle for blaming the PTO for the prosecution delays. *See, e.g., Iancu*, 332 F. Supp. 3d at 122 (stating that “under the totality of circumstances test[, the] PTO’s actions and omissions can likewise be considered in determining the reasonableness of any delay actually attributable to the applicant”); *see also id.* at 132 (stating that the totality of circumstances includes “the greater context of his interactions with PTO, and the agency’s actions or failures to act, of which the near-decade of suspended examination is but one example”). Notably, the district court cited no legal authority supporting its emphasis on the PTO’s actions and inactions.

Specifically, the district court faulted the PTO for using its normal procedures when examining Hyatt’s applications. *Id.* at 132-33. The court reasoned that the atypical nature of Hyatt’s GATT Bubble applications “required [the PTO] to employ and embrace atypical procedures for addressing the challenge before them.” *Id.* at 133. There is no legal requirement, the court explained, for the PTO to be “wedded” to its policy of using compact prosecution. *Id.* The court placed responsibility squarely on the PTO for the fact that processing Hyatt’s applications was like trying to fit a “large proverbial square peg” into “the rounded-out and well-trodden hole of its 3,000 page practice manual.” *Id.* at 134.

The district court also erroneously found that the PTO is solely responsible for the suspension of prosecution from 2003 to 2012—which the PTO did not rely on to prove delay. *See id.* at 131. It reasoned that the PTO’s

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stipulation on that score “functions as an admission that the PTO shoulders responsibility for the delay during that period.” *Id.* But the PTO’s stipulation, which was offered by the PTO but not ultimately agreed upon by the PTO and Hyatt, was an attempt by the PTO to streamline the trial. Appellant’s Br. 17 n.4. The PTO argues, persuasively, that the “period was directly attributable to Mr. Hyatt’s numerous challenges to USPTO procedures because, depending on the outcome of those cases, time the USPTO spent examining roughly 400 pending applications could have been rendered meaningless.” *Id.*

The court also faulted the PTO for not taking actions that it could have taken during the restricted period the court considered, i.e., up to 2002. It pointed out that the “PTO had ample opportunity over many years to act to resolve its difficulties through formal means” instead of “await Mr. Hyatt’s help, which, it appears obvious, was not forthcoming.” *Iancu*, 332 F. Supp. 3d at 134. Because it did not use more “formal means,” the district court explained, the PTO failed to give Hyatt adequate notice and opportunity to cure “the allegedly offensive conduct.” *Id.* The district court also relied on the fact that the PTO did not “take action to enforce compliance with the informal agreements it now argues it had with Mr. Hyatt.” *Id.* at 135. Summing up, the court stated that “the PTO itself did nothing to police the conduct they now complain of for the better part of two decades.” *Id.* at 137.

While faulting the PTO in the ways described above, the district court repeatedly emphasized the broad latitude and discretion that applicants including Mr. Hyatt have

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in prosecuting their applications as they choose within the law and PTO regulations. *See, e.g., id.* at 134 (stating that Hyatt had “discretion as to how to prosecution [his] claims”). According to the court, Hyatt would have assisted the PTO if it were “in Mr. Hyatt’s interest to” do so, and Hyatt should not be penalized for choosing “instead to pursue his own private enterprise while the bureaucracy fulfills its duties to the applicant and to the public.” *Id.* Similarly, the court explained that, although Hyatt “could have’ been more helpful during the examination process,” “there is no abstract requirement for a citizen to tailor his conduct in pursuit of his constitutional right to a patent, to conform to what is ‘feasible’ for the agency.” *Id.* at 135. However, the doctrine of prosecution laches itself—the subject of the district court’s analysis—is one example of an obligation to tailor prosecution conduct in pursuit of patent rights.

In the above ways, the district court erred by improperly focusing the analysis on the PTO’s conduct rather than Hyatt’s conduct. It is not the case that an applicant may prosecute his patents however he or she wishes within the statute and PTO regulation, because the doctrine of prosecution laches places an additional, equitable restriction on patent prosecution conduct beyond those imposed by statute or PTO regulation. An applicant must therefore not only comply with the statutory requirements and PTO regulations but must also prosecute its applications in an equitable way that avoids unreasonable, unexplained delay that prejudices others. *See Cancer Research*, 625 F.3d at 729.

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Further, the PTO's conduct may be considered in the totality of circumstances, but its delay "cannot excuse the [applicant's] own delay" in prosecution. *Bogese*, 303 F.3d at 1362. Indeed, the patent statute already deals with delay by the PTO when it provides for patent term adjustment to account for that delay. *See* 35 U.S.C. § 154(b); *Supernus*, 913 F.3d at 1353. The PTO's delay therefore provides a weak reason to negate prosecution laches, which asks a separate question of whether the patent should issue, or if issued is enforceable, in light of the applicant's prosecution conduct.

Nor does the PTO's failure to adopt special procedures to accommodate extreme prosecution conduct negate prosecution laches. The PTO is entitled to adopt rules and practices to efficiently administer the patent examination system set up by the patent statute. Requiring the PTO to adopt tailored approaches to make sure that each applicant that delays, is unresponsive, or is otherwise outside normal prosecution conduct successfully progresses through prosecution would impose obligations on the PTO not contemplated by the statute. The applicant is in the driver's seat and must take care to avail itself of the PTO's beneficial patent examination process as it stands and in a way that avoids undue delay leading to prejudice imposed on others. Here, the PTO's instructions to, for example, provide written description support and priority date support, its instructions to demarcate the applications, its creation of a new art unit, and its issuance of atypical Requirements demonstrate that the PTO did not stand back and do nothing, but rather it notified Hyatt of its own obligations and requirements and thereby gave him

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the opportunity to avoid prosecution laches. Prosecution laches does not strictly require formalized notice, warnings, or office actions, although those may well lend support to a prosecution laches finding.

In sum, the district court's restricted view of the record, as well as its overemphasis on the PTO's actions and inactions and its repeated excuse of Hyatt's prosecution conduct, amounted to a misapplication of the legal standard governing prosecution laches. We clarify, consistent with the above discussion and our past precedent, that prosecution laches considers the totality of circumstances, *Symbol Technologies II*, 422 F.3d at 1386, and that the PTO's delay does not excuse an applicant's delay, *Bogese*, 303 F.3d at 1369.

D

We turn to the question of whether the PTO's prosecution laches evidence and arguments presented at trial are enough to shift the burden to Hyatt. We hold that they are.

Unreasonable and Unexplained Delay

Whether an applicant's delay is unreasonable depends on the specific circumstances. *A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1032 (Fed. Cir. 1992), *overruled on other grounds by SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 197 L. Ed. 2d 292 (2017); *see also Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 988

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F.2d 1157, 1162 (Fed. Cir. 1993) (“The reasonableness of the behavior of the person against whom laches is asserted depends on the facts of the particular case.”).

As described above, the trial record shows that Hyatt filed 381 applications during the GATT Bubble—the most of any filer. Each application was a photocopy of one of 11 earlier parent applications, and each had a small set of claims, many of which were identical to each other. Simply put, Hyatt’s applications were placeholders. Director Godici then met with Hyatt instructing Hyatt to focus each application on a separate invention, and Hyatt agreed. Since then, Hyatt has expanded his claim count to at least 115,000, an average of about 300 per application.

The magnitude of Hyatt’s delay in presenting his claims for prosecution suffices to invoke prosecution laches. On multiple occasions, the Supreme Court has found patents unenforceable based on eight- and nine-year prosecution delays. *See, e.g., Woodbridge*, 263 U.S. at 53, 56 (nine-and-a-half-year delay); *Webster Electric*, 264 U.S. at 465 (eight-year delay); *see also Bogese*, 303 F.3d at 1369 (eight-year delay). The PTO presented evidence establishing that Hyatt’s four applications at issue claimed priority to applications filed in the early 1970s and 1980s, meaning that Hyatt delayed between 12 to 28 years to present his claims for prosecution. In fact, the PTO presented additional evidence that Hyatt had delayed similar amounts across all his GATT Bubble applications. The following table presented at trial, for example, demonstrates Hyatt’s delay across all pertinent applications:

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| Hyatt Patent Application Family | Number of Pending Applications | Range of Filing Dates of Pending Applications | Earliest Claimed Priority Date | Earliest Identical Specification |
|---------------------------------|--------------------------------|---|--------------------------------|----------------------------------|
| 4 | 18 | Nov. 9, 1977 – June 6, 1995 | Dec. 28, 1970 05/101.881 | Nov. 9, 1977 05/849,812 |
| 8 | 16 | May 3, 1995 – June 5, 1995 | Dec. 28, 1970 05/101.881 | Dec. 2, 1988 07/279,592 |
| 7 | 30 | Apr. 3, 1986 – Apr. 21, 1995 | Dec. 28, 1970 05/101.881 | April 7, 1986 06/849,243 |
| 11 | 22 | Dec. 3, 1987 – May 31, 1995 | Dec. 28, 1970 05/101.881 | Dec. 3, 1987 07/128,659 |
| 10 | 100 | Dec. 22, 1988 – Dec. 6, 2004 | Oct. 17, 1984 06/661,649 | Dec. 22, 1988 07/289,355 |
| 2 | 19 | Mar. 30, 1990 – June 6, 1995 | Nov. 24, 1969 04/879,293 | Dec. 27, 1989 07/457,451 |
| 6 | 30 | Oct. 10, 1989 – June 1, 1995 | Dec. 28, 1970 05/101.881 | Oct. 10, 1989 07/419,911 |
| 12 | 44 | May 1, 1995 – June 6, 1995 | Feb. 14, 1975 05/550,231 | Mar. 22, 1993 08/034,627 |
| 9 | 67 | Sept. 20, 1991 – Jan. 19, 1996 | Nov. 24, 1969 04/879,293 | June 15, 1983 06/504,691 |
| 1 | 10 | Mar. 13, 1990 – June 6, 1995 | Dec. 28, 1970 05/101.881 | Mar. 13, 1990 07/493,061 |
| 5 | 30 | May 25, 1989 – May 31, 1995 | Dec. 28, 1970 05/101.881 | May 25, 1989 07/357,570 |

J.A. 30211.⁹

Hyatt disputes that the claims at issue were delayed 12 to 28 years. Relying on the latest possible priority dates, Hyatt argues that he delayed only seven to 11 years to file the four applications at issue and between 10 and 19 years before presenting the claims now in dispute. *See* Appellee’s Br. 27; Appellant’s Response and Reply Br. 7. Even accepting Hyatt’s arguments on this score, these quantities of time are enough to trigger prosecution laches. *See, e.g., Woodbridge*, 263 U.S. at 53, 56; *Webster Electric*, 264 U.S. at 465; *Bogese*, 303 F.3d at 1369.

Beyond merely the magnitude of Hyatt’s delay in filing his claims, Hyatt adopted an approach to prosecution that

9. This table includes the four Hyatt applications at issue in this case: the ’639 application is in family 8; the ’211 and ’398 applications are in family 10; and the ’062 application is in family 12.

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all but guaranteed indefinite prosecution delay. The PTO presented evidence at trial demonstrating that multiple characteristics of Hyatt's application and claim web, when combined, made it effectively impossible for the PTO to process them.

For one, the applications claim priority to a large number of earlier applications, creating a large number of possible priority dates. This reality frustrated the examiners' ability to take the preliminary step of identifying the relevant body of prior art for purposes of examining the claims. *E.g.*, J.A. 29425-26.

Exacerbating this problem was the length and complexity of both the specifications themselves and those of the priority applications. As Mr. Morse testified, it was not enough for an examiner to merely find a claim element or group of claim elements in a claimed priority reference; instead, the examiner had to identify the particular interconnection of elements claimed, which was extraordinarily difficult and time consuming. J.A. 29435-36, 29544, 29570-71. Notably, the PTO did not digitize its files until 2003, so before that point examiners needed to wade through large stacks of paper to determine, for example, written description or the priority date. J.A. 29419-20 ("You would have 30-foot high stacks you would be comparing against each other looking for double patenting."). Even in determining written description long after the documents became digitized, the district court noted that it took "many weeks of trial," relying "heavily upon the new evidence presented at trial, in the form of expert testimony," to make the written description

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findings. J.A. 87 n.22. Despite these challenges' obvious effect of delaying prosecution, Hyatt went many years failing to identify written description support for his claims. *See, e.g.*, J.A. 36700-01.

Hyatt also engaged in a pattern of filing amendments adding hundreds of claims to each application, effectively starting examination from the beginning. *See, e.g.*, J.A. 31869-72. Many of these claims were not unique; instead Hyatt repeatedly filed identical or patentably indistinct claims across different applications. *See, e.g.*, J.A. 31874-84. Hyatt further frustrated examiners by engaging in a pattern of rewriting claims entirely or in significant part midway through prosecution, thereby, again, restarting examination. *E.g.*, J.A. 29550-51.

All of the above patterns of prosecution conduct created a perfect storm that overwhelmed the PTO. *See, e.g.*, J.A. 29981-83. It was virtually impossible for examiners to perform a double patenting analysis. *See, e.g.*, J.A. 29912. The same was true, as already mentioned, with respect to determining priority dates and identifying written description support. The PTO's witnesses testified that Hyatt's approach to prosecution was unique and created an "extreme situation" at the PTO. *E.g.*, J.A. 29417-21, 29467-68, 29471-73, 29893, 29980-81.

The PTO also showed that Hyatt had engaged in specific, exemplary acts during prosecution that were patently unreasonable. For example, Hyatt filed claims that he had previously lost in interference proceedings. *Iancu*, 332 F. Supp. 3d at 138. Whether Hyatt did so purposely is

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not material because these actions suggest, at a minimum, that his prosecution approach had overwhelmed even his own ability to manage his applications and claims.

We also conclude that no reasonable explanation has been shown to justify Hyatt's prosecution approach. As the record shows, Hyatt agreed with Director Godici in October 1995 to demarcate his applications, but he then did precisely the opposite to an extreme degree. Twenty years later, Hyatt acknowledged he lacked a "master plan" for demarcating his applications. *Iancu*, 332 F. Supp. 3d at 132 n.12; J.A. 204921. Any goal Hyatt may have had of, for example, correctly capturing his inventions or steering clear of prior art, as Hyatt argued at the dismissal stage, could not come close to justifying the particular, multi-faceted approach he took to prosecution when viewed in its entirety. *See, e.g.*, Pl.'s Opp. to Def.'s Mot. to Dismiss for Prosecution Laches at 12, *Hyatt v. Matal*, No. 1:05-cv-02310-RCL (D.D.C. Jan. 9, 2017), ECF No. 101. Nor can the contention that some or all of Hyatt's conduct was not literally violative of law or PTO regulation provide an adequate explanation under these circumstances. *See id.* Hyatt's conduct—including his delay in presenting claims, his creation of an overwhelming, duplicative web of applications and claims, and his failure to cooperate with the PTO—was a clear abuse of the patent system, even if it did not literally violate regulations or statutory provisions.

When the above circumstances are considered in their totality, we believe the conclusion is inescapable that the PTO satisfied its burden of proving that Hyatt engaged

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in unreasonable and unexplainable delay, as prosecution laches requires. Hyatt's pattern of conduct resembles, but goes well beyond, Bogese's consistent pattern of receiving a rejection on an application, filing a continuation application without any amendments, and abandoning the original application. *Bogese*, 303 F.3d at 1364-65. Hyatt's time-wasting process obstructed the PTO from examining not only Hyatt's four applications at issue, but nearly all of his GATT Bubble applications.

Prejudice¹⁰

This case requires us to address the prejudice requirement of prosecution laches for the first time in a case where the PTO asserts the defense in a § 145 action. Our precedent to date establishes that, to prove prosecution laches in the context of an infringement action, an accused infringer must prove prejudice attributable to the patentee's delay. *Cancer Research*, 625 F.3d at 729. Proving prejudice in that context requires proving intervening rights, i.e., "that either the accused infringer or others invested in, worked on, or used the claimed technology during the period of delay." *Id.*

10. Although the parties briefed the prejudice element of prosecution laches during the district court action, the district court did not squarely address the issue in its order on prosecution laches. *See generally Iancu*, 332 F. Supp. 3d at 113-39; *see also* Def.'s Mot. to Dismiss for Prosecution Laches at 41-43, *Hyatt v. Matal*, No. 1:05-cv-02310-RCL (D.D.C. Nov. 22, 2016), ECF No. 91; Pl.'s Opp. to Def.'s Mot. to Dismiss for Prosecution Laches at 27-29, *Hyatt v. Matal*, No. 1:05-cv-02310-RCL (D.D.C. Jan. 9, 2017), ECF No. 101.

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In the context of laches, we have held that a delay of more than six years raises a “presumption that it is unreasonable, inexcusable, and prejudicial.” *Wanlass v. Gen. Elec. Co.*, 148 F.3d 1334, 1337 (Fed. Cir. 1998). That presumption shifts the burden to the patentee to prove that “either the patentee’s delay was reasonable or excusable under the circumstances or the defendant suffered neither economic nor evidentiary prejudice.” *Id.* Presumptions of fact such as this “have been created to assist in certain circumstances where direct proof of a matter is for one reason or another rendered difficult.” *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1581 (Fed. Cir. 1984), *overruled on other grounds by Richardson-Merrell, Inc. v. Koller*, 472 U.S. 424, 105 S. Ct. 2757, 86 L. Ed. 2d 340 (1985). Presumptions “arise out of considerations of fairness, public policy, and probability, and are useful devices for allocating the burden of production of evidence between the parties.” *Id.*

Hyatt argues that the district court’s decision should be affirmed because the PTO did not adequately prove intervening rights. Appellee’s Br. 56. The PTO responds that the intervening rights requirement does not apply to the PTO in the context of a § 145 action to obtain a patent. Appellant’s Response and Reply Br. 36-37. Consistent with both *Cancer Research* and *Wanlass*, we now hold that, in the context of a § 145 action, the PTO must generally prove intervening rights to establish prejudice, but an unreasonable and unexplained prosecution delay of six years or more raises a presumption of prejudice, including intervening rights. Applying these principles, we conclude that the PTO’s demonstration of an unreasonable and

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unexplained delay by Hyatt, which exceeds six years by any measure, shifts the burden to Hyatt to prove lack of prejudice.

We further hold that, where a patent applicant has committed a clear abuse of the PTO's patent examination system, the applicant's abuse and its effects meet the prejudice requirement of prosecution laches. A clear abuse of the patent system occurs when, for example, the applicant's conduct unduly increases the administrative burden on the PTO and thereby effectively taxes everyone using the system. Such abuse also demonstrates a dangerous likelihood that the applicant is harming the public's interests more broadly, diminishing the patent system's benevolent nature, and stifling innovation and creativity in the useful arts. In rare circumstances like these, an applicant's conduct and its effects on the PTO can alone suffice to prove prejudice for purposes of the prosecution laches defense in a § 145 action.

We conclude that the PTO has carried its burden of proving that Hyatt engaged—intentionally or not—in a clear abuse of the PTO's patent examination system that contributed to delay in the four applications at issue. Barring significant evidence to the contrary from Hyatt, the PTO has therefore demonstrated material prejudice. Hyatt's approach to prosecuting his GATT Bubble applications made it impossible for the PTO to process them using its normal compact prosecution procedures. The PTO created an art unit to deal specifically with his applications and began using atypical procedures to ascertain the information needed to process the

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applications. The PTO spent approximately \$10 million administering Hyatt's applications over a period of about five years—during which Hyatt paid only \$7 million in fees. *Iancu*, 332 F. Supp. 3d at 137. The new art unit was capable of examining about 900 typical applications per year but could not come close to that number when examining Hyatt's applications. J.A. 31885. According to PTO data, a typical examiner could prepare an office action for a typical application in two to three days, but each office action for Hyatt's applications took approximately four months. J.A. 31885-86. The PTO therefore estimated that it would take 532 years of examiner time to complete the prosecution of his roughly 400 applications, during which it could complete over 40,000 typical applications. J.A. 31886.¹¹ These exemplary figures, combined with the details surrounding Hyatt's pattern of prosecution conduct, show that the PTO has carried its burden of proving that Hyatt's prosecution of his applications clearly abused the PTO's patent examination system and that that clear abuse contributed to the delay that occurred with respect to the four applications at issue. Under our holdings above, this abuse may establish prejudice for prosecution laches purposes.

11. The PTO's expert additionally opined, based on PTO data, that the average GATT Bubble application undergoes three office actions, while Hyatt's have undergone on average 15.7 office actions. J.A. 39279. He also opined that comparing each of Hyatt's 115,000 pending claims to each other to determine double patenting would require 6.6 billion comparisons, and that, assuming one minute per comparison, that analysis would take over 12,000 years. J.A. 39280.

*Appendix E***DISPOSITION**

In certain circumstances this court and our sister circuits have retained jurisdiction over appeals and held them in abeyance pending resolution of a limited issue. *See, e.g., Tempur-Pedic Mgmt., Inc. v. FKA Distrib. Co.*, 481 F. App'x 615 (Fed. Cir. 2012); *Endo Pharms. Inc. v. Teva Pharms. USA, Inc.*, 729 F. App'x 936, 938 (Fed. Cir. 2018); *Patel v. Haro*, 443 F. App'x 17, 18 (5th Cir. 2011) (“We retain jurisdiction over the appeal except for the purposes of the limited remand.”); *Sickle v. Torres Advanced Enter. Sols., LLC*, 653 F. App'x 763, 764 (D.C. Cir. 2016) (“[T]his case will be held in abeyance pending resolution of the limited jurisdictional question on remand.”); *United States v. Hinojosa-Bencomo*, 7 F.3d 1045 (10th Cir. 1993) (“We retain jurisdiction over the balance of this case and hold in abeyance our judgment pending resolution of *United States v. Nichols*.”); *Hayden v. Pataki*, 449 F.3d 305, 371 (2d Cir. 2006); *Carnegie Mellon Univ. v. Schwartz*, 105 F.3d 863, 867 (3d Cir. 1997). Consistent with this precedent, and given the potential for the prosecution laches issue to resolve the entire case at hand, we retain jurisdiction over the appeal with respect to the anticipation and written description issues, and we remand to the district court for the limited purpose of affording Hyatt the opportunity to present evidence on the issue of prosecution laches, consistent with the standards set forth in this opinion. *See Int'l Union, United Auto., Aerospace & Agric. Implement Workers of Am., UAW v. Mack Trucks, Inc.*, 917 F.2d 107, 110-11 (3d Cir. 1990) (“[A] defendant moving for a directed verdict retains the right to present evidence against the

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plaintiff's case whether its motion is denied at the trial or appellate level.”).

On remand, the district court should bear several points in mind. First, regarding the unreasonable and unexplained delay requirement of prosecution laches, the record shows that Hyatt has already proffered a number of reasons for his delay, including that he timely completed examination four applications at issue; that his conduct during prosecution of his other GATT Bubble applications is irrelevant to the prosecution laches analysis; that he filed his GATT Bubble applications to cover a number of inventions he believed he had made; and Hyatt met statutory requirements and followed the PTO's rules in prosecuting his applications. We conclude that, under the circumstances of this case, these reasons without more are insufficient as a matter of law to negate that Hyatt's delay was unreasonable and unexplained. To carry his burden, Hyatt must show by preponderance of evidence that Hyatt had a legitimate, affirmative reason for his delay. Such a reason must operate to excuse Hyatt from responsibility for the sizable undue administrative burden that his applications have placed on the PTO in its efforts to process Hyatt's applications, which the record before us demonstrates to be extreme. More specifically, any satisfactory reason must, at a minimum, justify Hyatt's decision to ignore Director Godici's instruction to demarcate his applications in 1995; justify his decision to adopt the specific prosecution approach that he did—unique in its scope and nature—as detailed in the PTO's Requirements; and justify his failure to develop a plan

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for demarcating his applications over at least the 20 year period from 1995 to 2015, *see, e.g.*, J.A. 204921. Any reasons that fall short of justifying those decisions or omissions fail to negate that his delay has been unreasonable and unexplained. We can divine no reason in the record currently before the court that would suffice, but Hyatt is entitled as a matter of fairness to present evidence and be heard on this issue.

In determining whether Hyatt's delay has caused prejudice, the district court should bear in mind that, as we explain above, Hyatt's delay of more than six years, by any measure, shifts the burden to Hyatt to prove that Hyatt's delay has not caused the PTO or any third party material prejudice. The district court should also bear in mind our conclusion above that the PTO has carried its burden of proving that Hyatt's prosecution conduct amounted to a clear abuse of the PTO's patent examination system, which may alone suffice to satisfy the prejudice requirement of prosecution laches. The record before us shows, for example, that the PTO has created a distinct art unit for Hyatt's applications; that the PTO has recently spent millions more dollars processing Hyatt's applications than Hyatt has paid in fees; that examiners have spent inordinate amounts of time preparing office actions; and that the PTO has resorted to special, customized procedures involving its Requirements to process Hyatt's applications. We again cannot guess what might negate this evidence of prejudice. But be that as it may, we recognize that Hyatt is entitled to present evidence that his delay did not cause prejudice.

*Appendix E***CONCLUSION**

The PTO carried its burden of proving prosecution laches, and the district court erred in granting Hyatt's Rule 52(c) motion for judgment on partial findings. We vacate the district court's grant of the motion, and we remand for the district court to conduct further proceedings, as promptly as possible consistent with principles of fairness, affording Hyatt the opportunity to present evidence on prosecution laches. We hold in abeyance this appeal with respect to the issues of anticipation and written description pending the district court's remand decision on prosecution laches. We have considered the parties' remaining arguments and do not find them persuasive or do not reach them. For the above reasons, we vacate-in-part and remand for further proceedings consistent with this opinion.

VACATED-IN-PART AND REMANDED

Costs

No costs.

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**APPENDIX F — MEMORANDUM OPINION,
FINDINGS OF FACT, AND CONCLUSIONS OF LAW
OF THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA,
FILED AUGUST 1, 2018**

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 05-2310 (RCL)
Civil Action No. 09-1864 (RCL)
Civil Action No. 09-1869 (RCL)
Civil Action No. 09-1872 (RCL)

GILBERT P. HYATT,

Plaintiff,

v.

ANDREI IANCU,

Defendant.

**MEMORANDUM OPINION, FINDINGS OF FACT,
AND CONCLUSIONS OF LAW**

I. BACKGROUND

Before the Court is the defendant's asserted affirmative defense of prosecution laches in the four above-captioned cases. Prosecution laches is an equitable doctrine that can hold patents unenforceable when an applicant engages in unnecessary and unexplained delays in prosecuting a

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patent. See *In re Bogese*, 303 F.3d 1362, 1367 (Fed. Cir. 2002); *Symbol Technologies, Inc. v. Lemelson Medical*, 277 F.3d 1361, 1365-66 (Fed. Cir. 2002) (*Symbol Techs. I*); *Woodbridge v. United States*, 263 U.S. 50, 56, 44 S. Ct. 45, 68 L. Ed. 159, 59 Ct. Cl. 952, 1924 Dec. Comm'r Pat. 534 (1923) (“It is a case of forfeiting the right to a patent by designed delay.”).

Plaintiff Gilbert P. Hyatt is a prolific inventor who has received more than 70 issued patents and has pending nearly 400 patent applications before the United States Patent and Trademark Office (PTO), the federal agency responsible for examining patent applications and for granting U.S. patents. 35 U.S.C. § 1 et seq. Andrei Iancu is the named defendant in these matters in his official capacity as the Under Secretary of Commerce for Intellectual Property and the Director of the PTO.¹ Because of the nature and lengthy history of the actions at-hand, throughout this opinion the Court refers to the defendant as “PTO.”

Mr. Hyatt brought these actions pursuant to 35 U.S.C. § 145 to obtain patents on four of his patent applications following decisions in the Board of Patent Appeals and Interferences, now known as the Patent and Trial Appeal Board (the “Board”).² Section 145 allows an applicant

1. Andrei Iancu has been automatically substituted for Joseph Matal in these actions under Fed. R. Civ. P. 25(d).

2. Case number 05-cv-2310 relates to the 08/457,211 application (the '211 application); No. 09-cv-1864 relates to the 08/456,398 application (the '398 application); No. 09-cv-1869 relates to the

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dissatisfied with the decision of the Board to “have remedy by civil action” in district court, rather than taking an appeal directly to the Federal Circuit.³ *See also Kappos v. Hyatt*, 566 U.S. 431, 132 S. Ct. 1690, 182 L. Ed. 2d 704 (2012). In a series of opinions issued August 23, 2016, the Court found genuine disputes of material fact precluded summary judgment in these matters;⁴ trials on the merits would be required with respect to claims in three of the four applications.

After the Court resolved the summary judgment motions, the PTO moved to dismiss these actions for prosecution laches. Def.’s Mot Dismiss, ECF No. 91. In that set of motions, PTO argued that Hyatt’s conduct in prosecuting these four patent applications, as well as approximately 400 others, called for dismissal. *Id.* at **8-9 (“Mr. Hyatt’s conduct in each application and across his roughly 400 applications has been unreasonable, inexcusable, and warrants dismissal of his pending claims under the equitable doctrine of prosecution laches.”). The PTO stressed that some of the applications claim

08/472,062 application (the ’062, application); and No. 09-cv-1872 relates to the 08/431,639 application (the ’639 application). All docket citations herein are to 05-cv-2310 unless otherwise specified.

3. At the time Mr. Hyatt filed the present cases, venue lay by statute with the District Court of the District of Columbia. In 2011, Congress amended the venue provision of certain patent-related statutes, including § 145, such that suits under those sections are henceforth to be filed in the Eastern District of Virginia. Pub. L. 112-29, §9 (Sept. 16, 2011).

4. *See* ECF No. 75 (05-cv-2310); ECF No. 71 (09-cv-1864); ECF No. 75 (09-cv-1869); ECF No. 72 (09-cv-1872).

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priority to patents over 45 years old, *id.* at *9, and that Hyatt bulk-filed approximately 400 photocopies of eleven applications in the days leading up to the effective date of the General Agreement on Tariff and Trade (GATT) in June 1995.⁵ *Id.* It noted an October 24, 1995 meeting, during which Mr. Hyatt agreed to focus each application on a different invention, *id.* at 21, but that some twenty years later, in 2015, Mr. Hyatt revealed that he never had a “master plan” for amending all 400 applications. *Id.* at **30-31. Mr. Hyatt, on the other hand, argued that the PTO was responsible for extensive delay in adjudicating many of the applications, Pl. Mot. Dismiss, ECF No. 101 at **7-9, and made the case that he was entitled to discovery. *Id.* at **37-38.

On March 16, 2017, the Court found that genuine disputes of material fact required treating the motions to dismiss as if they were for summary judgment, and denied them accordingly. ECF No. 116. With leave of Court, the PTO subsequently amended its answers on leave of the Court to assert prosecution laches as an affirmative defense. ECF No. 123.

The Court set the PTO’s affirmative defense of prosecution laches across all four actions for a bench trial, which also would consider evidence relating to Mr. Hyatt’s approximately 400 pending applications. ECF No. 150. The PTO, bearing the burden of proof on the affirmative defense of prosecution laches and upon agreement of the parties, presented its case-in-chief first.

5. The Court has addressed the GATT in previous memorandum opinions. Information about GATT and its impact on patents is available in those opinions or at the websites of the PTO or WTO.

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During the five trial days beginning October 6, 2017, during which the PTO presented its case in chief, the PTO presented the testimony of three witnesses: Robert A. Clarke, Gregory Morse, and Stephen Kunin, its expert witness. The parties also introduced a number of exhibits.

Mr. Clarke has worked for the PTO for 27 years, and he is currently the editor of the Manual of Patent Examining Procedure (“MPEP”), a 3,000-page collection of guidance material for use by patent examiners in the examination of patent applications. Trial Tr. 75:20-76:14 (Oct. 6, 2017 A.M. Session). He also spent 9 years examining patent applications, wrote an article on patent procedure, taught more than 600 hours of classes to patent examiners, and served in the Office of Patent Legal Administration (which drafts examination guidelines), as Chief of Staff for the PTO, and as an Administrative Patent Judge. Trial Tr. 75:15-78:21, 81:20-83:16 (Oct. 6, 2017 A.M. Session). Mr. Clarke has had no personal involvement in the examination of Mr. Hyatt’s patent applications. In or around 2012, however, Mr. Clarke spent approximately three days reviewing the file histories of approximately 80 of Mr. Hyatt’s patent applications that were then subject to an undue delay action brought by Mr. Hyatt in the United States District Court for the Eastern District of Virginia and offered a declaration attesting to certain facts about those patent applications. *See* Trial Tr. 55:5-56:14 (Oct. 6, 2017 P.M. Session).

Mr. Morse is currently Supervisory Patent Examiner (“SPE”) of Art Unit 2615, which is assigned to examine Mr. Hyatt’s pending patent applications. Mr. Morse has worked at the PTO since 1992 and has been supervising the

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examination of Mr. Hyatt's patent applications since March 2013. Trial Tr. 72:19-75:3 (Oct. 10, 2017 A.M. Session). Before March 2013, Mr. Morse had no involvement in the examination of Mr. Hyatt's patent applications. Trial Tr. 47:14-9:5 (Oct. 11, 2017 P.M. Session).

Mr. Kunin, PTO's retained expert, testified as to PTO patent policy, practice, and procedure, and how the prosecution of the applications at-issue in these cases presented uniquely difficult circumstances for the PTO. Mr. Kunin, an attorney with an engineering background and over thirty years of service in the PTO, rose to very senior positions within the agency, including spending ten years as its Deputy Commissioner for Patent Examination Policy. In that position he provided administrative oversight to and coordinated the activities of several offices within the PTO, and was responsible for the promulgation of patent examination guidelines and training materials. DX-1486 at paras. 7-13. Mr. Kunin offered no opinion as to whether prosecution laches should be applied to Mr. Hyatt's cases.

At the close of the PTO's case-in-chief, Hyatt moved for judgment pursuant to Federal Rule of Civil Procedure 52(c). Hyatt argued four bases for his motion: 1) the PTO did not prove that it provided Mr. Hyatt with adequate warnings of impending laches rejections; 2) the PTO failed to prove any intervening rights of third-parties in the technologies claimed in the present applications; 3) although the PTO may issue laches rejections, no such rejections are at issue in these cases and the Patent Act displaced the equitable remedy of prosecution laches

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in the context of a §145 action; and 4) assuming that an affirmative defense of prosecution laches is available in a §145 action, the PTO failed to meet its burden of proving unreasonable and unexplained delay.

Upon consideration of the evidence and arguments presented during trial and the entire records in these cases, and review of the relevant case law, the Court found the PTO failed to prove unreasonable and unexplained delay that supports a finding of prosecution laches, and accordingly granted Mr. Hyatt's motion on his fourth proffered ground. The present opinion, including the Court's findings and conclusions, is issued pursuant to Federal Rule of Civil Procedure 52(a)(1).⁶

II. LEGAL STANDARD

a. Rule 52(c)

Federal Rule of Civil Procedure 52(c) permits the Court to enter judgment against a party fully heard "on a claim or defense that, under the controlling law, can be maintained or defeated only with a favorable finding on that issue." Fed. R. Civ. P. 52(c). In determining a Rule 52(c) motion, "a district court may not draw any special inferences in favor of the non-movant." *Burke v. Record Press, Inc.*, 951 F.Supp.2d 26, 31 (D.D.C. 2013). However, if

6. In a separate Order, the Court granted PTO's Motion for Leave to File its Corrected Response to Plaintiff's Proposed Findings of Fact and Conclusions of Law [ECF No. 214]. The Court therefore treats ECF No. 214-1 as the PTO's operative Responsive filing.

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the party with the burden of proof has failed to meet that burden by the conclusion of its case-in-chief, the district court is to grant the motion against it. *Cf. id.*

b. Patent Prosecution Laches

Although the government has asserted prosecution laches administratively, *see, e.g., In re Bogese*, 303 F.3d 1362 (Fed. Cir. 2002), and both the government and private party litigants have done so in, *e.g.,* infringement actions, *see, e.g., Woodbridge v. United States*, 263 U.S. 50, 44 S. Ct. 45, 68 L. Ed. 159, 59 Ct. Cl. 952, 1924 Dec. Comm’r Pat. 534 (1923); *Symbol Techs. I*, 277 F.3d 1361 (Fed. Cir. 2002), these four cases are the first in which the PTO has asserted prosecution laches in actions before a district court under 35 U.S.C. §145. “Prosecution laches is an equitable defense.” *Cancer Research Tech. Ltd. V. Barr Labs., Inc.*, 625 F.3d 724, 728 (Fed. Cir. 2010).⁷ In its traditional articulation, the doctrine stands for the proposition that an already issued patent “may be rendered unenforceable if it was obtained after an unreasonable and unexplained delay in prosecution.” *In re Bogese*, 303 F.3d at 1367 (citing *Symbol Techs. I*, 277 F.3d at 1365-66).

A pair of Federal Circuit opinions in 2002 concerning prosecution laches, and a 2012 Supreme Court case articulating district courts’ duties under §145, *Kappos v. Hyatt*, 566 U.S. 431, 132 S. Ct. 1690, 182 L. Ed. 2d

7. This differs from standard laches, which “is an affirmative defense rather than a claim for equitable relief.” *See Foster*, 733 F.2d at 90.

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704 (2012), make clear the Court can consider the PTO’s affirmative defense of prosecution laches here, where the PTO has issued neither a patent nor any laches warnings. In *Symbol Techs. I*, the Federal Circuit upheld a district court’s authority to find prosecution laches in an infringement case. Soon thereafter, that court affirmed the PTO’s authority to assert prosecution laches as a basis for rejecting a patent application. See *In re Bogese*, 303 F.3d at 1367. Because the PTO is empowered to assert prosecution laches administratively, and because litigants may assert the same before district courts, the affirmative defense ought also be available to the PTO in a §145 action. Cf. *id.* (“[W]e see no basis for denying the power to the PTO itself that we have recognized exists in the district courts in infringement actions. It necessarily follows that the PTO has the authority to reject patent applications for patents that would be [otherwise unenforceable].”).

Further, under the Supreme Court’s ruling in *Kappos v. Hyatt*,⁸ district courts can consider new evidence not in the administrative record before the PTO from prosecution of a §145 plaintiff’s antecedent patent application, and “the district court must make a *de novo* finding when new evidence is presented on a disputed question of fact.” 566 U.S. at 434. This mandate for *de novo* findings likewise opens the door to new arguments concerning the evidence in the case, and just as the PTO can accordingly raise new grounds for rejecting a §145 plaintiff’s claims on the merits in response to new evidence presented as to those

8. Mr. Hyatt’s application that gave rise to the *Kappos v. Hyatt* decision, 08/471,702, first litigated in this court, 09-cv-901, has origins and ancestry largely in common with the applications at issue here.

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claims, so too can the PTO raise an affirmative defense for the district court to consider. *See also Troy v. Samson Mfg. Corp.*, 758 F.3d 1322 (Fed. Cir. 2014) (holding that, under *Kappos v. Hyatt*, new issues and arguments may be presented to district courts in §145 and §146 actions). In that vein, the Court here exercised its discretion to allow the PTO to amend its Answer to include an affirmative defense of prosecution laches. ECF No. 122.

Although there is no case directly on-point regarding how a district court should analyze prosecution laches as an affirmative defense in a §145 case, the contours of the doctrine previously articulated in infringement suits and in reviews of agency administrative actions, are instructive. “The doctrine [of prosecution laches] should be applied only in egregious cases of misuse of the statutory patent system.” *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., LP*, 422 F.3d 1378, 1385 (Fed. Cir. 2005) (*Symbol Techs. II*). In other situations not involving *prosecution* laches, the Federal Circuit has cautioned, “The mere passage of time does not constitute laches.” *Advanced Cardiovascular Systems v. Scimed Life Systems*, 988 F.2d 1157, 1161 (Fed. Cir. 1993). The Supreme Court has held the same. *United States v. American Bell Tel. Co.*, 167 U.S. 224, 246, 17 S. Ct. 809, 42 L. Ed. 144, 1897 Dec. Comm’r Pat. 442 (1897) (“The mere fact of delay does not, therefore, operate to deprive the inventor of his legal rights.”). Indeed, lengthy patent application prosecutions have been held not to implicate prosecution laches in many cases. *See, e.g., Cancer Research*, 625 F.3d at 728 (reversing finding of prosecution laches, despite “eleven continuation applications, ten abandonments, and no substantive prosecution for nearly

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a decade”); *Studiengesellschaft Kohle mbH v. Northern Petrochem. Co.*, 784 F.2d 351, 352 (Fed. Cir. 1986) (per curium) (affirming district court’s finding of no laches despite prosecution period that lasted over twenty years); *Regents of the Univ. of Cal. v. Monsanto Co.*, 2005 U.S. Dist. LEXIS 40379, 2005 WL 3454107, *25-26 (N.D. Cal. 2005) (finding the doctrine of prosecution laches inapplicable despite the fact that twenty-four years had passed between the application filing and patent issue); *Koninklijke Philips Electronics N.V. v. Cinram Int’l, Inc.*, 2012 U.S. Dist. LEXIS 135839, 2012 WL 4074419, *7 (S.D.N.Y. 2012) (prosecution laches inapplicable despite nearly 19 years between the application filing and patent issue dates).

Rather than merely calculating the passage of time, delay must be unreasonable and unexplained. To determine this, courts are to look to “the totality of the circumstances, including the prosecution history of all of a series of related patents and overall delay in issuing claims.” *Symbol Techs. II*, 422 F.3d at 1386. Further, prosecution laches principally looks to a patent applicant’s conduct, not his intent; although evidence that an applicant intended to delay issuance of a patent can be relevant, the absence of such intent does not forgive conduct that does, in fact unreasonably and inexplicably delay examination of his application(s). *See, e.g., Woodbridge*, 263 U.S. at 56 (“This is not a case where evidence has to be weighed as to the purpose of the inventor.”).

Finally, whereas in an action between private parties a court will balance equities in its analysis, *see Symbol Techs. II*, 422 F.3d at 1385, the Federal Circuit has

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elsewhere determined that “a delay by the PTO cannot excuse the applicant’s own delay.” *See In re Bogese*, 303 F.3d 1362, 1369 (Fed. Cir. 2002). It is significant that each of those matters is somewhat distinct from the instant cases in their present posture. The *Symbol Techs*, cases involved private parties litigating issued patents, and in *Bogese* the Federal Circuit was reviewing an appeal from the Board’s upholding administratively-issued prosecution laches rejections on an arbitrary and capricious standard.

In a §145 action where the district court is making a *de novo* determination on the evidentiary record before it and not the administrative record of the PTO, its review of the propriety of applicants’ prosecution conduct in a §145 action is not done in light of any presumptions as to the validity of PTO’s earlier actions. To the contrary, the same ground from which this Court derives authority to entertain the PTO’s equity-based affirmative defense in the first instance, *i.e.*, PTO’s broader administrative authority to reject patent applications, is relevant to an equitable inquiry that necessarily concerns, in part, PTO’s failure or otherwise declining to exercise that authority earlier. An adapted standard is therefore appropriate where, as here, a district court is conducting a *de novo* analysis of PTO’s *ex-post* assertion of prosecution laches during litigation, as opposed to during examination in which an applicant may have an opportunity to cure the alleged inequitable conduct in response to an agency’s action or warning. While it remains that any delay by the PTO does not excuse any unreasonable and unexplained delay by the applicant, under the totality of the circumstances test PTO’s actions and omissions can

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likewise be considered in determining the reasonableness of any delay actually attributable to the applicant, and the applicant's explanations therefor.

III. ANALYSIS

The PTO accuses Mr. Hyatt of inequitable prosecution conduct that caused unreasonable and unexplained delay in the examination of his applications. PTO argues, *inter alia*, that the following alleged factors contributed to unreasonable delay in examination: 1) the large number of claims in and across Mr. Hyatt's applications; 2) his amendment practice; 3) his alleged shifting of claims; 4) numerous and complicated priority claims in Mr. Hyatt's applications, including that the claims of priority made it difficult for examiners to identify written description support; 5) difficulties in identifying written description support for Mr. Hyatt's claims due to challenges in identifying priority dates for claims, the length of the applications, the incorporation by reference of other applications, and unclear interconnections among claim elements; 6) double-patenting, duplicate claims, and indistinct claims across the applications, including overlaps with claims in applications pending before the Court; 7) prosecution of claims previously allowed in another application (06/663,094, referred to as 'the '094 application'); 8) reintroducing certain claims previously lost in interference actions; and 9) delay in presenting the claims contained in his 1995 pre-GATT applications, including the four applications pending before this Court, which claim priority to earlier-filed applications.

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The Court does not doubt that Mr. Hyatt’s “GATT Bubble” applications (*i.e.*, those filed in the spring of 1995) have menaced the PTO for decades. They are long, highly technical, and voluminous. But also true, and particularly telling for present purposes, is that many of Mr. Hyatt’s applications spent an inordinate time in a proverbial Never-Never Land, during which he was not allowed under PTO’s procedures to prosecute his applications further, until the PTO took certain actions. As detailed further below and as PTO concedes, ECF No. 214-1 at *29, at least a nine-year period thus does not factor into the Court’s laches analysis.

Unsurprisingly, the PTO’s approach at trial tracked very closely with its earlier motions to dismiss for prosecution laches. ECF No. 91 (05-cv-2310); ECF No. 91 (09-cv-1864); ECF No. 94 (09-1869); ECF No. 93 (09-cv-1872). For example, the PTO spent most of its presentation addressing facts concerning Mr. Hyatt’s approximately 400 applications not otherwise implicated in the four cases before this Court, with a particular and peculiar emphasis on prosecution conduct related to those applications that post-date the filing of the present actions in district court. The obvious rationale for the PTO’s doing so is that PTO apparently understands the Federal Circuit’s totality test to include consideration of all prosecution conduct as to all related applications, without temporal or procedural limitation.⁹ But, for reasons explained below,

9. At the same time, however, the PTO objects to this Court making any findings as to those other 400 applications that are not the subject to any of the four actions here. *See, e.g.*, ECF no. 214-1 at *3, *16. This desire for the Court to consider but not decide matters not directly before it permeated PTO’s entire litigation strategy.

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that sweeping construction cannot reasonably be applied to these cases. The PTO also relies upon representations allegedly made at a meeting with Mr. Hyatt in 1995, but does not adequately establish a corresponding duty by Mr. Hyatt to ease PTO's burden as a result of that meeting. These and other factors are detailed in the Court's findings and conclusions below.

a. Findings of Fact**The Nature of the Cases and Mr. Hyatt's Applications**

Each of the applications at issue in these cases was filed before June 8, 1995, the effective date of the law that changed the term of a patent from 17 years after issuance to 20 years from the application date of the oldest application from which the application claims priority. This change in the U.S. patent term was part of the implementation of the Uruguay Round of the General Agreement on Tariff and Trade ("GATT"). See Trial Tr. 43:8-14:3 (Oct. 6, 2017 P.M. Session); 20:6-14 (Oct. 10, 2017 P.M. Session).

To address circumstances where an applicant had the right under U.S. patent law to file a new patent application to pursue claims described in a specification that had already been filed with the PTO (known as a "continuing application"), Congress required the PTO to promulgate rules to provide applicants further examination of additional patent claims that claim priority from pre-GATT applications without loss of patent term. Pub. L. No. 103-465, sec. 532(a)(1), § 532(a)(2), 108 Stat. 4809, 4984 (1994) (codified as amended at 35 U.S.C. § 154). The

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PTO's rule implementing this legislation is in 37 C.F.R. § 1.129 ("Rule 129"), which was promulgated on April 25, 1995. See 60 Fed. Reg. 20,195, 20,226-27 (Apr. 25, 1995) ("Changes to Implement 20-Year Patent Term and Provisional Applications"); *see also* Trial Tr. 45:18-47:9 (Oct. 6, 2017 P.M. Session) (addressing Rule 129).

To preserve the opportunity to obtain a 17-year term for patents based on pre-GATT applications, many applicants filed a large number of patent applications during the brief period between the promulgation of Rule 129 in April 1995 and the date on which the new patent term law went into effect, June 8, 1995. The surge in applications filed during this period is known as the "GATT Bubble." Trial Tr. 104:17-107:21 (Oct. 6, 2017 P.M. Session).

Mr. Hyatt's GATT Bubble applications filed in 1995, including the four applications pending before the Court, were continuing applications that claim the benefit of earlier-filed parent applications under 35 U.S.C. § 120. Their claims also claim the benefit of the date of the earliest-filed parent application whose specification provides support for the claims.

Mr. Hyatt's GATT Bubble applications differed in number and size from those filed by most other applicants. Mr. Hyatt filed many more applications, with much longer specifications, and many more claims, than most other applicants. The number, volume, length, and complexity of Mr. Hyatt's applications are not ordinary.

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Mr. Hyatt's patent applications, including the four applications pending before the Court, contain lengthy and detailed disclosures, including specifications. The 700-family specification, which forms the basis of the '211 and '398 applications, is comprised of 576 pages of text and 65 pages of figures. PTX-001.05255-5830; PTX-001.05840-905. The 500-family specification, which forms the basis of the '062 application, is comprised of 238 pages and 40 pages of figures. PTX-002.01183-1458. The 600-family specification, which forms the basis of the '639 application, is comprised of 518 pages and 46 pages of figures. PTX-003.01333-1896. "Typical" specifications are 20 or 30 pages. Trial Tr. 23:16 (Oct. 6, 2017 P.M. Session).

Mr. Hyatt's applications, including the four applications pending before the Court, contain unusually large sets of claims. Trial Tr. 79:10-11 (Oct. 10, 2017 P.M. Session) ("[I]t was extremely unusual. I can recall one case that had approximately that number of claims."). The four applications before this Court presented a total of approximately 1,592 claims, including claims that were subsequently canceled by Mr. Hyatt. Trial Tr. 50:6-20 (Oct. 12, 2017 P.M. Session). Across Mr. Hyatt's approximately 400 applications pending before the PTO in 2003, those applications presented a total of approximately 115,000 claims, or on average approximately 300 claims per application. Trial Tr. 68:19-70:9 (Oct. 10, 2017 P.M. Session).

A PTO study of patent applications filed between 1995 and 2013 reveals that the "typical application" contained

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20 claims at the time it was filed. Trial Tr. 78:22-81:19 (Oct. 6, 2017 A.M. Session); 74:2-8 (Oct. 10, 2017 P.M. Session); DX 251. A typical examiner on average is allotted about 20 hours to examine 20 claims. Only 0.02% of all applications filed included more than 299 claims. *See* DX1486 ¶ 162.

The largest technology companies filing GATT Bubble applications did not engage in the same examinational behavior as Mr. Hyatt engaged in. *See, e.g.*, Trial Tr. Day 4 P.M. Session, 29:17-41:15 (describing how 10 large companies filed pre-GATT applications with only 17.7 claims per application, as opposed to Mr. Hyatt's average of 299 claims per application), 55:17-25, Oct. 10, 2017.

The cases before the Court were filed in 2005 and 2009. In accord with a PTO stipulation, *see, e.g.*, 214-1 at *29, the years 2004-2012, a period in which PTO suspended examination of the majority of Mr. Hyatt's applications, is not considered in the present analysis. PTO restarted examination of Mr. Hyatt's remaining applications in 2014. PTO began issuing Requirements that included prosecution laches warnings beginning in April 2015.¹⁰

10. During oral arguments before the Federal Circuit in *Hyatt v. United States PTO*, 797 F.3d 1374 (Fed. Cir. 2015), Judge Moore asked Government counsel, "How could there be 115,000 claims that were filed prior to June 8, 1995, that are still kicking around? . . . If Mr. Hyatt is responsible . . . why aren't you nailing him to the wall with prosecution laches? We handed it to you — why aren't you using it?" *See* oral arg., dkt. 2014-1596, May 6, 2015 40:06 — 44:09. Presumably, Judge Moore was referring to *Bogese* in 2002. PTO issued its first prosecution laches warning in one of Mr. Hyatt's applications nineteen days before that exchange. After oral arguments and up through its filing of its Motion for Leave to

*Appendix F***The Four Applications Before the Court**The '211 Application (Case no. 05-cv-2310)

Mr. Hyatt filed the '211 application on June 1, 1995. PTX-004.07554. The '211 application is a continuation of patent application serial number 07/289,455, filed December 22, 1128, which is a continuation of patent application serial number 06/664,094, filed October 19, 1124. PTX-004.07555. The PTO entered a non-final Office Action rejecting the claims on September 22, 1995, and entered a final rejection made on July 41, 1996. PTX-087.00004. Mr. Hyatt, using the transitional rules provided in 37 C.F.R. § 1.129(a) (“Rule 129(a)”), petitioned to file an amendment, the effective equivalent of a continuing application, on March 25, 1997. PTX-004.06587-89. The PTO issued a non-final Office Action rejecting the claims on August 4, 1912. PTX-087.00004. The PTO entered a final rejection of the claims on August 27, 1999. PTX-087.00004; Trial Tr. 40:12-41:18 (Oct. 11, 2017 P.M. Session). Prosecution concluded in just over four years, when the PTO issued a final rejection from which Mr. Hyatt appealed. PTX-087 (PALM record).

Having been twice rejected, the '211 claims were eligible for an appeal to the Board. *E.g.*, Trial Tr. 6:16-20 (Oct. 13, 2017 P.M. Session); 35 U.S.C. § 134(a). Mr. Hyatt timely noticed his appeal to the Board on February 28, 2000, and he filed his appeal brief on August 28, 2000.

file its Motion to Dismiss for Prosecution Laches in this Court on September 30, 2016, PTO issued fifty-one additional warnings. *See* ECF 81-2 at *21-22.

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PTX-087.00003; Trial Tr. 30:12-41:18 (Oct. 11, 2017 P.M. Session). In the course of its decisions on Mr. Hyatt's appeal and subsequent motion for reconsideration, the Board reversed several rejections by the examiner of the '211 application claims, ending the PTO's administrative adjudication of the '211 application on September 21, 2005. PTX-087.00006. Mr. Hyatt filed suit under 35 U.S.C. § 145 to obtain a patent on claims in the '211 application on which the Board affirmed at least one ground of rejection on November 18, 2005. At that time, jurisdiction passed from the PTO to the United States District Court for the District of Columbia.

The '398 Application (Case no. 09-cv-1864)

Mr. Hyatt filed the '412 application on June 1, 1995. PTX-001.05921. The '398 application is a continuation of patent application serial number 07/289,355, filed December 22, 1995, which is a continuation of patent application serial number 06/663,094, filed October 19, 1994. PTX-001.05921; *see* PTX-004.07555. The PTO entered a non-final Office Action rejecting the claims on September 19, 1995, and a final rejection on August 9, 1996. PTX-001.05184; PTX-001.05184. Mr. Hyatt petitioned to enter a submission pursuant to 37 C.F.R. § 1.129(a) with an amendment, effectively equivalent to a continuation application; the PTO subsequently rejected the then-pending claims in a non-final Office Action on December 12, 2000. PTX-001.04812; PTX-001.04505-06. Mr. Hyatt amended the claims on January 40, 2002. PTX-001.04268-69. On July 31, 2002, January 23, 2003, and August 18, 2003, the PTO suspended prosecution in the

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'412 application for a cumulative total of twenty months ending on February 18, 2004. PTX-001.04812; PTX-001.04246-48; PTX-001.04211-13; Trial Tr. 31:20-33:13 (Oct. 11, 2017 P.M. Session). The PTO issued a non-final Office Action on September 7, 2004. PTX-001.0402426; Trial Tr. 44:6-44:7 (Oct. 11, 2017 P.M. Session).

Mr. Hyatt timely noticed his appeal to the Board on March 7, 2005. PTX-001.03898. He filed his appeal brief on August 26, 2005, thereby closing prosecution. PTX-001.00928; Trial Tr. 34:14-25 (Oct. 11, 2017 P.M. Session). In the course of its decisions on Mr. Hyatt's appeal and subsequent two motions for reconsideration, the Board reversed numerous grounds of rejection found by the examiner of the '398 claims, concluding the PTO's administrative adjudication of the '412 application on July 8, 2009. PTX-086.00007. Mr. Hyatt filed suit under 35 U.S.C. § 145 to obtain a patent on claims on which the Board affirmed at least one ground of rejection on September 25, 2009. At that time, jurisdiction passed from the PTO to the United States District Court for the District of Columbia.

The '062 Application (Case no. 09-cv-1869)

Mr. Hyatt filed the '062 application on June 6, 1995. PTX-002.1223. The '062 application is a continuation of patent application serial number 06/661,649, filed October 17, 1984, through several other continuation applications. PTX-002.1224. The PTO entered a non-final Office Action rejecting the claims on September 18, 1995, and another non-final Office Action rejecting the claims in

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full on June 26, 1996. PTX-088.00004. After Mr. Hyatt amended his claims, the PTO entered a final rejection on October 16, 1997. PTX-088.00003. It therefore took the PTO approximately two years and four months to issue the final rejection of Mr. Hyatt's claims from which he appealed. Trial Tr. 25:7-26:5 (Oct. 11, 2017 P.M. Session).

Mr. Hyatt timely noticed his appeal to the Board on or around March 4, 1998. PTX-002.00891; PTX-088.00006. He filed his appeal brief on September 3, 1998. PTX-002.00557; Trial Tr. 25:7-26:22 (Oct. 11, 2017 P.M. Session). In the course of its decisions on Mr. Hyatt's appeal and three subsequent motions for reconsideration, the Board reversed numerous rejections by the examiner of the '062 claims, concluding the PTO's administrative adjudication of the '062 application on July 8, 2009. PTX-088.00006. Mr. Hyatt filed suit under 35 U.S.C. § 145 to obtain a patent on claims on which the Board affirmed at least one ground of rejection on September 25, 2009. At that time, jurisdiction passed from the PTO to the United States District Court for the District of Columbia.

The '639 Application (Case no. 09-cv-1872)

Mr. Hyatt filed the '639 application on May 1, 1995. The '639 application is a continuation application of patent application serial number 07/279,592, filed December 2, 1992. PTX-003.01380. The PTO entered a restriction requirement requiring Mr. Hyatt to elect one group of claims for examination drawn to one invention on October 19, 1995. PTX-003.01311-13. On July 24, 1996, the PTO rejected the claims in a non-final Office Action. PTX-

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085.00005. The PTO rejected the claims in a final Office Action dated May 19, 1999. PTX-085.00005. It therefore took the PTO just over four years from the filing of the '649 application to issue the final rejection from which Mr. Hyatt appealed to the Board. Mr. Hyatt timely noticed his appeal on October 19, 1999. PTX-085.00005.

Mr. Hyatt filed his Appeal Brief on April 18, 2000, thereby closing prosecution. PTX-085.00005; Trial Tr. 28:2-29:15.7. In the course of its decisions on Mr. Hyatt's appeal and three subsequent motions for reconsideration, the Board reversed numerous rejections by the examiner of the '639 claims, concluding the PTO's administrative adjudication of the '639 application on July 8, 2009. PTX-085.00005. Mr. Hyatt filed suit under 35 U.S.C. § 145 to obtain a patent on claims on which the Board affirmed at least one ground of rejection on September 25, 2009. At that time, jurisdiction passed from the PTO to the United States District Court for the District of Columbia.

PTO's Examination Policy and Practice

PTO's longstanding policy is to engage in "compact prosecution." The goal of compact prosecution is for the examiner to raise every noncumulative ground of rejection or objection that the examiner finds to exist in one office action. *See* Trial Tr. 8:22-9:11; 84:17-85:7 (Oct. 6, 2017 P.M. Session). In general, the practice and policy of compact prosecution is prudent for PTO and patent applicants alike, with the aim of resolving applications as quickly as possible. Trial Tr. 85:8-86:1.

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Patent applicants have discretion as to how to prosecute their claims within the PTO's rules and regulations. The PTO has several legal authorities to regulate inequitable applicant conduct during the examination process. These include undue multiplicity rejections, PTO's Rule 11.18, and 37 C.F.R. §1.145. PTO policy is that, absent entry of a restriction requirement, undue multiplicity rejection, or prosecution laches rejection, applicants are entitled to an examination of the claims presented in a single application, including claims directed to multiple inventions, provided the applicant pays the required fees and complies with the patent statutes. Trial Tr. 15:13-18 (Oct. 10, 2017 A.M. Session); 16:8-22 (Oct. 10, 2017 A.M. Session); 65:14-24 (Oct. 13, 2017 A.M. Session); *see also* Trial Tr. 78:24-79:3 (Oct. 10, 2017 P.M. Session) ("There is no limit to what can be presented.").

Applicants pay for every independent claim in excess of three and for every claim in excess of 20 total claims in accordance with fee schedules set by the Government. Trial Tr. 16:23-17:11 (Oct. 10, 2017 A.M. Session). Mr. Hyatt has paid more than \$7,000,000 in fees to the PTO in recent years to have his applications and claims examined. PTX-099; Trial Tr. 17:2-19 (Oct. 10, 2017 AM Session); 65:9-12 (Oct. 11, 2017 P.M. Session). The PTO's accounting is that Mr. Hyatt paid only approximately \$59 per claim, in light of the fact that an examiner on average was allotted about 20 hours to examine 20 claims. *See* Trial Tr. Day 1 P.M. Session, 31:4-14, 4:9-16, Oct. 6, 2017; Trial Tr. Day 1 A.M. Session, 89:17-20, Oct. 6, 2017. In the past 5 years, the PTO has paid over \$10 million to examine Mr. Hyatt's claims. *See* Trial Tr. Day 4 A.M. Session, 57:1-16, Oct. 12, 2017.

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The time a patent application is pending in the PTO can vary based on factors intrinsic and extrinsic to the application. Intrinsic factors might include: the number of claims presented for examination, the claim amendment practice, claim “shifting,” entitlement to priority and benefit sought by the applicant, written description support issues, double-patenting issues, and other discrete issues raised by the patent office. *See* Trial Tr. 4:6-7:3 (Oct. 12, 2017 P.M. Session). Extrinsic factors generally relate to PTO’s workload and allocation of resources, but also can include an applicant’s willingness to cooperate with PTO examiners’ informal requests during the examination process.

If an applicant wants to show entitlement to the right of priority to establish an earlier effective filing date as against intervening prior art, it is the applicant’s burden to establish that right of priority. *See* Trial Tr. 23:20-24:7 (Oct. 13, 2017 P.M. Session).

Under 35 U.S.C. § 112(1), the test for whether a specification contains an adequate written description of the subject matter claimed in a patent application is whether it enables any person with ordinary skill in the art to make and use the invention. Trial Tr. 22:9-14 (Oct. 10, 2017 P.M. Session). That is a legal determination regularly made in patent application examination. Written description rejections are “fairly common” in PTO practice, with numerous court decisions and specific PTO guidelines addressing such issues. Trial Tr. 97:11-99:5 (Oct. 6, 2017 P.M. Session); 23:4-15 (Oct. 13, 2017 P.M. Session). The PTO can and does address claims that

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it contends lacks written description support through written description rejections. Trial Tr. 97:11-99:10 (Oct. 6, 2017 P.M. Session); 23:4-24:12 (Oct. 13, 2017 P.M. Session). Should the examiner make a written description rejection, the application must then demonstrate that there is adequate written description support for the claims.

Double patenting is relevant to examination to avoid issuing a claim that is substantially similar to another claim that is also under examination and may be subject to a rejection that would be relevant to the other pending claim. The PTO attempts to police double-patenting issues during examination, and issues provisional double-patenting rejections to which applicants respond, when those issues arise in two (or more) pending applications. *See, e.g.*, Trial Tr. Day 1 P.M. Session, 92:5-17, Oct. 6, 2017; Trial Tr. Day 3 A.M. Session, 40:18-41:4, Oct. 11, 2017; Trial Tr. Day 4 A.M. Session, 44:19-45-17, Oct. 12, 2017. Double patenting rejections “may be deferred until allowable subject matter has been indicated. At that time, the allowed claims should be reviewed against all related application claims for any double patenting issues.” PTX-003.00970.

Patent applicants are entitled to traverse rejections, including challenging those decisions before the Board and/or in the courts. Patent applicants are entitled to amend or cancel claims to avoid a ground of rejection.

After a patent application is filed, further mandatory action on the part of the applicant can only be triggered by formal means in accord with PTO regulations.

*Appendix F***Examination and Prosecution of Mr. Hyatt's Applications**

Despite being 4,000 pages long, the PTO's Manual of Patent Examining Procedure does not cover a case such as Mr. Hyatt's. The PTO could not practice its typical and preferred mode of compact prosecution of Mr. Hyatt's claims across 400 lengthy applications. The PTO's policy of compact prosecution made it impossible to complete examination of Mr. Hyatt's applications in its desired manner under the time typically given to examiners. Mr. Hyatt's applications could not be treated as typical applications given their size and scope. *See* ECF No. 214-1 at *9 ("the evidence showed that the applications could not be treated as typical applications given their size and scope") (*citing* Trial Tr. Day 2 A.M. Session, 75:14-77:15, Oct. 10, 2017); *id.* at *40 ("all agree that Mr. Hyatt's applications are far from typical"). The PTO has conceded that it could not engage in compact prosecution with respect to Mr. Hyatt's applications, given their unusual characteristics. *See* ECF no. 214-1 at *8.

Mr. Hyatt attended a meeting in October 1995 with Nicholas Godici, a former PTO group Director, during which they discussed focusing each of his applications on different subject matter. Trial Tr. 54:10-65:3 (Oct. 10, 2017 P.M. Session). At the meeting, Mr. Hyatt agreed to "focus" his claims by increasing the demarcation between applications. Trial Tr. 69:14-70:9 (Oct. 10, 2017 P.M. Session). Neither Mr. Godici nor Mr. Hyatt memorialized the purported agreement in an interview summary, even though doing so is required by PTO rules. Trial Tr. 53:17-

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20 (Oct. 11, 2017 P.M. Session); 14:4-15:1 (Oct. 6, 2017 P.M. Session); 12:25-13:20 (Oct. 10, 2017 A.M. Session). Despite those formal rules, conversations between applicants and examiners, never mind Group Directors like Mr. Godici, are not always memorialized in interview summaries. Trial Tr. Day 2 A.M. Session, 62:10-16, Oct. 10, 2017.

After his conversation with Mr. Godici, Mr. Hyatt proceeded to file petitions to enter amendments in some of his applications. Trial Tr. 53:1-13 (Oct. 11, 2017 P.M. Session). A number of those petitions were denied by Mr. Godici. Trial Tr. 54:3-56:12 (Oct. 11, 2017 P.M. Session); PTX-051; PTX-052. After the October 1995 meeting, the PTO continued examining Mr. Hyatt's applications, rather than make rejections on procedural grounds.

Mr. Hyatt never "focused" his claims in accordance with the informal agreement made during the October 1995 Meeting. In 2015, Mr. Hyatt stated he never had a "master plan" to do so. *See* ECF 81-2 at *23; Trial Tr. 73:7-76:5 (Oct. 11, 2017 A.M. Session).

Mr. Hyatt has made numerous amendments to the claims in his applications, including the four applications pending before this Court. *See* Trial Tr. 68:19-70:9 (Oct. 10, 2017 P.M. Session) (contending Mr. Hyatt submitted 115,000 claims for examination via his amendments); 51:3-56:15 (Oct. 10, 2017 P.M. Session) (testifying regarding amendments in the four applications before the Court); *see also* PTX-001.05167; PTX-001.04951; PTX-001.04812; PTX-001.04268; PTX-002.01180; PTX-002.01102; PTX-002.01111; PTX-003.01314; PTX-003.01257; PTX-

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003.00990; PTX-004.06831; PTX-004.06716; PTX-004.06607; PTX-004.06309; PTX-004.05962; Trial Tr. 50:6-20 (Oct. 12, 2017 P.M. Session) (stating Mr. Hyatt submitted 1,592 claims for examination via amendments). Mr. Hyatt's amendments, in some instances, substantially rewrite claim language and add additional claims. *E.g.*, Trial Tr. 75:13-78:14 (Oct. 10, 2010 P.M. Session) (Morse testimony discussing amendment in the '211 application).

From approximately 1995 through 2003, the PTO issued numerous non-final and final Office Actions on the merits of Mr. Hyatt's patent applications. The PTO issued 13 of Mr. Hyatt's patent applications (between June 1995 and May 1997), and withdrew from issuance 4 applications. For approximately 100 of Mr. Hyatt's applications, the PTO issued rejections that Mr. Hyatt appealed (closing prosecution) and briefed before the Board. *See* PTX-005; PTX-019.00008-9; DX-254; DX-268.

Between approximately 2003 and 2012, 80 of Mr. Hyatt's pending applications were held by PTO in a proverbial Never-Never Land, with no Examiners' Answers filed that, under PTO regulations, were required to trigger Board consideration of Mr. Hyatt's appeals in those applications. PTO has stipulated that this period is not time that can be attributed to Mr. Hyatt's allegedly unreasonable and unexplained delay. *See, e.g.*, ECF No. 214-1 at *29.

The PTO did not issue any prosecution laches warnings as to any of Mr. Hyatt's pending applications prior to the commencement of litigation in these cases,

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although it had authority to do so if it had deemed his conduct so inequitable as to merit it.

The PTO did not reject any of Mr. Hyatt's pending claims under the doctrine of prosecution laches prior to the commencement of litigation in these cases, although it had authority to do so if it had deemed his conduct so inequitable as to merit it.

There is no record of the PTO invoking Rule 11.18 in these applications, nor did the PTO apply undue multiplicity rejections or deny entry of amendments in Mr. Hyatt's applications prior to 2014. More recently, the PTO has issued formal Requirements, laches warnings, and laches rejections as to several of Mr. Hyatt's applications not among the four directly at issue in this litigation.

The PTO did not issue any rejections or otherwise invoke 37 C.F.R. § 1.145 to refuse to enter any amendment prior to 2015. Trial Tr. 59:10-60:1 (Oct. 13, 2017 A.M. Session).

The PTO has shown evidence of so-called "claim shifting," or amending claims in a wholesale way as if to re-write them to refer to or reflect a different invention, without renumbering them, since the agency began issuing Requirements against Mr. Hyatt's remaining applications after reopening prosecution in 2014. *See, e.g.*, DX146 at *25-29. The alleged claim shifts in other applications identified by the PTO long postdate the close of prosecution at the PTO and this Court's assumption of jurisdiction over the four applications pending before the

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Court. *See* Trial Tr. 59:10-60:1 (Oct. 14, 2017 A.M. Session). The PTO has also shown evidence of amendments in the four applications before the Court that it considers to be unusual. *See* DX-050; DX-086; DX-090; DX-103; DX-108; DX-120; DX-208; DX-222; DX-267; Trial Tr. 74:14-91:11 (Oct. 10, 2017 P.M. Session).

The PTO experienced difficulty conducting double-patenting reviews of Mr. Hyatt's applications. Such reviews are typically done in accord with the agency's policy of compact prosecution.

The PTO allowed Mr. Hyatt's claims in 1989 in the '094 application, but Mr. Hyatt chose not to pay for issuance of those claims, and he re-submitted those claims in continuing application 07/289,355 (the '455 application). Trial Tr. 5:17-7:15 (Oct. 10, 2017 P.M. Session). The PTO's expert, Mr. Kunin, testified that Mr. Hyatt chose not to take the allowed claims in the '094 application because he wanted to submit additional prior art references via an Information Disclosure Statement; Mr. Hyatt's patent could have been rendered unenforceable if he had not done so. After allowance of the '094 claims, Mr. Hyatt was not entitled to receive consideration of the Information Disclosure Statement, so he filed a continuation application to have that Information Disclosure Statement considered. Trial Tr. 52:7-59:9 (Oct. 13, 2017 A.M. Session). Prior to 1995, it was common for applicants to file a continuation application to obtain consideration of prior art references. Trial Tr. 52:7-59:9 (Oct. 13, 2017 A.M. Session). Ultimately, the previously-allowed claims were subjected to a restriction requirement in the '455 application, and Mr.

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Hyatt elected to proceed with a different invention in the '455 application. *See* Trial Tr. 42:10-11 (Oct. 12, 2017 P.M. Session).

Mr. Hyatt presented at least one claim in an application that he had previously lost in an interference proceeding regarding the single-chip microprocessor. *See* Trial Tr. 9:5-15:2 (Oct. 11, 2017 P.M. Session); 47:8-24 (Oct. 12, 2017 P.M. Session); 4:15-24 (Oct. 14, 2017 P.M. Session). The PTO has methods to address any claims it contends were lost in interference: it can issue an interference estoppel rejection. *See* Trial Tr. 45:3-47:6 (Oct. 12, 2017 P.M. Session). Mr. Hyatt canceled one claim the PTO contends was lost in an interference. Trial Tr. 4:15-5:13 (Oct. 13, 2017 P.M. Session) (addressing cancellation of claim 186 in the '879 application). While the USPTO can issue an interference estoppel rejection, it would have facilitated examination for Mr. Hyatt not to introduce claims that he lost in an interference.

During the pendency of these four cases before the Court, the Court has never issued an Order to Show Cause why any of these cases should not be dismissed for failure to prosecute.

b. Conclusions of Law

Prosecution laches is an issue “to be decided as a matter of equity, subject to the discretion of a district court before which the issue is raised.” *Symbol Techs. II*, 422 F.3d at 1385. As it is the party asserting the affirmative defense, the PTO bears the burden of proof

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and persuasion. *See, e.g., Brunswick Bank & Tr. Co. v. United States*, 707 F.2d 1355, 1360 (Fed. Cir. 1983) (“the party raising an affirmative defense has the burden of proof on the issue.”). The parties dispute the level of that burden. These actions under §145 are civil matters in which the Court is making *de novo* findings on patentability for the claims for which new evidence is presented. The burden of proof on the merits of these actions is thus on the applicant-plaintiff to establish by a preponderance of the evidence that he is entitled to a patent on those claims. *See generally SD3, LLC v. Lee*, 205 F. Supp. 3d 37 (D.D.C. 2016) (making findings by a preponderance). Even though Administrative Procedure Act deference may be appropriate regarding claims for which the plaintiff has not offered new evidence, this Court will assume and apply a preponderance standard to PTO’s affirmative defense for the simple reason that, if it can prove by a preponderance that it is entitled to dismissal of these actions, then it is necessarily the case that Mr. Hyatt cannot, in turn, meet his burden that he is entitled to the relief he seeks. Assuming that the preponderance standard applies, PTO has not met its burden here.

The Relevant Period, and Related Patent Applications

In their most simplistic forms, the parties’ arguments boil down to this: the PTO says Mr. Hyatt’s applications should be denied for prosecution laches because his conduct across all 400 of his applications from the filing of their parent applications through today unreasonably and inexplicably delayed examination. Hyatt, on the other hand, wishes the Court to determine he did not

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commit prosecution laches because the examination of the four applications before the Court concluded in a timely manner. As is often the case in litigation, and especially in cases of first-impression, neither side is spot-on.

Although determining whether the four applications before the court ought to be dismissed for prosecution laches takes into account the applicant's conduct in his related applications, that totality principle does not apply in a manner as to require this Court to account for the entirety of the prosecution history of each related application from its inception to final disposition. Transactions or occurrences that take on special legal significance in any one application may operate prospectively to remove the subject application from the prosecution laches calculus. An applicant's filing of a §145 action in district court is such an occurrence, as it initiates a wholly different set of obligations on behalf of both the applicant-plaintiff and the examining agency-defendant than those that pre-existed the court action. Therefore, Mr. Hyatt's general prosecution conduct across his remaining factually (though no longer legally) related applications to the ones before the Court, which post-dates his filing of the §145 actions at-issue here, is only relevant insofar as it might demonstrate circumstantially something about Mr. Hyatt's conduct across all related applications before these four cases were filed in 2005 and 2009.

Because the PTO stipulates that the period between 2003 and 2012 ought not be considered in the Court's prosecution laches analysis, *see, e.g.*, 214-1 at *29, and

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because by 2012 these matters were already subject to litigation in this Court, the Court, is left only to consider Mr. Hyatt's prosecution conduct up through 2002. The PTO's stipulation functions as an admission that the PTO shoulders responsibility for the delay during that period. That nearly decade-long delay by the PTO, and any other delay that might be attributable to the agency, is not directly relevant to the applicant's delay. *See Bogese*, 303 F.3d at 1369. Mr. Hyatt could not, for example, elect to delay his prosecution because the PTO had first delayed in processing or examining his applications. There is no tit-for-tat in the examination and prosecution process. But the question before the court is whether Mr. Hyatt engaged in *unreasonable* and unexplained delay. The very totality test that PTO wishes to leverage in its favor similarly functions such that, whether Mr. Hyatt's delay is unreasonable is not wholly divorced from the greater context of his interactions with PTO, and the agency's actions or failures to act, of which the near-decade of suspended examination is but one example.

Although the PTO wishes to restart the clock once more after 2012, the cases before the Court had been filed years earlier. Any delay in prosecuting the §145 litigation was within the power of the Court to enforce,¹¹ and the relevance of any post-2012 delays in prosecuting the other 400 applications not at-issue in these cases is

11. A plaintiff's "prosecution" of his civil action in district court is a different use of the word than that implied by administrative patent "prosecution." Though the homonyms are even thematically similar, they entail different duties and procedures and, without more, do not compound each other for the purposes of this analysis.

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so circumspect that the Court must decline to consider it here.¹² In other words, even in light of the totality of the circumstances test applicable in prosecution laches cases, this Court ascribes no weight to the subsequent prosecution history of other applications not before the Court following the onset of litigation in these matters.

A Unique and Extraordinary Circumstance

In its objections to Mr. Hyatt's proposed findings and conclusions, PTO repeatedly refers to its typical procedures, while at the same time grounding its case in how unusual Mr. Hyatt's applications were and are. For example, PTO explains that it "did not make all applicable rejections to Mr. Hyatt's claims because it would have

12. The PTO tries mightily to avoid the necessary inference that the relevance of such later conduct lies in how it might relate back to Mr. Hyatt's intent and strategy from the start. As noted *supra*, this Court construes the supposed irrelevance of intent in prosecutions laches to be limited to the irrelevance of a *lack* of evidence of intent on the part of the applicant to delay examination; an established intention on the part of the applicant to delay issuance of his patents, however, can be grounds not to issue them. *Compare Symbol Techs. II*, 422 F.3d at 1382, 1384, *with Woodbridge*, 263 U.S. at 56-62 (discussing indicia of deliberateness, willfulness, and intent). The closest evidence PTO presented that could be construed as evidence of Mr. Hyatt intending to delay is his lack of a "master plan" to cooperate with examiners. As explained further below, especially in light of the PTO's own inaction to exercise formally any of its authorities to require further action from Mr. Hyatt on his applications undergoing examination, this is insufficient for the Court to draw an inference warranting dismissal of Mr. Hyatt's applications at this stage based on his prosecution conduct between 1995 and 2003.

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been impossible to do so under the time typically given to examiners.” ECF 214-1 at *7 (regarding proposed findings 20-22). *See also id.* at, *e.g.*, *9 (regarding proposed findings 52-53); *12 (regarding proposed findings 62 and 66); *16 (regarding proposed finding 81); *17 (regarding proposed findings 93-94); *25 (regarding proposed findings 118-121).¹³ And yet, PTO explains, “it is not disputed, and in fact is judicially recognized, that Mr. Hyatt’s applications are not ordinary, and that ordinary rejections and complete

13. PTO repeatedly argues that, “To the extent certain rejections were reversed, this supports the USPTO’s argument that the examiners could not effectively examine the cases under the time allowed, leading to reversal of the rejections that were made, and leading to further examination or appeals in the applications at issue.” ECF no. 214-1 at *12, *13, *17. The PTO offered no evidence as to this alleged causal link, nor any comparative data concerning typical reversal rates at any level (agency-wide, within certain art groups, or among the specific examiners who took action on Hyatt’s applications), from which the Court could reasonably draw such an inference. Strangely, the PTO also has not pointed the Court to any new ground for rejection that it has discovered since this litigation commenced and that wishes to assert in the four applications before the Court. This includes the lack of any double-patenting rejections, even though PTO’s witnesses at trial discussed at length the importance of double-patenting reviews during examination. Even if it was impossible to conduct a complete double-patenting analysis in these four applications before their respective § 145 actions were filed, PTO has had an additional 8-13 years to conduct those reviews, using ever-improving technologies to search the digitized file wrappers for Mr. Hyatt’s applications. Just as resolution of a double-patenting rejection is not necessary for, and does not stand in the way of, advancing prosecution on all other matters, the filing of a §145 action does not prevent PTO from asserting double-patenting as a grounds for rejection before the district court. *See also Troy v. Samson*, 758 F.3d 1322 (Fed. Cir. 2014).

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examination could not be made with respect to his claims given,” for example, the applications’ complexity. *Id.* at *21. *See also, e.g., id.* at *32 (quoting Federal Circuit precedent describing Hyatt’s patent applications and prosecution history as “extraordinary”); *id.* at *9 (“the applications could not be treated as typical applications given their size and scope.”); *id.* at *28 (“Mr. Hyatt’s applications are far from typical.”); *id.* at *30 (same).

Implied in this dichotomy is that the PTO wishes the Court to find Mr. Hyatt caused unreasonable and unexplained delay in the examination against the benchmark of the PTO’s typical practice. But the PTO itself explains a great deal of the delay: Mr. Hyatt’s applications were not typical. *See also* 214-1 at *25. The court notes that anything “unusual” can cause delay by its very nature and not due to unreasonable actions of the applicant. Even “unique” and “extraordinary,” *see* 214-1 at *32, do not necessarily connote “unreasonable.” PTO’s blind spot is in neglecting that the unusual scenario with which it was presented in Mr. Hyatt’s GATT Bubble applications required it to employ and embrace atypical procedures for addressing the challenge before them. It appears to the Court that, from 1995 through today (and certainly 1995-2002), PTO seems, in the respects relevant here, largely to be wedded to its typical practices and procedures with only minor, if any adaptations.¹⁴ The

14. The suspensions between 2003 and 2012 appear largely to be responses to pending litigation, not the applications, themselves. *Compare* ECF no. 200 at **45-51 *with* ECF no. 214-1 at **29-33. To the extent PTO resents having had to devise “unusual procedures

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PTO's witnesses' numerous references during trial to a general policy and preference for examiners to engage in compact prosecution is unavailing. The PTO itself acknowledges that, despite its operational efficiency in the majority of cases, there is no legal requirement that the PTO engage in compact prosecution. *See* 214-1 at *8 (in light of *Troy v. Samson's* application of *Kappos v. Hyatt*, "neither Mr. Hyatt, nor the USPTO, [is] required to make all arguments for or against patentability during examination.").

That the PTO simultaneously argues that "the applications could not be treated as typical applications given their size and scope," 214-1 at *9 (relating to proposed findings 52-53), and that the Court must consider the prosecution history in these cases in light of its typical procedures and timelines, is somewhat bizarre and, perhaps, unreasonable. Suffice it to say, PTO's lengthy, even noble attempts through 2002 to fit the large proverbial square peg of Hyatt's applications into the rounded-out and well-trodden hole of its 3,000 page practice manual do not warrant a prosecution laches finding against Mr. Hyatt.

...that were not needed with respect to other applicants, who for example, did not litigate regarding procedural issue[s] and did not file Section 145 appeals," ECF 214-1 at *32, the Court finds that sentiment to be somewhere between vexing and outright galling. It takes a certain chutzpah for a government agency to chafe against citizens seeking to vindicate their rights through lawfully available means, even in those cases where the opposing party's litigious zeal is itself remarkable for any number of reasons.

*Appendix F*The October '95 Meeting and Agreement

The PTO places much emphasis on Mr. Hyatt's October 1995 meeting with Mr. Nicholas Godici, a former PTO group Director, and the promises Mr. Hyatt made during that meeting to "focus" his claims. Although the PTO has certain formal mechanisms by which it can compel patent applicants to comply with its demands, there is no evidence this informal conference was an exercise of any of those authorities. To the contrary, what little evidence there is concerning what was discussed at that meeting (since it was not contemporaneously memorialized) could be interpreted as it having been PTO's attempt to orient itself to the unusual challenge Mr. Hyatt's applications presented.

Patent applicants have discretion as to how to prosecute their claims within the PTO's rules and regulations. The PTO argues vehemently that Mr. Hyatt "frustrated examination by failing to cooperate with the USPTO" during the examination process. 214-1 at *18. *See also id.* at*7, *34, *36. It contends that "failing to cooperate [by failing to provide] material information that would assist examination" is inequitable conduct. *Id.* at *36. The Court is concerned by the PTO's characterization of a supposed "increased burden[] on the USPTO to examine Mr. Hyatt's claims resulting from Mr. Hyatt's lack of assistance." *Id.* at *18. Certainly it would seem to have been in Mr. Hyatt's interest to assist examination when invited to do so, if he had indeed prioritized having his applied-for patents issue at the earliest possible date. But this Court finds dubious the proposition that a Government agency

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can compel such self-help via an informal meeting, such that negative legal consequences result for the citizen who elects instead to pursue his own private enterprise while the bureaucracy fulfills its duties to the applicant and to the public. The potential economic benefit to Mr. Hyatt from PTO's difficulties under pre-GATT rules does not alter this principle, where PTO had ample opportunity over many years to act to resolve its difficulties through formal means. If the examiners(s), for example, could not find written description support for certain claims, *see id.*, the examiner was likewise empowered to issue written description rejections or other specific and formal Requirements under PTO rules and regulations, rather than await Mr. Hyatt's help, which, it appears obvious, was not forthcoming.

The PTO asserts: "That the USPTO could have, but did not" invoke certain authorities or make certain rejections earlier is irrelevant. 214-1 at *13 (as to undue multiplicity rejections and Rule 11.18); *id.* at *14 (as to Rule 1.145); *id.* at *27 (as to prosecution laches). The Court finds PTO's repetition of this concept rather troubling, as well. Though perhaps not relevant in a case in law, failure to exercise certain authorities is most certainly relevant in a *post hoc* equity determination where there was neither formal and proper notice nor opportunity for the applicant to cure the allegedly offensive conduct.¹⁵ *Cf., e.g., 37 C.F.R.*

15. The Court also questions the relevance of the PTO's curious speculation that, had it exercised certain authorities, "it would have only led to a procedural dispute with Mr. Hyatt, as it has today." 214-1 at *13 (regarding undue multiplicity rejections); *id.* at *14 (regarding Rule 11.18). If such a procedural dispute was inevitable, the PTO's

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§11.18(c) (providing for adjudication of certain alleged rules violations “after notice and reasonable opportunity to respond.”). Because “the PTO’s authority to sanction undue delay is even broader than the authority of a district court to hold a patent unenforceable,” *Bogese*, 303 F.3d at 1367, the PTO’s decision not to exercise that authority is relevant to a district court’s *ex post* analysis of the applicant’s allegedly unreasonable delay in prosecuting his applications.

“The PTO has inherent authority to govern procedure before the PTO, and that authority allows it to set reasonable deadlines and requirements for the prosecution of applications.” *In re Bogese*, 303 F.3d at 1368. Such deadlines were never set in a properly formal and binding manner here. Nor did the PTO take action to enforce compliance with the informal agreements it now argues it had with Mr. Hyatt, during the pendency of these applications before the agency. PTO examiners knew how to enter formal Restriction requirements, and even did so in his ’639 application currently being litigated before this Court. This is critical because patent applicants are entitled to amend or cancel claims to traverse a ground of rejection. But in many of his applications, Mr. Hyatt was not given a similar opportunity to amend or cancel claims to avoid rejections during the period relevant here, *i.e.*, prior to 2003.

It is entirely likely that Mr. Hyatt “could have” been more helpful during the examination process. *Cf.* 214-1 at

own arguments in equity suggest that it would have been preferable to resolve those disputes at the earliest juncture.

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*19. But there is no abstract requirement for a citizen to tailor his conduct in pursuit of his constitutional right to a patent, to conform to what is “feasible” for the agency. *Cf, e.g.*, 214-1 at *23. Agency demands for further action by the filer of an accepted patent application must be tied to properly constituted statutory or regulatory authorities.¹⁶ The Court is left with no choice but to conclude that the PTO itself ignored for 20 years the details of whatever informal agreement Mr. Hyatt and Mr. Godici had. PTO offers that “conversations between applicants and examiners, never mind Group Directors like Mr. Godici, are not always memorialized in interview summaries, even in typical cases, and Mr. Hyatt’s applications are far from typical.” 214-1 at *28. The atypicality of Mr. Hyatt’s applications and his meeting with a Group Director would seem to be all the more reason to memorialize the conversation and agreement. Regardless, Mr. Hyatt and Mr. Godici did not reach any agreement that the Court can now enforce.¹⁷ Further, Mr. Hyatt’s failure to devise a “master plan” to “focus his claims” subsequent to the October 1995 meeting, *see* ECF No. 81-2 at *23; Trial Tr. 73:7-76:5 (Oct. 11, 2017 A.M. Session), though it may have been helpful for him to do so, did not violate his duty of

16. Although the Court did not consider this fact when ruling on the plaintiff’s Rule 52(c) motion, it is telling for context that Mr. Hyatt’s trial testimony in the 09-1864 case that he was *told* to re-file photocopies of applications as placeholders *by* PTO personnel, went unchallenged and un rebutted. Trial Tr. 41:8-23, 09-cv-1864 (Feb. 12, 2018 A.M. Session).

17. The Court understands that the PTO “does not seek to enforce a contract *per se*,” 214-1 at *28, but reiterates that exercising its equitable powers against Mr. Hyatt in this context would be inappropriate.

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disclosure, candor, and good faith to the PTO, as “There is no duty to submit information which is not material to the patentability of any existing claim.” 37 C.F.R. §1.56(a).¹⁸

The PTO fears that, in declining to agree with its position on prosecution laches here, the Court will have established that the PTO can suffer legally from attempting to resolve patentability issues at the examiner level without formally flexing its regulatory muscle. Although the Court does not wish today’s ruling to chill informal interactions between examiners and applicants, the overall theme of PTO’s case is to ask the Court to do as they now say, not as they have done, or failed to do, for decades. This is not a case where “designed delay” has been proven, *Woodbridge*, 263 U.S. at 56,¹⁹ demanding the Court find “abandonment by conduct,” *id.* at 59. Rather, the evidence before the Court principally Mr. Hyatt’s decision not to affirmatively assist the PTO in its examination, despite the potential consequences for not doing so including, *e.g.*, having his applications rejected on any number of potential grounds-for rejection in the 3,000 page Manual of Patent Examination Procedure. *See also* Trial Tr. 9:6-7 (October 6, 2017, P.M. Session) (“[C]ertainly the examiner needs to keep in mind all of those potential

18. Notably, PTO did not invoke §1.56, including its “bad faith or intentional misconduct” language, as a ground to reject any of Mr. Hyatt’s applications prior to this litigation. Further, 37 C.F.R. §11.18 itself specifies that alleged violations of the PTO’s certification requirements are to be adjudicated by the PTO “after notice and reasonable opportunity to respond.” *Id.* at §11.18(c).

19. Indeed, the PTO has repeatedly disclaimed any attempt at all to show Mr. Hyatt intended to obstruct the patent system.

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grounds of rejection.”). One such ground of rejection is for lack of written description support under 35 U.S.C. §112, by far the most common rejection at issue on the remaining claims in the four applications before the Court. The Court is highly skeptical of PTO’s contention that failing to provide written description support for a claim or element of a claimed invention, a statutory ground for rejection on the merits, is simultaneously evidence of “unreasonable delay.” *See* Trial Tr. 25:1-7 (Oct. 13, 2017, P.M. Session). To equate the two would certainly would run counter to the Supreme Court’s ruling in *Kappos v. Hyatt* allowing patent applicants to present new evidence in §145 cases, and effectively divest the Court of jurisdiction to review §112 rejections on the merits in a §145 proceeding.

The Court here does not wish to incentivize the PTO to take an unreasonably hard line against flawed but meritorious applications — examiners working in concert with applicants to ensure patents are awarded when deserved lies at the heart of PTO’s mission. But the PTO cannot have it both ways here — it cannot at once lament decades of allegedly outrageous conduct, while simultaneously arguing that its own inaction for much of that time is irrelevant to the Court’s analysis. If Mr. Hyatt’s conduct were so outrageous as to make available so many potential grounds for the PTO to take definitive action against his claims or entire applications, there comes a time that a court must ask, “Why not?” The answer in a case like this cannot simply amount to the bureaucratic equivalent of, “We were just being nice.”

Further, aside from generalizations about Mr. Hyatt’s conduct, PTO presented no evidence of just how much

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of the delay was caused by Mr. Hyatt's representations concerning the focusing of his claims. That the PTO finally, in 2015, got fed-up enough with the difficulties of examining Mr. Hyatt's claims that it began issuing prosecution laches rejections, does not itself have any relevance to this Court's treatment of the applications' respective prosecution histories through 2002.

Other Matters

Mr. Hyatt paid to PTO over \$7 million in fees for the 400 applications at issue; PTO has spent more than \$10 million in the last five years examining his claims in those applications. "This means that the amount of money Mr. Hyatt was paid does not approach the amount of time spent to examine his claims." 214-1 at *13. The PTO's fiscal "loss" in the course of examining Mr. Hyatt's applications is given little weight. The PTO both sets the examination fees and, through various mechanisms, the salaries of the employees assigned to examine Mr. Hyatt's applications. Presumably it does so in a manner designed to be fiscally neutral over time — the PTO will inevitably see either some "profit" or "loss" as to nearly any application or applicant, but those gains and losses should even out over time in accord with the Law of Large Numbers, despite the occasional outlier to typical examination scenarios.

Mr. Hyatt argues that the PTO's allegations of claim shifting is "just applying a new label to its contentions regarding the number of claims in Mr. Hyatt's applications and Mr. Hyatt's amendment practice." ECF No. 200 at *23. The Court disagrees. There is a fundamental difference

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between amending a patent application by adding new numbered claims (and paying the accompanying fees), and significantly amending the language of individual claims that have neither been cancelled nor re-numbered in such a way as to effectively create a new claim. At the very least, the latter red-line method is more opaque and complicates review of an administrative record far more than the former. Indeed, the Court in other circumstances would likely be inclined to agree with the PTO that shifting “is inimical to furthering prosecution.” DX-136.000026. But the Court here is faced with the facts that: 1) it is “not unusual to see a few claims rewritten,” Trial Tr. 88:7-8 (Oct. 10, 2017, P.M. Session); 2) most if not all of the activity in question occurred, as PTO ensured the Court was aware, after the October 1995 meeting between Mr. Hyatt and Mr. Godici; Trial Tr. 75:16-17, 79:15-17, 81:22-24, 85:22-86:4, 91:6-11 (Oct. 10, 2017 P.M. Session); and 3) the PTO accepted the amendments and continued examination of each of these applications to their conclusion. Under the circumstances, the PTO has not made clear to the Court by a preponderance of the evidence that the agency found any of the amendments to be unreasonable at the time they were filed or for several years afterward. The PTO did not reject the amendments, nor does it appear that any PTO official attempted to schedule a second meeting with Mr. Hyatt to clarify the matters discussed in 1995 or express that the amendments were not in accord with the agreement, which one might reasonably have suspected to occur if the PTO assessed that Mr. Hyatt was doing anything other than attempting to refocus his claims per the informal agreement made during the 1995 meeting. The Court sees and appreciates the challenge that faced

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the PTO in processing these unusual applications during an unique time of a paradigm shift in the U.S. patent system, but the PTO has left the Court without a basis to draw such adverse conclusions against Mr. Hyatt's conduct at this stage, in this legal posture, when the PTO itself did nothing to police the conduct they now complain of for the better part of two decades. In any event, much of the PTO's testimony on this matter was conclusory, and it did not present evidence of just how Mr. Hyatt's alleged claim shifting unduly frustrated examination in the four applications before the Court, and PTO has not presented evidence sufficient to establish that other applications saw similar shifts before 2003 and that the shifts in those applications and the four before the court mutually, unreasonably, and inexplicably delayed examination to such an extent as to warrant dismissal for prosecution laches for conduct up through that time. Had the PTO done so, this might be a significantly different case.

The PTO introduced evidence concerning four claims not in the applications before the Court that Mr. Hyatt re-submitted despite having previously lost them in interference. *Hyatt v. Boone*, 146 F.3d 1348 (Fed. Cir. 1998). It is reasonable for the PTO to assume that an applicant is not claiming an invention that he has already been told he did not invent. And it is unreasonable for Mr. Hyatt to continue to seek claims that he has lost, particularly without noting the similarity of the claims to the examiner, thereby forcing the PTO to expend time and resources to identify the improper conduct to issue the rejection(s). *See, e.g.*, Trial Tr. Day 3 P.M. Session, 5:6-15:2, Oct. 11, 2017; Trial Tr. Day 4 P.M. Session, 43:4-49:16, Oct.

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12, 2017; DX1486 ¶¶ 29, 220-225. Mr. Hyatt's conduct as to these four claims was not reasonable. But unreasonable conduct as to four allegedly illustrative claims does very little to move the ball in consideration of the totality of Mr. Hyatt's conduct across approximately 115,000 claims.

IV. CONCLUSION

In light of the above, the Court concludes that Mr. Hyatt's conduct did not cause unreasonable and unexplained delay under the totality of the circumstances relevant here sufficient to warrant dismissal of these four matters for prosecution laches. In so holding, the Court takes this opportunity briefly to clarify the scope of this opinion.

The PTO objected to Mr. Hyatt's proposed findings and conclusions, among other reasons, "to the extent they find or conclude that Mr. Hyatt's conduct in the related 400 applications still pending before the USPTO did not result in or cause any unreasonable and unexplained delay with respect to those applications." 214-1 at *4. Although the Court's opinion today does not reach those applications not subject to the § 145 cases before it, it is worth noting that the PTO's objection in this regard rests on similarly faulty logic to the rest of its laches argument. First, the PTO insists the Court consider the totality of the circumstances, including Mr. Hyatt's conduct in prosecuting those other 400 applications. The PTO, again, cannot have it both ways - the Court is dubious of the notion that any consideration of Mr. Hyatt's conduct with respect to the other applications can nevertheless produce

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a judgment that has no bearing whatsoever on those same applications. To the extent the PTO wishes the Court to mine and weigh the evidence produced relative to Mr. Hyatt's applications that are not themselves before the Court, the Court is fully capable and authorized to make findings and conclusions as to the entirety of the evidence the PTO has produced for the Court to consider. The PTO's strategy in pursuit of its prosecution laches theory thus was a gamble with potentially widespread ramifications. It was not Mr. Hyatt's §145 merits actions, but the PTO itself that created the possibility of such an outcome.

Although the PTO did not prevail in its gamble here, the Court's ruling today is nevertheless a narrow one. The Court today grounds its ruling in findings as to the prosecution conduct before the PTO up through 2002, the last date the PTO includes in its own calculations prior to the onset of litigation in these cases. The Court's opinion does not reach patent prosecution conduct after those dates, and should not be read either to draw conclusions based upon later conduct, nor upon the PTO's prosecution laches rejections that presumably took into account that later conduct in conjunction with pre-2003 conduct in a totality of the circumstances approach.²⁰

In other words, though Mr. Hyatt's 1995-2003 conduct itself is not sufficient to warrant applying prosecution laches here; that does not mean that it is irrelevant to a totality of circumstances analysis that would include later-occurring events.

20. The Court likewise makes no findings or conclusions as to the intervening rights of third-parties.

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An order consistent with this holding accompanies this opinion.

Date: 7/31/18

/s/ Royce C. Lamberth
Royce C. Lamberth
United States District Judge

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**APPENDIX G — RELEVANT STATUTORY
PROVISIONS**

35 U.S.C.A. § 101

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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35 U.S.C.A. § 102

§ 102. Conditions for patentability; novelty

Effective: May 13, 2015

(a) Novelty; Prior Art.--A person shall be entitled to a patent unless--

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.--

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.--A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if--

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

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(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) Disclosures appearing in applications and patents.--A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if--

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) Common Ownership Under Joint Research Agreements.--Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if--

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(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) Patents and Published Applications Effective as Prior Art.--For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application--

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

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35 U.S.C.A. § 120

**§ 120. Benefit of earlier filing date in the
United States**

Effective: May 13, 2015

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 or 385, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

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35 U.S.C.A. § 131

§ 131. Examination of application

Effective: November 2, 2002

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

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35 U.S.C.A. § 132

§ 132. Notice of rejection; reexamination

Effective: September 16, 2012

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1).

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35 U.S.C.A. § 133

§ 133. Time for prosecuting application

Effective: December 18, 2013

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto.

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35 U.S.C.A. § 134

§ 134. Appeal to the Patent Trial and Appeal Board

(a) Patent Applicant.--An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) Patent Owner.--A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

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35 U.S.C.A. § 141

**§ 141. Appeal to Court of Appeals for the
Federal Circuit**

Effective: September 16, 2012

(a) Examinations.--An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board's decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section 145.

(b) Reexaminations.--A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(c) Post-Grant and Inter Partes Reviews.--A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(d) Derivation Proceedings.--A party to a derivation proceeding who is dissatisfied with the final decision of the Patent Trial and Appeal Board in the proceeding may appeal the decision to the United States Court of Appeals

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for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section 142, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146. If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section 146, the Board's decision shall govern the further proceedings in the case.

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35 U.S.C.A. § 142

§ 142. Notice of appeal

Effective: November 2, 2002

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

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35 U.S.C.A. § 145

§ 145. Civil action to obtain patent

Effective: March 16, 2013

An applicant dissatisfied with the decision of the Patent Trial and Appeal Board in an appeal under section 134(a) may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the Eastern District of Virginia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Patent Trial and Appeal Board, as the facts in the case may appear and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

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35 U.S.C.A. § 151

§ 151. Issue of patent

Effective: December 18, 2013

(a) In General.--If it appears that an applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.

(b) Effect of Payment.--Upon payment of this sum the patent may issue, but if payment is not timely made, the application shall be regarded as abandoned.