No. 25-1049

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 UNITED STATES PATENT AND TRADEMARK OFFICE,

Respondent.

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

BRIEF OF *AMICI CURIAE* US INVENTOR, SAN DIEGO INVENTORS FORUM, TAMPA BAY INVENTORS COUNCIL, MICHIGAN INVENTORS COALITION, INVENTORS NETWORK OF MINNESOTA, ACTURE NETWORK (FORMERLY INVENTORS NETWORK KENTUCKY), INVENTORS ASSOCIATION OF SOUTH CENTRAL KANSAS, JACKSON INVENTORS NETWORK, LANSING INVENTORS NETWORK, AND INVENTORS SOCIETY OF SOUTH FLORIDA, ALL IN SUPPORT OF PETITIONER

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INTEREST OF *AMICI CURIAE* [1]

Amici Curiae national and regional inventor organizations listed below have substantial interests in the results of this case and in contributing to this Court's understanding of reasons for reviewing and correcting the decisions of the Court of Appeals for the Federal Circuit below. Therefore, *amici* hereby support the grant of *certiorari*.

1. **US Inventor, Inc.**, is a not-for-profit § 501(c)(4) corporation, with a mission to restore innovation in the US by establishing a strong patent system. Our members include individual inventors and startup inventor companies. We support our mission by publishing information and videos on our website at www.usinventor.org, by our newsletters (www.usinventor.org/subscribe), and by conferences (https://usinventor.org/usi-third-annual-conference/).

2. **San Diego Inventors Forum** includes inventor members throughout San Diego County, helping inventors become product developers and entrepreneurs. The group meets once per month, where members provide advice and encouragement for other inventors to pursue their creativity. https://sdinventors.org/.

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[1] Pursuant to Supreme Court Rule 37.6, counsel for the *amici curiae* certifies that no counsel for any party authored this brief in whole or in part and that no person or entity other than the *amici* made a monetary contribution intended to fund the preparation or submission of the brief. Rule 37.2 notice of the intent to file this brief was timely provided by email to counsel of record for Petitioner and for Respondent.

3. **Tampa Bay Inventors Council** is an inventor organization fostering inventors' networking, connecting and learning about inventing and taking one's innovations to market. The Council brings innovative people together twice a month to discuss various aspects of inventing. Speakers discuss issues from patenting to packaging and all the steps in between and taking it to market. www.meetup.com/tbic-us/.

4. **Michigan Inventors Coalition** is an inventor organization dedicated to help grow and sustain Michigan's economy by facilitating education and collaboration among Michigan Inventors and local support networks. www.miinventors.org

5. **Inventors Network of Minnesota** is a voluntary membership organization composed of individuals wishing to encourage the development of new ideas and to promote the spirit of innovation through the seeking and sharing of information. It accomplishes this goal by focusing the individual and collective experience and expertise of its members, and others, to assist inventors and innovators through the process of bringing their ideas to use. www.inventorsnetwork.org

6. **Acture Network (formerly Inventors Network Kentucky)** conducts a variety of monthly, quarterly and annual programs that teach valuable principles and engage participants in activities designed to move their inventions, products or businesses forward, through in-person and online formats. Hosting three meetings every month on distinct topics. www.acturenetwork.org

7. **Inventors Association of South Central Kansas** is a non-profit organization assisting regional inventors through counseling and

educational programs. Individuals are encouraged to attend monthly educational meetings to learn from technical experts regarding patent development and protection and are encouraged to present their ideas to association members to obtain feedback regarding development direction. https://resource-navigator.networkkansas.com/resource-navigator/detail/180632/15/

8. **Jackson Inventors Network** is a Michigan-based, non-profit support group for inventors, marketers, and creators. It provides networking, educational, and mentoring opportunities for members to help bring their inventions and product ideas to market. www.facebook.com/JacksonInventorsNetwork/about

9. **Lansing Inventors Network** is a local group, often associated with the Lansing Makers Network, that provides a collaborative space for inventors to connect, share, and develop their ideas. It serves as a community resource for makers and innovators in the Lansing area to foster local invention.
www.facebook.com/LansingInventorsNetwork

10. **Inventors Society of South Florida** is a § 501(c)(3) non-profit organization dedicated to the advancement of the independent inventor through the use of Education, Motivation and Collaborative Support. To that end, we provide a wealth of information to our members and the general public regarding all aspects of the invention process through our newsletters, website, speakers, and webinars conducted on the second Saturday of every month. www.inventors-society.net/

SUMMARY OF ARGUMENT

The decision below permits an equitable defense of prosecution laches to defeat an applicant's claim to a statutory right in a civil action under 35 U.S.C. § 145, notwithstanding this Court's precedents holding that equitable doctrines of laches cannot bar relief in actions at law. The Patent Act confers a statutory entitlement to a patent upon satisfaction of specified conditions, and a § 145 proceeding is a civil action at law to adjudicate that entitlement, not a suit invoking equitable discretion. Section 145 authorizes the district court to "adjudge" that the applicant is entitled to receive a patent, language characteristic of a judgment at law rather than a decree in equity. The proceeding vindicates a legal right created by statute—not a privilege in common law—and the remedy sought is a determination of entitlement, not discretionary equitable relief.

The statute's structure further confirms its law-side character: it provides a mutually exclusive alternative to appellate review of the same agency determination and imposes mandatory expenses on the applicant including those of the agency, even when the applicant prevails—features inconsistent with traditional equitable adjudication and reflective of a fixed statutory legal remedy. Because the action seeks a judgment that the applicant "is entitled to receive a patent," and the resulting issuance follows as a legal consequence of that determination, the proceeding mirrors traditional actions at law rather than equitable proceedings. Under settled principles reaffirmed in *Petrella* and *SCA Hygiene*, equitable defenses such as laches are unavailable to defeat claims at law, and nothing in § 145 authorizes courts

to deny a statutory entitlement based on equitable considerations. The Federal Circuit nevertheless permitted prosecution laches to extinguish Petitioner's claim, effectively converting a statutory right into a discretionary privilege.

The Federal Circuit further erred in concluding that the 1952 Patent Act preserved such equitable defenses. 35 U.S.C. § 282 governs defenses in actions involving the validity or infringement of issued patents, not proceedings concerning patent applications, and thus does not apply to § 145 actions. Even if § 282 incorporated certain equitable doctrines, this Court has already held that such doctrines cannot bar legal relief. Congress' silence in the Patent Act contrasts with statutes, such as the trademark Lanham Act, that expressly authorize equitable doctrines, confirming that no such authority exists here. By allowing prosecution laches to defeat an applicant's statutory entitlement, the Federal Circuit departed from longstanding distinctions between law and equity and from this Court's precedents preserving those limits.

Review is warranted because the decision below creates a presumption that patents issued from multiple continuing applications may be unenforceable. It creates uncertainty regarding the nature of the patent right and threatens broader erosion of statutory entitlements by permitting equitable defenses to defeat claims at law. The Federal Circuit's precedential rulings is binding in all patent cases nationwide and without the diversity benefit of "circuit splits" are unlikely to be reconsidered absent this Court's intervention, leaving applicants and patent holders subject to discretionary denial of statutory rights. The petition

therefore presents an important federal question concerning the availability of equitable defenses in actions at law and the proper interpretation of the Patent Act, warranting this Court's review. This brief takes no position on the patentability or the prosecution at the US Patent and Trademark Office ("PTO") of Petitioner's underlying patent applications.

ARGUMENT

In the two separate decisions below in this case, *Hyatt v. Hirshfeld*, 998 F. 3d 1347 (Fed. Cir. 2021) ("*Hyatt I*"), and *Hyatt v. Stewart*, 148 F. 4th 1376 (Fed. Cir. 2025) ("*Hyatt II*"), the Federal Circuit Panel failed to follow controlling Supreme Court precedents on the principles of separation of powers that render unavailabile equitable laches defenses as discussed in *Petrella v. Metro Goldwyn Mayer, Inc.* 572 U.S. 663 (2014), and *SCA Hygiene Prod. Aktiebolag* v. *First Quality Baby Prod., LLC*, 580 U.S. 328 (2017). This case merits scrutiny for contravening key rulings within *Petrella* and *SCA Hygiene*: *regardless* of whether a timeliness statutory "gap" exists in the Patent Act, *equitable* claims of laches are unavailable to defeat the claims in *actions at law* under 35 U.S.C. § 145. The Panel clearly erred.

I. The applicant has a *statutory right* to a patent—not a *privilege* to be extinguished by equitable power of judicial discretion

The 1952 Patent Act[2] (the "Act") provides that inventors may obtain patents for their inventions "subject to *the conditions and* requirements *of this title*." 35 U.S.C. § 101 (emphasis added). One such requirement is: "A person *shall be entitled* to a patent unless [certain enumerated patentability requirements are not met]." 35 U.S.C. § 102(a) (emphasis added). This affirmatively clarifies that the right to a patent is not a privilege but a presumptive *statutory right*. Moreover, 35 U.S.C. § 261 provides that "patents shall have the attributes of *personal property*" and "any interest therein, shall be assignable *in law* by an instrument in writing." (Emphasis added). A patent property right *is a statutory right*.

I.A The proceeding under § 145 is a civil *action at law*

The Act provides for an applicant's civil action against the US Patent and Trademark Office ("PTO") in District Court so that the "court may *adjudge* that such applicant is *entitled* to receive a patent for his invention, … and such *adjudication* shall *authorize* the [PTO] to issue such patent on compliance with the *requirements of law*. § 145 (emphasis added). This is a *judgment at law* on patentability—not a *decree* in equity ordering the PTO. *See Gould v. Quigg*, 822 F.2d 1074, 1079 (Fed.

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[2] Pub. L. No. 82-593, 66 Stat. 792 (1952).

Cir. 1987) (as "to the issue of whether the district court has authority to direct the issuance of a patent, we conclude it does not.")

"To determine whether a statutory action is more similar to cases that were tried in courts of law than to suits tried in courts of equity or admiralty, the Court must examine both the *nature* of the action and of *the remedy sought*." *Tull v. United States*, 481 U.S. 412, 417 (1987) (emphasis added). The "nature of the action" by the plaintiff/applicant in a § 145 proceeding is the vindication of his *legal right* to a patent; the "remedy sought" is the court's *judgment* that he "is entitled to receive a patent …", and an authorization of the PTO to issue such patent. § 145.

Courts recognize that "[l]itigation of patent validity is *an action at law*, separate from the infringement cause of action." *In re Technology Licensing Corp.*, 423 F.3d 1286, 1292-93 (Fed. Cir. 2005) (emphasis added; Newman, CJ., dissenting and collecting cases). The Supreme Court confirmed this also with respect to patentability determinations in prosecution of an application at the PTO. *Microsoft Corp. v. I4I Limited Partnership*, 564 U.S. 91, 96-97 (2011) ("While the ultimate question of patent validity is *one of law*, the same factual questions underlying the PTO's original examination of a patent application will also bear on an invalidity defense in an infringement action.") (Cleaned up, emphasis added). An applicant's claim to a patent, both during prosecution at the PTO and later in a § 145 action, is not contingent on privilege, fairness, or judicial discretion; it is a statutory claim to a defined *statutory property right*.

Accordingly, a § 145 proceeding is best understood as an *action at law to obtain a statutory entitlement*, not a suit invoking the district court's equitable powers. First, the source of the applicant's entitlement is purely statutory: the Patent Act provides that the inventor "*shall be entitled* to a patent unless…" § 102 (emphasis added). An inventor meeting the statutory conditions is "entitled to a patent," and the PTO "*shall* issue a patent therefor." § 131 (emphasis added). Section 145 does not create an equitable cause of action; it provides a *civil action* by which an applicant may establish entitlement to that statutory right when the agency has denied it. The statutory language directing that "[t]he court may *adjudge* that such applicant is *entitled* to receive a patent … as the facts in the case may appear," is language characteristic of a law-side adjudication of entitlement rather than the exercise of discretionary equitable relief. The court does not weigh equitable factors or fashion flexible remedies; it determines, *de novo* and on the evidence, whether the statutory requirements are satisfied. If so, the judgment "authorize[s] the Director to issue such patent on compliance with the requirements *of law*," making the court's role analogous to entering judgment establishing a legal right, with issuance of the patent following as a ministerial consequence of that determination.

Second, the structure of the remedy confirms the law-side character of the proceeding. The applicant seeks a determination of *entitlement* to a government-conferred statutory right, not an injunction against unlawful conduct, specific performance, or other traditionally equitable relief. The statute does not speak in equitable terms—no

reference to equity, discretion, balancing, or irreparable injury—but instead contemplates adjudication of facts and application of *law* to determine whether the applicant is "entitled." This mirrors traditional actions at law used to establish an entitlement at law, after which the operative consequence follows by force of the judgment. The directive that the court "adjudge" entitlement reinforces that the court is entering a judgment declaring a right, not exercising equitable discretion by decree. The following other aspects of the statute support this conclusion.

Mutually-exclusive alternative to appeal

The fact that § 145's "unless appeal has been taken" clause makes it an *express mutually-exclusive alternative* to an appeal under § 141, strongly supports treating it as a *law-side proceeding*. Both mechanisms review the same agency determination and address the same alleged wrong: the PTO's denial of a patent. Section 141 provides a conventional appellate path—indisputably a law-side adjudication determining entitlement under statutory criteria. Section 145 does not alter the nature of the right asserted; it merely changes the *mode of adjudication* from appellate review on the record to a *de novo* civil action with optionally additional evidence. Where Congress provides two mutually-exclusive procedural avenues to vindicate the same statutory entitlement, it is implausible that one path invokes equitable discretion while the other applies legal standards. Nothing in § 145 authorizes the court to grant or deny relief based on equitable considerations; instead, the court "may adjudge" entitlement "as the facts in the case may

appear," paralleling a law-side determination of right. The structural symmetry—same parties, same agency decision, same statutory entitlement, and mutually-exclusive routes—indicate that § 145 is not an equitable substitute but a *law-side alternative procedure* for obtaining the same statutory right.

Mandatory expenses of the proceedings

The mandatory-expenses provision is also difficult to reconcile with an equitable proceeding. Section 145 states: "All the expenses of the proceedings shall be paid by the applicant." This applies *even when the applicant prevails* and the court adjudges entitlement to the patent. That provision is fundamentally inconsistent with traditional equitable principles. Equity acts *in personam* and is guided by fairness; courts exercising equitable jurisdiction historically retain discretion over costs and tailor relief to avoid unjust outcomes. A regime requiring a fully successful plaintiff to bear *all expenses*—including those incurred by the opposing party—does not reflect equitable tailoring but instead a *fixed statutory consequence* attached to invoking a particular legal remedy.

The rigidity of § 145 contrasts with equity's hallmark completeness for flexibly achieving justice. As the maxim goes, "*equity delights to do justice and not by halves*." [3] A court exercising equitable discretion would not ordinarily vindicate a party's right yet impose the entire financial burden of

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[3] See e.g., *Caddington v. United States*, 178 F. Supp. 604, 607 (Ct. Cl. 1959).

litigation on that same party. Congress's decision to impose all expenses categorically—without regard to outcome, fairness, or equitable considerations—evidences that § 145 is a *statutorily defined action at law*, not a proceeding governed by equitable principles.

I.B Equitable defenses cannot be interposed in a § 145 proceeding as it is an *action at law*

The action-at-law nature of the proceeding controls. A civil action under § 145 to obtain a *statutory right* is an action *at law* in which an equitable defense is unavailable, including prosecution laches. Therefore, equitable judgments cannot be the basis upon which the District Court in a § 145 civil action "must … state its conclusions *of law*." Fed. R. Civ. Proc. § 52(a)(1) (emphasis added). The Supreme Court has long recognized that, "in actions at law[,] … equitable defenses are *not permitted*." *Lantry* v. *Wallace*, 182 U.S. 536, 549-550 (1901) (emphasis added); *County of Oneida v. Oneida Indian Nation of N.Y.*, 470 U.S. 226, 244, n.16 (1985) ("[A]pplication of the equitable defense of laches in an action at law would be novel indeed."). This is not a mere semantic separation of forms, but a substantive *functional* and *jurisdictional* separation that prevents courts from converting statutory rights into mere privileges that can be refused as a matter of judicial discretion or equity. The Supreme Court has held "equitable principles [as] applicable *only* against one who affirmatively has sought equitable relief." *Manufacturers' Finance Co.* v. *McKey*, 294 U.S. 442, 453 (1935) (emphasis added). Therefore, statutory rights are not "subject to denial or

curtailment in virtue of equitable principles." *Id.*; *Deweese v. Reinhard*, 165 U.S. 386, 390 (1897) ("A court of equity acts only when and as conscience commands; and, if the conduct of the plaintiff be offensive to the dictates of natural justice, then, whatever may be the rights he possesses, and whatever use he may make of them in a court of law, *he will be held remediless in a court of equity*.") (Emphasis added).

The Federal Rules of Civil Procedure merged the procedures of law and equity in 1938 to create a single "civil action." Fed. R. Civ. Proc. § 2. However, that procedural merger "[did] not abolish the distinction between law and equity" as a substantive matter. *Coca-Cola Co.* v. *Dixi-Cola Labs.*, 155 F.2d 59, 63 (4th Cir. 1946); *see Stainback* v. *Mo Hock Ke Lok Po*, 336 U.S. 368, 382 n.26 (1949) ("substantive principles … remain[ed] unaffected"); *Grupo Mexicano de Desarrollo, S.A.* v. *All. Bond Fund, Inc.*, 527 U.S. 308, 322 (1999) (The "merger did not alter substantive rights"). Federal courts remain constrained to "apply equitable principles to equitable rights and legal principles to legal rights." *Sun Oil Co.* v. *Burford*, 130 F.2d 10, 17 (5th Cir. 1942), *rev'd on other grounds*, 319 U.S. 315 (1943). Indeed, the Supreme Court has recognized that, "a major departure from the long tradition of equity practice should not be lightly implied." *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 320 (1982). It later acknowledged that the "substantive and remedial principles [applicable] prior to … the federal rules [have] not changed." *Petrella,* 572 U.S. at 679 (cleaned up, brackets in original). Honoring the substantive distinction between law and equity, the Supreme Court held that in an action at law for

money damages, a United States District Court has no equitable power to enjoin the defendant from transferring assets in which no equitable interest is claimed. *Grupo Mexicano de Desarrollo,* 527 U.S. at 333 (1999).

Later decisions on laches were no different in effect. First, in *Petrella*, the Supreme Court held that the equitable defense of laches could be applied only to equitable claims. 572 U.S. at 678 ("[L]aches is a defense developed by courts of equity; its principal application was, *and remains*, to claims of an equitable cast.") (Emphasis added). The Court reasoned that the 1938 adoption of the Federal Rules of Civil Procedure did not alter "the substantive and remedial principles" of the federal courts. *Id.* at 679. Accordingly, the Court *entirely rejected* the argument that a "federal civil action is subject to both equitable and legal defenses" because "since 1938, federal courts have frequently allowed defendants to assert what were formerly equitable defenses—including laches—in what were formerly legal actions." *Petrella,* 572 U.S. at 699 (Breyer J., dissenting). Second, the Supreme Court was to decide "whether *Petrella*'s reasoning applies to a similar provision of the Patent Act" and held "that it does." *SCA Hygiene*, 580 U.S. at 332 (Laches "cannot be invoked to bar legal relief").

Nothing about the equitable defense of laches suggests any different treatment in a civil action under § 145 or during prosecution at the PTO to obtain the *statutory right* to a patent. Broadening the application of laches defense to claims at law would "clash with the purpose for which the defense developed in the equity courts." *SCA Hygiene,* 580 U.S. at 335.

I.C All cases the Federal Circuit relied upon adjudicated underlying equitable claims by the patent holder

The cases relied upon by the Federal Circuit in *Symbol Technologies*[4] and now by the PTO, are consistent with the proposition that laches may be applied *only against equitable claims*, because they all involved underlying assertions of injunction and *equitable claims*:

(a) *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U.S. 463 (1924), involved the underlying District Court "bills in equity" on patent infringement and seeking to *prevent unfair competition*, which is an equitable claim. *See Webster Electric Co. v. Podlesak*, 255 F. 907, 908 (D. Ill. 1919);

(b) *Woodbridge v. United States*, 263 U.S. 50 (1923), involved an underlying proceeding in the Court of Claims "to hear and determine, … to what extent the United States had used [the patent] and the amount of compensation which was due in *equity* and justice therefor." *Id.* at 51 (emphasis added);

(c) *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159 (1938), involved an underlying suit "to *enjoin* infringements of patents, two of which are here involved." *Id.* at 160 (emphasis added);

(d) *General Talking Pictures Corp. v. Western Electric Co.*, 304 U.S. 175 (1938), involved three underlying suits "brought … to *restrain* [enjoin]

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[4] *Symbol Technologies, Inc. v. Lemelson Med*, 277 F.3d 1361 (Fed. Cir. 2002).

infringements." *Id*. at 176 (emphasis added); and

(e) *Overland Motor Co. v. Packard Motor Co.,* 274 U.S. 417 (1927), involved an underlying suit "in which the Packard Motor Car Company and the Wire Wheel Corporation seek to *enjoin* an alleged infringement by the Overland Motor Company of the Cowles Patent." *Id*. at 418 (emphasis added).

There appears to be no case prior to the 1952 Patent Act upon which the Federal Circuit relies where courts have permitted the equitable defense of prosecution laches other than when patentee sought relief that included equitable relief.

II. Argument that the 1952 Patent Act codified the equitable defense of prosecution laches is unavailing

The Federal Circuit Panel maintained that "in enacting the 1952 Patent Act, Congress intended the prosecution laches defense to remain available."[5]. The relevant provision is 35 U.S.C. § 282(b), which provides: "The following shall be defenses in any action involving *the validity or infringement* of *a patent* and shall be pleaded: (1) Noninfringement, absence of liability for infringement or *unenforceability*." (Emphasis added). The argument is that the *"unenforceability"* defense includes the equitable defense of prosecution laches. This argument is wrong on two levels:

First, § 282 does not apply to patent *applications*. The reference to "any action involving *the validity or infringement* of *a patent*" cannot

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[5] *Hyatt I,* 998 F.3d at 1360.

pertain to the *patentability* of an *application* that is *not* a *patent*; an action under § 145 is not an "action involving *the validity or infringement* of *a patent.*" An *application* in prosecution cannot be *infringed,* nor could it require a *defense against infringement*. The Supreme Court recognized for the predecessor of § 145 that "the proceeding is, in fact and necessarily, a part of the *application* for the patent."[6] Therefore, nothing in § 282 changed the law-equity distinction in prosecution at the PTO, nor in § 145 proceeding, which only involve patent *applications*. Nothing in § 145 permits insertion of any equitable factors when rendering a judgment at law in the case.

Second, the "unenforceability" in § 282(b)(1) at most may include equitable defenses that are only applicable to patent holders' claims for *equitable* relief such as injunctive relief—*not* claims at law. The Supreme Court has already rejected the notion that § 282 makes *all* equitable defenses available against relief at law, holding that the equitable defense of *laches* is not available to defeat *a claim at law* for damages. *SCA Hygiene*, 580 U.S. at 338-39. That defies any view that § 282 makes *all* equitable defenses applicable against all claims at law, traditional boundaries notwithstanding.

Finally, for the proposition that § 282(b)(1)'s "unenforceability" defense to claims at law includes laches, the Panel (at 1361) refers to P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1 (West 1954; reprinted in 75 *J. Pat. & Trademark Off. Soc'y* 161 (March 1993)), where Federico

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[6] *Gandy v. Marble*, 122 U.S. 432, 439 (1887) (emphasis added, describing RS § 4915, the predecessor of § 145).

explains that defenses in § 282 would include "equitable defenses such as laches, estoppel and unclean hands." Federico commentary, however, was made two years after the Patent Act was enacted. It is well settled that "[p]ost-enactment legislative history (a contradiction in terms) is not a legitimate tool of statutory interpretation." *Bruesewitz v. Wyeth LLC*, 562 U.S. 223, 242 (2011).

Where Congress intends equitable principles to govern adjudication, it does so expressly, as it did in the 1946 Lanham Act for trademarks.[7] *See* 15 U.S.C. § 1115(b)(9) (expressly providing for "equitable principles, including laches, estoppel, and acquiescence" as defenses to trademark infringement); 15 U.S.C. § 1116(a) (Courts "shall have power to grant injunctions, according to the principles of equity…"); 15 U.S.C. § 1117(a) ("plaintiff shall be entitled, subject to the principles of equity, to recover… (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.") It even expressly authorized the PTO, an agency normally lacking inherent equitable authority, that in the limited area of "inter partes proceedings, equitable principles of laches, estoppel, and acquiescence, where applicable *may* be considered and applied." 15 U.S.C. § 1069. When it enacted the 1952 Patent Act only a few years later, Congress saw the need and knew how to authorize application of equity, but declined to do so. There is no indication that by enacting § 282, Congress intended to override centuries of equity tradition

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[7] Pub. L. No. 79-489, 60 Stat. 427 (1946)

that precludes equitable claims from defeating claims at law.

Conversely, reading § 282 as codifying equitable doctrines in claims at law means that persons no longer have statutory "rights," but instead only "privileges" judges may deny based on their own assessments of fairness and the equities. At no time did Congress authorize that kind of radical revision to obtaining and enforcing property rights. Whatever grounds might exist to deny petitioner his patents, those grounds cannot rightfully include the equitable defense of prosecution laches.

III. The compelling reasons for granting *certiorari*

The Federal Circuit decisions below have created an unprecedented dark cloud over the enforceability of the statutory patent right. If left standing, this cloud threatens more broadly any statutory right by establishing the availability of *equitable* claims for defeating claims in *actions at law*. Moreover, these Federal Circuit decisions with the prosecution laches presumption they establish were made *precedential*[8] and *final* because the Petitioner's timely request for rehearing *en banc* was denied. Pet.App. 213-14.

The decisions below raise an important federal question in a way that conflicts with decisions by this Court and by sanctioning such a departure by

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[8] *Hyatt I* is classified as "precedential" at www.cafc.uscourts.gov/10-12-2021-20-2321-hyatt-v-hirshfeld-opinion-20-2321-opinion-10-12-2021_1847303/ and *Hyatt II* is classified "precedential" at www.cafc.uscourts.gov/08-29-2025-18-2390-hyatt-v-stewart-opinion-18-2390-opinion-8-29-2025_2565719/ .

lower courts and the PTO. As the single appellate court dealing with patent law, 28 U.S.C. § 1295, the Federal Circuit decision constitutes *a singular* appellate decision, because there can be no "circuit-split" competition on such issues. Given the entrenched position of the Federal Circuit that is now binding on all its future panels as well as lower tribunals, the matter is extremely unlikely to come before this Court again for many years. The result will be irreversible harm not only to applicants prosecuting patent applications at the PTO, but also for all holders of issued patents in force.

The compelling reason for this Court's review is that the Federal Circuit has decided an important federal question in a way that conflicts with relevant decisions of this Court—a question that has never been, but should be, settled by this Court.

CONCLUSION

For the foregoing reasons, the Court should grant the petition for *certiorari*.

Respectfully submitted,

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