

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* SMALL BUSINESS
TECHNOLOGY COUNCIL AND THE ASSOCIATION FOR
AMERICAN INNOVATION IN SUPPORT OF PETITIONER**

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INTEREST OF *AMICI CURIAE* ¹

Amici Curiae Small Business Technology Council (“SBTC”) and the Association for American Innovation (“AAI”) described further below, are particularly qualified to aid this Court in understanding the adverse impact on our inventor and patent holder members, both when prosecuting their patent applications at the US Patent and Trademark Office (“PTO”) or enforcing patents, if the precedential rulings of the Federal Circuit Panel in this case are not corrected. For the reasons detailed below, we support the petition for granting *certiorari*.

The SBTC (www.nsbaadvocate.org/sbtc) is the nation’s largest association of small, technology-based companies in diverse fields. SBTC is a council of the National Small Business Association (NSBA), the nation’s first small-business advocacy organization. NSBA is a staunchly nonpartisan organization with 65,000 members in every state and every industry in the US. SBTC advocates on behalf of the 6000 firms who participate in the Small Business Innovation Research (SBIR) and Small Business Technology Transfer (STTR) programs.

¹ Pursuant to Supreme Court Rule 37.6, counsel for the *amici curiae* certifies that he fully reviewed this brief that was authored by *amici curiae* and that no party or 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.

These SBIR/STTR companies obtain more patents at the PTO than all the American universities combined in most years.

The AAI (<https://aainnovation.org>) is a diverse coalition of innovation ecosystem stakeholders. From authors, inventors, scientists, manufacturers, and engineers to attorneys, intellectual property professionals, policy experts, entrepreneurs, and investors, our vision is a world in which America is the unquestioned leader in technological innovation. We represent a broad range of technology sectors and are committed to supporting and promoting American technological innovation. Our mission is rooted in a strong belief: innovators must be given preference over implementers. *Without the breakthrough, there is nothing to build.*

SUMMARY OF ARGUMENT

The decision below warrants this Court's review because it conflicts with this Court's precedents and permits an equitable doctrine to extinguish patent rights in circumstances not authorized by statute. The Federal Circuit held that the equitable doctrine of prosecution laches could be applied to render unenforceable a patent that issued after "unreasonable and unexplained delay" in prosecution. However, this Court's decisions in *Petrella* and *SCA Hygiene* clarified a principle holding that when Congress creates a framework fully governing timeliness requirements, equitable doctrines of laches cannot override statutory rights. That principle applies equally to prosecution conduct, contrary to the Federal Circuit's continued reliance on its earlier precedent recognizing

prosecution laches and creating uncertainty about the enforceability of issued patents.

The decision below also adopts a six-year presumption of unreasonable and prejudicial delay for applications issued more than six years from their earliest priority date. This presumption, as reasonably interpreted, places a substantial portion of issued patents under a cloud of unenforceability. Patent prosecution commonly extends beyond six years from earliest priority for legitimate reasons inherent in the statutory scheme, including continuation practice, divisional filings following restriction requirements, and ongoing developments of the invention disclosed in Continuation-In-Part (“CIP”) applications. Statistical evidence shows that a significant percentage of issued patents’ prosecution exceed this duration, yet those patents result from ordinary and permissible prosecution activity overseen by the PTO. The presumption therefore lacks any rational connection between the fact proved and the fact presumed and improperly converts routine prosecution timelines into presumptive evidence of “unreasonable and unexplained delay.” By importing a presumption derived from delay in filing infringement suits—where patentees control timing after their patent issues—into the fundamentally different context of agency-controlled examination, the Federal Circuit created a rule that is both doctrinally unsound and practically disruptive.

Independent of that presumption, Congress has already established a comprehensive statutory and regulatory framework governing prosecution timing and applicant conduct, leaving no gap for judicially created equitable doctrines. The Patent Act

authorizes the PTO to regulate applicants' prosecution conduct, and the agency has promulgated extensive rules requiring diligence, good faith, and bona fide advancement of applications, backed by sanctions including forfeiture of the application. These regulations are administered by the expert agency charged with supervising prosecution and evaluating applicant conduct, and they directly address the types of alleged delay that prosecution laches purports to remedy. Allowing courts to superimpose equitable judgements of prosecution laches on top of this detailed framework displaces Congress's chosen scheme and invites courts to second-guess agency determinations regarding prosecution practice.

The Federal Circuit's decision therefore raises an important federal question affecting the enforceability of a substantial portion of issued patents and the proper relationship between statutory patent rights, administrative regulation, and equitable doctrines. Because the decision is precedential and nationwide in effect, the issue is unlikely to receive further percolation, yet it threatens to unsettle expectations of patent applicants, small businesses, and innovators who rely on established continuation practice. This Court's review is warranted to clarify that equitable prosecution laches cannot override statutory and regulatory mechanisms governing patent prosecution and to restore certainty to the patent system.

This brief takes no position on the patentability or the prosecution at the PTO of Petitioner's underlying patent applications.

ARGUMENT

In the two decisions below at *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 has decided an important federal question in a way that conflicts with relevant decisions of this Court and also raises an important question of federal law that has not been, but should be, settled by this Court. The decisions below, if uncorrected, will remain a precedent that presumptively renders unenforceable 30% of issued U.S. patents. The petition for *certiorari* should be granted for the reasons further explained below.

I. The decision below conflicts with Supreme Court precedents

The Federal Circuit held that the equitable doctrine of prosecution laches could be applied to render unenforceable a patent that issued after “unreasonable and unexplained delay” in prosecution. *Symbol Techs., Inc. v. Lemelson Med.*, 277 F.3d 1361 (Fed. Cir. 2002) (“*Symbol I*”). It essentially adopted this holding in the case below. However, later Supreme Court decisions 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) on laches in infringement actions, clarified the *general principles* of unavailability of laches. These general principles also apply to prosecution laches, suggesting that *Symbol I* is abrogated.

II. This Court should grant *certiorari* to review and correct erroneous presumptions reasonably interpreted to render 30% of issued patents unenforceable

. The decision below declared: “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.’”² The Panel further stated: “Consistent with both *Cancer Research* and *Wanlass*, we now hold that, . . . an unreasonable and unexplained prosecution delay of six years or more *raises a presumption* of prejudice, including intervening rights.”³ There would be little reason for the Panel to remove the context of *bringing suit* in reference to *Wanlass*, and to mention “consistency” with *Wanlass*, had the Panel not intended to import *Wanlass*’ six-year delay as triggering the presumption of “unreasonable, inexcusable, and prejudicial” delay in prosecution laches. These statements are justifiably interpreted as creating such a presumption, as argued by counsel for accused infringers.⁴ These are *precedential*⁵

² *Hyatt v. Hirshfeld*, 998 F. 3d 1347, 1369 (Fed. Cir. 2021) (“*Hyatt I*”). (emphasis added) (Quoting *Wanlass v. Gen. Elec. Co.*, 148 F.3d 1334, 1337 (Fed. Cir. 1998)).

³ *Hyatt I*, 998 F.3d at 1370 (emphasis added).

⁴ *Wirtgen America v. Caterpillar*, 746 F.Supp.3d 218, 227 (D. Del. 2024) (“Caterpillar cites to *Hyatt* for the proposition that a six-year delay is *presumptively unreasonable*.”) (Emphasis added); *PMC v. Apple*, Appeal No. 21-2275, Oral Argument (Fed. Cir. July 7, 2022) (Apple’s counsel states at 21:50: PMC’s delay until filing a continuation “was eight years; *that’s enough*,

presumptions applicable broadly—not only to Petitioner.

Patent application prosecution from priority filing to patent issuance involves objective and necessary durations spanning several years. A statistical study reported by SBTC shows that 30% of US patents have issued more than six years after their earliest priority date.⁶ This cannot mean that patent applicants of 30% of US patents have presumptively engaged in “unreasonable, inexcusable, and prejudicial” delay.⁷ The holding below, as reasonably interpreted, presumed *facts that cannot happen* under PTO’s regulations. This is because under the presumption of agency regularity,⁸ the PTO is presumed to have ensured

as [*Hyatt I*] said, to trigger laches.” www.cafc.uscourts.gov/oral-arguments/21-2275_07072022.mp3).

⁵ *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/

⁶ Br. of SBTC in Support of Rehearing below (November 13, 2025) (See Addendum 1 at <https://sbtc.org/wp-content/uploads/2025/11/SBTC-CAFC-Submission-Amicus-Brief-Hyatt-Nov-13-2025-Stamped.pdf#page=32>) (“Br. of SBTC”).

⁷ *Hyatt I*, 998 F.3d at 1369.

⁸ *National Archives and Records Admin. v. Favish*, 541 US 157, 174 (2004) (“The presumption of regularity supports the official acts of public officers and, in the absence of clear evidence to the contrary, courts presume that they have properly discharged their official duties.”) (cleaned up).

compliance with its regulations, including that any applicant submission is not “being presented ... to cause unnecessary delay,” in contravention of 37 C.F.R. § 11.18(b)(2)(i). The PTO—not the District Court—has the specific agency expertise and experience to make the determination under this rule and must be presumed to have enforced it regularly. Accordingly, it is more probable than not, that the patent applicants of these 30% of issued US patents have not engaged in “unreasonable and unexplained delay in prosecution.” Therefore, as reasonably interpreted, the six years “presumed fact” of laches in *Hyatt I* is invalid under Rule 301, Federal Rules of Evidence, because “the nonexistence of the presumed fact is more probable than its existence.”⁹

II.A The six years presumption of prosecution laches is invalid as it lacks rational connection between actual facts and the fact presumed

Even if the equitable defense of laches were available (which it is not), the six years presumptions of laches cannot be legally sustained. First, the panel’s presumptions arose in the context of an unreasonable delay in *filing suit*—a charge that cannot apply to a patent applicant’s *prosecution* conduct during PTO examination. Second, there must be “a rational connection between the fact proved and the fact presumed.”¹⁰ Here, patent

⁹ FRE 301. Notes of Advisory Committee on Proposed Rules.

¹⁰*Id.*

applicants have legitimate objective necessity for filing continuing applications years after the original filing priority dates, leading to application pendency of more than six years after their earliest priority date, during which others may have exploited the invention.

For example, filing dates of Continuations In Part (“CIP”) applications are substantially later than the original priority filing date because they involve additional disclosure of *further* improvements obtained through research and development activities that took place long after the original filing date.

Another example is divisional applications for which the timing for introducing the divisional claims must be deferred under the PTO rules and practice, which may even obviate the need for them (emphasis added below):

1. 37 C.F.R. § 1.142(b) provides for restricted claim “reinstatement in the event the requirement for restriction *is withdrawn or overruled;*” § 1.143 provides for applicant traverse and election of “one invention for prosecution “*in the event the requirement becomes final*”—a finality that *only the examiner* may provide; § 1.144 provides that applicant petition to “the Director to review the requirement... may be deferred *until after final action on or allowance of claims to the invention elected,* but must be filed not later than appeal.”
2. The Manual of Patent Examining Procedure (“MPEP”) in § 809 provides that “should any linking claim be allowable, *the restriction requirement between the linked inventions must be withdrawn.*” Moreover, MPEP § 821.04

requires the examiner to *reconsider* “the propriety of a restriction requirement ... when all the claims directed to the elected invention are *in condition for allowance*, and the nonelected invention(s) should be considered for *rejoinder*.”

The Federal Circuit has acknowledged that reasonable delays in prosecution include (i) filing a divisional application in response to a restriction requirement—*even 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 to attempt to support broader claims as the development of an invention progresses.¹¹ That Court also noted that an applicant may refile an application for other reasons, “provided that such refiling is not unduly successive or repetitive.”¹² Therefore, there is no rational connection between actual facts and the fact the Federal Circuit presumed. This is particularly so because the “imported” six-year presumption was based on delay in *bringing infringement suit*, a period during which the patentee sits on an issued patent having full control in asserting it any time during that period, as opposed to an applicant engaged in prosecution and awaiting PTO actions for issuing the patent.

¹¹ *Symbol Techs., Inc. v. Lemelson Med.*, 422 F.3d 1378, 1385 (Fed. Cir. 2005) (“*Symbol II*”).

¹² *Id.*

III. Congress' composite statutory *and* administrative regulatory framework foreclosed on the equitable doctrine of prosecution laches

The extensive provisions of the Patent Act specify the timeliness, context, and modalities in which applicants must prosecute their applications. This includes provisions implemented and *supplemented* by the administrative regulations that Congress included in *this* framework. This framework includes 35 U.S.C. § 2(b)(2), authorizing the PTO to “establish regulations, not inconsistent with law, which shall govern the conduct of proceedings in the Office.” Accordingly, the PTO promulgated regulations prescribing applicants’ timeliness and conduct. SBTC lists 132 of these PTO regulations that have timing and conduct requirements in all facets of prosecution and submissions to the Office.¹³

The PTO administers these 132 regulations and others based on its expertise as to workflow and *what constitutes proper applicant conduct*. Some rules employ words requiring applicants to act “promptly,”¹⁴ to be “diligent,”¹⁵ act in “good faith,”¹⁶

¹³ Br. of SBTC, Addendum 2.

¹⁴ See 37 C.F.R. §§ 1.6(f)(1)(i); 1.8(b)(1); 1.10(c)(1), (d)(1), (e)(1), (g)(1), (h)(1), (j)(1); 1.25(a); 1.803(a)(2)(vii); 1.804(b); 1.805(c), (d); 5.2(c); 11.103; 11.104(a)(1), (a)(4); 11.118(d)(2)(ii); 41.108(c); 41.109(c); 41.120(c); and 41.124(e).

¹⁵ See 37 C.F.R. §§ 1.701(d)(2); 1.775(d)(1)(ii); 1.776(d)(1)(ii); 1.777(d)(1)(ii); 1.778(d)(1)(ii); 1.779(d)(1)(ii); 1.805(c)(3), (d); 5.25(a)(3)(ii); and 11.103.

and demonstrate “a *bona fide* attempt to advance the application to final action.”¹⁷ The Office developed specific practices to determine applicants’ compliance. For example, for determining whether applicants’ replies “appear throughout to be a *bona fide* attempt to advance the application ... to final action” pursuant to 37 C.F.R. § 1.111(b), the examiners guidance in the MPEP for this rule alone contains 14 sections addressing facets of this requirement.¹⁸ More generally, the PTO routinely demonstrates active use of the timeliness rules when facing what the Office regards as applicant’s dilatory conduct.¹⁹ It is simply unreasonable to expect a

¹⁶ See 37 C.F.R. §§ 1.28(c); 1.29(k); 1.56(a); 1.555(a); 1.765(a); 1.933(a); 5.1(d); and 42.11(a).

¹⁷ See 37 C.F.R. §§ 1.85(a), 1.97(f), 1.111(b), 1.135(c), and 1.957(d).

¹⁸ See MPEP §§ 608.01(b); 706.07(h); 707.07(f); 708.02(a); 714.02; 714.03(a); 804; 818.01; 1302.14; 1490; 2141; 2246; 2266, and 2269.

¹⁹ See e.g., *In re Goodman, et al.*, 1987 Commr. Pat. LEXIS 19, *8, (Comm'r Pat. & Trademarks January 28, 1987) (The “application became abandoned for failure to [meet 37 CFR § 1.111 and] file a complete response to the first Office action.”); *In re Colyvas*, 2010 Commr. Pat. LEXIS 24, *6-9 (Comm'r Pat. & Trademarks May 24, 2010) (Denying repeated petitions to withdraw holding of abandonment after extended period of delay); *In re Gilbert et al.*, 2011 Commr. Pat. LEXIS 328, *1, *16 (Comm'r Pat. & Trademarks July 14, 2011) (Denying petition to withdraw the finality of the final Office action after applicant’s prior attempt at further amendments, thereby enforcing Rule 1.111(b)); *In re Amaitis, et al.* 2012 Commr. Pat. LEXIS 13, *14 (Comm'r Pat. & Trademarks February 27, 2012) (Denying applicants’ petition to vacate abandonment of the application under 37 C.F.R. § 1.135(c) because applicants failed

District Court judge to second-guess the expert agency on such prosecution timing and workflow issues.

The PTO, however, is well-equipped to render such determinations and to *enforce* compliance. The PTO's regulations governing applicants' conduct provide that in every submission to the Office, applicant *certifies* that it "is not being presented ... to cause unnecessary delay or needless increase in the cost of any proceeding before the Office." 37 C.F.R. § 11.18(b)(2)(i). This regulation also provides that "violations of any of [these provisions] are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the [PTO] Director, which may include, but are not limited to ... [t]erminating the proceedings in the Office." *Id.*, § 11.18(c)(5). This is equivalent to forfeiture of the application.²⁰

For example, the PTO reviews submissions of continuing applications filed in chains spanning many years to enforce 37 C.F.R. § 1.78(f) (requiring that "patentably indistinct claims [be eliminated] from all but one application.") While doing so, the PTO expertly evaluates if claiming practice in the chain constitutes "unreasonable and unexplained delay," for example, whether cancelled claims are reintroduced, or otherwise are opportunistically

to elect between multiple inventions and "the amendment on its face is not a 'bona fide attempt to advance the application to final action.'")

²⁰ Rule 11.18's predecessor prior to September 2008, 37 C.F.R. § 10.18, was in place since 1985. *See* 50 *Fed. Reg.* 5172 (Feb. 6, 1985).

“presented ... to cause unnecessary delay.” If so, such contravention of § 11.18(b)(2)(i) justifies PTO’s refusal to enter submissions or even forfeit the application. § 11.18(c)(5).

Hence, the existing statutory scheme and implementing regulations are *already structured* to produce the outcome that prosecution laches purports to achieve through undue expansion of adjudicators’ equitable powers. However, “[s]uch an expansive role careens away from understandings ... of the essentially gap-filling, not legislation-overriding, office of laches.”²¹

The Patent Act in its full framework *including implementing regulations* leaves no room for the application of equitable doctrines to supplant statutes, where agency administrative regulations specifically do so. *See Sebelius v. Auburn Reg’l Med. Ctr.*, 568 U.S. 145, 149 (2013) (Held that equitable tolling of the 180-day statutory period for filing an appeal under 42 U.S.C. § 1395oo(a)(3) is unavailable where an administrative process by regulation in 42 C.F.R. § 405.1841(b) fills “gaps,” extending the period for three years for “good cause.”)

²¹ *Petrella*, 572 U.S. at 680.

CONCLUSION

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

Respectfully submitted,

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