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 *AMICUS CURIAE* DR. RON D. KATZNELSON IN SUPPORT OF PETITIONER

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INTEREST OF *AMICUS CURIAE* [1]

Amicus curiae Ron D. Katznelson, Ph.D., is a technology entrepreneur, named inventor on 25 U.S. patents and applications and an independent scholar of the patent system. He is the author of several *amicus* briefs on patent matters, filed with the U.S. Supreme Court and the Court of Appeals for the Federal Circuit. He served as the Chairman of the Intellectual Property Committee of IEEE-USA during 2019 and 2020 and advises high technology startup companies since 2005.

Dr. Katznelson's interest in this case is twofold. First, he has used continuing application practice in his own patent applications at the U.S. Patent and Trademark Office ("PTO") and experienced the critical role of patents issued from such applications in appropriating returns from patented inventions. Second, he conducted and published empirical research on continuing application practice, showing how their share increased over time, including documenting a trend of narrowing patent claim scope.[2] Dr. Katznelson's

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[1] Pursuant to Supreme Court Rule 37.6, counsel for the *amicus curiae* certifies that he fully reviewed this brief that was authored by *amicus 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 *amicus* 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.

[2] Ron D. Katznelson, "Patent Continuations, Product Lifecycle Contraction and the Patent Scope Erosion - A New Insight into

detailed study and experience in the filed as particularly expressed in this brief should be helpful in aiding this Court on the decision to grant *certiorari*.

SUMMARY OF ARGUMENT

The Question Presented in this case 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." The answer is categorically and unconditionally "No", which applies in any tribunal, and the reason for that lies within the plain statutory text. Congress established in the Patent Act a closed and comprehensive statutory framework governing both entitlement to a patent and the circumstances under which that entitlement may be lost. The Act specifies the exclusive conditions for patentability and expressly enumerates the circumstances that result in forfeiture or loss of the patent right. By defining those conditions in detail, Congress foreclosed on any additional, judge-made grounds for forfeiture based on equitable assessments of prosecution delay. Allowing prosecution laches to extinguish patent rights despite compliance with statutory requirements improperly converts a statutory entitlement to a patent into a discretionary privilege conflicting with the law.

The same statutory design governs continuation practice. Section 120 *guarantees* that a

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Patenting Trends." *Southern California Law Associations Intellectual Property Spring Seminar*, (June 8-10, 2007). Available at SSRN: https://ssrn.com/abstract=1001508.

continuing application meeting its exhaustive enumerated conditions "*shall have the same effect*" as though filed on the date of the earlier parent application. Invoking prosecution laches to deny enforceability of such applications nullifies that statutory guarantee by imposing extra-statutory timing requirements Congress deliberately omitted. The Patent Act instead facilitates prosecution of continuing applications over extended periods, recognizing that divisional, continuation, and continuation-in-part filings commonly occur across many years as inventions are refined, developed, and commercialized. These practices are not anomalies but central features of the statutory scheme, and Congress expected chains of related applications to mature at widely divergent times while retaining the benefit of earlier disclosure dates.

Congress also demonstrated that when it intends equitable doctrines to govern timeliness, it says so expressly. The Lanham Act explicitly authorizes courts and the PTO to apply equitable doctrines such as laches, whereas the Patent Act contains no comparable authorization and instead prescribes specific statutory timing rules and consequences. This contrast reflects deliberate legislative design: trademark law leaves timing issues to equity, while patent law resolves them through statute. The Federal Circuit's application of prosecution laches disregards that distinction and inserts equity where Congress provided a comprehensive statutory regime.

Finally, the statutory continuation framework reflects the unique American "prospecting patent bargain," which encourages early continuous disclosure of inventions' "best mode" in exchange for

allowing inventors to continue developing improvements and disclosing better implementations over time through continuation-in-part applications while preserving early priority dates. These developments frequently span many years and are expressly accommodated by the Patent Act. Treating such extended prosecution as presumptively inequitable undermines Congress's chosen balance between early disclosure and continued technological refinement. Because the Federal Circuit's decisions permit equitable forfeiture of patent rights contrary to this statutory structure, this Court should grant certiorari to clarify that prosecution laches has no place within the Patent Act's closed and comprehensive framework. This brief takes no position on the patentability or the prosecution at the PTO of Petitioner's underlying patent applications.

ARGUMENT

I. Introduction

Through two influential decisions in 2002 that marked a stark departure from judicial holdings since the 1952 Patent Act, the Federal Circuit substituted the patent statutes with judge-made law, to extinguish patent rights via equitable powers of prosecution laches never provided by Congress, under the extra-statutory charge of applicant's "unreasonable and unexplained delay in prosecution." The first decision in *Symbol Technologies*[3] empowered courts under that charge

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

to hold unenforceable patents in infringement suits and the second decision, *In re Bogese*,[4] empowered the PTO to do so through prosecution laches rejection of pending applications. In its decisions below in *Hyatt I*[5] and *Hyatt II*,[6] the Federal Circuit expanded the reach of the prosecution laches doctrine to proceedings under 35 U.S.C. § 145, and for the first time created a substantive burden-shifting rule holding that "a delay of more than six years raises a '*presumption* that it is unreasonable, inexcusable, and prejudicial.'"[7]

This brief shows that these decisions contravene the patent statute. Leaving them stand threaten any patent applicant prosecuting continuing applications at the PTO over extended period after the original priority date with the risk of patent rights forfeiture. That burden-shifting risk arises presumptively any time a third party can merely *allege* that the applicant's prosecution involved "unreasonable and unexplained" delay, even though the applicant complied with all statutory and regulatory timeliness requirements. Patent application prosecution from priority filing to patent issuance including through continuing applications involves objective and necessary durations spanning many years. A statistical study reported by the Small Business Technology Council

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[4] *In re Bogese,* 303 F. 3d 1362 (Fed. Cir. 2002).

[5] *Hyatt v. Hirshfeld*, 998 F. 3d 1347 (Fed. Cir. 2021) ("*Hyatt I*").

[6] *Hyatt v. Stewart*, 148 F. 4th 1376 (Fed. Cir. 2025) ("*Hyatt II*").

[7] *Hyatt I,* 998 F. 3d at 1369. (emphasis added).

("SBTC")[8] shows that 30% of US patents can be subject to such prosecution laches allegation based on the presumptions created by the CAFC in the *Hyatt* decisions.

It is argued that regardless of prosecution time durations, the judge-made equitable doctrine of prosecution laches cannot be sustained under the Patent Act and Supreme Court controlling precedents. All prosecution timeliness requirements were set by Congress in statute; the statute itself provides the *exclusive* modes for applicants' forfeiture of their patent rights; and Congress left no room for equitable judgements on those conditions.

II. Congress prescribed by statute all possible modes of forfeiture or loss of patent rights and excluded prosecution laches

The 1952 Patent Act[9] provided in 35 U.S.C. § 101 that obtaining a patent is "subject to the conditions and requirements *of this title*") (emphasis added). When those statutory conditions and requirements are met, the applicant is "entitled to a patent," and the PTO "*shall* issue a patent therefor." 35 U.S.C. § 131 (emphasis added). Upon enactment in 1952, 35 U.S.C. § 102 provided the following: (emphasis added below)

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[8] "Br. of SBTC in Support of Rehearing, (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=33).

[9] Pub. L. 82-593, 66 Stat. 792 (July 19, 1952) (Hereinafter the "Patent Act")

Conditions for patentability; novelty and *loss of right to patent*

A person *shall be entitled* to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, *or*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, *or*

(c) he has abandoned the invention, *or*

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, *or*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, *or*

(f) he did not himself invent the subject matter sought to be patented, *or*

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, *or* concealed it. In determining priority of

> invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Here, Congress enumerated a series of *disjunctive* exceptions and conditions under the section heading including "*loss of right to patent*," which are enforced both during prosecution of an application at the PTO and after a patent is issued. It is well-recognized that "the title of a statute and the heading of a section are tools available for the resolution of a doubt about the meaning of a statute." [10] There can be little doubt that the enumerated exceptions and conditions under this heading specify in detail *all* the possible modalities for the "*loss of right to patent*," and that those are *exhaustive*. "When Congress provides exceptions in a statute, it does not follow that courts have authority to create others. The proper inference, and the one we adopt here, is that Congress *considered the issue of exceptions* and, in the end, limited the statute to the ones set forth."[11]

Indeed, the enumerated series in § 102 must be interpreted as exhaustive leaving no room for others unlisted given the statutory construction canon *expressio unius est exclusio alterius*, that is, "[t]he

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[10] *Almendarez-Torres v. United States*, 523 US 224, 234 (1998) (cleaned up).

[11] *United States v. Johnson,* 529 US 53, 58 (2000) (emphasis added).

expression of one thing implies the exclusion of others."[12] This canon is strongest here, "when the items expressed are members of an 'associated group or series,' justifying the inference that items not mentioned were excluded by deliberate choice, not inadvertence."[13] Accordingly, neither the courts nor the PTO can create *other* extra-statutory exceptions through equitable doctrines forcing forfeiture that result in "*loss of right to patent*."

"When a statute limits a thing to be done in a particular mode, it includes a negative of any other mode." [14] Specifically, Congress has expressly specified the modes for *forfeiture* of the patent right, and did so under § 102(b) for inventions in "public use" or "on sale" more than one year prior to the priority filing date, in § 102(c) for abandonment of the invention, and in § 102(g) in timeliness consideration of the "reasonable diligence of one who was first to conceive and last to reduce to practice." For example under the "on sale" bar, "a patentee is not allowed to derive any benefit from the sale or use of his machine, without *forfeiting* his right, except within the" grace period prior to filing the application. [15] Forfeiture for abandonment of the

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[12] Antonin Scalia and Bryan A. Garner, *Reading Law: The Interpretation of Legal Texts* (Thomson/West 2012) (§10 Negative-Implication Canon).

[13] *Barnhart v. Peabody Coal Co.*, 537 U.S. 149, 168 (2003).

[14] *Raleigh & Gaston R. Co. v. Reid,* 80 US 269, 270 (1872).

[15] *Metallizing Engineering Co. v. Kenyon Bearing & AP Co.,* 153 F. 2d 516, 519 (2nd Cir. 1946) (emphasis added); See same result under post-AIA law in *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.,* 139 S. Ct. 628 (2019).

invention under § 102(c) may arise in circumstances evidencing constructive dedication of the invention to the public, as described in the case *In re Gibbs*, 437 F.2d 486 (CCPA 1971) ("constructive abandonment is often referred to as 'statutory forfeiture.'") In conclusion, Congress prescribed by law that forfeiture of the patent right can *only* occur under these statutes and left no room for equitable doctrines of forfeiture.

III. The doctrine of prosecution laches contravenes the "shall have the same effect" clause of § 120

35 U.S.C. § 120 in the 1952 Patent Act provided a series of conditions and constraints for statutory-compliant continuing applications. Those conditions are enumerated in § 120 by their components, as rewritten with component numbers added in brackets below (emphasis added):

> **Benefit of earlier filing date in the United States**
>
> [1] An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title
>
> [2] in an application previously filed in the United States
>
> [3] by the same inventor
>
> [4] *shall have the same effect*, as to such invention, as though filed on the date of the prior application,
>
> [5] if filed before the patenting or

> [6] abandonment of or
>
> [7] termination of proceedings on the first application or
>
> [8] on an application similarly entitled to the benefit of the filing date of the first application and
>
> [9] if it contains or
>
> [10] is amended to contain a specific reference to the earlier filed application.

Here too, the detailed list of ten (10) statutory conditions must be interpreted as exhaustive under the negative implication canon of *expressio unius est exclusio alterius*. [16] Thus, by § 120, Congress *guaranteed* that filing of a continuing application within those enumerated conditions, subject to no other extra-statutory conditions, "*shall have the same effect* … as though filed on the date of the prior application."

However, forfeiture of patent rights in a continuing application that meets all of § 120 conditions by invoking prosecution laches rejection contravenes the statutory *guarantee* that its filing "*shall have the same effect* … as though filed on the date of the prior application," because such forfeiture denies that statutory-compliant continuing application the same effect. Indeed, the Federal Circuit's predecessor court explained that "justice and reason … require that § 120 be held applicable

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[16] Scalia and Garner, *Reading Law* (2012) (§10 Negative-Implication Canon); *Barnhart*, 537 U.S. at 168.

to all bases for rejection, that its words 'same effect' be given their full meaning and intent."[17]

Clearly, the statutory guarantee in § 120 permits no exceptions, equitable or otherwise. Congress *did not permit* any equitable judgment that prosecution delay was not "unreasonable" as a required condition for the filing to "have the same effect." The statutory requirement that it "*shall have the same effect*" includes the effect of enforceability and such effect cannot be disturbed by interjecting any extra-statutory judgement that a filing was "unreasonably delayed." Doing so completely emasculates § 120.

IV. Congress knows when to make equitable doctrines available

In the 1946 Lanham Trademark Act, [18] Congress provided express provisions making equitable doctrines, including laches, available in the courts and in the PTO. Those include (emphasis added below):

- 15 U.S.C. § 1069 ("In all inter partes proceedings equitable principles of *laches*, estoppel, and acquiescence, where applicable *may* be considered and applied.")
- 15 U.S.C. § 1115(b)(9) (expressly providing that trademark infringement "*shall* be subject to the … defenses … [t]hat equitable principles, including *laches*, estoppel, and acquiescence, are applicable.")

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[17] *In re Hogan*, 559 F.2d 595, 604 (CCPA 1977).

[18] Pub.L. 79-489, 60 Stat. 427 (July 5, 1946).

- 15 U.S.C. § 1116(a) ("The several 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.")

The Patent Act and the Trademark Act reflect fundamentally different congressional approaches to timeliness, and those differences explain why Congress expressly directed equitable doctrines to be applied in trademark law but not in patent law when the Patent Act was enacted six years later in 1952.

In the Patent Act, Congress created a comprehensive and self-contained statutory timeliness framework governing the creation, duration, prosecution, challenge, and enforcement of patent rights. Patentability itself is barred if the inventor delays filing beyond the statutory limits set forth in 35 U.S.C. § 102. Once an application is filed, the applicant must respond to PTO actions within six months under 35 U.S.C. § 133 or the application is abandoned. If a patent issues, its term is fixed and expires twenty years from filing under 35 U.S.C. § 154, regardless of any equitable considerations. Administrative challenges are subject to strict statutory deadlines, including seeking interference under 35 U.S.C. § 135 with an issued patent no later than one year after it issues. Enforcement is likewise governed by statute: 35 U.S.C. § 286 limits damages recovery to infringement occurring within six years before suit. These provisions collectively define the legal consequences of failing to meet the timeliness requirements at every stage. Because Congress itself specified the timelines modalities, and failure to

meet them results in forfeiture, expiration, or limitation of recovery, there were no statutory gaps requiring equitable doctrines to determine timeliness or to limit remedies.

By contrast, the Trademark Act of 1946 left major aspects of timeliness undefined by statute. Trademark rights arise from use, and there is no statutory analogue to 35 U.S.C. § 102 that bars registration or enforcement based on delay in filing after first use. Trademark rights may continue indefinitely so long as statutory renewal filings are made, and there is no fixed statutory term comparable to the patent term in § 154. Significantly, the Lanham Act contains no statutory limitation period equivalent to 35 U.S.C. § 286 restricting recovery of damages for infringement, and no statutory deadline for bringing infringement actions after rights are violated. In this statutory environment, delay does not automatically result in forfeiture or limitation by operation of statute.

Provisions for cancellation of a registered mark exemplify this point. Under the Lanham Act, certain cancellation grounds are expressly perpetual and may be asserted "at any time," reflecting Congress's determination that these defects invalidate trademark rights regardless of the passage of time. Specifically, a registration may be cancelled at any time if the mark has become generic (15 U.S.C. § 1064(3)); if the mark has been abandoned through discontinued use or loss of source significance (15 U.S.C. §§ 1064(3), 1127); if the registration was obtained fraudulently (15 U.S.C. § 1064(3)); if the mark consists of functional matter that trademark law cannot protect (15 U.S.C. § 1064(3)); or if the mark was improperly registered in violation of

statutory prohibitions, including false suggestion of connection, use of governmental insignia, or use of the name or likeness of a living person without consent (15 U.S.C. §§ 1052(a)–(c), 1064(3)). In addition, certification marks remain perpetually subject to cancellation if the registrant fails to control their use, discriminates in certification, or otherwise ceases to function as a legitimate certifier (15 U.S.C. § 1064(5)). These perpetual cancellation provisions operate without statutory time limitation and are therefore expressly subject to equitable defenses such as *laches*, estoppel, and acquiescence in inter partes proceedings (15 U.S.C. § 1069).

Congress addressed these statutory omissions not by imposing fixed timing rules, but by expressly directing courts and authorizing the PTO to apply equitable principles. The Lanham Act provides that monetary recovery is available "subject to the principles of equity" in 15 U.S.C. § 1117(a), that equitable defenses such as laches and estoppel may bar enforcement under 15 U.S.C. § 1115(b)(9), and that equitable principles including laches may be applied in administrative proceedings under 15 U.S.C. § 1069. These provisions expressly delegate to adjudicators the authority to determine the legal consequences of delay where Congress did not define timeliness requirements by statute.

It is instructive and significant that the three trademark statutes listed above in 15 U.S.C. §§ 1115(b)(9), 1116(a), and 1117(a), all directed to Article III courts, employ the imperative "shall" in directing the court to apply principles of equity, whereas 15 U.S.C. § 1069 on inter partes proceedings at an agency (the PTO) employ the permissive "may" in authorizing the PTO to consider

and apply specifically enumerated equitable principles. Congress does not "hide elephants in mouseholes."[19]

This reflects that when Congress intends equitable doctrines to operate in adjudication, it provides express, tribunal-specific instructions. Administrative tribunals such as the PTO possess no inherent equitable authority, so §1069 affirmatively authorizes it, in inter partes proceedings, to "consider and apply" laches, estoppel, and acquiescence. But Congress did not rely on courts' inherent equitable powers either. In parallel provisions governing infringement and remedies, it directed Article III courts to adjudicate claims "subject to the principles of equity" and to grant relief "according to the principles of equity," thereby making equitable doctrines an integral component of judicial decisionmaking rather than a matter left to background discretion. Read together, these provisions show a deliberate statutory design: Congress specified the role of equity separately for each tribunal and calibrated how strongly they should apply —permissively for the PTO, and as an obligatory governing framework for courts— demonstrating that when Congress intends equitable doctrines to apply in adjudication, it does so through explicit and differentiated statutory commands, not by implication.

The contrast between the two Acts reflects deliberate legislative design. In the Patent Act, Congress specified timeliness requirements and

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[19] *Whitman v. American Trucking Assns., Inc.*, 531 US 457, 468 (2001).

their consequences directly, leaving no role for equity in determining forfeiture or entitlement to relief. In the Trademark Act, Congress instead left critical timing issues unresolved by statute and expressly authorized equity to govern those issues. The presence of express equitable authority in trademark law, and its relative absence in patent law enacted shortly thereafter, reflects not a difference in judicial tradition but a difference in statutory completeness.

The Trademark Act shows that Congress knew how to make equitable doctrines available where needed. Where Congress intends the equitable doctrine of prosecution laches to be specifically available in patent cases, it knows how to provide so *expressly* by law. In the Special Act of March 2, 1901, 56th Cong. 2nd Sess., 31 Stat. 1788. Ch. 821, Congress referred the claim of William E. Woodbridge to the Court of Claims, instructing that "the said court shall first be satisfied that the said Woodbridge did not *forfeit*, or abandon, his right to a patent, by publication delay, *laches*, or otherwise; and that the said patent was wrongly refused to be issued by the Patent Office" (emphasis added).

This Court has repeatedly treated Congress's decision to include a particular mechanism in one statute but omit it in another as evidence of deliberate legislative choice because Congress "knew how to do so." *Custis v. United States*, 511 U.S. 485, 492 (1994) ("when Congress intended to authorize collateral attacks on prior convictions at the time of sentencing, it knew how to do so. Congress' omission of similar language in § 924(e) indicates that it did not intend to give defendants the right to challenge the validity of prior convictions under this statute.")

That reasoning applies here, confirming that Congress intended that, contrary to the Trademark Act, no equitable timeliness doctrine would be applied under the Patent Act.

V. The Patent Act's framework specifically facilitates prosecuting continuing applications over many years

Patent prosecution practice at the PTO has long provided for multiple types of continuing patent applications. Prior to the 1952 Patent Act, the first edition of the PTO's Manual of Patent Examining Procedure ("MPEP") dated November, 1949, describes a **divisional** application as "[a] later application for a distinct or independent invention, carved out of a pending application," § 201.06; a **continuation** application as "a second application for the same invention claimed in a prior application and filed before the original becomes abandoned," § 201.07; and a **continuation-in-part** application as "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." § 201.08.

This 1949 edition of the MPEP further adds in § 201.11 (emphasis added):

> A division, continuation, or continuation-in-part is linked by co-pendency with the original or parent application; and contains, in whole or in part, identical disclosure in common with the original application. Such applications are entitled to the effective filing date of the original application for only the common subject matter disclosed. A division,

> continuation, or continuation-in-part may be filed at any time during the pendency of the parent application. Such continuing application may be filed, for example, after an appeal to the Board or to the Court, provided the parent application has not become abandoned.

The Patent Act essentially codified this proven pro-innovation practice in §§ 101, 120 and 121, which expressly provide for objective and necessary circumstances where filing continuing applications claiming priority to a single original application spans many years. The Federal Circuit has acknowledged that filing continuing applications after substantial periods of prosecution of parent applications include (i) filing a divisional application in response to a restriction requirement—*even as late as just 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, and for other reasons.[20]

These are but some circumstance, and "[t]he exigencies of prosecution commonly compel the issuance of interrelated applications with overlapping disclosures at *widely divergent times*."[21] Experimentation and development over time has

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[20] *Symbol Techs., Inc. v. Lemelson Med.*, 422 F.3d 1378, 1385 (Fed. Cir. 2005) ("*Symbol II*").

[21] *In re Sarett,* 327 F.2d 1005, 1011 (CCPA 1964) (emphasis added).

salutary effects of the scope of patent rights. Claims in patents issued from continuing applications appear better matched to commercial applications, as such patents are empirically shown to have greater private value.[22] Moreover, legislative history shows that Congress expected "*several patents*" to issue from a single parent application.[23] Clearly, 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,"[24] and large chains of continuing applications are not uncommon. For example, PTO data for 2025 shows that of the applications allowed over one year, there were 6,180 having *five or more* parents in their chain of benefit

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[22] Cesare Righi, et al., "Continuing patent applications at the USPTO," 52 *Research Policy,* 104742 (2023) (Finding "that continuing application patents have higher private value than original patents: they are more likely to be renewed, litigated, reassigned, used as collateral, licensed, used to protect drugs listed in the Orange Book, or declared essential for information and communication technology (ICT) standards; according to most measures, they are also more valuable than their own parents.")

[23] Senate Rep. 82-1979, "Revision of Title 35, United States Code," at 20 (June 27, 1952) (Recognizing that an application can be "divided in *several patents"* under Section 121).

[24] *Immersion Corp. v. HTC Corp.*, 826 F.3d 1357, 1360 (Fed. Cir. 2016); *see also In re Henriksen*, 399 F.2d 253, 261 (CCPA 1968) ("We hold that there is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications.")

claim and 832 applications were with *ten or more* such parents in the chain.[25]

V.A The American "Prospecting Patent Bargain" for disclosing improvements in Continuation-In-Part applications over "widely divergent times"

The Patent Act in 35 U.S.C. § 101 provides for obtaining a patent for inventions and also for "*any new and useful improvement thereof* … subject to the conditions and requirements of this title" (emphasis added). One of the "conditions and requirements" for obtaining the exclusive patent right is specified in the first paragraph of 35 U.S.C. § 112, which requires the specification to include the written description and enablement of the invention and "shall set forth the *best mode* contemplated by the inventor of carrying out his invention" (emphasis added). This *quid pro quo* is commonly referred to as the "patent bargain." The Supreme Court explained:

> By the patent laws Congress has given to the inventor opportunity to secure the material rewards for his invention for a limited time, on condition that he make full disclosure for the benefit of the public of the manner of making and using the invention, and that upon the

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[25] PTO, "Studying Applications with Large Patent Families," (June 2025) (Slide 8). Available at www.uspto.gov/sites/default/files/documents/USPTO_Hour_Large_Patent_Family_Study_Final_06042025_CleanCopy_brand508c.pdf

> expiration of the patent the public be left free to use the invention.[26]

Once such disclosure is made in an original patent application, the inventor may later file a continuing application subject to the requirements of § 120, *including* that the invention be "disclosed in the manner provided by the first paragraph of section 112." To be sure, divisional and continuation applications must contain specifications identical to those in the parent application, which must already comply with the first paragraph of § 112. Had Congress intended to limit continuing applications only to these two types of applications, there would have been no need to expressly repeat in § 120 the requirement of the first paragraph of § 112. However, this text is not surplusage.[27] In including this text in § 120, Congress specifically provided for circumstances in which the written description, enablement, or "best mode" disclosures may *differ* from that in the parent application. It is this aspect of § 120 that particularly creates the statutory category of Continuation-In-Part ("CIP") applications.

Congress structured § 120 for protecting CIPs because it was well aware of the substantial benefits

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[26] *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 255 (1945).

[27] Scalia and Garner, *Reading Law* (2012) (§ 26. The Surplusage Canon: "If possible, every word and every provision is to be given effect (*verba cum effectu sunt accipienda*). None should be ignored. None should needlessly be given an interpretation that causes it to duplicate another provision or to have no consequence.")

of CIPs in incentivizing inventors to disclose and teach not only inventions as conceived, but also their improvements and developments once conceived. Many of these developments entail substantial investments over periods of many years. Experimentation with various embodiments of inventions is often necessary, as well as operational use and research of commercialization of such embodiments. Judge Pauline Newman observed: "A patentee may also be encouraged to continue to study and invest in fine tuning the invention, with the added security that the investment, if the project is successful, will be protected even if the patentee's improvements are not separately patentable." [28] Converging on claims specifically directed to such new preferred embodiments may take many years to include in the CIP applications. At these points any improved "best modes" of carrying out the inventions must be disclosed in the CIP. Congress sought to expand disclosure of improvements but understood that inventors should be protected by issued patent claims to those improvements. However, without resorting to the original priority date, such claims may be deemed obvious in view of the parent priority applications or intervening prior art later than the priority date.

Accordingly, the Patent Act strikes a balance between the public interest in *early* disclosure of inventions, and inventors' ability to fully appropriate returns from their developed and perfected inventions. Under that balance, patent applications

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[28] *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F. 3d 1512, 1533 (Fed. Cir. 1995) (Newman, J., concurring).

for many technologically important inventions have been filed long before commercial exploitation became possible. At the front-end, the patent application need not disclose a device or process in fully developed or commercially valuable form—only an embodiment of the invention in the "best mode" known to the inventor to work at that time. Thus, applications are typically filed early from the first positive results, and in the United States, failure to do so may result in the applicant's loss of patent right. The rules that forced early disclosure of inventions and filing under the Patent Act are extensive. See 35 U.S.C. §§ 102(a)-(e), and (g) above. On the back-end, the CIP regime facilitates appropriating returns from downstream invention developments.

For example, the "on sale" bar against secret commercialization codified in § 102(b) forces early disclosure of inventions [29] and is unique to U.S. patent law, as patentability in foreign patent laws is governed by absolute novelty based on public disclosure. CIPs and the requirement for "best mode" disclosure are also unique to U.S. patent laws. Foreign patent laws do not permit claiming priority to an earlier application through CIPs, but also do not require the disclosure of "best mode" in the

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[29] *Metallizing Engineering Co.*, 153 F. 2d at 519 ("[A] patentee is not allowed to derive any benefit from the sale or use of his machine, without forfeiting his right, except within the" grace period prior to filing the application.) See same result under post-AIA law in Helsinn Healthcare, 139 S. Ct. 628.

specification.[30] The American patent system can thus be seen to have long employed a unique "*prospecting patent bargain*" that foreign patent systems forego: early filing stakes an exclusive position that encourages exploration of improved implementations, which must then be disclosed through best-mode updates in CIP applications. Absent this CIP's "*prospecting patent bargain*," inventors would lack incentives to disclose *further* invention developments and improvements, which may be the most valuable aspects of their inventions. Such developments of the prospects necessarily span many years, and therefore, so do legitimate prosecutions of CIP applications.

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[30] Donald S. Chisum, "Best Mode Concealment and Inequitable Conduct in Patent Procurement: A Nutshell, a Review of Recent Federal Circuit Cases and a Plea for Modest Reform," 13 *Santa Clara Computer & High Tech. L. J.* 277, 282 (1997) ("The intricate best mode disclosure requirement is unique to the United States.")

CONCLUSION

Throughout its enactments, Congress created in the Patent Act a closed, self-contained framework and left no "gap" for equitable doctrine of prosecution laches by its choice of modalities for fairly and flexibly enforcing timeliness requirements in prosecuting patent applications, including by the administrative framework that Congress authorized the PTO to implement.

This Court should grant certiorari to review the Federal Circuit's decisions below and to clarify that the equitable doctrine of prosecution laches cannot be available under the Patent Act.

Respectfully submitted,

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