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, UNITED STATES PATENT AND TRADEMARK OFFICE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Since 1995, Congress has provided that the term of an issued U.S. patent generally runs from the date that a patent application is *filed*. Before that time, a patent term instead ran from the date that a patent was *issued*, which sometimes created an incentive for an applicant to delay issuance in order to maximize the value of its patent rights. This Court has responded to such delay by applying the equitable doctrine of prosecution laches to hold that patent rights can be "forfeited" if an applicant unreasonably "postpones * * * the beginning of the term of his monopoly" and thus "puts off the free public enjoyment of the useful invention." *Woodbridge* v. *United States*, 263 U.S. 50, 56 (1923).

In this case, the United States Patent and Trademark Office (USPTO) rejected various claims in petitioner's patent applications. Petitioner filed suit in federal district court under 35 U.S.C. 145 to challenge those rejections. The USPTO raised prosecution laches as a defense to that suit, and the court of appeals ultimately affirmed the district court's entry of judgment for the government on that ground, based on petitioner's unreasonable and prejudicial delay in prosecuting patent applications that he had filed under the pre-1995 statute. The question presented is as follows:

Whether the USPTO may invoke prosecution laches as a defense to a disappointed patent applicant's suit under 35 U.S.C. 145.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-16a) is reported at 148 F.4th 1376. The court of appeals' prior opinion (Pet. App. 215a-264a) is reported at 998 F.3d 1347. The memorandum opinion of the district court (Pet. App. 17a-209a) is available at 2024 WL 2208581. The district court's prior memorandum opinion (Pet. App. 265a-315a) is reported at 332 F. Supp. 3d 113.

JURISDICTION

The judgment of the court of appeals was entered on August 29, 2025. A petition for rehearing was denied on January 22, 2026 (Pet. App. 212a-214a). The petition for a writ of certiorari was filed on March 2, 2026. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. The Patent Act of 1952, 35 U.S.C. 1 *et seq.*, makes the United States Patent and Trademark Office (USPTO or PTO) "responsible for the granting and issuing of patents." 35 U.S.C. 2(a)(1). After a patent application is filed, the USPTO undertakes an examination process to determine whether a patent should issue. 35 U.S.C. 131. In that process, the applicant prosecutes its application through a back-and-forth with a USPTO patent examiner. See 35 U.S.C. 132(a); 37 C.F.R. 1.102-1.146, 1.111(a) and (b). If the examiner denies the application, the applicant may appeal to the Patent Trial and Board (Board), an administrative body within the USPTO that was formerly known as the Board of Patent Appeals and Interferences. 35 U.S.C. 134(a); see Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3(b), 125 Stat. 290 (2011).

"If the Board also denies the application, the Patent Act gives the disappointed applicant two options for judicial review." *Kappos* v. *Hyatt*, 566 U.S. 431, 434 (2012). The applicant may appeal the Board's adverse ruling to the United States Court of Appeals for the Federal Circuit. 35 U.S.C. 141. Alternatively, the applicant may file a civil action in federal district court. 35 U.S.C. 145. The plaintiff in a Section 145 suit may "present new evidence to the district court that was not presented to the PTO." *Kappos*, 566 U.S. at 435. And "if new evidence is presented on a disputed question of fact, the district court must make *de novo* factual findings that take account of both the new evidence and the administrative record before the PTO." *Id.* at 446.

Until 1995, a patent term ran from the date on which the patent was issued. Pet. App. 217a; see, *e.g.*, Patent Act of 1790, ch. 7, § 1, 1 Stat. 110; Patent Act of 1861, ch. 88, § 16, 12 Stat. 249. "The fact that patent term was keyed

to the date of issuance, rather than the date of filing [an application], incentivized certain patentees to delay prosecuting their patents" in order to "obtain a patent at a financially desirable time when the accused product market had become suitably developed." Pet. App. 217a. "Critics of this practice have argued that it harms industries by upsetting the expectations of product manufacturers," "deprives the public of timely disclosure," and "add[s] to the administrative burdens on" the USPTO. *Id.* at 217-218a.

Beginning in 1995, Congress changed the term of U.S. patents to run instead from the date on which a patent application was filed, pursuant to the Agreement on Trade-Related Aspects of Intellectual Property at the Uruguay Round of the General Agreement on Tariff and Trade (GATT). Uruguay Round Agreements Act, Pub. L. No. 103-465, §§ 532, 534, 108 Stat. 4983, 4990. That change triggered a "gold rush" known as the "'GATT Bubble'" in 1995, when applicants "filed a large number of applications in the short period before the change in patent term," requiring the USPTO to hire "hundreds" of examiners to process those applications. Pet. App. 219a.

2. Petitioner is a "prolific patent filer and litigant." *Hyatt* v. *Hirshfeld*, 16 F.4th 855, 857 (Fed. Cir. 2021); see, *e.g.*, *Kappos*, *supra*; *Franchise Tax Bd.* v. *Hyatt*, 587 U.S. 230 (2019). He has filed nearly 400 patent applications, including 381 applications during the GATT Bubble, which was "the most of any filer" during that period. Pet. App. 252a; see *id.* at 220a.

Petitioner's GATT Bubble applications are "highly unusual" in several respects. Pet. App. 25a. For example, those applications were "bulk-filed," with "each one being a photocopy of one of 11 earlier [patent] applications,"

including "numerous duplicate" claims. *Id.* at 220a, 230a; see Gov't C.A. Resp. Br. 14 (graphic illustration). They are "extraordinarily lengthy and complex," *Hirshfeld*, 16 F.4th at 857 (citation omitted), extending for hundreds of pages each, Pet. App. 221a. And as amended by petitioner, they include about "300 claims per application," for "a total of approximately 115,000" claims, which "far exceed[s] the average." *Ibid.*; see *id.* at 194a (explaining that petitioner's applications are "in the top 0.02% of applications" by claim count). By contrast, "a typical patent application contains about 20 to 30 pages" and "20 claims." *Id.* at 221a, 281a-282a; see *id.* at 260a (explaining that "a typical examiner could prepare an office action for a typical application in two to three days, but each office action for [petitioner's] applications took approximately four months").

Petitioner's prosecution of his applications has posed "unique" and "'extreme'" challenges for the USPTO. Pet. App. 255a (citation omitted). For example, although petitioner initially "agree[d]" to "focus each application on a different invention," he did not abide by that agreement. *Id.* at 227a. Instead, he filed a series of amendments "dramatically increasing" the number of claims, "rewriting" claims to "shift[] subject matter from one application to another," "presenting numerous duplicate or patentably indistinct claims across applications," and "filing claims that [he] had already lost in [other] proceedings." *Id.* at 138a, 230a. Petitioner "did not intend for the PTO to examine" many of those amendments, which he instead filed to "buy time" by "effectively restart[ing] prosecution" on his "placeholder[]" applications. *Id.* at 103a, 229a, 252a. The "significant hurdle[s]" petitioner created meant that the USPTO "could not effectively examine [his] applications using ordinary means,"

which delayed examination by years or decades. *Id.* at 200a, 224a; see *id.* at 252a-253a. The USPTO eventually created a 12-examiner unit dedicated to processing his applications under special procedures, which took far longer (and cost the government far more money) than typical applications. See *id.* at 164a, 169a, 201a, 223a, 259a-260a. All told, petitioner's conduct "created a perfect storm that overwhelmed the PTO" and "all but guaranteed indefinite prosecution delay." *Id.* at 254a-255a.

3. This case involves four of petitioner's GATT Bubble patent applications. Pet. App. 3a. The examiner rejected most of the claims in those applications, and the Board affirmed in part and reversed in part. *Ibid.* Petitioner then filed suit in federal district court under Section 145, and the court of appeals ultimately held that the suit was barred by prosecution laches. *Id.* at 1a-16a.

a. The examiner and Board adjudicated petitioner's applications based on various grounds of patentability under the Patent Act, including "lack of written description," "obviousness," "lack of enablement," and "anticipation." Pet. App. 224a-225a. The examiner and Board did not invoke prosecution laches as a ground for rejecting any of petitioner's patent claims.

b. In 2005 and 2009, petitioner challenged the Board's rulings by filing suit under 35 U.S.C. 145 in the United States District Court for the District of Columbia. Pet. App. 3a. The USPTO asserted an affirmative defense of prosecution laches in each case. *Ibid.*

In 2018, the district court rejected the USPTO's defense and entered judgment for petitioner in relevant part. Pet. App. 3a, 265a-315a. The court agreed with the government that the defense of prosecution laches—an "equitable doctrine that can hold patents unenforceable

when an applicant engages in unnecessary and unexplained delays in prosecuting a patent"—is "available to the PTO." *Id.* at 265a-266a, 273a. The court explained in particular that, "[b]ecause the PTO is empowered to assert prosecution laches administratively, and because litigants may assert the same before district courts [in infringement suits], the affirmative defense ought also be available to the PTO in a §145 action." *Id.* at 273a. The court further found that in certain respects petitioner's prosecution conduct "was not reasonable." *Id.* at 313a. The court nonetheless concluded that petitioner had "not cause[d] unreasonable and unexplained delay * * * sufficient to warrant dismissal of these four matters for prosecution laches." *Ibid.*

c. In 2021, the court of appeals vacated the district court's judgment in relevant part and remanded for further proceedings. Pet. App. 215a-264a. The court held that the defense of prosecution laches is available to the USPTO in a suit brought under Section 145. *Id.* at 216a; see *id.* at 243a (explaining that "the PTO may assert the prosecution laches defense in a § 145 action even if it did not previously issue rejections based on, or warnings regarding, prosecution laches during the prosecution of an application that is at issue in the § 145 action"). The court further held that the district court had erred in concluding that the USPTO had failed to prove prosecution laches in this case. *Id.* at 216a. The court of appeals found that the district court had "failed to properly consider the totality of the circumstances," including petitioner's conduct across his GATT Bubble applications, by "repeatedly discount[ing] or ignor[ing] evidence showing that [petitioner's] conduct caused unreasonable and unexplained delay." *Id.* at 244a.

The court of appeals determined that the USPTO's "prosecution laches evidence and arguments presented at trial are enough to shift the burden to" petitioner, given the "magnitude of [petitioner's] delay in presenting his claims for prosecution," petitioner's patterns of conduct "frustrat[ing]" examination, and the fact that "no reasonable explanation has been shown to justify [his] prosecution approach." Pet. App. 251a-252a, 254a, 256a. The court also found that petitioner's "clear abuse of the PTO's patent examination system" had inflicted prejudice on the USPTO and the public that justified prosecution laches in these "rare circumstances." *Id.* at 259a. The court of appeals vacated the district court's judgment in part and remanded for further proceedings at which petitioner could present additional evidence that might rebut the government's showings of unreasonable delay and prejudice. *Id.* at 263a.

d. On remand, the district court held a nearly three-week bench trial on petitioner's rebuttal arguments against prosecution laches. Pet. App. 5a. In 2024, the court entered judgment for the USPTO on its prosecution-laches defense. *Id.* at 17a-211a. The court's opinion set forth 247 findings of fact and various conclusions of law, including that petitioner's conduct was "inexcusable" and "constituted a clear abuse of the patent examination system"; that petitioner's testimony was "not credible" and "falls far short of justifying decades of resulting delay"; and that petitioner's delay had "prejudiced" the "public," "third parties," and the USPTO. *Id.* at 176a, 178a, 181a, 207a-208a. The court concluded that the facts it "found based on the complete trial record require a singular result—judgment for the PTO. No other result is even colorable." *Id.* at 209a.

e. In 2025, the court of appeals affirmed. Pet. App. 1a-16a. On appeal, petitioner argued that the prosecution-laches defense "is inconsistent with" this Court's decisions in *SCA Hygiene Products Aktiebolag* v. *First Quality Baby Products, LLC*, 580 U.S. 328 (2017), and *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663 (2014). Pet. App. 7a (citation omitted). The court of appeals rejected that argument, adhering to its prior ruling that prosecution laches is an available defense. *Id.* at 7a-9a. The court declined to consider petitioner's argument that application of prosecution laches here would be inconsistent with a 1992 Board decision, explaining that petitioner had "forfeited" that argument by "fail[ing] to make" it "before the district court." *Id.* at 9a. The court of appeals further held that the district court had not abused its discretion in ruling for the USPTO, "following more than 1,000 pages of post-trial briefing, and a nearly three-week trial, during which the district court admitted hundreds of exhibits into evidence." *Id.* at 10a.

f. The court of appeals denied rehearing en banc without noted dissent. Pet. App. 212a-214a.

ARGUMENT

Petitioner contends (Pet. 11-22) that the doctrine of prosecution laches in patent cases is inconsistent with the relevant statutory text and with this Court's precedents. The court of appeals correctly rejected that contention. This case is a poor vehicle for considering the issue because petitioner forfeited certain arguments below. In addition, the question presented has limited and diminishing importance because the vast majority of pending patent applications and patents in force today postdate the 1995 change in patent term. That shift to a regime under which the patent term runs from the date

the patent application is filed has largely eliminated the incentive for delay that existed under the pre-1995 statute. This Court has previously denied petitions raising similar issues, see *Personalized Media Commc'n, LLC* v. *Apple Inc.*, 144 S. Ct. 290 (2023) (No. 23-230); *Barr Labs., Inc.* v. *Cancer Research Tech. Ltd.*, 565 U.S. 977 (2011) (No. 11-131); *Lemelson Med., Educ. & Research Found.* v. *Symbol Techs.*, 537 U.S. 825 (2002) (No. 01-1855), and it should follow the same course here.

1. The decision below is correct.

a. This Court and others have long recognized the equitable doctrine of prosecution laches. In *Kendall* v. *Winsor*, 62 U.S. (21 How.) 322 (1858), the Court deemed it "unquestionable" that an inventor "may forfeit his rights as an inventor by a wilful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others." *Id.* at 329. Building on that precedent, the Court subsequently upheld the denial of patent rights on the ground that an inventor had "forfeited or abandoned his right to a patent by his delay and laches" in prosecuting his application over "9 and a half years" from 1852 to 1861. *Woodbridge* v. *United States*, 263 U.S. 50, 55, 57 (1923) (citing *Kendall*, 62 U.S. (21 How.) at 322). The Court similarly held with "no hesitation" that an unjustified eight-year prosecution delay "was unreasonable" and "constitutes laches, by which the [inventor] lost whatever rights it might otherwise have been entitled to." *Webster Elec. Co.* v. *Splitdorf Elec. Co.*, 264 U.S. 463, 466 (1924).[1] As applied in such

[1] Cf. *Crown Cork & Seal Co.* v. *Ferdinand Gutmann Co.*, 304 U.S. 159, 167-168 (1938) (recognizing the doctrine but declining to apply it on the case's facts); *General Talking Pictures Corp.* v. *Western*

cases, prosecution laches properly furthers a traditional "great object" of the patent system, which is to "giv[e] the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible" after a patent's "limited" term. *Pennock* v. *Dialogue*, 27 U.S. (2 Pet.) 1, 19 (1829).

The court of appeals correctly held that the defense of prosecution laches "remain[s] available" under the Patent Act of 1952. Pet. App. 237a. Nothing in the text or context of that statute indicates that Congress "abrogated the defense of prosecution laches" as established in prior precedent. *Symbol Techs., Inc.* v. *Lemelson Med.*, 277 F.3d 1361, 1365 (Fed. Cir.), cert. denied, 537 U.S. 825 (2002). "To the contrary," the contemporaneous understanding "[s]hortly after the passage of the Act" was that the new law "maintain[ed] the defense." *Id.* at 1366.

Congress enacted the Patent Act of 1952 "'against a background of common-law'" and "equitable" adjudicatory principles, and "it 'expect[ed]' those principles to 'apply except when a statutory purpose to the contrary is evident.'" *Minerva Surgical, Inc.* v. *Hologic, Inc.*, 594 U.S. 559, 572 (2021) (citation omitted). Like the doctrine of "assignor estoppel" that the Court applied in *Minerva Surgical*, prosecution laches "was by 1952 just such a background principle of patent adjudication, and Congress gave no indication of wanting to terminate it or

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Elec. Co., 304 U.S. 175, 183 (1938) (similar); see also, *e.g.*, *In re Fritts*, 45 App. D.C. 211, 215-216 (D.C. Cir. 1916) (applying *Kendall* to affirm the Patent Office's rejection of an application for "laches" in prosecution); *Hartford-Empire Co.* v. *Coe*, 76 F.2d 426, 426-427 (D.C. Cir. 1935) (per curiam) (similar, applying *Webster*); *Ex parte Hull*, 191 U.S.P.Q. 157, 1975 WL 20742, at *1 (B.P.A.I. Feb. 20, 1975) (collecting cases of patent "rejection[s] based upon the equitable doctrine of laches").

disturb its development. Nor has Congress done so since that time." *Ibid.*

b. Petitioner primarily contends (Pet. 11-17) that continued application of prosecution laches would be inconsistent with *SCA Hygiene Products Aktiebolag* v. *First Quality Baby Products, LLC*, 580 U.S. 328 (2017), and *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663 (2014). The court of appeals correctly rejected petitioner's reliance on those inapposite decisions. See Pet. App. 7a-9a.

In *SCA Hygiene* and *Petrella*, this Court addressed "the relationship between the equitable defense of laches and claims for damages that are brought within the time allowed by a statute of limitations." *SCA Hygiene*, 580 U.S. at 331. The Court concluded that the Patent Act of 1952 should not be read to "codify such a defense" because the Court's pre-1952 precedents had generally rejected it and no prior "consensus" of lower-court decisions supported it. *Id.* at 339-340; see *Petrella*, 572 U.S. at 678-680 (similar). But the Court did not disturb the continued viability of other doctrines that *were* "well-established" in 1952, such as "equitable estoppel," which still "provides protection against * * * unscrupulous patentees," *SCA Hygiene*, 580 U.S. at 345-346, or assignor estoppel, which the Court subsequently reaffirmed in *Minerva Surgical*, 594 U.S. at 566-579.

Thus, in *SCA Hygiene* and *Petrella*, this Court held that, when Congress has enacted a statute of limitations that specifies the period for commencing a damages suit in court, laches ordinarily may not be used to bar suits filed within the limitations period. See *SCA Hygiene*, 580 U.S. at 346 ("Laches cannot be interposed as a defense against damages where the infringement occurred within the period prescribed by" the Patent Act's statute of limitations.); *Petrella*, 572 U.S. at 679 ("[I]n face

of a statute of limitations enacted by Congress, laches cannot be invoked to bar legal relief."). The question presented here differs substantially from the issue the Court decided in those cases. The gravamen of the government's prosecution-laches argument is not that petitioner waited too long before filing suit in court, but that he engaged in dilatory conduct during the patent-examination proceedings before the USPTO. That argument rests on longstanding precedents that *SCA Hygiene* did not address or purport to abrogate. See pp. 9-10, *supra*. And while the existence of precisely defined limitations periods was central to the Court's decisions in *SCA Hygiene* and *Petrella*, the Patent Act does not impose a fixed time period to complete prosecution, and prosecution laches "protect[s]" the public interest in the spread of scientific progress, not just the interests of particular "defendants." Cf. *SCA Hygiene*, 580 U.S. at 333.

Petitioner now asserts (Pet. 17, 22) that, when the Patent Act of 1952 was enacted, this Court had not previously "recognize[d]" that prosecution laches "existed." But petitioner correctly acknowledged below that this Court had repeatedly "applied laches" to patent-prosecution conduct in older cases, including *Woodbridge*, *Webster*, *Crown Cork*, and *General Talking Pictures*. Pet. C.A. Reply Br. 9-10; see Pet. C.A. Opening Br. 23 (similar); p. 9 & n.1, *supra*. Petitioner's attempts (Pet. 17-22) to distinguish those precedents are unavailing.

The "laches" defense affirmed in *Woodbridge*, 263 U.S. at 55, did not turn on a particular statutory clause, contra Pet. 19-20; rather, the defense "would have been open to the defendants without this clause," which merely presupposed the doctrine's availability, *Woodbridge* v. *United States*, 55 Ct. Cl. 234, 256 (1920), aff'd, 263 U.S. 50. "[T]he claims at issue in *Webster* were not the subject of

an interference proceeding," and "[n]othing suggests that *Webster* was limited to cases involving an interference." *Symbol*, 277 F.3d at 1365; contra Pet. 20-21. Similarly, *Crown Cork* and *General Talking Pictures* "validated prosecution laches and did not limit [the defense] to cases involving interferences"; although the Court found that the "evidence" in those cases did not warrant the application of laches, the Court again "ratified the existence of the prosecution laches defense" as a general matter. *Symbol*, 277 F.3d at 1365; contra Pet. 21-22.

The other decisions on which petitioner relies (Pet. 11-12, 17-22) are not to the contrary. *United States* v. *American Bell Telephone Co.*, 167 U.S. 224 (1897), did not address prosecution laches; it considered a claim "not set up as laches" but instead as "fraud on the public." *Id.* at 242 (citation omitted). The Court in *Chapman* v. *Wintroath*, 252 U.S. 126 (1920), rejected a "laches" defense based on the evidence "in this record"—while noting that the examiner "did not permit the introduction of any evidence with respect to laches"—and specifically contemplated that in other cases, an application "may" be "bar[red]" even though it was submitted "within the two-year period allowed for filing" by statute at the time. *Id.* at 139. Similarly, the Court's decision not to apply laches in *Overland Motor Co.* v. *Packard Motor Co.*, 274 U.S. 417 (1927), did not rest solely on a statutory filing period, but also on the fact that "no other ground appears by reason of which laches could be imputed to the applicant." *Id.* at 424; see *id.* at 426-427 (acknowledging *Woodbridge*'s application of laches). None of those decisions rebuts the strong foundation for prosecution laches established by more than a century of this Court's precedent.

Petitioner also argues that, whatever the pre-1952 rule may have been, the enactment of certain timing provisions in the Patent Act of 1952 leaves "no room" for prosecution laches today. Pet. 13; see Pet. 15-16. That argument lacks merit. Although the current statute includes limited provisions that address certain subsidiary steps in the administrative process, it does not "explicitly put[] a limit upon the time" to complete patent prosecution. Contra Pet. 13 (citation omitted). As this case illustrates, an applicant's overall course of conduct may substantially disrupt the USPTO's operations and produce an "indefinite" extension of the prosecution process, even though the applicant does not violate any statutory deadline governing a discrete step in that process. See pp. 4-5, *supra*.

In that respect, this case is markedly different from *SCA Hygiene* and *Petrella*. The Court in those cases rejected proposed laches rules that would have imposed alternative judge-made deadlines for taking the precise action—the filing of a complaint in a patent- or copyright-infringement suit for damages—that applicable statutory limitations provisions specifically addressed. In addition, the 1952 Act provisions on which petitioner relies are merely analogues of similar timing limits that applied under the prior patent laws and have long coexisted with prosecution laches.[2] Nothing in the 1952 Act changed the fundamental aspect of patent law that historically

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[2] See Act of July 8, 1870, ch. 230, § 24, 26 Stat. 201 (bar for inventions or discoveries "in public use or on sale for more than two years prior to his application"); § 32, 16 Stat. 202 (requiring an applicant to prosecute an application "within two years after any action therein"); § 46, 16 Stat. 204-205 (permitting appeal after two rejections); § 49, 16 Stat. 205 (Patent Office to set period for appeal); *Godfrey* v. *Eames*, 68 U.S. 317, 325-326 (1863) (co-pendency).

underlay the doctrine of prosecution laches: a patent term defined in a way that (until 1995) incentivized prosecution delay. See pp. 2-3, *supra*.

c. In the alternative, petitioner contends that, "[e]ven if prosecution laches were available as a defense in infringement litigation (notwithstanding *SCA Hygiene*), it still would not follow that the PTO could rely upon the doctrine itself to deny the issuance of a patent." Pet. 23; see Pet. 23-26. Indeed, petitioner's question presented focuses specifically on the PTO's authority to invoke prosecution laches as a ground for denying a patent application. See Pet. i ("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."). For three separate reasons, that argument does not warrant the Court's review.

First, petitioner did not make that alternative argument in his appellate briefs below, where he instead argued broadly that "prosecution laches does not exist" for anyone. *E.g.*, Pet. C.A. Opening Br. 15. To the extent that petitioner made any appellate argument based on the 1992 Board decision on which he now relies, Pet. 26, the court of appeals declined to "consider" that argument and held that it was "forfeited because [petitioner] failed to make it before the district court," Pet. App. 9a-10a. As "a court of review, not of first view," this Court likewise should "not consider" petitioner's unpreserved arguments in the first instance. *Cutter* v. *Wilkinson*, 544 U.S. 709, 718 n.7 (2005).

Second, petitioner's alternative argument is incorrect. By statute and as a practical necessity, the agency has the authority to deny a patent application under the prosecution-laches doctrine. The Patent Act of 1952 is similar to earlier patent laws in making the USPTO

"responsible for the granting and issuing of patents," 35 U.S.C. 2(a)(1), and in directing the agency to issue a patent only "if on * * * examination it appears that the applicant is entitled to a patent under the law," 35 U.S.C. 131; cf., *e.g.*, Act of July 8, 1870, ch. 230, § 31, 16 Stat. 202. "Like other administrative agencies," the "PTO has inherent authority to govern procedure before the PTO, and that authority allows it to set reasonable deadlines and requirements for the prosecution of applications," as the agency has done for more than a century. *In re Bogese*, 303 F.3d 1362, 1368 (Fed. Cir. 2002); see pp. 9-10, *supra*. To the extent the 1992 Board decision suggested that the USPTO could not deny a patent application based on prosecution laches, that decision has been superseded by intervening Federal Circuit authority. See Pet. App. 273a (district court recognizing that the Federal Circuit in *Bogese* had "affirmed the PTO's authority to assert prosecution laches as a basis for rejecting a patent application").

Third, this case does not squarely present the question whether the USPTO may invoke prosecution laches administratively, as a basis for denying a patent application. Here, the examiner and the Board did not rely on prosecution laches, but instead rejected various patent claims in petitioner's applications based on substantive patentability requirements. See p. 5, *supra*. The USPTO first invoked prosecution laches in federal district court, as a defense to petitioner's Section 145 suit. Thus here, as in the infringement cases where this Court has previously applied the prosecution-laches doctrine, the courts below treated a patent applicant's dilatory conduct before the agency as a ground for withholding *judicial* relief. The disconnect between the circumstances of this case and petitioner's framing of the question presented

(see Pet. i) provides an independent reason for this Court to deny review.

d. Petitioner additionally criticizes (Pet. 26-29) certain aspects of the specific standard for prosecution laches that the court of appeals applied. This Court should "not consider" those contentions, *Yee* v. *City of Escondido*, 503 U.S. 519, 535 (1992), which fall outside the question presented, see Pet. i ("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."); Sup. Ct. R. 14.1(a). The court of appeals affirmed the application of prosecution laches in this case based on the district court's "247 findings of fact, none of which [petitioner] challenge[d] on appeal," and which demonstrated that petitioner had "unreasonably and inexcusably delayed" prosecution in a "clear abuse" that "prejudiced the PTO and third parties." Pet. App. 10a, 208a. Petitioner's failure to challenge any of those findings, and the court of appeals' consequent failure to address them, provide additional reasons for declining to consider petitioner's belated objections. *Yee*, 503 U.S. at 533.

2. The limited and diminishing significance of the question presented provides a further reason to deny review. Contra Pet. 29-33. As explained, Congress's 1995 change in patent term largely eliminated the potential incentive for dilatory conduct that historically has underlain the prosecution-laches doctrine. See pp. 14-15, *supra*. The Federal Circuit has recognized that under current law, cases of similar delay "are not likely to be frequently repeated, as patent terms are now measured from effective filing date, subject to only limited extensions provided by statute, not by delaying issuance by refiling." *Cancer Research Tech. Ltd.* v. *Barr Labs., Inc.*,

625 F.3d 724, 732 (2010) (citation omitted), cert. denied, 565 U.S. 977 (2011).

Today, the vast majority of pending applications and patents in force post-date the 1995 amendment. And while petitioner contends (Pet. 31-32) that prosecution laches is frequently invoked, he cites no case in which the Federal Circuit has relied on the doctrine to bar a patent application that was filed after the effective date of the 1995 amendment. There is consequently no sound basis for petitioner's assertion (Pet. 32) that the decision below threatens patent practice "going forward."

Even within the universe of pre-1995 applications, the Federal Circuit has generally limited prosecution laches to "extreme outliers" like petitioner, whose inequitable conduct was "extraordinary" and "unique in its scope and nature." Pet. App. 194a, 198a, 262a. The USPTO's Manual of Patent Examining Procedure similarly explains that prosecution laches "applies only in egregious cases of unreasonable and unexplained delay." *Manual of Patent Examining Procedure*, § 2190 (9th ed. Nov. 2024). This Court's review is not warranted to police that small, and shrinking, class of cases.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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