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 U.S. Patent and Trademark Office,
Respondent.

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

REPLY BRIEF FOR PETITIONER

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INTRODUCTION

The doctrine of prosecution laches has no basis in the text of the Patent Act, its history, or any relevant precedent. Congress has set forth the "conditions and requirements" for obtaining a patent, including the timing requirements for every step of the prosecution process. 35 U.S.C. § 101. And it has commanded that the PTO "shall issue a patent" to those who meet such requirements. *Id.* § 131. The PTO may not rewrite the Patent Act under the guise of prosecution laches. Only Congress can amend the statutory deadlines it sets.

In response, the Government says vanishingly little about the statute itself. It asserts that "[b]y statute and as a practical necessity, the agency has the authority to deny a patent application under the prosecution-laches doctrine." BIO.15. But the Government identifies no statutory authorization for its pronouncement. And "practical necessity" is no substitute; it is just another name for administrative fiat.

Left without any statutory authorization, the PTO argues that Congress *implicitly* approved the doctrine as a "background principle of patent adjudication." BIO.10 (citation omitted). But a background principle cannot trump statutory text, and no such doctrine lingered in the background anyway. On the contrary, by the time Congress passed the Patent Act of 1952, this Court had made clear that "[a] party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one." *United States v. Am. Bell Tel. Co.*, 167 U.S. 224, 247 (1897). It had

correspondingly "settled" the rule that a patent "may not be denied" due to an inventor's "delay," so long as his patent was "prosecuted strictly as required by the statutes" Congress enacted. *Chapman v. Wintroath*, 252 U.S. 126, 136 (1920). Since then, this Court has repeatedly stated in *SCA Hygiene*, *Petrella*, and elsewhere that the deadlines set by Congress matter, and laches cannot be used as a means to circumvent the will of Congress. The Federal Circuit's persistence in refusing yet again to recognize that principle calls for this Court's review and reversal.

There is no reason to let the Federal Circuit's freewheeling doctrine persist. Try as it might, the Government cannot manufacture a vehicle issue. Nor can it diminish the importance of the question presented. As the Petition and several *amici* have explained, this issue is not limited to cases predating the 1995 patent term changes. Far from it. There are hundreds of pending cases asserting prosecution laches as a defense to infringement claims under post-1995 patent applications. So without this Court's review, many patentholders and patent applicants will face wasteful litigation. And many more will suffer from the uncertainty spawned by this manufactured doctrine, as the PTO continues to spurn the expressed will of Congress. This Court should grant certiorari and abolish prosecution laches once and for all, just as it abolished litigation laches in *SCA Hygiene* and *Petrella*.

ARGUMENT

I. The Federal Circuit's Prosecution Laches Doctrine Is Indefensible.

The Government has no plausible means to defend the Federal Circuit's prosecution laches doctrine. It fails to ground that doctrine in the Patent Act's text—while ignoring the text that cuts against it. And the Government is simply wrong to argue that this Court has "long recognized" prosecution laches to curtail patent rights. BIO.9. This Court has held exactly the opposite. Review is thus needed to uphold this Court's precedent and the law that Congress enacted.

A. The Prosecution Laches Doctrine Conflicts with the Patent Act's Text.

Start with the Patent Act's text. The Government does not dispute that the doctrine of prosecution laches is atextual. And the text that Congress *did* enact positively refutes it.

The Petition explained why that is so. *See* Pet.15-16, 23-24. The Patent Act sets forth all the "conditions and requirements" for "obtain[ing] a patent." 35 U.S.C. § 101. And among those are detailed timing requirements for every step of the prosecution process. Those include deadlines for filing a patent application, *see id.* § 102(a)-(b), deadlines for filing continuation applications, *see id.* § 120, and deadlines for responding to office actions, *see id.* § 133. If an applicant complies with those statutory deadlines and the Act's other "conditions and requirements," *id.* § 101, then Congress left the PTO no discretion. The agency "*shall* issue a patent therefor." *Id.* § 131 (emphasis added).

The Government conspicuously ignores all that statutory text. And by doing so it gives the game away. For even if prosecution laches were a well-established equitable doctrine—it is not and never was—equitable doctrines must yield when "inconsistent with the text of the relevant statute." *United States v. Beggerly*, 524 U.S. 38, 48 (1998). Such is the case here. Invoking laches to deny patents to inventors who have complied with every statutory prosecution deadline "would give judges a 'legislation-overriding' role that is beyond the Judiciary's power." *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 335 (2017) (citation omitted).

B. The Prosecution Laches Doctrine Conflicts with this Court's Precedent.

In any event, this Court never "established" the "defense of prosecution laches" in the first place. BIO.10. So there was no "background principle" for Congress to carry forward in the Patent Act of 1952. BIO.10 (quoting *Minerva Surgical, Inc. v. Hologic, Inc.*, 594 U.S. 559, 572 (2021)).

1. On the contrary, this Court had by that point "settled" that prosecution laches is not a defense. *Chapman*, 252 U.S. at 136. Where a patent has been "prosecuted strictly as required by the statutes and the rules of the Patent Office," the inventor's rights "may not be denied or diminished on the ground that [his] delay may have been prejudicial to either public or private interests." *Id.* at 136-37.

The Government's passing effort to distinguish *Chapman* fails. BIO.13. It notes that the examiner there "did not permit the introduction of any evidence with respect to laches." *Chapman*, 252 U.S. at 139.

But that is precisely the point: Such evidence did not and could not matter. When it comes to the "action necessary to be taken in order to obtain a patent," the "whole subject is one of statutory origin and regulation." *Id.* at 135. And applicants are "within their legal rights" to act "at any time" within the time limits Congress has prescribed. *Id.* at 139. Arguments of "equitable laches" thus "cannot prevail against the provisions of the statutes." *Id.* at 134, 138 (citing *Am. Bell Tel. Co.*, 167 U.S. at 247); *see also Overland Motor Co. v. Packard Motor Co.*, 274 U.S. 417, 423-26 (1927).

Further, the Government's discussion of *Chapman* confuses the concepts of abandonment, which the patent laws have long recognized, *see infra* at 6, and laches, which they never have. Abandonment occurs when an inventor surrenders his invention "to the public," which "may be proved by express declarations of an intention to abandon, or by conduct inconsistent with any other conclusion." *U.S. Rifle & Cartridge Co. v. Whitney Arms Co.*, 118 U.S. 22, 24-25 (1886). But that is not (and could not be) alleged here. Thus, *Chapman*'s suggestion "that there may" be "abandonment which might bar an application within the two-year period allowed for filing" does not assist the Government. 252 U.S. at 139.

2. Nor does any case the Government cites in support. It first points to *Kendall v. Winsor*, 62 U.S. 322 (1858). But *Kendall* was a "case on abandonment," not laches. 2A *Chisum on Patents* § 6.03[1][a] (2026). The jury there was instructed that if the inventor's "declaration and conduct were such as to justify the defendants in believing he did not intend

to take letters patent," then "such an abandonment to the public" would "destroy [his] right to take a patent." 62 U.S. at 327. The jury found against the defendants as a factual matter, and this Court upheld the instruction as in "strict conformity" with the law. *Id.* at 331. In doing so, the Court said not a word about laches.

To the extent the Government relies on *Pennock v. Dialogue*, 27 U.S. 1 (1829), that, too, was an abandonment case. *Pennock* held that the "true construction" of the Patent Act of 1793 was that an inventor "cannot acquire" a patent if he allows "the thing invented to go into public use, or to be publicly sold or use, before he makes application for a patent." *Id.* at 23-24. The inventor's "voluntary act or acquiescence in the public sale and use is an abandonment of his right." *Id.* at 24. Indeed, that general limit on patentability persists to this day—in the statutory text. *See* 35 U.S.C. § 102(a)(1).

The Government's reliance on other cases from this Court fails for the reasons explained in the Petition. Pet.19-22. Parroting the Federal Circuit's mistake, the Government argues that *Crown Cork* and *General Talking Pictures* "'ratified the existence of the prosecution laches defense' as a general matter." BIO.13 (quoting *Symbol Techs., Inc. v. Lemelson Med., Educ. & Rsch. Found., LP*, 277 F.3d 1361, 1365 (Fed. Cir. 2002)). But *Crown Cork* held the opposite, rejecting a laches defense because the applicant acted within the time "contemplated by the statute." *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159, 168 (1938); Pet.21. And *General Talking Pictures*—which never mentions "laches"—similarly

held that the applicant had acted "in time" because he had followed the statutory deadline. *Gen. Talking Pictures Corp. v. W. Elec. Co.*, 304 U.S. 175, 183 (1938) (citing Rev. Stat. § 4886); Pet.21-22.

The Government also misreads *Woodbridge* and *Webster Electric* in the same ways as the Federal Circuit. It ignores that Woodbridge lost his patent because he acted "in plain violation of the statutory law." *Woodbridge v. United States*, 263 U.S. 50, 63 (1923); Pet.19-20. And it ignores that *Webster Electric* borrowed from "analog[ous]" statutes to fill a statutory timing gap, declaring that a "two-year time limit" would presumptively apply in cases of "copying for interference." *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463, 469-71 (1924); Pet.20-21. That is nothing like the Federal Circuit's prosecution laches doctrine, which "careens away from understandings, past and present, of the essentially gap-filling, not legislation-overriding, office of laches." *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 680 (2014); *see* Pet.13-17.

The Government thus fails to identify any decision suggesting that "prosecution laches '[had] by 1952'" reached the level of "a background principle of patent adjudication." BIO.10 (citation omitted). This Court had never overridden any statutory timeliness provision in the name of laches. Nor has it since.

3. Instead, this Court recently reiterated in *SCA Hygiene* and *Petrella* that "laches cannot defeat" a right exercised "within the period prescribed" by Congress. *SCA Hygiene*, 580 U.S. at 334 (citing *Petrella*, 572 U.S. at 677-80). The Government tries to distinguish those decisions because "the Patent Act

does not impose a fixed time period to complete prosecution." BIO.12; *see also* BIO.14. But Congress provided deadlines for every step along the way. Pet.4-6, 15-16. Thus, just as in *SCA Hygiene* and *Petrella*, Congress has "sp[oken] directly to the issue of timeliness." *SCA Hygiene*, 580 U.S. at 334 (citing *Petrella*, 572 U.S. at 677). Courts "are not at liberty to jettison" that legislative judgment. *Id.* at 335 (citation omitted). Nor can the PTO claim some "inherent authority" to do the same. BIO.16 (citation omitted). It "possess[es] only the authority that Congress has provided." *Nat'l Fed'n of Indep. Bus. v. OSHA*, 595 U.S. 109, 117 (2022).

* * *

In short, the doctrine of prosecution laches conflicts with the Patent Act's text; it violates this Court's precedent; and it lacks any support in historical practice. The doctrine was instead fashioned out of whole cloth by the Federal Circuit in 2002. This Court should grant review and eliminate that judicial invention.

II. This Petition Presents a Clean Vehicle to Address an Exceptionally Important Issue.

Unable to defend the Federal Circuit's equitable freelancing, the Government fumbles for a vehicle issue and strains to diminish the doctrine's significance. Both efforts fail.

A. This Case Is an Excellent Vehicle.

The Government does not dispute that the viability of prosecution laches presents a clean, outcome-determinative question of law in this matter. And the issues have been fully vetted in multiple split

decisions. Pet.12. Given the Federal Circuit's jurisdiction, there is no percolation to come. Pet.30.

The Government thus tries to conjure up a preservation issue. It faults Petitioner for "broadly" arguing below that prosecution laches is not available "for anyone." BIO.15. That is entirely correct; it is not. But the PTO, of course, is part of that universal set. And Petitioner specifically argued that the PTO could not *itself* assert "prosecution laches as a ground [for] rejection," because the doctrine "is no longer viable following *Petrella* and *SCA Hygiene*." Pet. C.A. Br. at 53, ECF No. 47. He then renewed that PTO-specific argument, along with his broader challenge to prosecution laches, in seeking rehearing en banc. *See* Reh'g Pet. at 3-13, ECF No. 145.

The Government also says Petitioner forfeited any "argument" based on a 1992 decision, in which the Board of Patent Appeals said it was aware of no case supporting prosecution laches. BIO.15. That fundamentally misunderstands the law of forfeiture. Once a "claim is properly presented, a party can make any argument in support of that claim." *Yee v. City of Escondido*, 503 U.S. 519, 534 (1992). As all agree, Petitioner has always claimed that "prosecution laches does not exist." BIO.15 (citation omitted). And the Board's observation is not necessary to that claim. It merely "confirms" that the doctrine is a twenty-first century judicial invention. Pet.25-26.

Reaching further, the Government quibbles with the "framing of the question presented." BIO.16. But that question is squarely implicated here. The PTO "invoke[d] the equitable doctrine of 'prosecution laches'" in Petitioner's case "to deny a patent to [him],"

even though he has undisputedly "complied with all the Patent Act's timeliness provisions." Pet.i; *see also* Pet.App.242a (allowing PTO to "assert the prosecution laches defense in a § 145 action" because it was "a basis for denying a patent" under Federal Circuit law).

Finally, the Government notes that Petitioner did not "challenge" the District Court's "findings" or the Federal Circuit's "specific standard" in its question presented. BIO.17. But that only shows why this case is a good vehicle. There are no factual disputes—just a pure legal battle over whether prosecution laches is a legitimate doctrine. The Federal Circuit's standard "only underscores the arbitrary nature of the doctrine" and highlights why this Court should intervene now. Pet.26; *see* NAPP.Amicus.Br.3-20; SBTC.Amicus.Br.3-4, 6-7.

B. The Question Presented Is Exceptionally Important.

The question presented also has enormous implications for the patent system. As the Petition explained, the Federal Circuit's prosecution laches doctrine threatens the rights of patentholders, patent applicants, and the businesses that depend on patent protection to recoup their investments in innovation. Pet.29-30. A coalition of *amici* agree.

The Government suggests the doctrine's reach is limited to patents filed before 1995, BIO.17-18, but that is wrong. The PTO's own data shows that nearly twenty percent of *all* continuation applications exceed the six-year threshold that triggers the Federal Circuit's burden-shifting presumption. Pet.30. And publicly available data confirms that nearly one in

three issued patents today carries that same cloud of presumptive unenforceability. SBTC.Amicus.Br.6-8.

That cloud is not theoretical. It looms over patentholders and patent applicants right now. Hundreds of litigants have asserted prosecution laches in the past few years. Pet.31-32. Indeed, at least 30 more have done so in the mere three months since Petitioner filed his Petition—with every one of those cases involving patents claiming priority to filing dates after 1995.[1] Far from "shrinking," BIO.18, cases involving prosecution laches are surging, disrupting the expectations of patentholders and applicants and undermining the incentive to invest in critical research and development. Pet.31-32.

There is also no reason to accept the Government's assurance that the Federal Circuit will "generally limit[] prosecution laches" to "extreme outliers." BIO.18.[2] If the rule of law means anything, it means that even extreme outliers may enjoy its benefits, as Sir Thomas More recognized. *See* Antonin Scalia, *Scalia Speaks* 95-96 (Christopher J. Scalia & Edward Whelan eds., 2017) ("Yes, I'd give the Devil benefit of

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[1] This data was pulled from Docket Navigator, an online resource that compiles publicly available filings in patent cases. *See* Pet.32 n.3.

[2] The Government claims that Petitioner's applications have "posed 'unique' and 'extreme' challenges for the [PTO]" and cost "more money" than "typical applications." BIO.4-5. Aside from being irrelevant, the Government omits that the PTO accepted over $7 million in filing fees from Petitioner to examine his applications. Appx29700. The Government also neglects that much of the delay here was attributable to the PTO's refusal to act on Petitioner's applications, despite his repeated requests for the PTO to resume its work. Pet.8.

law, for my own safety's sake." (quoting Robert Bolt, *A Man for All Seasons*)). And the doctrine is hardly confined to outliers. Under the Federal Circuit's arbitrary judge-made rule, *every* patent with a prosecution history exceeding six years is presumptively unenforceable.

Moreover, even if the PTO is cautious when departing from the statute, private parties surely will not follow suit. They can assert prosecution laches to challenge any patent as a defense in infringement actions or offensively through inter partes review. *See, e.g.*, *Maquet Cardiovascular LLC v. Abiomed, Inc.*, __ F. Supp. 3d. ___, 2026 WL 1026338, at *1 (D. Mass. 2026) (allowing the "defense of prosecution laches" to proceed to trial). In those high-stakes cases, parties will be "subject to the discretion of a district court" that is free to use "equity" to examine "the totality of the circumstances," rather than the law that Congress prescribed. *Symbol Techs., Inc. v. Lemelson Med., Educ. & Rsch. Found., LP*, 422 F.3d 1378, 1385-86 (Fed. Cir. 2005).

The continued viability of prosecution laches thus poses an urgent, systemwide threat to the patent rights of thousands of patentholders and applicants nationwide. This Court should grant certiorari to resolve that issue of great public significance.

CONCLUSION

The Court should grant the Petition.

Respectfully submitted,

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