

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**

PETITION FOR REHEARING

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PETITION FOR REHEARING

Pursuant to Supreme Court Rule 44, Petitioner Gilbert Hyatt respectfully petitions this Court for rehearing of its June 29, 2026 order denying his petition for certiorari. The petition challenged “prosecution laches,” an invented doctrine that the Federal Circuit ruled enables the Patent and Trademark Office (PTO) or a court to abrogate patent rights based on *ad hoc* notions of equity. No statute authorizes that, and the Patent Act’s reticulated framework leaves no room for the freewheeling whims of fairness that may move an agency or court to achieve a given desired outcome on a given day. But the Federal Circuit has fashioned an expansive doctrine of prosecution laches that was applied here to invalidate patent rights that the district court originally awarded to Petitioner. If the Government has its way, that ruling will not only cancel the patent claims at issue in this case but also all Petitioner’s other claims.

Rehearing is warranted because subsequent events have disproven core assertions the Government made against certiorari. Specifically, the Government argued that prosecution laches is unimportant because it has little if any practical application to claims asserted after a 1995 change in patent law that supposedly renders the doctrine unnecessary or even obsolete. In fact, in the five weeks since certiorari briefing closed, two federal courts in cases involving at least eight of the world’s largest pharmaceutical companies have ratified defenses of prosecution laches as to claims that post-date the 1995 change in law. These decisions come in some of the most significant pending patent litigation, including in a case concerning the mRNA vaccines of Pfizer and Moderna that were

widely administered during the pandemic. This development in a short time period leaves no credibility in the Government's assertion that the question presented is unimportant or relegated to extreme cases.

Additionally, rehearing is warranted because the Court may have been mistaken about the scope of issues raised in the petition and suitability of this case as a vehicle to address prosecution laches. In opposing certiorari, the Government claimed that Petitioner raised a challenge to the PTO's authority to deny a patent application based on prosecution laches, even though prosecution laches was asserted as an equitable defense against Petitioner's claims in court, not before the agency. Petitioner in fact clearly disclosed the posture of this case in the petition and only referenced the scope of agency power during the administrative stage to demonstrate the structural problem that results from recognition of prosecution laches in respect to judicial proceedings. There is no vehicle problem. However, Petitioner's limited reply space was spent on other matters, and Petitioner respectfully requests that the Court consider this clarification at this stage.

The Court should grant rehearing and the petition for certiorari.

REASONS FOR GRANTING THE PETITION

A. Recent Patent Rulings Disprove the Government's Assertion That the Question Presented Is Unimportant

The Court should grant rehearing because of "intervening circumstances of a substantial ... effect." S. Ct. R. 44.2. Among the Government's principal bases for opposing certiorari was its assertion of the "limited

and diminished significance of the question presented.” BIO.17. The Government observed that, pursuant to the Agreement on Trade-Related Aspects of Intellectual Property at the Uruguay Round of the General Agreement on Tariff and Trade (GATT), Congress in 1995 changed the term of U.S. patents to run from the date on which a patent application is filed rather than the date on which a patent issues. BIO.3. The Government claimed that this shift “largely eliminated the potential incentive for dilatory conduct that historically has underlain the prosecution-laches doctrine.” BIO.17. From there, it deduced that the Federal Circuit’s prosecution-laches doctrine does not “threaten[] patent practice ‘going forward.’” BIO.18 (quoting Pet.32).

1. That assertion was proven false in the brief five-week period after certiorari briefing concluded. In that time, two federal courts ratified prosecution-laches defenses in significant patent cases involving at least eight of the world’s leading pharmaceutical companies. *See In re: Aflibercept Patent Lit.*, No. 1:25-cv-74, No. 1:24-MD-3103, 2026 WL 1961865, at *2–4 (N.D. W. Va. July 7, 2026); *GlaxosmithKline Biologicals SA v. Pfizer Inc.*, Nos. 24-cv-512, 24-cv-1135, 24-cv-1136, 2026 WL 1732953, at *3–6 (D. Del. June 16, 2026). Each decision expressly rejected the argument “that prosecution laches does not apply to patents applied for after” GATT. *Aflibercept*, 2026 WL 1961865, at *7; *see also GlaxosmithKline*, 2026 WL 1732953, at *4 (“The court rejects [the] contention” that “prosecution laches does not extend to post-GATT patents”). Insofar as the Government implied otherwise in opposing certiorari, that alone is ground for rehearing.

Each decision also found prosecution-laches defenses properly stated against major pharmaceutical companies as to patents of obvious significance, based on minimal allegations of inequitable conduct. *GlaxosmithKline* involves six of the largest international drug companies (GlaxosmithKline, Pfizer, Pharmacia & Upjohn, BioNTech, and Moderna) and allegations that Moderna and Pfizer’s “mRNA” vaccines used to treat the SARS-CoV-2 (2019) coronavirus disease infringed on GlaxosmithKline’s mRNA patents. *See* No. 1:24-cv-01135, Dkt. 91, ¶¶ 30–70 (Moderna); No. 1:24-cv-00512, Dkt. 26, ¶¶ 29–74 (Pfizer). *Aflibercept* involves two additional pharmaceutical juggernauts (Regeneron and Amgen) and 32 patents for a drug (Eylea) used to treat serious retinal diseases that cause vision loss. 2026 WL 1961865, at *1. One would be hard pressed to identify higher-stakes patent litigation pending in the United States today.

Prosecution laches will play a major role in both cases. In *GlaxosmithKline*, the plaintiff (GlaxosmithKline) is alleged to have waited years to broaden pending claims to include language covering “RNA” technology “that had entered the public domain,” utilizing “multiple requests for continued examination.” 2026 WL 1732953, at *3, 5. In *Aflibercept*, the plaintiff (Regeneron) is similarly alleged to have waited years to pursue a patent after a provisional application was filed, prejudicing the defendant (Amgen) in its intervening inventions. 2026 WL 1961865, at *6. Faithfully applying the Federal Circuit’s decisions challenged here, both courts permitted the prosecution-laches defenses to proceed to discovery, given that the defense is available any time “prosecution was used not merely to obtain allowance of the invention as originally claimed, but to adjust

the claim scope, without proper disclosure, in light of intervening developments.” *GlaxosmithKline*, 2026 WL 1732953, at *5; *see also Aflibercept*, 2026 WL 1961865, at *7 (rejecting contention that muted allegations of inequitable conduct “fall outside of the original purpose of the prosecution laches doctrine”).

2. These decisions remove all credibility from the Government’s assertions that “the potential incentive for dilatory conduct” has ended and that laches reaches only “extreme outliers.” BIO.17–18 (quotation marks omitted). Bet-the-company cases between giant drug companies over some of the nation’s most important patents are not outliers. These decisions issued in a short time frame refute the Government’s representation that this “class of cases” is “small, and shrinking.” BIO.18. And patent-infringement defendants plainly do not think Congress eliminated the incentive for conduct that arguably strays beyond the “equitable.” *Hyatt v. Hirshfeld*, 998 F.3d 1347, 1366 (Fed. Cir. 2021) (decision below). Nor do the courts. They instead hold that allegations need not “match [the] specific fact pattern” the Government alleges against Petitioner to support a laches finding. *GlaxosmithKline*, 2026 WL 1732953, at *4.

Besides, defendants in all cases have their *own incentive* to raise the fluid laches doctrine. The courts in *Aflibercept* and *GlaxosmithKline* had little trouble ratifying the strategy.¹ Going forward, defense

¹ The decisions followed a longer streak of precedents sending laches defenses to trial. *Mojo Mobility, Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-0398, 2024 WL 3354705, at *1–2 (E.D. Tex. June 11, 2024) (partial summary judgment denied), *report and recommendation adopted*, 2024 WL 3350884 (E.D. Tex. July 9, 2024); *Bos. Sci. Corp. v. Cook Med. LLC*, No 1:17-cv-3448, 2023 WL

counsel with qualms about pursuing a prosecution-laches defense will have more to fear by way of a malpractice charge if they do not raise the defense than by way of failure on the merits if they do raise it.

Indeed, it is hard to imagine a significant patent immune from assertion of a prosecution laches defense, given the doctrine’s enormous breadth. For one thing, the Federal Circuit has directed courts to “consider the totality of the circumstances,” *Hyatt*, 998 F.3d at 1363, which is a standard that ordinarily necessitates a trial, *see, e.g., Blanchard v. Peerless Ins. Co.*, 958 F.2d 483, 488 n.6 (1st Cir. 1992) (“The caselaw ... overwhelmingly favors the view that [a] ‘totality of the circumstances’ calculus is for the jury”); *Vicknair v. Formosa Plastics Corp. Louisiana*, 98 F.3d 837, 839 (5th Cir. 1996) (“[A] totality of the circumstances inquiry is frequently difficult to accomplish on motion for summary judgment.” (quotation marks omitted)). Pleading (and obtaining discovery on) such affirmative defenses is not difficult. *See, e.g., Kohler v. Flava Enters., Inc.*, 779 F.3d 1016, 1019 (9th Cir. 2015) (“[T]he ‘fair notice’ required by the pleading standards only requires describing the defense in ‘general terms.’”) (quoting 5 Charles Alan Wright & Arthur R. Miller, *Federal Practice and Procedure* § 1274 (3d ed. 1998)); *see GlaxosmithKline*, 2026 WL 1732953, at *5 (same standard). And the vagueness of the governing standard makes it anyone’s guess when an applicant will be found to “prosecute its applications in an equitable way that avoids unreasonable,

3691113, at *4 (S.D. Ind. May 27, 2023) (same); *Seagen Inc. v. Daiichi Sankyo Co.*, No. 2:20-cv-00337-JRG, 2022 WL 2789901, at *4 (E.D. Tex. July 15, 2022) (ruling on laches defense only after trial).

unexplained delay that prejudices others.” *Hyatt*, 998 F.3d at 1366.

For another thing, the laches standard is so low—and relevant considerations so lacking in “firm guidelines,” *Symbol Techs., Inc. v. Lemelson Med., Educ. & Rsch. Found.*, 422 F.3d 1378, 1385 (Fed. Cir. 2005)—as to give creative lawyers legitimate arguments in most cases. A defendant raises a fact question simply by alleging claims were expanded after a meaningful period based on intervening developments, *Aflibercept*, 2026 WL 1961865, at *7; *see also GlaxoSmithKline*, 2026 WL 1732953, at *4, even though this Court has long recognized it is permissible to “add claims to [an] application covering the independent intervening developments of others,” *Overland Motor Co. v. Packard Motor Car Co.*, 274 U.S. 417, 423 (1927). The practice is common. In all events, it cannot be seriously argued that a change in patent terms eliminates the incentive to do this.

For yet another thing, the scope of inquiry the Federal Circuit has set is so open-ended as to enable lawyerly inventiveness across “an enormous body” of patents. *Hyatt*, 998 F.3d at 1364. The Federal Circuit has made clear that a district court cannot “focus[] its analysis on the ... specific applications at issue in th[e] case” but must place on trial all an applicant’s “conduct causing delay” before PTO. *Id.* Here, Petitioner was found to have forfeited patent rights for claims brought to federal court in 2005 and 2009 based in part on alleged conduct before the PTO concerning other applications “after 2012.” *Id.* at 1355, 1364; *see, e.g., Hyatt v. Vidal*, No. 05-cv-2310, 2024 WL 2208581, at *61–62 (D.D.C. May 16, 2024) (2013 events).

The possibilities bound up in that doctrine are staggering. It, for example, could permit Pfizer and Moderna to challenge GlaxoSmithKline’s mRNA patents (as to which prosecution began in 2010) based on conduct as to different applications at different time periods, including present and past conduct. The opportunities for arguments, discovery, and litigation are nearly endless.

3. One need not assume laches defenses will usually succeed to see how important this problem is. “Of course, the vast majority of patent infringement actions (~97%) are settled.” Robert Van Arnem & Rick Matthews, Williams Mullen, Patent Litigation Update 2024 (Mar. 11, 2024).² The value and terms of those settlements necessarily turn on the types of claims and defenses present in the case, as well as their attendant uncertainty. But the Federal Circuit has elected to administer U.S. patent rights in the manner of King Louis IX, with his “eminently just and good” judgments “under the oak tree,” delivered “case-by-case.” Antonin Scalia, *The Rule of Law As A Law of Rules*, 56 U. Chi. L. Rev. 1175, 1175 (1989). The unknowable result of future judgments concerning laches—based on an unknowable scope of inquiry—will devalue patent rights in settlement negotiations.

And because the Federal Circuit may deem an applicant’s supposed inequitable conduct somewhere to be its inequitable conduct everywhere, the risk of losing on the issue of prosecution laches is enormous. Here, the Government is sure to contend in Petitioner’s pending patent cases that Petitioner cannot

² Available at <https://www.williamsmullen.com/insights/news/legal-news/patent-litigation-update-2024> (last visited July 22, 2026).

be entitled to *any patent ever again* because of the lower courts' laches rulings in cases involving *four* applications. Imagine what a ruling like that could do to a company like Pfizer or Amgen. Why would any patentholder risk that outcome?

The question presented is as important as any this Court could ever resolve concerning the patent system. The Government's contrary assertions are now manifestly disproven. Because the Court may have mistakenly relied on the Government's erroneous assertions, it should revisit the petition for certiorari and grant review.

B. This Case Involves No Vehicle Defect

The Court should grant rehearing based on additional "substantial grounds not previously presented." S. Ct. R. 44.2. Another principal basis the Government presented against certiorari was an alleged "vehicle" defect "because petitioner forfeited certain arguments below." BIO.8. Specifically, the Government claimed Petitioner was challenging "the PTO's authority to invoke prosecution laches as a ground for denying a patent application" and countered that, in this case, the PTO "did not rely on prosecution laches" in rejecting Petitioner's claims but rather asserted the doctrine "as a defense to petitioner's Section 145 suit," BIO.16, which is a civil action for a patent after the examination process ends, *see* 35 U.S.C. § 145; *Kappos v. Hyatt*, 566 U.S. 431, 437 (2012); BIO.2. The Government also noted that Petitioner did not in the lower courts squarely challenge the PTO's authority to invoke prosecution laches during the examination process. BIO.15. The Government therefore criticized "petitioner's framing of the question presented" and

called it “an independent reason for this Court to deny review.” BIO.16–17.

The Government mistook Petitioner’s position and may have led the Court off course. The petition, in fact, stated that “[t]he PTO had not raised” prosecution laches “in its examiner rejections” and instead raised it for the first time in a motion on the eve of trial in Petitioner’s consolidated Section 145 actions. Pet.9. In asserting that the PTO’s authority to assert laches is concerned in this case, *see* Pet.23–26, Petitioner did not mean to suggest that the Court address that issue directly. Rather, the Federal Circuit has linked the PTO’s “authority to sanction undue delay” with “the authority of a district court to hold a patent unenforceable” and held that the agency’s authority “is even broader” than a court’s. *In re Bogese*, 303 F.3d 1362, 1367 (Fed. Cir. 2002). By consequence, recognition of the doctrine of prosecution laches in Section 145 actions (like this one) creates the untenable scenario where an agency has inherent equitable powers, despite that they “are creatures of statute.” *NFIB v. OSHA*, 595 U.S. 109, 117 (2022); *see* Pet.23–26. In effect, Petitioner raised a structural argument about a statutory scheme regulating both agencies and courts, which is a type of problem this Court routinely addresses. *See, e.g., AMG Cap. Mgmt., LLC v. FTC*, 593 U.S. 67, 75–82 (2021) (addressing metes and bounds of agency’s powers to proceed in court as compared to its powers to proceed administratively); *Liu v. SEC*, 591 U.S. 71, 84–85 (2020) (similar).

In trying to manufacture a vehicle defect from an issue Petitioner did not present for review, the Government seized on a sentence taken from context. The petition stated that, “[e]ven if prosecution laches were

available as a defense in infringement litigation ..., it still would not follow that the PTO could rely upon the doctrine itself to deny the issuance of a patent.” Pet.23; *see* BIO.15 (quoting this sentence). But this case involves *neither* “infringement litigation” *nor* a patent denial by PTO “itself.” Rather, this is a Section 145 action where Petitioner seeks a court order that he is entitled to a patent. *Kappos*, 566 U.S. at 437; BIO.2. The petition’s point, taken in fair context, was not to present an “alternative” issue or argument about the facts of another case, BIO.15, but to demonstrate an anomalous consequence of the Federal Circuit’s recognition of the prosecution laches doctrine.

Although this issue arose in the Government’s opposition brief, the limited space of Petitioner’s reply brief was devoted to other issues. This petition for rehearing therefore presents the first clarification of Petitioner’s position concerning the scope of the question presented. Because the Court may have believed the petition for certiorari was deficient based on the Government’s argument, it should reconsider the matter and grant review.

CONCLUSION

The Court should grant rehearing and certiorari.

Respectfully submitted,

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CERTIFICATE OF COUNSEL

As counsel for the petitioner, I hereby certify that this petition for rehearing is presented in good faith and not for delay and is restricted to the grounds specified in Rule 44.2.

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