

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
Alexandria Division**

GILBERT P. HYATT,

Plaintiff

v.

ANDREW HIRSHFELD, Performing the  
Functions and Duties of the Under Secretary  
of Commerce for Intellectual Property and  
Director of the United States Patent and  
Trademark Office,

Defendant.

Civil Action No. 1:20-cv-00983 (AJT/IDD)

**USPTO'S OPPOSITION TO PLAINTIFF'S  
SUPPLEMENTAL RULE 56(D) DECLARATION**

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## I. INTRODUCTION

Plaintiff's Supplemental 56(d) Declaration should be rejected for the same reasons as his original one--he seeks discovery he does not need or already has. The Administrative Record in this case establishes Mr. Hyatt's decades-long pattern of delay and obfuscation. The USPTO's contribution to this delay is legally irrelevant, as explained in its summary judgment briefing, and the Administrative Record speaks for itself on the USPTO's role. Moreover, Plaintiff has received all the discovery to which he might be entitled through numerous other cases (brought under the Patent Act, the Administrative Procedure Act ("APA"), and the Freedom of Information Act ("FOIA")). He does not need any more discovery to respond to the USPTO's motion for summary judgment. The paid factual testimony of former USPTO employees—improper in its own right because Plaintiff elicited it before confirming that those employees may testify as to privileged quasi-judicial information—falls woefully short of the evidence necessary to encroach on the deliberative thought-processes of USPTO personnel. Plaintiff's motion for discovery should be denied.

## II. ARGUMENT

Plaintiff's proposed discovery requests should be denied. Neither the "issues" raised in Plaintiff's supplemental declaration nor the discovery requests themselves merit further discovery.

### A. Plaintiff's "Issues" Do Not Require More Discovery

Plaintiff introduces broad discovery "issues," but he cannot hide the broad scope of his actual requests. *See* Pl. Supp. 56(d) Decl., ¶¶11, 17-20, and 25. In fact, Plaintiff seeks a universe of information to which he is not entitled because his requests (1) seek information already provided in the Administrative Records, (2) are not relevant to the ultimate legal questions regarding prosecution laches and undue multiplicity now before the Court, and/or (3) are barred by long-standing quasi-judicial and deliberative process privileges that Plaintiff has not overcome.

**1. Issue 1: PTO's contention that Mr. Hyatt, as opposed to the USPTO, is responsible for particular periods of delay.**

Plaintiff argues that he is entitled to more discovery into the USPTO "policies and practices" relating to its handling of his applications because: (1) the PTO omitted certain custodians in prior cases; and (2) Plaintiff was not permitted discovery of documents protected by the "deliberative process privilege." Pl. Supp. 56(d) Decl., ECF 107, ¶¶ 12-16. Plaintiff is incorrect.

First, the Administrative Record is the best evidence of who is responsible for the delay. Second, Plaintiff already brought another suit in this Court in an attempt to prove that the USPTO had a "de facto" policy against issuing Mr. Hyatt a patent, and failed. *Hyatt v. USPTO*, No. 1:18-CV-546, 2020 WL 4820709, \*21 (E.D. Va. Aug. 19, 2020). Third, Plaintiff only offers speculation that, despite all of the prior discovery, other custodians "such as Deputy Commissioner Robert Bahr" might have additional, non-privileged documents. Pl. Supp. 56(d) Decl., ¶ 12. Fourth, Plaintiff is not entitled to discovery into the USPTO's deliberative process, as discussed further below. *See* Sec. II(C)(2), *infra*.

Finally, Plaintiff's new declarations merely recycle old information about Plaintiff's allegations that was fully developed in the numerous previous cases, including:

(a) Internal USPTO communications demonstrating that Senior PTO Management Officials "blocked issuance"<sup>1</sup> of Mr. Hyatt's patent applications. *See* Ex. 35<sup>2</sup> at 10 ("PTO correspondence regarding holdup of allowance of Hyatt application..."), 11 ("PTO (Morse) correspondence regarding Hyatt applications and talking points"); Ex. 3 at 8-10 (identifying

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<sup>1</sup> This is Plaintiff's characterization, which the USPTO disputes.

<sup>2</sup> Exhibit 35 is a copy of Plaintiff's Exhibit List filed in the District of Columbia. A detailed summary of many of the "laches-related" exhibits also can be found in the Administrative Record. (A17203-A17230.)

individuals “involved in the decision to withdraw from issuance” certain of Plaintiff’s applications);

(b) Direction from USPTO management to “reject”<sup>3</sup> Mr. Hyatt’s applications. *See* Ex. 2 at 5-6 (requesting Kunin documents “evidencing policies applicable to Mr. Hyatt’s patent applications”); Ex. 4 at 8-10 (identify any such Kunin documents); Ex. 35 at 7 (Kepplinger memo re: “SAWS”), 44 (6/23/2011 “Email from Kappos, David... re COPA progress”));

(c) USPTO’s withdrawal of numerous of Mr. Hyatt’s applications from issuance. *See* Ex. 35 at 2 (“Withdrawal from Issue documents”), 5, 18;

(d) USPTO placing Mr. Hyatt’s applications in the secret “Sensitive Application Warning System.” *See* Ex. 35 at 7 (“Technology Center 1600 Special Applications Warning System (SAWS)”); 18 (“(‘SAWS’) Documents”); Ex. 3 at 6-8 (Hyatt SAWS applications));

(e) That the USPTO “stranded”<sup>4</sup> Mr. Hyatt’s applications in “Phantom Art Units.” *See* Ex. 35 at 18 (4/5/2006 “PTO Correspondence regarding status of Hyatt applications”), 37 (“Spreadsheet listing information for... Application number ... Art unit, Status...”), 40 (same);

(f) That the USPTO allowed several of Mr. Hyatt’s applications to completely expire through PTO’s “extraordinary delay.”<sup>5</sup> *See* Ex. 35 at 38 (“Hyatt Abandonment tracking”), 41 (4/5/2206 “Email from Trans, Vincent to Wong, Peter, et al re workload in SPRE 2100”); and

(g) That the USPTO had determined to reject Mr. Hyatt’s applications for prosecution laches (“Memorandum of Points and Authorities in Support of Defendant’s Motion to Dismiss for

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<sup>3</sup> The USPTO rejects this premise, but it did produce certain guidelines, instructions, and emails from Supervisory Patent Examiners on how to address the challenges presented by Mr. Hyatt’s applications. (*See, e.g.*, A017171-A17176 (“Compilation of Guidance from Greg [Morse] on 2615 Applications”).)

<sup>4</sup> Again, the USPTO rejects this characterization but did produce numerous documents relating to how Mr. Hyatt’s applications were handled and by whom. *See* Ex. 3 at 4 (“Identify all patent examiners having any involvement with Mr. Hyatt’s patent applications after April 8, 1995”).

<sup>5</sup> The USPTO denies that it was responsible for the abandonment of these applications.



Prosecution Laches,” *Hyatt v. Lee*, ECF 81-2, Case No. 09-1864, (D.D.C. Sept. 30, 2016) (“The USPTO Has Recently Begun Making Prosecution Laches Rejections in Mr. Hyatt’s Applications”)).

**2. Issue 2: PTO’s contention that Mr. Hyatt’s actions delayed prosecution of the ’213 Application by impairing PTO’s ability to appropriately examine the ’213 Application.**

It is not clear what additional discovery Plaintiff needs to more fully develop a response to this “contention.” As a general proposition, the only “contention” that matters is one relied upon by the Board in rejecting Plaintiff’s application for prosecution laches, because that is the subject of Defendant’s motion for summary judgment. However, all of those findings are contained in the Administrative Record. (*See, e.g.*, A7332-A16766 (Examiner’s Answer); A17573-A17714 (Decision on Appeal).) The “impacts” of those findings, to the extent relevant, were weighed by the Board in rendering its decision that Plaintiff’s “actions constitute an unreasonable delay.” (A17707.) No additional discovery will change the Board’s decision.

**3. Issue 3: PTO’s contention that Mr. Hyatt’s prosecution actions in the ancestor applications delayed prosecution of the ’213 Application.**

Plaintiff does not require any more discovery from the USPTO about the “prosecution actions in the ancestor applications” to respond to Defendant’s summary judgment motion. Pl. Supp. 56(d) Decl., ¶18. First, Plaintiff does not need discovery from the USPTO to explain why he waited over 20 years to file his application. That information is solely in his own possession. Second, Plaintiff is wrong that he “has not previously taken discovery on the ancestor applications.” *Id.* The USPTO already produced over 1.7 million pages of documents from all of the over 400+ related applications in prior cases, including all of the ancestor applications of the ’213 application. *See Ayers Decl.*, ECF 83-1, Ex. A at 10-22 (listing Bates ranges of related applications). Moreover, given the overlap of his applications and the central coordination with the USPTO, much or all of that previous discovery is relevant to this case.

**4. Issue 4: PTO's contention that Mr. Hyatt's prosecution conduct across his other patent applications delayed prosecution of the '213 Application.**

Plaintiff purports to identify multiple “factual disputes” related to this issue that require additional discovery. Pl. Supp. 56(d) Decl., ¶19. The first such dispute relates to the “lawsuits Mr. Hyatt filed against PTO,” citing “SUMF ¶ 33(d) and ECF 51, Hyatt Decl. ¶96(a), -(c), -(e).” *Id.* The cited statement of undisputed fact, however, references a specific section of the Examiner's Answer that discusses “Delay related to Litigation (2003 – 2012).” (A7356-A7358.) Those cases are all a matter of public record. No additional discovery is needed to understand the impact of those decisions on the USPTO's handling of the present application.

Plaintiff also suggests that there is some sort of “factual dispute” related to the “PTO's treatment of Mr. Hyatt's applications and policies concerning them between the 2013 Requirements and the present day,” citing “SUMF ¶¶18-25 and ECF 71, Hyatt Decl. ¶76(b).” Pl. Supp. 56(d) Decl., ¶19. Those cited paragraphs in the SUMF, however, merely recite post-Requirements chronology. No additional discovery will change those facts.

Next, Plaintiff suggests that there is some sort of “dispute between Mr. Hyatt and PTO over the scope of a prior interference proceeding,” citing “SUMF ¶ 31” and “Hyatt Decl. ¶ 96(d).” *Id.* Paragraph 31 of the SUMF merely mentions that My Hyatt “has continued to argue for subject matter—such as the invention of the ‘single-chip computer’—to which he was finally determined not to have invented in decisions including *Hyatt v. Boone* nearly two decades previously.” SUMF ¶ 31(d). It is a matter of public record that Mr. Hyatt was the losing party in an interference proceeding in the USPTO that declared Mr. Boone the rightful inventor of “a computer formed on a single integrated circuit chip,” not Mr. Hyatt. *Hyatt v. Boone*, 146 F.3d 1348, 1351 (Fed. Cir. 1998). It is also indisputable that following that decision, as the Examiner rightly noted, Mr. Hyatt continued to add claims including “a single chip integrated circuit.” (A581.) While Mr. Hyatt

may try to justify this behavior, no amount of discovery will change these underlying facts relied upon by the Examiner to reject his patent application.

Finally, Plaintiff argues that there is “a broader factual dispute about whether any delay between 2003 and 2012 could be charged to Mr. Hyatt in light of PTO’s stipulation to the contrary,” citing “SUMF ¶ 33(C).” Pl. Supp. 56(d) Decl., ¶19. Paragraph 33(c) contains no such stipulation. Regardless, the USPTO’s delay in responding to Plaintiff’s actions does not excuse his delay. *See* Defendant’s Reply, ECF 78 at 16-18 (Jan. 22, 2021). Moreover, the USPTO was completely transparent with Mr. Hyatt about when and why it was suspending further examination of his applications during this time. (*See, e.g.*, A2736-A2738, A2750-A2752.) That is all in the Administrative Record. (*Id.*)

Plaintiff also misrepresents the amount of discovery he had “in the *Hyatt v. Iancu* cases” before Judge Lamberth. Pl. Supp. 56(d) Decl., ¶19. Given the overlap of subject matter and issues between those cases and this, much or all of the discovery provided by the USPTO in those cases is directly related to this one. Indeed, the USPTO even produced the ’213 Application file history in that case. Ex. 3 at 21 (“Application No. 08/418,213” (as of May 16, 2017)). No more discovery is needed on this issue.

**5. Issue 5: Mr. Hyatt’s contention that PTO has acted in bad faith towards Mr. Hyatt’s patent applications in the time since 1997.**

Plaintiff does not need additional discovery into the USPTO’s supposed bad faith. Not only does the USPTO contend that this evidence is irrelevant because there is no *de facto* policy against issuing Mr. Hyatt a patent (despite his best efforts to prove it), as Judge Ellis already finally determined, but the USPTO already has produced all the evidence it has on the subjects of “memes” and statements casting Mr. Hyatt “in a negative light.” Pl. Supp. 56(d) Decl., ¶ 22. The Court need look no further than the Administrative Record in this case to prove that Mr. Hyatt has received this discovery. (*See* Reply Br. on Appeal, Appendix F - Laches-related evidence.

A17043-A17313.) Mr. Hyatt submitted a copy of the infamous “Submarine Prosecution Chokehold” meme. (A17195.)

Many of these documents still include Plaintiff’s exhibit labels from the trial before Judge Lamberth. He even includes a 28-page “Table of exhibits” that provides a detailed description of each laches-related exhibit. (A17203-A17230.) One of these exhibits (“PTX-110”)—an email from Greg Morse “regarding Hyatt tax lawsuit”—allegedly “further reflects the PTO’s bias toward [Mr. Hyatt].” (A17208). Another email (“PTX-24”) supposedly illustrates “a further demonstration of bias by the examiners” responsible for examining his applications. (A17223.) Mr. Hyatt’s counsel even prepared demonstratives for oral argument before the Board with excerpts of many of these exhibits including one labeled “PTO officials repeatedly disparage Mr. Hyatt.” (A17470-A17478.) Plaintiff cannot seriously dispute that he has had extensive discovery from the USPTO about this subject.

**6. Issue 6: PTO’s contention that the Subject Claims of the ’213 Application are indefinite as unduly multiplied within the meaning of pre-AIA 35 U.S.C. § 112, paragraph 2.**

The final “issue” into which Plaintiff seeks discovery relates to the Examiner’s “undue multiplicity” rejection. Pl. Supp. 56(d) Decl., ¶¶25-29. Plaintiff argues that further development of the record is necessary beyond the supposed “self-serving documents” contained in the Administrative Record. *Id.* at ¶28. Ironically, those documents are copies of the dozens of claim sets filed by Mr. Hyatt in all of his related patent applications. That was all the evidence that the Examiner and the Board needed to reject his hundreds of pending claims as unduly multiplied despite an explicit Requirement demanding that he limit his claims to no more than 600 claims across all of this related cases, which he refused to do. Plaintiff does not need any more discovery into the basis of the Examiner’s “contention” that the claims are unduly multiplied. This Court can count the claims and look at the claims, which are in the Administrative Record.

## B. Plaintiff's Requests Violate the Court's Order

### 1. Plaintiff's Requests are a Fishing Expedition

The Court was quite clear at both the hearing and in its subsequent order that Rule 56(d) is not intended to be “an open-ended license to conduct discovery.” Ex. 37 (Hearing Tr.) at 5. Despite this admonition, Plaintiff proposes exceedingly broad requests, unlimited by person, time, or topic. Plaintiff's motion should be denied for that reason alone.

The Court need look no further than Document Request No. 1 to realize that Plaintiff has ignored the Court's admonition:

Request 1. The documents evidencing any policies, practices, instructions, memoranda, procedures, or guidelines applicable to Gilbert P. Hyatt and/or his patent applications.

Pl. Supp. 56(d) Decl., ECF 107, ¶31. This request would require the USPTO to search every communication between every patent examiner and corresponding supervisor relating to the examination of every one of Mr. Hyatt's 400+ patent applications over the last 40+ years (including emails, as far back as they go) looking for, *inter alia*, any “instructions.”<sup>6</sup> All in hopes that Plaintiff would discover the proverbial “smoking gun” email saying “don't issue any Hyatt applications.” As discussed further below, this Court already has found that the PTO has no *de facto* policy of denying Mr. Hyatt patents. *Hyatt v. USPTO*, No. 1:18-CV-546, 2020 WL 4820709, \*21 (E.D. Va. Aug. 19, 2020). And even if it had not already been decided, this is just the sort of “fishing expedition” that this Court warned against.

Plaintiff's proposed document request number 2 is no better. It seeks all documents “evidencing ‘memes,’ claims of submarining, or *other statements that portray Gilbert P. Hyatt or his patent applications in a negative light*, including without limitation references to the terms

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<sup>6</sup> That is on top of the request also covering all of the guidance that applies to all examiners broadly, such as many editions of the thousands of pages of the Manual of Patent Examining Procedure. See <https://www.uspto.gov/web/offices/pac/mpep/old/index.htm>.

chokehold, troll, non-practicing entity or NPE, or Lemelson.” Pl. Supp. 56(d) Decl., ECF 107, ¶33 (emphasis added). This request is not narrowly tailored or proportional to the needs of the case. Again, responding to this request would require a manual review of virtually every examiner communication to identify any such documents. Further, as discussed below, such discussions would necessarily contain undiscoverable predecisional discussions of how to approach Mr. Hyatt’s applications.

Another example of Plaintiff’s failure to propose narrowly tailored discovery requests in response to the Court’s order is his “contention” discovery. Plaintiff seeks a corporate representative to testify about the “USPTO’s contention[s]” on several issues. Pl. Supp. 56(d) Decl., ¶¶43, 46, and 47. However, the “contentions” that matter for summary judgment purposes are the ones upon which the Board rejected Plaintiff’s claims for prosecution laches and undue multiplicity. Plaintiff does not need additional discovery from the USPTO to explore the reasoning or the basis of the Board’s decision. It is in the Administrative Record. In fact, it is hard to imagine how any USPTO representative could testify on these proposed “contention” topics other than by simply referring Plaintiff back to that Record.

## **2. Plaintiff Misrepresents All the Discovery He Has Obtained**

Even assuming that Plaintiff had sought targeted discovery, he already has all the discovery he needs to respond to the USPTO’s motion. As this Court knows all too well, “[t]he instant dispute is not the plaintiff’s first suit against the USPTO; to the contrary, he has filed a number of cases against the USPTO ....” *Hyatt v. USPTO*, No. 1:18-CV-546, 2020 WL 4820709, at \*5 (E.D. Va. Aug. 19, 2020). As indicated in the preceding “issues” section above, Plaintiff grossly understates all the relevant discovery that he has obtained over the years, not just in Section 145 cases, but in cases brought under the APA, the Privacy Act, and FOIA.

**Hyatt DC §145 Suits:**

In this series of consolidated §145 cases before Judge Lamberth, Plaintiff filed a “Motion for Discovery Pursuant to Rule 56(d).” *Hyatt v. Matal*, 1:09-cv-01864, ECF 98 (D.D.C. Dec. 12, 2017). That motion sought “fact discovery on the issues raised by the Defendant’s Motion to Dismiss for Prosecution Laches.” *Id.* Once the USPTO amended its answer to plead prosecution laches, Plaintiff renewed his motion for additional discovery. *Id.*, ECF 124 (Apr. 12, 2017). That renewed motion stressed the importance of discovery on “the equitable nature of the USPTO’s conduct toward Mr. Hyatt,” calling that issue of “central relevance” to the USPTO’s defense. *Id.*, ECF 124-1 at 2.

Judge Lamberth granted Plaintiff’s renewed motion for discovery. ECF 131 (May 2, 2017). His order explicitly permitted discovery into “USPTO policies not contained in the administrative record regarding how [Mr. Hyatt’s] applications were processed.” *Id.* He also ordered the USPTO to produce “the administrative record of [Mr. Hyatt’s] other 396 cases, something between one and two million pages of records.” *Id.* at 3. Just as importantly, however, Judge Lamberth recognized that “given the quasi-judicial nature of patent proceedings and the need for an expeditious conclusion to these cases, all discovery into these issues ought to be narrow and limited to factual matters—not delve into hypotheticals or speculation or the reasons, mental processes, or conclusions of the examiners or other USPTO officials.” *Id.* (citing *W. Elec. C. v. Piezo Tech., Inc.*, 860 F.2d 428, 432 (Fed. Cir. 1988)).

In response to this Order, Plaintiff propounded document requests, interrogatories, and deposition notices. Many of those are virtually indistinguishable from his current requests:

**REQUEST NO. 5:** All documents evidencing any policies, practices, instructions, memoranda, procedures, or guidelines (whether formal or informal) applicable to Mr. Hyatt’s patent applications....”

**REQUEST NO. 7:** All documents relating to the withdrawal from issue of the following [four Hyatt patent applications]....

**REQUEST NO. 8:** All documents showing any of Mr. Hyatt's patent applications, including those identified in Document Request No. 7, as applications planned for issue, as prospective patent grants, or as utility grant prints.

**REQUEST NO. 9:** All documents relating to "submarine" or "submariner" patents, patent applications, or patent applicants or to patent applications filed by "independent inventors," "individual inventors," or "small inventors" referring to Mr. Hyatt, Mr. Hyatt's patent applications, or any issues involving Mr. Hyatt.

**REQUEST NO. 10:** All communications sent from, sent to, or received by Michelle Lee, David Kappos, Teresa Stanek Rea, Jon Dudas, James Rogan, Bruce Lehman, Q. Todd Dickinson, Nick Godici, John Doll, Robert Stoll, Margaret "Peggy" Focarino, Drew Hirshfeld, Lawrence Goffney, Stephen Kunin, Edward Kazenske, Esther Keppinger, the Office of Patent Legal Administration or its personnel, or the Board of Patent Appeals and Interferences or Patent Trial and Appeal Board ("Appeals Board") or its personnel referring to Mr. Hyatt, Mr. Hyatt's patent applications, or any issues involving Mr. Hyatt.

Ex. 1 (Defendant's First Supplemental Objections and Responses to Plaintiff's First Set of Requests for Production (Nos. 1-26) (June 12, 2017)). Subject to its legal objections, the USPTO fully responded to these requests. *Id.*<sup>7</sup> The USPTO's document production spanned over 1.7 million pages. *Id.*

In addition to documents, Plaintiff sought the depositions of high-level USPTO employees including the Supervisory Examiner overseeing all Mr. Hyatt's applications since 2013, Gregory Morse. *See* Ex. 5 (Robert Clark), 6 (Gregory Morse), 7 (Patricia Capers), 9 (Michael Razavi); *see also* Ex. 10 (USPTO Notice of former USPTO employee Andrew Christensen). Plaintiff also sought testimony of the USPTO on a whole range of prosecution-laches-related deposition topics

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<sup>7</sup> Plaintiff notes that Judge Lamberth "sanctioned" the USPTO "for discovery misconduct," Pl. Supp. 56(d) Decl., ¶5, but fails to inform the Court that the USPTO's "offense" was providing Plaintiff with too much discovery, not too little. Ex. 38 (*Hyatt v. Iancu*, No. 1:05-cv-2310-RCL, ECF 273 (D.D.C. July 23, 2020)). In that case, Plaintiff successfully argued that the USPTO sandbagged Plaintiff by failing to identify in its interrogatory response "which documents in a nearly two-million-page administrative record it intended to rely on at trial." ECF 273 at 6. Plaintiff's further reliance on that court's decision in a FOIA case to compel the production of a single email also falls flat. Pl. Supp. 56(d) Decl., ¶5 (citing *Hyatt v. USPTO*, 346 F. Supp. 3d 141, 152 (D.D.C. 2018)). Not only did the USPTO have a legitimate legal argument why it was not required to produce that single email, but Judge Lamberth refused to sanction the USPTO for refusing to produce it. Ex. 38 at 6.



including:

1. The factual bases on which the PTO contends that Mr. Hyatt's applications (including but not limited to the four patent applications at issue in these cases) are subject to prosecution laches, including ... the delays the PTO attributes to Mr. Hyatt

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10. All policies, practices, instructions, memoranda, procedures, or guidelines (whether formal or informal) for handling Mr. Hyatt's patent applications...

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19. Policies, practices, instructions, memoranda, procedures, or guidelines ... concerning patent applications being filed prior to the effective date for the GATT (i.e., June 8, 1995) including those policies, practices, instructions, memoranda, procedures, or guidelines as applied to Mr. Hyatt's patent applications....

Ex. 6 at 1-5. In response to these notices, the USPTO produced Mr. Morse, Senior USPTO official, Robert Clarke, and Administrative Supervisory Patent Examiner Michael Razavi for depositions. Exs. 5, 6, and 9. The USPTO also proffered the former Deputy Assistant Commissioner for Patent Policy and Projects in the Office of the Assistant Commissioner, Stephen Kunin, as its expert on prosecution laches. Mr. Kunin was deposed at length on his prosecution laches opinions set forth in his detailed expert report, and he then testified at trial. Ex. 8 (Exhibit 1 to the Deposition of Stephen Kunin (Sept. 1, 2017)). Many of the documents produced in those cases are included in the Administrative Record in the present case.<sup>8</sup>

Those cases are presently on appeal. *Hyatt v. Hirshfeld*, No. 18-2390 (Fed. Cir.). Although Plaintiff has appealed aspects of Judge Lamberth's decisions in those cases, he has nowhere argued to the court of appeals that he was somehow denied any documents that were responsive to his requests in those cases. And because the requests covered the same material as his requests in this case, he has already received any responsive, nonprivileged documents.

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<sup>8</sup> For example, Mr. Kunin's report is attached to the Examiner's Answer. (A012584-A012698.)

**EDVA APA Suit:**

In 2018, Plaintiff filed another suit against the USPTO, this time before Judge Ellis, asserting a number of claims including ones arising under the APA. *See* Compl., *Hyatt v. USPTO*, ECF 1, Case No. 18-cv-546 (E.D. Va. May 7, 2018). Judge Ellis permitted Plaintiff to take up to five individual depositions in the case or up to three if one of those was under Rule 30(b)(6). ECF 73 at 2. Because Plaintiff raised an issue about whether he was entitled to pierce the deliberative process privilege, Judge Ellis ordered that the depositions be conducted in court so that he could rule on any privilege objections in real time.

For the hearing, Plaintiff requested that Supervisory Patent Examiner Gregory Morse and Senior Patent Attorney in the Office of Patent Legal Administration, Pinchus Laufer, be made available for examination. In addition, Plaintiff requested that the USPTO present a corporate representative on a number of policy-related topics. Pl. Resp. to the Court's June 11 Order and Desig. of Witnesses, ECF 83 (June 12, 2019). The USPTO objected to some of these topics on relevance grounds because they sought information related to its past practices, as opposed to current practices. The Court sustained those objections "insofar as Hyatt's proposed examination focuses on events that occurred decades ago and [is] not sharply focused on the existence of the alleged de facto policy not to issue Hyatt patents and to avoid final agency action on his patent applications that allows judicial review." ECF 89 at 2.

At the hearing, Plaintiff examined USPTO employees Mr. Morse, Mr. Laufer, as well as Mr. Morse's supervisor--Group Director Tariq Hafiz. *See* ECF 92 at A9 (Morse), A109 (Hafiz), A115 (Laufer<sup>9</sup>) (July 2, 2019) (attached hereto as Ex. 36). During that hearing, "to get to the heart of the matter," the following exchange occurred between Judge Ellis and Mr. Morse:

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<sup>9</sup> Mr. Laufer did not have much relevant information and was quickly excused.

THE COURT: As the head of the unit, is there any order, rule, or requirement by the PTO not to issue Mr. Hyatt any patent on any of his applications?

THE WITNESS: No, Your Honor.

THE COURT: Have you issued such an order?

THE WITNESS: No, Your Honor.

THE COURT: Has anyone in the PTO issued such an order?

THE WITNESS: I'm not aware of any such order, no; and I've—I'm in the position that I would have been told if that were the order.

THE COURT: Would such an order be legal?

THE WITNESS: I don't think so.

Ex. 36 at A12-A13; *Hyatt v. USPTO*, 2020 WL 4820709, at \*7. (E.D. Va. Aug. 19, 2020).

Although Plaintiff now tries to impugn Mr. Morse's testimony by characterizing it as being driven by "manifest self-interest," Pl. Supp. 56(d) Decl., ¶15, the Court had the opportunity to determine its credibility. The Court did so, and then issued an opinion dismissing Plaintiff's remaining APA claims. 2020 WL 4820709 at \*21. According to Judge Ellis:

The Administrative Record reflects that there is no rule, order, or policy to deny plaintiff any patents based on his existing patent applications or to deny plaintiff judicial review of his existing patent applications regardless of the merits of plaintiff's patent applications. Plaintiff is understandably disappointed that the PTO is not processing plaintiff's applications at a faster pace, but plaintiff must accept that the length, complexity, and interrelatedness of his patent applications are significant contributing factors to the slow pace of examination.

*Id.* at \*7. In reaching this decision, Judge Ellis rejected Plaintiff's argument that his partial success before Judge Lamberth demonstrates "the pretextual nature of the PTO's examination." *Id.* Rather, the Court noted that this result merely reflected the additional new evidence on patentability that Plaintiff presented to Judge Lamberth that he did not present to the agency. It "does not show that the PTO has engaged in any bad faith or improper behavior." *Id.*

**Hyatt Requirements Suit:**

In February 2014, Mr. Hyatt filed a different suit in this Court, challenging the USPTO's decision to issue the Requirements in 80 of his applications (those in which appeal briefs had been filed), arguing that reopening prosecution to issue the Requirements constituted unreasonable delay. Mr. Hyatt requested "the Court to order the PTO not to reopen prosecution on the appeals or otherwise delay final resolution on the merits of the appeals as presented to the [Board] in each of these 80 appealed patent applications." *Hyatt v. USPTO*, No. 1:14-cv-01300-TSE, Compl., ECF No. 2-1, at 18 [10-18] (E.D. Va. Feb. 27, 2014). This Court granted summary judgment in favor of the USPTO in November 2015, determining that the USPTO "has already done what it is statutorily required to do, namely to cause an examination of the applications. Indeed, the Requirements expressly state that they were issued to achieve this very purpose." *Hyatt v. USPTO*, 146 F. Supp. 3d 771, 783 (E.D. Va. 2015). Mr. Hyatt did not appeal this Court's decision, and it is now final.<sup>10</sup>

In the course of the Hyatt Requirements Suit, the Court required the USPTO and Mr. Hyatt to assess the prosecution histories of the 80 applications at issue and jointly provide the Court with one chart per application, detailing every USPTO action taken, every response by Mr. Hyatt to those actions, every amendment, every time the USPTO had reopened prosecution after an appeal brief had been filed, every suspension of action, every petition, Board appeal, or lawsuit Mr. Hyatt had filed covering that application, and every USPTO response. *Hyatt v. USPTO*, No. 1:14-cv-01300-TSE, ECF No. 50 (E.D. Va. Dec. 12, 2014). The parties jointly assessed the prosecution

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<sup>10</sup> Mr. Hyatt separately sued the USPTO for its issuance of the Requirements based on an asserted right to avoid having examiners reopen prosecution after an appeal brief has been filed. The Federal Circuit agreed with the USPTO that the USPTO's policy did not violate any laws. *Hyatt v. USPTO*, 904 F.3d 1361 (Fed. Cir. 2018).

histories and jointly filed all 80 charts, with no one complaining that they had insufficient information to complete the task. ECF No. 57 (E.D. Va. Jan. 23, 2015).

The USPTO also stated to the Court that it would, among other things, issue approximately 10 office actions per month on Mr. Hyatt's applications and would not suspend Mr. Hyatt's pending applications, barring unforeseen circumstances. The USPTO has worked diligently to uphold those commitments. Because the USPTO was able to coordinate its actions by issuing the Requirements, it has issued over 1,500 office actions since January 2014 on Mr. Hyatt's applications, which is over 10 per month. *Hyatt v. USPTO*, 146 F. Supp. 3d 771, 773 (E.D. Va. 2015). The current crop of six pending §145 actions in this Court also reflects the ongoing progress the USPTO has made to bring these cases to finality.

#### **Hyatt FOIA Requests:**

Not only has Mr. Hyatt obtained discovery through district court actions, he also has been pursuing discovery through FOIA requests, either directly or through proxies. Much of his discovery into the "SAWS" program, for example, was obtained through FOIA and is now in the public domain. See Exs. 11 and 12 (publicly available articles discussing the USPTO's now defunct SAWS program based on FOIA requests).

### **C. Plaintiff is Not Entitled to the Discovery He Seeks**

#### **1. Plaintiff's Requests are Premised on the Faulty Notion that USPTO Delay is Relevant**

As a starting point, Plaintiff's discovery requests all focus around the USPTO's intent in handling Mr. Hyatt's application. Not only is this evidence not discoverable, as discussed further below, it is also irrelevant for two independent reasons. First, the USPTO's intent is irrelevant because the Administrative Record speaks for itself about who is responsible for what delay. The Administrative Record in this case provides a blow-by-blow account of each action and reaction over the entire history of Mr. Hyatt's patent application. For example, Plaintiff does not dispute

that he waited 20 years from his original priority date to file the present application. *Compare* Compl., ECF 1 at ¶15 (“filed ... on April 6, 1995”) *with id.* at ¶11 (“has the benefit of the filing date of ... 05/550,231, filed on February 14, 1975”). The USPTO likewise does not dispute that it suspended prosecution on several occasions awaiting “[a] court decision relevant to the examination of this application.” (A4857, A4866.) Discovery as to the reasons or intent behind these delays will not change who is responsible for what.

Second, the USPTO’s delay, whether intentional or unintentional, does not excuse Mr. Hyatt’s delay. *See* Defendant’s Reply, ECF 78 at 16-18 (Jan. 22, 2021). That is the focus of the Board’s prosecution laches decision and the USPTO’s summary judgment motion. Discovery into the USPTO’s intent will not change the facts upon which the Board relied in reaching its decision, including that, regardless of any USPTO delay, Mr. Hyatt could have filed the claims he is now pursuing in 1975 and chose not to file them until 2016.

## **2. Plaintiff is Not Entitled to Discovery Into the USPTO’s Thought Processes**

Even if the USPTO’s intent were relevant, the discovery that Plaintiff seeks is barred by several long-standing legal doctrines. While there are narrow exceptions to pierce these privileges, Plaintiff’s self-serving declarations from former USPTO employees who were improperly paid for their testimony about events that occurred during a brief window in the late 1990s fails to prove any entitlement to exceptions. Moreover, examiners’ testimony about their thought processes is broadly disallowed in court proceedings, including in §145 cases, and allowing this discovery would mark the start of “open season” on examiner testimony in future cases that would be a stark departure from the *status quo* regarding the availability of such testimony.

**a) Examiner Testimony is Neither Discoverable Nor Relevant**

**(1) Examiners are quasi-judicial employees whose mental impressions are not discoverable.**

Plaintiff attempts to dramatically expand the scope of permissible discovery in this §145 action by explicitly seeking evidence of the Examiner's mental processes. Pl. Supp. 56(d) Decl., ¶39. Not only does Plaintiff not need to depose the Examiner to discover the "examination history of the '213 Application," *id.*, that testimony is not discoverable.

"Since [*United States v. Morgan*, 313 U.S. 409 (1941)] federal courts have consistently held that absent 'extraordinary circumstances,' a government decision-maker will not be compelled to testify about his mental processes in reaching a decision, 'including the manner and extent of his study of the record and his consultations with subordinates.'" *Franklin Sav. Ass'n v. Ryan*, 922 F.2d 209, 211 (4th Cir. 1991) (quoting *Morgan*, 313 U.S. at 1004 and collecting cases).

Thus there must be a "strong showing of bad faith or improper behavior" before a court may "probe the mental processes of [an] agency or its members." *Id.* at 211-12 (internal quotation omitted). Furthermore, the Fourth Circuit has specifically affirmed that "[p]atent examiners act as quasi-judicial officers during the process of issuing and reexamining patents." *Rein v. USPTO*, 553 F.3d 353, 373 (4th Cir. 2009) (citing *United States v. Am. Bell Tel. Co.*, 128 U.S. 315, 363 (1888); *W. Elec. Co. v. Piezo Tech., Inc.*, 860 F.2d 428, 431 (Fed. Cir. 1988)).

In accordance with these protections, USPTO employees are generally forbidden from providing opinion (or expert) testimony regarding USPTO information, subjects, or activities related to decisions on patent applications. *See* 37 C.F.R. § 104.23; *W. Elec. Co.*, 860 F.2d at 431. The USPTO's binding guidance to examiners states that it is normally impermissible to answer questions about, *inter alia*, their understanding of a patented invention, an invention sought to be patented, a patent, or prior art. *See* MPEP § 1701.01(A)(6). Because the entire point of this §145 proceeding is for the Court to determine whether Mr. Hyatt is "entitled to receive a patent for his

invention,” any testimony of current or former examiners would almost exclusively cover these prohibited topics.

**(2) The Examiner’s motives are irrelevant because this case involves the Board’s final decision not the Examiner’s rejection.**

Other than attempting to impugn his motives, it is not clear what Plaintiff hopes to discover by examining Mr. Divecha, just one of the many examiners who have examined Mr. Hyatt’s application over the last 25 years. Plaintiff attempts to justify his deposition because he was the Examiner when the USPTO first rejected the claims for prosecution laches. However, the record speaks for itself as to what the Examiner did and why he did it.

For example, when he issued the Requirements in this application, Mr. Divecha explained that he was not acting on his own accord--“[a] Technology Center (TC) ... Director has approved of reopening prosecution by signing below.” (A4983). These same Requirements were issued across all of Mr. Hyatt’s pending applications, leaving no doubt that Mr. Divecha was acting pursuant to the TC Director’s instructions.

Mr. Hyatt filed a petition requesting “Supervisory Review” of these Requirements. (A5014-A5040.) That petition was denied in a lengthy order signed by Tariq Hafiz, the “Director, Technology Center 2600.” (A5481-A5491.) Mr. Hyatt then escalated the issue further by seeking “Supervisory Review of T.C. Director’s Decision.” (A5492-A5533.) That petition was denied in a written order signed by Andrew Hirshfeld, then “Deputy Commissioner for Patent Examination Policy/Petitions Officer.” (A5584-A5600.)

Mr. Divecha and Mr. Hyatt then went back and forth over the Requirements. (A5601-A5666; A5726-A6343.) This culminated in a 118-page “Final” rejection of Mr. Hyatt’s claims. (A6345-6465.) Mr. Hyatt appealed that rejection to the Board. (A6545.) The parties then filed their respective briefs. (A6560-A6711 (Appeal Brief); A7332-A16766 (Examiner’s Answer).)



In his Examiner's Answer, Mr. Divecha raised prosecution laches as a "New Ground of Rejection[.]" explaining that:

This rejection follows many similar rejections made in other applications and mailed to Appellant beginning in late September 2016. An example is the non-final rejection in 08/471,704 of 11/3/2016. The USPTO generally began mailing these rejections in late September 2016 following a series of warnings to Appellant that are discussed in the body of the rejection that follows.

(A7339.) As was required by USPTO procedure, John L. LeGuyader, Director, TC 2600, "personally approve[d] the new ground(s) of rejection." (A7504.) The Board affirmed this new rejection. (A17710.)

As that chronology demonstrates, there is no need for discovery into what Examiner Divecha did or the reasons for his actions. The Administrative Record explains that in black and white. Plaintiff's motion to take his deposition should be denied, because it seeks irrelevant information and is otherwise is not proportional to the needs of the case.

**b) Plaintiff's Requests are Barred by the Deliberative Process Privilege**

The deliberative process privilege, also referred to as executive privilege, protects communications "reflecting advisory opinions, recommendations and deliberations comprising part of a process by which governmental decisions and policies are formulated." *NLRB v. Sears, Roebuck & Co.*, 421 U.S. 132, 150 (1975) (quotation and citation omitted). "The deliberative process privilege rests on the obvious realization that officials will not communicate candidly among themselves if each remark is a potential item of discovery and front page news, and its object is to enhance the quality of agency decisions by protecting open and frank discussion among those who make them within the Government." *Dep't of the Interior v. Klamath Water Users Protective Ass'n*, 532 U.S. 1, 8-9 (2001) (quotation and citation omitted). In other words, "[t]his privilege is designed to protect the quality of administrative decisionmaking by ensuring that it is

not done ‘in a fishbowl.’” *City of Va. Beach v. Dep’t of Commerce*, 995 F.2d 1247, 1252 (4th Cir. 1993) (quoting *EPA v. Mink*, 410 U.S. 73, 87 (1973)).

Thus, for example, “the privilege encourages free-ranging discussion of alternatives; prevents public confusion that might result from the premature release of nonbinding such deliberations; and insulates against the chilling effect likely were officials to be judged not on the basis of their final decision, but for matters they considered before making up their minds.” *City of Va. Beach*, 995 F.2d at 1252-53 (quotation omitted). Accordingly, materials must be “both predecisional and deliberative” in order to be subject to the deliberative process privilege, meaning they must be “prepared in order to assist [the] decisionmaker in arriving at his decision” and “reflect [] the give-and-take of the consultative process by revealing the manner in which the agency evaluates possible alternative policies or outcomes.” *Solers, Inc. v. IRS*, 827 F.3d 323, 329 (4th Cir. 2016) (quotations omitted). “Thus, the deliberative process exemption protects recommendations, draft documents, proposals, suggestions, and other subjective documents which reflect the personal opinions of the writer rather than the policy of the agency.” *Va. Beach*, 995 F.2d at 1253 (quotation and citation omitted). Finally, the deliberative process privilege “protects not only communications which are themselves deliberative in nature, but all communications which, if revealed, would expose to public view the deliberative process of an agency.” *Russell v. Dep’t. of the Air Force*, 682 F.2d 1045, 1048 (D.C. Cir. 1982).

Plaintiff bears the burden of “showing an overriding need for the information” protected by the deliberative process privilege. *See Heyer v. U.S. Bureau of Prisons*, 2014 WL 4545946, \*3 (E.D.N.C. 2014) (citing *Redland Soccer Club, Inc. v. Dep’t of Army*, 55 F.3d 827, 853 (3d Cir. 1995)). The four factors described in *Cipollone v. Liggett Group, Inc.*, 812 F.2d 1400 (4th Cir. Feb. 13, 1987) (unpublished disposition available at 1987 WL 36515), balance the Government’s need in asserting the deliberative process privilege with a plaintiff’s need for disclosure of

information. *Cipollone* directs courts to consider “(1) the relevance of the evidence to the lawsuit; (2) the availability of alternative evidence on the same matters; (3) the government’s role (if any) in the litigation, and (4) ‘the extent to which disclosure would hinder frank and independent discussion regarding contemplated policies and decisions.’” *Id.* at \*2 (quoting *FTC v. Warner Commc’ns. Inc.*, 742 F.2d 1156, 1161 (9th Cir. 1984)).

**c) Plaintiff has Not Met His Burden to Pierce the Deliberative Process Privilege**

Plaintiff falls woefully short of carrying his burden to pierce the USPTO’s deliberative process privilege. As a starting point, the USPTO did nothing to prevent Mr. Hyatt from filing the patent claims at issue at any time between 1975 when he filed his priority application and 1995 when he filed his present application. There is also no question that the USPTO had the authority and the justification to impose Requirements on Mr. Hyatt to attempt to bring some order to the chaos his more than 400 applications and 115,000 claims wreaked on the USPTO. *Hyatt v. USPTO*, 797 F.3d 1374, 1384 (Fed. Cir. 2015) (“In light of the nature of Mr. Hyatt’s applications, longstanding USPTO rules justify the issuance of the Requirements.”). Once those Requirements were issued, as the chronology above illustrates, the application made steady progress to decision in 2020.

The most that the USPTO can be accused of is contributing to the protracted prosecution between 1995 and 2013. To the extent that it is not readily apparent to the casual observer why it would take an inordinate amount of time to examine Mr. Hyatt’s applications, the USPTO was quite transparent with Mr. Hyatt about when and why it suspended prosecution. The USPTO issued numerous “Suspension of Action[s],” giving reasons. (A2736-A2738, A2750-A2752, A4859-A4860, A4861-A4862, A4865-A4866). Given the common issues across the examination of Mr. Hyatt’s applications, the USPTO made the logical decision to await further clarity from the Board or the Federal Circuit before potentially making the same reversible error in multiple

applications. *See, e.g.*, A2737 (“The decision by the Board on the co-pending applications is likely to affect the outcome of the current application because they have similar issues and claims with common subject matter.”). Mr. Hyatt implicitly recognized the reasons when he filed a “Petition for an [sic] Status Under 37 CFR 1.181(A)(3),” after “the Federal Circuit ... affirmed the district court with a decision dated December 23, 2008 in appeals 2007-1050, -1051, -1052, -1053.” (A4863-A4864.) In response, the USPTO issued a notice indicating his appeal had been docketed with the Board. (A4867.) This effectively accounts for the entire lapse in USPTO action during the time between the filing date and the Requirements.

Regardless, nothing prevented Mr. Hyatt from filing the claims—the ones he now asserts he would like examined—before, during, or after the years in which examination was suspended.

In the face of this incontrovertible evidence, Plaintiff’s reliance on the paid testimony of three former USPTO employees does not meet his burden to pierce the USPTO’s deliberative process privilege in this case. Pl. Supp. Decl., ¶¶ 13-16. As described below, at most these declarations establish that the USPTO pumped the brakes on Mr. Hyatt’s applications while it got its arms around the scope of the challenges presented by his unprecedented filings:

**Kazenske Declaration:**

Mr. Kazenske was a high-ranking official in the USPTO but left in 2005 before much of the relevant events in this Application occurred. ECF 71-4, ¶4. His relevant knowledge is even further cabined to a brief three year period from 1995 to 1998 when he served as the “Assistant Secretary of Commerce and Commissioner of Patents and Trademarks” under Bruce Lehman. *Id.*, ¶6. “By 1999 [he] had been reassigned to financial duties and was no longer responsible for the examination of Mr. Hyatt’s patent applications.” *Id.*, ¶34.<sup>11</sup>

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<sup>11</sup> Mr. Kazenske’s own Declaration states, “In effect, I was responsible for giving the order not to issue any more patents to Mr. Hyatt.” ECF 71-4 at 12. To the extent that this is true for the period of Mr. Kazenske’s tenure, Plaintiff cannot justify discovery on the issue pursuant to Rule 56(d).

It was during this brief period that the first-to-file, 20-year GATT term was coming on-line. Even taking Mr. Kazenske's testimony at face value, it should come as no surprise that the "politicals" within the USPTO were concerned about the optics of issuing a patent with a 1970s priority date given all of the talk of "submarine" patents that contributed to the push for the 20-year term in the first instance.<sup>12</sup> See, e.g., Karen Tripp & Linda Stokley, *Changes in U.S. Patent Law Effected by the Uruguay Round Agreements Act—The GATT Implementation Legislation*, 3 TEX. INTELL. PROP. L.J. 315, 318 (1995) ("This change [to a 20-year term] is intended to prevent the use of 'submarine' patents."). If the USPTO tapped the brakes on Mr. Hyatt's patent applications for this brief period to get their arms around the problem, that demonstrates prudent management rather than malice.

Notably, while Mr. Kazenske professes to remember his actions with respect to Mr. Hyatt's applications with complete clarity, he conveniently fails to recall his obligations to avoid providing privileged information to private entities about decisions he made during his government service. See 37 C.F.R. § 104.22(b) (an "employee may not give testimony .... without the approval of the General Counsel"); see also *id.* at § 104.1 (defining "employee" to mean "any current or former officer or employee of the Office").<sup>13</sup> Furthermore, his declaration fails to note that he is being paid \$500/hour to provide these recollections about his time at the USPTO, casting an even longer shadow over his testimony. Ex. 15 ("Agreement"), p. 1.

#### **Bawcombe Declaration:**

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<sup>12</sup> According to then Commissioner of Patents, Bruce Lehman: "Well, Mr. Chairman, we have come up with a solution, among other things, to the 'submarine' patent problem, and that is the legislation that we're talking about today." Ex. 14 at 118. Indeed, Mr. Hyatt's own "US Patent Number 5,339,275" was listed as an example of one such "submarine" patent. See *id.* at 143.

<sup>13</sup> The USPTO preserves all of its objections to this testimony including those based on the deliberative process privilege and reserves the right to strike his declaration from the record. The USPTO preserves the same objections to the testimony of the other former USPTO employees Mr. Hyatt has hired.

Mr. Bawcombe's paid testimony is of even less import than Mr. Kazenske's. Ex. 17 ("Agreement"), p. 1 ("\$300 an hour"). Like Mr. Kazenske, Mr. Bawcombe appears to have forgotten his obligations to the USPTO. *See supra*. Furthermore, Mr. Bawcombe was not involved in examining Mr. Hyatt's applications nor setting or establishing the policy for those who did. Instead, he ran the USPTO printing operations until his retirement in 2006. ECF 71-10, ¶10. The only "bad acts" that his declaration purports to establish is that during a brief two-year window (1997-1998), the USPTO sought to stop from issuing Mr. Hyatt any patents that had been allowed by an examiner. ECF 71-10, ¶23. This is both factually incorrect and irrelevant.

First, the USPTO actually issued four patents to Mr. Hyatt in this time period: U.S. Pat. No. 5,594,908 on January 14, 1997, U.S. Pat. Nos. 5,615,142 and 5,616,380 on March 25, 1997, and U.S. Pat. No. 5,619,445 on April 8, 1997. Second, it is well within the USPTO's right (and duty) to withdraw improvidently allowed patents. *See* 37 C.F.R. § 1.313 ("Applications may be withdrawn from issue for further action at the initiative of the Office. . . ."); *Blacklight Power, Inc. v. Rogan*, 295 F.3d 1269, 1273 (Fed. Cir. 2002) (allowing withdrawal after allowance because "[t]he object and policy of the patent law require issuance of valid patents"). Exercising this right cannot be the basis for piercing the USPTO's privilege.

Withdrawing the four applications identified in Mr. Bawcombe's declaration (¶28) from issuance is also not about this application. There is no dispute that the USPTO actively pushed the '213 Application forward between 1995 and 1998. Following a final rejection of his 75 pending claims in 1996, Mr. Hyatt filed a petition to "withdraw the finality of the Action, to reopen prosecution, and to have the submission after-final rejection entered and considered on the merits." (A843-A844.) The USPTO granted that request, only for Mr. Hyatt to file an addition 275 claims in September 1997. (A1211-A1223.) The Examiner examined all 300 some claims and issued a 200-page, non-final rejection in February 1998. (A1239-A1439.) Mr. Hyatt and the Examiner

then went back and forth, culminating in a final rejection on June 6, 2000. (A1691-A1852; *see also* A1458-A1479.) Thus, whether or not the USPTO stopped issuing Mr. Hyatt patents during this brief window of time was irrelevant because the '213 Application was nowhere near being in condition for allowance during that time. Mr. Bawcombe's declaration does not alter that discovery regarding an alleged USPTO policy against issuing Mr. Hyatt a patent is irrelevant and not proportional to the needs of the case. In any event, as already discussed above and further discussed in the next section, Plaintiff already has obtained discovery on that subject.

### **Razavi Declaration:**

Mr. Razavi is a former Administrative Supervisory Patent Examiner ("SPE") who for a period of time had some management responsibility for Mr. Hyatt's applications. ECF 71-5. Mr. Razavi was deposed at length in the Hyatt D.C. §145 cases when he was still a USPTO employee. *See* Ex. 22 (Razavi Tr. excerpts). While his recollection then was much less clear than in his current paid testimony,<sup>14</sup> he was certain about one thing—the USPTO “wanted to make sure we can . . . do the best possible examination on those cases.” *Id.* at 109:6-17, 46:21-47:3, 61:4-14, 158:21-159:16; *see also* 129:14-130:3 (“how we should put the team together to give the best examination to these cases”).

Even if the Court fully credits Mr. Razavi's current recollection of events, it does not prove anything nefarious. It merely confirms what the Administrative Record already shows—the USPTO was not in a position to handle Mr. Hyatt's unprecedented filings. *See also Hyatt v. USPTO*, 797 F.3d 1374, 1384 (Fed. Cir. 2015) (“These circumstances are not just special—they are unique.”). It was not improper, for example, for the USPTO to take steps to ensure that

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<sup>14</sup> *See* Ex. 16 (Agreement) at 1 (indicating that Mr. Razavi is being paid “\$650.00 an hour for general consultation services”). Like Mr. Kazenske and Mr. Bawcombe, he too failed to obtain permission from the USPTO before working on Plaintiff's behalf in violation of his legal obligations to his former employer. 37 C.F.R. § 104.22(b).

examiners were not unfairly penalized for taking an inordinate amount of time to examine one of Mr. Hyatt's 500-page applications, when that one application was the size and complexity of hundreds of "typical" applications.<sup>15</sup> See ECF 71-5, ¶¶ 12 (referring to "shadow art units"), 15-17, 19, 26, 34, 41. Whether that practice ultimately proved more or less efficient at reducing the issues is immaterial, Mr. Razavi's Monday-morning quarterbacking notwithstanding. *Id.*, ¶¶ 10, 16, 18, 23-25. Likewise, given that any decision in one case could have a substantial ripple effect across all of Mr. Hyatt's hundreds of pending cases, it was not surprising that additional checks or approvals were necessary in Mr. Hyatt's cases as opposed to others. *Id.*, ¶¶ 13, 14, 21, 27, 31. All this proves is that the USPTO's administrative practices evolved over decades based on the USPTO's collective and cumulative experience showing that standard practices did not work for Mr. Hyatt's unprecedented portfolio.

Mr. Razavi's testimony that the USPTO would "suspend" or put "on hold" Mr. Hyatt's applications adds nothing new. *Id.*, ¶¶ 10-12, 26-27, 29, 40. The suspensions are clear from the Administrative Record. Ironically, one of the exhibits Mr. Hyatt used at the hearing before the Board in this case is an email from Mr. Razavi stating that "we are on hold." (A17477.) Again, that was a perfectly reasonable administrative decision. One critical, threshold issue that needed to be resolved before Hyatt prosecution could proceed was "when and how" the examiner satisfies the *prima facie* burden of production in making a written description rejection. See *Hyatt v. Dudas*, 492 F.3d 1365, 1367-68 (Fed. Cir. 2007). Many, if not all, of Mr. Hyatt's applications stood rejected for lack of written descriptive support (as in the present case) because Mr. Hyatt's claims were drafted decades after his original application was filed. "Rather than respond to the merits of the rejection by explaining where in the specification the cited combinations of components

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<sup>15</sup> A "typical" patent application includes three independent claims and twenty total claims because that is the number of claims that are included in the "Basic filing fee." 37 C.F.R. § 1.16(a), (h), and (i).



could be found,” however, “[Mr.] Hyatt instead merely challenged the adequacy of the USPTO’s *prima facie* case.” *Id.* at 1367. Instead of continuing to make these rejections in numerous Hyatt applications in hopes that they would not be unraveled by the Federal Circuit, the USPTO decided to suspend prosecution while that issue was litigated. While reasonable minds might differ on whether this was the correct approach, it does not amount to bad faith.

Similarly, given the overlap of issues raised across Mr. Hyatt’s applications, it is no wonder that the USPTO sought clarity from the Board or the Federal Circuit before proceeding with further examination. For example, one critical, pre-Requirement issue was the use of “representative” claims during examination. That issue was litigated in a number of §145 cases involving “approximately 2,400 claims in twelve [Hyatt] related patent applications” before being resolved by the Federal Circuit in 2008. *See Hyatt v. Dudas*, 551 F.3d 1307, 1309 (Fed. Cir. 2008). The Federal Circuit clarified that a “representative” claim may not be used to reject an entire group of claims for lack of written description “unless the claims share a common limitation that lacks written description support.” *Id.* at 1313. Fortunately, the impact of this decision was attenuated because the USPTO had made the prudent decision to stay Mr. Hyatt’s cases pending this decision, as Mr. Hyatt himself recognized. (A4863-A4864.) This is not bad faith.

#### **D. Plaintiff Does Not Need Any More Discovery to Oppose Defendant’s Summary Judgment Motion**

Not only does Plaintiff’s Rule 56(d) proposed discovery far exceed this Court’s Order and what is legally permissible, it also fundamentally misapprehends the current posture of the case. This is not a typical summary judgment case where a party is asking this Court to resolve an arguably disputed issue of fact for the first time. In this case, the USPTO made its rejection, Mr. Hyatt responded to that rejection, and the Board ruled on that rejection. The record is complete. Just because Mr. Hyatt has the right to submit new evidence, *Kappos v. Hyatt*, 566 U.S. 431, 445–46 (2012), does not mean that he is entitled to discovery beyond what he already has received. Not

only did Mr. Hyatt have a full and fair opportunity to respond to the USPTO's case before the Board, he did so with the full benefit of all of the discovery he has obtained in all of his prior cases. (A16870-A17354 (Reply Brief on Appeal).)

# **1. Plaintiff Does Not Need Any more Discovery into Prosecution Laches**

The "Laches-related evidence" submitted by Mr. Hyatt and considered by the Board was substantial. (A17043.) That evidence included declarations (A17198, A17315), deposition testimony (A17134, A17138, A17177), expert reports (A17232, A17256, 17309), emails (A17075, A17142, A17170, A17171, A17179), and trial exhibits (A17044, A17076, A17140, A17143, A17145). As discussed above, this is a small fraction of the discovery he received from the USPTO. *See* Exs. 1-4; *see also* Exs. 23-34. Mr. Hyatt even included a 28-page "Table of Exhibits" providing a detailed description of each laches-related exhibit. (A17203-A17230.) Some of this evidence is precisely the same evidence Plaintiff contends he still needs. *See* Exs. 23 (1999 email discussing examination of "Hyatt actions so far this year"), 24 (2000 email to Hyatt examiners indicating that each "needs to complete at least one Hyatt action per month"), 29 (2006 email "RE: Hyatt after final"), 30 (2006 Razavi email—"we are on hold"), 31 (2007 email regarding "timely abandonment process"). For example, a document entitled "Compilation of Guidance from Greg [Morse] on [Hyatt Unit] 2615 Applications" falls within Plaintiff's document request number 1. (A17172-A17176; *see also* Ex. 26 (Morse email instructing examiners).) Another includes a forwarded copy of a Sacramento Bee article on California's case against Mr. Hyatt for "\$20 million" in unpaid state income taxes that arguably "portray Gilbert P. Hyatt. . . in a negative light," as sought by his second document request. (A17188; A17197; *see also* Exs. 25 (2003 email discussing Hyatt tax case), 27-28 (email discussing Hyatt divorce settlement.)) He also submitted a copy of a "meme" generated by a USPTO examiner showing two WWE wrestlers—with Mr.

Hyatt's face superimposed on one, holding another representing the USPTO in a "chokehold," captioned "The Submarine Prosecution Chokehold." (A17195.<sup>16</sup>)

With all this evidence before it, the Board concluded that Mr. Hyatt had engaged in prosecution laches. That is the decision at issue in the USPTO's summary judgment motion. Additional discovery will not change the evidence already of record in the case, and authorizing a fishing expedition in order to try to locate possibly duplicative or cumulative evidence on these largely irrelevant and collateral issues is improper and certainly not proportional to the needs of the case.

## **2. Plaintiff Does Not Need Any More Discovery on Undue Multiplicity**

The evidence adduced on the undue multiplicity rejection considered by the Board is also complete and incontrovertible. There can be no dispute that the USPTO's Requirements gave Mr. Hyatt a generous budget of 600 claims per unique specification with which to work. (A4947-A4984.) Despite that budget, he kept hundreds and hundreds of claims alive in each application including this one. (A6346-A6347 (listing "Claims pending").) Not until his Appeal Brief did he make any meaningful attempt to reduce his number of claims.<sup>17</sup> (A6820-A6824.) No amount of additional discovery will change these facts.

## **III. CONCLUSION**

For all of these reasons, this Court should deny Hyatt's Rule 56(d) Motion and proceed directly to the merits of the USPTO's motion for summary judgment.

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<sup>16</sup> Mr. Hyatt has argued that this meme shows that the PTO was biased against him. In fact, it shows the agency in a chokehold, after Mr. Hyatt's prosecution practices crippled examination.

<sup>17</sup> Mr. Hyatt employed a similar tactic in this Court by substantially reducing the 320 claims pending before the Board to the 54 "Subject Claims" in his Complaint. This reduction has no impact on the merits of the Board's rejection of the 320 claims as unduly multiplied. And even here, the list of claims he is attempting to pursue is much longer than the 9 claims he selected for prosecution after the Requirement.

DATED: March 23, 2021

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that on March 23, 2021, I have electronically filed the foregoing using the CM/ECF system, which will send a notification of such filing to the all counsel of record including the following:

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