

**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 Nos. 1:20-cv-00990 (AJT/IDD)
1:20-cv-00983 (AJT/IDD)

**USPTO'S OPPOSITION TO PLAINTIFF'S MOTION FOR LEAVE
TO FILE A SUPPLEMENTAL MEMORANDUM AND DECLARATION**

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I. INTRODUCTION

The Court should deny Plaintiff's Motion for Leave To File a Supplemental Memorandum in Opposition to Defendant's Motion for Summary Judgment and in Support of Plaintiff's Rule 56(d) Motion (ECF 140¹) ("Motion") because it does not establish good cause or excusable neglect for filing an additional brief after the expiration of the applicable filing deadlines.

The Court already has issued three different orders giving Mr. Hyatt the opportunity to submit purportedly relevant evidence (or identify allegedly relevant discovery) in opposition to the United States Patent and Trademark Office's ("USPTO") summary judgment motion. First, the Court ordered completion of initial summary judgment briefing by January 25, 2021. *See* ECF 74. Thereafter, the Court ordered completion of combined summary judgment and Rule 56(d) briefing by February 15, 2021. ECF 95. Third, the Court ordered the parties to complete supplemental briefing of the Rule 56(d) issue by March 30, 2021. ECF 130.² Mr. Hyatt also had a fourth opportunity to raise his intent to obtain and file a LeGuyader declaration during the summary judgment hearing in this matter.

Mr. Hyatt should not get a fifth bite at this apple because: (1) he fails to demonstrate diligence and explain his delay; (2) the LeGuyader declaration involves significant prejudice and evinces a lack of good faith, because it implicates privileges that are not Mr. LeGuyader's to waive, including the USPTO's internal attorney-client privilege, as well as federal law that prohibits certain testimony by former federal employees; and (3) the LeGuyader declaration largely provides irrelevant and duplicative testimony.

¹ All ECF citations herein are to *Hyatt v. Hirshfeld*, Case No. 20-990 (E.D.V.A.) unless indicated otherwise.

² This Order provided for up to 35 days of briefing time after February 23, 2021.

II. LEAVE TO FILE SHOULD BE DENIED

A motion for an extension of time for a filing deadline requires good cause. *See* Fed. R. Civ. P. 6(b)(1); *see also* Fed. R. Civ. P. 16(b)(4) (requiring good cause for modification of a scheduling order). Furthermore, “on motion made after the time has expired, the [C]ourt may only extend the time ‘if the party failed to act because of excusable neglect.’” *Smith v. Look Cycle USA*, 933 F. Supp. 2d 787, 790 (E.D. Va. 2013) (quoting Fed. R. Civ. P. 6(b)(1)(B)). The applicable “good cause” and “excusable neglect” factors weigh against granting Mr. Hyatt leave to file his Supplemental Memorandum and the LeGuyader declaration.

Demonstrating good cause requires “a showing” that a schedule “cannot reasonably be met despite the diligence of the party seeking the extension.” *See* Fed. R. Civ. P. 16 Advisory Comm.’s Notes (1983 Am.). Additional factors that may be relevant in determining whether a party has shown good cause specifically to file a supplemental brief include: “(1) the explanation for the failure to submit [the supplemental information] ...on time; (2) the importance of the testimony; [and] (3) potential prejudice in allowing the testimony....” *Shepherd on behalf of Est. of Shepherd v. City of Shreveport*, 920 F.3d 278, 287–88 (5th Cir. 2019) (internal quotes and citations omitted); *see also, e.g., Midgett, Tr. of Hardcastle Charitable Remained Annuity Tr. U/A August 6, 2007 v. Hardcastle*, 2:17-CV-663, 2018 WL 4781178, at *3 (E.D. Va. Oct. 3, 2018) (listing as good cause factors “the danger of prejudice..., the length of delay..., the reason for the delay..., and whether the movant acted in good faith”).

Excusable neglect is “not easily demonstrated” and applies “only in the ‘extraordinary cases where injustice would otherwise result.’” *Smith*, 933 F. Supp. 2d at 790. Factors to consider are similar to the good cause factors above: “the danger of prejudice, length of delay and potential impact, the reason for the delay, whether the delay was within the reasonable control of the movant, and whether the movant acted in good faith.” *Id.* (citing *Thompson v. E.I. DuPont de Nemours &*

Co., 76 F.3d 530, 533 (4th Cir. 1996) (quoting *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P'Ship*, 507 U.S. 380, 395 (1995)). “The most important ... factor[] is the reason for failure to timely file.” *Smith* at 790 (citing *Thompson*, 76 F.3d at 534). The Court should deny Plaintiff’s Motion in light of these factors.

A. The Motion does not make a showing of diligence or explain Mr. Hyatt’s delay.

The Court should deny the Motion because it does not show that Mr. Hyatt acted diligently. Instead, it offers only cursory conclusions based on attorney argument: “Mr. LeGuyader recently retired from PTO in December 2020 and Mr. Hyatt has worked diligently to obtain a sworn statement from Mr. LeGuyader;” “[d]espite Mr. Hyatt exercising his best efforts to obtain a sworn statement in time for the briefing schedule caused by the PTO’s early summary judgment motion and the Supplemental 56(d) Declaration, Mr. Hyatt did not obtain the attached declaration until April 19, 2021, after the close of briefing”; and “Mr. Hyatt diligently pursued this evidence even after the Court, at PTO’s request, stayed discovery in these actions.” Motion at 2, ¶ 2; 3, ¶ 4. Mr. Hyatt’s Motion does not support these statements with any examples of the alleged “best efforts,” much less any evidence. It does not even describe a single interaction between Mr. Hyatt and Mr. LeGuyader or proffer a dated email or consulting agreement (as Mr. Hyatt has with the other former USPTO employees) to corroborate this story.

Mr. Hyatt’s exclusive reliance on attorney argument constitutes a failure to demonstrate diligence that alone dictates that the Court should deny the Motion, because “whatever other factors are also considered, ‘the good-cause standard will not be satisfied if the [district] court concludes that the party seeking relief (or that party’s attorney) has not acted diligently in compliance with the schedule.’” *Cook v. Howard*, 484 Fed. Appx. 805, 815 (4th Cir. 2012) (unpublished) (quoting 6A Charles Alan Wright, Arthur R. Miller, and Mary Kay Kane, *Federal Practice and Procedure Civ.*, § 1522.2 (3d ed. 2010)); see also *Hussain v. Nicholson*, 435 F.3d

359, 367 (D.C. Cir. 2006) (Rogers, J., concurring) (if the moving party “was not diligent, the inquiry should end” (citing numerous federal appellate decisions for this proposition)); *Midgett*, 2018 WL 4781178, at *3 (“the diligence of the [moving party] ... is the most important consideration”).

The Motion likewise fails to adequately explain Mr. Hyatt’s delay. *See Thompson*, 76 F.3d at 533 (the most important “excusable neglect” factor is the reason for the failure to timely file); *Shepherd*, 920 F.3d at 287–88 (the first factor in determining good cause is the explanation for the delay). The Motion does not describe when and how Mr. Hyatt learned of Mr. LeGuyader’s retirement, and what prevented Mr. Hyatt, despite his alleged diligence, from obtaining Mr. LeGuyader’s declaration in order to file it with the Court on time.³ Mr. Hyatt’s failure to explain his delay weighs strongly in favor of denying the Motion. *See Shepherd*, 920 F.3d at 288 (a plaintiff’s failure to explain her delay was a reason she fell “far short of demonstrating that there was good cause for receiving a schedule adjustment to permit supplemental briefing”).

B. Mr. LeGuyader’s declaration is prejudicial and evinces a lack of good faith because it breaches his ongoing duties and obligations to the USPTO.

The prejudice in allowing the LeGuyader declaration weighs heavily in the USPTO’s favor. The LeGuyader declaration continues Mr. Hyatt’s pattern of inducing former USPTO employees to breach their post-employment duties of confidentiality to the agency. Federal law precludes former federal employees from providing anything other than purely factual information garnered during their prior employment in an action against the United States, and – of significance here – still precludes the disclosure of official information that is privileged or otherwise protected by

³ Regardless of when Mr. Hyatt finally “obtained” the LeGuyader declaration, *see* Motion at 2, ¶ 2, he made no effort to inform the Court or opposing counsel about his ongoing efforts and his intent to obtain and submit it before the Court-ordered supplemental briefing period expired on March 30, 2021. *See* ECF 130. Had he done so, at least some of the prejudice discussed in detail in Section II(B) below might have been avoided.

law. *See* 15 C.F.R. § 15.13 (former employee is required to seek authorization from USPTO before disclosing “confidential, sensitive information and the deliberative process of the Department”); *see also* 18 U.S.C § 207. For these additional reasons Mr. Hyatt’s motion should be denied.

1. The LeGuyader declaration is prejudicial and shows a lack of good faith because he may not disclose privileged communications.

Mr. LeGuyader contends that the USPTO’s Solicitor’s Office is the real mastermind behind the USPTO’s supposed “no-patents-for-Hyatt” policy. Declaration of John LeGuyader, ECF 140-2 (“Decl.”), ¶¶ 19, 22, 28. However, even if that were true (it is not), there is nothing improper about the Solicitor’s Office providing legal advice to the patent examiners about proper course of conduct in a given situation. *In re Gould*, 673 F.2d 1385, 1386-87 (C.C.P.A. 1982).⁴

In re Gould is particularly instructive given the similarities between that case and this one. In *Gould*, a patent applicant appealed a rejection of his patent claims. *Id.* at 1385. After the appeal was docketed at the court of appeals, the USPTO moved the court to remand the case back to the Board for consideration of new grounds of rejection that had come to light in a parallel Section 145 action “testing whether a related application is entitled to an [earlier] effective 1959 filing date” under 35 U.S.C. § 120. *Id.* at 1386. The applicant “strenuously” opposed the remand. *Id.*

The applicant argued, as Mr. Hyatt does here, that “the [S]olicitor acted improperly in making ex parte contact with the board and examiner, and in arrogating to himself their decision-making functions.” *Id.* at 1386. The court of appeals rejected that argument because it was “premised on a fundamental misconception of the role of the solicitor in an ex parte patent appeal.” *Id.* The court explained that the solicitor is “legal counsel to the PTO,” and therefore entitled to advise it on the proper, legal course in a given situation:

⁴ Decisions of the U.S. Court of Customs and Patent (“C.C.P.A.”) are binding precedent on the U.S. Court of Appeals for the Federal Circuit. *South Corp. v. United States*, 690 F.2d 1368, 1369 (Fed. Cir. 1982) (en banc) (adopting, in its first published opinion, the case law of the C.C.P.A. as binding precedent).

It is not improper for him to discuss a case at any stage with the Commissioner, the board, or an examiner, even to ascertain the course of any prosecution after the PTO regains jurisdiction. Such discussion is neither impermissible “tampering,” nor impermissible ex parte contact.

Id. at 1386–87. Accordingly, the court granted the USPTO’s motion and remanded the case back to the agency for consideration of the new grounds of rejection. *Id.* at 1387.

It defies logic to think that the Solicitor’s Office would *not* be involved in Mr. Hyatt’s cases given his litigious history. *Cf. Pub. Emps. for Env’t Resp. v. U.S. Env’t Prot. Agency*, 211 F. Supp. 3d 227, 231 (D.D.C. 2016) (The attorney-client privilege “is intended to protect the quality of agency decision-making by preventing the disclosure requirement of the FOIA from cutting off the flow of information to agency decision-makers.” (quoting *Mead Data Cent., Inc. v. U.S. Dep’t of the Air Force*, 566 F.2d 242, 252 (D.C. Cir. 1977))). Attorneys routinely review, and revise, written materials that their clients intend to send to a litigation adversary. This is especially true of allegedly “boilerplate” language that likely is going to appear in hundreds of documents and form the legal foundation upon which the party stands in subsequent litigation between the parties. Likewise, that the Solicitor’s Office may have reviewed and commented on the common legal framework in the 2013 Requirements that was mailed to Mr. Hyatt in all of his pending cases, for example, should come as no surprise. *See Mead Data*, 566 F.2d at 256 (Congress exempted privileged communications from FOIA discovery “in recognition of the merits of arguments from the executive branch that the quality of administrative decision-making would be seriously undermined if agencies were forced to ‘operate in a fishbowl’ because the full and frank exchange of ideas on legal or policy matters would be impossible.”). It certainly does not evince any bad faith or bias on the part of the USPTO, as Mr. LeGuyader implies.

More importantly, communications between the Solicitor’s Office and its client (the USPTO) are protected from discovery by the attorney-client privilege. *See Rein v. USPTO*, 553 F.3d 353, 376 (4th Cir. 2009) (“[A]n agency can be a ‘client’ and agency lawyers can function as

‘attorneys’ within the relationship contemplated by the privilege.” (quoting *Coastal States Gas Corp. v. Dep’t of Energy*, 617 F.2d 854, 863 (D.C. Cir. 1980)); see also *Mead Data*, *supra*.⁵ Any communications regarding legal advice between the USPTO’s attorneys and Mr. LeGuyader or any of his examiners is privileged and he is not at liberty to now disclose their substance simply because he is no longer employed by the agency. Cf. *In re Grand Jury Proceedings*, 33 F.3d 342, 348 (4th Cir. 1994) (“The client is the holder of this privilege.”). Attempting to disclose such privileged communications (regardless of whether he accurately describes them) violates his ongoing duty to the agency to maintain those conversations in confidence. See 15 C.F.R. § 15.13; see also 18 U.S.C. § 207.⁶

While the USPTO certainly disagrees with Mr. LeGuyader’s characterization of the examination process of Mr. Hyatt’s patent applications and the Solicitor’s Office’s role in it, the USPTO is unable to defend itself against his mischaracterizations without running the risk of waiving its privilege. See *United States v. Jones*, 696 F.2d 1069, 1072 (4th Cir. 1982) (“Any disclosure inconsistent with maintaining the confidential nature of the attorney-client relationship waives the attorney-client privilege.”). To the extent that the LeGuyader declaration was intended to lure the USPTO into doing so, it will not take the bait. However, allowing this testimony to

⁵ Any such communications also might be protected under the attorney work-product doctrine given the likelihood of subsequent litigation with Mr. Hyatt or covered by the deliberative process privilege. See *Jud. Watch, Inc. v. U.S. Postal Serv.*, 297 F. Supp. 2d 252, 268 (D.D.C. 2004) (“The attorney work-product privilege protects disclosure of materials prepared by attorneys, or non-attorneys supervised by attorneys, in contemplation of litigation, that reveal information about an attorney’s preparation and strategy relating to a client’s case.”); see also *City of Virginia Beach, Va. v. U.S. Dep’t of Com.*, 995 F.2d 1247, 1251 (4th Cir. 1993).

⁶ Mr. Hyatt’s lawyers also have an ethical obligation not to induce Mr. LeGuyader to divulge privileged information. Rule 4.4 of both the District of Columbia and Virginia Rules of Professional Conduct state that, when representing a client, a lawyer shall not “use methods of obtaining evidence that violate the legal rights of [a third] person.” Va. R. of Prof. Conduct, Rule 4-4; see also DC Bar Ethics Opinion 285 (Nov. 1998) (this rule “preclude[s] attempts to induce [a] former government employee to reveal information made confidential by statute or a well-established common law privilege”), available at https://www.dcbar.org/getmedia/44d1c67d-166e-4698-b594-8bf4d0e48c15/DC_RPC_02_2021_Opinions_Only.

stand will prejudice the USPTO by forcing it into a Hobson's choice of remaining silent or waiving privilege to prove their falsity. *Cf. Quantum Corp. v. Tandon Corp.*, 940 F.2d 642, 644 (Fed.Cir.1991) ("An accused infringer, therefore, should not, without the trial court's careful consideration, be forced to choose between waiving the privilege in order to protect itself from a willfulness finding, in which case it may risk prejudicing itself on the question of liability, and maintaining the privilege, in which case it may risk being found to be a willful infringer if liability is found."). Mr. LeGuyader has no business disclosing any communications with the Solicitor's Office in the first place. 15 C.F.R. § 15.13. Therefore, the Court should cut this off before it takes root by denying Mr. Hyatt's Motion.

2. Mr. LeGuyader's opinion testimony is prejudicial and shows a lack of good faith.

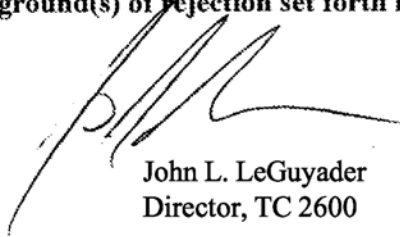
A former USPTO employee also may not provide expert testimony, without a court order, in a case against the USPTO in a matter in which he "personally and substantially" participated. 18 U.S.C. § 207(j)(6)(A). A government employee may not "resign[] his position and 'switch[] sides' in a matter which was before him in his official capacity." *Goodeagle v. United States*, 2010 WL 3081520, at *2 (W.D. Okla. Aug. 6, 2010) (quoting H.R. Rep. No. 87-748 at 3 (1961)); *see also United States v. Rosen*, 599 F. Supp. 2d 690, 699 (E.D. Va. 2009) (explaining that the statute is "designed to prevent former government officials from using the specific knowledge . . . obtained during their employment for the benefit of parties whose interests conflict with those of the United States"); *United States v. Clark*, 333 F. Supp. 2d 789, 793 (E.D. Wis. 2004) (noting that the statute's "purpose was to protect the public from an individual attempting to use not the expertise, but the specific knowledge obtained while serving as a public servant").

Mr. LeGuyader's testimony should be excluded because it would allow him to "switch sides." *Goodeagle, supra*. It is indisputable that he was personally and substantially involved in both the '213 and '173 applications at issue in the -983 and -990 cases, respectively. *See, e.g.*,

Decl., ¶¶ 2, 9, 32. While Mr. LeGuyader admits that he signed “suspensions in some of Mr. Hyatt’s applications,” he conveniently omits that he signed suspensions of prosecution in both the ’213 and ’173 applications. *See Hyatt v. Hirshfeld*, Case No. 20-983 (E.D. Va.) (A4870), and 20-990 (E.D. Va.) (A5284). Whether he was “uneasy about doing so” or not, while convenient, is beside the point. Decl., ¶ 31. He signed them in his official, decision-making capacity exercising his authority over both the ’213 and ’173 applications, triggering Section 207’s prohibition against expert testimony in the present cases.

Mr. LeGuyader’s testimony in the -983 case is particularly troubling because it relates to the propriety of the same prosecution laches rejection he endorsed while at the agency.⁷ He signed an Examiner’s Answer in the ’213 application, personally approving the assertion of prosecution laches as a “new ground[] of rejection” in that application:

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (1) above by signing below:


John L. LeGuyader
Director, TC 2600

Hyatt, Case No. 20-983 (A7504).

Despite having “personally approve[d]” and endorsed the USPTO’s assertion of prosecution laches in the ’213 application, Mr. LeGuyader now offers his opinion testimony that the USPTO’s handling of Mr. Hyatt’s applications was inconsistent with his perceptions of USPTO norms, practices, policies, and procedures. Below are examples of his opinion testimony about such things (with emphasis added):

⁷ Footnote withdrawn—intentionally left blank.

- “One *unusual* feature of the Art Unit 2615 was that examiners would not have the usual primary examiner authority....” Decl., ¶ 22.
- “The *culture* is not to buck upper management and not to question Assistant Deputy Commissioners, the Commissioner of Patents, or the Solicitor’s Office.” *Id.* at ¶ 24.
- “This was *unusual*. The USPTO generally requires that a new examiner give full faith and credit to the work of a prior examiner.” *Id.* at ¶ 26.
- “Also, it is *rare* for the USPTO to reopen prosecution for an application already on appeal in the absence of a new ground of rejection.” *Id.*
- “The agency does not do these kinds of things because they cause *unwarranted* delay and they are *unfair* to the application.” *Id.*
- “In addition to personal bias against Mr. Hyatt, the USPTO’s policies *evidence* a kind of institutional bias against Mr. Hyatt.” *Id.*, at ¶ 42.
- “For example, the USPTO policy is that examiners are *supposed to* work with applications to identify allowable subject matter when possible and thereby advance prosecution. See MPEP ¶ 707.07.” *Id.*

Mr. LeGuyader bases these opinions on the specialized knowledge, training and experience he acquired working at the USPTO on these very applications. While he is certainly entitled to those opinions, he is not permitted to offer them in a matter in which he was directly involved, particularly not in an effort to undermine the same actions he endorsed while at the agency. 18 U.S.C. § 207(j)(6)(A); *Goodeagle*, 2010 WL 3081520, at *2. Introducing these opinions in the record in these cases, in derogation of Mr. LeGuyader’s duties, would be prejudicial to the USPTO.

3. Mr. Hyatt’s payments to former PTO employees indicate a lack of good faith.

Mr. Hyatt’s practices of paying top dollar for the testimony of former PTO employees also raises serious questions about the veracity of Mr. LeGuyader’s testimony and the motivations behind it. *See, e.g.* ECF 137-15 (\$500/hr), -16 (\$650/hr).⁸ While Mr. Hyatt has yet to produce his payments to Mr. LeGuyader (or his “consulting” agreement) because discovery is currently stayed,

⁸ Such payment also would support an inference that Mr. LeGuyader is actually a *de facto* paid expert.

if payments to other former USPTO employees are any indication, Mr. LeGuyader will be handsomely compensated for his “testimony.” That is problematic and further suggests a lack of good faith. *See United States v. Anty*, 203 F.3d 305, 311–12 (4th Cir. 2000) (“Legitimizing the payment of money to witnesses can be a risky business, particularly when the payment greatly outstrips any anticipated expense.”); *see also* 18 U.S.C. § 201.

Consistent with the proposition that Mr. Hyatt has compensated Mr. LeGuyader, the LeGuyader declaration is replete with rhetorical advocacy more appropriate for a brief than a factual declaration. *See, e.g.*, Decl., ¶ 2 (the USPTO “sought to keep Gilbert P. Hyatt’s patent applications bottled up in examination so that they could not reach the Appeal Board and could not issue as patents.”), ¶ 3 (“The USPTO’s denials that it has maintained a ‘no-patents-for-Hyatt’ policy are false; the USPTO has maintained a policy of delaying and rejecting Mr. Hyatt’s applications at least through [his] retirement in 2020”), ¶ 12 (“Mr. Hyatt was commonly referred to as a ‘submariner,’ a pejorative label ... this was a myth....”), ¶ 24 (“The initial approach was to prevent Mr. Hyatt’s application from any type of productive movement forward in prosecution.... No one questioned this strategy....”), ¶ 37 (“The new strategy was ... double down on hitting him with technical rejections, such as laches and undue multiplicity.”), ¶ 39 (“Mr. Hyatt’s claims are correct.”), and ¶ 40 (“In late 2018, USPTO was forced to produce to Mr. Hyatt a doctored image....”). Not surprisingly, these soundbites appear verbatim in Mr. Hyatt’s Supplemental Memorandum, raising questions about common authorship. Mr. LeGuyader’s rather sharp tone is also surprising for someone who spent 30 years at the USPTO.

4. Inherent failures of credibility also suggest a lack of good faith.

On the one hand, Mr. LeGuyader portrays himself as being intimately involved in the handling of Mr. Hyatt’s applications. *See* Decl., ¶¶ 2, 9, 21, 32. On the other hand, he tries to distance himself from the day-to-day actions taken in Mr. Hyatt’s cases, knowing that his

fingerprints are all over the applications. *Id.*, ¶ 19 (“I exercised at least nominal responsibility over Mr. Hyatt’s applications”), ¶ 29 (“Although I was the TC Director formally charged with oversight over Art Unit 2615, the Solicitor’s Office and senior management was in control.”), ¶ 31 (“I signed petition decisions that the Solicitor’s Office had approved, because I did not want to go against the strategy”). Mr. LeGuyader cannot have it both ways—either he lacks relevant knowledge or he is partially responsible for the problem he now decries. Either way, his testimony is of dubious value.

Mr. LeGuyader’s testimony about the USPTO’s handling of Mr. Hyatt’s applications in response to Judge Ellis’s order is another example of the lack of credibility inhering in the LeGuyader declaration. According to Mr. LeGuyader, it was Judge Ellis’s order denying the USPTO’s motion to dismiss that finally forced the agency to begin moving his applications toward final decision. Decl. ¶ 36. However, Judge Ellis’s order did not issue until March 26, 2019. *Hyatt v. Iancu*, Case No. 1:18-cv-546, ECF 66 (Mar. 26, 2019). By then, the Examiner already had issued final rejections in both the ’213 and ’173 applications. *See* ’213 application (Case No. 20-983 (A6346-465 (dated July 11, 2016))) and ’173 application (Case No. 20-990 (A6981-7121 (dated Oct. 3, 2017))). The latter included both prosecution laches and undue multiplicity. *Id.* As a result, Mr. LeGuyader’s argument that Judge Ellis’s order precipitated a “new strategy” whereby the USPTO “would double down on hitting him with technical rejections, such as laches and undue multiplicity,” Decl. ¶ 37, is belied by the records in these cases.

Mr. LeGuyader’s allegations about Mr. Morse’s bias are beyond the pale. Implicit in his allegations is that Mr. Morse perjured himself before Judge Ellis to hide the USPTO’s “secret” policy. As the USPTO explained in its previous filings, Judge Ellis already found that the USPTO has no current policy against issuing Mr. Hyatt patent applications. *Hyatt v. USPTO*, 2020 WL 4820709, at *7. (E.D. Va. Aug. 19, 2020). That finding was based in part on the testimony of Mr. Morse, who has managed the Art Unit responsible for examining Mr. Hyatt’s applications since

2013. *See id.* (quoting Morse testimony). By alleging that “[t]he USPTO’s denials that it has maintained a ‘no-patents-for-Hyatt’ policy are false,” Decl. ¶ 3, Mr. LeGuyader is, for all intents and purposes, calling Mr. Morse a liar.⁹ The Motion and proposed Supplemental Memorandum make it explicit, calling Mr. Morse’s testimony “untruthful.” Motion at 3, ¶ 5; Supp. Br. (ECF 140-1) at 4, ¶¶ 7, 8. To suggest that Mr. Morse would risk criminal prosecution by lying to Judge Ellis’s face in response to a direct question—all to prevent Mr. Hyatt from receiving a patent—is another example of the lack of both credibility and good faith presented by the LeGuyader declaration.

In an attempt to bolster his attack on Mr. Morse, Mr. LeGuyader also intimates that Mr. Morse perjured himself about “view[ing] the ‘chokehold’ image around [the] time that it was produced to Mr. Hyatt.” Decl., ¶ 41. This allegation again refers to Mr. Morse’s testimony before Judge Ellis that, while he was “aware” of this meme, he had not seen it until it was shown to him at the hearing. *Hyatt*, Case No. 1:18-cv-546, ECF 157 at A98 (98:19-99:23). As is clear from his testimony before Judge Ellis, Mr. Morse had a perfectly clear recollection of how and when he first learned about the meme and whether he had actually seen it before. *Id.* Moreover, unlike Mr. LeGuyader’s recollection, Mr. Morse’s testimony was both subject to Judge Ellis’ scrutiny and supported by contemporaneous documents in that case demonstrating that Mr. Morse was not a recipient of the email that contained the meme. *Id.* at A230-235. Once again, to suggest that Mr. Morse would lie about such a minor point says much more about Mr. Hyatt’s litigation tactics than Mr. Morse’s character. These baseless attacks on Mr. Morse’s character are yet another indication

⁹ Equally troubling is the implication that the Solicitor’s Office suborned perjury by allowing his testimony to stand, with full knowledge that it was false as the purported mastermind behind this alleged “policy.” This allegation is particularly outrageous coming from someone who interacted with the Solicitor’s Office and supervised and even endorsed the very actions he now abhors.

that Mr. LeGuyader's declaration lacks credibility. It suggests a lack of good faith and certainly does not amount to "good cause" for supplementing the record or additional discovery.

C. The LeGuyader Declaration is not important because it provides irrelevant and duplicative information.

Even putting aside the impropriety of Mr. LeGuyader's testimony, the content of his declaration does not amount to "good cause" to supplement the record or conduct further discovery. By and large, his declaration simply rehashes many of Hyatt's well-worn themes—SAWS, PTO delay, and institutional bias. *See, e.g.*, ECF 90-7 at 8 ("SAWS"), *id.* ("PTO delay"), 10 ("policy against issuing Hyatt patents") (Jan. 11, 2021). This is clear based on the roles that he played at the USPTO.

1. 1990-2006: LeGuyader had no personal knowledge about the Hyatt matters.

By Mr. LeGuyader's own admission, he has no relevant knowledge until 2006 when he became involved in the now defunct SAWS program.¹⁰ By that time, Mr. Hyatt's applications in the -983 and -990 cases already had been pending for 31 years and 22 years, respectively. Prior to that time, Mr. LeGuyader worked in a completely unrelated art unit—one devoted to "Biotechnology and Organic Chemistry," given his background in "Biological Science." *Compare* <https://www.uspto.gov/patents/contact-patents/patent-technology-centers-management> (last checked April 22, 2021) *with* Decl., ¶ 4. (Mr. Hyatt's applications, in contrast, are assigned to the "Communications" technology center, TC 2600.) By 2006, Mr. Hyatt was already dug in on his unreasonable prosecution strategy. He had filed 446 claims in the '213 application and 551 claims in the '173 application alone. ('213 Application, Case No. 20-983 (A3566-3636 (dated Aug. 8, 2006))); ('173 Application, Case No. 20-990 (A4666-4782 (as of Oct. 4, 2005))). The lines over

¹⁰ His knowledge of supposed USPTO "folklore" based on water-cooler talk, *see* Decl., ¶¶ 11-12, is vague, unhelpful, and based on hearsay statements by unidentified individuals.

lack of written description support, effective filing date, and duplicative claims were well drawn by this time. *See, e.g.*, '173 application, Case No. 20-990 (Appeal Br., pp. 1-8 Oct. 4, 2005) (A4304-4311 ("Table of Contents")). Unlike the Administrative Record, Mr. LeGuyader can offer nothing useful on what happened before then.

2. 2006-2009: LeGuyader's SAWS testimony is duplicative and immaterial.

Mr. LeGuyader's testimony on the now-defunct "SAWS" program is also unnecessary to resolve the USPTO's summary judgment motion. Dec., ¶¶ 14-15. As the USPTO already explained, "Hyatt or his proxies (ACET and AAET) have filed numerous cases seeking documents related to SAWS." ECF 129 at 16. As a result of this discovery, the USPTO identified five of Mr. Hyatt's applications that were flagged in this quality review program, along with many other applications. *Id.* at 16-17; *see also* ECF 137-3 at 8-9 (identifying five Hyatt applications in SAWS). Neither of the applications at issue in the present cases were flagged in SAWS. *Id.* The program was shut down in 2015. *See* ECF 137-12. Mr. LeGuyader's testimony sheds no new light on this defunct program. *See Hyatt*, Case No. 20-983, ECF 71-11 at ¶¶ 4-15 (describing "SAWS program"); *see also* Devon Rolf, "Secret Examination Procedures at the USPTO: My Experience with SAWS," (Dec. 14, 2014);¹¹ ECF 137-11 (dated Dec. 3, 2014).

Much of Mr. LeGuyader's testimony about the treatment of Mr. Hyatt's applications is also old news. Decl., ¶¶ 16-23, 27. The particular treatment of his applications has been part and parcel of Mr. Hyatt's defense since the USPTO raised prosecution laches. *See Hyatt*, Case No. 20-983, ECF 71-5, ¶¶ 9 ("Hyatt Room"), 41 ("Hyatt unit"); ECF 137-36 at 16 (9:20-10:7, referring to "Hyatt Unit"). For example, one of Mr. Hyatt's 2017 deposition topics in the DC cases was:

All policies, practices, instructions, memoranda, procedures, or guidelines (whether formal or informal) for handling Mr. Hyatt's patent applications, including (but not

¹¹ Available at <https://www.ipwatchdog.com/2014/12/14/secret-examination-procedures-at-the-uspto-my-experience-with-saws/id=52638/> (last checked May 4, 2021).

limited to): (a) a **“Hyatt Room”** or other location to work on, segregate or place Mr. Hyatt’s patent application materials. (b) a **“Bulk Filers”** Art Unit, **“Art Unit 2615,”** **“Team Exam Six,”** or other unit, **group,** or team **to examine or otherwise act upon Mr. Hyatt’s patent applications;** (c) **“an entire art unit since 2013, dedicated to examining Mr. Hyatt’s applications,”** as detailed on pages 3 and 43 of your Memorandum of Points and Authorities in Support of your Motion to Dismiss (“Memorandum of Law”).

ECF 137-5 at 6 (emphasis added). He also propounded a corresponding document request on this same topic. ECF 137-1 at 8 (“Request No. 5”). His trial exhibit list reflects actual discovery on this issue. *See, e.g.,* ECF 137-33 at 14 (“Bulk filer 1 tracking report”). Mr. LeGuyader’s proffered testimony on the organizational changes the USPTO made to accommodate Mr. Hyatt’s unprecedented filings is duplicative and immaterial.

More importantly, there is nothing nefarious about bringing all of Mr. Hyatt’s complex and interrelated applications under one group and even in one room. Mr. Hyatt’s applications are exceedingly long and “incorporate by reference” numerous of his other applications. Because they involve common, overlapping subject matter, his applications present many of the same issues. Indeed, Mr. Hyatt routinely filed the same prior art in all of his related cases. (A1100 (“These IDSs are common to 100 related applications....”)). From an efficiency standpoint, it only makes sense that the USPTO would consolidate these related applications under one roof to facilitate the review of those applications by the same group of examiners. As a result, Mr. LeGuyader’s testimony does not move the needle on USPTO’s prosecution laches rejection and is completely irrelevant to undue multiplicity.

3. 2009-2013: LeGuyader’s testimony as TC 2600 Director is irrelevant.

Mr. LeGuyader’s testimony about what happened to Mr. Hyatt’s applications after he took over as the Director of TC 2600 in 2009 is equally irrelevant. The Administrative Record in the -990 case, for example, makes clear that the USPTO suspended prosecution during much of this time. A5272 (six month suspension issued on March 14, 2008); A5274 (six month suspension

issued on December 29, 2008), A5278 (six month suspension issued on September 21, 2009); A5280 (six month suspension issued on April 12, 2010); A5284 (six month suspension issued on September 23, 2011). In the last of these suspensions—signed by Mr. LeGuyader himself—the USPTO explained that:

A group of applications involving issues related to this application have been remanded for action to the TC requiring reconsideration of matters brought forth by the CAFC. In view of the requirement placed on the TC to address the aforementioned remands, Ex parte prosecution is SUSPENDED FOR A PERIOD OF 6 MONTHS. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

(A5284.) These facts are not disputed. Nothing Mr. LeGuyader has to say about these administrative suspensions will change these facts.

4. 2013-2020: LeGuyader's post-Requirements testimony is irrelevant.

Mr. LaGuyader's testimony about the handling of Mr. Hyatt's applications after the 2013 Requirements were issued is completely irrelevant. There can be no dispute that these Requirements were a watershed moment in the prosecution of the applications. (A5285-318.) They imposed certain requirements on Mr. Hyatt (hence the name) including a limitation of 600 claims per unique specification. (A5311.) Because these requirements were a fresh, new approach to bringing order by managing the examination of Mr. Hyatt's applications, the Examiner allowed Mr. Hyatt an opportunity to make an informed selection of the claims he wanted to prosecute. (A5317.) Rather than take advantage of these Requirements to focus his claims, Mr. Hyatt continued his shell game of shifting and amending claims, stubbornly refusing to live within this generous claim budget. *Compare* A5419, A5509-15, A5539-40 (originally selected claims 454, 460, 468, and 547), *with* A5796, A5864, A5878-79, A5993-94, A6000-01, A6007-09, A6079-80 (re-designated claims 230, 253, 454, 460, 468, and 547 as amended). Had he complied with the Requirements he may have avoided a prosecution laches rejection altogether and, almost certainly, an undue multiplicity rejection. Mr. LeGuyader's *post hoc* explanation for what happened during

this time does not change the historical facts of record and, as a result, does not create “good cause” for the late admission of his declaration or re-opening discovery. *See* Decl., ¶¶ 25-37.¹²

Finally, Mr. LeGuyader’s claims of “examiner bias,” while false, are not new. They are one of Mr. Hyatt’s common “talking points,” appearing in virtually every case he has filed against the USPTO. *See, e.g.,* Complaint at i-ii, *Hyatt v. USPTO*, ECF 1, Case 1:18-cv-00546 (E.D. Va. May 7, 2018). His only purported evidence of “bias” is examiner frustration with examining Mr. Hyatt’s applications, as evidenced by the notorious “chokehold” meme. Again, the Court need only review the 137 pages of claims in Mr. Hyatt’s ’173 application to get a sense of how daunting a task it is to examine his applications. (A7899-8035.) Many of the claim terms appearing in these claims *do not appear at all* in Mr. Hyatt’s 600+ page specification, making it unclear what these terms even mean. (A12-A663.) Imagine, then, the plight of an examiner who has finally prepared a detailed office action, only to have Mr. Hyatt completely re-write his claims, rendering all of the previous effort for naught, just as Mr. Hyatt did below with selected claim 454. (A5993-94) (deletions in strike-through and additions underlined). To think that an examiner would not grow frustrated with these tactics denies human nature. Justifiable frustration, however, does not equal bias. *Cf. Liteky v. United States*, 510 U.S. 540, 555–56 (1994) (“*Not* establishing bias or partiality, however, are expressions of impatience, dissatisfaction, annoyance, and even anger, that are within the bounds of what imperfect men and women, even after having been confirmed as federal judges, sometimes display.”); *Sharkey v. J.P. Morgan Chase & Co.*, 251 F. Supp. 3d 626, 633 (S.D.N.Y. 2017) (“Judicial remarks ‘that are critical or disapproving of, or even hostile to, counsel, the parties, or their cases, ordinarily do not support a bias or partiality challenge.’” (quoting *Liteky*,

¹² As previously discussed in Section II.B.4, *supra*, the LeGuyader declaration lacks credibility on this point.

510 U.S. at 555)). Because Mr. LeGuyader's testimony on examiner "bias" is immaterial to the USPTO's motion for summary judgment, Mr. Hyatt's Motion should be denied.

5. The LeGuyader declaration is irrelevant because it mistakes correlation for causation.

Correlation is not causation. *See Verisign, Inc. v. XYZ.COM LLC*, 848 F.3d 292, 300 (4th Cir. 2017). Mr. LeGuyader's declaration conflates the two. Just because the USPTO consistently rejects Mr. Hyatt's patent applications does not prove that the agency has a secret "no-patents-for-Hyatt" policy. Decl., ¶ 3. Rather, it simply proves that Mr. Hyatt continues to do the same things that the USPTO told him not to do.

The USPTO's undue multiplicity rejection illustrates this point. When the USPTO issued its Requirements it gave Mr. Hyatt a budget of 600 claims in each of his 12 unique patent specifications or a total of 7,200 claims with which to work. That is roughly 30 typical patents worth of claims for each of his unique specifications (assuming 20 claims/patent), or a total of approximately 360 patents. Rather than keep within these budgets and maintain clear lines of demarcations between his applications (as he agreed to do in 1996), Mr. Hyatt kept alive hundreds of claims in each application, shifting his claims along the way, making it virtually impossible for an examiner to meaningfully examine his applications. *Compare Hyatt*, Case No. 20-990, A803 (1996 Petition stating "the Applicant agreed to file supplemental preliminary amendments having focused claims in said 49 related applications, as suggested by Director Godici."), *with id.*, A5824-6100 (2016 amendment substantially rewriting pending claims 95-551 and adding new claims 552-632). Mr. Hyatt was doing these same things across all of his applications.

The USPTO finally rejected all of Mr. Hyatt's claims as unduly multiplied. Mr. Hyatt correctly anticipates that the USPTO is likely to issue the same undue multiplicity rejection in future applications if he uses the same playbook. To the extent that he refuses to comply with the Requirements, his concerns are well founded. Presenting thousands of claims in related

applications with numerous, subtle variations of claim terms that do not appear in the original specification likely will result in another undue multiplicity rejection. But that is not bias, it is consistency. If Mr. Hyatt desires a different outcome, he should try a different approach, namely cancelling all but his 600 selected claims across his related applications. Until then, he should expect the same result, not because of a policy against him, but because his claims are unduly multiplied for the reasons originally explained in the 2013 Requirements. *Hyatt*, Case No. 20-990 (A5286-5318).

III. CONCLUSION

The Motion has not shown good cause or excusable neglect to justify the filing of the proposed Supplemental Memorandum or the LeGuyader declaration. It does not provide facts to demonstrate diligence or explain why Mr. Hyatt did not raise the prospect of the proposed supplementation until he filed the Motion. The LeGuyader declaration constitutes prejudice by its improper testimony implicating various privileges, including the USPTO's attorney-client privilege, as well as Mr. LeGuyader's on-going duties as a former federal employee. It evinces a lack of good faith for the same reasons, and because it is inherently incredible on several points. Finally, the LeGuyader declaration largely presents duplicative or irrelevant testimony. As a result, the relevant "good cause" and "excusable neglect" factors weigh in the USPTO's favor. For all of the foregoing reasons, this Court should deny Hyatt's motion for leave to submit his Supplemental Memorandum and Mr. LeGuyader's supporting declaration and proceed directly to the merits of the USPTO's motion for summary judgment.

DATED: May 4, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on May 4, 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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