

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

GILBERT P. HYATT,

Plaintiff,

v.

KATHERINE K. VIDAL, Under  
Secretary of Commerce for Intellectual  
Property and Director of the United  
States Patent and Trademark Office,

Defendant.

Civil Action No. 1:24-cv-00184

**COMPLAINT**

Plaintiff Gilbert P. Hyatt, by and through his attorneys Baker & Hostetler LLP, alleges as follows:

**Nature of the Action**

1. This is an action under the Patent Act, 35 U.S.C. § 145, to obtain a patent on patent application serial number 08/457,726 (Dkt. #707). For over two decades, Plaintiff Gilbert P. Hyatt has diligently prosecuted the '726 Application in the U.S. Patent and Trademark Office ("PTO"), as well as several hundred co-pending applications.

2. Rather than examine Mr. Hyatt's applications in good faith, the PTO has engaged in an unprecedented decades-long campaign to prevent Mr. Hyatt from obtaining further patents on his inventions. That campaign included placing his applications in an administrative purgatory that one federal judge referred to as "never-never land," ignoring applications until all potential terms on them expired, misrepresenting the PTO's intent to act on Mr. Hyatt's applications to federal court, "recycling" his applications when examiner rejections were reversed by administrative appeals, pulling allowed applications from issuance, and even representing in federal court that it intended to reject Mr. Hyatt's applications.

3. Congress has provided a cause of action for an aggrieved patent applicant to bring a civil action under 35 U.S.C. § 145 to obtain *de novo* consideration of his entitlement to a patent. Mr. Hyatt brings this action to obtain a patent in this application.

#### **Parties**

4. Plaintiff Gilbert P. Hyatt is an engineer, scientist, and inventor who has obtained more than 70 issued patents. Some of his patents and applications cover microcomputer structure, computer memory architecture, incremental processing, illumination devices, display devices, graphics systems, image processing, and sound and speech processing. He is 85 years of age and resides in Clark County, Nevada.

5. Defendant Katherine K. Vidal is the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. She has overall responsibility for the administration and operation of the PTO, including the patent examination process. She is named as a defendant in her official capacity only.

#### **Jurisdiction and Venue**

6. This action arises under the patent laws of the United States. This Court has subject-matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338(a), and 35 U.S.C. § 145.

7. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(e) and 35 U.S.C. § 145.

8. This Complaint is timely filed in accordance with 35 U.S.C. § 145, 37 C.F.R. § 90.3(a)(3)(i), and the order granting Mr. Hyatt's request for an extension of time under 37 C.F.R. § 90.3(c)(1)(i).

9. This matter has not been appealed to the United States Court of Appeals for the Federal Circuit.

#### **The '726 Application**

10. Mr. Hyatt is the owner and inventor of U.S. Patent Application Serial No. 08/457,726 (Dkt. #707) (the "'726 Application").

11. The '726 Application has the benefit of the filing date of U.S. Patent Application Serial No. 06/663,094 (Dkt. #303) filed on October 19, 1984.

12. The '726 Application includes the following 333 claims: 115, 119, 120, 123, 128, 133, 135, 137, 139, 141, 144, 148–150, 153, 154, 157, 158, 161, 162, 165, 167, 169, 171, 173, 175, 178, 179, 184, 186, 188, 189, 195, 196, 199, 201, 202, 209–211, 214, 218, 223, 227–243, 245–247, 249, 251–253, 255–266, 268–278, 280–285, 287, 288, 290, 292–295, 297–299, 301–305, 307, 309–312, 317, 321, 322, 326–335, 337–339, 342, 343, 348, 349, 354, 355, 359, 360, 364, 365, 370, 371, 373–375, 377–379, 387, 396–404, 407, 409–411, 414–423, 425, 427–445, 447, 449, 451–453, 455–458, 460–470, 472–474, 476–484, 486–490, 492, 494–496, 507–517, 519–527, 529–537, 539–542, 544–546, 548, 550–552, 554–557, 560–578, 580–584, 588–594, 596–599, and 601–619 (the “Subject Claims”).

13. Mr. Hyatt is seeking issuance of a patent on the Subject Claims, but not on any other claims in the '726 Application.

14. Subject Claim 115 of the '726 Application is generally directed to a process of displaying a moving 3D-perspective image representing roaming through and zooming into a 3D environment based on shaded kernel filtering image information that is in turn based on transforming data compressed 2D memory mapped image information that is accessed from a charge storage memory having a relational database management capability and then data decompressed. Subject Claim 139 of the '726 Application is generally directed to a process of controlling a robot based on inertial navigation information and shaded kernel processing information that is based on camera information, computer instructions, and information that is accessed from a charge storage memory having a relational database management capability and then data decompressed, without recitations of feedback. Subject Claim 247 of the '726 Application is generally directed to a process of displaying a moving 3D-perspective image simulating a viewpoint translating through and zooming into and out of a 3D environment based on data compressed 3D-environment information that is accessed from a charge storage memory having a relational database management

capability and then data decompressed. Subject Claims 179, 240, and 404 of the '726 Application are generally directed to processes of displaying a moving 3D-perspective image, pattern recognition processing, or artificial intelligence processing based on memory mapped background image information and memory mapped object image information that are accessed from a charge storage memory having a relational database management capability and then data decompressed. The remaining Subject Claims in the '726 Application are generally directed to processes of (a) performing various actions by iteratively processing information from a communication link and from database information stored in a memory, using an outer loop, a middle loop, and an inner loop, at least the inner loop processing being performed in real time, or using a plurality of pipelined or parallel processors in real time, in any case without recitation of Fourier transforming; or (b) displaying an image, pattern recognition processing, artificial intelligence processing, or outputting information to an output communication link, in all cases based on shaded kernel filtered image, television, or video information generated by real time processing of rotating information or translating information that is generated by transform processing information from a communication link and data decompressed or database information stored in a memory, where either the transform processing or kernel filter processing uses time slice processing. These lines of demarcation are further evidenced by the specific limitations of each Subject Claim. Each claim of the Subject Claims of the instant application has ascertainable differences in scope from the claims of Mr. Hyatt's co-pending applications.

15. Mr. Hyatt filed the '726 Application on June 1, 1995. As such, this application is governed by the Transitional Rules under the Uruguay Round Agreements Act, Public Law No. 103-465 (1994) ("URAA"), including a provision the PTO implemented in 37 C.F.R. § 1.129(a) ("Rule 129(a)"), that limits to two the number of submissions that an applicant can file, to require limited further examination.

16. The '726 Application is deemed "special" under the PTO rules and must be "advanced out of turn." 37 C.F.R. § 1.102(a). It "continue[s] to be special throughout its entire course of prosecution in the [PTO], including appeal, if any, to the [Board]." MPEP § 708.01.

17. Mr. Hyatt has never made a dilatory filing in prosecuting the '726 Application. In contrast, the PTO suspended prosecution on at least seven occasions (5/30/2003, 5/3/2007, 3/17/2008, 12/29/2008, 9/24/2009, 4/19/2010, and 9/23/2011), and entered new grounds of rejections at least as late as September 2019.

18. The PTO subjected all of Mr. Hyatt's applications, including the instant application, to the Sensitive Application Warning System ("SAWS"), from at least the late 1990s through 2015. In accordance with the terms of the SAWS, examiners lacked authority to allow Mr. Hyatt's patent applications. Moreover, under the terms of the SAWS, examiners and other PTO officials were directed to consider factors that are irrelevant to the statutory criteria for patentability in determining whether or not to permit Mr. Hyatt's applications to issue as patents. The inclusion of Mr. Hyatt's applications in the SAWS prejudiced the PTO in its consideration of Mr. Hyatt's applications, including the instant application.

19. In August 1995, Mr. Hyatt filed a preliminary amendment.

20. In September 1995, the PTO sent a non-final office action rejecting all claims.

21. In March 1996, Mr. Hyatt timely responded.

22. In August 1996, the PTO sent a final office action rejecting all claims.

23. In January 1997, Mr. Hyatt filed a notice of appeal, and in April 1997, Mr. Hyatt made a Rule 129(a) submission removing the finality of the office action, and in August 1997, Mr. Hyatt filed a supplemental amendment.

24. In August 1997, the PTO sent a final office action rejecting all claims and containing a two-way restriction requirement.

25. In October 1997, Mr. Hyatt filed a petition to withdraw the restriction requirement and a request to reconsider the restriction requirement. Later that month, Mr. Hyatt had an interview with the examiner in which the examiner stated that the final office action would be withdrawn and promised to send a new office action, and the PTO sent a paper in November 1997 confirmation that this mooted Mr. Hyatt's request.

26. In December 1997, Mr. Hyatt filed a supplemental amendment.

27. For a year and a half after Mr. Hyatt's Rule 129(a) submission, the PTO did not take any action on the merits. In October 1998, the PTO sent a non-final office action rejecting all claims.

28. In April 1999, Mr. Hyatt timely responded, and in August 1999, Mr. Hyatt filed a supplemental amendment.

29. For another year, the PTO did not take any action on the merits. In September 2000, the PTO sent a final office action rejecting all claims.

30. In March 2001, Mr. Hyatt filed a notice of appeal, and in September 2001, Mr. Hyatt made a second Rule 129(a) submission removing the finality of the office action, and in October 2001, Mr. Hyatt filed a supplemental amendment.

31. In July 2002, the PTO sent a non-final office action rejecting all claims.

32. In January 2003, Mr. Hyatt timely responded, and in July 2003 and December 2003, Mr. Hyatt filed supplemental amendments.

33. For more than a year and half after Mr. Hyatt's response, the PTO did not take any action on the merits. In November 2004, the PTO sent a non-final office action rejecting all claims.

34. In December 2004 and February 2005, Mr. Hyatt had interviews with the examiner, in which the examiner agreed to replace the office action.

35. In March 2005, Mr. Hyatt sent a response to the office action even though the examiner had not sent the promised replacement.

36. The PTO did not take any action on the merits for nearly eight and half years after Mr. Hyatt's interview with the examiner. Instead, the PTO suspended examination on six different occasions and did not decide Mr. Hyatt's repeated petitions for action.

37. In October 2013, the PTO sent a so-called "Requirement" action that, among other things, purported to require Mr. Hyatt to select 600 claims for examination in applications of the "700 Family" (each of which have the same disclosure as the disclosure in the '726 Application) and to identify any earlier embodiment that falls within the scope of any selected claim that Mr. Hyatt believed was entitled to a priority date earlier than December 22, 1988, or to provide a simple statement that the claim was described in the written description of the 07/289,355 Application (Dkt. #321), filed on that date, excluding documents incorporated by reference.

38. In late 2013, the PTO sent similar Requirements in nearly all of Mr. Hyatt's applications.

39. In January 2014, Mr. Hyatt timely responded to the Requirement.

40. For two years, the PTO did not take any action on the merits. In January 2016, the PTO sent a non-final office action rejecting all claims. The PTO acknowledged that Mr. Hyatt's response was "bona fide" and "fully responsive."

41. In July 2016, Mr. Hyatt timely responded.

42. For more than another two years, the PTO did not take any action on the merits. In August 2018, the PTO sent a notice of non-compliant amendment that contained a two-way restriction requirement.

43. In February 2019, Mr. Hyatt timely responded.

44. In September 2019, the PTO sent a final office action rejecting all claims but in a December 2019 interview, the examiner withdrew the finality of the action.

45. In February 2020, Mr. Hyatt timely responded.

46. In May 2020, the PTO sent a final office action rejecting all claims.

47. In November 2020, Mr. Hyatt filed a notice of appeal with minor claim amendments, which the PTO entered in January 2021, and in May 2021, Mr. Hyatt filed his appeal brief.

48. In October 2021, the PTO sent an examiner's answer.

49. In January 2022, Mr. Hyatt timely filed a reply brief.

50. The PTO did not take any action on the merits for another period of nearly two years. On November 22, 2023, the Board sent its decision affirming the rejections of each of the Subject Claims on at least one ground of rejection.

### **The Written Description Rejections**

51. The PTO rejected Subject Claims 115, 139, 179, 240, 247, and 404 for alleged lack of written description within the meaning of pre-AIA 35 U.S.C. § 112, first paragraph.

52. The disclosure of the '726 Application describes the claimed subject matter of Subject Claims 115, 139, 179, 240, 247, and 404 in such manner that a person of ordinary skill in the relevant field of art would understand that Mr. Hyatt had possession of the invention claimed in that Subject Claim as of the '726 Application's effective filing date.

53. The rejection of Subject Claims 115, 139, 179, 240, 247, and 404 under pre-AIA 35 U.S.C. § 112, for alleged lack of written description under pre-AIA 35 U.S.C. § 112, first paragraph, is erroneous.

### **The Prosecution Laches Rejection**

54. The PTO rejected the Subject Claims and held the '726 Application entirely forfeited under the equitable doctrine of prosecution laches.

55. The rejection for prosecution laches is erroneous.

56. The prosecution laches rejection is erroneous because prosecution laches is not a valid ground of rejection under the Patent Act, particularly for the '726 Application, which is subject to the two-submission limit of the URAA Transitional Rules.

57. The prosecution laches rejection is erroneous because Mr. Hyatt did not delay prosecution.



58. The prosecution laches rejection is erroneous because any delay in the prosecution is attributable to the actions or inaction of the PTO.

59. The prosecution laches rejection is erroneous because any delay in prosecution fairly attributed to Mr. Hyatt is not unreasonable and not unexplained.

60. The prosecution laches rejection is erroneous because Mr. Hyatt's prosecution actions did not constitute an egregious misuse of the statutory patent system.

61. The prosecution laches rejection is erroneous because the PTO failed to warn Mr. Hyatt in advance of any specific actions or inaction of the risk of forfeiture of his rights under the Patent Act in or as to the '726 Application and failed to warn Mr. Hyatt of what specific actions he should take or not take to avoid forfeiture.

62. The prosecution laches rejection is erroneous because the PTO failed to make a sufficient showing of intervening rights.

63. The prosecution laches rejection is erroneous because the PTO unreasonably delayed in asserting prosecution laches after decades of prosecution activity by Mr. Hyatt, prejudicing Mr. Hyatt, who has invested significant amounts of time and money in the prosecution of the '726 Application.

64. The prosecution laches rejection is erroneous because the PTO has unclean hands.

#### **The Undue Multiplicity Rejections**

65. The PTO rejected all of the Subject Claims under pre-AIA 35 U.S.C. § 112, second paragraph, as allegedly failing to distinctly claim the subject matter that Mr. Hyatt regards as the invention under the doctrine of undue multiplicity.

66. Each of the Subject Claims informs with reasonable certainty about the scope of each claim.

67. Each of the Subject Claims distinctly claims the subject matter that Mr. Hyatt regards as the invention.

68. The Subject Claims are distinguished from all claims that Mr. Hyatt seeks to pursue in all of his other applications because each of the Subject Claims are generally directed to the processes listed in paragraph 14 above, whereas Mr. Hyatt does not seek to patent any claims that meet the same descriptions in any other of his applications. Each of the Subject Claims contains further specific limitations. Each of the Subject Claims has ascertainable differences in scope from the claims of Mr. Hyatt's co-pending applications. Each of the Subject Claims of the '726 Application has ascertainable differences in scope from each other.

69. The rejection of the Subject Claims as unduly multiplied under pre-AIA 35 U.S.C. § 112, second paragraph, is erroneous.

### **Objections**

70. In addition to rejecting the Subject Claims, the PTO has objected to the specification and drawings.

71. All objections to the specification and drawings are erroneous because the specification and drawings comply with the requirements of law.

### **Count I: Issuance of a Patent**

72. The above paragraphs are hereby incorporated by reference as if set forth fully herein.

73. Patent Act Section 145 provides a cause of action for a patent applicant dissatisfied with a decision of the Patent Trial and Appeal Board to obtain a judgment that the "applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Patent Trial and Appeal Board." 35 U.S.C. § 145.

74. Each of the Subject Claims of the '726 Application was involved in the November 22, 2023, decision of the Patent Trial and Appeal Board.

75. Each of the Subject Claims of the '726 Application is patentable.

76. Each of the Subject Claims of the '726 Application satisfies all applicable legal requirements for issuance of a patent.

77. Mr. Hyatt is entitled to receive a patent on the Subject Claims in the '726 Application.

**Prayer for Relief**

WHEREFORE, Plaintiff respectfully asks that this Court enter Judgment in his favor and that he be granted the following relief:

- A. A decree that Mr. Hyatt is entitled to receive a patent for the '726 Application on the Subject Claims;
- B. A decree that the rejections of the Subject Claims of the '726 Application are erroneous;
- C. A decree authorizing the Director of the United States Patent and Trademark Office to issue a patent for the subject matter claimed in the Subject Claims of the '726 Application;
- D. A decree that the specification and drawings of the '726 Application comply with the requirements of law; and
- E. Such other and further relief as the Court may deem just and proper.

Dated: February 3, 2024

Respectfully submitted,

/s/ Mark W. DeLaquil  
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\* Application for admission *pro hac vice* forthcoming