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-01025

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 08/483,011 (Dkt. #852). For over two decades, Plaintiff Gilbert P. Hyatt has diligently prosecuted the '011 Application in the U.S. Patent and Trademark Office ("PTO"), as well as several hundred co-pending applications.

2. 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

3. 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 86 years of age and resides in Clark County, Nevada.

4. 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

5. 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.

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

7. This Complaint is timely filed in accordance with 35 U.S.C. § 145 and 37 C.F.R. § 90.3(a)(3)(i).

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

The '011 Application

9. Mr. Hyatt is the owner and inventor of U.S. Patent Application Serial No. 08/483,011 (Dkt. #852) (the "'011 Application").

10. The '011 Application has the benefit of the filing date of U.S. Patent Application Serial No. 05/849,812 (Dkt. #145) filed on November 9, 1977.

11. The '011 Application includes the following 181 claims: 118, 168–171, 173–179, 181–183, 185–187, 190–196, 199–202, 204–207, 209–213, 215–217, 219–225, 232, 236, 237, 239, 240, 242, 248, 250–252, 255, 257, 258, 262, 263, 266–271, 276, 279, 280, 282–287, 293, 297–305, 312, 317, 318, 320–323, 326–329, 331–335, 341, 345–358, 360–375, 377, 378, 380–388, 390, 391, 394–396, 400–403, 405, 410, 415, 422–429, 436–444, and 459–464 (the "Subject Claims").

12. Mr. Hyatt is seeking issuance of a patent on the Subject Claims, but not on any other claims in the '011 Application.

a. Subject Claim 250 is generally directed to a process of controlling an integrated circuit machine with an output circuit generating output information based on execution of computer instructions stored in a program memory and based on control information from a processor circuit that uses information received over a data link, with the output circuit, the processor circuit, and the program memory being implemented as part of a single integrated circuit chip.

b. Subject Claim 297 is generally directed to a process of transmitting information onto a telephone data link with an output circuit based on data compacted information generated with a processor circuit, based on execution of computer instructions stored in a program memory, and based on transducer information generated with a monolithic transducer, with the output circuit, the processor circuit, and the program memory being implemented as part of a single integrated circuit chip.

c. Subject Claim 242 is generally directed to a process of generating a speech message with an integrated circuit sound transducer based on output information generating with an output circuit based on secure sound information generated by decoding with a processor circuit, based on execution of computer instructions stored in the program memory, and based on information received over a microwave data link, with the output circuit, the processor circuit, and the program memory being implemented as part of a single integrated circuit chip.

d. Subject Claim 415 is generally directed to a process of generating computer output information with a computer output circuit based on decoded sound information generated with a processor circuit based on execution of computer instructions stored in the program memory and based on information received over a telephone data link, with the output circuit, the

processor circuit, and the program memory being implemented as part of an integrated circuit computer.

e. The remaining Subject Claims in the '011 Application are generally directed to systems or processes of (i) transmitting onto a data link information based on computer instructions stored in a program memory, the data link information either generated with a bit serial output circuit or based on sound information stored in charge storage memory, speech recognition information, or plural channels of data compressed information; (ii) generating output information based on computer instructions stored in a program memory and information received over a data link, the output information either being bit serial or based also on sound information stored in charge storage memory or plural channels of demultiplexed information; or (iii) generating sound or a speech message with an integrated circuit transducer or monolithic sound transducer based on information received over a data link and based on computer instructions stored in a program memory on a single integrated circuit chip, in all cases (i)-(iii), *supra*, without recitations of any of non-volatile memory, read-only memory, or computer operands stored in a scratch pad memory.

f. These lines of demarcation, *supra*, 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.

13. Mr. Hyatt filed the '011 Application on June 6, 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.

14. The '011 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.

15. Mr. Hyatt has never made a dilatory filing in prosecuting the '011 Application. In contrast, the PTO suspended prosecution on at least six occasions (5/11/2007, 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 June 2017.

16. 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.

17. In August 1995 and December 1995, Mr. Hyatt filed preliminary amendments.

18. In April 1996, the PTO sent a non-final office action rejecting all claims.

19. In July 1997, Mr. Hyatt filed a petition to revive the application as unintentionally abandoned, along with a response to the non-final office action.

20. In September 1997, the PTO granted the petition.

21. In December 1997, the PTO sent a final office action rejecting all claims.

22. In May 1998, Mr. Hyatt filed a notice of appeal, and in November 1998, Mr. Hyatt made a Rule 129(a) submission removing the finality of the office action, and Mr. Hyatt filed a further amendment in January 1999.

23. In June 1999, the PTO sent a final office action rejecting claims and entering a restriction requirement.

24. In August 1999, Mr. Hyatt filed a request for reconsideration and petition to withdraw the restriction requirement.

25. In November 1999, Mr. Hyatt filed a notice of appeal, and in May 2000, Mr. Hyatt filed an appeal brief.

26. In November 2000, the PTO dismissed the petition as premature.

27. For nearly three years after Mr. Hyatt's appeal brief, the PTO did not take any action on the merits.

28. In March 2003, the PTO sent a non-final office action re-opening prosecution, withdrawing the restriction requirement, and rejecting all claims.

29. In August 2003, Mr. Hyatt timely responded, and in September 2003, Mr. Hyatt filed a supplemental amendment.

30. The PTO did not take any action on the merits for more than ten years after Mr. Hyatt's August 2003 response. Instead, the PTO suspended examination on six different occasions and did not decide Mr. Hyatt's repeated petitions for action.

31. 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 "600 Family" (each of which have the same disclosure as the disclosure in the '011 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 November 9, 1977, or to provide a simple statement that the claim was described in the written description of the 05/849,812 Application (Dkt. #145), filed on that date, excluding documents incorporated by reference.

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

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

34. In June 2014, 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."

35. In December 2014, Mr. Hyatt timely responded and included an amendment.

36. In June 2015, the PTO sent a notice that Mr. Hyatt's response was "bona fide" but refused to enter the amendment.

37. In December 2015, Mr. Hyatt timely responded.

38. For another period, lasting more than a year and a half, the PTO did not take any action on the merits. In June 2017, the PTO sent a non-final office action rejecting claims and including a restriction requirement.

39. In December 2017, Mr. Hyatt timely responded.

40. In April 2018, the PTO sent a final office action rejecting all elected claims.

41. In October 2018, Mr. Hyatt made another submission under Rule 129(a) removing the finality of the office action.

42. In January 2020, the PTO sent a final office action rejecting all elected claims.

43. In July 2020, Mr. Hyatt filed a notice of appeal, and in February 2021, Mr. Hyatt filed a claim-cancellation amendment and his appeal brief.

44. In November 2021, the PTO sent an examiner's answer and an advisory action entering the claim-cancellation amendment.

45. In April 2022, Mr. Hyatt timely filed a reply brief.

46. The PTO did not take any action on the merits for another period, of nearly two years. On April 12, 2024, the Board sent its decision affirming the rejections of each of the Subject Claims on at least one ground of rejection.

47. *De novo* consideration of Mr. Hyatt's entitlement to a patent on the '011 Application is uniquely necessary due to the PTO's decades-long campaign to prevent Mr. Hyatt from obtaining further patents on his inventions. Beginning in the mid-1990s, when PTO pulled several of Hyatt's applications from issuance, PTO has engaged in concerted action to prevent any of Hyatt's applications from issuing as patents. PTO placed Hyatt's

applications into the SAWS program to prevent the mailing of a notice of allowance even where an examiner wished to allow Hyatt's applications. Where Hyatt prevailed before the Patent Board, PTO "recycled" his applications by reopening prosecution after he prevailed before the Board. PTO then began to thwart Patent Board review altogether by placing Hyatt's applications in an administrative purgatory that one federal judge referred to as "never-never land." During this time, PTO misrepresented its intent to act on Mr. Hyatt's applications to at least one federal court. Aspects of that campaign have been attested to in sworn testimony by officials who personally interfered with the examination, issuance, and appeal of Hyatt's applications.

48. Ultimately, after nearly two decades of prosecution, PTO threw out all prior activity and began prosecution anew with the goal of rejecting or forcing Hyatt's applications into abandonment. During this time, the very examiners who were supposed to be impartially examining his applications were creating disrespectful "memes" about him that mirrored the language in the PTO's office actions and were sending emails disparaging his personal character. Meanwhile, PTO management instructed examiners to reject submissions Hyatt had not even made and, within three years of resuming examination, informed a federal court that PTO intended to reject all of Mr. Hyatt's applications. And PTO did, rejecting every claim in every application that the Office had not forced into abandonment, irrespective of the actual merits of the applications.

49. For these reasons, among others, PTO acted in bad faith and prejudiced the proceedings underlying the '011 Application.

The Written Description Rejections

50. The PTO rejected Subject Claims 224 and 297 for alleged lack of written description within the meaning of pre-AIA 35 U.S.C. § 112, first paragraph.

51. The disclosure of the '011 Application describes the claimed subject matter of Subject Claims 224 and 297 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 '011 Application's effective filing date.

52. The rejection of Subject Claims 224 and 297 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

53. The PTO rejected the Subject Claims and held the '011 Application entirely forfeited under the equitable doctrine of prosecution laches.

54. The rejection for prosecution laches is erroneous.

55. The prosecution laches rejection is erroneous because prosecution laches is not a valid ground of rejection under the Patent Act for the '011 Application, especially because the '011 Application is subject to the two-submission limit of the URAA Transitional Rules.[1]

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

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

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

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

60. 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

[1] In *Hyatt v. Vidal*, Judge Lamberth held that four of Mr. Hyatt's patent applications were barred based on prosecution laches. *Hyatt v. Vidal*, Case No. 1:05-cv-2310-RCL, ECF 358 (D.D.C. filed May 16, 2024). That decision does not control the disposition of this case.

under the Patent Act in or as to the '011 Application and failed to warn Mr. Hyatt of what specific actions he should take or not take to avoid forfeiture.

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

62. 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 '011 Application.

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

The Undue Multiplicity Rejections

64. 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.

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

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

67. The Subject Claims are distinguished from all claims that Mr. Hyatt seeks to pursue in all of his other applications because Subject Claim 250 is generally directed to a process of controlling an integrated circuit machine with an output circuit generating output information based on execution of computer instructions stored in a program memory and based on control information from a processor circuit that uses information received over a data link, with the output circuit, the processor circuit, and the program memory being implemented as part of a single integrated circuit chip; Subject Claim 297 is generally directed to a process of transmitting information onto a telephone data link with an output circuit based on data compacted information generated with a processor circuit, based on

execution of computer instructions stored in a program memory, and based on transducer information generated with a monolithic transducer, with the output circuit, the processor circuit, and the program memory being implemented as part of a single integrated circuit chip; Subject Claim 242 is generally directed to a process of generating a speech message with an integrated circuit sound transducer based on output information generating with an output circuit based on secure sound information generated by decoding with a processor circuit, based on execution of computer instructions stored in the program memory, and based on information received over a microwave data link, with the output circuit, the processor circuit, and the program memory being implemented as part of a single integrated circuit chip; Subject Claim 415 is generally directed to a process of generating computer output information with a computer output circuit based on decoded sound information generated with a processor circuit based on execution of computer instructions stored in the program memory and based on information received over a telephone data link, with the output circuit, the processor circuit, and the program memory being implemented as part of an integrated circuit computer; and the remaining Subject Claims in the '011 Application are generally directed to systems or processes of (a) transmitting onto a data link information based on computer instructions stored in a program memory, the data link information either generated with a bit serial output circuit or based on sound information stored in charge storage memory, speech recognition information, or plural channels of data compressed information; (b) generating output information based on computer instructions stored in a program memory and information received over a data link, the output information either being bit serial or based also on sound information stored in charge storage memory or plural channels of demultiplexed information; or (c) generating sound or a speech message with an integrated circuit transducer or monolithic sound transducer based on information received over a data link and based on computer instructions stored in a program memory on a single integrated circuit chip, in all cases (a)-(c) without recitations of any of non-volatile memory, read-only memory, or computer operands stored in a scratch

pad memory, 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 '011 Application has ascertainable differences in scope from each other.

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

The Obviousness Rejection

69. The PTO rejected certain of the Subject Claims under pre-AIA 35 U.S.C. § 103 as allegedly being obvious over certain references.

70. The PTO rejected Subject Claims 224 and 297 as obvious over Dudley (*Phonetic Pattern Recognition Vocoder for Narrow-Band Speech Transmission*, 30 J. Acoustical Soc'y of Am. 733 (August 1958)), Pols (*Real-Time Recognition of Spoken Words*, 20 IEEE Trans. on Computers 972 (September 1971)), Smith (*Application Techniques for the MCS-48 Family* (August 1977)), Boone (US H1970 H), Four-Phase Systems (*System IV/70 Computer Reference Manual* (October 1972)), Threewitt (*The microprocessor rationale*, AFIPS Conf. Procs., 1975 National Computer Conf. (May 19–22, 1975)), and Spence (U.S. Patent No. 3,786,495).

71. Subject Claims 224 and 297 would not have been obvious to a person having ordinary skill in the relevant field of art as of the effective filing date of the '011 Application, from the above-identified references or their combinations.

72. The rejection under pre-AIA 35 U.S.C. § 103 is erroneous.

The Double Patenting Rejection

73. The PTO has rejected Subject Claims 224 and 297 for non-statutory obviousness-type double-patenting over allegedly conflicting reference claim 28 of U.S. Patent 4,016,540 in view of Dudley, Pols, Smith, Boone, Threewitt, and Spence.

74. The non-statutory double-patenting rejection of Subject Claims 224 and 297 is erroneous.

The Provisional Double Patenting Rejections

75. The PTO has provisionally rejected Subject Claim 224 for non-statutory obviousness-type double-patenting (a) over allegedly conflicting reference claims 119 and 172 of U.S. Patent Application No. 08/470,856 (Dkt. #859) in view of Dudley, Pols, Spence, Boone, Smith, and Threewitt, and (b) over allegedly conflicting reference claims 329, 334, and 351 of U.S. Patent Application No. 08/486,151 (Dkt. #855) in view of Dudley, Pols, and Spence.

76. The PTO has provisionally rejected Subject Claim 297 for non-statutory obviousness-type double-patenting (a) over allegedly conflicting reference claims 119 and 172 of U.S. Patent Application No. 08/470,856 (Dkt. #859) in view of Dudley, Spence, Boone, Smith, and Threewitt, and (b) over allegedly conflicting reference claims 329, 334, and 351 of U.S. Patent Application No. 08/486,151 (Dkt. #855) in view of Dudley and Spence.

77. The provisional non-statutory double-patenting rejections of Subject Claims 224 and 297 are erroneous.

78. The provisional non-statutory double-patenting rejections are insufficient to preclude issuance of a patent on the Subject Claims of the '011 Application because the reference claims have not issued.

Objections

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

80. 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

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

82. 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.

83. Each of the Subject Claims of the '011 Application was involved in the April 12, 2024, decision of the Patent Trial and Appeal Board.

84. Each of the Subject Claims of the '011 Application is patentable.

85. Each of the Subject Claims of the '011 Application satisfies all applicable legal requirements for issuance of a patent.

86. Mr. Hyatt is entitled to receive a patent on the Subject Claims in the '011 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 '011 Application on the Subject Claims;

B. A decree that the rejections of the Subject Claims of the '011 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 '011 Application;

D. A decree that the specification and drawings of the '011 Application comply with the requirements of law; and

E. Such other and further relief as the Court may deem just and proper.

Dated: June 13, 2024

Respectfully submitted,

/s/ Mark W. DeLaquil

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* Application for admission *pro hac vice* forthcoming