

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

GILBERT P. HYATT,

Plaintiff,

v.

COKE MORGAN STEWART, Acting
Under Secretary of Commerce for
Intellectual Property and Acting Director
of the United States Patent and
Trademark Office,

Defendant.

Civil Action No. 1:25-cv-00179

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 08/426,554 (Dkt. #435). For over two decades, Plaintiff Gilbert P. Hyatt has diligently prosecuted the '554 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. Coke Morgan Stewart is the Acting Under Secretary of Commerce for Intellectual Property and Acting 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 his 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 '554 Application

9. Mr. Hyatt is the owner and inventor of U.S. Patent Application Serial No. 08/426,554 (Dkt. #435) (the “554 Application”).

10. The '554 Application has the benefit of the filing date of U.S. Patent Application Serial No. 05/550,231 (Dkt. #128) filed on February 14, 1975.

11. The '554 Application includes the following 27 claims: 66, 69, 76, 77, 88, 91, 93, 96, 98, 102, 108, 110, 111, 115, 117, 124, 129, 131, 134–136, 140, 143, 145, 151, 154, and 156 (the “Subject Claims”).

12. Mr. Hyatt is seeking issuance of a patent on the Subject Claims, but not on any other claims in the '554 Application.

13. The Subject Claims in the '554 Application are generally directed to the following subject matter: outputting onto a microwave data link and controlling equipment

(i.e., machine, aircraft, or machine tool) using Fourier-transformed information, which is in turn based on demodulated information received from an input microwave data link, but without recitation of a machine transducer. 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.

14. Mr. Hyatt filed the '554 Application on April 21, 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.

15. The '554 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.

16. Mr. Hyatt has never made a dilatory filing in prosecuting the '554 Application. In contrast, the PTO suspended prosecution on at least two occasions (9/25/2009 and 4/19/2010), and entered new grounds of rejections at least as late as August 2017.

17. 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.

18. In September 1995, Mr. Hyatt filed a preliminary amendment.

19. In February 1996, the PTO sent a final office action rejecting the originally filed claims.

20. In July 1996, Mr. Hyatt had a telephone interview with the examiner, who agreed to withdraw the final office action.

21. In July 1996, Mr. Hyatt filed a supplemental amendment.

22. In August 1996, the PTO sent a non-final office action rejecting some of the claims.

23. In November 1996, Mr. Hyatt timely responded.

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

25. In December 1996, after a telephone interview with Mr. Hyatt, the PTO sent a supplemental non-final office action rejecting all of the claims.

26. In April 1997, Mr. Hyatt timely responded and filed a notice of appeal, and in August 1997, Mr. Hyatt filed an appeal brief.

27. In November 1997, the PTO sent a non-final office action rejecting claims.

28. In April 1998, the PTO sent a supplemental office action rejecting all claims.

29. In September 1998, Mr. Hyatt timely responded.

30. In August 1999, the PTO sent a final office action rejecting all claims.

31. In December 1999, Mr. Hyatt filed a petition to restore his rights under PTO Rule 129(a) because the examiner reopened prosecution after Mr. Hyatt's appeal brief, and in March 2000, the PTO granted the petition.

32. In January 2000, Mr. Hyatt filed a notice of appeal, and in July 2000, Mr. Hyatt filed an appeal brief.

33. For more than a year, the PTO did not take any action on the merits. In October 2001, the PTO sent an examiner's answer.

34. In December 2001, Mr. Hyatt filed a reply brief and a request for oral hearing.

35. For another year, the PTO did not take any action on the merits.

36. After an oral hearing, the Board rendered a decision in September 2003 affirming one rejection but reversing another rejection.

37. In November 2003, Mr. Hyatt filed a request for rehearing.

38. In March 2004, the Board denied the request for rehearing.

39. In July 2004, Mr. Hyatt filed a lawsuit under 35 U.S.C. § 145 in the U.S. District Court for the District of Columbia.

40. In August 2006, the district court held that the rejection that the Board had affirmed was improper.

41. In October 2006, the PTO appealed the adverse decision.

42. In December 2008, the Federal Circuit affirmed the District Court's decision against the PTO, thereby confirming that all rejections by the examiner had been wrong. *See Hyatt v. Dudas*, 551 F.3d 1307 (Fed. Cir. 2008).

43. In September 2009, the Board remanded to the examiner in light of the Federal Circuit's decision.

44. For nearly five years after the Federal Circuit decision, the PTO did not take any action on the merits. In September 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 "410 Family" (each of which have the same disclosure as the disclosure in the '554 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 April 7, 1986, or to provide a simple statement that the claim was described in the written description of parent application Serial No. 06/849,243 (Dkt. #310), filed on that date, excluding documents incorporated by reference.

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

46. In December 2013, Mr. Hyatt timely responded to the Requirement.

47. In April 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."

48. In October 2014, Mr. Hyatt timely responded.

49. In August 2015, the PTO sent a notice of continuing requirement, confirming Mr. Hyatt's response was "bona fide" but refusing to enter the amendment.

50. In February 2016, Mr. Hyatt filed a replacement response to the office action.

51. In August 2017, the PTO sent a non-final office action rejecting all claims.

52. In January 2018, Mr. Hyatt timely responded.

53. In June 2018, the PTO sent a final office action rejecting all claims.

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

55. In March 2019, the PTO sent a final office action, which included a restriction requirement and a statement that two claims were withdrawn from consideration, and which rejected all other claims.

56. In September 2019, Mr. Hyatt made another submission under Rule 129(a) removing the finality of the office action, and in December 2020, Mr. Hyatt filed a supplemental amendment.

57. In December 2020, the PTO sent a final office action rejecting all claims but ignoring the December 2020 supplemental amendment.

58. In June 2021, Mr. Hyatt filed a notice of appeal, and in December 2021, Mr. Hyatt filed a claim-cancellation amendment and an appeal brief.

59. In January 2022, the PTO entered Mr. Hyatt's claim-cancellation amendment, and in November 2022, the PTO sent an examiner's answer.

60. The PTO's failure to send an examiner's answer within six months violated the commitment it made to this Court in *Hyatt v. PTO*, No. 14-cv-01300-TSE-TCB, ECF 156 (E.D. Va.).

61. In March 2023, Mr. Hyatt timely filed a reply brief.

62. The PTO did not take any action on the merits for a period of more than a year and a half. On December 10, 2024, the Board sent its decision affirming the rejections of each of the Subject Claims on at least one ground of rejection.

63. *De novo* consideration of Mr. Hyatt's entitlement to a patent on the '554 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.

64. 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.

65. For these reasons, among others, PTO acted in bad faith and prejudiced the proceedings underlying the '554 Application.

The Written Description Rejection

66. The PTO rejected Subject Claims 66, 69, 110, 129, 131, 135, 143, and 151 for alleged lack of written description within the meaning of pre-AIA 35 U.S.C. § 112, first paragraph.

67. The disclosure of the '554 Application describes the claimed subject matter of Subject Claims 66, 69, 110, 129, 131, 135, 143, and 151 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 '554 Application's effective filing date.

68. The rejection of Subject Claims 66, 69, 110, 129, 131, 135, 143, and 151 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

69. The PTO rejected the Subject Claims and held the '554 Application entirely forfeited under the equitable doctrine of prosecution laches.

70. The rejection for prosecution laches is erroneous.

71. The prosecution laches rejection is erroneous because prosecution laches is not a valid ground of rejection under the Patent Act, particularly for the '554 Application, which is subject to the two-submission limit of the URAA Transitional Rules.

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

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

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

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

76. 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 '554 Application and failed to warn Mr. Hyatt of what specific actions he should take or not take to avoid forfeiture.

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

78. 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 '554 Application.

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

The Undue Multiplicity Rejections

80. 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.

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

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

83. 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 subject matter identified in paragraph 13 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 '554 Application has ascertainable differences in scope from each other.

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

The Obviousness Rejections

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

86. The PTO rejected Subject Claims 66, 69, 110, 131, 135, and 143 as obvious over Johnstone (U.S. Patent No. 3,882,305), Games (U.S. Patent No. 3,758,758), Games II (U.S. Patent No. 3,731,526), Nelson (U.S. Patent No. 3,787,670), Ewanus (U.S. Patent No. 4,185,241), Baker (U.S. Patent No. 3,705,391), and Berg (U.S. Patent No. 3,824,597).

87. The PTO rejected Subject Claims 66, 69, 110, 131, 135, and 143 as obvious over Edwards (U.S. Patent No. 4,202,048) with the addition of either (a) Ewanus and Baker, or (b) Robinson (U.S. Patent No. 3,706,929) and Baker.

88. The PTO rejected Subject Claims 66, 69, 110, 129, 131, 135, 143, and 151 as obvious over Fleishman (U.S. Patent No. 4,232,313), Edelblute (U.S. Patent No. 4,754,282), Robinson, and Baker.

89. Subject Claims 66, 69, 110, 129, 131, 135, 143, and 151 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 '554 Application, from the above-identified references or their combinations.

90. The rejections under pre-AIA 35 U.S.C. § 103 are erroneous.

The Provisional Double Patenting Rejection

91. The PTO has provisionally rejected Subject Claims 66, 69, 110, 129, 131, 135, 143, and 151 for non-statutory obviousness-type double-patenting over allegedly conflicting reference claim 27 of U.S. Patent Application Serial No. 08/426,540 (Dkt. #430).

92. The provisional non-statutory double-patenting rejection of Subject Claims 66, 69, 110, 129, 131, 135, 143, and 151 is erroneous.

93. The provisional non-statutory double-patenting rejection is insufficient to preclude issuance of a patent on the Subject Claims of the '554 Application because the reference claim has not issued.

Objections

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

95. 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

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

97. 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.

98. Each of the Subject Claims of the '554 Application was involved in the December 10, 2024, decision of the Patent Trial and Appeal Board.

99. Each of the Subject Claims of the '554 Application is patentable.

100. Each of the Subject Claims of the '554 Application satisfies all applicable legal requirements for issuance of a patent.

101. Mr. Hyatt is entitled to receive a patent on the Subject Claims in the '554 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 '554 Application on the Subject Claims;
- B. A decree that the rejections of the Subject Claims of the '554 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 '554 Application;
- D. A decree that the specification and drawings of the '554 Application comply with the requirements of law; and
- E. Such other and further relief as the Court may deem just and proper.

Dated: January 31, 2025

Respectfully submitted,

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